

Institut der beim Europäischen
Patentamt zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

I – Information concerning epi

127 Report on the 71st Council Meeting on 5th November 2011, Darmstadt

132 Report of the European Patent Practice Committee

136 2012 epi membership fee

II – Contributions from epi Members and other contributions

140 Need to Revise Guideline on Rule 45(3) – Claims being Deemed Abandoned,
by H. C. Dunlop (GB)

142 New Opportunities for Challenging the Validity of a US Patent under the “America
Invents Act” by Dr. S. J. Farmer (DE) and Dr. M. Burda, LL.M. (DE)

147 The pass rate of the EQE: too low, too high ... or just wrong? By G. Checcacci (IT)

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Table of Contents

Editorial	126	Forthcoming issues	139
I – Information concerning <i>epi</i>		<i>epi</i> Disciplinary bodies and Committees	153
Report on the 71 st Council Meeting by T. Johnson	127	<i>epi</i> Board	U3
<i>epi</i> Disciplinary Committee Report by P. Rosenich	130		
Report of the European Patent Practice Committee by F. Leyder	132	II – Contributions from <i>epi</i> Members and other contributions	
		Articles	
Education and training		Corrigendum	140
<i>epi</i> Mock EQEs and <i>epi</i> Seminars 2012	133	Need to Revise Guideline on Rule 45(3) – Claims being Deemed Abandoned by H. C. Dunlop (GB)	140
Tutors wanted	134	New Opportunities for Challenging the Validity of a US Patent under the „America Invents Act“ by Dr. S. J. Farmer (DE) and Dr. M. Burda, LL.M. (DE).	142
Director of Education of <i>epi</i>	134	The pass rate of the EQE: too low, too high ... or just wrong? by G. Checcacci (IT)	147
Results of the 2011 EQE	135	The CEIPI: International Center of Excellence in Intellectual Property	150
Information from the Secretariat		Die Crux mit der erfinderischen Tätigkeit by Dr. A.W. Kumm (DE)	151
List of Professional Representatives as per 31.10.2011	135	Trois années de changement et une certitude by P.G. Maué (CH).	151
New contact data of Legal Division	136		
2012 <i>epi</i> membership fee.	136	Letter to the Editor	
Annual Subscription 2012.	137	Dr. C.A.M. Mulder (NL)	152
Direct debiting mandate	138		
<i>epi</i> Artists Exhibition 2012	139		
Next Board and Council Meetings.	139		
Next issue Deadline 1/2012	126		
News concerning <i>epi</i> Council	139		

Editorial

T. Johnson (GB)

Despite economic turmoil, particularly in our Institute's sphere of interest, Europe, the show goes on. Something which might not be high on the Agenda of Finance Ministers, but which nevertheless could have a financial impact on the businesses of our clients, and on the advice we as professionals give to those clients, is the America Invents Act which came into effect on 16th September 2011. The President of the USA found time to welcome the Act, saying that it would help businesses to grow, and indeed create jobs. No doubt his words were directed solely to the US situation, but our clients in Europe and their businesses should also benefit from the < first to file > system being adopted by the USA under the Act, if only because obtaining US patent protection should be quicker and cheaper than under the old < first to invent > system, which could raise contentious issues. Hopefully progress towards a European unitary patent, and concomitant Unified Court, will

ultimately benefit industry, particularly SMEs, in a similar manner.

So, patents are not so far removed from the world of Finance Ministers after all; we hope that the patent system can play its part in leading at least our part of the world out of the economic doldrums.

Our Institute as part of the European Patent Organisation can with the EPO play what we think is an important part in this process. Indeed, our new President Tony Tangena has reported recently to Council that the Office has in discussions with him emphasised that it sees our Institute as its main partner in fostering the European patent system. We hope that the partnership does prosper, and with that happy thought, we wish all our members, and our colleagues in the EPO and elsewhere, a Very Happy Festive Season and a Prosperous and Healthy New Year.

Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionsschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **10. Februar 2012**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu 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 **10th February 2012**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veillez 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 l'*epi* Information est le **10 février 2012**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Report on the 71st Council Meeting 5th November 2011, Darmstadt

T. Johnson (GB)
Editorial Committee

President Tony Tangena opened the meeting, his first full one since being elected to the Presidency of the Institute. In opening, he welcomed delegates from Serbia to their first meeting, proposed *epi*'s delegates to SACEPO, advised Council that two *epi* members of the Disciplinary Board of Appeal had to be proposed to the EPO, and that members of the Institute's Disciplinary Committee had to be appointed. He then presented his **President's Report:**

He had previously circulated a note of meetings he had attended since taking office, which was accepted by Council. In addition, he reported that the Institute website was being updated, it would when finalised be accessible to members by an individual's username and password. Further, the membership should in future be able to access communications to Council via the Extranet.

He mentioned too the appointment of Karl Rackette as Director of Education (see below), and finally reported on discussions he has had with the EPO since taking office. In short, the EPO wants a transparent and open dialogue with the *epi*, stating that it sees the Institute as its main partner in providing services to applicants.

Secretary General:

Joao Pereira da Cruz gave his first report since becoming Secretary General. He too had previously circulated a summary of his activities since taking office. The present Institute offices provide an excellent working environment. The Institute's IT systems need to be upgraded (see President's report above), but care needs to be exercised as the *epi* databases and those of the EPO are not presently totally compatible, while the website needs to be more interactive. The Editorial Committee will have an input on these matters.

Having appointed a Director of Education (see above) for a 3 year term from 1st July, the Institute continues its search for a Legal Coordinator or Legal Adviser. Hopefully there will be an appointment in the first quarter of 2012.

As of 2nd November, 2011, the *epi* has 10391 members.

The next Council meeting is on 21st April, 2012 in Bucharest, Romania.

Treasurer's Report:

Claude Quintelier spoke to his previously circulated report, giving the floor initially to the *epi* Finance Com-

mittee which had also previously circulated a report to Council. The main thrust of both reports was the ongoing legal case against a former employee for fraud. A formal letter had been sent to the *epi*'s former external auditors by lawyers acting for the Institute, seeking compensation. The former auditors were seeking advice from their insurers before replying.

Claude Quintelier spoke to the draft budget 2011/2012. He advised that on the advice of the new external auditors there was no provision in the 2011 budget for double membership fee payments as there had only been about 10 requests for repayment thus far.

A major expense is the mailing of 'hard' copies of *epi* Information. He is investigating with the Editorial Committee possible ways to reduce this cost, which was 35,000 Euros in 2010.

The budget deficit proposed for 2012 is covered by the Institute's assets, so he proposed, supported by the Finance Committee, that the membership fee would remain at 160 Euros for 2012.

Regarding the membership fee payable on passing the EQE, historically exam results were only known late in the year and the membership fee was waived for that first year of qualification. Nowadays, the exam results are known much earlier, successful candidates can be registered by the end of August. He therefore proposed that the historical rule that:

"The annual membership fee is waived if a person is registered for the first time on the list of professional representatives after September 30th" be cancelled.

Council approved this cancellation, and the draft Budget, and adopted the Treasurer's report nem con.

Manual of EPO (Best) Practice:

Chris Mercer reported. There had been extensive discussions with the EPO, who had also consulted Business Europe. Mr Mercer explained the *epi*'s objections to the draft document originally produced by the EPO. The *epi* had submitted a revised draft, which he reported had been mainly accepted by the EPO and Business Europe. The document now has the title "Quality Processes before the EPO". The document is being revised by the EPO, and when adopted (the EPO hopes by the end of the year) it will not be mandatory.

Council approved the *epi*'s continued involvement with the project, and thanked Mr Mercer and Jim Boff, the Institute's main representatives on the project, for their work.

Quality Road Map:

Document CA/97/11 had been produced by the EPO. The aim is for the Office to become ISO 9001 compliant in its aspiration to grant high quality patents. A decision will be taken by the AC in due course, meanwhile Council agreed with Mr Mercer that the *epi* will continue to consider what we as an Institute want from the EPO.

epi payment for *epi* costs of the EQE:

Chris Mercer again reported. The EPO presently absorbs *epi* costs for running the exam, these costs being mainly travel and subsistence costs of *epi* EQE committee members. The EPO would like the *epi* to pay at least these costs. The EPO had produced a table of overall costs, including their own, but these were not seemingly supported by hard evidence. Council, after a lively debate, approved *epi* continuing discussions with the EPO concerning the EPO's costs, and to discuss the topic again at a later Council meeting.

Disciplinary Committee:

Paul Rosenich reported. He proposed Committee members for Latvia and Malta, who were approved by Council. The Committee still needed members from Republic of Macedonia, Serbia and Cyprus. He reminded Council that the Committee is only responsible for EPAs, and not non-EPA representatives in for example law firms.

Regarding decisions of disciplinary Chambers, the current practice is not to publish them as to do so would name defendant(s), so providing them with 'punishment' in addition to that imposed by the Chamber. There was a discussion, following which Council requested the Committee to continue to consider whether or not decisions should be published with reasons for any penalty imposed on a defendant, and to report again at a later meeting.

Litigation Committee:

Axel Casalonga reported, speaking to his previously-circulated paper, which was also presented on Powerpoint, and which covered several topics concerning the proposed Unified Patent Court. In this regard, the Polish Presidency issued on 7th October, 2011 a revised version of the Draft Agreement on the Unified Patent Court and Draft Statute. The main topics addressed by the Committee were:

Jurisdiction of the future UPC for EP „bundle“ patents:

Article 58 of the revised Agreement provides for a transitional period of 5 years from entry into force with an opt-out during that time for EP "bundle" patents

granted before entry into force. After a long discussion, Council voted in favour of the following motion:

"The *epi* approves the fact that the jurisdiction of the future UPC extends to the Unitary patents as well as to the EP ("bundle") patents."

Turning to the transitional period, Council voted in favour of a separate motion reading:

"The transitional period, during which national Courts remain an open option, should be more than the presently proposed 5 years after entry into force."

Composition of the panels of the Court of First instance:

The draft agreement states in Article 6(2) that the panel of a local division should have two judges who are nationals of the host contracting country.

The Committee proposed that for each local or regional panel, there should be judges from three different nationalities and that one of these should be technically qualified.

Council approved the Committee's proposal.

Substantive law:

Articles 14f to 14i define infringement, limitation of the effect of infringement and prior user rights. These Articles only refer to a "European" patent. The opinion of the Committee is that these provisions should be applicable to the Unitary patent too, and that the definition should be in the Agreement, and not in any UP Regulation.

Council approved the Committee's opinion.

Jurisdiction of divisions of Court of First Instance:

Article 15a (2) retains the possibility of 'split' proceedings. The Committee is of the view that this is generally not desirable, and formed the opinion that where a revocation action is pending before the central division, a related counterclaim for infringement should be dealt with by the central division too (to avoid the expense and inconvenience of a transfer to another division).

Council approved the opinion of the Committee.

Representation:

Article 28(2) states that parties may be represented by EPAs who have appropriate extra qualifications. Article 28(2a) refers to 'representatives' being assisted by "patent attorneys", but there is no definition of "patent attorney", and this could lead in the opinion of the Committee to ambiguity and uncertainty. The Committee therefore proposed that "EPA" (i.e. European Patent Attorney) should be used when referring to a representative's assistant, and that an EPA assistant should be able to address the Court without the full certification required for an EPA acting alone.

Council approved this proposal by a large majority.

EPO Board of Appeal Members in litigation:

Council approved by a large majority the Committee's opinion that it would be desirable that serving EPO Board of Appeal Members should act as technical judges in the UPC system, but that they should not be the sole source of such technical judges.

The Committee had prepared a draft letter covering the above topics. Council approved the checking of the text for consistency with the discussions in Council, translating it as necessary and sending it to the EU President, the EU Council the European Parliament, and to National authorities (by *epi* national groups). The *epi* Secretariat is to be notified as to addressees of the letter when it is sent.

PQC:

Paolo Rambelli, newly appointed Chairman, spoke to his previously-circulated report.

The committee has 33 members, 33 % of whom are newcomers. There are no members from Greece, Serbia, Republic of Macedonia, Malta and Monaco.

Referring to the EQE, the pass rate in 2011 was 24.3 % (2010: 29 %). Candidates still find major difficulties with Papers C and D. The pass rate for Paper C (not including compensable fails) was 34.6 % (2010: 39.3 %). For Paper D, it was 27 % (35.4 % including compensable fails) against 43.4 % in 2010 (54.4 % including compensable fails).

According to a survey of candidates, the time factor seems to be their main problem.

Karl Rackette, the newly-appointed Director of Education was introduced to Council, which he addressed, setting out his aims and objectives as covered by his agreement with the *epi*. These are, briefly, to cooperate with the Academy and CEIPI, cooperate with national Groups on education, organise seminars, particularly in cooperation with national PQC members, to participate in at least one PQC meeting, and to support coordination between tutors and tutees of *epi* Tutorials.

A brief discussion ensued, during which a Council member suggested that in view of the falling pass rate, efforts should be concentrated on the EQE.

EPPC:

Francis Leyder had previously circulated a comprehensive report, which was for information. Council approved it *nem con*.

Mr Leyder did add that the revised Guidelines for examination were hoped by the EPO to be in force about June 2012.

Harmonisation:

John Brown continues as Chairman of this Committee, Mr Leyder being the Secretary. The Committee's previously circulated report was adopted by Council *nem con*.

Mr Brown reported a recent development concerning WIPO. The Palestinian Authority, now a member of UNESCO, could now apply to join WIPO without needing a vote for membership. Developments, if any, will be monitored and reported to Council.

Biotech Committee:

Ann de Clercq, had previously circulated a report, which was approved and accepted by Council.

EPO Finances Committee:

Jim Boff, Chairman, had previously circulated a report, which was approved and accepted by Council. He added that a general increase in fees of 5 % by the EPO (document CA/63/11) was in reality a 6 % increase as the fees' increase would be rounded up to the nearest 5 Euro. Over a number of years, the cumulative effect of the increase could be much more than 5 %.

AOB:

Members from Macedonia and Serbia were approved for the Disciplinary Committee. A Board member for Serbia was also approved as was a member from Macedonia for the PQC.

Vice President Gabriele Leißler – Gerstl proposed that with the increasing use of the internet, blogging etc. by inventors the *epi* should set up an ad hoc committee to follow EPO initiatives in this area.

Council approved this proposal *nem con*.

The President closed the meeting at 5.18pm.

epi Disciplinary Committee Report

P. Rosenich (LI)
Chair of Disciplinary Committee

Composition of the Chambers

Fixed Chambers last Council period:

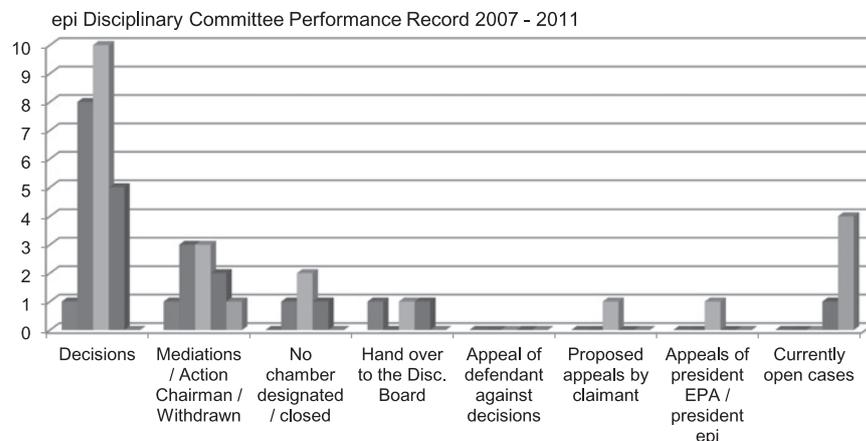
Chamber Kinsella	GB	CD1/08*, CD5/08*, CD4/08*; CD5/09; CD1/11; CD3/11 (XX)
Chamber Monain	FR	CD1/06; CD5/06; CD9/06; CD3/05; CD7/09; CD9/09; CD2/10; CD3/10
Chamber Markó	DE	CD2/06; CD3/06*; CD6/06*; CD7/06*; CD8/06*; CD10/08; CD11/08; CD1/09, CD10/09
Chamber Fröhling	GB	CD4/05; CD1/07; CD3/08; CD3/09; CD4/09
Chamber Kuzjukevica	GB	CD3/07; CD8/08
Chamber Rosenich	GB	CD 6/08
Chamber Gil Vega	GB	CD4/06; CD2/07; CD7/08; CD6/09; CD6/10
Chamber POP	FR	CD9/08; CD8/09; CD2/09
Chamber Westerholm	GB	CD4/10*; CD5/10
Chairman Rosenich	DE, GB	CD2/05***; CD10/06**, CDx/07**, CD2/08****, 3 x CDx/09**, CD1/10**

* Intermediate decision
** solved before chamber installed
*** sent back for clarification (currently in the hands of president)
**** informed the claimant, that he has to do something

(XX): SM Arni Vilhjalmsson takes for this case the position as the Chair of this chamber



Epi Disciplinary Committee Performance Record 2007 - 2011



2007: 3 cases / 3 designated chambers
2008: 11 cases / 9 designated chambers
2009: 11 cases / 10 designated chambers
2010: 6 cases / 6 designated chambers



epi Disciplinary Committee Constitution I

We thank the the retiring Officers

Vice Chair: Emil Benatov (BG)

Secretary: Simon Wright (GB)

Vice Secretary: Viktor Gil Vega (ES)

At the epi Secretariat

Vice Registrar: Dominique Monéger (FR)



epi Disciplinary Committee Current Work I

When DC changes its composition, the then currently active Chambers continue to finish the cases up to decision.

Soon after Election the Chairman of DC will install new fixed Chambers.

08.10.2011 Election of the new Officers

Chair: Rosenich, Paul (LI)

Vice Chair: Fröhling, Werner (DE)

Secretary: Vilhjálmsson, Arni (IS)

Vice Secretary: Poth, Wolfgang (AT)

At the *epi* Secretariat

Registrar: Ortlepp, Heike (DE)

Vice Registrar: Laedtke, Ute (DE)



epi Disciplinary Committee Current Work II

Important points under current consideration

A *epi*-Member who is officially representing a client before the EPO is in principle responsible under the Code of Conduct, also in cases where another Person (qualified national Patent Attorney) of his firm makes a mistake when dealing/acting with or for a client regarding a European patent application .

Proceedings in respect of a failure to comply with professional obligations shall be barred after a period of five years. The period of limitation shall begin on the date of such failure. Procedural steps of a Disciplinary Body interrupt said term. (Article 26 Regulation on Discipline for Prof. Representatives).

Report of the European Patent Practice Committee

F. Leyder (BE)
Chair of EPPC

This report completed on 08.11.2011 covers the period since my previous report dated 23.08.2011.

The EPPC is the largest committee of the *epi*, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT, and (3) the future EU Patent Regulation, including any revision thereof, except all questions in the fields of other committees: Biotech, OCC, PDC, LitCom, and EPO Finances.

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

EPC

1. SACEPO/WPR6 – Evaluation of the recent rule changes

The EPO has announced that the next meeting of the Working Party on Rules will be mainly devoted to an evaluation of the recent rule changes. The date has not yet been set.

GUIDELINES

2. SACEPO/WPG2:

In preparation of the meeting of the SACEPO Working Party on Guidelines, the Guidelines sub-committee met in Copenhagen on 08.–09.09.2011 in order to instruct the *epi* members of the SACEPO/WPG. It was a huge task, for which A. Hegner and all those who contributed under her leadership deserve warm thanks.

As she reported, the meeting “was conducted in a friendly atmosphere; the EPO was very constructive and listened with interest to our requests and suggestions”.

MSBA: Boards and Enlarged Board of Appeal

3. G1/11 – ,Competent Board‘:

A new referral has been sent by the Legal Board of Appeal (J 21/09). The question (in German, translation published in OJ 10/2011, p. 478) reads: “Is a technical board of appeal or the Legal Board of Appeal competent to hear an appeal against an EPO examining division’s decision – taken separately from its decision granting a patent or refusing the application – not to refund search fees under Rule 64(2) EPC?”.

Up to now, only one member has indicated an interest in joining an ad hoc working group for preparing an amicus curiae brief. The time limit for filing a brief has been set at end January 2012. I could welcome a few more volunteers to join an ad hoc working group; a meeting would ideally be organised just before the next EPPC meeting planned early 2012.

4. MSBA meeting 14.10.2011:

During a meeting with chairmen of Boards of Appeal, the main topics discussed were:

1. Anonymity in or of decisions.
2. Exclusion of certain documents from public inspection.
3. Issuance of interlocutory non-binding opinion.
4. The Challenges of the Practice under Art. 123(2) EPC.
5. Interlocutory Revision due to formal errors in a decision by an Examining Division.
6. Re-establishment of rights.
7. Duration of the appeal procedure.
8. Consistency of procedure.
9. External visits by the Boards of Appeal.

This was the last meeting with Mr Messerli as VP3; Mr van der Eijck will be the new VP3.

EPO – epi Liaison

5. MANUAL OF BEST PRACTICE:

The expression “best practice” has been abandoned, and even the qualification of the document as a “manual” is being reviewed. The advisory nature of the manual has repeatedly been confirmed. The entire manual has now been re-written in the format “if you do X, the consequence will be Y”.

The Board unanimously approved the general concept of this Manual, subject to the epi delegation led by C. Mercer reaching an agreement with the EPO on the last few points.

A meeting with BUSINESSEUROPE and the EPO took place in Brussels on 31.10.2011.

TRILATERAL & IP5

6. Trilateral Conference

On the occasion of meetings of the Trilateral Offices, the President of the EPO and BUSINESSEUROPE invited the epi to a jointly hosted conference near Paris on 9 November 2011. G. Leißler-Gerstl will represent us.

UNITARY PATENT

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

The draft regulations are with the European Parliament. As announced during the Lisbon Board meeting, the sub-committee met on 22.09.2011 to prepare a letter for the attention of the European Parliament, where a Hearing is planned on 10.–11.10.2011. Further moves are being considered, in cooperation with our President.

For the latest drafts, please refer to the Council website: <http://register.consilium.europa.eu>. A comparison table is available in a document dated 26.10.2011, with three columns showing the Commission proposal, the Council general approach and the Parliament draft report.

The EPPC is also monitoring the Draft agreement on a Unified Patent Court; whilst the draft mainly relates to the court, it contains some patent law, and as such is relevant to the work of the EPPC.

epi Mock EQEs and *epi* Seminars 2012

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

For further information, please visit our website (www.patentepi.com → *EQE and training*) in 2012 or contact the *epi* Secretariat (email: education@patentepi.com).

Tutors wanted



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

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

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

Director of Education of *epi*



Karl Rackette was appointed Director of Education of the *epi* on 1st July 2011. He was one of 18 candidates that responded to an invitation sent by the PQC Chair to the *epi* members in February 2011 by filing an application for the position which had become vacant.

Before studying physics and electronics in Germany and France he had spent a year as an exchange student

in the USA. Karl Rackette became a German and European Patent Attorney in 1979 and worked ever since in private practice in Germany. He has been involved in training candidates for the EQE in his firm in Freiburg as well at the CEIPI in Strasbourg for more than 20 years and was a member of the Examination Committee for German patent attorneys from 1995 to 1998.

Between 1997 and 2003 he taught patent law at the University of Applied Sciences in Offenburg, Germany and from 2005 to 2010 he has been teaching German IP at the University in Strasbourg.

Mr Rackette also was involved in training activities in numerous countries in Europe, Africa and Asia organized e.g. by FICPI, WIPO or the EPO. Among these activities

were the annual South East Asian Patent Drafting Courses held in Singapore, Bangkok and Hong Kong since 1997 and the Philippine Patent Agent Qualification Examination (PAQE) since 2006.

Karl Rackette is a member of several international intellectual property associations, notably the Training and Education Commission of the Federation Internationale des Conseils en Propriete Industrielle (FICPI). He is also a member of AIPPI, ECTA, INTA and LES as well as a number of national associations in Germany, Switzerland, United Kingdom, Canada, USA and Australia.

As a Consultant to the *epi* the Director of Education performs services in order to:

- cooperate with CEIPI and European Patent Academy to implement the projects to be realised in the framework of the MoU (Memorandum of Understanding)
- cooperate with national bodies/groups in educational matters
- organise seminars in particular in cooperation with national PQC members
- participate in at least one (full) PQC meeting per year
- support the coordination tutors-tutees of *epi* tutorials where needed
- propose, prepare and supervise seminars and new seminars to PQC according to the determined needs
- prepare and update a list of speakers for *epi* training activities and to
- plan in cooperation with the treasurer the educational budget.

Results of the 2011 European Qualifying Examination

Passes pursuant to Article 14(1) REE*

Place of residence	Total number of candidates	PASS		NOT PASSED	
		Number	%	Number	%
AT	20	5	25,00%	15	75,00%
BE	40	7	17,50%	33	82,50%
CH	81	17	20,99%	64	79,01%
CZ	4	1	25,00%	3	75,00%
DE	956	221	23,12%	735	76,88%
DK	89	21	23,60%	68	76,40%
ES	89	9	10,11%	80	89,89%
FI	82	16	19,51%	66	80,49%
FR	232	66	28,45%	166	71,55%
GB	193	87	45,08%	106	54,92%
HU	3	0	0,00%	3	100,00%
IE	9	6	66,67%	3	33,33%
IT	129	18	13,95%	111	86,05%
LI	3	0	0,00%	3	100,00%
LU	4	2	50,00%	2	50,00%

Place of residence	Total number of candidates	PASS		NOT PASSED	
		Number	%	Number	%
MC	2	0	0,00%	2	100,00%
MT	1	0	0,00%	1	100,00%
NL	120	38	31,67%	82	68,33%
NO	6	0	0,00%	6	100,00%
PL	13	0	0,00%	13	100,00%
PT	4	0	0,00%	4	100,00%
RO	2	1	50,00%	1	50,00%
SE	150	28	18,67%	122	81,33%
SI	1	1	100,00%	0	0,00%
TR	9	1	11,11%	8	88,89%
CN	1	0	0,00%	1	100,00%
JP	1	0	0,00%	1	100,00%
US	1	0	0,00%	1	100,00%
TOTALS	2245	545	24,28%	1700	75,72%

Source:
Examination Secretariat for the European Qualifying Examination

* Regulation on the European qualifying examination for professional representatives

List of Professional Representatives as per 31.10.2011

by their places of business or employment in the Contracting States

Country	Total Repr.	% of Tot.Repr.
AL	31	0,30
AT	126	1,21
BE	179	1,72
BG	68	0,65
CH	454	4,37
CY	12	0,12
CZ	98	0,94
DE	3528	33,95
DK	208	2,00
EE	26	0,25
ES	170	1,64
FI	171	1,65
FR	940	9,05
GB	1974	19,00
GR	24	0,23
HR	27	0,26
HU	90	0,87
IE	65	0,63
IS	20	0,19
IT	460	4,43

Country	Total Repr.	% of Tot.Repr.
LI	18	0,17
LT	26	0,25
LU	18	0,17
LV	21	0,20
MC	3	0,03
MK	40	0,38
MT	7	0,07
NL	457	4,40
NO	101	0,97
PL	342	3,29
PT	42	0,40
RO	62	0,60
RS	55	0,53
SE	332	3,20
SI	31	0,30
SK	38	0,37
SM	29	0,28
TR	98	0,94
Total :	10391	100,00

Source:
Legal Division / Dir. 5.2.3 / European Patent Office

New Contact Data of Legal Division

Update of the European Patent Attorneys database

For the attention of all *epi* members
Kindly note the following new contact data of the Legal Division of the EPO (Dir. 523):

European Patent Office
Dir. 523
Legal Division
80298 Munich
Germany

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

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by *epi*. Therefore, to make sure that *epi* mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 523 of any change in your contact details.

Thank you for your cooperation.

epi Mitgliedsbeitrag 2012

Es wurde in der 71. Sitzung des *epi*-Rates am 5. November 2011 beschlossen, dass der *epi*-Mitgliedsbeitrag für das Jahr 2012 € 160 betragen wird. Alle Mitglieder werden vom Schatzmeister eine Rechnung über den Mitgliedsbeitrag 2012 erhalten. Aus der Unterlassung der Sendung der Rechnung kann das Mitglied keine Ansprüche herleiten.

Information zur Zahlungsmodalitäten entnehmen Sie bitte der *epi*-Webseite: www.patentepi.com.

Claude Quintelier, *epi* Schatzmeister

epi membership fee 2012

At the 71st *epi* Council Meeting on 5th November 2011 it was decided that the *epi* membership fee for 2012 will be 160 €. The Treasurer will send to each member an invoice relating to the payment of the 2012 membership fee. Whilst the member's attention is drawn to the sending of this invoice, he or she may not invoke the omission of such an invoice.

For information concerning payment, please see the *epi* website: www.patentepi.com.

Claude Quintelier, *epi* Treasurer

Cotisation 2012

Lors de la 71^{ème} réunion du Conseil de l'*epi*, le 5 novembre 2011, il a été décidé que le montant de la cotisation pour l'année 2012 serait de 160 €. Le Trésorier enverra une facture pour le paiement de la cotisation à tous les membres de l'*epi*. Le membre ne peut se prévaloir de l'omission de l'envoi de cette facture concernant un tel paiement.

Pour toute information concernant les modalités de paiement, merci de consulter le site de l'*epi*: www.patentepi.com.

Claude Quintelier, Trésorier de l'*epi*

Annual Subscription 2012

The invoices regarding the epi subscription 2012 will be sent in the beginning of January 2012. Please note that everybody will receive an invoice, even if a direct debiting mandate is set up with epi.

In case of doubt and to avoid double payment, please get in touch with the epi Secretariat, to check whether a direct debiting mandate is set up for you.

The 2012 epi subscription fee (160 EUR without surcharge) can be settled as follows:

1. Direct debiting mandate

- by debiting the EPO deposit account on February 24, 2012 – valid only for payment of the 2012 subscription
- The form to set up/amend/delete a direct debiting mandate can be found on our website (www.patentepi.com).
- In case a direct debit mandate is set up with epi, kindly note the following:
- The due membership fee will be debited automatically from the EPO account on February 24, 2012, taking into account that the account holder is entitled to amend the direct debiting mandate.

If you have any questions relating to the direct debiting mandate, please get in touch with the epi Secretariat

2. Credit Card

- by credit card (Visa or Mastercard only)
- The link to the online payment tool can be found on our website (www.patentepi.com).
- Credit card payment is at no charge for members.
- For payments with American Express please use PayPal.

3. PayPal

The link to the online payment tool can be found on our website (www.patentepi.com).

4. Bank transfer

- by bank transfer in Euro (bank charges payable by subscriber)
- Please note that payment should be on epi's account at the latest by February 29th, 2012.

Account holder:	European Patent Institute
Bank Name:	Deutsche Bank AG
BLZ/Sort Code:	700 700 10
Account Number:	272 5505 00
BIC-SWIFT:	DEUTDEMMXXX
IBAN No:	DE49 7007 0010 0272 5505 00
Address:	Promenadeplatz 15 80333 München

Kindly note: No cheques accepted!

In order to minimise the workload in processing accurately and efficiently subscription payments, and independently of the transmitting way, each payment should be clearly identified indicating invoice number, name and membership number. Obviously unidentifiable payments subsequently cause considerable problems for the Secretariat and in many instances unnecessary protracted correspondence.

João Pereira da Cruz
Secretary General

Please visit our website for news !

www.patentepi.com



Institut der beim Europäischen Patentamt zugelassenen Vertreter
 Institute of Professional Representatives before the European Patent Office
 Institut des mandataires agréés près l'Office européen des brevets

Einzugsermächtigung

Eingangsfrist im
epi-Sekretariat:

1. Februar 2012

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (*epi*) wird hiermit ermächtigt, den jeweils gültigen *epi*-Jahresmitgliedsbeitrag für das genannte Mitglied einzuziehen. Der Einzug erfolgt einmalig am 25. Februar des laufenden Jahres von dem nachfolgend anzugebenden Konto beim Europäischen Patentamt (EPA). Die Einzugsermächtigung wird wirksam beginnend mit dem Jahresmitgliedsbeitrag 2012 und gilt für künftig fällige Mitgliedsbeiträge bis auf schriftlichen Widerruf. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem *epi* getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993,367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

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

Das vollständige Formular zum Einzugsverfahren finden Sie auf der Homepage: www.patentepi.com

Direct debiting mandate

Deadline for receipt by the
epi Secretariat:

1st February 2012

The Institute of Professional Representatives before the European Patent Office (*epi*) is hereby authorised to debit the *epi* annual subscription for the member named below at the appropriate rate. This direct debit occurs once on February 25 of the current year from the deposit account held with the European Patent Office (EPO) as specified below. This direct debiting mandate applies to the membership fee 2012 and the forthcoming subscriptions until it is revoked in writing. Debiting will be done on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the *epi* (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

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

Please find the complete form concerning the direct debiting mandate on our website: www.patentepi.com

Autorisation de prélèvement

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

1^{er} février 2012

L'Institut des mandataires agréés près l'Office européen des brevets (*epi*) est autorisé par la présente à prélever le montant en vigueur de la cotisation annuelle de l'*epi* pour le membre dont le nom figure ci-dessous. La présente autorisation de prélèvement sur le compte ouvert à l'Office européen des brevets (OEB) prend effet une seule fois le 25 février de l'année en cours. Cette autorisation de prélèvement vaut pour la cotisation 2012 ainsi que pour les cotisations suivantes jusqu'à révocation par écrit.

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

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

Veillez trouver le formulaire complet concernant l'autorisation de prélèvement sur notre site: www.patentepi.com

epi Artists Exhibition 2012

The *epi* Artists Exhibition 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 and 2009. In 2012 we are happy to welcome creative members from France, Germany, the Former Yugoslav Republic of Macedonia, Romania, Switzerland, the Netherlands and the United Kingdom showing a wide range of various art works. The exhibition will be opened with a vernissage on Monday 6th February 2012 at 6 pm and will last from

6th February to 18th February 2012
at the
European Patent Office
PschorrHöfe building
Bayerstrasse 34 in Munich.

If you wish any further information please contact:
Jacqueline Kalbe or Renate Schellenberg
at the *epi* Secretariat
P.O. Box 260112
80058 Munich
Germany

Tel: +49 89 24 20 52-0
Fax: +49 89 24 20 52-20
e-mail: info@patentepi.com

Next Board and Council Meetings

Board Meetings

86th Board meeting on 17th March 2012 in Brussels (BE)

Council Meetings

72nd Council meeting on 21st April 2012 in Bucharest (RO)

News concerning *epi* Council

Change of Practice

Margareta Ydreskog (SE), who was elected Council member for Sweden for industry, has gone to private practice as from April 4, 2011. She therefore resigned from her position in Council.

Anita Skeppstedt (SE), who has been elected substitute member for Sweden will act as full member for Sweden.

Kim Finnilä (FI), who was elected Council member for Finland, resigned from his position in Council.

Pekka Valkonen (FI), who has been elected substitute member for Finland will act as full member for Finland.

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
1/2012	10 February 2012	31 March 2012
2/2012	11 May 2012	30 June 2012
3/2012	10 August 2012	30 September 2012
4/2012	02 November 2012	30 December 2012

Corrigendum

The editors apologize for an error in issue 3/2011. The authors A. C. Hillier and F. Sieber.... are European Patent Attorneys. The footnotes to the articles should read:

Frank Sieber is a European Patent Attorney in Frankfurt

Anna C. Hillier is a European Patent Attorney in Düsseldorf

Need to Revise Guideline on Rule 45(3) – Claims being Deemed Abandoned

H. C. Dunlop (GB)¹

During the present review of the Guidelines for Examination, there is a need to consider Guideline A-III, 9.

The penultimate paragraph of the Guideline reads:

Features of a claim deemed to have been abandoned pursuant to Rule 45(3) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims (J 15/88, OJ 11/1990, 445).

There is no support in the case law for this paragraph in the Guidelines. It operates to the detriment of applicants who file direct with the EPO rather than applicants who proceed via the PCT. Moreover, it is not in the interests of the EPO, applicants or the general public to maintain this guideline.

The Guideline as written is not supported by the case law

The purported support for this paragraph in Guideline A-III, 9 is J 15/88, but that decision is all about whether numbered paragraphs at the end of a specification should or should not be considered claims for which fees are to be paid. It is *not* about whether subject matter is deemed abandoned, nor is it about what „deemed abandoned“ means.

The Appellant (Applicant) in that case argued that there is a risk of a bar against reintroducing such features into the application if they are not otherwise to be found in the description or drawings, and the Appellant cited a paper by Rudolf Teschemacher on this subject.² The Board agreed that an applicant who fails to pay claims fees „runs the risk“ that deemed abandonment might be final if the features are not otherwise to be found in the description or drawings, but the Board did not go further than this. The Board *merely* acknowledged such

a risk, i. e. acknowledged that the Appellant had a valid concern that a later Board might so rule.

In fact, the Board in J 15/88 expressed a quite contrary view. The Board actually held (Reasons, para. 7):

The idea that there can be forced abandonment of subject-matter, in reliance on one Implementing Regulation (Rule 31(2) EPC) introduced in order to secure compliance with another (Rule 29(5) EPC, first sentence) appears to be rather in conflict with principles of higher law (cf. Article 164(2) EPC) . . .

An applicant normally has the right to derive subject-matter from any part of the description, claims or drawings as originally filed. It seems to the Legal Board of Appeal that any limitations of this right must be construed narrowly if they are to be regarded as legally valid. It follows that Rule 31(2) EPC must be applied carefully and within reasonable limits.

The Guideline as written puts applicants who enter the EPO direct at a disadvantage vis-à-vis applicants who enter via the PCT

An applicant who enters the EPO direct is due to pay excess claims fees 1 month from filing of the claims or within 1 month of a communication notifying the failure to do so – Rule 45(2). At this early stage, before a search report is drawn up under Article 92, such an applicant *may not amend* his application (Rule 137(1)), for example to reduce the number of claims fees payable and thereby avoid the effects of Rule 45(3). Such an applicant has only two choices in relation to claims to subject matter not found elsewhere in the description and drawings: pay the fees to avoid „deemed abandonment“ or suffer the consequences set out in the Guideline.

In contrast, an applicant who enters the European Regional Phase via the PCT has 6 months to amend the application under Rule 162(2) *before* the claims fees due are computed. The opportunity to amend arises whether

¹ Hugh Dunlop is a European Patent Attorney and a Partner at R.G.C. Jenkins & Co. in London (www.jenkins.eu).

² Münchener Gemeinschaftskommentar, 7. Lieferung, Mai 1985, S. 70, Rdnr. 138

the ISR was drawn up by the EPO (Rule 162(1)) or a supplementary search report is to be drawn up (Rule 161(2)). As with Rule 45(3), where a claim fee is due under Rule 162(2) but is not paid, the claim concerned shall be deemed to be abandoned (Rule 162(4)). However this applicant can reduce the number of claims so that excess claims fees are not due and there is no deemed abandonment of subject matter. Re-introduction of the subject matter is governed only by Rules 137(3) and 137(5).

The Guideline as written is not in the interests of the EPO nor the Applicant nor the general public

The Guideline as written raises concerns even among applicants who enter the European phase via the PCT. The response of such applicants (whether through excessive caution or otherwise) is to not permit the situation described by *Teschemacher* to arise. The response of such applicants is to add (as is their right) to the end of the specification numbered paragraphs that correspond at least to the cancelled claims (or, frequently, to add numbered paragraphs that correspond to all the claims, because to separate out some claims from others may be more time consuming). EP(PCT) Applicants will do this regardless of whether the subject matter of the deleted claims is in fact found elsewhere in the specification, because (a) it requires effort to check whether this is so and (b) applicants and their attorneys are naturally cautious against the possibility of inadvertently abandoning subject matter. This is what Alison Brimelow might have referred to as "the law of unintended consequences".

It often introduces repetition, and in any case extends the length of the description to little purpose, because, *de facto*, these passages are added to preserve subject matter, if any, that is not intended to be claimed in subsequent stages. They serve no other purpose to the applicant or the reader at this stage in procedure and they can create additional work (albeit minor) for the examiners who frequently require the additional passages to be deleted or amended to clarify that they do not relate to claimed embodiments. For these reasons, the effect of the Guideline is not in the interests of applicants or the Office or the general public.

Such additional paragraphs are not to be prohibited or censured. They may serve a valid purpose upon grant of the patent. Applicants have a legitimate right to ensure that all the original subject matter is present in the patent when granted, not least for the ability to amend to that subject matter under Article 105a. But this is a different matter. Whether applicants add paragraphs for this purpose at an early stage or at a later stage when allowable claims are agreed is another matter, but the Guidelines should not mis-state the law to provoke applicants into doing so in a wholesale manner at a premature state in the prosecution.

Proposed re-wording of Guideline A-III, 9

For the above reasons, two versions for the last paragraph of Guideline A-III, 9 are suggested here. The first version is a cautious one merely stating the present state of the jurisprudence in relation to Rule 45(3) itself and in relation to higher law governing divisional applications:

Rule 45(3) (and corresponding Rule 162(4)) is an exception to the general principal that an applicant normally has the right to derive subject-matter from any part of the description, claims or drawings as originally filed and is to be construed narrowly (J 15/88, OJ 11/1990, 445).

It may be noted that in an EP(PCT) application the effects of Rule 162(4) can be avoided by actively amending under Rule 161 to delete claims that are not required, rather than passively declining to pay fees. The latter course of action would subject such unwanted claims to deemed abandonment, the consequences of which are uncertain pending clarification from the Boards of Appeal.

Subject matter deemed abandoned under Rule 45(3) or Rule 162(4) may be claimed in a divisional application, subject to the provisions of Rule 36.

Better still, the EPO may wish to adopt a policy on this point for the reasons given above and to unburden examiners. For this purpose a second version is presented:

Rule 45(3) (and corresponding Rule 162(4)) is an exception to the general principal that an applicant normally has the right to derive subject-matter from any part of the description, claims or drawings as originally filed and is to be construed narrowly (J 15/88, OJ 11/1990, 445). The policy of the EPO is that, once the European Search Report has been drawn up, Rule 45(3) has served its purpose and does not place a constraint on applicants additional to those of Rule 137. Accordingly, the EPO will consider Rule 137 as setting out the over-riding principals that govern whether the subject matter of a claim deemed abandoned under Rule 45(3) or Rule 162(4) may be re-introduced.

Subject matter deemed abandoned under Rule 45(3) or Rule 162(4) may be claimed in a divisional application, subject to the provisions of Rule 36.

Conclusion

The EPO should take the opportunity presented by the current round of revisions to the Guidelines to delete or revise this paragraph of Guideline A-II, 9 in the interests of applicants and the Office and indeed the general public.

New Opportunities for Challenging the Validity of a US Patent under the „America Invents Act“

Dr. S. J. Farmer (DE)¹ and Dr. M. Burda, LL.M. (DE)²

The Leahy-Smith America Invents Act (“AIA”), which was signed into law by President Obama on September 16, 2011, represents a historic reform of US patent law, and the most comprehensive since the last major revision in 1952. The AIA introduces a host of changes to US patent practice, including the notable shift from a first-to-invent recognition to a first-inventor-to-file regime, which will be somewhat more streamlined with current patent systems worldwide when it takes effect on March 16, 2013. Important, and the topic of the present article, are the variety of post-patent grant procedures that have been introduced and/or modified by the AIA, which will undoubtedly open up new and strategically important options for dealing with a US patent following its allowance.

The AIA at SEC. 6 establishes a new system for post-grant challenges of US patents through two new chapters appearing under Title 35 of the United States Code (i. e. ‘35 USC’): Chapter 31, entitled “Inter Partes Review”³ and Chapter 32, entitled “Post-Grant Review”⁴. The legal weight of these ‘Chapters’ in the 35 USC is akin to that of ‘Articles’ under the European Patent Convention (EPC). The ‘implementing regulations’ associated with these new Chapters (and for implementing all changes reflected in the AIA generally) will be found in Title 37 in the Code of Federal Regulations (‘37 CFR’). Of note, the implementing rules governing the particulars of these new procedures are still in the drafting process and have yet to be promulgated (e.g. see scope of regulations for IPR, PGR, respectively at §§ 316(a) and 326(a)); this task must be completed “not later than” one year of the AIA’s effective date, or September 16, 2012 (AIA at SEC. 6(f)).

Briefly, ‘inter partes review’ under the AIA is a multiple party proceeding intended to replace the existing *inter partes* reexamination of a granted US patent, and remains similar in that the grounds for challenging a issued US patent (and types of art that can support said challenge) are somewhat limited, namely to novelty and obviousness. On the other hand, ‘post-grant review’ is a completely new ‘opposition-style’ procedure, wherein a non-patentee may allege the invalidity of one or more patent claims of a US patent based on a broad range of grounds similar to those found in Article 100 EPC. Finally, a new ‘Supplemental Examination’ procedure will be available exclusively to a patentee seeking to have the

USPTO re-evaluate its granted US patent based on certain “information” believed to be relevant to that patent; ‘information’ is not limited to patents or printed publications. We shall discuss all of these post-grant procedures in greater detail below. We will also mention brief comparisons between US post-grant procedures and counterparts found in the EPC as appropriate.

A brief mention of existing US post grant procedures

There are a variety of current post-grant procedures before the USPTO allowing a party, either a patentee or third party or both, to challenge and/or amend an issued US patent.

One type of procedure is the reissue process, which can be initiated by the patentee at any time during the term of the patent and used to correct an error, made without deceptive intent, that might render the patent wholly or partially inoperable or invalid.⁵ Therefore, the reissue process somewhat resembles the ‘request for limitation’ option according to Article 105a EPC, except that all of the claims during the reissue will be subject to a full examination on the merits. Possible errors that can be corrected through a reissue include a defective specification (based on a broad menu of grounds including novelty and obviousness in addition to utility, written description or enablement), an inaccurate claim of priority, or those claims considered to be too narrow or broad (but claims may only be broadened no later than two years after grant, and cannot be enlarged to recapture claimed subject-matter surrendered during earlier prosecution of the patent application).

A reexamination of a US patent refers generally to a process where either the USPTO, a member of the public (third party requester) or the patentee may file a detailed, well-reasoned request that the USPTO ‘reexamine’ an issued patent (on the merits) in order to confirm the validity of one or more claims in that patent.⁶ This analysis is based on submitted prior art, which is limited to patent documents and printed publications and on the grounds of novelty, obviousness and obviousness-type double patenting. The threshold standard for admissibility is that the issues brought forth in the request must raise a “substantial new question of patentability” (SNQP) of one or more claims in the patent. An SNQP exists where the submitted prior art would be important to a reasonable examiner in determining whether the claims of the original patent should

1 UK Solicitor, England & Wales and US Patent Attorney, and a Registered Legal Practitioner before the EPO; practicing at Grund IP Group, Nikolaistrasse 15, D-80802, Munich, DE

2 European Patent Attorney and German Patentanwalt practicing at Grund IP Group, Nikolaistrasse 15, D-80802, Munich, DE

3 New procedure found in 35 USC §§ 311–319

4 New procedure found in 35 USC §§ 321–329

5 See 35 USC § 251

6 See generally 35 USC §§ 301–318

be reexamined. Reexamination proceedings are made available to the public, may be filed before or during an ongoing litigation proceedings, and come in two 'flavors': *Ex parte* reexaminations are typically filed by non-patentee third parties (and this can be done anonymously), but once the request is submitted, the party is no longer an active participant in the proceedings and is unable to appeal the USPTO decision in case of an adverse ruling: the dialog is strictly between the USPTO and the patentee (35 USC § 302). *Inter partes* reexaminations are likewise initiated by members of the public, which must be named as a 'real party in interest', but here the party is an ongoing participant in the proceedings and can appeal an adverse USPTO decision.

As a formality, from this point forward in this article, all of the referred to sections below (§) are found in Title 35 USC, unless otherwise indicated.

Post-Grant Review

Under the new Post-Grant Review ('PGR') system, provided in the AIA at SEC. 6(d), a third party non-patent owner can challenge the validity of one or more claims of a US patent based on any ground recited by revised § 282(b)(2) and (3) per § 321(b),⁷ thus advantageously offering broader grounds (and types of art) for contesting a patent than present USPTO reexamination procedures; the scope of the PGR grounds are a bit broader than those available to an opponent in a European opposition proceedings as the issues of clarity or definiteness (e.g. Art. 84 EPC) are not grounds of opposition under Article 100 EPC. However, like EPO oppositions (Art. 99 (1) EPC), a PGR petition must be filed not later than 9 months after the date of patent grant, or issue date of a US reissue patent as the case may be (§ 321(c)).

The threshold requirement for admitting a PGR action requires that the information presented in the petition, if not rebutted, demonstrates that it is "more likely than not" that at least one of the claims challenged in the petition is not patentable, or alternatively, that the petition raises a "novel or unsettled legal question" important to *other* granted patents (or pending applications) (e.g. the patentability of human embryonic stem cells) (see § 324(a),(b)). Because the "more likely than not" standard is arguably a rather demanding standard to meet, the party initiating a PGR should draft the most compelling petition possible, in light of all available and relevant evidence, in particular since the USPTO's decision to admit the petition is not subject to appeal (§ 324(e)). Of course, the inability to appeal is quite different from EPC provisions, which permit an appeal from any decision given by an Opposition Division (Art. 105(1) EPC). Thus, one must wonder whether § 324(e) will prevent the establishment of reliable, consistent admissibility standards for PGR petitions. Moreover, this threshold standard also appears to be higher than the criteria used to assess admissibility of a notice in

European opposition procedures, where the grounds of opposition must be merely "substantiated".⁸ It remains to be seen whether the tougher standard required to institute a PGR compared to an *ex parte* reexamination will influence a choice of procedure: as mentioned above, *ex parte* reexamination actions require a less demanding showing of a 'substantial new question of patentability' (§ 303). This will mostly depend on the framework used by the USPTO when interpreted and applying the two standards.

In the PGR petition, the 'opponent' petitioner must identify "with particularity" each claim under challenge, and provide sufficient evidence to support each ground against patentability of said claim, including submission of patents and printed publications and/or affidavits or declarations of supporting factual evidence and/or expert opinions (§ 322(3)) and "any other information" the USPTO may require (§ 322(a)(4)). These requirements appear to correspond to the European patent procedure, which requires "a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds" (Rule 76(2)(c)EPC). Of note, no PGR will be instituted for any claim in a reissue patent having the same or narrower scope as the original patent (§ 325(f)). Other required filing formalities specify that the petition must identify the 'real party in interest' (i. e. no anonymous filings) and must include the USPTO official fee at the time of filing (see petition requirements, § 322). Accordingly, the use of a strawman as permitted in European opposition procedures is not available in the PGR.⁹

Once the PGR action is filed, the patentee may file a preliminary response refuting the petition within a time period set by the USPTO (§ 323), an action not provided for under EPO practice, where the patentee is not involved in the opposition until after admissibility of the action. The USPTO shall then decide whether to admit the petition within 3 months from when patentee's response was filed or could have been filed, and the case must be finally determined within one year after the PGR was instituted (§ 324(c)). However, upon a showing of "good cause", the USPTO may exercise discretion and extend this one-year period by no longer than 6 months (§ 326(a)(11)). Similar provisions limiting the absolute length of the proceedings are not provided for in the EPC, but arguably would be highly desirable, since practically speaking, oral proceedings do not take place until two years (give or take) following the end of the opposition period.

There are additional constraints as to when a PGR can be filed. A potential PGR petitioner must keep in mind that PGR is barred if such petitioner or real party in interest files a civil action challenging the validity of a claim of the same US patent *before* a PGR action is initiated (§ 325(a)(1)); however, the meaning of "civil

⁷ 35 USC 282(b): any patentability ground specified in 35 USC at Part II; 35 USC 282(c): failure to comply with any requirement of 35 USC §§ 112, 251 such as written description, definiteness, clarity

⁸ See T 222/85 (OJ 1988, 128)

⁹ See G 3/97 and G 4/97

action" does not extend to a counterclaim challenging the validity of a claim in that US patent when asserted in defense of an infringement action (§ 325(a)(3)), meaning an accused infringer can properly file an IPR action. Furthermore, any subsequent civil litigation action initiated by a PGR petitioner against the same US patent *on or after* filing a PGR will be "automatically" stayed, until or unless either the patentee motions to lift the stay, dismiss the action, or itself files a civil action or counterclaim alleging that the petitioner has *infringed* his patent (§ 325(a)(2)(A)-(C)). These provisions thus act to prevent concurrent challenges against the same US patent using different forums. However, a US federal court will *not* stay a request for a preliminary injunction filed by the patentee on the mere basis that a PGR petition has been filed or instituted (by anyone), if said court action is filed within 3 months from the patent issue date (§ 325(b)); but this provision is silent on whether the court can consider the PGR petition itself when determining the 'likelihood of success on the merits' prong when evaluating whether to grant the injunction. Overall, filing a PGR action will be particularly attractive where staying a federal court or ITC action pending the outcome of the PGR might be desired. Unfortunately, corresponding provisions guiding the relation of competing patent office and court proceedings are absent in the EPC, and presently only exist on the national level of some, but not all, EPC Contracting States, indicating a lack of harmonization on this issue.

The PGR proceedings are a matter of public record (§ 326(a)) and are conducted by the newly created Patent Trial & Appeal Board ('PTAB'), consisting of a three person Administrative Patent Judge panel (§ 326(c)) and not the Examining Corps, which is an approach substantially different from the European opposition procedure where the Opposition Division consists of three examiners, one of which one is typically the primary Examiner who conducted the grant proceedings (Art. 19(2) EPC). Although the PGR proceedings can be completely carried out in writing, each party has the right to oral proceedings as desired § 326(a)(10)); corresponding provisions exist in the EPC (Article 116 EPC). The PTAB may permit additional discovery, which is limited to "evidence directly related to factual assertions advanced by either party in the proceedings" (§ 326(a)(5)). Apparently, the PTAB is more limited with respect to the permitted scope of discovery compared to the EPO, which is at least theoretically not restricted by the facts, evidence and arguments provided by the parties (Art. 114 (1) EPC). Moreover, the Opposition Division may invoke its discretionary power to examine grounds of opposition not even raised by any opponent (Rule 81(1) EPC).

Protective orders may also be granted in a PGR to avoid public exposure of, e.g. a company's confidential information (§ 326(a)(7)). Also, a party must meet their burden of proof by satisfying the standard of a 'preponderance of the evidence', i.e. that on a balance of the probabilities the claim is invalid in view of the asserted ground against patentability. This burden is

likely easier to satisfy than the more rigorous standard of 'clear and convincing evidence' which is required to invalidate a US patent in a US federal court. Interestingly, the Boards of Appeal at the EPO also apply the standard of a "balance of probabilities" when evaluating whether a party has met their burden of proof.¹⁰

The scope of a patentee's right to effect any amendments to the claims, or provide replacement claims during PGR proceedings won't be entirely clear until the PGR rules are fully promulgated. However, the AIA specifies that a patentee has the right to file a single motion to amend any challenged claim by either canceling it (§ 326(d)(1)(A)) or to propose a "reasonable number" of alternative claims for each challenged claim (§ 326(d)(1)(B)). But no amendment made can enlarge the scope of the claims or introduce new matter (§ 326(d)(3)), which appears to parallel the provisions laid down in Articles 123(2) and (3) EPC. The AIA further provides that, upon joint request of both the petitioner and patentee, additional motions to amend may be heard for the purpose of advancing settlement or by the sole request of the patentee but only with "good cause", which is not explicitly defined by the AIA (§ 326(d)(2)).

PGR actions are terminated either by a PTAB decision or by a settlement between the parties, but this decision is ultimately at the discretion of the USPTO (§ 327(a)). Of course, the EPC does not address the concept of settlement provisions. The USPTO's final written decision must determine both the patentability of any claim challenged and any new claim introduced pursuant to § 326(d)(1)(B). Importantly, either party is entitled to appeal an "adverse" final decision to the Court of Appeals of the Federal Circuit ('CAFC') as a second instance, and both parties shall have the right to be a party to the appeal proceedings (§ 329). The AIA also provides a settlement provision, where a PGR action shall be terminated with respect to any petitioner upon the joint request of said petitioner and the patentee, but not if the Board has already decided the case on the merits prior to the filing of said request (§ 327(a)). Any settlement agreement between the parties concerning termination of the proceedings, actual or contemplated, shall be treated as business confidential information and the agreement itself will be kept out of the USPTO public register, but available to a party on a showing of "good cause" (§ 327(b)). Furthermore, when multiple proceedings have been launched against a single US patent (e.g. a reexamination or interference), the USPTO may stay, transfer, terminate or consolidate such proceedings, as considered appropriate (§ 325(d)), but the USPTO is authorized to consolidate more than one admissible PGR action against the same US patent into a single proceeding (§ 325(c)). This scenario does not arise during European opposition proceedings: Pursuant to Article 99(3) EPC, all opponents shall be parties to the proceedings where a particular EP patent is being

10 See, for instance, T 182/89, T 270/90, T 859/90, and T 409/91

opposed. Accordingly, only a single opposition action is established even in the case of multiple opponents.¹¹

Under the AIA, the estoppel provisions provide that a petitioner (or real party in interest or privy) involved in a PGR review of a patent claim that results in a "final written decision" by the USPTO, is not allowed to request or maintain any other proceeding before USPTO disputing the same claim(s) "on any ground that the petitioner raised or reasonably could have raised" during the PGR action. Accordingly, the estoppel effect applies on a claim-by-claim basis rather than to the patent as a whole, and further extends to all civil actions (e.g. in US district court) and proceedings before the ITC with respect to that same claim.¹² In other words, the petitioner is precluded from getting 'two bites at the same apple' when trying to invalidate a claim using grounds that were/possibly could have been raised in a PGR action. Interestingly, if the PGR is terminated with respect to any petitioner under § 327(a) (i.e. the patentee and petitioner jointly request that the PGR action be terminated), *no estoppel* shall attach to the petitioner or to the real party of interest on the basis of "that petitioner's institution of the PGR" (§ 327(a)). To emphasize the broad reach of these provisions, PGR estoppel will attach to all subsequently filed USPTO proceedings including other IPR actions or *ex parte* reexaminations; thus, the petitioner may not challenge the unpatentability of a claim on 'recycled' grounds already considered and finally determined by the USPTO. Corresponding estoppel provisions are absent in the EPC, but do exist to some degree in several of the EPC Contracting States (e.g. in Great Britain, Netherlands).

The new PGR procedure clearly offers several advantages when seeking to challenge a granted US patent including providing significantly broader grounds and types of art available to refute patentability compared to reexamination or *inter partes* review, a final decision is 'quickly' rendered in 1–1.5 years, and a lower burden of proof standard compared to typical civil litigation proceedings involving patents. However, a PGR cannot be conducted anonymously (e.g. using a strawman), it requires quick petitioner action throughout and a rather high admissibility threshold must be satisfied for instituting a PGR petition. Also, the potentially damaging and rather broadly applicable estoppel effect cannot be overlooked. At first sight, it appears that the PGR option has many similarities to European opposition procedure, but only the future implementation of the PGR (e.g. following promulgation of the implementing rules) will prove how alike these two procedures really are.

Availability of the PGR for patents will be phased in over time. One-year following enactment, on September 16, 2012, the following become eligible for PGR: (i) "business method" patents¹³ issued *before, on or after* the AIA effective date (AIA at SEC. 6(f)(2)); (ii)

pending interference proceedings may be 'transferred' to the PGR regime (AIA at SEC. 6(f)(3)); and (iii) for patent applications in the "first-inventor-to-file" system, and any patent issuing thereon, containing at any time a claim with an effective date after March 16, 2013 (*the date the "first-inventor-to-file" standard becomes effective*). As a cautionary note, the AIA provides a statutory authorization for the USPTO to limit the number of PGR proceedings in any one year for a four year period following AIA implementation (AIA, SEC. 6 at (f)(2)(B)), thus potentially restricting the number of PGR cases that can be heard and perhaps the viability of this post-grant mechanism to would-be petitioners.

Inter Partes Review

The new Inter Partes Review ('IPR') option, provided in the AIA at SEC. 6(a), is intended to eventually replace the existing *inter partes* reexamination ('IPEX') procedure, and allows a third party non-patent owner to challenge a US patent after the later of: (1) nine months from the issue or re-issue date of a US patent (i.e. after the PGR period has expired); (2) if a PGR has been instituted, then from the date of its termination; or (3) within one year after petitioner is served with a complaint where patentee alleges infringement of the patent (see § 311(c)(1),(2) and § 315(b)). Of note, the IPR has no real counterpart in the EPC. An IPR action can be initiated throughout the life of the US patent. In contrast to the PGR (and like the current IPEX), an IPR action can be initiated only on the grounds of novelty and obviousness and in view of only patents and printed publications (§ 311(b)).

The admissibility threshold requirement of an IPR action is similar to the tough PGR requirement in that the petition content submitted by the non-patentee, if not rebutted, establishes that there is a "reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition" (§ 314(a)). This standard is intended to be more stringent than the "substantial new question of patentability" ('SNQP') standard currently required for existing IPEX procedures. As with PGR, this high threshold implies that a party seeking use of IPR must draft the most persuasive petition possible, in view of all available evidence, since the USPTO's decision to admit a petition is likewise not subject to appeal (§ 314(d)); use of evidentiary affidavit and declaration submissions are therefore encouraged. Similar to PGR, a petitioner must identify "with particularity" each claim under challenge, provide sufficient evidence to support each ground against patentability, and also comply with other formalities such as identifying the 'real party in interest' and submitting the filing fee at the time of petition (§ 312). The relation of IPR actions to other proceedings or actions insofar that the IPR may be barred, or the civil action stayed mirror those specified for the PGR proceedings (see § 315(a)(1),(2),(3)). Furthermore, no IPR will be typically instituted if the petition requesting same is filed more than one year after the date on which the petitioner (or privy) is served with a complaint alleging infringement of the patent (§ 315(b)).

11 See Case Law of the Boards of Appeal, 6th ed., 2010, VII.D.1.3

12 See § 325(e)(1),(2)

13 Business method patents are generally understood to relate to a method or apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service

Unlike present *inter partes* reexamination, IPR proceedings will be heard before the PTAB, who may likewise allow further limited discovery such as deposing those witnesses providing the submitted affidavits or declarations; protective orders may also be mandated (§ 316(a)(5),(7)). Like PGR actions, a party must satisfy their burden of proof by a 'preponderance of the evidence' (§ 316(e)).

Many of the IPR procedural provisions contain similar language and effect as those applicable to PGR actions, namely: patentee's right to argue against instituting the IPR (§ 313), the timing requirements for USPTO action in initiating and terminating the IPR action (see § 314(b) and § 316(a)(11)), and the scope of the final written decision (§ 316(d)). Appeal and settlement paragraphs are likewise analogous (see § 319 and § 317(a), respectively). Amendment practice under the IPR parallels that authorized for the PGR procedures (§ 316(d)(1)–(3)). As with PGR, additional motions to amend the claims may be heard if made to "materially advance settlement" or as otherwise permitted by the USPTO (§ 316(d)(2)). Furthermore, as is the case during a PGR action, the USPTO is authorized to stay, transfer, terminate or consolidate multiple proceedings initiated against a single US patent (§ 315(d)) or consolidate more than one IPR action against the same US patent into a single proceeding (§ 315(c)).

The estoppel provision under IPR proceedings mostly parallel those discussed above for PGR actions (see § 315(e)(1),(2) and 317(a)). In addition and to emphasize, IPR estoppel applies to any petition "request[ing] or maintain[ing] a proceeding before the Office" (USPTO) regarding a claim "on any ground that the petitioner raised or reasonably could have raised" during a PGR action (§ 315(e)(1)). As noted above, many *ex parte* reexamination proceedings are conducted anonymously, a practice permitted under the USPTO Examiner Guidelines ('MPEP') at § 2213. Thus a conundrum: how does estoppel then apply to an anonymous filer using the *ex parte* procedures and an identified petitioner potentially caught by an estoppel effect during an IPR? It appears that this issue will have to be addressed with the enactment of the implementing rules for Chapter 31 procedures, for example, by requiring that an IPR petitioner file an affirmative statement acknowledging any participation in existing *ex parte* patent reexamination proceedings against the same US patent, even if filed anonymously.

Benefits of the new IPR procedures are similar to those afforded by the PGR including a final decision in a relatively short timeframe of 1–1.5 years and a lower burden of proof and probably overall expense compared to typical civil litigation. Additionally, an IPR action can be initiated during the entire life of the US patent (unless petitioner is being sued). On the other hand, IPR actions must identify the real party of interest, offers fewer grounds to contest a patent claim than other procedures like PGR, and requires a high admissibility threshold. The estoppel issue should be carefully evaluated, but may be somewhat more limited in

scope than the PGR since the IPR grounds are to be based on printed publications and patents.

Availability of the IPR regime begins one-year following enactment of the AIA and shall thus apply to any patent issued before, on, or after September 16, 2012.¹⁴ As is the case with the new PGR option, the AIA authorizes the USPTO to conduct a "graduated implementation" of IPR, wherein the number of IPR proceedings can be restricted in any one year for a four year period following AIA implementation,¹⁵ which could initially curtail the attractiveness of this procedure as a feasible post-grant challenge option.

Supplemental Examination:

The AIA provides for a new additional post-grant procedure in SEC. 12, exclusively permitting a patentee to submit a request that the USPTO "consider, reconsider, or correct information believed [by the patentee] to be relevant to the patent", which clearly offers the broadest grounds compared to other reconsideration procedures; the request will be decided upon within three months of filing and this examination will conclude by indicating whether the information presented raises 'a substantial new question of patentability' (35 USC § 257(a)). The ensuing reexamination process is conducted before the Examining Corps, and not the PTAB, according to the procedures outlined in e.g. 35 USC § 305 in connection with § 257(b). One beneficial effect of supplemental examination to a patentee is provided in § 257(c), which states that a patent "shall not be held unenforceable on the basis of conduct relating to information that had not been considered, reconsidered, or corrected", but was considered by the USPTO during this procedure. This implies that any instance of inequitable conduct in relation to the patent might be purged if this condition was satisfied. However, one poignant exception to the protections afforded by § 257(c) is a finding of "material fraud", which authorizes the USPTO to cancel a claim or claims in the patent (under § 307) and refer the matter to the "Attorney General" for further action as considered appropriate (§ 257(e)). Importantly, nothing under this new procedure precludes the imposition of sanctions based on certain US criminal or antitrust laws, or limits the authority of the USPTO to investigate issues of possible misconduct and impose sanctions accordingly (§ 257(f)). The Supplemental Examination procedure is available for any patent application pending on, or filed on or after September 16, 2012, and to any patent issued on or after that date (AIA, SEC. 12(c)).

Challenging a US patent has been, and still is, a costly and complex procedure. The AIA creates new opportunities that, if used effectively, provide attractive options for challenging a competitor's US patent portfolio that may substantially trim costs and provide a final decision with a fast turnaround time. The new post-grant patent challenge procedures discussed herein pro-

¹⁴ See AIA, SEC. 6(c)(1)

¹⁵ See AIA, SEC. 6(c)(2)(B)

vide new (and revised) avenues for confirming a patent's validity; however, these procedures demand an up-front familiarity with the AIA for developing a full understanding of how these procedures may be optimally employed

as part of a more general strategy of defending and/or attacking the validity of a US patent. It is our sincere hope that this article has provided a useful practical overview of these new post-grant procedures.

The pass rate of the EQE: too low, too high ... or just wrong?

G. Checcacci (IT)

The results of the EQE have always been debated, from the many points of view of the many players: the candidates, the examining structures, the tutors, the EPO, *epi*, the national associations, etc. And the starting points for discussions have always been the statistics, or better the figures.

The Examination Secretariat, that is the body having all the individual data, is thus the source of all the figures and statistics for the public. It might be said that figures and statistics distributed by the Examination Secretariat have improved over the years or not, depending on what one expects from those figures and statistics.

In any case, while different information is expected by different players, there is a figure that immediately attracts the attention of anybody: the pass rate.

Many discussions have always been made on the figure of the pass rate. The typical discussion path starts from the consideration that the pass rate is too low: in general, in a specific country of nationality or of business, among first sitters rather than resitters, for the costs of the organization, for the benefit of the profession and/or the industry, and so on. Then, any discussion continues with some proposals for remedies.

But what is the pass rate?

Being a rate, i.e. a ratio, it must have a numerator and a denominator, i.e. it must be built by defining clearly a total population (the denominator) and a partial population (the numerator). The pass rate as reported every year by the Examination Secretariat has the total number of candidates who enrolled for the EQE as the denominator, and the number of those who passed the EQE as the numerator.

This definition was first made decades ago, when the EQE started, and it was never reconsidered, notwithstanding the fact that the structure of the EQE has changed several times, and quite dramatically.

When I sat my EQE in 1987, we candidates had to sit four papers at the same time: to pass the EQE, we had to pass all the four papers, and failing even one of the four papers implied failing the EQE as a whole; thus, resitting meant resitting all the four papers, irrespective of the

fact that in any of them a candidate had got the minimum grade to pass. In other words, the EQE was actually a unitary examination made up of four parts. At that time, a pass rate calculated according to the definition above was perfectly fitting the actual situation.

However, after the many changes occurred since then, the structure of the EQE is now quite different. The EQE is no longer a unitary examination, rather it is a non-unitary set of four individual examinations, that must all be passed, individually¹. Nevertheless, the pass rate we see in the reports distributed by the Examination Secretariat is still calculated more or less in the same way as in the 1980s: as the denominator, the total number of candidates who enrolled for *any of the papers of the EQE*; as the numerator, the number of them who passed *the EQE*.

Besides, as from 2012 (or 2013, depending on the candidates) the individual examinations will be five, and also – for the first time – no candidate will be allowed to sit all of the examinations at the same time, since at least the pre-exam will have to be passed in a certain year to be allowed to sit the other papers in a following year. I do not know how the pass rate will be calculated in reports as from 2012, I expect that separate pass rates will be given for the pre-exam and for the four papers. Anyway, what I want to address here is how the pass rate should be calculated now, i.e. in 2011, and also in recent years, in order to give more significant information about the performance of the candidates.

But let's first consider some simple examples, to understand better why the definition that is currently used gives mainly wrong information.

Example 1: Ms Agatha, the perfect candidate

Agatha sat and passed all the four papers in 2011. She is certainly a successful candidate, and her case contributes both to the denominator and to the numerator of the pass rate. Agatha's case is thus correctly reflected in the pass rate, even as calculated now: 100% success.

¹ The mechanism of compensation implies a possible partial interrelation among the individual papers, but it does not change the general non-unitary structure, it just provides for a small help for some candidates under certain conditions

Example 2: Mr Ben, still a perfect candidate, just needing more time

Ben sat and passed paper A in 2008, paper B in 2009, paper C in 2010 and paper D in 2011. So, Ben never failed a single paper, just like Agatha, only he distributed his four papers over four years. It does not seem a situation substantially different from that of Agatha (Ben and his tutors have always been very happy with the result every year), but the impact on the pass rate is dramatically different. Indeed, in 2008, in 2009 and in 2010, his case contributed to the denominator, not to numerator: by isolating his case, the pass rate was 0 % for three years, then 100 % last year. However, his performance always met 100 % of the goal each time.

Example 3: Ms Caroline, a less perfect candidate

Caroline sat papers A, B, C, D in 2008 and passed A only; then she sat B, C, D in 2009 and passed B only; then she sat C and D in 2009 and passed C only; eventually, she sat and passed D in 2011. So, she sat ten individual papers and passed four of them. It seems a case rather different from that of Ben (Caroline and her tutor for paper D were never happy, until 2011), but it affects the pass rate exactly in the same way as Ben. Indeed, in 2008, in 2009 and in 2010, her case contributed to the denominator, not to numerator: by isolating her case, the pass rate was 0 % for three years, then 100 % last year. However, her performance met 25 % of the goal in 2008, 33 % in 2009, 50 % in 2010 and 100 % in 2011.

Example 4: Mr Ernest, a top tutor

Ernest tutored four candidates who sat and passed papers A, B and C in 2010, without sitting paper D. They could certainly be happy and celebrate their objectively excellent performance, but their contribution to the pass rate was a depressing 0 %.

Example 5: Ms Francy, a better tutor?

Francy tutored the four candidates of example 4 for paper D in 2011; two out of the four candidates passed. Her performance should be considered far less outstanding than that of Ernest, however she had a much better pass rate of 50 %.

Example 6: Goodland, a young member state

Let's assume that Goodland joined the EPC few years ago. Until recently, no candidates from Goodland sat the EQE; in 2010, five candidates sat and passed papers A and B; in 2011, ten more candidates sat and passed paper A and B, while – of the five who had sat A and B in 2010 – two sat and passed C, the other three sat and passed D. The pass rate of candidates from Goodland shows a steady 0 % in 2010 and 2011, suggesting that there are training difficulties in the country, contrary to what is suggested by common sense.

Example 7: Hardland, another young member state

Let's assume that Hardland also joined the EPC few years ago. In 2010, five candidates sat papers A and B; four of them failed both papers, while one passed both A and B; in 2011, the four candidates who had sat A and B in

2010 without success sat all the four papers and failed again all papers, while the only candidate who had passed A and B in 2010 sat and passed also C and D; no new candidates sat in 2011. The pass rate of candidates from Hardland shows an encouraging trend from 0 % in 2010 up to 20 % in 2011, suggesting that training in the country works well, again contrary to what is suggested by common sense.

I guess no further examples are needed to show that the present way of calculating the pass rate is not useful to produce a truthful picture of the results of the present non-unitary EQE.

So, how can a pass rate be calculated? The answer is not so difficult, it is simply to accept the present non-unitary structure of the EQE:

- as the denominator of the ratio, the total number of individual papers is to be taken;
- as the numerator of the ratio, the total number of individual passed papers is to be taken.

By applying this amended pass rate to the example above, it would result that Agatha is still at her high 100 % pass rate, but also Ben would have 100 % pass rate every year, while Caroline would collect 25 %, 33 %, 50 % and 100 % in the four years. This appears far more in line not only with the personal satisfaction of the three candidates, but also with the cost for the examination system, as only in this way the six failed (i.e. wasted) papers of Caroline are considered differently from the non-sat (i.e. non-wasted) papers of Ben.

Similarly, by this amended pass rate it would be apparent that Ernest was actually a top tutor, with 100 % pass rate among his candidates, while Francy's pass rate of 50 % would show that her performance as a tutor was not at the same level as that of Ernest.

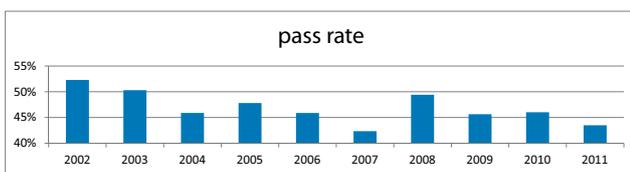
Coming to the fictitious countries, the amended pass rate would clearly show the outstanding results of candidates from Goodland: 100 % pass rate every year. On the contrary, Hardland would get 20 % in 2010 and only 11 % in 2011, these figures giving a more accurate picture of the performance by candidates from that country, and thus of the need for local training.

A reasonable objection to this proposed approach to the calculation of the pass rate might be in respect of candidates getting a compensable grade, i.e. getting 45 to 49 marks. Should they count as passes or as fails? I believe however that this is a false problem, not affecting the merit of the proposed change: compensable fail could either be added to the passes, or they could be added to the fails, or they could be taken as a separate, third category. I prefer the last option, as indeed the % of compensable fails gives somehow an indication of the uncertainty of the EQE system, which is also something interesting to monitor.

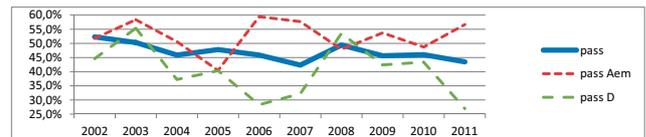
Thus, the proposed new approach seems to be able to give a more accurate picture of the reality. Moreover, it could be easily and directly applied to the results of each of the papers, thus giving an easier means to compare the results of a specific paper to the results of the whole EQE.

Anyway, apart from any theoretical discussions, the best way of getting an idea of the effect and thus of the possible interest of the proposed new calculation for the pass rate is obviously to apply it to the available data of the past EQEs. This is what I did, applying the data from the statistics available from the website of the EQE. I then arrived at the following:

- The total pass rate for 2011 is 43,5 %, not including compensable fails (51,4 % including compensable fails).
- The best total pass rate for the decade 2002–2011 was 52,3 %, in 2002.
- The worst total pass rate for the decade 2002–2011 was 42,3 %, in 2007.
- The following is a graph of the total pass rate of the decade, not including compensable fails:



- The following is a graph of the pass rate of the decade for paper A (E/M) and for paper D, compared to the total pass rate:



I do not intend to draw any conclusions from the above graph, it is just an example of how a pass rate more properly calculated could be used.

In 2012, it will be then advisable to keep the data of the pre-exam separate, i. e. to calculate a pass rate for the pre-exam and another pass rate for the other four papers. Mixing the data seems very confusing, as the conditions of the two groups of candidates are very different, as well as very different are their papers.

As from 2013, it will be highly advisable not only to keep data of the pre-exam separate, but also – for the other four papers – to keep data of candidates having passed the pre-exam separate from data of candidates having acceded the EQE without pre-exam: this will allow to see the actual effect of the pre-exam.

And now, the question is whether 43,5 % is an acceptable pass rate or not. But this is another story.

The CEIPI: International Center of Excellence in Intellectual Property



Mr Christophe GEIGER,
Director general
of the CEIPI

The role of the CEIPI

Founded in Strasbourg in 1963, the CEIPI (Center for international intellectual property studies) is today known as one of the most important academic centers in Europe for teaching and research in intellectual property law. Each year the CEIPI trains more than 2500 specialists in the various IP professions: French or European representatives, patent attorneys, civil servants in national, European and international offices and organizations, academics.

The strengths of the CEIPI: high quality training and strong research

As part of the University of Strasbourg, the CEIPI offers a wide range of courses and brings together a body of almost 400 academics and eminent practitioners in 37 European cities, so as to meet the challenges of the continually evolving international landscape of intellectual property.

Through its full range of courses covering all aspects of intellectual property, the CEIPI trains tomorrow's IP professionals, be they students or professionals. Its four university diplomas and five Master of Laws programs (LLM), one of which is research oriented, emphasize the Europeanization and the internationalization of intellectual property issues. Furthermore, CEIPI courses and seminars prepare future French and European patent representatives for the French and European qualifying examinations (the EQF and the EQE).

The CEIPI, in parallel to its academic program, concentrates on research. This plays a fundamental role in adapting to the on-going changes in the IP field.

The research program at the CEIPI, founded five years ago, has therefore undertaken an important review of intellectual property law in the knowledge based society through publications, participation in European and international projects as well as through the organization of one-day legal news seminars and of conferences. The main objective of this activity is to participate in the European construction of intellectual property law.

An international center: at the heart of a network of partners

By developing partnerships with the principal intellectual property organizations and with numerous international universities and research centers, the CEIPI plays a role in the evolution of the intellectual property field and develops joint academic and research programs, as well as student and teaching staff exchanges throughout the world.

Besides close cooperation with the different entities of the University of Strasbourg, as well as with national intellectual property institutions such as the INPI (Institut national de la propriété industrielle), and the main professional associations, the CEIPI demonstrates its international ambitions through cooperation agreements with the principal European and international organizations in intellectual property.

The WIPO (World Intellectual Property Organization), the EPO (European Patent Office), and the African Intellectual Property Organization are among the international partners of the CEIPI, partners with which the CEIPI has developed a special relationship. The CEIPI, as a non-governmental organization, has observer status with the WIPO and it extends its expertise in the training of future European representatives to the EPO.

The CEIPI also acts as a consultant for community institutions and, last July, was appointed expert to the European Parliament.

More information at: www.ceipi.edu

The link to the CEIPI EQE brochure:
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Die Crux mit der erfinderischen Tätigkeit

Dr. A. W. Kumm (DE)

Der Art. 52 EPÜ (... werden für Erfindungen erteilt, sofern sie... auf einer erfinderischen Tätigkeit beruhen ...) wird durch den Art. 56 EPÜ (... wenn sie sich für den Fachmann nicht in naheliegender Weise ... ergibt) spezifiziert. Wegen des zweifellos fiktiv-irrealen „Fachmannes“ ist jene Tätigkeit nach wie vor nicht operabel (nicht widerspruchsfrei) festzustellen.

Die Spruchpraxis jeder Instanz, die immer einen Einzelfall entscheiden muss, ist nolens volens gezwungen, die ontologische Sperre zwischen Irrealem und Realem zu ignorieren: Sie muss de facto unterstellen, dass „dem Fachmann“ das Denken und Handeln einer aussage- und zeugnisfähigen, natürlichen Person eigne; er verkörpere letztlich die Gesamtheit der realen Fachleute des Fachgebietes. Das ist aber ein Zirkelschluss, der das zu Beweisende schon als Prämisse voraussetzt¹

Die vielen, unüberschaubaren Entscheidungen über die erfinderische Tätigkeit sind prinzipiell unabhängig voneinander. Sie sind vor allem keine Präjudizen für später kommende Erfindungen, bei denen es immer um fallrechtsfreies Anderes und Neues geht, und sie

¹ Ähnliche Argumente, dass „der Fachmann“ objektiv urteile, halten einer logischen Kritik ebenfalls nicht stand. Jede Bewertung ist naturgemäß immer eine subjektive Festsetzung und keine operable Feststellung.

lassen sich auch nicht induktiv zu einer treffenderen Aussage über die erfinderische Tätigkeit verknüpfen, denn jeder Induktionsschluss führt zu einem Zirkelschluss oder zu einer endlosen Reduktion. Die Crux bleibt so dem Patentrecht und seinen Kommentatoren noch lange erhalten.

Das US Patent and Trademark Office umgeht die ontologische Sperre zwischen Irrealem und Realem offenbar ganz pragmatisch.² Nach Technology Review, 6/2004, 20ff. und 8/2009, 38ff. winkt es 90 % aller Anmeldungen durch; es nimmt offenbar „den Fachmann“ sehr wörtlich als skill-maker mit ordinary skill.³

Wenn auch in Europa Geschäftsmodelle usw. patentierbar werden, dann wird sich die Crux bald von allein auflösen. Auch mit berufsständischen Folgen. Jedenfalls wurde 1973 der „technische Fortschritt“ als objektiveres Bewertungskriterium nicht ungestraft über Bord geworfen.

² Die Angloamerikaner sind im case law und in fallrechtsfreiem Denken verwurzelt. Ihnen fehlt die kontinental-europäische Vorstellung, dass jeder neue Fall aus einem vorhandenem Gesetz „gerecht“ zu entscheiden sei.

³ Das US Patent Office schließt etwa Geschäftsmodelle, Heilbehandlungen, Entdeckungen von DNA-Sequenzen oder Algorithmen nicht schlechthin von der Patentierung aus. Im Gegenteil, der Oberste Gerichtshof erklärte 1980, dass „alles von Menschen Gemachte unter der Sonne“ patentierbar sei.

Trois années de changement et une certitude

P. G. Maué (CH)

Secrétaire Général de l'epi de 2008–2011



Durant les trois années de mon mandat de Secrétaire Général, qui coïncidaient avec les trois dernières années d'activité de Madame Dominique Monéger pour l'epi, j'ai toujours eu cette certitude d'avoir à mes côtés une collaboratrice expérimentée et attachée à la cause de l'epi. Par ces quelques lignes, j'aimerais exprimer ma

gratitude à Madame Monéger pour son soutien pendant tous les changements qui ont marqué ces trois années.

Changement d'abord en la personne du Secrétaire Général qui, après des années de proximité géographi-

que, avait son lieu de travail principal à une heure de vol de Munich. La présence au Secrétariat était donc fortement réduite, mais grâce aux échanges constants avec Madame Monéger, cette distance n'a jamais pesé sur mon travail pour l'epi

Changement majeur au niveau de l'organisation du Secrétariat suite à la décision d'employer un Office Manager et, par ce fait, d'instaurer une hiérarchie interne au Secrétariat. Malgré ce changement majeur avec ces implications au fonctionnement du Secrétariat, Madame Monéger a contribué largement au succès de la nouvelle organisation, en particulier par le partage de ses connaissances accumulées en tant d'années de travail pour l'epi.

Changement aussi du lieu de travail avec le déménagement des bureaux du Secrétariat à la Bayerstraße. L'organisation de ce déménagement n'aurait pas été possible sans le concours infatigable de Madame Monéger. Ces nouveaux locaux, plus adaptés pour ren-

dre les services attendus par les 10'000 membres de l'*epi*, ont été rendus opérationnels au cours d'un week-end prolongé.

Changement douloureux de la composition des collaborateurs du Secrétariat avec la maladie grave et la mort bien trop prématurée de Madame Della Bella. Madame Monéger a su garder un esprit positif et d'entraide pendant cette période difficile. Un peu plus tard, cet esprit était mis à nouveau à rude épreuve après la découverte des malversations de l'ancien comptable.

L'expérience et le travail bien fait de Madame Monéger ont aussi permis d'organiser un Conseil en moins de

six semaines, suite à l'éruption du volcan Eyjafjöll en Islande et tout récemment les élections pour le nouveau Conseil.

Je remercie Madame Monéger pour toutes ces années de travail au Secrétariat de l'*epi* en y apportant ses compétences dans des domaines très variés incluant le domaine linguistique et je vous souhaite, Madame Monéger, pleine satisfaction et bonne santé pour les années à venir.

Novembre 2011

Letter to the Editor

Dr. C. A.M. Mulder (NL)

On 19 December 2011, Cees Mulder successfully defended his PhD thesis entitled: "On the Alignment of the European Patent Convention and the Patent Cooperation Treaty with Requirements of the Patent Law Treaty".

The Patent Law Treaty was drafted with the aim to "streamline and harmonize" formal requirements set by national or regional Patent Offices for the filing of national or regional patent applications and the maintenance of patents. During the past few years requirements of the Patent Law Treaty have been implemented in, for instance, the European Patent Convention and the Patent Cooperation Treaty. Upon studying and compar-

ing the outcome of the implementation, not much harmonization and streamlining can be detected between these patent treaties.

For the purpose of the thesis, a number of core issues of the Patent Law Treaty has been selected: requirements for the accordance of a filing date, relief in respect of time limits and restoration of priority. The implementation of these issues in the European Patent Convention and the Patent Cooperation Treaty has been studied and compared to each other. In addition, the negotiation history of these issues is described resulting in the adoption of the Patent Law Treaty at a Diplomatic Conference in Geneva in 2000.

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