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Information

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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Report from the 87th Council Meeting

Cover:
Autumn light
Acrylic and mixed media on boxed canvas.
This picture painted by
Aylsa Williams
(European Patent Attorney GB)
was part of the **epi** Artists
Exhibition 2018 at the EPO, Munich

Aylsa Williams

Aylsa ist eine auf Biotechnologie spezialisierte Vollzeit-Patentanwältin mit Sitz in Hampshire, Großbritannien. Sie ist Biologin und hat einen Kurs über botanische Kunst bei der Society of Botanical Artists besucht, der ihr die Möglichkeit bot, ihre Liebe zur Kunst mit ihrem biologischen Hintergrund zu verbinden. In ihrer Freizeit beschäftigt sich Aylsa mit Aquarellmalerei. Neben der botanischen Kunst interessiert sich Aylsa für Landschaftsmalerei und genießt es, Dinge in der Natur in einem zeitgenössischen Umfeld zu beobachten und zu dokumentieren.

Aylsa is a full time patent attorney specialising in biotechnology and based in Hampshire, UK. She is a biologist and has undertaken a course on botanical art with the Society of Botanical Artists, which offers the possibility to combine her love of art with her biological background. In her spare time Aylsa engages in watercolour painting. As well as botanical art Aylsa is interested in landscape painting and enjoys observing and documenting things in the natural world in a contemporary setting.

Aysla est une mandataire en brevets européens basée dans le compté d'Hampshire au Royaume-Uni. Biologiste de formation, elle a suivi des cours sur l'art botanique à la « Society of Botanical Artists », ce qui lui permet d'associer sa formation technique à sa passion. Aysla s'adonne à la peinture, notamment les aquarelles, et à la gravure, et elle adore observer et documenter les choses du monde naturel dans un cadre contemporain.

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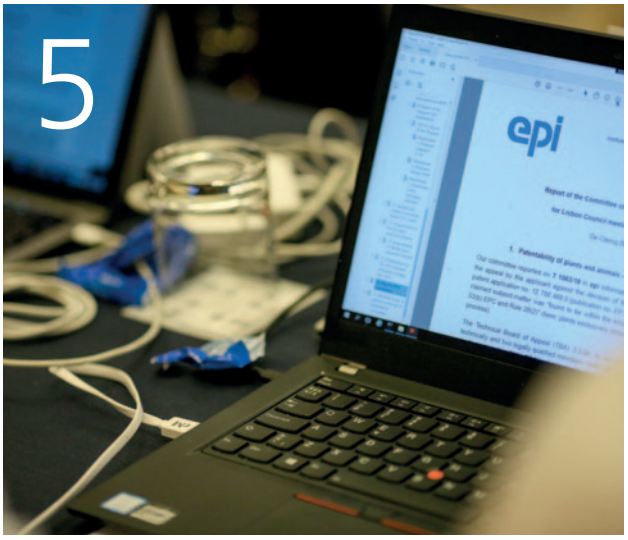

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Trading places

M. Névant (FR), Editorial Committee

Marc Névant

In the 1983 comedy film "Trading places" directed by John Landis[1], the lives of two unwitting people at opposite sides of the social hierarchy are switched as the result of a wager. One is a well-mannered and educated broker and the other is a homeless street hustler. The plot is based on the *nature versus nurture* debate, which involves whether human behavior is determined by the environment, or by a person's genes. In the movie, the environment in which the characters are placed is such that the broker falls off his pedestal (and becomes a thug) while the hustler becomes well-versed in the art of finance.

In a different context I wonder whether a professional representative and an EPO examiner (let alone a member of the Boards of Appeal) could nowadays trade places with equal "success".

When I started in the profession some 25+ years ago it was not uncommon for EPO examiners to be allowed to stay 2 or 3 months within an IP firm as part as the program called "praktika extern". This program still exists but EPO examiners now only spend a couple of weeks "outside their walls". How can an examiner possibly get to grasp with our daily work within such a short period of time? How can an examiner realize that we are often faced with last minute instructions (not always useful) from our clients to reply to a Communication? Likewise professional representatives can under certain conditions spend a couple of weeks within an examining division ("praktika intern") but the value of such internships appears to be limited for similar reasons: how can we possibly realize that an examiner has – give or take – about 2 working days to handle an application from search to grant or refusal?

The value of having well-trained professional representatives has been long recognized by the EPO and **epi**, and the involvement of EPO examiners in the EQE committees speaks highly for it (although we may live to regret that the ratio of EPO examiners to **epi** members in the committees has decreased over the past few years). It is equally important in our view that EPO examiners understand that we are bound by the instructions we receive from our clients which ultimately decide on the scope of protection they seek to obtain. We believe that it would be a beneficial learning experience for both EPO examiners and professional representatives if the former could "live the life" of the latter for a substantial period of time. We can therefore only encourage the EPO management to renew with the old practice of allowing examiners to stay with their "clients" for a couple a months.

On behalf of the Editorial Committee I sincerely wish all our readers a Happy Christmas and a Healthy and Prosperous 2020.

1 „Die Glücksritter" auf Deutsch; « Un fauteuil pour deux » en français

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 **27. Januar 2020**. 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 **27 January 2020**. 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 **27 janvier 2020**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Report from the 87th Council Meeting in Lisbon on 23rd November 2019

M. Névant (FR)

Meeting opening – Adoption of the Agenda

President Leyder opened the meeting at 9 am. Apologies for absence were noted after which the agenda was adopted with slight changes, namely item 10 (report of the internal auditors) was cancelled and item 16-5 (report of By-Laws Committee) was combined with item 13 (amendments of the By-Laws).

Council then observed a minute of silence in memory of Mr Christiansen (DK), a former Council Member (until 2014), and a long-standing member of many committees.

Adoption of the Minutes of the 86th Council Meeting – Matters Arising from Said Minutes

The minutes of the last meeting were approved and the Secretary General informed Council Members that the action points arising from the last meeting (online test voting and opening of threads in the forum re the EBA referrals) had been completed.

Report of the Board

The President referred to his report in the accumulated file, and reminded members that minutes of the Board meetings are available in a dedicated area in the forum (NB: which can be accessed on the **epi** website after login).

Vice-President Kunič Tesović updated Council Members on the implementation of the Workshare platform on the website (a presentation was displayed showing how to use it). The platform will be available to all **epi** members shortly after the Council Meeting.

Report of the Secretary General

The Secretary General referred to his report in the accumulated file. Council then proceeded to elect the following members:

Mr Lars Pallisgaard OLSEN (DK) was elected as a member of the Litigation Committee.

Ms Vasiliki KOSTI (GR) was elected as a member of the Biotech Committee.

Mr Thomas POTT (DE) and Ms Martina STORCK (DE) were respectively elected as full member and substitute member of the Professional Education Committee.

Report from the Treasurer

1) As of mid-October 2019 the budget is in line with what had been planned. Income revenues are slightly higher than expected (because a high number of candidates passed the EQE, generating additional subscription fees), and expenses are under control. The Treasurer indicated that there was accordingly no need to adapt the 2019 budget and the planned deficit of 65 k€, which measure was supported by the **epi**-Finances Committee. This was approved by Council.

2) The Treasurer then provided an update on a number of on-going projects, including:

- **epi** legal status (joint work with By-Laws Committee): a legal opinion has been obtained from a well-recognized expert in international institutional public law, and **epi** documents/contracts will be updated to reflect the Institute's legal status as highlighted in the opinion.
- professional liability insurance (PLI) for members: at present 200+ members benefit from it, discussions regarding the recognition of PLI under national requirements are ongoing in some countries (e.g., UK).
- **epi** insurance policy: Council Members are reminded that health and accident insurance is in principle within the own responsibility of **epi** members who are acting for **epi** (e.g. Committee members). The possibility for members of the Presidium to benefit from special liability insurance is being investigated.

- online voting tool: the system has been successfully tested and was used recently for the vote of the Danish **epi** constituencies regarding whether they should unify.
- **epi** rules on reimbursement of expenses: Council approved amendments of the rules to take better into account business/professional realities and to close some gaps in the present rules (e.g. regarding parking expenses); the new rules will come into force on 1.5.2020 and the aim is to change the present paper-based process to a fully digital process.
- WIPO/WEF Inventor Assistant Program (IAP): this program, supported by **epi** since 2016, aims to assist pre-selected under-resourced inventors from developing countries (so far CO, EC, ZA, PH and MA) by providing pro bono work of European patent attorneys in order to help them obtain patent protection. Recent discussions with WIPO led to the proposal made to **epi** to administer a regional fund which would essentially cover EPO fees and translations costs to support the inventors' expenses.

  A discussion followed during which the Treasurer gave further explanation on the program and how this would impact the Secretariat (FTE-wise). Council then approved the proposal that **epi** would administer the above-mentioned regional fund.

3) The Treasurer finally presented the budget for 2020. Income revenues are expected to increase by about 4% (compared to the planned 2019 budget) while expenses are

expected to increase by about 5% (compared to the planned 2019 budget), resulting in a planned deficit of 90.5 k€. The Treasurer explained in particular that IT expenses will increase next year as a new Document Management system will be implemented. Overall the Treasurer indicated that there was no need to change the amount of the annual subscription fee which he proposed to remain as is (190 € if paid until 1st April, 240 € if paid after 1st April, and 95 € for students).

The budget and the amount of the annual subscription fee for 2020 were approved by Council.

Report of the By-Laws Committee – Amendments of the By-Laws

The Chair of the BLC presented a series of amendment of the By-Laws intended to regulate the decision taken at the previous Council meeting (C86) to appoint an Executive Director to "un-burden" the Secretary General and the Treasurer. The amendments presented concerned articles 10B, 15-17, 18, 18a, 21, 26, 27, 64, 67 as well as transitional provisions. These amendments were approved at a large majority (4 objections and 4 abstentions).

Another amendment concerning article 7.2 (possibility to elect the new Board towards the end of the meeting of the newly elected Council rather than at the beginning) was also approved at a large majority (1 objection).

A decision on other amendments concerning article 4.1 and 4.2 was postponed to the next meeting.

Report of the Electoral Committee

The Chair of the Electoral Committee reported that Denmark voted (via the online tool, which worked very well) to change from non-unitary to unitary constituency. Council was also informed that the nomination process for the next Council election needed to be re-opened in the following constituencies or groups in which fewer people applied as the number of seats available: HR, CY, CZ, DK, EE, FI, HU, MT, NO, SK, SI, ES, TR, GB.

Various Committee Reports/Miscellaneous

1) The Chair of the European Patent Practice Committee (EPPC) reported that WIPO will for the time being retain facsimile transmission as a backup filing means.

2) The Chair of the Litigation Committee informed Council that the chief judge in charge of the constitutional complaint against the UPC in Germany had given an interview in which he was quoted to say that a decision on the complaint could be issued in the 1st quarter of 2020.

3) The Chair of the Professional Education Committee presented a proposal to amend Rules 11-14 of the IPREE (Implementing provisions to the Regulation on the European Qualifying Examination). The main aim of the proposal is:

- on the one hand, to allow aggregation of qualifications (e.g., bachelor + master degrees) to reach the 80% technical content (of the courses followed) required by Rule 11(2);

- on the other hand, to somehow "soften" the requirements set forth in Rule 14 (evidence needed to establish knowledge equivalent to that required by Rules 11-13).

4) Vice-President Vogelsang-Wenke proposed to set up a working group to establish a new Committee, namely the IP Commercialisation Committee (IPCC) which would *inter alia* tackle the following issues: IP valuation and monetarization, portfolio optimization, assignment of IP rights, licensing matters, notably in cooperation with other organizations such as LESI, FICPI, AIPLA. This proposal was unanimously approved by Council.

Meeting with Mr Campinos

A large part of the afternoon was devoted to a speech given by the President of the EPO, Mr António Campinos, followed by a Q&A session.

Mr Campinos addressed Council to present the Strategic Plan that was voted by the Administration Council of the EPOrg earlier this year, plan which comprises 5 goals, namely:

- build an engaged, knowledgeable and collaborative organisation
- simplify and modernise EPO IT systems
- deliver high-quality products and services efficiently
- build a European patent system and network with a global impact
- secure long-term sustainability.

Mr Campinos stressed that while many changes occurred since the EPO was created, there is one constant over the years which is the relationship with the **epi**, "EPO's closest partner". Mr Campinos pointed out though that it is not enough to look back, because our patent system has to evolve and so has our collaboration.

Mr Campinos noted that there is a need for a high level of quality, which is the bedrock of the patent system, and that this needs to be nurtured by the users of the system. High quality starts with quality drafts, but there must be a common understanding (between EPO and its users notably **epi**) of what high quality means. High quality also supposes that the EPO masters the prior art, which requires cutting edge IT tools but also that the number of samples for quality control increases (control will include formalities and opposition). In this respect, Mr Campinos pointed out that **epi**'s input, via SACEPO, is most valuable.

Mr Campinos also mentioned that we (i.e. EPO and **epi**) have to address the anticipated loss of patent attorneys in some member states due to the simple fact of demographics.

During the Q&A session, Mr Campinos suggested that enhanced cooperation between EPO and **epi** could be contemplated e.g. in the following areas:

- claim drafting
- certification of paralegals
- promotion of IP in universities.

Closing of meeting

Council thanked the Portuguese delegation members with acclamation for their efforts in organising a very successful meeting. The President then closed the meeting at 5:00 pm.

epi's letter to the EPO „Request for Referral to the Enlarged Board of Appeal – Selection Inventions" and the Corresponding Response Letter of the EPO

As reflected by the articles of Derk Visser (pages 27-33) and Roel van Woudenberg (pages 34-39), there have recently been discussions in our profession about the novelty of selected sub-ranges, in particular regarding purposive selection. Our Institute has recently written to the President of the EPO, requesting him to refer this question to the Enlarged Board of Appeal. **epi**'s letter and the EPO's response declining to proceed are reproduced below. Should our readers be involved in an appeal involving the selection of a continuous sub-range, they may wish to request a referral of this question under Article 112(1)(a) EPC as being a point of law of fundamental importance.

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Mr Ernst vp5@epo.org
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17th October 2019

Dear Mr Campinos,

Re: Request for referral to the Enlarged Board of Appeal – Selection Inventions

This letter is sent on behalf of the Institute of Professional Representatives before the European Patent Office (**epi**). **epi** presently has about 12,300 members spread across the 38 member states of the EPC. Its members work mainly in industry or private practice and represent the vast majority of applicants, proprietors and opponents in proceedings before the EPO.

epi requests that you refer a question to the Enlarged Board of Appeal under Article 112(1)(b) EPC. The reasons for this request are set out below.

It has come to the attention of **epi** that there is a clear divergence in the case law of the Boards of Appeal with respect to the treatment of novelty with respect to selection inventions. This is most clearly illustrated with respect to the selection of a sub-range from within a range disclosed in the prior art. For instance, a prior art document, which we will call D1, discloses a composition comprising component X wherein component X comprises from 10 to 90% by weight of the composition. A later patent application claims a composition which comprises from 30 to 40% by weight of component X but which in all

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other respects is identical to the composition disclosed in D1. In such circumstances, it is necessary to consider whether the claim lacks novelty over the disclosure in D1.

This question has been addressed in the case law of the Boards of Appeal and the leading case was T 198/84. The principles established by T 198/84 were summarised in T 279/89. This case has been followed by numerous subsequent decisions. This was referred to in the 8th Edition of the Case Law Book. According to T 279/89, there was a three-fold test to determine whether the selection of a sub-range was novel. For there to be novelty, it had to be proved that:

(a) the selected sub-range is narrow compared to the broad range of the prior art;

(b) the selected sub-range is sufficiently far removed from the point values within the broad range specified in the examples; and

(c) the selected sub-range is not be an arbitrary selection from the prior art but is another invention, i.e. the selection is purposive.

There have recently been a number of cases where the Board has decided that criterion (c) is not a matter to be taken into account when considering novelty. These cases have held that criterion (c) relates to inventive step, not novelty. A recent case which took this view is T 0261/15 and other decisions which follow this line include T 1233/05, T 1131/06, T 230/07, T1130/09, T 2041/09, T492/10, T 1948/10, T 423/12, T 378/12 and T 1404/14.

However, this line is not universally accepted. For instance, T66/12 and T 673/12, which were decided after many of the decisions referred to in the previous paragraph, still regard criterion (c) as part of the test for novelty.

It is clear from the above that there are clearly two incompatible lines of Board of Appeal decisions as to what are the criteria to be used in deciding whether a sub-range is novel.

The fact that there are two lines is clearly shown by the 9th Edition of the Case Law Book, which sets out the two lines but fails to indicate which is the correct line.

This is also illustrated by developments in the Guidelines. In the November 2018 version of the Guidelines (G-VI, 8(ii)), all three criteria are referred to. However, in the November 2019 version of the Guidelines, the reference to the three criteria has been removed, despite the fact that there is no clear basis from the decisions of the Boards of Appeal for this deletion.

There is lack of clarity about the criteria to be used in assessing the novelty of a sub-range. There is a distinct possibility that a claim might be refused by the first instance for lack of novelty, because the first instance took into account all three criteria, but held to be

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novel by a Board following the line that criterion (c) does not need to be considered for novelty. The alternative possibility, that the first instance finds the claim to be novel but a Board overturns this finding by relying on criterion (c), could also occur. This lack of clarity is detrimental to users of the EPO.

This lack of clarity is particularly relevant where there is a novelty-only citation, for instance a co-pending European patent application under Article 54(3) EPC. In such cases, Article 56 EPC (inventive step) is not to be considered. However, if criterion (c) is applied, then it may be argued that matters relating to inventive step are being taken into account.

In the circumstances outlined above, where there are two clearly diverging lines of decisions from the Boards of Appeal regarding the assessment of novelty as regards sub-ranges, it is **epi**'s view that the President of the Office should refer a question to the Enlarged Board of Appeal under Article 112(1)(b) EPC.

epi suggests that the question should be:

> "What are the criteria to be used in assessing the novelty of a claim where the allegedly distinguishing feature of the claim relative to a prior art document is a sub-range of a broader range disclosed in that prior art document."

epi appreciates that you may wish to formulate the question in a different way and would be pleased to discuss the way in which to formulate the question if this would be of assistance.

It is also possible that a subsidiary question could be included in the reference. This could be in the form:

> "If any one of the criteria is not relevant for novelty, how do(es) that(those) criterion(criteria) relate to inventive step?"

If **epi** can be of any further assistance, please let us know.

Yours sincerely

Francis Leyder
President

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Re: Your letter of 17 October 2019 on selection inventions

25. 11. 19

Dear Mr Leyder,

Thank you for your letter addressed to the President of the EPO concerning the developments in the case law on the criteria to be applied for the assessment of novelty of selection inventions, in particular in the case of inventions directed to a subrange selected from numerical prior art ranges. The President has asked me to answer on his behalf, having taken note of epi's wish that the matter is referred to the Enlarged Board of Appeal.

The EPO has been closely monitoring and assessing the case law on selection inventions during the last years. As you point out, the decisions of the Boards go in two directions: those following the findings of the early decisions T 198/84 and T 279/89, which set out a three-part test to assess novelty of the selection of sub-ranges; and those which, following decision T 1131/06, of 28 January 2008, partially depart from that approach. The latter line of case law refers the assessment of the third criterion, namely that the selected sub-range is not an arbitrary selection from the prior art, but another invention ("purposive selection"), to the assessment of inventive step.

Presently, a clear trend towards abandoning the assessment of the third criterion as part of the novelty assessment can be identified. In particular, the Technical Board 3.2.08 shifted to the new approach in its decision T 261/15, of 7 February 2018, after having already expressed its doubts in T 1634/13, or 25 April 2017. This technical board is the one having most consistently maintained the earlier approach during the last 10 years (including the cited decision T 673/12, but also T 875/07, of 14 January 2009; T 1281/07, of 13 April 2010; T 1999/11, of 18 February 2014; T 1409/12, of 10 July 2014; T 100/12, of 5 August 2014; and T 1895/12, of 18 August 2015). All other technical boards usually dealing with this type of invention, like *inter alia* 3.3.10, 3.2.06 or 3.3.05, had already adopted the new approach for some time.

This trend is thus seen as a development of the case law, rather than a contradiction. The fact that some decisions, such as T 673/12, of 10 March 2014, and T 66/12, of 9 November 2016, may have still applied the early approach does not detract from that conclusion. Developments in the case law are a normal part of judicial activity and usually take place over a certain period of time, during which there may be decisions going in different

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directions. In the opinion of the Enlarged Board of Appeal, this is a normal part of the application and development of the law, which does not always develop in a linear fashion (G 3/08, reasons No. 7.3.1 and 7.3.6). Shifts of this kind, when identified as such, establish for the Office as patent granting authority that the EPC is to be interpreted according to the Boards' latest findings. This may entail altering the Examination Guidelines, but not having the case law reviewed by the Enlarged Board (G 3/08, reasons No. 7.3.5).

With the adaptation of the Guidelines for Examination (G-VI, 8), clarity has been established on how the EPO departments are to assess novelty of such inventions.

In any event, we wish to assure you that the Office continues to closely monitor any further development in the case law.

I would like to thank you for your contribution.

Yours sincerely,

Heli Pihlajamaa

2/2

The IP Office of the Czech Republic celebrates its 100 years

Prague, 19 September 2019

F. Leyder (BE)*

The Industrial Property Office of the Czech Republic (the Office) was established 100 years ago, in the wake of the independence of Czechoslovakia in October 1918. To celebrate this, the Office organised an International Conference on Protection of Industrial Property In Europe.

My welcome package contained a decorated gingerbread from Pardubice, a Czech city famous for gingerbread production that was awarded a "protected geographical indication" in 2008, and a publication "Vědci, vynálezci a podnikatelé v českých zemích".
After a short welcome by the Master of Ceremonies, the event started with a small humoristic film showing actors dressed in 19th century fashion, featuring an inventor arriving at the patent office after Bell or Edison. Czech colleagues later told us that this was a scene from a film featuring Jára Cimrman, a fictional character presented as a universal genius who became immensely popular in Czechoslovakia: https://www.youtube.com/watch?v=wo-F2HH4Fwg (English subtitles available)

In his Opening Statement, Mr. Kratochvíl, President of the Office, mentioned the document "Innovation Strategy of the Czech Republic 2019–2030", which the R&D Council headed by the Prime Minister prepared, and the introduction of a new brand "Czech Republic: The Country For The Future".

A first panel discussed today's challenges for IP Rights Protection in the Czech Republic.

Mr. Fusek, Deputy Director for Strategic Development, Institute of Organic Chemistry and Biochemistry of the Czech Academy of Sciences, explained the challenges that universities face for extracting value from their inventions, supported by English language slides. His institute files about 10 applications per year, from which result about 8 patent families, and has granted 10 licences with an annual income of about 60 million €.

Mr. Havlík, President of the Czech National Group of AIPPI, explained the challenges relating to the modernisation of trademark law with the support of Czech language slides, showing examples of the new types of trademarks.

Mr. Dobřichovský, Director of the Institute of Copyright, Industrial Property and Competition Law, Law Faculty of Charles University, led us through challenges facing the protection and licensing of other intellectual rights, he compared different legal aspects of copyright and industrial property rights.

After the panel discussion, Mr. Ménière, Chief Economist of the EPO, took the floor for the first presentation on "Patents and the European Economy" (in English). He first explained the dual role of patents. He then presented the importance of IPR-intensive industries in the EU, highlighting the good performance of the Czech Republic. According to him, most of a country's productivity gains is due to international technology transfers.

A coffee break followed.

Mr. Wunsch-Vincent, Co-Editor of the Global Innovation Index, Head of Section in the Economics and Statistics Division of WIPO, presented the Global Innovation Index. His presentation "The Shifting Global Innovation Landscape and the Czech Republic" highlighted how well the Czech Republic is doing.

The second panel featured "IP Education and Awareness Raising".

Mr. Maier, Director of the EU Observatory on Infringements of IP Rights at the EUIPO, presented the problem. 97% of Europeans believe that inventors and creators need to be rewarded, but especially youngsters challenge this, downloading illegally and buying counterfeits. The EU developed "Key competences for lifelong learning" (recommendation, 22 May 2018) linked to IP. The EUIPO has received missions in this regard. It developed the concept of an IP Day at school. His conclusion: there is light at the end of the tunnel.

1 Acknowledgement: this paper could not have been finalised without the kind support and editorial assistance of Petra Fousková, **epi** student in the Czech Republic.

Mr. Bradley, Head of the Academic Institutions and Executive Program at the WIPO Academy, presented the Academy and its missions globally.

Mr. Flammer, Principal Director Patent Information and European Patent Academy at the EPO, presented the objectives of the Academy. These include ensuring that there are enough professionals in all countries, training the paralegals. He also mentioned the cooperation with national offices in the area of patent information, including the recent revamp of PatLib centres.

Ms. Engelová Pavková, Head of the Industrial Property Training Institute of the Office, introduced her presentation with a reminder that this Institute had been founded in 1963. She then proceeded to present the activities of her Institute.

The moderator asked what in the view of the panellists is the biggest challenge for reaching the younger. Mr Bradley said it was catching their attention first. For Mr Flammer, it was selecting the right channel, and convincing them they are in IP when they use modern tools.

Just before the lunch break, the Surprise of the Day was a short (Mercedes Benz) film about 1888 Bertha Benz historic trip of 106 km by car from Mannheim to Pforzheim.
https://www.youtube.com/watch?v=vsGrFYD5Nfs

This was followed by another Mercedes Benz film showing an autonomous car.
https://www.youtube.com/watch?v=AihC5flC-38

At lunch, I had the honour of being seated next to the Master of Ceremonies, Ms. Hergetová, who is a famous Czech journalist with economic and civil engineering background.

The afternoon session started with a Congratulatory Speech of the Minister of Finances, followed by a presentation of the "Innovation Strategy of the Czech Republic 2019–2030", by the Deputy Minister of Industry.

Mr Campinos, President of the EPO, first mentioned the 17.5% increase in EP applications from Czech inventors last year and reminded the audience of Czech inventors nominated at recent European Inventor Awards Events. He then presented the EPO Strategic Plan 2023, in particular emphasising quality, timeliness, and flexible examination.

Mr Archambeau , Executive Director of the EUIPO, presented a main outline of the upcoming EUIPO's Strategic Plan 2025.

Mr. Gurry, Director General of WIPO, was meant to present "Today's IP Challenges of the World" but his plane landed late, and he was announced to speak during the gala dinner.

Thus, Mr Kratochvíl delivered the closing remarks early, and the conference ended with a round of applause.

During the conference, there was an exhibition of student inventions and ideas in the next room. This had allowed the Minister of Finances to mention that she is not worried about the future of Czech inventiveness.

A gala evening was held in the Spanish Hall of Prague Castle, one of the most exquisite places, normally not ordinarily open to the public.

The Master of Ceremonies opened the event at 19:19 (of course), explaining that the hall got its name from being built above the stables of noble Spanish horses by Emperor Rudolf II from 1602 to 1606 to store his art collection.

The stage was decorated with four "living statues" as can be seen in the streets of Prague, Nobel, Bell, Einstein and Edison (a reminder of the clip that opened the Conference).

The official part started with the Deputy Prime Minister and Minister of Industry handing diplomas and awards of Bohemian crystal to Messrs Gurry, Campinos and Archambeau.

When on stage, Mr Gurry reminded the audience that it was also 100 years ago that Czechoslovakia ratified the Paris Convention, and 100 years ago that the League of Nations was created, mentioning the role of the country's first president, Tomáš Garrigue Masaryk.

Diplomas and awards were presented to numerous scientists, inventors or people active in the field of intellectual property, for example to Antonín Holý (in memoriam), who invented important antiretroviral drugs used in the treatment of HIV, or to microbiologist Blanka Říhová, specialist in immuno-oncotherapy. Our colleague František Kania, Chairman of the Chamber of Patent Attorneys of the Czech Republic, was also presented an award.

Mr Gurry presented the WIPO Gold Medal for Creativity to a former President of the Czech Office, Ladislav Jakl.

The Prague Cello Quartet provided musical interludes with their adaptations of well-known classical compositions, starting with 'Humoreska' by Czech composer Antonín Dvořák.

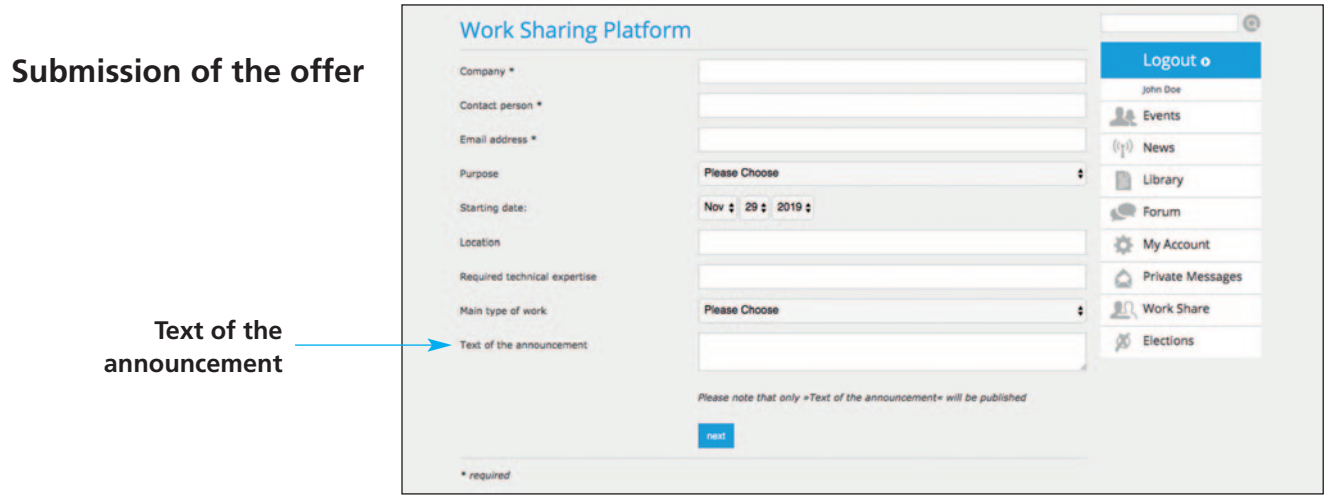
Mr Kratochvíl thanked everyone, presented flowers to the Master of Ceremonies, and the Prague Cello Quartet closed the official part by playing 'Vltava' (The Moldau), the famous symphonic poem by the Czech composer Bedřich Smetana. The guests could then enjoy Czech cuisine with excellent local wines.

“Work Share” platform

Dr. B. Kunič Tešović (SI)

As announced in the previous issue of **epi** Information, **epi** introduced a ‘Work Share’ platform with the purpose of enabling enhanced cooperation between the **epi** members.
The aim of the platform is to facilitate the interactive cooperation between European Patent Attorneys who are interested in work exchange. The offers for work sharing can be placed in the form of announcements.
To access the platform you need to login and click on 'Work Share' as shown below:

When you decide for an announcement, please click the 'Submission of the offer' and enter the requested information. Please note that only the text of the announcement will be published. All other data will be kept confidential by the **epi** Secretariat.



If you are interested in the offer, please press 'Contact' and inform the **epi** Secretariat accordingly.
With the introduction of the platform, **epi** establishes a possibility to communicate the requests for exchange of work similar to some national associations, e.g. the established ‚Kollegenarbeit‘ announcements in the journal of the Patentanwaltskammer.
As mentioned before, the platform can be used in various situations. It can be used for example when lacking capacity in different technical or scientific fields, to absorb additional work when needed, or to provide attorney work-related coaching or mentoring to colleagues who have recently passed the EQE.
We welcome you to start using the platform and hope you will benefit from it!

Patent practice

Report on "WIPO Conversation on Intellectual Property and Artificial Intelligence" on 27 September 2019 in Geneva

M. M. Fischer (DE)

Artificial Intelligence (AI) is fast becoming part of our everyday lives, changing how we work, shop, travel and interact with each other. Yet we are only at the beginning of discovering the many ways in which AI will have an impact on – and indeed challenge – business, society and culture. Also, the field of IP will be heavily affected by AI, and not only in the way that patents will be granted on inventions in the field of AI, but also in the way that AI will be (or already is) able to create inventions itself. Who will own such an invention? Moreover, AI is already used in patent offices around the world to search for prior art and to translate patent literature. AI also poses new questions in the field of data protection and copyright. Hence, the relationship between AI and IP is multi-faceted and it is high time to discuss all the issues arising in a comprehensive way, on a global level and with all stakeholders involved. That is why WIPO organized a conference on this topic and invited delegations from its member states, people from industry, academia and other organizations, such as lobbying and professional organizations as well as industry associations. **epi** was also invited and sent a delegation of three European Patent Attorneys, Matteo Pes (IT), Marjut Honkasalo (FI) and Michael M. Fischer (DE) from **epi**`s ICT Subcommittee. The conference was attended by approximately 350 participants and also webcast to reach an even larger audience. Video summaries of the conference are available on WIPO`s webpage and are linked in the following.

Mr. Francis Gurry, Director General, WIPO opened the conference by welcoming the panelists and the audience. He gave a short overview of the conference's programme and explained that AI is raising a broad and multi-disciplinary range of policy questions. One of those questions is property and intellectual property. A video of the opening statement can be found here[1].

The conference was divided into six one-hour panels:

The first panel, **Opening Panel**, discussed what impact AI has on the IP System and IP Policy. The panelists were Mr. Andei Iancu (Under Secretary of Commerce for IP and Director of the USPTO), Ms. Nuria Oliver (Data-Pop Alliance), Ms. Karin Meyer Rubinstein (Israel Advanced Technology Industries), and Mr. Zeng Zhihua (China National Intellectual Property Administration). The panel was moderated by Mr. Francis Gurry and the panelists discussed AI`s impact on innovation, commercial markets and industry. Other questions that were discussed: What IP-related issues doe we have regarding AI`s rise? Will AI change IP traditional concepts? Why? What needs to be done in the IP area to support AI innovation? What impact does AI have on IP Offices? It is worthwhile mentioning that Andrei Iancu explained that the USPTO is interested in gathering information on patent-related issues regarding artificial intelligence inventions for purposes of evaluating whether further examination guidance is needed to promote the reliability and predictability of patenting artificial intelligence inventions. To assist in gathering this information, the USPTO is publishing 12 questions on artificial intelligence inventions to obtain written comments from the public. The questions can be found here[2]. Answers from the public (also from readers of this article!) can be sent to aipartnership@uspto.gov (original deadline has been extended to November 8, 2019 and will possibly further be extended). A video summary of the main statements of the Opening Panel can be found here[1].

The second panel, **Patent Panel**, discussed the many-faceted relationship between AI and patents and was moderated by Mr. Marco Aleman from WIPO. All panelists were representatives from industry, namely Ms. Belinda Gascoyne (IBM), Mr. Zhixiang Liang (Baidu), Mr. Toshimoto Mitomo (Sony) and Beat Weibel (Siemens). From an **epi** perspective, this panel was naturally the most interesting one. The discussion touched upon the referral G1/19 which deals with computer-implemented simulations but may have a farther reaching effect on AI-related inventions since AI can be interpreted as a simulation of the human brain. Although computer-implemented simulations of technical systems have been considered to be patentable in the past by the EPO, "things are up in the air again" because of this referral. It was discussed that inventions nowadays are already made by AI systems. As an example, a chassis for a car developed by AI of Siemens was shown where human engineers have difficulties in explaining why the AI came up with this particular construction. When an AI system makes an invention, the question arises who should be named as the inventor. So far, three solutions have been discussed: First, one could pretend that the inventor is the natural person under whose supervision the AI system made the invention. Second one could nominate the AI system as the inventor (but machines do not have any rights in most jurisdictions and do not care whether they are rewarded for their invention) or third one could name the legal person (i.e. the company in which the invention was made) as the inventor (i.e. expansion of the inventor term from a natural person to a legal person). Indicating the "wrong" inventor can have severe consequences in many jurisdictions. For example, in the USA, this could be considered as a fraud to the patent office and as a consequence the patent becomes unenforceable. Other questions which were discussed: Who should be considered liable if an AI system infringes a patent? Do we need other patentability criteria if an invention is made using an AI system? For example, who should be considered as the skilled person? Are the patent systems fast enough to respond to the speed of innovation in the AI field? Examination Guidelines of IPOs; are they coherent, or is there a need for international convergence? A video summary of the main statements of the Patent Panel can be found here[1].

The third panel, **Governance and Development Panel**, dealt with the socio-economic and ethical impacts of AI on the IP System. After lunch break, WIPO Secretariat gave a presentation on WIPO AI tools and showed video messages on IP and AI, some of which can be found here[1].

The fourth panel, **Copyright Panel**, discussed the question whether AI will change human creativity and its protection as Copyright and Related Rights.

The fifth panel, **Data Panel**, discussed the relationship between Data Policy and AI.

The sixth panel, **IPO Administration Panel**, debated on the question what the impact of AI on examination of IP applications is.

Mr. Francis Gurry closed the conference by thanking all panelists and the audience for their attendance and contribution. He explained that this conference, which was intendedly quite general and high-level, conforms the basis of a more detailed and structured discussion. WIPO will issue a list of questions by November 2019 and invite everyone for comments by the end of the year, which will be an opportunity for **epi** to participate in the discussion and provide further input. Based on this, a second open discussion is planned for April/May 2020.

1 https://patentepi.org/r/info-1904-01
2 https://patentepi.org/r/info-1904-02

„Aufgabe – Lösung“ unter einem Fragezeichen

S. V. Kulhavy (CH)

Das Junktim „Aufgabe-Lösung“ scheint im EPA eines der Hauptinstrumente zur Ermittlung der Tatsache zu sein, ob eine gewerblich anwendbare und neue Lösung auf einer erfinderischen Tätigkeit beruht oder nicht (Art. 56 EPÜ). Bei der Bindung zwischen den Ausdrücken „Aufgabe“ und „Lösung“ dieses Junktims kann sich, nach diesseitiger Ansicht, nur die Frage stellen, ob die genannte Aufgabe durch die definierte Lösung gelöst werden kann oder nicht. Die Voraussetzung sine qua non dafür, dass eine Erfindung vorliegt, ist die Tatsache, dass die Lösung die genannte Aufgabe löst. Wenn man die gerade genannte Einschränkung des Junktims zwischen den Ausdrücken „Aufgabe“ und „Lösung“ akzeptiert, dann muss man sich fragen, wie man in einer sonstigen Weise ermitteln könnte, ob eine gewerblich anwendbare und neue Lösung auf einer erfinderischen Tätigkeit beruht oder nicht?

Wenn man eine andere Methode zur genannten Unterscheidung finden will, dann braucht man nur eine Stufe tiefer unter das Junktim „Aufgabe-Lösung“ herabzusteigen. Die geprüfte Lösung ist in einem Patentanspruch definiert. Befassen wir uns vorläufig nur mit dem zweiteiligen Patentanspruch. Im kennzeichnenden Teil dieses Patentanspruchs ist die Differenz der geprüften Lösung gegenüber dem Inhalt des nächstliegenden Dokuments des Standes der Technik definiert. Diese Differenz gilt als die kausale Ursache dafür, dass die in den Unterlagen genannte Aufgabe gelöst werden kann. Nennen wir diese Differenz daher technisches Mittel, das zur Lösung einer Aufgabe bestimmt ist.

Das technische Mittel kann die Aufgabe deswegen lösen, weil es die dazu erforderliche technische Wirkungsfähigkeit aufweist. Wir befinden uns auf der Gebiet der Kausalität! Die Wirkungsfähigkeit konnte den Fachmann dazu *motivieren*, das technische Mittel zur Lösung der gegebenen Aufgabe zu verwenden, falls diese Wirkungsfähigkeit beim lösungsgemäss verwendeten technischen Mittel bereits bekannt war. Eine solche Lösung, obwohl sie gewerblich anwendbar und neu ist, ergab sich für den Fachmann *in naheliegender* Weise aus dem Stand der Technik (Art. 56 EPÜ). Dies deswegen, weil das Bekanntsein der Wirkungsfähigkeit bei einem bekannten technischen Mittel den Fachmann zur lösungsgemässen Anwendung eines solchen Mittels *geführt* hat.

Andererseits gibt es Lösungen von Aufgaben, die gelöst werden konnten, obwohl kein technisches Mittel zum relevanten Stand der Technik gehörte, bei dem es bekannt war, dass es die zur Lösung der Aufgabe erforderliche Wirkungsfähigkeit aufweist. Diese Situation ist in zwei grundsätzlichen Fällen möglich. Im ersten dieser Fälle gab es das lösungsgemäss verwendete technische Mittel noch nicht. Im zweiten der grundsätzlichen Fälle ist die lösungsgemäss erforderliche Wirkungsfähigkeit bei einem bereits bekannten technischen Mittel erst entdeckt worden. In den erst genannten Fällen liegt eine Kombinationserfindung vor. In den auf der zweiten Stelle genannten Fällen liegt eine Erfindung vom Typ Verwendung vor.

In Opposition zu diesen zwei gerade genannten Fällen liegt die Situation, die hier zunächst dargelegt wurde, nämlich, die nicht patentwürdige naheliegende Lösung. Die naheliegenden Lösungen bilden eine *Alternative* zu den nicht naheliegenden Lösungen – Art. 56 EPÜ! Wenn es umständlich ist, eine Definition der nicht naheliegenden Lösungen zu finden, dann kann man die Definition einer naheliegenden Lösung aufstellen. Dies deswegen, weil die Struktur der naheliegenden Lösungen wesentlich einfacher ist als die Struktur der Erfindungen. Diese Definition lautet wie folgt:

> *„Eine gewerblich anwendbare und neue Lösung ergab sich in naheliegender Weise aus dem Stand der Technik, wenn ein bekanntes technisches Mittel aufgrund der bei diesem Mittel bekannten Wirkungsfähigkeit* neu *verwendet wurde.“*

Die Anwendung dieser Definition erfolgt in folgender Weise. Man untersucht, ob die geprüfte Lösung, bei der es bereits feststeht, dass sie gewerblich anwendbar und neu ist, unter die Definition einer naheliegenden Lösung fällt oder nicht. Wenn nicht, dann gilt die geprüfte Lösung, bei der es bereits feststeht, dass sie gewerblich anwendbar und neu ist, als Erfindung. Wenn es sich während der Prüfung eines Falles herausstellt, dass die Differenz, d. h. der Inhalt des kennzeichnenden Teiles eines zweiteiligen Patentanspruchs, d. h. das lösungsgemäss verwendete technische Mittel als neu gilt, dann nimmt man es an, dass keines der Mittel des Standes der Technik in der Lage war, die Aufgabe so zu lösen wie das neue technische Mittel. Es handelt sich um eine Erfindung, nämlich um eine Kombinationserfindung. Wenn die geprüfte Lösung in einem Verwendungsanspruch definiert ist, dann geht man ebenfalls davon aus, dass keines der Mittel des Standes der Technik in der Lage war, die Aufgabe so zu lösen wie das im Verwen-

dungsanspruch definierte technische Mittel. Auch in solchen Fällen handelt es sich um eine Erfindung.

Wenn eine gewerblich anwendbare und neue Lösung unter die Definition einer naheliegenden Lösung *nicht fällt*, d. h. wenn sie über diese Definition hinausgeht, dann stellt diese Lösung eine Erfindung dar. Dabei spielt es keine Rolle, ob es sich um eine Kombinationserfindung, An- bzw. Verwendungserfindung, Auswahlerfindung usw. handelt.

Der Schwerpunkt dieser Prüfungsweise der Erfindungen liegt bei der Frage, ob die geprüfte Lösung naheliegend war oder nicht. Dies mag zunächst als ein Widerspruch erscheinen, weil es bei der Prüfung um Erfindungen und nicht um naheliegende Lösungen geht. Eine der wohl wichtigsten Aufgaben der Patentämter ist zu verhindern, dass naheliegende Lösungen patentiert werden. Diese Aufgabe können die Patentämter am einfachsten erfüllen, wenn sie genau wissen, welches die naheliegenden Lösungen sind. Dies zeigt den Patentämtern die Definition einer naheliegenden Lösung.

Diese Art und Weise der Prüfung von Erfindungen ist im Buch von S. Kulhavy „Erfindungs- und Patenlehre", Carl Heymanns Verlag, Köln 2010, anhand zahlreicher Beispiele im Einzelnen erläutert.

Translators at Oral Proceedings

C. Mercer (GB)

The EPO is obliged, at our request, to provide translators for opposition oral proceedings or a subsequent appeal oral proceedings. At a minimum, this requires two translators. At the maximum, for a multi-opponent case, it needs twelve translators. The translators are of high quality and are employed for a minimum of a whole day. Thus, the cost of providing translators is high and, ultimately, the cost is met by applicants, proprietors and opponents via the payment of official fees.

However, quite often, the translators are not used. Every year, around 750 interpreting days are cancelled at short notice. In opposition proceedings, this can happen for various reasons, e.g.: the oral proceedings are cancelled due to withdrawal of the patent, the opposition or the request for oral proceedings; the oral proceedings are postponed due to late submissions; or the party who requested interpreting does not attend the oral proceedings or decides not to use the translators, for instance because of a change to a representative having better language skills. Only in rare cases can the interpreters be rebooked for other tasks.

Sometimes, the party does not inform the EPO that the translators are not required. Sometimes, the party does tell the EPO, but too late for the EPO to cancel the contract with the translators. These are contrary to Article 6 of **epi**'s Code of Conduct. In such cases, the EPO has to incur substantial expenses to no purpose. This can be avoided if the party informs the EPO as soon as possible if it no longer needs translators. This does not mean that the party has to withdraw its request for oral proceedings. The oral proceedings can go ahead, but just without the need for the translators.

We, as responsible representatives, should think carefully about requesting translators in the first place. If we can represent our clients effectively without translation, then we should not request translation. If we have requested translation but circumstances change, such as a change in representative, we should consider whether translation is still required. If it is no longer required, we should inform the EPO as soon as possible.


Chris Mercer

In particular, when we receive a summons to oral proceedings, we should consider whether we really need translation at all and, when we respond to a summons, we should reconsider our need, or otherwise, for translation and inform the EPO of our decision. If possible, we should inform the EPO well before the Rule 116 deadline or any deadline set by a Board. It would be very useful to the EPO if we were to ensure that we had made a decision on translation and informed the EPO at least two months before the date for the oral proceedings.

It is possible for the EPO to appoint translators at relatively short notice. Thus, it is better to tell the EPO that you will not need translation and then change your mind rather than routinely telling the EPO you will need translation and then not using it.

It is good for our clients to avoid causing the EPO to waste money by arranging for translators who are not used as this adds to the costs of the EPO, which must be met by the payment of official fees. Therefore, please consider at every stage whether you really need translators and inform the EPO as soon as possible if translators are not required.

Highlights aus der chinesischen IP-Welt 2019

P. Rosenich (LI)

China hat ein extrem junges IP-System. Erst in den achtziger Jahren des letzten Jahrhunderts wurden Patentgesetze und Markengesetze eingeführt. Im Unterschied dazu existieren in der westlichen Welt bereits seit dem Mittelalter – jedenfalls aber seit über zweihundert Jahren – Patentgesetze.

Chinesische Patentanwälte

Es gibt heute in China über 2.000 registrierte Patentanwaltskanzleien. Diese beherbergen über 14.000 geprüfte Patentanwälte. Im Schnitt wären das 7 Patentanwälte pro Kanzlei, tatsächlich dominieren jedoch Großkanzleien das chinesische IP-Wesen. Hier gibt es einen deutlichen Unterschied zu Europa.

Paul Rosenich

Im Vergleich zu Europa, wo es etwa 12.500 europäische Patentvertreter für das gesamte Territorium gibt und zusätzlich noch eine wenigstens gleich grosse Anzahl von nationalen Patentanwälten tätig sind, sind in China relativ weniger Patentanwälte für ein vergleichsweise wesentlich grösseres Territorium tätig.

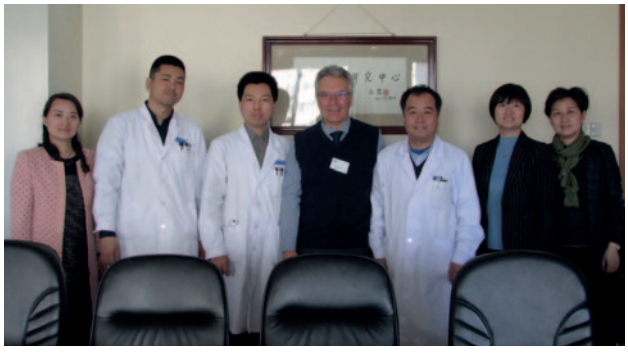
Produktivität der Patentanwaltsleistungen

Ca. 300.000 europäischen Patentanmeldungen/Jahr stehen weit über 1.500.000 chinesische Patentanmeldungen/Jahr und nochmals etwa die gleiche Anzahl an chinesischen Gebrauchmusteranmeldungen gegenüber.
Das bedeutet aber auch, dass in China relativ mehr Patentanmeldungen/Gebrauchsmusteranmeldungen von den in China tätigen Patentanwälten geschrieben und eingereicht werden als in Europa. Man könnte sagen – betrachtet man nur die Anmeldezahlen –, dass die Produktivität der chinesischen Patentanwälte fünfmal-zehnmal größer ist. Ein konkretes Beispiel: 65 Patentanwälte einer bestimmten chinesischen Kanzlei bewältigen ca. 1800 Patentanmeldungen/Jahr d.h. im Schnitt reicht jeder Patentanwalt alle dreizehn Tage eine neue Patentanmeldung ein. Zusätzlich zu diesem Arbeitspensum bewältigen diese 65 Patentanwälte z.B. noch rund 800 PCT-Patentanmeldungen pro Jahr für chinesische Firmen. Alle anderen Patentanwalts-Tätigkeiten, wie Beratungen, Marken- und Design-Anmeldungen, Betreuung von Streitfällen usw. laufen natürlich auch noch nebenher.

Insgesamt arbeiten in einer chinesischen Patentanwalts-Kanzlei typischerweise jedoch wesentlich mehr Personen. Kanzleien mit über 1000 Mitarbeitern – verteilt auf mehrere Städte – sind keine Seltenheit. Ca. 100 Beschäftigte/Patentanwaltskanzlei sind guter Standard und der Footprint dieser vielen Arbeitskräfte am Arbeitsplatz ist typischerweise relativ klein, da die Mietkosten für Büroräume in den Großstädten relativ teuer sind. Ein Arbeitsplatz verbraucht selten mehr als 2 m^2 Bürofläche. In Europa sind demgegenüber kleinere Kanzleigrössen üblich und nur einige wenige Kanzleien haben mehr als zwei Dutzend Mitarbeiter. Diese haben dafür relativ große und schöne Büros.

Effekte der Massenproduktion

Durch die Massenproduktion an Patentanmeldungen fehlt in China oftmals noch die in Europa übliche Qualität der Patentanmeldungen. Dies führt oftmals zu mangelndem Schutz für chinesische Firmen in Europa. Das wird jedoch von etlichen Konzernen in China schon erkannt, die dementsprechend reagieren und qualitätssteigernde Massnahmen einleiten. Insgesamt ist damit zu rechnen, dass aus China mehr und mehr wertvolle Schutzrechte in alle Welt getragen werden, denn der Wille von Regie-



rung und Bevölkerung ist groß, an die Technologie-Spitze zu kommen. Auch werden Kooperationen mit westlichen Spezialisten gesucht und mit offenen Armen eingegangen.

Legislative und Exekutive

Die Patentgesetze sowie das Patentamt und auch die Gerichte dürfen als sehr gut etabliert und auf hohem Niveau als gut funktionell eingestuft werden. Die Ausbildung und der Berufsstand eines Patentanwalts und eines Patentprüfers sowie von IP-Richtern sind angesehen und kompatibel mit westlichen Standards.

Wechselwirkung zwischen Innovatoren

Der Drang der chinesischen Wirtschaft nach oben geht einher mit einer emsigen Innovationstätigkeit, die oftmals auch an das konfuzianische Denken erinnert, wo das Kopieren einer guten (westlichen) Innovation etwas Ehrenvolles ist. Heute ist ein solches „Kopieren" jedoch meistens auch mit einer „Weiterentwicklung" der übernommenen Innovation verbunden. Dies bevorzugt nach dem Gedanken-Prinzip des „Leapfroggings". Dabei geht es darum, die Weiterentwicklung so erfolgreich zu platzieren, dass herkömmlich übliche Entwicklungsschritte einfach ausgelassen werden. Trotz des staatlich gelenkten Prinzips des Leapfroggings reichen chinesische Firmen oftmals aber auch nur kleine marginale Verbesserungen von bereits bestehenden Schutzrechten ihrer Mitbewerber als eigene Patentanmeldungen ein, wodurch Basisinnovatoren in China oftmals selbst zu Patentverletzern werden, da sie in ihrer normalen Geschäftsgebarung auch inkrementale Verbesserungen vornehmen und damit letztlich in die neuen Schutzrechte der „Nachahmer" fallen.

Unterstutzung durch Defensivpublikationen

Um hier gewappnet zu sein, bleibt den chinesischen und nicht-chinesischen Entwicklern weltweit keine andere Wahl, als selber vorausschauend zu patentieren und mehr noch auch dafür zu sorgen, dass mittels Defensivpublikationen z.B. via dem europäischen Anbieter Protegas AG auch kleinere Entwicklungsschritte unmittelbar als Stand der Technik gesichert werden, so dass später eingereichten Patenten von «Nachahmern» wirksam entgegen getreten werden kann.

Zukunftsaussicht

In jedem Fall darf in China damit gerechnet werden, dass das chinesische IP-Wesen in Zukunft neben dem unbestrittenen ersten Platz in quantitativer Hinsicht in Zukunft auch eine vorderen Platz in qualitativer Hinsicht erreichen wird, denn die chinesischen Firmen drängen auf den Weltmarkt und wollen dort wirksam verhindern, dass ihre eigenen Innovationen einfach kopiert werden. Dies führt automatisch zu einem Erstarken des Rufs nach hoher Patent-Qualität und Durchsetzbarkeit. Im westlichen Ausland haben diese Firmen nämlich keinen sprachbedingten Heimvorteil mehr.

Erforderliche Massnahmen

Um hier nicht den Anschluss im freien Wettbewerb zu verlieren, muss Europa auf der Hut sein und weiter und noch mehr das europäische IP-sowie Innovations-Wesen fördern.
Protektionistische Massnahmen à la Trump-Administration sind à la long sicher ein Schritt in die falsche Richtung, weil sie das Bemühen der Mitbewerber zusätzlich anstacheln und weil sie die eigene Innovation als nicht mehr

vordringlich erscheinen lassen, da sie durch Protektion ersetzt wird. Protektionismus führt daher zum Zurückgang der eigenen Innovationsleistung.

Europäische Startup Szene

Es genügt aber auch nicht – wie gegenwärtig auch hierorts sehr modern – Startups in Europa dadurch zu fördern, dass durch marketingartige „Behübschung" der Startups künstlich deren Firmenbewertung nach oben geschraubt wird, ohne echte Basisinnovation zu realisieren.

Es muss vielmehr dort der Hebel angesetzt werden, wo man konkrete Innovationsarbeit leistet: Nämlich aus technischer Sicht bestehende Produkte und Herstellverfahren verbessert oder durch bessere Produkte und Herstellverfahren ersetzt. Daran führt kein Weg vorbei.

Case Law

Disclaimers – Examples of global (dis)harmony

T. Yamada[1] (JP), K. Kitatani[1] (JP), C. Köster[2] (DE)

Successfully introducing disclaimers into claims of a European patent application or a European patent is not easy. This is true for "undisclosed disclaimers" as well as for "disclosed disclaimers". In G 1/16, the Enlarged Board of the European Patent Office elaborated that "undisclosed disclaimers" relate to the situation in which neither the disclaimer itself, nor the subject matter excluded by it, have been disclosed in the application as filed.[3] In contrast, "disclosed disclaimers" relate to the situation in which the disclaimer itself might not have been disclosed in the application as filed, but the subject-matter excluded by it has a basis in the application as filed.[4] The requirements for an undisclosed disclaimer being allowable are outlined in G 1/16, while the requirements for a disclosed disclaimer being allowable are outlined in former decision G 2/10.[5] It would seem that the respective requirements are rather strict, and we asked ourselves whether disclaimers might be handled in a more lenient way elsewhere. In this article, we thus look at requirements for introducing undisclosed disclaimers and disclosed disclaimers, respectively, in other jurisdictions. This journey to other jurisdictions brings us first to Japan, where undisclosed disclaimers have gained popularity over the last years, and then takes us back to Europe by looking at the requirements for a disclosed disclaimer in Germany.

I. Japan - Undisclosed disclaimer

Japan had previously long maintained the practice that an undisclosed disclaimer should only be used in exceptional cases, such as for restoring novelty over accidental anticipation in a prior document. However, the Grand Panel of the Intellectual Property High Court (IPHC) dramatically shifted the landscape of this practice in Japan when it issued a notable ruling on the admissibility of disclaimers (Heisei 18 (Gyo-Ke), No. 10563; judgment rendered on May 30, 2008). In summary, the Grand Panel eased the admissibility of

1 TMI Associates, Tokyo
2 Banse & Steglich Patentanwälte PartmbB, München
3 G 1/16, OJ EPO 2018, A70, at. No. 14 of the Reasons
4 G 1/16, loc. cit., at. 15 of the Reasons
5 G 2/10, OJ EPO 2012, 376

undisclosed disclaimers by holding that amendments are to be allowed unless they add new technical matter in relation to the technical matter taken from the specification or drawings as viewed by a person skilled in the art.

Since then, disclaimers have been used as an easy manoeuvre to overcome prior art issues, including lack of inventive step, during prosecution before the Japan Patent Office (JPO). Nevertheless, even after the above-noted Grand Panel case, the JPO has made no substantial change to the JPO's Examination Guidelines. In particular, the Guidelines still stipulate that examples of admissible undisclosed disclaimers include cases wherein "the claimed invention is likely to lack novelty and the like (Article 29, paragraph 1, Article 29bis or Article 39) (Note: including lack of novelty rejections, rejections over secret prior art and double-patenting rejections)" while refraining from explicitly mentioning the lack of inventive step rejection.

As such, it had been uncertain whether an undisclosed disclaimer could be regarded as establishing the existence of inventive step. However, on 25 September 2014, a notable court ruling was handed down by the IPHC regarding a disclaimer introduced by the proprietor as the defendant in the following claim of JP Pat. No. 4768217:

> *"A transparent film comprising an ethylene/vinyl acetate copolymer, and acid acceptor particles dispersed in the copolymer,*
> *wherein the acid acceptor particles are a metal oxide (provided that an oxide of Sn, Ti, Zn, Zr, Fe, Al, Cr, Co, Ce, In, Ni, Ag, Cu, Pt, Mn, Ta, W, V, or Mo is excluded), a metal hydroxide or a mixture thereof,*
> *wherein the content of the acid acceptor particles is 0.5 wt% or less of the copolymer, and*
> *wherein an average particle size of the acid acceptor particles is 5 μm or less,*
> *wherein the content of vinyl acetate in the ethylene/vinyl acetate copolymer is 20 to 36 wt%,*
> *wherein the ethylene/vinyl acetate copolymer is further cross-linked with a cross-linker, and*
> *wherein the transparent film is characterized by being used as a sealing film or a laminated glass for a transparent adhesive layer for a solar cell."*

The disclaimer "*an oxide of Sn, Ti, Zn, Zr, Fe, Al, Cr, Co, Ce, In, Ni, Ag, Cu, Pt, Mn, Ta, W, V, or Mo*" was introduced as an undisclosed feature during invalidation trial proceedings in order to render the claim inventive because a prior art document had disclosed these oxides as functional superfine particles. The JPO had allowed this "undisclosed" disclaimer, regarding it is duly satisfying the requirements for correction of claims, and, therefore, maintained the patent.

Dissatisfied with this decision, the plaintiff appealed to the IPHC, arguing that "*the correction (a) (Note: the disclaimer as described above) deviates from the purpose of corrections which are only allowed to exclude the scope overlapping with the prior art*".

The IPHC accepted the appeal but rejected the plaintiff's argument against the disclaimer for the following reasons:

> "*Corrections are allowed as long as they are for the purposes of Article 134 and do not introduce technical matter... and therefore the fact that such corrections were made to overcome the lack of inventive step as a ground for invalidation, should not influence the admissibility of the corrections*".

The IPHC went on to say that "*third parties could not face disadvantages from the correction as a person skilled in the art could easily understand that, with regard to the types of metal oxides in the invention, specific ones as the acid acceptor particles were excluded*".

Such court ruling has been taken as giving a de facto green light for the use of disclaimers as a measure to establish inventive step, and practitioners are now able to disclaim undisclosed features in Japan as an easy solution to prior art issues.[6]

Obviously, this is contrary to the European practice in which a disclaimer, which is, or becomes relevant for, the assessment of inventive step constitutes added matter and is, consequently, not allowable.[7]

II. Germany – Disclosed disclaimer

The latest view on disclaimers by the Federal Court of Justice of Germany is the order "Phosphatidylcholin".[8] The underlying case concerned an application for a patent filed with the German Patent and Trademark Office.[9] The claim at issue read in the Federal Court of Justice's structuring as follows:[10]

> *"1. Cosmetic, non-therapeutic use of*
> *a) 5 – 30 wt.% NaCl*
> *b) 5 – 30 wt.% glycerine*
> *in hand protection creams, cleansing milks, sun protection lotions, nutrient creams, day or night cremes for strengthening the barrier function of the skin,*
> *2. wherein the indications of weight refer to the total weight of the compositions,*
> *3. wherein these compositions are free from phosphatidylcholine."*

6 The JPO's Examination Guidelines have remained unchanged even since the court ruling.
7 G 1/03, OJ EPO 2004, 413, headnote II.3
8 BGH, Order of 25 July 2017 - X ZB 5/16 - Mitt. 2017, 493
9 DE 101 23 771 A1
10 BGH, loc. cit., marginal no. 9

Feature no. 3 formed the disclaimer in dispute. More specifically, the language of feature no. 3 is disclaiming the presence of phosphatidylcholine, but this language was not found in the application as filed. Phosphatidylcholine was, however, mentioned by its alternative name lecithin as one of various contemplated emulsifiers.[11] Hence, following the terminology of G 1/16, feature no. 3 amounted to a disclosed disclaimer.

The German Patent and Trademark Office refused the application for lack of support for feature no. 3 in the original disclosure. The applicant appealed to the German Patent Court, which dismissed the appeal, but granted leave to appeal on a point of law to the Federal Court of Justice.[12]

In its order, the Federal Court of Justice first emphasized that the Patent Court was right in starting from the standpoint that an application, which claims subject matter which goes beyond the content of the application as filed, must be refused in case this deficiency is not remedied upon invitation by the Examining Section.[13] The Federal Court of Justice then stated its own case law "*Wundbehandlungsvorrichtung*" on undisclosed, but merely limiting features, which do not jeopardize a patent's validity in post-grant invalidity actions, needs not to be extended to pre-grant application procedures.[14]

The Federal Court continued with discussing the technical information provided to the reader by the application at issue. Based on this discussion, the Court concluded at marginal no. 24 of its order that there was no pointer in the original application to phosphatidylcholine as an essential or advantageous ingredient. The respective passage of the order reads in English translation as follows:

> *"c) There is accordingly no clue in the application documents that phosphatidylcholine is an essential constituent of the preparation or only that the addition thereof would be considered advantageous. This is confirmed by the fact that the preparations 1 to 3, which are listed in the description in an exemplary manner, each contain 5 wt.%. glycerine and 7 wt.% common salt, but no phosphatidylcholine."*

Overall, the Federal Court of Justice came to the conclusion that the introduction of feature no. 3 into the claim in dispute did not amount to an unallowable extension beyond the content of the application as originally filed.[15] In other words, the disclaimer was allowed.

An interesting side note in this context is that the Federal Court of Justice also discussed in its order the pertinent case law of the European Patent Office.[16] In particular, the then available case law of the Enlarged Board of Appeal of the European Patent Office on disclaimers was referenced.[17,18,19] The Federal Court of Justice took from that case law the message that a disclaimer, which excludes certain embodiments or ranges of a generally formulated feature, shall be not allowable in case the corresponding limitation is technically relevant. In the decided case, the Federal Court of Justice, however, saw no such technical relevance, and also found its own approach to be in line with the case law of the Enlarged Board of Appeal of the European Patent Office.[20]

Conclusion

It seems to be fair to say that the limits for allowability of both undisclosed and disclosed disclaimers set in the case law of the European Patent Office are comparably tight.

From the German practice, it can be learned that there can be room for manoeuvre within these limits, at least when it comes to disclosed disclaimers. This might require a somewhat generous assessment of the question whether an introduced disclosed disclaimer leads to a technically relevant limitation. However, the German Federal Court of Justice itself believes that its own approach is in harmony with the European Patent Office's approach. Hopefully so.

The Japanese practice goes far beyond the limits of the European practice. Undisclosed disclaimers are allowable even if their purpose is to render the claimed subject matter inventive, which can offer a loophole for applicants encountering extremely similar prior art. However, the misuse of such undisclosed disclaimer should be avoided in some way. The Japanese approach therefore appears to be in disharmony with the European Patent Office's approach, showing that the latter is not the only way of handling disclaimers, at least not from a global perspective.

11 DE 101 23 771 A1, paragraph [0055]
12 BPatG, GRUR 2016, 583
13 BGH, loc. cit., marginal no. 17
14 BGH, loc. cit., marginal no. 19; citing BGH, Order of 17 February 2015 - X ZR 161/12 – Mitt. 2015, 275
15 BGH, loc. cit., marginal no. 25
16 BGH, loc. cit., marginal no. 26
17 G 1/03, loc. cit.
18 G 2/03, OJ EPO 2004, 448
19 G 2/10, loc cit.
20 BGH, loc. cit., marginal no. 26

Novelty Test for Sub-Ranges

D. Visser (NL)

Developments in case law have given rise to uncertainty about the interpretation of the three criteria of the novelty test for sub-ranges and to divergence in interpretation between departments of first and second instance in the EPO. An analysis of the legal basis of the criteria and the different interpretations within the EPO shows that it is time for a revision of the novelty test.

1 Introduction

The EPO uses a special novelty test to determine whether or not a claimed sub-range of a broader, known range is novel over that known range. According to this test, a sub-range must comply with each of the three criteria of the test to be novel.

Any novelty test must be based on the novelty requirement of Art. 54(1) EPC:

> *"An invention shall be considered to be new if it does not form part of the state of the art."*

The state of the art is defined in Art. 54(2):

> *"The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application."*

The word 'available' emphasises the possibility that the public can take note of the invention, according to the Travaux Préparatoires EPC 1973[1]. The extent of the disclosure of the prior art is determined by the disclosure test: the subject-matter which the person skilled in the art can derive directly and unambiguously, using common general knowledge, from the prior art[2].

Recent developments in case law have given rise to uncertainty in the interpretation of the novelty test for sub-ranges, in particular about what information the prior art makes available. Moreover, differences in interpretation between departments of first and second instance have emerged, recently resulting in the Guidelines dropping one of the criteria while the book Case Law of the Boards of Appeal maintains the three criteria. The differences cause legal uncertainty for users of the EPC.

This article will discuss the developments and differences in interpretation for each of the three criteria, with an emphasis on what subject-matter a broad parameter range discloses and the effect of this disclosure on the novelty assessment of a claimed sub-range of the known broad range. It concludes with a plea to refer the novelty test for sub-ranges to the Enlarged Board of Appeal to bring to an end years of legal uncertainty.[3]

The novelty tests for overlapping ranges and for purity ranges of a compound[4] use similar concepts as the novelty test for sub-ranges and also suffer from diverging case law. Several arguments developed in this article apply to these novelty tests as well. A referral should therefore consider also these novelty tests.

2 Origin of the novelty test for sub-ranges

2.1 First decision on novelty of sub-ranges

T198/84 was the first decision to discuss disclosure in relation to a sub-range. The prior art in that case described a chemical process using a catalyst within a range from > 0 to <100 mol%. The claimed sub-range of the patent in suit was from 0,02 to 0,2 mol%.

The approach that only subject-matter described explicitly in the prior art documents had to be regarded as prejudicial to novelty, which was essentially normal practice in all patent offices, was not followed by the board, because the approach disregarded the purpose of Art. 54(1) EPC.[5]

The board pointed out 'once again' that the purpose of Art. 54(1) EPC is to prevent the state of the art from being patented again. Hence, the examination of novelty has to establish "whether the state of the art is likely to reveal the content of the invention's subject-matter to the skilled person in a technical teaching".[6] Applying this criterion, the board held that the extensive numerical

1 Travaux Préparatoires EPC 1973, **Art. 54 E**, document IV/2767/61-E, page 12, second paragraph. See also **G2/88**, reason 10.
2 **G2/10**, reason 4.6. The disclosure test is sometimes referred to as the 'gold standard'; see **G1/16**, reason 17.
3 Reference is made to Roel van Woudenberg's article in this issue of *epi Information*. The article is on the same topic but expresses a different point of view on several aspects.
4 **T990/96**, headnote
5 **T198/84**, reason 4, first sentence, second part. Decision issued on 28.02.1985.
6 **T198/84**, reason 4, last two sentences.

range of the prior art "does not necessarily represent a disclosure[7], ruling out a selection from it, of all the numerical values between these minimum and maximum values if, as in this case, the sub-range selected is narrow and sufficiently far removed from the known range illustrated by means of examples."

Hereby, the board introduced the new concepts of 'narrow' and 'far removed' for numerical sub-ranges, without specifying how to evaluate them. In the case in suit, 'narrow' and 'far removed' were determined on a purely numerical basis by comparing values of the prior art range and of the claimed sub-range[8].

The board showed that it applied the same novelty test for numerical sub-ranges as was applied earlier for chemical substances defined in a formula. If the prior art definition covers nine chemical substances of which only one is individualized by a disclosed embodiment, the other eight substances are not individualised and do not belong the prior art[9].

The board added a third criterion for novelty of a sub-range to prevent that the sub-range is not more than just a formal delimitation vis-à-vis the prior art, i.e. just an arbitrary selection from the prior art range. The board held that a selection is arbitrary if the sub-range has the same properties and capabilities as the prior art range. Novelty requires that the sub-range is a purposive selection in that an effect occurs within the sub-range that does not occur over the whole prior art range. The board emphasises that the sub-range is not new by virtue of the newly discovered effect occurring in it but must be new per se.[10]

2.2 Formulation of novelty test for sub-ranges

Although the novelty test for subranges was formulated by the above board in 1985, the test was included in the Guidelines only in 2005. The wording of the test in the Guidelines remained the same from 2005 till 2018:

> *"A sub-range selected from a broader numerical range of the prior art is considered novel, if each of the following three criteria is satisfied (see T 198/84 and T 279/89):*
>
> *(a) the selected sub-range is narrow compared to the known range;*
>
> *(b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range;*
>
> *(c) the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new technical teaching)."11*

The end-points in the second criterion were not mentioned in the novelty tests of T124/87 and T279/89[12]. See the discussion in section 4 below.

The following sections discuss recent developments in case law that may affect the validity of the three criteria (a) – (c).

3 Purposive selection

The board of T198/84 "adheres to the principle that the sub-range singled out of a larger range is new not by virtue of a newly discovered effect occurring within it, but must be new per se" and "An effect of this kind is not therefore a prerequisite for novelty".[13] Nevertheless, the board did include the new effect in the third criterion of the novelty test. Since the new effect is introduced to avoid an arbitrary selection and not to establish novelty, the third criterion is apparently inappropriate for a novelty test; its presence in a novelty test therefore lacks legal basis.

Recent decision 261/15 held, that the third criterion on purposive selection considers the presence of an effect of the claimed invention, which goes beyond the comparison of the claimed invention with the disclosure of

7 The board did not explain why the range disclosed in a prior art patent document is not a disclosure of all numerical values between the end-points whereas the same prior art is a sufficient disclosure in the sense of Art. 83 EPC allowing the skilled person to carry out the invention for each numerical value within the range. If the disclosure had been insufficient, the prior art document should not have been used as prior art (see e.g. **T1437/07**, reason 25 and **T1457/09** reason 36). See section 6.3.2 below.

8 **T198/84**, reason 5. The sub-range 0.02 to 0.2 is a small specimen from the prior art range >0 to <100 and removed at least a power of ten from the prior art embodiments between 2 to 13. Note, that the board does not refer to the very small distance between the sub-range and the lower end-point of the prior art range, only to the distance between the sub-range and disclosed examples.

9 **T198/84**, reason 6, supporting the reason by a reference to **T181/82**.

10 **T198/84**, reason 7, supporting the reason by a reference to **T12/81**. A peculiarity of the third criterion is that, although the presence of a new effect does not make a sub-range novel, lack of a new effect does make the sub-range not novel.

11 Guidelines for Examination in the EPO, edition November 2018, G-VI, 8(ii)

12 **T261/15** reason 2.3.2

13 **T198/84**, reason 7. Likewise, **T230/07**, headnote, states "A sub-range is not rendered novel by virtue of a newly discovered effect occurring within it."

Please note that the mentioned links in the footnotes of the article can be found in the online version of **epi** Information on the **epi** website as follows:
https://patentepi.org/r/info-1904-03

the prior art. Therefore, whether the selection of the sub-range is purposive or not is more a question of inventive step than of novelty.[14]

The draft 2019 edition of the Guidelines that has entered into force on 01.11.2019 refers to T261/15 and dropped the third criterion on purposive selection.[15] Departments of first instance should therefore no longer use the third criterion when assessing the novelty of a sub-range[16].

However, the latest edition of the Case Law book, published in July 2019, mentions the three criteria and cites a few recent decisions supporting the third criterion in the novelty test, but in addition it also mentions a large body of case law issued over the last ten years that considers the third criterion an inventive step issue[17]. The boards have hereby caused a prolonged legal uncertainty in that it depends on the board handling the case whether or not the third criterion will be used[18].

4 End-points

It is established case law, that the disclosure of a range is an explicit disclosure of the end-points of the range.[19] This case law could have been the reason for including the end-points in the novelty test for sub-ranges in the Guidelines, as mentioned in the above section 2.2. Hence, the 'far removed' criterion requires that a sub-range must be far removed not only from disclosed examples but also from the end-points of a known range.[20]

Decision T261/15 held, that the criterion that a sub-range must be sufficiently far removed from the end-points of a known range, although mentioned in the Guidelines, is not stated in any jurisprudence, in particular not in the two decisions T198/84 and T279/89 cited in the passage of the Guidelines. In the view of the board, "the limit values of a known range, although explicitly disclosed, are not to be treated in the same way as the examples. The person skilled in the art would not, in the absence of further teaching in this direction, necessarily contemplate working in the region of the end-points of the prior art range, which are normally not representative of the gist of the prior art teaching".[21, 22]

According to T261/15, a sub-range close to an end-point would not lack novelty because of the 'far removed' criterion. T279/89 appears to follow the same reasoning by not acknowledging novelty of a sub-range that is not near the lower or upper end of a known range but right in the middle thereof.[23]

It could be argued contrary to T261/15, that the teaching of a prior art patent document is sufficient for the skilled person to carry out the teaching in the sense of Art. 83 EPC also near the end-points and a technical effect of the disclosed invention is achievable throughout the entire range.[24] Hence, normally a skilled person would contemplate working anywhere in the range, including near the end-points, unless further teaching points away from the end-points.[25]

Another argument against T261/15 is, that the decision creates different types of disclosure: disclosures that can be used and disclosures that cannot be used for the novelty test for sub-ranges[26]. If prior art discloses a feature in the sense of making it available according to Art. 54(2) EPC and complying with the disclosure test, that feature should be usable in any novelty test under Art. 54(1) EPC[27].

All editions of the Guidelines since 2005, including the November 2019 edition, mention the end-points in the second criterion. In contrast, the Case Law book has never included the end-points in the second criterion[28]. The different treatment of end-points by departments of first and second instance causes legal uncertainty. For example, a sub-range near an end-point may be regarded not novel in first instance and novel in second instance.

14 **T261/15**, reason 2.2.2. Confirmed by a large body of case law; see the book Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019 (CLBA) **I.C.6.3.1**.
15 Draft Guidelines, edition 2019, G-VI, 8(ii), published on the EPO website on 01.10.2019. The published draft still mentions in the paragraph below the three criteria the relevance of a technical effect in the sub-range for novelty, which appears to be inconsistent with the deletion of the purposive selection requirement.
16 As a consequence, a patent granted on three criteria may, after entry into force of the Guidelines 2019 on 01.11.2019, be assessed in opposition on two criteria and subsequently in appeal on three criteria.
17 **CLBA I.C.6.3.1**
18 As a consequence, a patent application refused on three criteria before 01.11.2019 may be re-assessed by a board using two criteria, or a patent application refused on two criteria after 01.11.2019 may be re-assessed by a board using two criteria.
19 **T1115/09**, reason 2.3, cited in **CLBA IC.6.3.2**.
20 The mention of the end-points of the known range in the 'far removed' criterion of the Guidelines would probably reverse decision T198/84 by making the sub-range discussed in the above section 2.1 not novel (see footnote 7).
21 **T261/15**, reason 2.3.2, one but last paragraph.
22 The gist of the prior art teaching, used for the special treatment of the end-points, normally relates to the attainment of a technical effect. Hence, a technical effect is used to disregard end-points in the second criterion. The same decision, T261/15, refuses to use a technical effect in the third criterion (see the above section 3). The decision does not reconcile these apparently different treatments of technical effect in the novelty assessment.
23 **T279/89**, reason 4.1.1
24 **CLBA I.D.9.8.3**
25 Followed by e.g. **T673/12**, reason 2.3
26 Although, according to the decision, an end-point should not be used for the second criterion, an end-point can be used as a disclosure to destroy the novelty a claimed range (Guidelines **G-VI, 8(iii))** and be used as basis for amending a range (**CLBA II.E.1.5.1**).
27 **G1/16**, reason 17, mentioning the applicability of the disclosure test to novelty.
28 This applies to all editions of Case Law of the BoA, including the 9th edition of July 2019.

5 'Narrow' and 'far removed' and technology

The 'narrow' and 'far removed' criteria require that a sub-range is narrow compared to the known range and is far removed from known examples within the range. Since the assessment of novelty involves a comparison of a technical invention with the disclosure of technical prior art, the comparison must be based on technical arguments.

Nevertheless, the large majority of decisions on novelty of a sub-range assess compliance with the 'narrow' and 'far removed' criteria merely by an arbitrary comparison of just numerical values, devoid of any relation to technology. An example of such a decision is T1233/05, in which the known range is from 0 to 100% including an example having at least 50% and the claimed sub-range from 1 to 20%[29]. The sub-range 'is narrow' and, since 50% is 'well above' 20%, the range is 'far away' from the disclosed value. Hence, the board regarded the sub-range as new without addressing any technical issues.

T673/12 is one of the few decisions that use among others technical arguments in the assessment of 'far removed'[30]. A product having a copper content in the range 0,6 – 2,7% and an example having 0,92% were known from a prior art document; a sub-range of 0,6 – 0,71% with favourable mechanical properties was claimed. The board regarded the example of 0,92% as not 'far removed' from the sub-range because 1) the example and the sub-range are both in the lower quarter of the known range (non-technical); 2) the example has a favourable mechanical strength (technical); 3) there is no teaching in the prior art document excluding a copper content in the sub-range from the teaching (technical). According to the board, the technical teaching for the assessment must be taken from the prior art document, not from the patent. Whether the skilled person is encouraged to use a copper content in the sub-range does not play a role in the assessment; it is rather whether the disclosure constitutes a usable technical teaching, i.e. whether the teaching is sufficiently supported by the examples.[31, 32]

The assessment of the 'narrow' and 'far removed' criteria based on numerical values without a relation to technology disqualifies the two criteria as novelty criteria.

A further problem with the 'narrow' criterion is, that the criterion itself is not related to technology. If the 'narrow' criterion is intended to prevent a sub-range from claiming a major part of a known range, thereby essentially just copying the known invention, it had better be part of the assessment of inventive step than of novelty.

Another difficulty of the 'narrow' and 'far removed' criteria is that the criteria are not clear in what 'narrow' and 'far removed' is. Is a sub-range of 40% of the known range narrow, or should it be 20%? The vagueness of the criteria set up in 1985 appears to be incompatible with the strictness of the requirement for novelty developed after 1990: for an invention to lack novelty, its subject-matter must be directly and unambiguously derivable from the prior art[33].

6 'Narrow' and 'far removed' and disclosure of prior art

According to the board that introduced the three novelty criteria for sub-ranges, the 'narrow' and 'far removed' criteria establish, "whether the state of the art is likely to reveal the content of the invention's subject-matter to the skilled person in a technical teaching" [34], in other words, whether "the person skilled in the art would seriously contemplate working" in the claimed sub-range[35].

The formulation of these novelty criteria date back to 1985. Since then, case law has further developed the concepts of novelty and disclosure. Decision T1085/13[36] summarises case law developed by the Enlarged Board of Appeal relating to novelty and disclosure of ranges, in particular decisions G2/88 and G2/10. It mentions the following relevant requirements for novelty.

a) "In order to conclude a lack of novelty, there must be at least an implicit disclosure in the state of the art of subject-matter falling within the claimed scope."

b) An "implicit disclosure means no more than the clear and unambiguous consequence of what is explicitly mentioned." An example of implicit disclosure is that "the teaching of carrying out a process … also makes available further information which is the inevitable result of carrying out such teaching."

c) The word 'available' in Art. 54(2) EPC "carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public."

29 **T1233/05**, reason 4.3. Another example is **T230/07**, reason 4.1.5.
30 **T673/12**, reason 2.3
31 Note, that the reasoning of the board about disclosure is similar to that in **T279/89**, reason 4.2, which made the patentability of sub-ranges next to impossible. See section 6.3.2 below.
32 The author has not found any decision using technical arguments in the assessment of 'narrow'.
33 See the disclosure test in the above section 1.
34 **T198/84**, reason 4, last two sentences.
35 **T261/15**, reason 2.2.2. In contrast, 'seriously contemplating' is not necessary according to **T673/12**, reason 2.3.
36 **T1085/13**, reason 3.6. The decision, issued in 2018, held that the well-established novelty test for purity of a compound was not in line with **G2/88** and **G2/10**.

It is emphasised that according to the Enlarged Board of Appeal a sub-range is not novel only if there is an implicit and / or explicit prior art disclosure within the sub-range. There are no other ways of taking away the novelty of the sub-range. The discussion below will focus on an implicit disclosure within the sub-range and not consider the obvious case of an explicit disclosure within the sub-range.

The present section investigates whether the two novelty criteria of 1985 still comply with above, recent interpretation of novelty and disclosure.

6.1 Clear and unambiguous

The vagueness in the phrases 'likely to reveal' in T198/84 and 'would seriously contemplate' in T261/15 are hardly compatible with the stricter requirement that the disclosure must be clear and unambiguous, i.e. admitting one interpretation.

Both phrases appear to interpret the word 'available' in Art. 54(2) EPC as using considerations of the skilled person to supplement the disclosure instead of using the considerations of the skilled person only to understand the disclosure[37]. In contrast, the Travaux Préparatoires held that the word 'available' emphasises the possibility that the public can take note of the invention[38].

If not only the interpretation by a skilled person but also the work of a skilled person is taken into consideration when assessing a prior art disclosure, the result is likely to be a further development of the prior art. Such a development will unavoidably include features that have not been disclosed in the prior art. That contravenes the requirement, that all the technical features of the claimed invention in combination must have been communicated to the public. Such a further development should be carried out under inventive step and not under novelty.[39]

6.2 'Narrow' and disclosure

The first novelty criterion requires that a sub-range is narrow in view of the known range. If a sub-range is broader than the narrow range, it becomes not novel according to the criterion. Following the above requirement 6a), there must be an implicit prior art disclosure in this broader sub-range to take away its novelty. The implicit disclosure must be in the area where the broader sub-range extends beyond the narrow sub-range.

Since the criterion of 'narrow' is not linked to a specific location within the known range, the area where the implicit disclosure should be located to take away the novelty of the broader sub-range can be anywhere within the known range. Such an undetermined requirement is incompatible with the 'unambiguous' requirement 6b).

The only possible assessment of the criterion left is to compare just numerical values without regard to technology, as is usually done by the boards[40]. This disqualifies the first criterion as novelty criterion.

6.3 'Far removed' and disclosure

The second novelty criterion requires that a sub-range is far removed from examples in the known, broad range. If a sub-range is not far removed but close to an example, it becomes not novel according to the criterion.

Applying the above novelty requirement 6a) to this situation, a sub-range close to an example is not novel because there is an implicit prior art disclosure within that sub-range. In other words, the sub-range is not novel if the teaching of an example having a parameter value outside the sub-range can be extended to an implicit disclosure having a parameter value within the sub-range.

Does a prior art document disclosing explicitly a range with one or more examples make such an implicit disclosure available? There are three approaches to what prior art discloses, as set out in the following three subsections.

6.3.1 Explicit – plus approach

The second criterion implies, that a known range with one or more explicitly mentioned examples in a prior art document not only discloses the explicitly mentioned examples but also a region around each example, in which a skilled person 'would seriously contemplate working'.[41] Taking into account not only the explicitly disclosed examples but also a region around each example is called in this article the 'explicit – plus approach'.

If the sub-range does not overlap a region, the sub-range is 'far removed' in terms of the second criterion and therefore novel; if the sub-range does overlap a region, it lacks novelty. To accord the second criterion with the novelty requirement 6a), there must be an implicit disclosure within the overlap of the sub-range and the region.

The implicit disclosure in the 'far removed' criterion appears not to comply with the requirements for novelty

37 See T**1085/13**, reason 3.6.4
38 See the above section 1 and the requirement c) in the above section 6.
39 See e.g. T1085/13, reason 3.6 – 3.10

40 See the above section 5.
41 **T261/15**, reason 2.2.2

mentioned in the above section 6b) and 6c). The implicit disclosure falling within the sub-range includes a parameter value within the sub-range that is not explicitly mentioned in the prior art of the cases discussed. The prior art neither mentions a process that inevitably results in a parameter value within the sub-range. Hence, the parameter value within the sub-range is not an implicit disclosure of the prior art. Instead, the parameter value is a development of the prior art starting from the parameter value of an explicitly disclosed example. Such a development is more a matter of inventive step than of novelty.

There is another reason why an implicit disclosure as required for the 'far removed' criterion is not in agreement with case law. The EBoA held that the same disclosure test must be used for novelty and amendments.[42] If an implicit disclosure as required for the second criterion of the novelty test may be based on a known range with one or more explicit examples in a published patent application, the same implicit disclosure would be permitted as basis for an amendment under Art. 123(2) EPC of the patent application or patent. However, a disclosure of a range in general does not specifically and thus directly and unambiguously disclose all values within the range for the purpose of amending a range.[43] This must also apply to the assessment of novelty according to the EBoA and, consequently, to the 'far removed' criterion. Hence, the implicit disclosure used for the 'far removed' criterion is not in agreement with the disclosure test and is therefore not a true implicit disclosure.

Hence, the use of the 'explicit – plus' approach for the 'far removed' criterion is not in line with recent case law on availability.

6.3.2 Whole content approach

Decision T279/89 is usually quoted for its summary of the novelty test for sub-ranges[44] but not for its arguments on disclosure[45]. Since the novelty test is based on disclosure, it is worthwhile to consider its arguments.

The board cites approvingly T26/85:

> *"… what is made available to the public by means of a written document should not be restricted to the explicit disclosure, but extends to the whole content, i.e. to the information actually given to the person skilled in the art. When that information is sufficient to enable the skilled man to practice the technical teaching which is the subject-matter of the disclosure, taking into account also the general knowledge in the field to be expected of him, novelty can no longer be acknowledged."*

and finds further support for this whole content approach in T12/81[46] and T124/87[47]. The latter decision held that a prior art disclosure of a process for preparation of polymers is clearly not limited to the particular polymers, whose preparation is explicitly exemplified, but extends to the general class of polymers in the disclosure. All members of this general class are therefore available in the sense of Art. 54(2) EPC.

Decisions T12/81, T26/85 and T124/87 relate the disclosure of a prior art document and, hence, the availability of Art. 54(2) EPC to the sufficiency of disclosure of Art. 83 EPC.

As an exception to the disclosure of the whole content of a broad range, a sub-range of a broad range is not available if the skilled person is dissuaded from carrying out the invention in the sub-range, thereby making the sub-range novel[48].

It is a reasonable assumption that a range disclosed in a prior art patent document is normally sufficiently disclosed for the skilled person to work the invention over the entire range, because such a disclosure is required for a patent document by Art. 83 EPC. Dissuading statements not to use a part of a range are exceptional. The whole content approach for determining the disclosure of prior art would make it next to impossible to patent sub-ranges, because the novelty of the sub-range must be based on such an exceptional dissuading statement.

Case law on amendments does not support the whole content approach. As already mentioned in the above sub-section 6.3.1, a disclosure of a range in general does not specifically, and thus directly and unambiguously disclose all values within the range for the purpose of amending a range.[49]

Most decisions relating to sub-ranges do not use the whole content approach and assess compliance of a sub-range with the 'far removed' criterion by a mere comparison of numerical parameter values. Where a decision advances technical arguments in the assessment of the 'far removed' criterion, the reasoning often moves from

42 **G2/10**, reason 4.6; **CLBA II.E.1.1**
43 **T985/06** reason 2.1.2; **CLBA II.E.1.5.3**
44 **T279/89**, reason 4.1. See the above section 2.2.
45 **T279/89**, reason 4.2 – 4.5. Reason 4.5 states that use of whole contents approach, which uses a broader definition of the concept of novelty than the explicit disclosure approach, is constant jurisprudence of the boards and established practice of the EPO. In spite of this assertion of the board, its arguments on availability are not cited in the Guidelines nor in the book Case Law of the Boards of Appeal.
46 **T12/81**, reasons 5, 7 – 9
47 **T124/87**, reason 3.4
48 **T279/89**, reason 4.2 for a sub-range entirely within a known range; **T26/85**, headnote, for an overlapping range.
49 **T985/06** reason 2.1.2 and 2.1.4; **CLBA II.E.1.5.3**

the explicit-plus towards the whole content approach, without explaining why this approach can be used in the novelty test and not in the assessment of the allowability of amendments, whereas both should be based on the same disclosure test.[50]

6.3.3 Explicit-implicit approach

A further possibility is the explicit approach: a sub-range lacks novelty only if there is a prior art disclosure falling within the sub-range. The disclosure can be explicit or implicit, the latter in the sense of T1085/13 as set out in the above section 6. An advantage of this approach is that the assessment is straightforward and complies with the decisions of the Enlarged Board of Appeal about disclosure. Moreover, this interpretation of disclosure is essentially the normal practice in all patent offices.[51]

Conclusion

The different criteria applied by departments of first and second instance and the difference of interpretation of criteria between boards in applying the novelty test for sub-ranges causes legal uncertainty for users of the system. Harmonisation would be welcomed.

Not only harmonisation but a review of the usability of the three criteria is desirable. Each of the three criteria appear to conflict with recent case law.

The explicit-implicit approach for disclosure is probably the only approach that is compatible with the disclosure test. However, a consequence of this approach is that many more sub-ranges will be novel compared to the common assessment by mere comparison of numbers. Similarly, the removal of the third criterion from the novelty test in the Guidelines will cause a similar increase in novel sub-ranges. The assessment of inventive step in the examination following the assessment of novelty will apply criteria such as the presence of a new effect in the sub-range and whether it is obvious for a skilled person to work the invention in the sub-range, probably resulting in a similar number of grants as when using the current novelty test for sub-ranges.

However, if the prior art is a European prior right under Art. 54(3) EPC, there will not be an assessment of inventive step and the large number of novel sub-ranges may form a problem, in particular in the field of chemistry. It may thus be desirable not to abandon the entire novelty test for sub-ranges but to maintain a novelty test that filters out a large proportion of certainly not patentable sub-range inventions.

The author therefore strongly recommends the President of the EPO to refer the question of novelty of sub-ranges, overlapping ranges and purity ranges to the Enlarged Board of Appeal.

50 See e.g. **T261/15**, reason 2.2.2 and 2.3.2; **T673/12**, reason 2.3
51 **T198/84**, reason 4, second part of first sentence

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Guidelines November 2019: Purposive selection no longer needed for novelty of sub-ranges?

R. van Woudenberg (NL)

In the (pre-published) 2019 edition of the Guidelines for Examination in the European Patent Office, the paragraph relating to the novelty test of a sub-range was amended by deleting the purposive-selection criterion. For many years, the test followed established case law on the novelty of selection inventions as developed in particular in T 198/84 and summarised briefly in T 279/89, reason 4.1, according to which a selection of a sub-range of numerical values from a broader range is new when each of the following criteria is satisfied: (a) the selected sub-range should be narrow, (b) the selected sub-range should be sufficiently far removed from the prior-art range illustrated by means of examples (and, in the Guidelines version, from the end-points of the known range), and (c) the selected area should not provide an arbitrary specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection); i.e., just (arbitrarily) different values do no confer novelty. However, in recent years some board decisions, e.g., T 261/15, deviated from this well-established test, and considered the purposive-selection criterion an issue for inventive step rather than novelty. This different line of reasoning was not followed by the Guidelines over various years, (implicitly) indicating that the line of T 198/84 and T 279/89, including the purposive-selection criterion, was to be considered as established case law. However, in the (pre-published) November 2019 of the Guidelines, the test for novelty of a sub-range was suddenly change to the line of T 261/15. In this article, it is challenged whether the line of T 261/15 is correct, and whether the amendments to the Guidelines by deleting the purposive selection criterion – and thereby giving a different definition of the prior art then before – is legally correct, also in view of recent Enlarged Board decisions, notably G 3/89, G 11/91 and G 2/10, emphasizing the relevance of what the skilled person derives directly and unambiguously, using common general knowledge and also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document, from the disclosure of the application as filed rather than what is literally disclosed.

1. Novelty of a sub-range – Guidelines G-VI, 8(ii)

In section G-VI, 8(ii) of the (pre-published) Guidelines 2019 (GL/EPO), the paragraph relating to the test for the novelty of sub-range has been amended to:

A sub-range selected from a broader numerical range of the prior art is considered novel if both of the following **two** ~~**three**~~ criteria are satisfied (see ~~T 198/84~~ **T 261/15** and **T 279/89**):

(a) the selected sub-range is narrow compared to the known range;

(b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points[1] of the known range;

(c) **the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new** ~~**technical teaching).**~~

An effect occurring only in the claimed sub-range cannot in itself confer novelty on that sub-range[2]. However, such a technical effect occurring in the selected sub-range, but not in the whole of the known range, can confirm that ~~**criterion (c) is met, i.e. that**~~ the invention is novel and not merely a specimen of the prior art. The meaning of "narrow" and "sufficiently far removed" has to be decided on a case-by-case basis.

1 Note that the Case Law Book (2019) indicates in III.W.3 that: "In T 261/15, in respect of the argument that a selected sub-range has inter alia to be sufficiently far removed from the end-points of the known range, the board pointed out that it was not aware of any jurisprudence stating this condition in such a general way. It was true that the Guidelines for Examination, G-VI, 8, recited under point (ii)(b) this criterion as a condition for acknowledging novelty of a numerical selection. However, neither decision T 198/84 nor T 279/89, which are cited in this passage of the Guidelines, stipulates this condition."

2 This sentence is taken from the headnote of T 198/84, which provides "The sub-range is novel not by virtue of an effect which occurs only within it; but this effect permits the inference that what is involved is not an arbitrarily chosen specimen from the prior art but another invention (purposive selection).". Thus, the headnote clarifies that a new effect permits to conclude that the selection is not arbitrary, but rather a purposive selection. It is addressed in some more detail in reason 7.

The new technical effect occurring within the selected range may also be the same effect as that attained with the broader known range, but to a greater extent.

i.e., the paragraph was amended to:

(i) replace the reference to T 198/84 by a reference to T 261/15,
(ii) while keeping the reference to T 279/89,
(iii) delete third criterion (c), which is the purposive-selection criterion,
(iv) while keeping the text that related to the third criterion (c) ("An effect … greater extent")

In my view, the amendment may create unclarity as to what the tests now comprises. Firstly, maintaining the reference to T 279/89 results in referencing to two decisions which are conflicting: T 261/15 deletes the purposive-selection criterion, while T 279/89 embraces T 198/84 and the purposive-selection criterion[3]. Secondly, maintaining the paragraph indicated above relating to the effect ("An effect …. greater extent") results in an inconsistent part (ii) of GL/EPO G-VI, 8. The first line of that paragraph originated from -the now deleted decision- T 198/84. Also, the presence of that paragraph suggests that there is still a (now hidden) criterion as to a new effect. This makes the paragraph unclear. If a reader would, when confronted with this unclarity, check the cited case law, he would not find a clarification as cited T 261/15 and T 279/89 give different and conflicting tests. Also, there is no decision from the Enlarged Board that resolves the matter.
Further, it is doubted whether moving away from T 198/84 towards T 261/15 is correct in view of the arguments presented below.[4]

2. Established case law, conflicting case law

Purposive selection

In T 261/15, the Board argued that the purposive-selection criterion should not be part of novelty, but part of inventive step. T 1233/05 (Reasons 4.4), T 230/07 (Reasons 4.1.6), T 1130/09 (Reasons, 3.2), T 1948/10 (Reasons 3.6) and T 378/12 (Reasons 4.8 to 4.9), T 305/16 (Reason 2.1.3) argued similarly. This conflicting case law was however not followed in the Guidelines until and including the edition of November 2018.

T 198/84 as well as T 279/89 however argued the contrary. T 198/84 as well as T 279/89 have always been followed in the Guidelines as well as in the Case Law Book[5]. The decisions imposed the "purposive selection" criterion for a sub-range selected from a known continuous numerical range. T 198/84, reason 7 provides hereto: "It remains to be established whether this view of novelty really entails more than just a formal delimitation of the process concerned vis-à-vis the state of the art. It would be delimited only in respect of the wording of the definition of the invention, but not in respect of its content, if the selection were arbitrary, i.e. if the selected range only had the same properties and capabilities as the whole range, so that what had been selected was only an arbitrary specimen from the prior art. This is not the case, since the effect of the substantial improvement in yield may be believed to occur only within the selected range, but not over the whole known range ("purposive selection")."[6] A sub-range which is arbitrarily selected has no new technical effect and no new technical teaching with respect to the prior art broader range, and is thus not novel according to the test of T 198/84 and T 279/89.

There has not been any referral to the Enlarged Board on the topic, so it is difficult to understand why the Guidelines have now deleted criterion (c).

"Gold" standard

Decision G 2/10 from the Enlarged Board of Appeal[7] emphasizes that the "gold" standard[8] of what an application (or the prior art, as the same tests are to be applied according to G 2/98) discloses is that the skilled person directly and unambiguously derives from the disclosure as a whole[9]; not what he reads there literally (this was confirmed in G 1/16). The reasoning of T 198 and T 279/89

3 The wording of the three criteria actually stems from T 279/89, reason 4.1, wherein the principles applied by the boards of appeal as part of their established case law on the novelty of selection inventions, as developed in particular in T 198/84, were summarized. Also see Case Law Book (2019) I.C.6.3.1.
4 Reference is also made to Derk Visser's article elsewhere in this issue of **epi** Information, expressing a different point of view as well as some other aspects.
5 Case Law Book (2019) I.C.6.3.1 "Selection from a broad range" as well as corresponding sections in all earlier editions
6 Reason 7 of T 198/84 continues with: "To prevent misunderstanding, it should be expressly emphasised that when examining so-called selection inventions as to novelty the Board adheres to the principle that the sub-range singled out of a larger range is new not by virtue of a newly discovered effect occurring within it, but must be new per se (cf. T 12/81 "Diastereomers/BAYER", OJ of the EPO 8/1982, 296, 303). An effect of this kind is not therefore a prerequisite for novelty; in view of the technical disparity, however, it permits the inference that what is involved is not an arbitrarily chosen specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection)." Thus, reason 7 emphasises that the third requirement is "what is involved is not an arbitrarily chosen specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection)" and that the latter may be interfered from a newly discovered effect.
7 G 2/10 is cited in the Guidelines (2019) in, e.g., H-IV, 2.1, last paragraph and H-V, 3.1.
8 G 2/10 did not develop the "gold" standard itself, but G 2/10 introduced the term in reason 4.3: "[…] the general definition of the requirements of Article 123(2) EPC established in opinion G 3/89 and decision G 11/91, which definition has become the generally accepted, one could also say the "gold" standard, for assessing any amendment for its compliance with Article 123(2) EPC."
9 For the definition of the "gold" standard, G 2/10, reason 4.3 refers to G 3/89 and G 11/91: "4.3 The basic principle underlying Article 123(2) EPC, in the jurisprudence of the Enlarged Board
The importance and the applicability, without exception, of Article 123(2) EPC was underlined in the jurisprudence of the Enlarged Board of Appeal as early as in its opinion G 3/89 and decision G 11/91 (OJ EPO 1993, 117 and 125, relating to amendments by way of correction). From these rulings it follows that any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed, points 1., 1.3 and 3. of the Reasons."

are fully consistent with that approach: it recognizes that the skilled person does not see some numerical values, but also an understanding of what happens in the range / what he can expect in the range based on the overall disclosure. T 261/15 and the other T-decisions that deny the criterion of purposive selection seem to put only little weight as to what the skilled person directly and unambiguously understands from the prior art range in its context (i.e., that the range reflects a certain physical, mechanical or chemical characteristic and that the prior art range reflects a certain purpose or effect upon the prior art subject-matter that is in part described by a range of a certain parameter). It may be doubted whether denying the relevance of a purpose/effect of the prior art on its disclosure and, consequently, denying the relevance of a new purpose/effect is consistent with the "gold" standard and the reasoning behind that.

Exact values of continues parameters are arbitrary
Further, T 198/84 and T 279/89 recognize that the exact values used to define a numerical range and the exact values of examples are arbitrary in the sense that they could be slightly different while substantially not changing any technicalities. Rather, the disclosure of the specific end points and examples just serves to proof that the claimed range is novel and enabled, over the full range with the technical characteristics as understood by the skilled person from the application as a whole. Only if something differently than what the skilled person derives from the disclosure as a whole would occur in a sub-range, can a sub-range be considered to relate to something technically different. This seems to be ignored in T 261/15.

End points
Also, other parts of decision T 261/15 (cited in Case Law Book (2019) I.C.6.3.1) are in my view difficult to understand and go against the common understanding, practice and the principle of legitimate expectations (see below). E.g., T 261/15, reason respect 2.3.2 comprises

> "In the view of this Board, the limit values of a known range, although explicitly disclosed, are not be treated in the same way as the examples. The person skilled in the art would not, in the absence of further teaching in this direction, necessarily contemplate working in the region of the end-points of the prior art range, which are normally not representative of the gist of the prior art teaching."

However, according to section I.C.6.3.2 "Overlapping ranges" of Case Law Book (2019), the Board held in T 240/95 that, "in accordance with established case law, disclosure of a range was considered to be an explicit disclosure of the end values", followed by. e.g., T 1115/09 as mentioned in the same section.

So, reason 2.3.2 of T 261/15 seems to go against the common approach for sub-ranges where end points of a prior-art range are considered to be explicitly disclosed and where an end point of a prior-art range destroys the novelty of a later range that comprises that end point and extends on either side. T 261/15 seems to be incorrect (at least as a general principle; it may be correct under possible special circumstances of a specific case, e.g., where the teaching of the prior art document as a whole indicates that the mentioned end points are speculative).

This usual approach is also explicitly used elsewhere in the Guidelines, e.g. in GL/EPO G-VI, 8(iii):

> "As to overlapping ranges or numerical ranges of physical parameters, **novelty is destroyed by an explicitly mentioned end-point of the known range**, explicitly mentioned intermediate values or a specific example of the prior art in the overlap."

Citing T 261/15 for sub-ranges while the same decision goes against established practice in relation to other aspects of ranges and against the Guidelines with respect to the interpretation of end points seems inconsistent. In my view, a decision relied on in the Guidelines should be followed with respect to all of the aspects addressed in that decision, as it reflects the underlying argumentation. Further, the novelty-test for sub-ranges shall be consistent with G 2/10. See also my arguments above.

Authority of T 194/84
In contrast, the Case Law Book attributes a high degree of authority to decision T 198/84. Firstly, the opening paragraph of the Novelty chapter I.C.1 "General" refers to this decision as one out of only two when describing the purpose of the novelty requirements as:

> "An invention can be patented only if it is new. An invention is considered to be new if it does not form part of the state of the art. The purpose of Art. 54(1) EPC is to prevent the state of the art being patented again (T 12/81, OJ 1982, 296; **T 198/84**, **OJ 1985, 209**)." [emphasis added]

Secondly, when discussing distinguishing features in I.C.5.2.1 "Difference in wording", T 198/84 is cited in support of the later T 114/86:

> "In T 114/86 (OJ 1987, 485) the board held that **a mere difference in wording was insufficient to establish novelty** (see T 12/81, OJ 1982, 296; **T 198/84**, **OJ 1985, 209**; T 248/85, OJ 1986, 261). In T 565/90 the appellant submitted that only preferred ranges or examples amounted to a technical disclosure destructive of novelty, and that generic ones could not anticipate the more specific teaching of the patent in dispute. The board did not agree and confirmed earlier case law that the definition of an invention which dif-

fered from the prior art only in its wording was insufficient to establish novelty. The board stated that what had to be established was **whether or not the state of the art made the subject-matter of the invention available to the skilled person in the form of a technical teaching**." (emphasis added]

In my view, where a decision has such a high level of authority in the Case Law Book, and not just established case law but also leading as established case law, extra care must be taken to deviate from the decision. Also, a difference in approach between the first instance search, examining and opposition divisions, who follow the Guidelines, and second instance Boards, is to be prevented.

Narrow and far-removed criteria cannot be seen independent from technical meaning

The narrow and far-removed criteria can in my view not be seen as a purely numerical comparison of end points of claimed and known ranges and end points of claimed ranges and known examples. When comparing the values, the skilled person will compare the technical differences, i.e., compare the technical teachings. Whether two values are close or far will be considered taking into account the difference between the complete technical embodiments at the two points. E.g., comparing embodiments comprising water at 85 and 95ºC may be considered close to each other, whereas embodiments comprising water at 95 and 105ºC will surely be far removed from each other in view of the - to the skilled person well-known - phase change occurring at 100ºC. The values 85, 95 and 100 as such have no technical meaning; their technical relevance, as understood by the skilled person, incorporates - and may even be considered to be fully determined by - the effects that they provide. Similarly, a claimed sub-range of 45-65% of a certain parameter compared to a prior art range of 40-70% may render novelty to the claimed sub-range if there would be some kind of new physics in the sub-range of which the existence is not known from the known end points 45 and 65%.

In view of this, the three criteria of T 198/84 should not be seen as independent, isolated tests, but the purposive-selection criterion may also play a role also for the narrow and far-removed criteria, as it gives technical meaning to the subject-matter associated with the respective values.

Principle of legitimate expectations

A change of the novelty-test for sub-ranges has a major impact on various existing and new cases: it changes the definition and the effect of the prior art and it also changes the definition of the "same subject-matter" in the context of amendments and of the "same invention" and the "first invention" in the context of priority (Art. 87 EPC). In my view, such an important change cannot occur silently, but would at least require an explanation in the Official Journal, either from the Enlarged Board or from the EPO. In view of the good faith requirement (principle of legitimate expectations), such a change would need to be announced far in advance such that the applicant can take it into account when drafting an application, during the substantive examination of his application, as well as during any subsequent opposition and/or appeal proceedings. In my view, making a new interpretation that goes against a long-established practice also applicable for already filed applications goes against this principle.

The Guidelines should be a reliable source of legitimate information. Established practice can -by definition- not change instantly by amending the Guidelines if it is not due to a change of the legal provisions, a T/J-decision on a topic for which there is no established case law yet, or a G-decision; none of which apply in this case.

Established case law can - by definition - not change instantly, unless there is a G-decision that overturns the earlier main way of reasoning; which there is not in that case. Also see Case Law Book (9th edition, 2019) III.A.1.1:

"1.1 Sources of legitimate expectations

Sources of legitimate expectations include information provided by the EPO in individual cases (e.g. in the form of communications to the party), information contained in official statements of general applicability and published by the EPO (e.g. the **Guidelines** and the Official Journal), established practice of departments of the EPO, and decisions taken by the Enlarged Board because of its special role (see J 25/95 and the decisions given on the same day, namely J 14/95, J 15/95, J 16/95, J 17/95 and J 24/95; see also T 905/90, OJ 1994, 306, Corr. 556). **The case law of the boards of appeal may also be a source of legitimate expectation, in particular, if it is established case law which has become enshrined in the consistent practice of the department of first instance (see J 27/94, OJ 1995, 831; see also in this chapter III.A.5)**. Courtesy services provided by the EPO may also be a source of legitimate expectation (see J 1/89, OJ 1992, 17; see also in this chapter III.A.2.2)" [emphasis added]

Even though the recent editions of the Case Law Book indicates that there is also some conflicting case law, the Case law Book (2019) takes a clear position as to what is the established case law, in I.C.6.3.1 "Selection from a broad range":

"The principles applied by the boards of appeal **as part of their established case law on the novelty of selection inventions were developed in particular in T 198/84** (OJ 1985, 209). They are summarised briefly in T 279/89, according to which a selection of a sub-range of numerical values from a broader range is new when each of the following criteria is satisfied: […].

> The Guidelines recall the three criteria (see G-VI, 8 (ii) – November 2018 version).
>
> The three postulates for the novelty of a selected sub-range are based on the premise that novelty is an absolute concept. It is therefore not sufficient merely for the wording of the definition of an invention to be different. What has to be established in the examination as to novelty is whether the state of the art is such as to make the subject-matter of the invention available to the skilled person in a technical teaching (T 198/84, OJ 1985, 209; see also T 12/81, OJ 1982, 296; T 181/82, OJ 1984, 401; T 17/85, OJ 1986, 406)." [emphasis added]

Except for the addition to the reference to the Guidelines, the text has been unamended in this wording in the Case Law Book since the first edition of 1993, including the explicit indication that "The principles applied by the boards of appeal as part of their established case law on the novelty of selection inventions were developed in particular in T 198/84 (OJ 1985, 209)".

It violates the principle of legitimate expectations to deviate from what the Boards have consistently referred to as established case law for over 25 years. Such a change could in my opinion only be appropriate if there would be a decision of the Enlarged Board of Appeal that overturns the established case law. In the absence of such a decision, it is difficult to see a justification for the amendment made to the Guidelines with the 2019 edition.

3. Consistency with the criteria for overlapping ranges

Guidelines G-VI, 8(iii) addresses overlapping ranges; this section is not amended in the 2019 edition. In my view, deleting the "purposive selection" criterion from the sub-range test is not consistent with the criteria, arguments and clarification given in the Guidelines for novelty of overlapping ranges.

In my view, the tests for novelty of overlapping ranges are consistent with G 2/10 and maintaining them unamended in the Guidelines is correct and appropriate. Guidelines G-VI, 8(iii) provides:

> "It has to be decided which subject-matter has been made available to the public by a prior-art disclosure and thus forms part of the state of the art. In this context, it is not only examples, but **the whole content of the prior-art document** which has to be taken into consideration." [emphasis added]

and

> "It is not sufficient to exclude specific novelty destroying values known from the prior-art range, **it must also be considered whether the skilled person, in the light of the technical facts and taking into account the general knowledge in the field to be expected from him, would seriously contemplate applying the technical teaching of the prior-art document in the range of overlap**. If it can be fairly assumed that he would do so, it must be concluded that no novelty exists. In T 26/85, the skilled person could not seriously contemplate working in the area of overlap, since the prior art surprisingly contained a reasoned statement clearly dissuading him from choosing said range, although the latter was claimed in said prior art." [emphasis added],

i.e., G-VI, 8(iii) recognizes, in the first two cited passages, the concepts of G 2/10 in that prior art is not just numeric values, it comprises a technical teaching. It emphasizes that it is not just the numerical values, but the what is understood as well as seriously contemplated from the prior art as a whole.

GL C-VI, 8(iii) also provides:

> "The concept of "seriously contemplating" is fundamentally different from the concept used for assessing inventive step, namely whether the skilled person "would have tried, with reasonable expectation of success", **to bridge the technical gap between a particular piece of prior art and a claim** whose inventiveness is in question (see G-VII, 5.3), because in order to establish anticipation, there cannot be such a gap (T 666/89)." [emphasis added]

I.e., G-VI, 8(iii) recognizes that novelty is about lack of technical gap and inventive step is about bridging the technical gap. As G-VI, 8(iii) also provides that

> "In the case of overlapping ranges (e.g. numerical ranges, chemical formulae) of claimed subject-matter and the prior art **the same principles apply** for the assessment of novelty as in other cases, e.g. selection inventions." [emphasis added]

Hence, in my view purposive selection needs to be maintained as part of the novelty test for sub-ranges: **without purposive selection, there is no technical gap between a prior art range and a claimed sub-range**. Thus, in my view, maintaining the test for overlapping ranges while amending the test for sub-ranges results in embracing conflicting principles for the two situations (see discussion above), while the current tests for the novelty of sub-ranges (i.e., including purposive selection) is fully consistent with the test for overlapping ranges and, at the same time, both embrace the principles of G 2/10.

Conclusion

In this article, it is argued that the test for novelty of a claimed sub-range of a known range should include the purposive selection criterion, as it did in the Guidelines until the revision of November 2019. Even though a decision of the Enlarged Board would be strongly preferred to clarify the situation, the purposive-selection criterion seems to be consistent with the principles of G 2/10 ("gold" standard), whereas a novelty test that excludes the purposive-selection criterion (i.e., is only based on comparing numerical values) seems to fail to recognize what the skilled person would directly and unambiguously derives from the prior art disclosure as a whole (i.e., the broader range and the technical meaning of the prior art subject-matter within its broad range). Further, it is argued that the purposive-selection criterion for sub-ranges is based on the same principles as the seriously contemplating concept for overlapping ranges: the whole prior art disclosure is to be taken into account and, for novelty, there must be a technical gap between what the skilled person would directly and unambiguously derive from the prior art disclosure as a whole and the claimed subject-matter with its sub-range. As first instance practice will suddenly change per 1 November 2019 due to the change to the Guidelines and the situation at second instance is also uncertain in view of conflicting Case Law, there is a strong and urgent need for alignment at first instance (via consistent Guidelines) as well as at second instance (via a referral to the Enlarged Board of Appeal) to provide for clarity as well as legal certainty for applicants and third parties.

The author wants to thank Cees Mulder, Derk Visser and Jessica Kroeze for discussions on the topics addressed in this article and for reviewing its draft versions.

Educational events

Tutors' Report on the EQE 2019 Papers

and the Meeting between Tutors and EQE Committees

N. Cordes (NL), L. Ferreira (PT), A. Hards (DE), K. Hartvichova (CZ),
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 of EQE tutors and members of the EQE Committees , usually referred to as "the Tutor meeting". 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 Examiners Reports. 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 18 October 2019, with a dinner on the preceding evening hosted by the **epi**. The participants list showed 87 registered participants (tutors, other EPO and **epi** members from the Academy, EQE secretariat and **epi**. Also, about 15-20 Committee members and Examination Board members were present.

All registered participants were invited to submit questions for the Committees by email via the Academy, at the latest one month prior to the meeting. The Academy made a compilation of 26 pages with all questions, which was distributed to the committee members prior to the meeting and available for all participants. During the meeting, additional questions were asked. The questions were addressed by the Committees when discussing the papers. The answers are incorporated in this report, and can be used to supplement the information from the Examiners Reports.

This Tutors' Report contains the following sections:
1. Pass rates EQE 2019; 2. General remarks; 3. Paper A; 4. Paper B; 5. Paper C; 6. Paper D; 7. Pre-Exam; and 8. Concluding remarks. .

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 go to the tutors who asked questions and contributed to the discussions.

My special thanks to -in alphabetical order- Nico Cordes, Luis Ferreira, Andrew Hards, Katerina Hartvichova, Harrie Marsman, and Sander van Rijnswou for finding time to prepare the individual paper summaries.

We all wish you good luck in 2020,
Roel van Woudenberg (editor)

1) Pass rates EQE 2019

In 2019, 813 candidates out of 920 (88%) who passed the Pre-Exam, the highest pass rate since 2015 (2018: 74%; 2015-2016-2017: 76%). 672 out of 1746 candidates that took at least one paper candidates passed the EQE (compared with 528 out of 1696 last year).

For the individual main exam papers, paper A showed a much higher pass rate and B a considerably lower pass rate than last year (which showed similar similar pass+compensable fail rates as in 2017); the pass+compensable fail rate for C was similar to last year (and 4%-point higher than in 2017); the pass+compensable fail rate for D went up from 45% to 60% and is 15%-point higher than last year (when it was 8%-point lower than 2017) and is, together with the 2015 D paper, the highest since the introduction of the 5-hour single-paper format.

The official results for each paper, as published on the EQE website and dated 24 June 2019 for EQE2019, are as follows:

EQE 2019*	#Candidates	PASS	COMP.FAIL	FAIL
Pre-Exam (4h)	920	88,37%**	--	11,63%
A (3½ h + 30 min)	1002	79,24%	5,49%	15,27%
B (3h + 30 min)	819	52,63%	10,26%	37,12%
C (5h + 30 min)	1043	49,57%	9,59%	40,84%
D (5h + 30 min)	1198	49,50%	10,85%	39,65%

*Note: as of 2017, the ABCD papers are designed according to Rules 23-27 IPREE as 3½h, 3h, 5h and 5h respectively, but all candidates are granted an additional thirty minutes per paper to these durations (by Decision of the Supervisory Board of 17 November 2016).
**Note: the results are based on the original Examiner's report, where two statements (19.1 and 19.2) were neutralized. It is not known whether appeals have been successful in interlocutory revision or before the DBA; at least one appeal is pending before the DBA.

2) General remarks

On the evening before the meeting, all participants were invited to a networking dinner, hosted by the European Patent Institute, in the center of Munich.

Opening words
The meeting itself opened with words of welcome and introductions by Jakob Kofoed (Chair of the Examination Board), Francis Leyder (President of the **epi**) and Giovanni Arca (Academy). Also, there was a demo booth from Yolanda Sánchez García (European Patent Register product marketing manager, Patent Information, EPO).

Jakob Kofoed indicated that 2019 was an EQE year with no major incidents, normal pass rates and normal fluctuations between the papers. The Pre-Exam seems to meet its purpose, as "the better people pass the Pre-Exam, the better they pass the main exam". A pilot was run for a computer-based EQE (main exam) with 15 candidates; this will be extended to 80 candidates at EQE2020 and more and more later, esp. also Pre-Exam.

Francis Leyder emphasised that the EQE plays a role in getting high caliber professionals, where preparation for the EQE develops knowledge, skills and abilities. A high pass rate is not the target: some candidate deserve to fail. Every year, about 500 new professional representatives enter on the list and about 250 leave from the list. Today, there are about 12.750 professional representatives on the list. A computer-based Pre-Exam would be highly welcomed. With respect to the EQE2019, only a few appeals were filed.

Giovanni Arca commented on the setup of the meeting: this year, all plenary sessions were directed to EQE papers, with a demo booth in the lobby. The Academy and the meeting are also meant to maintain and develop the relationship between four parties: committee members, tutors (who submitted 26 pages of questions to the committees), Academy and **epi**.

General comment
A tutor observed that in recent years, the Guidelines are amended every year with often quiet relevant changes to the claims interpretation / analysis chapters. e.g., from 2016 to 2017 the introduction of summons to oral proceedings as first action in examination; from 2017 to 2018 the essentiality test was no longer considered sufficient to satisfy Art. 123(2) EPC and a change was made in interpretation of the terms "about", "approximately" and "substantially"; and from 2018 to 2019 the deletion of purposive selection from the novelty-test for a subrange. Thereby, the tests that need to be applied according to the IPREE (Guidelines on 31/10 of year before exam) are no longer the relevant tests when the exam is taken (which requires GL of 1/11 of year before the

exam = same as valid on exam). The Examination Board and Committees were asked to comment on how the Pre-Exam, A, B, C and D committees deal with these late changes, to confirm that the test of the Guidelines of November 2018 (as being the ones in force on 31 October 2019) are the relevant tests on EQE 2020 and to indicate whether the committees would also give full marks to answers that are based on the amended/ new/ different tests in Guidelines of November 2019. The Pre-Exam committee commented that they aim to only have questions that are not affected by a change to the Guidelines in the autumn before; the D Committee commented that it is required to answer using the syllabus (on 31/10), but that usually marks are also awarded if reference is made to the new Guidelines provided that its edition is clearly indicated.

3) Paper A by Andrew Hards and Katerina Hartvichova

Liz Elmhirst gave the presentation on paper A. The presentation was authored by Liz Elmhirst, Matthias Kollmannsberger, Wim van der Poel and Andreas Böhm-Pélissier du Besset. Also present was Nicolas Favre (Chairman of EQE Examination Committee I).

2019 marks the 3rd time since the technical fields of chemistry and mechanics/electrical were combined to create a consolidated drafting paper A. This setting is still problematic due to diverging case law in the different technologies and the loss of specialisation in what is testable. On the other hand, candidates are expected to be knowledgeable about the legal practice in other fields, especially when these can be applied generically, such as the extensive jurisprudence on parameter ranges. Nevertheless, this year there was a high pass rate of 79 % (fail 15 %, compensable 5 %).

The topic was a chamber for cultivation of cells, i.e., a mechanical device with a biotechnological use. The technical problem was to improve the cell growth rate by increasing gas exchange. The solution was an upper and lower gas-permeable membrane on opposite sides of the frame. A key feature was to indicate the position of the membranes relative to the frame. However, substances still needed to be introduced to the chamber. This could be done in two ways and both were suggested in the client's letter. Either an aperture in the frame or at least one of the membranes needed to be resealable. In a third embodiment, the alternatives were combined.

A major challenge was to formulate all three alternative embodiments in a single claim using "and/or". Instead, drafting of three independent device claims was also accepted, but the subsequent dependent claims were difficult to consolidate, and the claim structure became messy. This is a good educational point, as such claim drafting techniques are invaluable in daily practise. The device claim(s) secured 42 marks in total.

A method of using the device (8 marks) and a method of production of the device (7 marks) were also expected, however, these must refer back to the device, as the methods themselves are known.

A difficulty that many candidates faced for the resealable membrane embodiment was failing to state the essential feature that: "the adhesive is pressure-sensitive." On the other hand, optically transparent membranes or adhesive coatings should not be claimed as they are known in the art. The claims also required a resealable opening somewhere in the device (loss of 30 marks).

Rather unusually, 27 marks were available for dependent claims, instead of the typical 15 claims from the last years. Importantly, a dependent claim containing several alternative features is only awarded marks for the first (maybe second) fall-back position. This is surprisingly different from real life practise, where alternatives are often formulated in claims to increase clarity (and save claims' fees). However, the exam committee does not wish to see the 15-claim limit in the exam circumvented by bunching of fall-back positions in dependent claims. Thus candidates should avoid alternatives in dependent claims as well as (overuse of) the indications „preferably" or „optionally". Good fall-back positions are features that do not appear in the prior art or those with an effect and a new inventive step argument, or features pinpointed by the client as important for his business.

There was an extensive discussion at the tutors meeting on the two-part form. Using the two-part form gains a couple of marks, but a correct identification of the distinguishing features from the prior art in the description was considered equivalent.

For the description, a discussion of the prior art documents was expected. Also, the technical problem underlying the invention should be defined. The features directly relevant for solving the technical problem and the way in which they solve it should be mentioned; this latter discussion is becoming increasingly relevant in paper A (5 marks). The rest of the description should support the claims. Converting the clients letter into the description, possibly by cutting and pasting passages from the paper seems efficient and acceptable. The examination committee is flexible as regards the length of the description, as long as the above elements are present. The description afforded 16 marks in total.

This year's paper had a simple mechanics claim structure, but in a biotech setting. The solutions/embodiments were not too difficult to identify from the client's letter, which was reflected in the relatively high pass rate.

4) Paper B by Harrie Marsman & Luis Ferrera

For Paper B, Davide D'Alessandro (EPO, main drafter) and Jens Sebastian (**epi**) attended the meeting. Nicolas Favre (Chairman of EQE Examination Committee I) was also present.

Davide gave the presentation on the Paper that has a pass rate of 52.6%.

Paper B was on an application dealing with solar cooking, cooking using solar radiation. The core of the invention was the use of a salt in storing heat for situations where the sun was not available. Especially, the storage of heat is associated with a phase change of the salt. Out of curiosity, the drafters shared a link where they had found initial inspiration for the invention:
https://spectrum.ieee.org/energywise/green-tech/solar/solar-cookers-get-hot

The drafters gave an overview of the paper, discussed the prior art and official communication, and the client's instructions and claims. Expected claims, expected arguments and inferior solutions were then discussed. This has also been covered in the very complete Examiner's Report.

Main issues in the paper were the presence of 2 independent claims that needed (for full marks) two separate discussions on inventive step using 2 different closest prior art documents (20 marks to earn for each independent claim); and the construction of a range in the product claim that brings novelty and inventive step and has support in the application as filed. What was emphasised a couple of times is that it is very important to follow the client's instructions. First, as was the case with the previous single papers B, the points for the claims are coupled to the amendments proposed by the client. Second, the comments and suggestions of the client are really intended to assist the candidates to find the solution. The client is the authority in terms of the commercial products to be protected. Rule 24 IPREE was cited for emphasising that it is the client who instructs about the way to proceed with the application: "it is about amending the claims of the client, according to the client's instructions letter, in order to meet the requirements of the EPC".

To avoid the claims being amended in a way not intended by the client, it may be easier to work with the set of claims having the amendments proposed by the client. Thus that you do not miss the client's suggestions. It was also felt that there was not a significant advantage by cutting and pasting. Candidates used all the possible approaches: rewriting the claim set (sometimes with the risk of incurring in added subject-matter), either using the claims as filed (sometimes forgetting client's instructions), or using the claims as proposed by the client (less to be changed).

In addition, it was confirmed that the position taken by the Examiner is essentially correct. Only if it is very clear that the Examiner is fundamentally wrong, this position should be challenged. However, it was reminded that there are not absolute rules for this and verifying the content of official communications is part of the job. For example, the client's instructions may give a pointer to this or an abridged or even incomplete inventive step objection may invite further review.

In Rule 24 of the IPREE, it is indicated that the candidate has to respond to all points raised in the official communication. *A contrario*, if there is no objection of non-unity raised, you do not need to address the issue of unity-of-invention.

It was also stressed that by not responding to all the points raised in the official communication, a number of candidates were losing some marks that were relatively easy to obtain.

On the process claim, the client suggests not to introduce a temperature range. What matters is that the salt is not only present, but is able to melt. This should bring you to the correct wording of the suggested claim 1.

For the independent product claim, it was clear that the client did not wish to claim salt composition A. What was expected was that the salts to be used had a melting point in the range of 130-350 degrees Celsius. The value of 130 degrees is based on the individual number for a specific salt, but this value is not based on an unallowable intermediate generalization.

About 50% of the candidates found the temperature range in view of paragraph 7. It was nevertheless mentioned that the remaining candidates were not seriously penalised for missing this.

If you used a disclosed disclaimer for salt composition A, you did not get full marks. Reasons were that this was not as indicated by the client, the defence for inventive step was more complicated, nor would it be supported by the task to give the client the broadest possible scope of protection. The latter is a requirement for paper A, not for paper B (see Rule 24 of the IPREE).

It was also reminded that "wherever possible, the claim should be limited by a positive indication of what subject-matter remains instead of stating what is being deleted", GL H-V 3.3. See also Case Law of the BoA - II-E 1.3.2 and T 201/83 (OJ 1984, 481) about forming a range with a value isolated from an example. We note this passage of the Guidelines was added in Nov.2018. As usual, candidates are well advised to include in their study any recent amendments to the Guidelines, in particular part H for paper B.

If you used a disclaimer, it was not expected to provide arguments why this disclaimer would be specifically allowable under G 2/10.

For the argumentation of inventive step of the independent claims, there was a total of 40 marks. 20 marks for the defence of the process claim and 20 marks for the defence of the product claim.

For the product claim, D1 was the closest prior art. For the process claim, D2 was now the closest prior art document. In the client's letter, a hint was given by the statement on sodium chloride which would not store heat as required by the invention, because sodium chloride does not melt at the indicated temperatures – "far higher than normal cooking temperatures". This links D2 to an effect.

All possible prior art combinations had to be discussed to attract all marks.

If other documents were selected as closest prior art or if the problem-solution approach was made for the combination of the product and process claim, you did not get all marks but at least some. As usual in the exam marking, a mistake is only penalised once and follow-up errors, as much as they relate to a previous mistake, are not penalised repeatedly.

As indicated above, the Examiner's Report is quite detailed and should be read attentively.

5) Paper C by Sander van Rijswou

Present for paper C and answering questions were: Celia Martínez Rico, Paolo Provvisionato (chair of the committee) and Sophie Creux.

Sophie Creux gave the main presentation for Paper C 2019; introducing the topic, its problems and the expected solution. This mostly followed the Examiners' Report for Paper C 2019. The notes below focuses on the additional information provided during the meeting.

References
One of the challenges was to digest all the information and make sense of it. For maximum points one should:

- use the information provided
- identify features in the annexes
- need to reference where the feature was found.
  A specific reference in the relevant document should be given. For example:
  - Paragraph number
  - Line number
  - Reference sign
  - Claim number
  - Figure number

Different terminology
Different terminology between claims and prior art should be addressed. For example, claim 5 requires comparing 'steam dispersing ducts' with 'steam passages'. For example, one could rely on section [0002] to argue that they are the same. One could also explain that they have the same function and that no differences are implied by the different wording. These would give the same marks.

Substantiated choice of closest prior art.
We don't want anything more than the Guidelines.
- Purpose is a very important thing
- Minimal structural modifications
- Minimal number of difference features is less strong

Example for claim 4: Annex 6 has the same purpose of domestic use as claim 4. It requires the least structural changes, (already internal water tank).

Combination of documents, "how and why"
Argue why starting from the closest prior art, how and why you get to the claim.

How (replace an element, select a specific material, add a feature etc.)
Claim 2: skilled person would replace the KeraTix layer of Annex 2 by a KeraMa layer, and choose aluminium as a suitable low density material for making a lightweight iron without changing the intermediate layer of Yur56

Why (hindrances, incentives, etc.).
Claim 5: the tilted passages may be used in all types of ironing devices not only in the ironing press of Annex 5. At least you should argue why the secondary document has the same problem, but also give the incentives or absence of hindrances.

Claim 1
The novelty attack on Claim 1 based on A4 was found by about 100% of the candidates. Also, the vast majority of the candidates spotted the added subject matter in Claim 1. Wording of the added subject matter attack didn't matter so much as long as the addition was pointed out and reference was made to sections [0006] and [0007].

For the KeraSi variant in Claim 1 an inventive step attack was expected starting from the first series of tests in A4. The effects of KeraMa and KeraSi are the same and so the objective technical problem should be to provide an alternative.

An alternative inventive step attack on claim 1 could start from the second series of experiments in A4. Although not impossible to attack the claim in this way, to attract marks, a candidate needed to spot two things: that the alloy is presented as essential and that Yur74 cannot be combined with aluminium. Also, the candidate needs to explain how to overcome these difficulties. An attack like

this is not as good as the expected attack, since it is not straightforward.

Claim 2
Claim 2 was limited to KeraMa to reduce the number of attacks that a candidate needs to perform. It was expected to start from A2 and to use partial problems.

An attack starting from A4 has the issue that it is a dry iron, and has a special construction with the heating element on top. You need to create holes and change the heating element.

Claim 3
It was expected to build on from the attack on claim 2, using A2. For claim 3, the best starting point was much better identified. The vast majority that attacked claim 3, started from A2.

If a candidate had no attack for claim 2, or an attack that could not be understood, then the candidate would get 0 marks for claim 2, but if claim 3 is attacked in the correct way, then some of the marks of claim 2 were also awarded.

Claim 4
An inventive step A6+A2 was expected.

Some candidates started from A2 and argued that you could just put a water tank in the iron. But the embodiment in A2 has a thin main body. Moreover, A2 focusses on removing weight. To attract marks for an attack based on A2, you would have to identify this issue and explain convincingly how you would overcome it. For example, a candidate could argue how the skilled person would adapt the thin body to accomodate the tank.

Claim 5
For claim 5 it was expected to continue the attack of claim 4.

Claim 6
Novelty attack with A3 was expected. The main issue was the use of information in A3. A good attack needs to rely on the text to find the steam iron, also to find steam nozzles / steam outlets. Then one should consider the figure.

Claim 7
A3 is available. Since a novelty attack on claim 6 is already done, it is reasonable to start from the novelty attack. A candidate who tried the reverse combination could gain some points.

Q&A
After the presentation, questions from the tutors were answered.

Q: Do you lose marks if you do not cite the guidelines for the product by process feature?
A: Actually, since paper C is marked positively, it's not that you lose marks but that you do not gain marks. Sometimes legal marks are available and sometimes not. In this paper, it was expected to cite the Guidelines. A candidate should be aware that this situation is very specific and that there are special rules for this situation.

Q: How many marks are lost if Claim 1 is attacked by inventive step instead of through novelty?
A: I think they would lose marks, just a few marks. You could also get marks for claim 1 if you did an inventive step attack on a different claim starting with the same document. Novelty attacks are better since they there is less to argue.

It all depends on how it is written. It depends on the choices. For a straightforward novelty attack, one may be penalized more but if the novelty attack was overlooked because of a specific word, then it is different. It always depends on the explanations of the candidates. How it is written may also make a difference in real life, that is why what is written, and how it is written, is given so much weight.

Marks may be awarded even for a wrong attack, if the way it is written makes clear that the candidate may be a good attorney, or at least not a bad attorney. However, this does not hold for serious mistakes though. Those are penalized.

Q. What is the limit for points if you take the wrong starting point?
A: We don't know. There is a quite detailed internal marking scheme for expected answers. But if you are not on it, it depends on how it is written.

Q: So if you have all the arguments available to you, you would get full marks?
A: The majority of candidates follows what is expected. Some unexpected attacks occur more often, e.g., switching and they also covered. Every individual answer has to be marked on its merits. That is easier if the attack was the expected one.

A good but unexpected answer could be awarded of all the marks. But it is very rare that an unexpected answer is perfect and achieves full marks. This is because Paper c is built as a puzzle. There are indications that should lead to considerations. If you start with an external tank, which has the purpose of low weight, you can never attract full marks if you don't address that problem. [Referring to claim 4].

After the questions, explanations were given on how to deal with the notice of opposition form in the future.

Opposition form

Rule 25 IPREE has changed (OJ 2019, A66); the provision of the form was deleted. There have always been problems with the form (e.g., to have the correct version of the form in the exam paper), but the trigger for discarding the form was because it no longer provides the option to indicate payment. In future, candidates are still required to make their opposition admissible, following Art. 99, Rule 76, etc.

Since no form will be provided, you are not allowed to hand one in. This is quite clear. A candidate can bring a form, if it helps him, but the candidate cannot hand the form in (Instructions to the candidates, OJ 2019, Suppl 2, 36-40, I.9(d)). If you do hand in the form, it will, at a minimum, be discarded, but you may be penalized.

A candidate will need to indicate that he has paid the opposition fee, by putting it in his answer paper. For example: I pay the fee by credit card or deposit account, etc. This is essential. You also need to identify the patent, and any other essential information to make the opposition admissible.

The possible answer for paper C 2019 in the Examiners' Report does not refer to the form, so this is something candidates could look at.

6) Paper D by Roel van Woudenberg

Representing Examination Committee III: Tiem Reijns (chairman), Magali Degrendel (main drafter DII), Anja Schmitt (coordinator D2019; will leave to the Boards of Appeal), Simone Fausti (new coordinator).

General remarks (Tiem Reijns)
The pass rate of D 2019 was 49,5%, compensable fails 10.9%.

Overall positive comments from the blogs and tutor comments: fair questions, not overly difficult, not too long, even "predictable". It seems that the exam was a little easier than the last few years.

Higher pass rate compared to the last few years, likely because the legal assessment (Part II) was perceived to be more straight forward than the last few years.

Despite a higher pass rate, many candidates focus on (and start with) the legal assessment. As observed also last year, candidates skipping entire Part I questions are generally not successful, because thorough legal knowledge is also required for a good legal assessment.

The paper length will remain similar to the last 5 years, with the 30 min extra time being extra time: 5 h + 0.5 h for revision. Only legal basis from the syllabus in REE/IPREE is legal basis; alternative legal basis is sometimes accepted too. Candidates using the latest guidelines were NOT be penalized. But the advice is to stick to the syllabus, and to indicate the GL year if a newer version is used.

Answering and marking
The purpose of the Examiners' report is to help future candidates prepare. The Examiners' report shall be read as the correct factual answer for 100 marks. In some questions alternative answers attracted marks, but only the best answer is in the Examiners' report. Some additional comments were awarded extra marks (sometimes referred to as bonus marks), e.g., if part of answers in blogs.

In principle, all information in a question is relevant. Candidates should answer the question, and should not speculate. Giving both a correct and a wrong answer to the choice of the marker, will not attract any marks. Full legal basis is what is needed to support the answer in full: Article and/or Rule and/or Guidelines and/or case law, whatever is needed to support all aspects of the answer. Alternative legal basis often attracts (full) marks.

Blogs are checked as well as an extensive pre-marking to come to the possible solution and the marking sheet, and possible alternative interpretations of parts of a question or alternative answers.

As guidance to how much of "answer" is required for full marks, Tiem indicated that the Committee takes a lot of effort in choosing the wording of the question in such a way that there is a trigger for each answer aspect and there is a clear exclusion for time consuming extra answers. Advice to candidates is to address all aspects in their answer, not use own knowledge/experience, and not discuss aspects for which there is no trigger/reference in the question.

Some tutors asked if marks / bonus marks are awarded for statements like: "No fee for a third party observation", "the (EPO as) ISA does not verify if priority is validly claimed", "what happens if a translation is not filed?". Generally, no marks are awarded for things that do not happen, things the attorney/client does not need to do, and actions that are not to be taken. Candidates are advised to not write about such things that are not triggered by the question.

When answering, "Today" is the day of the exam.

Reminder - change of the format as of D 2020
Readers are reminded of the change to the D papers as of D 2020. Reference is made to the Notice from the Examination Board of 13.03.2019 (on EQE website), and the

publication T. Reijns, chairman of the D Committee, "Announcement on the EQE – Paper D" in **epi** Information 4/2018, page 25[1].

There is ONE Paper D: any reasonable variation of marks to the DI and DII parts (e.g. between 40:60 – 60:40) should be expected from 2020 onwards. Candidates can expect that the full range will be used over the next years.

DI-part: summary of the paper

The DI part, still of 40 marks, of the 2019 D paper again had a variety of topics ranging from entitlement, third party observations under EPC and PCT, missing claims under EPC and PCT, priority, to debit accounts. Scoring about 20 marks in 1,5 hours or 25 marks within 2 hours seemed feasible for a well-prepared candidate; the Committee also indicated that the average DI score was higher than usual.

The first, 9-mark question, was directed to stay of proceedings just after a R.71(3) communication was received, resumption (incl. time limits) and acts to be done after resumption to proceed to grant with amended claims and to continue with the other independent claim in a separate European patent application. The second, 8-mark question asked what a client could do while a PCT application is pending during the international phase and during the EP regional phase in view of alleged relevant prior art and in view of an alleged lack of clarity, and was checking the differences in requirements for filing third party observations between both systems. In the third, 9-mark question, the client had filed on the last day of the priority period an application X claiming priority from an earlier application, but the application X lacked claims; an article was published in the priority period describing subject-matter of the missing claims. Also in this question, the differences between PCT and EPC were tested, here w.r.t. missing parts/elements. The fourth, 7-mark question was directed to priority, in particular invalidity of priority due to a first application problem and whether a translation of the (Korean) priority application would be required during an opposition. The last, 8-mark question was directed to automatic debiting in the international phase, in particular to insufficient funds to pay the additional search fee in view of non-unity, and the effect of replenishment after the time limit as well as the effect of a timely filed order to a banking establishment in a contracting state to transfer a large amount to the deposit account (which so far failed to actually be executed in time).

The answers to the questions are given in the Examiners' Report. It also indicated, as every year, important guidance for answering (e.g., "Candidates are reminded that they should pay attention to the way the questions are asked") - most of these points were also emphasized at the meeting (see above under "General remarks" and "Answering and marking").

DII-part: summary of the paper

The DII paper of 2019 related to shoe soles for running shoes. Your client is a German shoe manufacturer, FASTER, whose main markets are Germany and Austria and whose only factory is in Germany. Its owner found out that all metal nanoparticles modify the foam structure of a shoe, thereby improving the energy storage of the shoe sole. The increase depends on the type of material (any metal, in particular copper; Silica) and on the size of the nanoparticles. Slightly more than a year ago, your client had filed several patent applications, EP-F1, EP-F3, EP-F2. Only EP-F2 claims priority, from EP-F1. An Australian competitor, HIKE, is also active in the field of running shoes, and has its only factory in Austria. HIKE made several announcements of the Internet, and has two patents: a national Austrian patent AT-H with a broad claim scope, and a European patent EP-H which has a problem with its translation (EP-H was originally filed by a Chinese company, LONGRUN, in Chinese, and the English translation has a major error in it). There is also a Mr Furious, a former employee of tours, who sold information to HIKE when he was angry for not getting promoted.

In this paper, analysis of priority was a key topic, and partial priority was present very pronouncedly -as expected-. Mr Furious' acts are an evident abuse against your client, and gave the opportunity to file a new application for Silica nanoparticle soles.

Answering required a careful analysis of priority, as some of the claims benefited from partial priority (G 1/15), an addition of a priority declaration to remove some prior art and get a claim patentable, amendment to get a claim patentable, effect of wrong translation on 54(3) effect and on validity of the granted patent with the error (123(2) as well as 123(3)), opposition, London Agreement and validation, protection conferred, cross-licensing. Partial priority had to be assessed in view of combinations with genus-species metal-Cu and ranges "any", <80, <40, 35-80, 70-80 - this made a challenging DII. The pass rate of the D-paper was nevertheless very high (one of the highest since the introduction of the 5-hour paper).

1 T. Reijns, chairman of the D Committee, "Announcement on the EQE – Paper D" in **epi** Information 4/2018, page 25: "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). […]
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."

A possible solution to the DII is given in the Examiners' Report. The Examiner's Report also indicated that "Candidates generally did well on the analysis and spotted most of the relevant relationships between the various rights and how they affect the freedom to operate of the parties involved.", "It is noted that candidates who immediately proposed improvements without fully analysing the situation as outlined in the paper, missed a lot of relevant issues", "The majority of candidates noticed that EP-F2 contained subject matter that was not covered by its priority application EP-F1. Only some candidates made the right assessment and distinguished between the different parts of the "OR-claim". Many candidates also did not recognise the consequence of partial lack of novelty for the claim as a whole", and "The possibility of adding a priority claim to EP-F3 in EP-F2 was also generally well recognised. However, while the candidates understood that the earlier effective date added another part to the "OR-claim" they neither applied it to the partial (lack of) novelty of specific parts of the "OR-claim" in their original assessment, nor did they realise that just adding the priority claim without making claim amendments is not sufficient to get a granted patent out of EP-F2".

Comments from Committee

The Committee commented on the questions submitted prior to the meeting and addressing various specific items in DI and DII questions.

Questions in the DI part

Tiem Reijns commented on the questions submitted w.r.t the DI-part.

Effect of stay on due date and periods for renewals: discussion (Q.1)

The answer in the Examiner's Report to Q.1 comprises "According to Rule 14(4) EPC, the period for payment of renewal fees is not interrupted. Company B should make sure the renewal fees are paid (if not by A, then by B) during the stay".

A tutor challenged the latter conclusion, as that tutor argued that Rule 14(4) provides what happens to time periods for renewals (running at the date of the stay), but does not indicate what happens with due dates for renewals falling due/having fallen due after the stay, nor to 6m-periods of R.51(2) that were not yet running at the stay but only thereafter. The tutor argued that, in view of the legal effect of the stay as described in GL (2018) A-IV, 2.3 ("neither the EPO nor the parties can validly perform any legal acts while proceedings are suspended (J 38/92)"), the effect on due dates should be the same as in the somewhat similar situation of R.142. There, the Guidelines as well as the case law are clear (GL (2018) E-VII, 1.5; J 902/87). The tutor concluded that, in his view, the answer should read: "The period for paying renewal fees is not interrupted – R. 14(4) -, but their due date is deferred until the date the proceedings are resumed – GL (2018) E-VII, 1.5 mutatis mutandis / J 902/87 mutatis mutandis. So, any renewal fee falling due between the date of stay and the date of resumption must be paid by the date of resumption."

The Committee indicated that is a difference between "stay" and "interruption of proceedings" in that the wording of the rules and the purpose/background is different, and, in case of bankruptcy, payment is impossible whereas in case of entitlement proceedings, that is different as anyone can pay.

The point seems to remain open. As only few candidates addressed the effect on renewal fees, the effect on obtained marks is probably anyhow small.

Effect of stay on divisionals (Q.1)

Filing a divisional (directed to the subject-matter of claim 3) can only be done after resumption (J 9/12), this is part of the required answer, not a Bonus point. The correct legal bases is J 9/12, as Case Law is "higher" legal basis than the Guidelines, but alternative Case Law or the correct GL reference was awarded full marks as well.

Third party observations in PCT (Q.2)

More candidates than expected missed the issue that third party observations in PCT cannot be directed to clarity.

Missing parts (Q.3)

Missing parts were done very well, except that some candidates wrongly used it also for missing claims under the EPC.

Translation of priority (Q.4)

Since Question 4(b) only asks if a translation is required in opposition proceedings, the only thing that needs to be discussed is if the translation is relevant to the priority claim. Candidates should then conclude that, irrespective of the exact contents of KR1, the priority claim is invalid, and therefore the translation of KR1 is not needed for determining the validity of the priority claim.

Debit order and insufficient funds (Q.5)

Was considered difficult and often skipped.

Questions in the DII part

Magali Degrendel commented on some DII-topics and the questions relating to the DII-part.

Partial priority

Magali indicated that the paper was designed such that if partial priority was not recognized, a candidate could continue.

Interpretation of [002]

The Possible Solution in the Examiner's Report interpretes

[002] so that the increased energy storage is only described with reference to the claimed embodiment, i.e. S + Cu < 40 nm. It was commented by tutors and, on the blogs, by various candidates that it could however also be read in an alternative manner, namely as to also refer to the first sentence of [002], i.e. "all metal nanoparticles modify the foam structure of a show sole, thereby improving the energy storage of the shoe sole". Various candidates and tutors have indicated that they used this "alternative interpretation".

The Committee indicated that they consider this alternative interpretation incorrect.

Effect of different Interpretation of [002]/ improvements of dependent claims
A submitted question indicated that when [002] is understood such that EP-F1 discloses also that "any metal nanoparticles modifies the foam structure of a shoe sole, thereby improving energy storage of the shoe sole" and thus "S + metal NP", the priority situation changes. With that interpretation, Claim 1 of EP-F2 (S + metal NP) gets full priority from EP-F1. Prior art is CGK (foam, but no NP) and AT-H (no metal NP) as 54(2) and EP-H as 54(3). EP-H's 54(3) effect is determined by CN text, so S + Cu 70-80 micrometers, so no nanoparticles, so new over EP-H (CN). Inventive over CGK and AT-H due to increased energy storage. So, claim 1 would be patentable. (It is noted that the patentability of claim 2 and 3, which still do not have full priority over their full scope but only partial priority from EP-F1 for S + Cu < 40 nm, does not change).

The submitted question indicated that with the alternative interpretation, the same actions and amendments w.r.t. claim 2 and 3 could be done as shown in the Possible Solution, resulting in patentable claim 2 and amended claim 3 (limit to < 40 nm). However, whereas there is a need to do these actions and amendments when following the Possible Solution in view of the invalidity of claim 1, there is not really such a need when the "alternative interpretation" is followed, as claim 1 already gives a broad and good protection.

The submitted question asked whether the Committee could confirm that even if a broad independent claim is valid, candidates are always expected to try to improve any invalid dependent claim to get valid explicit protection for the dependent claims? (As was also the case in, e.g., DII 2013, where the client could protection for frying pans with 3D protection of any shape (via Art.61), but also specific protection for frying pans with cubic protrusions were to be obtained (via Art.55)).

The Committee indicated that dependent claims also need to be improved, also if the independent claim is considered to be valid.

Adding a priority declaration
The Committee indicated that, even though many candidates proposed to add the priority declaration, the analysis of the resulting situation was often missed (valid claim 2).

Filing language
A tutor asked why the filing language of EP=F1, EP=-f2, and EP-F3 was specified to be German. It seemed a trigger word, but the language does nowhere appear in the Possible Solution.
The Committee answered that some facts are given to prevent speculation and/or to not make you worry.

Detail required in (cross-)licensing advice
A few tutors observed that the level of detail as to the cross-licensing advice is very different between the examiner's reports of various years. Here, the advice was very brief whereas in other years, it was required to also indicate explicitly which claim of which application/patent and in relation to which product/activity and where.
The Committee indicated that as this year, the minimum of mentioning the relevant patents was enough.

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

Representing Examination Committee IV: Stefan Götsch (EPO), Stefan Kastel (**epi**)

General remarks
This year's pre-exam had legal questions of similar difficulty as in the last 4 years (2015-2018), where understanding of the legal provisions itself as well as of the Guidelines was tested (who can speak at oral proc, transfers, inventors). Some usual topics, such as divisionals and EP-entry, were missing. Partial priority (G 1/15) was not tested yet.

The claims analysis part was much shorter than in 2018 and 2015-2017 in terms of total number of words (2019: about 2500 words vs 2018: 5238 words), length of client's application, embodiments, claims, prior art embodiments and length of (independent) claims. Moreover, the claims analysis part comprised two technical cases. Each case had a short client's application, short prior art documents, concise claims, very understandable subject-matter and five questions.

During the meeting, the Committee briefly reiterated its comments from the previous year:

- The true-false format with grouping of 4 statements into one question and a non-linear marking of the question (all correct: 5 points, -2 subtraction for each wrong answer with a minimum of zero, i.e., no negative points) is not cast into concrete. However, the 20x4 scheme is believed to work quite well.

  - The Committee is open to proposals and reforms in the future.

- The Committee consists of 20 persons, so there is little manpower to test the questions. Feedback is obtained from blogs and from direct questions and comments of tutors.

- The disadvantage of the present form of the pre-exam is the need to create 'black-and-white' situations, and in which it is only possible to neutralize statements, for example if very good arguments exist for another answer.

  - In such cases, the Committee **will** neutralize the respective statements.

- The questions are aimed at the basic 'mainstream' answers. The syllabus aims at the knowledge of candidates with 2-years of practice.

- Statistics: it is not easy to create statistic on whether the pre-exam increases the pass-rate of main exam. Such statistics are therefore not available to the Exam Committee. However, it was reported that candidates with a high pre-exam score often also score high on the main exam.

- Computerization would be nice in the future, preferably with the possibility to take it multiple times per year..

Legal part

This year's legal part addressed several topics that were to be expected (filing date requirements EPC, time limits, time limit differences PCT-EPC, languages, filing requirements EPC and PCT -including an Argentinian co-applicant-, right to an EP patent, third party observations) as well as several less standard topics which well-prepared candidates would have been able to find in their EPC/ reference materials/ Guidelines (who can speak at oral proc, transfers -incl recording transfer during opposition period-, rights of inventors, recording changes in PCT, refunds of fees, admissibility of opposition). Some usual topics, such as divisionals and EP-entry, were missing. Partial priority was not tested.

Wording, terms and languages

In the meeting, there was some discussion as to the wording of various questions and as to the explanations given in the Examiner's Report in the legal part.

In **Question 2** of the Pre-Exam, the correspondence between terms in the question & statements and in Art. 133 EPC was not the same for all three languages (EN: "the headquarters" & "its research centre" in paper vs "principle place of business"; DE: „einen Hauptsitz" & „beim Forschungszentrum" vs „Sitz" (not „Hauptsitz"); and FR : « son siège » & « au centre de recherche » vs « siège »), i.e. the FR term uses exactly the term from the law, whereas the EN version used the less legal headquarters and the DE version added "Haupt-". It was argued that this causes inequality between candidates and it was suggested that all language versions use the authentic terms from the EPC Articles in future papers. The Committee indicated that correspondence between the various language versions has a high priority, but that is difficult to always have it exactly the same

There was a discussion on the effect of information letter "Expected start of examination" (form F2919), which was introduced when RFees 11 was amended in 2016 [OJ 2016, A48 & A49] on **statement 3.1**. A candidate that is aware of this form F2919 may have come to the opposite answer, while the candidate's understanding was actually quite good; he would only answered wrongly by having considered this "information letter" to be a "communication".

The Committee also considered the form to be an information letter, and not a communication that sets a time limit for responding. The Committee will take the form and the comments into account for the future.

In **statement 4.1**, the question did (in all three languages) not use the words from the law (R.6(1) EPC: "shall"), but an informal term ("must"). Some candidates (native as well as non-native EN speakers) have indicated that they consider the meaning of the statement different with "must" than with "shall", e.g. in view of (Rule 57(a) and) Rule 58 EPC which provides for an invitation to give the translation within another 2m from the invitation and/or in view of the question not indicating whether the applicant wants to proceed with the application or just wants a filing date. It was suggested to use the words from the legal provisions. Further, it was suggested that the statement should also indicate the effect ("to prevent the application to be deemed to be withdrawn immediately upon expiry of a 2m period from the date of filing" – which would be FALSE in view of R.58). The Committee indicated that they consulted their legal experts and they considered the words "shall" and "must" to have the same meaning. The Committee also indicated that a candidate shall not think too sophisticated: a Rule 58 consideration was not expected.

Related/correlated statements

In **Question 8** of the 2019 Pre-Exam, a tutor observed statements 8.1 and 8.2 as well as statements 8.3 and 8.4 are coupled and not independent, contrary to item 1.(a) of the instructions for answering the paper on page 1of the exam paper. A wrong answer to statement

8.1 causes that statement 8.2 is also answered wrongly (i.e., two errors are made if one wrongly uses the EPC's 10-day rule for notification for a PCT). In addition, a wrong answer to statement 8.3 may cause that statement 8.4 is also answered wrongly (i.e., two errors are made if a candidate considered the 10-days' fiction of R.134 to extend to Monday if the 10th day is on a Sunday). The tutor considered the coupling of statement in one question results in unfair treatment of candidates.

The Committee indicated that statements do not always need to be uncorrelated, even though the main rule is to have them unrelated. The Committee also observed that for these related statements, the answers were not perfectly correlated.

Claims analysis part

The claims analysis part started with an invention relating to a washing composition in the form of a tablet, described in a 1-page description. The washing composition comprises one or more detergents (surface active agents), one or more builders (help to keep the water soft), one or more bleaches (to destroy coloured dirt components), and, optionally a colourant. Ranges of amounts of the various components were given. The components are contained in separate layers: a first layer (all detergents), a second layer (all bleaches), and preferably a third layer in between those (preferably comprising only a builder). The application had no drawings.

A first claim set of 1 independent claim and 8 dependent claims (some of them multiple-dependent) was to be considered for questions 11 to 14. Two very brief documents D1 and D2 were given and expected to be used as prior art documents. D1 described two embodiments of washing tablets including, as usual, a detergent, a builder and a bleach; in the first embodiment, all ingredients are mixed together and compressed to form a tablet; in a second embodiment, the mixture is divided into two separate parts, forming two layers of the tablet. D2 proposes a washing tablets comprising three layers: a first layer with a builder and a bleach, a second comprising a builder and a detergent, and a third comprising a builder and a colourant.

Questions 11-14 were directed to clarity, scope, novelty, and extension of subject-matter.
For question 15, a different independent claim was presented, and several inventive step-related statements were tested.

After this highly chemical-type first invention, the claims analysis part continued with a mechanical-type invention. A one-and-a-half page application described a composite structure having holes with reinforcing inserts for the holes in the composite structure, so as to strengthen the holes. Preferably, a support layer is joined to each reinforcing insert. The support layer is formed from a different material to the plies of the composite material. The composite fibres are preferably carbon fibres, while the support layer is made of metal such as aluminium. The single figure showed a composite structure with 10 to 100 plies of fibre-reinforced composite material and a support layer such as a support grid. The support grid has a mesh size in between 0,5 and 1500, preferably between 100 and 150 (considerably improving the fastening strength), measured according to standard XYZ.

Question 16 was directed to essential features.

After question 16, and before questions 17 to 20, a claim set was presented with 1 independent claim and 7 dependent claims (most being multiple-dependent claims in the form is "any one of claims X-Y"). D11 and D12 were cited as prior art documents, each one page and each including one figure. D11 relates to composite structures for aircraft components such as aircraft wing covers; D12 relates to a composite structure for bicycle components.

Question 17-18 were directed to clarity, scope, basis for amendment, novelty (of dependent claims).

For questions 19 and 20, a new set of 1 independent and 1 dependent claim was presented which had been filed by the applicant during the examination proceedings, i.e., as amendments.

Allowability of the new claims, two-part form, closest prior art arguments, and arguments in favour of inventive step were tested.

Although the opening paragraph of the application describes that "The present patent application relates to a composite structure such as an aircraft wing cover", none of the claims is directed to such an aircraft wing cover - all claims are directed to a composite structure.

In all, the claims analysis part was well-balanced between chemical as well as mechanical inventions, with two separate cases for both technical domains. Both cases were concise, the applications as well as the prior art documents, and should not have led to timing problems. Optional features, preferred embodiments, ranges, and correct understanding of dependent claims were tested.

Comments to specific statements

During the meeting, the Committee considered questions 11-18 and 20 to be unproblematic, as they were very well answered and there was no pattern perceived in the candidates' answers which would indicate a problem in one of the statements.

With respect to the answers to **statement 18.3 and 20.3**, a tutor observed that the third criterion of Guidelines (2017/2018) G-VI, 8(ii)(c), i.e. purposive selection, is not mentioned in the answer to 18.3, even though [007] explicitly indicates that "using a support grid 3 having a mesh size between 100 and 150 improves the fastening strength considerably". However, in the novelty-argumentation of 20.3, 'purposive selection' was included as the third requirement for novelty of a subrange. The tutor asked what the reason for this difference was. The Committee commented that they already considered the novelty criteria of the updated Guidelines (into force 1-11-2019, which omits the purposive selection as a third criterion in the novelty test) in their answer, in part since the Committee considered the Exam Report to be published relatively nearby in time to the updated Guidelines, so it was decided to present the answer already in line with the new Guidelines. The Committee also indicated that they try to prevent to have questions dependent on or influenced by a change in the Guidelines.

With respect to **statement 19.1 and 19.2**, which pertained to the allowability of amendments under Art. 123(2) EPC, the Committee indicated that both statements were neutralized after it became aware of acceptable alternative answers by which the amendments would not to be allowable under Art. 123(2) EPC by representing on unallowed intermediate generalization with respect to an embodiment in the description. The Committee further remarked that they expected consistency between both statements, with the answer varying depending on whether the 'intermediate generalization issue' was seen, but saw that both statements were often answered inconsistently.

General comments to the claims analysis part
The Committee commented that the claims analysis part with two technical cases is easier to draft since it is easier to create 'black-and-white' situations which fit the true-false nature of the pre-exam. As such, the claims analysis part is likely to continue to consist of "several" technical cases in the near future. The Committee further commented that such shorter technical cases may also enable the computerization of the pre-exam, although nothing has been decided yet in this regard.

In their written questions, tutors also indicated that they thought that the partitioning of the claims analysis part in several technical cases is very adequate for a true/false pre-exam and its purposes since it allowed the understanding of claims analysis topics to be tested without candidates being hampered by a vast amount of information and a lot of reading – which was a problem for many in 2018. Also, with the first case being quite chemical and the second being rather mechanical/structural, aspects from all technical fields were tested with an approximate equal-level playing field between the various technical backgrounds.

The Committee further commented on the high pass rate this year, contemplating whether this is due to the two technical cases but also considering that the legal part had a higher average score this year even though the difficulty was similar to previous years. Ultimately, the Committee expected the improvement in pass rate to at least in part reside in better prepared candidates.

In their written questions, other tutors also considered that the fact that the pass rate was surprisingly high not to be a problem, as it will probably have filtered out the candidates that have no chance of passing the main exam the year after. Some tutors expressed that they believe that keeping this format also for future exams will be much appreciated by candidates and tutors, and strongly support the current format of the claims analysis part.

During the meeting, one tutor expressed that with 90 % pass rate the discriminatory purpose is being missed, and that, in his view, the pass rate should correspond to that of the main exam at least, which means something like 66% in order for this to be a true early selection.

The Committee is not aware of any pre-exam appeals (note: appeals are addressed to and handled by the Examination Board and the Disciplinary Board), so the Committee expects that there are none or only few. (note: on one of the blogs, it was indicated that at least one person filed an appeal w.r.t. statement 2.3 and 4.1).

8) Concluding remarks

The annual meeting of EQE tutors and members of the EQE Committees took place on 17-18 October 2019 in Munich. The EQE papers were discussed in detail. The questions submitted prior to the meeting were addressed by the Committees when discussing the papers, and several other questions were asked during the meeting.

With this report, tutors summarize the papers and provide information of the points discussed at the meeting so that candidates can also find this information. In addition, our summaries and comments can assist when reading and interpreting the official Examiner's Reports of the EQE2019 papers.

Continuing Professional Education (CPE) seminars 2020

Opposition and Appeal seminars

The new Rules of Procedure of the Boards of Appeal entering into force on 1 January 2020 and their implications on the proceedings will be dealt with in detail at these seminars. The speakers provide you with an intensive and practical overview of all relevant legal and practical issues concerning opposition and appeal proceedings before the European Patent Office.

10 February 2020	Munich (DE)	**epi** roadshow supported by the EPO
17 March 2020	The Hague (NL)	**epi** roadshow supported by the EPO (registration soon available)
14 October 2020	Paris (FR)	**epi** roadshow supported by the EPO (registration soon available)
17 November 2020	Milan (IT)	**epi** roadshow supported by the EPO (registration soon available)

All detailed information and registration is available in the event calendar on the **epi** website.

Case Law seminars in 2020

The "Case Law" seminars will provide you with an overview of the most recent key decisions and developments in the EPO's board of appeal case law. This collection of lectures offers a range of subjects, including procedural and substantive topics, and with a mixture of general-interest and more field-specific topics. The seminar also includes the demonstration of a mock EPO Oral Proceedings.

All venues for 2020 are published on the **epi** website as soon as these are confirmed.

Seminar series "Life of a patent"

In 2013 **epi** started a series of seminars on the "Life of a patent".

The series covers 4 topics which are composed of pre-drafting and drafting of applications, prosecution and opposition. The seminar is intended for attorneys new in the profession but also for patent practitioner/patent engineers in industry that would like to refresh their EPC knowledge and skills.

The first two topics will be presented in Lisbon in January 2020.

23 – 24 January 2020 Pre drafting course	Lisbon (PT)	**epi** roadshow supported by the EPO

Claim Drafting Course

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.

All venues for 2020 are published on the **epi** website as soon as these are confirmed.

epi preparation courses for the EQE pre-examination and main examination 2021

All courses are provided in the three EPO official languages:

epi Tutorial

Get your individual feedback on papers Pre-Examination/ A/B/C/D whenever you need it during your preparation for the EQE

- Sign up for a tutorial whenever you want
- Decide which paper you want to prepare
- Arrange individually with your tutor:
  - the due date when you need to send your prepared paper to your tutor
  - the date when you will discuss the result of your individual paper with your tutor

- Discuss the result of your paper with your tutor
  - in small Groups (on request) or
  - in a one to one session

Further Information can be found on the **epi** website.

Mock EQE(s)

The mock EQE(s) allow participants to attempt an EQE exam under exam conditions. The participants sit the various papers (A, B, C and D) in the same order as during the real exam and are given exactly the same time to sit the paper(s).

The **epi** has prepared new papers A, B, C and D for the Mock EQE with the assistance of epi Tutors and members of the Professional Education Committee. The papers will be available in all three of the official languages.

The feedback will be given in small groups or one to one session(s) depending on the number of participants. Further information about the venue and time schedule are available in the Education and Training section on the **epi** website.

2-day Weekend Workshop

The workshop program is aimed at EQE candidates who have recently passed the pre-examination and are beginning their preparation for the full examination. The workshop will also be of benefit to candidates who will be resitting Paper A, B or D.

The workshop is exclusively for **epi** Students. The **epi** offers the possibility to become an **epi** student to be able to participate in the workshops, detailed information how to become an **epi** Student can be found here: https://patentepi.org/en/epi-students/rules-conditions.html

The Paper A, B or D workshop will introduce participants to the formal and practical requirements of Paper A and how to prepare an answer.

Further Information can be found on the **epi** website.

Committee Reports

Report of the European Patent Practice Committee (EPPC)

C. Mercer (GB), Chair

This report covers the period from the last Council meeting in Sofia to the Council meeting in Lisbon.

The EPPC is the largest committee of the **epi**, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT and (3) the future EU Patent Regulation, including any revision thereof, except all questions reserved for the Biotech or Harmonisation Committees.

The EPPC is presently organised with seven permanent subcommittees (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, Quality, Unitary Patent and Patent Documentation). Additionally, ad hoc working groups are set up when the need arises. Four thematic subcommittees have also been set up (Mechanics, Pharma, ICT and Chemistry). Members of EPPC are also delegates to various meetings organised by the EPO, including meetings under the SACEPO banner.

Membership

Michel Gilio (BE) has been elected to EPPC.

Alain Werner (FR) is now a member of the Pharma Thematic Group.

Meetings

17/01/2019 – SACEPO-WPR
A copy of the report of the above-referenced meeting is attached (Annex 1).

02/05/2019 – Meeting with VP1
Combined notes on a meeting with VP1 on May 2019, which took place before the Sofia Council meeting, are attached (Annex 2).

11-13/06/2019 – PCT Sub-Committee
A note on a meeting at WIPO attended by our PCT Sub-committee Chair is attached (Annex 3).

03/07/2019 – ICT Thematic Group
The ICT Thematic Group has been involved in drafting an amicus curiae brief for submission in connection with the reference to the Enlarged Board of Appeal in case G1/19 on simulation. This brief has now been filed. A copy is attached (Annex 4).

27/08/2019 – EPPC / Biotech Meeting regarding G3/19
I met with two members of the Biotech Committee to begin drafting of an amicus brief for filing in connection with Enlarged Board case G3/19. This is a very politically-charged subject and will be reported on by the Biotech Committee.

17-18/09/2019 – Guidelines Subcommittee Meeting
A report from the Guidelines Subcommittee is attached and also attached are documents referred to in the report (Annex 5).


Chris Mercer

18/09/2019 – SACEPO-WPR
A copy of the report of the above-referenced meeting is attached (Annex 6). Also attached is a copy of a document on Cancellation of Translation Services for Oral Proceedings (Annex 7) and a summary of conclusions (Annex 8). An article about this can be found on page 27.

The biggest point which is under discussion for EPPC is on Streamlining Procedures. The EPO has come up with a number of proposals, as shown in the attached PowerPoint presentation (Annex 9) and document (Annex 10). These will need to be studied in detail and **epi** positions on many points will need to be taken.

27/09/2019 – WIPO Conversation on Intellectual Property (IP) and Artificial Intelligence (AI)
Delegates from the ICT Thematic Group attended the above event. A report on the event will appear in **epi** Information. A copy of the summary of conversation, prepared by WIPO, is attached (Annex 11). Further documents can be found on web page: https://www.wipo.int/meetings/en/details.jsp? meeting_id=51767

01/10/2019 – Meeting of Chemistry Subcommittee with EPO Directors
Delegates from the "Chemistry" sub-committee met with the EPO 1st October 2019. Subject matters discussed included:

- Added subject matter – instances of inappropriate application of the "two list" approach to novelty to find added subject matter
- Clarity relating to alloy formulations – where it was confirmed that closed lists of components are required but it is not necessary to specifically include the word "impurities"
- Assessment of claims relating to unusual parameters – where reference was made to the amended Guidelines published that day.
- Prior use and implicit disclosure and the difficulty of proof
- Product by process claims – their assessment and allowability.

The discussions were open. All agreed that a repetition next year would be welcomed.

16-17/10/2019 – Meeting of Pharma Subcommittee with EPO Directors
A report on the above-referenced meeting is attached (Annex 12), together with copies of two EPO documents presented at the meeting. This report and the documents should NOT be further distributed as the EPO wishes to keep the details of the meeting confidential. If there are any questions which arise from the meeting, please contact eppc@patentepi.org.

11/11/2019 - Meeting of Mechanics Subcommittee with the EPO Directors
The meeting took place and a report will follow in due course.

Case Law Seminars

Members of EPPC have been assisting PEC by presenting topics at a series of Case Law Seminars. These seminars are presented by two **epi** members and two Board of Appeal members and include a mock oral proceedings.

References to the Enlarged Board of Appeal

This period has seen significant work on preparing amicus curiae briefs in respect of a number of references to the Enlarged Board of Appeal.

G1/19 – As noted above, the ICT Subcommittee produced a brief which was filed in connection with the referral on "simulation".

G2/19 – A small group was formed to prepare a brief for filing in connection with the "Haar" referral. The oral proceedings on this referral took place earlier this year and the opinion of the Enlarged Board has now been issued. The basic answer was that it is in conformity with the EPC to hold oral proceedings in Haar.

G3/19 – EPPC has been co-ordinating with the Biotech Committee to produce a brief in connection with the referral on plants produced by essentially biological processes. This will be reported on by the Biotech Committee. The brief has now been filed.

G4/19(??) – We have been aware for some time that there will be a reference to the Enlarged Board on double patenting. However, the referring decision has not yet been issued. A Working Group has been formed to prepare a brief and is ready to spring into action.

G5/19(??) – During the meeting of the Guidelines Subcommittee, it was noticed that there are two lines of case law relating to novelty as regards ranges. It appeared that this is a situation where the President of the EPO should refer a question to the Enlarged Board. A letter regarding this has been sent to the President of the EPO (Annex 13). The letter is deliberately short and does not say in which way **epi** considers the question should be decided. If the President agrees to refer a question to the Enlarged Board, **epi** will prepare and submit a brief.

Further Meetings

There are a number of other meetings which will take place between the drafting of this report and the Council meeting. If possible, reports of those meetings will be provided before the Council meeting, such as the note in Annex 14.

*All Annexes are available at:
https://patentepi.org/r/info-1904-04

Report of the Committee on EPO Finances

J. Boff (GB), Chair

The matter of fees is active again. At the Budget and Finance Committee meeting of 23rd / 24th October, approval was given for an upwards review of fees to come into effect 1st April 2020. This approval needs to be followed by a corresponding decision of the Administrative Council, but is likely to go ahead.

If approved by the Administrative Council, most fees will increase by 4% [about 8% above the actual inflation figure of 3.7%] with the appeal fee increasing by 20%. The fee for International Search and for International Preliminary Examination remain unchanged, as part of a policy of decreasing the difference between EP and PCT fees.

Despite extremely short notice, **epi** submitted a paper in advance of the Budget and Finance Committee meeting drawing attention to the damaging effect of accumulated above-inflation fee increases, and on the particular problem of the increase in appeal fee.

One positive proposal is to abolish the 10% surcharge of Article 7 RRF. This reflects the reality of modern banking, and means that bank transfers will cease to be disadvantaged in comparison with credit card payment. The most secure payment method remains an EPO deposit account.

Jim Boff

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

1. Meetings with attendance of the Biotech Committee

On **16 October 2019** the Committee held its yearly meeting in the **epi** Secretariat. The Biotech Committee was also partly joined by members of the EPPC group on Pharma.

On **17 October 2019** an ad-hoc delegation of the Biotech Committee met with the DG1 Biotech Directors and other EPO delegates at the EPO in Munich. The meeting was very productive and informative. No official minutes will be prepared at the request of the EPO delegation.

An update was given by the EPO on the EPO and DG1 more particularly the Strategic Plan 2023, the Opposition Practice and experience with OCFD (Opposition & Centralised Formalities Directorates) as well as on Quality including timeliness.

Also, the following general patentability issues in Biotech were discussed:

a. Plants and animals – updates in view of G3/19
b. New type of 'plausibility objections' in biotech area?
c. Antibody patenting
d. Unity of invention in biotech
e Amendment and method of treatment language in the description
f. New rules of proceedings Board of Appeal

2. Patentability of plants and animals – G 3/19

Our committee reported on **T 1063/18** in **epi** information 1/2019- 3/2019. This decision concerns the appeal by the applicant against the decision of the Examining Division to refuse European patent application no. 12 756 468.0 (publication no. EP 2 753 168 A1) for the sole reason that the claimed subject-matter was "found to be within the exception to patentability according to Article 53(b) EPC and Rule 28(2)" (here: plants exclusively obtained by means of an essentially biological process).

The Technical Board of Appeal (TBA) 3.3.04, in an enlarged composition consisting of three technically and two legally qualified members, held that Rule 28(2) EPC (see OJ 2017, A56) is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal (EBA) in decisions G 2/12 and G 2/13. In these decisions, the EBA had concluded that the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC did not have a negative effect on the allowability of a product claim directed to plants or plant material.

The following points of law have been referred to the EBA by the President of the EPO in **G3/19**:

> 1. Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?
>
> 2. If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?

The **epi** Biotech Committee together with EPPC prepared an amicus brief in name of **epi** for G 3/19 which was filed by **epi** on 30 September 2019. An ad-hoc working group consisting of Ann De Clercq, Simon Wright, Chris Mercer and Heike Vogelsang-Wenke was involved with drafting the amicus brief and our Associate members Jan Desomer and Bart Swinkels also contributed to the discussion as well as many other members of the Biotech Committee. All amicus briefs filed can be found here: https://www.epo.org/law-practice/case-law-appeals/eba/pending/g3-19.html. The Biotech Committee with special thanks to Jan Desomer has summarized these amicus brief in the overview that can be found here: https://patentepi.org/r/info-1904-05. The EPO webpage with G3/19 amicus curiae letters shows 41 entries of which two entries are in fact multiple entries i.e. the written statements filed by 23052 natural persons via Umweltinstitut München e.V. and a statement filed by Christophe Then signed by 49 organizations and 2725 individuals.

The letters can be grouped into:

1) Emotional letters: driven by the sentiment that there should be no patents on life (No patents on seeds/Julian Cockbain)

2) "Teleological letters": breeding germplasm should be freely accessible to ensure food security
(German Plant Breeders association/Euroseeds/Plantum/Association of the Horticultural producers)

3) Letters by government instance including the Patent Offices: expressing support for the president referral in view of harmonization of patent law.
(Portugal INPI/ Spain Patent and Trademark office/Bundesregierung Deutschland/IP office of Czech Republic/Belgian Patent office/Poland patent office/Kingdom of the Netherlands/INPI France/Danish Government/European Union)

4) Legal/Patent-Technical letters
- On admissibility of the referral, the views differ from
  - Clearly inadmissible (FICPI/FEMIPI/ IP Federation/VPP/Croplife and ECPA/CIPA/CNCPI)
    - There is no divergent case law
      - On rule 28(2) EPC there is only T1063/18
    - There is no divergence in the methodology of application of Art 164(2) in earlier decisions re Art 53 (Konig/Rennie Smith/Haedicke/CIPA)
    - There is no divergence by analogy and there are no lacuna in the law to be filled (Konig/Haedicke)
  - Inadmissible or not, but urging the Boards to provide guidance anyhow, in line with G3/08 (**epi**/Van Woudenberg)
  - EBA should apply some lenience, in view of the importance of the issue (Metzger et al./IPO/Van Woudenberg/European Union)
  - Assumed admissible (Kennington/de Lange/Leconte)
  - Admissible
    - For the reasons the president provided (National instances)
    - There is only one board for biotech – impossible to have divergent case law (Plantum/German Plant Breeders association)
- Suggested answers to the questions
  - Question 1
    - A distinction should be made between articles that refer to the Implementing Regulations, and ones that do not, like Art 53 (de Lange)
    - Numerous submissions on separation of powers within the EPO, extent of the legislative power of the AC and constitutionality of the EPO (CIPA, Haedicke/Malek/Köning/de Lange/Leconte)
      - Suggested answer: No – one cannot implement a Rule that conflicts with an article as interpreted by a BOA (various letters)
      - Suggested answer: No – one cannot do that for articles as interpreted by EBA but Yes for an article interpreted by a BOA (IPO)
      - Suggested answer: Yes, Rule 28(2) is lex posterior (Dolder and various of the national instance letters).
  - Question 2
    - Not applicable in view of the no answer to Q1
    - No- A rule cannot be used to add exceptions – What is not prohibited by Art 53b is allowed by virtue of Art 52 (Leconte/Konig/…)
    - Yes, but with a narrow definition of EBP (Metzger et al)
    - Yes, and the definition of EBP should even include smart breeding and mutagenesis (No patents on seeds and the like)

Fritz Dolder has raised partiality of Mr Beckedorf. If picked up by the EBA, they may first have to decide on participation or exclusion of Mr Beckedorf, which would likely delay the issuance of an opinion.

With respect to other publications on G3/19, we refer to:


Ann De Clercq

Heiko Sendrowski in **epi** Information 2/19 and 3/19
The BoA in T1063/18 may have misjudged the "acte eclairé" status of Art 53b EPC and Art 4 BD. Lenience should be applied in accepting the referral at least with regard to question 1. In the second part there is a plea for referral to CJEU, as this would concern interpretation of the Biotech Directive provisions incorporated in the EPC

Huttenberger in GRUR Int. 2019, 869
A BOA has likely the power to ignore Rule 28(2) EPC in "inter partes" proceedings, but for an "omna erges" effect an EBA decision is required.
The Biotech Committee will keep on following up this topic and provide its comments. It seems that we can expect an opinion by the EBA in 2020.

3. Overview of patentability of plants in the Member States

The Biotech Committee is following further national developments and has prepared an updated overview of the patentability of plants in the member states on basis of reactions of the members in each country and will follow this up further. The information given in the referral docu-

ment for G3/19 is in our opinion not completely accurate and in many countries the national law has not been amended and there are no immediate changes foreseen (see https://patentepi.org/r/patentability-of-plants).

4. New Rules of Procedure of the Boards of Appeal

There is a general concern about the effect of these rules on the first instance proceedings since the new procedure is more front loaded (in order to reduce the workload and backlog of the Boards of Appeal). This is likely to result in more auxiliary requests and procedural questions in opposition proceedings. DG1 does not completely realise these consequences. There is also a general concern about not remitting.

5. Antibody patenting

A working group from Pharma on antibodies with members from industry exists which meets with the EPO (outside of the remit of the Biotech Committee it appears) and which raises the problems applicants phase towards the EPO. The EPO apparently considers the creation of antibodies as routine and done by nature. This group considers that there is a lack of case law and that antibodies are not covered by the Guidelines. Thus, the examination depends on the examiner. The EPO may need more munition to create case law (either by third party observations and rejection of the applications or by opposition in inter partes proceedings). A suggestion was that the the EPO could publish their internal guidelines.
With regard to patentability, inventive step is a high hurdle for many applicants. In this regard, it is difficult to obtain case law. The EPO needs to be convinced that antibodies should not be treated differently than other molecules. She would not use the term FTO but rather broad and narrow claims.

6. New type of 'plausibility objections' in the biotech area?

The pregabalin national court rulings regarding second medical use clearly contradict the EPO's practice. The EPO will nonetheless be hoped to keep its granting practice. In this specific case, it was questioned whether the experiments proved the plausibility of the substance to relieve pain. Before the EPO, the issues were only novelty and inventive step. The opposition was dismissed. In the national proceedings, the issue was sufficient disclosure. In Hungary, the argument that this was a pioneering second medical use was put forward. In support of this, the EPO's practice was cited (G IV.7.1), according to which pregabalin for use in the treatment of pain would be allowable even if not plausible for all kinds of pain. The Hungarian patent office allowed the claim but the courts decided to the contrary. This topic was raised with the EPO.

7. Amendment and method of treatment language in the description

At the meeting with the EPO PAOC Directors, it was indicated that in the chemistry field, it is not required that amendments to medical use language in the description are made. It was confirmed at our meeting that this is applied in practice. The question is whether this also applies to biotech. This was discussed at the meeting with the EPO.

8. Joint meeting with EPPC Pharma Group

8.1. Plausibility

Two cases relating to a patent of BMS for a compound (T 0488/16 and T 0950/13) were mentioned wherein the scientific data were only provided during the proceedings. In one case, plausibility was denied, even when on appeal the claim was reduced to a single compound. In the other case, relating to the same compound, plausibility was found. These inconsistent decisions show that we need some information on the criteria applied. On earlier occasions the EPO said that decisions are taken on a case-by-case basis. This is also relevant for the biotech field, even though compounds are defined in a different way.

8.2. Antibody patenting

There was a discussion on the patentability of antibodies as compared with chemicals. The Biotech members explained the problem that the EPO's practice (of requiring a surprising or unexpected effect) forces applicants to accept very narrow claims which do not provide sufficient protection. There is also the problem of having to provide the scientific data, more particularly there is a timing problem since it takes time to produce the data while it is arbitrary which antibody is chosen. In the US, China and Japan, the patent offices are not that strict.

9. Guidelines for Examination – biotech issues

The Biotech Committee was represented in a discussion of the Guidelines for Examination at the SACEPO Working Party on Guidelines on 22 February 2019. The Biotech Committee also presented its comments on Rule 28(2) EPC and relating disclaimer parts of the Guidelines. The new version of the Guidelines and also the new version of the Case Law book will be studied by the Biotech Committee to spot any changes relating to biotech not previously reported on.

10. Next meeting and questions

The Biotech Committee will continue to deal with all questions relating to biotech and related life sciences inventions as well as topics referred to it by EPPC or other channels. The next committee meeting dates for 2020 have to be set as well as new meeting dates with the EPO.

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Next Board and Council Meetings

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106th Board Meeting on February 2020 in Munich (DE)

Council Meetings
88th Council meeting on 11 and 12 May 2020 in Glasgow (GB)
89th Council meeting on 14 November 2020 in Ljubljana (SI)

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P.R. Thomsen (CH), Treasurer

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Eingangsfrist im **epi**-Sekretariat:

15. Februar 2020

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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).

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