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before the European Patent Office

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## Editorial

T. Johnson (GB)

As I have reported in other years, the holiday period is often considered in journalistic circles to be a 'silly season' as there is often not much news of import to report, so items such "man bites dog" find their way into print. However, as I am sure all our readers will also be aware, it is increasingly the case that there is no quiet holiday period in the world of intellectual property as clients (happily!) seem to call on us for advice all year round. If there is a lull, then we are adept at seeking to improve the service we offer. Your Institute is no exception. As I hope members will recall, the Editorial Committee in conjunction with the Reform Group and the Board has been working hard on an upgrade of the Institute website.

Indeed as I type this, a link to the development area of the new website is being sent to a selected group of members to test the upgraded website and implemented functions and to provide feedback. The new website is still under construction, so its development should be considered as work in progress. However, we

remain confident that the feed-back we receive will help to avoid problems and inconveniences with the website in the future. We hope to provide a user-friendly website!

Our Institute is not alone in its ambition to provide updated services. As has been reported elsewhere, reform of the Boards of Appeal to provide for their actual and perceived independence has been under scrutiny. The President of the EPO has recently made some proposals for such reform. These proposals have been published by the Administrative Council, see:

[www.epo.org/modules/epoweb/acdocument/epoweb2/164/en/CA-16-15\\_en.pdf](http://www.epo.org/modules/epoweb/acdocument/epoweb2/164/en/CA-16-15_en.pdf).

No doubt our Council will consider whether to take a view.

I hope you will agree that there is no silly season in evidence in the current activities of the **epi** or our partner in the European Patent Organisation, the EPO.

We hope all our readers had a relaxing and enjoyable Holiday Season!

# UPC Agreement Ratification Process and Local or Regional Divisions

## Litigation Committee

Before the Unified Patent Court Agreement (UPCA) can enter into force, it needs to be ratified by 13 Member States, including Germany, France and the UK (Art 89(1) UPCA). The **epi's** Litigation Committee members from the various EU Member States have contributed information on the latest developments in their respective countries with regard to the ratification process. The input has been summarised in the attached table, which

also contains news about the potential establishment of local or regional divisions (Art 7 UPCA) and the corresponding languages of proceedings (Art 49 UPCA). This table comprises data from all Signatory States to the UPCA. In addition, Poland, Croatia and Spain are included, being Member States of the European Union and potential candidates for joining the UPC in the future.

	Ratification Process	Local or Regional Division
<b>AT</b>	Austria deposited its instrument of ratification on 6 August 2013.	In January 2015, it was decided by the Council of Ministers to establish a local division in the premises of the Austrian Patent Office in Vienna. It is not yet sure whether, and to what extent, English will be admitted as an additional language of proceedings.
<b>BE</b>	Belgium deposited its instrument of ratification on 6 June 2014.	Belgium is committed to establishing a local division in Brussels, which will operate in the three national languages (French, Dutch and German) plus English.
<b>BG</b>	Bulgaria is the 25th country that signed the UPCA. At this stage, its ratification is not envisaged. The reasons for which ratification is put off are related to the necessity of assessing the financial aspects.	Bulgaria is not considering the establishment of a local division, but under certain conditions the establishment of a regional division could be supported. In Bulgaria, there are no court cases on infringement of a European patent. Taking this lack of disputes into consideration, the opinion of the Bulgarian competent authorities is that the benefits of a regional division would be insignificant.
<b>CY</b>	In Cyprus, there is no progress with regard to ratification.	Cyprus has not made proposals for a local or regional division.
<b>CZ</b>	In the Czech Republic, for the moment, no steps have been taken for ratification. A study is expected to be carried out on the impact of the UPC on Czech firms and on the Czech economy and budget. It is moreover noted that the present quality of machine translation into Czech must be improved.	There are furthermore no measures for a local or regional division. Discussions with Slovakia in this regard are only at the beginning.
<b>DE</b>	In Germany, a draft law for ratification has still not been proposed to the Parliament, but no obstacles are expected. The bill should be ready in the second half of 2015.	It is planned to have four local divisions in Germany: Munich, Düsseldorf, Mannheim and Hamburg. Munich will most likely have English as the second language of proceedings (besides German). Düsseldorf appears to be more reluctant in this respect. It is thus not clear that all local divisions will accept English.
<b>DK</b>	Denmark deposited its instrument of ratification on 20 June 2014.	A local division in Copenhagen with English and Danish as the languages of proceedings is envisaged.

	<b>Ratification Process</b>	<b>Local or Regional Division</b>
<b>EE</b>	The Ministry of Justice of Estonia has made a draft law for ratification, which might still take place in 2015 but more likely at the beginning of 2016.	Estonia has concluded an agreement with Sweden, Latvia and Lithuania to set up a regional division (the "Nordic-Baltic" division) seated in Stockholm. This will enter into force when two of these countries, including at least Sweden, have ratified the UPC. The Nordic-Baltic division is expected to constitute a flexible organisation which allows for proceedings to also be held in other locations than the seat of the division. The language of the proceedings will be English with interpretation to and from the national languages.
<b>ES</b>	The main political parties in Spain are against the unitary patent package. This has not changed after the decision of the CJEU dismissing Spain's actions. The Spanish profession is divided in this respect. Since there will be general elections at the end of 2015, the position of the newly elected government needs to be awaited.	
<b>FI</b>	In Finland, the Patent Act and some other laws need to be amended before the UPCA can be ratified. There have been various stakeholder consultations and a report on the economic aspects. A draft law concerning the implementation of the UPCA has just been released for public consultation. This law will be discussed in Parliament at the end of September 2015. The instrument of ratification is expected to be deposited at the end of this year or, at the latest, at the beginning of next year. The general opinion in Finland is in favour of ratification.	Finland plans to create a local division in Helsinki with Finnish, Swedish and English as the languages of proceedings.
<b>FR</b>	France deposited its instrument of ratification on 14 March 2014.	France intends to establish a local division in Paris. It will most likely designate French and English as the languages of proceedings. There are ongoing discussions to also accept German, but it is not sure whether it will pass. This will also depend on the rule concerning the limitation of a language to certain parts of the proceedings (Rule 14 Draft RoP).
<b>GB</b>	The UK Intellectual Property Office [IPO] is currently reviewing and revising the Statutory Instrument [SI], which it will first discuss with the Law Commission. The next step is to clear policy with government. Since the SI will pass or fail in the form in which it is presented to Parliament, the IPO intends to share it with CIPA before it is published. CIPA requested to involve several knowledgeable interest groups. The UK ratification process is expected to be completed by Spring 2016.	The UK plans to have a local division in London.
<b>GR</b>	In Greece there is no progress, until now, regarding the ratification.	

	<b>Ratification Process</b>	<b>Local or Regional Division</b>
<b>HR</b>	Croatia has not made a formal decision to join the system. "Formal procedure to join has not yet been initiated, but competent authorities are currently working on analyses and preparations for the likely joining. Competent state authorities and participants in the discussions concerning this issue took the view that it is necessary to wait with the final decision until all relevant aspects of the new system are known and until some open issues of the national innovation system are resolved."	
<b>HU</b>	It is assumed that Hungary will ratify the UPCA, but it is not known when. A study on the impact of the UPC on the Hungarian economy will be conducted, according to a legal requirement.	Hungary may establish a local division with Hungarian and English as the languages of proceedings. Another option is to take part in a regional division.
<b>IE</b>	Before Ireland is able to ratify the UPCA, a referendum will be necessary. Since there will be a general election in 2016, it is not sure whether the referendum will still be held under the existing government.	If the Agreement is ratified, it is expected that a local division will be established in Ireland.
<b>IT</b>	Italy has filed a formal request with the European Commission to participate in the enhanced cooperation for the creation of unitary patent protection. This has been confirmed in a document of the EU Council (10621/15, dated 7 July 2015). The EC has four months to decide on the request.	Italy intends to have a local division with seat in Milano.
<b>LT</b>	A working document for ratification of the UPCA, which has been prepared by the Lithuanian State Patent Bureau, has been circulated in Government. It is not available to the public. Ratification is expected to take place in the autumn 2015 or the spring 2016 session of parliament.	Lithuania will take part in the "Nordic-Baltic" division (see above under "Estonia").
<b>LU</b>	Luxembourg deposited its instrument of ratification on 22 May 2015.	Luxembourg will not have a local or regional division. This means that all cases will be brought before the central division (Art 33(1) UPCA).
<b>LV</b>	There are no real obstacles in Latvia against ratification. Ratification may be postponed until the costs become clear, perhaps at the end of the year.	Latvia will take part in the "Nordic-Baltic" division (see above under "Estonia").
<b>MT</b>	Malta deposited its instrument of ratification on 9 December 2014.	Malta will not have a local or regional division. This means that all cases will be brought before the central division (Art 33(1) UPCA).
<b>NL</b>	In order to ratify the UPCA, the Dutch Patent Act needs to be amended. Together with the ratification act, this is treated as a package. After an online public consultation, some minor amendments were made to the proposal. The Council of Ministers approved the proposal. It is currently before the Council of State. Thereafter, it will be put to Parliament.	The Council of Ministers formally decided that there will be a local division in The Hague. A study commissioned by the Ministry of Economic Affairs had pointed to rather limited benefits (or even an overall cost) of having an own local division, but there are expected to be substantial indirect benefits.
<b>PL</b>	Even though Poland participated in the enhanced cooperation concerning unitary patent protection, it decided not to sign or ratify the UPCA. This position has not changed.	

	<b>Ratification Process</b>	<b>Local or Regional Division</b>
<b>PT</b>	The Portuguese Parliament approved on 10 April 2015 the accession of Portugal to the UPCA. The legislative process will follow its legal course with the referral to the Portuguese President for ratification.	
<b>RO</b>	In Romania, there are currently two points being discussed that somewhat slow the ratification process: 1) Transitory application of the UPCA. 2) Compatibility between national lawyers or judges that are going to become part-time UPC judges. However, these two points should not constitute an impediment to the ratification by Romania, which is expected to be finished by end of this year.	The preliminary option of Romania is to set up a regional division with the neighbouring states, such as Bulgaria, Greece and Cyprus, having the headquarters in Bucharest. At the present moment, however, Romania is taking into consideration other states for forming a regional division. A final decision in this respect has not yet been taken.
<b>SE</b>	Sweden deposited its instrument of ratification on 5 June 2014.	Sweden will take part in the "Nordic-Baltic" division (see above under "Estonia").
<b>SI</b>	In Slovenia an inter-ministerial group for unitary patent package was formed in July 2013, which is preparing documents for ratification of the UPCA. The ratification process is ongoing. However, the time frame for its completion is still rather undetermined. Ratification is not expected within this year.	A tripartite expert meeting with respect to forming a potential regional division was held in 2014 with the representatives of Hungary and Croatia, which expressed their interest for partnership in the regional division. Croatia would join such regional division subsequently, following the signing and ratification of the UPCA.
<b>SK</b>	The Slovak Republic has not moved to ratifying the UPCA. It will wait until the system is operational. Officials are discussing whether a study on the impact of the UPC on the Slovak economy should be conducted. There are concerns about the increase in density of patents, the level of the fees and the pro-patent approach of the UPC. The Ministry of Justice will look into the CJEU decisions.	There are no concrete steps for a local or regional division. The Ministry of Justice is involved in formal discussions with Czech colleagues in this regard. Brno has been considered as a possible seat of the local division.



## Reform of the Boards of Appeal

### epi Response to the User Consultation

On behalf of the *Ad Hoc* Group and the **epi** President, Amparo Campos Coll, **epi** Secretariat

The European Patent Office (EPO) has proposed a structural reform of the Boards of Appeal (BoA) in document CA/16/15. The goals of the reform are to increase the organizational and managerial autonomy of the BoA, the perception of their independence and their efficiency within the framework of the current EPC.

For these purposes, CA/16/15 envisages the creation of a new advisory committee of the AC (the BoAC). This would be a body within the AC, with advisory functions towards the AC and monitoring and controlling functions towards the management of the BoA such as proposing amendments to the Rules of Procedure or suggesting criteria for re-appointment based on "quality and efficiency". CA/16/15 also proposes the creation of a new position of President of the BoA to whom the President of the EPO would delegate his powers regarding appointment and management of the BoA. The paper also suggests *inter alia* the provision of a separate budget under the control of the President of the BoA, within the budget of the EPO.

In order to implement the aims set forth in CA/16/15 and to prepare concrete amendments, the EPO launched an on-line user consultation to get input from the users of the system. The **epi** created an *ad hoc* group (comprised by Ms Leissler-Gerstl, Mr Leyder and Mr Mercer) to prepare a position paper about this topic and respond to the on-line user consultation. After approval of Council, the papers prepared by the *ad hoc* group were submitted to Mr Benoît Battistelli and to Mr Jesper Kongstad on the 29<sup>th</sup> June 2015.<sup>1</sup>

#### **epi** position paper

By means of this paper, the **epi** highly welcomed the proposal for a structural reform of the BoA and considered it as a good basis for further action. The basic concept set out in the document was that the day-to-day management of the Boards of Appeal should be carried out by a Presidium, including external members and chaired by the newly-proposed President of the Boards of Appeal, with users having observer status. The Presidium would be responsible to the AC who would be represented by a BOAC, an advisory committee consisting of three members of the Administrative Council and four external members, with users having observer status. The BOAC would advise the AC since the AC would have to formally take all decisions. The position paper further envisaged that the BOAC would provide to the Presidium broad objectives to be met but would not make detailed prescriptions regarding the operation of

the Boards of Appeal. It also highlighted the importance of having a further body responsible for appointments/reappointments of members and chairmen for the Boards of Appeal and the Enlarged Board of Appeal as the presence of members of the AC in the BOAC might be seen as limiting the independence of the Boards of Appeal.

#### **epi** response to the user consultation

The EPO's online consultation was divided into five questions.

##### *Question A: Position of the Boards of Appeal – Independence*

Question A dealt with rules concerning the improvement of the appointment/re-appointment procedures, in particular to attract more external members in the BoA and the EBoA. In this regard, the **epi** proposed that responsibility for recruitment, appointment and re-appointment of members of the BoA and the EBoA will still be with the Administrative Council (AC), but a Judiciary Committee (JC), a body similar to the bodies which carry out judicial nominations in most contracting states, should support the AC and propose members for appointment/reappointment. The JC should consist of a majority of external members of judicial appointment bodies in a contracting state or for a European tribunal or court and some members of the BoA elected by their peers; users would not have observer status. The Chairman would be elected by the JC from among the external members to be appointed by the AC. The AC should, except in exceptional circumstances, accept the decisions made by the JC. (In the longer term, if the EPC is amended, the power to make decisions in this respect should be given to such a JC.) The AC could provide to the JC broad criteria regarding appointments and re-appointments. In connection with making re-appointments, the JC should take into account proposals and appraisals from the Presidium.

In relation with the attraction of more external member, the **epi** considered that it should be mandatory for external members to be present in panels of the Enlarged Board constituted for review cases, as set out in its letter of 6th February, 2015.<sup>2</sup>

<sup>1</sup> The complete version of the papers is available at the **epi** website.

<sup>2</sup> Letter sent to Mr Jesper Kongstad on the 6th February 2015 in relation with the organization of the Boards of Appeal where the **epi** proposed that a three-member panel shall always consists of one member who is one of the external members of the Enlarged Board and one legal member and one technical member from the Boards of Appeal. The letter further stated that were a need for a five-member panel may arise, a further two external members should be added to the three-member panel. In this way, in the first stage, if the external member disagrees with the internal members, the

Question A also addressed the rules regarding possible conflicts of interests. In this point the **epi** stated that the rules on conflict of interest should only require that a member of a Board has no interest in any case on which he has to make a decision. However, there does not seem to be any real difficulty in having this as the rule. It further explained that the question about conflicts of interest also relates to attracting external members. An external candidate will no doubt have a position in his or her home country, from which he or she will have to resign. No doubt, such candidates would envisage, after completing a term as a Board member, returning to his or her former position or a similar position. Therefore, the **epi** expressed that if any rules on conflict are too strict, then it would be difficult for such a person to return to his or her former position or a similar position. Therefore, any rules on conflict of interest need to be drafted to be as limited as possible to ensure that the Boards are in fact independent and are perceived to be independent. However, there should be differences between those applying to members in post and members no longer in post. Besides, the **epi** explained that the rules on conflict should not be so broad as to exclude members of the Boards taking part in general educational matters. In this context, the **epi** further considered that it is preferable to provide guidance against which Board members can judge any particular situation rather than writing a detailed rules to cover all possible situations. It also suggested that it should be possible for any Board member to consult the proposed Boards of Appeal Committee (BOAC) about any particular situation.

#### *Question B: Work of the Boards of Appeal – Efficiency*

Question B asked for suggestions about the improvement of the BOA's efficiency. The **epi** argued that this question would appear not to be linked to the independence of the BoA. In fact, it might even be seen to limit the independence of the Boards of Appeal. It thus suggested that the AC should provide the management of the Boards, which we think should be the Presidium, with suitable broad guidelines and then to require the management to report to the BOAC, if necessary with suggestions for rule changes or other measures.

To the EPO's question concerning the optimal length of the proceedings, the **epi** exposed that the length of proceedings is not directly linked to efficiency, for example in case of insufficient staffing of the Boards. Moreover it expressed that this question cannot be answered in a general sense. Each case is different and so each case has its own answers to the questions. The cases before the Boards vary from simple cases, such as some appeals from an Examining Division, where there may only be one issue and a few documents, to very complex cases, such as some appeals from an Opposition Division, where there may be many parties, many issues, large numbers of documents, many auxiliary requests

and very complicated technology. Moreover, the **epi** argued that it is not possible to judge the complexity of a file by its size. Cases with not many documents and not many issues can turn out to be very complex while a case where there is a vast amount of documentation may, in the appeal, be limited to a single point. The **epi** also referred to the technology involved. In the consumer electronics field, technology moves on very quickly. In cases in this field, the parties may want a final decision in a very short period of time. However, in the pharmaceutical field, where obtaining approval to market a new drug can take a long time, there may be no need for a decision until after the drug has been approved. The need for fast proceedings differs from case to case and **epi** suggested that more consideration should be given to a system like PACE, taking better account of the needs or even the wishes of the parties. It further stated that today, prioritization and acceleration can be requested, with variable success, but the request has to be motivated and is made public.

#### *Question C: Work of the Boards of Appeal – Procedure*

Question C asked for suggestions of improvements of the procedure before the BOA to increase their efficiency and/or predictability and transparency. The **epi** expressed again that this question would appear to have no link with the independence of the BoA. It further stated that the main problem with the procedure before the BoA is that, in fact, there are many procedures. The present Rules of Procedure contain many rules which leave each Board a large amount of discretion. This means that there are a large number of different procedures as each Board has its own procedural traditions. The **epi** thus considered that the degree of discretion the Boards have regarding procedure should be more limited. However, it acknowledged the degree to which it should be limited is difficult to gauge. The **epi** also stressed that with the new structure, any proposal made for a change of the Rules of Procedure (RoP) will be discussed in the BOAC with the involvement of users and if fundamental changes are considered, a user consultation should be held. It further argued that proposals for amendments of the RoP should come from the Presidium, possibly triggered by very general guidelines set by the BOAC. To increase involvement of all stakeholders, users should have observer status in the Presidium. At present, the RoP are drafted by the Presidium with no user involvement. By the time that the Rules reach the AC, there is very little time for any user input and generally it has no effect.

The **epi** also expressed that the one change in procedure that is considered would make a significant difference to harmonizing procedure would be to require all Boards to issue a detailed preliminary opinion before oral proceedings. This should happen in sufficient time to allow parties to withdraw their appeal whilst allowing a reallocation of the date for oral proceedings. The **epi** suggested *inter alia* that a workshop could be organized with members of BoA, users of the system and

petition proceeds to the next stage as unanimity is required for rejecting a petition at this stage. In the second stage, the majority of the panel would be external members and any perception that the panel would be biased against the petitioner would be removed.

members of judiciary panels (such as courts dealing with infringement and/or validity of patents) to analyse their respective procedures and discuss best practices.

*Question D: Boards of Appeals Committee (BOAC)*

Question D made reference to the envisaged Boards of Appeal Committee (BOAC) mentioned in CA/16/15 and asked whether the users should have a seat in it, whether this BOAC should carry out surveys among users concerning the general functioning of the BOA and whether it should make proposals for changes of the Rules of Procedure of the BOA.

In this regard, the **epi** considered that the BOAC will be an advisory sub-committee of the AC, such as the CPL, BFC or TOSC and that, as in these committees, there should be no user representatives sitting on it. Nonetheless, user representatives should be allowed as observers at meetings of the BOAC.

The **epi** further argued that no value is seen in general surveys. As noted before, all cases are different and so a general survey will not provide any useful results. It is worth pointing out that the number of attorneys who appear before BoA more than once or twice per year is relatively low. It may be less than 500. Therefore the **epi** suggested to be more sensible to have a user group, drawn from, or consisting of, attorneys who have appeared before BoA a number of times, which could

be consulted electronically by the BOAC. Such a consultation would be seen of particular value if fundamental changes are envisaged.

With regard to the possible entitlement of the BOAC to make proposals for changes to the Rules of Procedure of the Boards of Appeal, the **epi** explained that according to the EPC, the Presidium shall adopt the RoP and it is considered that most changes to the Rules of Procedure should originate with the Presidium. It therefore suggested that the BOAC should also have the possibility to initiate changes to the RoP. However such changes should then be submitted to the Presidium for opinion and discussed within the BOAC and also with user representatives before they are submitted to the AC for approval. The AC would take into account any comments of the Presidium before deciding on such changes.

*Question E: Proceedings of petitions for review*

Question E, dealt with the composition of the EBoA in review cases. In light of the criticism of having review cases dealt with solely by internal members, the **epi** considered that it should be mandatory for external members to be present in panels of the Enlarged Board constituted for review cases and stated that such appointments should be made by the Presidium.

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## New Patent Law in Spain

L. A. Durán (ES)

On July 25th, 2015 the Spanish Official Gazette has published a new Spanish Patent Law.

The new Law will not come into force until April 1st, 2017.

The new Law introduces, inter alia, the following changes:

1. It becomes compulsory to request the full substantive examination on novelty and inventive step of all Spanish patent applications. Until now, it was optional to request this substantive examination.
2. Enlarges the possibility to obtain utility models to chemical products. No utility models can be obtained for inventions relating to processes, methods, pharmaceutical and biological products. The novelty required is worldwide (before it was only in Spain). Utility models are not subjected to substantive examination on novelty and inventive step. However, oppositions on these grounds can be filed by third parties. Before enforcing a utility model, it will be required to obtain a search report on the state of the art made by the Spanish Patent and Trade Mark Office.
3. Patents of addition are abolished.
4. It will be possible to submit a protective letter to the Courts when one would foresee that the owner of a patent or utility model is likely to request a provisional injunction.
5. Incorporates into the Spanish law the provisions of several international treaties signed by Spain, like EPC 2000, PLT, PCT etc.
6. Will permit to the patent or utility model owner to restrict the claims after grant. So far it was only possible to delete claims.
7. In invalidity proceedings, it will be possible to have partial invalidation of claims. So far it was only possible to invalidate claims in its entirety.
8. Introduces privilege for all communications of Spanish Patent and Trade Mark attorneys with their clients. Privilege is extended to matters relating to patents, utility models, industrial designs, trade marks and trade names.

## Report of the By-Laws Committee (BLC)

P. Moutard (FR), Chair

Several topics were discussed on the occasion of a BLC meeting held in Munich on March 20, 2015. These topics are discussed in this report. We also discuss other issues, in particular those resulting from the recent Barcelona Council meeting.

Participants to the BLC meeting of March 20 were: Guenther Schmalz, Paolo Gerli, Michael Thesen, Dieter Speiser, Sylvain Le Vagu  re  , Pascal Moutard, Vernessa Pr  ll (**epi** Secretariat), Amparo Campos (**epi** Secretariat).

**1. Terms of reference of the Harmonisation Committee:** this committee has proposed a change of its terms of reference. There are still discussions as to the need for such amendments.

**2. epi 4.2.2.2.:** the title "European Patent Attorney" is missing in several national languages.

Paolo Gerli is still trying to collect all missing translations, in order to present a proposition to the K  ln Council meeting.

**3. The amendments to the By Laws** were on the agenda of the Barcelona Council meeting. It is reminded that, due to a tight schedule, this topic has been deleted from the agenda of the Milano Council meeting.

These amendments were all adopted by the Council in Barcelona.

**3.1.** The meeting of March 20 was an opportunity to review one more time the proposed amendments, shortly before the Barcelona Council meeting.

We refer to **epi** information 4/2014 for a complete presentation of these amendments.

**3.2.** However, 2 differences with respect to this former presentation have to be noted:

a) Concerning Art. 3.1 and Art. 13 BL: it was proposed by the BLC to maintain a reference to A 17 of the EQE regulation in art. 3.1 and to delete it from Art. 13.1.

As already explained in the **epi** information 4/2014, the EQE regulation refers clearly and explicitly to the President of the **epi**: see Art. 2(1)a, 2(1)(c)i, 2(1)(c)(ii), 4(1)(a), (b), so that it was impossible to keep a reference to these articles in Art. 3.1 of the By-Laws.

Concerning the EQE fee, the situation is different, since the EQE regulation is not so clear in this respect: Art. 17 just states that the "Institute" is consulted. The Institute is represented by its President, which was the motivation for deleting the reference to article 17 from Art. 3.1 of the By-Laws. However the powers defined in Art. 3.1 belong to the retained powers of the Council and, furthermore, the question of the EQE fee can be a "political" issue.

The former proposition was therefore amended, so that the reference to article 17 is not deleted from Art.

3.1 of the By Laws and, in Art. 13.1, references are made to Art. 2(1) and 4(1) of the EQE Regulation.

b) Concerning Art. 18.2 and 18.3 BL:

We had expressed some doubts as to the meaning of the expression "vote, actively or passively" (Art. 18.2, 3<sup>rd</sup>   ), see **epi** information 4/2014.

The "passive vote", resp. the "active vote" concerns the possibility of being elected, resp. of voting.

Some amendments to the English wording ("right of voting, actively or passively") will be examined, which will not change the scope of this article.

**3.3.** The orthography of all 3 versions (DE, FR, GB) of the By-Laws has been checked, in particular the use of capital letters in the French version.

**4. Code of Conduct** (see Supplement to OJ EPO 1/2014, 117–122): Art. 7(e) refers to A. 5b, whereas it should refer to 5a, second sentence.

The Chair of PCC was informed of this minor problem, but this committee is considering further amendments to the CoC, so that all amendments should be discussed together.

**5. epi 5.1.5, epi 4.2.4., epi 5.4.3, epi 5.3 and 3.3.1:** Minor formal amendments or adaptations of translations of these decisions have been discussed.

**6. Other issues – Future work**

- During the Barcelona Council meeting, the Presidium and the Council were reminded of A. 35 and A. 48 of the By-Laws concerning the deadline for filing documents in view of a Council meeting and the limitations applicable to motions concerning items added to the agenda in accordance with Article 37 BL or based on additional documents as referred to in Article 35 BL.
- Amendments to sections 4, 5 and 6 of the collection of decisions are currently being considered. Most of these amendments are formal ones and do not need to be decided by Council.
- The following issues form part of the future work:
  -    Should A.73 BL be amended or even deleted?
  -    Possible amendment of A. 15.4.b) BL will also be examined.
  -    During the Barcelona Council meeting, the Internal Auditors have proposed amendments to art. 16.3 BL. A joint meeting of the BLC and of the Internal Auditors will be organized.
- The BLC has been informed that general remarks were made by an external auditor, who is of the opinion that the whole collection of decisions should be simplified. Although the BLC generally agrees with the need for a simplification of the collection of decisions, absent any concrete indication about redundant or useless provisions, it is difficult to deal with such comments. It



was suggested that this external auditor should contact the Internal Auditors or the By-Laws Committee or the Secretary General.

- In A. 18 BL, the expressions “full members”/“substitute members” (of the commissions) are misleading.

These expressions are also used in connection with the Council Members (see BL, Art. 2.3 for example). Possible other expressions (in Art. 18) have to be considered.

## Report of the Litigation Committee (LitCom)

A. Casalonga (FR), Chair

### I. Appropriate qualifications and certificate for representation by European patent attorneys (EPLC)

Discussions about this question are continuing within the legal group in charge within the Preparatory Committee.

At present it seems that only a few changes are considered.

A few non-profit organisations authorized to grant the Certificate would be added, for instance, the Academy of European Law (ERA) in Trier and the European Patent Academy of the EPO.

The transitory period in Rule 12 for a request to be entered on the list would be cut down from three years to one year.

Rule 12(2) – possibility to be entered on the list if one has represented a party in patent infringement actions on his own – has not been changed. The **epi** had stressed that this rule is too limited since in many countries patent attorneys are not allowed to represent on their own in infringement cases. It should suffice to have assisted a lawyer.

This seems to be under discussion within the legal group. In case however that mere assistance of a lawyer would be accepted, the required number of infringement actions may need to be increased.

### II. Representation by EPAs from non-EU Countries

At the public hearing on the RoP in Trier on 26 November 2014 it was noted that the wording of Rule 286(1) would enable non-EU lawyers to represent parties before the UPC. Thus, a limitation based on nationality has been introduced for lawyers.

Art 1(2)(a) of Directive 98/5/EC contains an inherent limitation on who can be a lawyer. The person must be a national of a Member State. However, Rule 286(1) RoP states “by way of exception”, which means that the definition of the Directive no longer applies. For this reason, a phrase like “having the nationality of a Member State” should be inserted.

At the hearing, some members of the drafting advisory group remarked that there should be a similar limitation on nationality for EPAs.

It was decided by the **epi** Council (C78) that LitCom would prepare a paper stating that representation should not be restricted to EPAs from EU Member States. Arguments for this position are that a lawyer’s title is per definition granted by national law, whereas the qualification as EPA is based on the EPC and thus concerns a unified profession. Art 48(2) UPCA does not include any limitation on nationality. It merely refers to EPAs who are entitled to act as professional representatives before the EPO pursuant to Art 134 EPC and who have appropriate qualifications such as a EPLC.

The LitCom prepared this paper but, after discussion, decided to wait before submitting the paper. In fact, the Preparatory Committee appears to be in line with the **epi**’s opinion. This is reflected by the wording of Rule 286 in the 18<sup>th</sup> draft of Rules of Procedure before the UPC, recently issued, which is satisfactory in regard of this question.

### III. Consultation on Court Fees and Recoverable Costs

The present consultation document on the Rules on Court fees and recoverable costs, which also includes a table of the proposed fees and ceilings for recoverable costs, differs from the previous draft in that for some procedures and actions only a fixed fee and no value-based fee is required, for instance, for a revocation action and counterclaim for revocation.

Two alternatives are proposed in the document. Alternative 1 foresees reimbursements of fees in case of a single judge (R. 370(6)(a)), withdrawal (R. 370(6)(b)) or settlement (R. 370(6)(c)). Alternative 2 contains an exemption of value-based fees for certain legal persons, such as SMEs. Alternative 1 benefits the system by encouraging certain behaviour, while Alternative 2 supports SMEs.

After discussion, The LitCom considered that these two alternatives should be combined.

The LitCom debated the proposed ceilings for the recoverable costs. These apply per instance and party and are hence not dependent on the number of representatives.

After discussion, the LitCom decided that the ceiling should be less progressive. Where the value of the action is more than 30 Million, the ceiling should be 1,5 Million and not 3 Million as proposed in the draft. This would also be in line with the table for the value-based fees.

The recoverable costs and the value of the dispute if there are multiple parties on one side was also discussed. This could happen for instance, in the case of generic companies in a pharmaceutical case that file a revocation action. It was suggested that the UPC should carefully consider such situations of multiple parties in the assessment under Rule 152 which provides that only "reasonable and proportionate costs for representation" can be recovered.

A draft **epi** position paper was prepared on the basis of the discussion held during the meeting of the Litigation Committee. This draft was approved by the President of the **epi** and posted in due time on the UPC website in answer to the consultation. (this paper is available on the **epi** website)

#### IV. Code of Conduct for UPC Representatives

The Preparatory Committee intends to attach a Code of Conduct (CoC) to the Rules of Procedure (see Rule 290(2)). Within the **epi**, the Professional Conduct Committee (PCC) takes the lead in this regard. The Litigation Committee may assist the PCC by providing ideas and reviewing the draft.

A fundamental question is whether to have separate Codes for lawyers and EPAs or a unified CoC. Furthermore, it must be decided whether there should be a stand alone CoC or a complementary CoC with reference to the existing Codes.

The Litigation Committee is in favor of a single CoC for both lawyers and EPAs. An independent disciplinary body for violations of this code should also be considered.

It was noted that Art 48(3) UPCA only provides for a list of EPAs kept by the UPC Registrar. There is no such list for lawyers (Rule 286 RoP does not foresee any legal consequences). Thus, it is not possible to strike lawyers from the list of representatives. However, according to Rule 291 RoP, a representative may be excluded from proceedings.

It was also stressed that the UPC CoC should address the specific situation of representatives working in industry.

## Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 12.08.2015 covers the period since my previous report dated 07.05.2015.

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 reserved for other committees: Biotech, OCC, PDC, LitCom, and EPO Finances.

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

### 1. Independence of the Boards of Appeal

At the AC meeting of 25-26.03.2015, there was presented a paper (CA/16/15) submitted by the President of the EPO, entitled "Proposal for a structural reform of the

EPO Boards of Appeal (BOA)". On behalf of **epi**, our delegates to the AC meeting expressed that we would not support moving the Boards, even less outside Munich, and that we would need more time to review in detail these proposals

Paper CA/16/15 has been included in the accumulated file for C78, with a request for comments by Council members. An *ad hoc* working group has been set, which prepared a draft answer. Mr Kongstad, Chairman of the Administrative Council, agreed to a meeting on 15.06.2015 with a delegation of **epi**, headed by our President, to exchange views. The final draft was submitted to the EPPC for review. The **epi** response to the consultation is published in this issue.

The *ad hoc* working group will shortly review the Questionnaire on the Reform of the Boards of Appeal of the Association of the Members of the Boards of Appeal of the EPO (available on the AMBA website <http://www.amba-epo.org/reform>).

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

The 14<sup>th</sup> SC meeting (26.–27.5.2015) dealt with various financial issues and (in closed session) the distribution key. The SC held an exchange of views on an outline of possible provisions for the Rules relating to Fees for Unitary Patent Protection (RFeesUPP)

The 15<sup>th</sup> SC meeting (23.–24.6.2015) dealt with the level of renewal fees, a proposal on the level of renewal fees, draft Rules relating to Fees for the unitary patent, a safety net provision for late rejections' of a UPP request, and (again in closed session), the distribution key. The SC endorsed the "True Top 4" proposal wherein the renewal fees applicable to the unitary patent correspond to the sum of the renewal fees currently paid for the four participating Member States in which European patents are most frequently validated today (DE, FR, GB, NL).

The 16<sup>th</sup> SC meeting was planned in September, but has been postponed to 13.–14.10.2015 to take into account the request of Italy to join the enhanced cooperation. It is expected that the whole package, comprising the level of renewal fees and the distribution key, can be finalised and adopted in the autumn.

## 3. Committee on Patent Law

The 45<sup>th</sup> meeting of the Committee on Patent Law (CPL45) will take place on 15.9.2015.

The draft agenda was not yet available at the time of finalising this report, however I expect the amendment of Rule 82 EPC discussed at the 12<sup>th</sup> meeting of the Working Party on Rules to be submitted to the CPL. This amendment relates to the requirement for typed documents in opposition: it is proposed to add a third sentence to Rule 82(2) EPC *"Where decisions under to Article 106(2) or Article 111(2) have been based on documents not complying with Rule 49(8) the proprietor of the patent shall be invited to file them within the three month time period."*

## 4. Thematic groups

Two thematic groups are up and running: one in the field of Pure and Applied Organic Chemistry (PAOC), which includes medical uses, the other in the field of Computer-Implemented Inventions (CII). The fields covered by thematic groups should correspond to Principal Directorates: the CII group is thus being expanded to Information and communications technology (ICT). A meeting with directors in the field of PAOC took place on 9.6.2015; the draft report is still to be agreed. A meeting with directors in the field of ICT will take place on 2.12.2015.

Thematic groups are normally composed with EPPC members. Since we appear not to have enough members to set up all thematic groups, my call for

candidates amongst the Council members is still open: Council members who are specialising in one of the other technical fields are kindly invited to contact me at [eppc@patentepi.com](mailto:eppc@patentepi.com).

## 5. Guidelines

The Guidelines Sub-Committee will meet in the offices of its chair, on 26.–27.8.2015. The meeting will be longer than usual, because the EPO has submitted for our review a separate set of Guidelines for PCT procedures before the EPO.

The Guidelines Sub-Committee would like to remind all **epi** members that we appreciate any comments/suggestions at any time during the year; please send them to its attention at [eppc@patentepi.com](mailto:eppc@patentepi.com).

## 6. PCT WG

The PCT Working Group was established by the PCT Assembly to do preparatory work for matters, which require submission to the Assembly. Since 2008, the Working Group meets once a year in Geneva. The 8<sup>th</sup> Session of the WG took place in Geneva, on 26.–9.5.2015. The documents relating to this session, including the Summary by the Chair, are available on the WIPO website:

[http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=35593](http://www.wipo.int/meetings/en/details.jsp?meeting_id=35593)

It is recalled that Council approved a position on "National phase entry using ePCT" during its meeting in Barcelona on 25.04.2015 (the position was published in issue 2/2015 of **epi** Information). The Summary by the Chair reported as follows about this agenda item:

97. The Working Group noted that the International Bureau intended to prepare a first draft interface in the Demo ePCT environment, likely in autumn 2015, which would help to inform more concrete discussions with potential pilot Offices and users. It further noted the intention of the International Bureau to invite participation by pilot Offices and users, by way of a PCT Circular, in the near future.

## 7. MSBA

The series of consultative meetings of user representatives with the Boards of Appeal will continue with the 22<sup>nd</sup> MSBA (Meeting of SACEPO with the Boards of Appeal) on 7.10.2015.

One of the topics of the meeting will be the current proposals for the institutional reform of DG3. Another will no doubt be the paper "Increasing Formalism in Appeal Proceedings – The EPO Boards of Appeal Headed to a Mere Reviewing Instance?" by G. Anetsberger *et al.* published in **epi** Information (issue 2/2015, pp. 63-70). The other topics were not yet known at the time of finalising this report.



## Report of the Harmonisation Committee (HC)

F. Leyder (BE), Secretary

This report completed on 10 August 2015 covers the period since my previous report dated 12 May 2015.

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

### 22<sup>nd</sup> Session of the SCP

The 22<sup>nd</sup> session of the Standing Committee on the Law of Patents (SCP 22) was held in Geneva, from the 27<sup>th</sup> to the 31<sup>st</sup> of July 2015, **epi** was represented.

The WIPO Secretariat presented a Study on the various international interpretations and applications of the inventive step requirement and a Study on the various international interpretations and applications of the sufficiency of disclosure requirement.

The meeting papers, including the two presentations shown during the meeting and the Summary by the Chair, are available on the WIPO website:

[http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=35591](http://www.wipo.int/meetings/en/details.jsp?meeting_id=35591)

The Standing Committee agreed that it would continue in a fact-finding capacity only and would not pursue harmonisation objectives at this stage.

### 23<sup>rd</sup> Session of the SCP

At the end of SCP 22, no dates were given for the 23<sup>rd</sup> session of the Standing Committee on the Law of Patents (SCP 23).

### Nächste Ausgaben · Forthcoming issues · Prochaine éditions

#### Issue

4/2015

#### Deadline

November 6, 2015

#### Publication

December 31, 2015

## Guidelines2day seminar in Warsaw

D. Lecomte (FR)

On 9<sup>th</sup> June 2015, I've had the honour and pleasure to speak as **epi** member at the seminar Guidelines2day and Article 123(2) EPC in Warsaw. This seminar is organised by the European Patent Academy in collaboration with the **epi**. It took the whole day and focused on four main topics: the new Guidelines, changes in the procedures with the EPO, developments in computer implemented inventions and Article 123(2) EPC. Each topic was presented by an EPO speaker with brief interventions of myself as representative of the patent attorney profession. I have also presented the last session consisting of

illustrative examples of application of the requirements of Article 123(2) EPC. The seminar was manifold and well perceived by the audience. I would like to thank and congratulate those who have carefully prepared the presentation material. The roadshow 2015 comprises 12 dates, six of which are already passed. The remaining dates are in Munich on 1<sup>st</sup> September, London on 21<sup>st</sup> September, Paris on 12<sup>th</sup> October, Madrid on 20<sup>th</sup> October, Istanbul on 14<sup>th</sup> November and Milan on 1<sup>st</sup> December. See you in Paris.

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## EPO update on Early Certainty from Search

### European Patent Office

**Abstract:** A year after its launch in July 2014, the new workload prioritisation program for EPO examiners "Early Certainty from Search" is having an impact. The EPO's efforts to improve timeliness and overall procedural duration aim at supporting legal certainty and strengthening the European patent system. The EPO provides insight on its internal work priorities.

On 1<sup>st</sup> July 2014 the European Patent Office launched a project called Early Certainty from Search (ECfS) aimed at optimising the use of examiners' resources to better serve users' interests. In particular the focus is on maximising legal certainty in Europe on pending patent applications early in the process.

Like most patent offices around the world, the EPO has seen significant growth in filings in the past decade. In 2014, the Office received 274,174 filings, an increase of 3.1% compared to 2013. If recent trends continue, the 300,000 filings a year mark will soon be passed. Such a growth is a major challenge for the Office and the European patent system at large. Focussing on the core work and improving efficiency of both processes and IT systems are ongoing measures contributing to the improved timeliness. However, examiners' workload should be structured so that the impact on legal certainty is minimised.

The Early Certainty from Search program builds on earlier projects at the Office, notably the "Raising the Bar" changes introduced in 2010 and 2011 and the introduction of the extended European search report in 2005. Applicants not only receive a high quality search report but also a written opinion which is de facto a preliminary examination on the patentability of the subject matter in the application. Most users report that these combined measures are very much appreciated in the patent world. With early and timely issuance of the opinion, applicants are in a better position to decide whether to pursue substantive examination of their application and if so on which basis. "Early Certainty from Search" also benefits third parties and the public in general, as search results are made available with the publication of the application at 18 months. This will ensure a better and earlier assessment of the risks and opportunities surrounding pending applications. Moreover with Early Certainty from Search third parties have means to accelerate examination on cases important to them by filing substantiated and non-anonymous third-party observations.

In a nutshell, the internal prioritisation principles implemented with Early Certainty from Search are the following:

- (1) Issue all search reports and written opinions on patentability within six months.
- (2) Prioritise completion of examination files already started over beginning examination work on new files;

(3) Expedite grants once a positive search opinion has been received;

(4) Ensure effective implementation of PACE and provide accelerated file prosecution when substantiated and non-anonymous third-party observations are filed.

This leads generally to the following goal for processing times:

(1) Search reports:

- EP first filings: **6 months** after filing date
- PCT chapter I searches: **3 months** after reception of the search copy
- EP direct second filings: **6 months** after filing for publication at 18 months as A1
- Euro-PCT where the EPO was not ISA: supplementary EP search **6 months** after entry into regional phase or after reply to Rule 161 EPC communication (whichever is the later);

(2) Further examination action: 4 months after applicant's reply

The new scheme will ensure effective acceleration, when requested by applicants, under PACE. Currently PACE is requested for about 7% of all applications (7600 searches and 12600 examination files). In examination a communication should be issued within 3 months from the reception of the PACE request. The current average is 6 months but improving. Filings for which the patent prosecution highway is used will benefit from a similar acceleration as PACE.

### Third party observations

New in Early Certainty from Search is that also third parties, without becoming a party to the proceedings, have now the possibility to trigger acceleration of the procedure. A similar effect as with PACE can be expected when third parties file substantiated and non-anonymous observations under Article 115 EPC. It is worth noticing that 75% of third party observations are considered and used by examining divisions and in 50% of the cases, third party observations directly lead to restriction of the scope of protection or even refusal.

During the consultation of users' associations which preceded the decision to implement ECfS, some user representatives expressed concerns regarding potential misuse of the acceleration possibility offered to third parties. Filing of third party observations is closely monitored and to date this risk did not materialise.

### Effects today

At the end of the second quarter of 2015, all key performance indicators linked to the ECfS timeliness show significant improvements. Currently 87,1% of international search reports are delivered on time for

publication at 18 months (N.B. Quality indicators are also available on the EPO website from the following link (<http://www.epo.org/about-us/office/quality/quality-indicators.html>))

and show the trends on a 12 months rolling period. They are now updated on a quarterly basis). The number of applications delayed with respect to the pendency objectives is steadily decreasing.

The applicant benefits are, with the search result and the opinion, a maximum legal certainty and early visibility for defining strategy. There are advantages for the public and for third parties, as an overview of prior art and

patentability is provided at 18 months across the board, with blind spots being minimised. Third parties have the chance to accelerate the procedure on cases important to them. Therefore the overall service to applicants and the public is improved.

Following initial positive reactions from patent attorneys in Europe during 2014, the effectiveness of Early Certainty from Search is proving itself in 2015. A year after its introduction, the new workload prioritisation program for examiners is producing results and the EPO is well on track to deliver according to the ECfS goals set.

## Contact Data of Legal Division

### Update of the European Patent Attorneys database

Please send any change of contact details using EPO Form 52301 (Request for changes in the list of professional representatives: <http://www.epo.org/applying/online-services/representatives.html>) to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 523 of any change in your contact details.

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

European Patent Office  
Dir. 5.2.3  
Legal Division  
80298 Munich  
Germany  
Tel.: +49 (0)89 2399-5231  
Fax: +49 (0)89 2399-5148  
[legaldivision@epo.org](mailto:legaldivision@epo.org)  
[www.epo.org](http://www.epo.org)

Thank you for your cooperation.

## General Information

### Unreliable agents

Please note that the **epi** has been made aware that some of our patent attorney firms in Europe have been entrusted with work by one or more unreliable agents from outside Europe. Apparently, the firm was entrusted with a series of applications, but after a while invoices were no longer paid, and applications were transferred away to another European patent attorney firm.

The **epi** is not in the position to verify these situations and therefore strongly advises its members to follow the rules set forth in the Code of Conduct of the Institute of

Professional Representatives before the European Patent Office. According to Rule 5(d) of the Code, whenever a member is instructed by a client to take over the handling of a case from another member, the member so instructed shall ensure that the other member is informed. Such other member shall without delay, loan or transfer all necessary information for the handling of the case. This practice would certainly allow the **epi** members to be warned about unreliable agents while taking over new cases.

## Next Board and Council Meetings

### Board Meetings

94<sup>th</sup> Board meeting on March 12, 2016 in Tallinn (EE)

### Council Meetings

79<sup>th</sup> Council meeting on November 14, 2015 in Cologne (DE)

80<sup>th</sup> Council meeting on April 30, 2016 in Athens (GR)

81<sup>th</sup> Council meeting on November 12, 2016 in Berlin (DE)

82<sup>th</sup> Council meeting on April 24/25, 2017 in Munich (DE)

### Nächster Redaktionsschluss für **epi** Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **6. November 2015**. 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 **6<sup>th</sup> November 2015**. 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 **6 novembre 2015**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

## R 0016/13 – A truly positive decision!

Dr. E. Ehlich (DE)<sup>1</sup>

### Abstract

The EPC 2000 introduced an extraordinary means of redress against decisions of the Boards of Appeal. Since then the Enlarged Board of Appeal no longer decides in an only abstract manner on questions referred to it, but in specific cases whether fundamental procedural rights, in particular the right to be heard, have been respected or not. The number of decisions on the subject now runs into three figures, but only very few cases have been decided in favour of the petitioner. R 0016/13 is one of these and the first providing detailed positive guidelines for compliance with the right to be heard.

### I. Introduction

It is now almost eight years since the EPC 2000 introduced an extraordinary means of redress against decisions of the Boards of Appeal. According to the law applicable until that time, *i.e.* under the EPC 1973, there was simply no legal remedy against decisions of the Boards of Appeal. The decisions of the Boards of Appeal were always truly final under the old law. Article 112a EPC 2000 now opens up the possibility of filing a petition for review of decisions of the Boards of Appeal by the Enlarged Board of Appeal based on a number of selected grounds, which are substantially limited to compliance with the fundamental procedural rights of the parties. A successful petition cancels the final nature of a decision of the Boards of Appeal and it is therefore no longer completely *res judicata*. It is not surprising that, even if narrow limits are placed on this means of redress, its effects in practice are far-reaching. First of all, the Enlarged Board of Appeal has been given a completely new task, namely that of monitoring fundamental procedural rights, and hence now has sovereignty over the definition of those fundamental rights under the EPC in individual cases. The Enlarged Board of Appeal thus no longer decides in an only abstract manner on questions referred to it,<sup>2</sup> but now decides in specific cases whether those fundamental rights have been respected or not.<sup>3</sup> Secondly, it is now the parties who have the freedom to play an active role in having a question of fundamental procedural rights reviewed by the Enlarged Board of Appeal in petition proceedings, rather than the Boards of Appeal, which under the old law ultimately always decided for themselves whether to refer a question to the Enlarged Board of Appeal and how to apply it in the case at issue.

### II. The importance of Article 112a EPC 2000

When Article 112a EPC 2000 was introduced, it was made clear that the field of application of the new means of redress was limited to decisions that had been handed down on the basis of intolerable situations. The intention was to avoid, at all costs, configuring the new petition proceedings as a further instance.<sup>4</sup> Considering the reasons for the impugned decision *per se* must therefore be avoided without exception. The strict criterion therefore applies that solely procedural errors may constitute grounds for a petition for review.<sup>5</sup>

By far the most important ground for review in practice is Article 112a (2) c) EPC, namely the existence of a fundamental violation of the right to be heard enshrined in Article 113 EPC. Article 112a (2) c) EPC is limited to "fundamental" violations of Article 113 EPC, which has so far been interpreted to require that a defect only leads to an intolerable situation of this kind if it is also causal for the decision,<sup>6</sup> *i.e.* the decision could not survive had it not been for these grounds based on the procedural defect.

Article 113 (1) EPC is directed towards the right to be heard, but at the same time it is also the basis in the EPC for the principle of the right to a fair trial, which is recognised in all the Member States and is laid down in the European Convention on Human Rights.<sup>7</sup> It is thus of far-reaching importance as the central guarantee of fundamental procedural rights under the EPC. Article 113 (1) EPC stipulates that decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This is intended to ensure that the parties are not taken by surprise by a decision, and above all to guarantee that the parties can play an active role in considering the facts and legal issues in dispute. This guarantees a fair opportunity for attack and defence and ensures that a party does not become a mere object of the proceedings. First of all it is clear that a violation of this principle protected in Article 113 EPC leads to intolerable situations and is thus always fundamental. Additionally, Article 113 EPC already makes clear that the defect needs to be firmly linked to the decision<sup>8</sup> and is already therefore always fundamental. The requirement of a "fundamental" violation of Article 113 EPC in Article 112a (2) c) EPC seems to be more a confirmation than a further condition. In essence Article 112a (2) c)

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2 To answer questions of fundamental importance referred under Article 112 EPC had been the only task of the Enlarged Board of Appeal under the old law

3 Petition for review filed by a party under new Article 112a EPC

4 Travaux Préparatoires MR/2/00 of 13th October, 2000, and CA/PL 17/00

5 Peter Messerli, GRUR 2001, 979

6 R 0001/08, Reason No. 3, regarding the so-called causal link

7 ECHR Article 6

8 Article 113(1) EPC already requires a causal link between the defect and the decision



EPC protects the principle enshrined in Article 113 EPC, no more and no less.

It may justifiably be claimed that the basic procedural principle enshrined in Article 113 EPC and Article 6 ECHR and given particular protection in Article 112a (2) c) EPC is something which ought normally to be taken for granted in our society and hence does not require any further discussion. However, the appropriate and correct organisation of the procedure in a particular case and above all the definition of the limits between tolerable circumstances and circumstances which are no longer tolerable is not quite so obvious. On top of that these aspects have a considerable influence on the practical organisation of the proceedings by the Boards of Appeal and by the parties, *i.e.* the necessity of a communication accompanying the summons and the provision of an adequate opportunity for response thereto, the documentation of oral proceedings, the decisions on postponements of oral proceedings and the decisions on rejections of late filed requests, evidence and arguments on the side of the Boards of Appeal<sup>9</sup> and the timing as well as the dimensions of the preparation of evidence, facts, arguments and requests on the side of the parties.<sup>10</sup> There is a need for a reliable guidance, as it were, which the parties to proceedings before the EPO can follow, the definition of which is now a task assigned to the Enlarged Board of Appeal. A too strict approach towards the parties is in danger of lowering the standard of the right to be heard and thus in danger of lowering transparency and predictability of proceedings, thereby burdening the parties with uncertainties, since it not only limits the applicability of Article 112a EPC but also creates a restrictive case law on Article 113 EPC in appeal proceedings as such.

In addition, it must be borne in mind that the fundamental procedural rights apply equally in all stages of procedure under the EPC; so that Article 113 EPC, for example, does not take on a different scope, depending on whether the proceedings are conducted before an Examining Division, an Opposition Division or a Board of Appeal. In the long term, the case law of the Enlarged Board of Appeal will thus define the contours of the right to be heard for all proceedings before the EPO and may thus have much more impact than initially intended. A too strict approach towards the parties may cause an erosion of fundamental procedural rights in principle in proceedings before the EPO.

So far, the case law of the Enlarged Board of Appeal in proceedings under Article 112a EPC since the beginnings in 2008 has been perceived as rather restrictive and formalistic.<sup>11,12</sup> With the decision recently handed down in case R 0016/13, the Enlarged Board of Appeal has countered this restrictive and formalistic impression

with a ruling that now establishes in detail important contours for the right to be heard.

### III. R 0016/13, the constellation of the case

The case underlying the decision was concerned with the question of inventive step in opposition appeal proceedings. As evidence of an inventive step, the patent proprietor had filed a document with comparative experiments *vis-à-vis* the state of the art and had based himself on the technical effect shown there of the products in accordance with the invention compared to those of the state of the art.<sup>13</sup> Those experimental data had clearly never been doubted throughout the entire proceedings.<sup>14</sup> In the oral proceedings, those experimental data were only discussed in general terms and the opponent did not doubt them. Following the discussion the main request was rejected for lack of inventive step. The patent proprietor was taken by surprise by that decision, and asked for the grounds, but seemingly did not receive any indications as to the reasons until after the decision on the first auxiliary request was announced, which was likewise negative, and he did not become aware of the details until he received the written decision.<sup>15</sup> The written reasons given by the Board of Appeal for revoking the patent were that the comparative data were incomplete and could not therefore support an inventive step.<sup>16</sup> According to the patent proprietor, that assessment was based on a misunderstanding, which he was unable to clarify or respond to by means of auxiliary requests, because he was unaware of the reasons.<sup>17</sup> The patent proprietor thereupon filed a petition for review under Article 112a (2) c) EPC, *i.e.* on the grounds of a fundamental violation of his right to be heard. That petition was considered allowable by the Enlarged Board of Appeal. For a petition, and in particular this petition, to be allowable, the decisive criterion is the amount of information – or to use the wording of Art. 113 EPC: the level of detail of the grounds or evidence on which the decision is based – to which a party has a procedural entitlement before the decision is reached and thus affects the definition of and the specific form given to the term “grounds” in Article 113 (1) EPC. The reasoning is presented in the following against the backdrop of the case law so far.

### IV. The case law of the Enlarged Board of Appeal so far

First of all, the entitlement to information just referred to appears to have been shaped by the first R decision R 0001/08 more than by any other decision. That decision was likewise occasioned by a decision in opposition appeal proceedings, revoking a patent. The decision of

9 On the one hand there may be limits to the discretion of the Boards of Appeal regarding procedural decisions and there may be certain procedural obligations on the Boards of Appeal

10 On the other hand there may be an obligation on the parties to file voluminous precautionary evidence, arguments and requests

11 H. Wegener, P.K. Hess, epi information 1/2014, pages 32 to 37

12 R. Teschemacher, Mitt. 2009 pages 297 to 302

13 R 0016/13 Summary of Facts and Submissions I, 4, the effect is improved storage stability of the micronised and conditioned tiotropium bromide of the invention

14 R 0016/13 Summary of Facts and Submissions I, 5 and 6

15 R 0016/13 Summary of Facts and Submissions I, 7

16 R 0016/13 Summary of Facts and Submissions I, 2

17 R 0016/13 Summary of Facts and Submissions II, 1

the Board of Appeal was based on a main request and an auxiliary request. Until the conclusion of the oral proceedings before the Board of Appeal, neither the opponent, who did not attend the oral proceedings, nor the Board of Appeal had commented on the auxiliary request. The patent proprietor was merely invited to state his position on inventive step in the context of the main and auxiliary requests. Only in the written decision, the grounds for revocation of the patent in its entirety based on Article 56 EPC were set forth.<sup>18</sup> The patent proprietor thereupon filed a petition for review in accordance with Article 112a (2) c) EPC. The Enlarged Board of Appeal observed on this subject that a petition under Article 112a (2) c) EPC could only be successful if it was shown, firstly, that the decision was based on an analysis or reasoning relating to grounds of which the party adversely affected by the decision was unaware or on which it had not had an opportunity to comment, and, secondly, if it was shown that that procedural defect was causal for the decision.<sup>19</sup> Applying this principle to the underlying facts of the case, the Enlarged Board of Appeal arrived at the conclusion that there was a direct link between the reasons given by the Board of Appeal and the patent proprietor's arguments and that they were therefore based on grounds on which the patent proprietor had had an opportunity to comment. It further noted that the EPC did not contain any provision obliging a Board of Appeal to inform the parties about all the foreseeable arguments for and against a request. The Board of Appeal's line of reasoning on inventive step corresponded to the classic approach and was therefore foreseeable.<sup>20</sup>

According to decision R 0001/08, the right to information on the grounds would appear to be largely limited to their legal basis in the EPC, *i.e.* in the case underlying decision R 0001/08: Article 56 EPC. All aspects relating to the legal basis are deemed to be foreseeable, and a party must not be surprised by them. This reading of R 0001/08 seems to be confirmed by the fact that in all the other comparable cases so far decided by the Enlarged Board of Appeal, except two,<sup>21</sup> no deficiency in the information was found.

Such a restrictive reading of Article 113 (1) EPC burdens the parties with a high degree of unpredictability and uncertainty. Furthermore, such a reading of Article 113 (1) EPC is in contradiction with the definition of the right to be heard according to the case law of the Boards of Appeal regarding the first instance, according to which the grounds include not only the legal basis in the EPC, but also the most important considerations regarding the facts and legal issues.<sup>22</sup>

## V. R 0016/13, the reasoning

For its reasoning, the Enlarged Board of Appeal takes the principles laid down in R 0001/08<sup>23</sup> as its point of departure and concludes from that that a Board of Appeal does not need explicitly to address all the considerations taken into account in the later decision, provided that their relevance at least became clear and that a party with technical expertise and training in patent law can be expected to realise their importance. It goes on to state on the basis of the case law that these principles must be applied not only to the grounds in their entirety, but also to part-aspects.<sup>24</sup> The Enlarged Board of Appeal then emphasises the fact that the parties must be given an opportunity to comment on the aspects on which the decision is based, by ensuring that they are addressed in the appeal proceedings and therefore cannot surprise the parties.<sup>25</sup> The emphasis now no longer appears to be placed on the foreseeability of all aspects, which, as held in decision R 0001/08 and seemingly until now never in fact contested, can be assumed without any further consideration, but rather on the requirement that those aspects have actually been addressed. R 0016/13 is the first decision which acknowledges a violation of the right to be heard based on a lack of information regarding a specific aspect. In view of R 0016/13 it is now clear that the grounds mentioned in Article 113 (1) EPC relate not only to the legal basis in the EPC, but also to the aspects on which the decision is based, *i.e.* the most important considerations regarding the facts and legal issues as the Boards of Appeal have already ruled for the first instance. This means that the right to be heard is now expressly defined more positively for proceedings before the Boards of Appeal and a uniform application of Article 113 (1) EPC is ensured for all instances. Thereby the procedural rights of the parties are strengthened and uncertainties are reduced.

## VI. R 0016/13, *ex officio* reasoning

In assessing the facts of the case, the Enlarged Board of Appeal also discusses a problem in connection with Article 113 (1) EPC, which is repeatedly raised in proceedings under Article 112a (2) c) EPC, namely the relationship between Article 113 (1) EPC, the protection of the right to be heard, and Article 114 (1) EPC, the principle of examination by the EPO of its own motion.<sup>26</sup> It acknowledged that it is not difficult to understand that difficulties in *inter partes* proceedings usually arise when a Board of Appeal bases its decision on grounds that have not been raised by either of the parties and when the Board of Appeal has not itself explicitly informed the

18 R 0001/08, Summary of Facts and Submissions III to VI

19 R 0001/08, Reasons No. 3

20 R 0001/08, Reasons No. 3.1

21 These decisions are R 0015/11 and R 3/10, wherein Article 84 EPC and Article 56 EPC, respectively, were the basis for revocation but not communicated to the parties, the remaining two positive decisions are concerned with different subject matter *i.e.* R 0007/09 was concerned with a mailing mistake and R 0021/11 was concerned with failure to decide on a request

22 Case law of the Boards of Appeal of the EPO 7<sup>th</sup> edition 2013, III.B.1. 1.2, first paragraph

23 R 0001/08, Reasons No. 3 and 3.1

24 R 0016/13, Reasons No. 3.2, a specific part-aspect (or aspect) of the grounds could be for example an interpretation of a passage in the prior art as in cited R 0019/11. None of the cited R-decisions and in fact none at all so far in fact acknowledged a violation of the right to be heard based on a part-aspect

25 R 0016/13, Reasons No. 3.3 with reference to R 0021/10, R 0015/09 and R 0003/13

26 R 0016/13, Reasons No. 4



parties of these *ex officio* grounds which have not been addressed by anyone.<sup>27</sup> In R 0016/13 the Enlarged Board of Appeal arrives at the conclusion that the impugned decision is largely based on the Board of Appeal's own considerations and hence on *ex officio* grounds for the purposes of Article 114 (1) EPC.<sup>28</sup> It is emphasised that there is of course nothing objectionable in principle about grounds on the part of the Board of Appeal under Article 114 (1) EPC, but that those *ex officio* grounds must then be brought to the attention of the parties in the communication accompanying the summons or at the latest in the oral proceedings. The Enlarged Board of Appeal goes on to state that the only time when this does not apply is when there can be no doubt that the party was able to recognise the Board's line of argument concerned. In contrast to the reasoning in R 0001/08 and previous case law this reasoning of R 0016/13 seems to be related to exceptions only and requires clear evidence. The party in R 0016/13 was regarded to have been unable to recognise for itself these own considerations on the part of the Board of Appeal, and in particular it was regarded not sufficient for the documents underlying the line of argument in question to be merely mentioned in the communication accompanying the summons. Finally, the ruling held that another reason why the line of argument in question could not be recognised was that the party asked in vain for the reasoning behind the decision when it was taken by surprise by the negative decision, and it ought to have been obvious to the Board that the party was unclear about the Board's grounds.<sup>29</sup> According to that reasoning of the Enlarged Board of Appeal, the parties can now rely on having their attention specifically drawn to the *ex officio* considerations central to the decision, and in particular a party which is obviously and demonstrably baffled must not be left in the dark. It may be further considered that normally the relevant information will already be contained in the communication accompanying the summons, because if it is notified at the last possible moment, namely during the oral proceedings, the new *ex officio* grounds would, depending on their complexity, lead to a postponement that could otherwise have been avoided.

## VII. R 0016/13, further possible implications

A further reason for mentioning new *ex officio* grounds no later than in the communication accompanying the summons is presumably the problem of proof concerning the events during oral proceedings.<sup>30</sup> In the case underlying R 0016/13, there were seemingly no differences of opinion regarding the events during the oral proceedings and hence no problem of evidence. The question of the burden of proof is therefore left open by

the Enlarged Board of Appeal. As a matter of principle, however, it should be noted that the minutes of the oral proceedings tend to be kept fairly brief and there are usually no detailed records or verbatim recordings, and the party has no right to them. Furthermore, the parties do not have any direct influence on the minutes or on the facts and submission part of the decision.<sup>31</sup> Objective evidence concerning the events during the oral proceedings is thus not available as a rule. It should be considered whether the party negatively affected ought to benefit from a reversal of the burden of proof in that a petition for review should be allowed unless it can be established beyond doubt that the party concerned had positive knowledge of the grounds in question. A complete written preparation of the oral proceedings including a communication accompanying the summons mentioning clearly all relevant aspects and an adequate opportunity for response thereto would not only avoid the evidence problem in petition proceedings but at the same time also eliminate most reasons for petitions as such. Such an approach would also be in line with the spirit of Rule 116 EPC and Articles 12, 13 and 14 of the Rules of Procedure of the Boards of Appeal of the European Patent Office and thus help to concentrate the proceedings on the points considered essential and thereby enhance efficiency.<sup>32</sup> It has been recently suggested that in particular an obligation to pre-emptively prepare a defence of a patent as early as possible in all possible directions in view of later potential preclusion unnecessarily blows up a case and works against efficiency and the initial good intentions behind the Rules of Procedure.<sup>33</sup> Late raised *ex officio* objections create in particular difficult procedural situations to manage and uncertainties if not communicated clearly and/or combined with preclusion. The mere threat of being exposed to such late raised or even never expressly communicated *ex officio* objections must lead to even more precautionary expanded arguments and auxiliary requests which to a great extent may later turn out to be unnecessary, are no guarantee for the right to be heard and simply burden the proceedings. In summary, procedural uncertainties are not only detrimental to the fundamental procedural rights but also to efficiency.

Disputes over patents deal with complex legal and factual aspects which are rarely foreseeable in their entirety. This does not mean that full reasons need to be given at any point in time before the written decision. But all aspects relevant for the decision need to be transparent to an extent that they can be fully understood by all parties. In case a Board of Appeal intends to rely on a line of argumentation not provided by any party it needs to communicate this line of argumentation in as much detail as a party would be required to do in order to avoid an imbalance between the parties arising from

27 It is the author's impression that most petition cases are based on an alleged surprise decision concerned with *ex officio* grounds

28 R 0016/13, Reasons No. 5.1

29 R 0016/13, Reasons No. 5.3 to 5.5

30 G 6/95 has been interpreted to allow much discretion on the providing of such a communication so that Appeal Boards may not provide such a communication or one with limited content

31 There is no formal procedure for a request for correcting the minutes and such requests seem to be rarely granted if nevertheless filed

32 Complete communications accompanying the summons was the former well respected and reliable praxis of the Boards of Appeal which was adopted by national courts like the German Federal Patent Court

33 G. Anetsberger, H. Wegner, C. Ann, K. El Barbari, T. Hormann, epi information 2/2015, pages 63 to 70, item D.3.

Article 114 EPC. A thorough preparation of the case by a written procedure is an essential element to ensure transparency, predictability and fairness.

### VIII. Conclusion

Against the backdrop of the case law so far, the new decision R 0016/13 establishes a positive framework for the right to be heard and thus creates more legal certainty and reliability in proceedings before the EPO. It can be concluded that the aspects on which decisions are based must either be explicitly communicated or there must be no doubts that they were foreseeable, and any questions about them from the party concerned which is obviously unclear about the grounds must not simply be disregarded. This makes the factual and legal framework of a case for the parties more transparent and the proceedings more predictable. R 0016/13 reduces procedural

uncertainties and thus strengthens basic procedural rights and has the potential to enhance efficiency. This is a truly positive signal for the users of the EPC.

### Zusammenfassung

Mit dem EPÜ 2000 wurde ein außerordentliches Rechtsmittel gegen Entscheidungen der Beschwerdekammern eingeführt. Die Große Beschwerdekammer entscheidet seither nicht nur in abstrakter Weise über Vorlagefragen, sondern in konkreten Fällen, ob Grundrechte, insbesondere das rechtliche Gehör, eingehalten wurden oder nicht. Mittlerweile gibt es schon Entscheidungen im dreistelligen Bereich, jedoch nur wenige Fälle, die für den Antragsteller erfolgreich verlaufen sind. R 0016/13 ist einer dieser wenigen Fälle und die erste Entscheidung, die eine detaillierte positive Vorgabe für die Einhaltung des rechtlichen Gehörs skizziert.

## eDrex – the new T-Rex?

A. Virkkala (FI)

### Introduction

Before the Examining Division decides to grant a European patent, it shall inform the applicant of the text in which it intends to grant it (R 71(3) EPC). The Examining Division sends the allowed application in the form of a "Druckexemplar" and invites the applicant to either approve it or request reasoned amendments. Until now the Druckexemplar has been a collection of facsimile copies of applicant-supplied pages, some of which may have been overlaid with handwritten amendments. Before approving the Druckexemplar, the Applicant had to check that it contained all pages in their most recent versions. This meant one check for each page.

The new electronic Druckexemplar "eDrex" will significantly change the way the applicant is informed of the forthcoming patent. One of the changes relates to marking of amendments. Handwritten amendments will be replaced by computer-generated correction marks. As said in an EPO poster titled "Recent Procedural Changes" and dated 26<sup>th</sup> January 2015, the eDrex will implement "Electronic Version Tracking ... to educe (sic) errors in printing process".

What the EPO poster does not say is that the eDrex will include not facsimile copies of applicant-supplied pages but their electronic versions processed by optical character recognition (OCR). Over a transition period, only pages amended during prosecution may be OCR-processed, but the EPO is likely to favour "early OCR processing" to have an editable text when examination begins.

The EPO outsources the OCR process to a company called Jouve, and claims 99.995% accuracy for "publication quality OCR". This translates to approximately 1 error per 20,000 characters, or 1 error per 10 pages. Most scanning errors will be harmless and mentally corrected by the reader. But the quoted accuracy is an average which does not apply for all documents. Furthermore, there are several reasons why errors are likely to concentrate in critical places.

If the eDrex includes OCR-processed pages, the amount of checking required from the applicant will increase dramatically. Instead of checking individual pages the applicant has to check individual characters! Each OCR-processed character is a source of an unmarked error. The eDrex thus hides a monster the size of a T-Rex.

### What is OCR anyway?

Optical character recognition is a misnomer because character recognition is not an optical process. OCR traditionally stands for optical scanning, followed by character recognition. Character recognition is a process in which a computer segments the pixels on a page into individual characters, detects shapes and finds best-matching glyphs for the shapes. OCR scanning is also applied to computer-generated documents that have never undergone optical scanning, such as character-based PDF (portable document format) documents, whose metamorphosis has never required a paper substrate. This distinction may be significant for the correct

interpretation of the claimed 99,995% accuracy figure. It is possible that the claimed accuracy is obtained with best possible source material, which is computer-generated PDF documents. Optical scanning from paper documents is likely to reduce accuracy because character outlines are smudged by absorption of ink or toner into pores of the paper. Another reason for an increased error rate is that lines on paper may not align perfectly with motion of the scanning machine.

It is unfortunate that applicants cannot avoid the OCR process and the associated risk of scanning errors. The EPO has indicated that in the near future it will accept applications in common word processing formats. The EPO will not dictate how Jouve processes the documents, however, and applications filed in a word processing formats may be converted to PDF and fed to the same pipeline with documents originally filed in PDF or on paper.

### Estimated frequency of character errors introduced by OCR scanning

The EPO does not specify how and under what conditions the claimed 99.995% accuracy was measured. For all we know, the source material for testing may have been optimal, which means character-based PDF with an OCR-friendly font. A character-based PDF has the benefit over scanned bitmaps that lines of text are perfectly aligned with the document and that character outlines are not smudged by absorption of ink or toner into pores of the paper.

Furthermore, it is reasonable to assume that Jouve applies linguistics-based proofreading to achieve the stated accuracy. If the quality of the source material for proofreading was a given quantity, it would make perfect sense to reduce errors by linguistics-based corrections. But in actual fact the given quantity is the final accuracy (the stated 99.995%), which means that raw OCR accuracy prior to linguistic correcting may be lower. A problem is that linguistic processing can only detect and correct errors which a human reader would ignore or mentally correct without so much thought. Conversely, OCR errors that resist linguistic proofing are likely to occur in places where automatic mental corrections cannot salvage the patent. Examples of such potentially harmful places are numbers, symbols, mathematical and chemical formulae. These are places in which a single OCR error may be detrimental to the scope and/or validity of the resulting patent.

As a starting point for coarse risk assessment, it is reasonable to assume at least one, and possibly several, character errors for every 10 pages, and that the errors may have above-average concentration in places where the error and correction are not immediately obvious.

### Severity of error versus place of occurrence

What are the sections of a patent where the errors are most likely to have serious consequences? The obvious answer is the independent claims. For instance, the change from a plus sign to a minus sign in a chemical

or mathematical formula may destroy the scope of the patent. A sign change may also destroy the validity of the patent if the incorrect sign is not supported by the description. But even plaintext claims may be destroyed by single-character errors. For instance, there is a dramatic difference between “asynchronous connection” and “a synchronous connection”.

The risk of having an independent claim ruined by OCR errors can be reduced by claiming the same invention via method and apparatus claims. Multiple parallel claims are unlikely to be similarly affected by OCR errors.

Another critical section is the part of the description or drawings from which support for the claims is derived. In a particularly risky scenario, which may result in OCR errors escaping detection, the claims define the invention in plaintext but the support is provided by a single mathematical formula. For instance, consider a claim feature “the normalization factor for an item  $j$  of the plurality  $N$  of items is based on items other than  $j$ ”, which is supported by a formula  $k_j = \sum_{i=1, i \neq j}^N$ . Validity of the patent is critically dependent on correct OCR scanning of the formula, including the inequality sign which supports the term “items other than  $j$ ”. EPC Art. 100 defines permissible grounds for opposition, including “the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art”). It is rare, but not impossible, for enabling disclosure to depend on individual characters or symbols. Another example is a case wherein enablement for a claim feature is provided via a reference to an earlier patent document whose identifier is distorted by a scanning error.

### Worst-case scenario

A prime candidate for a worst-case scenario is an infringement trial concerning a pharmaceutical patent, which has been going on for some time when the respondent detects that a previously undetected scanning error renders the patent worthless. The litigation costs for both parties may run up to millions, and the losses caused by the invalidity of the patent are unimaginable.

### Possibility of finding scanning errors via visual inspection

Considering the fact that most errors do not significantly affect the scope or validity of the patent, it will be impossible to ensure that human proof readers detect all scanning errors. Humans tend to see what they expect to see. In a medium-sized patent agency it may take years until an undetected error causes a serious loss of rights to a client. It is extremely difficult to motivate people to stay alert when they can merely pretend to be alert without consequences.

It is reasonable to expect that a significant portion of scanning errors, such as 10% for example, will go undetected in visual inspection.

## Coarse assessment of risk for a significant error to go undetected

Let us start with the following assumptions:

- 1 error per patent,
- 10 % pass rate for errors after visual inspection,
- 10 % chance for an error to affect scope or validity,
- and 10 % chance for the affected patent to be infringed.

Under these assumptions, one patent out of 1000 is infringed and significantly affected by one or more OCR errors. A medium-sized patent agency may need 10 years to obtain 1000 granted patents.

Exhaustive manual checking of the eDrex is prohibitively expensive. Unless the patent grant system is changed in such a manner that the definitive text of the patent will (again) be the collection of applicant-supplied pages, or that correction of scanning errors after grant is possible, there will be cases wherein rights are lost because of scanning errors.

## How to reduce risks?

Applications are preferably drafted by using OCR-friendly fonts in which all glyphs are distinguishable from one another and successive characters are always separated by a space. For instance, Arial and Times do not comply with the first and second requirement, respectively. It does not seem necessary to use special fonts optimized for OCR, such as OCR-B or Inconsolata, because being monospaced fonts they are harder to read by humans than proportional fonts are.

Risk of critical OCR errors may be lowered by claiming inventions in multiple categories. If the claims contain or are supported by matter in which automatic mental corrections are not possible, such as formulas, the formulas may be explained in plaintext. If claims are restricted by a feature derived from a formula, the description can be simultaneously augmented by a plaintext interpretation of the formula. To mitigate consequences of undetected OCR errors, the patent agency is advised to confirm that their liabilities are adequately covered by insurance.

# Eine 2. und 3. Auslegungsart von Art. 56 EPÜ

S. Kulhavy (CH)<sup>1</sup>

## Einleitung

Herr R. Rath, der Präsident der Kammern des Europäischen Patentamtes, empfiehlt in **epi** Information 2/2014, 68ff, sogar, welche Arten von Textpassagen man in den Verfahren vor den Beschwerdekammern des Europäischen Patentamtes die Parteienvertreter in ihren Eingaben zweckmässigerweise benützen können. Wir Patentanwälte haben Erfahrungen mit der Bearbeitung von Patentanmeldungen vor den Abteilungen des Europäischen Patentamtes. Jedoch es kommt selten vor, dass eine Patentanmeldung Gegenstand der Behandlung vor einer der Beschwerdekammern von EPA wird. Die Empfehlungen von Herrn Rath werden durch uns Patentanwälte daher sehr geschätzt. Solche Empfehlungen verdienen daher das höchste Lob.

Aber wie es so in der Welt ist, haben auch die besten Produkte der mentalen Tätigkeiten des Menschen manchmal eine „Achilles Ferse“. Diese findet man auf S. 72, r. Sp. des Beitrags von Herrn Rath, wo von der Beurteilung des Naheliegens die Rede ist. Der diesbezügliche Passus lautet wie folgt:

„Here it is not worth getting bogged down in aspects which are not only superfluous but which also com-

plicate the understanding and render the reasoning incomprehensible.“

Mit anderen Worten ausgedrückt, wird im genannten Beitrag zur Beurteilung des Naheliegens nichts ausgeführt. Das problem-solution-approach können wohl alle Patentanwälte. Wenn man die verwaltungstechnischen Belange der Arbeit eines Patentanwalts beiseite lässt, dann bildet das Naheliegen das Kernstück der Arbeit des Patentanwalts. Dies ist einer der Gründe, warum die Patentanwälte, möglicherweise nicht alle, wie dies die Erfahrung zeigt, möglichst genau wissen möchten, wie es um das Naheliegen bestellt ist.

## Die Deutung der erfinderischen Tätigkeit in juristischen Entscheidungen

Die Begründungen der Entscheide von Kammern und Gerichten aus den letzten Jahren bringen keine präzisen diesbezüglichen Angaben. Dies überrascht auch nicht, wenn man den Inhalt des vorstehend wiedergegebenen englischsprachigen Passus berücksichtigt. Der Autor des vorliegenden Beitrags befasst sich seit vielen Jahren mit der Forschung auf dem Gebiet des Naheliegens. Am Anfang dieser Forschungsarbeiten hoffte er, dass er in den alten Heften von GRUR und von „Mitteilungen“ einen vergessenen Artikel oder Gerichtsentscheid findet, in dem man schon damals, und zwar ganz genau gesagt

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hat, wann eine neue Lösung eines technischen Problems die Erfindungshöhe aufweist und wann nicht. Er hat nichts gefunden. In den Zeitschriften gibt es Artikel, in welchen die Autoren versucht haben, die Erfindungshöhe frei von subjektiven Urteilen, d. h. verstandesmäßig zu prüfen. Diese Artikel betrafen allerdings nur die Kategorie Kombinationserfindungen. Man hat die An- bzw. Verwendungserfindungen, ob bewusst oder unbewusst, nicht berücksichtigt. Solche Vorschläge konnten daher nicht zur globalen Beseitigung der Unklarheiten auf diesem Wissensgebiet dienen. Der Misserfolg bei der Suche in den früheren Literaturquellen war einer der Gründe dafür, dass der Autor dieses Beitrags das Buch „Erfindungs- und Patentlehre“, Carl Heymanns Verlag, Köln 2010, geschrieben hat.

Die derzeit praktizierte Beurteilungsweise des Naheliegens hat einen gravierenden Nachteil. Man hält den Begriff Erfindung für einen unbestimmten Rechtsbegriff. Deswegen ist es den die diesbezüglichen Entscheide treffenden Organen erlaubt, nach ihrem eigenen Dafürhalten – richterliches Ermessen nennt man dies – zu entscheiden, ob die beurteilte neue Lösung eines Problems als naheliegend gilt oder nicht. Solche subjektiven intellektuellen Übungen haben keinen Zusammenhang mit der Tatsache, dass Erfindungen und Patente auch gesellschaftliche Funktionen ausüben. Dies wird bei der derzeit praktizierten Entscheidungsweise über das Naheliegen überhaupt nicht berücksichtigt.

### Eine neue Beurteilungsweise des Naheliegens

Wünschenswert wäre daher, eine Beurteilungsweise des Naheliegens zu haben, welche einerseits präzise bestimmen kann, ob die beurteilte Lösung als naheliegend gilt oder nicht, und welche andererseits die gesellschaftlichen Belange der Erfindungen und der Patente mitberücksichtigt. Der interessierte Leser sagt sich an dieser Stelle sehr wahrscheinlich, jetzt geht es aber entschieden zu weit. Wir haben Probleme schon allein mit dem genauen Entscheid über das Naheliegen, und er will zugleich die gesellschaftlichen Belange der Erfindungen in solchen Entscheiden auch noch berücksichtigen.

Die genannten Forderungen des Autors dieses Beitrags sind keine Utopie, weil eine solche Beurteilungsweise des Naheliegens auf Seiten 124 und 125 seines genannten Buches bereits beschrieben war, und zwar wie folgt:

„Das genannte Erfindungskriterium geht von einer allgemein bekannten Tatsache aus, wonach die Technik es ermöglicht, Bedürfnisse, welche sich aus den Lebenssituationen, d. h. spontan ergeben, zu befriedigen. Nachdem sich ein Bedürfnis ergab, versucht man im Stand der Technik zumindest ein technisches Mittel zu finden, mit dessen Hilfe das Bedürfnis befriedigt werden kann. Die überwiegende Menge von Bedürfnissen kann sofort und problemlos anhand zumindest eines der Mittel des Standes der Technik befriedigt werden.

Damit ein technisches Mittel zur Befriedigung eines Bedürfnisses geeignet ist, muss dieses technische Mittel

ganz bestimmte und manchmal sogar sehr eng definierte technische Eigenschaften aufweisen. Diese erforderlichen Eigenschaften ergeben sich aus der Analyse jenes Objekts, d. h. jener Sache oder jenes Verfahrens, auf welches sich das gegebene Bedürfnis bezieht. Man sucht im Stand der Technik, ob es dort zumindest ein technisches Mittel gibt, welches die erforderlichen technischen Eigenschaften aufweist, damit das gegebene Bedürfnis befriedigt werden kann.

Falls es kein solches Mittel im Stand der Technik gibt, so gilt das Bedürfnis, zumindest im Moment der Suche im Stand der Technik nach einem passenden technischen Mittel, als nicht befriedigbar. Dies kann für die Gesellschaft von einer negativen Bedeutung sein. Man kann daran erinnern, dass es immer noch Bedürfnisse gibt, welche nicht oder nicht in einer zufriedenstellenden Weise befriedigbar sind. Wenn jemand in einer solchen Situation ein technisches Mittel nennt, mit dessen Hilfe ein bisher nicht befriedigbares Bedürfnis nunmehr befriedigt werden kann, dann hat sich eine solche Person um die Gesellschaft verdient gemacht. In solchen Fällen erfordert das „auf – den – Markt – Bringen“ einer solchen neuen technischen Lösung oft beträchtliche Investitionen. Damit der Erfinder bzw. seine Rechtsnachfolger die Möglichkeit haben, diese Investitionen zurückzubekommen, erteilt ihm die Gesellschaft ein zeitlich begrenztes Privilegium, nämlich ein Patent. Hieraus dürfte ersichtlich sein, dass das vorliegende Erfindungskriterium auf der Bedeutung der Erfindung für die Gesellschaft abgestützt ist, und dass dieses Erfindungskriterium daher in der sogenannten Belohnungstheorie fußt.

Für die Prüfung von Erfindungen ist dieses Erfindungskriterium, welches sich auf das nicht befriedigbare Bedürfnis abstützt, nicht handlich. Ausgehend vom genannten Erfindungskriterium kann man eine praktische Methode zur Prüfung von Erfindungen ableiten. Es ist gesagt worden, dass im Stand der Technik nach zumindest einem technischen Mittel gesucht wird, welches die zur Befriedigung eines gegebenen Bedürfnisses erforderlichen Eigenschaften aufweist. Die Auffindung eines solchen technischen Mittels stellt ein technisches Problem dar. Wenn man im Stand der Technik ein technisches Mittel findet, bei welchem es bekannt ist, dass es die zur Befriedigung des gegebenen Bedürfnisses erforderlichen Eigenschaften aufweist, dann gilt das betreffende Bedürfnis als befriedigbar. Die Verwendung eines solchen technischen Mittels gilt für einen Fachmann als *naheliegend*, weil zum Wissen und Können der Fachleute gehört es, dass sie die Wirkungsfähigkeiten bekannter technischer Mittel kennen und solche technischen Mittel auch dementsprechend anwenden können.

Naheliegend deswegen, weil das verwendete bekannte technische Mittel samt seinen relevanten Eigenschaften bereits bekannt war und weil es daher kein Hindernis für die Befriedigung des gegebenen Bedürfnisses gab. Daraus kann man die Definition einer naheliegenden Lösung ableiten, welche somit noch keine Erfindung darstellt, auch wenn diese Lösung als neu gilt:

„Eine gewerblich anwendbare und neue Lösung einer Aufgabe bzw. eines Problems ergab sich (für den

Fachmann) in naheliegender Weise aus dem Stand der Technik, *wenn zur Lösung der Aufgabe bzw. des Problems ein bekanntes technisches Mittel aufgrund einer bei diesem technischen Mittel bereits bekannten technischen Eigenschaft (Wirkungsfähigkeit) verwendet worden ist.* Eine neue Lösung, welche unter diese Definition nicht fällt, ergab sich **logischerweise nicht in naheliegender Weise** (Art. 56 EPÜ) aus dem Stand der Technik.“

### Erste Art der Auslegung

Anhand einer Recherche im Stand der Technik lässt es sich feststellen, ob das lösungsgemäß verwendete technische Mittel bereits bekannt war, und wenn ja, ob die bei diesem bekannten technischen Mittel lösungsgemäß ausgenützten technischen Eigenschaft (d.h. seine lösungsgemäß ausgenutzte Wirkungsfähigkeit) bei *diesem* technischen Mittel bereits bekannt war. Hieraus dürfte ersichtlich sein, dass alle Merkmale der Definition einer naheliegenden Lösung sich durch eine Recherche im Stand der Technik verifizieren lassen. Bei der Benützung dieser Beurteilungsmethode müssen daher keine subjektiven intellektuellen Übungen, d.h. intuitive Überlegungen mehr ausgeführt werden, welche heutzutage Gang und Gebe sind.

Das Merkmal „erfinderische Tätigkeit“ war das einzige Merkmal im Art. 52,1 EPÜ, bei dessen Prüfung bisher subjektive Urteile angewendet werden mussten. Da solche Urteile nunmehr nicht angewendet werden müssen, braucht der Begriff Erfindung, welcher im Art. 52,1 EPÜ definiert ist, nicht mehr als unbestimmter Rechtsbegriff zu gelten.

Wenn eine neue Lösung unter die Definition einer naheliegenden Lösung **nicht fällt**, dann ergab sich eine solche Lösung **nicht** in naheliegender Weise aus dem Stand der Technik. Dies entspricht dem im Art. 56 EPÜ verwendeten Wortlaut. Folglich beruht eine solche neue Lösung auf erfinderischer Tätigkeit usw. Diese Beurteilungsweise des Naheliegens bzw. des Nicht-Naheliegens bedient sich des Weges über eine Negation, welche eine geläufige logische Operation ist. Diese Negation ist im Wortlaut von Art. 56 EPÜ vorgeschrieben und deswegen dürfen wir diese Negation während der Beurteilung des Naheliegens bei einer neuen Lösung nicht ausser Acht lassen! Zu diesem Zweck müssen wir die Bedeutung dieser Negation erläutern, was hier vorstehend geschah. Wollen wir diesen Weg als die 1. Art der Auslegung von Art. 56 EPÜ nennen.

### Zweite Art der Auslegung

Möglicherweise finden manche Leser den Weg über die Negation als zu kompliziert. Es gibt noch eine 2. Art der Auslegung von Art. 56 EPÜ. Die beurteilte neue Lösung beruht auf einer Idee, welche der Fachmann vorher nicht hätte haben können. Unter ‚vorher‘ ist das Prioritäts- bzw. Einreichungsdatum der geprüften Patentanmeldung bzw. des angegriffenen Patents gemeint. Als erster Hinderungsgrund hierfür gilt die Tatsache, dass das lösungsgemäß verwendete technische Mittel zum Stand

der Technik noch nicht gehörte, wie dies die Recherche im Stand der Technik gezeigt hat, damit das betreffende Bedürfnis befriedigt werden konnte. In diesem Fall gilt die neue Lösung als die sogenannte Kombinationserfindung. Denn das technische Mittel, welches in der beurteilten neuen Lösung verwendet wird, entstand durch eine Kombination von Bestandteilen des damaligen Standes der Technik. Als ein zweiter Hinderungsgrund kann die Tatsache gelten, dass das lösungsgemäß verwendete technische Mittel zum Stand der Technik zwar bereits gehörte, aber man hat es nicht gewusst, dass dieses bekannte technische Mittel eine Wirkungsfähigkeit besitzt, welche die Lösung der gegebenen Aufgabe ermöglichen würde. Aus diesem Grund konnte das bekannte technische Mittel zur Befriedigung des gegebenen Bedürfnisses nicht verwendet werden. Die beurteilte neue Lösung gilt in diesem Fall als eine An- bzw. Verwendungserfindung, nachdem man es entdeckt hat, dass das bekannte technische Mittel die genannte Wirkungsfähigkeit besitzt. Alle übrigen Arten von Erfindungen, welche in der Fachliteratur genannt werden, lassen sich auf eine dieser zwei Erfindungsarten zurückführen.

### Dritte Art der Auslegung

Eine 3. Art der Auslegung von Art. 56 EPÜ geht eigentlich aus der Art 2 hervor. Die beurteilte neue Lösung beruht auf einer Idee, welche der Fachmann vorher nicht haben konnte. In diesem Fall sind die Hinderungsgründe usw. gleich wie bei der 2. Art der Auslegung.

Diese Auslegungsarten 2 und 3 haben den Vorteil, dass sie sich in einem Gespräch leichter verwenden lassen als die Art 1. Dafür aber fehlt ihnen der Zusammenhang mit dem Wortlaut von

Art. 56 EPÜ. Die Erläuterungen, wie es um die zwei Erfindungsarten steht, die im Rahmen der Auslegungen 2 und 3 genannt wurden, kann man während einem Gespräch dann später nachtragen. Für diese zwei Erfindungsarten gilt selbstverständlich das, was hier im Zusammenhang mit der 1. Art der Auslegung ausgeführt wurde. Als technisches Mittel gilt jener Teil des Inhaltes der Unterlagen der geprüften Patentanmeldung, welcher nach dem Abzug des Inhaltes des Dokumentes des nächstliegenden Standes der Technik vom Inhalt der Unterlagen der geprüften Patentanmeldung übrig bleibt. Die wesentlichen Merkmale dieser Differenz werden zur Bildung des kennzeichnenden Teiles eines unabhängigen Patentanspruchs verwendet. Im genannten Buch des Autors dieses Beitrags werden etwa 20 Beispiele für die Anwendung der Definition einer naheliegenden Lösung im Rahmen der Auslegungsart 1 im Einzelnen erläutert.

### Diskussion und Aussicht

Wenn man bedenkt, dass in diesem verhältnismässig kurzen Text sogar drei mögliche Arten der Auslegung von Art. 56 EPÜ beschrieben sind, dann gibt es keinen Grund dafür zu meinen, dass eine Beschreibung der Beurteilungsweise des Naheliegens schwer verständlich

und unbegreifbar sein müsste. Für die meisten Patentanwälte ist diese Beschreibung ganz bestimmt nicht überflüssig. Ohne Zweifel erfordert das Verständnis der Auslegungsart 1 vom Leser eine gewisse Portion logischer Akrobatik. Wenn man jedoch bedenkt, dass die Patentanwälte, die Prüfer und die Richter Absolventen von Hochschulen sind, dann darf man eine solche Portion logischer Akrobatik diesen zumuten. Übrigens, der Autor dieses Beitrags hat sich diese Auslegungsarten des Art. 56 EPÜ selbst ausgedacht. Wenn man ferner bedenkt, dass es während der mehr als hundert vergangenen Jahre weder den Patentämtern noch den Gerichten, in welchen, wie gesagt, Hochschulabsolventen arbeiten, gelungen ist, eine verstandesmäßige Beurteilungsweise des Naheliegens bzw. der Erfindungshöhe zu finden, dann kann man nicht erwarten, dass die Beschreibung einer verstandesmäßige Beurteilungsweise des Naheliegens trivial sein wird.

Nachdem man den vorstehend wiedergegebenen englischsprachigen Satz zum ersten Mal gelesen hatte, stellte sich ein Unbehagen an der Stelle dieses Satzes ein, wo behauptet wird, dass Ausführungen zum Naheliegen überflüssig seien. Als Bürger möchte man doch wissen, wie die da oben denken. Dieses Unbehagen legt sich jedoch, wenn man sich die Situation in einem Richter-gremium vorstellt. Wenn das Gremium fünf Richter hat und wenn jeder von diesen seine intuitiven Ideen zum Naheliegen hat, dann würde eine Diskussion über diese Ideen zu einer beinahe unendlichen Debatte führen.

Die Benützung der vorliegenden Lehre ist sogar sehr einfach. Die theoretischen Grundlagen dieser Lehre, welche hier vorstehend erläutert sind, kann man während der praktischen Anwendung dieser Beurteilungsweise einfach beiseite lassen. Man muss nur die Patentschrift bzw. die Unterlagen einer Patentanmeldung lesen, eine Recherche im relevanten Stand der Technik

durchführen und den Inhalt des Dokumentes des nächstliegenden Standes der Technik vom Inhalt der Patentschrift bzw. der Anmeldungsunterlagen abziehen. Diese Differenz stellt das lösungsgemäß verwendete technische Mittel dar. Die lösungsgemäße Verwendung dieses technischen Mittels wird anhand der Definition einer naheliegenden Lösung geprüft. *Bis auf diese Prüfung anhand der Definition einer naheliegenden Lösung sind alle übrigen Schritte dieses Vorgehens mit den Schritten im problem-solution-approach identisch.* Folglich gibt es mit der Handhabung dieser übrigen Schritte bereits genug Erfahrungen. Es verwundert, warum das EPA unter so einfachen bzw. günstigen Umständen die vorliegende Art der Prüfung von Erfindungen nicht übernimmt und nicht praktiziert.

### Summary

It is well known that non obviousness or inventive step is one of the features of an invention. If a case is examined whether its subject matter involves inventive step then it will be decided whether the subject matter of the examined case did not result in an obvious manner from the prior art. It is also well known that invention is an indistinct legal concept. Consequently, the judges are in the course of their voting about inventive step allowed to vote at their discretion. Such decisions are private matter and they do not consider the impact of such decisions in the community. It should be desirable to find out a method for the assessment inventive step which also considers the impact of such decisions in the community. Such an assessment was already worked out and it is disclosed in one of the books of the author of this contribution. In the present contribution essential features of just said assessment are among other things described.

## Strawman oppositions – Advantages and Disadvantages

I. de Baere (BE), U. Storz (DE)

Oppositions at the European Patent Office are a popular tool to invalidate European Patents. Compared to national invalidation proceedings, oppositions are very cheap, and have effect on the European Patent as a whole, i.e., they are not restricted to national parts thereof.

Under Art. 99 (1) EPC any person may file an opposition against a European Patent. Under Rule 76 (2) (a) EPC, the notice of opposition shall contain, inter alia, particulars of the opponent as provided in Rule 41, para-

graph 2(c). The latter makes clear that the term "person" encompasses both natural persons and legal persons.

This means that the EPC does not require that an opponent has a personal interest in the revocation of a European Patent. However, according to Enlarged Board of Appeals Decision G 9/93, the patent proprietor himself cannot file an opposition, because opposition proceedings are inter partes proceedings, so the patentee and opponent must be different persons. To allow patent proprietors to request limitation or revocation of their

European Patents, Art 105a EPC has therefore been introduced with the EPC 2000.

Enlarged Board of Appeals decisions G 3/97 and G 4/97 clarified that the fact that the opponent is acting on behalf of a third party does not *per se* render the opposition inadmissible. It is only inadmissible if the opponent's involvement is to be regarded as abusively circumventing the law. Such circumvention of the law arises, *inter alia*, if the opponent is acting on behalf of the patent proprietor, while such circumvention would not arise merely because a professional representative files an opposition in his own name on behalf of a client.

While generally, everybody can act as a strawman, patent law firms do usually take over this role, i.e., they file the opposition on behalf of a client, but in their own name ("strawman-representative"). In addition thereto, companies exist which have specialized in acting as a strawman for other companies, but do not act as representatives at the same time ("passive strawman"). In this context, decisions G 3/97 and G 4/97 set forth that if a strawman which is not a professional representative acts on a client's behalf and carries out all the activities typically carried out by professional representatives, while himself assuming the role of a party in order to circumvent the prohibition on his acting as a professional representative, such situation would qualify as a circumvention of the law.

Therefore, in case of a passive strawman in the above meaning, the opponent or the strawman also has to appoint a professional representative who actually represents the case before the European Patent Office.

Strawman oppositions are particularly popular in opposition proceedings against 2<sup>nd</sup> or higher generation patents related to pharmaceutical products, e.g., 2<sup>nd</sup> medical indication patents, formulation, galenics or dosage patents, and the like.

## 1. Advantages

### 1.1. General advantages

Generally, using a strawman allows an opponent to conceal his true identity. This helps avoiding that the patent proprietor knows who is interested in practicing his technology, and/or who is a potential target for litigation.

### 1.2. The use of a strawman leaves the "true" opponent all options

When using a strawman, the "true" opponent has it in his hands if, and when, he may want to disclose his identity to the patent proprietor. According to the developments in the ongoing opposition, the opponent can thus approach the patent proprietor to negotiate a license either with or without disclosing that he is behind the opposition. This may provide valuable strategic advantages.

For example, the opponent can influence the terms of a patent license by opposing the patent, while, at the same time negotiate with the patent proprietor freely, and on cordial terms.

### 1.3. A strawman's arguments do not fall back on the client

If an opponent has a patent or patent application which claims similar subject matter as the patent he opposes, arguments raised against the opposed patent can be held against his own patents or patent applications. This applies, *inter alia*, for lack of inventive step arguments. In formulation patents or antibody sequence patents, for example, lack of inventive step arguments have almost always a universal component, which can be applied, *mutatis mutandis*, to other patents or patent application of similar kind.

The proprietor of the opposed patent may thus use these arguments to attack opponent's patents or patent applications in a counter-attack. While the use of a strawman cannot exclude this risk, one can at least avoid that the patent proprietor cites the opponent in his own words in his counter attack. Further, the true opponent can thus conceal the target coordinates of his patent estate from the patent proprietor. The use of a strawman thus makes it more difficult for the patent proprietor to identify those patents that can be subject of a counter attack, and use opponent's arguments in that attack.

Further, an opponent who puts forward an argument in one case which might be harmful for him in another case, might come under pressure to offer an explanation if this argument is resumed by another party and held against him.

This risk is less pronounced in proceedings before the European Patent Office, which is mainly influenced by the Roman Law System, and thus less obliged to the principles of equity than the Common Law System, as applied in the United States. Therefore, no statutory principles apply in which an argument put forward by a party in an EP case do automatically count against the party in another case, if applicable.

However, if a co-pending US-case exists, opponents should be aware that such argument would most likely have an impact on the corresponding US litigation or prosecution, and thus bounce back on the opponent, even if such statement has been made in another jurisdiction.

The use of a strawman can reduce this risk. Opponents need, however, to be aware that a US litigation often brings with it discovery proceedings, under which the alleged infringer needs to disclose any kind of communication which is not marked to be protected by client attorney privilege. Therefore, opponents who use a strawman should make sure that all their communication with the strawman is protected under this privilege.

This, however, applies only if the strawman is a "strawman-representative", because communication between a client and a professional representative is privileged under Rule 153 EPC, while communication with a "passive strawman" who is not a professional representative is not.



## 2. Disadvantages

### 2.1. *Provision of experimental data can become more complicated*

Attacks related to lack of enablement (Art 83 EPC) usually imply that the burden of proof is on the opponent (decision T 0063/06). Thus, an opponent who wants to attack a claim for undue broadness which would not be covered by the enabling examples is usually required to provide non-working examples. These examples can be taken from the literature, but more frequently these are derived from own experiments.

If the true opponent is represented by a strawman, respective experiments need to be anonymized, so that the true opponent cannot be traced back. To ensure that these data are still credible, they would have to be made, e.g., by a contract researcher. It is usually not sufficient if the true opponent uses in-house resources to have the experiments made and then anonymizes them, because this would significantly affect their credibility.

### 2.2. *The true opponent cannot recruit his own employees as experts*

Expert opinions are becoming increasingly popular in EP oppositions. They are explicitly mentioned in Art 117 (e) EPC as suitable means of evidence in EPO proceedings. According to the Guidelines for Examination, E III 4.7, the Opposition Divisions may not disregard an expert opinion, even if the expert testifies at the request of one of the parties. The same principle applies to declarations and affidavits made by experts (Art 117 (g) EPC).

Oftentimes, employees of the opponent make suitable experts, because they may have the closest insight into the technology that is covered by the opposed patent. However, in a strawman opposition, the opponent cannot recruit his employees as experts, because this would disclose his identity to the patent proprietor. Thus, opting for a strawman means deliberately waiving a potentially important source of evidence.

### 2.3. *Strategic coordination between different opponents is more difficult*

Opponents may want to coordinate their strategy during opposition. However, if one opponent is using a strawman, his true identity is not only disguised to the patent proprietor, but also to the co-opponents. A meaningful strategic coordination between the different opponents may however require that the individual opponents know who they negotiate with.

### 2.4. *Changing the representative can become more difficult*

In case the true opponent appoints a lawfirm to act as a strawman ("strawman-representative"), he cannot simply change his representative, e.g., in case he is dissatisfied with the latter's performance. This is because, technically, the strawman-representative is the opponent. The only thing the true opponent can do is to instruct his strawman-representative to appoint another representative. This again makes communication more complicated. In case the true opponent

has chosen a passive strawman, however, a change of representative is less difficult.

### 2.5. *Opponent cannot always appoint his preferred representative*

Often, a potential opponent has a close and long-lasting working relationship with a Patent Attorney. In many cases such attorney would make a perfect representative in an opposition filed by the opponent, due to the expertise regarding the respective technology that the representative has accumulated over the years. However, in such case it would be quite likely that the patent proprietor can identify the true opponent, e.g., from patent publications disclosing the representative. This means that cases may exist where the true opponent, to maintain his anonymity, cannot appoint his preferred representative as strawman, but needs to appoint another representative, who may have less expertise regarding the respective technology.

## 3. Pitfalls to be avoided

Now the pros and cons of a strawman opposition have been discussed, parties considering this option should be aware of the pitfalls that can come along with a strawman opposition.

### 3.1. *Make sure that Strawmans's identity is clear*

As discussed above, an opposition can be filed by a natural person or a legal person. A strawman should thus make it clear whether he files the opposition as a natural person or a legal person. This may sound obvious, but when a law firm acts as a strawman-representative the letter of opposition is usually printed on the firm's letterhead, but signed by a natural person, e.g., a European Patent Attorney, who is a member of that firm.

In such cases, the strawman should make unambiguously clear who the opponent is – the firm or the individual. Otherwise, the opposition may be deemed inadmissible, because the Opposition Division may consider the identity of the opponent unclear.

### 3.2. *Avoid that the "true" opponent's identity is unintentionally disclosed*

In an opposition filed by a strawman, it may occur that the true opponent's identity is unintentionally disclosed. This can happen, e.g., if the strawman submits documents which he has obtained from the true opponent, in case said documents carry tags that allow identification of the latter. Such tags are, for example, client identification tags which are oftentimes stamped on scientific literature obtained through a respective client portal.

Likewise, if a document submitted by the strawman is a copy of a document that the true opponent has sent to him by facsimile, it can happen that the true opponent's fax number is still visible on the submitted document, thereby allowing identification of the latter.

Therefore, strawmen should meticulously take care that all documents submitted are free from any kind of tags or marks that allow identification of the opponent.

## 4. Case studies

### 4.1. EP1537878 B1

Bristol Myers Squibb (BMS) and Ono sued Merck & Co in the United States for patent infringement of Ono's US patents US8728474 and US9073994.

Both parties have an anti-PD-1 antibody on the market, which both appear to fall under Ono's patents. In the respective complaint, BMS and Ono referred to a corresponding EP opposition filed by Merck against Ono's European counterpart EP1537878 B1, to establish that Merck willfully infringed Ono's US patents.

This allegation was based on the fact that in said opposition proceedings Merck would have admitted that they were aware of Ono's corresponding US patent US8728474. In fact, Merck's EP representative had justified late introduction of a prior art document with the fact that Ono had already disclosed the same document in the prosecution of one of the two corresponding US patents.

BMS and Ono used this allegation to demand triple damages for past and future infringements.<sup>1</sup> Although

the outcome of the litigation is not yet clear, it can at least be stated that, if Merck's opposition had been filed by a strawman, BMS and Ono could not have used this argument.

### 4.2. EP1406656 B1

In the pending oppositions against European Patent EP1406656 B1, which protects a dosage of the anti TNF antibody adalimumab, 15 parties filed oppositions by October 2013, out of which 9 were strawmen who most probably acted on behalf of biosimilar manufacturers.

According to information provided by the Generics and Biosimilars initiative (GaBI) dated June 26, 2015,<sup>2</sup> 12 companies have disclosed that they have an adalimumab R&D programme. Interestingly, only 3 out of these 12 companies have openly opposed the adalimumab dosage patent, namely AET BioTech, Amgen and Pfizer. It is however quite obvious that others have anonymously filed opposition through strawmen. See Table 1 for an overview.

Company with an adalimumab biosimilar programme	Opponent against EP1406656 B1	Remarks
AET BioTech	AET BioTech	opponent has disclosed an adalimumab programme
Amgen Inc	Amgen Inc	
Pfizer Inc	Pfizer Inc	
Boehringer Ingelheim	Gedeon Richter	opponent has not disclosed an adalimumab programme
Coherus Biosciences	Mylan	
Fujifilm	Teva	
LG Life Sciences	Kilburn & Strode LLP	strawman-representative
Momenta Pharmaceuticals	George Schlich	
Oncobiologics/	Zwicker Schnappauf & Partner Patentanwälte	
Samsung Bioepis	Wolfgang Weiss	
Sandoz	Markus Breuer	
Zydus Cadila	Christian Appelt	
	William Bird	
	Hoffman & Eitle Patent Attorneys	
	Strawman Limited	passive strawman

Table 1

### 4.3. EP1297016 B1

European Patent EP1297016 B1 assigned to Vlaams Interuniversitair Instituut voor Biotechnologie was directed to antibodies binding to placental growth, with eye diseases and cancer as therapeutic indication.

On December 12, 2006, an opposition was filed by "Strawman Ltd", which is a passive strawman residing in the UK which was represented by a professional representative. With his letter of opposition, the represen-

tative filed, inter alia, a journal article that carried the following tag:

Downloaded from www.nejm.org at AstraZeneca on October 27, 2006 .  
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Comparison of the download date (Oct 27, 2006) with the filing date (Dec 12, 2006) provides a clue who the true opponent was who used the strawman to conceal his identity.

1 Storz U, IP issues of Immune checkpoint inhibitors. Submitted with mAbs  
2 <http://www.gabionline.net/Biosimilars/General/Biosimilars-of-adalimumab>

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- **Munich (DE):** now also Paper C Methodology in German language, Paper D courses already in German language
- **Paris, Lyon and Toulouse (FR):** Pre-Exam, Paper C and Paper D courses in French language, tutor Grégory Baque

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- 2-day Introduction to IPR
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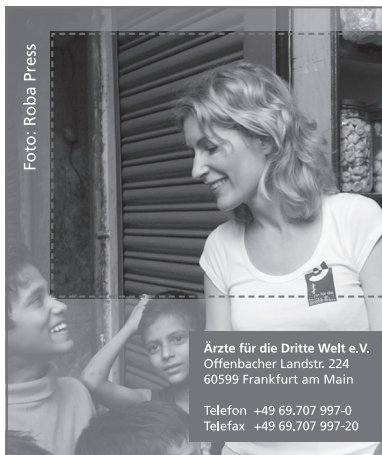
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Dr. Maria Furtwängler

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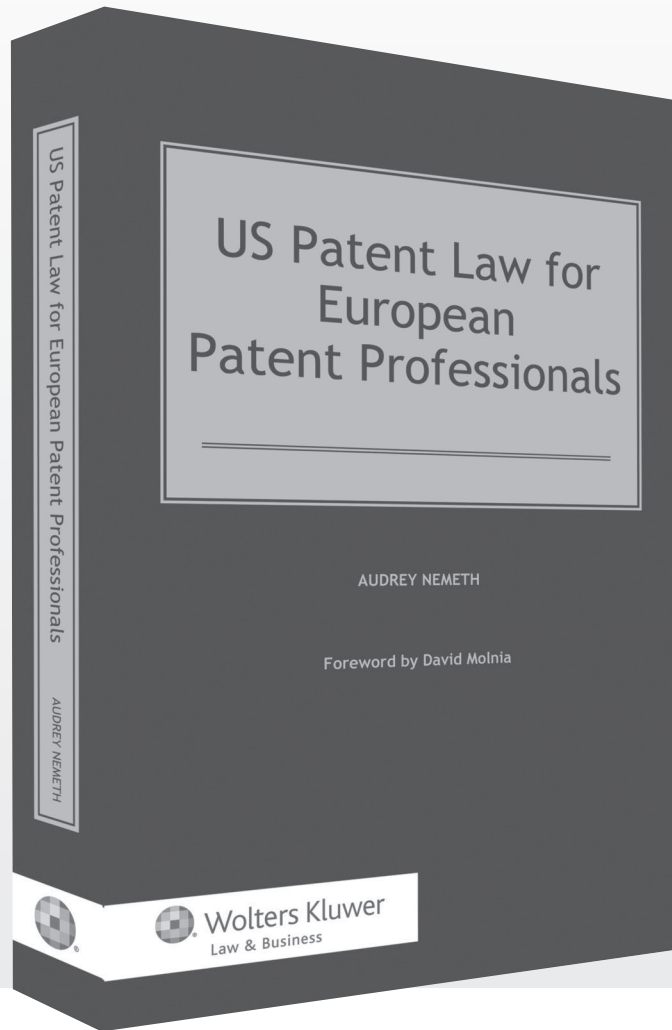
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NEW

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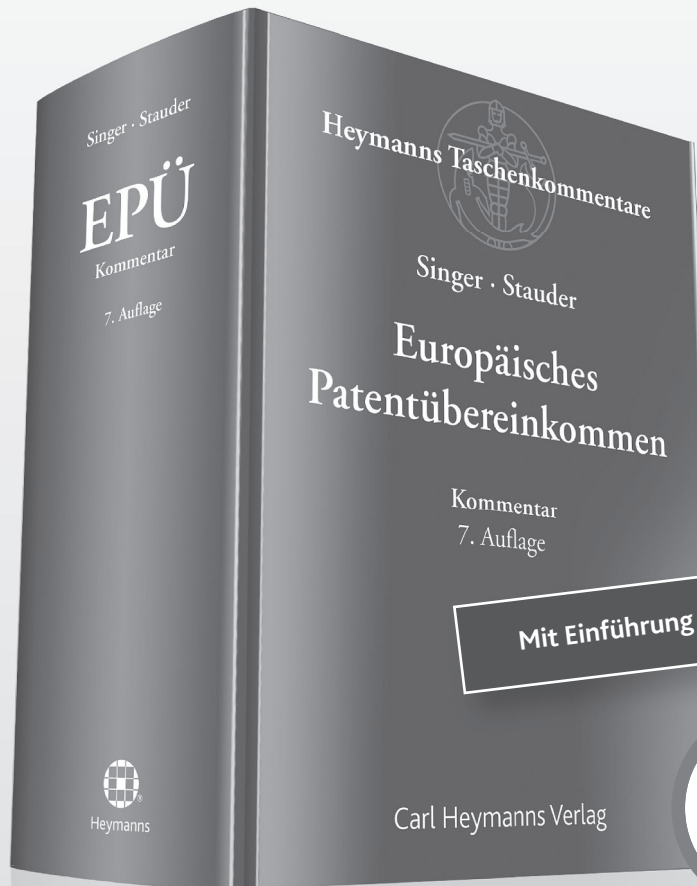
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**Price: EUR 125 / USD 169 / GBP 100**



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# Die verständliche Kommentierung mit Tiefe



Mit Einführung in das Einheitspatent

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## Erhebliche Verbesserungen, Erweiterungen und Neugestaltungen der Kommentierung:

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- Wesentliche Bestimmungen der AusO erscheinen als eigenständige Kommentierung im Rahmen der zugehörigen Artikel des EPÜ.
- Schneller Zugriff auf Kommentierung PCT und AusO über Artikel-/Regel-Register
- Zukunftsweisend: Einführung in das Einheitspatent

## Die Herausgeber:

Dieter Stauder und Stefan Luginbühl

Singer/Stauder

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EPÜ**

Kommentar

7. Auflage 2016, ca. 2.200 Seiten,  
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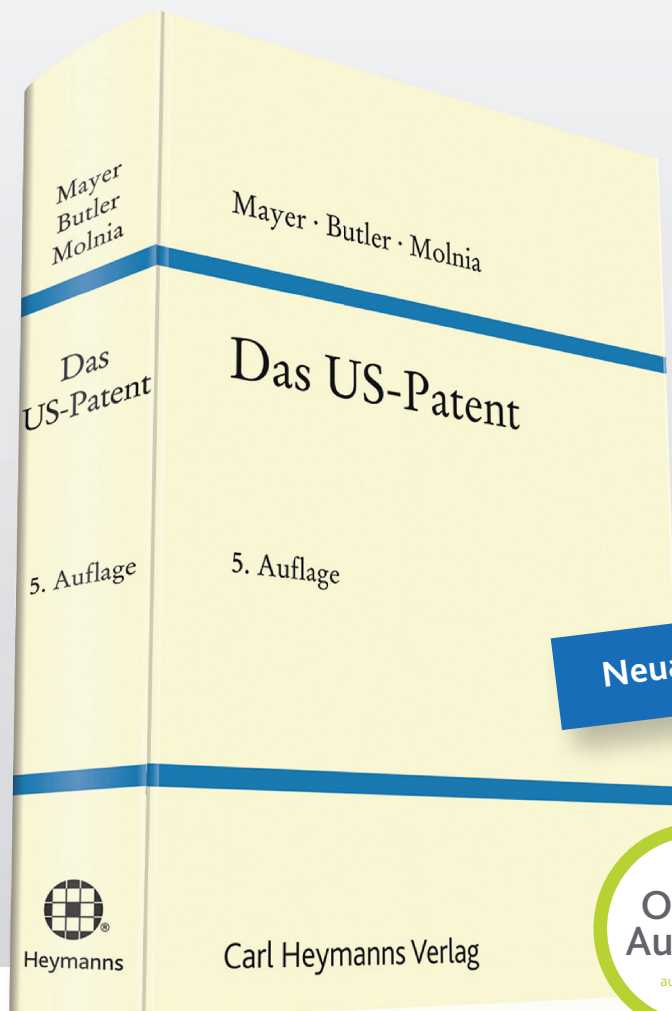
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# Das neue Recht: Patenterteilung und Patentverletzung in den USA



Neuaufgabe 2016

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Der umfassende Überblick über das neue amerikanische Patentwesen nach dem Leahy-Smith America Invents Act:

- first inventor to file
- Post-grant review (neu; vgl. Einspruch in Europa)
- Inter partes review (statt inter-partes re-examination)
- Derivation (statt interference)
- Supplemental examination (neu, zusätzliche Prüfung des eigenen Patents)
- novelty und prior art (wesentliche Änderungen)

Anhand von Beispielen aus der Rechtsprechung ausführliche Erläuterung von materiellen Patentierbarkeitsvoraussetzungen, Anmeldeformalitäten und Prüfungsverfahren sowie Grundsätzen des Patentverletzungsverfahrens.

Der Anhang enthält oder nimmt Bezug auf die wichtigsten Quellen des US-Patentrechts:

- United States Code, Title 35 Patents (35 USC), ■ Leahy-Smith America Invents Act und die wichtigsten Federal Regulations (37 CFR), ■ Manual for Patent Examination Procedure. Anhand der Übersichten im Anhang findet der Leser schnell, wo im Text eine bestimmte Vorschrift erläutert wird.

Mayer / Butler / Molnia (Hrsg.)

**Das US-Patent**

5. Auflage 2016, ca. 600 Seiten, gebunden, ca. € 238,-

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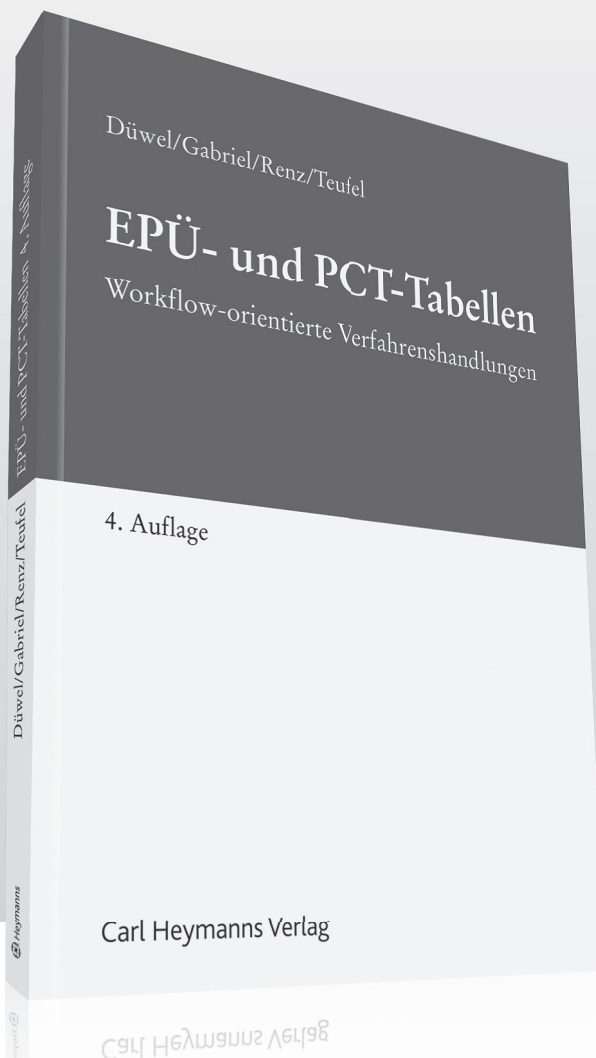
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# Komplexe Verfahrensabläufe leicht erfassen



Die tabellarische Übersicht dient EQE-Prüfungen als Lehrmittel, erfahrenen Patentanwälten und Neulingen im gewerblichen Rechtsschutz als Arbeitsmittel und Patentingenieuren und Patentverwaltungsangestellten als praktisches Nachschlagewerk.

Orientiert am Workflow des Verfahrens sind für typische Praxisfälle und wichtige Spezialfälle die Rechtsnormen in Rechtsketten zusammengestellt. So werden die erforderlichen Verfahrenshandlungen deutlich. Zwei Haupttabellen decken das EPÜ 2000 und den PCT ab. Unterkapitel behandeln besondere Rechtsfragen, wie

Priorität, Fristen und Teilanmeldungen.

Weiterhin erlauben die aufgeführten Rechtsketten einen schnellen Zugriff auf Hinweise zur Mängelbeseitigung.

Gerade die kompakte und übersichtliche Darstellung ermöglicht es, komplexe Verfahrensabläufe leicht zu erfassen.

#### Neu in der 4. Auflage:

- Aktualisierung von zahlreichen Änderungen AusFO EPÜ und PCT
- neue Übersichtstabellen
- Änderungen des PCT Applicants Guide

Düwel / Gabriel / Renz / Teufel  
**EPÜ- und PCT-Tabellen**

Workflow-orientierte  
Verfahrenshandlungen

4. Auflage 2016,

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In Vorbereitung für November 2015



Carl Heymanns

# »...Klassiker der Patentrechts- handbücher...«

*RA Thorsten Beyerlein, Mitteilungen 09/13*



Die Neuauflage des bewährten Standardwerks zu materiellen und verfahrensrechtlichen Fragen rund um die Patentverletzung enthält in gewohnt praxisorientierter Art:

- alle wesentlichen Phasen des Verfahrens auf der Grundlage der Rechtsprechung des BGH und der Instanzgerichte;
- Ermittlung und Überprüfung des Verletzungstatbestandes;
- das außergerichtliche Abmahnverfahren;
- das gerichtliche Streitverfahren;
- Darstellung des Zwangsvollstreckungsrechts;
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#### Die Neuerungen der 8. Auflage:

- Patentschutz für Ersatz- und Zubehörteile

- Umfassende Kommentierung der EuGH-Entscheidung zur kartellrechtlichen Zwangslizenz bei SEP und Darstellung ihrer Folgen für die Behandlung von Zwangslizenzen außerhalb von Standardpatenten
- Berechnung der FRAND-Lizenzgebühr
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- Aktualisierte Rechtsprechung auf dem neuesten Stand
- Neue Fallbeispiele

Auch in dieser Auflage stehen Formulierungsmuster (Beweisanordnungen), Musteranträge und Check-Listen für Kläger und Beklagte zum Download zur Verfügung.

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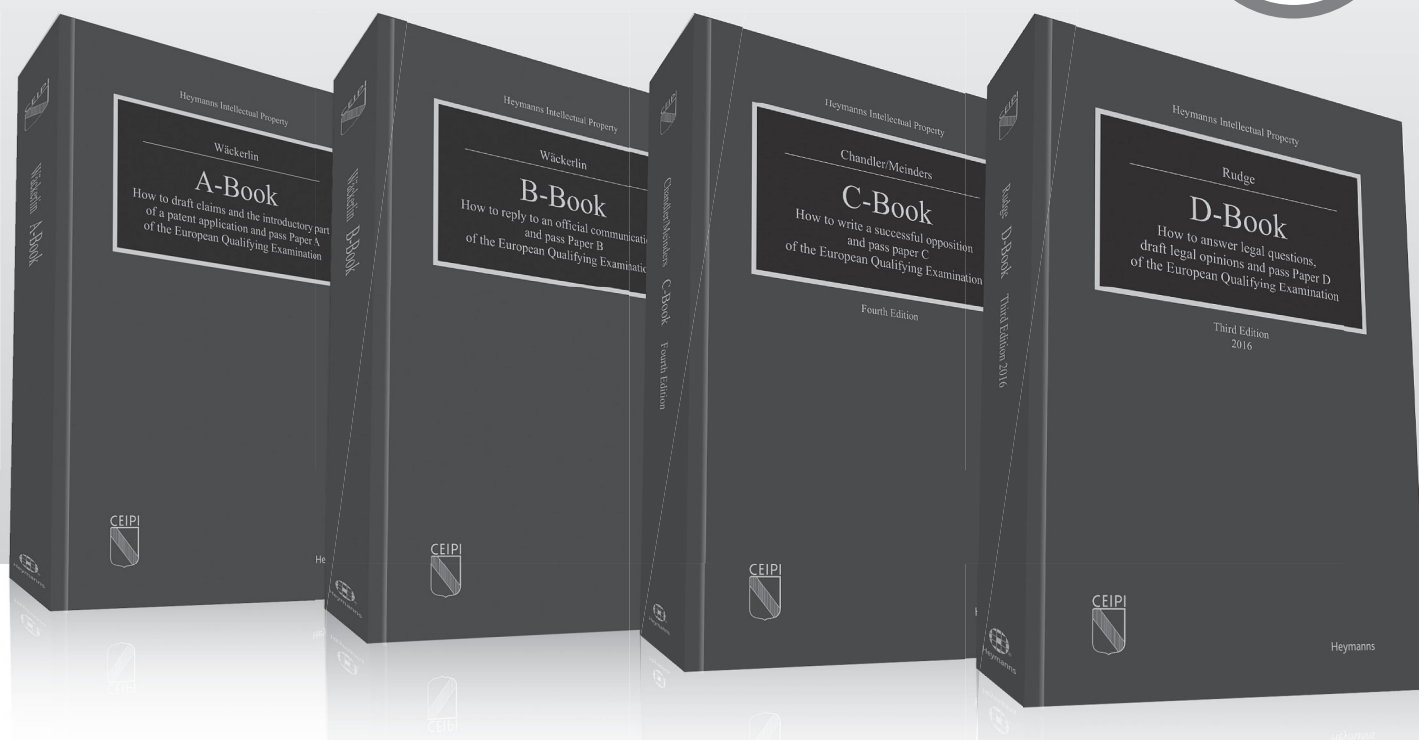
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