

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**

2 Editorial

3 Election results

### **II – Contributions from epi Members and other contributions**

30 Poisonous National Priority Application for the Unitary Patent,  
by P. Rambelli

32 The right to be heard before the EPO Boards of Appeal – overruled by formal  
regulation?, by Dr. H. Wegner, P. K. Hess

37 Unitary Patent – Questions and answers: What is a Unitary Patent,  
by N. Fox, A. Kupecz, D. van Dam

39 What is the unified Patent Court?, by N. Fox, A. Kupecz, D. van Dam

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

---

Redaktionsausschuss / Editorial Committee / Commission de Rédaction

Walter Holzer  
Terry Johnson  
Thierry Schuffenecker  
Albert Wiedemann

---

Postanschrift / Mailing address / Adresse postale

epi  
P.O. Box 26 01 12  
80058 Munich  
Germany  
Tel: +49 89 24 20 52-0  
Fax: +49 89 24 20 52-20  
Email: [info@patentepi.com](mailto:info@patentepi.com)  
[www.patentepi.com](http://www.patentepi.com)



---

Verlag / Publishing House / Maison d'édition

Carl Heymanns Verlag  
Eine Marke von Wolters Kluwer Deutschland GmbH  
Luxemburger Straße 449  
D-50939 Köln  
Tel. (0221) 94 373-7000  
Fax (0221) 94 373-7201  
Kundenservice: Tel. (02631) 801-2222  
[info@wolterskluwer.de](mailto:info@wolterskluwer.de)  
[www.heymanns.com](http://www.heymanns.com)

---

Anzeigen / Advertisements / Publicité

Carl Heymanns Verlag  
Eine Marke von Wolters Kluwer Deutschland GmbH

---

Druck / Printing / Imprimeur

Grafik + Druck GmbH, München  
ISSN 1434-8853  
© Copyright epi 2014

---

#### **Vierteljahreszeitschrift**

Abonnement im Mitgliedsbeitrag enthalten, für Nichtmitglieder € 62,00 p.a. zzgl. Versandkosten (€ 9,90 Inland / € 14,00 Ausland), Einzelheft € 20,00 zzgl. Versandkosten (ca. € 2,27 Inland / ca. € 3,20 Ausland) je nach Heftumfang. Preise inkl. MwSt. Aufkündigung des Bezuges 6 Wochen vor Jahresende.

#### **Quarterly Publication**

Subscription fee included in membership fee, for non-members € 62,00 p.a. plus postage (national € 9,90 / abroad € 14,00), individual copy € 20,00 p.a. plus postage (national about € 2,27, abroad about € 3,20) depending on the size of the issue, VAT included. Cancellation of subscription is requested 6 weeks before any year's end.

#### **Publication trimestrielle**

Prix de l'abonnement inclus dans la cotisation, pour non-membres € 62,00 p.a., frais d'envoi en sus (national € 9,90 / étranger € 14,00), prix à l'unité € 20,00, frais d'envoi en sus (national environ € 2,27, étranger environ € 3,20) selon le volume du numéro, TVA incluse. Résiliation de l'abonnement 6 semaines avant la fin de l'année.

Das Institut ist weder für Erklärungen noch für Meinungen verantwortlich, die in Beiträgen dieser Zeitschrift enthalten sind. Artikel werden in der oder den Amtsprachen (deutsch, englisch, französisch) wiedergegeben, in der bzw. denen diese Artikel eingereicht wurden.

The Institute as a body is not responsible either for the statements made, or for the opinions expressed in the publications. Articles are reproduced in the official language or languages (German, English or French) in which they are submitted.

L'Institut n'est pas responsable des opinions exprimées dans cette publication. Les articles sont publiés dans celle ou celles des trois langues officielles (allemand, anglais ou français) dans laquelle ou lesquelles ils ont été proposés.

The trade mark "epi" is the property of the Institute and is registered nationally in Germany and as a Community Trade Mark at OHIM.

## Table of Contents

<b>Editorial</b> . . . . .	2	<b>Information from the Secretariat</b>	
<b>I – Information concerning epi</b>		Next Board and Council Meetings . . . . .	29
<b>Results of the election to the 17<sup>th</sup> Council</b> . . . . .	3	Deadline 2/2014 . . . . .	29
Election results . . . . .	4	<b>epi</b> Disciplinary bodies and Committees . . . . .	45
		<b>epi</b> Board . . . . .	U3
<b>Committee Reports</b>		<b>II – Contributions from epi Members and other contributions</b>	
Report of the Committee on Biotechnological Inventions, by A. De Clercq, S. Wright . . . . .	18	<b>Articles</b>	
Report of the By-Laws Committee (BLC), by P. Moutard . . . . .	19	Poisonous National Priority Application for the Unitary Patent, by P. Rambelli (IT) . . . . .	30
Report of the European Patent Practice Committee (EPPC), by F. Leyder . . . . .	20	The right to be heard before the EPO Boards of Appeal – overruled by formal regulations?, by Dr. H. Wegner, P. K. Hess (DE) . . . . .	32
Report of the Disciplinary Committee (DC), by P. Rosenich, V. Pröll . . . . .	21	Unitary Patent – Questions and answers: What is a Unitary Patent, by N. Fox (GB), A. Kupecz (NL), D. van Dam (NL) . . . . .	37
Report of the Harmonization Committee (HC), by F. Leyder . . . . .	22	What is the unified Patent Court?, by N. Fox (GB), A. Kupecz (NL), D. van Dam (NL) . . . . .	39
<b>Education and Training</b>		<b>Book Review</b>	
Forthcoming <b>epi</b> educational events . . . . .	23	Inside Intellectual Property, by M. Jewess (GB) . . . . .	43
Candidate Support Project (CSP), M. Teodorescu, M. Fromm . . . . .	23	<b>Letters to the Editor</b>	
News from <b>epi</b> 's "Education and Training" Section . . . . .	24	Intellectual freedom on economical common sense, by G. Kern (DE) . . . . .	44
Information about <b>epi</b> student membership . . . . .	25		
<b>epi</b> /EPO „Opposition and Appeal“ seminars, M. Fromm . . . . .	25		
<b>epi</b> summer and autumn tutorial 2014 . . . . .	26		
<b>Information from the EPO</b>			
Contact Data of Legal Division . . . . .	28		

## Editorial

T. Johnson (GB)

So it is out with the old and in with the new. Issue 2/2014 of **epi** Information will have an editorial presented by a member of the Editorial Committee to be appointed by the newly – elected Council in this an election year. “On with the Motley” might be an appropriate call in the circumstances, the “Motley” readers will recall being a multi-coloured costume worn by a clown or Court jester. This is not to suggest, we hasten to add, that the new Council (or this Committee!) will in any way be clowns. Far from it. Indeed we are sure that the new Council will be just as serious, diligent and hard-working as the outgoing one was. It is, however, also worth the new President and the new Board remembering that in medieval times the jester was an important person who could tell the truth at Court (aka Council) without fear of

punishment, even if that truth was contrary to the king’s or senior persons’ opinion. So the jester, and our Council by extension, acts as an antidote to hubris in high places.

I cannot let this ‘motley’ theme pass without being reminded that the expression “Motley Crew” is an expression in English used to mean a roughly organised assembly of characters, usually of ill-repute, such as pirates. Our elections are smoothly and properly conducted and Council is a well-organised group of persons of the utmost integrity having the common aim of furthering the aims and objectives of our Institute and its membership. We are therefore confident that here will be no Motley Crew in evidence over the next three years. Or so we hope ...

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

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **9. Mai 2014**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

### Next deadline for **epi** Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of **epi** Information is **May, 9<sup>th</sup> 2014**. 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 **epi** Information est le **9 mai 2014**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

## Ergebnisse der Wahl zum 17. Rat

### Hinweis

Mitglieder des Instituts, die gegen das Wahlergebnis Einwände erheben möchten, müssen ihre schriftlichen Einwände rechtsgültig unterzeichnet bis spätestens **29. März 2014** beim Sekretariat des Instituts einreichen. Später eingehende Einwände werden nicht berücksichtigt.

Ich danke den Mitgliedern des Wahlausschusses, den Herren M.A. Müller, H.H. Breiter, und A.Vilhjálmsson sowie Frau Vernessa Pröll (**epi** Sekretariat) für ihren Einsatz.

## Results of the election to the 17<sup>th</sup> Council

### Notice

Members of the Institute wishing to object against the election results must submit their written objection duly signed to reach the Secretariat of the Institute by **29 March 2014** at the latest. Any objections reaching the Institute after this date will not be taken into consideration.

I thank the members of the Electoral Committee, Messrs. M.A. Müller, H.H. Breiter, A.Vilhjálmsson and Ms Vernessa Pröll from the **epi** Secretariat for their commitment.

## Résultats de l'élection au 17. Conseil

### Note

Les membres de l'Institut désirant contester les résultats de l'élection doivent faire parvenir leurs objections écrites dûment signées au Secrétariat de l'Institut avant le **29 mars 2014** au plus tard. Toute objection parvenant à l'Institut après cette date ne sera plus prise en considération.

Je remercie les membres de la Commission Electorale, MM. M.A. Müller, H. Breiter, et A.Vilhjálmsson et Mme. Vernessa Pröll (**epi** Secrétariat) pour leur engagement.

João Pereira da Cruz

Generalsekretär/Secretary General/Secrétaire Général

### Erläuterung

- \* als stellvertretendes Mitglied zur Wahl
- \*\* Losentscheid bei gleicher Stimmenzahl
- + nominiert im wieder eröffneten Nominationsverfahren

### Legend

- \* stood as substitute only
- \*\* tie vote position decided by lot
- + nominated in reopened nomination procedure

### Légende

- \* éligible comme suppléant uniquement
- \*\* classement par tirage au sort à égalité de voix
- + nommé dans la procédure de nomination ré-ouverte

**AL – Albania**

Sent ballots: 19      Participation: 68 %      Received ballots: 13

**Candidates**

DODBIBA Eno	5	PANIDHA Ela	3
NIKA Vladimir	6	SHOMO Vjollca	4

**Allotment of seats**

Full Members		Substitute Members	
1. NIKA Vladimir	6	3. SHOMO Vjollca	4
2. DODBIA Eno	5	4. PANIDHA Ela	3

**AT – Austria**

Sent ballots: 129      Participation: 44 %      Received ballots: 57

**Private Practice**

Received ballots: 37

**Candidates**

FORSTHUBER Martin	17	ISRAILOFF Peter	11	WEINZINGER Philipp	20
HARRER-REDL Dagmar	13	LOIDL Manuela Bettina	10		

**Allotment of seats**

Full Members		Substitute Members	
1. WEINZINGER Philipp	20	3. HARRER-REDL Dagmar	13
2. FORSTHUBER Martin	17	4. ISRAILOFF Peter	11

**Other Capacity**

Received ballots: 20

**Candidates**

HEDENETZ		KOVAC Werner *	10	SCHRITTWIESER Waltraud	12
Alexander Gernot *	10	KRAUSE Peter	6	SCHWEINZER Friedrich	15

**Allotment of seats**

Full Members		Substitute Members	
1. SCHWEINZER Friedrich	15	3. KOVAC Werner * /**	10
2. SCHRITTWIESER Waltraud	12	4. HEDENETZ Alexander Gernot * /**	10

**BE – Belgium**

Sent ballots: 205      Participation: 54 %      Received ballots: 110

**Private Practice**

Received ballots: 49

**Candidates**

DE CLERCQ Ann G. Y.	23	VAN DEN BOECK Wim * +	12
QUINTELIER Claude	24	VAN MALDEREN Joëlle	25

**Allotment of seats**

Full Members		Substitute Members	
1. VAN MALDEREN Joëlle	25	3. DE CLERCQ Ann G. Y.	23
2. QUINTELIER Claude	24	4. VAN DEN BOECK Wim * +	12

**Other Capacity**

Received ballots: 61

**Candidates**

CLERIX André	24	MELLET Valérie Martine *	10	VOORTMANS Gilbert J. I.	26
DAELEMANS Frank F. R.	26	VANDERSTEEN Pieter *	15		
LEYDER Francis	42	VIAENE Ann I. M. *	10		

**Allotment of seats**

Full Members		Substitute Members	
1. LEYDER Francis	42	3. DAELEMANS Frank F. R. **	26
2. VOORTMANS Gilbert J. I. **	26	4. CLERIX André	24

**BG – Bulgaria**

Sent ballots: 65

Participation: 45 %

Received ballots: 29

**Candidates**

ANDREEVA Natasha Petkova	17	IVANOV Ivan Nikolov	4	SHENTOVA	
BENATOV Samuil Gabriel	14	KOSSEVA		Violeta Varbanova	11
DARAKTSCHIEW		Radislava Andreeva	17	SLABOVA	
Todor Dotschew	4	MANEV Kostadin Chanev	2	Roumiana Stefanova	6
GEORGIEVA		NEYKOV Neyko Hristov	8	STEFANOVA	
Antoaneta Ganeva	6	PAKIDANSKA		Stanislava Hristova	17
GEORGIEVA-TABAKOVA		Ivanka Slavcheva	10	VINAROVA	
Milena Lubenova	11			Emilia Zdravkova	6

**Allotment of seats**

Full Members		Substitute Members	
1. ANDREEVA Natasha Petkova	17	5. SHENTOVA Violeta Varbanova **	11
2. KOSSEVA Radislava Andreeva	17	6. GEORGIEVA-TABAKOVA Milena Lubenova **	11
3. STEFANOVA Stanislava Hristova	17	7. PAKIDANSKA Ivanka Slavcheva	10
4. BENATOV Samuil Gabriel	14	8. NEYKOV Neyko Hristov	8

**CH – Switzerland**

Sent ballots: 506

Participation: 40 %

Received ballots: 203

**Private Practice**

Received ballots: 92

**Candidates**

BALLOT Gabriel	17	REISS Gilles François	21	SCHIRBACH Marcel	11
BRAUN André Jr.	67	REUTELER		TOLETI Martin	23
LATSCHA Silvan	43	Raymond Werner	58	WAGNER Kathrin *	34
LIEBETANZ Michael	76	SAAM Christophe	34		

**Allotment of seats**

Full Members		Substitute Members	
1. LIEBETANZ Michael	76	4. LATSCHA Silvan	43
2. BRAUN André Jr.	67	5. SAAM Christophe **	34
3. REUTELER Raymond Werner	58	6. WAGNER Kathrin */**	34

**Other Capacity**

Received ballots: 111

**Candidates**

BAST Tim	43	DALE Gavin Christopher *	39	THOMSEN Peter René	88
BERNHARDT		KLEY Hansjörg	78		
Wolfgang Willy-Hans *	66	MAUÉ Paul Georg	74		

**Allotment of seats****Full Members**

1. THOMSEN Peter René	88
2. KLEY Hansjörg	78
3. MAUÉ Paul Georg	74

**Substitute Members**

4. BERNHARDT Wolfgang Willy-Hans *	66
5. BAST Tim	43
6. DALE Gavin Christopher *	39

**CY – Cyprus**

Sent ballots: 12

Participation: 67 %

Received ballots: 8

**Candidates**

DEMETRIADES Achilleas L.	2	MARKIDES Hermione Al.	2	THEODOULOU Christos A.	4
--------------------------	---	-----------------------	---	------------------------	---

**Allotment of seats****Full Members**

1. THEODOULOU Christos A.	4
2. MARKIDES Hermione Al. **	2

**Substitute Members**

3. DEMETRIADES Achilleas L. **	2
--------------------------------	---

**CZ – Czech Republic**

Sent ballots: 95

Participation: 22 %

Received ballots: 21

**Candidates**

FISCHER Michael	6	HARTVICOVA Katerina	8	ZAK Vitezslav	13
GUTTMANN Michal	17	HOLASOVA Hana	15	ZEMANOVA Veronika *	15
HAINZ Miloslav *	12	MALUSEK Jiri	14		

**Allotment of seats****Full Members**

1. GUTTMANN Michal	17
2. HOLASOVA Hana	15
3. MALUSEK Jiri	14
4. ZAK Vitezslav	13

**Substitute Members**

5. ZEMANOVA Veronika *	15
6. HAINZ Miloslav *	12
7. HARTVICOVA Katerina	8
8. FISCHER Michael	6

## DE – Germany

Sent ballots: 3903

Participation: 27 %

Received ballots: 1062

### Private Practice

Received ballots: 634

### Candidates

BANSE Klaus-Dieter	92	KELLER Günter	147	RAUNECKER Klaus Peter	42
BOCKHORN Josef	181	KLEMM Rolf	45	RAYKOWSKI Marcus	26
DE ANNA Pier Luigi	41	LEISSLER-GERSTL Gabriele	344	RITTER Albrecht	71
FELGEL-FARNHOLZ Wolf-Dieter	86	LINHART Friedrich		RUPP Christian	189
FRANKE Dirk	63	Karl Eberhard	25	SCHOBBER Christoph D.	76
GOSMANN Martin	64	MAIKOWSKI Michael	301	SUN Yiming	60
HOFFMANN Jörg	104	POTT Thomas	69	VOGELSANG-WENKE Heike	321
		RAUH Hannelore	161		

### Allotment of seats

#### Full Members

1. LEISSLER-GERSTL Gabriele	344
2. VOGELSANG-WENKE Heike	321
3. MAIKOWSKI Michael	301

#### Substitute Members

4. RUPP Christian	189
5. BOCKHORN Josef	181
6. RAUH Hannelore	161

### Other Capacity

Received ballots: 428

### Candidates

KREMER Véronique		STEILING Lothar	278	WILLEMS Volker	166
Marie Joséphine	124	SZYMANOWSKI Carsten	208	WINTER Andreas	224
MARX Thomas	106	TÜNGLER Eberhard	163		
MOHSLER Gabriele	282	VÖLGER Silke Beatrix	245		

### Allotment of seats

#### Full Members

1. MOHSLER Gabriele	282
2. STEILING Lothar	278
3. VÖLGER Silke Beatrix	245

#### Substitute Members

4. WINTER Andreas	224
5. SZYMANOWSKI Carsten	208
6. WILLEMS Volker	166

## DK – Denmark

Sent ballots: 243

Participation: 44 %

Received ballots: 106

### Private Practice

Received ballots: 71

### Candidates

CHRISTIANSEN Ejvind *	18	HEGNER Anette	13	KOEFOED Peter	37
DAMSGAARD Henriette Ammitzbohl	11	HØIBERG Susanne	35	THORSBOE Eva Pernille	13
		INDAHL Peter Jensen *	30		

### Allotment of seats

#### Full Members

1. KOEFOED Peter	37
2. HØIBERG Susanne	35

#### Substitute Members

3. INDAHL Peter Jensen *	30
4. CHRISTIANSEN Ejvind *	18

**Other Capacity**

Received ballots: 35

**Candidates**

JENSEN Bo Hemmer	23	KANVED Nicolai	24	PEDERSON Soeren Skovgaard	12
------------------	----	----------------	----	---------------------------	----

**Allotment of seats****Full Members**

1. KANVED Nicolai	24
2. JENSEN Bo Hemmer	23

**Substitute Members**

3. PEDERSON Soeren Skovgaard	12
------------------------------	----

**EE – Estonia**

Sent ballots: 26

Participation: 73 %

Received ballots: 19

**Candidates**

KAHU Sirje	18	NELSAS Tõnu	15	SARAP Margus	12
KOPPEL Mart Enn	11	OSTRAT Jaak *	15	TOOME Jürgen	17

**Allotment of seats****Full Members**

1. KAHU Sirje	18
2. TOOME Jürgen	17
3. NELSAS Tõnu	15
4. SARAP Margus	12

**Substitute Members**

5. OSTRAT Jaak *	15
6. KOPPEL Mart Enn	11

**ES – Spain**

Sent ballots: 187

Participation: 39 %

Received ballots: 72

**Candidates**

ALVAREZ Fernando	3	ELOSEGUI DE LA PENA Inigo	27	SAEZ GRANERO Francisco Javier	43
ARIAS SANZ Juan	36	GALLARDO Antonio M. *	11	SANZ-BERMELL MARTINEZ Alejandro *	16
ARMIJO NAVARRO-REVERTER Enrique	30	JORDA PETERSEN Santiago *	32	STIEBE Lars Magnus	29
BERNARDO NORIEGA Francisco	37	MASLANKA Dorota	3	VILALTA JUVANTENY Luis *	30
DURAN MOYA Luis-Alfonso	25	MOHAMMADIAN Dario	9		
		MORGADES Y MANONELLES Juan Antonio	27		

**Allotment of seats****Full Members**

1. SAEZ GRANERO Francisco Javier	43
2. BERNARDO NORIEGA Francisco	37
3. ARIAS SANZ Juan	36
4. ARMIJO NAVARRO-REVERTER Enrique	30

**Substitute Members**

5. JORDA PETERSEN Santiago *	32
6. VILALTA JUVANTENY Luis *	30
7. STIEBE Lars Magnus	29
8. ELOSEGUI DE LA PENA Inigo **	27

## FI – Finland

Sent ballots: 181

Participation: 38 %

Received ballots: 68

### Candidates

ETUAHO Kirsikka Elina	33	KÄRKKÄINEN Veli-Matti *	29	WESTERHOLM Carl Christian	27
HÄYRINEN Ville Tapani	28	LAMBERG Samu Petteri * +	26		
HONKASALO Terhi		VÄISÄNEN Olli Jaakko	15		
Marjut Anneli	53	VALKONEN Pekka Juhani	23		

### Allotment of seats

#### Full Members

1. HONKASALO Terhi Marjut Anneli	53
2. ETUAHO Kirsikka Elina	33
3. HÄYRINEN Ville Tapani	28
4. WESTERHOLM Carl Christian	27

#### Substitute Members

5. KÄRKKÄINEN Veli-Matti *	29
6. VALKONEN Pekka Juhani	23
7. VÄISÄNEN Olli Jaakko	15
8. LAMBERG Samu Petteri * +	26

## FR- France

Sent ballots: 1012

Participation: 32 %

Received ballots: 325

### Private Practice

Received ballots: 194

### Candidates

CALLON DE LAMARCK Jean-Robert *	99	LAGET Jean-Loup *	48	NUSS Laurent	114
CASALONGA Axel	112	LEBKIRI Alexandre	61	PEUSCET Jacques	48
DELORME Nicolas	57	MOUTARD Pascal Jean	49	PRUGNEAU Philippe	43
		NEVANT Marc	72	VENTAVOLI Roger	21

### Allotment of seats

#### Full Members

1. NUSS Laurent	114
2. CASALONGA Axel	112
3. NEVANT Marc	72

#### Substitute Members

4. CALLON DE LAMARCK Jean-Robert *	99
5. LEBKIRI Alexandre	61
6. DELORME Nicolas	57

### Other Capacity

Received ballots: 131

### Candidates

BAUVIR Jacques	103	LE VAGUERESE Sylvain Jacques	75	ROUGEMONT Bernard	87
CONAN Philippe Claude	104	RADZIMSKI Eric	61	TARAVELLA Brigitte *	84
GENDRAUD Pierre	78				

### Allotment of seats

#### Full Members

1. CONAN Philippe Claude	104
2. BAUVIR Jacques	103
3. ROUGEMONT Bernard	87

#### Substitute Members

4. TARAVELLA Brigitte *	84
5. GENDRAUD Pierre	78
6. LE VAGUERESE Sylvain Jacques	75

## GB – Great Britain

Sent ballots: 2066

Participation: 16 %

Received ballots: 325

### Candidates

BOFF James Charles	189	GRAY John James	179	NORRIS Timothy Sweyn	150
BROWN John D.	172	HEPWORTH		WRIGHT Simon Mark	224
DUNLOP Hugh Christopher	198	John Malcolm *	136		
GOWSHALL		JOHNSON Terence Leslie	167		
Jonathan Vallance	184	MERCER Christopher Paul	245		

### Allotment of seats

#### Full Members

1. MERCER Christopher Paul	245
2. WRIGHT Simon Mark	224
3. DUNLOP Hugh Christopher	198
4. BOFF James Charles	189
5. GOWSHALL Jonathan Vallance	184
6. GRAY John James	179

#### Substitute Members

7. BROWN John D.	172
8. JOHNSON Terence Leslie	167
9. NORRIS Timothy Sweyn	150
10. HEPWORTH John Malcolm *	136

## GR – Greece

Sent ballots: 24

Participation: 46 %

Received ballots: 11

### Candidates

BAKATSELOU Vassiliki	10	TSIMIKALIS Athanasios	5	YAZITZOGLU Evagelia S.	7
PAPACONSTANTINOOU Helen	8	VOSEMBERG-VRETOS Ileana	3		

### Allotment of seats

#### Full Members

1. BAKATSELOU Vassiliki	10
2. PAPACONSTANTINOOU Helen	8

#### Substitute Members

3. YAZITZOGLU Evagelia S.	7
4. TSIMIKALIS Athanasios	5

## HR – Croatia

Sent ballots: 26

Participation: 31 %

Received ballots: 8

### Candidates

BOSKOVIC Davor	6	KORPER ZEMVA Dina	4	VUKINA Sanja	7
HADZIJA Tomislav	7	TOMSIC SKODA Slavica	3		

### Allotment of seats

#### Full Members

1. VUKINA Sanja	7
2. HADZIJA Tomislav	7
3. BOSKOVIC Davor	6
4. KORPER ZEMVA Dina	4

#### Substitute Members

5. TOMSIC SKODA Slavica	3
-------------------------	---

## HU – Hungary

Sent ballots: 78

Participation: 45 %

Received ballots: 35

### Candidates

BIACS Mónika	7	KOVARI Zoltan	10	PINTZ György	5
BODIZS Arpad *	7	LENGYEL Zsolt	16	SOMFAI Eva	4
KERESZTY Marcell *	25	MARKO József	7	SZENTPÉTERI Adam	31
KÖTELES Zoltan	26	PETHO Arpad	25	TÖRÖK Ferenc	30

### Allotment of seats

#### Full Members

1. SZENTPÉTERI Adam	31
2. TÖRÖK Ferenc	30
3. KÖTELES Zoltan	26
4. PETHO Arpad	25

#### Substitute Members

5. KERESZTY Marcell *	25
6. LENGYEL Zsolt	16
7. KOVARI Zoltan	10
8. MARKO József **	7

## IE – Ireland

Sent ballots: 70

Participation: 49 %

Received ballots: 34

### Candidates

BOYCE Conor	20	KELLY Donal Morgan *	14	SYRISOVA Ekaterina *	15
CASEY Lindsay Joseph	20	MCCARTHY Denis Alexis	25	WHITE Jonathan Patrick *	13
GAFFNEY Naoise Eoin	13	O'NEILL Brian *	20		
HARTE Seán Paul	22	QUINLAN Angela *	9		

### Allotment of seats

#### Full Members

1. MCCARTHY Denis Alexis	25
2. HARTE Seán Paul	22
3. BOYCE Conor	20
4. CASEY Lindsay Joseph	20

#### Substitute Members

5. O'NEILL Brian *	20
6. SYRISOVA Ekaterina *	15
7. KELLY Donal Morgan *	14
8. GAFFNEY Naoise Eoin **	13

## IS – Iceland

Sent ballots: 22

Participation: 36 %

Received ballots: 8

### Candidates

FRIDRIKSSON Einar Karl	7	INGVARSSON Sigurdur	4	MARLIN Dana Stewart	2
HARDARSON Gunnar Örn	6	JONSSON Thorlakur	7		

### Allotment of seats

#### Full Members

1. FRIDRIKSSON Einar Karl	7
2. JONSSON Thorlakur	7

#### Substitute Members

3. HARDARSON Gunnar Örn	6
4. INGVARSSON Sigurdur	4

## IT – Italy

Sent ballots: 494      Participation: 63 %      Received ballots: 309

Of which invalid: 1

### Private Practice

Received ballots: 273

### Candidates

CHECCACCI Giorgio *	147	GERLI Paolo	120	RAMBELLI Paolo	131
DE GREGORI Antonella	103	MODIANO Micaela Nadia	149		

### Allotment of seats

#### Full Members

1. MODIANO Micaela Nadia 149  
2. RAMBELLI Paolo 131

#### Substitute Members

3. CHECCACCI Giorgio \* 147  
4. GERLI Paolo 120

### Other Capacity

Received ballots: 35

### Candidates

COLUCCI Giuseppe	23	GUERCI Alessandro	24	TAGLIAFICO Giulia	26
GIBERTI Stefano	15	MACCHETTA Francesco	24		

### Allotment of seats

#### Full Members

1. TAGLIAFICO Giulia 26  
2. GUERCI Alessandro \*\* 24

#### Substitute Members

3. MACCHETTA Francesco \*\* 24  
4. COLUCCI Giuseppe 23

## LI – Liechtenstein

Sent ballots: 22      Participation: 64 %      Received ballots: 14

### Candidates

ALLWARDT Anke	13	HARMANN Bernd-Günther	9
GYAJA Christoph Benjamin * 13		PISCHETSRIEDER Tobias M. * 11	

### Allotment of seats

#### Full Members

1. ALLWARDT Anke 13  
2. HARMANN Bernd-Günther 9

#### Substitute Members

3. GYAJA Christoph Benjamin \* 13  
4. PISCHETSRIEDER Tobias M. \* 11

## LT – Lithuania

Sent ballots: 26      Participation: 69 %      Received ballots: 18

### Candidates

BANAITE VITALIJA Vitalija	9	KISKIS Vaclovas *	3	SRUOGIENE Gene Ona	6
DRAUGELIENE Virgina Adolfina	10	KLIMAITIENE Otilija	10	VIESUNAITE Vilija	6
GERASIMOVIC Jelena	6	PAKENIENE Ausra	9	ZABOLIENE Reda	6
GERASIMOVIC Liudmila	11	PETNIUNAITE Jurga	10		
		SIDLAUSKIENE Aurelija	8		

### Allotment of seats

#### Full Members

1. GERASIMOVIC Liudmila 11  
2. DRAUGELIENE Virgina Adolfina 10  
3. KLIMAITIENE Otilija 10  
4. PETNIUNAITE Jurga 10

#### Substitute Members

5. BANAITE VITALIJA Vitalija \*\* 9  
6. PAKENIENE Ausra \*\* 9  
7. SIDLAUSKIENE Aurelija 8  
8. SRUOGIENE Gene Ona \*\* 6

## LU – Luxembourg

Sent ballots: 20

Participation: 90 %

Received ballots: 18

### Private Practice

Received ballots: 16

### Candidates

BEISSEL Jean	9	BRUCK Mathis	9	LECOMTE Didier	1
--------------	---	--------------	---	----------------	---

### Allotment of seats

#### Full Members

1. BEISSEL Jean \*\* 9

#### Substitute Members

2. BRUCK Mathis \*\* 9

### Other Capacity

Received ballots: 2

### Candidates

KUTSCH Bernd	2	LAMPE Sigmar *	2
--------------	---	----------------	---

### Allotment of seats

#### Full Members

1. KUTSCH Bernd 2

#### Substitute Members

2. LAMPE Sigmar \* 2

## LV – Latvia

Sent ballots: 21

Participation: 57 %

Received ballots: 12

### Candidates

FORTUNA Jevgenijs	12	SERGEJEVA Valentina	4
OSMANS Voldemars	8	SMIRNOV Alexander	3

### Allotment of seats

#### Full Members

1. FORTUNA Jevgenijs	12
2. OSMANS Voldemars	8

#### Substitute Members

3. SERGEJEVA Valentina	4
4. SMIRNOV Alexander	3

## MC – Monaco

Sent ballots: 4

Participation: 75 %

Received ballots: 3

### Candidates

HAUTIER Nicolas +	2	SCHMALZ Günther	2	THACH Tum +	1
GEVERS Jacques	1	SCHUFFENECKER Thierry +	0		

### Allotment of seats

#### Full Members

1. SCHMALZ Günther	2
2. GEVERS Jacques	1

#### Substitute Members

3. HAUTIER Nicolas +	2
4. THACH Tum +	1

## MK – former Yugoslav republic of Macedonia

Sent ballots: 26      Participation: 69 %      Received ballots: 18

### Of which invalid: 1

#### Candidates

DAMJANSKI Vanco	7	KJOESKA Marija	6	VESKOVSKA Blagica	0
ILIEVSKI Bogoljub	7	KOSTOVSKA-STOJKOVSKA		VUKADINOVIC PEKEVSKA	
JOANIDIS Aleksandar	1	Zivka	4	Margarita	2
JOANIDIS Biljana	2	PEKEVSKA Anna	4		
JOANIDIS Jovan	2	PEPELJUGOSKI Valentin	9		

#### Allotment of seats

##### Full Members

1. PEPELJUGOSKI Valentin	9
2. DAMJANSKI Vanco	7
3. ILIEVSKI Bogoljub	7
4. KJOESKA Marija	6

##### Substitute Members

5. PEKEVSKA Anna **	4
6. KOSTOVSKA-STOJKOVSKA Zivka **	4
7. JOANIDIS Biljana **	2
8. JOANIDIS Jovan **	2

## MT – Malta

Sent ballots: 5      Participation: 80 %      Received ballots: 4

#### Candidates

SANSONE Luigi	4	ZIERER Otto	0
---------------	---	-------------	---

#### Allotment of seats

##### Full Members

1. SANSONE Luigi	4
------------------	---

##### Substitute Members

None

## NL – Netherlands

Sent ballots: 482      Participation: 42 %      Received ballots: 203

#### Candidates

AALBERS Arnt Reiner	81	JORRITSMA Ruurd *	84	MULDER Cornelis A. M. *	100
CLARKSON Paul Magnus	51	KETELAARS Maarten		TANGENA	
DU PONT Jeroen	66	F. J. M.	60	Antonius Gerardus	131
HOGENBIRK Marijke	126	KRAAK Hajo	84	WITMANS Hermanus *	73

#### Allotment of seats

##### Full Members

1. TANGENA Antonius Gerardus	131	5. MULDER Cornelis A. M. *	100
2. HOGENBIRK Marijke	126	6. JORRITSMA Ruurd *	84
3. KRAAK Hajo	84	7. WITMANS Hermanus *	73
4. AALBERS Arnt Reiner	81	8. DU PONT Jeroen	66

## NO – Norway

Sent ballots: 100

Participation: 22 %

Received ballots: 22

### Candidates

BERG André	13	REKDAL Kristine	17	THORVALDSEN Knut	10
BERG Per Geir *	11	SIMONSEN Kari Helen * +	12	THRANE Dag	15
FLUGE Per Roald *	9	THORESEN Liv Heidi * +	11		

### Allotment of seats

#### Full Members

1. REKDAL Kristine	17
2. THRANE Dag	15
3. BERG André	13
4. THORVALDSEN Knut	10

#### Substitute Members

5. BERG Per Geir *	11
6. FLUGE Per Roald *	9
7. SIMONSEN Kari Helen * +	12
8. THORESEN Liv Heidi * +	11

## PL – Poland

Sent ballots: 311

Participation: 27 %

Received ballots: 84

### Candidates

BURY Lech Marek	31	KREKORA Magdalena	29	MALEWSKA Ewa	35
BURY Marek	33	LEWICKA Katarzyna		PAWLOWSKI Adam	24
KAMINSKI Piotr	19	Dorota	42	ROGOZINSKA Alicja	33
KORBELA Anna	35	MALCHEREK Piotr	34	WITEK Rafal	23

### Allotment of seats

#### Full Members

1. LEWICKA Katarzyna Dorota	42
2. KORBELA Anna	35
3. MALEWSKA Ewa	35
4. MALCHEREK Piotr	34

#### Substitute Members

5. BURY Marek **	33
6. ROGOZINSKA Alicja **	33
7. BURY Lech Marek	31
8. KREKORA Magdalena	29

## PT – Portugal

Sent ballots: 41

Participation: 56 %

Received ballots: 23

### Candidates

ALVES MOREIRA Pedro	20	DIAS MACHADO		PEREIRA DA CRUZ João	20
BESSA MONTEIRO César *	20	Antonio J. *	20	SAMPAIO José Eduardo De *	20
CARVALHO FRANCO Isabel	20	FERREIRA MAGNO		SILVESTRE DE ALMEIDA	
CRUZ Nuno Carlos *	20	Fernando Antonio	20	FERREIRA Luis Humberto	3

### Allotment of seats

#### Full Members

1. ALVES MOREIRA Pedro	20
2. CARVALHO FRANCO Isabel	20
3. FERREIRA MAGNO Fernando Antonio	20
4. PEREIRA DA CRUZ João	20

#### Substitute Members

5. CRUZ Nuno Carlos * /**	20
6. SAMPAIO José Eduardo De * /**	20
7. DIAS MACHADO Antonio J. * /**	20
8. BESSA MONTEIRO César * /**	20

## RO – Romania

Sent ballots: 56 Participation: 57 % Received ballots: 32

### Candidates

BUCSA Gheorghe	9	NITA Florina	4	POPA Cristina *	15
ENE Silvia	6	OPROIU Margareta	8	PUSCASU Dan	9
FIERASCU Cosmina-Catrinel	12	PETREA Dana-Maria	6	TEODORESCU Mihaela	18
FILIPPI Valentina	4	POP Calin Radu	1	TULUCA F. Doina	14
NICOLAESCU Daniella Olga	15	POP Virginia-Daisy	1	VASILESCU Raluca	12

### Allotment of seats

#### Full Members

1. TEODORESCU Mihaela	18
2. NICOLAESCU Daniella Olga	15
3. TULUCA F. Doina	14
4. VASILESCU Raluca **	12

#### Substitute Members

5. POPA Cristina *	15
6. FIERASCU Cosmina-Catrinel **	12
7. PUSCASU Dan **	9
8. BUCSA Gheorghe **	9

## RS – Serbia

Sent ballots: 53 Participation: 21 % Received ballots: 11

### Candidates

BOGDANOVIC Dejan	6	PETOSEVIC Slobodan	2	ZATEZALO Mihajlo	2
BRKIC Zeljka * +	7	PLAVSA Uros	10		

### Allotment of seats

#### Full Members

1. PLAVSA Uros	10
2. BOGDANOVIC Dejan	6
3. ZATEZALO Mihajlo	2
4. PETOSEVIC Slobodan	2

#### Substitute Members

5. BRKIC Zeljka * +	7
---------------------	---

## SE – Sweden

Sent ballots: 373 Participation: 37 % Received ballots: 138

### Candidates

BJERNDSELL Per Ingvar *	43	KARLSTRÖM Lennart	57	SJÖGREN PAULSSON Stina	102
ERIKSSON Hans Gustaf	27	LINDGREN Anders *	48	YDRESKOG Margareta	78
ESTREEN Lars J. F.	82	MARTINSSON Peter	69		

### Allotment of seats

#### Full Members

1. SJÖGREN PAULSSON Stina	102
2. ESTREEN Lars J. F.	82
3. YDRESKOG Margareta	78
4. MARTINSSON Peter	69

#### Substitute Members

5. KARLSTRÖM Lennart	57
6. LINDGREN Anders *	48
7. BJERNDSELL Per Ingvar *	43
8. ERIKSSON Hans Gustaf	27

## SI – Slovenia

Sent ballots: 30 Participation: 57 % Received ballots: 17

### Candidates

BORSTAR Dusan	16	KRALJIC Janez *	12	OSOLNIK Renata	12
GOLMAJER ZIMA Marjanca	16	KUNIC TESOVIĆ Barbara	17	REDENSEK Vladimira *	13
IVANCIC Bojan *	10	MACEK Gregor	17	VOJIR Andrej	7

**Allotment of seats**

Full Members		Substitute Members	
1. MACEK Gregor	17	5. REDENSEK Vladimira *	13
2. KUNIC TESOVIC Barbara	17	6. KRALJIC Janez *	12
3. BORSTAR Dusan	16	7. OSOLNIK Renata	12
4. GOLMAJER ZIMA Marjanca	16	8. IVANCIC Bojan *	10

**SK – Slovak Republic**

Sent ballots: 34

Participation: 29 %

Received ballots: 10

**Candidates**

BAD'UROVA Katarina	3	MAJLINGOVA Marta	9	NEUSCHL Vladimir	5
CECHVALOVA Dagmar	7	MESKOVA Viera *	1	ZOVICOVA Viera +	4

**Allotment of seats**

Full Members		Substitute Members	
1. MAJLINGOVA Marta	9	5. MESKOVA Viera *	1
2. CECHVALOVA Dagmar	7	6. ZOVICOVA Viera +	4
3. NEUSCHL Vladimir	5		
4. BAD'UROVA Katarina	3		

**SM – San Marino**

Sent ballots: 23

Participation: 74 %

Received ballots: 17

**Candidates**

AGAZZANI Giampaolo	11	PETRAZ Davide Luigi	9
MARTINI Riccardo	5	PRIMICERI Maria Vittoria	3
MASCIOPINTO Gian Giuseppe	11	TIBURZI Andrea	8

**Allotment of seats**

Full Members		Substitute Members	
1. AGAZZANI Giampaolo	11	3. PETRAZ Davide Luigi	9
2. MASCIOPINTO Gian Giuseppe	11	4. TIBURZI Andrea	8

**TR – Turkey**

Sent ballots: 91

Participation: 32 %

Received ballots: 29

**Candidates**

ARKAN Selda Mine	22	FESLIGIL Ahmet Önder	7	YAVUZCAN Alev	21
ATALAY Baris +	15	KÖKSALDI A. Sertaç Murat	21		
ERKEKLI Ferit	9	MUTLU Aydin	14		

**Allotment of seats**

Full Members		Substitute Members	
1. ARKAN Selda Mine	22	5. ERKEKLI Ferit	9
2. KÖKSALDI A. Sertaç Murat	21	6. FESLIGIL Ahmet Önder	7
3. YAVUZCAN Alev	21	7. ATALAY Baris +	15
4. MUTLU Aydin	14		

# Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair; S. Wright (GB), Secretary

This report mainly summarizes the discussion that took place at the last yearly **epi** Biotech Committee Meeting held on 20 November 2013 in Munich.

## Patentability of Plants and Referrals to the EBA (G2/12 and G2/13)

A draft Amicus Curiae brief on the Broccoli II case (G2/13) prepared by an ad-hoc Committee of the Biotech Committee and discussed by said Committee on 19 November 2013 was further discussed by the whole Biotech Committee. *It should be noted that the amicus brief prepared by the Biotech Committee was approved by EPPC and effectively at EPO in time after the meeting. We thank Nicole Van der Laan (epi in-house lawyer) for her active help in this matter.*

In the Netherlands, in the *Taste of Nature -v- Cresco* case, the decision in preliminary proceedings has been reversed in the proceedings on the merits, and the Dutch first instance court is now in favour of patentability. The Dutch court confirmed that under Art. 53(b) EPC product claims directed to plant are to be patentable, even though the processes of producing them may be excluded from patentability. For a final (but appealable) first instance decision, the court still needs to decide on infringement and on an allegation of prior use.

Germany changed its national law earlier in 2013, to exclude products of biological processes. The German Government said that this was a "clarification", but it seems to have rather jumped the gun, especially in advance of the decision resulting from second referral to the EBA.

It was noted that the Netherlands and Germany have a relatively high number of plant variety applications before the CPVO (42.3% and 18.6%, respectively).

The Committee also discussed a letter from the EU Parliament to the Administrative Council of the EPO on 26 September 2013, urging the EPO not to grant product claims to plants where the process for making them is unpatentable.

Separately, the EU has decided who will be on the expert group, resulting from the EU Biotech Directive. Sisko Knuth-Lethola (FI) from the **epi** Biotech Committee and some other **epi** members have been noted to be on the expert group. The Biotech Committee will closely follow up the developments of this group.

## Stem Cells

The Opposition Division decision from the EPO in the Brüstle Case was noted to contain an error, as it says that **epi** supports the content of the submissions made by Greenpeace (and not George Schlich which it should

have been). The **epi** in the meanwhile wrote to the EPO to get this corrected.

## Sequence Listings

The EPO published a new notice from the President of 18 October 2013, detailing the change in policy on sequence listings starting 1 January 2014.

The EPO has also changed its Guidelines in September 2013 to refer to Decision J8/11 which suggests that sequence listings do not need to include prior art sequences.

BISSAP is the EPO's own software for preparing Sequence Listings (as an alternative to PatentIn). Our experience of it is poor, and it does not seem to work very well at the different offices who have tried it.

Unfortunately applicants still have to file sequence listings on divisional applications if the sequence listing is not part of the description. It is our opinion that if the EPO needs a sequence listing for the search they should be able to use the one filed on the parent case. It was also noted that it is a pity that it is still not possible to file sequence listings online on PCT cases that were filed online at the EPO.

**epi** members are encouraged to contact the EPO in order to get a copy of a prior filed sequence listing. This will allow us, for example, to compare it with another sequence.

We still want sequence alignments from Examiners when they are relying on a prior art sequence in a lack of novelty objection.

## US Decisions

The *Myriad* decision from the USA on the breast cancer gene is high profile and controversial. We wonder whether the patent was attacked because the US does not have a research exemption that is widely available in Europe.

*Prometheus* is also causing problems in the US, forcing applicants into getting only narrow claims (if you're lucky). The US PTO guidelines are currently written broadly, and are strictly enforced.

## Disunity

It had been agreed at last year's committee meeting that the committee (with help from the EPPC) should present a paper on this issue, possibly to be sent directly to the EPO after EPPC input (this was not done yet). Attorneys are still worried about providing to the EPO examples of cases where disunity has been handled poorly; there is concern that this might prejudice the approach taken

during examination of the cases. This issue should be put on the agenda for the "Examination Matters" seminar this year we think. We also think that Examiners want to reduce the subject matter that they need to examine, and are using disunity to try and achieve this. It is often unpredictable as to whether disunity arises, either because of the art, or by virtue of how the claims are written. It is also often very difficult to know how the Examiner is going to divide the subject matter, and thus how it will fragment.

### Added Matter – Article 123(2) EPC

Several cases were discussed. T972/04 (Oswald Board) suggests that you can not pick features from two lists. T1919/11 (also Oswald Board) suggests to draw a distinction between genus and species. In T583/09, there was a combination of 80 % homology with SEQ ID. NO. 69 in the same paragraph, but this was still found to add matter.

Other cases worth mentioning are T223/11 (also Oswald Board), and T783/09 from Board 334 (which gave a positive decision). Of course, the flip side to being generous with added matter is that there may be more novelty objections in the future and less scope for

selection inventions. It was remarked that the EPO is also becoming stricter on priority.

### Deposits and the Expert Solution

One of our members attended a workshop at Examination Matters 2013, meeting an Examiner that gets many of the deposit cases. The real problem is if the depositor is different from the applicant. The EPO takes a very strict line at this moment in such cases in our opinion.

### Nagoya protocol

The Nagoya protocol was briefly discussed regarding the requirement to indicate the country of origin of biological material. The Committee will follow the further developments of this matter and its importance for EPI practitioners.

Ann De Clercq & Simon Wright  
Chair & Secretary epi Biotech Committee

15 February 2013

## By-Laws Committee Report

P. Moutard (FR), Chair

### 1. Comments on epi-EPO Memorandum of Understanding

Further to the Prague Council meeting, the BLC was asked by the Presidium to prepare comments on a epi-EPO Memorandum of Understanding (MoU).

Detailed comments were prepared by the BLC and submitted to the Presidium on December 12, 2014.

### 2. Meetings to which the By-Laws committee participated

2 meetings took place on January 15 at the epi:

#### 2.1. BLC- PEC meeting

A first meeting was a joint BLC-PEC meeting in order to further discuss the possibilities of implementing CPE; Paolo Gerli, Günther Schmalz, Dieter Speiser and Pascal

Moutard (Chair) attended the meeting on behalf of the BLC.

#### 2.2. BLC- PEC- Presidium meeting

A second meeting was a joint BLC-PEC-Presidium meeting in order to discuss the various issues raised in the BLC comments on the MoU (see § 1 above).

Paolo Gerli, Günther Schmalz and Pascal Moutard (Chair) attended this 2<sup>nd</sup> meeting on behalf of the BLC.

### 3. Adaptation of the Collection of Decisions (CoD)

The work for adapting and updating the Collection of Decisions is going on, thanks to the help of the secretarial staff, in particular Ms Nicole van der Laan, Ms Vernessa Pröhl and Ms Sadia Liebig.

# Report of the EPPC

F. Leyder (BE), Chair

This report completed on 18.02.2014 covers the period since my previous report dated 04.11.2013.

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; in particular, thematic groups have been created in the fields of CII (computer-implemented inventions) and PAOC (pure and applied chemistry), and one is planned in industrial chemistry (polymers).

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

On 06.12.2014, **epi** submitted a non-paper on the relationship between European patents having unitary effect and European patents, indicating that it would appear just and proportionate, and in accordance with both UPR and EPC, for national measures to provide that where unitary effect is lost, in whole or in part, it would be open to the proprietor to validate the patent in any country to the extent that the unitary effect has been lost and the subject matter does not lack in novelty or inventive step in that country.

During its meeting of 10-11.12.2013, the Select Committee (of the Administrative Council of the EPOrg) has reviewed Rules 12-21 of the Draft Rules relating to unitary patent protection and proceeded to a second reading of Rules 1-11 as amended (second draft).

The Select Committee considered "Issues relating to the UPP system in the Member States".

A. Practical measures to ensure that a European patent does not take effect as a national patent where unitary effect is registered for that patent: these are mandatory under the Regulation.

B. Entry into the register for unitary patent protection of information relating to compulsory licences under European patents with unitary effect: what can be done at national level to ensure that the information will be sent to the EPO for inclusion in the Register of unitary patents?

C. National validation of a European patent where a request for unitary effect has been finally rejected: this possibility might influence the attractiveness of the unitary patent system.

D. National validation of a European patent where a prior right is invoked against a European patent having unitary effect: this was discussed as a possible fall-back position (in the absence of one in the Regulation).

Finally, the Select Committee discussed Draft Rules for the Compensation Scheme for translation costs and accepted the principle of observer status of non-participating EPC member states.

## 2. ESAB workshop on the unitary patent

The EPO's Economic and Scientific Advisory Board organised a workshop on the economic effects of the unitary patent and the UPC, on 03-04.12.2013. No report is available, see <http://www.epo.org/news-issues/news/2013/20131209.html>

It has also been announced that the ESAB has commissioned an independent study to identify, quantify and understand the individual drivers behind the behaviour of market players in applying for unitary patents.

## 3. SACEPO/WPR10

The 10<sup>th</sup> meeting of the Working Party on Rules was held on 11.02.2014. The agenda included the following main points:

- Possible amendment of Rule 126 EPC (notifications): allowing the EPO to use delivery service providers; increasing certainty for electronic notifications (including maintaining the ten-day rule); electronic authentication of minutes (Rule 124(3) EPC).
- Rule 71(3) EPC: introduction of the possibility of a "waiver".
- Address for correspondence: allowing an address for correspondence to be used in the proceedings before the EPO for all applicants acting without a professional representative (presently only allowed for legal persons).
- Certainty from Search (new priority model in DG1): see the EPO President's blog of 18.02.2014.
- Hand-written amendments: it was clarified that the possibility of filing hand-written amendments during oral proceedings remains.

## 4. 2014 revision of the Guidelines

**epi** members are kindly reminded that suggestions for amendment of the 2013 Guidelines are welcome at any time ([eppc@patentepi.com](mailto:eppc@patentepi.com)).

## 5. European Patent Academy Symposium on Article 123(2)

The EPO organised a symposium on 07.02.2014 and invited several users organizations to send delegates. G. Leissler-Gerstl, J-R. Callon de Lamarck, M. Honkasalo, R. Jorritsma and H. Vogelsang-Wenke were the 5 delegates proposed by **epi** and invited to the symposium.

The EPO is aware of concerns about different interpretations in different countries resulting from different philosophies. Having noted concerns amongst the user community that the EPO approach had become too photographic, they wanted to identify possible problems and possible solutions. Breakout sessions in the afternoon included cases identified by the EPO and the users.

G. Leissler-Gerstl made a presentation emphasizing the need for a fair balance between applicants and third parties, and what undesirable consequences a very strict approach has to the applicant. She mentioned a perceived inconsistency between different technical areas, and discussed some issues specific to chemists.

## 6. 7<sup>th</sup> PCT WG

The PCT Working Group discusses future development of the PCT system and proposed changes to the PCT procedural and legal framework. It will meet in Geneva on 10-13 June 2014. No working documents had been received when finalising this report.

# First Meeting of Representatives of the Disciplinary Board of Appeal the Disciplinary Board and the Disciplinary Committee

P. Rosenich (LI), Chair, V. Pröll (DE), Registrar

On invitation of the Chair of the Disciplinary Committee, Paul Rosenich, a meeting took place at the **epi** on October 9, 2013. The participants were the Registrar, Mr P. Martorana, and Deputy-Registrars, Ms G. Rauh and Ms E. Görgmaier of the Disciplinary Board of Appeal, the Chair of the Disciplinary Board, Mr H.-C. Haugg, as well as with the Chair, Mr P. Rosenich, and Vice-Chair, Mr W. Fröhling, of the Disciplinary Committee together with their Registrar, Ms Vernessa Pröll and Deputy-Registrar, Ms Michele Voth and the Legal Advisor, Ms Nicole van der Laan. The main target was to achieve more transparency concerning the functioning working process and to increase the cooperation among the disciplinary bodies.

It was the first time since the foundation of the **epi** and EPO that those bodies met for an exchange.

The following items on the agenda were discussed:

- Organization and working method of the disciplinary bodies
- Forwarding of the decisions
- Publication of the decisions
- File keeping
- Forwarding of the file
- Disciplinary measures
- Immunity
- Revision of the Rules of Procedure
- Revision of the Code of Conduct
- Legal basis of the Code of Conduct

The meeting started with a presentation of the Chair of the Disciplinary Committee, Paul Rosenich. He presented the tasks of the committee and the different levels of treatments referring to disciplinary cases. Various examples were shown to give an idea of the work. A short overview about typical case problems was given as well as about the cooperation of the Disciplinary Committee with other bodies.

It was indicated that the Disciplinary Committee serves as a filter. After collecting all relevant data, the Committee can identify the received complaints. The Committee also has a so called "memory". It case that the complainant or defendant was already involved in a previous DC-case, the Chamber of the new case will be informed.

The other bodies reported about their proceedings in the different matters. Possibilities of improvement were discussed.

The upcoming UPC and the participation of European Patent Attorneys in its proceedings were discussed in view of disciplinary questions.

After having reviewed the situation, the participants agreed that it was a very fruitful meeting and the proposal was given to set up such a meeting once a year.

Initiated by the results of the meeting, the Chair of the Disciplinary Committee, will have a meeting with the Chair of the Professional Conduct Committee, Mr Tim Powell, after the Council Meeting on April 30, 2014 in order to discuss further strategies.

## Report of the Harmonization Committee

F. Leyder (BE), Secretary

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

### **20<sup>th</sup> Session of the SCP (27 to 31 January 2014)**

Our Institute had decided not to send a delegate to this meeting of the Standing Committee on the Law of Patents. The Summary by the Chair and all working papers are available on the WIPO website (the Draft

Report will follow): [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=30925](http://www.wipo.int/meetings/en/details.jsp?meeting_id=30925)

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

The 21<sup>st</sup> session would tentatively be held from 3 to 7 November 2014.

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

## Forthcoming **epi** educational events:

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

12-13 May 2014 – Istanbul (TR) –  
“Pre-Drafting and Drafting of Applications”

9 September 2014 – Barcelona (ES) –  
“Opposition and Appeal”

### Scheduled **epi**/EPO webinars

Further information on the Guidelines2DAY webinars, as published in the **epi** Information 4/2013, is available at

the “Education and Training” section of the **epi** website [www.patentepi.com](http://www.patentepi.com).

PEC, together with the European Patent Practice Committee and the Litigation Committee, is about to set up webinars to give general information on the Unitary Patent system and the Unified Patent Court.

We intend to set up these webinars in the second quarter of 2014.

For further information please consult the “Education and Training” section of the **epi** website [www.patentepi.com](http://www.patentepi.com).

## Candidate Support Project (CSP)

M. Teodorescu (RO), **epi** Vice-President and M. Fromm (DE), **epi** Education Section

The Candidate Support Project has been set up by the European Patent Office (EPO) under the “Co-operation Roadmap”. Apart from the national patent offices, Centre d’Études Internationales de la Propriété Intellectuelle (CEIPI) and **epi** support this project.

The project assists candidates from countries with less than five EQE-qualified European patent attorneys to prepare for and pass the European qualifying examination (EQE). The project will run for the duration of the Co-operation Roadmap (2012-2015; exam years 2013-2017)

Candidates receive an exhaustive set of training materials, as well as having access to the EPO’s e-learning courses. Additionally they get personal support from **epi** coaches, who stay in close contact throughout the programme. The coaches motivate the candidates, for example by monitoring their learning, assigning, marking and discussing homework, being available to answer the candidate’s questions.

The course consists of three to four 1-2-1 sessions, where candidates receive training, sit mock examination and meet their coaches. The rest of the time they contact their coaches digitally.

Currently there are two courses running in parallel: the 2012 class and the 2013 class.

The 2012 class comprises 16 candidates and 6 coaches. All of the candidates passed the pre-examination in 2013 and sat papers A+B+D in 2014.

The 2013 class comprises 23 candidates and 6 coaches and all of the candidates have sat the 2014 pre-examination.

Candidates from 23 EPC countries have access to this programme and may apply, if they meet certain conditions. These countries are: Albania, Bulgaria, Croatia, Cyprus, Czech Republic, Estonia, FYR of Macedonia, Greece, Hungary, Iceland, Latvia, Lithuania, Malta, Monaco, Norway, Poland, Portugal, Romania, San Marina, Serbia, Slovak Republic, Slovenia and Turkey.

Candidates who wish to apply are asked to send a CSP application form and a motivation letter to their national patent office (NPO).

The NPOs, together with a national **epi** member, will filter applications and will forward those selected to the EPO which will make a final selection.

Applicants should also ensure that they have registered for the EQE Pre-examination 2015 by the deadline (usually in May). Otherwise their application for the CSP cannot be taken into account.

The application deadline for the CSP 2014 has not yet been fixed, but it will be publicised on the EPO and NPO websites.

All in all, the CSP provides a comprehensive preparation programme for EQE candidates, and we encourage all candidates from the 23 countries to apply, and benefit from this unique opportunity.

Further information can be found on the website of the European Patent Academy:

<http://www.eqe-online.org/CSP/>

You are also very welcome to direct any question to the **epi** Education Team at [education@patentepi.com](mailto:education@patentepi.com)

## News from **epi**'s "Education and Training" Section

M. Fromm (DE), **epi** Education Section

A new beginning goes always hand in hand with a farewell. The successful year 2013 is over and before we are able properly to say "adieu", we are busy welcoming 2014 and heading steadily towards its second quarter.

2014 is an **epi** election year. So, we have to say good-bye to some of the **epi** members who contributed so much to the profession, and to welcome new volunteers, willing to commit themselves to the profession for the next three years.

In the Education Section we are looking forward to a partly new Professional Education Committee (PEC). Some PEC members have decided to leave the committee and to turn to new challenges. In particular, two highly experienced "old hands" are taking well-deserved "retirement" from PEC, namely Ms Susanne Kaminski (LI) and Mr Freek Smit (NL). We will sorely miss their expertise and their advice.

On behalf of the PEC chair, Mr Paolo Rambelli, we thank all PEC members for their commitment over the past term. We are looking forward to meeting the new committee members and we wish all the members leaving PEC the best for the future. We prefer to say "see you" rather than "good-bye"!

PEC also welcomes new digital means for providing education across Europe. As already mentioned in the last issue of the **epi** Information, we are planning to organise "Guidelines2DAY" webinars, as a follow-up to the successful "Guidelines2DAY" seminars in April/May 2014.

Furthermore, PEC, in co-operation with the European Patent Practice Committee (EPPC) and the Litigation Committee (LitCom), is about to set up general information webinars on the Unitary Patent system and the Unified Patent Court.

Both courses are also addressed under "Forthcoming events" in this issue of the **epi** Information.

Turning to this new medium does not mean we are leaving aside the "classic" seminars.

We have introduced a new seminar on "Opposition and Appeal" (see separate article in this **epi** Information). As also mentioned under "Forthcoming

events", the next "Opposition and Appeal" seminar is in Barcelona, on September 9, 2014.

Moreover we continued with our "Life of a patent" series of seminars in Bucharest. After the **epi**/EPO "Pre-drafting" and the "Drafting of Applications" seminars in 2013, we organised a "Prosecution" seminar at the beginning of March 2014. This will lead us to the last seminar in this series, scheduled for the second half of 2014, on "Opposition". Once we have finished the series in Bucharest, we start the series over again in Istanbul.

We have scheduled our first Istanbul "Pre-drafting and Drafting of Applications" seminar on May 12-13, 2014. Based on the successful seminars in the previous years and the famous Turkish hospitality we look forward to the opportunity of holding the seminar there.

It is with much pleasure that we continue close co-operation with the European Patent Academy (EP Academy) in other areas as well as the seminars.

Our successful "Pre-exam online course" finished at the end of January 2014 with an all-time high number of participants: 228! The course will re-open in summer 2014, for the 2015 pre-examination preparation.

We will further strengthen our co-operation by supporting one of the highly rated EPO events, Examination Matters 2014. Some of the workshops may be presented jointly by **epi** and EPO speakers, to provide a practical approach to addressing some of the issues facing **epi** members. We welcome this opportunity to co-operate further with the Academy.

*Every new beginning comes from some other beginning's end. Seneca*

Check out the "Education and Training" section of the **epi** website [www.patentepi.com](http://www.patentepi.com) for further information about our events.

If you have further questions/feedback on education related matters or our educational events, please contact us:

PEC: [pec@patentepi.com](mailto:pec@patentepi.com)

Education Team: [education@patentepi.com](mailto:education@patentepi.com)

## Information about **epi** student membership

**epi** focussing on the future of the profession not only involves training its members, but also supporting EQE candidates in preparing for the European qualifying examination (EQE).

For many years we have provided assistance by organising EQE preparation courses, like our tutorials and Mock EQEs, as well as by offering the **epi** student membership.

There are lots of good reasons to become an **epi** student member!

The benefits include email alerts about our training courses, priority access to our educational events, receiving your own copy of the "European qualifying examination – Guide for preparation" publication, receiving our quarterly magazine "**epi** Information", and a 50% reduction on course fees for **epi** educational events, such as tutorials, Mock EQEs and seminars.

### Application:

All EQE candidates may become an **epi** student.

Candidates may apply, at any stage of their training, to the **epi** Education Team, simply filling in the online application form.

EQE candidates must give the name of their sponsor, i. e. the person responsible for their professional training. As soon as the sponsor confirms the applicant's information, the Education Team will issue an invoice for the student fee (EUR 80) and, once that is paid, the **epi** student membership becomes effective.

### Terms

The first application provides student membership for the following three years. After that, the student may renew membership annually. The Education Team will send an email reminder at the beginning of each year.

The **epi** student membership expires automatically once the student passes all parts of the EQE or discontinues student membership.

Additional information, including the Rules governing **epi** student membership, and the application forms are available on our website: [www.patentepi.com](http://www.patentepi.com) under "Education and Training".

For further questions you may contact the Education Team at [education@patentepi.com](mailto:education@patentepi.com). We are very happy to help.

## **epi**/EPO „Opposition and Appeal“ seminars

M. Fromm (DE), **epi** Education Section

According to our motto "*We make high-quality and relevant education available to all **epi** members at a reasonable price*" **epi** is constantly looking to offer new and interesting seminars to our members.

The Professional Education Committee (PEC), in cooperation with the European Patent Office (EPO), was delighted to announce a new seminar on "Opposition and Appeal".

The topic alone would have attracted already a lot of members, but this it proved even more popular when we announced the names of the speakers.

We were very pleased to have two very experienced speakers to present this topic, and to share their immense knowledge in this field: Mr Marcus Müller, a member of the Boards of Appeal of the EPO, and Mr Cees Mulder, European patent attorney.

Both guided the participants through the various aspects of proceedings, including the landmark decisions

of the Boards of Appeal and the Enlarged Board of Appeal, which every patent attorney should know during opposition and appeal proceedings. The speakers also highlighted important tactical and strategic aspects.

This approach, contrasting the EPO's point of view with that of an **epi** speaker has already proven to be the right formulae in previous seminars. It was not surprising that the audience particularly appreciated this feature of the seminar. It not only makes the lectures more interesting, but the open discussion between EPO and **epi** also add more value to the presentations.

The seminar is not only valuable for members with significant experience of opposition and appeal procedures, but also for patent attorneys who want to refresh or deepen their knowledge.

We have already held two of these events, with an overwhelming response. Our seminar in Milan (December 2013) was fully booked, but our seminar in

London (February 2014) exceeded our expectations. After two weeks, and during the holiday season (!) we had to close registration, as we were already fully booked, and unfortunately 20 enrolled people could not attend.

Currently PEC is in contact with the EPO to see whether a second seminar can be organised in London in the end of 2014 or the beginning of 2015.

The next scheduled event will be the seminar in Barcelona on September 9, 2014.

We thank Mr Marcus Müller and Mr Cees Mulder for sharing their expertise with us, the EPO for supporting this event and the participants for making the seminars so successful.

We will keep all our members informed on further scheduled seminars, in the "Education and Training" section of our website [www.patentepi.com](http://www.patentepi.com).

We remind our members that, among other duties, PEC members are responsible for setting up national seminars. All **epi** members should get in touch with their respective PEC member if they would like to have a seminar organised in their city/country. To contact your PEC member, please log onto our website, and the email addresses of the PEC members will be visible. Please note that the email addresses on our website may not be used for any other purpose than communication on educational/PEC matters.

## epi summer and autumn tutorial 2014

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

The schedule is as follows:

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

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

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

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

4. In a second round discussions are scheduled for papers A/B and C/D respectively. The papers are discussed in general, particular problems are addressed, individual solutions commented on and questions answered. The format is flexible: it is up to the tutor and the particular group candidates to decide upon a commonly agreeable form for the tutoring session. In case it is decided that a meeting should be held with all candidates, time and place is to be agreed upon by the tutor and the candidates. The candidates provide in this

case their own travel expenses as well as the travel expenses of their tutor. Alternatively a telephone conference could be arranged, but as indicated it is up to the tutor/candidates to agree upon a suitable format.

5. Exam papers to be discussed

Summer tutorial: 2010, 2011, 2012, 2013

Autumn tutorial: 2010, 2011, 2012, 2013, 2014

6. Schedule

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

Summer tutorial:

Deadline for registration: May 23, 2014

Papers to be returned: June 20, 2014

Feedback to be given until: September 5, 2014

Autumn tutorial:

Deadline for registration: September 15, 2014

Papers to be returned: October 20, 2014

Feedback to be given until: December 15, 2014

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

For further information/enrolment form please visit our website ([www.patentepi.com](http://www.patentepi.com) → Education and Training) or contact the **epi** Secretariat at:

[education@patentepi.com](mailto:education@patentepi.com).

**VESPA**

Verband der freiberuflichen  
Europäischen und Schweizer Patentanwälte

**VIPS**

Verband der Industriepatentanwälte  
in der Schweiz

organisieren auch in diesem Jahr ein

## PRÜFUNGSTRAINING FÜR DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 2015

- Der Kurs versteht sich als letzte Etappe vor der Eignungsprüfung und als Ergänzung zu den eigentlichen Ausbildungskursen.
- Die Lehrfunktion des Kurses beschränkt sich demgemäss auf das Durcharbeiten konkret gestellter Prüfungsaufgaben der Teile A bis D und die Instruktion der Prüfungstechnik und -strategie durch erfahrene Europäische Patentanwälte.
- Die Aufgaben können nach Wunsch auf deutsch, englisch oder französisch bearbeitet werden, Modul 2 wird auf deutsch durchgeführt.
- Die Bewertung erfolgt vertraulich anhand der bei der Eignungsprüfung angewandten Kriterien. Eine schriftliche Korrektur wird abgegeben, Fragen an die Tutoren sind möglich.
- Der Kurs ist aus drei zeitlich getrennten Modulen aufgebaut (Module 1 und 3, jeweils einschliesslich Modul 2, können auch einzeln belegt werden) und umfasst je die Teile A bis D der Europäischen Eignungsprüfung.
- Teilprüfungskandidaten können auch einzelne Teile (A, B, C oder D) belegen, wobei die Kursgebühr entsprechend reduziert wird.
- An den Modulen 2 und 3 können auch Resitter teilnehmen (auch an einzelnen Teilen), deren nicht bestandene Prüfungsarbeiten (2014) wir schriftlich kommentieren.

Aufteilung des Kurses:

**Modul 1** (ab Juni 2014)

Die Kandidaten erarbeiten zu Hause schriftlich Lösungen zu den Prüfungsaufgaben des Jahres 2013. Die eingegangenen Arbeiten werden schriftlich korrigiert, bewertet und den Kandidaten wieder zugestellt, die Kandidaten können nach Erhalt der Korrekturen den Tutoren Fragen stellen und an Modul 2 teilnehmen.

**Anmeldeschluss Modul 1 (und 2): 01.06.2014**

**Modul 2** (September 2014)

Vorstellen von Prüfungstechnik und -strategien für die einzelnen Teile. Ausführliche Besprechung der Fragen zu Prüfungsaufgaben 2013 und, wo erwünscht, Fehleranalyse der Kandidatenarbeiten.

**Modul 3** (Anfang November 2014)

Die Kandidaten können zur Vorbereitung an Modul 2 teilnehmen. Modul 3 umfasst die Durchführung einer simulierten, dreitägigen Prüfung mit den Prüfungsaufgaben von 2014. Die an Modul 2 erarbeitete Strategie kann gezielt in Modul 3 geübt werden. Die Lösungen der Kandidaten werden korrigiert, bewertet und den Kandidaten zugestellt. Die Kandidaten können nach Erhalt der Bewertung zu ihren Aufgaben den Tutoren Fragen stellen.

**Anmeldeschluss Modul 3 (und 2): 01.09.2014**

- **Kursgebühr Modul 1 (inkl. Modul 2 für alle Teile A-D):** CHF 600.-
- **Kursgebühr Modul 3 (inkl. Modul 2 für alle Teile A-D):** CHF 600.-
- **Kursgebühr alle Module (1, 2 und 3 für alle Teile A-D):** CHF 1050.-
- **Beim Belegen einzelner Teile wird die Gebühr entsprechend reduziert**

**Auskunft / Anmeldung:**

Regula B. Müller, Müller Steuer & Rechtspraxis AG, Genferstrasse 33, CH-8002 Zürich  
Tel.: +41(0)44 206 16 60; Fax: +41(0)44 206 16 61; E-Mail: [regula.mueller@mueller-praxis.ch](mailto:regula.mueller@mueller-praxis.ch)

## Contact Data of Legal Division

Update of the European Patent Attorneys database

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

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

Thank you for your cooperation.

European Patent Office

Dir. 5.2.3

Legal Division

80298 Munich / Germany

Tel.: +49 (0)89 2399-5231

Fax: +49 (0)89 2399-5148

legaldivision@epo.org

www.epo.org

### **So erreichen Sie die Anzeigenabteilung:**

Wolters Kluwer Deutschland GmbH

Luxemburger Str. 449, 50939 Köln

Tel.: 02 21 / 9 43 73-77 97

Fax: 02 21 / 9 43 73-1 77 97

E-Mail: [anzeigen@wolterskluwer.de](mailto:anzeigen@wolterskluwer.de)

**Anzeigenschluss für Heft 2/2014 ist der  
15. Mai 2014**

## Next Board and Council Meetings

### Board Meetings

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

### Council Meetings

76<sup>th</sup> Council meeting on April 28/29, 2014 in Munich (DE)

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

### Nächste Ausgaben · Forthcoming issues · Prochaines éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
2/2014	May 9, 2014	June 30, 2014
3/2014	August 8, 2014	September 30, 2014
4/2014	November 6, 2014	December 31, 2014

## Poisonous National Priority Application for the Unitary Patent

P. Rambelli (IT)

The title of this article was inspired by the paper "Poisonous EPC Divisionals" by M. Lawrence and M. Wilkinson, published in **epi** Information 2/2011.

The quoted paper addresses the issue that a European patent application and its divisional(s) may be mutually conflicting, under Art. 54(3) EPC, in the non-infrequent case that the subject-matter claimed by the European application is not entitled to the claimed priority/priorities, according to the principles of G2/98, whereas a specific embodiment in the divisional application is entitled to the claimed priority.

Under such circumstances, the authors postulate the conclusion that the divisional application would be a novelty destroying prior right under Art. 54(3) EPC.

It is here postulated that, under the same circumstances and principles, the priority document from a state participating to the UPC Agreement and to the Unitary Patent Regulation may be poisonous to a European patent having acquired the unitary effect and claiming priority there from.

At the time when the quoted paper was published, the authors' conclusion was not supported by case law by the EPO Boards of Appeal, but it is now explicitly supported by T1496/11 of 12.09.2012.

In T1496/11, claim 1 of the main request was considered to constitute an intermediate generalization with respect of the disclosure of the priority document, since the claim omitted a feature disclosed by the allegedly supporting embodiment of the priority document.

Accordingly, the subject-matter of the claim was considered not to constitute the same invention as that set out in the priority document whereby the claim was only entitled to the filing date.

The divisional application of the patent in suit disclosed an embodiment, identical to that provided in the priority document, which therefore was entitled to the claimed priority date, whereby claim 1 was held to lack novelty with respect to the divisional application under Art. 54(3) EPC.

It is worth to note that the decision does not consider the issue relating to the possible entitlement to multiple priorities in the claim of the patent in suit; however, the decision appears to be based on G2/98, paragraph 6.7 of the reasons for the opinion, according to which "the use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Art. 88(2), second sentence, EPC is perfectly acceptable under Art. 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly identified alternative subject matters" and on the interpretation given to the quoted sentence by several subsequent decisions such as particularly T1877/08 of 23 February

2010, T476/09 of 21 September 2012, T1443/05 of 4 July 2008 and T1127/00 of 16 December 2003.

T1496/11 was recently heavily criticized by R. Teschenmacher in Bardehle Pagenberg IP Report 2013/IV. The author finds a basis for his criticism in T1222/11 of 04.12.2012, which provides a detailed analysis of the multiple priority issue to conclude that, according to G2/98, "when an application on the basis of which a priority date is claimed encompasses a narrower subject-matter already disclosed by the same Applicant in an earlier application, the decision on whether the claim to priority on the basis of the later application is valid does not depend on whether the narrower subject-matter disclosed in the earlier application is identified in said later application". It follows that the embodiment, constituting the narrower subject-matter, would not be novelty destroying if the claimed subject-matter was generalized in the later application claiming priority.

Indeed, T1222/11 appears to open the way to a different interpretation of G2/98, conflicting with T1877/08, which would constitute an antidote to the poisonous effect of a divisional application. However, since the argument on multiple priorities is set forth therein as an obiter dictum, at present there is no situation of conflicting decisions by the Boards of Appeal on the multiple priority issue, which may lead to an early referral to the Enlarged Board of Appeal.

According to the case law of the EPO Boards of Appeal, also a priority document consisting of a European patent application can have a novelty destroying effect on a further European application which claims priority there from, if the entitlement to priority is lost due to a limitation or to a generalisation which is not supported by the priority document, cf. Case Law of the Boards of Appeal of the European Patent Office, 7th Edition, September 2013, II.D.2. paragraph 2.1.7, quoting T1443/05 and T0680/08.

In T1443/05 of 04.07.2008, the independent claim was amended to include a disclaimer which could not be considered as unambiguously disclosed in the previous European patent application from which priority had been claimed. Due to loss of the priority right, the examples included in the previous application were considered to be novelty destroying under Art. 54(3) EPC.

In T0680/08 of 15.04.2010, the claim of the patent under opposition recited a numerical range for a given parameter which was slightly narrower than the numerical range disclosed in the priority document. The Board reached the conclusion that the subjectmatter of the claim concerned the "same invention" as that disclosed in the priority document, however with the exception of the explicit reference to the particular lower limit of the range claimed for said parameter. The claim was con-

sidered not to be entitled to priority with reference to the lower limit of the numerical range and the subject-matter of the claim was considered not to be novel under Art. 54(3) EPC with respect to the later published European patent application corresponding to the priority document which disclosed the broader range.

Since national prior rights from EPC contracting states do not constitute prior art under Art. 54(3) EPC, clearly there is no decision by the EPO Boards of Appeal dealing with the parallel situation where the priority document of the European patent application is a national patent application from a contracting state. However, under national patent law and in view of Art. 139(2) EPC, a national prior right from an EPC contracting state is applicable on the ground of novelty against the corresponding national fraction of a European patent or patent application. Although this matter, at present, is to be decided by the national courts of the contracting states, a priority document from an EPC contracting state could well be considered as novelty-destroying with respect to the national fraction of a European patent under the same principle, *mutatis mutandis*, of the above-quoted decisions T0680/08 and T1443/05.

The fact that national courts may follow the EPO case law on the multiple priority issue is already supported by the decision of the English Patent Court in *re Nestec SA versus Dualit Ltd* (2013), although only with reference to the case where the priority document was a European patent application.

The above-mentioned situation, which in any case might be prejudicial only for the relevant national fraction of the European patent, could be cured, if spotted by the Applicant during examination, by filing with the European Patent Office a different set of claims for the contracting state from which the priority document originates; alternatively, if such a situation is spotted after grant, it may be envisaged to resort to national limitation proceedings, if available in that contracting state, or to the centralised limitation under Art. 105a EPC with a set of claims for that contracting state only.

But what will happen in the case of a European patent having acquired unitary effect under the Unitary Patent Regulation? It has been pointed out that a prior right in one EPC contracting state participating to the UPC Agreement and Unitary Patent Regulation could invalidate the unitary patent in its entirety, in view of Art. 65 of the Unified Patent Court Agreement according to which: "The Court may revoke a patent, either entirely or partly, only on the grounds referred to in Art. 138(1) and 139(2) of the EPC". Indeed, the reference to Art. 139(2) EPC has the effect of making national prior rights as applicable

prior art on the ground of novelty against a unitary patent in its entirety.

Since in view of Art. 3 of the Unitary Patent Regulation, the European patent with unitary effect must have the same set of claims in respect of all the participating member states, neither the centralised limitation procedure under Art. 105a EPC limited to one country, nor a national limitation procedure would be available as a possible remedy. More precisely, a limiting amendment by means of the centralised limitation procedure would, in principle, be available, if supported, to possibly reinstate novelty, but only for all states participating to the unitary patent, leading to an undesirable limitation of the extent of protection, which would have been unnecessary for the European patent.

The case of a national prior right, emerging after grant of the European patent having acquired the unitary effect may, perhaps, not be very frequent. However, in view of the relevant backlog of the EPO, the number of pending European patent applications claiming priority from a national application from a participating state, but not fully entitled to that priority, is likely to be non-negligible.

Thus, the question arises as to whether the applicants for a European patent are aware that, according to the present EPO case law relating to multiple priorities, and if such a case law is applied, by way of analogy, also to the priority document from a participating state to a European Patent Regulation having acquired unitary effect, there is a real danger that the unitary patent may need to be limited in its entirety or may even be held invalid, in case that the claims of the unitary patent are not entitled to the claimed priority.

It appears therefore that, in all cases where the subject-matter of a European patent application was amended with respect to the subject-matter of the priority document from a state participating to the Unitary Patent Regulation, particular care should be applied prior to requesting the unitary effect. The withdrawal of the national priority application, in order to prevent its publication, could of course constitute a suitable remedy but such a remedy is clearly not available anymore, at present, with reference to the surely high number of European patent applications filed many years ago and still pending before the EPO and for which the unitary effect will be available in the near future.

Needless to say that the most relevant remedy could be offered by a revision by the EPO Boards of Appeal or by the Enlarged Board of Appeal of the present case law relating to multiple priorities.

## The right to be heard before the EPO Boards of Appeal – overruled by formal regulations?

Dr. H. Wegner (DE), P. K. Hess (DE)

*In its recent decision R 1/13 of 17 June 2013, the Enlarged Board of Appeal rejected the petition for review as clearly unallowable in a case where a Board of Appeal had raised clarity objections for the first time in the course of oral proceedings, and the petitioner had filed new auxiliary requests with a view to reply to these objections. The new requests, though clearly responding to the late objections, were however not admitted by the Board. The Enlarged Board found that there was no right of admissibility for requests filed to overcome late-raised objections and that Article 113(1) EPC did not overrule Article 13(1) RPBA in the case of such requests. Rather, the right to be heard was already safeguarded under these circumstances if the petitioner was afforded an opportunity to comment on the issue of admissibility. This leads to the question whether the right to be heard might undergo a fundamental loss of substance before the Boards of Appeal.*

### 1. The right to be heard as enshrined in the relevant provisions

The right to be heard is enshrined in Article 113(1) EPC stipulating that the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The importance of this principle of procedural law is conclusively expressed in Article 112a(2)(c) EPC giving the parties the right to file a petition for review by the Enlarged Board of Appeal on the ground that a fundamental violation of Article 113 occurred. According to the preparatory work to EPC 2000 where Article 112a was introduced for the first time, the explicit mentioning of a fundamental violation of Article 113 in the revised Convention itself was adopted by the Diplomatic Conference on request of the French and German delegations and the Secretariat<sup>1</sup>, thus underlining the significance of procedural violations in this respect.

Furthermore, the Rules of Procedure of the Boards of Appeal (RPBA) of the EPO provide that the Board may decide the case at any time after filing the statement of grounds of appeal and the written reply of the respondent “subject to Articles 113 and 116 EPC” (Article 12(3) RPBA) and that the Rules of Procedure are binding upon the Boards of Appeal on condition that “they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention” (Article 23 RPBA). As to Article 13 RPBA, the preparatory documents

explain that it makes the admissibility of any amendment to a party’s case as filed (“whether relating to facts, evidence, arguments or requests”) after the cut-off point defined by Articles 12(1) and 13(1) RPBA a matter for the Board’s discretion, but gives the Board a specific authority to refuse the amendment *inter alia* on the grounds of complexity of the new subject matter submitted, of the current state of proceedings and the need for procedural economy. In particular, amendments should not be admitted if they would lead to adjournments of oral proceedings.

The intended overall effect of these regulations was “to prevent ‘ping pong’ submissions and ‘salami’ tactics in written proceedings and to provide the Board (and the rapporteur in particular) with an appeal file containing one comprehensive submission from each party”<sup>2</sup>.

### 2. The right to be heard as construed by established case law of the Boards of Appeal

According to the case law of the Boards of Appeal, the right to be heard under Article 113(1) EPC is an elementary principle of the proceedings before the EPO and of fundamental importance for ensuring a fair procedure between the EPO and a party to proceedings before it. If a Board of Appeal identifies a violation of the right to be heard, the consequences may be a remittal of the case to the department of first instance and/or the reimbursement of the appeal fee<sup>3</sup>.

In a case where an Opposition Division or a Board of Appeal feels bound by Article 114(1) EPC to examine new facts or evidence, it must, in accordance with Article 113(1) EPC, give the parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence<sup>4</sup>. As regards new arguments, the requirements of Article 113(1) EPC have been satisfied even if a party did not have the opportunity to comment on them during oral proceedings, insofar as such new arguments do not change the grounds on which the decision is based<sup>5</sup>.

If the parties can be said to have been surprised, from an objective point of view, by the decision and the grounds and evidence on which it is based, then an opportunity to present their comments cannot have been sufficiently granted. In other words, “the term ‘opportunity’ in this article can only be given effective meaning by applying the principle of good faith and the right to a fair hearing”<sup>6</sup>.

<sup>2</sup> T 1621/09, Reasons No. 27f

<sup>3</sup> Case Law of the Boards of Appeal, 7<sup>th</sup> edition, September 2013, III.B.1.

<sup>4</sup> G 4/92, OJ EPO 1994, 149; Reasons No. 8

<sup>5</sup> Loc.cit., Reasons No. 10

<sup>6</sup> T 892/92, OJ EPO 1994, 664; Reasons No. 2.1

<sup>1</sup> EPO Diplomatic Conference documents MR/8/00 and MR/21/00 (<http://www.epo.org/law-practice/legal-texts/archive/documentation/travaux-preparatoires/dc-documents.html>)

### 3. The role of the right to be heard in petitions for review by the Enlarged Board of Appeal

Pursuant to Article 112a(2) EPC, a petition may only be filed on the grounds that

(a) an excluded member of the Board of Appeal took part in the decision,

(b) the Board of Appeal included a person not appointed as a member of the Boards of Appeal,

(c) a fundamental violation of Article 113 occurred, (d) any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings; or

(e) a criminal act may have had an impact on the decision.

Rule 104 EPC exemplifies Article 112a(2)(d) by mentioning

(a) a failure to arrange for the holding of oral proceedings requested by the petitioner, or

(b) a decision on the appeal without deciding on a request relevant to that decision.

In practice, the grounds listed in Article 112a(2) and Rule 104 EPC are, however, of very unequal importance. *De facto*, it has turned out that the ground of Article 112a(2)(c) EPC, i.e. a fundamental violation of the right to be heard, is the most important ground and by far predominant in review cases. An analysis shows that the vast majority of petitions filed down to the present day are based on this ground. For instance, of the 19 petitions filed in 2012, all but one at least *inter alia* refer to Article 112a(2)(c) EPC. Similarly, all the 20 petitions filed to date in 2013 claim a violation of the right to be heard<sup>7</sup>.

It is thus evident that the review proceedings under Article 112a EPC have become a major, or even the most important, instance for the Enlarged Board of Appeal to construe the right to be heard, the Enlarged Board's interpretation of this fundamental principle having direct implications for all EPO proceedings. This fact is in some contrast with the intentions expressed in the preparatory work for introducing this Article<sup>8</sup>.

### 4. The Enlarged Board's original approach to the review issue

In its decision G 1/97 "Request with a view to revision/ETA" underlying the introduction of new Article 112a into EPC 2000<sup>9</sup>, the Enlarged Board emphasized "that while, on the one hand, legal certainty and the principle that all litigation must end within a reasonable interval

are essential elements in any jurisdictional system, a flagrant violation of a fundamental procedural principle is inimical, on the other hand, to the very idea of justice and does serious harm to the image of the judicial bodies concerned. This would be the case, for example, if it transpired that a decision had been crucially influenced by an illicit or even criminal act such as forging documents or giving false oral evidence"<sup>10</sup>.

Hence, it appears that the necessity of reviewing a decision by a Board of Appeal was originally considered to be very exceptional, if arising at all. Only the "exotic" case of illicit or criminal acts was explicitly referred to, which has little importance in practice. One might therefore conclude that according to the Enlarged Board's original expectations, the number of successful petitions should be very low and in particular should not originate from a Board's own behavior.

If this conviction prevailed, very strict standards might be applied wittingly or unwittingly to keep such number low, irrespective on which ground a petition is based. This would, of course, also affect the most common ground for review, i.e. a violation of the right to be heard, the legal principle itself thus undergoing a gradual process of loss of substance in the light of the Enlarged Board's case law on petitions.

### 5. A recent example: case R 1/13<sup>11</sup>

5.1 In case T 808/11-3.5.03, the patent proprietor had filed an appeal against the decision of the opposition division to maintain the patent in amended form. In the course of oral proceedings before the Board, the Board did not allow the proprietor's main and first auxiliary requests and, when considering the proprietor's second auxiliary request, raised a clarity objection against a term that was already present in the claims of the patent as granted and had never been objected to before. The proprietor then filed two new auxiliary requests including amendments meant for clarifying that term. Although in the course of a debate on the new requests, the chairman of the Board had indicated that the new requests now appeared to be clear, the Board, after a deliberation, announced that the new requests were not admitted into the proceedings due to a *prima facie* lack of clarity, dismissed the appeal and closed the proceedings. The patent proprietor then filed a petition for review under Article 112a EPC, in substance based on the argument that by surprisingly not admitting the new requests the Board would be in contravention of Article 113(1) EPC<sup>12</sup>.

5.2 The Enlarged Board considered the following facts as established from the file,

(a) that the Board of Appeal's objection under Article 84 EPC against claim 1 of the second auxiliary request

7 See the cases cited at <http://www.epo.org/law-practice/case-law-appeals/eba/decisions-petitions.html> and <http://www.epo.org/law-practice/case-law-appeals/eba/pending-petitions.html>

8 MR/2/00 „Basic proposal for the revision of the European Patent Convention“, New Article 112a EPC, No. 5: „Under no circumstances shall the petition for review be a means to review the application of substantive law. This restriction is justified because the function of the petition for review is to remedy intolerable deficiencies occurring in individual appeal proceedings but not to further develop the practice in proceedings before the EPO or to ensure the uniform application of the law.“ (emphasis added)

9 CA/PL 17/00, 27.03.2000, No. I.2f ([http://documents.epo.org/projects/babylon/eponet.nsf/0/CFE03D88F62C3984C1257280002F7329/\\$File/capl\\_00017\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/CFE03D88F62C3984C1257280002F7329/$File/capl_00017_en.pdf))

10 OJ EPO 2000, 322, Reasons No. 9

11 <http://www.epo.org/law-practice/case-law-appeals/recent/r130001eu1.html#q=%22R%200001%2F13%22>. Summary of decision cited from S.V. Steinbrener, Bardehle Pagenberg IP Report 2013/IV ([http://www.bardehle.com/en/publications/search\\_in\\_all\\_publications/document/ip-report-2013iv.html](http://www.bardehle.com/en/publications/search_in_all_publications/document/ip-report-2013iv.html))

12 R 1/13, Facts and submissions

was raised for the first time during the oral proceedings before the Board;

(b) that the new requests were filed during the oral proceedings in response to that objection; and

(c) that the chairman of the Board remarked that the claims of those newly filed requests appeared to be clear<sup>13</sup>.

However, the Enlarged Board could not find any suggestion in the petition of a denial of the petitioner's opportunity to present its comments on the admissibility of those requests. Quite the contrary, far from showing a denial of an opportunity to comment, in the Enlarged Board's view the petition confirmed that the opportunity occurred<sup>14</sup>.

5.3 On this basis, the Enlarged Board then rejected the petitioner's main arguments to the effect that the Board of Appeal did not consider the new requests sufficiently or was obliged to admit the new requests or exercised its discretion incorrectly, each argument being said to demonstrate a violation of Article 113 EPC<sup>15</sup>.

5.4 The petitioner's first argument was based on the premise that Article 113 EPC enshrined the possibility of a full reaction to overcome any late raised objection. A *prima facie* assessment to establish whether a new request was likely to overcome an objection was not adequate to satisfy the right to a thorough discussion under Article 113 EPC of all points at issue. In the Enlarged Board's view this premise was false. The decision in question here was whether or not to admit the petitioner's new requests, and the petitioner had and used the opportunity to comment on that issue. The petitioner's suggestion that the right to be heard carried with it, in the case of requests filed in response to late objections, a right to a full discussion which transcended the requirement of admissibility was simply incorrect. A late objection might lead to more latitude in the filing of requests in response but there was no certainty of admissibility, let alone of a more thorough discussion if admissibility was achieved. The requirement of admissibility for late-filed requests served several purposes – *inter alia* to ensure the requests offered a prospect of success – and the requirement was not suspended for latecomers, however understandable the lateness of filing their requests might be. If that were not the case, Article 13 RPBA would have little or no purpose<sup>16</sup>.

5.5 The petitioner's second argument, i.e. that Article 113 EPC overruled Article 13(1) RPBA so that the Board had no discretion in respect of the admissibility of such requests, was considered by the Enlarged Board to be no more than a necessary corollary of the previous argument starting from the false premise of a "right to a thorough discussion", which would mean that Article 13 RPBA had little or no purpose. It was thus rejected for the same reason<sup>17</sup>.

5.6 The petitioner's third argument that it was responding with new requests to a late objection, that the new requests were not an abuse of procedure and that therefore a *prima facie* assessment resulting in non-admissibility was also a fundamental violation of the right under Article 113 EPC to react fully to new issues, was again seen by the Enlarged Board to rely on the petitioner's fallacious view that Article 113 EPC provided a right of full response<sup>18</sup>.

5.7 The petitioner's fourth and final argument was that on the assumption that the Board did have a discretion under Article 13(1) RPBA not to admit new requests in response to late objections, the Board exercised that discretion in an unduly restrictive manner since pursuant to that Article the new requests could not be considered late and did not introduce any complexity as they attempted to overcome the objection. The state of the proceedings could not apply since the petitioner was responding to a new objection to terms which had been on file since the beginning of the appeal procedure; and procedural economy could not justify the adverse exercise of discretion since that would outweigh the right of the petitioner to defend its case. The Enlarged Board, however, found that this argument again erroneously supposed rights to flow from Article 113 EPC overriding Article 13 RPBA. Furthermore, the petitioner overlooked that Article 13(1) RPBA stated that the Board's discretion should be exercised in view of *inter alia* those criteria. Therefore other considerations could be taken into account, a well-established one of which was whether the claims were likely to overcome the objection raised<sup>19</sup>.

5.8 All its previous arguments having been found wholly unconvincing, the only remaining argument deployed by the petitioner to support a denial of opportunity to comment was that the petitioner was surprised by the decision not to admit its new requests because of the remark by the chairman of the Board that the requests appeared to be clear. The Enlarged Board also found this argument unconvincing for various reasons. Firstly, the petitioner and its representatives must have known that the remark was that of one member only and any additional significance they gave it had nothing to do with the proceedings. To seek subsequently to elevate the remark into something more in order to support a petition for review was not merely unconvincing but implausible. Rather, it was apparent that the petitioner conducted its case in reliance on its own assumptions. Hence, only the petitioner and its representatives could be responsible if such assumptions proved incorrect and the petition for review procedure was not a remedy for the consequences. Furthermore, the chairman of the Board had not actually said that the new requests were admissible. In addition, Article 15(4) RPBA could not be interpreted to mean that a remark or indication by the chairman had to be relied on by a party without question, let alone that it had the status of

13 Loc. cit., Reasons No. 6

14 Loc. cit., Reasons No. 9

15 Loc. cit., Reasons No. 12

16 Loc. cit., Reasons Nos. 13.1ff

17 Loc. cit., Reasons Nos. 14.1f

18 Loc. cit., Reasons No. 15

19 Loc. cit., Reasons Nos. 16.1ff

a ruling or the removal of a previous objection. Lastly, the Enlarged Board observed that in accordance with established case law, surprise, while being an understandable subjective reaction of a party which expected to but did not succeed, could not affect an objective review of the decision – so if the petitioner knew the issues which might be raised and had an opportunity to comment thereon, its subsequent surprise was of no relevance<sup>20</sup>.

5.9 The petition for review was therefore unanimously rejected as clearly unallowable<sup>21</sup>.

## 6. Comments

Case R 1/13 is remarkable from various points of view. It does not appear to be an isolated incident, but may well exemplify an overall tendency characterizing the Enlarged Board's approach in R-cases on the right to be heard. Such being the case, the author of these lines feels that it should provoke some comments.

### 6.1 Case management by Board 3.5.03

As has been pointed out above, the Rules of Procedure of the Boards of Appeal have been drafted with a view to "to prevent 'ping pong' submissions and 'salami' tactics in written proceedings". The question, however, arises whether it is fair to impose the requirement of an early disclosure of facts, submissions and arguments one-sidedly on the parties to the appeal proceedings. Proper case management by a Board should be expected to also identify possible problems at an early stage of the proceedings and to inform the parties accordingly.

This is exemplified by the Draft Rules of Procedure of the Unified Patent Court (RoP)<sup>22</sup> which may be considered as a synthesis of a proper conduct of patent infringement and revocation proceedings in the countries establishing the Court. Rule 101 RoP entrusts the judge rapporteur with the task of making all necessary preparations for the oral proceedings. In accordance with Rule 104 RoP this includes the obligation to identify the main issues and, where appropriate, to clarify the position of the parties as regards these issues. These provisions make clear that a proper case management requires a court to play an active role at an early stage of the proceedings in order to have the decisive questions properly prepared as a basis for the final discussion in the oral proceedings.

While late objections cannot be absolutely ruled out they should be exceptional and not be presented for the first time in concluding oral proceedings.. Moreover, the present case is extraordinary in that the late clarity objection was raised by the Board against a term that existed already in claim 1 as granted (!). Hence, its alleged lack of clarity lay dormant for many years, and the mere fact that under these circumstances this issue

became virulent at the end of appeal proceedings must alone be highly surprising.

### 6.2 Balance of powers and arguments

Should a Board, nevertheless, feel obliged to raise objections "out of the blue", one would expect that the affected party will be given an opportunity to deal with such late objection comprehensively or that the oral proceedings will be adjourned. It may be worthwhile recalling that Article 13(3) RPBA even excludes admittance of such issues if they were raised late by a party and could neither be dealt with by the other party nor by the Board without adjournment of the oral proceedings. The reason for that regulation must be seen in preventing situations where the right to be heard would enforce an impairment of procedural economy. However, again the Boards' own Rules do not appear to apply to the Boards who are hardly subject to any restrictions in this respect.

Since the Board apparently did not raise its surprising clarity objection on a *prima facie* basis (otherwise the clarity problem should have been discovered much earlier), for a fair balance of argument one would assume that a reasonable reaction of the patent proprietor to cope with the new problem would be fully considered on its merits. The Enlarged Board, however, found that a *prima facie* assessment in the context of an admissibility discussion of the new requests was sufficient for respecting the right to be heard. Therefore, it must be concluded that the Enlarged Board considered the admissibility issue to be the overruling aspect and focused on the late filing of the requests, thereby thrusting aside any reasons as to why these requests could not have been filed earlier. In accordance with this interpretation, the right to be heard is already complied with if a response to a surprising substantive objection of a Board undergoes a cursory review by the same Board and is then not admitted into the proceedings.

This apparent imbalance of powers and arguments, now having the Enlarged Board's blessing, does not seem to be easily compatible with the requirement of a fair procedure.

### 6.3 The Board's discretion under Article 13 RPBA

Since the Enlarged Board put so much emphasis on Article 13 RPBA, it is useful to look into this article again. The intention "to prevent 'ping pong' submissions and 'salami' tactics in written proceedings" led to vesting the Boards with the discretion to preclude any late issues raised by a party "in view of *inter alia* the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy" (Article 13(1) RPBA).

Hence, the question arises whether this provision also applies to late subject-matter raised by the Board itself, and in particular whether the Board still has discretion not to admit party submissions filed in response to such subject-matter. One might hesitate to answer this ques-

20 Loc. cit., Reasons Nos. 18ff

21 Loc. cit., Order

22 Available on the future Court's homepage <http://www.unified-patent-court.org/>

tion in the affirmative since the intention underlying this Article and the consequences resulting from it do not appear to address the Board's own behavior. In particular, the provision's basic objective, i. e. to prevent ping pong submissions and salami tactics by a party in written proceedings, evidently does not apply.

In any case, this cannot mean that the right to be heard is irrelevant in the present context. Quite the contrary: A late objection by the Board is, as a rule, much more dangerous for the patentee than a late attack by the opponent. A late attack is often not more than a last attempt to strengthen the opponent's case and the opponent has to convince the Board of its relevance. A late objection from the Board normally means that the Board has already a preliminary opinion in this regard and it may be rather difficult for the patentee to persuade the Board that the objection is without merits. In such a situation, the Board assumes the role of the patentee's adversary and one might therefore conclude that the patentee's interest in a proper opportunity to defend his patent deserves even more protection than in case of a late attack of the opponent. In *inter partes* proceedings the principle of equal treatment applies<sup>23</sup> which implies that the admission of late objections based on new facts and evidence requires the admission of late amendments in reply to these objections and *vice versa*<sup>24</sup>. There is no reason whatsoever to deny a full and proper opportunity for amendments including a full and proper consideration of their merits if the Board turns out to be the patentee's "adversary". When late submissions of the parties are at stake, the Boards of Appeal tend to cite G 9/91 and G 10/91 putting emphasis on their judicial function to give a decision upon the correctness of the decision taken by the department of first instance and stating that this review can, in principle, only be based on the reasons already submitted in the proceedings of first instance.<sup>25</sup> All this seems to be of no relevance when the Board intends to make a new objection of their own motion. In this situation, the principle of party disposition is set aside and examination *ex officio* takes place even at the very end of the proceedings. The least, a patentee may expect in such a situation is that he gets a fair chance to save his patent on the basis of an amendment to be admitted because it has been filed in reaction to the objection.

If under particular circumstances it might nevertheless be accepted that a Board has discretion not to admit reactions to its own late objections, possibly on the assumption that such reactions might be unfounded or create entirely new problems, such discretion should in any case be exercised duly.

In the present case, the criteria mentioned explicitly in Article 13(1) RPBA apparently cannot be used to preclude the proprietor's new requests: Neither were these requests complex since they only explained the allegedly unclear term, nor could they be filed earlier, nor could they be seen as a cause for adversely affecting pro-

cedural economy. The Board and the Enlarged Board therefore resorted to the "*inter alia*" clause in Article 13(1) RPBA and asserted that a further criterion for exercising the discretion was whether the requests were clearly allowable on a *prima facie* basis<sup>26</sup>.

Apart from the fact that this further criterion is somewhat logically flawed by mixing up aspects of admissibility and merits, it does not seem to be appropriate in the present case where the new requests clearly aimed at overcoming the clarity problem, and it appears utterly unfair to first raise an objection and then judge reasonable attempts for overcoming it only on a provisional evaluation of their probability of success, and not on a full consideration of their merits. In this context, the petitioner rightfully referred to a passage of decision R 3/10<sup>27</sup>, where the Enlarged Board (in a different composition) held:

"The right to be heard is a fundamental right of the parties which has to be safeguarded, irrespective of the merits of the party's submissions. The necessity to respect it is absolute and therefore cannot be made dependent on a prior assessment of the merits of the party's submissions, which in the present case would involve an assessment of the degree of likelihood that the arguments of the petitioner would have convinced the Board to acknowledge inventive step.

It is the very essence of the right to be heard that the party is given a full opportunity to defend its case and to persuade the deciding body that its position is the correct one. This right would be undermined if it were made dependent on an evaluation as to whether the party's standpoint is likely to be justified."

This was commented by the Enlarged Board in R 1/13 to only mean that the petitioner was to be heard on the admissibility of the new requests, and the petitioner had been given a full opportunity to defend its case in this respect<sup>28</sup>. However, the Enlarged Board ignored that in the case under consideration the admissibility issue had indeed been linked with an evaluation of likelihood as to whether the clarity objection would be overcome by the new requests. Hence, R 1/13 seems to be at odds with R 3/10. Since case R 3/10 was one of the very rare successful petitions, one may wonder whether this fact is due to taking the right to be heard more seriously.

When stating that the petitioner had been given a full opportunity to defend its case for admissibility, the Enlarged Board seems to restrict the party's right to be heard to the mere formal aspect whether or not admission of the request has been discussed. However, the substance of the right to be heard requires that the discretion exercised in deciding on the admission of submissions has been based on all relevant criteria meeting the fundamental requirement of fair proceedings. The right to be heard would be meaningless if an improper use of the discretion bestowed on the Boards of Appeal could not be reviewed.

23 G 1/86, OJ EPO 1987, 447

24 See e.g. recently T 366/11, Reasons No. 3

25 Case Law, loc. cit. IV.E.1. ,

26 R 1/13, Reasons Nos. 11 and 16.2f

27 R 3/10, Reasons No. 2.10 (<http://www.epo.org/law-practice/case-law-appeals/recent/r100003eu1.html#q=%22R%200003%2F10%22>)

28 R 1/13, Reasons No. 13.5

## 6.4 Legal expectations

The Enlarged Board is right in finding the Chairman's unchallenged remark that the claims of the new requests appeared to be clear to have been provisional and not binding on the Board<sup>29</sup>, as all members have equal rights in deciding a case (Article 19 RPBA).

However, as the Enlarged Board also correctly notes, pursuant to Article 15(4) RPBA, the "Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct". It is therefore usual practice that the Chairman has a special responsibility in conducting the oral proceedings and can normally be expected to speak for the whole Board. Otherwise, members could ask questions or make comments of their own volition. This not being the case, it may, at least on a *prima facie* basis, be assumed that the Chairman actually expresses the common views of all members.

Hence, the Chairman's remarks must be seen to carry particular weight and may well create legal expectations. Such expectations were, however, not satisfied by the Board announcing after deliberations that the new requests were not admitted since they were *prima facie* unclear. This must naturally have been surprising for the petitioner, in particular since the Chairman was responsible for the fair conduct of the oral proceedings, and fairness would have required to inform the petitioner that either the remark expressed the Chairman's personal opinion or that the Board had changed their mind. Misguiding a party in oral proceedings would normally not fall under the notion of "fair conduct". The only advice given by the Enlarged Board in this context is that parties should not rely on remarks or indications by the Chairman without question.

The Enlarged Board's conclusion seems to be in a remarkable contrast to the approach by the German Federal Supreme Court allowing a party to rely on a remark of the Federal Patent Court indicating that it is

inclined to follow the party's position with the consequence that the party is not required to strengthen its position by further submissions and is allowed to add such submissions if the Court changes its position.<sup>30</sup>

## 7. Conclusions

There is reasonable concern that the right to be heard, a fundamental principle of procedural law, is undergoing a loss of substance in proceedings before the EPO Boards of Appeal. This trend is mainly due to the Enlarged Board's narrow interpretation of Article 113(1) EPC in its case law on petitions for review without there being any need or even good reason for doing so.

In accordance with this case law, the right to be heard is at risk of being increasingly constrained or overruled by means of secondary provisions of basically formal nature, as encoded in the Rules of Procedure of the Boards of Appeal, in particular in Articles 12 to 15 RPBA. These provisions are predominantly directed to the parties of the proceedings by giving them directions and stipulating their responsibilities. However, without hesitation the Enlarged Board still applies these provisions one-sidedly to the parties in cases where they should in fact also be applied to the Boards when raising late objections.

The result is an accepted imbalance of powers and arguments leading to unfair and surprising situations for the party actually affected by such objections. The right to be heard, however, primarily finds expression in the principle of good faith and the right to a fair hearing, avoiding surprise actions also by the Boards. The decisive question is thus not whether Article 113(1) EPC overrules the Rules of Procedure of the Boards of Appeal, but whether the Rules of Procedure are interpreted by the Enlarged Board of Appeal so as to avoid surprise decisions as required by the right to be heard.

29 Loc.cit., Reasons No. 20

30 BGH GRUR 2013, 912 – *Walzstrasse*. See also Case Law of the Boards of Appeal of the EPO, 7th ed. 2013, IV.D.5.4.1, last sentence.

# Unitary Patent – Questions & Answers

N. Fox (GB)<sup>1</sup>, A. Kupecz (NL)<sup>2</sup>, D. van Dam (NL)<sup>3</sup>

## What is a Unitary Patent?

A Unitary Patent, also known as a European patent with unitary effect, will be a European patent which covers all of the EU member states with the exception of Italy, Spain and Croatia who are currently not participating in

the Unitary Patent scheme. The Unitary Patent is based on EU regulations 1257/2012 and 1260/2012. Although future amendments in the applicable legislation are possible, a basic framework for the Unitary Patent has emerged, the outlines of which are discussed in the rest of this article.

1 European and UK Patent Attorney & Solicitor, Simmons & Simmons LLP, London, nicholas.fox@simmons-simmons.com

2 European and Dutch Patent Attorney & Advocaat, Simmons & Simmons LLP, Amsterdam, andras.kupecz@simmons-simmons.com

3 European and Dutch Patent Attorney & Advocaat, Simmons & Simmons LLP, Amsterdam, dirkjan.vandam@simmons-simmons.com

## How do I get a Unitary Patent?

Unitary Patents will be granted by the European Patent Office ('EPO')<sup>4</sup> and can be derived from any European patent applications which designate all the countries involved in the Unitary Patent scheme and are pending before the EPO when the Unitary Patent comes into effect.<sup>5</sup> In practice this will be almost all patent applications pending before the EPO with a filing date on or after 1 March 2007, which was the date when Malta acceded to the European Patent Convention.

Unitary Patent applications will be examined in the ordinary way by the EPO and will be subject to the provisions of the European Patent Convention ("EPC") just like the current European patents. When the EPO agrees that an application is in order for grant, the EPO will give applicants the option of obtaining either a bundle of individual national patents for all designated states, or a Unitary Patent that covers the participating member states, with individual national patents for the non-participating states (such as Italy and Spain and the non-EU EPC member states such as Iceland and Turkey).

To obtain a Unitary Patent, an applicant must confirm that it wants a Unitary Patent rather than national patents in respect of the participating member states, and – during a transitional period of at most 12 years – must file a translation of the patent with the EPO.<sup>6</sup> This translation will need to be in English if the European patent application was not in English, or any other official language of the EU if the European patent application was prosecuted in English. The translation will have to be filed with the EPO – together with a request for "unitary effect" in order to obtain the Unitary Patent – no later than 1 month after the date of grant.

## Why would I want one?

A Unitary Patent will be a single right that extends to all participating member states. The formalities for obtaining a Unitary Patent will be significantly less onerous than the formalities for obtaining equivalent protection via a "traditional" European patent that lead to a bundle of national patents or filing a number of separate national patent applications. As discussed above, only a single translation of the patent into English or a language of one of the EU member states needs to be filed.<sup>7</sup> In the case of a typical patent this can reduce costs by around €30,000 compared with trying to obtain equivalent coverage under the existing system.<sup>8</sup>

Maintaining a granted Unitary Patent should also be less onerous than maintaining a bundle of equivalent national patents as a single annual renewal fee will need to be paid opposed to separate renewal fees being

payable to each of the national patent offices where protection is to be maintained. Similarly, if a Unitary Patent is transferred to a new proprietor, a single request to update the European patent register will be sufficient.

## When will the first Unitary Patent be issued?

It is intended that the EPO will issue the first Unitary Patents on the same day as the Unified Patent Court comes into existence.<sup>9</sup> For this to happen, the Unified Patent Court Agreement must be ratified by 13 member states including the UK, Germany and France. Amendments to Regulation (EU) 1215/2012 on jurisdiction and the recognition and enforcement of judgements in civil and commercial matters must also be in force for the new Court to come into effect on or after 1 January 2014.

The changes to the EU regulation are likely to take place sometime in 2013. Ratification of the Unified Patent Court Agreement will probably be completed towards the end of 2014 or early 2015. The Unified Patent Court and the first Unitary Patents will come into existence four months after that date. At present it is therefore expected that the first Unitary Patents will be issued possibly as soon as the middle of 2015. However, this date could be delayed if there are delays in ratifying the Unified Patent Court Agreement.

## What happens if any of the member states fail to ratify the Unified Patent Court Agreement?

As Unitary Patents can be granted four months after Unified Patent Court Agreement has been ratified by at least 13 member states (which must include the three most popular countries for validation i.e. UK, Germany and France), it is possible that the Court Agreement and the Unitary Patent may come into effect before the ratification process has been completed by all the participating member states. If this happens, the scope of each Unitary Patent will be limited to those countries which had completed ratification and for which the new Court is in force when the unitary effect is registered. The most likely country to be effected by this provision is Poland which, although it has indicated it is participating in the Unitary Patent is still debating whether or not to join the Unified Patent Court and has not yet signed the Unified Patent Court Agreement. If Poland decides not to be involved in the Unified Patent Court, Unitary Patents would not have effect in that territory.

## How much will it cost?

The costs of the prosecuting a Unitary Patent through to grant will be similar as the costs for any other European patent application as the new agreement does not change the prosecution process.

Upon grant, however, translation costs will be much reduced as a Unitary Patent will only have to be trans-

4 Reg. EU 1257/2012 Article 9(1)

5 Reg. EU 1257/2012 Article 3(1)

6 Reg. EU 1260/2012 Article 6

7 Unless the Unitary Patent is enforced in which case additional translation requirements to provide an alleged infringer with a translation of the patent apply.

8 Estimate provided by the European Commission based on a review of granted European patents.

9 Reg. EU 1257/2012 Article 18(2)

lated into one other language (during a transition period of at most 12 years), typically costing in the region of €2,500 for a patent application of average length.<sup>10</sup> After the transition period, translation requirements are to disappear and translations will only be required in the event of a dispute.

The renewal fees for a Unitary Patent are yet to be fixed.<sup>11</sup> However, it is expected that the fees are likely to be set at a level similar to the current costs for maintaining national patents in the UK, Germany and France (in the region of about €25,000 over a 20 year period, according to the current fee schedules). If that is the case, a Unitary Patent will provide coverage in countries that represent about 80 % of the EU market (in terms of GDP) for the costs of covering about 50 % of the EU market under the current European Patent regime. As with existing patent renewal fees, renewal fees for Unitary Patents are likely to rise from a few hundred Euros in the early years of a patent's life, to a few thousand in the final year.

### How can I enforce a Unitary Patent?

Unitary Patents can only be enforced in the new Unified Patent Court which will come into existence at the same time as the EPO begins to grant Unitary Patents.

<sup>10</sup> Figures provided by the EU Commission

<sup>11</sup> Reg. EU 1257/2012 Article 12 sets out the principles to be applied to the setting of the level of renewal fees.

### What do I need to be thinking about now?

Due to the time it takes for the EPO to grant patents, it is likely that many currently pending patent applications will be eligible for Unitary Patent protection upon grant. Proprietors will have to weigh up the benefits of obtaining Unitary Patents, such as broader coverage at significantly less expense than is required under the current system, against possible disadvantages, such as the inability to opt-out of the jurisdiction of the untested new Court and that Unitary Patents will be subject to central attack.

It will also be important to weigh up the hidden costs in portfolio management, such as the benefits of having to manage a single renewal fee and deal with a single patent register rather than multiple national patent fees and patent registers as is currently the case. Equally, however, the unitary nature of the new right may on occasion be a disadvantage – for example, it will only be possible to maintain or abandon the entire right rather than merely dropping one or two of the less important jurisdictions as is possible under the current system.

Unitary Patents with coverage across the 25 EU member states will be highly valuable assets and innovative companies should therefore be reviewing the costs involved with their current portfolios, their pending patent applications and also performing a realistic strategic appraisal of how they use their patents to establish how they can take maximum commercial advantage of the new Unitary Patent when it comes into force.

## The Unified Patent Court – Questions & Answers

N. Fox (GB)<sup>1</sup>, A. Kupecz (NL)<sup>2</sup>, D. van Dam (NL)<sup>3</sup>

### What is the Unified Patent Court?

The Unified Patent Court is a new court based on an agreement between all EU member states, apart from Spain and Poland who have not (yet) agreed to join the new court system and Croatia which joined the EU after the Unified Patent Agreement was concluded. After coming into effect, the Court will enable the enforcement or revocation in a single court action of: corresponding European patents granted by the European Patent Office ('EPO') in force in EU countries participating in the Court; European patents with unitary effect (otherwise known as Unitary Patents)<sup>4</sup>; and any related supplementary protection certifi-

ates.<sup>5</sup> Part of the legislation relating to the Unified Patent Court (rules of procedure) is still being developed. In this paper we discuss some main lines of the agreement and the rules in their current form.

### When will the Unified Patent Court come into effect?

The Unified Patent Court will come into effect 4 months after the Unified Patent Court Agreement has been ratified by 13 member states which must include the three most popular countries for validating European patents (i. e. UK, Germany and France).<sup>6</sup> Also, before the new Court comes into effect, Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgements in civil and commercial matters must be amended. The changes to the EU regulation on jurisdiction and the recognition and enforcement of judgements are likely to take place in

<sup>1</sup> European and UK Patent Attorney & Solicitor, Simmons & Simmons LLP, London, nicholas.fox@simmons-simmons.com

<sup>2</sup> European and Dutch Patent Attorney & Advocaat, Simmons & Simmons LLP, Amsterdam, andras.kupecz@simmons-simmons.com

<sup>3</sup> European and Dutch Patent Attorney & Advocaat, Simmons & Simmons LLP, Amsterdam, dirkjan.vandam@simmons-simmons.com

<sup>4</sup> Unitary Patents will be discussed in greater detail in a separate article to be published in the EPI Information.

<sup>5</sup> Article 4 UPC

<sup>6</sup> Article 89 UPC

2013 and ratification of the agreement will probably be completed towards the end of 2014 or early 2015. Since the – still unamended – Regulation (EU) No 1215/2012 will apply at least through to 10 January 2015, the Unified Patent Court is expected to come into existence not earlier than the middle of 2015.

### What will the impact of the Unified Patent Court be on my business?

The Unified Patent Court will have a significant impact on any business which is involved in patent litigation or licensing.

At present, patent rights are national rights and are to be enforced through individual enforcement actions in each of the national courts. This means that where a patentee seeks to enforce corresponding rights across Europe, multiple court actions are required.<sup>7</sup> Similarly, if someone wants to clear the way and have different national parts of a European patent revoked other than through Opposition before the EPO, separate revocation actions are required. When the Unified Patent Court fully comes into existence, it will be possible to enforce or revoke such rights across almost the entirety of the EU in a single court action before the Unified Patent Court.

As the Unified Patent Court removes the need for multiple parallel court actions, the cost of patent litigation will be reduced. Because of the similarities in structure and procedure, the cost of litigation in the new Court is likely to be similar to the cost involved in a court action in a single continental European jurisdiction such as the Netherlands or Germany. Litigation in the Unified Patent Court is therefore likely to be cheaper than e.g. enforcement in the UK, which is currently the most expensive jurisdiction for enforcement of patent rights in Europe. By cutting down costs and numbers of procedures, both patent enforcement and defence against unfounded claims should be improved, thus meeting one of the primary purposes of the Unified Patent Court.

### Who can sue in the Unified Patent Court?

Patent proprietors, holders of supplementary protection certificates and exclusive licensees of such rights will be able to bring actions for actual or threatened infringement before the Court.<sup>8</sup> A holder of a non-exclusive licence can in principle also enforce their rights in the Unified Patent Court. However, this is only in so far as expressly permitted by the licence agreement.<sup>9</sup> In addition, anyone may bring an action to revoke such rights or for a declaration of non-infringement.<sup>10</sup>

7 Although, based on the Solvay/Honeywell ECJ case (C616-10), some national courts (notably the Dutch court) have accepted cross-border jurisdiction to take provisional measures in patent cases.

8 Article 47(1) UPC

9 Article 47(3) UPC

10 Article 47(6) UPC

### Where will actions be heard?

At first instance, the Court will consist of a number of local or regional divisions ('national or regional chambers') and a Central Division divided into three sections located in Paris, London and Munich.<sup>11</sup> The section of the Central Division in Munich will handle cases concerning mechanical inventions, the section in London will be responsible for chemical and pharmaceutical inventions and all other inventions, such as electronics and telecoms, will be handled by the section in Paris.<sup>12</sup>

Infringement actions have to be brought before the national or regional chamber where infringement is alleged to have occurred or alternatively before the national or regional chamber where a defendant is domiciled.<sup>13</sup> Procedures that start as a revocation action or as an action for a declaration of non-infringement have to be brought before one of the sections of the Central Division,<sup>14</sup> unless an action for infringement between the same parties has already been brought before a local or regional division in which case any revocation action can only be brought in that division.<sup>15</sup>

National chambers can be established in any participating member state. Alternatively, two or more countries can choose to establish a joint regional chamber. It is expected that national chambers will be established in all of the countries where there is currently a significant amount of patent litigation, such as the UK, Germany, France, Holland and Italy. In Germany, it is expected that multiple chambers will be established, most likely in the same locations as the existing German courts which handle a significant amount of patent litigation, namely Mannheim, Düsseldorf and Munich.

The Danish government<sup>16</sup> has proposed that a regional chamber should be jointly established by Denmark, Sweden, Finland, Latvia, Lithuania and Estonia. The proposed Nordo-Baltic court would have its seat in Malmö. Discussions are also on-going between Romania, Bulgaria, Greece and Cyprus about establishing a South-eastern regional chamber. In both cases it is being proposed that English should be the working language of the proposed regional chambers.

If no local or regional court is established in a particular jurisdiction, infringement actions concerning infringement in that jurisdiction or against defendants domiciled in that jurisdiction can be brought before the Central Division, as may any action against a defendant who is domiciled outside of the territory of the contracting EU member states.<sup>17</sup>

Appeals against decisions made at the first instance of the Unified Patent Court will be heard in the Court of Appeal based in Luxembourg.<sup>18</sup>

11 Article 7(1) & (2) UPC

12 Article 7(2) UPC & Annex to the Statute of the Unified Patent Court

13 Article 33(1) UPC.

14 Article 33(4) UPC

15 Article 33(4) UPC

16 Location of a Regional Division of the Court of First Instance (UPC), Ministry of Business and Growth, Denmark, 08 April 2013

17 Article 33(1) UPC

18 Article 9(5) UPC

## What will the language of proceedings be?

Actions brought before the Central Division will be conducted in the language in which the patent was prosecuted before the EPO.<sup>19</sup> In approximately 80 % of cases this is English, in around 15 % of cases it will be German and in around 5 % it will be French.

The language of proceedings in cases before the national and regional chambers will depend upon the chamber. In many cases this will be the national language of the country where the chamber is established, although some chambers may provide litigants with a choice of languages.<sup>20</sup>

As presently drafted, if a local or regional division provides litigants with a choice of languages, proceedings are required to be brought in the language in which the defendant normally conducts its business in that jurisdiction.<sup>21</sup>

## Who will be the Judges?

Each case will be heard by a multi-national panel of judges.<sup>22</sup> Where a case is brought before a local division in a country where a 'significant amount' of patent litigation has previously been brought, or before a regional division, two of the judges will be from that country respectively region and the third will be appointed from elsewhere.<sup>23</sup> If the local division is established in a country without a 'significant amount' of patent litigation, there will be one local judge and two judges from other jurisdictions, probably jurisdictions with a history of patent litigation.<sup>24</sup>

A 'significant amount' of litigation, for the purposes of the rules, is at least 50 patent cases per calendar year (averaged over a 3-year period). This means that chambers in Germany, France, the UK, Italy and Holland will have two local judges. It is also possible that a Swedish chamber may sit with a panel of two local judges. Any local chamber outside of those countries is expected to have one local judge and two foreign judges appointed from a list.

Any regional chamber will have two judges appointed from within the jurisdictions hosting the regional chamber and one judge appointed from outside of the region.<sup>25</sup>

Initially, the Court will be staffed with the existing patent judges from the various national courts. So, for example, the local judges in the Italian chambers will be drawn from the existing judges in the IP courts. Similarly, the local judges for the German chambers will be drawn from the judiciary serving in the Bundespatentgericht and judiciary handling patent matters in the Landgericht.

The rules also provide for technical judges to be appointed to the Court, on request and whenever the

Court considers it appropriate or is considering invalidity matters.<sup>26</sup> Any technical judges will be appointed from a list of individuals with relevant university degrees and proven expertise in a field of technology and knowledge of civil and procedural law relevant to patent litigation.<sup>27</sup>

## What law will apply?

The basic law on validity and the scope of patent protection will be drawn from the existing European patent convention (EPC).<sup>28</sup> The Unified Patent Court Agreement contains provisions defining acts of infringement which basically correspond to existing national law.<sup>29</sup> In addition the agreement also provides for the court to base its decisions on provisions of EU law and in particular the EU regulations for the Unitary Patent.<sup>30</sup> The Court will also refer to international agreements applicable to patents which are binding on the member states such as TRIPS and the Paris Convention, and to national (patent) law.<sup>31</sup>

## What are the rules of procedure?

Detailed draft rules of procedure have been issued and put out to formal consultation which runs until 1 October 2013 after which any submissions made will be considered and the rules will then be finalised.

The rules of procedure can be regarded as a mixture of various aspects roughly similar to existing national laws. The rules provide for obtaining evidence by way of a *saisie contrefaçon* procedure<sup>32</sup> such as currently exists in Italy and France, and for the filing of protective letters<sup>33</sup> such as are currently used in Germany and Holland. In the period straight after proceedings have been commenced, parties will be required to provide detailed explanations of the case in writing<sup>34</sup>, such as is currently the case in Holland and Germany. At the end of this 'written procedure', the Court will hold a case management conference<sup>35</sup> similar to the procedure in the English Patent County Court<sup>36</sup> to decide upon the next steps in the case. This can include the Court ordering parties to disclose specific documents and orders for the cross-examination of witnesses.<sup>37</sup> The extent of any such cross-examination will be limited to specific issues in the manner of Danish patent proceedings. After any such additional evidence has been obtained and any cross-examination has taken place, an oral hearing will be held to provide the parties with a final opportunity to summarise their case and

26 Article 8(6) & Draft Rules of Procedure Rules 33, 34, 37(3)

27 Article 15(3) UPC

28 Article 24(1)(c) UPC

29 Articles 25-27 UPC

30 Article 24(1)(a) UPC

31 Article 24(1)(d) & (e) UPC

32 Draft Rules of Procedure Rules 192-198

33 Draft Rules of Procedure Rule 207

34 See for example, Draft Rules of Procedure Rule 13(l), (m) & (n) & Rule 24 (e)(f) & (g)

35 Draft Rules of Procedure Rule 101(3) & 104

36 Renamed as the Intellectual Property Enterprise Court with effect from 1 October 2013.

37 Draft Rules of Procedure Rules 176-179

19 Article 49(6) UPC

20 Article 49 (1)-(5) UPC

21 Draft Rules of Procedure Rule 14(2)

22 Article 8(1) UPC

23 Article 8(3) UPC

24 Article 8(2) UPC

25 Article 8(4) UPC

present arguments to the Court.<sup>38</sup> Such an oral hearing will typically be concluded within a single day.

### Will the Court hear infringement and validity together?

Local and regional chambers hearing infringement cases in which a defendant files a counter-claim for revocation of a patent will have a choice. After having heard the parties, the chamber may choose to hear infringement and validity together; may choose to hear only arguments on infringement and send the validity proceedings to be heard by the Central Division; or alternatively, with the agreement of the parties, may send the entire case to be heard by the Central Division.<sup>39</sup> If a local or regional chamber does decide to split a case and only hear arguments relating to infringement and send the validity case to the Central Division, the chamber will have the option to stay the infringement proceedings pending the outcome of the validity case and will be obliged to do so if there is a high likelihood of a patent being found invalid.<sup>40</sup>

### Who can appear before the court?

Parties are required to be represented by lawyers<sup>41</sup> or alternatively European Patent attorneys who have an appropriate litigation qualification.<sup>42</sup> A European Patent Litigation qualification will be established for this purpose. At present it is not clear whether national qualifications such as the UK Intellectual Property Litigation Certificate which enables UK national patent attorneys to represent clients independently of lawyers before the English courts will be considered to be an appropriate qualification for appearing before the Courts.

National patent attorneys and European Patent attorneys regardless of whether they have a European Patent Litigation qualification may assist parties' representatives and will be allowed to speak at hearings subject to a representative's responsibility to co-ordinate the presentation of a party's case.<sup>43</sup>

### Can I opt out?

During a transitional period the new Court will run in parallel with the existing national patent enforcement systems.<sup>44</sup> For at least the first seven years<sup>45</sup> of the Unified Patent Court, patent proprietors will be able to opt both granted European patents and European patent applications pending before the European Patent Office out from the jurisdiction of the new Court unless an action has already been brought before the new Court, thus avoiding risking valuable assets in an untried sys-

tem. It is not yet clear whether there will be an administrative fee for doing so.

Depending on the costs involved, opting-out may be an attractive option for patent proprietors as it prevents competitors from being able to apply to revoke patents across Europe in a single court action. Further, the rules of procedure permit a proprietor to withdraw an opt-out unless an action has already been brought before a "conventional" national court. Accordingly, if a patent proprietor wishes to enforce a patent they in principal have the option of either using the existing national country-by-country enforcement procedures or opting back into the new Court at that stage.

### What do I have to do now?

The actions required by patent proprietors at this time are relatively limited.

Patent proprietors should review their existing patent portfolios so determine whether or not they want to file opt-outs on any of their existing European patents. Any opt-outs will have to be chosen on a case by case basis. Deciding upon an appropriate strategy and assessing the appropriate approach for the various patents in a large patent portfolio will be a substantial task. Fortunately, as ratification is unlikely to take place until 2015, patent proprietors currently still have time to make their decisions.

In the short term, patent proprietors should also review the countries where they choose to validate their European patents. Many European patents are only validated in the larger European countries, namely: UK, Germany, France, Italy and Spain as those countries account for the majority of the EU market. However, when the new Court comes into force it will no longer be necessary to initiate separate court proceedings in each individual member state. This increases the value of validating patents in the next tier, particularly in countries which are members of the London agreement where national validation of patents prosecuted before the EPO can be achieved by simply filing claims translations into the national language (e.g. Netherlands and Sweden). Additional validations will increase the impact of the single court action in the Unified Patent Court and would also increase the options available as to the national and regional chambers where court actions might be initiated).

Patent proprietors should also consider the expected timing of the prosecution of patent applications before the EPO, in view of the possibility to take advantage of the new Unitary Patent system which will come into force at the same time as the new Court. Where it is felt that a Unitary Patent is particularly attractive, applicants should refrain from taking actions to speed up prosecution so that grant does not occur before the option of a Unitary Patent becomes available.

38 Draft Rules of Procedure Rules 176 & 178(5)

39 Article 33(3) UPC

40 Draft Rules of Procedure Rule 37(3)

41 Article 48(1) UPC

42 Article 48(2) UPC.

43 Article 48(4) UPC and Draft Rules of Procedure 292 & 287(6) & (7)

44 Article 89 UPC

45 Article 89(1) UPC

## Inside Intellectual Property

M. Jewess (GB)

Published by CIPA

As a patent attorney involved in mainly patent-related cases in the UK Courts I recall one now retired judge who invariably would say to an advocate addressing him on a particularly thorny point of law, "Right Mr. X, let's get back to basics", where upon he would reach for the CIPA Guide to the Patents Acts (aka 'The Black Book'), consult it, read out the relevant text, and await the advocate's response. I confess to having used the Judge's back-to-basics approach in all levels of Hearings at the EPO, and elsewhere, as it helps to concentrate the minds of all involved. Which brings me to the book under review. Dr. Jewess goes back to basics too in that he gives detailed advice on basic tools an IP practitioner should have at his disposal, such as being able to monitor dates, develop drafting skills, and the practice of peer review of the practitioner's work, particularly for example of priority filing texts.

But this is not by any means a textbook on just the basics of IP. Dr. Jewess develops the world of IP through chapters on for example ethics and privilege, IP management systems, R&D and innovation (it being pointed out that this latter term is not the same as 'novelty' in patent law, innovation being the successful intrusion of an idea into the "real world", eg of economics), patent strategy eg where to file, and why, and educating the client. As a practitioner in private practice, these latter two chapters are close to my heart as they are topics my former colleagues will remember me banging on about *ad nauseam*. Dr. Jewess does not 'bang on', he gives sensible practical advice, valuable insights, and helpful guidelines. The topics I have mentioned are just some included in the impressive and comprehensive spread of

the text based as it is on research of 'best practice' (an expression used in the sub-title of the book) provided by a survey of 10 UK patent attorney private practices, the IP departments of 5 UK solicitor firms, and 10 in-house company IP departments. The results of the survey, coupled with the author's own personal, and wide, experience of IP and his attention to detail provide a compelling read for all those who practice IP. By this I mean practitioners in private practice, in in-house departments, in solicitor IP departments, and those IP policy makers on the 'Official Side'.

I emphasise too that the book is wide-ranging in that the author covers all the major jurisdictions, including the EPC/EPO, the PCT, and the pitfalls which can be connected with translation. Dr. Jewess also has refreshing thoughts on the topics covered, for example the desirability of acceptance or otherwise of non-mandatory requirements, such as the use of the 'two-part' claim format.

Every chapter of the book is studded with footnotes, all of them gems, and these together with a comprehensive index and list of references, and pertinent appendices, for example on representation and attorney-client privilege under the UPC, make this well-written and readable book a "must have" for all IP practitioners of whatever nationality and wherever they practice world-wide.

If I have any quibble, it is with the Title: the word "Inside" could be omitted, for this book covers IP in all its ramifications and suggests proven best IP practice.

T. Johnson (GB)

## Intellectual freedom and economical common-sense

G. Kern (DE)

Dear Colleagues,

Please take notice of the following opinion:

### Intellectual freedom and economical common-sense

With respect to numerous modern publications, in particular to a "Commentary on J.E. Stiglitz's article: life or profit" in **epi** information 3/2013, publication of P. Rosenich (LI), it urgently needs be well understood that intellectual property as such can never be subject of individual rights.

The actual notion of intellectual property is derived from an individual conquest made to appropriate an extraordinary and uncommon intellectual structure as an individual possession which could probably be kept secret for a while as long as it is not published or otherwise used in a commercial context. Such possession may be the unexpected result of an extraordinary effort to conceive an exceptional or exquisite artistic product, be it pictorial or graphic art or literature or music or a technical invention intended for an objective of realist economy. However at all events, it is the result of an activity in regular and respectable use of intellectual freedom.

It further urgently needs be well understood that intellectual freedom is in fact the only one undeniable freedom of mankind in general and thus, is the fundamental basis of now nowadays acknowledged human rights, Although human rights may justify and serve to

legalize individual property on definite material objects acquired by activities in real economy, they cannot likewise justify and serve to legalize individual property on intellectual possessions acquired by individual appropriation out of public competences to exercise intellectual freedom. Thus, intellectual property is not a precept of human rights. And a technical patent cannot be claimed on the basis of some intellectual property as it were derived from the acquisition of individual knowledge about useful technical means and methods of activity only.

A claim of intellectual property signifies an individually restricted contest contrary to intellectual freedom and thus, is worthless. But the effective ground of the institution of technical patents is in fact nothing but the result of common-sense in realist economy, and the result of fairness in commercial competition with technical competence. And in this respect, the Nobel-Price winner Stiglitz may well have some useful economical competence to evaluate and judge modern patent systems for the benefit of our society.

Let us go back to the roots of technical patent rights. We so may find Stiglitz's ideas present in public tuition and born in respect since over 100 years. and still duly maintained for instance in the original conception of the European Patent Convention.

Yours sincerely

Gerbert Kern

**Disziplinarorgane und Ausschüsse**  
**Disciplinary Bodies and Committees · Organes de discipline et Commissions**

<b>Disziplinarrat (epi)</b>	<b>Disciplinary Committee (epi)</b>	<b>Commission de Discipline (epi)</b>
AL – Melina Nika	GB – John Gray	MT – Antoine Camilleri
AT – Wolfgang Poth <sup>°</sup>	GR – Athanasios Tsimikalis	NL – Arjen Hooiveld
BE – Thierry Debled	HR – Dina Korper Zemva	NO – Elin Anderson
BG – Vesel Pendichev	HU – József Markó	PL – Alicja Rogozinska
CH – Raymond Reuteler	IE – Shane Smyth	PT – Antonio J. Dias Machado
CY – Vasiliki A. Rousounidou	IS – Árni Vilhjálmsson**	RO – Calin Pop
CZ – Michael Fischer	IT – Bruno Muraca	RS – Dejan Bogdanovic
DE – Werner Fröhling <sup>°</sup>	LI – Paul Rosenich*	SE – Lennart Karlström
DK – Susanne Høiberg	LT – Vitalija Banaitiene	SI – Janez Kraljic
EE – Sirje Kahu	LU – Pierre Kihn	SK – Tomas Hörmann
ES – Inigo Elosegui de la Pena	LV – Ileana Florea	SM – Giampaolo Agazzani
FI – Christian Westerholm	MC – Eric Augarde	TR – Tuna Yurtseven
FR – Bernard Rougemont	MK – Blagica Veskovska	
<b>Disziplinarausschuss (EPA/epi)</b> epi-Mitglieder	<b>Disciplinary Board (EPO/epi)</b> epi Members	<b>Conseil de discipline (OEB/epi)</b> Membres de l'epi
BE – Georges Leherte	DE – Walter Dabringhaus	FR – Bruno Quantin
GB – James Boff		
<b>Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi)</b> epi-Mitglieder	<b>Disciplinary Board of Appeal (EPO/epi)</b> epi Members	<b>Chambre de recours en matière disciplinaire (OEB/epi)</b> Membres de l'epi
DE – Nanno Lenz	ES – Pedro Sugrañes Moliné	GB – Terry Johnson
DK – Ejvind Christiansen	FR – Pierre Gendraud	NL – Bart van Wezenbeek
	GB – Huw George Hallybone	
<b>Ausschuss für epi-Finzen</b>	<b>epi Finances Committee</b>	<b>Commission des Finances de l'epi</b>
CH – André jr. Braun	GB – Timothy Powell**	LU – Jean Beissel
DE – Michael Maikowski*	IT – Salvatore Bordonaro	PL – Ewa Malewska
FR – Jean-Loup Laget	LT – Marius Jason	SE – Klas Norin
<b>Geschäftsordnungsausschuss</b> Ordentliche Mitglieder	<b>By-Laws Committee</b> Full Members	<b>Commission du Règlement intérieur</b> Membres titulaires
FR – Pascal Moutard*	GB – Terry Johnson	MC – Günther Schmalz
	IT – Paolo Gerli	
Stellvertreter	Substitutes	Suppléants
AT – Martin Forsthuber	DE – Dieter Speiser	FR – Sylvain Le Vaguère
<b>Ausschuss für Standesregeln</b> Ordentliche Mitglieder	<b>Professional Conduct Committee</b> Full Members	<b>Commission de Conduite professionnelle</b> Membres titulaires
AT – Friedrich Schweinzer	FR – Jean-Robert Callon de Lamarck	NL – Hans Bottema
BE – Philippe Overath	GB – Timothy Powell*	NO – Per Fluge
BG – Neyko Neykov	HR – Aleksandar Bijelic	PL – Ludwik Hudy
CH – Regula Rüedi	HU – Mihaly Lantos	PT – César de Bessa Monteiro
CZ – Dobroslav Musil	IE – Michael Lucey	RO – Lucian Enescu
DE – Holger Geitz	IS – Thorlakur Jonsson	SE – Ronny Janson
DK – Leif Roerboel	IT – Paolo Gerli	SI – Jure Marn
EE – Raivo Koitel	LT – Virgina Draugeliene	SK – Dagmar Cechvalova
ES – Juan Antonio Morgades	LU – Henri Kihn	SM – Giuseppe Masciopinto
FI – Juhani Kupiainen	LV – Sandra Kumaceva	TR – Kazim Dündar
Stellvertreter	Substitutes	Suppléants
AT – Eberhard Piso	FI – Jonna Sahlin	LT – Vitalija Banaitiene
CH – Paul Georg Maué	FR – Philippe Conan	LU – Romain Lambert
CZ – Vitezslav Zak	GB – Simon Wright	NL – John Peters
DE – Rainer Kasseckert	HR – Albina Dlacic	NO – Lorentz Selmer
DK – Anne Schouboe	IE – Brian O'Neill	PL – Miroslaw Klar
EE – Jürgen Toome	IS – Einar Friðdriksson	RO – Gheorghe Bucsa
ES – Anna Barlocchi	IT – Andrea Marietti	SE – Stina Sjögren Paulsson
		SI – Marjanca Golmajer Zima

\*Chair/\*\*Secretary

<sup>°</sup>Vice-Chair/<sup>°°</sup>Vice-Secretary

<b>Ausschuss für Europäische Patent-Praxis</b>	<b>European Patent Practice Committee</b>	<b>Commission pour la Pratique du brevet européen</b>
AL – Vladimir Nika	FR – Jacques Bauvir	LV – Alexander Smirnov
AT – Werner Kovac	FR – Jean-Robert Callon de Lamarck	MC – Michael Fleuchaus
AT – Andreas Vögele	GB – Jim Boff	MC – Günther Schmalz
BE – Ludivine Coulon	GB – Chris Mercer <sup>o</sup>	NL – Arnt Aalbers
BE – Francis Leyder*	GR – Manolis Samuelides <sup>o</sup>	NL – Ruurd Jorritsma
BG – Ivanka Pakidanska	HR – Tomislav Hadzija	NO – André Berg
BG – Violeta Shentova	HR – Gordana Turkalj	NO – Kristine Rekdal
CH – Ernst Irniger	HU – Zsolt Lengyel	PL – Katarzyna Lewicka
CH – Paul Georg Maué	HU – Zsolt Szentpéteri	PL – Ewa Malewska
CY – Christos A. Theodoulou	IE – Olivia Catesby	PT – Pedro Alves Moreira
CZ – Ivana Jirotkova	IE – Denis McCarthy	PT – Fernando Ferreira Magno
CZ – Jiri Malusek	IS – Einar Friðriksson**	RO – Daniella Nicolaescu
DE – Ingo Heinzelmann	IS – Ragnheidur Sigurdardottir	RO – Doina Tuluca
DE – Heike Vogelsang-Wenke	IT – Francesco Macchetta	SE – Carl Carlsson
DK – Eva Carlsson	IT – Micaela Modiano	SE – Anita Skeppstedt
DK – Soeren Pedersen	LI – Christoph Gyaja	SI – Bojan Ivancic
EE – Jaak Ostrat	LI – Roland Wildi	SK – Marta Majlingova
EE – Margus Sarap	LT – Ausra Pakeniene	SK – Robert Porubcan
ES – Enrique Armijo	LT – Jurga Petniunaite	SM – Antonio Maroscia
ES – Luis-Alfonso Durán Moya	LU – Sigmar Lampe <sup>o</sup>	SM – Andrea Perronace
FI – Marjut Honkasalo <sup>o</sup>	LU – Philippe Ocvirk**	TR – Hülya Cayli
FI – Arja Weckman	LV – Jevgenijs Fortuna	TR – Aydin Deris
<b>Ausschuss für Berufliche Bildung</b> Ordentliche Mitglieder	<b>Professional Education Committee</b> Full Members	<b>Commission de Formation Professionnelle</b> Membres titulaires
AL – Eno Dodbiba	FI – Tomi Konkonen	LV – Edvards Lavrinovics
AT – Friedrich Schweinzer**	FR – Francis Fernandez	MK – Valentin Pepeljugin
BE – Nele D'Halleweyn	GB – Jon Gowshall	NL – Freek Smit
BG – Radislava Kosseva	HR – Tomislav Pejcinovic	NO – Per Berg
CH – Wolfgang Bernhardt	HU – Dóra Tepfenhárt	PL – Piotr Malcherek
CY – Christos A. Theodoulou	IE – Conor Boyce	PT – Isabel Franco
CZ – Jiri Andera	IS – Sigurdur Ingvarsson	RO – Cosmina-Catrinel Fierascu
DE – Felix Letzelter	IT – Paolo Rambelli*	SE – Martin Holmberg
DK – Pia Stahr	LI – Susanne Kaminski	SI – Antonija Flak
EE – Tónu Nelsas	LT – Otilija Klimaitiene	SM – Davide Petraz
ES – Francisco Saez Granero	LU – Didier Lecomte	TR – Alev Yavuzcan
Stellvertreter	Substitutes	Suppléants
AT – Herwig Margotti	FR – Jérôme Collin	NL – Bart van Wezenbeek
BE – Bart Van Den Hazel	GB – Gary Whiting	NO – Eirik Røhmen
BG – Vesel Pendichev	HU – Imre Ravadits	PL – Adam Pawlowski
CH – Michael Liebetanz	IE – Seán Harte	PT – José de Sampaio
CZ – Irena Langrova	IS – Gunnar Hardarson	RO – Mihaela Teodorescu
DE – Gabriele Ahrens	IT – Isabella Ferri	SE – Christer Jönsson
DK – Bo Hammer Jensen	LI – Anke Allwardt	SI – Zlata Ros
ES – Ismael Igartua	LT – Aurelija Sidlauskienė	SM – Andrea Perronace
FI – Terhi Nykänen	LU – Mathis Brück	TR – Ayşe Ünal Ersönmez
	LV – Valentina Sergejeva	
<b>Examination Board Members on behalf of epi</b>		
DE – Ulla Allgayer	DE – Stefan Kastel	GB – Ian Harris*

\*Chair/\*\*Secretary

<sup>o</sup>Vice-Chair/<sup>oo</sup>Vice-Secretary

<p><b>Ausschuss für biotechnologische Erfindungen</b></p> <p>AL – Diana Sinojmeri  AT – Albin Schwarz  BE – Ann De Clercq*  BG – Stanislava Stefanova  CH – Dieter Wächter  CZ – Roman Hak  DE – Günter Keller  DK – Anne Schouboe  ES – Francisco Bernardo Noriega  FI – Sisko Knuth-Lehtola  FR – Anne Desaix</p>	<p><b>Committee on Biotechnological inventions</b></p> <p>GB – Simon Wright**  HR – Tihomir Dragun  HU – Arpad Pethö  IE – Anna-Louise Hally  IS – Thorlakur Jonsson  IT – Olga Capasso  LI – Burkhard Bogensberger  LT – Liudmila Gerasimovic  LU – Pierre Kihn  LV – Valentina Sergejeva  NL – Bart Swinkels</p>	<p><b>Commission pour les Inventions en biotechnologie</b></p> <p>NO – Liv Thoresen  PL – Jadwiga Sitkowska  PT – Alberto Canelas  RO – Cristina Popa  RS – Zeljka Brkic  SE – Niklas Mattsson  SI – Mojca Bencina  SK – Katarína Makel'ová  SM – Maria Primiceri  TR – Ayse Ildes Erdem</p>
<p><b>Ausschuss für EPA-Finzen</b> Ordentliche Mitglieder</p> <p>DE – Walter Dabringhaus</p> <p>Stellvertreter</p> <p>IT – Alessandra Longoni</p>	<p><b>Committee on EPO Finances</b> Full Members</p> <p>FR – Pierre Gendraud  GB – Jim Boff*</p> <p>Substitutes</p> <p>NL – Erik Bartelds</p>	<p><b>Commission des Finances de l'OEB</b> Membres titulaires</p> <p>IE – Lindsay Casey</p> <p>Suppléants</p> <p>PL – Ewa Malewska</p>
<p><b>Harmonisierungsausschuss</b> Ordentliche Mitglieder</p> <p>BE – Francis Leyder**  CH – Axel Braun</p> <p>Stellvertreter</p> <p>BG – Natasha Andreeva  FI – Veli-Matti Kärkkäinen</p>	<p><b>Harmonization Committee</b> Full Members</p> <p>DE – Lothar Steiling  FR – Philippe Conan  IT – Filippo Santi</p> <p>Substitutes</p> <p>IT – Stefano Giberti  LI – Anke Allwardt  LT – Gediminas Pranevicius</p>	<p><b>Commission d'Harmonisation</b> Membres titulaires</p> <p>GB – John D. Brown*  SE – Nils Ekström</p> <p>Suppléants</p> <p>PL – Marek Besler  SM – Paolo Ferriero</p>
<p><b>Ausschuss für Streitregelung</b> Ordentliche Mitglieder</p> <p>AT – Werner Kovac  BE – Pieter Vandersteen  BG – Ivanka Pakidanska  CH – Peter Thomsen**  CY – Christos A. Theodoulou  CZ – Michal Guttmann  DE – Matthias Wagner  DK – Nicolai Kanved  EE – Mart Koppel  ES – Enrique Armijo  FI – Kirsikka Etuaho  FR – Axel Casalonga*</p> <p>Stellvertreter</p> <p>AT – Harald Nemeč  CZ – Eva Halaxova  DE – Gabriele Mohsler  DK – Ejvind Christiansen  ES – Inigo Elosegui  FI – Arja Weckman  FR – Pierre Gendraud</p>	<p><b>Litigation Committee</b> Full Members</p> <p>GB – Edward Lyndon-Stanford  HR – Mladen Vukmir  HU – Ferenc Török°  IE – Triona Walshe  IS – Gunnar Hardarson  IT – Giuseppe Colucci  LI – Bernd-Günther Harmann  LT – Vilija Viesunaite  LU – Mathis Brück  LV – Voldemars Osmans</p> <p>Substitutes</p> <p>GB – Terry Johnson  HR – Sanja Vukina  IE – Jonathan White  IS – Einar Friðriksson  IT – Antonella De Gregori  LI – Roland Wildi  LT – Ausra Pakeniene  LU – Valérie Mellet</p>	<p><b>La Commission procédure judiciaire</b> Membres titulaires</p> <p>MC – Günther Schmalz  NL – Leonardus Steenbeek  NO – Haakon Thue Lie  PL – Lech Bury  PT – Nuno Cruz  RO – Ileana Florea  SE – Stina Sjögren Paulsson  SI – Nina Drnovsek  SK – Vladimir Neuschl  SM – Gian Giuseppe Masciopinto  TR – Aydin Deris</p> <p>Suppléants</p> <p>NL – Paul Clarkson  NO – Kari Simonsen  PL – Anna Korbela  RO – Dan Puscasu  SE – Lars Estreen  SK – Katarina Bad'urová  TR – Serra Coral</p>

\*Chair/\*\*Secretary

°Vice-Chair/°°Vice-Secretary

<b>Redaktionsausschuss</b>	<b>Editorial Committee</b>	<b>Commission de Rédaction</b>
AT – Walter Holzer	DE – Albert Wiedemann FR – Thierry Schuffenecker	GB – Terry Johnson
<b>Ausschuss für Online-Kommunikation (OCC)</b>	<b>Online Communications Committee (OCC)</b>	<b>Commission pour les Communications en Ligne (OCC)</b>
DE – Ludger Eckey DK – Peter Indahl FI – Antero Virkkala*	FR – Catherine Ménès GB – John Gray IE – David Brophy**	IT – Luciano Bosotti NL – Johan van der Veer RO – Doina Greavu
<b>Ausschuss für Patentedokumentation</b> Ordentliche Mitglieder	<b>Patent Documentation Committee</b> Full Members	<b>Commission documentation brevets</b> Membres titulaires
AT – Birgitta Gassner	DK – Peter Indahl*/** FI – Tord Langenskiöld	IE – Brian O'Neill
Stellvertreter	Substitutes	Suppléants
FR – Jean-Robert Callon de Lamarck	GB – John Gray IT – Alessandro Guerci	NL – Bart van Wezenbeek
<b>Interne Rechnungsprüfer</b> Ordentliche Mitglieder	<b>Internal Auditors</b> Full Members	<b>Commissaires aux Comptes internes</b> Membres titulaires
	CH – Hansjörg Kley	FR – Philippe Conan
	Stellvertreter	Substitutes
		Suppléants
		LI – Bernd-Günther Harmann
<b>Wahlausschuss</b>	<b>Electoral Committee</b>	<b>Commission pour les élections</b>
CH – Heinz Breiter	CH – Markus Müller*	IS – Árni Vilhjálmsson
<b>Ständiger Beratender Ausschuss beim EPA (SACEPO)</b> epi-Delegierte	<b>Standing Advisory Committee before the EPO (SACEPO)</b> epi Delegates	<b>Comité consultatif permanent auprès de l'OEB (SACEPO)</b> Délégués de l'epi
BE – Francis Leyder DE – Gabriele Leißler-Gerstl FI – Antero Virkkala	GB – Jim Boff GB – Chris Mercer GB – Simon Wright IT – Luciano Bosotti	LU – Sigmar Lampe NL – Antonius Tangena RO – Mihaela Teodorescu
<b>SACEPO – Arbeitsgruppe Regeln</b>	<b>SACEPO – Working Party on Rules</b>	<b>SACEPO – Groupe de travail Règles</b>
BE – Francis Leyder	GB – Chris Mercer	LU – Sigmar Lampe
<b>SACEPO – Arbeitsgruppe Richtlinien</b>	<b>SACEPO – Working Party on Guidelines</b>	<b>SACEPO – Groupe de travail Directives</b>
DE – Gabriele Leißler-Gerstl	DK – Anette Hegner	GR – Manolis Samuelides
<b>SACEPO – PDI</b>	<b>SACEPO – PDI</b>	<b>SACEPO – PDI</b>
AT – Brigitta Gassner	DK – Peter Indahl FI – Tord Langenskiöld	IR – Brian O'Neill

\*Chair/\*\*Secretary



**New  
Edition**

## **Key to the European Patent Convention Clé pour la Convention sur le brevet européen Schlüssel zum europäischen Patentübereinkommen**

Stephan C. Fritz, Elisabeth K. Grünbeck, Ali Hijazi

Edition 2014

Classification of the case law of the Boards of Appeal of the EPO by using selected key words taken from the Articles and Rules of the EPC (closing date for inclusions: November 2013).

**Available in English. Disponible en français. In Deutsch erhältlich.**

Useful for everyday work and for preparing the European qualifying examination.  
Available as a **book** or on **CD-ROM** as an **eBook** including full text of the decisions.

Further details and electronic extracts: <http://www.key2epc.com>  
Contact: [info@key2epc.com](mailto:info@key2epc.com)

**Patent search is a matter of trust.**

**This is why we show you our best – our researchers:  
engineers, natural scientists and patent examiners.**



**Eidgenössisches Institut für Geistiges Eigentum  
Institut Fédéral de la Propriété Intellectuelle  
Istituto Federale della Proprietà Intellettuale  
Swiss Federal Institute of Intellectual Property**

Stauffacherstrasse 65/59 g | CH-3003 Bern  
T +41 31 377 77 77  
F +41 31 377 77 93  
[ip-search@ipi.ch](mailto:ip-search@ipi.ch) | [www.ip-search.ch](http://www.ip-search.ch)

NEU

# „Schultes Neunte“



- kostenloser Online-Zugriff
- durchsuchbar wie eine Datenbank
- verlinkt mit Normen und Entscheidungen



Mit PatNovG 2013

Die Kommentierung anhand der deutschen und europäischen Rechtsprechung ist ganz auf die Bedürfnisse der Praxis ausgerichtet: Bündige Kürze, klare Sprache und Übersichtlichkeit der Darstellung zeichnen das Werk aus. Deutsches und europäisches Recht werden in den harmonisierten Bereichen gemeinsam erläutert. Auf Abweichungen wird jeweils hingewiesen. Wo beide Rechte sich unterscheiden, sind sie getrennt dargestellt.

#### Der Herausgeber:

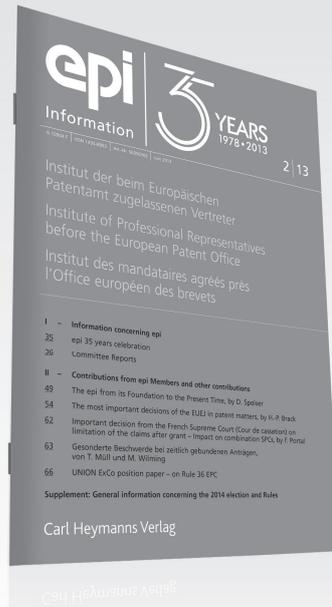
Dr. Rainer Schulte ist Vorsitzender der juristischen Beschwerdekammer des EPA und Richter am Bundespatentgericht i.R.

Die 9. Auflage – ein Standardwerk für jeden Praktiker – bringt den Kommentar auf den neuesten Stand und berücksichtigt alle gesetzlichen Änderungen, insbesondere:

- das Patentnovellierungsgesetz (PatNovG) mit den zahlreichen Änderungen von PatG, PatKostG, IntPatÜG;
- die Verordnung zur Änderung von ERVDPMAV, DPMVA, EAPatV, PatKostZahlVO, DPMVAVerwKostV;
- die neue EuGVVO.

Schulte  
**Patentgesetz mit Europäischem Patentübereinkommen**  
 Kommentar  
 9. Auflage 2013, 3.016 Seiten, gebunden, inkl. jBook, €228,- ISBN 978-3-452-27586-8  
 Heymanns Kommentare

Online im Shop bestellen:  
[www.carl-heymanns.de](http://www.carl-heymanns.de)  
 Gebührenfreie Bestellhotline:  
**0800 7763665**  
 Im Buchhandel erhältlich.



**epi Information**

**Auflage:** 10.700 Exemplare

**Erscheinungsweise:** 4 x jährlich

**Mediaberater:**

Karsten Kühn

Media Sales Manager

Tel.: 0221 94373-7797

kkuehn@wolterskluwer.de

Format	Breite x Höhe	Preis
<input type="checkbox"/> 1/1 Seite *	210 mm x 297 mm	€ 2.995,-
<input type="checkbox"/> 1/2 Seite *	186 mm x 134 mm	€ 1.595,-
<input type="checkbox"/> 1/2 Seite *	92 mm x 270 mm	€ 1.595,-
<input type="checkbox"/> 1/4 Seite	92 mm x 134 mm	€ 845,-
<input type="checkbox"/> 1/4 Seite	186 mm x 65 mm	€ 845,-
<input type="checkbox"/> 1/8 Seite	92 mm x 65 mm	€ 495,-

**\*SONDERAKTION bei Buchung bis 31.12.2014:**

Der **Farbzuschlag** in Höhe von 3 x € 299,- **entfällt.**

<input type="checkbox"/> <b>Einhefter:</b> 4 Seiten, Heftmitte	€ 5.545,-
--	-----------

	Preis pro Tausend
<input type="checkbox"/> <b>Beilagen:</b> bis 25 g (min. 105 x 150 mm – max. 200 x 290 mm)	€ 399,-
je weitere 5g:	€ 30,-

**Zeitschriftenformat:** 210 mm x 297 mm · Satzspiegel: 186 mm x 270 mm · Anschnitt: 216 mm x 303 mm

**Ablauf:** Nach der Buchung erhalten Sie eine Auftragsbestätigung mit der Nachricht, welche Informationen und Daten wir von Ihnen benötigen. **Preis:** Alle Preisangaben zzgl. ges. MwSt. **AE:** Der Verlag gewährt 15% Mittler-Agenturprovision auf den Nettopreis. **AGB:** Für unsere Vertragsabschlüsse und Anzeigenaufträge gelten unsere AGB, die Sie unter <http://www.wolterskluwer.de/kontakt/mediadaten/agb> finden. Ausgenommen von diesem Angebot sind bestehende Sondervereinbarungen.

Name / Firma / Kanzlei

Ansprechpartner

Straße, Hausnummer

PLZ/Ort

Telefon

E-Mail

Ort, Datum

Unterschrift

Wolters Kluwer Deutschland GmbH

Luxemburger Str. 449 ■ 50939 Köln ■ E-Mail: [anzeigen@wolterskluwer.de](mailto:anzeigen@wolterskluwer.de) ■ Telefon: 0221 94373-7797 ■ Fax: 0221 94373-17797

Sitz der Gesellschaft: Köln ■ HRB 58843 Amtsgericht Köln

Geschäftsführer: Dr. Ulrich Hermann (Vorsitz), Michael Gloss, Christian Lindemann, Frank Schellmann ■ USt.-ID.Nr. 188836808

# Heymanns Gewerblicher Rechtsschutz

Das Spezialistenportal für Patentanwälte  
und Anwälte im Gewerblichen Rechtsschutz

NEU  
Jetzt mit neuester  
JURION-Technologie!



[www.gewerblicher-rechtsschutz.de](http://www.gewerblicher-rechtsschutz.de)

Mit den führenden Standardkommentaren  
**Schulte, Patentgesetz; Ströbele/Hacker,**  
**Markengesetz** und **Singer/Stauder, EPÜ**  
aus dem Carl Heymanns Verlag.

**Jetzt 4 Wochen kostenlos testen!**

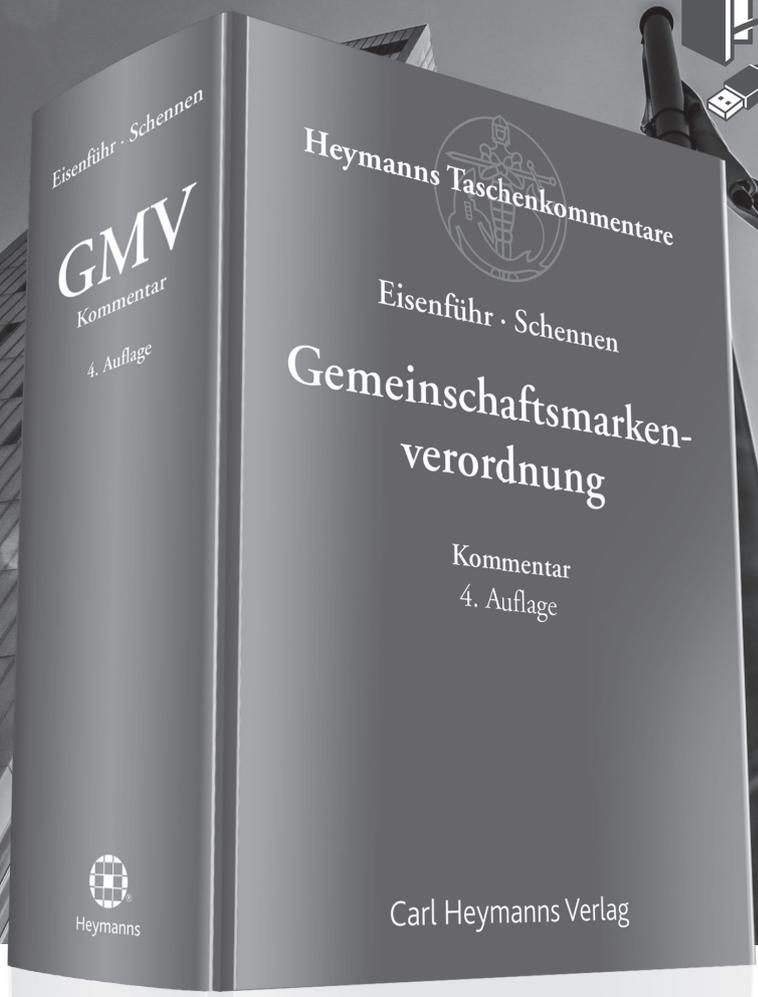


NEU

# Der bewährte Kommentar aus europäischer Perspektive

Der erste zur GMV bereits in 4. Auflage!

inklusive  
**jBook**  
www.jurion.de



### Der Kommentar

konzentriert sich unter weitgehendem Verzicht auf wissenschaftliche Streitfragen, gleichwohl nicht ohne kritische Beleuchtung, darauf, wie sich das Gemeinschaftsmarktrecht heute in der Praxis des Amtes und der Rechtsprechung des EuGH darstellt.

### Das erweiterte Autorenteam:

PA Dipl.-Ing. Günther Eisenführ, Dr. Detlef Schennen, RA Dr. Julian Eberhardt, RAIn Marlene Feddermann, RA Harald Förster, RAIn Yvonne Holderied, RAIn Dr. Stefanie Overhage, RA Ulrich Sander

„Der ‚Eisenführ/Schennen‘ bringt seinen Nutzer schnell auf den Stand der Entscheidungspraxis des HABM und der Rechtsprechung. Er bleibt damit die unerlässliche Hilfe für alle, die mit den erforderlichen Vorprüfungen und der Anmeldung selbst, mit Widerspruchsverfahren und weiteren Streitigkeiten hinsichtlich der Gemeinschaftsmarke befasst sind.“

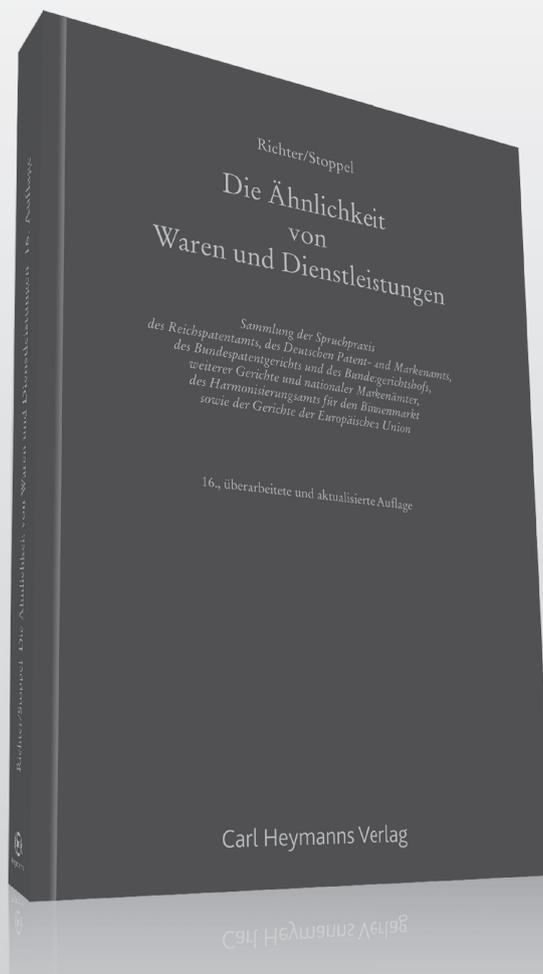
RA Constantin Rehaag, Frankfurt/Main, zu Voraufgabe in: Mitteilungen 04/11

Eisenführ/Schennen  
**Gemeinschaftsmarkenverordnung**  
Kommentar  
4. Auflage 2014, 2.020 Seiten, gebunden, inkl. jBook, € 218,-  
ISBN 978-3-452-27896-8  
Heymanns Taschenkommentare

Online im Shop bestellen:  
**www.carl-heymanns.de**  
Gebührenfreie Bestellhotline:  
**0800 7763665**  
Im Buchhandel erhältlich.

NEU

# Das Standardwerk zur Beurteilung von Kollisionsfällen



Der „Richter/Stoppel“ bietet eine alphabetisch geordnete Auflistung aller Waren und Dienstleistungen, deren Ähnlichkeitsverhältnis zu anderen Waren oder Dienstleistungen Gegenstand der hier erfassten Spruchpraxis gewesen ist. Ausgewertet werden u.a. Entscheidungen des BPatG und BGH sowie Entscheidungen aus Österreich, der Schweiz, den Widerspruchsabteilungen und Beschwerdekammern des HABM in Alicante und der Gerichte der Europäischen Union.

Für die Neuauflage wurden aus den Entscheidungen zur Markenkollision nahezu 800 neue Ähnlichkeitsfälle eingearbeitet, wobei der quantitative Schwerpunkt wie schon in den Vorjahren immer mehr bei der Spruchpraxis des HABM und den europäischen Institutionen liegt. Selbstverständlich hat auch die Entscheidung des EuGH in Sachen „IP Translator“ Berücksichtigung gefunden, da es hierbei nicht nur um die Abfassung von Waren- und Dienstleistungsverzeichnissen geht, sondern vor allem um die Auslegung von Oberbegriffen der Nizzaer Klassifikation und damit den Schutzzumfang von Marken und das Verhältnis von Waren und Dienstleistungen zueinander.

Richter/Stoppel  
**Die Ähnlichkeit von Waren und Dienstleistungen**  
 16. Auflage 2014, 450 Seiten, Leinen,  
 € 178,-  
 ISBN 978-3-452-27996-5

Online im Shop bestellen:  
[www.carl-heymanns.de](http://www.carl-heymanns.de)  
 Gebührenfreie Bestellhotline:  
**0800 7763665**  
 Im Buchhandel erhältlich.

# Das komplette Wissen für Beruf und Patentanwaltsprüfung



- kostenloser Online-Zugriff
- durchsuchbar wie eine Datenbank
- verlinkt mit Normen und Entscheidungen



Im Mittelpunkt des Handbuchs steht das Rüstzeug für den Patentanwaltsberuf: die Vertretung und Beratung von Mandanten, das Mandatsverhältnis (Vertrag, Vergütung und Haftungsfragen) bis hin zur Vertragsgestaltung und den berufsrechtlichen Pflichten.

An Fallbeispielen und Abbildungen wird alles erläutert, was ein Patentanwalt für den Berufsalltag und ein Bewerber für die Patentanwaltsprüfung benötigt, insbesondere die nationalen und internationalen Schutzrechtssysteme.

Die 4. Auflage berücksichtigt die neusten Entwicklungen in Rechtsprechung und Gesetz und deren Auswirkungen auf die tägliche Praxis des Patentanwalts. Berücksichtigt sind insbesondere PatNovG und das neue Designgesetz sowie das EU-Patent-Reform-Paket zum Einheitspatent und einheitlichen Patentgericht.

#### Der Autor:

*Prof. Dr. Ing. Dr. Jur. Uwe Fitzner* ist Patent- und Rechtsanwalt in Ratingen.

Fitzner

#### Der Patentanwalt

Beruf und Beratung im gewerblichen Rechtsschutz

4. Auflage 2014, ca. 650 Seiten, gebunden, inkl. jBook, ca. € 118,-

ISBN 978-3-452-28133-3

Im Vorbereitung für Juli 2014

Online im Shop bestellen:

[www.carl-heymanns.de](http://www.carl-heymanns.de)

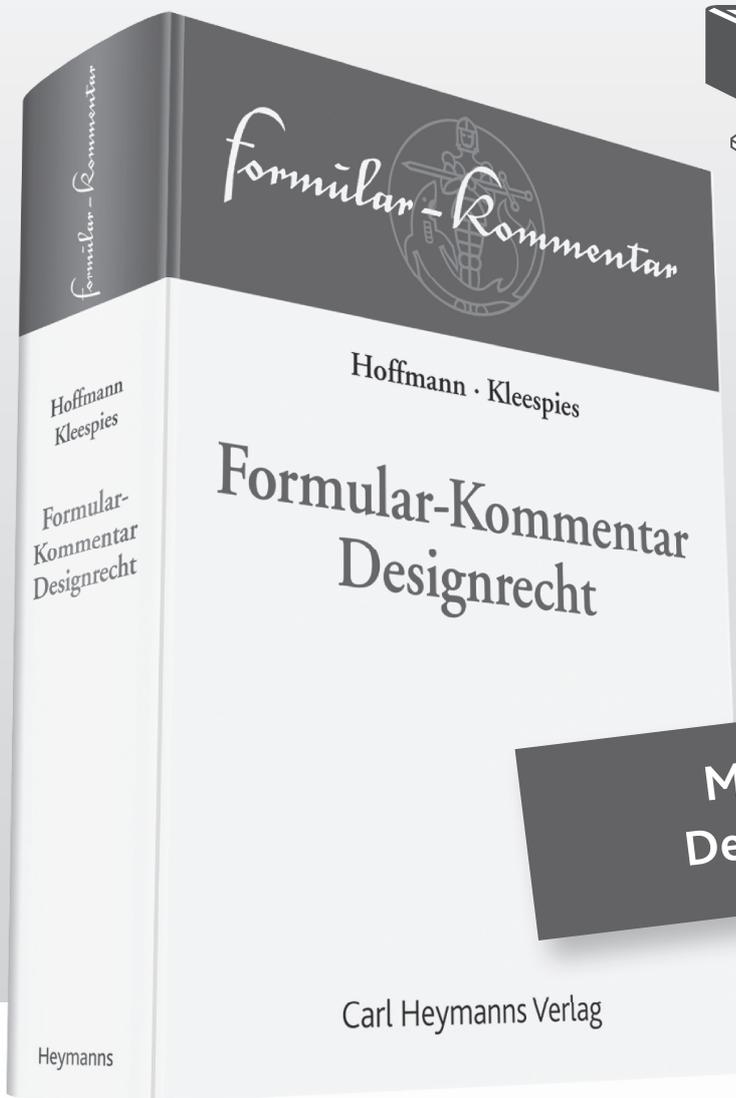
Gebührenfreie Bestellhotline:

**0800 7763665**

Im Buchhandel erhältlich.

NEU

# Die einzigartige Darstellung des vollständigen Designrechts



inklusive  
**jBook**  
 www.jurion.de



- kostenloser Online-Zugriff
- durchsuchbar wie eine Datenbank
- verlinkt mit Normen und Entscheidungen

**Mit neuem  
 Designgesetz**

Das Werk liefert eine in dieser Form einzigartige Darstellung des vollständigen Designrechtes mit seinen Bezügen zum Urheber- und Wettbewerbsrecht anhand kommentierter Muster und Formulare.

Die Gliederung orientiert sich an den typischen Stationen der Praxis:

1. Schutzerlangung für Designleistungen,
2. Durchsetzung der Rechte im Verletzungsfall sowie
3. wirtschaftliche Verwertung von Designleistungen.

Praktiker finden gezielte Handlungsanleitungen zu den wichtigen Fragen der Anmeldeverfahren vor den Ämtern (DPMA, HABM, WIPO), der Verletzungsverfahren vor den Gerichten sowie zur Vertragsgestaltung für die erfolgreiche Kommerzialisierung von Designerleistungen.

Sämtliche Vorlagen ermöglichen dem Nutzer eine schnelle und sichere Lösung für den Einzelfall ohne dabei das Gesamtbild aus dem Blick zu verlieren. Zahlreiche Schautafeln und Übersichten erleichtern den Überblick. Viele Praxis- und Strategietipps vermitteln Spezial-Know-how.

Hoffmann/Kleespies  
**Formular-Kommentar Designrecht**  
 2014, ca. 900 Seiten, gebunden,  
 inkl. jBook, ca. € 188,-  
 ISBN 978-3-452-27840-1  
 In Vorbereitung für Juli 2014

Online im Shop bestellen:  
[www.carl-heymanns.de](http://www.carl-heymanns.de)  
 Gebührenfreie Bestellhotline:  
**0800 7763665**  
 Im Buchhandel erhältlich.

## Vorstand / Board / Bureau

---

Präsident / President / Président

NL – Antonius Tangena

---

Vize-Präsidenten / Vice-Presidents / Vice-Présidents

DE – Gabriele Leißler-Gerstl

RO – Mihaela Teodorescu

---

Generalsekretär / Secretary General / Secrétaire Général

PT – João Pereira da Cruz

---

Stellvertretender Generalsekretär /

Deputy Secretary General / Secrétaire Général Adjoint

CH – Michael Liebetanz

---

Schatzmeister / Treasurer / Trésorier

BE – Claude Quintelier

---

Stellvertretender Schatzmeister / Deputy Treasurer

Trésorier Adjoint

CZ – František Kania

## Mitglieder / Members / Membres

---

AL – Vladimir Nika

AT – Friedrich Schweinzer

BG – Natasha Andreeva

CY – Christos A. Theodoulou

DE – Lothar Steiling

DK – Bo Hammer Jensen

EE – Margus Sarap

ES – Luis-Alfonso Durán Moya

FI – Marjut Honkasalo

FR – Jacques Bauvir

FR – Laurent Nuss

GB – Edward Lyndon-Stanford

GB – Simon Wright

GR – Vassiliki Bakatselou

HR – Davor Bošković

HU – Ádám Szentpéteri

IE – Lindsay Casey

IS – Thorlakur Jonsson

IT – Paolo Rambelli

LI – Burkhard Bogensberger

LT – Reda Zaboliene

LU – Bernd Kutsch

LV – Jevgenijs Fortuna

MC – Günther Schmalz

MK – Valentin Pepeljugoski

MT – Luigi Sansone

NO – Dag Thrane

PL – Anna Slominska-Dziubek

RS – Slobodan Petosevic

SE – Lars Estreen

SI – Gregor Macek

SK – Dagmar Cechvalová

SM – Andrea Tiburzi

TR – Selda Arkan

