epi Information

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Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

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Table of Contents

Editorial

T. Johnson (GB)

August being the month in which this is being written, and also being the holiday season, we on the Editorial Committee hope all our readers are having, or have had, a pleasant and restful holiday period. As the British member of the Committee I hope our non-GB residents are having better summer weather than we are experiencing in GB. Perhaps climate change is the cause, and also perhaps the EPO's policy of enhancing the patenting of green technology may bear fruit in bringing about better weather at the proper time!

For those in need of holiday stimulation the European Commission produced at the end of May Communication COM (2011) 287 final, addressed to the European Parliament, the Council, the European Economic and Social Committee, and the Committee of the Regions. As readers will probably know the Communication sets out an over-arching strategy for a single market for IPRs. Patents are a key part of this strategy, which as readers will know, includes work to create a unitary patent protection system for Europe. This will naturally involve the EPO as the body which will create unitary patent protection, this protection enabling companies, particularly SMEs, to have significant cost savings. It is hoped that cost savings will be achieved *inter alia* by obviating the need to validate a granted EP nationally. Moreover, the EPO has a programme for machine translation of patent documents which the EC Communication welcomes and promotes. These measures are essentially post-grant. However, the examination procedure at the EPO is crucial to the strategy and will play an essential part in realising it. We hope therefore that there will be continuing and developing EPO/Institute co-operation so that examination is consistent across all technologies leading to the grant of effective patents for the benefit of business. A positive example of this is in the field of biotechnology, a report of an EPO/*epi* meeting being detailed elsewhere in this issue.

We on the Editorial Committee would also like to add our warm thanks and appreciation to Ms Monéger, recently retired from long service in the Secretariat. As readers will know, she worked diligently for the Institute in general, but we on the Editorial Committee had our work made much easier by her efforts in effectively being our secretary, and also in organising publication of each issue of this Journal. A big thank you to her for all her work from which the whole membership benefited. We wish her a long and happy retirement.

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 **28. Oktober 2011**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi* Information is **28th October 2011**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de l'*epi* Information est le **28 octobre 2011**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Minutes of EPO/*epi* Meeting on 15 November 2010

S. Wright (GB)
Secretary of Biotech Committee

In Attendance:

Thanos Stamalopoulos (GR)
Bernd Isert (BI, dir. 2404)
Uli Thiele (UT, dir. 2402)
Siobhán Yeats (SY, dir. 2403)
Victor Kaas (VK, dir. 2401, Munich)
Francisco Fernandez y Brañas, dir. 1222, The Hague)
Sjoerd Hoekstra (SJH, dir. 1223 – The Hague)
Maria Fotaki (MF, dir. 2405, Munich)
Aliki Nichogiannopoulou (AN, dir. 2406 , Munich)
Bertrand Gellie (BG, dir. 2101, JC PAOC, Munich)

Ann De Clercq (AdC) – BE
Bo Hammer Jensen (BHJ) – DK
Günter Keller (GK) – DE
Bart Swinkels (NL) – BS
Simon Wright (SW) – GB

Associate Members

Hans-Rainer Jaenichen (HRJ) – DE
Gabriele Leissler-Gerstl
(GLG, liaison member of EPPC) – DE

Introduction

A welcome was given by EPO. The EPO wants to be open, and offer the best possible service, but equally welcomes sensible criticism.

1. Stem cells/WARF decision

G2/06 needs to be interpreted by examiners working on embryonic stem cell files. The Directors had considered the matter with the EPO's legal department and had issued an internal instruction paper to Examiners. In principle patents may be granted for cells which could be prepared at the filing date (e.g. by using established cell lines available from a cell bank) without destroying human embryos. There is, though, an on-going issue, which is the earliest date that the EPO accepts when embryonic stem cell lines become publicly available (this now seems to be 9 May 2003). For adult and foetal stem cells, there are no special criteria for patentability.

In this regard there is an interesting European Application No. 03751238.1 (Technion). This was before the Technical Board of Appeal, and the grounds of appeal were filed on 15 August. The issue here is when a skilled person in the art had access to stem cell lines.

In the Hague one Examiner has also investigated cell line availability, and decided on 9 May 2003 as a cut-off. This decision is public, as is the detective work, and it is on Application No. 05740642.3 (Axiogenesis). There were convincing attorney arguments.

For cases with later filing dates, perhaps 2005 and 2006 and later, it is more likely that the availability of established human embryonic stem cell lines will not be an issue.

In the WARF case the EPO's Board of Appeal decided not to consult the CJEU since it considered that the EPO was not bound by the CJEU. The *epi* thinks that the EU cannot condemn research that they are effectively funding. It was noted that Mr.Messerli, currently head of MBA, wondered whether any ECJ decision (e.g. concerning Brustle) would apply to Switzerland, a non-EU state.

2. G1/07 and G2/07 Plant decisions

These are expected before the end of the year[1].

3. Amended Rule 71(3) procedure

The new Rule 71 and 71(a) will come into force in April 2012. The procedure is now closer to the 2002 original procedure, and more flexible since an applicant will not have to file translations of the claims if challenging the text. There now seems to be a reasonable compromise between attorney concerns on amendments and the EPO's desire to get cases to grant.

Examiners often phone attorneys to discuss changes, and are encouraged to do so at this stage. Attorneys don't always revert back particularly quickly, though (mainly because they need instructions from their clients). Some Examiners just make the changes in writing anyway, and then leave the attorney to contact the client about the amendments.

Epi members will later receive the minutes of a telecon, and then they can be set one or two months to respond. Examiners may, however, need some explanation as to why applicants need all the various different types of claims.

Separately, the EPO said that there are a lot of young, capable, Examiners who were being encouraged to take the EQE, although not all succeed.

4. Summons to Oral Proceedings

The Hague, in particular, had seen a sharp increase in Summons. However, about 90 % of Oral Proceedings got cancelled before they take place. Oral proceedings are actually held in 2 % of all biotech cases (the figure for the EPO is 1 %).

1 In the meanwhile these decisions have become public

The EPO encourages Examiners not to write 5, 6 or 7 Office Actions, but to issue a Summons sooner, so there shouldn't be so many Office Actions. The *epi* noted, though, that applicants often get new objections in the second Examination Report, for example new prior art. The EPO said that if new technical features are placed in the claims, the Examiner may want to conduct a top up search.

The EPO said that there are half as many Office Actions for non-biotech cases (often before a summons). The problem is often a functional definition in the claims (it was noted that in many cases chemistry is easier). The *epi* said that often a function is the best way of defining the invention, but this can be more difficult to search. The EPO has a quality review system, where 10 %-15 % of cases proposed for grant by the primary examiner have a separate review at the grant stage. Of course, the Primary Examiner still has to convince the other two Examiners.

5. New EPO Rules

Rule 161 is going to be amended from 1 month to 6 months[2], which fact is welcomed by the *epi*. It has been noted that many US applicants have stopped using the EPO, as the ISA. This may reverse, and lengthening the deadline may help.

The *epi* thinks that many of the objections we get are far too formalistic: there are lots of objections to clarity and added matter and Examiners often say that they have not searched the feature if it is later taken from the description. According to the *epi*, "Raising the Bar" had originally been intended to raise the bar for inventive step, but had not done so.

Many applicants will precautionarily file a divisional application before two years, just in case, as they do not know how the examination procedure is going to work out.

For Rules 62a and 63, the EPO had sent about 50 communications under either Rule, so only about 2 % of all cases. Mr Thiele had two cases, and good experience of them. He suggested he would only use Rules 62a/63 when it is really needed. So if there is a broad claim and he can see a clear fall-back, then the EPO may not bother.

The EPO wants to get on with the search. Sometimes one might get amended claims, but the EPO cannot formally take them into account.

The EPO considered it an abuse to withdraw the parent before refusal, and then file a divisional application. There could be other ways of dealing with this (for example, you can't file the divisional until the parent case is closed).

Apparently the previous divisional Rules had been abused. Ms Brimelow had been convinced about the bad behaviour of US applicants, particularly in the area of computers, which allegedly prolonged uncertainty.

Separately, Mr Thiele said that anything from an applicant that looks like a complaint goes to DQMS. However, the Formalities Officer is usually the first filter.

6. Lack of unity

No additional search fees can be paid now for Euro-PCT applications. The EPO produced some statistics where it is suggested that the number of lack of unity objections has stayed constant. Examiners are told, though, not to be too formalistic.

The *epi* asked the EPO to please try and search all the inventions, especially if little additional effort was needed.

Rule 36(b) won't be applied harshly, but we will just have to see how practice under the new Rule develops. The EPO was requested to be clear on what lack of unity objection is being made (or not).

7. Auxiliary Requests (ARs)

This issue was considered as part of raising the bar, and may result in a future change in the Guidelines. The *epi* made a plea not to be refused discretion to amend at the Oral Proceedings. However, there had been no instructions from Directors in the Biotech Group to do this.

The EPO asked for a reasonable approach from applicants. Seventeen ARs may be too many, but if the Examiner objects to not having enough he may get more next time round!

9. Sequence Listings

The EPO explained that a request for a listing can be made up to 4 years or later after filing, if a Formalities Officer only discovers one is missing much later. Some requests were wrongly made; in these cases, the applicants will have their late filing fees refunded.

Divisionals apparently need fresh sequence listing. The Directors took legal advice from DG5.

The software Patenting was developed with the US PTO, but the EPO will in future use a new program developed by EU and WIPO[3].

10. Use of laptops at Oral Proceedings

The EPO confirmed that, in principle this is no problem. Attorneys just need to announce that there will be no sound recording. As far as colour drawings are concerned, we should say that something is in colour, and ask the EPO to please scan it in colour. Or we could file it on disk, or electronically. Animation is also fine: again, we just need to announce this in advance.

The meeting closed at 12:30.

2 This amendment to R. 161 EPC is now in place

3 This new software is now available

European Patent Practice Committee

F. Leyder (BE)
Chair of EPPC

This report covers the most important items since my previous report dated 15.01.2011.

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

The EPPC is presently organised with seven permanent sub-committees (EPC, Guidelines, MSBA, EPO-*epi* Liaison, PCT, Trilateral & IP5, and Unitary Patent). Additionally, *ad hoc* working groups are set up when the need arises. The matter of EPA-Client Privilege has been taken over by the Litigation Committee.

1. EPPC meeting:

The Committee met on 20.06.2011. The main purpose of the meeting was to organise the committee after the election of the full members for the 2011-2014 term and to inform the members about the activities of the EPPC.

2. Working plans for the next months

A meeting before the Darmstadt Council appeared too close, and it was agreed to have the next EPPC meeting early 2012. Sub-committees or *ad hoc* working groups can meet if and when needed.

EPC

3. SACEPO WPR5:

The 5th meeting of the SACEPO Working Party on Rules was held on 19.05.2011. The clear message from the EPO is that no further changes will be implemented before the last ones have been properly evaluated.

GUIDELINES

4. SACEPO/WPG2

The EPO has now -at last- provided us with a draft of their current revision exercise of the Guidelines for Examination in the EPO in preparation for a two-day meeting of the SACEPO Working Party on Guidelines at the beginning of October.

Accordingly, the Guidelines sub-committee will meet in Copenhagen on 08-09.09.2011 in order to instruct the *epi* members of the SACEPO/WPG. The revision exercise is a huge task, as this will be a complete revision of the Guidelines, with a new structure.

MSBA, BOARDS AND ENLARGED BOARD OF APPEAL

5. G2/10 – 'Supported disclaimer':

The question read: "Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?"
The *epi* has not filed an *amicus curiae* brief.

The appellant's representative requested the answer to be: "No, provided there is a clear and unambiguous disclosure of the subject-matter remaining in the claim". In my opinion, this should come close to the answer of the Enlarged Board.

6. MSBA meeting 14.10.2011:

Three papers have already been sent in preparation of the Meeting with the Boards of Appeal (MSBA):
– on non-binding opinions;
– on exclusion of certain documents from public inspection, and
– on anonymisation.
A fourth one is ready, on the criteria for allowing re-establishment of rights.

EPO-*epi* LIAISON

7. VP1 meeting

The *epi* President and two EPPC Vice-Chairs met the new Vice-President DG1 and some of his staff on 09.02.2011.

Review of action points from last year's meeting (main points):
– Delay between submission of amended claims during *ex parte* oral proceedings and their publication: the EPO has introduced a procedure to provide for early information of the public.
– Wireless-lan: instructions on how to connect are available in all break-out rooms.
– Automatic debiting: *epi* will send a short description of its needs regarding the redesign of the EPO's automatic debiting practice.

The main topics discussed this year were:
– Mandate of each *epi*/EPO meeting: it was found that the VP1 meetings should be used to exchange information on practices and policies from both parties and to discuss general issues faced by both parties.
– Implementation and use of the new EPC Rules. The EPO is aware of problems with implementation, some improvement has been announced such as the indi-

cation of the deadline for filing divisional applications in the register and on communications
– Case management.: delay of remitted cases shall be avoided by allocating high priority to them; summons to oral proceedings shall not be sent too early; examiners shall not make amendments unless those that will obviously accepted to avoid loss of time and resources on both sides;
– Praktika extern: has been re-launched.

8. MANUAL OF BEST PRACTICE:

During its meeting on 20.06.2011, the committee reviewed one chapter of the Manual of Best Practice as redrafted by Chris Mercer with assistance of the other *epi* delegates.

The *epi* delegates attended a meeting on 22.06.2011, at which an *epi* draft prepared as counter-proposal was discussed. In general, the atmosphere was positive and constructive. The EPO accepted that the title should be changed and no longer use the expression 'best practice', but no agreement was reached on an alternative.

During the month of July, the EPO reviewed the *epi* draft. At the beginning of August, the EPO returned it to the *epi* with a few proposed amendments, and at the same time sent it to Business Europe for comments.

In the meantime, the Presidium has decided to invite Mr Weaver, representing Ms Lonati who is the Principal Director in charge of the Manual, to the *epi* Board meeting on 10.09.2011. In preparation for that meeting, I have circulated in the EPPC the latest version, visibly showing the last amendments carried out by the EPO, for the EPPC members to send their *substantive* comments to Chris Mercer and to the Board member(s) of their country.

PCT

9. PCT WG4

The 4th session of the PCT Working Group was held in Geneva on 06-10.06.2011. The meeting documents, including the draft report, are available on the WIPO website: http://wipo.int/meetings/en/details.jsp?meeting_id=22683

The WG discussed future development of the PCT system and proposed changes to the PCT procedural and legal framework, in particular a third party observation system, establishing a new WIPO XML Sequence Listing Standard (I have forwarded the relevant meeting document to the Biotech Committee), and proposed amendments of Rules 17.1(b-*bis*) and 20.7(b) PCT.

UNITARY PATENT

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

The European Commission has issued two draft regulations:
– COM (2011) 215/3: Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL implementing enhanced cooperation in the area of the creation of unitary patent protection.
– COM (2011) 216/3: Proposal for a COUNCIL REGULATION implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements.

On 26.05.2011, the HU Presidency issued revised proposals. On 30.05.2011, the Competitiveness Council discussed them and confirmed the broad lines.

On 21.06.2011, the HU Presidency again issued revised proposals. On 27.06.2011, an Extraordinary Competitiveness Council adopted a common general approach on both regulations.

On the same date, there was a first exchange of views in the European Parliament, where a Hearing is planned on 10-11.10.2011.

The unitary patent will be on the agenda of the Board meeting on 10.09.2011, and a meeting of the sub-committee is planned on 22.09.2011.

Miscellaneous

11. AIPLA-*epi* meeting

A delegation of the "IP Practice in Europe" Committee of AIPLA visited Europe and met *epi* delegates on 02.03.2011.

12. EUROTAB 20

This year, the EUROTAB meeting was hosted by the EPO in Munich, on 26-27.05.2011. The main subjects discussed this year were:
– Interaction between Patent Offices and applicants/ representatives: experiences in development and use of concepts of best practice;
– Supplementary protection certificates: national implementation and practice;
– Problems associated with Asian prior art searches;
– Issues of double patenting: in preparation of this agenda item, an *epi* position paper was sent to the EPO and included in the meeting papers.

epi Mock EQEs and *epi* Seminars 2011

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

Scheduled seminars:

03.10.2011	Brussels: "PCT – seminar for paralegals and administrative staff"
07.10.2011	Eindhoven: "Mock oral proceeding"
21.10.2011	Warsaw: "Proceedings before the European Patent Office – legal and formal aspects"
18.11.2011	Berlin: "PCT – seminar for paralegals and administrative staff"
01.-03.11.2011	Helsinki: "Mock EQE"
07.12.2011	Munich: "Patent Portfolio Management"

For further information, please visit our website (*http://www.patentepi.com/patentepi/en/EQE-and-Training/pqc.php*) or contact the *epi* Secretariat (email: *education@patentepi.com*).

Tutors wanted

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

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

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

Double payments of membership fees

C. Quintelier (BE)
epi Treasurer

1. Introduction

In the context of an embezzlement procedure of which *epi* has been the victim, it has come to our attention that double payments have been made by some of the *epi* members. Now that this problem has been identified, a solution on how to deal with this has been discussed and agreed on at the 70th *epi* Council meeting in Dublin on May 23rd to 24th 2011.

2. Decision of *epi* Council taken on 23rd May 2011

"The *epi* Council agreed to pay back double payments made in 2008, 2009 and 2010 upon request of the concerned member"

3. Invitation to the *epi* members

The member, who paid the membership fee twice in 2008, 2009 and 2010, is invited to send evidence of such double payment to the *epi* Secretariat.

Such evidence should mention the name and the professional address of the member at the due date of the payment i.e. at the 4th of January of each of the relevant years. Evidence that the payment was indeed made to the *epi* for the relevant year should also be provided. The member is also invited to indicate the bank data, i.e. account holder, BIC and IBAN number of the account on which the reimbursement should be effected. (Indication of EPO account number is also possible.)

Doppelzahlungen von Mitgliedsbeiträgen

C. Quintelier (BE)
epi Schatzmeister

1. Einleitung

Im Zuge der Unterschlagungsaffäre, von der das *epi* betroffen war, wurde festgestellt, dass einige *epi* Mitglieder Doppelzahlungen geleistet haben. Nach Feststellung dieses Problems wurde, anlässlich der 70. *epi* Ratssitzung in Dublin vom 23. – 24. Mai 2011, die Verfahrensweise diesbezüglich diskutiert und ein Ratsbeschluss gefasst.

2. Beschluss des *epi* Rates vom 23. Mai 2011

„Der *epi* Rat beschließt Doppelzahlungen, geleistet in 2008, 2009 und 2010 auf Antrag des Mitglieds zurückzuerstatten".

3. Aufforderung an die *epi* Mitglieder

Die Mitglieder, die in den Jahren 2008, 2009 und 2010 den Jahresbeitrag zweimal entrichtet haben, werden aufgefordert, den Nachweis über die erfolgten Doppelzahlungen an das *epi* Sekretariat zu übermitteln.

Die Nachweise müssen den Namen und die Berufsadresse des Mitglieds am Fälligkeitstag, das heißt am 4. Januar jedes betreffenden Jahres, beinhalten. Ein Nachweis, dass die Zahlung an *epi* im betreffenden Jahr geleistet wurde ist gleichfalls zu erbringen.

Das Mitglied ist aufgefordert, seine Bankdaten anzugeben, das heißt, den BIC und die IBAN Nummer des Kontos, auf das die Rückerstattung zu erfolgen hat. (Alternativ kann auch die Nummer des EPA-Kontos angegeben werden.)

Double paiements de la cotisation annuelle

C. Quintelier (BE)
Trésorier de l'*epi*

1. Introduction

Dans le cadre d'une procédure de détournement de fonds dont l'*epi* a été victime, nous avons constaté que des doubles paiements ont été effectués par certains membres de l'*epi*. Maintenant que ce problème a été identifié, une solution sur la façon de le traiter a été discutée et adoptée lors de la 70ème Réunion du Conseil de l'*epi* à Dublin du 23 au 24 mai 2011.

2. Décision du Conseil de l'*epi* prise le 23 mai 2011

Le Conseil de l'*epi* approuve que les doubles paiements faits en 2008, 2009 et 2010 seront remboursés sur demande du membre concerné.

3. Invitation aux membres de l'*epi*

Le membre qui, en 2008, 2009 et 2010 a payé sa cotisation annuelle deux fois est invité à envoyer une preuve du paiement de ce double paiement au secrétariat de l'*epi*.

Une telle preuve doit contenir le nom et l'adresse professionnelle du membre à la date d'échéance du paiement c'est-à-dire le 4 janvier de chacune des années en question.

La preuve que le paiement a bien été effectué en faveur de l'*epi* durant l'année en question doit également être fournie.

Le membre est également invité à indiquer le titulaire du compte bancaire ainsi que les numéros BIC et IBAN du compte sur lequel le remboursement doit être effectué. (Il est également possible d'indiquer le numéro du compte auprès de l'OEB.)

European Patent Attorneys Excess Liability

Dear *epi* member,
The Institute of Professional Representatives before the European Patent Office gives all members the possibility to get access to an additional excess professional liability programme.

As from the day you subscribe to this insurance, cover is provided for claims made by reasons of any actual or alleged wrongful act committed within the framework of the Patent Attorney activities.

The indemnity of basic professional liability insurance schemes is often limited to EUR 1.022.584. Therefore, the *epi* excess liability insurance scheme indemnifies losses when they exceed EUR 1.022.584/equivalent (excess liability policy). Its limit of indemnity is further EUR 1.533.876 per loss so that – together with the basic insurance – a total loss of EUR 2.556.460/equivalent is covered. There is a collective indemnity limit to EUR 15.338.756 per year for all participating *epi* members.

The cover runs for 12 months from 1.October of each year. *epi* members joining the scheme in the course of an insurance year will receive an invoice on a pro-rata basis.

The *Funk International GmbH*, which is *epi*'s insurance broker, will be pleased to help if you have any further questions.

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Please do not contact the *epi Secretariat.*

Important Information for *epi* Members having their Place of Registration in Switzerland

We would like to inform you about the "non-admitted-complex of problems".

This topic is relevant for all Swiss Patent Attorneys.

Insurers are not willing to draw risks in Switzerland. Therefore contracts in Switzerland are no longer performed in our excess professional liability programme.

The reason is the "non-admitted" ban initialized through the insurance law of many countries (e.g. Switzerland, Brazil, China). This insurance law obliged to secure risks, which are situated in Switzerland, through an authorized local licensed insurer.

Insurer, policyholder or supervising broker who would violate the local applicable regulatory law must take into account legal consequences of nullity of the insurance cover to the relevance of regulatory and criminal provision relating to companies and persons acting so.

The Swiss Co-Broker *GWP Insurance Brokers AG* is responsible for future contracts.

Please use the following contact details:

GWP Insurance Brokers AG
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3073 Gümligen
Switzerland

Contact person: Mr Stefan Engeler
Phone: +41 31 959 00 02
Fax: +41 31 959 00 19

epi Artists Exhibition 2012

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

6 February to 18 February 2012
at
European Patent Office
PschorrHöfe building
Bayerstrasse 34, 80335 Munich.

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

For information please contact:
epi Secretariat
Jacqueline Kalbe
P.O. Box 26 01 12
80058 Munich
Germany

Tel: +49 89 24 20 52-11
Fax: +49 89 24 20 52-20
Email: info@patentepi.com

New contact data of Legal Division
Update of the European Patent Attorneys database

For the attention of all epi members

Kindly note the following new contact data of the Legal Division of the EPO (Dir. 523):

European Patent Office
Dir. 523
Legal Division
80298 Munich
Germany

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

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

Thank you for your cooperation.

Next Board and Council Meetings

Board

86th Board Meeting: 17th March 2012, Brussels (BE)

Council

71st Council Meeting: 5th November 2011, Darmstadt (DE)
72st Council Meeting: 28th April 2012, Athens (GR)

New Council Members from Serbia (RS)

The following Serbian representatives have been appointed to the epi Council by the EPO President:

Full Members:

Mr Dejan Bogdanovic
Mr Slobodan Petosevic

Substitute Members:

Mr Uros Plavsa
Mr Zoran Zivkovic

Change of Practice

Ms Anne SCHOUBOE (DK) who was elected Council member for Denmark for private practice has gone to industry as from 1 September, 2011. She therefore resigned from her position in Council.

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

"A Truth Universally Acknowledged …" Still? Double Patenting at the EPO, Current Status

T. Bremi (CH)[1] and D. Harrison (GB)[2]

1. Introduction

About two years ago we published in *epi* Information 2/09 a rather critical article on the topic of double patenting which was initiated by the controversial decision T307/03 taken on 3.7.2007, published in the Official Journal in 2009.[3] At that time we questioned whether indeed there is a legal basis for or a generally accepted principle of prohibition of double patenting before the EPO, be it based on Art. 60 as stated in reasons 2.1 of T307/03:

> Article 60 EPC (identically worded under the EPC 1973 and 2000) states "The right to a European patent shall belong to the inventor or his successor in title" … From this the Board deduces that under the EPC the principle of prohibition of double patenting applies and that the inventor (or his successor in title) has a right to the grant of one and only one patent from the European Patent Office for a particular invention as defined in a particular claim. Once a patent has been granted to the inventor (or his successor in title) this right to a patent has been exhausted, and the European Patent Office is entitled to refuse to grant a further patent to the inventor (or his successor in title) for the subject-matter for which he has already been granted a patent.

or based on some other general principle called "legitimate interest" as suggested in the obiter observation in G 1/06 reasons 13.4:

> The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor.[4] Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent….

We found in our article that T307/03 created a great deal of uncertainty since it was going against established case law such as T 118/91, T 587/98 but also against the Guidelines (C IV 7.4 and C VI 9.1.6) which allow for overlapping claims in a parent patent and a divisional as long as the claims are not essentially identical. Graphically the situation of scopes of claims in parent and divisional in view of the decision T307/03 was then summarized as given in Figure 1.

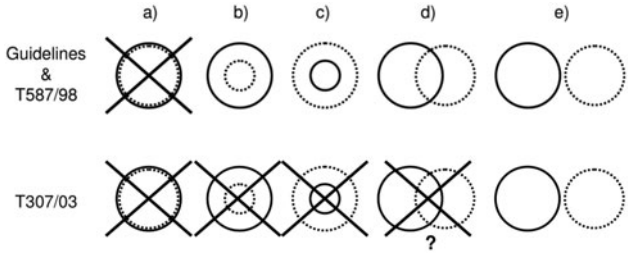

Figure 1: Schematic representations of possible relationships between claims of a parent (solid line) and a divisional (dotted line).[5]

It was concluded at that time that due to the conflicting decisions there was legal uncertainty and that hopefully T307/03 would not be followed. Now that some time has lapsed and further decisions have issued (none of them officially published in the OJ), it seems appropriate to analyse the development after T307/03 and look at the consequences for applicants. The most important decisions taken after T307/03 and dealing with the question of double patenting will thus briefly be presented and the findings summarized with reference to the above situations a) – d) in Figure 1.

2. Recent case law in relation to divisional applications

For the case of partial overlap of the scopes of the claims of parent and divisional (above scenario d), which after T307/03 seemed unclear, T1391/07, dated 7.11.2008, appears key.

This decision was dealing with a situation where a divisional application which was the last of a chain with two sequential parent applications, both granted, was refused by the examining division for the reason that the subject matter of the main claim of this divisional application was not "clearly distinguishable from that of claim 1 of the parent". The application was thus refused for double patenting also with reference to GL C VI 9.1.6. The Board disagreed and found the claims to be

1 European Patent Attorney, Isler & Pedrazzini AG, CH; email: *tobias.bremi@islerpedrazzini.ch*; judge at the Swiss federal patents court. The statements made in this article reflect the author's personal opinion.

2 European Patent Attorney, Mewburn Ellis LLP, GB; email: davidc.harrison@virgin.net

3 OJ 7/2009, p 422–433

4 The notion of legitimate interest seems borrowed from civil procedural principles (Rechtsschutzinteresse), where it is a mandatory requirement for a case to be handled by a judicial body, similar to the "adversely affected" (Beschwerde) to be entitled to appeal a decision before the EPO. Interestingly this principle is not applied in other situations before the EPO, so no need of legitimate interest has to be proven in case an opposition is filed, and G4/97 (Straw man) rather seems to expressly deny the requirement of such an interest.

5 Source: D. Harrison, T. Bremi, *epi* information 2/2009, p64–68.

"distinguishable" and, referring to the Guidelines, to a list of old case law, as well as to G 1/06[6], finds that a refusal for double patenting is only justified if *the same invention is claimed*[7] in parent and divisional. It expressly goes even further and states that there is

> …no basis to extend this practice to cover claims not defining the same subject-matter but conferring a scope of protection overlapping with each other only partially in the sense that some, but not all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims.[8]

The decision is followed by T877/06 dated 2.12.2009. Unfortunately neither of the two decisions expressly mentions and distinguishes from T 307/03. Nevertheless it seems these decisions clarify that in case of above scenario d) of partial overlap there can be no double patenting.

For the case of a divisional having a scope broader and fully encompassing the scope of the parent (above scenario c), which after T307/03 seemed unclear, T422/07 dated 7.12.2009 appears relevant. While actually in this case the claims of the divisional, again the last of a chain of three sequential applications, only partially overlapped with the claims of the parent, the Board expressly states that

> … no abuse can be identified in the mere fact that the claims of the application on which the examining division had then to decide had a broader scope than the claims granted in relation with the parent application.[9]

Again unfortunately this decision does not expressly mention and distinguish from T 307/03. Nevertheless it seems to make clear that also above scenario c) should not be one of double patenting. From a practical point of view, this is a very important clarification as often in case of an infringer being early on the market one wants to bring a parent application quickly to grant. One can do so by narrowing down the claims to clearly allowable subject matter with the aim of swiftly getting a granted patent to be able to act against the infringer. By filing a divisional with broader claims lengthy difficult discussions with the examining division can be carried through without being prevented from acting against the infringer.

Considering the independence of parent and divisional and the reciprocity of scenarios b) and c), we think that the argumentation of T 422/07 should also apply to scenario b).

To summarize the above case law seems to overturn the view taken by T 307/03 for the scenarios b), c) and d). Two flaws however remain, first, in contrast to T307/03, none of these more recent decisions has been published, and second, none of these more recent decisions clearly discusses and explicitly disagrees with T307/03.

6 T1391/07, reasons 2.5
7 Emphasis added by the Board
8 T1391/07, reasons 2.6
9 T422/07, reasons 3

3. Recent case law in relation to subsequent applications

Luckily however there is another decision, namely T1423/07 dated 19.4.2010, which is not related to divisional applications but which deals with the situation of a European subsequent application claiming priority of a first European application which has been granted. The issue of double patenting here came up because the claims of the granted priority application and of the subsequent European application claiming its priority were *identical*.

The decision is well reasoned and analyses the double patenting issue in detail by first looking at the possibilities of refusal under Art 125. While it is highly questionable whether Art 125 is applicable at all in what is evidently a substantive matter, the Board doubtless used it as a doorway to the very useful analysis it made regarding the situation in the contracting states. The Board finds that there indeed is a majority of contracting states in which there is prevention of double patenting for post grant situations, but not for pre-grant situations,[10] and it notes in the first headnote:

> In view of the fact that there are no principles of law generally recognised in the Contracting States for *refusing* a patent application for double patenting, *refusal* of a European patent application for double patenting cannot be based on Art 125 (emphasis added)

The analysis by the Board showed that in only two contracting states, GB and IE, was there pre-grant refusal on the basis of double patenting.

This decision also looks at the double patenting refusal under Art. 60 in T 307/03 and clearly reverses it as summarized in the third headnote:

> Article 60 EPC cannot be used as a basis for refusing a European patent application for double patenting either. In particular, Article 60 EPC cannot be interpreted such that the inventor or his successor in title has a right to the grant of one and only one patent from the EPO for a particular invention, with the consequence that claims comprising subject-matter included in the claims of an already granted patent of the same applicant are refused no matter whether or not the applicant has a legitimate interest in the grant of the subsequent application.

The actual ratio decidendi of T1423/07 is quite difficult to determine; during the prosecution of the applications the applicant of one had changed (albeit to a related company) and it appears that this is a second ground (Reasons 2.4) for finding that there is no double patenting.[11] But it also appears that due to the difference in term of the priority patent and the subsequent application the Board finds a legitimate interest in getting the subsequent application granted.[12] Since this would be in line with the observation in G1/06, and because that concerned a divisional situation which this is not, the Board sees no reason to refer the issue to the Enlarged Board of Appeal. Unfortunately the decision will not be published in the OJ.

10 T1423/07, reasons 2.2.3
11 See also Art 118 EPC and J 2/01
12 T1423/07, reasons 2.2.4.1

4. The Guidelines

In our earlier article we criticized the Guidelines for Examination. They contain the only attempted definition of double patenting, based on subject-matter, and the only prohibition of grant; at the end of GL C IV 7.4 it is stated that an applicant having more than one application falling foul of the definition must choose which one of them shall proceed to grant. As the analysis in T 1423/07 has shown, refusal of grant by the EPO would pre-empt the position in those contracting states which have no objection to the existence of double patenting (not forgetting the further few who distinguish in this respect between patents and utility models[13]). Even in T 307/03 the Board was forced to admit

> The Board can recognize no legitimate interest in anyone having two or more identical patents with the same claims and the same priority dates [plural, sic; and compare T 1423/07], yet even this extreme case would have to be allowed if no prohibition of double patenting were considered to exist in the EPC.

That decision was based on Art 60 EPC; the analysis in T 1423/07 however shows that Art. 60 cannot be used and that even if Art125 EPC were applicable it would not show a general principle of refusal before grant and thereby justify pre-grant refusal by the EPO.

It therefore appears that there is indeed no prohibition in the EPC. The Guidelines do not represent the law and should be changed; as they stand they are confusing for applicants and may mislead examiners.

5. Summary and Conclusion

Looking at the above chain of decisions it appears reasonable to assume that T 307/03 is not being followed and we are back to the situation as before. Or maybe not? It seems that T1423/07 progresses beyond the previous situation and elaborates the notion in G1/06 of legitimate interest - despite the obiter nature of that observation, and the doubt we expressed in footnote 4 - in the sense that there cannot be double patenting as long as one can show a legitimate interest in getting both patents. That's why in that specific case the subsequent application, having a longer term, was allowed to proceed to grant in spite of the claims being identical to the granted priority patent. So we have one example for the situation of identical scope where sufficient legitimate interest was found due to the different duration of the patents, regardless of the fact that for the great majority of the lives of the patents there would be "double jeopardy", the usual objection to double patenting!

In which other situations a legitimate interest might be accepted is difficult to anticipate.

In the absence of any specific additional legitimate interest like a longer term, i.e. normally in case of a divisional, it now seems clear from the recent case law that the EPO only considers double patenting to exist where there is substantial identity between the claims of the parent and the divisional.

It seems important to point out that we are not advocating double patenting as a good thing. We however think that it is not the EPO's task to prevent double patenting, for a number of reasons.

In the travaux préparatoires to the 1973 Convention, at least according to our understanding, it was made clear that the issue of double patenting is up to the contracting states and not to the EPO (See footnotes 4 and 5 to our earlier article).

In addition to that we do not see any legal basis in the EPC for even preventing the grant of exactly the same patent twice. It might seem abusive for a holder to hold, twice, exactly the same patent with the same term. But even then, taking the legitimate interest argument used in the above decisions, couldn't it be argued that an applicant has a legal interest to have a second patent in case one (or both) is limited in limitation proceedings?[14] Or in case of a block-buster patent: isn't there a legitimate interest in getting both to be on the safe side if one of them lapses e.g. for some administrative error, so in the sense of a legal backup or safety redundancy as in IT systems, power plants and the like?

In any case as soon as there are even only subtle differences in the wording of the claims difficult questions arise. The key criterion for determining whether there is double patenting should not be whether the same subject matter is claimed but whether the claims have the same scope of protection. In other words, the question should be whether all embodiments within one claim necessarily fall within the scope of protection of the other claim, each way. This is something that can be and should only be determined by a national court in a contracting state when dealing with an actual situation involving scope of protection and infringement. Determination of scope may also depend on the time when this is looked at, quite apart from questions of limitation, which is another reason why a comparison of scope should not be done before grant. It is neither the task nor the experience of the EPO to determine a difference in scope between two differently worded claims, and therefore EPO should not do it.[15]

As a tailpiece, consider the wording of the rarely-read Art 4(3) EPC:

> The task of the Organisation shall be to *grant* European patents. This shall be carried out by the European Patent Office … .

Needless to say, the emphasis was added!

13 See Art 140 EPC

14 Note that the national legislation at present takes no account of the limitation provisions of EPC 2000

15 If the EPO should nevertheless be considered to have the task of preventing the grant of a second patent with potentially essentially equivalent claims, we propose a simple and straightforward approach to find out whether the same subject matter is claimed by a double test: using the conventional novelty criteria it is on the one hand determined whether the claim of the divisional is novel comparing it with the claim of the parent. Then it is determined whether the claim of the parent is novel comparing it with the claim of the divisional. If in both tests no novelty is found, the same subject matter is claimed and double patenting may be found. If in one or both tests novelty is found, not the same subject matter is claimed and there is no basis for a double patenting situation. This is a reliable test which the applicants and the EPO have experience of in leading to legal certainty for all users.

How does „Enhanced Cooperation" work?

F. Sieber (DE)[1]

Enhanced cooperation is an instrument for decision-making within the legal framework of the European Union, allowing a number of Member States to make use of the institutions of the EU to cooperate between themselves in one of the areas of the EU Treaties. It aims at increased flexibility in all those areas that are not within the exclusive competency of the Union, taking into account a "multi-speed Europe", as critics say. The concept was first introduced by the Amsterdam Treaty and subsequently underwent refinement and simplification with the Nice and the Lisbon Treaty. This paper reviews the enhanced cooperation policy-making process and will briefly discuss the first enhanced cooperation approval in the area of divorce and judicial separation law and the current attempts for establishing a unitary patent system.

1. THE PREPARATORY PHASE

Article 20 TEU (Treaty on European Union) and Articles 326 – 334 TFEU (Treaty on the Functioning of the European Union) set the stage for enhanced cooperation initiatives. Enhanced cooperation is generally defined as a measure concerning operational cooperation between the authorities in case of the absence of unanimity or qualified majority within all Member States. The conditions of the procedure remain, however, rather restrictive:

- The request may only affect non-exclusive competences of the Union (Art. 20(1) TEU). A list of the Union's exclusive competences is mentioned in Article 3 TFEU.
- Any enhanced cooperation shall "aim to further the objectives of the Union, protect its interests and reinforce its integration process" (Art. 20(1) TEU), and therefore must comply with the Treaties and Union law and may not undermine the internal market or economic, social and territorial cohesion of the Union. Trade protective or discriminative or otherwise anti- competitive acts are explicitly prohibited (Art. 326 TFEU). The enhanced cooperation shall also respect the competences, rights and obligations of those Member States which do not participate in it, who in turn may not impede the implementation of the enhanced cooperation by the participating Member States (Art. 327 TFEU).
- Enhanced cooperation must be the "last resort" (Art. 20(2) TEU). While the Nice Treaty did not specify who and how this should be measured, the Lisbon Treaty leaves the determination of this criterion to the Council.
- At least one third of all Member States must support the request. The previous requirement of the Amsterdam Treaty (request to be filed by a majority of Member States) was softened by the Treaty of Nice (8) and adapted to 27 Member States under the Lisbon Treaty (now: 9; Art. 20(2) TEU).

Article 20 TEU

1. Member States which wish to establish enhanced cooperation between themselves within the framework of *the Union's non-exclusive competences* may make use of its institutions and exercise those competences by applying the relevant provisions of the Treaties, subject to the limits and in accordance with the *detailed arrangements laid down in this Article and in Articles 326 to 334 of the Treaty on the Functioning of the European Union*.
   Enhanced cooperation shall *aim to further the objectives of the Union, protect its interests and reinforce its integration process*. Such cooperation shall be open at any time to all Member States, in accordance with Article 328 of the Treaty on the Functioning of the European Union.
2. The decision authorising enhanced cooperation shall be *adopted by the Council as a last resort*, when it has established that the objectives of such cooperation cannot be attained within a reasonable period by the Union as a whole, and provided that *at least nine Member States participate* in it. The Council shall act in accordance with the procedure laid down in Article 329 of the Treaty on the Functioning of the European Union.
3. All members of the Council may participate in its deliberations, but only members of the Council representing the Member States participating in enhanced cooperation shall take part in the vote. The voting rules are set out in Article 330 of the Treaty on the Functioning of the European Union.
4. Acts adopted in the framework of enhanced cooperation shall bind only participating Member States. They shall not be regarded as part of the acquis which has to be accepted by candidate States for accession to the Union.

Article 3 TFEU

1. The Union shall have *exclusive competence* in the following areas:
   (a) customs union;
   (b) the establishing of the competition rules necessary for the functioning of the internal market;
   (c) monetary policy for the Member States whose currency is the euro;

1 The article has been submitted for the diploma of the CEIPI *epi* Course on Patent Litigation in Europe
Frank Sieber is a European Patent Attorney in Frankfurt.

(d) the conservation of marine biological resources under the common fisheries policy; (e) common commercial policy.

2. The Union shall also have exclusive competence for the conclusion of an international agreement when its conclusion is provided for in a legislative act of the Union or is necessary to enable the Union to exercise its internal competence, or in so far as its conclusion may affect common rules or alter their scope.

2. INITIATION AND DECISION MAKING PROCESS

The Commission is the only gateway for launching an enhanced cooperation legislative initiative.

In all those cases of enhanced cooperation that do *not* deal with common foreign and security policy, on submission of the participating Member States the Commission will assess the request and decide whether to submit a proposal to the Council in this respect or not to present a proposal (in this case, it will explain its reasons to the requesting Member States). If the Commission presents a proposal, the authorisation to proceed with the enhanced cooperation is granted by the Council after obtaining the consent of the European Parliament (Art. 329(1) TFEU).

Article 329(1) TFEU

1. Member States which wish to establish *enhanced cooperation* between themselves *in one of the areas covered by the Treaties*, *with the exception of fields of exclusive competence and the common foreign and security policy*, shall *address a request to the Commission*, specifying the scope and objectives of the enhanced cooperation proposed. The Commission may submit a *proposal to the Council* to that effect. In the event of the Commission not submitting a proposal, it shall inform the Member States concerned of the reasons for not doing so.

   Authorisation to proceed with the enhanced cooperation referred to in the first subparagraph shall be granted by the Council, on a proposal from the Commission and after obtaining the *consent of the European Parliament*.

Unlike the Nice Treaty, the Lisbon Treaty excludes the opportunity of a non-participating Member State to veto in the Council an enhanced cooperation of other Member States. As a general rule, Council decisions are taken by a qualified-majority voting (QMV; for example Art. 16 TEU). In enhanced cooperation, only members of the Council representing the Member States participating in enhanced cooperation take part in the vote (Art. 330 TFEU), and must act unanimously, but may adopt a decision stipulating that it will act by a qualified majority (Art. 333(1) TFEU).

Article 330 TFEU

All members of the Council may participate in its deliberations, but only members of the Council representing the Member States participating in enhanced cooperation shall take part in *the vote*.

Unanimity shall be constituted by the votes of the representatives of the participating Member States only. A *qualified majority* shall be defined in accordance with Article 238(3).

Article 333(1) TFEU

1. Where a provision of the Treaties which may be applied in the context of enhanced cooperation stipulates that the *Council shall act unanimously*, the Council, acting unanimously in accordance with the arrangements laid down in Article 330, may adopt a decision stipulating that it will act by a *qualified majority*.

The European Parliament gives its consent with simple majority. No legal mechanism exists for proposing amendments, the European Parliament may, however, address its concerns to the Council and can threaten to withhold its consent unless its concerns are taken care of.

In case the enhanced cooperation stipulates that the Council shall adopt acts under a special legislative procedure, the Council may, after consulting the European Parliament, adopt a decision stipulating that it will act under the ordinary legislative procedure (Art. 333(2) TFEU).

Article 333(2) TFEU

2. Where a provision of the Treaties which may be applied in the context of enhanced cooperation stipulates that the *Council shall adopt acts under a special legislative procedure*, the Council, acting unanimously in accordance with the arrangements laid down in Article 330, may adopt a decision stipulating that it will act under *the ordinary legislative procedure*. *The Council shall act after consulting the European Parliament*.

If the European Parliament gives its backing and the legislative initiative is decided by the Council, the decision is legally binding for the Member States engaged in the enhanced cooperation (Art. 330 TFEU).

If Council or European Parliament rejects the proposal, the enhanced cooperation fails.

- **Enhanced cooperation in the framework of the common foreign and security policy**

In all cases of enhanced cooperation in the framework of common foreign and security policy, the request is to be addressed to the Council (in contrast to submission to the Commission under Art. 329(1) TFEU) and is forwarded to the High Representative of the Union for Foreign Affairs and Security Policy and to the Commission for their opinion. It is also forwarded to the European Parliament for information, but not for consent (Art. 329(2) TFEU).

Article 329(2) TFEU

2. The request of the Member States which wish to establish *enhanced cooperation* between themselves *within the framework of the common foreign and security policy* shall be *addressed to the Council*. It shall be *forwarded to the High Representative of the*

Union for Foreign Affairs and Security Policy, who shall give an opinion on whether the enhanced cooperation proposed is consistent with the Union's common foreign and security policy, and to the Commission, which shall give its opinion in particular on whether the enhanced cooperation proposed is consistent with other Union policies. It shall also be *forwarded to the European Parliament for information*.

Authorisation to proceed with enhanced cooperation shall be granted by a decision of the Council acting unanimously.

- **Enhanced cooperation related to criminal matters**

Cooperation in criminal matters is an exception. If a Member State vetoes a decision on police and judicial cooperation in criminal matter and at least nine Member States wish to proceed, these Member States are deemed to be engaged in enhanced cooperation, and authorization is deemed to be granted automatically (Art. 87(3) TFEU).

Article 87(3) TFEU

3. The Council, acting in accordance with a special legislative procedure, may establish measures concerning operational cooperation between the authorities referred to in this Article. The Council shall act unanimously after consulting the European Parliament.

In case of the absence of unanimity in the Council, a group of at least nine Member States may request that the draft measures be referred to the European Council. In that case, the procedure in the Council shall be suspended. After discussion, and in case of a consensus, the European Council shall, within four months of this suspension, refer the draft back to the Council for adoption.

Within the same timeframe, in case of disagreement, and *if at least nine Member States wish to establish enhanced cooperation on the basis of the draft measures concerned*, they shall notify the European Parliament, the Council and the Commission accordingly. *In such a case, the authorisation to proceed with enhanced cooperation referred to in Article 20 (2) of the Treaty on European Union and Article 329 (1) of this Treaty shall be deemed to be granted and the provisions on enhanced cooperation shall apply.*

The specific procedure provided for in the second and third subparagraphs shall not apply to acts which constitute a development of the Schengen acquis.

3. CONSISTENCY OF ENHANCED COOPERATION WITH UNION POLICIES

Council and Commission have to ensure that any request made under the enhanced cooperation procedure is in compliance with policies of the Union (Art. 334 TFEU). In order to forestall complications which would result from legal disputes concerning the compatibility with the Treaties of international agreements binding upon the European Union, the European Parliament, the Council, the Commission or a Member State may obtain the opinion of the Court of Justice as to whether an envisaged agreement is compatible with the provisions of the Treaties (Art. 218(11) TFEU). The Court must have sufficient information both on the content of and background to the envisaged legislative initiative that is the subject of the envisaged enhanced cooperation.

Article 218(11) TFEU

11. A Member State, the European Parliament, the Council or the Commission may obtain the *opinion of the Court of Justice* as to whether an agreement envisaged is compatible with the Treaties. Where the opinion of the Court is adverse, the agreement envisaged may not enter into force unless it is amended or the Treaties are revised.

Article 334 TFEU

The Council and the Commission shall ensure the *consistency of activities undertaken in the context of enhanced cooperation and the consistency of such activities with the policies of the Union*, and shall cooperate to that end.

4. ACCESSION OF FURTHER MEMBER STATES

A further fundamental principle of the enhanced cooperation is open access for all Member States either when enhanced cooperation is established or at any other time, "subject to compliance with any conditions of participation laid down by the authorising decision" (Art. 20(1) TEU; Art. 328(1) TFEU; Art. 331 TFEU). If previously non-participating Member States desire to join an existing enhanced cooperation such Member States must also comply "with the acts already adopted within that framework".

Article 20(1) TEU

1. Member States which wish to establish enhanced cooperation between themselves within the framework of the Union's non-exclusive competences may make use of its institutions and exercise those competences by applying the relevant provisions of the Treaties, subject to the limits and in accordance with the detailed arrangements laid down in this Article and in Articles 326 to 334 of the Treaty on the Functioning of the European Union.

Enhanced cooperation shall aim to further the objectives of the Union, protect its interests and reinforce its integration process. *Such cooperation shall be open at any time to all Member States, in accordance with Article 328 of the Treaty on the Functioning of the European Union*.

Article 328(1) TFEU

1. *When enhanced cooperation is being established*, it shall be *open to all Member States*, *subject to compliance with any conditions of participation laid down*

by the authorising decision. *It shall also be open to them at any other time, subject to compliance with the acts already adopted within that framework, in addition to those conditions*. The Commission and the Member States participating in enhanced cooperation shall ensure that they promote participation by as many Member States as possible.

Article 331 TFEU

1. Any Member State which wishes to participate in *enhanced cooperation in progress in one of the areas referred to in Article 329(1)* shall notify its intention to the Council and the Commission.

   The Commission shall, within four months of the date of receipt of the notification, confirm the participation of the Member State concerned. It shall note where necessary that the conditions of participation have been fulfilled and shall adopt any transitional measures necessary with regard to the application of the acts already adopted within the framework of enhanced cooperation.

   However, if the Commission considers that the conditions of participation have not been fulfilled, it shall indicate the arrangements to be adopted to fulfil those conditions and shall set a deadline for re-examining the request. On the expiry of that deadline, it shall re-examine the request, in accordance with the procedure set out in the second subparagraph. If the Commission considers that the conditions of participation have still not been met, the Member State concerned may refer the matter to the Council, which shall decide on the request. The Council shall act in accordance with Article 330. It may also adopt the transitional measures referred to in the second subparagraph on a proposal from the Commission.
2. Any Member State which wishes to participate in *enhanced cooperation in progress in the framework of the common foreign and security policy* shall notify its intention to the Council, the High Representative of the Union for Foreign Affairs and Security Policy and the Commission.

   The Council shall confirm the participation of the Member State concerned, after consulting the High Representative of the Union for Foreign Affairs and Security Policy and after noting, where necessary, that the conditions of participation have been fulfilled. The Council, on a proposal from the High Representative, may also adopt any transitional measures necessary with regard to the application of the acts already adopted within the framework of enhanced cooperation. However, if the Council considers that the conditions of participation have not been fulfilled, it shall indicate the arrangements to be adopted to fulfil those conditions and shall set a deadline for re-examining the request for participation. For the purposes of this paragraph, the Council shall act unanimously and in accordance with Article 330.

"Within four months of the date of receipt of the notification" the Commission shall decide about any request for entry into an existing enhanced cooperation (Art. 331(1) TFEU). If the enhanced cooperation relates to common foreign and security policy, it is the Council that shall evaluate and confirm the participation of the Member State concerned "after consulting the High Representative of the Union for Foreign Affairs and Security Policy" (Art. 331(2) TFEU).

- **What happens if all Dissenting Member States join the Enhanced Cooperation?**

By definition, if all Member States support a legislative initiative at least the prerequisite set in Article 20(2) TEU ("when it has established that the objectives of such cooperation cannot be attained within a reasonable period by the Union as a whole") ceases to exist. Therefore, with the accession of the last Member State the enhanced cooperation is terminated and the legislative initiative is governed by the respective provisions of the Treaties.

5. ENHANCED COOPERATION IN THE CONTEXT OF DIVORCE LAW

In July 2010, the first enhanced cooperation was approved in the field of cross border divorce law. A core issue was the independent choice of the divorce legislation to be applied. The enhanced cooperation suggested to limit this choice to the member states to which the spouses have a close connection, on the basis of objective criteria: (a) the law of the state of common usual stay, (b) the law of the last common usual stay, (c) the law of the state in which one of the spouses has citizen rights, or (d) the law of the state in which the divorce or judicial separation procedure takes place. The common usual place of residence plays a pivotal role.

Especially the Swedish position was opposing a unanimous decision in fear of losing Nordic liberalism in this field. 9 countries (Austria, France, Greece, Hungary, Italy, Luxembourg, Romania, Slovenia and Spain) had decided to be engaged in a proposal for enhanced cooperation. On 28 July 2008, all of the above countries except France (i. e. 8 Member States, the minimum number according to the Nice Treaty) formally requested enhanced cooperation to the Commission. Belgium, Bulgaria, France, Germany, Latvia, Malta, Portugal, Slovenia and Spain subsequently joined (as for France, re-joined), while Greece withdrew. On 12 July 2010, about 2 years after submission of the enhanced cooperation request to the Commission, the Council authorised these 14 countries to proceed with enhanced cooperation.

6. ENHANCED COOPERATION IN THE CONTEXT OF THE PROPOSED EU PATENT

The Lisbon Treaty commissions the European Parliament and the Council, in the context of the establishment and functioning of the internal market, to establish measures for the creation of European intellectual property rights to provide uniform protection of intellectual property rights throughout the Union (Article 3(3) TEU; Article 118 TFEU), the so-called "Enhanced patent system in

Europe" (not to be confused with "enhanced cooperation").

While efforts in this direction have been made for decades, certain countries continue to disagree on specific points of the respective legislative initiatives, especially with regard to the translation arrangements. In December 2009, the Council adopted conclusions on the Enhanced patent system according to which "the EU patent regulation should be accompanied by a separate regulation, which should govern the translation arrangements for the EU patent adopted by the Council with unanimity in accordance with the second subparagraph of article 118 of the treaty. The EU patent regulation should come into force together with the separate regulation on the translation arrangements for the EU patent. ". The Commission adopted a respective proposal for a Council Regulation on 30 June 2010.

- **Preparatory Phase & Initiation**

Despite several rounds of negotiations the Competitiveness Council meeting on 10 December 2010 confirmed "insurmountable difficulties … making a decision on the translation arrangements requiring unanimity impossible now and in the foreseeable future". Twelve Member States (i. e. $\geq$ 9 Member States, fulfilling the requirement of Art. 20(2) TEU: Denmark, Estonia, Finland, France, Germany, Lithuania, Luxembourg, the Netherlands, Poland, Slovenia, Sweden and the United Kingdom) then proposed to the Commission the use of the enhanced cooperation procedure, in order to set up a unitary patent applicable in all participating European Union Member States.

- **Commission approval & European Parliament consent**

With the Commission's approval on 14 December 2010, the EU patent is only the second case of enhanced cooperation.

On 14 February 2011, the Council requested the European Parliament's consent to the use of enhanced cooperation for a unitary patent with the participation of 23 member states (all except Italy, Spain, Cyprus and the Czech Republic), which the Parliament fast-tracked and approved the next day by 471 to 160 votes, with 42 abstentions.

- **Consistency of the EEUPC Draft Agreement with Union policies**

As mentioned above, Council and Commission have to ensure that any request made under the enhanced cooperation procedure complies with the EU Treaties. The same is true for any other legislative act. Consequently, the Council on 6 July 2009 requested to the European Court of Justice to provide its opinion on whether the draft agreement on the European and Community Patents Court (EEUPC) is compatible with the provisions of the Treaties.

On 8 March 2011 the European Court of Justice issued its opinion on the consistency of the proposals to implement a European and EU patents court with the EU treaties, concluding that "the envisaged agreement creating a unified patent litigation system ("European and Community Patents Court") is not compatible with the provisions of the EU Treaty and the FEU Treaty". CJEU Opinion 1/09 will however not hinder the Council from authorising the enhanced cooperation procedure, since the Council's assertion that the creation of a unitary patent title across the Union is distinct from creating a patent court that shall have jurisdiction in cases dealing with such unitary patent rights.

- **Council authorisation of enhanced cooperation & Council adoption of proposals**

The Council authorised the enhanced cooperation on 10 March 2011, confirming that the conditions as laid down in Article 20 TEU and Articles 326 and 329 TFEU are fulfilled, cf. (8)-(16). At that time, 25 Member States had joined the enhanced cooperation (with Italy and Spain still staying out). Council Decision 2011/167/EU had effect to only the requesting countries.

On 13 April 2011, the Council adopted 2 proposals:

(i.) a proposal for an implementing enhanced cooperation in the area of the creation of unitary patent protection (Council Regulation (COM (2011) 216 final)), and

(ii.) a proposal for implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (Council Regulation (COM (2011) 215 final)).

The proposals are accompanied by an Impact Assessment working paper explaining the rationale of the decision in more details.

- **What's next?**

The proposals are now transmitted to the Council and the European Parliament for adoption.

In view of CJEU Opinion 1/09, the "enhanced unitary patent" would have to make do without an "enhanced unitary patent court" as proposed in the EEUPC draft agreement even if the participating Member States adopt an agreement. A Presidency Note of 26 May 2011 that was discussed by the Competitiveness Council on 30 May 2011 suggests that, similar to the Benelux Court of Justice, the participating Member States could set up a unified patent court among themselves, thereby excluding the participation of third states. The European Union would not be a party. The proposed unified patent court would comprise exclusive jurisdiction in respect of civil litigation related to infringement and validity for both the "classical" European patents as well as the European patents with unitary effect, while maintaining the main features of the EEUPC and ensuring conformity with the Treaty as set out in the opinion 1/09 of the CJEU.

RESOURCES

- **Enhanced Cooperation in general**

– Lisbon Treaty, CONSOLIDATED VERSIONS OF THE TREATY ON EUROPEAN UNION AND THE TREATY ON THE FUNCTIONING OF THE EUROPEAN UNION and

CHARTER OF FUNDAMENTAL RIGHTS OF THE EUROPEAN UNION, Publications Office of the European Union, March 2010, ISBN 978-92-824-2577-0
– Treaty of Nice: A Comprehensive Guide, http://europa.eu/legislation_summaries/institutional_affairs/treaties/nice_treaty/nice_treaty_cooperations_en.htm
– J.A. Emmanoulidis, "Institutional consequences of Differentiated Integration", Center for Applied Policy Research, February 2007
– The Treaty of Lisbon: Implementing the Institutional Innovations, Joint Study, CEPS, EGMONT and EPC, November 2007, cf. pages 97–119
– Summaries of EU legislation, Glossary, Enhanced cooperation, http://europa.eu/legislation_summaries/glossary/ enhanced_cooperation_en.htm
– Dietrich Neumann, Head of Legal Affairs, Europol, "Police cooperation after Lisbon and Stockholm", Catania, Faculty of Political Science – October 2010/July 2011, http://www.fscpo.unict.it/europa/JM_OC/october2010_ Neumann.pdf
– F. Tekin & W. Wessels, "Flexibility within the Lisbon Treaty: Trademark or Empty Promise?" EIPASCOPE 2008, 1, 25–31
– Wikipedia, Legislature of the European Union, http://en.wikipedia.org/wiki/Legislature_of_the_European_Union
– Wikipedia, Enhanced co-operation, http://en.wikipedia.org/wiki/Enhanced_cooperation
– EU Parliament, Enhanced cooperation procedure, http://www.europarl.europa.eu/parliament/expert/staticDisplay.do?id=55&pageRank=10&language=EN
– EU Parliament, INTERGOVERNMENTAL DECISION-MAKING PROCEDURES, March 2010, http://www.europarl.europa.eu/ftu/pdf/en//FTU_1.4.2.pdf

- **Enhanced Cooperation in International Divorce Law**

– K. Boele-Woelki, To Be or Not to Be: Enhanced Cooperation in International Divorce Law within the European Union, Victoria
– University of Wellington Law Review 2008, pp. 779–792, http://igitur-archive.library.uu.nl/law/2009-1007-200150/UUindex.html
– European Union Law, A blog about EU law by Vihar Georgiev, First Enhanced Cooperation Approved, http://eulaw.wordpress.Com/2010/07/13/first-enhanced cooperation-approved/, 13.07.2010
– Council Regulation (EU) No 1259/2010 of 20 December 2010 implementing enhanced cooperation in the area of the law applicable to divorce and legal separation

- **Enhanced Cooperation in the Area of the Creation of Unitary Patent Protection**

– European Commission, The single EU market, Enhanced cooperation in the area of unitary patent protection, http://ec.europa.eu/internal_market/indprop/patent/index_en.htm
– Wikipedia, EU patent, http://en.wikipedia.org/wiki/EU_patent, 02.05.2011
– PRESS RELEASE 3057th Council meeting, Competitiveness (Internal Market, Industry, Research and Space), 17668/1/10 REV 1, PRESSE 339, PR CO 45, cf. pages 8–9, 10.12.2010
– COM (2010) 790 final, 2010/0384 (NLE), Proposal for a COUNCIL DECISION authorising enhanced cooperation in the area of the creation of unitary patent protection, 14.12.2010
– Parliament to fast-track vote on EU patent, http://www.euractiv.com/en/enterprise-jobs/parliament-fast-track-vote-eu-patent-news-501590, 26.01.2011
– European Parliament legislative resolution on the draft Council decision authorising enhanced cooperation in the area of the creation of unitary patent protection (05538/2011 – C7-0044/2011 – 010/0384(NLE)) (Consent), P7_TA-PROV(2011)0054, 15.02.2011
– Court of Justice of the European Union, OPINION 1/09 delivered pursuant to Article 218(11) TFEU – Draft agreement – Creation of a unified patent litigation system – European and Community Patents Court –Compatibility of the draft agreement with the Treaties, 08.03.2011
– COUNCIL DECISION of 10 March 2011 authorising enhanced cooperation in the area of the creation of unitary patent protection (2011/167/EU), Official Journal of the European Union, L 76/53, 22.03.2011
– G. Roberts, "An European Patent without a Court", Kilburn & Strode LLP, 04.04.2011, http://www.kstrode.co.uk/news/NewsDet.asp?RID=383&NewsType=Current
– COM (2011) 215 final, 2011/0093 (COD), Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL implementing enhanced cooperation in the area of the creation of unitary patent protection, {COM (2011) 216 final}, {SEC (2011) 482 final}, {SEC (2011) 483 final}, 13.04.2011
– COM(2011) 216 final, 2011/0094 (CNS), Proposal for a COUNCIL REGULATION implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, {COM(2011) 215 final}, {SEC (2011) 482 final}, {SEC (2011) 483 final}, 13.04.2011
– SEC(2011) 482 final, IMPACT ASSESSMENT, Accompanying document to the Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND THE COUNCIL implementing enhanced cooperation in the area of the creation of unitary patent protection and Proposal for a COUNCIL REGULATION implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, {COM(2011) 215 final}, {COM(2011) 216 final}, {SEC (2011) 483 final}, 13.04.2011
– MEMO/11/240, Commission proposes unitary patent protection in 25 Member States – Frequently Asked Questions, http://europa.eu/rapid/pressReleasesAction.do?reference=MEMO/11/240&format=HT, 13.04.2011

– Press release, Commission sets out "blueprint" for Intellectual Property Rights to boost creativity and innovation, IP/11/630, 24.05.2011
– Presidency Note to Council, Creating a Unified Patent Litigation System- Orientation debate, 10630/11, Annex II, "SOLUTIONS FORA UNIFIED PATENT LITIGATION SYSTEM – THE WAY FORWARD AFTER THE OPINION 1/09 OF THE CJEU, NON – PAPER OF THE COMMISSION SERVICES", 26.05.2011
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Fristverlängerungen

J. Ehlers (DE)

Gemäß Regel 132 (2) S. 2 EPÜ werden vom Europäischen Patentamt bestimmte Fristen auf Antrag verlängert: *„In besonderen Fällen kann die Frist vor Ablauf auf Antrag verlängert werden."*

In der Praxis hat sich eine relativ verlässliche Gewohnheit etabliert: Sofern nicht ein Anmelder einen „PACE-Antrag" auf beschleunigte Bearbeitung gestellt hat, werden solche Fristgesuche ohne weiteres gewährt, die (nach Verlängerung) zu einer Frist von maximal sechs Monaten führen. So auch Heusler/Stauder in Rn. 79 zu Art. 94 und Kroher in Rn. 41 zu Art. 120, beides in: „Singer, Stauder: "Europäisches Patentübereinkommen", 5. Auflage Wurde also beispielsweise ursprünglich eine Frist von vier Monaten bestimmt, so akzeptiert das Europäische Patentamt in der Regel ohne Darlegung *besonderer* Gründe eine Verlängerung um weitere zwei Monate. Weitergehende Fristgesuche werden erfahrungsgemäß nicht akzeptiert, wenn nicht in der Tat ganz besonders außergewöhnliche Umstände vorliegen, die ggfs. ausführlich darzulegen und glaubhaft zu machen wären.

Es ist zu begrüßen, dass – nach übereinstimmenden Praxisberichten – das Europäische Patentamt das ihr in Regel 132 (2) S. 2 EPÜ eingeräumte Ermessen gewohnheitsmäßig – und damit vorhersehbar – in einer bewährten Praxis ausübt.

Vor diesem Hintergrund erstaunlich erscheint die Praxis zumindest einiger technischer Beschwerdekammern, über die ich mit diesem Beitrag berichten möchte. Gemäß Art. 12 (5) der Verfahrensordnung der Beschwerdekammern können Fristen *„…nach dem Ermessen der Kammer nach Eingang eines schriftlichen und begründeten Antrags ausnahmsweise verlängert werden"*. Diese Formulierung unterscheidet sich sprachlich ein wenig von derjenigen in Regel 132 (2) S. 2 EPÜ, aber dass mit „in besonderen Fällen" etwas anderes gemeint sein könnte als mit „ausnahmsweise" ist diesen beiden Formulierungen selbst zunächst unmittelbar nicht zu entnehmen. Deshalb wäre die Vermutung naheliegend – obschon der in Art. 23 EPÜ ausgedrückten Unabhängigkeit der Mitglieder der Kammern – dass eine gleichermaßen fundamentale wie auch einfache Praxis wie diejenige, die sich zu Regel 132 (2) EPÜ entwickelt hat, auch für die Verfahren vor den Beschwerdekammern gilt. Dies ist nach unserer Beobachtung in zurückliegender Zeit indes nicht der Fall. Jedenfalls die Technische Beschwerdekammer 3.5.06 gewährt selbst erstmalige Fristverlängerungen (vier auf sechs Monaten) offenbar nur bei Vorliegen *ganz* außergewöhnlicher Umstände. Selbst dieses (erstmalige) Fristgesuch:

"On behalf of the patent proprietor, we hereby request to extend the term set by official communication dated … by another two months to a total of six months, Art. 12 (5) Rules of Procedure of the Boards of Appeal of the European Patent Office.

Reasons for the request:

1. Exceptional complexity and extensiveness of the case:
   The present appeal case refers to the three oppositions provided on no less than 120 pages which refer to no less than 82 documents. Also, the opponents refer to opposition proceedings in the parent application … . This (parent) case is also extraordinarily voluminous. The present appeal of … has been provided on no less than 84 pages and with reference to 9 further, newly introduced documents. The complexity of this case – from the perspective of the patent proprietor – is further increased by the second appeal, filed by the opponent … , filed on 29 pages and being entirely inconsistent with the appeal filed by ….
2. *Translations:*
   The patent proprietor is an American company. All submissions by … have to be translated from German into English, and the same is true for all draft submissions that we file on behalf of … in German language. They are provided in German language, are to be translated into English, and all amendments are to be retranslated into German. In view of the complexity of the case, the translation effort and the time delay associated with these translations is significant.

3. Special circumstances in this time frame:

… ' headquarters recently moved to its new location at … . The relocation of the entire company is just about to be finalized, but the move of the entire headquarter included a significant period in which no effective communication with the responsible persons at … has been possible.

In summary, we believe that the present case is exceptional. We are faced with three opponents and exceptionally comprehensive submissions. The case involves an exceptional amount of prior art documents; we now need to deal with references of almost 100 documents. Translation issues imposed a significant delay (considering the volume of the documents to be translated) and on top of these facts, the relocation of the corporate headquarter of the proprietor imposed an additional, exceptional handicap.

After all, we respectfully request to grant a term extension of two months."

lehnte die Technische Beschwerdekammer 3.5.06 ab, und zwar mit folgender Begründung:

"According to Art. 12 (5) RPBA, extensions of time limits may exceptionally be allowed in the boards discretion following receipt of a written and reasoned request.

The proprietor argues that the present case is exceptional due to the complexity of the case, the translation requirements involved, and the move of the proprietor's headquarters which, over significant periods of time, inhibited effective communication between the responsible persons at … and the professional representative in Europe. The board considers that the complexity of the present case may be very high but is not exceptionally so. Complexity and translation requirements were apparent as from the beginning of the time limit in question, and also the move of the proprietors headquarters was surely known in advance. The fact that the proprietor's request was filed so late *suggests, in the board's view, that it is not due to the circumstances that a time extension is needed but, possibly, to inadequate planning.*

On the basis of the present facts and arguments therefore, any submission by the opponent made after the set time limit will be an amendment to the proprietor's case, to be considered at the board's discretion *according to Art. 13 (1) RPBA."*

Dieser Maßstab ist sicherlich nicht derjenige, in der gewohnheitsmäßig die Regel 132 (2) EPÜ zur Anwendung kommt. Im Interesse eines vorhersehbaren, fairen Verfahrens für alle Beteiligten wäre es wünschenswert, wenn die Rechtsprechung der Technischen Beschwerdekammern nachvollziehbare Maßstäbe entwickeln würden, nach welchen Kriterien Beschwerdekammern ihr in Art. 12 (5) der Verfahrensordnung eingeräumtes Ermessen ausüben. Trotz der formalen Unabhängigkeit der Beschwerdekammern gemäß Art. 23 EPÜ ist kein sachlicher Grund erkennbar, warum zumindest einige Technische Beschwerdekammern von einer Praxis abweichen, die sich in Verfahren vor den Prüfungs- und Einspruchsabteilungen bewährt hat.

Decisions and Judgments of the ECJ[1]

A. C. Hillier (DE)

Introduction

Since the course is entitled "European Patent Litigation", the following essay describes the aspects considered to be of greatest relevance to patent-related cases. Accordingly, prominence is given to the decisions of the Court of Justice on preliminary rulings from the national courts of the Member States, while the decisions of the General Court (e.g. in questions of Community Trademark – related laws) and of the Civil Service Tribunal are not considered.

1 The article has been submitted for the diploma of the CEIPI *epi* Course on Patent Litigation in Europe
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I. The Court of Justice of the European Union

1. Background

The European Union (EU) has legal personality (Treaty of Lisbon, entry into force 1 December 2009).

"*The Court of Justice of the European Union is the judicial institution of the European Union and of the European Atomic Energy Community (Euratom). It is made up of three courts: the Court of Justice, the General Court and the Civil Service Tribunal. Their primary task is to examine the legality of European Union measures and ensure the uniform interpretation and application of European Union law.*

Through its case-law, the Court of Justice has identified an obligation on administrations and national courts to apply EU law in full within their sphere of competence and to protect the rights conferred on citizens by that law (direct application of EU law), and to disapply any conflicting national provision, whether prior or subsequent to the EU provision (primacy of European Union law over national law)."[2]

The CJEU consists of the Court of Justice, the General Court and the Civil Service Tribunal. Only the Court of Justice is addressed in the following.

The Court of Justice is composed of 27 Judges and eight Advocates-General. They are appointed for a term of office of six years, which is renewable. They are chosen from among "*individuals whose independence is beyond doubt and who possess the qualifications required for appointment, in their respective countries, to the highest judicial offices, or who are of recognised competence.*"[1] The Court may sit as a full (plenary) court, in a Grand Chamber of 13 Judges or in Chambers of three or five Judges. Except under certain circumstances the Court sits in Chambers of three or five judges.

2. Jurisdiction

The forms of jurisdiction of the Court of Justice can be defined as direct actions and preliminary rulings. Direct actions include actions against Member States and actions against Community institutions. Preliminary rulings concern validity of acts and interpretation of the EC Treaty and of the acts of the institutions. Although patent law is not excluded as a possible subject matter of direct actions, preliminary rulings are most relevant for intellectual property matters.

The Court of Justice thus exercises jurisdiction in various types of proceedings. Direct actions include Types i. to iii. below; Type iv. concerns preliminary rulings. The Court of Justice can also act as an appeal instance (Type v.) and as a review instance (Type vi.):

i. Actions for failure to fulfil obligations
   These actions enable the Court of Justice to determine whether a Member State has fulfilled its obligations under European Union law. Actions can be brought by the European Commission or by a Member State.
ii. Actions for annulment
   The applicant seeks the annulment of a measure (in particular a regulation, directive or decision) adopted by an institution, body, office or agency of the European Union.
iii. Actions for failure to act
   These actions enable the lawfulness of the failure of the institutions, bodies, offices or agencies of the European Union to act to be reviewed. However, such an action may be brought only after the institution concerned has been called on to act.
iv. References for preliminary rulings
   References from national courts of member states seeking:
   – Clarification of points of interpretation of EU law (the EU Treaty);
   – Review of the validity and interpretation of an act of the institutions of the Community and the ECB;
   – Review of the validity and interpretation of an act of the bodies, offices or agencies of the EU.
v. Appeals
   Appeals on points of law only may be brought before the Court of Justice against judgments and orders of the General Court.
vi. Reviews
   Decisions of the General Court on appeals against decisions of the European Union Civil Service Tribunal may, in exceptional circumstances, be reviewed by the Court of Justice as provided in the Protocol on the Statute of the Court of Justice of the European Union.

The area of jurisdiction of the Court of Justice which is most important in terms of patents is Type iv.: **references from national courts of Contracting States**. References for preliminary ruling have some special characteristics, which arise from their being regarded as being a dialogue between the national court and the Court of Justice in a spirit of judicial cooperation. In particular, proceedings are not contentious and there are no parties to proceedings. In addition to the parties in the proceedings before the national court, the Commission, the Council, the European Parliament and all the Member States are also entitled to submit written observations. The proceedings are an interlocutory step in the action before the national court, and the national proceedings are generally stayed until the CJ ruling has been given.

3. Form of decisions of the Court of Justice

Decisions of the Court of Justice take the form of either judgments or orders. Judgments usually constitute the final decision in a case. Orders either come before the final judgment, for example in the case of interim measures orders or admitting intervention in the case, or they follow the judgment, or they close the proceedings where an action is manifestly inadmissible or unfounded in law.

4. Procedures applied to arrive at a judgment[3]

A judge and an advocate general are assigned to each case that comes before the Court.

Cases submitted to the court are processed in two stages: a written stage and a subsequent oral stage.

In the written stage, all the parties involved submit a written statement to the judge responsible for the case. The judge then writes a summary of these statements and the case's legal background.

The second stage is a public hearing. Depending on the complexity of the case, this can take place before a panel of three, five or thirteen judges or in front of the whole Court in a plenary session. At the hearing, lawyers from both sides put their case to the judges and to the Advocate-General, who can question them. The Advocate-General then writes an opinion, although this is

2 http://curia.europa.eu/jcms/jcms/Jo2_7024/#avantpropos

3 http://europa.eu/about-eu/institutions-bodies/court-justice/index_en.htm

only required if the Court believes that the particular case raises a new point of law; the Court does not necessarily follow the advocate-general's opinion. Subsequently, the judges deliberate and give their judgment. The deliberations take place in secret, in French, on the basis of a draft drawn up by the Juge Rapporteur. An uneven number of judges is necessary, and only those judges who were present at the oral hearing may take part in the deliberations. Judges cast their vote in reverse order of precedence, i. e. the final vote is reserved for the most senior judge. Only the judges may be present during the deliberations and no dissenting opinions are published.

The Court's judgments are consensus decisions or, if consensus cannot be reached, majority decisions and are read out at public hearings in open court. The judgment is also published in the Official Journal of the EU, in all the EU languages.

5. The Judgment – content and formal requirements

The written judgments are in three parts:

– The introductory part
– The grounds for the decision
– The operative part.

Judgments must contain:

– A statement that it is the judgment of the CJ (or of the GC or CST)
– The date of its delivery
– The description of the parties
– The names of the President, the Judges, the Advocate-General and the Registrar
– The names of the agents, advisors and attorneys of each party
– A statement that the Advocate-General has been heard (CJ only)
– A summary of the facts
– A statement of the forms of order sought by the parties
– The submissions of the parties
– The grounds of the decision
– The operative part of the judgment, including decision as to the costs.

6. Legal effect of judgments and decisions

Judgments are binding from the date of their delivery.

In the case of judgments on references for preliminary rulings, the interpretation of the Court of Justice is binding on the referring national court in deciding the dispute before it. The validity or interpretation of the Community law in question is deemed to have been definitively determined with respect to the referred question. Implementation is then a matter for the national court.

However, judgments on interpretation are declaratory and do not lay down new rules. They are incorporated into the body of provisions and principles of Community law. They have an *erga omnes* effect since the binding effect of the interpretation coincides with the binding effect of the provisions on which they are based.

The consequences of judgments on Actions for annulment are automatic.

Judgments imposing a pecuniary obligation on individuals and companied are enforced in accordance with domestic civil procedural law, with the co-operation of the competent national authorities if necessary.

In the case of judgments against community institutions, the EU Treaty obliges the institutions to take necessary steps to comply with judgments. However, there is no provision for enforcement of these judgments.

Judgments against Member States are declaratory. The Maastricht Treaty empowers the Court of Justice to impose a financial penalty on a Member State refusing to comply with a judgment.

7. Costs

Proceedings before the Court are free of charge. In the case of references from national courts, the Member States and Community institutions cannot recover their costs. The costs of other parties, i. e. the parties to the national court proceedings, are considered to be a matter for the national courts to decide. The reasoning is that the proceedings before the CJEU are, for the parties to the main (national) proceedings, a step in the action pending before the national court, and accordingly the decision on costs is a matter for that court.

8. Possibility of appeal and/or review

The Court of Justice can act as an appeal or review instance as outlined in points 2.v. and 2.vi. above. Judgments of the Court of Justice usually constitute the final decision in the case and are not open to any appeal.

II. Selected Case Law

1. Introduction

In the area of IP law, judgments have been handed down by the Court of Justice in questions concerning cross-border jurisdiction, recognition and enforcement, e.g. in GAT v. LUK and Roche v. Primus; concerning the application of the TRIPs Agreement under Community Law or by a national court, e.g. in Merck Genéricos v. Merck, in Hermès and in Dior and Others; concerning Supplementary Protection Certificates for medicinal and plant protection products (SPCs); and concerning protection of biotechnological inventions, e.g. Monsanto Technology LLC: „gene performing function". An Advocate-General Opinion has recently been issued concerning the treatment of goods in transit where there is a suspected infringement of an IP right (joined cases C-446/09 and C-495/09) and judgment should follow in due course. There is also a large body of case law relating to community trademarks, which is not dealt with in the present paper.

2. Cross-border jurisdiction of national courts

The cases GAT v. LuK and Roche v. Primus effectively ended the possibility of national courts having jurisdiction in cross-border patent litigation cases.

2.1 Case C-4/03: „GAT v. LuK"

GAT v. LuK deals with a reference for a preliminary ruling from the Oberlandesgericht Düsseldorf regarding the interpretation of Article 16(4) Brussels Convention (Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, amended by the Convention of 29 November 1996, OJ 1997 C 15, p. 1; now superseded by Council Regulation EC 44/2001). Article 16(4) of the Brussels Convention provides for the exclusive jurisdiction of national courts in questions of the registration or validity of patents, trademarks, designs, or other similar rights required to be deposited or registered, in the Contracting State where registration or deposit has been made.

The reference was made in the course of proceedings between Gesellschaft für Antriebstechnik mbH & Co. KG ("GAT") and Lamellen und Kupplungsbau Beteiligungs KG ("LuK") concerning the marketing in Germany of products by GAT which, according to LuK, amounted to an infringement of two French patents of which LuK was the proprietor. GAT brought a declaratory action before the Landgericht Düsseldorf maintaining non-infringement of the LuK patents and seeking to have the patents declared void or invalid. The Landgericht considered it had jurisdiction, dismissed the action brought by GAT and upheld the validity of the patents.

On appeal by GAT, the Oberlandesgericht Düsseldorf stayed the proceedings and referred a question to the Court of Justice for a preliminary ruling. The question is summarized in paragraph 13 of the judgment as follows:

> "*the referring court seeks in essence to ascertain the scope of the exclusive jurisdiction provided for in Article 16(4) of the Convention in relation to patents. It asks whether that rule concerns all proceedings concerned with the registration or validity of a patent, irrespective of whether the question is raised by way of an action or a plea in objection or whether its application is limited solely to those cases in which the question of a patent's registration or validity is raised by way of an action*."

The issue was therefore whether the German courts had jurisdiction to decide whether the German company GAT's activities would infringe LuK's French patent, and whether a (counter) claim that the patent was invalid affected the German court's jurisdiction in this case. The questions arise because while the courts of an EU member state generally have jurisdiction over the extraterritorial activities of a locally based defendant, Article 16(4) of the Brussels Convention (Article 22(4) of Council Regulation 44/2001) means that that jurisdiction regarding patent validity is exclusive to the courts of the country where the patent is registered.

The Court of Justice ruled that Article 16(4) of the Brussels Convention is to be interpreted as meaning that "*the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection*."

Effectively, the Court of Justice ruled that patent infringement cannot be decided without reference to validity, and validity must be decided upon by the national courts of the Member State where the patent is registered. As a result, the German courts had no jurisdiction to decide in matters relating to validity and therefore also infringement of patents registered in France.

2.2 Case C-539/03: „Roche v. Primus"

Roche v. Primus deals with a reference for a preliminary ruling from the Hoge Raad der Nederlanden regarding the interpretation of Article 6(1) Brussels Convention. Article 6(1) of the Brussels Convention allows a defendant domiciled in a Contracting State to be sued, "*where he is one of a number of defendants, in the courts for the place where any one of them is domiciled*". This represents a special jurisdiction from the general provisions of Article 2 of the Brussels Convention that "*Subject to the provisions of this convention, persons domiciled in a Contracting State shall, whatever their nationality, be sued in the courts of that State*". Article 16(4) Brussels Convention, on the other hand reserves exclusive jurisdiction, in patent validity proceedings, for the courts of the State where the patent is registered, as confirmed in GAT v. LuK.

In Roche v. Primus, the patent proprietors, Drs Primus and Goldenberg, brought an action before the Rechtbank te s'-Gravenhage against Roche Nederland BV, established in the Netherlands, and eight other companies in the Roche group which were established in various EU Member States, Switzerland and the USA, alleging infringement of their European patent. The companies not based in the Netherlands contested the jurisdiction of the Netherlands' court and based their substantial arguments on absence of infringement and invalidity of the patent.

The first instance court dismissed the applications of the patent proprietors. On appeal, the second instance court set aside the judgment of the first instance court and prohibited all the defendants from infringing the rights attached to the European patent in all the countries designated in it. An appeal to the Supreme Court on a point of law led the Supreme Court to stay the proceedings and refer questions to the Court of Justice for a preliminary ruling.

The questions are summarized in paragraph 18 of the judgment as the national court asking whether Article 6(1) of the Brussels Convention must be interpreted as meaning that it is to apply to European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States and, in particular, where those companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.

A point which was given much weight in the judgment, also by reference to Case 189/87 (paragraph 12) and Case 51/97 of the CJ case law, is that for Article 6(1) Brussels Convention to apply, there must exist, between the various actions brought by the same plaintiff against

different defendants, a connection of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings. However, the CJ considered it was not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact (Roche v. Primus judgment, paragraph 26). In Roche v. Primus, the Court of Justice considered that the same situation of fact did not exist, since the defendants were different and the alleged infringements, committed in different Contracting States, were not the same. The Court also considered that the same legal situation did not exist, since infringement must be examined according to national law in the respective Contracting States. There would, therefore, be no risk of contradictory decisions if the defendants were sued before the respective national courts.

Furthermore, any infringement proceedings would also deal with the validity of the patent, which can only be determined, in light of GAT v. LuK, by the national courts of the Contracting State where the patent is registered.

Accordingly, the Court of Justice decided that Article 6(1) of the Brussels Convention must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States, even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.

3. Judgements relating to TRIPs

Case C-53/96 ("Hermès"), Case C-392/98 ("Dior and Others") and Case C-431/05 (Merck Genéricos v. Merck") all concern the interpretation of the TRIPS Agreement, in particular with regard to interim measures, the jurisdiction of the Court of Justice to interpret the TRIPS Agreement, and the direct effect of the TRIPS Agreement, i. e. whether national courts can or must apply the provisions of the TRIPS Agreement in their decisions in IP cases a) where Community law exists (e.g. the Community Trademark Regulation) and b) where the Community has not yet legislated.

3.1 Case C-53/96: „Hermès"

In Hermès, the Arrondissementsrechtbank de Amsterdam referred a question regarding the interpretation of Article 50(6) of TRIPS for a preliminary ruling. This Article provides for the judicial authorities of the contracting parties to have authority to order prompt and effective provisional measures and sets out the requirements and conditions therefor. The case before the national court involved interim measures in an alleged infringement of Hermès' international (Community) trademarks in the Netherlands.

Of relevance to the present discussion is that the Court of Justice considered the question of whether it had jurisdiction to interpret the TRIPS agreement and found that it did, in spite of submissions to the contrary from some Member States. One reason was that the TRIPS Agreement was concluded by the Community and its Member States under joint competence, so that the Court of Justice has jurisdiction to define the obligations which the Community has thereby assumed. Another reason was that provisions of TRIPS can apply to situations falling within the scope of national law and to situations falling within the scope of Community law, so that it is in the Community interest that such provisions be interpreted uniformly. The Court of Justice is in a position to provide such a uniform interpretation. It was also considered of relevance in Hermès that Article 50 of the TRIPS Agreement applies to Community trademarks as well as to national trademarks.

3.2 Case C-392/98: „Dior and Others"

In Dior and Others, the questions referred were similar to that in Hermès, concerning Article 50 of the TRIPS Agreement, except that the Court of Justice was asked to rule on a matter involving an industrial design, which raised the questions of whether industrial designs are intellectual property rights according to the TRIPS Agreement, whether the Court of Justice has jurisdiction to interpret the TRIPS Agreement in cases where no Community legislation exists (compared to Hermès, where a Community trademark was involved), and whether the national court can or must apply the TRIPS Agreement directly in its decision even in the absence of any corresponding provision of national law ("direct effect").

As in Hermès, the Court of Justice found that it also has jurisdiction to interpret the TRIPS Agreement where there is no Community legislation, since the Community and the Member States concluded the TRIPS Agreement under joint competence. In particular, the Court of Justice found it has jurisdiction to interpret Article 50 of TRIPS in order to meet the needs of the courts of the Member States, in order to forestall future differences of interpretation, and to give Article 50 of TRIPS a uniform interpretation. This last point was considered relevant because Article 50 of TRIPS constitutes a procedural provision which should be applied in the same way in every situation falling within its scope and is capable of applying both to situations covered by national law and to situations covered by Community law. According to paragraph 38 of the judgment, only the Court of Justice acting in cooperation with the courts and tribunals of the Member States pursuant to Article 177 of the EU Treaty is in a position to ensure such uniform interpretation. Accordingly, the jurisdiction of the Court of Justice to interpret Article 50 of TRIPS is not restricted solely to situations covered by trademark law.

Regarding the question of direct effect, the Court of Justice decided that:

> "*in a field to which TRIPS applies and in respect of which the Community has already legislated, the judicial authorities of the Member States are required by virtue of Community law, when called upon to apply national rules with a view to ordering provisional*

measures for the protection of rights falling within such a field, to do so as far as possible in the light of the wording and purpose of Article 50 of TRIPS, but

in a field in respect of which the Community has not yet legislated and which consequently falls within the competence of the Member States, the protection of intellectual property rights and measures adopted for that purpose by the judicial authorities, do not fall within the scope of Community law. Accordingly, Community law neither requires nor forbids that the legal order of a Member State should accord to individuals the right to rely directly on the rule laid down by Article 50(6) of TRIPS or that it should oblige the courts to apply that rule of their own motion."

Regarding the question of whether an industrial design is an intellectual property right according to TRIPS, the Court of Justice interpreted Article 50 of TRIPs as leaving this up to the national law of the Contracting Parties.

3.2 Case C-431/05: „Merck Genéricos v. Merck"

Merck Genéricos v. Merck deals with the direct application of Article 33 of the TRIPs Agreement by a national court in a question of the term of protection of a patent.

For the same reasons as in Dior and Others, the Court of Justice found it had jurisdiction to interpret Article 33 of TRIPs.

In deciding the referred question, the Court of Justice also followed the reasoning of Dior and Others, that where there is Community legislation in the sphere in question, Community law will apply, which will mean that it is necessary, as far as may be possible, to supply an interpretation in keeping with the TRIPs Agreement, although no direct effect may be given to the provision of that agreement at issue. However, in the sphere of patents there is no Community legislation, and accordingly it is not contrary to Community law for Article 33 of the TRIPs Agreement to be directly applied by a national court subject to the conditions provided for by national law, i.e. there is direct effect.

4. Biotechnology: Case C-428/08: Monsanto gene: „performing function"

This fairly recent case concerned the interpretation of Article 9 of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions ("the Directive"), in particular in the case of a patent protecting a product containing or consisting of genetic information and the extension of the scope of protection under Article 9 of the Directive to a material incorporating the product.

Article 9 of the Directive provides:

"The protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material … in which the product is incorporated and in which the genetic information is contained and performs its function."

Monsanto Technology LLC ("Monsanto") is holder of a patent relating to enzymes which are not sensitive to the non-sensitive herbicide glyphosate. Plants containing such enzymes survive the use of glyphosate. The genes encoding these enzymes were isolated by Monsanto and inserted into the DNA of a soy plant it called RR soybean plant, thereby conferring glyphosate resistance onto this plant. The RR soybean is cultivated on a large scale in Argentina, where no patent protection is in place.

Monsanto applied for injunctions against two soy meal traders, alleging infringement of the European patent due to their importation from Argentina into the Netherlands of soy meal from RR soybeans. However, the Rechtbank's-Gravenhage, while accepting that Monsanto had established the presence of the enzyme and the DNA sequence encoding it in the imported soymeal, was unsure whether this was sufficient to constitute infringement. It therefore referred the question of interpretation of Article 9 of the Directive to the Court of Justice for a preliminary ruling.

The Court of Justice ruled that Article 9 of the Directive must be interpreted as meaning that the genetic information contained in the patented product must be performing its function in the material in which that information is contained. In the case of soy meal, the genetic information was clearly not performing its function of conferring herbicide-resistance to the material in which it is contained, i.e. to the soy meal, irrespective of whether it had performed that function in the soybean plant or of whether it might be extracted from the soy meal and transferred to a living organism in which it could once again perform its function. Accordingly, the soy meal did not infringe the Monsanto patent.

The Court of Justice also did not accept Monsanto's argument that the principal claim was for protection of its patented DNA sequence as such, which was found in the soy meal. The Court of Justice cited recital 23 in the preamble to the Directive which states that "*a mere DNA sequence without indication of a function does not contain any technical information and is therefore not a patentable invention*."

The Court of Justice also decided that there could be no absolute protection to the product as such under national law, since this would be contrary to the exhaustive harmonization achieved by the Directive. This also held for patents issued prior to the adoption of the Directive.

The Court of Justice also decided that Articles 27 and 30 of the TRIPs Agreement, which concern respectively patentability and the exceptions to the rights conferred by a patent, do not affect the interpretation given of Article 9 of the Directive.

5. Supplementary Protection Certificates

Supplementary Protection Certificates (SPCs) can be granted to extend the effects of a patent for a maximum of five years, where the patent concerns a medicinal product and an authorization to market the medicinal product has been granted by one of the Member States.

The relevant date for calculating the lifespan of the SPC is the date of the first marketing authorization in the EU. Cases C-431/04, C-482/07, C-229/09 and joined Cases C-207/03 and C-252/03 *inter alia* deal with different aspects of the granting and validity of SPCs.

Joined Cases C-207/03 and C-252/03 established that if a marketing authorization (MA) issued by the Swiss authorities and automatically recognized by the Principality of Liechtenstein under that State's legislation is the first authorization to place that product on the market in one of the States of the European Economic Area (EEA), it constitutes the first MA within the meaning of Article 13 of Council Regulation (EEC) No. 1768/92 of 18 June 1992 concerning the creation of a SPC for medicinal products, because although the MA was not issued by an EU Member State, it is recognized by one and has the effect of an MA issued by that State. In this case, the relevant date for calculating the life of the SPC is therefore the date of the Swiss MA, and not the date of a potentially later MA issued by a Member State.

In Case C-431/04, the Court of Justice decided that the concept of "combination of active ingredients of a medicinal product" must be interpreted as meaning that "active ingredients" are those ingredients which have a therapeutic effect. This interpretation excludes from the concept of "combination of active ingredients of a medicinal product" a combination of two substances, only one of which has therapeutic effects of its own for a specific indication, the other rendering possible a pharmaceutical form of the medicinal product which is necessary for the therapeutic efficacy of the first substance for that indication. Accordingly, in C-431/04, an SPC could not be granted for a combination of a substance having a therapeutic effect, for which a SPC had previously been granted, with an excipient capable of slowly releasing the therapeutic substance, since the excipient did not itself have a therapeutic effect and was not therefore an "active ingredient".

In Case C-482/07, it was established that a SPC can be granted to the holder of a basic patent for a product, even if, at the time the certificate application is submitted, one or more SPCs have already been granted to one or more holders of one or more other basic patents.

In Case C-229/09, which concerns a SPC for a plant protection product, the Court of Justice decided that a "provisional MA" can be considered as the first MA for the purpose of creating a SPC.

Farewell for Dominique Monéger

Kim Finnilä (FI)
epi President 2008–2011

Dominique Monéger is a wonderful lady. Having known her for fifteen years makes me a lucky person.

Our first encounter was in 1996 when Dominique attended a PQC meeting acting, as I presumed at the time, as secretary. Years passed, the visits to the *epi* Secretariat became more and more frequent, and as time crept by we became friends.

This even led to a walk in the muddy and slippery woods of eastern Finland together with my colleague Laurent Nuss and his lovely wife Danièle in the autumn of 2003 in connection with a Board meeting in Helsinki. To our pleasure and surprise, at the end of the walk, we found a restaurant offering great snails downed with a Chablis Premier Cru – even found acceptable by the dominant French palate…

At the *epi* Secretariat Dominique was always a guarantee of efficiency, order and stability. She had an excellent overview of all our activities and assisted us rapidly with a high degree of competence and initiative.

In May 2011 Dominique had done her part of the working life and now she certainly earns her freedom. I can see her carefully treading the ripples of the Loire with a paint brush in her hand… I do miss her!

Liebe Frau Monéger,

Walter Holzer (AT)
epi President 1999–2005

Wir haben uns gelegentlich über die Idee des Ruhestandes unterhalten, ohne eine tatsächliche Vorstellung davon zu entwickeln. Dafür war auch kaum Zeit, weil die Belastung des Sekretariats seit der Jahrtausendwende ständig zugenommen hat. Begonnen hatte unsere gemeinsame Tätigkeit im Jahr 1999. Dazu zitiere ich aus einem CIPA *Journal,* September 1999, das mir vor wenigen Tagen zufällig in die Hände fiel. Ein gewisser Chris Mercer schreibt unter dem Titel *epi News*: Secretariat Move – *„As you are no doubt aware, the epi* Secretariat is at present located in the EPO main building in Munich. However, this is soon to come to an end. The EPO requires space for more examiners and the *epi* Secretariat needs more space in view of the increased membership. These needs have proved to be incompatible. Therefore, the *epi* Secretariat is moving out."

Von diesem Zeitpunkt an war nicht nur eine große Anzahl neuer Mitgliedsländer zu integrieren und zu betreuen, es gab auch eine Reihe umfangreicher politischer Aktivitäten, wie die Pariser und Londoner Diplomatische Konferenz samt ihren Auswirkungen, z. B. die Arbeitsgruppe Streitregelung zur Entwicklung des EPLA, die Revision der Konvention in Form des EPÜ2000, die Vorarbeiten für das Gemeinschaftspatent, eine Auseinandersetzung vor dem europäischen Gerichtshof Erster Instanz über der Standesrichtlinien des *epi*, um nur einige zu nennen, ganz zu schweigen von der Herausgabe der *epi* Information. In dieser Zeit hatten Sie die gesamte Arbeit im Sekretariat praktisch zu zweit erledigt, mit Ruhe und Übersicht und noch relativ wenig email Verkehr, was heute kaum noch vorstellbar ist.

Das oben angeführte Zitat aus dem CIPA *Journal* ist nicht vollständig. Unterhalb der Übersiedlungsankündigung kommt Chris Mercer nämlich auf ein anderes Thema zu sprechen: *"Exhibition of epi* Artists. *The epi* is organising an exhibition of artistic works produced by European Patent Attorneys. The exhibition will take place in the EPO Main Building in Munich from 13 to 31 March 2000. The *epi* would like the exhibition to be representative of its members and therefore would be very pleased to display works by UK EPAs. *May I use the pages of your Journal to appeal to any UK EPAs who are artists to volunteer to have their work exhibited? More details on either of the above can be obtained from Dominique Monéger. Chris P. Mercer*

Damit ist eine andere Seite Ihrer Tätigkeit angesprochen, die Veranstaltung einer „Biennale" der *epi* Künstler, zu denen natürlich auch Sie zählen. Ich gehe davon aus und hoffe, dass Sie den Ruhestand zur Gänze der Kunst zur Verfügung stellen und auch in Zukunft als Vorbild für alle EPAs Ihre Aquarelle in den Kunstausstellungen des *epi* präsentieren werden. Die Beschäftigung mit der Kunst kennt keinen Ruhestand, sie ist lebensnotwendig.

Vielen Dank für Ihren unermüdlichen Einsatz und meine besten Wünsche für die kommenden Jahre!

Zuverlässig, ruhig und fleißig: Dominique Monéger Erinnerung an eine 6-jährige Zusammenarbeit

Wolfgang Baum (DE),
epi Generalsekretär 2002 bis 2008

Es war im Mai 2002, nach der EPI-Ratstagung in Stockholm, als ich – gerade gewählter Generalsekretär – mich meinen fünf Mitarbeitern im EPI-Sekretariat vorstellte und meine Arbeit aufnahm. Natürlich hatte ich Dominique Monéger schon bei früheren Ratstagungen kennen gelernt; aber nun war sie ja meine Mitarbeiterin und kam auch gleich mit einer Reihe von anstehenden Entscheidungen zu mir, der weder die interne Arbeitsweise des

EPI-Sekretariats noch die einzelnen Aufgabenbereiche der fünf Mitarbeiter kannte. So war es ganz natürlich, dass ich zunächst der Fragende, um nicht zu sagen, das „Greenhorn" war und darauf angewiesen, sehr viel Neues kennen zu lernen. Gerne erinnere ich mich daran, dass D.M., die praktisch über alle Abläufe im Sekretariat Bescheid wusste, viel Verständnis für diese Situation hatte und nicht nur geduldig sondern auch immer fundiert Auskunft über die bestehenden Verfahrensabläufe gab. Es traf sich dabei gut, dass D.M. eher von zurückhaltender ruhiger Art war, was mir sehr entgegen kam und wodurch von Anfang an eine effiziente Zusammenarbeit entstand.

Im Laufe der folgenden Monate änderte sich dann schrittweise unsere Rollenverteilung, insoweit, als mancher Verfahrensablauf bzw. manche Aufgabe des Sekretariats von mir neu zu regeln oder zu ergänzen war. Jetzt war sie es, die mit großer Aufmerksamkeit und stets mit Bereitschaft dazu beitrug, von mir vorgesehene Änderungen praktisch durchzuführen.

In den Jahren 2002 bis 2008, also in der Zeit meiner Zusammenarbeit mit D.M., wuchs die Zahl der Mitgliedsländer im EPI von 18 auf 31, und die Zahl der Mitglieder verdoppelte sich fast von 4500 auf 8800. Es muss hier besonders lobend erwähnt werden, dass in dieser Zeit der ständig wachsenden Aufgaben es nie Unwilligkeit seitens D.M. gab, sondern dass ich mich immer auf eine konstruktive Zusammenarbeit mit ihr verlassen konnte; an dieser Stelle seien besonders unsere gemeinsamen Vorbereitungsarbeiten für die Ratstagungen erinnert, die in dieser Zeit auf Wunsch des Rates im Hinblick auf die finanzielle Verantwortung mehr in die Hände des Sekretariats als in die der einladenden Landesdelegation gelegt wurden; jeder, der ähnliche Veranstaltungen organisiert, weiß, das alles, was klappt, nicht bemerkt wird, dazu aber im Hintergrund unzählige Details zu regeln sind; gerne erinnere ich mich daran, dass ich in diesem Zusammenhang wiederholt mit Überzeugung und Zufriedenheit D.M. Lob für ihre große Zuverlässigkeit aussprechen konnte.

Nicht unerwähnt bleiben sollen die hohen Anforderungen an Kollegialität und Mitarbeitereinsatz, die sich durch die schwere Krankheit von Diana Della Bella für D.M. ergaben und die sie mit bewundernswertem Einsatz gemeistert hat.

Es ist nicht selbstverständlich, wenn man von einer Mitarbeiterin sagen kann, dass sie immer am selben Strang gezogen hat und immer in die richtige Richtung; ich bin sicher, dass auch andere Vorstands- oder Ausschussmitglieder sich gerne an die Zusammenarbeit mit Dominique Monéger erinnern, ihr Dank sagen und ihr mit mir für ihren Ruhestand alles erdenklich Gute wünschen!

Dominique

Tony Tangena (NL)
Acting *epi* President

As an 'old' Council and Board member I will always remember the excellent organization of our meetings. Dominique made it look easy: Council decides on a meeting somewhere in greater Europe and it was taken care of, but imagine you have to organize meetings in places as different as Vilnius and Istanbul. That is no small feat. Organization is one thing, but people are the core of *epi*: whether they feel comfortable, part of a European 'family', whether they work together, feel at home, respected and taken care of, is even more important. Dominique gave you the 'family' feeling. If you were a new Council member, she would explain things, make you feel comfortable. As an experienced Council member she would welcome you as an old friend, easily speaking all the EPO languages, so that none felt left out. We will miss her organizational talents, but most of all we will miss her warm friendship. We all wish her a very good time in her retirement with lots of new interesting experiences.

Poisonous EPC Divisionals

M. Lawrence and M. Wilkinson in *epi* Information 2/2011

RE: Poisonous EPC Divisionals – an alternative viewpoint

M. A. Hay[1] (GB)

In their interesting article on priority and whole contents novelty, Lawrence and Wilkinson propose that divisional applications and their parents can be mutually anticipatory. If they are correct that the case law of the EPO supports their proposal, then I believe that the case law is built on a flawed legal basis. Where is the flaw?

Article 60 EPC provides that the right to a European patent shall belong to the inventor or his successor in title. Article 60 is a very important provision of the EPC, without which the European patent system would not function properly. However, it is often ignored by both the EPO and Applicants during proceedings before the EPO, presumably because Article 58 EPC permits any person to file a European patent application and lack of entitlement is not a ground for opposition under Article 100 EPC. In the United States, patent applications must be filed in the name of the inventor(s). The inventorship needs to be reviewed in the event that the claims are amended, for example following response to a restriction requirement (objection of lack of unity). The enforceability (validity) of a US patent depends upon the correct inventors having been named for the invention(s) claimed in the patent.

The United States has a first-to-invent patent system. The system includes a procedure known as patent interference. Essentially, this system provides a process for determining which inventor(s) were the first to invent claimed subject matter, and hence are entitled to the rights in a patent for the claimed invention. An interference is thus a contest between inventors for priority.

It is highly unusual for two independent inventors of an invention to file patent applications with identical claims. If an inventor were to give a hundred different patent attorneys the same specific description of an invention, they would each draft a unique set of claims. Clearly, the claims would all be directed to the same invention, otherwise the patent attorneys would be co-inventors. Accordingly, US interference practice has evolved a procedure based upon a hypothetical claim for an invention that is supported by all of the conflicting applications. This hypothetical claim is known as a count.

Turning back to Europe, one can easily imagine a case where an inventor files a priority application containing specific descriptions of A and B, but no claims or generic definitions of any invention(s). A European patent application is then prepared by a patent attorney containing a generic claim covering A and B, subgeneric claims covering either A or B, and specific claims to A and/or B. During examination, the Applicant is obliged to divide the application as between A and B. The application is restricted to claims generically covering A only and a divisional is filed with claims generically covering B only. The description for the divisional is not amended prior to publication, so that it discloses both A and B.

Now, the question arises as to whether the generic claims are entitled to the European and/or the claimed priority dates. Article 87 EPC accords priority where the claims are directed to the same "invention". Article 88(2) permits a claim to have multiple priority dates.

If the generic claims are not directed to the same invention and the species claims, then who is the inventor of the claimed genus? One of the inventors must be the patent attorney who drafted them. If the species A or B within the scope of the generic claims is not part of the claimed invention, then the patent attorney must be the sole inventor of the generic claim. There is no provision in the EPC for deeming a client to be the inventor of an invention made by their patent attorney.

This issue of inventorship is not merely of academic interest. It could be commercially very important, and spawn a whole new sector of commercial activity.

The practice of a patent attorney is unlike the practice of any other branch of law, in that the patent attorney is intimately involved in the creation of property rights, not merely their transfer as when buying and selling real estate. Patent rights can be phenomenally valuable. Instead of working in a master/servant relationship with a client, a patent attorney could find it economically much more attractive to enter into collaborations with other inventors, to create jointly owned patent rights. For example, in the case given above, the inventor of A and B and the inventor of the genus (the patent attorney) might collaborate based upon an agreement to commonly own the patent rights. In effect, the patent attorney starts a new career as a property developer. For more thoughts along this line, please see my GB 2474105 and US 2011- 0082805.

I do not think that a patent attorney can be the inventor of a genus drafted to protect a client's specific invention, as I have explained in GB 2474105 and US 2011-0082805. In the example given above, the inventor of A and B is also the inventor of each genus in the

1 European Patent Attorney, US Patent Agent

generic claims. However, if European case law is allowed to develop along the line that a genus is not the same invention as a species within it, then what is to stop patent attorneys from claiming inventorship rights?

Patent law throws up many paradoxes, because it has not been designed as a coherent system. Boards of Appeal and Courts have to find practical solutions when such paradoxes arise. In the example given above, I think that the practical solution is to treat the generic claims in the parent and divisional as having two dates: the priority date and the original European filing date. As long as the parent and divisional retain the original specific descriptions of A and B respectively as embodiments of the claimed inventions, then it should be as if the words "including embodiment A" and "including embodiment B" are part of the subject matter of the generic claims in the respective applications. Consequently, the parent and divisional cannot be mutually anticipatory.

I think that the parent/divisional situation is relatively straightforward. The more difficult problem arises where a European patent application has been filed claiming priority from an earlier application the whole contents of which will become available for citation for novelty purposes. This can happen, for example when claiming priority from a PCT application that disclosed an embodiment not disclosed in its own priority document. It is not uncommon for Applicants to be tempted to replace that example (embodiment A) with a better one (embodiment A', e.g. an example of a chemical process that gives a better yield). That could be fatal. There would then be no basis in the European application for deeming the claim to contain the words "including embodiment A". The whole contents of the priority document would anticipate the generic claim even though priority had been claimed.

In conclusion, Europeans are sometimes quick to find fault with the US first-to-invent patent system, but its focus on treating patent applications as property rights belonging to the true and first inventor ensures a coherent (albeit inefficient) patent system. Lack of entitlement is not a ground for opposition under the EPC, but the practice and case law of the EPO must develop along lines consistent with Article 60 EPC if the overall system is to function coherently. The incentive of private property rights for inventors lies at the heart of a properly functioning patent system in a modern economy.

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