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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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Information

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Cover:
Die Welle (The Wave)
Cotton, sewn and
quilted with machine
by Dr. Sabine Reicheneder
(European Patent Attorney, DE),
Part of the **epi** Artists
Exhibition 2018 at the EPO, Munich

Dr. Sabine Reicheneder

Dr. Sabine Reichender, geboren 1972 in München, studierte Chemie und promovierte anschließend im Fachbereich Naturstoffsynthese. Seit 2005 ist sie im IP Bereich als Industrie- und Patentreferent tätig. Nach erfolgreichem Abschluss des EQE 2013 arbeitet sie derzeit als Senior IP Counsel bei BASF in Ludwigshafen.

Seit 1999 macht sie Patchwork als Hobby und legt dabei seit 2007 zunehmend Wert auf den Textilkunst-Aspekt. Hierfür besuchte sie zahlreiche Kurse und Weiterbildungen und ist Mitglied der Patchworkgilde Deutschland e.V., Heidelberg Hearts and Castles Quilt Guild e.V., Patchworkgruppe Hockenheim

Dr. Sabine Reicheneder was born in Munich in 1972. After studying chemistry and her PhD in natural substance synthesis, she specialized in IP. Currently she works as Senior IP Counsel at BASF SE, Ludwigshafen, Germany.

She pursues patchwork as her hobby since 1999, with a stronger focus on the textile art aspect since 2007. Therefore she is participating at many courses and trainings and she is member of the Patchworkgilde Deutschland e.V., Heidelberg Hearts and Castles Quilt Guild e.V., Patchworkgruppe Hockenheim.

Le Dr. Sabine Reicheneder est née à Munich en 1972. Après ses études de chimie et sa thèse sur la synthèse de substances naturelles, elle s'est spécialisée en PI. Elle travaille actuellement comme Senior IP Counsel chez BASF SE, à Ludwigshafen (Allemagne).

Elle pratique le patchwork comme loisir depuis 1999 avec un intérêt tout particulier pour l'art textile depuis 2007. Elle participe ainsi à de nombreux cours et formations, et elle est membre de la Patchworkgilde Deutschland e.V., de la Heidelberg Hearts and Castles Quilt Guild e.V., et du Patchworkgruppe Hockenheim.

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Editorial

M. Névant (FR), Editorial Committee

The sound of silence

Marc Névant

The 85th Council Meeting took place last month in Helsinki. Finland is known for its breathtaking landscapes; 70% of the land is indeed covered by forests which – according to an official source[1] – are well managed! We also learnt from our Finnish colleagues that their beautiful country has 5 seasons (there are 2 winters). There are many reasons to love Finland[2] one of which is that people can listen to silence – a luxury in modern times.

During the Meeting, a video message from the President of the EPO, Mr. Campinos, was presented the text of which is reproduced on page 9. Mr. Campinos notably indicated that the EPO "wants to work more closely with the **epi** to see how we can ensure the European patent system continues to function effectively and can continue to serve our users". A dialogue has commenced on the quality management process at the EPO (see https://patentepi.com/en/epi/news/125). While we have little doubt that **epi**'s voice will be heard, we wonder whether our voice will actually be listened to. We appreciate that it may be difficult for the EPO to strike an appropriate balance between their internal needs and users' needs. We, however, believe that a sustainable patent (eco)system can no longer work without taking into account – and implementing to the extent possible – input from users.

This time of the year reminds us that the northern part of Finland (Lapland) is the home of Santa Claus. Santa will bring our readers a brand new format of **epi** Information (starting as of 2019) with publication dates one month earlier than the current publication dates. Your contributions for the next issue should, therefore, reach us by 14 January 2019!

The Editorial Committee sincerely wishes all our readers a Happy Christmas and a Healthy and Prosperous 2019.

1 https://www.bbc.com/news/world-europe-46256296
2 See e.g. https://www.visitfinland.com/article/greatest-things-about-finland

Nächster Redaktionsschluss für **epi** Information	Next deadline for **epi** Information	Prochaine date limite pour **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 **14. Januar 2019**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.	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 **14 January 2019**. Documents for publication should have reached the Secretariat by this date.	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 **14 janvier 2019**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Report from the 85th Council Meeting in Helsinki on 10th November 2018

M. Névant (FR), Editorial Committee

President Leyder opened the meeting at 9 am and welcomed the participants. The Secretary General informed the audience that 133 members (out of 139) were present - that number rose to 137 later in the meeting. The agenda was adopted with a slight change: the election of committee members was added under item 8. The minutes of the 84th Council meeting were then adopted.

Matters arising from the minutes of C84

An action point arising from the said minutes was still outstanding, namely the implementation of a double signature system for expenses exceeding 5,000€. Council was informed that the system would probably "go live" next year subject to further discussions between the Internal Auditors and the Presidium.

Report of the Board, President and Vice-Presidents

The President referred to his report submitted in advance of the meeting. Council was informed that the minutes of the last Board meeting were not available in time for the Council meeting and will be dispatched as soon as possible.

Video message of EPO President

The president of the EPO, Mr Campinos, addressed Council via a video message. The content of the message is published immediately after this report.







Report of the Secretary General

The Secretary General next referred to his report submitted in advance of the meeting.

Council was informed of the dates of the next meetings: the 86th meeting will take place in Sofia on 11th May 2019. The 87th meeting will take place in Lisbon on either 16th November or 23rd November 2019. The 88th meeting will probably take place in the UK (date in 2020 and venue to be determined). The 89th meeting will take place in Lubjana in November 2020.

Council then proceeded to elect the following members:

- Ms Hülya Cayli (TR) was elected as member of the PCC with effect as of 1st January 2019. Ms Cayli will replace Ms Selda Arkan (TR) who has been appointed to the Disciplinary Board of Appeal (DBA) with effect from that date.
- Ms Natasa Marsic (HR) was appointed to the DC with effect as of 1st January 2019 in replacement of Ms Dina Korper Zemva (HR) who has also been appointed to the DBA with effect from that date.
- Mr Pierre Gendraud (FR) was appointed substitute member of the By-Laws Committee (BLC) with effect as of 1st January 2019.

Report of the Treasurer

The Treasurer then presented his report on the 2018 budget. As of the end of September income is in line with what was planned. As far as expenses are concerned IT costs are higher than planned notably because secretariat staff had to be trained to the new bookkeeping software and management tool implemented at the end of last year. These higher costs are however balanced by lower costs than planned for committees. Overall the Treasurer indicated that there was no need to adapt the 2018 budget and the planned deficit of 42 k€.

The Treasurer then gave an update on the professional liability insurance. So far 138 k€ have been collected, no minimum amount is due at the end of the year in contrast to what was originally planned by our broker. A change of syndicate has been decided because the premiums for the big firms were not competitive, the new syndicate agreeing to lower those premiums. The solution offered by **epi** appears to be in line with what is required by the German PAK (Patent Anwalt Kammer). The situation is not so clear cut with what is required by IPREG in the UK.

The Treasurer also gave details on the support given by **epi** to the EQE Committees. Since 2017 a pre-marking meeting is organized (typically in April) in one and same venue for all EQE Committees. This has a cost. The EPO has indicated that they would reimburse all meeting costs up to 150 k€, the difference if any being borne by **epi**. For 2019 it is expected that **epi** would have to pay from 10 to 25 k€. In addition, **epi** pays each year a dinner for all Committee members (typically in June in Munich). It is proposed, as of 2019, to organize the annual dinner during the pre-marking meeting, which would reduce the overall costs borne by **epi**. This will require amending Council decision in C49 (mentioning that the annual dinner takes place in Munich).

The Treasurer also reminded Council members that amended Rule 154 EPC will enter in force on 1st January 2019. The annual subscription will be due at the end of March (versus end of April in previous years). A reminder will be sent by mid-March if no payment has been received. Payments by credit card or Paypal will no longer give rise to extra fees.

Reports of the Internal Auditors/double written approval system

The Internal Auditors informed Council that they were still discussing the implementation of the system with the Treasurer and the Presidium, and will make proposals to be voted on during the next Council meeting.

2019 Budget/report of the epi-Finances Committee

The Treasurer informed Council of the main expenses to be incurred in 2019:

- A legal opinion on the status of **epi** as an international organization should be delivered early next year. A working group will be formed with the BLC to check whether this status is compliant with the Founding Regulations.
- Offers for an online voting tool have been received, the choice of the selected tool will be made in the first quarter;
- **epi** insurance portfolio will be reviewed with the aim of consolidating the investment asset rules decided in C74 and C77;
- It is planned to streamline the internal process for reimbursing expenses, an electronic tool will be used to that effect; the Treasurer will work with the Finance Committee on this project, which will require a revision of the reimbursement rules as set forth in the By-Laws;

- A budget of 138 k€ is planned for **epi** representation, with a focus on improving communication, which budget includes:
  - modernizing the back structure of the website (switch to a modular system);
  - working on a strategic communication plan (with the help of a specialized agency);
  - "revitalizing" **epi** information;
  - organizing a welcome celebration for new **epi** members.

On the income side, the Treasurer proposed to maintain the subscription fee unchanged (190 € if paid by end of March then 210 €; 95 € for **epi** students). More seminars should be organized in 2019, some with a new format, e.g. an intensive course on the EQE D2 paper.

Overall the balance income/expenses should result in a planned deficit of 65 k€.

The **epi**-Finances Committee informed Council that they approved the 2018 budget and that they had some concerns about the 2019 Communication plan. The "good job by the Treasurer" was nonetheless highlighted.

After hearing the report of the Treasurer and the comments of the **epi**-Finances Committee, Council approved the 2019 budget and the amount of the 2019 subscription fee.

Report of the European Patent Practice Committee (EPPC)

The Chair of the EPPC reminded Council members that a forum is available to discuss all EPPC-related matters, and that said forum needs to be used as much as possible. A number of submissions were made in 2018 including:

- an amicus brief on G1/18
- a letter to the president of the Boards of Appeal (in relation to the new rules of procedure of the Boards of Appeal).

A position paper will be prepared concerning ODEC (Office Driven Early Certainty – i.e. deferred examination).

Report of the Online Communication Committee (OCC)

A draft letter to the President of the EPO was presented by the Chair of the OCC, which addressed the following points:

- electronic notifications from the EPO (Mailbox, MyFiles);
- Online filing: "new" Online Filing System;
- Online filing: closure of "old" Online Filing System;
- Rescue/emergency filing (need for a backup system e.g. fax);
- Authentication and access (limitations of smart card);
- OOXML (docx) filing.

Details on the above points can be found in the report of the OCC published elsewhere in this issue.

Council approved the sending of a letter along the lines mentioned above.

Report of the Professional Conduct Committee (PCC)

The Chair of the PCC presented a proposed amendment to the Code of Conduct (CoC) to take into account activities before the UPC. In order to have the CoC amended, it was necessary that Council approves a request to have the Regulation on Discipline (RoD) amended by the EPOrg Administration Council.

Council approved the proposed amendment to the CoC (134 votes in favour, 1 vote against, 0 abstention) and the request to have the RoD amended (130 votes in favour, 0 against, 0 abstention).

Report of the By-Laws Committee (BLC)

The Chair of the BLC reported on the activity of the Committee since the last Council meeting. The BLC notably addressed the following topics:

- amendment of article 1 (consistency with article 134 EPC) and 8.2 (term of office of Board members) of the By Laws (BL);
- amendment of article 54 BL (election of committee members) to set the principle that any **epi** member can be a candidate for the election of any committee (the possibility for full Council members to propose candidates being maintained).

Amendments to articles 1, 8.2 and 54 BL were thus presented to Council. The first two amendments were approved unanimously; the last amendment was approved by a large majority (10 abstentions). The decision to amend article 54 BL will be included in the Collection of Decisions (which is available on the website).

Election of Internal Auditor

Ms. Brigitte Carion-Taravella (FR) was elected as a substitute internal auditor.

Reports of other Committees

1) The Chair of the Harmonisation Committee reported on a meeting between the B+Sub-Group, the Industry Trilateral and FICPI whose position on patent law harmonization can be found here: https://www.ficpi.org/_/uploads/gonzo/FICPI-WP-2018-001-Patent_Law_Harmonization.pdf.

2) The Chair of the Professional Education Committee (PEC) reported on a joint meeting with the EQE Examination Board and Supervisory Board, the purpose of the meeting was to discuss various issues including:

- assessment of the pre-examination
  - current pass rate = 70%
  - relevance of multiple choice format
- amendment of Rules 11 and 14 IPREE (technical qualification for EQE enrolment).

Council was also informed that:
(i) Guidelines had been set up for the **epi** Tutorials and Mock EQEs, aiming at regulating the relationship between the tutors and the candidates, mediated by the **epi**.

(ii) An agreement was reached with the EPO Academy to resume in 2019 the "Life of a patent" training including live seminars and online courses.

(iii) The development and implementation of the 3-year training programme for **epi** students is progressing and will notably include videos and access to an **epi** student forum.

(iv) it is proposed to organize weekend workshops for DII training (Legal Opinion) and for Papers A and B.

The future of the profession

A debate was organized at the end of the meeting to address questions such as if/how should our profession adapt to face challenges ahead of us (e.g. the impact of artificial intelligence on our daily work).

The debate was moderated by our past-immediate president, Tony Tangena (NL). Contributions were made (in that order) by Ms. Ann De Clercq (BE), Ms. Mihaela Theodorescu (RO), Mr. Luis-Alfonso Duran (ES), Mr. Paul Rosenich (LI), Mr. Claude Quintelier (BE), Mr. John Brown (GB), Ms. Ewa Malewska (PL), Ms. Marijke Hogenbirk (NL), Mr. Paolo Gerli (IT), Mr. Francesco Macchetta (IT), Mr. André Clerix (BE), Mr. Axel Casalonga (FR), Ms. Barbara Kunic Tesovic (SI), Mr. Peter Thomsen (CH) and Mr. Joao Pereira Da Cruz (PT).

All speakers agreed on the need, going forward, for a more diverse profession: in addition to obtaining IP rights skills should be developed in the field of economics (e.g. licensing, auditing, tech transfers, valuation). Concerns were also raised that the future may be grim for some countries: it was indeed pointed out that 17 out of the 28 countries of the European Union today file less than 2% of all EP patent applications.

Closing of meeting

Council thanked the Finnish delegation members with acclamation for their efforts in organising a very successful meeting. President Leyder then closed the meeting at 5:20 pm.

Speech of Mr Campinos (EPO President) to **epi** on the occasion of the 85th Council Meeting in Helsinki

A very warm hello to everyone at the **epi**. I'm sorry I can't be with you today, in person, for this council meeting.

But I wanted to take this opportunity to send you a brief message.

Firstly, to introduce myself to those who I haven't met so far.

And secondly, to underline the importance of cooperation between our organisations.

As you know, the EPO and the **epi** have a shared history - one which has existed since the very beginning of the modern European patent system, some forty years ago.

In this time we've worked together on many issues of mutual interest.

Through your presence on various EPO bodies – be it as an observer or active member – you've made many important contributions to the development of the patent system.

Particularly in areas such as training, legislation and the European qualifying examination.

Contributions from the **epi** have been – and always will be – much appreciated.

Because we understand that the **epi**'s extensive membership means you're able to draw on a vast network of professionals – A network that has remarkable insight and understanding of both our users and the issues they face.

So we will always hold your contributions in high esteem, knowing that you bring expert views to the table.

Those views and your input are going to become more and more important as we look to develop the patent system in a strong and sustainable way.

As we all know, there are a number of challenges that we all have to deal with.

Some of them are a result of the good work has been done so far.

A functioning patent system with high quality IP - such as we have – is generating further demand for patents, costs need to be kept down and we have to work in a timely manner.

António Campinos, EPO President

Some of the challenges are relatively new, such as the impact that Artificial Intelligence will have, or blockchain. We can already see that they're going to have a profound effect on all those involved in patents - whether it's the inventors themselves, those who represent them or the Offices responsible for granting patents.

Just as the EPO itself was founded on the principle of cooperation, that same principle will be essential for facing these challenges and turning them into opportunities.

And that underpins my main message today:

We want to work more closely with the **epi** to see how we can ensure the European patent system continues to function effectively and can continue to serve our users.

Patent applicants - those you represent - have put their faith in both our institutions to deliver the highest quality patents in an efficient way.

To do that, we simply have to work together.

And there is one particular element of that I would like to highlight now.

It's already become evident to me that the **epi** has already become an ambassador for the European Patent system and, to some extent, the EPO.

So I want to propose that we can support the **epi** in various initiatives, which would help you to further develop and fulfil this ambassadorial role.

And, in addition, we could also work on other topics which are also important to our users, such as quality expectations and the development of your profession.

Both myself and my colleagues at the EPO are very much looking forward to the next stage of our co-operation. And to hearing your ideas and opinions on the various issues, so we can work with each other more closely.

I'm very sorry that I can't be with you today in person to explore these ideas further.

But I hope to attend one of your Council meetings next year.

In the meantime I wish you a very constructive and successful meeting.

News from the **epi**

M. Nollen (BE), Chair of the Editorial Committee

In the past three months, **epi** has been very active to represent the profession before the EPO. As expressed in his speech to the **epi** Council (see page 9), the new President of the EPO, Mr Campinos, is keen on collaboration with the **epi** due to its valuable contributions and its vast network of professionals. At the same time, the EPO proposes initiatives so as, in the words of Mr. Campinos "*how we can ensure that the European patent system continues to function effectively and can continue to serve our users*". A short update on some highlights:

Cooperation on Quality Management Process

The European Patent Attorney profession has observed ongoing changes at the EPO over the past years with interest and concern. It is clear that a high quality level is very important for the entire patent system. This applies to both the EPO and the patent attorney profession. This is also the reason behind the strict examination for European Patent Attorneys (European Qualifying Examination), which **epi** has been supporting from the beginning.
The new President has expressed that the EPO wishes to start a further dialogue on the quality management process at the EPO with the European Patent Attorneys. He has invited **epi** thereto, as the standing representation of European Patent Attorneys before the EPO. **epi** has accepted this invitation and is engaged to work out projects together with the EPO.
For further information please contact **epi**'s Vice President Heike Vogelsang-Wenke.

The revision of the Rules of Procedure of the Boards of Appeal

On 29 October, the second (published) draft of the revised Rules of Procedures of the Boards of Appeal were published on the EPO's website (https://www.epo.org/law-practice/case-law-appeals/communications/2018/20181029.html). These revised Rules and the reasons therefore were presented and discussed at several occasions, among which is the EPO's User Consultation Conference of 5 December. As will be elaborated in more detail in the next issue of **epi** information, the second draft includes just as the first one, the three-stage convergence approach for admission of any new document, request or line of argument at the appeal stage. However, the second draft is clarified and specified on many points in comparison to the first one, taking into account the 140 responses to the user consultation of April this year. During the Conference, the views of the profession were expressed by **epi**-delegates Chris Mercer and Heike Vogelsang-Wenke as part of the panel discussion. Chris Mercer expressed the wish that the Boards cooperate with the parties to indicate that Oral Proceedings may be expected within a year and to find another date for Oral Proceedings when necessary. He also was against abridged decisions. Heike Vogelsang-Wenke argued that the 4-month period for response to an appeal should remain extensible in complex cases, particularly in case of multiple appellants. She further expressed that the strictness of admission should leave space for a proprietor to file requests 'late' so as to save the patent.

The new User Consultation on deferred Examination (deadline 11 January)

The EPO has launched a new User Consultation on deferred Examination. This subject is addressed in more detail in this issue in an article by Daniel Herrmann. The **epi** is aware that there are different views in the profession concerning deferred examination. Some parties consider it positive, as one does not need a granted patent long before the protected invention will be adopted. Other parties see the disadvantages, particularly of legal certainty.
The **epi** recommends all users to respond to the User Consultation. The Consultation includes 20 questions. Most of them are multiple choice questions with the option to give comments, examples and/or reasons for an answer.

The User Consultation can be found at https://www.epo.org/law-practice/consultation/ongoing.html, and the deadline is Friday 11 January 2019.

Next Board and Council Meetings

Board Meetings

103rd Board Meeting on 29 March 2019 in Munich (DE)

Council Meetings

86th Council Meeting on 11 May 2019 in Sofia (BG)
87th Council Meeting on 23 November 2019 in Lisbon (PT)

Do you want to be regular author for **epi** Information?

M. Nollen (BE), Chair of the Editorial Committee

The Editorial Committee is engaged that **epi** Information will be a journal that a skilled European Patent Attorney needs to keep up with the profession. The ambition is that each issue contains

- an overview of changes in the practice
- an overview of most relevant Case Law of the Boards of Appeal
- an overview of relevant courses and other training opportunities

The overviews should are to be summaries and to give guidance to fellow European Patent Attorneys, as to whether a change requires attention or is an opportunity for an improved practice. Each issue should have such overviews so as to enable that one can rely thereon.

Table 1 indicates the overviews that the Editorial Committee has in mind.
In order to achieve this, the Editorial Committee needs help from you: we need additional patent attorneys as regular authors, that provide such overview 4 times a year. But, as you may realize, this is also an opportunity for you: any regular author will be the expert providing overviews in the journal that is sent to all European Patent Attorneys.

What we have in mind for an overview:

- 1000-1500 words per contribution
- Covering important updates, providing a summary and guidance and referring with link where to find the text of the update

Chapter	Subject	Remarks
Agenda	Overview of epi, EPO and other conferences in next six months and introduction per conference, indicating target group, nr. of participants etc. Include also Inv of the Year Award etc	Contacts with EPO etc in advance to ensure that information is complete; Include table for overview
Agenda	Overview of trainings and deadlines (ie. EQE, litigation certificate, assistants etc	Probably in the form of a table Perhaps twice per year (?)
EPC/PCT practice updates	Update on new EPC rules and other changes at EPO (fees, ancillary regulations). Discuss relevance	Contacts with EPO to ensure that we do not miss a change and to verify that 'advice' is correct
EPC/PCT practice updates	Update on new PCT rules	Subdivide overview of entire guidelines over more than 1 issue
Case Law	Rules of Procedures	A regular one or two page overview on relevant decisions. Decisions can be selected by reviewing case law blogs etc
Case Law	Enlarged Board (G-decisions and Review decisions	Discussion on each G-referral and G-decision, review of relevant Review decisions
Case Law	Chemistry & Pharma	
Case Law	Computer related inventions	
Case Law	Mechanics	
Case Law & practice	Biotechnology	Due to the specifics of the field, it seems useful that a biotech attorney reports on Case Law and practice

- Meeting the high standards of our profession as to quality and relevance
- Addressing qualified European Patent Attorneys
- prepared by one author or a small team of authors

What we ask:

- commitment to be a regular author at least for one year, preferably for two years or more;
- willingness to provide the overview according to a format specified by the Editorial Committee
- sufficient background knowledge in the field, so as to give the guidance
- commitment to investigate independently (and/or with fellow authors) updates on a certain subject.

What we offer:

- publication in each issue of **epi** Information as regular author, with email address in a footnote
- opportunity to become a leading and well-known expert on the topic
- review of the contribution by the Editorial Committee

Interest to become a regular author on a specific subject can be expressed by email to: editorialcommittee@patentepi.com. Please provide also a short introduction of yourself. For further information, please contact Maarten Nollen, Arnold & Siedsma, Tel. 0032-2-7376290.

The path to UPC and the **epi** Code of Conduct
Report of the Professional Conduct Committee (PCC)

Giorgio Checcacci (IT), Chair

It is now about two years since the issue of the conduct provisions in respect of UPC was addressed in **epi** Information: in issue 3|2016, I presented the so called UPC Code of Conduct (https://www.unified-patent-court.org/sites/default/files/code_of_conduct_2016.06.pdf) that at that time had just been finalized and at the same time I announced that our **epi** conduct provisions (i.e the Regulation on Discipline or RoD, https://patentepi.com/assets/uploads/documents/institute/Regulation%20on%20discipline%20for%20professional%20representatives%20(2).pdf, and the Code of Conduct or CoC, https://patentepi.com/assets/uploads/documents/institute/Code%20of%20Conduct%20of%20the%20Institute%20of%20Professional%20Representatives%20..._.pdf) were also under revision, to clearly define their application to UPC-related activities. This revision process has been guided by PCC (Professional Conduct Committee), that received suggestions, comments and support by other **epi** bodies, such as the Disciplinary Committee, the By-Laws Committee, the Litigation Committee, the Board and the Council.

Well, this revision process has been probably more difficult and slower than expected, albeit after all not slower than the ratification process of UPC itself. However, a key step was recently marked at the last 85th **epi** Council meeting in Helsinki on 10 November: the Council approved the text of the proposal to amend the RoD and the text of an amended CoC. This means that eventually **epi** agreed on what amendments are needed to be UPC-ready in terms of conduct provisions; above all, **epi** agreed on the basic principle that **epi** members must continue to apply the same conduct provisions both when they act in respect of the EPO and when they act in respect of the UPC.

However, the vote of the Council is not the conclusion of the revision process: the amendments to the RoD will have to be brought before the Administrative Council of the EPOrg for adoption and only after that adoption **epi** Council will have the possibility to eventually adopt the revised CoC. Said like this, it might appear a straightforward process, however it is not, as obviously the Administrative Council might disagree on what we are proposing. **epi** will thus follow this process very carefully (through Professional Conduct Committee), in order to have full support from the EPO before going to the Administrative Council. All of this will certainly require at least a few months.

A question might then come up quite naturally: is all this effort useful? Yes, it is, for at least two main reasons.

The first reason is a quite obvious matter of fairness.

It seems simply unacceptable that our conduct is ruled by different principles whether we act before the UPC or before the EPO. Let me give just a couple of examples to show the issue.

A very serious misbehaviour during EPO-related activities could lead to sanctions up to deletion from the list of professional representatives (art. 4.1 RoD). UPC CoC does not provide for sanctions like this. The proposed amended **epi** RoD and CoC will allow to apply the same sanctions irrespective of whether the misbehaviour has

happened during either UPC-related or EPO-related activities.

Conflict situations are regulated (art. 3.2 RoD) for EPO-related activities, while UPC CoC does not consider conflicts. The proposed amended **epi** RoD and CoC will allow to rule conflicts in the same way.

The second reason is more political and relates to the reputation and prestige of our profession in general.

If we have our **epi** conduct provisions with the amended text just approved by the Council, **epi** representatives before the UPC will be the only category of UPC representatives having single, Europe-wide conduct provisions. This is something that lawyers cannot offer and is an ideal complement to the equal dignity principle defined in art. 48(2) UPC.

Achieving these two goals is certainly worth some efforts.

Report of the Online Communication Committee (OCC)

J. Gray (GB), Chair

OCC members continue to work on the topics summarised in **epi** Information 02/2018. On 2 October 2018, a strong contingent of OCC members attended the annual meeting with EPO customer support and IT personnel, chaired by John Bambridge. The potential of the meeting was hampered by the fact that none of the new systems which we had anticipated being in use or in trial by now have yet been launched (new online filing, XML filing, for example).

OCC observes that EPO systems, while established and stable, create increasing difficulty and risks for users in modern computing and business environments. Also, while EPO online filing systems have a good track record, we are very concerned that EPO and users should not be complacent:

- In recent months, the USPTO experienced an 8-day interruption in its online systems availability, which was mitigated only by extensive use of both facsimile and the legal provisions that allow filing date to be secured by a suitable deposit with the US Federal Postal Service.

- Facsimile is the only backup for several time-critical procedures at the EPO. Future EPO systems will be web-based, which reduces the burden on the user side, but may bring new risk of outages due, for example, to cyber attacks.

- The International Bureau at WIPO has identified hazards in the use of facsimile as a backup, particularly as telephony systems move to Internet protocol. (The transition of business users and telecom providers to VoIP or "voice over Internet Protocol" brings with it the need for FoIP – fax over Internet Protocol).

In other words, long-standing concerns about the usability and safety of existing systems are being joined by new concerns. OCC observes that investment and effort over recent years has been directed primarily to improving the systems internally and patent information systems. These are good developments, but they must be followed swiftly by investment in user systems.

Furthermore, the strategic review initiated by the incoming EPO President, Mr Campinos, presents a risk that long-awaited improvements will be dropped or further delayed. It also presents an opportunity for user to assert new priorities, where the EPO's current plans do not meet user needs.

The Strategic Plan is due to be presented to the Administrative Council in June 2019. On a proposal from OCC, **epi** Council at C85 Helsinki authorised the President to writes urgently to the President of the EPO, to make the following points (a draft letter including these points and explanatory detail is provided in the annex to this report):

1. Electronic notification from EPO to applicants (Mailbox, Myfiles, etc.)

- **epi** hopes that the Strategic Plan will promote rapid implementation of the vision which EPO has previously shared, as mentioned below.

2. Online Filing – New Online Filing System

- For some years now, a "new online filing" system has been under development but has been delayed several times. The Strategic Plan process should not be a cause of further delay.

3. Online Filing – Closure of "old" eOLF

- EPO has stated that the established eOLF system will be turned off two years after the EPO judges that all EP and PCT functionality and one national filing function is provided in the new system. However, closing eOLF without ensuring that a new system offers the same existing national functionality is considered unacceptable by **epi**. We urge EPO to find a more satisfactory arrangement for transition.

4. Rescue/emergency filing – fax filing and alternatives

- EPO does not yet offer adequate solutions as a backup to the normal online filing. The current safeguard is fax, but this is becoming inconvenient and unreliable due to the adoption of Internet telephony.
- New solutions are urgently required to avoid loss of rights in cases of urgency, and cases of local or general technical difficulty. Fax filing must be preserved until satisfactory alternatives are in place.
- Emergency filing solutions should not impose formal requirements. The obligation for patent offices to afford a filing date as a result of reasonable formal requirements, and the possibility for applicants to correct formal errors after filing, is a fundamental principle of the EPC.

5. Authentication and Access – Smart card limitations

- The dependence of EPO online systems on smart card infrastructure issue brings inconvenience to users and increasing risk of loss of rights. New (additional) means of authentication should be adopted without delay.

6. OOXML (.docx) filing

- **epi** supports the aims of this project, subject to the lessons learned from the first pilot stage. The Strategic Plan should promote its early conclusion.

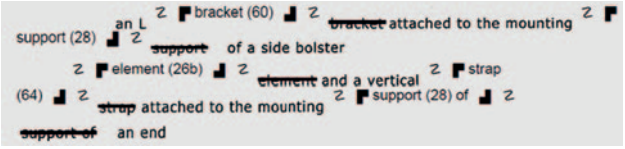
Videoconference for Oral Proceedings

In October, with assistance from the Secretariat, OCC conducted an online survey of members' experiences of using videoconference for oral proceedings. Over 500 members kindly participated, and the findings will be shared in a separate report.

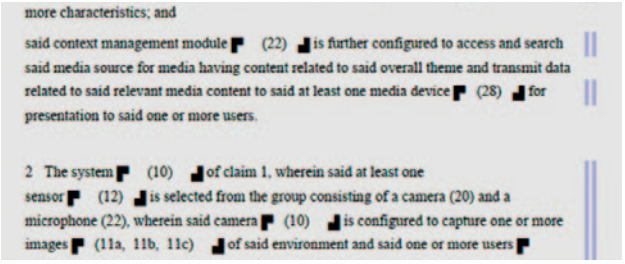
Electronic Druckexemplar (eDrex) issues – SACEPO-EPP

The new president of the EPO has acted quickly on one matter which was raised by his staff in his early consultations with them: simplification of the eDrex tool, by which examiners prepare the amended text for grant of a patent. I and two other OCC members were able to attend a quickly-convened extraordinary meeting of the SACEPO Working Group on the Electronic Patent Process (SACEPO-EPP). We hope this meeting has been very productive.

Copies of presentations are in the papers for Council C85 Helsinki. On practical issues, improvements in the manner of presenting amendments were shown, which aim to simplify the presentation of amended pages. We expect that members will be pleased at the change from this style:



to this:



which is already being implemented. I and other users also begged the EPO to ensure that the clean version of the text is included with the Rule 71(3) communication, and not only the marked-up version. Many users do not realise that there is a clean version available online when they are looking at the marked-up version. Other users complained that the clean version becomes available only a day after communication, disrupting their processing.

The meeting explored other practical issues. For example, it was highlighted that the EPO currently considers the marked-up version of the text as the authoritative text proposed for grant. On the other hand, when applicants submit amendments, the clean version is the authoritative text, and the marked-up version is for information only. The EPO will consider whether to adopt this alternative approach.

EPO Director Heli Pihljamaa presented the legal issues around **correction of errors in granted patents**. She emphasised that since G1/10, the EPO has lost almost all freedom to assist applicants to rectify errors that occur at the grant stage. As shown by recent appeal decisions, rights are being lost by applicants, either because there was no way to remedy an error, or because the wrong remedy was selected. Applicants must check closely all changes that are marked as changes in the margins and headers of the eDrex pages. If there is an error in these parts of the text proposed for grant, including complete missing pages, as well as minor slips, and it is not spotted by the applicant/representative, there may be no remedy, no matter how obvious the error.

Particular risks arise if the applicant requests amendments and waives the right to a further Rule 71(3) communication. EPO is working to eliminate errors in its processing, but asked SACEPO-EPP members how they can communicate to representatives the importance of checking, and the correct remedies in case of errors.

This matter is outside OCC's remit, and has been passed to EPPC for further monitoring/action.

Conducting Oral Proceedings in Examination by Video Conference – Current trends

Report from the Survey of the OCC, F. Stöckle (DE), member of OCC

In October 2018, the Online Communications Committee (OCC) of the **epi** conducted an online survey to gather user experience and opinions on this topic. We would like to thank the more than 500 participants that took part in the survey.

Summarizing the results of the survey, users in general experience very few technical issues with video conferencing. The adoption of a unified software solution that enables online document filing would be welcomed by many users. The following user comments are examples of the focus areas of the comments received:

"Video-conferenced Oral Proceedings are an extremely valuable tool, particularly in terms of value for the client. They are effective and reduce costs. I believe the present implementation can only be improved upon with the addition of filing functionality and greater availability."

"Requests to use video conferencing should be accepted as standard, unless there is a very good reason why it would be near-impossible to do so, due to the environmental impact caused by the representative having to travel to Munich, Berlin or The Hague to attend oral proceedings in person. Judging by the Environmental and Sustainability part of the EPO's Principles regarding Social Responsibility, it would appear that this concern of mine is aligned with the principles of the EPO."

"The criteria for refusing a videoconference at present do not seem to be applied uniformly. One gets the impression that some EDs refuse to hold a videoconference in nearly every case, while others never (or very rarely) refuse. Maybe the request for videoconference does not always need to be allowed, but refusal should be exceptional, and the reasoning should be detailed and convincing."

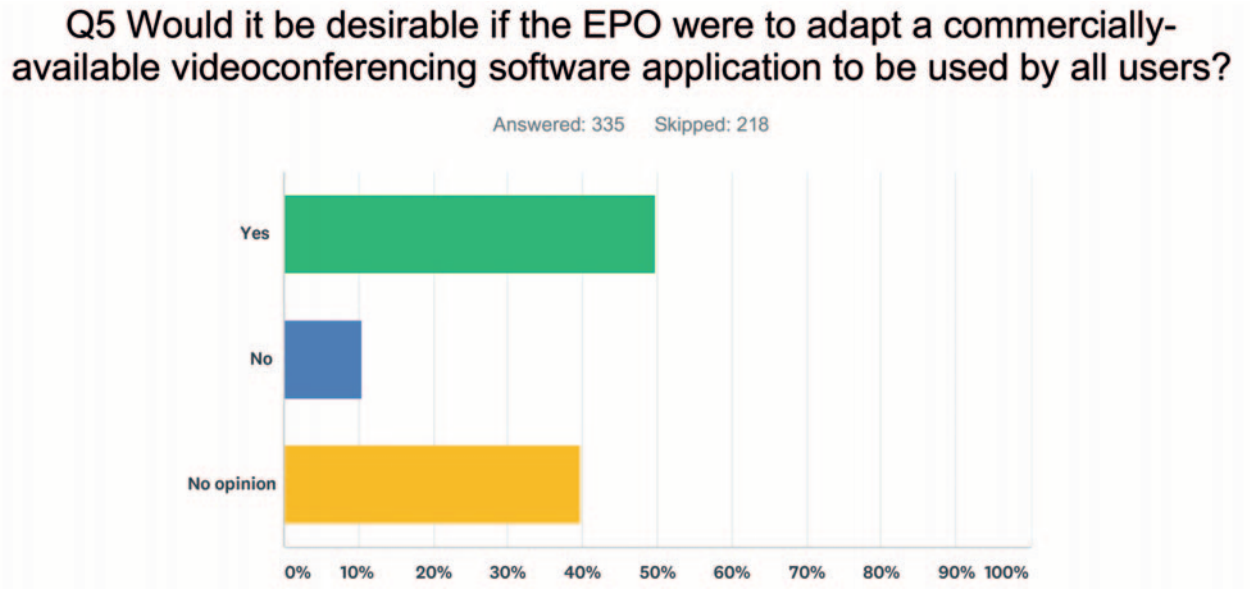
*"Whereas Examining Divisions in The Hague almost always accept requests for Oral Proceedings by videoconference, the Ex.Div. in Berlin are much more relucant to use vidcons. Instead, they frequently inform us that a decision whether the request for a vidcon can take place will only be allowed *after* they are in receipt of our submission one month prior to the oral proceedings. This, however, is really inconvenient in view of flight and travel accomodations."*

In a meeting of the OCC with a delegation of the EPO in October 2018, the EPO underlined that it supports video conferencing which avoids expensive travel costs to users. Examiners are encouraged to use this way of communication and the number of available video conferencing facilities have been increased in The Hague as well as in Munich.

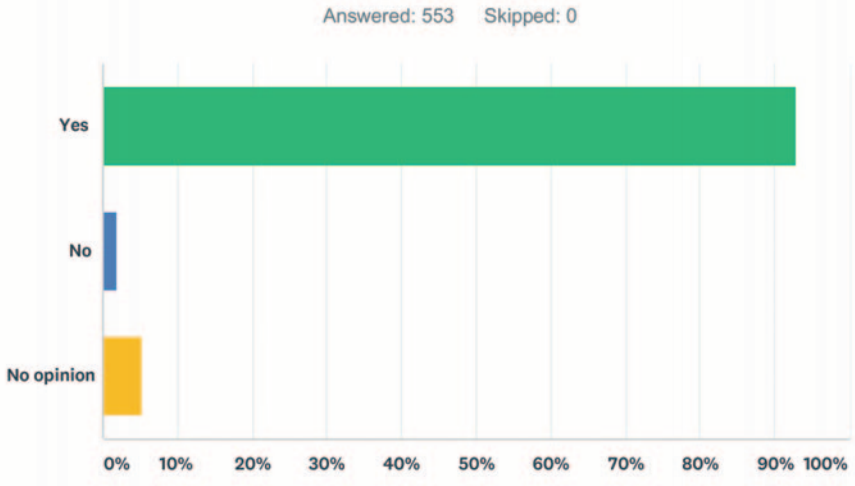
Furthermore the EPO is in the process of shifting to Voice over IP internally using Skype for Business. It is envisaged to extend the usage of Skype for Business to Oral Proceedings, which would e.g. allow each member of the Examining Division to participate in a common video conferencing room or from each of their work places separately, such that non-availability of video conferencing rooms should then no longer be an issue. The EPO also expressed that physical oral proceedings will of course always remain possible.

Results of the online survey and full statistics can be found on the epi website: https://patentepi.com/r/occ-survey

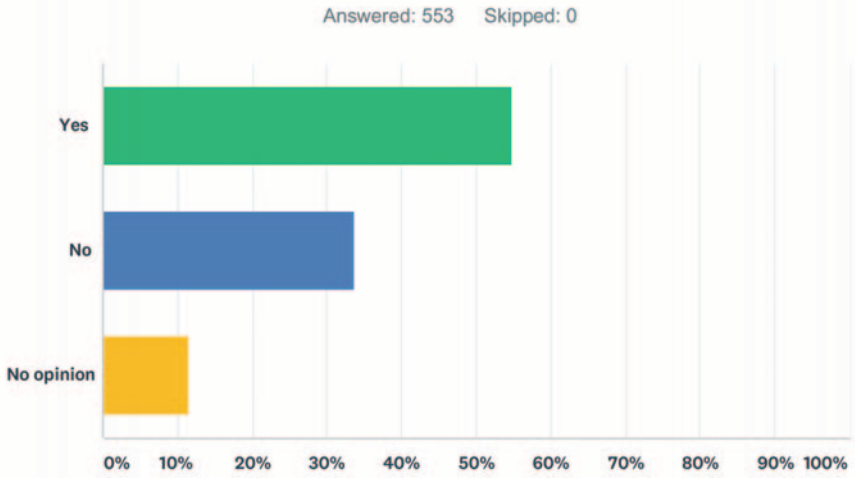
Excerpt from the statistics:



Q3 At present, amended patent documents can only filed by fax during Oral Proceedings held by videoconference. Would it be desirable to be able to file documents by email or online filing?



Q8 At present the Examining Division may refuse a request to hold oral proceedings by videoconference. Criteria for refusing are, for example, the unsuitability of the subject-matter of the application, the high complexity of the case, or the need to see or handle samples or models. The unavailability of video-conference rooms on the date set for the oral proceedings is also a reason for refusing the request. Should a request for a videoconference be always allowed?



Report of the By-Laws Committee (BLC)

P. Moutard (FR), Chair

1. BLC meetings and the topics discussed during these meetings

Since the C 83 Council meeting several BLC meetings took place, some of them being held through the new video system of the Secretariat. Depending on the topic discussed, other **epi** members were invited to the discussions: Mr Francis Leyder, President of the **epi**, Mr Peter Thomsen (Treasurer), Mrs Gabriele Leissler-Gerstl and Mr Claude Quintellier (both of the Nominations Committee), Mr Paolo Rambelli (PEC) etc.
The main following topics were discussed during these meetings:

- the incompatibilities between certain committees or bodies of the **epi**;
- amendments of following articles of the By-Laws: Art.1, 8.2, 15.4, 18, 20.1 and 54;
- a new proposal for amending Rule 154 EPC;

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

2. Incompatibilities between certain Committees or Bodies of the epi

It has been proposed to amend the Terms of Reference of some committees (By-Laws Committee, Professional Education Committee (PEC), Professional Conduct Committee (PCC), **epi**-Finances Committees, Student Admission Committee) in order to avoid conflicting situations, in particular in Disciplinary and EQE related issues, between some committees or bodies, but without stretching the notion of "conflict" too much (which would also result in too extreme situations).

Following proposals were made and approved by the **epi** Council (Malta, C 84):

- concerning the members of the **epi-**Finances Committee: they should not be at the same time members of the Board;
- concerning the members of the By-Laws Committee (BLC): they should not be members of the Board because one of the tasks of the BLC is to advise the Board.
- concerning the Professional Conduct Committee (PCC): its members should not be members of the Disciplinary Committee, of the Disciplinary Board, of the Disciplinary Board of Appeal nor of the **epi** Board, because the core activities of PEC consist in advising the Secretary General, the Board and the President on conduct and disciplinary issues and in formulating recommendations on conduct;
- concerning the Professional Education Committee (PEC): its members should not be members:

  * neither of the Disciplinary Board of Appeal (DBoA) nor of the Examination Board, because

  PEC may represent the **epi** President before the DBoA when Appeals against decisions of the Examination Board are heard (see also 3.2.1.1 of the Collection of Decisions);

  * of the Supervisory Board, which is advised by the Examination Board (EQE regulation, Art. 6(1)).

  Furthermore, it is recommended that a member of PEC, who would be member of an examination committee, does not represent the **epi** President before the DBoA (because the members of the examination committees receive instructions from the Examination Board (EQE regulation, Art. 6(2) and 24).

- Concerning the Student Admission Committee (SAC):

  * a member of the SAC cannot be a member of the Disciplinary Board of Appeal (because of appeals against decisions of the Examination Secretariat, before which anybody can apply for being an EQE candidate, in particular after being refused by the SAC):

  * the Chair of SAC should not be member of Supervisory Board of the EQE.

  These exclusions will apply only from the next Committee elections in 2020, although, as rightly mentioned by the President of the **epi**, Mr Francis Leyder, during the Council meeting in Warsaw (C83), this situation does not remove any existing conflict until 2020.

  In particular, members and deputy members of the Supervisory Board, of the Examination Board and of the Examination Committees are bound by a

duty of secrecy (EQE Regulation, art.23) which is quite extensive (« … ***during and after*** *their term of office with regards to* ***all matters*** *concerning the preparation of the examination papers, the candidates and any relevant deliberations* »). It can be very risky for any **epi** member to be a member of any of these bodies and to be involved in other activities, in connection with matters on which he/she is bound to secrecy.

3. Admendments of the By-Laws

A. Article 1 (Council elections):

In article 1, the reference to Article 134 EPC was replaced by a reference to Article 134a EPC, for consistency with the EPC2000 (Helsinki, C85).

B. Article 8.2 (Terms of office of Board Members):

According to this article, the terms of office of each Board Member ceases in case of a change of constituency or of electorate of the Board member.

Some years ago, Council amended Article 5.2 of the By-Laws so as to allow a Council member to remain a Council member when he/she changes constituency or electorate.

A similar amendment to article 8.4 was proposed and approved by the Council in Helsinki (C 85) for Board Members, so that a change of constituency or of electorate is no longer a reason for which the term of office of a Board Member ceases.

C. Article 15.4 (Duty of the Secretary General to produce a summary of the unapproved minutes after each Council meeting).

Art. 15.4 BL was amended (Malta, C84) in order to remove the obligation to prepare a summary document in 3 languages of the unapproved minutes. This summary is now prepared in only one language.

D. Article 18 (Constitution and organisation of Committees).

This article was amended further to the discussions and the decision taken in Warsaw (C 83).

The BLC has harmonized the 3 versions of this long article with each other. Further stylistic amendments were made (for example: reference to "*such other committee*" or to "*any such other committee*" in art. 18B.2-18B.8).

The text of the finally proposed art.18 BL was adopted by the Council in Malta (C84).

E. Article 20 (Internal Auditors).

Article 20.1 BL was amended (Malta, C84) to make clear that there can be other elections during the term of office of the Council members, for example in case an auditor resigns.

F. Article 54 (Election of committee members).

This topic was discussed further to the Board meeting B100, the Board having asked the By-Laws Committee to draft a proposal for the Helsinki Council meeting (C85) aiming at improving the election and nomination process for Committees; in particular, there should be deadline for nominations for Committees in advance of the Council meeting where new Committee members are elected.

Furthermore, in view of the problem of **epi** members who would like to be candidates but who are not supported by Council members, article 54 BL was amended (Helsinki, C 85) in order to explicitly allow any **epi** member to be a candidate for any committee election and to publish the information about possible vacancies on the **epi** website. The possibility for full Council members or for any person according to Art 38.1(2) BL to propose candidates is maintained.

Rules were also adopted by Council (Helsinki, C 85) in order to organise the nominations. These Rules will be part of the Collection of decisions of the **epi**. Briefly:

- According to § 1 of these Rules, the Secretariat informs all **epi** members about vacancies in committees through the **epi** website. Thus it will be easier for **epi** members to be informed about such vacancies and to be candidates;

- A formal process is defined for being a candidate, both in terms of deadlines (3 months before the election) and of nomination form (§§ 3 and 4 of the Rules). The deadlines do not apply to by-elections (§ 2 of the Rules) because a committee member must sometimes be replaced during his/her term of office on a short term basis; however, in such case, the information about the vacancy is published by the **epi** on the website (§ 1 of the Rules);

- Any candidate must fill out a nomination form, which includes a field for a short CV of the candidate and a field for explaining his/her motivations (§ 3 of the Rules); this applies to all candidates, even those proposed by full Council members or by any person according to Art 38.1(2) BL (§ 5 of the Rules).If a candidate files a nomination form within the deadline (§ 4 of the Rules), his/her nomination will be processed by the **epi** Secretariat;

- For committees for which there are fewer candidates than the number of electable members the nomination procedure will be reopened for a period of 14 days (§ 6 of the Rules), ending at the latest 1 month before the elections.

The Secretariat finally draws up the final list of candidates for elections not later than 2 weeks before the election (§ 7 of the Rules). This list can thus be included in the accumulated file just before the Council meeting.

4. New proposal for amending rule 154 EPC

The BLC has also worked on a new proposal to amend Rule 154 EPC, together with the Treasurer, since the former proposal was not fully accepted by the Committee on Patent Law of the EPO.

Report of the epi-Finances Committee

M. Maikowski (DE), Chair, T. Powell (UK) Secretary

The 81st Meeting of the Finances Committee took place in Munich on 15 October 2018. The Treasurer and Deputy Treasurer attended as invited guests, as did Mr Kley representing the Internal Auditors.

The Committee received reports from the Treasurer on the year-to-date income and expenditure positions. The Treasurer also presented the draft Budget. The Committee queried certain aspects of the draft, most notably the decision to allocate funds to an internal communications project to improve communication with **epi** Members. As a result of the Treasurer's responses the Committee approved the budget as presented.

Presently the Treasurer must operate within the agreed budget, and deviations from the budget require the approval of Council. This is inefficient when considering minor deviations. The Treasurer therefore would like to see amendment of the By-Laws to remove the requirement for the approval of Council of minor departures from, or adjustments to, the budget.

The Committee supports this idea, both in the interest of procedural efficiency and also because of the increased transparency that potentially would result.

At the Treasurer's request the Committee has established a working group to explore possibilities for automating the reimbursement of expenses of participants in **epi** committee, working group, Council and Board meetings.

By a previous decision, Council determined that the annual dinner for EQE tutors should take place in Munich. In order to encourage participation in pre-marking and marking meetings, that may take place in locations other than Munich, the Treasurer would like the freedom to organise the Tutors' Dinner at any suitable location. This will require a further decision of Council. The Committee supports the Treasurer's request for Council to make such a decision.

The Treasurer reported that all the Committees of **epi**, and the Secretariat, presently are operating within budget. The Committee congratulates the Treasurer on this achievement, and supports his continuing efforts in this regard.

The Committee reviewed the Treasurer's proposals to combine Council Decisions C77 and C73, relating to investment policies and non-Euro currency investment hedging. The Committee determined that changes to these Decisions are not necessary.

Council Members are reminded that the regime under Rule 154 EPC pertaining to deletion of Members who do not pay their annual subscriptions will change with effect from 1 January 2019. As a result, existing Members of **epi** who do not pay in a timely fashion will become the subject of deletion proceedings one month earlier than in the past.

The Committee discussed charging of credit card and PayPal fees for those paying their subscriptions via these routes. The Treasurer proposes treating these costs in the future in the same way as bank charges, and not invoicing them to Members. After discussion the Committee indicated support for this proposal.

Report of the Committee of Biotechnological Inventions (Biotech)

A. De Clercq (BE), Chair

Ann De Clercq

The Committee on Biotechnological Inventions met on 11 September 2018.

1.1. Patentability of antibodies

Ms Carine Crepin and Ms Brigitte Taravella gave a presentation after formation of a working group composed of different representatives from the pharmaceutical industry working in the field of therapeutic antibodies. Its' aim is to be better armed vis-à-vis the challenges faced with broad functional claims, and to build a partnership with the EPO in order to address the patentability requirements of antibodies. Several examples were shown on granted patents with broad claims such as "binding to an amino acid of an epitope", "compete for binding with a reference antibody" as well as broad use claims, all aimed at illustrating the current practice of the EPO, including problems resulting from inconsistent examination from one Examiner to another. The working group is aiming at partnering with the EPO to find a balance between too broad and too narrow claims, to understand and propose patentability requirements for the claims, to advance innovation and increase business certainty in this highly competitive field. A better predictability of the examination outcome and an increase in the quality of the examination will lead to strong and enforceable patents. A further point that was mentioned was the need to have greater transparency in the way these types of claims are examined, and ultimately to get access to the EPO Guidelines on patentability of antibodies as they are at the moment for internal use only. A discussion followed on the best way to find a balance between narrow and broad claims.

1.2. Patentability of plants and animals – amendments to EPC and GL

There was a report on a case by Syngenta Seeds Inc.: EP 12756468 – T1063/18-3.3.04 (New Pepper Plants And Fruits With Improved Nutritional Value) where the new EPO Rules and Guidelines would apply. The Applicant refused to insert disclaimers as required by current R. 28 EPC and the TBA summoned for oral proceedings. The oral proceedings are set forth for 5 December 2018. Several other applications in the plant field are following[1].

The Working Group for Guidelines in EPPC will meet end of September[2] to comment on proposed amendments, especially asking for further clarification on disclaimers in relation to R. 28 EPC with the EPO.

1.3. Guidelines

It was decided to set up, by means of the forum, a small ad hoc working group to review the EPO Guidelines for Examination. This working group shall liaise with EPPC.

2. 5 Nov 2018 EC Expert Group on Industrial Property Policy meeting - Brussels

On **5 November 2018**, Ann De Clercq (Chair Biotech) was invited to a Meeting at the EC in Brussels of the Expert Group on Industrial Property Policy in the presence of outside experts to discuss the application of the Biotech Directive in the field of plants. Different stakeholders were present at this meeting and Francis Leyder (President **epi**) also attended. The following topics were discussed:

- (1) Implementation of the Commission notice: Overview of the recent practices of the EPO and the Member States.
- (2) Patentability of plants obtained by New Breeding Techniques of native traits
- (3) Scope of protection of patents on native traits and products obtained by NBTs
- (4) Access to genetic resources/developments of new varieties/farmers privileges

The questions for the panel 2 discussion on "Patentability of plants obtained by new breeding techniques and of native traits" were formulated by the Rapporteur of the panel as follows:

1) Rule 28(2) EPC says: "Under Article 53(b), European patents shall not be granted in respect of plants or animals **exclusively obtained** by means of an essentially biological process." Assuming for a moment that this Rule is in conformity with what is said in Art. 53(b) EPC as interpreted by the Enlarged Board of Appeal, does this provision not guarantee adequately that only a very clearly defined category of plants obtained by specific processes are excluded from patentability?

1 T2734/18 (EP2825024) is a more recent other example

2 This has in meanwhile happened

2) One of the issues seems to be that in a growing number of circumstances it is impossible to distinguish and/or discern whether a plant has been obtained by an essentially biological process or a technical process. Do you think that the current legal framework tackles this issue sufficiently and why (not)? Please illustrate your views with examples.

3) Can patents obtained by technical processes be enforced against infringers under a scenario as per 2), and why (not)?

4) Do you have any suggestions as per 2) and/or 3)?

Ann De Clercq presented slides in the panel 2 discussion and defended a position which is in line with what is presented under point 5 below. It is not clear at this moment whether the EC will draft a report on this meeting or not.

3. 16 Nov 2018 User Life Science Groups – Liaison meeting at Boards of Appeal – Haar

On **16 November 2018**, Ann De Clercq (Chair Biotech) was invited to a "User Life Science Groups - Liaison Meeting with the Boards of Appeal of the EPO – 2018" by Mr Carl Josefsson, President of the Boards of Appeal of the EPO. CIPA Life Science Committee and the UNION Lifescience Group have also been invited to participate in this common meeting with all chairs of the boards dealing with "life science", i.e. 3.3.01 (chair: Albert Lindner), 3.3.04 (chair: Gabriele Alt) and 3.3.08. (chair: Beat Stolz). **epi** Biotech was represented at this meeting by Ann De Clercq (Chair Biotech), Chris Mercer (Chair EPPC) and Heike Vogelsang-Wenke (Vice-President).

4. 5 Dec 2018 User Consultation Conference on the Rules of Procedure of the Boards of Appeal - Munich

On **5 December 2018**, Ann De Clercq (Chair Biotech) will attend the User consultation conference on the Rules of Procedure of the Boards of Appeal.

5. Comments Biotech Committee on draft Guidelines for Examination on R. 28 (2) EPC

The Biotech Committee has also provided its comments to the draft Guidelines for Examination on Biotech matters. Amongst these comments there was a comment to the Rule 28(2) EPC disclaimer:

5.1. Comments on the "Rule 28(2) disclaimer"

The following comments refer to the proposed amendments to the Guidelines for Examination in the EPO compared to the previous version as of November 2017. Many changes in the proposed guidelines relate to the need to introduce a disclaimer when claims are directed to plants characterized by a technical feature that may be the result either from a technical intervention or from an essentially biological process (EBP). The need for such a disclaimer seems to originate from the change to Rule 28(2) which now reads as follows:

Rule 28 – Exceptions to Patentability
…
(2) Under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.

The comments below are generally with regard to the disclaimer issue.

5.1.1. The legal basis for a Rule 28(2) disclaimer should be clarified first

Discussions about the need of a disclaimer seem to have started on the change to new Rule 28(2).

However, it should be noted that the legality of that rule change is currently being challenged before the Technical Board of Appeal of the EPO in T1063/18 with requests to refer several questions to the Enlarged Board of Appeal (EBA). Third party observations addressing concerns with regard to the rule change were filed in that case[3]. It is therefore requested not to introduce changes in the guidelines during the pendency of T1063/18 and any potential referral to the EBA[4], or in the alternative to clarify in the guidelines that the requirement for removing subject matter pursuant to Rule 28 (2) – by disclaimer or otherwise - is contingent upon the applicability of Rule 28(2) as it currently exists.

3 These can be accessed at the EPO register under the documents with respect to European Patent Application EP 12756468. Observations by e.g. Prof. Kirchberg concluded that: The amendment/supplementation of Rule 28 …contradicts the primacy of the Convention over the Implementing Regulations (Art. 164 para. 2 EPC). It also infringes the legitimate expectations based on the existing legal and judicial practice as a generally accepted procedural principle in the EPC contracting states (Art. 125 EPC). This is because of the retrospective application of the amended Rules which has been ordered. Finally, it also unjustifiably intervenes with the proprietary right to the European patent under Art. 60 EPC guaranteed by Art. 1 of the Additional Protocol I of the ECHR.

4 Before the change to Rule 28 (2) was introduced complaints were raised that claims directed to plants being issued in the plant breeding area might lack clarity and would somehow affect the freedom to operate of breeders. It should be pointed out that rather than applying the Rule 28(2), another option would be to ensure that claims to plants carrying a novel characteristic could only be granted when the genetic basis for such characteristic is clearly and unambiguously and reproducibly described in the specification. This would allow breeders to unequivocally determine whether any material in their possession would be infringing any such claim.
Further, it would give legal certainty to all involved parties what is patentable subject matter or not. Any still remaining freedom to operate concerns could be addressed by other legal means such as by a breeder's exemption, or by the prior use exemption or by (to some extend already existing) facilitated licensing offerings. Raising the clarity requirements for plant based inventions is actually already an ongoing process as is shown by developing case law (T0967/10, T1988/12).

5.1.2. There is no absolute requirement for a disclaimer

Even if the current Rule 28 (2) remains applicable this does not necessarily "mandate" or "require" a disclaimer. The proposed guidelines use wording like "*a disclaimer is necessary to delimit the claimed subject matter…*" and "*A disclaimer is required in all cases and, in particular, even if the description only mentions a technical method of production and is silent on the use of an essentially biological process.*". In fact there does not seem to be a legal basis for doing so and the passages in the proposed guidelines that relate to the mandatory introduction of a disclaimer do not provide any legal authority by reference to standing case law of the EPO.

The EPC gives no basis for requiring introducing a disclaimer into any claim. To the contrary, it is standing case law of the Appeal Boards that the Applicant is solely responsible for wording of an application, including claims. Introducing the strict requirement of a disclaimer having no basis in the EPC in particular into claims of a specific technical field, drawn to a specific product by way of internal instructions is not in line with the provisions of the EPC[5]. Although nobody is legally bound by the Guidelines, the Examining and Opposition Divisions of the EPO are bound to comply with the Guidelines based on internal instructions. Examining and Opposition Divisions will therefore have no choice but to impose a disclaimer to applicants. The appeal boards of the EPO however are strictly and only bound by the EPC (Art 23 (3) EPC). Thus, introducing a disclaimer requirement for plants into the Guidelines will oblige Examination and Opposition Divisions bound to the Guidelines by EPO internal instructions to only propose that single unarguable solution, which applicants will have no choice but to appeal. Constantly having to appeal such decisions contradicts the principle of efficiency of proceedings and equity and good faith an applicant can rely on in a constitutional system.

In fact when looking at the notice on introduction of Rule 28 (2) (CA56/17 point 41) seems, when faced with claims including both natural and artificial mutant plants, to direct the practice in the opposite directions:

> *Some forms of mutagenesis occur in nature (usually called spontaneous mutagenesis). However, whether a specific mutation indeed would occur as the result of spontaneous mutagenesis is entirely speculative. Application of an exception to patentability cannot depend on hypothetical considerations and on whether specific process elements are traceable in the claimed product, in particular when taking into account the considerable developments in the technical field of plant Nbreeding in the past and the unpredictable nature of future developments. (emphasis added)*

Furthermore in notice CA56/17 there is an entire section about use of disclaimers but this only generally points to the case law of disclaimers. Nowhere is there any suggestion that any disclaimer should be mandatory. Even in the proposed guidelines Part H, the use of a disclaimer and its form is left completely at the discretion of the applicant.

5.1.3. There is no need for a disclaimer – other options are available

If at all, applicants should be able to remove any subject matter from the claims by other means. In factat least one example of permitted claim language in the proposed guidelines seems to make this possible without the need for a disclaimer.

> *A mutant of a plant carrying a heritable exchange in a nucleotide sequence effected by technical means, e.g. UV mutagenesis or CRISPR/Cas*

If Rule 28(2) remains applicable, it should be clarified that there are multiple ways in which the claims can comply with it and that the applicant is free to choose the wording of the claims.

In this case, other guidance with regard to acceptable claim language should be included. For instance, it is suggested - in the spirit of the above-cited example - to clarify that a claim reciting "a mutated gene" (rather than "a mutant gene") implies an active mutation step so that the requirements of Rule 28(2) are implicitly complied with. Other suggested alternative to comply with Rule 28 (2) could be "human created mutant gene", "manufactured" or "artificially induced mutant gene" or similar wording. In this respect, it may even be provided that the adjectives "mutated", "human created" or "artificially induced" would not necessarily have to find support in the specification to allow compliance with both R. 28(2) and Art. 123(2) EPC.

5.1.4. Introduction of "Rule 28(2) disclaimers" provides legal uncertainty

The proposed guidelines indicate that the disclaimer is required to exclude subject matter that is not patentable pursuant to Rule 28 (2) and seem to suggest that the disclaimer should be in the form of

> *" A plant … provided that the plant is not exclusively produced by means of an essentially biological process".*

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5 There is precedent for not requiring a disclaimer even though the claims may encompass embodiments excluded from patentability (G1/98). Indeed plant varieties are clearly not patentable under Art 53 (b) EPC but there is no requirement for applicants to disclaim plant varieties from claims directed to plants. In this regard it may be important to note that Art 53 (b) and Rule 28(2) in defining exceptions to patentability use similar wording :
"European patents shall not be granted in respect of…". Furthermore, in a comparable situation, the European Patent Office now routinely grants claims directed to (human) stem cells without requiring a disclaimer to exclude stem cells obtained by a method which involves destruction of a human embryo although such methods excluded from patentability under Art 53(a) and Rule 28(1) (see e.g. EP 2455452, EP 2548950 or EP 2611910).

In fact, in many applications applicants will have no choice but to use such wording because they have no support for other claim language that would effectively exclude subject matter that is not patentable pursuant to Rule 28 (2) and would run into restrictions with regard to the use of undisclosed disclaimers (as set forth in proposed guidelines Part H).

However it is submitted that a disclaimer in the form specified above is unclear and would introduce legal uncertainty both for applicants and third parties as it would be based on unclear terms (see below).

The term "essentially biological processes"

Rule 28(2) refers to processes by which the claimed plant product is obtained (i.e. essentially-biological processes). However the definition of essentially biological processes is not at all clear.

Rule 26(5) provides that :

> *A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.*[6]

This definition was taken over from the Biotech Patent Directive EC 98/44/EC and was necessarily the one used by the European commission in drafting their Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (the "Commission Notice"). Indeed, the Commission Notice took the view that "*the EU legislator's intention when adopting Directive 98/44/EC was to exclude from patentability products (plants animals and plant/animal parts) that are obtained by means of essentially biological processes*". In addition the Commission Notice links the technical character of the invention to reproducibility.
However the EPO, in G2/07 deviated from the principle of alignment with 98/44/EC in adopting a broader definition of an EBP and furthermore defines processes comprising steps of crossing and selection as non-technical, irrespective of their reproducibility and technical character. This definition is reflected in the Guidelines Part G 5.4 and is used also for purposes of Rule 28(2) :

> *"Thus the exclusion extends to plants and animals exclusively obtained by means of an essentially biological process where no direct technical intervention in the genome of the plants or animals takes place, as the relevant parental plants or animals are merely crossed and the desired offspring is selected for. This is the case even if technical means are provided serving to enable or assist the performance of the essentially biological steps. In contrast, plants or animals produced by a technical process which modifies the genetic characteristics of the plant or animal are patentable."*
>
> *"Determining whether a plant or animal is obtained by exclusively n biological means entails examining whether there is a change in a heritable characteristic of the claimed organism which is the result of a technical process exceeding mere crossing and selection, i.e. not merely serving to enable or assist the performance of the essentially biological process steps."*

Therefore it remains unclear what is actually disclaimed with a disclaimer in the form set forth above since the scope of the disclaimer will depend on the definition of EBP that is adopted. It will be up to the Boards of Appeal of the EPO and/or the National courts to determine which definition is appropriate in the context of Rule 28(2).
This fundamental question is also raised in T1063/18 where one of the questions requested for referral to the ELBA is:

> *"What is the applicable definition for an essentially biological process in the context of Rule 28(2) EPC?"*

Consequently, in line with the definition in the commission notice, the term essentially biological processes should be clarified first before any disclaimer requirement based on such term should be considered to be introduced.

The scope of removal of Rule 28(2) subject matter (by disclaimer or otherwise)

The Guidelines in Section F IV 4.24 provide that :

> *"Claims defining plants or animals produced by a method including a technical step which imparts of technical feature to a product constitute an exception in so far as the requirements of Art 53 (b) are concerned"*

This provision is not based on any precedent and is not binding on the Boards of Appeal of the EPO or on National Courts. It is however contrary to existing product-by-process EPO case law which consistently equates "obtained" as meaning "obtainable". It is therefore not certain how this would be decided in the end. Nevertheless, the outcome of such interpretation is especially important with regard to claims in the form "*a plant obtained by a technical process*" (which is a form of claim explicitly endorsed in the guidelines (see examples in Part G II 5.4.2.1) as well as to claims with a disclaimer which amount to "plants not obtained (exclusively) by an essentially biological process".

The term "exclusively obtained"

In principle offspring of a mutated plant that carry the mutation would be obtained by processes that involve

6 The Administrative Council when introducing the amendments to Rule 28 did not amend Rule 26(5), which consequently stays in place.

only crossing and selection and could be regarded as plants exclusively produced by EBP. Although the guidelines provide that

> *"When looking at the offspring of transgenic organisms or mutants, if the mutation or transgene is present in said offspring it is not produced exclusively by an essentially biological method and is thus patentable"*

it remains to be seen how the disclaimer would be interpreted with regard to offspring, especially in the case of potential infringers who have developed varieties based (unknowingly perhaps) on the basis of plants originally produced by a technical process. Such potential infringers may argue, that since "plants obtained exclusively by an essentially-biological process" have been disclaimed from the patent scope, offspring of the claimed plants, which are obtained only by crossing and selection, are part of the disclaimed subject-matter and are therefore not infringing the patent, even though such claimed plants and their offspring originate from a process having created or modified a trait in their genome. Although this may not have been the intent of the legislator having created Rule 28(2), the consequence may well be for patentees that their technically-obtained plant inventions become so easily copied that applicants may consider not to file such applications any more this solely because of having been forced to introduce a disclaimer.

5.1.5. The introduction of a disclaimer aggravates undesired consequences of Rule 28(2)

As discussed above in section 4) the use of the disclaimer in the form set forth there results in legal uncertainty. It is simply not clear what subject matter is covered by a claim that has such a disclaimer. This is true from the perspective of both patentee and for the potential infringer[7].
An undesired effect of the new Rule 28 (2) seems to be that it allows that use is made of the information provided by a published patent application disclosing a trait that is introduced into a plant by technical means, to "copy" the invention by using "essentially biological processes". Indeed, the fact that it was technically created means that it is likely to be genetically characterized at DNA level in the patent application. As soon as the application is published the disclosed genetic information can be used in combination with current technologies to screen large plant populations to identify plants with the similar genetic change (which would then have occurred naturally). Plants obtained in such way would however then not necessarily be covered by claims of the patent under Rule 28 (2). Apparently, this seems to create a loophole for potential infringers to benefit from the teaching of a patent application and create products that would be non-infringing[8].
From a patentee's position the generation of such product obtained by EBP using the technical information of a patent should be equivalent with having made such product by technical means and should therefore not fall under any disclaimed subject matter. Obviously the presence of a disclaimer in the form set forth above makes this problem even more visible.

5.1.6. Conclusions

The following comments should be taken into account when revising the proposed Guidelines:

- The introduction of the need to remove subject matter in accordance with Rule 28 (2) – by disclaimer or otherwise – should await resolution of cases such as T1063/18.
- There is no overall need to remove subject matter - by disclaimer or otherwise solely on the ground of Rule 28 (2). It is well accepted that claims can cover subject matter that is not patentable on its own (G1/98).
- The introduction of a disclaimer would introduce legal uncertainty for all involved parties. If Rule 28(2) remains applicable in its current form, guidance should rather be provided on various other ways of claim construction, including by way of examples.

6. Remaining matters

In view of items 4 and 5 above, the **epi** Biotech Committee is updating its overview of the patent ability of plants in the Members States based on input of its members.
Ann De Clercq has requested to become an associate member of the **epi** Guidelines sub-committee.
The Biotech Committee will also be involved in any other topics that come up for discussion related to Biotech or referred to it by EPPC or other channels.
The Biotech committee welcomes any **epi** member wishing to become an associate member who has a solid background in biotech and wishes to contribute to ongoing discussions in biotech patent matters. An email can be sent to the Chair of Biotech or the **epi** secretariat for applications.
The next meeting date of our committee is still to be scheduled in 2019. A meeting with the EPO Biotech Directors will also be scheduled for next year. The meeting with the Biotech EPO Directors may in the future be jointly organized with the meeting with the PAOC EPO Directors and EPPC.

7 In this respect it should not be forgotten that, since the guidelines are not binding on the boards of appeal of the EPO and on national courts, neither party will necessarily be able to rely on the guidelines for interpretation of a disclaimer.

8 In this regard – as discussed above – the discussion resulting in the new Rule 28(2) seemed to have been primarily arising from the concern of breeders that they may be prevented from using traits that are subject of patents but that they had independently developed prior to patent publication. However, if Rule 28(2) remained applicable in its current form, breeders could also independently develop patented traits after patent publication even making use of the teaching of the patent.

Continuing Professional Education (CPE)

In the first half of the 2019 the following seminars will take place:

Opposition and Appeal

5 February 2019	Vienna (AT)	**epi** roadshow supported by the EPO

Claim drafting course 2019

The claim drafting course aims at providing participants with a solid understanding of the theoretical basis on which the claim language is formulated as accompanied by practical examples in interactive sessions during which the participants discuss and interpret scopes of different claims, analyze different types of claims and the terminology thereof.

7 - 8 February 2019	Istanbul (TR)	**epi** course

Announcement on the EQE – Paper D

T. Reijns (NL)

Article 1(4) REE and Rule 26(1) IPREE specify that the purpose of Paper D is "*to assess candidates' ability to answer legal questions and to draft legal assessments*".

Over the last 4 years we have noticed a decline in the quality of candidates' answers to the legal questions in Paper D. The candidates appear to be less well prepared on the legal documentation in the syllabus. It also appears that candidates focus more on the preparation for the legal assessment part (part 2) of Paper D than the legal questions (part 1).

With the formal merger of the two parts of Paper D into a single exam some years ago, candidates have shifted their focus to the legal assessment and moved to answering the legal questions only in the time they have left after completing the legal assessment. This in itself is a way of time management that is allowed and could be a good strategy for some candidates.

What is not desired is when candidates do not prepare for the legal questions enough and focus only on the legal assessment. Fifteen years ago, more emphasis was given to the legal assessment by changing from a 50:50 point distribution to 40:60, because candidates at that time put most of their effort on answering the legal questions and gave little attention to the legal assessment. We have now reached the other extreme.

In order to be considered "fit for practice", candidates must know the law and be able to apply it. Only being able to do one of these, is not enough.

For this reason, the point distribution between the legal questions and the legal assessment will be floating with a variation between 60:40 to 40:60 from EQE 2020 onwards.

Since the purpose of the floating point distribution is to encourage candidates to prepare well for both parts of Paper D, the distribution will not be announced before the date of the exam. Of course, the point distribution will be clearly indicated on the exam papers.

Tutors' Report on the EQE 2018 Papers

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

Each year in September-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. The Tutors' Report appears each year in the last edition of **epi** Information.

This year's meeting was held in the Isar building of the EPO in Munich, on October 18. The participants list showed 85 registered participants (tutors, other EPO and **epi** members from the Academy, EQE secretariat and **epi** institute).

This Tutors' Report contains the following sections:

1. Pass rates EQE 2018
2. General remarks
3. Paper A
4. Paper B
5. Paper C
6. Paper D
7. Pre-Exam

On behalf of the tutors present in Munich, I would like to thank all the members of the Examination Board and Committees as well as the EQE department and Exam Secretariat 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 -in alphabetical order- Nico Cordes, Luis Ferreira, Andrew Hards, Jelle Hoekstra, Margaret Mackett, Harrie Marsman, and Sander van Rijnswou for finding time to prepare the individual paper summaries. The summaries for the common A and B papers were each made by two tutors, one with an e/m background and one with a chemistry background, such that the experiences from both technical backgrounds could be reflected in this report.

We all wish you good luck in 2019,
Roel van Woudenberg (editor)

1) Pass rates EQE 2018

In 2018, 689 candidates out of 935 (73,7%) passed the Pre-Exam, slightly lower than last year (76,0%) and 2015-2016 (76%). 528 out of 1696 candidates that took at least one paper passed the EQE (similar as last year).

For the individual main exam papers, paper A and B showed similar pass+compensable fail rates as last year; the pass+compensable fail rate for C is 4%-point higher; the pass+compensable fail rate for D is 8%-point lower than last year and the lowest since we have the 5-hour single-paper format.

The official results for each paper, as published on the EQE website and dated 2 July 2018, are as follows:

EQE 2018*	#Candidates	PASS	COMP.FAIL	FAIL
Pre-Exam (4h)	935	73,69%**	--	26,31%*
A (3½ h + 30 min)	992	51,61%	10,58%	37,80%
B (3h + 30 min)	804	72,76%	6,84%	20,40%
C (5h + 30 min)	1077	46,70%	11,51%	41,78%
D (5h + 30 min)	1123	32,86%	12,47%	54,67%

*note: as last year, the ABCD papers were designed according to Rule 23-27 IPREE as 3½h, 3h, 5h and 5h respectively, but all candidates were granted an additional thirty minutes per paper to these durations (by Decision of the Supervisory Board of 17 November 2016).

**note: the initial Pre-Exam results showed a pass rate of about 70% where two statements were neutralized (12.2 and 12.4; see Examiners' Report of 22 March 2018); the statistics on the EQE webpages seem to reflect the pass rate after interlocutory revision, where three more statements were neutralized for all candidates (4.4, 5.3, 13.1; see examiners' report of June 2018). It is not known whether some appeals have led to neutralizing answers for a specific candidate only; it is also not known whether there are still any pending appeals on other statements.

2) General remarks

On the evening before the meeting, all participants were invited to a networking dinner, hosted by the European Patent Institute, in a Bavarian restaurant at walking distance from the EPO.

The meeting opened with words of welcome and introductions by Nicolas Favre (Chair of the Examination Board), Paolo Rambelli (**epi**) and Giovanni Arca (Academy). Other presentations were given by Pete Pollard (European patent attorney: "Using DII to become "fit to practice" at the exam"), Yolanda Sánchez García (Product Marketing Manager, Patent Information, EPO: Patent Information essentials for patent attorneys), and Christoph Machwirth (Head of department, EQE Secretariat, EPO: Matters of general interest and statistics of the 2017 Examination).

Christoph Machwirth pointed all participants at the need for candidates to register at the beginning of professional activities, and not only when close to enrolment to the Pre-Exam.

Christoph Machwirth showed some facts about the Candidate Support Program, for candidates from (23) states that have only few EQE-qualified European patent attorneys. The limit of 10 was increased this year to max 20 candidates per country that can participate in the program. CSP is entering its 7th year. Since 2012, 154 students enrolled. 46 student from 16 countries have passed the EQE; 8 of the CS alumni are now coaches in the program. Courses are given by CEIPI (A, B) and DeltaPatents (Pre, C, D); coaching is done by **epi** coaches.

An open discussion followed on the longer-term future of Pre-Exam, in which various possibilities were discussed, including a possible reform of the Pre-Exam. As part of the discussion, the format of the Pre-Exam was discussed, and it was considered that in principle the format of the Pre-Exam may be changed if desired by all parties (EPO, **epi**, tutors, etc), for example to the form of a computer-based exam with online questions from a pool and debug questions (similar to the US); that could allow the candidates to receive the result immediately after exam and to choose a time slot to sit the Pre-Exam. However, various challenges were identified, such as how to create and maintain a question pool (e.g., past papers, accepting questions from external tutors/attorneys); should the pool be publicly available or not; should the Pre-Exam be fully open-book without annotations as now, or closed book or only clean EPC/PCT Art and Rules and Guidelines? No conclusion was reached, other than the expectancy that this will be an ongoing discussion for the near future for which also input is solicited from the various parties.

3) Paper A by Andrew Hards and Margaret Mackett

This year (2018) was the second year, in which the technical fields of chemistry and electricity/mechanics were combined to form the exam papers A and B. Generally, it takes the Examination Committee between 3 to 4 years of work to prepare each of the papers. Notably, both papers A and B 2018 entailed chemical and mechanical/physics elements.

As usual, the Examination Committee provided an excellent Examiners' Report and we urge candidates to study the comments therein. Unusually this year, the Examiners also prepared a revised report.

From the client's letter, the candidates should have been able to derive that the invention related to making protrusions directly on a glass pane using a laser, the protrusions being monolithic and having a convex shape.

The prior art describes both the use of lasers to form protrusions as used in Vacuum-Insulated-Glass (VIG) where the protrusions form a spacer which provides improved transparency.

The invention has two distinguishing features over the prior art, namely, the use of cooling air to form the convex protrusions with respect to D1 and the improved transparency due to the protrusions being monolithic with respect to D2.

Candidates do not always write the description correctly as there is no need to apply the problem-solution approach in the same way, as one would do when responding to an official communication in Paper B.

There was no 'double penalisation' for the same mistake made in more than one of the claims. However, if the claims were not novel, no marks were awarded. In addition, if candidates had multiple independent claims in the same category, marks were awarded for the worst of these claims.

For the description, there is no need for a complete description text as this would be a repetition of the client's letter. Instead, candidates needed to indicate the field of the invention, discuss the prior art, discuss the problem(s) to be solved and state how each of the independent claims addresses or solves the problem(s). The dependent claims also need not be discussed in the description. This should be the same for future papers.

A question was asked about whether candidates would be penalised for not using the two-part form for the independent claims. The same marks were awarded irrespective of whether the two-part form was used or not. The only effect of not using the two-part form appears to have been with respect to the description, as more detail needs to be provided relating to the prior art. (Use of the two-part form effectively reduces the discussion of the prior art in the description.). Only one or two marks were deducted for an incorrect two-part form claim.

Finally, it is to be noted that the final marks and deductions are decided at the Examiners' pre-marking meeting which is held after each marker has marked 10 papers (In total there are around 600 marked papers). Trends in the answers by the candidates are, therefore, taken into account in the final marking scheme.

4) Paper B by Luis Ferreira and Harrie Marsman

In a joint session with the discussion on Paper A, the Committee was represented by Jens Sebastian (coordinator for Paper B), David Cousins (drafter Paper B), Wim van der Poel (chair and coordinator for Paper A), Elisabeth Schober (drafter Paper A). The B paper presentation was authored by David Cousins and Tom Vermeulen

.

For Paper B the passing rate was quite high with 73%; duration of the Exam: 3.5 hours

David gave a general presentation on the intention and issues with the Paper. The discussion focused on points which were already present in the Examiner's Report, but with particular emphasis on specific points.

The Paper was directed to a fuse for protecting the components of an electronic circuit from damage by too high electrical currents. The fuse comprises a fuse track of an aluminium-copper (AlCu) alloy. In a preferred embodiment, it is covered by a cover layer. The AlCu material makes that when the fuse track melts and ruptures it will not easily reform. The preferred embodiment further reduce the chances of reforming by melting and filling up the space between the broken fuse track parts. This was emphasised by a discussion on the problem of metal reflow into the gap and how current flowing again is dangerous for electronic components.

The prior art consisted of 3 documents. In the Communication of the Examining Division, novelty objections, inventive step objections and clarity objections were raised. The client proposed to limit the independent fuse claim to fuses having a quality score of at least 60 to argue novelty and inventive step. In addition, the client makes proposals to overcome the clarity objections.

In the working examples of the application, there are two tables, Table 1 and Table 2, which give data for embodiments that have a cover layer of epoxy resin (Table 2) and that do not (Table 1). Table 2 shows that when the percentage Cu in the AlCu alloy is 10, 15 and 20%, the quality score is higher than 60. When the Cu percentage is 5% and 25%, the quality score is also higher than prior art fuses. The client gives reasons why a percentage of 5% Cu and of 25% Cu are not preferred.

There were clarity issues and intermediate generalization issues with the client's claims. Because the quality score feature in client's claim 1 is determined by a not further specified own method of the client, this parameter is not suitable to be used as a functional claim limitation; it is a so-called unusual parameter.

In claim 1, candidates were expected to limit the AlCu alloy to those having 10-20% Cu. If you limited to a range of 5-25% Cu, you lost 3 marks. To avoid an unallowable intermediate generalisation, the cover layer needed to be an epoxy resin cover layer. Such a claim was novel over the prior art. The example amendments to claim 1 were explained focusing on how the amendment could be initially motivated by obtaining novelty over D1 and to satisfy Art. 123(2). For the dependent claims, it was simply highlighted how the amendments were, for the most part, a consequence of the amendment to claim 1.

For inventive step, one was expected to start from D1. The motivation for this selection is essentially based on D1 having the most features in common with the amended claim 1. You had to argue that there are more differences in D2 and especially D3, which has the same subjective problem as D1 and the patent application. A remark was that D3 could be closer, because it would come closer to the subjective problem in the patent application. The committee answered along the lines that D1 was seen as the more promising springboard. It, however, also noted that marks were given for good arguments starting from D3 as closest prior art. The Objective Technical Problem (OTP) was heavily stressed: "further reducing ..." and the unnecessary limitations received particular attention: AlCu alloy having 15% by weight Cu or the fuse track having a neck portion.

To overcome a clarity objection in a claim using the terms "the upper layer" not having antecedent basis, this term could be replaced by "the cover layer".

To overcome a clarity objection in respect of the relative term "smooth", candidates were expected to introduce an upper limit for the "well-known" standard reflow index. The marking also received special attention. Again it was stressed how the penalisation for failing an exam item, does not spill-over to other items. For example, while adding the desired features to claim 1 provided a maximum of 20 marks and adding unnecessary limitations or non-compliances with the EPC could deduct 5 to 10 marks, the overall marks per claim cannot be negative.

Inventive step, as expected, attracted a large number of marks – 36 marks.

It was again strongly stressed how marks are not available (and thus a waste of exam time) for writing a letter to the applicant, writing a letter to the examiner, providing additional dependent claims, making amendments against the wishes of the client, requesting oral proceedings, or making any other kind of submissions like introductions, comments, etc.

We understand that a broader background of candidates is advantageous for the 'mixed' papers, but EM candidates should be able to process a table to obtain numerical results relevant for inventive step and Chem candidates should be able to recognise an unallowable intermediate generalisation when splitting features that were only disclosed in some combination.

It was also felt that the methodologies for extracting information from the exam documents are, at their core, the same as for the old 'mixed' papers, but an increased critical eye is required as the papers seem to have more condensed information. For example, cutting and paste based on the suggested claim set does not seem to be useful, and cutting and paste based on the originally filed claims does not give focus to the client wishes or the full inventive step argumentation being required. Of course, methodologies are based in the past experiences, not future experiences, so candidates are best to be systematic, but also be flexible.

It was highly recommended that candidates review the Examiners' Report. This can only be stressed by us tutors, given the extension and detail provided – 'decoding' the exam is indeed possible by giving directed attention to the Examiners' Report and this should be a very important part of the exam preparation.

In summary, with the correct set of claims, it was rather straight-forward to motivate support in the application as filed, obtaining clarity, novelty and inventive step.

It was felt that this paper was not too difficult, which is also reflected by the rather high passing rate.

5) Paper C - by Sander van Rijnswou

The tutor meeting discussed the suggested solution in the Examiner's Report and questions were answered.

General
During testing of the paper, the paper was modified to help candidates unfamiliar with the subject matter. For example, a definition of soaking was added to the paper. It was not present in a first draft. Disclosure was also added in case candidates did not know what teats and udders are.

Any time a candidate finds useful information in the description he should refer to A1 to reinforce his argumentation. For example, section [0018] of annex 1 describes what marking is. This section must be used to evaluate if the prior art discloses marking or not.

It was noted by the audience that the paper was longer than past year, but that the pass rate was the same. It was explained that the paper is extensively tested. Moreover, the paper was made before the half hour of additional time was added. Also, claim 6 was an easy attack if the priority issue was spotted.

The examination report is to train future generations. It is to show what the straightforward way to attack the paper is. But each paper and solution is marked individually. Every statement is taken in to account. The marking scheme tries to consider all alternatives.

Opposition form
It was pointed out from the audience that the Notice of opposition form that was supplied to the candidates is not the current version of the form. The current form does not have boxes to indicate the type of payment. It was explained that Paper C is prepared long in advance of the EQE, which is probably why the old form was included in the Exam. In any case, there is no obligation to use the form, the only requirement is make the opposition admissible.

Apart from that, it was noted that many candidates filed the opposition notice in the name of the signer, not of the company.

Effective dates and evidence
For claim 5, one should remark that the priority of the first variant is valid and that it has no extension of subject matter.

A6 has the same applicant and discloses all of claim 6, so it is a first application issue. Many candidates noticed that A6 did not enter the EP regional phase. Marks were available for stating that A6 was not a 54(3) document.

Claim 1: A novelty attack based on A2 was expected.
The suitable-for in the claim needs to be argued. Where are cleaning and soaking detailed? Annex 2 observes that it is for inside use, but also that it could be used for outside use. So, A2 satisfies the suitable-for of claim 1.
If claim 1 was attacked with inventive step, then the corresponding marks are awarded for the dependent claim.

Claim 2: An inventive step attack based on A4 + A2 was expected. A3 cannot be the closest prior art since it uses a single motor and rails.
For the inventive step, it is important to argue why a skilled person can combine them. In this case, the brush of A2 is suitable with A4 since both are controlled by a computer

Claim 3: An inventive step attack with A2 as closest prior art was expected. A2 is the only device with a specific amount of water to use for cleaning. A3 is not the closest prior art since it has fewer features in common with claim 3. Moreover, the cameras of A3, [0010] are not suitable for use outside a milking robot.
There are various reasons why A4 is not the closest prior art. A4 does not need to remove dirt with liquid, since dirt is removed before measuring temperature by ultrasound. In A2 we have brushes that cooperate. So starting from A4 we have features with effects that are synergetic so inventive step attack would be weak. Starting from A4 would increase reservoir times two and times the number of cows. So the reservoir would become too large. Some tried to use A3 to argue for a larger reservoir, but A3 is not applicable. A3 is indoor and uses rails. Also, A3 is not an autonomous device

Claim 4: A novelty attack based on A5 was expected.
It needed to be argued why A5 has all the features in the correct order. If the claim was attacked with inventive step, then marks were awarded under the dependent claim.

Claim 5: An inventive step attack to the first alternative in the claim was expected as well as an added subject matter attack to the second alternative.
The Exam commission could not comment how the 22 available marks were distributed between the added subject matter attack and the inventive step attack that were expected for claim 5.
Clearly both alternatives must be attacked. It is complex to give a division of the marks since there are several alternative ways in which a candidate can answer. For example, some identify the two parts, but attack only one. Some attack the claim as a whole, but really attack only one part. There are many alternatives. Full marks are given if it is identified that there are two parts and that both parts are attacked. But the other alternatives are a bit blurred. The only certainty is what is needed for full marks. If something is different, then it is specific for that candidate.

Alternatives in a claim are often not clear to many candidates. Candidates do not know the approach for or-claims. That is why we have a pool of marks for the claim. We need a flexible approach.
Some marks were available for recognizing the two alternatives in the claim.

Claim 5 (1st alterative): An inventive step attack based on A3+A2 + A4 was expected.
A3 is the closest prior art, since it discloses a method of cleaning and requires few modifications. A5 cannot be the closest prior art since the only fluid disclosed in A5 is the river. So starting from A5 would require one to provide a river through the nozzle. This is unlikely.
A4 cannot be the closest prior art because it treats only sick cows, that can't be milked. Disinfectant is not suitable for milking

Claim 5 (2nd alternative): An added subject matter attack was expected. In particular, it needed to be argued why the basis of [0021] or of [0022]+[0023] is not sufficient.

Claim 6: The challenge was to analyze the priority. Features were disclosed in an immediate manner.

6) Paper D by Jelle Hoekstra and Roel van Woudenberg

Representing Examination Committee III: Tiem Reijns (chairman), Constantijn van Lookeren, Olivier Kern

DI-part: summary of the paper
The DI part, of 40 marks, consisted of 5 questions addressing a variety of EPC and PCT topics. In the first, 10-mark question, missing parts under PCT in combination with a client's wish for fast provisional protection in EPC states was tested (incorporate missing part from pri, early publ, national requirements: claims translations). The second, 8-mark question required intervention using new grounds of opposition and required G 4/91, G 1/94 as well as G 3/14. The third, 8-mark question, was directed to signatures/representation requirements when and after filing an EP application in Spanish by/for an applicant from Argentina. The fourth, 6-mark question addressed the (im)possibilities to remedy the missed time limit to file appeal in opposition; two situations had to be discussed: where you were the representative for the patent proprietor (re-establishment), and where you were the representative for the opponent (no possibility). In the fifth and last, 8-mark question, it was to be discussed how the subject-matter for which protection was sought could be restricted, without and with paying fees to the EPO, after the applicant became aware of new prior art, novelty-destroying for claim 1, only after the R.71(3) acts were performed.

The answers to the questions are given in the Examiners' Report. It also indicated that "Candidates are reminded that they should pay attention to the way the questions are asked", "Answering more than prompted by the question merely causes loss of time but is not awarded any marks", "Full marks were only awarded when the full legal basis was cited to support the analysis. However, alternative relevant legal bases also attracted marks.", "An unexpected amount of points was lost due to miscalculation of time limits." and "It has become a trend that candidates skip entire questions from D1. However, these candidates typically do not pass." Most of these points were also emphasized at the meeting (see below).

DII-part: summary of the paper
The DII-part related to methods of preparing a fried food product (FFP), in particular "Oliebollen" (balls of dough), and apparatuses for forming the balls of dough. The methods used different fruits and/or different temperature ranges. The apparatuses includes nozzles of various shapes for shaping the balls of dough.

The DII-part started with an appeal in opposition. EP-BB1 addresses a concern that all fried products have high levels of acrylamide, a substance some studies have indicated is carcinogenic in high doses. EP-BB1 had claims directed to a method of preparing a fried food product (FFP) with an acrylamide level below 225 ppb, by frying a ball of dough containing at least 5 % by weight of dried fruit, wherein the fruit comprises fruit A. Dependent claims required the fruit to comprise fruit B and/or C. The patent was maintained in amended form on basis of granted claim 2 after the opponent showed that the method according to the patent using only fruits A as dried fruit did not result in a product having the claimed acrylamide level. The opponent appealed and included the results of tests in his grounds in which a method according to the patent using only fruits A and B as dried fruit also did not result in a product

having the claimed acrylamide level. The proprietor appealed with the grounds of appeal in the form of a letter that merely refers the Board of Appeal to our submissions made at first instance – the appeal was thus, inadmissible, and the proprietor was consequently only a party-as-of-right in the appeal.

The client also filed EP-BB2 describing and claiming a method of preparing a fried food product (FFP) by frying a ball of dough at a temperature in the range of 150-220°C. The description states that the preferred range is between 175°C and 200°C. The claimed range was novelty-destroyed by EURO-PCT-FK1, in particular by the lower endpoint of the range 155°C to 250°C described in PCT-FK1 (see below). The claimed range could be amended using the preferred range endpoints to, most optimally, 175-220°C (or, less optimally, 175-200°C).

EP-BB2 also discloses an apparatus including a dough mixer and a trumpet-shaped nozzle mounted thereon for forming the balls of dough. A PCT-BB2 was filed an -invalid- priority claim to EP-BB2. EP-BB3 was filed with a trumpet-shaped nozzle. The client intended to file a new PCT-BB3 claiming priority from EP-BB3. A careful priority (same invention, first application) and novelty assessment was expected.

A research institute offered the earlier, EURO-PCT-FK1 application to our client which claims an apparatus comprising a dough mixer having a nozzle arranged to deposit balls of dough into a bath of frying, with the description showing (only) a conically-shaped nozzle. Its second claim is directed to a method of preparing a fried food product (FFP) containing fruit D by frying dough at between 155°C and 250°C. The chosen fruit and the temperature range in combination make the products crispy on the outside and fluffy on the inside for longer.

The client wanted to use fruits A, C and D in the mix of dried fruit and any temperature between 160°C and 210°C, as that leads to their latest variety of tasty "Oliebollen" that recently won a competition.

Answering required understanding of admissibility of appeal, prohibition of reformation in peuis, novelty of ranges, novelty of sub-ranges (narrow, far from examples, purposive selection; GL (2016) G-VI, 8), amending ranges, priority and first application, protection conferred.

A possible solution to the DII is given in the Examiners' Report.

Comments from Committee

The D paper is a single paper with a DI part (legal questions – to test legal knowledge) and a DII part (legal assessment – to test ability to implement the knowledge), as described in Rule 26 IPREE.

The pass rate for paper D in 2018 was lower than normal (33% pass, 12% compensable fail). The committee has looked into the matter and comes to the conclusion that the paper does not seem more difficult than in previous years, and that the lower pass rate is puzzling. Some of the questions submitted by the tutors however indicated that some tutors considered the DII part more difficult than earlier 5-hour papers, especially in view of the topics tested and in view of its different style (not starting with a patentability investigation but with a complex legal assessment of an opposition appeal case). The committee observes that more candidates start with DII and quite some seem to run out of time for DI. This strategy may not be wise for candidates who are weak in DI. The committee has the feeling that candidates spend less time in preparing for DI than in the past. The underlying idea of paper D is that candidates should have sufficient knowledge of the theory (primarily DI part) and be able to apply this (primarily DII part). Since DII is based on applying the theory and also can have some more theoretical issues, a drop in knowledge of the theory also affects DII negatively. During the discussions some speculation took place whether the drop in theoretical knowledge might be a consequence of the Pre-Exam. Candidates have already spent time on studying the theory for the Pre-Exam. They may (mistakenly) think that they are already at the level for the DI part or find it difficult to study the same material again.

The D committee wants to stimulate candidates to raise their knowledge of the theory. The committee does not expect big changes for the 2019 D exam compared to the papers of the last years. As before, the D paper will be a 5 hour + 30 minutes paper. The committee indicated that it can be expected that D 2019 will have, as before, about 40% of the marks for the DI part and 60% for the DII part. However, no specific ratio is indicated in Rule 26 IPREE and both parts are equally important. The D committee indicated that after 2019, there will still be ONE Paper D, but the ratio between DI and DII may vary: "any reasonable variation (e.g., between 40:60 – 60:40) should be expected". Shifting the marks is expected to take place gradually.

Legal basis in the DI part

Full marks for the legal basis can be obtained by citing the relevant part of the syllabus given in Rule 22(1) IPREE (as amended per 29/7/2017 by OJ 2017, A88). Marks may also be awarded if not the most optimal legal basis is given.

In general it is not required to cite the full legal tree. Legal basis should be provided for every aspect of the answer. If all these aspects are given in a rule, it is not required to additionally cite the article which gives the basis for the rule.

For the EPO Guidelines the version valid at October 31st should be cited. Marks were also be awarded for citations from the version valid from November 1st if the version is indicated.

Questions in the DII part
The questions are intended to guide the candidates efficiently through the paper. However, it is the task of the candidate to provide a legal opinion for a complex industrial-property law case. Some 'holes' left by the guiding questions may need to be filled by the candidates; they still have to think for themselves. For any useful comment given by a candidate, marks are awarded irrespective of for which question the comment is made.

Some suggestions for candidates

- Avoid wasting time. Mere copying of the question of facts given in the paper attracts no marks. Focus on the question and do not answer more than required. Read the question properly.
- Do not speculate based on own ideas.
- Ensure to score the easy marks, e.g. for discussing priority mention that the priority application is the first application, show the calculation of the time limits (time limits are often miscalculated), in DII mention the effect for discussing inventive step.

7) Pre-Exam by Nico Cordes and Roel van Woudenberg

EC IV representatives: Julia Mills (**epi**), Stefan Götsch (EPO), Stefan Kastel (**epi**)

General remarks (Stefan Kastel)
The 2018 pass-rate was stated by the Committee to be 80%.

The Committee reiterated that the Pre-Exam is aimed at basic knowledge. To illustrate this point, the Pre-Exam should be answerable by Committee members in a closed-book setting in two hours (rather than the four hours given to candidates). Statements are only considered for inclusion in the final exam if 80% of Committee members provides the correct answer.

Nevertheless, the Committee recognizes that, despite the elaborate testing of statements, some statements are considered as ambiguous by candidates. Feedback, e.g., by tutors, is appreciated, as the Committee continues to strive to avoid ambiguities in the statements.

There is no recommendation from the Committee on how a candidate should distribute his/her time between the legal and claims-analysis part. However, the Pre-Exam is designed and tested to be 'doable' as a whole within the available four hours.

Some candidates appear to use personal answer sheets or write answers on the exam paper itself, and only transcribe their answers on the official answer sheet in the last minutes.

- Candidates often fail to do so on time, or make mistakes in filling in the answer sheet.
- In view of this, the Committee recommends against using personal answer sheets.
- Nevertheless, in consideration of this problem, the end of the paper will be announced 10 minutes before the closing signal (previously 5 minutes before) to give candidates more time to fill in the answer sheet. This only applies to the Pre-Exam, not to the Main Exam.

The Committee considers the effect of the Pre-Exam on the preparation of the candidates for the Main Exam difficult to assess, as this would require two groups (double blind testing). However, the Committee is open to feedback, e.g., on improvements or perhaps reform.

Legal part (Stefan Götsch)
This year's Pre-Exam had legal questions directed to allowability of amendments (Q.1), missing drawings (Q.2, EPC), opposition/ priority / fresh grounds (Q.3), R.71(3) communication with amendments by the examining division / late third party observations (Q.4), EP entry just before the 31m time limit, i.e., early entry (Q.5), translation for entry / representation on entry (Q.6), infringement/ rights conferred / national renewals (Q.7), R.161/162 requirements after entry / amended R.164 (Q.8), appeal / pendency / interlocutory revision (Q.9), and oral proceedings/ written submissions (Q.10).

Questions 1, 2, 4-8 and 10 were generally well answered.

Question 3 showed that some candidates had difficulties in determining the ground for opposition.

Question 7 contained two general statements of which the answer was not in the Syllabus per se (statements 7.2 and 7.3, which read "The patent proprietor is entitled under all circumstances to produce in Germany any matter that is covered by the claim of EP-X" and "The patent proprietor is entitled under all circumstances to sell in Italy any matter that is covered by the claim of EP-X." where EP-X was validated in Germany and Italy) but was nevertheless thought to represent basic knowledge, namely which tested that a patent is not a right to use but a right to exclude.

Question 9 showed that some candidates had difficulties with statements involving interlocutory revision.

Claims analysis part (Julia Mills)
In the claims analysis part, the client's patent application related to jugs or filter carriers for mounting on jugs with replaceable filter cartridges for filtering water. In such jugs or filter carriers the filtering capacity of the cartridges is subject to exhaustion, and therefore the cartridges must

be replaced after a certain number of filtering cycles and/or after a predetermined period of activity of the cartridge.

[003] of the paper indicated that jugs or filter carriers provided with counting devices are known. Typically the counting devices are installed on the lid and are incremented manually when the jug is filled thereby indicating the number of filtering cycles. Drawbacks are that the counting device requires an operation to be carried out manually by the user and that the opening of a flap on the lid also involves manual operation. Thus, filling the jug requires the use of both hands, one to hold the jug and the other to open the flap and to increment the counter.

[004] indicated that it would be desirable to provide a jug where the amount of water filtered and therefore the level of exhaustion of the filter could be determined accurately. It would be desirable if the jug were easy to manipulate when filling and also when incrementing the counter indicating the number of times water has been added to the jug.

The application described 3 embodiments relating to a lid on a jug in detail, and mentioned an alternative embodiment wherein the lid may be a lid on a filter carrier in its last paragraph.

Two prior art documents D1-D2 were introduced after resp. the client's application, D3 after claim 16, and D4 after claim 18.

D1 described 3 embodiments of a jug for filtering water, D2 described 2 embodiments providing jugs in which the amount of water treated by the filter cartridge is accurately determined. D3 disclosed a container lid with an opening for filling the container. D4 disclosed a water filter jug with a replaceable cartridge.

The statements were testing scope of protection, novelty, two-part form, Article 84 EPC, correctness of dependency (neutralized after appeal), amendments, Rule 43(2) EPC's interrelated products and different uses, unity, common special technical feature, aspects of the problem-solution approach: effect of distinguishing feature, objective technical problem, arguments as to combine or not, arguments for assessing inventive step, closest prior art, and (lack of) inventive step assuming D4 to be the closest prior art and assuming a formulation of the objective technical problem.

General

The claims analysis part is designed to be relevant for Paper A and B but with 'black & white' questions. Scope questions are thought to be relevant for preparation for Paper A. Novelty questions are thought to be relevant for preparation for Papers A and B.

Statements on inventive step were considered to be difficult to phrase in 'black & white' but seen as particularly relevant for the preparation of the candidates for paper B. In consideration of the choice of closest prior art document often being arguable, the questions are designed not to directly ask which document is closest prior art.

There are no tricks in the claims analysis part; the Committee is not 'trying to be clever'. Candidates should try not to overthink the questions of the claims analysis part. However, there are also no trivial questions. It is seen as an ongoing challenge to design questions and statements which are answerable without ambiguity, as there are always different opinions.

In general, it is attempted to derive the wording of the statements from parts of the Guidelines so to be recognizable to candidates familiar with the Guidelines.

2018 paper

The 2018 Pre-Exam paper is thought to contain technically easy subject matter.

Regarding the prior art: D2 was functionally similar, but structurally different, and introduced in the paper as a relevant document for scope and novelty questions. D3 was functionally similar, but has a different purpose/field, and was introduced as relevant document for inventive step assessment. D4 also introduced for inventive step.

The first questions were expected to be easy. It was therefore surprising to Committee that this part contained statements to be 'neutralized', i.e. both answers counted as correct.

In response to a tutor's question on the phrasing of statement 12.2 ("Claim II.1 is in the correct two-part form with respect to the third embodiment of document D1"): this was considered to be a useful way of asking about what features a document contained and which it did not.

In response to a tutor's question on the phrasing of 18.4 ("For the assessment of inventive step of claim V.2 it is a valid argument that none of the documents D1, D2 or D3 disclose a water level detector"): the phrasing "a valid argument' merely refers to the reason being correct and relevant ("worthwhile"). Nothing else was intended by the phrasing, i.e., it does not need to be the most complete or only argument.

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Technical Problems in AI Inventions in the Light of the Guidelines for Examination in the EPO

Dr. R. Free (GB)

In this article Rachel Free extends her arguments, first made in "Framing new technical problems for AI inventions" CIPA Journal October 2018 Volume 47 Number 10 pages 18 to 21, to take into account the updates to the Guidelines for Examination in the EPO which came into force on 1 November 2018 (referred to herein as The Guidelines).

One of the requirements to obtain valid patent protection in Europe (and arguably in many other jurisdictions), for a computer-implemented invention (CII), is to have a technical problem that is solved in a technical manner, which is new and inventive. Ideally, patent attorneys are able to incorporate in the patent specification at the time of drafting, several of the technical problems and solutions that they find, in order to aid prosecution of the patent application to grant. Another way of expressing the concept of a technical problem and technical solution, is to say that the result of the technical problem and technical solution is a "further technical effect" which is an effect going beyond the "normal" physical interactions between the software and the computer hardware. The updates to The Guidelines include the following examples of further technical effects at section 3.6.1:

- Methods with a technical character/technical purpose;
- Methods designed based on specific technical considerations of the internal functioning of the computer;
- Methods controlling the internal functioning or operation of a computer;
- Programs for processing code at a low level such as compilers.

Artificial intelligence (AI) inventions are essentially a subset of CIIs because AI is a field of study which is a branch of computer science. The Guidelines has a new section headed "Artificial Intelligence and Machine Learning" which is a sub-section within the section on mathematical methods. The new section "Artificial Intelligence and Machine Learning" is limited to inventions concerning "computational models and algorithms for classification, clustering, regression and dimensionality reduction" and so is clearly not intended to apply to inventions using other forms of AI such as robotics, expert systems, probabilistic knowledge bases, reasoning systems and others. The section in The Guidelines headed "Artificial Intelligence and Machine learning" explains that where AI inventions are of a mathematical nature, they will need to meet the same requirements for patentability as for a mathematical method. That is, to be patentable, AI inventions of a mathematical nature need to be either:

- tied to a technical application/technical purpose, or
- tied to computer hardware.

Often, applicants limit the claim scope to a specific problem domain, in order to move the invention into technical

subject matter. However, this is typically not enough to achieve an inventive step because there needs to be an improvement or benefit over the prior art. Therefore typically, there will be another benefit resulting from the patent claim, such as improved accuracy, efficiency, saving resources, or giving security.

In considering seeking patent protection for AI inventions, it is interesting to consider whether AI inventions exhibit any new types of technical problems as compared with those that we are familiar with for CIIs in general. In particular, perhaps there are new types of technical problem concerned with AI ethics as explained in more detail below.

Fundamental technical problems for CIIs

Many of the technical benefits achieved by CIIs relate to a small set of high-level problems. These can be identified as:

1. saving resources (memory, processing capacity, bandwidth, space, time, power),
2. improving accuracy (of simulation, prediction, control of processes or equipment), and
3. improving security.

In some cases one of these problems may be subsumed into another. For example, improving accuracy of a prediction may be seen as part of the problem of saving a resource. However, for the sake of argument, let's assume there are three fundamental technical problems of CIIs.

Note that the three fundamental technical problems are intended to be expressed at a general or high level, independent of a specific task (as "task independent problems"). Examples of problems which include the specific task ("task-specific problems") are ones like "how to recognise a face from an image depicting a person" or "how to control a manufacturing plant" or "how to reduce burden of user input to a computer".

There are other problems CIIs typically address, but are arguably not considered as technical problems at all, due to their abstract nature. Some of these abstract problems are fundamental to CIIs and, more particularly, are fundamental to AI inventions. Examples in AI are: how to represent knowledge/data in a way best suited to the task at hand, how to represent uncertainty, how to search a huge search space/compute an optimisation. Many of these tasks are building blocks used in AI technology.

New technical problems

In the case of AI inventions, the author has been finding that there are a number of new technical problems arising that it is difficult to incorporate into her list of high-level, or fundamental, technical problems. Because these problems are common to many types of AI inventions, the author argues that these are sub-problems of a new fundamental technical problem, rather than task-specific ones. Some examples are set out below:

Generating a rationale for an AI decision:

An example of this is the claim language paraphrased below and taken from European patent publication number EP3291146 Fujitsu ("**'146**"). The claim is directed to an invention where a conventional neural network is mapped into a form where nodes of the neural network have semantic labels. A technical problem here is how to make the behaviour of a neural network more interpretable by humans. When a trained neural network computes a prediction, it is difficult for scientists to give a principled explanation of why the particular prediction was computed as opposed to a different prediction. Such a principled explanation is desirable for ethical reasons. The claim language in '146 captures a new technical problem: "how to make a prediction computed by a neural network more interpretable by humans".

Paraphrased claim 1 of EP3291146

A method for use with a convolutional neural network, CNN, used to classify input data, the method comprising:

- *after input data has been classified by the CNN, carrying out a labelling process in respect of a convolutional filter of the CNN which contributed to classification of the input data, the labelling process comprising using various complicated filters to assign a label to a feature of the input data represented by the convolutional filter;*
- *repeating the labelling process for each convolutional filter used;*
- *translating the CNN into a neural-symbolic network in association with the assigned labels;*
- *extracting, from the neural-symbolic network, knowledge relating to the classification of the input data by the CNN;*
- *generating and outputting a summary comprising the input data, the classification of the input data assigned by the CNN, and the extracted knowledge, and an alert indication that performance of an action using the extracted knowledge is required.*

Implementing the right to be forgotten

Another example is the problem of how to efficiently remove data about a particular person from a machine-learning system or a knowledge base, which has been created using data about the particular person and data about a huge number of other people. This problem is also referred to as "how to enable the right to be forgotten". Removing data about a particular person is extremely difficult where that data has become subsumed in a complex representation of data inside a computer, such as a deep

neural network, without completely retraining the neural network. Removing data about a particular person from a knowledge base is also extremely difficult for the same reason. Ways of tracking which data has been used in which parts of the knowledge base and removing the effects of particular data need to be invented. This would overcome the high costs of completely retraining or reconstructing the neural network or knowledge base. These problems are seen as very complex, and more than mere administration since they could not be done manually and since there is no straightforward solution currently known.

Determining accountability where an autonomous agent is involved

Determining accountability, for example, when an autonomous vehicle is involved in a collision or event resulting in death of a human or other harm is a very real obstacle to securing acceptance of autonomous decision making systems. The problems involved in determining which entity is accountable are known to be extremely difficult to solve. Indeed, a recent report from the European Commission proposed that because of this difficulty a sensible and pragmatic way forward is to make the autonomous AI agent itself the entity which is accountable[1]. As a step towards this, tamper-proof ways of recording state of the autonomous vehicle need to be invented, and ways to trigger when it is appropriate to record such state so that after an event involving harm, the recorded state can be used as evidence. How to record state of the autonomous agent in tamper-proof ways will become even harder in future because there will be a possibility for the AI agent to be deceptive. Humans will need to invent ways to record state in ways guaranteed to represent ground truth.

Driving "acceptable" behaviour

A further example is how to create a trained machine-learning system to perform a particular task in a manner that is acceptable to humans, so that, for example, it is not biased against particular sections of society. A machine-learning system trained to recognise faces might inadvertently be biased against people from a particular ethnic group, depending on the training data used. If a solution to this problem is more than mere abstract statistics, there is potential for a technical solution.

The "problem" of ethics using AI

If we think about the new technical problems of AI inventions discussed above, these are all concerned with so-called "AI ethics". That is they reflect the values that societies hold concerning how to use and create AI. The AI ethics value of each of the examples is:

- In the case of generating a rationale for a decision computed by a neural network, that humans should have a right to know that an automated decision is being used and how the automated decision has been made when that decision uses personal data and the decision has a legal effect on the person;

- In the case of how to remove data about a particular person from an AI system, that humans have a right to withdraw consent to use of their data in some cases, and that the withdrawal of consent should be effective;

- In the case of determining accountability, that it should be possible to determine which human entities and legal persons are responsible or accountable for artificial, or semi-artificial, autonomous agents; and

- In the case of unacceptable behaviour such as avoiding bias, that AI (or at least its use) should be fair and not discriminate against particular sections of society.

Returning then to the list of fundamental CII problems, note that the first and second (efficient use of resources, and greater accuracy) relate to objective determinants based on the laws of nature, whereas the third, improving security, arises from and is determined by human-made requirements. Adding the AI ethics-related "technical" problems to the list, would be adding further human-made requirements, determined on the basis of human made rules of ethical conduct. There are potentially several new entries into the list in this class, including how to achieve transparency, how to give data privacy rights, how to enable accountability and how to ensure fairness.

Do AI ethics-related problems have anything in common?

If AI ethics related problems have something in common, then perhaps we can replace them in the list by a single new fundamental problem.

In my view, the AI ethics-related technical problems do have commonality, which is "how to address the risks that come with increasingly able AI", and I would therefore argue that we should add this problem to the list of fundamental technical problems of CIIs. The rationale for each of these is that:

- Generating a rationale for a decision computed by a neural network will help humans to control the AI as AI becomes more "able";

- Implementing the right to be forgotten gives individuals the ability to control AI in the use (or abuse) of their personal data as the use of AI becomes more pervasive;

1 see JURI draft report of 31 May 2016 PE582.443 2015/2103(INL) setting out a series of recommendations on civil law rules on robotics

- Enabling accountability to be determined such as by recording the ground truth state of an AI agent in a tamper-proof way gives humans the ability to know what an AI agent has done; and

- Avoiding bias enables humans to ensure AI agents act fairly, again as the use of AI becomes more pervasive.

As the ability of AI increases there will be a corresponding increase in the need to deal with the risks, as explained by the following quote. Thus the specific problems mentioned in the bullet point list above are the beginning of a whole field of problems yet to be formulated and solved.

"Let an ultraintelligent machine be defined as a machine that can far surpass all the intellectual activities of any man however clever. Since the design of machines is one of these intellectual activities, an ultraintelligent machine could design even better machines; there would then unquestionably be an "intelligence explosion", and the intelligence of man would be left far behind. Thus the first ultraintelligent machine is the last invention that man need ever make, provided that the machine is docile enough to tell us how to keep it under control." I J Good, 1965.

I have therefore argued that the fundamental technical problem to be added is "how to address the risks of increasingly able AI"[2].

What is the relevance of a "new" fundamental technical problem to patent drafting and patent prosecution of CII inventions?

- The list of fundamental technical problems provide a resource to help the patent drafter work with the inventors to identify technical problems to be mentioned in the patent specification.
- During prosecution the list can also be used to identify and frame technical problems based on material in the specification, although it is much harder to rely on problems that are not already expressly mentioned in the specification.

In addition to using the idea of a wider set of fundamental technical problems, and specifically the addition of an ethics based technical problems, practitioners also need to take account of the recent updates to the EPO Guidelines for Examination regarding AI technology. Let's consider each of the examples of further technical effects given in The Guidelines.

2 I would note that others have suggested a more fundamental problem, namely that of how to control super-intelligent machines. (In Superintelligence (Oxford University Press 2014), Nick Bostrom argues that as AI advances there will eventually be an exponential explosion in the rate of improvement of AI cognitive ability, which results in a singleton superintelligence that will pose an existential risk to humanity.)

- Methods with a technical character/technical purpose;

- Methods designed based on specific technical considerations of the internal functioning of the computer;

- Methods controlling the internal functioning or operation of a computer;

- Programs for processing code at a low level such as compilers.

Methods with a technical character/technical purpose

Is technology which answers the technical problem of "how to address the risks of increasingly able AI" technology which has a "technical purpose"?.

In order to assess whether a purpose is technical or not the EPO looks to case law. However, there is no existing case law regarding AI ethics as it is such a new field.

Another way to assess whether a purpose is technical or not is to consider whether the field of study is a technical field or not. So for example, an engineering purpose would be considered technical because engineering is a field of technology. In the case of AI ethics, ethics is a branch of philosophy and philosophy is not a science or technology because it is not empirical. Ethical values are held by human societies and vary according to the particular human society involved. Therefore there is an argument that "how to deal with the risks of increasingly able AI" by giving AI ethical values is a social problem which is not in a technical field. I disagree with this line of argument since scientists and engineers will need to devise engineering solutions, be they software and/or hardware engineering solutions, in order to give AI ethical values and ensure the AI upholds those values. The problem of deciding what ethical values to give AI is a separate problem.

With regard to ways to make AI computation interpretable by humans, there are arguments that this is a technical purpose since it gives information to humans about the internal states of the computer.

With regard to ways to remove data from already trained AI systems without having to completely retrain them, there are arguments that this is a technical purpose because it is not merely administrative. Getting the solution wrong would lead to a non-working result or worse, to an incorrectly operating AI that may cause harm as a result. The same applies for ways to make AI decision making systems unbiased/fair. These problems are part of a broader task of controlling an AI system which is a technical problem of control and is not an administrative problem of removing data.

In my experience, even where a claim is limited to a technical purpose, it is often necessary to include one of the fundamental technical problems of CIIs in order to achieve inventive step. If AI ethics becomes one of the fundamental technical problems of CIIs then perhaps it will often be combined with a more specific technical purpose such as those listed in The Guidelines (controlling an X-ray apparatus, determining a number of passes of a compaction machine to achieve a desired material density, image processing, ...).

Methods designed based on specific technical considerations of the internal functioning of the computer

It is very likely that some inventions that address the risks of increasingly able AI will be designed to make use of particular internal functioning of the computer. One can imagine an ethical AI operating system designed to prevent the computer from being deceptive and using detail of the internal functioning of the computer.

Methods controlling the internal functioning or operation of a computer

The operation of a computer, where the computer implements artificial intelligence technology, is potentially autonomous operation that may need to be controlled by humans. Therefore methods of controlling the internal functioning or operation of a computer are at the heart of technology which addresses the risks of increasingly able AI.

Programs for processing code at a low level such as compilers

Programs for processing code at a low level such as compilers will also need to have AI ethics values integrated in order to deal with the risks of increasingly able AI. Therefore some AI ethics inventions will show a technical effect by virtue of processing code at a low level.

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News from the EPO – Report about the VPP Conference in October 2018

Dr. D. Herrmann (DE), Dr. J. Schmid (DE), Members of the Editorial Committee

VPP is an Association of Intellectual Property Experts in Germany and organizes two annual meetings in spring and autumn. On October 25-26, 2018, the autumn annual conference took place in Mannheim, Germany. Both instances of the EPO presented updates about current developments and ongoing projects such as (user-driven) early certainty, IP5 and the revision of the Rules of Procedures of the Boards of Appeal. Furthermore, legal challenges of Internet of Things, Blockchain and 3D printing were also discussed.

1. Revised Rules of Procedure of the EPO Boards of Appeal

In a first session, Dr. Peter Guntz, member of the EPO's Legal Board of Appeal, provided an overview of the current situation regarding the admission of late submissions in proceedings before the Boards of Appeal. In particular, he presented an update on relevant recent case law and discussed the upcoming revision of the Rules of Procedure of the Boards of Appeal (RPBA). A first draft of said revision had been published in February 2018 and formed the basis of this presentation. On December 5, 2018, a user consultation conference on the RPBA took place at the EPO in Munich and a revised draft was made available via the conference webpage in November 2018.

First, Dr. Guntz gave an introduction on the relevant legal provisions in the EPC and in the RPBA and highlighted recent decisions of 2017 and 2018 applying these regulations. In T 1719/13 it was decided that a request aiming only at "polishing a claim" is not admissible in opposition appeal proceedings. In T 1578/13 it was decided that a request aiming at solving a problem with Art. 123 (3) EPC by returning to the granted claim version that was not submitted in the first instance in spite of being obvious is not admissible. In T 2598/12 an auxiliary request that was only filed after the Board had issued a first communication was rejected for lack of substantiation. In T 1162/12 it was decided that a new set of claims that could have been filed in the first instance can be rejected in opposition appeal proceedings even if it is filed after a communication of the Board. In T 1280/14 it was decided that a subset of a larger set of non-converging auxiliary request corresponding to different lines of defence cannot be admitted into the proceedings, although the original larger set had been filed in the first instance. In T 649/14 the Board decided to not admit an originally converging auxiliary request which was rendered non-converging

upon filing further requests during oral proceedings. In T 156/15 it was decided to reject an auxiliary request which was submitted after an internal discussion of the Board. In T 360/13 a request that was filed after the debate was closed was rejected. In T 158/14 the Board decided to admit new evidence into the proceedings after it was found that the late filing could not be considered a misuse of the appeal proceedings. In T 2187/14 a second machine translation that was filed to replace an initial incomprehensible machine translation was not admitted. In T 884/18 it was decided to not admit a public prior use by the appellant that was only introduced in the appeal proceedings. In T 1914/12 it was found that a mere argument, even it has not been presented before, cannot be rejected based on Art. 114 (1) EPC. Dr. Guntz closed this first part of his talk by emphasizing that in spite of the presented decisions the number of decisions in which a late submission was not admitted is small in comparison with the cases in which late submissions were allowed.

With respect to the revision of the RPBA, Dr. Guntz lined out that the revision aims at improving appeal proceedings with respect to predictability, consistency, efficiency and duration. A first change will be that a compulsory communication of the Boards of Appeal prior to oral proceedings will be codified. Further, it will be stipulated that appeal proceedings correspond to a judicial review of the decision under appeal. In this respect, various new regulations relating to late submissions of new subject-matter (such as a new request or a new document) during appeal proceedings will be introduced, allegedly codifying the prevailing case law.

In particular, the burden to justify a late submission of new subject-matter in the appeal proceedings will be shifted to the parties. New subject-matter will only become part of the proceedings if explicitly admitted by the Boards of Appeal after consideration of the reasoning in support of the admission of the new matter, which must proactively be submitted by the party. The statement setting out the grounds of appeal should be directed to the requests, facts, arguments or evidence that form the basis of the first instance decision. According to the revised rules, any other subject-matter will be considered late filed under normal circumstances. If a request is amended, reasons have to be proactively provided as to why the amended request is nevertheless to be admitted into the proceedings and why the amended request does not give rise to further objections. Any subject-matter that could have been introduced or that has been abandoned in the first instance will only be admitted under special circumstances.

Already now, all arguments why the first instance decision is to be revoked should preferably be included in the initial statements of appeal or defence, respectively, to reduce the risk that arguments initially not submitted become rejected since they are only filed later on in course of the appeal proceedings. However, the situation with respect to amendments to a party's appeal case may be stricter in the future. According to the revised rules, any subject-matter going beyond a party's appeal case will be considered late under normal circumstances. If a request is amended, reasons have to be proactively provided as to why the amended request is nevertheless to be admitted into the proceedings and why the amended request is prima facie allowable. The later along the appeal proceedings a party files new subject-matter, the higher the probability will be for the Boards of Appeal to reject the new matter for reasons of procedural economy only.

Apart from the revised RPBA, Dr. Guntz also presented that the Boards of Appeal would currently assess whether or not requests filed during opposition proceedings but filed after the deadline set by Rule 79 EPC and before the deadline set by Rule 116 EPC, could be rejected by an Opposition Division as being late filed.

Dr. Guntz finished his presentation by pointing out that the revised RPBA will enter into force at the earliest six months after the approval by the Administrative Council. Possibly, the Administrative Council will approve the draft in March 2019 so that the revised RPBA could enter into force in early 2020. The above topics presented by Dr. Guntz lead to a controversial discussion between the participants and the speaker, and among the participants during the breaks.

2. Current developments at the first instance of the EPO

In another session, the vice president of the EPO, Raimund Lutz, presented updates from the first instance of the EPO, such as (user driven) early certainty, online filings and IP5. With regard to early certainty, Mr. Lutz explained the increases of patent grants by about 40% in 2016 and 10% in 2017 with consequences of "raising the bar" from 2010, the establishment of the new Rule 70a EPC and the new practise that applications ready for grant are immediately granted. Mr. Lutz emphasized that, from the EPO's point of view, this increase in granted patents is not going along with a reduced quality of the grant proceedings, even though the perception of applicants and attorneys may be different. Mr. Lutz showed that the average time for search, examination and opposition would be 4.5 months, 22.4 months and 19.6 months, respectively. Examiners would also be encouraged by the EPO to use telephone consultations with the applicants more frequently. Mr. Lutz indicated that a 20% increase in divisional filings would have been observed in the last six months, which may be a reaction to the increased speed of examination. The initially planned user driven early certainty, according to which applicants could defer examination, would currently not be pursued anymore by the EPO due to a lack of international support. However, another user consultation is

planned in the near feature and this initiative may be picked up again by the EPO. Mr. Lutz reminded the audience about the validation states, Morocco, Moldova, Tunisia and Cambodia, where European patents can be validated although these states could not become EPC members. With regard to online filing, Mr. Lutz described that 98% of all EP applications would be filed online, wherein the current web browser-based system would be replaced by a new web browser-based system "online filing 2.0" in 2020. Mr. Lutz emphasized some of the achievements of IP5, namely the "global dossier", which allows to access the patent registers of IP5 patent family members via Espacenet, and the "common citation document". The IP5 offices will run a test phase for a "collaborative search and examination" during which applicants can participate and can have all IP5 offices contribute to the ISR and the WO-ISA of their PCT applications. The audience thanked Mr. Lutz, who will leave office as planned end of 2018, for his work over the past years.

3. Other legal topics: Internet of Things, Blockchain and 3D printing

Apart from the updates from the EPO, the VPP conference provided, as usual, high quality presentations about various current legal challenges. This time, Internet of Things, Blockchain and 3D printing were covered by experienced presenters from private practise. The legal challenges for obtaining and enforcing IP rights in these fields by patents, designs, trademarks and copyrights were discussed.

VPP consistently provides a well-organized platform for attorneys at law, patent attorneys, in-house councils, judges, examiners and other IP professionals to exchange IP viewpoints. The next VPP spring annual conference will take place in Bamberg on May 9-10, 2019.

Blood, Sweat and Tears – in Vitro Diagnostic Method Claims Limited by Intended Use

Dr. C. Richter (DE)

The European Patent Office frequently grants in vitro diagnostic method claims limited to an intended use feature in the form of the diagnosis of a specific disease. What may at first glance seem a fair limitation to what was actually invented may introduce a lack of clarity and deny the inventors a fair reward reflecting their contribution to the art. It is proposed that extending the scope of protection depending on the value of the method in a diagnostic workflow or for an indirect diagnosis of further diseases be considered. Furthermore, specific guidance on the interpretation of intended use features in in vitro diagnostic method claims is required.

1. Introduction to in vitro diagnostics

In vitro diagnostics (IVD) continues to be one of the fastest-growing areas in healthcare, with an expected growth of 5.1 % between 2014 and 2020 and worldwide sales of 67.3 billion dollars in 2020[1], owing to advances in the field of genomics and an increasing demand for diagnostics for age-related conditions. Therefore, it comes as no surprise that patent offices and courts are dealing with an increasing number of patents and litigation cases in this field[2].

IVD tests are usually based on the detection of a biomarker in a bodily fluid. A biomarker is an analyte the presence, absence or concentration of which relates to a disease of interest. For example, if a patient is infected by a virus, the circulating virus will trigger the production of antibodies that bind specifically to the virus and can be detected in a blood sample. A variety of biomarkers for diseases and conditions exist, from simple organic compounds to complex biomolecules including specific gene sequences or even whole cells.

2. Claims in European patent office (EPO) prosecution proceedings

R&D activities in IVD frequently culminate in the filing of patent applications. According to national case law, a method claim can only be enforced in those countries where the patent is valid and the diagnostic assay is actually performed, not in those where the service is merely adver-

1 Deloitte, 2017 global life sciences outlook; https://www2.deloitte.com/hu/en/pages/life-sciences-and-healthcare/articles/global-life-sciences-sector-outlook.html; downloaded on October 2, 2018.

2 For example, BGH 2016, 1027 – Zöliakiediagnoseverfahren; BGH, GRUR 2017, 475 – Rezeptortyrosinkinase II; BGH GRUR 2017, 493 – Borrelioseassay.

tised or where samples are collected[3]. Therefore, patent protection in a broad range of countries is desirable, which is the reason why many applicants intending to commercialize in Europe decide to file European patent applications.

Patent offices find themselves under considerable pressure not to grant unduly broad claims, in particular in the field of biotechnology. IVD related product claims often lack novelty, since reagents such as polypeptides may be described in the state of the art before their function and diagnostic usefulness is revealed. In consequence, many applicants request the grant of method claims.

In prosecution proceedings, applicants frequently incorporate the diagnosis of a specific disease as an intended use in such method claims, either voluntarily or hoping that such a limitation will render novel the subject matter of the claims over a piece of prior art disclosing the method in general or for the diagnosis of another disease.

Furthermore, in the absence of relevant case law and provisions in the Guidelines providing guidance how to examine sufficiency of disclosure of *in vitro* diagnostic claims, EPO Examining Divisions frequently tend to interpret Art. 83 EPC such that method claims must be limited to the diagnosis of one or few select diseases the correlation of which with the biomarker is directly corroborated by experimental evidence. In other words, if it is shown that a sample from a patient suffering from a certain disease contains the biomarker, but samples from healthy subject do not, claims relating to a method for the diagnosis of this disease (but no others) are likely to be considered allowable[4].

As a result, the vast majority of granted *in vitro* diagnostic method claims appear to include an intended use feature[5].

3. Claims limited to a specific diseasemay neither be a fair reward for the inventors nor clearly define of the scope of protection

The assumption underlying the objection according to Art. 83 EPC that a biomarker directly correlates only with one or few select diseases is far from current approaches in diagnostics and tends to underestimate the value of many IVD assays. If a patient presents, the medical doctor in charge is likely to consider his clinical picture and history and then follow a diagnostic workflow starting with methods based on unspecific biomarkers, the results of which may lead them to exclude certain diseases and consider more seriously others, leading to the performance of a select number of highly specific tests for the final diagnosis.

In other words, the result of an IVD assay may be a valuable contribution, even though it may only steer the clinician in the right direction rather than provide a conclusive diagnosis. The fact that a negative test result may be used to rule out one disease and point to another one has been acknowledged by the Enlarged Board of Appeal in G1/04[6]. Therefore, a claim limited to diagnosis of a single disease is in many cases not a fair reflection of the inventor's contribution to the art.

Moreover, the limitation of a claim to a distinct disease of condition may lead to legal uncertainty at the stage of litigation.

The result of diagnostic tests may be relevant for the diagnosis of other diseases, but the patentee may argue that the protected diagnostic method will inevitably be used if the technical steps of the method are practiced, because the diagnostically useful result is obtained, no matter whether the person carrying out the method aimed to diagnose the disease specified in the intended use feature[7].

While this may seem like a rather biased way of interpreting the scope of protection, features relating to the purpose, technical effect or function of product claims have been considered irrelevant if structural features were sufficient to define the requirements for achieving the sought-after technical effect in national infringement proceedings[8]. Similarly, the BGH ruled that indications of purpose, technical effect or function in method claims do not necessarily limit the scope of protection, but may simply help the person skilled in the art understand the background of the invention[9].

Moreover, the Guidelines, referring to **T304/08**, contemplate in the context of clarity that the indication of an intended use of this method may at most be seen as limiting to the extent that the method has to be suitable for that use[10]. If this was applied to *in vitro* diagnostic method

3 Landgericht Düsseldorf 4b O 247/09 - Hunde-Gentest; BGH, GRUR 2017, 475 – Rezeptortyrosinkinase II

4 Throughout this article, it is assumed that the claim is phrased such that it does not fall under the exception to patentability according to Art. 53 (c). A more accurate intended use feature would be "aiding in the diagnosis" rather than "for diagnosis".

5 For a rough assessment, 42 patents comprising in vitro diagnostic method claims granted and published by the EPO between 2012 and 2018 were identified using the PatBase software package (Minesoft) and the key words "method" and "diagn*" as well as IPC classes G01N33/48 and G01N33/50, followed by review of the claims. Patents relating to veterinary diagnostics, companion diagnostics, the identification of pharmacologically active compounds, general analytical or chemical methods and medical or diagnostic devices were disregarded. In 37 out of 42 patents (88.1%), claims were limited specific diseases. Only in 4 out of 42 patents (9.5 %), claims were limited to a reasonably broad generic group of diseases, in one patent there was no disease-related limitation.

6 In section 5.1 of the results of G1/04, the Enlarged Board of Appeal acknowledges that a diagnosis includes a negative finding that a particular condition can be ruled out.

7 It may in fact be difficult for a court to determine, based on technical facts, whether the intended use feature is practiced, since the disease to be diagnosed may be considered a subjective element, i.e. depend on the intention of the alleged infringer (German: subjektives Tatbestandsmerkmal). An expert witness may have to be heard before a decision can be made.

8 *BGHZ 112, 140, 155f. – Befestigungsvorrichtung II.*

9 *BGH, GRUR 2010, 1081 – Bildunterstützung bei Katheternavigation.*

10 Section F-IV 4.13 (2018), final paragraph, where there is no reference to diagnostic claims, though. T304/08 relates to a method for reducing malodor.

claims, a claim limited to a novel intended use such as the diagnosis of a specific disease would be anticipated by the disclosure in the state of the art of the method in general or for the diagnosis of another disease. This new provision is in line with the national case law cited in that the intended use is not to be regarded as a limiting technical feature.

By contrast, in a more recent BGH decision regarding the validity of a patent comprising a biomarker-based diagnostic claim[11], the indication of the intended use and the reaction of the reagent and the analyte was disclosed in the prior art, but without revealing their exact chemical natures. The claims of the patent comprised a method with an intended use ("for the diagnosis or monitoring the therapy of coeliac disease"), and the BGH pointed out that neither was a method for the purpose of diagnosing coeliac disease disclosed nor clarified whether the autoantigens could be used for such a method, apparently considering the intended use an independent feature contributing to the novelty to the patented method. It was emphasized that the prior art did not disclose a method for the purpose of diagnosing or monitoring the therapy of said disease.

Likewise, many EPO examining divisions readily acknowledge novelty subject to incorporation of an intended use feature relating to the diagnosis of a second disease, apparently in a manner similar to a novel use of a previously known product[12].

If such an intended use is indeed considered a valid novelty-conferring feature, the logical consequence is that it will have to be considered as limiting the scope of protection. However, since opinion on the subject appears to be divided, it is at present unclear how a national court in infringement proceedings will interpret the scope of such claims.

In summary, limiting patents by introducing an intended use in the form of a single specific disease may not only mean that the patentee is denied a scope of protection reflecting their contribution to the art, but may also obscure the scope of protection and lead to legal uncertainty.

4. Towards a balance between a fair reward for the patentee and public interest

Novel case law and special consideration of *in vitro* diagnostic method claims in the Guidelines are clearly desirable to clarify how an intended use should be interpreted. In particular, attention should be given to the difference between working methods and methods of manufacture on the one hand and *in vitro* diagnostic method claims on the other. While the intended use may well only be a redundant feature if the properties of the product are determined by manufacturing steps, there is no implicit technical connection between the steps of the diagnostic method and the diagnostic result, meaning that an intended use feature in an *in vitro* diagnostic claim that is essential for the patentability should not be disregarded. In any event, it is paramount that patent offices and courts follow a uniform approach.

As far as the examination of the requirements according to Art. 83 EPC is concerned, it seems necessary to establish a minimum standard that has to be met if an *in vitro* diagnostic method claim is to be considered allowable.

It is of course essential that data provided by applicant should provide credible support showing that the assay provided is a valuable contribution to the diagnosis. More specifically, it should be plausible that there is a significant correlation between the detection of a biomarker and the disease, i.e. that a group of patients suffering from the disease of interest is more likely to show a specific test result that allows for distinction from another relevant group such as a group of healthy individuals or a group of patients suffering from a different conditions, but with similar symptoms. It should be borne in mind, though, that this specific test result need not necessarily be positive in the sense that the presence of the marker in the patient's sample is detected. In some cases, detecting the absence of a marker may be just as useful[13].

Furthermore, it is just as important to consider clinical symptoms of the relevant diseases as well as the diagnostic work flow. An examining approach involving an automatic limitation of an *in vitro* diagnostic method claim to the disease(s) mentioned in the examples may not do the inventors justice. A key consideration should be whether a clinician is in practice likely to consider the result relevant for the diagnosis. The applicant should be allowed to extend the protection to the diagnosis of further diseases which are characterized by similar symptoms, but may be distinguished using the method according to the invention, even if such diseases are unrelated in terms of their molecular mechanisms. Furthermore, extending the scope of protection this way will make it more difficult for an infringer to argue that his intention was to use the method for the diagnosis of another disease, thus adding to the clarity of the claims and streamlining infringement proceedings.

11 *BGH 2016, 1027 – Zöliakiediagnoseverfahren.*
12 G2/88, G6/88.

13 For example, it is widely accepted that the presence of an autoantibody to the protein DFS70 shows that a patient is *less likely* to suffer from ystemic rheumatic autoimmune disease (Showman, O., Gildburd, B., Chayat, C., Amital, H., Langevitz, P., Watad, A., Guy, A., Perez, D., Azoulay, D., Blank, M., Segal, Y., Bentow, C., Mahler, M., Shownfeld, Y. (2018) Prevalence of anti-DFS70 antibodies in patients with and without systemic autoimmune rheumatic disease. Clin. Exp. Rhematol. 36 (1):121-126.

In addition, special credit should be given to inventors of assays for the diagnosis of orphan diseases, since samples and clinical data are difficult to come by and supplementary protection certificates are not available for diagnostic products and methods.

Applicants are well advised to provide arguments supporting the usefulness of their method for the diagnosis of all relevant diseases rather than just including a list of diseases of commercial interest in the application. It may be helpful to discuss the importance of the test result in the context of a diagnostic workflow and by showing how a clinician may build on the test result a diagnosis of diseases beyond those mentioned in the examples. Key clinical symptoms should be defined in the application or by reference to current text books.

The result should be a granted patent reflecting the true achievements of the inventors, from a broad method claim, with a limitation to a reasonably broad group of diseases or even no such limitation in the case of a groundbreaking diagnostic method contributing to a variety of diagnoses, to a narrow claim for the diagnosis of a specific single disease if the readout of the *in vitro* diagnostic method merely confirms a diagnosis strongly suggested by the clinical picture.

The Patent Attorney of the Future: The Dutch View

A. G. Tangena (NL)

Vision: European Patent Attorneys (EPAs) should be first rate advisors for companies on how to exploit their innovations, how to integrate the use of patents in their business plans and in protecting companies from making costly mistakes in contracts that have IP clauses.

1. Introduction:

This article is mainly based on the training that someone who wants to become a Dutch Patent Attorney receives via the non-profit organization SBO. The skills to be developed by the trainees have been determined in close cooperation by the Dutch Patent Office (part of the Ministry of Economics), the Orde (Organisation of Dutch Patent Attorneys), private patent firms and industry. All these groups are also represented in the management team of the non-profit organisation.
In order to be first rate advisors EPAs should have skills in the following areas:

Technical: think with the inventor to transfer an idea into a patent application

Legal: prosecute patent applications, set-up the right legal framework in cooperations, (cross)licensing contracts, NDAs, advice on IP liability in contracts like purchase/selling contracts.

Strategic: have a vision of the future and structure a patent portfolio to optimally fit in this strategic vision.

Commercial: When taking any strategic decisions make sure value for a company is created and decisions fit with business plans.

Communication: EPAs should be able to communicate above mentioned topics both with inventors, business(wo)men and EPO officials

Other IP rights: EPAs should have knowledge on basics of other IP rights: TM, design, copyright

Skills alone are not sufficient. There must also be enough work in the countries to keep the skills at a high level through regularly practicing these skills.

Part 2 will give a more detailed exploration of the skills of the EPA of the future.

Part 3 will give some ideas on how to realize the EPA of the future and how to generate enough work so that EPAs can be found in every EPC country.

2. More detailed exploration of the skills of the EPA of the future:

Technical:

Technical know-how is the basis of the profession. The EQE is now very limited to one technical topic.

- As a follow-up to EQE make training available in different technical areas, i.e. how to draft in chemistry, pharma, ICT, mechanics or telecom areas. Courses can be based on decided EPO cases (teach best practice) set up by PEC, EPO Academy and technical working groups of EPPC. **epi** could hand out certificates when courses have been followed. Courses also serve to build networks in a specific technical field for consulting/outsourcing purposes. This is also in line with

the suggestions to provide more training for those EPAs who recently passed the EQE and want to further develop as Magdalena Augustyniak indicated in her contribution to the "40 years **epi**" booklet.

- Inventor should also understand patents (or IP in general), i.e. we should train academics in why patents are important for businesses. There must be a lot of countries who already do this sort of work. Collect material and make a set of best practices available for use in all countries. Focus should be on how patents can be used to create value not on Articles and Rules. Laws change all the time, for that up to date knowledge on laws inventors should consult EPAs. Involve the EPO Academy (they have a section focused on Academics: Giovanna Oddo (IP teaching kit) and IP4inno presentations) and National Patent Offices. This aspect is very important for countries that generate few patents locally. By making technical (and creative) people aware of how they can make use of patents to create value we can increase the local interest in patents (or IP in general).

Legal:

Besides the standard legal knowledge on EPC, PCT and national patent laws, the 4th industrial revolution makes cooperation between companies necessary leading also to open innovation and public-private cooperation. Advice is needed on (cross) licensing, freedom to operate (limitation of IP liability) and how to deal with IP liability in purchasing or selling contracts. Such developments make detailed advise and agreements on what rules are recommended, necessary.

- Training on how to structure cooperation, what rules, how to give recommendations, how to draft and deal with patents in contracts.

- In NL we discussed a set of rules for cooperation between public institutions (universities, government research institutes) and private companies, i.e. who gets the IP at what costs and what are the rights of other participants. Such rules are essential for a smooth cooperation.

- We could also work with the LES to train people in licensing.

Strategic:

When filing a patent application this is (mostly) for the future. Thus companies need to make strategic considerations.

- EPAs should be trained in patent portfolio management, i.e. what questions to ask a company about relevance of (future) technology, what are the internal competences of a firm, do your own research versus insourcing of technology, how is the competitive field, how many patents in what technology area, what countries to file in, possibilities for licensing? Especially for SMEs costs are of utmost importance, so EPAS should be able to advice on what strategic choices cost (in the future).

Commercial:

Patents are a tool that companies should use to further their business goals. Patents should contribute to value creation for companies. Also when buying or selling patents an EPA should be able to advice.

- Training on the different methods of valuation of patents.

- EPAs should know the basics on ways to acquire extra funds for R&D, i.e. European funds, local possibilities for tax reduction for R&D in the specific countries (done in close cooperation with the national patent office)

Communication:

EPAs need to communicate with inventors, companies and EPO officials.

- General training in pleading, i.e. how to structure arguments, make a logical reasoning. In NL we use trainers from the Dutch language institute of a University to do this sort of training on non-patent topics when persons just start in the profession.

- Further focus on how to do oral proceedings. PEC already offers this sort of training in seminars. Focus should be on training in small groups where you plead yourself and not on listening in classrooms.

Other IP rights:

At this stage focus on this field is not recommended since most EPAs have knowledge of other IP rights from their training for national patent attorney. It is important however to realize when we speak of patents we should often include other IP rights, i.e. talk of Integrated Intellectual Asset Management.

3. How to realize the EPA of the future:

Many of the above topics deal with training. PEC in cooperation with the EPO Academy should take the lead in this training. The words of President Campinos of the EPO: 'EPO would be ready to explore possibilities for supporting **epi** for instance towards transforming ideas into commercial realities', is in line with the above way of thinking about the EPA of the future.

One major complication is the distribution of EPAs across Europe, especially in those areas where attorneys are widely

spread. In such a case a form of blended learning (flipping the classroom) seems very suitable as Magdalena Augustyniak already indicated in her contribution to the "40 years **epi**" booklet. In short blended learning is a combination of e-learning in a digital learning environment and learning in the classroom:

Digital learning environment	In the classroom
Reading (literature)	Focus on specific topics
Looking at videos	More extensive learning
Practice (teaching modules)	Share practical experiences
Tests (self-diagnostic tests)	Tips and tricks (checklists)
Contemplation (read again)	Practice skills
Exchange (forum)	Check whether topic is understood
Apply (homework)	Discuss homework

Table after M. van den Bosch, Radboud University of Nijmegen (NL)

Even in the Netherlands with its small size we will transfer the standard 2 year classroom training for Dutch patent attorney trainees into blended learning to make the whole training more effective and better suited for the student of the future, who will have also blended learning at universities.

Who should lecture, organize the training?

In NL we are used to 'polder' model, i.e. we all work together to get the best results. This means that for every topic we find the best teacher available. This can be an attorney at law, an IP judge, a university lecturer or professor, someone from the Ministry and of course a patent attorney. The idea is that we complement each-other and are not direct competitors. For instance an attorney at law can draft a contract but he does not know enough about IP to formulate specific IP clauses in that contract. A Court case regarding infringement needs both EPA's and Attorney at Law's expertise.

What else is needed?

A small group of countries is now doing most of the patent work in Europe. Luckily we already see an increase in local filings in many countries as Luis-Alfonso Durán indicated in his contribution to the "40 years **epi**" booklet. However, the total numbers are still rather low and this increase may not be enough. The unitary patent will get rid of local validations, presenting a further threat to the profession in many smaller countries.

It is important to stimulate innovations in all EPC countries. This means also to have well educated EPAs in all EPC countries. Without them innovations cannot be properly exploited. It should be an important task of **epi** to assist in this goal. The Candidate Support Programme established together with the EPO is in this respect a good step forward. But once a group of well-trained EPAs is established they need enough work to remain viable.

This can be done in different ways. One way is that EPC countries with enough work outsource work to colleagues in countries that have not enough work. This is especially important since in many countries there is or will soon be a lack of technical people, who are the basis of our profession. Thus looking across borders and distribute work to EPAs in other countries should be an excellent way to keep EPAs provided with enough work. Our Vice President Barbara Kunič Tešović already took the initiative to create a web based market for exchange of services. This exchange should be build up, so that EPAs get to know each other and gain trust in the quality of the outsource EPA.

Another way is to form cooperations with firms across borders. Such cooperations exist. The cooperation is then presented to firms outside Europe as THE way to go to Europe, since the cooperation has expertise in many countries. Whenever there is a problem in one of the EPC countries there is a local firm in the cooperation that can help solve issues locally. Moreover such a cooperation makes it easier to outsource work to others within the cooperation and distribute work received from abroad.

A further way is to look at (historical) relations of EPC countries with countries outside EPC. It is well-known that the UK gets a lot of work from the US. In the same way PT and ES can exploit their relations with South America. The former East European countries can exploit their relations with the former Soviet Union countries and Turkey can exploit their relation with the Middle East.

4. The end result:

As said in the vision part of this note, an EPA should be a first rate advisor to companies. The result of the following up on the training for skills sketched before will be an EPA, who not only understands patent laws and knows how to get a patent granted, but an EPA who can think with the business to create most value out of inventions and can protect the company from making costly mistakes when dealing with IP, like in an infringement case or when drafting an agreement.

The different training options are also useful to create networks across Europe, so that EPAs get to know and appreciate others, i.e. the training options serve as a quality badge that will help working together or outsourcing across borders.

In general the appreciation of EPAs by the general public can be lifted to a higher level.

Another Attempt at Deferred Examination: New User Consultation by the EPO on Increased Flexibility in the Timing of the Examination Process

Dr. D. Herrmann (DE), Member of the Editorial Committee

The EPO has launched a new online user consultation on the possibility of allowing more flexibility in the timing of the examination process by offering means to postpone the examination of European patent applications. This user consultation is to be seen in context of the "Early Certainty" initiative and the previously initiated and stopped attempt to implement "User-Driven Early Certainty", which was supposed to allow applicants to postpone the start of substantive examination by a maximum of 3 years. The primary objective of this user consultation is to receive the views of all stakeholders on the advantages and drawbacks of a postponed examination scheme in the European patent grant procedure.

Since the launch of the "Early Certainty" initiative in 2014, the EPO has been advertising that the office has significantly reduced the length of the patent grant procedure. The still to achieve goal of this initiative is to reduce the average time for examining an application to 12 months. While some stakeholders have generally welcomed the faster processing of applications, as it provides information on the outcome of examination at an earlier stage, other stakeholders have argued that there are various instances at which applicants might need more time before the grant of a patent, for example, to adapt the claims to the parallel development of corresponding products or to determine the final choice of countries in which the patent is to be validated.
In the present EPO system, examination of EP-direct applications must be requested and the examination fee must be paid within 6 months of the publication of the search report and examination of Euro-PCT applications must be requested and the examination fee must be paid, in most circumstances, on entry into European regional phase. Under this current system, the applicant has only a few means to start examination at the EPO earlier, such as by requesting early processing under Article 23(2) or 40(2) PCT, or to accelerate examination proceedings, such as by filing a PACE request or by waiving the Communications under Rules 161, 70/70a EPC. However, the applicant has otherwise no control over when examination begins. This is entirely dependent on when the EPO takes up the application for examination.

I. User-Driven Early Certainty (UDEC)

For the above reasons, the EPO presented again a proposal for deferred examination in autumn 2017, which was finally called "User-Driven Early Certainty (UDEC)" (initially: "Early Certainty with Flexibility"). UDEC was planned to allow applicants to postpone the start of substantive examination by a maximum of three years.

Deferred examination systems have been available in multiple countries, including all other IP5 Offices. One prominent example is also the German system where an applicant has a period of seven years from the date of filing in which to request examination and pay the examination fee. This has turned out to be attractive for applicants, who would like to make strategic decisions in context of the grant of a patent at a later stage. Such deferred examination even provides advantages for global patent strategies, because some applicants file a German national phase patent application in parallel to a Euro-PCT application and do initially not request examination for the German patent application to see how the European patent application turns out. That is, the German national phase patent application can serve as a sort of "back-up" for the case that the European patent application does not get granted with the desired scope and the applicant can "activate" the German patent application whenever desired within these 7 years. The German patent community has had good experiences with its deferred examination system and has thus been supporting deferred examination at the EPO.
The basic idea of UDEC was that an application, whether EP-direct or Euro-PCT, would proceed as so far up to the payment of the examination fee. Thus, as usual, the (S)EESR would be produced and the applicant would have to file a response to the ESOP. The applicant would also have to pay the examination fee according to the present rules of the EPC.

The new part would have started with the payment of the examination fee by the applicant. At this stage, the applicant could file a request to postpone examination for up to three years. The applicant would have been able to lift the postponement on request. Apart from the examination fee, no other fee would have been required. The new part of UDEC also included the option for a third party to file substantiated, non-anonymous (but with strawman filings being possible), third party observations. The effect of doing so would have been to lift the postponement of the examination of the application. No fee would have been required for lifting the postponement

UDEC was also considered to provide advantages for the EPO. For example, the EPO could avoid the examination of applications in which applicants lost interest during the defer-

ment. The overall expected effect of UDEC was that it could reduce, or at least more evenly distribute, the existing backlog. Moreover, as there were no fees involved in the proposal, the EPO considered that it could have been introduced as a change in practice with no need for a change of any rules.

However, there are also disadvantages for third parties. The period of legal uncertainty would be extended by several years. If third party observations needed to be filed, such as in context of FTOs, to lift the deferment, it may be necessary to carry out costly prior art searches and evaluate the results so that sufficiently substantiated observations can be filed. The EPO held a user consultation for interested parties, including **epi**, at which the proposal for UEDC was discussed. Some parties were overall in favour and some were completely against the proposal. The content of the proposal was changed in response to user comments but maintained to be differed from the three year postponement from filing that the other IP5 Offices offer.

After the user consultation, the proposal for UDEC went to the Committee on Patent Law (CPL), which advises the Administrative Council (AC) on patent law, in the spring of 2018. After a controversial discussion, which mainly went against the proposal, the proposal was not presented to the next meeting of the AC and was not pursued further by the EPO (see also the article about UDEC by Chris Mercer in issue 2/2018 of **epi** Information).

II. New User Consultation

Until now. In November 2018, the EPO has launched a new online user consultation to again assess the interest of the stakeholders in increased flexibility in the timing of the examination process. This online consultation will remain open until **11 January 2019** and can be found here: https://forms.epo.org/law-practice/consultation/ongoing/increased-flexibility-examination-process-form.html.
By this new user consultation, stakeholders can submit their answers to a variety of questions regarding the following topics:

1. Need for more flexibility in the timing of examination
In particular, the EPO would like to know from the users, whether they

- are in favour of a procedural option for postponing examination of a European patent application and, if so, why?
- think that a postponed examination system would benefit the European patent system and why?
- are aware of any examples of economic and business impact of a postponed examination system.
- think that such a system would influence the strategy in filing patent applications or enforcing patents and, if so, how?
- think that a postponed examination system would benefit the public at large?

2. Possible features of a postponed examination system
In particular, the EPO would like to know from the users, whether

- all European and Euro-PCT applications should be eligible for postponed examination.
- any particular given implementation detail of a system of postponement would be considered the most suitable.

3. Third-party activation mechanism
In particular, the EPO would like to know from the users, whether and how third parties should be allowed to trigger the start of examination.

4. Office activation mechanism in a postponed examination scheme
In particular, the EPO would like to know from the users, in which situations the EPO should be allowed to start examination ex officio.

The users are also invited to submit any other suggestions for giving applicants greater control over the speed of the examination process.
All readers of **epi** information are kindly invited to reply to this survey.

III. Office-Driven Examination Control (ODEC)?

Overall, it appears that a careful balancing of the various interests of the applicants, the parties and the EPO could lead to a system of deferred examination at the EPO. On the one hand, it is argued that as long as the EPO continues to provide an EESR including an ESOP and the applicant is obliged to file a response to the ESOP and pay the examination fee, the applicants as well as third parties would have a reasonable basis to estimate what might happen during deferred examination proceedings. On the other hand, it is evident that the argumentation provided by the EPO in the ESOP is not carved in stone and unforeseeable claim amendments can of course be performed by using features from the description, so that there of course remains a certain degree of uncertainty about the outcome of the examination proceedings, which is immanent to deferred examination.
In any case, an increased flexibility for the grant proceedings at the EPO and more means to shape the global patent strategy would increase the need for advice by the profession of European patent attorneys, who should look out for upcoming legal changes in context of deferred examination.
The new user consultation shows that the EPO is planning to make another attempt at implementing deferred examination. As such a potential upcoming system would be proposed by the EPO, the term "Office-Driven Examination Control" (ODEC) was already suggested. It remains to be seen whether the new user consultation will lead to a new initiative by the EPO and whether such a new initiative will have higher chances to be approved by the stakeholders in the various EPC member states as it was the case for UDEC.

Annual Subscription 2019

P. R. Thomsen (CH), Treasurer

In accordance with the decision of **epi** Council C85 on November 10, 2018, the amount for the **epi** annual subscription has been set at 190 EUR for 2019.

The annual subscription for **epi** students was set to be 95 EUR for 2019.

Following the amendment of R. 154(1) EPC that will come into force on January 1, 2019, the deadlines for payments of the annual subscription have been changed to become 1 month shorter compared to 2018 (see my article in **epi** Information 3/2018). Please note that also the sanction for non-payment will remain a deletion from the list of professional representatives. In order to be reachable by the **epi** and the EPO in connection with the annual subscription, keep your address and email data current in the list of professional representatives (https://www.epo.org/applying/online-services/representatives/notes.html).

Invoices regarding the **epi** annual subscription 2019 will be sent by email at the beginning of January 2019.

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Eingangsfrist im **epi**-Sekretariat:

15. Februar 2019

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 **2019** 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 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen werden dem Einzug des **epi**-Beitrags vorgezogen.
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Deadline for receipt by the **epi** Secretariat:

15 February 2019

The Institute of Professional Representatives before the European Patent Office (**epi**) is hereby authorised to debit the **epi** annual subscription for the member named below at the appropriate rate. This direct debit occurs once on 25 February of the current year from the deposit account held with the Eu- ropean Patent Office (EPO) as specified below. This direct debiting mandate applies to the membership fee **2019** and the forthcoming subscriptions until it is revoked in writing.
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L'Institut des mandataires agréés près l'Office européen des brevets (**epi**) est autorisé par la présente à prélever le montant en vigueur de la cotisation annuelle de l'**epi** pour le membre dont le nom figure ci-dessous. La présente autorisation de prélèvement sur le compte ouvert à l'Office européen des brevets (OEB) prend effet une seule fois le 25 février de l'année en cours. Cette autorisation de prélèvement vaut pour la cotisation **2019** ainsi que pour les cotisations suivantes jusqu'à révocation par écrit.
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