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Editorial

T. Johnson (GB)

As has been well-documented, this year marks the 40th anniversary of the signing of the EPC. The event will be celebrated in Munich in October. The Office has made good progress over the years, being generally perceived to have achieved high quality production and overall performance, more of which will be required with the coming into force of the Unitary Patent.

The Founding Fathers of the EPC no doubt had their priorities well in mind all those years ago. But who would have thought that 40 years on, priority in the sense of patent validity would still be an issue, and is thus a continuing important issue for applicants, our profession and the Office? Two recent Court cases in the UK have emphasised the importance of priority. In both, Samsung Electronics Co. Ltd v Apple Retail Ltd. *et al*, and Nestec SA *et al* v Dualit Ltd. *et al* two well-respected UK Judges held independently that patent(s) at issue were not entitled to priority, were invalid over the disclosure of priority documents and were thus not infringed. In the Nestec case, the Judge referred to Art. 54(3)EPC, which supports the contention that where there is no entitlement to priority, the priority document counts as prior art.

So priority is still an issue. Referring to my opening comments, the Office would no doubt argue that it had its priorities right over the last 40 years. We wish them well in keeping their priorities right for the next 40.

Nächster Redaktionsschluss für *epi* Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **4. November 2013**. 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 **November 4, 2013**. 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 **4 novembre 2013**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 09.08.2013 covers the period since my previous report dated 16.05.2013.

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

The EPPC is presently organised with seven permanent sub-committees (EPC, Guidelines, MSBA, EPO-*epi* Liaison, PCT, Trilateral & IP5, and Unitary Patent). Additionally, *ad hoc* working groups are set up when the need arises; in particular, thematic groups have been created in the fields of CII (computer-implemented inventions) and PAOC (pure and applied chemistry).

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

During its third meeting on 27.06.2013, the Select Committee (of the Administrative Council of the EPOrg) has adopted its Rules of Procedure (*http://www.epo.org/about-us/organisation/select-committee/documentation.html*) and accepted the request of *epi* to be granted observer status.

Its next meeting is planned on 18.09.2013, with the Draft Rules relating to unitary patent protection as main agenda item.

2. SACEPO/WPR written consultation

The members of the Working Party have been invited to provide comments about a non-paper containing draft Rules relating to unitary patent protection.

The EPC and Unitary Patent Sub-Committees met on 23.07.2013 to review the draft. The resulting comments were sent as a non-paper to the EPO on 31.07.2013. It is expected that the next draft will be available by the time this report will be circulated (see above, under item 1).

3. 45th SACEPO meeting (19.06.2013)

The subjects falling within the remit of the EPPC had already been discussed during the SACEPO/WPR meeting of 17.05.2013.

PCT reform – Proposals to strengthen the PCT:

(a) Proposal on the amendment of Rule 164 EPC: very positive feedback from the users.

(b) Proposed PCT Rule changes: some users expressed reservations about the proposed amendment of Rule 42.1 PCT (allowing the ISA to extend to 17 months from priority the time limit for establishing the ISR).

IT Roadmap:

- Report on the pilot project "administrative staff support examiners" (including minute-taking in oral proceedings).
- Report on tests of an electronic Druckexemplar and on plans to abolish the possibility of hand-written amendments, including accompanying measures (additional PC's and printers available during oral proceedings).
- Reports on pilots running with small groups of pilot users: e-mail Filing Pilot, Webform Filing Pilot, PCT-RO CMS pilot (Case Management System).

Quality Roadmap – Report

Divisional applications (Rule 36 EPC): the EPO reported on the results of the users consultations.

Changes in examiners' practice:

- Video-conference oral proceedings: the number of requests increased (438 in 2012 vs 297 in 2011); more ViCo rooms will be made available. The EPO is considering requesting that users summoned to OPs by ViCo make a preliminary test in case there was no ViCo oral proceedings done by them with the EPO in the previous 12 months.
- The EPO has decided, as a general rule, that the summons should be issued between 4 to 5 months before the date of the oral proceedings.
- The EPO has (finally) accepted to amend the Guidelines [in 2014] so that use of laptops and other electronic devices would be allowed as a general rule.

4. 2013 Guidelines and the 2014 revision

The sub-committee will meet on 26.08.2013 to finalise its lists of proposals.

epi members are kindly reminded that suggestions for amendment of the Guidelines are welcome at any time (eppc@patentepi.com).

5. 6th Meeting of the PCT Working Group (21 to 24.05.2013)

epi attended the meeting as observer. All documents from the PCT WG are available from the WIPO website, including the draft report:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=28622

In particular, it was agreed to delete Rule 44ter PCT, so that the Written Opinion by the International Searching

Authority will be available as of the Date of International Publication (as of 1.07.2014).

6. EPPC meeting

The committee met in Munich on 24.05.2013, with three sub-group meetings in the afternoon of 23.05.2013:
– a meeting of the Guidelines sub-committee;
– a joint meeting of the Unitary Patent and EPC sub-committees; and
– a meeting of a workgroup on Article 123(2) set up at the request of VP Leissler-Gerstl.

7. 20th MSBA meeting

The meeting with chairmen of Boards of Appeal will take place on 08.11.2013.

8. VP1 meeting

Meetings with the EPO Vice-President 'Operations' (VP1) had not continued after a new VP1 had been appointed in 2011. A meeting has now been set on 09.10.2013.

Report of the Harmonization Committee

F. Leyder (BE), Secretary

This report completed on 9th August covers the period since my previous report dated 17th May 2013.

The Harmonization Committee deals with all questions concerning the worldwide harmonization of Patent Law, and in particular within the framework of WIPO.

1. The Tegernsee process

The "Tegernsee Experts' Group" (a group of experts appointed by the Trilateral -JP, US, EP- and DE, FR, GB and DK) developed a joint questionnaire covering four topics: (1) Grace period; (2) 18-month publication; (3) Prior art effect of secret prior art (or treatment of conflicting applications); (4) Prior user rights. The EPO added some questions, clearly identified as such.

At the end of July, three reports on the results of the user consultation carried out on the basis of the Tegernsee Joint Questionnaire were received by *epi* in preparation of a meeting of the Committee of Patent Law (to be held on on 17th September): the reports of the five European Tegernsee delegations (EPO, DE, DK, FR, UK), the JPO and the USPTO (draft report) on the results of the user consultation carried out in their respective jurisdictions.

2. Meeting of the Harmonization Committee

As reported previously, the Council has agreed to discuss "Grace Period Harmonization" at its next meeting on 16th November in Prague. The committee held a meeting on 18th July to redefine its position.

Forthcoming *epi* educational events

epi Seminars

28 October 2013 – Munich (DE) – "Patent Strategy and Valuation"
22 November 2013 – Eindhoven (NL) – Topic to be decided

Mock EQEs 2013

The mock EQEs allow participants to attempt an EQE exam under exam conditions. The participants sit the papers in the same order, and in the same time, as the real exam. The exam papers are from previous EQE exams and are chosen for their didactic value. Experienced *epi* tutors mark the papers. About one month after the mock EQE, the tutors discuss the answers with small groups of candidates. Each participant receives personal feedback on his/her work.

Participants may sit any combination of papers.

Scheduled epi Mock EQEs:

Munich:
29.10. – 31.10.2013: Mock EQE
02.12. – 04.12.2013: Feedback sessions

Helsinki:
12.11. – 14.11.2013: Mock EQE
09.12. – 11.12.2013: Feedback sessions

Autumn Tutorial 2013

The autumn tutorial provides candidates an opportunity to sit the A/B/C/D papers privately, and to have their individual papers reviewed by and discussed with an experienced *epi* tutor.

Candidates can decide which papers they want to practice. When they enrol, *epi* assigns them (a) tutor(s). Two different tutors may be assigned for papers A/B and for papers C/D. No more than 5 candidates are assigned to any one tutor.

Candidates complete their answer(s), and send them to the assigned tutor(s). The tutor reviews the paper(s) by a specified date.

The tutor and candidates then schedule a time to discuss the answer(s). During the discussion, the tutor addresses specific problems, comments on individual solutions and provides general guidance. The format is flexible: it is up to the tutor and the candidates to decide the form the tutorial should take. If the tutorial is in a meeting, the candidates must meet both their own travel expenses and those of the tutor

epi autumn tutorial 2013 – proposed schedule:

Deadline for registration:	September 13, 2013
Papers to be returned:	October 18, 2013
Feedback to be given by:	December 13, 2013

EQE Training for paper C in a different way – Workshop on Oral Proceedings after drafting an opposition by EQE candidates

The *epi* is proposing to candidates having reached at least the Pre-Examination level to participate actively in drafting an opposition and defending a patent, the whole exercise ending up in a simulated Oral Proceedings where all the participants meet.

During those "Oral Proceedings", the participants will have not only to defend the statements they have made in writing, but will have to convince an "Opposition Division" of the correctness of their arguments.

The exercise is set for 12 to 15 participants. The participants will be distributed in three groups: two "opponent" groups and one "proprietor" group. Should the number of candidates be larger, it is envisaged to hold two sessions at an interval of a month.

The drafting of the respective oppositions and the reply from the proprietor, comprising some auxiliary requests, should be a collective action from all the candidates of the respective groups.

Further information is available on our website

http://www.patentepi.com/en/education-and-training/ preparation-for-the-eqe/

News from *epi*'s „Education and Training" Section

M. Fromm (DE), *epi* Secretariat

The first half of the anniversary year 2013 has passed quickly, being busy and eventful. Now everybody across Europe, including the "Education & Training" section of the *epi*, is taking a well-deserved summer break, before starting relaxed and motivated into the second half of 2013.

The *epi* education team cannot leave without mentioning important developments in the months since our last article in *epi* Information.

The most important development is that Ms Sadia Liebig joined the team in June 2013. We are very happy to have her.

Another event was not so joyful. Unfortunately we had to interrupt our annual seminar in Istanbul, on June 3-4, 2013, as the seminar hotel was situated at Taksim Square, which was the centre of disturbances at the time. We were very sad having to make this decision, as we had about 60 participants – an all-time high.

We will decide, in autumn 2013, whether we can re-schedule the seminar in winter 2013, or whether we will be forced to postpone the event to 2014.

On June 25, we held our annual dinner with the Examination Committees, the Examination Secretariat of the EPO, and the Supervisory and Examination Boards (this issue of *epi* Information contains a detailed article about this event).

The "Editorial" working group (WG) of the Professional Education Committee (PEC) is currently restructuring the "Education and Training" section of the new *epi* website, aiming for a more informative and user-friendly appearance. We invite all *epi* members and *epi* students to let us have their feedback/comments, so that we can take those into account before we go live. We hope to make the new section public by autumn 2013.

By the time this issue of the *epi* Information is published we will have held our two September seminars.

The first one is a "Mock Oral Proceedings" seminar in Copenhagen, on September 17. *epi* organised this seminar in cooperation with the European Patent Academy and the Danish Patent and Trademark Office. We have previously held this seminar successfully in Eindhoven and Helsinki.

The other event is a "Drafting of Applications" seminar in Bucharest, on September 19. This seminar is the second in seminar series set up by *epi* in cooperation with the European Patent Academy. As with the previous "Pre-drafting" seminar, the "Drafting" event is followed by a webinar dealing with one particular topic, about four weeks later.

The next in the series is the "Prosecution" seminar, that *epi* intends to organise at the beginning of 2014.

Great news for our tutors: We are very happy that finally we could re-schedule our postponed tutors' meeting for October 10, 2013. We will publish feedback on this event in the next *epi* Information.

On October 28 we will hold a seminar on "Patent Strategy and Valuation" in Munich.

IPR in today's business environment has growing importance as a strategic corporate tool, contributing to the value of corporations. As a result, strategic patent creation and a co-ordinated patent strategy have become fundamental factors of success.

Patents are a crucial element that managers should take into account when developing business strategies.

As a sequel to our very successful "Patent Portfolio Management" seminar, we will organise a new seminar focussing on patent strategy and valuation, as well as discussing other aspects of IPR, like patent trolls. Mr Tony Tangena and Mr Severin De Wit will host this seminar, sharing their expert knowledge in this field.

We have not yet scheduled a seminar on the Unitary Patent and Unified Patent Court. As promised in the *epi* Information 2/2013, we are monitoring the situation and we will keep all our members informed of educational events on this topic.

The training of EQE candidates is also a focus of PEC. This issue of *epi* Information contains further information on *epi*'s EQE training activities, under "Forthcoming *epi* educational events".

If you have further questions/feedback on education related matters, please contact us:
PEC: *pec@patentepi.com*
Education Team: *education@patentepi.com*

As you can see, the *epi* education team is expecting a hot autumn, with several very interesting events. We hope that all of you had a wonderful summer, and we look forward to welcoming you to one of our educational events in autumn 2013!

epi Dinner with the Examination Committees 2013

M. Fromm (DE), *epi* Secretariat

Every year the European Qualifying Examination (EQE) imposes a huge workload on EPO staff, who work hard to make the exams a success, alongside their colleagues from *epi*.

To thank all involved for their commitment, *epi* traditionally invites all involved to an annual dinner. Over the years these dinners have become a highly appreciated institution, that allow everyone to get together and exchange opinions, but mostly to enjoy themselves, usually hitting a peak by singing songs.

On June 25, 2013, *epi* President Tony Tangena opened the annual dinner by thanking the Examination Committees, the EPO Examination Secretariat, the Examination and Supervisory Boards, and the EPO and *epi* contributors for their valuable efforts with the EQE 2013.

President Tangena emphasised that producing a successful EQE not only required the identification of the right level for the examination papers, but also the smooth organisation of the exams, and accurate marking of the papers. These were all achieved by close cooperation between the EPO and the *epi*.

In his view, the result was a smoothly-functioning and well-balanced EQE, giving rise to a highly qualified profession that was fit to practice.

epi President Tangena ended his speech by laying out an ambitious vision for the future, to have EQE-qualified representatives in all EPC contracting states. To this end, the *epi* and the EPO had set up a Candidate Support Programme, which provides proper training and tutoring for candidates from countries with relatively low patent activity. This would help these countries to exploit their innovations and ultimately provide prosperity for Europe.

We hope that everyone enjoyed the dinner, and we look forward to a continuing cooperation of all involved – and certainly to next year's dinner!

Examination Matters 2013
19-20 November 2013
European Patent Office, Munich

Examination Matters gives patent professionals the chance to discuss day-to-day problems and burning questions face-to-face with EPO examiners in small groups in a workshop-type atmosphere. The online registration is open until 18.10.2013. Please visit the event website at *www.epo.org/examination-matters.*

Next Board and Council Meetings

Board Meetings

90th Board meeting on March 15, 2014 in Lyon (FR)
91th Board meeting on September 27, 2014 in Zagreb (HR)

Council Meetings

75th Council meeting on November 16, 2013 in Prague (CZ)
76th Council meeting on April 28/29, 2014 in Munich (DE)
77th Council meeting on November 15, 2014 in Milan (IT)

European Patent Attorneys Excess Liability

Dear *epi*-member,

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

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

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

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

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

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

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

This topic is relevant for all Swiss Patent Attorneys.

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

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

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

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

Please use the following contact details:

GWP Insurance Brokers AG
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Issue	Deadline	Publication
4/2013	November 4, 2013	December 30, 2013

Contact Data of Legal Division
Update of the European Patent Attorneys database

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by *epi*. Therefore, to make sure that *epi* mailings as well as 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):

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Thank you for your cooperation.

Back to national filings?
A little help for sceptics of the Unitary Patent[1]

M. Köllner (DE)[1]

((Abstract))

Whether justified or not –that remains to be seen – there are concerns that the enforcement of unitary patents will be far more slowly, more expensive and more unpredictable than has been the case with patents in Germany up to now. Many such sceptics are already advising their clients to avoid European patents and revert to national filing. Whether or not this makes sense will be briefly clarified here.

Whether or not I am one of those sceptics doesn't matter[2]. Nor does it matter if the sceptics – probably – are right or wrong. We'll see. The only question is what you should do if you are a sceptic. Is it really advisable to file nationally within Europe?

After all, the objective of this approach is to keep the German infringement courts for litigation. However, in the Agreement on a Unified Patent Court (UPC) there are a few pertinent regulations.

Once a European patent has been granted validation of the unitary patent can be requested for all states of the EU that have ratified the UPC up to that point, meaning those for which the UPC agreement and the EU regulation[3] are in effect. This request must be submitted to the EPO – together with a translation[4], at least for the time being – within one month following the mention of grant (Art. 9 Sec. 1 g), Regulation (EU))[5] .

But that is only an option. You don't have to do it. You can stay with the "classic" European patent and validate traditionally.[6] You will do this anyway if you only want protection for a few countries, since the unitary patent will only pay off if there are five or more countries.[7]

1 This article was first published in German in Mitt. 2013, 253. It has been amended for this edition.

1 European Patent Attorney und Patentanwalt, Frankfurt am Main

2 Fact is, I am really not such a great fan of the present practice of the German bifurcated system. The combination of the relatively slow Bundespatentgericht in nullity cases and the unwillingness of the infringement instances to stay proceedings results in a systematic bias in favour of the patent holder (see Wuttke/Guntz, Mitt. 2012, 477). In other words: in systematic injustice. That's not what anyone could call good. Therefore, maybe the new system will be better than the old German one. Only time will tell. If the local or regional divisions make use of their authority to refer a nullity case to the central division and hand down a decision on the infringement without staying the proceedings, then we would have the continuation of systematic injustice of German style. We'll see.

3 By EU regulation we mean Regulation (EU) No. 1257/2012 of the EUROPEAN PARLIAMENT AND OF THE COUNCIL of 17 December 2012, implementing enhanced cooperation in the area of creation of unitary patent protection.

4 Recitals 12 and 13 as well as Art. 6 of Regulation (EU) No 1260/2012 of the Council of 17 December 2012, implementing enhanced cooperation in the area of creation of the unitary patent protection with regard to the applicable translation arrangements

5 Why only one month from the grant is stipulated here and not three, as in any other validation (Art. 65 Sect. 1, Sentence 2, EPC) is not clear to me.

6 Recital 26, Regulation (EU)

7 Teschemacher, Mitt. 2013, 153 ,157

Well, then, isn't the unified patent court system valid for "classic" European patents as well? Theoretically, yes. That is precisely what makes up the compulsory nature of the new court system. It is valid also for "classic" European patents (Art. 32 tog. with Art. 2, letters e), f.) and g), UPC Agreement).

However, it is possible to choose to *opt out* under Art. 83, Sect. 3, UPC. You can declare before the Registry of the court that you wish to stay with the old court system.[8] And this can be done up to one month prior to the end of the transitional period pursuant to Art. 83, Sect. 1 or 5 UPC (Art. 83, Sect. 3 UPC).

And I can even declare this *opt-out* for European patent **applications** – that really takes the cake!

Have a look, Art. 83, Sect. 3, UPC reads:

*Unless an action has already been brought before the Court, a proprietor of or an **applicant for a European patent** granted or **applied for prior to the end of the transitional period** under paragraph 1 and, where applicable, paragraph 5, as well as a holder of a supplementary protection certificate issued for a product protected by a European patent, shall have the possibility to opt out from the exclusive competence of the Court. To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period. The opt-out shall take effect upon its entry into the register. (Highlights added by the author)*

This means I can still file an application(!) for a European patent several years from now, until shortly before the transitional period expires, and still keep the old court system for this patent application all the way to the end of the life of the patent! The sceptics would love that, wouldn't they?

The PCT deadweight effect doesn't matter either. According to the deadweight effect, in France, for example, you would no longer be able to pursue a national patent after having filed a PCT application. All you can do about France would be to file for a European patent. But what is the worst that can happen? You have a European patent application. But as we've already seen, it won't automatically end up as a unitary patent. That means that PCT applications will produce the same result as European patent applications. They, too, can still be filed exactly as before.

Now you have to exercise a bit of caution with "classic" European patents that have already been granted. If an infringement case is brewing, the potential infringer can force the patent proprietor into the new system by taking legal action. That's because the *opt-out* opportunity is available only as long as no litigation is pending (see above, Art. 83, Sect. 3, Sentence 1, UPC): *"Unless an action has already been brought before the Court, …".* So in a situation like this you have to take the first step yourself; if you want to stay with the old court system, then you have to opt out on time. In such a situation it is risky to wait until the end of the transitional period.

Of course this situation doesn't exist for new applications. This means that the *opt-out* should be requested without delay for all already granted European patents and still pending European patent applications. For all new European patent applications filed in the future it would be best to opt at an early date as well, for instance as soon as the file number is known. And this procedure can be pursued up to one month before the end of the transitional period.

Therefore, at least for the next seven years and probably much, much longer, for instance for the next 10 years, it will be possible to keep the previous way of handling European patent applications. If the ratification process is drawn out, say, for seven more years,[9] and if the transitional period of seven years is extended by another seven years (Art. 83, Sect. 4 UPC), then we are talking here about the biblical number of three times seven years. Will I live to see that?

Everyone will have to judge for themselves whether or not national filings in Europe would be advisable AFTER THAT. By that time, hopefully, experience with the new court system will have been gathered.

And now for the non-sceptics: Actually, the *opt-out* could be declared for all European patent applications and granted European patents. Nothing can go wrong; you can withdraw the *opt-out* at any time (Art. 83, Sec. 4 UPC). You could call that an *opt-in*. The proprietors retain all possibilities for choosing a court. I think that's what you should do – even as non-sceptic. And if almost everyone does it – and supposing they do,[10] – then we'll have two competing, parallel court systems for many years to come.[11]

But there is a clear advantage here over national filings: No one who files nationally can choose the *opt-in*, not even if the new court system proves to be very useful. That is only possible for European applications.

Finally, for fans of the new opportunities that are opening up: If – for financial or other reasons – you choose a validation in the form of the unitary patent, then you will have protection in many countries and the new court system. Actually, that should also be the case

8 I have heard that there are tentative plans to charge a fee for the *opt-out*. Now why on earth would they do that? A court collects payment for doing such a bad job that a plaintiff would rather go elsewhere? What a fantastic business model that is, with really extraordinary incentive structures.

9 Teschemacher, Mitt. 2013, 153, 154

10 Pagenberg, GRUR 2012, 582, 586

11 Actually they could change the UPC straight away along these lines: free choice of courts for all European patents applied for up to the end of the transitional period. That would save the registry of the court system a lot of work. I only hope that as a result of this free choice the courts will not attempt to attract as many cases as possible by being particularly plaintiff friendly. *Forum shopping* is not without its problems. Competition among courts is not only sound practice. It can offer incentives for enhanced quality. On the other hand, it also offers incentives for injustice since it is usually the plaintiff who selects the court. And what plaintiffs look for above all are victory, speed, predictability and low costs. And only the predictability has a positive correlation to quality – and it is only a secondary effect for the plaintiff after all. It would be different if the courts only competed with one another for recognition of their competence – which it would be possible to achieve by curtailing forum shopping. For in that case the alternatives and hence the interests of the plaintiff would fall by the wayside. Contrary to this, from the perspective of legal policy the plaintiffs' interest in speed and low cost is worthy of support. If you deprive the plaintiffs of the possibility of voting with their feet, what would be missing then is a healthy dose of pressure on the courts. In short: Nothing is as easy as it seems.

if you requested the *opt-out* option beforehand. The request should then lose its admissibility retroactively.

However, to date it is still not possible to opt. Nothing is in effect yet; no deadlines have been set. And maybe everything will fail anyway at the European Court of Justice or with the ratification process in England. Or with the necessary amendment of "REGULATION (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters", for which you need unanimity, as far as I heard[12]. If that is true, Spain could be able to block the entry into force that way – unless they make a deal with whatever else.

Not very likely, but wait and see.

Okay, dear EPO: This tiny hint will probably bring you millions. As a token of your appreciation you may now draw a pretty picture for the author.

And what about us? We will meet again 10 years from now. *Same place, same time.*

12 Art. 89 Sect. 1 UPC. Mr. Pagenberg of Bardehle, Munich, drew my attention to this.

Continued Professional Education "Noblesse oblige"

F. De Corte (BE)

By virtue of Article 134 of the European Patent Convention, the European Patent Attorney receives a privilege from society. He or she is allowed a quasi-monopoly on the representation of third parties before the European Patent Office. The *raison d'etre* for that quasi-monopoly is the assumed guarantee that the representation will be done in a professional way. The procedures before the European Patent Office are indeed very complex and constantly changing. Not understanding the procedures and thus making mistakes can cost the applicant – our client – dearly.

However, that privilege comes (and should come) at a price. First of all, the European Patent Attorney is required to pass the European Qualifying Examination. Moreover, every European Patent Attorney is expected to make sure that he or she continuously educates him or herself to be able to be worthy of the quasi-monopoly that society has bestowed upon the European Patent Attorney.

Now, let me be clear. I am absolutely convinced that all European Patent Attorneys have the solid conviction that keeping up to date is of vital importance. I also vigorously believe that the vast majority of our colleagues maintain their knowledge and skills. However, I also know and believe that given the increasing demands from our clients, the opportunity to find the time or to give continued professional education sufficient priority is becoming scarcer. Consequently, there is a risk that some of our colleagues might find themselves dropping out of the peloton, so to speak. Again I am sure that this represents a small minority but still, it seems fair to ensure that for the benefit of the whole, we make sure that the few people that might potentially endanger the reputation of all European Patent Attorneys are forced to keep up the standards. It is fair as an organization to require that everybody who is given this privilege of representation is in fact worthy of that privilege.

The European Patent Convention envisions that the Institute of Professional Representatives exercises a disciplinary power in respect of professional representatives. Clearly the notion that the Institute determines what is professional behavior and the notion that in case of non-abidance there can be disciplinary measures is in the legislation. So ensuring that Professional Representatives act professionally by keeping their knowledge up to date seems well within the reach of what the Institute can and actually should do.

Other similar organizations, such as organization of lawyers, of UK patent agents, etc. have a similar requirement. Actually many professions that rely on a similar quasi-monopoly as the one the European Patent Attorneys holds have to receive regular recertification. What makes us European Patent Attorneys so special that we could actually claim the right to the above described quasi-monopoly, yet not ensure that all those who carry that title have the up-to-date knowledge to perform their task in a professional way?

I do understand that there are two aspects here. There is the continued professional education and there is the monitoring system linked to "corrective measures' for those representatives that do not act according to the rules. In the many debates that I have witnessed, I have never heard anyone contest the fact that we should actually continuously educate ourselves. Consequently, I think it is common ground that Continuous Professional Education is important, if not crucial for being a European Patent Attorney.

Then we come to the element of monitoring. I think the proposal that was presented by the Professional Education Committee (PEC) was a good one. It is a

minimal administrative burden on the European Patent Attorney and yes, it is based on an honours system. The contestants of the proposal make a confusing argument. They say that it is "too easy" to just fill out the form even if you have not done any continuous professional education. That is confusing to me because on the one hand they seem to believe their colleagues when they say that they are taking continuous professional education (without a monitoring system) but the same people would assume that colleague professional representatives would lie when they fill out a form.

I also submit that our Institute should provide the training that is necessary. This could indeed give an extra incentive for partner organizations such as the CEIPI and the EPO Patent Academy as well as others to broaden their scope of trainings thus bringing the profession of European Patent Attorney to the next level.

In conclusion, it is my humble opinion that the Institute of Professional Representatives has the duty to ensure the professionalism of its members through continuous professional education both from the point of view of providing the actual continuous professional education as well as from the point of view of monitoring of the continuous professional education because indeed … "noblesse oblige".

The Unified Patent Court – Questions & Answers

N. Fox (GB)[1], A. Kupecz (NL)[2], D. van Dam (NL)[3]

What is the Unified Patent Court?

The Unified Patent Court is a new court based on an agreement between all EU member states, apart from Spain and Poland who have not (yet) agreed to join the new court system and Croatia which joined the EU after the Unified Patent Agreement was concluded. After coming into effect, the Court will enable the enforcement or revocation in a single court action of: corresponding European patents granted by the European Patent Office ('EPO') in force in EU countries participating in the Court; European patents with unitary effect (otherwise known as Unitary Patents)[4]; and any related supplementary protection certificates.[5] Part of the legislation relating to the Unified Patent Court (rules of procedure) is still being developed. In this paper we discuss some main lines of the agreement and the rules in their current form.

When will the Unified Patent Court come into effect?

The Unified Patent Court will come into effect 4 months after the Unified Patent Court Agreement has been ratified by 13 member states which must include the three most popular countries for validating European patents (i. e. UK, Germany and France).[6] Also, before the new Court comes into effect, Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgements in civil and commercial matters must be amended. The changes to the EU regulation on jurisdiction and the recognition and enforcement of judgements are likely to take place in 2013 and ratification of the agreement will probably be completed towards the end of 2014 or early 2015. Since the – still unamended – Regulation (EU) No 1215/2012 will apply at least through to 10 January 2015, the Unified Patent Court is expected to come into existence not earlier than the middle of 2015.

What will the impact of the Unified Patent Court be on my business?

The Unified Patent Court will have a significant impact on any business which is involved in patent litigation or licensing.

At present, patent rights are national rights and are to be enforced through individual enforcement actions in each of the national courts. This means that where a patentee seeks to enforce corresponding rights across Europe, multiple court actions are required.[7] Similarly, if someone wants to clear the way and have different national parts of a European patent revoked other than through Opposition before the EPO, separate revocation actions are required. When the Unified Patent Court fully comes into existence, it will be possible to enforce or

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4 Unitary Patents will be discussed in greater detail in a separate article to be published in the EPI Information.
5 Article 4 UPC
6 Article 89 UPC
7 Although, based on the Solvay/Honeywell ECJ case (C616-10), some national courts (notably the Dutch court) have accepted cross-border jurisdiction to take provisional measures in patent cases.

revoke such rights across almost the entirety of the EU in a single court action before the Unified Patent Court.

As the Unified Patent Court removes the need for multiple parallel court actions, the cost of patent litigation will be reduced. Because of the similarities in structure and procedure, the cost of litigation in the new Court is likely to be similar to the cost involved in a court action in a single continental European jurisdiction such as the Netherlands or Germany. Litigation in the Unified Patent Court is therefore likely to be cheaper than e.g. enforcement in the UK, which is currently the most expensive jurisdiction for enforcement of patent rights in Europe. By cutting down costs and numbers of procedures, both patent enforcement and defence against unfounded claims should be improved, thus meeting one of the primary purposes of the Unified Patent Court.

Who can sue in the Unified Patent Court?

Patent proprietors, holders of supplementary protection certificates and exclusive licensees of such rights will be able to bring actions for actual or threatened infringement before the Court.[8] A holder of a non-exclusive licence can in principle also enforce their rights in the Unified Patent Court. However, this is only in so far as expressly permitted by the licence agreement.[9] In addition, anyone may bring an action to revoke such rights or for a declaration of non-infringement.[10]

Where will actions be heard?

At first instance, the Court will consist of a number of local or regional divisions ('national or regional chambers') and a Central Division divided into three sections located in Paris, London and Munich.[11] The section of the Central Division in Munich will handle cases concerning mechanical inventions, the section in London will be responsible for chemical and pharmaceutical inventions and all other inventions, such as electronics and telecoms, will be handled by the section in Paris.[12]

Infringement actions have to be brought before the national or regional chamber where infringement is alleged to have occurred or alternatively before the national or regional chamber where a defendant is domiciled.[13] Procedures that start as a revocation action or as an action for a declaration of non-infringement have be brought before one of the sections of the Central Division,[14] unless an action for infringement between the same parties has already been brought before a local or regional division in which case any revocation action can only brought in that division.[15]

National chambers can be established in any participating member state. Alternatively, two or more countries can choose to establish a joint regional chamber. It is expected that national chambers will be established in all of the countries where there is currently a significant amount of patent litigation, such as the UK, Germany, France, Holland and Italy. In Germany, it is expected that multiple chambers will be established, most likely in the same locations as the existing German courts which handle a significant amount of patent litigation, namely Mannheim, Düsseldorf and Munich.

The Danish government[16] has proposed that a regional chamber should be jointly established by Denmark, Sweden, Finland, Latvia, Lithuania and Estonia. The proposed Nordo-Baltic court would have its seat in Malmö. Discussions are also on-going between Romania, Bulgaria, Greece and Cyprus about establishing a South-eastern regional chamber. In both cases it is being proposed that English should be the working language of the proposed regional chambers.

If no local or regional court is established in a particular jurisdiction, infringement actions concerning infringement in that jurisdiction or against defendants domiciled in that jurisdiction can be brought before the Central Division, as may any action against a defendant who is domiciled outside of the territory of the contracting EU member states.[17]

Appeals against decisions made at the first instance of the Unified Patent Court will be heard in the Court of Appeal based in Luxembourg.[18]

What will the language of proceedings be?

Actions brought before the Central Division will be conducted in the language in which the patent was prosecuted before the EPO.[19] In approximately 80 % of cases this is English, in around 15 % of cases it will be German and in around 5 % it will be French.

The language of proceedings in cases before the national and regional chambers will depend upon the chamber. In many cases this will be the national language of the country where the chamber is established, although some chambers may provide litigants with a choice of languages.[20]

As presently drafted, if a local or regional division provides litigants with a choice of languages, proceedings are required to be brought in the language in which the defendant normally conducts its business in that jurisdiction.[21]

8 Article 47(1) UPC
9 Article 47(3) UPC
10 Article 47(6) UPC
11 Article 7(1) & (2) UPC
12 Article 7(2) UPC & Annex to the Statute of the Unified Patent Court
13 Article 33(1) UPC.
14 Article 33(4) UPC
15 Article 33(4) UPC
16 Location of a Regional Division of the Court of First Instance (UPC), Ministry of Business and Growth, Denmark, 08 April 2013
17 Article 33(1) UPC
18 Article 9(5) UPC
19 Article 49(6) UPC
20 Article 49 (1)-(5) UPC
21 Draft Rules of Procedure Rule 14(2)

Who will be the Judges?

Each case will be heard by a multi-national panel of judges.[22] Where a case is brought before a local division in a country where a 'significant amount' of patent litigation has previously been brought, or before a regional division, two of the judges will be from that country or region respectively and the third will be appointed from elsewhere.[23] If the local division is established in a country without a 'significant amount' of patent litigation, there will be one local judge and two judges from other jurisdictions, probably jurisdictions with a history of patent litigation.[24]

A 'significant amount' of litigation, for the purposes of the rules, is at least 50 patent cases per calendar year (averaged over a 3-year period). This means that chambers in Germany, France, the UK, Italy and Holland will have two local judges. It is also possible that a Swedish chamber may sit with a panel of two local judges. Any local chamber outside of those countries is expected to have one local judge and two foreign judges appointed from a list.

Any regional chamber will have two judges appointed from within the jurisdictions hosting the regional chamber and one judge appointed from outside of the region.[25]

Initially, the Court will be staffed with the existing patent judges from the various national courts. So, for example, the local judges in the Italian chambers will be drawn from the existing judges in the IP courts. Similarly, the local judges for the German chambers will be drawn from the judiciary serving in the Bundespatentgericht and judiciary handling patent matters in the Landgericht.

The rules also provide for technical judges to be appointed to the Court, on request and whenever the Court considers it appropriate or is considering invalidity matters.[26] Any technical judges will be appointed from a list of individuals with relevant university degrees and proven expertise in a field of technology and knowledge of civil and procedural law relevant to patent litigation.[27]

What law will apply?

The basic law on validity and the scope of patent protection will be drawn from the existing European patent convention (EPC).[28] The Unified Patent Court Agreement contains provisions defining acts of infringement which basically correspond to existing national law.[29] In addition the agreement also provides for the court to base its decisions on provisions of EU law and in particular the EU regulations for the Unitary Patent.[30] The Court will also refer to international agreements applicable to patents which are binding on the member states such as TRIPS and the Paris Convention, and to national (patent) law.[31]

What are the rules of procedure?

Detailed draft rules of procedure have been issued and put out to formal consultation which runs until 1 October 2013 after which any submissions made will be considered and the rules will then be finalised.

The rules of procedure can be regarded as a mixture of various aspects roughly similar to existing national laws. The rules provide for obtaining evidence by way of a *saisie contrafaçon* procedure[32] such as currently exists in Italy and France, and for the filing of protective letters[33] such as are currently used in Germany and Holland. In the period straight after proceedings have been commenced, parties will be required to provide detailed explanations of the case in writing[34], such as is currently the case in Holland and Germany. At the end of this 'written procedure', the Court will hold a case management conference[35] similar to the procedure in the English Patent County Court[36] to decide upon the next steps in the case. This can include the Court ordering parties to disclose specific documents and orders for the cross-examination of witnesses.[37] The extent of any such cross-examination will be limited to specific issues in the manner of Danish patent proceedings. After any such additional evidence has been obtained and any cross-examination has taken place, an oral hearing will be held to provide the parties with a final opportunity to summarise their case and present arguments to the Court.[38] Such an oral hearing will typically be concluded within a single day.

Will the Court hear infringement and validity together?

Local and regional chambers hearing infringement cases in which a defendant files a counter-claim for revocation of a patent will have a choice. After having heard the parties, the chamber may choose to hear infringement and validity together; may choose to hear only arguments on infringement and send the validity proceedings to be heard by the Central Division; or alternatively, with the agreement of the parties, may send the entire case to be heard by the Central Division.[39] If a local or regional chamber does decide to split a case and only hear arguments relating to infringement and send the validity case to the Central Division, the chamber will have the option to stay the infringement proceedings pending the

22 Article 8(1) UPC
23 Article 8(3) UPC
24 Article 8(2) UPC
25 Article 8(4) UPC
26 Article 8(6) & Draft Rules of Procedure Rules 33, 34, 37(3)
27 Article 15(3) UPC
28 Article 24(1)(c)UPC
29 Articles 25-27 UPC
30 Article 24(1)(a) UPC
31 Article 24(1)(d) & (e) UPC
32 Draft Rules of Procedure Rules192-198
33 Draft Rules of Procedure Rule 207
34 See for example. Draft Rules of Procedure Rule 13(l),(m) & (n) & Rule 24 (e)(f) & (g)
35 Draft Rules of Procedure Rule 101(3) &104
36 Renamed as the Intellectual Property Enterprise Court with effect from 1 October 2013.
37 Draft Rules of Procedure Rules 176-179
38 Draft Rules of Procedure Rules 176 & 178(5)
39 Article 33(3)UPC

outcome of the validity case and will be obliged to do so if there is a high likelihood of a patent being found invalid.[40]

Who can appear before the court?

Parties are required to be represented by lawyers[41] or alternatively European Patent attorneys who have an appropriate litigation qualification.[42] A European Patent Litigation qualification will be established for this purpose. At present it is not clear whether national qualifications such as the UK Intellectual Property Litigation Certificate which enables UK national patent attorneys to represent clients independently of lawyers before the English courts will be considered to be an appropriate qualification for appearing before the Courts.

National patent attorneys and European Patent attorneys regardless of whether they have a European Patent Litigation qualification may assist parties' representatives and will be allowed to speak at hearings subject to a representative's responsibility to co-ordinate the presentation of a party's case.[43]

Can I opt out?

During a transitional period the new Court will run in parallel with the existing national patent enforcement systems.[44] For at least the first seven years[45] of the Unified Patent Court, patent proprietors will be able to opt both granted European patents and European patent applications pending before the European Patent Office out from the jurisdiction of the new Court unless an action has already been brought before the new Court, thus avoiding risking valuable assets in an untried system. It is not yet clear whether there will be an administrative fee for doing so.

Depending on the costs involved, opting-out may be an attractive option for patent proprietors as it prevents competitors from being able to apply to revoke patents across Europe in a single court action. Further, the rules of procedure permit a proprietor to withdraw an opt-out unless an action has already been brought before a "conventional" national court. Accordingly, if a patent proprietor wishes to enforce a patent they in principal have the option of either using the existing national country-by-country enforcement procedures or opting back into the new Court at that stage.

What do I have to do now?

The actions required by patent proprietors at this time are relatively limited.

Patent proprietors should review their existing patent portfolios so determine whether or not they want to file opt-outs on any of their existing European patents. Any opt-outs will have to be chosen on a case by case basis. Deciding upon an appropriate strategy and assessing the appropriate approach for the various patents in a large patent portfolio will be a substantial task. Fortunately, as ratification is unlikely to take place until 2015, patent proprietors currently still have time to make their decisions.

In the short term, patent proprietors should also review the countries where they choose to validate their European patents. Many European patents are only validated in the larger European countries, namely: UK, Germany, France, Italy and Spain as those countries account for the majority of the EU market. However, when the new Court comes into force it will no longer be necessary to initiate separate court proceedings in each individual member state. This increases the value of validating patents in the next tier, particularly in countries which are members of the London agreement where national validation of patents prosecuted before the EPO can be achieved by simply filing claims translations into the national language (e.g. Netherlands and Sweden). Additional validations will increase the impact of the single court action in the Unified Patent Court and would also increase the options available as to the national and regional chambers where court actions might be initiated.

Patent proprietors should also consider the expected timing of the prosecution of patent applications before the EPO, in view of the possibility to take advantage of the new Unitary Patent system which will come into force at the same time as the new Court. Where it is felt that a Unitary Patent is particularly attractive, applicants should refrain from taking actions to speed up prosecution so that grant does not occur before the option of a Unitary Patent becomes available.

40 Draft Rules of Procedure Rule 37(3)
41 Article 48(1) UPC
42 Article 48(2) UPC.
43 Article 48(4) UPC and Draft Rules of Procedure 292 & 287(6) & (7)
44 Article 89 UPC
45 Article 89(1) UPC

Divisional Applications – Another Trap in the Law

S. M. Barth (DE)

According to Rule 36(1)(b) EPC a divisional application can be filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82 EPC (unity of the invention), provided it has been raising that specific objection for the first time.

The case is considered here that the twenty-four term according to Rule 36(1)(a) EPC for the earliest application has already been lapsed, and that non-unity of the invention is stated in the search report of a divisional application derived from the earliest application. The communication pursuant to Rule 62(1) EPC will not trigger the term of Rule 36(1)(b) EPC, because it is not a communication from the Examining Division, the Examining division not yet being responsible for the application.

If the applicant thereafter amends the divisional application in the response to the communication pursuant to Rule 69 EPC by deleting one or more further claimed inventions in order to establish unity of the invention, the following first communication from the Examining Division will not object non-unity, because unity had already been established. Thus, in the worst case, the applicant will have no chance to file another divisional application, because the condition of Rule 36(1)(b) EPC will not be met.

In order to avoid such an unwanted situation, the applicant has the following possible options:

(i) In the response to the communication pursuant to Rule 69 EPC, the applicant might argue against the non-unity objection raised in the European search report. However, this might be difficult, if the non-unity objection is actually justified.

(ii) The applicant might file a main request and one or more auxiliary request in the response to the communication pursuant to Rule 69 EPC, wherein the non-unity objections are only be cured in one of the auxiliary requests. Then, according to the Guidelines for Examination, Part A, Chapter IV, 1.1.1.3 (vi), a notification of a communication according to Rule 71(3) where the text proposed for grant by the Examining Division is an auxiliary request and where the accompanying reasoning indicating why the higher requests were not allowable raises for the first time a specific objection of lack of unity to at least one of those non-allowed higher requests, the condition of Rule 36(1)(b) EPC will be met.

However, there is the risk that the higher request or requests are not allowed for other reasons than for non-unity. Then, of course, the term of Rule 36(1)(b) EPC will also fail to be triggered.

It is also dangerous to file such a combination of main and auxiliary requests late after having received the communication according to Rule 71(3) EPC in response to a request which was filed in order to overcome the non-unity objections mentioned in the search report in response to the communication pursuant to Rule 69 EPC. Such a combination of request might be rejected pursuant to Rule 137(3) EPC.

(iii) If a communication according to Rule 71(3) EPC has already been received for a request, wherein non-unity as mentioned in the European search opinion has already been removed when responding to the communication according to Rule 69 EPC, the most promising way is to contact the Examining Division by phone and to ask the Examining Division to notify the minutes of the telephone call to the applicant raising a specific objection of lack of unity related to the original claims for the first time as discussed during that telephone call. Such a notification will trigger the term of Rule 36(1)(b) EPC, provided the minutes reflect the newly raised objection of lack of unity, according to the Guidelines for Examination, Part A, Chapter IV, 1.1.1.3 (iv).

However, in this case, it should be observed that not a twenty-four months term will be triggered, but only a term which expires with the publication of the notification of grant of the parent application which normally happens much earlier.

In summary, it turns out that the restriction in Rule 36(1)(b) EPC to "any communication in which *the Examining Division* has objected that the earlier application does not meet the requirements of Art. 82" can lead to the above-mentioned problematic trap situation, and therefore it should be deliberated, if this Rule should be modified by deleting the requirement that the objection must have come from the Examining Division.

At least it appears to be appropriate that the EPO issues a statement thereabout for the applicants.

A Review of Priority Date Assessment under EPC

M. Lawrence (GB)

Peer Reviewed:
Ursula Kinkeldey, former Chair, EPO Board of Appeal 3.3.4 and former Member, Enlarged Board of Appeal
Peercat, a senior Fellow of the UK in-house profession[1]

Nearly 10 years ago, an eminent member of an Appeal Board in the EPO opened a particular issue at oral proceedings with the words "The problem the EPO has with priority …". It was certainly a taxing issue then, and it's still a taxing issue now.

One of the two tests for attribution of priority in G0002/98 is the same as that which controls added matter, and as time has passed it has grown closer to those legal origins in its implementation. The other test, less well-formed, has been implemented differently by different EPO tribunals – but creating a semi-consensus amoungst the majority of appeal boards; that is now challenged by an alternative approach which, if adopted, will change many future outcomes, and probably for the better, but only after a period of uncertainty.

And priority in Europe isn't just taxing, but also very relevant to commercial outcomes. There is one context which makes it especially so: a large proportion of EPC patent applications originate in the PCT environment and, created by practitioners outside Europe whose grasp of the above picture is necessarily limited, follow strategies which can lock in attributes which fit poorly with the EPC priority system. That's an issue made worse, although by no means created, by recently emerging IP risks such as Poisonous Divisions and Poisonous Priority Documents. Hopefully, this paper will catalyse debate and aid communication in a way that ameliorates that issue.

0. Introduction and Overview

0.1 Priority entitlement is at the core of best patent practise, capable of determining "*life and death*" decisions in private patent validity disputes as well as in the more extreme of patent prosecution contexts[2]. Whilst there is literature highlighting individual EPO Appeal Board decisions within this overall theatre, less than might be expected has been written on priority date assessment in the round using Enlarged Board of Appeal Decision *G0002/98* as the starting point[3].

0.2 Priority is seldom a straightforward matter for patent proprietors where the technology concerned, or perhaps the proprietor's understanding of it, grows within the priority year after first filing and leads to specification changes which threaten the originally established priority date.

0.3 Priority is equally a tough issue for tribunals and, as this paper will show, appellate decisions of the EPO have been an imperfect source of guidance for patent applicants and patentees. Indeed, a definitive position on multiple priorities is still lacking 15 years after the presidential referral which led to the landmark Enlarged Board of Appeal Decision G0002/98. As one of a handful of concepts which are absolutely fundamental to the patent system, it is remarkable that any significant aspect of priority should still await final resolution after such a lengthy gestation period.

0.4 The developing landscape of jurisprudence on priority, and the current implications for practise, can conveniently be reviewed as the following chapters:

Claim Splitting:

- 2001: Enlarged Board of Appeal Decision *G0002/98*
- 2003 to 2012: Development of a Strict Approach: *T1127/00* to *T0476/09*
- Mezzanine: The *T0665/00* Approach to Split Priority
- Discussion of the Decade of Developmental 2003 to 2012
- 2013: The *T1222/11* Approach to Split Priority
- Specific Embodiments as Priority Domains
- Split Priorities – Practise

The Subject-Matter Test:

- Applying the G0002/98 *Conclusion* Test to Priority Documents

1. 2001: Enlarged Board of Appeal Decision G0002/98

1.1 The Decision

1.1.1 *G0002/98* (May 2001)[4] decided two things. First, what amounts to the key teaching, at least in the consciousness of most practitioners, sets the disclosure standard needed in a priority document to support a priority claim. Secondly, the decision sets out the circumstances in which a claim can be partitioned to recognise

1 The pseudonymity of this peer reviewer is a result of the internal rules of the relevant corporation

2 Notably, although specific to the UK jurisdiction, three patents were held invalid earlier this year through having disallowed priority claims: *Samsung v Apple, [2013] EWHC 468 (Pat)* [March 7, 2013]; *Samsung v Apple, [2013] EWHC 467 (Pat)* [March 7, 2013]; and *Hospira and another v Novartis, [2013] EWHC 516 (Pat)* [March 15,2013]

3 This is against a real life background in which there is some evidence that priority challenges are becoming more common in *inter partes* proceedings, especially in crowded technology areas

4 G0002/98 is, of course, approved in the key UK court decisions in (1) Biogen v Medeva [1997] RPC 1 and (2) Unilin Beheer v Berry Floor [2005] FSR 6

multiple priorities under Article 88(2)(3) EPC. The latter tends to be the harder question, and of the two teachings it is the one least well understood.

1.1.2 The key teaching in G0002/98 (as set out in the Conclusion) requires that the skilled person must be able to derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. The board commented extensively on the fact that its decision represented a narrow approach achieving necessary alignment and consistency in implementation of a number of different legal concepts underlying EPC, and those comments have been reprised in other decisions.

1.1.3 The seminal test which this key teaching sets out is an Article 123(2) EPC test which examines whether there is basis in that sense in the priority document for the claim concerned. Article 123(2) EPC is a "*daily*" challenge, quite outside of questions of priority date assessment, for most IP practitioners; it is perhaps this which explains why this part of the overall teaching of G0002/98 takes the higher position it does in practitioner consciousness.

1.1.4 Reason 6.7 of G0002/98 also gives the Enlarged Board of Appeal's view on legislative intentions driving the multiple priority provisions of Article 88(2)(3) EPC. Reason 6.7 deals with priority date assessment for so-called "AND claims" and "OR claims". The first arm of this is easy enough and will not here be discussed. The second arm of Reason 6.7 deals with situations where a claim covers features expressed in the alternative – "*Feature A*" or "*Feature B*" – where those features may be contained in a group of priority documents whose dates are claimed but not all of those features are contained in any *single* priority document.

1.1.5 Commonly, the alternative features referred to are expressed in the claim as a generic term. Reason 6.7, second sentence gives as an example the situation where the claim is directed to Feature C, a generic term encompassing Features A and B; here, the claim is split for priority date assessment purposes, with the claim so far as it covers Feature A having one date (P1) and so far as it covers Feature B having a different date (P2) – reflecting two priority documents having Features A and B as respective disclosures. However, the final sentence of Reason 6.7 contains the crucial message, namely that Article 88(2)(3) EPC permits a patent claim to claim multiple priority dates using a generic term subject to satisfaction of the important compound legal pre-requisite that use of the generic term gives rise to the claiming of alternatives which (i) are clearly defined and (ii) are limited in number[5]**.** This test makes the "OR claims" arm of G0002/98, Reason 6.7 more difficult to apply – first because it is inherently more difficult to comprehend and secondly because EPO Boards of Appeal have adopted different approaches to its implementation.

1.1.6 In applying the above test, most lower boards, perhaps led principally by T1127/00, have looked for real signs in the specification of the patent/application in suit[6] of individualisation of the features in question which the generic term subsumes, as well as clarity in expression of, and limitations in the number of, such individualisations. This consideration is applied narrowly and strictly (although the test is not an Article 123(2) EPC test).

1.1.7 In a closely reasoned but *obiter* opinion on the interpretation of *G0002/98*, *T1222/11*, published at the end of last year, takes the entirely different approach that Reason 6.7 of that EBA decision permits multiple priorities in any one claim assignable to domains which can be conceptually envisaged in the patent/application under priority date assessment, but they do not need to be individualised.

1.1.8 It should not be forgotten, but commonly is, that the primary embodiment of legislative intention behind Reason 6.7 of G0002/98 is derived from the so-called "*FICPI Memorandum*"[7] forming a crucial part (as far as priority is concerned) of the *Préparatoires Travaux* to EPC 1973. That background text is referred to in G0002/98 as an important authority but in comparatively few other places in terms of either lower board decisions or expert papers on the subject of multiple priorities[8].

1.1.9 Reason 6.7 of G0002/98 has an obvious focus on situations where technology grows after first filing to engender claim *broadening*, as distinct from *narrowing.* That is the focus in the FICPI Memorandum (and indeed the two contexts are treated differently in T0680/08, although in applying the test for identity of invention rather than in claim splitting[9])**.** However, it is nevertheless argued that it also embraces *narrowing* in that Feature A and Feature B may be alternative narrowing features (with different priority dates). For example, the first filing may disclose a broad range (abandoned in a

5 The exact language in G0002/98, Reason 6.7 is: „*The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters*" (emphasis added)

6 An interesting consideration is whether basis for claim splitting must be in the patent, if priority is challenged for the claims as granted, as opposed to *having been* historically present in the application filed, a question presumably to be answered in the affirmative (Article 88(2) EPC is framed about patent *applications*, but it is suggested that this is not significant beyond the fact that it is there that the priority claim is made). To this conjectured extent, it is clearly, although inconveniently, possible for priority entitlement to change, through disapplication of claim splitting, in the amendment process which may be experienced by a patent application in prosecution. Amending a specification always moves the goal posts but an outcome such as this seems a technical consequence too far and is perhaps an early sign that the *semi-consensus* state of case law, at least prior to T1222/11, has not entirely ended up in the right place

7 Denoted „*Memorandum MI/48/II, Section C*" in the *Préparatoires Travaux*

8 It would be (theoretically) interesting to learn how many people who practise IP have read the *FICPI Memorandum*, or even had it in their possession, until recently

9 In T0680/08, it is stated by the board in Reason 1.3, second paragraph that it found nothing in G0002/98 to suggest that the Enlarged Board of Appeal had „*explicitly*" considered situations where a claim had been „*marginally*" narrowed; however, it is suggested (see Paragraph 8.8 below) that the deciding board may have erred in concluding that this gave it the freedom it decided it had

second filing in favour of the new narrow range referred to below) and a more specific parameter (the latter being Feature A), and the second filing may disclose the narrow range (Feature B) encompassing the more specific parameter (the latter being, as already noted, Feature A).

1.2 Various Priority Contexts

1.2.1 For the purposes of conceptual understanding, it is perhaps helpful at an early point to look at the three model priority contexts illustrated below, and how they sit in the context of a possible prior art attack (based on a disclosure of specific embodiment subject-matter[10]). As there is more than one type of broadening, there are three Illustrations to illustrate narrowing and broadening amendments after P1 filing. Illustration 3 is the reciprocal of Illustration 2.

1.2.2 Illustration 1:

- P1 filing was limited to W (and duly exemplified\)
- At P2 filing, a new disclosure was filed directed to an alternative X (together with its own exemplification)
- P3, the cognate of P1 and P2, was subsequently filed and produced **broadening** relative to the P1 filing as its claims are to {W *or* X}. The main claim *overall* enjoys date P3 as it does not *overall* claim the same invention as the P1 or the P2 filing. However, the claim is notionally divided into separate priority domains, Domain W (P1) and Domain X (P2), in line with G0002/98, Reason 6.7
- Domain W is invulnerable by virtue of its P1 priority date to a novelty challenge based on eg a *whole contents* disclosure of P1 subject-matter and P1 date (or later)[11]
- Domain X has the same invulnerability despite its later priority date P2 as it is limited to subject-matter X and does not include any subject-matter W
- But for the claim splitting, the whole claim would be invalid

1.2.3 Illustration 2:

- As shown in Table 1 below, a P1 filing has a Claim A limited to a parameter range 1 to 8 and this is exemplified by an Example (parameter 3.5)
- At P2 filing, Claim B replaces Claim A and relies instead on parameter range 2 to 5 not disclosed at the P1 stage
- P2 with the latter definition – a **narrowing** relative to the P1 filing – is proceeded with[12] to examination. As a result of the narrower parameter definition, the invention claimed in P2 is not the same as in P1, and Claim B *overall* is entitled only to priority date P2
- Claim B is vulnerable to a novelty challenge based on eg a *whole contents* disclosure of the Example in the P1 filing as this would fall within the scope of Claim B. Final outcome would depend on basis for splitting Claim B to define a P1 domain encompassing the cited Example and one or more domains representing the balance of Claim B (ie the subject-matter: {Claim B minus the P1 domain})

Table 1

	Range 1 – 8	Range 2 – 5	Example (parameter 3.5)
P1 filing (Claim A)	x		x
P2 filing (Claim B)		x	x

1.2.4 Illustration 3:

- As shown in Table 2 below, a P1 filing has a Claim C limited to a parameter range 2 to 5 and this is exemplified by an Example (parameter 3.5)
- At P2 filing, Claim D replaces Claim C and relies instead on a parameter range 1 to 8.[13]
- P2 with the latter definition – a **broadening** relative to the P1 filing – is proceeded with to examination. As a result of the broader parameter definition, the invention claimed in P2 is not the same as in P1, and Claim D *overall* is entitled only to priority date P2
- Claim D is vulnerable to a novelty challenge based on eg a *whole contents* disclosure of the Example in the P1 filing as this would fall within the scope of Claim D**.** Final outcome would depend on basis for splitting Claim D to define a P1 domain encompassing the cited Example and one or more domains representing the balance of Claim D (ie the subject-matter: {Claim D minus the P1 domain})

Table 2

	Range 1 – 8	Range 2 – 5	Example (parameter 3.5)
P1 filing (Claim C)		x	x
P2 filing (Claim D)	x		x

2. 2003 to 2012: Development of a Strict Approach: T1127/00 to T0476/09

2.1 There are a number of EPO appeal board decisions, involving key boards of appeal associated with widely recognised sound decision making, which have taken quite strict approaches (and, in particular, approaches which are less lenient than in *T0665/00* and *T0680/08* – see Paragraph 3 below); they have as a common theme that claim splitting under Article 88(2)(3) EPC can only be allowed when there is a solid rationale for the split in

10 Where priority date is at issue, it is common for alleged anticipatory disclosures to be self-disclosures and for those self-disclosures to be disclosures of *specific* information. For a recent example, see the UK case of *Hospira and another v Novartis, [2013] EWHC 516 (Pat)* (and IPKat March 19, 2013) and, more generally, T1213/05 and T0331/07 (scientific paper publication), T0665/00 (product disclosure), T0680/08 (publication in priority document) and *T1496/11* (publication in divisional)

11 This could be the result of a competitor's patent procurement actions or, as in the case of T0680/08 and T1443/05, those of the proprietor

12 Of course, commonly, an EPC P3 will be filed cognating the P1 and P2 filings

13 Unlike Illustration 1, the broadening is the result of a redefinition of a parameter rather than the provision of an entirely different alternative feature

terms of what the patent/application discloses – some disclosure which supports the selectivity associated with any individualisation.

2.2 Decision *T1127/00* (December 2003) (so far as it deals with the Main Request) provides perhaps one of the more useful outlines of how *G0002/98* should be applied. As noted earlier, in the case of "OR" claims having a feature expressed in generic language, G0002/98 stipulates in Reason 6.7 the over-arching proviso that this must only give "….*rise to the claiming of a limited number of clearly defined alternative* subject-matters". In T1127/00, the board applied Reason 6.7 of G0002/98 and determined whether the claim could be split into different domains for priority date assessment purposes (see Reasons 5 to 7). The board pointed out that a notional domain in the claim under assessment, in particular such as one disclosed in the priority document, might be intellectually envisaged to fall within the scope of the claim being assessed but this did not in the board's view make up for the lack of a clear and unambiguous individualized presence *in the claim* justifying award of multiple priorities (see Reason 7). The board thus found that Claim 1 of the case before it did not embrace "…….*a limited number of clearly defined alternative subject-matters in the form of an "OR"-claim which could be split up into groups of different priorities*"; a single later priority date was assigned to the claim.

2.3 In an Auxiliary Request, AR2, made by the patentee in *T1127/00*, a claim to a ribozyme was, however, split into separate domains. The ribozyme was defined in AR2 by Features A, B, C and D. Feature C in turn was defined by parameters *m* and *m′* 1 and b 2[14]**.** In splitting the claim across the definition of Feature C, the board felt able to individualise a first priority domain {C: *m* = 1, *m′* = 1, *b* = 2} entitled to the date of PD1 and a second priority domain comprising the rest of the claim – a *limited number of clearly defined subject matters*[15]**.** The granted claims had specified an embodiment corresponding to AR2 which, of course, specified the values *m* = 1, *m′* = 1 *and b* = 2 in that these were the lower limits of the open-ended ranges *m* and *m′* 1 and b 2; and the board was no doubt assisted in its individualisation task by the flagging of these limits as of significance in the description of the patent eg the schematic model ribozyme of Figure 3[16].

2.4 *T0070/05* (February 2006)[17] examined the right to priority of a citation. The board pointed out at an early stage of the decision (Reason 4) the requirement emanating from G0002/98 that consistency calls for the same criteria to be applied to priority date assessment of a citation as applied to a patent/application under challenge. In the citation, similar extracellular receptor fragments DDCR (30-215) and DR3-V1 (26-212)[18] defined, respectively, in the citation and its priority document could be seen as having a common polypeptide chain or sub-group. In Reasons 17 and 18 of the decision, the board applied Reason 6.7 of G0002/98 to the citation in the following way: –

- Reason 17: the common sub-group was "*not singled out as such*" in the citation and the use of approximate terminology in its definition[19] created an open-endedness which meant that (echoing the *limited number* requirement of the proviso to Reason 6.7 of G0002/98) the number of sequences covered by the sub-group definition was not limited
- Reason 18: referring to the rationale expressed by the board in T1127/00, the common polypeptide chain could not be individualised *inter alia* in the citation as one alternative subject-matter domain – the board holding that the fact that the domain might be intellectually envisaged as falling within the disclosure of the citation was not sufficient. The board decided that the claim could not be so split as the common chain was not as such identified *in the claim* (as opposed to capable of being intellectually envisaged) and not clearly defined[20].

2.5 In *T0184/06* (March 2007), the board took a tough line in the case of a bleaching composition and nearly, but not quite, stated (in Reason 6.1.2) that its interpretation of Article 88(2) and (3) EPC was that multiple priorities could be claimed only in the case of specific distinct alternatives. The board contrasted this with how it saw the claims before it (Ninth Auxiliary Request) as characterized by a combination of features which "*cannot be regarded isolately* (sic) *from each other*". The patentee's argument on individualization was that priority should be assigned to at least the included compositions comprising a hypohalite bleach and the specific alkyl ether sulphate disclosed in the Examples. Whether better ammunition to deal with the board's somewhat refractory posture existed is beyond the scope of this paper but the above argument has little obvious strength. In any event, multiple priorities were not permitted.

2.6 As noted in Paragraph 2.2 above, *T1127/00* (Main Request) states that basis for individualisation of an embodiment is required to be "*in the claim*"[21]. However, as plain as this is stated in the decision, it is suggested that it would be going too far to treat this as a general

14 The decision may be found difficult to follow as Reason 21 incorrectly refers to *n* and *n′* whereas m and *m′* were intended

15 See Reason 21 (in which, however, Reason 6.7 of G0002/98 was not expressly mentioned)

16 The decision can be distinguished over T0665/00 because Feature C was individualised in the patent with a force greater than was the relevant microsphere density in T0665/00

17 Oral proceedings were heard before a five-member board

18 With a general audience in mind, the style of nomenclature shown has been used as a convenience in distilling into assimilable abstract form the reasonably complex technical fact pattern in T0070/05

19 The board noted that the DDCR (30-215) and DR3-V1 (26-212) fragments could be in slightly shortened or extended form so that there were a number of alternative possibilities for the composition of the common polypeptide chain

20 The board in T0070/05 also decided (Reason18) that the common polypeptide chain could not be derived clearly and unambiguously from the priority document so that, even if the claim could have been split, it seems that the claimed priority date would not have been assigned to the domain defined in the split

21 A position also taken by the board in *T1443/05*

principle. As noted in Paragraph 2.3 above, T1127/00 itself appears to accord with this in the approach taken to the Auxiliary Request[22]. Moreover, observing the requirement for a solid rationale for a claim split to be contained in the patent/application in question, if basis for individualisation of a priority domain were flagged in *the body of patent specification*, it is not easy to explain why this should be treated as inferior to basis in *a claim* – at least, not without recourse to artificial arguments which are more technical than equitable.

2.7 Reason 6.7 of *G0002/98* derives principally from Article 88(3) EPC, which refers to "*elements*" of the invention. In *T1877/08* (February 2010), the board, in highlighting this terminology, makes the point that it must be understood as referring to "*separable alternative embodiments*". In that case, the board dealt with a chemical composition comprising three components in proportions defined by numerical ranges (30-65, 33-69 and 1-10) not disclosed in the priority document (which disclosed rages of 30-55, 35-65 and 2-10). These were argued unsuccessfully to be entitled to priority so far as there was overlap between the ranges claimed and those in the priority document. The board did not agree and held that no "*separable alternative embodiments*" could be identified in the patent, citing Reason 6.7 of G0002/98. The decision, usefully reiterating the language of Article 88(3), underlines the perceived need for *individualisation* of domains within the patent whose claims are subject to priority date assessment. A later decision, *T0476/09* (September 2012), supports the position taken by the board in T1877/08, the facts being somewhat similar (a range of 0.93 to 0.99 was recited in the claims in question for the circularity of toner particles in a toner composition whereas the priority document disclosed a marginally narrower range of 0.94 to 0.99 for the same parameter).

2.8 A very recent, and well-publicized, judgement (April 22, 2013) of the UK Patents Court in the case of *Nestec SA & Others v Dualit Ltd & Others [2013] EWHC 923 (Pat)* is broadly aligned with the above EPO appeal decisions, and in particular with T1127/00 (Main Request). In Nestec, the relevant claim was to an extraction system in a Nespresso coffee maker, the system being defined in terms which encompassed arrangements in which a beverage capsule had an inclined or non-inclined attitude whereas the priority document did not disclose arrangements in which the capsule had the former attitude (Paragraphs 99 and 102). Relying on G0002/98 (Paragraph 91) the court held that, *inter alia* on this ground, Claim 1 was not entitled to the claimed priority date (Paragraphs 103 and 104) but only to the filling date of the application on which the patent was granted. Counsel for Nestec did not argue that the claim was entitled to multiple priority dates for the respective subject-matters it encompassed (Paragraph 103), but in any event the judge stated in Paragraph 103 that he did not consider the "*inclined*" embodiments to be *"… clearly defined alternatives to the other arrangements covered by …"* the claim (also see Paragraph 96 for a similar view on other features). It is worth mentioning that not only did the UK Patents Court follow the T1127/00 approach in Nestec but that this is also true of the even more recent HTC case[23]. In HTC, before a different judge, multiple priorities were not argued, nor permitted, for Claim 1 (which would be notionally split into a *Java language* domain and an *other language* domain – the claim having specified *language* generally) and a split priority argument in relation to a sub-claim was rejected by the judge (see Paragraphs 172, 193 and 195 of the HTC judgement). As noted later in this paper (see Paragraph 5.9), neither judge appears to have considered T1222/11.

2.9 Pithy rules of thumb are dangerous in the practise of IP law. However, there's a general flavour in most of the case law that claim splitting across the scope of a generic expression[24] must be straightforward or it's not going to be allowed as a tool in priority date assessment, at least not under the widely supported "*strict approach*" laid down in T1127/00. It wasn't straightforward in T1127/00 (Main Request) or T0070/05, and nor, it is suggested, was it in *T0665/00* or *T0680/08* (see Paragraph 3).

2.10 There are cases where *it was straightforward* that are worth mentioning to illustrate the point; in these cases, the need to apply split priorities was occasioned by claim broadening at subsequent filing relative to the first filing and the board looked for, and easily found, basis for the necessary individualisation in the patent concerned. In *T0135/01* (January 2004), a domain of Claim 1 whose subject-matter was entitled to the earliest priority date claimed was explicitly defined in Claim 2 and in the description of the original PCT application, so that the situation easily sat within the framework of allowability the board saw as set out by Reason 6.7 of *G0002/98*; things were straightforward and splitting of Claim 1 was permitted so as to attribute multiple priority dates. In *T0441/93* (decided before G0002/98, in March 1996), the claim challenged was also partitioned in a similar manner into (A) transformation processes applied to yeast cell protoplasts (for which priority was allowed) and (B) transformation processes applied more broadly to include whole yeast cells (for which priority was not allowed). As the decision predates G0002/98, no reference is made in the decision to application of the principles set down by the Enlarged Board of Appeal although express disclosure of (A) was contained in the sub-claims of the patent and presumably relied on by the board. *T0395/95* (also decided before G0002/98, in September 1997) also allowed split priority, the split-off domain again being clearly disclosed and identified as such in the patent (see Claim 2 of the patent and Reasons 2.1.1 and 2.1.2 of the decision).

22 ….. and see T0135/01 (Paragraph 2.10 below)

23 HTC Corp v Gemalto [2013] EWHC 1876 (Pat) (April and May 2013)

24 Of course, situations where the claim scope is defined by expressly stated alternatives are an easy matter; see, for example, T0676/01 (May 2005) and T0108/98 (March 2003)

2.11 In both cases, the splitting, quite apart from the subject-matter to which it was directed being flagged in the specification of the patent concerned, gave rise to a limited number of alternative subject-matters. Perhaps importantly, they were cases where the later filing broadened the claim scope; had it instead narrowed the claim scope, there might have been a greater challenge to individualisation of eg a domain of early priority date encompassing an anticipatory specific embodiment, at least not one likely to have appealed to the deciding board.

3. Mezzanine: The T0665/00 Approach to Claim Splitting

3.1 The *T0665/00* (April 2005) approach, which has featured in a number of blog posts, is best demonstrated with reference to Illustration 2 (Paragraph 1.2.3 above). There are two possible approaches in Illustration 2, each with a different outcome:-

(i) Claim B is not split at all and therefore has the priority date P2. The P1-dated specific Example (parameter 3.5) is anticipatory of Claim B; or

(ii) Claim B is split to provide the following priority domains:
- A priority domain characterised by parameter 3.5 (entitled, following the reasoning in T0665/00, to date P1), and
- Following the claim splitting approach adopted in T0665/00, plural priority domains, respectively representing the rest of Claim B, each of which is specific separately to all other parameters within the claimed limits *2 to 5* recited in Illustration 2. The first-mentioned domain has priority date P1 and is therefore invulnerable to any citation of the Example with an effective date later than P1. The remaining domains of Claim B are distinguished from the Example (on a novelty basis) by virtue of different subject-matter.

3.2 The analysis in 3.1(i) seems right on the basis of G0002/98. The approach to claim splitting adopted in T0665/00 is entirely different and, whilst it cannot be ignored, it seems questionable.

3.3 Referring now to the detailed circumstances in *T0665/00*: –
- In T0665/00, the board was tasked with assessing priority entitlement of a composition claim reciting a density limit of <0.1 g/cm^3 for a microsphere component where the priority document recited instead a density limit of <0.5 g/cm^3 and mentioned no additional densities. Example 1 of both patent and priority document stipulated the presence in the composition of a branded microsphere product (*Expancel DE*) in combination with identical other components
- The Example in the *patent* provided a greater amount of information on the branded microsphere component, in particular express disclosure of a density of 0.04 g/cm^3. Submissions by the patentee, supported by expert testimony and not challenged by the opponent, were accepted by the board to establish a figure of 0.036 g/cm^3 for that branded product as used in Example 1 of the *priority document* (see Reason 3.2 of T0665/00)
- This composition exemplified in Example 1 of the priority document had allegedly been disclosed through prior use between the claimed priority date and the EP filing date[25]
- As to legal setting, T0665/00 refers in Reason 3.5 expressly to Reason 6.7 of G0002/98.

3.4 Although Reason 6.7 of G0002/98 was duly applied, the board approached matters in an unusual way: it decided in Reason 3.5.1 of T0665/00 that the density of <0.1 g/cm^3 in the claims as granted *"……permits the definition of……."* a group of microspheres, each characterised by a given density falling within the generic limitation <0.1 g/cm^3 and each element of the group representing an alternative to which its own priority date can be assigned. In short, the board ruled that all densities within the spectrum covered by the terms of the granted claim could be individualised to generate plural respective priority domains. Adopting this approach, the priority domain defined by density 0.04 g/cm^3 was entitled to the claimed priority date and was held not anticipated by the use which had taken place between the priority date and filing date. The remaining domains would be entitled to the filing date.[26]

3.5 This rather artificial approach appears to take *T0665/00* well beyond the boundaries of G0002/98, Reason 6.7 and therefore to treat the patentee with an unexpected leniency[27] which it is submitted is unlikely to be generally available: –
- There is no clear basis, and certainly not one expressed in Reason 3.5.1 of T0665/00, for taking the claims in question and individualising each of plural microsphere densities falling within the claimed <0.1 g/cm^3 limit, as the Appeal board did:
  - Following case law available to the board (T1127/00 *supra*), the board would have been expected to require a solid rationale for the split – some disclosure in the patent which supports the selectivity associated with individualisation. However, the patent in *T0665/00* specifically discloses only one density, namely the density of 0.04 g/cm^3 mentioned in Example 1, and is silent as to any other density within the spectrum concerned

25 Reason 2.3 makes it clear that the board did not actually accept that there had been prior publication; the consideration the board gave to priority date issues in the decision was to that extent *gratis dictum*

26 The board did not find the claims lacked inventive step, although there is a case that the approach taken left inventive step issues intact and unaddressed. For example, a composition comprising a microsphere component density of (say) 0.045 g/cm^3 would presumably not be entitled to the claimed priority date (as no domain so defined had not been disclosed in the priority document) and would presumably be open to challenge under Article 56 EPC for lack of inventive step. Parenthetically, it should be said that the expert evidence in the case suggests that composition properties are density-dependant and that might suggest such a challenge could be met – but the *general* point remains valid that the approach of the board in T0065/00 is, for reasons beyond novelty, likely to provide non-holistic and therefore imperfect solutions in many instances

27 From the decision, it's difficult to resist the feeling that this is not the only area in which the board demonstrated leniency

- As to the specific density mentioned in Example 1, the figure is not flagged in the patent in the individualised sense apparently required by the then existing case law. It is merely disclosed as one only of a number of microsphere characteristics (the copolymer composition and particle size for the microspheres are, for example, also recited in Example 1), and indeed the microspheres are one integer only of the overall budget of features in the Example (which also mentions, for example, pigments and other components representing the bulk of the composition disclosed)[28]. In short, the density integer is presented as part of a marriage with other features, the whole constituting an overall setting from which density alone cannot be individualised[29]

- In terms of "OR" claims, the proviso to Reason 6.7 of G0002/98 (per *T1127/00* and T0070/05) requires that splitting a claim across a generic term or formula into alternative features in priority date assessment is limited to situations where those features can be individualised to give rise to a limited number of clearly defined alternative subject-matters.[30] The approach of the board in T0665/00 to individualization does not create a *limited* number of alternatives, but many alternatives; in essence, the board divided a range, with considerable granularity, into its component parts using a denominator which seems tailored to the desired outcome.

3.6 Unlike *T0665/00*, the reasoning in *T0680/08* (April 2010) does not cite Reason 6.7 of G0002/98 but it did adopt an approach which has more than mere shades in it of that earlier T decision[31]: –

- In T0680/08, the claims of the opposed patent recited a numeric range of 0.330 – 0.415 kWh/kg for a parameter, total drive specific energy, in a chemical process. The range was held not disclosed in the priority document, which recited a different range of 0.325 – 0.415 kWh/kg; the range definition had been narrowed between P1 and P2 filings
- The board held in T0680/08[32] that "… *the subject-matter of claim 1 according to the main request – insofar as a method carried out at the lower bound value of 0.330 kWh/kg is concerned – is not entitled to the priority …"*[33] *(emphasis added)*
- However, the board went further, and surprisingly assigned the claimed priority date to a claim amended to exclude, by use of a disclaimer, processes carried out in accordance with the specific parameter of 0.330 kWh/kg on the basis that this limit was in the board's view responsible for loss of priority[34]; the board commented[35] that "… *methods carried out at claimed SEC values other than 0.330 kWh/kg, i. e. the subject-matter of claim 1 according to the first auxiliary request, concern the same invention as is disclosed in document D0*"
- It can be argued that the board split the claim in depicting it as having one domain specific to 0.330 kWh/kg and a domain representing the balance of the claim (namely, 0.330 – 0.415 kWh/kg truncated at its bottom end by loss of the specific 0.330 kWh/kg figure)
- The latter domain would, however, still be narrower than the priority document because it would exclude the parameter range 0.325 to <0.330 kWh/kg at the bottom end of the range recited in the priority document; it would thus not be the same invention and as a consequence would not enjoy the claimed priority date.

3.7 In summary, it is submitted that the amendment with which the patentee succeeded in T0680/08[36] does not result in a residual claim entitled to the P1 priority date – the residue of the claim following the disclaimer has date P2 and remains anticipated by the description in the priority document cited by the opponents. Additionally, viewed as a process of claim splitting, the two domains formed by the split have the same priority date. As a split must, it is suggested, produce domains of different priority dates (Reason 6.7 of G0002/98 and Article 88(3) EPC are concerned with *multiple* priorities) for it to be a *valid* split under, and fulfilling the purpose behind, Reason 6.7 of G0002/98, there was no basis for a claim split in T0860/08 in the first place.

An Important Philosophical Test

The fundamental purpose of recognising "OR" claims is to enable definition of individual priority domains which have different priority dates – Reason 6.7 in G0002/98 is about "multiple" priorities (see also T01127/00, Reason 6). Taking T0665/00 as an example, the density integer used to define the split in T0665/00 per Paragraph 9.3.3

28 On the latter point, the description in the patent specification beyond the Examples singles out the *class of* branded microsphere product (*Expancel*) of which one form (*Expancel DE*) was used in Example 1. Whilst this seems a move towards the necessary basis for individualisation, it seems to fall short of permitting individualization of density divorced from other microsphere attributes, such as composition and particle size. Perhaps the board thought the same as it did not propound this approach but ventured more deeply to decide on the basis it did

29 As demonstrated by the patent and the priority document, the patentee did not seem to know enough about microsphere density at either filing date. Accordingly, a reflection on the fundamentality that priority is awarded for knowledge which is appropriately demonstrated at both junctures, non-entitlement to priority is a consequence which objectively might well be seen as just

30 As noted previously, the exact language in Reason 6.7 of G0002/98 is: „*The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters*"

31 The boards in the two cases were not the same

32 Blog posts on this decision contained notable surprise, even taking into account that blogs are commonly a medium for anonymous expressions of astonishment by the blog's followers

33 The board thus was perhaps at least *courting* with the rationale of Reason 6.7 of G0002/98 – see Reason 2.1 of T0680/08 („… *the subject-matter of claim 1 according to the main request – insofar as a method carried out at the lower bound value of 0.330 kWh/kg is concerned – is not entitled to the priority…"*)

34 It is submitted that it is not the „*bookends*" per se that determine priority but the subject-matter between them – in this case, subject-matter which is not the same as that between the 0.325 and 0.415 kWh/kg „*bookends*" of the priority document

35 Reason 3.2 of T0680/08

36 The amendment was instigated by the board during oral proceedings

of the decision is exported from a specific setting much narrower than the general setting of the claim into which it is imported. The import seems unlikely to be priority-conferring.

If that is right, the split would not achieve its purpose of defining plural priority domains which collectively have at least two priority dates. The split, on this basis, is not a valid one in the first place, and in principle should be impermissible.

3.8 It is valid to consider a modification of the approach in *T0665/00* – on that fact pattern, dividing the claim into just two domains, Domain I characterised by microspheres of density 0.04 g/cm^3 and Domain II representing the balance of the claim. This has a sense of the right scale to it (*vis-à-vis* the proviso to Reason 6.7 of G0002/98) and so may deal with the issue flagged in the second (main) bullet point of Paragraph 3.5.

3.9 However, it does not deal with the issue flagged in the first bullet point of Paragraph 3.5 (see its second sub-bullet point) if Domain I is comprised of the subject-matter of the claim expressed in unchanged *general* terms save only for the *specific* density limitation applied to the microsphere component.

4. Discussion of the Decade of Development 2003 to 2012

4.1 The position in terms of EPO appeal decisions as of late 2012, then, is that, viewed overall, EPO Boards of Appeal have looked for real signs of individualisation in the patent/application in question to justify claim splitting; and there is evidence that, in some cases, boards have wanted basis for individualisation in the claim in question. T0665/00, supported by T0680/08, contrary to this strict line, takes a different approach which seems aberrant and unlikely to provide a secure basis for action. Based just on the number of boards that have taken the strict approach, there is likelihood that most cases, in the near future at least, will be determined on this basis. That must inform how risk is assessed by patentees/applicants and their opponents in contexts where patent validity hinges on considerations of multiple priority.

4.2 That having been said, it isn't that clear that this overall mood of appeal boards is based on a correct implementation of what was intended in G0002/98:

(i) Reason 6.7 of the G0002/98 states that when a generic expression is used in a claim, the test for awarding multiple priorities is that such use gives rise to the claiming of (a) a *limited number* of (b) *clearly defined* alternative subject-matters. Both these requirements need to be interpreted carefully, particularly the former.

(ii) Referring to the first requirement – the *limited number* requirement[37] – many generic expressions subsume very substantial numbers of alternatives which they import into the claim in question. It cannot have been intended by the Enlarged Board in G0002/98 that the number of alternatives a generic expression in a claim theoretically covers should be a determinant as to whether priority is or is not to be awarded. Referring to Paragraph 3.7 and the adjacent text box, the purpose of Reason 6.7 of G0002/98 is to enable the definition of domains of different priority dates. On that basis, a sounder interpretation of Reason 6.7 is that the Enlarged Board intended the *limited number* requirement to be with reference *not* to the number of theoretical alternatives the generic expression covers as a matter of semantics, *but rather* to the number of different *priority domains* it subsumes with reference to the priority documents.

(iii) As a requirement, that then seems a reasonable one as it would deny multiple priority in situations where the number of priority domains was sufficiently large to constitute an undue burden on a public needful of knowledge as to both the boundaries of the relevant patent protection and how those boundaries interact with validity and its dependence on priority date; the *clearly defined* requirement is, of course, similarly motivated. An interesting comment, which is less than supportive of the above, was made on the *limited number* requirement of Reason 6.7, G0002/98 by the judge in the HTC case *supra*[38].

(iv) It may also not make a great deal of sense for the system to produce outcomes such as mentioned in the footnote to Paragraph 1.1.6.

(v) If sub-Paragraph (ii) is correct as a matter of interpretation, it must follow that claim splitting is not dependent on what the patent/application identifies by way of individualised domains (the position taken in the decisions referred to earlier in Paragraph 3) but *per contra* on the disclosure of priority domains in the priority documents which fall within the scope of the claims in the patent/application. The alternative subject-matters to which the *limited number* and *clearly defined* tests of G0002/98 are applied are thus the sum of those which have a claimed priority date and those which do not.

(vi) This proposition is the converse of the overall *semi-consensus* position which has been developed in EPO case law over the *circa* 10 year period up to the end of 2012 – and indeed supported by the Nestec case[39] in the UK Patents Court within the few weeks prior to authorship of this paper. However, it is suggested that it is a proposition of merit.

37 The „*clearly defined*" requirement is submitted to be an Article 84 EPC test – the latter safeguards public interest, and public interest should demand clarity, not just on what a claim covers *per se,* but on what parts of that coverage grounds for invalidity impinge differently; that said, Article 84 EPC inherently calls for a determination which balances private and public interest although with the latter naturally of greater weight

38 The judge's comment, in Paragraph 160 of the judgement, reads (emphasis added) „*Although one can sympathise with the desire for a limited number, I doubt there is any principled basis for such a requirement but I accept the need for clearly defined alternative subject-matters if a single claim is to be given multiple or partial priorities*"

39 See Paragraph 2.6 above

5. 2013: The T1222/11 Approach to Split Priority

5.1 This decision, published in December 2012[40], also challenges the development of case law over the 10+ years which preceded it, and provides reasoning which has significantly greater depth – and obviously much greater authority – than the thoughts expressed in Paragraph 4.2 above.

5.2 In doing so, the decision goes out of its way to set out a complete alternative (and, by definition, contrarian) approach occupying just over 11 pages of *obiter* content which is formidably, if somewhat challengingly, reasoned. The decision directly demurs from the opinions set forth in *T1127/00*, T1443/05, T1877/08 and T0476/09 in Reasons 11.4 and 11.5 (pages 23 and 24 of the decision) as regards the proper interpretation of the proviso to Reason 6.7 of G0002/98 ("… *provided that it* [ie the use of a generic expression in a claim] *gives rise to the claiming of a limited number of clearly defined alternative subject-matters*").

5.3 *T1222/11* states that the determination of whether subject-matter claimed within an "OR" claim enjoys priority is independent of whether the subject-matter in question is identified in the "OR" claim[41]. This directly contradicts T1127/00 in particular. The decision justifies this position with detailed argument as to how Reason 6.7 G0002/98 is properly to be construed. With a degree of synthesis, the writer's interpretation of these arguments is as follows:

(i) Article 88 EPC deals with substantive issues of priority right and not just procedural issues[42]. More specifically, Article 88(3) EPC, when properly interpreted, states that if priority is claimed by an application, the applicant/patentee is *entitled* to priority for the *elements* of the patent application[43] included in the priority document(s). There is no conditionality that the included elements should themselves be identified individually as such in the patent/application. In line with this, the final sentence of Reason 6.7 of G0002/98 confirms that a claim in a patent/application claiming priority may subsume the *elements* in question within a generic expression such as a formula. [See Reason 11.5.1 of T1222/11 on pages 23 and 24 of the decision]

(ii) Per G0002/98, the determination as to which *elements* enjoy priority is to be carried out by comparing the claim under assessment with the priority document(s)[44]. The two tests set out in the proviso to Reason 6.7 of G0002/98 (namely, the *limited number* and *clearly defined* tests) refer, according to the board in T1222/11, to (i) the *alternative subject-matters* which are disclosed in the priority documents and are conceptually identifiable in the claim under assessment (as opposed to actually being individualised)[45] plus (ii) the *alternative subject-matters* encompassed by the claim but not disclosed in the priority documents. [See Reason 11.5.2 of T1222/11]

(iii) The *limited number* and *clearly defined* tests serve to enable the public to identify which parts of the claim concerned enjoy the benefits of priority according to Article 89 EPC. [See Reason 11.5.3 on pages 24 and 25 of T1222/11]

(iv) According to G0002/98, the legislative intentions[46] behind the provisions of Article 88 EPC regarding multiple priorities are as set out in the FICPI Memorandum[47]. The FICPI Memorandum makes clear by the words (quoted by the board in *T1222/11*): "*It is, of course, immaterial whether the word "or" actually occurs in the claim, or is implied through the use of a generic term, or otherwise*" that an embodiment need not be individualised as such in a patent/application to benefit from priority. [Reason 11.5.4 of T1222/11]

(v) The FICPI Memorandum gives three examples of "OR" claims. The first example refers to a context where a narrow formula in the priority document is replaced by a broader encompassing formula in the later priority filing. The example proposes that multiple priorities are enjoyed by doing no more than including a single claim directed to the broader formula; such claim carries the date of the priority document insofar as it *encompasses* the narrower formula. It therefore supports the contention that it is whether an element of an invention disclosed in a priority document *falls within the scope of the claim in question* that is determining of priority entitlement. This first example given by FICPI expressly uses the term "*scope*" in referring to the relationship between elements of the invention and the claim, adding to the clarity that the element need not be *individualised* in the claim. [See Reason 11.5.5, page 26 of T1222/11, lines 10, 11, 21 and 22].

(vi) The second FICPI Memorandum example attributes priority entitlement to temperature-defining domains of the claim concerned despite the fact

40 *T1222/11* is a helpful decision which points a way forward to a (perhaps) more hospitable approach to priority date assessment in multiple priority contexts. However, of the four options on intra-EPO distribution available to the board when issuing a decision, the deciding board opted for distribution to chairmen only, with the result that dissipation of the case may be slower than it might otherwise have been

41 Reason 11.8 on page 30 of the decision states: *„… so far as a subject-matter disclosed in a priority document and encompassed by an „OR" claim of a European application … is concerned, the decision on whether priority can be acknowledged for this subject-matter … is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the „OR" claim … as a separate alternative embodiment*" (emphasis added)

42 Reason 6 of G0002/98

43 Reason 6.2 of G0002/98 states that this term is synonymous with *elements of the invention*

44 Reason 4 of G0002/98 and Article 4H of the Paris Convention

45 Kitchin J may have got close to this in *Novartis AG v Johnson & Johnson Medical Ltd [2009] EWHC 1671 (Pat)*, where, at Paragraph 122, he stated: *„I discern from this passage [Reason 6.7 of G0002/98] that the EPO considers it is permissible to afford different priority dates to different parts of a patent claim where those parts represent a limited number of clearly defined alternative subject-matters and those alternative subject-matters have been disclosed (and are enabled) by different priority documents. Further, this principle applies even if the claim has adopted a generic term to describe and encompass those alternatives. I do not detect anything in the decisions of the Court of Appeal in Pharmacia and Unilin Beheer which is inconsistent with this approach and in my judgment is one which this court should adopt."*

46 Reason 6.3 of G0002/98

47 *Memorandum MI/48/I, Section C in the Préparatoires Travaux*

that they are not (all) "*explicitly or implicitly disclosed in the claim*". [See Reason 11.5.6, page 27 of T1222/11, lines 14 to 18].

(vii) The third example in the FICPI Memorandum presents a context where the claim defines in general terms a substrate to be treated (inner surfaces of a hollow body) but it is stated by FICPI to enjoy priority for domains disclosed in priority documents (inner surfaces of pipes) which fall within those general terms but are not identified as such in the claims. The identifiable alternative subject-matters in the claim are those related to treatment of inner surfaces of (a) pipes and (b) hollow bodies other than pipes. [See Reason 11.5.7 of T1222/11]

(viii) The opinions expressed by the board are not, in the board's view, inconsistent with the key teaching set out in the Conclusion of G0002/98 (that the skilled person must be able to derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole). The EBA's Conclusion (see page 20 of G0002/98) is not, according to the board in T1222/11, applied to "OR" claims as such *in vacuo* but takes account of, and is without prejudice to, both Reason 6.7 of the EBA's decision and to the provisions of Article 88 EPC. Reason 6.7 is to be applied to a claim in a comparative manner with respect to the priority documents so as to identify a domain within the claim scope for which the priority document contains basis entitling that domain to priority[48]. [See Reason 11.7 of T1112/11 on page 30]

(ix) G0002/98 emphasises the need for application to patents/applications of the legal concepts underlying EPC in a consistent and coherent manner. This is important when considering Article 87(4) EPC, which provides for priority rights to be generated only from the *first* application for protection of an invention. When, for example, a priority document P1 encompasses narrow subject-matter already disclosed in an earlier application *P minus 1* filed before the start of the Paris Convention period applicable to the context, this is a crucial question. By custom and consensus, answering the question does not involve determining whether the narrow subject-matter is actually identified in an individualised manner in the later specification P1. For consistency, the same standard of consideration must apply to the different question of the priority date candidature under Article 88(2)(3) EPC of a domain within a claim of a P2 patent/patent application validly claiming priority from that P1 priority document – the principle of consistency and coherence between implementation of Article 87(4) EPC and Article 88(2)(3) EPC means that priority cannot depend on whether the subject-matter of the domain is actually identified in an individualised manner in the P2 case. [see Reason 11.8, bridging pages 30 and 31 of T1222/11]

5.4 As noted already, *T1222/11* demurs from the *T1127/00* position that, for a domain of a claim to enjoy a claimed priority date, that domain must be individualised in the claim concerned. It appears, however, that T1222/11 may go further and establish that the domain need not be individualised in the application/patent **as a whole**.

5.5 The board's elaborate and independent reasoning, which leads off from G0002/98 along an entirely different road to T1127/00, means that the board's conclusion has no inherent pre-requisite that a domain disclosed in a priority document and encompassed by the claim in question, if not identified as such in the claim, must nevertheless be flagged in the body of the patent specification.

5.6 In addition, simple logic would suggest that, in terms of this issue, there is no distinction to be made between a condition under which subject-matters are identified in the claims which encompass them and a condition under which such encompassed subject-matters are identified in the patent/application in question as a whole – if the former is not a requirement, then nor can the latter be. Moreover, there is no part of G0002/98 or the FICPI Memorandum which suggests that **any part** of a patent specification must itself, as a pre-condition for priority entitlement, identify a domain for which priority-generating basis can be found in a priority document. It is perhaps notable that the (somewhat difficult language) of Reason 11.8 refers at its very end (page 31) in a specific context to the lack of any need for identification of a priority domain (anywhere) in the later application there referred to.

5.7 Although T1222/11 does not mention *T0910/06* (December 2008) *supra*, it is possible that the latter-mentioned decision provides support for the position taken by the board in T1222/11.

5.8 In T0910/06, priority date entitlement for a claim in a patent under opposition needed to be established to distinguish the invention over a self-disclosure – a scientific paper published by the inventor before the filing date. Relying on Article 88(4) EPC and Reason 6.2 of G0002/98, the board took the approach of seeking an answer to the query as to what subject-matter in the citation which fell *within the scope* of the claim under challenge could also be found in PD2 – the board expressing the view that, in such case, the citation did not form part of the state of the art as the claim would enjoy the date of PD2. The board found this to be the case on a fact pattern in which it assessed PD2 as disclosing, in its overlap area with the claims, the same mix of reactants and initiator as did the citation. The board did not cite Reason 6.7 of G0002/98 but from Reason 6.7 (sic) of T0910/06 it seems clear the board was articulating the idea of a claim split to define a domain entitled to the date of PD2. The board appeared not to

48 This suggests the T1222/11 approach will mean more opportunities for award of multiple priorities where the subject-matter of the claim as a whole does not pass the test set out in the Conclusion of G0002/98

be looking for any individualization of the relevant priority domain in the patent, merely stating (again in Reason 6.7 of T0910/06) that the subject-matter of the domain fell *within the scope* of the claim under consideration (as in *T1222/11*). It may have been possible to find basis for such individualisation[49] but the board in T0910/06 did not seem to make it a pre-requisite[50].

5.9 It is interesting that in the Nestec case *supra* before the UK Patents Court in April this year, the judge appears not to have considered T1222/11 even though that decision was published several months before his judgement[51]. T1222/11 also appears not to have been considered by the (different) judge in the event more recent HTC case *supra*, which came to trial in the weeks bridging April and May 2013. In Netstec, an appeal to the UK Court of Appeal was filed in June 2013, a trial date in late 2013 or early 2014 being expected. Additionally, an appeal is pending before an EPO board of appeal (Appeal T1674/12) on the same European patent[52] and is expected to be heard later this year[53]. It therefore seems likely that a view on T1222/11 may be forthcoming from both appellate instances in the relatively near future.

6. Specific Embodiments as Priority Domains

6.1 In cases where priority date really matters, it is commonly because of an interim publication which (as noted in the footnotes to Paragraph 1.2.1) experience shows is not only rather specific but which also emanates from persons associated with the patent in question (eg the inventors or the patentee)[54]. Typically, in such cases, the publication is of a commercial form of the invention or a *whole contents* citation which discloses a specific embodiment of the invention. Where such a disclosure is cited against a claim established to be disentitled to a claimed priority date that would have neutralised the citation, it is relevant to pose the question*:*

Could the claim be partitioned under Reason 6.7 of G0002/98 to define as one priority domain the subject-matter of the specific embodiment (that domain then enjoying the date of the priority document)?

6.2 Two cases where the fact pattern appears to have presented an opportunity for the board to do just that are (i) T1443/05 and (ii) T0665/00 *supra*. T1443/05 is a case where *whole contents* conflict arose between generationally separated family members, the patent in suit having claims which did not enjoy the priority date of the cited matter as a result of a disclaimer introduced after first filing. The cited matter was specific Examples of earlier priority date in the published priority document, the latter cited as a *whole contents* citation[55]. T0665/00 *supra*, whilst not quite the same scenario, was similar in that the citation was of a prior use of an Example in the patent in suit, which prior use took place between the claimed priority date and the filing date[56].

6.3 In T0665/00, in which decision the deciding appeal board ultimately decided in favour of the proprietor, it seems that the fundamental motivation of the board emanated from a view that justice would be served by neutralising the anticipatory prior use conflict. The special approach of splitting the claim to provide a domain whose subject-matter is the offending Example could theoretically have cured the problem and that would have aligned with the board's apparent motivation. However, the deciding board chose *not* to take the approach of splitting the claim to create a domain whose subject-matter is the offending specific embodiment. In T1443/05, the board decided against the patentee but the above special approach was available to it. However, the deciding board in that case too chose *not* to take the approach of splitting the claim to create a domain whose subject-matter is the offending specific embodiment. In the limited sense that such domains are usually unlikely to satisfy the *clearly defined* test set out in the proviso of Reason 6.7 of G0002/98[57], this seems sensible in both cases. In the case of T1443/05, the plurality of the specific embodiments would perhaps also

49 In terms of individualisation, first impression suggests that the reaction mixture features of T0910/06 mentioned in the body of Paragraph 5.8 above are constituents severed from Examples. It is submitted that by reference to the patent specification, this is not so; rather, the constituents are mentioned in passages which, although *organisationally* positioned as if part of the body of Examples, are not *intellectually* fixed in that setting. As such, the features are individualised and would in the context not unreasonably have been combined as a priority domain of the claim under assessment following the T1127/00 approach to G0002/98

50 T0352/97 (October 2000) may be earlier appeal board thinking somewhat in alignment with T1222/11. The board assigned the date of PD1 to subject-matter which subsumed the intermediate prior art and which corresponded to a subset of substituent definitions disclosed as such in PD1 and encompassed within the overall scope of the claim concerned; there was no apparent search for a disclosure of the subset identified as such in the case under consideration

51 The Nestec trial was in Q1 of 2012 and, whilst the parties would not have had an opportunity of being heard on the matter of T1222/11 at trial, it is possible (indeed not uncommon) for parties to send newly issued decisions to the judge, with a short note, after trial and before judgment is handed down

52 The litigation of the patent in suit forms part of a portfolio of proceedings in various jurisdictions

53 It is understood that T1222/11 has been cited in the EPO appeal

54 See Paragraph 1.2.1 and its footnotes, above

55 T1443/05 is similar to T0680/08 in terms of the legal principles applied and the fact that both are in the chemical field. In T1443/05, the priority document (a European patent application which had been published and which was citable as a *whole contents* citation as of the priority date), embraced the presence of a particular biocide in a biocide composition. The claims of the eventual patent disclaimed the presence of this component. The patent and priority document were held in opposition proceedings relating to the former not to relate to the same invention and the claims in the patent were thus held disentitled to the claimed priority date. Examples in the priority document in which the relevant biocide was absent (a) did not support the priority claim and (b) were held to anticipate the patent as it fell within the scope of its claims. An interesting paper analysing T1443/05 appears in *EPI Information 2/29 („Study of Priority Right under EPC: Same Invention/Disclaimers", F Portal*, EPI Information 2/09, pages 56-59. The Portal paper states (page 58, column 1) that all of the Examples of the priority document in T1443/05 which disclose compositions from which the particular biocide concerned was absent, appear in the application which matured into the opposed patent (and would be entitled to the date of the priority document). A quick review by the non-German-speaking writer of the present paper could not fault this

56 It will be recalled that, in T0665/00, it was established as fact that Example 1 of *the patent* and Example 1 of *the priority document* were the same, the former simply giving more details of what the branded microsphere component actually was (Reason 3.2).

57 As to clarity, Example 1 of the patent in T0665/00, not untypically of many patent specifications, defines the microspheres in part by reference to a trade mark, and there is a run of case law holding that use of a trade mark in a claim contravenes Article 84 EPC (see T0762/90, T0932/92 and T0480/98)

mean that the *limited number* test of G0002/98 would not be met. But perhaps the point is that in neither case do the decisions suggest that the above special approach has been contemplated.

6.4 Specifically at the UK level, Hospira[58] is a case where Example 5 in the patent reported a Phase 2 clinical trial and where the same report appears as Example 5 in PD2 (the only priority document at issue) – therefore, on the face of it, Example 5 of the patent was subject-matter carrying the PD2 priority date. The primary (novelty) citation, relevant only for subject-matter disentitled to the date of PD2, also reported the same Phase 2 trial. The citation, however, used different language and, to some extent, different terms (eg with reference to the definition of the patient volunteer group receiving treatment). This underlines the difficulty in deploying Examples in this way as the question of whether the cited subject-matter falls wholly within the defined domain (which would mean a neutralised citation) or whether it straddles the walls of the domain (which would not clearly have the neutralising effect) is not easy. Of course, one could instead define the priority domain as consisting of the report of the clinical trial in the citation, and the question then requiring an answer would be whether that subject-matter satisfied the identity of invention test laid down in the Conclusion to G0002/98 so as to have the date of the priority document.

6.5 On the basis of most case law experience to date, it is reasonable to venture the instinctive prediction that the idea of splitting a claim to provide a domain whose subject-matter is the offending Example of a citation is unlikely to be a popular one with many EPO appellate instances and other tribunals in the foreseeable future. Indeed, it's hard to resist the feeling that it is debatable whether *in principle* an Example would be capable of the individualisation contemplated by G0002/98[59] as interpreted eg by the appeal board in T1127/00. It remains to be seen whether T1222/11 will change this.

7. Split Priorities – Practise

7.1 The concept of priority is exceedingly difficult and collective EPO appellate case law, whilst helpful, is disappointingly so. The notion that a priority domain must be seen as individualised in the patent/application under assessment enjoys a degree of establishment, whilst at the same time being poorly understood by a significant audience and not always easy to implement. *T1222/11* seems, although this is an early stage, a sensible decision with practical benefits in terms of priority date assessment generally – and in terms of dealing with *Poisonous Division* and *Poisonous Priority Documents*[60] more specifically.

7.2 It is tempting to conclude that the decision in T1222/11 will result in a referral to the Enlarged Board of Appeal; indeed, the decision manifests all the hallmarks of a device created to lead to just that result.

7.3 In the interim, prudent practitioner policy – remembering that even practitioners whose practice is wholly patent procurement have to stand in the two opposing corners of securing priority for their client's claims and obstructing priority for cited matter under Article 54(3) EPC – should recognise that, as matters stand, outcome will depend on whether it is the *T1127/00* or T1222/11 approach to multiple priority that prevails in any particular instance[61].

7.4 Best drafting practise in preparing patent applications at the stage of filing priority-claiming applications will no doubt, pending an Enlarged Board of Appeal decision, be to ensure that all originally disclosed features falling hierarchically below the broadest scope of claim going forward are clearly retained in the priority-claiming filing[62]. As noted earlier, it is common for anticipatory material to be self-published (eg as *whole contents* matter), and here the necessary strategy is to ensure the presence of a disclosure which individualises an embodiment which (a) is entitled to priority and (b) encompasses the self-published matter. Experience seems to show that this does not always happen. Under G0002/98 and *T1127/00*, this would enable a claim which has been broadened to be partitioned into a domain distinguished by virtue of priority date and a domain which is novel by virtue of subject-matter differentiation.

7.5 It should be appreciated that in principle the same rationale applies where the case going forward has been *narrowed* by incorporation of a new narrowing feature; a domain reflecting even greater narrowing and entitled to priority may well be distinguished over such a self-disclosure as mentioned above and, in the same fashion as in broadening contexts, serve through the claim-splitting process of G0002/98 to save the claim from what would otherwise be an anticipation.

58 Hospira and another v Novartis, [2013] EWHC 516 (Pat) *supra.* One of the Novartis patents involved is subject to EPO opposition also citing the principle novelty citation deployed in the UK Patents Court proceedings

59 The message in Reason 6.7 of G0002/98 is that it is intended to deal with situations where development of the invention in the first year after first filing gives rise to a second filing which introduces Feature B as an alternative to Feature A disclosed in the first filing. Assuming the specification drafting supports it, one can imagine fitting into this scheme a narrowing scenario – splitting out of embodiments characterised respectively by a narrow Feature B (Priority P2) and an originally disclosed preferred form of Feature A (Priority P1) which is even narrower. However, that seems to be an adventure in itself and it could be that a split to define a domain consisting of an entire specific embodiment is simply not permissible as a matter of principle

60 As to both, see:
(1) *„Poisonous EPC Divisionals (Just as you thought it was safe….)"*, Malcolm Lawrence, *Inventive Steps – Ideas in IP Management, December 2010*
(2) *„Poisonous EPC Divisionals – Implications for Risk Management & Opportunistic Advantage",* Malcolm Lawrence & Marc Wilkinson, *EPI Information, No 2/2011*, pages 54-61, European Patents Institute, June 2011
(3) „Thoughts and Feedback since Original Publication of the ‚Poisonous Divisionals' Concept", Malcolm Lawrence & Marc Wilkinson, *Journal of the UK Chartered Institute of Patent Attorneys, February 2012, pages 74-78*

61 It is not totally unrealistic to assume that, pending an Enlarged Board of Appeal decision, there is a prospect that boards in the pharmaceutical and life sciences fields may follow T1127/00 (which was a biotechnology decision) whilst boards dealing with other matter may follow T1222/11 (where the patent was not in these areas)

62 There is in principle quite a lot of potential practitioner control at this point, although obviously falling short of an omniscient awareness of all prior art that may produce a call for a multiple priorities

8. Applying the G0002/98 Conclusion to Priority Documents

8.1 The more case law that is read on this subject, the clearer it is that the philosophical and practical need for consistency between the various principles underlying the EPC has driven home a firm policy that the standard to be applied when considering a priority document for basis for a priority claim is the same as under Article 123(2) EPC. Voices can be heard in IP corridors which (still) suggest that the EPO will sometimes adopt a softer approach for priority date assessment. Although this is not without some grounds[63], the case law overall makes it clear that no safe presumption can be drawn from this: it is evident from G0002/98 that a narrow and strict interpretation of the concept of "*the same invention*" should be applied, equated to the concept of "*the same subject-matter*" referred to in Article 87(4) EPC, and that this is being applied faithfully by at least the more experienced lower appeal boards – and indeed the stated reasoning set out in the Conclusion of G0002/98 is reiterated *in terms* with ubiquity in appellate decisions.

8.2 In *T0070/05* (February 2006), the above was illustrated by a very experienced board in holding the claims in question as entitled to the claimed (first or second) priority dates and then applying G0002/98 to the whole contents citation alleged nevertheless to anticipate them. The board noted that a small percentage of the amino acid residues of which the receptor molecules disclosed in the citation and its priority document consisted were different as between the priority document the citation, holding that this deprived the citation of the right to priority (see Reason 13). The board suggested that this would be the right decision regardless of the reasons for the different amino acid in the two documents, even if this was due eg to a typing error.[64]

8.3 Somewhat analogous fact patterns arose in *T0351/01* (July 2003), *T0030/02* (October 2006), *T0902/07* (December 2010) and, in particular, *T1213/05* (September 2007). In T1213/05, the patent claimed a nucleic acid the definition of which relied on a coding sequence which enjoyed more than 99.5 % homology (see Reason 28, third paragraph) with a coding sequence disclosed in a priority document. It was argued by the patentee that, if parameters used to define a substance in a claim are known to vary within margins of commonly encountered experimental errors, variation in such a parameter between a priority document disclosure and a claim being assessed for priority date purposes did not necessarily abrogate entitlement to the claimed priority date. However, the board disagreed (Reason 29), referring to G0002/98 and T0070/05 *supra* in particular, as well as, comprehensively, to various other appellate decisions[65,66].

8.4 The decisions referred to in Paragraphs 8.2 and 8.3 relate to cases in the biotechnology field and it is in this field, and in the chemical and pharmaceutical fields, that most cases, and the most argued cases, can be found. However, it hardly need be stated that this is a circumstantial reality rather than a limit on applicability of G0002/98.

8.5 As to other technologies: –

- In *T0184/06* (March 2007), the Conclusion of G0002/98 is applied in Reason 6.1.1 to disallow priority for a claim broadened to include additional possibilities for a component of a chemical composition and for the absence of another component required in the priority document. It is perhaps the firmness with which the decision (a feature it has in common with others) refers to the *"established jurisprudence of the boards of appeal"* (Reason 6.1.1) which makes the decision compelling, together with the specific referral to Reason 9 of G0002/98 (which latter concludes that the so-called "*narrow*" interpretation of the expression "*same invention*" is to be applied in priority date assessment)
- *T0273/04* (March 2006) is a relatively rare example of seriously challenged priority date assessment in a mechanical case, the decision made being in favour of the patentee. It is not immediately clear from Reason 2 of the decision how the differences between the terms in which the subject-matter was claimed and those of the second priority document were not fatal to that priority claim under the G0002/98 test. Both the description and the claims of the (second) priority document call for a configuration including members having side walls and concave-shaped and convex-shaped further walls having apices which, in at least one case, is substantially flat (arguably, on the basis of the description in the priority document, only a preferred feature). Claim 1 of the Main Request does not recite this configuration but was nevertheless held entitled to the date of the priority document. Further, that claim also recites the presence of longitudinal struts and this can be compared with the disclosed *preferred* feature in the priority document of longitudinal struts – but there these connect the apices whereas the claim in the patent merely states that the struts connect rows of the members. As a mechanical case, T0273/04 may simply reflect the tendency for cases in certain technologies by habit to experience

63 See the examples in Paragraph 8.5, second bullet point and Paragraph 8.6, below

64 This point in T0070/05 is made with reference to that decision, but with perhaps even greater force and clarity, in T1213/05, Reason 33, second paragraph

65 Oral proceedings were heard in both T0070/05 and T1213/05 by very experienced boards, in T1213/05 a five-member board. Both T1213/05 and T0070/05, in surveying a great deal of case law on the subject of priority date assessment, are each a memorable tableau on the topic not limited to the specific points made here. Reason 29 of T1213/05 is perhaps the most powerful development of the key teaching of G0002/98

66 In this respect, as already noted above, the point in T0070/05 about small discrepancies between patent and priority document (eg caused by experimental errors) is made with reference to that decision, but with perhaps even greater force and clarity, in T1213/05, Reason 33, second paragraph. Reason 40 of T1213/05 expresses the board's firm rejection of the notion that the narrow interpretation of the requirement for identity of invention should be replaced in specific cases by a different approach taking account of *„possibly unintended errors resulting from specific physical characterization methods"*, adding the further point that the Enlarged Board of Appeal in G0002/98 state that a distinction between technical features related to function and effect of an invention and features not having this significance must be avoided

Article 123(2) EPC with less injury[67], as well as less frequency, than say biotechnology cases.

8.6 There are cases in the biotechnology field which contrast with *T0070/05* and *1213/05*, although these can be explained and don't detract from the substantial establishment enjoyed by the strict application of the *"narrow"* interpretation of the expression "*same invention*". In *T0065/92* (June 1993), the board held that a glycosylated polypeptide of molecular weight 61-68kD was entitled to priority from a priority document disclosing one of molecular weight 61-65kD. However, importantly that decision predates G0002/98 by nearly 10 years and it is suggested that it would be decided differently now for several reasons. First, Reason 3.2 (final paragraph) of T0065/92 suggests that the board was influenced by an understanding that the difference was "*qualitatively irrelevant*" in terms of function, a factor which would not *per se* find favour with a modern board, and did not find it with the board in the run of decisions led by *T1213/05*[68]. Secondly, notwithstanding that both the patent and priority document made it expressly clear that the reader was being informed of approximate figures, the patentee made a choice in presenting the skilled man with different information in the patent[69].

8.7 As an aside, it is suggested that the same is not quite true in the case of the branded microsphere component density in T0665/00 *supra*, whose priority document recited no density at all in its Example 1. The question was whether Example 1 of the patent, *which did*, was the same, in particular with respect to density. In what must have been a difficultly balanced decision for the board, patentee submissions – supported by expert evidence – that the microsphere density in both was *virtually* the same[70] were accepted as establishing as fact that this was indeed the case. The approximation took place outside the documents being compared and was attributed to the evidence rather than those documents.

8.8 In this respect, as mentioned earlier[71], the board in T0680/08 drew a clear distinction between claims *broadened* and claims *narrowed* at P2 filing relative to the relevant priority document, and in Reason 1.3, second paragraph the board stated that it found nothing in G0002/98 to suggest that the Enlarged Board of Appeal had "*explicitly*" considered situations where a claim had been "*marginally*" narrowed (in the case before it, the range "0.325 – 0.415 kWh/kg" had been changed to "0.330 – 0.415 kWh/kg"). In the light of the emphasis the Enlarged Board put on the need for a "*narrow and strict approach*" to the expression "*same invention*" and to the clear ruling in the Conclusion of G0002/98, the approach in T0680/08 seems highly adventurous and out of alignment.

Please feel free to offer feedback to the author at *malfiblu@yahoo.co.uk*

67 Although there are exceptions, of course – see, for example, T0030/01 (June 2004) concerning an imaging apparatus and T0832/04 (September 2006) concerning a bale shredding apparatus, although these perhaps were not cases where the board was faced with especially contentious situations

68 In T1213/05, the board held in Reason 31 that for justice to await a decision on whether deviations between a priority document and a patent claim had any effect on the function of the subject-matter in question would be incompatible with G0002/98. The decision refers with approval to T0351/01 in which polynucleotide sequence deviations were sufficient to deny priority even though the deviations were in non-coding regions of the polynucleotide and could not have any functional effect on the polynucleotide or the protein it encoded

69 There is an analogy here with early Article 123(2) EPC case law drawing a distinction between information originally disclosed and information which was not but which falls within the scope of the original disclosure. Information is either new or not, and a flag in both documents concerned in T0065/92 indicating that the data constituting it is approximate does not, through the notion that approximation naturally infers scope, do anything to change that

70 Example 1 of the patent in T0665/00 stipulated presence of a branded microsphere product of density 0.04 g/cm^3. In the expert testimony referred to, a figure of 0.036 g/cm^3 was given for that branded product used in Example 1 of the priority document

71 See Paragraph 1.1.9 footnote

Getting everything decided at first Instance at the EPO

G. W. Schlich (GB)

The EPO Brüstle Decision was decided on added matter. Having revoked the patent for contravention of Article 100(c) EPC, the EPO's job was done. After all, only one ground is needed to revoke a patent. That is understood. There was no reason to continue the proceedings and deal with morality under Article 100(a) EPC or with sufficiency under Article 100(b) EPC. It may even be said that it would be incorrect to continue once the patent is revoked.

The EPO Brüstle case has now been punted into the long grass of the appeal system, and a successful appeal may well deal solely with the added matter issue, bouncing the case to the Opposition Division some 4(?) years later, at which time no doubt a sufficiency issue could be taken first, again potentially disposing of the case (in accordance with the EPC we should stress) and with no need yet to address morality – the one aspect of the case the outside world is interested in.

As practitioners, we would welcome a procedure that ensures all issues are addressed at e.g. the first opposition hearing. If added matter attacks fail but the patent is revoked for insufficiency then the hearing should nevertheless move onto novelty and inventive step, giving a decision under each of 100 (a), (b) and (c).

The EPO is invited to consider internal changes in opposition procedures so as to require a decision under each ground raised, so potentially under each of Article 100(a), (b) and (c) EPC.

The Search For Morally Allowable Starting Material – When Is An Embryo Not An Embryo?

The test for excluded subject matter under Rule 28(c) is explained in the current EPO Guidelines For Examination, Part G, Chapter II as follows:

A claim directed to a product, which at the filing date of the application could be ***exclusively*** *obtained by a method which necessarily involved the destruction of human embryos from which the said product is derived is excluded from patentability under Rule 28(c), even if said method is not part of the claim (see G 2/06). The point in time at which such destruction takes place is irrelevant.*

This test prompts a search for the first date on which human embryonic stem cell lines can be derived without destroying an embryo, and there is an official date. The EPO accepts that as of 10th January 2008 such allowable starting material was available (Chung *et al*, Cell Stem Cell. 2008 Feb 7;2(2):113-7. doi: 10.1016/j.stem.2007.12.013. Epub 2008 Jan 10). An earlier publication by the same group (Klimanskaya *et al*, Nature. 2006 Nov 23;444(7118):481-5. Epub 2006 Aug 23) has not been accepted to date by the EPO as providing morally acceptable starting material, as the cells obtained were co-cultured with (and hence contaminated by) human embryonic stem cells obtained using conventional techniques considered to require embryo destruction.

The German Brüstle Decision raises another option: that embryos whose development has arrested are no longer embryos, with the consequence that human embryonic stem cell lines derived from those structures are *not derived from embryos*, in which case there can be no embryo destruction in the process.

In *International Stem Cell Corporation v Comptroller General of Patents,* [2013] EWHC 807 (Ch), a similar point was raised and has been referred to the CJEU under C-364/13. Nevertheless, having made the referral, Henry Carr QC gave the preliminary view:

I agree with ISCC that if the process of development is incapable of leading to a human being, as the Hearing Officer has found to be the case in relation to parthenotes, then it should not be excluded from patentability as a 'human embryo'.

This is in line with the decision in the German Federal Court; a structure that can not complete development into a human being is not an embryo. How does this help with the first date on which morally acceptable subject matter was available? Answer: stem cell lines exist and are deposited so as to render them publicly available in which the cells are derived from these *non-embryo* structures, and earlier than 10 January 2008.

Zhang *et al*, "Derivation of human embryonic stem cells from developing and arrested embryos", Stem Cells 2006 Dec 24(12): 2669-76. Epub 2006 Sep 21 is one such disclosure of deriving human embryonic stem cells lines from these *non-embryos*, taking the date to 21 September 2006. There are many cell lines made in a similar manner from e.g. embryos rejected from *in vitro* fertilization procedures. We haven't had the time yet to identify earlier examples, but we expect these go back earlier still.

Lastly, the CJEU in C-34/10 (the "Brüstle CJEU decision") decided that totipotent cells are unpatentable and constitute embryos. The Chung *et al* techniques mentioned above remove a cell from an 8-cell blastomere, yielding a 7-cell structure that is an embryo and can complete its development and a 1-cell structure, used to derive a cell line. What is the potency of that 1-cell?

Van de Velde *et al*, Oxford Journals, Medicine, Human Reproduction, Volume 23, Issue 8, pp. 1742-1747 report that cells from the human 4-cell blastomere are totipotent. Does this mean that individual cells isolated from the 8-cell blastomere are also, or partially totipotent? If so, is that 1-cell structure also an embryo (the Chung technique splits one embryo into two embryos?) and is an embryo destroyed when the cell line is made from this 1-cell structure?

Stem Cell Patents in Europe – No End To the Waiting?

On 28th June 2013 the European Brüstle patent (EP 1040185) was formally revoked, but the EPO did so without considering morality issues; sadly, therefore, we are no closer to resolving the patentability of human stem cell inventions in Europe. As the EPO has not gone beyond the WARF decision (G 02/06) we will have to do so ourselves. We offer our own solutions and make a suggestion as to how EPO internal procedures may be modified for the future.

As background, Prof. Dr. Brüstle has parallel European and German patents relating to neural precursor cells, derivable from cells obtained from human embryos (as well as other sources). The patents are notable in that they were initially objected to in both jurisdictions as covering subject matter that necessarily required destruction of human embryos – thus rendering the claims unpatentable in accordance with the EPO's WARF decision, as supplemented by the CJEU decision in C-34/10.

Brüstle German Federal Court Proceedings – Patent Maintained

In November of last year, the German patent was considered and the German Federal Court handed down its decision in Brüstle vs. Greenpeace (X ZR 58/07, the "German Brüstle decision"), holding Prof. Dr. Brüstle's German patent valid in amended form, with a disclaimer to state explicitly that the method claimed does not encompass methods that destroy embryos. The decision was widely reported, but more should have been said about specific elements of the decision: namely

(i) the disclaimer was found allowable,
(ii) sources of starting material that did not destroy embryos were accepted as being disclosed in the application as filed, and
(iii) structures which were once embryos and whose development has been arrested so they can not complete the process of developing into a human being (but from which human embryonic stem cell lines can be derived) do not constitute embryos.

Brüstle EPO Opposition Proceedings – Patent Revoked

On 11th April 2013 oral proceedings were held in respect of the opposition against the Brüstle European patent, EP 1040185, and a decision to revoke the patent was handed down on the day (the "EPO Brüstle decision") and formally issued on 28th June 2013. The key topic for parties to the opposition was application of the morality provisions of the European Patent Convention. Third party observations were filed on that issue. The stem cell patent world watched and waited for a final resolution of the stem cell patenting issue.

This resolution did not arrive, however, as the EPO instead promptly revoked the patent for added matter, choosing to take this issue first, and having revoked the patent closed the proceedings and made no decision on morality. The basis for the decision: the disclaimer allowed by the German Court was held to constitute added matter by the EPO and disallowed (on essentially the same claim language and facts).

What a shame. What an opportunity missed. And what can we do about it?

Getting All Issues Heard at First Instance At The EPO

While we do not have all the details of the system, it is widely understood that the EPO operates performance monitoring of Examiners – see Box 1. A revision and a procedural change may promote hearing of all issues at first instance – which would have meant morality being dealt with in the Brüstle EPO decision.

Current EPO Practice Re Morally Acceptable Starting Material

As of today, inventions in this field post 10 January 2008 are regarded as unproblematic, as morally acceptable starting material is available from at least that date. See Box 2 for details and an analysis of how that issue too needs reconsideration.

What Next? Back To The Intention Of The Legislator

The existing decision made by the EPO in WARF, as supplemented by the CJEU decision in C-34/10, enunciates a patentability test that does not enable the EPO adequately to deal with patent applications in which the fact situation presented differs from those in the WARF case, namely the proposed destruction of embryos by the person making the invention and by any person subsequently carrying out the invention.

The EPO Brüstle decision could have revised the test to deal with other fact situations; it didn't, so we will have to do this ourselves.

The *original object and purpose of the legislators* in framing the wording of the exclusion from patentability in Rule 28(c) must be properly incorporated into the interpretation of the exclusion; and this must also be done taking into account the context in which human embryonic stem cells (hESCs), human induced pluripotent stem cells (hIPSCs) or other such cells are used and proposed to be used in each invention under examination.

When this approach is taken it is seen that the EPO practice that has developed in light of the WARF decision is too restrictive; patent protection is being denied for inventions the legislator did not intend to exclude from patentability.

Just as EPO disclaimer practice aims at disclaiming no more and no less than is necessary to achieve the object of the disclaimer, EPO practice on exclusions from patentability should aim at removing no more subject matter than is necessary to fulfil the legislator's original object and purpose in framing the exclusion from patentability.

That object and purpose was to prevent commercialisation of embryos. Hence, EPO practice in this area should aim only at removing subject matter from a patent claim (and possibly also corresponding subject matter from elsewhere in the specification) that relates to commercialisation of embryos.

Interpretation of International Treaties

In G1/07 (Method by Surgery/Medi-Physics) and G2/08 (Dosage Regime/Abott Respiratory) the EBA indicated that all EPC provisions should be interpreted in accordance with Articles 31 and 32 of the Vienna Convention on the Law of Treaties 1969.

Article 31 indicates that:

"'A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its **object and purpose**"

Article 32 allows recourse:

"… to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of article 31"

Hence, to reach the correct interpretation we should look back in detail at the object and purpose of the exclusion as in the minds of those drafting the original legislation.

Legislative History Of The Biotechnology Directive

The first (1995) and second (1996) drafts of the Directive did not contain any exclusion provisions relating to the use of human embryos. The Group of Advisers to the European Commission on the Ethical Implications of Biotechnology issued its 8th Opinion in September 1996. Opinion No. 8 was concerned with ethical aspects of patenting inventions involving elements of human origin; an invention which "infringes the rights of the person and the respect of human dignity" cannot be patented.

In the third draft of the Directive submitted by the Commission in 1997, Article 6 read:

Article 6

1. Inventions shall be considered unpatentable where their commercial exploitation would be contrary to public policy or morality; however, exploitation shall not be deemed contrary merely because it is prohibited by law or regulation.
2. On the basis of paragraph 1, the following shall be considered unpatentable:
   (a) …
   (b) …
   (c) **methods in which human embryos are used**;
   (d) …

Finally in the Common Position EC No 19/98 adopted by the Council on 26 February 1998, the text of Article 6(2)c was amended to read "**uses of human embryos for industrial or commercial purposes**". This is also the text of Article 6(2)(c) of the final version of the Directive that was adopted on 6 July 1998.

It is seen that the original wording would have excluded "methods in which human embryos are used" and that the revised wording switched this order around and changed it slightly to result in the final wording "uses of human embryos for industrial or commercial purposes". Perhaps the intention was to cover not only methods in which human embryos are used but also the products of methods in which human embryos are used.

‚Object And Purpose' Of The Exclusion Under Rule 28(c)

In WARF it was concluded that the purpose of Rule 28(c) is "to protect human dignity and *prevent the commercialization of embryos*".

Re commercialisation of embryos, the EU Charter of Fundamental Rights, Article 3(2) states "In the fields of medicine and biology, the following must be respected in particular:… – the prohibition on making the human body and its parts as such a source of financial gain".

In relation to the intention of the legislator to prevent commercialisation of embryos, it is relevant to examine in detail the way in fact in which, for example, hESC lines are prepared. It can then be seen whether there has been any commercialisation of embryos in connection with these technologies.

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hESC Lines

With reference to the UK National Stem Cell Bank, European Human Embryonic Stem Cell Registry and the International Stem Cell Registry, one does not have to look far to see that hESC lines are derived from spare IVF embryos donated for research purposes.

Our first two examples are the MEL-1 and MEL-2 hESC lines which are derived from:

"donated frozen IVF embryos no longer required for infertility treatment".

Our next examples are the BJNhem19 and BJNhem20 hESC lines which are derived from:

"the inner cell mass (ICM) of grade III poor quality blastocysts that were not suitable for *in vitro* fertility treatment".

Lastly, we turn to the KCL002-WT4 hESC line which is derived from a:

"supernumerary IVF embryo".

The conclusions from the above are abundantly clear: in deriving and then using hESCs from these deposited hESC lines there is no commercialisation of embryos. Embryos used to derive the cell lines exemplified above have been donated and are described as "spare" or "supernumerary".

Interpretation Of The Biotechnology Directive

In interpreting the wording of the Biotechnology Directive, we should also acknowledge those things that the legislator did *not* intend to do. In particular, we believe it must be accepted that the intention of the legislator was not to render morally unacceptable practices that were at the time routine, public, publicly available and practiced throughout many and possibly even all of the states of the European Community.

We refer, by way of example, to methods of *in vitro* fertilisation (IVF), which by the mid 1990's were an accepted medical practice throughout Europe and throughout the developed world.

The first "test tube" baby was born in the UK on 25 July 1978. According to figures from the UK's Human Fertilisation and Embryology Authority ("HFEA"), in 1991 approximately 30,000 embryos were used in IVF methods in the UK alone. By 1997 the number of embryos used had risen to approximately 160,000 and by 2006 the number had risen to approximately 230,000.

The HFEA figures also indicate the number of embryos discarded and the number of embryos donated for research. To emphasise, these latter embryos are stated to be *donated*.

For convenience in understanding the relevant numbers, Fig. 1 below is a graphical representation of the number of embryos used, discarded and donated over a 15-year period from 1991 to 2006.

Note the significant increase in the number of embryos used (as IVF procedures become more common). Also note the significant increase in the number of embryos discarded – this clearly shows that 'spare' embryos from morally acceptable IVF methods are routinely *destroyed*.

If the spare embryos from morally acceptable IVF methods are routinely destroyed, how can subsequent medical use of those be rendered unacceptable by the Biotech Directive? How can research use for the good of human health be worse than destroying them?

Again, the intention of the legislator cannot have been to render IVF methods morally unacceptable – it is evident that IVF is indeed regarded as morally acceptable and part of this morally accepted procedure includes the routine destruction of embryos.

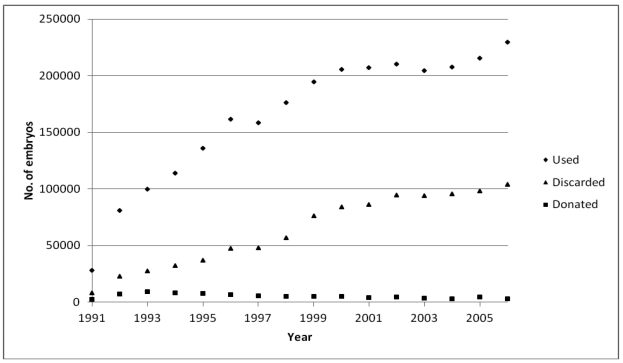

Fig 1: Embryos used, discarded and donated, 1991-2006, UK HFEA data

It can also not have been the intention of the legislator to render morally unacceptable contraceptive products and devices that destroy the embryo, for example, the "morning after pill" and intrauterine devices that prevent implantation. We acknowledge that some individuals and organizations find these products morally unacceptable, but the point is Europe as a whole does not.

The Correct Test

One phrasing of the modified WARF test (or part of the test) quoted from the CJEU Decision in *Brüstle v. Greenpeace e.V.* (C-34/10) is:

'an invention must be regarded as unpatentable, even if the claims of the patent do not concern the use of human embryos, where the implementation of the invention requires the destruction of human embryos or their use as base material whatever the stage at which that takes place'

Under this modified WARF test, the WARF patent is revoked. So too are patents directed at contraceptives and IVF (in which embryo destruction is inevitable, as not all IVF embryos are used). The test is wrong.

We must go back to the intention of the legislator and reformulate the test to examine instead whether the invention relates to commercialisation of embryos. Inventions based on hESC lines, derived from donated, "spare" or "supernumerary" (to use the language of the IVF practitioners) embryos pass that test and should be patentable. We trust the EPO, perhaps through its Technical Board of Appeal, will eventually instate the test the legislator intended. The sooner the better.

„Made Available to the Public" – Understanding the Differences of the America Invents Act from the European Patent Convention in its Definition of Prior Art.

D. Bjorkman (US)[1], G. Voortmans (BE)[2] and L. M. Block (US)[3],[4]

I. Introduction

With enactment of the America Invents Act (AIA),[5] U.S. patent law has undergone its biggest change since at least 1952. On March 16, 2013, the final phase of this change was completed by shifting from a "first to invent" to a "first inventor to file" system.[6] This change is hailed as a large step towards harmonization of U.S. patent law with those of other jurisdictions in the world.

One of the key terms in § 102 of the post-AIA U.S. patent statute is "or otherwise available to the public."[7] This phrase is deceptively familiar to the European practitioner, because it is reminiscent of the definition of the state of the art in Article 54 of the European Patent Convention (EPC), which comprises "everything *made available to the public*."[8]

While the words are very similar, practitioners both in the United States and elsewhere in the world should not be misled to believe that this similar language will lead to harmonized treatment of the definition of prior art. This article will explain what we believe to be the core philosophies that will result in a very different interpretation of the definition of available prior art.

We predict that the difference in interpretation of this phrase between the patent offices and courts of Europe and the United States will be profound. Essentially, Europeans tend to interpret this phrase to mean that the relevant public has knowledge of the invention itself through the teaching of the prior art. Under the European view, the focus is on whether the skilled artisan is able to *understand* the invention from the prior art disclosure.[9] In contrast, U.S. practitioners focus instead on whether the object of the invention is in the public domain, and therefore may be available for use as prior art.[10] The U.S. view focuses more on the ability to prove whether the disclosure itself can be obtained by the public. Additionally, under the U.S. system, the skilled artisan is endowed with an expansive ability to repair or adapt a limited prior art disclosure for use as an effective reference against a claim.

We will explain the interpretation of the meaning of "available to the public" by discussing case law of the Boards of Appeal of the European Patent Office (EPO).[11] Additionally, we will contrast the views of the EPO with a discussion of case law of U.S. courts regarding the interpretation of relevant terms of 35 U.S.C. § 102 under the previous U.S. patent laws (the 1952 Patent Act) that are also present in the new 35 U.S.C. § 102 under the AIA.[12] From this analysis, we will paint a possible pathway of how the new term "otherwise available to the public" might be construed in future decisions of the U.S. Patent Office and courts in the United States.

II. The Statutes

Relevant portions of the EPC and U.S. patent law that are addressed by the AIA and are of interest for the purpose of this article are reproduced in the table below.

EPC Art. 54[13]	35 U.S.C. § 102(a)[14]
(1) An invention shall be considered to be new if it does not form part of the state of the art. (2) The state of the art shall be held to comprise everything *made available to the public* by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.	NOVELTY; PRIOR ART. – A person shall be entitled to a patent unless – (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or *otherwise available to the public* before the effective filing date of the claimed invention.

As can be seen from a comparison of the relevant statutes, both contain the words "available to the public."

The European novelty requirement begins with the concept that an invention is new if it is not a part of the

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5 Leahy-Smith Amercia Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).
6 *Id.* § 3 (stating that the first inventor to file amendments would take effect eighteen months (Mar. 16, 2013) after the date of enactment of the Act (Sept. 16, 2011)).
7 35 U.S.C.A. § 102(a)(1) (West 2012) („(a) Novelty; prior art–A person shall be entitled to a patent unless– (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.").
8 European Patent Convention art. 54(2), Oct. 5, 1973, 1065 U.N.T.S. 199 (as amended Nov. 29, 2000) [hereinafter EPC] (emphasis added), *available at* http://www.epo.org/law-practice/legal-texts/html/epc/2010/e/ar54.html („The state of the art shall be held to comprise everything *made available to the public* by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.").
9 *See infra* notes 43–45 and accompanying text.
10 *See infra* notes 52–53 and accompanying text.
11 *See infra* Part III.
12 *See infra* Part IV.
13 EPC, *supra* note 4, art. 54(1), (2) (emphasis added).
14 35 U.S.C.A. § 102(a)(1) (West 2012) (emphasis added).

state of the art.[15] Paragraph (2) of Article 54 then defines what constitutes prior art – anything that has been made available to the public.[16] Accordingly, the novelty assessment at the EPO starts by a determination of what the prior art is and identification of the relevant portion of the disclosure. In a second step, a comparison is made between the content of that art and the invention as claimed. The EPO Boards of Appeal case law that will be reviewed in some detail below has construed the prior art as being anything made available to the public as a technical teaching (e.g., a collection of technical features).[17] This interpretation derives from a policy or concept of rewarding new technical teachings to the world so as to thereby enhance and further technology. The purpose of EPC Article 54(1) is thus to prevent that which is already a part of the state of the art from being patented.[18]

New 35 U.S.C. § 102 under the AIA, although being labeled "novelty and prior art" does not define prior art *per se*, but rather begins with the concept that a person shall be entitled to a patent unless the invention was disclosed under one or more of recited categories of prior art.[19] The categories of "patented, described in a printed publication, or in public use, on sale" were present in the 1952 Patent Act.[20] However, a large and fairly ambiguous phrase was added to the statute. "[O]therwise available to the public" was added in the United States as a clause that modified at least the two previous novelty bars[21]: public use or on sale. Congressional records do not define this term except to say that the act as a whole is meant to harmonize the United States with the rest of the world.[22]

Comments made in the legislative history indicate that the terminology "patented, described in a printed publication, or in public use, on sale" were apparently chosen for use in the AIA because they were present in the 1952 Act, and so can be understood in the context of case law. However, at least one comment managed to jumble the alternative interpretations of the statute in a single statement, asserting both that the AIA does away with private offers for sale while at the same time asserting that the public accessibility standard has not changed.[23]

The impact of the words "otherwise available to the public" was discussed in the congressional record as follows:

> *The words "otherwise available to the public" were added to section 102(a)(1) during that Congress's Judiciary Committee mark up of the bill. The word "otherwise" makes clear that the preceding clauses describe things that are of the same quality or nature as the final clause—that is, although different categories of prior art are listed, all of them are limited to that which makes the invention "available to the public." As the committee report notes at page 9, "the phrase 'available to the public' is added to clarify the broad scope of relevant prior art, as well as to emphasize the fact that it [i. e., the relevant prior art] must be publicly available." In other words, as the report notes, "[p]rior art will be measured from the filing date of the application and will include all art that publicly exists prior to the filing date, other than disclosures by the inventor within one year of filing."*[24]

By this interpretation, "or otherwise available to the public" should modify the four listed categories of prior art: patented, described in a printed publication, in public use, and on sale. Such an interpretation would suggest that "or otherwise available to the public" does not add a fifth category of prior art to be cited against a patent claim.

Meanwhile, multiple commentators and even the U.S. Patent Office muddy the application of this phrase by at times referring to it as a "catch all" phrase that simply collects any prior art that might not fit in the listed categories of prior art that are set forth in the statute.[25] The Final Guidelines from the U.S. Patent Office go farther, stating:

> *AIA 35 U.S.C. 102(a)(1) provides a "catch-all" provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. Specifically, a claimed invention may not*

15 EPC, *supra* note 4, art. 54(1).

16 *Id.* art. 54(2).

17 *See infra* Part III.

18 Bayer, [1982] T 0012/81 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t810012ep1.html; Hoechst, [1985] T 0198/84 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t840198ep1.html (citing *Bayer*).

19 35 U.S.C.A. § 102 (West 2012).

20 *Compare* 35 U.S.C.A. § 102(a)(1) (West 2012), *with* 35 U.S.C. § 102 (2006) („A person shall be entitled to a patent unless– … (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States …").

21 As will be discussed in detail below, the uniformity of application of the expression „otherwise available to the public" to interpretation of prior art novelty bars is in question.

22 157 Cong. Rec. E1219 (daily ed. June 28, 2011) (extension of remarks of Rep. Smith), *available at* http://www.gpo.gov/fdsys/pkg/CREC-2011-06-28/pdf/CREC-2011-06-28-pt1-PgE1219-2.pdf.

23 Senator Leahy stated: One of the implications of the point we are making is that **subsection 102(a) was drafted in part** *to do away with precedent under current law that private offers for sale or private uses or secret processes practiced in the United States that result in a product or service that is then made public may be deemed patent-defeating prior art.* That will no longer be the case. In effect, the new paragraph 102(a)(1) imposes an overarching requirement for availability to the public, that is a public disclosure, which will limit paragraph 102(a)(1) prior art to subject matter *meeting the public accessibility standard that is well-settled in current law*, especially case law of the Federal Circuit.
157 Cong. Rec. S1496, at S1496 (daily ed. Mar. 9, 2011) (emphasis added) (statement of Rep. Leahy), *available at* http://www.gpo.gov/fdsys/pkg/CREC-2011-03-09/pdf/CREC-2011-03-09-pt1-PgS1496.pdf.

24 157 Cong. Rec. S1360, at S1370 (daily ed. Mar. 8, 2011) (alteration in original) (quoting S. Rep. 110-259, at 9 (2008)), *available at* http://www.gpo.gov/fdsys/pkg/CREC-2011-03-08/pdf/CREC-2011-03-08-pt1-PgS1360-2.pdf.

25 *American Invents Act Public Forum*, U.S. Patent & Trademark Office (Mar. 15, 2013), http://www.uspto.gov/aia_implementation/FITF_Public_Training_2013mar12.pptx (slide 26); *see e.g.*, *Otherwise Available to the Public*, Power Patent (Mar. 18, 2013), http://www.powerpatent.com/blog/725-otherwise-available-to-the-public; *First Inventor to File Patent Takes Effect on March 16, 2013*, Blakely Sokoloff Taylor & Zafman LLP (Mar. 13, 2013), http://www.bstz.com/sites/default/files/news/AIA2_March_16_2012.pdf; Jeffery Duncan, *Why Life Sciences Needs to Reassess Their U.S. Patent Strategies*, Life Science Leader, *http://www.lifescienceleader.com/magazine/past-issues3/item/4244-why-life-sciences-needs-to-reassess-their-us-patent-strategies?list=n* (last visited May 16, 2013); James Morando et al., *The America Invents Act: Key Provisions Affecting Inventors, Patent Owners, Accussed Infringers and Attorneys*, http://apps.americanbar.org/litigation/committees/intellectual/roundtables/1111_outline.pdf (last visited May 16, 2013).

be patented if it was "otherwise available to the public" before its effective filing date. This "catch-all" provision permits decision makers to focus on whether the disclosure was "available to the public," rather than on the means by which the claimed invention became available to the public or on whether a disclosure constitutes a "printed publication" or falls within another category of prior art as defined in AIA 35 U.S.C. 102(a)(1).[26]

Given this interpretation, the practitioner (and especially the European practitioner) must consider *how* this phrase "or otherwise available to the public" will be deemed to modify the previous understanding of the definition of prior art.

III. Meaning of „Available to the Public"

While this phrase is new to U.S. practitioners, the case law of the Boards of Appeal of the EPO have construed the meaning of "available to the public" in the context of making a technical teaching available to the public. These decisions make it clear that, under the EPC, three conditions are important in determining if a disclosure is available to the public:

1. the relevant disclosure must be available to at least one member of the public,
2. the disclosure has to actually teach the information to be used in evaluation of patentability, and
3. the technical teaching of the prior art must be enabled.[27]

We will examine each of these conditions in light of case law and legislative history to show how the identification of prior art under the EPC and the AIA will be significantly different, despite the apparently common language.

A. The Relevant Disclosure Must Be Available to at Least One Member of the Public

1. Access

There is likely to be agreement between the U.S. and European jurisdictions over many aspects of the first prong of the above analysis. For example, remarkably similar rules have developed under both the EPC and the U.S. 1952 Patent Act regarding the timing of when the disclosure is actually available. Basically, the question about when a journal article, paper, public presentation, and so forth can be obtained by the public is subject to the same logical analysis.[28]

2. Confidentiality

Similarly, U.S. and European jurisdictions both treat agreements to keep information confidential as effective vehicles to preserve the ability to later file for patent rights. Thus, in Europe, prior use is prior art only if and when the circumstances of the prior use are such that the subject matter is available to at least one member of the public in an unrestricted way.[29] Information transferred under conditions of secrecy or similar restrictions, express or implied, typically prevent the disclosure from being considered to be available to the public.[30]

An obligation of secrecy does not need to be in writing and can be a tacit agreement deriving from the particular circumstances. For example, in T 0472/92, the Board accepted that in the case of a joint venture agreement an understanding of confidentiality would normally exist between the parties, either expressly or by implication.[31] In another case related to uranium enrichment technology, the Board found that the very nature of this technology and project meant that everyone involved were bound by secrecy.[32] Likewise, in T 1076/93 the Board found that a weapon manufacturer was normally expected to behave as if an agreement of confidentiality had been specified, presumably because of the nature of that industry.[33]

Notably, if unrestricted access to a process is provided to the public, that process will be considered to be made available to the public even if it cannot be shown that a visitor actually did receive the relevant information. For example, as described in EPO Board decision T 0947/99, an ice cream making process had become available to the public when the process was shown to visitors at the

26 Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 78 Fed. Reg. 11,059, 11,075 (Feb. 14, 2013) [hereinafter AIA Guidelines], *available at* http://www.gpo.gov/fdsys/pkg/FR-2013-02-14/pdf/2013-03450.pdf (to be codified at 37 C.F.R. pt. 1).

27 *European Patent Office*, *Case Law of the Boards of Appeal* 69–85 (Legal Research Serv. for the Boards of Appeal ed., 6th ed. 2010) [hereinafter *Case Law of the Boards of Appeal]*, *available at* http://documents.epo.org/projects/babylon/eponet.nsf/0/1ae7315e321e933ec12577bd0024d650/$FILE/Case_law_of_the_boards_of_appeal_2010_en.pdf.

28 For example, while for typical printed media such as newspapers, journals and, in particular, patent publications, the date of their public availability can be easily determined from the mentioned publication date, for other printed matter this may not always be as trivial. This is the case for printed publications issued by companies such as technical brochures and sales literature. *Id.* at 72–73. Often such publications do not bear a clear publication date, or even if they do, it may not be the actual date at which the publication became accessible to the public. *See,* e.g., Beloit Tech., Inc. v. Voest-Alpine Industrieanlagenbau Gesellschaft m.b.H., [2000] T 0037/96 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t960037eu1.html. Also, public availability of printed matter may be determined by the date at which the particular publication is retrievable by a member of the public. Accordingly, in T 0314/99, the Board of Appeal decided that the availability of a thesis was not the date on which it arrived in the university library but rather the date on which that thesis was catalogued and thus found when a search was done. *See* ExxonMobil Research & Eng'g Co. v. Targor GmbH, [2001] T 0314/99 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t990314eu1.html. Absent the cataloging, the public had no means to become aware of the thesis and hence it was not publicly available up to that time. *See, e.g.*, *In re* Hall, 781 F.2d 897, 899–900 228 U.S.P.Q. (BNA) 453 (Fed. Cir. 1986) (stating that a single copy of a thesis cateloged in the university's library constitutes sufficient accessibility); Protein Found., Inc., v. Brenner, 260 F. Supp. 519, 520–21, 151 U.S.P.Q. (BNA) 561 (D.D.C. 1966) (determining that a magazine's effective prior art date is the date the publication reaches the addressee).

29 Union Carbide Corp. v. Linde AG, [1991] T 0245/88 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t880245eu1.html.

30 *Id.* (stating that that several vaporizers that had been installed in a fenced-off area of a shipyard had not been made available to the public as the public did not have unrestricted access to the relevant area).

31 Sekisui Kaseihin Kogyo Kabushiki Kaisha v. Owens-Illinois, Inc., [1996] T 0472/92 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t920472ex1.html.

32 Hareus Quarzglas GmbH & Co. KG v. Nikon Corp., [2000] T 0633/97 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t970633eu1.html.

33 Marposs Societa' per Azioni v. FAG Kugelfischer George Schäfer & Co., [1995] T 1076/93 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t931076eu1.html.

manufacturing plant.[34] Three declarations were submitted by the opponent allegedly showing that the visitors had access to the relevant process details thus destroying the novelty of the claimed invention.[35] Each of the three declarations additionally stated that there was no explicit or tacit agreement of confidentiality.[36] The Board reasoned that although they would likely not have seen each and every detail of the process the visitors could have asked about such details and would have been given the relevant information.[37] Arriving at its decision the Board observed:

> *It appears to be well established in the case law of the boards of appeal that for a claimed invention to have been "made available to the public" within the meaning of Article 54(2) EPC before the relevant filing date, information equivalent to the claimed invention must have been accessible to a skilled person. As stated by the Enlarged Board in decisions G 2/88 and G 6/88 (OJ EPO 1990, 93 and 114), "the word 'available' carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public, or laid open for inspection*."[38]

Similarly, in T 0084/83 a new type of mirror had been fitted to cars for demonstration purposes during a period of several months prior to the effective date of the patent.[39] The Board held that this constituted a prior public use because the mirrors could have been inspected by a member of the public (e.g., when they were parked at public locations).[40] Whether or not a member of the public actually did inspect the mirror was irrelevant; the mere possibility of someone inspecting the mirror was sufficient to satisfy the criterion of "public availability."[41]

The U.S. concept of a novelty destroying disclosure is very similar in both the protection afforded by confidentiality and whether anyone has to in fact receive the information. In the United States, once an invention is in the public domain, it is no longer patentable by anyone.[42] A reference has been made publically available if such document has been "disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it."[43]

As a long-standing principle of U.S. patent law, once an inventor gives or sells his or her device to another to be used without limitation or restriction, or injunction of secrecy, such use is public.[44] This is the case even if the use and knowledge of the use is confined to one person.[45] Additionally, once accessibility of a reference is shown, it is not necessary to show that anyone actually inspected or understood the reference.[46]

3. When the Audience is Not Skilled in the Art

Whether or not the audience must be sufficiently skilled in the art is not in agreement between both jurisdictions. In Europe, an oral presentation, accompanied by slides, only makes an invention available to the public if a member of the public would have understood the subject matter.[47] In T 1212/97, a presentation was given, accompanied by slides, but no handouts were provided.[48] The Board concluded that since there was not significant proof regarding the exact content of the lecture or that anyone in the audience could have deduced the invention from the presentation given the nature of a live lecture being such that degree of comprehension of the information that is supposedly disclosed (i. e., the actual communication of information) depends on the manner or speed of the presentation as much as what is actually said.[49] In view of this lack of proof, the Board decided that the there was insufficient evidence that the information content of the lecture was publicly available.[50]

While it is difficult to predict, it seems likely that a U.S. adjudicator would focus more on the information content of the slides that were in evidence and less on whether the invention was understood by the audience.

Similarly, in T 0877/90 the Board determined that since an oral disclosure took place before a circle of persons, all of who were unable to understand its technical teachings, the oral disclosure was not considered a public disclosure.[51] "[T]he word 'public' in Article 54(2) EPC has the same meaning as the words 'skilled person' in Article 83 EPC, but whereas in the case of Article 54(2) EPC the making available to the public of a disclosure is seen form the stand-point of passive reception . . . ."[52] The decision was affirmed later when the Board of Appeal determined that a disclosure is made available to the public when the audience is able to understand and potentially able to further distribute the information to others—when there is no bar of confidentiality.[53] Again, in T

34 Unilever PLC, v. Nestec S.A., [2003] T 0947/99 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t990947eu1.html.
35 *Id.*
36 *Id.*
37 *Id.*
38 *Id.* (emphasis added).
39 Luchtenberg GmbH, [1983] T 0084/83 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t830084du1.html; *Case Law of the Boards of Appeal, supra* note 23, at 74.
40 *Case Law of the Boards of Appeal, supra* note 23, at 74.
41 *See id.*
42 *See* SRI Int'l, Inc. v. Internet Sec. Sys., Inc., 511 F.3d 1186, 1194, 85 U.S.P.Q.2d (BNA) 1489 (Fed. Cir. 2008) (quoting Application of Bayer, 568 F.2d 1357, 1361, 196 U.S.P.Q. (BNA) 670 (C.C.P.A. 1978)).
43 Brukelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 1378, 78 U.S.P.Q.2d (BNA) 1684 (Fed. Cir. 2006) (quoting I.C.E. Corp. v. Armco Steel Corp., 250 F. Supp. 738, 743, 148 U.S.P.Q. (BNA) 537 (S.D.N.Y. 1966)).
44 35 U.S.C.A. § 102(b) (West 2012).
45 Egbert v. Lippmann, 104 U.S. 333, 336 (1881).
46 *See In re* Lister, 583 F.3d 1307, 1314, 92 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2009).
47 Genentech, Inc., v. Bristol-Myers Co., [2001] T 1212/97 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t971212eu1.html.
48 *Id.*
49 *Id.*
50 *Id.* The court required certainity beyond a reasonable doubt that the particular information was made available to the public. *Id.*
51 Hooper Trading Co. N.V. v. Biotest Pharma GmbH, [1992] T 0877/90 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/pdf/t900877eu1.pdf. The court required certainity beyond a reasonable doubt that the particular information was made available to the public. *Id.*
52 *Id.*
53 Research Found. of State Univ. of N.Y. v. Calgene Inc., [2000] T 0838/97 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t970838eu1.html.

1212/97 there was no public disclosure because "[n]o instructions were provided to enable the skilled person to carry out the claimed [invention]."[54] The Board further articulated that "the subject-matter of the claim must be clearly and unambiguously disclosed in the prior publication, and also in a manner which enabled the skilled person to carry it out."[55]

Under U.S. case law, the main factor is not whether the audience is skilled in the art. "It is not public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it."[56] Older precedent and U.S. Patent Office Board decisions go further to indicate that the person receiving the information does not need to understand the significance of the invention, or even to see the invention that is hidden from view as part of the larger machine.[57] Thus, a public use that is not understood by the receiving public was still considered to be a bar under the 1952 Patent Act.

B. The Disclosure Has to Actually Teach the Information To Be Used in Evaluation of Patentability

In the United States, the prior art category of "on sale" historically did not require that the sale be a "teaching" sale.[58] Likewise, the concept of forfeiture, which was established by case law and did not appear in the 1952 Patent Act, did not require an enabling teaching.[59] These categories of prior art are not "teaching" prior art in the sense of necessarily disclosing the *technical features* of the invention.

The EPC again stands in contrast to the U.S. approach. In a key opinion, "Availability to the Public," the EPO Enlarged Board of Appeal applied the concept of prior use of a product and found that any information that could be derived from the publicly available product without undue burden belonged to the state of the art.[60] Whether or not there was a particular reason to analyze the product for the presence of a particular feature was irrelevant.[61]

In the "Availability to the Public" opinion, the Enlarged Board of Appeal observed that an essential purpose of any technical teaching is to "enable the person skilled in the art to manufacture or use a given product by applying such teaching."[62]

> *Where such teaching results from a product put on the market, the person skilled in the art will have to rely on his general technical knowledge to gather all information enabling him to prepare the said product. Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure [have been made available to the public and thus] become the state of the art.*[63]

However, the EPO Board also noted that "a commercially available product *per se* does not . . . disclose anything beyond its composition or internal structure."[64] Extrinsic characteristics, properties, or capabilities that are only revealed when the product is exposed to specifically chosen conditions, other than those of the prior art, are not considered to be disclosed by commercially available products.[65] One of the cases referred to by the Board in its opinion was G2/88, relating to the use of a known compound for a particular purpose based on a new technical effect.[66] Such characteristics cannot be considered as already having been made available to the public, even if those characteristics are inherent.[67] The concept of inherency is alien to the EPC, as will be discussed later in this article.[68]

C. The Technical Teaching of the Prior Art Must Be Enabled

1. Enablement Under the EPC

Boards of Appeal of the EPO have consistently interpreted Article 54(2) to include only reproducible technical teachings as prior art. For example, if a document discloses a chemical compound by its structure, the particular compound will only belong to the prior art if the document contains a teaching on how to make the compound. One of the early decisions of the Boards of Appeal illustrates this. In T 0206/83, the structure of a chemical compound was disclosed, as was its method of making.[69] However, the document failed to disclose how one skilled in the art could obtain the starting materials using only his common general knowledge.[70] It is perhaps noteworthy to point out here that patent documents can be used under the EPC to establish or prove the state of common general knowledge of one skilled in the art only in special or exceptional circumstances.[71]

54 *Genentech*, [2001] T 1212/97 [E.P.O.].
55 *Id.*
56 TP Labs., Inc. v. Prof'l Positioners, Inc., 724 F.2d 965, 970, 220 U.S.P.Q. (BNA) 577 (Fed. Cir. 1984) (quoting City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126, 136 (1877)) (referring to the fact that at the time *Elizabeth* was decided the previous law required that if an invention was not kept secret one could not obtain a patent).
57 *U.S. Patent & Trademark Office, U.S. Dep't of Commerce*, *Manual of Patent Examining Procedure* § 2133.03(a) (8th ed. rev. 8, Aug. 2012) [hereinafter MPEP] (citing Application of Blaisdell, 242 F.2d 779, 783, 113 U.S.P.Q. (BNA) 289 (C.C.P.A. 1957); Hall v. Macneale, 107 U.S. 90, 96–97 (1883); *Ex parte* Kuklo, No. 92-2698, 25 U.S.P.Q.2d (BNA) 1387, 1390 (B.P.A.I. Aug. 31, 1992)), *available at* http://www.uspto.gov/web/offices/pac/mpep/s2133.html.
58 The only two requirements of the on sale bar are that the invention was offered for sale and it was ready for patenting. Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998).
59 Mason v. Hepburn, 13 App. D.C. 86, 95 (1898). *Mason* is cited by over 200 subsequent cases.
60 Availability to the Public, [1992] G 1/92 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/pdf/g920001ex1.pdf.
61 *Id.*
62 *Id.*
63 *Id.*
64 *Id.*
65 *Id.*
66 Mobil Oil Corp. v. Chevron Research Co., [1989] G 2/88 [E.P.O.], *available at* http://archive.epo.org/epo/pubs/oj1990/p093_185.pdf.
67 *Id.*
68 *See infra* Part IV.D.3.
69 ICI, [1986] T 0206/83 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t830206ep1.html.
70 *Id.*
71 Bayer CropScience S.A., [2004] T 0890/02 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t020890ep1.html.

How a teaching in a document is read and understood by one skilled in the art may significantly change over time. Several decisions of the EPO Boards of Appeal have held that the relevant point in time to interpret the teaching of a piece of prior art for purposes of determining whether a reference enables the skilled artisan to reproduce the invention is the publication date.[72] Thus, if a particular disclosure is found to be non-enabled when read and understood at the time of its publication based on the knowledge of a skilled artisan, it cannot be used for the purpose of defeating the novelty of the claimed subject matter.

The American practitioner may start to wonder at this point, how and why this all matters: if knowledge has become available later, then the particular non-enabling disclosure would render the claimed matter obvious. This, however, ignores the sometimes-surprising effects of the problem-solution approach that is a well-established method of assessing inventive step at the EPO.[73] Under the problem-solution approach, one first identifies the closest prior art and determines the differences between the invention and the closest art.[74] Then, one determines the technical effect brought about by the difference between the invention and the closest art, which defines the *objective* technical problem to be solved.[75] Finally, one examines whether the claimed solution to the objective problem is obvious to the skilled person in view of the state of the art in general.[76] The U.S. practitioner has trouble understanding the construction of the objective problem when using the problem-solution analysis. This is because the objective problem is not the inventor's subjective goal, but rather is a problem that is both defined by the differences between the claims and the prior art *and* that also is derivable from the prior art.[77] In fact, during European prosecution, the objective problem may change if it is decided that a different reference is more relevant, and therefore becomes the closest prior art for the problem-solution analysis.[78]

As can be taken from the above outline of the problem-solution approach, the selection of the closest prior art is an important and critical step. It is well-established case law of the Boards of Appeal of the EPO that the closest prior art is not necessarily that art which has the most technical features in common with the claimed invention but rather that art which relates to a similar purpose or objective. Typically, a defective publication used in an inventive step rejection will have all the technical features in common but is for a particular reason not enabling. However, when such a publication relates to a different purpose or objective, it would likely not qualify as a starting point for the purpose of the problem-solution approach. Formulation of the problem as one of finding a way to cure the defect of the publication would then be regarded as an *ex-post facto* analysis and not an objectively formulated problem. Likely, the purpose and objective to which the claimed invention relates would provide technical effects that are not addressed or foreshadowed in a closest prior art that in addition to being defective also relates to a different purpose and objective. In other words, formulating the problem relative to such a reference, as the closest prior art, in effect amounts to disregarding one or more technical effects and thus to a technical problem that is incomplete.

Under the problem-solution approach, an inventive step rejection that identifies a defective (i. e., non-enabling) publication as the closest prior art must include cure of the defect as part of its objective technical problem. If upon cure of this objective technical problem there is still a non-trivial difference (technical effect) between the closest prior art and the claim, it is very difficult to sustain a rejection based on lack of inventive step. In principle, it is not appropriate to formulate a technical problem on only one of the technical effects achieved and ignore any of the other technical effects that have been achieved by the claimed invention, even if those effects might be seen as inherent once the defect of the publication has been cured. This makes it more likely that the "defective publication" will not be the appropriate starting point for analyzing the patentability of a claim because it may be a disclosure that is not concerned with the purpose or objective of the patent at issue.

Complications caused by selection of a non-enabling reference as the closest prior art can be illustrated by the Board's decision in T 0835/95, relating to glass microspheres.[79] The opponent in that case attacked the novelty on the basis of a document that at the time of its publication did not enable the making of glass microspheres having the claimed composition.[80] When the opponent subsequently attempted to start from this document as the closest prior art, the Board stated that the document could not be considered as the closest prior art because it related to a very different purpose (i. e., laser-induced thermonuclear fusion), whereas the microspheres of the patent in suit where intended for use as light-weight fillers.[81] In essence, the opponent played their "solution card" on curing the defective publication, and could not bridge the gap between the reference and the patent claims with regard to the additional technical effects achieved in the context of microspheres as light-weight fillers.[82]

72 *Case Law of the Boards of Appeal, supra* note 23, at 64 (citing Lenzing Aktiengesellschaft v. Akzo Faser AG, [1996] T 0590/94 [E.P.O.]; Daiichi Seiyaku Co. v. Henkel Kommanditgesellschaft auf Aktien, [1995] T 0965/92 [E.P.O.]; Fraunhofer-Gesellschaft v. G. Siempelkamp GmbH & Co., [1992] T 0205/91 [E.P.O.]).

73 *European Patent Office, Guidelines for Examination in the European Patent Office*, pt. c, ch. IV, § 11.5 (Apr. 2010) [hereinafter *EPO Examination Guidelines*], *available at* http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/$FILE/guidelines_2010_complete_en.pdf.

74 *Id.* § 11.5.1.

75 *Id.* § 11.5.2.

76 *Id.*; *see also* G. Knesch, *Assessing Inventive Step in Examination and Opposition Proceedings in the EPO*, 3 *Eur. Pat. Convention, EPI Info.* 95, 95–101 (1994), *available at* http://216.92.57.242/downloads/Articles/Knesch-article.pdf.

77 *See* Knesch, *supra* note 72, at 96.

78 *See id.*

79 Minn. Mining & Mfg. v. Asahi Glass Co., [1999] T 0835/95 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t950835eu1.html.

80 *Id.*

81 *Id.*

82 *See id.*

2. Enablement Under U.S. Law

In contrast, U.S. patent law allows secondary evidence to demonstrate public possession. A § 102 rejection may stand even if the reference itself does not teach one of ordinary skill in the art how to make or use the article because secondary evidence may be used to close this gap and provide the enabling teaching.[83]

When the claimed composition or machine is disclosed identically by the reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure."[84] For example, two compound claims were rejected under § 102(b) over a publication in view of two patents.[85] "The publication disclosed the claimed compound structure [in a non-enabling manner] while the [cited] patents taught methods of making compounds of the general class."[86] The court held that the publication taught all the elements of the claim and there was no need to provide a specific motivation to combine the publication with the patents to establish enablement of the publication.[87]

The U.S. courts go even further and state that a reference is still prior art for all it teaches, even if it discloses an inoperative device.[88] For the purposes of determining obviousness, a non-enabling reference may therefore qualify as prior art.[89]

IV. Specific Categories of Prior Art

The answer to the question of whether a disclosure is "available to the public" begins to get very complicated when considering the categories of prior art, including the so called "secret" prior art of "on sale," "forfeiture," and also the special case of certain "public use" disclosures.

A. „On sale"

The U.S. 1952 Patent Act states that a sale of a product is a bar to patentability, and U.S. courts confirm this bar, whether the sale was confidential or non-confidential. Well-established case law supports the view that once a product is offered for sale the on sale bar begins. "Any attempt to use it for a profit, and not by way of experiment … would deprive the inventor of his right to a patent."[90] There are two conditions that must be met before the on sale bar applies.[91] First, the product itself must be the subject of a commercial *offer* to sell, and, second, the invention must be ready for patenting.[92] A product is subject to a commercial offer for sale when the patent owner attempts to "exploit his discovery competitively."[93] A commercial offer for sale includes both confidential and non-confidential sales.[94] Additionally, the sale does not even need to be complete. A mere *offer* for sale is sufficient.[95] In fact, there is no requirement that the invention actually be in the hands of the customer and therefore available for reverse engineering.[96]

Under the AIA, the legislative history indicates that it is the intent of the statute to remove confidential sales as a basis of rejecting patent applications.[97] Therefore, the phrase "otherwise available to the public" is considered to modify the understanding of the term "on sale."[98] Senator Kyl, one of the bill's sponsors, further asserted that the sentence structure of the statute by its use of commas between the modifying clause "or otherwise available to the public"[99] and antecedent clauses establishes that the modifier applies to all of the antecedents.[100] The legislative history thus attempts to establish that a public availability standard is imposed on all of the categories of prior art enumerated by the bill. The U.S. Patent Office agrees stating that "[t]he 'or otherwise available to the public' residual clause . . . indicates that AIA 35 U.S.C. 102(a)(1) does not cover secret sales or offers for sale."[101]

83 *In Re* Donohue, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985) („Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his won knowledge to make the claimed invention."); MPEP, *supra* note 53, § 2121.01.

84 Application of Samour, 571 F.2d 559, 563, 197 U.S.P.Q. (BNA) 1 (C.C.P.A. 1978) („Additional references cited in a rejection under 35 U.S.C. § 102(b) are not relied on for a suggestion or incentive to combine teachings to meet claim limitations (as in a rejection under 35 U.S.C. § 103), but, rather, to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public."); *In re* Donohue, 766 F.2d 531, 533–34 (Fed. Cir. 1985); MPEP, *supra* note 53, § 2131.01(I) (citing Application of Samour, 571 F.2d 559; *In re* Donohue, 766 F.2d. 531).

85 MPEP, *supra* note 53, § 2131.01.

86 *Id.*

87 *Id.*

88 Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551, 13 U.S.P.Q.2d (BNA) 1301 (Fed. Cir. 1989).

89 Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1578, 19 U.S.P.Q.2d (BNA) 1241 (Fed. Cir. 1991); MPEP *supra* note 53, § 2121.01(II).

90 City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126, 137 (1877).

91 Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998).

92 *Id.* at 66.

93 A product is subject to a commercial offer for sale when the patent owner attempts to „exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly." *Id.* at 68 (quoting Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 520, 68 U.S.P.Q. (BNA) 54 (2d Cir. 1946)).

94 Special Devices, Inc. v. OEA, Inc., 270 F.3d 1353, 1357, 60 U.S.P.Q.2d (BNA) 1537 (Fed. Cir. 2001) („We see no reason why sales for the purpose of the commercial stockpiling of an invention, even if they took place in secret, should merit different treatment.").

95 Seal-Flex, Inc. v. Athletic Track & Court Constr., 98 F.3d 1318, 1324 (Fed. Cir. 1996) („The general rule is that the on-sale bar starts to accrue when a completed invention is offered for sale." (citing Baker Oil Tools, Inc. v. Geo Vann, Inc., 828 F.2d 1558, 1563, 4 U.S.P.Q.2d (BNA) 1210 (Fed. Cir. 1987)).

96 J.A. LaPorte, Inc. v. Norfolk Dredging Co., 787 F.2d 1577, 1582, 229 U.S.P.Q. (BNA) 435 (Fed. Cir. 1986) („To hold otherwise would mean adding a requirement that goods be ‚on hand' and transferred at the time of the sale to invoke the bar, a requirement specifically rejected by this court." (citing Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd., 731 F.2d 831, 836, 221 U.S.P.Q. (BNA) 561 (Fed. Cir. 1984)).

97 157 *Cong. Rec.* S5319, at S5320 (daily ed. Sept. 6, 2011) (statement of Sen. Kyl), *available at* http://www.gpo.gov/fdsys/pkg/CREC-2011-09-06/pdf/CREC-2011-09-06-pt1-PgS5319-3.pdf („Public uses and sales of an invention will remain prior art, but only if they make the invention available to the public. An inventor's confidential sale of his invention, his demonstration of its use to a private group, or a third party's unrestricted but private use of the invention will no longer constitute private art. Only the sale or offer for sale of the invention to the relevant public or its use in a way that makes it publicly accessible will constitute prior art.").

98 *See* 35 U.S.C.A. § 102(a) (West 2012).

99 *Id.*

100 157 *Cong. Rec.* S1360, at S1370 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl), *available at* http://www.gpo.gov/fdsys/pkg/CREC-2011-03-08/pdf/CREC-2011-03-08-pt1-PgS1360-2.pdf („The word ‚otherwise' makes clear that the preceding clauses describe things that are of the same quality or nature as the final clause–that is, although different categories of prior art are listed, all of them are limited to that which makes the invention ‚available to the public.'").

Senator Kyl went on to assert that the understanding of whether an invention has been made "available to the public" is the same as had been previously carried out in determining whether a reference was publicly accessible.[102]

B. Forfeiture

1. Background of Forfeiture in the United States

The concept of forfeiture is that an invention that is used to commercial advantage more than a year before patent filing is barred from patenting by the party that used the invention.[103] This is a judicially created concept derived from the principle of preventing inappropriate extension of a monopoly beyond the statutory term of a patent.[104] This is different from the "on sale" bar set forth in 102(b), because the sale of a product produced by a secret process that is not capable of being reverse engineered is a bar only against the party that took commercial advantage of the process, and is not a bar against a third party.[105]

2. Forfeiture Under the AIA

Confusingly, the legislative history instead uses an improper broader definition of forfeiture, stating that "[t]he present bill's elimination of the patent forfeiture doctrines in favor of a general public availability standard also limits and reconciles the various purposes that previously have been ascribed to section 102's definition of prior art."[106]

Thus, when reading the legislative history, comments with respect to forfeiture must be read with the understanding that they relate at least to any manner that a potential patentee could lose patent rights by their own actions.

For purposes of this section, we will use the strict definition of forfeiture as a judicially created concept derived from the principle of preventing inappropriate extension of a monopoly beyond the statutory term of a patent.[107] It should be noted that the question of whether the AIA eliminates strictly defined "forfeiture" from the U.S. patent landscape is not without some controversy. Law Professor and blogger Dennis Crouch of *Patently-O* has noted that the only basis in the statute for this interpretation is the residual phrase "otherwise available to the public."[108] As discussed by Mr. Crouch and sources cited in his blog, this phrase may not be sufficiently explicit language to overrule a United States Supreme Court decision.[109] Eliminating the concept of forfeiture would necessarily entail overturning the long-standing precedent set by Judge Learned Hand in *Metallizing Engineering*, when Judge Hand stated that "it is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or [a patent]."[110] However, all major patent law associations, including the AIPLA, the ABA, and the IPO have taken the position that the AIA statute does in fact overturn the concept of forfeiture.[111] It will ultimately be left to the U.S. courts to decide whether the AIA has effectively changed this well-established precedent.

3. European View of Forfeiture

Since the governing principle in Europe is that of a public teaching, it comes as no surprise that the concept of forfeiture as barring patentability is not recognized by the EPC. Indeed, as is well established within the EPC, as well as national patent laws of European countries, a secret/non-disclosing use of an invention does not make the invention "available to the public."

C. „Public Use"

In the United States, the 1952 Patent Act stated that the public use of a product more than a year before the filing of the patent application was a bar to patentability.[112] For example, an improved kaleidoscope was held to be in public use within the meaning of the 1952 Patent Act § 102(b) because the inventor had demonstrated the device to several guests at a party in her own home.[113] Public use includes "any use of [the claimed] invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor."[114] The public use bar furthers patent policy by encouraging prompt filing and not allowing an inventor to claim things already in the public realm of knowledge.[115] The court considers whether the use was accessible to the public and whether it was commercially exploited.[116] As discussed above in the context of confidentiality and teaching of the reference, the focus of the public use analysis has historically been whether or not the information is available, and not whether the content of the information was understood or even received by anyone.

101 AIA Guidelines, *supra* note 22, at 11,075.

102 157 *Cong. Rec.* at S1370 („Whether an invention has been made available to the public is the same inquiry that is undertaken under existing law to determine whether a document has become publicly accessible, but is conducted in a more generalized manner to account for disclosures of information that are not in the form of documents.").

103 Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 520, 68 U.S.P.Q. (BNA) 54 (2d Cir. 1946) („[I]t is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.").

104 *Id.*

105 W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 U.S.P.Q. (BNA) 303, 310 (Fed. Cir 1983) („There is no reason or statutory basis, however, on which [one party's] secret commercialization of a process, if established, could be held a bar to the grant of a patent to [a different party] on that process.").

106 157 *Cong. Rec.* at S1370.

107 *See Metallizing Eng'g Co.*, 153 F.2d at 520.

108 Dennis Crouch, *Did the AIA Eliminate Secret Prior Art?*, *PatentlyO* (Oct. 10, 2012), http://www.patentlyo.com/patent/2012/10/did-the-aia-eliminate-secret-prior-art.html.

109 *Id.*

110 *See Metallizing Eng'g Co.*, 153 F.2d at 520.

111 Dennis Crouch, *supra* note 104.

112 35 U.S.C. § 102(b) (2006).

113 Beachcombers, Int'l, Inc. v. Wildewood Creative Products, Inc., 31 F.3d 1154, 1159–60, 31 U.S.P.Q.2d (BNA) 1653 (Fed. Cir. 1994).

114 Netscape Commc'ns Corp. v Konrad, 295 F.3d 1315, 1320, 63 U.S.P.Q.2d (BNA) 295 F.3d 1315 (Fed. Cir. 2002) (quoting Petrolite Corp. v. Baker Hughes Inc., 96 F.3d 1423, 1425, 40 U.S.P.Q.2d 1201 (Fed. Cir. 1996)).

115 *Id.* (quoting Allied Colloids Inc. v. Am. Cyanamid Co., 64 F.3d 1570, 1574 (Fed. Cir. 1995)).

116 Invitrogen Corp. v. Biocrest Mfg., L.P., 424 F.3d 1374, 1380, 76 U.S.P.Q.2d (BNA) 1741 (Fed. Cir. 2005).

1. Experimental Use

Under the 1952 Patent Act, the term "public use" is subject to the common law rule that "experimental use" is by definition not a public use.[117] *City of Elizabeth v. American Nicholson Pavement Co.* is the case that best articulates the experimental use exception.[118] The case involved Nicholson who invented a new pavement.[119] He laid it in public to see the effects heavily loaded wagons had on it.[120] The court record states that he was there almost daily checking the condition of the pavement and asking questions to those who used it.[121] The court held that this experimental use is not a public use.[122] "So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent."[123] Up until passage of the AIA, this negation of public use is still recognized more than 100 years later.[124] The policy is to allow an inventor to perfect his invention before having to file. This allows the invention to conduct extensive research and obtain a patent even if the research takes place in public.[125]

The AIA law itself and its legislative history does not discuss experimental use. The U.S. Patent Office has taken a wait-and-see attitude, stating:

> *Under pre-AIA case law, the experimental use exception negates a use that would otherwise defeat patentability. Neither the AIA nor its legislative history expressly addresses whether the experimental use exception applies to a public use under AIA 35 U.S.C. 102(a)(1), or to a use that makes the invention available to the public under the residual clause of AIA 35 U.S.C. 102(a)(1). Because this doctrine arises infrequently before the Office, and is case-specific when it does arise, the Office will approach this issue when it arises on the facts presented.*[126]

As discussed above, the legislative history does state that the terms are known from case law, which suggests that the experimental use exception is intact.[127] If this view holds, one could argue that the phrase "otherwise available to the public" does *not* modify the understanding of the term "public use," in contrast to the interpretation that "otherwise available to the public" does modify the understanding of "on sale" as discussed above.

2. EPC View of Experimental Use

The decisions of the EPC do not contain the concept of an "experimental use" exception to exempt certain uses from the prior art. This can be particularly troubling for an applicant given the absence of a grace period in the EPC. What is decisive in establishing, whether a particular use or sale forms part of the state of the art, is the question whether the use was made available to the public. If the use was carried out in a way that restricted or imposed confidentiality on those involved with the use, then the particular use will not form part of the state of the art. A number of cases of the EPO Boards of Appeal are concerned with experimental uses and sales where there was no explicit confidentiality agreement but rather an implicit confidentiality was argued.[128]

D. Patented or Described in a Printed Publication – Inherency

1. Inherency in the United States

Under the 1952 Patent Act the teaching of a patent or printed publication may be used for all it fairly discloses, including "inherent disclosures."[129]

> *Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."*[130]

This doctrine applies to products sold to the public as well as published references. Thus, once a product is sold on the market, any invention that is inherent to the product becomes publicly available prior art and cannot be patented.

U.S. courts have made it clear that disclosures, either expressly or inherently, can be prior art references that can anticipate a claim.[131] If a reference is silent as to a claimed feature, extrinsic evidence may be used as a resource so long as the evidence "make[s] clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

117 City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126, 135 (1877).
118 *Id.; see also* Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 78 U.S.P.Q.2d (BNA) 1684 (Fed. Cir. 2006).
119 *City of Elizabeth*, 97 U.S. at 127.
120 *Id.* at 133.
121 *Id.*
122 *Id.* at 134–36.
123 *Id.* at 135.
124 As explained in *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 971, 220 U.S.P.Q. (BNA) 577 (Fed. Cir. 1984), the difference between „exception" and „negation" is not merely semantic. The burden of proof of is on the party attacking the validity of the patent, and the correct question to ask is „was the use a public use?"
125 Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 64 (1998).
126 AIA Guidelines, *supra* note 22, at 11,063 (responding to comment 12 that questioned whether the experimental use exception to public use would continue under the AIA first inventor to file provisions).
127 *H.R. Rep. No.* 110-314, at 57 (2007).
128 *See* Tokai Rubber Indus., Ltd. v. Firma Carl Freudenberg, [1994] T 0782/92 [E.P.O.], *available at* http://www.epo.org/law-practice/case-law-appeals/recent/t920782eu1.html (wherein the opponent had alleged a public prior use). The public prior use concerned the delivery of fifteen dampers to Daimler Benz in Stuttgart. *Id.* In view of the relatively small number of dampers involved, the Board concluded that delivery of the dampers was intended for experimental or test purposes. *Id.* However, as T 0602/91 illustrates, it is not the experimentation per se that disqualifies a use or test from public availability and thus prior art under the EPC. *See Case Law of the Boards of Appeal, supra* note 23, at 81. The opponents in this case had conducted an experiment using the patent proprietor's invention prior to the effective date of the patent without a confidentiality agreement. *Id.* It was found that the opponent had a financial interest in disclosing the invention to the proprietor's competitor, and so the disclosure qualified as prior art. *Id.* at 81–82.
129 *See* SmithKline Beecham Corp. v. Apotex Corp., 403 F.3d 1331, 1342, 74 U.S.P.Q.2d (BNA) 1398 (Fed. Cir. 2005).
130 Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373, 1380, 64 U.S.P.Q.2d (BNA) 1676 (Fed. Cir. 2002) (quoting Cont'l Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2d (BNA) 1746 (Fed. Cir. 1991)).
131 EMI Grp. N. Am., Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350, 60 U.S.P.Q.2d (BNA) 1423 (Fed. Cir. 2001) (citing Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 U.S.P.Q. (BNA) 781 (Fed. Cir. 1983)).

recognized by persons of ordinary skill."[132] Further, "Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art."[133]

In a specific example, an application for a compound applied to sprouts as a fungicide is a bar to later patentability of the application of the same compound to sprouts to achieve a growth regulation effect.[134] The second use, even though not recognized by the skilled artisan as providing a growth regulation effect, was inherently disclosed.[135]

2. Inherency Under the AIA

Surprisingly, the legislative history of the AIA speaks of the concept of inherency in the context of the broader concept of "forfeiture." Specifically, Senator Kyl stated:

> *Another important aspect of public availability or accessibility is the doctrine of inherency. "Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill," a point noted in Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373, 1380, Fed. Cir. 2002. This doctrine applies to products sold to the public as well as published references. Thus once a product is sold on the market, any invention that is inherent to the product becomes publicly available prior art and cannot be patented.*[136]

Senator Kyl went on to state that the AIA eliminated patent forfeiture doctrines in favor of a general public availability standard.[137] It is unusual to categorize "inherency" as a form of forfeiture, since this does not arise from an act of the party to destroy their own patent rights. The U.S. Patent Office made no comments regarding the concept of inherency in the Final Examination Guidelines—they apparently did not see an issue.[138]

The present authors do not see how this brief statement in legislative history could possibly overturn the substantial body of case law establishing the doctrine of inherency in the United States. This is particularly true when it is realized that members of the U.S. Supreme Court indicate that the value of legislative history that does not directly address a topic is questionable.[139]

Interestingly, if the doctrine of inherency is not eliminated by the AIA, this means that the phrase "otherwise available to the public" would *not* be considered to modify the understanding of the term "patents and printed publications."

3. Inherency in Europe

Probably one of the most significant and fundamental differences in interpretations by courts in the United States and the Boards of Appeal of the EPO in the determination of what a disclosure teaches to one skilled in the art is the doctrine of inherency. EPO decisions have held that the doctrine of inherency is not compatible with the requirement of "availabil[ity] to the public" in Article 54(2) EPC.[140] In a number of decisions, the Enlarged Boards of Appeal deliberated on the use of claims whose limitation lies solely in the stated purpose. The now well-established claim format at the EPO reads as "use of compound X for the purpose Y."[141] The Board observed: "[W]here a particular technical effect which underlies such use is described in the patent, . . . the proper interpretation of the claim will require that a functional feature should be implied into the claim, as a technical feature; for example, that the compound actually achieves the particular effect."[142]

The Enlarged Board applied this principle to a case having a second nonmedical use claim.[143] The claim read: "Use of (certain compounds) . . . for controlling fungi and for preventive fungus control."[144] The relevant prior art disclosed the same compounds in a context of plant growth regulation.[145] The Examining Division in the appealed decision had rejected the claim for lack of novelty, apparently on the basis that the process of carrying out the invention was the same in the prior art document, and so the claimed effect (outcome) underlying the use of the compound for fungus control must have been achieved in the treatment described in the document.[146] In other words, the technical effect underlying the purpose limitation of the claim was inherently achieved by carrying out the prior art process. In its decision, the Enlarged Board of Appeal stated:

> *Under the EPC, a hidden or secret use, because it has not been made available to the public, is not a ground of objection to validity of a European patent. In this respect, the provisions of the EPC may differ from the previous national laws of some Contracting States, and even from the current national laws of some non-Contracting States. Thus, the question of "inherency" does not arise as such under Article 54 EPC.*[147]

132 *Cont'l Can Co. USA*, 948 F.2d at 1268 (citing *In re* Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. (BNA) 323 (C.C.P.A. 1981)).

133 MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 U.S.P.Q.2d (BNA) 1303 (Fed. Cir. 1999) (citing *In re* King, 801 F.2d 1324, 1326, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986)).

134 *See In re* Cruciferous Sprout Litig., 301 F.3d 1343, 1352, 64 U.S.P.Q.2d (BNA) 1202 (Fed. Cir. 2002).

135 *See id.*

136 157 *Cong. Rec.* S1360, at 1370 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

137 *Id.*

138 *See* AIA Guidelines, *supra* note 22.

139 Justice Scalia, for one, is notoriously skeptical of its value, stating that „‚examining the entrails of legislative history' is a fool's errand." Robert Barnes, *Supreme Court lawyers cautious when offering one specific piece of evidence*, *Wash. Post* (Apr. 22, 2012), http://articles.washingtonpost.com/2012-04-22/politics/35452738_1_justice-sonia-sotomayor-legislative-history-lawyers-offer.

140 Mobil Oil Corp., [1989] G 2/88 [E.P.O.], *Official Journal EPO* (Dec. 11, 1989), *available at* http://archive.epo.org/epo/pubs/oj1990/p093_185.pdf (Decisions of the Enlarged Board of Appeal).

141 *Id.*

142 *Id.*

143 *Id.*

144 *Id.* at 109 (alteration in original).

145 *Id.*

146 *Id.* at 109–10.

147 *Id.* at 111–12.

It deserves mention here that the rejection of the application of the doctrine of inherency by the EPO has implications reaching well beyond the question of novelty. This difference in the permitted scope of availability of a given prior art reference as determined by what it is deemed to "make available to the public" is a key factor that may lead to a finding of inventive step in the EPO, whereas under the same set of facts, giving due consideration to what the disclosure "inherently" teaches, U.S. courts may arrive at a finding of obviousness.

V. Conclusion

The AIA does not achieve one of the expressly desired goals of harmonization of U.S. patent law with the patent laws of the rest of the world, even though it introduces a phrase that is familiar to European practitioners. This is, on the one hand, because the definition and core philosophy of the concept of what is appropriately available as prior art is fundamentally different. However, as the above comparison of various case law in the respective jurisdictions show, the term "available to the public" found in both the AIA and the EPC will likely be interpreted in a very different way by U.S. courts compared to the Boards of Appeal at the EPO.

While certain categories of prior art will no longer be available for citation in the United States because of the new phrase "otherwise available to the public," such as confidential sales and secret prior art processes, other categories will likely not be disturbed. It does not appear conceivable that U.S. courts would disregard a whole body of case law pertaining to the pre-AIA law related to inherency or experimental use without clear repudiation in the plain language of the AIA. It is even less likely that U.S. courts will consider interpretation given to the similar terms by tribunals in a foreign jurisdiction. Rather, it is to be expected that U.S. courts will attempt to reconcile the pre-AIA case law with the new law. There is ample opportunity for the courts to do so because terms in 35 U.S.C. § 102 of the 1952 Patent Act[148] also appear in the new 35 U.S.C. § 102 under the AIA.[149]

We must conclude that the similarity of prior art definitions between U.S. law and that of the EPC will stop at the similarity of the phrase "otherwise available to the public." Harmonization of the evaluation of availability of many types of disclosures as prior art in the United States as compared to Europe has likely not been achieved by the AIA. On reflection, this is not surprising, given that years of harmonization of patent law in Europe have not achieved harmonization to the extent that the outcome of a particular case in one country is also the outcome in another country.[150] It would be an illusion to think that the amendments to the AIA would achieve such harmonization.

We are concerned that the new phrase in 35 U.S.C. § 102(a) may lead some practitioners, in particular, the European practitioner, to a false sense of security in understanding the AIA. It is to be expected that the term "available to the public" will have a significantly different interpretation in U.S. courts, as compared to how this term is typically interpreted in the EPO. It is the hope of the authors that this article will aid in avoiding confusion among practitioners on both sides of the Atlantic.

148 35 U.S.C. § 102 (2006).
149 35 U.S.C.A. § 102 (West 2012)
150 *See* David Perkins & Garry Mills, *Patent Infringement and Forum Shopping in the European Union*, 20 *Fordham Int'l L.J.* 549, 549–50 (1996) (discussing forum shopping and in particular the famous *Epilady* cases).

Corrigendum

The editors apologize for the following errors in issue 2/2013.

Page 54 – The most important decisions of the EUEJ in patent matters
The correct title of the publication should have been
"The most important **decision** of the **CJEU** in patent matters".
– so singular decision and not plural decisions
– also CJEU and not EUEJ. The correct abbreviation of the Court of Justice of the European Union is CJEU.
The author, Mr Brack, works and lives in Switzerland and has Swiss citizenship so it should read: H.-P. Brack (**CH**)

Page 67 – UNION ExCo Position paper

The authors of the UNION ExCo Position paper should read:

The Vice President
Reinier Wijnstra

Hearing within a reasonable time

L. Steenbeek (NL)

Abstract

If an international organization does not sufficiently guarantee human rights itself, national courts will jump in and ignore the privileges and immunities of the international organization to the extent necessary to ensure that human rights are respected. The German Bundesverfassungsgericht has said so in relation to the EU, and recently, the NL District Court of The Hague has said so in relation to the EPO. In the NL case at hand, an EPO employee could only expect a decision in his labor dispute 15 years from now, while the European Convention on Human Rights guarantees a hearing within a reasonable time.

To prevent national courts from intervening into EPO matters, the EPO itself has to ensure that decisions are taken within a reasonable time. Not only in labor disputes, but also in patent matters.

To achieve this goal in labor matters, the article suggests that labor disputes are first decided by the Legal Board of Appeal, and that the possibilities for a further appeal to the ILO are limited so that the ILO will not receive more cases than it can handle. To achieve this goal in patent matters, the article suggests to reduce the number of patent cases to ensure that patent decisions are taken within a reasonable time. The number of patent cases can be reduced by making it relatively unattractive to enter the PCT national phase without a fully positive PCT report, and by relaxing the time limit for filing oppositions.

Background

In a decision dated 16 July 2013[1], in a dispute between a former EPO employee and the EPO, the District Court[2] of The Hague decided that it had to ignore the EPC Protocol on Privileges and Immunities. The reason for this decision was that the Administrative Tribunal of the International Labour Organization ("ILOAT"), the court mentioned in Article 13(1) EPC[3] as competent to settle such disputes, is unable to guarantee a hearing within a reasonable time, as required by Article 6(1) ECHR[4]. As there are about 150 appeals by EPO employees pending before the ILOAT, while the ILOAT only handles about 10 of such appeals per year, it may take 15 years before an appeal is handled. The District Court believed that this violates the right to a hearing within a reasonable time.

The District Court of The Hague is not the first national court saying that if necessary, it will guarantee human rights if an international organization does not sufficiently guarantee human rights itself.

See the Solange-II-Beschluss [5] (Beschluss vom 22. Oktober 1986, Az: 2 BvR 197/83) from the German Bundesverfassungsgericht:

> *„Solange die Europäischen Gemeinschaften, insbesondere die Rechtsprechung des Gerichtshofs der Gemeinschaften einen wirksamen Schutz der Grundrechte gegenüber der Hoheitsgewalt der Gemeinschaften generell gewährleisten, der dem vom Grundgesetz als unabdingbar gebotenen Grundrechtsschutz im wesentlichen gleichzuachten ist, zumal den Wesensgehalt der Grundrechte generell verbürgt, wird das Bundesverfassungsgericht seine Gerichtsbarkeit über die Anwendbarkeit von abgeleitetem Gemeinschaftsrecht, das als Rechtsgrundlage für ein Verhalten deutscher Gerichte und Behörden im Hoheitsbereich der Bundesrepublik Deutschland in Anspruch genommen wird, nicht mehr ausüben und dieses Recht mithin nicht mehr am Maßstab der Grundrechte des Grundgesetzes überprüfen; entsprechende Vorlagen nach Art. 100 Abs. 1 GG sind somit unzulässig."*

Put otherwise: as soon as the EU no longer sufficiently guarantees human rights itself, the German Bundesverfassungsgericht will jump in and handle human rights complaints against the EU.

I would believe that what holds for the EU also holds for the EPO.

I would thus believe that the EPO has to do something to ensure that EPO hearings are within a reasonable time, so as to prevent further interferences by national courts from occurring.

Not only in labor disputes, but also in patent matters[6], the latter subject being more interesting for users of the EPC system.

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1 See *https://sites.google.com/site/ipkatreaders/cases/dh-kantonrechter.pdf?attredirects=0&d=1*.

2 In particular a judge from the District Court team that handles civil law labor disputes; administrative law labor disputes are handled by another team in the District Court. Before going into the question whether the EPO may invoke immunity, the question could have been raised whether this judge had jurisdiction.

3 Article 13 EPC – Disputes between the Organisation and the employees of the European Patent Office
(1) Employees and former employees of the European Patent Office or their successors in title may apply to the Administrative Tribunal of the International Labour Organization in the case of disputes with the European Patent Organisation, in accordance with the Statute of the Tribunal and within the limits and subject to the conditions laid down in the Service Regulations for permanent employees or the Pension Scheme Regulations or arising from the conditions of employment of other employees.

4 See *http://www.echr.coe.int/Documents/Convention_ENG.pdf*.
Convention for the Protection of Human Rights and Fundamental Freedoms, Rome, 4.XI.1950
Article 6 ECHR – Right to a fair trial
1. In the determination of his civil rights and obligations or of any criminal charge against him, everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law.
…

5 See *http://de.wikipedia.org/wiki/Solange_II* .

6 From Chapter IV EPC it follows that a European patent application is an object of property, and thus a civil right, so that Article 6(1) ECHR is relevant as it says that in the determination of his civil rights and obligations …,

For a reference on what would be a reasonable time, the Preamble of the draft Unified Patent Court Rules of Procedure[7] says that proceedings shall be conducted in a way which will normally allow the final oral hearing on the issues of infringement and validity at first instance to take place within one year whilst recognising that complex actions may require more time and procedural steps and simple actions less time and less procedural steps.

As an EPO examination/opposition appeal only relates to validity, without having to decide on infringement, there is no reason why the one year period mentioned in the draft UPC Rules of Procedure should be exceeded for a normal EPO appeal. However, in 2012 it took on average 30.8 months to settle an EPO appeal, while the number of new technical appeals (2 602) was again higher than the number of appeals settled (2 029), so that pendency time has gone up[8].

It also seems a quite reasonable desire that an EPO labor dispute does not take more than one year either, rather than 15 years, as is currently the case with the ILOAT's way of handling EPO labor disputes.

Possible solutions

1. Labor disputes

In labor matters, the EPO could perhaps derive inspiration from Rule 12(6) EPC[9] and change the Service Regulations and Rule 12(6) EPC to the effect that labor disputes are first handled by the Legal Board of Appeal (LBA)[10] after payment of the appeal fee, and that appeals to the ILOAT against LBA decisions are only possible to the extent that the appellant complains about a violation of the Universal Declaration of Human Rights[11]. However, if the appellant believes a review ground[12] to apply to the LBA decision, the appellant should first exhaust that possibility as well. Such limitations would seem possible in view of Article 13(1) EPC: "within the limits and subject to the conditions laid down in the Service Regulations", and would ensure that the ILOAT will no longer get more EPO appeals than it can handle. As the LBA is clearly an independent and impartial tribunal established by law, it seems perfectly OK to limit any further appeal to the ILOAT (a UN body) to grounds mentioned in a basic UN document.

If any such decision is made, the EPO only needs to ensure that unlike the ILOAT, the LBA does handle appeals within a reasonable time, i.e. within about one year from filing the appeal.

Rule 12(6) EPC is in the EPC as from its adoption in 1973, which shows that the EPC's founding fathers have believed that the EPO Boards of Appeals' competences as laid down in the EPC Articles are not limitative, and that the Administrative Council could give additional judicial powers to the EPO Boards of Appeal.

I would recommend against following the example in disciplinary matters by establishing an appeal body outside the EPO Boards of Appeal (i.e. not using the possibility suggested by Rule 12(6) EPC to give additional judicial powers to an EPO Board of Appeal), as the EPO employees in any appeal body outside the EPO Boards of Appeal are subject to the supervisory authority[13] of the EPO President as Article 23 EPC on independence of the members of the Boards of Appeal only applies to the Boards of Appeal mentioned in Articles 21 and 22 EPC, so that such a new appeal body would not meet the requirements of Article 6 ECHR as regards independency. If an internal appeal body for handling labor disputes in not independent, then it is not acceptable to limit the jurisdiction of the ILOAT as proposed above. So, in order to ensure that the ILOAT only receives a number of EPO appeals that it can handle, the EPO needs to provide for an internal appeal body that is independent, and that implies that jurisdiction should be given to an EPO Board of Appeal.

The Disciplinary Board of Appeal[14] is not independent as any clause in an Administrative Council decision such as the Disciplinary Regulation[15] aiming at guaranteeing independence of an appeal body outside the EPO Boards of Appeal is subject to the higher-ranking Article 10(2)(f) EPC on the EPO President's supervisory authority as regards the EPO employees who are members of that appeal body, while these EPO employees form the majority in the Disciplinary Board of Appeal.

2. Patent matters

Also in patent matters, there is something left to be desired as regards the EPO's timeliness and thus as regards compliance with Article 6 ECHR, so that here too, a national court may see a need to jump in. Timeliness is also a TRIPs requirement[16].

everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law.

7 See *http://www.unified-patent-court.org/images/documents/draft-rules-of-procedure.pdf*.

8 Data from CA/44/13, EPO President's Activities Report for the year 2012, dated 01-03-2013.

9 The Administrative Council may allocate duties under Article 134a, paragraph 1(c), to the Boards of Appeal.

10 An EPO Board of Appeal that consists of three legally qualified members (Article 21(2) EPC) should be quite capable of handling labor disputes.

11 See *http://www.un.org/en/documents/udhr/*.

12 See Article 112a EPC on petitions for review by the Enlarged Board of Appeal.

13 Article 10 EPC – Management
(1) The European Patent Office shall be managed by the President, who shall be responsible for its activities to the Administrative Council.
(2) To this end, the President shall have in particular the following functions and powers:
…
(f) he shall exercise supervisory authority over the staff; …

14 In its decision D 5/82, see *http://www.epo.org/law-practice/case-law-appeals/recent/d820005ep1.html*, the Disciplinary Board of Appeal decided that it is not a Board of Appeal within the meaning of Article 21 EPC, so that it could not refer questions to the Enlarged Board of Appeal. As a consequence of not being a Board of Appeal within the meaning of Article 21 EPC, Article 23 EPC does not apply to the Disciplinary Board of Appeal either.

15 See *http://www.patentepi.com/fileadmin/user_upload/content/By-Laws/Regulation_on_discipline_as_published_in_Suppl_to_OJ_EPO_1_2013.pdf*.

16 See *http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm*.
Article 62(4) TRIPs: Procedures concerning the acquisition or maintenance of intellectual property rights and, where a Member's law provides for such procedures, administrative revocation and *inter partes* procedures such as opposition, revocation and cancellation, shall be governed by the general principles set out in paragraphs 2 and 3 of Article 41.
Article 41(2) TRIPs: Procedures concerning the enforcement of intellectual property rights shall be fair and equitable.

As in the near future, EP applications could become unitary patents, and EPC opposition procedures could relate to unitary patents, the need to ensure a hearing within a reasonable time is confirmed by Article 47 of the EU Charter of Fundamental Rights[17].

I would believe that the most effective way to improve the EPO's timeliness is to reduce the numbers of cases to be handled by the EPO.

The number of cases subject to substantive examination and beyond could e.g. be reduced in the followings ways:

1. Encourage using the PCT international phase (and the EP search for EP direct applications) more as a gateway by incentivizing applicants to only request substantive examination if they have a fully positive report for the claims for which examination is requested. This could be done by substantially increasing the examination fee e.g. by integrating the designation fee and the grant fee into it (the latter two fees would thus be abolished), while giving reductions based on whether when substantive examination is requested, the applicant has a fully positive report for all claims for which examination is requested. By using PCT-II it should be generally possible to obtain a fully positive report if the application contains a patentable invention. The level of the reduction could depend on who made the positive report: with an EPO report, the reduction would be higher (e.g. up to 100 %) than if the positive report was made by another European PCT authority (still a substantial reduction but less than 100 %) or by a non-European PCT authority (then a lower reduction should apply that still acts as an encouragement to only enter the EP national phase with a positive report).

   As a further incentive for requesting substantive examination only when the applicant has a fully positive report for all claims for which examination is requested, such cases would be automatically subject to accelerated examination.
2. Extend[18] the deadline for filing oppositions to 20 years from filing: this will likely result in fewer oppositions as oppositions would then only be filed if the patent is a genuine threat to current activities (or activities in the immediate future) rather than some potential threat in a more distant future to some future activities that may never start), and thus in fewer opposition appeals. A further reduction in the number of opposition appeals may be expected as the longer period for filing an opposition also allows opponents to file better oppositions. As 50 % of the EPO appeals are opposition appeals, the reduction in appeals could be very substantive, and thus result in a very substantive throughput time reduction.

A reduction in the number of EPO appeals is especially necessary if – as provided for in Article 149a(2)(a) EPC[19] – members of the EPO Boards of Appeal start serving as part-time Unified Patent Court ("UPC") judges, which is very desirable to ensure that the UPC has sufficient technical judges in all technical fields to ensure a high level of quality and efficiency, and if – as suggested above – the LBA starts handling labor disputes as well.

There will always be users against such changes as they believe that maximum freedom should be left to applicants/patentees. It would – in their view – thus not be desirable to encourage users to tidy up their applications already in the international phase, which would benefit all designated offices. Other users want to keep the situation that it is difficult for their competitors to attack their patents by only having a possibility for a central attack during a short period after grant.

However, I would believe that the EPO should act in the general interest rather than in the particular interest of certain users, and that it is in the general interest that legal certainty is improved by improving the EPO's timeliness. Especially when a lack of timeliness results in an ECHR issue that may prompt a national court to see a need to interfere in EPC matters.

Businesses need early certainty about whether their competitors' applications will be granted and whether any opposition is successful. It is not in the general interest if any questionable patents[20] that slipped through the net cannot be removed by means of a central attack during the entire lifetime of the patent.

As an aside, the UPC opt-out fee should thus be commensurate with the costs to society of not being able to subject any questionable patents to a central attack.

They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

17 See *http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2010:083:0389:0403:en:PDF.*
Article 47 EU Charter of Fundamental Rights – Right to an effective remedy and to a fair trial
Everyone whose rights and freedoms guaranteed by the law of the Union are violated has the right to an effective remedy before a tribunal in compliance with the conditions laid down in this Article.
Everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal previously established by law. …

18 As the deadline for filing an opposition is a time limit, any such change can be decided upon by the Administrative Council under Article 33(1)(a) EPC with a 75 % majority, see Article 35(2) EPC.

19 Article 149a EPC – Other agreements between the Contracting States
(2) The Administrative Council shall be competent to decide that:
(a) the members of the Boards of Appeal or the Enlarged Board of Appeal may serve on a European patent court or a common entity and take part in proceedings before that court or entity in accordance with any such agreement; …

20 As a result of the fact that EPO examiners are humans, while humans make mistakes, some EPO grant decisions will be the result of a mistake even if in general, the EPO's quality is high. While the percentage of wrongly granted patents may not seem high, the costs of any such patents to competitors may be considerable.

Commentary on J. E. Stiglitz's article „life or profit?"

P. Rosenich (LI)

On May 27, 2013, the *Volksblatt* a daily Liechtenstein Newspaper printed an article by Joseph E. Stiglitz, the Nobel Prize winner for economics and professor at The Columbia University.

The title of the article is **life or profit**?

It relates to the question, whether "today's patent system" is still adequate.

Subheadings read and suggest that the author wants also to add to "IP-bashing" which became topical recently:

Rights ruthlessly enforced; Weigh interests; Risk of corruption due to monopolies; Trend heads into a different direction; Design rules better.

The author refers to a pending court case, which was heard in the U.S. before the Supreme Court at the time of the article. The article obviously served the purpose of influencing the Supreme Court to a certain extent or to at least give a political opinion on the subject of patent protection.

Without discussing this concrete case in detail, the article by the Nobel Prize winner, however, worries in a number of aspects and it causes some surprise because of an attitude, which is downright anti-patent for an economist.

Due to the fact that the general topic of the article is gene technology, this attitude reminds me of the statement by a known immunologist, who commented to the ever increasing voices against immunizations as follows: "In an immunized environment, not being immunized still means being relatively well protected."

With this, the physician expressed what I can also see by analogy in the patent criticism by Nobel Prize winner Prof. Stiglitz: Supported on the patent system, mankind initiated an enormous technology development in the last 200 years and enjoyed its advantages, which had not existed before in the million years of history of mankind.

It was no coincidence that the Paris Union Convention of 1883 witnessed many important inventions of worldwide significance. Hardly any noteworthy invention in the last hundred years did not also appear in patent applications and the desire for patent protection steadily drove inventors in their intellectual creation. When someone in society today "owns a patent", this automatically means a higher social recognition. Rightfully so, I think, for the most part.

The fact that today, every noteworthy company has one or more impressive portfolios of intellectual property worldwide – in particular inventions or patents, respectively, is no coincidence or a side effect, but it is the basis of our developed world with the enormous conveniences, which were brought to us by modern technology.

In this respect, we are in a protected environment with Prof Stiglitz. In such an environment, this leads to more and more inventions sparked by inventive genius and the pursuit of patent protection. Personal competition among inventors, but also the pursuit of business are surely a driving factor.

It is not only wrong and unfair to the "patent system" to now cry out and postulate in this "protected environment":

"It is becoming more and clearer that the patent system, as it is currently designed, does not only because of immeasurable social costs, but also fails to ensure a maximum of innovation."

Such a statement completely ignores the fact that it is the "patent system", which has brought us this technology-based prosperity with a relatively distinctive welfare system.

This is so, because it is the basic principle of the "patent system" to get inventors to disclose their ideas and results to the public – instead of keeping them a secret – where possible, as is practiced in some places (see the secret formula for the Coca Cola® beverage). For gaining this knowledge, society uses the patent laws to provide an incentive to the inventor, namely the limited monopoly to his invention and a limited period of time and for payment of a maintenance fee, which is often quite considerable.

This principle is fair and, generally speaking, adequate as well. It is not uncommon for disputes and difficult questions to arise time and again in peripheral areas of technology, but this does not mean at all that the "patent system" as such is ineffective or harmful.

Prof. Stiglitz is incorrect when alleging and without giving proof: "a badly designed patent system – such as the one we currently have – can hinder scientific follow-up studies".

In contrast it is a fact that patent publications make the public aware of the knowledge about a new invention – generally for the first time – 18 months after a patent application and they thus oftentimes invite scientist or researchers for the first time to carry out follow-up studies or to look for better alternative solutions, respectively. In principle, the effect of an invention multiplies in this way, because it is oftentimes improved and further developed by many other inventors or because it is bypassed by other, better solutions. This can be compared to an avalanche effect, which is triggered by the "patent system, as we know it today".

This is so, because research is generally free and patents generally do not interfere with pure research, as is the wrong opinion of Prof. Stiglitz. It may be the case that problems occur occasionally in this regard in the field of gene technology or in medicine, respectively,

but medical technology in particular is the best example for innovation-driven developments, which are based on patent protection.

It is surprising to find that Prof Stiglitz documents the fact that this appears to be a bit too complicated for some people, in that he gives the IP world an unusual name:: "obscure world of the intellectual property rights".

It seem disconcerting that with this, he again mixes apples and pears, because not only technical inventions, but also literary creations, copyright, music, film but also trade secrets, etc., among others, belong to "intellectual property".

The author's allegation that the "search for knowledge per se" is the reason for "all revolutionary discoveries and innovations – DNA, transistors, lasers, the internet, etc.", is pure speculation, the inaccuracy of which can be substantiated a million times over. All of said fields are paved with patent rights.

The fact that researches have sometimes "overlooked" to file an application for their invention, turned out to be a tragedy in many cases. In addition, it is correct that some inventors did not have "enough money" or "sponsors" so as to look for comprehensive patent protection. In principle, however, this is what always was and is the goal: patent protection for fame, recognition and financial profit from the invention.

It might be politically correct that Prof. Stiglitz challenges monopolies and their price politics in the article and thus voices hidden criticism about capitalism, but to convert this into criticism of the "patent system" and to even base the poverty in the Third World on this, does not fit the facts at all.

Monopolies create a risk of corruption, because they are subject to the capitalistic desire for profit maximization and not, because they can patent inventions. To "express this more generally" in Prof Stiglitz's words: Capitalism is a form of society, which promotes the formation of monopolies. In contrast, the patent system is an instrument for reproducing knowledge and creates incentives to invent and to further develop the technology. This works out regardless of the respective form of society, as millions of patents from the former COMECON States prove.

When Bill Gates and his friends founded Microsoft in a garage and strived for patents, this had definitely something to do with "the patent system". It should be obvious that our prosperity today is largely also based on these and other software inventions. I don't begrudge Bill Gates and any other inventor as well that this made him rich. Whether or not the software giant Microsoft now acts like a monopoly – as criticized by Prof. Stiglitz – is not due to the patent system but due to the political economic system.

With this in mind, I have insight into the IP world after more than 35 years: It creates life *and* profit and is in no way obscure as opposed to some theories by some economists.

The article by Prof Stiglitz nonetheless points towards an increasing problem: Due to the quantitative increase of information and oftentimes specific politically-motivated misinformation, the IP world is more and more becoming the focus of public opinion and is becoming subject to political pressure. IP-bashing as Prof. Stiglitz presents became fashionable.

In addition, there is a direct impact from the permanent "financial and economic crises", which also finds its way more and more into field strategists and senior IP manager levels.

I see this as the actual risk, because I start out at the above thesis that a further development of prosperity and technology for the benefit of humankind depends on a "patent system" that functions and that is recognized. In that moment, in which an inventor becomes socially ostracized with a patent, this automatically leads to a decline in inventions and improvements.

The fact that, on the other hand, the IP world takes measures and further develops the IP system as well as the processes utilized therein, is obvious due to the current circumstances, in particular also in view of the "financial and economic crises".

Under the patronage of Erbprinz Alois von und zu Liechtenstein and supported by UNION by I3PM and by other institutions, an international IP forum will take place on this topic in Vaduz/Liechtenstein as a conference on November 15-16, 2013, during which experts from the IP world will discuss this topic and will exchange information and strategies. I hope for significantly more valuable impulses than for negative statements by Nobel Prize winners of economics in the local newspaper.

Among others, the Principality of Liechtenstein got into the focus of the IP world, because it introduced a revolutionizing new tax law with an innovative IP box in 2011, which will have the result that this small country in the middle of Europe will become the home for IP portfolios and innovative industry even more so than before. The tax burden of revenue, which is based on IP rights, is finally taxed with a tax rate of 2.5 %, which is to lead to a further stimulation of research and development. In Liechtenstein, a considerably higher number of patents than in any other country in the world are already filed per capita today. Certainly, the Principality of Liechtenstein is among those countries with the highest welfare.

One can predict that political actions like installing IP-Boxes based on the "IP-system" will promote innovation and will help to avoid negative effects which would come up, if the IP-bashers would gain more influence in the society.

Book Review
The Practitioner's Guide to the PCT

Authors: Jay Erstling, Samson Helfgott and T. David Reed
Issued by American Bar Association – Section of Intellectual Property Law
(first edition; 2013;278 pages; US$ 139.95)
ISBN 978-1-62722-014-9

C. Mulder (NL)

I remember that when I was preparing to sit the examination to become a European Patent Attorney, I enjoyed studying the EPC with its Articles and Rules ordered in a straightforward and clearly expressed manner. At the end of the training course, when I was confronted with the PCT, this was a 'disturbing' experience. The PCT Articles appear to be logically ordered, but they also radiate a certain rigidity. Furthermore, the 'Regulations implementing the PCT' (*i.e.* the PCT Rules) seem to have lost contact with the Articles.

In the years following the filing of the first international application in 1978, the PCT Contracting States and the International Bureau of WIPO, desiring to take account of new developments in the world of international patent law (*e.g.* TRIPS and PLT) and also to add more flexibility/leniency to the PCT, started to amend the PCT Rules. Over the years, this has resulted in a disturbing complexity of the PCT Rules, which often caused the meaning of a certain PCT Article to be changed or even declared 'dead' by the PCT Rules.

So, it is complicated to draft a book about the PCT which explains in a straightforward manner how the PCT functions and how applicants and patent attorneys should deal with international applications in order to get them through the international phase, taking advantage of the provisions and avoiding the traps and pitfalls of the system.

This is precisely what the three authors have accomplished with **'The Practitioner's Guide to the PCT'**: they explain the PCT system in a straightforward manner. The book is a pleasure to read. They start by setting out the main lines of the PCT, followed by chapters detailing the procedural provisions. A very helpful chapter is the one dealing with procedural safeguards with helpful options when things go wrong. Another very useful chapter describes strategies and recommendations. There is a general chapter on entering the national phase, which is followed by a chapter on entry into the national phase before the USPTO and a further chapter on entering the national/regional phase in Europe, China and elsewhere. The final chapter discusses the future of the PCT.

Because two of the three authors are experienced US patent agents registered to practice before the USPTO, all aspects of American Patent Law are fully covered in the book including all the changes in relation to the America Invents Act and the effects on the PCT. Therefore, the book is very up-to-date and complete.

If I may add one negative point: the book describes the functioning of the PCT practically without referring to the Articles, Rules or the Applicant's Guide. Therefore, the book is not very helpful as a tool for preparing for the EQE.

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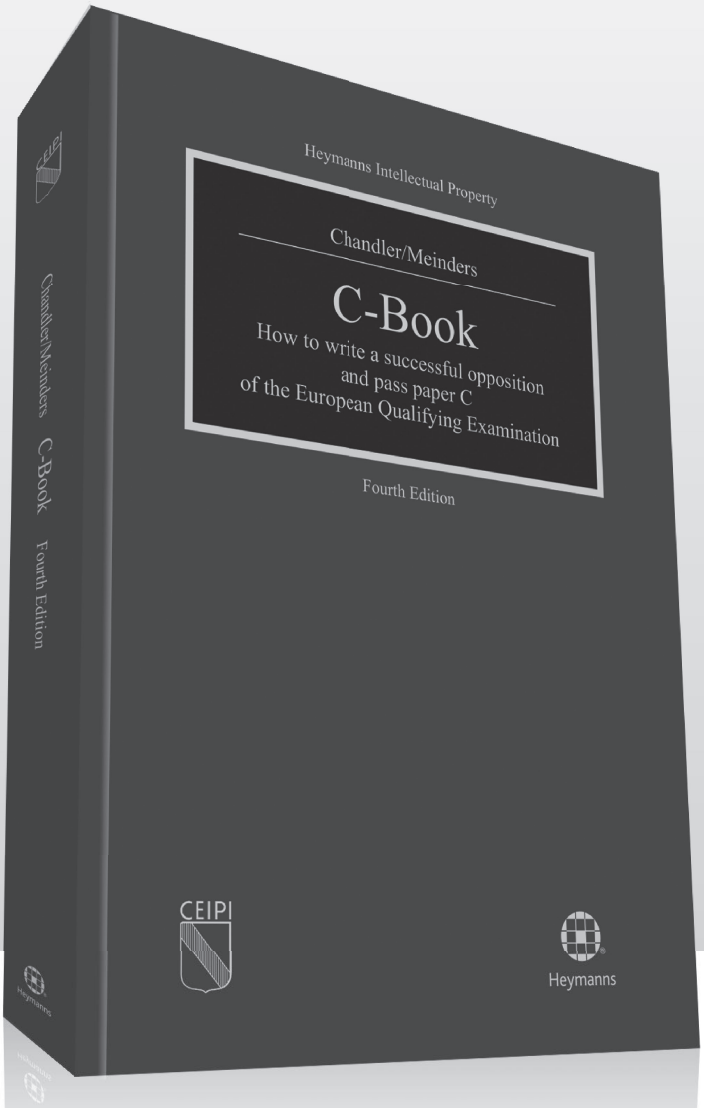

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William E. Chandler, Member of a Technical Board of Appeal of the EPO, and
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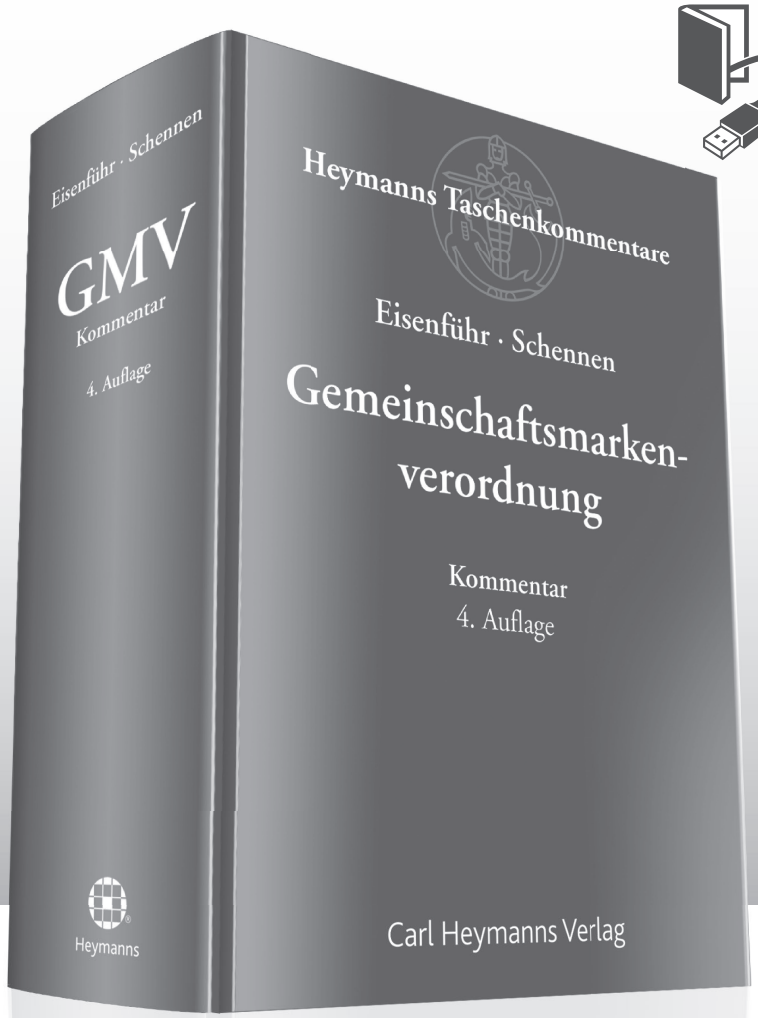

Der Kommentar
konzentriert sich unter weitgehendem Verzicht auf wissenschaftliche Streitfragen, gleichwohl nicht ohne kritische Beleuchtung, darauf, wie sich das Gemeinschaftsmarkenrecht heute in der Praxis des Amtes und der Rechtsprechung des EuGH darstellt.

Das erweiterte Autorenteam:
PA Dipl.-Ing. *Günther Eisenführ*, *Dr. Detlef Schennen*, RA *Dr. Julian Eberhardt*, RAin *Marlene Feddermann*, RA *Harald Förster*, RAin *Yvonne Holderied*, RAin *Dr. Stefanie Overhage*, RA *Ulrich Sander*

„Der ‚Eisenführ/Schennen' bringt seinen Nutzer schnell auf den Stand der Entscheidungspraxis des HABM und der Rechtsprechung. Er bleibt damit die unerlässliche Hilfe für alle, die mit den erforderlichen Vorprüfungen und der Anmeldung selbst, mit Widerspruchsverfahren und weiteren Streitigkeiten hinsichtlich der Gemeinschaftsmarke befasst sind."

RA Constantin Rehaag, Frankfurt/Main, zu Vorauflage in: Mitteilungen 04/11

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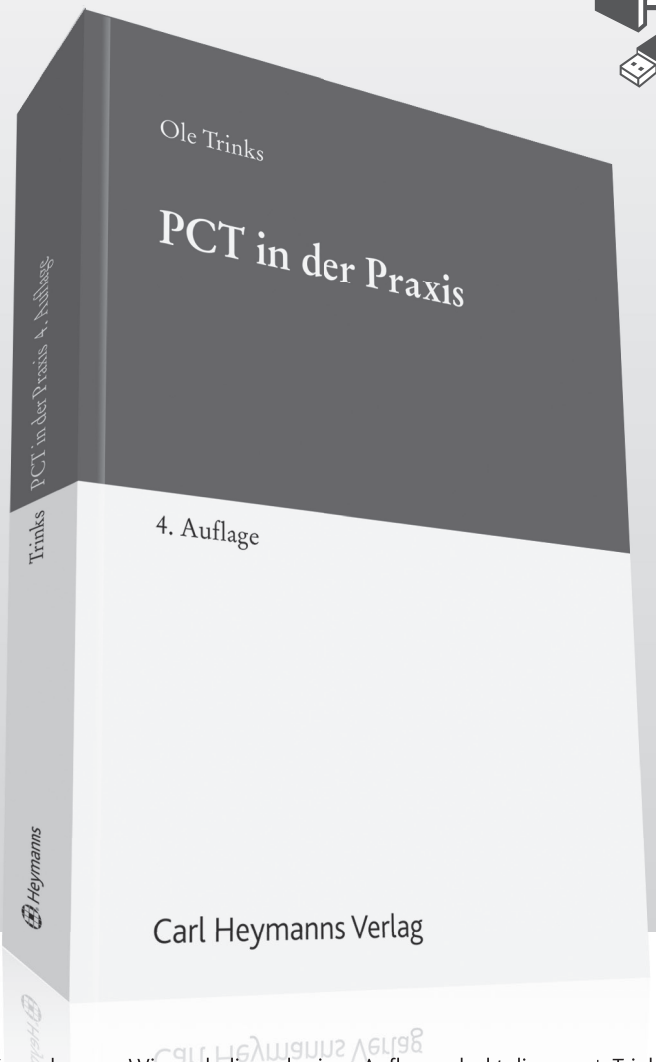

Schwerpunkt des Buches ist der PCT aus der Sicht des europäischen Anmelders, da vor allem die Besonderheiten des Europäischen Patentamts als PCT-Behörde berücksichtigt sind. In der überarbeiteten vierten Auflage wurden die neusten Entwicklungen im PCT-Verfahren aufgegriffen und eingearbeitet. Insbesondere wird nunmehr auf die neuen (elektronischen) Möglichkeiten des PCT sowie die Auswirkungen des **America Invents Act**, der zum 16. September 2011 in den Vereinigten Staaten von Amerika in Kraft getreten ist, eingegangen. Außerdem wurden zahlreiche Aktualisierungen vorgenommen sowie eine Vielzahl von neuen Fallbeispielen eingefügt, um die praktische Anwendbarkeit des PCT weiter zu erläutern.

Wie auch die vorherigen Auflagen deckt die Neuauflage alle wichtigen bei der Europäischen Eignungsprüfung (EQE) behandelten Problemstellungen betreffend den PCT umfassend ab.

Der Autor:
Dr. Ole Trinks ist Patentanwalt und zugelassener Vertreter vor dem EPA und HABM.

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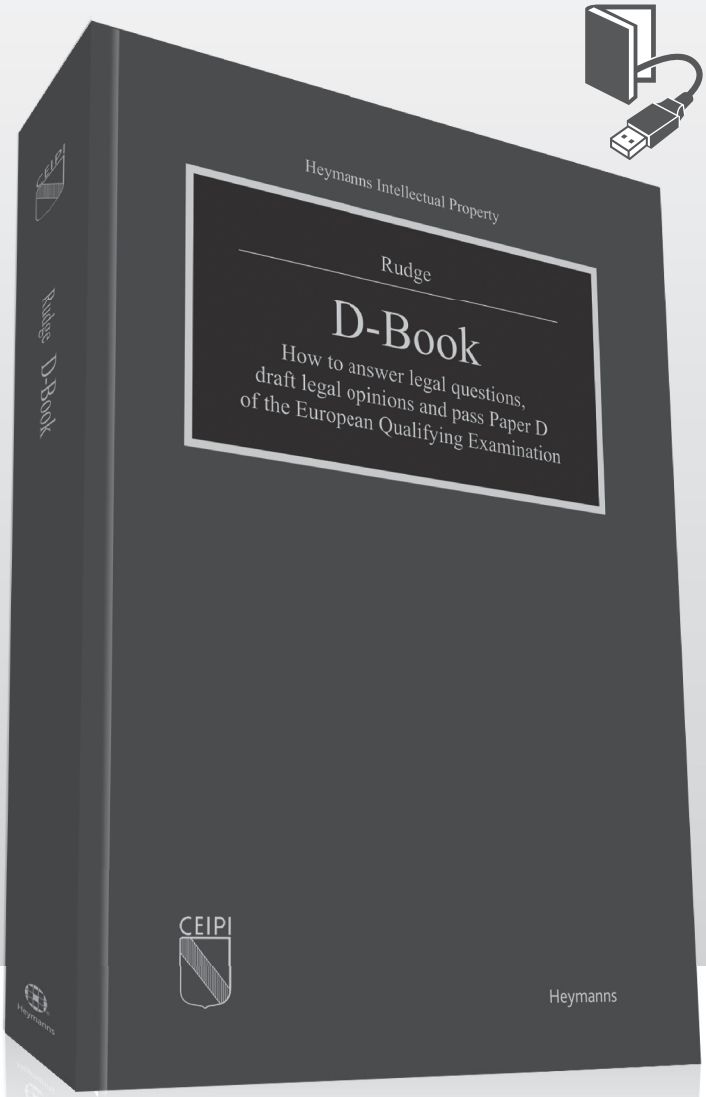

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Part A offers general advice on how the legal papers should be approached and should be used in conjunction with attempts at past papers in order to develop strategy and tactics. Key legal principles are also explained in Part A.

Parts B and C set out the relevant law under the EPC and PCT. Subject matter in these sections has been set out in a logical sequence that mirrors the stages of the patent exam and granting process an applicant encounters in real life. With all the relevant legal materials relevant to each topic brought together, and ordered systematically, it makes it easier for even newcomers to locate important legal basis quickly.

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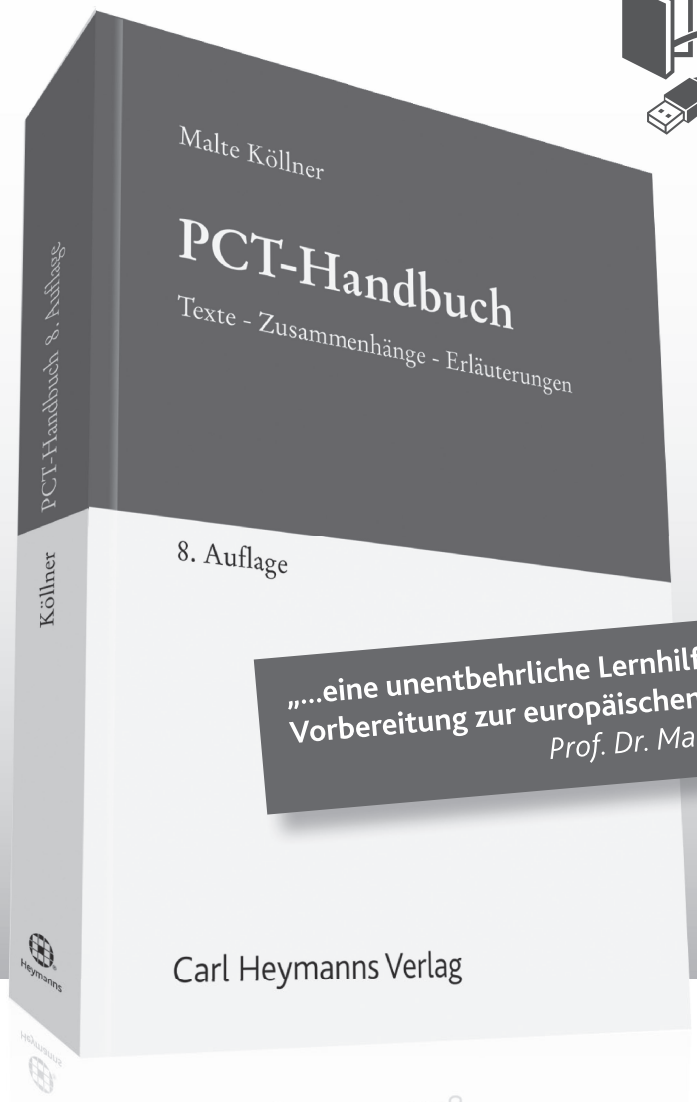

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