

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

### **I – Information concerning epi**

59 Committee Reports

68 EPO Information: Seminar „Boards of appeal and key decisions“

69 European Patent Attorneys Excess Liability

### **II – Contributions from epi Members and other contributions**

71 Article 123(2) EPC, Recent Case Law and a Chessboard, by Christian Köster

78 Monumental Changes to U.S. Patent Law: Issues Related to the Implementation of the Leahy Smith America Invents Act, by P. Stephenson and R. S. M. Gorman

87 Statistical Advice for Passing the EQE Pre-Exam, by O. Griebeling

89 Letters to the Editor

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## Table of Contents

<b>Editorial</b> . . . . .	58
----------------------------	----

### I – Information concerning *epi*

#### Committee Reports

Report of the Professional Qualification Committee, by P. Rambelli. . . . .	59
Report of the European Practice Committee, by F. Leyder. . . . .	62
Report of the Harmonisation Committee, by F. Leyder. . . . .	63
Report of Biotech Committee, by Ann de Clercq . . . . .	64
Report of the EPO Finances Committee, by J. Boff . . . . .	66

#### Education and training

<i>epi</i> Tutors' Meeting in Berlin on September 18, 2012. . . . .	67
<i>epi</i> Mock EQEs and <i>epi</i> Seminars 2012 . . . . .	68
Tutors wanted . . . . .	68
EPO Information: Seminar „Boards of appeal and key decisions“ . . . . .	68

#### Information from the Secretariat

Next Board and Council Meetings. . . . .	69
European Patent Attorneys Excess Liability. . . . .	69
<i>epi</i> meeting room for <i>epi</i> members . . . . .	67
European Patent Attorneys Excess Liability. . . . .	69

Important Information for <i>epi</i> Members having their place of registration in Switzerland . . . . .	70
Deadline <i>epi</i> Information 4/2012. . . . .	58
Contact Data of Legal Division. . . . .	70
Dates of forthcoming issues of <i>epi</i> Information . . . . .	63
<i>epi</i> Disciplinary bodies and Committees . . . . .	93
<i>epi</i> Board . . . . .	U3

### II – Contributions from *epi* Members and other contributions

#### Articles

Article 123(2) EPC, Recent Case Law and a Chessboard, by Christian Köster . . . . .	71
Monumental Changes to U.S. Patent Law: Issues Related to the Implementation of the Leahy Smith America Invents Act, by P. Stephenson and R. S. M. Gorman . . . . .	78
Statistical Advice for Passing the EQE Pre-Exam, by O. Griebing . . . . .	87

#### Letters to the Editor

Über Jurisprudenz im Patentrecht, von G. Kern . . . . .	89
Beitrag angeregt durch den Artikel von Herrn Dr. A. Kumm: „Die Crux mit der erfinderischen Tätigkeit und die schweizerische Chance ihrer operablen Bewertung“ ( <i>epi</i> Information 1/2012, S. 22/23), von S. V. Kulhavy . . . . .	90

## Editorial

T. Johnson (GB)

The summer is drawing to a close, not that there has been much to speak of weather-wise from the UK side of the Channel. While economic woes continue to cause concern, the Olympics have perhaps taken our minds off the weather and the world-wide economy, so we congratulate all of those from the member States who took part in the Olympics, particularly if medals of any colour were won.

The marathon is one of the Olympic events, and brings to mind two IP marathons of continuing interest. One is of wider interest to applicants, business, Member States and our members, namely the fate (?) of the Unitary Patent. This is particularly so bearing in mind the stance of the European Parliament in response to the European Council's seeming agreement to cancel clauses 6-8 of

the draft law on the Unitary Patent. We await the Parliament's deliberations with interest.

A second marathon, more on the *epi* home front, is the work being done not least by the Editorial Committee, to create a re-vamped *epi* website, which it is hoped will be more user-friendly and accessible to users. Outside consultants have been involved, and they have made a positive contribution in the Committee's view. It is hoped to give a presentation of the new web-site to Council at the Hamburg Council meeting on 10th November 2012.

Stamina, perseverance, (and perhaps a little hope) are needed to complete a marathon, so we hope for a successful conclusion to the two IP marathons referred to above.

### Nächster Redaktions- schluss für *epi* Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **2. November 2012**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu 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 **2<sup>nd</sup> November 2012**. 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 **2 novembre 2012**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

# Report of the Professional Qualification Committee

P. Rambelli (IT)  
Chair of PQC

A PQC meeting was held in Vienna at the EPO premises on 30 March 2012, attended by 27 representatives. The meeting was also attended by Mr Tony Tangena, *epi* President, Ms Gabriele Leissler-Gerstl, *epi* Vice-President, Ms Mihaela Teodorescu, *epi* Vice-President and Presidium PQC liaison member, and Mr Karl Rackette, Director of Education, all as invited guests.

Mr Richard Flammer, Principal Director Patent Information and European Patent Academy gave an opening speech focusing on the willingness by the EPO President to improve the present situation of the European patent attorneys' profession by increasing the number of EQE qualified patent attorneys, particularly in those countries where at present the number of EQE qualified representatives is not satisfactory (less than five). The improvement plan requires a comprehensive approach to the training for EQE, which could be carried out by the EP Academy, in cooperation with *epi* and national Patent Offices. Such a comprehensive approach would involve the definition of standard EQE preparation courses and further improvement of the e-learning modules. There is a need to tailor the EQE preparation courses to the needs of individual countries and PQC can have a relevant role, particularly in the cooperation with NPOs for customised training.

The EP Academy has funds to subsidy and develop EQE training; it is however necessary to synergise the existing funds and manpower resources in order to achieve the intended goals.

To achieve said intended goals, at the present date, the EPO has set up the EQE Candidate Support Project (CSP) with the specific aim of ensuring that candidates selected to participate attain an adequate level of knowledge such that they successfully pass the EQE.

A core element of the project is the provision of an extensive training programme, jointly developed by the EPO, the *epi* and CEIPI, with the NPOs as active stakeholders.

The 21 candidates from 19 selected countries (those where the number of EQE qualified representative is less than 5), already enrolled for the pre-examination 2013, have been invited to apply for the training programme which will take place in the period from September 2012 to February 2013. The candidates who will be eventually selected will receive free training and tuition, training material and customised tutoring and coaching for the preparation of the pre-examination.

The training project is intended to be continued in 2013 for the preparation to the EQE 2014.

In the following, the major PQC activities carried out or in progress, in the recent period, will be briefly discussed.

## 1. Pre-examination and pre-examination training

The first pre-examination was held in Munich on 5 March 2012 and the pre-examination paper and relating Examiner's Report have been made available on the EPO website. The paper includes 10 legal questions and 10 claim analysis questions, each including 4 false/true statements.

The pre-examination was sat by 390 candidates with a substantial reduction (about 35-40 %) with respect to the number of first sitters in previous EQEs.

The results, published in May 2012, show a pass rate close to 99 %. On the basis of the available preliminary comments from candidates and tutors, the pre-examination was considered easier than expected (in comparison with the difficulty of the Mock pre-examination tests released by the EPO in 2011); the very high pass rate seems to indicate that the pre-examination, for the time being, has acted as a filter at the time of enrolment, rather than as a filter based on difficulty of the test itself.

### 1.1 Pre-examination training

PQC has cooperated with the EP Academy in the pre-examination training course, which was held in the period from November 2011 to February 2012.

For the purpose of the pre-examination course, a relevant amount of new training material was developed ad hoc both by the *epi* tutors and EPO Examiners.

Particularly *epi* tutors have been directly involved in providing simple and multiple questions relating to the legal part of the pre-examination and case studies for the claim analysis part and as lecturers in virtual classrooms.

A preliminary survey carried out by the Academy among the candidates enrolled with the pre-examination course shows that the information made available on the website and the training material were considered as satisfactory, although improvement is needed particularly in connection with the virtual class rooms. Virtual class rooms are considered the appropriate tool for training candidates in individual countries; however, it is agreed that the tutors involved should get a specialised training for giving online courses.

Preparation for the next e-learning course due to start in the first week of September 2012 is now well advanced. The course is divided into a series of modules, each of which is three-week long (each module will be released onto the website every three weeks).

The number of *epi* tutors assisting the Academy has been raised to 15.

Our special thanks goes to the *epi* tutors who have positively answered to our call for available tutors and who contributed a very important part of the training material.

## 2. CPE seminars

In the year 2011 we celebrated the ten-year anniversary since the first CPE seminar was organised by the PQC in Copenhagen (28 May 2001) on the topic "Oral proceedings at the EPO". Mr Daniel Thomas, EPO Director chaired that seminar; in the same year, the second CPE seminar on the same subject was held in Milan on 13 December.

At that time, *epi* took responsibility for the practical arrangement of the seminars, Mr Thomas provided the case study and PQC members were directly involved, both in providing didactic material for the seminar and as actors for the Mock oral proceedings.

Clearly, since then the situation has changed and CPE seminars are an established reality.

In year 2012, the following CPE seminars are envisaged.

### 2.1 Guidelines-2DAY seminars

The 2012 substantially revised edition of the Guidelines for Examination has been made available in its English draft on the EPO website in March 2012. The Guidelines were published in all three official languages in June 2012 and became legally binding. In September 2012 the paper publication is expected.

The revised Guidelines edition has a totally new structure and a new content, so that information to the users is deemed to be necessary.

To this end, specific seminars, called "Guidelines2DAY" seminars, have been organised by the EP Academy and *epi* with the coordination of the *epi* Director of Education.

The goal to be achieved is helping EP practitioners in mastering the changes in the Guidelines, thereby to increase efficiency in daily work; the targeted audience are EPA of "average skill in the art". The language for the seminars will be mainly English, but national language is not to be excluded in some targeted countries.

The first kick-off seminar was held in Munich on 11-12 June 2012, with 140 participants.

National seminars (one day) have already been scheduled in September-December 2012 in Milan, Copenhagen, London, Eindhoven and Istanbul.

### 2.2 Further CPE seminars

It is intended to continue to offer the traditional CPE seminars, in spite of the quite heavy burden caused by the new Guidelines 2DAY seminars. The offered/requested topics include for 2012:

- Amendments
- Mock opposition
- Opposition and appeal
- PCT
- Oral proceedings
- Understanding Examiner's Communication
- Patent portfolio management.

The first seminar on "Patent Portfolio Management" was held in Munich on 7 December 2011, with four speakers: Mr Tony Tangena, Mr Dieter Reinhardt, Mr

Peter Bittner and Prof. Alexander Wurzer. It was attended by 38 participants.

A Train the Trainers follow-up seminar was held in Warsaw on 23-24 March 2012 on the topics:

- National law relating to EPC
- National phase of Euro-PCT applications and successful opposition in chemistry.

CPE seminars have been held in Oslo on "EPC2DAY", in Helsinki on "Mock Oral Proceedings" and in Istanbul on "EPO Procedures".

Since 2010 CPE seminars have been developed and offered also for administrative staff and paralegals. In October 2012 seminars for paralegals will be offered in Munich on the new topic "Handbook of Quality Procedures before the EPO" and in Warsaw on "PCT".

## 3. *epi* tutorials

The summer and autumn tutorials for year 2012 have already been announced on the *epi* website, according to the usual format and schedule. The summer tutorial offers to the trainees a choice among examination papers of 2009, 2010 and 2011 and the autumn tutorial a choice among examination papers of 2010, 2011 and 2012.

The PQC Working Group on *epi* tutorials is presently working on defining proposals for improvement of the tutorials to provide more customised training. The Working Group is also focused on improvement in the establishment of a tutor's network and on improvement and harmonisation of tutoring capabilities.

As a first step to achieve such a goal, an *epi* tutors' meeting has been organised in Berlin in September 2012.

## 4. Working Group online self-testing

The above-identified Working Group was established under the Memorandum of Understanding. According to the latest report received from Derek Jackson, the Working Group activity has recently be overshadowed by the Academy/*epi* pre-examination course, which has taken many of the ideas from the Working Group, as well as the time available, and introduced them into the e-learning course for the pre-examination.

The Working Group completed a paper A chemistry exercise and paper D exercise, both of which had been on the Academy website for some time but were removed when the pre-examination course was introduced. In addition, there is a partly finished paper A E/M exercise. Material has been gathered for a priority date exercise, which is about 50 % complete.

It is a preliminary conclusion by the Working Group members that indeed a considerable amount of training for EQE can be carried out as "e-learning exercises". This is confirmed by recent development in the training material for the pre-examination course. Bottle necks in the development of the e-learning exercises are how-

ever the need to find people available to provide the necessary exam-like case studies and finding the best way to convert the case study material into a e-learning material.

## 5. Mock EQEs

Mock EQEs were held in:

- Helsinki, 1-3 November 2011 with a feedback session in the period 30 November-2 December 2011 with 18 participants,
- Munich, 5-7 December 2011, with a feedback session in the period 31 January-2 February 2012 with 20 participants.

A Mock EQE has been scheduled in Helsinki for the year 2012. 15–17 October 2012 Mock EQE, 14–16 November 2012 Feedback session

## 6. EQE statistics

PQC believes that appropriate statistics on the EQE constitute an essential tool in order to tailor the needs for EQE training in individual countries. The EP Academy shares the same view. Whereas the recent statistics published by the EPO for 2010 and 2011 EQE do not allow to evaluate the EQE pass rate of the overall examination or of individual papers with reference to first sitters, it is believed that first sitters' performance provides relevant information in order to better evaluate needs for additional or improved training.

Also, the introduction of the pre-examination requires the publication of detailed statistics on the candidates' performance, possibly allowing differentiating between performance in the legal part and claim analysis part.

It has been agreed with the European Qualifying Examination Board and the EP Academy that more detailed statistics will be released in the near future both for the pre-examination and EQE.

## 7. EQE 2013: fee increase

The decision of the EPO President of 2 February 2012 (O.J. EPO 3/2012, page 210), which is binding for payments made after 1 April 2012, has increased the basic fee for the EQE which is now fixed at € 200.

The new basic fee corresponds to:

- ~ 43 % increase with respect to 2012 (basic fee € 140),
- ~ 67 % increase with respect to 2010 (basic fee € 120),
- ~ 122 % increase with respect to 2009 (basic fee € 90).

In view of the newly applicable basic fee, the cost for the full examination is as follows:

- EQE year 2013:
  - 5 basic fees (registration + 4 papers) = € 1000
- Pre-examination:
  - 2 basic fees (registration + 1 paper) = € 400; the pre-examination also requires additional travel and accommodation costs.

In addition to the above, the fee structure according to the IPREE requires for year 2013:

- 150 % of the basic fee for sitting a paper for the third time (computed as off 2010)
- 200 % of the basic fee for sitting a paper for the fourth time (computed as off 2010).

The only good news is that the announcement of the EQE 2013 contemplates examination fee subsidies for candidates permanently resident and working in EPO member states: AL, BG, HR, CY, CZ, EE, MK, GR, HU, LV, LT, MT, PL, RO, RS, SK, SI or TR.

The fee increase has been justified by the EPO on account of the too low cost coverage of the EQE activities by the fee income. Whereas *epi* was indeed consulted prior to the fee increase by the EPO, the *epi* position according to which measures should be taken in order to reduce the EQE cost, prior to deciding any fee increase, was not successful. A specific report on such an issue is provided by the *epi* President.

## 8. Director of Education

Since July 2011, Mr Karl Rackette acted as Director of Education of the *epi* on the basis of an "independent consultant agreement".

Following his resignation by the end of July 2012, the DoE position is presently vacant.

At present, Ms Martina Fromm and Ms Jacqueline Kalbe of the *epi* Secretariat are in charge of all organisational activities relating to education and training events.

Information about  
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Rules governing payment of the *epi* annual membership fee  
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# Report of the European Practice Committee

F.Leyder (BE)  
Chair of EPPC

## Report of the EPPC Chairman

This report completed on 14.08.2012 covers the period since my previous report dated 22.05.2012.

The EPPC is the largest committee of the *epi*, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT, and (3) the future EU Patent Regulation, including any revision thereof, except all questions in the fields of other committees: Biotech, OCC, PDC, LitCom, and EPO Finances.

The EPPC is presently organised with seven permanent sub-committees (EPC, Guidelines, MSBA, EPO-*epi* Liaison, PCT, Trilateral & IP5, and Unitary Patent). Additionally, ad hoc working groups are set up when the need arises.

## DG3

### 1. MSBA

The tradition of annual meetings with the Chairmen of the Boards of Appeal will continue, and the date of the 19th meeting has been set for 03.12.2012.

## UNITARY PATENT

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

On 29.06.2012, the Council reached an Agreement on "the last outstanding issue of the patents package", but added: "We suggest that Articles 6 to 8 of the Regulation implementing enhanced cooperation in the area of the creation of unitary patent protection to be adopted by the Council and the European Parliament be deleted."

The European Parliament is obviously unhappy about this suggestion, and, on 02.07.2012, voted to postpone its vote on the European patent, due two days later. Discussions will resume in September.

The EPPC will continue to monitor the developments.

## PCT

### 3. PCT Working Group

The 5th session of the PCT Working Group was held from 29 May to 1 June 2012. The working documents and a Summary by the Chair are available on the WIPO website: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=25017](http://www.wipo.int/meetings/en/details.jsp?meeting_id=25017)

In general, the Working Group noted the contents of the documents. These included some proposals by the

EPO; the concerns raised by some delegations on those proposals which would affect national laws or national phase processing led the EPO to agree to further elaborate on the proposals for further discussions at the next session of the Working Group.

The Working Group approved the proposals for amending the PCT Regulations as necessitated by the America Invents Act, with a view to their submission to the Assembly in October 2012.

## EPC

### 4. 126<sup>th</sup> AC meeting

The EPO proposal to amend Rule 53(3) EPC has been accepted by the Administrative Council on 26.06.2012, and already published in the O.J., for entry into force on 01.04.2013.

*epi* had raised objections, essentially submitting that the amended rule would infringe Article 113(1) EPC and further would be unfair in cases where the translation would not be required.

### 5. 42<sup>nd</sup> CPL meeting

The Chairman of the Committee on Patent Law has indicated that the next meeting would take place on 09.10.2012. At the time of drafting this report, it was unclear whether there would be any item relating to the EPPC.

### 6. 7<sup>th</sup> SACEPO/WPR meeting

The EPO has indicated that the next meeting would take place on 16.10.2012. At the time of drafting this report, no agenda item was known.

## GUIDELINES

### 7. 3<sup>rd</sup> SACEPO/WPG meeting

Completely revised Guidelines entered into force on 20.06.2012. The EPO had promised to revise the Guidelines on an annual basis, and indeed has indicated that the next Working Party on Guidelines would meet on 14.11.2012.

In preparation for that meeting, the Guidelines sub-committee met on 01-02.08.2012 and drafted a long list of proposals for amendment. Suggestions from *epi* members are welcome at any time ([epcc@patent-epi.com](mailto:epcc@patent-epi.com)).

**SACEPO****8. 44<sup>th</sup> SACEPO meeting**

The 44<sup>th</sup> meeting of the Standing Advisory Committee to the EPO took place on 20.06.2012. The President delivered his report on the development of the European patent system and answered all questions from the members. He joined us again for the lunch.

The agenda items related to the EPPC were:

- PCT reform – EPO proposal to strengthen the PCT: the series of proposals already submitted to the PCT WG.
- Raising the Bar – follow-up: *epi* repeated its objections about the way the EPO alleges having solved all information problems for Rule 36(1) EPC when the measures taken (mention on the front page of the relevant communication and in the European Patent Register) actually relate to paragraph (a) only.

## Report of the Harmonisation Committee

F. Leyder (BE)

Secretary of Harmonisation Committee

**Secretary of Harmonisation Committee**

This report completed on 14.08.2012 covers the period since my previous report dated 22.05.2012.

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

**1. 44<sup>th</sup> meeting of SACEPO**

During the 44<sup>th</sup> meeting of the Standing Advisory Committee to the EPO, the EPO reported on the discussions with the other IP5 Offices, DE, FR, GB and DK in the so-called Tegernsee meetings. The written report, which was submitted just a few days before the meeting, contained as Annex II a questionnaire. Due to the late circulation of the questionnaire, it could hardly be dis-

cussed during the meeting, and written replies were requested.

On the basis on the past discussions inside *epi* and of comments on the questionnaire by SACEPO members appointed by *epi* and by members of the Harmonisation Committee, our chairman drafted a paper that has been forwarded to the EPO.

**2. Meeting of the Harmonisation Committee**

The committee will meet on 07.09.2012, together with the President and Vice-Presidents, to re-evaluate the position of *epi* with regard to harmonisation in the light of the amendments to the US Patent Law resulting from the America Invents Act.

### Nächste Ausgabe · Forthcoming issue · Prochaine édition

Issue

Deadline

Publication

4/2012

02 November 2012

30 December 2012

# Report of Biotech Committee

A. De Clercq (BE)  
Chair of Biotech Committee

The items below have been presented by the *epi* Biotech Committee at the last Council meeting (some more recent matters have been added):

## 1. Position paper on the CJEU Brüstle case

A position paper dated February 2, 2012 on the Brüstle CJEU case (stem cells) has been prepared by the Biotech Committee and presented to the EPO at the 6<sup>th</sup> meeting of SACEPO WPR on February 3, 2012. The EPO is still deciding its policy on this issue. It will be very important to get more guidance on how the EPO will implement this CJEU decision.

## 2. Sequence Listings

The EPO is perceived as not being very user friendly regarding Sequence Listings. The *epi* Biotech Committee members think the EPO should delay sending the Communication that asks for a Sequence Listing and demands a fee. Also the policy on requiring a Sequence Listing on a divisional application is illogical. It is not clear why applicants cannot refer to a sequence listing on a parent case, when the sequence listing on the divisional is exactly the same. EPC 2000 allows making reference to certain parts of a previous application, so it is not clear why this would not be possible for Sequence Listings.

## 3. Subsequent filing of PCT documents online at the EPO

The EPO should also allow the filing of subsequent documents online for PCT applications filed at the EPO. At the moment, applicants cannot file subsequent documents like Sequence Listing on-line for an international application where the EP is the receiving office.

## 4. Patentability objections based on sequence alignments

When Examiners refer to their internal sequence alignments in lack of novelty (or other) objections, the Examiner could be requested to routinely provide the alignment that they are relying upon in their objection. The EPO should make available on-line access to sequence listings submitted by applicants. For example, in an objection where there is 95 % identity over a certain length, and yet the claim requires a minimum of 90 %, we should ask the EPO to provide their alignment.

## 5. Wrinkly tomato case

On the wrinkly tomato case (EP 1211926 patent), a hearing took place on 8 November 2011 before the TBA, and is now the subject of a further referral to the Enlarged Board of Appeal (the second referral to the Enlarged Board in the same case).

On June 27, 2012 the EBA made available the questions which are to be replied to in this second referral in the same case to the EBA (G2/12).

The questions are:

1. Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit?
2. In particular, is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?
3. Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC?

Amicus curiae briefs may be filed before the end of November 2012 and the *epi* Biotech Committee intends to prepare observations for *epi* upon agreement with EPCC.

On June 28, 2012 the sole opponent (Unilever) withdrew its appeal. Nevertheless, the proprietor was also an appellant and thus G2/12 will continue.

This case relates to G1/08 and G2/07 which relate to patentability of essentially biological methods (Art. 53(b) EPC).

The issue in G2/12 relates to the patentability of product claims on conventionally bred (non-GMO) plants (such as product-by-process claims).

## 6. Unity

The *epi* Biotech Committee is of the opinion that we should continue to request the EPO to be sensible about disunity in biotech cases. Increasingly, Examiners are raising disunity objections with a large number of inventions, and are not searching subsequent dependent claims.

## 7. Deposits and expert solution

The EPO keeps a list of possible experts for the expert solution (Rules 32 and 33 EPC). However, they claim the list has never been used. There have been a few requests for samples but the list has never been called into play. In fact, the expert solution has never been used as far as the people at the EPO are aware. It was suggested that this may be because the parties either come to an agreement on sharing the deposited material or they come to an agreement between themselves as to the expert to be used. It therefore seems that the list may be a waste of time. The EPO therefore has a first proposal that the list should not be maintained and that the parties, if necessary, should agree between themselves. I said that if the list is really never used, it seems pointless to keep it up to date.

The *epi* Biotech Committee has discussed this point and came to the conclusion that it does not wish to abolish the expert solution.

Our Committee has not received statistics on how many times the expert solution has been put into practice and we intend to discuss this topic further at our next Committee meeting.

We agree that the expert solution was used more frequently in earlier times in respect of deposits, where the deposit was a novel microorganism, and the depositor did not wish competitors to have access to the full genome of the microorganism and the patent application typically related to one gene only.

Nowadays, there are a large number of applicants that still request the expert solution.

The procedure is mostly meant as a security measure to avoid sequencing errors in the written disclosure or for instance for cases where micro-organisms (or other biological material) have to be characterized to meet the requirements of Art. 83 EPC.

Some members experienced problems with obtaining samples from the USA (ATCC, NRRL) because of security measures instituted by the EU, and where the depositary institutions seems not really competent in complying with the import regulations to the EU. Also some members have experienced a number of instances, where the EPO has authorized the delivery of a sample in spite of the applicant having requested the expert solution.

We believe it is "unfair" of the EPO to ask us for indicating experts to be entered on the list. It is in our

view definitely a task for the EPO, possibly in collaboration with the depositary institutions, to identify such experts.

We cannot understand that the EPO has commented that the system is not being used. Many applicants still use it according to our members, when we file applications. However, it may have been extremely rare that the experts are being used.

On the other hand, it can be expected that applicant and requester will not voluntarily agree to share the deposit (normally they are competitors).

In conclusion, the *epi* Biotech Committee insists that the option to request the expert solution in the framework of depositing biological material should be kept as a possibility for the applicants who so desire. As a policy, many applicants and representatives always request the expert solution in order to keep the best possible control over our strains which are valuable assets. By restricting the delivery of a deposited strain to an independent expert the risk that a valuable strain comes into the hand of a competitor before a patent is issued is minimized.

For this reason we will also insist that the list of independent experts is kept as it is.

## 8. Next Committee meeting

The Biotech Committee will meet again on November 5, 2012 in Munich.

## 9. Next meeting with the EPO Biotech Directors.

A delegation from the *epi* Biotech Committee will meet with the EPO Biotech Directors on November 6, 2012 in Munich.

## 10. Associate members

It was agreed to admit, as further associate members to the *epi* Biotech Committee, Bo Hammer Jensen (DK) and Stefan Murnaghan (IE).

## 11. Member from ES

The *epi* Biotech Committee at present does not have a full member from ES, but temporarily have agreed to admit Mr Francisco Bernardo Noriega as associate member.

# Report of the EPO Finances Committee

J. Boff (GB)  
Chair of EPO Finances Committee

## Refund of fees

Decision J25/10 questioned the practice of the Office in the way it decides on partial refunds of the examination fee. The reasoning of the decision also affects the refund of the search fee.

J25/10 did not say that it is wrong to give refunds that complied with present RRF 11(b) or Rule 9(1): it said that if a refund is refused there had to be a concrete and verifiable act sufficient to justify refusal. It appears that the Office is presently unable to point to such an act indicating commencement of the search or examination.

Epi is pressing the Office to consider that despatch of the relevant search or examination report is a concrete and verifiable act, and that refunds should be given up to the date of despatch of the relevant search or examination report.

It is important to retain the refund mechanism, as this encourages cases to be withdrawn without wasting examiner time. Less wasted examiner time means more productive examiner time.

Budget and Finance Committee meeting May 2012

## Small entity fees

For a three year trial period a fee reduction is to be introduced, to be funded from the co-operation programme, for certain member states with working agreements on search co-operation (CA/47/12).

The four countries concerned are Cyprus, Greece, Malta and Turkey. The reduction is of 50 % of the search fee on national applications from these countries. The reduction will only be given to applicants who meet the criteria of being: –

- a) natural persons
- b) SMEs as defined by the European Commission's recommendation of 6 May 2003, i.e. staff < 250, turnover < EUR 50m or balance sheet < EUR 43m, no more than 25 % of capital held by another company
- c) universities or not-for-profit research institutes

The number of applications that can benefit from the program is to be limited to 100 dossiers a year per country.

It was noted by *epi* that: –

- There may be problems in the definitions – at present a millionaire in one of the four favoured countries would get a discount: but a person on average income outside the favoured countries would not
- A company with 249 employees is not small [whatever the EU says] and could afford patent fees
- Some universities are very wealthy and need no assistance.
- Although this proposal is directed to search fees on national applications, once small entity discounts start to be given there will inevitably be political pressure to provide discounts on EP applications.

The trial program was approved by the BFC and subsequently at the Administrative Council.

## EPOQUE Net dissemination and pricing policy (CA/27/12 Rev. 1)

This largely technical document concerning access to EPOQUE tools included the requirement that non-Member States should commit to allowing their applicants to name EPO as an ISA.

It appears that the EPO is still keen to be the most active ISA despite the facts that: –

- the EPO lose money on each international search performed
- one third of PCT applications never proceed to a European application
- performing International search for non-European applicants is equivalent to a subsidy from Europe to the rest of the world
- an examiner searching a PCT application is not searching or examining a European application
- European applicants generally do not have the luxury of choosing their ISA
- the net effect is to hinder European industry and help the rest of the world.

The EPOQUE policy has been approved by the Administrative Council.

## *epi* Tutors' Meeting in Berlin on September 18, 2012

We are proud to inform you that an *epi* tutors meeting will be organised in Berlin on September 18, 2012.

As this would be the first meeting after a long time, we would like to start with a short introduction about *epi*, followed by presentations of different working fields for *epi* tutors and of the working group of the Professional Qualification Committee dealing with all matters concerning *epi* tutors.

After a coffee break we would like to continue with workshops to gather input from you on certain projects.

Enrolment form and further useful information can be found here:

[https://www.patentepi.com/patentepi/en/forms/120918\\_epi\\_Tutors\\_Meeting\\_Berlin\\_Cover.php](https://www.patentepi.com/patentepi/en/forms/120918_epi_Tutors_Meeting_Berlin_Cover.php)

### *epi* meeting room

The *epi* Secretariat provides a convenient meeting room free of charge for all *epi* members. You can use the room to meet with your clients or prepare for oral proceedings.

Located within walking distance to the EPO Building PschorrHöfe and only a few minutes walk from the central station you will find a light and airy room equipped with:

- Flipchart
- Whiteboard
- Wireless Internet
- Video projector
- Catering on request (at own charge)



Size: 31 qm  
Persons: max. 14  
Seating: flexible  
Open: Mo – Fr  
8am to 5pm



## epi Mock EQEs and epi Seminars 2012

epi will organise a series of Mock EQEs (for EQE candidates) and epi seminars (for patent attorneys and paralegals)

### Scheduled seminars:

8.10.2012	Munich: "epi/EPO – seminar for paralegals and administrative staff"
12.10.2012	Vienna: "Guidelines2DAY" seminar
15.–17.10.2012	Helsinki: "Mock EQE"
18.10.2012	Warsaw: "PCT – seminar for paralegals and administrative staff"
19.10.2012	London: "Guidelines2DAY" seminar
14.–16.11.2012	Feedback Session Mock EQE Helsinki
19.11.2012	Madrid: "Guidelines2DAY" seminar
26.11.2012	Eindhoven: "Guidelines2DAY" seminar
10.12.2012	Helsinki: "Guidelines2DAY" seminar
17.12.2012	Istanbul: "Guidelines2DAY" seminar

Further information about these events can be found here: [www.patentepi.com](http://www.patentepi.com) → EQE and Training.

### Tutors wanted



As epi is always looking to add new tutors to its current group we would like to know whether you are – in principle – interested in participating in this activity. In case you decide to volunteer your commitment is conditional: you will always be asked whether you are willing to tutor in a specific event.

Please volunteer by filling in the form available on the epi website ([www.patentepi.com](http://www.patentepi.com) → EQE and Training).

For any further queries, kindly contact the epi Secretariat ([education@patentepi.com](mailto:education@patentepi.com)).

## Seminar „Boards of appeal and key decisions“

EPO, European Patent Academy  
F. Rety (FR)

On 8/9 November, in Munich, the European Patent Office is hosting a second seminar on the boards' case law and recent developments. At this event, entitled "Boards of appeal and key decisions", EPO and other experts will talk about issues which feature prominently in the daily work of IP managers and patent attorneys. About 100 attendees are expected.

The programme includes presentations and discussions on the following topics:

- Petitions for review: an overview after more than four years of case law
- Disclaimers and their use as an instrument of patent prosecution

- Patentability of computer-based inventions; human embryonic cells; plants and fruits
- Substantive requirements for sufficiency of disclosure and industrial applicability
- Amendments before and after grant

The seminar will also look at the appeal procedure and how to keep up-to-date on the case law. Attorneys and judges will talk about the case law from their perspective, and short workshops on novelty and inventive step will round off this special event.

For more information and to register, visit [www.epo.org/boa-seminar](http://www.epo.org/boa-seminar)

## Next Board and Council Meetings

### Board Meetings

87<sup>th</sup> Board meeting on 6<sup>th</sup> October 2012 in Istanbul (TR)  
88<sup>th</sup> Board meeting on 23<sup>rd</sup> March 2013 in Stockholm (SE)  
89<sup>th</sup> Board meeting on 28<sup>th</sup> September 2013 in Riga (LV)

### Council Meetings

73<sup>rd</sup> Council meeting on 10<sup>th</sup> November 2012 in  
Hamburg (DE)  
74<sup>th</sup> Council meeting on 19<sup>th</sup>/20<sup>th</sup> April 2013 in Vienna (AT)

## European Patent Attorneys Excess Liability

### Dear *epi*-member,

The Institute of Professional Representatives before the European Patent Office gives all members the possibility to get access to an additional excess professional liability programme.

As from the day you subscribe to this insurance, cover is provided for claims made by reasons of any actual or alleged wrongful act committed within the framework of the Patent Attorney activities.

The indemnity of basic professional liability insurance schemes is often limited to EUR 1.022.584. Therefore, the *epi* excess liability insurance scheme indemnifies

losses when they exceed EUR 1.022.584/equivalent (excess liability policy). Its limit of indemnity is further EUR 1.533.876 per loss so that – together with the basic insurance – a total loss of EUR 2.556.460/equivalent is covered. There is a collective indemnity limit to EUR 15.338.756 per year for all participating *epi*-members.

The cover runs for 12 months from 1.October of each year. *epi*-members joining the scheme in the course of an insurance year will receive an invoice on a pro-rata basis.

The *Funk International GmbH*, which is *epi*'s Insurance broker, will be pleased to help if you have any further questions.

### Please do not contact the *epi* Secretariat.

Funk International GmbH  
IB Professional Risks  
Postfach 30 17 60  
20306 Hamburg  
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Contact person: Ms Stefanie Riemer  
Phone: +49 (0) 40 35914-279  
Fax: +49 (0) 40 35914-73-279  
Mail to: s.riemer@funk-gruppe.de

## Important Information for *epi*-Members having their Place of Registration in Switzerland

We would like to inform you about the “non-admitted-complex of problems”.

This topic is relevant for all Swiss Patent Attorneys.

Insurers are not willing to draw risks in Switzerland. Therefore contracts in Switzerland are no longer performed in our excess professional liability programme.

The reason is the “non-admitted” ban initialized through the insurance law of many countries (e.g. Switzerland, Brazil, China). This insurance law obliged to

secure risks, which are situated in Switzerland, through an authorized local licensed insurer.

Insurer, policyholder or supervising broker who would violate the local applicable regulatory law must take into account legal consequences of nullity of the insurance cover to the relevance of regulatory and criminal provision relating to companies and persons acting so.

The Swiss Co-Broker *GWP Insurance Brokers AG* is responsible for future contracts.

### Please use the following contact details:

GWP Insurance Brokers AG  
Feldstrasse 42  
CH-3073 Gümligen  
Switzerland

contact person: Mr Stefan Engeler  
Phone: +41 31 959 00 02  
Fax: +41 31 959 00 19

## Contact Data of Legal Division

### Update of the European Patent Attorneys database

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by *epi*. Therefore, to make sure that *epi* mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 523 of any change in your contact details.

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

European Patent Office  
Dir. 5.2.3  
Legal Division  
80298 Munich  
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Fax: +49 (0)89 2399-5148  
legaldivision@epo.org  
www.epo.org

Thank you for your cooperation.

# Article 123(2) EPC, Recent Case Law and a Chessboard

Christian Köster<sup>1</sup>(DE)

## 1. The basic principle

The Enlarged Board of Appeal of the EPO has elaborated on the fundamental concept behind Article 123(2) EPC<sup>2</sup> in decision G 1/93<sup>3</sup>. Stating that an applicant cannot add subject-matter not disclosed in the application to achieve an unfair advantage and jeopardize the legal security of third parties<sup>4</sup>. Decision G 1/93 deals, in particular, with the possible conflict between Article 123(2) and Article 123(3) EPC and has been viewed and commented on from different points of view<sup>5</sup>. However, the basic principle elaborated in G 1/93 must certainly be welcomed by anyone who has ever been in the situation of defending a third party against amended claims tailored to cover the third party's business; but evidently unsupported by the original application. There is good reason for provisions in the EPC to prevent an applicant from acquiring an unjustified legal position.

At the application stage, it is Article 123(2) EPC itself which safeguards the legal certainty of third parties. In opposition proceedings the requirement of Article 123(2) EPC is enshrined in Article 100(c) EPC; in limitation proceedings under Article 105b EPC it must be observed according to Rule 95(2) EPC. The standards for assessing whether an amendment finds basis in the underlying application are the same in all these cases. The same assessment standards must also be applied when a divisional application is examined for compliance with the requirements of Article 76(1) second sentence, first half sentence, EPC, as was explicitly confirmed in G 1/05<sup>6</sup>. Whilst there is no *ex officio* examination of compliance with Article 76(1) EPC in limitation proceedings, Article 100(c) EPC provides a basis for such an examination in opposition proceedings. Likewise, a fresh application filed in accordance with Article 61(1)(b) EPC must comply with the requirements of Article 76(1) EPC<sup>7</sup>, such that again no extension beyond the original disclosure is permissible. Once granted, a European patent may also be declared null when its subject-matter extends beyond the content of the application as filed, as stipulated in Article 138(1)(c) EPC.

In all proceedings and irrespective of the applicable provision in the law, it is therefore always the content of the first application filed with the office which is decisive for determining whether an amendment is supported by the original disclosure. The original disclosure is equally found in description, claims and drawings<sup>8</sup>, and it is well known that it only encompasses subject-matter which is disclosed "directly and unambiguously"<sup>9</sup>. Several tests have been developed in the case law to assess whether particular subject-matter after amendment is found in the original application in a direct and unambiguous manner.

## 2. The several tests

Following the elaborations in the case law book, three tests can be mentioned which are regularly applied by the EPO for testing whether an amendment is in conformity with the requirements set out in particularly Article 123(2) EPC. These three tests will now be briefly discussed.

### 2.1 Novelty test

The basic idea of the novelty test is that no subject-matter should be created by amendment which results in subject-matter which – compared to the application as filed – would be new<sup>10</sup>. Since the development of this test it has at first been considered particularly useful in the case law, even where amendments amounted to deletions<sup>11</sup>. In the context of generalizations, compared to the original disclosure, a strict application of the novelty test has not been accepted. Instead, it was held that the test for additional subject-matter and the novelty test are only similar in that they both ultimately ask whether or not the tested subject-matter is directly and unambiguously derivable from the relevant source<sup>12</sup>. Limits of the novelty test were also discussed in other decisions<sup>13</sup>, and the current version of the case law book even comes to the conclusion that the recent case law makes no reference to the novelty test anymore<sup>14</sup>.

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<sup>2</sup> The wording of Article 123(2) EPC underwent a minor editorial change when the EPC2000 entered into force, i.e. formerly used indefinite articles were replaced by a definite article. It is not apparent that this change has any influence on procedural or material aspects of Article 123(2) EPC.

<sup>3</sup> O.J. EPO 1994, 541

<sup>4</sup> Id., point 9 of the Reasons

<sup>5</sup> See e.g. Wheeler, GRUR Int. 1998, 199, „Der „Konflikt“ zwischen Artikel 123(2) und (3) EPÜ“; Laddie, GRUR Int. 1998, 202, „Die unentrinnbare Falle Überlegungen aus dem Vereinigten Königreich“; Brinkhof, GRUR Int. 1998, 204, „Kollision zwischen Artikel 123(2) und (3) EPÜ“; Rogge, GRUR Int. 1998, 208, „Zur Kollision zwischen Artikel 123(2) und (3) EPÜ“; Pfeiffer, epi Information 1/2003, 21, „Zu EPÜ Art. 123(2) und (3)“

<sup>6</sup> O.J. EPO 2008, 271, point 5.1 of the Reasons

<sup>7</sup> See Article 61(2) EPC

<sup>8</sup> G 11/91, O.J. EPO 1993, 125, Headnote 1, and G 2/95, O.J. EPO 1996, 555, Headnote

<sup>9</sup> A terminology used e.g. in the Headnotes of G 3/89 and G 11/91, O.J. EPO 1993, 117 and 125; see also Case Law of the Boards of Appeal of the European Patent Office, Sixth Edition, July 2010 (hereinafter abbreviated in the footnotes as „Case Law of the Boards of Appeal“, also referred to in this article as the „case law book“), Section III.A.7, 346

<sup>10</sup> T 201/83, O.J. EPO 1984, 481, point 3 of the Reasons

<sup>11</sup> T 136/88, point 4.1 of the Reasons

<sup>12</sup> T 194/84, O.J. EPO 1990, 59, Headnote; confirmed in T 118/89, point 3.2 of the Reasons

<sup>13</sup> E.g. T 133/85, O.J. EPO 1988, 441, point 5 of the Reasons; T 177/86, point 5 of the Reasons; T 150/07, point 1.1.4 of the Reasons

<sup>14</sup> Case Law of the Boards of Appeal, Section III.A.7.3, 354

This conclusion, although found in some case law as well<sup>15</sup>, however appears to be at odds with the “exceptions” referred to in the very same paragraph in the case law book. The Guidelines still explicitly refer to the novelty test as the applicable test in the case of additions, namely in the paragraph which illustrates the field of application of Article 123(2) EPC<sup>16</sup>. This seems to be a clear indicator that this test is considered a useful tool at first instance. This view, expressed in the Guidelines, is further supported by quite recent case law; specifically by decision T 1374/07, which makes reference to T 201/83 and considers the novelty test applicable at least where the amendment is by way of addition<sup>17</sup>. This was also confirmed by the Enlarged Board of Appeal in decision G 2/10 that no amendment may create novel subject-matter<sup>18</sup>.

It can probably be said that the novelty test has limitations, but that it is still considered in the case law as a suitable method for determining whether or not amended subject-matter is sufficiently supported, i.e. directly and unambiguously disclosed in the original application. Decision T 60/03 puts it this way: “Whereas the “novelty test” may assist in determining the allowability of an amendment, it cannot override the basic criteria.”<sup>19</sup> It is not the only tool for assessing support within the original disclosure, but one which can be, and in fact is, used where deemed applicable.

## 2.2 Essentiality test

Amendments are possible by way of addition, but also by way of deletion or replacement; which two cases should be distinguished<sup>20</sup>. This is where the essentiality test may come into play. Essential means essential for the invention, and a feature fulfilling this criterion cannot be removed from an independent claim without contravening Article 123(2) EPC<sup>21</sup>. Following decision T 260/85, a stepwise test was developed in the case law for the assessment whether a deleted feature is essential<sup>22</sup>; the test is sometimes also called the three-point test. The first point is whether the feature was not explained as essential in the original application. The second point is whether the feature is not indispensable for the function of the invention before the background of the solved technical problem. The final third point is whether the occurred replacement or removal requires no real modification of other features to compensate for the change. Only when all three points can be answered in the affirmative is essentiality denied and a replacement or removal of a particular feature may be allowable.

The three-point essentiality test is also referred to in the Guidelines<sup>23</sup> and has been applied in more recent

case law<sup>24</sup>. It was even considered also suitable for the scenario in which a feature in a claim is generalized and the scenario in which a feature is isolated from an embodiment set out in a description<sup>25</sup>. Evidently, the essentiality test is another tool for assessing compliance of amendments with Article 123(2) EPC.

## 2.3 Deducibility test

Contrary to the order in this article, the “deducibility test” is the first test which is discussed in the case law book in the section referring to tests for assessing the allowability of an amendment<sup>26</sup>. The deducibility test thus seems to be given particular emphasis. A reason could be that one may see the deducibility test as an umbrella under which the novelty test and the essentiality test can be united. In fact, in T 514/88 the novelty test and the essentiality test were considered non-contradictory and pose the same question; namely whether there is consistency between the amendment and the original disclosure<sup>27</sup>. In this context, it was also demanded by the Board of Appeal that the disclosure of the subject-matter, after amendment in the underlying application, fulfills the two almost notorious criteria, i.e. directness and unambiguously<sup>28</sup>.

In the already mentioned decision G 2/10, the Enlarged Board of Appeal did not refer to a “deducibility test”, but called the relevant test the “disclosure test”<sup>29</sup>. This test nevertheless seems to be one asking for a direct and unambiguous disclosure because in G 2/10 this principle, as laid down in G 3/89 and G 11/91, is referred to as the “‘gold’ standard”<sup>30</sup>. The requirement that amended subject-matter must be directly (or clearly) and unambiguously disclosed in the originally filed documents also appears to be accepted as the decisive assessment standard by national courts of the EPC member states<sup>31</sup>.

Furthermore, for particular scenarios, it seems that additional (sub)criteria have been developed in the EPO’s case law. In case of a so-called intermediate generalization, for example, the features of the generalized embodiment must be “separable”<sup>32</sup>, and such a generalization must further be recognizable “without any

24 T 775/07, point 2.1 of the Reasons

25 T 404/03, point 10 of the Reasons

26 Case Law of the Boards of Appeal, Section III.A.7.1, 347ff; the term “deducibility test” is however only used in this article as an abbreviation for a “Direct and unambiguous deducibility of amendments from the application as filed”

27 T 514/88, O.J. EPO 1992, 570, point 2.4 of the Reasons

28 Id., point 2.7 of the Reasons

29 G 2/10, Loc. cit., point 4.5.1 of the Reasons

30 G 2/10, Loc. cit., point 4.3 of the Reasons

31 See e.g. the decision from the Court of Appeal of England and Wales, *European Central Bank v Document Security Systems Incorporated* [2008] EWCA Civ 192, and the decision from the German Federal Supreme Court, BGH GRUR 2010, 910, *Fälschungssicheres Dokument*, which in parallel cases come to the same conclusion as regards an unallowable extension beyond the original disclosure and which with respect to disclosure requirements refer to “clearly and unambiguously” and “*unmittelbar und eindeutig*”, respectively. The corresponding decision from the French Court of Appeal dated 17 March 2010, RG n° 08/09140, concludes that the skilled person was not enabled by the original application to deduce the claimed invention (“...ne permettait à l’homme du métier de déduire...”). It is, however, interesting that the concerned patents were national parts of an EP patent which was granted after an application appeal procedure before the EPO.

32 T 461/05, point 2.6 of the Reasons (“*dissociables*”)

15 T 150/07, point 1.1.4 of the Reasons

16 Guidelines for Examination in the European Patent Office, June 2012 (hereinafter abbreviated as “Guidelines”), H-IV, 2.2

17 T 1374/07, point 2.2 of the Reasons

18 G 2/10, O.J. EPO 2012, 376, point 4.6 of the Reasons with reference to G 2/98, O.J. EPO 2001, 413

19 T 60/03, point 2 of the Reasons

20 T 404/03, Catchword

21 T 260/85, O.J. EPO 1989, 105, Headnote 2

22 T 331/87, O.J. EPO 1991, 22, Headnote

23 Guidelines, H-V, 3.1

doubt”<sup>33</sup> in order to be allowable under Article 123(2) EPC. It does therefore not come as a surprise that the Boards of Appeal typically apply Article 123(2) EPC in a restrictive manner when it comes to intermediate generalizations<sup>34</sup>. But even restrictively applying Article 123(2) EPC can hardly mean limiting the original disclosure to what is explicitly disclosed, given that it is accepted in the case law that applications also may contain an implicit disclosure<sup>35</sup>. Also, adding terms not originally disclosed is not automatically prohibited, and a pure semantic analysis of relevant passages of the original disclosure is not sufficient for assessing the allowability of amendments<sup>36</sup>. Accordingly, the amended subject-matter need not necessarily be found in the original application in an explicit and furthermore literal manner, but still must be found therein in a direct and unambiguous manner; whatever that precisely means for the actually judged case.

In summary it can be said that there are currently three so-called “tests” for original disclosure, the comparably specific tests for novelty and essentiality, and the broader test for deducibility. All three tests are applied these days by the Boards of Appeal and the first instances, respectively, of the EPO for judging whether or not an amendment is in accordance with Article 123(2). It is not known to the author whether *Teschemacher* had these three tests in mind when referring to the three yardsticks applied within the EPO, the first being strict, the second stricter and the third brutal<sup>37</sup>. When it comes to lists and fields of features, respectively, it seems that the applicant – and also the draftsman prior to the filing of the application – should be prepared for any of these approaches. A chessboard may serve as an example.

### 3. How to claim a chessboard

Obviously, a chessboard is not patentable. For the purpose of this article, it will only be an illustration of how information can be presented. Almost everyone knows that a chessboard has 64 squares, with eight lines typically denominated a to h and eight rows typically denominated 1 to 8, and also typically with a frame surrounding the 64 squares. This gives rise to at least three different kinds of representation of the information “chessboard”, and it is quite instructive to study what the consequences of these possible presentations are with a view to amendments. The study is made in reverse order and will assume that the most valuable part of the chessboard is the square “e4” so that even if prior art anticipates other parts of the chessboard, “e4” shall be covered by an amended claim.

33 T 962/98, Catchword

34 For a discussion of case law on intermediate generalisations, see Pentheroudakis, GRUR Int. 2008, 699, „Zulässigkeit von Änderungen der Patentansprüche nach Art. 123 (2) EPÜ im Hinblick auf die Problematik der sog. ‚Zwischenverallgemeinerung‘ (intermediate generalisation)“; see also Case Law of the Boards of Appeal, Section III.A.2

35 See e.g. T 1125/07, point 3.2 of the Reasons

36 T 1269/06, point 2 of the Reasons

37 *Teschemacher*, Mitteilungen der deutschen Patentanwälte, 2008, 289, 294, „Aktuelle Rechtsprechung der Beschwerdekammern des EPA – Notizen für die Praxis“

#### 3.1 Representation by a frame

The first discussed disclosure of a chessboard is the aforementioned frame. It is not uncommon to use general terms in a patent specification for describing and summarizing technical aspects of the invention which is believed to have been made. So in order to cover the most valuable part “e4” without unduly limiting the claim from the outset, the frame surrounding the chessboard could be used as a characterizing feature. Such a characterization will however become problematic once prior art<sup>38</sup> is discovered which discloses a particular part of the framed area, say for example the square typically denominated “e7”. According to the general principle that a specific disclosure takes away the novelty of a generic claim embracing that disclosure<sup>39</sup>, the frame would be anticipated by the prior art disclosure of “e7”. At this point, an amendment of the claim using the frame as a definition is required to restore novelty.

One possibility for doing so could possibly be removing the anticipating prior art element from the subject-matter defined by the frame, namely by disclaiming that element. The valuable “e4” would then still be covered. However, in this scenario the only representation of subject-matter is the frame itself, nothing else. There is accordingly no reference to a disclaimer by which “e7” may be removed from the framed area, so that any used disclaimer would be a so called undisclosed disclaimer. As is well-known, unless particular conditions are fulfilled which are not of interest for the discussion herein, the disclaimer solution is thus not allowable in the present scenario<sup>40</sup>. Different ways out of the anticipation are not available because the original disclosure contains no other definitions or levels of generalisation apart from the frame. Especially, “e4” is not mentioned individually. Then, irrespective of the applied test for assessing the amendment, claiming the “chessboard minus e7” or the more limited “e4” will fail for non-compliance with Article 123(2) EPC.

In this scenario, no subject-matter is patentable anymore due to the limited original disclosure. Of course, this situation is the reason for drafting applications such that there are fall-back positions in case unexpected and novelty-destroying prior art must be dealt with. One possibility for such fall-back positions is to provide lists of features which are more specific compared to the general term covering them.

#### 3.2 Representation by lists

Chess notation uses the eight rows and eight lines making up the chessboard. In fact, this has already been done above when referring to “e4” or “e7”. There are lines a to h and rows 1 to 8. This makes it possible to unambiguously identify “e4”. But really unambiguously? Following the logic of T 181/82<sup>41</sup>, according to which the definition of a C1 to C4 alkyl bromide does not

38 In the sense of Article 54(2) EPC

39 See e.g. Guidelines, G-VI, 5

40 G 1/03, O.J.EPO 2004, 413, and G 2/03, O.J. EPO 2004, 448

41 O.J. EPO 1984, 401

represent a listing of each of the chemically possible eight alkyl bromides, the disclosure "a to h" probably discloses "a"<sup>42</sup>, but not necessarily "e". In order to be on the safe side in this respect, it would be required to define lines a, b, c, d, e, f, g and h in combination with rows 1, 2, 3, 4, 5, 6, 7 and 8. Again, it shall be assumed that prior art unfortunately discloses "e7", so that amendments are required to obtain protection for "chessboard minus e7", or at least for the valuable "e4". The less ambiguous aim, i.e. protection for "e4", is analysed first.

In the scenario discussed here, the definition of the chessboard is realized using two indices, one number and one character, i.e. by two lists of indices. Now the alarm bells are ringing. Whilst a chess player, who is a skilled person when it comes to chessboards, would certainly have no problems to make the correct move when instructed to move a piece to e4, according to EPO case law a simultaneous selection from two lists typically creates novel subject-matter<sup>43</sup>. The natural question is whether this principle is also applicable when it comes to amendments. According to e.g. decisions T 727/00 and T 686/99 it in fact does, because a multiple selection within two lists of alternative features is considered to generate a fresh particular selection<sup>44</sup>. The novelty test is applied and the fresh particular selection is therefore something which goes beyond the original disclosure.

According to the basic decision T 12/81, one requirement for creating new subject-matter by selection of elements from two lists is that those lists must each be a "list of certain length"<sup>45</sup>. In decision T 727/00 referred to above, the first list had six members and the second list twenty-three members, which in the Board's opinion was sufficient for satisfying the required certain length. Would this also hold true for the chessboard, for the two lists with eight elements each defining the chessboard by means of indices? At first sight, it appears that the case law is not unambiguous in this respect.

In the already mentioned decision T 1374/07, it was held that a twofold selection from the same list of eight members is in fact nothing else but a selection from two identical lists of eight members<sup>46</sup>. Applying the quite lively novelty test, the Board then identified an extension beyond the original disclosure. The difference of the decided case to the chessboard example is merely that the lists defining the latter are not identical, but in substance this difference changes nothing. A field of eight times eight members is basically created in both cases<sup>47</sup>, and according to the cited case law, an amended claim directed to claim "e4" would evidently be considered contravening Article 123(2) EPC.

However, there is different case law which seems to indicate that selections from lists are not necessarily in conflict with the original disclosure. According to decision T 607/05, two lower limits of an array were combinable in a claim in agreement with Article 123(2) EPC<sup>48</sup>. When the underlying application is inspected, it would be difficult not to identify two lists from which those parameters were selected, although both lists are found in the same sentence. In effect, a twofold selection from a first list of five explicit numbers and a second, different list of again five explicit elements had been made. The created field of twenty-five elements is apparently smaller than the chessboard, so that the shorter the lists, and hence the smaller the generated fields become, the better the chances for compliance with the requirements of Article 123(2) EPC might be. This is, however, not predictable. A selection from an even smaller field of twenty-four elements, generated by a list of eight members and a list of three members, respectively, was held to be in contravention to Article 123(2) EPC in decision T 137/04<sup>49</sup>.

It could therefore be asked what is the lowest limit of elements in a list such that the list still has a "certain length" in the sense of the above cited case law. A first hint is already found in decision T 7/86, which with respect to lists only deals with novelty issues, but which is cited in decision T 1374/07 as support for the view on selections from two lists in the context of inadmissible extensions beyond the original disclosure. The document relevant for judging a disclosure arising from two lists, in case T 7/86, contained two lists for two substituents on a chemical entity, one list having five members and one list having only two members. Despite these relatively short lists and the just ten possible combinations derivable from the two lists, the Board in T 7/86 with explicit reference to T 12/81 came to the conclusion that the two lists did not result in a disclosure of all individual compounds.

It must thus be expected that a selection from two very short lists can still result in the creation of something novel, i.e. of something not originally disclosed. This expectation is fully met by the quite recent decision T 1710/09<sup>50</sup> in which the concept of non-disclosure due to selection from two lists seems to have reached its climax. In the underlying case, one examined claim was written in the Swiss-type claim format and defined an administration of a specific medicament in tablet form which had a particular dosing strength. An example was cited in support of the given definition which in a first suggested treatment referred to the claimed dosing strength and the possibility to administer the medicament in the form of tablets or liquid formulations. A second suggested treatment for a different purpose in the same example referred to a dosing strength not claimed, and again mentioned the possibilities of tablets or liquid formulations as dosage forms. The Board took the

42 In T 181/82, the C1 alkyl bromide, methyl bromide, was considered disclosed.

43 T12/81, O.J. EPO 1984, 401; see also Case Law of the Boards of Appeal, Section I.C.4.1.1b), and the reference to the "two-lists principle" in the Guidelines, G-VI, 8(i)

44 T 727/00, point 1.1.4 of the Reasons; T 686/99, point 4.3.3 of the Reasons

45 T 12/81, Loc. cit., point 13 of the Reasons („Aufzählung gewissen Umfangs")

46 T 1374/07, point 2.2 of the Reasons

47 Provided the same member could be selected twice from the list disclosed in the case underlying T 1374/07.

48 T 607/05, point 10 of the Reasons

49 T 137/04, point 3.1 of the Reasons

50 A petition for review of T 1710/09 had been filed pursuant to Article 112a EPC (case number R 16/11), but was rejected as clearly allowable.

example into account and identified two alternatives for the dosing strength and two alternatives for the dosage form<sup>51</sup>. Another variable mentioned in this context in the decision, namely the dosing interval<sup>52</sup>, is factually irrelevant because that variable was fixed in the example in the original disclosure to a once-daily dosing regimen. It seems to follow that compared to the explicit example in the underlying application, two lists with two members each were identified. The combination of one member of the first list with one member from the second list was found to go beyond the original disclosure. In some decisions of the EPO's case law, the minimum number of elements for a list of "certain length"<sup>53</sup> is thus apparently defined, it is two.

When the same assessment standards as in the just discussed ruling are applied, it seems that "e4" could never be claimed on the basis of the definition by lines a, b, c, etc. and rows 1, 2, 3, etc., respectively, without contravening the requirements of Article 123(2) EPC. In such a scenario, the novelty test is applicable in order to solidify the deducibility test. No matter how many elements are contained in the originally disclosed lists, any selection from the lists including e.g. "e4" would most likely fail the test.

The fact that "e4" thus cannot be claimed without violating Article 123(2) EPC under the current practice of at least some Boards of Appeal also answers the question whether one would be able to obtain the "chessboard minus e7". In order to cover all sixty-three remaining couples of lines and rows, sixty-three times a twofold selection from two lists would have to be made, thereby sixty-three times going beyond the original disclosure<sup>54</sup>. Instead of presenting features in lists, it is of course also possible to originally disclose in a very specific manner all conceivable elements and feature combinations. Presenting features in an enumerative manner will therefore be discussed next.

### 3.3 Representation by enumeration

In this scenario, the original disclosure shall explicitly refer to each of the sixty-four squares of the chessboard. This can be done by using the indices of the two lists referred to above, i.e. by writing down each and every combination, namely a1, a2, a3, etc. up to h8. The situation shall be the same as in the above scenarios, "e7" is known and "e4" of certain value.

The first aim is trying to achieve protection for the "chessboard minus e7". Due to the nature of the original disclosure in this scenario, "e7" is part of that disclosure, i.e. part of a list enumerating sixty-four separate elements. It could be opined that there can be no objection when deleting "e7" as one element from a long list of elements, that is, when making a one-di-

mensional restriction, as it seems to be the view in some case law<sup>55</sup>.

However, it is somewhat questionable whether this approach is still true and can be maintained in the light of more recent case law from the Enlarged Board of Appeal. In the author's view, there is no logic or material difference between actually deleting "e7" from a list of 64 elements on the one hand and defining at the end of the list that "e7" is excluded, i.e. disclaiming it. The final list does either not contain the element in question or it is unequivocally defined that the element in question is disclaimed. The message to any third party is the same: "e7" is not part of the claim.

Provided it is correct that a deletion of one element from a list is equal to a statement that a particular element is not part of the list and thereby equal to a disclaimer, what is actually done by deleting an element is disclaiming this originally disclosed element without mentioning the disclaimer in the claim. In decision G 2/10, it was ruled that disclaiming originally disclosed subject-matter is only admissible if the remaining subject-matter passes the deducibility test, i.e. that it is directly and unambiguously disclosed to the skilled person in the application as filed<sup>56</sup>. Whether the Enlarged Board of Appeal's instructions in this respect, namely that the deducibility test in such a case requires a technical assessment of the overall technical circumstances of that individual case<sup>57</sup>, will be of much help in the future is yet to be seen. It can however not be ruled out that without a specific mention of the remaining sub list, disclaiming one element from a certain list might not be allowable in light of G 2/10. Nothing else should then apply to deletions. This is because deletions are hardly something other than disclaimers, removing disclosed subject-matter, which disclaimers are simply unmentioned in the amended claim.

For the chessboard example, this would require that after deleting/disclaiming "e7", the conglomerate of the remaining sixty-three elements needs to be deducible from the original disclosure. The direct and unambiguous disclosure of the group of sixty-three elements does not necessarily need to be explicit, but may also be implicit, and the skilled person as the addressee of the original disclosure must take common general knowledge into account when assessing the deducibility<sup>58</sup>. However, relying on an implicit disclosure is more dangerous as an implicit disclosure can usually be more easily denied than an explicit disclosure. Thus, in order to try to safeguard an original disclosure of the subgroup of sixty-three elements right from the beginning, there is probably no other way but explicitly mentioning it in the specification. A problem is that it is typically unknown in advance which subgroup of sixty-three elements should be disclosed to the skilled reader in a direct and unambiguous manner as a security measure should one of the

51 T 1710/09, point 3.3b) of the Reasons

52 T 1710/09, point 3.3c) of the Reasons

53 Or of „some length“, as it is stated in T 1710/09 at point 4.3 of the Reasons with reference to T 12/81

54 Deletion of especially row „7“ might help to restore novelty over the disclosure of „e7“ and keep „e4“. The deletion of features – in the chosen picture of „squares“ – from the original disclosure is discussed in section 3.3, and the principles of deleting „squares“ and „rows“, respectively, should be the same.

55 See e.g. T 978/99, point 4.1 of the Reasons; similarly in T 633/09, point 3.3.3(a) of the Reasons

56 G 2/10, Loc. cit., Headnote 1a

57 G 2/10, Loc. cit., Headnote 1b

58 G 2/10, Loc. cit., Headnote 1a

squares of the chessboard already be known from the prior art. The draftsman is thus left with only one choice, and that is disclosing all sixty-four possible subgroups of sixty-three squares. Should the applicant be afraid of prior art anticipating two squares, all possible subgroups with sixty-two elements each should also be explicitly disclosed – and so forth for all conceivable permutations.

For a moment, it is sufficient to look at the subgroups each containing sixty-three elements. Logically, there are sixty-four such subgroups which will necessarily be presented as alternatives in the original disclosure. In sixty-three of the subgroups, the valuable element “e4” will be present. Accordingly, those groups will typically be attributed the same weight in the original disclosure. When facing anticipation by “e7”, it would however be required to extract the particular subgroup without “e7”, i.e. to select one subgroup from a number of subgroups which are all of equal weight. This is unfortunate because where alternatives are of equal weight and no preference is attributed to them, a singling out thereof appears to be inadmissible<sup>59</sup>. That is, even the cumbersome exercise of writing down each and every conceivable permutation might not help if no preference of the one or the other permutation is clearly indicated. The reason is that according to decision T 1710/09, an alternative can be admissibly extracted from the original disclosure only provided this alternative is given a particular weight in the specification<sup>60</sup>. Although the cited decision assesses a combination of features in this context, it could indeed be understood to prohibit the selection of one element out of a series of elements of equal weight even where no second selection is made. One relevant passage of the decision reads as follows:

“In all cases, the alternatives are of equal weight, no preference is indicated by specific words or in any other directly recognisable way and their singling out for reasons of original disclosure is not allowed.”<sup>61</sup>

Is this a kind of “singling-out test” or which kind of test is applied? In fact, explicit reference to decision T 12/81 is found in T 1710/09<sup>62</sup>, so that the novelty test seems to be used by the Board in the latter decision. However, subject-matter which is not novel in the sense of Article 54 EPC (because a skilled addressee would seriously contemplate applying the technical teachings of a relevant prior art document in the range of overlap<sup>63</sup>), can apparently still be novel according to the novelty test used in the mentioned decision for assessing the allowability of amendments. This is because at least according to decision T 1710/09, when it comes to amendments there shall be no room for asking what the skilled person would seriously contemplate<sup>64</sup>. The novelty test in the context of amendments therefore seems to be very strict, probably even stricter than the novelty test in the context of novelty itself. With the

approach adopted in T 1710/09, it cannot be ruled out that selecting one element from a single list of elements of equal weight is not permissible and creates an unallowable extension.

Such an approach might in fact be in line with G 2/10. Selecting one element out of a series of elements of equal weight cannot reasonably be seen to be different from deleting all other elements from the original series. As argued above, this factually means that all other originally disclosed elements of the series are disclaimed, so that the remaining element would have to be directly and unambiguously disclosed to the skilled person in the application as filed. Without a particular weight being attributed to the selected/remaining element, a direct and unambiguous disclosure of that element as an individual may be questionable. For example, an original disclosure may refer to alternative chemical compounds for a certain purpose. If later one of these compounds is chosen, this might lead to a forbidden singling out of one compound. Such a singling out is used in G 2/10 to illustrate which standards must be applied when testing a disclaimer disclaiming positively disclosed subject-matter for conformity with the original disclosure<sup>65</sup>.

Alternatively, such a singling out can be also seen as a one dimensional shrinking of the original list to one element. When read together, decisions G 2/10 and T 1710/09 might thus suggest that a one-dimensional restriction of a list of elements is impermissible unless the remaining element(s) is/are given a particular preference in the original application. With such a conclusion and when “e7” is known in the present scenario, even disclosing all possible subgroups of sixty-three squares including “e4” as equally suitable alternatives should consequently be insufficient to obtain protection for “chessboard minus e7”. This amended subject-matter is then not validly claimable anymore.

For the far more limited subject-matter “e4”, the situation is probably more comfortable. In this scenario, “e4” is explicitly disclosed and – given its value – it is reasonable to assume that it is provided with some particular weight in the specification, in other words it is given a certain priority among the sixty-four disclosed squares. Then, irrespective whether it is “selected” from the one-dimensional list of sixty-four elements or whether all elements apart from “e4” are “deleted” from the list, “e4” is directly and unambiguously disclosed, even in the sense of G 2/10 and T 1710/09, respectively. In the scenario discussed here it should hence be possible to draft a claim directed to “e4” in compliance with Article 123(2) EPC. Contrary to the representation by a frame or the representation by lists, respectively, at least the most valuable element of the invention can be saved despite the partly anticipating prior art. The reason is that the disclosure of the invention in the original application is divided into small sections with particular weight being placed on the most relevant section. This leads to a comparison of the

59 T 1710/09, point 3.5.2 of the Reasons

60 T 1710/09, point 4.2 of the Reasons

61 T 1710/09, point 3.5.2 of the Reasons

62 T 1710/09, point 4.3 of the Reasons

63 T 26/85, O.J. EPO 1990, 22, Headnote I

64 T 1710/09, point 4.1 of the Reasons

65 G 2/10, Loc.cit., point 4.5.4 of the Reasons

discussed types of original disclosure as to allowable amendments and the resulting subject-matter.

### 3.4 Comparison of the discussed types of representation

When studying the second discussed type of representation, the representation by lists, it is seen that in principle this type of representation is well known as illustrated by the indices regularly found on a chess-board. In patent drafting, lists have traditionally been used quite frequently. However, an unintentionally overbroad disclosure using lists, which is in part anticipated by prior art, may result in a completely unpatentable application. Neither the original disclosure minus the prior art disclosure nor the unambiguously novel and most valuable part of the made invention may ultimately be claimable any more under the provisions of Article 123(2) EPC.

The two other discussed types of representing features, i.e. the frame and the permutations, are almost contrary to each other. The inventive concept is in both cases initially believed to be quite broad, and protection for the entire concept is sought. However, when a frame is chosen for the representation, this means all or nothing. If no prior art within the frame comes up, the entire frame may be patentable. With prior art falling into the frame, no limitations by way of amendment are possible and nothing will be patented. On the other hand, the very detailed disclosure of all possible features and permutations can also win the total protection if there is no novelty-destroying prior art. In case a partial anticipation occurs, it could happen that the claimable aspect of the invention must be limited down to very specific and hence very limited subject-matter.

## 4. Conclusions and suggestions

Drafting a fresh application is an interesting, yet definitively not simple exercise in view of the requirements for an original disclosure should amendments become required at a later stage due to conflicting prior art. For a patent attorney, there is a natural duty to define a new invention in rather broad terms so as to develop an intellectual property right which is of real value for the client. However, with broad terms, there is always the risk that a single anticipation sinks the entire vessel. This

is the situation illustrated by the frame of the chess-board.

It is therefore usually tried to split up a broad term into smaller elements. Already for a two-dimensional definition, it appears not advisable to group such elements in lists, because combinations of elements from lists are immediately suspicious of creating something new and therefore not originally disclosed. The fictitious skilled person is not a chess player; in EPO case law rows and lines are not sufficient to define a square.

The discussed recent case law may further suggest that enumerating permutations detailing a broader term, i.e. enumerating explicitly disclosed combinations of elements, is also of limited use. For the chessboard, this means that explicitly naming all squares as well as all conceivable sub-groups of squares is not necessarily a way out in case one square belongs to the prior art. When no preference is attributable to a specific subgroup of such enumerated permutations or squares, or to a single permutation or square, even a one-dimensional shrinking of the original disclosure could possibly violate the provisions of the EPC which govern amendments. This is a conclusion which may be drawn from G 2/10 and further case law. From the applicant's perspective, such a conclusion is certainly unpleasant.

As aforesaid, sometimes people identify three approaches applied by the EPO for assessing amendments, the strict, the stricter and the brutal. At present, there seems to be a tendency in the Boards of Appeal's case law to confirm this *bon mot*. Of course, there can be no doubt that third parties' interests must be safeguarded, and Article 123(2) EPC and the equivalent provisions prohibit a misuse of the applicant's freedom to draft and amend patent claims. The other side of the coin is a danger of an undue restriction of the very same freedom enjoyed by the basic users of the EPC system, applicants and patentees. The author concurs with the viewpoint that Article 123(2) EPC not only defines a prohibition, but should also be understood as an offer to utilize and exploit the original disclosure in order to achieve the deserved protection for the entire patentable subject-matter of the original application<sup>66</sup>. Whichever test for assessing whether or not amendments are supported by the original disclosure is used, balancing of all relevant interests, including those of applicants and patent proprietors, must not be underestimated.

<sup>66</sup> Blumer in: Singer, Stauder, *Europäisches Patentübereinkommen*, Art. 123, marginal no. 32, with reference to Kraßer, GRUR Int. 1992, 699, 702, and to Zeiler, *Mitteilungen der deutschen Patentanwälte*, 1993, 353

# Monumental Changes to U.S. Patent Law: Issues Related to the Implementation of the Leahy Smith America Invents Act

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## I. INTRODUCTION

The historic legislation known as the Leahy Smith America Invents Act<sup>2</sup> (hereafter referred to as the "AIA"), was signed into law on 16 September 2011 and is considered the biggest reform to U.S. patent laws since 1836<sup>3</sup>.

At its broadest level, the AIA changes the legacy U.S. patent law system from "first-to-invent" to what it is termed a "first-inventor-to-file" system<sup>4</sup> (also referred to by some alternatively as "first-to-file-with-grace"), thereby somewhat harmonizing the U.S. system with that of other countries. In addition, the AIA also provides other significant changes, including authorization for the United States Patent and Trademark Office (hereafter referred to as the "USPTO") to re-examine granted patents through a framework of *inter partes* and post-grant proceedings<sup>5</sup>, a change which may alter the landscape of patent litigation dramatically. The AIA will eliminate old interference proceedings for resolving priority contests among near-simultaneous inventors who both file applications for the same invention because priority will now be determined based on filing date, and will be replaced by new derivation proceedings<sup>6</sup>. Such derivation proceedings are designed to ensure that the first to file an application is actually the original inventor, and that the application was not derived from another inventor<sup>7</sup>. Also, significant changes have been made to the understanding of novelty as defined under 35 U.S.C. 102<sup>8</sup>, and this may yield certain benefits for filings that originate in foreign countries. Prior art definitions are also included, with some notable changes including the defining of prior art with reference to the effective filing date only, and not the date of invention, as well as also providing for the expansion of prior art to include foreign offers for sale and public use<sup>9</sup>.

Administratively, the AIA provides for Congressional appropriations oversight over the USPTO budget such that the official functions of the USPTO would be at no

net cost to the U.S. taxpayer<sup>10</sup>. Within this oversight, the USPTO Director will be able to adjust fees to meet market conditions as needed, and many fees have already, or will increase<sup>11</sup>. Additionally, the USPTO is required to establish three or more satellite offices around the country, including one in Detroit<sup>12</sup>. Additionally, effective in 2013, the current Board of Patent Appeals and Interferences ("BPAI") will be replaced by the Patent Trial and Appeal Board ("PTAB")<sup>13</sup>.

Each of the above changes will have different dates of implementation. Not all of the changes took effect upon the actual signing of the law in September 2011. Furthermore, exactly how certain aspects of the law will be implemented by the USPTO through different rule promulgations, will significantly affect the importance of some of these changes as well.

The AIA is therefore quite extensive in reach, and the entirety of it cannot be fully described in one article alone. To that end, the present goal is to discuss the aforementioned broad changes and to provide practice tips for foreign attorneys and corporate intellectual property management, so that they can be better aware of the revisions under the AIA and how the revisions may bear on tactical and strategic patenting planning. Accordingly, what follows is a categorical listing of some of the changes and the expected rules to be implemented therefrom.

## II. FIRST-INVENTOR-TO-FILE SYSTEM AND CHANGES TO PRIOR ART DEFINITIONS

Under the AIA, the U.S. patent law system will change from a "first-to-invent" ("FTI") system to a "first-inventor-to-file" ("FITF") system on March 16, 2013<sup>14</sup>. Under this change, an application will now be subject to the FITF system if the application at any time contained a claim with an effective filing date on or after March 16, 2013, or if a claim is made for priority benefit from any application that may have contained such a claim at any time. This change represents both significant conceptual and practical changes, because the U.S. patent laws from 1836-2011 favoured granting patents based upon inventive work done in secret, a potentially problematic dynamic, given that it raised questions regarding the authenticity and proof of timing as to when the alleged patentable work was actually performed by the inventor. Under the "first-inventor-to-file" system, the AIA now favours granting patents to inventors who take affirm-

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2 The full text of the Leahy Smith America Invents Act (AIA), designated as Public Law 112-29, signed into law on 16 September 2011 is available at [http://www.uspto.gov/aia\\_implementation/20110916-pub-l112-29.pdf](http://www.uspto.gov/aia_implementation/20110916-pub-l112-29.pdf).

3 Gongola, Janet, USPTO Patent Reform Coordinator, comments introducing the AIA implementation on 30 September 2011, at [http://www.uspto.gov/aia\\_implementation/blog.jsp](http://www.uspto.gov/aia_implementation/blog.jsp).

4 Ibid.

5 AIA, Section 6.

6 AIA, Section 3.

7 Ibid.

8 Ibid.

9 Ibid.

10 AIA, Section 22.

11 AIA, Sections 10 and 11.

12 AIA, Section 23.

13 AIA, Section 7.

14 AIA, Section 3, 35 USC §§100, 101, 102 & 103.

ative steps to make an invention public before filing, so that the public can promptly benefit from the disclosure.

True first-to-file ("FTF") systems generally provide that the first entitled person to file a patent application, for any invention that is not in the public domain, will receive the patent rights, even if someone else invented it first. It is not uncommon for many to assert that the U.S. now has a FTF system that brings the U.S. in harmony with most of the world<sup>15</sup>. However, due to the clear differences outlined above it is more accurate to term the U.S. system under the AIA as a FITF system because it has at least one distinguishing factor from most FTF systems, familiar to European attorneys and practitioners. Specifically, the AIA provides a one year grace period from the time of disclosure of the invention by either the inventor (or someone who rightfully obtained the invention from the inventor), during which the inventor has the ability to obtain patent protection, thereby earning the alternative nickname of a "first-inventor-to-file-with-grace" ("FITFG") system<sup>16</sup>. Accordingly, such a disclosure by the inventor can act as a bar to anyone else filing for patent protection on the invention (even where someone else has independently invented it first) yet provides a one year window for the disclosing inventor to obtain patent protection.

#### A. Changes to Novelty

Section 3 of the AIA makes dramatic changes to the novelty requirement in the U.S. patent system. Accordingly, 35 U.S.C. §102 has now been reformed with a requirement for "public accessibility" of subject matter in order for it to be considered "prior art". Such "public accessibility" essentially means that disclosures must be available to the public (35 U.S.C. 102(a)(1)) or that earlier U.S. patent filings must have been subsequently made public (35 U.S.C. 102(a)(2)). Note that "public accessibility" is not explicitly defined in the AIA, and will likely be clarified by forthcoming USPTO regulations or legal precedent. Also, aspects that are beneficial to certain inventors and collaborative inventor groups are provided, such as retaining the legacy one year inventor grace period for disclosures, and disallowing co-workers' and collaborators' earlier patent filings as "prior art" for use in novelty determinations. Overall, the known aspects of novelty have been replaced with similar, yet different guidelines on novelty that lends a single, common understanding of "prior art" as a definition for *both* novelty and non-obviousness.

Within the FITF system, each patent application is given an "effective filing date", defined as either the actual filing date of the patent application, or the filing date of the earliest patent application from which priority is claimed, including foreign applications (e.g., Paris Convention based priority under 35 U.S.C. 119) and international applications (e.g., PCT based priority under

35 U.S.C. 365). Assessments of novelty are based on whether any prior art was available before the "effective filing date", as defined by the new 35 U.S.C. 102(a). To this end, the new 35 U.S.C. 102(a) has two parts, 35 U.S.C. 102(a)(1) and 35 U.S.C. 102(a)(2) that specifically delineate respective classes of prior art.

The new 35 U.S.C. 102(a)(1) essentially combines elements of legacy novelty sections 35 U.S.C. 102(a) and 102(b) such that a given patent application will be rejected if the claimed invention was patented, described in a printed publication, in public use, on sale, or "otherwise available to the public" before the effective filing date. The AIA expands the scope of available prior art compared to previous definitions by removing the legacy limitation to prior art from "this country [the U.S.]" and references to "a foreign country" as it pertains to bars for "public use" and "on sale". Furthermore, the AIA adds the verbiage "otherwise available to the public" to the new 35 U.S.C. 102(a)(1). Hence, the new 35 U.S.C. 102(a)(1) contains no geographical limitations, thereby expanding available prior art to any subject matter that is publicly available anywhere in the world, prior to the filing date of the patent application. Thus, any public use or sale abroad that occurs prior to the filing date of the U.S. application can be used as prior art against the patent application. This definition of "prior art" will no doubt be familiar to patent attorneys practicing before the EPO and European national offices.

The new 35 U.S.C. 102(a)(2) further defines prior art for any publications of U.S. patent applications and PCT publications designating the U.S., as well as U.S. patents, where such references name another inventor. In such cases, these references are deemed prior art as of their earliest "effective filing date", regardless of publication date, so long as that date is before the "effective filing date" of the claimed invention. Further to this point, publications of U.S. applications having a claim of priority to a non-U.S. application may be considered prior art for both novelty and non-obviousness assessment as of the filing date of their foreign priority claim. Note, however, that where a publication or patent discloses subject matter obtained directly or indirectly from the inventor or a joint inventor, or where the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor), before such subject matter was filed, it is not deemed prior art under 35 U.S.C. 102(a)(2) as of its earliest filing date, but may still be prior art under new 35 U.S.C. 102(a)(1) as of its publication date. In the case of PCT publications, the language of the application will not affect the status of such publications as prior art under this section. Clearly, 35 U.S.C. 102(a)(2) mirrors the definitions of prior art or "state of the art" in Art. 54(3) EPC, however a corresponding "novelty only" proviso present in the second sentence of Art. 56 EPC is not present and therefore prior art which is relevant to novelty only in Europe can be assessed for relevance to inventions in the U.S.

15 See, e.g., "The Global Impact of the America Invents Act", WIPO Magazine (December 2011) at [http://www.wipo.int/wipo\\_magazine/en/2011/06/article\\_0002.html](http://www.wipo.int/wipo_magazine/en/2011/06/article_0002.html).

16 See, e.g., "The America Invents Act for Academic Scientists", Science Magazine, 3 February 2012 at [http://sciencecareers.sciencemag.org/career\\_magazine/previous\\_issues/articles/2012\\_02\\_03/credita.1200013](http://sciencecareers.sciencemag.org/career_magazine/previous_issues/articles/2012_02_03/credita.1200013).

Furthermore, new 35 U.S.C. 102(b) provides for a one year grace period and two distinct classes of exceptions to the prior art determinations under 35 U.S.C. 102(a), found respectively in sections 35 U.S.C. 102(b)(1)(A) and 35 U.S.C. 102(b)(1)(B) which will be unfamiliar to European practitioners. The one year grace period under new 35 U.S.C. 102(b)(1) is measured from the priority date of an application rather than the earliest filing date in the U.S., thereby offering foreign applicants a potential advantage when claiming foreign priority. As it relates to the prior art exceptions, the first exception is contained within new 35 U.S.C. 102(b)(1)(A) which provides that a "disclosure" made by the inventor or otherwise obtained directly or indirectly from the inventor one year or less prior to the "effective filing date" will not be deemed prior art, thereby giving an inventor the advantage of not having his own work considered as prior art under 35 U.S.C. 102(a)(1) if it is disclosed within one year of his earliest filing date. The second exception is contained within new 35 U.S.C. 102(b)(1)(B) which provides that any disclosure made one year or less before the effective filing date of a claimed invention where "the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor" will not be deemed prior art under 35 U.S.C. 102(a)(1). This provides the inventor protection from a disclosure by a third party if it was disclosed after a previous disclosure by the inventor, before the patent application was filed. Separately, the AIA also provides through new 35 U.S.C. 102(b) (2) (C) and 102(c) for the exclusion of prior art under new 35 U.S.C. 102(a) (2) as of its earliest filing date for purposes of obviousness and novelty for a reference owned by same company or subject to joint research agreement, however, such a reference may be available as prior art under new 35 U.S.C. 102(a) (1) as of its publication date.

#### B. Changes to Obviousness

The AIA provides that obviousness will be assessed based on the "effective filing date" of the application, instead of the "time of invention" as required presently. Hence, the revised 35 U.S.C. 103 provides a basis for rejection of patent applications when the differences between the claimed invention and the prior art references are of the type that the whole of the claimed invention would have been seen as obvious before the "effective filing date". Essentially, where there is any prior art from before the effective filing date that would make the claimed invention obvious, the USPTO will then reject the application based on obviousness.

### III. POST GRANT PROCEEDINGS/EVALUATING THE VALIDITY OF PATENTS

The AIA provides interested parties increased options to challenge or otherwise re-evaluate the validity of a patent by maintaining the existing *ex parte* re-examination process, by replacing the *inter partes* re-examin-

ation with an *inter partes* "review" and also by adding three other types of post grant review proceedings:

**Post-Grant Review Proceedings (Section 6):** The AIA creates a new administrative construct called "post-grant review" that allows settlement of disputes involving patent quality and scope (i.e., virtually all issues of patent validity). Effective one year after enactment of the AIA, any third party may petition the USPTO to review the validity of an issued patent within nine months of its issuance. Although superficially similar to opposition proceedings before the EPO, under the post-grant review process a patent may be challenged on any grounds of patentability, and the petition will be granted where the petitioner demonstrates that "if such information is not rebutted, [it] would demonstrate that it is more likely than not that at least one of the claims challenged in the petition is unpatentable". Compared to existing re-examination which is limited to consideration of only patents and printed publications in view of prior art, the new post-grant review instead encompasses a greater scope of review and provides a lower burden of proof, and the petition can be supported by patents, printed publications, as well as supporting factual or expert opinion evidence that relates to assertions that any claim is invalid for prior art reasons, and/or for other reasons, such as allegedly unpatentable subject matter (i.e., 35 U.S.C. § 101 matters) or for indefiniteness reasons (i.e., 35 U.S.C. § 112).

New Chapter 32 therefore institutes the post-grant review process and generally applies only to patents which issue under the new FITF rules (e.g., applications filed eighteen months after enactment), except for "business method" patents which are covered by separate, transitional post-grant review rules discussed below. Notably, interferences instituted less than one year after enactment of the AIA may be dismissed (without prejudice) by filing of a petition for post-grant review.

**Inter-Partes Review Proceedings (Section 6):** The AIA provides for a new type of proceeding, *inter partes* review, that grants one who is not the owner of a patent the right to file a petition to institute *inter partes* review of a patent. The new proceeding represents a transition from an examiner based *inter partes* patent "re-examination" to a "review" proceeding at the new Patent Trial and Appeal Board (PTAB). The proceeding will allow for limited discovery, settlement, oral hearings, protective orders and many litigation style specifics. Accordingly, the old *inter partes* re-examination process is therefore scheduled for termination on September 15, 2012, to be replaced by the new "*inter partes* review" on September 16, 2012.

Such *inter partes* reviews will be governed by new rules in Chapter 31 that will apply to the institution and conduct of any *inter partes* review commenced after enactment as to all patents, whether issued before, on, or after enactment. In the interim, current Chapter 31 continues to control *inter partes* re-examinations filed

before enactment. However, effective as September 16, 2011, the standard for triggering an *inter partes* (but not an *ex parte*) proceeding has been changed. The new standard has now been elevated from the old standard of making a showing regarding issues that raise a “substantial new question of patentability” (“SNQ standard”), to a higher standard which asks whether there is a “reasonable likelihood that the requester will prevail with respect to at least one of the challenged claims” (“reasonable likelihood standard”). In any case, *inter partes* proceedings will be limited to issues involving relevant patents, printed publications, and related novelty and non-obviousness questions, and accordingly, the grounds for this type of review is more narrow than that of the post-grant review.

The petition for *inter partes* review must be filed no later than one year after a patent is granted. *Inter partes* review is available after the nine month post grant review period has expired, and is thereby a subsequent option to filing of the post grant proceedings. Once an *inter partes* review petition is filed, the patent owner may thereafter file a response to the petition that sets forth reasons why no *inter partes* review should be instituted based upon the failure of the petition to meet specific requirements. The AIA prohibits the Director from authorizing an *inter partes* review to commence unless the Director determines that the information presented in the petition, and any response thereto, shows that there is a reasonable likelihood that the petitioner may prevail on at least one of the claims challenged in the petition, thereby limiting frivolous proceedings.

The Director’s determination as to whether to institute an *inter partes* review pursuant to a petition must be made in writing within three months after receiving a response to the petition, or if no such response is filed, the last date on which such response may be filed. The determination by the Director is not appealable.

**Supplemental Examination (Section 12):** The AIA provides that a patent owner may ask for “supplemental examination” to consider new or corrected information. Proposed rules indicate that materials submitted will be limited to no more than 10 items, otherwise separate request and fees will need to be submitted for each grouping of 10 items beyond that<sup>17</sup>. If a validity issue is raised through the submissions, the USPTO will re-examine the patent, except if an allegation of invalidity over that art has already been made in a patent infringement action, in an International Trade Commission (ITC) section 337 proceeding, or in a detailed statement of the bases of invalidity or unenforceability of the patent by the applicant for an Abbreviated New Drug Application (“ANDA”). In providing for the examination, the AIA prohibits the assertion of an inequitable conduct defense against the owner of a reissued patent based upon the information considered, reconsidered, or corrected during a supplemental examination. This essentially provides

an alternative to having a court consider certain misconduct and validity issues in subsequent patent infringement litigation.

#### **Transitional Business Method Review (Section 18):**

Within one year of the enactment of the AIA, the Act provides that the Director of the USPTO will issue rules to permit someone being accused of infringing a business method patent to petition the USPTO to review the validity of the patent. Such review will only apply to a business method patent which “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” The functions of the program are the same as other post-grant proceedings initiated by the AIA, and allows for any party to request a stay of a civil action if a related post-grant proceeding is granted. This review process will expire eight years after the U.S. Patent and Trademark Office issue the rules governing this review process.

#### **IV. MISCELLANEOUS CHANGES**

The AIA also provides for numerous other stand-alone changes worthy of brief mention as follows:

**Inventor’s Oath or Declaration (Section 4):** The AIA changes the language in the inventor’s oath or declaration by requiring that the affiant swear that “the application was made or was authorized to be made by the affiant or declarant; and such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.” Noteworthy is the fact that this language from the inventor’s oath or declaration may instead be included in the assignment.

**Prior User Rights Defenses to Infringement (Section 5):** The AIA expands prior-user rights defenses (i. e., defenses to infringement based upon prior commercial use) and makes such defenses applicable to subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in manufacturing or other commercial process. Previously, such defenses were limited to business method claims. However, under this revision, the defense is not available where the subject matter of the patent was developed pursuant to a federal funding agreement, or by a non-profit institution of higher education or an affiliated technology transfer organization.

**Pre-issuance Submissions by Third Parties (Section 8):** The AIA allows, for a fee, any third party to submit for the record and for consideration any patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing within specified timelines. Any such submission must set forth a concise description of the relevance of each submitted document and must include a statement

<sup>17</sup> Federal Register, Vol. 77, No. 16, Wednesday, January 25, 2012, USPTO Proposed Rules at p. 3667.

affirming that the submission is in compliance with the AIA. Note that the AIA apparently does not provide for submitting (now expanded) prior art that includes foreign sales or uses in pre-issuance submissions by third parties because pre-issuance submissions are limited to relevant patent applications, patents, published patent applications and/or other printed publications.

**Best Mode Requirement (Section 15):** The AIA removes the patentee's failure to comply with the best mode requirement as a defense to patent infringement. Accordingly, while 35 U.S.C. §282 has been amended to eliminate best mode as a defense to patent infringement, 35 U.S.C. §112, first paragraph (and the guidance under MPEP §2165) still maintains best mode as a condition for patentability (although not necessarily for priority purposes in provisional and non-provisional applications). Therefore, the best mode requirement still exists and remains available as a basis for a rejection of an application by an Examiner.

**Marking (Virtual and False) (Section 16):** The AIA allows a manufacturer to "virtually mark" patented products by writing the word "patent" or "pat." on a product, along with a reference to an internet website that the public can access free of charge in order to learn more about the specific patent. This may be done in lieu of physically marking a product with a patent number. Additionally, the AIA clarifies that the patent holder would remain protected after the patent expires if he "virtually" marks the product and posts updated information on the internet. The AIA also eliminates the existing problem of predatory "false marking" claims by opportunistic parties. The AIA does this by requiring, among other things, that a person suffer a "competitive injury" as a result of false marking in order bring a civil action in federal court for compensatory damages.

**Advice of Counsel (Section 17):** The AIA provides that the failure of a defendant to obtain advice of counsel or the failure to present such evidence to the court or jury cannot be used to prove that the defendant wilfully infringed the patent.

**Jurisdiction and Procedural Matters (Section 19):** Under the AIA, the U.S. Court of Appeals for the Federal Circuit has jurisdiction over appeals involving compulsory patent counterclaims. Instead of the District Court for the District of Columbia, the Eastern District of Virginia is now the venue for appealing decisions of the USPTO Board of Appeals and PTA determinations. Perhaps more importantly, the AIA also tightens existing requirements by prohibiting the joining of causes of action or defenses in a suit by parties who are unrelated in a patent infringement action, thereby preventing non-practicing entities (also known as "patent trolls") from dragging all accused infringers into lawsuits in distant courts throughout the U.S. Under the AIA, plaintiffs will now have to file multiple lawsuits against unrelated defen-

dants instead of simply filing one single lawsuit naming unrelated multiple defendants.

**New Priority Examinations (Section 26):** The AIA requires that the USPTO provide prioritized examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness at no extra aggregate cost. Additionally a "Track I" prioritized examination is available for a fee of \$4,800 (reduced 50 % for small entities) in addition to other costs, for applications of a certain size and number of claims. The Track I prioritized examination does not apply to international, design, reissue, or provisional applications or to re-examination proceedings, but it may be available for continuing applications.

The stated USPTO goal for final disposition (e.g., mailing notice of allowance, mailing final office action) is expected to be on average 12 months from the date of prioritized status<sup>18</sup>. However, the prioritized exam may be terminated without a refund of any prioritized exam fees if the patent applicant petitions for an extension of time to file a reply or to suspend action or if the applicant amends the application to exceed the claim restrictions. Also, the program is limited to a maximum of 10,000 applications per fiscal year.

**Human Organism Prohibition (Section 33):** Effective September 16, 2011, no U.S. patent may issue on a claim directed to or encompassing a human organism. This "change" merely codifies old USPTO policy which already prohibited patenting a human organism, and provides that non-naturally occurring, non-human multicellular living organisms, including animals, are patentable subject matter.

**Fee Increases, Discounts and Electronic Filing Incentive (Section 10):** The AIA provides for setting fees, which the USPTO has announced includes a 15 % surcharge on all fees charged or authorized under 35 U.S.C. §41 (a), (b), and (d)(1). However, the 15 % surcharge does not apply to international stage PCT fees, certain petition fees, and enrolment fees. For each original application filed by paper, the USPTO has established a \$400 additional fee (reduced by 50 % for small entities) although design, plant, and provisional applications are excluded. Patent fees for filing, searching, examining, issuing, appealing, and maintaining patent applications and patents are eligible for discounts as follows: (i) a 50 % discount for small entities that qualify for reduced fees under 35 U.S.C. 41(h)(1); and a 75 % discount for "micro entities" as defined in 35 U.S.C. 123, as added by Sec. 10(g) of AIA. Also, under the fee setting authority of the USPTO Director, it is anticipated that the large entity fees for long application specifications (e.g., more than 100 pages in length) will rise 29 % and claims sets in excess of 3 independent claims will rise 84 % and claim

18 Gongola, Janet, USPTO Patent Reform Coordinator, „Status Report: USPTO Implementation of the America Invents Act, 2 December 2012, p. 5, at [http://www.uspto.gov/iaa\\_implementation/20111202-patent\\_reform\\_implementation-iu.pdf](http://www.uspto.gov/iaa_implementation/20111202-patent_reform_implementation-iu.pdf).

sets with more than 20 total claims will rise 67 %<sup>19</sup>. Similarly, the fee for lodging a Request for Continued Examination ("RCE") is projected to rise 83 % for large entities<sup>20</sup>. Interestingly, the fee for appeals, although set to increase (223 % total costs for large entity), is expected to be set lower than that of the revised RCE fee<sup>21</sup>. In any case, such fee projections may be revised in the interim, however the intent behind the projected increase will remain constant as the USPTO is aiming to reduce backlogs and streamline examiner processing times.

#### No-Fault Inventorship/No Mal-Joinder Invalidity:

The AIA now allows the assignee to file as the patent applicant, not merely the inventor. This allows assignee, or someone who has obligated an inventor to assign ownership rights, to file an application without obtaining an oath or declaration (or even permission or knowledge) of the inventor. Additionally, inventorship can now be corrected without swearing under oath that the error in naming inventors occurred without "deceptive intent." To this end, changes to named inventor can remove misjoinder/non-joinder as a patent validity issue in litigation, because any such changes will now merely determine ownership only.

#### V. RULE CHANGES – IMPLEMENTATION TIMELINE

The aforementioned changes will become effective at different dates<sup>22</sup>:

*Implementation of the "Group 1 Rule Changes":* This includes the aforementioned best mode changes, the human organism prohibition, the *inter partes* re-examination threshold standard change, the court venue changes, the fee changes and establishment of a micro-entity fee status, and the electronic filing incentive and prioritized examination changes, all of which will occur at dates on or shortly after September 16, 2011, but in no case later than November 15, 2011;

*Implementation of "Group 2 Rule Changes":* This includes the aforementioned inventor's oath/declaration change, the third party submission of prior art for patent application program, the supplemental examination program, the citation of prior art in a patent file changes, the priority examination for important technologies program, *inter partes* review, post grant review, and the transitional program for covered business method patents, all of which will occur on September 16, 2012; and

*Implementation of "Group 3 Rule Changes":* This includes the aforementioned FITF system, the derivation

proceedings program, and the repeal of Statutory Invention Registration system, all of which will occur on March 16, 2013.

In implementing these changes, the USPTO has indicated that it will conduct, in the upcoming months, thirteen different "notice and comment" periods for rule making. It will post these periods and other notices related to the AIA on a dedicated "AIA Micro-Site" which can be found at <http://www.uspto.gov/american-inventsact>.

#### VI. PRACTICE TIPS

The substantive and procedural changes under the AIA may be too extensive to fully summarize as a "one size fits all" collection of practice tips, given that many foreign patent attorneys, counsel and patent holders overseeing patent prosecution and litigation in the U.S. will be faced with numerous types of patent portfolios and competitive environments. However, some of the following practice tips for both prosecution and litigation are nevertheless highlighted below:

##### A. Patent Prosecution

- **New Advantages/Disadvantages:** Given that the "first to invent" system is abolished for new patent filings, any issues related to conception, diligence, and reduction to practice will not be relevant to future patentability. Similarly, abandonment, suppression, and concealment will also no longer be factors of concern. Many may consider the new system more advantageous. It is helpful to remember however, that despite the changes, the new system does not provide an ability to overcome prior art by swearing behind it, and may also contain some additional disadvantages in certain areas.
- **Monitoring Both In-House and Competitive Patent Portfolios:** Given the expanded options for challenging the validity of U.S. patents, patent holders should closely monitor the patenting activities of their competitors to assess whether to challenge the validity of any patent that issues, especially those regarding its mission-critical technologies. Such challenges could come under the *inter partes* proceedings, or preferably, under the "post-grant review proceedings" program. Similarly, companies may wish to monitor patent publications in order to decide whether to submit prior art in applications under the "preissuance submissions by third parties" program described above. As a preventive measure, companies should assess their own approaches to the making of rapid patent filings and should contemplate having very thorough patentability searches done before filing, so as to lessen the risks of having patents challenged by others. Thereafter, companies may consider using the "supplemental examination" program in cases where they become aware of additional relevant prior art in order to shield their patents from subsequent challenges by competitors. However, note that "supplemental examination"

19 USPTO, "Executive Summary: Patent Fee Proposal", as submitted to the Patent Public Advisory Committee on 7 February 2012, p. 11, at [http://www.uspto.gov/aia\\_implementation/fee\\_setting\\_-\\_ppac\\_hearing\\_executive\\_summary\\_7feb12.pdf](http://www.uspto.gov/aia_implementation/fee_setting_-_ppac_hearing_executive_summary_7feb12.pdf).

20 Ibid.

21 Ibid.

22 Gongola, Janet, USPTO Patent Reform Coordinator, comments introducing the AIA implementation on 30 September 2011.

costs are expected to be quite severe<sup>23</sup>, so much so that patentability searches done in advance of filing for important technologies may, in some cases, be more cost effective.

- Flexibility in How and When Patent Applications are Filed in the U.S.: The new definition of “prior art” and the aspects of the first to file system may merit several strategic considerations as to when one should file. Hence, it is important to understand that an applicant can choose the FITF system based on when they file. In fact, the applicant may even be able to choose the new system for applications that are already filed, because the FITF rules apply to any application that contains (or contained at any time) a claim which has an effective date that is one year or more after the date of enactment of the AIA (or which contains a reference to a priority application that contains or contained at any time such a claim). As such, an applicant can creatively manipulate the application of the FITF rules on an application by filing a continuation-in-part application that contains at least one claim that relies on new matter in the continuation in-part. When done in this manner, all claims of that application (including any that were supported by the pre-AIA application) will be examined under the new rules, even if the newly-added claim were to be subsequently withdrawn. This could effectively protect an application from assertions of prior art under pre-AIA law (e.g., rejections relating to prior invention under the legacy section 35 U.S.C. 102(g)), given that certain types of prior art are no longer deemed “prior art” under the AIA system. Conversely, where an applicant needs to rely on invention date proofs, this advantage may be lost in a continuation in-part filing.
- Consider Duplicate Filings: Following on from this it may be advantageous under certain conditions for applicants to consider duplicate applications, with one filed before the complete transition to the FITF system, and another filed afterwards. Rather than *delay* filing in order to obtain the advantages of the FITF system, filing duplicate applications may be more desirable. For applications filed in the normal course before the transition, a duplicate filing immediately after transition to the FITF system might therefore be a viable strategy in order to reap the advantages of the new law, obviously keeping in mind the limitations for those who need to rely on invention proofs under the existing FTI system. If pre-transition filing dates are *not* needed for priority or prior art reasons, then any post-transition filing will provide advantages that certain prior inventions and secret uses would *not* affect patent validity, and near duplicate patents can issue given the improved 35 U.S.C. §102(b)(2)(c) exceptions. Although this approach may be alien to European attorneys, it is an important consideration for clients who wish to obtain patent protection in the U.S. only.
- Invention Publication Strategy: Under the pre-AIA law, publication before patent filing was not advantageous in the U.S. because any third party reading a publication might then promptly file a patent on your invention in order to attempt to become the first “inventor” to file for the patent. However, as discussed above, the AIA now better protects such an inventor by offering a grace period for inventors who publish prior to filing, so that the third party cannot prevail over the inventor who promptly files after their own publication. Nevertheless, publication before patent filing is not a preferred patenting tactic because even though the AIA seems to solve the “legacy third party” problem, because of the loss of 18-month potential for pre-USPTO publication secrecy and the quickening of the end of the inventor’s “grace period” after the outside publication.
- Recognize New Fees and Examination Options: Applicants should encourage their U.S. counsel to move to electronic filing if they have not already done so, in order to avoid the new fee surcharges for paper filings. For time-sensitive patent protection strategies, consider asking U.S. counsel to pursue the Prioritized Examination program provided for under the AIA. Prioritized Examination is expensive, but offers advantages over existing expedited examination options. Specifically, when compared to the existing Accelerated Examination program, the new Prioritized Examination is simpler and does not require a pre-examination search or an examination support document, and unlike a Petition to Make Special (which is available only in limited circumstances), the Prioritized Examination will be available for most new applications.

Note that many specific fees are set to increase, except for the issuance fees, which will decrease. The fee increases will even affect simple particulars, such as late submissions of declarations, maintenance fees, and other smaller aspects of prosecution. Such increases seem especially large for entities that cannot avail themselves of small (50 %) and micro-entity (75 %) fee reductions. Many applicants (except for universities) will not be entitled to “micro entity” status because the requirements for a micro-entity are extraordinarily strict, and include both gross income limits of three times the median household income (about \$150,000) and caps on the number of applications made in the name of an inventor.

Such increases are particularly noticeable in the case of appeals and RCE processes. In fact the RCE and appeals processes may become so much more expensive that it may make sense to have U.S. counsel employ a telephonic interview with the Examiner early in prosecution, even upon receiving a first office action in a given case. Traditionally, cost concerns and the potential for expanded prosecution *estoppel* have caused U.S. counsel to employ Examiner interviews sparingly, often only for select cases. However, depending on the on-going fee increases for RCE and appeals processes, telephonic

23 UPSTO, „Executive Summary: Patent Fee Proposal”, as submitted to the Patent Public Advisory Committee on 7 February 2012, p. 11.

Examiner interviews early in prosecution may warrant consideration in some cases.

Further note that certain program costs, such as total “supplemental examination” are actually expected to be slightly higher than the cost to the USPTO of conducting the proceeding, and will cost between \$16,000-\$20,000+ for large entities<sup>24</sup>. In setting this extraordinary fee, the USPTO expects that the higher than cost fee will encourage applicants to submit applications with all relevant information during initial examination, thereby facilitating compact prosecution. To this end, it behooves applicants not only to take their duty of disclosure seriously when submitting an Information Disclosure Statement (“IDS”), but it may also mean that will want to obtain patentability searches prior to filing for important applications, in order to reduce the chances that they will encounter relevant disclosures later on that will warrant requesting supplemental examination.

- Update Assignments/Declarations As Soon As Possible: Declarations and/or assignments used for filing in the U.S. should be updated soon to reflect the “required statements” under the AIA. Although not required until September 16, 2012, if done across the board for all filings at one time, it can avoid subsequent complications. However, until the USPTO rule making is finalized, it is unclear what other information or statements might be further required.
- PCT Simplification: Under the AIA, use of PCT applications will be simplified starting immediately because the PCT applicant will be the assignee.
- Consider Foreign Sales/Uses in U.S. Patent Applications: Patent holders and foreign patent counsel should also be aware of the effect of foreign sales/uses when preparing to lodge US counterpart applications through their U.S. counsel.
- Recognition of Competing U.S. Patent Law Systems: Both patent holders and foreign patent counsel should recognize that despite the imminent changes discussed above, pre-AIA law will still control many proceedings before the USPTO and the courts for many years hereafter. To this end, interferences, FTI, previous prior art definitions and the like will continue to remain the law for certain cases for quite some time.

#### B. Litigation/Pre-Litigation

The AIA provides some important tools that foreign patent counsel and in-house intellectual property managers may wish their U.S. counsel use against competitors, both in and out of court:

- Consider Using the Post-Grant Review Process Instead of Litigation: Post-grant review provides a means for attacking a competitor’s new patent similar to post-grant opposition proceedings in other countries and at the EPO. Constant monitoring of competitor portfolios is warranted in order to meet the nine month

post-grant deadline. Anyone but the patent owner may institute the post-grant review process, and it includes the benefit of limited discovery. However, the post-grant review process has a large drawback which is not present in national litigation subsequent to opposition proceedings at the EPO, in that if the petitioner loses a final determination before the PTAB in this action, they cannot assert in a civil action or an ITC action any invalidity defense on a ground that was raised or which reasonably could have been raised in the process. Also, defendants in current actions on business method patents should consider the effect of the availability of post-grant review on the conduct of the litigation. Conversely, patent owners may wish to consider the alternative use of *inter partes* proceedings for novelty and obviousness issues. Nevertheless, the *inter partes* process, like the post-grant review process is fairly expensive and also carries with it *estoppel* issues, although these are somewhat more limited in scope than in the post-grant review process.

- Consider Use of Derivation Proceedings: Patent applicants and owners should monitor competitors’ recently published and issued applications and patents for similar or identical claims that may have been derived from their inventors in order avail themselves of relief by civil action in federal court for an allegedly derived, earlier filed patent containing a claim that was effectively filed on or after March 16, 2013 or that claims priority from such an application.
- Consider Foreign Sales/Uses in U.S. Patent Applications: If a third party is aware of a foreign sale or use that may serve as relevant prior art to a competitor’s patent application, they may not be able to utilize the third party submission process based on that reason alone, and may instead have to wait until after a patent is granted in order to submit a challenge in a post-grant review proceeding. If made in a timely fashion, the post-grant review proceeding provides for submission of affidavits or declarations including supporting evidence and opinions that may provide a better vehicle for such submissions. Conversely, as practitioners and patentees outside of the U.S. are well aware be careful of the effect of your sales or uses anywhere, as it will now have a more direct impact on the validity of any U.S. patents you may be asserting.
- Consider Use of Third Party Submissions: Vigilant monitoring of competitor patent applications is critical to maximizing the effective use of this program. Although the submission of prior art by a third party requires a written explanation of the pertinence of the submission, one important advantage is that the identity of the third-party submitter can be made confidential upon written request. Interested parties may even consider providing such submissions through another party in order to better preserve anonymity.
- Dismissal of False Marking Actions and Use of Virtual Marking: Defendants in “false-marking” litigation should request that plaintiffs dismiss such actions voluntarily and/or move to dismiss themselves. Com-

<sup>24</sup> Ibid.

panies who choose to employ “virtual marking” should retain proper records of any changes to patent information on their website, and may wish to consider use of a separate party to document such changes.

- Deceptive Intent Will No Longer Provide an Automatic Defense: Infringement actions can still be maintained even with an invalid claim based on deceptive intent because there is no statutory basis for invalidating the remaining claims where the subject patent contains an invalid claim and where “deceptive intent” has been proven.
- Understand the Joinder and Venue Changes: The AIA relieves certain unrelated defendants from having infringement claims against them being automatically joined in actions in distant court venues because now only related parties may be joined as defendants in a common suit. Other actions may require new venues depending on the action at hand, such as venue changes for actions under 35 U.S.C. §§ 32, 145, 146, 154 (b)(4)(A) and 293.
- Consider Whether a Prior Commercial Use Defense Exists: Importantly the AIA expands the prior commercial use defense to more than just business method patents and is therefore more akin to many national defences and exclusions in Europe. Where commercial use existed more than one year prior to the effective filing date or earliest publication of an asserted patent, the defendant now has a defense. Note that the scope of “commercial use” is quite broad, and may even encompass activities such as

work in a non-profit research lab and pre-marketing regulatory review.

- Litigation May Increase in New Areas: Expect uncertainty in many of the definitions and rules present herein. In the same vein, expect forthcoming litigation to define a whole new set of patent statute terminology. Conversely, while some litigation may decrease given the new post-grant processes under the AIA, such processes may represent a new form of “litigation” and indeed, some of these proceedings may involve appeals to the federal courts.

## VII. CONCLUSION

Despite the numerous changes described herein, the revisions in both prosecution practice and litigation mechanics brought about through the AIA are ultimately designed to result in positive results to the U.S. patenting system. Such positive results include more transparent patentability standards, objective criteria and simpler tests for patentability, and more predictable assessments of patentability. Notably, some aspects of these changes may, instead, be seen as providing a new and unique kind of patent system that exhibits characteristics of both the FTI and FTF systems, rather than a truly harmonized system. Nevertheless U.S. patent law will now follow many of the international norms on a broad swath of ancillary patenting practices, but patent holders and in-house counsel will be well-served by thorough consultation with their U.S. patent counsel regarding the various particulars and exceptions contained therein.

# Statistical Advice for Passing the EQE Pre-Exam

## or

### *How an untrained monkey can score 50 % better than a fully trained candidate*

O. Griebeling (NL)

The year 2012 will mark a milestone in the history of the European Qualifying Examination: it is the first year that a pre-examination will be organized, which will function as an entrance examination for the "true" EQE. Since it is a first time, much is uncertain for both the candidates and their supervisors. But from the little information given, some practical conclusions can be drawn.

The pre-exam is generally indicated as a multiple choice examination, but actually it is not a true multiple choice examination: at best it is a triple choice examination. From information available at the EPO's website (see: <http://www.eqe-online.org/pre-exam/>), it appears that the examination will contain a total of 20 questions, and each question will contain 4 statements. Each statement is either TRUE or FALSE. So, per statement, the candidate must choose from two options: he/she must state whether the statement is true or whether the statement is false. A third option would be to leave open the answer, indicating „don't know“.

This seems fairly simple, but in practice it is not so easy to quickly see whether a statement is true or false. And "quickly" is a key issue here: the total time available is 4 hours, so a candidate has on average 12 minutes per question to read and understand the question and the 4 statements, which leaves less than 3 minutes per statement.

The "true" examination has an open format, where the candidate has to formulate an answer. In such case, it is hardly possible to score if one does not know the answer, and it is very easy to lose points if the candidate knows the answer but does not formulate it correctly. In contrast, the choice-type pre-examination is more user-friendly for the candidate who does not know the answer, because it allows the candidate to guess. Whether or not guessing is attractive depends on the marking scheme.

It seems that the Examination Board is aware that guessing is possible. In an interesting note (see: [http://www.eqe-online.org/wiki/How\\_to\\_tackle\\_multiple\\_choice\\_questions\\_in\\_the\\_pre-exam/](http://www.eqe-online.org/wiki/How_to_tackle_multiple_choice_questions_in_the_pre-exam/)), the following information is given:

*In order to minimise the effect of guesswork, the marking scheme is biased in favour of candidates who get most or all of the 4 possible answers to a question correct. That is, if you get all the possible answers wrong, or only one of the four correct, you will score 0 marks. There is 1 mark if you have two of the four answers correct, 3 marks if you have three of the four*

*answers correct, and 5 marks if you have all four answers correct. A pass is awarded to candidates scoring 50 marks or more.*

Perhaps the Examination Board does not realize it, but actually they have invented a marking scheme that on the one hand is unfair and on the other hand is stimulating the candidates to guess.

The candidates are expected to handle 80 statements. A priori, there seems no reason for distinguishing between the different statements. Compare three candidates, each having correctly answered 40 out of 80 statements. A priori, one would say that such candidates are equally "good".

However, assume candidate A has his correct answers evenly distributed over the questions: two correct answers per question. This candidate has scored 20 points, and fails.

Assume candidate B has 3 correct answers in 13 of the 20 questions, plus one correct answer in one of the remaining questions. This candidate has scored 39 points, and fails.

Assume candidate C has 4 correct answers in 10 of the 20 questions. This candidate has scored 50 points, and passes.

This seems hardly fair.

Traditionally, candidates are given the advice to try all questions, therefore to spend no more than the calculated average time and then move on to the next question. In the context of the pre-exam, this would mean that the candidates would be advised to spend no more than 3 minutes per statement. But in view of the above statistics, it may well be advisable to reconsider such advice: it is better to correctly answer 100 % of 50 % of the questions than to correctly answer 50 % of 100 % of the questions.

In a statistically well-balanced marking scheme, guessing will have no or little effect on the score. On average, a candidate who does not know and is not afraid to tell this, should score the same amount of points as a candidate who does not know but is guessing. The logical consequence is that a WRONG answer should score less than NO answer.

In contrast, with the marking scheme proposed, guessing will have an enormous effect on the score.

Consider again candidate A above. Assume that in each question, the candidate has found two easy statements where he is absolutely certain of the answer. And

assume that these answers are indeed correct. With these answers, the candidate has scored only 20 points. If he leaves open the remaining difficult statements, he will fail.

Now the candidate knows, of course, that he still has to answer 40 statements, 2 in each of the 20 questions. However, he has no idea what the answers are, and/or he is running out of time. What does he do?

Surprisingly, the answer is: do random guesswork.

True "random" guesswork is in order if the answers TRUE and FALSE are truly randomly distributed over the questions. The above-mentioned note gives examples how guesswork might be less random to improve the chances on success. But for sake of illustration, consider true random guesswork, such as perhaps would be done by an untrained monkey (in analogy of Adam Monk). True randomness expects that, in each question, there is 25 % chance that both answers to the remaining statements are wrong, 25 % chance that the first is correct and the second is wrong, 25 % chance that the first is wrong and the second is correct, and 25 % chance that both statements are correct. It can easily be seen that in a series of 4 questions one would, on average, expect to score  $0 + 2 + 2 + 4$  additional points, i.e. 8 points.

In the total of 20 questions, with two answers per questions, it is possible to score anywhere between 0 and 80 (but no odd scores). It can be shown that, with true randomness per answer, the probability of scoring 30 points or more is as high as 96 %: chances are that the candidate will pass!

So what would happen if the exam rules were amended as follows:

- 1) a candidate is allowed to bring to the pre-exam an untrained monkey;
- 2) in each question, the candidate is allowed to select the two EASIEST statements to answer by himself
- 3) the remaining two MOST DIFFICULT statements per question are given to the untrained monkey for answering
- 4) the results of the candidate and the monkey are combined

To our surprise, we would see that, even if the candidate scores 100 % correct answers, the untrained monkey would score 50 % more points than the trained candidate. One may wonder why the Examination Board fancies such a marking scheme.

Statistics is a wonderful art. While being based on solid mathematical rules, it can be used to prove almost anything. But behind all this, there remains a practical truth for the candidates: if you do not know an answer, you'd better guess than leave the question unanswered. And you need only to know 50 % of the answers.

Just one final remark. It has been said in the past that the exam should, to some extent, be a reflection of the daily challenges of a patent attorney. By analogy, one might expect that the pre-exam is, to some extent, a reflection of the preparation program of a trainee. I do hope that the opposite is not true.

## Letters to the Editor

### The Editors believe that for the time being the theme of inventive activity is exhausted

## Über Jurisprudenz im Patentrecht

G. Kern (DE)

Die seit über hundert Jahren bisher allgemein anerkannte Philosophie der Jurisprudenz in Bezug auf das Patentrecht ist von Dr. jur. Dr. Ing. Joseph Kohler (1849 – 1919) in vielen bedeutenden und international geschätzten Schriften dargelegt worden und dort noch immer mit intellektuellem Gewinn nachlesbar. Das Europäische Patentübereinkommen (EPUe) wurde ursprünglich mit breitester internationaler Zustimmung streng nach der global nahezu einheitlich gelehrten Jurisprudenz verfasst und danach auch angewendet. Wenn jetzt Dr. A. W. Kumm in *epi-information* 2/12 die Meinung vorträgt, der bisher gültige Begriff von der erfinderischen Tätigkeit sei wissenschaftlich erledigt, stellt sich die Frage, ob dieser Meinung erfinderische Erkenntnis bisher verborgener Gegenstände menschlichen Denkens beispielsweise in Bezug auf eine Abscheidung sozio-ökonomischen Schrotts vom Patentrecht oder doch vielmehr nur das Bedürfnis zugrunde liegt, den Erfinder als persönlichen Schöpfer intellektuellen Eigentums durch namenlos anonyme Organisationen oder Roboter zu ersetzen, die mit Programmen scheinbar objektivierbarer Begriffe zeitgenössischen Managements gesteuert sind.

Der ursprünglichen Lehrmeinung liegt die Vorstellung zugrunde, dass das Patentrecht ein schwerwiegender Eingriff in das allgemeine Menschenrecht des Denkens, des intellektuellen Begreifens und Gestaltens, außerdem der Handels- und Gewerbefreiheit ist und als solcher besonderer Begründung bedarf. In Bezug auf die Beschränkung allgemeinen Menschenrechts kann die Begründung nicht aus allgemein gültigen Regeln und materiell objektivierbaren Umständen abgeleitet werden. Sie bedarf vielmehr zwingend individuell menschlicher Leistung, die als solche außerordentlich nicht im bekannten Geltungsbereich allgemeinen Menschenrechts erbracht wurde. Sie bedarf außerdem zwingend deutlicher und vollständiger Offenbarung (Art. 83 EPÜ) sowie öffentlicher Bekanntmachung (Art. 93 EPÜ) solcher außerordentlichen Leistung derart, dass sie danach allgemein nachgeahmt werden kann. Demnach ist erfinderische Tätigkeit diejenige, die zwar auf individuell menschlicher Leistung von Erfindern beruht, aber jedenfalls ursprünglich nicht im ordentlich bekannten Geltungsbereich allgemeinen Menschenrechts stattgefunden hat. Der Durchschnittsfachmann/die Fachfrau ist aufgrund allgemein zugänglicher Wissenschaft dazu befähigt, die deutlich und vollständig geoffenbarte und öffentlich bekannt gemachte Erfindung zu verstehen und zweckmäßig nachzuahmen.

Leuten, die öffentlich unzugängliche Wissenschaft im Geheimen nutzen, steht das ursprüngliche Patentrecht nicht zur Verfügung. Wenn T. Fox in *epi-information* 2/12 findet, „Der Fachmann (sei) die notwendige Fiktion im System“, so sind wohl mit der Fiktion die Fachleute im Sinne patentrechtlicher Jurisprudenz gemeint, zu denen die Hüter öffentlich unzugänglicher Wissenschaft eben nicht gehören, obwohl sie für sich den Ruf von Eliten der Gesellschaft in Anspruch nehmen. Aber der Fachmann/die Fachfrau im Sinne des noch immer geltenden Patentrechts gibt sich tatsächlich durch die in der vorhandenen Literatur allgemein zugängliche Wissenschaft einwandfrei zu erkennen und gehört so nicht in das Reich der Fiktionen sondern zur materiell menschlichen Realität.

Das Patentrecht im Sinne der Beschränkung allgemeiner Menschenrechte durch Verbot der Nachahmung bestimmter Technik wird zwar mit außerordentlicher Leistung der Art erfinderischer Tätigkeit und insbesondere mit der allgemein verständlichen Offenbarung solcher Tätigkeit begründet. Sein Schutzbereich ist durch den Inhalt der Patentansprüche bestimmt (Art. 69 EPÜ) und der Inhalt der Patentansprüche Gegenstand des Schutzbegehrens (Regel 29 EPÜ). Demnach hat das ursprüngliche Patentrecht nicht die Erfindung als solche sondern das daraus vom Erfinder oder seinem Rechtsnachfolger abgeleitete Schutzbegehren zum Gegenstand. Das durch die Patentansprüche bestimmte Schutzbegehren genügt allerdings in aller Regel nicht zum Nachweis erfinderischer Tätigkeit, die jedenfalls in einer zusätzlich beigefügten Beschreibung verständlich geoffenbart sein sollte. Im Gegenstand der Patentansprüche eines Patents sucht man also gewiss vergebens nach Wissenschaft erfinderischer Tätigkeit.

Dr. A.W. Kumm schlägt in *epi-information* 2/12 vor, anstelle erfinderischer Tätigkeit technischen Fortschritt als hinreichend objektives Merkmal einer Erfindung und so als Begründung des Patentrechts gelten zu lassen. Technischen Fortschritt als Begründung des Patentrechts hat allerdings die Jurisprudenz von jeher abgelehnt, weil die Bedeutung erfinderischer Tätigkeit für technischen Fortschritt von den ständig wechselnden Umständen allgemeiner technischer Entwicklung in der menschlichen Gesellschaft bestimmt wird und der durch eine Erfindung erzielbare technische Fortschritt als veränderliche Größe grundsätzlich nicht rechtsverbindlich festlegbar ist.

Patente wurden bisher erteilt gewissermaßen als Lohn für die Bereicherung der menschlichen Gesellschaft mit

allgemeiner technischer Wissenschaft durch Offenbarung anstelle der Geheimhaltung von aus erfinderischer Tätigkeit geschöpfter Erfindung. Im deutschen Sprachraum hat noch vor sechzig Jahren hauptsächlich Prof.Dr.jur. Dr.Ing. e.h. Lindenmaier gelehrt, dass das technische Patent gewissermaßen zum Wettbewerbsrecht gehört und den Fachmann/die Fachfrau von unlauterem Wettbewerb mit Erfindern abhält, indem es die gewerbliche Nachahmung unter staatlicher Aufsicht amtlich bekannt gemachter Erfindungen ohne die Zustimmung der Erfinder verbietet. Soweit das Wettbewerbsrecht eine moralische Verpflichtung zur Geltung bringt, gilt diese also gleichermaßen auch im Patentrecht und ist nicht nur durch erfinderische Tätigkeit sondern auch durch gewerbliche Tätigkeit der Erfinder oder ihrer Rechtsnachfolger begründet.

Im Hinblick auf den scheinbar unaufhaltsamen Fortschritt technischer Wissenschaft und ihrer Anwendung im wirtschaftlichen Wettbewerb stellt sich die Frage, was an solchem unaufhaltsamen Fortschritt denn noch als außerordentliche Leistung erfinderischer Tätigkeit mit

der Wirkung, allgemeine Menschenrechte einzuschränken, und als notwendige Voraussetzung des Fortschritts gelten kann. Diese Frage ist allerdings nicht neu. Sie hat vielmehr bereits vor über hundert Jahren beispielsweise den hier anfangs genannten Joseph Kohler umgetrieben und seitdem die Jurisprudenz des Patentrechts nicht mit endgültigem Abschied durch philosophische Antworten verlassen.

Im Hinblick auf die seit über einem Jahrhundert unverändert bestehenden Bedenken betreffend behauptete oder tatsächliche Willkür der Bestimmung erfinderischer Tätigkeit bleibt weiterhin mehr denn je zuvor die persönlich menschliche Individualität der Entstehung des Patentrechts als Begrenzung allgemeiner Menschenrechte zu berücksichtigen. Solche Individualität lässt sich weder durch Roboter noch durch Robotern ähnliche Organisationen oder elitäre Geheimbünde ersetzen. Vielmehr wird man die Patentämter zu schließen und auch die *epi*-information abzubereiten haben, wenn erst die Erfinder und deren erfinderische Tätigkeit aus dem technischen Fortschritt endgültig hinwegrationalisiert sind.

## Beitrag angeregt durch den Artikel von Herrn Dr. A. Kumm: „Die Crux mit der erfinderischen Tätigkeit und die schweizerische Chance ihrer operablen Bewertung“ (*epi* Information 1/2012, S. 22/23)

S. V. Kulhavy (CH)

In den Fusszeilen zum Artikel von Herrn Dr. Kumm wird auf seine Bücher hingewiesen, welche mit dem technologischen Denken in den Industrieunternehmen im Zusammenhang stehen. Der Text des vorliegenden Beitrags soll dieses Thema vertiefen.

Die Fachhochschule in St. Gallen organisierte am 25. April 2012 eine Innovationstagung. Während dieser Innovationstagung hat man unter anderem auch über die Resultate einer Umfrage in den schweizerischen Industrieunternehmen berichtet. Das Ziel dieser Umfrage war zu ermitteln, warum die Mitarbeiter in den Industrieunternehmen zu wenig innovativ sind. Etwa 60 % der Befragten haben sich darüber beklagt, *dass die Unternehmen ihnen nicht sagen, wie man Innovationen machen kann*. Etwa 40 % der Befragten haben darauf hingewiesen, dass sie innere Blockaden haben, welche sie daran hindern, bei den Innovationen mitzumachen. Lassen wir diese 40 % der Befragten zunächst beiseite, weil man gegen solche Blockaden mit anderen Mitteln vorgehen müsste als mit den hier besprochenen Mitteln.

Man kann sich fragen, warum die Industrieunternehmen nicht in der Lage sind, ihren Mitarbeitern zu

erläutern, wie Innovationen, d.h. auch Erfindungen entstehen. Die Industrieunternehmen haben andere Sorgen, als sich damit zu befassen, wie Innovationen entstehen. Die Patentanwälte wären für solche Erläuterungen eigentlich zuständig. Aber sie kümmern sich um solche Erläuterungen nicht. Beispielsweise im Art. 56 EPÜ wird auf den Fachmann Bezug genommen. Diesen Fachmann verstehen die Gerichte, Einspruchsabteilungen und die Prüfer als Durchschnittsfachmann. Damit diese Institutionen über Erfindungen entscheiden können, wird das Wissen und das Können des Fachmanns auf das Wissen und Können des für den jeweils beurteilten Fall zuständigen Durchschnittsfachmanns reduziert. Wie weit diese Reduktion des Wissens und des Könnens geht, *dies steht im freien Ermessen* der Gerichte, der Einspruchsabteilungen und der Prüfer. Folglich kann man sich als Partei im Voraus nicht einmal vorstellen, wie diese Institutionen entscheiden könnten.

Die technischen Innovationen haben eine ganz spezielle Eigenschaft, mit der sie sich von allen anderen Arten von Kreationen unterscheiden, nämlich, dass sie den Naturgesetzen, insbesondere dem Kausalgesetz,

gehören müssen, damit sie funktionstüchtig sind. Damit dies möglich ist, muss der Mensch während der Entstehung neuer Lösungen technischer Probleme logisch, d. h. schlussfolgernd bzw. konsequent denken. Wenn man den Mitarbeitern in der Industrie erläutern will, wie Innovationen entstehen, dann muss dies folglich so geschehen, dass diese Leute mit ihrer konsequenten Denkweise eine solche Erläuterung auch verstehen können.

Unter den genannten Bedingungen in den genannten Institutionen sagen sich die Patentanwälte jedoch, warum sollten wir uns um eine rational nachvollziehbare Erfassung von Erfindungen kümmern, wenn die genannten Institutionen nach ihrem freien Ermessen, d. h. nicht voraussehbar entscheiden? Als eine der Konsequenzen dieser Überlegungsweise gilt, dass sich, mit Ausnahme des Autors dieses Beitrags, niemand um die Umstände kümmert, unter welchen Innovationen entstehen. Und jetzt weiss man es auch, warum es sonst niemanden gibt, welcher den 60 % der Mitarbeiter in den Industrieunternehmen erläutern kann, wie Innovationen entstehen. Aus diesen Darlegungen sollte auch ersichtlich sein, wie die hier kritisierte Fiktion des Durchschnittsfachmanns, welche übrigens als längst überholt gilt, *die technische Entwicklung in den Industrieunternehmen im beträchtlichen Umfang blockiert!*

Man darf wohl annehmen, dass entsprechende Umfragen in anderen europäischen Ländern sehr ähnliche Zahlen liefern würden. Hieraus dürfte ersichtlich sein, *wie gewaltig gross der volkswirtschaftliche Schaden ist*, wenn es nicht möglich ist, den Mitarbeitern in den Industrieunternehmen in einer rational nachvollziehbaren Weise zu erläutern, wie Erfindungen und sonstige Innovationen entstehen. Ausserdem müsste aus den Zahlen der Umfragen sowie aus den vorstehenden Erläuterungen auch ersichtlich sein, *dass es in den Industrieunternehmen einen enormen Bedarf nach einer schlussfolgernden Erläuterung dessen gibt, wie Innovation entstehen.*

Nach dieser Darlegung der Situation und der Zusammenhänge, welche den Lesern dieses Textes wohl kaum bekannt waren, sollten die Leser, gleich wie der Autor dieses Beitrags, ebenfalls zum Schluss kommen, dass die Fiktion des Durchschnittsfachmanns fallen gelassen werden soll. Wenn dies geschehen würde, dann müsste keine Prüfungsweise von Erfindungen erst entwickelt werden, welche es ermöglichen würde, Erfindungen in einer logisch nachvollziehbaren Weise zu beurteilen. Dies deswegen, weil eine solche Prüfungsweise bereits bekannt ist und weil diese Beurteilungsweise von Erfindungen im Einzelnen ebenfalls bereits beschrieben wurde<sup>1</sup>. Im Rahmen dieser Prüfungsweise wird auch dargelegt, wie die erfinderische Tätigkeit in einer schlussfolgernden Weise beurteilt werden kann.

Eine sehr wichtige Folge des Verzichtes auf den Durchschnittsfachmann wäre es, dass die Patentanwälte beginnen würden, sich mit der rational nachvollziehbaren Theorie des Begriffes Erfindung zu befassen, weil

die Resultate der soeben erwähnten Beurteilungsweise von Erfindungen voraussehbar sind. Dann könnten die Patentanwälte den Leuten in der Industrie aber auch erläutern, wie die Innovationen entstehen. Damit könnte der enorme volkswirtschaftliche Schaden beendet werden, welcher sich daraus ergibt, dass die Leute in den Industrieunternehmen nicht wissen, wie Innovationen entstehen.

Die Situation heutzutage ist derart, dass die Innovationen den Leuten in den Industrieunternehmen nämlich nur intuitiv einfallen können. Wenn die Lösung eines gegebenen Problems einem intuitiv nicht einfällt, dann bleibt das Problem ungelöst oder sogar unlösbar.

Vor etwa hundert Jahren hat sich ein Gericht dahingehend geäussert, dass die mentale Tätigkeit, welche zu den Erfindungen führt, dermassen komplex ist, dass man nichts genaueres dazu sagen kann, ob eine Erfindung vorliegt oder nicht. Deswegen gelte der Begriff Erfindung als ein unbestimmter Rechtsbegriff. Nur der Richter im Rahmen seines freien Ermessens könne entscheiden, ob eine Erfindung vorliegt oder nicht. Dies ist eine Doktrin, welche auch heutzutage noch gilt. Ausserdem wird diese Doktrin mit allen verfügbaren Mitteln entschlossen verteidigt. Denn solange man sich auf diese Doktrin berufen kann, muss man nichts neues lernen und man muss auch nichts ändern. Und wenn es in einem Gerichtsfall darauf ankommt, dann probiert man es halt irgendwie, und man schaut, was daraus herauskommt. (Das Herzstück dieser Beurteilungsweise von Erfindungen bildet der Durchschnittsfachmann.) So versetzte sich das Patentwesen in einen „angenehmen“ lethargischen und seit Jahren dauernden Schlaf. Wegen diesem lethargischen Schlummer nahm das Patentwesen keine Notiz davon, dass sich die Situation betreffend die zu den Erfindungen führenden mentalen Prozessen vor allem während den letzten etwa 50 Jahren gründlich geändert hat.

Vor allem die modernen medizinischen Abbildungsverfahren, wie zum Beispiel die Computertomographie und weitere diesbezügliche Abbildungsverfahren, machen es möglich, der Tätigkeit des Gehirns beinahe zuzuschauen. Wer sich diesbezüglich weiter bilden möchte, der kann die Bücher beispielsweise der folgenden Autoren studieren: Antonio Damasio, Dietrich Dörner, John C. Eccles, Erich Kandel, Gerhard Roth, Manfred Spitzer und/oder anderer Autoren. Diese Literaturquellen beziehen sich allein auf die physiologischen und psychischen Prozesse, welche sich im Gehirn des Menschen abspielen. Keine dieser Literaturquellen befasst sich damit, wie die über die Denkweise des Menschen gewonnenen Erkenntnisse auf die Entstehung von Innovationen, d. h. auch auf die Entstehung von Erfindungen angewendet werden können. Das Studium solcher Bücher hat es dem Autor des vorliegenden Beitrags dennoch ermöglicht, jene mentalen Schritte zu entdecken, die zu den Innovationen führen.

Der Autor dieses Beitrags plant jetzt, eine Erfinderschule zu betreiben. Während dieser Ausbildung werden zahlreiche Bilder gezeigt und der Inhalt dieser Bilder wird vom Vortragenden erläutert. So kann wohl jeder Besu-

<sup>1</sup> S. Kulhavy: „Erfindungs- und Patentlehre“, Carl Heymanns Verlag, 2010, ISBN 978-3-452-27120-4

cher auch die schwierigsten Themen dieses Wissensgebietes verstehen. Nachstehend befinden sich Beispiele für Themen, welche in der Erfinderschule behandelt werden sollten:

- Methoden zur Registrierung von Hirnaktivitäten;
- Die Experimente von Deecke und Kornhuber sowie von Libet;
- Das Bewusste und das Unterbewusste beim Menschen;
- Die Wahrnehmung durch Sinnesorgane; aktivierbare Areale im Gehirn;
- Das Mentalsystem des Menschen in Analogie zur Architektur eines Computers;
- Die Funktionen des menschlichen Gedächtnisses;
- Das Blockschaltbild der Lösung technischer Probleme; „Allgemeiner Problemlöser“;
- Gehirnphysiologische Grundlagen der Kreativität; das Vorstellungsvermögen;
- Mentale Vorgänge während der Entstehung von Erfindungen;
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- Beseitigung von Denkblockaden bei der Lösung technischer Probleme; Empfehlungen für die Arbeit der Innovatoren;
- Lenkung von Naturkräften als die äussere Grenze der Technik;
- Gesetzliche Vorschriften darüber, was als Erfindung gelten kann;
- Als Erfindung gilt ...; „Der Ladenpult“;
- Ablauf der Prüfung von Erfindungen im Europäischen Patentamt (Ablaufschema).

Es wäre sehr zu begrüßen, wenn die massgebenden Institutionen auf die Beurteilung von Erfindungen auf der Grundlage des Durchschnittsfachmanns verzichten. Je schneller dieser Verzicht erfolgen würde, umso besser. Aus den hier dargebotenen Darlegungen sollte auch ersichtlich sein, dass der Durchschnittsfachmann nicht bloss ein „Sandkasten“ der genannten Institutionen ist, sondern dass dieses „Spielen“ gesamthaft einen gewaltigen volkswirtschaftlichen Schaden verursacht, und dass dieses daher nicht einen Schaden nur im jeweils beurteilten Fall nach sich ziehen kann.

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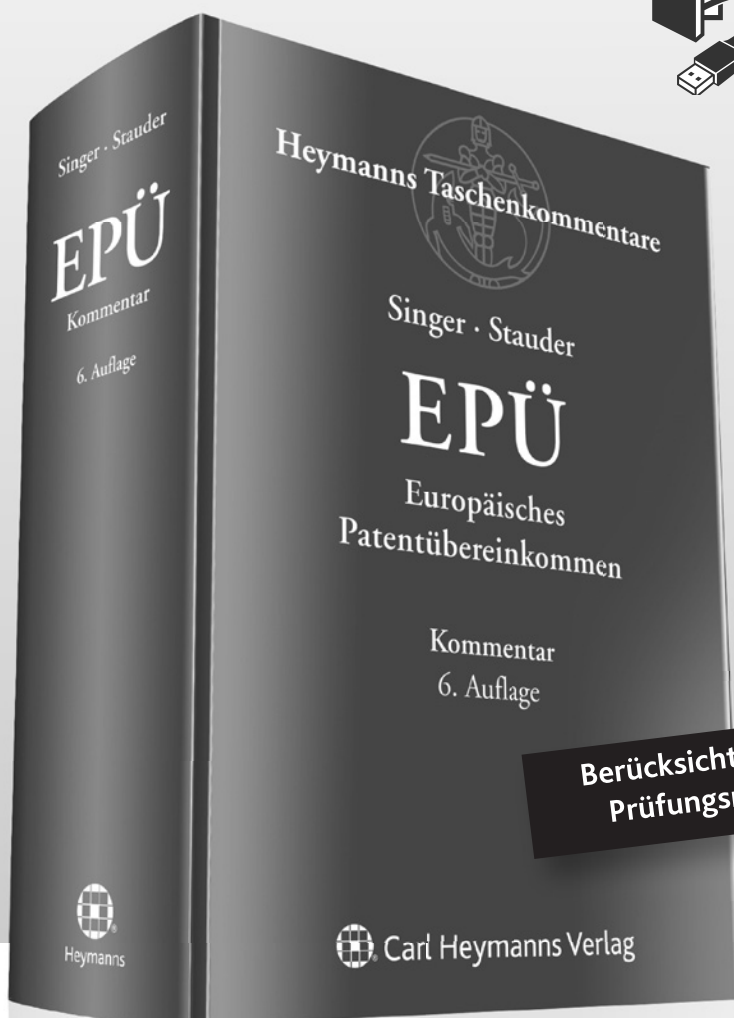
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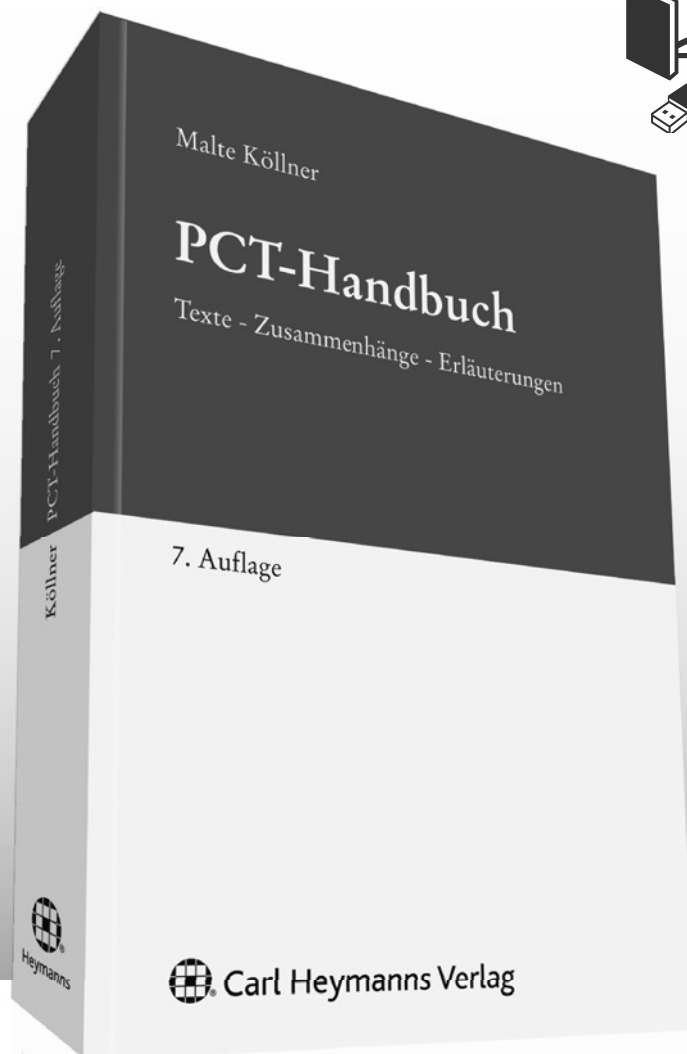
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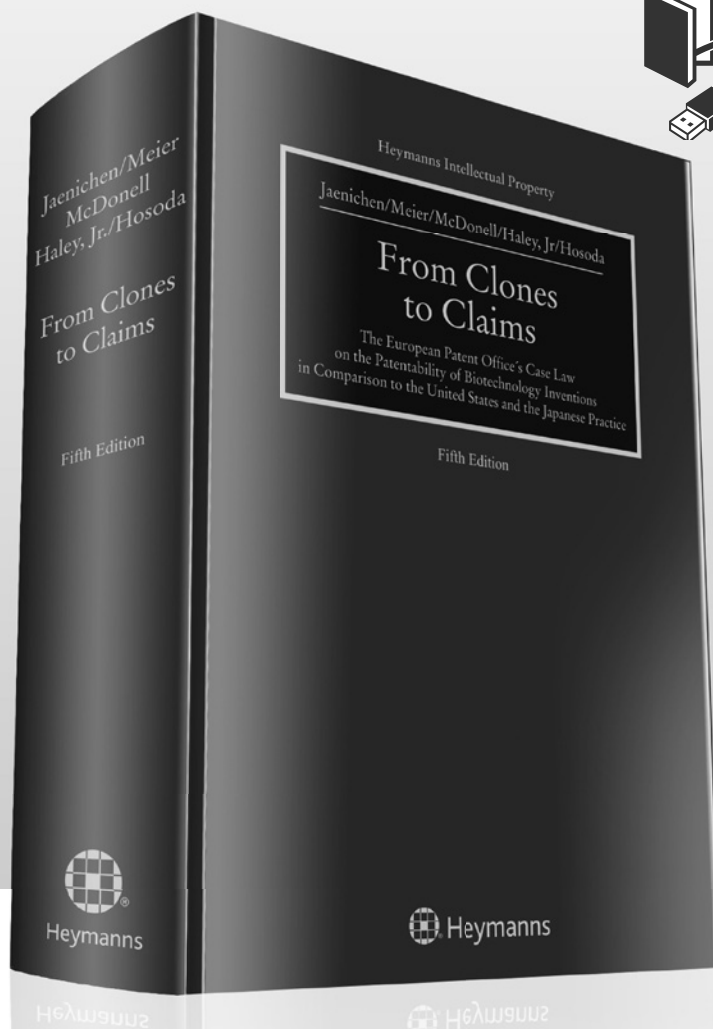
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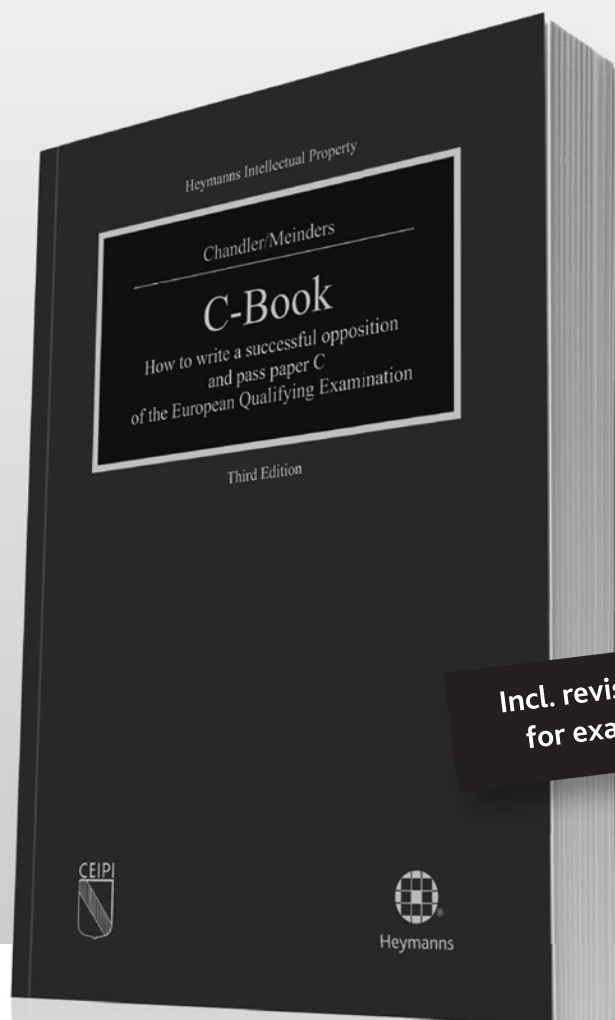
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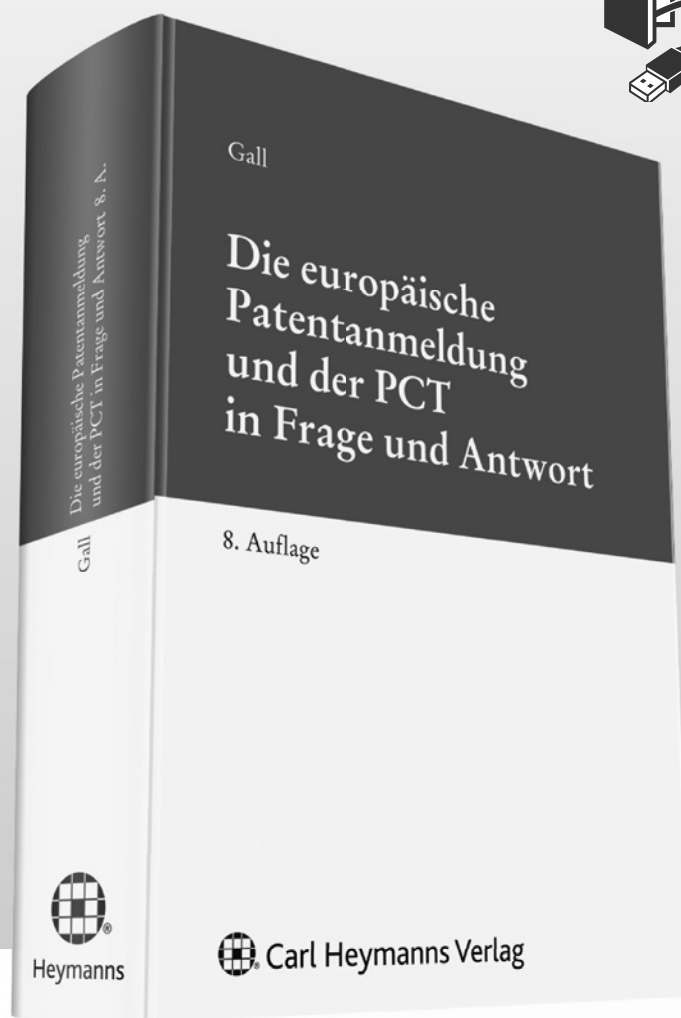
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