Institut der beim Europäischen Patentamt zugelassenen Vertreter Institute of Professional Representatives before the European Patent Office Institut des mandataires agréés près l'Office européen des brevets

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### Michael Berger

ichael Berger (51), European Patent Attorney from Germany studied "Geology" from 1985 until 1991 at the University in Bonn. In 1995 he graduated in "Geochemistry of isotopes" from the University of Bern. Beside his universitary studies he has been very active in artistic work since 1990 and included his scientific knowledge in his artistic work continuously. At this time Mr. Berger developed a technique combining pastel and acrylic painting. The artwork on the cover "Hommage to Albertus", which refers to the great philosopher, lawyer, scientist and theologian Albertus Magnus (Albert von Lauingen), was realized using this special technique.

According to the scientific laws of nature nothing in the universe is static. Everything is in a permanent motion. In painting to poor attention is paid to this realisation. Mr. Berger felt this disproportion between scientific knowledge and artistic presentation always as unsatisfying. Therefore he developed the innovative concept oft he "Transformable ART" which combines painting and sculpture in a manner that a continious change in the view of the picture allows any arrangements of the sculptures on the picture. Due to the granted manual intervention, the observer will be involved in the creative process of the picture design and picture presentation. In this way he could continue an artistic design process in an individual matter. www.berger-art.ch

ichael Berger (51), zugelassener Vertreter vor dem Europäischen Patentamt aus Deutschland studierte von 1985 bis 1991 Geologie an der Universität Bonn und promovierte 1995 an der Universität Bern in Isotopen-Geochemie. Neben seinen universitären Studien war er seit 1990 auch künstlerisch tätig und ließ seine in der Wissenschaft gewonnenen Erkenntnisse kontinuierlich in sein Schaffen als Künstler einfließen. In dieser Zeit entwickelt Berger eine Technik, die Pastellund Acrylmalerei miteinander kombiniert. Das hier wiedergegebene Werk "Hommage an Albertus", welches an den grossen Philosophen, Juristen, Naturwissenschaftler und Theologen Albertus Magnus (Albert von Lauingen) erinnert, entstand in dieser Technik. Nach den Gesetzen der Naturwissenschaft ist nichts im Universum statisch, alles befindet sich in einer ständigen Bewegung. In der Malerei allerdings wird dieser Erkenntnis wenig Beachtung geschenkt. Dieses Missverhältnis zwischen wissenschaftlicher Erkenntnis und künstlerischer Darstellung empfand Michael Berger als unbefriedigend. So entwickelte er das innovative Konzept der "Transformable ART", durch das Malerei und Skulptur in einer Weise miteinander kombiniert werden, die einen ständigen Wechsel in der Bildsicht durch beliebige Anordnungsmöglichkeiten der Skulpturen auf dem Gemälde ermöglichen. Mehr zu Berger's Kunst unter www.berger-art.ch

Cover:

Hommage to Albertus This picture painted by Mr. Michael Berger (European Patent Attorney, DE) was part of the **epi** Artists Exhibition 2015 at the EPO, Munich

ichael Berger (51), mandataire Magréé près l'OEB, originaire d'Allemagne, a étudié la géologie à l'université de Bonn de 1985 à 1991 et a soutenu en 1995 sa thèse de doctorat en géologie isotopique à l'université de Berne. En plus de ses études universitaires, il est aussi engagé depuis 1990 dans des activités artistiques où il applique dans ses œuvres artistiques ses connaissances acquises dans la science. Pendant cette période, M. Berger a développé une technique qui combine la peinture à la fois pastel et acrylique. L'œuvre reproduite ici, intitulée « Hommage à Albert », qui rend hommage au grand philosophe, juriste, naturaliste et théologien Saint Albert le Grand (Albert de Lauingen), a été élaborée à partir de cette technique. D'après les lois de la science de la

nature, rien dans l'univers n'est statique, tout est en mouvement permanent. En revanche, peu d'attention est prêtée à cette conclusion dans la peinture. Michael Berger a ressenti de l'insatisfaction en constatant une inadéguation entre cette conclusion scientifique et la représentation artistique. C'est ainsi qu'il a développé le concept novateur du « Transformable ART », par lequel la peinture et la sculpture sont combinées de telle sorte qu'elles permettent un changement permanent dans la visibilité de l'image à travers des possibilités de dispositions au choix des sculptures sur le tableau. www.berger-art.ch

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### Editorial

T. Johnson (GB), Editorial Committee

ne of the greatest pains to human nature is  ${m J}$  the pain of a new idea". So said Walter Bagehot, a British economist, journalist, and editor -in-chief of The Economist in Victorian times. Perhaps our clients might agree with the sentiment, and we are sure that we have all had experience of an inventor sacrificing time, money, and even a marriage to get an idea off the ground. On the other hand, we have often pondered on the phenomenon of what appears to be a perpetual human desire to develop/improve/innovate so that even tried and tested technology moves on to new heights. The desire seems to be part of human nature. Yet as the philosopher of science Karl Popper said "the initial stage, the act of conceiving or inventing a theory seems to me neither to call for logical analysis nor to be susceptible of it".

Thus the famous "Eureka" moment when the inventor springs metaphorically from his bath with the new idea in his mind.

We are not unused to new ideas in the realm of patent law and procedure. Though perhaps long in the tooth now, the UP and UPC are ideas which had severe birth pains but may now soon become realities, particularly as post-Brexit the United Kingdom has, we understand, indicated that it may ratify the UPC. As Bagehot also said "The greatest pleasure in life is doing what people say you cannot do".

On that happy note, one thing the Editorial Committee can do is sincerely to wish all our readers a Happy Holiday Season and a Healthy and Prosperous New Year.

### Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **17.Februar 2017**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

### Next deadline for **epi** Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of **epi** Information is **17<sup>th</sup> February 2017**. Documents for publication should have reached the Secretariat by this date.

### Prochaine date limite pour **epi** Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de **epi** Information est le **17 février 2017**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

### Report from the 81<sup>st</sup> Council Meeting in Berlin on 12<sup>th</sup> November 2016

M. Névant (FR)

The 81<sup>st</sup> Meeting of **epi**'s Council took place in a conference room in a hotel in downtown Berlin. The meeting was well attended.

The President opened the meeting by welcoming the Council members to Berlin and by asking Council to appoint two scrutineers. The President thanked those members who will not return to the next Council meeting for their work. The President then requested that Council observed a minute of silence in memory of Mr Leo Ryckeboer, former Vice-President of the Institute, who had passed away on 22<sup>nd</sup> September 2016. The President then suggested some changes to the agenda, as some matters initially scheduled for discussion were postponed until the next Council meeting. The amended agenda was adopted.

The minutes of the 80<sup>th</sup> Council meeting and the matters arising from said minutes were reviewed. The minutes were adopted with some editorial changes. Some of the actions points were still being pursued. The President presented his report and so did the Secretary General.

The floor was then given to Mr Raymond Lutz, Vice-President of DG5 at the EPO. Mr Lutz' presentation was focused on the EPO's strategy to cope with the steady growth of European patent applications (160 000 in 2015). Mr Lutz explained how the EPO managed to increase the number of search/examinations/oppositions dealt with in 2015 (+ 14% vs 2014) while maintaining a high quality in tasks performed. Mr Lutz in particular pointed out that the EPO received the ISO 9001 certification for the patent granting



process. At the same time Mr Lutz mentioned that a reduction of backlogs had been achieved thanks to the implementation of the Early Certainty from Search and Early Certainty from Examination programs. The goal for the EPO is to have a complete control of the following timelines by 2020: 6 months for a search and its opinion, 12 months on average for examination, and 15 months for a standard opposition. Mr Lutz concluded his presentation by indicating that the number of grants projected in 2016 is 90 000 (compared to 68 400 grants in 2015).

Both the President and the Secretary General presented their report. Points of interest such as an analysis of the Brexit situation and work done by the Reporting Group were also on the agenda of Council's meeting as reported below. A new member of the Professional Conduct Committee was elected, namely Mr Knut Thorvaldsen (NO).

Council then turned to the report of the Litigation Committee which report analyzed the consequences of the Brexit referendum on the UPC agreement. A letter prepared by the Committee had been sent by the **epi** President to the Preparatory Committee to express the wish of **epi** that the UPC enters into force as soon as possible. Various scenarii were presented to Council depending on whether the UK would ratify the UPC Agreement before leaving the European Union, and in particular if ratification would take place early in 2017. The Litigation Committee proposed that an opinion be sought from an EU Law expert to further explore the feasibility of the scenarii presented. The pros and cons of having such an opinion prepared were discussed at length, and Council eventually decided not to ask for an opinion.

Council then had to decide on proposals to amend the Terms of Reference (ToR) of the Online Communication Committee, of the Editorial Committee and the Electoral Committee. All proposed amendments were reviewed by the By-Laws Committee. These amendments were essentially intended to bring the respective ToRs in line with today's current practice. All the proposals were approved by Council.

The floor was then given to the Reporting Group which presented a set of proposals, in particular the creation of a Nominations Committee (NC), the role of which is to ensure that there is at least one candidate for each vacant position in the Board (in its format as of 2017, i.e. an "expanded" Presidium). The NC would be composed of 6 members to be elected by Council, all being or having been a member of the Presidium and not standing for election in the Board to be elected. Council approved the creation of the Nominations Committee and its corresponding Terms of Reference, and then elected the following members: Ms Selda Arkan (TR), Mr Luis-Alfonso Durán (ES), Ms Gabriele Leissler-Gerstl (DE), Mr Sylvain Le Vaguerèse (FR), Mr Claude Quintelier (BE) and Ms Mihaela Teodorescu (RO). The Reporting Group also proposed that the terms of the existing Committees be extended until the Warsaw Council meeting in November 2017 so that the new elected Council (in April 2017) can decide which Committee **epi** needs for the term 2017-2020. In this context the Reporting Group also proposed that except for Committees where there is in practice one member from each country, the Committees be populated by members having expressed their interest by sending a motivation letter and a CV. Both proposals were approved by Council.

The Reporting Group further proposed, in order to streamline the decision-making process, that Council can make decisions by internet voting. Rules for internet voting were also presented, which triggered an exchange of views. Council decided that members should be given the opportunity to express their view in a forum on the **epi** website (NB: which is up and running) so that a decision can be taken at the next Council's meeting.

The Treasurer presented his report: the 2016 adapted budget, showing a slight deficit (less than originally planned) was approved, and the provisional 2017 budget, also showing a slight deficit, was also approved. The Treasurer also indicated that a working group was studying the possibility to give all members of the Institute access to professional liability insurance; the Working Group intends to present a proposal at the next Council meeting. The Treasurer also asked Council to approve an amendment to Rule 154 EPC whereby a single reminder (as opposed to repeated reminders in the current version) would be sent to representatives having failed to pay the annual subscription. The proposed amendment was the result of a discussion with DG5. Council approved the proposal.

Council finally heard a report from Mr Chris Mercer (GB) on a proposed new **epi** studentship concept. The underlying idea is to facilitate EQE-enrolment in close collaboration with the EQE Secretariat and EQE Supervisory Board. In short, candidates are encouraged to apply to become **epi** Students at the start of their training. **epi** would check whether candidates (i) satisfy the requirements a set forth in article 11(1)(a) of the Regulation on the EQE and (ii) work under the supervision of a professional representative or work in a company whose residence or place of business is within the territory of a contracting state. If these conditions are met candidates shall be registered as **epi** Student and no further requirement should normally be asked by the EQE Secretariat when the time of registering for the pre-exam and the EQE comes.

Mr Mercer explained that the proposal would require (i) to adapt **epi** rules and by-laws, (ii) to create an "**epi** studentship examination Committee", (iii) to establish capacity and processes at the **epi** Secretariat and (iv) to establish a new fee structure for **epi** Students. This proposal was approved by Council.

The Secretary General then summarised the decisions and action points arising from the meeting and the President closed a long but nonetheless interesting meeting.

# **epi** becomes supporter of the Inventor Assistance Program (IAP)

P. Thomsen (CH)

### The program

he Inventor Assistance Program (IAP), a WIPO initiative in cooperation with the World Economic Forum (the Forum), is the first global program of its kind. It aims at facilitating to spur innovation from the initial phases towards new and useful products and processes by helping under-resourced inventors and small-businesses in developing countries to obtain patent protection and therefore attract further financial or collaboration resources. The IAP aims at matchmaking eligible inventors and small businesses having limited financial means with patent attorneys, who provide pro bono legal assistance to secure patent protection for promising inventions. After a pilot phase in 3 countries (Colombia, Philippines and Morocco), the IAP was rolled-out globally with a ceremony at WIPO in Geneva on October 17, 2016. epi is one of the presently six supporters of the program. epi will play a role in promoting the program and helping to recruit Patent Attorneys who would be willing to provide their services in the framework of the IAP, in particular by assisting the inventors selected within the program to obtain patent protection in Europe for their invention.

### How does it work?

Inventors or a small business resident in a participating developing country have to demonstrate a basic understanding of the patent system in order to apply to the IAP. This requirement is considered fulfilled if the inven-

tor has already filed a patent application or has obtained the certificate of the online course for inventors available on the IAP webpage. Secondly, the applicants to the IAP need to prove that their income is below a certain threshold and that their invention meets some eligibility criteria adopted by national authorities of the countries where the IAP has been implemented. If those criteria are fulhe enwhereas European Patent Attorneys will become essential whenever protection is sought for European countries. If you are interested in participating in the IAP as a European Patent Attorney, please contact **epi** via sadia.liebig@ patentepi.com or treasurer@

in the IAP as a European Patent Attorney, please contact **epi** via sadia.liebig@ patentepi.com or treasurer@ patentepi.com. Further information on the program can be found on the WIPO webpage http://www.wipo. int/iap/en/. We will convey more details about the IAP in a future issue of **epi** Information.

by the national Screening Board and the inventor will be matched by WIPO with a patent attorney among those who volunteered. The patent attorneys in the roaster managed by WIPO are considered having suitable skills since they need to be allowed to practice before their national patent office. The patent attorney works closely together with the inventor/applicant to draft patent applications and prosecute them up to grant. Whereas it is expected that the patent attorney's service is offered free-of-charge, the inventor/applicant still has to bear the expenses of official fees for filing and prosecuting a patent application. By participating in the program, pro bono attorneys provide a free kickstart to the use of the patent system for inventors and small businesses from developing countries. The precise scope of services provided under the IAP will be defined on a case-by-case basis, through agreement between the volunteer patent attorney and the applicant. Therefore, the scope of representation and the services offered may differ from one case to another.

Most eligible inventors and small businesses will be supported

by local patent attorneys from their countries of residence,

filled, the invention shall be accepted into the program

### How to participate as a pro bono patent attorney?



### Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair



T his report completed on 2 November 2016 covers the period since my previous report dated 12 August 2016 published in **epi** Information 3/2016.

The EPPC is the largest committee of the **epi**, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with,

practice under (1) the EPC, (2) the PCT, and (3) "the future EU Patent Regulation", including any revision thereof, except all questions reserved for the Biotech committee.

The EPPC is presently organised with six permanent subcommittees (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, and Unitary Patent). Additionally, ad hoc working groups are set up when the need arises. Thematic groups are also being set up.

### **1. European patent with unitary effect in the participating Member States**

The entry into force of the unitary patent system requires ratification or accession of 13 States to the UPC Agreement, including Germany, France and the UK. As mentioned earlier, the outcome of the "Brexit" referendum has created some uncertainty about the ratification by the UK. The entry into force of the unitary patent system will most likely be delayed.

The Select Committee held its  $20^{th}$  meeting in Munich on 25 October 2016.

The Committee noted the results of a questionnaire on national measures accompanying the implementation of the Unitary Patent.

It further noted an oral report given by the Office on the technical, namely IT, implementation of the Unitary Patent and on pre-certification of the Unitary Patent under ISO 9001.

During a closed session, the Committee approved administrative instructions relating to the distribution of fees amongst the participating member states and noted that this completed the legal preparation of the Unitary Patent. The next meeting would take place at the latest in March 2017 or earlier, depending on the development of the question of the entry into force of the unitary patent system at the political level, within the framework of the European Union.

In the meantime, the series of UP/UPC seminars initiated by **epi** has successfully continued, in Milan (25 October), in Prague (8 November) and Hamburg (7 December). The schedule of the next seminars is still under review.

### 2. Meeting with TWPAA

On 12 September 2016, the undersigned participated in the meeting with a delegation of the Taiwan Patent Attorneys Association and made a short presentation on the unitary patent.

### 3. Guidelines sub-committee

The **epi** delegates to the SACEPO/Working Party on Guidelines received the draft 2016 Guidelines for review in preparation of the annual meeting in the autumn. The sub-committee met on 15 and 16 September 2016 to discuss the draft and set up a list of further proposed amendments.

The lists have been sent to the EPO, in advance of the meeting of the SACEPO/Working Party on Guidelines that took place on 14 November 2016.

### 4. ICT thematic group

**epi** delegates of the Information and Communication Technologies (ICT) thematic group of the EPPC met again with EPO representatives (mainly Directors in that field) on 21 September 2016. The report had not yet been finalised at the time of preparing the present report.

It can be said to be a positive result of these meetings that the group actively contributed to the preparation of the **epi** comments of the draft 2016 Guidelines and generally welcomed the recent and proposed amendments of the Guidelines relating to computer-implemented inventions.

### 5. PCT Union Assembly

The PCT Union Assembly met in Geneva, as one of the 56<sup>th</sup> Series of Meetings of the Assemblies of the Member States of WIPO that took place from 3 to 11 October 2016.

The Assembly essentially appointed the Turkish Patent Office as ISA and IPEA, and approved the amendment of Rule 45*bis*. 1(a) to extend the time limit for requesting supplementary international search from 19 to 22 months from the priority date.

The PCT Assembly documents are available on the WIPO website :

http://www.wipo.int/meetings/en/details.jsp? meeting\_id=39951

### 6. TOSC 83

The 83<sup>rd</sup> meeting of the Technical and Operational Support Committee took place on 3 November 2016. The agenda includes two items directly relevant to the work of the EPPC, namely Quality at source and Quality at the EPO. Bogoljub Ilievski and the undersigned will represent **epi**.

### 7. SACEPO/WPR 15

A meeting of the SACEPO/Working Party on Rules has been summoned on 15 November 2016. In addition to several agenda items for information, the agenda includes four main topics:

2. Corrective actions – clarification of Rules 51 and 162 EPC (aiming at re-establishing the EPO's long-standing practice in view of decisions T 1402/13 and J 11/12)

3. Fee payment methods (update on the changes as from 1 November 2016 [see OJ] and changes expected in the first half of 2017: (i) Rejection of a debit order ("Validation tool") (ii) Online management of deposit accounts (iii) Applicability of Automatic Debiting to the current exceptions provided by the ADAs)

4. Entry into the European Phase (preliminary discussion on the possibility to delay entry in the European phase from 31 to 34 months, with a corresponding reduction of the period for replying to the Rule 161/162 communication)

5. Update on Early Certainty (with further proposals: telephone interviews as first action; positive statements and suggestions; summons to Oral Proceedings as first action in examination; preliminary opinion accompanying partial search results; further harmonisation in the treatment of auxiliary requests in examination)

### 8. CPL 47

The 47<sup>th</sup> meeting of the Committee on Patent Law took place on 21-22 November 2016. The agenda includes two EPPC-related items:

- The patentability of plant-related inventions
- Amendments to the Implementing Regulations to the EPC Clarifications of Rule 51 and Rule 162 EPC (see above).

### 9. G1/16 (disclaimers)

Board 3.3.09 referred in decision T437/14 three new questions to the Enlarged Board of Appeal, relating to disclaimers, more precisely relating to the relationship between G1/03 and G2/10:

1. Is the standard referred to in G 2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?

2. If the answer to the first question is yes, is G 1/03 set aside as regards the exceptions relating to undisclosed disclaimers defined in its answer 2.1?

3. If the answer to the second question is no, i.e. if the exceptions relating to undisclosed disclaimers defined in answer 2.1 of G 1/03 apply in addition to the standard referred to in G 2/10, may this standard be modified in view of these exceptions?

The EPPC will consider at its next meeting (17 November 2106) whether to set up a dedicated working group for preparing an *amicus curiae* brief.

### Guidelines

The EPPC urges the readers of this journal to address to its Guidelines Sub-Committee at eppc@patentepi.com

any comments regarding the Guidelines for Examination in the European Patent Office https://www.epo. org/law-practice/legal-texts/guidelines.html or suggestions to improve them.

The same applies to the Guidelines for Search and Examination at the EPO as PCT authority https://www.epo.org/law-practice/legal-texts/ guidelines-pct.html.

### Report of the Harmonisation Committee

F. Leyder (BE), Secretary



This report completed on 2<sup>nd</sup> November 2016 covers the period since my previous report dated 12<sup>th</sup> August 2016.

The Harmonisation Committee deals with all questions concerning the worldwide harmonisation of Patent Law, and in particular within the framework of WIPO.

### 48th Session of the WIPO General Assembly

The 48<sup>th</sup> session of the WIPO General Assembly was held in Geneva, from the 3<sup>rd</sup> to the 11<sup>th</sup> October 2016. **epi** was not represented.

The Assembly took note of the report of the Standing Committee on the Law of Patents.

The meeting papers, including the draft reports, are available on the WIPO website:

http://www.wipo.int/about-wipo/en/assemblies/ 2016/a\_56/agenda.html

### 25<sup>th</sup> Session of the SCP

The 25<sup>th</sup> session of the SCP will be held in Geneva, from the 12-15 December 2016. **epi** will be represented by the undersigned then by John Brown. The meeting papers are or will be available on the WIPO website: http://www.wipo.int/meetings/en/details.jsp? meeting\_id=41286

The draft agenda comprises the following items:

- Report on the international patent system
- Exceptions and limitations to patent rights
- Quality of patents, including opposition systems Sharing session on examples and cases relating to assessment of inventive step

- Patents and health

Sharing session among Member States on national experiences relating to use of health-related patent flexibilities for promoting public health objectives or the challenges thereof

Confidentiality of communications between clients and their patent advisors<sup>1</sup>

Transfer of technology

Sharing session on the relationship between patent systems and transfer of technology as well as examples and cases presented by experts from different regions with a view to deepening the understanding of the impact of sufficiency of disclosure on transfer of technology

Proposal of the Group of Countries of Latin America and the Caribbean (GRULAC) on the revision of the 1979 WIPO Model Law for Developing Countries on Inventions

### Discussions on Substantive Patent Law Harmonisation in Group B+

The meetings of Group B+ do not involve observers, however some documents have been made available on the EPO website during the period reviewed:

http://www.epo.org/news-issues/issues/ harmonisation/group-b-plus.html

Thus, we can report that the Group B+ Plenary meeting took place on 4<sup>th</sup> October 2016, on the fringe of the WIPO General Assembly. The meeting notes have been published, as well as an agreed statement:

[...] The Group agreed that [the Sub-Group on Patent Harmonisation and its associated workstreams] should continue their work, and that the Sub-Group should continue developing proposals with a view to producing a finalised consultation document.

[...] Group B+ reaffirmed the importance of continued engagement with all interested stakeholders. As a next step towards finalising the consultation document, the Group agreed to hold a user symposium to allow a wider range of users to contribute to the development of proposals.

The Group also addressed the issue of privilege in communications between intellectual property advisors and their clients. [... The] Group agreed that Switzerland should lead a group of delegations to undertake work towards a multilateral solution.

International substantive patent law harmonisation is on the agenda of the next meetings of the SACEPO/Working Party on Rules (16<sup>th</sup> November 2016) and of the Committee on Patent Law (21<sup>st</sup> November 2016), in both cases for information.

<sup>1</sup> In this regard, my previous report (published in **epi** Information) already invited **epi** members to provide to this Committee the references (and a copy) of any court case in which privilege created difficulties, for submission to WIPO and inclusion in the compilation of cases. It would be useful to demonstrate that absence or limitation of privilege can create real difficulties, as some delegations suggested that discussion on this agenda item be discontinued.

### Report of the By-Laws Committee

P. Moutard (FR), Chair

### **1. BLC meetings and the topics discussed during these meetings**

Two BLC meetings took place recently, the 1<sup>st</sup> one on 31 August 2016 and the second one on 13 October.

Following topics were discussed:

- possible amendments to R.154 EPC and to internal regulations of the **epi** regarding the payment of the membership fee;
- the Terms of Reference of the Editorial Committee, the Electoral Committee and the Online Communication Committee;
- the new rules governing the **epi**-studentship and the formulation of the Terms of Reference of a new committee in charge of studying the admission of candidates to the **epi**-studentship;
- the Terms of Reference of a new committee in charge of seeking candidates for positions at the Presidium or in the Board; this proposal, as well as the following ones, are from the Reporting Group (RG);
- the possibility of implementing Internet voting for Council to take decisions outside Council meetings;
- the possibility of shifting the terms of the committees from the spring meeting of each election year to the autumn meeting of the same year;
- a new method to select candidates for the committees.

We make here below a short presentation of the state of these different topics.

### **2. Rule 154 EPC and amendments** to epi internal regulations

The BLC revised the **epi** internal regulations (**epi** 3.1.1, 4.2.1, 4.3.2 - 4.3.4, 5.1.1 - 5.1.5 and 5.2.2) which should be amended in accordance with the reform of Rule 154 (1) EPC.

The discussions were based on the versions of the regulations that had been previously prepared by the Legal Advisor and circulated among all members of the BLC.

Due to internal changes in the Legal Division of the EPO, the amendment to Rule 154 EPC – and to the corresponding **epi** provisions - are postponed to 2017. The work already done by the BLC will form a good basis when the amendments to said Rule are further discussed with the EPO.

# **3.** The terms of Reference (ToR) of the Editorial Committee, the Electoral Committee and the Online Communication Committee.

These 3 provisions were amended based on requests from, and in cooperation with, the respective committees. All the amendments will be presented to the Berlin Council meeting for decision.

**3a.** The BLC revised the amendments proposed by OCC to its ToR. The amended ToR will be presented at the next C81 Council meeting. The FR and the DE translation of the ToR will be prepared after the Council meeting (provided that the text is approved).

There was a need to amend the Terms of Reference of the OCC, in particular further to the decision of the Council (C80) to entrust the OCC with the task of reminding the EPO that fax reception should not be dismantled until backup measures have been found satisfactory. This task is not clearly compatible with the existing Terms of Reference. There was also a need to adapt the ToR of the OCC to new communication tools, in particular those which should be implemented by the UPC and, possibly, the ePCT.

**3b.** The BLC revised the amendments proposed by the Electoral Committee to its ToR. These amendments concern the adaptation of the tasks Electoral Committee to the new possibilities of e-voting.

**3c.** The BLC also revised the amendments proposed by the Editorial Committee to its ToR.

### 4. Rules governing the epi Studentship

The BLC revised the Rules governing the **epi** Studentship and provided some comments for the Working group (WG) on "Early Registration" in order to enable the WG to finalize the document.

## 5. Terms of Reference of the epi studentship admission committee

The BLC revised the ToR of this new committee and made some recommendation.

### 6. Terms of Reference of the Nominations Committee

The BLC revised the ToR for the Nominations Committee proposed by the RG. This committee would look for candidates for positions belonging to the Presidium or to the Board.

### 7. Internet voting

The BLC revised the proposal of the Reporting group regarding the Internet voting and also prepared an alternative version.

Since there are many articles in the BL (see list here below) that should be amended due to Internet voting, the BLC decided to draft the Articles after the Council decision in Berlin.

It will certainly be necessary to elaborate further regulations; however the problems that will be met by this new procedure are impossible to predict now.

### 8. Shifting of the term of the Committees

The BLC discussed the proposal of the Reporting Group concerning the shifting of the term of the Committees. Generally, there is no inconsistency in shifting the term of the Committees according to Art. 18.2 BL. Nonetheless, the Board (Art. 7.2 BL), the Disciplinary Committee (Art. 11 FR) and the Internal Auditors (Art. 20 BL) have to be elected at the same Council meeting. The BLC recommended to inform the Committee Chairs shortly after the decision of Council in Berlin.

### 9. Populating the committees

The BLC also discussed the proposal of the Reporting Group concerning new rules for candidates applying for being members of committees. 3 different proposals have been elaborated by the BLC, including an early application, with or without further details – like a cv – from any candidate for some or all committees.

### **Next Board and Council Meetings**

**Board Meetings** 96<sup>th</sup> Board meeting on 11 March 2017 in Manchester (GB)

### **Council Meetings**

82<sup>nd</sup> Council meeting on 24/25 April 2017 in Munich (DE) 83<sup>rd</sup> Council meeting on 18 November 2017 in Warsaw (PL)

### Forthcoming **epi** Educational Events

### epi CPE Seminars - Updated Event Calendar

21 February 2017	Hamburg (DE)	epi Seminar »Opposition & Appeal« supported by the EPO
16 May 2017	Rom (IT)	epi Seminar »Opposition & Appeal« supported by the EPO
26 September 2017	Dublin (IE)	epi Seminar »Opposition & Appeal« supported by the EPO
21 November 2017	Budapest (HU)	epi Seminar »Opposition & Appeal« supported by the EPO

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### Tutors' Report on the EQE 2016 Papers

L. Ferreira (PT), A. Hards (DE), M. Mackett (BE), H. Marsman (NL), S. van Rijnswou (NL), and R. van Woudenberg (NL)

**E** ach year in October, the European Patent Academy and the **epi** arrange a meeting between EQE tutors and the Examination Committees. The goals are to discuss last year's papers, to improve future EQE's by openly exchanging ideas and to help tutors prepare candidates for next year's exam.

The Examination Board has kindly given the tutors permission to publish their own report of the important points so that candidates can more easily find this information. In addition, the comments can greatly assist when reading and interpreting the official EQE Compendium.

This year's meeting was held in Munich on October 21. The participant list showed 84 registered tutors, 20 registered Committee and Board members, and 8 further registered EPO and **epi** members (Academy, EQE secretariat, **epi**).

This Tutors' Report appears each year in the end of year edition of **epi** Information.

It contains the following sections:

- 1. Overview of the passing rates in 2016
- 2. General remarks
- 3. A E/M
- 4. B E/M
- 5. A CH
- 6. B CH
- 7. C
- 8. D
- 9. Pre-Exam

10. The combined AB Papers (EQE 2017)

On behalf of the tutors present in Munich, I would like to thank all the members of the Examination Board and Committees for their openness, for listening to our opinions and comments, and for providing their feedback thereto. This meeting is our yearly opportunity to learn from each other. My thanks also to the tutors who asked questions and contributed to the discussions.

My special thanks to Harrie Marsman, Andrew Hards, Luis Ferreira, Margaret Mackett and Sander van Rijnswou for finding time to prepare the individual paper summaries.

We all wish you good luck in 2017,

Roel van Woudenberg (Editor)

### 1) Overview of the passing rates in 2016

In 2016, 619 candidates out of 821 (75%) passed the Pre-Exam, and 514 candidates passed the Main Exam out of 1669 who took at least one paper. The official results for each paper, as published on the EQE website and dated 19 August 2016, are as follows:

EQE 2016	#Candidates	PASS	COMP.FAIL	FAIL
Pre-Exam	821	75,40%		24,60%
A e/m	532	52,63%	10,15	37,22%
B e/m	545	68,44%	8,62%	22,94%
A ch	324	62,65%	6,79%	30,56%
B ch	259	55,98%	7,34%	36,68%
С	1133	40,16%	7,86%	51,99%
D	1000	42,30%	10,80%	46,90%

#### 2) General remarks

#### Introductions

In introductions by Jakob Kofoed (Chair of the Examination Board), Paolo Rambelli (**epi**) and Giovanni Arca (Academy), the following items were mentioned:

The EQE is an EPO-**epi** cooperation, aiming to have a fair exam, with the same level every year (not too big fluctuations). The EQE is meant to let people pass who are fit to practice

This meeting aims to also provide an understanding of the new AB (one-for-all). The **epi** and the Academy also recorded a webinar about the new AB format, in the form of an interview with Nicolas Favre, available as of mid November on the website.

The EQE has been largely the same since it was introduced for initially 20-25 candidates. The intention is to modernize it while maintaining the quality and guarantee high pass rate.

The Academy published the "Terminology training manual for professional representatives" and an accompanying book for teachers – order via EPO website. It clarifies terminology for an EP patent training, and used a.o. EQE papers and Examiner's Reports. The manual can be ordered free of charge via http://www.epo.org/learning-events/ materials/terminology-manual.html.

#### Benchmarking

Nicolas Favre (**epi**; chairman EC I) commented on the benchmarking.

Benchmarking is already used for years: committee members sitting the main papers of the EQE in the EQE exam hall with the candidates. This year also EQE-passed EP attorneys participated (invited via an **epi** mailing), without specific preparation.

Ideally, a benchmarker gets around 50 marks. The results of the benchmakers are used to gauge the answers, where it makes a difference for the candidates. The obtained grade is not given to the benchmarker, and the benchmarking is fully anonymized.

Benchmarkers are not used for the Pre-Exam, as the answers there are either black or white. It was asked by a tutor whether it would not be useful to identify possibly ambiguous or unclear questions, but it was not considered useful.

### 3) A – E/M by Luis Ferreira

EC I (AB EM) representatives: Christophe Chauvet (EPO), Sabine Hillebrand (EPO), Tom Vermeulen (EPO).

The paper was about a "siphon" or, more precisely, about improvements to a conventional siphon. It was not overlooked by the Examination Committee that siphon has the same wording in English, German and French, and it was probably anticipated that this would give candidates a familiar everyday starting point. The points addressed by EC were mostly contained in the Examiner's Report, but particular points were emphasised, as follows.

As usual in E/M papers, the prior art and the invention were clearly mapped into the drawings (Fig. 1 vs. Fig. 2-4). An approach based on the functions performed by the different parts (connecting, draining, storing, blocking) provided a sound basis for understanding the paper and the invention to be claimed.

It is noted that a small deduction was foreseen for mentioning that an aesthetic problem is solved – however, positively, no candidate relied purely on this.

There was a piece of "private" prior art - Fig. 1C – which was not expected to be cited. This was used also as a means to look for other aspects having a more nuanced view of the candidates' competencies and training. Although it would not be necessarily a good idea to reveal "internal" prior art in the real world, the candidates were not penalized by this. Only a "couple" of candidates actually identified this "internal" prior art as CPA. However, compounded with other mistakes, this could be an indicator of not yet being fit to practice.

Although the mistakes present in the Report were actually not that common, only roughly a third of the candidates came up with the correct answer of feature (d2). This was not fatal however and other points could be obtained from the rest of the paper. Taken into consideration the average score of the exam, 5 point differences had a large impact of "saving" a number of candidates, provided if no other major mistake was committed.

It was mentioned that a wall 'ending freely' – which covers all embodiments but, in fact, is more limited (for example, a wall could go to the bottom but have holes to accomplish its function) – had no deduction.

It was expected that an inventiveness discussion would start from conventional prior art and not be described in the context of private prior art e.g. how the R&D Dept. reached the invention, etc.

An approach based on the different functions performed by the different parts, recognising how these functions were split in a different way compared to the prior art again was a sensible way to tackle the paper.

It was commented on how the two-part is getting to be less and less important – depends on the papers, sometimes it is crystal clear it should be used, but often may not be important or even required. It may even be said that more mistakes appear when candidates try to draft in 2-part form.

Lack of clarity was as important (-30) as lack of novelty (-30) and this may reflect a trend. It certainly was noted how poorly drafted claims will normally accompany a patent application throughout examination and opposition.

### 4) B – EM by Margaret Mackett

EC I (AB EM) representatives: Christophe Chauvet (EPO), Sabine Hillebrand (EPO), Tom Vermeulen (EPO).

This year's paper, the last of its kind, related to raising traffic awareness with the invention having two embodiments, both of which needed to be covered with any amendments made to the claims.

A summary of the invention was presented followed by an analysis of the three prior art documents and the objections raised in the Communication.

The invention had two embodiments, namely, a garage exit with pavement sensors for pedestrians and a display for the driver in the garage, and, a weight sensor for the vehicle with warning signals for the pedestrians.

For the prior art, D1 was directed to a garage exit but having only a driveway sensor; D2 was directed to a hospital exit with weight and pavement sensors; and D3 was directed to a driveway crossing in an alley having vehicle and pedestrian sensors.

The proposed draft claims were based on a combination of claims 1, 4 and 2 (in part) as originally filed and needed to be revised to meet the requirements of the EPC.

In the letter of reply, candidates needed to address intermediate generalisation and why it was allowable as only claim 2 (in part) was included in new claim 1. As usual, full basis for the amendments needed to be provided and arguments needed to be provided to address all of the objections raised in the Communication. In addition, candidates were expected to argue for any changes in claim dependencies.

More information can be found in the Examiners' Report published in the Compendium.

### 5) A – Ch by Harrie Marsman

The presentation was given by Nicolas Favre (chair of EC-I; **epi**), Wim van der Poel (Coordinator; EPO), Harald Schmidt-Yodlee (EPO) and Josep Enric Giménez Miralles (EPO). Mr Giménez Miralles was the main drafter for paper A. Mr Schmidt-Yodlee was the main drafter for paper B.

Further, Kaisa Suominen gave a summary of the chemistry papers for the AB Mech group.

Passing rates for paper A 63%; for paper B 56%.

Paper A was dealing with biodegradable nanoparticles and the use thereof in the oral administration of insulin.

The marking was based on 70 marks for the independent claims, 15 for the dependent claims and 15 for the description.

The problem and solution were already sketched in the first paragraphs of the paper.

The problem has two aspects: the passage through the stomach and the absorption in the intestines.

Important aspects are the polymers, wherein the length of the alkyl groups is relevant for the degradation. In addition, a process for the preparation of the polymers is described, with emphasis on the pH.

There were 2 documents of prior art both dealing with particles having entrapped therein insulin. D1 discloses in detail an anionic polymerization method. The claims of D1 were good examples on how to claim in the field of the paper.

D2 is from the client and discloses also a preparation method using different pHs. D2 discloses that when using a pH of 1.9, the polymers are not stable. Moreover, D2 teaches that insulin behaves different from other peptides.

D2 contains quite some teachings which was to be used to come to good claims.

In the client's letter, it is taught that stabilizers in combination with the alkyl chain length have unexpected effects. It was important to realize that not only the exemplified dextran stabilizer could be used but any pharmaceutically acceptable stabilizer, since a number of stabilizers were mentioned in the client's letter. If the stabilizer was not present in the product claim, this caused major novelty problems with D2.

The paper clearly contained an indication of which types of claims were expected.

On the nanoparticles, it was important to realize, which features needed to be restricted and which features could be kept general. Thereto, there were clear remarks in the letter, which were illustrated in the examples and the figure.

When you used product-by-process language to define the product, you could only get 22 marks instead of the 32 marks for a claim that used only product language. The important point was to use the term "non-covalent complex".

On the method claim, the only method described is dealing with anionic polymerization. It was advised to use the wording from the client's letter and add the features of having a stabilizer present and keeping the pH 2 or lower. If you made the same mistake in the product and the process claim you would not get a double penalty. It was indicated by Mr Favre that this would also apply for future papers.

When you have two claims in one category, the worst one is marked. Candidates should make a clear decision where they want to go for.

Two points were emphasized by Mr Favre "also with an eye on future papers": the categories of the claims expected are in the letter; and read the letter of the client up to what the invention is, read the prior art and continue with the client's letter.

Interesting remarks on paper B which may have a bearing on future papers B: it is not expected in the new format of paper B to completely rewrite the claims.

The remarks in the paper are intended to help the candidates to come to the desired solution. These are not made to complicate matters. In this paper the Examiner raised quite a number of clarity objections. It was not necessary to consider that the Examiner is always right. You were allowed to counter some of the clarity objections, based on the application and especially definitions therein.

For support in the application as filed, it is needed to give also arguments as to why the various passages on which the amendments are based could be combined.

### 6) B – Ch by Andrew Hards

EC I (AB CH) representatives: Nicolas Favre (**epi**), Wim van der Poel (EPO), Harald Schmidt-Yodlee (EPO), Josep Enric Giménez Miralles (EPO).

This year's paper B was the last of a long series of highly successful EQE chemistry papers that have been used to train candidates in the profession for decades. As you know, this long and rich tradition is ending, very much to the detriment of chemical practitioners. As of next year, there will be a joint mechanics/chemistry paper, which will likely no longer cover important chemical aspects such as productby-process claims, Markush groups or second medical use claims. How can a practitioner in the chemical arts be cleared as fit to practice, if such essential elements are not even on the curriculum? We will see how the committee tackles this daunting task in next year's exam papers A and B.

However, not all is changing for the worse and we might see some new ideas and fresh concepts injected into the examination. The intermarriage of mechanics and chemistry might help to cross-pollinate the different professions and lead to a more unified concept regarding issues such as ranges and the requirements of Art. 84 EPC.

For all those chemists preparing for the exam, beware of functional definitions in mechanical devices. I doubt that there will be a rude awakening, since the first exams will be drafted by chemical committee members to ensure that they are comprehensible at the most basic level. Nevertheless, drafting or amending such functionally-defined claims may be challenging to chemical patent candidates that have never laid hands on mechanical features (although this itself might not be good preparation for life as a patent attorney). To facilitate those taking the exam 2017, most likely the elements relevant to the solution might be found in the text itself (maybe even in Paper A), so candidates must not attempt to find quixotic mechanical terminology, they just need to spot the decisive features.

Personally, I would also expect the trend toward increased emphasis on argumentation to continue. Naturally, finding the right features to amend a claim is paramount in Paper B, but there are hefty points to be earned for arguing each step, e.g. of the problem-solution approach. In addition, the argumentation should go beyond mere rote phrases; points can be earned for spotting facts that can be interwoven into the argumentation, such as push or pull arguments for inventive step.

Anyway, this year's paper B was about a dog or cat repellent that can be applied to walls and fences. The expected solution was to restrict the paint to a composition wherein the cyclohexylurea derivative is embedded in a polymer matrix and has a specific Markush formula.

Plenty of marks were given for arguing that the clarity objections were overcome and the basis for the amendment. In addition, novelty and inventive step argumentation (with showing how the problem is credibly solved) afforded 40 marks. Thus, 70 marks were awarded for argumentation!

As so often in the past, the applicant's letter contained suggestions that would violate Art. 123(2) EPC. However, in contrast to past papers, the solution deviated slightly from the applicant's wish in that he desired ready-to-spray dispersions. Candidates had to distance themselves from these wishes, which many found difficult, and perhaps rightly so, since the applicant's economic goals should normally be respected.

However, in line with previous papers, the effects are important pointers to the solution and by referring to working example 3, candidates could derive that the polymer matrix embedded paint had superior adhesion to the wall and thus longer efficacy. As always, it is thus important to cross-reference the working examples for advantageous effects. How such effects will play out in the joint mechanics/chemistry paper next year will be interesting to follow. Good luck!

### 7) C – by Sander van Rijnswou

EC II representatives: Celia Martinez Rico (EPO), Jen Le Mière (**epi**), Christoph Ritter (EPO).

The Exam Committee for Paper C 2016 discussed the paper and answered questions.

The Committee explained that re-use of the cooling device is an important aspect of the invention. For users of cooling devices re-usability makes an important different in the cost of using the device.

#### Annex 2

In the annexes A2 was an intervening application. An analysis of the dates was expected.

### Annex 5

A discussion on the public availability was expected. One mark was available for saying that further evidence could be provided.

### Annex 7

The Committee wanted to do something different with A7. Attorneys spend a lot of time comparing text, and this aspect is hardly tested in paper C. Originally, the client's letter did not give a hint in which section A7 differed from the granted patent. This hint was later added, and explains why A7 comes across as a bit confusing.

Effective dates section was done quite good and is straightforward.

### Claim 1

For the novelty A2 attack, a link with A1 had to be made to explain that A2 satisfies the definition of thermally active composition.

Both a novelty 54(3) and an inventive step attack was expected. The novelty attack under 54(3) is considered a weak attack since it could easily be overcome by adding a non-essential feature. If the inventive step attack for claim 1 is only made for dependent claim 3, a candidate would get most of the marks available for claims 1 and 3; At most 3 marks may be lost. The lost marks relate to the technical effect which is different for claim 1 and claim 3. Full marks could be gained by only doing the inventive step attack for claim 3, and explaining that the attack also applies to claim 1, but that the technical effect has to be modified.

It was remarked that both for claim 1 an additional attack was required because the attack could be overcome, but for claim 2 no additional attack was required because the attack could not be overcome. The Committee indicated that it is not the intention that candidates need to ask for each claim if the attack can be overcome in opposition or not. However, it was emphasized a few times that no recipe can be given. Candidates each year have to find the way of the paper. Future committees are free to do it differently.

### Claim 2

The added subject matter attack for claim 2 was discussed. In particular, the Committee discussed if it was clear that no additional attack was required for claim 2. According to the Committee, if an attack cannot be overcome, we do not expect another attack. There was no way to overcome the Art.123(2) attack on claim 2. Some candidates were not able to distinguish between added subject matter and lack of priority, as added subject matter attacks were received on claim 6 on the basis that it was absent in the priority document.

A question was asked regarding the difference between paper C and D with respect to added subject matter. According to the question, paper D assumes that a date must be accorded to a claim with added subject matter, and additional attacks are required, but in paper C for a few years now it is assumed that no date is assigned to a claim with added subject matter. The Committee promised to discuss the point internally.

The Committee advises candidates to first attack all claims before considering if an additional attack is possible on a claim that contains added subject matter. In this paper, no additional attack was possible, but also the attack could not be overcome. If a candidate thinks he can do it, he should leave it to the end.

The Committee explained that they cannot make marking sheets for every possible attack, because an objective marking is needed.

Candidates generally do very well on added subject matter attack and receive a lot of marks for it.

### Claim 3

There were two possible closest prior arts: A3 and A5. In real life, multiple closest prior arts do occur, but candidates are in an exam situation and need to pick the best attack. The Committee wanted to get away from past papers that gave the impression that purpose is the sole determinant of closest prior art. Both A3 and A5 have the same purpose, so that in this case an examination of the structural features is needed.

Attacks that started off from a different prior art could get marks, if the attack makes sense and is well reasoned.

Closest prior art needs to be reasoned. We need to see your thinking. Why did you choose this attack and not another? They must explain why they choose a closest prior art. The Committee did not answer how many marks there are available for closest prior art argumentation, but did mention that a candidate who never argues his closest prior art selection could still pass the exam.

Only positive arguments are required for CPA selection, not negative ones. The Examiner's report does mention negative reasons, i.e., why some documents cannot be the closest prior art, but these are for completeness and are not expected from the candidates.

### Claims 4 and 5

These claims were done quite well.

### Claim 6

This claim is anticipated by A2 because it inherently has the claimed property. Novelty and inventive step attacks starting from A4 were also accepted. The Committee was generous in allowing different attacks for this claim.

The Committee drew attention to the examiner's report for claims 1 and 5 which gave a lot of explanation of what is expected in a good inventive step attack.

### 8) D – by Roel van Woudenberg

EC III representatives: Dimitrios Roukounas (**epi**), Charlotte Nessmann (EPO), Magali Degrendel (EPO – main drafter DI), Gabriele Gislon (**epi** – main drafter DII).

### **General remarks:**

This D paper got a high pass rate again, even though not as high as in 2015. But there is also still very badly scoring people, with very big mistakes. This year no major issues were missed by all candidates.

The Examiner's Report indicates that candidates are reminded that they should pay attention to the way the questions are asked and should not simply repeat information from the paper in the answer. Repeating information per se is not awarded any points.

The Committee is thankful for all the questions, as it helps the committee too.

No answers will be given to questions directly addressing the number of marks – but actually many answers given indicating that a certain item was needed or not to get marks

There is no intention from the Committee to put the DI questions in a multiple-choice or True-False form, despite some rumours.

#### DI

It was asked whether the amount of PCT in DI this year let to a lower DI score. This was not the case: this paper shows the same DI average as in 2014 and 2015. Further, PCT is very important. Note that only 1 Q was really a PCT question, needing PCT provisions for answering; all others were Euro-PCT questions for which the EPC was needed for answering.

The Examiner's Report indicated that surprisingly many candidates failed to apply the 10-day rule of R.126(2) correctly. No statistics is available, but the markers commented about this.

The Exam Committee emphasized that too many candidates loose points on basic topics such as R.126(2).

#### Q.1 – appeal:

Q.1 was the best answered question from this paper.

The numbering of the questions as a), b1), b2) is meant to .clarify which parts belong to which "preamble"

Many candidates missed the recent amendment of R.103 (refund of appeal fee) and consequently answered wrongly.

R.132(2) was needed for full marks when indicating that the time limit would be at least 2 months. In response

to a question of a tutor whether the Boards is not free to deviate from R.132(2) as it would be bound by its Rules of Procedure, the Committee answered that R.132(2) also applies to time limits set by the Boards of Appeal.

### Q.2 – languages for PCT applications:

Q.2 was not so well answered.

Most did validity of priority correctly.

But language of the PCT application gave problems: transmittal to IB and translation for EPO as ISA.

Candidates were expected to understand that "filed online" did not need to be further addressed, as the method of filing has nothing to do with the real topic of the question (language issues). Tutors commented that it is usual that a candidate uses all information in the question, and would thus comment on it. If they did, they could have attracted bonus marks: marking is always done in favour of the candidate, if a correct but non-expected answer is given.

Although the answer to Q.2-b) in the Examiner's Report indicates also Art.16(3)(b) PCT and Art.152 EPC (in connection with the EPO being ISA, EPO-WIPO agreement OJ 2010, 304), these were not needed for full marks.

No specific article or page of OJ 2010, 304 was needed (EPO-WIPO agreement).

The Committee emphasized that the Examiner's Report's Possible Solution has no teaching function. Requirement as to how complete the legal basis needs to be may be different in a future year.

### Q.3 – direct entry into national phases; early entry into the EP regional phase

As it was not clear from the PCT Newsletter and the PCT Gazette whether the international filing date or the entry date was the relevant date for the old or new provisions of Lithuania to apply (national route closed per 4/9/2014; was filed before, entry was after), both answers were accepted.

A reference to the relevant paragraphs in the Euro-PCT Guide for early entry was not accepted as an alternative for OJ 2013, 156.

Only Art.45(2) PCT gives full marks for legal basis for closure of the national route.

### Q.4 – effect of non-payment of claims fees on EP entry

Abandonment of claims on entry if no claims fee paid has the result that they cannot be reintroduced if no further basis in the application. It was not expected, for full marks, to discuss whether a divisional can be used to revive the subject-matter of claim 16: the questions asks "...this patent application".

### Q.5 – opposition based in a Euro-PCT Art.54(3) application

For full marks, grounds and related documents for opposition need to be indicated.

For Art.54(3) effect for a successful opposition, just Art.153(5) and R.165 is enough (and both are needed), not needed to do full entry with all the acts of R.159(1).

### DII

The DII part of the D paper related to coffee capsules with ribs of various shapes and various material, as well as a coffee powder with an additive.

The client, coffee maker San-Antonio (SA) from France, developed a plastic coffee capsule with reinforcing ribs. The ribs make the coffee capsule more rigid leading to a more reliable piercing step. SA established that coffee capsules having ribs with a cross-section which is triangular or elliptical can be made of any plastic material. A complication arises as it is impossible to produce coffee capsules having ribs of other shapes of the cross-section unless they are made of plastic material X. They have filed national French applications as well as a PCT-application directed to plastics cups with ribs.

The client's main competitor is Swiss company "Big Coffee" (BC). They have a national Swiss application and a PCT application (a bit earlier priority date than that of the client) describing and claim a plastic coffee capsule having an elliptical rib. Material X is not disclosed in the applications from BC. The competitor's PCT application also discloses and claims a coffee powder containing additive G, which results in a surprisingly good coffee because the aromas are extracted very well. Our client already filed an earlier French application directed to capsules with additive G, and this text is also included in the client's PCT application.

BC also has a granted European patent, which has a single claim relating to coffee capsules made of material X. No mention of ribs is made in that patent. The opposition filed by the client against it was recently rejected, but their Dutch professional representative before the EPO just found a new novelty-destroying document and filed an appeal, in Dutch, and paid the appeal fee. The candidate had to deal with this.

The questions addressed the different subject-matters explicitly:

"Please let us know:

1. What is the patent situation as it currently stands with respect to

- a- plastic coffee capsules having an elliptical rib,
- b- plastic coffee capsules having a triangular rib,
- c- plastic coffee capsules having a rib,
- d- plastic coffee capsules made of material X,
- e- coffee powder containing additive G?
- 2. What actions can we take to improve our situation with regard to each of the above products?
- 3. After having taken these actions, can Big Coffee stop us from selling any of the above products in Europe, or can we stop Big Coffee from selling any of the above products in Europe?"

The Examiner's report indicates: "Some candidates did not follow the scheme that was given in question 1. Instead of discussing the patent situation by subject matter, as was requested, they discussed it by patent application. This approach often resulted in an incomplete analysis for a particular subject matter and earned fewer marks. If the conclusions were not present, e.g. "elliptical rib takes away novelty of rib in general", the relevant points were missed."

Main issues were validity of priority, lack of enablement of the priority application and the applications from the clients and the competitor, the (im)possibility to overcome the enablement objections, (lack of) novelty over 54(3) prior art, entitlement to use a certain language when filing an appeal.

When discussing validity of priority, an explicit indication is needed that applicant and subject-matter are the same, and indicate which subject-matter (e.g., 'elliptical ribs').

Preferably organize the answer as the question is organized: here, per subject-matter and not per application. In this DII, Q.1 addresses the current situation, Q.2 addresses what to do. The questions thus explicitly ask for an analysis of the present situation as it is and as it will be if nothing is done, as well as what the proprietor shall do. If the answer to Q.2 is given under Q.1, full marks can be attracted, as long as it is there. However, the order of the questions is expected to be optimal, so answering in the order of the Qs is encouraged.

Not all possible future scenarios need to be discussed. E.g., no unsuccessful oppositions.

A detailed structure of the questions (1 a-e, 2 a-e) can be expected in other D papers, as far as possible.

Many candidates repeat a lot of information from the paper in the answer without any argumentation.

Neither the Examiner's Report nor the Possible Solution is a training tool.

Possible Solution is at least 100 marks. May, or actually has, have a bit more.

The order of a few sentences in the answer to Q.1(b) was incorrect (page 8), and will be corrected in the online Compendium ("If ..." should be moved after the second paragraph "PCT-SA validly... Monday"), if possible.

It is enough to argue "elliptical ribs in PCT-BC are novelty-destroying for ribs in PCT-SA", it is not needed to explicitly mention "elliptical ribs" to be a species of the genus "ribs".

Key was enablement: in PCT-SA, the coffee cup with ribs can be repaired by adding "of material X", but not in PCT-BC.

Some info was presented to prevent speculation, and did not require attention in the answer: "The representative left for the South Pole" (so, cannot be reached, cannot be involved), "Material X is known to the person skilled in the art" (so, can use it, enabled), "validly filed".

(The same) Lack of enablement made the priority from CH-BC invalid, as well as the application PCT-BC not enabled. Marks were available for both items.

### 9) Pre-Exam by Roel van Woudenberg

EC IV representatives: Stefan Kastel (**epi**), Francesco Rinaldi (EPO), Stefan Götsch (EPO).

### Pre-Exam: General remarks

Raison d'etre for the Pre-Exam: "is a candidate fit to sit the main exam?"

When drafting the Pre-Exam questions, considerations include:

- Is the topic relevant for patent practice before the EPO?
- Is legal situation and Guidelines clear?
- Is it an elementary element in advice?
- Can one expect a candidate to know when at pre-exam level?
- Equally fair to electricity/mechanics and chemistry candidates?

Trying to get questions as clear and unambiguous, trying to avoid any doubt.

There is no target for a certain pass rate, the priority is to ensure suitability to sit main exam.

No detailed statistics are produced by the committee, so no statistics on legal score vs claim score, why resitting, scores per country, ...

The pre-exam is made with the following process:

- Legal and claims analysis drafting sub-groups
- First drafts for both parts by main drafters
- Meet with the committee, test exam: 2,5 hours, all make it: issues show up, discuss statement-by-statement

- Reworking
- Presented to Examination Board: receive suggestions
- Incorporate suggestions
- Guinea pig sessions: members from other committees; analyze, discuss, improve
- Translations into German and French
- Present to Board
- Ready
- Exam
- Review in light of all information available, including what goes on on the internet
- Marking meeting
- Marking, by hand with a transparency and by a computer
  - As marking is done on copies and not on the originals, a clear indication of the answers on the answer form is needed
- Meet in Examination Board

Appeals based on statement 5.4 were successful (D 1/16, D 2/16, D 13/16 in German; D 4/16 in English) due to an error in the German translation.

- It was asked whether the committee can also share the opinion as to other appeals, esp. why those were not successful, as the information may be useful for candidates to understand when it makes (no) sense to file an appeal. Committee cannot comment on appeals that are pending or are withdrawn
- In 2014 and 2015, successful appeals also let the Examination Board to decide that candidates who did not appeal but who otherwise would have passed, were awarded a PASS. The Examination Board will decide, the Committee cannot comment.

### Legal part of the Pre-Exam:

The legal part addressed a variety of subjects.

Question 1 was related to third party observations during opposition.

Question 2 was related to the R.71(3)-stage of examination.

Question 3 was directed to calculating time limits for responding to a communication, testing R.126(2), R.134(1) and further processing.

Question 4 addressed correction of the designation of inventor (inventor missing).

Question 5 tested various aspects of representation in the international phase.

Question 6 tested aspects related to a granted patent: renewals after grant, opposition, infringement, rights conferred.

Question 7 was related to validly claiming and transferring priority.

Question 8 was related to the scope of protection of a process claim and various aspects of a product-by-process claim.

Question 9 addressed renewal fees and re-establishment of a missed renewal fee payment.

Question 10 tested various aspects of opposition, in particular to language aspects, including fee reduction, time limit for translation, and languages in oral proceedings.

The answers are discussed in the Examiner's Report. Some questions were submitted and discussed at the meeting: The questions are not arranged in a certain order based on, e.g., alleged difficulty level. The order of answering the questions is left to the candidates.

Only statement 5.1 related to the case introduction, all other statements 5.2-5.4 were generic. Candidates may expect questions to have specific as well as generic parts in a single question also in the future.

Statement 5.2: it was asked why the wording "as a general rule" was used, as the statement relates to an exception of a general requirement – the waiver of a PoA. The wording "as a general rule" was meant to let the candidate focus on the daily practice at the EPO.

Statement 6.4: for the first time in the pre-exam, it was tested whether a candidate knows what rights are really conferred by a patent, with the statement "The patent proprietor is entitled under all circumstances to produce and sell in France any matter that is covered by the claim of EP-I". Although not in the (non-exhaustive) list in Rule 22(1) IPREE, this is considered a key topic of the patent system and not specific for one technical area. Further, a correct understanding is very crucial for a successful DII in the main exam.

#### Claims analysis part of the Pre-Exam:

The claims analysis part related to a saucepan with an integrated strainer. Three embodiments were shown in three separate figures. The lid of the saucepan can be rotated in the cooking position and in the straining position while keeping the lid on the container of the saucepan. When the pieces of cooked food are bigger than the dimension of the opening of the skirt, the lid can be lifted off the container to pour out the contents from the circular upper opening of the saucepan.

The four prior art documents related to a kitchen utensil for washing vegetables (D1), a prior art saucepan wherein the lid can be pivoted by an angle from the container (D2), another prior art saucepan with an annular straining portion that is in communication with the spout in any seated position of the lid on the container (D3), and another prior art saucepan having an opening which is large enough to permit the vapour to escape from the saucepan when the pressure inside the saucepan exceeds a threshold pressure, i.e., one that functions as a pressure cooker.

Questions 11-16 related to a first claim set I comprising claims I.1 to I.13: one independent claim directed to a saucepan and 12 dependent claims. Questions 11-13 largely related to scope of the claims; questions 14-15 largely related to novelty w.r.t. D1-D4 and clarity. Question 16 related to amendments and extension of subject-matter, testing three proposals for amending the independent claim, and one proposal for amending one of the dependent claims.

Questions 17-19 related to a second claim set II comprising claims II.1 to II.6, directed to a saucepan and a lid for a saucepan. Questions 17-19 related to aspects of the problem-solution approach, such as distinguishing feature, its effect, objective technical problem, and arguments for (lack of) inventive step, esp. arguments for combining two prior art documents.

Question 20 related to another independent claim III.1, and addresses further arguments for (lack of) inventive step, esp. effects and combining documents.

The answers are discussed in the Examiner's Report. Some questions were submitted and discussed at the meeting: This year, the exam has 23 claims (3 independent, 20 dependent). Most claims were single-feature claims. According to the Committee, the number of claims is not an indicator for the difficulty level.

Statement 12.1-12.4: it was observed that there is no clear order in the embodiments referred to, nor in the order of the claims referred to, e.g. none is monotonous: 3-2-3-nothing resp. 1.4-1.4-1.8-1.6. The Committee commented that candidates have to bear with this kind of sets of statements. Sometimes the order of statement results from editing history.

Statement 18.2 and 18.4: these statement are still subject to appeal. The Committee can hence not comment on these.

Candidates can expect that future exams have a similar type of claim sets as in 2015 and 2016, i.e., e.g., 2 sets of about 6-10 claims, and 1 other independent claim.

## 10) The combined AB Papers (EQE 2017) by Margaret Mackett

The Chairman of Examination Committee I, Nicolas Favre, provided information relating to the important points that will be needed for the future Papers A & B. He also men-

tioned that there will be a video interview posted in due course where these points are discussed.

The Mock Papers A & B are not representative of the real papers as they were only tested on 20 to 30 people compared to the 2000 answers normally received during the EQE. However, they were prepared to give an indication of the type of subject matter that may need to be addressed in 2017 and subsequent years.

The basic intention of the new papers is to streamline the EQE and make it fairer for all. Everyone will need to adapt to the new papers, and, candidates are reminded that, if it appears that groups of candidates have the same issue during the pre-marking meetings, the marking schedule may be adapted accordingly.

The new papers are prepared by teams of experienced drafters from all specialisations in mixed committees composed of both members of the former sub-committees (one for chemistry and one for electricity/mechanics). The subject-matter of the future papers is intended to be suitable for everyone, and, the papers will concentrate on the basic principles of patentability.

Specifically, in relation to new Paper A, whilst the drafting of functional claims cannot be excluded, there will be hints in paper, and, candidates are required to use all the information in the paper as a whole. Comparative examples may need to be considered when drafting claims but it would be evident from the paper how such comparative examples should be used.

The good news for non-chemists is that they will not need to draft Markush claims as these claims are considered to be too specialised. However, they will need to draft more than one independent claim in accordance with the information provided in the paper, for example, a device or apparatus claim and a process claim. Essential features will be indicated in the paper and candidates should not try to outsmart the client.

All candidates must remember that an independent claim which is not novel will not be given any marks. If the same mistake is made in more than one independent claim, the candidate will only be penalised once.

Whilst the EPC states that independent claims should be drafted in two-part form, candidates will not fail by not doing so. The marks that will be deducted for a claim not in two-part form will be determined during the pre-marking meeting where the marking schedule is finalised. Similarly, for lack of reference numerals, a candidate will not fail if he/she is fit to practice.

Turning now to new Paper B, candidates will need to prepare a response as they have done in recent years but must not forget to address all the objections raised in the Communication.

When providing basis for the new features or new combination of features in a claim, candidates need to say why it is possible to add these new features or combination of features, and not simply list the relevant paragraph or lines where the feature can be found in the description as originally filed.

Naturally, candidates will also need to provide arguments in support of novelty and inventive step, and, the problem-solution approach must be used when arguing in support of inventive step.

Finally, do not be 'too smart' and to stay within the framework of the papers, and, you can look at suitable papers in the other field of technology to assist with your preparation for the change in subject-matter.

### Contact Data of Legal and Unitary Patent Division

Update of the European Patent Attorneys Database

P lease send any change of contact details using EPO Form 52301 (Request for changes in the list of professional representatives: http://www.epo.org/applying/ online-services/representatives.html) to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 523 of any change in your contact details.

Kindly note the following contact data of the Legal and Unitary Patent Division of the EPO (Dir. 5.2.3):

European Patent Office Dir. 5.2.3 Legal and Unitary Patent Division 80298 Munich Germany

Tel.: +49 (0)89 2399-5231 Fax: +49 (0)89 2399-5148 legaldivision@epo.org www.epo.org

Thank you for your cooperation.

### Results of the 2016 European Qualifying Examination

Statistics on the results of the 2016 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	16	8
BE	30	10
BG	3	0
СН	49	11
CY	0	0
CZ	3	0
DE	717	232
DK	36	11
EE	0	0
ES	68	19
FI	37	2
FR	169	53
GB	165	81
GR	3	0
HR	2	0
HU	10	3
IE	5	3
IS	1	0
IT	84	17
LI	1	1
LT	1	0

Place of residence	Total number of candidates	Pass
LU	2	1
LV	1	0
MC	0	0
MK	0	0
MT	1	1
NL	102	31
NO	15	3
PL	22	5
PT	4	0
RO	2	0
RS	2	0
SE	87	19
SI	3	1
SK	1	0
SM	0	0
TR	20	1
CN	1	0
IL	2	0
JP	2	0
SG	1	1
US	1	0
Grand Total :	1669	514

Information source: http://www.epo.org/learning-events/eqe/statistics.html

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 (ie 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 fullfilled 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 as at 31.10.2016

Contr. State	Number Total	% of Total Repr <u>.</u>
AL	16	0,13%
AT	144	1,21%
BE	229	1,93%
BG	58	0,49%
CH	550	4,63%
CY	11	0,09%
CZ	93	0,78%
DE	4297	36,15%
DK	258	2,17%
EE	26	0,22%
ES	208	1,75%
FI	183	1,54%
FR	1112	9,35%
GB	2206	18,56%
GR	24	0,20%
HR	25	0,21%
HU	70	0,59%
IE	76	0,64%
IS	21	0,18%
IT	528	4,44%

### Internship for patent professionals Praktika Intern 2017 - working with examiners

19 September – 6 October 2017 European Patent Office, The Hague

The Praktika Intern programme is designed for professional representatives working in private practice or industry with experience in drafting and prosecuting European patent applications. It is an international programme organised and co-ordinated by the European Patent Academy, and it aims to promote equal access to education and training opportunities in the field of European and international patent law and practice across all current and future contracting states of the European Patent Convention (EPC).

Interns spend three weeks in Directorate-General 1 (DG 1), which is responsible for search, examination and opposition. They have the opportunity to work on actual case files and run prior-art searches. Each intern is looked after by one or more examiners, who explain step by step how DG 1 operates.

For more information, please see the Official Journal November 2016: OJ EPO 2016, A93

Closing date for applications: 31 January 2017

European Patent Office European Patent Academy Bob-van-Benthem-Platz 1 80469 Munich, Germany e-mail: academy@epo.org

### Fast and Sure: Options to Quicker Processing Before the EPO

by L. Petrucci (Administrator, Directorate Patent Procedures Management at the EPO) and J. Beatty (Director, Directorate Patent Procedures Management at the EPO)

T imeliness of the patent grant process brings greater legal certainty for everyone – patentees and third parties. This has been the driving consideration behind the EPO's *Early Certainty from Search* initiative (ECfS), launched in July 2014 and which in only 24 months has eliminated the search backlog.

Under ECfS the EPO delivers a high quality search report and written opinion, for all searches, within six-months from receipt of the patent application.

With search timeliness under control the EPO has extended the Early Certainty initiative to Examination and Opposition where it is moving towards completion of the examination procedure within 12 months on average and completion of opposition within 15 months from the end of the period for filing an opposition.

This article explains the options offered by the EPO to provide flexibility to shorten and/or accelerate the grant process.

To *shorten* the procedure, applicants can waive the right to certain communications: as a consequence the EPO can skip directly to the next step of the procedure without having to wait for the expiration of the time-limits associated with these communications.

To accelerate the procedure, the EPO offers possibilities for fast track treatment of applications, thus resulting in earlier treatment than normally foreseen.

However a request to accelerate the treatment of an application does not dispense with procedural steps and, vice versa, the filing of waivers does not result in fast track treatment.

In the following, the different possibilities for shortening and accelerating the procedure are presented in relation to the processing of an international application entering the regional phase before the EPO. Some emphasis is given to applications where the EPO did not act as the International Searching Authority (ISA); such applications are referred to at the EPO as a EuroPCT-*bis*.

In addition, some of the more common misunderstandings with respect to the acceleration possibilities will be clarified.

### 1. Example of a EuroPCT-bis application

This example begins with the initial filing of an application with a non-EPC national office to the grant of the European patent by the EPO. In the following it is assumed that no formal errors are encountered in the treatment of the application, and that the application was filed in 2016.

After the priority year, a PCT application is filed with the International Bureau. At the latest moment possible, i.e. at 31 months from the date of priority (Rule 159(1) EPC), the applicant requests entry into the regional phase before the EPO.The applicant has then six months to amend the application (Rule 161(2) EPC).

Once the application is in order for the search to start, the EPO delivers the supplementary European search report and the accompanying written opinion <u>within 6 months</u>.

Under Rule 70a(2) EPC the applicant has 6 months to reply to the written opinion, thereby confirming that the examination procedure should start (Rule 70(2) EPC). Upon expiry of this time limit the examination procedure can start.

### 2. Shortening the procedure

### 2.1 Possibilities to shorten the procedure open to all applicants

Any applicant can shorten the time to grant by:

(i) Explicitly waiving the right to receive a communication pursuant Rule 161(2) and 162 EPC. Since in such a case, the EPO does not have to wait for a reaction from the applicant, it can immediately start with the supplementary European search. This has the effect of saving 6 months from the procedure.

To take advantage of this option, the waiver must be filed when entering the regional phase and any claims fee due must already have been paid. If any of these conditions are not fulfilled, the communication will be issued and the application will be processed only after expiry of the six-month period. For more information see Guidelines E-VIII, 3.1.

It is noted that the applicant can *already amend the application on entry into the regional phase*: hence, in a way, this waiver concerns merely a second possibility

of amending the application before the start of the search procedure.

(ii) Waiving the right to receive the invitation under Rule <u>70(2) EPC</u> to indicate whether it is wished to proceed further with the application. Where this waiver option is applied the supplementary European search report is dispatched without written opinion and the first examination communication is dispatched by the examining division shortly after dispatching the search report. In order to benefit from this waiver, the applicant must file an unconditional request for examination regardless of the results of the supplementary European search.

It is also noted that in this particular case the applicant can amend the application on his own volition when replying to the first communication of the examining division. For more information please see Guidelines C-VI, 3.

(iii) <u>Entering the regional phase early</u>. The applicant can enter the regional phase before the expiration of the period applicable under Art. 22 PCT, i.e. before the thirty-one months under Rule 159(1) EPC.

In order for the EPO to be able to process an international application as designated Office, it must have been published and the International search report must be available. In practice this means that an applicant can enter the regional phase at the earliest at 19 months from the priority date. For more information please see Guidelines E-VIII, 2.8.

By using all three of the above possibilities, the time to grant can be reduced by up to 24 months.

### 2.2 Possibilities to shorten the procedure open only to applicants that can use the EPO as their International Search Authority (ISA)

Where the EPO acts as ISA, the supplementary European search report is dispensed with (Art. 153(7) EPC) as well as the invitation under Rule 70(2) EPC.

The possibilities to waive the right to receive the communication under Rule 161 EPC and to enter the regional phase early remain. However, where a reply to the WO-ISA is required, in order not to receive a communication under Rule 161, any required reply needs to be filed on entering the regional phase.

### 3. Accelerating the procedure

### 3.1 Possibilities to accelerate open to all applicants

Since 1995 any applicant can request the prosecution of any application to be accelerated under the **P**rogramme for the **AC**celerated prosecution of **E**uropean patent applications (PACE). The only condition to join the programme is to file EPO Form 1005 on line. There are no fees and no justification is required. Furthermore, the request is not included in the public part of the file by the EPO. To be fair to all, applicants requesting PACE for many or all of their pending applications will be asked to make a selection and reasonably limit the number of their requests to only those which are the most urgent.

On receipt of the PACE request form 1005, the EPO will do its utmost to deliver the next substantive action within three months. In 2016, the EPO delivered in more than 70% of the cases on time.<sup>1</sup>

When considering filing a PACE request, the following is to be noted:

an applicant has to show continued collaboration in the fast processing of the application for it to remain in the PACE programme;

Since under ECfS, the EPO <u>issues all</u> search reports with written opinion within six months from the filing date or from expiry of the period under Rule 161(2), no PACE request is needed for the search of European patent applications filed on or after the start of ECfS (1 July 2014). This includes PCT applications entering the European phase where the EPO did not act as (S)ISA).

Further details on the PACE programme can be found in Guidelines E-VII, 4.

To achieve maximum speed in getting to grant, a PACE request is best used in conjunction with the above mentioned waivers. It is the combination of both the shortening and the acceleration that clears the procedural path so that the search or the examining division can start work on the file as early and quickly as possible.

As a counter-example, in the event that a PACE request to accelerate examination is filed on entry into the regional phase *without* the waivers for a EuroPCT-*bis* application, the search division would not be able to work on the file until the six-months' time limit under Rule 161(2) has expired. This would mean that the search report with opinion would only be dispatched within six months after the expiry of the six months' time limit under Rule 161(2) EPC.

### **3.2** Possibilities to accelerate open only to applicants that can use the EPO as their International Search Authority

Under ECfS, in the case of a positive International Preliminary Report on Patentability (IPRP) by the EPO, following entry into the regional phase, the EPO will do its

<sup>1</sup> Figures of July 2016 see http://www.epo.org/about-us/office/quality/quality-indicators.html.

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utmost to dispatch a communication under Rule 71(3) EPC (intention to grant) within four months from the moment the examining division can start work on the application.

With a positive IPRP and entering the regional phase early, the applicant could receive an intention to grant notification within 23 months.

Furthermore the positive IPRP can be used to enter accelerated proceedings before the national offices with which the EPO has signed a Patent Prosecution Highway (PPH) agreement. These partner offices are JPO (Japan), KIPO (South Korea), SIPO (China), USPTO (USA), ILPO (Israel), CIPO (Canada), IMPI (Mexico), IPOS (Singapore), IP Australia (Australia) and SIC (Colombia).

In order to be able to optimise the claims while receiving a positive IPRP, applicants can make use of the PCT-Direct programme; at the moment this programme is offered worldwide only by the EPO and ILPO.

Under the PCT-Direct programme,

- (i) an applicant either files a PCT application with any Receiving Office as office of first filing and designates the EPO as ISA or files the application directly with the EPO as office of first filing;
- (ii) the EPO dispatches the (international) search report within six months;
- (iii) the applicant then files a (second) international application claiming the application under (i) as priority. The applicant requests to have the (second) international application processed under PCT Direct and files a letter ("PCT Direct letter") containing informal comments aimed at overcoming objections raised in the search opinion established by the EPO for the priority application under (i).

In this way the applicant is in effect able to react to any objections raised in the search opinion and thereby can optimise the claims to be searched in the second application.

Further details on the PCT-Direct programme can be found in PCT-EPO Guidelines B-IV, 1.2.1.

### 3.3 Patent Prosecution Highway (PPH)

PPH enables an applicant whose claims have been determined as patentable/allowable by a partner office to have a corresponding application filed at the EPO processed in an accelerated manner, with the EPO able to exploit the available work results from said partner office.

Once the request for participation in the PPH has been granted, the EP application will accelerated. The same con-

ditions as applicable to the PACE programme apply to the prosecution of European applications processed under the PPH (see point 3.1 above).<sup>2</sup>

PPH is a programme under which the prosecution of the application will be accelerated, but within the legal framework of the EPC. This means, in particular:

The (substantive) prosecution of an application can only begin once all the formal requirements of the EPC have been respected, for example only once the time-limit under Rule 161 has expired.

A requirement of the PPH pilot programmes is that the PPH request must be accompanied by a copy of the claim(s) found patentable/allowable by the partner office.

These claims form part of the documentation required for participation in the PPH pilot programme; however the EPO will not consider these claims as amendments to the respective application. To file amendments to the application, the applicant must file a second copy of the amended claims and indicate explicitly that these claims are an amendment.

However, it is to be noted that such filed amended claims will only be taken into consideration at the stage where the procedure under the EPC permits the application to be amended.

For example, where an applicant files a PPH request for a EuroPCT-bis before the supplementary European search has been carried out, but after expiry of the period under Rule 161(2) EPC, the claims accompanying the PPH request will not be taken into consideration even with an explicit request of the applicant, as filing of amendments to the application is not foreseen by the EPC (Rule 137(1) EPC) at this stage of the procedure. The supplementary European search is therefore based on the last set of claims filed up to expiry of the period under Rule 161(2) EPC (c.f. Guidelines E-VIII, 3.1).

### 4. Conclusion

The Early Certainty initiative already assures delivery of all searches within six months from receipt. Applying the procedural options described above to an individual application has a further impact in reducing pendency.

The EPO Early Certainty initiative brings greater legal certainty to the European patent system by delivering high quality products in a timely manner

<sup>2</sup> For more details on how to file a PPH request with the EPO can be found in OJ 2014, A8 for the agreement with JPO, KIPO, SIPO and USPTO; OJ 2015, A6, A7 and A70 for the agreements with ILPO, IMPI and CIPO respectively; and OJ 2016, A54, A68 and A75 for the agreements with IPOS, IP Australia and SIC.

### The Problem and Solution Approach – Basic Case Law and Recent Development (II)

M. M. Fischer (DE), European Patent Attorney

### **B. Objective Technical Problem**

As a next step, the distinguishing features between the appropriate starting point and the subject-matter of the claim are determined. Then, the *technical effect* achieved by these distinguishing features is determined and an objective technical problem is formulated based on the technical effect. It is important to note that the formulated objective technical problem must not provide pointers to the claimed solution.<sup>1</sup> The objective technical problem mentioned in the background section of the patent application. Hence, the objective technical problem can be reformulated. If a technical effect cannot be demonstrated, the problem must be reformulated.<sup>2</sup>

Before the EPO, the presence of a technical effect is essential to the acknowledgement of an inventive step. In this context, the decision **T 2044/09** should be cited in which the Board noted that "the mere fact that the claimed subject-matter was not novel over the prior art, even when combining document, was not sufficient to render it inventive. In fact in the absence of a proven effect in comparison to the prior art, it was considered that this must be regarded as an arbitrary non-functional modification of the prior art. Even if there was no pointer or suggestion in the prior art towards the addition of a distinguishing feature, if said modification was not linked to a particular functionality, then it could not per se constitute the basis for acknowledging an inventive step".

Hence, when drafting a European patent application, care should be taken to not only mention a technical problem or a technical effect in the background section of the patent application which normally relates to the overall problem addressed in the patent application but also to mention the technical effects associated with features mentioned in the dependent claims and/or in the description. If the technical effect is not mentioned in the application, it may be more difficult to convince the Examining Division that the technical effect (merely alleged in examination proceedings) is actually achieved. Reference is made to GL G-VII, 5.2 which states that "It is also possible to rely on new effects submitted subsequently during the proceedings by the applicant, provided that the skilled person would

recognise these effects as implied by or related to the technical problem initially suggested".

While it is common practice in the field of pharmacy to file results of clinical studies performed after the filing of the application in order to demonstrate a technical effect, applicants in other technical areas often do not seem to This is the second part of an article that is based on a talk held by the author on September 8, 2015 at the European Patent Experts' Forum (EuPEX) in Munich. The author thanks the audience for the animated discussion accompanying the talk. Some of the contributions have been woven into the article. The first part of this article was published in **epi** Information 3/2016.

contemplate this option. For example, if the inventor has published – after filing the patent application – an article in which the technical effect is better explained than in the patent application itself, this article can be adduced in order to demonstrate the technical effect before the EPO. "In T 440/91 the Board pointed out that R. 27 EPC 1973 did not rule out the possibility of additional advantages not themselves mentioned in the application as filed but relating to a mentioned field of use - being furnished subsequently in support of patentability for the purposes of Art. 52(1) EPC 1973, as such advantages did not alter the character of the invention. Thus, the character of the invention was not altered if the technical problem specified in the application as filed was supplemented by such advantages, since the skilled person might consider them on account of their close technical relationship to the original problem (see also T 1062/93). The Board made a distinction with regard to the situation in T 386/89 and T 344/89, where there was no such technical relationship. In T 386/89 the Board had found that the solution to the technical problem derivable from the application as filed was in no way associated with a technical effect subsequently invoked. This additional effect had thus not been taken into consideration. The alleged effect of a described feature could not be taken into account when determining the problem underlying the invention for the purpose of assessing inventive step, if it could not be deduced by the skilled person from the application as filed considered in relation to the closest prior art. Similarly in T 344/89, the Board had refused to take account of a subsequently invoked technical effect on the grounds that to do so would have altered the character of the invention (T 532/00, T 845/02, T 2179/08)"<sup>3</sup>. If a technical effect is purported that is associated with a range of values, it should be noted that "an

<sup>1</sup> T 641/00 suggests to put all non-technical features into the problem in order to avoid that they provide pointers to the solution.

<sup>2</sup> Handout of presentation "Problem/Solution Approach to Inventive Step and Challenging Cases" held by Graham Ashley, Chairman of a Technical Board of Appeal, at the conference "Boards of Appeal and key decision" on November 26/27, 2015 in Munich

<sup>3</sup> Case Law of the Boards of Appeal, section I.D, 4.4.2, 7th edition, 2013

effect cannot be retained if the promised result is not attainable throughout the entire range covered by the claimed subject matter. Therefore, the technical problem needed to be redefined in a less ambitious way (T 626/90, T 1057/04, T 824/07)"<sup>4</sup>. Hence, should a first application not include the technical effects associated with individual features, it should be legitimate to incorporate these technical effects - taking into account the restrictions set forth in the decisions above – into the description of a second application to be filed with the EPO and claiming priority from the first application in order to facilitate its prosecution. Since this addition of technical features does not affect the feature combinations recited in the claims, this measure should not jeopardise the validity of the priority claim. A slightly different question is whether the claimed subject-matter solves the problem to be solved. In this context, the Boards held hat "post-published evidence to support that the claimed subject-matter solves the problem to be solved is taken into account if it is already credible from the disclosure in the patent [or patent application] that the problem is indeed solved. In other words, supplementary post-published evidence may not serve as the sole basis to establish that the problem is solved (T 1329/04, T 415/11)"5.

At this point, it is worthwhile taking a look across the big pond where no other decision has shaken the patent world in recent years more than "Alice Corp. v. CLS Bank International" rendered by the US Supreme Court in 2014. The patents in suit were held to be invalid because the claims were drawn to an abstract idea, and implementing those claims on a computer was not enough to transform that idea into patentable subject matter. In short, this decision may be interpreted in a way that subject-matter (in this case software) is only patentable if it achieves a technical effect. As harsh and consequential<sup>6</sup> as this decision may (or may not, if overturned) be for the patent world in the USA, it could constitute a harmonisation between the jurisprudence of the USA and the EPO. The author of this article appreciates the EPO's concentration onto a technical effect. Firstly, it makes sure that a patent is granted only for "technical" solutions (which leads, however, to the problem of the meaning of the term "technical"). Secondly, a patent is granted in return to the applicant making the invention public which can then be further developed by others. Hence, if it is not (at least implicitly) clear what the invention achieves because it is nothing but a combination of seemingly arbitrary features, then the description has to be considered to be incomplete and may be of little or no value to the public since the public does not know what the invention is for (see also the requirement of R. 42 (1) (c) EPC).

If the objective technical problem formulated based on the distinguishing features leads to a problem that cannot occur at the selected appropriate starting point, the selected starting point is inappropriate (see **T 513/00**). At least one cannot show in a logical chain of arguments that starting from this document the subject-matter of the claim can be arrived at in an obvious manner. When attempting to show that the subject-matter of a claim is not inventive using the problem and solution approach, it is advisable to countercheck whether the problem formulated is a problem that the selected appropriate starting point actually has. Otherwise the chain of argumentation becomes illogical.

As already mentioned above, if one has chosen a closest prior art document from a different genus, then it is difficult to formulate a reasonable problem which does not point to the solution because the problem would have to be based on the generic difference. If we consider a military helmet having the features a, b and c and the closest prior art is a worker's safety helmet having the same features a, b and c. The problem cannot be formulated as how to modify the safety helmet to also be able in military actions directly points to the solution. How to modify the safety helmet to be usable in a different environment would be too broadly formulated.

This leads to the question on how specific the objective technical problem should be formulated. In T 1019/99, the Board held that it is established case law that the objective technical problem to be used in the problem and solution approach is to be formulated so that it does not anticipate or contain pointers to the solution. This constrains the specificity of the formulation. However, there is also a constraint on the amount that the formulation can "back off" from this specificity, i.e. a constraint on the generality of the problem. The problem can be no more general than the disclosure of the prior art allows. Otherwise, a problem could be formulated so generally as to circumvent indications in a prior art document towards the claimed solution. Thus the correct procedure for formulating the problem is to choose a problem based on the technical effect of exactly those features distinguishing the claim from the prior art that is as specific as possible without containing elements or pointers to the solution.

#### **C. Obviousness**

Following the gedankenexperiment of the problem and solution approach, by determining the appropriate starting point and the objective technical problem, a hypothetical situation is defined in which the fictitious skilled person<sup>7</sup>, a purely fictitious person with a certain knowledge and abilities, could have been.

<sup>3</sup> Case Law of the Boards of Appeal, section I.D, 4.4.2, 7th edition, 2013

<sup>4</sup> Case Law of the Boards of Appeal, section I.D., 4.4.2, 7<sup>th</sup> edition, 2013

<sup>5</sup> Case Law of the Boards of Appeal, section I.D.4.6, 7<sup>th</sup> edition, 2013 The graph available at http://cdn.theatlantic.com/assets/media/img/ posts/2014/11/chart\_1-1/5966e14bf.jpg shows that the USPTO issued fewer than half the number after Alice that it had issued per month during the period prior to Alice. At the same time, however, the issuance of other types of software patents rose. (https://en.wikipedia.org/wiki/ Alice\_Corp.\_v.\_CLS\_Bank\_International#Lower\_courts)

<sup>7</sup> A detailled definition of the skilled person, his abilities and his knowledge in different fields of technology is omitted. Not many decisions on this seem to have been issued any time recently.

### (Hypothetical) Situation = Appropriate Starting Point + Objective Technical Problem

While the first two steps of the problem and solution approach are made in full knowledge of the invention (i.e. based on hindsight), it is now important to erase the knowledge of the invention from one's mind in order to be able to assess the question of obviousness without hindsight.

In practice, this situation could be compared with a development process in which a development manager gives a development engineer or team of engineers (skilled person(s)) the order to further develop a given product in a certain respect (based on a functional specification).<sup>8</sup> The question is whether the skilled person in the situation above could and would have found the solution to the objective technical problem, for example in a second document from the prior art, or not (could-would approach). Hence, a skilled person may perform the role of a guinea pig by means of which it is tested whether it reaches - in a given situation - the target (the subjectmatter of the claim) or not. It is important to note that the skilled person neither selects the closest prior art nor formulates the problem but is presented with both of them.

The assessment of whether the further development of the prior art is obvious or not is not determined by what the skilled person could have done but by what he would have done. It should be noted that it is completely irrelevant in which situation the inventor actually was.

"That it was theoretically possible for the skilled person to arrive at the invention simply means that he could have used the requisite technical means. If, however, it is to be established that he would actually have used them, it must be possible to ascertain a pointer in the prior art which

In T 1014/07 the Board stated that the mere existence of teachings in the prior art is not a conclusive reason for explaining that the skilled person would have combined these teachings in order to solve the problem that he or she is confronted with. As a further reason for denying an inventive step for the claimed subject-matter the examining division indicated that "[t]he mere fact that a known biochemical step has been added to a known chemical process of oxidation cannot be considered in itself inventive in the absence of a special feature or advantage of the combined use of biochemical and chemical processes". However, for the determination of the obviousness or non-obviousness of claimed subjectmatter, it is not decisive that teachings are known - it must be decided whether or not the skilled person would have combined the known teachings such as to arrive at the claimed subject-matter when attempting to solve the underlying technical problem. Thus, in contrast to the examining division's view, the combination of known teachings may result in non-obvious subject-matter, namely when the skilled person is not motivated, for example by promptings in the prior art, to make such a combination. Under these circumstances the presence of any special effect arising from the combination is not necessary to establish an inventive step.

While it appears that the "could-would approach" is sometimes only applied to the question whether there was an incentive/prompting to apply the teaching of a secondary document to the teaching of the appropriate starting point, the author of the article suggests the following more comprehensive scheme:

would have prompted him to do so (T 1317/08)"9. Although the "raising the bar" initiative a few years ago only affected the European Patent Office and not the Boards of Appeal, some Boards of Appeal came to the conclusion that even an implicit prompting or implicitly recognisable incentive is sufficient to show that the skilled person would have combined the elements from the prior art (see T 257/98 and **T 35/04**). This must have been the case for the skilled person before the filing or priority date valid for the claim under examination.

COULD?	WOULD?
Is the solution to the prob- lem available somewhere in the prior art? (Can a passage of a prior art document be read under the distinguishing features?)	Is the document from the same, a neighboring or a broader gen- eral technical field of the invention? E.g. the technical fields of automotive engineering and avionics are considered to be neigh- boring technical fields because they involved similar problems ( <b>T 1910/11</b> ). In some cases, the question above can be answered based on the International Patent Classification (or any other patent classification system).
	Are there no impediments (inherent incompatibilities, technical difficulties, necessity of major adaptations, teaching-away) that would prevent the skilled person from applying the solution to the appropriate starting point? <sup>10</sup>
	Is the skilled person prompted to apply the solution to the appro- priate starting point? (Would the skilled person recognize that the passage solves the problem? E.g. because it also mentions the technical effect associated therewith.) A typical prompting to apply the teaching to an appropriate starting point is if the sec- ond document does not only mention the features of the solution but also the technical effect obtained thereby.
SOLUTION AVAILABLE?	IN A SUITABLE CONTEXT?

<sup>8</sup> Hoekstra, J., "Methodology for Paper C - Training for the European Qualifying Examination", Deltapatents, October 2009, p.151

Case Law of the Boards of Appeal, section I.D.5, 7th edition, 2013

<sup>10.</sup> Of course, the question whether two teachings are compatible with each other is determined based on the concrete disclosure of the two documents and not on the abstraction level of the claims since the skilled person does not know the subject-matter of the claim.

While the question of "could" merely refers to the fact whether something falling under the features of the claimed solution was somewhere available in the prior art, the question of "would" deals with the question whether the skilled person would have found the solution and applied it to the appropriate starting point. In short:

### Could : Would = Solution : Context

In other words, "could" refers to the theoretical possibility of finding the solution while "would" denotes whether the skilled person would have practically found the solution in view of the context in which the solution is presented. Typically, the transfer of a known solution in a suitable context to an appropriate starting point is considered to be a further development that the skilled person could and would have achieved. In T 142/84<sup>11</sup>, the Board argued in a such an archetypal way: "The respondents are of course correct when they state that the mere fact that a skilled person would not encounter insurmountable difficulties in providing a characterising feature of a claim does not lead (necessarily) to the conclusion that there is no inventive step. However, when the feature is known from a document in the same specialised field, and solves the same problem, then the fact that the skilled person would not encounter insurmountable difficulties in applying this known feature to a known apparatus from a second document does demonstrate that the documents are not conflicting (see T 02/81, OJ EPO 10/1982, 401), and that an inventive step is lacking. The problem solved does not have to be stated expressis verbis in the prior art. The respondents refer further to the earlier decision T 39/82 OJ EPO 11/1982, 423. In that case it was decided that the problems to be respectively solved with a known measure in the known case and in the case to be decided must be taken into account. Since the problems differed fundamentally from one another it could not be considered obvious for the skilled person to use this known measure in a different context. Since however the purpose of the features known from US-A-4 100 657 is the same as in the present case, it cannot be denied that the problems do not differ fundamentally and this prior art gave the skilled person an indication for applying these features in the present case."

In yet other words, the could-would approach tests in how far two documents/teachings fit with each other. This is sometimes compared with a jigsaw puzzle<sup>12</sup> with the documents being the pieces of the jigsaw puzzle. As mentioned above, it is crucial that at least one of the documents contains an incentive/prompting so that its teaching will be applied to the teaching of another document which implies that "mosaic-like combinations will normally not be persuasive"<sup>13</sup>. However, one must not forget that the prior art can also be represented by a "prior use" which normally – by its nature – does not contain any incentive/prompting.

While the skilled person needs an incentive to apply the teaching of a second prior art item to that of an appropriate starting point, the Guidelines state under G-VII, 6 (iii) that "it would normally be obvious to combine with a prior art document a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art". This obviously means that no incentive/prompting is needed to apply the skilled person's common general knowledge to an appropriate starting point. Thus, according to the Guidelines, the difference between a normal prior art document and the skilled person's common general knowledge appears to be that the common general knowledge as the skilled person's mental furniture is very present in his brain and therefore the hurdle that the skilled person applies it to a teaching of another document is very low or not existing (= no incentive is needed). However, care has to be taken in order to identify what is actually known from the common general knowledge and how the skilled person would apply it to the teaching of a prior art document. It is important to note that the skilled person's common general knowledge may not be applied in a certain (target-oriented, purposeful) direction to arrive at the claimed subject-matter. This would be considered an unallowable ex-post-facto analysis.

In T 1471/11, the Board held that "the argument of the appellant must fail that neither claim 1 nor the description of the patent in suit define the claimed arrangement for lubrication to such an extent that it can be understood without having recourse to the general technical knowledge and understanding of the skilled person. With that general technical knowledge in mind, in addition to the teaching of the available documents, the examination of inventive step would necessarily lead to the conclusion that the claimed subject-matter does not involve an inventive step. The reason is that even if it is correct that general technical knowledge and practice needs to be taken into account in order to reduce the arrangement for lubricating defined by claim 1 to practice, the decisive direction in which this general technical knowledge is to be applied to arrive at what is claimed, still needs to be derivable

Handout of presentation "Problem/Solution Approach to Inventive Step and Challenging Cases" held by Graham Ashley, Chairman of a Technical Board of Appeal, at the conference "Boards of Appeal and key decision" on November 26/27, 2015 in Munich
 Hoekstra, J., "Methodology for Paper C – Training for the European

<sup>12</sup> Hoekstra, J., "Methodology for Paper C – Training for the European Qualifying Examination", Deltapatents, October 2009, p.154 and cover page

<sup>13</sup> section 3.3 of http://www.bardehle.com/en/publications/interactive\_ brochures/inventive\_step.html

from some teaching or knowledge"<sup>14</sup>. The Board set forth a similar argumentation in **T 386/12** and **T 1426/10**.

This is different from the use of the common general knowledge in the field of "sufficiency of disclosure" (Art. 83 EPC) where the skilled person would use his common general knowledge in a target-oriented way to determine whether the invention is sufficiently disclosed by the application as a whole. He is in the position to use his common general knowledge in a target-oriented way because he knows the prior art and the invention, while the skilled person in the assessment of inventive step only knows the prior art. However, in both assessments, "the same level of skill has to be applied (T 60/89 and T 373/94)"<sup>15</sup>. In slightly other words: "The skilled person when assessing sufficiency of disclosure of a patent has knowledge of the invention as disclosed, i.e. knowledge of both the prior art, the problem and its solution, and is aware of documents cited in the patent and the common general knowledge in the art" (T 6/84, T 171/84)<sup>16</sup>. With both decisions being quite old and search engines becoming more and more powerful, it would be interesting to see if e.g. a novel, unusual or special term in a claim of a patent application, the term not being part of the skilled person's common general knowledge (i.e. cannot be found in standard textbooks, etc.) and the patent application neither containing any explanations nor references to other documents, would make the application not meet the requirement of "Sufficiency of Disclosure" even if an explanation of the term could easily be found using a search engine. The decision T 580/88 also appears to be quite harsh in this respect.

In **T 1641/11**, the Board held that the assertion that something was part of the common general knowledge therefore needed only to be substantiated if challenged by another party or the EPO. "Where an assertion that something was part of the common general knowledge is challenged, the person making the assertion must provide proof that the alleged subject-matter indeed forms part of the common general knowledge (**T 438/97**, **T 329/04**, **T 941/04**, **T 690/06**)"<sup>17</sup>.

#### **D. Further Considerations**

The following schematic example wants to demonstrate why it does not make sense to focus on one closest prior art document.

Doc:\Claim features	Α	В	С	D	E
D1:	а	В	С		
D2:	а	В	С	d	
D3:				d	е
D4:					е

(The lowercase letters denote special features that anticipate the features denoted by the corresponding uppercase letters.)

Both documents D1 and D2 qualify as appropriate starting points (same purpose as the claim, etc.). However, since D2 has one more feature in common with the claim, it could be considered to be the (one and only) closest prior art document. Although D2 is per se closer to the claim than D1, it may be that there are incompatibilities (e.g. mechanical incompatibilities, incompatible dimensions) between D2 and D3 and D2 and D4 such that the skilled person would neither apply the teaching of D3 nor the teaching of D4 to that of D2. Hence, the (wrong) conclusion would be that starting from the closest prior art D2, the skilled person would not have arrived at the subjectmatter of the claim in an obvious manner. However, there may not be incompatibilities between document D1 and D3 and the skilled person could and would apply the teaching of D3 to that of D1, thereby arriving at the subjectmatter of the claim in an obvious manner. Since there exists one way to arrive at the subject-matter of the claims, it has been shown that claim 1 does not involve an inventive step. Since the question whether one arrives at the subject-matter of the claim in an obvious way also depends on how well the primary reference fits together with the secondary reference, documents must not be prematurely disregarded as appropriate starting points.

Applying the problem and solution approach is sometimes compared with mountaineering<sup>18</sup>. Two hikers A and B, of ordinary skill, not Reinhold Messner, (person of ordinary skill in the art, no Nobel Prize winner) want to hike to the summit (invention/ subject-matter of claim) of Mount Inv. From their starting point, they both see the summit they want to reach (selection of appropriate starting point is made in knowledge of the invention). Hiker A takes a trail (a first appropriate starting) which is very steep and goes very straight into the direction of the summit (same purpose). This trail appears to be very promising since, as far as he can see, it almost reaches the summit (only one feature missing <sup>©</sup>). Hiker B takes another trail (a second

<sup>14</sup> The Federal Court of Justice of Germany came to a similar (possibly even broader) conclusion in its decision Xa ZR 56/05 "Airbag-Auslöse-steuerung": "The mere fact that a teaching belongs to the skilled person's common general knowledge does not yet prove that it was obvious for the skilled person to employ this teaching in order to solve a specific technical problem". A further decision in this context is the decision X ZR 139/10 "Farbversorgungssystem" in which the Federal Court of Justice came to the conclusion that the skilled person would have applied a solution from his common general knowledge "because using its functionality was objectively expedient and there were no special circumstances rendering such use impossible, difficult or otherwise impracticable from a specialist point of view".

<sup>15</sup> Case Law of the Boards of Appeal, section I.D.8.3, 7th edition, 2013

<sup>16</sup> Visser, D., "The Annotated European Patent Convention", 21st edition, 2013, p.174, section 2.2

<sup>17</sup> Case Law of the Boards of Appeal, Section I.D.8.3, 7th edition, 2013

<sup>18</sup> see for instance: http://k-slaw.blogspot.de/2012/09/t-5609-so-close.html

appropriate starting point) which also goes in the direction of the summit but is less steep. However, he can only see that his trail ends somewhere in the forest at half the height of the summit (some more features missing  $\circledast$ ). When hiker A reaches the end of his trail, he notices that the trail abruptly ends and that he would have to climb (perform an inventive step) the last few meters from there to reach the summit. Unfortunately, there is no signpost (pointer, incentive/prompting) showing him how he could alternatively reach the summit by hiking. He also looks into his standard mountain survival guide (common general knowledge – a hiking map would not be a good analogon under the assumption that the common general knowledge must not be used target-oriented) that he always carries with himself. When hiker B reaches the end of his trail, he has only reached half the height of the summit, but he notices a signpost (pointer to another document) that indicates that several other trails (further documents possibly containing a solution) start from a place very close (neighboring technical field) from here. He follows the signpost and arrives at a point where he sees different signposts (incentives/promptings to different documents), one of them (incentive/prompting to the document disclosing the solution) indicating that this hiking trail – ideal for the ordinary hiker, no climbing necessary – leads to the summit of the mountain. The hiker follows this trail (second document) and easily arrives at the summit without any climbing. A trail which appears at first glance less promising than another trail may lead to the summit while the other trail may not. In the language of the problem and solution approach, this means that not any document that appears to come closer to the subjectmatter of the claim than all other documents is suitable to show that the subject-matter of the claim is inventive, while a not so close document is ideally complemented by another document which shows that the subject-matter of the claims is indeed inventive.

### **E. Alternatives**

The EPO lives and breathes the problem and solution approach. Hence, the decision **T 465/92** received a lot of attention because already its headnote stated that the problem and solution approach is no more than one possible route for the assessment of inventiveness. Accordingly, its use is not the only possibly approach when deciding on inventiveness under Article 56 EPC. In the Case Law Book 6<sup>th</sup> edition, this decision has been classified as "a one-off decision". Interestingly, in the 7<sup>th</sup> edition, this remark has been replaced with the sentence that the Board "took the view that all of the seven cited documents came equally close to the invention". Possibly, this decision, which has often been categorized as a heretical decision not to be followed, was an early decision to recognize the issue of referring to one closest prior document, which was not possible in the present case, and therefore decided not to apply the problem

and solution approach. Possibly, the members of the Board had a (formal) problem with the superlative notion of a one and only "closest prior art document" and therefore declined applying the problem and solution approach. Maybe, the amendment of the Case Law Book is a late and silent rehabilitation of this decision which partly anticipated the decisions **T 967/97**, **T 558/00**, **T 21/08**, **T 308/09** and **T 1289/09** that have now found their way into the last version of the Guidelines.

In T 939/92 the Board of Appeal referred to the decision T 465/92. Although it was held in No. 9.1 of the reasons of this decision that the "problem and solution approach" is not a sine qua non for the determination of inventiveness by the EPO, it follows, in the Board's judgment, from the detailed explanations given in the following points 9.2 to 9.6 of the reasons that in that case the Board refrained from identifying a certain document as "closest state of the art" and formulating a "technical problem" on the basis of such a state of the art. In the present case, however, the question of selecting a particular document as "closest state of the art" is not at issue. However, in decision T 465/92 the Board considered the results which had been objectively achieved by the claimed invention, and then proceeded, on that basis, to decide whether or not the cited state of the art, as a whole, would have suggested to the skilled person that these results could be achieved in the way indicated in the patent under consideration.

In **T 188/09** the Board stated that the "problem and solution approach" is regularly applied as an auxiliary means by the instances of the European Patent Office in the course of deciding whether or not claimed subject-matter fulfils the requirements of Article 56 EPC. The appellant, referring to decision **T 465/92** of 26 November 1993, observed that there are however cases where the "problem and solution approach" hinders, rather than assists answering the question of whether claimed subject-matter is obvious over the prior art.

In decision **T 465/92** the Board explicitly decided not to use the "problem and solution approach" (see points 6 to 9.6 of the Reasons). Thus, the Board understands the appellant's reference to this decision as an argument that the present case is one where the "problem and solution approach" should not be used.

The Board notes first that whatever approach is applied as an auxiliary means for the evaluation of inventive step of claimed subject-matter, in a given evidential situation it must provide the same result, be it either in favour of or against inventive step. Therefore, in the present case, even if the "problem and solution approach" was applied, the decision on inventiveness should be the same as if it was not used.

Moreover, according to the reasons of decision T 465/92,

the Board decided to avoid the "problem and solution approach" because it considered that the seven relevant citations were all equally close to the claimed invention and that therefore, the opponent "ought not to be tied down by having to select one or more citations as being closer than others" (see points 9.3 and 9.4 of the Reasons). Consequently, the Board considered them all individually without selecting one as the closest prior art document.

The Board in decision **T 465/92** also notes in point 9.5 of the Reasons that there may be situations which "can result in a complicated multi-step reasoning where the facts were clear, either for or against inventiveness. Thus, if an inventions breaks new ground it may suffice to say that there is no close prior art rather than constructing a problem based on what is tenuously regarded as the closest prior art."

None of the circumstances for the avoidance of the classical "problem and solution approach" referred to in decision **T 465/92** is present in the case at hand [i.e. **T 188/09**], i.e. neither can the claimed subject-matter be considered as breaking new ground, since document D4 describes a G-protein coupled receptor specifically located in taste cells nor is there a large number of equally close prior art documents (see points 9 to 13 below).

Thus, having considered the rationale in decision **T 465/92** the present Board does not see a reason to apply the approach adopted by the Board in that decision rather than the classical "problem and solution approach".

### **F. Conclusion**

The application of the problem and solution approach has evolved over the years. However, the problem and solution approach is still - and more than ever - the one and only prayer before the EPO and has pushed all other approaches into the field of heresy. The problem and solution approach is even applied outside the scope of the EPC since the PCT International Search and Preliminary Examination Guidelines also suggest applying this approach<sup>19</sup>. Although the problem and solution approach appears to be algorithmic<sup>20</sup> in nature and hundreds of decisions of the Boards of Appeals give advice on how to apply the approach in many cases, its outcome is in the eyes of the author of this article not always predictable. Ultimately, the question of "inventive step" is a legal question and assessing inventive step is an act of judging which involves subjective elements. In patent law and in many other legal fields the roman legal principle "Iudex non calculat." still applies. Nevertheless, the problem and solution approach is a systematic approach and that alone may be the reason for its success and longevity.

<sup>19 &</sup>quot;One specific method of assessing inventive step might be to apply the so called "problem-solution approach", PCT International Search and Preliminary Examination Guidelines as in force from October 1, 2015, Appendix to Chapter 13, page 117, http://www.wipo.int/export/sites/ www/pct/en/texts/pdf/ispe.pdf

<sup>20</sup> Not surprising in view of the high number of scientifically educated people in patent law. Not surprising either if the search tools used by the EPO Examiners already supported the problem and solution approach by e.g. suggesting documents from the same, broader or neighbouring technical fields which in combination anticipate all the features of a claim.

#### **Disclaimer, Union IP Position Paper**



Note from the Editorial Committee: It is our intention to seek to inform our members of developments and/or opinions of members and others in the field of IP. We therefore scrutinise rigorously requests for publication in **epi** 

Information with we trust transparency and fairness, there being an understood caveat that the views and

opinions expressed in documents that are published are solely those of the author(s), and not those of the **epi** or of the Editorial Committee. Neither the **epi** nor our Committee accordingly endorses the views and opinions expressed in documents selected for publication. With the above statement in mind, we publish below for the information of members a position paper recently submitted to us by UNION IP.

### Position Paper Grace Period for Patents

*The President* Jochen Kilchert On Behalf of the UNION-ip ExCo The Patents Commission of UNION-ip *The Vice President* Reinier Wijnstra

*Member* Cyra Nargolwalla

### I. Introduction

NION-ip is an association of practitioners in the field of Intellectual Property, that is of individuals whose principal professional occupation is concerned with patents, trademarks or designs and related questions and who carry on their profession independently or as employees. UNION-ip is a private, free, international Association which is not dependent on any national or international authority: it approves its own members, in accordance with its statutes, in total independence, and likewise decides on its own activities and its own budget. It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improvement of professional and personal understanding between European Practitioners in the Intellectual Property field in different countries and different branches of the profession.

UNION-ip maintains close contacts with International authorities such as WIPO (The World Industrial Property Organisation), the European Patents Office, and the Commission of the European Union, and it is invited to their consultations and discussions. It participates regularly as a non-governmental organisation with observer status at International Conferences.

### **II. Comments**

Patent law is harmonised on an international level to a great extent. One subject that is dealt with differently in

different countries is the so called grace period. In short, grace period is the period that an inventor may disclose his invention before he files a patent application. Some countries apply a grace period of half a year, others of a full year, while several other countries don't apply a grace period at all. A grace period exists in countries such as the United States of America, Korea, and Japan. On the other hand, none of the European countries have a grace period for patents, although Germany does have a grace period for utility models.

Important International IP associations such as FICPI and AIPPI are in favour of a harmonized global grace period. This is because the existence of grace period possibilities in some countries but not others has a negative effect on both patent holders and third parties, due to the uncertainties and discrepancies which arise. Thus, FICPI and AIPPI have both taken the position that a strictly applied grace period, with a narrow scope (also known as a "safety-net" grace period) would be beneficial for both patent-holders and third parties.

### III. Position of UNION-ip

Union-ip is in general in favour of harmonisation of IPlaw. This applies a fortiori to the subject of grace period. It is confusing at least for many applicants, that it is possible to get a patent in a country like the United States of America after presenting ones invention to the public, while it became impossible in for instance the countries of Europe due to that same presentation. Due to this confusion, inventors in countries with a grace period involuntarily loose the possibility of worldwide protection, while inventors in countries without a grace period don't realise that they still can obtain a patent in several important countries even though they might have lost that possibility in their own country. Accordingly, the main and unanimous position of Union-ip is that it were best if a grace period would exist either worldwide, or in no country at all.

The position whether a harmonised patent world should have a grace period, or not, is not unanimous. A majority of the patent commission of Union-ip is against such a grace period, while an important minority is in favour. The arguments pro and con will be presented below.

The majority of the members of the patents commission is of the opinion that although a grace period could help out inventors in some cases, overall it adversely affects legal certainty, not only for third parties, but also for the inventors.

A first disadvantage for third parties is that there is a longer period of uncertainty before it is known whether someone has filed a patent application for a certain inventive product or method, or not. In a system without a grace period, one is sure that a patent application – if one has been filed – will publish within 18 months after filing. As the filing needs to be done on the day of disclosing the invention the latest, one knows that the publication will be 18 months after disclosure the latest. In a system with a grace period, the duration of the grace period will be added to this, so the uncertainty will last 24 or 30 months.

A second disadvantage is related to the first one, as third parties will be uncertain for what elements of a novel product or method protection is sought, and what the claimed scope of protection for these elements is, for a period of 24 or 30 months, instead of 18 months. It is quite legitimate in the patent system to design and market alternatives for an inventive product or method, as longs as these fall outside the scope of the earlier patent. As long as the patent application is not published, it is unknown what scope is claimed, and it is not possible to investigate whether the claimed scope is likely to be granted or not.

A third disadvantage for third parties is that it becomes more difficult to assess the validity of a patent (application), as pieces of prior art that would be detrimental for the patent (application) might be graced. As a result, the third party needs to investigate for each piece of prior art whether it comes from the inventor, is based on a disclosure by the inventor, which are graced, or comes from an independent source and is not graced.

A grace period introduces uncertainty for inventors too. Third parties might become inspired by a disclosed new product or method, and develop a related alternative. Then he could perform one or more of the following actions before the original inventor files a patent application. Firstly, he could simply start using his alternative and obtain a prior use right as a result, so the later filed patent application cannot stop him. Secondly, he could simply disclose the alternative. Both the first and the second action results in the alternative becoming prior art against the later filed patent application of the original inventor. This application then needs to be novel and inventive over the alternative. In many cases, this means that the invention needs to be claimed more narrowly, as a more broad claim would not be novel over the alternative. Even this narrow claim risks being rejected, as it may lack inventive step in view of this alternative. A third action would be to file a patent application for the alternative (or improvement), which may limit the original inventor in exploiting his idea.

Another uncertainty for the inventor, is whether he is able to prove that all publications that are done before filing for a patent are actually derived from his own disclosure(s). An author of an article may deviate from the original disclosure and not mention the original source. This might result in reasonable doubt whether this is an independent disclosure, which is not graced, or a disclosure based on the inventor's disclosure which should be grace.

Given the risks for the inventor, the best option is always to file first before disclosing, even if there is the option of a grace period. However, once it is known that a grace period is available, a lot of inventors will know just that, and will be unaware of the risks. As a result, they will rely on the grace period while that is not in their interest. In the opinion of the majority of the patents commission, this disadvantage is bigger than saving the rights of the few inventors that are not aware of the 'file first' principle of patent law. Accordingly, it is best to further reduce this unawareness by educating the public consistently that one should file before disclosing, instead of creating an inappropriate notion that early filing is not that important.

A minority of the members of the patents commission is in favour of a harmonized grace period. In their view, a harmonized, safety-net grace period would overcome the disadvantages outlined above, and would greatly benefit all users of the patent system. This is because the safety net grace period would be limited to providing protection only against applicant's own disclosures, or those of a third party which directly reproduce or result from applicant's own work. Such a safety net grace period would not protect the applicant from thirdparty disclosures resulting from independent research. Thus, this type of safety net grace period would still always encourage applicants to file at the earliest possible stage. Furthermore, a global grace period having the same time period (commonly agreed as either 6 months or 12 months) would also reduce the uncertainties which arise from the present unharmonized situation. Thus both patent holders and third parties would be aware that limited types of disclosures (as indicated in the paragraph above) would be "graced" for a limited time period, and this would apply in all territories.

Although the upholders of grace period favour a system without an obligatory declaration which lists the publications that should be graced under the grace period, it is noted that the opponents of a grace period consider this a measure that mitigates the negative effects of a grace period for third parties. When a third party is interested in developing a product that might infringe a pending patent application, it is often desired to evaluate the strength of such application Such third party might be aware of publications that could harm the pending application. Accordingly, it is important to know whether or not these publications are 'graced' or not. Such information should be obtainable from the prosecution file.

Another measure that would mitigate the adverse effects of a grace period is adjusting the publication period. Currently, the publication period of a patent application is 18 months from the earliest priority date. Only when a patent application is published, a third party is able to evaluate how strong the resulting patent might be. However, a grace period extends the period between the first publication or even market introduction of a new product and the moment of publication of the related patent application. Accordingly, a third party has to wait longer before he knows what the strength of the patent application as, and base a strategy on this (e.g. designing around the patent). It is therefore proposed to count the 18 months publication period from the earliest priority date, or the earliest disclosure date as indicated in the declaration of graced publications, whichever is the earliest.

### Optional Features, Article 84 EPC and Rule 137(5) EPC - An Ambiguous Relationship?

Y. Robin (UK)



Yann Robin

t is not uncommon for the use of optional language in the claims to cause difficulties at the EPO. European Examiners sometimes object that including terms such as "optionally", "or", and "preferably", contravenes Article 84 EPC (lack of clarity). Other Examiners, without raising an objection *per se*, consider that optional features are non-limiting and therefore should be

disregarded. A more recent trend that has been observed is the rise of objections that "optional" features are considered "unsearched" for the purposes of Rule 137(5) EPC. In this article, I investigate the nature of and the legal basis for such objections, and the implications that such objections may have on the Applicant's ability to amend the claims during examination.

### Background

In the June 2012 edition of the **epi** Information<sup>1</sup>, I investigated the increasing occurrence of objections under Rule 137(5)

EPC raised by European Examiner during examination, and the legal framework surrounding the applicability of Rule 137(5) EPC. Rule 137(5) EPC states that "[a]mended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept". In particular, it was observed that, in the light of the wording of Rule 137(5) EPC, of the corresponding sections of the Guidelines for Examination, and of the relevant case law, unsearched claims should not always imply unsearched subject-matter for the purposes of Rule 137(5) EPC. It was therefore concluded that, in many cases, the EPO tends to apply a rather liberal interpretation of Rule 137(5) EPC.

Following the significant increase in 2008 in claims fees for each claim in excess of 15, a common tactic to reduce the total number of claims to be searched by the EPO, while maintaining as much of the originally claimed subject-matter as possible, involves combining related features into a single dependent claim, for example by using terms like "optionally", "or", "preferably", or the like.

While it was not unexpected to observe numerous instances of objections from the EPO on the grounds that such wording can, in some cases, contravene Article 84 EPC (lack of clarity), or that such optional features are simply non-limiting and therefore should be disregarded, a significant increase in the

<sup>1</sup> epi Information, June 2012, Volume 2|12, pages 44-47

number of objections stating that "optional" features were "unsearched" for the purposes of Rule 137(5) EPC has been observed.

In this article, I investigate the nature of and the legal basis for such objections, and discuss the implications that such objections may have on the Applicant's ability to amend the claims during examination.

### **Claim Amendments and Article 84 EPC**

Following entry into the European phase of a PCT Application, the EPO issues a Communication under Rule 161 EPC, giving the Applicant an opportunity to amend the claims and pay any excess claims fees due for any claims in excess of 15.

At that stage, whether for commercial or strategic reasons, the Applicant may wish to maintain in the claims a number of distinct features which were originally recited in different dependent claims. Thus, in cases for which the Application originally contained more than 15 claims, the Applicant may require the amended claims to contain subject-matter relating to more than strictly 15 claims of the original claim set. This may be particularly true of overseas-originating Applications, which may not have been drafted with European regulations in mind. However, due to the prohibitive excess claims fee regime in operation at the EPO, it may not be financially viable to include more than 15 claims in the amended set of claims. In an effort to solve this dilemma, a common tactic used by patent attorneys involves combining related features (within reason) into a single dependent claim, for example by using terms like "optionally", "or", "preferably", or the like, in order to cover multiple embodiments in a single claim. This practice can sometimes lead to an objection under Article 84 EPC, alleging that such claims lack clarity.

Referring to paragraph F-IV-4.9 of the Guidelines for Examination in the EPO, "[e]xpressions like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional."

Whilst it is generally accepted that optional features are nonlimiting to the scope of a given claim, it is less evident in which cases the use of such language can always be considered to "introduce ambiguity". In a recent Decision<sup>2</sup>, the Board of Appeal had to review the Examining Division's refusal of claims (which were otherwise novel and inventive), because of alleged lack of clarity of dependent claims containing the terms "preferably", "particularly preferably", and "in particular". Critically, the Board of Appeal held that there are no express provisions in the EPC that preclude the inclusion of optional features in claims, provided that the inclusion of such language does not create any ambiguity or confusion in the scope of the claims. Therefore, this Decision confirms that the mere existence of words like "optionally", "or", and "preferably" should not systematically trigger an objection under Article 84 EPC. Rather, an objection should only be raised if the language used in the claim in question generates real ambiguity or confusion as regards the scope of such claim.

Of course, in practice, once an independent claim has been allowed, an Applicant may be willing to delete some optional features present in dependent claims in order to expedite grant.

### Article 84 EPC and Rule 137(5) EPC

Notwithstanding the above interpretation of Article 84 EPC by the EPO, a potentially much more significant impact of the inclusion of optional features in a claim is whether or not such features can be considered to be "unsearched" for the purposes of Rule 137(5) EPC.

### The objection

The specific wording of this objection inevitably varies from one case to another, but the gist of the objection raised by certain EPO Examiners is that, because "optional features" do not limit the scope of the claims, they have been excluded from the search, and so are considered to be "unsearched" for the purposes of Rule 137(5) EPC. This in effect prevents the Applicant from being able to use such features as basis for a later amendment to the independent claims. If the Applicant attempts to amend the independent claims by introducing "unsearched" subject-matter, such amendment will normally be refused, and the Applicant will need to file a divisional application in order to pursue such subject-matter<sup>3</sup>.

### Legal Basis

While a comprehensive analysis of the legal principles surrounding what constitutes "unsearched subject-matter" was provided in my earlier article published in the June 2012 edition of the **epi** Information<sup>4</sup>, a summary of these principles is provided below:

Rule 137(5) EPC recites as follows (emphasis added):

"Amended claims may not relate to **unsearched** subjectmatter **which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.** (...)".

The Guidelines for Examination in the EPO state at paragraph H-II, 6.2:

"If amended claims are directed to subject-matter which has not been searched (e.g. because it only appeared in

<sup>3</sup> Guidelines H-II-6.2

<sup>4</sup> epi Information, June 2012, Volume 2|12, pages 44-47

<sup>2</sup> T 1882/12

the description and the Search Division did not find it appropriate to extend the search to this subject-matter, see B-III, 3.5) and which does not combine with the originally claimed and searched invention or group of inventions to form a single general inventive concept, such amendments are not admissible".

It is further stated at paragraph B-III, 3.5:

"In principle, and insofar as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended".

Thus, paragraph B-III, 3.5 of the Guidelines clarifies that the search should cover not only the subject-matter of the claims, but also the subject-matter which might reasonably be expected to form the basis for a possible amendment.

As regards the possible interpretations in respect of the phrase "to which they [the claims] might reasonably be expected to be directed after they have been amended", T274/03 highlights that:

"(...) it is clear that post-search "switching" of subjectmatter clearly implies a **significant change in the nature of the subject-matter being claimed** which is not normally comparable to the addition of features taken from the description to further define an element that was already a feature of the original main claim.

In accordance with the case law of the Boards of Appeal (**T 377/01**, point 3.1 and T 708/00, point 17, both decisions not published in OJ EPO) the Board is of the opinion that an amendment amounting to the restriction of an original main claim by including complementary features from the original description into the claim represents an admissible reaction of an applicant vis-à-vis an objection against the patentability of the unamended claim and does not constitute an abuse of the system of the nature which Rule 86(4) EPC was introduced to prevent. This type of amendment should not therefore in general be judged as contravening the requirements of the rule, even though an additional search may be required".

From the above legal framework, it can be concluded that:

- The purpose of Rule 137(5) EPC is to prevent Applicant from "switching" the claimed subject-matter during examination to a different invention, when a search fee was not paid in respect of that invention;
- The mere fact that a specific feature in a claim was not searched (e.g., for clarity reasons) does not necessarily mean that the subject-matter in question was "unsearched" for the purposes of Rule 137(5) EPC;
- Unsearched claims should not always imply "unsearched subject-matter" as defined in Rule 137(5) EPC.

In the author's view, if the Applicant deliberately included certain features in the original dependent claims, then it seems logical that such features could be expected to form the basis for an amendment during examination. Considering that "the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended" (see B-III, 3.5 above), and provided that no lack of unity was raised in respect of such features, the mere fact that a specific feature was reformulated as being "optional" during examination, and was subsequently not specifically searched by the EPO, cannot serve as justification for refusing an amendment to include such feature during examination provided there is no switching in the inventive concept. Of course, a "top-up" search might be appropriate in such instance<sup>5</sup>.

Reaching a different conclusion would potentially lead to an Applicant being put at a disadvantage for including certain features in the claims over the same features being left out of the claims and being merely present in the description. Indeed, it is not uncommon to include a feature originating from the description in an independent claim, for example to overcome a prior art reference. Clearly, if that feature was not present in the dependent claims, then it was not originally specifically searched by the EPO. Yet, provided that it combines with the same inventive concept as the claims originally searched, that it complies with Article 123(2) EPC ("added matter"), and that it leads to an allowable claim, such an amendment is normally permissible. Therefore, it would seem somewhat obtuse for the same amendment to be rejected under Rule 137(5) EPC merely because it was included as an optional feature in a claim and was not **specifically** searched by the EPO pursuant to Article 84 EPC.

### Conclusion

It appears that a consistent interpretation of the wording of Rule 137(5) EPC is yet to be applied by the EPO. It also appears that a trend in a new relationship between Article 84 EPC when relating to "optional" features, and Rule 137(5) EPC, may be developing. It is the author's opinion that, based on the existing legal framework surrounding the applicability of Rule 137(5) EPC, this relationship appears to lack legal basis. Therefore, it is to be hoped that, until certainty on this matter emerges, Applicants will not suffer undue side effects derived from objections raised under Article 84 EPC, such as those discussed in the above scenario. I would of course welcome any comments and/or diverging views on this topic from fellow attorneys.

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With thanks to Paul Chapman (Partner at Marks & Clerk's Edinburgh office) and Mairi Rudkin (Associate at Marks & Clerk's Glasgow office). Both are European Patent Attorneys.

<sup>5</sup> T274/03; Guidelines C-IV-7.2

### Drafting & Amendment of European Patents, Author: Brian Cronin

by P. Rosenich

**B** rian Cronin is one of the early EQE trainers who did not only consider legal questions and practical aspects of the IP-work but also the psychological mechanisms of learning/teaching the exam situation and practical skills in writing exams. He is an excellent Tutor at CEIPI and Patskills.

Coming from industrial patent departments and working successfully as independent patent attorney in free practice during many decades he gained also an extensive knowledge of European Patent law and practice.

Just ready before the hot training period for EQE-candidates in Autumn 2016 and as a must for all practitioners, Patskills published the second edition of DRAFTING & AMENDMENT OF EUROPEAN PATENTS in two handy volumes printed from SHOP MY BOOKS. Both volumes have together more than 440 pages of easily legible Din A4 format text. The book fits perfectly into briefcases and computer back packs – at least when the volumes are taken separately.

Copies of the book can be purchased from the printer/binder www.shopmybooks.com when keying in the words "drafting patents". You have to purchase each volume separately and the two will be sent together.

Volume 1 of this book refers to generalities, where the reader may reflect questions about embarking on drafting, protection conferred, client considerations, influences of PCT and US-Patent law, drafting trends, claim interpretation and others. An extensive list of explanation of terms which are used on both sides of the Atlantic Ocean allows younger professionals to understand/translate terms like "free beer claims" and "couldwould".

Volume 2 of this book refers to fundamentals and covers aspects that every drafter needs to understand as basis for successful drafting of European patents in an international environment. Here the book is astonishingly relevant, as it e.g. comments already about the Brexiteffect on the Unitary Patent.

Volume 2 covers further claim types, formats and sets and refers directly to the Guidelines for Examination at the EPO. Also the considerations to draft a good description find ample space on more than 30 pages.



Volume 2 also covers the various possibilities for making changes at different stages of the procedure before the EPO.

A list of topic headers in alphabetic order helps the reader to quickly find the relevant chapter.

A table of claims referred to by order of introduction and in alphabetical order and the sources of those claims is also useful, if someone wants to find a decision of the Boards of Appeal or reference to an EQE exam.

In the foreword for the  $2^{nd}$ 



Paul Rosenich

Liechtenstein, Swiss and European Patent Attorney Chairman of **epi** Disciplinary Committee Comments welcomed: rosenich@rosenich.com

volume Brian Cronin writes: "All drafters must master these fundamental requirements". I cannot do more than confirm that the profession of European Patent Attorneys has to act according to the **epi** Code of Conduct with professional competence which of course includes knowledge about the fundamentals of our practice and law.

Certainly, one can and has to at least study the EPC, the Case Law Book of the Boards of Appeal and the Guidelines for Examination. However, having Brian Cronin's book Drafting and Amendment of European Patents at hand provides a complement to the official materials presented from the drafter's viewpoint. This

> greatly facilitates the task to get into and understand the most important principles of our current European Patent System and Practice.

> For the more experienced practitioners, it is a practical book to remember some basic principles even if they are not every day on one's desk. It further helps the senior patent attorneys to focus their training for EQE-candidates on the relevant questions and topics related to everyday drafting and to the exam.

> I thank Brian Cronin for his work to provide this practical and highly relevant book.

# Smart in C, A simple and efficient methodology for EQE paper C;

Authors: Nyske Blokhuis and Cees Mulder Book review by Harrie Marsman

### Harrie Marsman

European professional representative before the EPO; tutor for the EQE The aim of the book Smart in C is already given in its subtitle: it wishes to provide a simple and efficient methodology for paper C of the EQE. To reach this aim, Nyske Blokhuis and Cees

Mulder have developed the "Maastricht method", named to the University to which they are associated.

The authors show a high level of knowledge on how to deal with the C Paper both on a theoretical and a practical level.

The book consists of 83 pages dealing with a practical approach on how to analyze the case that is presented in C papers, how to select the attacks, and how to formulate the attacks in an answer paper. After this, the method is demonstrated in all details on the EQE 2015 C Paper. The core of this new method is formed by a smart use of a number of highlighters in different colours and key words/annotations on the actual

opposition paper pages, supplemented by a so-called "do-not-forget list" and a simplified novelty matrix. One needs a good discipline on the simple steps, but once you get used to this method, I can imagine that it is quite time saving compared to other methods; and especially compared to methods, wherein very large and/or complicated matrices are used.

I close this short review with a sentence laid down in this book: There is one major criterion in selecting the method for the analysis of the C paper: select the one that works for you to score sufficient marks within the time set for the Exam. One of the best things of this new book is that it is written with the aim of passing the exam paper. It is concise, easily readable and focuses only on what one needs for Paper C. Even if you do not use the Maastricht method or have insufficient time to practice it, I consider it full of helpful information that can be read in just a few hours.

### How to use the Forum on the **epi** Website

S. Liebig (epi Secretariat) on behalf of the Editorial Committee

n the right-hand column of the **epi** website you will find the category "Forum" – this category is only visible after login as this area is restricted for our members.

After having successfully logged into the **epi** website, every member will have available all forums for which he has access rights. The **epi** Secretariat has created forum channels for every body of the **epi** (such as Council, Board and any Committee of the **epi**), but the individual member will only see the forum channels of the groups to which he belongs.

However, it is possible to create further forum channels upon request – the Secretariat can create a forum channel for any individual group and assign the access rights accordingly – and this is applicable for any existing group within the **epi**, a composition of several groups and also for individual members of the **epi** or a group plus an additional member. Therefore, all possibilities to create an individual forum channel are possible.

### To start a new tread

Any member of a forum channel who has access rights to this channel can open a new thread within the forum channel to start a new discussion.

To do so the member has to click on "start new thread".

In the following window the member can give a title to the thread, draft a description and add any relevant documents as attachments.

The staff of the **epi** Secretariat have the moderation rights for every forum channel on the **epi** website and can edit and revise any contribution upon request.

Any member of the forum channel has the possibility to subscribe to a forum channel as well as to an individual forum thread in order to receive a notification as soon as a new contribution has been added or if there has been any change. This subscription can be activated and deactivated at any time.





Title *		
Body *		
Attachments		add document

#### **Private Message**

Furthermore any member of a forum channel can send a "Private Message" to all participants of the forum channel and/or thread.

This offers the possibility to contact any member of the forum channel without knowing his email address and vice versa without providing any personal details any member of the group can be reached. All **epi** members have a "Private Message" account on our website which is implemented in the right-hand column of the **epi** website. As soon as a new message has been sent, the member receives a notification by email and the message that a new message has arrived appears in the account of the member accordingly.

All Private Messages are stored in the section "My Account" and can be replied to, deleted or saved by the member upon request.

In addition to this possibility the Secretariat can give moderation rights to one or several members of the forum channel. These moderation rights will allow to this person to revise and delete contributions and to close a thread upon request. This moderation function would be a possibility for all Committee Chairs to moderate their own channels and threads within their Committees.

### **Shared Desk**

The "shared desk function" within the forum is a possibility to add a document to the thread of a forum which can be edited by any person who has access rights to this forum channel.

The intention is that several members of a group can work on the same document and that not any revised version of a document should be updated. As soon as a document is uploaded in the forum thread, every member of the forum channel can "check out" the document. Therefore the document will be uploaded on his personal computer for revision. After the revision has been completed the member has to "check in" the document in the forum thread again. The status of the document and which person is temporarily working it is transparent for every member of the group. Every version of the document, every change and date of change and every editor name is saved in the history data and therefore always available and traceable. Only one person can work on the document at a time- as soon as he has "checked out" the document for revision, the document is only visible to the other persons of the group -in order to guarantee that all members are working on the same document.







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As a leading innovative company, Philips has a large IP portfolio with tens of thousands of patents, trademarks, designs, copyrights and trade secrets with a strong focus on leading-edge technology areas such as healthcare and consumer well-being. Maximizing the value of that IP requires technical knowledge, affinity with intellectual property, investigative skills and out-of-the-box entrepreneurial thinking. We don't just protect our inventions. We proactively search out new applications, markets and business models, in which we can use our IP to generate substantial new revenue streams. http://www.ip.philips.com

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Eingangsfrist im epi-Sekretariat:

15. Februar 2017

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (epi) wird hiermit ermächtigt, den jeweils gültigen epi-Jahresmitgliedsbeitrag für das genannte Mitglied einzuziehen. Der Einzug erfolgt einmalig am 25. Februar des laufenden Jahres von dem nachfolgend anzugebenden Konto beim Europäischen Patentamt (EPA). Die Einzugsermächtigung wird wirksam beginnend mit dem Jahresmitgliedsbetrag 2017 und gilt für künftig fällige Mitgliedsbeiträge bis auf schriftlichen Widerruf. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem epi getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABI. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABI. EPA 1993, 366).

Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen werden dem Einzug des **epi**-Beitrags vorgezogen. Bitte stellen Sie sicher, dass im Abbuchungszeitraum Ihr EPA Konto über eine ausreichende Deckung verfügt.

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