epi Information

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G 10904 F | ISSN 1434-8853 | Art.-Nr. 56356102 | Juni 2011

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

Carl Heymanns Verlag

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Verlag / Publishing House / Maison d'édition
Carl Heymanns Verlag
Eine Marke von Wolters Kluwer Deutschland GmbH
Luxemburger Straße 449
D-50939 Köln
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www.heymanns.com

Anzeigen / Advertisements / Publicité
Carl Heymanns Verlag
Eine Marke von Wolters Kluwer Deutschland GmbH

Druck / Printing / Imprimeur
Grafik + Druck GmbH, München
ISSN 1434-8853

Vierteljahreszeitschrift
Abonnement im Mitgliedsbeitrag enthalten, für Nichtmitglieder € 52,00 p.a. zzgl. Versandkosten (€ 9,90 Inland / € 14,00 Ausland), Einzelheft € 20,00 zzgl.Versandkosten (ca. € 2,27 Inland / ca. € 3,20 Ausland) je nach Heftumfang. Preise inkl. MwSt. Aufkündigung des Bezuges 6 Wochen vor Jahresende.

Quarterly Publication
Subscription fee included in membership fee, for non-members € 52,00 p.a. plus postage (national € 9,90 / abroad € 14,00), individual copy € 20,00 p.a. plus postage (national about € 2,27, abroad about € 3,20) depending on the size of the issue, VAT included. Cancellation of subscription is requested 6 weeks before any year's end.

Publication trimestrielle
Prix de l'abonnement inclus dans la cotisation, pour non-membres € 52,00 p.a., frais d'envoi en sus (national € 9,90 / étranger € 14,00), prix à l'unité € 20,00, frais d'envoi en sus (national environ € 2,27, étranger environ € 3,20) selon le volume du numéro, TVA incluse. Résiliation de l'abonnement 6 semaines avant la fin de l'année.

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Editorial

T. Johnson (GB)

„The times they are changin'", so sang Bob Dylan, who will be 70 this year. It might be considered appropriate that the 70th meeting of our Council has just taken place, in Dublin, and marked the beginning of a New Council term, with a New Board and many New Council Members from the 38 Member States of the EPC. The New President of our Institute, Tony Tangena (NL) gave a rousing presentation to the New Council, setting out his mission statement for the *epi*. He asked, where do we want to go as an Institute, and how do we get there? The Institute should emphasize what it is for, not what it is against and in doing so should be proactive, not reactive, and should strengthen its links with the EPO, the EU, and sister organisations. In addition, the Institute should strive for efficiency internally, and continue to strengthen its educational programme. The agenda we feel could be challenging, and the Institute has to be alert to what is a changing world in IP. The EPO for example encourages users, particularly attorneys, to provide input on their views as to what the Office is doing, with the aim of improving the EPC system. As part of the European Patent Organisation, our Institute is well placed to do so. Classification of patent literature world-wide could be set to change following the development of the Cooperative Patent Classification System (CPC) a partnership between the EPO and the USPTO and which is based on the USPTO adopting the ECLA as a basis for the system. The EPO is to be congratulated on its role in providing a basis for the CPC. There are, and will be, many other changes in the world of IP during the life of our New Council. We are confident that Tony Tangena and the New Board will ensure that the Institute rises to these challenges, that its image is burnished and that the work of all Members of the Institute will continue to be respected in Europe and abroad. We wish the New Council well, the times are certainly changing.

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 **12. August 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 **12th August 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 epi Information est le **12 août 2011**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Elected Board and Committee Members

At the 70th Council meeting in Dublin the following Board members were elected:

Tony Tangena,
the new elected President

Präsident/President/Président
NL – Antonius Tangena

Vize-Präsidenten/
Vice-Presidents/Vice-Présidents
DE – Gabriele Leissler-Gerstl
RO – Mihaela Teodorescu

Generalsekretär/Secretary General/Secrétaire Général
PT – João Pereira da Cruz

Stellvertretender Generalsekretär /
Deputy Secretary General/Secrétaire Général Adjoint
CH – Michael Liebetanz

Schatzmeister/Treasurer/Trésorier
BE – Claude Quintelier

Stellvertretender Schatzmeister/Deputy Treasurer/
Trésorier Adjoint
CZ – Frantisek Kania

Mitglieder/Members/Membres

AL – Vladimir Nika
AT – Friedrich Schweinzer
BG – Natasha Andreeva
CY – Christos A. Theodoulou
DE – Lothar Steiling
DK – Bo Hammer Jensen
EE – Margus Sarap
ES – Luis-Alfonso Durán Moya
FI – Marjut Honkasalo
FR – Jacques Bauvir
FR – Laurent Nuss
GB – Edward Lyndon-Stanford
GB – Simon Wright
GR – Vassiliki Bakatselou
HR – Davor Bošković
HU – Ádám Szentpéteri
IE – Lindsay Casey
IS – Thorlakur Jonsson
IT – Micaela Modiano
LI – Burkhard Bogensberger
LT – Reda Zaboliene
LU – Bernd Kutsch
LV – Jevgenijs Fortuna
MC – Günther Schmalz
MK – Valentin Pepeljugoski
NO – Dag Thrane
PL – Anna Slominska-Dziubek
SE – Nils Ekström
SI – Gregor Macek
SK – Dagmar Cechvalová
SM – Andrea Tiburzi
TR – Selda Arkan

The results of the election of committee members are available on pages 85–88 of this issue.

Report on the 70th Council Meeting 23-24 May 2011, Dublin

T. Johnson, Editorial Committee

Kim Finnilä opened the meeting, the 70th meeting of Council which marked the beginning of a new Council term, the 16th since 1978.

New members of Council representing respectively Albania and San Marino were introduced and welcomed.

Members of Council were present following the recent elections, which Mr Finnilä reported had been conducted validly, there being a turnout of about 40 % overall of *epi* members voting. There were no protests concerning election results for any constituency. There now being 38 Member States as opposed to the original

7 in 1978, Council approved a proposal that amendment of the Rules for election would be considered. The election results for the 70th Council were then confirmed unanimously.

The Treasurer then gave an extended report based on the closing of the accounts for 2009 which had been held over pending investigation of the mis-demeanours of the former book-keeper. The conduct of the former external auditors was also being considered; they could be said not have fulfilled the duty of care they owed to the Institute. The Treasurer reminded Council that a new book-keeper is now employed, and he thanked the whole Secretariat for their work in assisting him in getting to the bottom of the problem caused by the former book-keeper. The Treasurer also reported that where there had been a double payment of subscriptions, ,,pay back" had to be made. After discussion, Council voted by a large majority that pay back policy would be to make a re-payment of a double subscription which had taken place in the previous three years. In order to make a re-payment a member would need to support a request for re-payment by producing evidence of over-payment.

The External and Internal auditors had confirmed that the 2009 accounts were now in order, so Council thereby approved those accounts by a large majority. Nothing contentious arose from the 2010 accounts, so they were also approved. Having finalised the previous two years' accounts, a revised budget for 2011 was presented, (there having been a previous draft), showing an increase in rent provision to 110K euros (from 103K euros) to take account of inflation and the rent of cellar space for storage. Also, as a precaution, legal costs were now included in the budget in the amount of 25K euros. The revised 2011 budget was approved by a large majority. The new External auditors had suggested future auditing would be simpler for them and more reliable if the *epi* accounts were prepared by rules established by the German HGB (Handelsgesetzbuch). Council approved the use of these rules.

Council then discharged the Board for both 2009 and 2010.

The Treasurer was thanked with acclamation for the work he had done in regularising the finances of the Institute, the thanks being extended by the Council to the Secretariat, Finance Committee and Internal Auditors.

The Secretary General reported that as of 11th May 2011 there were 9932 professional representatives on the list including 24 from Serbia (RS). The Council representatives for that State had to be appointed by the EPO President in consultation with the National Office. Regarding the Secretariat he reported that Ms Moneger would be retiring at the end of the month. Ms Michaela Kowal had been employed as an accountant from 1st April 2011 and Ms Renate Schellenberg had also been employed from that date as assistant to the Committees, her role also being to provide additional support for Board and Council meetings. Secretariat staff had taken part in a seminar held by the European Patent Academy, also attended by CEIPI Secretariat staff, which was positive for future co-operation between *epi* and our sister organisations.

A claim for debt enforcement against the former book-keeper had been initiated.

In accordance with a former decision of Council, a suitable candidate for the post of Director of Co-ordination and Communication (DoCC) had been identified. If appointed this person could start work on 1st July 2011.

Kim Finnilä then gave a comprehensive report of his activities since the last Council meeting, reminding Council that the Institute web-site had been launched a year ago and was now more user-friendly. Regarding IP5, the EPO was considering the format of consultation with the Institute. The President of the EPO wishes to sustain and develop contacts with the *epi*.

Kim reminded Council that this was his last Council meeting as he was stepping down as President and as a Council member for Finland. He had been active in the *epi* since 1997 when he became a member of the PQC. He outlined developments during his term of office, resulting in a strengthening of the Institute both internally and its external relations with other bodies in the IP field. He had also initiated a steering group comprising the Presidium, chairs of committees and the DoCC to direct the *epi* for the benefit of Members. He graciously thanked Council for its support over his term of office. Sylvain le Vaguerèse, an outgoing Vice-President, then gave a fulsome encomium to Kim, who then received a standing ovation from Council in acknowledgement of his work as President.

Election of the new Bureau then took place, those elected being:

President:	Antonius (Tony) Tangena (NL);
Vice-Presidents:	Gabriele Leissler-Gerstl (DE);
	Mihaela Teodorescu (RO);
Secretary General:	João Pereira da Cruz (PT);
Deputy Secretary General:	Michael Liebetanz (CH);
Treasurer:	Claude Quintelier (BE);
Deputy Treasurer:	František Kania (CZ)

Tony then gave his own encomium for the immediate Past President and the old Presidium, which he followed by giving a Power Point presentation setting out his agenda for the ensuing three years. He said his strategy will be one of high-level aims, basically addressing the questions, where do we want to go, and how do we get there? He hopes that the Institute will be positive, emphasising what it stands for and not what it is against. For example on the EU Unitary patent the overall philosophy should be to say if we cannot get what we like then let us like what we get.

Council then elected Board Members from the respective Member States, and members of committees, all of whom are set out elsewhere in this issue.

Various committees then reported to Council. PQC reported that it hoped to invite a representative from the

European Patent Academy to its next meeting. The MoU with the Academy was also discussed, as it was desired to strengthen links with the Academy. A person deemed suitable for the post of Director of Education had been identified. The new Presidium would be asked for approval so that the person could take up the post on 1st July 2011. The DoE will report to the PQC.

Council was reminded by Mr Schweinzer that the Institute had an education plan, the main goal of which was to secure a quality standard in the profession. The main topics addressed by the plan are (a) candidates, and their preparation for the exam; (b) grandfathers; and (c) continuing professional education (CPE). For (a), it is proposed to increase mock EQEs from 2 to 5, to hold them in locations in new countries, and to increase and expand tutorials, arrange special training for pre-examination and also provide training for candidates in countries with a large majority of (or only) grandfathers. For (b) the aim is to introduce new ,,train the trainer" courses for both old and new countries, to hold follow-up seminars, to create on-line training courses, and to provide specific courses on basic topics such as filing procedure, opposition etc. For (c) the aim is to follow EPC2DAY seminars in various countries to establish a programme on the PCT and new PCT Rules, to create new topics on a one-per-year basis, and to hold CPE seminars (more than 5 per year) in various locations.

As part of the EPPC report Chris Mercer spoke to the Manual of Best Practice being compiled by the EPO. There was an extended discussion, as a result of which Council proposed that Tony Tangena would discuss the project with the President of the EPO.

All outgoing committees were thanked with acclamation for their work over the previous term and new committees were also thanked for their willingness to work on behalf of the *epi*.

Ms Monéger had been with the Institute for 21 years as an integral part of the Secretariat. As she was due to retire at the end of May the present manager of the Secretariat gave a warm address outlining her tireless work and invaluable contribution to the *epi* over those years, to which Ms Monéger sincerely and graciously saying how she had enjoyed her time and had made many friends. Tony Tangena wishes her well for a long and happy retirement, and presented her with a gift on behalf of the *epi*. Council gave her a standing ovation.

The next Council meeting is due to take place in Darmstadt (DE) on 5th November 2011.

Presidential Visits

The meeting of the 84th Board of the *epi* in Budapest on March 18 and 19 was honoured by a visit from EPO President Battistelli, EPO Vice-President Lutz (DG5), and Mihály Ficsor, Vice-President of the Hungarian Intellectual Property Office.

President Battistelli during a one hour intervention presented an overview of and his plans for the activities of the EPO during the forthcoming years. At the beginning of his speech President Battistelli emphasised that the *epi* had been a privileged partner of the EPO for 30 years. He wishes for a continued and improved cooperation, as many objectives of common interest will have to be implemented in the future.

In general, the EPO is in good health, the President remarked, with 38 Member States and two extension countries (Morocco and Tunisia) plus three countries with validation agreements which will not join the EPC. President Battistelli considers 40 member countries to be the limit of the economic growth for the EPO. The European patent could thus be effective over an area totalling 600 million inhabitants.

In 2010 the number of applications has increased by 11 % over 2009, an increase of 5 %, if one disregards divisional applications. The granting rate amounted to 42 %, the pendency time is about 43 months, search reports and written opinions are delivered within about 6 months.

The fast track procedure was used for only 6.3 % of the applications, the opposition rate amounted to about 4.7 %.

The President stressed the Office's ambition for *quality*. No changes are expected as regards the initiative „raising the bar", as the economic impact of this initiative should be assessed first and shared with the users, and the real effect of these changes still has a question mark.

In general, the President sees the task of the Office as balancing an applicant's interest with the interests of third parties, which according to the President are equally important. Even if the applicant is a large company or a business leader, this applicant will always file less applications than all of the competitors together, the President remarked.

Another major topic for the President is *efficiency*. Any dramatic increase of fees is not foreseen, the balance of pre-grant and post-grant fees should remain, of course minor adaptations will be made over time. The *budget* of the EPO shows a balance between 70 % pre-granting fees and 30 % post-granting fees. If changes are to be made they will address the annuities in the last years of a

patent's life, because such patents renewed over a long period have apparently created profits.

The President then referred to *external* studies he had commissioned after taking office. In order not to lose time he had set himself priorities, with a road map, precise objectives, a calendar and a budget. The first of the studies commissioned concerned IT. The *IT system* of the Office, although globally solid, uses old technology in ESPACENET, EPOC and so on. Other major offices, such as the Korean are more advanced. Efforts will therefore be made to improve the IT system. One has to be careful, however, because in the IT field it is easy to make mistakes, since IT is user driven.

As to *finances,* over the next 10-20 years the President does not foresee any problems for the Office, in particular as far as training and building ventures are concerned. Although there are no financial constraints for the Office at present and in the near future, the long term demographic staff structure needs to be taken into account, as in 2025 a sharp increase in pension expenditure will occur; therefore, the pension regime needs to be addressed and reformed without causing social unrest. The staff must accept the idea of a system change, not only for newcomers. As to the Office management – staff relationship, President Battistelli said this now is more transparent and open. The EPO is a community of about 40.000 people, there must be a social dialogue. *Management – staff relations* will therefore be improved, based on a mutual understanding. Apart from a dialogue with the staff, a dialogue with the stakeholders will have to take place. The EPO is still too internally oriented and should be open to external influence. In particular the DGs must be more open.

The President then reflected on the forthcoming *unitary patent* pursuant to the recent decision of the Council of Ministers. He considers the enhanced patent for 25 member states a positive step. As to the calendar of enhanced cooperation: the necessary Regulation on unitary protection and the language regime will be established. The EPO will be responsible from filing to grant, and thereafter the applicant will have the choice to take out a unitary patent according to the enhanced cooperation and a European patent for the remaining countries. This is a new task for the EPO, as if it were a national office. It will publish the unitary patent and will also collect annuities.

The fate of the *litigation system* is open, for the time being. Either the 25 countries will wait until in about five or ten years a treaty concerning a community patent court is ratified, or for all pending applications a transitory judicial system is adopted and national courts specialised in patent matters will be given the competence to decide on enhanced patents in litigation.

As to *patent reforms*, Europe is not alone, President Battistelli said. In the US Patent Reform is also taking place. In the framework of IP5 a new classification system will be created. The US will adopt a system based on the European classification. The President also said that in relation to the EPN Network the strategic debate is terminated, the role of the EPO has changed, NPOs have to develop activities, taking into consideration that there is a European level and a national level. The EPO assists national offices in developing capacities, in training, innovation policy, IP policy etc.

The President concluded that the EPO is on a solid basis, that the European system is a success and that the EPO is a global player (with 45 % of the applications from non European applicants).

epi President Finnilä in a first reaction underlined that the *epi* supports the EPO in its plans.

He referred to the EPN, and in this regard stated that the EPC resulted in a harmonisation of European patent law. He stressed the importance of the European Patent Academy in fostering training, and pointed to the „EPC2DAY" Seminar in Finland as an example.

epi Vice-President Le Vaguerèse expressed his satisfaction with the financial situation of the EPO and added that small fee increases are acceptable. Mr. Tangena referred to the role of NPOs as an information and service tool as well as to the service of European Patent Attorneys in this respect. He pointed out that France provides for pre-diagnostic tools for industry. President Battistelli replied that for SMEs patent attorneys are essential actors. In a pro-active IP policy NPOs have a complementary role. The EPO on the other hand should rather concentrate on its core business.

Mr. Pereira da Cruz asked whether in a future patent court system for 25 countries, in which national patent courts could become active during an intermediate period, the invalidity of unitary patents should also be decided on. President Battistelli replied that since there also are European trademark courts in the member states acting in this respect, objective criteria should be applied when choosing the courts, they should be specialised and experienced courts with a certain number of cases to their credit. The panels should comprise both legal and technical judges. EPO Vice-President Lutz reflected the decision of the ECJ, that what will be possible in the future is still open, as there will be no court outside the EU, and what will be possible within a relatively short transition period, would be national courts deciding in litigation, however not on European patents.

Mr. Nuss asked about representation, the European Patent Attorneys Litigation Certificate, the European Patent Academy with its budget increased by 1 million Euros, the role of the Academic Advisory Board and the cooperation of national training centres as well as of the CEIPI with the Academy. President Battistelli stated that in the future there will be different and competing training centres. As concerns the CEIPI, President Battistelli considered that there is no monopoly in training activities in Europe and that further discussion with the CEIPI about the envisaged EURO – CEIPI collaboration will begin once the findings of the working group on the activities of the CEIPI have become known.

Upon further interventions from other Board members President Battistelli said the quality issue also applies to the EPO Boards of Appeal (DG3). New Boards will be created to cope with demand. He again referred to the

automatic translation system. A non-exclusive Partnership-Agreement was concluded with Google. Google has the technology, the EPO provides the linguistic know- how. Google will provide translations in all (29) European languages, also non-European languages (prior art from CN, JP, KR). These translations will have no legal value. The service will be available on the EPO website free of charge in 2011. All languages will be available from 2014.

In a separate presentation Mr. Mihály Ficsor, Vice-President of the Hungarian Intellectual Property Office, drew a precise picture of the current situation of the so-called enhanced cooperation, both as regards the Regulation on a unitary patent and the possible court systems for enforcing this patent. Mr. Ficsor gave his overview over the enhanced cooperation from the viewpoint of the Hungarian EU Presidency.

As chair of the Patent Working Group of the European Council, he started with the state of the art and added that the unitary patent will contribute to competitiveness in Europe. It will improve the situation in countries with little innovation. It should combine cost effectiveness with legal certainty. The package would include four elements: 1.The Regulation on the unitary patent; 2. a unanimous Council proposal concerning the translation arrangements; 3. a Patent Court for unitary patents; 4. an agreement on the relationship between the EU and the EPO.

On 4/12/2009 the European Competitiveness Council reached conclusions on a general approach concerning a unitary patent. The translation arrangements remained a question mark.

The Regulation on the unitary patent (which requires a qualified majority in Council) and a separate Regulation on the translations (requiring unanimity in the Council) should enter into force together.

On 10/11/2010 the Competitiveness Council realised that a unanimous decision was impossible to achieve among all 27 member states, because Spain and Italy refused the proposed language arrangements. Thus, a common patent for the entire Union would politically not be possible.

On 10/12/2010 twelve member states therefore decided to continue with an in-house cooperation, the so-called enhanced cooperation. According to the EU treaties this enhanced cooperation may make use of the EU institutions, such as a Regulation. It is the „last resort" when the EU as a whole cannot attain its objectives. The envisaged enhanced cooperation would only bind the participating (25) member states. The enhanced system according to Article 308 EU Treaty requires consultation with the EU Parliament after a unanimous vote in the Council.

On 14/12/2010 the Commission proposed the use of enhanced cooperation for the creation of a common patent system. Up to now, 25 member states have joined. Italy and Spain have abstained. Moreover, any member state may withdraw from the enhanced cooperation until legislative acts have been adopted. The proposals for the two Regulations will be elaborated during April 2011 (*the proposals have indeed been published on April 14, 2011*). A Regulation on the unitary patent will bind only the member states involved.

The enhanced patent can be filed in any language; the grant will be in one of the EPO official languages. No further translations will be necessary. Upon the grant of the patent, an applicant will thus have a choice of a unitary patent and patents for the non-participating member states. As a permanent measure the following would be foreseen for disputes: full translation into the language of the infringer as well as the language of the court. Upon adoption of the Regulation the Council will have to decide on the annuities distribution key.

As to the possible *revision of the EPC*, the following options exist: 1. Accession of the EU to the EPC and Revision of the Convention plus ratification pursuant to Article 33. 2. Agreement between the EU and the EPO, entrusting the EPO with the grant of a unitary patent.

As to the *litigation* arrangements: the EEUPC was meant for European patents and community patents. The Court of Justice, however, gave a negative AVIS. The ECJ basically said that no court could exist outside the EU because the relationship between the ECJ and national courts is indispensable for preserving EU law. The ECJ's decision needs to be analysed in detail. The following questions remain: 1. Is it worthwhile to create a unitary patent without a centralised single court system? 2. If one sticks to the idea – no unitary patent without a court system – one has to create a court system, which means unanimity and a subsequent ratification procedure. 3. Should a court system be created within an in-house cooperation system, i. e. a few national courts specialised in patents, like the European Trademark courts for Trademarks? 4. Transitional provisions could provide for a mixed solution. The Hungarian Presidency will continue to work on these topics, however it requires proposals from the EU Commission.

An open question also is as to whether the Directive on Enforcement should be revised.

The *epi* Board thanked all the speakers with acclamation.

Walter Holzer (for the Editorial Committee)

Report of the Committee on Biotechnological Inventions

A. De Clercq (Chair); S. Wright (Secretary)

This report mainly summarizes the last yearly meeting of the Biotech Committee on November 11, 2010.

The following issues were discussed:

WARF and Stem Cells

We would like some guidance from the EPO on what is, and is not, publicly available in terms of stem cell lines. Furthermore, there seems to be no consensus, or internal guidelines, on this point. We need consistency.

EU Biotech Directive

It was reported that Italy effectively now has purpose-bound protection, in common with several other European countries. The way some countries have implemented the Biotech directive is clearly influencing others. It was thought that some States had wrongly used the Recitals to interpret Article 9. There was a discussion on the meaning of function, and whether that means that the function had been performed (in the past), or that it could be performed (i.e. performable) at some time in the future.

Italy had recently introduced a new amendment to the national law, as a result of harmonisation with the EPC 2000. It requires the function of the gene to be placed in the product claim. It appears to apply to Italian national patents only, but this is far from clear. Thus, we are not sure whether it applies to EP (IT) patents, and clarification is awaited from the Italian Patent Office. Note that there are fines, for example, if one does not indicate the origin (up to Euros 100,000) and even more (Euros 1,000,000) if consent has not been obtained first.

Mr Danielle Pieraccioli provided an update on Italian law. As for the meaning of a credible function, some members had experienced such rejections from the EPO concerning fragments and variants.

On the WARF case, there is a separate referral by the German Courts on the Brüstle case to the ECJ concerning stem cells, and we await the outcome of the decision (opinion of AG came out on March 10, 2011).

Requests by Examiners to remove the word „isolated" seem to have receded, but in any event practitioners may be reluctant to use the word „isolated" in view of the recent UK/ECJ Monsanto decision.

Divisionals

It was agreed that the new divisional rules are going to hit biotech companies hardest. Most applicants think the two year deadline is unfair. It was thought that someone will file a test case, at some stage, on a divisional application outside the two year time limit. The current EPO President, Mr Battistelli, had said at a AIPLA meeting that he was not against further discussion of this particular topic.

We should consider how we can change the divisional rules, if at all possible. Individuals, on their own behalf and representing their firms and companies, were encouraged to write to the EPO.

It was noted that one of the reasons that the EPO gave for abuse, namely filing divisionals before Oral Proceedings, now no longer exists after the Enlarged Board of Appeal's decision on the meaning of „pending".

The practice on Rule 36(b), and what constitutes a „new" disunity objection, should be raised with the EPO Directors. One of the problems is that Examiners are suggesting that a disunity objection may possibly be raised sometime in the future, so it is not clear whether an Article 82 objection is being raised or not. So, it is unclear as to whether the examination report triggers a two year term.

Interestingly, Rule 36(b) doesn't say what subject matter the divisional can be directed to, even though the EPO Guidelines seem to suggest that it can only be filed to subject matter not yet searched. The law is not clear, but it does look as if one can file a divisional directed to any invention. Of course, we won't actually know what the answer is for a few years. Rule 36(b) is a prime example itself of lack of clarity!

We are also concerned about the unpredictability of the EPO in terms of objections raised. For example, one member had the Examiner change his mind in between issuing the Written Opinion in the International Phase and the first Examination Report (after entry into the European Regional Phase).

Double-Patenting

The case law is still not clear, but it does appear as if objections will now only arise where claims are identical. Note the recent decision where the EPO drew a difference between the European priority application and the European application in suit (the latter potentially giving one more year's worth of life to the patent). Some Examiners are keener than others to raise double patenting objections. It is unclear as to whether this matter may be referred to the Enlarged Board of Appeal.

Sequence Listings

We still seem to be getting invited to file sequence listings, and fined €200, on relatively minor issues. We think the Formalities Officers are not well informed, and are being far too strict. One member noticed the difference between The Hague and Munich (the first seems

to object more frequently, especially on minor points). For example, one member was asked to pay the fine when they had simply omitted the word „primer". Some Formalities Officers have asked that „human" should be changed to "*homo sapiens*".

G1/07 and Surgical Methods

It seems as though no significant change in practice has occurred. The decision has not lead to new objections are being received by members.

G2/06 and Dosage Regimes

The Enlarged Board of Appeal decision has now been published. This starts a three month cut-off period, expiring 29 January 2011. One member noted that he had received objections from Examiner to having both types of claims, the Examiner arguing that one type is redundant.

An interesting question arose whether if a parent has Swiss-style claims, and you then file a divisional that only had EPC 2000 claims. Would the claims of that divisional be allowable? Note that the EPO doesn't like looking at the scope of claims, but of course it needs to, for example, when considering double patenting issues.

Note that (amazingly) Spain appears not to have fully implemented EPC 2000. The ES PO will allow Swiss-style claims in a Spanish national application, but not EPC 2000 style claims. It is thought that for European patents designating ES, the Spanish Courts will follow EPO practice.

Crystallographic Data

The main problem here is page fees, because the data is essential, and uses a lot of pages. It makes cases very expensive. We wonder whether we could file the data separately, perhaps electronically?

Perhaps the *epi* should push the EPO to drop, or decrease, the page fees. It takes the EPO time to check if they are incorrect, and to send out Communications if not, so there is little profit for the EPO on this particular matter.

Sufficiency

We are seeing more sufficiency objections under the guise of inventive step. One member said that the EPO is becoming like the Chinese Patent Office, allowing very narrow claims, barely covering the Examples. The EPO is also becoming tougher on the width of antibody claims.

There are two recent cases to be noted. T1617/07 concerned antibodies and said that a single CDR may be sufficient to define an antibody. T1305/00 arose from the insistence of the Examining Division that the Applicant should limit to the specific sequences. There was concern that the EPO will restrict applicants to only one single antibody, namely the one(s) exemplified, and yet a different antibody may be commercialised later, many years after filing.

Disunity

This seems to be getting worse, especially on *a posteriori* cases. One member had filed a divisional, after disunity of the parent, putting invention 2 first in the hope that this would be searched. Rather annoyingly it wasn't, as the subject matter of the divisional application was divided up in an entirely different manner from that of the parent case.

Disclaimers

This is of course the subject of referral to the EBA, and we are awaiting a decision.

Public debate about biotechnology

The female Bavarian Minister of Agriculture had been recently critical about patents in general (no doubt spurred on by the farmer's lobby).

Note the surprising recent intervention of the US Government, suggesting that genes should not be patented. Luxembourg is now effectively a GM-free zone.

Traditional Knowledge

One member had received third party observations from India, citing a traditional medicine document in Sanskrit. They were going to challenge the authenticity and accuracy of the translation, especially as it referred to many different parts of the plant and cited lots of different medicinal uses. It wasn't credible that just a few short several sentences in Sanskrit could contain all such detailed information.

Note that on the consent issue, Myriad had, on their breast cancer case, managed to get consent, even though this was a relatively hot topic at the time.

UK Patent Office

Note that in the UK Supreme Court (previously the House of Lords) has now decided to take the *HGS v Lilly* case. The UK Court's decision was different from the EPO, but that was primarily because of procedural and evidential reasons. The EPO will take additional evidence on appeal, whereas the UK Courts will not.

Voluntary Amendments

We wonder whether the EPO is going to get stricter on this matter. One member had two of his colleagues go to Oral Proceedings, only to find that their requests had not been admitted at all, because they were not „converging the case". We should try and ask the EPO Directors what they think about discretion to amend, and whether they will tighten up on this.

Sequence Comparisons

If the Examiner cites an alignment (say with a percentage identity) we should ask the EPO to provide a copy of the alignment. Then we can see what the differences are. However, we should not normally have to ask for this; we wonder whether, as a matter of routine, it may be possible for the EPO to send this to applicants.

Oral Proceedings

We should argue that we must be able to amend the claims on the day, and present new Auxiliary Requests, especially as a result of discussion of issues that only arise on the day. Remember that there is no third party here.

We still think that there are too many summons, and the deadline for responding is too short. One member mentioned that he had complained to DQMS about an Examiner who had cited new art and new objections in the summons, asking him to rescind them, but DQMS did not uphold the complaint, simply saying that Examination Divisions have discretion as to when to summon. It is precisely this lack of guidelines, and inconsistency, that we are concerned about.

Online Filing

It was noted that the EPO online filing software has several bugs (mistakes). The EPO knows about them, but won't fix them. It was explained that there is a problem where some of the fees can be reset to zero. Apparently the software also finds difficulty coping with page fees for non-English language originating PCTs (such as those filed in Japanese).

Added Matter/Basis

We are also seeing the Examiners becoming increasingly strict on added matter, under Article 123(2), and lack of clarity. One member had received a lack of clarity objection to the beginning a claim which started „A method for identifying a protein…."

Other Issues

We should encourage the Examiner exchange, which we think is very positive. We should also offer to let Examiner's work in our offices for a short period of time, so that they could see what work as an attorney is like, and get a view from the other side of the fence. Some attorneys had already lectured to the EPO, and the continuance of this practice is also to be encouraged.

Meeting with EPO

This was scheduled for the Monday after the committee meeting. An agenda, with a list of topics, was produced and sent to the EPO. This was discussed (with a reduced membership) after the main biotech committee meeting. Separate Minutes of the meeting with EPO Directors will be made and circulated for approval and after that published in epi information.

May 4, 2011

epi Autumn tutorial 2011

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

In this year's autumn tutorial the EQE papers of years 2009, 2010, 2011 will be taken.

The schedule is as follows:

> Beginning of registration: June 25, 2011
> Deadline for registration: September 5, 2011
> Tutees must send their papers to their tutors by October 10, 2011
> Personal feedback is planned to be given to the tutees before December 17, 2011

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

For further information/enrolment form please visit our website (http://www.patentepi.com –> EQE and Training) or contact the *epi* Secretariat:
email: education@patentepi.com.

epi Mock EQEs and *epi* Seminars 2011

epi is organising this year a series of mock EQEs (for EQE candidates) and *epi* seminars (for patent attorneys and paralegals).

Scheduled seminars:

12.–13.09.2011	Istanbul: „Drafting and Examination of a European Patent Application"
7.10.2011	Eindhoven: „Mock oral proceeding"

For further information, please visit our website (www.patentepi.com) 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).

9th CEIPI *epi* Course on Patent Litigation in Europe

The programme of the 2011/2012 CEIPI-*epi* Course is available on the *epi* website www.patentepi.com as well as on the CEIPI website www.ceipi.edu

For further information or application, please refer to Walter Holzer (Course Coordinator) WHolzer@gmx.at

CEIPI preparation courses for the EQE pre-examination and main examination 2012

The Centre for International Intellectual Property Studies (CEIPI), more in particular its International Section, offers an extensive programme of courses for preparing candidates for the European qualifying examination (EQE).

Pre-examination

Owing to recent amendments of the Regulations on the EQE, a pre-examination will be held for the first time in 2012 for candidates fulfilling the requirements to present themselves to the pre-examination of the EQE in 2012 (see the Supplement to OJ EPO 3/2011).

CEIPI is organising a seminar in Strasbourg to help candidates in preparing themselves for that pre-examination. The seminar will cover relevant topics which can be expected for the pre-examination. It will give participants the opportunity to apply their knowledge in a short mock-examination.

The pre-examination seminar will take place from 7 to 11 November 2011 in Strasbourg.

The fee is EUR 1 100. Closing date for enrolment is 3 October 2011.

More information can be obtained from christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

Main examination

For all papers of the EQE main examination 2012 (A/B, C and D), the programme starts with „Introductory Courses" in the early autumn of 2011, in a number of different cities in Europe (Strasbourg, Paris, Lyon, Copenhagen, Milano, Warsaw), so as to set candidates on the rails, as early as possible, in preparing themselves.

The introductory courses are followed by the „Preparatory Seminars" in November 2011 and January 2012, centrally in Strasbourg, France, which build on the introductory courses and expand on the issues treated, as well as provide for working on a mock exam under exam conditions, which is then discussed and compared with a CEIPI „model solution".

CEIPI, by its tutors, has developed this programme over recent years and believes it has been successful in providing a large number of candidates (about 400 every year) with a set of courses adapted to the EQE, increasing their chances of success.

For *paper C*, which every year appears to be one of the major stumbling blocks of the EQE, this programme is supplemented with *two extra courses*: a „Special C-Resitter" course specifically designed for those who have failed the C-paper (more than) once, and a last-minute „Cramming" Course, one month before the examination, where candidates once again can sit last year's paper under exam conditions, followed by a discussion of these drafted papers and the CEIPI-model solution the following day, in small groups. This course also provides for answering any last-minute questions regarding paper C. Both these courses are offered only in Strasbourg.

All courses are provided in the three EPO official languages: English, French and German, and are given by a mix of tutors from private practice (*epi)*, industry and the EPO.

The program is as follows (more extensive information is contained in OJ EPO 4/2011):

„Introductory Courses" 2011:

Paper	Milano (EN)	Warsaw (EN)	Copenhagen (EN)	Paris (FR)	Lyon (FR)	Strasbourg (EN, DE)
AB	2./3.09.		16./17.09.	30.09.		24.09.
C	7./8.10.		9./10.09.	1.10.		23.09.
D	30.09/1.10.	14./15.10.	30.09/1.10.	2./3.09.	8./9.09	21/22.09.
					min. 12 p.	

The fee for each one-day course in Paris or Strasbourg is EUR 500. The fee for the one-and-a-half day courses in Strasbourg, Lyon, Warsaw, Milano and Copenhagen is EUR 750 each.

Closing date for enrolment is 4 July 2011.

More information can be obtained from: sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

„Preparatory Seminars" 2011/2012:

The AB seminar will be held in Strasbourg, from 21 to 23 (am) November 2011, the C seminar from 23 (pm) to 25 (pm) November 2011. Both parts can be booked separately.

The D seminar will be held twice in Strasbourg, from 9 to 13 January 2012 and from 23 to 27 January 2012. All seminars are intended for those who wish to sit the EQE main examination in 2012.

The fee is EUR 1 100 for the five-day courses (ABC or D); for the AB part and the C part on its own the fee is EUR 725 each.

Closing date for enrolment is 3 October 2011.

More information can be obtained from: christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

The „Special C-Resitter" course 2011 will be held in Strasbourg on 2 and 3 December 2011.

The course fee is EUR 850. The price includes the „C-Book", 3rd edition.

Closing date for enrolment is 3 October 2011.

More information can be obtained from: sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

The „Cramming" course 2012 will be held in Strasbourg (EN, DE) on 2 and 3 February 2012 and in Paris (FR) on 4 February 2012.

The fee for the Strasbourg course is EUR 650, for the Paris course EUR 450.

Closing date for enrolment is 4 January 2012.

More information can be obtained from: sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

Christiane Melz, Secretariat of the International Section of CEIPI

(For any information on the above courses: tel. 0033 368 858313 or mail to *christiane.melz@ceipi.edu)*

Exchange views with European Patent Office Examiners

An opportunity to get an inside view of how the EPO works by having an examiner residing in your office and working with your staff. The EPO is launching this programme again in order to bring to examiners in contact with the user community and particularly the patent professionals. An opportunity for both parties to exchange views and get a better insight of how each works and the different challenges and issues each one faces.

In the words of Vice-President DG1, Mr Guillaume Minnoye: „The patent system in Europe works well due to highly qualified patent attorneys and patent examiners. Whilst having different functions to perform, they can be seen as two sides of the same coin. A coherent interaction between these two is essential to the effectiveness of the patent system. For this reason, the EPO would like to promote a more intense professional relationship between attorneys and examiners. To do this, the EPO is offering the possibility for examiners to go to patent attorney firms or industry for some 2 weeks to work in close cooperation with each other. Around 30 examiners will be available for this programme in 2011, which follows a successful pilot in 2010 where both sides agreed on the added value brought by the initiative."

Are you interested in this unique opportunity? More information is available on *www.patentepi.com* –> News

Corrigendum

2011 Results of the election to the 16th Council
epi Information 1/2011

Final election results for the Slovak Republic

Sent ballots: 38	Participation:	63,2 %
Received ballots:		24
Valid ballots:		18
Void ballots:		6
BAD'UROVÁ Katarina		13
CECHVALOVA Dagmar		18
MAJLINGOVA Marta		15
MESKOVA Viera*		12
NEUSCHL Vladimir		15
ZOVICOVA Viera		14

Allotment of seats

Full members

1. CECHVALOVA Dagmar	18
2. MAJLINGOVA Marta	15
3. NEUSCHL Vladimir	15
4. ZOVICOVA Viera	14

Substitute members

1. BAD'UROVÁ Katarina	13
2. MESKOVA Viera*	12

**stood as substitute only*

Withdrawals

The following elected Council Members have resigned from Council:

Mr Kim FINILÄ (FI), Mr Jan STEIN (SE) and Ms Margareta YDRESKOG (SE).

Issue 3/2011 – Themed edition

„The enhanced cooperation in Unitary Patent matters"
We would greatly appreciate receiving your contributions on this topic.
Please forward any contributions to the Editorial Committee
epi Secretariat – P.O. Box 260112 -D-80058 München
info@patentepi.com

Submissions are requested as soon as possible.
The deadline for submission of articles is 12th August 2011.

Next Board and Council Meetings

85th Board meeting on 10 September 2011 in Lisbon (PT)

71st Council meeting on 5 November 2011 in Darmstadt (DE)

Poisonous EPC Divisionals

Implications for Risk Management and Opportunistic Advantage

M. Lawrence (GB); M. Wilkinson (GB)

Headnote

An EPC application and its divisional(s) may be mutually anticipatory – in an unexpectedly large number of cases. This previously unrecognized anticipation threat to patent portfolios is based on a fusion of two sound legal principles not previously put together. The proposition, whilst disruptive and counter-intuitive, is supported by G0002/98, G0004/98 and G0001/05.

The threat is inherent in the widely used strategy of filing EPC divisional applications, a strategy which reached a zenith in the approach to the change in procedural law for divisionals which occurred last October. The threat has implications along several risk management and opportunity axes.

Executive Summary

We have identified and researched a highly significant anticipation threat to patent portfolios posed by the widely used strategy of filing EPC divisionals. This threat has not been recognized previous to our work.[1],[2] Its discovery points to a common, significant (we suggest probably universal) omission in strategic planning of divisional filings, and changes the landscape for IP risk management. We have already applied the threat in EPC oppositions.[3]

We postulate the disruptive original proposition that an EPC application and its divisional(s) may be mutually anticipatory where the subject-matter disclosed is materially the same (almost always so). Our proposition is based on a novel fusion of legal principles not previously put together:

- The first is the familiar principle that two applications come into anticipatory conflict when matter *claimed* in one is *disclosed* in the other with benefit of an earlier priority date but without prior publication (so-called "*whole contents*" anticipation)
- The second is far from familiar but is key to the proposition, namely that the two applications may, in accordance with the EPC, be any two applications within an EPC family comprising a parent and all its divisionals.

The key principle rejects the assumptive, and we suggest normally unconscious, idea that divisionals are special and to be treated specially for the purposes of substantive law. We identify a clear statutory basis, with authoritative and philosophical support, for concluding that this idea is misconceived, incorrect and of no effect.

We propose IP strategy solutions in two separate dimensions based on SWOT analyses.

In one dimension, we propose solutions in the context of proprietor interests:

- insertion of a prophylaxis into strategy formulation when planning division
- solutions for problem contexts already created

In the second dimension, we look:

- opportunistically at the interests of potential patent opponents
- implications for IP due diligence („DD") and freedom to operate („FTO") methodologies
- opportunities, and reciprocally threats, in relation to IP values, both at audit and in transactional context

1. Introduction

1.1 The facility for filing EPC divisionals has been widely used by applicants for many years, both to deal with non-unity and for other purposes; in the latter context, division usually aims to deliver strategic goals eg ring-fencing of claimed subject-matter of special commercial importance.

1.2 Such strategic goals are, however, contingent on overall validity for the strategy or are otherwise

1 We first presented arguments in accordance with our proposition in EPO proceedings in October 2005. In those proceedings, the patent concerned was invalidated on other grounds; although the particular issue of parent/divisional mutual anticipation was not formally decided, the Appeal Board indicated *obiter* (and *off-minute*) in oral proceedings that the arguments appeared in principle to be sound.

2 Narrow subsequent dissemination of our 2005 work discloses the essence of our proposition and this has been the subject of limited comment in academic circles.

3 In addition to the instance reported in Footnote 1 above, arguments as presented in this paper have been presented in proceedings on other patents; the arguments await formal authority of an EPO tribunal decision.

ephemeral – validity is impaired if the goal is materially prevented or the action seeking it engenders material collateral disadvantage. We conclude that when a parent's disclosure has more than one priority date, the same will usually be true of any divisional but that claims in the divisional deemed only entitled to a later date can be anticipated by matter enjoying an earlier date in the parent[4].

1.3 We have examined several sub-models of this overall risk model and identified various risk factors which can be identified and assessed individually. We thus also propose a basis for strategic review and damage limitation particularly applicable in the context of recent divisions[5].

1.4 Not all divisional/parent relationships will conform to the risk model but it appears that many will. Where so, the divisionals concerned will be at risk of invalidity, and remedial action may be damaging or even impossible to implement.

1.5 Alarmingly, there is a reciprocal to this anticipatory context: if divisionals are at risk from parents, then parents are at risk from divisionals due to conformity between parent and divisional in almost all cases in terms of both priority and disclosure – indeed, the risk is omni-directional within each EPC parent/divisionals family and may, for example, impact *divisional-to-divisional*.

1.6 Many divisionals now exist. A currently controversial but realistic view is that many will exist going forward indefinitely: although a new procedural context under EPC has presented constraints on divisional filing, it is not clear that this will reduce the quantum of divisions as opposed to simply ensuring a landscape of statutory division management aimed at reducing past public uncertainty.

2. Background – The Two Dimensions of Anticipation under EPC

2.1 EPC claims must be novel in two senses:

(i) they must be novel over subject-matter which falls *within* the state of the published prior art as it exists at their priority date

(ii) they must be novel over subject-matter which falls *outside* the state of that published prior art but which subject-matter:

- o is contained in a published EPC patent application[6]
- o is entitled to a priority date earlier than that of the claims in question.

2.2 By way of illustration, in a typical scenario:

- two applicants file US patent applications at different times describing common subject-matter
- the two applications give rise to two EPC applications, the first of which is published before the second but too late to form part of the state of the published art as it exists at the priority date of the second
- the first EPC application is citable[7] against the second so far as the first contains matter of earlier priority date also claimed in the second
- the filing programme may be one where direct European patent applications are filed or may be one where European patent applications are the result of a PCT filing step – for the purposes of this illustration, this is immaterial.[6]

2.3 Typical remedial action, either during or in anticipation of prosecution, is as follows:

- insert a conventional limitation into the claims of the second application which patentably distinguishes those claims from the disclosure of the first
- insert a specific disclaimer[8] into the claims of the second application in order *surgically* to excise from them the anticipatory subject matter disclosed in the first application.[9]

2.4 In order for a citation to be citable against claims of later priority date, the citation does not need to be in a different name – both applications could be in the same name – and indeed this is a very common circumstance.

The Increasing Importance of Priority Entitlement in EPC Practice

Priority date assessment under EPC is a more stringent exercise than in the USA and most other jurisdictions. At the same time as pursuing established filing strategies in other jurisdictions, securing a valid priority date for an EP claim – commonly imperative – is becoming a significant challenge in many instances, particularly as attacks on patents in eg EPO Oppositions become increasingly resourceful:

- Subject-matter enjoys a claimed priority date if it is for an invention the same as disclosed in the priority document but not otherwise
- Both granted patents and applications in the examination phase can, and often do, fail on the basis of the invalidity of the priority claim. See „Priority in Europe (everything you wanted to know but didn't

4 Our conclusion has withstood recent internal debate within HLBBshaw against a background of EPC statute/case law, the Vienna Convention (law of treaties) and important philosophical issues covered in the body of this paper.

5 Very large numbers of divisionals were filed in the period leading up to October 1, 2010. Under new procedural law governing divisionals which commenced in April 2010, divisionals filed voluntarily (ie other than in response to a non-unity objection) must be filed within a term calculable for each case -but, for a transitional period expiring on October 1, 2010, voluntary divisionals for which any such set term would already have expired could be filed by that date.

6 A published PCT application designating EPC counts as a published EPC application once the EPC regional phase has been entered.

7 The citation is usually, and not always very helpfully, termed a *„whole contents"* citation. The citation is relevant for the assessment of novelty only and not for obviousness.

8 A typical specific disclaimer in say a composition claim to A, B, C + D would read: *"… subject to the proviso that the composition is not a composition comprising A, B, C and D1 if C is either C1 or C2"*.

9 The first of the applications cannot, on these facts, be used in an obviousness challenge to the claim in the second application having the specific disclaimer. Accordingly, the subject-matter at the margins – where the area disclaimed interfaces with the claim scope which remains – is not at risk for alleged lack of inventive step over the first application.

want to ask)" [May 2010] – available at www.hlbbshaw.com

In practice, for example, a claim is not entitled to a claimed priority date if it contains a feature which is not directly and unambiguously generically derivable from the priority document. This is the same test as that applied to restrict greatly the making of amendments to European patent applications in prosecution. See „EPO Added Subject Matter Objections" [December 2003] – available at www.hlbbshaw.com

As such, the presence in a claim of a feature which is not disclosed in a generic sense in the priority document, but which is extrapolated from a specific embodiment, can effectively add matter over the priority document, leading to loss of priority.

3. Divisionals – A Disruptive Proposition Based on Established Law

3.1 We postulate the disruptive proposition that a parent and its divisional(s) may be mutually anticipatory. This can occur in cases where some subject-matter is entitled to a declared priority date and some to either a later declared priority date or to the EPC filing date.[10]

See Appendix 1 Venn diagram: How parents and divisionals can mutually anticipate

3.2 A divisional application and a parent application are two separate applications with no special relationship which precludes this proposition. They have an unusual relationship in one solitary sense and one only – the divisional application claims, on its filing, the date of filing of the parent. Apart from this, the two have all the attributes of separate un-linked applications – separate application fees, separate prosecution, separate renewal fees, separate outcomes and, if successful, they produce separate patents. A parent and divisional might even in some cases not have common inventorship.

3.3 The legal basis for this is in our view perfectly clear:

- Article 76 EPC provides for the existence of divisional applications and defines their parental relationship only at the instant of filing
- This independent status of divisionals has twice been endorsed by the Enlarged Board of Appeal (Decision *G0004/98, Reasons for the Decision paragraph 5; Decision G0001/05, Reasons for the Decision paragraphs 3.1 and 8.1*)[11].

3.4 We are aware of evidence of a legal expert witness submitted to an EPO first instance in EP0846450, which suggests a view contrary to our own view that parents and divisionals enjoy separate independent status. Although this evidence has received some favourable comment from blog commentators, we disagree completely with the opinions set forth in that evidence as it conflicts in our view with the above authoritative background. Notably, (i) the above expert evidence was not mentioned by the tribunal in its decision and (ii) the blog commentators do not mention either of G0004/98 and G0001/05.

3.5 We put forward the view that the separation means that a parent and its divisional(s) have the same capacity to come into conflict in a novelty sense as two applications which were effectively never linked:

- Paragraphs 2.1 and 2.2 above set out the established fact that two EPC applications can come into anticipatory conflict even if the priority date of the second is before the first was published – with an outcome either that the scope of the later of the two suffers significant limitation or that the application fails completely
- A divisional application may thus be cited against a parent if the parent claims are not entitled to the claimed priority date but relevant matter in the divisional is so entitled[12]
- For the same reasons, the parent is citable against the divisional claims[13] so far as those claims are not entitled to priority but relevant matter in the parent is so entitled.

Illustration: A Specific Parent/Divisional Anticipation Context. See Text Panel below and Appendix 2

Illustration: A Specific Parent/Divisional Conflict Context

A Redacted Real Case: parent and divisional EPC patents for mechanical subject-matter claiming priority from two UK patent applications with different general disclosures and common specific disclosures

- UK patent application „A" is filed on date „A" for subject-matter involving a device comprising „members" and the claims recite the presence of plural members. The same applies to the general description. The specific embodiment depicts an array of members in which the members form a matrix but there is no other disclosure of an array.
- UK patent application „B" is filed on date „B" also for subject-matter involving members. Date „B" is later than date „A". The claims recite the presence of plural members. The general description makes

10 Of course, both parent and divisional have the same effective filing date.

11 Appeal Decision T0441/92 states that thereafter a divisional application is to be treated as a separate application: "*Thus, once the conditions of Article 76(1) have been met, the divisional application is to be examined as an application quite separate from the parent application and must itself comply independently with all the various requirements of the EPC.*"

12, 13 This line of argumentation currently forms part of challenges to several European patents currently under opposition where HLBBshaw is the representative of the opponent. In one previous opposition (placed on appeal in 2004), the argument was tested by HLBBshaw at oral proceedings and received broad acceptance by a Board of Appeal as a meritorious challenge (the patentee, however, amending his claims to a narrow form which the Board of Appeal in that case determined was entitled to a priority date which would not otherwise have been enjoyed by the claims). Whilst the issue of parent/divisional mutual anticipation has yet to be decided at EPO appellate level, we believe it to be valid and supported indirectly by very recent case law – see Paragraphs 4.3.1 and 4.3.2 of this paper.

a specific reference to members in the form of an array. The specific embodiment is the same as in application A.
- A European patent application is filed claiming the dates of both applications „A" and „B". The specification is the same as that of application B.
- An EPC patent is granted with claims reciting an array of members. The claims are entitled to date „B" – the first occurrence of any general disclosure of arrays.
- A divisional EPC application is filed just before grant of the parent patent, and this subsequently publishes.
- The divisional corresponds to the parent as filed. It discloses the same specific embodiment as the parent and applications „A" and „B". That specific disclosure is entitled to date „A" and anticipates the claims of the parent patent – which are entitled to date „B", as already noted.

3.6 It will be recalled that a divisional will usually include at filing *all* the matter of the parent. Usually, neither is amended to give an outcome in which less appears at publication – what is filed will generally be what is published (unless publication as a whole is prevented by abandonment). Divisionals and parents in short have, more often than not, once published, the same disclosure, and this potentially makes each a *perfect citation* against the other if the priority date circumstances permit.

4. Challenging the Proposition – Fairness, Expectations, Law

4.1 An instinctive first reaction to our disruptive proposition that a parent and a divisional can be mutually anticipatory is that it is unfair, not in accord with reasonable expectations and likely to be wrong in law – because divisionals are special. Support is rallied from history – divisionals have always been filed and never before challenged on the basis here presented, and as a matter of public policy it cannot now be decided that some of them are casualty to a new proposition.

4.2 We suggest that these are reactions which are driven by aspiration and that they do not survive balanced critical appraisal:

- The two dimensions of anticipation (ie anticipation in both the normal and "*whole contents*" senses) have formed part of EPC law and practice since 1978 and have not changed in any way that is material to this issue[14]. Applicants and the public as a whole have had proper notice
- Applying the principles of this established law and practice in a new way which aligns with them is a matter of intellectual process that is available to all
- Managing the unchanged but newly perceived legal context generated by that process, and in so doing addressing expectations, is a matter of exercise of choice, skill and judgement – the fact that this exercise may be challenging is not a relevant factor and nor is the fact that the need for it has not been appreciated
- History is also not relevant as it is perception and applicability that have changed and not the law
- Public policy has no business, at least not at the executive as opposed to the legislative level, interfering with the effects of proper interpretation and application of the law
- An applicant filing two separate European applications at the outset would plainly be subject to the legal reality that they could conflict in a "*whole contents*" anticipation sense; his position cannot fairly be superior through filing a single application and dividing it later
- A divisional is not a special application (for purposes of anticipation or at all); divisionals are ordinary applications which (i) happen to claim the parent filing date in consideration of limitations on geography[15] and disclosure which keep them within the parent's scope and (ii) do not deserve or enjoy any preference in substantive law.

4.3.1 This latter point has been implied with some strength in one very recent decision at EPO appellate instance. T680/08 (June 2010) poses the anticipation of patent claims in an EP application (EP2) by an earlier EP application (EP1) whose priority is claimed – as opposed to the two having a parent/divisional relationship.

4.3.2 The factual context is worth explaining so as to demonstrate how the decision's consistency with our basic proposition supports it:

- the patent claims concerned in T680/08 were asserted to be disentitled to the priority date of EP1 (and entitled only to the filing date of EP2) because of an amendment to the main claim
- EP1 disclosed earlier embodiments falling within the scope of the claims of EP2. Accordingly, those embodiments anticipated the patent claims in question even though EP1 was not published until after the filing date of EP2 (ie anticipation was asserted in the "*whole contents*" sense)[16]

14 The geographical ambit of "*whole contents*" anticipation was at one time aligned to the EPC state designations in the citation and thus potentially restricted but, although this has changed, the removal of this restriction is not material to the proposition in this paper.

15 A divisional cannot designate any EPC state that is not designated (or available for designation) in the parent – see eg Decisions J0022/95 and G0004/98.

16 Decision T0680/08 follows Koch & Weinzierl, EPI Information No 1/10 (March 2010) and both refer to Decision T1443/05 (published in June 2008 in German, not published in English and of somewhat low profile – the case had by November 1, 2010 been cited only once in other appeal decisions). However, neither of the two cases nor the Koch & Weinzierl paper mentions parent/divisional mutual anticipation (nor do they mention divisionals at all); they are instead focused on broader issues of determining priority entitlement.

- In short, a *later priority-claiming* application can according to T680/08 be anticipated by an *earlier priority-conferring* application – the relationship between the two is not regarded as special and nor then, we contend, can be that between a parent and its divisionals.

4.4.1 The Vienna Convention on the Law of Treaties (VCT) contains provisions setting out how Treaties (and Conventions) should operate. The VCT makes two rules applicable to the interpretation of the EPC:[17]

- EPC should be interpreted in good faith
- Terms in EPC should be given their ordinary meaning in their context and in the light of the object and purpose of the EPC.

4.4.2 As set out in Paragraph 2.2 above (third bullet point), the prior art in relation to EPC claims is considered to include disclosures of earlier priority date contained in other EPC applications (even if not actually pre-published); Article 54(3) EPC states that the prior art includes:

"*the content of European patent applications as filed, the dates of filing of which*[18] *are prior to*" the filing date of the case in suit. As construed in good faith, this provision includes *all* other EPC applications and cannot be seen as excluding those that are part of a parent/divisional relationship as to do so would be to import a nuance and would be capricious.

4.4.3 The same conclusion can be expressed in different terms (perhaps more cogently; certainly less prone to philosophical variance), namely that it would be necessary to assign a special (rather than *„ordinary"*) meaning to the term *„(other) European patent Applications"* in the relevant EPC provisions[19] in order to sustain any argument that a divisional application is not citable against its parent or vice-versa.[20]

5. The Cruciality of the Priority Test

5.1 Priority is to be determined on the basis of G0002/98. In circumstances where a claim does not find priority document basis which enjoys considerable precision[21], things are far from clear cut. G0002/98 is commonly regarded as applying to priority date assessment a test that is an analogue of the Article 123(2) EPC test for added matter. This in itself suggests a hurdle of sufficient height that imprecise priority document basis will commonly mean a real risk that priority is to be denied.

5.2 Reason 6.7 of G0002/98 suggests tools for applying the bottom line finding of the Enlarged Board of Appeal in a way which recognises that a claim not entitled to priority can notionally be divided into separate domains of which some may be entitled to priority[22]. This can mean outcomes where relevant matter in one of a parent and divisional does not anticipate such domain because both the *missile* and the *target* have the same priority date. In short, in such a case the divisional is not *poisonous*. However, Reason 6.7 is to be applied with care in only allowing a claim to be divided into a "*limited number of clearly defined alternative subject-matters*". In many parent-divisional interactions, the circumstances do not support application of the Reason 6.7 tools in a way which leads to acknowledgement of priority.[23] For example:

- acknowledgement of priority may require notional individualisation in the claim concerned of a subject-matter domain which, as it is not "*clearly defined*" (eg perhaps an Example) or leads to a non-limited number of alternative subject-matters, is not permitted by G0002/98
- in cases where the claim in question has been drawn more narrowly than the priority document disclosure[24], it is unclear if and how the Reason 6.7 tools of G0002/98 can be deployed.

5.3 Put bluntly, except in cases where a claim is foreshadowed with a good degree of precision in a priority document[25], priority will be (at least) uncertain[26]. Where it is uncertain and there is a parent-divisional family where one family member contains eg specific matter falling within the relevant claim of another family member, there is a meaningful IP risk. As an IP management matter, this should attract risk management activity in the hands of the proprietor, adapted DD/FTO methodologies in the hands of transaction suitors/competitors and opportunistic patent challenge strategies in the hands of those considering exploitation of the claimed subject-matter in question.

6. Conventional Solutions Will Usually Not Produce Acceptable Outcomes

6.1 The same remedial tactics are available to resolve parent/divisional conflicts as set out in Paragraph 2.3 above but this is likely to be theory rather than

17 The VCT is not formally applicable to EPC as it did not exist when EPC came into force but, in common with eg the European Court of Human Rights, its provisions are noted and broadly followed by the EPO (see Decisions G0005/83 and J0022/95).

18 Article 89 EPC explicitly provides that the reference to *filing* date here refers to the *priority* date enjoyed.

19 In fact, the word *„(other)"* does not appear in the relevant part of EPC although its presence is regarded by custom as understood.

20 In this respect, evidence that a contracting state to EPC intended a special meaning would be relevant – but no such evidence exists.

21 Such circumstances are far from rare.

22 Of course, the claim may already individualise separate domains in the classic fashion of a so-called "–OR *claim";* however, our impression from personal experience is that this is less common.

23 We are currently finalising a companion paper for publication on priority date assessment focussing on G0002/98 – a decision which is surprisingly poorly understood despite its publication more than 10 years ago – and case law of the lower Boards of Appeal which both precede that decision and post-date it.

24 Again, such circumstances are far from rare.

25 In the case of a claim where it is expression of a feature of generic scope which engenders the priority issue, uncertainty of priority will apply unless the totality of the scope of that genus, or at least a clearly defined alternative subject-matter domain nested within it, is properly foreshadowed in a priority document.

26 We are aware of first and second instance decisions, some unpublished, where tribunals have declined to divide claims into separate domains per Reason 6.7 of G0002/98.

practice in this setting for two reasons which make it less likely that they will offer an acceptable outcome.

6.2 First, the anticipatory context is very different because the parent and divisional are normally at least approximate clones of one another so that citability is potentially ecliptic. Secondly, the protection goals in this context are usually very tactical; most *voluntary* divisionals are filed as part of a contingency plan – for example, in case the parent is opposed with a likelihood of success, to ring-fence subject-matter of immediate commercial significance to obtain rapid allowance or to separate clearly allowable from contentious related subject-matter.

6.3 In general, parent/divisional conflict will arise through the existence of citable specific matter of earlier priority date and this can be difficult to distinguish in the above contexts and in any event:

- No conventional amendment may be available to provide a distinction – either because there is no basis for one or because those for which there is basis conflict with the protection goals
- At the same time, the rules on specific disclaimers call for (a) an exclusion of *only* the limited subject-matter which engenders anticipation[27] and (b) compliance with formal clarity requirements which are almost never compatible with the latter rule[28]
- Post-issue, the only potential amendment which is effective to restore priority and deliver the protection goal may be a broadening one – but a patent may not lawfully be amended to extend its scope.[29, 30]

7. Strategic Action as Patentee/Applicant

7.1 Risk Assessment

7.1.1 Contexts which have higher probabilities of suffering from parent/divisional mutual anticipation have characteristics which can be identified and detected. Broad predictive risk management is therefore an available tool.

7.1.2 Table 1 shows characteristics which indicate higher risks. Whilst Appendix 2 (see side bar to Paragraph 2 above) shows an illustration in a particular setting from which a risk assessment plan could be derived, Appendix 3 directly expresses a suggested a decision tree structure; this might be used to analyse different parent/divisional contexts to enable case streams to be defined for further more detailed consideration appropriate to the context[31]

Table 1: Risk factors indicating probability of parent/divisional mutual anticipation

1	EP claims multiple priorities from earlier basic applications (BAs)
2	EP claims single priority from earlier basic application (BA) and EP and BA are not identical
3	EP as filed contains substantial new material relative to at least the earliest BA
4	New material in the EP relative to at least the earliest BA includes general information
5	The general information is mentioned in at least some of the claims of the EP
6	Specific embodiments in the EP are mentioned in the BAs and fall within the scope of at least some of the EP claims
7	The EP was filed urgently and may not have optimized the capacity for claims to secure the priority date(s)
8	A divisional has been filed which substantially reproduces the parent EP
9	Publication of the divisional is imminent

7.2 Preventive Action by Patentees/Applicants

7.2.1 Preventive steps include:

Ancestors threatened by proposed divisionals

- Remove from the proposed divisional text any matter which would anticipate the patent claims of any ancestor[32]
- Exclude the (relevant) priority claim(s) from the proposed divisional application[33]
- Do not file the proposed divisional application[34]

Proposed divisionals threatened by ancestors[35]

- Formulate a precise distinguishing amendment strategy for the proposed divisional prior to filing it, and implement that strategy as part of the filing.[36]

7.3 Curative Action by Patentees/Applicants

7.3.1 For ancestors threatened by new divisionals already on file, curative steps include:

- Withdraw the new divisional application if still possible[37, 38]

27 This would call for the disclaimer language to recite precisely the specific embodiment causing the anticipation.

28 Clarity (Article 84 EPC) will hardly ever be satisfied by disclaimer language reciting precisely the specific embodiment causing the anticipation – the disclaimer might be of great length and would probably include in many cases language of the kind not ordinarily suitable for use in a claim.

29 Article 123(3) EPC.

30 For example, a claim reciting an *array* of members if amended to recite a *plurality* of members would broaden the scope of the patent as a whole and so the amendment would be unallowable.

31 This decision tree is in simplified form. A more comprehensive decision tree, which can be provided on request to the authors, shows further decision process steps which insert assessments of priority using the tools we consider are derivable from G0002/98.

32 It will not always be the case that doing this poses a meaningful enablement risk for the proposed divisional but it often will.

33 This is often risky but the earlier date is not relevant if, for example, the subject-matter the divisional claims (as distinct from its descriptive disclosure) is not entitled to that date anyway.

34 This may seem drastic but there are many scenarios where the risk to parent case efficacy significantly outweighs the potential benefits of any divisional.

35 Obviously, action to amend a parent will lack effectiveness since the parent is already on file and what was filed *will* be published (unless the parent is abandoned in time to prevent that happening); the prior art effect under the *"whole contents"* principles will take effect at publication although based on the applicable parent priority date.

36 The amendments will need to satisfy the test that they add no subject-matter relative to the subject-matter content of the divisional's ancestors and so there is no statutory advantage in amending as part of the filing. However, tactically, this may prove the better option in terms of Examiner reaction and strategically the exercise should enable the viability of the divisional and its threat to ancestors to be assessed early in the spend programme.

37 Put briefly and in general terms, an application will not be published if it has been finally refused, deemed withdrawn or withdrawn before the termination of the *technical preparations for publication*. These preparations are considered terminated at the end of the day five weeks before the end of the eighteenth month from the date of filing or priority (EPO Notice, OJ 6/2006, 406). If withdrawn before publication but *after* the termination of *technical preparations for publication*, the application will still publish, but no whole contents prior art effect under Article 54(3) EPC will arise (see Decision J0005/81).

38 One way of withdrawing a divisional application is, of course, to omit payment of official fees whose absence results in deemed withdrawal.

- Withdraw the (relevant) priority claim(s) from the new divisional application[39] if still possible[40]
- Formulate a precise amendment strategy for the ancestor to distinguish it and implement that strategy as soon as possible.

8. Strategic Action as "*Opponent*"

8.1 Opponent Opportunities

8.1.1 Reciprocatively, our proposition generates opportunities for opponents and potential opponents which are self-evident from this paper.

8.1.2 It remains to be seen whether first instance tribunals of the EPO will be willing to follow our proposition without there first being authority from a specific decision at an appellate instance (and no such authority currently exists).

8.1.3 We suggest that challenges based on our proposition should be admissible in already filed oppositions where such a challenge has not already been made, at least in cases where lack of novelty has been pleaded on other bases.

8.2 Third Party Observer EPC Prosecution Opportunities

8.2.1 Challenges made as a third party in EP prosecution are commonly mounted by parties – who often later become opponents. Most EPC states have national provisions for making third party observations on patentability during prosecution of a patent application.

8.2.2 Such *Observers* do not become party to the prosecution proceedings and that *status quo* makes this a difficult setting in which to promote unusual, difficult or philosophical arguments. Our proposition may have little value in this context for this reason and because Examiners in prosecution will likely be reticent to apply our proposition in an application context until there is appellate authority; tactically, mounting a challenge on this basis would alert the patent applicant and enable him to plan an amendment strategy in the more hospitable environment of prosecution (as compared to post-grant opposition or litigation).

8.3 Third Party Observer EPC Post-Issue Opportunities

8.3.1 Challenges may also be made as a third party in post-issue EP opposition proceedings. For the reasons given above in Paragraph 8.1.2 and 8.2.2, these may lack effectiveness, although the issue could well be adopted by a skilful opponent (but see Paragraph 8.1 above).

8.4 Post-Issue Challenges under National Laws

8.4.1 In addition to orthodox litigation (eg revocation proceedings in UK and nullity proceedings in Germany), "*whole contents*" issues (as a specific cause) can be used to invalidate UK patents (including European Patents (UK)) by an informal procedure in which the citation and its relationship to the UK patent concerned can be brought to the attention of the Patent Office[41] (now, Intellectual Property Office – UKIPO).

8.4.2 The above mechanism confers on the UKIPO the perhaps surprising jurisdiction to revoke the UK patent concerned *of its own motion*. This power provides what amounts in reality to an extension of the normal UK prosecution environment into a post-issue chapter and provides a national remedy[42] to compensate for the fact that, in EPC prosecution, EPO Examiners enjoy no jurisdiction to raise a "*whole contents*" objection based on a national right (even though such rights are relevant to national validity).[43]

8.4.3 Contrary to the view we give in Paragraph 8.1.2 above, we feel that consideration at the more senior tribunal levels normally involved in revocation proceedings (including those where revocation in light of a "*whole contents*" issue is empowered at a Patent Office's own motion) may result in a more propitious prospect of successful intervention. The patentee has an opportunity to make observations and seek amendments but the person bringing the citation to the attention of the UKIPO does not become a party to the proceedings.

8.4.5 This provision is, however, peculiarly UK in style, and we do not expect similar provisions in the national laws of other EPC member states, at least note in the top slice of that constituency measured in economic terms[44]. However, we are researching the question of whether there are effective analogues elsewhere in Europe to this unusual provision of UK law and will publish the results of this research at www.hlbbshaw.com.

9. Due Diligence and Freedom to Operate Methodologies

9.1 The existence of division suggests a new dimension of risk in both DD and FTO contexts.

9.2 In both contexts, we suggest adaptation of standard methodologies to address the new risk dimension.

10. IP Value Detraction

10.1 IP audits are increasingly common in well-managed businesses and may include a risk assessment element and an associated IP valuation. Parents „poisoned" by divisional filings may, for example, need to be revalued at lower valuations as compared to a past IP audit.

10.2 In transactional contexts, „poisoned" EPC items may not justify revenue streams attaching to them, with the result that those revenue streams (a) may be less reliable in a „going concern" financial governance sense applied to the patentee/appli-

39 This may seem drastic but there are many scenarios where the risk to parent case efficacy significantly outweighs the potential benefits of any divisional

40 Broadly, this will need to be done quickly and good practise suggests that individualised advice is prudent on such a matter.

41 See Section 73(1), UK Patents Act, 1977 (as amended).

42 The remedy is in addition to, but very much simpler than, the alternative option of bringing full *inter partes* revocation proceedings.

43 The provision in fact *overcompensates*, as it provides more than an answer to just this specific point; for example, the provision gives the UKIPO power to revoke if a *whole contents* conflict exists between a UK national patent and another UK national case.

44 Preliminary research suggests the Irish law is similar to that in UK.

cant and (b) as payment obligations of eg a licensee, may be less justifiable.

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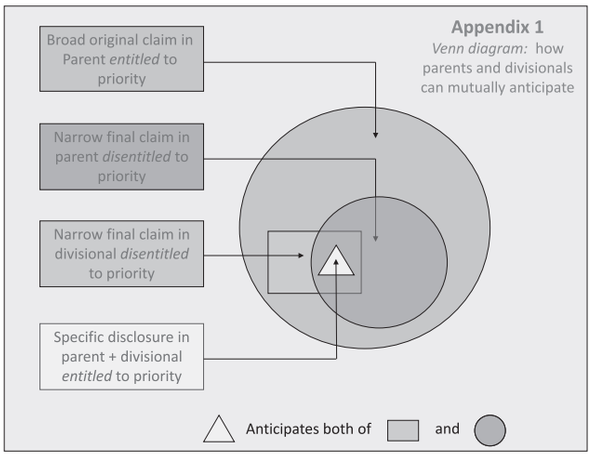

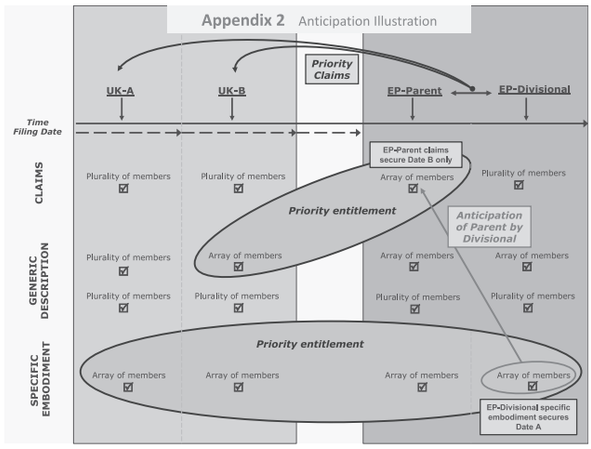

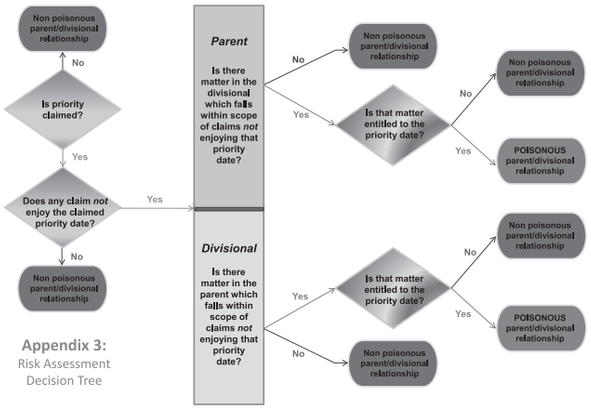

Appendix 3:
Risk Assessment Decision Tree

Divisionals and Deemed Withdrawal – A Way out of the Mist?

N. Bouche (FR), S.-E. Braitmayer (DE), T. Bremi (CH), D. Visser (NL)[1]

1. Introduction

Decision G1/09 of the Enlarged Board of Appeal of the EPO (EB) has to the surprise of users of the EPC changed the practice of the office regarding filing of divisional applications. Under long standing practice a divisional application could be filed until pronouncement of a decision in oral proceedings or until notification of a decision in written proceedings by an examining division refusing a patent application. However, G1/09 held that a divisional application can be filed until expiry of the period for filing an appeal against the refusal, independent of whether an appeal is actually filed.

The decision is based on the premise that a patent application is pending as long as substantive rights deriving therefrom are in existence. This pendency is one of the requirements of Rule 36 EPC[2] for filing a divisional application. The EB supported its position by referring to similar practice in several EPC contracting states. In a previous article[3] it was shown that application

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2 All provisions of the EPC in this article refer to the EPC 2000

3 Visser and Blaseby, „Divisionals – Peering into the Mist“, epi Information 1/2011, page 32

of this premise to situations other than refusal of an application may lead to an increased legal uncertainty for the public. G1/09 could be interpreted as allowing the filing of divisional applications during any unavailed remedial period, such as the two-month period for requesting further processing.

This article tries to shed some light on issues involved and to start a discussion. It proposes a definition of pendency that reduces legal uncertainty by restricting the possibility of filing divisional applications in remedial periods to only the appeal period after a first instance decision and excluding other remedial periods, such as for further processing. After a summary of G1/09, the practice in a few contracting states is set out. A generally accepted legal principle, derived from the national procedures, provides a basis for the proposed definition. Subsequently, this definition is applied to several EPO procedures and the outcome is compared with case law of the EPO.

2. G1/09 – A summary

The EB had to decide whether an application after refusal by a decision of the Examining Division is pending until expiry of the period for filing a notice of appeal, when no appeal has been filed. The pendency is a requirement of Rule 36 EPC for filing of a divisional application. The EB makes a distinction between a pending patent application and pending proceedings, which need not coincide in time[4]. For example, during a stay of the proceedings under Rule 14 EPC the proceedings are not pending, whereas the application is still pending[5]. According to Rule 36(1) EPC the pendency of the application rather than the pendency of the proceedings is relevant for the right to file a divisional application.

The EPC does not define when an application is pending. In view of the substantive character of the right of the applicant to file a divisional application[6], the EB defines a pending (earlier) European application in the specific context of Rule 36 EPC as „a patent application in a status in which substantive rights deriving therefrom under the EPC are (still) in existence"[7].
The EB uses the substantive right of provisional protection under Article 67(4) EPC to show that substantive rights are in existence until the decision to refuse has become final.[8] The EB endorses and follows the legal principle of several contracting states that „decisions do not become final until the expiry of the respective period for seeking ordinary means of legal redress"[9]. It concludes that the application is pending until expiry of the appeal period and is no longer pending on the day after if no notice of appeal is filed.[10] If no appeal is filed, the applicant may thus file a divisional application until expiry of the appeal period.

3. Problems

The EB used the „existence of substantive rights deriving from an application" as definition of pendency of an application to justify the filing of a divisional application in an unavailed appeal period following refusal in first instance. In many procedural situations other than the situation following refusal of an application discussed in G1/09, substantive rights can also reasonably be assumed to exist. These substantive rights, following the reasoning of G1/09, would permit filing of a divisional application. For example, after an application is deemed withdrawn because the applicant did not complete a procedural act in due time, the applicant may still be regarded to have a substantive right to the patent, which he can secure by requesting further processing. Hence, using the above basis for pendency, a divisional application could be filed in the two-month period for filing the request for further processing, even if the request is not actually filed. Similarly, it could be argued that filing a divisional application in an unavailed one-year period of Rule 136(1) EPC for requesting re-establishment should be possible. This would result in a long period of legal uncertainty for third parties.

The increased legal uncertainty would have been avoided if the definition of a pending application were applicable only to refusal of the application by the examining division and not to other situations. However, we have not been able to find any legal basis for such a limitation in decision G1/09. Therefore, section 4 below will analyse provisions in national law to find a basis for such a limitation.

The reasoning in G1/09 may also have the following logical problem. According to Rule 36(1) EPC, a divisional application may be filed when the earlier application is pending. An application is pending if substantive rights deriving therefrom are in existence. Since the right to file a divisional application has a substantive character[11], the earlier application will be pending if a divisional application may be filed on it. This reasoning is circular, caused by including the right to file a divisional application in the substantive rights that define pendency. It is not clear on what grounds the right to file a divisional application should not be taken into account for determining when substantive rights deriving from the parent application are in existence.

4. National law

The EB endorses the „generally accepted principle" in national law that decisions do not become final[12] until

4 Decision G1/09 reason 3
5 Decision G1/09 reason 3.2.2
6 Decision G1/09 reason 3.2.3
7 Decision G1/09 reason 3.2.4
8 Decision G1/09 reason 4.2.1-3. The EB does not explain why the retro-active effect of a final decision to refuse does remove retro-actively the provisional protection but does not remove retro-actively the pending status of the application, which depends on the existence of the provisional protection during the appeal period.
9 Decision G1/09 reason 4.2.2
10 Decision G1/09 reason 4.2.4
11 Decision G1/09 reason 3.2.3
12 The final character of a decision is part of the „res iudicata" principle (*Rechtskraft*) and ends litigation. The further aspects of *res iudicata,* like e.g. enforceability of a decision, are not relevant for the present problem

the expiry of the respective period for seeking ordinary means of legal redress[13]. This section will go more deeply into the national provisions in France, Germany, and Switzerland relating to this principle to determine characteristics that may be applied also in the procedures of the EPO.

4.1 French national law

The *voies de recours* in French civil law, the means by which judicial decisions can be contested, are divided into ordinary and extraordinary means of redress (*voies de recours ordinaires et extraordinaires*). On the one hand, the ordinary means of redress (*appel* and *opposition*) are broadly available, being a prerequisite for the achievement of justice ensuring the right to reply or to defend oneself – *principe du contradictoire* – and the two instances – a person is entitled to have his case decided twice, on the second occasion by judges of greater experience – *double degré de juridiction*. They have suspensive effect. On the other hand, the extraordinary means of redress (*tierce opposition*, *recours en révision*, *pourvoi en cassation*) are exceptional means of redress, available only in cases specified by the law. They have a specific purpose and have no suspensive effect.

A decision can only be enforced once it has become *res iudicata*, in other words once it has *force de chose jugée* (Article 501 of the French Code of Civil Procedure, hereinafter referred to as *CPC*). Article 500 *CPC* attributes *force de chose jugée* to decisions that are not subject to any redress staying its execution and to decisions for which such a redress was available but against which no redress was made in time. Hence, *force de chose jugée* may be acquired immediately or in a delayed manner.

A decision of the *Cour d'Appel* rendered *inter partes* acquires immediate *force de chose jugée* because there is no ordinary means of redress possible against such a decision. The *pourvoi en cassation* is an extraordinary means of redress without suspension of execution.

An appealable decision acquires delayed *force de chose jugée* one month as of its notification if no ordinary means of redress is requested against the decision within this period. If an ordinary means of redress is requested, the suspensive effect continues until the decision on the request is issued and

– either the contested decision is reversed or annulled, and only then the decision on the redress will become final or
– the contested decision is affirmed, it recovers *force de chose jugée* and is enforceable retroactively.

These French rules of civil procedure are applicable to French patent law, not to the decisions of the Director of the INPI which are administrative decisions but to the judicial decisions of the *Cour d'Appel* of Paris. Article L. 411-4 paragraph 2 of the French Intellectual Property Code provides for judicial review of decisions rendered by the Director of INPI (*Institut National de la Propriété Industrielle* – French Industrial Property Office). All decisions rendered by the Director of INPI in connection with grant or rejection, may be reviewed (*recours*) before the *Cour d'Appel* of Paris. The request for review must be filed within one month. Pursuant to the French rules of civil procedure, the decision of the *Cour d'Appel* becomes final (*res iudicata*) immediately because there is no possible ordinary means of redress against such a decision.

The time limit for filing divisional applications is governed by Article R. 612-34 of the French Intellectual Property Code, which states: „Up to payment of the fee for granting and printing of the patent specification, the applicant may, on his own initiative, file divisional applications for his initial patent application".

Hence, a divisional application may be filed until the application is replaced by the granted patent[14] and therefore ceases to exist. However, this text relates only to the case of grant and is silent if the application does not lead to grant. This silence appears to imply that it is impossible to file a divisional application if the application no longer exists.

If no filing date is accorded to a patent application, it has never existed. After a filing date is accorded, the patent application exists.

The patent application may be rejected because of a deficiency, such as incorrect form of the documents, lack of payment or lack of novelty. The patent application ceases to exist if the deficiency is not corrected (no regularization or no accepted observations) within the period afforded.

Furthermore, the law also provides for some „extraordinary procedures" (which are not „means of redress"), such as „further processing" or „re-establishment". If the request for further processing is duly submitted before the rejection decision, this decision shall not be rendered. If the request is duly submitted after the rejection decision, the rejection will not have effect. The request for re-establishment may be submitted only after the rejection decision and the patent application has already ceased to exist; the application comes alive again if the re-establishment is allowed.

4.2 German national law

The relevant provisions setting the time limit for filing divisional applications in the EPC and German Patent Act (PatG) are slightly different: Rule 36(1) EPC requires „to any pending earlier … application" („zu jeder anhängigen … Patentanmeldung") whereas § 39(1) S. 1 PatG stipulates that the applicant may divide its application at any time ("Der Anmelder kann die Anmeldung *jederzeit* teilen." – emphasis added). Even though the wording differs, one has to assess also how long a German application exists. The result is (of course): as long as the application is pending.

The difference between the pendency of the proceedings and of the application as pointed out by the EB exists

13 Decision G1/10 reason 4.2.2

14 The patent is regarded to be granted on the day of payment of the fee for granting and printing the patent specification. See „Traité des brevets" p. 799-803, J.M. Mousseron,1983 and "Traitement de la demande française de brevet", JCL Brevets, fasc. 4420, Y. Basire, 2008, spec. No. 67.

also in Germany. Whereas a German patent application is pending until the decision becomes final, the proceedings are pending until the work of the competent authority (German Patent and Trademark Office – DPMA – or German Federal Patent Court – BPatG) is completed. This differs from the EPO's practice, according to which the proceedings end with (oral) issue of the decision[15]. According to the German understanding the proceedings are still pending after that date as the competent authority has to draw up the written decision; as a result, the proceedings end when handing over the signed decision to the post room. This difference is of only minor relevance to the filing of divisional applications.

The German Federal Court of Justice (BGH) decided that the period for filing a divisional application ends only with the expiry of the appeal period[16], the same as in G1/09. The BGH decision is based on the following reasons[17].

The interpretation of the above-mentioned § 39(1) S. 1 PatG according to its object and purpose as well as its systematic placement is that this period extends as long as the Office's decision may be challenged[18]. The need to file an appeal only to revive the right to divide the application would not be in conformity with the applicant's right to file divisional applications („umfassende Zuweisung des Teilungsrechts")[19]. Further, the practical ground that it would be an unnecessary formality („unnötige Förmelei") to force the applicant to file a superfluous appeal that might be withdrawn or might be accepted to be dismissed after filing the divisional application[20].

The BGH's reasons are based amongst others on finality of a decision being an aspect of the principle of *res iudicata*, coming from Roman law, which should be a general principle in the sense of Article 125 EPC. According to the decision, an application is pending as long as the decision has not yet become final[21].

An applicant may not file a divisional application in an unavailed period for requesting further processing (Article 121 EPC = § 123a PatG)[22] and re-establishment (Article 122 EPC = § 123 PatG). According to German interpretation[23], the application is not anymore pending during such a period. The application is retroactively „revived" only when the remedy is allowed (*Durchbrechung der Rechtskraft*); in the meantime no rights may be derived from the (not anymore existing) application. It is evident that further processing and re-establishment are not ordinary means of redress like an appeal after refusal of the application but mere remedies. Further processing and re-establishment may affect the finality of a decision. For example, when re-establishment in the appeal period is allowed, a decision that was already final, becomes appealable again. As a result, the filing of divisional applications is possible only as long as the decision has not become final.

4.3 Swiss national law

The principle of a decision becoming final only upon expiry of the period for filing an appeal is also known in Swiss law, as mentioned in decision G1/09. A first instance decision open to appeal can only be enforced (*Vollstreckung*) once it has become final (res iudicata, Article 336 of the Swiss code on civil procedure), because the appeal is an ordinary means of legal redress, i. e. a means of legal redress which has suspensive effect[24]. The suspensive effect delays the enforceability of a first instance decision, e.g. according to Article 315 of the Swiss code on civil procedure, thereby avoiding the decision to be enforced and this enforcement to have to be changed if the higher instance comes to a different conclusion. The first instance decision becomes final when the parties renounce the means of legal redress (Article 239 of the Swiss civil procedural law) or when the period for filing an appeal expires without any party having filed an appeal[25]. This also holds true for patent prosecution, as documented in an old communication of the Swiss patent office, stating that in the case of a refusal of a patent application, a divisional application can be filed until expiry of the period for filing an appeal even if no appeal is filed[26].

The sanction on failure to meet a time limit under Swiss procedural patent law is refusal rather than the legal fiction of deemed withdrawn. Deemed withdrawn is only used when the requirements for entry into the Swiss national phase are not complied with in time (Article 124 of the Swiss patent act). In most cases the legal remedy is further processing (Article 46a of the Swiss patent act). There is, to the best of our knowledge, no case law on the possibilities of filing divisional applications in these situations.

According to Swiss code on civil procedure a distinction has to be made between a general legal remedy, called *Rechtsbehelf*, and a specific legal remedy, called *Rechtsmittel*[27] or means of legal redress[28]. A general legal remedy (*Rechtsbehelf*) is any kind of legal remedy against a decision or an adverse legal situation with the

15 Decision J2/08 reason 5 and decision G1/10 Summary of facts and submissions, point VII.2

16 BGH GRUR 2000, 688 „Graustufenbild". Note, that it may even be filed during the period for filing an appeal on a point of law („Rechtsbeschwerde" according to § 100 PatG – comparable to a review) with the BGH after a decision issued by the BPatG in an appeal proceedings (BPatG in "Mitteilungen der deutschen Patentanwälte„ 2005, 22 "Entwicklungsvorrichtung" – file no. 20 W (pat) 46/04 of 18.11.2004)

17 See also J2/08 reasons 29-32

18 BGH GRUR 2000, 688, 689 „Graustufenbild" under II.2.c para. 2

19 BGH GRUR 2000, 688, 689 „Graustufenbild" under II.2.c para. 3

20 BGH GRUR 2000, 688, 689 „Graustufenbild" under II.2.c para. 5

21 Follows from BGH GRUR 2000, 688, 689 „Graustufenbild" under II.2.c and decision J2/08 reasons 30, 31 (OJ 2010, 100) discussing decision „Graustufenbild"

22 Even if the wording of § 123(1) PatG („wird der Beschluss wirkungslos") and Article 121(3) EPC („gelten die Rechtsfolgen der Fristversäumung als nicht eingetreten") differs, the effect is the same: the application is retroactively revived

23 § 123 and 123a PatG, following the same reasoning given in section 6.2 below; for re-establishment see also Schulte, Patentgesetz, Carl Heymanns Verlag 2008, § 123, 9

24 See e.g. Spühler, Dolge, Gehri, Schweizerisches Zivilprozessrecht, Stämpfli Verlag AG, Bern 12 N 15-17 and 67-69.

25 Basler Kommentar, Schweizerische Zivilprozessordnung, 2010, Art. 336, N3

26 PMMBl 1970 I S 43, and also Blum, Pedrazzini, Das schweizerische Patentrecht, Stämpfli, 1975, Vol III, 327/I

27 The meaning of *Rechtsbehelf* and *Rechtsmittel* is slightly different in Switzerland and Germany

28 In this article we use 'remedy' for *Rechtsbehelf* and 'redress' for *Rechtsmittel*' in the Swiss sense.

aim of changing or annulling it. On the other hand, a means of legal redress in the sense of a *Rechtsmittel* is a qualified legal remedy to have a decision reviewed and possibly changed[29]. Within this framework, re-establishment is obviously a general legal remedy (*Rechtsbehelf*) and not a means of legal redress (*Rechtsmittel*), as it is not a legal remedy for reviewing a decision[30].
If the time limit for filing an appeal is missed, the first instance decision does become final at expiry of the period for filing the appeal, even if the general legal remedy of re-establishment in this period is requested (Article 148 of the Swiss code on civil procedure). In other words, a first instance decision may have become final and can even be enforced, even if re-establishment in the period for filing an appeal is still available[31]. Therefore the fact that the legal remedy of re-establishment is potentially still available does not affect the finality of the first instance decision.

Applying this, as done by the EB, to the question of existing substantive rights, this means that unless the legal remedy of re-establishment is actually used, the loss of rights occurs at the moment of missing a time limit or when a decision has become final, and the application does not exist anymore during the period for filing a request for re-establishment. Hence, re-establishment does not have suspensive effect and the right is lost on expiry of the failed time limit; in the case re-establishment is used, it has the effect that the legal consequences of the failure shall be deemed not to have ensued. The result is analogous to that of an extraordinary means of legal redress, i. e. a means of legal redress which has no suspensive effect. In view of the equivalence of the effects of re-establishment and further processing[32] the same should apply for further processing.

As a consequence, the filing of a divisional application in the periods for requesting re-establishment and further processing from the Swiss perspective should not be possible if the request for the remedy is not filed and allowed.[33]

5. Alternative definition of pendency

The legal uncertainty that may result if G1/09 is interpreted as set out in the above section 3 is not present in the practice in France, Germany and Switzerland because of the distinction made between ordinary means of legal redress and other legal remedies, as shown in the above section 4. G1/09 does mention the notion of „ordinary means of redress", but only to support the finding that its definition of pendency results in the application being pending until a decision becomes final.

We propose to include the notion of „ordinary means of redress" in the definition of pendency to reduce the mentioned legal uncertainty. Although the notion is not used in the EPC, it may be introduced under Article 125 EPC as a principle of procedural law recognised in the contracting states. The EB appears to approve of such an introduction[34].

The pendency of the application in the context of Rule 36 EPC should not be based on pendency of proceedings, as this would not improve the presently inconsistent practice of the EPO[35]. However, a definition based on the existence of substantive rights as used in G1/10[36] may lead to an increased legal uncertainty.

A suitable definition of pendency in the context of Rule 36 EPC appears to be: a pending patent application is a patent application that exists as such, i. e. a patent application that can lead to a granted patent. In terms of substantive rights, this means that a pending patent application is a patent application for which the substantive right to the patent under Article 60 EPC is in existence; any other substantive right that may be derived from the patent application should be disregarded for establishing pendency of the application. In other words, as long as the patent application can be granted, the application is pending. Hence, a patent application is pending from the date of filing until the date the application ceases to exist.

When the patent application ceases to exist depends on whether or not an ordinary means of legal redress exists to revive the application. When the right to the patent is lost by a decision allowing an ordinary means of legal redress, the application is pending until expiry of the period for seeking this legal redress. When the right is lost by a decision or an operation of law not allowing an ordinary means of redress, the application is pending until the date of the decision or the date of operation of law.

According to the reasonably consistent national practices, an ordinary means of redress is characterised by a review, suspensive effect and delayed finality, i. e. the decision to be redressed becomes final only upon expiration of the period for filing a request for ordinary means of legal redress; all other legal remedies do not have suspensive effect and the legal consequences of the decision take effect immediately. Following this principle, a remedy under the EPC is regarded as an ordinary means of redress if the remedy includes a review and has suspensive effect; a decision allowing such a remedy will have a delayed finality. The only ordinary means of redress in the EPC is appeal, as it has suspensive effect[37]. A review under Article 112a EPC is an extraordinary means of redress; although it is a review of a decision, it does not have suspensive effect[38]. Further processing

29 Basler Kommentar, Schweizerische Zivilprozessordnung, 2010, Vorbemerkungen zu Art. 308-334 N1
30 Basler Kommentar, Schweizerische Zivilprozessordnung, 2010, Art. 148 N2
31 Basler Kommentar, Schweizerische Zivilprozessordnung, 2010 Art. 148 N43
32 See Art. 121(3) and Art. 122(3) EPC
33 Interestingly, this is in contrast to the communication of the Swiss patent office mentioned above, PMMBl 1970 I S 43, and also in Blum, Pedrazzini, Das schweizerische Patentrecht, Stämpfli, 1975, Vol III, 327/I, in which it is stated that a divisional application can be filed also as long as a legal remedy similar to further processing, available at that time via the Swiss patent regulation Art. 32, is still available. However it appears that this is in contrast to the general procedural principles and would not be in line with the reasoning of the Enlarged Board of Appeal as concerns the basis for pendency
34 Decision G1/09 reason 4.2.2, pen-ultimate sentence
35 J2/08 reason 36-42
36 Decision G1/09 reason 3.2.4
37 Article 106(1) EPC, second sentence
38 Article 112a(3) EPC

and re-establishment are not means of redress but merely legal remedies because they do not review a decision.

The proposed definition is applicable to all procedural situations under the EPC and does not lead to an undesirable increase in legal uncertainty. In the following section the definition will be applied to several procedural cases.

6. Application of alternative definition

6.1 Refusal and grant in first instance

A decision by an examining division refusing a patent application under Article 97(2) EPC is open to appeal. An appeal is an ordinary means of redress as it has suspensive effect under Article 106(1) EPC, second sentence. Hence, an appealable decision becomes final only upon expiry of the period for filing a notice of appeal, at which expiry the patent application ceases to exist. According to the definition of pendency in the above section 5, the patent application will be pending until expiry of the period for filing the appeal.

Since according to Rule 36(1) EPC a divisional application can be filed on a pending earlier application, the divisional application can be filed until expiry of the two-month period for filing an appeal. The proposed definition of pendency has the same procedural result as decision G1/09[39], without reliance on Article 67(4) EPC[40].

G1/09 prohibits the filing of a divisional application during the appeal period after a decision to grant[41], e.g. when appealing a decision to grant that did not take into account an amendment filed after issue of the Rule 71(3) EPC communication. It should be noted that the prohibition is not in line with the „generally accepted principle" set out in G1/09[42], the definition of pendency in the above section 5, and German practice[43].

G1/09 agrees that no divisional application can be filed when there are no pending proceedings in the case of a stay under Rule 14 EPC or because of the processing prohibition of Article 23(1) PCT[44]. However, in both cases there are substantive rights in existence, which should allow the filing of a divisional application. Does pendency of the proceedings override pendency of the application? Note, that there are neither pending proceedings during the appeal period following a refusal in first instance.

6.2 Automatic loss of rights after failure to meet a time limit

A deemed withdrawal of an application after failure to complete an act within a prescribed period is an automatic loss of rights occurring by operation of law, without a decision being taken[45]. The available remedies, further processing and re-establishment, have no suspensive effect and are therefore no ordinary means of redress. Such a loss of rights occurs at expiry of the failed period[46]. The law confirms this interpretation; both Article 121(3) and 122(3) EPC state „If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued." These provisions hold that the legal consequences have already ensued before application of the remedy, i. e. at expiry of the failed period, and will be regarded as not having ensued after an allowed request for remedy, i. e. the remedy revives the patent application retroactively.

When no remedy is applied, the patent application will be pending until expiry of the basic, failed period and a divisional application can be filed until the expiry. A divisional application filed after the expiry, even within the two-month period for requesting the remedy, will only be valid if a remedy is applied. This consequence of the proposed definition for pendency is in line with the current, consistent practice of the EPO[47].

It should be noted that under Rule 112(2) EPC a party may apply for a decision on an allegedly inaccurate finding of the loss of rights. The decision has a declaratory character in that it only confirms or denies the legal consequence. In the former case, the right will still be lost on expiry of the failed period. An appeal lying from the decision does suspend the consequences of the decision but does not revive the lost application. The application will only become pending again if the board reverses the decision and decides that the finding was inaccurate.[48]

The distinction between ordinary means of legal redress and other legal remedies accords with Article 67(4) EPC, which states that a patent application is deemed never to have conferred provisional protection „when it has been withdrawn, deemed to be withdrawn or finally refused". The patent application ceases to exist when it is withdrawn (without remedy) or is deemed to be withdrawn (which often has a legal remedy in the form of further processing and/or re-establishment) or when it is *finally* refused (which has an ordinary means of redress in case of refusal in first instance). It is very likely that this distinction has been in the mind of the legislator when drafting the provision; however, the Travaux Préparatoires are silent about it.

6.3 Decision after failure to meet a time limit

The legislator has chosen in a few situations to use the sanction of refusal instead of deemed withdrawn when an act is not completed within a specified period, which results in a very different pendency of the application. Not filing the designation of inventor within the period specified in Rule 60(1) EPC is such a situation. The

39 Decision G1/09 reason 4.2.4

40 Decision G1/09 reason 4.2.3 interprets Article 67(4) broadly as a self-contained provision at which substantive rights and therefore the pending status of the application must end, whereas decision G4/98 reason 3.4 holds that the paragraph relates to provisional protection only

41 Decision G1/09 reason 4.3.1-2

42 Decision G1/90 reason 4.2.2

43 BGH GRUR 2000, 688 „Graustufenbild". See also J2/08 reason 38-39 on the unacceptability of the gap in pendency caused by the prohibition

44 Decision G1/09 reason 3.2.2 and 3.2.5

45 Decision G1/90 reason 4

46 Decision G4/98 reason 7 and J4/86 reason 3-5

47 Guidelines for examination in the EPO, A-IV,1.1.1.1. See also decision J4/86

48 Decision J1/05 reason 4

following example shows the consequences of this choice.

The designation of inventor had to be filed at the latest on 12.08.2009 and the decision refusing the application was dated 13.10.2009[49]. The decision will enter into force on the date of notification[50], i. e. 23.10.2009, and a notice of appeal can be filed until 23.12.2009. According to both the reasoning of G1/09 and the above definition for pendency, the last day for filing a divisional application is 23.12.2009 if no appeal is filed. Had the EPC chosen for the sanction of deemed withdrawn instead of refusal, the last day would have been 12.08.2009.

It would be helpful for public certainty if similar failures have similar sanctions. Since deemed withdrawn is the most used sanction in the EPC for failure to complete an act, the failures that presently prescribe refusal as sanction should be changed to deemed withdrawn, in spite of the fact that Article 90(5) EPC presents refusal as default sanction for not correcting a formal deficiency in time.

49 Example taken from decision J1/10

50 Decision G12/91 reason 2. Note, that the EPO uses the concept of „entry into force" or „becoming effective" of a decision mainly in relation to the inability to amend the decision. In Article 97(3) EPC the decision to grant shall „take effect" on the date of publication of the mention of the grant, which relates to enforceability. If all consequences of a decision to refuse would enter into force on the day the decision is issued, the patent application would cease to exist on the date of issue; however, G1/09 held that the application is still pending after the date of issue. Hence, it is not clear which legal consequences of a decision enter into force on issue of the decision and which consequences have a delayed entry into force.

6.4 Priority application

The previous article[51] showed that application of the reasoning of G1/09 could be interpreted to allow the filing of a divisional application in the priority year even after the priority application was deemed withdrawn, based on the existing substantive right of priority during this year.

When using the proposed definition of pendency, a divisional application can be filed on the priority application only between the filing of the priority application and the date the application is deemed withdrawn, since the priority application is no longer in existence after the deemed withdrawal. This corresponds to the current practice of the EPO.

7. Conclusion

There may be a way out of the mist shrouding divisionals after issue of decision G1/09. The distinction between ordinary means of redress and other legal remedies, used in national law, may be applied to define pendency of a patent application under the EPC. The resulting opportunities to file a divisional application correspond to G1/09 in the case of refusal in first instance and to the established practice of the EPO in other situations.

51 See above footnote 2

Important clauses in NDAs in view of Art. 55(1)(a) EPC

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Abstract

In the following discussion regarding Non-Disclosure Agreements, the authors have analysed the case law with respect to non-prejudicial disclosures through evident abuse, Art. 55(1)(a) EPC. The conclusion being that drafting NDAs should take into account the findings in order to utilise this privilege in the event of an unauthorised disclosure.

1. Introduction

As many of you are probably aware, there is an Article in the EPC, namely Art. 55 EPC, which deals with non-prejudicial disclosures. Whereas Art. 55(1)(b) EPC refers to the display at specific exhibitions, Art. 55(1)(a) EPC refers to a publication due to, or in consequence of, an evident abuse. As both of the above scenarios are a rare occurrence in daily practice, spending time studying the respective case law appears worth while only for those interested in the philosophic side of things or when preparing for the EQE.

However, quite often without us being aware of it, many may deal with the implications of Art. 55(1)(a) EPC and the facts related to its case law on a regular basis, namely, when preparing and negotiating NDAs (non-disclosure agreements). Whilst the direct application of Art. 55(1)(a) EPC may be irrelevant, the indirect implications thereof are of crucial importance. Drafting, negotiating and in particular agreeing to an NDA should not be done without the consideration of the case law of the Boards of Appeal (BoA) with respect to Art. 55(1)(a) EPC.

In general terms, an NDA is a contract according to applicable Law between at least two parties. It normally includes the obligations of non-disclosure of specific information to third parties and to not utilise the information in any other way than agreed upon. Whereas the standard situation should be that the party

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receiving the information (henceforth called „the recipient") abides by the contract and thus does not disclose the information to any other party other than an authorized person, little attention has been directed to the issue of what happens if the contract is breached by the recipient.

In the following sections, it is the intent of the authors to present some relevant case law and important consequences to consider when drafting NDAs. In particular, some aspects are presented where, if inserted in an NDA, should allow for the utilisation of the exceptional privilege of Art. 55(1)(a) EPC in the event of an unauthorized disclosure.

2. Purpose of an NDA

Civil Law

The NDA is a contract according to, for example, Civil law between at least two parties, which generally can be agreed upon in writing, orally, or even tacitly. As is the case in all contractual issues, the breach of a contract results in Civil Law consequences that might differ slightly in each individual member state of the EPC.[3] If the recipient makes the information available to the public, the discloser may claim for omission, if this is still possible or helpful.[4] What can become more important is the claim for damages suffered due to any unauthorized disclosure. A clause about a penalty sum in case of contract breach may be included in the contract so that the discloser has the chance of receiving some reimbursement without the burden of proving the existence of, and, what is potentially more complicated, the sum of damages suffered.[5]

Art. 54 EPC

There are two important implications of an NDA regarding patent law. One of them, and this is certainly the most relevant issue in practice, is the requirement of Art. 54(2) EPC which, in conjunction with Art. 89 EPC, requires that the state of the art shall be held to comprise *„everything made available to the public"* before the filing/priority date of the European patent application. Extensive case law has been developed as to what can be considered as public. With respect to the application of Art. 54 EPC, it seems that the introductory sentence in the case law book under the section *„obligation to maintain secrecy"* perfectly summarizes the very broad approach of the BoA: *„If the person who was able to gain knowledge of the invention was under an obligation to maintain secrecy, the invention cannot be said to have been made available to the public, provided the person did not breach that obligation"*.[6]

That is, in order to disqualify as prior art according to Art. 54(2) or (3) EPC, it seems sufficient that there is *some kind* of obligation to maintain secrecy. Compared with the strict case law regarding Art. 55(1)(a) EPC as discussed in the next section, the BoA generally appear to have a lenient attitude when recognising the presence of such an obligation under Art. 54 EPC, for instance, if a third company is sub-contracted (without any explicit NDA)[7] or if the information was taken from the correspondence between partners having some contractual link.[8]

Art. 55(1)(a) EPC

Not only is the respective case law with respect to Art. 54(2) EPC part of our daily practice, for instance when opposing a patent based on alleged public prior use, it does also shape our understanding of what should be considered as confidential according to the EPC. It would be, however, a large mistake if this interpretation was used as a basis for our understanding of the non-prejudicial disclosure according to Art. 55(1)(a) EPC. Indeed, as will be outlined below, the authors have not been able to identify a single case from the decisions of the BoA where the injured party was allowed to benefit from this rule.

The general intention of Art. 55(1)(a) EPC is quite clear. A disclosure of the invention shall not be taken into consideration for the judgement of novelty and inventive activity if it occurred no earlier than six months[9] preceding the filing of the European patent application and was due to, or in consequence of, an evident abuse in relation to the Applicant or his legal predecessor. Any doubt as to whether the filing date could be interpreted as the priority date was eventually resolved by the Enlarged Boards of Appeal in the decisions G 3/98 and G 2/99 holding that the relevant date is the actual filing date of the European patent application and not its priority date.[10]

The pertinent question is, however, that of what an *evident abuse* actually constitutes. According to the Travaux Préparatoires for the EPC 1973,[11] Art. 55(1)(a) EPC is designed to give proper compensation for an inventor whose ideas had been stolen or who had been the victim of industrial espionage or abuse of a position of trust because an ordinary Civil Law action for damages

3 Consequences according to the criminal law are generally also possible. For more details see, e.g., Westermann, Ingo (2007): *Handbuch Know-how-Schutz*, pp. 105ff for Germany, and pp. 135ff for twelve further important industry nations.

4 The claim for omission could be valuable for the discloser if there is an imminent danger that the recipient could make the information public in the near future. Once the information has been made public already, from a prior art viewpoint, a claim for omission is not helpful for the discloser any more.

5 The national law with respect to penalty clauses differs essentially. For instance, whereas in Germany the penalty establishes a claim on its own, which, dependent on specific situation and wording, does in principle not affect the claim for damages, the penalty according to the Anglo-American law constitutes the so-called *„liquidated damages"* which is not an independent claim but indemnifies the injured party from proving the height of the damage, see Kurz, Peter (2008): *Vertraulichkeitsvereinbarungen*, p. 77ff.

6 See *„Case Law of the Boards of Appeal of the European Patent Office"*, 2010, p. 77.

7 See, for instance, T 830/99 and T 799/91.

8 See, for instance, T 887/90, T 541/92, T 1076/93, T 818/93, and T 480/95. In particular, T 472/92, OJ. 1998, 161, deals with the case of a joint venture agreement between the parties which, according to the BoA, implies an obligation to maintain secrecy.

9 The wording *„no earlier than six months"* replaced the original wording of *„within six months"* which was objected to by the British delegation since it excluded prior art according to Art. 54(3) EPC from that privilege. For a detailed discussion see Straus, Joseph: "*Neuheit, ältere Anmeldungen und unschädlcihe Offenbarungen im europäischen und deutschen Patentrecht"*, GRUR Int. 1994, p.89ff.

10 See OJ 2/2001, p. 62ff and p. 83ff.

11 The Travaux Préparatoires for the EPC 1973 were recently made available online, see http://www.epo.org/law-practice/legal-texts/archive/epc-1973/traveaux.html.

could not give him full satisfaction. Nevertheless, it was also stated in the Travaux Préparatoires that the provisions of Art. 55 EPC ran contrary to the principle of absolute novelty and that it may lead to legal uncertainty. The Working Party in charge of drafting the EPC thought that the provision would be applied rarely and that any possible abuse of this article could be limited by a restrictive wording.

As will be set forth in the following, the BoA at the EPO have not contradicted the intention that the Working Party placed on Art. 55 EPC.[12] Instead, the BoA have developed their interpretation of the term *„evident abuse"* that highly restricts the possibility of saving an application by relying on Art. 55(1)(a) EPC.

To start with, not surprisingly, the burden of proof that a disclosure was the result of an evident abuse lies with the prejudiced party, i. e. the applicant or the patentee.[13] The BoA have set a high standard of proof for a legally enforceable obligation of confidence. Although it is generally possible that an NDA may be acknowledged even in the absence of written evidence,[14] as a general rule, the applicant/patentee must present evidence *proving beyond doubt* that a disclosure contravened the confidentiality obligation.[15] Evidently, oral or tacit contracts are much harder to prove *beyond doubt* than written agreements.

Regarding the interpretation of the term *„evident abuse"*, in the mid-eighties the decision T 173/83 interpreted that there would be an evident abuse if it emerged "*clearly and unquestionably that a third party had not been authorised to communicate to other persons the information received.*"[16] There would be abuse not only when there is the intention to harm, but also when: a) a third party acts in such a way as to risk causing harm to the inventor, or b) when this third party fails to honour the declaration of mutual trust linking him to the inventor.[17]

Apparently, the headnote of decision T 173/83 contained an interpretation of the term *„evident abuse"* that is rather generous for the applicant/patentee. Further, by the reasons brought forward in the decision, it seemed that the Board in charge set a precedent for an interpretation of Art. 55(1)(a) EPC in which an NDA between an applicant/patentee and an alleged abuser covering the subject-matter of the abusive disclosure would suffice for rescuing a European patent application by making recourse to Art. 55(1)(a) EPC, independently of the intention of the abuser. Thus, Singer/Stauder conclude that the intention, bad faith or any other form of guilt is not of any relevance but only the factual consequence that the rights of who is entitled to the invention are wrongfully violated.[18]

Nevertheless, it should be noted that the respective BoA did not consider the publication as non-prejudicial in the sense of Art. 55(1)(a) EPC in this case because it put a high burden of proof for accepting that the alleged abuser was bound to a secrecy agreement. The patentee, incapable of submitting an explicit NDA but referring to an ongoing business relationship with the discloser for the *„final development of the invention"* of about two years prior to the allegedly abusive disclosure,[19] was not able to overcome this burden and the patent was lost.

Almost a decade after the decision T 173/83, in the landmark decision T 585/92 the BoA established what should be the correct interpretation of the term *„evident abuse"*.[20] Therein, it is stated that the term *„abuse"* as used in Art. 55 EPC "*is not the equivalent of a mere breach or a clear infringement of the applicant's right.*"[21] While it was held true that every abuse of an applicant's right involves a breach or infringement, the BoA made clear that not every breach or infringement constitutes an abuse.

In contrast to the assertions in T 173/83, the Board thus found that "*the state of mind of the abuser is of importance to determine whether there is an abuse***"**.[22] When there is a legally enforceable obligation of confidence, either tacit or explicit, the recipient of the information would know or should know the likely commercial and legal consequences of any unauthorised disclosure. The Board held that such a disclosure, "*made either with actual intent to cause harm (here commercial damage), or with actual knowledge (cf. constructive knowledge) that some such harm would or could reasonably be expected to result from it, would amount to an abuse in relation to the owner of the information"*.[23] It is noted that T 585/92 is presently established case law and is followed by the Guidelines, see section see C-IV, 10.3.

In the particular case dealt with in T 585/92, the disclosure under dispute was caused by an accidental publication by the Brazilian Patent Office. Whilst this might sound irrelevant for drafting NDAs, the ruling and reasons of this decision are generally applicable. The Board made unambiguously clear that *„not everything done in infringement of local laws … is of necessity an abuse in relation to Applicant's rights"*. In particular, *"lamentable errors or simple mistakes do not… qualify as 'abuse', let alone evident abuse"*.[24]

In the decision T 291/97, the BoA further held that merely being aware that an early publication might prevent someone from a getting a patent granted cannot be considered as a state of mind leading to an evident abuse. Rather, in the particular case dealt with in that decision, abuse could not be acknowledged since there was no legal obligation of the recipient not to

12 As a side remark it shall be noted that Art. 55(1)(a) EPC was not amended during the revision of the EPC performed in 2000.
13 See, for instance, T 436/92, r. 5.2.
14 Ibid.
15 See in particular T 291/97, r. 13.
16 See OJ 1987, p. 465.
17 See T 173/83, headnote.
18 See Singer, Margarete and Stauder, Dieter (2010): *European Patent Convention*, Art. 55, marginal number 15.
19 See T 173/83, r. 3.
20 See OJ 1996, p. 129ff.
21 T 585/92, r. 6.4.
22 Ibid, second headnote.
23 Ibid, r. 6.5.
24 Ibid, r. 6.4 and r. 6.6.

publish. The BoA thus neglected that the alleged abuser could be bound to an NDA since, in their opinion, the alleged abuser had an interest in disseminating the work forming the substance of the invention because he formed part of the scientific community and was employed by a university institution. Thereby, the Board made clear that the finding of an evident abuse of Art. 55(1)(a) EPC is a *„serious matter"*. Thus, *„the case must be clear cut and a doubtful case will not be resolved in favour of the applicant"*.[25]

Although these decisions do not refer to situations where an explicit NDA was involved, they already give a clue of how much stricter the case law with respect to Art. 55(1)(a) EPC is when compared to the generous view normally taken with respect to Art. 54(2)(3) EPC issues. Some additional cases where it could be proven that an NDA existed between the alleged abuser and the applicant, yet the Board still did not rule favourably towards the injured party, will be discussed further.

In decisions T 436/92[26] and T 41/02, the BoA asserted that the fact that the applicant did not react to the alleged breach of confidentiality by, for example, *taking judicial measures at the time of the disclosure* proved that the disputed disclosure was not the result of an evident abuse. According to T 436/92, the absence of any objections by the discloser after the publication by the recipient *„could be assumed to indicate"* that the injured party would condone it.[27]

From the authors' Civil Law understanding, making the interpretation of the contract dependent on how a party reacts in the case of a subsequent breach of the NDA by the other party is an approach which seems quite unusual, to say the least. Be that as it may, practitioners should learn therefrom that the EPO might take not only a legal action as indication, but in particular the result of the legal action, i. e., the decision of the court called, as an evidence of a breach of the contract.[28]

The case T 41/02 is furthermore quite significant because it allows the conclusion that, given an NDA, a disclosure *only partially describing the subject matter of the prejudicial disclosure* cannot constitute an evident abuse because *„it could suggest"* that the discloser considered the avoidance of the complete disclosure *„to be enough to obey to the secrecy agreement"*.[29] The decision T 189/91 dealt with a similar case. The confidentiality was considered to relate to the use and operation of specific equipment. The Board found it *„very questionable"* whether the agreement applies also to the equipment as such.[30] These decisions underline that the confidential information in an NDA is to be defined most carefully.

3. Is there any chance to benefit from Art. 55(1)(a) EPC?

In view of the decisions discussed, one might question whether there is any chance at all to benefit from this exceptional regulation. Indeed, the authors were able to identify only two cases, namely T 377/95 and T 535/95, whereby the Boards decided in favour of the injured party in proving that a disclosure was a consequence of an evident abuse. In these cases, an affidavit filed by the alleged abuser declaring his prejudicial act was the evidence that fulfilled the standard of proof for convincing the Boards. Nevertheless, this did not help the applicants since the disclosures in question did not occur within the time limit of Art. 55(1) EPC, as established after referring to the Enlarged Boards of Appeal for clarifying the question giving rise to decision G 3/98.

Accordingly, the authors were not able, thus far, to identify a single decision of the BoA where the applicant/patentee was able to save an application/patent making recourse to Art. 55(1)(a) EPC.[31] However, considering the following aspects in NDAs should increase the chances of that occurring in the future.

4. Implications for drafting NDAs

First of all, and not surprising to all practitioners, giving away important, but not yet protected, information without having agreed on an NDA is wantonly negligent. In addition, although it may not be ruled out that an NDA is acknowledged by the EPO despite the lack of any written documentation, relying on oral or even tacit NDAs makes sense only for those prepared to take a big gamble.

Since most of us agree that a written NDA is indispensable, evidently, the discloser of the NDA trusts that the recipient abides by the contract. This should be the standard situation which has in particular the beneficial effect that the disclosure is not considered as prior art in the sense of Art. 54(2) and (3) EPC. The less frequent, but highly unpleasant, situation is, however, the one where the recipient breaches the contract. Aside from the Civil Law claim for damages, the discloser may still want and/or need to file a patent application. As previously stated history tells us, applicants should not be too optimistic when relying on Art. 55(1)(a) EPC for overcoming unauthorised disclosures. Nevertheless, the established case law also allows deducing some practical consequences for drafting NDAs which are outlined in the following.

1. Generally, the BoA require a high burden of proof, namely demonstrating clearly and unquestionably that a third party had not been authorised to communicate to other persons the information received.

25 See T 291/97, r. 13.

26 For the sake of completeness it shall be noted that in this particular case a written NDA, albeit drafted, was not signed by the recipient. Nevertheless, the further circumstances caused the Board to come to the conclusion that there was a common understanding that this party was bound by a tacit agreement, see r. 5.2.

27 See T 436/92, r. 5.2.

28 See T 41/02, r 2.2.4, which the authors understand in that any such legal action against the discloser under the law as agreed upon in the NDA (presently the law of New Jersey) would at least put the discloser in the position to prove to the EPO that the contract was, in fact, breached.

29 See T 41/02, r. 2.2.5.

30 See T 189/91, r. 5.

31 In case any such decision has been overlooked, the authors are thankful to be provided therewith.

An NDA and its use is thus subject to strict requirements in order to be accepted as proof of an evident abuse.

2. The NDA has to specifically ban the publication of the subject-matter which is the basis for the prejudicial disclosure in dispute. For that reason, the NDA must detail what information is covered by the contract and thus banned from disclosure. This should be done with care and important aspects must not be forgotten. In particular, it should be explicitly included in the NDA that also *part* of the information provided, such as the general chemical formula without the indication of possible moieties, still falls under the scope of the contract.
3. The NDA should explicitly include that the potential abuser is well aware of the fact that a breach of confidence, either complete or partial, would amount to an abuse in relation to the other party and would thus cause an irreparable harm to the other party. In addition, the NDA should explicitly state that the recipient has the obligation to ensure that his/her behaviour does not impede the discloser from achieving the benefits of legally protecting the information covered by the NDA.

   For instance, an NDA may start with a preamble defining the general purpose of the contract. The preamble could be complemented with the remark that the NDA shall particularly allow the discloser to get patent protection for the substantial matter relating, partially or completely, to the disclosed information, and so the secrecy of the disclosed information is of utmost importance to the discloser. Any form of publication of the information covered by the NDA, partial or complete, is likely to render the grant of a patent impossible.
4. If applicable, the recipient should explicitly agree in the NDA not to prefer other interests, such as, the desire to academically disseminate the information, to the interest of the discloser in obtaining adequate legal protection for information covered by the NDA.
5. NDAs often include a clause that the recipient shall use the same degree of care, but in any case no less than a reasonable degree of care, to prevent the unauthorised use, dissemination or publication thereof, as it uses to protect its own information of a like confidential nature.[32] Although such a clause may be sufficient from a Civil Law viewpoint, the case law presented should be motivation to reconsider the wording. The recipient should be committed to apply all efforts whatsoever in order to avoid any kind of disclosure of the information which could harm the discloser's rights, in particular, it is his full responsibility to take all means for avoiding that the information will be made available to the public unintentionally, by mistake or any other error. The recipient acknowledges that should any such misfortune happen, it is likely to render the filing of a patent application for the discloser impossible, thus causing enormous harm to him/her.
6. With respect to the inclusion of third parties in the NDA (such as affiliates, suppliers, etc.), the NDA should include that it is the recipient's obligation to fully instruct and explain the negative and possibly fatal legal consequences of a disclosure for the disclosing party to all third parties that are informed of some or all of the information covered by the NDA. In particular, all third parties must be instructed that any intended or erroneous publication of the information is likely to jeopardise a patent protection in the future and that may result in drastic economic harm to the discloser. Generally, the clauses addressed herein should likewise apply to third parties.
7. If applicable, the NDA might already include a clause obliging the recipient to return all tangible items of the confidential information and all copies thereof, or to certify that all media with the information have been destroyed.[33] A time limit for returning or destroying may be predetermined, or it is to be done only upon request. In any case, it seems that such a clause would ease the necessity to prove the *beyond any doubt* evidence for the breach of the contract in those cases where the abusive disclosure happens after the deadline for returning or destroying the information.
8. A provision banning the recipient from filing a patent application which is essentially based on the confidential information could further ease the proof of a breach, in particular in those cases where the breach is constituted by the filing of a patent application, such as in the decision T 41/02.
9. Presently it seems that the only proof of an evident abuse accepted by the BoA was an affidavit from the recipient stating that the relevant disclosure was performed in abuse of the applicant. It might thus be worth considering to include an obligation in the NDA outlining the recipient's obligations in the event of a breach, wherein upon request by the discloser, he/she must fully cooperate with the discloser to avoid any negative effect on a possible patent application. In particular, to declare, if necessary under oath, in writing and/or orally: i) which information has been disclosed; and ii) that it was done in abuse of the other party's rights, if so. To what extent such a clause is in harmony with the national civil law would have to be analysed in view of the exact wording and the applicable right. However, interestingly enough, depending on the applicable law, it might give the injured party an enforceable court order to summons the abuser for making (honest!) statements of what exactly happened when the information was made available to the public.[34]

Furthermore, once a breach of confidence is recognised, prompt reaction to the publication might become essential for allowing the EPO the conclusion that the breach of the NDA constituted in fact an abuse. Hence, should

32 See, for instance, Kurz, p. 68.

33 Ibid, p. 73ff.

34 Subject to the validity of any such clause, in particular in those national laws where the penalty sum of the contract does not limit or define the claim for damages, the penalty sum could also be automatically reduced if the recipient agrees to witness for the EPO why and how the disclosure happened.

such a situation arise, the discloser should initiate immediate action even though the result of a civil law proceeding *per se* might not be of interest to him/her.

The authors have addressed elements of an NDA which should be considered in the preparation for the undesirable case of a contract breach, and the only rescue to get patent protection is by the exception stipulated in Art. 55(1)(a) EPC. Evidently, the Civil Law consequences in view of the applicable law as agreed upon in the NDA must be examined before any wording is chosen. Also, whether the enclosed suggestions are ultimately helpful in the event of a ruling by the BoA cannot be predicted. However, at least in view of the presently available case law, it would appear that these clauses at least strengthen the legal obligation of the recipient to maintain secrecy and help fulfil some of the restrictive requirements set by the BoA for the application of Art. 55(1)(a) EPC.

The Special Inventive Step Standard for Antibodies

Mark Stewart, Lindsey Kent, Andrew Smith, and Emma Bassinder[1] (U.S.)

In the pharmaceutical industry, as well as in all other industries, the patent laws function to weed out those discoveries that are worthy of patent protection from those that are not. Through the grant of a limited monopoly, the patent laws are designed to promote research and development that embodies true innovation. If pharmaceutical companies are unable to adequately and predictably protect the output of research and development efforts, then it will become difficult to justify the enormous investments required to commercialize life-saving and life-enhancing products.[2] In most cases, the inventive step standard encompassed by Article 56 will function to effectuate the proper balance by ensuring that those discoveries which represent real innovation are the subject of exclusive rights. The inventive step standard that has been applied for decades to patents covering a particular class of pharmaceutical products known as antibodies, however, no longer functions to provide exclusivity for these products.

The EPO takes a non-uniform approach in assessing the inventive step for chemical compounds. For compounds that are not antibodies, the EPO makes structural comparisons with prior art molecules and does not consider whatever methods might have been used to achieve such compounds. Unless a compound falls within a prior art genus or has structural changes not predicted to change the activity compared to prior art compounds, no functional improvement or unexpected properties are required. The EPO, however, takes the opposite approach for chemical compounds that are classified as antibodies. Examiners do not consider even significant differences from prior art antibodies at the most important structural positions and instead focus on the methods used to achieve the antibodies claimed. A significant improvement over any prior art antibody is almost always required. A beneficial consequence of the EPO's approach to non-antibody chemical compounds will most likely be a continued flow of a diversity of new drug products of all sorts, including small molecules, peptides, and proteins. On the contrary, unless the EPO changes its approach, most antibodies discovered within the last several years will not be patentable. More than 500 separate antibody drugs are currently in clinical trials, and the annual growth rate is expected to be more than 25 %[3], but it remains to be seen whether the inability to obtain patents to protect these investments will impact whether the products are launched in Europe or in some cases even developed at all. There is a real possibility that the inability to receive patent protection on antibody molecules in the future may deter research and development in this area.

Inventive step standard for non-antibody molecules

The general approach in assessing inventive step for any type of molecule is the problem and solution approach. For molecules other than antibodies, the closest prior art will disclose a compound or compounds with a use similar to that of the claimed compounds "*requiring the minimum of structural and functional modifications*" to arrive at the claimed invention.[4] The analysis focuses on a prior art structure and on whether it would have been obvious for a skilled person to make the modifications in the prior art structure to end up with the claimed structure. To that end, the Board has stated that when comparing two chemical structures representing compounds that have the same or similar utility, one compound is obvious over the other only if the structural differences "*were so small that they would have no essential bearing*" on the functional properties disclosed

1 Mark Stewart is a U.S. Patent Attorney; Lindsey Kent, Andrew Smith, and Emma Bassinder are European Patent Attorneys all employed by Eli Lilly and Company. The views expressed herein are not necessarily those of Eli Lilly and Company.

2 http://csdd.tufts.edu/news/complete_story/pr_outlook_2011

3 W. Wang et al., *Monoclonal Antibody Pharmacokinetics and Pharmacodynamics*, 84 Clinical Pharmacology and Therapeutics 548, 549 (2008)

4 Case Law of the Boards of Appeal of the European Patent Office (2010) 6th ed. p. 164.

(T852/91). There is a general presumption that unless there is an established correlation in the prior art between certain structural features and activity, any change will be expected to disturb the pharmacological activity profile of the initial structure (T467/94 which confirmed the guidance issued in T643/96). Thus, what is important is whether, at the time of filing, there is information available on the impact of any changes made that resulted in the claimed compound(s). As the analysis is primarily a structural one, the EPO also takes the position that compounds which provide an alternative solution to a known problem can still satisfy the inventive step requirement. In T92/92 the Board stated that *„Article 56 does not require that the problem to be solved be novel and thus, there is no reason why an alternative solution to a known problem be excluded from patentability. The inquiry is merely whether the alternative is obvious"* (T588/93).

Further, there is no requirement that the claimed compound be „better" or „superior" to known compounds. Unless the art is such that the differences between the closest prior art compounds and the claimed compounds would not be expected to disturb the activity of the compound or unless the claim is directed to specific compounds that are encompassed by a larger genus of compounds disclosed in the art, there is no requirement that the claimed compound possess improved or unexpected properties compared to compounds in the art.

In summary, in the absence of a teaching in the art that the structural modifications required to reach the claimed compounds will not disturb the activity, then inventive step over prior art compounds having the same or similar function will be acknowledged. The problem to be solved would be the provision of alternative chemical compounds with the same function as some compounds in the art. The controlling patent law for small molecules has been particularly clear on what is required to meet the Article 56 inventive step requirement. It is a predictable and objective primarily structure-based approach which focuses on structural similarity between the structure of the compound or compounds claimed and the structure of compounds in the art.

Antibody Structure and Function

Before analyzing the EPO's inventive-step approach for antibody inventions, it is important to provide background about antibody structure and function. Antibodies are chemical compounds, and like any chemical compound, an antibody has a specific molecular structure and can be readily characterized by that structure. The function of antibodies that is relevant for the present discussion is their ability to attach specifically to a different molecule, which is referred to as the antibody's target or antigen. Antibodies are comprised of polymer strings of amino acids, referred to as „chains."

Each chain of an antibody is conventionally discussed in terms of certain „regions" known as „constant regions" and „variable regions." Variable regions are primarily responsible for antigen binding as well as for the great structural diversity that exists among antibodies. Further, variable regions are comprised of framework regions and complementarity determining regions (CDRs). Framework regions, whose precise structures can vary significantly from one antibody to another, orient the CDRs such that the antibody can bind the antigen. The CDRs, which display even greater variability, directly interact with and bind to the antigen. It is impossible to predict which of the twenty naturally occurring amino acids exists at each position in the variable region of an antibody based on the structure of the antigen and, in most cases, even knowing the structure of another antibody that binds the same antigen. In addition, it is usually impossible to predict, even if the amino acid sequence of a particular antibody is known, whether that antibody will have the desired biological activity. The entire premise upon which antibody-based medicine rests is dependent on these variable and completely unpredictable chemical structures.

Inventive Step Standard for Antibodies

Unlike the approach to inventive step for small molecules which focuses on structure, the approach for antibodies is a functional method-based approach.

Antibodies are generally claimed in three basic ways: 1) functionally (e.g. an antibody that binds target antigen X with a particular binding strength); 2) structurally (e.g. an antibody having particular amino acid sequences as its chains or as in its variable regions; or 3) a combination of structure and function (e.g. an antibody that binds target X with a particular binding affinity and having particular amino acid sequences for its CDRs).

Although the EPO ostensibly uses the same general problem-solution approach methodology to assess inventive step for antibody molecules as it does for small molecules, regardless of how the antibody is claimed, the identification of the closest prior art is almost always an entirely functional approach which does not make reference to structure. The closest prior art is generally art that discloses other antibodies with a similar function. In this regard, the prior art antibodies may have a completely unrelated structure and may not even disclose a single structure. Once this closest art is identified, the EPO determines whether it would be obvious to try to make the claimed antibodies and, if so, whether there would be a reasonable expectation of success using methods the EPO considers routine (T915/93). Thus, if the claimed antibodies have a function similar to antibodies disclosed in the art or, in some cases, even an improved function, and if routine methods can be or were used to obtain such antibodies, the antibodies will lack an inventive step. This is true even if the antibodies have a completely different and unrelated sequence compared to antibodies in the art.[5]

5 T735/00 states that inventive step is recognised *„if and when there is evidence that a claimed monoclonal antibody prepared by routine methods shows unexpected properties"*. In T0111/00 the EPO did not take a structural non-obviousness approach.

Unless the patentee has evidence that the steps taken to obtain a particular antibody were especially difficult, the only way to satisfy the inventive step requirement is to significantly differentiate the claimed antibodies from antibodies in the art based on function (T510/94). For applications filed within the last several years, overcoming the inventive step hurdle has become increasingly difficult. It used to be that a 10-fold improvement in binding affinity would suffice, but now many Examiners consider it routine to achieve antibodies having such an improvement. It is not unusual for an improvement in the region of a 100-fold increase in affinity to be required. Affinity, however, cannot be infinitely improved, and higher affinity does not necessarily translate into a better drug for patients. Going forward the degree of improvement of a claimed antibody which is required in order to be seen as inventive will become significantly greater as more techniques used in the development of therapeutic antibodies become routine in the eyes of the EPO.

Evolution of the inventive step standard for antibodies

A look at the historical progression of antibody technology provides clues as to why the EPO originally adopted a functional method-based approach for antibody claims. The law, however, must keep pace with the science, and technology today is such that the current approach is no longer feasible and no longer works to protect significant innovation.

Prior to 1975, the only way to generate antibodies was to immunize animals with a foreign antigen and then purify the serum of those animals to extract a heterogeneous mixture of antibody molecules. Such antibody mixtures could not be described structurally but only as products produced by immunizing animals with a specific antigen. Thus, antibodies were claimed this way („Antibodies binding target X produced by immunizing animals with target X"), and the EPO took the position that discovery of a novel antigen entitled the discoverer to all antibodies that were produced by immunizing an animal with the novel antigen. Similarly, once an antigen was in the art, all antibodies were obvious until such time as the antibodies could be claimed more specifically.

It was not until 1975 that hybridoma techniques became available that enabled scientists to isolate a specific antibody, known as a monoclonal antibody or mAb, from the mixture of antibodies present in the serum of the blood and, further, to expand the specific antibody into an amount sufficient to be studied and tested.[6] Thus, for a period of time, broad claims to monoclonal antibodies were considered inventive over prior art disclosing mixtures of antibodies with similar functions (known as polyclonal antibodies) (T512/94, T906/91 and T355/92).

Manipulation of the genes encoding mAbs and the ability to specifically alter such genes by methods such as site-directed mutagenesis now allow construction of antibody genes not found in nature. These genes can be expressed to produce antibodies with new properties and further allow scientists to fine-map the structure-function relationships between particular antibody-antigen interactions. Over the past decade, a major focus of the research and development activities related to therapeutic antibodies has been to create antibodies that look as much like human antibodies as possible to avoid adverse reactions once injected into humans. At one point in time, broad claims to chimeric (human constant region with murine variable region) or humanized (human constant and partial human variable region) antibodies were considered inventive over antibodies in the art, such as murine antibodies, with a similar function. Techniques used to create such antibodies are now considered routine such that any new antibodies obtained using these techniques, regardless of the scope of the claim, are no longer patentable unless such antibodies have significant unexpected properties compared to prior art antibodies. Genetic engineering of mAbs has progressed since 1986 to allow fine tailoring of the antibody sequence to generate very particularized characteristics of the mAb. More than half of the FDA-approved mAbs are human-engineered as are the majority of mAbs presently in clinical trials. It is unclear when these genetic engineering techniques will be considered routine such that antibodies obtained by these methods will not be considered inventive.

Problems with current inventive step approach to antibodies

Given the current state of technology, the method-based approach adopted by the EPO for antibody claims creates a number of problems. The approach is subjective in nature making it difficult to predict *a priori* whether even an extremely narrow claim covering a single antibody sequence will be patentable. This approach fails to reward the significant innovation required to achieve an antibody with a particular variable region sequence that gives rise to the properties associated with the potential to be a life-saving drug. Furthermore, we are nearing the point when all antibodies will be considered obvious in light of a disclosure of any antibody that binds and blocks or agonises a target of interest.

It will almost always be the case that engineering an antibody with a similar function, or even with a significantly improved function, will be considered by the EPO to be obvious to try. Scientists focus on the optimisation of a number of functional attributes in relation to a particular antibody in order to improve the likelihood that such antibody will be a successful drug. Some of the more common properties include the ability to bind a target antigen with a certain binding affinity, antagonizing or agonizing the target by binding a particular epitope on the target, specific target binding in the context of closely related family members with high sequence identity, and having fully-human or substantially human origins. The focus then is on the second prong of the test which requires that there be a reason-

6 G. Kohler and C. Milstein, *Nature.* 256, 496, 1975.

able expectation of success in achieving an antibody within the scope of the claim. This is a method based inquiry. If the methods used to discover such an antibody are routine art-recognized methods, the claim is seen by the EPO to lack inventive step.

It is unclear when a particular method is considered by the EPO to be routine such that any antibodies discovered by such a method are considered obvious. As discussed above, at various points over the past several decades, specific antibodies having a similar function to antibodies disclosed in the art have become obvious as the methods used to obtain them have become routine.[7] The techniques used to obtain human-engineered antibodies, including the creation of human antibody libraries, as well as transgenic mice having human antibody genes that can then be screened or immunized with a target antigen, may very well already be considered routine by the EPO. Thus, it is unclear whether any antibodies discovered using this methodology will be considered by the EPO to be inventive in the future, regardless of how „improved" they are compared to prior art antibodies.

Even very narrow claims directed to a specific antibody sequence are valuable to companies that are taking huge risks and expending enormous resources to bring a product encompassed by such a claim to the market. While such claims may not block off an entire class of drug development, such claims do protect against biosimilar generic compounds which, following data package protection expiration, have the potential to completely destroy the innovator's market. Furthermore, if narrow sequence-based claims are allowed, the public will benefit from competition that involves competing drugs with different side-effects and efficacy profiles. If all antibodies become obvious over an initial disclosure of an antibody that is able to bind and neutralize or agonize a target, this type of competition will be eliminated and companies will no longer invest in research and development to improve those antibodies.

The average research and development time for a single therapeutic antibody is more than 10 years and requires the investment of more than a billion dollars. At the very least it should be possible to patent the single antibody (claimed by its full sequence) that will ultimately make it to market as a life-saving medicine. However, the method-based approach adopted by the EPO makes it difficult for pharmaceutical companies to justify the resources that must be expended to bring these potentially life-saving products to the market. A logical solution to this predicament, however, is to apply the same standard as that applied for non-antibody chemical compounds.

The non-antibody molecule approach for antibodies

A structure-based approach is consistent with the goals of a strong patent system. Discovery and development of human-engineered antibodies is labour intensive and unpredictable in terms of what sequence will eventually confer the desired antibody properties. It is not possible to predict which amino acid changes in an antibody molecule will confer improved properties upon the parent molecule. It requires a process of constructing and analyzing numerous antibody mutants; a process that is no less difficult than constructing related small molecule chemical compound libraries and screening them for activity. It is not possible to predict how changes in amino acid sequence will affect the folding of the antibody protein or the binding of the antibody to an antigen.

As discussed above, the variable region of the antibody is responsible for the primary biological activity which involves antigen binding. Given that changes in amino acid sequence in the variable region of an antibody can have dramatic and entirely unpredictable effects on its binding characteristics, structure should play a fundamental role in the inventive step analysis. It is well documented that interactions between framework residues and CDRs dramatically and unpredictably affect the characteristics of antibodies. Changing even a single residue can modify the affinity or specificity of an antibody.[8] It is always the case that developing an antibody with optimal characteristics requires extensive research and analysis of the exact sequence which will yield the desired effects.

The fundamental technical feature of an antibody with a particular binding activity is the sequence of the CDRs in the variable regions. Whilst the prior art may disclose the function of certain antibodies and possibly structures very different to the claimed antibody structures, it is generally impossible to predict from such prior art that the six CDR sequences and perhaps even certain framework regions which define an antibody according to the claims would successfully achieve an antibody with any of the favourable properties identified in the prior art. The functional attributes of the claimed antibody, as governed by the CDR sequences claimed, are not obvious from the prior art. Contrary to the approach currently applied to antibody claims, there is no requirement in Article 56 that an invention be better than what is known in the prior art, an invention must simply be not obvious to a person skilled in the art (T588/93). Furthermore, an alternative solution which is the claimed antibody identified by specific CDR sequences, should be sufficient to provide an inventive step provided the technical feature of the invention – the structure of the antibody – is not obvious over the prior art.

Conclusion

The EPO's method-based approach for antibodies is now beginning to have grave consequences. The EPO could not have predicted when it began the practice of granting broad functional claims based solely on how difficult it was to discover antibodies with the claimed function,

7 Longberg, N. Nature Biotechnology, 23:9, 1117, 1118 (2005).

8 Roberts et al., *Nature* 328:731734 (1987); Tempest et al., *Bio/Technology* 9:266271 (1991); Co et al., *PNAS* 88:28692873 (1991)

that technology would progress to the point where all antibodies, regardless of function and structure, have become obvious once the antigen or target to which they bind is in the art. The attributes that make an innovative drug worth pursuing and which ultimately may benefit the public compared to drugs already on the market may no longer be attributes that will make a drug patentable at the end of the day. This has significant implications for future investment in research and development and ultimately for human health. Only a structure-based inventive step analysis is objective and will function to protect and reward true innovation.

Nicht zum letzen Mal in der epi Information:

Der fiktive Fachmann im Patentrecht

S. Gedeon (HU)

Die Kriterien für die Erteilung des Patents wurde für die Länder, die sich dem Europäischen Patentübereinkommen (EPÜ)[1] angeschlossen haben, im Übereinkommen definiert, und die einzelnen Mitgliedstaaten haben diese im Rahmen der Rechtsharmonisierung auch in ihre nationalen Gesetze übernommen. Demnach: „Europäische Patente werden für Erfindungen auf allen Gebieten der Technik erteilt, sofern sie neu sind, auf einer erfinderischen Tätigkeit beruhen und gewerblich anwendbar sind."[2] und „Die Erfindung ist in der europäischen Patentanmeldung so deutlich und vollständig zu offenbaren, dass ein Fachmann sie ausführen kann."[3]

Die vier Anforderungen sind also

A) die Offenbarung der Erfindung,

B) Neuheit,

C) erfinderische Tätigkeit,

D) gewerbliche Anwendbarkeit

Das Fehlen irgendeiner dieser Anforderungen führt zur Abweisung der Anmeldung. Die alle Fehler und Irrtümer ausschließende Prüfung dieser Anforderungen stößt jedoch auf objektive Hindernisse, und unter anderem muss *auch* deshalb ermöglicht werden, dass das Ergebnis der Prüfung angefochten werden kann. Falls der Einsprechende oder der Nichtigkeit Beantragende beweisen kann, dass die Prüfung irgendeiner der vier Anforderungen nicht mit der erforderlichen Umsicht durchgeführt wurde, wird das Patent rückwirkend (ex tunc) auf den Tag der Anmeldung vernichtet.

Die Bedingung D) verursacht die geringsten Probleme, da der über eine technische Ausbildung verfügende Prüfer das „Perpetuum mobile", das heißt die fehlerhafte technische Lösung, im Allgemeinen erkennt. Sollte eine nicht ausführbare Lösung dennoch die Erteilung eines Patentes erlangen, wird dies sowieso nicht verwirklicht. Wenn eine solche fehlerhafte Lösung veröffentlicht wird, kann das deshalb ein Problem darstellen, weil es zu einem Bestandteil der Datenbasis geworden ist. Dies hingegen geht mit der Gefahr einher, dass man sich bei der Feststellung des Stands der Technik darauf als Anteriorität berufen kann. Es kann angenommen werden, dass das Patent deshalb erteilt wurde, weil die sich auf die Ausführbarkeit beziehende Untauglichkeit schwer zu erkennen war und sich dies bei der weniger gründlichen Prüfung als Anteriorität noch schwerer herausstellt.

Die Möglichkeit der objektiven Prüfung der ersten drei Anforderungen hat sich im Laufe der Zeit trotz des Umstands, dass sich die Mittel und Geräte der Prüfung in bedeutendem Maße weiterentwickelt haben, nicht bedeutsam verbessert. Der Grund hierfür besteht neben der in außerordentlichem Maße anwachsenden Datenmenge in der Tatsache, dass die endgültige Entscheidung von *tatsächlich existierenden* Fachleuten getroffen wird, deren Fähigkeit zur Übersicht sich bei Weitem nicht in solch proportionalem Maße entwickelt hat wie die zur Verfügung stehenden Mittel und Geräte, weiterhin wird die Objektivität der Bewertung durch ihre auch untereinander abweichende Beurteilung, subjektive Bewertungsfähigkeit behindert. Dazu trägt auch bei, dass, obwohl die Prüfung der Neuheit, wenn auch nicht als vollständig, so doch als relativ objektiv betrachtet werden kann, die Bedingungen der erfinderischen Tätigkeit nur noch mit einer besonderen Erläuterung bedürfenden Begriffen ausgedrückt werden können, für deren genaue Definition keine Möglichkeiten bestehen.

In Anbetracht dessen, dass die Prüfung weltweit von vielen tausenden vorgenommen wird, ist die Schaffung irgendwelcher einheitlicher Gesichtspunkte wünschenswert. Der erste Schritt war die Annäherung der im materiellen Recht verankerten Kriterien, Definitionen zueinander. Dies ist mit Hilfe der internationalen Übereinkommen erfolgt. Im Interesse der Interpretierung der

1 Europäisches Patentübereinkommen in der Fassung des Beschlusses des Verwaltungrats der Europäischen Patentorganisation vom 21. Juni 2001 (EPÜ 2000)

2 EPÜ 2000, Artikel 52 Absatz 1

3 EPÜ 2000, Artikel 83

einheitlichen Definitionen wird die Harmonisierung des Verfahrensrechts, der Beurteilung, die möglichst einheitliche und bessere Annäherung der objektiven Entscheidung immer notwendiger.

A) Die Prüfung der Offenbarung der Erfindung

Zu Beginn wurde von der Beschreibung der Erfindung gefordert, dass der Sachverständige auf deren Grundlage die Lösung herstellen kann[4].

Bereits bei den ersten Anwendungen stellte es sich heraus, dass im Interesse der einheitlichen, objektiven Beurteilung das Wissensniveau des „nutzenden Sachverständigen" besser festgelegt werden muss, da auf dem gegebenen technischen Gebiet das Wissensniveau vom Techniker bis zum Universitätsprofessor, vom Auszubildenden bis zum über mehrere Jahrzehnte an Berufserfahrung verfügenden Werkmeister sehr bedeutende Differenzen aufweist. So gelangte man im Laufe der Rechtspraxis zu irgendeinem Fachmann mit durchschnittlichem Wissen. Musste die Erfindung so ausführlich dargelegt werden, dass ein Fachmann mit mindestens einem solchen Wissensniveau, der sog. Durchschnittsfachmann[5], die Lösung ohne erfinderische Tätigkeit verwirklichen kann.

Der zur Prüfung der Offenbarung der Erfindung angestellte Fachmann besitzt im Wesentlichen zwei Eigenschaften. Er hat *einerseits* über derartige Fähigkeiten zu verfügen, dass er aufgrund *seines im Beruf erwünschten „Pflichtkönnens"* in der Lage ist festzustellen, ob die Beschreibung und die Zeichnungen der in den Ansprüchen zu verteidigen gewünschte Lösung ausreichende Informationen für die Verwirklichung enthalten, *andererseits* ist er jedoch dazu *nicht in der Lage*, über die bekannten Routinelösung hinausgehende neue Lösungen zu schaffen bzw. auf dem Fachgebiet bzw. auf verwandten Gebieten angewandte, bekannte Anlagen, Geräten, Materialien, Verfahren usw. *auf dem Niveau eines Schöpfers zu kombinieren*.

Zur Erfüllung der ersten Bedingung kann auch eine natürliche Person, ein tatsächlich existierender Fachmann geeignet sein. Dafür müsste er nämlich auch vom Prinzip her nicht sämtliche, vor dem geprüften Zeitpunkt veröffentlichten Informationen, sondern nur die zur Ausführung der in der Patentanmeldung und in den als Stand der Technik betrachteten Dokumenten angeführten Lösungen notwendigen und geeigneten Geräte und Verfahren in einem zum Verständnis der Beschreibung des Patents erforderlichen Maß kennen. Der die Offenbarung prüfende Fachmann stellt nur fest, ob in der Beschreibung die zur Verwirklichung erforderlichen und ausreichenden Informationen zur Verfügung stehen. Es kommt allerdings die Frage auf, welches Niveau als Allgemeinwissen verlangt werden muss. Bei der Konstruktion stellt es sich heraus, ob die Informationen für die routinemäßige Konstruktionsarbeit ausreichen oder ob für die Konstruktion eventuell auch eine schöpferische Tätigkeit erforderlich ist. Als Kenntnisse des die Offenbarung der Erfindung prüfenden Fachmanns können – laut dem Standpunkt des Verfassers – die Pflichtkenntnisse (die allumfassenden Kenntnisse der auf dem Fachgebiet angewandten Verfahren und der zur Verwirklichung notwendigen Materialien, Mittel und Geräte auf Benutzerniveau) des das gegebene Fachgebiet gut kennenden Konstrukteurs als maßgebend angesehen werden.

Das Problem besteht darin, dass der sich auf einem Fachgebiet gut auskennende Konstrukteur, der aufgrund seiner Kenntnisse nicht dazu in der Lage ist, auf irgendeinem Niveau etwas zu erschaffen – *kein Fachmann ist*. Deshalb war bereits zur Prüfung der Offenbarung der Erfindung die Erstellung eines solchen Fachmann-Modells notwendig, dessen Eigenschaften natürliche Personen nicht besitzen können. Das bedeutet, dass der Fachmann für Patentrecht: ein fiktiver Fachmann ist. (im Weiteren: Fachmann[6]).

Bei der Feststellung der Fachkenntnisse des Fachmanns kann es in konkreten Fällen als Problem auftreten, wenn in der Lösung der Erfindung solche Geräte, Verfahren, Merkmale, usw. zur Anwendung kommen, die der Stand der Technik zum Teil in benannten Lösungen sind oder nicht aufgefunden werden können, oder wenn es einen Hinweis dafür gibt, aber keine ausführliche Darlegung erfolgt ist. Hier kommt dann die Frage auf, ob diese vor dem Zeitpunkt der Priorität auf dem gegebenen Fachgebiet angewendet wurde, das heißt ob deren Nutzung zum „Pflichtkönnen" des Fachmanns gehört oder nicht. Der Fachmann hat also festzustellen, ob hinsichtlich der in der Beschreibung erwähnten Mittel, Geräte, Verfahren, Merkmale, usw. der zu diesen erfolgende Hinweis bzw. der Umfang der Bekanntmachung ausreicht, um diese bei der Verwirklichung der den Gegenstand des Patents bildenden Einrichtungen, Verfahren als Benutzer anwenden zu können. Für gewöhnlich wird hierzu erwähnt, dass es notwendig, ja gar nicht erwünscht ist, die im Handel erhältlichen Materialien und Geräte, deren Anwendung zumindest in Fachkreisen als bekannt zu betrachten ist, im Detail darzulegen.

Im Anmeldungsverfahren kann es Probleme aufwerfen, dass der Anmeldende bemüht ist, die zur Verwirklichung der Erfindung erforderlichen Informationen zu verschweigen (das Niveau des „Pflichtkönnens" des Fachmanns zu hoch anzusetzen). Wenn die vorgehende Behörde diesen Umstand wahrnimmt, muss die Anmeldung abgelehnt werden, wenn der Mangel nicht nachgereicht werden kann. Im Laufe des Nichtigkeitsverfahrens legen die Antragsteller jedoch der Regel nach das „Pflichtkönnens" des Fachmanns auf einem niedrigen

4 Deutsches Patentgesetz vom 7. April 1891 § 20 (… In der Anlage ist die Erfindung dergestalt zu beschreiben, dass danach die Benutzung derselben durch andere Sachverständige möglich erscheint. …)

5 In der deutschen Fachliteratur: Durchschnittsfachmann. Der Begriff „Sachverständiger" wurde durch „Durchschnittsfachmann" abgelöst, weil ein *Sachverständiger* auf irgendeinem *Fac*hgebiet nur eine solche natürliche Person sein kann, die *über ein wesentlich umfangreicheres Fachwissen verfügt als der Durchschnitt*.

6 In den geltenden Rechtsvorschriften wird der fiktive Fachmann im Patentrecht kurz als „Fachmann" angeführt. S. Artikel 83 EPÜ 2000. Die Bezeichnung Durchschnittsfachmann entspricht aus dem Grunde nicht, weil dieser Begriff für gewöhnlich in der Praxis für natürliche Personen verwendet wird.

Niveau fest und bemängeln solche Details, die zum „Pflichtkönnen" der sich auf dem Fachgebiet gut auskennenden Fachleute (Konstrukteure) gehören.

Bei der Prüfung der Offenbarung der Erfindung werden die sonstigen Kriterien[7] der Patentierbarkeit vom Fachmann nicht beurteilt, nicht geprüft. Wenn er feststellt, dass die im Bericht laut Erfindung offenbarten Einrichtungen, Verfahren aufgrund seines Fachwissens auch ohne eine erfinderische Tätigkeit verwirklicht werden können, kann die Prüfung der Neuheit vorgenommen werden.

B) Neuheit

Der Begriff der Neuheit wird in Artikel 54 Absatz 1[8] des EPÜ 2000 festgehalten. Absatz 2[9] definiert, was unter dem Begriff Stand der Technik verstanden werden kann.

Der Stand der Technik wurde hier (und in den Patentgesetzen der verschiedenen Länder) als einer der Gesichtspunkte der Anforderungen, unter Berücksichtigung des Zeitpunktes der Veröffentlichung festgelegt, und dies hat bei der Rechtsanwendung bereits schon Probleme verursacht. Aufgrund dieser Festlegung gehören die Bibel, Goethes Faust, ein vor dem Tag der Priorität herausgegebenes Telefonbuch oder die Dokumentation einer im Jahre 1912 gebauten Dampflokomotive z. B. im Falle der Anmeldung eines Handys zum Stand der Technik. Der andere Gesichtspunkt, der Sachbereich der in der Anmeldung benannten Lösung, der eine Antwort darauf erteilen würde, wie diese unermesslich riesige, expotential zunehmende Datenmenge abgegrenzt werden kann, wird nur bei der praktischen Durchführung realisiert. Diese andere Anforderung könnte man *zum Beispiel* mit der Ausweitung der im Gesetz benannten Bestimmung so definieren "…oder ist auf eine andere Art und Weise, *auf demselben oder einem verwandten Fachgebiet, zur Lösung derselben oder einer verwandten Aufgabe* erreichbar geworden."

Diese Bestimmung stellt eine bereits wesentlich kleinere Informationsmenge dar, es gibt aber immer noch einen Ausdruck, der bestritten werden kann, weil dieser Definition immer noch viele Dokumente entsprechen können. Zum Stand der Technik gehört/en im Laufe eines gegebenen Verfahrens nämlich nur die Information/en, die von der Forschung offenbart wird/werden, auf die sich jemand beim Einspruch beruft und mit deren Zugrundelegung letztendlich eine Entscheidung gefällt wird. Deshalb wäre in Artikel 54 Absatz 2 anstatt des Verbs "*bildet*" die Anwendung der Verbform "*kann bilden*" zweckmäßiger.

In der Praxis gehört zum Stand der Technik das dazu, was von dem während des vollständigen Zeitraums der Neuheitsforschung bzw. der Prüfung offenbarten Material in die Prüfung einbezogen wird. Ideal wäre es, wenn auf identischen oder verwandten Fachgebieten jemand oder irgendein Programm von sämtlichen, für die Lösung von identischen oder verwandten Lösungen zugängig gewordenen Lösungen die nächst gelegene Lösung bzw. Lösungen auswählen könnte, die vom Gesichtspunkt der Neuheitsschädigung in Frage kommen können. Diese Leistung könnte eine tatsächlich existierende Person überhaupt nicht erbringen. Eine dafür erforderliche Datenbasis gibt es noch nicht, und das dafür benötigte Programm auch nicht. Obwohl dieser Fakt so in der Form noch nicht formuliert worden ist, wäre auch für die Neuheitsforschung ein fiktiver Fachmann notwendig; wir sind jedoch mangels Mitteln auf die verwendeten Datenbasen und die Geschicklichkeit der darin forschenden Personen angewiesen.

Wegen der Grenzen der Fähigkeiten der Menschen, die sich mit Forschung beschäftigen, zeigt der Wirkungsgrad der Forschung eine außerordentlich große Streuung auf. Dies ist der Grund dafür, wenn jemand seine Erfindung in mehreren Ländern oder Regionen patentieren lassen will, dass die an verschiedenen Orten durchgeführten Prüfungen sich oftmals voneinander unterscheiden. Über die erwähnten menschlichen Faktoren hinaus wird die mit einem guten Wirkungsgrad erfolgende Durchführung der Neuheitsforschung auch durch andere Hindernisse, durch den möglichen Zeitaufwand und die wirtschaftlichen Gesichtspunkte behindert. Die Neuheitsforschung, die Offenbarung des Stands der Technik ist eine der Achilles-Sehnen der Prüfung der Patentierbarkeit.

Zwischen der Genauigkeit der Offenbarung des Stands der Technik und der Anzahl der kostspieligen, zeitraubenden strittigen Angelegenheiten besteht ein umgekehrtes Verhältnis. Wegen der Grenzen der Offenbarung kann der wirkliche Stand der Technik in vielen Fällen auch nähere Lösungen als offenbart wurde, eventuell auch identische Lösungen beinhalten. Bis die Entwicklung dort anlangt, falls dies überhaupt irgendwann einmal eintritt, dass entsprechende Datenbasen und Programme zur Verfügung stehen und die Offenbarung sodann mit der erforderlichen Genauigkeit vorgenommen werden kann, ist die gesellschaftliche Kontrolle, die Möglichkeit des Einspruchs bzw. die Anfechtbarkeit des erteilten Patents unverändert notwendig.

C) Die Anwendung des Begriffs des Fachmanns für die Prüfung der erfinderischen Tätigkeit

Die Vornahme der Prüfung des dritten Kriteriums der Patentierbarkeit, der erfinderischen Tätigkeit im Anmeldungsverfahren, ist praktisch nur aufgrund des im Anmeldungsverfahren und im Laufe der Neuheitsforschung offenbarten, bzw. die Grundlage der Einspruchs- oder Nichtigkeitsklage bildenden „Stands der Technik" möglich und gebräuchlich.

Bei der Prüfung der erfinderischen Tätigkeit ist festzustellen, ob die als neu betrachtete Erfindung im Vergleich zum Stand der Technik auf einer Schöpfung beruht, die zum Patentschutz geeignet ist. Die Aufstellung objektiver Messparameter für die Prüfung der

7 EPÜ 2000 52. cikk

8 „Eine Erfindung gilt als neu, wenn sie nicht zum Stand der Technik gehört."

9 „Den Stand der Technik bildet alles, was vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit durch schriftliche oder mündliche Beschreibung durch Benutzung oder in sonstiger Weise zugänglich gemacht worden ist."

erfinderischen Tätigkeit stieß und stößt auch heute auf noch größere Schwierigkeiten als im Falle des zur Offenbarung der Erfindung angewendeten Fachmanns. Einer der Hauptgründe besteht darin, dass es im Prinzip unmöglich ist die Grenze zu ziehen, wo eine neue Lösung bereits als Schöpfung angesehen werden kann. Die Definitionen, die im Gesetz niedergelegt wurden, gingen und gehen mit viel Wünschenswertem einher. Solche Definierungen sind zum Beispiel: „es gehört nicht zum „Pflichtkönnen" des Fachmanns", „für einen Fachmann liegt es nicht auf der Hand", „für einen Fachmann ist es nahe liegend/selbstverständlich", „auch für einen Fachmann ist es eine Überraschung", „für einen Fachmann bringt eine vorhersehbare Wirkung mit sich". Diese Begriffe stellen – vor allem in Grenzfällen – nicht gerade eine objektive Beurteilung dar. Daher kann die Annäherung als zweckmäßigste angesehen werden, laut der eine Erfindung dann patentierfähig ist, wenn sie *zumindest* auf einer Kombination begründet ist.

Die unterste Schicht der aus schutzfähigen technischen Geistesschöpfungen bestehenden Pyramide bilden die Menge der Gebrauchsmuster (kleine Patente). An der Spitze der Pyramide befinden sich die sog. bahnbrechenden Erfindungen, die die Richtung und Schnelligkeit der Entwicklung grundlegend und ausschlaggebend beeinflusst haben. Zwischen den beiden Schichten hat die breiteste, aus den übrigen patentierbaren Erfindungen bestehende Schicht ihren Platz, worin sich oben die wesentlichen, aber nicht als bahnbrechende Erfindungen zu betrachtenden Patente und unten die das Maß der Patentfähigkeit gerade noch erreichenden Kombinationspatente sich befinden. Die kritische Grenzfläche liegt demnach zwischen der patentierbaren Erfindung und dem Gebrauchsmuster.

Das *„Pflichtkönnen"* des zur Prüfung der erfinderischen Tätigkeit in Anspruch genommenen Fachmanns ist mit dem Können des die Offenbarung der Erfindung prüfenden fiktiven Fachmanns *identisch*, das heißt mit ihrem technischen Können (das allumfassende Können des Fachgebiets auf dem Niveau eines Konstrukteurs) identisch.

Die *mit der Anmeldung verbundenen Kenntnisse* des zur Prüfung der erfinderischen Tätigkeit in Anspruch genommenen Fachmanns weichen allerdings von den Kenntnissen des Fachmanns ab, der mit der Prüfung der Offenbarung der Beschreibung der Erfindung betraut wird. Letzterer kennt die komplette Patentanmeldung inklusive alle Anlagen, weiterhin das (die) im Teil Stand der Technik angeführte(n) Dokument(e), *dem zur Prüfung der erfinderischen Tätigkeit in Anspruch genommenen Fachmann ist jedoch von der Anmeldung nur der Teil Stand der Technik zusammen mit dessen Beurteilung und das gesteckte Ziel bekannt,* er kennt aber auch sämtliche sonstigen, im Recherchenbericht benannten sowie im Laufe der eventuellen Verfahren einbezogenen sonstigen Dokumente. Vereinfacht kann man sagen, *die gegenständlichen Kenntnisse des zur Prüfung der erfinderischen Tätigkeit in Anspruch genommenen Fachmanns umfasst die einschließlich bis zum Tag der Priorität veröffentlichten Kenntnisse, während die Kenntnisse des mit der Prüfung der Offenbarung der Beschreibung der Erfindung betrauten Fachmanns, auch den Tag der Priorität inbegriffen, sich einen Tag weiter ausbreitet.*

Im Laufe der Prüfung werden die meisten Probleme durch das Fehlen der Schaffensbereitschaft, der Kombinationsfähigkeit des Fachmanns verursacht. Ein zu Schöpfungen unfähiger Fachmann, der nur zu Additionen fähig ist, ist auf jeden Fall eine Fiktion.

Im Falle von Einspruch und in den Verfahren gegen ein genehmigtes Patent werden die meisten Streitigkeiten rund um die Beurteilung des „Pflichtkönnens" des Fachmanns entfacht. Der Antragsteller ist, wenn er die Feststellung des Fehlens der erfinderischen Tätigkeit beantragt, bestrebt, das *Niveau des Könnens des Fachmanns so hoch wie möglich anzusetzen*. Bei einem Teil der Streitfälle ist der Antrag berechtigt, weil die Erteilung des Patents auf einem Irrtum beruhte. Ein bedeutender Teil der Anträge ist jedoch nicht auf die Aufhebung eines sich unrechtmäßig angeeigneten Rechts, sondern auf das Abdrängen eines Mitwettbewerbers ausgerichtet. Es steht in der Verantwortung der beurteilenden Behörden bzw. Gerichte, das in solchen Angelegenheiten zu verhindern und eine objektive Entscheidung zu fällen.

Ein typischer Fall für den unberechtigten Angriff gegen einen Mitwettbewerber ist es, wenn der Antrag auf die Mängel der Offenbarung und auf das Fehlen der erfinderischen Tätigkeit gleichzeitig begründet wird. Dazu, um die Mängel der Offenbarung zu beweisen, muss er nämlich nachweisen, dass im Anmeldungsverfahren das Niveau des „Pflichtkönnens" des Fachmanns zu *hoch* angesetzt wurde. Für den Nachweis des Fehlens der erfinderischen Tätigkeit hat er jedoch zu beweisen, dass das Niveau des „Pflichtkönnens" des Fachmanns zu niedrig festgelegt wurde.

Eine der in der Praxis oftmals vorkommenden fälschlichen Feststellungen ist, dass sie den Fachmann der erfinderischen Tätigkeit für fähig halten, auch den Abstand zwischen zwei voneinander bedeutend abweichenden Lösungen überbrücken zu können, weil er zum Beispiel von einer die Lösung einer völlig anderen Aufgabe darstellenden Abbildung, die der (ihm nicht bekannten) Abbildung der geprüften Anmeldung ähnlich ist, die laut der Erfindung vorliegende Lösung hat erkennen können. Dies bedarf – meinem Standpunkt zufolge – einer solchen Erkennungsfähigkeit, die nicht mehr als Routinearbeit betrachtet werden kann, das heißt *das „Pflichtkönnen" des Fachmanns wird überschätzt*.

Hier kann angeführt werden, dass die irrtümlich vorgebrachten Dokumente den Fachmann der Prüfung der erfinderischen Tätigkeit orientieren können, das heißt fördern können, dass eine Lösung, die als Schöpfung angesehen werden kann, als Routinetätigkeit aufscheint. Ein solcher Fall ist zum Beispiel das bereits erwähnte, auf einem anderen Gebiet sich auf die Lösung einer anderen Aufgabe beziehende Dokument, wo die Abbildung der Abbildung der geprüften Lösung „ähnlich" ist. Die Anforderung der Objektivität erwünscht es, dass der Fachmann nicht beeinflussbar sein soll. Es ist die

Verantwortung des Entscheidungsträgers, derartige Versuche im Laufe des Verfahrens herauszufiltern.

Der fiktive Fachmann für Patentrecht kann – prinzipiell – deshalb nicht orientiert werden, dass er nur das zu erkennen in der Lage ist, ob die gestellte Aufgabe im Sachbereich der Erfindung bzw. auf den nächstgelegenen verwandten Gebieten bereits gelöst wurde oder noch nicht, und wenn ja, auf welche Art und Weise, mit welchen Mitteln, oder ob er eine solche bekannte Lösung findet, von der man es sicher weiß, dass die gestellte Aufgabe mit deren Hilfe, höchstens mit einer sehr geringfügigen Abänderung gelöst werden kann.

Der Fachmann der erfinderischen Tätigkeit spielt also bei der richtigen Beurteilung der Grenzlinie zwischen der Übertragung und der Kombination im gegebenen Fall eine wichtige Rolle. Bei der Prüfung der erfinderischen Tätigkeit werden die meisten Fehler durch eine unterschiedliche Beurteilung der Ähnlichkeit verursacht. Hier kommt die Frage auf: kann das Ausmaß der Abweichung so geschätzt werden, dass aufgrund dessen das Bestehen oder Fehlen der erfinderischen Tätigkeit mit Hilfe des Fachmanns auf eine zuverlässigere Art und Weise als bisher festgestellt werden kann, das heißt die Schätzung mit Hilfe irgendeiner Ableitung bekräftigen?

Laut der Meinung des Verfassers ist bei der Prüfung vom Fachgebiet, von der Aufgabe und Lösung der im angeführten Dokument benannten Lösung auszugehen. In dem aufgrund des bei der Neuheitsprüfung angegebenen Dokuments entsprechend abgegrenzten Anspruch liegen solche Merkmale vor, die auch in der Anteriorität vorgefunden werden können und es gibt einen oder mehrere Merkmale, die im Vergleich zur Anteriorität als neu und schöpferisch betrachtet werden können. Anschließend kann es zur Entscheidung in der Frage der erfinderischen Tätigkeit kommen, hierbei wird ein solches Dokument (eventuell zwei Dokumente) geprüft, in welchem die Kombination des oder der neuen Merkmale des Anspruchs in identischer oder ähnlicher Form enthalten sind. Im Anschluss daran muss nur noch entschieden werden, ob der Fachmann in Kenntnis der Anteriorität der Neuheitsprüfung und der Anteriorität(en) der erfinderischen Tätigkeit in der Lage ist, die Möglichkeit einer zwischen dieser bestehenden Verbindung zu erkennen, das heißt ob diese Verbindung mit einer Übertragung die Lösung laut Erfindung zur Folge haben kann.

Für die Durchführung dieser Aufgabe muss festgestellt werden, *in mindestens wie vielen Schritten man von der im Dokument der erfinderischen Tätigkeit angeführten Lösung so zum Dokument der Neuheitsprüfung gelangen kann, dass wir das mit diesen Schritten zu der zu schützen gewünschten Lösung der in der geprüften Anmeldung oder im Patent gestellten Aufgabe umformen.*

Diese Methode kann eine Hilfe bei der Auswahl der neben der Anteriorität der Neuheitsprüfung vorliegenden zweiten Anteriorität sein, weil man von mehreren Dokumenten das auswählen kann, aus dem man über das Dokument der Neuheitsprüfung am leichtesten zur zu schützen gewünschten Lösung gelangt.

Die Schritte des Übergangs zwischen zwei technischen Lösungen können relativ leicht bestimmt werden. Diese Schritte sind an sich routineartige Schritte, verfügen jedoch im gegebenen Sachbereich über unterschiedliches Gewicht. Von den einfachen, überall in gleicher Form routineartigen Schritten (z. B. Übergang von einem Niederdrucksystem in einem Hochdrucksystem durch Änderung der Maße) ganz bis zu solchen Schritten, die vom Fachkreis für die Lösung der gestellten Aufgabe als ungeeignet, ja sogar als unmöglich gehalten werden (berufliche Vorurteile). Unter Berücksichtigung dieses Umstands kann bestimmt werden, welcher ein einfacher routineartiger bzw. ein patentrechtlich relevanter Schritt ist, und auch das Gewicht der einzelnen Schritte kann bewertet werden. Im Falle einer Lösung entgegen der erwähnten beruflichen Vorurteile kann sogar die Unterschiedlichkeit eines einzigen Merkmals zur Anerkennung der erfinderischen Tätigkeit ausreichend sein. Es kann auch vorkommen, dass einzelne Schritte nur eine Routinetätigkeit verdecken, zum Beispiel Änderung der Maße, so bedeuten sie in sich selbst, ja sogar auch in ihrer Gesamtheit eine konstrukteurartige Routinearbeit und geltend deshalb als Übertragung. Von diesen Ausnahmen abgesehen kann von einem zur Kombination unfähigen Fachmann das Anerkennen von mehr Unterschieden als ein-zwei Schritte nicht erwartet werden. Wir dürfen hier auch nicht vergessen, dass der die erfinderische Tätigkeit prüfende fiktive Fachmann die geprüfte Lösung nicht kennt. Das bedeutet, dass die Wahrscheinlichkeit dafür, dass der Fachmann im Falle einer größeren Anzahl von Schritten als die erwähnte minimale Schrittzahl zur geprüften Lösung kommt, sehr gering ist.

Ein umstrittener Punkt der Prüfung der erfinderischen Tätigkeit ist der Fall der Bezugnahme auf mehr als zwei Dokumente. Die einzelnen Schritte der Umgestaltung von einer technischen Lösung zu einer anderen technischen Lösung sind jeweils gesondert – von den Schritten gegen die bereits erwähnten beruflichen Vorurteile abgesehen – an sich selbst bekannte, zum „Pflichtkönnen" des Fachmanns gehörende Routineschritte. Das bedeutet, dass alle Schritte auf dem gegebenen oder verwandten Fachgebiet, in einem anderen technischen Umfeld separat vorhanden sind. Gerade deshalb ist es von Bedeutung, aufgrund wie vieler Dokumente von allen, in Frage kommenden Dokumenten die Prüfung durchgeführt werden kann bzw. muss.

Nun besteht die Frage, wie die Grenze gezogen werden kann, wo die Herleitung aus den zwei Dokumenten noch als Übertragung angesehen werden kann und wo die Kombination beginnt. Der einfachste ist der Fall, wo im Laufe der Prüfung der, von der bei der Neuheitsprüfung bestimmten nächstgelegenen Anteriorität gut abgegrenzten Lösung für die Feststellung des Bestehens der erfinderischen Tätigkeit sich auf verwandte Fachgebiete beziehende Dokumente hinzugezogen werden, in welchen für die Lösung einer identischen Aufgabe, in identischer Anordnung sämtliche neuen Merkmale des kennzeichnenden Teils vorgefunden werden. In diesem Fall liegt der Fall der Übertragung

vor, es sei denn, die erwähnten beruflichen Vorurteile haben bisher auf dem gegebenen Fachgebiet die gemeinsam mit den im Fachbereich aufgezählten Merkmale erfolgende Verwirklichung nicht behindert. Im Zusammenhang mit dem letztgenannten Fall muss auch darauf aufmerksam gemacht werden, dass die sog. beruflichen Vorurteile unterschiedlichen Ausmaßes sein können, also auch das ist kein eindeutiges Erscheinungsbild. Da der Fachmann *die Lösung nicht kennt,* muss auch geprüft werden, ob die Kenntnis der gestellten Aufgabe für die Anwendung der offenbarten ähnlichen Lösung als eine Art Übertragung ausreicht.

Wenn über die nächstliegende Anteriorität hinausgehend alle Merkmale des kennzeichnenden Teils nicht in einem, sondern in zwei Dokumenten vorliegen, muss auch der Umstand berücksichtigt werden, welche Verbindung zwischen dem Fachgebiet der zwei Dokumente, den gestellten Aufgaben besteht, ob vom fiktiven Fachmann für Patentrecht erwartet werden kann, dass er diese beiden Dokumente miteinander und mit der geprüften Lösung in einen Zusammenhang bringt. Im Extremfall ist die Kombination so vieler Merkmale im kennzeichnenden Teil angeführt, wie viele Dokumente notwendigerweise einbezogen werden müssen. Laut Standpunkt des Verfassers können unter Berücksichtigung der zur Umgestaltung erforderlichen Schritte die aufgezählten Probleme vermieden und leichter der Wahrheit näher kommende Entscheidungen getroffen werden.

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Der Verfasser ist sich darüber im Klaren, dass hinsichtlich der Inanspruchnahme des Fachmanns für Patentrecht sehr umfangreiche Literatur, die Darlegung veröffentlichter Rechtsfälle zur Verfügung steht und deren auf seinen praktischen Erfahrungen basierende Analyse auf nicht überall gleichermaßen auftretenden Erscheinungen fundiert. Neben der Rechtsharmonisierung betrachtet er jedoch auch die Harmonisierung des Verfahrensrechts für notwendig. Mit seiner Analyse möchte er dies fördern in Kenntnis des Fakts, dass sein Vorschlag ausreichende Gründe für eine Diskussion liefern kann. Er bringt seine Hoffnung zum Ausdruck, dass dieser kleine Artikel die Aufmerksamkeit der Kollegen weckt und als Synthese von Kritik sowie anderer Analysen eine solche verwendbare Lösung zustande kommt, die die gegenwärtig herrschende Unsicherheit zumindest vermindert, den bedeutenden Teil der oftmals völlig überflüssigen, zeitraubenden Streitigkeiten umgeht.

Comments to the article Filing date requirements under the EPC – filing by reference to a previously filed application by Cees Mulder and Derk Visser in epi Information 4/2010, p. 126ff.

H. Kley (CH); S. Frischknecht (CH)

First of all a big compliment to the authors Mulder and Visser for this analytic representation of an implementation of the Patent Law Treaty PLT. The intention of the PLT is (actually was) a harmonization of formal and material requirements, e.g. for a filing date. By the way a German or a French text of the PLT is available under *http://www.admin.ch/ch/d/sr/c0_232_141_2.html*.

However, we like to add the following comment to the last paragraph of this article. Even if the last paragraph doesn't express „never make a filing by reference", it suggests clearly, that filing by reference should not be a preferred option.

1. However, when filing a divisional application, we think it is highly advisable to use the offer of EPC R. 40(2) with a reference to the description and drawings of the parent application. By doing so, it is assured that the divisional not only fulfills EPC Art. 76 sentence 2 but also that the filed application has no deficiency regarding missing or wrong pages.
2. The EQE 2011 in part D1 question 5 deals also with filing by reference. At first glance, the answer must be NO, since „October 2009" does not represent a filing date of the previous application in the meaning of R. 40(2) but a period of a whole month. However with the means of information technology the answer can easily and legally correctly turned into YES. In a discussion H. Kley's colleague Didier Capré presented a simple solution, since a representative is obliged to say YES vis-à-vis his client:
   File 31 indications that a European patent is sought (R. 40(1)a) with the filing by reference technique (R. 40(1)c) and R. 40(2)), the indications contain subsequently the dates 01.10.2009, 02.10.2009 and so on until 31.10.2009 as the possible filing date of the previously filed application. When the applicant (see Q5 Part D1 EQE 2011) is back from his holidays you may ask him about the correct filing date of the previously filed application. Then take the indication/ filing with the corresponding filing date of the pre-

viously filed application and fulfill the further requirements of R. 40(3) and pay the fees within the 1-month term (R. 38). It is not a question of transmission technology but simply of intelligent telecommunication.

3. By the way, in May 2011 H. Kley expects a decision for grant of a European Patent. The corresponding divisional application was filed by SMS on August 1, 2008; Patent N° is EP 2 040 225 B1.

Priority Applications as Prior Art

A. Kennington[1] (GB)

In epi Information 4/2010, pages 133 and 134, M. Rots raises the problem of a claim not being entitled to priority and then lacking novelty over the publication of the priority document. She asks whether the EPO could adopt a practice that the content of an earlier application, whose priority is claimed, is not allowed to become part of the state of the art (obviously, only in the case that the publication of the content of the earlier application is after the filing date of the earlier application).

I think that the answer is provided by Enlarged Board of Appeal opinion G3/93. The conclusions of the Enlarged Board in that case were as follows:

1. *A document published during the priority interval, the technical contents of which correspond to that of the priority document, constitutes prior art citable under Article 54(2) EPC against a European patent application claiming that priority, to the extent such priority is not validly claimed.*
2. *This also applies if a claim to priority is invalid due to the fact that the priority document, and the subsequent European application, do not concern the same invention because the European application claims subject-matter not disclosed in the priority document.*

Thus, if a claim is obvious over the content of the priority document, but is not disclosed in the priority document, and the content of priority document has been disclosed between the priority date and the filing date, the claim is not entitled to the priority date and is invalidated by that publication even though priority is claimed.

It might be thought that the Enlarged Board opinion is not fully consistent with Article 4B of the Paris Convention, part of which states

> *Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention*

However, the Enlarged Board apparently based its conclusion on the reference to „the same invention" in Article 87(1) EPC, and on the following observation concerning the Paris Convention (taken from part 5 of the Opinion):

> *It is generally held that the subsequent filing must concern the same subject- matter as the first filing on which the right of priority is based [cf. R. Wieczorek, Die Unionspriorität im Patentrecht, Köln, Berlin, Bonn, München 1975, p. 149; G.H.C. Bodenhausen, Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967, Geneva 1968, at Article 4, Section A(1), sub (i)].*

The practical effect of this decision is unfortunate. In the 1980s it was normal to advise a client that once a patent application had been filed it was safe to disclose the contents of the application. Such advice could no longer be given after G3/93. Since that decision it is necessary to advise clients that, if there is a possibility that later applications claiming priority from an initial application will include modifications of the invention disclosed in the initial application, they should keep the content of the initial patent application secret until all those later applications have been filed. This creates a particular problem for a client who needs to disclose his invention to a venture capitalist in order to obtain the funds to pay for patent applications in other countries, since such venture capitalists will not normally accept a disclosure in confidence. However, unless the Enlarged Board can be persuaded to overturn its own earlier decision, I do not think that the approach proposed by Ms Rots is possible.

It is also worth remembering that a similar situation can arise with divisional applications even if the priority application was not published before the filing date of the parent application. If the parent application discloses an invention that is not entitled to the priority date, this can initially be claimed without any problem. However, as soon as a divisional application is filed and published, the contents of the priority application become prior art for novelty purposes against such a claim, owing to Article 54(3) EPC. This arises because each of the parent and divisional applications becomes an „application of earlier filing date" under Article 54(3), in respect of the contents of the priority application, with respect to a claim in the other application that is not entitled to the priority date.

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The „problem-solution-approach" set forth

S. Kulhavy (CH)

In epi-Information 3, 1994, 95ff, G. Knesch looks into the very well known method for the assessment of the inventive step, named „problem-solution-approach". On page 95 he recites the following structure of this approach:

1) The most relevant prior art in that particular case has to be defined. Then it has to be evaluated what are the differences between the subject matter claimed and that most relevant prior art.
2) Now the objective problem has to be defined. Furthermore it has to be clear that this problem is really solved by the invention.
3) In the final stage, the following question has to be answered: Starting from the most relevant prior art, was it obvious to implement the differences identified in stage (1), in order to provide a solution to the objective problem (2)?

In the following, Knesch then deals with the details of this assessment method. These explanations comprise some less understandable or even uncertain sections some of them will be here in the following analyzed.

According to Knesch "two kinds of documents can be provided by the search: in the first one a very similar structure is disclosed, but with different properties; the second one shows a different structure, but with very similar properties. In such a case, the second document would normally be considered as being the closest prior art."

In most cases, the invention is a thing (product, apparatus and so on) or a process. These are characterized by their structural features. The inventor added some structural features to a thing or process already known. For these reasons, only the first of said kinds of documents of the pertinent prior art can be considered as the closest document of the pertinent prior art. Knesch calls this approach „structure-oriented" approach where the emphasis is on similarities or equivalences. Consequently, the highest number of common features qualifies a document of the pertinent prior as to be the closest document.

Knesch poses a crucial question (page 96), „whether the man skilled in the art would really have chosen that document as starting point." This is no question. It is the fact that such a document was revealed in the course of the search in the prior art, even independently of the man skilled in the art and independently of the inventor.

„Therefore the problem must be derivable from this state of the art." (Knesch, p. 96). This is one of the crucial difficulties of the „problem-solution-approach" used up to now. In the most cases, the subject matter of the closest document has nothing to do with the subject matter of an examined patent application. This for the reason, that such closest document was published years ago prior to the filing of the examined patent application. Consequently, it is impossible to derive the problem to be solved in the examined case solely from the closest document, i.e. without having any regard to the examined case.

Starting from this point, the description of the „problem-solution-approach" used up to now is replete with uncertainties and unclear passages. Instead of discussing such uncertainties and unclear passages, it is better to describe a method for the assessment of the inventive step that is free of said faults.

Said method for the assessment of the inventive step resides on the notice of the author of this article, that *new* solutions of a technical problem, which are usually considered as obvious and which are therefore not patentable, are „too" simple. Therefore, he defined what is an obvious *new* solution of a technical problem. Because such solutions are simple, said definition is possible and it is also simple. On page 125 of the book „Erfindungs- und Patentlehre", Carl Heymanns Verlag KG, 2010, written by the author of the present article, said definition is recited. This definition is also recited under point 7 of the following list of steps. In the past, a great number of attempts was made to define what is the invention. All such attempts were without success.

If an examined *new* solution of a technical problem cannot be subordinated under the definition of an obvious solution, then such *new* solution is not obvious. Consequently, such *new* solution involves an inventive step and it is an invention. To this kind of the decision see the following provisions of the European Patent Convention (EPC). Sentence 1 in Article 56 EPC reads s follows:

„An invention shall be considered as involving an inventive step if, having regard to the state of the art, it *is not obvious* to a person skilled in the art."

Article 52, Sec. 1 EPC reads as follows:

„European patents shall be granted for any inventions, … … provided that they are new, involve an inventive step and are susceptible of industrial application."

There is a number of kinds of inventions. *But there is only one kind of obvious new solution of a technical problem.* Consequently, it is enough, to define what is an obvious solution when we will examine inventions. Based on the alternative defined and underlined here in the recitation of Article 56 EPC, the use of the definition of an obvious new solution reveals or encompasses automatically all kinds of inventions. Therefore the examiners need not to look at what kind the invention could be, when they decide, based on the definition of an obvious solution, that a new solution of a technical problem is an invention. For granting a patent it is not necessary to know of which kind the invention to

be patented is, because for all kinds of inventions patents are granted having the same legal effects.

For the examination of patent applications, the examiners have only to consider that the new solution of a technical problem defined in the main claim does not fall under the definition of an obvious solution. It is well known, that one of the most important duties of a Patent Office is to prevent that obvious solutions of technical problems will be patented. Also for this reason it is very useful for the Patent Offices, for the examiners and for the patent attorneys that they know as precisely as possible what must be considered as an obvious solution of a technical problem.

There is a list of steps, which an examiner or a patent attorney has to carry out when he is examining the subject matter of a patent application. This list of steps is a refining of the list called „problem-solution-approach" and used up to now. The capital letters in the following list denote the examples of examined cases in said book „Erfindungs- und Patentlehre".

For carrying out the above said assessment, the following steps have to be made:

1. For the solution of a problem to be patented, a novelty search in the pertinent prior art is carried out.
2. That one of the documents mentioned in the search report will be considered as the closest document of the pertinent prior art, the subject matter of which has the most features common with the examined solution.
3. If any, the difference between the solution to be patented and the subject matter of said closest document of the pertinent prior art will be elaborated and drafted. A solution, which shows any kind of difference, is considered as new.
4. Said difference is defined in the characterizing portion of a two part claim.
   The characterizing portion of the two part claim defines a technical means for solving a technical problem.
5. Said technical means is used on a place (thing or process) which is defined in the introductory portion of the same two part claim.
6. With the aid of a definition of a solution, which is considered as obvious, it will be examined whether said difference results from the pertinent prior art in an obvious manner or not. To this end, an attempt is made, to subordinate said difference, i.e. said technical means under said definition. This process of subordination is well known in logic.
7. The definition of a new solution which resulted in an obvious manner from the pertinent prior art reads as follows: „A new solution, which resulted in an obvious manner from the pertinent prior art is a solution, which uses a known technical means based on the ability of this known technical means to bring forth a technical effect which was with this known technical means already known in the pertinent prior art."
8. If the examined new solution falls under this definition of an obvious solution, then the examined new solution resulted in an obvious manner from the pertinent prior art. Such a new solution is not an invention. (See the examples A, G and M in the book of Sava Kulhavy: „Erfindungs- und Patentlehre").
9. If the examined new solution *does not fall* under the definition of an obvious solution, then this examined new solution *resulted not in an obvious* manner from the pertinent prior art. Such new solution involves an inventive step and therefore such new solution is an invention. In this case there are two possibilities:

9a. The examined new solution does not fall under the definition of an obvious solution because the used technical means was new, i.e. not known with respect to the pertinent art. Such an invention is a combination invention. (See the examples B, D, E, K, N and R in said book.)

9b. The examined new solution does not fall under the definition of an obvious solution because the used technical means, although it was already known, was used for solving the given problem based on the ability of this known technical means to bring forth a technical effect which was with this known technical means not yet known in the pertinent prior art. Such an invention is a so called use invention. (See the examples C, F, H and R in said book.)

As the present method is precise and as it is very simple and very reliable, it is suitable for use by a great number of the examiners and for a *not* time consuming treatment of a huge number of patent applications. Besides, such kind of the examination of patent applications is congruent not only with the provisions of EPC but also with Article 33, Sec. 1 and 3 PCT. Consequently, the present method can be used throughout the world.

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