

Institut der beim Europäischen
Patentamt zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

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Editorial

T. Johnson (GB)

This issue sees the publication of an interview with the President of the EPO. Alison Brimelow was typically generous with her time and thoughts, as we hope readers will agree when they read the report of the interview. The topics were diverse, and her views characteristically *a point* on each one.

The interview was well timed in being just before the elections for Ms Brimelow's successor, *epi* interviews with the four candidates being posted on the Institute website. We commend a reading of them. They are, we feel, both instructive and informative as to the respective candidate's views. It will be common knowledge by now that the first round of voting did not produce an outright winner, so there will be a re-run in December. As an integral member of the European Patent Organisation by virtue of the Founding Regulation, the *epi* is in a sense

part of this election procedure, though the Institute has no vote in the AC.

There is a general perception that industry wants certainty as a result of its use of the patent system -valid patents of narrow scope rather than patents of broad scope, but perhaps of less certain validity? In such a climate, if such exists, it is perhaps a pity that the AC could not come to a decision in October. We shall all have to wait and see!

One of the four candidates may have a happy Xmas if a decision is arrived at in December. On that note we on the committee wish Ms Brimelow, the candidates, the AC, the members of the Office and all our members and colleagues a very happy Christmas and a healthy and prosperous New Year.

Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionssausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi Information* ist der 12. Februar 2010. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi Information* is 12th February 2010. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de *epi Information* est le 12 février 2010. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

epi interview with Alison Brimelow, President of the EPO

Kim Finnilä, *epi* President, interviewer

W. Holzer, Editorial Committee, interviewer

Terry Johnson, Editorial committee, interviewer-reporter

At our President, Kim Finnilä's suggestion, Ms. Brimelow was approached for an interview with the *epi*. We are gratified to report that she readily agreed to this, the interview taking place on 11th September, 2009 in her office in the Westsite Building. Before the meeting, Kim Finnilä in conjunction with the Editorial Committee of *epi* produced a list of topics for discussion, which list was sent to Ms. Brimelow in advance. The topics are set out below: –



1. Ms. Brimelow's views on patenting in general;
 - a) What is the use of patenting?
 - b) What is a „good“ patent?
2. Ms. Brimelow has initiated a number of reforms in the EPO;
 - a) which does she consider the major ones?
 - b) How does Ms. Brimelow see how they will be progressed?
3. What is the staff's view of the reforms?
4. Can Ms. Brimelow comment on the social partnership in practice?
5. Is there a need for International partnership, particularly outside the IP5?
6. How is the partnership with the EPN developing?
7. How does Ms. Brimelow see the relationship of the EPO with the profession?

At the interview, Ms. Brimelow was accompanied by Eugen Stohr and Rainer Osterwalder.

For the *epi*, Kim Finnilä was accompanied by Walter Holzer and Terry Johnson (rapporteur).

The interview took the form of a wide-ranging discussion, based on the topics listed above, which acted as guidelines for the discussion.

The interview took place at the end of a very busy week for Ms. Brimelow, during which she seemed to be in a different MS country each day.

With regard to the first topic, we were informed that Ms. Brimelow has no doubt at all that the patent system is essential for the effective functioning of innovation and in providing a competitive economy. She quoted with approval Abraham Lincoln: „The patent system added the fuel of interest to the fire of genius, in the discovery and production of new and useful things.“

The patent system was a driver for both legal and technical development, the downside was that the system could have an anti-competitive effect, particularly

where there is a significant backlog of cases undergoing examination in Patent Offices, and where there is duplication of work in different Patent Offices. Ms. Brimelow had been ten years on the AC before becoming President, and timelines of examination had been an issue throughout at least that period. The backlog, often caused by duplication of effort, created uncertainty for industry. Madam President expressed herself therefore strongly in favour of the initiatives taken by IP5, particularly regarding the Foundation Projects, which aimed to provide basic building blocks for a patent system without duplication of effort in Patent Offices.

Asked about the EPO/EU relationship, we were informed that Ms. Brimelow spent one day a month on average meeting with the Commission and others in Brussels. The relationship was that of partners engaging in an open dialogue.

As part of the system, Ms. Brimelow is very much in favour of the EPN, NPOs should be able to provide more guidance to SME's, universities, individuals etc. in their own language, locally. The EPO would assist with technical and best practice advice.

Ms. Brimelow agreed that a qualified, quality local profession of patent attorneys was also needed in each MS. Advice given locally should cover the whole range of IP, not just patents: „Trade Marks sometimes can be more important than patents!“.

Turning to her major reforms, in no order of importance, Ms. Brimelow noted;

- a) Addressing the sustainable financing of the Office under IFRS rules.
- b) IP5, which was designed to change how the patent system works, and to work with change, not against it; and
- c) developing a social partnership with the staff.

On the last topic, Ms. Brimelow was clear that there was need for change. She acknowledged that working in an international organisation such as the EPO, with employees from many cultures and backgrounds and in what as an Examiner was a solitary occupation, caused understandable stresses and strains. However, the seemingly entrenched culture of confrontation, and other expressions of unrest had to change, and she was confident that the dialogue she had initiated between the staff and management would bear fruit and the management was learning to develop the relationship and manage a multi-national way of doing things. The current staff pension situation is a (big) case in point, the MS having given up their historical tax rebates paid to staff,

the EPO now has to pay, and to budget accordingly, but the staff must play their part.

Ms. Brimelow is actively working on the progress of these issues, and hopes to leave in place for her successor a sound basis and a clear way forward.

In that regard, Ms. Brimelow is proud of her management team, which is very supportive. This in turn has meant that the AC, whilst having its own Chairman, can clear away some „house-keeping“ questions and therefore devote more time to discussion of issues important to the Office and IP in general, for example the strategies to be employed in developing the IP system globally, and, for the EPO, a New Budget Dynamic, based on IFRS.

The time allotted being nearly expired, and no further processing being possible, Ms. Brimelow was asked about the relationship of the Office with the profession. Ms. Brimelow welcomed the Office's, and her, interaction with the *epi*. She acknowledged that there was room for improvement, and thought the Office was getting better at managing the relationship. She, and the Office, recognised that there were several stakeholders to consider, the *epi* however being „pretty much on top of the list“.

The governance of the Office via the MS and AC made it difficult for the *epi*, or other stakeholders to be given even a limited vote in AC meetings, but she was encouraged by the recent SACEPO meeting, at which the *epi* was strongly represented, and which had discussed important issues in depth.

From the *epi* side, it was suggested that some Examiners did not understand the role of the attorney, and seemed to have a prejudice against them. To be constructive, *epi* suggested that a Seminar might be held with the Examining Body to explain our role as part of the European Patent Organisation. Ms. Brimelow thought this a good idea, and herself suggested that following on from this interview, the *epi* should also arrange interviews with the Vice-Presidents and Heads of DGs in the Office.

A very constructive and helpful meeting, for which we are indebted to Ms. Brimelow for giving her time, and for her frankness in responding to our topics.

Terry Johnson
Editorial Committee, Rapporteur

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
1/2010	12 February	30 March
2/2010	12 May	30 June
3/2010	13 August	30 September
4/2010	3 November	30 December

Report of the 67th Council meeting, Düsseldorf, 10th October 2009

W. Holzer (AT)
Editorial Committee

The President, Mr. Finnilä, opened the meeting on October 10, 2009, reporting on the successful recruitment of an Office Manager for the Secretariat, Ms. Heike Ortlepp. On the sad side the President reported on the forthcoming retirement of Mr. Eder as Chair of the By-laws Committee at the end of 2009. Mr. Finnilä thanked Mr. Eder for having been the backbone of the *epi* since the beginning of the organisation which was ratified by Switzerland as the first country. Carl Eder was instrumental in the establishment and amendment of the By-laws. All Presidents of the *epi* have profited from the interventions of Mr. Eder to remain within the By-laws in the various Council debates. The Council will miss Mr. Eder and his activity. The Council gave Mr. Eder a standing ovation and Mr. Casalonga added a special thanks.

Following the appointment of the scrutineers the previously circulated provisional agenda was adopted as well as the minutes of the 66th Council meeting. The Secretary General, Mr. Maué, then gave his report, welcoming first of all a new Maltese Council member, Mr. Sansone. He then introduced the new Office manager, Ms. Ortlepp, and went on to report on the new premises of the Secretariat.

Mr. Maué also explained the decisions taken at the last Council meeting and the actions taken based thereon. Mr. Leyder pointed out that the By-laws Committee should be enlarged in order to deal with all language issues involved in the drafting of the By-laws and the collection of the decisions. The matter will be taken up at the next Council meeting. Mr. Holzer remarked that the By-laws Committee has a native speaker in each of the three official languages.

The Treasurer, Mr. Quintelier, presented his report, proposing that the annual subscription should remain at EUR 160.–. Mr. Jason remarked for the *epi* Finance Committee that the Committee should be involved in the signing of long term agreements, such as for example the new rent agreement for the Secretariat. The Treasurer reported that the one day Council meeting had resulted in substantial savings for the budget. The financial crisis has not affected the *epi* finances. The *epi* has 9200 members at present. As the new Secretariat does not provide a big meeting room, other premises will have to be found in Munich. The Extranet will need updating, which will incur additional costs. This however, as was pointed out by the Treasurer, can easily be met within the present budget postings, such as maintenance and repair, computer costs and others.

Mr. Nuss asked about the educational expenses. The main costs and investment of the *epi*, as pointed out by the Treasurer, are for the train-the-trainers programmes, in particular for the new and smaller countries. Mr.

Schweinzer reported that the number of seminars in 2010 will not increase dramatically. The question is also whether continued professional education will become mandatory. Mr. Hammer Jensen pointed out that continued professional education should be paid for by the profession. Mr. Finnilä requested a more „transparent“ budget, not simply figures.

The Council then voted on the annual subscription of EUR 160.– and approved it by a large majority.

Council also approved the accounts and the budget presented by the Treasurer.

The election of a new member for the By-laws Committee (and the size of the Committee) was another point of discussion. Mr. Steiling remarked that the Committee works well with four persons. Mr. Eder requested not to change the current composition of the Committee. The President gave his proposal for the By-laws Committee. The normal election of a By-laws Committee member will take place at the next Council meeting. Mr. Eder agreed to act *ad interim* until then.

The President reported on the Presidium activities as shown in his official written report. Mr. Lyndon-Stanford asked about the drafting of a „Manual of Best Practice“ for applicants and for examiners by the EPO and the possible participation of the *epi* (by Ms. Modiano, Mr. Tangena). Mr. Mercer suggested that the *epi* should cooperate. Mr. Rosenich mentioned that a disciplinary complaint was filed by a member of the EPO for the first time. The EPPC formally was not in favour of the manual. Mr. Leyder said that the new EPPC has not yet discussed it.

Mr. Nuss then asked about an oral report by the President, and Mr. Finnilä provided a short summary.

The President then opened a discussion about non-attendance and translation requests at oral proceedings and the problems caused thereby. The *epi* had promised to the Boards of Appeal (BoA) (MSBA) to look at possible remedies, and a respective Recommendation to *epi* members had been prepared. Mr. Mercer explained the problem. The Council discussed as to whether translation should be paid for by the parties and which kind of pressure, if any, could be put on the representatives. Mr. Boff explained that the BoA should give an early indication of what is going on in each case. There are also short time cancellations by the BoA. The BoA oral proceedings should be managed in a better way. It turned out that the matter is two-fold, one point being the non-attendance, the other being costs of translation. Mr. Eder presented a motion to refer the matter to the Conduct Committee. Mr. Mercer asked for a vote on the Recommendation first. The question was discussed whether the Code of Conduct needs amendment in this regard. The wording of the Recommendation was dis-

cussed. The Recommendation was then approved by a large majority of Council members.

The Council further discussed Continued Professional Education (CPE), in particular as to whether it should become mandatory and which seminars and subject matters it should comprise. In the opinion of the PQC it should become mandatory. Mr. Gowshall explained that only the principles should be discussed. He explained that the system works well in the UK (16 hours a year). Mr. Nuss was in favour, however, he said that CPE should not be mandatory. A number of other speakers

argued in favour on non-mandatory CPE. The Council then voted against a mandatory CPE.

Mr. Boff reported on the EPO finances and the budgetary situation. He said that the appeals backlog had increased (pendency 4 years), that the financial income has dropped by 1/3 and that there would be a 5 % fee increase in 2010.

At the end of the meeting the Council approved the date of the next 68th meeting which will take place in Dublin on Saturday 24th April 2010. The President thanked all participants for their attendance and contributions and closed the meeting.

Treasurer's report

C. Quintelier (BE)

1. Situation on June 30, 2009

1.1 Income

In particular due to the good results of the 2008 EQE the total number of *epi* members increased with respect to the figures on June 30, 2008. This compensates for the increase in deleted members (130 in 2008, 152 in 2009). The percentage of members who did not pay their contribution showed a small decrease this year (3.8 % in 2008, 3.6 % in 2009). Altogether this leads to an increase on income originating from the contribution fee.

The interest income on short term investment reflects the actual low interest rate. The low total amount on interest income on investment of more than one year is normal, as most of the investment have an interest payment date in the second half of the year.

The income relating to education originates from the Istanbul CPE seminar and the Mock EQE of September 2009, as well as from the other usual educational activities (tutors, *epi*/CEIPI litigation course).

1.2 Expenses

The one day *epi* Council meeting showed its expected effect on costs saving. Approximately a 38 % saving was realized when compared to a one and a half day meeting. The biggest saving was realized on hotel and conference room costs, as only two nights and one day conference room was necessary. As only one Board meeting and one Presidium meeting took place in the first half of 2009, the expenses reflect this.

On the side of the Committees less meetings took place leading to less costs.

Notwithstanding the intervention of a lawyer, the institute had to pay the landlord of the premises at Tal 29 in Munich a substantial increase in the rent. The costs of personnel at the *epi* secretariat decreased as a.o. no

students are employed any more. The costs on office supplies increased to the acquisition of some new office material. The amount under promotional activity is caused mainly by the art exhibition and the *epi* trademark renewal.

The costs on education are partially due to payments for seminars, which took place in 2008.

1.3 Budget 2010

The annual contribution can remain at the same amount of 160 €. As it looks like the interest will remain low in 2010, the income from interest will be less than in the past.

As several seminars given by the trained trainers should be organized in 2010 and as some other education projects are planned, an income on seminars of 200 000 is estimated. However as some support will have to be given in particular on the trainers' expenses on education are estimated at 250 000 €. This signifies an investment of 50 000 € on education.

The posting Council meeting is budgeted on 210 000 € in view of the experience of this year and the fact that the one day meeting principle is maintained in 2010. In view of the increased number of committee members the committee posting has been increased somewhat.

As the new *epi* premises do not have a conference room for the larger committees, an additional posting called conference room (4.1.2) has been added and budgeted at 15 000 €. As in 2010 the preparation for the election will take place, the posting for postage was somewhat increased. Moreover as some new computers will have to be bought, the post office supply and computer costs were increased.

The Office manager budget (post 4.13) has been set on 75 000 €.

Report of the Disciplinary Committee – Autumn 2009

Paul Rosenich (LI)
Chairman

The number of cases in 2009 has not grown so quickly as in 2008.

Nevertheless, the content and complexity of the cases is very demanding and time consuming.

One case of 2007 could only be completed in June this year. The Chairman of this Committee and the President have discussed the problems surrounding this case and its course and have decided to put this on the agenda of the Disciplinary Committee for reviewing the procedure.

The Disciplinary Committee further requests (again) that all Member States nominate one member for the Disciplinary Committee, who should be willing and able to work in a Chamber.

In some cases it seems that Complainers believe that the proceedings before our Chambers are similar to a Civil Court procedure, with parties presenting their cases on an equal basis before a judicial body. However, the *epi* system is different and Complainers do not become „parties to the proceedings“. Of course they are sometimes invited by the Rapporteur – if necessary – to assist in the work of the responsible Chamber, but this only with discretion (and under the autonomous lead of) the

Chamber. The right of filing requests (or the like) is very limited, compared to civil procedures. These limitations include in particular the right of the Complainers to discuss the cases with members of the Chamber or with the Registrar of DC or with its Chairman.

The Disciplinary Committee has postponed its scheduled meeting from Autumn this year, to Spring next year.

The Disciplinary Committee reminds all Colleagues of their duties under the code of conduct. It seems of utmost importance that all members of *epi* conduct themselves with respect for any other member of this institute, and so avoid a situation which could bring a member of this institute into discredit.

Regarding the latest publication about disciplinary cases in *epi* news 03/09 the Chairman received a question which triggers the following advice: The Chambers of Disciplinary Committee may look into cases where *epi* candidates did insufficient work thereby harming a client's interest. The responsible supervising member(s) of *epi* might have to take disciplinary consequences in such cases.

Report on the EPO/epi Biotech Committee Meeting 21st November 2008

A. De Clercq (BE)
Chairwoman

In Attendance:

Maria Fotaki (MF, dir. 2405, Munich)
Reinhard Hermann (RH, dir. 2402, Munich)
Bernd Isert (BI, dir. 2404, Munich)
Uli Thiele (UT, dir. 2403, Munich)
Siobhán Yeats (SY, dir. 2406, Munich)
Victor Kaas (VK, dir. 2401, Munich)
Enrique Molina Galan (EMG, dir. 1212, The Hague)
Sjoerd Hoekstra (SJH, dir. 1223, The Hague)

Ann De Clercq (AdC) – BE
Dieter Wächter (DW) – CH
Gunther Keller (GK) – DE
Bo Hammer Jensen (BHJ) – DK

Anne Desaix (AD) – FR
Arpad Petho (AP) – HU
Simon Wright (SW) – GB
Gabriela Staub (GS) – IT
Dieter Wachter (DW) – CH
Lars Høglund (LH) – SE
Hans-Rainer Jaenichen (DE) – HRJ
Gabriele Leissler-Gerstl (GLG, liaison member of EPPC)

Introduction

1. Stem cells/WARF (G2/06)

The decision was, at the time of the meeting imminent (in fact it issued late November). The *epi* asked about suitable disclaimers to deal with the issue; however, the

EPO opined that examiners should not usually ask for a disclaimer, especially as it was not clear what matter should be excluded.

No cases are being stayed of the EPO's own motion in view of the WARF case, and indeed the general policy now is not to stay cases routinely. The EPO may, though, stay a case at the applicant's request, if Article 53(a) EPC is the only issue remaining.

2. *Essentially Biological Processes (G 2/07)*

This decision will take a while; it will be decided after G2/06 and the diagnostics cases.

Lots of amicus briefs have been filed. Greenpeace organised a march to the EPO with cows and tractors. Political bodies also attended. They argued that the EPO should only allow patents on GM plants, not 'natural' plants. There is a standard letter doing the rounds, many copies of which were sent to EU politicians. It is now a political hot potato, and generating a lot of interest (which was unexpected). Amicus briefs from CIPA, *epi* and seed companies had been filed (but were not always in agreement, especially when dealing with the amount of human intervention).

RH mentioned that the winner of a recent Bavarian election had used the slogan '*No genes in tomatoes*'. (In a survey, allegedly 80 % of the public were against GM crops). All agreed about the need for better education of the public, although this is not something the EPO can easily do actively (for fear of being accused of bias).

3. *Rule 71(3) procedure*

The *epi* is still experiencing some examiners amending the description in the Rule 71(3) without the applicant's consent. Some examiners telephone first, which is to be encouraged. Whatever the mode of communication, attorneys would rather have a phone call or communication first, before the changes are made. Often what an examiner thinks is 'minor' change may not be. The *epi* mentioned a case of an examiner making whole-sale amendments even when no amendments were explicitly requested. In general, examiners are requested by the *epi* only to make changes if the attorney has agreed to them first. Examiners, though, say that it can take 2-3 week for an attorney to get back to them on suggested changes. A faster response is usually received from in-house attorneys. RH said that if we have real problems we can contact him.

BHJ remarked that examiners should only make amendments of their own accord to correct typographical errors. Examiners say that attorneys can delay in responding; perhaps attorneys could tell the examiners if they are still awaiting instructions. The *epi* is to provide examples of problems to the directors.

4. *Non-Unity objections*

GLG considered that a very high proportion of cases lack unity. SJH said there had been no change in training; the only change under EPC 2000 was that boards of appeal do not now decide on protests. RH commented that board of appeal case law forces the EPO to examine the

first invention, so the EPO sticks to this rigidly (e.g. if disease states are listed alphabetically in a claim).

In the PCT the Rules now refer to the 'main' invention, so examiners have a little more flexibility here. The *epi* said that examiners tend to take a formal, rather than common sense, approach. The EPO's advice is to make sure you place the most important invention first.

5. *Summons to Oral Proceedings*

RH said the EPO were considering internal guidelines on this issue (a checklist) but this was not yet in force. SW complained about new objections being raised, but the EPO argued that this was acceptable if the amendments made were not allowable (e.g. if they add matter). MF pointed out that some attorneys are happy to receive summons to oral proceedings to show their clients that the EPO is getting serious.

The EPO's practice is to consider (and give a decision) on all requests filed before the Rule 71a cut-off, even when the client doesn't attend, or withdraws his request for oral proceedings.

BI said that some parties request an interpreter in advance, but at the oral proceedings didn't need them. The interpreters are brought in from outside the EPO and cannot be cancelled late. Unnecessary interpreters cost the EPO about 460,000€ in 2008. The EPO would ideally like three weeks', but at least one week's notice if an interpreter will not be needed. The *epi* thought this was not unreasonable. In future, Formalities Officers may contact parties in advance to check if interpreters are really needed.

The *epi* suggested that examiners should not cancel oral proceedings only a day or so before hearings, as this was very short notice. According to the EPO, examiners are encouraged to meet, and make a decision, well in advance of the hearing date.

6. *Rule 30 EPC 2000*

The *epi* said that some Formalities Officers are interpreting this rigidly, e.g. a small mistake in the listing, or not using Latin. They are not using their discretion. The PCT procedure seems to be more liberal and convenient. The *epi* was encouraged to send directors a list of examples where we have been asked to change/amend the sequence (and pay a fee) for only minor matters. An examiners' group may look at practice in this area, in a workshop, to see what is happening and how it is implemented. Attorneys are encouraged to telephone Formalities Officers about alleged defects.

7. *Divisionals practice*

There will be new proposals from the EPO (since implemented). Abuse is seen as a filing divisional for exactly the same subject matter as in the parent case.

8. *Article 124 and requests for prior art*

SW said his firm had seen different approaches between different clusters. RH said biotech clusters were not keen, and routinely do not ask for these documents. Certain technical areas may have CN, KR etc. documentation which cannot easily be translated (this is less likely

in biotech as most documents are in English). Examiners often get prior art documents from the US Patent and Trademark Office anyway.

9. PPH (Patent Prosecution Highway)

The EPO said that no PPH's had yet been filed in the biotech cluster. It was often better to use the PCT route; the only potential benefit is to get fast grant in Japan.

10. Fee Increases and Claims Fees

The reasons for increases in fees were discussed (IFRS accounting standards, etc). The *epi* all agreed that the fee increases were unpopular, and possibly counter-productive. Applicants may even consider filing nationally instead.

11. Raising the Bar Initiative (and Proposed New Rules 62a, 70a, 137(4)EPC)

The *epi* was positive about Rule 63, and the idea of the Examiner contacting the attorney to obtain clarification on what to search. All other proposals were generally seen as being harsh and unpopular. The timelines for responding to the EESR are unrealistically short. There may be problems over Rule 137 as the meaning of 'clearly identify' could be interpreted very restrictively. BI said this requirement will be checked by Formalities Officers. This is only a first package of measures. A second round may include:

- Third party requests for examination
- Greater use of A115 (3rd party observations)
- Auxiliary Request (limited to a certain number during examination)
- Review of Rule 71(3) procedure.

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE)
Chairman

This report covers the period since my previous report dated 17 May 2009.

Referrals to the Enlarged Board of Appeal

Third parties have the opportunity to file written statements (*amicus curiae* briefs) in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, see <http://www.epo.org/patents/appeals/pending.html>

1. G1/09 – New referral – Pending application:

The question referred to the Enlarged Board has only lately aroused interest, including outside the EPPC. The committee will thus consider the matter: a member of the committee has proposed a preliminary draft, and comments have independently been received from an *epi* member.

2. G4/08 – Referral – Language of the proceedings:

In addition to the *amicus curiae* brief of the *epi*, only one other brief has been filed in which Aropi (Association romande de propriété intellectuelle) advocates against the need or interest of allowing filing a translation. Oral proceedings have been summoned for 16 November 2009.

3. G2/08 – Referral – Dosage regimen:

A total of 13 *amicus curiae* briefs have been filed, including the one of *epi*. Oral proceedings have been summoned for 5 November 2009.

Liaison Sub-Committee

4. Partnership for Quality (PfQ)

A meeting was held on 18 May 2009. The meeting focused on statistics and their interpretation, as well as on quality management.

Statistics, surveys and the evaluation of complaints are seen as tools to observe trends, to highlight areas for action, to contribute to professionalism and to preventive and corrective actions. It was found that there are more complaints in PCT proceedings than in EP proceedings.

In the evaluation it was found that consistency has the highest impact on user satisfaction, and that many users have raised lack of consistency. The influence of third party observations on the examination result was analysed and it was found to substantially increase the percentage of refusals. In general, the refusal rate is increasing.

Inconsistency of examination has been identified as a problem and measures for harmonisation have been introduced.

The larger projects of drafting a Manual of Best Practice and drafting new Guidelines are delayed because of not enough resources. *epi* will be invited to add topics to the list that will be provided by the EPO and that should be addressed in the Manual.

5. Manual of Best Practice

After the PfQ meeting, the EPO expressed the wish to set up a Working Group on the „Manual of Best Practice“. Our President has nominated Ms. Modiano and Mr Tangena as *epi* delegates, and the EPPC will advise them as provided by its Terms of Reference.

6. Notice of the EPO relating to R.79

The Office's interpretation of Rule 79, as reflected in the Notice dated 3 June 2009 published in the Official Journal 7/2009 at page 434, has attracted the committee's attention. The Council has approved the principle of sending a letter to the EPO.

PCT Sub-Committee

7. PCT Working Group

The PCT Working Group has met in Geneva from 4 to 8 May 2009. All working documents, including a draft report prepared by the Group secretariat, are available from the WIPO website: http://www.wipo.int/meetings/en/details.jsp?meeting_id=17449

The meeting considered a comprehensive plan with actions to be realised until 2012 for improving the PCT system. Other items of particular interest in the agenda are proposals for enhancing the value of the International Search and the International Preliminary Examination, the Supplementary Searches, and the International Form for National Phase Entry.

8. PCT Assembly

The PCT Assembly is one of the 20 Assemblies of Member States of WIPO that have taken place in Geneva from 22 September to 1 October. *epi* is traditionally not attending the WIPO Assemblies. All documents are available from the WIPO website: http://www.wipo.int/meetings/en/details.jsp?meeting_id=17449 including

- the report of the 2nd session of the PCT working group;
- amendments to the PCT;
- quality management systems for PCT international authorities;
- appointment of EG and IL as ISA and IPEA.

Community Patent Sub-Committee

9. Community Patent Regulation

The President has asked the EPPC to consider the latest proposals in order to possibly draft a paper for adoption as the *epi* position. This will be entrusted to the Community Patent Sub-Committee.

EPC Sub-Committee

10. SACEPO/WPR2 and CPL37

On 20-21 July, the Committee on Patent Law gave an opinion on:

- amendments to the Implementing Regulations resulting from a first stage implementation of the European Patent Network (EPN): new R. 70b and amended R. 141, implementing Art. 124 [favourable];
- amendments to the Implementing Regulations resulting from the introduction of Supplementary International Searches (SIS) in the international phase [favourable];
- deferral of examination [no support for deferral of searches; dominant desire to obtain more information about the consequences of a deferral of the substantive examination; referral to the Budget and Finance Committee].

These topics had previously been discussed in a meeting of the SACEPO/Working Party on Rules on 5 June.

11. SACEPO/WPR3 and CPL38

The next meeting of the Committee on Patent Law, initially planned for 23-24 November, has been postponed to February 2010. At the time of drafting this report, the only agenda item appeared to be a document prepared by the EPO and providing, for information, „an overview of the EPO's efforts aimed at enhancing procedural efficiency and quality and at establishing a compact examination procedure“.

Guidelines Sub-Committee

12. Revision of the Guidelines

The Guidelines Sub-Committee met on 28 July to discuss the most important comments previously made by its members. As a result, a long and detailed list of comments will be sent to the EPO in preparation of the next meeting of the SACEPO/WPG.

13. SACEPO/WPG1 meeting

The WP held its first meeting on 14 September. The sub-committee had thoroughly prepared the meeting, by e-mail and during a one-day meeting, setting up two lists – a blue list (45 comments/suggestions) with comments/suggestions expected to be acceptable to the EPO without requiring a discussion and a green list (45 comments/suggestions) of comments/suggestions which in our view were more important. The list of comments was circulated in advance of the meeting with the request to EPO that the *epi* preferred to concentrate the discussions to the green list.

During the meeting, the discussion could thus concentrate on the most contentious issues relating to Rules 36(1), 63, 64 and 137(5) as well as the reliability of dates on internet sites, the burden of proof, the removal of unsearched matter from the application, the possibility of filing a divisional from a PCT designating EPO, and the meaning of the expression „meaningful search“.

The EPO has indicated that they intend to revise the Guidelines on an annual basis.

Miscellaneous

14. EUROTAB

EUROTAB (European Round Table) is a meeting where national patent offices of the Contracting States of the EPC and the European Patent Office come together to discuss differences in practice and see whether a harmonized approach is possible.

Four subjects were discussed at the 18th meeting held on 7-8 May:

- How to improve the quality of incoming applications, especially with regard to the so-called „complex applications“.
- Increasing the efficiency and quality of the search procedure: discussion in the context of the work sharing between Offices of first and second filing.
- Disclosure of the invention: discussing the effect on the public of the uncertainty created by the possibilities to amend the claims.
- The question of absolute substance protection in the field of chemistry: no consensus.

15. Labelled members of EPPC

Ms Skeppstedt has tendered her resignation as Secretary and as Vice-Chairman of the EPPC, in charge of the Community Patent Sub-Committee. Ms Skeppstedt has been the Secretary of the EPPC for over 4 years now, and her work was highly valued by my predecessor and myself. I and my predecessor wish to thank her for devoting time and efforts to that function, and for always being willing to taking more responsibilities.

Mr. Lampe, Deputy Secretary, has kindly accepted to take over the duties of the Secretary, and I thank him.

16. Future EPPC meetings

The next EPPC meeting is being planned for January 2010. In the meantime, meetings of sub-committees and *ad hoc* groups are planned.

I have informed the Presidium of my plans to organise in 2010 three meetings of the committee and four meetings of sub-committees and *ad hoc* groups.

Report of the Litigation Committee October 2009

E. Lyndon-Stanford (GB)
Chairman

The draft Agreement on the European and Community Patents Court (ECPC) and Court Statute, previously known as the Unified Patent Litigation System (UPLS)

The draft Agreement is set out in working document 7928/09, dated 23rd March 2009. Two further working documents 13705/09, dated 29th September 2009, and 14040/09, dated 16th October 2009, have issued, 14040/09 superseding 13705/09. 14040/09 alters a number of the provisions of 7928/09.

The present draft Agreement covers the whole European Community and besides is open to ratification by any Contracting State of the EPC, who would have to bring into force the laws, regulations and administrative provisions necessary to comply with Community law relating to substantive patent law.

The draft provides a Court of First Instance and a Court of Appeal. The Court of First Instance will have a central division (which will have a single seat but need not sit in one location), local divisions and regional divisions. A local division can be set up in any of the Contracting States of the Agreement, on request by the State concerned. A regional division can be set up by two or more Contracting

States. There will be a single Court of Appeal. There is provision for referral to the ECJ on questions of interpretation of the European Community Treaty or acts of the institutions of the European Community.

In general, there will be panels of three judges in the Court of First Instance though at present there is provision for a single judge, if the parties agree. The three-membered panels will be multi-national in the sense that there will be at least two nationalities. In the local divisions, if there are fewer than fifty cases per calendar year, one of the judges will be a national of the hosting state and the other judges will come from a pool of judges – if there are more cases per year, two of the judges will be nationals of the hosting state. In the regional divisions, two judges will come from the region and the third from the pool. None of the judges in the local and regional divisions need be technically qualified, but an additional technical judge will be required if there is a counterclaim for revocation or on request by one of the parties (14040/09, #11). In the central division, two of the judges will be legally qualified and one technically qualified. In the Court of Appeal, three of the judges will be legally qualified and two technically qualified.

An infringement action or an action for a declaration of non-infringement must be taken (i) before the local or regional division of the actual or threatened infringement, or (ii) before the local or regional or local division where the defendant is domiciled (if domiciled in one of the Participating States), or (iii) in the central division if there is no local or regional division, or (iv), by agreement between the parties, in any of the first division courts.

Independent revocation actions must be taken before the central division. A counterclaim for revocation must be filed at the court seized of the infringement action, but the court or the parties can decide to refer the counterclaim to the central division. Thus bifurcation or split jurisdiction is possible though not mandatory.

The language of the local divisions will be the local language whilst the language of the regional divisions will be a language of one of the hosting states or one of languages designated by the regional divisions. However states may designate for their local court proceedings one or more of the EPO official languages or the parties may agree the language of grant, subject to approval by the court, or the court may decide on the language of grant after having heard the parties. The language of the central division is the language of grant. The language of the Court of Appeal is the language of the proceedings before the Court of First Instance unless the parties agree to use the language of grant or unless the Court and the parties agree on a different local language.

The paper 14040/09 contains a proposal that after seven years and after approximately 2000 cases have been decided, and if necessary at regular intervals thereafter, certain provisions can be altered, one being the composition of local and regional panels and the other being the split jurisdiction.

Article 28 of 7928/09 is of particular interest to EPA's, containing the representation provisions, namely representation by lawyers or alternatively by EPA's with an appropriate extra qualification, and also the right of patent attorneys in general to assist and speak in court. The question of representation is important for European Patent Attorneys and the Board will consider how we can obtain general government approval for the present text.

The EU Competitiveness Council considered it appropriate to request the opinion of the ECJ on the compatibility of the envisaged Agreement with the EC Treaty before taking further steps towards the negotiations with third countries, and to determine whether the EC had the power to enter into the Agreement. The draft Agreement was referred to the European Court of Justice on 18th June 2009, accompanied by Council Legal Service paper 11125/09, which has a restricted circulation.

In a formal sense, the draft Agreement as set out in paper 7929/09 will not be amended until the ECJ hands down its opinion, which is expected some time in the first six months of 2010.

It is reported that the current Swedish Presidency of the EU hopes to achieve a political agreement at the EU Competitiveness Council meeting of 3rd and 4th December. The documents 7928/09 and 14040/09 would

form the basis of the agreement. There are ongoing discussions with the Presidency, states have been invited to respond to paper 14040/09, and there will be further meetings in November and a meeting of the Competitiveness Council on 3rd and 4th December. It is believed that if there is agreement in the Competitiveness Council on 7928/09 and 14040/09, that agreement will be treated as a commitment and will not be later reversed.

The *epi* has already approved two papers, one on representation and one on an earlier version of the draft Agreement. The Litigation Committee has made initial comments on the present draft Agreement. These comments will be debated in a meeting of the Litigation Committee in order to prepare a draft *epi* response. The response will be presented to the Board meeting of 13th February 2010 for decisions on the details of the Agreement, and possibly will be presented to the Council meeting of 24th April 2010 for a decision on the overall acceptability of the Agreement.

Some comments on the text of the Agreement were made in *epi* Information 2/09, and they still stand though the two further working documents have (among other provisions) reduced the length of the transitional period to five years (rather than seven years).

The proposed Community Patent, Enhanced Partnership and amendment of the EPC

Proposals have been made for the amendment of the proposed Council Regulation on the Community Patent, for an Enhanced Partnership between Patent Offices under the Community Patent (European standard for searching) and for the amendment of the EPC to accommodate the Community Patent. These are referred to in the EPPC report.

The UPLS (or ECPC) draft Rules of Procedure

Following an earlier paper, working document 11813/09 has set out Rules of Procedure for the First Instance Courts. Following this, paper 11845/09 set out a list of „points for discussion“ by the member states, which have already been answered. One of the states has expressed the view that it is too early to discuss details of the court procedures. However difficulties with the draft Rules of Procedure could cause reconsideration of some minor provisions of the draft Agreement. In addition, the specific Rules of Procedure will determine whether the new system is to function in a quick and relatively inexpensive manner. The Litigation Committee will study the Rules of Procedure in the coming three months and report to the Board.

The UPLS (or ECPC) practice directions

These will be proposed at a later date and are not available for comment.

Report of the EPO Finances Committee

J. Boff (GB)
Chairman

This report summarises the Budget and Finance Committee meeting of 5th-7th October 2009.

Deferred Examination

A paper had been produced by the EPO looking at the financial implications of adopting a deferred examination system. Some delegations were in favour of such an approach, many were against. On the financial aspects many seemed concerned by the suggestion that deferred examination would lead to a decline in income for national offices and the EPO.

epi questioned the assumption that deferred examination would lead to lowered income for EPO and member states. This is not self evident – if deferred examination leads to better handling of the backlog, this could lead to more granted patents, granted earlier in their life, and for those to be cases where wide validation may be required [more important cases]. *epi* called for more and better modelling to compare with the reality of the present situation [de facto deferred examination – particularly for non-European users of the PCT].

Single Patent Process programme

This is a major project to consider business flow within the EPO and to make suitable adjustments to procedures to improve efficiency. The programme started from the perspective of improvements in the office's technology, but is drifting towards more fundamental issues of practice and procedure. The procedural aspects include relations with attorneys and handling the examination process. A focus group will discuss issues and have user participation.

Repair to ISAR building

More asbestos has been found than the initial survey had indicated. Also, problems have been found with air conditioning and fire protection systems. This has resulted in a higher cost for the work [~€ 13m] – and a delay in completion [now expected April 2011].

Financial position and business plan

2008 was the first year in which the Office had a surplus under IFRS accounting rules. However the general economic situation has spoilt this good news.

There has been a big drop in filing numbers in the first half of 2009, but renewal fee income has held up well and so the effect on operations of the EPO has been less than was feared. However, despite the operating income being good in both cash and IFRS terms, the EPO's financial income has dropped by about a third. This leads to a projected drop of € 100m in income overall during 2009.

The Pension fund lost over 30 % of its value during 2008 but now seems to have nearly recovered that loss. However a lower return on the fund is to be expected than in the past and this will be reflected in future accounts.

There has been no estimate made of the number of divisional applications to be filed in 2010. Accordingly the filing predictions in the business plan for 2010 may be too low.

The appeals backlog is planned to increase, leading to a near doubling of pendency if nothing is done. DG3 said that more boards will be needed, but these are not budgeted for.

There are a number of unfunded examiner posts in the budget – if there is an upturn in 2010 the office will ask for more money to fund these posts.

Improved governance of investments is required.

Fees

No change in fee structure in 2010, but it seems there will be a regular biennial inflation increase of about 5 % [for 2 years inflation].

IFRS

The staff association has proposed that a different standard of accounting [IPSAS] should be used as this may permit the value of future renewal fees to be included in the accounts. The Office will be producing a report.

epi's activities in education – an overview

H. Hanneman (NL)
Director of Education, *epi*

epi's contribution to education comes in two areas: one part focuses on the initial qualification of patent attorney trainees (EQE-related educational effort) and the other area is that of continuing professional education (CPE-related educational effort)

In this article we present an overview of the current and (near) future main activities in either area.

Educational policy is (mainly) a matter of the Professional Qualification Committee (PQC; current chairperson: Mr. Fritz Schweinzer) and is not the subject of the article. However, all educational programmes and activities presented in this article are the result of deliberate decisions of PQC and whenever necessary backed by Presidium, Board and Council.

epi's activities on education are targeted specifically at those issues, subjects, or using those educational formats that are not or not in that form covered by commercial or other organisations. *epi* tries to offer complementary or broader or more in depth seminars, training courses, tutorials and e-learning either by itself or in cooperation with outside partners (mainly EPO Academy and CEIPI). Further, *epi*'s organisational efforts are offered to its members at very attractive fees as *epi* is a not for profit organisation and some of its costs are already covered by its membership fees.

A. EQE-related educational effort

epi's educational effort focuses on the two categories of 'actors' relevant in this area: the patent attorney trainees ('students') and their tutors, mentors and/or supervisors.

(As a third category we could consider training programmes for support staff e.g. patent administrators. So far *epi* has not developed in programmes in this area although individual *epi* members have acted as a tutor in courses organised by other parties.)

We will deal with both categories in turn.

1. Patent attorney trainees

For students the main offers of *epi* are:

- *epi* tutorials
Twice a year students are offered the opportunity to sit (at home or at their office) last (two) years of EQE exam papers and have their answers discussed with experienced *epi* tutors in a small group of 3-5 students. The tutors who volunteer to do this most valuable job are recruited among *epi*'s members. *epi* tutorials which are organised in summer and in winter are announced in *epi* Information.
- Mock-EQE
epi recently started with organising mock-EQE's (last year in Helsinki, Finland; this year in Munich and

Helsinki). The mock-exam offers students the opportunity to sit the EQE under exam-like conditions (e.g. three consecutive days together with other students). Approximately one month after the exam their papers will have been reviewed by experienced *epi* tutors. In a three day session the tutors will discuss the personal answers of the candidates in small groups of 3-5 candidates.

Mock-EQEs are announced through a personal e-mail to *epi* (student) members.

- Study Guide

Earlier this year a joint *epi*/EPO/CEIPI working group finished its work on a „Guide to preparing for the European qualifying examination'. The 25+ page guide has been designed to bring together a wealth of advice, experience and information, including recommended training courses, from members of the joint working group, previous candidates and supervisors/tutors to help candidates prepare for the EQE.

The Guide is available at *epi*'s and EPO's webpage and will become available in printed form. Next year an updated version will be published taking into account the recent decided changes in the (Implementing provisions to the) Regulation on the EQE (IPREE/REE).

A possible new kind of programme would be seminars for making our profession more known (and possible liked) by young graduates. The seminar would provide them with information on the patent profession, the individual career paths and what it takes to become a patent attorney.

- Online programmes for self-testing of EQE-candidates

Another joint *epi*/EPO/CEIPI working group started last year with the ambitious goal to develop online testing programmes. The programmes intend to provide candidates with the tools to train and test their knowledge and competences regarding all four EQE exam papers. As the programme is an e-learning tool it is not (yet?) possible to offer users to train on exam papers in the exact form as they appear in the EQE. The goal is to offer training and testing material for as many possible of the significant knowledge and competence parts in a form comparable with an e-learning environment.

The working group started with a programme for paper DI. The particular programme generates questions on time limits/deadlines under EPC/PCT and requires the user to submit their answer as well as the relevant article(s)/rule(s) which support their answer. The programme reviews the answer (right/

wrong), provides the correct answer and points out the relevant article(s) and or rule(s) to be referred to in order to arrive at the correct answer. Over 70 unique questions are programmed. The tool is available at: www.eqe-online.org/questions

A paper A-like exercise is to be finalised next.

Exercises for the other papers (B, C and DII) are being considered.

2. Tutors, mentors and supervisors

Educating patent attorney trainees requires *epi* members who can act as tutors in an effective way. *epi* supports its members in this role in a number of ways.

- **Tutors' meeting**
Yearly, *epi* organises a tutor meeting. At that meeting *epi* tutors meet members of the examination board with the goal to discuss that year's EQE papers and the marking sheet. In this way *epi* tutors can obtain first hand knowledge about the intricacies of the most recent EQE and have the possibility to share their thoughts with the members of the EB. *epi* as an organisation ensures in this way that its pool of tutors is offered the chance to keep abreast of the developments in the field of examination and the actual demands on candidates to show that they are fit for practice.
- **Supervisors/mentors**
Every patent attorney trainee has to have a tutor, mentor or supervisor. Later this year *epi* in cooperation with EPO Academy and CEIPI will organise for the first time a seminar specifically targeted at *epi* members playing this role. The meeting aims at providing guidance and information on how to structure a trainee's preparation period for becoming a good patent attorney including and more specifically preparing for taking the EQE. The one and a half day meeting held in Berlin on November 23-24 will also give ample opportunities for an exchange of best practices, and address inter alia questions as how much time and effort needs to be invested by supervisors and trainees as well all other aspects that are of relevance in order to ensure that those who are about to enter the profession are prepared in the best possible manner and in the most effective way.

B. Continued professional education efforts

„Lifelong learning is the key to long lasting professional success.“ (J.-H. Zilliox in *epi* Information)

The main part of *epi*'s vocational training activities is in the area of EPC/PCT and in particular new development in the law or the rules as well as the interpretation thereof.

The preferred form is the *epi* seminar. In recent years *epi* seminars have been organised throughout Europe covering subjects as:

- Oral proceedings at the EPO
- Opposition
- Amendments to European applications
- How to understand examiner's communications
- EPC 2000
- Recent amendments to PCT

The speakers at those seminars are either *epi* members or outside speakers from e.g. EPO, WIPO or a joint effort. On particular Mr. Daniel X. Thomas of EPO has been a prominent and highly acclaimed speaker. We recently interviewed Mr. Thomas on his views and his contribution towards continuous professional education. An account of this interview will be published in the next issue of *epi* Information.

Earlier this year *epi* organised a so-called train the trainer seminar for experienced *national* patent attorneys from recently acceded contracting states. A detailed account on these activities has been published in *epi* Information 2009/3.

At the Luxembourg council meeting a considerable amount of members suggested that it would be useful if *epi* would consider organising seminars in a broader area i.e. outside the EPC/PCT scope. Among the subjects mentioned in this context are:

- Patent portfolio management
- Patent valuation
- Universal drafting (i.e. drafting an application and in particular its claims in such a form that it is best suited to act as a starting document in the tri-lateral (EP, US, JP) or penta-lateral (+CN, KR) area.
- Licensing-in, -out, cross-licensing
- Etc.

At a recent meeting of the PQC working group on CPE it was decided to request Council's agreement to organise early next year a seminar on patent portfolio management covering in detail subjects like (i) the strategic considerations (ii) possible forms of exploitation and (iii) alignment of firm's strategy to chosen form(s) of exploitation.

Usually, *epi* seminars are held at the request of members who indicate the topic and the venue. *epi* will assist in organising the event including announcement, registration and enrolment, assist in providing speaker(s), and carry out the evaluation of the event. If you want to organise an *epi* seminar in your country or region please contact the *epi* secretariat or the director of education.



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zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

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annexée, à retourner à l'epi avant le 24
février 2010.

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(uniquement Visa ou Mastercard)**

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First name of epi member

Membership number (8 digits)

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Expiry date

Verification code**)

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*) Just Visa and Master Card.

**) The verification code is the last three digits on the signature panel of the card.

Bei Zahlungseingang nach dem
30. April 2010 ist der Beitrag € 190.

Payments made after **30 April 2010**
must be in the amount of € 190.

La cotisation est de € 190 si le
paiement est effectué après le **30 avril**
2010.

Sollten Sie Ihren Jahresbeitrag nicht
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Kenntnis, dass Ihr Name von der Liste
der zugelassenen Vertreter gelöscht
wird, gemäß Regel 154(1) der
Ausführungsordnung zum EPÜ. Ihr
Name kann jedoch gemäß den derzeit
gültigen Regeln wieder in die Liste
aufgenommen werden, sobald Sie den
ausstehenden Beitrag bezahlt haben,
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Please note that if you fail to pay your
annual subscription your name will be
deleted from the list of professional
representatives, cf. Rule 154(1) of the
Implementing Regulations of the EPC.
However, you may, upon request, be re-
entered under the current regulations on
the list of professional representatives
as soon as your outstanding
subscription has been paid, cf. Rule
154(3).

Nous vous rappelons que, si vous
n'avez pas acquitté votre cotisation
annuelle, votre nom sera radié de la
liste des mandataires agréés, voir
Règle 154(1) du Règlement
d'exécution de la CBE. Toutefois, vous
pouvez faire une demande de
réinscription sur la liste des
mandataires agréés selon les règles en
vigueur après avoir acquitté votre
cotisation impayée, voir Règle 154(3).

Der Schatzmeister
Claude Quintelier

The Treasurer
Claude Quintelier

Le Trésorier
Claude Quintelier

Bitte einreichen an:

Please return to:

Retournez s.v.p. :

epi-Sekretariat
Postfach 26 01 12
D-80058 München

Telefax 089 – 242052-20

Neue
Einzugsermächtigung

New direct debiting
mandate

Nouvelle autorisation de
prélèvement

Eingangsfrist im
epi-Sekretariat:

Deadline for receipt by the
epi Secretariat:

Date limite de réception au
Secrétariat de l'epi:

24. Februar**24 February****24 février**

Bitte verwenden Sie **nur dieses Formular**,
 gegebenenfalls mit einem gesonderten Blatt
 für die Namen mehrerer **epi**-Mitglieder.

Please use only this form, if necessary
 with a separate sheet for the names of
 several **epi** members.

Veillez utiliser uniquement ce formulaire,
 si nécessaire avec une feuille séparée pour
 les noms de plusieurs membres de l'**epi**.

Wenn die Liste der **epi**-Mitglieder sich seit
 letztem Jahr **nicht** geändert hat, wird die
 Abbuchung automatisch entsprechend der
 vorhandenen Liste erfolgen und es ist kein
 Formular an das **epi** zu senden.

If **no changes** apply to your existing list,
 the debiting will be done automatically,
 based on the existing list and there is no
 need to send any document to the **epi**
Secretariat.

Si **aucun changement** ne doit être fait à
 votre liste existante, le prélèvement sera fait
 automatiquement, basé sur la liste existante
 et il ne faut envoyer aucun formulaire au
Secrétariat de l'epi.

Bitte senden Sie diese Einzugsermächtigung
 oder eine Kopie davon **nur an das epi-**
Sekretariat.

Please return this form, if applicable, **to**
the epi Secretariat only.

Veillez, si nécessaire, renvoyer ce formulaire
 uniquement **au Secrétariat de l'epi**.

Name/Vorname des **epi-Mitglieds**:
epi member's surname/first name:
 Nom/prénom du **membre de l'epi** :

epi-Mitgliedsnummer:
epi membership number:
Numéro d'affiliation à l'epi:

Name des **Kontoinhabers**:
Account holder's name:
 Nom du **titulaire du compte** :

Kontonummer beim EPA:
EPO account number:
Numéro de compte auprès de l'OEB :

 Datum · Date

 Unterschrift des **Kontoinhabers** · **Account holder's** signature
 Signature du **titulaire du compte**

NOT FOR USE AFTER FEBRUARY 24

Bitte einreichen an:

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Retournez s.v.p. :

epi-Sekretariat
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D-80058 München

Telefax 089 – 242052-20

Änderungen für eine bereits bisher existierende Einzugsermächtigung

Changes to be applied to an existing direct debiting mandate

Changement à appliquer à une autorisation de prélèvement existante

Eingangsfrist im epi-Sekretariat:

Deadline for receipt by the epi Secretariat:

Date limite de réception au Secrétariat de l'epi:

24. Februar**24 February****24 février**

Bitte verwenden Sie **nur dieses Formular**, gegebenenfalls mit einem gesonderten Blatt für die Namen mehrerer **epi-Mitglieder**.

Please use only this form, if necessary with a separate sheet for the names of several **epi members**.

Veillez utiliser uniquement ce formulaire, si nécessaire avec une feuille séparée pour les noms de plusieurs membres de l'**epi**.

Wenn die Liste der **epi-Mitglieder** sich seit letztem Jahr **nicht** geändert hat, wird die Abbuchung automatisch entsprechend der vorhandenen Liste erfolgen und es ist kein Formular an das **epi** zu senden.

If **no changes** apply to your existing list, the debiting will be done automatically, based on the existing list and there is no need to send any document to the **epi Secretariat**.

Si **aucun changement** ne doit être fait à votre liste existante, le prélèvement sera fait automatiquement, basé sur la liste existante et il ne faut envoyer aucun formulaire au **Secrétariat de l'epi**.

Bitte senden Sie gegebenenfalls diese Einzugsermächtigung oder eine Kopie davon **nur an das epi-Sekretariat**, wenn notwendig.

Please return this form, if applicable, **to the epi Secretariat only**.

Veillez, si nécessaire, renvoyer ce formulaire uniquement au **Secrétariat de l'epi**.

<p>Die folgenden epi-Mitglieder sind von jetzt an auf der Liste für die Einzugsermächtigung zu ergänzen: The following epi members should from now on be added to our list of names for direct debiting mandate: Les membres de l'epi repris ci-dessous doivent à partir de maintenant être ajoutés à votre liste de noms pour l'autorisation de prélèvement :</p> <p>Name/Vorname des epi-Mitglieds: epi member's surname/first name: Nom/prénom du membre de l'epi :</p>
<p>epi-Mitgliedsnummer: epi membership number: Numéro d'affiliation à l'epi:</p>
<p>Die folgenden epi-Mitglieder sind ab sofort in der Liste für die Einzugsermächtigung zu streichen: For the following epi members the membership fee should from now on no longer be debited from our EPO account: Pour les membres de l'epi repris ci-dessous la contribution ne doit à partir de maintenant plus être débitée de notre compte auprès de l'OEB :</p> <p>epi-Mitgliedsnummer: epi membership number: Numéro d'affiliation à l'epi :</p>
<p>Name des Kontoinhabers: Account holder's name: Nom du titulaire du compte :</p>
<p>Kontonummer beim EPA: EPO account number: Numéro de compte auprès de l'OEB :</p>
<p>_____ Datum · Date</p> <p>_____ Unterschrift des Kontoinhabers · Account holder's signature Signature du titulaire du compte</p>

NOT FOR USE AFTER FEBRUARY 24

Einzugsermächtigung

Eingangsfrist im
epi-Sekretariat:

24. Februar

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (**epi**) wird hiermit ermächtigt, den **epi**-Jahresbeitrag für das unten angegebene **epi**-Mitglied in der jeweils gültigen Höhe von dem nachstehend genannten und beim Europäischen Patentamt (EPA) geführten laufenden Konto einzuziehen. Die Einzugsermächtigung gilt für den nächstfälligen und künftig fällige Beiträge bis auf schriftlichen Widerruf. Sie gilt ebenso für offene Beiträge vergangener Jahre. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem **epi** getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Der Einzug des Beitrags erfolgt mit Wirkung vom 25. Februar des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des **epi**-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, fasst das **epi** zu einem Gesamtbetrag zusammen. Demgemäß erteilt das **epi** dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Reicht das Guthaben nach Begleichung der vorrangigen EPA-Gebühren und Auslagen zur Ausführung des Abbuchungsauftrags des **epi** nicht aus oder trifft die vorliegende Einzugsermächtigung beim **epi** nach dem 24. Februar ein, kann der Abbuchungsauftrag nicht ausgeführt werden. Das **epi**-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Beitrag dann nicht bis spätestens 30. April (Kontoeingang) für das **epi** spesenfrei im normalen Bankverkehr, erfolgt ein Einzugsversuch des erhöhten Jahresbeitrags am 25. Juni. Schlägt auch dieser Versuch fehl, muss der erhöhte Beitrag im normalen Bankverkehr beglichen werden.

Mit Wirkung vom 25. Juni kann der Beitrag auch für **epi**-Mitglieder, die zum vorausgegangenen Abbuchungstag noch keine Einzugsermächtigung vorgelegt hatten, eingezogen werden. Eingangsfrist für die Einzugsermächtigung im **epi** ist hierfür der 15. Juni.

Falls ein gesondertes Blatt mit den Namen mehrerer **epi**-Mitglieder beigelegt wird, braucht es nicht gesondert unterschrieben zu werden.

Direct debiting mandate

Deadline for receipt by the **epi**
Secretariat:

24 February

The Institute of Professional Representatives before the European Patent Office (**epi**) is hereby authorised to debit from the deposit account held with the European Patent Office (EPO) as specified below the **epi** annual subscription for the **epi** member named below at the appropriate rate. This direct debiting mandate applies to the forthcoming and all subsequent subscriptions until it is revoked in writing. It also applies to outstanding subscriptions from previous years. Debiting will be on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the **epi** (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

Subscriptions are debited with effect from 25 February of each year. All fees and costs payable to the EPO on the debiting date have priority over the **epi** subscription. The **epi** will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. If, after priority payment of EPO fees and costs, the credit balance is not sufficient to carry out the **epi** debit order, or if the direct debiting mandate is received by the **epi** after 24 February, the debit order is not carried out. The **epi** member will be informed. Then, if the annual subscription has not been credited to the **epi** account through the standard banking procedure and at no expense to the **epi** by 30 April (reception on **epi** account), an attempt will be made to debit the higher annual subscription on 25 June. Should this attempt also prove unsuccessful, the higher annual subscription must be paid to the **epi** through the standard banking procedure.

Subscriptions of **epi** members who had not issued a direct debiting mandate by the previous debiting date may also be debited with effect from 25 June. The deadline for receipt of the direct debiting mandate by the **epi** is then 15 June.

If a separate sheet with the names of several **epi** members is enclosed, it does not need a separate signature.

Autorisation de prélèvement

Date limite de réception au Secrétariat
de l'**epi**:

24 février

L'Institut des mandataires agréés près l'Office européen des brevets (**epi**) est autorisé par la présente à prélever, sur le compte courant ouvert à l'Office européen des brevets (OEB) dont le numéro est mentionné ci-après, le montant en vigueur de la cotisation annuelle du membre de l'**epi** dont le nom figure ci-dessous. La présente autorisation de prélèvement est valable pour la prochaine cotisation venant à échéance, ainsi que pour les cotisations suivantes, jusqu'à révocation par écrit. Elle vaut également pour les cotisations des années précédentes non encore acquittées. Le prélèvement est opéré sur la base des dispositions de l'accord administratif en date du 5 avril 1993 entre l'OEB et l'**epi** (JO OEB 1993, 367) ainsi que de celles du point 9 de la décision modifiant la réglementation applicable aux comptes courants (JO OEB 1993, 366).

Le prélèvement de la cotisation prend effet le 25 février de l'année en cours. Le règlement de toutes les taxes et de tous les frais dus à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle à l'**epi**. L'**epi** regroupe en un seul montant plusieurs cotisations devant être débitées du même compte. A cette fin, l'**epi** donne à l'OEB un ordre de débit pour le montant total. Si, après règlement prioritaire des taxes et des frais dus à l'OEB, la provision du compte ne suffit pas pleinement pour exécuter l'ordre de débit de l'**epi** ou si la présente autorisation parvient à l'**epi** après le 24 février, l'ordre de débit ne peut être exécuté, et le membre en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d'inscription au compte de l'**epi**), par une opération bancaire normale et sans frais pour l'**epi**, il sera procédé, le 25 juin, au prélèvement du montant majoré de la cotisation annuelle. Au cas où ce prélèvement non plus ne peut être effectué, le montant majoré de la cotisation doit être acquitté par une opération bancaire normale.

Avec effet au 25 juin, il est également possible de prélever le montant de la cotisation annuelle des membres de l'**epi** n'ayant pas produit d'autorisation de prélèvement à la date de débit précédente. A cette fin, la date limite de réception des autorisations de prélèvement par l'**epi** est le 15 juin.

S'il est joint une feuille séparée portant le nom de plusieurs membres de l'**epi**, il n'est pas nécessaire de la signer.

Neues aus dem Sekretariat

P.G. Maué (CH)
Secretary General

Am 05. Oktober 2009 trat Frau Heike Ortlepp die Stelle als Office-Managerin im *epi*-Sekretariat an. Frau Ortlepp bringt eine 20-jährige Berufserfahrung mit, wobei sie die letzten 10 Jahre mit zunehmenden Verantwortlichkeiten administrative Tätigkeiten ausübte.

Frau Ortlepp wird im Sommer 2010 ihr berufsbegleitendes Masterstudium zur Betriebswirtin abschließen. Diese personelle Verstärkung wird es erlauben, dass die Tätigkeiten im Sekretariat konsequenter organisiert werden und auf mittlere Sicht auch zusätzliche Dienstleistungen angeboten werden können.

Auch nach dem Umzug – in die Bayerstrasse 83 – verfügt das Sekretariat über ein Sitzungszimmer. Dieses Sitzungszimmer ist primär für Ausschusssitzungen (bis max. 16 Teilnehmer) vorgesehen; es kann jedoch auch von *epi*-Mitgliedern genutzt werden. Zu berücksichtigen wäre hier, dass die Nutzung zu den üblichen Geschäftszeiten (08:30 – 17:00 Uhr) stattfindet. Ein entsprechender Kalender wird im Sekretariat geführt. Terminwünsche sind per E-Mail an meetingroom@patentepi.com zu richten.

Obituary

P.G. Maué (CH)
Secretary General

It is with deep regret that I have to announce to you the death of our *epi* Secretariat staff member Ms Della Bella after a long illness. We will remember Ms Della Bella for

her strong commitment to the work entrusted to her, which she accomplished until the very last day, and her positive attitude. Our thoughts go to her family.

CEIPI Conference „Towards a European Court“ Strasbourg, 16-17 April 2010

On April 16 and 17, 2010, the Center for International Intellectual Property Studies (CEIPI) is organizing a conference at the European Parliament in Strasbourg on the topic: „*Towards a European Patent Court*“, under the high patronage of Mrs Catherine Trautmann, Member of the European Parliament and former Minister for Culture and Communications.

There is now a rather broad consensus in favor of the creation of a common jurisdiction to settle disputes related to European patents and forthcoming Community patents. Indeed, the effectiveness of patent rights closely depends on the jurisdictional system in charge of its implementation. On this matter the present system could be improved.

Nevertheless, it raises several delicate questions that remain to be settled. With this in mind, the CEIPI has

invited a panel of specialists – academics, practitioners and senior officials – who will share their expertise during the two days of the conference on the main issues of this ambitious project : the structure of the Court, the composition of the panels and the appointment procedure ; the competence *ratione materiae* ; the competence *ratione loci* ; the link between the European Patent Court and the European Court of Justice ; the agreement's coming into force and opting-out ; representation ; and languages.

This conference aims to formulate ingenious and constructive proposals on all these topics and thus to contribute to the achievement of this important project.

Further information and a registration form can be found on our website: www.ceipi.edu

Next Board and Council Meetings

Board Meetings

82nd Board meeting on 13 February 2010 in Milan (IT)
 83rd Board meeting on 12 June 2010 in Oslo (NO)
 84th Board meeting on 25 September 2010 in Budapest (HU)

Council Meetings

68th Council meeting on 24 April 2010 in Dublin (IE)
 69th Council meeting on 20 November 2010 in Berlin (DE)

List of Professional Representatives as at 13.08.2009

by their place of business or employment in the Contracting States

No.	Contr. State	Total Repr.	% of Tot.Repr.
1	AT	114	1,23
2	BE	154	1,67
3	BG	76	0,82
4	CH	402	4,35
5	CY	13	0,14
6	CZ	109	1,18
7	DE	3.085	33,39
8	DK	169	1,83
9	EE	29	0,31
10	ES	157	1,70
11	FI	151	1,63
12	FR	823	8,91
13	GB	1.784	19,31
14	GR	27	0,29
15	HR	27	0,29
16	HU	104	1,13
17	IE	55	0,60
18	IS	22	0,24
19	IT	355	3,84

No.	Contr. State	Total Repr.	% of Tot.Repr.
20	LI	12	0,13
21	LT	31	0,34
22	LU	19	0,21
23	LV	21	0,23
24	MC	2	0,02
25	MK	26	0,28
26	MT	8	0,09
27	NL	394	4,26
28	NO	113	1,22
29	PL	371	4,02
30	PT	43	0,47
31	RO	79	0,85
32	SE	286	3,10
33	SI	32	0,35
34	SK	39	0,42
35	SM	2	0,02
36	TR	106	1,15
	Total:	9.240	100,00

For information concerning
epi Membership and membership subscription
 or
 Rules governing payment of the *epi* annual membership fee
 visit the *epi* website www.patentepi.com

Corrigendum

- On page 90 of issue 3/2009, it should be noted that Mr. Zsolt Szabo is a trainer from Hungary and not from Croatia, as erroneously reported.
- In the survey „The Patent Profession in the EPC Contracting States“ on page 86 of issue 3/2009,

the name for the Association of IP Professionals in Swedish Industry has been changed and should read now „Svenska Industrins IP Förening“. The address at present is c/o Uppdragshuset Sverige AB, Maria Bangata 6, SE 118 63 Stockholm.

Machine, Apparatus, or Transformation ... What Do Section 101 and In re Bilski Mean for Patent Applicants in the United States?

F. Tanty¹ (FR) and J. Bell² (US)

Article I, Section 7 of the Constitution of the United States grants the Congress power to „promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.“³ The Congress of the United States has utilized this power to codify a patent system at Title 35 U.S.C., under which an inventor of „any new and useful *process, machine, manufacture, or composition of matter*, or any new and useful improvement thereof, may obtain a patent therefore ...“⁴

Between the July 23, 1998 and October 30, 2008, 1,848,345 U.S. Patents were issued by the U.S. Patent and Trademark Office (USPTO), of which, 14,208, or approximately 0.77 %, were classified by the USPTO as business methods.⁵ But what did the U.S. Congress intend when it used the term „process“ as patentable subject matter in Section 101? Title 35, Section 100(b) of the United States Code states „[t]he term ‚process‘ means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.“⁶ Which of the myriad of process types should be patentable for purposes of „promot[ing] the progress of science and useful arts?“ To further guide patent practitioners and applicants alike, the U.S. Supreme Court has decided to review the *en banc* decision of the U.S. Circuit Court of Appeals for the Federal Circuit („Federal Circuit“) in *In re Bilski*, which announced the machine-or-transformation test, i.e., only processes tied to a particular machine or

apparatus, or those transforming an article to a different state or thing qualify as statutory subject matter.⁷

In this article we offer an interim look at what has developed with regard to the patentability of process claims, through former and current jurisprudence of the Supreme Court, Federal Circuit, and finally, the Board of Patent Appeals and Interferences (the BPAI), with particular emphasis on business methods.

I. What is Statutory Subject Matter

„Any new and useful process, machine, manufacture or composition of matter“ i.e., „anything under the sun that is *made by man*“ may be afforded the protections of the U.S. patent system.⁸ However, U.S. Courts have held that several exclusions to statutory subject matter under Section 101 exist, i.e., abstract ideas, laws of nature, and natural phenomena.⁹ Determining whether a claim falls into the exclusionary categories has proven difficult at best.

A. Decisions of the U.S. Supreme Court

The U.S. Supreme Court last spoke on the issue of patentable subject matter under 35 U.S.C. § 101 with regard to computer implemented process claims in 1981, ruling on the final of a trilogy of cases: *Gottschalk v. Benson*, 409 U.S. 63 (1972); *Parker v. Flook*, 437 U.S. 584 (1978), and *Diamond v. Diehr*, 450 U.S. 175 (1981).

1. Gottschalk v. Benson

In *Benson*, the claimed process related to conversion of binary coded decimal (BCD) numbers into pure binary numbers, the claims being rejected by the U.S. Patent and Trademark Office (USPTO), but sustained as statutory subject matter by the Court of Customs and Patent

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2 M. BELL is a registered U.S. Patent Attorney and associate at Nony and Partners in Paris, France.

3 U.S. Constitution Article I, Section 7 1790

4 35 U.S.C. § 101. The term „process“ replaced the term „art“ in Section 101 in 1952.

5 Source USPTO

6 35 U.S.C. §§ 100(b)

7 *In re Bilski*, 545 F.3d 943 (Fed. Cir. Oct. 30, 2008) (*en banc*), cert. granted June 1, 2009; Arguments to be heard November 9, 2009.

8 *Diamond v. Chakrabarty*, 447 U.S. 303 (1980)

9 MPEP 2106(IV)(C)

Appeals (CCPA) (a precursor court to the Federal Circuit).¹⁰ The *Benson* Court noted that the patent application claims were not limited to any particular technology nor were they related to *any particular machine or apparatus*.¹¹ Indeed, the Court recognized that such conversions could be carried out mentally without a computer, despite the fact that the claimed process rearranged the steps one might undertake to perform the conversion.¹²

Relying on its prior decisions, the Court stated „[t]ransformation and reduction of an article, to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines ...“¹³ Notably, however, the Court backed away from the position that process claims must either be tied to a particular machine or apparatus, or operate to change articles or materials to a different state or thing, holding that the claim at issue was nothing more than an algorithm with no practical application, and was therefore not patentable subject matter.¹⁴

2. *Parker v. Flook*

In *Flook*, the process was related to updating alarm limits based on a particular algorithm during a catalytic conversion process, for which the claims were rejected by the USPTO and the rejection upheld on appeal to the CCPA.¹⁵ Once again the Supreme Court determined that the algorithm at the heart of the claimed process could be performed with a pencil and paper, but the Court recognized that the claims did not read on „every conceivable application of the formula.“¹⁶ Upholding the CCPA, the Court thus held that post-solution activity cannot transform an otherwise unpatentable method claim into a patentable one.¹⁷ Thus, it was clear that post-solution activities appended to an otherwise unpatentable algorithm would not render a computer executed process claim statutory subject matter.

3. *Diamond v. Diehr*

The claimed process at issue in *Diehr* related to molding plastic or rubber items in a press, the press being heated for a time to cure the item being molded.¹⁸ Prior art taught that cure time could be calculated based on an equation with variable inputs including the temperature of the press.¹⁹ However, the prior art did not teach any method for accurately reporting a temperature measurement without opening the press, resulting in inaccurate cure times.²⁰ The claimed process solved this problem by including thermocouples within the press to provide continuous temperature information to a computer to continuously recalculate the cure time based on the

temperature.²¹ The Examiner initially rejected the claims as non-statutory subject matter under Section 101 based, at least in part, on the presence of the computer in the claims. However, the CCPA reversed the rejection holding that, simply introducing a computer into a claim does not render such a claim non-statutory subject matter.²²

In upholding the decision of the CCPA and finding the claims at issue statutory under Section 101, the Court reiterated that patent protection could not be granted for claims to an algorithm whose sole purpose was to program a digital computer nor to a claim which sought to patent an algorithm only through introduction of one or more post-solution steps.²³ However, the Court then held that „when a claim containing a mathematical formula implements or applies that formula in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect (e.g., *transforming or reducing an article to a different state or thing*), then the claim satisfies the requirements of § 101.“²⁴

B. Important Decisions of the Federal Circuit and CCPA

1. *In re Abele*

In 1982, following the Supreme Court's decision in *Diehr*, the CCPA rendered its decision in the case of *In re Abele*.²⁵ At issue in the case were claims directed to a process for calculating and displaying data obtained via X-ray exposure of various portions of a body.²⁶ Claim 5 of the patent application at issue recited limitations related solely to data manipulation and display.²⁷ However, claim 6, depending from claim 5, limited the „data“ to „X-ray attenuation data produced in a two dimensional field by a computed tomography scanner.“²⁸ Thus, in combination with claim 5, claim 6 recited the transformation of raw X-Ray data representative of a physical thing, to produce an on-screen, human-cognizable image.²⁹

While the court ruled claim 5 non-statutory matter, the court held claim 6 statutory subject matter under Section 101.³⁰ This was so, the court reasoned, primarily because the *data* that was representative of physical objects (e.g., bones and tissue), was collected and *transformed* into a human-cognizable displayed image of the underlying physical object.³¹

10 *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972)

11 *Id.* at 67.

12 *Id.*

13 *Id.* at 70 (emphasis added).

14 *Id.* at 71-73.

15 *Parker v. Flook*, 437 U.S. 584, 586 (1978)

16 *Id.*

17 *Id.* at 589-590

18 *Diamond v. Diehr*, 450 U.S. 175, 177-178 (1981)

19 *Id.* at 177.

20 *Id.* at 178.

21 *Id.* at 178-179

22 *Id.* at 179-181.

23 *Id.* at 187.

24 *Id.* at 192 (emphasis added)

25 *In re Abele*, 684 F.2d 902 (C.C.P.A. 1982)

26 *Id.* at 908.

27 Claim 5 recited: A method of displaying data in a field comprising the steps of calculating the difference between the local value of the data at a data point in the field and the average value of the data in a region of the field which surrounds said point for each point in said field, and displaying the value of said difference as a signed gray scale at a point in a picture which corresponds to said data point.

28 *Id.*

29 *Id.*

30 *Id.*

31 *Id.* at 908-09

2. State Street Bank

In 1998 the U.S. Court of Appeals for the Federal Circuit decided the case of *State Street Bank and Trust Co. v. Signature Financial Group, Inc.* In *State Street*, the claims at issue related to a system for calculating share prices of various mutual funds based on particular investment parameters.³² Citing *Benson, Flook, and Diehr*, the court reiterated that mathematical algorithms *per se* are not patentable subject matter, unless „reduced to a practical application.“³³ Notably, in finding the claims patentable under Section 101, the court struck down the „misconception“ that a „business method exception“ existed, holding that where a claimed method produced „a useful, concrete, and tangible result,“ the requirements for statutory subject matter were met.³⁴

3. In Re Bilski

Shortly before the decision in *State Street*, Bernard Bilski et al. filed a patent application³⁵ directed to methods for „managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price.“³⁶ The claims were rejected for lack of statutory subject matter under 35 U.S.C. § 101, and the rejection was upheld by the BPAI.³⁷ On October 30, 2008, an *en banc* Federal Circuit upheld the rejection below „clarify[ing] the standards applicable in determining whether a claimed method constitutes a statutory ‚process‘ under § 101.“³⁸

Overruling their decision in *State Street*, the Federal Circuit abrogated the „useful, concrete, and tangible result“ test and, relying on the *Benson, Flook, Diehr* trilogy of decisions from the U.S. Supreme Court, held that the „machine-or-transformation“ test was henceforth applicable for determining patentable subject matter under Section 101.³⁹

II. After Bilski

A. Implications

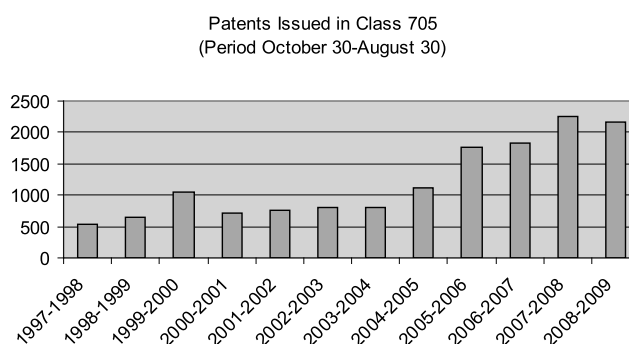
It is important to note that the „machine-or-transformation“ test was not limited by the Federal Circuit strictly to business or computer implemented methods. In fact, the test is applicable not only to business method

claims, but *any* process claim in general, e.g., medical processes, diagnostic processes, manufacturing processes, refining processes, etc. While some process claims may be drafted to easily meet such requirements, some otherwise valuable processes may fail, thereby potentially stifling innovation and failing to „promote the progress of science and useful arts.“

Furthermore, many patentees have presumably relied on the standard set forth in by the Federal Circuit in its *State Street Bank* decision, i.e., the „useful, concrete, and tangible result“ test.⁴⁰ Millions of dollars have no doubt been spent preparing, filing, prosecuting, and maintaining patents and patent applications according to this standard. These costs may be partially or completely lost to the patentees, because the value of patents previously issued may be diminished unless revised through reissue procedures, while applications may not have been drafted in accord with the new standard.⁴¹

B. Statistics

A bar chart demonstrating the number of patents issuing from business methods class 705 over the last 10 years is shown below.⁴²



A search of the USPTO records shows that from the period October 30, 2007 to August 30, 2008, some 2,247 patents classified as class 705 (business methods) issued from the USPTO. During the exact same period one year later immediately following the Federal Circuit's decision in *Bilski*, (i.e., from 2008 to 2009) some 2,176 patents classified in class 705 issued, a difference of only 71 total patents for the periods year on year.

Note that, issuance of business method patents in class 705 increased substantially from 2000 through 2008, with only a small decrease during the same period of 2009. It is possible that the pendulum has only just begun to swing in the other direction with regard to business method patents, and that 2008-2009 was the beginning of a downward trend in issuance of business method claims, but additional data is likely necessary for a clearer view.

32 U.S. Patent No. 5,193,056

33 *Id.* at 1373.

34 *Id.* at 1375.

35 Bilski Claim 1 recites: A method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising the steps of: (a) initiating a series of transactions between said commodity provider and consumers of said commodity wherein said consumers purchase said commodity at a fixed rate based upon historical averages, said fixed rate corresponding to a risk position of said consumer; (b) identifying market participants for said commodity having a counter-risk position to said consumers; and (c) initiating a series of transactions between said commodity provider and said market participants at a second fixed rate such that said series of market participant transactions balances the risk position of said series of consumer transactions.

36 *In Re Bilski*, 545 F.3d at 949. It may be of interest to note that Mr. Bilski's patent application was filed *well prior* to the Federal Circuit's decision in *State Street Bank*.

37 *Id.* (citing to *Ex parte Bilski*, No.2002-2257, 2006 WL 5738364 (B.P.A.I. Sept. 26, 2006))

38 *Id.*

39 *Id.* at 959 (further invalidating the *Freeman-Walter-Abele* test).

40 Was this reliance reasonable in view of the previous trilogy of Supreme Court precedent?

41 35 U.S.C. § 251 enables a patentee to seek correction of an inoperative or invalid patent.

42 Source: USPTO Search of class 705.

C. USPTO Examination Guidelines

On August 24, 2009, the USPTO issued a memorandum entitled „New Interim Patent Subject Matter Eligibility Examination Instructions,“ which forwarded „The Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101.“⁴³ The Guidelines preliminarily set forth a two-step process for examiners to follow when determining if a claim is drawn to patentable subject matter.⁴⁴ Step one requires determination of whether the claim falls into one of the enumerated categories of patentable subject matter (i.e., process, machine, manufacture, or composition of matter).⁴⁵

Next a determination is made as to whether the claim wholly embraces a judicially recognized exception (e.g., abstract ideas, mental processes or substantially all practical uses (pre-emption) of a law of nature or a natural phenomenon) or whether the claim is directed to a particular practical application of a judicial exception.⁴⁶ The Guidelines state that if the claim is directed to a machine, manufacture, or composition of matter, then the practical application element has been presumptively met.⁴⁷ However, if the claim is directed to a process, the examiner must apply the machine-or-transformation test to ensure that a practical application has been met.⁴⁸

In explaining application of the machine-or-transformation test, the Guidelines note that the first prong of the test is to determine if a process is sufficiently tied to a particular machine or apparatus, or if it transforms a particular article to a different state or thing.⁴⁹ If the process claim meets the requirements of the first prong, the examiner must determine whether the particular machine or transformation „imposes a meaningful limit on the claim’s scope“ and whether use of the machine or the transformation involves „more than insignificant ‘extra-solution’ activity“ (e.g., tying to mere „field of use“ or „extra-solution steps“ is insufficient).⁵⁰

While these Guidelines may provide some assistance for applicants wishing to ensure process claims are drafted to patentable subject matter under Section 101, application of the Guidelines can be difficult. Therefore, it is of some interest to review some recent decisions of the BPAI to determine what may, or may not be considered statutory subject matter in view of *Bilski*.⁵¹

D. Recent BPAI Decisions

The cases reviewed below have been placed into three categories: 1) Article of Manufacture; 2) Tied to a Particular Machine; and 3) Transformations, though issues

related to one or more of the categories may be present in a case.

1. Article of Manufacture

Articles of manufacture remain statutory subject matter in view of the *Bilski* decision. Some method claims, particularly those executed on a computer may be drafted as an article of manufacture by use of a computer program product (e.g., computer readable medium). Such claims have come to be known as „Beauregard claims“ in view of the *In re Beauregard* case in which their statutory nature was determined.⁵²

a) *Ex Parte Li* (6 November 2008)

Claim 42⁵³ of U.S. Patent Application 10/463,287 to Li was directed to a computer program product having computer readable code thereon, the code being configured to execute a method for generating reports.⁵⁴ The claim recited a series of steps that were to be carried out by particular software modules for purposes of generating the report.⁵⁵

In determining that such a claim was indeed statutory subject matter for purposes of Section 101, the BPAI noted that the claim presented a number of distinct software modules configured to perform various operations, and that claims like this had, for a number of years, been considered product claims by the USPTO.⁵⁶

b) *Ex Parte Cornea-Hasegan* (13 January 2009)

One may contrast *Li* with *Cornea-Hasgan* to gain insight into the „practical application“ requirement. Similar to *Li*, Claim 18⁵⁷ of U.S. Patent Application No. 10/328,572 to Cornea-Hasegan was directed to a computer readable media including program instructions for a decision making process as to whether to use hardware or software for performing various floating point mathematical operations on a computer.⁵⁸ Interestingly, the

52 *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). But see *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007) (holding that an encoded signal is not statutory subject matter under Section 101.)

53 42. A computer program product, comprising a computer usable medium having a computer readable program code embodied therein, said computer readable program code adapted to be executed to implement a method for generating a report, said method comprising: providing a system, ...wherein the distinct software modules comprise a logic processing module, a configuration file processing module, a data organization module, and a data display organization module; parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at least one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module...; extracting the report data from the at least one data source...; receiving, by the logic processing module, the definition data...; and organizing, by the data display organization module in response to being called by the logic processing module, a data display organization of the report....

54 *Ex Parte Li*, Appeal 2008-1213 (BPAI November 6, 2008)

55 *Id.*

56 *Id.* at 9.

57 Claim 18. A computer readable media including program instructions which when executed by a processor cause the processor to perform the following: normalizing operands a, b, and c for a floating-point operation; utilizing the results of a hardware prediction unit predicting whether result d of said floating-point operation on said a, b, c might be tiny; if so, then scaling said a, b, c to form a', b', c'; calculating result d' of said floating-point operation on said a', b', c'; determining whether said d is tiny based upon said result d'; if so, then calculating said d using software; and if not, then calculating said d using floating-point hardware.

58 *Ex Parte Cornea-Hasegan*, Appeal 2008-4742 (BPAI January 13, 2009).

43 Memorandum of Andrew H. HIRSCHFELD, Acting Deputy Commissioner for Patent Examining Policy, August 24, 2009 (available at: http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf).

44 *Id.* at 1.

45 Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, U.S.P.T.O., August 24, 2009.

46 *Id.* at 2.

47 *Id.* at 3.

48 *Id.* at 3-4.

49 *Id.* at 5.

50 *Id.*

51 The cases discussed herein stem from published patent applications. To view the exemplary claims and subsequent case history, please use the Public PAIR system at www.uspto.gov and the provided application numbers.

method to be executed revolved around manipulation of multiple variables and calculation of a final variable for purposes of making the decision.⁵⁹

In ruling that claim 18 was not statutory subject matter, the BPAI acknowledged that the claim was drawn to a product (i.e., the computer readable media), however, the method executed was merely a mathematical algorithm, and not limited to any *practical application*.⁶⁰ Thus, even where a claim is directed to computer readable medium, the claim must still be limited to a practical application, as announced in the Guidelines.⁶¹

c) *Ex parte Holmstead* (10 May 2009)

Claim 10⁶² of U.S. Patent No. 10/211,915 was directed to computer-readable medium with stored instructions configured to direct a printer to receive information about a print job and determine whether any of the print job elements are already present in the printer's memory.⁶³ The examiner rejected claim 10 as non-statutory subject matter relying on the „useful, concrete, and tangible results“ test of *State Street Bank*.⁶⁴

However, in reversing the examiner, the BPAI first noted that, when taken in view of the specification, the computer-readable medium was in fact a machine.⁶⁵ Moreover, the BPAI ruled that the computer-readable medium could also be construed as a „manufacture“ and therefore, claim 10 was not directed to merely a set of instructions as alleged by the examiner, nor did any judicial exceptions apply – presumably implying that a practical application was a significant portion of the claim.⁶⁶

d) *Ex parte Bodin* (5 August 2009)

Claims 17 and 21⁶⁷ of U.S. Patent Application No. 10/322,058 to Bodin each recited „a computer program product for digital imaging, the computer program product comprising: a recording medium;...“⁶⁸ The claims were rejected by the examiner as non-statutory based on failure to recite, in the preamble, that the computer program product was present on a computer readable medium.⁶⁹

59 *Id.*

60 *Id.* at 12.

61 Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101 at 2.

62 Claim 10. A computer-readable medium having stored thereon instructions that, when executed, direct a printer to: receive a print job ticket that references one or more print job elements, each of the print job elements containing contents that enable generation of a printable document; examine the contents of the one or more print job elements to determine if one or more of the print job elements is already present in a local memory of the printer; and ascertain a location in the local memory of the printer to store any of the one or more print job elements that do not already exist in the local memory.

63 *Ex Parte Holmstead*, Appeal 2009-1485, 1 (BPAI May 20, 2009).

64 *Id.*

65 *Id.* at 7. The BPAI based this decision on the recitation in the specification that the printer device includes firmware stored in a read-only-memory (ROM), the firmware configured to coordinate operations of hardware within the printer.

66 *Id.* at 8-9.

67 Exemplary Claim 17 A computer program product for digital imaging, the computer program product comprising: a recording medium; means, recorded on the recording medium, for creating, in the virtual camera, an unedited image request for an unedited digital image.

68 *Ex Part Bodin*, Appeal 2009-002913, 2 (BPAI August 5, 2009).

69 *Id.* at 3-4.

In reversing the examiner, the BPAI noted that the claim included a „recording medium“ and that the specification noted that the recording medium could be a diskette, CD, or DVD, and each was a computer readable medium.⁷⁰ Notably, the BPAI did not undertake a discussion of whether the practical application prong was met, as it appears such a discussion is unnecessary in view of the explicit limitation to digital imaging.

In view of the above cases, it appears that Beauregard claims continue to present a viable option for meeting the requirements of statutory subject matter under Section 101.⁷¹ Importantly, the claim drafter must carefully consider how to include language tying a method claimed on computer readable media to a particular application, and further avoid defining computer readable media as non-statutory matter (e.g., as a carrier wave). Where a process is sufficiently limited to a practical application, e.g., one or several applications, and claimed as a computer program product stored on a computer readable medium, the claims may more easily meet the requirements of the machine-or-transformation test in view of *Bilski*.

2. Particular Machine

As stated in the *Bilski* decision, claims tied to a particular „machine or apparatus“ may satisfy the machine-or-transformation test, provided the tie to the particular machine or apparatus is not found merely a field of use limitation or „extra-solution activity.“

a) *Ex parte Verhaegh* (11 June 2009)

Claim 6⁷² of U.S. Patent No. 10/069,742 was drawn to a scheduler for executing tasks, and was drafted in means-plus-function form.⁷³ Claim 6 recited constructing means, ordering means, timing means, and scheduling means, each configured to perform various functions associated with the scheduler.⁷⁴ The examiner rejected claim 6 as directed to non-statutory subject matter, alleging the elements were software and were not stored on computer readable medium or claimed as executable by a computer.⁷⁵

In reversing the examiner, the BPAI noted that the claims were to be interpreted according to Section 112, paragraph 6,⁷⁶ and as such, were implicitly directed to a machine.⁷⁷ Because the claims were implicitly directed to

70 *Id.* at 11-12.

71 Note that the decision of *In re Nuijten* 500 F.3d 1346 (Fed. Cir. 2007) reh'g en banc denied, 515 F.3d 1361

(Fed. Cir. 2008), cert. denied, ___ U.S. ___, 127 S.Ct. 70 (2008) (holding that a *transitory, propagating signal* is non-statutory matter) is not discussed herein, but is important for recognizing the types of computer readable media that may be claimed and remain statutory subject matter.

72 Claim 6. A scheduler for determining a schedule for executing a plurality of tasks requiring a plurality of resources, comprising [1] constructing means for ...; [2] ordering means for ...; [3] timing means for ...; and [4] scheduling means for...

73 *Ex Parte Verhaegh*, Appeal 2009-000128, 2-3 (BPAI June 11, 2009).

74 *Id.*

75 *Id.* at 4-5.

76 35 U.S.C. § 112, paragraph 6 recites: An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the *corresponding structure, material, or acts described in the specification* and equivalents thereof. (emphasis added).

machine via the means-plus-function nature, the BPAI looked to the specification to determine that the machine was a *particular* machine, i.e., a digital video transmission system, and therefore concluded that claim 6 was statutory subject matter.⁷⁸

b) *Ex parte Altman* (29 May 2009)

Claim 21⁷⁹ of U.S. Patent No. 10/244,559 to Altman et al. was drawn to a method performed in a host multiprocessor system.⁸⁰ The Examiner rejected the claims under Section 101, alleging that no transformation or tangible result was present, and that the claims were drawn to abstract ideas and software *per se*.⁸¹

The BPAI reversed the examiner's rejection, finding that „a host multiprocessor system that emulates a target n-processor system“ met the requirements for a particular machine in the machine-or-transformation test.⁸² The BPAI continued by determining that „use of the specific machine imposes meaningful limits on the scope of the claims – the host processor emulates a target system's memory addressing causing it to behave like the target processor.“⁸³ In other words, because the tie to a particular machine was significant, and not merely a field of use or extra solution activity, the BPAI found that claim 21 was drawn to statutory subject matter.

c) *Ex parte Schrader* (31 August 2009)

Claim 1⁸⁴ of U.S. Patent Application No. 10/251,118 to Schrader was drawn to a method for obtaining feedback from consumers receiving an advertisement from an ad provided by an ad provider through an interactive channel, and the examiner rejected the claim as non-statutory matter.⁸⁵ Notably, the specification described the „interactive channel“ as „the internet and world wide web, interactive television, and self service devices....“⁸⁶

In reversing the examiner's rejection of claim 1 under Section 101, the BPAI stated that one of ordinary skill in the art would understand the term „interactive channels“ constitutes statutory subject matter because the specification described the interactive channels „as part of an overall patent eligible system of *apparatuses* which

include the Internet and World Wide Web, Interactive Television, and self service devices....“⁸⁷

While providing little guidance on what else may constitute an apparatus, it appears that the BPAI acknowledges here that, provided a claim is sufficiently tied to operation over the Internet and World Wide Web, interactive television, or self service devices, such tying may satisfy the „particular apparatus“ portion of the machine-or-transformation test.⁸⁸

In view of the above cases, the claim drafter may be careful to include limitations to a particular machine that are significant, e.g., intertwined with the process claimed where scope and protection allow. Further, the claims should be carefully drafted to limit the claim to a practical application, and not simply an algorithm executed by a computer, while limitations directed to non-statutory matter, such as a carrier wave, should be avoided.

3. Transformations

In the *Bilski* decision, the Federal Circuit specifically referenced the case of *In re Abele*, 684 F.2d 902 (CCPA 1982) and the associated data transformations.⁸⁹ Presumably, such data transformations continue to be accepted as statutory subject matter following the *Bilski* decision, although the cases discussed below demonstrate that additional care must be taken when drafting process claims to meet the transformation portion of the machine-or-transformation test.

a) *Ex Parte Hardwick* (22 June 2009)

Claim 1⁹⁰ of U.S. Patent Application No. 10/046,666 was drawn to a method of synthesizing a set of digital speech samples, and was rejected by the examiner as non-statutory subject matter under Section 101.⁹¹ Notably, claim 1 did not recite any particular machine, nor did it recite any human-cognizable output, reciting steps only related to production of digital speech samples corresponding to a selected voicing state.⁹²

In analyzing the rejection the BPAI initially considered whether the method was tied to any particular machine, but noting the applicant's argument that the samples could be used on a phone, but so being so limited would result in insufficient patent protection, the BPAI concluded that no tie to a particular machine was intended.⁹³ The BPAI,

77 *Id.* at 13-14.

78 *Id.*

79 Claim 21. In a host multiprocessor system for emulating the operation of a target n-processor system (nby execution of one or more threads representing the operation of the target system, a method for emulating the target system's memory addressing using a virtual-to-real memory mapping mechanism of the host multiprocessor system's operating system, said method comprising: (a) reading a target system virtual memory address (ATV); (b) mapping said ATV to a target real address (ATR); (c) mapping said ATR to a host virtual memory address (AHV); and (d) mapping said AHV to a host real memory address, wherein the emulation of the target system's memory addressing is treated as an application running on the host multiprocessor system.

80 *Ex parte Altman*, 2008-2386, 2-3 (BPAI May 29, 2009).

81 *Id.* at 8.

82 *Id.* at 11.

83 *Id.*

84 Claim 1. A method for obtaining feedback from consumers receiving an advertisement from an ad provided by an ad provider, through an interactive channel, the method comprising the steps of: creating a feedback panel including at least one feedback response concerning said advertisement; and providing said feedback panel to said consumers, said feedback panel being activated by a consumer to provide said feedback response concerning said advertisement to said ad provider *through said interactive channel*.

85 *Ex parte Schrader*, Appeal 2009-009098

86 *Id.* at 5.

87 *Id.* at 8 (emphasis supplied)

88 Notably, however, the BPAI also provided little guidance as to how significantly tied such a method must be or why this was not simply a „field of use“ limitation.

89 *In re Bilski*, 545 F.3d at 962-63.

90 Claim 1. A method of synthesizing a set of digital speech samples corresponding to a selected voicing state from speech model parameters, the method comprising the steps of: dividing the speech model parameters into frames..., voicing information determining the voicing state in one or more frequency regions, and spectral information; computing a first digital filter using a first frame of speech model parameters...; computing a second digital filter using a second frame of speech model parameters...; determining a set of pulse locations; producing a set of first signal samples from the first digital filter and the pulse locations; producing a set of second signal samples from the second digital filter and the pulse locations; combining the first signal samples with the second signal samples to produce a set of digital speech samples corresponding to the selected voicing state.

91 *Ex parte Hardwick*, Appeal 2009-002399, 1 (BPAI June 22, 2009).

92 *Id.* at 8-9.

93 *Id.* at 7.

referring to *In re Abele*, next examined whether a transformation of electronic data was claimed so as to meet the transformation portion of the machine-or-transformation test.⁹⁴ In finding the claim insufficient to meet the transformation portion of the test, the BPAI relied heavily on the analysis from *In re Abele*, noting that claim 1 recited only synthesizing data representing speech parameters, did not recite how the samples were obtained, nor any transformation of the samples to a visual or analogous format that was human cognizable (the BPAI noted audio output).⁹⁵ The BPAI therefore reasoned that the claimed subject matter was more likened to the non-statutory claims at issue in *Abele* rather than those found statutory.⁹⁶

b) Ex parte Barnes (22 January 2009)

Claim 1⁹⁷ of U.S. Patent Application No. 11/017,450 was directed to a fault identification method using seismic data to „determine a planarity value,“ and was originally rejected by the examiner as anticipated by a number of references.⁹⁸ On appeal, however, the BPAI raised a new ground of rejection as to claim 1 for lack of statutory subject matter in view of *Bilski*.⁹⁹

In newly rejecting claim 1 and its dependents for lack of statutory subject matter, the BPAI noted that the claims recited steps related to collecting, analyzing, and displaying the data, but, apparently relying on the decision in *In re Abele*, that no details were provided as to *how* the data was collected, analyzed, or displayed.¹⁰⁰ The BPAI, noting that recitation of data-gathering and analysis steps alone constitute pre-emption of a fundamental principle, further stated that displaying of data, without any reference as to how or why it is displayed

94 *Id.* at 8.

95 *Id.*

96 *Id.*

97 Claim 1. A fault identification method that comprises: obtaining seismic data; and for each of multiple positions of an analysis window in the seismic data, determining a planarity value for discontinuities in the analysis window.

98 *Ex parte Barnes*, Appeal 2007-4114 (BPAI January 22, 2009).

99 *Id.* at 12.

100 *Id.*

constitutes only insignificant post-solution activity.¹⁰¹ Therefore, because the claim recited only the physical steps of gathering, analyzing, and displaying, no transformation could be exist, and the claim did not qualify as statutory subject matter.¹⁰²

Note that the guidance provided by the BPAI as to what was *not* recited in the claim is somewhat helpful, and it appears that the claims at issue in *Abele* may serve as a helpful drafting model going forward. In other words, rather than reciting only data collection, analysis, and display steps, the careful drafter may include details such as data origination and provisioning, as well as recitations to *how* and/or *why* the transformed data is displayed, scope and protection permitting.¹⁰³ Indeed, following the BPAI decision in this case, the Applicant amended the claims to recite that the seismic data was „produced from a seismic survey of an earth formation,“ and further that, based on the determination of the planarity value, „displaying an indication of faults of the earth formation.“ This amended claim subsequently issued on June 30, 2009 as U.S. Patent No. 7,554,883.

III. Conclusion

The current state of determining statutory subject matter with regard to claimed processes, and more particularly with regard to business methods is in flux in view of the U.S. Supreme Court review of the *Bilski* decision. In the interim, careful drafting of a patent application's specification and claims may enable many such methods to remain statutory subject matter, even under the machine-or-transformation test, which the Federal Circuit believes has basis in Supreme Court precedent.

101 *Id.*

102 *Id.* The BPAI appears to liken such a claim to claim 5 of *In re Abele*, which failed to recite how the X-ray data was collected. This deficiency was remedied by *Abele*'s claim 6, which recited a CT scanner.

103 See e.g., Fletcher, Brian, *Possible Strategies For The Bilski Machine-or-Transformation Test*, Patentability Weblog, April 17, 2009. (citing to Presentation of Nigon, Kenneth N. and Durant, Stephen C.) (accessible at: <http://www.patentabilityblog.com/2009/04/17/possible-strategies-for-the-bilski-machine-or-transformation-test/>)

Attendance and Use of Simultaneous Translation at Oral Proceedings

C. Mercer (GB)

epi has regular meetings with the Members of the Boards of Appeal at the EPO. Following the meeting in 2008, an article appeared in *epi* Information 2/2008, pages 67 and 68. This raised the problem of non-attendance at oral proceedings. Despite the article, the problem still occurs.

At the meeting in 2009, the problem of non-use of simultaneous translation at oral proceedings was raised. The Boards hold about 750 oral proceedings in *inter*

partes cases a year. In more than one third of the cases, a request for simultaneous translation is made. The request is sometimes withdrawn. In some cases, a request is made but the simultaneous translation is not used, for instance because a party decides at a late stage to address the Board in a language different from the language used by that party in the written procedure or because the person for whom the translation was intended did not attend.

In both cases, the EPO normally has to pay the translators (unless the request for translation is withdrawn at least one month before the oral proceedings). Overall, in more than 20 % of the cases where simultaneous translation was requested, the request was withdrawn too late or the simultaneous translation was not used. This imposes an unnecessary cost burden on the EPO. Needless to say, this is an unsatisfactory situation for the EPO and its finances.

These matters were discussed at the last *epi* Council meeting. As a result of the discussion, Council passed a Recommendation. This is published below. If practitioners do not follow this recommendation, the EPO may take steps to recoup wasted costs for non-attendance at oral proceedings or non-use of simultaneous translation. This could add significantly to costs incurred by parties to proceedings before the EPO and should be avoided. Please, therefore, act on the Council's Recommendation.

Recommendation

Whereas:

- (i) all *epi* members are obliged to act in a professional and courteous manner, in particular in respect of their interactions with the EPO; and
- (ii) keeping the cost of oral proceedings before Boards of Appeal to a reasonable level requires *epi* members to inform the Boards of their intentions at as early a stage as possible,

Council now hereby recommends that:

- (1) if a party to an appeal decides that it will not attend a scheduled oral proceedings, the representative of the party should, as soon as possible, preferably at least one month, before the oral proceedings:

- (a) inform the Board of the party's non-attendance,
- (b) if appropriate, inform the Board whether that party withdraws its request for oral proceedings and
- (c) if the party is an appellant, inform the Board whether the party withdraws its appeal, and

- (2) if a party has requested simultaneous translation, but it is no longer required, the representative of the party should inform the Board, as soon as possible, preferably at least one month, before the oral proceedings that it withdraws its request for such translation.

The art of gracefully renouncing what's not yours – how the Boards of Appeal have applied G1/03 and G2/03 in practice

A. Rudge (GB)

Introduction

It has been more than five years since the Enlarged Board of Appeal handed us definitive guidance on the use of undisclosed disclaimers in their identical decisions G1/03 and G2/03 dated 08 April 2004. The number of Board of Appeal decisions which cite G1/03 has grown in the meantime to 164 (as of August 2009) and this wealth of jurisprudence fills in much of the detail around the bare dicta of the Enlarged Board decisions, informing us more clearly when and how we should use disclaimers in the amendment of European patent applications and patents. This review article seeks to summarise what can be learnt from the one hundred and forty of these decisions

in which English or French is the language of the proceedings.

The Enlarged Board decisions

The main points of decision G1/03, as reflected in the headnote, are as follows: as an exception to the usual constraints of Art. 123(2) EPC, a claim may be limited by the inclusion of a disclaimer having no textual basis in the application as filed in order to restore novelty over an anticipation under Art. 54(3) EPC, in order to restore novelty over an accidental anticipation under Art. 54(2) EPC or to limit the claim to patentable subject matter in view of Art. 53(a)-(c) and Art. 57 EPC. The corollary is

that the use of an undisclosed disclaimer for any other purpose, such as restoring novelty in view of a non-accidental anticipation under Art. 54(2) EPC or excluding non-working embodiments, adds matter contrary to Art. 123(2) EPC.

It also follows that if an undisclosed disclaimer is not actually necessary to achieve one of the legitimate aims listed above, in full or in part, then it is also unallowable. Moreover, the undisclosed disclaimer must achieve the legitimate aim and no more – if it excludes more than is absolutely necessary in view of the purpose at hand then it is also unallowable. These requirements, demanding an absolute precision in assessing the disclosure of the anticipatory document and crafting the corresponding scope of the disclaimer, have caused difficulties for patent attorneys trying to apply G1/03 in practice. The strict line taken by the Boards of Appeal in applying this aspect of G1/03 is reflective of the well known approach of the Boards of Appeal in judging all matters relating to Art. 123(3) EPC.

According to the Enlarged Board, an anticipation citeable under Art. 54(2) EPC is accidental when it is 'so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention.' In coining a brand new definition for the term 'accidental', the Enlarged Board specifically dismissed several other indicators previously in currency as unfit for purpose: 'The individual elements of these and other attempts to find an adequate definition cannot be taken in isolation. The fact that the technical field is remote or non-related may be important but is not decisive because there are situations in which the skilled person would also consult documents in a remote field. Even less decisive, as an isolated element, is the lack of a common problem, since the more advanced a technology is, the more the problem may be formulated specifically for an invention in the field.' Given the austerity of the Enlarged Board's interpretation of 'accidental', in particular that implacable 'never', and its lack of approbation for previous formulations of the same test, it is not surprising that the hurdle which an anticipation must clear to be accidental now seems to be set much higher than before.

The Enlarged Board's decision also makes it clear that a disclaimer's legitimacy may be a fragile thing indeed, potentially temporal in nature and subject to constant re-evaluation in light of new facts. Thus, a disclaimer with a legitimate purpose, and which is correctly drafted in light of that purpose, is still unallowable if it inherently turns out to have an illegitimate second purpose. For example, an amendment which legitimately excludes an anticipation citeable according to Art. 54(3) EPC during prosecution may be successfully challenged under Art. 123(2) EPC in opposition proceedings if it can be shown that the abandoned area of the claim contained non-working embodiments. Similarly, an amendment which legitimately excludes an accidental anticipation citeable under Art. 54(2) EPC will become objectionable if

it can be later shown that even part of the disclaimed scope is disclosed in a further Art. 54(2) citation the contents of which would have been taken into consideration by the skilled person in making the invention.

Finally, the Enlarged Board confirmed that apart from running the gauntlet of Art. 123(2) EPC, a disclaimer must also meet all the other requirements of claimed subject matter, including the requirement for clarity and conciseness according to Art. 84 EPC.

Do the decisions have retroactive effect?

If G1/03 has changed the law in relation to disclaimers, and there is ample evidence to suggest that it has, particularly in relation to the definition of an accidental anticipation, then the new law has a retrospective effect according to decision T1076/01. Since contravention of Art. 123(2) is a ground of opposition and revocation, this means that many patents granted with disclaimers may no longer be valid (and may be difficult to amend in view of Art. 123(3) EPC). In T1076/01, a disclaimer was introduced by a patentee in order to exclude embodiments which had been shown to lack reproducibility by the opponent, clearly in contravention of G1/03, even though arguably allowable according to previous EPO procedure at the time of its introduction. The Board concluded that no transitional provisions were proposed by the decision and so G1/03 has retroactive effect.

What is a disclaimer?

The Boards of Appeal have distinguished clearly in their decisions between disclaimers and other limiting amendments and have only been willing to accord the potential benefit of G1/03 to the former. According to G1/03, a disclaimer is 'an amendment to a claim resulting in the incorporation therein of a „negative“ feature, typically excluding from a general feature specific embodiments or areas.' It should not, therefore, be '... hidden by using undisclosed positive features defining the difference between the original claim and the anticipation.'

The following cases are illustrative of the kind of limiting amendments to which G1/03 has been held not to apply. In T201/99, a patentee unsuccessfully argued that the restriction of a range '1-10 minutes' to '1-6 minutes', the latter not being disclosed in the application as filed, represented a disclaimer of more than 6 to 10 minutes. The limitation of a numerical range in a similar fashion was also ruled to fall outside the ambit of G1/03 in decision T985/06. In T285/00, in respect of a limitation to compositions wherein 'the weight ratio of the non-ionic surfactant to the dissolution aid is greater than 10:1' the Board commented that this 'so-called disclaimer contains positive instead of negative features as it would be preferable for the sake of transparency' but the point was not considered further since the disclaimer was otherwise unallowable due, inter alia, to its inappropriate breadth. This kind of positive limitation dressed up as a disclaimer inevitably ends up being impermissibly broad, as was the case in T1247/04 with a limitation in the form 'provided that if

R¹ is X then R² is Y'. This feature, being a positive limitation (a selection of compounds), rather than a disclaimer within the meaning of G1/03, was held to require explicit basis in the application as filed.

In some cases, the attempted use of a positive feature as a disclaimer has not been objected to as such but in all these cases the disclaimer has been unallowable for other reasons. In T566/03, for example, to distinguish from document disclosing a free shrink of at least 80 % at 85°C, a patentee restricted his claim to a free shrink of less than 80 % at 85°C. The positive nature of the restriction was not objected to but the term 'free shrink' was consequently construed as a feature of the invention and assigned a meaning (based on the content of the description) different from the meaning of the corresponding term in the prior art document (as construed from common general knowledge) and the disclaimer was therefore of an inappropriate scope and unallowable. Similarly, in T795/05, there was no objection to the positive formulation of 'and the mole ratio of aluminium in any alumoxane activator to the transition metal being above 100' but the 'disclaimer' was unallowable for other reasons.

Does G1/03 apply to disclaimers introduced to prevent double patenting?

The extent to which the subject matter of a European patent application can be split up and parcelled in separate divisional applications without contravening the unwritten prohibition on double patenting is a matter of topical debate following decisions such as T307/03 (recently published in the Official Journal) and T936/04. One way to prevent any impermissible overlap between such divisionals is to disclaim the subject matter which has already been granted. In decision T1139/00, the Board considered that the rules of G1/03 did not apply in such a situation: '... G1/03 confined itself to the consideration of those cases where a disclaimer is employed in order to restore novelty in cases where documents under Art. 54(3) and 54(4) are revealed after the application date or to disclaim subject-matter excluded from patentability for non-technical reasons. G1/03 did not consider the case of conflicting applications having the same applicant and the same application date, e.g. the case of parent and divisional applications. For these reasons the Board is of the opinion that the conclusions of G1/03 do not apply to the present case.' Instead, principles derived from G1/93, relating to any possible unwarranted advantage gained by the proprietor were applied. In allowing the amendment, the Board concluded that 'The effect of the "disclaimer" in the claims is to exclude one particular process from the group of processes, to leave a more limited group, which merely narrows the scope of the claims.' However, this decision does not sit particularly well in the company of the decisions discussed below which consider that the disclaimer of a disclosed embodiment of the invention contravenes Art. 123(2) – the purpose of amendment in the two cases may be different but the end result is the same.

Does G1/03 apply to the disclaimer of a disclosed embodiment of the invention?

Some applicants and patentees, desiring to avail themselves of a disclaimer not meeting the stringent requirements of G1/03, have attempted to argue before the Boards of Appeal that subject matter disclosed in the application as filed can always be disclaimed, even if originally disclosed as an embodiment of the invention rather than as subject matter to be avoided. However, the Boards of Appeal have consistently expressed the view that a disclaimer is only properly based on the contents of the application as filed when the disclaimed subject matter is originally disclosed as being excluded from the invention. Thus, according to the Board in T1050/99, '... there is a basis in the application for the subject-matter which is excluded in the claim. However, that subject-matter is presented as a part of the invention, not as an area which should be excluded or avoided. In the same sense, the disclaimer is in fact an "undisclosed" disclaimer because there is no disclosure in the application as filed of the disclaimer per se.' Similarly, the Board in T868/04, judging whether the disclaimer 'with the proviso that imidazoles are excluded' was based on the disclosure of the application as filed concluded that the passage in the description cited as basis '... directly and unambiguously discloses imidazoles as forming part of the invention, and not as being excluded therefrom.' Similar comments are found in T1559/05 and T1268/06.

And then, unexpectedly, comes T1107/06 which decides exactly the opposite. In this carefully reasoned decision, the Board considers that disclaimers should be allowable if the subject matter of the disclaimer is disclosed in the application as filed, regardless of the sense of the disclosure, G1/03 dealing only with disclaimers whose subject matter was not disclosed at all. Unfortunately, the Board did not refer questions back to the Enlarged Board and now applicants are forced to hedge their bets in seeking to disclaim a disclosed embodiment before an unwilling first instance.

When is an anticipation accidental?

Following G1/03, convincing a Board of Appeal that an anticipation in a document citeable under Art. 54(2) EPC is accidental represents a significant challenge. The Enlarged Board's exhortation that the remoteness of neither the technical field nor the problem addressed were individually decisive, seems to have been interpreted to mean that only anticipatory documents which both address a different technical problem *and* are located in a different technical field would never have been taken into consideration by the skilled person. Thus, anticipations in Art. 54(2) documents which address the same problem in an unrelated technical field, or which address an unrelated problem in the same technical field are now very difficult to successfully disclaim.

In respect of the latter situation, for example, consider decision T134/01 in the pharmaceutical field, in which the Board considered compounds disclosed in a 1948 US

patent as analeptics (CNS stimulants) to be non-accidental anticipations of a claim directed to compounds which bind to the FK-506 binding protein and are hence useful as immunosuppressive agents: 'Thus, document (5) belongs to the same technical field, namely to the field of pharmaceuticals, as does the claimed invention. Since this document has not „nothing to do with the invention“ and is not „so unrelated and remote“ from the invention that it would never have been taken into consideration, it is not an accidental anticipation within the meaning of decisions G1/03 and G2/03.' This is a very harsh conclusion indeed and rather out of touch with the way skilled people in the pharmaceutical field actually operate. It is hard to see why compounds disclosed in a document such as document (5), which would never have been taken into account in the assessment of inventive step, should be classed as non-accidental anticipations just because they relate to the same general technical field. The same approach was taken in T0782/03 in relation to sunscreens: 'Document (3) relates to the formulation of sunscreen compositions. Thus, document (3) belongs to the same technical field as does the claimed invention and thus is not an accidental anticipation within the meaning of the decisions G1/03 and G2/03.' Decisions in the field of detergents, such as T1924/06, also conform to the general rule that anticipations in the same technical field are non-accidental even if they address a different problem. Decision T584/01 is also illustrative of the same point, the invention relating to the use of vitamin E to improve the penetration of topically applied compositions containing a non-steroidal anti-inflammatory agent and the relevant prior art document disclosing pharmaceutical compositions for external use containing an anti-inflammatory agent and vitamin E without discussing the issue of penetration. The Board stated: 'It is therefore evident that this prior art is closely related to the invention defined in present claim 1' and 'The skilled person would have taken this prior art into consideration when working on topically-applied compositions comprising an anti-inflammatory agent.' When the anticipatory document is the closest prior art for determining inventive step there is understandably little chance of arguing for an accidental anticipation, regardless of whether a different problem is addressed (see T540/05 and T1141/05).

In view of these decisions, the Board in decision T298/01 seemingly applied a different standard when considering the disclaimer of 'a reagent consisting of a mixture of potassium trifluoroacetate and 1,3,5-trinitrobenzene in DMF or DMSO' (translation from the French original) as accidental. The anticipated claim was directed to a reagent useful in the preparation of fluoroalkyl sulphinic and sulphonic acids and the relevant Art. 54(2) prior art document disclosed a reagent for converting 1,3,5-trinitrobenzene to 1,3,5-trinitro-2-trifluoromethylbenzene. The prior art document therefore related indisputably to the same technical field, disclosing a reagent for use in organic synthesis, but the reactions described, both mechanistically and in terms of the products prepared, were unrelated.

Naturally, anticipations relating to the same technical field as a claimed invention and solving the same overall problem have little chance of passing as accidental. In the pharmaceutical area, for example, two decisions have suggested that prior art compounds having a therapeutic application in common with the compounds of an anticipated claim cannot be disclaimed as accidental anticipations (see T639/01 and T580/01). In the words of T639/01: '... document (1) thus being state of the art within the meaning of Art. 54(2) EPC does not represent an accidental anticipation as defined in G1/03, since it is concerned with anti-inflammatory agents as is the present application.'

Decisions concerning anticipations in a different technical field relating to the same problem include T507/99 concerning coated glass compositions. The invention was intended to find application as a glazing material in the automobile field whereas the teaching of the anticipatory document concerned building materials. In this case it was even admitted that the prior art document would not have made invention obvious but the coated glass materials in both cases had common properties and the anticipation was consequently not accidental. In T0438/02 the Board of Appeal decided that an anticipation citeable under Art. 54(2) EPC relating to laundry detergents containing proteases was not accidental in relation to a claim directed to dishwasher detergent also containing a protease since in both cases the basic objective was the removal of soil and the skilled person working in either field would be expected to keep in mind the state of the art in the other.

For decisions which confirm that an anticipation in a different technical field which relates to the solution of a different technical problem is accidental and may be disclaimed, see, for example, T1035/03 (claimed invention related to compounds having pharmaceutical activity; prior art documents disclosed anticipatory compounds useful in spectroscopic and synthetic methods) and T426/98 (claimed invention related to compositions useful as well servicing fluids; prior art document disclosed an anticipatory composition used in a theoretical study into chemical interactions).

It is clear from a number of decisions that what counts when assessing whether an anticipation is accidental or not is the general teaching of the document in which the anticipation is contained, regardless of the relevance of the actual anticipatory embodiment to the claimed invention. Thus, if the general teaching of a prior art document would have been taken into consideration by the skilled person when making an invention, then it is impermissible to disclaim any teaching in that document, including comparative examples which are included expressly in view of their differences from the general teaching of the document or which even teach away from it. This principle was expressed in T739/01 in the following terms: 'In the circumstances, it does not matter if the skilled person finds reasons in the cited prior-art document that make him believe that a particular novelty-destroying embodiment in its context appears accidental. As long as the document in which this embodiment is set out relates to

the same technical field as the alleged invention, the anticipation is related and not remote.' In this decision the relevant prior art document disclosed lithium compounds for use in the treatment of Alzheimer's disease, including lithium acetylsalicylate as an acceptable salt, whereas claimed invention related to the use of non-steroidal anti-inflammatory compounds in the treatment of Alzheimer's disease. Concerning comparative examples, reference may be made to T1146/01, in which the Board concluded that although the anticipatory comparative example in the prior art provided a teaching not to be followed, this does not mean that their information is not part of the disclosure of D1 or would not be considered by an inventor working on his invention' and T1119/05 in which the Board concluded that the anticipatory comparative example, although outside the invention claimed in D1, is still closely related to the invention of D1 and serves to elucidate the teaching of the document as a whole.' A similar conclusion was reached in decision T208/01.

Finally, in T14/01, the Board had to consider an alleged accidental anticipation which addressed an alternative solution to the problem addressed by the claimed invention. The Board indicated that even if the prior art document could be considered to teach away from the claimed invention, the anticipation would still not be accidental since: 'The Appellants' allegation that the person skilled in the art would have extracted from Document (3) a teaching leading away from the present invention actually hypothesises what the skilled person would have done *after* having taken Document (3) into consideration. For an anticipation to be accidental it is instead necessary that the skilled person would have *never* taken this prior art into consideration when working on the invention.'

Disclaimers based on prior art which is not novelty-destroying

According to the Enlarged Board, a disclaimer must be carefully drafted in order to achieve one of the legitimate purposes identified in G1/03 – no more and no less. A disclaimer which limits a claim when no limitation is necessary is therefore clearly unallowable, a principle expressed by the Board of Appeal in decision T474/00 in the following way: 'Since in the absence of a novelty-destroying disclosure disclaimer (1) thus removes subject matter without any need to do so, that disclaimer necessarily removes more than is necessary to restore novelty, which is not allowable according to the order 2.2 of G1/03.' The disclosure of any prior art must therefore be examined with care in order to assess whether any potential novelty-destroying embodiment is really clearly and unambiguously disclosed. In T474/00 the esters of pentaerythritol and iso C9 acid described in the prior art would only have been novelty destroying in the case of full esterification but the document was silent on this matter. In T1345/04 the disclaimed prior art was held not to be novelty destroying since, '... specific combinations from the five categories of ingredients listed in document (19) and reflected in the disclaimer have to be selected to

form the perfume composition ...'. Thus, although the claim and the prior art disclosure overlapped, the prior art did not directly and unambiguously disclose an embodiment which was novelty destroying and needed to be disclaimed. Other cases of the same kind include T544/05 and T107/07 – in the latter case the proprietor even concurred that the Art. 54(3) prior art in light of which the disclaimer had been crafted was not novelty destroying.

Disclaimers which do not limit the scope of the claim

If the wording of a disclaimer means that it does not actually limit the scope of a claim, either *ab initio* or in view of supplementary amendments made at a later date, then it should be possible to delete it in order to meet the requirements of Art. 123(2) EPC and, in post-grant proceedings, Art. 123(3) should not be a concern. Curiously, in T724/03, such a superfluous disclaimer, which was introduced in claim 1 during grant proceedings and became unnecessary in view of the combination of claims 1 and 4 during opposition proceedings, was not deleted. Nevertheless the Board sensibly concluded that the disclaimer did not give the patentee an unwarranted advantage and should not render the claim invalid: 'Under these circumstances, the disclaimer merely excludes subject-matter which is in any case already excluded from the scope of the claim by virtue of the further amendment and the disclaimer does not therefore provide any technical contribution.' It may also be the case that a disclaimer properly excludes anticipated subject matter from a claim but also refers to additional subject matter which is outside of the scope of the claim. This may particularly be the case when the claim in suit and the anticipatory prior art are described in different terms and the wording of the disclaimer is based directly on the wording of the prior art document in order to remove no more than necessary from the claim. In this case, one may have expected similarly clement treatment since the superfluous part of the disclaimer does not limit the claim in any way and cannot therefore put the applicant or patentee in a better position. However, the Board in T1345/04, judged differently the allowability of a disclaimer based on the wording of an Art. 54(3) citation which 'excluded' some subject matter which did not fall within the scope of the claim: 'The disclaimer thus removes subject matter which does not anticipate the subject matter of the product claims in the absence of said disclaimer. It thus inevitably removes more than is necessary to restore novelty vis-à-vis document (19) and, hence, does not amount to an allowable disclaimer.' This reasoning is puzzling since a disclaimer cannot 'remove' subject matter that does not fall within a claim in the first place.

Disclaimers which are too broadly drafted

As with disclaimers based on prior art which is not novelty-destroying, disclaimers which remove more of the subject matter of a claim than is actually disclosed in the prior art are clearly unallowable according to the principles set out in G1/03. There are very many decisions which illustrate this point, possibly as a result of appli-

cants and patentees seeking to limit their claims for other well understood reasons. For instance, in T285/00 a disclaimer allegedly crafted in view of Art. 54(3) anticipation but which was broader than necessary, also excludes non-accidental anticipations disclosed in an Art. 54(2) citation.

The use of an inappropriate positive limitation of a claim rather than a true disclaimer usually results in an improperly broad limitation as discussed above (see T201/99 and T566/03). Equally, genuine mistakes can be made with the scope of a disclaimer when the general teaching of a document is taken into account and only specific embodiments are held to be novelty-destroying. See T795/05 where such an error was made and T426/00 where the general teaching was correctly ignored by the patentee and the opponent's arguments to the contrary were rejected by the Board. The scope of a disclaimer will also be too broad when one or more limitations relating to the relevant prior art anticipation are left out, as was the case in T10/01 where a disclaimer was based on only one part of the passage in which the anticipation was disclosed: 'what is disclaimed is a fusion protein comprising any portion of the HBsAg protein irrespective of whether or not it is capable of forming particles whereas document (1) discloses fusion proteins comprising only these portions of the HBsAg protein which are capable of forming particles.' Cases which further illustrate this pitfall include T1050/99, T33/06, T1847/06 and T1141/05.

Other problems can arise when the features of the disclaimer are drawn partly from the claim itself and partly from the relevant prior art document. If the features drawn from the claim are ascribed a broader meaning in the patent or application in suit than the same feature is given in the prior art then the disclaimer will be overly broad. For this reason, it is safer to base the wording of a disclaimer exclusively on the features of the anticipatory prior art. In decision T580/05, a disclaimer referred to an antibody molecule, which was the subject matter of the claim, not having certain sequences disclosed in the prior art. However, the term antibody molecule had a special meaning according to the patent which was broader than the antibody described in the prior art document and as a consequence the disclaimer was broader than necessary and unallowable.

Although there do not seem to be any specific examples in the case law yet, G1/03 does seem to suggest that a disclaimer drafted too broadly may be nevertheless allowable in order to avoid a lack of clarity. The Enlarged Board stated that: '... the understanding of a claim may be considerably complicated if the terminology of the application-in-suit and of the application differ and different, incompatible terms are used in the claim. Here, Article 84 EPC may require that the terminology be adapted in order to exclude what is necessary to restore novelty.' This was interpreted by the Board of Appeal in T10/01 to mean that '... a disclaimer being broader than strictly necessary to restore novelty may, depending on the circumstances of the case be allowed, if this turns out to be necessary to avoid an otherwise resulting unclarity (sic) of the claim.'

Disclaimers which are too narrowly drafted

When a disclaimer is drafted too narrowly and does not fully exclude a prior art teaching from the claim in suit then its inappropriate scope will once again deny it the safe harbour offered by G1/03. Although the inevitable lack of novelty is perhaps the more serious deficiency, the claim will be refused for non-compliance with Art. 123(2) EPC. This situation can arise, in counterpoint to one of the topics considered above in relation to overly broad disclaimers, when a specific prior art embodiment has been disclaimed without taking into account the general teaching of the document disclosing this embodiment. In decision T440/04 the proprietor had disclaimed a specific example from a prior art Art. 54(3) citation but the Board considered that the disclosure of the document, taking into account its general teaching, went further than this example: 'Whereas on the one hand a disclaimer should not remove more than is necessary to restore novelty, it cannot, on the other hand, be considered to serve its intended purpose where it excises less than what is necessary to restore novelty'. The Board concluded that 'Since the disclaimer does not serve its intended purpose, its insertion into the respective claims 1 of all requests is an amendment which is not allowable pursuant to Art. 123(2) EPC in accordance with decision G 0001/03.'

The wolf dressed in sheep's clothing

Finally, a disclaimer can be properly based on an Art. 54(3) or accidental Art. 54(2) anticipation and be drafted with the correct scope in view of this anticipation and yet turn out to add subject matter when it is revealed to have an unallowable ulterior purpose. In decision T788/05, for example, a disclaimer which properly excluded the overlapping disclosure of Art. 54(3) document was found to be unallowable since it also partly excluded the disclosure of non-accidental Art. 54(2) citation.

Conclusions

The main conclusion that can be drawn from the decisions discussed above is that both the suitability and the scope of any proposed undisclosed disclaimer needs to be very carefully considered following decisions G1/03 and G2/03. In many cases, it may be more prudent to choose a limiting amendment based on the disclosure of the application as filed, even if the scope of protection obtained will necessarily be narrower. Particular care needs to be paid in assessing whether an anticipation citeable under Art. 54(2) can be classed as accidental, but a general caution needs to be exercised in considering whether a disclaimer which would otherwise be allowable might simultaneously exclude non-working embodiments or further prior art which could be not classed as an accidental anticipation. If a disclaimer is finally chosen as the most suitable amendment then it must be drafted with the utmost precision. The disclaimer must be framed properly as a negative feature. Its wording should be based solely on the wording of the prior art and include all the limitations which form part of

the anticipatory embodiment in order to avoid excessive breadth. At the same time, the general teaching of the prior art document needs to be taken into account where appropriate to ensure the disclaimer is not too narrow. And, ideally, the scope of the disclaimer should not exceed the scope of the claim being amended.

Acknowledgement and disclaimer

My thanks are gratefully extended to Claire Laurent, who went through the relevant decisions in the French language and pointed out to me the points of interest. And, finally, the last disclaimer to be discussed in this article is the one that confirms that all the views expressed above are the personal opinions of the author and not necessarily those of the legal person that employs him.

Artikel von Frischknecht/Kley zu den Änderungen an der Ausführungsordnung des EPÜ 2000, hier: R70a, epi-Information 3/09

Kommentar von P. Roos (DE)
epi-Mitglied

Mit Interesse habe ich Ihren im Betreff genannten Artikel betreffend die „chaotische Gesetzgebung“ des EPA-Verwaltungsrates gelesen. Ich kann Ihnen und Herrn Kley nur voll zustimmen. Vielen Dank also dafür, dass Sie sich dieser längst überfälligen Thematik angenommen haben

– einschließlich der Bedenklichkeit des neuen Art. 33 EPÜ. In Anbetracht einschlägiger historischer Erfahrungen ist es schon befremdlich, mit welcher Selbstverständlichkeit derartige „Reformen“ heutzutage durchgewunken werden.

Kommentar von I. Heinzelmann (DE)
epi-Mitglied

Die Anmerkungen von Frischknecht/Kley zu der *neuen Regel 70a* halte ich für zutreffend. Es ist schon erstaunlich, dass demnächst aufgrund einer Mängelmitteilung der *Recherche*abteilung eine europäische Anmeldung bei fehlender Stellungnahme durch den Anmelder als zurückgenommen gilt.

Hier läuft doch u.U. Art. 94 (3) ins Leere, der bestimmt, dass die *Prüfungs*abteilung prüft und den Anmelder „so oft wie erforderlich“ auffordert, eine Stellungnahme einzureichen. Einmal abgesehen davon, dass die künftige Regelung möglicherweise gesetzes-technisch problematisch ist, ist bemerkenswert, dass die neue Regelung demnächst zwei in Reihe geschaltete

materielle Prüfungen ermöglicht. Ob der Gesetzgeber das gewollt hat? Die Auffassung der Autoren, dass der Verwaltungsrat hier seine Kompetenzen überschritten hat, ist meiner Meinung nach begründet.

Dieses Vorgehen zwingt Anmelder ggfs zu einem sehr frühen Zeitpunkt, im europäischen Verfahren Weichenstellungen vorzunehmen. Anmelder, insbesondere Großunternehmen mit Industriepatentabteilungen könnten daher zukünftig kritischer prüfen, ob eine europäische Anmeldung eingereicht werden soll.

Wäre hier nicht eine Stellungnahme seitens *epi* angebracht (Verwaltungsrat, Aufsichtsrat, SACEPO)?

Disziplinarorgane und Ausschüsse
Disciplinary bodies and Committees · Organes de discipline et Commissions

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