



Report from the 96th Council Meeting

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Cover:

Two robins in the snow

Picture (Waterpainting 23 x 31 cm)

painted by Marinella Valle

(European Patent Attorney, IT)



Marinella Valle

Born and raised in Milan, after classical education Marinella graduated in Pharmaceutical Chemistry and Technology at the University of Milan and received a PhD in Pharmaceutical Chemistry from the same University. After completing the PhD, Marinella completed a master's course in intellectual property at the Politecnico of Milan; she is now an Italian and European patent attorney and works as in-house patent counsel in Milan. Marinella's passion for art, literature and foreign languages, developed during her classical studies, never died and some years ago, she started painting.

Geboren und aufgewachsen in Mailand, absolvierte Marinella nach einer klassischen Ausbildung ein Studium der pharmazeutischen Chemie und Technologie an der Universität Mailand und promovierte in pharmazeutischer Chemie an derselben Universität. Im Anschluss an ihre Doktorarbeit folgte ein Masterstudien-gang in Geistigem Eigentum am Politecnico Mailand. Heute ist sie italienische und europäische Patent-anwältin und arbeitet als Patentan-wältin in Mailand. Marinellas Leidenschaft für Kunst, Literatur und fremde Sprachen, die sich während ihres Studiums entwickelt hat, ist ungebrochen und vor einigen Jahren hat sie begonnen zu malen.

Née et élevée à Milan, Marinella a obtenu, après des études classiques, un diplôme de l'université de Milan en Chimie et Technologie pharmaceutique, puis une thèse en Chimie pharmaceutique dans la même université. Après sa thèse, Marinella a obtenu un master en propriété intellectuelle à l'école polytechnique de Milan. Elle est aujourd'hui conseil en brevet italien et mandataire en brevets européens et travaille dans l'industrie à Milan. Sa passion pour les arts, la littérature et les langues étrangères, développée durant ses études classiques, ne s'est jamais éteinte, et elle a commencé à peindre il y a quelques années.



Warm season's greetings from the **epi** Board and **epi** Secretariat.
May the year 2024 bring you prosperity, health, joy,
and the fulfillment of both personal and professional goals

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Picture: Marinella Valle, Two robins in the snow (Waterpainting, 23 x 31 cm)



Institute of Professional Representatives before the European Patent Office

Editorial

Let it snow! Let it snow! Let it snow!

M. Nevant (FR), Editorial Committee

Winter is coming! At this time of year, Christmas songs naturally come to mind, in particular the song that accompanies the end credits of the movie "Die Hard" (of which I am a die-hard fan): *Let it snow!* Who knows that this song was written in July 1945, recorded by Vaughn Monroe, and released



Marc Nevant

just after Thanksgiving that year, becoming a hit by Christmas? The song was covered by many artists, including Dean Martin and Frank Sinatra (I can already hear my younger colleagues say: WHO??).

Back to business (or patents shall I say), the past few months have seen a tug-of-war between the Industry Patent Quality Chapter (IPQC) and the European Patent Office. The former implicitly reproaching the latter for issuing patents that would not be robust enough, which might harm the European industry. Is that really so?

It may happen that EPO Examiners miss during examination a piece of prior art which is detrimental to novelty or inventive step. While such a situation is quite unfortunate, it can nonetheless be remedied in post-grant proceedings. By contrast, challenging in post-grant proceedings granted claims which contravene Article 84 EPC is virtually impossible. Are Applicants, including those from IPQC, ready to take action and stop seeking to secure such broad claims which are unclear/unsupported by the description? And are EPO Examiners ready to spend more time on clarity/support issues? Time will tell if future patents granted by the EPO reflect the real contribution of inventions to the state of the art (which I believe is hardly the case these days).

In any event, we should (always) look on the bright side of life. We, as professional representatives, are lucky to interact with the best Patent Office in the World. As we say in French, criticism is easy, but art is difficult. Hence Applicants should also be self-critical.

As mentioned to start this editorial, winter is coming, and snow might (hopefully) be here for the upcoming holidays. On behalf of the Editorial Committee, I wish all our readers a Merry Christmas and a Happy New Year!

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2023 – A year of remarkable changes in the European patent landscape

Peter R. Thomsen, **epi** President

Dear members, colleagues and students,

During the year 2023, which is coming to an end in the next few weeks, we have seen remarkable developments in the patent landscape of Europe affecting all of us in our professional life. After around three years of pandemic, 2023 was the first year with operations and processes back to a more normal stage, although some developments that were triggered by the pandemic have sustainably changed our way of working, e.g. the increased use of video-conferencing for meetings, events and even oral proceedings.

With the **Unitary Patent and the Unified Patent Court (UPC)**, that became reality and operational for a territory of 17 countries in 2023 after decades of discussions and several failed attempts, 2023 marks the year when the vision of some previous generations of legislators and patent attorneys in Europe became true, to further develop the patent landscape in Europe by complementing the regional EP system with a single patent title being common to several EPC countries and with a pan-European Court specialised in Patent law that has the potential to further harmonize so far quite fragmented patent litigation in Europe. Our profession plays an important role in the new system and some of our colleagues with an additional appropriate qualification such as a European Patent Litigation Certificate can fully represent clients before the new UPC. In that connection, I would like to remind all colleagues who fulfil the requirements and intend to benefit from the transitional provisions to submit their registration as representatives before the UPC at latest by 31 May 2024. **epi** will continue to work closely with the respective governance bodies being the Administrative Committee of the UPC and the Select Committee of the European Patent Organisation for the Unitary

Patent to ensure an operation and procedures that can be practically implemented by the users. We will also of course monitor the first decisions from the UPC.

Together with the EPO and many other stakeholders, **epi** celebrated the **50th anniversary of the European Patent Convention**. I believe that since 1973 the EPC has proven to be fit for purpose and sufficiently flexible to deal with any challenges, e.g. due to new science and technology. **epi** will contribute also in the future to keep up the EPC system to cope with new emerging technologies such as the expected impact of Artificial Intelligence. In October, **epi** organised its own event on the occasion of the 50th anniversary of the EPC that was dedicated to recognising the enormous contribution of the voluntary work of the **epi/EPO** joint Committees and bodies who have organised and carried out the EQE over the past 44 years.

From the times of its inception came also the so called 10-days rule for calculating deadlines in connection with service of documents issued by EPO, to which we gave farewell in November. A free recording was offered by **epi** to all members to explain the implications.

In 2023 we obtained clarification from the **Enlarged Board of Appeal**, in joint cases **G1/22** and **G2/22** that the EPO has jurisdiction on checking entitlement to priority under the EPC, but that there is a rebuttable presumption of entitlement, which also applies for Euro-PCT applications. On the contentious area of how far plausibility of an invention at the filing/priority date should influence patentability examination, the Enlarged Board issued a decision in **case G1/21** which stated that evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for



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acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date. A patent applicant or proprietor may thus rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention. However, there remains some questions open from the decision on the practical requirements of European Patents when it comes in particular to plausibility of prophetic or very broadly described inventions. At the end of 2023, there is one case pending before the Enlarged Board of Appeal, case **G1/23**, which concerns whether the composition of a product that was publicly available before the filing date of a patent, but where the skilled person was not able to analyse the internal structure constitutes part of the state of the art, and to which extent other public information on the composition of that marketed product before the filing date shall be taken into account when determining novelty. **epi** has recently submitted an amicus curiae brief in that case and we may expect a decision within 2024.

During 2023, we have also seen the **EU-Commission proposal for a patent package**, which contains three elements:

1. A European wide mechanism to facilitate compulsory licensing at occasions of crisis;
2. The introduction of a Unitary Supplementary Protection Certificates (SPC) system for pharmaceuticals and agrochemicals as well as a common granting and challenge procedure for SPCs being in force only in some EU/EEA countries, and
3. A proposal to increase transparency and facilitate dispute resolution in connection with Standard Essential Patents (SEPs).

All three elements include new roles for the EUIPO in Alicante, which so far has very little exposure to patents. **epi** has commented each of those proposals and is overall critical about the perceived need to install an additional institution within the European Patent landscape

that would be totally new to it. We will continue to support this project on its way through the EU legislative process in 2024 and probably in the years to come.

Just a few days ago, the Administrative Council of the European Patent Organisation adopted the **biggest reform of the EQE** since its existence at its December meeting. The present EQE with pre-examination and parts A, B, C and D will be gradually replaced from 2025 to 2027 into a **New EQE** consisting of modules F, M1, M2, M3 and M4. Transitional provisions of recognition ensure that candidates who have passed parts in the old-style format do not need to repeat all modules within the new system. The New EQE will on the one hand make the EQE fully compatible with a digital environment but will also focus more on testing the competencies and knowledge of future European Patent Attorneys. Although a lot of work and dedication has been invested by several **epi** colleagues as well as by EPO to develop the current proposal that was refined during many meetings, i.a. an extraordinary **epi** Council meeting in September/October, there is now still a lot of work ahead to implement the New EQE and make sure that there will be a smooth transition. Additionally, a second basket of rule changes will be discussed and worked on particularly during 2024 with the aim to modernise the access requirements to the EQE as well as some aspects of the appeal proceedings from EQE-related decisions.

2023 was also a year of elections for **epi**. Following the **epi** Council election, a **new epi Presidium**, with me as President, and a Board were elected at the Spring Council meeting in Malmö. Since then, we have started our journey to find out in targeted interviews with each **epi** Council delegation on which topics and aspects **epi** could assist our local membership in the contracting states. We will also use the information gathered to develop a longer-term vision for the **epi**. Partially based on the work of previous **epi** Presidiums, **epi** was welcomed as **a member of ANIPA and IP5 Industries** this year, which will help to increase **epi**'s input and support on questions generally affecting the profession in Europe and contribute aside with BusinessEurope to practical initiatives of international harmonisation of procedural patent law such as acceptance

of colour drawings in patent applications or simplified acceptance of e-signatures. In addition, **epi** elected its committees for the first time in an online election process. Many of the newly elected Committees have already or will soon constitute themselves and elect their officers. I am therefore confident that we will continue our journey in 2024 with fresh energy and ideas.

I wish you and your families a relaxing, peaceful and re-energising festive time and a good start into 2024, which will be a year of further new developments in Europe's patent system.



Ann De Clercq (BE)
Deputy Secretary General



Zsolt Szentpéteri (HU)
Treasurer



Andreas Winter (DE)
Deputy Treasurer

Report from the 96th Council Meeting

held on 11th November 2023 in Ljubljana (Slovenia)

M. Névant (FR)

To be as complete as possible, it is worth noting that a very interesting seminar entitled “Patent Quality in Europe” took place on the eve of the Council meeting, as reported here¹.

1/ Meeting opening

President Peter THOMSEN opened the meeting at 9 am and welcomed the participants. A test vote was conducted (125 voters were present then) and scrutineers were appointed.



2/ Adoption of the agenda

Proposed changes were made to the provisional agenda to include a discussion on: two motions from the Dutch delegation, a proposal to reform the disciplinary system, a proposal for support for economically weak applicants, and motions on the EQE (first basket). The revised agenda was **adopted**.

3/ Adoption of the minutes of the 94th and 95th Council meetings – matters arising from the decisions and actions recorded during said meetings and previous Council and Board meetings

Council agreed to **postpone the adoption** of the minutes of the 95th meeting until the next Council meeting. The list of decisions taken during C95 was however **adopted**.

A few changes were made to the draft minutes of the 94th Council meeting which were then **adopted**. A reference was made to the accumulated file with respect to matters arising from the previous Council and Board meetings.

4/ Report of the Committees Election Committee (CEC) and validation of the election of the members of the Committees – Report of the Committee Elections’ Objections Committee (CEOC)

The Chair of the CEC, Thomas MARX, first reminded Council of the process and timeline of the elections, and indicated that the implementation of said process included not only the CEC but also the Presidium, the By-Laws Committee and the Secretariat. Mr MARX indicated that it was a challenging task as the CEC was under time pressure to review the results for each Committee and publish them on the website. Mr MARX further mentioned that 3 objections against the results were received (see next item).

Paul-Georg MAUE, speaking on behalf of the CEOC, reported that the objections against the results of the election had been reviewed, and that there was no reason why the election should not be validated.

The election of the members of the Committees was **validated by Council** with 97.5% in favour and 2.5% against.

NB: the composition of the Committees is available on our website :

<https://patentepi.org/en/epi-bodies/epi-committees>

¹ <https://patentepi.org/r/info-2304-18>



5/ Report of the President and Vice-Presidents

President THOMSEN referred to his (note from the editor: comprehensive) report in the accumulated file, which also included activities of the Vice-Presidents.

6/ Report of the Secretary General – Report of the Executive Director

The Secretary General, Magdalena AUGUSTYNIAK referred to her report and that of the Executive Director in the accumulated file. Ms AUGUSTYNIAK thanked the Secretariat and her Deputy Ann DE CLERCQ for their support since the beginning of her term of office. Ms AUGUSTYNIAK also reported on the progress in IT made since C94.

A discussion followed on whether the minutes of Council meetings should be drafted in English only. Council was in favour of **postponing the decision** on the language version(s) of the Council minutes until the Council meeting in Sofia.

7/ Report of the Treasurer

The Treasurer, Zsolt SZENTPETERI, presented the financial outlook for the 2023 accounting year. In substance, the overall result was expected to be in line with the budget. The income will be significantly lower than expected (planned deviation of – 551 k EUR), in part due to a lower income from educational activities. The expenses will also be lower than expected (planned deviation of – 553 k EUR), in part due to lower costs in the Secretariat and also lower education costs. A planned deficit of – 524 k EUR is expected.

8/ Report of the epi-Finances Committee

The Chair of the **epi**-Finances Committee, Claude QUINTELIER, reported that the Committee has met with the Treasurer, the Deputy Treasurer, the Internal Auditors, the Executive Director and the Head of Finance to review the financial situation of the Institute. Mr QUINTELIER noted that variations in educational event income and expenditure were very hard to predict at the budget planning stage. Overall, the Committee was happy to accept the 2023 financial performance of the Institute to date, and noted the projected performance to the year-end.

9/ Motions of the Dutch delegation – Annual subscription fee – 2024 Budget

a) The following motions were discussed and put to vote.



Motion 1: Does Council agree to invite the Presidium to draft a proposal for reviewing the position of the Executive Director, reviewing the function and powers of the Secretary General and of the Treasurer, reviewing the structure and utilisation of the Secretariat, and a long term financial plan to bring the **epi** finance back to a long term sustainable situation; and to present this proposal on the Council meeting in Autumn 2024, with an interim report in Spring 2024?

The motion was **adopted** with 80% in favour and 20% against.

Motion 2: Does Council agree to work towards a long-term stabilisation or even reduction of the costs of the Secretariat?

The motion was **rejected** with 63.5% against and 36.5% in favour.

b) The planned 2024 budget was presented. The Treasurer explained that the draft was based on the following assumptions:

- Price increases especially for rent (6%) and IT Licences,
- Physical meetings of Council, Presidium, Board and Committees,
- All bodies/Committees will at least be able to meet once physically,
- Considerable use of ViCos by Committees and Presidium,
- Extension of expense arrangement with EPO for EQE-Committees,
- High activity level on educational activities, with new formats aimed at the development of the profession and related topics (AI, setting up a business),
- Stable membership and studentship numbers.

The Treasurer also noted that there were still a number of uncertainties for next year, such as the high inflation rate in Germany, IT investments and the downstream impact of "MyEPO" rollout on **epi** IT.

In the planned budget, total revenues were projected to be 3640 k EUR and total expenses were projected to be 4131 k EUR, resulting in a deficit of – 491 k EUR.

The Treasurer then stressed that while **epi** has a comfortable reserves position at present, continuing with

the current level of losses, will change this position. The consequence of a worsening position would leave no room for future investments and reduce **epi**'s flexibility in case of risk situations. The Treasurer then presented a graph showing that if **epi**'s annual subscription fee had been adjusted each year since 2016 in line with the inflation rate in Germany, its current amount would be close to 240 EUR. In order to bring **epi**'s finances back to an even break position, it would make sense to increase the annual subscription fee by 50 EUR, i.e. from 190 EUR to 240 EUR.

At this point, Mr QUINTELIER indicated that the **epi**-Finances Committee had explored in depth the reasons for needing an increase in the subscription fee, and after



extensive debate the Committee supported an increase in the annual subscription fee to €240.

This proposal was debated within Council and a motion was then tabled by Laurent NUSS to increase the annual subscription fee from 190 EUR to 250 EUR, with a late payment surcharge fee of 50% (i.e. 125 EUR). The motion was **adopted** with 68% in favour and 32% against. The studentship annual subscription fee was accordingly set at 125 EUR (50% of the "normal" subscription fee).

c) A revised planned 2024 budget was presented, taking into account the new amount of the annual subscription fee. In the revised budget, total revenues were projected

to be 4538 k EUR and total expenses were projected to be 4131 k EUR, resulting in a surplus of 407 k EUR. The revised budget was **adopted** with 92.5% in favour and 7.5% against.

10/ Report from the Diversity & Inclusion Working Group

Fatema SARDHARWALA, John GRAY and Marc NEVANT presented the activities of the WG since C94, which included: (i) an analysis of the statistics provided in the 2023 EQE survey report with respect to D&I questions; (ii) writing an article on the prerequisites to sit the future EQE, which was published in issue 3/23 of **epi** Information; (iii) attending various events notably giving a pre-



sentation at the event organized on 13 October 2023 by **epi** ("Half a century of EPC, 44 Years of EQE and opening a New Chapter").

Council **agreed** that the WG continues their work until at least the 2024 ordinary Spring Council meeting.

11/ Amendment of the Code of Conduct – Motions for establishing a new Working Group

a) The Chair of the Professional Conduct Committee, Giorgio CHECCACCI, presented proposals to amend the CoC. The scope of the proposed revision included:

- updating and improving some wording (to be as gender neutral as possible);
- addressing Continuing Professional Education;
- improving the definition of conflicts;
- giving indications about keeping files;
- addressing members' concerns during **epi** internal elections.

More specifically, the following proposals were put to vote.

Amendments of article 4, paragraphs (d), (e) and (f) dealing with conflicts

The amendments were **adopted** with 84.3% in favour and 16.7% against.

Introduction of new article 4, paragraph (h) dealing with the keeping of files

This was **rejected**: 50.4% were in favour and 49.6% were against; the required 2/3 majority was not obtained.

*Introduction of new article 8 dealing with the conduct of internal **epi** elections*

This was **adopted** with 74.4% in favour and 25.6% against.

General updates not impacting the substance of articles

This was **adopted** with 91.4% in favour and 8.6% against.

NB: the revised CoC will be soon available on our website

b) Mr CHECCACCI also presented the following motions intended to establish a Working Group aimed at studying whether our disciplinary system can be improved.

Motion 1: Does the Council approve establishing a WG ("DS WG"), with the task of studying the present disciplinary system and considering possible proposals to improve it?

The motion was **adopted** with 66.7% in favour and 33.3% against.

*Motion 2: Does the Council authorize the WG to address the EPO (and in particular the competent Principal Director) under the direction of the **epi** President or his delegate, to share opinions and proposals, with the understanding that the WG will report to the Council?*

The motion was **adopted** with 70.6% in favour and 29.4% against.



Motion 3: Does the Council approve populating the WG with the following list of members: Tim Powell; Martina Stork; Francis Leyder; Jonna Sahlin; Bart van Wezenbeek; Giorgio Checcacci; Magdalena Krekora; Jim Boff?

The motion was **adopted** with 60.3% in favour and 39.7% against.

12/ Motions on database of professional representatives

Council was informed that the EPO intends to no longer publish information about professional representatives in the OJ. The list will still be available online, and the EPO is contemplating to improve the search tool within the database. Different motions were discussed and voted on:

Motion 1: Does Council agree to include in the database of professional representatives available online the name of any association according to Rule 152(11) EPC?

The motion was **rejected** with 63.2% against and 36.8% in favour.

Motion 2: Does Council agree to include the nationality in the database of professional representatives available online?
The motion was **adopted** with 54.7% in favour and 45.3% against.

Motion 3: Does Council agree to include the place of business or employment in the database of professional representatives available online?

The motion was **adopted** with 73.6% in favour and 26.4% against.

Motion 4: Does Council agree to request the EPO that the database of professional representatives available online

includes, for each and any representative in the list provided by Art. 134(1) EPC, at least the name and the data mentioned in Art. 134(2) EPC, i.e. nationality and place of business, with no exceptions?

The motion was **adopted** with 54.7% in favour and 45.3% against.

Council was further of the opinion that there is no need for an OJ EPO publication at all because all information (concerning representatives) will be available in the searchable database.

13/ EQE Reform 1st Basket – Motions by Martina STORK

a) Vice President Tiem REIJNS presented the latest changes on the reform of the new EQE. VP REIJNS reminded Council that the REE and IPREE needed to be amended only to the extent that amendments were occasioned by the implementation of the new EQE concept. VP REIJNS also mentioned that the outcome of the eC95 motions and forum comments were shared with the EPO Lawyers. In a nutshell, the so-called “first basket” amendments were made to the article and rules shown below:



REE/IPREE amendments

- | | |
|----------------------------|--|
| 1. Art 1(5) REE | - Define papers in REE |
| 2. Art 3(7) and NEW Art 26 | - codify epi consultation for REE/IPREE |
| 3. Art 11 and 14 REE | - training period for examiners |
| 4. Rule 6(6) IPREE | - pass mark definition |
| 5. Rule 10(2) IPREE | - clarification |
| 6. Rule 10(3) IPREE | - exemptions for sitting F |
| 7. Art 25(6) REE | - cancelation of the pre-exam after 2024 |
| 1. NEW Art 27(3) | - sunrise period |

The following motion was then tabled:

Does Council support the present version of the new eEQE package as presented during C96?

The motion was **adopted** with 62.2% in favour and 37.8% against.

Council also **decided** that an extra Council meeting dedicated to the EQE was no longer necessary (94.5% in favour, 5.5% against).

b) A number of motions tabled by Martina STORK were then discussed and voted on.

Motion 1: Council does not agree to Art. 11(2)(b) REE, which would abolish the four-year minimum period of service as an examiner at the EPO, and to Article 14(2) REE, which would reduce the period of practice for examiners from two years to one year, in the form as presented on



November 4, 2023.

The motion was **adopted** with 73.3% in favour and 26.7% against.

Motion 2: Council strongly rejects the justification in the form as presented on November 4, 2023 along the amendments of Art. 11(2)(b)(iii) REE and Art. 14(2) REE, seemingly alleging that the skill levels of a European Patent Attorney and an EPO Examiner are more or less the same.

The motion was **adopted** with 78.1% in favour and 21.9% against.

Motion 3: Council does not agree to Rule 6(6) IPREE in the form as presented on November 4, 2023, because the introduction of setting a grade threshold for passing within a range of between 25% and 75% of the total achievable marks is not a sufficient definition of a pass level and because Rule 6(6) IPREE does not specify a very limited variation of the pass level according to the criterion of fitness-to-practice (see decision 6 of C95).

The motion was **adopted** with 64.5% in favour and 35.5% against.

14/ EQE Reform 2nd Basket

A short presentation was given by Anna VALBORG GUDMUNSDOTTIR on the topics to be addressed as part of a “2nd basket”, including: early registration and definition of training (Art.11 REE). No detailed discussion on these topics has taken place yet.

15/ Report from the Online Communications Committee

The Chair of the Online Communications Committee, John GRAY, informed Council that the EPO will decommission a number of services in 2024:

- No new smart cards will be issued (except for representatives using smart cards to access national

office systems – the service will be available until September 2024). Smart cards users should therefore get familiar with the new 2FA (two-authentication factor) system which is already working.

- Fax and Web form filing are going too. Representatives are encouraged to find the Contingency Upload Service to have a “Plan B” when things go wrong in their systems or EPO systems.

16/ Proposal for support for economically weak applicants

A new proposal from the EPO is on the table, which is to provide for a reduction in all fees for eligible entities, but with a reduced scope for eligibility. Eligibility would differ from the current criteria:

- natural persons
- micro-entities (< 10 persons, turnover and/or balance sheet < EUR 2 M, no more than 25% of capital held by another company);
- universities or not-for-profit research institutes.

Eligibility would thus not be restricted geographically; entities worldwide would benefit (e.g. a billionaire filing his first 5 European patent applications in his own name, or a micro-entity in China filing his first 5 European patent applications; by contrast a SME with 10 employees would pay the full cost).

The reduction would be cumulative with existing fee reductions.

The following motion was put to vote.





*“Support for economically weak applicants to obtain European patents is a useful thing, and a range of support is available from governmental sources. The EPO is not a government, but some support is provided through fee reductions in specific circumstances. However, if support is to be provided by the EPO, by fee reduction or otherwise, **epi** considers that it should be support that:*

- *Efficiently reaches deserving applicants*
- *Is not liable to distort applicant behaviour with a view to gathering that support; and*
- *Does not significantly increase costs for other applicants.”*

The motion was **adopted** with 93.1% in favour and 6.9% against.

17/ Closing of meeting

Secretary General AUGUSTYNIAK read the list of decisions and actions taken during the meeting, and President THOMSEN then officially closed the meeting at 6:45 pm.

Next deadline for **epi** Information

The Editorial Committee invites contributions for publication in the next issue of **epi** Information. Documents for publication or any enquiry should be sent by eMail to (editorialcommittee@patentepi.org) no later than **19 February 2024**.

Further information can be found in our “Guidelines for Authors” here: <https://patentepi.org/r/guidelines-epi-info>

Nächster Redaktionsschluss für **epi** Information

Bitte senden Sie Ihre Beiträge zur Veröffentlichung in der nächsten Ausgabe der **epi** Information an den Redaktionsausschuss. Alle Artikel oder Anfragen schicken Sie bitte an folgende Email Adresse

editorialcommittee@patentepi.org bis spätestens **19. Februar 2024**.

Weitere Informationen finden Sie in unseren „Guidelines for Authors“ auf der **epi** Webseite:

<https://patentepi.org/r/guidelines-epi-info>

Prochaine date limite pour **epi** Information

La Commission de Rédaction vous invite à lui faire parvenir vos contributions pour publication dans le prochain numéro d'**epi** Information. Les documents pour publication ou toute demande d'information doivent être envoyés par courriel (editorialcommittee@patentepi.org) au plus tard le **19 février 2024**.

De plus amples informations sont disponibles dans nos « Directives pour les auteurs » à l'adresse :

[https:// patentepi.org/r/guidelines-epi-info](https://patentepi.org/r/guidelines-epi-info)

epi Artists Exhibition 2024

The **epi** Artists Exhibition has become a cherished tradition within the cultural life of **epi**. Opened for the first time in 1991, it was followed by further events in 1994, 1996, 1998, 2000, 2003, 2006, 2009, 2012, 2015, 2018 and 2021 and is repeated every three years.

This unique exhibition features European patent attorneys who, in addition to their professional pursuits, showcase their artistic capabilities. The exhibition presents a diverse array of creative works ranging from paintings to graphical and fine art works, such as ceramics, sophisticated watches, jewelry, and artistic textile creations.

Throughout the years, the Exhibition has taken place in the foyer of the EPO which offered the possibility to present these intriguing artworks to a broad audience.

Notably, 2021 marked the Exhibition's 30th anniversary and Covid 19 restrictions required us to organise the Exhibition in a virtual manner on the **epi** website. A dedicated website section for the presentation of all **epi** Artists and their artworks was launched on the **epi** website to present their artwork, offering an expansive virtual stage. To duly honour the 31 participating **epi** artists and their artworks, the **epi** organised a virtual "Get Together", affording the artists the opportunity to engage with the audience, introduce their artworks, and to exchange experiences and thoughts.

The resounding success of the virtual exhibition in 2021 has led to the decision to continue this format in 2024.

A critical prerequisite for each Exhibition is a robust participation of artists eager to showcase their skills and art-

works. The virtual platform is envisioned to attract a more extensive and diverse participation from all contracting member states.

The intention is to prolong the visibility of the artworks and artists by maintaining an online presence on the dedicated website for an extended period, allowing all **epi** members to appreciate the creative contributions.

The **epi** warmly invites all creative **epi** members to participate in the exhibition by submitting the application form available at:

<https://patentepi.org/r/epi-artists-exhibition-registration>

Interested participants are encouraged to include a brief biography, a photograph, and background information outlining their inspiration, the history of the artwork, and the techniques employed.

It is foreseen to have the Exhibition online in May 2024. We are eagerly awaiting numerous applications to curate another vibrant virtual **epi** Artists Exhibition.

We are looking forward to receiving numerous applications to enable us to prepare the virtual **epi** Artists Exhibition in 2024.

Further information regarding the requirements for the provision of documents, artwork images and additional data will be communicated in due course.

For further inquiries, please contact us at the **epi** Secretariat at info@patentepi.org





Patent practice

UPC Spotlight

Opt outs, withdrawing opt outs, and “self-pinning” in the decision between *AIM Sport Vision AG v Supponsor Oy et al.*

J. Snape (GB); A. Michel-de Cazotte (FR); I. Barry (GB) – all of Carpmaels & Ransford LLP

Abstract

(EN) A crucial choice for patentees is whether to opt a patent, application, or SPC out of the competence of the UPC. The possibility of later withdrawing the opt out in order to enforce a patent in the UPC makes opting out seem appealingly flexible. But withdrawal may be blocked if prior national actions have been brought against the patent, even prior to the full entry into force of the Agreement on a Unified Patent Court. A recent decision from the Helsinki Local Division illustrates this risk and shows how UPC provisions may be interpreted. The decision is essential reading for practitioners.

(DE) Für die Patentinhaberin ist es von entscheidender Bedeutung, ob sie ihr Patent, ihre Anmeldung, oder ihr ergänzendes Schutzzertifikat (SPC) der Zuständigkeit des EPG entziehen will. Durch die Möglichkeit, den Opt-out zu einem späteren Zeitpunkt zurückzunehmen und wieder am EPG teilnehmen zu können, ist ein Opt-out scheinbar sehr flexibel. Die Rücknahme kann jedoch blockiert werden sein, wenn eine nationale Klage gegen das Patent vorher erhoben worden ist, sogar wenn eine solche Klage bereits vor dem vollständigen Inkrafttreten des Übereinkommens über ein Einheitliches

Patentgericht erhoben wurde. Eine kürzlich ergangene Entscheidung der Lokalkammer in Helsinki veranschaulicht dieses Risiko und zeigt, wie die Rechtsvorschriften des EPG ausgelegt werden können. Die Entscheidung ist für Rechtspraktiker eine unverzichtbare Lektüre.

(FR) Un choix crucial pour les titulaires de brevets est de décider s'ils veulent qu'un brevet, une demande de brevet ou un CCP soit soustrait de la compétence de la JUB. La possibilité de retirer l'opt-

out à une date ultérieure, et de pouvoir à nouveau participer à la JUB, donne l'impression que l'opt-out est avantageusement flexible. Mais le retrait d'un opt-out peut être bloqué si des actions nationales ont été engagées contre le brevet, même avant l'entrée en vigueur de l'accord sur la Juridiction Unifiée du Brevet. Une décision récente de la division locale d'Helsinki illustre ce risque, et montre comment les règles de la JUB peuvent être interprétées. Cette décision est une lecture essentielle pour les praticiens.

Opting out and the risk of “pinning”

Practitioners will know that patentees and applicants can opt their patents, applications, and SPCs¹ out of the competence of the UPC under Article 83(3) of the Agreement on a Unified Patent Court (UPCA) and Rule 5.5 of the Rules of Procedure (RoP).

Opting out has been viewed by some as a safe way of interacting with the UPC. Opting a patent out prevents a third party from filing a UPC action against the patent – which would otherwise tie the patent into the jurisdiction of the UPC, preventing any future opt out. This has been described as the third party “pinning” the patent into the UPC’s competence².

Whether or not a patentee has opted its patent out of the UPC, a third party may file an action against the patent in one or more national courts, thereby tying the patent into the competence of national courts – “pinning” the patent out of the UPC’s competence. Absent such pinning (i.e. if no national action has been filed against the patent), the patentee can “withdraw” the opt out at any time, under Article 83(4) UPCA and Rule 5.8 RoP, and place its patent back into the UPC’s competence. For example, an opt out withdrawal could be filed immediately before enforcing the patent in the UPC.

The apparent flexibility of opting out has obvious appeal.

Yet this ‘hedging-your-bets’ view of opting out is not so simple as shown by the Helsinki Local Division in its Decision of 20th October 2023³, in the case between AIM Sport Vision AG (claimant) and Supponor Oy et al. (defendants). The Division held that a national action commenced before the UPCA fully entered into force

on 1st June 2023 *did* prevent a patentee from withdrawing its opt out. In this case, the patent was effectively pinned out of the UPC’s jurisdiction by the patentee’s own opt out – in what may be described as “self-pinning”.

This article reviews the Decision’s implications for the validity of opt out withdrawals and examines how the Division interpreted of the UPCA and RoP.

The facts

The claimant brought an infringement action and an application for provisional measures against the defendants, on the basis of patent EP3295663⁴. The claimant had opted the patent out of the UPC’s competence on 12th May 2023, in the so-called ‘sunrise period’ prior to the UPC’s opening. The opt out took effect when the Court opened on 1st June 2023⁵.

The claimant then withdrew the opt out on 5th July 2023, under Article 83(4) UPCA:

Article 83(4) UPCA

Unless an action has already been brought before a national court, proprietors of or applicants for European patents or holders of supplementary protection certificates issued for a product protected by a European patent who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment. In this event they shall notify the Registry accordingly. The withdrawal of the opt-out shall take effect upon its entry into the register.

However, the defendants argued that the withdrawal was invalid, because appeals were pending before the German national courts: an appeal of a first-instance decision on infringement, issued on 4th April 2022, to

¹ For simplicity, this article will refer only to patents.

² E.g. “The Unitary Patent & Unified Patent Court: Guide to key features & perspectives”, Carpmals & Ransford LLP, 2023, page 6, <https://patentepi.org/r/info-2304-01>.

³ The Decision is combined for ORD_572699/2023 and ORD_581208/2023, corresponding to case number UPC_CFI_214/2023. The Decision may be accessed here: <https://patentepi.org/r/info-2304-02>

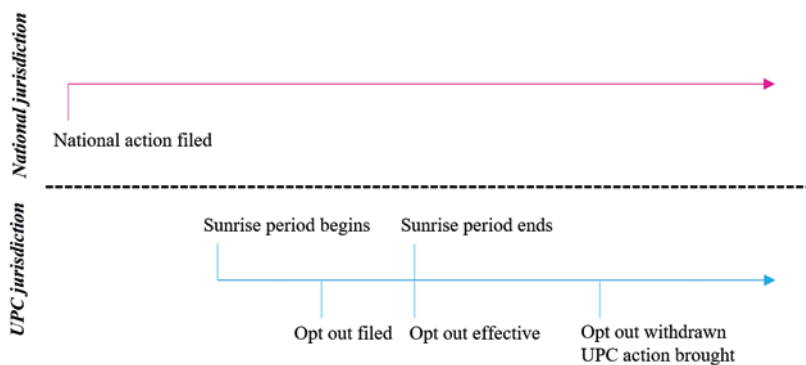
⁴ <https://patentepi.org/r/info-2304-03>

⁵ Rule 5.12 RoP.

be heard on 12th October 2023, and an appeal of a first-instance decision on revocation, issued on 10th November 2022, to be heard on 5th December 2024. The defendants argued that these were actions “*commenced before a court of a Contracting Member State in a matter over which the Court also has jurisdiction pursuant to Article 32*” within the meaning of Rule 5.8 RoP:

Rule 5.8 RoP

In the event that an action has been commenced before a court of a Contracting Member State in a matter over which the Court also has jurisdiction pursuant to Article 32⁶ of the Agreement in respect of a patent or application contained in an Application to withdraw, prior to the entry of the Application to withdraw in the register or any time before the date pursuant to paragraph 5⁷, the Application to withdraw shall be ineffective in respect of the patent or application in question, irrespective of whether the action is pending or has been concluded.



The fact pattern of the Decision, in which a prior national action was filed before an opt out took effect.

The Decision

The Division therefore focussed on Article 83(4) UPCA and Rule 5.8 RoP (herein, the “*opt out withdrawal provisions*”). The Division addressed “[t]he temporal scope” of these opt out withdrawal provisions in respect of national actions. Did the national actions, which were filed before the UPCA fully came into force, block the withdrawal of the opt out, meaning that the opt out had pinned the patent *out* of the UPC’s competence?

In this case, the Division said ‘yes’: the prior national actions invalidated the withdrawal, even though the actions were filed before the UPCA fully came into force. Consequently,

the opt out could not be withdrawn and the UPC did not have competence over the patent, so the actions were dismissed. In reaching its conclusion, the Division considered how to interpret the wording of the opt out withdrawal provisions, and whether its interpretation was compliant with non-UPC legislation such as the Vienna Convention on the Law of Treaties (VCLT) and the Brussels I Regulation (recast). These considerations are summarised below.

Article 83(4) UPCA and Rule 5.8 RoP

For this case, the Division considered that neither of the opt out withdrawal provisions contains an explicit time limit, such as a date before which national actions may have been brought without blocking a subsequent withdrawal of an opt out. For example, neither provision expressly states that national actions will *not* block withdrawal of an opt out if those national actions were brought prior to the 1st June 2023 entry into force of the UPCA. Article 83(4) UPCA simply states that an opt out may be withdrawn “[u]nless an action has already been brought before a national court”. Rule 5.8 RoP similarly lacks restriction, stating that any prior national action is relevant if brought “*prior to the entry of the Application to withdraw in the register or any time before the date pursuant to paragraph 5 [the effective date of opt out]*”.

The claimant seemed to argue that, because Rule 5.8 RoP stipulates that a prior national action has a withdrawal-blocking effect only if that action is “*in a matter over which the Court also has jurisdiction*”, then Rule 5.8 RoP could only apply to national actions brought *after* the Court started operations. There appears to have been some discussion

over whether the “*matter*” is a reference to the *patent* over which the action is brought (which appears to have been the claimant’s position), or to the nature of the action, with reference to Article 32(1) UPCA⁸. The Division rejected the claimant’s interpretation, finding that there is no reason to interpret the above expression in Rule 5.8 RoP such that only actions filed after 1st June 2023 would block withdrawal of an opt out, and rejecting any arguments that this interpretation leads to any results that are manifestly absurd or unreasonable, contrary to Article 32(b) of the Vienna Convention on the Law of Treaties (VCLT).

The Division seemed to favour a literal interpretation of the opt out withdrawal provisions⁹, suggesting that their meaning is “*clear from the wording*”¹⁰.

⁶ Article 32 UPCA specifies the actions for which the UPC has competence. They include actions for actual or threatened infringement, and actions for provisional measures.

⁷ The “*date pursuant to paragraph 5*” is the date of entry into the Register of an application to opt out, or the date of entry of a correction thereto.

⁸ Decision, page 11, paragraph 4.

⁹ Decision, page 11, paragraph 2.

¹⁰ Decision, page 9, paragraph 2.

Non-retroactivity under Article 28 VCLT

The claimant argued that any interpretation of the opt out withdrawal provisions must conform to the VCLT. In particular it highlighted the “rule of non-retroactivity” enshrined in Article 28 VCLT:

Article 28 VCLT – Non-retroactivity of treaties

Unless a different intention appears from the treaty or is otherwise established, its provisions do not bind a party in relation to any act or fact which took place or any situation which ceased to exist before the date of the entry into force of the treaty with respect to that party.

Simply stated, in the absence of a contrary intention, an international treaty does not apply to situations which occurred before the treaty entered into effect¹¹. This has been described as a “rebuttable negative presumption” because the rule may be overridden if “a different intention appears from the treaty or is otherwise established”¹².

The claimant’s argument was that the existence of prior national actions is an “act or fact which took place [...] before the date of the entry into force” of the UPCA. It argued that such acts or facts cannot be binding on a party according to Article 28 VCLT, and therefore the literal interpretation of the opt out withdrawal provisions cannot be correct.

The Division disagreed, drawing three main lines of reasoning:

- 1) The Division held that its interpretation of the opt out withdrawal provisions involved no violation of Article 28 VCLT because the act of opting out was performed with complete foresight of the UPC provisions¹³.
- 2) The Division also held that Article 28 VCLT was not contravened because non-retroactivity applies “[u]nless a different intention appears from the treaty or is otherwise established”¹⁴. The Division considered that the intention clearly present in the wording of the UPC provisions allowed for retroactive effect.
- 3) Finally, the Division held that Article 28 VCLT limits non-retroactivity to “any act or fact which took place or any situation which ceased to exist before the date of the entry into force of the treaty”. The

¹¹ Kryvoi and Matos, “Non-Retroactivity as a General Principle of Law” (2021) 17(1) Utrecht Law Review pp. 46-58. DOI: <https://doi.org/10.36633/ulr.604>

¹² Rosenne, Shabtai (1970) “The Temporal Application of the Vienna Convention on the Law of Treaties”, Cornell International Law Journal: Vol. 4: Iss. 1, Article 1.

¹³ Decision, paragraph bridging pages 9-10.

¹⁴ Decision, page 10, paragraph 1.

Division acknowledged that a prior national action may be an “act or fact”, but held that prior national actions are not a “situation which ceased to exist” prior to the UPCA¹⁵. The Division viewed the prior national actions as situations which *did* not cease to exist at the effective date of the opt outs.

The Division therefore saw no conflict between a literal interpretation of the opt out withdrawal provisions and Article 28 of the VCLT. The Division noted that its interpretation conformed with the general rule of interpretation in Article 31 VCLT, such there could be no recourse to supplementary means of interpretation as provided for in Article 32 VCLT.

Brussels I Regulation (recast)

The claimant argued that a withdrawal-blocking effect for pre-UPCA national actions contravened the Brussels I Regulation (recast):

Article 71c(2) Brussels I Regulation (recast)

Articles 29 to 32 shall apply where, during the transitional period referred to in Article 83 of the UPC Agreement, proceedings are brought in the Unified Patent Court and in a court of a Member State party to the UPC Agreement.



John Snape

Articles 29-32 Brussels I Regulation (recast) govern the handling of “*lis pendens*”, or “*related actions*” – in which proceedings involving the same cause of action, between the same parties, are brought in the courts of different Member States. The claimant argued that because the parties in the prior national actions were not the same as those in the present UPC case, the prior national actions should not exert a withdrawal-blocking effect.



Agathe Michel-de Cazotte

The Division disagreed, using two main lines of reasoning:



Isobel Barry

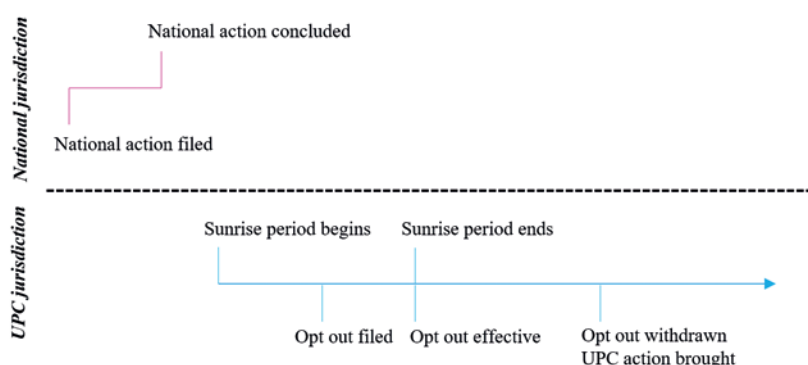
¹⁵ Decision, page 10, paragraph 2.

- 1) It held that the opt out withdrawal provisions concern a situation which does not involve actions being brought between different Member States, because the UPC's competence had been removed by the opt out. The question was whether *withdrawal* of the opt out had been blocked (i.e. whether the UPC's competence should be restored), and the Division's answer in the negative meant that Article 71c(2) did not apply¹⁶.
- 2) The Division also highlighted that the UPC provisions do not mention parties, only patents. It was therefore enough that the patent in question had been subject to prior national actions, whether or not the same parties had participated.

Overall, the Division's interpretation of the opt out withdrawal provisions is clear: when a prior national action was commenced before and remains pending after an opt out took effect, withdrawal of the opt out is prevented by Rule 5.8 RoP. The patentee's opt out causes "self-pinning" of the patent *outside* the UPC's competence.

"Self-pinning" in other guises

A natural extension of this scenario is a prior national action that was commenced *and concluded* before an opt out took effect. Do concluded prior national actions also trigger the withdrawal-blocking effect of Rule 5.8 RoP, and mean that the opt out causes self-pinning?



A different fact pattern to that of the Decision; here, a prior national action was concluded before an opt out took effect.

The Division would not be drawn on this specific point, highlighting that the case at issue involved prior national actions that were pending on 1st June 2023 (when the opt out took effect) and were still pending when the Decision was handed down¹⁷. Even so, the Division appeared to favour a literal interpretation of the opt out withdrawal provisions, the wording of which it held to contain no explicit time limit. As recorded in the Decision, almost all elements of the Division's reasoning seem equally applicable to prior national proceedings that are concluded, as they do to those prior national proceedings that remain pending. The Division reached its conclusion in the current Decision having already acknowledged the claimant's argument that a literal interpretation of the opt out withdrawal provisions "would discriminate against all those patentees whose European patents have ever been subject to a former national action"¹⁸.

Opting out: not without risk

"There's no such thing as a 'wait and see' approach to the UPC", according to the President of the Court of Appeal of the UPC, Klaus Grabinski¹⁹.

The President may not have had the UPC's opt out system in mind, but the above statement seems apt following the Helsinki Local Division's Decision. Far from being a passive, 'wait-and-see' strategy, opting out can be a permanent choice – an act of "self-pinning" – depending on the national actions that have been filed against the patent previously.

Practitioners will no doubt be keen to see whether the Decision is appealed and, if so, whether the UPC's Court of Appeal also addresses the issue of concluded prior national proceedings.

Disclaimer

All views expressed apply solely to the decision under discussion. All views are those of the author(s) at the time of writing, and do not necessarily represent the authors' current views or those of their employer. This article provides a summary of the subject-matter and should not be acted on without first seeking legal advice.

¹⁶ Decision, page 10, final paragraph.

¹⁷ Decision, page 11, paragraph 3.

¹⁸ Decision, page 11, paragraph 1.

¹⁹ No such thing as 'wait and see' approach, warns UPC's top judge as sunrise period begins, Houldsworth and Grabinski, 1st March 2023, <https://patentepi.org/r/info-2304-04>

Navigating through the Unitary Patent System and the Unified Patent Court (UPC)

Mr Wizner and Mr Oleksyn, Sołtysiński Kawecki & Szlęzak,
Ms Przytocka and Mr Siewlewiesuk, AOMB Polska

On 1 June 2023, the Unified Patent Court Agreement entered into force, and with it the EU Regulations¹ establishing the Unitary Patent System. On the same day, the Unified Patent Court (UPC) also started its operations.

Although Poland, like Croatia or Spain, has not joined the UPC Agreement, these developments and the activities of the UPC will certainly have a significant impact on the activities of Polish entities, especially entrepreneurs.

National patent, European patent (EP) or European patent with unitary effect (EPUE)

An applicant may apply for protection for the same invention under a national application filed with the relevant national patent office (e.g. when applying for protection in Poland – with the Polish Patent Office (PPO)) or under the European application with the European Patent Office (EPO). The most common practice for applicants is to first file a national application in “their” country (i.e. the country in which the applicant is established) and then file an application with the EPO within 12 months on a priority basis. The EPO and the relevant national office work in parallel and independently of each other. Both applications can get patent protection or be rejected. There is also the possibility that one authority will grant protection and the other will not.

Protection can be sought before the European Patent Office according to two procedures. The path so far has been to perform validations (translations) in selected countries after being informed of the granting of the European patent. The protection thus obtained is valid in countries chosen by the right holder from among the 39 countries of the European Patent Organisation². In addition, there is a group of countries³, which under

separate agreements recognise European patents on their territory. By fulfilling the relevant conditions, the right holder of the European patent can make its patent also valid in countries of its choice from this group. Validation in countries of the right holder’s choice still remains an option available to right holders. However, as of 1 June 2023, the second possible path to seek protection, in the 17 countries⁴ that have agreed to this, is the European patent with unitary effect, where protection covers 17 countries simultaneously. Such protection, called unitary protection, is an alternative possible instead of validation in these 17 countries.

The UPC will settle disputes in 17 countries, i.e. Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, Sweden, with effect for all these countries. The UPC is empowered to handle disputes relating to unitary patents and European patents validated and remaining in force in countries that have ratified the UPC Agreement, unless the right holder has actively acted to exclude its patent from the competence of the UPC by filing a so-called *opt-out*. Issues of infringement and validity of validated European patents for which an *opt-out* has been filed will be decided by national authorities. In any case, for the first 9 months from the date of publication of the European patent, opposition will be possible, filed with and adjudicated before the EPO.

Revocation of the European patent with unitary effect before the UPC will have the effect of revoking it in all of these 17 countries. For other European patents that are not European patents with unitary effect, patent revocations are carried out separately in each country before the national authority of the country where the validation took place.

Double protection for the same invention is not yet regulated in Poland. Such a situation may arise if national protection is obtained and at the same time in the EPO and validation is carried out in Poland. Such a scenario is possible with an existing European patent and with

¹ Regulation (EU) No 1257/2012 of the European Parliament and of the Council (hereinafter “**Regulation 1257/2012**”) and Council Regulation (EU) No 1260/2012.

² Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Montenegro, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, North Macedonia, Malta, Monaco, Spain, Netherlands, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Sweden, Switzerland, Turkey, United Kingdom

³ Bosnia and Herzegovina, Morocco, Moldova, Tunisia, Cambodia

⁴ Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, Spain, Sweden

the European patent with unitary effect. The applicant may choose protection through a unitary patent and at the same time conduct validations in other countries of interest. This is not allowed in most countries of the European Patent Organisation. A previous positive decision to grant patent protection precludes the grant of a second one. This is the case in Germany, among others, where the validation of the European patent excludes protection derived from a national patent. At the same time, in Italy – this year and probably in connection with the entry into force of the unitary patent system, of which Italy is a member – the previous rules on the invalidity of a national patent vis-à-vis the European patent for the same invention have been amended and it is now permissible there to obtain dual protection – i.e. protection from the European patent (with unitary or national effect) and from the Italian national patent. Such a change is likely to ensure that key inventions are protected at national and European level. Among the 17 Member States where dual patent protection is not allowed, the revocation of the EPUE or other action will take place before a single authority – the UPC. In countries where the issue of dual protection is not regulated or such protection is allowed,

court cases based on the EPUE will be decided before the UPC, while those based on a national patent will be decided before a national authority.



Wojciech Wizner

According to the Regulation 1257/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, this Regulation should not replace the patent laws of the participating Member States and should give freedom to the applicant to choose the type of protection. The applicant should remain free to choose to apply for: (i) a national patent, (ii) the European patent with unitary effect, (iii) the European patent valid in one or more of the Contracting States to the EPC or (iv) the European



Magdalena Przytocka

patent with unitary effect valid additionally in one or more of the Contracting States to the EPC which are not participating Member States. It follows that the situation of double patenting for a national patent and the European patent with unitary effect depends on the national law of each country. The example of Italy shows that legal changes governing double protection can also occur in other of the 17 states participating in the Unitary Patent System.

It is not possible to simultaneously validate the same European patent in any state participating in the Unitary Patent System and claim the unitary effect of that European patent. By way of example, an applicant cannot validate, for example, in Germany and at the same time file an application for the European patent with unitary effect, as Germany is among the 17 countries of the Unitary Patent System.

In those countries where the issue of double patenting is not regulated, the right holder may face revocation before several authorities. A right holder who obtains the European patent with unitary effect and, at the same time, has another – national – exclusive right, relating to the same invention, will be a party to the proceedings before both the UPC and the national court. The two proceedings will be conducted separately.

UPC competence – 17 EU Member States (currently)

The UPC, at this stage, covers the territories of 17 Member States, which is less than half of the territories falling within the territorial scope of the European patent. In the future, however, the number of countries for which UPC has competence may change.

Structure of the UPC – many divisions, many countries

Structurally, the UPC comprises the Court of First Instance (CFI), the Court of Appeal and the Registry.

The Court of Appeal and the Registry are located in Luxembourg.

The Court of First Instance, on the other hand, is decentralised and consists of a central division and local and regional divisions.

CFI's central division is based in Paris and has sections in Milan⁵ and Munich.

The central division and sections have competence over solutions in a class according to the International Patent Classification⁶, according to the table below:

⁵ It was previously assumed that this section would be based in London.

⁶ International Patent Classification.C

Milan	Paris	Munich
(A) Human necessities (without SPCs ⁷)	(B) Performing operations, transporting	(C) Chemistry; metallurgy (without SPCs)
	(D) Textiles; paper	(F) Mechanical engineering; lighting; heating; weapons; blasting
	(E) Fixed constructions	
	(G) Physics	
	(H) Electricity	
	Supplementary protection certificates	

Source: <https://patentepi.org/r/info-2304-05>

In practice, this means that the subject matter of the patent will influence which central division or section of the court will have competence to decide the case. The aim is for the division handling the case to have not only legal competence, but also technical competence in the relevant technical field.

Local divisions, however, have been established in the following cities: Vienna (Austria), Brussels (Belgium), Copenhagen (Denmark), Helsinki (Finland), Paris (France), Düsseldorf (Germany), Hamburg (Germany), Mannheim (Germany), Munich (Germany), Milan (Italy), Hague (Netherlands), Lisbon (Portugal), Ljubljana (Slovenia).

Currently, 1 regional division – Nordic-Baltic – has been established, which includes the following cities: Stockholm (headquarters), Riga, Tallinn, Vilnius.

In practice, this means that in most states participating in the Unitary Patent System there is a division of the court, while in countries outside the Unitary Patent System – such as Poland, Spain or Croatia – there are no such divisions.

A transitional period, the so-called *opt-out* (waiver of UPC competence) and *opt-in* (2023-2030 or even longer)

Ultimately, the UPC will be the sole court of competence for both EP European patents and European patents with unitary effect.

In contrast, there will be a transitional period for the first 7 years⁸ of the operation of the UPC. During this period, **actions may still be brought before national courts or other competent national bodies** for infringement or invalidity of the European patent or actions for infringement or invalidity of a supple-

mentary protection certificate issued for a product protected by the European patent.

In addition, during the transitional period, an EP right holder (including with SPC) as well as an EP applicant have the possibility to opt-out from the exclusive competence of the Court. This possibility does not apply to the EPUE. In practice, this means that, in the absence of the opt-out, either the UPC or the national court/authority will have exclusive competence when the first case is brought before such a court/authority. In contrast, in the case of the opt-out, only national courts/authorities will have competence to assess the patent in question. Withdrawal of such an opt-out will be possible at any time (*opt-in*). However, in light of the UPC Agreement, it is not entirely clear whether such an opt-out will have effect for the entire duration of the patent and not just for the duration of the transitional period (although the prevailing view seems to be that the effect will be for the entire duration).

In summary, in practice, this means that the default competent court is the UPC, but now and until 2030, an *opt-out* can be filed, in which case the national court will have competence. The *opt-out* cannot be filed after a claim has been filed with the UPC (too late). The *opt-out* can be withdrawn (by submitting the *opt-in*). The *opt-out* and the *opt-in* is filed by the applicant/patent holder – because he/she is the holder of the right, which is the European patent, EP, or European patent with unitary effect, EPUE.



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⁷ Supplementary protection certificate.

⁸ Note: this period may be extended by up to 7 years.

Competence of the UPC – not only European patents with unitary effect

The UPC's competence is to adjudicate on European patents (EP) or European patents with unitary effect (EPUE), as well as supplementary protection certificates (SPC) based on the said patents, with regard to:

- 1.1. actual or threatened infringements, counterclaims for licences;
- 1.2. provisional and protective measures and injunctions;
- 1.3. declarations of non-infringement;
- 1.4. revocations;
- 1.5. counterclaims for revocation.

In addition, the UPC will hear cases:

- 2.1. for damages or compensation derived from the provisional protection conferred by a published European patent application;
- 2.2. concerning the use of an invention prior to the granting of a EP or EPUE or concerning a right based on prior use of an invention;

- 2.3. for compensation for the EPUE licence under art. 8 of the Regulation 1257/2012;
- 2.4. concerning the decisions of the European Patent Office arising from its administrative tasks⁹.

Thus, at first glance, the broad scope of the UPC's competence is apparent, contrary to the intuition suggesting its competence only over the EPUE.

With the exception of the cases under point 2.4, the parties will be able to agree on the handling of the case at the division of their choice (including central division). However, it can be assumed that such a situation will be rare and that the competent division will be determined based on the rules expressed in art. 33 of the UPC Agreement.

The rules for determining the division of competence depending on the type of case are (in a nutshell) set out in the table below:

⁹ As indicated in art. 9 of the Regulation 1257/2012.

Type of case	Competent division
1.1, 1.2, 1.5*, 2.1, 2.2	<p>1 The local division where the infringement has occurred or is threatened to occur or the regional division in which that contracting Member State participates. The local division where the defendant (one of the defendants) has residence or has its principal place of business.</p> <p>*If a counterclaim is filed, the division concerned may:</p> <ol style="list-style-type: none"> (1) proceed with both the infringement action and the counterclaim for revocation and request the assignment of a technical judge (2) refer the counterclaim for revocation to the central division for consideration and suspend or proceed with the action for infringement; or 3) with the agreement of the parties, refer the case for decision to the central division.
2.3	<p>The local division to which the territory in which the defendant/one of the defendants has residence or has its principal place of business or the regional division in which that Contracting Member State participates. If outside the territory of the contracting countries, the central division (or competent division where the infringement occurred/was threatened).</p>
1.3, 1.4	<p>Central division. However, if an action for infringement, between the same parties and concerning the same patent, is brought before a local or regional division, these actions may only be brought before the same local or regional division.</p>
2.4, as well as cases in which the territory of the country in question does not fall under the local/regional division	<p>Central division.</p>

Languages of proceedings before the UPC – various possibilities, trend: towards the language of the patent grant (English, German, French)

There will be a number of procedural languages available before the UPC.

The starting point will be the languages of the local or regional division concerned. In contrast, the UPC Agreement provides for the possibility to choose the language in which the patent is granted in certain situations – primarily depending on the location of the parties and the linguistic competence of the adjudicating panel.

In the central division, on the other hand, the language of proceedings is the language in which the patent in question was granted.

Patent infringement and the assumptions of the UPC procedure – quick and effective protection for the right holder

The owner of the EP/EPUE, in proceedings before the UPC, may seek an injunction against a third party not having its consent, in relation to:

- a) regarding the product patent:
 - a. making,
 - b. offering,
 - c. placing on the market,
 - d. using,
 - e. importing or storing the product for those purposes;
- b) regarding the process patent:
 - a. using a process,
 - b. offering the process,
- c) In terms of a product obtained directly through the use of a protected method:
 - a. offering,
 - b. placing on the market,
 - c. using or importing or storing for these purposes;
- d) indirect use of the invention, understood as supplying (or offering to supply) to any person other than a party entitled to exploit the patented invention, means relating to the so-called “essential element” of that invention, when the third party knows or should have known that such means are suitable and intended for the practical application of that invention (exception: this does not apply to means that are “staple commercial products”; exception to the exception: unless there is a situation of inducement by the third party of the person supplied to engage in specific prohibited acts).

What is striking, therefore, is the broad catalogue of the right holder's claims, which also explicitly includes indirect

infringement. From the point of view of the Polish reader, it is worth noting that the issue of indirect infringement is not regulated in Polish law.

In a very simplified outline, the proceedings before the UPC will proceed as follows:

- 1) written procedure (letter initiating the proceedings and letters covering the presentation of the parties' positions);
- 2) ancillary procedure (primarily preparation for trial);
- 3) oral procedure (hearing);
- 4) compensation procedure;
- 5) procedure regarding cost provisions.

The aim is for proceedings before the UPC to be swift.

The UPC will also be able to apply a broad catalogue of measures to protect (or assist in protecting) the right holder's rights even before the decision finding an infringement is issued. For example, the UPC will be able to:

- 1) order the preservation of evidence using provisional measures such as detailed description, sampling, physical seizure of products, relevant materials and implements and related documents;
- 2) order inspection of the premises;
- 3) prohibit, provisionally and where appropriate subject to a recurring penalty payment, continuation of the alleged infringement or allow them subject to the lodging of guarantees to compensate the right holder;
- 4) order the seizure or delivery up of products suspected of infringing a patent;
- 5) order a precautionary seizure of movable and immovable property belonging to the alleged infringer, including blocking of bank accounts and other assets belonging to that person;
- 6) order a party not to remove or dispose of any assets located within its competence regardless of whether they are within the competence of the Court.

In addition, the UPC will be able to order the production of evidence under the control of the opposing party or a third party.

In relevant situations, the UPC will be able to decide on a particular measure even before the start of the proceedings on the merits of the case, thus also immediately after receiving the letter initiating the proceedings and even without hearing the other party.

The judges of the UPC will include not only legally qualified judges, but often also those technically qualified. The UPC is intended to ensure that proceedings are conducted swiftly by experienced and qualified judges who hold expertise and appropriate training for patent litiga-

tion – including: judges competent in the specific fields of technology to which the patent relates.

Declaration of non-infringement and protective letters (although not for everyone)

A third party wishing to start using a particular solution, after having contacted the right holder and no response from it within one month, will be able to bring an action for declaration of non-infringement. This is intended to provide protection to a third party who may be accused of patent infringement. Such an action will seek a judgment from the UPC confirming that the solution in question does not infringe the patent/SPC.

In addition, the possibility of filing a so-called protective letter is provided for, but not by everyone – the circle of entities in this case has been limited to those entitled to initiate proceedings under art. 47 of the UPC Agreement, and only if there is a suspicion that provisional measures may be requested against them. However, this limitation is not entirely clear – art. 47 of the UPC Agreement first mentions the patent owner and the holder of the exclusive licence as being entitled to bring an action, which, from the perspective of protection against provisional measures sought by, for example, the owner of *another* patent, would require the potential infringer to be both the holder of *its own* patent or *its own* exclusive licence. Perhaps, however, the possibility for entities other than the patent owner or exclusive licensee to file protective letters should be seen in para. 6 of art. 47 of the UPC Agreement, which provides that “Any other natural or legal person, or any body entitled to bring actions in accordance with its national law, who is concerned by a patent, may bring actions in accordance with the Rules of Procedure”.

With a strict, narrow understanding of the entities entitled to file a protective letter, it will be possible in practice that a protective letter could not be filed by an entity without a unitary patent who, for example, expects to initiate proceedings before the UPC due to proceedings in other countries. As a general remark, it is worth noting that only the practice of the UPC will bring concrete information in this regard. The necessary interpretation of the provisions of the UPC Agreement will then also take place.

For example, it will be possible to include in the protective letter arguments for the rejection of requests for provisional measures. Thus, the UPC receiving, for example, an action together with requests for preservation of evidence, will have the opportunity to familiarise itself with the arguments of the alleged infringer, which may significantly increase the defendant's chances for a decision to not apply provisional measures. Such a letter will have to be filed in the language of the patent in question, the infringement of which could potentially be raised. The letter will

be subject to a fee of EUR 200 for filing and storage for six months. There is a fee of EUR 100 for extending the storage of the letter. On the other hand, if provisional measures are requested, such a letter is forwarded to the competent panel. Protective letters are not made publicly available.

Settlements before the UPC

The UPC agreement is to promote quick resolution of disputes by the parties themselves through settlement. A settlement will be possible at any time during the proceedings, with confirmation of such settlement by the UPC.

However, it should be noted that such a settlement will not be able to result in the revocation or limitation of a patent.

Polish entities before the UPC – new possibilities to claim protection and the need for increased vigilance regarding the patent clearance of products when operating in EU markets

Although, as mentioned in the introduction, Poland has not joined the UPC Agreement, the UPC is not indifferent to Polish entities. There are primarily 2 situations to consider here:

- 1) Polish holder of the EP or EPUE;
- 2) Polish entity operating in the territories of countries that have ratified the UPC Agreement.

Situation 1

From the perspective of a Polish right holder, the UPC may appear as an efficient forum for claiming protection for its patent/SPC protected solutions. Particularly in the case of strong patents, it can be assumed that the UPC will provide quick and effective protection against infringements. In addition, the UPC could be part of a multi-territory enforcement strategy – for example, it will be possible to assert patent protection before the UPC, which will cover 17 Member States, and in parallel assert protection in proceedings before the courts of countries not covered by the UPC. In this way, the right holder will be able to obtain protection in a significant number of markets, with the cost stability that comes from covering 17 countries in a single proceeding. Although enforcing patent claims before the UPC and, at the same time, before the national courts in the country where the patent was validated may require increased effort and careful coordination on the part of the right

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holder, it creates new opportunities for the right holder to protect its technical solutions. Bearing in mind that the judges of the UPC will also include judges with a technical background, it must be assumed that the UPC will bring a new quality as to the assessment of the acquisition of a protected combination of technical features (and therefore the assessment of infringement) by the disputed solution. Before the UPC, the right holder has a certain degree of freedom to choose the division of the UPC before which it will bring an action. In addition, the UPC has a wide range of measures to temporarily safeguard the interests of the right holder. Although time will only tell, already at this stage it is to be expected that the UPC will be an affordable (also cost-wise – especially when covering several countries) court for obtaining patent protection.

Not only is unitary protection cheaper to obtain and maintain compared to patent validations in individual countries (even in a few countries, not to mention all 17), it is also far simpler to obtain, as it requires only one application – to the EPO (rather than several or a dozen validation applications in individual countries). Also, maintaining unitary protection from one year to the next (by paying one annual fee – to the EPO) is simpler than paying fees separately in several or more validation countries).

In terms of costs, a patent with unitary effect is, as mentioned, a significantly cheaper solution compared to traditional patent validations in 17 countries. Indicative estimates made by the authors of this article indicate that – once the European patent has been granted – obtaining unitary effect means, in practice, a cost of approximately EUR 1,500, while maintaining it for up to 20 years from the filing date – a cost of approximately EUR 40,000, including the official fees payable, as well as the cost of monitoring the timing and payment of these fees. In comparison, the cost of validating the European patent in the 17 states participating in the Unitary Patent System is approximately EUR 20,000, and the cost of maintaining protection for up to 20 years from the filing date is more than EUR 200,000 (including official fees for monitoring the timing and payment of these fees). Indeed: since June, we have seen a lot of interest among our clients in obtaining unitary protection. This is particularly the case for SME beneficiaries, for whom the low cost of such protection is a very important argument. This cost is further reduced by the possibility to file, together with the unitary effect application, a translation of the patent into Polish (even though Poland is not a member of the Unitary Patent System countries) and to use the same translation to validate the patent in Poland. In addition, the right holder, which is an SME from Poland, receives an amount of EUR 500 from the EPO as compensation for the translation costs of the patent.

Situation 2

In turn, Polish entities operating in the territories of countries that have ratified the UPC Agreement must take into account the risks associated with proceedings brought before the UPC, as well as the available ways to minimise/avoid them. In any case, so called FTO (*freedom to operate*) studies should be carried out prior to the introduction of a product into the EU markets in order to pre-establish the risks associated with potential infringements of intellectual property rights (including patents and SPC). When such risks arise, a product-specific strategy should be prepared that takes into account (by way of example) the possibilities of a non-infringement action, the need to file a protective letter, or the prospects of a central revocation of the European patent before the UPC. Failure to prepare such a strategy can, unfortunately, have drastic consequences for the provisional measures of a fast-acting UPC.

Representation before the UPC

In the course of the initiated proceedings, the parties are represented, according to art. 48 of the UPC Agreement, by professional attorneys. The representative may be a lawyer who is entitled to act before a court of a contracting Member State (so, for example, before a German court) or the European patent attorney who is entitled to act before the European Patent Office and to solve patent disputes. The European patent attorney acquires his/her qualification for patent litigation by obtaining the European Patent Litigation Certificate, completing legal studies in accordance with the relevant training standards in a Member State of the European Union and, within one year of the entry into force of the UPC Agreement, also by submitting a diploma from one of the relevant courses¹⁰. Eligible attorneys can obtain support from patent attorneys who are not entitled to representation before the Unified Patent Court. Such individuals may also speak at the trial.

It is important to note that the power of representation before the Unified Patent Court is not limited to European patent attorneys from states participating in the Unitary Patent System. European patent attorneys from e.g. Poland or the UK may be included in the list of authorised representatives before the UPC and are thus entitled to represent the parties before the UPC.

A party is not obliged to be represented by an attorney in several situations. These exceptions are: appeals against the EPO decision on the registration of the European patent with unitary effect, the filing of an *opt-out* application, the filing of a request for legal aid and the payment of official fees.

¹⁰ As indicated in the *Rules on the European Patent Litigation Certificate and Other Appropriate Qualifications*

From the perspective of Polish entrepreneurs, it will also be no less important to determine the optimal strategy for enforcing the EP or EPUE rights or defending against claims incurred against them before the UPC – involving a law firm experienced in conducting and coordinating cross-border patent litigation or an attorney's office with European patent attorneys authorised to represent them before the Unified Patent Court.

In summary, the UPC represents both new opportunities to efficiently enforce the protection granted by the European patent and the need to pay particular attention to the exclusive rights enjoyed by others operating in the markets of countries that have ratified the UPC Agreement. Currently, there are 17 EU countries, mentioned earlier, but it is assumed that more countries will decide to join the Unified Patent Court Agreement in the future.

The “long arm” of the Unified Patent Court

– on the property-based subsidiary international jurisdiction over defendants from non-EU states

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Brief summary:

Art. 71b no. 3 of Regulation (EU) No. 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, as amended by Regulation (EU) No. 542/2014, grants the Unified Patent Court property-based subsidiary international jurisdiction over defendants who are not domiciled in a Member State of the European Union (EU). This allows to establish jurisdiction of the Unified Patent Court for a legal dispute concerning an infringement of a European patent by a defendant from a “non-EU state”. This “long arm” makes it possible to use the Unified Patent Court to claim damages arising from such an infringement outside the EU. In particular, Contracting States of the European Patent Convention that are not Member States of the European Union are in the focus of the “long arm”. However, if the defendant is domiciled in a Member State of the 2007 Lugano Convention, it should be protected from the “long arm”.

Core theses:

- The “long arm” gives the Unified Patent Court a geographically far-reaching jurisdiction for damages caused by a patent infringement outside the Member States of the European Union and thus also outside the Contracting Member States of the Unified Patent Court Agreement (UPCA).
- The UPC may have subsidiary jurisdiction for damages resulting from the infringement of a European patent in a Contracting Member State of the UPCA (narrower interpretation) or even due to an infringement in a Contracting Member State of the EPC which is not a Contracting Member State of the UPCA (broader interpretation).

- Practice will show in what form the UPC will exercise its subsidiary competence.
- However, defendants from Iceland, Norway or Switzerland should be safe from the “long arm” of the UPC due to the primacy of the 2007 Lugano Convention (Lugano Shield).

Introduction:

On 1 June 2023, the Unified Patent Court, or UPC for short, commenced its work.¹ The UPC opens up interesting new possibilities for conducting patent disputes. This article takes a closer look at the possibilities arising from the UPC's new property-based subsidiary international jurisdiction (also referred to as the “long arm” or *long-arm jurisdiction* of the UPC)² and which have already been the subject of a number of publications.³

In order to analyse the property-based subsidiary international jurisdiction, it may be worth to take first a look at the jurisdiction of the UPC in general. According to Art. 1 sentence 1 of the Agreement on a Unified Patent Court,⁴ in short UPCA, the UPC is established for the settlement of disputes

¹ <https://patentepi.org/r/info-2304-06>, <https://patentepi.org/r/info-2304-07>, each accessed on 07/06/2023.

² The term *long-arm jurisdiction* is sometimes used in different ways. In this article, it refers to the jurisdiction of courts for proceedings that lie outside their actual territory.

³ See e.g. P. Véron, Extent of the Long-Arm Jurisdiction Conferred upon the Unified Patent Court by Art.71(b)(3) of the Brussels I Regulation as Amended by Regulation 542/2014 of May 15, 2014: Turkish Delight and a bit of Swiss Chocolate for the Unified Patent Court, *European Intellectual Property Review*, Vol. 37, Issue 9, 2015, pp. 588-596; P. Mankowski, Die neuen Regeln über gemeinsame Gerichte in Artt. 71a-71d Brussels Ia Regulation, *GPR* 2014, 330-342; P. A. de Miguel Asensio, The Unified Patent Court Agreement and the Amendment to the Brussels I Regulation (recast), in *Luci e ombre del nuovo Sistema UE di tutela brevettuale*, ISBN 978-88-348-4793-0, pp. 153-170, 2014

⁴ Official Journal of the European Union, C 175 of 20 June 2013, p. 1.

relating to European patents and European patents with unitary effect.⁵ The UPC therefore serves not only to settle disputes relating to European patents with unitary effect, but also to settle disputes relating to European patents without unitary effect.⁶

Art. 3 UPCA further restricts the scope of the Agreement – and thus also of the UPC – to European patents “*which [have] not yet lapsed at the date of entry into force of this Agreement or [are] granted after that date*”. At the same time, according to Art. 3 UPCA, the scope covers supplementary protection certificates⁷ and European patent applications “*which [are] pending on the date of entry into force of this Agreement or which [are] filed after that date*”. European patents that expired before 1 June 2023 and European patent applications that were filed before 1 June 2023 but were no longer pending on 1 June 2023 may therefore not fall within the scope of the UPCA and thus within the jurisdiction of the UPC.

This probably also applies to patents that come into existence on the basis of an extension or validation agreement, because they are not granted under the provisions of the European Patent Convention (EPC),⁸ but on the basis of the national law of the extension or validation states.^{9,10} Patents in extension or validation states are therefore unlikely to be European

patents within the meaning of the UPCA¹¹ and should therefore not play a role in the following discussion. Similar arguments may apply to registrations in Hong Kong.

The territorial scope or effect of a European patent with or without unitary effect (or a European patent application) also plays a role in determining the jurisdiction of the UPC.¹² To this end, it should be recalled that a European patent “*shall [...] confer on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State*”.¹³ The term “European patent” therefore covers the entire bundle of national rights, irrespective of whether or not any part of this bundle has unitary effect. A European patent therefore initially concerns all Contracting States of the EPC.¹⁴ However, only 24 Member States of the European Union (EU) have signed the UPCA to date and only 17 of them have ratified it, i.e., only 17 of the Contracting States of the EPC are also Contracting Member States to the UPCA, i.e., so-called Contracting Member States pursuant to Art. 2 lit. c) UPCA.

Figure 1 illustrates the relationship between the Contracting States of the EPC and the Contracting Member States of the UPCA (and others).

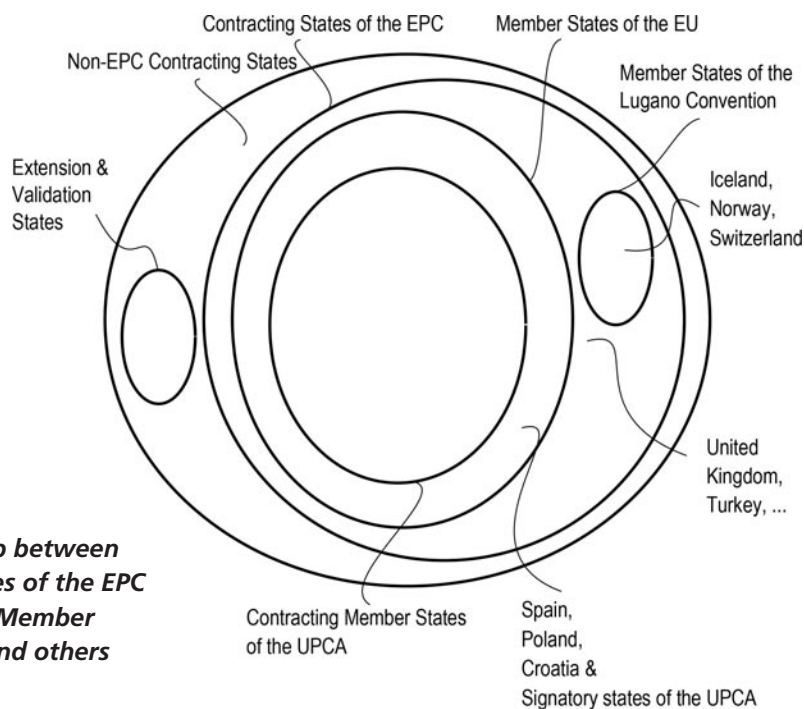


Figure 1: Relationship between the Contracting States of the EPC and the Contracting Member States of the UPCA and others

5 See point (24) of the preamble to REGULATION (EU) No 1257/2012 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection.

6 The difference between the two forms of a European patent is explained in more detail in Art. 2 UPCA. Accordingly, the term “European patent” under Art. 2(e) UPCA refers to a patent granted under the EPC which does not have unitary effect under Regulation (EU) No 1257/2012. According to Art. 2(f) UPCA, a “European patent with unitary effect” means a patent granted under the EPC which has unitary effect under Regulation (EU) No 1257/2012.

7 I.e. a supplementary protection certificate granted under Regulation (EC) No. 469/2009 or Regulation (EC) No. 1610/96 pursuant to Art. 3(h) UPCA.

8 The abbreviation EPC stands in accordance with Art. 2 (d) UPCA for the Convention on the Grant of European Patents of 5 October 1973 with all subsequent amendments. It is also used in this way in the following.

9 See e.g. Benkard, European Patent Convention, 4th edition, Art. 3, para. 8.

10 See also Guidelines for Examination in the European Patent Office A-III, 12.1.

11 See Art. 2(e) UPCA.

12 Cf. Art. 2 (2), 3 EPC.

13 See Art. 64(1) EPC.

14 Montenegro (ME) became the 39th Contracting State to the EPC on 1 October 2022 (OJ EPO 2022 A78).

The facts that not all Contracting States of the EPC have acceded to and ratified the UPCA¹⁵ and that the UPCA will not be accessible to a number of these states in the near future immediately raise questions regarding the international jurisdiction¹⁶ of the UPC; among other questions, whether and, if so, to what extent the UPC can also settle disputes concerning, for example, the British or Turkish part of a European patent?

At first sight, one would probably expect the UPC not to have jurisdiction over the latter due to the principle of territoriality, even though it is formally supposed to have jurisdiction over disputes concerning the whole bundle. However, as we shall see, the UPC's "arm" extends beyond the territory of the UPCA's contracting member states, at least in certain cases.

An answer to the above questions can be found in Art. 31 UPCA. The article states that the international jurisdiction of the UPC "shall be established in accordance with Regulation (EU) No 1215/2012 or, where applicable, on the basis of the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Lugano Convention)". As the UPC is a court common to the Contracting Member States of the UPCA and is therefore subject to "the same obligations under Union law as any national court of the Contracting Member States",¹⁷ Art. 31 UPCA merely reflects the applicable law of the EU. Accordingly, the jurisdiction of the UPC – as with any national court of the Member States of the EU – is determined on the basis of Regulation (EU) No. 1215/2012, Brussels Ia for short, also referred to as the Brussels I Regulation, and the Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters of 30 October 2007,¹⁸ the 2007 Lugano Convention for short. However, the UPC's property-based subsidiary international jurisdiction cannot be found in either Brussels Ia or the 2007 Lugano Convention. It can be found in the so-called Brussels Ib Regulation, which is analysed in more detail below.

The Brussels Ib Regulation – an overview:

As a court common to the Contracting Member States of the UPCA, the UPC is not subject to the articles of the Brussels Ia Regulation. The Brussels Ia Regulation was therefore amended accordingly by Regulation (EU) No 542/2014 of the European Parliament and of the Council of 15 May 2014¹⁹ in order to embed common courts, such as the

UPC in particular, in the EU court system.^{20, 21} The amendment to the Brussels Ia Regulation has been in force since 10 January 2015.²² The amended Brussels Ia Regulation is hereinafter also referred to as the Brussels Ib Regulation or Brussels Ib for short.

Brussels Ib comprises four new articles, Art. 71a - 71d Brussels Ib. Art. 71a Brussels Ib first defines what is meant by a common court. Art. 71c Brussels Ib concerns pendency and related proceedings. Art. 71d Brussels Ib concerns the recognition and enforcement of judgements of a common court. Art. 71b Brussels Ib governs the jurisdiction of a common court and thus also the UPC's property-based subsidiary international jurisdiction. Art. 71b Brussels Ib reads:

"The jurisdiction of a common court shall be determined as follows:

- (1) a common court shall have jurisdiction where, under this Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument;*
- (2) where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, Chapter II shall apply as appropriate regardless of the defendant's domicile.*

Application may be made to a common court for provisional, including protective, measures even if the courts of a third State have jurisdiction as to the substance of the matter;

- (3) where a common court has jurisdiction over a defendant under point 2 in a dispute relating to an infringement of a European patent giving rise to damage within the Union, that court may also exercise jurisdiction in relation to damage arising outside the Union from such an infringement.***

Such jurisdiction may only be established if property belonging to the defendant is located in any Member State party to the instrument establishing the common court and the dispute has a sufficient connection with any such Member State."

The first and second points of Art. 71b Brussels Ib embed common courts, such as the UPC in particular, in the system of national courts of the Member States of the EU. The second point should be emphasised in this respect. It regulates

¹⁵ More precisely, have deposited a corresponding instrument, cf. Art. 84, 89 UPCA.

¹⁶ territorial jurisdiction in the sense of the English term jurisdiction (cf. the English version of Art. 31 UPCA), to be distinguished from the subject-matter jurisdiction of a court in the sense of the English term competence (cf. the English version of Art. 32 UPCA).

¹⁷ See Art. 1 s. 2 UPCA.

¹⁸ Official Journal of the European Union, L 147 of 10 June 2009, p. 5.

¹⁹ Official Journal of the European Union, L 163, 29.5.2014, p.1.

²⁰ This also integrated the Benelux Court of Justice into the EU court system.

²¹ Point (4), Preamble to Regulation (EU) No 542/2014.

²² See Art. 2 of Regulation (EU) No 542/2014.

the jurisdiction of the UPC over defendants who are not domiciled in a Member State of the EU and in cases where jurisdiction over them cannot be established otherwise under Brussels Ib, in short: over defendants from non-EU states, i.e. so-called third states.²³ While national courts can fall back on national provisions in these cases via Art. 6 Brussels Ia, a common court cannot do so due to the lack of an “own” national law. Rather, it can be called upon in these cases on the basis of Art. 71b no. 2 in conjunction with Chapter II Brussels Ib. From the perspective of a potential plaintiff, this can certainly be seen as progress in dealing with defendants from third countries and is also in line with the principles of the Brussels Ia Regulation, according to which the jurisdiction rules should be “highly predictable”.²⁴

Art. 71b no. 3 Brussels Ib introduces the property-based subsidiary international jurisdiction. This means that for patent infringements that have led to damage within the EU and for which the UPC has jurisdiction under Art. 71b No. 2 Brussels Ib, subsidiary jurisdiction of the UPC can be established for damages outside the EU from such infringements.²⁵ The factual elements to be fulfilled in Art. 71b No. 3 Brussels Ib are:

1. The defendant is not domiciled in a Member State of the EU and the UPC's jurisdiction over the defendant cannot be established otherwise under Brussels Ib.
2. A European patent has been infringed.
3. The infringement led to damage within the EU.
4. Such an infringement also led to damage outside the EU.
5. The defendant has property located in a Contracting Member State that is a party to the agreement establishing the common court.
6. The legal dispute has a sufficient connection to such a Contracting Member State.

Analysis, possible interpretations and discussion of the subsidiary jurisdiction – the “long arm” of the UPC

The possible interpretations of subsidiary jurisdiction and of the above-mentioned factual elements are wide-ranging. Among other things, it is argued that the new Art. 71b No. 3 Brussels Ib establishes a limited jurisdiction for the UPC for the infringement of a European patent in countries that are Contracting States of the EPC but not Member States of the EU,²⁶ or in the original:

“This is the result of the new art. 71(b)(3) of the Brussels I Regulation as amended by Regulation 542/2014 giving (limited) jurisdiction to this court for acts of infringement of a European patent committed in countries that are signatories to the European Patent Convention but not Member States of the EU [...]”²⁷

The subsidiary jurisdiction thus provides a legal basis for the UPC to decide on an infringement of a patent that is in force in a territory outside a Member State of the EU (and thus also outside a Contracting Member State of the UPCA) and at the same time within a Contracting State of the EPC.²⁸

On the other hand, there is a narrower interpretation according to which an act of infringement of a European patent has taken place in an EU Member State, whereby the infringement in the EU Member State has led to damage within the EU Member State and/or another EU Member State and additionally to damage outside the EU.

The above-mentioned broader interpretation also assumes such an act of infringement in order to justify the damage within the EU, but requires a further act of infringement outside the EU to cause damage outside the EU.

Due to the different possible interpretations, the above-mentioned elements of property-based subsidiary jurisdiction pursuant to Art. 71b No. 3 Brussels Ib are analysed in more detail below. The focus will be on the last part of sentence 1 and sentence 2 of no. 3 of Art. 71b Brussels Ib, i.e., on the factual elements 4 to 6.

1st factual element (defendant from third country)

The reference of Art. 71b No. 3 p.1 Brussels Ib to Art. 71b No. 2 Brussels Ib refers in particular to a defendant from a third country,²⁹ i.e., to cases in which the defendant is not domiciled in a Member State of the EU and the Brussels Ia/Ib Regulation does not otherwise



Matthias Grob



Rainer Härtle

²³ See point (7), sentence 1 of the preamble to Regulation (EU) No 542/2014.

²⁴ See point (15), sentence 1 of the preamble to Regulation (EU) No 1215/2012.

²⁵ See point (7), sentence 1 of the preamble to Regulation (EU) No 542/2014.

²⁶ P. Véron, Extent of the Long-Arm Jurisdiction Conferred upon the Unified Patent Court by Art. 71(b)(3) of the Brussels I Regulation as Amended by Regulation 542/2014 of May 15, 2014: Turkish Delight and a bit of Swiss Chocolate for the Unified Patent Court, European Intellectual Property, Review, Vol. 37, Issue 9, 2015, p. 588, right column, penultimate paragraph.

²⁷ Ibid.

²⁸ P. Véron, Extent of the Long-Arm Jurisdiction Conferred upon the Unified Patent Court by Art. 71(b)(3) of the Brussels I Regulation as Amended by Regulation 542/2014 of May 15, 2014: Turkish Delight and a bit of Swiss Chocolate for the Unified Patent Court, European Intellectual Property, Review, Vol. 37, Issue 9, 2015, p. 593, line column, penultimate paragraph.

²⁹ See also, for example, the first paragraph of section III 4. in P. Mankowski, Die neuen Regeln über gemeinsame Gerichte in Art. 71a-71d Brüssel Ia-VO, GPR 2014, 330-342.

establish jurisdiction over him. This means that the UPC's jurisdiction under Art. 71b No. 3 Brussels Ib cannot be established for defendants domiciled in a Member State of the EU that is not a contracting state of the UPCA – such a defendant should be safe from the “long arm” of the UPC in this respect. This applies to Spain, Poland and Croatia as well as the Member States of the EU that have signed the UPCA but have not yet ratified it. These are Greece, Ireland, Romania, Slovakia, the Czech Republic, Hungary and Cyprus. These states thus create a gap between the scope of the UPCA and the “long arm” of the UPC.

2nd factual element (infringement of a “European patent”)

Furthermore, according to Art. 71b No. 3 S.1 Brussels Ib, there should be an infringement of a European patent. This might be clear reading the English versions of Brussels Ib and the UPCA. However, the term “European patent” appears conspicuous at least in the German version of Art. 71b No. 3 Brussels Ib. In contrast to the German wording of the UPCA, it is capitalized.³⁰ The capitalization could be an indication that the term “European patent” is not intended to be the same as a “European patent” within the meaning of the UPCA.³¹ Ultimately, however, the aim is to integrate the UPC into the EU court system. Since the UPC is competent for European patents with and without unitary effect, it would therefore make little sense to restrict its jurisdiction to European patents without unitary effect (see the discussion in the introduction). The term “European patent” should therefore cover European patents with and without unitary effect.

It is well known that the infringement of a European patent without unitary effect is determined in accordance with national law pursuant to Art. 64 EPC. This also applies to European patents with unitary effect. According to Art. 5 of Regulation (EU) No 1257/2012, a European patent with unitary effect “shall confer on its proprietor the right to prevent third parties from committing acts against which that patent provides protection within the territories of the participating Member States in which the patent has unitary effect, subject to any applicable limitations”.

The actions from which third parties can be prevented are determined in accordance with Art. 5(3) in conjunction with Art. 7 of Regulation (EU) No. 1257/2012 according to national law.

As all Contracting States of the EPC are also Member States of TRIPS,³² the protection defined by Articles 28 and 30 TRIPS should provide the minimum level for defining the rights arising from the national part of a European

patent or from a European patent with unitary effect. This protection is set out in Art. 25, 26 UPCA with the limitations set out in Art. 27 - 30 UPCA, which appear to be in line with Art. 30 TRIPS. This makes clear, at least in principle, which acts can be categorised as an infringement of a European patent within the meaning of Brussels Ib.

3rd factual element (damage within the EU)

Furthermore, according to Art. 71b No. 3 sentence 1, there must have been damage within the EU due to the infringement. The connecting factor here could be³³ Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights,³⁴ hereinafter referred to as the Enforcement Directive. In particular, Article 13(1) of the Enforcement Directive states:

“Member States shall ensure that the competent courts, at the request of the injured party, order the infringer who knew or ought reasonably to have known that he was committing an infringing act to pay the rightholder appropriate damages to compensate for the actual prejudice suffered by the rightholder as a result of the infringement.”

The damage should therefore be attributable to an infringement or one of the above-mentioned infringing acts.³⁵

4th factual element (damage outside the EU due to such an infringement)

The most questionable point in Art. 71b(3)(1) Brussels Ib is probably the criterion “damage arising outside the Union from such an infringement”. The interpretation of this factual element is likely to be decisive in determining how far the “long arm” of the UPCA actually reaches.

Since the first sentence of Art. 71b No. 3 Brussels Ib concerns an infringement of a European patent, the term “such an infringement” in the second sentence should refer to an or the infringement of the same European patent. Otherwise, infringement disputes concerning different European patents could be interwoven, which seems to go far beyond the intention of the legislator.

If we now decide on the “same” European patent, we can also ask about the damage. Does this mean damage in accordance with Art. 13 Enforcement Directive or is the “damage arising outside the Union” to be determined in accordance with the respective national law? At this point, however, a consistent interpretation of the term “damage” seems to be appropriate, as this should be interpreted as

³⁰ This discrepancy does not exist in the English version of the UPCA or the Brussels Ia.

³¹ So according to Art. 2 e) without uniform effect.

³² Agreement on Trade-Related Aspects of Intellectual Property Rights (Federal Law Gazette, Volume 1994, Part II, p. 1438, 1730).

³³ See inter alia point (13) of the preamble to Regulation (EU) No 1257/2012.

³⁴ Official Journal of the European Union L 157 of 30 April 2004.

³⁵ See also point (26) of the preamble to the Enforcement Directive.

a characteristic of an EU law standard in the light of the Enforcement Directive, irrespective of whether it is about a “damage within the Union” or about a “damage outside the Union”. Thus, the term “damage arising outside the Union” should be interpreted in the same way as the term “damage within the Union”.

As described above for the term “damage within the Union”, the damage should be attributable to an infringement or an infringing act, namely to “such an infringement”.

Since damage is therefore linked to an infringement, it can be assumed that if the damage occurred outside the EU, the infringement or the infringing act must also have taken place outside the EU. The European patent – as a right that is infringed in this context – must therefore also have had an effect outside the EU. This justifies the view that Art. 71b No. 3 Brussels Ib refers to an infringement in a Contracting State of the EPC that is not a Contracting Member State of the UPCA³⁶ (see Figure 2). This corresponds to a broader interpretation of the term “such an infringement” as “an infringement of the same European patent” in the sense of an infringement by a further infringing act outside the EU, whereby the infringing act outside the EU is, however, linked to the infringing act within the EU by the reference “such”.

In contrast, another position can be adopted by interpreting the criterion of “such an infringement” as “the infringement of the same European patent”. This interpretation is based solely on an infringement within the Contracting Member State of the UPCA, namely on precisely the infringement that also led to the “damage within the Union”. The infringing act should also have given rise to the damage outside the EU. With this narrower interpretation, the UPCA reaches a smaller territory with regard to the act of infringement than with the broader interpretation, but the UPC’s power of cognition concerning the damage could be independent of any effect of the European patent outside the Contracting Member States of the UPCA. In addition, damage outside the EU could also mean damage outside the Contracting States of the EPC (see Figure 3), e.g., in the USA.

Such a case constellation arises, for example, through the manufacture of a product or components that are later assembled into the product within the scope of a patent and the subsequent sale of the product and/or the subsequent assembly of the components in a patent-exempt foreign country. In this case, the infringement of the patent already results in damage within the scope of the patent,³⁷ but the relevant part of the

damage (e.g., in terms of lost profits or orders) can occur in the patent-exempt foreign country.

In the past, such damages were already considered to be part of the infringement of a patent and penalised accordingly.^{38,39} This generally speaks against the narrower interpretation, as Art. 71b No. 3 Brussels Ib would thus be superfluous or represent a duplication.⁴⁰ However, such duplications are not unusual in the context of the UPCA,⁴¹ so that this interpretation should not be rejected for this reason alone.

Both views also appear to be in line with the travaux préparatoires on Art. 71b (3) Brussels Ib,⁴² according to which “access to the Unified Patent Court [...] will be ensured in situations where the defendant is not domiciled in an EU Member State as access is ensured in situations where the defendant is domiciled in an EU Member State”. The travaux préparatoires even contain an example to illustrate this:

“For instance, with respect to the Unified Patent Court, the asset-based jurisdiction would ensure that the Court would have jurisdiction vis-à-vis a Turkish defendant infringing a European patent covering several Member States and Turkey.”

The example illustrates that a Turkish defendant who has infringed a European patent covering several Member States and Turkey should fall under the asset-based, i.e., property-based, subsidiary international jurisdiction. However, the example raises some questions: Why is the defendant Turkish in particular? Is he or she supposed to have a seat in a Contracting State of the EPC? Where has an infringing act of the European patent occurred?

In any case, the broader interpretation according to which jurisdiction of the UPC can be established for damages due to infringing acts in countries that are not Contracting Member States of the UPCA seems to be justifiable. However, let us first look at the remaining factual elements before drawing a conclusion.

5th factual element (property in a member state of the UPCA)

37 Deutscher Bundestag Drucksache 16/5048 vom 20.04.2007, Gesetzentwurf der Bundesregierung Entwurf eines Gesetzes zur Verbesserung der Durchsetzung von Rechten des geistigen Eigentums, page 37, right column.

38 See, for example, WesternGeco LLC v ION Geophysical Corp, 837 F. 3d 1358; BGH Schutzverkleidung, X ZR 95/18, is likely to apply in a similar way, see in particular paras 46 to 48.

39 See, for example, the second paragraph of section III 6. a) in P. Mankowski, Die neuen Regeln über gemeinsame Gerichte in Art. 71a-71d Brüssel Ia-VO, GPR 2014, 330-342.

40 See also, for example, the third paragraph of point 3.3 in P. A. de Miguel Asensio, The unified patent court agreement and the amendment to the Brussels I Regulation (recast), in Luci e ombre del nuovo Sistema UE di tutela brevettuale, ISBN 978-88-348-4793-0, pp. 153-170, 2014.

41 See, for example, the duplications resulting from Art. 20, 24 (1) a) and 31 1st alternative UPCA.

42 Procedure 2013/0268/COD, COM (2013) 554: Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL amending Regulation (EC) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.

36 P. Véron, Extent of the Long-Arm Jurisdiction Conferred upon the Unified Patent Court by Art.71(b)(3) of the Brussels I Regulation as Amended by Regulation 542/2014 of May 15, 2014: Turkish Delight and a bit of Swiss Chocolate for the Unified Patent Court, European Intellectual Property, Review, Vol. 37, Issue 9, 2015.

The defendant must also own property that is located in a Contracting Member State of the UPCA. The property may be, for example, real estate.⁴³ The existence of a connection between the property and the infringement of the European patent is not specified in detail, except that the value of the property should be in proportion to the damage caused in order to enable enforcement,⁴⁴ and furthermore it should not be capable of establishing the jurisdiction of the UPC under Brussels Ia in any other way (which would be the case, for example, in the case of patent infringing products).⁴⁵ It therefore seems clear that the property is not only intended to establish the jurisdiction of the UPC, but also to ensure the enforceability of a corresponding decision.

6th factual element (reference to a contracting member state of the UPCA)

The legal dispute should have a sufficient connection to "any such Member State". This could now be interpreted similarly to the term "such an infringement", i.e., the litigation must have a connection to the same UPCA Contracting Member State in which the defendant's property is located.⁴⁶ However, "such" is preceded here by "any" so that a reference to any contracting member state of the UPCA seems to be sufficient.

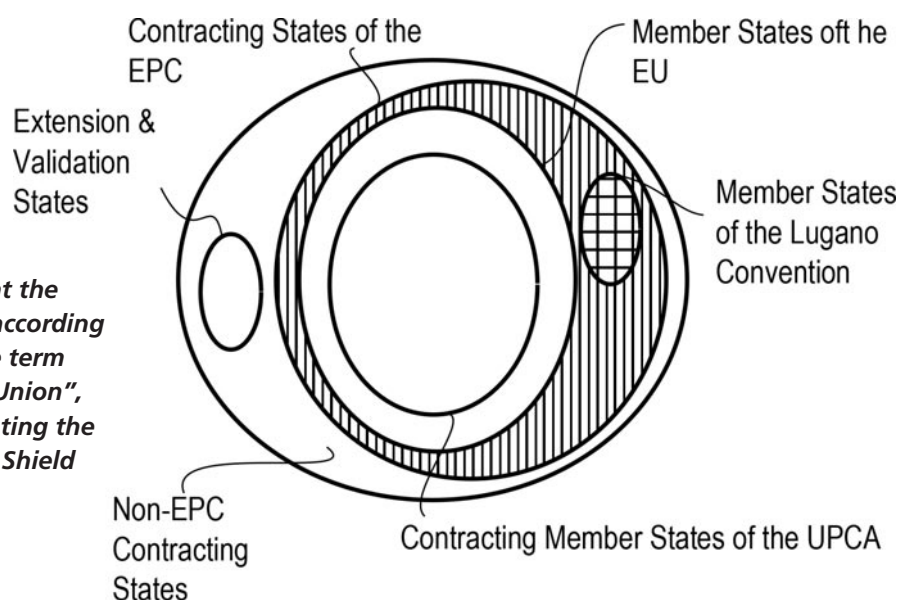
Moreover, examples of such a connection are given in point (7) of the preamble to Regulation (EU) 542/2014. If evidence of the infringing acts is located in a Contracting Member State of the UPCA, a link within the meaning of sentence 2 of no. 3 of Art. 71b Brussels Ib would be estab-

lished. The domicile of the defendant is also mentioned, but will only play a role in cases in which the obvious contradiction to the first factual element can be resolved.

Discussion:

The UPC's property-based subsidiary international jurisdiction relates to cross-border disputes concerning damages within and outside the EU resulting from the infringement of a European patent. With regard to proceedings outside the EU, the UPC's jurisdiction is limited to damages and/or damages related to the infringing acts. Art. 71b no. 3 Brussels Ib should therefore not provide a basis for the UPC to determine whether an infringement has occurred in a third country per se. Rather, such an infringement must be linked to an infringement in a member state of the UPCA. This applies in particular to acts of infringement in a third country that are directly attributable to acts of infringement in a Contracting Member State of the UPCA. Examples of this are the production of infringing products/components in a Contracting Member State of the UPCA and the delivery of the products/assembly of the components to a third state. Another example would be the uploading of an infringing offer to a server that can be accessed both in a Contracting Member State of the UPCA and in a third country. Other examples are conceivable. However, acts of infringement in a third country that only peripherally affect the territory of the UPCA or require an examination of the infringement under the national law of the third country are likely to form the limits of the UPC's property-based subsidiary international jurisdiction.

Figure 2: The shaded areas represent the territorial scope of the "long arm" according to the broader interpretation of the term "such an infringement outside the Union", with the different shading representing the restrictions imposed by the Lugano Shield (see last section).



43 Cf. example 5a described in para. 69 of the EPO publication "The jurisdiction of European courts in patent disputes" 2022 (available at epo.org/brussels-scenarios, accessed on 13 June 2023).

44 See point (7), sentence 3 of the preamble to Regulation (EU) No 542/2014.

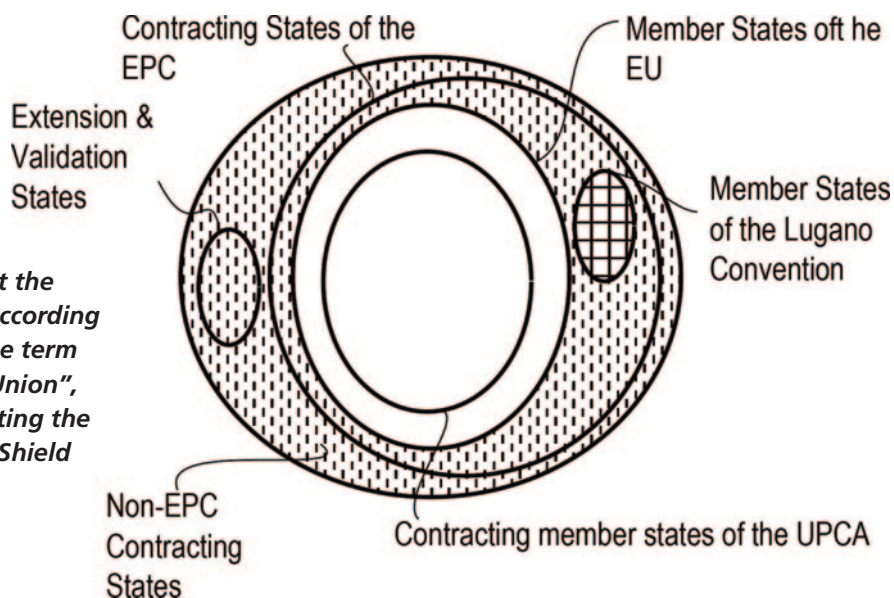
45 See, for example, the penultimate paragraph of point 3.3 in P. A. de Miguel Asensio, The unified patent court agreement and the amendment to the Brussels I Regulation (recast), in *Luci e ombre del nuovo Sistema UE di tutela brevettuale*, ISBN 978-88-348-4793-0, pp. 153-170, 2014.

46 See, for example, the last paragraph of section III 6. b) in P. Mankowski, Die neuen Regeln über gemeinsame Gerichte in Artt. 71a-71d Brüssel Ia-VO, GPR 2014, 330-342.

The territorial scope of the “long arm” varies depending on the interpretation of the term “such an infringement outside the Union”. While according to the above-mentioned broader interpretation, damages can be collected in Contracting States of the EPC that are not EU member

states (see Figure 2), according to the above-mentioned narrower interpretation, it also appears to be possible to claim damages outside the Contracting States of the EPC (see Figure 3). This is briefly illustrated by Figs. 2 and 3.

Figure 3: The shaded areas represent the territorial scope of the “long arm” according to the narrower interpretation of the term “such an infringement outside the Union”, with the different shading representing the restrictions imposed by the Lugano Shield (see last section).



Lugano shield:

For the sake of completeness, a further element should be mentioned in this context. In order to strengthen legal and economic cooperation between the EU and certain Member States of the European Free Trade Association,⁴⁷ the Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters,⁴⁸ hereinafter referred to as the 2007 Lugano Convention, was concluded between the EU and three of the four member states of the European Free Trade Association.⁴⁹ The three member states of the European Free Trade Association are Iceland, Norway and Switzerland. Liechtenstein is not a Contracting Member State to the 2007 Lugano Convention.

Art. 73 of the Brussels I Regulation explicitly states that “[this] Regulation shall not affect the application of the 2007 Lugano Convention”. Similarly, the 2007 Lugano Convention also stipulates that the application of the Brussels I Regulation remains unaffected.⁵⁰ This is immediately followed by a restriction:⁵¹

“However, this Convention shall in any event be applied

(a) in matters of jurisdiction, where the defendant is domiciled in the territory of a State where this Convention but

not an instrument referred to in paragraph 1 of this Article applies, or where Articles 22 or 23 of this Convention confer jurisdiction on the courts of such a State; [...]”

In a Contracting State of the EPC and the 2007 Lugano Convention which is not a Member State of the EU, the Brussels I Regulation or Brussels Ib as its successor shall not apply. Unless there is already exclusive jurisdiction of a court of a state bound by the Lugano Convention pursuant to Article 22 of the 2007 Lugano Convention or a choice of court agreement pursuant to Article 23 of the 2007 Lugano Convention, the 2007 Lugano Convention applies and not the Brussels Ib Regulation. This means that defendants domiciled in one of the three member states mentioned above cannot be reached in the Member State of the European Free Trade Association through the long arm of the UPCA, at least unless the 2007 Lugano Convention is amended in the same way as the Brussels I Regulation. However, this appears to be unlikely at least at the moment.

We would like to thank Dr. Olga Bezzubova and Dr. Malte Köllner for very good discussions on the topic and many constructive suggestions for this article.

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Note from the Editorial Committee: This article has already been published in the German journal “Mitteilungen der deutschen Patentanwälte” (Carl Heymanns Verlag)

⁴⁷ Preamble to the 2007 Lugano Convention.

⁴⁸ Official Journal of the European Union L 147 of 10 June 2009, p. 5.

⁴⁹ Iceland, Liechtenstein, Norway and Switzerland are member states of the European Free Trade Association.

⁵⁰ Article 64 (1) of the 2007 Lugano Convention.

⁵¹ Article 64 (2) of the 2007 Lugano Convention.

UPC Opt-Outs – A Cautionary Tale

Dr. T. Turner (UK), Partner | Abel + Imray

You didn't file an opt-out, but are you sure that no opt out has been filed? As we have found out, unauthorised UPC opt-outs do exist, and – whether filed intentionally or by accident – they are a headache for rights' holders. In this article, we recount our hands-on experience of unauthorised UPC opt-outs, and what you need to do about them.

Introduction

The Unified Patent Court (UPC) has introduced a new forum for enforcement of European Patents across 17 European Union states. As well as offering patent owners a centralised, one-stop-shop for patent infringement actions, it provides third parties with the possibility of seeking revocation of a European patent across those same 17 states simultaneously. When the new court opened on 1 June 2023, all existing European patents in force in those states automatically fell within the jurisdiction of the UPC unless their owner(s) had filed a formal 'opt-out' request with the UPC Registry during the preceding three-month 'sunrise period' that ended on 31 May 2023.

A valid opt-out allows a patent owner to prevent the UPC having jurisdiction in the event that a third party attempts to start a revocation action at the UPC. If a third party files a revocation action against an opted-out European patent, the patent owner has only one month to file a preliminary objection against the UPC's competence to take jurisdiction and show that the European patent has been opted out (per Rule 19 of the Rules of Procedure of the Unified Patent Court). If the patent owner does not respond in time, the UPC will assume jurisdiction. Furthermore, we understand that it may at that point be too late to correct or re-file a deficient opt-out, again resulting in the revocation action being able to proceed before the UPC.

As far as we are aware, the UPC Registry does not conduct any substantive or clerical checks on opt-out submissions. That is perhaps not surprising given that over 500,000 European patents were opted out during the sunrise period. As soon as an opt out request has been filed, the publicly-available overview on the UPC Registry website will indicate the opt-out status of the relevant European patent (here: Opt-Out | Unified Patent Court¹). The lack of checking may have resulted in some opt-out filings being formally deficient and/or ineffective. It opens the possibility of 'unauthorised' opt-outs being filed, intentionally or in error.

The large number of opt-outs recorded in the sunrise period was facilitated in part by an API provided by the UPC Registry, which European patent owners and IP service providers could use to file 'bulk' opt-out submissions for large numbers of European patents simultaneously. Service providers who were not UPC Representatives were able to file opt-out requests provided that they obtained an appropriate 'mandate' form authorising them to act on behalf of the patent owner(s). Throughout the sunrise period, the UPC provided a test portal alongside the live API portal, allowing API users to check their systems before filing formal opt-out requests. The API avoided the need to manually key-in details of individual European patents through the UPC Case Management System (CMS).

A spurious opt-out

In August 2023, we were made aware of a puzzling UPC opt-out that appeared to have some link to Abel + Imray. A company having no connection to our firm found that one of their European patents (which they had not yet intended to opt-out) was shown as having been opted-out on 1 March 2023. While opt-out documents are not automatically made available to the public, it is possible to check a few additional details via the CMS, and in this case it appeared that European patent in question had been opted out by one "Juan Abel & Imray" via an 'API'. Concerned at this finding, the company contacted us to ask if we could shed some light on the situation.

It was immediately clear to us that this opt-out request was not filed by anyone in our firm, despite our name appearing on the documents. In an effort to better understand the situation, we contacted the UPC Registry service desk and also filed a formal request for access to the UPC opt-out documents (as provided for under Rule 37 of the Rules governing the Registry of the Unified Patent Court). The UPC Registrar granted access to the opt-out form relating to the European patent, on which we found a somewhat confusing array of details for the opt-out requester and the patent owner, almost all of which appeared to be entirely false. The UPC Registry service desk also provided us with a list of 12 other European patents opted out by the same user. Once we obtained access to the opt-out forms for those other European patents, we found the same apparently false details on each form. In a particularly bizarre twist, around half of the opt-out submissions were accompanied by a document purporting to be a mandate, which document was in fact a set of slides from a language

¹ <https://www.unified-patent-court.org/en/registry/opt-out>

school presentation. If nothing else, that document clearly underlines the absence of any verification of the documents filed with an opt-out request.

Remedial action

Despite the obvious formal and substantive deficiencies in these opt-outs, each European patent remains recorded on the UPC Register as opted-out. As far as we are aware, this can only be rectified by a UPC representative acting on behalf of the patent owner(s). We believe, and the UPC Registry has confirmed, that each owner would need to formally request removal of an unauthorised opt-out under Rule 5A of the Rules of Procedure of the Unified Patent Court. Once the unauthorised opt-out is removed, it will be possible for the patent owner(s) to file a genuine opt-out request on each case, if they wish. We have contacted the EPO representatives of each patent in the list provided to us by the UPC Registry to make them aware of the situation.

In the documents we were given access to, we identified the details of the service provider that we understand was responsible for these filings. They have indicated that the filings appear to have been made in error, although we have as yet received no explanation as to how our firm's name appeared in the documents.

While we do believe that these opt-outs were filed in error, and not as a malicious act, it remains the case that investigating and resolving this matter has been and continues to be time-consuming and somewhat complicated, both for us and for the owners of the affected European patents.

Practice points

This unfortunate incident (which *fortunately* affected 'only' 13 European patents, as far as we are aware) serves to highlight a number of practice points, for patent owners and professional representatives, and also for third parties.

Firstly, there really is no checking of opt-out documents by the UPC Registry. If you entrusted opt-out filings to a third party, be sure to obtain copies of the documents and check that the opt-out requests are correct and

complete. In the case of a European patent, an opt-out request must be filed on behalf of all owners and indicate the owner(s) for each state in which the patent was granted. That should be the true owner(s), which may or may not match the owner(s) as recorded on national registers.

Secondly, if you have deliberately not opted-out certain European patents in your portfolio, you may wish to check that no opt-out has been recorded. If you do become aware that an unauthorised opt-out has been filed on one of your patents or applications and you wish to have it removed, you should make a request for removal of an unauthorised opt-out under Rule 5A of the Rules of Procedure of the Unified Patent Court. In particular, you should not request that the opt-out is withdrawn under Rule 5, as while this may also lead to the opt-out being removed, it will then very likely not be possible to decide to opt-out the patent or application in the future, should you wish to do so.

Thirdly, a patent recorded as opted-out may not have been effectively opted out. While some basic details are available through the CMS immediately, copies of opt-out forms and mandates can be requested provided that the requester provides a reason for seeking access. An explanatory note accompanying amendments made to the Rules governing the Registry of the Unified Patent Court on 31 July 2023 explicitly indicate that suitable reasons include a third party wishing to verify the validity of the opt-out of a patent before challenging it.



Dr Tom Turner

Finally, we take this opportunity to provide a reminder that an opt-out allows patent owners to object to the UPC assuming jurisdiction if a third party files a UPC revocation action. If the patent owner(s) fail to lodge a preliminary objection to the revocation action within the short one-month window from the revocation action being served, or if the opt-out is found to be ineffective and cannot be corrected, we understand that the UPC will allow revocation proceedings to go ahead.



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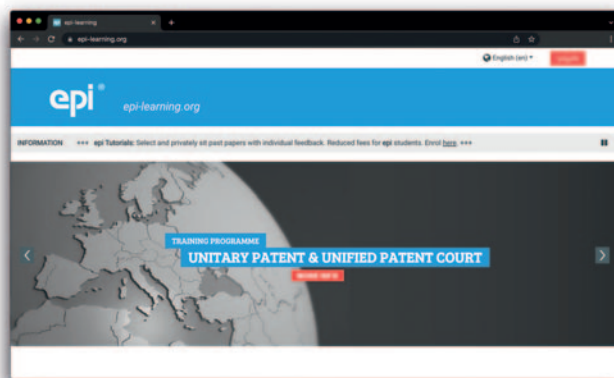
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³ <https://www.epi-learning.org>
⁴ <https://patentepi.org/r/info-2303-12>

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¹ <https://patentepi.org/r/student-membership-01>
² <https://patentepi.org/r/student-membership-02>

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Appeal seminar in Madrid

M. Nevant (FR) and C. Mulder (NL)

On 22 November 2023, the seminar “**A fresh look at procedural aspects of appeal proceedings**” was given in Madrid. It was presented by Michele Maremonti (member of the boards of appeal) and Cees Mulder (**epi** speaker). There were 25 participants in the conference room. The seminar was moderated by Isabel Pato (PEC member).



Marc Nevant



Cees Mulder

The cycle of opposition and appeal seminars started 10 years ago when Marcus Müller (currently, Chair of board of appeal 3.3.02) contacted **epi** with the idea of an opposition and appeal seminar and then Paolo Rambelli (at that time Chair of PEC) suggested Cees Mulder as speaker on behalf of **epi**. And this is how Marcus Müller and Cees Mulder gave their first “Opposition and Appeal” seminar on 3 December 2013 in Milano. Before the lunch break, the speakers would deal with opposition and the afternoon was devoted to appeal proceedings.

Since then, around four seminars per year were given at various cities all over Europe. During the Covid-19 period, there was a limited number of online/hybrid seminars.



From statistical data collected by the Education department of the **epi** Secretariat, the 31 seminars in 10 years attracted around 2,500 participants of which were around 2,200 European patent attorneys (= more than 15% of all **epi** members).

In the beginning, the speaker on behalf of the boards of appeal was Marcus Müller. In recent years, his colleague Michele Maremonti was the alternate speaker on behalf of the boards.

In 2020, the new Rules of Procedure of the Boards of Appeal (RPBA) entered into force, and since then the focus of the seminars shifted to the procedural aspects of appeal proceedings with emphasis on new case law developed under the 2020 RPBA. Since then, opposition is only dealt with to the extent that this is necessary for and relevant to appeal proceedings.

Based in the success of the seminars, Edward Elgar invited Marcus Müller and Cees Mulder to write a book. The first edition of the book “*Proceedings before the European Patent Office – A Practical Guide to Success in Opposition and Appeal*” issued in February 2015 at the occasion of the opposition and appeal seminar at CIPA in London. A second edition of the book was published in 2020 with an outlook on the 2020 RPBA. Currently, the authors are planning a book focussing on appeal proceedings only.

The seminar in Madrid was the last one with Cees Mulder as **epi** speaker. From 2024, his role will be taken over by Erik Nijs (NL).

At the beginning of the seminar in Madrid, **epi** President Peter Thomson joined by video link expressing his gratitude to Cees Mulder for his long-term contribution to continuous professional education in **epi**.



Tutors' Report on the EQE 2023 Papers

and the Meeting between Tutors and EQE Committees

N. Cordes (NL), L. Ferreira (PT), A. Valborg Guðmundsdóttir (IS), A. Hards (DE),
H. Marsman (NL), Z. Pintz (HU), S. van Rijnsouw (NL), and R. van Woudenberg (NL)

Each year in autumn, the EPO 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 again held by videoconference, in the mornings of 18 and 19 October 2023. On the first day, General matters, the Pre-Exam and Papers A and D were discussed; on the second day, Papers B and C followed by Discussion, summary and closing.

On the first day, about 50-55 people participated of which about 35-40 tutors; on the second day, a few people less. The low attendance may be due to the online videoconference format, which is less attractive and less interactive than an onsite meeting, also due to the lack of social, informal moments. As expressed during the meeting by several tutors via video or the chat, an in-person or hybrid format is preferred and is essential to have the tutor meeting meet its goals. We all wish and look forward to having the 2024 Tutor Meeting again in person at the EPO in Munich or The Hague!

Some questions for the Committees were submitted via the EQE secretariat to the exam committees and the Examination Board by email prior to the meeting, unfortunately



only by one or two tutors per exam paper. Unfortunately, these questions were not distributed to all participants, so that not all participants were aware about the questions asked and the arguments presented therewith. During the meeting, additional questions were asked by voice, video or chat. Most questions were addressed by the Examination Board and the Committees in the General part of the meeting or 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 2023;
2. The Online EQE 2023;
3. General remarks from the Tutor Meeting;
4. Paper A;
5. Paper B;
6. Paper C;
7. Paper D;
8. Pre-Exam; and
9. Concluding remarks.

On behalf of the tutors present in the meeting, I would like to thank all the members of the Examination Board and Committees as well as the EQE 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 my co-authors -in alphabetical order- Nico Cordes, Luis Ferreira, Anna Valborg Guðmundsdóttir, Andrew Hards, Harrie Marsman, Zsófia Pintz and Sander van Rijnsouw for finding time to prepare the individual paper summaries.

We all wish you good luck in 2024,
Roel van Woudenberg (editor)

1) Pass rates EQE 2023

The official results for each paper of EQE 2023, as published on the EQE website and dated 18 July 2023 (as last year, one day after the candidates received their Results letters in MyEQE) for EQE2023, are shown in the table below:

Online EQE 2023*	#Candidates	PASS**	COMP.FAIL	FAIL***
Pre-Exam (4 x 70min)	519	84,78%	--	15,22%
A (4 hours)	873	70,56%	4,35%	25,09%
B (3½ hours)	829	61,52%	9,17%	29,31%
C (2 x 3 hours)	1176****	54,08%	12,08%	33,84%
D (27+28+45 marks; 1h45 + 1h40 + 2h45)	836	38,28%	10,29%	51,43%

*The Pre-Exam, A, B, C, and D papers are designed as papers of 4h, 3½h, 3h, 5h and 5h respectively [Rule 22-27 IPREE]. Since 2017, all candidates are granted an additional thirty minutes per paper to these durations [Decision of the Supervisory Board of 17 November 2016]. In the Online EQEs of 2021-2023, the Pre-Exam and C and D papers were split into multiple parts. Each part had to be completed before the start of the next break, with the next part only becoming available after the break. As a result, candidates were no longer free to allocate their time as they see fit across the different parts of the Pre-Exam and the C and D papers. To compensate for this restriction, the total duration of the Pre-Exam, C and D papers was extended to the lengths shown in this column. For paper D, the number of marks, number of questions and duration of each part varies from year to year [Notice Examination Board 13.03.2019]; this was the first D paper with a D2 part of only 45 marks (2022: 55; 2010: 50; 2010-2020: 60).

** note: These pass rates as published do not include the results of any appeals. It is not known whether/how many appeals have been successful in interlocutory revision by the Examination Board or before the Disciplinary Board of Appeal or are still pending before the latter.

*** The FAIL rate includes no-shows.

**** The difference between the number of candidates sitting paper C compared to the numbers sitting A, B or C can be largely explained by the differences in pass rates in the previous two years: paper C had considerable lower pass rates than the other papers (usual for A and B; D was relatively high in 2021-2022 due to neutralizations of 25 resp 5 marks), so that there are considerably more resitters for paper C than for the other main exam papers this year.

In 2023, 519 candidates sat the Pre-Exam, which is somewhat less than in 2022 (680) and 2021 (626) and significantly less than in 2019 (920) and 2018 (935). This low number is probably caused by a relatively low number of resitters due to the very high pass rate in 2022 (97%; due to neutralization of part 3 of 25 marks and Q.20 of 5 marks) as well as due to a lower hiring of new patent attorney trainees during the COVID-19 pandemic. Of these 519 candidates, 440 (85%) passed the Pre-Exam. This pass-rate is comparable to that of the earlier papers which also contained two, concise cases/parts in the claims part (2021: 87% from 626 candidates; 2019: 88% from 920 candidates), and is somewhat higher than the typical pass rate for the 2015-2018 papers (74-76%; each 800-935 candidates) which each had a single and much longer claims part with much more reading.

690 out of 1630 candidates that took at least one paper passed the EQE (compared to 885 out of 1918 in 2022 and 1093 out of 2780 in 2021). When comparing the results for the individual main exam papers with earlier years:

- The pass rate for Paper A was in the usual (wide) range (2022: 60%, 2021: 74%; 2019: 79%;
- The pass rate for paper B was back to the usual range (2017: 67%, 2018 73%, 2019 53%, 2021 55%) after it having been quite high in 2022 (78%).

- The pass rate for paper C was similar as in the years before (2022: 49%, 2021: 47%; 2019: 50%);
- The pass rate of paper D was back in the usual range from before Covid (D 2019: 49%; 2018: 33%; 2017: 39%; 2016: 42%), after having been artificially high in 2021 and 2022 due to significant neutralizations (2021: complete D1-1 of 25 marks; 2022: one D1 question of 5 marks) .

2) The Online EQE 2023

In their "Information on the schedule for the EQE 2023 examination papers" communication of 27 September 2022, updated on 19 December 2022¹, it was indicated how the exam papers and the schedule would be adapted for the online EQE 2023. The document provided that:

"The **EQE 2023** will take place online using the same setup as the EQE of 2021 and 2022 [comment from the editor: so, using the secure WISEflow/LockDown Browser]" .

"The pre-examination and both papers C and D will be split into parts. This means that candidates will not be free to allocate their time as they see fit across the different parts of the papers. To compensate for this restriction, the total duration of the relevant papers has been extended. Once the time allowed for a part has elapsed, it will not be possible to go back to that part."

"The **pre-examination** will have the same syllabus and character as before, but it will be split into four parts. Each part must be completed before the start of the next break, with the next only becoming available after the break. The pre-examination lasts four hours and forty minutes. Candidates will be allowed to print the description of the invention as well as the prior-art documents for the claim analysis parts before the start of the appropriate part. The documents allowed for printing will be made available during the break preceding the relevant claim analysis part."

"**Paper D** will have the same syllabus and character as before, but it will be split into three parts. Each part must be completed before the start of the next break, with the next part only becoming available after the break. Paper D lasts six hours. No calendars will be provided."

"**Paper A** will have the same syllabus and character as before [note from the editor: Paper A was not split in parts]. Paper A lasts four hours. Candidates will be allowed to print the prior-art documents and the drawings of the application, but not the letter of the applicant."

¹ Information on the schedule for the EQE 2023 examination papers, 19 December 2022

"Paper B will have the same syllabus and character as before [note from the editor: Paper B was not split in parts]. Paper B lasts 3.5 hours. Candidates will be allowed to print the prior-art documents and the drawing(s), but none of the following: the description and claims of the application, the EPO communication, the client's letter and the amended claims."

"Paper C will have the same syllabus and character as before, but it will be split into two parts. The first part is to be completed before the break, with the second part only becoming available after the break. It will not be possible to go back to the first part after the break. Paper C lasts six hours.

Candidates will be allowed to print everything except the claims of the patent in suit/opposed."

The communication also included the start and end times of each (part of the) paper, and information about possible unscheduled breaks. The latter were only allowed for paper A, B, C part 1, C part 2, and D2, but not for the shorter parts (the four Pre-Exam parts and the two D1 parts).

For A, B and C, the communication also indicated that "The documents allowed for printing will be made available approximately ten minutes before the start of the examination". Printing was only available before entering the respective exam flow, but not anymore after entering the flow in the secure environment.

Compared to the 2021 and 2022 exams, the most significant changes in the schedule were the different lengths of the D1.1, D1.2 and D2 parts for paper D.

The EQE website also provided further documents such as the REE/IPREE (OJ EPO 2019, Suppl 2) "Announcement of the European qualifying examination 2023, OJ EPO 2022, A12", the "Code of conduct for candidates during the EQE taking place online (e-EQE)" and "Instructions for answering the pre-examination paper and marking scheme" (Notice from the Examination Board dd 11 February 2021).

WISEflow

EQE 2023 was again conducted online using the locked browser in the examination platform WISEflow. WISEflow provides a secure online exam platform, allowing candidates to take the exam from any suitable location (without any other person in the room and without any other electronic equipment in the room/within reach apart from the computer and screen used for the exam), i.e., typically from home or the office. There were no examination centers. A computer with a network connection was required, and only a single screen could be used of a size and resolution at the candidate's choice.

For the Pre-Exam 2023, WISEflow presents each question on the left half of the screen in a language selected from the three EPO language, as it did for Pre-Exam 2022. On the right half of the screen, 4 statements are presented in all three languages with a True/False answer option to each trilingual statement (clickable bullets). In the claims analysis parts, the prior art documents are provided as pdf documents via a hyperlink; these document could be printed before entering the exam flow and viewed online during the exam flow.

For the main exam papers, WISEflow provides a secure environment (FLOWlock) with the paper in pdf format and a proprietary editor with basic formatting functions (headers and ToC navigation pane; underline, bold, italics and strikethrough; enumerated lists, bullet lists). The editor allows a basic copy/paste from any text part of the examination paper into the editor, and within the editor. A basic form of annotation/ highlighting was available in the pdfs of the main exam papers; annotation/highlighting was also possible in the answer in the editor and in the Pre-Exam onscreen questions. We further refer to our report in **epi** Information 4/2022 on EQE 2022 and Wiseflow and its features.

As in the previous exams, candidates could bring any paper documentation, and make notes on paper. These notes could however not be handed in.

During the exam, the legal texts on the EPO website were also available in WISEflow via a hyperlink "Legal texts", including the EPC, GL/EPO, GL/PCT-EPO, OJ EPO, National Law tables and the Euro-PCT Guide; as well as to some of the PCT legal texts on the WIPO website, in particular to the eGuide version of the PCT Applicant's Guide. Candidates are recommended to check the situation in WISEflow during the Mocks exams as to which legal texts are available online and in which format. Wiseflow gave access to the version of the legal texts as in force in the date of the exam itself, rather than that on 31 October of the year before the exam as specified in Rules 2 and 22(1) IPREE as the relevant version; however, this had no effect on the answers and, as before, candidates are recommended to indicate which version they are using.

Mock exams/ Compendium

The EQE secretariat made part of the Compendium available in Wiseflow. These included all main exam 2022 and 2021 papers, A 2019, B 2019, C 2014, D 2016 and Pre-Exam 2019, 2021 and 2022 as well as mock main exam papers made by **epi** (the same mock papers as for e-EQE 2021). All enrolled candidates as well as any registered tutor had access to the Wiseflow Compendium.

The actual Online EQE 2023

The online exam took place from 7 – 16 March 2023 (Main Exam) and on 17 March 2023 (Pre-Exam). Compared to earlier years, the main exam papers were in the same sequences as before (D, A, B, C) with always at least one day in between two successive main exam papers.

3) General remarks from the Tutor Meeting

Opening words

The meeting itself opened with words of welcome and introduction by Jacob Kofoed (Chair of the Examination Board). The meeting aims to get a good understanding of EQE 2023 so that tutors can help candidates passing the exam next years. The committees will go through papers and questions as submitted in advance and as asked during the meeting. Jakob expressed his thanks to the committees and members of the Examination Board to make time available for this meeting.

Jakob briefly described the history of the EQE. The EQE was, for long, a paper exam in exam halls. The EQE 2020 had to be cancelled due to the pandemic that had just broken out. The EQE organization had to find a solution to allow EQE 2021 to proceed and managed to arrange the EQE 2021 as an online exam - with many more sitters than usual. Jakob indicated that that first online exam did have some technical issues, but that it went relatively well. In 2022, the exam again had the normal number of sitters and there were still some technical issues, but much less. In 2023, the exam had again more or less the normal number of sitters, i.e., about 1000 per main exam paper. Jakob presented the number of sitters per paper and the pass rates; we refer to the table above. Jakob indicated that the pass rates for Pre-Exam, A, B and C were usual, but that D was less successfully passed compared to these other papers (and, when compared to the D 2022 and 2021, but see comments to the table above and the discussion of the D paper below).

Complaints

Jakob discussed the filing and handling of complaints. If candidates want to file a complaint about the conduct of the exam, they could do so when the exam was in exam halls immediately after the exam - at that time, hardly any complaints were filed. Now, with the online exam, complaints must be filed in electronic form using the dedicated form on the EQE website, on day of the exam. Very many were filed in 2021, when candidates using the new technology ran into hiccups and about 1500 complaints were filed; these were so many that they could only be answered in more general form. In 2022 less complaints were filed than in 2021, partially

because less candidates than in 2021. Now, in 2023, 239 complaints were filed (Pre-Exam: 39; A: 26; B: 20; C: 45; D: 109), most relating to technical issues. All complaints go to the Examination Board. For EQE 2023, the Examination Board looked into each individual complaints in detail, and responded individually; this process ran relatively smoothly. It is believed that with more 2000 candidates these numbers of complaints are acceptable.

Misconduct

Jakob further addressed misconduct. When the exams were in exam centers, candidates had to travel to Munich, Copenhagen, Paris, ..., take hotels and bring all their material to the exam center. There were tight controls around registration and around unscheduled breaks, preventing any possible misconduct. Now people take the online exam at home or elsewhere alone, with a camera showing the candidate from frontal view. The code of conduct regulations, published on the EQE website, comprise details rules on, e.g., showing ID at beginning, no head sets or ear plugs, no cell phones near, not leaving scheme unauthorized, ... However, the invigilators and Examination Board have seen some deterioration about respecting the rules, e.g., people wearing headsets and some even refused to take them off/ ignored instruction to take them off. The latter is not acceptable, and the Examination Board had to take them more serious in 2023, also in view as not in pandemic crisis anymore. In EQE 2023, 36 (Pre-Exam: 17; main exam: 19) cases with a breach of rules were detected. All 36 candidates were contacted, giving facts and asking for explanation. Not all replied or convincingly explained their behaviour and some disciplinary action had to be taken, in particular deduction of points, sometimes leading from PASS into COMP FAIL or FAIL. In 2024, the Examination Board will be more strict on the rules for conduct.

Appeals

Jakob informed us that 27 appeals were received on EQE 2023. This is a relatively low number, as is usually 40-50 (and in 2021, with almost double number of sitters and first online EQE: 150). Possibly the number is relatively low now due to the way the complaints were handled. For about half of the appeals, interlocutory revision was granted by the Examination Board in view of obvious mistakes during marking. The other half, where the Examination Board did not consider (main) request allowable, went to Disciplinary Board of Appeal (and, as far as is known, have not yet been decided by the date on which this report was finalized in November).

Jakob concludes that the electronic exam now runs smoothly and will also be used for the future.

Outlook to 2024 [comments made spread out over the meeting by various people; information from EQE website]

The “Information on the schedule for the EQE 2024 examination papers” dated 27 July 2023 is already available on the EQE website. EQE 2024 candidates already received WISEflow access to the Compendium in September 2023.

The **Unitary Patent** and the Unified Patent Court have entered into force on 1 June 2023. The core EU regulations have been published in the OJ EPO in 2013^{2,3}. The FAQ on the EQE website provides the particular relevance of the UPR in OJ EPO 2022, A41: **“To which extent the syllabus of the EQE covers the Unitary Patent and transitional measures thereto?”** The syllabus of the EQE includes all updates and publications as defined in Rule 22 IPREE as at the syllabus cut-off date (31 October of the year preceding the examination). This includes inter alia, OJ EPO 2022, A41, which sets out the “Implementing Regulations on Unitary Patent Protection” before the EPO.”

The notification provisions of the EPC, **Rule 126(2)/127(2) EPC**, are amended per 01.11.2023, abolishing the 10-day legal fiction of notification and introducing a compensation for late receipt similar as in PCT. The amended rules are thus already in force for more than four months when sitting the EQE 2024 papers. However, the current IPREE specify that the version force on 31.10.2023, just one day before being amended. In view of this, the Supervisory Board decided⁴ to take the amended version as default for EQE 2024, while allowing also the earlier version:

“1. Candidates sitting the EQE 2024 (pre-examination and main examination) can use as legal basis Rules 126, 127 and 131 EPC as in force on 31 October 2023 or Rules 126, 127 and 131 EPC as in force on 1 November 2023.

2. In the main exam papers, the default Rules 126, 127 and 131 EPC to be applied are those in force on 1 November 2023. If the candidate chooses to apply Rules 126, 127 and 131 EPC as in force on 31 October 2023, this must be clearly indicated.

3. Candidate papers will be marked accordingly.”

2 Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (also in OJ EPO 2013, 111) -- which creates a “European patent with unitary effect” (“Unitary Patent”); Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (also in OJ EPO 2013, 132). See <https://www.epo.org/en/legal/up-upc>

3 Also see the (informal) Unitary Patent Guide published by the EPO (<https://new.epo.org/en/legal/guide-up>)

4 Decision of the Supervisory Board of the EQE dd 26 June 2023, EQE website (link “EQE 2024: Notification and time limit calculation”)

New EQE

The EQE 2024 will still be according to the current format. Dates for EQE 2024 and EQE 2025 have been announced on the EQE website^{5,6}.

The New EQE was not discussed during the Tutor meeting. It is expected that more information will become available in Q1 2024.

Why so few questions from tutors this year?

A tutor commented that the number of questions submitted in advance and the number of questions asked and comments made from the participants was quite low, and hence the degree of interaction quite limited. He indicated that he believes that to be largely due to the online format of the meeting. When the meeting was still in-person, there was a lot of “formal” interaction in the sessions between tutors and committee and Board members, as well as a lot of “informal” discussion during the breaks and other social moments around the meeting. He expressed a strong wish to again organize the meeting in in-person, or hybrid, format. Other tutors expressed their support for this request.

4) Paper A by Andrew Hards and Anna Valborg Guðmundsdóttir

In 2023, Paper A was again held electronically within the traditional 4 hrs without being split into parts. Just before the examination, candidates were allowed to print the prior-art documents and the drawings of the application, but not the Client’s letter.

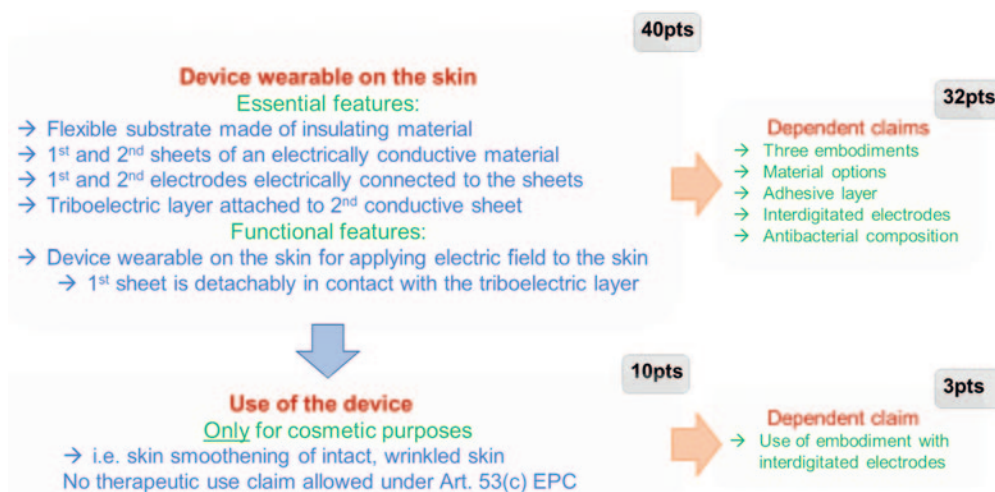
Paper A was about a device for treating skin problems, such as healing wounds, wherein the device is worn on the skin. The invention related to the generation of an electric field by a triboelectric effect, which is driven by movements of the body.

D1 described an electric plaster for accelerating the healing of a wound by applying an electric field to the wounded skin, however, using a battery as power source. D2 disclosed a sensor of muscular activity, which works based on the triboelectric effect, to generate electricity by body movement but not for applying it to the skin.

5 See <https://www.epo.org/en/learning/professional-hub/european-qualifying-examination-eqe> --> Dates for the EQE 2024 dated 20 September 2022, and Dates for the EQE 2025 dated 20 July 2023

6 It seems to be envisaged that the New EQE will be introduced in a staged way, and that there will still be current A, B, C and D papers in (at least) 2025. Please monitor OJ EPO and the EQE website for information about the New EQE and its introduction and transitional measures, as well as to whether the so-called Foundation paper of the New EQE will already be introduced in 2025 and, if so, whether the (currently announced) Pre-Exam 2025 will still take place.

The invention lies in substituting the wound healing device battery with a triboelectric power source such as known from D2.



The main device claim had to be formulated with functional features and could provide up to 40 marks. The cosmetic use claim may have compensated the chemical candidates in this mechanically orientated exam somewhat but that only garnered 10 marks.

A particular challenge was to cover all embodiments by one independent claim and to avoid unnecessary limitations, in particular in view of the type of wearable device, e.g. plaster or bandage, and the materials of the devices.

The challenge for the use or method claim was to limit the claim to a cosmetic use so as to avoid the restriction of Art. 53(c) EPC and thus excluded any therapeutic use. It was necessary to explicitly exclude the therapeutic healing of wounds, i.e. a formulation of the type “wherein the device is worn on intact wrinkled skin” or the like had to be included to receive full marks. The use claim should also make reference to the device claims.

For the drafting of dependent claims, up to 35 marks were obtainable. These dependent claims should cover the different embodiments shown in Figs. 2 to 4 and the different material options, in particular those which have been disclosed in the client’s letter as being advantageous. Further dependent claims were expected to be directed to interdigitated electrodes and the presence of an antibacterial composition. The examination committee also expected a dependent use claim, which was directed to the combination advantage of the use of an interdigitated shape of the electrodes (Fig. 5) on intact skin.

For the introductory part of the description, including the citation of prior art, an indication of the problem to be solved, and an explanation of how the invention solves the technical problem, a maximum of 15 marks could be

obtained. Up to 5 marks were received for the proper citation of the prior art and the explanation of the relevant features. The formulation of the technical problem could

be awarded with up to 4 marks, but only when D1 was used as a starting point. A problem formulated over D2 was less pertinent and thus gained only 2 marks. Another 6 marks were available for a discussion of the solution to the problem provided by the invention, however, the solution had to be consistent with the independent claim.

Overall, the examination committee considered the paper to be balanced

and cover broad aspects. However, the examination committee was also worried that the topic of paper A was slightly too mechanical, so that chemical candidates might have had a disadvantage in solving the paper. The paper focussed on formulating appropriate functional features, but this is in any case a valuable skill regardless of the technological background of the candidates. The pass rate of the paper was at about 70 %, which is relatively high, but in line with the recent Paper A pass rates, which have ranged between 60 and 80 %.

5) Paper B by Luis Ferrera & Harrie Marsman

For Paper B, Wim van der Poel (EPO, Coordinator Examination Committee I and member of the Examination Board) informed the attendees that he was the main author for Paper B this year. He thanked not only co-drafters Liz Elmhirst and Sami Aromaa (both **epi**), but also made clear that there was a considerable number of persons involved in finalizing an examination paper.

Wim informed that the paper had a pass rate of 61.52%, complemented by a compensable fail rate of 9.17%. Wim noted that the Committee views with a positive light a pass rate around 62%. In addition and triggered by a question, Wim emphasized that it is always a goal to draft a paper with a mixture of mechanical and chemical aspects, which should be accessible to candidates both with a mechanical or a chemical background.

Paper B 2023 was inspired on an acquaintance of Wim which is suffering from diabetes and has to regularly check blood glucose levels. This check requires a droplet of blood and a clear improvement would be to strive to requiring smaller blood droplets.

While reading into the technology of the apparatus used, Wim saw good possibilities to have a paper dealing with selection inventions for sub-ranges, noting that the Guidelines changed recently on this subject. Instead of three requirements for having novelty for selection inventions, the Guidelines nowadays only require two requirements, viz. a narrow sub-range and the selected sub-range being sufficiently far removed from any specific examples in the prior art. The third requirement relating to the selection being purposive was removed from the Guidelines, because of developments in the case law.

On a question as to what was done with candidates who used the Case Law Book that is not yet in line with the amended Guidelines, it was noted that most, if not all, candidates worked with the Guidelines. And, this was good, because there was no real argument to be used to show a purposive selection.

Just like for the presentation on Paper A, the presentation on Paper B closely followed the Examiners' Report that, according to our humble opinion, was detailed and of good quality.

Wim gave an overview of the paper, shortly discussed the application as filed and the problems underlying it, the prior art, the official communication, and the client's instructions and claims.

There were two prior art documents, one of them being only a document citable under Art 54(3) EPC. This document, D2, should not be used in the inventive step discussion, and it was considered a serious mistake to do so. Some candidates that used D2 as secondary document lost marks. It was also mentioned that candidates that used D2 in inventive step were already seemingly struggling with the overall paper; the Art 54(3) citation was not seen, in itself, to have been a significant stumbling block for candidates. On average, the inventive step argumentation given by the candidates for this year's exam was quite good.

In the Communication, the Examiner indicated that D2 was novelty destroying for all five claims as filed. This point was apparently accepted by the vast majority of candidates and is in line with the usual practice that in the EQE paper B the Examiner's position is correct.

One of the tutors observed that an argument that D2, read in combination with D1, did not directly and unambiguously disclose the subject-matter of claims 2 and 4. From the Examiners' Report it is unclear how such an alternative solution would have been marked. Wim stated that such candidates would probably have received some marks, if arguing convincingly. However, such cases were not reported to him.

In respect of a question regarding computer implemented inventions (CII), it was confirmed that a basic knowledge is expected from all candidates, but not at the same level as practitioners in the field (for example, a complete paper based on CII would, in all likelihood, be too selective).

The presentation also included a mention to the two different effects provided by the two independent claims (smaller amount of blood can be used; more accurate measurement) and corresponding objective technical problem to be solved. As expected, the second inventive argument provided fewer marks than the first.

In the communication, it was also noted that there was an error in claim 3 or in paragraph [017]. The units ml and µl were used for indicating the same property. The candidates were expected to request for a correction citing Rule 139 EPC and using the document supplied by the client. This request for correction should preferably be supported by additional information, such as a reference to another document, in this case D1.

Also, an objection under Rule 43(2) EPC regarding claims 1 and 5, directed to a strip and a measuring device, respectively, as originally filed had to be dealt with. This could be easily dealt with while referring to the exception of the plug-and-socket type in Rule 43(2)(a) EPC by adding the corresponding feature of the array detector. Candidates who solved this Rule 43(2) EPC objection by introducing a claim directed to the use of the strip together with an array detector lost marks.

The applicant's letter raised the issue of wishing to also incorporate hydrophobic membranes in the device. This wish could not be met. There is simply no support to broaden from hydrophilic membranes and violating this resulted in a considerable loss of marks.

As was the case with the previous single Papers B, the points for the claims are coupled to the amendments of the set of claims as suggested by the client.

As indicated above, the Examiners' Report is quite detailed and should be read attentively. The paper was well appreciated by the participants to the EQE tutors meeting.

6) Paper C by Sander van Rijswou

Presentation at the annual meeting of EQE tutors and members of the EQE examination committee. The presentation was by Pelayo Fernandez Plaza but presented by Sophie Creux. Questions were answered by Sophie Creux, Paolo Provvisionato, and Celia Martinez Rico.

The presentation closely followed the Exam report for Paper C, with relevant excerpts from the report on the slides. These minutes focus on comments that seem to add to the Exam report.

Effective dates of the claims

The priority application was filed by two applicants, whereas the patent application was filed by only one of them. No transfer of priority right had taken place.

Following the EPO practice, reflected in the Guidelines of 2022 and 2023, A-III, 6.1, the priority is not validly claimed. Reference was made to the recent decision from the enlarged board of appeal about priority [G1/22, G2/22]. Nevertheless, candidates should apply the law as it was at the time.

List of Evidence

Annex 2 and Annex 5 required more discussion.

A2 itself was published after the filing date of A1. But it's evidence that a public prior use took place before the filing date. It should be noted that the internal structure of the pedal was also made available to the public through posters which were displayed.

A5 is a screenshot of a social media post. Following EPO practice, the date stamps of the post and the comments are considered to be reliable publication dates. Note that A5 has two dates.

Claim 1 - Lack of novelty (A5) and discussion on other attacks

Novelty A5

This was the only expected attack. It should be noted that road racing implies limitations; not all prior art pedals were suitable for road racing. The sensor was also an important point: a pedal angle sensor is enough, see A1[6].

Novelty A4

Prior to the meeting, a tutor submitted that he considered a novelty attack based on A4 also a valid attack. This attack was not expected, and considered incorrect because A4 does not provide information about where the dead spots are in the pedal stroke.

Although A1[6] mentions that there could be other methods for measuring dead spots, none are specified. A4 discloses strain gauges, which can be used to measure power. They are mentioned in A3, A5, and A7. However, they measure total power or power balance between left and right. But what is needed is a sensor that measures power in a stroke. A strain gauge is not enough; you need information that tells you where you are in the stroke like an angle detection. Gauge sensors, without any further indication, are not suitable for detecting the dead spots in the pedal stroke.

The time invested in a novelty attack based on A4 was not lost however, as the analysis of A4 is useful for attacking claim 2. There are thus few marks lost because of this. Missing the novelty attack based on A5 was penalized by the corresponding number of marks.

Inventive step using A7

In passing, a brief mention was made about a possible inventive step attack on Claim 1 using document A7. This attack was not expected but may have received points based on the merit of the attack. The other document(s) used in this attack were not mentioned. [Perhaps this may have been inventive step A4+A7, since A7 establishes a 'power profile along the stroke' thus overcoming the shortcoming of A4, SMR]

Claim 2 - Lack of inventive step (A4 + A2)

For the inventive step attack for claim 2, it is needed to change to A4 as the closest prior art. A5 is not the closest prior art because A5 has a very different structure, and so is not suitable to start from. Also, document A2 is not the closest prior art, because it discloses a stationary bicycle pedal.

Claim 3 - Lack of inventive step (A4 + A2 + A3)

A4 is still a good starting point, and it additionally has a bicycle computer. A2 is even further from claim three because there is no bicycle computer, only a PC workstation.

Claim 4 - Lack of novelty (A7)

A novelty attack based on A7 was the only expected attack. A7 is the only document disclosing a bicycle with a chain drive. The attack required an explanation of what a chain drive is.

Claim 5 - Lack of inventive step (A7 + A6)

A6 has preferred and non-preferred embodiments. An explanation was expected for why these specific ranges would be combined.

Claim 6 - Added subject-matter

There is added subject matter because ceramic ball bearings are isolated from its context in A1. To achieve a reduced friction and an increased life span when compared to standard steel bearing, the Zirconia ball bearings and ceramic races need to be combined. There is no information that ceramic ball bearing could be extracted.

Claim 7 - Lack of inventive step (A3)

Claim 7 comprises a mix of technical and non-technical features. It is expected that candidates apply the Comvik problem-solution approach of Guidelines G-vii, 5.4.

Note that in Paper C of 2022 there was also a mixed type invention, for which it was expected to apply the Comvik approach.

According to the Guidelines first one should state what the technical features are (a computer and displaying pedaling efficiency being at 80% or below), and what the non-technical features are (a heart or an angry icon).

The closest prior art is then selected with a focus on the features contributing to the technical character.

The bicycle computer of claim 7 needs to be suitable for the system of claim 4. This means only that the bicycle computer needs to be able to communicate with the sensor of that system.

A3 is considered to be the prior art because it discloses a bicycle computer, which is suitable for communicating with a sensor and which already displays efficiency information.

Although, A7 discloses a bicycle computer it is not the closest prior art because it lacks a display for pedaling efficiency.

For A3, the only distinguishing feature is that the display of whether the efficiency surpasses or is below 80% is a heart icon or an angry icon. This feature does not make a technical contribution because it depends on the user's preference.

Distribution of marks

Effective dates of the claims and prior art (10 marks)

Claim 1 (11 marks)

Claim 2 (18 marks)

Claim 3 (15 marks)

Claim 4 (9 marks)

Claim 5 (17 marks)

Claim 6 (6 marks)

Claim 7 (14 marks)

Questions from tutors

Question: Although the marks appear to be balanced between the two parts, the effort needed by the candidates was not balanced, as many candidates appeared to run out of time in Part 1, but they had sufficient time for Part 2. Do you have any comment on that?

A split paper allows some rest during this online exam. It would be demanding to sit the whole paper online. This comes with the drawback that candidates are not allowed to answer the first part of the paper, during the second part. If this is done, zero marks are awarded.

This year one of the annexes was only provided in part 2, because candidates have to spend more time in the first part. Nevertheless, reading material that is not useful is part of the challenge.

Question: What is the situation in paper C: do we also need novelty or inventive step attacks in paper C if a claim violates Art.123(2) EPC?

It depends on the paper. This year, there is a clear variation of Article 123(2), and therefore that is enough to kill the claim. It is not a rule that added subject matter is sufficient, though until now this has always been the case. In future there could be a paper in which the added subject matter situation is not so clear. One of the tutors remarked that some older papers did have auxiliary attacks on added subject matter claims.

Finally, a reminder was given that candidates should read the instructions to sit the exam and know how to behave during the examination. There have been incidents with people wearing headsets, having cell phones, and leaving unauthorized. Next year there will be consequences for not adhering to the rules.

7) Paper D by Roel van Woudenberg and Zsafia Pintz

The D committee was represented by Tiem Reijns (**epi**, chairman D, member Examination Board), Josef Schriefl (EPO, D1) and Simone Fausti (EPO, D2).

D1-part: summary of the paper

This year's D1 came in two parts: 1 first part of 1 h 35 min and 27 marks (D1.1) and a second part of 1 h 40 min minutes and 28 marks (D1.2), i.e., a total of 55 marks. The D1 had a well-balanced mixture of EPC and PCT questions, with common topics as well as some less-familiar topics. Candidates that were well-prepared, with a sound legal knowledge and familiar with their legal reference books and other material should have been able to score 50-60% or more out of the 45 marks within the time available.

Some topics were common topics that candidates could have expected, such as dealing with lack of unity and divisional applications. Some topics were not so familiar, e.g. the excuse procedure in PCT national phase.

The online access to the Guidelines GL/EPO and GL/PCT-EPO in html-form (only) was convenient and may have been of additional help.

The first D1 part, D1.1, consisted of three questions of 10, 10 and 7 marks, i.e. a total of 27 marks, for which 1 h 35 minutes were available, followed by a break.

In Q.1, two pending divisional applications had to be analysed for patentability, both of which were filed out of EP-A. EP-A disclosed two inventions, the first invention comprising two alternative solutions. EP-A was a recently refused application which was still pending until the expiry of the period for filing a notice of appeal, so a new divisional could still be filed of it for the second invention. Candidates were expected to discuss the removal of an optional feature in one of the divisional applications and that the omission of a feature that is indispensable for the function of the invention was not possible in the other divisional application.

Q.2 related to an international patent application, where the priority claim included a typographical error in one digit of the application number of US-B. The applicant received an invitation from the EPO as receiving Office to correct the priority, but this was overlooked and the invitation was not replied to. Candidates had to discuss whether it was still possible to rectify the priority claim in the international phase and calculate the last day to file a demand for international preliminary examination. Candidates were expected to rectify the priority claim under Rule 91.1 PCT, and to indicate the necessary steps for requesting the rectification.

The topic of Q.3 was a recently granted European patent, a revocation request filed for the same patent and a debit order for said revocation filed via fax. The question also mentioned that the renewal fees were not paid in Germany and that another company is concerned about infringing the patent, also in Germany. Candidates were expected to analyse the current status of the revocation proceedings and discuss why the company concerned about infringing the patent should file an opposition. It had to be realised that the purpose and effect of an actively filed opposition (ex tunc) is different than the lapse of the patent (ex nunc).

The second D1 part, D1.2, consisted of another three questions of 7, 11 and 10 marks, i.e., a total of 28 marks, for which 1 h 40 minutes were available.

Q.4 related to a recently revoked patent. A notice of appeal was already filed against the decision of the opposition division; however, the notice of appeal was erroneously filed in the name of a different company, i.e. the previous patent proprietor. Candidates had to describe the current status regarding the admissibility of the appeal and discuss how the situation may be improved. It was expected to conclude that according to the current situation, the appeal was likely to be rejected as inadmissible. However, there were at least two possible ways for a successful correction (G 1/12); either under Rule 139 EPC or Rule 101(2) EPC.

Q.5, the question for the most marks in D1 (11 marks), had a PCT related topic, in particular a missing abstract in

an international patent application. As the application was declared withdrawn, candidates were required to analyse the legal consequence of said withdrawal in the designated states if nothing is done; and then discuss if and how applicant could revive the application before the EPO. Candidates were expected to state that the application ceased to have the effect of a regular national application in each designated state and then indicate the steps of the excuse procedure to successfully revive the application before the EPO.

In Q.6, there was a pending opposition against a patent, which was granted with a single claim to product P. The patent described the product P, a method only resulting in product P, and the use of product P as a fertiliser to enhance plant growth. The opposition included a document under Article 54(3) EPC as a possible novelty destroying prior right, disclosing the same product P, wherein P is obtained by a different method, and the use of product P as a detergent. Candidates had to discuss how the patent should be amended to provide the maximum scope of protection; while, of course, also meeting the requirements of Art. 123 and 54 EPC. In the second part of the question, wherein the patent described product P for use as a medicament rather than describing the use of product P as a fertiliser, candidates were expected to realise that the use claim is excluded from patentability and had to be reformulated as a purpose-related product claim under Art. 54(4) EPC.

The full 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").

D2-part: summary of the paper

This year's D2 was a 45-mark for which 2 h 45 min was available, the shortest D2 exam so far.

The paper was of a quite common design, with quite some different subject-matter. A careful patentability assessment was needed, followed by a who-is-free-to-do-what analysis, and then an improvement question. As always, it was recommended that candidates follow the scheme for the questions in their response. In this case, to discuss the patent situation by subject matter, as asked in the exam. This way of structuring the answer intended to help candidates not to lose marks because of an incomplete analysis.

There were no strange legal topics, but the length of the paper was actually longer than in previous years and last year (in 2023: 1479 words in the exam in 2 h 45 min vs. in 2022: 1408 words in the exam in 3 h 20 min).

The subject of the paper was nappies with control unit, electrodes, warning means, substances; electrodes for detecting presence of urine, special electrodes G or P for measuring glucose or pH and electrodes made from metal, silver, copper, platinum, gold, or conductive plastic.

Candidates had to deal with a competitor with a recently granted patent with quite a wide scope, validity of priority, the consequences of the invalid priority, undisclosed disclaimer, and a presumed Art.54(3) that turned out to be a Art.54(2) prior art. Other legal issues were added matter, non-unity, non-claimed subject-matter, and a R.71(3) communication already being approved. The client was based in Sweden, but producing and selling in EP, the US and China. However, the client only had EP applications pending, so a PCT application had to be filed for the nappies comprising substance X, because the International application can provide protection in US and China.

According to the Examiners' Report, the candidates are expected to analyse the available prior art given in the paper, to discuss the effective date of claimed subject-matter, and to conclude on patentability and/or validity of the claim(s), even -as more often in D2- if it is stated in the exam paper that a search report only contains documents of category A, or that a communication for the intention to grant has been issued. Some candidates did not provide a complete analysis as outlined above and were not awarded full marks.

As in 2021 and 2022, the paper had to be taken fully from the screen in Wiseflow - nothing was printable. The pdf of the paper could be viewed side-by-side with the editor, without an annotation possibility; or in one or more separate tabs, with limited annotation possibility. No calendars were given with the exam paper, but candidates had to bring their own lists of Saturdays and Sundays and had to check EPO closure dates in the OJ.

General remarks (Tiem Reijns)

Paper D 2023 had a pass rate of 38,3% and 10,35% compensable fail. This is a relatively normal pass rate for paper D from before Covid (pass rates 33-53%, compensable fail 8-13%), after a few high years of artificially high pass rate due to significant neutralizations in 2021 (one complete part of 25 marks, due to technical issue at start of D1-1) and 2022 (one question, 5 marks, due to date error in English version).

The Committee was actually expecting a higher pass rate, as there were only few resitters due to the higher pass rates in 2021 and 2022 and also because candidates got used to the online platform, the paper was quite straightforward without any substantial surprises in the content

of the paper, most candidates answered all questions, and because the online materials helped candidates in finding the legal basis more easily [note from the editor: the latter may not be true for all candidates, as some may consider printed reference books to be more efficient and easy to use than online resources, especially when those books are annotated with personal comment].

In the 2023 paper however, the legal questions scored lower than expected. This is largely due to a continuing trend of citing less and less legal basis; apart from Articles and Rules, the committee sees little cited legal basis (case law, Guidelines and OJ EPO are generally ignored. The question about opposition and revocation (Q.3) included a debit order was scored disappointingly low; this was unexpected as debit order questions are normally quite well-scored.

The legal assessment (part 2) was considered straightforward and candidates scored according to expectation. Few candidates discussed non-EPC markets.

Pre-received questions relating to general aspects (Tiem Reijns)

Unscheduled breaks

A tutor noted that, currently, unscheduled breaks are not allowed in the D1 parts. However, the D1 parts have grown to be as long as 1h 40 minutes for 28 marks, and may even become as long as 2 hours if a 60-mark D1 would have a 33 mark and a 27 mark part. With D1's getting as long as 1 h 40 min in 2023 and even 1 h 45 in 2024, should one not also allow unscheduled breaks in such D1 parts? (What is the limit: 1h30, 1h45, 2h, 2h30, 3h?)

Answer: D1 can indeed be more than 40 marks, as floating between 40 and 60. As a limit for unscheduled breaks, a 2 hour cut-off was set. Thus, unscheduled breaks are given for A, B, C and D2, but only after 60 min and no longer than 3 min. As D1 will not be longer than 2 hours, D1 can do without.

The Examination Board was requested by the tutor to allow unscheduled breaks in paper parts of any length, also during Pre-Exam parts and D1 parts.

Tiem answered that for security reasons, unscheduled breaks are only given in accordance with the instructions to the candidate. exceptions may be made for e.g. medical reasons if requested in advance.

Length and number of D1 questions

A tutor observed that this year's D1 part has 6 questions of 10, 10, 7, 7, 11 and 10 marks, no short questions, and the average above 9 marks. The document "Information on the schedule for the EQE 2024 examination papers" shows a first 26-mark part of only two questions, such

that there will be a question of even at least 13, but possibly 14-16 marks or more. Before 2020, D1 papers used to have 5 or 6 questions for 40 marks, with the number of marks per question between 4 and 10, and mostly between 6 and 8, with the average around 7.

The tutor wondered whether having only a few (in D1 2024 even only 5) high-value questions may make failing D due to misunderstanding of a single legal principle more likely, and unwanted. He also wondered whether it was in line with the intent of Rule 26(2) IPREE which indicates that "It [Paper D] shall comprise questions relating to different areas of the candidates' legal knowledge" (emphasis added), from which a candidate can legitimately expect that he will be tested on a wide variety of topics and that none of the topics will have a very high weight.

He requested the Committee to comment on their choice to provide questions with such a high number of marks and such a high relative weight.

Tiem commented that the Committee has the impression that candidates do better on questions with more marks. Possible reasons: lower overall number of words and this more time to answer. D1 2024 will have a first 26-mark part of only two questions, such that there will be a question of at least 13, but possibly 14-16 marks or more.

Tiem sees no deviation from the past, as there have always been 5 or 6 questions. Thus, the number of questions is stable, but number of marks per questions varies.

The Committee does not wish to limit the length of an individual question to 10 marks, not the average in the (previously common) range of 7-8 marks, as was requested by the tutor.

Length D2 part and possible solution

The same tutor noted that, when comparing the answer to that of the last years, the D2 2023 paper as well as its Possible solution, are considerably longer than the 2021 and 2022 papers, even though only 45 marks were available, i.e., significantly less than in 2021 and 2022, and also considerable longer than the papers before 2020.

The absolute lengths (in number of words) are given below, as well as the length scaled to 60 marks in brackets:

- D2 2023, 45 (60) marks, 2 h 45, paper: 1479 (1972) words; possible solution: 1395 (1860) words
- D2 2022, 55 (60) marks, 3 h 20, paper: 1408 (1536) words; possible solution: 1251 (1365) words
- D2 2021, 50 (60) marks, 3 h 00, paper: 1289 (1547) words; possible solution: 1186 (1423) words
- D2 2019, 60 marks, 3 h 00, paper: 1183 (1183) words; possible solution: 1438 (1438) words
- D2 2017, 60 marks, 3 h 00, paper: 1335 words; possible solution: 1303 words
- D2 2013, 60 marks, 3 h 00, paper: 435 words; possible solution: 1244 words

Also when not counting the number of words, but the number of arguments or sentences in the Possible Solution, this paper and its answer was by far the longest. The tutor considered that it may be assumed that this length is one of the factors causing a low pass rate for D 2023.

The tutor asked what the reason is that this paper was so long and required such a long answer, and how the D Committee decides and validates whether the length of the paper is adequate for the time (and marks) available?

Tiem commented that, indeed, the number of words appears to go up, but the committee does not consider it a worrying trend: 1) the number of words in paper D varies from year to year; 2) the possible solution is drafted to help candidates prepare, not because the answers style as such is required; using full wording is giving more clarity to the possible solution; 3) there was quite some repetition to precisely define the subject-matter ("*...nappies comprising acoustic warning means, a control unit and electrodes made of metal for detecting the presence of urine*"); repeating this multiple times is already many words -- considering the repetition, the effective length is the same as in the past; in the digital format, allowing copy-paste, these extra words are only added to the reading, not the writing (note from the editor: the paper also provided for abbreviations, so that writing could also be limited by using the abbreviations only).

Further, the main difference with previous years is the number of words in the detailed questions 1-3 of the D2 part. These detailed questions are provided to help candidates by giving guidance and they provide repeated subject-matter definitions. E.g., D2 2023 used 255 words for Q.1-3, whereas D2 2017 (metal beams) used only 71 for Q.1-3. Tiem showed a graph to illustrate that, when excluding the word count for the explicit questions from the total number of words, the net effect is small.

As to deciding on the length of the paper, Examination Committee III determined whether the part tests candidates on being "fit to practice" and does not steer on the number of words in the paper or the solution. However, the Committee aims to be concise, in D1 and D2.

D1 - Josef Schriefl (EPO)

Josef addressed the questions submitted prior to the meeting in detail.

Guidelines as legal basis

In view of the Examiner's Report's indication that "The examiners note that this issue has become more acute in recent years, with the 2023 answers **showing an all-time low in the citation of legal basis from e.g. the guidelines** and case law." (emphasis added), a tutor asked whether the Committee can give guidance when a Guidelines citation is necessary.

Josef answered that a reference to the Guidelines is expected if an element of the answer cannot be directly derived from the Article or Rule. Corresponding considerations apply to references to case law and other provisions comprised in the syllabus.

As an example, D1, question 1s, states: "*it is directly and unambiguously apparent that feature B is indispensable for the function of the first invention*". Art. 123(2) EPC: application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. G 1/05: (1) divisionals not complying with Art. 76(1) at their filing date may be amended later; (2) even if parent no longer pending; (3) same principle for examining Art. 123(2) and 76(1) EPC. Guidelines H-V, 3.1: removing a feature that is *indispensable* for the function if the invention contravenes Art. 123(2) EPC. Thus, the reference to the Guidelines is required as that provides the basis that removal of the *indispensable* feature leads to added matter.

Divisional in appeal period

A tutor commented that the Possible Solution does not explicitly include that the divisional may be filed in the appeal period "also if no appeal is ultimately filed", and asked whether the latter was necessary for full marks and whether there would be a loss of marks if a candidate suggested that an appeal was necessary for the pendency status.

Josef indicated that marks were also awarded to candidates that advised to file an appeal and file the divisional during the appeal proceedings, but that that option is less-preferred as it requires additional acts and fees - the only good reason would be to gain time, but there is no such hint in the question, nor is there a hint that the appeal could be successful. So, only those that filed the divisional without filing an appeal scored full marks.

D2 - Simone Fausti

Simone also commented on the length of the paper and the possible solution. His comments are incorporated in the General section above.

Level of detail when arguing novelty and inventive step

A tutor commented that in the argumentation of novelty, earlier Examiner's Reports usually required a thorough, complete analysis when assessing novelty: they required to explicitly indicate each prior art disclosure, then argue why the claim was novel by explicitly identifying the distinguishing feature(s) compared to each individual piece of prior art one-by-one, and then conclude. However, the D2 2023 model solution used arguments like "The claimed subject-matter is novel, because there is no disclosure of nappies comprising acoustic warning means in the prior art", i.e., without explicit indication of the prior art and without explicit indication of the distinguishing feature (but rather just citing the complete claim).

Simone disagreed. He argued that the possible solution of this year (and last year) does not deviate from general good practice. E.g., "*The claimed subject-matter is novel, because there is no disclosure of nappies with the special electrodes G configured to measure glucose in the prior art*" as given in the Possible Solution clearly mentions distinguishing feature vs an argument that would not give any identification such as "... because there is no disclosure of the claimed subject-matter in the prior art".

Where it relates to discussing individual prior art, the D2 allows to provide information and provide analysis in selective manner; this may be in aggregated manner if situation is appropriate. An extensive discussion gets same marks as the aggregate discussion in the possible solution. No bonus for unnecessary words. Level of detail in discussing novelty and inv step depends on the situation in paper D; not as in ABC, where the way to discuss it is tested.

Simone commented that marking is candidate-friendly: looking for proof that candidates relies on the relevant effect when arguing inventive step; wording used not relevant. In an inventive step discussion, a general reference to an unspecified improvement is not sufficient; for marks, specifying the improvement/ surprising effect is necessary, or an argument like "only known from remote field" in support of inventive step.

Art. 123(2) and inventive step grounds of opposition

A tutor commented that the Possible Solution correctly provides in Q.1-a that: "By claiming electrodes not made of silver, there is an undisclosed disclaimer in the granted claim of EP-Z, because silver was not mentioned in EP-Z. An undisclosed disclaimer can be allowed to restore novelty over an accidental disclosure and/or a

prior right. EP-Y is [...]. Hence, the undisclosed disclaimer is not allowable, as it represents added matter. Altogether, the claim of EP-Z is invalid.” and in Q.3 “Based on the analysis made in the answer of Q1, file a notice of opposition on the ground[s] of [...] added matter.”

However, the Possible solution also provides in Q-1-a that “The effective date is therefore the filing date of EP-Z.” and “The subject-matter of the amended claim is novel because none of the prior art documents discloses electrodes, which are made of metal other than silver. However, it does not involve an inventive step over the handbook, because the distinguishing feature is a well-known alternative for nappy electrodes to detect the presence of urine.” and in Q.3 “and in Q.3 “Based on the analysis made in the answer of Q1, file a notice of opposition on the ground[s] of inventive step [...]”. And, as to the latter, the comments to Q.3 indicated: “Fewer proposed the ground of inventive step.”

The tutor was surprised that it seems that the inventive step attack was needed, in addition to the 123(2) attack, for full marks, as a 123(2)-violating claim cannot be given an effective date (so would not be legally sound; even though in real life one would always add one...), and the 123(2) attack alone would be successful. He asked the committee to comment.

The tutor also indicated that he appreciated the inventive step option in case candidates had not recognized the (relatively complicated) 123(2) problem: the possibility for an inventive step would reduce the knock-on effect as it could still allow those candidates to conclude that the claim with the disclaimer was not valid (as not inventive in that case) and would still allow a successful opposition (albeit in the wrong ground). Reducing such knock-on effects is good and consistent practice in D2 papers since many years, and much appreciated.

Simone answered that “fit for practice” supports to also require raising inventive step as a ground besides 123(2), and he also referred to the statement of the tutor himself that he would always file that in real life. It is an additional ground and a fallback position. However, a candidate would hardly lose marks when not including inventive step as a ground of opposition; those marks are negligible compared to the total number of marks for EP-Z assessment and opposition. The main purpose was indeed to reduce the knock-on effect.

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

Examination Committee IV (Pre-Exam) was represented by Stefan Götsch (EPO), Volker Franz (EPO) and Joanna Moore (epi).

We will first give some general comments on the paper, then discuss the legal part of the paper, followed by the claims analysis part, and then discuss the session at the Tutor meeting.

General remarks

This was the third online EQE with the Pre-Exam being held in a similar way as in 2021 and 2022: the Pre-Exam was split into 4 parts and the questions had to be taken almost fully from the screen (only the description of the application and the prior art for each of the claims analysis parts were printable). Each part had to be completed before the start of the next break, with the next set of questions only becoming available after the break in between two successive parts. The split into parts means that candidates were not free to allocate their time as they see fit across the different parts of the paper. To compensate for this restriction, the total duration of the paper was extended: for every part, an extra 10 minutes was available so that each part lasted 70 minutes. Once the time allowed for a part had elapsed, it was not possible to go back to that part. The Pre-Exam 2024 will have a similar design.

As in 2022, the order of the four statements in each of the questions was randomized. In the legal as well as the claims analysis parts, i.e., it was different for different candidates. Also, the order of the questions was randomized in the legal parts (e.g., the sequence used below is the one shown in the Compendium), but not in the claims analysis parts.

All questions, statements, prior art documents and claim sets were provided in all three official EPO languages. As in Pre-Exam 2022, candidates could view the question body in a single language of choice in a first column on the left half of the WISEflow window, while the statements were presented in a second column on the right half of the window in all three languages without the possibility to select just one: this resulted in quite some scrolling, especially in the claims parts, where a single webpage showed four trilingual statements with True/False tick boxes.

The online Pre-Exams have the same syllabus and character as the earlier paper exams, and candidates are -as before- allowed to bring any printed reference material. During the exam candidates also had access to the EPO Legal Text pages, so including the full EPC Articles and Rules, Guidelines, GL/PCT-EPO, National Law Tables, Case Law, and the Euro-PCT Guide (HTML versions), and in this year also to some of the PCT Legal Texts, in particular the eGuide of the PCT Applicant's Guide (Introductions and Annexes) and the Article and Rules⁷. Access to the full pdf-versions

⁷ It was indicated that candidates need to monitor the Notices on the EQE website to check what is available online in Pre-Exam 2024.

of longer legal texts was generally not available. Access was to the live versions, so to the versions in force on the date of the Pre-Exam (so not the version of 31.10.2022 acc. Rules 2 and 22(1) IPREE) and answers based thereon were also accepted⁸.

Some questions and statements were extensively debated in comments on the blogs, both the legal part and especially the claims part. At earlier occasions, the Committee and Examination Board indicated that they consider the blogs and their comments when checking whether statements may need neutralization. However, In the legal part of this year's exam, no statements were neutralized.. In the claims part, one statement was neutralized; however, even though some candidates and tutors expected so, the "water-based" statements (see below) were not neutralized and the committee kept to their interpretation of "water-based solvent system" being "only water".

Legal part

The legal part of this year's Pre-Exam had similar style and a difficulty level as in 2022, 2021 and 2019, and a bit more difficult than those of 2016, 2017 and 2018. As in the last few years, the legal questions were a mix of questions addressing several topics that were to be expected (such as filing date requirements, languages) as well as several less standard topics (such as entitlement, transmittal under PCT Rule 19.4) which well-prepared candidates would have been able to find in their EPC/ PCT/ reference materials/ Guidelines, albeit with some effort. Surprisingly, representation and opposition were not tested (except for third party observations in opposition in 8.4).

Several questions were amended versions from earlier Pre-Exam questions, with names of parties, names of applications and dates adapted. Candidates that practiced the earlier Pre-Exams using the Compendium or Q&A books will have recognized so when working on the paper and will have benefitted from having used them in their preparation.

Well-prepared candidates having good knowledge of the EPC and PCT and knowing their material well (reference books, EPO Guidelines, PCT Applicants' Guide, Euro-PCT Guide, Q&A books, flowcharts, other course material) for fast look-up should have been able to answer most of the statements correctly and well within the time available, provided they had their material updated to the legal status of 31 October 2022 (the cut-off date for EQE 2023). The EPO Guidelines in particular play a key role to get to the right answers. Candidates with a poor preparation will have found those questions considerably more difficult than the questions from earlier years.

⁸ For the questions of Pre-Exam 2023, the differences between both versions of the Guidelines had no effect on the answers.

Q.1 was an adapted version of Q.1 of Pre-Exam 2019. Unlike the usual practice of "today" being the date of the exam (17 March 2023), the question indicated as "Today, 6 March 2023"; the origin of this deviant date seems to be that the Committee wanted to keep the Rule 134(1) extension of the priority period, which was an element of the original version (Pre-Exam 2019 was held on a Monday). Q.1 tested filing aspects, in particular filing date, language of filing and priority.

In Q.2, the effect of missing drawings and late-filing of those were tested. E.g., it tested whether a candidate was aware that not responding to an invitation to file missing parts of the description or missing drawings does not result in a deemed withdrawal but in then all references to the missing parts are deemed to be deleted (Rule 56(4) and Guidelines A-II, 5.1).

Q.3 was an adapted version of Q.5 of Pre-Exam 2019 and tested recording of changes under the PCT, who can validly file a first application at the EPO under EPC and at the EPO or OB under the PCT. The change of the question led to the complication that one of the applicants now lived in France (in 2019, Werner lived in Berlin), such that national security provisions apply to any application (whereas in Germany they only apply for applications containing state secrets - AG-IP Annex B); it is unclear whether the Committee was aware that some candidate may have been confused by this and did not know (as it is nowt documented in any of the documents of the exam syllabus for Pre-Exam 2023) whether violating national security provisions (requiring filing with the national office of France) results in an invalid filing or not (note: for the purposes of the EPC or PCT, it does not have an effect of the validity of the filing).

Q.4 described an entitlement situation and tested possible follow-up actions and their effect. Candidates may generally not be very familiar with entitlement issues from their daily practice, and may thus consider this a difficult question. However, the question could be fully answered using the Guidelines (2022) A-IV, 2 and sub-sections, so that a candidate that is well familiar with the EPC and his/her reference material can nevertheless answer this answer efficiently.

Several PCT aspects were tested in Q.5, such as (no) change of language of proceedings on entry (G 4/08; Guidelines E-IX, 2.1.3), and effects of withdrawal of a priority claim on effective date of claim 2 and on the entry time limit. In this question, one statement was neutralized, because it required a calendar for 2024 to know that 31 August 2024 was a Saturday so that the time limit for EP entry expired on Monday, 2 September 2024.

Q.6 was substantially the same as Q.2 of Pre-Exam 2014 and directed to divisionals: effect of matter extending beyond the parent application on its date of filing, prior art effect, pendency and renewal fees.

Q.7 was another PCT question, addressing fees and translations for international search, and addressing the effect of filing with the French office in English (received on behalf of IB as rO, transmittal to the IB, Rule 19.4). The later topic had a similar complication as Q.4, as R.19.4(b) which provides that the transmittal to the IB is done “unless prescriptions concerning national security prevent the international application from being so transmitted”, causing some candidates to doubt what the French office would actually do in this case, as may be caused by the condition in R.19.4 that “that Such transmittal may be subjected by the national Office to the payment of a fee, for its own benefit, equal to the transmittal fee charged by that Office under Rule 14”. However, the two statements relating to R.19.4 were not neutralized.

In Q.8, aspects of third party observations were tested. Most statements could be answered based on Guidelines (2022) E-VI, 3. Candidates that used the later version of the Guidelines may have had a slight advantage as section E-VI, 3 was significantly amended.

In Q.9, the applicant just received an invitation under Rule 70(2) and Rule 70a(2) EPC while the European search opinion stated that claim 1 lacks novelty. The question tested requirements for the reply to the invitation, time limit, requesting accelerated examination and claims fees. Q.10 related to the designation of inventors and their rectification, waiving the right to be mentioned and who can pay fees. Candidates may have overlooked that Rule 19 EPC was amended per 1 April 2021 so that the EPO no longer inform the inventors in a communication about their designation as inventor.

Claims analysis part

The claims analysis part had a similar style as in EQE 2021 and 2022, in that the claims analysis part was structured into two parts which were separately identified as part 3 and 4 (with parts 1 and 2 being the legal parts). As in the EQE 2021 and 2022, parts 3 and 4 each concerned a separate case with their own set of questions, rather than one case of 10 questions as in previous years:

- Part 3: Cleaning utensil (questions 11-15)
- Part 4: Erasable inks (questions 16-20)

Each of the parts 1-4 was given their own timeslot with each timeslot being divided by a break of 20 minutes (between parts 1 and 2, and between parts 3 and 4) and a larger break of 80 minutes between the legal parts and the claims analysis parts.

Part 3 concerns a cleaning cloth which combines relatively simple mechanical aspects (an arrangement of layers) with some chemical aspects, for example relative weights expressed as ranges and different types of materials, such

as sponge material, woven material and different types of polymers. Three different embodiments are described. Embodiment 1 is a basic embodiment, embodiment 2 adds a reinforcement layer, and embodiment 3 has fibres which form loops on the upper layer of the cleaning cloth. Each embodiment is accompanied by a figure showing its cross-section.

Part 3 contains only one prior art document, namely D1. The legal status of D1, being Art. 54(2) EPC, is explicitly indicated (i.e., it is not needed to determine the legal status using a comparison of dates), which is typical in the claims analysis part.

The claim set I which was initially presented included seven claims, namely one independent claim and six dependent claims. Several (sets of) other claims were introduced during later statements.

Substantive topics in part 3 included scope of protection, novelty, inventive step, and quite extensively, support for amendments. Of particular interest were:

- Q12, in which candidates had to assume that a claim set was filed after the description and drawings in response to a communication under Rule 58 EPC and had to determine whether individual claims met the requirements of Art. 123(2) EPC. This question demonstrated the peril of filing claims as amendments under Rule 58 EPC.
- Q14, which contained a statement about the formulation of the objective technical problem, however without indication of which document to consider as the closest prior art. The statement was not neutralized by the Examination Board. Fortunately, it appeared that candidates did not particularly struggle with this statement, perhaps given the fact that only one prior art document (D1) was available in this claims analysis part.

Part 4 dealt with the topic of erasable inks.

Notable aspects of part 4 included the following: the application was a PCT application of which the filing date was indicated to be 16.08.2019.

The prior art document D1 was an Advertisement in *The Local Sun*, published on the 15 August 2019 and D2 was Editorial paper published in *Pen Technology* on 1 March 1995. The prior art documents had no drawings.

The claim set which was filed with the description included eight claims, with two independent claims directed at an erasable ink composition and one independent claim directed at a pen. Several other claims were introduced during later statements.

Substantive topics in part 4 included clarity, support by the description, novelty, inventive step, and support for amendments. Of particular interest were:

- Q16, which contained statements on whether certain features were described as essential in the description. Here, statement 16.3 lacked a reference to a specific claim, by which both T and F could be argued. This statement was neutralized by the Examination Board.
- Q17, which contained statement 17.4 on the allowability of amendment of a claim in which several ranges are combined. These ranges were individually disclosed in the application as filed but arguments could be made (and were made in candidates in blog comments) that there is no disclosure of this specific combination. This statement was not neutralized by the Examination Board.
- Q19, which contained statements on whether certain features or effects were 'mentioned', 'disclosed' or 'taught' by prior art documents (and where it appears from the Examiner's Report that there were no differences intended between the phrasings 'mentioned' and 'disclosed' and that 'taught' also meant 'disclosed' but for a technical effect).
- Q20, which contained statements on whether, in an opposition procedure, certain attacks (novelty, Art. 83 EPC, Art. 123(2) EPC) would be successful (and where it appears from the Examiner's report that the fact that this took place during an opposition procedure did not appear to be of relevance on the substance of the statements).
- Statements 18.3 and 20.1, where the answer to each respective statement was dependent on whether one considered D2 to disclose specific ranges of "water" in view of D2's literal disclosure of ranges of a "water-based solvent system" (and without indication in the paper on how much water was present in this water-based solvent system). Despite this apparent discrepancy between the claim and the disclosure of D2, the statements were not neutralized. See also below for questions asked during the Tutor Meeting on this topic.

Comments and questions at the Tutor Meeting

Rather than showing a presentation with all Pre-Exam questions one-by-one, Stefan Götsch, Joanne Moore and Volker Franz went through the general questions that were submitted in writing prior to the meeting.

In a first set of questions, a tutor asked whether the Examination Board had checked the MC questions of Pre-Exam

2023, whether there had been guineapig testing, whether the Examination Board promotes re-use of earlier Pre-Exam questions and whether the latter are properly checked and updated (while the reference to the former 24 month time limit was kept when re-using the divisional question despite that 24 month clause having been abolished already in 2014). The tutor also asked whether also in future exams there will be a re-use of earlier questions.

The Committee answered that all questions are prepared by EC-IV (Pre-Exam committee), and all are checked and approved by the Examination Board. Also, there was guineapig testing with other Committee members from other Exam Committees.

Re-used questions are checked in same way as newly generated questions, including testing with guineapigs and review by the Examination Board. There are no instructions that would prevent re-use. EC-IV was aware that the 24 month provision abolished in 2014 but decided to keep the statement without amendment as it tests that candidates are aware that there were no further requirements than pendency. Future exams will again re-use questions, which may also be based on former legal provisions and which will be updated where necessary and appropriate.

The same tutor also noted that the Examiner's Report was initially published on the Compendium webpage (8 May), then corrected and expanded and a new version was uploaded on the Compendium webpage (10 July) replacing the initial version and without indicating that this was a new/correct version. The tutor asked whether the Examination Board had approved this, and requested that when a new Examiner's Report is published, as e.g. in 2018 for paper A, an indication "Rev. 1" is given and the original version is maintained.

The Committee indicated that they always include version number.

Joanne Moore commented to general questions submitted by two other tutors:

Q: Several questions were reused from earlier Pre-Exams, with some changes made to have them slightly different, which sometimes introduced some potential unclarities. Some examples are:

Q-a: E.g., Q.1 corresponded to Q.1 of Pre-Exam 2019, with the names of the persons and dates adapted. This resulted in the date indicated as "Today" (6 March 2023) to be different from the date of the exam (17 March 2023) – which was critical for being in time or not.

A-a: Committee wants to remind candidates that they should use the information in the question, and thus use 6/3/23 as today if the question says so. However, the

Committee has decided to avoid confusion with the today-date in the future.

Q-b: Q.3 corresponded to Q.5 of, again, Pre-Exam 2019, with the names, nationalities and residencies of the persons adapted. As a result, one of the applicant now lived in France, introducing a complication due to the national requirement of France to first file with the French office. Q.7 has a similar complication in relation to PCT Rule 19.4(a)(ii), where some candidates considered that the national provisions of France could/would prevent the INPI from transmitting the PCT application to the IB. This made some candidates considered that these provisions could/would prevent the valid filing of EP-S with the EPO, or PCT-S with the EPO or the IB. The original question did not have this complication. In this context, it is noted that the 2023 versions of the GL/EPO, GL/PCT-EPO, AG-IP and Euro-PCT Guide are all silent about the effect of national security restrictions in the situations of Q.3 and Q.7.

A-b: The Committee answered that nationalities and national restrictions did not make difference to the answer as EPO would anyhow accord the filing date. Unfortunately, the Committee did not address the issue as to how candidates could be aware of this.

Q-c: Q.6 corresponded to Q.2 of Pre-Exam 2014, with the dates adapted. As for the exam of 2024, the previous version of R.36(1) EPC was in force, the original exam tested that 24m clause. However, the current exam also had a statement reading "An EP divisional application cannot be validly filed after 24 months from the issuance of the first communication under Article 94(3) EPC in respect of EP-P and therefore EP-D was not validly filed as a divisional application."! It seems not appropriate to confuse candidates with provisions that was only in force until 01.04.2014 (even so long ago that there would not even be any candidates that have the rule still in their reference material): in view of the tutor, the statement could better have been amended to relate to the current law.

A-c: The statement is not incorrect and can be unambiguously answered; it is checking the conditions for filing a divisional.

Q: The Pre-Exam paper became available on the Compendium only in Wiseflow, and not as a pdf-file. It is kindly requested to make each paper (Pre-Exam, D, A, B, C) available as pdf on the EQE Compendium pages 1 hour after the end of each respective exam paper, so that they are available for all candidates as well as tutors.

A: The exam paper is only available in Wiseflow. But a pdf version of paper will be requested.

Q: Already on the day of the exam, candidates ask tutors and on the blogs when the results will be available. It is

requested that the Instructions to the candidates for Pre-Exam 2024 already indicate when the exam answers (Examiner's Report) as well as when the exam results (scores) can be expected. If possible by date, else by week.

A: The finalization and availability of the Examiner's Report depends on checks and controls take time. It is not possible to get the Examiner's Report available earlier.

Q: Randomizing the sequence of statements within a single question in the legal part and in the claims part does not provide an equal level playing field (whereas equal treatment is of key importance according to D 11/19), as some candidates got "easier" sequences than others. It is therefore requested to provide the same sequence of questions statements to all candidates, in the legal as well as in the claims parts, in order to provide an equal-levelled playing field.

A: For paper exams where all candidates received the same paper exam with the questions and statements in the same order for all candidates, the order of questions and statements was sometimes deliberate. The online exam is nowadays designed such that sequence does not matter, such that randomization can be done.

Q: As a result of the neutralization in Pre-Exam 2022 of complete part 3 (Q.11-15) as well as Q.20, i.e., for a total of 30 out of 100 marks, the pass rate for that Pre-Exam was as high as 97% (658 of 680 candidates passed; 22 did not pass. How many of these candidates re-sat the Pre-Exam in 2023? How many of these passed in 2023 / how many failed again?

A: The Committee has no information on this.

Stefan Götsch commented to questions on specific statements from these two other tutors:

Q: In Q.5, the time limit for entry into the European phase, after withdrawal of priority claim, had to be calculated: 31/1/22 + 31m [R.159(1) EPC] -> 31/8/2024 (Sat) [R.134(1) EPC] -> 2/9/24. Hence, a calendar of 2024 was needed to come to the correct answer. According to the Examiner's Report, "This statement has been neutralized, because the calendar for 2024 was not made available to the candidates". However, no calendars were made available at all, in line with the Notice from the Examination Board of 19 November 2021. It is also noted that the calendar for 2023 was only made available in the OJ 2022, A107, published 30.11.2022, i.e., after the legal cut-off date of 31.10.2022. So, also for any time limits expiring in the year of the exam, no closure dates are covered by the syllabus. This case shows that the non-availability of the required calendars for EPO closure dates, in combination with not being able to consult a calendar for Saturdays and Sundays, leads to unwanted effects. Therefore, it is requested to, as of

EQE 2024, again provide calendars showing the EPO closure dates as well as the Saturdays and Sundays with the exam paper, e.g., as external legal resource.

A: The calendar for 2024 was needed to correctly answer Q.5, which candidates did not have available and was neutralized. It is the intention of the Committee to provide calendars to the candidates before the exam; whether this is possible will be checked with the EQE Secretariat.'

Q: The case statement of Q.5 provides: "On 31 January 2022, Susanne [...] filed a PCT application PCT-S in German, validly claiming priority from her European patent application EP-S [...]." Statement 5.4 provides: "Withdrawing the priority claim of EP-S will affect the effective date of claim 2." For which the Examiner's Report provides answer: "FALSE: Claim 2 was not disclosed in EP-S, the priority is not valid for this claim, and the effective date of this claim is the filing date of PCT-S (Article 88(3) EPC)." So, a candidate was expected to determine whether priority was valid or not before the withdrawal (not) and after (also not). However, the term "validly claiming priority" in the case statement may have led candidates to skip the first check, as the case could be understood to already give as a fact that priority was valid, for all claims, so also for claim 2. Presumably, the drafters of the question have meant the term "validly claiming priority" to indicate that the priority declaration / priority claim satisfied (just) the formal requirements for such priority claim (PCT Art. 8, Rule 4.10 referring to Art. 4 Paris Convention; PCT R.26bis.1), while not intending to imply whether priority is actually valid for the claimed subject-matter. It is requested to refrain from using terms that may easily be misunderstood

A: The Committee always tries to use phrasing that cannot be misunderstood. Here, the term is also used in the GL, so clear what is meant.

Q: Statement 14.4 provides (emphasis added): "**A valid argument** that the cleaning utensil of claim III.1 involves an inventive step is that the claimed ranges of the fibre portions are not obvious from D1 since D1 gives the skilled person no hint at a technical advantage associated with a larger portion of lighter fibres so that the skilled person would not increase the portion of the lighter fibres to more than the maximum 64% disclosed in D1." For which the Examiner's Report provides (emphasis added): "TRUE: Indeed, D1 does not disclose any technical effect associated with respect to the amount of the lighter fibres in its cleaning cloth. Thus, in the present case this **is one example of a valid argument** to support the inventive step of claim III.1."

The answer clearly indicates that there could be more examples of valid arguments than just this one. Indeed, more arguments may be needed to argue that claim III.1 is indeed inventive over D1 (e.g., in relation to the ends/loops), but in an inventive step argumentation, the

argument given in statement 14.4 is just one of a series of arguments that together form a complete reasoning in support of inventive step. 1) Can the Pre-Exam committee indicate what they consider "a valid argument"; 2) Is it any argument that can be part of a complete reasoning? Or only the "key arguments" thereof; 3) Can an argument be "a valid argument" even if it is by itself not a sufficient argument to demonstrate inventive step?

A: The term "valid argument" is used more or less each year. A "valid argument" is an argument that is not faulty, that has no flaws. So, is a specific argument that is considered valid. It is not necessarily complete. It is not necessarily successful.

Q: The neutralization in Q.16 is understood and appreciated. Can the Committee indicate how former exams are evaluated, including complaints and appeals, and how that evaluation is used in the design and review of new exams? Is there a plan-to-check-action cycle?

A: The Committee uses evaluation of former exams, complaints and appeals: the Committee evaluates them and uses them in the design of the exam. Direct feedback from candidates during pre-exam is absent, so the Committee uses all other input for drafting of questions, such as these meetings.

Q: W.r.t. statement 17.4 (which was not neutralized), one could argue that while the specific range for the amount of water is explicitly disclosed in [009] of the application, this range is described in relation to "some implementations" and thereby not sufficiently linked to the embodiment represented by claim I.8. Likewise, if the client's application were to be considered for support for claim I.8bis, one could argue that while each of the ranges claimed in claim I.8bis is disclosed individually in the client's application, the specific combination is not suggested. There are thus also valid arguments in support of the amendment violating Art. 123(2) EPC and answering 'False' to this statement. Can the Committee and the Examination Board indicate why the statement was not neutralized?

A: Statement 17.4 was not neutralized, as the Committee considers the answer sufficiently clear.

Q: In assessing statements 18.3 and 20.1, the Committee appears to consider D2 to disclose specific ranges of water while D2 just discloses ranges of "a water-based solvent system". However, when considering that a certain percentage of a water-based solvent system does not directly and unambiguously disclose a certain percentage of water (as the water-based solvent system may, or even will, have additional components than just water), the answers to 18.3 and 20.1 flip. See below for details for the two statements, 18.3 and 20.1. Neutralization of these statements was however not done.

Q-a): In assessing statement 18.3, the Committee appears to consider D2 to anticipate the subject matter of claim I.3.

However, there are valid arguments to be made that D2 in fact does not anticipate claim I.3. Namely, according to D2, the “solvent system” of D2 is “water-based” and does not directly and unambiguously disclose any amount of water: while a range is given for the solvent system, it is not clear how much of the solvent system is actually water. Without specialist knowledge in this field (and possibly even with such knowledge), it stands to reason that a water-based solvent system comprises additional components besides water. This follows from the plain meaning of the term “water-based” which normally indicates more constituents than just water and, even more, the term “system” which normally indicates a group of components. If this interpretation is followed, there is necessarily less water present in the erasable ink composition of D2 than indicated by the numerical values given for the solvent system itself. Since the amount of water is not otherwise disclosed, one cannot *directly and unambiguously* conclude whether the disclosure of the water-based solvent system of D2 anticipates the claimed water range in claim I.3.

In this respect, it is noted that the Examiner’s Report refers to the client’s application as providing a definition that “water-based solvent system” means that the solvent system consists of (i.e., is 100%) water⁹. However, it was argued that this argument is not convincing for the following reasons:

- [002] of the client’s application simply states that “*water-based inks are based on using water as a solvent*” which does not go beyond the direct meaning of the term “water-based”, i.e., that the solvent system is based on water. Also, the phrasing “using water ... as a solvent” does not indicate that a “solvent system”, which is the actual claim feature in claim I.3, does not comprise other components.
- Furthermore, the sentence in [002] of the description of the application cannot be used to interpret the prior art differently than what would be the common interpretation: one cannot redefine the prior art in one’s own application and thereby create novelty. Hence, when applying the gold standard to the prior art disclosure, one can argue that there is no unambiguous disclosure of an amount of water (only) which could anticipate the ranges in claim.

However, the statement was not neutralized by the Examination Board, while it was mentioned before that statements would be realized in case of doubt and ambiguities about their interpretation or correct answer.

⁹ The Examiner’s Report provides, in the argumentation for 18.3: “The description in [002] of the application mentions that water-based ink are based on using water as a solvent rather than using other solvents. This means that “water-based” corresponds to “water”.”

Can the Committee and the Examination Board indicate why the statement was not neutralized?

Q-b): For Q.20.1, the Examiner’s Report argues “True”. No neutralization was done. However, as for statement 18.3, one may argue also here that one cannot conclude whether the disclosure of the water-based solvent system of D2 anticipates the claimed water range in claim II.1.

Another argument against D2 anticipating the claim is that claim II.1 claims a specific combination of ranges. However, there is no direct and unambiguous disclosure of one embodiment in D2 which anticipates all of these ranges at once. Rather, D2 itself discloses various ranges (which have end points which do fall within the claimed ranges) but these ranges in D2 are not part of a same embodiment. One could thus argue that claim II.1 is novel in view of the “two-list” selection principle of Guidelines (2022) G-VI 8.

Given the above, one may argue that a novelty attack based on D2 will fail.

However, the statement was not neutralized by the Examination Board.

Can the Committee and the Examination Board indicate why the statement was not neutralized?

A to Q-a) and Q-b): When setting up the Examiner’s Report, the Committee considered the answer sufficiently clear. The Committee does not know of candidates that have been failed because of these two questions (note: some did, as is known from the blogs and from private communications).

Q: As follow-up, a tutor commented that he was also surprised that 18.3 and 20.1 were not neutralized in view of the earlier information from the Committee that “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”¹⁰, as well as that “the Committee and Examination Board consider statistics, blog posts and comments when deciding on a possible neutralization of a statement or question, as these may indicate possible problems and ambiguities”^{11,12} - that these statements were widely discussed on the blogs with good and detailed arguments seems a reason to expect neutralization.

¹⁰ “Tutors’ Report on the EQE 2019 Papers and the Meeting between Tutors and EQE Committees”, Nico Cordes (NL), Luis Ferreira (PT), Andrew Hards (DE), Katerina Hartvichova (CZ), Harrie Marsman (NL), Sander van Rijnsouw (NL), and Roel van Woudenberg (NL), **epi** Information 4/2019.

¹¹ “Tutors’ Report on the EQE 2021 Papers and the Meeting Between Tutors and EQE Committees”, Nico Cordes (NL), Luis Ferreira (PT), Anna Valborg Guðmundsdóttir (IS), Andrew Hards (DE), Jelle Hoekstra (NL), Harrie Marsman (NL), and Roel van Woudenberg (NL), **epi** Information 4/2021.

¹² “Tutors’ Report on the EQE 2022 Papers and the Meeting between Tutors and EQE Committees”, Nico Cordes (NL), Luis Ferreira (PT), Anna Valborg Guðmundsdóttir (IS), Andrew Hards (DE), Harrie Marsman (NL), Zsófia Pintz (HU), Sander van Rijnsouw (NL), and Roel van Woudenberg (NL), **epi** Information 4/2022.

A: The Committee sees this as a clear definition of the term “water-based”, and not just a term in the application. Volker suggested to agree to disagree, and the discussion was closed.

Volker expressed his thanks for questions asked by tutors, as they are useful for thinking questions for the future.

9) Concluding remarks

The annual meeting of EQE tutors and members of the EQE Committees and of the Examination Board took place on 18 and 19 October 2023. The meeting took place by videoconference.

With this report, tutors summarize the papers and provide information of the points discussed at the meeting so that candidates and other tutors can also find this information. In addition, we hope that our summaries and comments can assist when reading and interpreting the official Examiners’ Reports¹³ of the EQE 2023 papers.

¹³ Candidates are reminded that “The purpose of the examiner’s report is to enable candidates to prepare for future examinations (cf. Art 6(6) of the Regulations on the European qualifying examination for professional representatives).” The Examiners’ Reports are available in the Compendium on the EQE website (<https://patentepi.org/r/info-2304-19>).

Report from annual epi Tutors’ Meeting on 12 October 2023

B. Atalay, Chair, **epi** Tutors and Coaches Subcommittee Professional Education Committee
M. Mackett, Chair, **epi** Students and EQE Candidates Subcommittee

The first part of the annual **epi** Tutors’ Meeting was held on October 12, 2023 at the Holiday Inn, Hochstrasse in Munich. The meeting was in a hybrid format moderated by Margaret Mackett. It featured three segments with different speakers and topics.

In the first segment, Jirka Bacik discussed the transformation of the tutor’s role into that of a content creator as well as a conventional tutor. The second segment featured Derek Jackson (now retired), who provided insights into the history of tutoring and past EQE papers as well as the current state of tutoring. In the third segment, Anna Valborg Gudmundsdóttir and Sara Morabito presented the survey results from Paper C covering the years 2021 to 2023.

In summary, the first part of the meeting allowed tutors to discuss the evolving role of tutors, the history and current state of tutoring, and the results of the Paper C survey study.

The **epi** Tutors who attended the meeting in person in Munich were able to join in the evening buffet dinner at Hofbräukeller in Wiener Platz.

The second part of the **epi** Tutors’ Meeting, again moderated by Margaret Mackett, was held on November 3, 2023, fully online to facilitate further discussion on the evolution of the EQE and the changing dynamics of how tutors should interact with candidates. This includes not only providing

training but also developing new material tailored for the updated EQE. The 2023 exams were briefly discussed, with comments noting a greater emphasis on an electromechanical style, with Paper A reverting to the old-style multiple embodiment generalization format.

Discussions delved into the structuring of a diverse range of questions in the new EQE, allowing for testing in more varied ways within the updated system. Considerations were made on how tutors should prepare their candidates for this new format, emphasizing the importance of awaiting further clarification on the specifics.

In an effort to assist candidates taking the exams in a non-native language, usually English, it was suggested to include reading lists that incorporate materials such as the Harry Potter series of books and Bill Bryson’s “A Short History of Nearly Everything”. These resources aim to enhance candidates’ English reading skills, even though the content may not be technical. Additionally, candidates were encouraged to read newspapers, blogs, and explore patents outside their specific technical field, as well as engage in translation exercises, as these practices can prove beneficial.

The next meeting is scheduled for February 14, 2024 at 11am via Zoom. If there are any patent attorneys wishing to join the ranks of **epi** tutors and attend the meeting, please contact the Education Team at the **epi** Secretariat (education@patentepi.org).

2023 epi survey of Paper C Candidates

J. Gwilt, Chair, Professional Education Committee

M. Mackett, Chair **epi** Students and EQE Candidates sub-committee (PEC)

Following numerous complaints received from candidates, tutors and bench-markers, the Professional Education Committee, by way of its **epi** Students and EQE Candidates subcommittee, carried out a survey about Paper C to be able to discern trends and to highlight specific issues relating to candidates having to sit this examination paper online. The surveyed group comprised individuals who could be contacted by **epi**, namely **epi** Students, and recently registered professional representatives. We received 636 responses to the survey.

In the survey, we asked a number of questions including those relating to time management in Part 1 and Part 2 of

the paper; the language in which the paper was answered; technical difficulty of the subject matter; and suggestions on how the examination could be improved.

Part 1 of the examination was the main issue with candidates sitting the examination as many ran out of time and could not complete all the required tasks. Chart 1(a) summarises the responses for reading documents, performing analysis, and attacking all three claims (respondents could select more than one option). In addition, very few respondents finished on time as shown in Chart 1(b), and when compared to 2019's examination, candidates still needed up to an additional time to complete the paper.

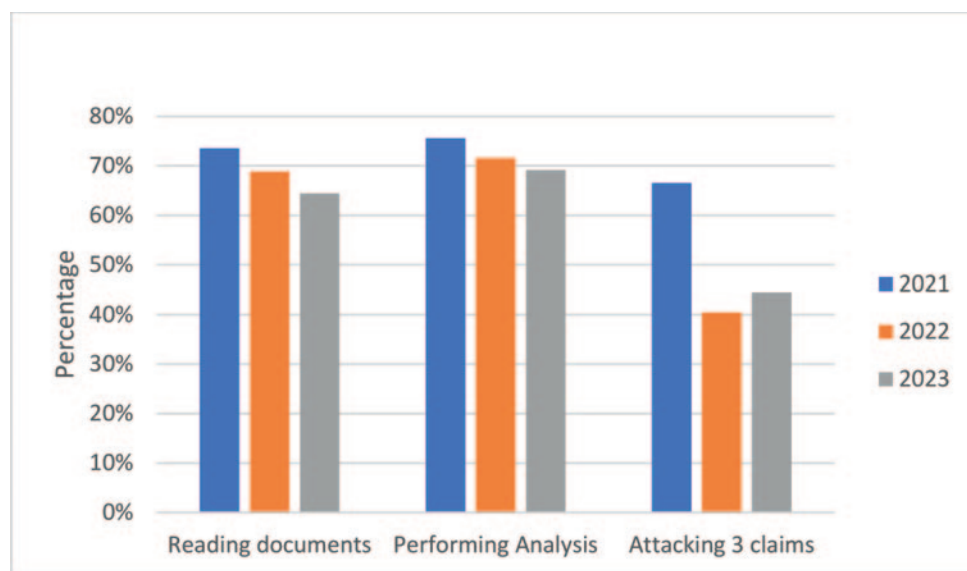


Chart 1(a) – Respondents ability to complete the tasks in Part 1

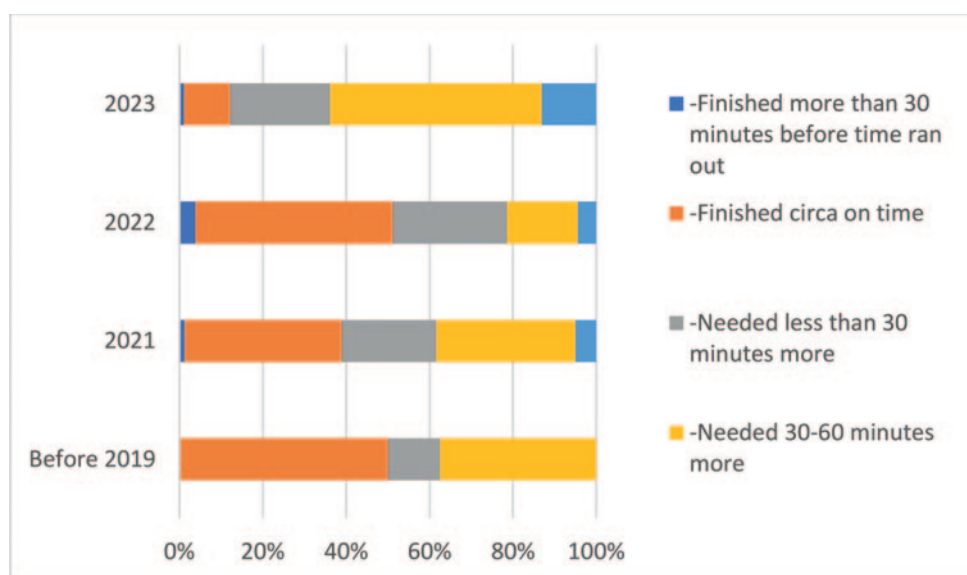


Chart 1(b) – Time management in Part 1

Chart 1(c) – Respondents’ overall success rate relative to time management

From analysis of the responses, we were able to evaluate overall success rate relative to time management for Part 1 as shown in Chart 1(c) above. The results appear to be skewed because large numbers of respondents passed (except in 2023), but not surprisingly, those that indicated that they needed more time are more likely to fail.

Chart 2(a) indicates that respondents were more able to complete tasks in Part 2 of the examination with Chart 2(b) indicating that less than 20% of the respondents needing more time.

Chart 2(a) – Respondents’ ability to complete the tasks in Part 2

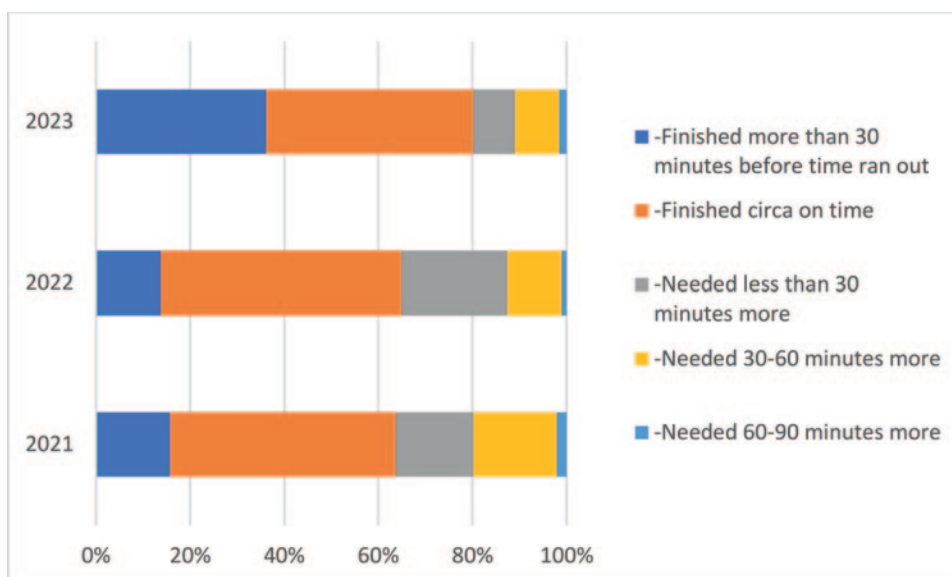
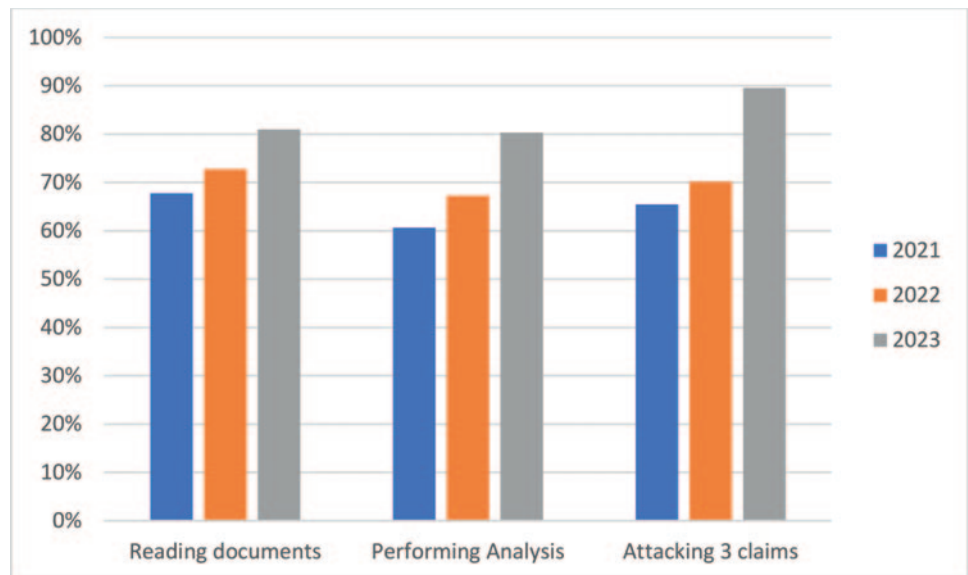
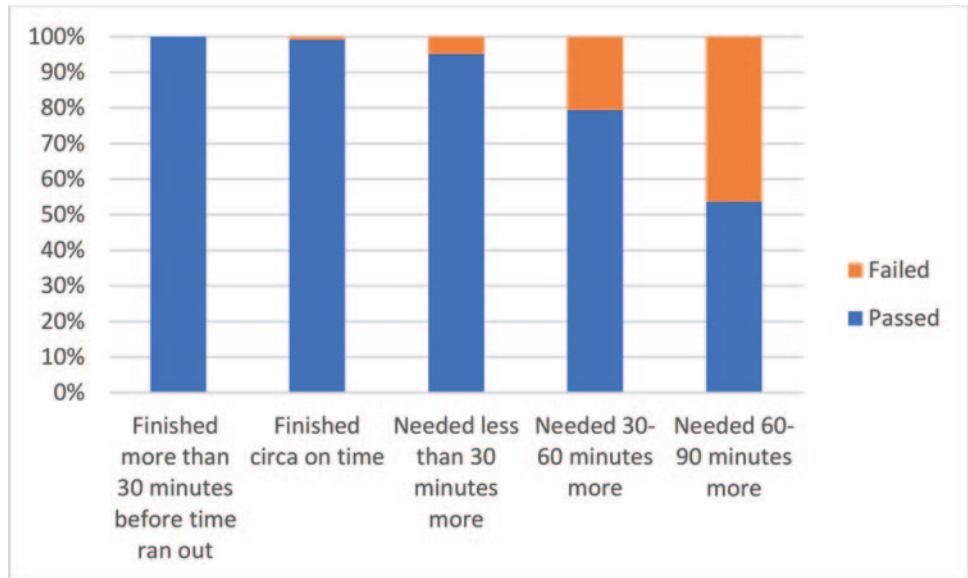
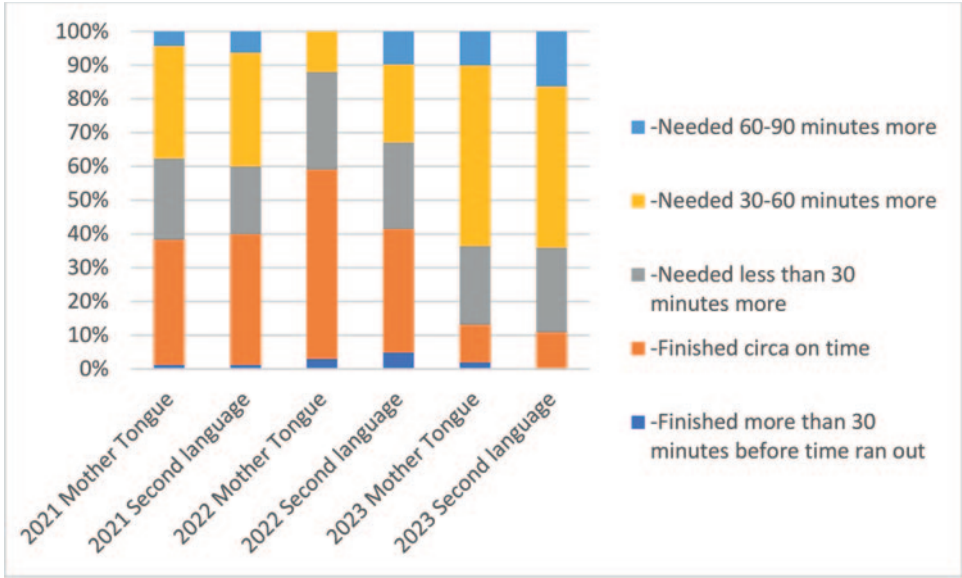
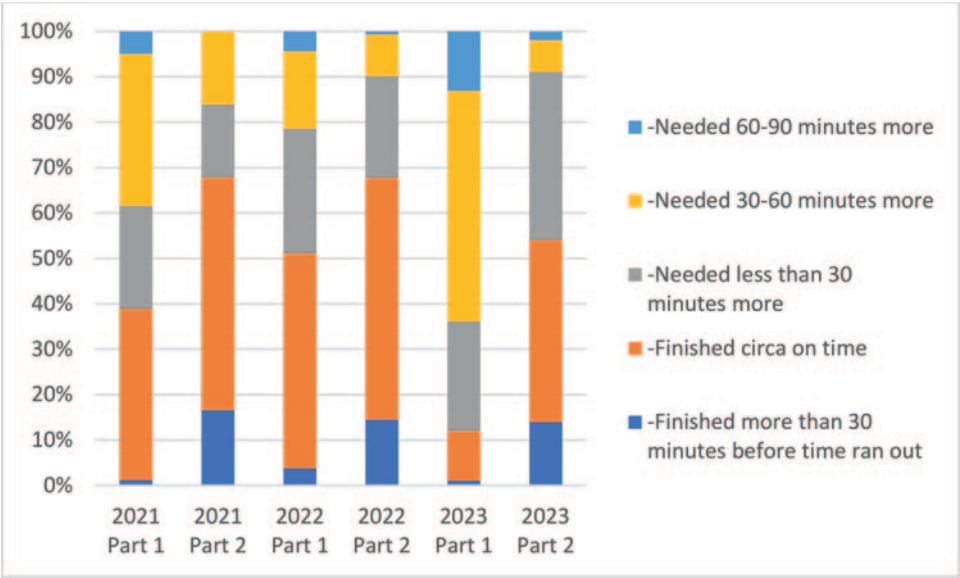


Chart 2(b) – Time management in Part 2

Chart 3 shows the comparison between Parts 1 and 2, indicating that there is too much to do within the available time for Part 1 (particularly in 2023).

Chart 3 – Comparison of time management in Parts 1 and 2

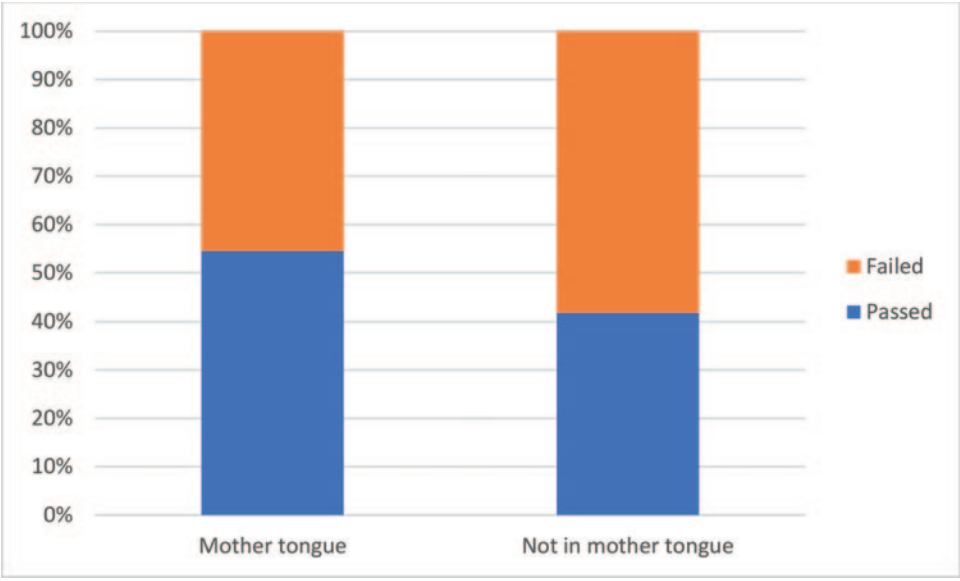


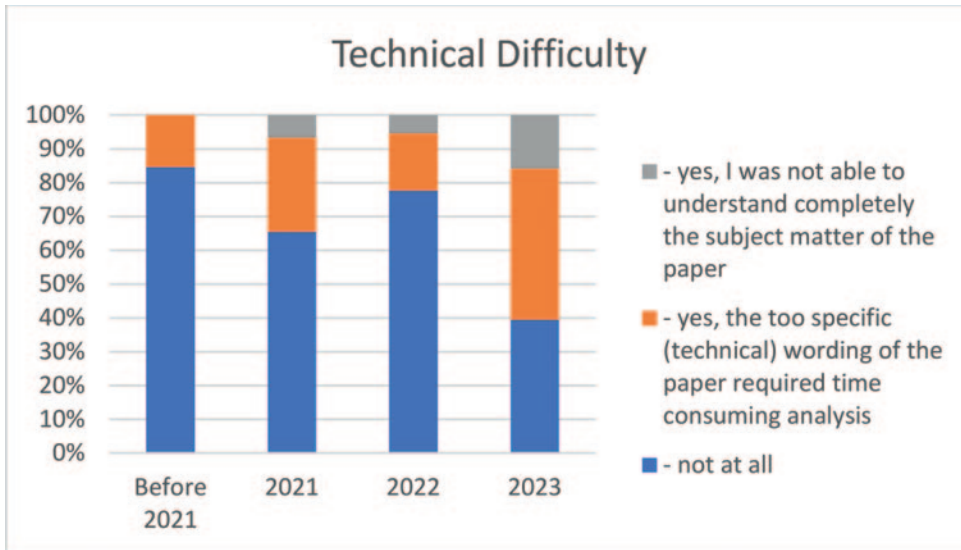
With respect to mother tongue analysis, it was found that for time management in Part 1, apart from in 2022, there was no significant difference between those answering the paper in their mother tongue and those who are answering in a second language. This is shown in Chart 4.

Chart 4 – Time management in Part 1 based on first and second language

Overall, for 2023, the pass rate appears to be better for those sitting in their mother tongue as shown in Chart 5.

Chart 5 – Pass rates in 2023 dependent on language



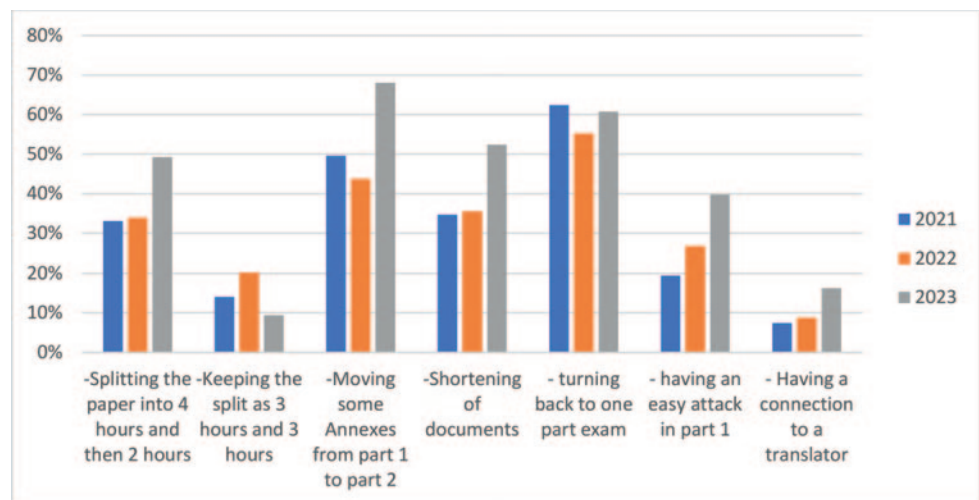


The technical difficulty in the subject-matter appears to have increased significantly in 2023 as shown in Chart 6.

Chart 6 – Technical difficulty of the subject-matter

Suggestions for improving Paper C were also received which include changing the split, shortening the length of the prior art documents, moving annexes from Part 1 to Part 2, having an easy attack in Part 1 and connection to a translator as shown in Chart 7.

Chart 7 – Suggestions for improving Paper C



In summary, there is a need to alleviate the consequences of the forced split of Paper C into Part 1 and Part 2 and to keep the technical subject-matter accessible to everyone (irrespective of their technical background). There is no wish for an easier paper but for a paper in which candi-

dates can prove their knowledge of the EPC and deal with the provided subject-matter efficiently and effectively.

The survey results have been shared with members of the Supervisory Board, the Examination Board as well as Examination Committee ECII.

Half a century of EPC

44 years of EQE and opening a new chapter

B. Atalay & M. Mackett, Event Organizing Working Group



epi held an event to celebrate 44 years of the EQE with thanks to the **e**pi and EPO examination committee members, Supervisory Board members & EQE Secretariat on 12-13 October 2023.

The event started on the evening of 12 October with a buffet dinner at Hofbräukeller in Wiener Platz, Munich which was also attended by **e**pi Tutors who were present at the Tutors' meeting earlier in the day.

On 13 October, the day began with the registration of attendees as usual and was moderated by Nicolas Favre. An earnest welcome was extended by Peter Thomsen, the President of the Institute of Professional Representatives before the European Patent Office (**e**pi), and António Campinos, the President of the European Patent Office (EPO). Their opening remarks underscored the historical importance of the occasion celebrating half a century of the EPC and 44 years of the EQE.



A comprehensive journey into the historical evolution of the European Qualifying Examination (EQE) followed. Michael Liebetanz traced the EQE's development over four decades, shedding light on the milestones and transformations that have shaped it into what it is today.

The focus then shifted towards the future of the EQE, a topic of paramount importance for examination committee members and candidates. Tiem Reijns and Xavier Seuba took the stage to provide their perspectives on the challenges and developments that lie ahead for the EQE.

The EQE Candidate Support Project (CSP) emerged as the focal point of the subsequent session after the lunch. Oana Boncea, Anna Valborg Gudmundsdóttir, and Delia Brasfalean collectively presented the CSP's significance and the vital role it has played in aiding EQE candidates in countries not having enough EQE-qualified European Patent Attorneys to pass the EQE.

In the following session, Marc Nevant and Nina Ferara, explored the strategies and initiatives designed to create a more inclusive and equitable environment for all involved in the intellectual property profession.

In the final session, by Bart van Bezenweek delved into the operations and responsibilities of the Disciplinary Board of Appeal with respect to appeals from the EQE.

The event culminated in a networking and cocktail reception, allowing attendees to engage in further discussions, exchange ideas, and celebrate the significant milestones reached during this gathering.



Committee Reports

Report of the Professional Conduct Committee

G. Checcacci (IT), Outgoing Chair

1 Code of Conduct – some amendments have been approved by the Council at its meeting on 11 November 2023

After a long work, spanning over three terms of PCC, some proposals for amending the Code of Conduct have been adopted by the Council at meeting C96. These proposals are the result of the work of several Working Groups of PCC, which proposed, discussed, received suggestions, presented drafts (to the Board and to the Council); in the end, the semi-final draft was discussed (and further amended) in a joint Working Group with the By-Laws Committee during last summer.

The scope of this revision includes updating and improving the wording of the Code of Conduct, a reference to continuing professional education, a revision of the wording in respect of conflicts, and specific conduct provisions in respect of internal **epi** elections.

Revision of the wording includes a more extensive and precise use of definitions, the correction of few incon-

sistencies, and the adoption of a gender-neutral wording.

Continuing professional education is addressed by an explicit reference in Art. 1 to the personal duty to keep ourselves professionally updated.

In respect of conflicts, a lot was discussed but in the end it was preferred to introduce only very limited amendments, only to conform to the wording of the Regulation on Discipline.

A new Art. 8 addresses now the conduct of members in respect of **epi** internal elections.

The proposal presented to the Council included also a new sub-article addressing keeping of files, but the Council has found possible difficulties in applying that provision in some specific cases and eventually rejected the proposal. Thus, this issue will be studied again by PCC.



Giorgio Checcacci

The amended Code of Conduct will be published as usual in the EPO Official Journal and be soon available on the **epi** website.

2 Code of Conduct – further activities in other areas

In addition to the mentioned issue of keeping of files, PCC will continue to study and discuss possible further improvements of the Code of Conduct, in particular in respect of the following issues:

- transfer of files
- diversity and inclusion
- provisions for members responsible for training EQE candidates
- provisions for EQE candidates
- possible conflict situations related to national address for service for granted patents

3 Training

The specific WG of PCC continues to work – together with the Professional Education Committee – to offer training in the area of conduct.

After the two webinars offered in January 2023, a further webinar was offered in September, addressing the

basics (provisions, bodies and procedures) of the disciplinary system for **epi** members. This webinar was offered after having realized from the practical experience of many requests under CoC Art. 7(d) that, while most **epi** members seem well in line with the conduct provisions, many of them do not know how the disciplinary system works and what can be expected in a disciplinary case or when requesting advice under Art. 7(d) CoC.

More webinars are under preparation.

4. Membership of PCC

In PCC, each national group can (and in principle should) be represented by a member, possibly also by a substitute member, but unfortunately some national groups have not been represented in the last term, and even less are represented in the present term. As many as 12 countries are not represented: Czech Republic, Denmark, Estonia, Croatia, Hungary, Iceland, Luxembourg, Latvia, Montenegro, Malta, Serbia, Slovakia. Even more are the countries with no substitute member: they are 27, i.e. the great majority of the 39 countries.

PCC reminds that there is always an opportunity to remedy this situation by interim elections, at future Council meetings, provided that there are available candidates.

Report of the epi-Finances Committee

C. Quintelier (BE) Chair, T. Powell (GB) Secretary

The 91st meeting of the Finances Committee took place in Munich on 19 October 2023. The Treasurer and Deputy Treasurer attended, as did the Internal Auditors and their substitutes. The Executive Director and the Head of Finance attended in order to provide information from the strategic management and finance functions of the Secretariat.



Claude Quintelier

The Treasurer presented an extensive financial report. This included a snapshot of financial performance for 2023 to date; a 2023 year-end projection; the 2024 budget proposal; and updates on investments.

The Head of Finance and the Executive Director summarised progress in the current financial and general management projects in the Institute.

The financial report indicated that a deficit of €524000 is projected for 2023. This was explained primarily by variations in educational event income and expenditure. These are very hard to predict at the budget planning stage; and 2023 has been notably volatile in this regard. Since the financial policies of the Institute require the maintenance of an adequate reserve to permit a deficit as an isolated occurrence, the Committee is happy to accept the financial performance of the Institute in 2023 to date. The Committee also noted the projected performance to the year-end.

The Head of Finance presented an analysis and several options pertaining to possible increases in the membership

subscription fee. In particular the Head of Finance showed figures in which the impact of the inflation and the increase in the number of **epi** members was taken into account. Based on those figures the Committee explored in depth the reasons for needing an increase, and the likely ramifications of various levels of change. After extensive debate the Committee unanimously approved an increase in the annual subscription to €240. The Committee recommended that this is presented to Council together with sufficient explanatory information as to make clear the compelling reasons justifying the proposed change.

The Committee noted the reports on progress in various projects that are in progress. The Committee questioned

the Executive Director and Head of Finance on numerous aspects, in order to be confident that the projects are being prosecuted in a financially efficient manner.

The Committee commented favourably on the increased levels of reporting information available from the finance team in the Secretariat as this considerably reduces the complexity of the Committee's meetings.

This being the last meeting of the Committee before the committee elections are complete the Chair took the chance to recognise the extensive contributions, over many years, of several members who had not stood for re-election.

Report of the EPO Finances Committee

J. C. Boff (GB), Chair

A meeting of the Budget and Finance Committee 25th October was attended by three members of the Committee (Winter, Schober, Boff), and the Committee has been occupied in preparing for this.

Earlier in the year the Committee assisted in discussions with the EPO concerning a "non-paper" relating to changes in fee structure and support for micro-entities. This non-paper has reappeared as document CA/63/23 which was discussed at the BFC, but other documents raised at the BFC are relevant and discussed in the following.

CA/63/23 – Fee-related support measures for micro-entities and review of the fee policy¹

Background

CA/63/23 proposes:

- a system of reduced fees for individuals, micro-entities, universities, and public research organisations;
- to change procedural fees, increasing for example the 3rd and 4th renewal fees by ~30%; other selected fees by 4% or more, and with a promise of no fee increases in 2025.

This proposal has been given a favourable opinion by the Budget and Finance Committee, although with some dissenting voices. It will be discussed at the Committee on Patent Law 16th November 2023.

The proposal on reduced fees for selected applicants appears poorly targeted, liable to distort applicant behaviour, insufficiently researched and costed, and liable to increase fees for other applicants.

The proposed change in fee structure will affect user cost in the early years of an invention.



James Charles Boff

Existing support for micro-entities

Support at varying levels and by various means is provided at national level and, for some, at an EU level.

At the EPO level, support is relatively small and consists of:

- Rule 6 language related reductions in fees for eligible entities [€3.1m]
- Unitary patent language related "compensation" for eligible entities [€0.2m]
- A reduced appeal fee for eligible entities [€0.1m]
- Reductions in search fees charged to national offices on searches performed for eligible entities [€5.7]

(costs are indicative total cost from Annex 1 of CA/63/23).

¹ <https://patentepi.org/r/info-2304-20>

Eligible entities for all such support are applicants who are:

- natural persons;
- small and medium-sized enterprises as defined by the European Commission Recommendation 2003/361 of 6 May 2003, i.e. staff < 250 persons, turnover < EUR 50m and/or balance sheet < EUR 43m, no more than 25% of capital held by another company;
- universities or not-for-profit research institutes

For the language related support, the applicant must be domiciled in (or optionally for Rule 6, national of) one of the 38 EPC states.

The effectiveness of the largest value item (reduction in search fees to national offices) must be questioned. The fee charged to the national office is indeed reduced for up to 400 cases a year for eligible entities. However, since for many of the national offices concerned the fee normally charged for search is below the reduced fee charged to the national office, the entity concerned never sees any benefit [see discussion of CA/55/23 below].

Problems with the proposal in CA/63/23

The proposal is poorly targeted.

In discussion of the non-paper it was pointed out to the EPO that in the US there is a lifetime limit of four applications to be able to claim micro-entity status. The proposal introduces a limit of five applications in the previous five years. However this still does not appear to target “those innovative entities with limited experience of the European patent system” that CA/63/23 is aimed at.

The proposed reductions are not limited geographically and could be claimed by entities from around the world. Is it right that European applicants should subsidise non-European entities?

The proposal is liable to distort applicant behaviour

In discussion of the non-paper it was pointed out to the EPO that in the US there are complicated rules concerning the relationships between parties to prevent someone claiming micro-entity status while acting on behalf of a larger entity. There are no such provisions in CA/63/23, and it is easy to imagine that some applicants will change their behaviour.

For example:

- for an SME (not eligible for a reduction) it could be worthwhile filing in the name of a director;

- for a university that had filed more than five applications in the previous five years (not eligible for a reduction) it could make sense to file in the name of inventors, or a company set up to deal just with one invention or group of inventions.

The provisions of EU Commission Recommendation 2003/361 include some provisions for dealing with related entities that might restrict some structures. However some people are prepared to get very complicated just to save a small amount of money – because a small amount of money a lot of times becomes a large amount of money.

The scope for distortion is large, and this makes the total cost to the EPO difficult to assess.

The proposal is insufficiently researched and costed

It has become apparent that the EPO do not know how many entities might claim fee reductions.

For “compensation” under the UP, the support has been embarrassingly successful. To date ~5% of cases have claimed compensation in contrast to the ~2% forecast by the EPO. This of course may change as small entities have been disproportionately likely to choose the unitary route. What is clearly not considered by the EPO is how applicant behaviour might change because of a general fee reduction not linked to the language regime of the EPC.

Reduced fees for one applicant, means increased fees for other applicants.

Despite their financial health (see below) the EPO's principal source of funds is applicant fees. If the EPO ever get to the position that they have more money than they prudently need, reducing costs for all should be the aim.

Irrational outcomes

Under the proposal a billionaire director of a multinational company could file for a patent in their own name and get reduced fees, whereas an SME having 10 employees will get no reduction. Do the rich need subsidies?

Alternative proposals

There are different ways that users can be supported other than by subsidy. One of the principal problems for new entrants to a market is timing. In the early years costs come in while revenues do not. A system of partial deferral of fees could permit applications to progress without costing the EPO so much in lost fees, with the need for other applicants to meet the shortfall. At a time when the EPO is sitting on extremely large prepaid fees while waiting to do the related work, this offers a potential solution. The President sent a letter to the

BFC² as attached with a proposal on these lines. This is not the only proposal that might be made.

CA/68/23 – financial study³

The EPO have previously commissioned financial studies to indicate the health of the EPO and to provide a 20-year view on how that health would develop. The latest study states that the EPO's finances are sound and liable to improve further, but that the principal risks are macroeconomic shocks that may affect the investments of the EPO and pension fund.

The study highlights the rapid growth in stock and demand, and the effect this is having on timeliness. It is noted that production is down, driven both by a decrease in the number of examiners and a decrease in examiner productivity.

CA/55/23 – Working agreements on search co-operation⁴

This paper reviews the fees charged to member states who use the EPO as a search authority. The formula used is to some extent reasonable.

² <https://patentepi.org/r/info-2304-21>

³ <https://patentepi.org/r/info-2304-22>

⁴ <https://patentepi.org/r/info-2304-23>

As mentioned above there is alleged support for micro entities which is in the form of a reduction in the search fee charged to the national office of 80%. This looks like generous support, however for many national offices concerned the fee normally charged for search is below the reduced fee charged to the national office, the entity concerned never sees any benefit. There may be offices where the SME will get the bulk of the value of the discount, but these do not include the largest users of the system where it is evident that the national office benefits more than the SME.

Other matters

As mentioned above, initial information on the UP indicates a higher use of the system by SMEs than had been anticipated and hence higher payments in compensation. In addition, the effect of the delayed start to the system is that for 2023 the national offices will see no share of the renewal fees, as start up costs had to be covered.

As SMEs normally have a tendency to validate in few countries, the high uptake by SMEs is likely to lead to an increase in income by the EPO from those applicants, and hence lower pressure on applicant fees. It is however too soon to judge the overall financial effect of the new system on the EPO.

Report of the Litigation Committee

K. Finnilä (FI), Chair, T. Walshe (IE) Secretary

The Litigation Committee had its last [in-person] meeting for the term 2020-2023 on 10 October 2023 with a good attendance with over 2/3 of our members. We have also had meetings with the UPC IT Team & Registrar as well as observers before the UPC Administrative Committee.

Litigation Committee meeting

Now that the UPC is operational, we had presentations on some of the initial decisions issued by various UPC local divisions.

The **first** case – UPC_CFI_ 177/2023 – myStromer AG v Revolt Zycling AG – concerned a Preliminary Injunction at the Düsseldorf Local Division.

The hearing was held *ex parte* although the Defendant had filed a Protective Letter. The Protective Letter included

non-infringing arguments, arguments regarding exhaustion of rights, and also a request for a hearing, however the Protective Letter did not call into question the validity of the patent. The Court did not find the arguments in the Protective Letter convincing. The court found that factors including the urgency requirement and irreparable harm to be relevant.

Accordingly, the PI was found appropriate and justified, and thus it was granted – decision¹.

The **second** case – UPC_CFI_2/2023 – 10x Genomics u.a. v NanoString Technologies u.a. – was an inter partes Preliminary Injunction hearing at the Munich Local Division.

The focus of this case was on claim interpretation. The claimant also requested a limitation of the claim considered

¹ <https://patentepi.org/r/info-2304-09>

to be infringed as an auxiliary request at the hearing stating that no stipulations exist which clearly would not allow such an auxiliary request.

The PI was granted – decision².

The **third** case - UPC_CFI_214/2023 - AIM Sport Vision AG v Supponor Oy/Limited/SASU/Italia SRL/España SL took place at the Helsinki Local Division.



Kim Finnilä

The case concerned an Infringement Action and a Preliminary Injunction. The Defendant contested the claims and raised Preliminary Objections in relation to both the Infringement Action and the Preliminary Injunction on the competence of the UPC, the Helsinki LD.



Triona Walshe

The basis for the Preliminary Objection was an infringement and a validity action before German courts initiated before the UPCA entered into force and which were still pending.

The Claimant had filed an opt-out on 12.5.2023 and a withdrawal of opt-out 5.7.2023 (in parallel with filing the claim before the UPC).

The Court [exceptionally] gave an oral decision at the end of the hearing concluding that the withdrawal of the opt-out was not valid and referred to Article 83(4) UPCA and Rule 5(8) RoP as well as to Article 28 of the Vienna Convention of the Law of Treaties – written decision³.

Further we had a discussion on a planned legislation in France on **privilege for in-house counsel**. The issue of privilege for in-house counsel has also come up at international forums.

Sub-committees

The **work** of the sub-committees, in relation to the list of topics of that sub-committee, was reviewed. In the instance, where the work on a topic of the sub-committee was completed, the topic was closed. The remaining open topics are being brought forward for review in the next term. It was also suggested that the set-up of the sub-committees should be reviewed for next term.

² <https://patentepi.org/r/info-2304-10>

³ <https://patentepi.org/r/info-2304-11>

For the subcommittee on “Representation and Privilege” we will have a possibility to join the sessions of the “WIPO Standing Committee on the Law of Patents” to directly follow-up on the international discussions on Client-Patent Attorney Privilege.

The sub-committee on **UPC CMS and Rules of Procedure** has been discussing unclarities in Rule 220 RoP relating to leave to appeal for certain orders or decisions. A draft letter on this has been prepared to be discussed with the UPC Administrative Committee and the UPC IT Team & Registrar. In the meantime, however, several cases have dealt with this rule which seems to indicate that it is functional in its present form.

UPC Administrative Committee (AC) and UPC IT Team & Registrar

The most recent 8th meeting with the **UPC IT Team & Registrar** was held on 23 October 2023.

We thus had a chance to discuss issues raised at the Litigation Committee meeting. General authorisations and other issues regarding opt-outs, the process flow for filing cases, and availability of decisions and orders were some of the topics that came up. At the meeting we were told that opt-out issues would have to wait as there are some more urgent matters to deal with. We learnt that a “my legal team” function is under progress as well as self-correction functions for representative data.

From the next 9th meeting (11 December 2023) onwards the other UPC Administrative Committee observers; BusinessEurope, EPLAW and EPLIT will also participate in these meetings.

The 9th meeting of the **UPC AC** was held on 24 November 2023.

The total number of cases to date at the Court of First Instance is 138. This figure covers 59 infringement cases, 23 isolated revocation cases, 42 counterclaims for revocation, 8 preliminary measure applications, 5 applications for preserving evidence and 1 application for inspection. At the Court of Appeal 9 appeals have been filed including 1 on provisional measures (hearing on 18th December 2023), 7 procedural (preliminary objections) appeals and 1 appeal regarding Rule 262 RoP (two conflicting CFI decisions).

However, in these statistics e.g. an infringement case with four (4) defendants each filing a counterclaim for revocation would count as 5 cases. Thus, on average the number of individual, i.e. not-linked cases would be about 110. German prevails as the dominant case language, followed by English.

The Registrar noted that the “my legal team” function and “self-correction of representative data” should be implemented shortly. Struggles with the CMS by both users and internally within the UPC are recognised, but it is clear that the IT team are working hard to ensure improvements are under way.

The implementation of the **Patent Mediation and Arbitration Centre** (PMAC) has been somewhat delayed. The next steps are the recruitment of a Director and a 12 mem-

ber Expert Committee (responsible for the Rules of Mediation and Arbitration and the list of mediators and arbitrators).

The EPLC accreditation requests by CEIPI and Fernuniversität in Hagen were approved. Now there are four accredited course providers.

We are now preparing for the term 2023-2026. Hopefully we can also continue with brief reports on UPC cases!

Report of the Committee on Biotechnological Inventions

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

Below is a summary of the points our committee has been handling in 2023.

1. Chair of the Biotech Committee (BC)

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

2. ST.26 Sequence listings

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

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

It has to be highlighted that technical issues remain with the systems for which we need EPO input. Some BC mem-

bers suggested to formulate a reply to request clarifications about what is acceptable or not regarding any automatic sequences' translations from ST.25 to ST.26. The Box-declaration on form 1001 for divisional application is also a concern. Some BC members are of the opinion that the declaration of non-added matter is considered as unfair. Such declaration should not be needed at all as soon as it will not part of the specification. It has been decided that it's up to the new chair and the new secretary to decide to formulate (or not) a reply after the summer break.



Simon Wright

On September 28, **epi** received a letter from the EPO in response to concerns raised by **epi** regarding the potential conversion errors from an ST.25 to an ST.26 sequence listing and the associated risks of added or lost subject matter. The EPO promised to change its practice soon and to implement further safeguards and steps in the transitional regime for divisional patent applications with sequence listings.

And finally, during the **SACEPO Working Party on Guidelines of October 10**, the EPO shared the news that it will **discontinue its practice of raising page fees for ST.25 sequence listings in a PDF format filed as part of a divisional application as a safeguard in order to avoid added-matter issues**. A corresponding notice should be published in the Official Journal of November 2023.

3. Draft amendments for the 2024 EPC and PCT Guidelines

epi has the possibility to comment on the draft of the new Guidelines proposed by the EPO following the SACEPO WP GL meeting of October 10. The **epi**/EPPC organised an in person meeting on August 24 and 25 to discuss those guidelines amendments. Simon Wright (new BC's chair) and De Clercq (former BC's chair) attended the meeting for sharing the first input on behalf of the BC. Our final and assembled comments have been passed to Anette Hegner by 1st September and concern mainly comments on ST.26 sequence listings, plant disclaimers and antibody patenting parts.

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

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

It could be that the EPO does not see the need to discuss the GLs with the users since it is considered an internal document. In addition, our comments are sometimes simply disregarded. This creates frustration in the user community and in the BC, at least about the section dedicated to amendment of the description. About sequence listing, things are moving into the right direction 'see above).

4. Biotech Committee meeting of July 19, 2023

The main topics of the meeting were to follow-up to points to be discussed with DG1 in the meeting of April 25, 2023, to discuss the status of our complaint to the EPO Ombuds Office and to elect the new Chair and Secretary of the **epi** BC.

5. Further special Biotech Committee meetings with the EPO

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

6. New elected Biotech Committee

Following the last validation election of the BC during the Ljubljana Council C96, the inaugural BC meeting took place on 6 December 2023 by Videoconference to perform the election of the new Chair and Secretary, to discuss about the location of the 2024 in person BC and the way to organise BC's agenda for the future. Simon Wright and Brigitte Taravella were re-elected as Chair and Secretary of the Committee. Another meeting will be planned for 2024 only by Videoconference to respect the established 2024 BC's budget. Finally, we anticipate organising a new meeting with DG1 in Q2/2024.

Report of the Online Communications Committee

J. Gray (GB), Chair

A new Session

epi's Online Communications Committee has met for the first time in its 2023-2026 composition. I am pleased to serve again as Chair, and to have David Brophy continue as Deputy Chair. Associate member Ulrich Harbach has agreed to act informally as Secretary. Thanks to these and to all the OCC members who will again put in a lot of time on behalf of the members and parties.

On 11 October 2023 the (former) OCC had its **annual meeting with EPO** IT and legal experts. This enables us to give the updates below. Members of have remained busy in various pilots, 'working groups', 'focus groups' and 'round tables', and reporting issues with new systems, some of which are discussed below. Support for ongoing improvement of UPC Case Management System continues in collaboration with Litigation Committee and UPC Reg-

istrar and IT experts. OCC members also joined the TOSC¹ meeting on 7-8 November as **epi** observers. I have also provided input to consideration of the digitalisation law changes that will be discussed in SACEPO Working Party on Rules on 26 October 2023.

EPO's IT Roadmap 2023-2024 (See previous issue)

Of great importance for *all epi* members is the EPO's roadmap for various IT developments. An updated version is in the Annex. The coming changes, and require planning & training by users, for transition to new systems.

- Firms and users need to switch to the new authentication methods NOW as **smart cards will no longer be issued from 1 Jan 2024**. More detail below.
- Firms and users should familiarise themselves with the new **Contingency Upload Service as Fax filing and Web Form Filing will be closed** later in 2024. More detail below.

These closures begin to take effect from 1 January 2024.
More detail is given below.

MyEPO Services – new functions and pilot features

MyEPO Portfolio has added major functionality for pilot groups and for general use since C94, with more due for release on 1 November 2023. For example “self-service” changes can now be made in representation and bibliographic data. Eventually, features of OLF 2.0 and Central Fee Payment will be integrated. However, OCC members have encountered many bugs and omissions in these functions, and continue to bring these to the attention of EPO.

Recent new functions include:

- Two-factor authentication (**2FA**) is now very successfully established as a flexible **alternative to the smart card** for MyEPO Portfolio, OLF 2.0 and Central Fee Payment).
- **See advice below**
- Requests for change of representation by “self-service”. A problem is that the old representative loses access to a case without knowing whether the change to a new representative is safely logged. Notification to the old representative should be mandatory and automatic (See also EPPC reports from SACEPO-WPR.)

- Improved integration with Central Fee Payment: payment with deposit account in a single step with e.g. approval of text is now provided. (Hooray!)

The latest pilot group session in October heard about further developments to be trialled with pilot users in Pilot Phase 3:

- A first **API** to download MyEPO mailbox communications automatically exists in pilot. Future projects: Error handling; APIs for OLF2.0; endpoints for signature and sending. APIs will be fully backwards compatible to eOLF. A sub-group of pilot users has been formed, which includes IT providers who make the popular IP management systems. A problem is that OCC/**epi** has no visibility of this collaboration, and IT developers talking only to IT developers is not always a good recipe for user-centred solutions...
- **Question for members:** Is your PMS provider involved in the pilots?
- **Retrofitting 2FA to eOLF** will be implemented before the year end. (See below)
- Portfolio access administered by company administrators is being trialled.
- Opposition cases will be visible in the portfolio.
- Interaction with examiners, including with editing of shared documents.

As previously advised, firm administrators and management need to pay attention to the updating of records of associations, access to unpublished cases, Mailbox, smart cards etc.. Even if you don't use MyEPO Portfolio day-to-day, use it to review such permissions. Permissions may change unexpectedly when new administrator features are released.



John Gray

UP and UPC IT infrastructure

OCC continues to support LitCom in submissions to the UPC Preparatory Committee concerning the UPC CMS, critical for managing Opt-out procedures (see also LitCom reports).

¹ (Technical and Operational Support Committee of the EPO Admin Council – EPO and national office experts cooperation)

Online Filing

Online Filing 2.0 has settled down and seems quite popular among its users. The **opposition form 2300** has been available for some time. A Notice of Appeal form EP3002E is now available in Demo mode, and should be fully live by the time of C96.

- **Your Administrator needs to give you rights to draft, sign and/or send each different form in production and/or demo mode.**

Alternatives to smartcards – !! MAKE THE CHANGE !!

No new smart cards will be issued after the end of 2023. The new MyEPO platform and OLF2.0 are already using the new **two-factor authentication** ("2FA") platform. **The "legacy" online filing system eOLF has been updated to use the new 2FA**, at least for EPO procedures. Users can even use their smart card in parallel while they get used to the new authentication system for the time being.

Take action NOW to avoid being locked out:

- **Smart card users should register NOW with the new 2FA system.** (Where are your smart cards & PINs? When do they expire?)
- **Firms/departments need policies NOW** as to which modes of 2FA are acceptable. Who can use (i) company devices and (ii) private devices. Setting up more than one second factor is a good precaution.
- **Do you use eOLF to file at EPO?** Update NOW to version 5.15 and try out the new way to sign and send submissions.
- **Do you use eOLF to file at a national office?** Your national office will need to update their eOLF setup, before 2FA can be used for national procedures. As far as we know, no national office has done this yet.
- **Do you use EPO smart cards to access other national office systems? Is your national IPO ready** with an alternative authentication method? It seems that **several offices are not ready**. EPO has announced that replacement smart cards may exceptionally be issued to renew existing users of such systems, but no new users will be accommodated.

More information on 2FA¹² and phasing out smart cards¹³ is at the EPO website and in the OJEPO article, November 2023 edition.

Contingency Upload Service (CUS)

The EPO now provides an alternative to fax filing for "**rescue**"/**emergency filings**. **Users and firms should familiarise themselves⁴ with CUS** in good time before incoming fax lines are abolished (scheduled mid-2024). The service is excellent in its implementation BUT OCC is vexed that this system has been conceived for a very limited set of circumstances, and legal certainty is undermined. My report to the Board on this is provided at **Annex 3**, which was endorsed at B127. Briefly:

- What happens if the IT emergency is at the user side? Or if you just don't know if it's at your side or theirs?
- What is the solution for last minute fee payments when EPO systems are inaccessible?
- What is the solution when proper PDF generators are unavailable and you need to establish a filing date with highly informal materials, e.g. a Word file, photos/scans of a paper document, etc. etc..
- What is the solution for a foreign or unrepresented applicant who knows nothing of the EPO formal requirements?

As a matter of principle, **OCC has always argued that imposing formal requirements before a person can establish a filing date** is contrary to fundamental principles of the EPC and international treaties. Any common file format should be acceptable, of course at the risk of the person filing.

EPO has promised clear guidance, but through SACEPO-WPR and direct contact we are seeking assurance that legal basis is provided for flexibility. Technical implementation to improve flexibility can only proceed when the legal certainty is in place.

'Front Office' for national patent filings

12-13 countries use/plan to implement **national filing systems** based on the new "**Front Office**" platform, after the proof of concepts by Lithuania and Spain. Other countries with ongoing/agreed implementations include: **Greece, Macedonia, Finland, Netherlands, Iceland,**

² <https://patentepi.org/r/info-2304-12>
³ <https://patentepi.org/r/info-2304-13>

¹ And bookmark the web page
<https://www.epo.org/en/applying/myepo-services/file-with-us/cus>

Belgium, Luxembourg. Larger countries (e.g. DE, FR, GB) will be providing their own alternative. **epi** members will want to ensure their own national offices have Front Office or some other service established as soon as possible. We have been assured that **eOLF is safe until the end of 2024**, at least, but the pressure will come to turn it off soon enough.

Other systems

Various other IT systems are up for discussion. Improvements have been requested in the **Third Party Observations (TPO)** form and **Register Alert**.

We are pleased to see a wider range of **digital signatures on assignments** are proposed in the recent in proposals presented to SACEPO-WPR.

With EPPC colleagues in SACEPO-WPR we strongly resist rule changes to restrict TPO to 100% online-only.

Last notes

Thanks as always to the members outside of OCC who report to us the random issues they face with EPO IT systems. You can submit issues and information directly to the OCC Chair at occ@patentepi.org.

Report of the Diversity and Inclusion Working Group

M. Nevant (FR), Chair

In addition to monthly meetings, the D & I WG has undertaken the following activities since C94:

- 1.) Meeting with Board on 5 July 2023
- 2.) Analysis of the statistics provided in the 2023 EQE survey report. For the first time ever, the survey included D&I-related questions, provided by the D&I WG
- 3.) Writing of an article on the prerequisites to sit the future EQE, which was published in issue 3/23 of **epi** Information¹
- 4.) Preparation of proposed amendments to Rule 17 IPREE – sent to the ad hoc joint **epi**/EPO WG
- 5.) Nina Ferara and Olga Sirakova attended a webinar organized by WIPO with IP offices and innovation stakeholders on “the IP gender and diversity gaps in the Africa and Arab regions”. See Olga’s LinkedIn post²
- 6.) Nina Ferara and Marc Névant gave a presentation on “Fostering the Diversity and Inclusion in our European Patent profession” at the event organized by

epi on 13 October (“Half a century of EPC, 44 Years of EQE and opening a New Chapter”).

- 7.) Olga Sirakova attended a webinar organized by WIPO on “Closing the Gender Gap in IP. Women in the Creative Industries”. See Olga’s LinkedIn post³
- 8.) On the occasion of the United Nations World Day for Cultural Diversity for Dialogue and Development, Sally Bannan, Nina Ferara and John Gray were invited to the podcast “Two IPs In A Pod”, to discuss the cultural differences within Europe and how they are helping their colleagues to find a common understanding on EDI issues. The podcast can be listened to following this link⁴
- 9.) WG members individually engage with D&I activities in other IP associations

The policy on diversity and inclusion is available on **epi**’s website: <https://patentepi.org/r/di-policy>

- **epi** recognizes the benefits of diversity & inclusivity (D & I)
- **epi** commits to and aims for D & I in our policies, practices and stakeholder relationships
- Diversity of **epi** membership

¹ <https://patentepi.org/r/info-2304-14>

² <https://patentepi.org/r/info-2304-15>

³ <https://patentepi.org/r/info-2304-14>

⁴ <https://patentepi.org/r/info-2304-15>

A link to a video message of the members of the D&I WG was included in the accumulated file for C94. The video is available here (after logging in):

<https://patentepi.org/r/di-working-group>

As a reminder, the Diversity and Inclusion Working Group (D & I Working Group) was set up by the Board (B117) in September 201. At C92 in May 2022 the D & I policy was adopted by the Council.

At the Council Meeting C93 the decision was approved, that the Diversity and Inclusion Working Group continue its work until at least C94 in order to help providing materials to support **epi** members to best address and adapt the need of their clients and to propose actions to grow **epi**'s commitment to diversity and inclusion.



Marc Nevant

At B127, the Board decided to distribute the REE/IPREE drafts with the Presidium, PEC, SAC, the **epi** Legal Advisors and the D&I Working group to review the documents.

The D & I core values of **epi** are:

- Our Code of Conduct – article 5(b) – prohibits discrimination between members ((**epi** membership now spans 39 countries!))

“(b) Since a prime interest of the Institute is to maintain a unified profession, no member must exercise or promote discrimination between members, for example on grounds of language or nationality.”

- The Institute has a long standing position not to discriminate based on nationality, e.g.
 - EQE vs grandfathers
 - Existing vs new countries
 - Existing EQE vs new EQE
- Work to maintain equality of the three official languages in the laws and the EQE
- Scheduling Board and Council meetings, and educational events around the member states
- Providing additional support for EQE candidates from the “new countries”: CSP is by design a diverse and inclusive program
- Fighting for the right of parties to have in-person or ViCo oral Proceedings according to their preference

The next steps of the D&I Working group to go forward are:

For employers:

- Wider hiring pool
- Retention and Employee Satisfaction
- Professional Reputation and Credibility
- Business Results and Profitability
- Embrace globalization with a diverse workforce

For employees / colleagues

- Positive working environment
- Improved Teamwork and Collaboration
- Diverse perspectives foster creativity by bringing in unique ideas and approaches
- Career Growth and Advancement

For tutors:

- Better understanding of Tutee's needs and effective addressing
- Improved Relationship and Trust
- Enhanced Tutoring Methods and Tips
- Enhanced success rates in Learning

Other organisations / institutions have an interest in D & I matters

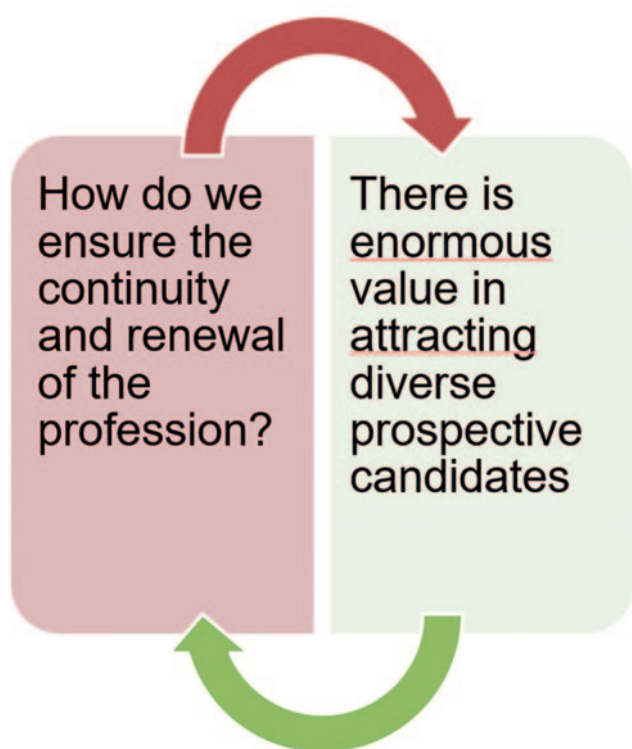
- AIPPI has set up this year a D&I Bureau Advisory Committee
- FICPI set up last year a Diversity, Equity, Inclusion & Accessibility Committee
- CNCPI (the French Association of Patent Attorneys) has set up this year a Diversity & Inclusion Committee
- This year's Nobel Prize in Economic Sciences was awarded to Claudia Goldin who provided the first comprehensive account of women's earnings and labour market participation through the centuries. Her research reveals the causes of change, as well as the main sources of the remaining gender gap.

Our Goals:

- Support and encourage working environments where current and future **epi** members can bring their whole selves to work, feel welcome and supported within the profession and are encouraged to bring in new ideas and ways of doing things to future-proof the role of European Patent Attorneys
- Engage with the various **epi** committees and bodies to communicate the D&I Policy and help them put it into effect in their daily activities

- Bring about change e.g. to our communication (inclusive language) and to diversity of our speakers (make sure D&I considered when looking into possible options)
- Encourage dialogue about different D&I issues that may affect members of the profession (discrimination, unconscious bias, microaggressions - e.g. seminars on different topics)
- Exchange with the EPO on broader topics (e.g. diversity among inventors)

D & In in the context of the EQE



- Providing input on revisions to REE and IPREE pertaining to D&I matters, with focus on reasonable adjustments (e.g. disabilities, maternity) and educational qualifications (for social inclusion)

- Supporting the implementation of reasonable adjustments for the EQE, including providing survey questions for candidates
- Working with relevant **epi** bodies to raise the profile of our profession, particularly within the student community across Europe

D & I WG calls to action!

- We invite Council, committee and **epi** members to familiarise themselves with the Policy and keep it in mind in all their work for **epi**
- We offer to give a short presentation on D&I to all newly elected Committees when they first meet after C96
- Talk to us, tell us about D&I topics related to your work, engage with our activities and help us make our profession more diverse and inclusive, and therefore fit for the future!
- The WG has been investigating how **epi** can support its members on the issues of diversity and inclusion
- We are aware that **epi** Committees already have a lot on their plates, e.g. informing **epi** members and defending **epi**'s positions vis-à-vis IP stakeholders
- We have come to the conclusion that implementing and upholding the unambiguous commitment from Council requires **a steady, permanent workforce, i.e. a permanent Committee** that can provide dedicated support across all Committees.

During C96 in Ljubljana Council agreed that the Diversity & Inclusion Working Group continue their work until at least the 2024 ordinary Spring Council meeting.

Communication on epi Subscription

Zs. Szentpéteri (HU), Treasurer, M. Augustyniak (PL), Secretary General

The financial operation of **epi** has faced significant challenges in recent years, yet we have been able to navigate through them with the help of our accumulated reserves. In 2022, as **epi**'s activities partially returned to normal level we faced a year-end loss of

approximately EUR 200k followed by an estimated loss for 2023 of around EUR 530k and - despite of a cautious budget planning - a projected loss of around 500k EUR for 2024.



Zs. Szentpéteri

While at the moment **epi** enjoys a comfortable position in terms of reserves, the continuation of losses at the current rate could modify this situation quickly and dramatically.

To restore **epi** finances to a sustainable break-even position, after in-depth discussions within the **epi** a proposal has been put forward during the C96 Council meeting and Council agreed to set the annual subscription for 2024 at EUR 250 with an increased annual subscription in case of a late payment of 50% of the annual subscription i.e. EUR

375. As a consequence, the studentship fee for 2024 is set at EUR 125. This adjustment was deemed necessary to address the current financial challenges and maintain our financial stability resulting in a more effective financial management and contributing to our progress.



M. Augustyniak

The subscription fee serves as the primary income of **epi** enabling the Institute to carry out its tasks and activities including for example, carrying out the EQE together with the European Patent Office; developing and organizing trainings, support of EQE candidates; developing and amending our Code of Conduct to reflect desired changes; dealing with disciplinary matters; representing the profession in official bodies such as the Administrative Council of the European Patent Organisation (EPOrg); drafting positions and papers on behalf of the profession, facilitating measures that assist our members to perform their profession, for example, a professional liability insurance specifically designed for **epi** members.

The time limit for the payment of the regular annual subscription is (a) 1st of April 2024 for members on the list on the 1st of January 2024; or (b) three months from the date of entry for members entered on the list after the 1st of January 2024. Members who fail to pay their regular annual subscription before expiry of the time limit mentioned in points a) and b) above have to pay the increased subscription fee of EUR 375 within five months from the said dates. In the absence of payment, **epi** will send you at least one reminder to the email or postal address of the member. If the subscription is finally not paid, the Treasurer will have to propose you for deletion from the list of Professional Representatives.

Should you have any questions or observations regarding the subscription for 2024, please direct your inquiries to info@patentepi.org.

Annual Subscription 2024

Zs. Szentpéteri (HU), Treasurer

In accordance with the decision of **epi** Council C96 on 11 November 2023, the amount for the **epi** annual subscription has been set at 250 EUR for 2024, if paid before 1 April 2024 and at 375 EUR if paid later.

The annual subscription for **epi** Students was set to be 125 EUR for 2024.

In order to minimize the workload in processing accurately and efficiently subscription payments, and independently of the transmitting way, please note that:

- Each payment should be clearly identified indicating invoice number and full name of the member.
- Unidentifiable payments bear to risk of being rejected.
- Invoices regarding the **epi** annual subscription 2024 will be sent by email around mid of January 2024.

Every member will receive an invoice, even if a direct debiting mandate from an EPO account has been provided to the **epi**.

In case of doubt and to avoid double payment, please get in touch with the **epi** Secretariat, to check whether a direct debiting mandate is valid for you.

The 2024 annual subscription can be settled as follows:

1. Direct Debiting Mandate

- By debiting an EPO deposit account on 25 February 2024
- The form to set up/amend/delete a direct debiting mandate can be found on the **epi** website (<https://patentepi.org/en/the-institute/annual-subscription.html>)
- In case a direct debiting mandate is set up with **epi**, kindly note the following:

The due annual subscription will be debited automatically from the EPO account on 5 February 2024. Please make sure that the EPO account has sufficient funds at that date. Any new direct debiting mandate or amendment/cancellation of a previous one must be received from the account holder at the **epi** Secretariat at latest by 15 February 2024. If you have any questions relating to the direct debiting mandate, please get in touch with the **epi** Secretariat (accounting@patentepi.org).

2. Bank Transfer

- By bank transfer in Euro (bank charges to be covered by payor)
- Please note that payment should be received on **epi**'s account by 31 March 2024

If payments are not made prior to 1 April 2023, the annual subscription is increased to an amount of 375 Euro.

Account holder: European Patent Institute
Bank Name: Deutsche Bank AG
BIC-SWIFT: DEUTDEMMXXX
IBAN No: DE49 7007 0010 0272 5505 00

3. Paypal

The link to the online payment tool can be found on our website (<https://patentepi.org/r/online-payment>).

4. Credit Card

- By credit card (Visa or Mastercard only)
- The link to the online payment tool can be found on our website (<https://patentepi.org/r/online-payment>)

For payments with American Express, please use PayPal.

In case you plan to withdraw from **epi** membership, please note that you may avoid the annual subscription 2024 if you submit a request to be deleted from the list until 1 April 2024 if you submit with the Legal Division of the EPO a request to be deleted from the list until 1 April 2024 (see <https://www.epo.org/applying/online-services/representatives/deletion.html>).

REMINDER: Option to update your annual subscription invoice address via our self-service functionality

Dear **epi** members,

As we are approaching the end of the year, we are starting to prepare for annual subscription invoices for 2024. You certainly have an interest that your **epi** annual subscription invoice will show the correct address and is sent to the proper e-mail address.

No action is required from your side at the moment if the address foreseen for your annual subscription invoice and your e-mail for the invoice to be sent to is correct. You may check your data in our new self-service area on the **epi** website in the member-restricted area "My Account".

<https://patentepi.org/en/epi/user/account>

In case you have provided us in the past with an invoicing address or specific e-mail address that differs from the data mentioned in the List of Professional Representatives pursuant to Art. 134 EPC, this provided address will be reflected in the self-service area and we will continue to use this address for invoicing. We nevertheless encourage you to double check your data in our new self-service area on the **epi** website in the member-restricted area "My Account".

In the self-service area, there is also a new possibility to update by yourself the address to be shown on your annual subscription invoice for 2024 and beyond as well as the specific email-address to which we will send your invoice in early January.

Therefore, you should act NOW, but latest until end of 2023, in particular:

1. If you wish that your annual subscription invoice reflects a different address from the address mentioned in the List of Professional Representatives pursuant to Art. 134 EPC

2. If you wish to have your annual subscription invoice sent to an e-mail address other than your e-mail lodged with the EPO for the List of Professional Representatives.

Please note that any final reminder for your annual **epi** subscription, if necessary, will still be sent to the postal address that you have provided to the EPO for the List of Professional Representatives.

You may also use this function if you would like, after having received an annual subscription invoice, e.g. in February, to have issued a corrected invoice with other address details. Please be advised however, that you need then to send an additional request for a corrected invoice per email to accounting@patentepi.org after having updated your contact details in the self-service area of the website.

Further down, you will find a more detailed description, how you may check and amend your invoice address and/or email address to receive the invoice in the new self-service area.

We are continuously trying to improve and optimize the annual subscription process and hope that you find this new feature useful.

Please contact the **epi** Secretariat under accounting@patentepi.org for any questions and myself under treasurer@patentepi.org with any suggestion or concern about the annual subscription process.

Kind Regards
Zs. Szentpéteri
The Treasurer

Detailed step-by-step description how to update the address of your epi annual subscription invoice and/or the email-address for receiving the invoice

- Logon to the **epi** website <https://patentepi.org/en/login> and you will be taken into the section "My Account".
- On the menu on the left-hand side, please choose "My Personal Data" and you will be taken to "My data overview".
- In this section, you can find your data as on the List of Professional Representatives before the European Patent Office. This data can only be updated by contacting the Legal and Unitary Patent Division of the EPO, e.g. by using EPO Form 52301/52301a
- Further down on the page, you will see the headline "Different invoice address for **epi** annual subscription".

Different invoice address for epi annual subscription

Please note that the absence of a different mailing and email address, **epi** will use by default your data in the list of professional representatives for the purpose of issuing the annual subscription invoice.

☐ If you wish to have the invoice issued to a different address, please tick the following box, and provide the necessary data below.

VAT no.

PO no.

EPO Account

Please use the form to set up/amend/delete a direct debiting mandate which can be found [here](#)

Click the tick box next to "If you wish to have the invoice issued to a different address, please tick the following box, and provide the necessary data below" and an additional section will open.

The site will expand, and you will be given the opportunity to enter your data and press submit at the bottom.

Different invoice address for epi annual subscription

Please note that the absence of a different mailing and email address, **epi** will use by default your data in the list of professional representatives for the purpose of issuing the annual subscription invoice.

☒ If you wish to have the invoice issued to a different address, please tick the following box, and provide the necessary data below.

Addressee *

Name 2

Addition

Street

Postcode POB / P.O. box

Postcode / City *

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Board Meetings

129th Board Meeting in Munich on 8 February 2024

Council Meetings

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

98th Council Meeting in Budapest (Hungary) on 16 November 2024

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