

Institut der beim Europäischen
Patentamt zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
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35th Anniversary of the *epi*

T. Johnson (GB)

The next *epi* Council meeting in Vienna in April will be an important and celebratory one, marking as it will the 35th Anniversary of our Institute.

As members will know our Institute became fully operative in 1978 when our partner, the European Patent Organisation, opened its doors for business. As members will also know, 1978 marked the culmination of many years of preparation for both the Institute and the EPO.

A lot has happened in the world of the *epi* in the last 35 years, but one thing is certain, the years have flown by! Our Institute can I believe be confident that it has made a significant contribution to the patent system in Europe over the 35 year period, and is I am sure ready for challenges ahead.

Without being complacent, however, I think that the Institute can rightfully take pause and enjoy this Anniversary Year.

Editorial

T. Johnson (GB)

After a long gestation and a seemingly difficult birth, the European Unitary Patent (UP) and Unified Patent Court (UPC) are with us (the UPC being due to be signed on 19th February, after this editorial goes to press). Most babies give a good yell on seeing the light of day, we may have to wait until about 2015 for the first yell of the UP baby, the date when the two systems are expected to commence their journey in the IP world. However, the EPO, national offices and our members are no doubt poring over the respective UP and UPC texts as we expect that they will profoundly affect the way patent protection is sought in Europe in the future. Applicants will no doubt be asking myriads of questions of their advisers. Questions such as "should we opt in or opt out?" "What 'mix' of EPCs and UPs should we use in our filing strategies?" "What are the renewal fees for UPs?" "What is the effect of Article 5 UP (which defines infringement according to national law)?" are some which will need to be answered. So, a lot to consider.

There is also a political dimension. The *epi* rightly avoids general politics, perhaps a good thing, as, as President Obama said in 2004, "Everyone knows politics is a contact sport".

However, we cannot escape the impact of politics. The same President Obama in his recent State of the Union address 2013 mentioned investment in ideas which surely means that patents will come into play to protect those ideas. For example he said "if we (*ed.-the USA*) want to make the best products, we also have to invest in the best ideas. Every dollar we invested to map the human genome returned 140 dollars to our economy". Later on in the address he said "... we should remember that today's world presents not only dangers, but opportunities. To boost American exports, support American jobs, and level the playing field in the growing markets of Asia, we intend to complete negotiations on a Trans-Pacific Partnership. And tonight, I am announcing that we will launch talks on a comprehensive Transatlantic Trade and Investment Partnership with the European Union because trade that is fair and free across the Atlantic supports millions of good-paying American jobs".

We are led to concur, and to reflect that by analogy such "fair and free" trade across the Atlantic ought to be good for EU jobs too.

Europe should remember that the UP and UPC are not solely for the benefit of European applicants. Patents are indeed tied up with politics.

Report of the Committee on Biotechnological Inventions

A. De Clercq (Chair); S. Wright (Secretary)

This report mainly summarizes the discussion that took place at last yearly *epi* Biotech Committee Meeting held on 5 November 2012 in Munich as well as some more recent matters.

The following issues were discussed at the committee meeting of 5 November 2012:

Stem Cells

The EPO seems to have a new policy on stem cell patenting, but this is very recent, and is informal. It is not presented in the Guidelines for Examination, nor is it likely to be. The policy appears to have been implemented at the beginning of September, and has been communicated by various people at the EPO giving lectures, in particular Aliki Nichogiannopoulou. The EPO has, to a significant extent, followed the CJEU Brüstle decision. The previous policy of there being a threshold in 2003, depending on whether stem cells were deposited or not, seems to have been scrapped. There might, though, be some room for manoeuvre over a new threshold date, 10/01/2008, concerning the publication of the single blastomere biopsy process (SBB). It appears that applications filed after 2008 might be patentable, because then applicants can argue that they did not need to destroy an embryo because of the SBB technique.

Of course, we still await the result of the German Court (since now received).

We are pleased to see that Aliki's talk suggested that culture media and apparatus for use with stem cells appear to be patentable (even if that use is exclusive for stem cells, and the description does not mention other types of cells) as well as iPS technology.

This new practice was also discussed with the EPO directors the day after the Committee meeting at the yearly meeting with the EPO Biotech Directors on November 6, 2012. Minutes hereof will be published in *epi* information.

Sequence Listings

We continue to press the EPO to allow the electronic filing of sequence listings, on PCT applications that have been filed online. This seems to be an anomaly or gap in the EPO's online services.

Some members reported that the EPO is asking for sequence listings, even after they have completed a search. For example, one member had agreed with the Examiner to file a sequence listing as he had inserted dependent claims referring a specific sequence (it was an Affymetrix commercially available probe). The EPO had issued their standard notice requesting a sequence listing, and additionally demanding €200.

The EPO's policy now is to demand sequence listings whenever a publicly available sequence is mentioned in the claims. This places applicants in an almost impossible position, because when filing a listing one has to warrant that no matter has been added. However, that is impossible if the specification does not include the actual sequence itself. This is a growing problem, and we are suspicious that the EPO is building up their own database of sequences which they may then be able to sell access to commercially.

Disunity

We continue to tackle the EPO concerning disunity. The problem is that we don't know whether the EPO will find a novelty destroying document, which then fragments the independent claims. It is very unpredictable as to how the EPO will divide the subject matter in that situation.

On one case the EPO divided the subject matter (which related to purification of a protein) into twelve different inventions, and the applicant wanted to pursue subject matter which the Examiner thought was arguably Invention 2 and so could not be prosecuted. It was unclear

Nächster Redaktions-schluss für *epi* Information

Informieren Sie bitte den Redaktions-ausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **13. Mai 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 **May 13, 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 **13 mai 2013**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

whether this and other Examiners realised the consequences of their actions, and the cost of filing a divisional. They may not realise it is actually cheaper for an applicant to fight before the Examining Division, have Oral Proceedings and possibly also take the case to appeal, rather than file a divisional application.

The Biotech Committee would like to present a paper on this by the next Council meeting in April 2013.

Deposits and the Expert Solution

The *epi* had been informally contacted by the EPO suggesting whether applicants wanted to continue with the EPO maintaining a list of experts, which apparently has not been used for a while, and rarely consulted. The *epi* doesn't know how often applicants tick the expert solution on the form, and how often samples are requested from experts in practice. We will continue to review the matter, and feed back to the EPO.

Patentability of Plants and Referral to the EBA (G12/12)

The need of filing an amicus brief by *epi* was discussed at the meeting. However, since the meeting, the patentee had written to the EPO. They had not withdrawn their appeal, but instead argued that the EBA should no longer consider the matter since the opponent had withdrawn their appeal, and in view of the *reformatio in peius* principle. The matter was further discussed within *epi*, and in the end it was decided not to file an amicus brief at this stage of the proceedings.

New EPO Rules

It was reported that the *epi* is trying to persuade the EPO to reintroduce Rule 164 EPC, which will allow additional search fees to be paid when a disunity objection is raised in the Search Report.

National Decisions

In the UK, it was reported that the Supreme Court (previously House of Lords) had accepted a relatively low standard for industrial applicability in the *HGS v Lilly* case.

Separately, a UK Examiner had issued a refusal on a UK patent application concerning stem cells, the invention relating to parthenogenesis.

Medical Use Claims

Several members reported that the EPO was getting rather fussy with the exact wording of dependent claims in the EPC 2000 format. The EPO now insisted that the product be stated "for use", to ensure clarity, and that the dependent claims wouldn't be interpreted as being anything other than purpose limited use claims.

Membership

At the Council meeting in Hamburg, barely a week after the *epi* Biotech Committee meeting, three new members Ms Zeljka Brkic (RS), Ms Diana Sinojmeri (AL) and Mr Francisco Bernardo Noriega (ES) were admitted.

Other Matters

One member reported that he had received third party observations from an Indian NGO, arguing that certain uses of plant extracts were not novel over Indian traditional knowledge, citing documents in the ancient language Sanskrit.

It was also reported that the Italian law on biological material source declaration applies to national Italian applications, and not granted European applications which are then validated in Italy.

Recent matters (after last Committee Meeting)

The *epi* filed an amicus brief in January 2013 in the US Myriad case before the US Supreme Court supporting a previous declaration of Prof. Strauss filed in this case and supporting the patentability of human genes.

The *epi* filed Third Party Observations in December 2012 in the Brüstle EP patent opposition case requesting the Opposition Division to consider also the German Brüstle decision of the BGH relating to the equivalent German Brüstle patent. The EPO has in the meanwhile postponed the oral proceedings until April 2013.

Information about
epi membership and membership subscription
or
Rules governing payment of the *epi* annual membership fee
is available on the *epi* website www.patentepi.com

Minutes of EPO/*epi* Meeting (held on 6 November 2012 at the EPO, Room BT7, Bayerstrasse 115, Munich)

A. De Clercq (Chair); S. Wright (Secretary)

In attendance:

Thanos Stamatopoulos (AS, Principal Director Biotechnology)
Enrique Molina Galan (EMG, dir. 1212, The Hague)
Francisco Fernandez y Brañas (FFB, dir. 1222, The Hague)
Sönke Holtorf (SH, dir. 1223, The Hague)
Victor Kaas (VK, dir. 2401, Munich)
Ulrich Thiele (UT, dir. 2402, Munich)
Siobhán Yeats (SY, dir. 2403, Munich)
Maria Fotaki (MF, dir. 2405, Munich)
Aliko Nichogiannopoulou (AN, dir. 2406, Munich)

Bernardo Noriega, Francisco (ES)
Capasso, Olga (IT)
De Clercq, Ann (BE)
Desaix, Anne (FR)
Jaenichen, Hans-Rainer (DE)
Hally, Anna-Louse (IE)
Jonsson, Thorlakur (IS)
Keller, Günter (DE)
Knuth-Lehtola, Sisko (FI)
Mattsson, Niklas (SE)
Pethö, Arpad (HU)
Schouboe, Anne (DK)
Thoresen, Liv (NO)
Wächter, Dieter (CH)
Wright, Simon (GB)
Heike Vogelsang-Wenke (liaison member of EPPC) (DE)

Introduction

Mr Stamatopoulos opened the meeting and welcomed all present. In addition to wanting such meetings to continue, he said that the EPO aims to give the best possible service, as well as becoming more efficient and better at its job.

1. Stem cells, and developments since the CJEU decision C-34/10.

With respect to the policy followed by the EPO when assessing the patentability of subject-matter implying the use of human embryonic stem cells (hES cells), the EPO examiners follow the instructions given in part G-II, 5.3 (iii) of the Guidelines which came into force on June 2013. For claims relating to an invention implying destruction of a human embryo, the revised guidelines specify that the point in time at which the destruction takes place is irrelevant. This reflects the approach taken by CJEU judgement C34/10, which went further than the leading WARF decision G2/06 by looking at the

complete history of any embryo destruction, regardless of how many steps before the claimed invention the destruction occurred.

This will not inevitably lead to a refusal of all files relating to hES cells since methods for providing hES cells which do not involve the destruction of a human embryo have now been developed, such as the single blastomer biopsy (SBB) method, published in 2008. While the EPO cannot currently predict the outcome of every file, it is considering various potential scenarios. In any case, where the essence of the claimed invention relies on the direct provision of hES cells from human embryos, the application will be considered to contravene Rule 28(c). The situation may be different where this is not the case, and it can be considered that the skilled person with knowledge of the state of the art could, at the filing date of the application, reproduce the invention by obtaining stem cells from sources that did not involve the destruction of human embryos, in line with decision G2/06 and the Guidelines G-II, 5.3(iii). Human ES cell lines which were obtained without the destruction of an embryo would be such a source. In this case, it could reasonably be argued that at least one way to reproduce the invention has been described which does not contravene Rule 28(c) EPC.

Concerning the SBB method referred to above, it was noted that a similar method was already published in 2006. However, that method involved a step of co-cultivation with cells obtained by destruction of an embryo.

Several *epi* members confirmed that they had received Examination Communications from the EPO recently on stem cell cases in which the above approach was followed.

The question of whether EU law is binding on the EPO will need to be assessed by DG3.

No official publication from the EPO is planned to take place on these matters.

2. Plant cases and G 2/12

Plant cases relating to non-GMO bred plants are not being systematically stayed for the moment. There are only a few applications directed to plants defined as products of classical breeding. Opinion is divided on how the EBA can proceed, in the light of recent events, and in particular the latest submission by the Patentee. He has not withdrawn his appeal, but argued that the EBA should no longer hear the case. It appears though that if the Patentee had indeed withdrawn his appeal, then the case would no longer exist.

Note that in the Broccoli case the Patentee has stated that he will only agree to submit questions to the EBA if G2/12 is decided. However, even if G2/12 dies, the issue will probably come up again with other pending cases. The current membership of the EBA has no biotech Directors

3. Deposit of biological material and the expert solution (Rule 32 EPC)

The EPO said the list of experts dates back to 1992. Apparently it has not been used very much, and it came to light as a result of someone suggesting that there was no expert for plants. Apparently there have been four cases where the requester wanted a sample, but didn't use the forms. The EPO had done some research, back to 1986, and could not find other examples of the list being used. This issue had been raised in the SACEPO meeting earlier this year. The *epi* has been asked for feedback, which they will provide. Initially the *epi* would like the EPO to keep the expert list, and both attorneys and applicants are likely to want to keep the system as it currently stands. However, the EPO considers that since the list has in practice hardly ever been used, it should be sufficient for the parties concerned to agree on an expert should there be a need.

One *epi* member said that we want to keep the list so that we know that the deposit will be in safe hands. The *epi* believes it can find evidence of samples being released to non-experts. Many Applicants do indeed cross the box on the deposits form, requesting expert solution, but we do not have numbers. The *epi* was encouraged to provide feedback to SACEPO and to the EPO Directors.

4. Admissibility of Claim Requests (and the EPO's late filing policy)

One *epi* member noted that there had been some restrictions on new claim requests on the day of the Oral Proceedings (even to the extent that deletion of claims was not allowed). The question is how late one could submit claim requests before the Examining Division, noting that Rule 112 is potentially not a strict deadline. The Board of Appeal however is more rigorous, and has indicated a distaste for divergent claim requests (they want convergent ones, whatever that means). Even on *ex parte* cases the Board had not exercised their discretion, for reasons of procedural economy. They wanted no "branching off" of claim requests that go in a different direction. It was noted that one particular biotech board can be particularly strict on convergence.

The *epi* pointed out though that often one does not know which arguments will be accepted, or not, and therefore different ways of dealing with the multiple issues can lead to claim request which do not immediately appear to be nested. The key for *inter partes* proceedings is that neither party should be surprised.

The *epi* said that it was very difficult to predict in advance how the Opposition Division, or the Board of Appeal will react. Also, it is not always clear whether the Opponent would be able to submit new arguments or documents at a late stage. The EPO, referring to first-instance proceedings, said that it is not easy to predict how some cases will develop, and so it may be better, for applicants in general, for the EPO to retain some leeway and discretion. If there were guidelines on what will, and will not, be allowed, then it was feared that this would inevitably result in greater strictness. One *epi* member wondered whether the EPO could draw up some basic principles for Oral Proceedings. Note that the Board of Appeal is less likely to allow requests withdrawn before the Opposition Division, so parties might submit many auxiliary requests, in the fear that if they do not submit them in the first instance, they won't be allowed before the Board. The EPO confirmed that Examiners have not been told to be tougher.

5. Added Matter and Article 123(2) EPC

The *epi* commented that the EPO is now seeing lists when arguably there aren't any. The problem now seems to be picking a combination from two or more lists. For EP cases derived from a PCT, for example from the US, there are no multiple dependencies (this is because the US PTO will not search claims that are multiply dependent). So arguably there is no explicit, or verbatim, basis for a combination, although a person skilled in the art would recognise that combination is in fact disclosed (at least implicitly).

There have been a few decisions which have been particularly strict recently, and the *epi* is concerned that the Boards are becoming increasingly strict on this issue. There have been a couple of rogue decisions which have not been well regarded, and would seem to represent a worrying trend. The Directors said that decisions are regularly reviewed and that examiners are given guidance as to which decisions are to be followed and which are not. Examiners have to follow EBA decisions, which are binding, but not necessarily individual TBA decisions, and they can ignore a decision if the facts are truly different.

6. Prior Art Objections when the Art is a machine translation of a JP or CN Document

The new EPO Guidelines (Part G, Chapter IV-4, items 4. and 4.1; and Part B, Chapter X, item 9.1.3) deal with documents in non-official languages (also see Part B, Chapter 10, Section 9.3). The EPO should cite the English language abstract in the search report, and not the machine translation. The examiner should attach an available machine translation of the document to the search opinion. He/she can refer to this translation in the Examination Report. One *epi* member said that he had received a prior art document in Polish, and had received

the translation barely a week before the Oral Proceedings before the Examining Division.

7. Backlog

The *epi* notes that there are still big backlogs in the biotech area. There are often delays of 4 or 5 years. The *epi* said that when they have asked when the next Examination Report is likely to issue, the reply can be that they may have to wait for a year. The EPO said that search and examination stocks are low, with a decreasing trend in biotechnology, so delays are probably due to individual cases rather than to the general situation. Special attention is being paid to timeliness in opposition proceedings, especially in the light of the EU pharma sector enquiry. There is now improved file monitoring, and in the EPO's internal system old files show up in red. If they are highlighted, then the Examiner can't choose another case (in theory).

The Biotech Directors would, though, welcome some more work. It was again pointed out that Applicants can always request PACE. How quickly a case goes to grant obviously depends on the Examiner, and the EPO tries to smooth out processing of the too recent and too old cases.

The *epi* said that they would like to have a first and second Office Action before the 2 year divisional deadline expires. Last year the EPO introduced a semi-automatic system to deal with requests regarding when the applicant will get the next examination report.

8. Pharmacogenomics cases

The EPO noted that the minutes from last year's *epi*/EPO meeting had made its way to the IPKat blog. There was perhaps some misunderstanding here. After the IPKat publication, two attorneys from a pharmaceutical company approached the Directors. If large patient groups have been treated, e.g. if large clinical studies have been carried out, it is considered to be beyond reasonable doubt (greater than 95 % probability) that a patient with a particular genotype, and hence a claimed patient group, has already been treated. In that case there may be a novelty objection against a 2nd medical use claim characterized only by the patient population (the active compound and the disease to be treated being known from the prior art). If, however, the determination of the patient's genotype is included as an active step in the 2nd medical use claim this will overcome the EPO's objection. Some applicants are already doing this. It appears, though, that there is no directly relevant case law from the Boards of Appeal. The EPO will be monitoring the BoA Decisions upcoming in this field in order to adapt its examination policy.

9. Voluntary Amendments to the Druckexemplar made by Examiners

The revised Guidelines specify what Examiners are allowed to do. An *epi* member was asked if his standard clause in response to Rule 71(3) Communications (asking the Examiners not to make any amendments without prior permission) was still valid (and he was confirmed that it is). Of course, we now have a new Rule 71(3) procedure. Attorneys can check the list of situations in the Guidelines and refer back to the EPO if the Examiner seems to have overstepped the mark. Examiners will usually be allowed to change the formal wording of dependent claims for EPC 2000 second medical use claims under the new practice.

10. Sequence Listings

The Legal Department has drafted new guidelines. The listings are still required on divisionals, although the *epi* does not see the logic why. The EPO needs to add sequences to databases so that they can properly search for the prior art. There may be some new instructions to be drafted with the Legal Department, and the EPO will want input, and streamline the process. The *epi* gave comments on the public consultation earlier this year on the new Standard 26. This new standard will be presented to WIPO in 2013. There is an ongoing consultation process through SACEPO. The EPO wants to move to an online system for PCT cases, via the IT roadmap (which is the umbrella project for several different improvement tools). Bizarrely, it is still not possible to file sequence listings online at the EPO even on a PCT application which has been filed online. The *epi* asked that Examiners provide their internal sequence alignments when they are, for example, objecting to lack of novelty based on a prior art sequence. The EPO said that they will try and make it easier for Examiners to be able to do this.

Currently the sequences submitted online are published as a pdf (but not txt, so it is not searchable or easily re-usable) but it is hoped that this will change soon. This will allow Applicants, for example, to use previously submitted sequence listings (such as on a parent case) on a divisional application.

11. Medical Use Claims

The EPO said that they will not grant a divisional, with EPC 2000 style claims, where the parent has equivalent Swiss Style claims. Three cases have been refused on this basis, citing double patenting. All three cases have been appealed; one is now before Board 334, and the other two before Board 338. Whether this constitutes double patenting is unclear, as is whether the two types of claims are of different scope.

12. Third Party Observations (TPOs)

There has been an increase in these. The number filed in 2012 was roughly double the number filed in 2006. Interestingly though, in the biotech field the number of TPOs have gone up threefold. The biotech group has almost 40 % of all Observations.

One *epi* member noted that on one of his cases he had TPOs filed after every reply, even after replying to the Rule 71(3), notice whereupon grant was rescinded. On one case they were filed only a day before the Oral Proceedings. About 35 % of cases with TPOs are opposed (data from 2009).

13. Disunity Practice

The *epi* said that the two year divisional deadline was still making it very difficult for Applicants, in particular in the Biotech area. Often we don't get a reply from the Examining Division before this deadline expires.

The *epi* asked for more logic on disunity matters. The EPO said that they try and group inventions together where at all possible. The EPO encourages Applicants to say why sequences are linked, for example mentioning in the specification why they are related. The EPO is seriously considering putting forward a proposal to reintroduced Rule 164, possibly before SACEPO.

Report of the Online Communications Committee (OCC)

A. Virkkala (FI)
Chair

The OCC committee did not meet but discussed various matters via e-mail. The committee prepared an agenda for a joint meeting with EPO personnel in charge of applicant-to-EPO communications. This meeting will take place in early March 2013.

Members of the OCC have also cooperated with members of other committees regarding various projects, such as a planned pilot for online voting concerning joining of electorates in Sweden and, possibly, Finland.

Report of the European Practice Committee (EPPC)

F. Leyder (BE)
Chair

This report completed on 17.02.2013 covers the period since my previous report dated 07.11.2012.

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.

1. EPPC meeting (06.11.2012)

The committee met in Munich. Thanks to the valuable (and much valued) support of the Legal Advisor, a draft report (attached) was prepared and circulated to the committee members within weeks. It will be submitted for approval at the next meeting, still to be planned (before the summer break).

Following a discussion on Rule 36 during the meeting, Ms Leissler-Gerstl and Messrs Mercer, Lampe and Leyder

prepared a position paper that was tabled and unanimously accepted at the Council meeting four days later. In a nutshell, it proposes reverting to the previous version of paragraph 1.

UNITARY PATENT

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

Both Regulations were finally adopted, and published on 31.12.2012:

- Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, OJ L361, 31.12.2012, pages 1-8;
- Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, OJ L361, 31.12.2012, pages 89-92.

They will apply from 01.01.2014 or the date of entry into force of the Agreement on a Unified Patent Court, whichever is the later, and then only in those participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration.

The articles formerly known as "Articles 6-8" have been moved as Articles 25 to 27 to the draft Agreement on a Unified Patent Court, the latest draft of which was published on 11.01.2013 as document 16351/12. Signature of the Agreement is planned on 19.02.2013 under the aegis of a Competitiveness Council meeting.

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

On 18.02.2013, our President will attend a conference organised by the European Commission in collaboration with the Irish presidency: "The unitary patent – a new tool for European innovators long overdue".

EPC

3. 134th AC meeting (11-12.12.2012)

The OJ 1/2013 contained a Report on the 134th meeting of the Administrative Council of the European Patent Organisation.

The President of the Office has been authorised to negotiate a validation agreement with Georgia.

The Council also noted information provided by the Office on adjusting the system for search and examination fee refunds under Articles 9(1) and 11(b) of the Rules relating to Fees following Legal Board of Appeal decisions J 25/10 and J 9/10.¹

¹ In other words, these articles will not be amended.

4. 8th SACEPO/WPR meeting

The EPO has proposed 08.05.2013 and 17.05.2013 as possible meeting dates.

5. Public consultation on Rule 164 EPC

The sub-committee is drafting a paper.

6. Public consultation on the new online format of the OJ.

The sub-committee is drafting a paper.

EPO-epi LIAISON

7. Meetings with EPO Directors

The first meeting with the Directors in the field of Pure and Applied Chemistry (PAOC) was held on 15.01.2013 and was successful.

The first meeting with Directors in the field of computer-implemented inventions (CII) had to be postponed at the request of the EPO, and will now take place on 18.09.2013.

The next meeting I would like to organize would be in the field of polymers.

8. 13th Partnership for Quality meeting (17.01.2013)

The meetings are now chaired by Mr Förster. The following items were discussed:

1. Agenda and Minutes of the 12th PfQ meeting
Rapporteur: EPO (Chair)
2. A Metrics Framework for the PCT
Rapporteur: EPO (Mr. R. Rankin) [ppt]
3. Catalogue of Differing Practices (revised version)
Rapporteur: EPO (M. Schneider) [ppt]
4. Unity of Invention
Rapporteur: EPO (Mr J. Moser) [ppt]
5. Third-party Observations – Nature of EPO Replies
Rapporteur: *epi* (Ms M. Honkasalo)
6. Searches based on wrong claims
Rapporteur: *epi* (Ms M. Honkasalo)
7. Quality of search opinions & examination reports – How is it assessed by the EPO?
Rapporteur: *epi* (Ms M. Honkasalo)
8. Breadth of allowed claims and consistency of examination
Rapporteur: *epi* (Ms G. Leissler-Gerstl)

Any other business.

Action points.

Next meeting(s) of the PfQ

MSBA**9. 19th MSBA meeting (03.12.2012)**

The Vice-President DG3, who chaired the meeting, presented a report on developments in DG3. The following topics were then discussed:

- Use of laptops at oral proceedings.
- Postponement of oral proceedings.
- How to deal with “technical inventive step” on software/business methods when relevant to a biotech, or invention such as bioinformatics.
- Cross-over of case law from different technical areas.
- Article 123 EPC.
- Harmonisation between the practices of the Boards.
- Case management in proceedings before the Boards of Appeal, in particular in *inter partes* cases with substantial changes on appeal.
- Development in the patenting of diagnostic methods with a “surgical problem”.
- Structure and form of multiple sets of auxiliary requests.
- Oral proceedings starting at 2:00 pm.
- The Unified Patent Court: potential effect on the Boards of Appeal.

GUIDELINES**10. 3rd SACEPO/WPG meeting**

The Working Party on Guidelines met on 14.11.2012.

epi members are kindly reminded that suggestions for amendment of the Guidelines are welcome at any time (eppc@patentepi.com).

PCT**11. 6th Meeting of the PCT Working Group**

The meeting will be held in Geneva from 21 to 24.05.2013. *epi* is traditionally attending these meetings as observer. The documents from the PCT WG (including the draft report) will be available from the WIPO website at:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=28622

TRILATERAL**12. Trilateral User Day (15.11.2012)**

The day comprised a Trilateral Cooperation's 30th Anniversary Symposium in the morning followed in the afternoon by a Trilateral Offices and Users meeting. Some information is available on the Trilateral website (<http://www.trilateral.net/>).

MISCELLANEOUS

The EPO organized a web form filing user consultation workshop on 04.12.2012 at the EPO office in The Hague.

Report of the Harmonization Committee

F. Leyder (BE)
Secretary

This report completed on 17th February covers the period since my previous report dated 7th November 2012.

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

1. Treaty to facilitate Access to Published Works by Visually Impaired Persons and Persons with Print Disabilities

An extraordinary session of the WIPO General Assembly was 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”. *epi* was not represented. This was immediately followed by a meeting of the Preparatory Committee; a second one is planned on 22nd February 2013.

The Diplomatic Conference would be convened in Marrakech, Morocco, between 16th June and 30th June 2013, with the mandate to negotiate and adopt a treaty pursuant to the draft text. *epi* is on the list of non-governmental organizations that would receive an invitation to attend as observer.

All documents are or will be available on the WIPO website:

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

http://www.wipo.int/meetings/en/details.jsp?meeting_id=28442

http://www.wipo.int/meetings/en/details.jsp?meeting_id=28883

2. The Tegernsee process

A 144-page report of the fact finding exercise carried out by the “Tegernsee Experts’ Group” (a group of experts appointed by IP5, DE, FR, GB and The Tegernsee DK) has been published (it is available via the EPO website <http://www.epo.org/law-practice/consultation/ongoing/SPLH.html>).

The report focuses 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.

The “Tegernsee Experts’ Group” developed a joint questionnaire covering the four above-mentioned topics, for use in gathering stakeholder input on a range of related issues. The EPO added some questions, clearly identified as such.

epi has been invited to participate to a hearing of European Users organised by the EPO to discuss the issues raised in the questionnaire. The hearing will be held on Thursday 21st February 2013.

3. Meeting of the Harmonisation Committee

The committee met on 28th and 29th January, to re-evaluate the position of *epi* with regard to the Tegernsee report and the questionnaire, in the light of the position paper adopted in May 2006 (Decision 17 of the Council in Salzburg), to prepare the position of *epi* for the hearing.

At the time of writing this report, a series of draft position papers and response to the Questionnaire had been circulated to the Board members, but the President had not yet been in a position to conclude that they were approved.

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, first to the week of 11th to 15th March, then to 25th to 28th February 2013.

All documents are or will be available on the WIPO website:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=25026

The agenda is practically identical to that of the 18th session. It is noteworthy that the session has been shortened to four days.

Report of the Litigation Committee

A.Casalonga (FR)
Chair

1. Update on the Unitary Patent Court (UPC)

On December 12, 2012, the draft UPC was finally accepted together with the Regulation on the Unitary patent. This final decision was possible after a political compromise according to which the definition of infringement acts of the Unitary patent would be stated in the UPC Agreement while the regulation on the Unitary patent would refer to national laws which would in that case be replaced by the UPC Agreement.

A new version of the agreement incorporating this compromise was issued on January 11, 2013 with a complete renumbering of the articles of the previous draft.

The French and German versions of the Agreement were also issued.

The Article concerning representation (now Article 48) has not been changed: lawyers and European patent Attorneys with a specific qualification will have full right

of representation and may be assisted during oral hearings by “patent attorneys” (meaning National patent Attorneys as well as European Patent Attorneys).

Privilege is however only formally mentioned for the “Representatives” i.e. lawyers and European patent Attorneys with specific qualification.

This signature of the Agreement should occur before the end of February 2013 or at the beginning of March.

The 12th draft of the Rules of procedure dated 29 November, 2012 was issued on a confidential basis and should be open for public consultation shortly after signature of the Agreement.

A time period of two months will be given for presenting observations to the draft of Rules of Procedure.

The Litigation Committee is preparing a new position paper on the Rules of Procedure which, after agreement of the *epi* Board, will be sent as *epi* observations.

After signature of the UPC Agreement, the contracting Member states will have to ratify the Agreement. It is hoped that the Agreement together with the Unitary patent regulation could enter into force before June 2014, i. e. after ratification by at least 13 Member States, including France, Germany and United Kingdom.

In the meantime, the contracting Member States will have to decide and prepare local divisions and regional divisions for the first instance court.

2. Activities of the Litigation Committee

a/ A position paper on past damages before translation of a patent is under final preparation.

b/ A proposal for the future European Patent Litigation Certificate allowing European patent attorneys to represent before the UPC is under study.

Report of EPO Finances Committee

J. Boff (GB)
Chair

Collective reward for staff

CA/D17/12 awarded a collective bonus of €4000 for each full-time EPO staff member (subject to their full time presence at work in 2011). The justification offered for the bonus was that in recent years the EPO has regularly obtained IFRS operational surpluses and that to a great extent this represented the work and efforts of EPO staff.

This justification appears weak: –

- although performance related bonuses may be justifiable (with suitable safeguards) this is a single award with no safeguards other than having been a surprise bonus;
- the bonus represent on average >4 % of basic salary whereas planned productivity in search, examination, opposition, appeal and is shown as rising only 1.2 % from 2011-2012;
- whereas the operational result has been positive in recent years, the same is not true for the overall result;
- if the operational IFRS result is positive this could be considered as indicating that fees are too high;
- the high growth rate in renewal fees [both for granted patents and pending applications] offers far more explanation for a positive operating result than does improved productivity.

The reward is stated to be a one-off payment. It is to be hoped it does not set a precedent.

Refund of fees

It had been proposed to abolish certain fee refunds following decisions [J25/10 and J9/10]. Following representations it has instead been decided to amend Office systems to permit recordal of when search or examination commences.

Statistics

CA/F5/12 presented statistics showing a decline in European activity in 2011.

Although the figure described by the EPO as “European filings” increased by about 4 %, that comprises both European direct filings and PCT filings [wherever made].

The figure for “European applications” [European direct filings and PCT applications entering the regional phase] declined by about 4 %.

It should be considered whether these figures represent only current economic circumstances or whether they represent a long-term change in behaviour, with Europe declining in importance as a place to patent.

Recently there has been an EPO press release [<http://www.epo.org/news-issues/news/2013/20130117.html>] reporting a 5.7 % increase in numbers in 2012, but again referring to both European direct filings and PCT filings [wherever made]. It will be interesting, in due course, to look to the numbers behind the press release.

epi Tutors' Meeting in Berlin on September 18, 2012

M. Fromm (DE)
epi Secretariat

For the first time in seven years, *epi* organised a half-day tutors' meeting, in Berlin on September 18, 2012. Although the meeting had been announced at short notice, 23 *epi* tutors attended. The tutors were joined by members of the PQC "*epi* tutors and EQE candidates" working group, the PQC chairman, Mr Paolo Rambelli, *epi*'s Deputy Secretary General, Mr Michael Liebetanz, and the *epi* Secretariat education team.

The meeting started with introductory presentations from the PQC, the working group and the *epi* education team.

Some tutors then talked about their specialities and how they teach them:

Mr Johnny Schmidt – "*epi* tutorials"

Ms SirpaKuisma and Mr Casper Struve – "*epi* mock EQEs"

Mr Derek Jackson – "Pre-exam online course" and his cooperation with the EP Academy and the CEIPI for an online self-testing tool

Ms Anna Barlocchi – "Praktika Intern", in cooperation with the EP Academy

Ms Jasmin Jantsch – Seminar on "Introduction to the EQE" in cooperation with the EP Academy, and CEIPI, and the "*epi* tutorials"

Subsequently the tutors participated in workshops on:

- A tutor's education programme
- A mentor's programme for new *epi* tutors
- Tutees – Training programme, Guidance/Schedule

A member of the PQC working group led each workshop. The conclusions were presented to the tutors, and collected for consideration at the next working group meeting.

The third part of the meeting was an open discussion about the meeting, the workshops, and any other issue that the tutors considered important. The participants gave their suggestions for the next meeting.

After the meeting all participants attended a casual dinner. A successful and fruitful day came to an end with a delicious meal, good wine, and interesting discussions.

epi thanks all the tutors who contributed to this meeting.

We look forward to the next meeting, which is currently scheduled for Friday, June 28, 2013.

Educational events and contributions of *epi* tutors 2012

M. Fromm (DE)
epi Secretariat

Another very successful year for the education section of *epi* has come to an end. As in previous years, *epi* organised a series of seminars across Europe, summer and autumn tutorials, and a mock EQE, and our tutors contributed to several EPO projects.

I. Seminars

epi held 14 seminars in 2012. All but one of the seminars were organised with the European Patent Academy. The exception, on PCT, was co-organised with WIPO.

In the first half of 2012, *epi* organised seminars in Warsaw, Oslo, Helsinki and Istanbul. The topics ranged from "National law relating to the EPC", "EPC2DAY", and "Mock Oral Proceedings" to "EPO Procedures".

In the second half of 2012 *epi* seminars were mainly "Guidelines2DAY" seminars, in Milan, Copenhagen, Vienna, London, Madrid, Eindhoven, Helsinki and Istanbul. Those one-day events were presented by two EPO speakers – a lawyer and an examiner – and an intervening *epi* speaker. The participants greatly appreciated and enjoyed this format.

We expect to continue "Guidelines2DAY" seminars until June 2013. You can find further details regarding dates and venues on our website.

epi also arranged two paralegal seminars. One was on "Handbook of Quality Procedures before the EPO", in Munich, and the other was on "PCT", in Warsaw.

In total 826 people attended our 2012 seminars, including 444 *epi* members, and 134 *epi* students.

II. *epi* Summer and AutumnTutorials

The *epi* tutorials are EQE training events. They provide candidates with an opportunity to attempt papers A, B, C, and D, and then to send their answers to an experienced *epi* tutor, who will review them and discuss them with the candidate.

38 tutees enrolled in the 2012 summer and autumn tutorials, with 28 tutors providing feedback on 106 exam papers.

III. *epi* Mock EQEs

The mock EQE allows participants to attempt an EQE exam under exam conditions. Experienced *epi* tutors mark the papers. About one or two months after the exam the tutors meet small groups of participants to discuss the papers. Each participant receives personal feedback on his/her work.

As in previous years, we held the 2012 mock EQE in Helsinki, with 9 tutees taking part.

IV. Pre-examination online training course 2012/2013

epi and the European Patent Academy has jointly developed this course. It was aimed at students preparing for the 2013 pre-examination. In total 203 candidates enrolled, and 14 *epi* tutors contributed, by giving webinars and writing articles.

We are setting up a new online training course for the 2014 pre-examination. We expect registration for this to open in late summer 2013. You will be able to find

further information on the *epi* and EPO websites later in the year.

V. Candidate Support Programme (CSP)

CSP is a project jointly developed by the EPO, *epi* and CEIPI. It is intended to support candidates from EPC countries that have less than 5, or no EQE qualified professional representatives. It will last 5 years (exam years 2013-2017). Four *epi* tutors have acted as coaches for 16 candidates, from Norway, Poland and Turkey.

VI. Praktika Intern 2012

The European Patent Academy has successfully organised the Praktika Intern programme for a few years. In 2012 the European Patent Academy introduced a new 3 week course, for participants who have started professional training and plan to sit the EQE, or the pre-examination paper, within the next 3-4 years. The final week involved four *epi* tutors teaching claim drafting. Three courses were run, in The Hague, Berlin and Munich, and each was taught by a chemist and an electromechanical tutor. *epi* tutors will be participating in the 2013 Praktika Intern course.

epi thanks all the speakers and tutors who made our events so successful and effective. We also thank everyone who contributed to joint projects with the EPO and the European Patent Academy.

We are looking forward to a fruitful and interesting 2013!

Tutors wanted



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

Please volunteer by filling in the form available on the *epi* website (www.patentepi.com -> EQE and Training).

For any further queries, kindly contact the *epi* Secretariat (education@patentepi.com).

Please visit our website for news !

www.patentepi.com

Summer and autumn tutorial

The *epi* tutorials are EQE training events that provide candidates with an opportunity to sit the A/B/C/D papers privately, to send the papers to an experienced *epi* tutor assigned to them and to have their individual papers reviewed and discussed.

The schedule is as follows:

1. Candidates enrol indicating the papers they want to sit. The enrolment is confirmed by the *epi* Secretariat and the candidates are informed about the assigned tutor(s). Two different tutors may be assigned for papers A/B and for papers C/D. A tutor will be assigned to a group of not more than 3 to 5 candidates to allow intensive discussions.

2. In a first round candidates write the papers privately (it is recommended to do so in the time the EQE allows for the particular paper).

3. Candidates send their paper(s) to the tutor they have been assigned to by the *epi* Secretariat. The tutor reviews the paper(s).

Candidates who do not get an answer to their papers from their tutor by a due date are requested to contact the *epi* Secretariat immediately.

4. In a second round discussions are scheduled for papers A/B and C/D respectively. The papers are discussed in general, particular problems are addressed, individual solutions commented on and questions answered. The format is flexible: it is up to the tutor and the particular group candidates to decide upon a commonly agreeable form for the tutoring session. In case it is decided that a meeting should be held with all candidates, time and place is to be agreed upon by the tutor and the candidates. The candidates bear in this case their own travel expenses as well as the travel expenses of their tutor. Alternatively a telephone conference could be arranged, but as indicated it is up to the tutor/candidates to agree upon a suitable format.

5. Exam papers to be discussed

a) Summer tutorial: 2010, 2011 2012

b) Autumn tutorial: 2011, 2012, 2013

6. Schedule

Each year *epi* suggests a schedule to ensure a timely feedback and to avoid an overlap of summer and autumn tutorials. This schedule should be seen as a proposal. The final agreement on the date when papers should be returned and the date of the feedback session is to be decided between tutor and candidate(s).

a) Summer tutorial:

- > Deadline for registration: May 24, 2013
- > Papers to be returned: June 21, 2013
- > Feedback to be given by: September 6, 2013

b) Autumn tutorial:

- > Deadline for registration: September 13, 2013
- > Papers to be returned: October 18, 2013
- > Feedback to be given by: December 13, 2013

7. Fees for the tutorials: 180.- € for non *epi* students
90.- € for *epi* students

For further information/enrolment form please visit our website (www.patentepi.com)
→ EQE and Training) or contact the *epi* Secretariat
(email: education@patentepi.com).

epi Mock EQEs and *epi* Seminars in 2013

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

Scheduled Seminars

11 April: Guidelines2DAY seminar Oslo

18 April: Guidelines2DAY seminar Warsaw

15 May: Guidelines2DAY seminar Bucharest

3-4 June: Seminar on "European Procedure – Basic concepts and how to use them when drafting claims", Istanbul

<https://www.patentepi.com/patentepi/en/EQE-and-Training/training-seminars.php>

Scheduled Mock EQEs

29–31 October: Mock EQE session in Munich

2– 4 December: Feedback session in Munich

List of Professional Representatives as at 19.01.2013

by their place of business or employment in the Contracting States

19.01.2013	All professional representatives
Contr. State	Number
AL	31
AT	127
BE	181
BG	67
CH	456
CY	12
CZ	99
DE	3539
DK	209
EE	26
ES	173
FI	171
FR	949
GB	1979
GR	24
HR	27
HU	89
IE	65
IS	20
IT	469

19.01.2013	All professional representatives
Contr. State	Number
LI	18
LT	26
LU	18
LV	21
MC	3
MK	40
MT	7
NL	455
NO	100
PL	340
PT	42
RO	62
RS	56
SE	333
SI	31
SK	38
SM	26
TR	98
Total:	10427

Source: Legal Division, EPO

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
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80298 Munich
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Fax: +49 (0)89 2399-5148
legaldivision@epo.org
www.epo.org

Thank you for your cooperation.

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

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

Next Board and Council Meetings

Board Meetings

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

Disciplinary Committee (epi)

Please be informed that due to changes within the epi Secretariat

Ms Nicole VAN DER LAAN has been appointed Registrar to the Disciplinary Committee

Ms Ute LAEDTKE will continue to act as Deputy Registrar to the Disciplinary Committee.

Information from the European Patent Office

New EPO electronic tools: Mailbox and My Files

The EPO is pleased to announce the launch of two electronic tools which enable you to receive electronic notifications from the EPO, access your published and unpublished files and use our new self-service functions, all in a secure environment.

Mailbox is a single point of delivery for electronic communications from the EPO. Your company Mailbox allows for rapid notification of communications. The history is fully documented and essential information can be found fast. The company Mailbox is user-friendly with special folders having search and sort functions.

	Date Sent	Application No.	User Reference	Subject
<input checked="" type="checkbox"/>	07.11.2012	09382293	6280EP575PRO	Changes to reference
<input type="checkbox"/>	07.11.2012	09772587	6626EP563CER	Changes to reference
<input type="checkbox"/>	07.11.2012	09382293	Garv3	Representation withdraw
<input type="checkbox"/>	07.11.2012	09382299	garv2	Changes to representation
<input type="checkbox"/>	07.11.2012	09772587	Garv1	Representation withdraw
<input type="checkbox"/>	07.11.2012	09803778	100277PEP579SOL	Changes to representation
<input type="checkbox"/>	07.11.2012	10798098	101977PEP605BIO	Representation withdraw
<input type="checkbox"/>	07.11.2012	10805430	101739PEP601GIR	Changes to representation
<input type="checkbox"/>	07.11.2012	10805430	101739PEP601GIR	Changes to representation
<input type="checkbox"/>	07.11.2012	11161474	123456789012345	Changes to reference

To start using the company Mailbox, you simply have to be a professional representative or association under Rule 152(11) EPC. One of the smart card users in your

company has to become an Administrator and follow the steps required to activate the company Mailbox (see *Mailbox Quick Reference Guide*).

The company Mailbox will then allow you to receive selected notifications electronically. The notifications currently available are search reports, examiner communications and those listed in the link *here*. During the coming months the aim is to make the portfolio of electronic notifications as complete as possible.

Your benefits with Mailbox:

➤ no scanning needed

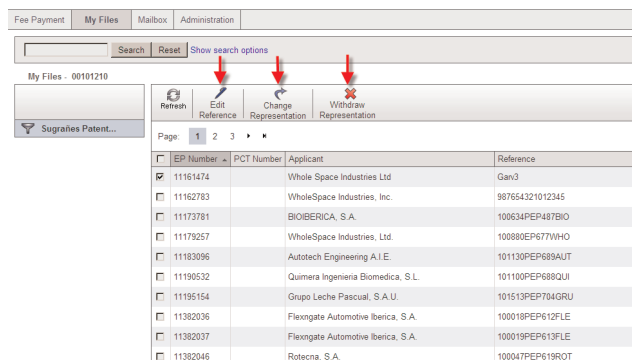
As companies become more automated, their workflows rely on documentation being electronic. The Mailbox facilitates this, while at the same time eliminating the need to scan documents.

ten-day rule remains

Documents are received on or before the legal dispatch date, meaning that recipients benefit to the full from the ten-day rule. With respect to search reports, as is the case in the paper world, documents are dispatched immediately to the customer, meaning that recipients may even have a few days more than provided for by the ten-day rule.

My Files is an online service which provides secure access to the files for which you are, according to EPO

data, the appointed representative. This cuts down on your administration and makes it easy for you to keep your portfolio up to date. You get access to your unpublished and published files as well as to complete file contents (including non-public documents). Additionally a new functionality enables you to manage your representation, i.e. to withdraw or re-assign representation and to change your user reference.



EP Number	PCT Number	Applicant	Reference
11161474		Whole Space Industries Ltd	Gan3
11162783		WholeSpace Industries, Inc.	987654321012345
11173781		BIOBERICA, S.A.	100634PEP487BIO
11179257		WholeSpace Industries, Ltd.	100880EP677VHO
11183096		Autotech Engineering A.I.E.	101130PEP689AUT
11190532		Quimera Ingeniería Biomedica, S.L.	101100PEP688QUI
11195154		Grupo Leche Pascual, S.A.U.	101513PEP704GRU
11382036		Flexgate Automotiva Iberica, S.A.	100018PEP612FLE
11382037		Flexgate Automotiva Iberica, S.A.	100019PEP613FLE
11382046		Rotensa, S.A.	100047PEP619ROT

To log in to My Files, you have to be defined as a mailbox user, be a registered smart card user and use the smart card and PIN (see *MyFiles Quick Reference Guide*).

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list of your files

A dynamically produced list provides you with a searchable overview of all the files for which you are responsible.

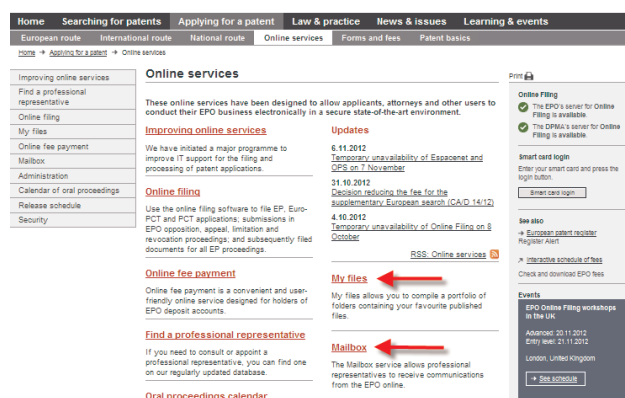
➤ self-service functionality

Being able to withdraw or change representation electronically on the files that you own means that you can keep the records of your active files up to date, thereby enhancing the quality of your data and observing your duty of care to applicants.

Giving it a try

Why not run a pilot phase in your company, have an internal user test these tools and draw your own conclusions? You can deactivate Mailbox at any time if you so wish; deactivation is processed overnight which means that you will receive EPO notifications by postal mail again the following day.

Visit the online services and software access point on the EPO website www.epo.org from which you can access the Mailbox and My Files.



The screenshot shows the EPO Online services page. The 'My files' link is highlighted with a red arrow. Other links visible include 'Online filing', 'Online fee payment', 'Find a professional representative', and 'Oral proceedings calendar'. The page also features a sidebar with 'Online services' and 'Events' sections.

PCT at the EPO Conference for patent professionals and industry 13 June 2013 – EPO Munich, Germany

The EPO is organising an in-house training event for patent attorneys and IP professionals from industry in Europe and elsewhere interested in filing PCT applications with the EPO.

The event will consist of eight sessions which will give participants the opportunity to get first-hand information and experience from experts on important aspects of filing and processing PCT applications with the

EPO in all its capacities under the PCT. EPO experts and experienced patent attorneys will lead the sessions. Furthermore, experts from other major patent offices (USPTO, JPO, SIPO) and patent attorneys experienced in the respective procedures will run sessions on specific aspects of entry into their national phases. The EPO will introduce and give details of proposed new services such as supplementary international search, the second

written opinion in the Chapter II procedure, and utilisation of PCT work in the PCT-PPH framework. The event will conclude with a panel discussion on key developments in the PCT, followed by a cocktail reception and a

networking dinner to celebrate the 35th anniversary of the PCT.

More information can be found on the website of the European Patent Office: www.epo.org/pct-conference

EPO Praktika Extern Programme

In 2013 the European Patent Office is again running a Praktika Extern programme for experienced EPO examiners to exchange their knowledge with industry and patent attorney firms.

The aim is for both parties, examiners and patent attorneys/host firms, to have the opportunity to interact in order to get a better idea of the issues and challenges in a different professional environment dealing with intellectual property.

The programme is to be financed entirely from EPO funds and there will be no administrative work required on your part. In the event of a placement taking place, a contract will be drafted in twofold for signature by a representative of your company and by the EPO.

Hosting periods will last between 10 and 20 working days and will take place in the period June- end November 2013.

The programme is open to industry and firms from all member states.

Should you indeed be interested in hosting an EPO examiner or have any questions, please contact: C. Rivero (Mr) crivero@epo.org or E. Jaspers-Otten (Mrs) ejaspers@epo.org

You may also indicate a preference on the time period and duration within the range as indicated above. A candidate will be carefully selected to closely match your expressed needs.

Warum man dem Register des europäischen Patentamts nicht uneingeschränkt Glauben schenken darf

Zeitangaben im epoline zu Erstbescheiden sind auf Grund der Auswirkungen der J9/10 nicht immer richtig.

S. Strässle (CH) und M. Liebetanz (CH)

Seit dem 1. April 2010¹ ist die Einreichung von Teilanmeldungen für anhängige europäische Patentanmeldungen nicht mehr frei dem Anmelder überlassen, sondern kann nur innerhalb von 24 Monaten nach Erhalt des ersten Bescheids der Prüfungsabteilung zu der frühesten Anmeldung, zu der ein Bescheid ergangen ist, eingereicht werden.² Wird eine Anmeldung ausserhalb der 24-Monatsfrist eingereicht, hat dies zur Rechtsfolge, dass diese Anmeldung nicht als europäische Teilanmeldung behandelt werden kann.

Diese Vorschrift wurde eingeführt, um die Zahl der als missbräuchlichen empfundenen Teilanmeldungen zu

verkleinern, und wird jedenfalls in Anmelderkreisen als unangenehme Einschränkung wahrgenommen. Hierzu hat der *epi*-Rat anlässlich der 73. Ratssitzung eine Lagebeschreibung³ ans europäische Patentamt (EPA) verabschiedet, welche einer begründeten Ablehnung der Beschränkung der Möglichkeit zur Einreichung von Teilanmeldungen bis zum Ablauf dieses Zeitfensters öffentlich Ausdruck verleiht.

Neben Fragen zur Berechnung dieser Frist, beispielsweise bei Ketten von Teilanmeldungen, sind auch ganz praktische Fragen wie das Auffinden dieser Frist für Dritte aufgetreten. Das Amt hat darauf beschlossen⁴, im europäischen Patentregister eine Zusatzinformation

¹ Geänderte Regel 36 AusFO EPÜ; siehe Abl. EPA 2009, 481

² Siehe auch Beschluss des Verwaltungsrates vom 26. Oktober 2010, CA/D 16/10, Abl. EPA 2010, 568

³ https://www.patentepi.com/downloads/Reports/PP_04_2012.pdf

⁴ Siehe Abl. EPA 2011, 273

in der Übersicht aufzuschalten, bei der unter der Rubrik „Teilmeldung(en)“ steht: „Das Datum des ersten Bescheids der Prüfungsabteilung zu der frühesten Anmeldung, zu der ein Bescheid ergangen ist, ist dd.mm.20yy“.

Es hat sich nun herausgestellt, dass sich Dritte nicht auf dieses aus dem Register des EPA hervorgehende Datum zum Erstbescheid, der die 24-Monatsfrist zur Einreichung von europäischen Teilmeldungen auslöst, verlassen können. Bis vor kurzem galten Mitteilungen, welche von Formalsachbearbeitern im Namen der Prüfungsabteilung auf einem Formular mit Nummer 2001A abgesetzt wurden, als fristauslösend⁴. Zwischen 2005 und 2012 wurde das Formblatt 2001A vom EPA regelmässig dann versandt, wenn der Anmelder auf eine vor dem 1. April 2010 erstellte negative Stellungnahme zur Recherche nicht reagiert hatte⁵.

Die Wirkung der vorgenannten Mitteilung auf Formblatt 2001A hat sich nunmehr geändert. Mit Datum vom 20. Dezember 2012⁶ hat das EPA eine Mitteilung auf seiner Newsseite publiziert, bei der darauf hingewiesen wird, dass das sich aus dem Formblatt 2001A ergebende Datum nicht mehr gültig sei.

Hintergrund dieser Änderung ist die Entscheidung J9/10⁷ der juristischen Beschwerdekammer des EPA, in welcher festgehalten worden ist, dass eine Mitteilung des EPA, die nicht vom Prüfer stammt, sondern von einem Formalsachbearbeiter abgesetzt wurde, nicht als Mitteilung der Prüfungsabteilung nach Artikel 94(3) EPÜ gilt und somit die Sachprüfung nach Artikel 94 EPÜ nicht auslöst, obwohl die Zuständigkeit für die Anmeldung bereits auf die Prüfungsabteilung übergegangen ist. Konsequenterweise darf dann eine Rückzahlung der Prüfungsgebühr zu diesem Zeitpunkt nicht aus diesem Grunde verweigert werden.

Amtsbescheide auf einem Formblatt 2001A sind in mindestens drei verschiedenen Versionen abgesetzt worden. Zum einen nur mit dem Amtssiegel des EPA versehen, ohne jeglichen Verweis auf eine handelnde Person. Dann gibt es eine zweite Version mit dem Amtssiegel und dem Schriftzug „Für die Prüfungsabtei-

lung“ und schliesslich eine dritte Version mit Dienstsiegel, dem Schriftzug „Für die Prüfungsabteilung“ und dem Namen des Erstprüfers; ohne dass jedoch textlich irgendeine inhaltliche Aussage ausser dem Formschreiben selbst vorgelegen hat. Insofern ist die Sachaussage des Formblatts und nicht eine aufgedruckte Unterschrift bzw. ein aufgebrachtes Dienstsiegel für dessen Wirkung entscheidend⁸.

Die oben erwähnte Mitteilung des EPA vom 20. Dezember 2012 stellt nun fest, dass die Frist im Sinne der Regel 36 EPÜ für keinen dieser drei formalen Amtsbescheide ausgelöst werde.

Insofern wird nun bei einer Vielzahl von Akten, in welche eine Mitteilungen auf Formblatt 2001A als fristauslösend verzeichnet wurde, die Möglichkeit bestehen, dass weiterhin innerhalb eines gewissen Zeitrahmens Teilmeldungen eingereicht werden können.

Für Dritte heisst dies aber auch, dass man sich auf die entsprechenden Auskünfte des europäischen Patentregisters nicht ohne Weiteres verlassen kann und man sich die Natur des dort angegebenen ersten Prüfungsbescheides bzw. die Aktenlage genauer ansehen muss. Das EPA weist im letzten Abschnitt der genannten Mitteilung vom 20. Dezember 2012 pauschal auf solche Fehleinträge im Register hin, was den Benutzern des Systems jedoch wenig hilft und den Nutzen der Massnahme der Eintragung des Datum des fristauslösenden Ereignisses für die 24-Monatsfrist im Register zumal vorerst arg schmälert. Auch stellt sich hier die Frage, ob ein Anmelder, dessen Rechte amtsseitig zu Unrecht systematisch beschnitten worden sind, nicht das Anrecht hätte, vom EPA über seine wahren Rechte aufgeklärt zu werden.

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5 Siehe Richtlinien für die Prüfung im EPA C-VI, 3.3 (Juni 2005) und C-VI, 3.5 (Dezember 2007), 6

6 http://www.epo.org/law-practice/legal-texts/official-journal/information-epo/archive/20121220_de.html

7 Einsehbar unter <http://www.epo.org/law-practice/case-law-appeals/recent/j100009eu1.html>

8 Siehe bspw. Richtlinien für die Prüfung im EPA-EI, 1.3 (Juni 2012)

What are the main elements of the so-called enhanced cooperation and when will it start?

W. Bernhardt (CH)

Introduction

The EU motivates its member states to increase cooperation and integration between the member states in one of the areas of the EU Treaties.

As usual among different parties, some would like to cooperate, others don't. This situation could lead to a problem, if unanimity is a requirement for a decision to be taken. And – in a nutshell – enhanced cooperation is simply one measure of dealing with exactly this “group dynamic behaviour”: how would it be possible for some member states to implement certain activities – better: operational cooperation, despite the dissenting vote or blocking rights of others – with the goal to “further the objectives of the Union, protect its interests and reinforce its integration process” (according to Art. 20(1) TEU).

Examples for common activities by not all member states were the introduction of the EURO under the EMU – economic and monetary union: where it is expected that every member state enters, and the Schengen treaty, which is automatically installed, once a country joins the EU. However, the member states do have opt-out possibilities or some “delaying tactics”, e.g. in case of the EURO (being mainly a three-stage process). Another example is the introduction of the London Agreement, which, however, as you know, was introduced on the basis of Art. 65 of the EPC by member states of the European Patent Organization.

A different approach – coming from the other side so to say – is the possibility of having a subset of member states, which would like to cooperate and participate in a common goal – of course – under the umbrella of the EU treaty system thus improving integration and cooperation.

Only recently we all know that enhanced cooperation can be a success story also in the field of patents: the unitary patent protection as well as its translation arrangements was established by this measure. The whole story will be completed in the near future by coming into force of the agreement on a unified patent court, which not only is open for member states participating in the enhanced cooperation, but by any member state of the European Union.

History

The idea of enhanced cooperation was introduced in the Treaty of Amsterdam (in force since 01.05.1999) with the condition of **using the institutions and procedures of the EU**. One practical drawback of this Treaty was the right to veto by member states who didn't want to cooperate, another one was that a majority of

the member states needed to agree. The right to veto was corrected in the Treaty of Nice (in force since 01.02.2003) – except for the field of foreign policy, but a new condition was introduced instead: this was the element of the **last resort**. Another further step was introduced in the Treaty of Lisbon (in force since 01.12.2009), which facilitated the process in so far as from then on only **nine member states**, i.e. 1/3 of all current member states, were required for launching the procedure for enhanced cooperation.

Legal Basis and general procedure

The legal basis for all this can be found essentially in Art. 20 TEU (Treaty on European Union) and in Art. 326-334 TFEU (Treaty on the Functioning of the European Union): here, it is regulated of who needs to do what, who has to decide on what and how the procedure works.

Requirements

Now, when exactly, i.e. under which specific conditions enhanced cooperation is applicable, and how can it be initiated by whom?

Usually, the Commission adopts proposals for Council Regulations, and the Council discusses those proposals during their meetings, and at the end, with the consent of the EU parliament, a new rule or regulation results.

With regard to enhanced cooperation the procedure is more or less the same: interested **member states** address a **request to the Commission** specifying the scope and objectives of the enhanced cooperation proposed. (Art. 329(1) TFEU) **after** the Council states that the requirements of the last resort are given.

This means that no common ground or compromise can be found in case of the absence of unanimity or a qualified majority among all member states – within a reasonable period by the Union as a whole, and provided that at least 9 member states participate in it (Art. 20(2)). If this is the case, the **Council** shall act in accordance with the procedure laid down in Art. 329 TFEU (Art. 20(2)).

The Commission then may or may not submit a **proposal to the Council**.

The final “GO” – or authorization to proceed with the enhanced cooperation – comes from the Council, after the Council obtained the **consent of the European Parliament**. (Art. 329(1) TFEU). Finally, there will be a **Council decision** that the participating member states

are authorised to establish enhanced cooperation between themselves.

In the specific case of the unitary patent the Commission adopted a proposal for the creation of a unitary patent (2000), and ten years later it adopted another proposal on the translation arrangements for the EU patent. At the Council meeting on Nov. 10, 2010 no unanimity was reached as far as the translation arrangements were concerned. Then, during December 2010, 12 member states addressed requests to the Commission indicating that they wished to establish enhanced cooperation between themselves on the basis of the existing proposals. Later on 13 more member states also wished to join in.

As guidance for the measures to be taken, the Council Decision of March 10, 2011 authorising enhanced cooperation in the area of the creation of unitary patent protection can be used as a helpful checklist:

Essentially, the red thread runs through the **general legal requirements** laid down specifically in Art. 20 TEU and Art. 326 (*inter alia* no barrier or discrimination in trade between member states) and Art. 329 (non-exclusive competence, procedure: Commission, Council, consent of EU parliament) TFEU:

- (i) The **area** within which enhanced cooperation would take place should be covered by the Treaties (in case of the unitary patent: Art. 118 TFEU)
- (ii) As mentioned already, Council needs to check whether the **last resort** requirement laid down in Art. 20(2) TEU is fulfilled.
- (iii) Next, it needs to be analysed whether enhanced cooperation would lead to **further the objectives** of the Union, protects its interests and reinforces its **integration process** in accordance with Art. 20(1) TEU.
- (iv) As usual in legal systems, you not only look whether something is allowable, but also whether it might be forbidden or excluded, or whether there is an exception of an exception. E.g. the creation of unitary patent protection is not included in the list of areas of exclusive competence set out in Art. 3(1) TFEU, rather, it falls within the framework of the Union's **non-exclusive competence** (Art. 118, Art. 4 TFEU).
- (v) Of course, enhanced cooperation needs to deal also with the issue of **respecting the competences, rights and obligations of non-participating member states**. E.g. the possibility of obtaining unitary patent protection on the territories of the member states participating does not affect the availability or the conditions of patent protection on the territories of non-participating member states. Moreover, undertakings from non-participating member states should have the possibility to obtain unitary patent protection on the territories of the participating member states under the same conditions as undertakings from participating member states. Existing rules of non-participating member states determining the conditions of

obtaining patent protection on their territory remain unaffected.

- (vi) Enhanced cooperation should be **open at any time to all member states** willing to comply with the acts already adopted in accordance with Art. 328 TFEU.
- (vii) Last but not least, enhanced cooperation needs **to comply with the pre-existing acquis**, i.e. the accumulated legislation, legal acts and court decisions constituting the EU law.

This is the general procedure. Of course, there are more details and variants, in particular in cases where one of the involved institutions, the Council, the EP parliament or the Commission say no. And there is also the possibility that the **Council requests an opinion of the Court of Justice of the EP Union (CJEU)**, which happened on March 08, 2011 leading to CJEU opinion 1/09. The issue was to check the compatibility of not only the creation of the unitary patent, but also of the creation of a EU Patents Court with the Treaties. The CJEU stated that the envisaged agreement – in its current state – was not compatible with the Treaties. Two days later, however, the Council granted a positive decision concerning the unitary patent, thus disconnecting the unitary patent issue from the EU Patents Court issue.

There are several further Articles concerning how to proceed more specifically, e.g. Art. 330 TFEU lays down that all members of the Council may participate in its deliberations, but only members of the Council representing the Member States participating in enhanced cooperation shall take part in the vote. Although unanimity is the rule, a qualified majority shall be defined in accordance with Art. 238(3).

Another issue concerns the question if at a later stage any other Member State could participate. This is laid down in Art. 331 TFEU: such a member state needs to notify both the Council and the Commission of its intention. Within 4 months, then the Commission will confirm – or not – such a participation. In case the Commission is of the opinion that the conditions for participation are not fulfilled, it will indicate the arrangements to be adopted to fulfil those conditions and sets a deadline for re-examination of the request. This could be the case if e.g. the Commission comes to the conclusion that a member state would like to join in only to “sabotage” the unanimity.

There remains the question what the “dissenting” member states can do in order to fight against enhanced cooperation: are there any legal measures they could use?

Such a measure is laid down in Art. 263 TFEU according to which actions can be filed at the CJEU for annulment of a Council Decision authorising enhanced cooperation. In case of the unitary patent ES and IT filed such actions based on e.g. misuse of powers, circumvention of the unanimity requirement, violation of the jurisdictional system of the Union, non-respect of essential requirements to establish an enhanced cooperation, lack of competence, violation of Art. 20(1) etc.

TEU Articles:*Article 20*

X***U (for authorisation)

X/XX/U (for participation in already existing enhanced cooperation)

1. Member States which wish to establish enhanced cooperation between themselves within the framework of the Union's non-exclusive competences may make use of its institutions and exercise those competences by applying the relevant provisions of the Treaties, subject to the limits and in accordance with the detailed arrangements laid down in this Article and in Articles 326 to 334 of the Treaty on the Functioning of the Union.

Enhanced cooperation shall aim to further the objectives of the Union, protect its interests and reinforce its integration process. Such cooperation shall be open at any time to all Member States, in accordance with Article 328 of the Treaty on the Functioning of the European Union.

2. The decision authorising enhanced cooperation shall be adopted by the Council as a last resort, when it has established that the objectives of such cooperation cannot be attained within a reasonable period by the Union as a whole, and provided that at least nine Member States participate in it. The Council shall act in accordance with the procedure laid down in Article 329 of the Treaty on the Functioning of the European Union.
3. All members of the Council may participate in its deliberations, but only members of the Council representing the Member States participating in enhanced cooperation shall take part in the vote. The voting rules are set out in Article 330 of the Treaty on the Functioning of the European Union.
4. Acts adopted in the framework of enhanced cooperation shall bind only participating Member States. They shall not be regarded as part of the *acquis* which has to be accepted by candidate States for accession to the Union.

TFEU (formerly TEC) Articles:*Article 3*

1. The Union shall have exclusive competence in the following areas:

- (a) customs Union;
- (b) the establishing of the competition rules necessary for the functioning of the internal market;
- (c) monetary policy for the Member States whose currency is the euro;
- (d) the conservation of marine biological resources under the common fisheries policy;
- (e) common commercial policy.

Article 4

1. The Union shall share competence with the Member States where the Treaties confer on it a competence

which does not relate to the areas referred to in Articles 3 and 6.

2. Shared competence between the Union and the Member States applies in the following principal areas:
- (a) internal market;
 - (b) social policy, for the aspects defined in this Treaty;
 - (c) economic, social and territorial cohesion;
 - (d) agriculture and fisheries, excluding the conservation of marine biological resources;
 - (e) environment;
 - (f) consumer protection;
 - (g) transport;
 - (h) trans-European networks;
 - (i) energy;
 - (j) area of freedom, security and justice?
 - (k) common safety concerns in public health matters, for the aspects defined in this Treaty.
3. In the areas of research, technological development and space, the Union shall have competence to delegate activities, in particular to define and implement programmes; however, the exercise of that competence shall not result in Member States being prevented from exercising theirs.
4. In the area of development cooperation and humanitarian aid, the Union shall have competence to carry out activities and conduct a common policy; however, the exercise of that competence shall not result in Member States being prevented from exercising theirs.

Article 118

X** In the context of the establishment and functioning of the internal market, the European Parliament and the Council, acting in accordance with the ordinary legislative procedure, shall establish measures for the creation of European intellectual property rights to provide uniform intellectual property rights protection throughout the Union and for the setting up of centralised Union-wide authorisation, coordination and supervision arrangements.

U* The Council, acting unanimously in accordance with a special legislative procedure, shall by means of regulations establish language arrangements for the European intellectual property rights. The Council shall act unanimously after consulting the European Parliament.

Article 263

The Court of Justice of the European Union shall review the legality of legislative acts, of acts of the Council, of the Commission and of the European Central Bank, other than recommendations and opinions, and of acts of the European Parliament and of the European Council intended to produce legal effects vis-à-vis third parties. It shall also review the legality of acts of bodies, offices or agencies of the Union intended to produce legal effects vis-à-vis third parties.

It shall for this purpose have jurisdiction in actions brought by a Member State, the European Parliament,

the Council or the Commission on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaties or of any rule of law relating to its application, or misuse of powers.

The Court of Justice shall have jurisdiction under the same conditions in actions brought by the Court of Auditors and by the European Central Bank and by the Committee of the Regions for the purpose of protecting their prerogatives.

Any natural or legal person may, under the conditions laid down in the first and second paragraphs, institute proceedings against an act addressed to that person or which is of direct and individual concern to them, and against a regulatory act which is of direct concern to him or her and does not entail implementing measures.

Acts setting up bodies, offices and agencies of the Union may lay down specific conditions and arrangements concerning actions brought by natural or legal persons against acts of these bodies, offices or agencies intended to produce legal effects in relation to them.

The proceedings provided for in this article shall be instituted within two months of the publication of the measure, or of its notification to the plaintiff, or, in the absence thereof, of the day on which it came to the knowledge of the latter, as the case may be.

Article 326

Any enhanced cooperation shall comply with the Treaties and the law of the Union.

Such cooperation shall not undermine the internal market or economic, social and territorial cohesion. It shall not constitute a barrier to or discrimination in trade between Member States, nor shall it distort competition between them.

Article 329

X*** 1. Member States which wish to establish enhanced cooperation between themselves in one of the areas covered by the Treaties, with the exception of fields of exclusive competence and the common foreign and security policy, shall address a request to the Commission, specifying the scope and objectives of the enhanced cooperation proposed. The Commission may submit a proposal to the Council to that effect. In the event of the Commission not submitting a proposal, it shall inform the Member States concerned of the reasons for not doing so.

Authorisation to proceed with the enhanced cooperation referred to in paragraph 1 shall be granted by the Council, on a proposal from the Commission and after obtaining the consent of the European Parliament.

U 2. The request of the Member States which wish to establish enhanced cooperation between themselves within the framework of the common foreign and security policy shall be addressed to the Council. It shall be forwarded to the High Representative of the Union for Foreign Affairs and Security Policy, who shall give an opinion on whether the enhanced cooperation proposed is consistent with the Union's common foreign and security policy, and to the Commission, which shall give

its opinion in particular on whether the enhanced cooperation proposed is consistent with other Union policies. It shall also be forwarded to the European Parliament for information.

Authorisation to proceed with enhanced cooperation shall be granted by a decision of the Council acting unanimously.

Article 330

All members of the Council may participate in its deliberations, **but only** members of the Council representing the Member States participating in enhanced cooperation shall take part in the vote. **Unanimity** shall be constituted by the votes of the representatives of the participating Member States only. **A qualified majority** shall be defined in accordance with Article 238.

Article 331

XX/X 1. Any Member State which **wishes to participate** in enhanced cooperation in progress in one of the areas referred to in Article 329(1) shall notify its intention to the Council and the Commission. The Commission shall, within four months of the date of receipt of the notification, confirm the participation of the Member State concerned. It shall note where necessary that the conditions of participation have been fulfilled and shall adopt any transitional measures necessary with regard to the application of the acts already adopted within the framework of enhanced cooperation.

However, if the Commission considers that the conditions of participation have not been fulfilled, it shall indicate the arrangements to be adopted to fulfil those conditions and shall set a deadline for re-examining the request. On the expiry of that deadline, it shall re-examine the request, in accordance with the procedure set out in the second subparagraph.

If the Commission considers that the conditions of participation have still not been met, the Member State concerned may refer the matter to the Council, which shall decide on the request. The Council shall act in accordance with Article 330. It may also adopt the transitional measures referred to in the second subparagraph on a proposal from the Commission.

U 2. Any Member State which wishes to participate in enhanced cooperation in progress in the framework of the common foreign and security policy shall notify its intention to the Council, the High Representative of the Union for Foreign Affairs and Security Policy and the Commission. The Council shall confirm the participation of the Member State concerned, after consulting the High Representative of the Union for Foreign Affairs and Security Policy and after noting, where necessary, that the conditions of participation have been fulfilled. The Council, on a proposal from the High Representative, may also adopt any transitional measures necessary with regard to the application of the acts already adopted within the framework of enhanced cooperation. However, if the Council considers that the conditions of participation have not been fulfilled, it shall indicate the arrangements to be adopted to fulfill those con-

ditions and shall set a deadline for re-examining the request for participation. For the purposes of this paragraph, the Council shall act unanimously and in accordance with Article 330.

Literature referred to:

- (1) Council Decision of March 10 2011 (2011/167/EU)
- (2) Proposal COM(2011) 215/3
- (3) Proposal COM(2011) 216/3
- (4) Consolidated versions of the TEU and TFEU (Official Journal of the European Union, Vol. 53, 30 March 2010; Foundation for EU Democracy, 2008)

- (5) The European Union Patent (CEIPI Litigation course by Francis Leyder, 09.12.2011)
- (6) F. Sieber, *epi* Information 3/2011, p. 103ff., How does "Enhanced Cooperation" work? (including extensive further sources)
- (7) Regulation (EU) No 1215/2012 (OJEU L 351, 20.12.2012, p.1)
- (8) Regulation (EU) No 1257/2012 (OJEU L 361, 31.12.2012, p.1)

Question # 36 of CEIPI Litigation Course 2011-2012

Wolfgang Bernhardt, European Patent Attorney, update 20.02.2013

The Pre-Exam: change the marking scheme?!

R. van Woudenberg¹ (NL) and J. Hoekstra² (NL)

Results of pre-exam 2012

A lot has been said, but not yet much written^{3, 4}, about the Pre-Examination⁵.

On May 9, 2012, the EPO published the official results⁶ and the examiner's report of the first ever EQE pre-exam. The results have turned out to be completely different from what we are used to in the EQE. The guinea pigs of this first year's pre-exam show an astonishing passing rate of 98.7%. Only 5 out of 390 candidates did not manage to score at least 50 out of 100 marks. Four candidates did not make any error at all.

With an average score of 84, a median score of 87 and almost every candidate passing, the pre-exam seems to have failed one of its main objectives to reduce the overall cost of the EQE by filtering out the ill-prepared candidates and serial re-sitters that take up so much of their valuable correction time (and energy).

Possible reasons for the results

In our view, the current results can only be interpreted in four ways. Either:

- 1) the pre-exam was too easy and the ill-prepared candidates will sit the main exam in 2013 with the usual lack of preparation and a little bit more confidence,

- 2) only well-prepared candidates sat the pre-exam 2012 (as suggested by the exam committee in view of the relatively low number of enrolments: 400 instead of the about 800 usual new enrolments to the EQE⁷),
- 3) there never have been many ill-prepared candidates and the low pass rates for the main exam are primarily caused by difficult exams, or
- 4) the pre-exam marking scheme is not appropriate to be sufficiently selective.

As to the first three points, a brief survey was held using hand raising during the meeting between the tutors and the exam committees in Berlin in September to check whether the pre-exam 2012 was too easy, too difficult or at the right level: only few tutors raised their hands to indicate that the pre-exam was at a too low level, some more tutors indicated that the level was adequate, and no tutor identified himself to indicate that the pre-exam was too difficult. However, the majority of the tutors did not raise their hands at all in response to any of the three questions. In view of the rather small minority that answered the questions by raising a hand, it is thus difficult to draw any reliable conclusions from the survey.

The exam committee indicated at the same meeting that they consider the pre-exam 2012 to be at the right level, and consequently indicated that the pre-exam 2013 is not planned to be more difficult. The results of the pre-exam 2013 should give an indication whether the pre-exam level is indeed adequate to let ill-prepared candidates fail the pre-exam: the 700 enrolments to the pre-exam 2013 are about the normal enrolment rate and can thus be expected to include the usual fraction of ill-prepared candidates. If the pre-exam is at the right

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³ <http://pre-exam.blogspot.nl/>

⁴ <http://www.eqe-online.org/pre-exam/>

⁵ <http://www.epo.org/learning-events/eqe.html>

⁶ <http://www.epo.org/learning-events/eqe/statistics.html>

⁷ P. Pollard, H. Marsman, D. Jackson, S. Roberts, R. van Woudenberg, „Tutors' Report on the EQE 2012 Papers“, *epi* Information 4/2012, 106

level to serve the purpose indicated and the enrolments are usual, we believe that the pass rate should be in the range of 65-80 %. Further, the results of the main exam papers 2013 (especially the D-paper, and more particular the DI-part⁸) from the candidates that passed the pre-exam 2012 shall give an indication whether indeed candidates benefited from taken the pre-exam. As this information is highly valuable, we invite the exam secretariat to do their utmost to prepare scoring statistics for pre-exam passers, first time D-paper sitters that did not take the pre-exam (because they were exempted under Art. 25(4) REE⁹), and D-paper resitters. As only the exam secretariat has all enrolment data as well as the results (down to the level of individual DI-questions) from all candidates, we all depend on the exam secretariat to provide such information: the *epi*, EPA, exam committees and tutor organizations cannot generate such information without the cooperation of the exam secretariat.

As an intermezzo, we note that the high pass rate and high score may actually have an opposite effect than intended on the pass rate for the main exam. We asked several third parties how they would prepare for an exam, if they had passed an entrance examination with 90 % of the marks available: most people indicated that they would feel very confident with continuing their preparation at the same or even a lower intensity as for the entrance examination to further prepare for the main exam, and they considered it a reasonable expectation that they could then have sufficient margin to pass the main exam the first time. That expectation may however not be met in view of the large gap in level of difficulty between the pre-exam and the main exam, and only one year training between the two exams. We believe it is fair to say that the main exam papers are also difficult for well-prepared candidates; a quick check with colleagues from various attorney offices indicated that substantially all experienced European Patent Attorneys would not at all be confident to pass the EQE again without resitting, not even if they would again spent a serious amount of dedicated studying for the exam.

Effect of the marking scheme on the results

Finally, let us discuss the marking scheme used for the pre-exam. The pre-exam consists of 10 legal questions and 10 claims analysis questions. Each question consists of a sketch of a case and four statements. For each statement, the candidate has to indicate on the answer sheet whether the statement is true or false. For example, Question 1 of the EQE pre-exam 2012¹⁰ reads:

Bikeparts AS is a Danish company based in Copenhagen. Bikeparts AS validly filed a Japanese patent application JP-X on 11 March 2011 at the Japanese

Patent Office in the Japanese language for invention X. Today, 5 March 2012, it is desired to file a European patent application EP-X at the EPO claiming the priority of JP-X for invention X.

For each of the statements 1.1 – 1.4, indicate on the answer sheet whether the statement is true or false:

1.1 EP-X can be filed in Danish.

1.2 EP-X can be filed in Korean.

1.3 EP-X can be filed in Japanese.

1.4 If EP-X is not filed in one of the official languages of the EPO, then a translation into an official language of the EPO must be filed within a time limit of one month.

No marks are awarded if none of the answers to any of the four statements is correct, or if only one answer is correct. If two answers are correct, 1 mark is awarded. If three answers are correct, 3 marks are awarded. If all four answers are correct, 5 marks are awarded. We will refer to this marking scheme as "0/0/1/3/5", indicating the number of marks where 0, 1, 2, 3 or 4 statements are answered correctly.

The author of an earlier publication in *epi* information¹¹ already indicated that the marking scheme used for the pre-exam awards guessing. The author concluded that it would not be too difficult to pass the pre-exam by, for each question of four statements, answering the two easiest statements based on the candidates' knowledge and experience, and randomly guessing the answers to the two most difficult statements. Although we do not fully agree with the analysis as presented by the author of this earlier publication, we do share his conclusion that the marking scheme makes passing too easy.

We however also acknowledge that designing a pre-exam format and marking scheme, as well as the questions themselves, is a delicate act. Further, candidates most likely do not benefit from changing to a completely different style for the pre-exam. Also, in view of the aim of the pre-exam to reduce the overall cost of the EQE, a multiple choice or true-false format seems to be a reasonable choice. It does however require the questions and their statements to be at a selective level. It also requires a marking scheme that suits testing the candidate's knowledge and understanding of the law and how the law shall be applied to legal cases as well as claims analysis cases, and does not award too many marks for random guessing.

So, let us review the current pre-exam marking scheme. As the answer to a statement can only be true or false, and the pre-exam 2012 did not show any bias to any of the two answers (50 statements were true and 50 statements were false), a candidate will on average get two out of each four statements of each question correct by random guessing. One would be tempted to conclude from this that a candidate would thus be awarded 1 mark for each question, so in total 20 marks, i.e., 20 % of all marks available for the whole pre-exam. That is

8 „New notice of 5 November 2012 from the Examination Board“ on <http://www.epo.org/learning-events/eqe.html> indicates that the new single-paper D exam will still comprise a DI-style part for which about 40 marks are available and a DII-style part for which about 60 marks are available.

9 Suppl. OJEP 12/2011, 2

10 <http://www.epo.org/learning-events/eqe/compendium/preexamination.html>

11 O. Griebing, „Statistical Advice for Passing the EQE Pre-Exam or How an untrained monkey can score 50 % better than a fully trained candidate“, *epi* Information 3/2012, 87

already quite a score, as it is common to award marks to exams on a scale of 1 – 10, i. e. in a range of 10 to 100 % of all marks, where a score of 10 out of 100 would be achieved by a candidate having no knowledge, and not 20.

However, a more careful analysis shows that the average expected number of marks obtained from guessing only is not 20, but even 28! The reason is that, although the candidate on average gets two out of four statements correct, statistics governs that he has a chance of 3/16 to get only one statement of a question correct –thus 0 marks– but with the same chance of 3/16 he may get three statements correct –thus 3 marks–: his average score per question is thus larger than 1. He even has a 1/16 chance to get all four statements correct and score the maximum of 5 marks (4 marks more than the marks awarded for two correct statements), whereas he is hardly penalized if he gets none correct (0 instead of 1 mark) for which he has the same chance of 1/16. This further increases the average expected score. So, the average expected score is the weighted sum of the marks for getting 0, 1, 2, 3 or 4 statements correct, which equals $1/16 * 0 + 3/16 * 0 + 1/2 * 1 + 3/16 * 3 + 1/16 * 5 = 1,4$ per question, so an expected score of 28 for the complete pre-exam by random guessing. That is quite a lot of marks “for free”.

We propose to maintain the format of the questions, but to change the marking scheme from 0/0/1/3/5 to 0/0/0/2/5. This would provide a more progressive marking, benefiting candidates who really understand the question at an adequate level, while reducing the effect of random guessing and while maintaining the level of easy of marking and adding all marks to obtain the full score. The expected average score for each question obtainable by random guessing would no longer be 1,4 corresponding to 28 marks for the whole pre-exam, but $1/16 * 0 + 3/16 * 0 + 1/2 * 0 + 3/16 * 2 + 1/16 * 5 = 0,7$ per question corresponding to 14 marks for the whole pre-exam. This seems a quite acceptable number of marks for random guessing.

Conclusions

The scores obtained by candidates and the pass rate of pre-exam 2012 were very high. In our view, this may be partially explained by the preparation level of the candidates in combination with the (rather low) level of difficulty of the questions and the statements. However, candidates may already get quite some marks from random guessing, where the 0/0/1/3/5 marking scheme gets the candidates on average 28 marks “for free” compared to a level of 10-15 marks for random guessing.

We propose to maintain the style of the questions, i. e., 10 legal and 10 claims analysis questions with four true/false statements each, while changing the marking scheme from 0/0/1/3/5 to 0/0/0/2/5. We believe that with this change in marking scheme, in combination with a careful design of the questions and statements, the pre-exam can serve its original goals: let candidates start studying earlier to be better prepared when taking the main exam, filtering out candidates who are at a too low level, increasing the pass rate of the main exam, and reducing the overall cost of the EQE.

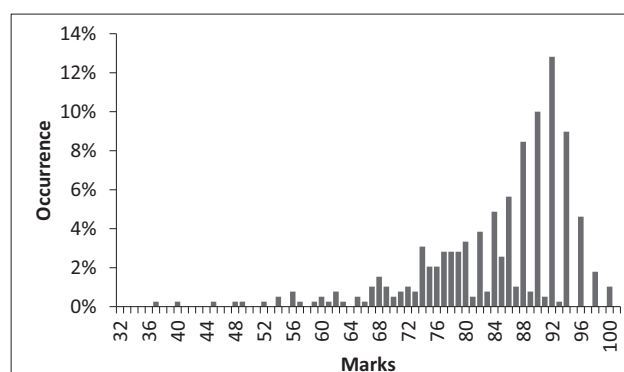


Figure: frequency of occurrence (in %) of marks obtained in pre-exam 2012. Each bar is 1 mark wide. The comb-like structure at marks above 80 originates from the 0/0/1/3/5-marking scheme, which does not allow scores of, e.g., 99 and 97, and has a lower frequency for even scores above 80.

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Anmeldeschluss Modul 1 (und 2): 01.06.2013

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Die Kandidaten können zur Vorbereitung an Modul 2 teilnehmen. Modul 3 umfasst die Durchführung einer simulierten, dreitägigen Prüfung mit den Prüfungsaufgaben von 2013. Die an Modul 2 erarbeitete Strategie kann gezielt in Modul 3 geübt werden. Die Lösungen der Kandidaten werden korrigiert, bewertet und den Kandidaten zugestellt. Die Kandidaten können nach Erhalt der Bewertung zu ihren Aufgaben den Tutoren Fragen stellen.

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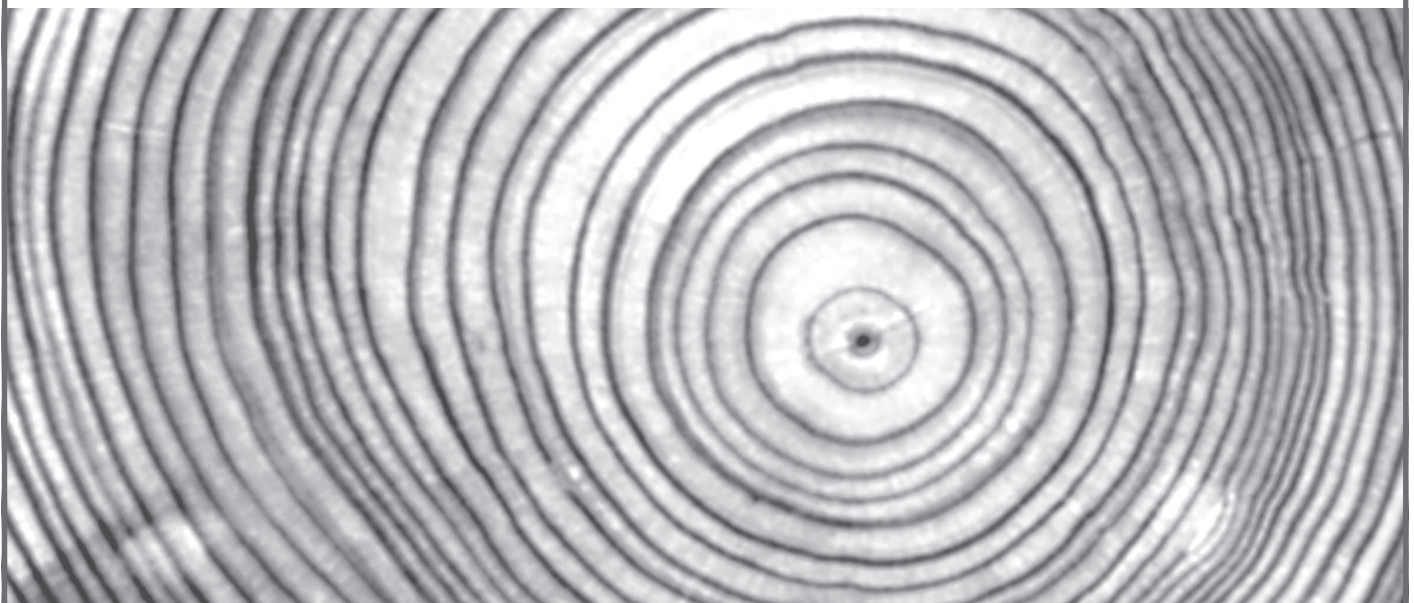
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Der Kommentar hat sich als Standardwerk im deutschen Sprachraum etabliert.

Die Herausgeber:

Prof. Dr. Jan Busche, Heinrich-Heine-Universität Düsseldorf; *Prof. Dr. Peter-Tobias Stoll*, Georg-August-Universität Göttingen; *Prof. Dr. Andreas Wiebe*, Georg-August-Universität Göttingen

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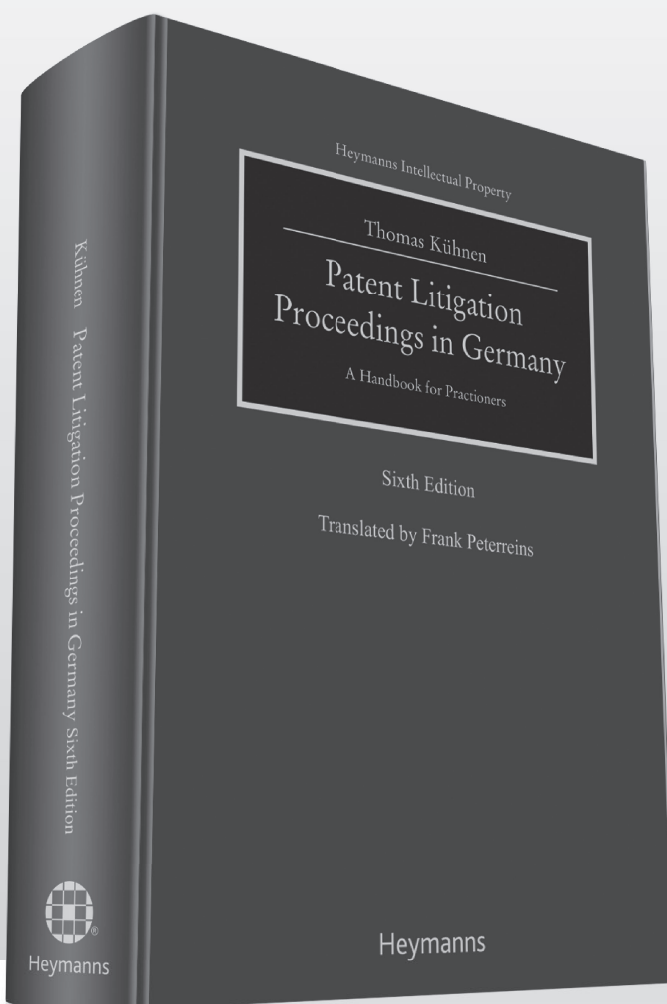
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Frank Peterreins is the Managing Principal of Fish & Richardson's Munich office. He is qualified in Germany as an attorney-at-law and a patent attorney and is also a European patent attorney, and has a wide-ranging litigation practice.

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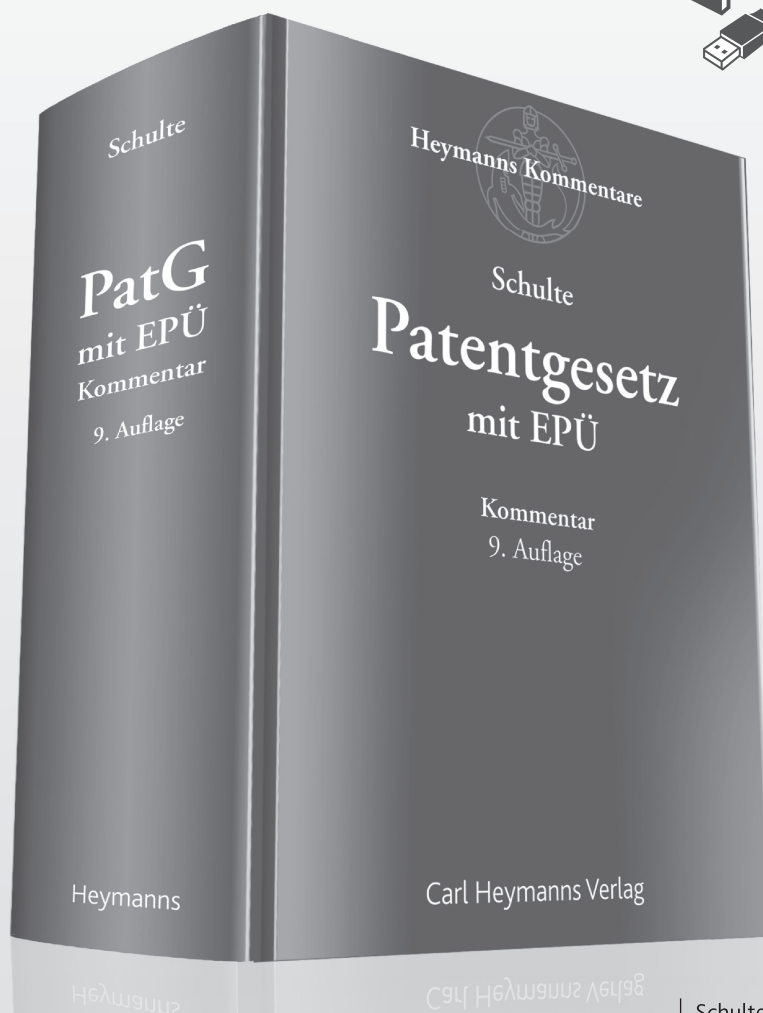
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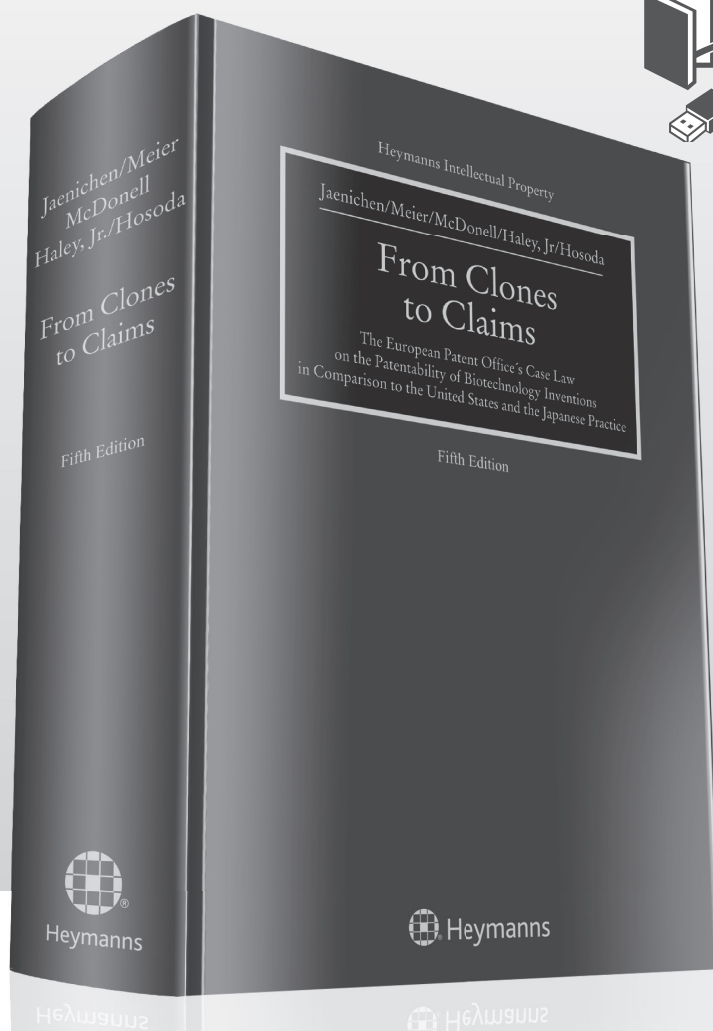


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