



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

Ausschuss für Europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

3rd April, 2019

Report from the Guidelines sub-committee

Point 1

On January 2018, a letter was sent to the EPO (Heli Pihlajamaa), suggesting a change of the revision cycle and explaining our concern concerning Issuing Summons to OP as first action in examination. See **Appendix A**.

The response is enclosed as **Appendix B**.

Point 2

20 March 2018 the SACEPO WPG members received EPC Guidelines and part B of the PCT-EPO Guidelines with EPO amendments for the November 2018 version for review, with a deadline of 20 April 2018. The Guidelines parts were posted on the Forum and a number of comments and suggestions were collected, compiled and send to EPO. The parts and our comments can be found on the Forum.

Point 3

The Guidelines sub-committee received the November 2018 guidelines drafts very late. We were asking for them several time, but did not receive them until 26 July 2018, with a deadline for comments/suggestions on 5 October 2018.

Many Guidelines sub-committee members as well as other epi members took time to review one or more parts and providing their comments/suggestions. The comments/suggestions were collected and discussed at a Sub-committee meeting in Copenhagen on 27-28 September 2018 and final lists of comments/suggestion was send to the EPO on 5 October 2018.

Thanks to everyone who have contributed.

Point 4

The 16th SACEPO WPG was held on 21 November 2018.

The EPO announced that matters concerning biotech related inventions would not be discussed at this meeting, but a supplementary SACEPO WPG meeting would be arranged



for this (see below).

It was further announced that 3 parts of the Guidelines for November 2019 would be distributed late March for comments/suggestion with a one month period for comments.

We shall be prepared for this. I will send these 3 parts to the sub-committee members for comments/suggestion as soon as possible.

The minutes of the meeting is enclosed as **Appendix C**.

Point 4.1

The results of the discussions at the SACEPO WPG are enclosed as **Appendix D** (EPC GL) and **Appendix E** (PCT-EPO GL).

As usual, many of our comments/suggestions were accepted partly or fully and some were rejected.

I wish to comment on a few:

PCT-EPO Guidelines

Expanding the GL

EPO intends to expand the PCT-EPO Guidelines over a number of years. The Office announced that, in the next edition of the PCT-EPO Guidelines, it intends to expand Part A by the inclusion of two new chapters dedicated respectively to “drawings” and “languages”.

EPC Guidelines

No Meaningful search

B-VIII 3 concerning “No meaningful search possible” has been discussed many times. For the 2017 revision we decided not to make general comments, but instead aiming at improving the wording slightly, such that “many claims” in itself is not sufficient reason to not search. We had success with this. Hence, for the 2018 revision we requested an amendment specifying that broadness of a claim was not in itself a reason not to search. This suggestion was accepted. What should we attack in the 2019 revision?



New document in Summons

E-III 6 - we argued that citing new documents in Summons to Oral appears to me to be a violation of the party's right to be heard.

The EPO did not agree and referred to T120/12 (at 4.4).

The Office asked to provide examples if it is believed that the practice of E-III 6 is not correctly followed.

We wish to discuss if this is a substantial problem.

Double patenting

In G-IV 5.4, we had the comment:

In relation to double patenting, the following sentence has been added:

"The prohibition of double patenting applies to three types of combinations of European applications by the same applicant: two applications filed on the same day, parent and divisional applications, or an application and its priority application."

What is the basis for this?"

At the meeting, we specifically mentioned that we did not find any basis for prohibition of double patenting in respect of an application and its priority application (third type).

The EPO answered that this was based on T 2402/10.

After the meeting, we send a letter to the EPO – See **Appendix F**.

The answer to this letter is attached as **Appendix G**, and attachment is **Appendix G-1**.

SACEPO WPG on Biotechnology

A supplementary SACEPO WPG on biotechnology took place on 22 February 2019.

A paper focused on the amendments in respects of new Rule 28(2) EPC that entered into force on 01.07.2017 was discussed. See **Appendix H**. Additional comments/suggestions from epi have been send to the EPO for discussion. See **Appendix H**.



The minutes of the supplementary SACEPO WPG on biotechnology is attached as **Appendix I**.

The consultation result of the supplementary SACEPO WPG on biotechnology is attached as **Appendix J**.

Revision of Guidelines for the 2019 versions

On 26 March 2019, we received preliminary revision drafts of EPC Guidelines parts B, D, E and H and EPO-PCT Guidelines parts B, C and D.

The Guidelines parts are uploaded to the epi Forum [permalink](#). The deadline for sending comments to the EPO is 29 April 2019.

Next ordinary SACEPO WPG

Next ordinary SACEPO WPG will be held in November 2019.

Appendixes

A: Letter from epi.

B: Answer from EPO.

C: Minutes of 16th SACEPO WP GL meeting.

D: Consultation results EPC GL.

E: Consultation results PCT-EPO GL.

F: Letter from epi.

G: Answer from EPO.

G-1: Attachment to EPO answer.

H: EPI comments on amendments in respect of new Rule 28(2) EPC.

I: Minutes of supplementary SACEPO WPG on biotechnology.

J: Consultation result of supplementary SACEPO WPG on biotechnology.