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Patentamt zugelassenen Vertreter

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before the European Patent Office

Institut des mandataires agréés près  
l'Office européen des brevets

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### Beilagenhinweis:

Mit dieser Ausgabe verteilen wir eine Beilage der  
Wolters Kluwer Deutschland GmbH.  
Wir bitten um freundliche Beachtung.

## Obituary: Prof. Dr. Rüdiger Zellentin (1941–2014)



It was with great sadness that we learnt of the passing on 11<sup>th</sup> July 2014 of Rüdiger Zellentin at the age of 72.

Rüdiger had a long and distinguished career as a patent attorney.

Rüdiger served as Secretary General of **epi** from 1995 until 2002. He had a successful six-year term and made an important and valuable contribution to the Institute.

Rüdiger was known for his integrity and dedicated professionalism. He will also be remembered as a warm and generous man.

He will be sadly missed by all his family, friends and colleagues, to whom we extend our deepest sympathy.

João Pereira da Cruz  
Secretary General, **epi**

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

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **6. November 2014**. 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 2014**. 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 2014**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

## Editorial

T. Johnson (GB), Editorial Committee Chair

This piece is being written in the Holiday Season, so we on the Editorial Committee hope that all our readers had, or are having, a happy and relaxing time, with batteries recharged for the coming months. In the UK, the media, particularly the Press, refer to the holiday season as the 'silly season' as Parliament has risen for the summer recess and, in the past at least, there was little to report except news' items such as 'man bites dog'.

This is not true of our profession. A lot is going on, summer or not. The EPO has started work on its new main building in Rijswijk, a not inconsiderable construction project and one which on completion should benefit all of us in the European Patent Organisation, not least by adding to the already existing prestige enjoyed by the Office at home and abroad. This project is one we believe dear to the heart of President Battistelli, to whom we also tender our congratulations on his being in June confirmed in office until 2018. We look forward to our continuing cooperation with him in furthering the cause of the Organisation.

One other project on which work will be ongoing over the summer is the implementation process for the

Agreement on the Unitary Patent Court, Denmark having recently deposited an instrument of ratification. To quote our President "I think the UP and UPC will become extremely important for our profession. Therefore it is also important that **epi** provides information on these topics."

We will continue to try to do so, and to that end you will find in this issue a summary of a report of research carried out on behalf of the UK IPO into effects of the UP and UPC on business and the law. As readers will be aware, the Agreement will come into force after ratification by thirteen member states, of which the UK has to be one, so their IPO report is we believe of interest to our members. Let us hope that those charged with bringing the UP and UPC into effect will also take note of submissions made on behalf of the **epi**, as it is our members who will have the brunt of work within the system. The UP and UPC will have considerable impact on the protection of IP in Europe – there is no room for a 'silly season', the Agreement has to be right, for the benefit of the users!

## UP and UPC Study Summary, edited for **epi** by T. Johnson (GB)

The **UK IPO** recently commissioned a study of the UP and UPC by Dr. L. McDonagh of Cardiff University, the study being entitled:

### **“Exploring perspectives of the UP and UPC within the business and legal communities”.**

A summary of Dr. McDonagh’s research paper based on his study is set out below:

#### **SUMMARY**

##### **Study Aims and Methodology:**

Patenting in Europe is currently a fragmented and a complex process, both in application and in enforcement. This has wide implications for firms looking to protect their patents within Europe, often leading to greater costs compared to other patenting regimes. The aim of the establishment of the Unified Patent Court and the Unitary Patent is to offer a more streamlined and easy to use system with the ambition of unifying the European patent system as much as possible. While it is known that businesses and the legal community have various concerns about the proposed changes, the evidence base is limited. Recognising this, the UK IPO commissioned this empirical study examining the perspectives of the business and legal communities with regards to the Unified Patent Court and the Unitary Patent. The aim of this report is to outline and explore the most important issues for the stakeholders who will potentially use the court.

##### **The main objectives of the study:**

- Identify the key issues of concern to the business and legal sectors with regards to the Unified Patent Court and the Unitary Patent
- Assess and appraise which issues are of greater or lesser relative importance to stakeholders
- Gauge the overall sentiment of the aforementioned stakeholders with respect to the introduction of the Unified Patent Court and the Unitary Patent, including the likelihood that they will engage with the new system.

##### **The study methodology involved:**

- A review of existing literature on the current state of patent litigation in Europe and the UPC/UP reforms.
- In-depth interviews with key stakeholders within the business and legal sectors.
- Analysis and synthesis of the findings from the interviews, and the provision of recommendations based on the observations therein.

##### **Key Findings:**

The issues of judicial composition and quality will be crucial to the success of the UPC. Potential users of the UPC have real concerns regarding bifurcation and the granting of injunctions (especially in the ICT sector) and the central revocation risk (particularly evident in the Pharmaceutical sector).

There is also anxiety amongst stakeholders concerning patent troll litigation and forum shopping at the UPC. In this respect, companies in all sectors have concerns about the maintenance of common standards across the 25 MS of the UPC. It is imperative that a high-quality judiciary is established across the entire UPC system, as this will do much to alleviate these concerns.

To achieve this, effective training must be provided for the judiciary and clear UPC Rules of Procedure must be defined and published as soon as possible.

##### **Cost is a real issue of concern for potential users of the UPC and UP.**

There is hope that the UPC will lead to lower overall costs for patent litigation in Europe; however, this is tempered by the fact that many potential users fear that the costs of patent litigation in Europe will in fact increase.

There are also concerns over the value-based fee system, including its perceived unpredictability, although it is noted that it could encourage parties to keep their legal costs down since it puts a cap on recoverable costs, and some feel it may benefit SMEs.

Many businesses report that the wide protection offered by the UP may not be worth paying for, although it will be seen positively if fees are set at a reasonable level.

A UP renewal fee which is set far above the combined UK, French and German renewal fees is likely to reduce the attractiveness of the UP as an option for those who currently take out limited European protection.

##### **Whether to opt-in or opt-out of the UPC jurisdiction is an important decision that patentees have to make, and many stakeholders are as yet undecided about what they intend to do.**

The responses strongly suggest that the opt-out fee will be a major factor in this decision and several interviewees argued that it should be set at an administrative level.

The data suggest that many patentees will initially seek to opt out their most valuable patents, while keeping low and mid-range patents within the UPC system, though some patentees may opt-in their ‘strongest’ patents to benefit from one-stop enforcement.

**A Central Division is expected to be beneficial for the legal community.**

The legal profession faces a number of important challenges over the coming years as a result of the new system. The emerging view is that larger firms will benefit over smaller firms due to the amount of resources required to conduct speedy patent trials. Patent attorneys expect there to be an increase in costs for their firms.

The key concerns relating to SMEs are cost, the revocation risk, and the injunction risk. SMEs share many of the primary concerns of the larger companies regarding the UPC. However, the major difference for SMEs is the scale of the risk involved. A revocation ruling, or an injunction grant, against an SME with effect across 25 MS could prove fatal to the SME's prospects.

Overall, potential users of the UPC and UP possess both hope for, and concerns over, the new system.

Concerns such as higher costs, greater complexity and more patent troll litigation are countered by the potential

benefits of lower costs and one-stop enforcement. However, it is clear from the interviews that these hopes, expectations and fears are not set in stone; they are contingent on a number of yet to be decided issues, such as what the exact rules of procedure will be and what the precise levels of the fees for the UPC and UP will amount to.

As such, the planners/organisers of the UPC and UP ought to take into account the views of the stakeholders in order to harness the real, yet fragile, goodwill that exists towards the UPC, while at the same time allaying the major fears about it in the minds of the system's potential users.

(Our thanks to the UK IPO for providing us with this information, which we hope is of interest to our membership. The full text of the study, supported by the UK Govt., can be found at:

<https://www.gov.uk/government/publications/exploring-perspectives-of-the-up-and-upc>)

# Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 06.08.2014 covers the period since my previous report dated 07.05.2014 published in **epi** Information 2/2014.

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. Last EPPC meeting of the 2011–2014 term – Partnership for Quality

The EPO has been invited to attend the EPPC meeting of 24.04.2014. The following items were presented:

- Development in Trilateral and IP5: Influence of IP5 on European patent practice (examples of Global Dossier and harmonisation): (N. Morey, Director, International Organisations, Trilateral and IP5). Involvement of **epi** was once again requested.
- Quality improvements at the EPO (R. Rankin, Administrator, Quality Analysis and Policy)
- Benefits of Using the EPO as PCT Searching Authority (R. Rankin)
- PCT Metrics- Findings and lessons learned (R. Rankin)
- Brief summary on latest developments in unitary patent protection (E. Stohr, Director, International Legal Affairs)

The feedback from the members has been extremely positive, and I expressed on their behalf that we would be happy to invite the Office at regular intervals. My request for increasing the involvement of **epi** in the developments on the Quality Roadmap has however not – for the moment – attracted any reaction.

The EPPC also discussed reports from OCC (presented by M. Honkasalo, liaison member) and EPO Finances (presented by J. Boff), and heard reports from the latest Select Committee meetings.

## 2. Thematic groups

For the second time, a group of EPPC members met EPO Directors in the field of Pure and Applied Chemistry, which includes medical uses.

Meeting with Directors in the fields of CII and Industrial Chemistry are being planned.

## 3. CPL 44

The 44<sup>th</sup> meeting of the Committee on Patent Law took place on 15.05.2014. It gave a favourable opinion to a package of amendments to the Implementing Regulations aiming at clarifying that the EPO may use private delivery services for notification (Art. 119EPC) and adapting to technical means of communication. There was also an exchange of views on offices practices regarding missing parts.

## 4. SACEPO 46

The 46<sup>th</sup> meeting of the Standing Advisory Committee before the EPO (SACEPO) took place on 22.05.2014. As usual, the President presented his report on the development of the European patent system. A dozen presentations followed, with ample discussion. Of particular interest to the EPPC were:

- Status report on Article 123(2) EPC, with the conclusions drawn by the EPO after the Symposium held on 07.02.2014;
- An update on recent and forthcoming procedural changes;
- Information on "Early Certainty from Search" (priority given to searches as announced later on the EPO website).

## 5. PCT Working Group

The 7<sup>th</sup> session of the PCT WG took place in Geneva, from 10.06.2014 to 13.06.2014. The working documents and the 'Summary by the Chair' are available on the WIPO website at [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=32424](http://www.wipo.int/meetings/en/details.jsp?meeting_id=32424).

It was announced that HU, CZ, SK and PL are working towards the establishment of a new PCT International Authority.

The question of whether an international application could claim the priority of an earlier application with the same filing date as the international application (for incorporation by reference of missing parts), the WG agreed to discuss the matter at its next session with a view to providing an opinion on the matter for consideration by the Paris Union Assembly as the competent decision-making body.

Also discussed were national phase entry using ePCT and expanding the right to practice before RO/IB (see below).

The eighth session of the Working Group is tentatively scheduled to be held in Geneva in May/June 2015.



## 6. First EPPC meeting of the 2014–2017 term

The EPPC held its first meeting on 16.06.2014. I presented the EPPC, its organisation and its environment. The sub-committees were set up, the respective chairpersons appointed, and associate members appointed.

The committee then heard a few reports, including a report on two representation-related topics discussed at the PCT WG, and decided to specifically report to Council:

- National phase entry using ePCT (document PCT/WG/7/12): the major issue concerns the role of the local agent. The committee discussed the role of the local agent, and expressed concerns that the local agent could be appointed without being informed (with the risk of a conflict of interest).
- Right to practice before RO/IB (document PCT/WG/7/13): the IB proposed that any person who has the right to practice before the national Office of any PCT Contracting State should have the right to practice before RO/IB, ISA (including for supplementary searches) and IPEA, irrespective of the nationality or residence of the applicants; the proposal found no support in the PCT WG. It was noted that no problem arises when the agent designates himself as additional applicant.

The afternoon was devoted to a final review of the latest draft Regulations relating to unitary patent protection.

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

During its 8<sup>th</sup> meeting on 26.05.2014, the SC (Select Committee of the Administrative Council of the EPOrg) noted four presentations given by the EPO on financial projections concerning renewal fees and their impact on EPO income; a preliminary exchange of views followed. No conclusions were drawn.

During its 9<sup>th</sup> meeting on 24.06.2014, the SC in principle approved the draft Rules relating to unitary patent protection, except Rule 25 which deals with financial issues. However, several rules and explanatory notes would still be subject to adaptations in order to reflect the outcome of the discussions in the committee. In addition some issues were identified as requiring

further technical analysis: computation of time limits (in particular for the payment of a renewal fee with surcharge), surrender and information on compulsory licences.

The EPO made two further presentations on financial projections concerning renewal fees and their impact on EPO income. An exchange of views followed. No decision would be taken until a full picture had merged, including for the distribution key.

Finally, the EPO announced that they started working on a project concerning top-up searches aimed at discovering prior national rights during the examination phase.

On 01.07.2014, the Court of Justice of the EU held a three hour hearing in the actions of Spain against both Regulations (C-146/13 and C-147/13). In relation to the alleged violation of Article 291 TFEU and the “Meroni” case law, the impact of decision C-270/12 was discussed. At the end, it was announced that the Advocate General would deliver his opinion on 21.10.2014.

The timeline for the future work of the SC is as follows:

28.10.2014	10th SC Meeting
	Issues requiring further technical analysis (see above).
	Presentation and discussion on a fee proposal (level),
	presentation and discussion on the estimated costs and
	on the draft Budgetary Rules.
December 2014	11th SC Meeting
	(in the margins of the AC meeting)

## 8. Guidelines

The excellent cooperation with the EPO continues. The sub-committee has received the draft 2014 Guidelines for a final review. The 2014 Guidelines will issue later this year, because of the amendments (in particular to Rule 164 EPC) entering into force on 01.11.2014.

The sub-committee will meet on 05.09.2014 to discuss proposed amendments for the 2015 Guidelines, in preparation of the SACEPO/WPG meeting.

## 9. Meeting with VP1

The next meeting with the Vice-President DG1 and some of his staff has now been set on 24.02.2015. We will propose agenda items in due course.

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

P. Moutard (FR), Chair

### Inquiries about election of certain Board members

In view of the large number of Board members questions may arise in application of Art. 9 BL.

Further to the last Elections (76<sup>th</sup> epi Council) questions were raised concerning the validity of the re-election of some Board members.

The BLC has examined the situation of the Council members concerned and has come to the conclusion that no objection could be raised against the re-election of these members as Board members.

This kind of issue will probably arise more often in the future than in the past. The BLC therefore recommends that the Secretariat keeps an electronic register of elected Board members for each election, which register could be rapidly checked in case of re-election.

### Comments on draft budget and financial reporting process for committees

The epi Treasurer has prepared draft guidelines budget and financial reporting process for Committees.

Detailed comments were prepared by the BLC and submitted to the Treasurer on June 18.

### Other issues

Among the other issues being currently discussed by the BLC:

- A possible adaptation of the Rules for elections to Council (BL, Chapter 6, Section 7) in view of the electronic vote which has been implemented for the first time during the last Council meeting;
- Possible amendments of Art. 51 (casting vote).

A BLC meeting, including members of the Secretariat, will soon be scheduled, most probably around mid – October.

The work for adapting and updating the Collection of Decisions is going on, thanks to the help of the secretarial staff.

## Report of the Litigation Committee (LitCom)

A. Casalonga (FR), Chair

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

The draft proposal issued by the UPC Preparatory Committee concerning the requirements for European patent attorneys to be authorised to represent before the UPC has been published for comments on the official web site of the UPC.

The Litigation Committee prepared a position paper which was approved by the epi Presidency and sent to the secretariat of the Preparatory Committee.

The main points of this paper are the following:

#### 1. European patent litigation course (Rule 2):

In the context of the EPLC, the epi believes that in general, courses and qualification should be available in any EPC member state. The right to represent under Article 48(2) UPC applies to all EPA's including both

those from states that are party to the UPC and those that are not. All should be able to follow an appropriate course and it is in the interests of the system for any training centre that meets the required standard to be accredited, regardless of its specific location.

In addition, a body (not falling within the definition of a body of higher education) that falls under the competence of the EPO, such as the European Patent Academy could also be included, should they wish to apply.

#### **Rule 2 of the draft should therefore be amended to read:**

*"The Certificate may be issued by universities and other non-profit educational bodies of higher education in an EPC Member State [as well as by the Unified Patent Court's Training Centre in Budapest (hereinafter referred to as Training Centre) or by a*

*body falling under the authority of the European Patent Office (EPO) ..."*

## 2. Content of the course (Rule 3)

The **epi** considers that explicit mention of professional ethics, privilege and duties to the court should be included.

## 3. Other appropriate qualifications:

Beyond the transitional period, the present draft provides only for one alternative to the EPLC, namely a law diploma. The **epi** believes that while the EPLC will be the logical and preferred way of gaining entry to the list, the wording of Article 48(2) UPC requires discretion to recognize any appropriate qualification even beyond the transition period.

The **epi** therefore proposes the addition of a new Rule 11a stating:

*"European Patent Attorneys having other qualifications and experience may, at the discretion of the Registrar, be deemed to have appropriate qualifications."*

## 4. Other qualifications during a transitional period: Rule 12(b)

In the explanatory memorandum of the Preparatory Committee it is stated that Rule 12 takes into account that "in some Member States patent attorneys are already authorised to represent parties in national courts in patent infringement cases".

However, the **epi** wishes to stress that these are rare exceptions and in the vast majority of EPC member states, the parties must be represented by lawyers. Since most lawyers do not have a technical background, patent litigation in most EPC member states is a team-work between a lawyer and an experienced patent attorney, who sits next to the lawyer in court and is involved in all stages of the preparation and conduct of the case.

In addition, the experience required under proposed Rule 12(b) does not take into account other actions involving a patent such as preliminary injunction procedures or declarations of non infringement as well as actions involving supplementary protection certificates.

The **epi** believes all actions stated in Article 32 of the UPCA should be taken into consideration.

The **epi** therefore suggests the following amended wording for Rule 12(b):

*"(b) having represented a party or assisted a lawyer or a judge before the court in at least three actions initiated before a national court of an EPC Member State and involving a patent or a supplementary protection certificate, including at least one infringement action or one action for declaration of non-infringement within the five years preceding the application for registration."*

## 5. Effects of entry on the List (Rule 16):

For those EPAs registered on the List and thus authorised to represent before the UPC, it is essential that they can identify themselves as such and also distinguish themselves from others who are not so authorised.

The **epi** therefore suggests that those EPAs could refer themselves as "European Patent Litigators".

A new Rule 16(2) should be introduced, stating:

*"European Patent Attorneys registered on the List shall be entitled to refer to themselves as European Patent Litigator in the course of their professional activities in all of the Contracting Member States. Persons not registered on the List shall not be entitled to refer to themselves in this manner."*

## II. Rules of procedure of the UPC

It is expected that the 16<sup>th</sup> draft of Rules of Procedure will again be amended after further public consultation.

The Litigation Committee is monitoring the situation and is preparing a new position paper including further comments.

Any input from **epi** members is welcomed.

# Report of the Harmonisation Committee

F. Leyder (BE), Committee Secretary

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

## The Tegernsee process

The Tegernsee process is actually a fact-finding process on four key harmonisation issues of the grace period, 18-month publication, treatment of conflicting applications and prior user rights, so as to provide substance for future discussions on substantive patent law harmonisation. For details and the history, please consult e.g. the EPO website: <http://www.epo.org/news-issues/issues/harmonisation.html> (with links to the documents).

The Tegernsee Final Consolidated Report was approved on 8<sup>th</sup> April 2014, with the results of the User Consultation in the U.S., Japan and Europe (DE, DK, FR, GB and EP).

This report concludes the work cycle of the Tegernsee Experts on the four topics. The Offices involved decided that opportunities for feedback from users would be provided as they deem appropriate. In this context, the Japanese Patent Office held a Symposium on 10<sup>th</sup> July 2014 (see below).

The Report has been forwarded to the Chair of the Group B+. This Group will meet in Geneva, in the margins of the WIPO Assemblies at the end of September.

## JPO Tegernsee Symposium

The Japanese Patent Office held a symposium in Tokyo on 10<sup>th</sup> July 2014, entitled "Tegernsee Symposium – focused on Grace Period", in cooperation with AIPPI and FICPI. The presentations are available on the JPO website:

[https://www.jpo.go.jp/torikumi\\_e/hiroba\\_e/patent\\_sympo260710/en/speaker.html](https://www.jpo.go.jp/torikumi_e/hiroba_e/patent_sympo260710/en/speaker.html)

epi was represented by Naoise Gaffney.

## Industry IP5 Harmonisation Topics List

The Industry IP5 drafted a list of topics for harmonisation. The EPO has passed the list to epi, with a request for comments. This Committee will have the list on the agenda of its next meeting.

## 21<sup>st</sup> Session of the SCP

The 21<sup>st</sup> session of the Standing Committee on the Law of Patents (SCP 21) will be held in Geneva, from the 3<sup>rd</sup> to the 7<sup>th</sup> November 2014.

All working papers will be available on the WIPO website:

[http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=32102](http://www.wipo.int/meetings/en/details.jsp?meeting_id=32102)

As indicated in the Summary of SCP 20 by the Chair, the SCP decided that the non-exhaustive list of issues will remain open for further elaboration and discussion at the next session of the SCP. It further agreed that its work for the next session be confined to fact-finding and not lead to harmonisation at this stage. The draft agenda mentions:

4. Report on the international patent system: Certain aspects of national/regional patent laws
5. Exceptions and limitations to patent rights  
Seminar on exceptions and limitations to patent rights
6. Quality of patents, including opposition systems.  
Sharing session regarding experiences on international work sharing and collaboration
7. Patents and health
8. Confidentiality of communications between clients and their patent advisors  
Seminar on the confidentiality of advice from patent advisors
9. Transfer of technology.

## Next Committee meeting

The committee will meet in Munich on 17<sup>th</sup> September 2014.

# Report of the Professional Education Committee (PEC)

P. Rambelli (IT), Chair

The newly elected Professional Education Committee (PEC) had a meeting in Munich on 20<sup>th</sup> May 2014.

The new Committee is now composed of 35 full members and 29 substitute members; for the first time, the member states Greece and Monaco are represented in PEC.

Three associate members, having experience in education either as active tutors or as former PEC full members were appointed during the meeting and we are thankful to them for their voluntary commitment.

At the meeting we had the pleasure to have Mr. Jean-Michel Zilliox, Director IP practice, Mr. Giovanni Arca, Administrator Professional Representatives and Mr. Alejandro Flores-Jimenez, Head of Unit Didactics of the European Patent Academy, who gave a presentation entitled "Professional Representatives Training", providing inter alia an overview of the Academy's initiatives, also including proposed activity for 2015 to be carried out jointly with **epi**.

At present, work is in progress, involving the Academy, PEC and the Educational Team in order to define an agreement and working plan for the 2015 activities.

A main purpose of the PEC meeting was to establish the operating structure of the Committee for the incoming three-year term. The undersigned, Paolo Rambelli (IT) was elected and confirmed as Chairman of the Committee and Mr. Didier Lecomte (LU) as Secretary. Our thanks go to Mr Schweinzer, former Secretary and past Chairman for his dedicated activity.

A new structure for the Working Groups was established. In the new structure all full members of the Committee are also a member of a specific Working Group, together with their own substitute member. The following Working Groups were established:

## a) „EQE“ WG

This WG deals with the European Qualifying Examination (EQE). It monitors EQE pass rates and evaluates the results of the annual EQE candidates' survey. It liaises with the Examination Secretariat at the European Patent Office (EPO), which is responsible for the EQE.

Specific duties comprise:

- Revision of the EQE questionnaire
- Improvement of the EQE statistics
- Reviewing the IPREE and making proposal for amendment to be addressed by PEC to the Supervisory Board, if the need is spotted
- Monitoring the EQE, the development of the passing rates, the quality of the papers, the impact of the pre-examination, etc.

## b) “epi Tutors” WG

The “**epi** tutors” WG should i. a. supervise the training of **epi** tutors, and set up a training programme for **epi** tutors, a mentor programme for new tutors, organise the annual **epi** tutors' meetings, and monitor the quality of our tutors.

Specific projects include:

- Setting up mentor system for new tutors
- Monitoring the quality of tutorials, tutors, etc.
- Setting up standard documents/presentations for tutors
- Setting up a tutors' training, e.g. by liaising with CEIPI
- Organising the annual **epi** tutors' meeting
- Setting up a flyer to attract new tutors.

## c) “epi students and EQE candidates” WG

The “**epi** students and EQE candidates” WG has the task of supervising the training of candidates (especially **epi** students). The WG should monitor and update **epi** training options for EQE candidates, such as **epi** tutorials, Mock EQEs and seminars.

The task of the WG include:

- Developing educational events for **epi** students and EQE candidates
- Setting up a training scheme for **epi** students and EQE candidates to facilitate the preparation for the EQE, e.g. by liaising with CEIPI
- Advising **epi** students and candidates on EQE enrolment requirements
- Supporting the **epi** students and EQE candidates in their preparation for the EQE
- Cooperation with other organisations with regards to EQE preparation courses.

## d) „CPE“ WG

This WG deals with continuous professional education (CPE) of **epi** members and their supporting staff. It conceives and organises educational events, such as seminars and webinars, and draws up the PEC educational programme.

Specific projects comprise:

- Guidelines2DAY webinar series
- Seminar series “Life of a Patent”

## e) „UP/UPC Education“ WG (jointly set up with the EPPC and the LitCom)

The implementation of the Unitary Patent and Unified Patent Court system will significantly affect the daily work of **epi** members. PEC has the responsibility of providing training for **epi** members to prepare for the new systems.

As a result, in autumn 2013 PEC established a joint WG consisting of PEC-, EPPC- and LitCom members.

This WG will set up a training programme to address the needs of the different target groups and level of knowledge across the profession.

#### f) „CSP“ WG

This WG is by far the largest in PEC, since it includes the PEC members of all the countries eligible for the Candidate Support Project (CSP).

The Candidate Support Project, founded in 2012, based on the EPO Cooperation Roadmap, is now entering its third year of activity.

The project involves now 54 candidates. The PEC members of the newly established Working Group have recently been involved with the selection of the candidates for the third year in cooperation with the national selection board.

The Working Group members are also called to cooperate with Ms Mihaela Teodorescu and the PEC Chair to monitor the smooth developments of the project and to support the **epi** coaches when needed.

#### g) „Editorial“ WG

This WG deals with all PEC editorial issues. It regularly updates texts in the **epi** website Education Section, and publishes education-related articles and announcements in „**epi** Information“. It liaises with **epi**'s Editorial Committee.

Specific projects comprise:

- Update of the “Education and Training” website section

- Publications for **epi** Information
- Liaison with the **epi** Editorial Board

#### h) „Study on CPE“ WG

This WG is working to develop an acceptable mandatory Continuous Professional Education proposal for all European professional representatives.

The immediate goals of the Working Group involve the cooperation with the Disciplinary Committee and the Professional Conduct Committee to set up a proposal for amendment of the Code of Conduct to be presented at the 2014 Autumn Council Meeting for evaluation by the Council.

#### i) „Executive“ WG

The Group consist of the PEC Chair, the Secretary and all WG Chairs. This WG will constantly review current PEC projects, consult regularly and decide quickly on issues on behalf of PEC, when there is no time to consult with the whole committee.

\* \* \*

The undersigned wishes to thank Martina Baum for her active cooperation in designing and in the establishment of the new PEC structure. Martina Baum is presently on maternity leave and has been replaced within the Educational Team by Ms Barbara Riffert, formerly employed by the European Patent Academy.

My best wishes go to Barbara Riffert and of course to Jacqueline Kalbe, established Educational Team member, for a successful work programme.



## Report of the Disciplinary Committee (DC)

P. Rosenich (LI), Chair

The Disciplinary Committee had its annual meeting on June 16 and 17, 2014 in Copenhagen.

As new officers Paul Rosenich (Chair), Werner Fröhling (Vice-Chair), Tuna Yurtseven (Secretary) and Wolfgang Poth (Vice-Secretary) have been elected unanimously. The respective entry in the last **epi** Information was incomplete.

One elected Member of the Disciplinary Committee was elected also into the Board and had to leave the DC as a consequence

A training for mediation was held by Prof. Dr. James Peter from Zurich/Switzerland, especially to allow the new Committee Members to get familiar with DC's practice to long for conflict resolution in certain disciplinary cases.

The Disciplinary Committee (Disziplinarrat in German) is a judicial body under the EPC and not an advisor body of the **epi** in the sense of the other Committees. This was

made clear by adapting the respective content of the homepage of the **epi** in close cooperation with the legal advisor Maria Oliete Ballester, the Editorial Committee and Ms Sadia Liebig of the **epi** Secretariat.

The President of **epi** Tony Tangena instructed the Disciplinary Committee together with the Code of Conduct Committee to look into the question of Disciplinary Regulation for representatives before the upcoming UPC. A first meeting was held in Munich hosted by the Registrars of the Disciplinary Committee Ms. Veronika Pröll and Ms. Michele Voth and supported by the legal advisor. A working plan was developed and basic principles defined.

The Chairman has installed 11 fixed Chambers to deal with future disciplinary cases. Pending cases are being dealt with by the current responsible Chambers up to decision.

### Nächste Ausgaben · Forthcoming issues · Prochaines éditions

#### Issue

4/2014

#### Deadline

November 6, 2014

#### Publication

December 31, 2014

## Forthcoming **epi** educational events:

### Scheduled **epi**/EPO Seminars

21<sup>th</sup> November 2014 – Eindhoven (NL) – “Opposition and Appeal”

Further information on the scheduled seminars, **epi** Tutorials and Mock EQEs is available on the “Education and Training” section of the **epi** website [www.patentepi.com](http://www.patentepi.com).

## Annual **epi** Tutors’ Meeting in Munich on 9<sup>th</sup> October 2014

We are pleased to announce that the third **epi** tutors meeting will be taking place in Munich on 9<sup>th</sup> October 2014.

This year participants will have an update on the activities of tutors and coaches, which will be presented by the newly formed working group named “**epi** tutors”.

The latest developments of the Unitary Patent system at the EPO as well as an insight into didactical training will be highlights of this meeting’s agenda.

Enrolment form and further useful information can be found here:

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



## **epi** Dinner with the Examination Committees 2014

### **epi** Education Team, **epi** Secretariat

Every year the preparation and organisation of the European Qualifying Examination (EQE) imposes a huge workload on EPO staff to successfully lead the EQE alongside their colleagues of **epi**.

In order to thank all involved for their commitment, **epi** traditionally invites EQE responsible persons to an annual dinner. Over the years this event has become a highly appreciated get-together which gives the floor for exchanging opinions and enjoyment.

On 24<sup>th</sup> June 2014, **epi** President Tony Tangena opened the annual dinner by thanking the Examination Committees, the EPO Examination Secretariat, the Examination and Supervisory Boards, and the EPO and **epi** contributors for their valuable efforts with the EQE 2014.

We look forward to the next dinner in 2015 and continuing good cooperation.

Information about  
**epi** membership and membership subscription  
or  
Rules governing payment of the **epi** annual membership fee  
is available on the **epi** website [www.patentepi.com](http://www.patentepi.com)

## Contact Data of Legal Division

### Update of the European Patent Attorneys' database

Please send any change of contact details in writing 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 5.2.3 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 23 99-52 31  
Fax: +49 (0)89 23 99-51 48  
[legaldivision@epo.org](mailto:legaldivision@epo.org)  
[www.epo.org](http://www.epo.org)

Thank you for your cooperation.

## Next Board and Council Meetings

### Board Meetings

91<sup>th</sup> Board meeting on September 27, 2014 in Zagreb (HR)

92<sup>nd</sup> Board meeting on March 7, 2015 in Belgrade (RS)

93<sup>rd</sup> Board meeting on September 19, 2015 in Porto (PT)

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

### Council Meetings

77<sup>th</sup> Council meeting on November 15, 2014 in Milan (IT)

78<sup>th</sup> Council meeting on April 25, 2015 in Barcelona (ES)

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)

## Survey for all **epi** members on future of structure and activities of **epi**

We feel very proud to inform you that in total 2.149 members of the **epi** have participated in our online survey. We would like to take the opportunity to thank all those persons who have contributed their views and opinions regarding the future of the **epi**. In particular, we are very glad that members from each of the 38 member states of the **epi** have participated and therefore we assume that the different perspectives from all regions of

our profession are appropriately represented. The Reporting group on **epi** future will now analyse your suggestions and ideas. Within the next months they will present results to the **epi** Council and work on a process on possible reforms to make **epi** more effective and most importantly more useful for its members. Further details and future steps will be published in the **epi** Information as soon as possible.

## **epi** Artists Exhibition 2015

The **epi** Artists Exhibition of **epi** artists has become a tradition in the cultural life of the **epi** and of the EPO. Opened for the first time in 1991, it was followed by further shows in 1994, 1996, 1998, 2000, 2003, 2006, 2009 and 2012. The interesting works on display have ranged from paintings to graphical and fine art works, such as ceramics, sophisticated watches and jewellery, and artistic textile creations. The exhibitions which were opened by the Presidents of the **epi** and of the EPO met with great interest. We hope that the forthcoming exhibition will be just as successful. It is planned to take place from

2 March to 13 March 2015  
at  
European Patent Office  
PschorrHöfe building  
Bayerstrasse 34, 80335 Munich.

A prerequisite for the exhibition is a large participation of artists from various countries. Therefore, all creative spirits among the **epi** membership are invited to participate. Please disseminate the information!

Please note that all contributions to the **epi** Artists Exhibition have to respect religions and beliefs, political views and take into consideration that children might be visiting the exhibition.

For information please contact:

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## Note from the Editorial Committee

Two contributions in this issue of the **epi** Information address the same subject, namely the so-called poisonous priority or divisional application. According to recent decisions of the Board of Appeal, lack of novelty occurs under art 54 (3) EPC in view of a patent application having the same priority document. The authors of both contributions consider this development of the Case Law as problematic and suggest and hope that a referral to the Enlarged Board may clarify this legal point.

As Editorial Committee, we have decided to publish both contributions. This is not merely for a practical reason, but also reflects our opinion on the importance of the subject, loss of patent being a tough consequence, which is hard to explain to a client.

Perhaps somebody will come forward to provide a contribution for the next issue of **epi** Information, as to why the poisonous priority or divisional is not merely formalistically, but also materially, the right approach?!

## Divisionals Reloaded: T 1443/05 and Poisonous Divisionals

by C. Bobzien (DE)<sup>1</sup> and R. Drope (DE)<sup>2</sup>

Decisions T 1443/05<sup>3</sup> and T 0680/09 by the EPO Boards of Appeal have basically created a new priority law. In these cases European patent applications claiming a priority of a previously filed European patent application and including broadened independent claims with respect to the priority documents published afterwards were considered to lack novelty because of specific examples included in those priority applications. The post-published priority documents were considered to constitute fictitious prior art according to Art. 54 (3) EPC<sup>4</sup>.

These decisions were then consequently extended to divisional applications of national priority applications, in order to reject the European applications including broadened subject-matter with respect to the national priority document, see T 1496/11. The divisional application was awarded the priority of the priority application, the claim of the parent application was only awarded the application date. In consequence the divisional application constituted prior art according to Art. 54 (3) EPC for the parent application. Meanwhile several similar decisions have been passed by the Boards of Appeal and are discussed under the key word "poisonous divisionals"<sup>5</sup>. Thus, the content of a national unpublished priority document can also indirectly become prior art via divisionals according to Art. 54 (3) EPC.

These rather "creative" decisions by the EPO Boards of Appeal are a clear contradiction of a 30-year old established EPO practice and a more than 100-year old established practice according to the Paris Convention. There are no comparable decisions by national patent offices, including the USPTO, in support of this "poisonous divisional" case law. The established practice is not

based on a misunderstanding or ignorance. It was based on the understanding that by broadening the subsequent application in comparison with the corresponding priority application, double patenting could not result, be it under the prior claim approach or under the whole contents approach according to Art. 54 (3) EPC or corresponding legal provisions stipulated in national patent laws. Also, a patent application can specifically claim several priorities according to the EPC and the Paris Convention.

We are sure that there are more than a thousand European patents, that were granted in contradiction of these new decisions by the Boards of Appeal and were upheld by Boards of Appeal decisions, that would be invalidated if this legal opinion were upheld. We can only hope that national validity courts will not adopt this argument, despite the fact that these national courts will have to assess priority law according to the EPC with respect to European patents.

The priority document has several effects as prior art, possibly also by publication of the published subsequent application:

1. If the priority document is a published European application its entire contents constitute fictitious prior art by the priority date according to Art. 54 (3) EPC for the assessment of novelty. This is intended to avoid double-patenting by different inventors.
2. If the priority document is national application or an unpublished European application, it constitutes fictitious prior art according to Art. 54 (3) EPC indirectly by publication of the subsequent European application, but only as far as its contents are included in the subsequent application. Correctly: any additional disclosure in the priority document not included in the subsequent application can therefore not constitute fictitious prior art.
3. At the publication date, possibly by publishing the subsequent application claiming its priority, it is a

<sup>1</sup> Dipl. Wi.-Ing., European patent Attorney, [www.pateam.de](http://www.pateam.de)

<sup>2</sup> Dr. rer. Nat., Dipl.-Phys, European patent Attorney, [www.pateam.de](http://www.pateam.de)

<sup>3</sup> See also discussion of T 1143/05 re disclaimer-problem in Portal, **epi** information 2/2009, 56

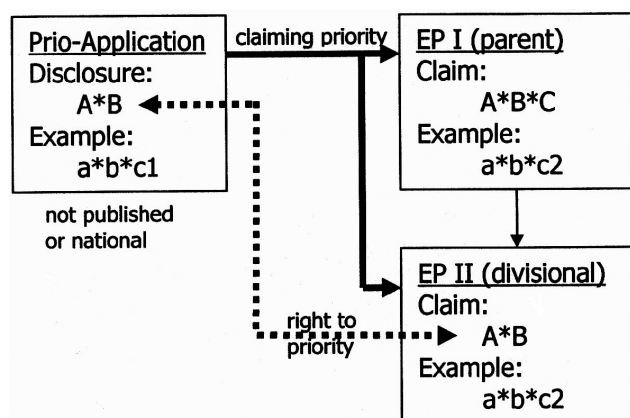
<sup>4</sup> Rots, **epi** information 4/2010, 133; Drope, Mitt. 11/2012, 494

<sup>5</sup> Lawrence, Wilkinson, **epi** information 2/2011, 54; Bremi, Mitt. 5/2009, 206; Kennington, **epi** information 2/2011, 82

publication just like any other publication of a scientific document or public prior use, its entire contents constitute prior art for the assessment of inventive step, Art. 56 EPC at its publication date or the publication date of the application claiming its priority. This applies to European application priority documents as well as national priority documents including a German priority-Utility model.

4. According to the newer decisions its effect of fictitious prior art according to Art. 54 (3) EPC is even effective against the subsequent application claiming its priority (see above nos. 1 and 2), either directly when the priority application is a published European patent application, or indirectly in the case of "poisonous divisionals" as far as the content of the priority document is included in the subsequent application.

This leads to a curious situation: If the priority document is not a published European application, and there is an example disclosing a specific feature generalized in the subsequent application, this example may be modified in the subsequent application. Thereby the original example in the priority document does not become part of the disclosure of the subsequent application claiming that priority and of possible divisionals thereof. The example of the priority document which is not included in the subsequent application and its divisional applications cannot indirectly become fictitious prior art under Art. 54 (3) EPC. This is explained in the following diagram: The specific example (a\*b\*c1) of the priority application cannot be cited against the generalized features (abc1 of claim (A\*B\*C) of parent EP I via divisional EP II because it has not become part of the disclosure of EP II.



Claim A\*B\*C is an AND-claim in the meaning of G2/98 and written as a product of features A, B and C in the sense of a mathematical convolution,

Claiming priority for European applications disclosing additional subject-matter has become a hazardous trap for applicants. They have to consider the possibility of filing divisional applications during drafting the European application which constitutes an incalculable burden<sup>6</sup>.

## Possible Solutions:

To avoid "poisonous divisionals" it has been suggested that the law be changed for divisional applications. A simpler and much quicker solution would be for the Enlarged Board of Appeal to pass a decision that the contents of the priority document cannot directly or indirectly be cited as prior art against a patent claim of a subsequent application, also in order to harmonize established national and European practices, as long as it cannot be cited as an intermediate publication as actual prior art according to Art. 54 (2) and Art. 56 EPC.

Clearly, a patent claim with a scope extending beyond the priority document does not represent the same invention disclosed in the priority document according to Art. 87 EPC and is therefore not entitled to a priority right. However, the priority claim is awarded to the patent application (Art. 88 (2) EPC, Art. 4 A Paris Convention), not a claim.

According to Art. 4 F Paris Convention the priority claim (Art. 88 EPC different from the priority right, Art. 87 EPC) can only be rejected for lack of unity. A subsequent application and a priority application therefore remain connected in a special manner by a valid priority claim (Art. 88 EPC). Contents and subject-matter of the priority claim is the disclosure of the priority application. How can this subject-matter also destroy novelty for the subsequent application as fictitious prior art (a detailed example in the priority document supporting a generalized claim in the subsequent application)? The disclosure of the priority document should therefore not constitute fictitious prior art according to Art. 54 (3) EPC<sup>7</sup>. The argument against double patenting does not appear valid. Early filing and early publication of research results are encouraged by exempting the priority document from fictitious prior art.

Since "poisonous divisionals" have not been addressed by the Enlarged Board of Appeals, the case law by the Boards of Appeal cannot be considered established case law. Decisions G02/98 and G03/98 commonly cited in this context (regarding AND- and OR-broadened claims, with respect to the priority application) were not based on facts including subject-matter like "poisonous divisionals" or a subsequently published European priority application. The underlying facts of these decisions related to published prior art according to Art. 54 (2) EPC and fictitious prior art according to Art. 54 (3) EPC, conventionally known as prior art. In any event these decisions did not address the situation where the content of the priority document could directly or indirectly be considered as prior art.

There are two alternative ways to proceed: A Board of Appeal could seek clarification by presenting this question to the Enlarged Board of Appeal. The alternative is for the President of the EPO to present this question to the Enlarged Board of Appeal to determine if these decisions are in line with the 30-year old established practice of the EPO.

6 Lawrence, Wilkinson, *loc. cit.*

7 Walder-Hartmann, GRUR Int. 2014, 17

## Potential Solutions for prior art under Art. 54 (3) EPC of the same patent family

J. Wohlmuth (CH)

Recent case law raised more and more the awareness for situations where the novelty of a claim of European patent applications is destroyed by its own priority application or by a European patent application claiming the priority of the same priority application, e.g. in the articles [1] and [2]. The subject shall briefly be resumed on the basis of those two articles. Subsequently, different solutions for this problem shall be discussed.

The enlarged board of appeal of the EPO construed the term "same invention" in Art. 87 (1) EPC as "only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole" (G2/98). Therefore, a claim of a European patent application fails claiming priority, if any of its features have been generalized with respect to the priority application. For example, a priority application P discloses a specific embodiment A', but not a generalized embodiment A. Then, the European patent application EP claiming the priority of P loses the priority for a claim on A.

In the case the priority application PEP is a published European patent application and the priority claim of a European patent application EP is not valid, the boards of appeal decided further in T1443/05 and T680/08 that the own priority application PEP can become state of the art under Art. 54 (3) EPC. In this case, the specific embodiment A' published with the priority document PEP destroys the novelty of the later-filed European patent application EP failing to claim the priority of the broader scope of protection A.

The same situation arises for any kind of priority application PXX disclosing A', whose priority is formerly claimed by the European patent application in question EP and a further published European patent application EP' disclosing as well A'. Then the specific embodiment A' of the further European patent application EP' becomes a state of the art under Art. 54 (3) EPC destroying again the novelty of the claim of the European patent application in question EP for the general embodiment A, because the specific embodiment A' disclosed in the further published European patent application EP' is able to claim priority of the priority application PXX. The further European patent application EP' could be a divisional of the European patent application in question EP as predicted in the mentioned article [1] and confirmed by the case law T1496/11 of 12.09.2012. The further European patent application EP' could also refer to a second invention on the same embodiment A' claiming the same priority application PXX.

This issue could become even more relevant for future unitary patents (UPs), if the future unified patent court (UPC) follows the strict interpretation of Art. 87 (1) EPC of the EPO. This is due to the fact that national priority applications of only one of the countries of the unitary patent could infer a nullity reason for the unitary patent under Art. 139 (2) EPC as described in [2]. However, it is also possible that the future UPC will follow the interpretation of Art. 87 (1) of e.g. the German supreme court which interprets Art. 87 (1) EPC such that a specific embodiment A' of a generalized scope of protection A could be a sufficient disclosure for validly claiming priority for A [3].

This recent development of the case law of the boards of appeal of the European patent office is not satisfactory and the following possible solutions are analysed.

### 1. Solution by change of the law

A change of the law seems the most unlikely solution. However, on a long term some hope is coming from the Tegersee experts group considering some questions on international patent law harmonization. At least two considered questions of harmonization could resolve the present issue.

One question of harmonization considers directly the prior right effect of an older patent application. On the user consultation of the EPO considering those questions, the Deutsche Patentanwaltskammer ([4]) favoured the Solution of Art. 54 (3) EPC as harmonized rule for prior rights. It was however mentioned that there is a need for an anti-self-colliding-clause that omits the above-described situation. Such an anti-self-colliding-clause could simply clarify that patent applications which have at least one applicant or successor in title in common with the patent in suit should not be considered for the novelty under Art. 54 (3) EPC.

Another question of harmonization considers a grace period for own publications of the applicant or the inventor in suit. If such a grace period is well formulated, it could also include the patent applications published after the filing date under Art. 54 (3) EPC and render an anti-self-colliding-clause for Art. 54 (3) EPC superfluous. This would be probably the most elegant solution. Care should be taken that such a grace period is open to change of applicants at least between the earlier filing or priority date of the prior right and the filing or priority date of the patent application in suit.

Considering the time periods of harmonization of international law plus the time it needs to organize a conference of the then probably more than 40 contracting states of the EPC, such a change of law for the EPC is



not likely within the next 10 years. In addition, such a new regime would not resolve the problem for the patent applications filed with the current law leading to a total of at least 30 years before this problem is completely resolved.

Maybe at least the problem for the future unitary patent applications could be addressed earlier by the ratifying contracting states of the UPC agreement. The biggest challenge for the acceptance of the new UP is to convince the practitioners and industry that there are no disadvantages compared to the present system. However, one well-known disadvantage of the unitary patent is that now a prior right of only one participating member state of the UP could destroy the novelty of the UP for the complete territory of the UP. Therefore, there are attempts to convince the contracting states, when ratifying the UPC and UP package, to allow in the national law under certain circumstances a so-called late-validation of national bundle patents of the UP group. This would give the patent owner under those circumstances the fall back to request the validation of the classic national bundle patents well after the three months period after grant of the European patent. One of the discussed circumstances is after a revocation of the UP due to a prior right. This would allow the patent owner in such a case to request at least the national patent validations for the contracting states not being compromised by the prior right. Coming back to our problem, when the own priority application of the UP being filed and published as a national patent application of one participating countries of the UP destroys the novelty of the UP, the patent owner could achieve the protection in most of the territory of the UP by a late-validation of the countries not compromised by the own priority application. However, the support among the participating Member States for this option seems not to be enormous at the moment ([5]).

Therefore, other solutions for the present issue are required.

## 2. Solution by case law

An immediate solution of this issue could be provided by the case law. Again the following case shall be considered. A published European priority application EP' (or another published European patent application claiming the same priority application) discloses the specific embodiment A' without any disclosure for the broader embodiment A and the European patent application EP in question claims the broader embodiment A, e.g. as in T680/08 and T1443/05. The scope of the claim for A can now be mentally divided in an "OR"-claim with the first alternative A' or the second alternative A without A'. For the first alternative claiming the specific embodiment A' the priority is valid, while the second alternative A without A' the priority is not valid. Consequently, the specific embodiment A' disclosed in the priority application cannot be state of the art according to Art. 54 (3) EPC for the first alternative A' in the claim on A, because the priority is valid for the first alternative A'. Fur-

thermore, the specific embodiment A' might be a prior right for the second alternative A without A', but is not novelty destroying for the second alternative. Such an argumentation can be based on the following case law.

The enlarged board of appeal pointed out in G2/98 reason 6.7 regarding multiple priorities of "OR"-claims that "the use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88 (2), second sentence, EPC is perfectly acceptable under Articles 87 (1) and 88 (3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters". The board of appeal in T1222/11 developed very well, in reason 11, how the feature "a limited number of clearly defined alternative subject-matters" must be interpreted considering also the Memorandum C drawn up by FICPI (M/48/I, Section C) for the Munich Diplomatic Conference in 1973 with three examples for multiple priorities. Those three examples show the situation where a first priority discloses A' and a second priority discloses A with the consequence that the claim on A has two priority dates, the first priority date for A' and the second priority date for A without A'. In reason 11.8, the board applied this concept of multiple priorities also to the present situation. It considers that the claim on A in EP should have two relevant dates, the priority date of EP' for the first alternative A' and the filing day of EP for the second alternative A without A'. The board specified in T1222/11 in reason 11.8 further that the priority claim for the first alternative A' is even independent of the fact that A' is disclosed in the later filed European patent application in question. With this interpretation T1222/11 expressly contradicts the approach of T1443/05 for interpreting the feature of a *limited number of clearly defined alternative subject-matters* of G2/98. In T1443/05 (and also in T680/08) it was decided that A' itself contained too many alternatives and the use of two dates according to G2/98 was refused. However, independently of how many alternatives A' comprises, in the discussed case, the scope of the claim can always be separated in a first set A' of all alternatives being disclosed in the priority document and a second set A without A' including all the remaining alternatives of A not being disclosed in the priority document. Therefore, the argumentation of T1222/11 seems right that the first set A' and the second set A without A' are two clearly defined alternative subject-matters and fulfil the feature of a *limited number of clearly defined alternative subject-matters* of G2/98, namely. This is intrinsic to the discussed problem and should always be applicable.

The contradiction on the interpretation between T1443/05 or T680/08 and T1222/11 for the feature of a *limited number of clearly defined alternative subject-matters* of G2/98 would be a reason for a referral to the enlarged board of appeal under Art. 112 (1) EPC. Such a referral would also clarify the approach for determining the first application disclosing the invention under Art. 87 (1) EPC, i.e. the date for calculating the end of the priority year.

For the case that the opinion of T1443/05 or T680/08 will be prevalent in the future, in the following a practical solution to the problem shall be discussed.

### 3. Practical solution for the actual situation

If a board of appeal refuses the above-discussed solution, it is proposed to *explicitly* reformulate the claim on A in EP as an "OR"-claim with the first alternative A' and the second alternative A without A'. In this case, the first alternative A' can validly claim the priority for A' and the priority application EP' is not a state of the art according to Art. 54 (3) EPC and the second alternative A without A' holds only the filing date, but A' of the priority application is not novelty destroying for A without A'.

However, this practical solution could create some problems regarding the disclosure of one or two of the alternatives with respect to Art. 123 (2) EPC. Obviously, there is no problem with Art. 123 (2) EPC, if the European patent application discloses the specific embodiment A' and the disclaimer A without A'. The disclaimer could be disclosed explicitly as a disclaimer "without A'" or as a positive feature like  $A=A' \cup A''$  with  $A''=A$  without A'.

Normally, the first alternative A' disclosed in the priority application is also disclosed in the later-filed European patent application EP. For the unusual case that A' is not originally disclosed, there is no case law yet which could justify the claim on the first alternative A' with respect to Art. 123 (2) EPC.

If the disclaimer "A without A'" of the second alternative is not explicitly disclosed – which is often the case – the case law for the allowability of undisclosed disclaimers of G1/03 and G2/10 must be considered. According to G1/03 (points a) to d)) and G2/10 (point e)) an undisclosed disclaimer in this case is allowable:

- a) if it restores novelty by delimiting a claim against state of the art under Article 54 (3) and (4) EPC;
- b) if it does not remove more than is necessary to restore novelty;
- c) if it does not become relevant for the assessment of inventive step or sufficiency of disclosure (subcase of e));
- d) if the claim with the disclaimer meets the requirements of clarity and conciseness of Article 84 EPC; and
- e) if the subject matter A without A' is directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

While a) is intrinsic to our problem, b), c), d) and e) must be considered for each individual case. The conditions b) and d) might become problematic, if A' comprises a large

number of alternatives which cannot be formulated clearly and concisely without removing more than necessary to restore novelty. Regarding the conditions c) and e), in G2/10 in reason 4.5.3. it is said that the disclaimer "without A'" normally does not provide a problem for the disclosure of the remaining part "A without A'" of the claim, but it has to be checked for each case. In addition, there is the clear intention to expand the protection from the embodiment A' to the embodiment A including also A without A'. Therefore, in most cases such a disclaimer should be allowable.

This solution should allow in most cases protection of all the embodiments A by reformulating the embodiment in a binary way as first alternative A' and a second alternative A without A'. As long as the specific embodiment A' is still disclosed in the European patent application EP in question, this should be allowable under Art. 123(2) EPC in most of the cases.

### 4. Conclusion

It was shown that a change of law is unlikely and would take too much time to resolve the problem of an own priority application being prior art under Art. 54 (3) EPC.

However, the present case law showed up in T1222/11 a potential solution for this problem by dividing the claim on A in the embodiments of A disclosed in the priority application for which the priority claim holds and the embodiments of A not disclosed in the priority application which might not be able to claim the priority, but which are also not anticipated by the priority application under Art. 54 (3) EPC. The contradiction to the approach of T1443/05 or T680/08 should be sufficient to justify a referral to the enlarged board of appeal for clarifying this legal uncertainty.

Until this issue is clarified and in the case that the opinion of T1443/05 or T680/08 will be confirmed, a practical solution could be to explicitly formulate the claim on A as a first alternative A' being disclosed in the priority document and as a second alternative A without A' being not disclosed in the priority document. This should be possible under Art. 123 (2) EPC in most of the cases.

[1] „Poisonous EPC Divisionals“ by M. Lawrence and M. Wilkinson, published in *epi* information 2/2011

[2] „Poisonous National Priority Applications for the Unitary Patent“ by P. Rambelli, published in *epi* information 1/2014

[3] Bundesgerichtshof (BGH), Kommunikationskanal, X ZR 107/12, February 11, 2014.

[4] „Konsultation des EPA zu den im Rahmen der Tegernsee-Expertengruppe aufgeworfenen Fragen“, by Dr. Keussen, Kammerrundschreiben KRS 2/13, Page 59, published by the Patentanwaltsammer.

[5] „Report of the European Practice Committee (EPPC)“ by F. Leyder, published in *epi* information 2/2014



# What is the legal effect of a prior national right for a European Patent with unitary effect?

by V. Mellet (BE)

A prior national right is a right under Art. 139(2) of the European Patent Convention<sup>1</sup> (herein after 'EPC'). This includes national patent applications or national utility model applications that have been filed earlier than a European application, but published after the filing date of said European application, in a Member State where the European Patent has an effect.

A prior national right may be relevant to the novelty of a claim in a European patent application or a European patent under Art. 139 (2) EPC. Thus a prior national right can be the priority application of a European patent when the claims are not entitled from the priority date<sup>2</sup>.

## Overview of the current situation regarding European patents without unitary effect

The European Patent Convention (EPC) deals with national rights in Art. 139 (1) and (2) EPC to avoid double patenting by European and national applications or patents having different filing dates. According to the second paragraph of this article, a national patent application and a national patent in a Contracting State shall have, with regard to a European patent designating that Contracting State, the same prior right effect as if the European patent were a national patent. Due to this equivalence, when the national right is older than the European right, Art. 139 (2) EPC gives a ground for revocation under Art. 138 (1) (a) EPC of the European right.

However, it is noted that prior national rights are neither an obstacle to patentability *per se* (and thus cannot be cited under Art. 54 or 56 EPC), nor a ground for opposition under Art. 100 EPC. Prior national rights from EPC Contracting States do not constitute prior art under Art. 54 (3) EPC, as this article only refers to earlier European patent applications.

As a consequence, prior national rights are not searched by the European Patent Office. If such earlier right is discovered before the grant of the European patent, the Applicant is informed accordingly. As an exception to Art. 118 EPC, the Applicant may, therefore, voluntarily file different claims, description and drawings for the designated State where the prior national right exists. In such case, the European patent will be granted with different claims for the designated State in question. Thus, a prior national right may have an impact on the scope of the claims of a European patent, but only in the State where it was filed.

After the grant of the patent, and according to Art. 2 (2) EPC, the European patent shall have the effect of and be subject to the same conditions as a national patent granted by that State. Therefore, a third party can attack the validity of the granted European patent in any designated State on the basis of a prior national right according to Art. 138 (1) and Art. 139 (2) EPC. As a consequence, the European Patent can be limited or revoked for the territory of that State.

So, regarding a European Patent without unitary effect, a prior national right can have an impact on the validity of a European Patent after the grant of said patent but only in the State where such prior national right exists.

What will be the situation regarding European Patent with unitary effect?

## A prior national right may prevent the registration of the unitary effect if discovered before grant of a European Patent.

If prior national rights are not an obstacle to patentability during examination or opposition proceedings before the European Patent Office, they may affect the possibility to benefit from unitary effect of the European Patent.

Indeed Art. 3 (1) Regulation (EU) 1257/2012 (hereinafter 'UPR') of 17 December 2012 implementing enhanced cooperation in the area of unitary patent protection, provides that

*"A European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection."*

*A European patent granted with different sets of claims for different participating Member States<sup>3</sup> shall not benefit from unitary effect."*

So, to benefit from unitary effect, the European patent needs to be granted with the same set of claims in respect to all the participating Member States.

Therefore, if a prior national right is discovered in a participating Member State prior to the grant of a European patent and the Applicant decides to file a different set of claims for that State, this will prevent the

<sup>1</sup> The European Patent Convention referred to is the EPC 2000, i.e. as revised by the Act of 29<sup>th</sup> November 2000, unless explicitly specified otherwise.

<sup>2</sup> See „Poisonous National Priority Application for the Unitary Patent“, by P. Rambelli in *epi* Information 1/14

<sup>3</sup> Participating Member States: Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Romania, Portugal, Slovenia, Slovakia, Sweden, United Kingdom (25 States presently; Spain and Italy did not join the enhanced cooperation, and neither did Croatia when it became an European Union Member State)

registration of the unitary effect for the European patent. Of course, the Applicant will still have the possibility to validate the European Patent in the designated States of his choice.

**If discovered after grant, a prior national right may have a different legal effect depending on the interpretation of the legal texts.**

The UPR does not deal explicitly with prior national rights, but the Agreement on a Unified Patent Court (hereinafter 'UPCA') does. The UPCA establishes the Unified Patent Court (hereinafter 'UPC') for the settlement of disputes relating to European patent and European patent with unitary effect. It takes prior national rights into consideration by means of its Art. 65 (2) which refers to Art. 138 (1) and 139 (2) EPC.

Art. 65 (2) UPCA provides that:

*"The Court may revoke a patent, either entirely or partly, only on the grounds referred to in Articles 138 (1) and 139 (2) of the EPC."*

Art. 65 (2) UPCA refers to "a patent". A definition of patent is given in Art. 2 (g) UPCA, which provides that patent "means a European patent and/or a European patent with unitary effect". From this it can be understood that according to Art. 65 (2) UPCA, a prior national right may be a ground for revocation (whether entirely or partly) for both European patent and European patent with unitary effect. Thus, if a prior national right is discovered in a participating Member State where the national law is providing a basis for such ground of revocation, the prior national right can be cited against the European patent with unitary effect.

A problem then arises from the unitary character of the European patent with unitary effect that establishes a uniform protection. To this purpose, Art. 3 (2) UPR provides that:

*"A European patent with unitary effect shall have a unitary character. It shall provide uniform protection and shall have equal effect in all the participating Member States."*

*It may only be limited, transferred or revoked, or lapse, in respect of all the participating Member States."*

A possible interpretation of the provisions of the EPC, the national laws, the UPCA and the UPR together, is that a prior national right can be cited against the European patent with unitary effect in its entirety, leading to its revocation in full ("entirely" as per Art. 65 (2) UPCA). Is that interpretation correct? We will try to determine what can be the legal effect of a prior national right for a European patent with unitary effect through the answers to four questions.

**Question 1: Can a prior national right affect a European Patent with unitary effect in its entirety?**

If the Unified Patent Court, when applying Art. 65 (2) UPCA, answers positively to this question, an action or counterclaim for revocation of the patent before the UPC, based on a prior national right in one participating

Member State in which the unitary effect has an effect, may result in the revocation or the limitation of the European patent with unitary effect in respect to all the participating Member States and not only with respect to the territory of the State where such prior national right was filed.

This would result in an extension of the legal effect of a prior national right from the territory of the participating Member State where it was filed to the territory of all participating Member States for granted European patents with unitary effect. Indeed, this implies that its legal effect is not limited to the territory of the State where it was filed. It could, therefore, affect the scope of protection or the validity of a European patent even for the countries where this prior national right cannot be cited against the validity of the patent under either the EPC or the national law.

Such an approach would be contrary to Art. 138 (1) and 139(2) EPC, as Art. 139 (2) EPC limits the effect of the prior national right to the Contracting State where it was filed by stating that:

*"A national patent application and a national patent in a Contracting State shall have with regard to a European patent designating that Contracting State the same prior right effect as if the European patent were a national patent."*

Moreover, it would confer to the national prior right a different legal effect according to the date on which it was discovered. Indeed, if discovered before grant or if the unitary effect has not been requested, the prior national right may result in a limitation of the patent only in the territory of the participating Member State where it was filed (by the filing of a different set of claims for that State), whereas if discovered after grant it may result in a limitation or revocation of the patent in all the participating Member States.

However, the Unified Patent Court, when applying Art. 65 (2) UPCA, may answer negatively to this question. Indeed, the UPC may assume that the UPR is a special agreement with the meaning of Art. 142 EPC in accordance with Art. 1 (2) UPR, and that, in the case of discrepancy, provisions of EPC shall prevail. In such a case, the Unified Patent Court will consider that the effect of a national prior right is still limited to the territory of the State where it was found. The European Patent with unitary effect as such would not be affected in its entirety, but only its part in the relevant State. Since this implies a possible limitation or revocation of the European Patent with unitary effect in one of the States for which the unitary effect has been registered, what will become of the unitary effect?

**Question 2: Can a prior national right cause the loss of the unitary effect?**

A positive answer to this question would result in the loss of the unitary effect for all the participating Member States, and in the limitation or revocation of the European Patent only in the State where the prior national right was filed. In other words, the unitary effect would

be lost but not the right attached to the patent in all the participating Member States where the prior national right is not applicable.

Such an approach would be in accordance with Art. 139 (2) EPC. It would also be in accordance with Art. 3 (2) UPR which establishes that a European patent with unitary effect *“shall provide uniform protection, and shall have equal effect in all the participating Member States”*. So if the patent is limited or revoked in one of the participating Member States, the uniform character of the protection is lost and so is the unitary effect.

This approach is also in line with the third sentence of said Art. 3 (2) UPR establishing that *“It may only be limited, transferred or revoked, or lapse, in respect of all the participating Member States”*.

This would be also in accordance with the statement made in the UPR that the unitary effect attributed to a European patent should have an accessory nature. This approach may be supported by Art. 3 (3) UPR which states that *“the unitary effect of a European patent shall be deemed not to have arisen to the extent that the European patent has been revoked or limited”*.

However, it may be assumed that in the large majority of the cases, if not all, the loss of the unitary effect will take place after the validation period prescribed by Art. 65 (1) EPC. This would be the case in particular when this loss is the consequence of the citation of a prior national right in revocation proceedings.

In order to avoid double protection via both the registration of the unitary effect and the validation procedure, the registration of the unitary effect replaces the need to proceed with the validation of the European patent. Thus, in case of loss of the unitary effect, the patent right would be lost in all the States where the patent has not been validated. Indeed, according to Art. 65 (3) EPC, the failure to proceed with the validation procedure in a State is that *“the European patent shall be deemed to be void ab initio in that State”*.

The validation of the European Patent, in parallel to the registration of the unitary effect, in one or more States would not help as in accordance to Art. 4 (2) UPR it would be deemed to not have taken effect.

Indeed, Art. 4 (2) UPR states that *“The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered and extends to their territory, that European patent is deemed not to have taken effect as a national patent in their territory on the date of publication of the mention of the grant in the European Patent Bulletin.”*

Thus it seems that it would not be possible to have the patent being kept alive on the basis of a validation performed in parallel to the registration of the unitary effect, unless the phrasing *“deemed to have not taken effect”* is understood *“deemed to have not taken effect as long as the unitary effect of the European patent is in force”*. In such a case the requirement of a payment of the renewal fees in each validated Contracting States should be regarded as being complied with by the

payment of the renewal fees for the European Patent with unitary effect before the loss of the unitary effect. However, proceeding to validation as precautionary measure would be an extra cost for the Patentee that would not be in the spirit of the UPR.

So, if the unitary effect is lost with the consequence that the European patent has not been validated in due time, and if the legal effect of a prior national right is limited to the State where it was filed, then the possibility to make a late validation of the patent should be given to the Patentee, including, if appropriate, the possibility to provide an amended set of claims for validation in the State where the prior national right was filed<sup>4</sup>.

As a consequence, the prior national right would have the effect to avoid the existence of a unitary effect attached to a European patent independently on the date on which that prior national right was discovered.

Unfortunately, there are no provisions in the national laws to open a new period for validation of the European patent after the loss of the unitary effect. Also, there are no provisions to suspend the validation period from the date that the registration of the unitary effect is requested to the date that this registration is refused or to the date on which the unitary effect is lost.

The lack of provisions or the uncertainty as regard to a possible late validation of a European patent leads to take into consideration a possible negative answer to this second question (i. e. can a prior right cause the loss of the unitary effect?).

A negative answer means that the unitary effect would not be lost in the case of limitation or revocation of the European Patent with unitary effect in one of the States for which the unitary effect has been registered. In other words, the effect of a prior national right would be limited to the part of the European patent in the relevant State where the prior national right was found (and would not affect the European patent in its entirety), and would not cause the loss of the unitary effect.

In such a case, Art. 3 (3) UPR should be interpreted as allowing a later change which will retain the unitary effect but will reduce the extent of the unitary effect. The phrasing of Art. 3 (3) UPR establishing that *“the unitary effect of a European patent shall be deemed not to have arisen to the extent that the European patent has been revoked or limited”*, seems to support also such an interpretation. However, it should then be defined what should be understood by *“the extent”* of the unitary effect? Does it refer to the participating Member States in which the unitary effect has effect? This leads to the third question.

### **Question 3: Can a prior national right lead to the exclusion of the State where it was filed, from territories in which the European patent has unitary effect?**

If answered positively, then the requirement of having the same set of claims in all participating Member States,

<sup>4</sup> see epi position paper dated 21.06.2010 on „Earlier National Applications and the EU Patent, proposal for a council Regulation on the EU Patent“.

as required by Art. 3 (1) UPR, would be interpreted as being only a condition of registration of unitary effect, and as being mandatory only at the date of grant of the patent.

This approach could be supported by Art. 5 UPR related to the uniform protection. Indeed this article refers in paragraph (1) and (2) to the *"participating member States in which the patent has unitary effect"*. The first paragraph even specifies that the protection given throughout the territories of the participating member States is subjected *"to applicable limitations"*. Thus, an *"applicable limitation"* would therefore be a limitation in the territories of the participating Member States in which the patent has unitary effect.

The later change in the protection conferred by the European patent with unitary effect as regard to the territories covered by the unitary effect would be a derogation from Art. 3 (1), 3 (2) and 4 (1) UPR. It is noted that such derogation is already allowed by Art. 18 UPR as transitional measures related to the entry into force and application of the UPR. Indeed Art. 18 UPR provides that a European patent has a unitary effect only in *"those participating member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patent with unitary effect at the date of registration"*. So, the situation where two European patents with unitary effect may not have the same scope of protection as regard to the territories covered by the unitary effect is already allowed by the UPR.

Additionally, the phrasing of Art. 4 (2) UPR which reads: *"The participating member States (...) where the unitary effect of a European patent has been registered and extend to their territory (...)"* (emphasis added), may also be interpreted as meaning that the unitary effect does not necessarily extend to the territory of a participating Member State.

However, in such a case a national prior right would still have a different legal effect according to the date on which it was discovered. Indeed, if discovered before grant, the prior national right may prevent the registration of the unitary effect (if the applicant decides to file different claims for the relevant State), whereas if discovered after grant it would have an effect on the extent of the unitary effect but not on the possibility to have a unitary effect registered.

Nevertheless, the Unified Patent Court may assume that the principle of the uniform protection conferred by the unitary effect prevents the development of such an approach, and that derogation from Art. 3 (1), 3 (2) and 4 (1) UPR may only be granted as transitional measures related to the entry into force and application of the UPR.

If answered negatively, then the phrasing *"to the extent that the European patent has been revoked or limited"* of art 3 (3) UPR, should be understood as referring to the scope of protection given by the claims.

The requirement of having the same set of claims in all participating Member States, as required by Art. 3 (1) UPR, would be interpreted as being only a condition of registration of unitary effect, and as being mandatory only at the date of grant of the patent. The later change

in the protection conferred by the European patent with unitary effect would allow a limited set of claims only in the State where such prior national right exists, as derogation from Art. 3 (1) and 3 (2) UPR.

Unfortunately, here again, the lack of provisions in this respect in the applicable laws may prevent the development of such an approach. Moreover, this approach may add complexity as regard to the determination of the scope of protection conferred by the patent, which seems clearly not intended by the UPR.

Due to the lack of provisions in applicable laws or due to interpretations of articles that may be incompatible with each other, there is no answer to the above questions that is entirely satisfactory.

By taking a step back, it can be noted that a basic premise was posed at the beginning of his paper. This basic premise is that according to Art. 65 (2) UPCA, a prior national right may be a ground for revocation for both European patent and European patent with unitary effect. Could this premise be reviewed?

It has already been noted that Art. 65 (2) UPCA refers to *"a patent"* and that the definition of patent is *"a European patent and/or a European patent with unitary effect"*. The wording *"and/or"* clearly provides a great deal of latitude when applying Art. 65 (2) UPCA. The following fourth question is therefore raised and should be the first to be answered by the Unified Patent Court in the case that a prior national right is used as ground for revocation of a European patent with unitary effect.

#### **Question 4: Can a prior national right be used as a ground for revocation for an European patent with unitary effect?**

The first answer that comes to mind is positive because the European Patent with unitary effect is a European Patent and therefore subjected to Articles 138 (1) and 139 (2) EPC. The situation occurring if the Unified Patent Court, when applying Art. 65 (2) UPCA, answers positively to this question has been studied above. What would be the situation if answered negatively?

A negative answer would imply that the unitary effect protects the European patent against the effect of a prior national right in the State where such a prior national right would have been prejudicial to the scope of protection of a European patent without unitary effect. The unitary effect would therefore provide an enhanced protection throughout the territories of the participating Member States. A prior national right would have no invalidating effect on a later European patent with unitary effect.

As a result, the participating Member States would have to deal with coexisting rights. Protection for an invention could be given by both a national patent and a European patent with unitary effect in the same territory. The UPCA deals with coexisting rights in Art. 28 UPCA related to rights based on prior use of the invention.

Art. 28 UPCA reads:

*"Any person, who, if a national patent had been granted in respect of an invention, would have had,*



*in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention."*

Of course, it would be unfair to restrict the right owned by the proprietor of a prior national right to a prior use right in the relevant Member State. However, the possibility to have both rights existing simultaneously may be considered.

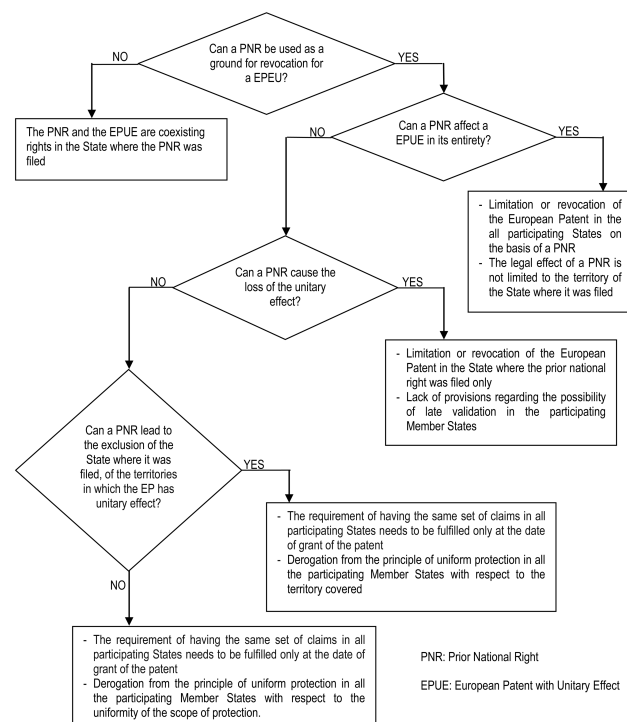
In the case that the rights are owned by different proprietors, this solution would require licensing measures. A compulsory and free licence, limited to the scope of protection of the earlier right, should be granted to the owner of the prior national right (if the prior national right led to a national patent which is still in force at the relevant date). The possibility to negotiate a licence of the earlier right should be given to the proprietor of the later European Patent.

Art. 4 (2) UPR does not specifically prohibit a double protection via the national route and the European route (such double protection is left to national law under Art. 139 (3) EPC for applications and patents having the same filing or priority date, and exists in some participating Member States). It only prevents the European patent to take effect at the same time in a Member State as result of a European patent and European patent with unitary effect.

## Conclusion

In conclusion, it can be seen that the legal effect of a prior national right for a European patent with unitary effect is not yet well defined. Time will tell if, regarding a prior national right, the unitary effect will enhance the

protection given by a European patent (in the case the prior national right cannot be used for revocation), or will weaken this protection (in the case the prior national right can affect the European patent with unitary effect in its entirety), or if balance can be found (in the case a late validation of the patent is allowed). In the meantime, the commitment of the participating Member States to find a legally sound solution to this question is expressed by the Chairman of the Select Committee. Time is running ...



## Intellectual property seen from the learning perspective

P. Rosenich (LI)

The American Nobel Prize laureate professor Joseph E. Stiglitz spoke out on June 13, 2014 in the daily newspaper Volksblatt where he again makes an attempt to consider and value Intellectual Property [IP] – this time with regard to the “learning perspective”.

Stiglitz concludes that IP may be a “double-edged sword” if “not correctly conceived”. He writes: “While it may enforce the stimulation to invest in research, it possibly increasingly promotes secrecy at the same time” a fact that – according to Stiglitz, blocks the flow of knowledge and encourages industry “to tap the common knowledge pool to the maximum extent while contributing to the least possible extent to it”.

Unfortunately, the Nobel Prize Laureate does not expand on how he reached the conclusion why it is possible that IP increasingly promotes secrecy. From the daily experience of the author of this article such promotion of secrecy by IP is not present in the international real life economy. The number of patent applications are still exploding over the years (at least in some countries) and the number of those who suffer from not having patented and/or published on time – in order to avoid others from patent pay their own inventions, grow as well. From that daily experience of a Patent attorney with more than 35 years practice in diverse industries it seems that the learning in all industries related to IP is: file for patents and/or publish your invention.

Did Stiglitz fully understand the principle of intellectual property laws, first of all the principle of patents? For an enterprise that makes use of the “incentive to invest in research” and tries to achieve a monopoly, needs to discard secrecy by filing a patent application, since without patent, no premium prices may be achieved. Without the protection of a patent – however, resources invested in research will not see refinancing by premium prices and the enterprise will be forced to leave the market with the respective product, as it can – in most cases – not compete with the cheaper prices of copycats. Worldwide intellectual property protection laws imply that inventions will be published after 18 months (see e.g. Art. 93 EPC). From publication also the whole file with all valuable discussions between examiner and applicant are open to public inspection (see e.g. Art. 127 and 128(1) EPC). Thus, as a consequence of Stiglitz’s first statement cited above, enterprises cannot be interested in the alternative “secrecy”. They have no choice:

Either they aim at advancing the technology in order to increase their profit via investments and premium prices, or they content themselves with day-to-day business lacking real innovation. Neither way, however, will they be attracted by secrecy to the same extent as by

protective law. All patent laws require on the other hand of an applicant a proper disclosure of an invention (see e.g. Art. 83 and 84 EPC). This shows clearly, that it is the patent system that forces enterprises to advance learning on a worldwide base, since each novel patent publication brings novel knowledge to the world. The fact that the inventor or applicant should gain money from this, is reduced to a side aspect when following the “learning perspective”. Enterprises which for whatever reason do not choose to file patents but still are innovating actively, will have to make use of systems like Protegas ([www.protegas.com](http://www.protegas.com), a European platform of defensive publishing) or like the IBM technical Disclosure Bulletin (The Bulletin was a form of defensive publication see ([http://en.wikipedia.org/wiki/IBM\\_Technical\\_Disclosure\\_Bulletin](http://en.wikipedia.org/wiki/IBM_Technical_Disclosure_Bulletin)), in order to make sure that they do not end up as victims of the patent system through their own secrecy while later filed patents of third parties are released and the use of the secretly kept innovation of those enterprises or further developments may be impeded by the third parties patents. As a consequence, it is precisely the currently prevailing system of protective law for intellectual property that guarantees publication. Secrecy of knowledge is in real business life and in most of the cases a very risky choice.

Hence, this implies the contrary of Stiglitz’s postulate, namely that the concept of patent law was lacking and might have negative implications on innovative development and knowledge proliferation.

Current patent laws do in fact automatically guarantee increase in knowledge and development, as the Austrian economist Schumpeter, one of Stiglitz’s sources, stated about 100 years ago, posterior to the founding fathers of the United States of America, who already wrote in the 1787 US-Constitution: “to promote the progress of science and useful arts by securing for limited times to authors and inventors, exclusive right to their respective writings and discoveries”. This brilliant thought is still valid today. As a proof the rapid economic development of mankind over the last 200 years could be taken. It happened particularly because of awareness and the accumulation of knowledge by learning from more than 100 million patent publications with valuable innovative content.

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He is Guest Researcher of the Global Intellectual Property Business Magazine and practices in the IP-world since more than 35 years in industry and private practice.

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## Hilfe braucht Helfer.

„Ich war mehrmals in den Projekten und weiß, dass wir schon mit bescheidenen Mitteln viele Leben retten können.“

Dr. Maria Furtwängler

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- GMV Reformentwurf der EU
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- DesignG vom 10.10.2013,
- VO Nr. 1151/2012 über Qualitätsregeln für Agrarerzeugnisse, Lebensmittel,
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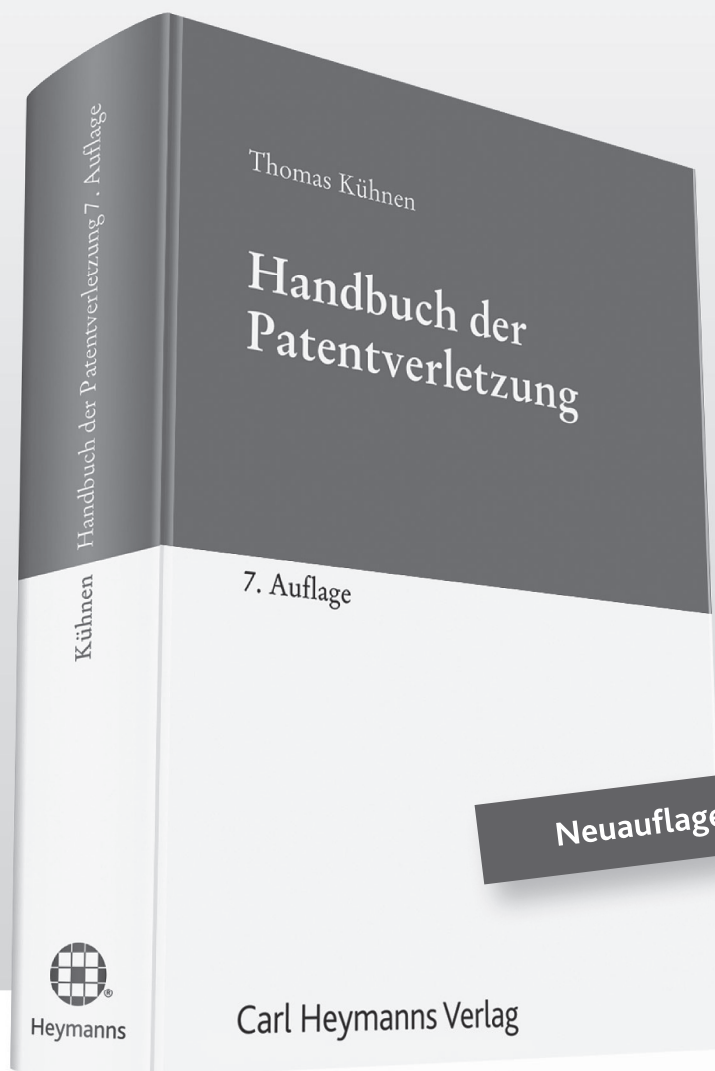
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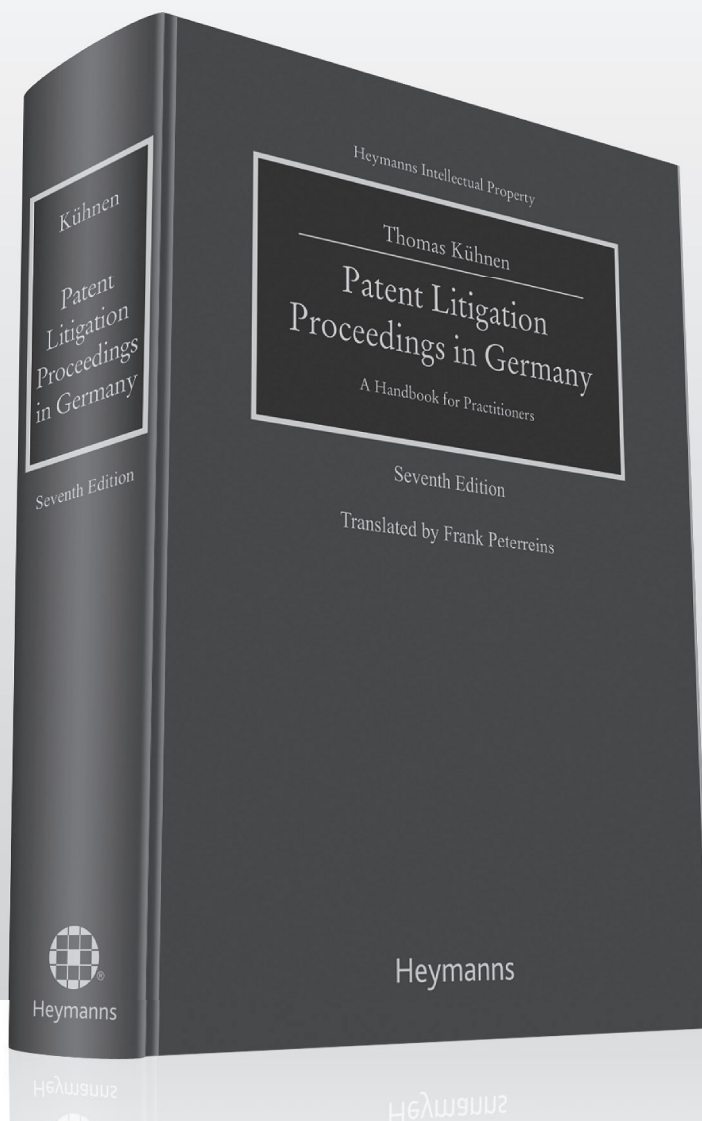
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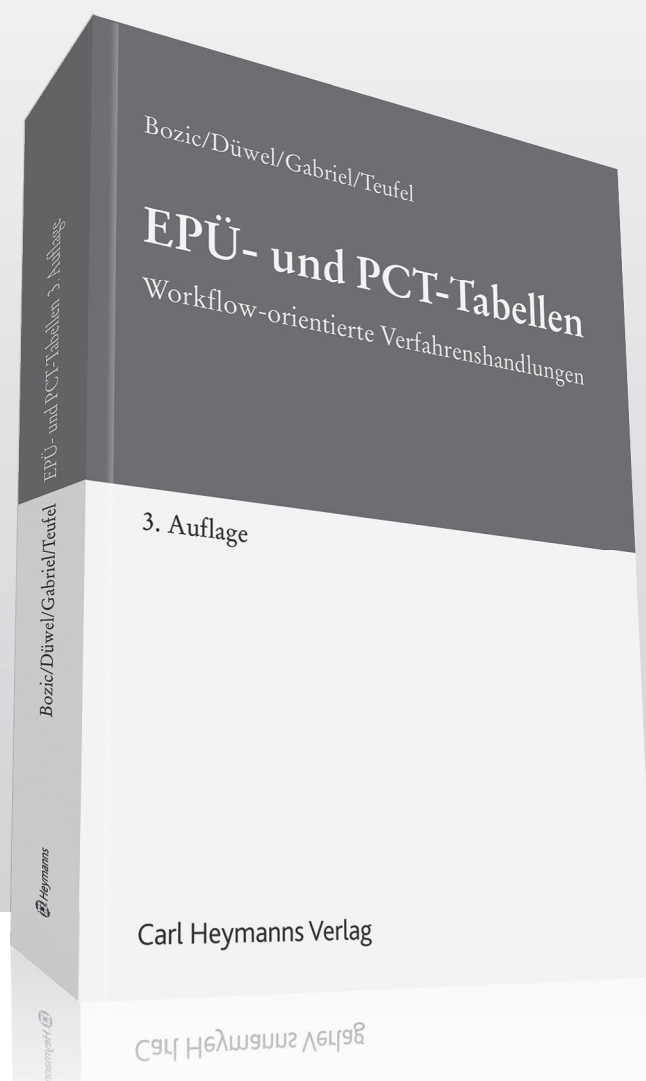
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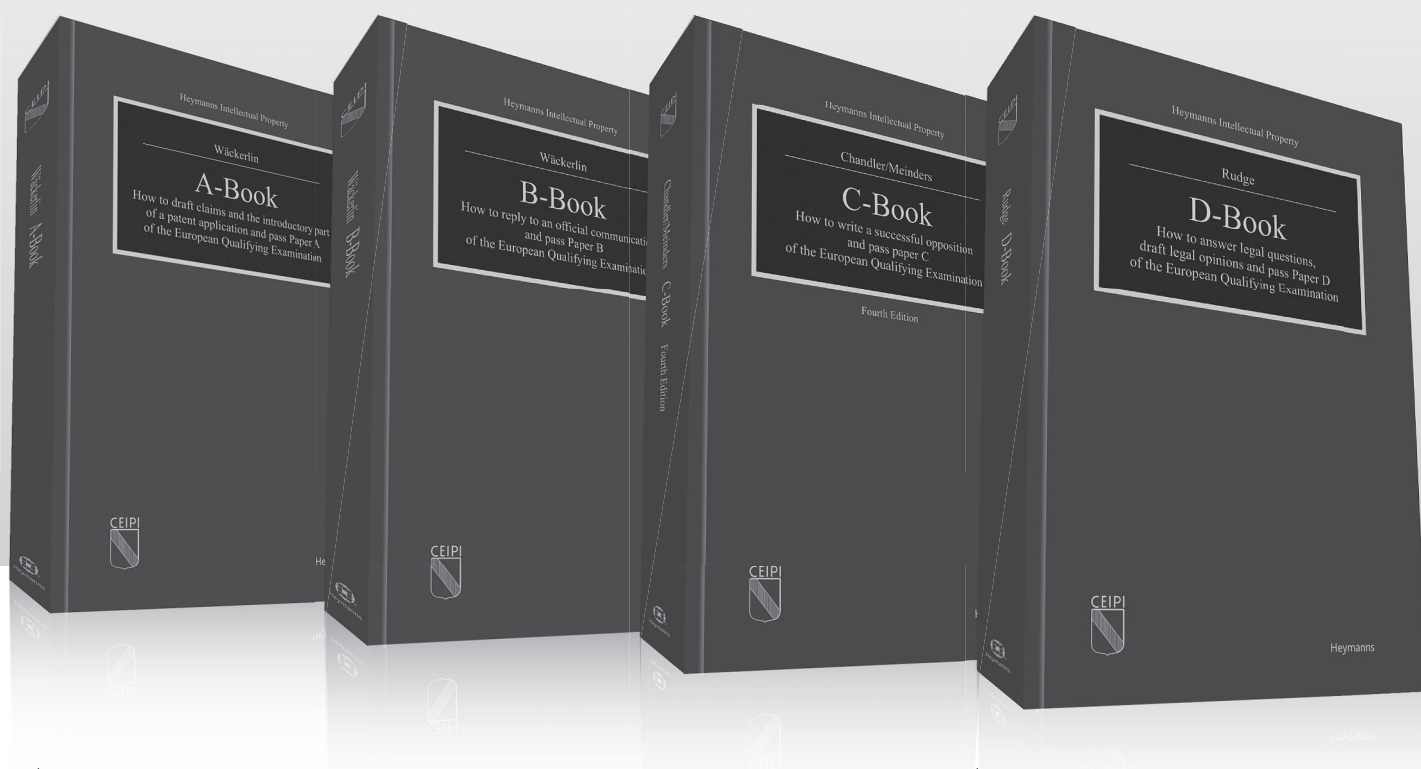
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