

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

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Editorial

T. Johnson (GB)

This year marks the centenary of the start of the Great War, the end of that war being marked this month, November, as I write this. Pat Barker memorably wrote about the war in her novel *Regeneration*. The word 'regeneration' is loosely defined as rebirth or, more meaningfully for patent attorneys, renewal. As our readers will know, our Council is concerned that our Institute continues to increase its relevance and importance to stakeholders using the patent system both in Europe and abroad, while not forgetting the benefit membership brings to our members. A group of members has been set up to look into this. I am confident that our Institute does not need a rebirth or renewal as such, but the current period is an important one as we move on, not least with the unitary patent system and commensurate Court system soon to be up and running, both of which will have a significant impact on all

stakeholders in the system. It is important therefore that our Institute continues to play a constructive and energetic role in the development of these systems which will effectively lead to a regeneration of the patent system in Europe.

As members will also know, in electronics 'regeneration' has the meaning of the use of positive feedback, in the sense of increasing the amplification of a radio frequency stage. We would be glad to hear from members who can provide positive feedback on how the Institute might continue for the benefit of all stakeholders.

This issue being the last one in 2014, there is another opportunity for reflection and regeneration as we move into a New Year. We take this opportunity of wishing all our readers a Happy Holiday Season and a fruitful 2015.

Report from the 77th Council Meeting

The 77th Council meeting brought together about 130 patent attorneys from the 38 member states. Under the good guidance of the President, the Council discussed the household of the Institute and the ongoing process to bring the Institute to a higher level of professionalism. The bookkeeping was improved so as to make the financial situation more transparent. Importantly, the Institute has in the past years increased its staff for making committees more efficient. In relation thereto, the Institute has rented more space within its building. The Council agreed with the proposed budget in 2015.

A major area of improvement is still the website and the information provided to all **epi** members on the ongoing activities of the **epi** in the field of education and statements made on behalf of the **epi** by the various committees. This was stressed also in relation to the outcome of the questionnaire sent out by the **epi** Reform Group. One of the decisions made in this respect is to convert the **epi** Information into a digital publication. This process will take place from 2016.

In view of the increased staff and budget, a first discussion took place on an increase of the membership fee. A decision on an increase of the membership fee starting in 2016 will be made at the next Council meeting. It seems that a higher membership fee than the current EUR 160 per member is feasible, but that the members should be made more aware of the activities and the benefits.

The **epi** Reform Group

Mr Durán Moya presented, as chair of the **epi** Reform Group, the results of the questionnaire sent out to **epi** members and gave several recommendations. He was happy to state that 20 % of the **epi** members had filled in the questionnaire. The results demonstrated that **epi** is less visible than desired, and that its function as a lobby organisation should be increased. As to the **epi** Information, highly desired were contributions on articles on the European Patent Practice and any developments in relation to European Patent Law. Mr Durán Moya concluded that the current suggestions are not radical and asked the Council to continue the work in the **epi** Reform Group up to the next Council meeting. A more detailed report will be presented in a future issue of the **epi** Information. The Council approved the drawing-up of a Communication plan and actions on how to improve the provision of information to members.

Professional Education

The Professional Education Committee (PEC) presented the progress on the cooperation between the **epi** and the EPO (particularly the Academy) in the organisation of seminars and the financial arrangements thereof. This is a positive development. It not only allows better information to the **epi** members on the EPO educational activities, but also provides the opportunity for both EPO

staff and **epi** members to be invited as speakers at conferences. For 2015, the following conferences are planned:

- on the Unified Patent Court (UPC)
- on added matter (Art. 123(2) EPC)
- on Opposition and Appeal

These conferences will be held more than once in various locations throughout Europe.

In addition, the **epi** will be responsible for exam preparation.

An important proposal was to merge the fee for pre-registration for the exam into the **epi** student membership fee.

European Patent Practice

Mr Leyder presented several activities of the Committee, in relation to the UPC, to PCT and an annual meeting with the Board of Appeal.

He obtained approval to present a paper to the Board of Appeal to slightly revise Article 12(4) of the Rules of Procedures, for better legal security, wherein the word 'could' in 'could have been submitted earlier' is to be replaced by 'should'. In relation thereto, an important observation was made on the point how to deal with documents that were not admitted into the proceedings by the first instance (i.e. opposition). Here the Board replied that non-admittance should be addressed in the Grounds of Appeal.

Mr Leyder further will send a paper to the Enlarged Board to request that at least one external member is involved in the Review Procedure so as to create greater independence (in view of R17/12). In fact, Mr Leyder pointed there out that the review is currently a review between peers, i.e. of chairmen of Boards of Appeal.

Litigation and Other Committees

Mr Casalonga presented a draft **epi** paper in relation to the four Rules of the Unitary Patent Regulation, to be discussed in a hearing at the end of November. Mr Casalonga made a number of useful observations on Rule 5 on the Opt Out, so that the process is clarified. As to Rule 14 on the language, Mr Casalonga proposed removal of the draft Rule 14(2)(c), in view of the created complexity. He further would specify comments to the Rule 286(1) on representation.

Ms De Clercq gave an overview of developments in the field of biotechnology. Most important is that the **epi** Legal Advisor has coordinated the generation of a summary of the national laws on plants.

Changes to the EQE

Ms Leissler-Gerstl mentioned that the Supervisory Board decided to change the A/B paper in the sense that the distinction between electromechanics and chemistry is given up. Mr Tangena added that this is a decision made

by EPO already. He would have preferred that the proposal had been discussed first in Council. Thereafter, the Council expressed its surprise and many members expressed their disagreement. In the exchange, it became clear that the arguments in favour of this change are that there are many subfields, and that the A/B paper does not test technical knowledge. The counterarguments are however that there are two main areas: electronics, mechanics and software on the one hand and chemistry and biotechnology on the other hand. Furthermore, the exam is not for lawyers, but for candidates with technical or scientific background.

Ms Leissler-Gerstl reported that there are further plans to revise the EQE. A first proposal is a multiple choice exam. The Council strongly opposed multiple choice for several reasons. Some of those arguments are that multiple choice testing is merely knowledge testing rather than skills. It was further observed that making good multiple choice exams is extremely time-consuming, and that it is not representative of the work in the profession. Furthermore, it could be harmful to reputation of the examination.

A second proposal is that a paper be marked by one examiner rather than by two examiners, as currently. It was observed that two examiners are certainly desired for training new examiners and in situations which are

close to the pass/fail limit (i. e. between 40–60 marks). Another view was that a second marker is anyhow needed, because even a first marker's view of clearly fail or pass may not be right. Also a single marker might lead to more appeals. Furthermore, half of the examiners are EPO staff, and the other half are patent attorneys. It would not be appropriate for exams to be reviewed by a single marker who is not part of the profession. Particularly, the **epi** members who have been markers expressed that they found that two markers are indispensable. The overall view was therefore in favour of two markers.

Further proposals were discussed to increase the pass rate. They are all intended to motivate people to prepare appropriately. Proposals were limiting the number of sittings, a limited validity of passed papers, fee increase for resitting. It was observed that there is no good data provided by the EPO, so it would be hard to make useful comments. It was further observed that it was not clear what the effect has been of the changes to the EQE of five years ago. One comment made was that candidates that need to resit often have a specific problem that they do not discover. If a higher fee were requested, it should therefore be used to provide training and support. The Council rejected with a big majority any such proposal that would restrict the options of candidates.

Reform of the European Patent Institute (**epi**) Report of the Reporting group on the reform of **epi**

L.-A. Durán (ES), Chair

The Council of **epi**, in its meeting in Munich on April 28–29, 2014 decided to set up a Reporting Group in order to review the structure, organisation and functioning of the Institute and submit proposals for improvement.

Said Reporting Group has been working for the last 6 months. In order to prepare proposals for reform, it was very important, in the view of the Group to have the opinion of the **epi** membership, and accordingly, a questionnaire was prepared that was launched on June 18, 2014 and was open for reply for more than a month.

The participation rate was quite positive and reached nearly 20% of the membership. A report about the result of the survey can be found at the **epi** website.

The Reporting Group looked at the results of the survey and decided to prepare a first set of suggestions for reform deriving from the replies received.

These proposals were presented to the Board at its meeting of September 27, 2014 in Zagreb and to the Council at its meeting in Milan last November 15, 2014.

The Council has decided to approve and implement most of the proposals for reform suggested. Some of these proposals are the following:

a) To request candidates to election for the Council to reply to a questionnaire with information to be sent to **epi** membership so they would know who is who before voting.

b) To send reminders for voting at the time of the election and to check the technical problems reported by members in the electronic process.

c) To review the **epi** website to make it more user friendly and to incorporate more and better information.

d) To increase the number of articles in the publication **epi** Information and to add English abstracts to facilitate reading.

e) To organize a half a day seminar in combination with Council Meetings, open to all members and particularly to members residing in the location of the meeting or its neighborhood.

f) To organize joint meetings in cooperation with national associations of different member states.

g) To attempt to be involved, at an earlier stage, on EPO legislative proceedings to become more impactful.

h) To build up and establish with official organizations other than EPO as well as with other IP NGO's.

i) To install a tool to collect and centrally track member requests and proposals.

j) To create and update an email database of members.

It was also decided that the Reporting Group should continue the study of proposals for reform, particularly in the area of structure, organization and functioning, to improve efficiency.

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

Report of the By-Laws Committee (BLC)

P. Moutard (FR), Chair

Since the Council meeting in Munich (C 76) several questions were referred to the BLC. A meeting was organized on October 16 for final discussions and decisions on these issues and also to decide further amendments of the By-Laws (BL).

Participants to this meeting were Pascal Moutard (Chair), Terry Johnson, Paolo Gerli, Martin Forsthuber, María Oliete Ballester (**epi** Secretariat), Vernessa Pröll (**epi** Secretariat).

The agenda was the following one:

1. New Belgian Council members after resignation of a Belgian Council representative
2. Electronic voting for elections in Council.
3. Art. 18.2, 4th §, A. 18.3 and A. 50 By-Laws.
4. Art. 51 By-Laws.
5. Budget and Financial reporting process for committees.
6. Further amendments to the By-Laws (**epi** 3.1.1)
7. Other issues

All amendments to the By-Laws (BL) discussed below are incorporated in the attached amended By-Laws.

1. New Belgian Council members.

The Secretary General informed Mr Moutard about the resignation of the Belgian colleague and Council member, Mr Gilbert Voortmans, from his position as Council member.

After checking the Election results and the nomination forms of both candidates the BLC agreed that, according to Art. 4.3 BL, Mr Daelemans automatically becomes a full member and Mr Vandersteen his substitute.

2. Electronic voting

The next topic on the agenda concerned the electronic voting and the system that was used during the Munich Council meeting of April 28–29, 2014 (C 76) for the elections in Council.

Ms Pröll will send an email to the supplier asking all the different functions of the software. This information will be forwarded to the BLC.

The BLC finally agreed on several amendments with regard to the Elections in Council, see in particular Art. 53.1, 56, 57, 61.1 BL.

No amendment to Art. 60 appeared to be necessary.

For the sake of clarity, the title of Section 6 was amended.

3. Art. 18.2, A. 18.3 and A. 50

Art. 18.2, 1st paragraph and Art. 50 BL:

Art. 18.2, 1st § refers to Art. 50.3. It was discussed whether Art. 50.3 should also refer to Art. 18.2. BLC decided not to make such a reference in A. 50.3.

However **Art. 50.1** should refer to Art. 18.2.

Art. 18.2, 3rd paragraph,

There was also a discussion about the translation of “passives Wahlrecht”, in Art. 18.2 3rd paragraph, which does not seem to correspond to the English “passive vote”. It was decided to postpone this topic to the next By-Laws meeting.

Another issue concerned the flexibility left to a full member to nominate a substitute. In some committees, no nomination is made, and this can result in difficult situations, in particular in small committees. It is therefore decided to make the nomination compulsory.

Art. 18.2, 4th paragraph

The English and French versions were adapted to the German one (reason: see in particular the minutes of C55 (Cannes, 2003), decision 9:

The Chairman of the By-Laws Committee, Mr EDER, submitted a proposal for revision of the decision taken at the Florence Council meeting, concerning the size of committees (epi 68/03, Annex 1).

President HOLZER recalled that the Council had decided that associate members are appointed by the Committees. They may participate in a meeting if they are invited by the Chairman of the Committee. They receive the working papers, can make an input, but do not take part in the deliberations of the Committee, and have no right to vote. Council members questioned the limitation of associate members in some committees. M. SPEISER pleaded in favour of leaving it to the Chairman of a Committee to decide on the number of associate members within his Committee.

Art. 18.3

It was also decided to amend Art. 18.3, in particular to make clear that the correspondence of a committee includes emails.

4. Art. 51 BL

Further to the Munich Council meeting C 76, the BLC discussed whether Art. 51 should be amended.

Although Art. 51 seems to be clear, it is not very clear whether the President can vote during elections in Council.

It was concluded that Art. 51 applies to votes on motions, not to elections in Council. Attention is drawn to Art. 4.1 c BL which establishes a clear difference between votes and elections and also to the difference between Art. 59 BL (Method of voting on motions) and 60 BL (Method of voting at elections in Council).

Art. 51 contains a rule applying in case of equality of votes. Another rule (Art. 55) applies during elections in Council in case of equality of votes.

The Founding Regulation (Art. 87(2) FR) also clearly stipulates that “Council elects the Board”, which does not exclude the President of the **epi**.

Art. 51 contains exceptions, when voting is required under Art. 50.2 and 50.3 BL, which concern cases where a 2/3 majority is required. Another question was therefore whether other provisions (for example: Art. 27.3, Art. 29.2, Art. 43.4, Art. 48, Art. 49.2), where the simple majority does not apply, should also be excluded. The answer is no, because all these other cases concern procedural issues, where the President has been conducting the discussions and therefore has been himself applying certain procedural rules.

The BLC has therefore come to the conclusion that Art. 51 is clear, consistent with the rest of the By-Laws, does not apply to elections in Council, and that there is no need to amend it.

5. **epi** Budget and financial reporting process for Committees

The Guidelines drafted and amended by the **epi** Treasurer, should be provided in all three languages (Art. 27.2 BL).

After talking about the different obstacles, the BLC came to the conclusion that the Guidelines should be adopted by Council.

6. Further Amendments

6.1. References to provisions of the Examination Regulation

Several articles had to be adapted to the new Examination Regulation:

- The 4th definition at the beginning of the By-Laws;
- Art. 3.1;
- Art. 13.1.

In particular, according to the new Examination Regulation the President of the Institute:

- nominates the **epi** members of the Supervisory Board, a Deputy Chair (Art. 2(1)(c)(i)), or a Chairman (Art. 2(1)(c)(ii));
- nominates the **epi** members of the Examination Board (Art. 42(1)(c)(i)), or a Chairman or a Deputy Chairman (Art. 4(1)(a) and (b)).

According to Art. 17 the Institute is consulted by the President of the EPO when laying down the EQE fees. But the Institute is represented by its President (Art. 13.1 BL).

The BLC therefore decided:

- To change the date to 10 December 2008 in the definition of the “Examination Regulations” (see beginning of the By-Laws);
- To delete any reference, in Art. 3.1, to Art. 2(a) and 15(1) BL, to the Examination Regulation.
- to include, in Art. 13.1, references to Art. 2(1), 4(1) and 17 of the Examination Regulation.

6.2. References to the Founding Regulation (FR)

Art. 9 BL

Art. 9.1 and 9.2 BL refer to Art. 15 of the Founding Regulation. This is confusing and no longer necessary

because the part of Art. 15 FR, applicable in the context of Art. 9 BL, referred to the first Council Meeting.

Therefore the reference to Art. 15 of the FR was deleted from Art. 9.1 and 9.2 of the By-Laws.

Art. 10.9 BL

Art. 10.9 refers to Art. 7 (5) of the Founding Regulation. This Article 7(5) FR was deleted in 2002. Art. 7(6) was renamed Art. 7(5), and then again changed in Art. 7(6). It was decided to amend Art. 10.9 BL so that it refers to Art. 7(6) (not Art. 7(5)) of the Founding Regulation.

6.3. Compliance with former amendments to the By-Laws

The By-Laws have been deeply amended by the Vilnius Council. However, some provisions, which should have been adapted accordingly, had not yet been amended.

Art. 10.6 BL

The original Art. 10.7 (now 10.6) referred to A. 24.2a.

In C 64 (Vilnius) it was decided to delete the whole initial Art. 23* and the original A. 24(2)a.

Hence A. 24(2)b (not a) became A. 23(2)a. But A. 10.7 was not adapted accordingly.

Unfortunately A. 24(2)b was also referring to a report, but it is the audit report of the spring meeting. Therefore the reference, in A. 10.6, to A. 23.2(b), does not make sense.

The expression “the Report on activities referred to in Art. 23(2)b and also” was therefore deleted from A. 10.6.

**In one annex to the Vilnius accumulated file, Art. 23 is commented as “deleted, because unworkable”. Actually, the duty of the Council to decide the date and place of the next Council meeting is now a duty of the Presidium (A. 10B(2)b), and part of the “earlier Council meeting” of original A. 23(2) is now in ... A .24!!*

Art. 14.5 BL

The original Art. 14.5 referred to former A. 23.2a, which was deleted by Council (C 64, Vilnius).

It was decided to delete, in Art. 14.5 BL, the reference to Art. 23.2 (a).

Art. 30 BL

Art. 30 BL was updated so as to cover the actual practice of sending by email.

Art. 43.2 BL

The German version of Art. 43.2 was updated.

Art. 48 BL

In Art. 48 the reference to Art. 35.2 was wrong, it was amended to a reference to Art. 35.3.

Art. 59 BL

Art. 59 will be adapted only if it is decided to implement electronic voting for Council meetings other than those where elections in Council are performed. The Secretary General is invited to inform the BLC in advance.

Art. 62.1 BL

Art. 62.1d refers to Art. 10.9, which is obviously wrong; according to Art. 13.5, the President may invite third parties to meetings.

Art. 67 BL

Art. 67 was amended to include the possibility of sending notices of general meetings by email.

7. Other matters

The Rules for elections (epi 3.1.3) were also updated: only formal amendments were made to these rules.

Some formal matters still have to be implemented:

- In Art. 16.2 the German version refers to a “Post-scheckkonto” which is not accepted anymore. The

Treasurer will be asked whether this expression should not be replaced by “Girokonto”.

- Comments were made on the use of capital letters in the French version on the By-Laws. The epi Secretariat staff will go through the French version regarding capital letters.
- in English the word “chairman” should be employed, even if the position is held by a woman. The epi Secretariat staff will check the By-Laws accordingly.
- a list (excel sheet) of all current Board members will be established by the Secretariat. The list should mention since when they are in the Board and their position. This excel sheet should be available to BLC.

Report of the Litigation Committee (LitCom)

A. Casalonga (FR), Chair

I. Appropriate qualifications and certificate for representation by European patent attorneys (EPLC)

The draft proposal issued by the UPC Preparatory Committee concerning the requirements for European patent attorneys to be authorised to represent before the UPC has been published for comments on the official web site of the UPC.

The Litigation Committee prepared a position paper which was approved by the epi Presidency and sent to the secretariat of the Preparatory Committee.

The main points of this paper are the following:

1. European patent litigation course (Rule 2):

In the context of the EPLC, courses and qualification should be available in any EPC member state. The right to represent under Article 48(2) UPC applies to all EPA's including both those from states that are party to the UPC and those that are not. All should be able to follow an appropriate course and it is in the interests of the system for any training centre that meets the required standard to be accredited, regardless of its specific location.

In addition, a body (not falling within the definition of a body of higher education) that falls under the competence of the EPO, such as the European Patent Academy could also be included, should they wish to apply.

Rule 2 of the draft should therefore be amended to read:

“The Certificate may be issued by universities and other non-profit educational bodies of higher education in an EPC Member State [as well as by the Unified Patent Court’s Training Centre in Budapest (hereinafter referred to as Training Centre) or by a body falling under the authority of the European Patent Office (EPO) ...”

2. Content of the course (Rule 3)

Explicit mention of professional ethics, privilege and duties to the court should be included.

3. Other appropriate qualifications:

Beyond the transitional period, the present draft provides only for one alternative to the EPLC, namely a law diploma. While the EPLC will be the logical and preferred way of gaining entry to the list, the wording of Article 48(2) UPC requires discretion to recognize any appropriate qualification even beyond the transition period.

A new Rule 11a should be added, stating:

“European Patent Attorneys having other qualifications and experience may, at the discretion of the Registrar, be deemed to have appropriate qualifications.”

4. Other qualifications during a transitional period: Rule 12(b)

In the explanatory memorandum of the Preparatory Committee it is stated that Rule 12 takes into account that “in some member states patent attorneys are already authorised to represent parties in national courts in patent infringement cases”.

However, these are rare exceptions and in the vast majority of EPC member states, the parties must be represented by lawyers. Since most lawyers do not have a technical background, patent litigation in most EPC member states is a teamwork between a lawyer and an experienced patent attorney, who sits next to the lawyer in court and is involved in all stages of the preparation and conduct of the case.

In addition, the experience required under proposed Rule 12(b) does not take into account other actions involving a patent such as preliminary injunction procedures or declarations of non infringement as well as actions involving supplementary protection certificates.

All actions stated in Article 32 of the UPCA should be taken into consideration.

Rule 12(b) should therefore be amended as follows:

"(b) having represented a party or assisted a lawyer or a judge before the court in at least three actions initiated before a national court of an EPC Member State and involving a patent or a supplementary protection certificate, including at least one infringement action or one action for declaration of non-infringement within the five years preceding the application for registration."

5. Effects of entry on the List (Rule 16):

For those EPAs registered on the List and thus authorised to represent before the UPC, it is essential that they can identify themselves as such and also distinguish themselves from others who are not so authorised.

Those EPAs should be able to refer themselves as "European Patent Litigators".

A new Rule 16(2) should be introduced, stating:

"European Patent Attorneys registered on the List shall be entitled to refer to themselves as European Patent Litigator in the course of their professional activities in all of the Contracting Member States. Persons not registered on the List shall not be entitled to refer to themselves in this manner."

II. Rules of procedure of the UPC

It is expected that the 16th draft of Rules of Procedure will again be amended after further public consultation.

The Litigation Committee is monitoring the situation and will prepare a new position paper including further comments.

Report of the Patent Documentation Committee (PDC)

P. Indahl (DK), Chair

The PDC would like to report on some developments in the area of patent documentation.

WIPO has created a Patent Register Portal with excellent presentation of information on the scope of national and regional registers on patents and SPCs. The portal may be used as a starting point for web access to official patent registers. The portal is easy to use and quite informative. You may find the portal on WIPO's Patent-scope under menu item 'browse'.

The number of European granted patent publications (EP-B1 and B2) during the first three quarters of 2014 has decreased by 5.4% compared to 2013. The number of patents published after limitation procedure (EP-B3) is 26 in the same three quarters and thus continues to be at an average rate of less than one per week.

The online version of the Official Journal of the EPO will be improved by making available the complete

archive of the OJ in a unified format that allows better searching. The work is in progress and the completion date has not yet been announced.

The Chinese part of the global dossier is now active in the European Patent Register. The register information on a European patent publication includes a page showing the patent family. When a Chinese family member is present the global dossier shown next to the Chinese document provides a view of the Chinese file and a possibility for opening both a Chinese document and an English machine translation thereof.

A recent initiative, ARABPAT, has focus on adding patent documents from Arab speaking countries to Espacenet, and currently documents from Egypt, Morocco and Jordan have been included in the world-wide collection.

Report of the Disciplinary Committee,

P. Rosenich (LI), Chair

The Disciplinary Committee is working in its Customary manner.

The Secretary Tuna Yurtseven und Vice Secretary Wolfgang Poth visited **epi** headquarters in Munich in order to update the files and documentation together with the Registrar Vernessa Pröll and Deputy Registrar Michele Voth. The Vice-Chairman Werner Fröhling was in close contact with the German Patent Attorneys Chamber to exchange opinions and seek harmonisation in the question of file keeping over the time.

The Chairman Paul Rosenich contacted – as instructed by President Tony Tangena – the legal advisor of the UPC

Mr Johannes Karcher to offer **epi** DC– assistance in drafting disciplinary regulations for representatives before that Court. This is because the **epi** members form the first European Profession and therefore **epi**'s disciplinary regulation has an international reputation and is properly tested over 35 years.

One interesting case was filed, where an inhouse **epi** member downloaded quantities of scientific data of his firm for unclear purposes. The Chairman swiftly entrusted Chamber Smyth to deal with this complaint.

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 07.11.2014 covers the period since my previous report dated 06.08.2014.

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

The EPPC is presently organised with six permanent sub-committees (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, and Unitary Patent). Additionally, *ad hoc* working groups are set up when the need arises. Thematic groups are also being set up.

1. Thematic groups

For the 2014-2017 term, it seems that only the thematic groups in the field of Pure and Applied Chemistry, which includes medical uses, and in the field of Computer-Implemented Inventions can be composed from EPPC members.

For all the other groups (corresponding to all other Principal Directorates), I am now making a call for candidates amongst the Council members.

2. PCT Working Group (follow-up)

At its last meeting, the Committee heard a report on two representation-related topics discussed at the PCT WG, and decided to specifically report to Council:

- National phase entry using ePCT (document PCT/WG/7/12).
- Right to practice before RO/IB (document PCT/WG/7/13).

The PCT/WG/7 documents are available on the WIPO website: http://www.wipo.int/meetings/en/details.jsp?meeting_id=32424.

The PCT sub-committee has now prepared a paper which will be submitted to the EPPC at its next meeting, with a view to seek the views of Council at its Barcelona meeting (C78).

3. SACEPO/WPR 11

The 11th meeting of the Working Party on Rules took place on 29.09.2014. The provisional agenda mentioned only oral reports in support of the various items. The users indicated that listening to oral reports is not in their view a basis for consultation.

On Rule 147, the EPO asked users to think about a reasonable preservation period. Users unanimously mentioned that telefax must be retained as an option.

As to the unitary patent, the issue of surrenders and the time limit for paying a renewal fee with surcharge were discussed.

Finally, we promised to update our “wish list” for rule amendments (suggestions from the readers of **epi** Information can be addressed to eppc@patentepi.com).

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

The actions of Spain against both Regulations (C-146/13 and C-147/13) are still pending before the Court of Justice of the EU. The opinion of the Advocate General was announced to be delivered on 21.10.2014, but this date has been postponed to **18.11.2014**.

The SC (Select Committee of the Administrative Council of the EPOrg) held its 10th meeting on 28–29.10.2014. One agenda item was particularly relevant to the EPPC, namely the decisions on the remaining open items of the draft rules relating to unitary patent protection:

- as to the due date for payment of renewal fees with surcharge, the European Commission (EC) said it wanted to be pragmatic and ensure consistency with the EPO practice [i. e. J4/91], however it stated that the present wording (“within six months”) is not entirely devoid of legal risks and that it is important that the SC be aware of that; **epi** repeated that it is in favour of legal certainty;
- as to re-establishment of rights, the EC stated that it still has an issue, however immediately added that Article 9(1) of the Regulation [which refers to the EPO’s internal practice] provides a bridge, that the short period (two months) is reassuring, and that Rule 22(7) will provide for protection of good faith use;
- as to the Register, the issue of surrender [is surrender possible, and if yes how] was not settled; the EC stated that if any member state would provide for a national procedure to handle surrender of a unitary patent, it would request the CJ EU to intervene; the question of further entries in the Register was also left open.

The SC then discussed financial aspects (simulation concerning fee reductions for SME’s; estimated costs of the EPO in relation to unitary patent protection) and agreed to launch work on the distribution key.

It was announced that the consolidated version of the draft Rules would be made available on the EPO website following the December meeting of the SC (09.12.2014).

5. MSBA 21

This year, the meeting took place on 07.11.2014 in restricted composition, with only 7 delegates from **epi**, two from BusinessEurope,⁹ chairmen of boards, observers from DG5 and support staff from DG3. The meeting was chaired by Mr Van der Eijk.

The topics discussed this year were, as usual, quite varied, from numerous procedural aspects to the application of Article 123(2). As to the latter, preliminary findings of a study by the IP Federation as to variations between boards were reported and discussed.

Incidentally, no *amicus curiae* briefs have been sent by **epi** for pending cases G1/14, G2/14 and G3/14, because no volunteer stepped forward.

6. Guidelines

The Guidelines Subcommittee held a meeting in Copenhagen on 05.09.2014 for preparing the list of comments and suggested amendments for the 2015 Guidelines to be discussed at the SACEPO Working Party on Guidelines (WPG) on 25.11.2014.

The Subcommittee would like to remind all **epi** members that we appreciate any comments/suggestions at any time during the year; please send them to our attention at eppc@patentepi.com.

The members of the WPG have been informed that during the next years, the revisions of the Guidelines will focus in particular on computer-implemented inventions, and will emphasise the practice relating to Article 123(2) EPC. In this connection we would in particular request comments on the Guidelines relating to computer-implemented inventions (G-II, 3.6 and 3.7) and/or to Article 123(2) EPC (H-IV, 2).

7. Patents and standards

The European Commission (DG Enterprise) has launched a public consultation on “Patents and Standards”, open until 31 January 2015:

http://ec.europa.eu/enterprise/policies/industrial-competitiveness/industrial-policy/intellectual-property-rights/patents-standards/public-consultation/index_en.htm

The members of the EPPC interested in this subject have been invited to volunteer and join a group that would prepare an **epi** submission – if any –. Other **epi** members may join the group, depending on its size.

8. IB survey on SIS

At the request of the PCT Assembly, the International Bureau (IB) has initiated a review of the Supplementary International Search (SIS) system. As part of this review, it has sent a questionnaire to all actors of the system, including **epi** as non-governmental organisation representing users of the PCT system.

The PCT Subcommittee of the EPPC is seeking the views of Council and EPPC members in order to prepare a response by the due date of 19.12.2014.

9. Next meeting

The next meeting is being planned in February 2015.

Committee on Biotechnological Inventions

A. De Clercq (BE) (Chair)

The below topics were discussed during our Committee meeting of 18 July 2014.

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

The Enlarged Board of Appeal issued a communication on G2/12 and G2/13, noting the oral hearing on 27 October 2014 and setting out the points for discussion. We think that the pendulum may be swinging towards allowing products (such as plants), even though they may be produced by an unpatentable process. We note that in both NL and in DE the legislator has excluded protection for plants produced by an essentially biological process (although in NL this is for NL national patents only – for EP(NL) cases the NL courts are following the EPO's line).

Ms Knuth-Lehtola (FI, member of our Committee and member of the EU Expert Group discussing on the Biotech Directive) is given input by the **epi** Biotech Committee when requested. We would like to point to our amicus brief filed to the EPO in name of **epi**. We may need to provide further comments. Ms Knuth-Lehtola was given permission to send our summary of the national laws concerning plants to the EU Expert Group. The **epi** legal adviser will finalize this document. It was also the intention to publish this document in **epi** Information.

2. Stem Cells

The EPO decision on the Brustle case is in contrast to the decision of the German National court. This had been picked up in the SACEPO document, which had recently been circulated. This seems to be due to a difference in German national law and the EPC.

The latest opinion from the CJEU in C364/13 suggests that "parthenotes" are not embryos and therefore are not excluded from patentability.

T2221/10 appears to follow the EPO's current practice, namely that cases filed before publication date of the single blastoma extraction process (SBP) are not patentable. Ms Knuth-Lehtola is on the expert commission formed by the EU, and while other groups from hers are working on stem cells, the **epi** may be able to comment too on this issue.

3. Sequence Listings

The decision J8/11 said that applicants do not need to include prior art sequences in listings, but we need to check that the EPO practice note does indeed follow this decision. The EPO guidelines have been changed, but we should check whether they are actually in line with J8/11.

It was good news to hear that we can now file sequence listing using the online filing software, once a PCT application has been filed on line at the EPO.

One member reported that unexpectedly he had been asked by an Examiner to file a sequence listing when he inserted accession numbers in the claims for the first time, and he got the standard communication from the EPO asking to file a listing and having to pay a fine. This came later in prosecution, and out of the blue, and at the very least we thought that it was inappropriate to have to pay the fee.

No Committee members use the EPO's sequence listing software BISSAP (Patentin is still used widely).

4. Medical use claims

T1780/12 concerned the difference in scope between Swiss style and EPC 2000 claims.

There is some concern by doctors, for example in CH, that they may infringe the EPC 2000 claims. There is also concern regarding infringement for off label marketing. We think that there are differences in scope, because Swiss style claims require the manufacture of a medicament: at a very basic level are two different types of claims have different wording. One of our members suggested that EPC 2000 claims might cover the use of an intermediate in a pharmaceutical formulation which then is metabolized to an active ingredient in the body. That probably would not be covered by a Swiss style claim.

5. Added Matter – Article 123(2) EPC

It was discussed that this issue had been the topic of a workshop held with the **epi**, and this is now becoming a major issue, with it being discussed at SACEPO and also at the annual meeting of **epi** with the Board of Appeal. There will be a first batch of changes to the Guidelines in October, emphasizing the EPO must not take a photographic view of matters. The EPO should be moving towards a more liberal view on added matter, even though this may have implications on novelty (for example, certain selection inventions may now no longer be novel). The Biotech Committee suggests to bring up this matter for discussion with the EPO Directors at the meeting on November 25, 2014.

6. Deposits and the Expert Solution

We think the EPO may have scrapped the expert list. However we are not sure, so we will ask for clarification at the meeting in November with the EPO Directors.

7. Procedural matters

We have noticed that, regarding patenting of antibodies, the EPO want the CDR's and the sequences in the claims.

Far as summons to oral proceedings are concerned, we are not sure what criteria the EPO apply. It seems to be very liberal, with few guidelines for Examiners.

On a separate matter it was noted that documents had not been scanned by the EPO four weeks after filing by a formalities officer in the Biotech group, which prevented urgent documents appearing on the online file.

We still like to file drawings in colour.

We also thought that in the Examiners' appraisals the EPO ought to include the results of any appeals against their cases.

8. National Developments

As far as plants are concerned, in the Cresco case in the Netherlands relating to plants there was an interlocutory injunction decision in favour of products produced by essentially biological processes (the claim is in fact in a product by process form). The Dutch national patent was, however, in contrast revoked on the basis of

national law (which does not appear to apply to European patents).

In the US, there has been much consternation and outcry concerning the new natural products guidelines, following the Supreme Court of Appeal decision in *Myriad*. The EU expert group will be discussing this issue.

9. Associate Members

It was agreed to include, as associate members:

Anne Desaix
Philipp Weinzing
Camilla Liden
Caroline Pallard

It is noted that associate members are allowed to attend the Biotech Committee meetings, but at their own expense.

10. Next meetings

Next meeting with the EPO directors and a subpart of our Committee is on 25 November 2014 at the EPO in Munich. A short meeting beforehand with the committee members that will be present at said meeting has also been organised.

Obituary: **epi** tutor Peter Low



It is with great sorrow that we inform you of the passing of our highly esteemed friend and colleague, Peter Low, who passed away, on 11th October 2014.

Peter was a European Patent Attorney and Chartered Patent Attorney who was widely recognised for his professional expertise and enthusiasm which he shared with his **epi** students with great pleasure. He has given CIPA tutorials for the UK Examinations for the last 20 years. In 1989 he set up the Manchester CEIPI basic training course for the European Qualifying Examination.

He has been one of the tutors at the Strasbourg seminars for preparing candidates for paper D of the European Qualifying Examination. He was a tutor and examiner for the Manchester University Postgraduate Certificate in Intellectual Property Law and he is also a tutor for the **epi**.

Peter was a great tutor and mentor throughout his life, he continued to be a model leader even until his last moments and he will be greatly missed in the **epi** Education section.

Tutors' report on the EQE 2014 papers

A. Hards (DE), D. Jackson (UK), S. Kirsch (UK), H. Marsman (NL), P. Pollard (NL) and R. van Woudenberg (NL)

Each year in October, the European Patent Academy and the **epi** arrange a meeting between EQE tutors and the Examination Committees. The goals are to discuss February's papers, to improve future EQE's by openly exchanging ideas and to help tutors prepare candidates for next year's exam.

The Examination Board has kindly given the tutors permission to publish their own report of the important points so that candidates can more easily find this information. In addition, the comments can greatly assist when reading and interpreting the official EQE Compendium.

This year's meeting was held in Munich on October 10, and was attended by more than 100 tutors from Austria, Belgium, Bulgaria, Czech Republic, Denmark, Finland, France, Germany, Italy, Lichtenstein, Malta, The Netherlands, Poland, Portugal, Romania, Spain, Sweden, Switzerland, Slovenia and United Kingdom.

This Tutors' Report appears each year in the end of year edition of **epi** Information. It is also distributed to all tutors who attended the meeting, as well being posted on the EPO's EQE Forum.

It contains the following sections:

- | | |
|-----------------------|-------------|
| 1. Future EQE changes | 5. C (1) |
| 2. AB CH (1) | 6. C (2) |
| 3. AB CH (2) | 7. D |
| 4. AB E/M | 8. Pre-Exam |

EB is used to refer to the Examination Board, and EC to the relevant Examination Committee.

On behalf of the tutors present in Munich, I would like to thank all the members of the Examination Board and the Examination Committees for their openness, and for listening to our opinions and comments. This meeting is our yearly opportunity to learn from each other.

My thanks also to the tutors who asked questions and contributed to the discussions. My special thanks to Harrie Marsman, Derek Jackson, Roel van Woudenberg, Susan Kirsch, and Andrew Hards for finding the time to prepare the individual paper summaries.

We all wish you good luck in 2015,
Pete Pollard (Editor)

1. Future EQE Changes

- It was announced that starting with EQE 2017, there will only be a single technical specialization for the A & B papers. The separate chemical and electromechanical papers will be merged following a decision by the EQE Supervisory Board.
- This will be a similar technical approach to the C paper – a technical subject that all candidates can understand
- A number of reasons were mentioned for the merging:
 - the very large overhead in producing, distributing and marking two papers
 - the divergent approach of the electromechanical and chemical EC's in setting the papers
 - the difficulty of trying to equalize the passing rates between the two technical disciplines

- the fact that some technical backgrounds have difficulty with the current papers, such as biotech and software specialists.
- Ian Harris (EB) expressed the intention to produce a mock exam well before EQE 2017 to allow candidates and tutors to prepare.

2. AB CH (1) – by Harrie Marsman

EC I representatives: Wim van der Poel (Coordinator), Thomas Leber (Paper A) and Jeremy Mauger (Paper B)

Moderator: Nicolas Favre

- Papers A and B were fair, but not necessarily easy papers

Paper A:

- Pass rate: 51 %; compensable fail 6.7 %
- The core of the paper was dealing with a method to detect proteins in a complex or in dissociated form. It was directed to the proportion method and the screening and in addition to products and uses.
- Particularly required was a claim directed to the proportion method; a claim directed to the screening; a claim to a CHAPS containing solution; a claim directed to an L-arginine composition; and the use of these compositions.
- D1 was dealing with the same method but for another protein. D2 was on the protein, but with another aim (mutated variant). It was relevant in view of novelty; the buffer composition containing the protein was known. This is reflected in the CHAPS containing solution; in the use claim the limitation required to bring novelty was not needed.
- One of the necessities was to broaden the pH range to 6.8-7.6. Essential elements were a cut-off stability factor, for which you had to find limits in the examples, buffer composition and chromatography. However, there were a considerable number of unnecessary limitations.
- At the end of quite a number of papers, quite “creative” claims were found which may well have problems with novelty and support.
- Reach-through claims should not be made.
- For the dependent claims, this year you had a maximum number of points “like the last years”. However, there were not many motivated preferences.
- If there is no statement in the Examiners’ Report, the situation was not seen in the candidates’ papers.
- Quite some information was given by the EC on how the marking was carried out. It is an iterative process starting with what the drafter expected, but after seeing the candidate’s solutions, adaptations were made.
- In the Examiners’ Report a set of claims is present that would give you the full number of marks. But it is only a set of claims.
- Major mistakes: missing category of claims. Method, product, use needs to be taken into account.

Paper B:

- Pass rate: 65 %

- There were novelty problems and there was an issue with an unclear parameter. The client referred to precious metal and to a polymer. One had to deal with Art. 123(2) EPC. At least some arguments were expected for the parameter.
- In the arguments, you needed to address the support in the application (if you combined passages, you were expected to argue why these passages could be combined), novelty (a summary of D1 and D2 was expected, together with a clear identification of all differences), inventive step (all steps based on all pieces of information were expected), and the clarity issue.
- In the marking, arguments had to be based on the claims presented.
- Problems in this paper were:
 - added subject-matter (it was emphasized that you should not completely alter the wording of the claims presented);
 - drafting of additional independent and dependent claims without giving arguments; and
 - definition of the problem (candidates should use all information)
- If you make an error in your claims you can “cure” this (at least partially) with arguments.
- The B paper is intended as responding to an office action. It is not an invitation to create claims.
- In addition, there was a discussion on the A & B papers no longer being chemical/mechanical as of 2017.
 - There will be a mock paper.
 - There were concerns about making a combined paper A. For example, Paper A chemistry typically tests Art. 123(2) and paper A mechanics gives multiple embodiments which require generalization.
 - Paper B should be possible, given the experience of making the C paper.
 - It was mentioned that you have one EPC. However, the case law created by the Boards of Appeal goes in different directions for the different technical fields.

3. AB CH (2) – by Andrew Hards

Paper A

- This year, candidates were confronted with a true biotech paper. Given the impending EQE changes planned for combining the A/B mechanics and chemistry papers, it seems likely that this will be the last exam for some time to focus on biochemistry. With all due respect for our mechanically-inclined colleagues, it is hard to imagine that combined papers A and B will touch on the peculiar case law of biotech reach-through claims. Likewise, it remains a mystery to me how the chemists will manage to tackle the intricacies of functional definitions in complex spatial apparatuses – time will tell.
- Paper A was in line with previous papers in that a chain of products, processes and use claims were expected, together garnering 70 points. Dependent claims accounted for up to 15 marks in total and another

15 marks were allocated for the truncated description. Evidently, candidates must seek out the independent claims.

- The exam was different this year in that two method claims (same category) had to be found. Primarily, there was an analysis process “proportion method” for determining the amount of active protein compared to the disintegrated protein by means of chromatography (15 pts). This led to a consecutive “screening method”, by which it was possible to search for protein stabilising solutions that kept the protein in the active state for a longer time (20 pts).
- Finally, the specific stabilising solutions thus found should be claimed (20 pts). However, of course, not as reach-through claims claiming any not-yet identified solution, but instead with the specific compositions of the stabilising solutions determined to be superior.
- Tables illustrated the effects achieved and served to guide candidates to the right compositions. In addition, the solutions themselves, were not new, so only the combination with the protein could be claimed.
- Use claims were also expected, and these could be formulated without certain restrictive features, because the use itself was novel (20 pts).
- As in previous years, essential features had to be picked up for each of the methods. This is well established EQE handicraft.
- In a sense, it is remarkable that although the exam could in fact be drafted quite differently, time and again the drafters have been keeping to this standard exam structure. No surprises here, but the complexity of the case and the need for detail (novelty analysis/essential features/catching all claim types) are enough to keep candidates duly challenged.

Paper B

- The paper was about a process to catalytically hydrogenate fish oils so as to reduce the melting point. However, the number of trans-isomers should be kept low (bad cholesterol).
- The applicant’s letter contained much useful information. However, there was no basis for the suggestions made by the client. Claim 2 could not be saved, because the pore size was given without a measurement method and the “nitrogen adsorption” method proposed by the client was not disclosed in the application.
- In addition, the proposed restriction to “polymer” was an intermediate generalisation, since only the specific polymers were mentioned.
- Nevertheless, the client’s letter does point candidates in the direction of the desired solution and should be followed. Both amendments together, i.e. nanoparticles and specific polymer, provide for a novel combination over D1 and D2, respectively.
- Arguing inventive step afforded 38 pts, underscoring the emphasis on detail-focused argumentation using the full problem solution approach. Justifying the

closest prior art is (justifiably) awarded up to 8 pts and standard phrases will not be enough.

- An exhaustive proof of the effect based on comparative examples was necessary. This also included the time of catalyst application, as could be deduced from the table, which was an effect not explicitly mentioned by the client initially.
- As for arguing inventive step proper, while D2 might afford the one missing feature (nanoparticles), it couldn’t suggest the increase in polymer wt%, because the beneficial effects of such a combination were not identified in D2.
- Note that the higher range of polymer was also required as an essential feature, as was derivable from the table. Again the data table and client’s letter served as Ariadne’s thread, leading the candidates through the maze of information to the right solution, but beware of the Art. 123(2) beast!

4. AB E/M – by Derek Jackson

EC I representatives: David Cousins and Christophe Chauvet

Paper A

Independent claim

- The EC first identified the common features between the two examples of the nutcracker of the invention (Figures 1-6 and Figures 7-11).

These are a nutcracker comprising:

- two support elements (generalisation from [011])
- at least three connecting elements (generalisation from [022])
- each connecting element is movably attached to each of the support elements
- the support elements and the connecting elements define a space for receiving a nut.
- The differences between the nutcracker of the invention and that of D1 is that movement of one of the support elements relative to the other support element causes at least one of the connecting elements to move relative to another of the connecting elements to restrict the space and to crack a nut in the space (see client’s letter [007] according to which the rods 3, 4 and 5 move relative to each other and compare with D1 [001] according to which pins 6 and 7 constrain the movement of the connecting elements 1, 2 and 3 so that they cannot move relative to each other).
- The difference between the nutcracker of the invention and that of D2 is more difficult to express, but essentially it is that it is movement of the connecting elements that causes movement of the support elements towards each other in order to restrict the space and to crack a nut, rather than movement of the support elements that causes movement of the connecting elements (see D2 [003]). The support elements are then pulled apart to cause relative movement of the connecting elements (see D2 [004]) which is the opposite to the functional limitation of the nutcracker of the invention.

- The challenges of the independent claim can be summarised as follows:
 - Avoiding unnecessary limitations (such as generalising to support elements and connecting elements)
 - Covering all the examples
 - Novelty over D2 in particular
 - Clarity (such as unclear definition of relative movements, arguable exclusion of second example)
- Typically, marks lost under clarity are 50 % of those lost for lack of novelty. A claim that is arguably novel will be marked down under lack of clarity (rather than lack of novelty) and will score correspondingly more marks.
- A significant number of candidates had minor limitations over the ideal claim, but many of these (such as the stiffness of the connecting elements) were not considered important and were not penalised.

Dependent claims

- Dependent claims are required to establish potential fallbacks in the event the independent claim has to be restricted in scope.
- Only 15 claims will be marked – any additional claims will be ignored.
- The structure of dependent claims is important – grouping claims by topic helps to optimise structure and dependencies (although for 2014 most dependent claims were able to refer back to any of the preceding claims).
- To avoid a lack of clarity, terminology of dependent claims should be consistent with that of the independent claim.
- Avoid unnecessary limitations: for example, by combining unrelated features in one dependent claim (this aspect is improving year-on-year).

Description

- Acknowledgement of only one piece of prior art is expected, preferably D1.
- Acknowledgement of both prior art documents does not lose marks, but takes time and can make the subsequent explanation of a problem and how it is solved more difficult to present well. This part of the answer gives a candidate the opportunity to demonstrate he or she has not arrived at the correct claim 1 by chance.

Paper B

- The main problem with Paper B appears to be the need to handle three sets of claims: the claims as filed, the claims as amended by the client, and the claims to be presented by the candidate in his or her answer.
- The claims originally filed have problems associated with novelty, clarity and unity.
 - The claims proposed by the client deal with one of the novelty problems, but not with the other (note: “we do not understand the objection” in the client’s letter).
 - The proposed claims do not resolve the problem with clarity, although they do address the unity problem.

- However, the proposed claims also introduce an added subject-matter problem relating to subject-matter introduced into claim 1.
- The amendment required to overcome the second novelty problem also introduces a more serious added subject-matter problem, due to splitting the subject-matter of dependent claim 3 and introducing part of that subject-matter into claim 1.
- For EQE 2014, all the features needed for the amendment were available in the claims and the description and drawings are not required for the amendments, although they are required for the justification of the amendments.
- Note for EQE 2015 that the new Guidelines for Examination appear to introduce a new approach by the EPO to added subject-matter.

5. C (1) – by Susan Kirsch

EC II representatives: Joanne Moore, Tessa Donovan-Beerman, and Vagn Nissen

- The terms used in the French translations were not as technically similar as the terms used in the English and German versions. Following this issue, a guinea pig will be used in future to test the paper in each of the 3 languages.
- There was no difference in the length of the paper (word count) compared to the 2013 paper, but there were more documents and a complex priority issue which probably gave the impression that it was a long paper. Most candidates appeared to be able to finish.
- There was a noted reduction in “shot-gun” attacks which pleased the EC. Very few superfluous attacks.
- The EC do not penalise if extra attacks are made – the candidate is wasting time however.
- Candidates are still often only using standard phrases for the justification of the CPA and the reason to combine two documents, which obviously do not attract marks.
- A “frightening” number of candidates used A6 as a document under Art. 54(3) EPC.
- It is expected that all possible novelty attacks should be given (in this paper there were two novelty attacks against claim 1 expected because of the priority issue); but only ONE inventive step attack per claim/object.
- Claim 2 has no effective date (Art. 123(2) EPC) therefore no novelty or inventive step attack can be made.
- A number of candidates used a combination of A3 + A5 + A6 to attack the second alternative of claim 3, which was not necessary as only A3 + A6 was needed.
- Candidates must ensure that they think through each inventive step argument from the beginning to see what the distinguishing features over the CPA are and how best to plug the gap rather than starting with an argument they may have already run in an earlier attack and just adding to it piecemeal.
- An attack starting from the “wrong” CPA may get good marks if nevertheless argued convincingly.
- For example, it was possible to get quite reasonable marks with an attack of A2 + A3 rather than the

expected A3 + A2 in this paper providing convincing reasons as to why A2 (rather than A3) could be the CPA – closest to the true start point of the inventor and set out in A1 as the prior art.

- Candidates should think about what they are doing and explain why – the explanation is the key; the examiner cannot read their minds!
- It was noted that the pass mark of the DE candidates has dropped.
- This same decline is not seen in the English candidates. It was suggested that this may be because the English were much better at distinguishing between the requirements of the EPO/EQE compared to their national office/exams – for example argued inventive step very well and followed the problem solution approach exactly rather than use a German/EPO fusion technique.

6. C (2) – by Roel van Woudenberg

- Most candidates appeared to be able to finish in time as most claims were decently attacked
- The attacks were generally well balanced. However, standard phrases as “it is the closest prior art because it is the most promising springboard” were still used too much, and some candidates wasted time on weak attacks.
- Most marks were lost in argumentation, especially as to motivation to combine documents.
- Some candidates seem to have overlooked the hints in the client’s letter and only focused on A1 and the other documents. Candidates should also read the letter carefully.
- Candidates should do all strong attacks: lack of novelty under Art. 54(2) and Art. 123(2)/Art. 100(c) being the strongest. If there is an Art. 54(3) attack, there is often also an inventive step attack on the same claim.
- Even candidates that indicated upon enrolment/front page that they want to use their own language (non-official EPO language) for answering the exam, candidates only occasionally do so.
- If the whole paper is answered in their mother tongue, it gets translated before marking starts.
- If only some isolated phrases or a paragraph is in the mother tongue, it is usually only detected during the marking, but it will always be accepted, even if not indicated on the front page.

7. D – by Pete Pollard

EC III representatives: Daniel Closa, Dimitrios Roukounas (commenting on DII), Brigitte Willems (commenting on DI)

Moderator: Jakob Kofoed

General comments on D, and how the papers are made and marked

- Most candidates struggle with PCT. But, at the exam, PCT questions are generally done as well as the EPC

questions. The EC aims to draft not-too-difficult questions, but that is rather difficult.

- After the paper is made, the situations are checked to make sure they are legally correct, and also that they comply with EPO practice. This second check leads to some questions being rejected.
- The Possible Solution in the Examiners’ Report is based on the marking scheme that was used.
- There is always discussion during this meeting about how much detail should be given about the procedural steps.
- The EC indicated that a deliberate choice is sometimes made to focus on either procedural law (for example: “How ...” or “What steps have to be taken”) or on substantive law, (for example: “will a patent be granted”). So, if in doubt, look at the question being explicitly asked.
- The EC has the freedom to vary the number of questions on DI. However, they are comfortable with the current number, which is 5–7 questions.
- The EC noticed a new trend this year: candidates passing with a good DII (> 40 points) and a poor DI (about 10 points). This is not a problem – there are no minimum requirements for DI and DII – it is completely unimportant where the points are scored to pass.
- It seems like many candidates are putting more effort into DII by using more than the nominal 3 hours for DII. Many seem to be starting first with DII, although the EC cannot always see that in sheets handed in – it is seen often during the exam by the invigilators.
- It was briefly discussed by the tutors that candidates should be made aware of this possibility. But, this will only work if the candidate knows how to score points on DII and is confident enough at the exam to invest extra time on DII instead of DI.
- Many candidates still go to the exam unprepared – it was pointed out by the EC that if you cannot get more than 30 points on D, it is hopeless just trying the exam.

D Paper in 2015

- The EC reported that from EQE 2015, the D paper will explicitly indicate that “Today” the day to consider whether anything can still be done in DI and DII) is the actual date of the exam. This is something that a number of tutors have been requesting for some time as there are many candidates who do not realize this, and hence miss points.

D 2014 results: approx. 37 % with 50 or more, approx. 45 % with 45 or more

- We are back to the passing rate seen in 2012, although the passing rate is relatively consistent over the years. It is not clear why this paper was not done as well as D 2013.
- One influence is the relative poor performance of many German candidates (candidates resident in Germany) – this was not due to the language in the paper (Austrian candidates performed well), and it was immediately noticeable when the EC was marking the papers – they clearly had 4–5 points less than the

average. The decline was seen in both DI and DII scores.

- From the official D 2014 statistics, the results for candidates taking the exam in their native language:
 - Resident in Germany: approx. 33 % with 50 or more, approx. 41.5 % with 45 or more
 - Resident in France: approx. 51.5 % with 50 or more, approx. 60 % with 45 or more
 - Resident in UK: approx. 58.5 % with 50 or more, approx. 62.5 % with 45 or more
- A clear decline was also seen for the C paper this year for candidates from Germany.
- The EC has noticed that the level of candidates in Germany has been decreasing generally over the years. Some tutors mentioned that a problem is that many German candidates approach the D paper in the same way as the national patent attorney exam – this is not the best way to pass.
- Some tutors have noticed that in the last couple of years fewer German candidates are following training courses. It appears that many companies and law firms are doing this to save money, and consequently many candidates are just trying the D paper with too little preparation. As 45 % of the candidates are resident in Germany, this has had an effect on the overall results.

DI 2014 – General

- Some candidates appear to be doing DI like DII – they are being less diligent in details, and missing points. However, it does not matter to pass where on D the points are scored.
- Some candidates spend time reciting law, but they have to apply it to get the marks.
- The EC noticed a number of candidates simply re-writing the questions. This was seen in both DI and DII. Just doing this does not attract any marks.

DI Q.2

- There were many candidates who cited R. 52(3) instead of R. 52(2) as legal basis for adding a priority claim – they lost the points for legal basis.
- Surprisingly every year, there are candidates who consider national applications as Art. 54(3) prior art
- There was some discussion about how much detail should be given about the procedural steps, such as filing a certified copy. The EC indicated that a deliberate choice was made to focus on substantive law by asking “whether a patent can be granted”
- So it was not expected to indicate that the certified copy should be filed no later than 3/4/14.

DI Q.3

- The interruption calculation is quite complex with many steps. However, if the correct answer (22/4/14) was reached using the wrong calculation chain, points were lost for the incorrect part.
- Exceptionally, on this particular question, a GL reference (E-VII, 1.4) was accepted for full legal basis points because the decision J7/83 is cited in that section.
- The true legal basis was the decision, but the EC sometimes chooses to be lenient for certain questions

– candidates should not rely on this leniency to always be available.

DI Q.4

- A number of candidates were not familiar with representation rules under PCT before the EPO.
- EPO allows professional representatives or legal practitioners to be “agent” – Art. 49 PCT; Art. 134 EPC. So legally two answers are possible to a).
- However, a discussion on “legal practitioner” was not expected by the EC for full points – if a candidate only discussed the legal practitioner, then no points were awarded.
- In the German paper, “Anwalt” was used to indicate “agent”. There was some discussion about whether this is confusing for German candidates, and may encourage the “Rechtsanwalt” interpretation which gave few points. The EC used “Anwalt” because that is how “agent” is translated in official communications from the EPO. For example, in How To Get a European Patent (Part II) paragraph 97 reads:
 - *Im Verfahren vor dem EPA als Anmeldeamt sind zwei Kategorien von Vertretern („Anwälte“ im Sprachgebrauch des PCT) vertretungsberechtigt:*
 - *zugelassene Vertreter oder Zusammenschlüsse von Vertretern, die im beim EPA geführten Verzeichnis der zugelassenen Vertreter eingetragen sind – ABl. 2013, 500, 535*
 - *Rechtsanwälte, die in einem der EPÜ-Vertragsstaaten zur Vertretung auf dem Gebiet des Patentwesens berechtigt sind und dort ihren Sitz haben.*

DI Q.5

- This question was generally well done.
- A discussion on the case being sent to the Board of Appeal was not required, because there are no indications in the question that any objections still exist to claim 1 + 2.
- There was a discussion on admissibility as one of the tutors suggested that a Board of Appeal may not consider the request to amend to claim 1 + 2 because the request could have been made in first instance proceedings, but was not – Rules of Procedure BoA 12(4).
- Although this is true, the EC explained that in such a case, the Examining Division will first consider the case before sending it on to the Board of Appeal. It is the Board of Appeal that ultimately decides on admissibility. In the case of successful interlocutory revision, the Board of Appeal is not involved at all.

DI Q.6

- Very few managed to get the number of pages completely correct. There were many different reasons why it went wrong, such as forgetting the abstract, using the complete English version, or just using the wrong documents.
- Although this is a difficult question to get correct, the EC will continue to ask questions on fees.

- Exceptionally, on this particular question, a GL reference (A-X, 6.1) was accepted for full legal basis points because the decision J1/81 is cited in that section.
- The true legal basis was the decision, but the EC sometimes chooses to be lenient for certain questions – candidates should not rely on this leniency to always be available.
- The EPO at The Hague was actually closed on 5 May 2014, but this was not in the calendars included with the exam. But some candidates knew this, or they had brought their own calendars, and extended the time limit to 6 May 2014. They did not lose marks for this.
- However, it is not recommended to bring your own calendars because the papers are made based upon the official EQE ones: [http://documents.epo.org/projects/babylon/eponot.nsf/0/92CF8614E15FB90EC1257BAC002A2B01/\\$File/Notice_Examination_Board_Calendars_DandPre.pdf](http://documents.epo.org/projects/babylon/eponot.nsf/0/92CF8614E15FB90EC1257BAC002A2B01/$File/Notice_Examination_Board_Calendars_DandPre.pdf)

DII 2014 – General

- Every year there are overlapping patent rights (usually a “dependent” patent situation), and every year there are many candidates that advise the client that having a patent gives the right to produce/sell. This is fundamentally wrong, and is dangerous advice for your client.
- Expect this to be tested every year – make sure you know this, and always write phrases legally accurately:
 - EP1 gives M the right to exclude others from exploiting X+A in DE
 - EPX gives P the right to exclude others from exploiting X in DE
 - EP1 is a dependent patent
- DII is unusual in that the number of points per question is never given. The EC explained that they need the flexibility to change the marking based on the answers they see. An initial sample of 5-10 papers is marked by each of the EC, and where necessary, the preliminary marking sheet is changed. This can mean that an extra 10 % will pass based upon the revised marking sheet. When comparing Q1 of 2013 and Q1 of 2014, it is noticeable that in 2013 the question was more explicit about what should be dealt with in the answer. The EC indicated that there are no rules for this and they determine it each year based on the paper.

DII – Q. 1

- For EPCZ1, the translation of the priority document (CZ1) must be filed, otherwise priority will be lost – R. 53(3) EPC. This rule was changed for invitations issued on or after 1/4/13 (OJ 2012, 442).
- Surprisingly, many candidates referred to the old rule which only had a sanction mentioned in the Guideline’s and a different time limit. This was also surprising for many tutors – an explanation may be that many candidates simply use their materials from the Pre-Exam for the Main Exam without updating anything. Candidates are advised to check this even though it is a lot of work.
- EPCZ1 claim 1 does not enjoy priority of CZ1 for all the combinations. Most candidates saw this, but there

were a lot of different conclusions about what needed to be done next.

- In principle, claim 1 may be retained with multiple effective dates.
- Suggesting that claim 1) be amended to two independent claims: 1) A + X+ Y and 2) (B,C,D) + X + Y did not lose marks because the scope at the end is the same.
- Concluding that claim 1 could not be saved at all lost many marks.

DII – Q. 2

- EPFR1 provides protection for both the process, and the directly obtained product Z – Art. 64(2) EPC.
- Most candidates commented on it, but most handled the extent and possible enforcement of this protection very badly.

DII – Q. 3

- In general, Q.3 was well answered.
- The paper informs that no communications were received relating to the EP phase of PCTCZ2. The intended interpretation was either that the EPO had not sent it, or that the EPO has sent it and that GD has not received it. So FP must still be available
- There was some discussion about this because it is a little strange that the EPO had not sent the loss of rights communication almost 5 months after it occurred. They had apparently also not sent the renewal fee reminder letter, although this is a courtesy communication.
- The “closing down of the chemical synthesis department due to financial difficulties” was not a hint to consider RE (a small number of candidates considered this) – the statement “no communications were received from the EPO” was intended to mean that the whole company GD had received no communications and thus GD had not been notified. The fact that GD “decided not to enter” any national or regional phases means that all due care was not taken.
- So no points were awarded for discussing RE
- There was also some discussion on how much detail to give with regard to the FP. As entry had been completely missed, there are a lot of omitted acts. The majority did not go into great detail – a small minority (< 10 %) did discuss all omitted acts. The only disadvantage is losing time.
- The question (Q3) does give some guidance as it is directed towards substantive law rather than procedural law. Compare this with Q1, where procedural law is expected to be discussed in detail for the cream compositions.

DII – Q. 4

- Every year, this type of advice question is answered badly – most candidates can do the patentability analysis, but many have problems giving advice. This may be because it is at the end, and a lot run out of time.

8. Pre-Exam – by Roel van Woudenberg

EC IV representatives: Stefan Kastel, Stefan Götsch, and Francesco Rinaldi

- EC indicated that they are happy with the scores. Pass rate was 85 %. Pass level will stay at 70 marks. There is no statistics as to number of marks on legal and claims analysis part separately.
- A tutor provided unofficial statistics comparing main exam paper scores with pre-exam score were appreciated. The EC commented that one should not forget that candidates have one year between the pre-exam and the main exam to catch-up.
- There was only a bit of PCT in this year's pre-exam (2 statements vs. 3 full questions of 4 statements each in 2012 and 2013), but PCT remains important. The EC could not give an indication of the number of PCT questions in the coming years – the tutors expect it will be 2 or 3 questions again.

Statement 10.4

- The EC was quickly aware about a potential issue after the exam. At the tutor's meeting, the EC did not consider it appropriate to further comment, as the issue is now *res judicata*. See appeals D 2/14, D 3/14, D 4/14, D 5/15, D 6/16 available from the EPO database of case law at: <http://www.epo.org/law-practice/case-law-appeals.html>

Statement 8.2

- The EC emphasized that the questions are fully self-contained, with the question containing all information necessary to answer. So, statement 8.2 was directed to the time limit of Rule 6(1) (only), and R. 58 should not be considered.

Statement 18.4

- A question was sent in arguing that the closest prior art teaching is taken into account by the skilled person in the problem-solution approach (GL G-VII, 5.2). The EC did not agree, and indicated that touching the base by the end is essential and needs to be included in the claim to obtain the required effect – reference is made to paragraphs 3, 5, 6 and 7 of the client's letter.

Questions on inventive step,

- The style of some statements was somewhat different this year compared to the earlier two pre-exams. The EC will continue to explore ways of asking questions, and may use any style in the future. All aspects of inventive step will continue to be tested.
- A question was sent in, proposing to make a provisional Examiners' Report available shortly after the exam for comments by tutors (to spot e.g. ambiguity issues as with 10.4). However, the EC responded that there is no room for this in the tight schedule. Furthermore, there is no legal room for interference by tutors: the exam is made by the EC and issued by the EB.
- A question was sent in whether the EC can consider to accept both True as False to be correct, in case of possible ambiguities in interpretation of the question/ a statement, to prevent detrimental effects to candidates that have a different, but not incorrect, interpretation than intended by the exam EC (see e.g. the D-decisions cited above). The EC answered that they are not considering doing so, as it would water down the multiple choice test format.

epi presentations on the Unitary Patent and the Unified Patent Court

J. Gowshall (GB), member of PEC working group on UP/UPC

epi has recorded two video presentations, entitled "**epi** video update on the Unitary Patent", and "**epi** video on the Unified Patent Court". **epi** has prepared these to update our members on recent developments in both areas.

The "**epi** video update on the Unitary Patent" lasts 18 min. and the "**epi** video on the Unified Patent Court" lasts 62,43 min. Both are free of charge.

The presentations add to the information in the EPO webinar on the Unitary Patent and the Unified Patent Court. We suggest that you watch the EPO webinar before watching the **epi** presentations.

To view the EPO webinar please follow this link here: <https://e-courses.epo.org/course/view.php?id=192&lang=en>

At the time of the recordings, the participants expected the opinion of the Advocate General to issue on 21 October 2014. This has been postponed to 18 November 2014.

The speakers on the Unitary Patent are Mr Francis Leyder and Mr Chris Mercer.

The speakers on the Unified Patent Court are Mr Peter Thomsen and Mr Bart van Wezenbeek.

Please log into the members section of the **epi** website and access the videos here:

<http://www.patentepi.com/en/education-and-training/news-of-the-education/>

We think you will find them informative and interesting.

Annual **epi** Tutors' Meeting, 9 October 2014 Munich

epi Education and Training section

About 35 **epi** tutors attended the third **epi** Tutors Meeting on 9 October 2014.

We were very pleased about the successful gathering of the **epi** tutors travelling from different EPC member states to Munich.

Ms Mihaela Teodorescu, **epi** Vice-President, welcomed all participants together with Mr Paolo Rambelli, chair of the Professional Education Committee (PEC). After the welcome address of Ms Mihaela Teodorescu, Mr Wolfgang Bernhardt, chair of the newly formed PEC working group "**epi** tutors" took over in moderating the meeting.

Before starting with the first presentation Mr Wolfgang Bernhardt presented an update about the activities of tutors and coaches within 2013/2014. In addition the status of the various current projects such as the successful Candidate Support Programme (CSP) was presented by Ms Mihaela Teodorescu. This programme has been set up between EPO, CEIPI and **epi**, with the focus to support EQE candidates from countries that have less than 5 EQE-qualified professional representatives in preparing and finally passing the EQE. Further information about this very valuable programme is available here: <http://www.eqe-online.org/CSP/>

In total 13 **epi** tutors contribute to this programme at the moment, and we would like to thank them for their support and their dedication.

During the morning session, **epi** expert Mr Francis Leyder presented the latest developments of the Unitary Patent system at the EPO.

In the afternoon session participants have received an insight into didactical training presented by **epi** expert Mr Cees Mulder.

A further presentation was given by Ms Anke Allwardt, chair of the newly formed PEC working group "**epi** students and EQE candidates" presenting some ideas of this working group, how the educational programme offered by **epi** can be designed more attractive for candidates.

All presentations resulted in lively discussions and we would like to thank all presenters for their contributions.

The last part of the meeting was reserved for an open discussion between the tutors and the PEC members.

After the participants exchanged their opinions on several topics of their interest in a lively discussion, Mr Rambelli closed the meeting by thanking the tutors for their input, the speakers for their valuable contributions and the **epi** Education Team for the organisation of this event.

PEC and the Education Team would like to thank all tutors for their assistance and support throughout 2014.

Meeting of Tutors with the EQE committees, 10 October 2014 Munich

P. Pollard (NL)

One of the priorities of the European Patent Academy and its partners is to support the network of tutors preparing candidates for the European Qualifying Examination.

The annual meeting of tutors with EQE committees allows an exchange of important information about the most recent examination. Tutors can especially benefit from the direct contact with people in charge of preparing the examination papers and marking candidates' answers.

These meetings are always very much appreciated by the tutors attending, as well as the Committee members. They provide an excellent opportunity for tutors to learn more about where to put particular emphasis when training candidates for the EQE.

Committee members will answer questions and give insight in what was expected from candidates, which particular aspects were generally answered well and what went wrong more often than right.

PCT at the EPO – Conference for patent professionals and industry 1–2 October 2014 European Patent Office, The Hague

G. Arca (IT), European Patent Academy (EPO)

The conference attracted 150 patent professionals from many countries

The European Patent Academy organised, in cooperation with directorate International Legal Affairs – PCT, this event offering participants an excellent opportunity to meet senior experts from the EPO and other major patent offices, as well as from patent law firms and industry. The programme spotlighted important aspects relating to the filing and processing of applications at the

EPO in all its capacities under the PCT. In addition, the conference looked at the specifics of entering the national phases at the JPO, SIPO and USPTO.

As a leading PCT authority the EPO produces approximately 40 % of all international search reports and 50 % of international preliminary examinations reports. This conference underlined that the EPO's involvement with the PCT has always been a matter of top priority.

Boards of appeal and key decisions conference, 8 and 9 October 2014 European Patent Office, The Hague

A. Rety (FR), European Patent Academy (EPO)

Record attendance in The Hague

"Boards of appeal and key decisions" is a major EPO conference organised by the European Patent Academy. This year's edition, held for the first time in The Hague, saw a record-breaking 300 patent law professionals (up 30 % on last year) gather for two days on 8 and 9 October to listen to a range of talks and presentations given by boards of appeal chairmen and members, together with expert patent attorneys like **epi** Council member Marc Névant.

Topics covered included recent key decisions of the boards of appeal, the rules of procedure and late filings, and the question of added subject-matter. Mock proceedings were held to give participants an insight into exactly what happens at hearings.

As far as technical fields were concerned, the focus was on therapeutic and surgical methods and computer-implemented inventions, which allowed participants to explore the boundaries of patentability and technicality.

EPO legal research service staff were on hand as well to show participants – including patent attorneys, attorneys at law, corporate lawyers, judges, members of national boards of appeal and national patent office staff – how to search decisions in the board of appeal case law database.

A more detailed report of the conference is presented in this issue.

The next conference shall be organised in November 2015 in Munich.

Forthcoming **epi** educational events

epi seminars with support of the EPO

Seminar series "Opposition and Appeal"

24 February 2015 – London (GB)

10 March 2015 – Munich (DE)

14 April 2015 – Stockholm (SE)

19 May 2015 – Helsinki (FI)

Please visit our calendar of events on the **epi** website for further information.

EPO seminars with support of the **epi**

In quarter 2 2015 a seminar series on Art. 123(2) and the new Guidelines is expected to start, following up the series for EPO2DAY and GL2DAY which toured through the member states in the past years. In 2015 the EPO plans to cover 10 different cities all over Europe.

The part on Art. 123(2) EPC will cover a short theoretical background, recent caselaw and general examples, i.e. where no field-specific technical knowledge is required to comprehend them. If there is sufficient demand, field-specific examples can be covered in follow-up virtual classrooms.

For GL2DAY a few topics relating to the amended Guidelines for Examination will be dealt more in depth, with special attention being paid to the new procedures under R. 164, while a 30-minute session will be reserved for a general presentation of the practice changes which are not included by the Guidelines, but nevertheless relevant to professional representatives (such as the limitation to the use of handwritten amendments).

For any updates and developments concerning **epi** education and training offers we kindly refer to visit our website www.patentepi.com or contact the **epi** Education Team by email education@patentepi.com.

Seminar "Opposition and Appeal" in Eindhoven well attended

B. van Wezenbeek (NL)

The yearly EPO-**epi** seminar in Eindhoven was held on 21 November 2014. This time, it was directed to the topic of 'Opposition and Appeal' which was presented by Marcus Müller, a member of the Board of Appeal at the EPO, and Cees Mulder, who spoke on behalf of **epi**.

The speakers did an excellent presentation on the subjects. Marcus Müller explained the procedures from a legal and EPO point of view, while Cees Mulder interrupted with pertinent questions and practical advice. This approach not only was entertaining, but also provided interesting practical information. The many questions from the audience added further value to the learning experience.

All relevant stages in the procedure got attention, starting with admissibility and terminating with special situations after the decision (such as apportionment of



costs). This gave a good overview, which was moreover supplemented with references to relevant articles, rules, decisions and to the guidelines. Significant attention was paid to amendments, and of course to late filings, especially in view of the Rules of procedure of the Boards of Appeal. The seminar helps attendants to set

out a strategy for opposition and appeal proceedings and be well prepared from the beginning.

The seminar was attended by about 150 **epi** members from The Netherlands, Belgium, Luxembourg, Germany and the UK. With this it is one of the most successful events of the **epi** education team. The "Opposition and Appeal" seminar will be continued in 2015 in other European cities: (please see "forthcoming **epi** educational events" above).

Results of the 2014 European Qualifying Examination

Statistics on the results of the 2014 EQE

Number of candidates per country and passes pursuant to Article 14(1) of the Regulation on the European qualifying examination (REE)

Place of residence	Total number of candidates	Pass
AL	0	0
AT	25	7
BE	34	11
BG	0	0
CH	63	15
CY	0	0
CZ	2	1
DE	700	174
DK	50	10
EE	0	0
ES	73	8
FI	51	8
FR	171	58
GB	153	66
HR	0	0
IE	2	2
IS	0	0
IT	98	16
LT	0	0

Place of residence	Total number of candidates	Pass
LV	0	0
MC	1	0
MK	0	0
MT	1	0
NL	77	27
NO	12	2
PL	24	4
PT	2	0
RO	3	0
RS	0	0
SE	87	21
SK	0	0
SM	0	0
TR	13	1
IL	1	0
JP	1	0
SG	1	0
US	2	2
Grand Total	1647	433

Information source: <http://www.epo.org/learning-events/eqe/statistics.html>

Candidates are free to choose which paper(s) they wish to sit. Candidates who have only sat a sub-set of papers cannot fulfil the conditions of Article 14(1) REE (ie have obtained the minimum grades for all four papers) and thus cannot be included in this table.

Example: A candidate has only sat papers A and B and passed both papers. Nonetheless the conditions of Article 14(1) REE are not yet fulfilled and this candidate is not included in this table.

This table includes all candidates who fulfil the conditions of Article 14(1) REE.

Nächster Redaktions- schluss 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 **13. Februar 2015**. 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 **13th February 2015**. 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 **13 février 2015**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

List of Professional Representatives as at 31.10.2014

by their place of business or employment in the Contracting states

Contr. State	Number Total	% of Total Repr.
AL	18	0,16
AT	134	1,18
BE	211	1,87
BG	64	0,57
CH	522	4,61
CY	11	0,10
CZ	92	0,81
DE	4019	35,53
DK	251	2,22
EE	26	0,23
ES	192	1,70
FI	179	1,58
FR	1053	9,31
GB	2096	18,53
GR	24	0,21
HR	26	0,23
HU	72	0,64
IE	71	0,63
IS	21	0,19
IT	507	4,48

Contr. State	Number Total	% of Total Repr.
LI	22	0,19
LT	26	0,23
LU	20	0,18
LV	19	0,17
MC	5	0,04
MK	26	0,23
MT	5	0,04
NL	484	4,28
NO	102	0,90
PL	307	2,71
PT	40	0,35
RO	53	0,47
RS	51	0,45
SE	395	3,49
SI	29	0,26
SK	31	0,27
SM	21	0,19
TR	88	0,78
Total:	11313	100,00

Internship for patent professionals Praktika Intern 2015 – working with examiners

16 June–3 July 2015
European Patent Office, The Hague

The Praktika Intern programme is designed for professional representatives working in private practice or industry with experience in drafting and prosecuting European patent applications. Interns spend three weeks in Directorate-General 1, which is responsible for search, examination and opposition. They have the opportunity to work on actual case files and run prior-art searches. In

this way, participants will get the chance to look at their daily work from the viewpoint of EPO examiners and gain valuable insights into how the EPO works.

For more information, please see the Official Journal November 2014: OJ EPO 2014, A110

The closing date for applications is 30 January 2015.

Contact Data of Legal Division

Update of the European Patent Attorneys database

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

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

European Patent Office
Dir. 5.2.3
Legal Division
80298 Munich
Germany

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Fax: +49 (0)89 2399-5148
legaldivision@epo.org
www.epo.org

Thank you for your cooperation.

Next Board and Council Meetings

Board Meetings

92nd Board meeting on March 7, 2015 in Belgrade (RS)
 93rd Board meeting on September 19, 2015 in Porto (PT)
 94th Board meeting on March 12, 2016 in Tallinn (EE)

Council Meetings

78th Council meeting on April 25, 2015 in Barcelona (ES)
 79th Council meeting on November 14, 2015 in Cologne (DE)
 80th Council meeting on April 30, 2016 in Athens (GR)

Annual Subscription 2015

The invoices regarding the **epi** membership fee 2015 will be sent at the beginning of January 2015. Please note that **every member** will receive an invoice, even if a direct debiting mandate via the EPO account is set up with **epi**.

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- The form to set up/amend/delete a direct debiting mandate can be found on our website (www.patentepi.com).
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João Pereira da Cruz
 Secretary General



Institut der beim Europäischen Patentamt zugelassenen Vertreter
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Einzugsermächtigung

Eingangsfrist im
epi Sekretariat:

15. Februar 2015

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (**epi**) wird hiermit ermächtigt, den jeweils gültigen **epi** Jahresmitgliedsbeitrag für das genannte Mitglied einzuziehen. Der Einzug erfolgt einmalig am 25. Februar des laufenden Jahres von dem nachfolgend anzugebenden Konto beim Europäischen Patentamt (EPA). Die Einzugsermächtigung wird wirksam beginnend mit dem Jahresmitgliedsbeitrag **2015** und gilt für künftig fällige Mitgliedsbeiträge bis auf schriftlichen Widerruf. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem **epi** getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen werden dem Einzug des **epi** Beitrags vorgezogen. Bitte stellen Sie sicher, dass im Abbuchungszeitraum Ihr EPA Konto über eine ausreichende Deckung verfügt. Wir weisen Sie darauf hin, dass bei unzureichender Deckung der komplette Abbuchungsauftrag nicht ausgeführt werden kann. Der Kontoinhaber und jedes **epi** Mitglied werden darüber schriftlich in Kenntnis gesetzt.

☐ Ich stimme den oben genannten Bestimmungen zu.

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Deadline for receipt by the
epi Secretariat:

15 February 2015

The Institute of Professional Representatives before the European Patent Office (**epi**) is hereby authorised to debit the **epi** annual subscription for the member named below at the appropriate rate. This direct debit occurs once on February 25 of the current year from the deposit account held with the European Patent Office (EPO) as specified below. This direct debiting mandate applies to the membership fee **2015** and the forthcoming subscriptions until it is revoked in writing. Debiting will be done on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the **epi** (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

All fees and costs payable to the EPO on the debiting date have priority over the **epi** subscription. Please be sure that during the period of time surrounding the time of the debit order there are sufficient funds in your EPO account to cover the entire debit order. Kindly note that a partial coverage will prevent the entire debit order from being carried out. In such cases, the holder of the account as well as each **epi** member involved will be informed in writing.

☐ I agree with the stipulations sited above.

Autorisation de prélèvement

Date limite de réception au
Secrétariat de l'**epi**:

15 février 2015

L'Institut des mandataires agréés près l'Office européen des brevets (**epi**) est autorisé par la présente à prélever le montant en vigueur de la cotisation annuelle de l'**epi** pour le membre dont le nom figure ci-dessous. La présente autorisation de prélèvement sur le compte ouvert à l'Office européen des brevets (OEB) prend effet une seule fois le 25 février de l'année en cours. Cette autorisation de prélèvement vaut pour la cotisation **2015** ainsi que pour les cotisations suivantes jusqu'à révocation par écrit. Le prélèvement est opéré sur la base des dispositions de l'accord administratif en date du 5 avril 1993 entre l'OEB et l'**epi** (JO OEB 1993, 367) ainsi que de celles du point 9 de la décision modifiant la réglementation applicable aux comptes courants (JO OEB 1993, 366).

Le règlement de toutes les taxes et de tous les frais dus à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle de l'**epi**. Veuillez vous assurer que votre compte à l'OEB est suffisamment approvisionné pendant la période de débit. Nous attirons votre attention sur le fait que l'ordre de débit sera refusé dans sa totalité si le compte n'est pas suffisamment approvisionné. Dans ce cas, le titulaire du compte ainsi que chaque membre de l'**epi** seront informés par écrit.

☐ J'accepte les conditions mentionnées ci-dessus.

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epi Artists Exhibition 2015

The **epi** Artists Exhibition of **epi** Artists has become a tradition in the cultural life of the **epi** and of the EPO. The forthcoming exhibition is planned to take place from

2 March to 13 March 2015

at

European Patent Office

PschorrHöfe building

Bayerstrasse 34, Munich.

We would like to take the opportunity to thank those persons who have already addressed their participation and would like to invite all creative spirits among the **epi** membership from various countries to join in the exhibition.

Please note that all contributions to the **epi** Artist Exhibition have to respect religions and beliefs, political views and take into consideration that children might be visiting the exhibition. Furthermore it is emphasised to present no extensive or heavy exhibits and you are kindly asked to abstain from light effects or video/audio art.

For information please contact:

epi Secretariat

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Issue

Deadline

Publication

1/2015

13 February, 2015

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2/2015

8 May, 2015

30 June, 2015

3/2015

7 August, 2015

30 September, 2015

4/2015

6 November, 2015

31 December, 2015

Note from the Editorial Committee – Guidelines for authors

M. Nollen (NL)

The **epi** Information is a regular publication sent to more than 11,000 Professional Representatives before the EPO. With the object of maintaining and improving quality of the **epi** Information, the Editorial Committee has adopted following Guidelines for authors.

Introduction

The **epi** Information is a regular publication sent to nearly 12,000 potential readers. Nearly all of those – more than 11,000 – are the Professional Representatives before the EPO, which are members of the **epi**. It goes without saying that such a large audience has the right to a publication that meets the standards of quality that our Profession is proud to represent.

In view thereof, the Editorial Committee has adopted following Guidelines for authors. These Guidelines are intended for supporting authors in drafting papers and will be used by the Editorial Committee in reviewing draft papers. They are intended as the “Rules of Procedure of the Editorial Committee”.

Contents

1. Contributions to the **epi** Information are addressed to Professional Representatives before the EPO. This applies to level of background knowledge, content and the international character of the audience.
2. Contributions to the **epi** Information may be news and information from the **epi**, articles, book reviews, letters and announcements. The articles and book reviews focus on European patent practice in its widest sense, including information on other jurisdictions deemed relevant for European patent practice.
3. Announcements include announcements from the European Patent Office, from other professional, non-commercial organisations in the field of intellectual property and from further third parties. Announcements from further third parties will be considered as advertisement, unless the editorial committee decides otherwise.

Format of contributions

1. Articles may be submitted in English, French or German. Articles shall contribute to the permanent education of Professional Representatives.
2. Articles shall have a maximum length of 3000 words. The Editorial Committee may decide to allow longer articles if it is of the opinion that the article is highly relevant and the length is appropriate for the content.
3. Articles shall start with an abstract in English. A French and German translation of the abstract shall be published at the end of the article. Support may be provided for such translation.
4. Articles shall address a point of law, of procedural or material nature. Articles shall end with a conclusion or discussion section, providing a summary of the reasoning of the article.

5. Reference to Case Law of the Board of Appeal is highly preferred, where an article addresses a subject of European Patent Practice. When addressing Case Law, the article shall contain an analysis or summary of one or more relevant decisions, such that this decision can be followed by a Professional Representative without reading it in detail.

Format of other contributions

1. Other contributions shall be in English.
2. Letters shall have a length of at most 500 words. Book reviews shall have a length of at most 1200 words (2 pages in the **epi** Information). Announcements shall have a length of at most 600 words (1 page in the **epi** Information). The Editorial Committee may decide to deviate from these maximum lengths, or to shorten a contribution.
3. Such contributions shall be informative, clear and not longer than appropriate in respect of their content.

Role of editorial committee

1. The Editorial Committee is responsible for the content of the **epi** Information. It may invite **epi** members and others to provide a contribution on a subject deemed relevant.
2. The Editorial Committee decides on publication of a contribution. A contribution will be (a) accepted as such (b) conditionally accepted if amended to meet the guidelines (c) likely accepted if rewritten (d) refused.
3. The Editorial Committee will inform authors of its decision. When conditionally accepting a contribution, the Editorial Committee may do amendment proposals. When requesting rewriting, the Editorial Committee shall provide a reasoned statement with suggestions. When refusing, the Editorial Committee shall provide a reason.
4. Refusal of a contribution is to be foreseen when the contribution would offend morality, is of a clearly commercial nature and/or is not relevant to European patent practice in its widest sense. Refusal shall also be foreseen for any contribution constituting a complaint to a decision of the EPO in relation to a specific case in which the author or his firm was involved as a representative. A contribution may furthermore be refused for editorial reasons, for instance if several contributions on a single subject are submitted.
5. When taking decisions, the Editorial Committee shall not merely address quality or brilliance, but also shall provide a forum for any opinion on European Patent Practice, particularly from the community of Professional Representatives.
6. Decisions of the Editorial Committee are not open to debate or discussion.

Lack of clarity, a new approach in case law?

T. Godemeyer (DE)

1. Introduction

The Board of Appeal 3.2.8 of the European Patent Office has referred a case to the Enlarged Board of Appeal to clarify the question whether lack of clarity of a claim can be examined in opposition proceedings.

With regard to this question there is a divergence in the decisions of the Board of Appeal. On the one hand, Art. 100 EPC does not include lack of clarity as a ground of opposition. On the other hand, it is established case law that, if amended claims are submitted in opposition proceedings, they have to be examined for all requirements of the European Patent Convention including the requirement of clarity of the claims.

The Board of Appeal 3.2.8 referred the case T 373/12 to the Enlarged Board of Appeal to clarify the question whether lack of clarity of an amended claim may be examined in opposition proceedings. At present there is a divergence in the decisions of the Boards of Appeal. Some decisions only allow the examination of clarity in case there is a substantial amendment to the claim. Other recent decisions come to the conclusion that any amendment to a claim has to be examined during opposition proceedings.

The case is pending under G 3/14 and the questions referred to the Enlarged Board of Appeal are the following:

1. Is the term "amendments" as used in decision G 9/91 of the Enlarged Board of Appeal (see point 3.2.1) to be understood as encompassing a literal insertion of (a) elements of dependent claims as granted and/or (b) complete dependent claims as granted into an independent claim, so opposition divisions and Boards of Appeal are requested by Article 101(3) EPC always to examine the clarity of independent claims thus amended during the proceedings?
2. If the Enlarged Board of Appeal answers question 1 in the affirmative, is then an examination of the clarity of the independent claim in such cases limited to the inserted features or may it extend to features already contained in the unamended independent claim?
3. If the Enlarged Board answers question 1 in the negative, is then an examination of the clarity of independent claims thus amended always excluded?
4. If the Enlarged Board comes to the conclusion that an examination of the clarity of independent claims thus amended is neither always required nor always excluded, what then are the conditions to be applied in deciding whether an examination of clarity is indicated in a given case?

2. Legal Basis

The legal basis for the requirement of clarity can be found in Art. 84 EPC. This article states that claims shall define the matter for which protection is sought and shall be clear and concise and be supported by the description.

The requirement of clarity is an important requirement for patent claims because according to Art. 69 EPC the claims define the extent of protection of a granted patent. Therefore it is important that the wording of such claims is clear so that the patentee as well as third parties, who may be competitors of the patentee, can exactly understand what kind of embodiments fall under the patent.

Lack of clarity is not a ground for opposition according to Art. 100 EPC. The reason for this is that clarity of the claims is examined during examination proceedings of the EP patent application. However, this only applies to the granted patent and not to any amendment of the patent with limited claims which might come about during opposition or appeal proceedings by request of the patentee.

As a consequence, Art. 101(3) EPC states that, if in opposition proceedings a patent is amended by the proprietor, this patent can only be maintained in the amended form if the amendments meet the requirements of the EPC and the conditions laid down in the implementing regulations.

From this wording of Art. 101(3) EPC can be deduced that amendments of claims in opposition or appeal proceedings have to be examined even for the requirement of clarity although lack of clarity is not a ground of opposition.

The question, however, is now how the term "amendments", as used in Art. 101(3) EPC, has to be interpreted in the light of any change of a granted claim.

3. Possible Amendments in Opposition Proceedings

In opposition and appeal proceedings the proprietor of a patent can amend a granted claim in many several ways:

- They can, for example, amend an independent claim by introducing features from a dependent claim, several dependent claims or parts of dependent claims or parts of several dependent claims as granted.
- They can furthermore add elements or features of the application as originally filed.
- Moreover, they can also restrict independent claims by removing or exchanging or adding specific features from a claim.
- Furthermore, they can amend a claim by any combination of the above possible limitations.

All this can be done assuming that the other formal requirements of the EPC like Art. 123 (2) and (3) EPC are met.

Thus it is evident that claims in opposition proceedings can be restricted in many different ways and not only by including dependent claims or parts of dependent claims as granted in the independent claim (see also question 1 of the referral to the Enlarged Board of Appeal).

4. Does the present case law of the Boards of Appeal fit with the legal situation on the question of clarity?

In my opinion the present case law of the Boards of Appeal does not perfectly fit with the legal frame of the EPC regarding clarity of claims. In the following I will give some arguments for this allegation.

There are several cases of the Board of Appeal, also mentioned in the decision T0373/12, interpreting the term “amendment”, used in Art. 101(3) EPC, in a narrow manner.

The decision T301/87 did not allow objections based on Art. 84 EPC unless arisen out of the amendments made. In view of this decision it would seem absurd if making a minor amendment could enable objections outside the grounds of opposition according to Art. 100 EPC.

It seems to me that this approach restricts the competence of the Board of Appeal to only examining the amended text of an amended claim. However, features or parts of the claims not changed by the amendments are not allowed to be examined.

A similar view is taken in the decisions T367/96, T472/88, and T381/02.

A further but similar approach is taken in the decision T1855/07. In this decision it is stated that basically an examination of clarity did not come into question where a dependent claim as granted was inserted literally into an independent granted claim. As a further argument the decision states, it is the nature of the dependent claim that it protects a specific embodiment of the invention already defined in the independent claim. Therefore, a dependent claim protects exactly the same embodiment as one in which the reference has been replaced by the complete content of the independent claim.

Similarly, the decision T381/02 also comes to the conclusion that the term “amendment”, as referred to in the Enlarged Board’s decision G9/91, always is to be understood as a substantial amendment and not a mere combination of the respective wording of the independent and dependent claims as granted. This conclusion is based on the understanding that all claims are systematically examined by the Examining Division for the criterion of clarity. Therefore, it follows that in oppositions the opposition division or the Board of Appeal does not have the power to repeat this examination. A similar approach is taken in the decisions T1459/05 and T1440/08.

In summary, it can be concluded that all these decisions interpret the term “amendment”, as used in the decision G9/91 and in Art. 101(3) EPC, in a very narrow way. As a result the examination of clarity in opposition proceedings for an amended set of claims is limited to the text changed in these claims or, as an allowed exception, in case an independent and a dependent granted claim are combined and by this combination a new problem of clarity is caused that did not exist previously in the adopted part (T381/02).

In my view this interpretation of the term “amendment” by the previous case law is too restrictive and not justified by the content of decision G9/91 or any Article or Rule of the EPC.

Particularly in view of the fact there being numerous possibilities for a patentee to limit their independent claims in opposition proceedings (see above), I consider it pointless and not legally justified to differentiate between certain amendments permitting examination of clarity and other amendments not permitting examination of clarity.

Art. 101(3) EPC is about amendments made by the proprietor of the European patent. Art. 101(3)(a) EPC states that, if the finding of the Opposition Division is that the patent and the invention it relates to meet the requirements of the convention, it shall decide to maintain the patent as amended. Looking at this wording it seems that amendments cannot be interpreted in such a narrow way as done by the previous case law. The previous interpretation of the term “amendment” is only based on case law and is not supported by any specific article or rule of the EPC.

One of the arguments justifying the present practice is that in the examination proceedings the clarity of all claims is systematically examined in a very strict way. However, a closer look at this argument reveals that this is actually not the case. In practice and according to my experience the clarity of independent claims is strictly examined during examination of a patent application. However, this does not equally apply to the subclaims. In practice subclaims are not examined in the same strict way as independent claims. Additionally, it is in my opinion not even possible to examine the clarity of a subclaim with multiple dependencies if it is not clear which of the other dependent or independent claims are combined with this subclaim.

In my view, clarity of subclaims can only be examined if it is apparent how these subclaims are combined with other independent or dependent claims. In practice therefore only the wording of a subclaim is more or less examined in the examination proceedings for the requirement of clarity, if at all, and not the combination of a specific subclaim with a specific independent claim. Hence, the assumption that, for example in decision T1459/05, all independent and dependent claims are examined for the requirement of clarity during the examination proceedings is not correct. Contrary to the opinion and several decisions of the Board of Appeal, subclaims are not fully and strictly examined in examination proceedings. This is not at all possible as it is unclear

how these subclaims are combined with other independent or dependent claims.

A further argument against the previous case law is that it is, in my view, not justified that a patentee amending their claims in opposition proceedings, for instance by combining an independent granted and a dependent granted claim, is treated in a better way than an applicant doing the same during the examination proceedings. If during the examination proceedings an independent and a dependent claim are combined the combination is examined with regard to clarity. If the same is done in opposition proceedings the resulting claim would not be examined for clarity. This is only justified by the assumption that the separate independent claim and the subclaim in the granted form have already been examined for the requirement of clarity during the examination proceedings. However, this is not the case (see above).

Another argument is that, if claims are amended, the restriction for the Opposition Division or the Board of Appeal to examine clarity only in case of substantial amendments is as such unclear since the question whether or not an amendment is actually substantial depends on the subjective opinion of the Opposition Division or the Board of Appeal deciding on an appeal case in an opposition.

This gives way to legal uncertainty for all parties in the opposition proceedings. In my view, the superior goal should be to grant a patent or to maintain a patent in the amended form having a distinct scope of protection defined by the claims. This is important to the patentee as well as third parties like competitors and leads to legal certainty. However, this goal is not achieved if, based on a subjective assessment, examination of clarity is either allowed or denied. Considering this context, I believe it makes no sense to examine only the changed wording of an amended claim whilst ignoring the question whether the complete claim is clear and defines the scope of protection clearly after a change of the wording.

Therefore I am of the opinion that the term “amendments” should be interpreted broadly and should cover

any amendment of a claim and not only a change of certain text passages of a granted claim.

Insofar I support the opinion of the recent case law as for example in T459/09 and in T409/10. In my view, Art. 101(3) EPC grants the Opposition Division or the Board of Appeal unlimited power to examine the clarity of a granted claim which has been amended somehow by either including elements from granted dependent claims or by including complete dependent claims or by adding elements of the originally filed application or removing features from a claim or by any combination of the above four possibilities.

As a consequence I suggest answering the four questions referred to the Enlarged Board of Appeal as follows.

Question 1:

The term “amendments” is interpreted in a broad way as defined by Art. 101(3)(a) EPC with the consequence that any amendment of a granted claim has to be examined with respect to clarity. This also applies to the amendments mentioned in question 1. Therefore question 1 has to be answered in the affirmative.

Question 2:

In my view the examination of clarity should not be limited to the inserted features of an independent claim. It should rather extend to features already contained in the unamended independent claim. I am of the opinion that the examination of clarity only makes sense if the entire claim is examined. Art. 84 EPC is not limited to inserted features of an amended claim.

Question 3:

The answer is superfluous because the answer to question 1 is not negative.

Question 4:

As the examination of clarity of an amended independent claim is always required, the answer to question 4 is also superfluous

Report on the „EPO boards of appeal and key decisions“ conference held in The Hague on 8–9 October 2014,

M. Nevant (FR) – European Patent Attorney

NB: the views expressed in this report are those of the author only.

The now annual conference on the case law of the Boards of Appeal was held this year in The Hague. The following topics were addressed during this two-day event (it is believed that the presentations will be made publicly available by the EPO Academy next year).

Day 1

1. Opening speech

The participants to the conference were welcomed by Mr Wim van der Eijk, Vice President of DG3. Mr van der Eijk reported on the efforts made by the Boards of Appeal to increase efficiency (understand: productivity) and reduce the backlog of cases. For example, the number of cases completed in 2013 was substantially the same as the number of new cases received.

2. Late requests – Mr Hugo Meinders (Chairman of Board of Appeal 3.2.07)

Mr Meinders' presentation essentially focused on the implementation of Articles 12(2), 12(4), 13(1) and 13(3) of the Rules of Procedures of the Boards of Appeal (RPBA).

- According to Art. 12(2) the parties should file their complete case at the first exchange; parties should not expect the Board to do their work.
- According to Art. 12(4) everything presented at the first exchange is taken into account, and earlier preparation of submissions (i. e. before an examining division or an opposition division) is crucial: in particular, the Board has the power not to admit in the appeal proceedings requests which could have been presented or were not admitted in the first instance proceedings.
- According to Art. 13(1) any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia:
 - the complexity of the new subject-matter submitted,
 - the current state of the proceedings and
 - the need for procedural economy.
- According to Art. 13(3), anything filed after issue of the summons is not admitted if it cannot be dealt with by the Board or the party without adjournment of the proceedings.

Although the way late filed requests are handled may vary from one Board of Appeal to another, the political will to increase the productivity of the Boards of Appeal may have far reaching consequences for the users of the system. Thus, although not mentioned by Mr Meinders,

the Boards of Appeal seem to show a desire to act more as a pure second instance reviewing the correctness of the first instance decision.

3. Added subject-matter – Mr Fritz Blumer (Legally qualified member of the Boards of Appeal)

Mr Blumer reviewed the allowability of amendments in the context of decision T612/09 (dosage regimen claims).

Mr Blumer then discussed the “reservoir theory” (according to which the originally filed application is a reservoir of information for amendments) as set out in T190/83 and further discussed e.g. in T305/87 and more recently in T1544/08 and T1799/12.

Mr Blumer also reviewed decisions dealing with disclaimers (T2464/10, T1870/08, T748/09, T1836/10, T1489/09) in the light of G1/03 and G2/10 [NB: G2/10 has raised the bar quite high with respect to the admissibility of disclaimers].

Mr Blumer finally reviewed T500/11, a decision dealing with intermediate generalization based on the examples (the principles set out in T962/98 are still applicable).

The conclusion that can be drawn from this presentation is that there is nothing new under the sun. The EPO still applies very strict criteria when assessing whether the requirements of Art. 123(2) EPC are fulfilled.

4. Mock trial

In the afternoon of day 1, mock oral hearings were held. This concerned an appeal by the Opponent against the decision of the Opposition Division to maintain EP1562352 in amended form.

Composition of the Board: Mr Alec Clell and (former Chairman of Board of Appeal 3.5.03), Mrs Marie-Bernardette Tardo-Dino (Legally qualified member of the Boards of Appeal) and Mr Bernhard Noll (Technically qualified member of the Boards of Appeal).

Representative for the Proprietor: Mr David Molnia, EPA.

Representative for the Opponent: Mr Markus Herzog, EPA.

The mock trial gave a really good overview of what can happen during oral proceedings, for example:

- Change of language at the start of the proceedings.
- Attempt to record the proceedings by one of the parties.
- Late filed submissions/requests/documents.

The trial was interrupted at regular intervals by the “mock” Chairman to explain the Board's process to reach a decision on the various requests on file. Mr Clell

and also stressed that the way to formulate requests is very important.

The mock trial was quite entertaining and a pleasant way to conclude day 1 of the conference. This was also a nice opportunity for representatives, who are not given many opportunities to attend oral proceedings, to get a better understanding of how events can unfold during such proceedings.

Day 2

5. Highlights of EPO case law – Mrs Petra Schmitz (Legally qualified member of the Boards of Appeal)

Mrs Schmitz first discussed R19/12 in which the petitioner objected to the Chairman of the EBA on the grounds of suspected partiality based on the following grounds:

- The Chairman of the EBA must rule on administrative acts for which he was responsible in his former position as a senior member of the EPO management.
- As VP DG3 he is still involved in the management of the EPO.

The EBA found that the objection of suspected partiality was justified and the Chairman of the EBA was replaced [NB: “suspected partiality” does not mean “partiality”]. In the aftermath of the decision the Chairman of the EBA stepped aside from active participation in the governing bodies of the EPO.

Mrs Schmitz then discussed G1/12 (“Correction of the appellant”). In that decision the EBA indicated that an incorrect designation of the appellant may be corrected under Rule 101(2) EPC or Rule 139 EPC (NB: the requirements set out in these rules must of course be satisfied).

Mrs Schmitz finally discussed two decisions dealing with re-establishment of rights in the context of /unpaid renewal fees: J5/13 and J1/13.

The first decision (J5/13) sets very high standards to be met by professional representatives even when they are not in charge of the payment of renewal fees. It is indeed questionable whether a professional representative should bear an “all due care” burden when an applicant decides to pay renewal fees on its own (or via a company specialized for that purpose).

5. Split workshops

1/ Exclusion of therapeutic and surgical methods: where do we stand – Mr Albert Lindner (Chairman of Board of Appeal 3.3.01).

2/ Exploring the borders of technicality: computer-implemented inventions – Mr Dai Rees (Chairman of Board of Appeal 3.5.06).

3/ On a quest for knowledge: searching the EPO board of appeal decisions – Mrs Barbara Dobrucki and Mr Frédéric Bostedt (EPO lawyers).

In the last session the speakers provided helpful tips and advice to search the database of the Boards of Appeal.

6. Sufficiency of disclosure: how much is enough? – Mr Marc Névant (EPA)

Mr Névant first reviewed what he considered to be “key” decisions (T409/91, T435/91, T792/00, G1/03) setting out the principles of how sufficiency of disclosure is assessed.

Mr Névant then essentially focused on decisions dealing with the sufficiency of disclosure of (i) claims including parameters and (ii) medical use claims. The decisions on “parameters” showed that the outcome is very much decided on a case-by-case basis, hence predictability for such cases is (regrettably) low. The decisions on “medical use” are, conversely, quite consistent in terms of the information needed to satisfy the requirements of Art. 83 EPC.

Mr Névant ended his presentation by reviewing selected decisions by French courts.

7. Crystal clear? The Article 84 issue – Mr Marco Alvazzi Delfrate (Technically qualified member of the Boards of Appeal)

Mr Alvazzi Delfrate started his presentation by “refreshing” our memories with T68/65 (“synergistic effect”) in which the Board held that a feature must be defined in the objectively most precise form, without unjustifiably limiting the scope of the invention or unacceptably restricting protection.

Mr Alvazzi Delfrate then explained why, in his view, there is no clarity test applied by instances of the EPO. He quoted two decisions (T971/10, T637/01) in which the term “substantially” was held in one case to be unclear and clear in the other case.

Mr Alvazzi Delfrate then reviewed decision T1271/05 in which the Board held that a claim has to clear from its own wording (except in the case where the description provides unambiguous definitions of certain terms and makes clear that the definitions apply throughout the complete application).

Mr Alvazzi Delfrate then cited decisions (T18/08, T608/07, T2403/11) in which issues arising under Art. 84 EPC are in fact discussed under Art. 100(b) EPC in opposition proceedings.

Mr Alvazzi Delfrate concluded his presentation by reviewing the case law that led to referral G3/14 which (we have been told during the conference) has been given top priority by the Enlarged Board of Appeal.

It turns out that in practice, the clarity of all dependent claims is not systematically examined by Examining Divisions. The decision of the EBA might therefore have a critical impact on opposition proceedings. In the event the EBA decides that the clarity of a combination of a granted independent claim with a granted dependent claim must always be examined, then Opposition Divisions and Boards of Appeal will have a dreadful tool to revoke patents without having to look into the substance (i.e. novelty and inventive step) of a claimed invention. Let’s hope that the EBA will strike a fair balance preserving the interests of both opponents and proprietors.

Amicus curiae brief of epi concerning case G 3/14

R. Jorritsma (NL)

Referral G3/14 is of great interest to all of us. **epi** finally filed an amicus curiae brief prepared by the EPPC after a short but intense debate, as some of us had different opinions. We thought it useful to share it with you. , R. Jorritsma (NL)

Summary

epi generally agrees with the position of the President of the EPO expressed in his comments of 11 August 2014, but has some additional points regarding the application of Article 84 EPC and Rule 80 EPC in opposition proceedings.

G3/14

In Decision T 373/12 Technical Board of Appeal 3.2.08 ("the TBA") referred to the Enlarged Board of Appeal ("the EBA") the four following questions:

1. Is the term "amendments" as used in decision G 9/91 of the Enlarged Board of Appeal (see point 3.2.1) to be understood as encompassing a literal insertion of (a) elements of dependent claims as granted and/or (b) complete dependent claims as granted into an independent claim, so that opposition divisions and boards of appeal are required by Article 101(3) EPC always to examine the clarity of independent claims thus amended during the proceedings?
2. If the Enlarged Board of Appeal answers Question 1 in the affirmative, is then an examination of the clarity of the independent claim in such cases limited to the inserted features or may it extend to features already contained in the unamended independent claim?
3. If the Enlarged Board answers Question 1 in the negative, is then an examination of the clarity of independent claims thus amended always excluded?
4. If the Enlarged Board comes to the conclusion that an examination of the clarity of independent claims thus amended is neither always required nor always excluded, what then are the conditions to be applied in deciding whether an examination of clarity comes into question in a given case?

Background

The questions raised by the TBA relate to Articles 100 and 101 EPC. Article 100 EPC limits the grounds on which a patent as granted may be attacked and excludes any ground equivalent to Article 84 EPC. Article 101(2) EPC confirms that an (unamended) patent can only be revoked on the basis of the grounds set out in Article 100 EPC and thus cannot be revoked for failure to meet the requirements of Article 84 EPC.

However, Article 101(3)(a) EPC provides that, if a patent is amended during opposition proceedings, the patent shall be maintained if "... the patent and the invention to which it relates ... meet the requirements of this Convention ...". Article 103(3)(b) EPC provides that

the patent will be revoked if "... the patent and the invention to which it relates ... do not meet the requirements of this Convention ...".

It is noticeable that, whereas Article 101(2) EPC refers to the grounds set out in Article 100 EPC, Article 101(3)(a) and (b) EPC refer to meeting the requirements of "this Convention".

The question which then arises is whether the reference to "this Convention" in Article 101(3) EPC includes a reference to Article 84 EPC and thus requires the Opposition Division to consider whether a patent which has been amended during opposition proceedings meets the requirements of Article 84 EPC.

epi considers that the wording of Article 101 EPC is clear and thus requires that, once a patent is amended during opposition proceedings, it has to be examined to see whether it meets the requirements of Article 84 EPC.

This is consistent with the *obiter dictum* made by the EBA in Section 19 of the Reasons in Decision G9/91, which appears to indicate that, in principle, once a patent is amended in opposition proceedings, the amended patent should be examined to see whether it meets the requirements of the Convention. Section 19 refers to Article 123(2) and (3) EPC, but this appears to be an example of the Articles in the Convention which need to be considered.

As the referring TBA has made clear, there is also a question as to what constitutes an amendment. Article 101(3) EPC itself does not indicate that there may be different types of amendments. In **epi**'s view, in principle, the requirement to examine whether the amended patent meets the requirements of the Convention applies whatever the amendment may be.

Certainly, if an independent claim is amended by the incorporation of part of a dependent claim or a feature from the description, then the Opposition Division or the TBA dealing with an appeal is presented with a new constellation of features not contemplated by the claims as granted. In such a case, **epi** considers that it will be necessary to determine whether the amended independent claim meets the requirements of the Convention.

It could be questioned whether this applies to dependent claims. Should the totality of a dependent claim be incorporated into an independent claim on which it was originally dependent, the question comes up whether this requires an examination of whether the amended independent claim fulfils the requirements of the Convention. As a dependent claim necessarily incorporates all the features of the claim on which it is dependent, it could be said that incorporating the features of the

dependent claim into the independent claim merely makes explicit what was already implicit in the dependent claim. If this view is taken, there has been no effective amendment to the dependent claim and so it could be argued that Article 101(3) EPC does not apply.

However, in other Decisions of TBAs, incorporation of the features of a dependent claim which is dependent on a number of higher claims into an independent claim has been examined to see whether the new independent claim meets the requirements of Article 123 EPC, on the basis that the dependencies led to the need for such examination. If this approach is correct, it would appear that such new independent claims should also be examined to see whether they meet the requirements of Article 84 EPC.

Thus, in **epi**'s view Article 101(3) EPC applies to all amendments, even if they constitute the incorporation of all the features of a dependent claim into an independent claim.

In going beyond the opinion of the President of the EPO, **epi** draws the attention to the assumption that a patent granted by the EPO meets all the requirements of the Convention. It is therefore expected that all the dependent claims meet the requirements of Article 84 EPC. For this reason, the onus of proof in opposition proceedings should rest on the opponent to make a *prima facie* case that the incorporation of all the features of a dependent claim into an independent claim on which it depends does not meet the requirements of Article 84 EPC. Merely pointing out that an amendment has been made should not be regarded as making a *prima facie* case.

The Questions

As to Question 1, **epi** does not see a fundamental difference between "*elements of dependent claims as granted*" and "*complete dependent claims as granted*" when inserted into an independent claim. The possibly implied suggestion that inserting a complete dependent claim into an independent claim would qualify the dependent claim as being a granted claim and thus being protected from an Article 84 EPC attack, does not appear to be supported by Article 101(3) EPC. The only question is whether partial or complete introduction of a dependent claim is an effective amendment of what has already been examined prior to grant and further allows Article 84 EPC issues to be raised in opposition. In **epi**'s view both partial and complete introduction allow this.

With regard to Question 2, it should be considered that a claim is either clear or it is not. It cannot be partly clear. Obviously, a clarity problem may originate from a certain term or feature, but it is only in the context of the entire definition of the claim to be decided whether the claim is clear or not. An inserted feature, which itself may or may not be clear, can and usually will have an interaction with a feature already present in the independent claim. For example, an inserted functional feature may qualify an existing structural feature to the extent that

the structural feature becomes unclear or inconsistent, rendering the claim as such unclear – see also Decision T1459/05, item 4.3, where the Board decided it should examine clarity of a claim amended by the introduction of a feature from a dependent claim, for essentially this same reason.

The question about where the limits of the examination required by Article 101(3) EPC should lie (Question 4) is an important question. First of all, the law has to be complied with. Second, care should be taken that opposition proceedings are not overly complicated with matters that could disproportionately detract from a swift and effective process to the benefit of all parties and the public at large.

The law, in the form of Article 100 EPC, states that an unamended patent cannot be examined for clarity, it being understood that such examination has been done during pre-grant examination and that this should suffice compared to the higher ranked opposition grounds of Article 100(a),(b) and (c) EPC. As noted above, it can be argued that the fundamental rule of Article 100 EPC should extend to claims which are amended with a feature or all features from a dependent claim, where such a dependent has clearly been effectively examined under Article 84 EPC during pre-grant examination and that combinations of such effectively-examined claims might therefore be considered to be unamended claims not open to examination under Article 84 EPC.

It can also be argued that the presumption of meeting the requirements of Article 84 EPC should extend to claims which are amended by incorporation of a feature from a dependent claim, where the basis for the introduced feature is already present in the same context in the unamended claim and the amendment is a straightforward limitation. For example, if the independent claim has the option of A or B, and the dependent claim limits this to A, without changing the context of A, or where the independent claim defines a numerical range and the dependent claim merely narrows the same numerical range, it could be argued that examination under Article 84 EPC is inappropriate.

It could further be argued that qualifications of the extent to which examination as to whether an amended patent meets the requirements of the Convention may be necessary so as to prevent opposition proceedings from being disproportionately burdened with formality issues. In this respect, the extent to which added matter issues under Article 100(c) EPC in conjunction with Article 123(2) EPC have grown to become a laborious and sometimes dominant element in opposition proceedings, not mirrored by its position in other jurisdictions, is an example to be taken into account.

However, since pre-grant examination under Article 84 EPC is not consistent, and is not feasible for all combinations of mutually dependent claims in many cases, it could be questioned whether there is any basis not to apply Article 101(3) EPC to even the complete introduction of a dependent claim into an independent claim. **epi** considers that the latter situation more often

applies and that this is a further reason why the scope of Article 101(3) EPC should not be construed narrowly.

epi acknowledges that, while Article 101(3) EPC requires a consideration as to whether an amended patent meets the requirements of the Convention, the Opposition Divisions and the TBAs at the EPO should take into account, *inter alia*, the situations referred to above when considering whether there is a *prima facie* relevant objection under Article 84 EPC so as to ensure that the proceedings are not burdened with clearly unsustainable objections which would unnecessarily complicate the proceedings.

Further to the comments by the President of the EPO, **epi** would also like to draw attention to Rule 80 EPC. This provides that amendments are only allowed if they are occasioned by a ground for opposition under Article 100 EPC. A strict interpretation of this provision would mean that, if a valid objection under Article 84 EPC is raised against an amended claim, it would not be possible to amend the claim to meet such an objection as such an objection would not have been occasioned by a ground of opposition. **epi** submits that such a strict interpretation should not be followed and that the wording "occasioned by" of Rule 80 EPC should be interpreted to include the notion of "directly or indirectly" so as to allow patent proprietors to further amend claims to meet valid Article 84 EPC objections following amendments made for overcoming a ground of opposition under Article 100 EPC.

The Answers

Question 1

epi considers that either type of amendment can potentially introduce or enhance issues under Article 84 EPC of an amended independent claim. Therefore, amended claims of either type should in principle be open to examination under Article 84 EPC.

Question 2

epi considers that the second option is correct: examination may extend to features already contained in the unamended independent claim.

Question 3

epi considers that this is not applicable: categorically not examining amended claims based on dependent claims is contrary to the duty under Article 101(3) EPC (which is consistent with the obiter dictum in Decision G9/91).

Question 4

epi considers that the first condition would be that there is a potential issue under Article 84 EPC in the independent claim thus amended. A second condition would be that such potential Article 84 EPC issue does not entirely and exclusively reside in the set of features of the unamended claim. If the amended feature contributes to the issue under Article 84 EPC in any way or any significant degree, the amended patent should be examined under Article 84 EPC, as required by Article 101(3) EPC.

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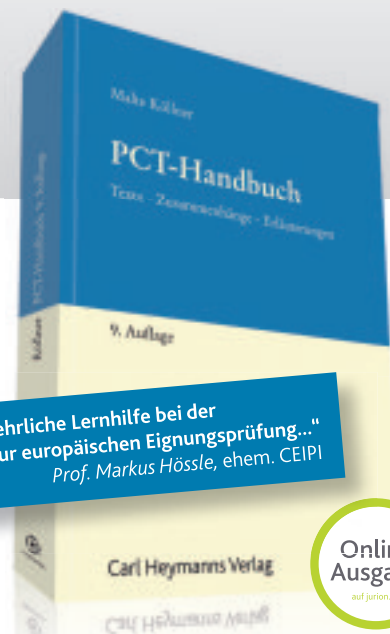
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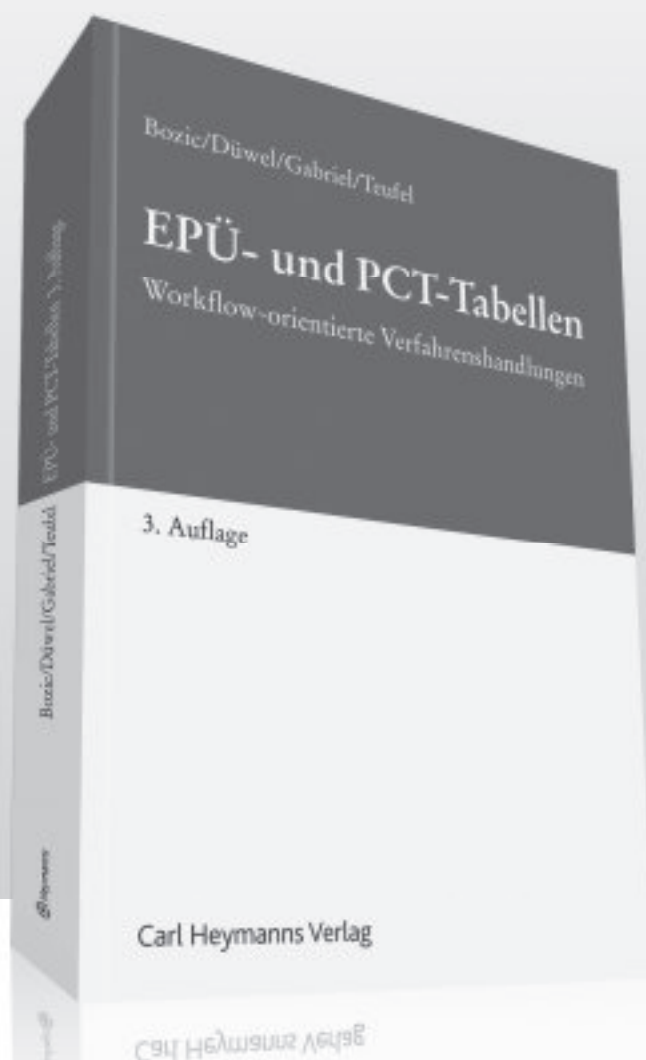
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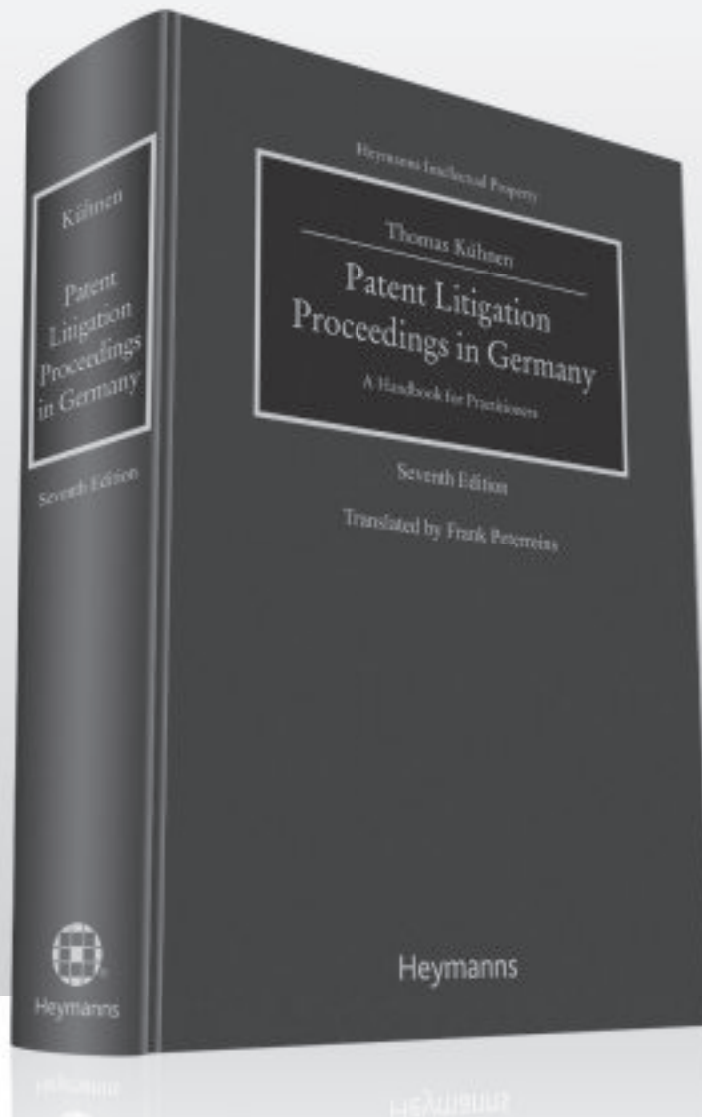
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Dr. Frank Peterreins is the Managing Principal of Fish & Richardson's Munich office. He is qualified in Germany as an attorney-at-law and a patent attorney and is also a European patent attorney, and has a wide-ranging litigation practice including EPO opposition cases and German nullity cases. Before becoming an attorney, Dr. Peterreins was a patent examiner with the European Patent Office and a member of an EPO Opposition Division.

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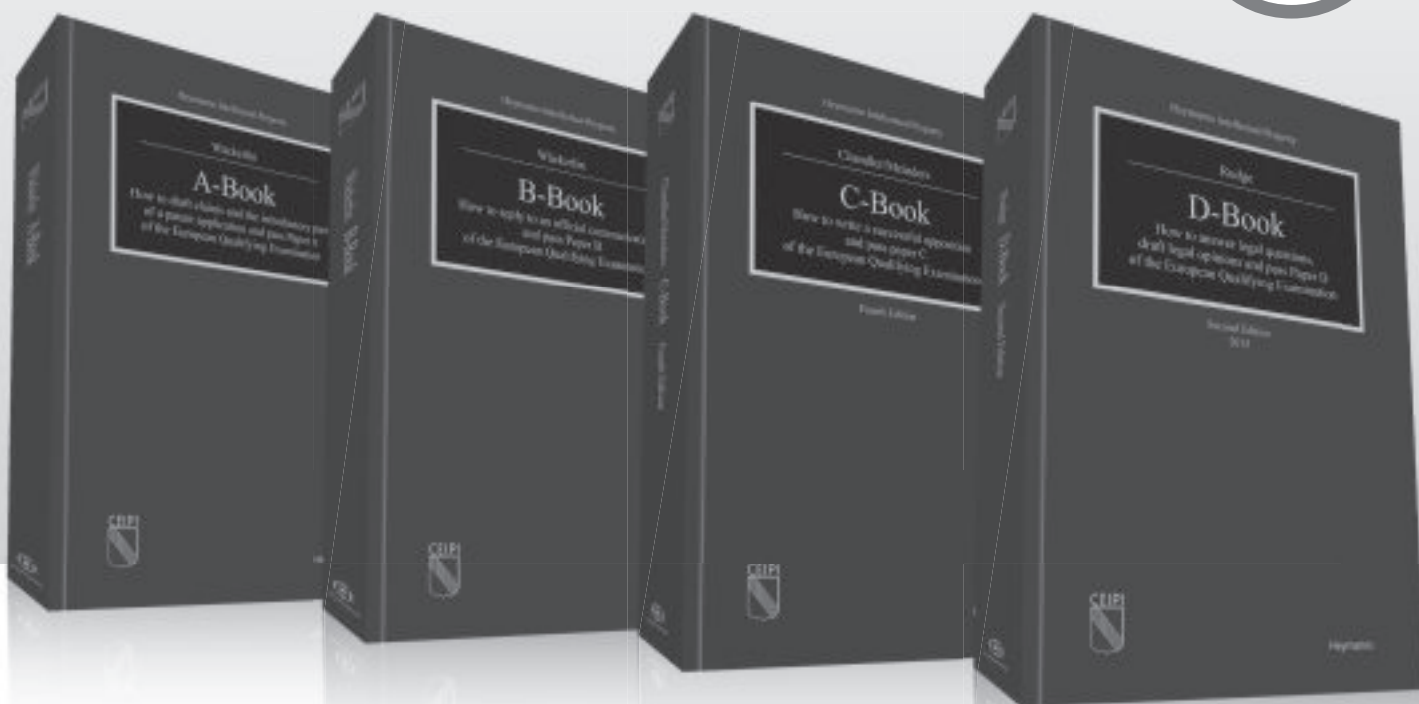
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