

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 07.05.2015 covers the period since my previous report dated 13.02.2015.

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 in the fields of 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. G3/14

The readers of **epi** Information remember that the *amicus curiae* brief of our Institute has been published in issue 4/2014, at pages 162-4.

The decision has now issued (on 24.03.2015). It states: “In considering whether, for the purposes of Article 101 (3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.”

Whilst Question 1 of the referral asked how the term “amendments” as used in **G 9/91** is to be understood, the Enlarged Board has concluded that neither the context of Article 101(3) EPC nor the object and purpose of the EPC as implemented by this article gives an unambiguous answer to the question of interpretation. It has added that the indication is that what is relevant is the amendment itself and its effect as regards the ground for opposition which it is intended to overcome. The Enlarged Board has clarified that if a claim is amended by limiting it to a complete dependent claim or by striking alternatives, such an amendment cannot be held to introduce non-compliance with Article 84 EPC; for other amendments based on dependent claims, it has to be decided case by case. Further, it concluded that if the patent is defended as granted, the fact that new prior art is cited which demonstrates that a granted claim is unclear has to be lived with. The Enlarged Board accepted that it is not optimal that there may be granted claims, even after amendment, which do not comply with Article 84 EPC.

Noteworthy that in the *travaux préparatoires* leading to the EPC2000, **epi** had suggested at an early stage that lack of clarity should be made a ground of invalidity (G3/14, at 70).

2. 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)”.

This paper had been circulated for comments in the MSBA sub-committee, and on the basis of the comments received our delegates to the AC meeting had been instructed. On behalf of **epi**, they 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.

An *ad hoc* working group has been set, which met on 6.4.2015 to prepare a draft paper containing the basic ideas for the **epi** position. This paper has been accepted by our Council at the end of its meeting in Barcelona on 25.04.2015.

The CA/16/15 paper has now been published on the EPO website, in the context of a public consultation. Our Institute will prepare and submit a paper. We have also requested a meeting with Mr Kongstad, Chairman of the Administrative Council, to explain our views.

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

The SC (Select Committee of the Administrative Council of the EPOrg) held its 13th meeting on 23–24.03.2015, dealing with the level of renewal fees, the amount to be reimbursed in the compensation scheme, and (again in closed session) the distribution key.

On 5.05.2015, the Court of Justice of the EU rejected the actions of Spain against both Regulations (C-146/13 and C-147/13).

The next meeting would take place on 26–27.05.2015. The agenda would comprise a proposal on the level of renewal fees, the compensation scheme, draft Rules relating to Unitary Patent Fees and, in closed session, the distribution key.

The next one would be held in the margins of the AC meetings in June 2015. The June meeting would see final decisions on all items.

4. SACEPO/WPR 12

The 12th meeting of the Working Party on Rules was held on 31.03.2015. As promised in the 11th meeting, the EPPC provided its updated “wish list” for rule amendments for consideration one month prior the meeting.

The agenda comprised essentially the following points relevant to the EPPC:

2. Amendment of Rule 46 EPC to allow filing of colour drawings: only the principle was discussed; all users approve.

3. Amendment of Rule 82 EPC for typed documents in opposition: it is proposed to add a third sentence to Rule 82 (2) EPC "*Where decisions under 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.*" All users approved. The EPO repeated that they would accept amendment of full paragraphs (as numbered in the B1 specification).

4. Amendment of Rule 147 EPC for preservation of files: there were some discussions because it was not clear what was kept and for how long. We argued for keeping the electronic files for the whole 20 years at least (so that grounds for refusal would – when applicable – remain known).

6. Any other business:

– Report on the Meeting of the International Authorities: the report itself is on the WIPO website. The EPO mentioned that there had been no compromise on the treatment of missing parts; this will be made clear in the EPO-PCT Guidelines. Also, same day priority claims remain an open question since they are not allowed in all national laws. Further, it was discussed whether the RO could forward to the ISA the search report it made for the priority application, together with the search copy (US/RO and others intend to make a reservation).

Incidentally, the EPO mentioned that automatic debiting from EPO deposit accounts would soon be available for PCT applications.

– Report on the state of play of the Unitary Patent.

– **epi** proposals for amendments to EPC Implementing Regulations: beyond clarification of some points, most were not discussed. The EPO repeated that in their view third party observations can only be filed in proceedings;

some users mentioned limitation proceedings and the unitary patent as reasons for placing them in the public part of the file.

5. Partnership for Quality (PfQ)

The PfQ meeting with **epi** took place in the afternoon of 20.04.2015, with a dozen members from the relevant sub-committees. The agenda covered essentially the EPO's quality management system, an update on recent developments relevant to quality, and developments in IP5 and work-sharing programmes.

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 next meeting is scheduled from 24 to 27.05.2015.

The PCT sub-committee prepared a position on the item "National phase entry using ePCT" which has been approved by Council during its meeting in Barcelona on 25.04.2015.

7. Examination Matters 2015

During this event, I enjoyed a poster prepared by Piotr Wierzejewski (DG1, Patent Procedures Management) which nicely summarises recent procedural changes in European patent practice. He kindly provided me with several copies, which were displayed during our Council meeting in Barcelona. The posters generated great interest, and the EPO kindly consented to publication in our journal.

Overview of procedural changes at the EPO

What	When	Description
Treatment of formal issues	2015	Amendment of Guidelines for Examination and/or Implementing Regulations (if necessary) to provide more flexibility when treating formal deficiencies (e.g. handwritten amendments)
Rules 124–127 and 129	2015	Terminology clarification in light of legal developments in EPC contracting states and IT developments at the EPO; replacement of term "post" with "delivery services"
Rule 147	2016	Shift to electronic file
Rule 71(3) waiver	Q3 2015	Proposal to introduce waiver of subsequent R 71(3) communications
Rule 164	Q4 2014	Give all applicants, irrespective of their chosen route, the same rights regarding non-unity prosecution; All Euro-PCT applicants to be able to ask for a European search report on any invention claimed, irrespective of previous ISA; all Euro-PCT applicants to be able to choose any searched invention as the basis for further prosecution
PCT-EPO Guidelines	Q4 2015	EPO will provide "Guidelines for search and examination at the EPO as PCT authority", describing specific procedures and substantive issues before EPO as RO/ISA/IPEA
PPH implemented	Done	Applications filed at EPO having corresponding application in any of other IP5 offices (JPO, KIPO, SIPO, USPTO) and whose claims are found to be patentable (allowable) will be processed at EPO in accelerated manner. PPH must be requested by applicant
PCT Deposit Accounts	Q3 2015	Holders of EPO deposit accounts to be able to request automatic debiting of accounts on basis of automatic debit order for specific international application. Electronic and online filing of debit orders
Global Dossier	Ongoing	Cooperation between IP5 offices to bring electronic files together to create a Global Dossier service

(from P. Wierzejewski, DG1 Patent Procedures Management)