



Il y a 50 ans naissait le brevet européen

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Cover:

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This picture painted by Tomislav Strnišćak (European Patent Attorney, HR) was part of the epi Artists Exhibition 2021



Tomislav Strnišćak

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Marc Névant

Foreword Vorwort Avant-propos

Quelle époque / What a time / Welche Epoche!

Cette année marque le 50^{ème} anniversaire de la signature de la Convention sur le brevet européen. A cette occasion, nous sommes fiers et honorés d'avoir pu recueillir le témoignage d'Axel Casalonga, qui a tant œuvré pour notre Institut à travers ses différents organes et comme représentant français au sein du Conseil. Un grand merci à lui de nous refaire revivre, avec l'enthousiasme qui le caractérise, les débuts du brevet européen, et de partager ses réflexions sur les évolutions du droit des brevets en Europe.

We found it difficult, if not impossible, not to say a word about one of the challenges we are facing, namely the emergence of artificial intelligence in our daily practice. Faced with the anguish of the blank page, I have asked ChatGPT to write an editorial to celebrate the 50 years of the EPC. The result is just amazing, as you can see from the editorial which follows!

Es erschien uns auch interessant, die Ansichten über die Entwicklung unseres Berufsstandes und insbesondere über die Kompetenzen, die erforderlich sind, um europäischer Vertreter zu werden, auszutauschen. Bei Redaktionsschluss findet (fand) eine außerordentliche Ratssitzung statt, auf der die Modalitäten der künftigen europäischen Eignungsprüfung erörtert werden sollen. Wir möchten allen Beteiligten im Namen des epi für die hervorragende Arbeit danken, die sie bei der Vorbereitung eines Vorschriftenentwurfs geleistet haben, der auf der Ratssitzung erörtert werden wird.

Celebrating 50 Years of Innovation: The European Patent Convention's Enduring Legacy

“Written” by ChatGPT

As the European Patent Convention (EPC) marks its momentous 50th anniversary, we are presented with an opportune occasion to reflect on the remarkable journey that has shaped the landscape of innovation, research, and technological progress in Europe. Since its inception in 1973, the EPC has been a beacon of cooperation and excellence, fostering creativity and nurturing groundbreaking ideas that have transformed industries and enriched our daily lives. With half a century of fostering innovation under its belt, the EPC has proven itself to be an indispensable cornerstone in the foundation of a prosperous and innovative Europe.

Over the past five decades, the European Patent Convention has achieved extraordinary feats, contributing significantly to the growth of science, technology, and economy across the European continent. By offering a unified and efficient patent system, the EPC has facilitated the protection of intellectual property rights for inventors, encouraging inventiveness and the pursuit of groundbreaking discoveries. As a result, countless inventors, entrepreneurs, and corporations have been empowered to take risks, invest in research and development, and bring their revolutionary ideas to fruition, bolstering Europe's global competitiveness in the process.

The EPC's influence has extended far beyond the boundaries of Europe, with the European Patent Office (EPO) playing a key role in international cooperation and harmonization of patent laws. Its collaborative framework has promoted cross-border innovation and cooperation, fostering a robust environment where inventors from diverse backgrounds and countries can come together to tackle global challenges collaboratively.

Although the EPC has witnessed tremendous success, it has not been without its share of challenges. As the pace of innovation accelerates and new technologies emerge, the EPC faces the task of adapting to the ever-changing landscape of intellectual property. The rise of digital technologies, artificial intelligence, and biotechnology demands a nimble and flexible patent system, capable of effectively protecting novel ideas and inventions while striking a balance between encouraging innovation and safeguarding public interests.

Furthermore, in an era where climate change and sustainability are pressing concerns, the EPC must continue to evolve to support and incentivize environmentally friendly and socially responsible innovations. By promoting patents that address global challenges, such as clean energy, healthcare access, and ecological sustainability, the EPC can serve as a catalyst for transformative solutions that benefit society as a whole.

On this momentous anniversary, we must recognize and celebrate the brilliance and dedication of the countless inventors and innovators who have enriched our world through their groundbreaking creations. The EPC's support has not only protected their intellectual property but also provided them with the confidence and resources needed to push the boundaries of human achievement. Their unwavering pursuit of knowledge and progress serves as a testament to the power of human ingenuity and the impact that individuals can have on shaping a brighter future.

As we celebrate the European Patent Convention's 50 years of accomplishments, we must also look ahead to the future with optimism and determination. Embracing emerging technologies, encouraging diversity in innovation, and addressing global challenges through collaborative efforts will be crucial in ensuring the continued success of the EPC in the next half-century.

Moreover, it is vital for the European Patent Office to remain committed to transparency, accessibility, and responsiveness to the needs of inventors and society as a whole. By streamlining processes, investing in digital transformation, and enhancing public outreach, the EPC can reinforce its position as a cornerstone of innovation in the global landscape.

As the European Patent Convention reaches this remarkable milestone, we are reminded of its profound impact on the world of innovation. It has not only protected the fruits of human ingenuity but has also encouraged the flourishing of new ideas, technologies, and collaborations across borders. As we celebrate its legacy, let us recommit ourselves to the pursuit of excellence, the promotion of innovation, and the shared vision of a more prosperous, sustainable, and harmonious Europe for generations to come. Happy 50th Anniversary, European Patent Convention!

Introduction

Il y a 50 ans naissait le brevet européen. Souvenirs, souvenirs...

A. Casalonga (FR), Mandataire en brevets européens, Docteur en droit

Début avril 1978, 21 heures, sur le quai de la gare de l'est à Paris. Le train de nuit pour Munich va partir. Un jeune conseil en brevets, récemment inscrit comme mandataire auprès de l'OEB, s'apprête à entrer dans le wagon. Une jeune journaliste accorte, équipée d'un enregistreur sur bande lui demande : « vous allez à Munich ? Qu'est-ce que cette ville évoque pour vous ? L'abandon de Chamberlain et Daladier ? » Je lui réponds, car le jeune conseil en brevets, c'était moi, « Pas du tout ! Je vais à Munich car c'est le nouveau symbole européen de la protection de l'innovation : savez-vous qu'un Office européen des brevets vient de s'y ouvrir ? »

Ce n'était pas mon premier voyage à Munich. Dès que la localisation du futur Office avait été connue, nous avions décidé d'ouvrir une antenne de Casalonga à Munich. Nous avions acheté un petit local en face du futur bâtiment de l'OEB, sur la Lilienstrasse. Une secrétaire avait été engagée et formée à Paris, de sorte que les premières demandes de brevet européen pouvaient être préparées à Paris et déposées physiquement à l'Office sans passer par les services postaux. Un tampon d'accusé réception était immédiatement apposé sur un double de la requête ce qui était particulièrement sécurisant. Les premiers dépôts acceptés quelques mois avant l'ouverture effective de l'Office prenaient tous comme date dépôt le 1^{er} juin 1978, date de l'ouverture.

Il y avait donc en 1978 une grande effervescence dans le milieu des professionnels du brevet. C'était, cinq ans après la signature de la CBE en 1973, à l'origine de ce tournant.

Cette nouvelle convention, révolutionnaire pour l'époque, a fixé pour longtemps le droit européen des brevets et notamment les critères de brevetabilité, dont « l'activité inventive ». Les rédacteurs de la convention, en fins diplomates, avaient choisi ce terme au lieu de celui de « Erfindungshöhe » qui aurait été trop imprégné de la pratique germanique ou de « flash of genius » de la pratique américaine.

En France la polémique sur le sujet s'est éteinte d'elle-même, les anciens adversaires résolus, tels Paul Mathély ou Jean Lavoix se ralliant finalement à « l'activité inventive » (voir l'article virulent dans les Annales de la propriété industrielle, contre l'introduction en droit français d'un tel critère considéré comme « subjectif »).

Mais revenons en 1978.

La publication des premières demandes de brevet européen allait donner lieu à une sorte de concours : qui serait le déposant de la demande publiée sous le N°1 ? Dans sa grande sagesse l'OEB avait décidé d'affecter le N°1 (pour une pompe à chaleur), à un organisme européen, l'EURATOM dont le siège était au Luxembourg.

Le N°2, (pour un dérivé de tétrahydrofurane), fût attribué à Bayer AG, la fameuse société chimique allemande, la seule société industrielle importante ou presque qui croyait à l'avenir du brevet européen (Bayer allait continuer à déposer un grand nombre de demandes de brevet européen au point que certains plaisantins pouvaient dire en 1979 que le brevet européen était « un brevet Bayer »)

Le N°3, (pour un système de serrure), à la société britannique Combi-lock Enterprises Limited et, enfin le N°4, divine surprise pour moi, (pour un dispositif de filtration centrifuge pour machine à café automatique), à un inventeur de génie indépendant, Serge Cailliot, que je connaissais personnellement, ayant déjà rédigé plusieurs brevets pour lui. L'explication du mystère résultait du fait que la demande publiée sous le N°4 était une co-propriété avec l'ANVAR, l'Agence Nationale de Valorisation de la Recherche, organisme officiel français.

Ainsi à part le N°1 au nom d'un organisme neutre européen, les Nos 2, 3 et 4 seront attribués, dans un évident souci d'équilibre politique, à des déposants importants ou officiels situés dans les trois principaux Etats membres, à savoir, l'Allemagne, le Royaume-Uni et la France.

Mais ce bel ordonnancement n'était bien sûr pas encore connu lorsque je débarquais à Munich en avril 1978. A ce moment, les demandes de brevet européen qui prendraient le 1^{er} juin 1978 comme date de dépôt étaient déjà déposées : leur dossier, avec le formulaire-papier de demande de délivrance dûment rempli, dormait dans les services de dépôt de l'Office européen en attendant le 1^{er} juin.

Ce n'est qu'à cette date que la procédure de délivrance commencerait véritablement. Pour certaines demandes situées dans des domaines techniques choisis, la recherche d'antériorités allait alors débiter dans la section de la recherche située à La Haye et constituée des chercheurs de l'ancien IIB (l'Institut International des Brevets créé par la France, les Pays-Bas et la Belgique pour les besoins de leurs offices de brevets nationaux respectifs). La décision politique essentielle de fusionner l'IIB existant avec le futur OEB avait en effet été prise, ce qui permettait de garantir la qualité du futur brevet européen.

C'est donc avec une certaine fébrilité que je me présentais le samedi 8 avril 1978 à 8h précises dans la grande salle de l'hôtel Penta où allait avoir lieu la réunion inaugurale d'un nouveau groupement professionnel unique de spécialistes européens des brevets, appelés « mandataires agréés près l'Office européen des brevets ».

C'est en effet une particularité remarquable de la Convention sur le brevet européen, que d'avoir songé aux personnes qui pourraient représenter les déposants pour les procédures devant l'Office. Non seulement un titre officiel était donné à ces « mandataires » mais encore, le conseil d'administration de l'Organisation européenne des brevets, sous la présidence de Georges Vianès, créait en octobre 1977 un « Institut des mandataires agréés ». C'est cet institut (en anglais « Institute of Professional Representatives ») qui allait ensuite être appelé plus simplement : « European patent Institute » ou « **epi** ».

Le règlement de création de l'institut prévoyait l'élection par les membres de l'institut d'un Conseil devant se réunir au moins une fois par an. Le nombre de représentants au Conseil à élire dans chaque circonscription était également prévu ainsi que les modalités des élections dans chaque circonscription avec des collèges séparés entre profession libérale et représentants de l'industrie ou, éventuellement des collèges uniques.

A la réunion inaugurale du 8 avril 1978, se trouvaient donc pour la première fois réunis, tous ceux qui s'étaient déplacés, les mandataires élus en tant que titulaires ayant seuls le droit de vote, et ceux élus en tant que suppléants.

A ce moment, seuls sept Etats européens avaient dûment ratifié la Convention sur le brevet européen de sorte que le nombre total de représentants titulaires élus au conseil n'était que de 44, auxquels s'ajoutaient 44 représentants

suppléants. Les sept Etats étaient : l'Allemagne, la Belgique, la France, le Luxembourg, les Pays-Bas, le Royaume-Uni et la Suisse.

Le président de l'Office européen des brevets, J.B. van Benthem ouvrit la séance par un discours en trois langues et les 44 représentants titulaires se mirent à discuter de la nomination des membres du bureau de l'institut et tout d'abord de l'élection de son président.

Le jeune mandataire que j'étais, l'un parmi les 44 suppléants non admis au vote, a pu alors assister à des discussions enflammées, dignes d'une guerre picrocholine décrite par Rabelais. A cette époque lointaine, les luttes entre les représentants de la profession libérale et ceux de l'industrie étaient encore vives en France et en Allemagne. Parmi les représentants français de la profession libérale, Jacques Corre, associé au cabinet Regimbeau, se voyait déjà président et tentait, à grands renforts d'arguments, aidé par Georges Bressand du cabinet Lavoix et Michel Nony, de convaincre chacun des représentants des autres pays de voter pour lui. Madame Sadones-Laurent, représentante française de l'industrie, menait de même de son côté une virulente campagne contre Jacques Corre. Les esprits s'échauffaient et on en serait presque venus aux mains si, après plusieurs heures d'échanges assez vifs et plusieurs interruptions de séance, une candidature consensuelle imprévue n'avait finalement été présentée en la personne de L.B. Chavannes, représentant des Pays -Bas et exerçant dans un cadre libéral. A la surprise générale, Mr Chavannes a alors été élu à la majorité au poste de Président et le calme est progressivement revenu.



Axel Casalonga

Madame Sadones-Laurent était ensuite élue au poste de Vice-Président comme K.J. Veryard, représentant britannique.

Le lendemain, le Conseil a entamé ses travaux et créé différentes commissions, notamment une commission sur la pratique de l'Office européen des brevets (droit européen des brevets) qui deviendrait par la suite connue sous l'appellation « European Patent Practice Committee » (EPPC). Supposant que les travaux de cette commission seraient intéressants j'avais aussitôt présenté ma candidature en tant que représentant français ce qui avait été accepté par le président désigné, Félix Jenny, du service brevet de Ciba-Geigy (Suisse). Je garde des réunions de cette commission un excellent souvenir. Les discussions étaient fructueuses et les sujets variés en ce début de mise en route de l'OEB. Les connaissances précises de la CBE que possédaient le Dr Jenny et J. Beton du service brevets de ICI (UK) nous

permettaient de préparer des propositions solides qui étaient ensuite soumises à l'OEB après acceptation par le Conseil de l'**epi**.

Les réunions du conseil de l'**epi** étaient une remarquable formation à l'esprit européen. Les trois langues officielles de l'OEB y étaient librement pratiquées, chacun s'exprimant dans sa langue. Après quelques séances, on devenait facilement trilingue. Chaque groupe national apportait son expérience et son esprit. Les Allemands la rigueur juridique, les Néerlandais le pragmatisme, les Suisses la pratique précise du vote des motions, les Français l'esprit de synthèse, les Britanniques la vision internationale.

Je me souviens notamment de l'introduction fulgurante par les Britanniques au cours d'une réunion du conseil, du titre simplifié de « European patent attorney ». Ce titre aujourd'hui mondialement reconnu a permis de se dégager, au moins en anglais, du titre officiel imprononçable prévu dans le texte de la Convention. C'était une remarquable opération de « marketing » car personne, en Europe, ne pouvait réellement prétendre à ce titre de « attorney » utilisé aux USA. Après quelques remous au sein du conseil, l'idée britannique a été adoptée et ce titre a été reconnu, même par l'OEB.

L'influence des prises de position de l'**epi** sur l'évolution du droit européen a également été, dès le début, déterminante, grâce à l'esprit d'ouverture et au pragmatisme du président van Benthem. Dans son discours inaugural, celui-ci avait déjà insisté sur l'importance qu'il attachait à l'opinion des utilisateurs. Il avait lui-même institué un organe consultatif, le SACEPO, qui devait faire entendre la voix des utilisateurs auprès de l'administration de l'Office. A chaque réunion du SACEPO, les utilisateurs étaient représentés par deux membres de l'industrie européenne (Business Europe) et deux membres de l'**epi**, généralement le président et le secrétaire de la commission EPPC.

C'est au titre de secrétaire puis de président (après le Dr Jenny) de la Commission EPPC que j'ai eu le privilège de suivre au SACEPO les développements juridiques de la pratique de l'OEB. La direction juridique de l'Office était dès l'origine de grande qualité et j'ai gardé le souvenir des discussions constructives avec le Dr Bernecker, le Dr Schatz, le Dr Gall, le Dr Teschemacher et d'autres que ma mémoire peine à nommer.

Par la suite, j'ai le souvenir de grands moments du SACEPO. Notamment les discussions sur la protection du médicament dans sa deuxième application. Sous l'impulsion du Dr Singer, la grande chambre de recours, dans sa toute première décision (ce serait la seule et la dernière sous la présidence du Dr Singer avant qu'il ne prenne sa retraite) avait admis ce que l'on a appelé « la revendication de type suisse » apte à protéger indirectement une deuxième application nouvelle d'un médicament.

Le droit européen des brevets a mis en œuvre cette revendication assez complexe de nombreuses années durant, la CBE ne prévoyant la protection du médicament en tant que produit ou composition que dans le cas d'une première application thérapeutique avec cependant une portée large puisqu'elle s'étend à toute application thérapeutique, même non décrite par le brevet et inventée par la suite. C'est une particularité européenne que les autres pays du monde ne connaissent pas. L'industrie européenne s'en accommodait, certains regrettant cependant l'insuffisance de cette revendication de type suisse et l'impossibilité d'obtenir une revendication de produit dans le cas d'une deuxième application thérapeutique.

La révision de la CBE (CBE 2000), en vigueur fin 2007, qui a été le résultat d'intenses travaux au sein de l'OEB, notamment par le trio de juristes Gert Kolle, Ulrich Schatz et Gérard Weiss, allait fournir une opportunité de modification du droit en ce qui concerne la protection des médicaments.

Les discussions au SACEPO étaient vives sur le sujet, certains redoutant que l'introduction d'une possibilité de revendication de produit pour une deuxième application thérapeutique se fasse au détriment de la protection large du produit pour la première application. D'autres étaient en faveur de la possibilité de breveter directement une méthode de traitement thérapeutique en revendiquant une application thérapeutique, ce qui aurait nécessité une modification importante de la CBE.

C'est au cours d'une réunion animée du SACEPO que la commission EPPC, alliée aux représentants de l'industrie un peu hésitants, a suggéré de conserver la revendication de produit pour la première application thérapeutique sans changement et de rajouter une revendication de produit très similaire dans sa rédaction, pour une deuxième application nommément indiquée. En tant qu'observateurs au SACEPO, nous n'avions pas la possibilité de présenter officiellement une motion dans ce sens. C'est la délégation suisse qui, après quelques hésitations en raison des risques de dérapage que cela présentait, a finalement présenté cette proposition.

Grand fut notre soulagement de constater que la proposition était acceptée par la majorité et que cette modification n'entraînerait pas de réduction de la protection du médicament dans sa première application ; le droit européen conservait ainsi toute sa puissance et se rapprochait du droit des autres pays pour la protection du médicament dans ses applications thérapeutiques autres que la première.

L'interprétation de la CBE, initiée par la grande chambre de recours dans le domaine de la santé a également porté sur les inventions mises en œuvre par ordinateur,

un domaine essentiel aujourd'hui, que le grand public ne comprend pas toujours clairement en assimilant ces inventions au logiciel protégé par le droit d'auteur. C'est une chambre de recours qui, par sa décision du 15 juillet 1986 dans l'affaire Vicom (T208/84) a fixé la règle fondamentale de la protection des inventions mises en œuvre par ordinateur, selon laquelle il y a invention brevetable dès lors qu'un effet technique est obtenu. C'est l'origine de l'abondante jurisprudence des chambres de recours dans ce domaine.

Le droit est une matière évolutive qui doit tenir compte des changements dans la société. Les quelques exemples ci-dessus illustrent les possibilités d'interprétation des textes de loi ainsi que les révisions périodiques nécessaires de ces derniers.

Aujourd'hui, l'essentiel pour la survie de l'humanité est probablement la recherche des solutions pour réduire les changements trop rapides du climat et la destruction de la biodiversité. Le droit des brevets ne peut rester insensible à ces nouvelles problématiques. Le progrès technique protégé par le brevet doit jouer un rôle important à l'avenir, que ce soit pour développer des solutions

de captation de CO₂ ou des innovations dans la création d'énergie, dans les transports etc...

Mais il est un autre aspect du droit des brevets qui gagnerait à être pris en considération. Dans une décision un peu isolée du 21 février 1995 (T356/93), une chambre de recours a reconnu que la protection de l'environnement faisait partie de l'ordre public.

Or le brevet ne peut être délivré pour une invention contraire à l'ordre public. L'OEB ne devrait-il pas envisager d'examiner de plus près cet aspect des inventions ? Cela permettrait-il de réconcilier le grand public et la technologie ? La Juridiction unifiée du brevet ne pourrait-elle aussi dans le futur, s'emparer de la question si la brevetabilité d'une invention était contestée pour cette raison devant la division centrale ?

L'avenir nous montrera si le droit des brevets s'engage dans une telle évolution interprétative en faveur de la protection de l'environnement comme il l'a fait dans le passé en faveur de la brevetabilité des inventions mises en œuvre par ordinateur, des médicaments et des inventions dans le domaine du vivant.





Patent practice

Rule 56a EPC and time travel

C. Mulder (NL) and R. van Woudenberg (NL)

On 1 November 2022, Rule 56a EPC was inserted into the EPC. This Rule allows the correction of erroneously filed application documents or parts thereof. Rule 56a EPC corresponds to a similar provision in PCT Rule 20.5bis. At the same date, Rule 56(3) EPC was amended to require that priority must already be claimed on the initially accorded date of filing in order to maintain the date of filing.

In a previous article, some flaws were noted in new Rule 56a EPC and amended Rule 56 EPC. In addition, the manner in which Rule 56a EPC was implemented in the Guidelines was criticised.

In the current article, further comments are given on Rule 56a and 56 EPC, as well as on PCT Rule 20.5bis, and some strange consequences of the Rules in proceedings before the EPO are shown.

A proposal for amending Rule 56a and Rule 56 EPC is presented in an Annex.

Introduction

Suppose you have filed a European patent application without a set of claims while claiming priority of an earlier national application containing a set of claims. Can you now later on file a set of claims without a loss of the initial date of filing? Under current Rule 56a EPC, the answer seems to be ‘yes’.

How would this work?

One of the problems with the amendment of Rule 56 EPC is that the Rule only relates to filing missing parts of the description and filing missing drawings.¹ Although the EPO stipulated that the amendment of Rule 56 EPC and the insertion of Rule 56a EPC was done “in align-

¹ Cees Mulder and Roel van Woudenberg: “New Rule 56a and amendments to Rule 56 EPC – Background, requirements and consequences” in *epi* Information 03|2022 pp.10-17.

ment with the PCT procedure”,^{2,3} the EPO did not or forgot to add the filing of missing claims into Rule 56 EPC.⁴

So, unfortunately, we cannot add a missing set of claims under Rule 56 EPC.

But can we do it under Rule 56a EPC without losing the original date of filing? Yes, this appears to be possible. However, a small trick has to be applied. You have to file a claim (preferably unrelated to the invention in the EP application).⁵ As we know, any late-filed claim (or claims) must have a basis in the application documents (description and any drawings) provided on the date of filing (Art. 123(2) EPC).⁶ However, we need not bother about this requirement, because we are going to “correct” this late-filed claim.

This “correction” is effected by filing a request to correct the application documents under Rule 56a(4) EPC, based on the priority application, in particular to correct the erroneously filed claim.⁷ To this end, the (correct) set of claims in the priority document has to be filed within two months of the original date of filing of the EP application. In addition, all further requirements in Rule 56a(4) EPC must be fulfilled, which are listed in the 2023 Guidelines.⁸ As the original EP application claims priority on the initial date of filing, it should be requested to base the correct application documents on the claimed priority in order to avoid a change in the date of filing. Where applicable, a copy of the priority application has to be filed. As the set of claims in the priority document is used to correct the erroneously filed European patent application, the “completely contained” criterion is fulfilled.

Where the conditions for including the correct application documents (or parts) under Rule 56a(4) EPC are fulfilled, the date of filing remains unchanged.⁹ The correct application documents (or parts) are included in the application

and the erroneously filed documents remain in the application as filed.¹⁰ The EPO will inform the applicants about this in a communication under Rule 56a(4) EPC.¹¹ The erroneously filed documents may only be removed by amending the application during the grant proceedings and subject to Art. 123(2) EPC.¹² This latter requirement will not be a problem if the “erroneous” claim is unrelated to the invention in our EP application.

Another advantage of this manner of acting is that even if the number of claims in the set of claims as corrected is above 15, no claims fees need be paid. This is because, the EPO did not amend Rule 45 EPC when inserting Rule 56a EPC. Rule 45(2) EPC refers to “the first set of claims” and this requirement is retained in the 2023 Guidelines for filing a correct set of claims. In the Guidelines, it is written: “Where correct claims are filed under Rule 56a(3) or (4) (see A-II, 6), the claims fee is calculated on the basis of the set of claims first filed”.¹³ This implies that the claims fees are (always) calculated on the basis of the erroneously filed claims.

Note the advantage that, even if the number of claims in the set of claims as corrected is above 15, payment of claims fees can also be avoided without using late-filed claims. One can avoid the payment of any claims fees if one accepts a one-day delay in the date of filing of a new European application¹⁴. Hereto, one first files a national application NL-0 containing a large set of claims or a European application EP-0 containing the large set of claims without paying any fees, whereby EP-0 becomes deemed to be withdrawn but can still serve as a valid priority application.¹⁵ Then, you file a European patent application EP-1 with a single, non-related claim while claiming priority of the earlier national application NL-0 or the earlier European application EP-0 containing the large set of claims. Subsequently, you file a request for including the correct, large set of claims from the priority document under Rule 56a(4) EPC so as to keep the date of filing unchanged, while including the large set of claims without the need to pay any claims fees.

In the current article, the legal basis for the application of Rule 56a EPC in the above-described circumstance is given. In addition, the implementation of Rule 56a EPC in the 2023 Guidelines is reviewed.

2 “Erroneously filed application documents and missing parts: New Rule 56a and amendments to Rules 56 and Rule 135 of the Implementing Regulations to the EPC and to Article 2 of the Rules relating to Fees”. Decision CA/4/21 (07.09.2021).
3 “Notice from the European Patent Office dated 23 June 2022 concerning the correction of erroneous filings in proceedings before the EPO” in Official Journal EPO, 2022, A71. In item I.4 it is written in relation to Rule 56 EPC: “In alignment with the PCT procedure, the EPC provision on missing parts is also amended with effect from 1 November 2022.”
4 The argument cannot be that claims are not a requirement for the accordance of a date of filing under Rule 40(1) EPC, because drawings are also not a requirement for according a date of filing and, nevertheless, missing drawings can be filed under Rule 56 EPC. Also see the discussion in the article by the current authors referred to in footnote 1.
5 See GL/EPO (2023) A-III, 15: “Late filing of claims”: “Where the application documents as originally filed did not include at least one claim, applicants may also file claims of their own motion after the date of filing, but before the EPO invites them to do so under Rule 58.” Note that, in view of the later use of Rule 56a(4), the last moment to file this erroneous claim is determined by the two-month period for filing correct documents under Rule 56a(4) EPC. Hence, the erroneous claim must be filed at the latest one day before expiry of the latter period.
6 See GL/EPO (2023) A-III, 15: “Late filing of claims”: “If the applicant does supply a set of claims in response to the invitation under Rule 58, the claims so filed must have a basis in the application documents (description and any drawings) provided on the date of filing (Art. 123(2)).”
7 See GL/EPO (2023) A-II, 6.4: “Correct application documents based on priority application, no change in the filing date”.
8 See GL/EPO (2023) A-II, 6.4.
9 See GL/EPO (2023) A-II, 6.4.

10 Rule 56a(4), last sentence, EPC.
11 See GL/EPO (2023) A-II, 6.4.
12 See GL/EPO (2023) A-II, 6.4.
13 See GL/EPO (2023) A-III, 9: “Claims fee”.
14 See GL/EPO (2023) A-III, 6.1 “Claim to priority – General remarks”: “the priority period starts on the day following the date of filing of the first application (Art. 4C(2) Paris Convention and Rule 131(2)). Accordingly, where a priority claim relates to an application filed on the same day as the European application, it will be disregarded (see, however, also A-III, 6.6).” Also see GL/EPO (2023) A-III, 6.6 “Priority period”: “Where priority is claimed from an application having the same date of filing as the European patent application (see A-III, 6.1), the EPO will inform the applicant that priority cannot be claimed from this application unless the priority date can be corrected (see A-III, 6.5.2).”
15 Art. 87(3) EPC.

In Annex 1 to this article, proposals for amended versions of Rule 56a and Rule 56 EPC are presented.

A brief history of Rule 56a EPC

On 1 July 2020, PCT Rule 20.5bis was inserted into the Regulations under the PCT.¹⁶ The Rule lays down a procedure for the correction of “erroneously filed” application documents. PCT Rule 20.5bis allows an applicant of an international application – under limited circumstances – to replace any erroneously filed claims and/or the description of the application (or parts thereof), or any erroneously filed drawings with the equivalent “correct” version of the claims, the description or the drawings (or parts thereof) as contained in the priority application.¹⁷

Current Rule 56a EPC aims at aligning the practice under the EPC with PCT Rule 20.5bis.¹⁸ The Rule is constructed in the same way as current Rule 56 EPC but includes additional provisions, as will be explained below.

After receipt of a European patent application, the EPO will first examine whether the application is entitled to a date of filing in accordance with Rule 40 EPC. If during this check, the EPO notes that the description, claims or drawings (or parts thereof), appear to have been filed erroneously (i.e. unintentionally¹⁹) the applicant will be invited pursuant to Rule 56a(1) EPC²⁰ to file the correct document (or parts thereof).^{21 22} A request for correction must be filed within two months of that invitation.²³

Under current Rule 56a(2) EPC a provision was added that formalises the EPO’s practice with regard to corrections of application documents received *on the date of filing*.²⁴ It allows the correction and exchange of application documents *before or on* the date of filing without changing the date of filing. Current Rule 56a(2) EPC applies to the unlikely and rare case that the applicant has already paid the fees on filing for the first-filed appli-

cation on the date of filing.²⁵ Anyhow, Rule 56a(2) EPC avoids that the applicant needs to file a second application and pay the corresponding fees again, if the applicant recognises on the date of filing (or earlier if the date of filing cannot yet be accorded) that erroneously filed incorrect application documents have been filed.²⁶ Note that when filing correct application documents under Rule 56a(2) EPC, the erroneously filed application document are “deemed not to have been filed”.²⁷ The insertion of Rule 56a(2) into the EPC seems to be rather superfluous, because in the EPC it is hardly possible to miss the accordance of a date of filing.²⁸ The equivalent provision in PCT Rule 20.5bis(b) makes more sense, because the requirements for obtaining an international filing date are more severe under the PCT and one does, e.g., not obtain an international filing date for a PCT application as long as no claim has been filed.²⁹ Thus, in practice, Rule 56a(2) EPC will probably only be used to replace an erroneously filed description by a correct one on the date of filing itself (e.g., where one realizes having filed an earlier draft version of the description), or to replace an erroneously filed set of claims or drawings on the date of filing itself.

In Annex 1 a proposal for an amended version of Rule 56a EPC is presented where current Rule 56a(2) EPC has been deleted.³⁰

Current Rule 56a(3) EPC allows an applicant to correct of own volition the description, claims and drawings (or parts thereof) *after the accordance of the date of filing*, if they were filed “erroneously”.³¹ The erroneously filed application documents will be deemed not to have been filed,³² and the correct documents will be included in

16 PCT Rule 20.5bis was adopted by the PCT Union Assembly on 09.10.2019 and entered into force on 01.07.2020. See https://www.wipo.int/meetings/en/details.jsp?meeting_id=52258 (accessed 21.07.2023).

17 See e.g., documents PCT/WG/12/9 (29.04.2019) and PCT/WG/12/24 (14.06.2019) of the PCT Working Group.

18 “Notice from the EPO dated 23 June 2022 concerning the correction of erroneous filings in proceedings before the EPO”, OJ EPO 2022, A71, in particular items 1-4.

19 OJ EPO 2022, A71, item 8 and GL/EPO (2023) A-II, 6.2: “Whether documents were erroneously filed will depend only on the applicant’s statement as to what was intended. No further evidence will be required by the EPO in this regard.”

20 Actually, the EPO will issue a communication under Rules 56(1) and Rule 56a(1). See GL/EPO (2023) A-II, 5.1 and 6.1. This is EPO Form 1114N.

21 Similar to Rule 56(1) EPC, the applicant may not invoke the omission of the invitation by the EPO.

22 If the applicant does not reply to the invitation of the EPO in due time, any filing of the correct application documents (or parts) will be deemed not to have been made and the erroneously filed application documents (or parts) will remain in the application or be restored to the application (Rule 56a(5) EPC).

23 Rule 56a(1), last sentence, EPC.

24 The so-called “same-day corrections”.

25 A similar provision can be found in PCT Rule 20.5bis(b).

26 See e.g., documents PCT/WG/12/9 (29.04.2019) and PCT/WG/12/24 (14.06.2019) of the PCT Working Group.

27 Note that the wording in Rule 56a(2) EPC: “the erroneously filed application documents or parts shall be deemed not to have been filed” is different from the wording in corresponding PCT Rule 20.5bis(b) where it is written “the erroneously filed element or part concerned shall be removed from the application”.

According to OJ EPO 2022, A71, item 15: all application documents (and parts) are considered part of the file, irrespective of whether or not they are considered to form part of the application as filed. As such they will be open to file inspection from publication of the application (Art. 128(4) and Rule 144 EPC). Upon reasoned request of the applicant, erroneously filed documents which are not considered to form part of the application as filed may be excluded from file inspection.

28 Rule 40(1) EPC.

29 PCT Art. 11(1)(iii)(e).

30 In Annex 1, the remaining paragraphs of Rule 56a EPC have been renumbered accordingly.

31 The correct application documents may be filed within a non-extendable period of two months of the date of filing (Rule 56a(3) EPC).

32 Note that the wording in Rule 56a(3) EPC: “the erroneously filed application documents or parts shall be deemed not to have been filed” is different from the wording in corresponding PCT Rule 20.5bis(c) where it is written “the erroneously filed element or part concerned shall be removed from the application”.

According to OJ EPO 2022, A71, item 15: all application documents (and parts) are considered part of the file, irrespective of whether or not they are considered to form part of the application as filed. As such they will be open to file inspection from publication of the application (Art. 128(4) and Rule 144 EPC). Upon reasoned request of the applicant, erroneously filed documents which are not considered to form part of the application as filed may be excluded from file inspection.

the application, i.e., in the application as filed. As a consequence, the date of filing will be shifted to the date of receipt of the correct application documents (or parts thereof). The applicant has to realise that a change of the date of filing may result in the loss of the right of priority.

The requirements for meeting the “completely contained” criterion in Rule 56(3) EPC have been taken over in current Rule 56a(4) EPC.³³ If the correct application documents (or parts thereof) are completely contained in the priority document, Rule 56a(4) EPC allows an applicant to maintain the initial date of filing when adding those documents or parts.³⁴ The erroneously filed application documents will *remain* in the European patent application and may only be *removed* by amending the application during proceedings up to grant.³⁵ Any removal of the erroneously filed documents during grant proceedings will be subject to the requirements for amending a European patent application under Art. 123(2) EPC.³⁶

If the applicant fails to file the correct application documents (or parts) “within the period under paragraph 3”, any – too late – filing of correct application documents (or parts) will be deemed not to have been made (Rule 56a(5)(a) EPC).³⁷ In addition, the erroneously filed application documents (or parts) will remain in the application.³⁸ The European patent application will thus proceed as originally filed, with the erroneously filed application documents (or parts) but without the correct application documents (or parts).

If the applicant fails to comply with the further requirements referred to in current Rule 56a(4) EPC³⁹ within the applicable period,⁴⁰ the European patent application pursuant to current Rule 56a(6) EPC will be re-dated to the date on which the correct application documents or parts were filed. In addition, the filing of the erroneously filed application documents or parts will be deemed not to have been made.⁴¹

In cases where the date of filing has been shifted, the applicant may withdraw the correct application documents

in order to maintain the initial date of filing (current Rule 56a(5) and (7) EPC).^{42 43 44} In that case, the European patent application will proceed as originally filed, with the erroneously filed application documents (or parts) and without the correct application documents (or parts).

Last but not least, on its introduction, a new provision was inserted into Rule 56a EPC relating to the search of the European patent application. If the applicant files correct application documents or parts under Rule 56a(3) or (4) *after* the EPO has already begun to draw up the search report, the EPO will invite the applicant pursuant to Rule 56a(8) EPC to pay a further search fee within a non-extendable period of one month.^{45 46} Note that a corresponding invitation to pay a further search fee was not present, and has also not been included, in Rule 56 EPC.⁴⁷ Presumably, this is caused by the fact that Rule 56 EPC does not allow the late-filing of missing claims and because the effect of added pages to the description were considered to not significantly affect the claimed subject-matter.⁴⁸

Following the entry into force of Rule 56a EPC on 1 November 2022, the incompatibility of PCT Rule 20.5*bis* with the

33 The formal requirements in Rule 56a(4) EPC correspond to those in Rule 56(3) EPC.

34 The priority of the earlier application must be claimed on the initial date of filing. This requirement has also been added in Rule 56(3) EPC as amended.

35 The same procedure is provided for in PCT Rule 20.5*bis*(d).

36 OJ EPO 2022, A71, items 10 and 16.

37 See GL/EPO (2023) A-II, 6.4, item (i).

38 The EPO will inform the applicant accordingly (Rule 56a(5), last sentence, EPC).

39 See GL/EPO (2023) A-II, 6.4, items (ii)-(vii).

40 Similar to Rule 56a(4) EPC, the wording of Rule 56a(6) EPC (emphasis added) “within the period under paragraph 3” is not correct. Like in Rule 56a(4) EPC, it would have been better to use a formulation in Rule 56a(6) EPC like (emphasis added) “within the *applicable* period under paragraph 3”.

41 The EPO will inform the applicant accordingly (Rule 56a(6), last sentence, EPC).

42 Rule 56a(5) EPC also applies to the situation where the applicant fails to file the correct application documents or parts within the period under Rule 56a(1) or (3).

43 In each of the situations in Rule 56a(5), (6) and (7) EPC, the EPO will inform the applicant on the outcome of the request to withdraw the correct application documents (or parts) or the re-dating of the application.

44 GL/EPO (2023) A-II, 6.5.

45 In Rules relating to Fees Art. 2(1), item 2, a reference to Rule 56a(8) EPC was added (effective 01.11.2022). If the search fee is not paid in due time, the application will be deemed to be withdrawn (Rule 56a(8), last sentence, EPC).

46 This is similar to the provision in PCT Rule 40*bis*, where the International Searching Authority (ISA) may request the applicant to pay an additional (search) fee if a missing part of a correct element or part is filed after the ISA has begun to draw up the international search report. Also see the reference to PCT Rule 40*bis* in Rules relating to Fees Art. 2(1), item 2.

47 The same applies where an applicant files missing parts or elements pursuant to PCT Rule 20.5. Although asking for a further (search) fee under PCT Rule 40*bis* applies to both the situations of PCT Rule 20.5 and 20.5*bis*, the EPO acting as ISA has chosen to ask for an additional (search) fee only in the situation where the applicant files correct elements or parts under PCT Rule 20.5*bis*, but not when the applicant files missing parts or elements under PCT Rule 20.5. This can be inferred from Art. 2(1), item 2 of the Rules relating to Fees where reference is made to PCT Rule 20.5*bis* but not to PCT Rule 20.5. Also see OJ EPO 2020 A36 and A81.

48 Note however that the addition of missing pages of the description may have a very significant impact in some cases as the search is made on the basis of the claims, with due regard to the description and drawings (if any) (Art. 92 EPC; GL/EPO (2023) B-III, 3.1). E.g., those pages may describe essential features of the invention which do not yet appear in the claims (GL/EPO (2023) B-III, 3.2), and where (at least implicitly) mention the technical problem, the application intends to solve, they need to be considered (GL/EPO (2023) B-III, 3.2.2). Also, those parts may be necessary to establish definitions of unclear terms not defined in the claims (GL/EPO (2023) B-III, 3.2.3), or to recognise that clear terms given a definition different from their usual meaning, in which case the search must take into account the definition of the terms as generally recognised in the technical field of the application (GL/EPO (2023) B-III, 3.2.4). The Guidelines do not seem to acknowledge that. Only in the situation where the application documents used for the search contain missing parts of description and/or missing drawings filed under Rule 56(3) and the search division expects the application to be re-dated by the examining division at a later stage of the procedure (see GL/EPO (2023) C-III, 1), does GL/EPO (2023) B-III, 3.3 provide that “[the search division] extends the scope of the search, such as also to cover prior art which will be relevant for assessing the novelty and inventive step of the subject-matter claimed on the basis of a possible new date of filing of the application (see also B-XI, 2.1).”

EPC legal framework has ceased.⁴⁹ For international applications filed on or after 1 November 2022, the EPO as receiving Office will process requests for incorporation by reference of the correct element (complete description, complete set of claims) or part (part of the description, part of the set of claims, some or all of the drawings) under PCT Rule 20.5bis(d).⁵⁰ If the requirements are fulfilled,⁵¹ the correct element or part will be considered to have been contained in the purported international application on the date on which one or more elements referred to in PCT Art. 11(1)(iii) were first received by the receiving Office *without* shifting the international filing date. It is noted that in this case the wrong element or part will also remain in the application.

Amendment of Rule 56 EPC

The requirements set out in Art. 5(6) PLT⁵² have to a large extent been taken over in Rule 56 EPC, allowing an applicant to include a missing part of the description or missing drawings after filing a European patent application. After receipt of the application, the EPO will first examine whether the application is entitled to a date of filing in accordance with Rule 40 EPC. If during this check, the EPO notes that a part or parts of the description or that drawings are or appear to be missing, the applicant will be invited to file the missing items within a non-extendable period of two months from the invitation (Rule 56(1) EPC).^{53 54}

According to Rule 56(2) EPC, the applicant may also file missing parts of the description or file missing drawings of own motion.⁵⁵ If the applicant files a missing part of the description or a missing drawing of own motion or upon invitation of the EPO, the application will normally be re-dated to the date on which the missing item is received by the EPO.⁵⁶

Under the amendment of Rule 56 EPC, a reference to the EPO issuing a communication under Rule 56a(1) EPC was added to Rule 56(2) EPC.⁵⁷ This allows an applicant to file

missing parts or correct application documents following either invitation of the EPO.

Rule 56(3) EPC allows an applicant to file missing parts of the description or missing drawings without loss of the date of filing initially accorded by the EPO. Redating is avoided if the missing items are completely contained in an application from which priority is claimed.

Note that the wording of Rule 56(3) EPC (emphasis added) “within *the period* under paragraph 2” is not correct. Due to the addition in Rule 56(2) EPC to an invitation from the EPO under Rule 56a(1) EPC, there are two (concurrent) periods that may be applicable. In principle, there even is a third period running, i.e., when the applicant files missing parts of own volition, but this one normally expires first. Upon amending Rule 56(3) EPC, it would have been better to use a formulation like (emphasis added) “within *the applicable period* under paragraph 2”.⁵⁸ As a solution the EPO has decided that in stead of issuing a communication under Rule 56(1) EPC and a separate communication under Rule 56a(1) EPC (as the case may be), to issue a single communication combined for Rule 56(1) and 56a(1) EPC.^{59 60}

The version of Rule 56 EPC as in force before 1 November 2022 specifies as one of the requirements for the “completely contained” criterion in Rule 56(3) EPC that “*the application claims priority of an earlier application*”. This formulation did not specify when the application must claim priority in order to avoid the re-dating when filing a missing part of the description or a missing drawing. The requirements that should be met are clear from Art. 5(6)(b) PLT stipulating that in order for a missing part of the description or a missing drawing to be retrieved from the priority application, the application:

“... at the date on which one or more elements ... were first received by the Office, claims the priority of an earlier application ...”

Note that the PCT when allowing the filing of missing parts or missing elements in PCT Rule 20.5 or the correction of erroneously filed elements or parts in PCT Rule 20.5bis, also requires that the international application must claim priority “on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office”.⁶¹

With the amendment of Rule 56 EPC, the ambiguity in Rule 56(3) EPC was repaired by stipulating that the priority claim must be made when the applicant files the European

49 Note, however, that in the period between 1 July 2020 and 31 October 2022, international applications relying on incorporation by reference by the receiving Office under Rule 20.5bis(d) PCT, i.e. without changing the filing date, will not be effective before the EPO. See e.g. GL/EPO (2023) C-III, 1.3 and E-IX, 2.9.4.

50 OJ EPO 2022, A71, item 23 and GL/PCT-EPO (2023) A-II, 6.

51 PCT Rules 20.6(b) and 4.18.

52 Also see Rule 2(3) and (4) PLT.

53 If the applicant does not reply to the invitation of the EPO in due time, all references to the missing items are deemed to be deleted (Rule 56(4)(a) EPC).

54 The last sentence of Rule 56(1) EPC stipulates that the applicant may not invoke the omission of a communication from the EPO under Rule 56(1) EPC.

55 The missing parts may be filed within a non-extendable period of two months of the date of filing (Rule 56(2) EPC).

56 If re-dating is undesirable, e.g., in view of priority, the applicant can retract the effect of the re-dating by withdrawing the missing item(s) within one month from the communication of Rule 56(2) or (5) EPC, in which case the re-dating is deemed not to have occurred (Rule 56(6) EPC). This can also be effected when later the examining division concludes that the missing parts are not “completely contained” in the priority document, contrary to the original finding of the Receiving Section (see GL/EPO (2023) C-III, 1.1.1).

57 OJ EPO 2022, A71, item 7. Also see GL/EPO (2023) A-II, 5.1.

58 Note that the wording “within the period under paragraph 2” appears twice in Rule 56(3) EPC. Also see the Annex.

59 See GL/EPO (2023) A-II, 5.1 and 6.1. EPO Form 1114N.

60 Note that the same remark applies to Rule 56(4)(a) and 56(5) EPC: following the amendment of Rule 56(2) EPC, the word “applicable” should be added where reference is made to “the period” in this provision.

61 This requirement is enshrined in PCT Rule 4.18.

patent application.⁶² This implies that Rule 56(3) EPC as in force from 1 November 2022 no longer allows adding a priority claim after the initial date of filing.⁶³

Procedural flaws in Rule 56a and Rule 56 EPC

The introduction of Rule 56a EPC is not only aimed at aligning the EPO's practice with that of the PCT, but also the result of users of the European patent system desiring to have a safety net for the rare case where an error was made when filing an application, such as when a set of claims foreseen for a different application was erroneously filed. Rule 56a EPC allows the correction of erroneously filed application documents in the initial phase of the patent grant procedure.

The purpose of introducing Rule 56a EPC and amending Rule 56 EPC as described in SACEPO WPR Document 5/20⁶⁴ is *"to align the EPC with the new PCT provision"*. However, the alignment with the PCT was not extended to allow the filing of "missing claims" as missing parts under Rule 56 EPC. The filing of missing claims is allowed under corresponding PCT Rule 20.3 (all claims missing) and Rule 20.5 (missing part of the claims). The argument that Rule 56 EPC is related to Rule 40 EPC (implementing Art. 80 EPC), and claims are not mandatory for according a date of filing, is true but then it is strange that the applicant can also file missing drawings under Rule 56 EPC whereas drawings are (also) not a requirement for the accordance of a date of filing. It seems incongruous that Rule 56a EPC, also implementing Rule 40 EPC, allows the correction of an erroneously filed set of claims. On the other hand, one may argue that Art. 5(6) PLT only addresses the topic of where "a missing part of the description or a missing drawing is filed" and "hence" there is no need to allow for the filing of missing claims under Rule 56 EPC. However, the vast majority of applicants files European patent applications together with a set of claims because when claims are filed after the date of filing, they must have a basis in the application as filed.⁶⁵ Furthermore, the preparatory documents emphasise even stronger the wish for alignment with the PCT⁶⁶ (rather than just with the PLT), but Rule 56 EPC fails to achieve that alignment in relation to missing claims. It is also observed that the preparatory documents for Rule 56a EPC repeatedly provide that *"The application documents, namely the description, drawings*

and claims, as filed on the date of filing establish the disclosure of a European patent application",⁶⁷ and that *"The application with the disclosure determined under proposed Rule 56a EPC would be considered the application as filed and would form the basis for any amendments under Article 123(2) EPC"*.⁶⁸ That this importance of the claims is reflected in the new provision for erroneous/corrected claims but not in the case of missing claims is difficult to understand.

In Annex 1 a proposal for an amended version of Rule 56 EPC is presented providing that an applicant can also file missing claims.⁶⁹ This promotes alignment with the PCT.

If current Rule 56a(4) EPC is used, the correct documents will be added to the application as filed and the erroneously filed application documents will remain in the application as filed, as in PCT Rule 20.5bis(d). However, the reason for PCT Rule 20.5bis(d) to keep both versions lies in the incompatibility with some national law/reservations of designated Offices:⁷⁰ it aims to allow, after incorporation by the receiving Office, to proceed with the relevant version in the national phases of Offices without and with reservations.⁷¹ In the EPC, there is no such "phase", there are no "reservations" and, hence, there is no need for keeping two versions of the application documents "active". Therefore, in our view, Rule 56a(4) EPC should be amended to provide that the correct part replaces the erroneously filed part, similar to Rule 56a(3) EPC, so that there is also no need for any amendment to delete the erroneous part in Rule 56a(4) EPC, as there is no such requirement in Rule 56a(3) EPC.

Further, after using Rule 56a(4) EPC the erroneously filed application documents have to be removed by amending the application during the proceedings up to grant, the



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⁶² Also see GL/EPO (2023) A-II, 5.4, item (ii).

⁶³ Note that the 2022 edition of the GL/EPO, in A-II, 5.4.1, explicitly indicated that, under the former version of Rule 56 EPC, a simultaneous request can be filed to insert a new priority claim not present when the application was filed, and to base late-filed missing parts of the description, or drawings, on that priority claim according to Rule 56(3)."

⁶⁴ "Draft Rule 56a EPC regarding correction of erroneous filings", Document 5/20 issued by SACEPO – Working Group on Rules (21.02.2020).

⁶⁵ Art. 123(2) EPC. See e.g., GL/EPO (2023) A-III, 15, B-XI, 2.2, C-III, 1.1.2 and H-IV, 2.2.4.

⁶⁶ "Erroneously filed application documents and missing parts: New Rule 56a and amendments to Rules 56 and 135 of the Implementing Regulations to the EPC and to Article 2 of the Rules relating to Fees", Document CA 4/21 (President EPO; 07.09.2021) items 6, 14 and 34 for Rule 56a EPC; CA 4/21 items 17 and 35 for the amendment to Rule 56 EPC.

⁶⁷ Document CA 4/21 (President EPO; 07.09.2021) item 8; OJ EPO 2022, A71, item 6.

⁶⁸ Document CA 4/21 (President EPO; 07.09.2021) item 18.

⁶⁹ In amended Rule 56(1) EPC in Annex 1, it is proposed to add the wording "on the date of filing" to establish the moment when any item is or appears to be missing. In addition, the word "applicable" has been inserted in Rule 56(3), (4)(a), (4)(b) and (5) EPC to avoid any ambiguity with respect to the applicable periods.

⁷⁰ See PCT Rule 20.8(a-bis) (not compatible with national law applicable by the receiving Office) and (b-bis) (not compatible with national law applicable by the designated Office).

⁷¹ "Erroneously filed elements and parts of the international application", Document PCT/WG/12/9, Comment 2 on Annex, page 11 (comment to Rule 20.5bis(d)).

amendment being subject to the standard high bar of Art. 123(2) EPC.⁷² Hence, current Rule 56a(4) EPC specifies that the erroneous documents and the correct documents together form *the application as filed* (in case of correction without a change of the date of filing in the “completely contained” situation), which is different from Rule 56a(3) EPC where the correction is done with a change of the date of filing and where the erroneously filed application documents will be deemed not to have been filed.⁷³

However, the erroneous parts may be so similar to the correct parts, that they cannot be “amended out” when they are considered also to be part of the application as filed. For example, consider a patent application relating to improvements to vehicles, such as cars. The erroneous description says, “in all embodiments of the invention, the vehicle is a car”, whereas it should have read “in an embodiment of the invention, the vehicle is a car”. In that case, the erroneous description, being part of the application as filed, would require to limit the whole application to cars, whereas the intention clearly was to cover all types of vehicles with cars just being one explicit embodiment. This cannot be the intention of filing correct parts! Further, if both the erroneously filed documents as well as the correct documents are part of the application as filed, a divisional could be directed to the erroneous embodiments – which may, at least theoretically, happen to be also valid and even more preferred embodiments. (*E.g.*, where the erroneous embodiment was a moped, and the correct one was a motor, and where the applicant later finds that his invention would also work for a moped.) In our view, Rule 56a(4) EPC should, as Rule 56a(3) EPC, specify that the erroneously filed application documents will be deemed not to have been filed and the correct documents will be added so as to replace the erroneously filed application documents, and the application as filed shall comprise the correct documents but not the erroneous ones.⁷⁴

Filing of a missing set of claims while keeping the original date of filing

In the example as described in the Introduction, it was shown how one can start with a European patent application without claims and how later on a set of claims can be filed without losing the original date of filing while avoiding problems with Art. 123(2) EPC. Of course, this was not the intention of Rule 56a(4) EPC, but the current formulation of the Rule seems to allow this.

The reason that this is possible is because Rule 56a(1) EPC defines “application documents” as being the description, claims or drawings without referring to the date on which

they are filed, and neither do Rule 56a(2), (3) and (4) EPC when referring to “the erroneously filed application documents”. Only for “the correct application documents or parts” the mentioned paragraphs relate the date on which these documents are filed, to the date of filing⁷⁵, by indicating that they are filed before or on (Rule 56a(2) EPC) or later than (Rule 56a(3) and (4) EPC) the date of filing. Further, claims may be filed later,^{76 77} so as to complete the application documents as the latter are defined in Art. 78(1)(c) EPC after the date of filing (but subject to Art. 123(2) EPC).

Effect of Rule 56a EPC on fees on filing

Rule 56a EPC⁷⁸ does not describe the effect of erroneous/correct parts on the filing fee (especially the additional fee, often referred to as ‘page fee’), and also not on the claims fees. We believe that clarification is necessary.

For example, under Rule 56a(3) EPC the correct parts *replace* the erroneously filed parts, so that one could expect that any page fees and claims fees are based on the application documents after correction. However, the period for paying the page fees runs from the filing of the first set of claims,⁷⁹ i.e., the erroneous claims, while this period for filing the correct application documents expires later (2 months), so that the correction may be filed after the page fees were already paid (albeit for the erroneously filed documents). The 2023 edition of the Guidelines confirms that,⁸⁰ where correct application documents are filed under Rule 56a EPC, the page fee is calculated on the basis of the documents present at expiry of the period under Rule 38(3) EPC; hence, the page fee may be based on the erroneous documents – which are, under Rule 56a(2) and (3) EPC deemed not to have been filed – while the further procedure will be based on the correct documents. This is undesired as it may result in the applicant paying for more pages than the ones in the application after correction if the number of pages was initially higher, or in the EPO receiving a page fee for less than the pages in the application and used for search and examination if the number of pages was initially lower.

Under Rule 56a(4) EPC, the correct parts are *added* to the erroneously filed parts. One could expect that any page fees as well as any claims fees are based on the erroneous and correct application documents together. Unfortunately, the 2023 edition of the Guidelines do not give clear guid-

⁷² OJ EPO 2022, A71, item 6.

⁷³ Rule 56a(3) EPC, OJ EPO 2022, A71, item 9.

⁷⁴ A proposal for amending Rule 56 and Rule 56a EPC is presented in Annex 1.

⁷⁵ To avoid confusion, with the wording “on the date of filing” it is meant “on the date on which the requirements laid down in Rule 40(1), were fulfilled”. Hence, the original date of filing of the European patent application.

⁷⁶ Rule 58 jo. Rule 57(c) EPC

⁷⁷ In principle, a sentence “after expiry of any period under Rule 56 paragraph 1, 2 or 3 or Rule 56a paragraph 1, 2 or 3,” could be added at the beginning of Rule 57(c) EPC.

⁷⁸ Nor any other amendment to the EPC Rules and RFees in OJ EPO 2023, A25.

⁷⁹ Rule 45(2), first sentence EPC.

⁸⁰ See GL/EPO (2023) A-III, 13.2.

ance, as they only indicate that⁸¹, where correct application documents are filed under Rule 56a(4) EPC, the page fee is calculated on the basis of the documents present at expiry of the period under Rule 38(3) EPC. However, the Guidelines do not indicate whether the documents present at expiry of the period under Rule 38(3) EPC are meant to include both erroneous as well as correct application documents, assuming that the latter were filed before the expiry of the period under Rule 38(3) EPC⁸², or only the correct ones; the wording of Rule 56a(4) EPC suggests both. However, when the correct application documents are filed after expiry of the period under Rule 38(3) EPC, the page fee would just be based on the erroneous documents only. It may be doubted whether this strange asymmetry was intentional and whether it is acceptable.

In Annex 2 a proposal for an amended version of Rule 38(2) and (3) EPC is presented clarifying the above mentioned disadvantage.⁸³

As to claims fees, the 2023 edition of the Guidelines indicates that, where correct claims are filed under Rule 56a(3) or (4) EPC, the claims fee is calculated on the basis of the set of claims *first filed*.⁸⁴ Thus, in a first example under Rule 56a(3) or (4) EPC, an erroneously filed set of claims set has 27 claims and the correct claim set has 14 claims, so that one would need to pay $27 - 15 = 12$ claims fees,⁸⁵ while less than 15 (only the 14 correct) claims are likely to be maintained in the application. However, if no claims fees would be paid, all claims above 15 would be deemed to be abandoned,⁸⁶ i.e., none of the *correct* claims would be abandoned. It may be doubted whether this is the intention of the new provisions, especially in case of Rule 56a(3) EPC where the erroneously filed application documents or parts – i.e., these 27 claims – are deemed not to have been filed, so that one would expect the claims fees to be based on the correct set of 14. In a second example under Rule 56a(3) or (4) EPC, the erroneously filed set of claims set has 2 claims and the correct claim set 31, one would not need to pay any claims fees, while all 31 claims will be maintained. It may be doubted whether this is the intention of the new provisions, especially in case of Rule 56a(3) EPC where the erroneously filed application documents or parts – i.e., these 2 claims – are deemed

not to have been filed so that one would expect the claims fees to be based on the correct set of 31 claims.

In our opinion, Rule 45 EPC should be amended to accommodate claims fee in the situation of Rule 56a(3) and (4) EPC, so that the claims fees are calculated on the basis of the set of claims that truly form the basis of the proceedings (and that will be searched), i.e., the correct set of claims, provided that this set is filed within two months of the date of filing or, within two months from a communication under Rule 56a(1) or 56(1) EPC and the other requirements of Rule 56a(3) or (4) EPC are fulfilled.

In Annex 2 a proposal for an amended version of Rule 45(2) EPC is presented clarifying the above mentioned disadvantage.⁸⁷

Effect of correcting erroneously filed application documents under PCT Rule 20.5bis(d) and entry before the EPO as designated Office

The effect of erroneous/corrections on Rule 159 EPC, Rule 161(1)/162 EPC and Rule 161(2)/162 EPC is not addressed in Rule 56a EPC,⁸⁸ nor in the Notice⁸⁹ clarifying its introduction.⁹⁰ Also the Guidelines do not provide clear guidance; the Guidelines rather indicate that *“On entry into the European phase, the normal procedures apply on the basis that the correct and erroneously filed parts are thus part of the application as filed (see E-IX, 2)”*.⁹¹ In our

87 In amended Rule 45(2) EPC in Annex 2, the basis for calculating the claims fees is given if the applicant files missing claims under Rule 56 EPC, or if the applicant files a correct set of claims (or part thereof) under Rule 56a EPC. In addition, the word “duly” has been inserted to take account of the situation that an applicant later on (but still in the filing stage) withdraws the missing claims under Rule 56 EPC, or if the applicant withdraws the correct set of claims (or parts thereof) under Rule 56a EPC.

88 Nor any other amendment to the EPC Rules and RFees in OJ EPO 2022, A3.. 89 OJ EPO 2022, A71, items 21-23.

90 Nor in the former “Notice from the European Patent Office dated 14 June 2020 concerning the applicability of new PCT Rule 20.5bis on the correction of erroneous filings in proceedings before the EPO”, OJ EPO 2020, A81, as the latter applied to the situation where the EPO as dO/eO had a reservation. Also note that under the old Notice, the EPO “will consider the application as filed to include the correct application documents but not the erroneously filed ones” (item 10). The entry procedure described therein largely relied on the incompatibility provisions of PCT Rule 20.8.

91 GL/EPO (2023) C-III, 1.3. Note that this section provides a lot of detail as to the scenarios for entry procedure during the period that the notice of incompatibility applied. When the incompatibility applies, the EPO will act in PCT Rule 20.5bis(d) cases in accordance with PCT Rule 20.8(b-bis) and (c) and PCT Rule 82ter.1(c) and (d): “on entry into the European phase, the EPO will consider the filing date of the application to be the date on which the correct application documents were received (Rule 20.8(c) PCT and Rule 20.5bis(b) or (c) PCT) in line with . Furthermore, it will consider the international application as filed to include the correct application documents but not the erroneously filed ones. The EPO will inform the applicant about this in a communication under Rules 20.8(c) PCT and 82ter.1(c) and (d) PCT.” The section also indicates that, where the incompatibility applies, the applicant may use an abridged procedure according to it, they may (within the 31-month period under Rule 159(1) EPC, at the time of validly requesting early processing or, at the latest, before the communication under PCT Rules 20.8(c) and 82ter.1(c) and (d) is issued) “(a) request that the EPO disregard the correct application documents [...] and (b) confirm that they wish to pursue the application with the filing date corresponding to the date of receipt of the correct application documents and with those correct application documents. In that case, no invitation and no interlocutory decision will be issued. The EPO will correct the filing date and consider the erroneously filed application documents not to have been filed. The applicant will be informed accordingly.”

81 See GL/EPO (2023) A-III, 13.2.

82 Or, if paid earlier, before the moment of paying, as the amount of the fee is determined by the fee levels at the moment of payment cf. GL/EPO (2023) A-X, 6.2.4.

83 In amended Rule 38(2) and (3) EPC in Annex 2, the basis for calculating the additional “page” fee is given if the applicant files missing parts of the description, missing claims or missing drawings under Rule 56 EPC, or if the applicant files correct application documents (or parts thereof) under Rule 56a EPC. In addition, the word “duly” has been inserted to take account of the situation that an applicant later on (but still in the filing stage and not during, e.g., substantive examination after an objection from the examiner that the parts were not completely contained and Rule 56a(5)-(6) and (4) or Rule 56a(6) and (7) and (5) apply) withdraws the missing parts of the description, missing claims or missing drawings under Rule 56 EPC, or if the applicant filed correct application documents (or parts thereof) under Rule 56a EPC.

84 See GL/EPO (2023) A-III, 9.

85 Rule 45(1) EPC.

86 Rule 45(3) EPC.

interpretation, the applicant is likely expected to amend the Euro-PCT application by removing the erroneously filed part and to limit to the correct documents upon entry under Rule 159(1)(b) EPC following a PCT Rule 20.5bis(d) situation. If not done upon entry, it seems likely that the applicant will be invited thereto in the communication under Rule 161(1)/(2) EPC. Further, if the entry documents contain non-searched matter at the end of the period under Rule 161/162 EPC, the EPO will issue a communication under Rule 164(1) or Rule 164(2) EPC, and during the related searches possibly a communication under Rule 62a EPC (multiple independent claims) or Rule 63 EPC (no meaningful search).

In Annex 2 an amended version of Rule 159(1)(b) EPC is presented clarifying the above-mentioned situation.⁹²

Even though it seems reasonable to expect that the applicant wishes to remove the erroneously filed documents and to limit the Euro-PCT application to the correct documents, there is nothing in the provisions that requires the applicant to do so. On the contrary, as both the erroneously filed and the correct documents are considered to be part of the application as filed under PCT Rule 20.5bis(d) (as well as in current Rule 56a(4) EPC), the applicant may still choose⁹³ at this moment with which documents to proceed: the applicant can, as long as Art. 123(2) EPC is satisfied, limit the application to just the erroneous or just the correct documents. In the below, we assume that the applicant wishes to proceed with the Euro-PCT application including the correct documents.

If the applicant amends the Euro-PCT application to only contain the correct documents at entry, i.e. before or on expiry of the period in Rule 159(1) EPC or at the date of early entry, page fees are calculated on the basis of the correct documents.⁹⁴ However, if the applicant amends at a later moment, e.g., within the Rule 161/162 period, page fees will be calculated on the basis of the total of the erroneous and correct documents, i.e., the complete international publication.⁹⁵ Non-payment of the page fees

will result in the Euro-PCT application being deemed to be withdrawn (with further processing as a remedy for 50% extra fee). Thus, timely amending may be necessary to avoid the need to pay “unnecessary” page fees, even if the erroneous documents (or parts) are not at all related to the invention and the correct documents (or parts) relate to the invention.

After entry, the applicant will receive an invitation under Rule 161/162 to file amendments, irrespective of whether amendments have already been filed or not. The application documents at the end of that period will serve as the basis for the further proceedings.

The application documents at the end of the Rule 161/162 period determine the number of claim fees. If both erroneous and correct claims are present, claims fees need to be paid for the sum of both sets. So, if, for example, an erroneous set of 34 claims was filed and a correct set of 12, a total number of $34 + 12 - 15 = 31$ claims fees must be paid. Claims over 15 for which no claim fees are paid are deemed abandoned. This leads to the strange effect that, if the erroneous set is the first set in the international publication and no amendments were filed, 19 erroneous claims plus all correct claims are deemed to be abandoned.

If the application documents at the end of the period under Rule 161/162 EPC period only comprise the correct document and parts, the Euro-PCT application will proceed as a “normal” application, with the proviso that the EPO will check whether the requirements of PCT Rule 20.5bis(d) (corresponding to those in Rule 56a(4) EPC) have been complied with, in particular the “completely-contained” criterion.⁹⁶

The EPO did not act as ISA nor as SISA

If the EPO neither acted as ISA nor as SISA in the international phase, the Euro-PCT application will go the search division. If both erroneous and correct claims are present, the search examiner will likely issue a communication under Rule 62a, 63, or 164(1) EPC, depending on the subject-matter of the claims. The search examiner will probably also object to the presence of two claim sets, and multiple claims numbered “1”, “2”, etc. If both erroneous and correct parts of the description are present, the search examiner will probably also issue a clarity objection.⁹⁷

If erroneous and correct claims relate to the same main invention, with different dependent claims, an invitation under Rule 62a EPC seems most likely. In that case, the applicant first receives an invitation which of the claims

⁹² In amended Rule 159(1)(b) EPC in Annex 2, the situation is described that if the applicant has filed correct application documents under Rule 20.5bis(d) PCT, the erroneously filed application documents (or parts thereof) will be deemed not to have been filed for the purpose of Rule 159(1)(b) EPC. If the applicant later on, in the European phase, is confronted with a re-date due to non-compliance with the “completely-contained” criterion and, in response thereto, wishes to withdraw the correct application documents, the provisions to this effect in Rule 56a EPC can be applied.

⁹³ Note that if the examiner considers that the requirements of PCT Rule 20.5bis(d) are not fulfilled, the applicant will be invited to comment and to choose with which version to continue with the erroneous ones while keeping the date, or the correct ones with a redate (PCT Rule 82ter.1(c) and (d)).

⁹⁴ GL/EPO (2023) A-III, 13.2

⁹⁵ GL/EPO (2023) A-III, 13.2: “In application of the general principles described above, for international applications comprising both erroneously filed application documents and correct application documents incorporated by reference (Rule 20.6 PCT in conjunction with Rule 20.5bis(d) PCT), irrespective of their date of filing (see OJ EPO 2020, A81 and OJ EPO 2022, A71; see also C-III, 1.3), the additional fee must be paid for all application documents contained in the international publication unless any are replaced by amendments filed on entry into the European phase, as specified by the applicant.”

⁹⁶ GL/EPO (2023) C-III, 1.3 for erroneous elements filed under PCT Rule 20.5 and C-III, 1.2 for missing elements or parts filed under PCT Rule 20.5 and 20.6.

⁹⁷ Art. 84 EPC.

are to be searched before the examiner searches the indicated claims. The applicant may then indicate the correct set of claims, and later – after receipt of the search report – amend the application to delete the erroneous claims, within the limits of Art. 123(2) EPC.

If erroneous and correct claims relate to different inventions, an invitation under Rule 64 EPC will probably be issued. In that case, the applicant first receives a partial search report directed to the first invention with an invitation to pay a further search fee to also search the second invention. If paid, the examiner will also search the second invention. The search report will then be established for both inventions and the applicant can later – after receipt of the search report – amend the application to delete the one set of claims and, if desired, file a divisional application for the other set. So, if the first invention relates to the erroneous claims and the second to the correct claims, the applicant may amend the application by deleting the erroneous claims, within the limits of Art. 123(2) EPC, and proceed with the correct claims. The strange situation may arise if the first invention is the erroneous invention and the applicant does not pay the further search fee, e.g., because the applicant does not wish to pay it because he/she considers to have corrected the initially erroneous filing such that he/she may legitimately expect that the rest of the procedure will be based on the correct claims or that he/she would at least have been invited to indicate which claims were to be searched before the search starts. In that case, the search report will only cover the first invention, defined by the erroneous set of claims, and the applicant can only proceed with the second invention, defined by the correct set of claims, via a divisional application.

The EPO acted as ISA or SISA

If the EPO acted as ISA (or as SISA) in the international phase, the Euro-PCT application will go directly to an examining division. The EPO as ISA will, usually, have established the international search report (ISR) and written opinion (WO-ISA) on the basis of the international application including the correct element(s) and/or part(s)⁹⁸ and will have checked the “completely contained” criterion⁹⁹. If both erroneous and correct claims are present, the examining division will likely issue a communication under Rule 164(2) EPC¹⁰⁰ inviting the applicant to pay a further search fee for the erroneous claims, as the erroneous claims have not been searched by the EPO as ISA. Irrespective of the payment the examining division will require the applicant

to restrict the application to a single invention in the next Rule 71(1) EPC communication.

However, the situation is somewhat surprising if the EPO as ISA was notified of correct element(s) and/or part(s) only after the search has started but before its completion, the EPO as ISA had invited the applicant to pay an additional fee equal to the search fee within one month of the date of the invitation, and the applicant had duly paid the additional fee.¹⁰¹ As above, the official ISR and WO-ISA will be established on the basis of the international application including the correct element(s) and/or part(s). However, the EPO will also complete the already initiated search and issue a *non-official* ISR and WO-ISA based on the international application as initially submitted,¹⁰² i.e. based on the erroneous claims. One could now expect, as the erroneous claims were also searched, that the examining division will not issue a communication under Rule 164(2) EPC inviting the applicant to pay a further search fee for the erroneous claims. However, as the search report and written opinion established for the erroneous claims are only a *non-official* ISR and WO-ISA, issued *only* for the benefit of the applicant and any designated Office which have notified an incompatibility under Rule 20.8(b-bis) PCT, it appears that the Rule 164(2) EPC communication will nevertheless be issued.

Amendments to remove the erroneously filed application documents or parts

For a Euro-PCT application, the application as filed is the international application as originally filed. When PCT Rule 20.5bis(d) is correctly applied, the international application as filed encompasses both the erroneously filed documents or parts and the correct documents as filed.¹⁰³ According to the OJ notices and the Guidelines, the erroneously filed documents may only be removed by amending the application during the grant proceedings and subject to Art. 123(2) EPC.¹⁰⁴ The latter requirement will most likely not be an issue if the erroneously filed documents or parts are directed to a completely unrelated invention, but the requirement may get the applicant in a trap if the erroneously filed documents and the correct documents are related, e.g., if one is an earlier version of the other and the drafter of the application was still in process of defining

98 GL/PCT-EPO (2023) B-III, 2.3.3; GL/EPO (2023) B-XI, 2.1.

99 Note GL/PCT-EPO (2023) B-III, 2.3.4: The receiving Office “may notify the ISA of correct part(s) and/or element(s) after the ISA has begun to draw up the international search report. In such cases, the EPO as ISA will invite the applicant to pay an additional fee equal to the search fee within one month of the date of the invitation (Form 208) (Rule 40bis.1 and Article 2(1) RFees).”

100 GL/EPO (2023) C-III, 3.1.

101 PCT Rule 40bis.1 in conjunction with PCT Rule 20.5bis. GL/PCT-EPO (2023) B-III, 2.3.

102 GL/PCT-EPO (2023) B-III, 2.3.4 and OJ EPO 2020 A81, item 6: “However, the non-official international search report and written opinion are issued only for the benefit of the applicant and [...] They therefore do not constitute the international search report under Rule 43 and written opinion under Rule 43bis.”

103 GL/EPO (2023) H-IV, 2.2.3 indicates that “Correct application documents or parts allowed under Rule 56a(2) and Rule 56a(4) are always considered to be part of the application documents “as originally filed” (see A-II, 6.3 and A-II, 6.4).”

104 OJ 2022, A71, item, 10. Note that, if erroneously filed application documents or parts remain in the application pursuant to Rule 56a(4) EPC, they are also part of the application as filed, and may only be removed by amending the application subject to Art. 123(2) EPC (see GL/EPO (2023) A-II, 6.4).

the invention. For example, if in an application claiming a bicycle with some special features, the erroneously filed description says “It is essential that the bicycle is an electric bicycle” while the correct description says “It is optional that the bicycle is an electric bicycle”, the strict application of Art. 123(2) EPC by the EPO will require the claims to be limited to electric bicycles because the application as filed indicated it to be essential that the bicycle is an electric bicycle. As another example, if in another application claiming a cycle with some special features, the erroneously filed description says “It is essential that the cycle is a bicycle, i.e. a cycle having two wheels” while the correct description says “It is essential that the cycle is a tricycle, i.e. a cycle having three wheels”, the strict application of Art. 123(2) EPC by the EPO will not allow any claim, as both essential elements cannot be met at the same time.

Translation errors

For a Euro-PCT application filed in another language than one of the official EPO languages, e.g. Chinese, a translation is required under Rule 159(1)(a) EPC. The translation must be a translation of the published application, and thus includes the erroneous as well as correct parts.¹⁰⁵ According to the Guidelines, it must also include an indication as to which pages relate to the correct and which to the erroneously filed application documents. The Guidelines indicate that “if, in the case of a correction of erroneously filed elements or parts under Rule 20.5bis(d) PCT by the receiving Office (see C-III, 1.3), translations of the erroneously filed application documents (in relation to items (i) to (iii) above) have not been filed” and “The EPO will invite [the applicant] to furnish the translation within a two-month period from notification of the respective communication under Rule 159(1)(a)”, with further processing being available as a remedy. Strangely enough, the Guidelines do not describe what the situation is if the erroneous parts are in the translation, but the correct parts are not.

Note that, if errors are made in translating, the translation may be brought into conformity with the application as filed, i.e., the international as originally filed in Chinese.¹⁰⁶ This seems to apply for both erroneous and correct parts.

Rule 56a EPC and European prior rights

Rule 56a EPC¹⁰⁷ does also not address the effect of erroneous/correct parts on the Art. 54(3) “prior right” effect that the European patent application may provide against later filings. In our interpretation, current Rule 56a(3) EPC suggests that only the correct documents will provide an Art. 54(3) effect, as the erroneously filed application doc-

uments will be deemed not to have been filed and the correct documents will be added to the application and considered to be part of the application as filed. This seems to be in line with the intention of the provision. However, current Rule 56a(4) EPC suggests that the erroneously filed and the correct documents *together* will provide the Art. 54(3) EPC effect, as the correct application documents or parts are included in the application and the erroneously filed parts remain in the application as filed. So, it appears that both the erroneously filed and the correct application documents are considered to be part of the application as filed and, hence, provide the Art. 54(3) EPC effect.^{108 109} On the other hand, one could argue that the skilled person can directly and unambiguously derive that there is an error and what the correction should be when considering the complete application as filed, i.e. from the combined erroneously filed and correct application documents, so that the disclosure of the erroneously filed parts is not taken into account.¹¹⁰ However, it may be doubted whether this applies if the erroneous disclosure is technically a sound disclosure and where the skilled person would need to take secondary, non-technical indications into account, i.e., when the skilled person needs to consider the procedural aspects of Rule 56a(4) EPC (as well as of PCT Rule 20.5bis(d)) rather than mere technical knowledge.

Rule 56a EPC and languages

Another issue with Rule 56a EPC is that it does not address the situation where under Rule 56a(4) EPC, the erroneously filed application documents are filed in one official EPO language and the correct application documents in another official EPO language: as both the application documents “remain” in the application, which filing will determine the language of the proceedings?¹¹¹

Rule 56 and 56a EPC and divisional applications

A question that can be asked, do Rule 56 and Rule 56a EPC also apply when filing a divisional application? It could apply to the situation where a divisional application has

¹⁰⁵ GL/EPO (2023) E-IX, 2.1.3.

¹⁰⁶ GL/EPO (2023) E-IX, 2.1.3, last paragraph and GL/EPO (2023) A-VII, 7 with reference to Art. 14(2) EPC.

¹⁰⁷ Nor any other amendment to the EPC Rules and RFees in OJ EPO 2022, A3.

¹⁰⁸ GL/EPO (2023) G-IV, 5.1: “It is important to note that it is the content of the earlier application as filed which is to be considered when applying Art. 54(3).”

¹⁰⁹ GL/EPO (2023) G-IV, 5.1.2: Addresses the situation where “the prior art considered by the examiner might comprise documents (European or international patent applications) for which the accorded date of filing and the content of the application on the filing date may still be under review before the EPO”, e.g., due to missing or erroneous part procedures. “The content of the application determined according to Rules 56 or 56a EPC or Rules 20.5, 20.5bis or 20.6 PCT is considered as the content of the application as filed within the meaning of Art. 54(3) EPC. Note that under Rule 56a(4) EPC and Rule 20.5bis(d) PCT, the erroneously filed application documents or parts remain in the application (see A-II, 6.4 and PCT-EPO Guidelines A-II, 6.2)”. This section confirms that Rule 56a(4) EPC and Rule 20.5bis(d) PCT, the Art. 54(3) effect includes both correct as well as erroneous parts.

¹¹⁰ Following the principles set out in GL/EPO (2023) G-IV, 9 “Errors in prior-art documents”.

¹¹¹ Cf. Decision of the Enlarged Board of Appeal G 4/08, OJ EPO 2010, pp. 572-597.

been filed, but a page of the description is missing or the wrong drawing(s) have been filed, and where this missing or correct part is present in the direct parent application. Under the current formulation of Rule 56/56a EPC, this cannot be done, because the “parent application” is not the “priority application”.

It is proposed to amend Rule 56 and 56a EPC to also apply to the filing of divisional applications with erroneously filed application documents (or parts thereof) where any missing or correct part is completely contained in the direct parent application.¹¹²

Rule 56a EPC and file inspection

An important issue when filing correct application documents under Rule 56a EPC is that even if the erroneously filed application documents are withdrawn under Rule 56a(5) or (7) EPC (e.g. to maintain the priority claim), these erroneously filed application documents will be part of the

file, irrespective of whether or not they are considered to form part of the application as filed. As such they will be open to file inspection from publication of the application.¹¹³ Upon a reasoned request of the applicant, erroneously filed documents which are not considered to form part of the application as filed may be excluded from file inspection.¹¹⁴

No more time traveling with Rule 56a EPC as amended

In order to close the “time travel” loop in Rule 56a EPC, the wording of current Rule 56a(3) EPC should be amended such that correct application documents can only be filed if the erroneously filed application documents were filed on the date of filing, and not through a backdoor (see the Introduction to this article) by filing first an unrelated “missing” claim and later on replace this “erroneous” claim by a “correct” set of claims contained in the priority document.

A formulation to this end can be found in the proposal for amended Rule 56a(3) EPC in Annex 1 (note that this paragraph has been renumbered to become Rule 56a(2) EPC).

¹¹² A solution could be to introduce Rule 56b EPC specifying that Rules 56 and 56a EPC apply *mutatis mutandis* to divisional applications with the proviso that “the date of filing” is replaced by “the date on which the divisional application is filed” and references to claiming priority from an earlier application as well as to Rule 40(1) EPC are deleted. The missing parts or the correct application documents should be completely contained in the (immediate) parent application. Filing a copy and/or a translation of the parent application as required by Rule 56(3) and Rule 56a(4) EPC would not be necessary, except in the exceptional situation that no translation of the parent has yet been filed on the date on which the divisional application is filed.

¹¹³ Art. 128(4) and Rule 144 EPC.

¹¹⁴ Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3.

Conclusions

On 1 November 2022, Rule 56a EPC was inserted into the EPC allowing the correction of erroneously filed application documents (or parts thereof). Rule 56a EPC corresponds to a similar provision in PCT Rule 20.5*bis* (in force since 1 July 2020). Also on 1 November 2022, Rule 56(3) EPC was amended improving alignment with requirements of the Patent Law Treaty and the PCT. Both Rules require that, in order to retain the initially accorded date of filing due to the filing of missing parts or correct application documents being “completely contained” in the earlier application, priority must have been claimed from this earlier application on the initial date of filing of the application. With the amendment of Rule 56 EPC and the introduction of Rule 56a EPC, the situation will be less flexible for applicants because priority may no longer be added e.g. when missing parts or correct application documents are filed. Rule 56 and 56a EPC emphasise the importance of declaring priority of any relevant earlier applications on the initial date of filing.

In its striving to improve alignment of the EPO’s practice with the PCT, it is a missed opportunity not to allow an applicant under Rule 56 EPC to also file missing claims so that those can become part of the application as filed. There is no logic in allowing the correction of erroneously filed claims under Rule 56a EPC whereas the filing of missing claims is not allowed under Rule 56 EPC.

Last but not least, upon inserting Rule 56a EPC and amending Rule 56 EPC, some inconsistent wording has been introduced in both Rules and the effect on some other aspects (e.g. calculation of page fees and claims fees, language of the proceedings, effect of Art. 54(3) EPC and Euro-PCT applications) is missing. Only some (page fees, claims fees), but not all of these other aspects are addressed in the 2023 edition of the Guidelines. It is suggested to clarify these ambiguities and unclarity in a later edition of the Guidelines.

In addition, it is advocated to amend Rule 56 and 56a EPC, or to introduce an analogue Rule 56b, to also apply to the filing of divisional applications with erroneously filed application documents (or parts thereof) where any missing or correct part is completely contained in the direct parent application.

In Annex 1 proposals to amend Rules 56 and 56a EPC are given. In Annex 2, proposals to amend Rules 38, 45 and 159 EPC are presented resolving unclarity in these Rules caused by Rule 56 and 56a EPC.

ANNEX 1 – Proposal for amended texts of Rule 56 and 56a EPC

Rule 56 EPC – Missing parts of the description, *missing claims* or missing drawings

- (1) If the examination under Article 90, paragraph 1, reveals that **on the date of filing** parts of the description ~~or missing drawings referred to in the description or in the claims~~, appear to be missing, **or claims or drawings appear to be missing**, the European Patent Office shall invite the applicant to file the missing parts within two months. The applicant may not invoke the omission of such a communication.
- (2) If missing parts of the description, **missing claims** or missing drawings are filed later than the date of filing, but within two months of the date of filing or, if a communication is issued under paragraph 1 or under Rule 56a, paragraph 1, within two months of that communication, the application shall be re-dated to the date on which the missing parts of the description or missing drawings were filed. The European Patent Office shall inform the applicant accordingly.
- (3) If the missing parts of the description, **the missing claims** or **the** missing drawings are filed within the applicable period under paragraph 2, and the application claims priority of an earlier application on the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, the date of filing shall, provided that the missing parts of the description, **the missing claims** or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, where the applicant so requests and files, within the **applicable** period under paragraph 2:
 - (a) a copy of the earlier application, unless such copy is available to the European Patent Office under Rule 53, paragraph 2;
 - (b) where the earlier application is not in an official language of the European Patent Office, a translation thereof in one of these languages, unless

such copy is available to the European Patent Office under Rule 53, paragraph 3; and

- (c) an indication as to where the missing parts of the description, **the missing claims** or the missing drawings are completely contained in the earlier application and, where applicable, in the translation thereof.
- (4) If the applicant:
 - (a) fails to file the missing parts of the description, **the missing claims** or the missing drawings within the **applicable** period under paragraph 1 or 2,
 - or
 - (b) withdraws under paragraph 6 any missing part of the description, **any missing claim** or **any** missing drawing filed under paragraph 2,

any references referred to in paragraph 1 shall be deemed to be deleted, and any filing of the missing parts of the description, **the missing claims** or **the** missing drawings shall be deemed not to have been made. The European Patent Office shall inform the applicant accordingly.
- (5) If the applicant fails to comply with the requirements referred to in paragraph 3(a) to (c) within the **applicable** period under paragraph 2, the application shall be re-dated to the date on which the missing parts of the description, **the missing claims** or **the** missing drawings were filed. The European Patent Office shall inform the applicant accordingly.
- (6) Within one month of the notification referred to in paragraph 2 or 5, last sentence, the applicant may withdraw the missing parts of the description, **the missing claims** or the missing drawings filed, in which case the re-dating shall be deemed not to have been made. The European Patent Office shall inform the applicant accordingly.

Rule 56a EPC – Erroneously filed application documents or parts

- (1) If the examination under Article 90, paragraph 1, reveals that **on the date of filing** the description, claims or drawings, or parts of those application documents, appear to have been erroneously filed, the European Patent Office shall invite the applicant to file the correct application documents or parts within two months. The applicant may not invoke the omission of such a communication.

- ~~(2) If correct application documents or parts referred to in paragraph 1 are filed on or before the date of filing so as to correct the application, those correct application documents or parts shall be included in the application and the erroneously filed application documents or parts shall be deemed not to have been filed. The European Patent Office shall inform the applicant accordingly.~~

[Because Rule 56a(2) EPC has been deleted, the other paragraphs of Rule 56a EPC are renumbered accordingly]

- (2) If correct application documents or parts **to correct erroneous application documents filed on the date of filing**, referred to in paragraph 1 are filed ~~later than the date of filing, but~~ within two months of the date of filing or, if a communication is issued under paragraph 1 or under Rule 56, paragraph 1, within two months of that communication, the application shall be re-dated to the date on which the correct application documents or parts were filed. The correct application documents or parts shall be included in the application **as filed** and the erroneously filed application documents or parts shall be deemed not to have been filed. The European Patent Office shall inform the applicant accordingly.
- (3) If the correct application documents or parts are filed within the **applicable** period under paragraph 2, and the application claims priority of an earlier application on the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, the date of filing shall, provided that the correct application documents or parts are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, where the applicant so requests and files, within the **applicable** period under paragraph 2:
- (a) a copy of the earlier application, unless such copy is available to the European Patent Office under Rule 53, paragraph 2;

- (b) where the earlier application is not in an official language of the European Patent Office, a translation thereof in one of these languages, unless such copy is available to the European Patent Office under Rule 53, paragraph 3; and

- (c) an indication as to where the correct application documents or parts are completely contained in the earlier application and, where applicable, in the translation thereof.

If these requirements are fulfilled, the correct application documents or parts shall be included in the application **as filed** and the erroneously filed application documents or parts shall ~~remain in the application~~ **be deemed not to have been filed**.

- (4) If the applicant:

- (a) fails to file the correct application documents or parts within the **applicable** period under paragraph 1 or **2**,
or
(b) withdraws under paragraph 6 any correct application documents or parts filed under paragraph 2,

any filing of the correct application documents or parts shall be deemed not to have been made and the erroneously filed application documents or parts shall remain in the application or be restored to the application. The European Patent Office shall inform the applicant accordingly.

- (5) If the applicant fails to comply with the requirements referred to in paragraph 3(a) to (c) within the **applicable** period under paragraph 2, the application shall be re-dated to the date on which the correct application documents or parts were filed. The filing of the erroneously filed application documents or parts shall be deemed not to have been made. The European Patent Office shall inform the applicant accordingly.
- (6) Within one month of the notification referred to in paragraph 2 or 5, last sentence, the applicant may withdraw the correct application documents or parts filed, in which case the re-dating shall be deemed not to have been made. The European Patent Office shall inform the applicant accordingly.
- (7) If the applicant files correct application documents or parts under paragraph 2 or 3 after the European Patent Office has begun to draw up the search report, the European Patent Office shall invite the applicant to pay a further search fee within one month. If the search fee is not paid in due time, the application shall be deemed to be withdrawn.

ANNEX 2 – Other Rules that require change upon amending Rule 56 and Rule 56a EPC

Where in the proposed amendments of the Rules in this Annex reference is made to Rule 56a EPC, account is taken of the deletion of Rule 56a(2) EPC and the subsequent renumbering of Rule 56a EPC as proposed in Annex 1.

Rule 38 EPC – Filing fee and search fee

[Rule 38(1): no change]

- (2) The Rules relating to Fees may provide for an additional fee as part of the filing fee if the application comprises more than 35 pages.

If the applicant duly filed missing parts of the description, missing claims or missing drawings pursuant Rule 56, paragraph 2 or 3, the additional fee shall be based on the number of pages including the missing parts of the description, missing claims or missing drawings. If the applicant duly filed correct application documents or parts thereof pursuant Rule 56a, paragraph 2 or 3, the additional fee shall be based on the number of pages including the correct application documents or parts thereof; the erroneously filed application documents or parts thereof are to be discarded.

- (3) The additional fee referred to in paragraph 2 shall be paid within one month of filing the European patent application or one month of filing the first set of claims or one month of filing the certified copy referred to in Rule 40, paragraph 3, ***or one month of filing any missing parts of the description, missing claims or missing drawings pursuant Rule 56, paragraph 2 or 3, or one month of filing any correct application documents or parts thereof pursuant Rule 56a, paragraph 2 or 3, whichever period expires last.***

If the applicant duly filed missing parts of the description, missing claims or missing drawings pursuant Rule 56, paragraph 2 or 3, or correct application documents or parts thereof pursuant Rule 56a, paragraph 2 or 3, any additional fees paid based on the incomplete or erroneously filed application documents and in excess of those due after the filing of the missing parts of the description, missing claims or missing drawings or the correct application documents or parts thereof shall be refunded.

[Rule 38(4) EPC: no change]

Rule 45 EPC – Claims incurring fees

[Rule 45(1): no change]

- (2) The claims fees shall be paid within one month of filing the first set of claims. If the claims fees have not been paid in due time, they may still be paid within one month of a communication concerning the failure to observe the time limit.

If the applicant duly filed missing claims pursuant Rule 56, paragraph 2 or 3 to obtain a complete set of claims, the claims fees shall be based on the complete set of claims and shall be paid within one month of filing the missing claims.

If the applicant duly filed a correct set of claims pursuant Rule 56a, paragraph 2 or 3, the claims fees shall be based on the correct set of claims and shall be paid within one month of filing the correct set of claims.

If the applicant duly filed missing claims pursuant Rule 56, paragraph 2 or 3 or a correct set of claims pursuant Rule 56a, paragraph 2 or 3, any claims fees paid based on the incomplete or erroneously filed application documents and in excess of those due after the filing of the missing claims or the correct set of claims shall be refunded.

[Rule 45(3) EPC: no change]

Rule 159 EPC – The European Patent Office as a designated or elected Office – Requirements for entry into the European phase

[Rule 159(1)(a) EPC: no change]

- (b) specify the application documents, as originally filed or as amended, on which the European grant procedure is to be based;
if correct application documents have been duly filed under Rule 20.5bis(d) PCT, the erroneously filed application documents or parts thereof shall be deemed not to have been filed for the purpose of this paragraph; Rule 56a, paragraphs 5 and 6 shall apply mutatis mutandis;

[Rule 159(1)(c)-(h) and (2) EPC: no change]

First experiences with the UPC system

Prof. Dr. A. Hüttermann, Michalski Hüttermann & Partner, Düsseldorf

After three months of entry into force, many users have made their first experiences with the UPC system. In this article I will give an overview as well as some (strictly personal) impressions on the UPC system as it presents itself so far.

1. „opt-outs“

Many colleagues – and my firm is no exception – have had busy times organizing the preemptive “opt outs” according to Rule 5.12 UPC. This started from informing the clients about the UPC system and their possibilities, organizing feedback and finally timely registering the preemptive “opt-outs” with the UPC.

The difficulties in this process were manifold, starting with the identification of the IP rights that could be opted out, answering the numerous questions that arose from the clients, the registration in the CMS system of the UPC – which is necessary to file the “opt-out” – and finally the actual application for the “opt-out”, where many colleagues will have used service providers.

In particular, the difficulties concerning the registration with the CMS system of the UPC led, as is known, to the fact that the start of the whole system was delayed by two months. For quite a while, it was even unknown from which company accepted security cards could be obtained at all – and when the corresponding list was finally published, not many were surprised at the small number of providers, who in turn often had problems coping with the applications that were rushing at them.

In the meantime, however, significantly more providers have joined the list, but registration with CMS is still anything but simple and often relatively time-consuming.

According to the data at hand, approximately 500.000 “opt-outs” were registered during the so-called “sunrise-phase”, i.e. the time when the UPC had started to accept such requests and the opening on 1 June 2023,¹ which would be a third of all “opt-outable” patents, which is estimated to be 1,5 million.² I will leave it to the reader to decide whether in view of the relatively low numbers of unsolicited nullity actions (cf. part 3) all of this was a bit of “*Parturient montes, nascetur ridiculus mus*”...

1 Cf. eg <https://patentepi.org/r/info-2303-01> (note that probably not all “opt-outs” that were filed before 1 June were registered already by the court, so the number of 500,000 seems more realistic)

2 Source: Klaus Grabinski, lecture at the VPP Frühjahrstagung in Dresden, 4 May 2023. Please note that other sources (e.g. the Kluwer Patent Blog) come to different numbers.

2. Unitary Patents

As is generally known, there had also been the possibility of early application for unitary patents, as well as applications that ensured that the publication of the grant would only take place after the system had come into force. Statistical data on Unitary Patents is available on the EPO’s “Unitary Patent Dashboard”³ and according to said dashboard, already in January the first of said requests for unitary patent protection were filed. The numbers, however, start to rise only from June on, when the UPC came into force. At the time of writing of this article (8 August 2023), 6021 requests for Unitary Patents were received at the EPO, with 5784 already accepted.

Unfortunately, the EPO does not provide figures on how many conventionally validated patents were applied for in the same period. When considering how to classify these figures, it helps to keep in mind that according to the 2022 Annual Report, 81754 were granted by the EPO in 2022, i.e. about 6800 per month. If one assumes – by way of a rough estimate – that approx. 14,000 patents should have been granted in the period from June onwards and neglects the applications up to then, one arrives at a quota of approx. 40%, which only can be called a success, taking into account that before the introduction of the UPC more than 70% of all validated patents were validated in Germany, France and the UK only and the UK does not form part of the UPC system.

When taking a closer look at the data available, it is interesting to see that three fields, i.e. “Infrastructure and Mechanic”, “Health” and “Materials and Production”⁴ lead the areas where Unitary Patents are requested, with approx. 20% each.

Quite striking is the nationality of applicants that request Unitary Patents. Here Europe clearly is way ahead, Germany with 1207 patents being the most Unitary-Patent-savvy country. Interestingly, the US with 880 patents also takes interest, whereas Asia so far avoids Unitary Patents – it is interesting that there are more unitary patents from Sweden (301) than China (298), more from Denmark (252) than Japan (184) and more from Finland (140) than South Korea (123) although for each of these pairs the number of patent grants is quite the opposite.

3 Available here: <https://patentepi.org/r/info-2303-02>

4 Unfortunately the EPO does not precisely state, which IPC classes it subsumes under these fields

Finally some language observations: The distribution of procedural languages of the European patents for which Unitary Patents were filed more or less follows the overall distribution with English being 71%, German 22% and French 7%. For the latter two an English translation is necessary and thus of course English has the major share of the language used as the translation for informational purposes according to the EU 1260/2012. Spanish with 28% and German with 21% follow, all other languages have lesser importance. The large number of Spanish translations does not surprise – Unitary Patents are often sought after for patents where a large territorial coverage is needed and then often either a validation into Spain, where a translation is mandatory, is conducted in parallel or a parallel application in a Spanish speaking country in Latin America, prominently Mexico, exists (or both); thus it is only efficient to use the Spanish text that is needed for other purposes anyway.

3. The UPC

In contrast to the relatively decent figures for unitary patents, the Unified Patent Court has not yet really taken off. According to the CMS, at the time of writing 37 cases are pending before the UPC, two of them applications for preliminary measures and five unsolicited nullity actions. These numbers, however, seem not be fully accurate – complaints about the usability of the CMS and electronic register are everywhere – and some cases not in the list, but it is a fair assumption to say that in the first two months of establishment less than 50 cases were filed, i.e. about 25 per month.

This is more than the UK received in 2022 (with 35 cases)⁵ but considering that 373 new infringement suits were filed in Düsseldorf alone in 2022, i.e. 31 per month, the figures are somewhat sobering.

Not surprising, the center of the action is Germany with 24 out of the 33 cases where the plaintiff had a choice (= which are not unsolicited nullity actions which need to be filed at the central division). What is to some extent unexpected is that Munich is the local division with the most cases so far, followed by Mannheim and then Düsseldorf. For German litigation cases Düsseldorf receives more cases than the other two combined, so one would have expected a bigger share of the cake to go there. Reasons for this are presumably two-fold:

- Judge *Pichlmaier*, one of the judges of the chamber of the Landgericht München I, who was responsible for the famous CJEU referral C-44/21 concerning preliminary injunctions, is one of the presiding judges at the Munich division. Therefore it is not surprising

that – in the expectation that the Munich division would take a more lenient (or as others say: less ideologic) view concerning the requirements on the validity of a patent – applications for provisional measures were filed there. The first order of the Düsseldorf division (cf. later) surely has the potential to change this practice in the future, however.

- A non-neglectable share of patent infringement cases that were filed involve FRAND terms. Here the Munich (and also Mannheim) courts in recent German patent litigation were seen by many as being more patent-owner friendly as their Düsseldorf counterpart, so this is suspected to be another reason why plaintiffs chose Munich (and to a lesser degree Mannheim) over Düsseldorf.

From what is known, the UPC has seen its first settlements already (three parallel cases in automation technology).⁶ More interesting are the first final orders already issued by the court and here the Milan and Düsseldorf division were involved.⁷

In Milan⁸ the division issued two inspection orders – both of them by the same applicant and based on the same patent but against two different competitors – in the context of a trade fair. The orders, as also set out in the rules, largely follow the “Düsseldorf Procedure” known by the German courts,⁹ i.e. (summarized) that an expert (here an engineer based in Milan) would help the bailiff to inspect certain machines and that this expert would later on write an expert report that could – unless the court decides otherwise – only be seen by the attorneys and one person from the applicant, but a strict NDA and prohibition to use this information for other purposes would apply.

Noteworthy is that both orders were issued one day after they were requested and without hearing the other party, i.e. *ex parte*.

More noteworthy is maybe the first ever *ex-parte* preliminary injunction order by the UPC, issued by the Düsseldorf division.¹⁰ Here especially the following seems interesting:

- The injunction was issued *ex-parte*, which is insofar remarkable that in all other preliminary injunction cases of which further details are known the other party was involved and oral hearings were summoned. However, same as with the Milan cases, the request was made in the context of a trade fair and

⁵ Source: <https://patentepi.org/r/info-2303-03> also for the Düsseldorf cases

⁶ <https://patentepi.org/r/info-2303-04>

⁷ A more detailed discussion of these orders will be published in GRUR Patent – albeit in German – in a separate article

⁸ UPC_CFL_127/2023 of 13 June 2023 and UPC_CFL_141/2023 of 14 June 2023

⁹ Cf. *Hüttermann*, Unitary Patent and Unified Patent Court, 1st edition, Wolters Kluwer 2023, para 1530 et seqq.

¹⁰ UPC_CFL_177/2023 of 22 June 2023

there had been a *saisie* (albeit not with the UPC, but in Switzerland), a warning letter and a protective letter with the UPC. Said protective letter, however, had been sent to the other party on the same day as the request was filed – which was remarkably issued on that very same day, 22 June 2023, as well.

- The patent was deemed to have sufficient legal validity, although no opposition or nullity action had been filed against it, which is somewhat against the Düsseldorf tradition that – following the “Harnkatheterset” decision¹¹ – requires such a procedure or otherwise sufficient indication that the validity of the patent is beyond doubt. The fact that the patent had been issued in 2015 with no following opposition or nullity and that the opposing party had raised no validity doubts in its protective letter was obviously considered sufficient.
- A request directed to “all countries of the UPC where the patent is in force” was not allowed, only a request directed to “Germany, Netherlands, France and/or Italy”. Here, interestingly, the applicant (as he later admitted) made a mistake: The patent was also in force in Austria, but that was forgotten to be requested. A later application to correct the first order via a correction according to Rule 353 was, however, denied by the UPC.¹²

11 OLG Düsseldorf, InstGE 12, 114 – Harnkatheterset, cf also *Böhler*, GRUR 2011, 965 and OLG Düsseldorf, Decision vom 30.9.2010 – I-2 U 47/10 – Gleitsattelscheibenbremse II, cf also *Hüttermann*, Unitary Patent and Unified Patent Court, 1st ed. Wolters Kluwer 2023, para 1501 et seqq.

12 UPC_CFI_177/2023 of 30 June 2022

From a practical point of view the CMS and IT system of the UPC is widely reported to have its difficulties and inconveniences, interesting not only for the users, but also for the judges.¹³ Especially the fact that also the judges are not entirely happy with the way the IT works gives hope that improvements are on their way.

4. Summary

In summary, the unitary patent system has seen an excellent start (as far as unitary patents are concerned) and a somewhat slower beginning (as far as the Unified Patent Court is concerned). It has not completely failed as many had feared, however the difficulties at the end of the “sunrise period” were unmistakable and the CMS system like the Register is in urgent need of overhaul. If the Unified Patent Court is to become the most important patent court in the world, as many assume, there is still a lot to be done – but the court has not even been in office for the famous 100 days yet. In any case, the decisions known so far generally point in the right direction.

13 Cf. personal discussion of the author with Hon. Judge Peter *Tochtermann* in the context of the 2nd VDI/VPP-Seminar on the Unitary Patent System on 20 June 2023

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A view on 20 years of Biotech patenting in Europe

A. De Clercq, PhD, ex-Chair **epi** Biotech Committee

As a (now) ex-chair¹ of the **epi** Biotech Committee and for many years a practitioner in this field, it is a privilege to report on the last two decades of biotech patenting at the EPO and in general in Europe. Some major changes and developments have occurred in this field. In the early days of biotech patenting in Europe it was debated whether living organisms and certain types of biotechnological inventions could be patented. In 1998, the European Union adopted the

Biotechnology Directive (Directive 98/44/EC), which aimed to harmonize patent laws in the EU member states concerning biotechnological inventions.



Ann De Clercq

Over the past 20 years, several landmark biotech patent cases have been decided by the EPO. In the field of **animal patenting**, Technical Board of Appeal decision **T315/03** (Harvard Oncomouse) was issued,

relating to morality under Art. 53(a) EPC and R. 23d(d) EPC. For many years we debated a lot on **patents on stem cells**. An Amicus Curiae brief was filed by **epi** in 2006 in the Enlarged Board of Appeal (EBA) case **G2/06** (WARF). In 2011, the EPO's policy was that the morality exclusion could be overcome if one can refer to a public human embryonic stem cells (hESC) cell line deposited after May 2003. In 2012, the EPO examiners followed the instructions given in the Guidelines which came into force in June 2013.

In 2012, EPO had a new policy on stem cell patenting. The EPO had, to a significant extent, followed the CJEU Brüstle decision. The previous policy of there being a threshold in 2003, depending on whether stem cells were deposited or not, had been scrapped as a new threshold date, 10/01/2008, concerning the publication of the single blastomere biopsy process (SBB) came into the picture. The interpretation of the CJEU Brüstle decision by the German Federal Court of Justice (BGH) is different than the EPO interpretation. The **epi** filed Third Party Observations in 2012 in the Brüstle EP patent opposition case requesting the Opposition Division to consider

also the Brüstle decision of the BGH relating to the equivalent German Brüstle patent. In summary, stem cell patenting has undergone many changes and reviews.

In 2010 the ECJ Monsanto Decision relating to a product (the DNA sequence) which forms part of a material (soy meal) and does not perform its function came out. This mainly concerned infringement, and the scope of downstream product claims. It was not well reasoned and so there remains a question mark over whether this decision will exclude all situations where the gene is inactive from infringement. Other **national decisions** in the Biotech field were also often a centre of debate, such as the UK *HGS v Lilly* case.

The **epi** also has filed **amicus briefs** in US cases such as in 2013 in the US Myriad case before the US Supreme Court supporting a previous declaration of Prof. Strauss filed in this case and supporting the patentability of human genes. The **epi** filed a **Third-Party Observations** in 2012 in the Brüstle EP patent opposition case requesting the Opposition Division to consider also the Brüstle decision of the BGH relating to the equivalent German Brüstle patent.

In 2013, the US Supreme Court issued the "Myriad" decision concerning the **patent eligibility of human genes** in the United States. The *Myriad* and the *Mayo vs. Prometheus* decisions from the US are very controversial and caused a lot of discussion in the US. The EPO did not follow the same lines of thought and sticks to its long-lasting practice of dealing with the patentability of gene and diagnostic method inventions. The EU Biotech Directive has an advising role on the EPO's practice.

Plant biotech patent law was (and is) also heavily debated in Europe. According to the current version of the EPC, plant varieties and essentially biological processes to produce plants, and the products exclusively obtained therefrom, are not patentable. However, it is essential to note that there was a period of uncertainty regarding this exclusion and over the years plant patentability changed a lot.

EBA decisions **G2/07** and **G2/08** (Tomatoes and Broccoli) relating to Art. 53(b) EPC, effectively said that the breeding methods for plants that involve sexual selection are

¹ Since 19 July 2023 Mr. Simon Wright succeeded Ms. De Clercq as chair of the **epi** Biotech committee

excluded. On these cases a second referral was done to the EBA: decisions **G2/12** and **G2/13** (Tomatoes II and Broccoli II) afterwards clarified that product claims or product-by-process claims directed to plants or plant material other than a plant variety are not excluded from patentability under Art. 53 (b) EPC and are allowable if they fulfill the formal and substantive requirements of the EPC. These decisions confirmed that exclusions to patentability must be construed narrowly. The EPO Guidelines were amended in this way. On 3 November 2016, the EC issued a notice on certain articles of the Biotech Directive 98/44/EC suggesting that the Biotech Directive should be interpreted to exclude plant products. On 24 November 2016, the EPO issued a notice informing that they would stay the proceedings of certain cases due to the Commission Notice of 3 November 2016. Such a stay was unprecedented at the EPO. As of 1 July 2017, Rules 27 and 28 EPC were amended and apply since then to European patent applications filed on or after this date, as well as to European patent applications

and European patents pending at that time. In **T1063/18**², the Board had found the new R. 28(2) EPC, excluding plants or animals exclusively obtained by means of an essentially biological process from patentability, to contradict Art. 53(b) EPC and its interpretation thereof by the EBA in cases **G2/12** and **G2/13**. This was very much welcomed by the plant industry professionals. A referral was made to the EBA again now by the President of the EPO. **G3/19** issued on 14 May 2020 and this opinion³ (so not a decision) explicitly abandoned earlier EBA decisions **G2/12** (Tomatoes II) and **G2/13** (Broccoli II), as it now held that plants and animal products exclusively obtained by essentially biological processes are not patentable. The EBA considered in G 3/19, the referral admissible and advanced a new interpretation of Art. 53(b) EPC in line with the amended R. 28(2) EPC and related developments. Applying a dynamic method of

² <https://patentepi.org/r/info-2303-13>

³ <https://patentepi.org/r/info-2303-14>



interpretation, having regard to the wording of the new R. 28(2) EPC and the *travaux préparatoires* for that Rule, the EBA accepted that it was the EPC legislator's intention to establish a particular interpretation of Art. 53(b) EPC, which is that plants or animals exclusively obtained by means of an essentially biological process are excluded from patentability. The **epi** had suggested in their amicus curiae brief⁴ to establish transitional measures to protect the legitimate expectations established by the EBA's earlier decisions. The EBA noted that its new interpretation of Art. 53(b) EPC has no retroactive effect on European patents containing such claims which were granted before 1 July 2017, when R. 28(2) EPC entered into force, or on pending European patent applications seeking protection for such claims which were filed (or have a priority filing date) before that date. This opinion is still controversial and was commented on by many practitioners as being very much influenced by political inspiration.

The Biotech Committee also followed the national developments and updated overviews of the patentability of plants in the member states based on reactions of the members in each country (see <https://patentepi.org/r/patentability-of-plants>).

Plant patent specialists are mainly concerned about the need for **plant disclaimers** according to the Guidelines. **G3/19** does not say anything about the need for disclaimers. At the SACEPO WP Guidelines meetings, **epi** biotech practitioners yearly reiterate to the EPO their concerns about the current need for **plant disclaimers** for which **epi** holds there is no legal basis. We regret at this moment no changes are being considered in the Guidelines. We may also expect future Technical Board of Appeal cases on this topic. **epi** would like already for many years to understand where the basis is in R. 28(2) for a disclaimer requirement. A disclaimer would appear to introduce legal uncertainty for applicants, because the scope of what is disclaimed, and how national courts or the UPC will interpret the coverage of the remainder of the claim remain to be seen, particularly in the light of various definitions of "essentially biological processes" or "exclusively obtained by essentially biological processes". The EPO confirmed disclaimers are not needed for genetically modified transformed plants and gene edited plants (created by CRISPR technology), provided the latter can be distinguished from natural variation and are not needed for offspring and propagatable parts of said plants. EPO explained that it is up to the applicant to show that it does not relate to a plant produced by an essentially biological process. EPO explained they consider what kind of exchanges are known for the plant in question

and depending on the plant make an objection or not. Recent discussions are regularly reported on in **epi** information by the **epi** Biotech Committee.

Antibodies have also been a field of heavy debate, changes and high importance in the field of biotech. Years of discussions between **epi** and EPO and amongst practitioners have happened and the most recent evolutions were reported on in our recent committee reports in **epi** information. The Guidelines need to be very carefully drafted and reflect the Case Law as they are also being referred to in national court cases. It is desired to have more interaction with the **epi** practitioners when draft Guidelines are made (also in the other Biotech areas). The antibody patenting Guidelines were a long time not public but have been inserted into the Guidelines now since 2020.

In general, the EPO Guidelines are updated yearly. Antibodies, **G3/19** and plant disclaimers as well as exclusions for stem cells parts were added and amended, and new paragraphs added also as well as a new part on homology, similarity, identity of genes and protein sequences, all in 2020. The biotech aspects of the Guidelines are from then also under yearly review after the SACEPO WP GL meetings. Maintaining high quality Guidelines is essential.

For more than a decade, the Biotech Committee has been also very involved in all discussions on Sequence listings, and we went from the incorporation of ST.25 to ST.26 WIPO Standard for Sequence Listings which came into force on the big bang date of 1 July 2022⁵. This raises a lot of questions which are reported on in **epi** information by the **epi** Biotech Committee regularly.

Several landmark biotech patent court cases in Europe have also had a significant impact on the interpretation and application of patent law in the field of biotechnology in Europe. Other topics than the above-mentioned ones that we have been dealing with in the last 20 years from the biotech angle are for instance sequence alignments, deposits of biological materials, pharmacogenomics, medical use claims, non-unity, post-published data, functions of genes, credible or plausible gene or protein function requirements, added matter, gene-editing technology, genomic sequencing and personalized medicine, T-cell receptor patenting and the Nagoya Protocol.

It is expected that biotech patenting will continue as a changing and challenging field and hopefully it can keep on flourishing for applicants and inventors and have commensurate protection possibilities.

⁴ <https://patentepi.org/r/info-2303-15>

⁵ See discussion in the recent reports of the **epi** Biotech Committee on the recent developments of this topic

The Practitioner's Guide to the PCT

Second edition by Jay A Erstling, Megan M Miller. ABA Book Publishing, 16 May 2023. ISBN: 9781639052936; paperback¹

Book Review by G. Roberts, Partner at Kilburn & Strode LLP in London

The authors of this excellent guide modestly suggest that the PCT is not as complex as it looks, and in this guide running to over 300 pages they demonstrate that whether or not the PCT is a complex entity, it can indeed be demystified. Sitting at, currently, 157 countries, the PCT must be one of the most astonishing international endeavours of all time, and its growth since 1978 demonstrates its huge commercial and economic importance, building from just 650 filings in its first year to over a quarter of a million in last two or three years. This guide, therefore, is tremendously important.

Starting with a super clear review of the PCT system, including useful historical context and an exposition of the practical benefits, The Practitioner's Guide to the PCT then takes the reader through the various stages of the process in awesome and essential detail. The first third of the book is dedicated to the filing process and through the liberal use of figures, tables, screenshots, hints and tips, holds the user's hand through the whole process including technically specific areas such as sequence listings and biological deposits, not to mention a host of 'wrinkles' on national practices. And it genuinely acts as a guide – not only giving many examples, but even stretching to gentle recommendations which, with a system of this complexity, is incredibly helpful. The guide then moves through various details of the intermediate parts of the process – publication, recording changes, troubleshooting and the search and examination process before devoting another significant chunk to the national and regional stage, again not avoiding practical guidance on topics such as country selection strategy, tips for global drafting, the important issue of attorney selection and management, and a raft of other pragmatic advice. The

guide is also very much up to date not only in its presentation, but also with handling of topics like third party observations, standard ST.26 and the introduction of the Unitary Patent at the EPO.

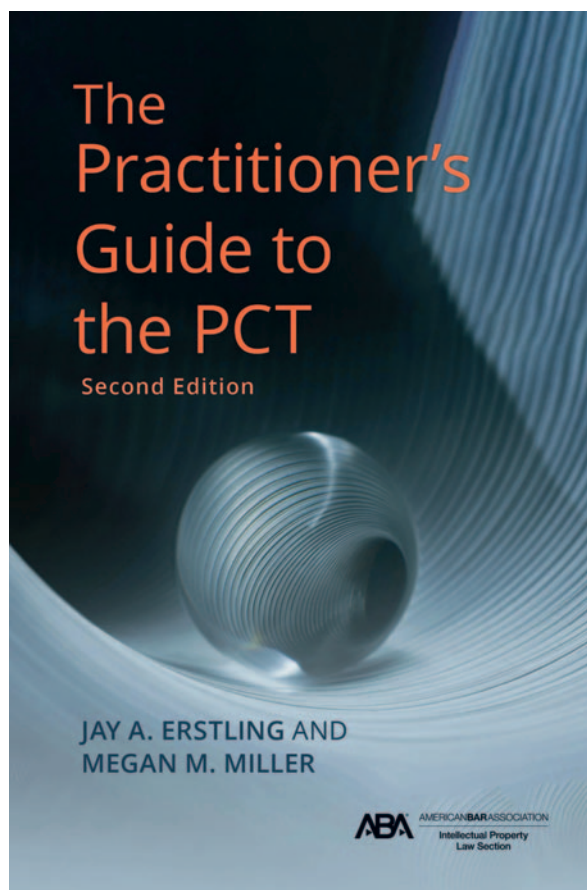
Both the authors bring huge experience and in wonderfully complimentary areas; Jay Erstling is known to anyone who's ever wanted to learn about the PCT system, having worked at WIPO and advised and taught on PCT matters for more years than he may want to admit to! But the expertise of co-author Megan Miller is equally impactful and in particular Megan brings a unique perspective with not only lengthy practitioner experience but also a history as a paralegal. And as we all know, it's the paralegals who really get the system...

Although published by the ABA, and although the authors have expressed awareness that there is a US centre to this book, it is of genuinely global relevance. The sections on national practice in major jurisdictions are lengthy and detailed and, based on this reviewer's experience, extremely accurate at least in relation to EPO practice. But the level of detail and the wrinkles about practice in a whole range of national stage elements is astounding and incredibly useful.

Anyone who wants to understand the PCT system from a procedural or strategic perspective needs to have a copy of this guide wherever in the world they are based, and we can only thank Jay, Megan and The American Bar Association for putting such effort into an essential resource.

This review was first published in the July-August edition of the CIPA Journal.

¹ <https://www.americanbar.org/products/inv/book/431043660>





Case Law

EBA Referral G 1/23

Is a marketed product excluded from the prior art if its composition could not be analysed without undue burden?

G. Murnane (GB)

The Enlarged Board of Appeal (EBA) in case G 1/23 has given third parties the opportunity to file comments (amicus curiae briefs) on the questions referred to it by Technical Board of Appeal 3.3.03 in its interlocutory decision of 27 June 2023 in case T 438/19¹. 2023

The EBA has set a deadline of 30 November 2023² for the filing written statements by third parties.

The referral seeks clarification on the enablement test for prior use of a product. The questions relate to the circumstances under which the prior use of a product may be excluded from the prior art for lack of enablement.

¹ <https://patentepi.org/r/info-2303-05>

² <https://patentepi.org/r/info-2303-06>

What constitutes prior art?

What constitutes prior art is a core issue for patent attorneys. We have all had to explain that a printed disclosure can be prior art, even if it has only had a limited circulation to a small group of people not bound to confidentiality. We have had to warn clients against exhibiting or even trialling their invention in a public space, before filing a patent application. This referral therefore appears to be significant for all patent attorneys.

The significance is not limited to the chemical field. Although G 1/92³, cited in the referral, refers to the

³ <https://patentepi.org/r/info-2303-07>

chemical composition of a product in the headnote, the headnote goes on to state that: “the same principle applies *mutatis mutandis* **to any other product**” (emphasis added).

As the Board in T 438/19 explained: “... the question at stake is of considerable practical relevance, rather than merely theoretical, as it potentially arises whenever the assessment of prior art involves the possibility to analyse and reproduce the chemical composition of a commercially available product.” The Board therefore found that the referral to the EBA was admissible and met the requirements of Article 112(1)(a) EPC⁴.

What is the Enlarged Board being asked?

The referral particularly asks whether the non-enabling prior use of a product excludes the composition of the product from the prior art or whether it also excludes the product per se. This is of significance, because if the product per se is excluded it cannot be used as a starting point for an inventive step analysis. The referral also seeks clarification over the definition of enablement with respect to the prior use of a product, and particularly whether “enablement” requires that the skilled person be able to fully analyse and reproduce the exact same product.

The questions are as follows:

1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?
2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?
3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

⁴ <https://patentepi.org/r/info-2303-08>

The “state of the art” is defined by Article 54(2) EPC⁵ as “everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application”.

According to the established case law (as discussed in EPO Guidelines for Examination, G-IV, 2⁶) in order to constitute prior art, a disclosure must also be enabled.

Also according to the established case law from the EBA (see G 1/92⁷), if the invention is a product, prior disclosures of the product are only considered to have resulted in the chemical composition having been “made available to the public” if “the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition”.

Why is this referral being made?

Given that G 1/92 has been with us so long, why has this referral been made now? The reasoning given by the Board in T 438/19 is that they noted a divergence in how Boards have interpreted a potentially confusing paragraph in G 1/92. Paragraph 1.4 of the Reasons for the Decision in G 1/92 reads as follows:

*“An essential purpose of any technical teaching is to enable the person skilled in the art to manufacture or use a given product by applying such teaching. Where such teaching results from a product put on the market, the person skilled in the art will have to rely on his general technical knowledge to gather all information enabling him to prepare the said product. **Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art.**”*

The Board in T 438/19 held that the last sentence of this paragraph (in bold above) could appear to indicate that a product put on the market becomes state of the art and therefore available to the public only when the composition or internal structure of the product can be discovered and reproduced without undue burden. This seems at odds with the conclusion of G 1/92 which states that “the product as such is available to the public”.

Diverging approaches in applying G 1/92

The Board identified diverging approaches adopted in the case law of the Boards of Appeal in applying G 1/92. In

⁵ <https://patentepi.org/r/info-2303-09>

⁶ <https://patentepi.org/r/info-2303-10>

⁷ <https://patentepi.org/r/info-2303-07>

particular the Board identified divergent decisions with regard to the following aspects:

- (i) *interpretation of “available to the public” leading to the exclusion from the state of the art within the meaning of Article 54(2) EPC of the product itself (including its chemical composition/internal structure) or only of its chemical composition/internal structure,*
- (ii) *the degree of detail required for the analysis of said product, and*
- (iii) *the requirements for its reproducibility.*

According to one body of case law, in cases where a product that was publicly available before the priority date of a patent could not be analysed or reproduced by a skilled person, only the internal composition of the product should be excluded from the prior art (T 370/02, T 2045/09, T 1833/14, T 0023/11). According to another body of case law, both the product per se and its internal composition should be excluded from the prior art (T 946/04, T 1666/16).

The referring Board in T 438/19 argued that the distinction over whether the composition of the product, or both the product and its composition, should be excluded

from the prior art is not just a theoretical question, but has practical consequences for inventive step analysis. If a product per se is excluded from the prior art, it cannot then be used as a starting point for inventive step in combination with other prior art documents, e.g. documents about the product that may assist in overcoming the enablement issues. Importantly, the enablement test permits the skilled person to use common general knowledge (CGK) but not prior art documents that do not form part of the CGK.

Comments on the referral

Many patent attorneys will have their own views on how G 1/92 should be applied, in order to provide certainty with regard to prior art disclosures.

Chris Mercer, the chair of the European Patent Practice Committee (EPPC), is coordinating the **epi**'s own amicus curiae brief, for consideration by the Enlarged Board in G 1/23. He would welcome any volunteers to help with the drafting of the brief. He would also welcome any comments from epi members as to what should go into the brief. He can be reached, with comments or offers of assistance, at the general EPPC email address (eppc@patentepi.org).

We await the decision in G 1/23 with interest.

Interpretation of the G2/21 decision by the national Courts: Of the uselessness of the Enlarged Board of Appeal?

M. Dhenne (FR), Adj. Prof., PhD, Patent Litigator (Paris Bar and UPC)

Is it still necessary to present the famous G 2/21 decision¹ to the readers of this review? Certainly not in detail, but main points are worth recalling.

In this case, the Enlarged Board of Appeal (“EBA”) ruled on the admissibility of post-filing data in assessing the plausibility notion. The EBA considered that post-filing data submitted in support of inventive step should not be excluded as a matter of principle, even in cases where

such post-filing data constitutes the sole means of proof of the alleged technical effect. However, “a patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention”². It seems three conditions arise from the criterion provided here in the Board’s

¹ EPO, EBA, March 23, 2023, “Reliance on a purported technical effect for inventive step (plausibility)”.

² Point 2 of the Order.

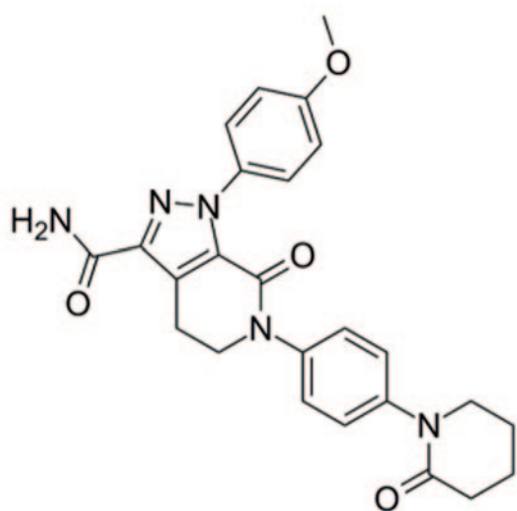
Order: (i) *encompassed by [the] technical teaching [of the application as filed]*", (ii) *"embodied by the same originally disclosed invention"*, and (iii) *"[it] does not change the nature of the claimed invention"*. To conclude the EBA states that it *"is aware of the abstractness of some of the aforementioned criteria"*³. This is indeed the least we can say. Such "abstractness" that one might well question what the G 2/21 decision input is (like many other EBA decisions, unfortunately).

Here we didn't have to wait for long before the uselessness of G 2/21 became apparent in practice. In fact, in the "APIXABAN" case, two different courts – British and French courts – have already succeeded in proposing two completely opposite interpretations of the decision. Let's briefly study those decisions to clarify the plausibility situation after G 2/21.

The "APIXABAN" case: facts

Patent EP1427415 ("EP'415") was filed on behalf of Bristol-Myers Squibb Company ("BMS Company") on September 17, 2002, as international application PCT/US02/29,491 (WO 03/026652) ("WO'652"), under the priority of provisional application US 60/324,165 of September 21, 2001. It expired on September 17, 2022, and forms the basis of SPC FR11C0042, which will expire on May 20, 2026.

EP'415 claims apixaban (claims 1 and 2), the pharmaceutical composition comprising it (claims 3 and 4), the compound and the pharmaceutical composition for use in therapy, in particular to treat thromboembolic disorders (claims 5 to 22), optionally in association with a second therapeutic agent to treat thrombolytic disorders (claims 23 to 29).



Apixaban
(1-(4-methoxyphenyl)-7-oxo-6-[4-(2-oxopiperidin-1-yl)phenyl]-4,5,6,7-tetrahydro-1H-pyrazolo[3,4-c]pyridin-3-carbamide)

The "APIXABAN" case: proceedings

The patent has not been opposed. However, several invalidity proceedings have been initiated worldwide. For instance, the validity of the Canadian patent (CA2461202) has been challenged on several grounds, but without success⁴.

In addition, Sandoz and Teva sought a declaration of invalidity of the UK part of the application⁵ for lack of inventive step, more particularly in view of international publication WO 00/39,131, lack of plausibility and extension beyond the content of the application as filed. The applicant obtained revocation of the patent, Arnold J having found that, in the absence of any theory based on the structure of apixaban or any data in the description, by way of example, nothing in the application supports the assertion that apixaban is a factor Xa inhibitor. As such, the assertion is not plausible, as the application gives the skilled person no reason to believe that there is a reasonable prospect that the assertion will prove to be true.



Matthieu Dhenne

In contrast to the UK judge, the Paris High Court⁶ (i.e., "Tribunal Judiciaire de Paris") ruled that the claim that apixaban is a factor Xa inhibitor was plausible for the purposes of assessing inventive step. According to the Court, the applicant was not in possession of the invention at the time of filing and filed on the basis of an idea or intuition. The Court notes, however, that WO'652 specifically discloses apixaban, which is then exemplified (no. 18), admittedly among 140 examples and the description of more than 100 product syntheses. That said, the Court notes that WO'652 discloses tests, resulting in the determination of "most preferred" compounds with very good affinity and in particular a K_i # 0.001 μ M. WO'652 further states that the invention concerns a factor Xa inhibitor with improved pharmacological and pharmacokinetic properties. It also describes that 3.07 g of apixaban have been synthesized (page 178). This quantity unquestionably distinguishes apixaban from all other examples of synthesized compounds, in that it is by far the largest quantity synthesized according to the description (no other example reaches one gram, the other largest quantity synthesized being example 91:0.34 g). A person

³ Point 95 of the Reasons.

⁴ Federal Court of Canada, January 12, 2021, Bristol-Myers Squibb vs. Pharmascience & Sandoz.

⁵ Sandoz and Teva vs. Bristol-Myers Squibb [2023] EWCA Civ 472.

⁶ Paris High Court, June 2023, 8, 2023, Teva vs. Bristol-Myers Squibb, RG n° 21/12727.

skilled in the art would necessarily have deduced, based on common general knowledge, that the patentee thought apixaban was a promising compound, if not the most promising.

In addition, BMS has submitted laboratory notebooks and reports from its researchers, predating the filing of WO'652, which indisputably demonstrate, and which are indeed not seriously disputed, that it was in possession of the invention, namely a factor Xa inhibitor, useful in the treatment of thromboembolic disorders, with improved pharmacological and pharmacokinetic properties. These elements fully confirm the research program as described by BMS, and the discovery of apixaban by Dr. Pinto and his colleagues before the priority date. The Court concludes that the plea alleging the lack of "plausibility" or "credibility" of EP'415's contribution to the state of the art at the time of filing, and therefore the lack of inventive step of claims 1 to 4, is therefore rejected.

Comments

Both decisions adopt an extreme interpretation of G2/21.

The British decision certainly appears the more questionable. Stating that nothing in the application supports the assertion that apixaban is a factor Xa inhibitor is saying both one thing and its opposite in the same sentence. Indeed, in pharma the names are very specified. Here, for instance the Xa factor finds itself in the name Api**X**aban. Not only does this position seem strange and contradictory to me, but it also fails to take account of the specifics of the pharmaceutical field, by reducing the notion of plausibility to almost nothing.

However, even if, in my opinion, the French position is better, we can't ignore that this position is a bit extreme too. The Paris High Court adopts a flexible interpretation of plausibility. While it aligns itself with EPO decision G 2/21, adopting the more favorable position of implausibility *ab initio*, it nevertheless gives an interpretation opposed to that of the British judge. Whereas the latter considers that tests and data are compulsory, the French judge considers, conversely, that they are not, except in the specific case of a subsequent therapeutic application.

Therefore, whereas the British position reduces plausibility to almost nothing, the French position tends to set the plausibility threshold at a low level, which is unquestionably favorable to the patentee. It seems to me that the use of plausibility is intended to facilitate the assessment of patentability in a field marked by the random nature of the results obtained by the claimed inventions: the pharmaceutical field. However, we must be careful not to lower the assessment of this criterion, which is already intrinsically favorable to applicants. To do otherwise would be to give an undue advantage to an applicant who could reserve for himself the exploitation of an invention that falls more within the field of research than that of technology. In short, plausibility would only be set aside if the person skilled in the art had legitimate reasons to doubt it at the time of filing, so that applicants can claim an entire field of research for themselves without having yet started work on it.

In conclusion, as we have just seen, the criterion laid down in the G 2/21 decision can be considered from different angles, so that we can only hope that the new Unified Patent Court will genuinely help to unify, at least, European litigation in such situations, at the risk, otherwise, of encouraging forum shopping.



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epi Educational trainings and events

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Session Calendar

- 09 October Webinar* Goodbye, ten-day rule
- 18 October Seminar Infringement by Equivalence in Major EPC Jurisdictions Munich
- 07 November Seminar Unitary Patent and Unified Patent Court Athens
- 22 November Seminar A fresh look at procedural aspects of appeal proceedings Madrid
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*This webinar is free of charge only for **epi** members and **epi** students.

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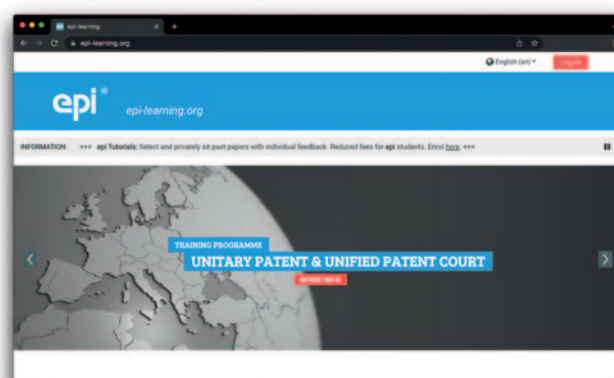
10-11 October Examination Matters
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¹ <https://www.epi-learning.org>

² https://www.surveymonkey.de/r/epi-learning_platform

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1 <https://patentepi.org/r/info-2303-11>

2 <https://www.epi-learning.org/enrol/index.php?id=108>

3 <https://www.epi-learning.org/enrol/index.php?id=103>

4 <https://www.epi-learning.org>

5 <https://patentepi.org/r/info-2303-12>

epi Student membership

epi student members have access to additional information on the **epi** learning website, including the student forum described below. Other benefits of student membership include receiving alerts about **epi** training courses, priority access to our educational events, and reductions on course fees for **epi** educational events, such as tutorials, seminars and webinars. Candidates for **epi** student membership may apply, at any stage of

their training, to the **epi** Secretariat (epi.student@patentepi.org), simply by filling in the online application tool¹, providing the necessary documents² and paying the fee.

1 <https://patentepi.org/r/student-membership-01>

2 <https://patentepi.org/r/student-membership-02>

Follow us on Twitter and LinkedIn for **epi** educational news!



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Results of the 2023 European Qualifying Examination

Statistics on the results of the 2023 EQE

Number of candidates per country and passes pursuant to Article 14 (1) of the Regulation on the European qualifying examination (REE)

Place of residence	Total number of candidates	Pass
AL	0	0
AT	18	5
BE	37	15
BG	3	1
CH	43	21
CY	0	0
CZ	4	1
DE	579	217
DK	38	19
EE	2	0
ES	64	14
FI	30	11
FR	128	63
GB	289	190
GR	4	1
HR	0	0
HU	6	1
IE	4	2
IS	0	0
IT	89	27
LI	1	0
LT	2	0
LU	2	0

Place of residence	Total number of candidates	Pass
LV	3	2
MC	0	0
ME	0	0
MK	0	0
MT	0	0
NL	99	51
NO	13	5
PL	38	10
PT	11	4
RO	4	2
RS	0	0
SE	74	23
SI	1	0
SK	0	0
SM	0	0
TR	38	3
AU	1	1
CA	1	
CN	1	
JP	2	
NZ	1	1
Grand Total :	1630	690

Information source: <https://www.epo.org/en/learning/professional-hub/european-qualifying-examination-eqe>

Candidates are free to choose which paper(s) they wish to sit. Candidates who have only sat a sub-set of papers cannot fulfill the conditions of Article 14(1) REE (i.e. have obtained the minimum grades for all four papers) and thus cannot be included in this table.

Example: A candidate has only sat papers A and B and passed both papers. Nonetheless the conditions of Article 14(1) REE are not yet fulfilled and this candidate is not included in this table.

This table includes all candidates who fulfill the conditions of Article 14(1) REE.

List of Professional Representatives

by their place of business or employment in the Contracting states
and their entry according to A134(2) (EQE) or A134(3) (Grandfathers)
as at 01.09.2023

Contr. State	Number Total	% of Total Repr.
AL	10	0,07%
AT	191	1,33%
BE	318	2,22%
BG	46	0,32%
CH	657	4,59%
CY	10	0,07%
CZ	84	0,59%
DE	5277	36,85%
DK	330	2,30%
EE	19	0,13%
ES	261	1,82%
FI	206	1,44%
FR	1368	9,55%
GB	2882	20,12%
GR	27	0,19%
HR	23	0,16%
HU	70	0,49%
IE	91	0,64%
IS	18	0,13%
IT	601	4,20%

Contr. State	Number Total	% of Total Repr.
LI	24	0,17%
LT	22	0,15%
LU	24	0,17%
LV	12	0,08%
MC	7	0,05%
ME	1	0,01%
MK	18	0,13%
MT	6	0,04%
NL	585	4,08%
NO	110	0,77%
PL	242	1,69%
PT	46	0,32%
RO	43	0,30%
RS	41	0,29%
SE	484	3,38%
SI	28	0,20%
SK	30	0,21%
SM	15	0,10%
TR	94	0,66%
Total :	14231	100,00%

All about Patent Quality

The role of technically qualified (European) patent attorneys

T. Marx (DE), Director IP Löwenstein Group

In Europe in Mid 2022 the Industry (Industry Quality Charter – IPQC) and the EPO both launched their new Patent Quality Charters.

What can be epi's position regarding Patent Quality

The technical qualification of patent attorneys is a critical factor in the quality of patents they produce. Patent attorneys must be able to understand the technical details of an invention in order to draft a patent application that adequately and accurately describes the invention.

A technical qualification means that a patent attorney has the necessary educational background and expertise to understand the technical aspects of the invention. This can be especially important in fields such as biotechnology, engineering, and computer science, where the inventions can be highly complex and require a deep understanding of the underlying technology.

A patent attorney with a good technical qualification can provide several benefits, including:

- Better understanding of the invention
- Better communication with inventors
- Better identification of patentable subject matter
- Better response to office actions

Overall, the technical qualification of patent attorneys plays a critical role in the quality of patents they produce. It is important for inventors and companies to work with patent attorneys who have the necessary technical expertise and qualifications to maximize the quality and value of their patents.

Is patent quality linked to the qualification of patent attorneys

Yes, the quality of patents is often linked to the qualifications and experience of patent attorneys.

Patent attorneys must have a deep understanding of patent law and the technical subject matter of the inventions they work with.

An experienced and qualified patent attorney can provide several benefits that can improve the quality of a patent. For example, a patent attorney with technical expertise in the relevant field can help ensure that the patent application adequately covers the invention and is not overly broad or too narrow. They can also provide guidance on how to avoid potential infringement of existing patents and help draft claims that are clear and specific.

Additionally, a patent attorney can provide valuable advice on patent strategy, such as whether to pursue patent protection in multiple countries, whether to file provisional patent applications before filing a full application, and how to respond to office actions from patent examiners.

On the other hand, an inexperienced or unqualified patent attorney may not have the necessary expertise or knowledge to provide high-quality patent services. This can result in a patent application that is poorly drafted, inadequately disclosed, or too narrow in scope, which can ultimately lead to a weaker and less valuable patent.

Therefore, it is important for inventors and companies to carefully select their patent attorneys and work with those who have the necessary qualifications, experience, and technical expertise to maximize the quality and value of their patents.

Patent attorney vs. Attorney and the UPC

The Unified Patent Court (UPC) is a new court system for the European Union that will have jurisdiction over patents granted by the European Patent Office (EPO). Patent attorneys will play a key role in the UPC system, as they will be responsible for representing parties in patent disputes before the court.

Here are some of the key roles that patent attorneys will or might play in the UPC system:

- Representing parties in patent disputes
- Advising clients on UPC proceedings
- Handling patent portfolio management
- Providing guidance on patent eligibility
- Interacting with the EPO

When it comes to representing parties in patent disputes before the UPC, both attorneys and patent attorneys can be suitable, depending on their qualifications and experience.

The decision will depend on several factors, including the complexity of the technical subject matter, the nature of the legal issues, and the qualifications and experience of the attorneys or patent attorneys in question.

Attorneys are legal professionals who are qualified to practice law and can represent parties in a wide range of legal matters, including patent disputes. Patent attorneys, on the other hand, are legal professionals who are trained and qualified to provide legal advice and representation in matters relating to patents.

In general, if the dispute involves complex technical subject matter, it is advantageous to choose a patent attorney with relevant technical expertise. A patent attorney can provide clients with a deep understanding of the patent system, help assess the strength of patents, and develop effective strategies for enforcing or defending patent rights.

In general, patent attorneys may be better suited to represent parties in patent disputes before the UPC, especially in cases involving complex technical subject matter.

On the other hand, an attorney who is not a patent attorney but has relevant technical expertise may also be suitable for representing parties in patent disputes before the UPC.

It is therefore desirable to shape the profile of a European Patent Attorney and to keep the standards of their qualification high.

For the EQE this means

- *no admission to EQE without a technical/scientific master or diploma (better PhD) degree of **at least 4** better 5 years fulltime university.*
- *one year of practical experience in the technical/scientific field*
- *no supplementation of a qualification*

Having a good (and proven) technical background is an advantage for a patent attorney, especially in cases involving complex technical subject matter. A patent attorney with technical expertise can provide clients with a deep understanding of the patent system, help assess the strength of patents, and develop effective strategies for enforcing or defending patent rights.

EPO and **epi** should be acting together to define new and highest standards for the technical (and legal) qualification of both patent attorneys and examiners.

Prerequisites to sit the future e-EQE

Perspective from the **epi** Diversity and Inclusion Working Group¹

Introduction

The Diversity and Inclusion (D&I) Working Group of **epi** has become aware that there is a proposal to change the conditions for registration as a candidate to sit the European Qualifying Examination. More specifically, there has been a proposal to “raise the bar” on the scientific/technical qualifications required for enrolment in the EQE.

Our working group has fundamental and practical objections to this particular change: it would immediately restrict the pool of potential recruits, and undermine the good standing of many existing **epi** members and candidates. We have not heard any evidence-based justification for such a change, and furthermore we consider the proposal incompatible with the Policy on Diversity and Inclusion adopted by the **epi** Council during its 92nd meeting on 7th May 2022².

¹ The members of the Working Group are S. Bannan (GB), E. Cogniat (CH), N. Ferrara (DE), J. Gray (GB), N. Marusic (CH), C. Nargolwalla (FR), M. Nevant (FR), J. Sahlin (FI), F. Sardharwala (GB), O. Sirakova (BG)

² See: <https://patentepi.org/en/diversity-and-inclusion/di-policy.html>

For the avoidance of doubt, our working group in no way advocates lowering the bar below its current and long-established level. Our working group further agrees that other amendments in the IPREE are necessary, and is already in collaboration with the relevant persons in **epi**.

The status quo

The current qualification requirements for registering as a candidate are set out in Article 11 of the Regulation³ on the EQE (REE) and Rules 11-14 of the Implementing Regulations (IPREE). The Regulation states that “a university-level scientific or technical qualification” or equivalent knowledge is required to enrol for the EQE.

In the IPREE, this “university-level qualification” is specified as at least a three-year degree. This corresponds to what the EHEA⁴ Bologna Process calls the “First cycle” of qualifications, usually awarding a Bachelor’s degree. To take account of those courses that include some non-technical modules (e.g. a language or business studies), this minimum three-year course must include at least 80% scientific and/or technical subjects.

(No effective⁵ route to show equivalent knowledge has ever been provided, which we believe needs to be addressed in the next version of the IPREE.)

The proposal to raise the bar

The proposal to raise the bar is that the minimum level of university course should be a four-year course, or what the Bologna Process would call a “Second cycle” qualification, for example a Master’s degree.

Analysis

Any proposal to increase the scientific/technical qualification requirements for entry into the profession should provide evidence that the current “bar” is not high enough. The reputation and quality of European Patent Attorneys is well known throughout the IP world. Introducing such a modification would unnecessarily cast doubt on the credibility and standing of numerous established professionals in the field. Surely, this cannot be the intended outcome.

Additionally, “raising the bar” would lead to a smaller pool of candidates for trainees, and actually make it harder to hire the best candidates because the pool

would no longer include very able candidates who did not take a four-year degree course. This change could also have negative consequences for the current members of the profession seeking new trainees; it simply must not be implemented without comprehensive research and surveys.

We believe that the key purpose of the EQE is to test those special patent attorney skills, that the client cannot be expected to judge. On the other hand, whether their attorney does or does not understand the technical aspects of an invention is something the client can actually judge for themselves. Clients don’t tend to be concerned about how many degrees or other qualifications their patent attorney has; the client will judge whether the attorney can listen and communicate ideas clearly, and whether they can match their advice and drafting to the client’s commercial goals.

In any case, the employer is primarily responsible and best placed to decide what technical qualifications and other personal attributes⁶ their trainees need, in order to become the EPAs of the future. Finding candidates with the right mix of skills to excel in the profession is not a simple task and it does not make sense to make it even harder. Of course, in addition to the minimum qualification threshold set by the REE/IPREE, the employer is at liberty to recruit a candidate who has the most appropriate educational and technical background, and any necessary additional skills, to serve the needs of their particular clients.

Finally, we believe that the proposal to increase the minimum length of the degree for entry into the profession is incompatible with the **epi**’s Policy on diversity and inclusion adopted by the Council⁷. The policy states:

***epi** believes that capturing and drawing on diverse points of view can improve the advice and services that its members can offer to clients and prospective clients, who are focused on innovation (which itself requires divergent thinking and novel perspectives).*

Raising the bar on the qualification required to enter the profession is likely to result in the exclusion of prospective candidates who could provide particularly divergent thinking and novel perspectives. As an example, such candidates may come from underprivileged backgrounds and/or they might be facing financial constraints that prevent them from pursuing extended educational paths to enter the profession. Furthermore, candidates with varied family circumstances (like child-care responsibilities, caretaker duties, sole providers

³ Regulation on the European qualifying examination for professional representatives, last amended in 2009.

⁴ European Higher Education Area (<https://www.ehea.info>)

⁵ The only alternative currently provided is at least ten years of experience working under the supervision of a European Patent Attorney or as an in-house patent engineer. This requirement appears outdated as it fails to acknowledge any relevant real-world experience the candidate may possess in the fields of science and technology.

⁶ E.g. workshop/lab experience, foreign language skills, interpersonal skills and the like are pretty much independent of degree level.

⁷ See: <https://patentepi.org/en/diversity-and-inclusion/di-policy.html>

for their family unit) might find it challenging to commit to longer degree programs. Also, members of diverse communities may have encountered various forms of discrimination during their educational journeys, which could have limited their access to advanced degrees.

The policy further states:

epi will therefore treat its members, their clients and other stakeholders fairly and equitably, with respect, honesty and dignity, and will communicate in a manner that promotes these values, free from discrimination, prejudice and harassment.

Raising the bar for entry into the profession based on a length of a degree is not equitable and discriminates against certain very able prospective members of the profession. Furthermore, as mentioned above, existing European Patent Attorneys who would not meet the new requirements would effectively be reduced to

“second-rate” members, which would be discriminatory and undignified treatment of those existing members. The policy further states:

epi understands that, to achieve diversity, inclusiveness must be fostered; and that increased inclusivity can itself lead to greater diversity.

The proposed increase in entry qualification level would inevitably lead to decreased diversity among the profession and therefore directly contradicts the above commitment.

The opinions expressed in this article are the unanimous opinion of the members: S. Bannan (GB), E. Cogniat (CH), , N. Ferara (DE), J. Gray (GB), N. Marusic (CH), C. Nargolwalla (FR), , M. Nevant (FR), J. Sahlin (FI), F. Sardharwala (GB), O. Sirakova (BG)

For more information, see:

<https://patentepi.org/r/di>

Conclusions

For the above reasons, the members of epi’s D&I working group strongly recommend that this proposal to raise the level of scientific/technical qualifications be abandoned. It is discriminatory, divisive, and, most of all, it does not address any real issue of quality or public interest. We are all aware that our degrees are only one of the factors determining success in our profession, and arguably not the most important one. The real “judgment” on the quality of a prospective new member of the profession comes from their employer, as well as from their clients. Let those stakeholders make a judgment then, and do not limit their choice by this ill-advised

proposal. The EQE itself presents a much more equitable test of the candidates’ skill skills in patent work than an arbitrary length of a prior degree could ever achieve.

Let’s work on making our profession more welcoming and inclusive, and fit for the future. The quality of its members and of our work will only be enhanced by encouraging a diverse intake of recruits, while of course maintaining our current standards of excellence.



Committee Reports

Report of the Committee on Biotechnological Inventions

S. Wright (GB), Chair and B. Taravella (FR), Secretary

1. New Chair and Secretary of the Biotech Committee (BC)

A new Chair and Secretary of the **epi** Biotech Committee were elected on 19th of July, namely Simon Wright (GB) and Brigitte Taravella (FR). The EPO has been informed of that change on August 4, 2023. Ann De Clercq (BE) will remain as BE member and she has been elected as liaison person with the Presidium.

2. ST.26 Sequence listings

As a follow-up of the complaint with the EPO Ombuds Office of January 16, 2023 highlighting our concerns regarding the lack of reactivity from the EPO on sequence listings problems and questions raised by **epi**, the EPO sent an answer in early May, just after the last meeting April meeting with the DG1.

On June 30, 2023 the EPO sent a response to the **epi**'s technical questions. The BC asked the EPO to make this response public by accessible in the EPO's FAQ. On August 29, 2023 EPO answered that it supports the idea of making those technical comments publicly available. They would, however, prefer publishing them on their own website and EPO is currently working on an improved version which can be also added in any publication **epi** would initiate on this topic such as the **epi** information journal.

Significant technical issues still remain with the systems, for which we need EPO input. Some BC members suggested we formulate a reply to request clarification about what is acceptable, or not, regarding automatic translations from ST.25 to ST.26. The Box-declaration on Form 1001 for divisional application is also a concern. Some BC members feel that the declaration of non-added matter is considered as unfair. Such declaration should not be needed if the sequence will not be part of the specification.



Simon Wright

3. Draft amendments for the 2024 EPC and PCT Guidelines

epi has the possibility to comment on the draft of the new Guidelines proposed by the EPO following the SACEPO WP GL meeting of October 10. The **epi**/EPPC organised an in-person meeting on August 24 and 25 to discuss the Guidelines amendments.

Simon Wright (new BC chair) and Ann de Clercq (former BC chair) attended the meeting on behalf of the BC. Our final and assembled comments have been passed to Anette

Hegner by 1st September and concern mainly comments on ST.26 sequence listings, plant disclaimers and antibody patenting parts.

Our comments on amending R. 30 EPC to be more lenient on sequence listings have also been passed on to the EPPC subcommittee in preparation of the SACEPO meeting WPR on October 19.

Looking at the amendments proposed by the EPO on the GLs, **epi** biotech committee still has concerns on the GLs drafting process and the impact it has on quality. There seems to be no real dialogue or listening in the SACEPO meetings on GLs. We suggest keeping on addressing this matter, at every possible level at the EPO.

We wonder if the EPO does not see the need to discuss the GLs extensively with the users since it is considered an internal document. In addition, our comments are sometimes simply disregarded. This creates frustration in the user community and in the BC.

4. Biotech Committee meeting of July 19, 2023

The main topics of the meeting were to follow-up to points to be discussed with DG1 in the meeting of April 25,

2023, to discuss the status of our complaint to the EPO Ombuds Office and to elect the new Chair and Secretary of the BC.

5. Further special Biotech Committee meetings with the EPO

A formal letter was sent on March 29, 2023 by the Biotech Committee to the EPO to request to organise further meetings regarding antibodies and ST.26 sequence listings. Based on the summer e-mail exchanges with the EPO, the BC agreed to decide, in the near future if such meeting is needed or to wait for the next meeting with the DG1 to be organised in 2024. BC will continue on email exchange with the EPO about Biotech issues.

6. Next Biotech Committee

The next BC has not yet been planned. It should be scheduled for January or February 2024 after the autumn council meeting. Only one in-person meeting is scheduled for 2024, to keep to the established 2024 BC budget.

Report of the Litigation Committee

K. Finnilä (FI), Chair

The Litigation Committee will meet on 10 October 2023. This will be the last meeting of the committee for the present term. We reported extensively for epi Information 02/2023 including a report from our last meeting on 28 March 2023.



Kim Finnilä

UPC Administrative Committee and the UPC IT Team

The most recent 7th meeting with the UPC IT Team was on 29 August 2023. The UPC Registrar has been present at these meetings since the beginning of the year, which has shown to be very valuable. At the time of the meeting there were over

50 cases pending before the UPC. The number of opt-outs was about 550 000.

The UPC IT Team and the Registrar are continuously working on improvements of the system. Two noteworthy improvements in the pipeline are (i) a possibility for a case team to

work on a case in the CMS and (ii) simplified CMS "self-correction" arrangements, e.g. for representative data etc. The next 8th meeting is scheduled for 23 October 2023. The next 8th meeting of the UPC Administrative Committee will take place on 27 September 2023.

The Litigation Committee

Executive and the Sub-Chairs of the subcommittees have reviewed the work progressed during this term. A review of the status of virtual proceedings before national courts will be updated by the "Virtual Proceedings" subcommittee. The subcommittee on "Representation and Privilege" will have a possibility to join the sessions of the WIPO Standing Committee on Patent Law to directly follow-up on the international Client-Patent Attorney privilege discussions. Some potential changes regarding the subcommittees and their focus have been discussed.

The next 04/2023 epi Information will include a report on the Litigation Committee meeting mentioned above. Hopefully we are then also able to report on the planned improvements of the UPC CMS in more detail.



General Information

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DE – WINTER Andreas

Next Council Meetings

Council Meetings

96th Council meeting in Ljubljana (Slovenia) on 11 November 2023

97th Council meeting in Sofia (Bulgaria) on 26 and 27 April 2024

Disciplinary Bodies, Committees and Audit

Disziplinarorgane, Ausschüsse und Rechnungsprüfung · Organes de discipline, Commissions et Vérification des comptes

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de Discipline (epi)
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BE – DEBLED Thierry	HR – MARSIC Natasa	NL – VAN LOOIJENGOED Ferry A.T.
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DK – KUHN Oliver Wolfgang	LT – GERASIMOVIC Jelena	SE – KARLSTRÖM Lennart
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ES – STIEBE Lars Magnus	LV – SMIRNOV Alexander	SK – ČECHVALA Radovan
FI – WESTERHOLM Christian	MC – AMIRA Sami	SM – MARTINI Riccardo
FR – NEVANT Marc	ME – LUTOVAC Vuk	TR – YURTSEVEN Tuna**

Disziplinarausschuss (EPA/epi)	Disciplinary Board (EPO/epi)	Conseil de Discipline (OEB/epi)
epi Mitglieder	epi Members	Membres de l'epi
BE – CAMPABADAL Gemma	FR – QUANTIN Bruno	IS – VILHJALMSSON Arni

Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi)	Disciplinary Board of Appeal (EPO/epi)	Chambre de Recours en Matière Disciplinaire (OEB/epi)
epi Mitglieder	epi Members	Membres de l'epi
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DK – FREDERIKSEN Jakob Pade	IT – COLOMBO Stefano	TR – ARKAN Selda
FR – GENDRAUD Pierre H.		

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DK – STAHR Pia	LU – MELLET Valérie Martine	SI – FLAK Antonija
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FI – KONKONEN Tomi-Matti Juhani	MK – PEPEJUGOSKI Valentin	TR – ATALAY Baris
FR – COLLIN Jérôme		
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EE – KOPPEL Mart Enn	IE – GILLESPIE Richard	SM – PRIMICERI Maria Vittoria
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	LI – HOFMANN Markus Günter	

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CY	– THEODOULOU Christos A.	HU	– LENGYEL Zsolt	PL	– KAWCZYNSKA Marta Joanna
CZ	– BUCEK Roman	IE	– MCCARTHY Denis Alexis	PT	– PEREIRA DA CRUZ Joao
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The representative area in MyEPO Portfolio as from 1 November 2023

As from 1 November 2023, the EPO will launch the Representative area as a new feature of the web-based online service MyEPO Portfolio. The Representative area will enable professional representatives registered on the list of professional representatives before the EPO to (self-)administer their entries on the registers of representatives. At first, representatives will be able to use the tool to request changes to their entry on the list and to manage their telecommunication details, including

the publication of these details in the searchable database on the EPO website as a self-service. They will also be able to request deletion from the list of professional representatives. The scope of the Representative area will be subsequently extended to enable representatives to request their entry on the list as well as to manage association memberships and general authorisations. For further details, the EPO will publish a feature guide as well as dedicated FAQ.

Contact Data of EPO Legal Division

Update of the searchable database of professional representatives on the EPO website

Please notify the Legal Division of the EPO of any changes to your contact details, ensuring that the list of professional representatives remains up to date. The list of professional representatives maintained by the EPO is also the one used by **epi**. To ensure that you receive **epi** mailings and email correspondence at the correct address, kindly inform the Legal Division of the EPO (Dept. 5.3.2.1).

Kindly note the following contact data of the Legal Division of the EPO:

European Patent Office
Dept. 5.3.2.1
Legal Division
80298 Munich
Germany

Tel.: +49 (0)89 2399-5231
legaldivision@epo.org
www.epo.org

The relevant form(s) to be submitted in the case of changes can be downloaded from the new EPO website:

<https://www.epo.org/en/law-practice/options-professional-representatives>.

At the button of the options for professional representatives you will find a link to consult your details in the searchable database of professional representatives. As from 1 November 2023, professional representatives can use the representative area in MyEPO Portfolio to request changes to their entry on the list and to manage their telecommunication details, including the publication of these details in the searchable database on the EPO website as a self-service. Deletion from the list of professional representatives can then also be requested via the Representative area. For more information about the Representative area, you may consult the announcement in the September edition of **epi** information. Additionally, the EPO will be publishing a feature guide and dedicated FAQs to provide further details.

Further information and forms relating to the list of professional representatives can be found on the EPO website and in the FAQ section of the **epi** website:

<https://patentepi.org/en/faq>

Thank you for your cooperation.

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