

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

99 Report of 73rd Council meeting

101 Committee reports

115 *epi* Subscription 2013

II – Contributions from epi Members and other contributions

106 Tutors' Report on the EQE 2012 Papers

120 Opponent Status – Questions and Answers? by J.H. Sunderland

129 UNION ExCo position paper – Principle of Prohibition of
Double Patenting before the European Patent Office

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Table of Contents

Editorial 98

I – Information concerning *epi*

Report of 73rd Council meeting 99

Committee Reports

Report of the European Practice Committee (EPPC),
by F. Leyder. 101

Report of the Professional Qualification
Committee (PQC), by P. Rambelli 102

Report of the Harmonisation Committee,
by F. Leyder. 104

Report of the Litigation Committee (LitCom),
by A. Casalonga 105

Education and training

Tutors' Report on the EQE 2012 Papers,
by P. Pollard, H. Marsman, D. Jackson, S. Roberts,
R. van Woudenberg. 106

epi Mock EQEs and *epi* Seminars 2013 113

Tutors wanted 114

Results of the 2012 European Qualifying
Examination 114

epi Subscription

Annual Subscription 2013. 115

Direct debiting mandate 116

Information from the Secretariat

List of Professional Representatives

as at 31.10.2012 118

Contact Data of Legal Division. 118

Deadline 1/2013. 98

Dates of issues of *epi* Information in 2013 113

Next Board and Council Meetings 119

News concerning *epi* Council and Committees. . . 119

epi Disciplinary bodies and Committees 133

epi Board U3

II – Contributions from *epi* Members and other contributions

Articles

Opponent Status – Questions and Answers?
by J.H. Sunderland 120

Position Paper

UNION ExCo position paper – Principle of
Prohibition of Double Patenting before
the European Patent Office 129

Editorial

T. Johnson (GB)

Grandfathers will remember it, those without grey beards or wrinkles will nevertheless be aware of it, and others may rue it. Our readers will of course know that we refer to the signing of the European Patent Convention in 1973, after a long journey with many pitfalls along the way. 1973 saw other events. To name but a (very) few: US involvement in the Vietnam War ended, Elvis Presley gave a concert in Hawaii which was the first world-wide telecast by an entertainer, followed perhaps fittingly by the release of Pink Floyd's "The Dark Side of the Moon", *Skylab*, the first US space station, was launched, and a patent for the ATM was granted. So the EPC is in interesting company and it is to the credit of those involved with it, including our Institute, that it is still going strong. We understand that the EPO will host celebrations in October 2013 to mark the signing; no doubt we shall return to the subject nearer the time. But on the basis of 'getting your retaliation in first', we congratulate the EPC on getting this far.

It is said that life begins at forty, what will EPC/EPO life be like after 2013? We do not pretend to know the answer to that question, but as our Institute would not exist but for the EPC the answer will undoubtedly affect all our members. However, our Institute can be proud in the knowledge that it has come a long way too. It also strives to be up-to-date and user –friendly, as evidenced by our new website which we hope will go 'live' in early 2013. This new tool is designed to be flexible, and to be regularly updated, and it will include a Forum for dialogue between members. So the launch will not be the destination, but rather a step on the journey of the *epi* towards modern communication and engagement with members of the Institute.

This being the last issue of our Journal before Christmas and the New Year, we on the Editorial Committee and on behalf of the President, Board and Council wish all our readers, whether members or not, a very Happy Holiday Season.

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 **15. Februar 2013**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for *epi* Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi* Information is **15th February 2013**. 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 **15 février 2013**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Report of 73rd Council Meeting, Hamburg, 10th November, 2012

T. Johnson (GB)
Editorial Committee

1. President Tony Tangena opened the meeting at 9am. The Minutes of the 72nd Council Meeting in Bucharest were adopted with minor amendments.
2. Legal Adviser: the Institute has recently appointed a Legal Adviser, a new post in the *epi*. The President then introduced the appointee, Nicole van der Laan. She will report to the President and assist Committee chairmen in their work.

Council welcomed her, and wished her well in her new job.

3. EPPC: Francis Leyder introduced an *epi* position paper on R36 EPC. Briefly the Rule was amended by the EPO purportedly to prevent "abusive" behaviour by certain applicants, particularly in the filing of divisional applications, which have allegedly "swamped" the EPO. The *epi* position paper proposes that R36 EPC should revert to its previous wording, namely allowing divisional applications to be filed during the pendency of the parent European application.

Council approved sending the paper to the EPO.

4. PQC: there was a long discussion on Continued Professional Education (CPE), in particular as to whether CPE should be mandatory for members. The EU Commission is apparently considering the introduction of CPE requirements on a profession-by-profession basis, having already done so for doctors and lawyers. PQC has the view that the *epi* should have a Regulation and Guidelines in place in anticipation of any EU Commission initiative, and set up a Working Group to study the topic. The Working Group has produced a draft Regulation and Guidelines, Council noting that CPE would be mandatory, and that 12 hours CPE would need to be recorded annually. Simon Wright (GB) gave a presentation for the guidance of Council on the GB national experience of CPE (which has an annual requirement for 16hrs recorded CPE).

PQC proposed that the Working Group complete its work in December 2012, and that the Board and Council decide respectively in March and April 2013. If the outcome is positive, the Code of Conduct would be amended accordingly and would be put to Council for adoption in November 2013, with the aim of bringing CPE into force in or by January 2015.

Council approved this work, and the time-table.

The Terms of Reference of the committee had been revised in conjunction with the By-Laws Committee.

Studentship: revised Rules governing Students were presented to Council, in particular stipulating

that the studentship subscription fee for the first application would be 50 % of the then current *epi* annual membership fee, and that students are entitled to a 50 % reduction for *epi* training events.

Council approved the revised Rules.

EPO Candidate Support Project (CSP): Council agreed to *epi*'s continuing support for CSP, which has the specific aim of ensuring that EQE candidates in countries where the number of EQE representatives is less than 5 attain an adequate level of knowledge such that they can pass the pre-exam and then the EQE.

Director of Education: following the resignation of the DOE, PEC considers that no replacement is required in the immediate future. Council supported this position.

5. LitCom: Mr Axel Casalonga gave a comprehensive update on the current position.

He referred to the seat of the Central Division of the UPC (Paris) and its two sections (London and Munich).

Articles 6 – 8 of the Agreement on the UP. Council approved the *epi* position that the Articles (which relate to infringement and exceptions to infringement) should be deleted.

Article 28 of the UP Agreement: The Committee considers that the current wording (relating to representation) is too broad, and proposes that it should be tied to Art. 134(1) EPC and Art. 134 (3) (a)-(c), Rule 366 EPC remaining to interpret the title "patent attorney".

Council approved the proposal.

Next steps relating to the UPA and UPC: New draft Rules of procedure are expected from the EU Commission. LitCom will monitor the position. In addition, LitCom will produce with input from CEIPI a paper on Certificate Qualification for Council to consider.

Council approved the LitCom report.

6. Disciplinary Committee: Mr Fröhling reported, following which there was an extended discussion on whether the EPO should publish all decisions of the Disciplinary Board and Disciplinary Board of Appeal with the name of the representative the subject of a disciplinary action, and in addition whether any person with a legitimate interest in a disciplinary case should be informed as to the status of the representative

Council referred the matter back to the Committee for further study.

7. Internal Auditors report: Council was advised that the accounts for 2011 were being finalised with the assistance of external auditors so the Board could be discharged. Council approved this work, and then approved a proposal from the Treasurer that part of *epi* funds could be invested in funds other than the Euro.
8. President's report: Tony Tangena referred to a previously-circulated list of meetings he had attended since the last Council meeting, expanding on this in his interventions and contributions during discussion of relevant Agenda items.
9. Secretary General's report: João Pereira da Cruz referred to the appointment of the *epi* Legal Advisor as of 1st October, 2012 (see above).

In addition he advised Council of the implementation of a new automatic invoicing system, with commensurate updating of the *epi* IT system. This latter was work in progress.

He also mentioned the project to establish a new website (see report below).

As of 26th October, 2012 there were 10.656 *epi* members on the List of Professional Representatives before the EPO.

10. Treasurer's report: Claude Quintelier reported that he was discussing with the Finances Committee procedures for upgrading financial information provided to the Board, and Committee Chairmen. Council approved this work.

He also introduced the Budget for 2013, which Council approved.

11. Electoral Committee: Mr Markus Müller reported on the work the Committee had been doing in conjunction with the By-Laws Committee to amend the "Rules for Election to Council", the Terms of Reference of his Committee also being revised as a result. The election Rules' amendment were basically to cater for those countries where there was a change from a split to a unitary constituency, self-nomination, extending the grace period for nominations, to provide for an initial resolution phase in the event of an objection, to define the Secretariat's involvement in the elections more clearly, and to allow submissions by fax and email in exceptional circumstances. The draft Rules and Terms of Reference had previously been circulated. After discussion, Council approved them for adoption.

Mr Müller also reported that his Committee was discussing with the Online Communications Committee (qv) the introduction of electronic voting, including the ability to hold an e-vote in a member state to change a constituency from split to unitary, and vice versa.

Council approved the continuation of this work.

12. By-Laws Committee: Dieter Speiser confirmed the action taken in conjunction with the Electoral Committee.

He also reported to Council that his Committee had revised Art. 4.3(a) and Art. 5.2 of the By-Laws respectively to cater for the election of a subsequent

substitute member of Council when an existing substitute ceases to hold office (Art. 4.3 (a)), and to avoid the loss of Council members caused by a change of constituency or a change of electorate by removing these causes from Art. 5.2.

Following discussion, Council approved the revised Articles.

Dieter Speiser announced to Council that he would be retiring as Chairman and from the Committee as of the next Council meeting and that his successor would be Jasmin Jantschy, who would take over as Chairman as of the current meeting.

The President then gave a warm encomium to Dieter Speiser in recognition of his services to *epi* as a Council member, Past President, and as Chair of the By-Laws committee, and presented him with a gift on behalf of Council, which confirmed the encomium with acclamation.

13. New Website: A presentation was given to Council by Mr Jan Imhoff on behalf of Agentur 22, the company engaged to provide the new website. He gave a demonstration of the currently 'live' part (95 % of the final version) which it was hoped would be launched in Q1 2013, the project having started from scratch in November 2011. There was a lively discussion, after which Council thanked Mr Imhoff for the presentation and approved the work done to date and the continuance of the project.

14. Online Communications Committee: Mr Antero Virkkala reported that the main work of his Committee was the evaluation of e-voting software in conjunction with the Secretary General and the Electoral Committee. As a result, "OAdeo" software of a Belgian Company, BlueKrypt, seemed to be the most suitable for *epi*'s needs.

Council approved the continuance of the evaluation work.

15. EPO Finances Committee: Mr Jim Boff reported. The latest figures show that direct EPO filings appear to be steady, Regional Phase entry from the International phase is now about 50 % of PCTs, compared with 55 %-60 % previously.

Interestingly, 3rd party observations were up by 50 %.

16. Harmonisation Committee: Francis Leyder reported that Vice-president Gabriele Leissler-Gerstl and he had attended the 42nd CPL meeting just before which the EPO released a report focusing on 4 topics, (1) grace period; (2) 18-month publication; (3) prior art effect of secret prior art (or treatment of conflicting applications); and (4) prior user rights.

The EPO is preparing a questionnaire for user consultation. The Committee will prepare *epi*'s comments.

In relation to the grace period, John Brown gave a brief presentation on the topic and how *epi*'s position, currently against such a concept, might be developed, there being various pressures for change, such as international and European pressures, pressure from some *epi* members for change, pressure

from clients of EPAs, and the need not to be left out of discussions.

Council approved the continuing work of the Committee in relation to the EPO report and the preparation of a response to the questionnaire.

17. Biotech Committee: Ann de Clercq reported. The EPO had introduced a new examination practice for human embryonic stem cell applications following C-34/10 (CJEU 2011 decision on stem cells). The Committee proposes to send a position paper on the topic to the EPO requesting the implementation of C-34/10 in a sensible manner.

The EPO is developing new procedures for dealing with sequence listings. *epi* has commented, but there will be further developments, for example a Bio-Sequence Search Sequence which will be delivered to examiners for testing in December 2012.

There is still concern in the committee about the frequency with which disunity objections are raised in bio-tech cases. The Committee will continue to

urge the EPO to be more sensible when considering raising a disunity objection, which can also lead to subsequent dependant claims not being searched.

The Committee is also still of the view that the EPO should continue with the current deposit systems with expert solution, with consequent maintenance of the current list of independent experts.

With regard to the 'wrinkly tomato' case, the Committee proposes to prepare an amicus curiae brief, in conjunction with the EPPC for submission to the EPO by the reply date the end of November, 2012.

Council approved the report and the actions proposed in it.

18. AOB: The President remarked that he will look at changing the format of Council meetings to say 1.5 days in order to provide on occasion sufficient time to get through a lengthy Agenda.

He closed the meeting at 5.50 pm. The next Council meeting (the 74th) is scheduled to take place in Vienna, on 19th/ 20th April, 2013.

Report of the European Practice Committee (EPPC)

F. Leyder (BE)
Chair

This report completed on 07.11.2012 covers the period since my previous report dated 14.08.2012.

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.

UNITARY PATENT

1. European patent with unitary effect in the participating Member States

The JURI Committee of the European Parliament met on 10th and 11th October.2012. It does not seem to accept the Council's suggestion to delete Arts 6-8 from the Regulation on the unitary patent, because it would constitute a breach of European law. It expects the

Council to come up with a new proposal in accordance with European law. Nonetheless, the Committee appears to be willing to further negotiate with the Council in order to find a solution.

The EPPC will continue to monitor the developments, with the assistance of the Legal Advisor whose contribution is valuable and valued.

PCT

2. 50th Series of Meetings of the Assemblies of Member States of WIPO

The meetings were held in Geneva from 1st to 9th October 2012. *epi* is traditionally not attending these meetings as observer. The 43rd session of the PCT Assembly was held as part of these meetings. The documents from the PCT Assembly (including the draft report) are available from the WIPO website at:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=26257

In particular, the PCT Assembly adopted amendments of Rules 4.15, 51bis.1, 51bis.2, 53.8 and 90bis.5 to take into account the America Invents Act (to apply to any international application whose international filing date

is on or after 1st January 2013). It also appointed the National Institute of Industrial Property of Chile as an International Searching and Preliminary Examining Authority under the PCT, effective from a future date to be notified.

EPC

3. 42nd CPL meeting (09.10.2012)

The EPO presented a report on 'National provisions and procedures relating to the payment of renewal fees in case of a successful petition for review'. The relevant information will ultimately be included in the booklet 'National Law and the EPC'. Many Patent Offices seem to have increased interest in this matter now that they have received the first requests.

The Committee discussed a paper on 'Re-establishment of rights' prepared by the Danish delegation, which announced its intention to prepare a revised document on the basis of information provided by other delegations, either during or after the meeting.

The Committee discussed an amendment of Articles 9 and 11 of the Rules relating to Fees proposed by the EPO to take into account decision J 25/10 on the partial

refund of the examination fee. It could not give a positive opinion.

Finally, the EPO announced its intention to issue the Official Journal in electronic form only as from January 2014.

4. 7th SACEPO/WPR meeting (16.10.2012)

The EPO announced that it concluded the evaluation of the "Raising the Bar" amendments. It is now open to discussing a possible amendment of Rule 36(1) EPC.

A possible amendment of Rule 164 EPC was discussed. Whereas the proposed paragraph 1 was agreeable to all participants, it was generally felt that the proposed paragraph 2 could be improved.

MISCELLANEOUS

The EPPC met on 6th November 2012, with Mr. Quan-Ling Sim, Head, PCT Outreach and User Relations Section, WIPO, as guest speaker for a presentation and lively discussion on the Future of the Patent Cooperation Treaty (PCT). The EPPC is thankful to WIPO for providing such opportunities, and to its guest for his contribution to the meeting.

Report of the Professional Qualification Committee (PQC)

P. Rambelli (IT)
Chair

1. Last PQC Meeting

The last PQC meeting was held in Milan on 13 September 2012, attended by 32 full and substitute members, one associate member and by the *epi* President Mr Tony Tangena and *epi* Vice-president Ms Mihaela Teodorescu.

The PQC members attending the meeting were also invited to attend the Guidelines 2DAY Seminar held in Milan the day before the PQC meeting.

2. Director of Education

Following the termination of the consulting agreement and resignation of the Director of Education in charge, being effective at the end of August 2012, at the meeting in Milan, PQC decided to propose to the *epi* Board that for an *interim* period, until the next PQC meeting to be held in February 2013, all organisation matters relating to education events and training programmes should be entrusted to the *epi* Secretariat, under functional

supervision of the PQC Chair in cooperation with the PQC secretary and chairs of the Working Groups.

The proposal was approved by the Board at the Board meeting in Istanbul.

3. PQC Terms of Reference (ToR)

At the meeting in Milan, PQC approved a draft amendment of the Terms of Reference which, following revision by the By-Laws committee, is being submitted to the Council.

The amendments aim at:

- better reflecting the tasks of PQC (to be newly named Professional Education Committee) as the *epi* body responsible for the education;
- harmonising the ToR with the By-Laws and the amended REE or IPREE;
- introducing activities presently carried out by PQC and not explicitly contemplated in the present ToR such as:
 - education/training responsibility for grandfathers, *epi* students and paralegals;

- education/training for tutors and mentors;
- organisation of tutorials and Mock EQEs;
- organisation relating to CPE.

4. Working Group activity: CPE Working Group

The CPE Working Group, in the meeting of 9 October 2012 and in the previous meeting of 4 July 2012, set up a detailed program for training events for 2013.

Seminars will be offered at three levels, namely:

- basic: e.g. pre-drafting, drafting, prosecution, opposition
- advanced: e.g. oral proceedings, appeal
- specialised: e.g. licensing, evaluation of patents.

The Working Group is striving to establish a system making good quality and relevant education accessible to all *epi* members and a system that allows every *epi* member to fulfil the educational requirements in case CPE would become mandatory. This goal is to be achieved both by “live seminars” which are to be distributed more evenly among the members states and through webinars which should become a relevant structural part of *epi*’s educational events. The plan relating to webinars contemplates cooperation with the EP Academy, that has already experience with webinars and the use the EPO webinar studio for webinars organised together with the EP Academy.

In 2011 educational events organised by *epi*, alone or in cooperation with the EP Academy, were attended by 1023 participants; the same figure is expected for 2012. The aim is to progressively increase the offer of educational events particularly through the offer of webinars, to increase the number of participants to about 3000 in 2015.

At present, the major part of the live seminar relates to the Guidelines2DAY Seminars which, since the kick off seminar in Munich in June 2012, have been successfully held in Milan, Copenhagen, Vienna and London in the period September-October 2012. The evaluation of the seminars by the participants has been highly positive. Within the end of the year further seminars will be held in Madrid, Eindhoven, Helsinki and Istanbul.

Since 2010, CPE Seminars were developed and offered also for administrative staff and paralegals. In October 2012 seminars for paralegals were offered in Munich on the new topic “Handbook of Quality Procedures before the EPO” and in Warsaw on “PCT”.

5. Working Group activity: epi tutorials

Following the PQC in Milan, the traditional Working Group named *epi* tutorials has been entrusted with all educational matters directed to the formation of *epi* tutors and to the training of the candidates through *epi* tutors.

Within the frame of this activity, the first *epi* tutors’ meeting was held in Berlin on 18 September 2012; the aim of such a meeting was to establish a tutors’ network

and improvement and harmonisation of tutoring capabilities.

In the beginning of October 2012 35 EQE candidates enrolled with the traditional *epi* tutorial programme.

The Mock EQE pre-exam and main exam was held in Helsinki on 15-17 October; the feedback session will be held on 14-16 November 2012.

6. Working Group activity: mandatory CPE

At the meeting in Milan, PQC approved a proposal for mandatory CPE worked out by the ad hoc PQC Working Group.

Such a proposal, including a draft regulation and draft guidelines, was presented to the *epi* Board at the Board Meeting in Istanbul and will be submitted to the *epi* Council in Hamburg for the purposes of discussion.

A first proposal for mandatory CPE had been approved by PQC with unanimous vote in 2010, but such a proposal was not approved by the *epi* Council in Düsseldorf 2010 with 61 votes against, 41 in favour and 4 abstentions.

Since then, the situation changed. The EU Commission more strongly looks into mandatory CPE to achieve a high quality of service from various free professions, and recently, the Commission has asked an expert to prepare a study on CPE in Europe for patent attorneys.

Accordingly, it appears advisable for *epi* to set up its own workable system for CPE. The draft regulation and guidelines are designed to set up a system for CPE which will allow the *epi* members to satisfy the requirements within the frame of their usual professional activity which in any case contemplates activities suitable to maintain up-to-dated the EPC knowledge of a professional representative, adequate to provide a professional standard of service and without making compulsory the attendance of seminars to meet the minimum requirements.

Details on the draft regulation and guidelines are available on the *epi* Extranet open to all *epi* members.

7. Candidates Support Project

As previously reported the EPO set up the EQE Candidate Support Project (CSP) with the specific aim of ensuring that EQE candidates from 19 selected countries (those where the number of EQE qualified representatives is less than 5) attain an adequate level of knowledge such that they can successfully pass the pre-examination and thereafter the EQE.

16 candidates have been selected and enrolled in the programme. The training programme is carried out by the EPO in cooperation with CEIPI and the *epi*.

The *epi* is contributing to the programme, by means of 4 selected coaches whose task is to monitor the progress of the candidates through the training programme and provide recommendation and guidance to the candidates as to their preparation.

Report of the Harmonization Committee

F. Leyder (BE)
Secretary

This report completed on 7th November 2012 covers the period since my previous report dated 14th August 2012.

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

1. Meeting of the Harmonization Committee

The committee met on 7th September 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. It concluded that it could continue to support the position paper adopted in May 2006 (Decision 17 of the Council in Salzburg).

2. 50th Series of Meetings of the Assemblies of Member States of WIPO

The meetings were held in Geneva from 1st to 9th October 2012. *epi* is traditionally not attending these meetings as observer. The sole relevant agenda item is a report from SCP.

The working documents and a Draft General Report can be found on the WIPO website:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=25010.

3. 42nd CPL meeting (9th October 2012)

Four days before the meeting, the EPO released a 144-page report (CA/PL 12/12) of the fact finding exercise carried out by the "Tegernsee Experts' Group" (a group of experts appointed by IP5, DE, FR, GB and DK), focusing on 4 topics: (1) Grace period; (2) 18-month

publication; (3) Prior art effect of secret prior art (or treatment of conflicting applications); (4) Prior user rights.

Users consultations have been announced, at national and European level¹. An Expert Group is preparing a questionnaire useable as a framework for user consultation.

This committee will prepare the *epi* comments, hopefully with assistance from the EPPC. Feedback from the national users' consultations will be welcomed by this committee.

4. Standing Committee on the Law of Patents at WIPO (SCP)

The 19th Session, initially planned for the week of 26th to 30th November 2012, has been postponed, most likely to the week of 25th February to 1st March 2013.

5. Extraordinary session of the WIPO General Assembly

An extraordinary session of the WIPO General Assembly will be held on 17th and 18th December 2012, with only one substantive agenda item: "Evaluation of the text on limitations and exceptions for visually impaired persons/ persons with print disabilities and decision on whether to convene a diplomatic conference in 2013".

The documents will be available on the WIPO website:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=27963

¹ During the SACEPO/WPR meeting on 16 October 2012, the EPO announced that the documents will be posted on the public version of MICADO (called Micado Public); there will be SPLH user days early next year (rather March than February), and an on-line consultation.

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Report of the Litigation Committee (LitCom)

A. Casalonga (FR)
Chair

Information on the draft of Unitary Patent Court (UPC)

The EU Council met on 28 and 29 June, 2012. During this meeting the concerned EU Member States agreed on the site of the Central Division of the First instance Court: the Central Division, together with the Office of the President of the Court Instance will be located in Paris.

Nevertheless taking into account the technical nature of the cases which will be submitted to the Central Division, it was decided to create thematic clusters in two sections of the Central Division.

One section will be located in London for patents in International Patent Classification (IPC): A (Chemistry, Pharmaceuticals) and C (Human necessities).

Another section will be located in Munich for patents in International Patent Classification: F (Mechanical engineering).

The Member States also decided that the Central Division could be chosen for infringement action where the defendant is located outside the European Union and in the case revocation action is already pending before the Central Division. In the same way if a revocation action is already pending before the Central Division, it will be possible to bring an infringement action concerning the same patent before the Central Division.

On the other hand, if the defendant is domiciled within the European Union, an infringement action must be filed before a local Division or a Regional Division.

Finally, the Member States suggested to delete from the Unitary Patent Regulation, Articles 6 to 8 relating to the definition of infringement acts, so that the definition of infringement acts would only be provided in the Agreement relating the Unitary Patent Court.

This last point remains controversial and a compromise will have to be found before the draft agreement can be finally accepted.

Representation before the future UPC

Article 28 of the present draft of the agreement provides for representation of the parties by lawyers admitted to represent before a National court or by European patent attorneys having a specific qualification.

It was also provided in Article 28 of the draft published in November 2011 that the representatives, defined as mentioned above, could be assisted by "a patent attorney" who will be allowed to speak at hearings of the Court.

Since the definition of "patent attorney" is not absolutely clear and does not correspond to the definition of "European patent attorney", it was suggested to amend the wording of Article 28.

An amended draft published in September 2012 proposed to allow the assistance of the representatives by "any person, such as a patent attorney".

This amendment of Article 28 was considered by the Litigation Committee as inappropriate since it would permit assistance of the representatives by persons not having any knowledge of European patent law.

A position paper was therefore prepared by the Litigation Committee after consultation of the Board. In this position paper, which was sent to the EU Commission, it is suggested to adopt the following wording for Article 28 (3a):

(3a) Representatives of the parties may be assisted by persons meeting the requirements indicated in Articles 134(1) or 134(3) a) to c) of the European Patent Convention who shall be allowed to speak at hearings of the Court in accordance with the Rules of Procedure.

In the meantime, a new draft agreement was published in October 2012. Article 28 of this new draft was again amended to revert to the previous wording of November 11 limiting the possibility of assistance to "patent attorneys".

At the present time therefore, assisting persons will only be patent attorneys defined according to a specific rule (Rule 366), of the draft of Rules of Procedure. According to Rule 366, such "patent attorneys" can be European patent attorneys authorised to act before the EPO (with or without the specific qualification required for representing parties before the UPC) and National patent attorneys authorised to act before a National Patent Office of a contracting Member State.

Study on past damages before translation

The Litigation Committee is presently studying the position taken by National Courts in the various EPC Member States concerning the determination of past damages resulting from the infringement of a European patent granted in a language which is not a National language of the relevant country.

The question relates mainly to situations resulting from the entry into force of the London Protocol which necessitates the filing of a translation of the patent during the Court procedure. The study should permit to arrive at a picture of the present situation in the various EPC countries showing whether or not the Courts take into account the date of filing of the required translation of the patent for the determination of past damages.

A questionnaire has been sent to all members of the Litigation Committee and the result of the answers will permit the Litigation Committee to establish a report on this question.

Tutors' Report on the EQE 2012 Papers

P. Pollard (NL), H. Marsman (NL), D. Jackson (GB),
S. Roberts (GB), R. van Woudenberg (NL)

Every year in September, the European Patent Academy and the *epi* arrange a meeting between EQE tutors and the Examination Committees. The goal is discuss the papers sat in March, to influence future EQE's by openly exchanging ideas and to help tutors prepare candidates for next year's exam.

This year's meeting was in Berlin on September 19-20, and was attended by 70 tutors from Austria, Belgium, Bulgaria, Czech Republic, Denmark, Finland, France, Germany, Italy, Lichtenstein, Malta, The Netherlands, Poland, Spain, Sweden, Switzerland, Slovenia and United Kingdom.

The Examination Board has kindly given the tutors permission to publish their own report of the important points so that candidates can more easily find this information. In addition, the comments can greatly assist when reading and interpreting the official EQE Compendium.

So, for the first time, we are publishing a Tutors' Report to complement the official Examiners' Report. We intend to do this every year, and to make our report available on the *epi* website and in the *epi Information* journal.

This report contains the following sections:

1. General comments on the EQE
2. Main-Exam 2013
3. Pre-Exam (2012)
4. A/B CH (2012)
5. A/B EM (2012)
6. C (2012)
7. D (2012)

EB refers to the Examination Board, EC to an Examination Committee and TS to tutors.

On behalf of the tutors present in Berlin, I would like to thank all the members of the Examination Board and the Examination Committees for being brave and taking the time to engage with us.

My thanks to all the tutors who asked questions and contributed to the discussions. My special thanks to Harrie Marsman (A/B CH), Derek Jackson (A/B EM), Simon Roberts (C) and Roel van Woudenberg (Pre-Exam) for preparing the individual paper summaries.

Good luck in 2013,

Pete Pollard (Editor)

1. General comments on the EQE

Milena Lonati (Chairman EB) explained the quality improvements introduced this year in the EQE procedures:

- A translation team now looks at the version of the paper that the candidate will see to check the language used carefully.
- This year's exam was one of the smoothest ever – there were few complaints by candidates about the papers, and no calls to invigilators were required to provide extra instructions during the exam about errors or unclear parts.

2. Main-Exam 2013

Ian Harris (Pre-Exam EC) talked about the papers in 2013:

- EB has already issued a notice with some comments: [http://documents.epo.org/projects/babylon/eponot.nsf/0/6F4B1D2A6D291606C1257A2C003DCC84/\\$File/NOTICE%20REGARDING%20THE%20EQE%20EXAMINATION%202013%20-%20CPM.pdf](http://documents.epo.org/projects/babylon/eponot.nsf/0/6F4B1D2A6D291606C1257A2C003DCC84/$File/NOTICE%20REGARDING%20THE%20EQE%20EXAMINATION%202013%20-%20CPM.pdf)
- There is an advantage to shorter exams – candidates should be less tired
- Intention of new format is not to challenge candidates on time – the shortened time is being evaluated using guinea-pigs.
- There will be no mock exams produced in the new format. EC's consider the differences actually quite small between 2013 and previous years.
- Paper B:
 - more emphasis will be placed on argumentation
 - extra claims can be thought of as US-style claims from your US client which you have to adapt to European practice
- Paper C:
 - probably no [or very few] legal questions
 - Complexity will be reduced – less claims, less attacks, less prior art
- Paper D:
 - back to old style from the 1990's – some DI questions and 1-2 DII questions
 - An exact 40:60 point split DI:DII cannot be guaranteed
 - Basically a reduced-down version of the current papers
 - Candidates should skim through paper to decide what they want to do
 - Marks will be indicated for each DI question
 - DI questions will be independent

Comments on the 2013 papers by the EC's can be found in the individual paper summaries below

3. Pre-Exam (2012) – by Roel van Woudenberg

Ian Harris [Pre-Exam EC] gave feedback on the very first Pre-Exam

- No detailed statistics will be provided about split between legal and claim analysis questions or per question.
- Pass rate was high. EB was surprised by this – they expected it to be worse. Possible explanations:
 - as it was the first Pre-Exam, many postponed until 2013: 400 candidates in 2012, and about 700 for 2013.
 - those who did it in 2012 were very well prepared
- No targeted pass rate. It is intended to test basic aspects of being a patent attorney, and basic principles needed for Main Exam.
- EC considers the Pre-Exam 2012 to be at the right level. The next pre-exam is not planned to be more difficult.
- Any increase in Main Exam pass rate due to Pre-Exam will be visible in a few years. So level, type of questions and general format of Pre-Exam will be kept the same for the coming years. But they expect some swings in pass rate.
- TS: There is a real danger that candidates, who scored highly in Pre-Exam, do too little for the Main Exam. EC: Candidates need to realize that there is a world of difference between Main Exam and Pre-Exam
- Pre-Exam format will remain 10 legal + 10 claims analysis questions of 4 statements each for the foreseeable future. 0/0/1/3/5 marking scheme will be maintained.
- They are looking at drafting the paper with fewer words to make it shorter.
- EC: multiple choice is a difficult balancing act – some answer may not be fully black-and-white (e.g. intermediate generalisations), but “we ask people not to be too clever”.
- No answers for which both T and F was accepted. In fact, majority of candidates agreed with EC
- Q.19 & 20 – choose arguments corresponding to wording of claims. This is a problem frequently seen in Main Exam

4. A/B CH (2012) – by Harrie Marsman

EC representatives: Martin Hatzmann, Cécile Kirsch, Jeremy Mauger

a) Papers in 2013

Chairman Hatzmann started the meeting by providing information on how paper B would look like in the coming years. He explained how the contents of papers A and B have developed over the years, whereby both papers came closer and closer to one another. Paper A has a strong emphasis on novelty and inventive step and requires drafting of claims and a description. This will not change in the near future.

Also for paper B, the candidates have to draft claims and present arguments to defend these claims. The argumentation part will get more emphasis as of 2013. Where candidates could pass paper B by drafting a good set of claims and providing some arguments, this practice will end. The focus will be more on the arguments.

Because of this consideration and because the duration of paper B will be an hour shorter, candidates will get (i) an application, (ii) prior art, (iii) objections by an Examiner, (iv) a letter from the client, and (v) a set of claims. Said set of claims is to be used as a starting point; the claims are (at least) a pointer.

The claims will not necessarily be all correct; likely there will be deficiencies in the set of claims. The candidates are expected to bring the claims in accordance with European patent practice, and they have to explain in a letter to the Examiner what they did, why they did this, and what support they used.

The claims have to meet the requirements of Art. 123(2), Art. 84, Art. 52-56, Art. 82 and R. 43(2) EPC.

The Committee expects that, because the focus will be more on argumentation, candidates may need more preparation to pass.

Tutors and candidates are advised to read everything that the EQE Committees publish and referred the tutors to the notice of the EQE Committees on the EQE pages of the EPO website. In addition, we were pointed to Rule 24 of the IPREE.

There will not be mock examinations for the new style paper B, but the Committee guaranteed that the B papers of the last years could well be used in the preparation, because these already contained a letter of the client and pointers to desired claims.

b) Paper B of 2012

As a general remark, Chairman Hatzmann noted that the filing of notes to the corrector should be discouraged. Only very seldom, will notes lead to a mark.

The Examiner's Reports for papers A and B Chemistry are based on the marking sheets used by the correctors.

The Chairman gave the floor to Mr. Mauger, who was involved with paper B. Paper B of 2012 had a pass rate of 53 %.

This year, Paper B dealt with process technology, and aimed to have an independent process claim and an apparatus claim.

Like the last years, the prior art provided came quite close to the original claims of the patent application.

The key to the solution was to add certain acids to reactants before these contacted the catalyst in the process and to have a conduit for re-using the acid in the apparatus.

It was stressed to use the wording present in the application to adapt the claims. “Quite creative candidates” ran into problems with Art. 123(2) EPC.

In this paper B a letter of the US client was present and candidates were expected to deduce from this letter whether the documents cited would form prior art under the EPC. In addition, said letter hinted to the required adaption in the apparatus by pointing out the desire to re-use acid.

In the discussion, it was emphasized that a candidate should explain in the letter to the EPO what he did and why. This was illustrated by the example as to why or why not the prior art conduit used to transport gas

would be suitable for transporting acid. Good arguments would give a candidate marks even if he did something unexpected.

Mr. Mauger indicated that the Committee made use of "guinea pigs" of all kinds of technical backgrounds in the "chemical" field.

c) Paper A of 2012

Ms. Kirsch was leading the discussion of paper A. Paper A had a pass rate of 56 %.

Like the last years', this paper dealing with sunscreen compositions encompassed 2 prior art documents of which D1 relates to similar compounds as those used in the client's letter, but used in an entirely different field; and of which D2 related to similar compounds used in a similar/same field. D1 was only relevant for novelty; D2 should be used as the closest prior art for inventive step. In the client's letter essentially two technical effects were addressed: photo stability and oil-solubility.

A compound claim was expected wherein the whole overlap with the compounds described in D1 needed to be removed. Many candidates merely excluded the single compound exemplified in D1, but this was insufficient because of the general teaching in D1. Also for D2, it was required to remove the entire overlap.

The unclear term "higher alkyl" needed to be clarified by introduction of a lower limit of "at least 6 carbon atoms". An upper limit was not expected, although in real life the EPO often requires this.

In addition, a "compound for use" claim was expected. Since the compounds have not only a cosmetic effect, but also a "medical" effect, the use required a wording based on Art. 53 (c) EPC. Candidates who did not use this Art. 53 (c) wording lost only 2 marks (many candidates did not use the correct wording). As a reason for this generosity, the Committee felt that this issue was quite field specific.

The compound definition in this compound for use claim could be and should have been broader than the compound definition in the compound claim. Variations on this theme occur in many A papers.

Further, an independent composition claim was expected, wherein one should not use the term "further additives" because that would give novelty problems in view of D1 wherein compounds together with a specific stabilizer were disclosed.

Finally, a process claim was expected. Many candidates put in too many limitations. Because the instructions for paper A require you to obtain "the broadest possible scope of protection" each unnecessary limitation leads to the deduction of 2 marks.

Ms Kirsch also focused on the writing of a description. This can bring a candidate 10-15 points, which are rather easily obtained. The intention of the description is not only to provide a basis for inventive step, but also to give the option to more or less clarifying the claims.

Like last years', the Committee observed that the description should look like a real description and not be in the form of a letter. Moreover, some candidates

also included a letter to the client. This costs time but does not bring any marks.

A last remark was that in the Examiner's report is written that D2 would state that the compounds would be water soluble. This is not the case.

5. AB E/M (2012) – by Derek Jackson

Paper A

We were treated to a presentation which started by explaining the three embodiments and then the prior art and its associated drawbacks.

a) Common features of embodiments

The Examiners then drew up a list of features common to all embodiments, these being:

- Body
- Weight
- Attachment means for attaching the weight to the body
- The weight being displaced with temperature variation
- The displacement being "reversible" (novel over D2)
- Different positions of the weight corresponds to different orientations of the body in the liquid (novel over D1)

Candidates should bear in mind the use of a list of common features, while potentially useful, is not a certain way of formulating a list of the essential features of the independent claim – there is a significant risk of including unnecessary limitations.

b) Independent claim

These common features were then quickly re-drafted to produce a claim considered to be suitable, the main requirement being a consideration of clarity. Other points to note are:

- The ideal claim does not use the term "reversible". "Reversible" can be used, but care is needed to distinguish from D2
- There are other ways of phrasing the claim – for example the term "centre of gravity" could be used provided the overall concept includes the common features.
- The major aspect for discussion concerned the arrangement of features in the preamble and characterising clause.

The Examiners advised there was room for flexibility in this matter, but in any event this aspect is only worth 2 or 3 points and in practice no acceptable candidate is likely to fail Paper A because of the distribution of features between the preamble and characterising clause.

The challenges of the independent claim were summarised as follows:

- Avoiding unnecessary limitations
- Covering all the embodiments
- Novelty over D1/D2
- Clarity (important for 2012)

c) *Dependent claims*

Dependent claims are required to establish potential fallbacks in the event the independent claim has to be restricted in scope.

Only 15 claims will be marked – any additional claims will be ignored.

The structure of dependent claims is important – try grouping claims by topic and this could permit better overall cover with a minimum number of claims.

Avoid unnecessary limitations.

d) *Description*

Acknowledgement of at least the closest prior art is expected. This should be followed by an explanation of the problem associated with the closest prior art and relevant to claim 1. Finally a discussion of the solution is required, for example how the means of claim 1 solves the problem associated with the prior art (i.e., how reversibility is achieved in response to changing temperature). This has the effect of helping the reader to understand the invention.

Paper B

The presentation for Paper B E/M was very straightforward and began with a review of the embodiments and the prior art, together with claim 1 as filed.

It is always important to read the client's letter to find out what the client wants. This then needs to be balanced with the communication from the EPO examiner.

The examiners were expecting a combination of claims 1 and 6 together with a generalisation to take out the "full length" feature and to specify that the zeolite is arranged only at the side. It is important to find a basis in the application-as-filed and to justify the amendments (see para [013]). Claim 6 is dependent on claim 5 which in turn is dependent on claim 4. Simply omitting the subject-matter of claims 4 and 5 lost a number of marks, but some of these could be recovered if arguments were submitted to the effect that the limitations were not essential.

Problem/solution aspects included the advantage of no zeolite at the bottom, the length of the barrel and the absence of a heating effect. Essentially all candidates do now use problem-solution, but the arguments are not always well presented.

Overall, the examiners thought the answer for 2012 were quite good.

6. C (2012) – by Simon Roberts

a) *General*

The EC disclosed that the main focus of the 2012 Paper C was "claims directed to specific purposes". This was an opportunity for candidates to demonstrate their ability to handle the problem and solution approach and to select the appropriate closest prior art (CPA). The EC found that many candidates had problems interpreting "for" in the

sense of "suitable for". As such, it seems likely that this same issue will re-appear in coming paper Cs.

The simplified letter from the client – which simply asked for an opposition to be filed, but which indicated no legal issues, should have meant that the question was rather straightforward. Nevertheless, the EC reported having seen a great many incorrect attacks, including Art. 83, Art. 123(2), and Art. 53c.

The EC were particularly annoyed by what they termed "useless standard phrases" used for justifying the selection of the closest prior art and for reasons to combine documents. They identified:

- "most promising springboard" as unhelpful, and
- "these documents can be combined because the solution is provided ..."

b) *Claim 1*

The EC wanted to see novelty attacks based on A3 and A5. A2 was not useable in a novelty attack because it does not include a "textile layer" – "a textile is defined by the presence of fibres" – although they cited no basis for this proposition, it was presumably based on the definition in paragraph 005 of A1.

The EC stated, as they do every year, that alleged synonyms should be explained and that the features in the prior art that correspond to the features in the attacked claim should be mentioned and their correspondence explained.

c) *Claim 2*

An obviousness attack was expected based on A2 as the closest prior art. A2 was the CPA because it is for the same purpose as the subject-matter of claim 2. The range of 5-10 mg in the claim was broader than the range of 7-8 disclosed in A2, so there was no need to discuss issues of overlapping ranges or possible effects within the range.

The distinguishing feature of claim 2 relative to A2 was the presence of a fabric layer.

The EC felt that any attack on claim 2 should identify the two technical effects that come from the use of a fabric layer – mechanical strength and flexibility – although these are not expressly associated in A1 with the presence of a fabric layer. The EC insisted that any proper obviousness attack on claim 2 should identify these two technical effects (which are set out in paragraphs 0007 and 0009 of A6) and not just one of them. A6 was therefore the document to be used to complete the obviousness attack.

d) *Claim 3*

Here the EC felt that candidates should make two obviousness attacks on this claim because the adhesive layer (incorporated via the dependency on claim 1), which was the distinguishing feature over A4, was mentioned in para 0009 of A1 as being either internal or external – that is there were two embodiments. The EC said that surely any good candidate would have provided two attacks against claim 3 if it had clearly expressed the two embodiments as alternatives – so why should two attacks not be required with the claim in its

current form? The two attacks were A4 as CPA with either A5 (for the internal adhesive effect) or A6 (for the external adhesive effect). The EC confirmed that one could make an attack against the internal adhesive embodiment based on A4 + A6. Indeed there were several possible alternative attacks – each of which would have gathered equal marks.

The EC explained that they do not like to identify in the Examiners' comments all the potentially acceptable alternative attacks for fear of candidates believing that each of those attacks needs to be made for a complete answer. Also, if the Examiners' report is too long it will not all be read and will not be absorbed. By mentioning only the strongest attacks the hope is that candidates will learn to discriminate between strong and weak attacks. Candidates should focus on finding motivation for making combinations of the prior art annexes.

During the discussion of claim 3 the EC said that candidates should not rely on what happened in past exams – every new exam paper should be expected to throw up new issues. This in part being based on tutors arguing that historically in paper C one might have expected just one obviousness attack against claim 3 as actually written (rather than how it might be amended) would be sufficient to gather all the relevant marks. The EC replied that if there is only a single aspect to a claim, then one attack will generally be sufficient, whereas if there are multiple aspects (e.g. multiple embodiments) then multiple attacks may be required. The EC stressed that while they like to retain predictability; the exams are organic and need to develop from year to year. So the over-riding message is THINK FIRST – do not answer the exam by rote.

Discussion concluded with an examiner explaining that if there were only one attack, then only one of the two embodiments was being attacked – although the tutors' view was that the claim did not recite any embodiments and as such a single obviousness attack was all that was required to show that the subject-matter of the un-amended claim lacked inventive step. The EC explained that given the wording of para 0009 of A1 – which was evidently provided for a reason – why would a candidate make an arbitrary choice by making only one attack (because that is all that it took to invalidate the claim?) – when there are two clear attacks based on the alternative technical effects set out in paragraph 9. Here the key message seems to be that candidates should pay attention to the existence of alternative embodiments that are embraced by a claim but which are not exemplified within a claim – the assumption should be that one needs to find attacks to cover each of the alternative embodiments.

The EC said that they had never before seen so many candidates finishing the paper as this year – from which they deduced that time pressure was not really an issue for candidates this year.

Returning to the theme of candidates needing to learn that this is not an exam to be treated as a rote exercise – where a single standard attack format will work irrespective of the actual content of the paper, an examiner

observed that it is good for every exam to have a novel aspect.

e) Claim 4

Claim 4 was treated quite well – “surprisingly well” – the expected attack based on A3 as CPA (patch for treating wrinkles) with A4 was seen often.

f) Claim 5

Two novelty attacks were expected, one based on A3 and one based on A5. Candidates did less well with this claim – many ignoring the expected purpose (suitable for use as a deodorant) that needed to be addressed in the attacks. In A5 the cover layer is designed to stop the leakage of liquid perfume, so that perfume is expected to be in the fabric layer.

There was discussion of whether the perfume in A3 was an active ingredient “to be delivered to the skin”. The EC's view was that the perfume in A3 would escape and reach at least the skin of the arm which rests against the underarm patch. A contrary view held by some tutors was that it is not clear that the perfume of claim 5 is an active ingredient in the sense of claim 1 – the teaching of the last sentence of para 0005 of A1 potentially being broader than the scope of claim 1. The matter could have been resolved had claim 5 identified the perfume as being the active ingredient.

g) Claim 6

An obviousness attack based on A4 alone was expected. No novelty attack based on A4 was possible because there was no express teaching to combine the general teaching of para 0005 (which mentions gelatine as one of several possible polymeric gelling agents) with the specific example of para 0007. An explanation/argument was needed to justify the selection of A4 as the CPA.

h) Claim 7

This was well handled by most candidates, although many failed to provide any convincing argument as to why A6 was the CPA.

Concerning the questions that were submitted in advance of the meeting, the EC provided the following answers:

i) TS: How much legal basis needs to be provided?

EC: Provide legal basis for everything that needs legal justification. In the 2012 question paper, candidates did not need to explain why A53c did not apply! The candidates need to provide legal attacks and not legal defences!

Candidates do not need to identify or mention any requirements of the EPC that are met – unless there is a clear pointer in the client's letter that an issue exists. The streamlining of Paper C means that legal issues in the client's letter are going to be rare.

Candidates need to provide basis/ citation for the attacks that they make – that is, from where in the question paper do the facts come from that are used in the attacks? Candidates who fail to do this will lose all

the marks available for use of information, although they can still earn marks for their argumentation. When citing/providing basis, candidates MUST use paragraph numbers as these are common across the three language versions of the paper, whereas line and page numbers differ between the different languages.

The EC explained, justifiably, that it would be unfair to award the same marks to two candidates one of whom provided the basis and one who didn't.

j) *TS: In this year's paper the divergent claim structure meant that candidates could not continue to develop one problem and solution attack – instead one needed 5 separate ones – did that not introduce unfair time pressure?*

EC: Most of the candidates finished the paper this year – which is unusual. For example, claim 7 was well dealt with by virtually all candidates. Moreover, by having separate attacks one avoids the situation that candidates who make an early mistake are repeatedly punished for it. With this year's format each attack stands alone, so candidates start each attack afresh and are not harmed by mistakes made in attacking earlier claims. This seems fairer and is a better approach.

k) *TS: How do candidates know which claims are worth more in terms of marks?*

EC: When a complex attack is required it will be allocated more marks than a simple attack. It would not be sensible to indicate on the question paper the number of marks available for attacks against the different claims. Partly this is because the EC only know how many marks they are going to award for each claim once they have marked a good number of actual candidates' answers. Secondly, if the marks available were indicated it would help candidates identify the claims where there might be multiple attacks to be found – and hence make it harder for the better candidates to demonstrate their abilities.

7. D (2012) – by Pete Pollard

EC representatives: Harald Bronold, Eve-Marie Mayer Martin, Andreas Haderlein
Moderator: Jakob Kofoed

a) General comments

- TS: Very few problems in this paper. Feedback from our candidates confirmed this. A normal passing rate.
- TS: There are possibilities to correct the marking if a candidate appears to be "fit to practice", but actually has a low score after initial marking. How can candidates influence this?
- EC: If candidate gets marks just under 45, and marker had impression of really "fit to practice", they will look through paper again for 1 or 2 marks. After that, any other form of compensation is formally arranged by EB.
- TS: Please mention actual date of exam in the paper. This is important when you do the questions later as

you make the questions as if today was that date.

EC: agreed in principle to do this.

- EC: Many improvements implemented recently in the exam-paper generation process.
 - Examination Board & Committees are advised by professors and experts in examination.
 - Much more testing by language teams and "guinea-pigs" is helping to take ambiguities out of the paper, and to test complexity and timekeeping before the exam.
 - The latest *epi* recruits [who are recent EQE graduates] to EC's are usually asked to function as "guinea-pigs". In this way, the exam is tested by different technical fields and with different native languages.
- EC: Handwriting is difficult to read. EC suggests use of a fountain pen or other broad-bodied pen. There are no plans to use computers for the exam because of the organizational and security issues involved.
- EC: Main weakness of candidates is still advising the client how to use patents in real-life situations (DII) to help his business.
 - Typically candidates pass with 30-35 in DI, and only 10-20 in DII scored mainly on the analysis part.
 - This seems mainly due to a lack of experience – 3 years to sit the exam is too little for this. Some offices and even states do very little advice work, so there is little chance to practice in real-life.
 - Candidates should cover this during their preparation – either during their courses [e.g. role playing], during daily work, or by practicing a lot of DII's
 - No detailed comments on national injunctions and precise licensing terms are expected
- TS: Many candidates complain that the situations are artificial and far from practice.
- EC: They should realize that the *epi* provides more than half of EC members and half of the Examination Board. They bring in their practical experience to shape questions and answers – this is especially true for DII.
- EC: PCT is usually weaker than EPC, but this year the PCT parts (in DI and DII) were done well and in DI legal base citations were accurate. PCT will remain important for exam, because PCT is important for EPO, so it needs to be studied well.

TS: general feeling is that EPC/PCT balance is correct.
- EC: For DII, points are not indicated per question. This flexibility is needed by the EC to avoid a catastrophe, because answering DII is very difficult to predict.

d) DI – General

- TS: References in Examiners' Report are to specific OJEPO pages. Was such accuracy required?
- EC: No – not crucial if it is clear, so referring to first page of an OJEPO notice is usually sufficient. But candidates should give the most precise legal basis they can. Also more than one citation [GL or OJEPO or later OJEPO] will be accepted if it is the same contents. You can always cite more – no points lost for giving everything that fits. If other OJ-references are given

than expected, it is always checked whether this other reference is also adequate.

- TS: It is often difficult to know when to stop answering a DI question.
- EC: take question and facts, and don't speculate. All DI questions are drafted for a single answer, even those that appear more open. No points are lost for writing down too much, so if it might be relevant, write it down.
- TS: It would be candidate-friendly to start with an easy question.
- EC: questions are put in the sequence that they think is the best for candidates. But it is difficult to find a question that is easy for all candidates.

e) DI Q.1

- TS: was T1176/00 not required – this is decision that explicitly stated that time limit for appeal did not change?
- EC: accepted as an alternative for other T decisions. Other T decisions also demonstrate this principle in facts and calculations. For example, facts of T 116/90 are similar – also date of notification was not changed (this was not clear from reasons, needed to check facts of case).

f) DI Q.2

- TS: This was a complicated question. Was the transitional provision for R.36(1) not too old to be tested in 2012?
EC: Whenever the law changes, transitional provisions are important. They also wanted to wait until situation with regard to notices was stable. These transitional divisionals are now an important legal question in current practice.

g) DI Q.3

- TS: Will EPO actually perform SIS on unsearched invention?
- EC: Assumed that they would.

From discussion with tutors, it became clear that the answer was not to be found anywhere – it is at the discretion of the EPO. But this would not change the expected answer to the question as only references to the PCT provisions were expected. Not expected to discuss actual EPO practice. Not known whether EPO as SISA will actually search invention not covered by ISR of main ISA

h) DI Q.6

- TS: Why is "unitary" mentioned?
- EC: added during testing, because some "guinea-pigs" discussed whether there was unity. It was not relevant to the desired answer, so it was put into question to stop speculation.

i) DI Q.7

- TS: Was this not too difficult for candidates not working in such a field?
- EC: No evidence of this – it was done well. Anyway, all technical disciplines should know the G-decisions.

j) DI Q.8

- TS: Would anyone file an amendment that was new and inventive?
- EC: applicants who don't use a patent attorney do such weird things.

Some discussion about interpretation – there are two possible meanings leading to two possible answers. This is a problem for non-native speakers. Question can be read such that amendment appears to have been disclosed in application-as-filed – this would lead to completely wrong answer. EC asked tutors for suggestions how to change wording to make it better without using "added". Conclusion from tutors and EC was that this type of ambiguity is almost impossible to prevent, even with the current level of language checking.

k) DII – General

- TS: DII paper had two cases
- EC: we prefer this as it gives candidates more than one chance to find the goldmine of points. Even though the last question was worth 19 points, many got to the end and the second question was done well.
Many tutors had feedback from candidates that they also liked it – they knew exactly what to answer for the last question, and it helped some to pass.
- TS: Candidates would like to see the number of points when doing the paper. The last question had 19 points
- EC: hint is given by the amount of text that there are a lot of marks for last question. Not indicating marks is needed for marking flexibility on DII because it is not possible to predict what will be done well, and what will be done badly.
- TS: Some words in this DII were difficult for non-native speakers – encrustation, stagnate, aerate, interstices etc.
- EC: D is not a test of technical knowledge, so the words are unimportant – you can mentally replace all technical features given with a letter, and the newer DII papers will usually explain the words sufficiently, or the effect provided by the feature.

In this paper, "interstices" was a problem. The "guinea-pigs" are used to prevent such language problems, but this can never cover all words and all candidates. Non-native speakers should consider taking a dictionary to the exam to cope with such words, but they don't have the time to look everything up

- TS: Was legal basis required in the last DII question? G decisions, for example.
- EC: legal basis is not required for points. But citing it does help marking and makes it easier to read.
- TS: This DII paper continued the trend of longer papers, started in 2011 because more words are now added to explain the facts.
- EC: must balance between too many words [which take a long time to read] and too few words [which may be ambiguous and vague]. EC carefully monitors the length and there was little evidence that candidates could not get to the end – in fact, many did the last question well.
- TS: why were paragraph numbers given in DII?

- EC: They were added to harmonize the look of the papers, but they *should not* be used in your DII answer – there are no points for using them. On DII, candidates should use the words from the paper in the way that they have always done.
- TS: candidates could use the paragraph numbers in notes to be able to quickly find sources of information again.

l) DII – IPE interview

- TS: Many candidates confused by this because EPO will not do this. Interview is limited to a telephone interview in HTG-II, 385-388.
- EC: OJ 2011, 352 notice does not limit interviews “only” to telephone and R.66.6 PCT allows personal interviews. HTG-II is not legal basis.

m) DII – Q.1

- TS: Examiners’ Report – page 4: “The *website* posting is prior art under Art. 54(2) EPC for claim 1 of EP-2”. But this is only true if the bundle disclosed was the bundle B. This is not explicitly given in paragraph [0009] of the paper – „... relates to a hollow fibre membrane module“. This seems unclear.
- EC: Not seen as a problem. Candidates did not seem to have a problem with it.
- TS: Examiners’ Report – page 4: “The *demand* for PCT-1 was validly filed as the time limit is the transmittal of ISR plus 3 months“. This does not a relevant

comment because examination is underway – we are even going for an interview.

- EC: Yes – not so relevant. But many candidates came up with it, so it was decided to give the statement marks.
- TS: Examiners’ Report – page 4: “there is sufficient *evidence* before the examiner that a module also works with other materials ...“. Would extrinsic evidence actually be considered to support a claim missing an essential feature?
- EC: “evidence” here should be read as meaning mainly intrinsic [i.e. from the application-as-filed].

n) D Paper in 2013

- EC: No substantial changes in marking. Structure will be similar, but reduced in size. If sections of 2012 paper were condensed, it would resemble a 2013-style D paper.
- EC: Candidates should prepare as they have always done
- EC: DI and DII parts will be identified, but time management will be more critical.
- EC: DI is never directed to specific US provisions, so knowledge need for AIA (America Invents Act) is limited.
TS: Candidates should know that from 16 Sept. 2012, it is no longer needed to specify that inventors are applicants for US when filing PCT application.

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Nächste Ausgaben · Forthcoming issues · Prochaine éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
1/2013	February 15, 2013	March 28, 2013
2/2013	May 13, 2013	June 28, 2013
3/2013	August 9, 2013	September 30, 2013
4/2013	November 4, 2013	December 30, 2013

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Statistics on the results of the 2012 EQE

1) Passes pursuant to Article 14(1) of the Regulation on the European qualifying examination (REE)*

Place of residence	Total number of candidates	Pass**
AL	0	0
AT	16	3
BE	42	13
BG	0	0
CH	84	23
CY	0	0
CZ	3	1
DE	953	248
DK	104	22
EE	0	0
ES	99	17
FI	65	8
FR	210	73
GB	211	102
GR	1	0
HR	0	0
HU	1	0
IE	5	0
IS	1	0
IT	137	14
LI	3	2

Place of residence	Total number of candidates	Pass**
LT	0	0
LU	4	1
LV	0	0
MC	2	0
MK	0	0
MT	1	0
NL	149	32
NO	5	1
PL	15	2
PT	7	1
RO	6	1
RS	0	0
SE	149	30
SI	1	0
SK	0	0
SM	0	0
TR	7	1
CN	1	0
JP	1	0
TOTALS	2283	595

* This table includes all candidates who fulfil the conditions of Article 14(1) REE irrespective of whether they fulfil the conditions of Article 14(2) REE.

** Candidates are free to choose which paper(s) they wish to sit. Candidates who have only sat a sub-set of papers cannot fulfil the conditions of Article 14(2) REE (have obtained the minimum grades for all four papers) and thus cannot be included in this column.

Example: A candidate has only sat papers A and B and passed both papers. Nonetheless the conditions of Article 14(1) REE are not yet fulfilled and this candidate is not included in this column.

Subject to Article 25(1) and (2) REE, passes awarded for examination papers in previous years remain valid.

Source: Examination Secretariat for the European Qualifying Examination

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João Pereira da Cruz
Secretary General

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Institut der beim Europäischen Patentamt zugelassenen Vertreter
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 Institut des mandataires agréés près l'Office européen des brevets

Einzugsermächtigung

Eingangsfrist im
epi-Sekretariat:

1. Februar 2013

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (**epi**) wird hiermit ermächtigt, den jeweils gültigen **epi**-Jahresmitgliedsbeitrag für das genannte Mitglied einzuziehen. Der Einzug erfolgt einmalig am 25. Februar des laufenden Jahres von dem nachfolgend anzugebenden Konto beim Europäischen Patentamt (EPA). Die Einzugsermächtigung wird wirksam beginnend mit dem Jahresmitgliedsbeitrag 2013 und gilt für künftig fällige Mitgliedsbeiträge bis auf schriftlichen Widerruf. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem **epi** getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen werden dem Einzug des **epi**-Beitrags vorgezogen. Bitte stellen Sie sicher, dass im Abbuchungszeitraum Ihr EPA Konto über eine ausreichende Deckung verfügt. Wir weisen Sie darauf hin, dass bei unzureichender Deckung der komplette Abbuchungsauftrag nicht ausgeführt werden kann. Der Kontoinhaber und jedes **epi**-Mitglied werden darüber schriftlich in Kenntnis gesetzt.

☐ Ich stimme den oben genannten Bestimmungen zu.

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Deadline for receipt by the
epi Secretariat:

1st February 2013

The Institute of Professional Representatives before the European Patent Office (**epi**) is hereby authorised to debit the **epi** annual subscription for the member named below at the appropriate rate. This direct debit occurs once on February 25 of the current year from the deposit account held with the European Patent Office (EPO) as specified below. This direct debiting mandate applies to the membership fee 2013 and the forthcoming subscriptions until it is revoked in writing. Debiting will be done on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the **epi** (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

All fees and costs payable to the EPO on the debiting date have priority over the **epi** subscription. Please be sure that during the period of time surrounding the time of the debit order there are sufficient funds in your EPO account to cover the entire debit order. Kindly note that a partial coverage will prevent the entire debit order from being carried out. In such cases, the holder of the account as well as each **epi** member involved will be informed in writing.

☐ I agree with the stipulations sited above.

Autorisation de prélèvement

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

1^{er} février 2013

L'Institut des mandataires agréés près l'Office européen des brevets (**epi**) est autorisé par la présente à prélever le montant en vigueur de la cotisation annuelle de l'**epi** pour le membre dont le nom figure ci-dessous. La présente autorisation de prélèvement sur le compte ouvert à l'Office européen des brevets (OEB) prend effet une seule fois le 25 février de l'année en cours. Cette autorisation de prélèvement vaut pour la cotisation 2013 ainsi que pour les cotisations suivantes jusqu'à révocation par écrit.

Le prélèvement est opéré sur la base des dispositions de l'accord administratif en date du 5 avril 1993 entre l'OEB et l'**epi** (JO OEB 1993, 367) ainsi que de celles du point 9 de la décision modifiant la réglementation applicable aux comptes courants (JO OEB 1993, 366).

Le règlement de toutes les taxes et de tous les frais dus à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle de l'**epi**. Veuillez vous assurer que votre compte à l'OEB est suffisamment approvisionné pendant la période de débit. Nous attirons votre attention sur le fait que l'ordre de débit sera refusé dans sa totalité si le compte n'est pas suffisamment approvisionné. Dans ce cas, le titulaire du compte ainsi que chaque membre de l'**epi** seront informés par écrit.

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List of Professional Representatives as at 31.10.2012

by their place of business or employment in the Contracting States

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BE	191	1,79
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CH	485	4,53
CY	12	0,11
CZ	99	0,93
DE	3683	34,42
DK	224	2,09
EE	26	0,24
ES	182	1,70
FI	170	1,59
FR	990	9,25
GB	2031	18,98
GR	24	0,22
HR	27	0,25
HU	79	0,74
IE	61	0,57
IS	21	0,20
IT	471	4,40

Contr. State	Total Repr.	% of Total Repr.
LI	18	0,17
LT	26	0,24
LU	20	0,19
LV	21	0,20
MC	3	0,03
MK	28	0,26
MT	6	0,06
NL	460	4,30
NO	100	0,93
PL	326	3,05
PT	40	0,37
RO	60	0,56
RS	56	0,52
SE	353	3,30
SI	29	0,27
SK	36	0,34
SM	24	0,22
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Source: Legal Division / Dir. 5.2.3 / European Patent Office

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
Germany

Tel.: +49 (0)89 2399-5231
Fax: +49 (0)89 2399-5148
legaldivision@epo.org
www.epo.org

Thank you for your cooperation.

Next Board and Council Meetings

Board Meetings

- 88th Board meeting on 23 March 2013 in Stockholm (SE)
- 89th Board meeting on 28 September 2013 in Riga (LV)
- 91th Board meeting on 27 September 2014 in Zagreb (HR)

Council Meetings

- 74th Council meeting on 19/20 April 2013 in Vienna (AT)
- 75th Council meeting on 16 November 2013 in Prague (CZ)
- 76th Council meeting on 28/29 April 2014 in Munich (DE)
- 77th Council meeting on 15 November 2014 in Milan (IT)

News concerning epi Council and Committees

Council

Albania:

- Ms Arseni Meçaj (AL), full Council member for AL , resigned from all offices.
- Ms Kola-Tafaj (AL), substitute Council member for AL, resigned from all offices.
- Mr Eno Dodbiba (AL) takes over as full member.
- Mr Alban Ruli (AL) takes over as substitute member.

Sweden:

- Ms Anita Skeppstedt (SE) left industry and joined private practice. Therefore she had to resign as full member.

For Sweden there are no more substitute members available.

Harmonization Committee

- Mr Gediminas Pranevicius (LT) was elected substitute member.

Patent Documentation Committee

- Ms Cristina Fraire (IT) resigned from the Committee.

- Mr Alessandro Guerri (IT) was elected substitute member.

Committee on Biotechnological inventions

- Ms Zeljka Brkic (RS) was elected full member.
- Mr Francisco Bernardo Noriega (ES) was elected full member.
- Ms Diana Sinojmeri (AL) was elected full member.

Disciplinary Committee (epi)

- Ms Vasiliki A. Rousounidou was elected as member of the Disciplinary Committee for Cyprus.
- Ms Flutura Kola-Tafaj (AL) resigned from all offices.
- Ms Melina Nika (AL) was elected as member of the Disciplinary Committee for Albania.
- Mr Luigi Sansone (MT) had to resign from the Disciplinary Committee since it is not allowed to be a Board member at the same time.
- Mr Antoine Camilleri (MT) was elected as member of the Disciplinary Committee for Malta.

Opponent Status – Questions and Answers?

J.H. Sunderland (GB)¹

Some questions concerning opponent status find no answers in the EPC. To arrive at answers Boards of Appeal have filled perceived gaps in the law. Evidently this has not been easy. Over time the Enlarged Board of Appeal has reversed two of its answers to questions concerning who may be an opponent. Could other answers be revised or even reversed in future? Could the present position regarding transfer of opponent status be a flawed compromise? How can problems relating to transfer of opponent status be averted?

Background

The EPC, whether EPC 1973 or EPC 2000², has little to say about who may enjoy the status of opponent: –

- Any person may give notice of opposition^{3,4}
- In the event of death or legal incapacity of an opponent, the opposition proceedings may (or may not) be continued with participation of the heirs or legal representatives⁵
- Third parties may act in common in filing a notice of opposition⁶

Given the paucity of guidance in the EPC, Boards of Appeal, including the Enlarged Board of Appeal, have had to evolve answers to some basic questions regarding opponents.

Opposition by Proprietors, Licensees and Inventors

The first question addressed by the Enlarged Board of Appeal in relation to opponents was whether the patent proprietor could oppose his own patent.

In an early decision (G1/84⁷) the Enlarged Board of Appeal found that so-called “self-opposition” by the patent proprietor was not prohibited.

G1/84, Order: – “A notice of opposition against a European patent is not inadmissible merely because it has been filed by the proprietor of that patent.”

The finding was based on considerations of public interest and on the EPC’s lack of any restriction on the motives or interests of “any person” who may give notice of opposition: –

G1/84, Reasons for the Decision, The question put, Point 3: – “... except in cases of manifest abuse of procedure, the overwhelming public interest lies in each opposition being examined on its merits. The motives of the opponent are in principle irrelevant (otherwise, no doubt, the phrase “any person” would have been rendered as “any person interested”) ...”

Further, in G1/84 a theory was proposed that opposition proceedings are not essentially contentious, but investigative: –

G1/84, Reasons for the Decision, The question put, Point 4: – “Even though opposition proceedings give the public the opportunity to be parties to proceedings challenging the validity of granted European patents, it would be wrong to regard such proceedings as essentially contentious proceedings between warring parties where the deciding body takes a neutral position, as would be the case in revocation proceedings before a national court. Opposition proceedings in the European Patent Office are designed to be investigative in nature ... and once an opponent has launched an admissible opposition he may play a completely passive role or even withdraw from the proceedings without thereby bringing them to an end ...”

On this theory – that opposition involves non-contentious, investigative examination of validity of the patent concerned – the Enlarged Board took the view that effectively *ex parte* opposition proceedings, with the patent proprietor also playing the role of opponent, were not precluded.

However, in later decisions of the Enlarged Board of Appeal (G9/91 and G10/91⁸) the G1/84 theory that opposition proceedings were not contentious was reconsidered: –

G9/91, Reasons for the Decision, Point 2: – “... it may be questioned whether the statement made by the Enlarged Board of Appeal in case G1/84 ... that “it would be wrong to regard such (opposition) proceedings (under the EPC) as essentially contentious proceedings

¹ Of Counsel, Haseltine Lake LLP, epteam@haseltinelake.com, www.haseltinelake.com

² The provisions relating to oppositions were largely left unchanged when the EPC was revised (see e.g. Case Law of the Boards of Appeal, 6th Edition, July 2010, page 764).

³ Article 99(1), 1st sentence, EPC 1973 Article 99(1), 1st sentence, EPC 2000: – (Opposition): „Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent, ...”

⁴ Article 105 EPC 1973 Article 105 EPC 2000 (Intervention of the assumed infringer) provides that subject to specific conditions an alleged infringer of the patent concerned, after expiry of the nine-month opposition term, may intervene in pending opposition proceedings and acquire the status of opponent (see e.g. Case Law of the Boards of Appeal, 6th Edition, July 2010, page 719 et seq.).

⁵ Implied by Rule 60(2), first sentence, EPC 1973 = Rule 84(2), first sentence, EPC 2000: – (Continuation of the opposition proceedings by the European Patent Office of its own motion): „In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs or legal representatives.”

⁶ Implied by Rule 100(1), final sentence, EPC 1973 Rule 151(1), final sentence, EPC 2000: – (Appointment of a common representative): – „The same shall apply to third parties acting in common in filing a notice of opposition ...”

⁷ Official Journal EPO, 10/1985, Pages 299-305. Decision date 24 July 1985. Referral from T130/84.

⁸ Official Journal EPO, 7/1993, Pages 408-421. Decision date 31 March 1993. Referrals from T580/89 and from the President of the EPO.

between warring parties ...” is quite accurate, at least as a generalisation

In any case, it seems to the Enlarged Board in its present composition that post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment.”

This was followed by reconsideration, in Enlarged Board of Appeal decision G9/93⁹, of the G1/84 finding that “self-opposition” by the patent proprietor was not prohibited.

G9/93, *Reasons for the Decision, Point 2*: – “The Enlarged Board of Appeal endorses the concept of opposition proceedings applied in G9/91 and G10/91.”

G9/93, *Reasons for the Decision, Point 3*: – “... the words “any person” in Article 99(1) EPC can in the present Board’s opinion only be reasonably interpreted as referring to the public at large which is being given the opportunity to challenge the validity of the patent in question. To include the patent proprietor in this concept appears artificial. In the present Board’s view, the provisions of ... the EPC ... are clearly posited on the assumption that the opponent is a person other than the patent proprietor and that opposition proceedings are always *inter partes* (c.f. in particular Article 99(4) and 101(2) and Rule 57 EPC¹⁰). Thus the present Board – in contrast to the decision in G1/84 – holds that the patent proprietor is not covered by the term “any person” in Article 99(1) EPC and is therefore not entitled to oppose his own patent under that provision.”

Drawing on G9/91 and G10/91, and the apparent implication of Article 99(4) EPC1973 (Article 99(3) EPC2000) that patent proprietor and opponents are distinct parties in *inter partes* proceedings, the Enlarged Board qualified the meaning of “any person” in a way – member(s) of the public at large – excluding the patent proprietor as a potential opponent. However, the Board did not question the proposition that the motives or interests of an opponent are in principle irrelevant.

Thus, nine years after the original finding in G1/84, the original view of the Enlarged Board of Appeal that “self-opposition” was not prohibited was reversed. This may illustrate the difficulties posed by the paucity of guidance in the EPC concerning the question of who may assume the status of opponent.

In Enlarged Board of Appeal decision G9/93 it was noted that, aside from self-opposition, the EPC provided no opportunity for the patent proprietor to request limitation of his patent, an issue that was also considered in G1/84: –

G9/93, *Reasons for the decision, Point 4.1*: – “The Enlarged Board hearing case G1/84 considered the question of self-opposition against the background that the EPC – unlike the Community Patent Convention (CPC),

which however is not yet in force – contains no provision enabling the proprietor of a European patent to request limitation of his patent. It concluded that if he could not limit it during opposition proceedings he would have to fall back on such limitation proceedings as might be available under national law, which was bound to cause legal uncertainty, procedural delays and extra expense. The present Board takes the view that even if such disadvantages existed they would not serve to justify not applying Article 99 EPC as it stands, but would be a matter for the legislator to cure if they were considered as giving rise to serious problems.”

The legislator did, of course, eventually cure this problem with the introduction of Articles 105a, b and c EPC2000, which allow the patent proprietor to request “central” limitation or even revocation of his patent at the EPO, without resort to national law provisions or to “self-opposition”.

Based on information available up to June 2012¹¹, around 220 requests for limitation had been filed at the EPO and about 40 requests for revocation. The issue of self-opposition by the patent proprietor may well now be regarded as moot.

Following the G9/93 decision prohibiting self-opposition by the patent proprietor, a natural question might be “who else could fall outside the concept of ‘the public at large’”?

It may seem difficult to regard a licensee under a patent as a member of “the public at large”. However, there seems to be no prohibition on a licensee attacking the relevant patent. For example, in case T1204/97¹² an opponent who became a licensee of the patent proprietor withdrew its own opposition but then assumed the status of opponent/appellant through universal succession on purchase of another original opponent. The patent proprietor argued that the opponent/appellant had no legitimate interest to further pursue opposition to the patent. The Board of Appeal said: –

T1204/97, *Reasons for the decision, Point 1.2*: – “Whether or not an opponent acts unlawfully or contrary to contractual obligations in relation to the proprietor by pursuing an opposition against its patent is, as a matter of principle, outside the opposition procedure and is not to be examined by the EPO but falls within the remit of the national courts. Even where the opponent’s contractual relations with the proprietor are so strong that it is under a no-challenge obligation ... this has no effect on the admissibility of an opposition filed by it with the EPO, but the proprietor must attempt to enforce its rights before the competent national authorities (G 3/97 and G 4/97 ... point 3.3.2 of the reasons) ...”

It also seems difficult to regard an inventor of the invention to which the patent relates as a member of “the public at large”. Is there some principle which prohibits an inventor attacking “his own” patent?

This issue was addressed by a Board of Appeal in case T3/06¹³. The T3/06 decision found an opposition by the

9 Official Journal EPO, 12/1994, Pages 891-897. Decision date 6 July 1994. Referral from T788/90.

10 Article 99(4) EPC 1973 = Article 99(3) EPC 2000: „Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.“. Article 101(2) EPC 1973 Article 101(1) EPC 2000. Rule 57 EPC 1973 Rule 79 EPC 2000.

11 This information is based on the EPO’s Espace Bulletin DVDs.

12 Decision date 11 April 2003

13 See Case Law of the Boards of Appeal, 6th Edition, July 2010, page 767. Decision date 3 May 2007.

sole inventor to be admissible despite the fact that, in the case concerned, the inventor was a not insignificant shareholder in the patent proprietor company, even if not active in its management, and could possibly have been considered to be acting contrary to fiduciary or contractual duty. It appears that there is no principle which generally prohibits an inventor attacking "his own" patent (at least where the inventor is not a patent proprietor of record).

The T1204/97 and T3/06 decisions may be based upon G9/93 and upon later decisions of the Enlarged Board of Appeal (G3/97 and G4/97) which are discussed below. These later decisions relate primarily to the subject of nominal or "straw man" opponents but also address general issues relating to the status of opponent.

Straw Man Opponents

Nominal or "straw man" opponents, typically individual European patent attorneys (professional representatives), appeared in the early days of the European patent system. However, the use of such nominal opponents was found not to be permissible.

It appears that the issue of "straw man" opponents was first considered by a Board of Appeal in T10/82¹⁴: –

*T10/82: – Headnote. "If a professional representative files notice of opposition in his own name although – as he later allows – he is acting in a professional capacity on behalf of a client, the notice does not comply with Rule 55 EPC"*¹⁵.

G1/84 alluded to the issue of "straw men" and approved T10/82, though the Enlarged Board of Appeal declined to extend the prohibition of use of a "professional representative" straw man to prohibition of use of "straw men" in general: –

G1/84, Reasons for the decision, The general background to the question put, Point 2: – "If the proprietor of the patent is not allowed to file the opposition himself, he would, no doubt, hesitate to induce a third party with whom he was not on close and reliably friendly terms to file an opposition. The only practical thing that he might do is to try to employ the very ancient lawyers' device of having a "man of straw" as the opposing party. That procedure may reduce the proceedings to a sham, since the "man of straw" in this case is no real third party but the puppet of the proprietor. If the connection between the proprietor and his puppet is not known to the European Patent Office and the general public, possibilities of deceit and abuse of the opposition procedure for ulterior purposes, e.g. delaying procedure in other jurisdictions, exist.

It is not necessary, for present purposes, that the Board should decide the question whether an opposition filed in the name of a "man of straw" is or is not admissible in any circumstances and the Board does not now do so.

Suffice it to observe that the Board sees no reason to question the rightness of the Decision in Case T 10/82 ..."

In practice, "straw man" allegations were made not only against professional representatives and the procedure to be adopted when an opponent was alleged to be a "straw man" raised questions – How "solid" need the allegation be? Was it sufficient merely that the opponent was a patent attorney, or simply an individual with no apparent commercial interest in the field of the opposed patent? Where did the burden of proof lie? To what extent could the opponent be called upon to prove he was not a "straw man"? These issues exercised Boards of Appeal in a number of cases, for example T635/88¹⁶, T289/91¹⁷, T590/93¹⁸, T339/93¹⁹, T798/93²⁰.

T635/88, Headnote: – "1. If the Board of Appeal or the Opposition Division has a legitimate doubt as to the identity of the real opponent, it has the power to request the alleged opponent at any time to assist in removing this doubt, e.g. by means of a written sworn statement 2. The failure of the alleged opponent to comply with such a request, so that the doubt remains, has the effect that the opposition must be rejected as inadmissible ..."

T289/91, Reasons for the decision: – "2.2.3 ... the Board must as a matter of principle assume that any person giving notice to the EPO of opposition against a European patent in his own name is indeed acting in his own name. The EPC does not provide for any demand that this should as a matter of principle be confirmed by a declaration under oath where there is no obvious economic interest in the subject-matter of the patent in suit 2.2.4 The Board therefore believes that an opponent can only be required to make such a declaration if, as in case T635/88, the Board is notified of concrete grounds for harbouring serious doubts as to the opponent's true identity, because only under these circumstances can the Board request the opponent to assist in removing the existing doubts."

T590/93, Headnote: – "Evidence relating to an opponent's personal circumstances is insufficient, in itself, to undermine the credibility of his stated identity under Rule 55(a) EPC. This identity can only be challenged by cogent evidence that another legal/natural person is the true opponent."

T798/93, Headnote: – "I. Article 99(1) EPC, which enables "any person" to institute opposition proceedings, establishes the presumption that the real opponent is the person who has lodged the opposition ... II. The presumption established by Article 99(1) EPC can only be set aside if proof is furnished, during the proceedings, that a third party has claimed to be the real opponent. In this event, to uphold the principle established by board of appeal jurisprudence that "oppositions must be filed

14 Official Journal EPO, 10/1983, Pages 407-411. Decision date 15 March 1983.

15 The requirement to identify the opponent. Rule 55 EPC 1973: – „The notice of opposition shall contain: (a) the name and address of the opponent and the State in which his residence or principal place of business is located, ... " Rule 76(2)(a) EPC 2000.

16 Official Journal EPO, 10/1993, Pages 608-616. Decision date 28 February 1992.

17 Official Journal EPO, 9/1994, Pages 649-652. Decision date 10 March 1993.

18 Official Journal EPO, 5/1995, Pages 337-344. Decision date 10 May 1994.

19 Decision date 18 April 1996.

20 Official Journal EPO, 8/1997, Pages 363-375. Decision date 20 June 1996.

and pursued ... so as to avoid ... uncertainty", the "person" in whose name the opposition was filed may be asked to assist in dispelling the doubt (see T 635/88)."

The Boards of Appeal set a high threshold to be overcome before they would consider taking action relating to a "straw man" allegation: – either the opponent must admit he is a "straw man" or concrete grounds must establish serious doubts as to the opponent's "true identity".

However, the Boards held to the idea that there could be a "real opponent" or "true opponent" who was other than the named opponent.

Nonetheless, the Boards do not appear to have questioned the proposition that the motives or interests of an opponent are in principle irrelevant: –

T635/88, Reasons for the Decision, Point 6: – "... the European Patent Convention does not require any particular interest to start opposition proceedings ... Therefore, the lack of interest in opposing a patent cannot be considered as a ground of inadmissibility."

*T590/93, Reasons for the decision, Point 2: – "... the provisions of Article 99(1) EPC must be given their plain and literal meaning in the context of the Convention as a whole. It is therefore clear that any person, as opposed to any person **interested**, may oppose a granted European patent. Had the intention of the legislature been different, the article would no doubt have been drafted to include locus standi or some other formulation of relevant interest as a precondition for the admissibility of an opposition ... It follows from the above that if an opponent's interests are irrelevant to admissibility, then the nature of these interests, let alone motives, whether they be fair or unfair, must likewise be irrelevant to the admissibility of an opposition."*

T339/93, Reasons for the decision: – Point 3. "Article 99(1) EPC states that any person may give notice of opposition. There is no requirement that he have an interest. It is already a gloss on this to require that such person file the opposition in his own name, ... 5 One can file an opposition, but would still like to persuade others to assist in substantiating it and possibly paying any legal costs. An opposition is not assignable as such, so that it and any appeal must usually be continued in the name of the original opponent, even if others may later have a greater interest in the outcome."

*T798/93, Reasons for the decision: – Point 3.1.2 "The board is bound to point out that Article 99(1) EPC allows "any person" to institute opposition proceedings, and that the EPC and its attendant provisions make **no stipulation as to the circumstances of a person acting** in opposition proceedings before the EPO ... 3.2.1 In addition to the fact that the EPC and its attendant provisions contain no stipulation as to the opponent's personal circumstances, the above-mentioned decision in T635/88 also makes it clear that **the opponent's interest in acting is not subject to any restriction**. The opposition procedure was deliberately designed to be open and readily accessible, so that third parties – acting on their own behalf, and, above all, in the public interest – would be able to get a patent limited*

or revoked by a department of the EPO, via a procedure which offers the advantage of being centralised. The openness of the procedure also speeds up the handling of the case by relieving the Office of the complicated task of verifying the opponent's circumstances and motives for acting."

It is observed that the idea of a "true opponent", other than the actually named opponent, appears to sit uncomfortably alongside the idea that the nature of the interests or motives of any opponent are irrelevant to the admissibility of an opposition.

Against this background, and based on referrals from two Boards of Appeal – see T301/95²¹ and T649/92²², which also provide a review of the background – the Enlarged Board of Appeal carried out a fundamental review of the issue of nominal opponents.

The Enlarged Board of Appeal took a clear position (see G3/97 and G4/97²³): –

1. Both referrals essentially pose the question whether an opposition is inadmissible if the opponent is acting on behalf of another person, i.e. as a straw man ... (and) ... invoked the principle that a person acting on behalf of a third party was not the true opponent.

2. The Board is unable to accept this premise.

2.1 The status of opponent is a procedural status and the basis on which it is obtained is a matter of procedural law. The EPC addresses this in Article 99(1) in conjunction with Article 100, Rules 55 and 56(1) EPC. On this basis, the opponent is the person who fulfils the requirements of the EPC for filing an opposition; in particular, the person must be identifiable (see Rule 55(a) EPC). The EPC does not specify any further formal requirements to be met by the opponent. A person who fulfils the said requirements becomes a party to the opposition proceedings (Article 99(4) EPC). In these proceedings, only his acts are relevant. A third party (the "principal") who has incited the opponent to file the opposition cannot perform any procedural acts. The question whether the opponent's acts accord with the intentions or instructions of the principal is relevant only to the internal relationship between the latter and the opponent, and has no bearing on the opposition proceedings.

By contrast, it has been argued that a person acting on behalf of a third party is not acting in his own name (T10/82 ...). However, such a view is expressly contradicted by the opponent's procedural statements. He has neither stated that he wishes to file an anonymous opposition, nor is this his intention; instead, he expressly wishes to file the opposition in his own name ... the opponent does not wish to act on the basis of the principal's personal entitlement. Instead, he is exercising his own right as a member of the public to file an opposition.

2.2 The opponent does not have a right of disposition over his status as a party. If he has met the requirements for an admissible opposition, he is an opponent and remains such until the end of the proceedings or of his

21 Official Journal EPO, 11/1997, Pages 519-532. Decision date 27 June 1997.

22 Official Journal EPO, 3/98, Pages 97-112. Decision date 2 July 1996.

23 Official Journal EPO, 5/1999, Pages 245-272. Decision date 21 January 1999.

involvement in them. He cannot offload his status onto a third party

Thus there cannot be another "true" opponent apart from the formally authorised opponent.

3. Accordingly, an opposition on behalf of a third party complies with the provisions on filing oppositions

3.2.1 Some of the EPC contracting states require, as a precondition for instituting revocation proceedings, that the plaintiff must have an interest in the invalidation of the patent. Taking a different approach, the EPC legislator explicitly designed the opposition procedure as a legal remedy in the public interest which, according to Article 99(1) EPC, is open to "any person". It would be incompatible with this to require that the opponent show an interest, of whatever kind, in invalidating the patent

3.2.2 If, therefore, it cannot be required that the opponent have an interest in the revocation of the patent, then logically this can only mean that the opponent's motives are of no consequence for the EPO, at least as long as no conduct involving an abuse of process arises from additional circumstances

The Enlarged Board thus dismissed the idea that there could be a "true opponent" other than the named opponent and determined that the use of nominal opponents was in general unobjectionable, essentially setting aside the position taken in earlier Board of Appeal decisions over a period of fifteen years. This again illustrates the difficulties posed by the paucity of guidance in the EPC concerning the question of who may assume the status of opponent.

The Enlarged Board reaffirmed the proposition that the motives or interests of an opponent are in principle irrelevant.

The Enlarged Board did, however, make the unsurprising reservation that an opposition by a nominal opponent ("straw man") was inadmissible if the involvement of the opponent was to be regarded as circumventing the law by abuse of process.

As an example of abuse, the Board mentioned opposition in which the nominal opponent was in fact acting on behalf of the patent proprietor. As discussed above, so-called "self-opposition" by the patent proprietor was originally allowed (G1/84) but later prohibited (G9/93). Disguising a "self-opposition" by the use of a nominal opponent would apparently be considered to be a circumvention of this prohibition. Of course, as mentioned above, Articles 105a, b, c EPC2000 now provide that the patent proprietor can request revocation or limitation of his patent without resorting to "self-opposition", so this may be a moot issue today.

As another example of abuse, the Board mentioned a situation in which a nominal opponent was used to circumvent requirements (Articles 133 & 134 EPC1973 and EPC2000) for representation by a suitably qualified professional representative (usually a European patent attorney).

The Enlarged Board also considered the question of burden of proof. The Board stated that the burden of proof is to be borne by the person alleging that an

opposition is inadmissible, and that the deciding body (an EPO Opposition Division or Board of Appeal) has to be satisfied on the basis of clear and convincing evidence that the law has been circumvented by abuse of process. The Enlarged Board thus set a high threshold to be overcome before Boards of Appeal, or Opposition Divisions, would take action relating to a "straw man" allegation, but now the threshold applies not to the mere fact that the opponent may be a nominal opponent, but to demonstration that an abuse of process has occurred.

In a later case, T315/03²⁴, which was decided by a 5-member Technical Board of Appeal, it was argued by the patent proprietor that some (joint) oppositions should be considered to be inadmissible because the relevant (common or multiple) opponents, in whose names the oppositions were filed, were "formed and supported" by other parties of unclear status. In effect, there was a lack of clarity regarding apparent "sponsors" of the oppositions – a form of "straw man" allegation. Referring to G3/97, the T315/03 decision rejected the argument, referred to the acceptability of "straw man" opponents and extended this to joint oppositions filed by multiple opponents: –

T315/03, Reasons for the decision ...

2.5 A further objection to the admissibility of certain other multiple opponents was that they were said to be "formed and supported" by persons of uncertain legal status. As regards "formation", the fact that certain opponents only came into being for the purpose of filing opposition to one patent cannot in itself be an objection to admissibility It is apparent from the opinion of the Enlarged Board in G 3/97 (OJ EPO 1999, 245, Order, paragraph 1(a)) that an opponent's motive or lack of motive is irrelevant: a "straw man", such as a company formed for the sole purpose of opposing a patent, could be acceptable. Since multiple opponents are permissible, it would be illogical to impose a stricter requirement on them.

2.6 As regards "support", it appears to the Board to be wholly irrelevant that an opponent, whether individual or multiple, may be supported by others. Such supporters clearly cannot take any part in the proceedings and cannot affect its outcome. In relation to any proceedings there are likely to be non-parties who want to see a particular party succeed (for example, employees or shareholders of a company which is a party) ...

Enlarged Board of Appeal decisions G3/97 and G4/97 seem to have put an end to discussion of the general legitimacy of nominal or "straw man" opponents, and nominal or "straw man" opponents now seem to be a rather routine feature of EPO opposition proceedings.

It is of course impossible to estimate reliably the proportion of oppositions filed by "straw men". However, considering oppositions filed or admitted in 2011²⁵, a count of cases in which the opponent is a professional

²⁴ Official Journal EPO 4/2005, page 246 (abridged version of the decision). Decision date 6 July 2004. A full version of the decision can be found at:

²⁵ This information is based on the EPO's Espace Bulletin DVDs.

representative or similar, or an overt “straw man”, suggests that they accounted for just over 5 % of a total of around 3650 oppositions (to about 2880 patents). It seems unlikely that this count could represent full coverage of “straw men”.

	Opponent	Count of Oppositions	%
1	Nominal Opponents?	193	5.3
2	Henkel	141	3.9
3	Siemens	80	2.2
4	Procter & Gamble	61	1.7
5	BASF	57	1.6

Transfer of Opponent Status

The transfer or assignment of an opposition from one person to another in response to changing circumstances is a difficult issue. The only hint in the EPC concerning a possibility of transfer of an opposition appears in a rule which primarily addresses something quite different: –

Rule 84 EPC2000 (= Rule 60 EPC 1973): –

Continuation of the opposition proceedings by the European Patent Office of its own motion

...

(2) In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs or legal representatives. The same shall apply where the opposition is withdrawn.

This suggests that, aside from voluntary withdrawal of an opposition, situations were contemplated in which an opponent may be factually or legally incapable of participating further in the opposition proceedings.

The rule apparently gives the EPO discretion to terminate the opposition proceedings when an opponent is unable to participate further (presumably termination of opposition proceedings as a whole could only apply in a case in which the affected opponent is the sole opponent). The rule might be read in the sense that if the EPO chooses to continue the proceedings it need not seek out any “heirs” by whom “rights” in an opposition may have been inherited, nor need it wait on contributions from putative “heirs” before reaching a decision. However, the rule has consistently been interpreted to the effect that “heirs” acquire opponent status and the proceedings continue with their contributions.

Most importantly, by analogy it has been considered that, where the original opponent is a legal person (e.g. a company) a “universal successor” acquires opponent status, for example in the event that the original opponent company is merged with another company: –

T349/86²⁶, Reasons for the Decision, Point 4: – “The Board considers that Rule 60(2) EPC, which states that in the event of the death of the opponent the opposition

proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs, may be read as definitely stating that an opposition may be transferred to a deceased opponent’s heirs and, by analogy, to a company absorbing the opposing company by merger or takeover.”

Beyond such transfer when the original opponent ceases to exist (or becomes legally incapacitated²⁷) there is no hint in the EPC that other possibilities for transfer of an opposition from one person, natural or legal, to another are contemplated. On the other hand, there is no suggestion that further possibilities for transfer are excluded. As stated in T349/86, Reasons for the Decision: –

“5. ... the EPC is silent on the possibility of an opposition being transferred in other circumstances, for example either freely or with the enterprise or part of the enterprise on whose behalf the opposition was instituted.

6. Since this is a purely legal question whose answer cannot be found in an interpretation of the EPC, the Board considers it necessary to refer the matter to the Enlarged Board of Appeal.”

Thus, the issue of transfer of opposition, beyond the scope of inheritance or “universal succession” (or legal incapacity), was first considered by the Enlarged Board of Appeal in G4/88²⁸ on a referral from the Board of Appeal in case T349/86.

The question referred to Enlarged Board of Appeal was: –

“Is an opposition instituted before the European Patent Office transferable only to the opponent’s heirs or can it be transferred freely either with the opponent’s enterprise or with a part of that enterprise operating in a technical field in which the invention to which the patent in suit relates can be exploited?”

In G4/88 the Enlarged Board of Appeal reasoned as follows: –

“1. Under Article 99(1) EPC any person, without restriction, has the right to give notice of opposition to the European patent.

2. This right available to any person, only gives rise to a subjective right for the opponent through actual institution of the proceedings. A bundle of procedural rights is then created in respect of the opponent because ... the opponent becomes a party to the opposition proceedings ...

3. In order to answer the question put, it is necessary to decide whether the status of party to the opposition as defined in this way is transmissible or assignable.

4. The transmission of the opposition to the opponent’s heirs is acknowledged implicitly in Rule 60(2) EPC which stipulates that the opposition proceedings may be continued even without the participation of the deceased opponent’s heirs the Guidelines for Examination in the European Patent Office also allows, by

27 For example bankruptcy in the case of a company? See e.g. T693/05, Reasons for the Decision, Point 1. Decision date 6 March 2007.

28 Official Journal EPO, 12/1989, pages 480-482. Decision date 24 April 1989.

26 Official Journal EPO, 9/1988, pages 345-347. Decision date 29 April 1988.

analogy, for the opposition to be transmitted to the opponent's universal successor in law.

5. The Enlarged Board considers that it falls outside the scope of the reply to the question at issue to examine whether an opposition could be transmitted or assigned independently of the existence of an interest in instituting the opposition, taking into account the provisions of Article 99(1) EPC.

It only appears to be necessary to examine the situation in which the opposition has been instituted in the interest of the opponent's business or part of that business. In this context the term "business" must be understood in a broad sense as describing an economic activity which is or could be carried on by the opponent and which constitutes a specific part of his business assets.

6. The Enlarged Board considers that, in such a situation, the opposition constitutes an inseparable part of those assets. Therefore, insofar as those assets are transferable or assignable under the applicable national laws, the opposition which is part of them must also be regarded as transferable or assignable in accordance with the principle that an accessory thing when annexed to a principal thing becomes part of the principal thing."

The Enlarged Board determined that: –

"An opposition pending before the European Patent Office may be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed."

The Enlarged Board thus declined to address the issue of general free (voluntary) transfer of oppositions, but created a new "business assets transfer" possibility, which allows limited (voluntary) transfer of an opposition. This possibility may bear some analogy to "universal succession" but does not require that the original opponent has ceased to exist as in the case of inheritance or "universal succession" (or has become legally incapacitated). It seems that the "business assets transfer" possibility is outside the scope of Rule 84(2) EPC2000 (= Rule 60(2) EPC 1973).

Subsequent Board of Appeal decisions have interpreted the G4/88 "business assets transfer" possibility narrowly, and Boards of Appeal have declined to create further transfer possibilities.

T9/00²⁹ apparently indicates one restriction on "business assets transfer": –

T9/00, Headnote: – "... If, as in the present case, the subject of an opposition is assigned to two different parts of the opponent's company, the status of opponent can pass to a third party only if both parts or the entire company are transferred to it."

This indicates that if the "assets in the interests of which the opposition was filed" are relevant to different parts of the business of the opponent company then only if all those parts of the business – the entirety of any business assets relevant to the opposition – are transferred to a single third party can the status of opponent

also be transferred, to that single third party. It is observed that as a practical matter it could be problematic to demonstrate in any circumstances that all business assets relevant to an opposition have, without remainder, been transferred.

A particular restriction on the G4/88 "business assets transfer" possibility was apparently that the "assets in the interests of which the opposition was filed" must be vested in the original opponent, and not in some related entity which could have filed the opposition itself. That is, if the original opponent is a parent company but the "assets in the interests of which the opposition was filed" were vested in a wholly owned but legally separate subsidiary company, the "business assets transfer" possibility does not apply. The opposition cannot, in the event of sale of the subsidiary company, be transferred from the parent company to a new owner of the subsidiary company.

This is illustrated for example by T711/99³⁰: –

T 711/99, Headnote: –

"I. The opponent does not have the right to dispose freely of his status as a party, following the general principle of law whereby legal actions are not transferable by way of singular succession – whether for a consideration or not – but only by way of universal succession ... Once he has filed an opposition and met the requirements for an admissible opposition, he is an opponent and remains so until the end of the proceedings or of his involvement in them.

II. Opponent status may be transferred to a singular successor when a commercial department is sold, but this is an exception to the general principle in law whereby an opposition is not freely disposable.

III. This exception should be a narrowly interpreted ... and precludes an opponent parent company from being recognised, in the event of the sale of a subsidiary that has always been entitled itself to file oppositions, as having the right to transfer its opponent status, by analogy with an opponent who sells a commercial department that is an inseparable part of the opposition but is not itself entitled to file oppositions ... The notion of legitimate interest in the proceedings, which is irrelevant for the admissibility of an opposition at the time of its filing, likewise has no bearing on the opponent's status at any subsequent stage ..."

Perhaps the final sentence quoted above illustrates that at some level there appears to be tension between the idea that a possibility for transfer of an opposition depends on transfer of business assets "in the interests of which it was filed" and the fact that possible "interests", if any, of the opponent are irrelevant to acquisition of the status of opponent at the outset of an opposition and are irrelevant to retention of opponent status thereafter³¹.

30 Official Journal EPO, 11/2004, Pages 550-561. Decision date 21 October 2003.

31 It is incidentally noted that when opponent status has been acquired by intervention under the provisions of Article 105 EPC, retention of opponent status does not appear to depend upon continuation of or the fate of the legal proceedings which originally justified the intervention.

29 Official Journal EPO, 6/2002, Pages 275-292. Decision date 18 December 2001.

The issue of transfer of opposition was eventually revisited by the Enlarged Board of Appeal, fifteen years after the G4/88 decision, in response to a referral by the Board of Appeal in case T1091/02³².

T1091/02 provides a detailed review of issues relating to transfer of opposition, consideration of opponent, patent proprietor and public interests, and the state of play with regard to decisions of Boards of Appeal at the relevant time. The Board of Appeal in the T1091/02 case rather took the view that it would be expedient to allow unrestricted free (voluntary) transfer of oppositions: –

T1091/02, Reasons for the decision, Point 2.5.2: – “Contrary to the view taken by the Technical Board of Appeal ... in ... T711/99 ... this board considers that legal certainty and efficiency of procedure could be enhanced if opposition status were freely transferable. Opposition divisions and boards of appeal could then simply rely on corresponding procedural statements of the old and of the new opponent without any need for further factual investigation or complex legal evaluation.”

In the particular case of T1091/02 the situation was similar to that outlined above: a wholly owned subsidiary X of the opponent company Y was sold and it was desired to transfer the opposition to the new owner of the subsidiary.

T1091/02, Reasons for the decision, Point 2.4: – “... the board takes the view that, from an overall perspective, the factual situation as alleged by the appellant is rather similar to the situation in which decision G 4/88 accepted a transfer of opponent status. If [X] had not been a separate legal entity, but a mere commercial division of [Y], the sale of this division would have been regarded as a transfer of the relevant business. The application of the above case law appears to make the transferability of opponent status depend on the corporate structure of the opponent: if a holding company files an opposition relating to the business of its legally separate affiliate, sale of this affiliate will not lead to a transfer of opponent status. If, however, a company files an opposition relating to the business of one of its commercial divisions, the sale of this division can give rise to a transfer of opponent status.”

The Board also commented as follows: –

T1091/02, Reasons for the decision, Point 2.5.6: – “... opposition proceedings before the EPO exhibit certain peculiarities which may support the argument that the party status of an opponent should be transferable more flexibly than party status in most other court proceedings ...

*... the party status of the **proprietor** is freely transferable. Thus, restricting the transferability of opponent status may result in an imbalance of procedural rights of the respective parties.*

Furthermore, according to Article 99(1) EPC an opposition can be filed by **any** person. There is no

*requirement that an opponent has to show an interest, of whatever kind, in invalidating the opposed patent ... The EPC legislator appears to have chosen this unlimited approach with respect to the **original acquisition** of opponent status in order to safeguard the public interest in the possible control of a granted patent. It may therefore be asked whether a similar approach is not also appropriate in the context of the issue of “**derivative**” acquisition, i. e. transfer of opponent status.”*

In the result, in its decision in G2/04³³, the Enlarged Board of Appeal rejected the proposition of free (voluntary) transfer of oppositions, and declined to extend the scope of the “business assets transfer” possibility: –

G2/04, Reasons for the decision: – “2.1.1 Whereas it may be said that in G4/88 the question was left undecided whether opponent status can be freely transferred ..., the Enlarged Board of Appeal took position in this respect in G3/97 stating that the “opponent does not have a right of disposition over his status as a party” ... There is no reason to deviate from this position.

Whereas the EPC has made provision for the requirements under which the status of the applicant or proprietor in the proceedings before the EPO may change, there are no corresponding provisions for the opponent. As an exception, the situation of the heir as universal successor is addressed in Rule 60(2) EPC. Apparently the legislator did not want to provide for cases of transfer apart from universal succession. No lacuna in the law has become apparent which the jurisprudence might be called upon to fill ...

2.2.2 In the case law of the Boards of Appeal subsequent to G4/88 ... the rationale of G4/88 was not extended to other situations. In addition to the cases of universal succession, a transfer of the opposition was only allowed when a relevant part of the opponent’s business was transferred ...

The interests involved do not justify applying the rationale of decision G4/88 mutatis mutandis to the case of the sale of a subsidiary company in whose interest the holding company filed the opposition.”

In conclusion: –

G2/04, Headnote: – “I.(a) The status as an opponent cannot be freely transferred.(b) A legal person who was a subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company.

It is opined that the Enlarged Board in G2/04 may have been rather uncomfortable with the G4/88 “business assets transfer” possibility (“Apparently the legislator did not want to provide for cases of transfer apart from universal succession. No lacuna in the law has become apparent which the jurisprudence might be called upon to fill ...”). It would not have been surprising if the Enlarged Board had concluded that transfer of opposition was possible only in the case of “universal succes-

32 Official Journal EPO, 1/2005, Pages 14-40. Decision date 23 July 2004.

33 Official Journal EPO, 11/2005, Pages 549-576. Decision date 25 May 2005.

sion" (or legal incapacity of the original opponent) and reversed G4/88.

Corporate Structure and Transfer of Opposition

Transfer of oppositions, and opponent appeals (transfer of which is subject to the same criteria as transfer of oppositions³⁴), has been addressed by Boards of Appeal in a number of other cases both before and since G2/04. As might be expected, and as exemplified by T9/00, T711/99 and T1091/02 mentioned above, cases in which transfer issues receive detailed consideration before Boards of Appeal generally relate to situations which do not readily and simply correspond to "universal succession" or to the G4/88 "business assets transfer" possibility³⁵. Some of these cases illustrate that corporate structures, changes to those structures, and transactions between corporations can be rather complex (e.g. T298/97³⁶, T1178/04³⁷, T1421/05³⁸).

In G2/04 the Enlarged Board recognised that different corporate structures could have different consequences for the transferability of oppositions. The Board indicated that it was the responsibility of the party concerned to choose a structure balancing the advantages and disadvantages of the available possibilities, recognising that a disadvantage of some structures could be that a transfer of an opposition may sometimes not be possible at all (and that the party concerned cannot complain if this proves to be the case).

In G2/04 the Enlarged Board suggested that, in the particular circumstances concerned, a different stance could have been taken which could have facilitated transfer of the opposition from the parent company to the new owner of the subsidiary: –

G2/04, Reasons for the decision, Point 2.2.1: – "... the opponent could easily have made provision for a future eventuality that its subsidiary should take over the responsibility for the opposition. If the holding company and subsidiary had filed the opposition as common opponents, the holding company could have withdrawn from the opposition at any time, leaving the subsidiary as the sole opponent"

Joint opposition by common opponents³⁹ is of course allowed, and some aspects of joint opposition are elucidated in Enlarged Board of Appeal decision G3/99⁴⁰. However, transfer in relation to common opponents involved in a joint opposition appears to be uncharted territory. It might be speculated that the heir or universal successor of one of the common opponents (or legal

representative in the event of incapacity) could step into the shoes of that one common opponent, though this seems doubtful. It seems more doubtful that a "business assets transfer" relating to one of the common opponents could allow a third party to step into the shoes of that one common component. It is noted that in G2/04 the Enlarged Board appears to have predicated the possibility of transfer of the subsidiary's "interest" in the proposed joint opposition upon previous withdrawal of the holding company as common opponent, so the subsidiary becomes the sole opponent before the transfer

The G2/04 "joint opposition" strategy may be viable as a means for facilitating transfer of an opposition in situations involving parent and subsidiary companies, or companies in a group under common control, but requires advance planning with regard to the companies to be included in the joint opposition. Further, the burden of proof that "universal succession" or a "business assets transfer" has taken place still has to be met after superfluous common opponents have been discarded from the joint opposition.

In the event of any transfer of opposition by "universal succession" and in the event of "business assets transfer", the transfer has to be supported by evidence provided to the EPO. If the evidence is unsatisfactory, the transfer fails. In some circumstances this may have no consequences – the opposition can continue in the name of the original opponent. In other circumstances, the result can be termination of the proceedings. An example of this is provided by case T675/05⁴¹ in which an opposition appeal was filed in the name of what at first glance appeared to be the universal successor of the original opponent – but the "small print" can be crucial:

T675/05, Statement by the Opponent/Appellant: – "X is the legal successor to Y as shown by the central company register ... whereby Y was deleted from the register and its business was merged with that of X. The merger came into force on ... upon the deletion of Y from the company register.

In addition, the extracts from the company register ... show that Y ... was completely merged into X. Y was deleted from the register and does not exist anymore."

Reasons for the decision, Point 1.2: – "... In all ... entries [in the central company register] it is indicated that Y was transferred to X as a whole ... with however the exception of certain assets. As such, the entry contradicts itself in referring to the transfer as a whole though with unspecified exceptions. The entry does not therefore allow the conclusion that there was no doubt that the totality of the assets of Y was transferred."

In the above case, the requirements for a "universal succession" transfer of opposition was not met (nor were the requirements for a "business assets transfer"). In the event, the appeal was found to be inadmissible.

It may be that "universal succession" could usually be demonstrated from the public record (e.g. company

34 See e.g. T659/92, Official Journal EPO, 8/1995, Pages 519-524. Decision Date 24 October 1994 („businessassets transfer“); T6/05, Decision date 9 October 2007 („universal succession“).

35 See Case Law of the Boards of Appeal, 6th Edition, July 2010, 5.1 Party status as opponent, Pages 729-736.

36 Official Journal EPO, 2/2002, Pages 83-111. Decision date 28 May 2001.

37 Decision date 27 February 2007.

38 Decision date 18 January 2011.

39 See Case Law of the Boards of Appeal, 6th Edition, July 2010, 2.1.6 Admissibility of a joint opposition – multiple opponents, Pages 769-771.

40 Official Journal EPO, 7/2002, Pages 347-363. Decision date 18 February 2002. Referral from T72/95. G3/99 could be considered to have created the law relating to joint opposition, so far as it stands at present.

41 Decision date 26 June 2007.

registers), but details of a “business assets transfer” may not be public. As a practical matter, it could be that the parties to the opposition transfer may not wish to reveal the details of the commercial transaction involved, perhaps least of all to the patent proprietor or other opponents.

Avoiding Transfer Problems?

In this context, a question to be considered is whether there is a stance to be taken which could meet the needs of changing business circumstances, changing corporate structures and transactions between companies, mitigate potential problems regarding disclosure of business information, and minimize the possibility that a desired transfer of opponent status may fail.

This of course suggests the adoption of a configuration which offers the prospect of avoiding the need for any transfer of opposition during the course of opposition and appeal proceedings.

This could be achieved by the use of a separate “opponent” company – a private limited company – the sole purpose of which is to act as opponent in one or perhaps in a number of related oppositions, with no other business.

In case of need, for example changing business circumstances such as sale of the “principal” or “sponsor” undertaking behind the private company, or sale of the relevant business division or subsidiary of the “sponsor” undertaking, ownership and control of the private com-

pany could be transferred to a new “sponsor”. This transfer would be a matter internal to the private company. The opponent party – the private company – would remain the same. There would be no need to provide the EPO with evidence of any “universal succession” or “business assets transfer”. This relieves the EPO of the need for factual investigation or legal evaluation relating to succession or transfer of assets. It also mitigates the possibility of unanticipated problems (e.g. as in T675/05 above). On conclusion of the opposition proceedings, the private company could simply be wound up.

It may be possible for the private company to accommodate, perhaps through appropriate shareholdings, a number of parties who might otherwise file a joint opposition. Changes to the participants in the opposition would be a matter internal to the private company. This would avoid additional overhead, for the participants and for the EPO, associated with supplying and registering information about any changes to the participants in the opposition.

Thus, by adopting an appropriate structure, following the general suggestion in G2/04, potential problems relating to transfer of opposition could be avoided – even if transfer of opponent status were to be more restricted in the future.

The link between the private company and its “sponsor(s)” could be transparent or opaque. If the private company is not overtly linked to its “sponsor(s)” it could also serve as a “straw man”.

UNION ExCo position paper – Principle of Prohibition of Double Patenting before the European Patent Office

I. Introduction

UNION is an Association of practitioners in the field of Intellectual Property, that is of individuals whose principal professional occupation is concerned with Patents, Trade Marks or Designs and related questions and who carry on their profession independently or as employees. UNION is a private, free, international Association which is not dependent on any National or International Authority: it approves its own members, in accordance with its Statutes, in total independence, and likewise decides on its own activities and its own budget. It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improve-

ment of professional and personal understanding between European Practitioners in the Intellectual Property field in different countries and different branches of the profession.

In the years after its foundation in 1961, UNION was one of the organisations which participated most actively in the preparations for the European Patent System. Since that time it has continuously pursued its activities in the Patent field, particularly in arranging Round-Table discussions on current Patent problems. It has contributed prominently to the debate on the application of the Patent System to Biotechnological Inventions. In addition it has dedicated its activities to other areas of Intellectual Property in Europe, especially the harmonisation of Trade Mark and Design Laws as well as the Community Trade Mark and Community

Design. It has taken the initiative in bringing forward discussions of the existing and newly created Utility Model or Short Term Patent Laws in numerous European countries and raising the question whether these laws should be harmonised or whether a European Utility Model should be created.

UNION maintains close contacts with International Authorities such as WIPO (The World Industrial Property Organisation) and the Commission of the European Union, and it is invited to their consultations and discussions. It participates regularly as a non-governmental organisation with observer status at International Conferences.

II. The legal context

European patent practitioners have been recently confronted with the discussion of double patenting, i.e. claiming for two patents for the same invention with identical priority date and in the name of one single applicant. This situation typically arises in the context of divisional applications which generally have the same priority date as their parent. In other events, the issue of double patenting may arise if an application claims priority of a European application which has already led to a granted patent. This is not exceptional as the European Patent Convention (EPC) – in contrast to e.g. the German Patent Act – does not provide for a domestic priority wherein the priority application automatically is deemed to be withdrawn.

The Guidelines for Examination in the European Patent Office valid until June 2012 contain two passages relating to double patenting which take account of the decisions G 1/05 and G 1/06 of the Enlarged Board of Appeal (EBA). In these decisions the EBA confirmed the principle that an applicant in possession of a patent is not entitled to a grant of a further patent for the same subject-matter. The EBA reasoned that “an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses a granted patent therefor”. However the Guidelines are not legally binding and since the EPC itself does not provide for a clear legal basis for the prohibition of double patenting, it has been up to the Boards of Appeal to find some general principles for dealing with applications which have been refused by the Examining Division on the basis of a double patenting objection.

The Boards of Appeal have been for the first time confronted with the question of double patenting in the past decade. T 587/98 issued on November 20, 2002 discussed the problem arising from a divisional application having wider claims than the main claim of its granted parent. The Board concluded that it was a well acknowledged principle in the contracting states that double patenting was not allowable. Referring to Article 125 EPC which deals with general principles in the contracting states, the Board refused the divisional application. Although Article 125 EPC appeared not to be directly applicable since it aims at applying principles

of *procedural* law generally recognized in the Contracting States in the absence of corresponding provisions in the EPC, the Board concluded that double patenting also comprises procedural aspects.

T 307/03 issued on July 3, 2007 did not follow the interpretation of Article 125 EPC in T 587/98 but led to further uncertainty about the prohibition of double protection under the EPC. Similar to T 587/98, T 307/03 had to decide on a divisional application wherein its parent application has been already granted. In this case the divisional has been refused on the basis of Article 60(1) EPC which reads “*The right to a European patent shall belong to the inventor or its successor in title*”. The Board deduced “... *that under the EPC the principle of prohibition of double patenting applies and that the inventor (or its successor in title) has a right to the grant of one and only one patent from the European Patent Office for a particular invention as defined in a particular claim.*”

T 307/03 gave two different definitions of double patenting. Under point 2.3 of the reasons the Board mentioned “... *two or more identical patents with **the same claims** and the same priority dates ...*”

In reasons 2.1 it has been found that “... *the European Patent Office is entitled to refuse to grant a further patent to the inventor (or his successor in title) **for the subject-matter** for which he has already been granted a patent.*” This definition has been strongly criticized because it contains cases wherein the application under decision contains any part of the subject matter of the granted patent.

Both decisions, T 587/98 and T 307/03, decided that double patenting should be prohibited in the case of two main claims having essentially the same subject matter. However, after T 307/03 it has been unclear whether other constellations may lead to a refusal of one application. Based on the definition of double patenting given in reasons 2.1 of T 307/03 it appeared that a refusal may also be rectified, for example in a parent-divisional combination, if

a. the main claim of the divisional is fully encompassed by the claim of the parent and vice versa

or

b. the claims of the divisional and the parent partially overlap.

In an obiter dictum the decisions G 1/05 and G 1/06 of the Enlarged Board of Appeal argued that the absence of a legitimate interest gives a reason for the prohibition of double patenting. Referring to these decisions, T 1423/07 shows that the case law departs from the conclusions of T 307/03.

T 1423/07 had not to deal with a divisional-parent constellation but had to decide whether a refusal on the basis of a double patenting objection has been rectified if the application under appeal claims priority of a European patent application which already led to a European patent. In particular, the Examining Division refused the application under Appeal since according to the Guidelines of Examination two European patents in the name of the same applicant must not contain claims of identical scope.

The Board concluded that the passage in the Guidelines upon which the refusal has been based makes reference to Article 125 EPC and thus the question to be answered is whether a European application may be refused for double patenting on the basis of that provision. From the wording of Article 125 EPC the Board evaluates that the following criteria must be met to rectify a refusal:

- a. it must be a matter of procedural law;
- b. the principles of general law invoked must be generally recognized in the Contracting States;
- c. there must be an absence of procedural provisions in the EPC.

Referring to above mentioned T 587/98 the Board concluded that double patenting comprises procedural aspects and thus criterion (a) has been met.

As to criterion (b) the Board considered national provisions concerning double patenting and summarized that there is a general principle of law generally recognized in the Contracting States for a prohibition of double patenting in existence of a granted national patent and a granted European Patent. However, this does not provide a basis for refusing a European application in the pre-grant stage.

In the present case, the application under Appeal claims priority from a European patent. According to Article 63(1) EPC *"the term of the European patent shall be 20 years from the date of filing the application"*. Because the 20-year term is calculated from the filing date instead of the priority date, the applicant has a legitimate interest in the grant of the later application. Consequently, the Board concludes that the German case law and its application via Article 125 EPC is not relevant.

Since criterion (b) is not met, the Board came to the conclusion that Article 125 EPC is not applicable for refusing a European application for the reason of double patenting.

T 1423/07 concluded that the EPC does not provide a basis for a double patenting objection and a pre-grant refusal of an application in this context. Moreover, it can be gathered from the decision that double patenting can arise only if the subject matter of the main claim of the application under examination and main claim of the granted patent is essentially identical.

Although T 1423/07 clarified the definition of double patenting and in particular refrained from the broad definition given in T 307/03, its conclusions have been applicable only in the case of an application claiming priority from an earlier granted European patent. Explicitly, the Board in T 1423/07 stated that a referral of the case to the Enlarged Board of Appeal is not necessary since the present case does not deal with a divisional-parent constellation as the decisions G 1/05 and G 1/06 do and thus is not in contradiction with these.

III. Position of UNION

UNION acknowledges that a fair patent system has to balance the interest of the public in legal security and the interest of the applicant in adequate protection for an invention.

The EPC was not drafted to prohibit double patenting. Art. 139 EPC concerns the post grant relationship of European patents and national patents. Art. 54(3) EPC prevents patents with the same protection, by different applicants. Consequently, the drafters were aware of the double patenting problem, but apparently choose not to include any regulations in the EPC. Moreover, the comparison of the claims to establish double patenting involves a determination of the scope of said claims if an overlap is considered as double patenting. The determination of the scope of a claim, however, should be left to national courts.

Therefore, it is the position of UNION to restrict the prohibition of double patenting on the basis of a lack of legitimate interest to clear cases when a pending application and a granted patent of the same effective date both filed by the same applicant claim the identical subject matter.

Consequently, the principle of prohibition of double patenting should not be applied, if the subject matter of the claims of the pending application and the granted patent differ such that the claims confer a different scope of protection. Examples of such allowable constellations:

- The claims of a divisional application are directed to the general teaching that completely encompass the claims of the granted parent patent directed to a preferred embodiment, i.e. claim 1 of the divisional application for example recites fixation means and claim 1 of the granted parent patent recites a screw instead.
- The claims of a divisional application and the claims of a granted parent patent confer a partially overlapping scope, i.e. claim 1 of the divisional application and claim 1 of the granted parent patent are the same except e.g. for the nail claimed in the divisional application and the screw claimed in the granted parent patent.

The amended Guidelines for Examination in the European Patent Office effective as of June 2012 do not clearly enough restrict the prohibition of double patenting to identical claims.

While the amended Guidelines appear to exclude the above exemplified constellations from the prohibition of double patenting, the Guidelines also require the claims to be *quite distinct* to not apply the principle of prohibition of double patenting. This formulation introduces an unnecessary ambiguity that should be avoided by the deletion of the word "quite".

It is the position of UNION that the identical double patenting regime should be applied to the pre-grant stage and the rare cases of amendments in an opposition or limitation proceedings leading to two identical patents. As in the pre-grant stage, any differences between

the claims of the opposed patent and the claims the further granted patent of the same applicant that result in a different scope of protection establish a legitimate interest to obtain two patents and should not be objected.

It is the position of UNION that the identical double patenting regime before the EPO should not affect national law. Another interpretation of the principle of the prohibition of double patenting should be possible that goes beyond the exclusion of identical claims for example in cases of a minor difference of the scope of protection of two European patents. As the double patenting regime is restricted to two European patents, the co-existence of a national patent and a European patent which is allowed in some member states such as Austria, Denmark and Finland is likewise not affected.

In conclusion, the restriction of the prohibition of double patenting to crystal clear cases of claimed identical subject matter is believed to be a good and fair

balance between the patentee's interest in adequate protection for an invention and the public interest in legal security:

The patentee is given a maximum degree of freedom to change the claims and to establish a legitimate interest because any minor difference in the scope is sufficient to overcome a double patenting objection. Legal security for the public is obtained because the examination of double patenting does not involve an assessment of the scope of a claim but is confined to a comparison of the subject matter of the claims of the pending application and the granted patent, respectively the subject matter of the claims of the granted patents which is similar to a novelty examination.

On Behalf of the UNION ExCo
The Patents Commission of UNION
The President
J. Kilchert

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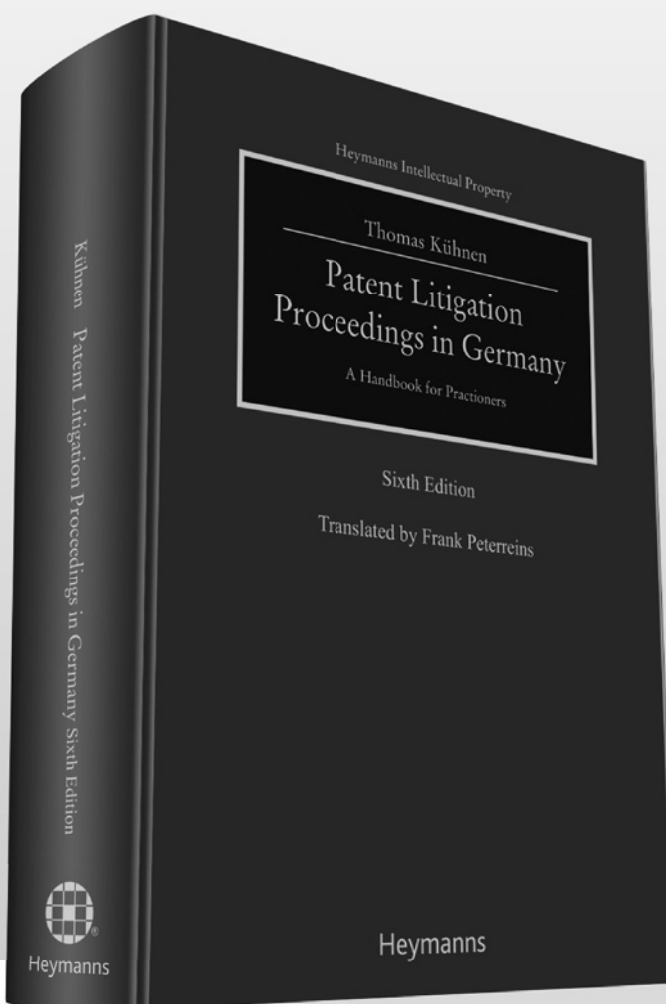
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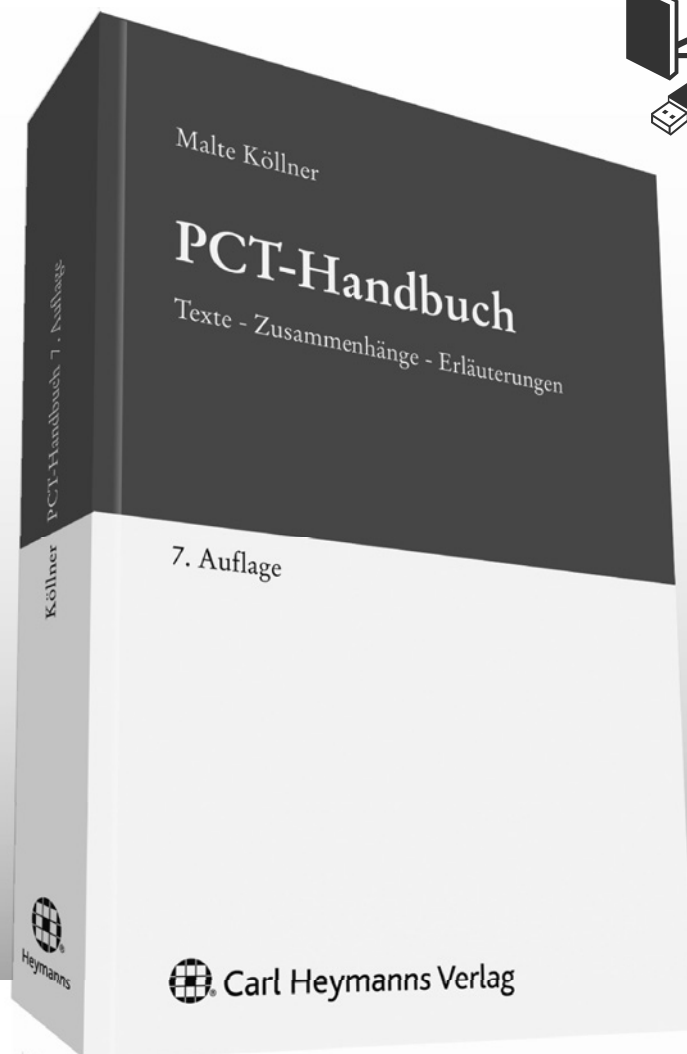
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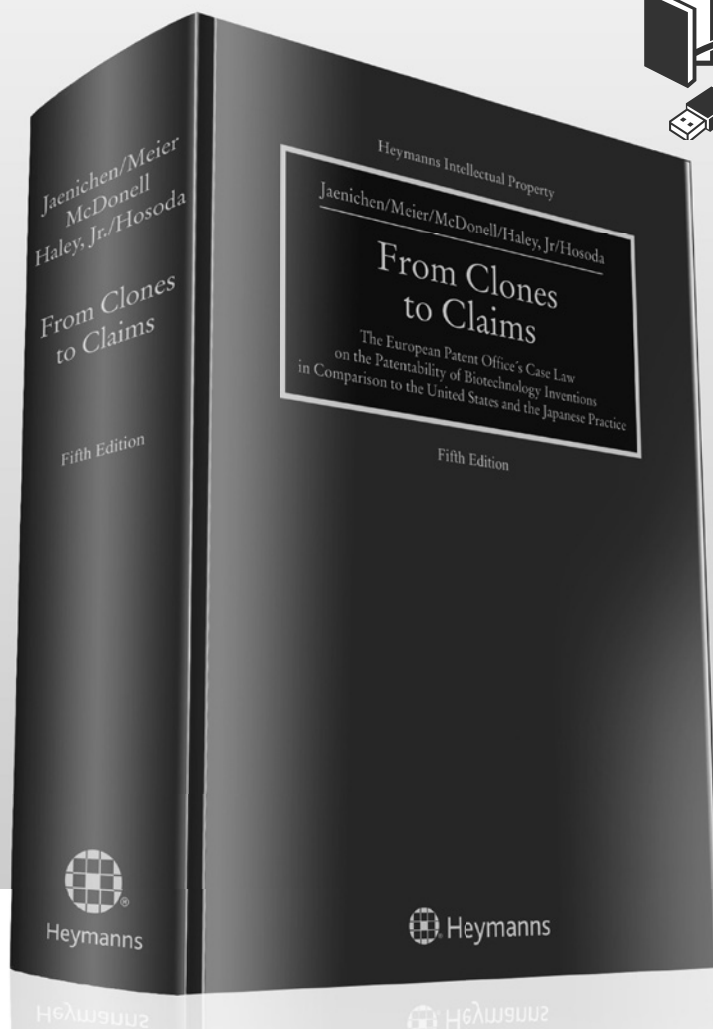
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