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

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

12 February 2021

Report

Technical Meeting epi – DG1

Date: Friday, 12 February 2021

Time: General Session 09 :00 – 12 :00 hrs CET

Thematic Sessions 13:00 – 15:00 CET

Venue: Videoconference via MS Teams

1. General Session

Lead EPO: Steve Rowan

1.1 Oral Proceedings and Covid

John Beatty presented a 2021 outlook. Around 900 oral proceedings had been held in 2019 by vico (examination only). In 2020: 2316 in examination, 333 in opposition.

So far in 2021: 434 in oppo, 768 in examination, 124 in appeal (total 1326).

Last week only: 217 in total (96 opposition, 81 in opposition, 40 in appeal).

Planned this week: 325 in total (119 opposition, 152 in examination, 54 in appeal).

New oral proceedings calendar has been made available on the EPO website, which is updated every single day. If it does not work, cache of browser has to be cleared.

Newly introduced feedback questionnaire e-Form with 19 questions has been introduced; attendees of OP are asked to provide this feedback on their experience.

Opposition stock is expected to get down again to about 5700 by end of 2021.

Changes to R 117 and 118 EPC (OJ EPO 2020, A132) re taking of evidence by videoconference, in force since 1 January 2021. First witness hearings have been already successfully conducted. Inspection of an object may also be ordered and carried out by videoconference (unless haptic feeling etc. is important).

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Jim Boff asked whether the numbers of OP show a change of behaviour, i.e. maybe more oral proceedings because traveling is no longer needed. John Beatty does not have the impression that users' behaviour has changed. Steve Rowan does not expect overall numbers of OPs being changed.

Heike Vogelsang-Wenke asked whether the questionnaire includes the question whether the participant would prefer videoconferencing or in-person hearings after the pandemic. Cutting a long answer short, Steve Rowan said, no, it is currently not.

Martin Wilming asked whether the video equipment on the EPO side could be set up in a way that persons do not disappear half-way or totally dive away when reading documents on the table / besides the screen / camera. John Beatty answered that they will look into that. Heike Vogelsang-Wenke asked whether it would be possible to show the whole upper body of the members for us to realize whether they take notes. Razi Menidjel added that we can be assured that the ED or OD is fully dedicated to the case at all times during the hearing.

Attending as member of the public: John Beatty referred to the FAQs on the EPO website how to e.g. make sure that the right name appears on Zoom, etc.

John Beatty mentioned that the EPO might provide details about the security agreement in place with Zoom in the near future.

1.2 Interpretation, clarity and sufficiency

Agenda: *"The role of the skilled person and of common general knowledge. There is a perception that the Boards of Appeal are more generous as the first instance."*

John Beatty presents a PPT. Setting the background: The skilled person as well as the basics of sufficiency is outlined in the GL F-II 4.1. He also gave a quick outline of what the Guidelines say on clarity, including functional features.

Michael Fleuchaus asks where the EPO's emphasis and overrated desire for clarity stems from. An extensive discussion circled around overwhelming numbers of clarity objections in office actions without diving into the subject-matter of the invention on the merits. Peter Bittner, Martin Wilming, Arndt-Christian Dürr, Jim Boff (the examiner should carefully who the skilled person is before addressing the meaning of terms at all), Valérie [n/a] took the floor.

Roberta Romano-Götsch mentioned training efforts internally, and that they would welcome feedback about the outcome therof in practice. Balancing the written opinion with the search report is currently under consideration at the EPO. They are looking into how to establish a digital

interaction with the applicant as early as possible. Razik Menidjel firmly rebutted that clarity objections are used to avoid work on the merits; but he supported that examiners should not stop at Art. 84, with the exception of very special cases.

John Beatty mentioned that we should give feedback whether anything in the GL should / could be improved.

1.3 Effect of new RoPBA

Agenda: *"Has the introduction of the new RoPBA had any adverse effects on the proceedings in DG1"*

John Beatty presents a PPT. Files with auxiliary request are increasing (steady trend); 2014: 42%, 2019: 54,7%, which is apparently not an effect of the RoPBA. However, in "specific situations" there are far more requests filed (based on feedback from EDs and ODs).

Chris Mercer mentioned that requests for correction of minutes might be on the rise(?). John Beatty replied that there is no such trend on a general level.

Jim Boff asked whether the EPO has seen an increase in divisional applications filed by applicants / opponents to prevent trouble at BoA level.

1.4 Search reports and examination reports lacking reasoned objections

Agenda: *"Are the requirements set out in T 697/17 not being followed?"*

Laura Smith-Hewitt found this question kind of provocative. There is a new section in the GL on how to assess technicality of features, in G-II 3.6.4 (coming into force on 1 March 2021, available as unedited version already now on the EPO website).

The CII group in the EPO is kind of pioneering the way how examiners are exchanging internally and learning from each other (meetings, electronic platforms, workshops, etc.), in a "community of practice".

Grant Philpott mentioned that the inclusion into the Guidelines was made to make the same approach mandatory for the whole body of examiners. There has been an enormous effort by the office over the past five years in this respect.

1.5 Providing input to DG1 – feedback not complaint etc.

Niclas Morey gave a quick overview of what the EPO does in this respect.

Complaints: 347 in 2020 (37% HBC, 18% ICT, 23% M&M, 21% NA).

Substantive issues: 141; Formal issues: 80; Feedback: 69 (not being replied to); Other: 84.

49% come from private complainants. 56% of complaints justified or partially justified (this is the share where they can actually act on)

30% of private complaints are justified or partially; 80% of complaints from professional representative are justified or partially justified.

Number of complaints pretty constant over the years.

Commonly heard feedback: Complete search reports; please pick up the phone; complete communications; objections should be clear; more suggestions to overcome objections; avoid over-formalistic approach to A 82, 84, 123(2); R 71(3); costs.

Improvements initiated upon Feeback:

- Coverage of dependent claims in SR
- Additional citations brought forward only during examination
- EPO response to Art. 94(3) communications: Below 4M
- Mistakes in the text proposed for grant (DREX)
- Learning from opposition outcomes

USS programme 2020/2021:

Completed already are EPO website; Filing behaviour & Covid-19; Pre-filing, filing, search services.

Now ongoing: Customer services; examination services, final actions, publication

Top-level findings expected end of April. Final reports expected in June, before AC/167.

Martin Wilming mentioned that external service provider had contacted applicants of still unpublished patent applications. Niclas Morey clarified that this has been addressed and should not happen anymore, and assured that only very little bibliographic information had been shared.

Chris Mercer mentioned that a better channel for positive feedback is awaited. The EPO is apparently looking into that right now.

1.6 Colour documents

John Beatty gave a quick PPT. IT transformation under SP2023 is tackling colour drawings. Also being addressed at IP5 level.

EPO already accepts applications with colour drawings and keeps record of such filings, and they form part of the application as filed. However, they are formally deficient in view of the Rules that require b/w drawings. Applicant is invited to re-file in b/w. At the EPO, one may ask the formalities officer to provide copies of the original colour filing.

Manolis Samuelidis mentioned that it is not possible to upload colour documents when filing PCT applications.

Steve Rowan mentioned that they are working on a user environment (ambitiously aiming at July 2021(!)), not any more reflecting old-times postal system, kind of collaborative workspace.

Nicolas Morey added (later, in the wrap-up session) that online filing of colour documents is possible technically, but will be converted to b/w.

1.7 EU Commission IP Action Plan

Agenda: *"Any views of the EPO on that? Direct/indirect impacts for EPO foreseen?"*

Michal Fröhlich mentioned that the EPO had been involved in the preparatory work of the IP action plan.

As to SPCs, the EU had made clear already back in 2015 that a unified SPC is being aimed at. The EPO is being aimed at handling the unified SPC by interested circles. And, in principle, the EPO "could" be interested in doing so. But the issue is "premature". Before, it should be clarified that SPCs are available for Unitary Patents.

1.8 Third party observations (not on the provisional agenda)

Suzanne Herrera presented a deeper dive into the numbers. 2020: 1561. There was a peak in 2018, with a slight decrease since then.

The likelihood of opposition is more than 10 times higher in files where TPOs occurred.

The grant rate is higher(!) in files with (82%) compared to files without TPO (70%).

Focus on NPL in TPOs: 36% in TPOs, only 15% in EPO Search Reports.

A TPO causes amendments in half of the cases.

Increase in non-anonymous TPO, because then the docket is treated under the PACE regime.

TPOs filed by representatives are considered non-anonymous.

2. Thematic Sessions

Actually, it was a joint session of HBC, Biotech, Pharma and Chemistry, out of a sudden.

Introduction by Roberta Romano-Götsch and Anne Reedijk.

The EPO prepared presentations on each topic, to kick-off the discussion.

2.1 Biotech Session, item 1.1 on the provisional agenda

Agenda: *"Patentability of antibodies. General patentability (and also unity?)"*

Aliki Nichogiannopoulou quickly introduced the commercial importance of antibodies, which finally is reflected by G-II 5.6 incorporated in the Guidelines. This does not imply any change in practice, which is already a decade old. "Written confirmation" of established practice.

Office-wide E-learning module will be launched in the next weeks re unity / incomplete search re antibodies.

From the Chat:

> John Beatty: Re: is it right that we will have an opportunity to comments new guidelines during 6 weeks after the publication (starting from March 1st)?: Yes - there will be a an 6 week opportunity to provide input on the GL. This input will be reviewed and then discussed in the SACEPO Working Party Guidelines that takes place normally in May. Following the meeting, the Office will work on the revision topics and then present them for the second SACEPO WP GL in the autumn. This second meeting offers the opportunity for further fine tuning of texts and introduction of any essential procedural developments since the first meeting.

2.2 Biotech Session, item 1.2 on the provisional agenda

Agenda: *"Patentability of plants and animals following on from G3/19"*

Aliki Nichogiannopoulou quickly summarized the outcome of G 3/19. As a reminder, G 2/07, G 1/08 and G 1/98 are explicitly confirmed by the EBoA.

Stay of proceedings has been lifted and affected cases are gradually being resumed. Revised draft of the relevant parts of the GL have been prepared.

EPO continues to practice based on R 28(2) EPC implemented per 1 July 2017, applicable to EP application filed on or after 1 July 2017 and not claiming a valid earlier priority date (applies to about 320 applications and 10 opposition cases).

The so-called "disclaimer solution" continues to apply. When, in theory, a species could be obtained by essentially biological processes, a disclaimer is mandatory. Jan Desomer and Martin Wilming asked for the level of proof of what "in theory" could happen? Even a most unlikely event could happen in theory. The situation will be clear with an isolated point mutation; and it will be clear with transgenic variants. But what about a certain number or mutations in a molecule, say 5 or 10?

From the Chat:

> Alikio Nichogiannopoulou: @ Martin, this is a q addressed at the person skilled in the art. If this notional person, based on common general knowledge at the relevant filing date would be certain that the claimed "multi-mutant" would never occur in nature, bcs this would violate generally acceptable laws of nature, then the disclaimer would not be necessary. If this were not the case, the disclaimer would be necessary.

2.3 Biotech Session, item 1.3 on the provisional agenda

Agenda: *"Homology, identity and similarity"*

Sönke Holthoff gave a quick overview of the GL, F-IV 4.24. Beware: If no algorithm or calculation is given in the application as filed, examiner will take the broadest possible approach. EPO recommends the term "identity" for both amino and nucleic acid sequences.

2.3a Amendments to the description, not on the provisional agenda

Brought in on short notice by Biotech committee; Simon Wright asked for basis and justification for requiring more and more amendments to the specification, in particular with R 71(3) communications.

Mark Weaver explained that an internal procedural instruction had been sent out last year, which might have been interpreted by some to be more stricter than what had been in place before. This was not intended.

2.4 Pharma Session, item 2.1 on the provisional agenda

Agenda: *"Clinical trials / inventive step; plausibility of data"*

Thomas Eijkenboom gave a quick overview (PPT) of how they approach clinical trial data (and prior disclosure thereof) in the assessment of novelty. Ongoing clinical trial is not prejudicial to novelty in particular if no conclusion can be drawn about the actual existence of an effect (non-enabling disclosure). But: In the absence of any data in the application and compared to the disclosure of the same "therapeutic application" by way of the clinical trials, an application may well fail for lack of novelty. It is recommended to include a "new element" vis-à-vis the prior disclosure.

Martin Wilming presented the situation (originally prepared by Jaap Mannaerts who could not make it to the meeting) where results from clinical trials are in fact needed for an applicant to make any effect plausible. In these cases, the application will post-date the publication of the clinical trial protocol. There is a line of case-law of the Boards along the lines that the mere publication of the protocol provides reasonable expectation of success to reduce it to practice, and that whatever is found along this path is merely a bonus-effect.

Stephen Piling replied that this case-law is being watched, but not currently being followed. When a prior art document is found non-enabling, they do not currently take it as closest prior art.

From the Chat:

> Denise Nestle-Nguyen: Maybe someone could comment on T 184/16, which was cited newly as a relevant decision in the Case Law Book reg. sufficiency of disclosure. As shown in the presentation, some sort of evidence has to be contained in the application to take the hurdle of Art. 83. So I was surprised that in T 184/16, the BoA took the opposite approach, basically saying that this it is *not implausible* that the effect is achieved, post-published data can be taken into account both for Art. 83 and 56. In case of further medical use claims (dosage regimen, patient group etc) it seems to be always plausible that a further, more specific treatment will show efficacy. So Art. 83 would then be fulfilled per default ...
>
> Stephen Pilling: yes although art 83 is the default issue of a medical use claim is not supported by data or reasoning once basic plausibility is established then inventive step may also be an issue in the event that the invention relies on an alleged improvement. It's quite a complex question.

2.5 Pharma Session, item 2.2 on the agenda

Agenda: *"Multiple convergent/non-convergent lists, selection inventions, ranges (GL and T1621/16)"*

Sjoerd Hoekstra gave a quick presentation of ranges and selection in the GL, G-VI (amended November 2019). Change in practice with immediate effect.

Overlapping ranges: practice unchanged.

Multiple selections: B-VI ((i) is unamended. The EPO will apply T 1621/16 in the future, be taken up in the next revision of the GL.

Jim Boff raised doubts as to whether the two lists principle in general makes much sense. It should rather only count what the skilled person would understand from the disclosure as it is.

2.6 Chemistry Session, item 3.1 on the agenda

Agenda: *"Inventive step, alternatives"*

Mark Weaver explains that an improvement over the prior art makes an inventive step more likely.

3. Plenary session – wrap-up

Both EPO and epi emphasized great appreciation of the open exchange. "Some fog has lifted, other fog remains". epi thanks for the dialogue on a regular basis, and hopes that epi input is deemed useful (which Steve Rowan confirmed).

/ MW