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Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Carl Heymanns Verlag

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Postanschrift / Mailing address / Adresse postale
epi
P.O. Box 26 01 12
80058 Munich
Germany
Tel: +49 89 24 20 52-0
Fax: +49 89 24 20 52-20
Email: info@patentepi.com
www.patentepi.com

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Tel. (0221) 94 373-7000
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Kundenservice: Tel. (02631) 801-2222
info@wolterskluwer.de
www.heymanns.com

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Editorial

T. Johnson (GB)

The ingenuity of the human mind never ceases to amaze – which is why we surmise our profession of patent attorney is so intellectually rewarding and stimulating. We are prompted to this reflection by recent news of the invention **and firing** of a pistol produced by a 3-D printer. What will this lead to? Whole armies producing their weapons at home before going off to the front? Would this be a 'good thing'? The mind boggles. Perhaps it is no surprise to learn that the invention was made in Texas.

Hopefully not of such an explosive nature, but closer to our Institute, is the topic of CPE–Continuous (Continuing?) Professional Education. Forty years on from the founding of the EPO, CPE is it seems becoming a hot topic once more. Council will no doubt in due course have to decide whether CPE is a 'good thing' for our members. We will not rehearse all the pros and cons here, but suffice it to say that arguments in favour of a 'yes' to the question include (a) the public, hence our clients, requires reassurance of the (continuing) competence of our members – (Ed- a 'no-brainer'?), (b) protection of the public by regulation of their advisers; and (c) The European Commission (EC) encourages such regulation. It can be argued that the EC has no jurisdiction to influence our Institute, governed as it is at least by the Founding Regulation, Rules of Conduct, and our By-Laws.

However, now that the Unitary Patent is upon us, could or will the EC consider that it has competence over the *epi* at least in matters such as CPE concerning the Unitary Patent and litigation thereof? Our Institute will need to be ever-watchful, whatever the outcome of internal Institute discussions on the desirability or otherwise of introducing CPE for the membership.

Perhaps that Texan invention might come in handy after all!

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 **9. August 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 **August 9, 2013**. Documents for publication should have reached the Secretariat by this date.

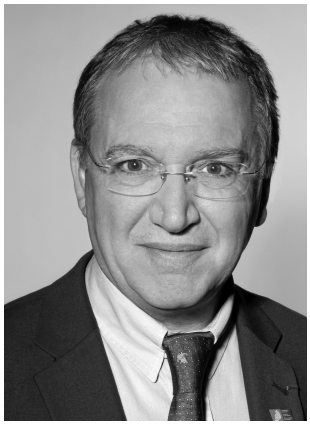
Prochaine date limite pour *epi* Information

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 **9 août 2013**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

President's blog

B. Battistelli, President of the EPO

The *epi* turns 35



This year, the *Institute of Professional Representatives before the European Patent Office (epi*) is celebrating the 35th anniversary of its foundation, and I was very pleased to be present at the ceremony held last week in Vienna to mark this occasion. I would like to take this opportunity to thank again Mr Tony Tangena, the Institute's President, for his very kind invitation to attend. The *epi* has been a close partner to the EPO from the outset: its existence was already enshrined in the European Patent Convention. As the professional body that represents the European patent attorneys of all 38 EPO member states, it has more than 10 000 members.

A main reason for our close cooperation is the *European Qualifying Examination (EQE)* which we organise jointly for patent professionals seeking to be entitled to represent applicants before the EPO. Well over 2000 candidates sit this rigorous examination each year at one of the twelve examination centres across Europe. The average pass rate is around 25 %. We are currently engaged in a modernisation exercise to improve the efficiency and quality of the EQE and also to widen its geographical reach and ensure that the results reflect the diversity of our 38 member states (at present, more than 80 % of the successful candidates come from only five countries).

To this end, we have initiated a wide range of measures, including the implementation of a new IT system to support the organisation of the examination, and the provision of dedicated training activities by the European Patent Academy, for example in the EQE Candidate Support Project for candidates from member states having fewer than five EQE-qualified representatives. The EPO will continue to make available the necessary human and budgetary resources to support the EQE, while striving to enhance the overall efficiency of the system.

In addition to our regular meetings with *epi* representatives on the various official bodies of the EPO, we have been pursuing for some years a specific programme, known as *Praktika*, to foster a better mutual understanding between EPO patent examiners and private practitioners with regard to their respective needs and obligations. The programme offers opportunities for patent attorneys to observe at first hand the work of a patent examination cluster or an EPO board of appeal and, vice versa, for EPO examiners to spend a month in a patent attorney's office. Experience has shown that both parties find this enlightening and useful.

From the EPO's point of view, a rich dialogue with the user community is of paramount importance, as one of the main drivers for the further development of the European patent system. We congratulate the *epi* on its 35th anniversary and look forward to the continuation of our successful partnership.

Report of the By-Laws Committee

P. Moutard (FR), Chair

Composition of the By-Laws Committee:

The Vienna Council decided to expand the By-Laws Committee by including up to 4 substitute members.

To be in line with this decision amendments to the terms of reference of the By-Laws Committee will be submitted to the next *epi* Council.

New committee members were elected by the Vienna Council. The By-Laws Committee is now composed of the following members:

Full Members: Terry Johnson; Paolo Gerli; Günther Schmalz; Pascal Moutard
Substitute Members: Dieter Speiser; Martin Forsthuber; Sylvain Le Vaguérèse;
Associate members: Francis Leyder; Carl Eder.

Preparatory work to the Vienna Council:

Before the Vienna Council amendments to several provisions were discussed in cooperation with the Chairs and members of the corresponding committees and checked for compliance with the By-Laws:
-the terms of reference of the PQC (now PEC) committee;
-the terms of reference of the Electoral objections committee;
-the rules for elections, in order to introduce the possibility of implementing e-voting.

I also remind you of the amendments to the rules for election which were prepared in September last year in the frame of a joint committee meeting (By-Laws – Electoral Committee); these amended rules were then discussed and voted by the *epi* Council in Hamburg.

Discussions on the possibility of implementing mandatory continuing education:

Further to discussions held during the Vienna Council meeting Mr Dieter Speiser has prepared a report on the difficult topic of mandatory continuing education. This paper is being reviewed and discussed by the members of the By-Laws Committee. It will be submitted to the Professional Education Committee on or before June 14 and subsequently to Council.

Meeting of the By-Laws Committee:

A meeting of the By-Laws Committee is scheduled on September 18 in Munich. On that occasion, Dieter Speiser will make a presentation of the By-Laws to the Secretariat and to the members of the By-Laws Committee.

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

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 16.05.2013 covers the period since my previous report dated 17.02.2013.

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

After the adoption of the two Regulations, the Agreement on a Unified Patent Court was signed on 19.02.2013. The Select Committee (of the Administrative Council of the EPOrg) has been set up on 20.03.2013. Its next meeting is planned at the end of May.

The EPPC will continue to monitor the developments. In particular, it is hoped that the request of *epi* to be granted observer status at the Select Committee will be accepted.

2. 8th SACEPO/WPR meeting (17.05.2013)

This report unfortunately had to be completed before the meeting. The papers have been received just a few days ago. The draft agenda reads:

2. Tegernsee process (oral report)[1]
3. Fee matters[2]
   (a) Proposal concerning European search fee/International search fee
   (b) Appeal fee reform
4. PCT reform – Proposals to strengthen the PCT
   (a) Proposal on the amendment of Rule 164 EPC
   (b) Proposed PCT Rule changes
5. Abolishment of printed B publication together with the certificate
6. Results of the online open consultation regarding divisional applications (Rule 36 EPC)
7. Changes in examiners' practice
8. IT Roadmap changes

3. 2013 Guidelines and the 2014 revision

The Working Party on Guidelines has received the final version of the 2013 Guidelines, which should be published in September.

The sub-committee will review the 2013 Guidelines and will start preparing the next batch of proposals, during a first meeting on 23.05.2013 and another meeting this summer. *epi* members are kindly reminded that suggestions for amendment of the Guidelines are welcome at any time (eppc@patentepi.com).

4. 6th Meeting of the PCT Working Group

This report unfortunately has to be completed before the meeting (21. to 24.05.2013). *epi* will attend as observer. The documents from the PCT WG are available from the WIPO website, as will be the draft report:
http://www.wipo.int/meetings/en/details.jsp?meeting_id=28622

5. EPO User Consultations

The committee prepared *epi* responses to the consultations on divisional applications (Rule 36 EPC) and on the revision of Rule 164 EPC.

6. EPPC meeting

The committee will meet 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.

1 This is relevant to the Harmonisation Committee.
2 These are mainly relevant to the EPO Finances Committee, whose opinion has been sought.

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

This report summarizes the main topics discussed by the Biotech Committee during the last Council meeting which were not yet included in the reports of earlier this year.

1. Stem Cells

The German BGH decided to uphold the German Brüstle patent in amended form on 27 November 2012. The interpretation of the CJEU Brüstle decision by the German BGH is different than the EPO interpretation. This German decision is important and is currently being studied by the Biotech Committee.

The EPO decided to revoke the EP Brüstle patent 1040185 on 11 April 2013 during OP for unallowable amendments. The decision may be appealed still and will be studied by the Biotech Committee when it is issued.

2. Sequence Listings

Recently we noted decision J 8/11 which indicates that listing for prior-art sequences would not be required. We will discuss this decision further in our Committee and address the issue in our yearly Committee meeting with the EPO Directors. We consider this to be an important decision.

3. Patentability of Plants and Referral to the EBA (G 2/12)

The EBA in G 2/12 has indicated end of January 2013 that they will continue with the case. The Biotech Committee is currently studying and discussing by email all previously submitted amicus briefs in this case and is preparing a possible amicus brief still.

Further, we note that a hearing took place in the Broccoli case (EP 1069819) on 1 March 2013. The minutes have come out and the case will be continued in writing. At this moment there is no indication that the Board will refer further questions other than the one already pending in G 2/12 to the EBA. Our Committee will monitor this case further.

Report of the Harmonization Committee

F. Leyder (BE), Secretary

This report completed on 13th May covers the period since my previous report dated 17th February 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 IP5, 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 time of completing this report, we did not have the report of the 21st February hearing of European Users organised by the EPO to discuss the issues raised in the questionnaire.

On grace period, the EPO announced that the Economic and Scientific Advisory Board will carry out a study (results expected in January 2014). It also informed us that a survey is being carried out by the USPTO among a number of research institutes and universities in Europe. From the users' side, divergent views were voiced, with a grace period being acceptable only if harmonised worldwide.

On 18-month publication, users were unanimous to welcome it.

On the treatment of conflicting applications, there was a broad consensus.

However, on prior user rights, users generally supported harmonization in Europe as a first step.

2. Next meeting of the Harmonization Committee

The Council has now agreed to discuss "Grace Period Harmonization" at its next meeting on 16th November in Prague, At its meeting of 28th and 29th January, the committee had prepared a series of draft position papers on that topic. The committee will hold a further meeting this summer (on 18th July) to prepare the necessary papers in time for the Board meeting on 28th September.

3. Standing Committee on the Law of Patents at WIPO (SCP)

epi was not represented at the 19th Session (25th to 28th February). All documents relating to that session, including a draft report, are available on the WIPO website:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=25026

No progress was made. In the Summary by the Chair, it is for example reported that some delegations reiterated that any future work on the quality of patents should not lead to harmonization of substantive patent law, and that the Secretariat will prepare a document, based on input received from Member States, on how some exceptions and limitations are implemented in Member States, without evaluating the effectiveness of those exceptions and limitations.

The Secretariat informed the SCP that its twentieth session would tentatively be held during the week of December 9, 2013.

Report of the Litigation Committee (LitCom)

A. Casalonga (FR), Chair

1. Update on the UPC

The UPC agreement was signed on February 19, 2013 by 24 Member States of the European Union (all Member States except Spain and Poland) and by Bulgaria on 5 March 2013.

The Preparatory Committee was established on 26 March 2013 with all signatory states attending the first meeting. Poland was invited as observer.

The tasks of the Preparatory Committee are to prepare:

- the legal framework
- the financial aspects
- the information technology and facilities
- the human resources and training.

a) The legal framework comprises the Rules of Procedure for the UPC and the organisation of the Registry.

It also contains Rules on legal aid, Rules on the Court fees, Rules on mediation and arbitration as well as Rules on the litigation certificate for European patent attorneys authorised to represent the parties before the UPC.

b) IT and facilities comprise the preparation of the necessary software for electronic filing and case management as well as for public online inspection. A website of the UPC Court will also be provided.

Concerning the facilities, the Preparatory Committee will formulate recommendations for the various divisions of the first instance Court concerning among other the definition of adequate Court rooms, facilities for video conferencing and recording as well as simultaneous interpretation. Recommendations will also be provided for the staff of the various divisions including their language skill.

c) Human resources and training comprise a training plan for the judges. The Advisory Committee will also be created and its members will have to be elected. The pool of judges will be organised. A regional list of judges will be created.

In addition, the list of European patent attorneys entitled to represent before the Court will be established.

A list of mediators and arbitrators will be created as well as a list of experts.

2. Rules of procedure for the Unitary Patent Court (UPC)

The fifteenth draft of Rules of Procedure has been issued on 29 April 2013 and takes into account the various comments received by the Drafting Committee and particularly the comments prepared by the *epi*.

Further comments are under final preparation by the Litigation Committee and will be sent to the Drafting Committee.

According to our information, the Preparatory Committee will take over this draft when finalised and it would be published for consultation at the beginning of June. Written comments would be possible until end of September 2013.

The Litigation Committee will file further comments if necessary during this consultation period.

Any input from *epi* members is highly welcomed.

3. The qualification certificate for representation by European patent attorneys

The Litigation Committee is preparing a draft proposal concerning the requirements for European patent attorneys to be authorised to represent before the UPC.

a) A first aspect concerning those requirements is the definition of the "appropriate qualifications" mentioned in Article 48(2) UPC. The definition of those qualifications will be particularly useful immediately after entry into force of the agreement so that European patent attorneys able to justify such qualifications will be entered on the list of European patent attorneys entitled to represent, even before entry into force of the agreement.

b) The second aspect of the requirements is the definition of the "European Patent Litigation Certificate" also mentioned as an example in Article 48(2) of the Agreement.

It will be necessary to define a curriculum as well as the amount of time to acquire such a certificate. Also important is to define the format of the certificate, whether a diploma will be required, which kind of attendance to lectures will be necessary, whether an oral examination will be appropriate, etc… The possibility of including mock trials training within the curriculum will also be examined.

At the present time, the Litigation Committee is considering a draft curriculum which could include:

- the main EU law principles
- studies on the EU directive on enforcement
- general features of the European Court of Justice including the Court of first instance
- general features of Common law
- general features of Civil law.

The Litigation Committee will also propose that the qualification certificate as such could be issued either by the CEIPI in Strasbourg or by certain local Universities in the contracting Member States and possibly by other organisations to be defined.

The proposal of the Litigation Committee, after approval by the Board, will be sent to the expert group which has been created and is responsible for the preparation of the litigation certificate.

4. Address for service for the Unitary patent

The Litigation Committee discussed the questions relating to service of revocation actions concerning future Unitary patents. In view of frequent difficulties to serve revocation actions to parties outside of Europe, it was suggested that, for revocation actions as well as for declarations for noninfringement concerning Unitary patents, the proprietor of the Unitary patent could decide, on a voluntary basis, to designate an European patent attorney as address for service.

This would simplify serving a claim and would in addition reinforce the role of European patent attorneys.

If this proposal is accepted, a corresponding specific organisation should be provided within the tasks of the EPO relating to the Unitary patent.

Report of the Online Communications Committee (OCC)

A. Virkkala (FI), Chair

Meeting with EPO March 8, 2013

The OCC met with a group of ten EPO personnel, headed up by Mr Ciaran McGinley, the Principal Director of Patent Administration. Also represented on the EPO team were specialists in software development, customer service and business development, making this a broader delegation than OCC has previously interacted with.

OCC members relayed their on-going difficulties in creating PDF documents which will be accepted by the EPO's online filing software. Particular difficulties with the Amyuni product were mentioned, including incompatibility with certain software packages. The EPO stressed that it does not require the use of Amyuni and about 50 % of the PDF documents it receives are generated using other PDF creation software. It was suggested that users ensure that they are using the latest version of Amyuni, and the EPO will endeavour to provide links to that version. The EPO will look into warning messages given by EOLF and adapt these to the actual EPO requirements for PDF.

OCC raised the lack of any option to submit post-filing documents electronically on PCT cases where the EPO is RO. The EPO does not accept documents filed through the ePCT system, nor is there any form in the online filing software for PCT cases which is equivalent to the 1038 form. The EPO is confident that they can revert with an acceptable solution on one or both fronts.

Instances have occurred where attorneys have been inappropriately removed from the EPO list of professional representatives. The EPO will check with the Legal Department as to what level of authentication should be required to remove a representative from the EPO list.

When public oral proceedings are held it was queried when the results are visible on the Register. The EPO told us that on the day of the oral decision a document should appear within the online file inspection. The Register itself is not updated until the written decision is dispatched. Procedures are being tightened to ensure that this information invariably appears on the day.

OCC indicated that on opposition and appeal files it can be extremely frustrating to locate and identify among many hundreds of documents listed in the online file inspection system, one particular document (e.g. a particular piece of prior art cited where dozens of links all bear the same description). The EPO recognises this problem, and it would appear that the same problem does not exist on their internal systems. They will look at providing a more user-friendly document listing for the public, and may do this as part of a current project to tidy up their opposition files and procedures.

In response to some other issues with current online systems, the EPO provided a preview of a prototype case management system ("CMS") on which it is currently working. This has been developed to a working prototype for PCT cases with EPO as RO, and will be expanded to cover all interactions and procedures on EP and PCT cases over the coming year, based on pilot trials.

Within the CMS system, the same case record can be accessed and managed by different "actors" or people with different roles, such as the EPO formalities and examination staff, the applicant (for the purposes of authorising representatives, etc.) and the representative and/or paralegal within a firm. Depending on the user's role, different actions will be available to different people accessing the case, and the available actions will be updated to take account of current deadlines and the prosecution status. The service will integrate with the currently available electronic mailbox and Myfiles systems.

In the context of the pilot testing of CMS, the data of the pilot users was cleaned up. In this regard, OCC members mentioned issues with unexplained (and incorrect) changes to data on their own cases. These errors are to be investigated and may have resulted from the EPO's data clean-up routines, which are being refined and error checked.

The EPO then presented a road map for their electronic products generally. There are currently pilots for the aforementioned CMS, as well as email filing of documents and web-form filings. The EPO's stated priorities for 2013 are focussed on developing the new CMS system, developing a replacement browser-based filing system, and ensuring that the EPO is in a position to handle the Unitary Patent at its end by January 2014 if needed. It is anticipated that the CMS system may be ready for users by April 2014.

The overall intention of current projects is to allow all PCT and EP procedures to be done online, and with enhanced communication with EPO staff members, and to integrate the new CMS with the Myfiles functionality. The latter system provides users with enhanced views of both individual cases and overall portfolios relative to the online register, and much of the functionality of Myfiles is already available.

One surprising aspect of the new developments is that the EPO intends to convert all patent applications on receipt, in whatever form they are received (PDF, paper, Word document attached to email, etc.) to structured, editable XML data. The days of attempting to encourage attorneys to prepare specifications in such a format are over, it seems. When a specification is converted to XML (by the EPO, for free) the file will be made accessible to the applicant free of charge. This will give the applicant and the EPO a common editable text for the patent application.

Finally, improvements are being made to the Druckexemplar and it is anticipated that this will be fully operational by September 2013. A new tool eDrex allows Examiners to edit PDF versions of the patent documents at grant. Two versions will result from such editing, one showing tracked changes and the other being a clean copy. It is currently suggested that applicants will be sent the tracked changes version as part of the 71(3) communication, with the clean copy also being available online. OCC members queried which was the legally definitive version, and the EPO said that the text of the B1 publication would be legally definitive, like it is today. OCC members were anxious to get a clarification on which version should be sent to applicants.

One of the knock-on effects of the eDrex project, and the more general push by the EPO to work with structured machine-readable data, is that hand-written amendments are to be prohibited in the not too distant future. This will not affect amendments which have previously been submitted, but we anticipate that the Office will issue a decision in the OJ requiring all amendments to be in a typed form. This does not imply the submission of fully re-typed pages, but could include typed annotations or insertions on a PDF document. OCC members emphasised that in many cases, particularly Euro-PCT cases, there is no editable electronic text available to them, and extensive or tricky amendments were often done in manuscript simply because there was no editable text available. OCC requested that consideration be given to the EPO providing conversion to XML form of existing patent applications already in prosecution.

By and large, OCC members were impressed with the degree to which the EPO personnel, led by Mr McGinley, were prepared to take on board their concerns and comments and to find solutions to problems experienced by EPI members. They were also satisfied by a stated

determination to share data and tools with users, where better data or tools were available within the EPO.

Inevitably, some of the current problems are with systems which will be retired in the next few years and these are unlikely to receive the same attention, if the EPO is going to release new tools that will solve those problems. All new systems will run in parallel with the legacy systems they are to replace for at least two years.

The CMS system, which will become the working environment for attorneys to interact with the EPO, appears useful and has much to recommend it, although OCC have only seen a video demo thus far. During the coming year *epi* Members should see pilot tests of these new systems being announced for all interested users, and the OCC will be involved in the pilot testing.

Report prepared by David Brophy

Report of the Electoral Committee

M. A. Müller (CH), Á. Vilhjálmsson (IS), H. Breiter (CH)

The last half year was a busy one: As authorised by the Council at it's Hamburg meeting in November 2012, we investigated, together with the Online Communications Committee, options for introducing remoting e-voting to the election of the Council, held every three years.

Remote e-voting

Four providers of electronic voting services were contacted (BlueKrypt, Scytl, Bigpulse, Electoral Reform Services). The best contender with respect to service offered and price turned out to be Electoral Reform Services (ERS). ERS is a UK based supplier of ballot and election services. ERS organises votes for City Councils, Banks, Charities, Law and Consulting Firms, Professional Bodies, etc., both in the UK and internationally, and is bound to confidentiality.

Vote on change of constituency in Finland and Sweden

While we were thinking about how to introduce and test remote e-voting, an unexpected opportunity arose: We were approached by *epi* members from Finland and Sweden who asked for a vote on the method of electing their council members. As you may know, in most EPC member states, the *epi* members elect their council members collectively ("unitary electorate"), but in other member states half of the Council members are elected by *epi* members from private practice and half from the other *epi* members ("non-unitary electorate"). Both Finland and Sweden were such non-unitary constituencies. The "Regulation on the establishment of the Institute" governing the *epi* (obtainable from www.patent-epi.com) allows for a change to the type of constituency, if a majority for the change is found in both groups separately, and states "*The Council shall organise a vote for this purpose if called upon to do so by at least ten electors in either category*". In accordance with these rules, the Finnish and Swedish members obtained the support required for such a request, and the Electoral Committee took on the task for organising the vote. This gave us a welcome test case for remote e-voting.

The time schedule was ambitious: The vote was requested by members from Finland and Sweden in the last days of February. The voting had to be set up in a relatively short time, i. e. in 2 weeks, in order to give the voters a time window of three weeks for voting and then again ERS and the Electoral Committee a few days to prepare the results for the Vienna Council meeting on April 20. Preparing all documents for the vote by remote e-voting and on paper in three languages was a challenge for all involved. The additional paper path for voting was kept open for this test in order to be on the safe side.

Given the question

"Are you in favour that the Finnish/Swedish members of the Institute switch to constituting a unitary electorate for the election of the Council of the Institute?"

the results of the vote are the following:

Finland results: (total vote by post 5/75 votes cast online)			
Private Practice		Other capacity (industry, govm.)	
YES	53 (96.4 % of valid vote)	YES	13 (56.5 % of valid vote)
NO	2 (3.6 % of valid vote)	NO	10 (43.5 % of valid vote)
TOTAL	55	TOTAL	23
Sweden results: (total vote by post 10/150 votes cast online)			
Private Practice		Other capacity	
YES	95 (91.3 % of valid vote)	YES	43 (81.1 % of valid vote)
NO	9 (8.7 % of valid vote)	NO	10 (18.9 % of valid vote)
TOTAL	104	TOTAL	53

(Of the 15 votes cast on paper, three were invalid because the papers returned were incomplete.)

Consequently, in both Finland and in Sweden, in the upcoming elections to Council the council memers will be elected by a unitary constituency.

What next?

Remote e-voting eliminates many of the pitfalls to which the paper vote is prone, and greatly reduces the effort for handling and counting the thousands of votes received. The goal is to have only the remote submission of votes in the future, in order to achieve a reduction of effort and cost. The Electoral Committe has been given the mandate to implement the next election to Council, in early 2014, by means of remote e-voting or paper voting. The method of voting can differ according to constituency. In remote e-voting, the material for the vote shall be sent to the members by post – it is only the casting of the vote that is done remotely. The preparations for the elections are beginning, and the Electoral Committee is in the process of deciding whether to implement remote e-voting in several or all EPC countries. Stay tuned.

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

M. Fromm, *epi* Secretariat

2013 is a special year for *epi*, as we celebrate our 35th anniversary.

We held our anniversary celebration at the end of April, in Vienna, in conjunction with our spring Council Meeting. During the celebration our President, Mr Tony Tangena, quoted: "You are never too old to set another goal or to dream a new dream." (*C.S. Lewis)*.

The *epi*'s Professional Education Committee (PEC) –formerly the PQC – is following this motto. It has set several ambitious goals for 2013.

One of the first was to update its Terms of Reference to better reflect its tasks, and to adopt a new name that mirrored its main responsibilities. It felt that its remit was not restricted to qualification but that its main focus is Education as a whole. Council approved the amended Terms of Reference and, as a result, the committee is now called "Professional Education Committee (PEC)".

Another goal for 2013 was to get involved in webinars. This field of e-learning is a very good tool to support the main goal of the PEC, to make education easily accessible for all of our 10,600 members and about 500 student members.

We are very proud to announce that Ms Kaisa Suominen, an experienced Finnish *epi* tutor, hosted the first *epi* webinar. The webinar was a supplement to a live seminar, the first of a series organised with the EP Academy.

The EP Academy kindly offered us the use of their studio for this webinar. The software is very user-friendly and participants can even join by webcam, if they wish.

The webinar passed without problems. We thank Ms Suominen for her commitment, the EP Academy for providing the virtual meeting room and the participants who made the webinar such a success.

PEC, together with the *epi* Education Team, Ms Jacqueline Kalbe and Ms Martina Fromm, will continue to organise webinars. We look forward to further interesting virtual debates.

We will keep you informed of all forthcoming events, on our website and in the next issues of *epi* Information.

A further PEC goal was to facilitate communication among *epi* tutors and *epi* students. This goal will be met by a 35th anniversary present from *epi* to all of our members – a new *epi* website!

The new website includes a forum to allow *epi* members to contact each other easily.

We have set up separate sections for our tutors and students. These sections will let participants communicate with each other, to share opinions and to discuss important issues. The student section will also make it easier to find other EQE candidates in the same city, region or country to build learning groups. Each section is only accessible by the respective group.

We hope that this forum will meet the expectations of our tutors and students, but we welcome feedback, as we constantly want to improve our service.

PEC thanks the *epi* Presidium, and *epi*'s Editorial Committee, for all their efforts in setting up the new website and including the tutors and student sections.

Unfortunately the *epi* Tutors' Meeting, scheduled for June 28, 2013, had to be postponed. We are currently working on a new date. As soon as we have set a new date, we will inform our tutors.

By the publication date of this *epi* Information, the 15th national Guidlines2DAY seminar will have been held.

We are very proud of the huge success of this seminar series. We thank the European Patent Office speakers, Mr John Beatty (Patent Procedures Management), Ms

Heli Pihlajamaa (Director Patent Law), Ms Laurence Brüning-Petit (Lawyer Patent Law), Mr Marko Schauwecker (Lawyer Patent Law), Mr Alfred Spigarelli (Director Patent Procedure Management), Mr Piotr Wierzejewski (Patent Procedures Management), Mr Jörgen Jochheim (Director a.i. Practice and Procedure) and the *epi* speakers, Ms Anette Hegner, Mr Francis Leyder, Mr Cees Mulder and Mr Derk Visser, for their commitment, and especially Cees Mulder for keeping the presentations up-to-date.

PEC is currently working on a new seminar series, to be launched this autumn. Further information will be available in the "Education and Training" section of our website (*www.patentepi.com*).

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

Overall, 2013 has started well, with several successful events. PEC is very happy that it has achieved several goals, and looks forward to interesting months to come. There are certainly new dreams to dream and further goals to achieve.

First *epi* webinar held with assistance of EP Academy

M. Holmberg (SE), Chair of PEC working group „*epi* members and paralegals"

On April 25, the first *epi* webinar was successfully held, with the kind and professional assistance from the EP Academy. The presenter Kaisa Suominen (FI) gave the presentation from her office in Finland, and there were between 10 and 20 participants. Among the participants, Paolo Rambelli, Chair of the Professional Education Committee (PEC), Martina Fromm, *epi* Education Section, and myself, Chair of the PEC working group "*epi* members and paralegals", enjoyed the presentation, and evaluated it from the perspective of the PEC. Judging from the names of the other attendees, several other countries were represented. Initially, Ms Bettina Berger from the EP Academy checked the connections, gave the participants some instructions and tips how to use the software, and introduced the speaker. Ms Kaisa Suominen then held her presentation, and also received and responded to questions from the audience, which proved that also the 2-way communication worked. The webinar was clearly successful, and proved that this is an effective and useful tool. In the PEC working group, together with the Education Section of the *epi* Secretariat, we believe that webinars will prove to be a useful tool in spreading information, and in the education activities of the *epi*. Webinars can be arranged on short notice, remove the need of travel both for speakers and participants, and offer significant cost savings for both the *epi* and the participants. Further, webinars can be used equally for urgent information, which needs to be made available for all members, and for in-depth education, where a smaller number of participants can be expected.

Technology

The technology and service of the EP Academy was of a high standard. The software made it possible to see both the presenter and the slides, side by side, which made the presentation more lively and nicer to follow. Personally, I did not have any problems with sound or picture, but I understood that one participant experienced some problems due to limited band width. We noticed that if a participant has a webcam at their side, we can see also that participant provided that the presenter/administrator gives speaking/showing rights to this person.

The software was simple and intuitive, with nice functions such as easy ways to indicate "raised hands", "applause" and "go faster"/"go slower" and emoticons. Questions could be presented to the speaker alone, or to all participants, in writing, and there was also the possibility to be heard and seen. At least in my computer, no installation was needed, the software was instantly ready to use. Overall, the technical platform exceeded my expectations.

Timing and length

We all know that the *epi* has members in different time zones, and it is difficult to find a time which is suitable for all. I, however, think that the slot chosen, 10 – 11 a.m. Central European Time, was satisfactory. The webinar lasted one hour, and I think that this is an absolute maximum. It is surprisingly more difficult to concentrate

on a presentation on the computer screen than in real life. Therefore, I think that shorter webinars would be better, perhaps dividing a subject into several shorter presentations. In such a setup, material could be emailed to the attendees, and they could be given homework. In the alternative, a webinar could be broken into subsections, opening up for questions from the audience and possibly discussions using the possibilities of the software.

Content and presentation

The webinar was planned to be a continuation of a live seminar (Pre-drafting) previously held in Bucharest. Ms Kaisa Suominen had picked a specific topic for the presentation. I think that a webinar is suitable exactly for this, making a deeper study into topics presented at a larger seminar. Participants at a seminar can then choose between different webinars if they wish to go deeper into any particular subject.

Ms Suominen is an experienced and relaxed lecturer, and she obviously feels confident and at ease also in front of the camera. She was also well versed in her subject. I'm convinced that experienced *epi* lecturers will easily adapt to the webinar setting, so finding speakers should not be any problem.

Forthcoming *epi* educational events

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

***epi* autumn tutorial 2013**

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

Further information about forthcoming educational events will be also published on our website *www.patentepi.com*

Please visit our website for news !

www.patentepi.com

epi Seminars on Unitary Patent and Unified Patent Court

M. Fromm (DE), M. Holmberg (SE), F. Leyder (BE) and P. Thomsen (CH)

With adoption of two EU Regulations and the signature of an international agreement, substantial progress has been made during the past months towards a Unitary Patent (UP) and a Unified Patent Court system (UPC). *epi* will closely follow further developments and, where appropriate, provide comments, in particular through the European Patent Practice Committee (EPPC) and the Litigation Committee (LitCom).

Taking into account that the introduction of the UP and the UPC system has the potential to considerably change the IP landscape and the working environment for European Patent Attorneys, *epi* is planning to offer a training program for its members. The training program will be organized by the Professional Education Committee (PEC) with input and help from the EPPC and LitCom. It will focus on informing our members about the new developments in order to enable them to advise their clients.

It is currently planned to have a two-step educational program.

The first step would consist of one-day seminars with detailed information about the UP and general information about the UPC system.

The second step would comprise an in-depth training on the procedure before the new UPC, probably in a two-day format.

The PEC is currently inquiring about possibilities to cooperate for the organisation of the seminars with other institutions such as national patent attorney associations, CEIPI and the EPO Academy.

Though the date when the UP will come into force is not yet clear and depends on certain future developments such as the ratification process and the action before the CJ of the EU, PEC presently intends to organise a general introductory seminar in the 4th quarter of 2013 or the 1st quarter of 2014. The first-step seminars will be held after the implementing regulations for the UP, including the fees, have been finalised, while the second-step seminars can only be held after the rules of procedure for the UPC will have been finalized.

The three *epi* Committees involved would like to assure all *epi* members that they monitor the developments and that the members will be kept informed of any educational events planned with regard to the UP and UPC system. Further details will be published on the *epi* website and in the next issues of the *epi* Information.

Online pre-examination training course by the European Patent Academy

Now entering its 3 year, the online pre-examination training course has matured into a comprehensive 6 month course. The course brings a blended e-learning offering which has over 20 hours of introductory videos, 40 in-depth articles divided into 8 topic areas. Each of these topics have support questions and review questions, which are presented in a form similar to the real examination. In-depth case studies form the final part of this course. The course is supported by a selection of experienced *epi* tutors from around Europe. These tutors will help you through a private discussion forum on eqe-online.org and clarify any queries you may have. The course is delivered on a 6 month schedule, with new content every few weeks, to bring you to completion at a managed pace. With this course from the European Patent Academy you will be better prepared for the EQE pre-examination. This material is the basis for a good understanding of the main EQE relevant topics. Participation in this online course costs €350, further information & signup can be found at
http://www.eqe-online.org/pre-exam/course/

CEIPI preparation courses for the EQE pre-examination and main examination 2014

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

A **pre-examination** will be held in 2014 for those candidates who fulfil the requirements to present themselves to the pre-examination of the EQE in 2013 (see Supplement to OJ EPO 12/2011).

The CEIPI is organising seminars in Strasbourg to help candidates in preparing themselves for that pre-examination.

The main seminar will take place from 4 to 8 November 2013. It will cover relevant topics which can be expected for the pre-examination. The seminar will give participants the opportunity to apply their knowledge in a mock examination.[1]

As a complement to this seminar, the CEIPI offers a pre-exam "Cramming Course" as a last minute opportunity to candidates wishing to improve their skills in respect of this paper. Participants will sit a paper under exam conditions, followed by a discussion of the drafted papers with the tutor. This Cramming Course will take place on 31 January 2014. For English- and German-speaking candidates, the course will be organized in Munich. For French-speaking candidates, it will be held in Paris.[2]

For all papers to the EQE **main examination** 2014 (AB, C and D), the programme starts with "Introductory Courses" in the early autumn of 2013, in a number of different cities in Europe (Strasbourg, Paris, Lyon, Copenhagen, Milan), so as to set candidates on the rails, as early as possible, in preparing themselves.

The introductory courses are followed by the "Preparatory Seminars" in November 2013 and January 2014, centrally in Strasbourg, France, which build up on the introductory courses and expand on the issues treated, as well as provide for working on a mock exam under exam conditions, which is then compared with a CEIPI "model solution".

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

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

The "Special C-Resitter" course is offered in Strasbourg.

The Cramming Course for paper C will be held in Strasbourg for English- and German-speaking candidates and in Paris for French-speaking candidates.

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

The program is as follows (more extensive information is contained in OJ EPO 4/2013):

"Introductory Courses" 2013:

Paper	Milan (EN)	Copenhagen (EN)	Paris (FR)	Lyon (FR)	Strasbourg (EN, DE)	Paris (EN)
AB	20./21.09.	04./05.10.	04.10.		21.09.	04.10.
C	27./28.09.	27./28.09.	05.10.		20.09.	05.10.
D	04./05.10.	11./12.10.	06./07.09.	13./14.09.	18./19.09.	02./03.10.

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

Closing date for enrolment is 19 July 2013.

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

„Preparatory Seminars" 2013/2014:

The AB seminar will be held in Strasbourg, from 25 to 27 (am) November 2013, the C seminar from 27 (pm) to 29 (pm) November 2013. Both parts can be booked separately.

The D seminar will be held in Strasbourg, from 6 to 10 January 2014. In case of a large number of enrolments, it

1 The course fee is EUR 1 400. Closing date for enrolment is 27 September 2013. More information can be obtained from christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

2 The course fee is EUR 500. Closing date for enrolment is 3 January 2014. More information can be obtained from christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

is possible that an additional, second seminar will take place, from 20 to 24 January 2014. All these seminars are intended for those who wish to sit the EQE main examination in 2014.[3]

The "Special C-Resitter" course 2013 will be held in Strasbourg on 22 and 23 November 2013.[4]

3 The fee is EUR 1 400 for the five-day courses (ABC or D); for the AB or C part on its own the fee is EUR 725.
Closing date for enrolment is 27 September 2013.
More information can be obtained from christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

4 The course fee is EUR 850. The price includes the „C-Book", 4th edition.
Closing date for enrolment is 1st October 2013.
More information can be obtained from sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

The "Cramming" course 2014 for paper C will be held in Strasbourg (EN, DE) on 30 and 31 January 2014 and in Paris (FR) on 1 February 2014.[5]

Contact: Christiane Melz, Secretariat of the International Section of CEIPI, for any information on the above courses.
telephone 0033 368 858313
or mail to: *christiane.melz@ceipi.edu*

5 The fee for the Strasbourg course is EUR 650, for the Paris course EUR 500.
Closing date for enrolment is 3 January 2014.
More information can be obtained from sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

Next Board and Council Meetings

Board Meetings

89th Board meeting on 28 September 2013 in Riga (LV)
91th Board meeting on 27 September 2014 in Zagreb (HR)

Council Meetings

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

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):

European Patent Office
Dir. 5.2.3
Legal Division
80298 Munich
Germany

Tel.: +49 (0)89 2399-5231
Fax: +49 (0)89 2399-5148
legaldivision@epo.org
www.epo.org

Thank you for your cooperation.

Nächste Ausgaben · Forthcoming issues · Prochaine éditions

Issue	Deadline	Publication
3/2013	August 9, 2013	September 30, 2013
4/2013	November 4, 2013	December 30, 2013

News concerning *epi* Council,Board and Committees

Board

Micaela Modiano (IT) resigned

Paolo Rambelli (IT) was elected Board member for Italy

Disciplinary Committee (*epi*)

The Chairman, Mr Paul Rosenich, appointed

Ms Nicole VAN DER LAAN as Registrar to the Disciplinary Committee and Ms Vernesssa PRÖLL as deputy Registrar.

Professional Education Committee (PEC)

Mr Jozef Kertész (SK) resigned from PEC

By-Laws Committee

At the occasion of the C 74 meeting in Vienna new members have been elected and announced:

Full Members:	**Substitute Members:**
Pascal Moutard (FR) Chair	Martin Forsthuber (AT)
Terry Johnson (GB)	Sylvain Le Vaguérèse (FR)
Paolo Gerli (IT)	Dieter Speiser (DE)
Günther Schmalz (MC)	
Associate members:	Francis Leyder; Carl Eder.

Litigation Committee

Stephen Murnaghan(IE) resigned and
TrionaWalshe (IE)substitutes

Electoral Committee

At the occasion of the C 74 meeting in Vienna the following members have been elected for a new 3-year term:
Markus Muller (CH), Chair
Árni Vilhjálmsson (IS)
Heinz Breiter (CH)

The *epi* from its Foundation to the Present Time

D. Speiser (DE)

M. le President,
Herr President,
ladies and gentlemen,
dear colleagues,

we have come together today from 38 European countries to celebrate the 35th anniversary of the Institute of Representatives before the European Patent Office known as the *epi* and to celebrate a story of success. As one of those who participated a bit in giving birth to the Institute in 1978 I was asked to give a speech on "the *epi* from its foundation to the present time".

So, I began to think about this topic and noted that in 1978 we started the *epi* from scratch, immediately set up quite a number of committees, and invested during the next 35 years an extreme number of precious hours of dedicated attorneys for deliberations in the committees, in our Board and in Council on numerous topics. In this way and up to the present time the Institute acquired a pretty good standing within the patent community. Why? Because over a period of 35 years many excellent professionals from all contracting states in Europe at numerous occasions and for numerous reasons had done and communicated a marvellous job to its members, our Board and Council, to the European Patent Office, the Administrative Council of the European Patent Organisation, to WIPO and the European Commission.

I could now start to prove my assessment with the help of numerous examples but my concern was that I would bore you ahead of time. Even worse, mentioning names and inadvertently omitting others would deprive the latter of what they deserve.

So I used my patent attorney's skills and focused on the true meaning of the term "foundation". You will agree that laying a foundation is but the first step of many following ones before you can move into a new building. Therefore, wouldn't it be more interesting to shed some light on the circumstances which finally resulted in the establishment of the *epi*?

At the inaugural meeting of the *epi* on the 8th of April 1978 Mr. van Benthem from the Netherlands, the first President of the European Patent Office welcomed the

attendants of the meeting with the following statement: "The establishment of the new Institute was a historic occasion and an even more noteworthy achievement when one considers that the new institute brought together in a single, independent body the patent professionals of the various contracting states, each with its own tradition".

Indeed, our 1st meeting was a historic event and a historic achievement. Up until then national patent attorneys had their national institutes such as the CIPA in the UK, the Patentanwaltskammer in Germany, the Ordre in the Netherlands, the Compagnie Nationale in France, and many more all over the world. All these entities had their individual statutes, by-laws, codes of conduct etc. Some had a forced membership but mainly membership was voluntary. Usually one could call them "special interest groups" vis a vis their respective societies and governments.

Internationally, there were a few associations founded by patent professionals to enhance international cooperation between their members, to maintain their dignity, to study problems relating to the protection of intellectual property and to the profession of the members, to express experts' opinions on new national and international legislation etc. It should be noted that all these international associations were fully independent. Partly they had common interests but beyond that were focused on different subjects. The important ones were the Federation or FICPI, CNIPA (Committee of National Institutes of Patent Agents), UNION of EPA and FEMIPI (European Federation of Agents of Industry in IP).

Under these circumstances, the establishment of our Institute did not just happen out of the blue. Over a very long period of time politicians and experts considered ways of setting up a European Patent without considering details of representation. Nevertheless, we wouldn't have a European Institute without those considerations about a European Patent. This means that the roots of our Institute are linked to the development of the patent system in Europe.

Bearing this in mind, the longest rootlet I was able to locate can be traced back over 97 years from now until the middle of the Great War, namely until 1916 when a proposal was made in public to unify the various European patent systems. Obviously, it was not the time to come together and change legal systems.

But already in 1919 France invited the Allied Nations to set up a Central Patent Office. An agreement was signed but never entered into force. Shortly thereafter an Empire Conference in London suggested the establishment of a British Empire Patent but failed.

The next approach towards a unified system was made at the occasion of the London conference in 1932 and even during the Second World War in 1942 it was suggested to change national patent systems with the aim of unification. None of these proposals where successful and where forgotten relatively quickly.

Then, in September 1949, just 4 years after the war French Senator Henri Longchambon submitted a paper at a meeting of the just founded Council of Europe proposing to create a European Patent Office with the task to issue European Inventor's Certificates. This plan was found to be too complex and for that reason was not supported. However, and in retrospect it marked the beginning of the work on a common European patent law. In my view Senator Longchambon is the person who laid the foundation not only for our present patent system in Europe but also the foundation of our Institute. The process towards the new system was slow at the beginning but it gained momentum over the years.

As part of the process a small group of patent minded experts and delegates from a number of European countries came together under the roof of the Council of Europe to resume and intensify considerations regarding a European patent system. Their work was concentrated during the years of 1951 to 1954 in the Committee of Experts in patent matters of the Council of Europe and resulted in two Patent related conventions, namely the European Convention relating to the formalities required for patent applications and the European Convention on the International Classification of Patents. Three of the 4 European associations which I mentioned above had official observer status and participated in the deliberations. Representation was not yet a topic.

During that period a number of plans were discussed in the Committee of Experts which plans had come on the table with the aim of unifying the patent system in Europe or – as an intermediary measure – to approach a European patent office stepwise.

One has to bear in mind that those were the years after horrible WW II when "Europe" had come into vogue and the work towards the European Economic Community was well under way resulting in the Treaty of Rome in 1957.

Fully in line with the mainstream trend experts from a number of European countries remained hooked on the idea of a European patent system. Some of these experts drafted complete plans for the unification of the systems and/or for a common European Patent, some of them were Dutch, namely Mr. de Haan and Dr.Was, others came from Germany, namely Prof. Reimer and Dr. Härtel; both in fact proposed two plans. And at that time even a plan for a Scandinavian Patent Community became known.

Representation in those early years of the process did not have a high priority. Harmonizing legal issues such as the question of a common patent or others such as novelty, inventiveness, duration, inventors rights, the huge number of procedural matters, financial issues and very many more were being discussed in Europe.

Understandably, Mr. Härtel in a study on fundamental problems necessary to be overcome on the way towards a common EEC patent mentions in July 1960 that the question of representation before the EPO neither concerns an urgent issue nor addresses an insolvable problem.

According to said study a decision will be needed on either voluntary or forced representation before the EPO. Further, the question will have to be answered whether those persons admitted to represent in their own country

should be admitted to represent before the EPO or whether only a selected number of those persons should be permitted to represent before the EPO. The other question of how to organize the professionals was not even touched.

The various plans for a European patent and/ or patent system which I mentioned show us – at least retrospectively – that over the years since Senator Longchambon addressed the Council of Europe a number of distinguished IP experts in Europe kept the pot boiling. They were so deeply convinced of their vision that they did not give up.

Mr. Härtel is a good example. Two years after publishing his study on fundamental problems and after an agreement on fundamentals had been reached within the EEC a working group chaired by him submitted at the end of 1962 a first proposal for a common EEC patent. It was discussed with the interested circles and served as a basis for a second draft.

Before viewing the fate of the second draft we have to take a look at our own profession:

In 1961 the patent attorneys whose international associations had supported the architects of the legal system began to look at their own interests whereupon a number of patent attorneys from European countries founded the UNION of EPA for the specific purpose of providing an adequate representation of European patent agents; they wanted to take an active part in the new economic and legal orientation of Europe. Mr. Härtel with regard to representation in 1960 had pointed into the future but it took our profession just one year to set a milestone in the name of UNION.

The establishment of this association seems to have motivated an increasing number of patent attorneys in Europe to look into their professional future under a European patent and this in turn triggered the national professional organizations all over Europe to exchange views about a European Patent attorneys organization representing all or as many as possible of the European practitioners.

It was in this situation that the President of the UNION convened a meeting of delegates from the national associations and institutes of the 12 countries adhering to the Council of Europe to discuss ways and means for providing what could be considered to be an adequate representation of patent agents practicing in these countries. This meeting became known as the Round Table Conference or RTC for short. It took place on the 27th May 1965 in Fredensborg, Denmark and can be called the second milestone with only 13 years left until the birth of our Institute. Further RTC meetings in 1965 took place in Torino and London.

At these meetings there was a tendency among the delegates towards the creation of another international organisation in addition to FICPI, CNIPA, and UNION. It's precise competence, constitution and functions remained under consideration. This new organisation for which a few different names where mentioned such as "International Chamber of patent agents" was frequently also called the "Institute of the Institutes". Due to its construction as an amalgamation of the three existing associations this new Institute would include as members both individuals and national institutes and both patent attorneys from industry and from the free profession. However, it became visible already at that early stage that different opinions existed in Europe about the admission of Company Agents.

The round table meetings were not the only events of interest for the profession in 1965. There was a memorandum submitted in the course of this year by the Patentanwaltskammer suggesting an amalgamation of FICPI and UNION and explaining in greater detail the reasons why a merger of these two groups would further the position of patent agents in Europe. Another memorandum was distributed in 1965 by our Danish colleague P.O. Langballe who focused on the same merger and particularly addressed what he called the almost insurmountable obstacle to the reconciliation of the French and British Doctrines, namely the different views on a coexistent membership of company agents and free agents. None of the various proposals for a merger was successful.

So, at this point in time delegates of the RTC and the Institutes had seriously discussed only the need for a merger of existing associations or for a new Institute to meet the potential demands of a unified patent system in Europe. They had not even agreed on the kind of membership they would accept and it appears that important questions remained untouched such as voluntary or forced membership or the extent of the education of the members beyond patents or whether the passing of a professional examination should be a requirement.

Outside our professional bodies the efforts towards a unitary EEC patent continued and at the beginning of 1965 the EEC working group completed its second draft convention on a unitary European patent. It was never published and failed in mid 1965 not for lack of agreement on the drafted system but for political reasons; the EEC member states could not agree on whether the new patent system would be open only for the 6 EEC countries or also for non EEC countries such as the UK; France was decidedly against that.

This brought the work within the EEC for the intended patent to a temporary halt.

Not so within the EFTA group of European countries. They started to work in Mai 1965 and in 1967 submitted a first draft of an "Open European Patent Convention Forming the First Convention in a Two-Part-Scheme". Their proposal even included in Articles 171 to 173 provisions regarding Professional Patent Agents. According to Article 171 they were entitled to represent only if their names appeared on an official list. In order to have their name entered on the list they had to provide a certificate of their national IP office proving that they were entitled to represent nationally. If in their home country there was no requirement of a special professional qualification they further needed a certificate specifying that they had habitually acted as a patent agent in their country for at least 5 years. No distinction

was made between company agents and free professionals and no institute is mentioned.

From our professional perspective this was a proposal reaching far beyond the considerations of our Institutes. But the EFTA draft Convention contained a much more futuristic proposal in that it suggested as step one of a two step proposal to limit the task of the EPO to the examination and granting of bundle patents requiring validation at the national stage.

For about two years Europe remained silent on the topic and some people were of the view that the European patent was dead.

But early in 1969 once again the French took the initiative. At a meeting of the Council of the European Communities they suggested to resume preparations for a European patent along the lines of the first step of the EFTA draft convention. As you will see, this initiative resulted in a great breakthrough.

Already in May 1969 an Inter-Governmental Conference was convened in Luxemburg. 21 European countries participated and their intensive work was based among other proposals on the EFTA draft Convention. Four of the European professional associations had observer status at the conference, namely the FICPI, the UNION, the CNIPA and the FEMIPI. Representation was an issue and the four associations contributed to the extent possible.

At the end of their working sessions in June 1972 the Conference handed over to the governments of the 21 participating countries a draft convention on the grant of European patents, a draft containing the implementing regulations, a draft of three protocols and two recommendations. Further, they suggested that a Diplomatic Conference be held with the task of accepting the drafts. Since the proceedings at the Diplomatic Conference was not governed by EEC law a 2/3rd majority was sufficient for acceptance. For this reason the participants were optimistically expecting a successful conclusion. And they were right.

For dealing with matters of representation the Luxemburg Conference seems to have had a sub-committee. It developed the respective provisions of the EFTA draft and recommended in Art. 133 of the draft convention that

a) representation may only be undertaken by professional representatives whose names appear on a list and
b) that in order to get on the list the representative must have passed the European qualifying examination

Thus, unlike under the EFTA draft, national qualifications should not be considered. And in addition to EFTA the newly proposed Administrative Council of the European Patent Organisation was to have the authority to adopt provisions governing

(1) the qualifications and training required of a person for admission to the EQE
(2) the conduct of the EQE
(3) the establishment or recognition of an Institute of representatives and
(4) any disciplinary power to be exercised by that Institute or the EPO

It was foreseen, that the Administrative Council would have to adopt these provisions by a three-quarters majority.

Transitional provisions were included such as the so called Grandfather Clause in Art. 163 EPC, now part of Art. 134. According thereto and for a period of 1 year after the accession of a new member state to the Convention a person can be entered on the list without having passed the EQE provided that this person has a special national qualification or can prove that it has acted as a representative in patent matters in its country for at least 5 years.

The Munich Diplomatic Conference which had been recommended by the Luxemburg Conference took place from the 10th of September 1973 until the 5th of October. Within less than one month and after having dealt with over 100 requests for amendment the EPC was ready for execution. 16 of the 21 countries participating in the Munich Conference signed the Convention immediately, namely CH, BE, DK, DE, FR, GR, IR, IT, LI, LU, MC, NL, NO, AT, SE, and UK.

Following a respective recommendation of the Munich Conference an Interim Committee was set up in January 1974 to prepare everything necessary for opening the EPO such as its organization, staff, finances, legal services, office building etc and last but not least representation. In fact, one of the early actions of the Interim Committee was to invite in April 1974 the four professional organizations FICPI, CNIPA, UNION and FEMIPI to submit proposals in particular as to

–the Institute and its statute
–the Code of Ethics and
–qualification, training and EQE.

The Interim Committee had expressed a certain urgency of the matter and so the organisations reacted quickly. They agreed to work together under the name of "Group of Four" in the form of joint meetings to collect the views from all participants and to try to reach a common understanding.

When the discussions of the Group of Four started the opinions expressed by the delegates on the topics under consideration varied considerably. Minutes and memos related to the discussions tell us, however, that the delegates were interested in finding solutions acceptable to everybody or at least to a majority. The results of the discussions were passed on to the Interim Committee which in turn used the results to prepare the necessary papers for the Administrative Council for decision.

I cannot possibly go into the details of the discussions within the Group of Four. The group spent many working days before the work was done. Thus, I will pick just a few topics.

–Shall there be a new organisation or shall the UNION be transformed to take over?
–Shall there be a compulsory membership?
–What are the objects of the Institute
–organisation of the Institute including council, board, and general assembly

–elections, one vote per country or a number of votes depending on the number of national representatives or the number of national patent applications per country
–Disciplinary Tribunal as part of the Institute and its powers
–applicability of the Code of Conduct for the free profession only?
–Combining national and European qualifying examinations?
–Scope of the examination: just EPC? or Paris Convention and PCT and national laws additionally?
–Written examination only or a combination of written and oral examinations?
Obviously, many hundreds of topics and subtopics had to be discussed and where discussed successfully so that the Interim Committee could finish its work in time for the Administrative Council. This Council held its first meeting in October 1977 at which the Regulation on the establishment of an Institute of professional representatives before the European Patent Office known as the "Founding Regulation" was adopted. This regulation which is necessarily based on Article 134 of the EPC not only establishes the Institute but contains all the major rules pertaining to the Institute such as the legal status, the objects, membership, subscriptions, Council, Board etc. None of these rules are in contradiction to what the Group of Four had suggested. This is certainly something to be proud of.

Now, there was an Institute and since December 1977 there was an official List of Representatives. What was needed next was the first Council of the Institute. The first elections for a term of one year were organized according to transitional provisions contained in the Founding Regulation of 1977 either by a national association or by the EPO. And under the transitional provisions the EPO was further obliged to convene the first meeting of the first Council. Before this could take place and in fact prior to the first elections the Group of Four was asked for input on the organization of the first meeting.

This is when I entered the picture. I had been part of the Group of Four as a relatively new German delegate of CNIPA and, therefore, had come too late to be involved in the deliberations mentioned above. I remember at least one joint meeting of the Group in Amsterdam and a discussion on the seating arrangement we wanted to propose for the first Council meeting. A lady from a country I won't mention and whose name I also want to keep for myself expressed the view that free professional members and employed members should not sit next to each other. In fact, she emphasized that she would certainly not even take a seat at a table where a colleague from the other group sat. I don't remember for sure how we solved this particular problem but I assume that we distributed the seats country by country and left it to the delegates to sit as they wanted. An arrangement we have now been using in Council for 35 years.

Then, on 8th of April 1978 I was one of the 44 full Council members from the seven contracting states who took their seats in the conference room of the Munich Penta hotel which is now known as the Holiday Inn Hotel adjacent RosenheimerStraße. In addition, all our 44 substitute members and 8 invited guests from Sweden attended.

Mr. van Benthem (NL), the first president of the EPO opened the inaugural meeting with an encouraging opening address the first part of which I recited at the beginning. He then emphasized that the Institute and the EPO will share two tasks, namely examination and disciplinary matters. Apart there from the Institute would be completely independent. He was convinced that the Institute was going to be an important partner of the EPO and would exert a substantial influence on the development of the European patent system. All these forecasts became true over the years as I indicated above. And the intense work performed over the years is the reason for the remarkable professional success of the *epi*.

At the inaugural meeting a lot of administrative business followed such as elections of the Board, appointments of committees, budget and subscription, a decision on the seat of the Institute. And when the meeting was closed on Sunday, the 9th of April we left with the feeling that participating in the future work of the Institute would become an intellectually highly rewarding task. This it did. But we could also observe while the years passed by that despite the many different traditions within Council, seven at the beginning and 38 today, the social relationships between members developed favorably, we learned to understand the value of traditions from other countries, trust was built up and – at least in my view – national interests which seemed to dominate in the very early years are increasingly replaced by common interests.

Let me close by giving an example of one of the other important achievements: It is the elimination of the friction and distrust originally existing in some countries between the groups of employed and free professional members. I told you about the lady who – 35 years ago – did not want to sit next to someone from the "other" group. These days the professional background is hardly ever noticed. Even more, in some countries members have begun to consider merging the two groups thereby terminating the artificial differences. We will learn more about this tomorrow and I am very much looking forward to it.

Thank you for your patience.

The most important decisions of the EUEJ in patent matters

H.-P. Brack (DE)

Abstract: In this paper, the CJEU case C-34/10[1] is discussed, starting from the earlier national first instance in the patent nullity proceedings at the German Federal Patent Court to the subsequent appeal to the German Federal Court of Justice (BGH) and then to the referral to the CJEU. In particular the Opinion of the Advocate General and the subsequent Ruling of the CJEU and the decision of the BGH are discussed and contrasted.

An interesting aspect of this case is that it concerns the effects of Community law (a directive) on a national patent, national patent law, and patent nullity proceedings in Germany. As will be discussed, the results of this CJEU decision may have effects well beyond the EU due to its potential influence on EPO practice and the interpretation of R. 26 – 29 EPC. The CJEU interestingly also makes reference to EPO BoA case law in its decision. Therefore this case is particularly fascinating in that it concerns numerous interactions and influences between national law in the EU, Community law and international pan-European law (the EPC).

Although the CJEU ruling in C-34/10 will likely not please everyone – particularly some in the biotech industry or the related patent profession have been critical, it has provided important legal certainty to several questions. It has clarified in the particular area of embryonic stem cell technology what is patentable in the EU – perhaps not so much – and what is not patentable – apparently quite a lot. However this result is perhaps not so unexpected or unreasonable. The CJEU ruling has placed greater emphasis and priority on fundamental basic rights such as the right to life and human dignity, as opposed to industrial property rights such as patents. Furthermore in this balancing of these rights, the CJEU has arguably struck the right balance by being careful to stay on the side of broader basic rights protection at the expense of narrower industrial property rights protection. Finally the subsequent ruling in the original case by the BGH and prospects for future patent practice in light of this important decision are discussed, as well as some few areas of unfortunately remaining legal uncertainty.

Oliver Brüstle v Greenpeace e.V. CJEU Case (Case C-34/10)

A DE 197 56 864 C1 And Its Prosecution History

A.i. Grant of DE 197 56 864 C1 and its disclosure and invention

The German patent in the present case, C-34/10, is DE 197 56 864 C1 filed on 19.12.97 and granted on 29.04.1999. No opposition was filed within the statutory period following publication of the mention of grant.

According to the patent specification of DE '864 C1, transplantation of neural cells into the nervous systems of mammals represents a promising method for the treatment of numerous neurological diseases. In order to remedy such defects in a mature nervous system it is necessary to transplant immature precursor cells, typically derived from several embryo brains. This creates enormous ethical problems and it is simply not currently possible to meet the need for precursor cells for the treatment of large numbers of patients.

According to the specification, embryonic stem cells (ES) offer entirely new prospects for the generation of donor cells for transplantation. It is stated that their key advantage is their ability to multiply over long time periods in an undifferentiated, pluripotent stage in which they maintain their capability to differentiate into all types of tissue, including neural tissue.

Among other aspects, the invention disclosed and claimed in DE '864 C1 allegedly solves the technical problem of providing isolated, purified non-tumorigenic ES-derived precursor cells with neuronal or glial properties, as well as methods for their large-scale production.

The granted patent DE '864 C1 has three independent claims, claim 1 to the isolated, purified precursor cells with neuronal or glial properties from embryonic stem cells and claims 12 and 16 to the process to prepare purified precursor cells with neuronal or glial properties. Dependent claims 7 and 8 claimed isolated cells of various types including human cells.

A.ii. Patent nullity trial of DE 197 56 864 C1 at the German Federal Patent Court

In 2004, Greenpeace filed a claim for nullity of the patent DE '864 C1 at the German Federal Patent Court (Bundespatentgericht). The Court rules as a court of first instance in actions for a declaration of patent nullity [German patent law (PatG) Arts. 21 and 22], as in this case.

A.ii.a. Arguments of claimant Greenpeace in patent nullity trial

Greenpeace requested that claim 1 as far as it concerned cells obtained from human embryonic stem cells, claim 8 as far as it concerns human cells, and claims 12 and 16 as far as they concern cells obtained from human embryonic stem cells, all be declared invalid. The legal basis provided for this request was the exception to patentability for inventions whose commercial exploitation would be contrary to public policy and morality according to Para. 2 Nr. 1 of the PatG. Greenpeace argued that the harvesting of human embryonic stem cells required the destruction of blastocysts (early stage embryos). They further argued that such acts would be against the rights

1 Judgement of 18.10.2011, Case C-34/10.

to human dignity and life, as constitutionally guarantied by the Art. 1, Para.1 and Art. 2 Para. 2, Sentence 1, of the German Basic Law (Grundgesetz, GG).

Greenpeace argued that it was clear that such rights in the Basic Law extended also to human embryos in accordance with the German Embryo Protection Act of 1990 (ESchG)[2]. The ESchG essentially forbids all forms of embryo stem cell research because it mandates that the use of embryos "for any other purpose not serving its preservation" will be punished with imprisonment. Greenpeace further argued that "public policy and morality" should be understood according to the Directive on the legal protection of biotechnological inventions in Germany of 21.01.2005 (BioPatG)[3], in which Germany implemented the EU Biotechnology Directive 98/44/EC, and the German Stem Cell Act of 28.06.2002 (StZG)[4]. According to the StZG, the import and use of embryonic stem (ES) cells are prohibited in principle, but it allows some exceptions if the lines were extracted from surplus embryos from *in vitro* fertilisations abroad before a particular cut-off date under certain very specific conditions. In addition, research projects dealing with these ES cells are only to be permitted on a case by case basis under an administrative proceeding.

The legal basis provided for this request by Greenpeace was the exception to patentability for inventions whose commercial exploitation would be contrary to public policy and morality according to Para. 2 Nr. 1 of the PatG, which entered into force on 28.02.2005. It is noted that this provision was identical to that of the earlier version of the law as amended in 1999. However the amendment of the patent law in 2005 also added paragraph 2 which provided specific exceptions to patentability, similar to R.28 EPC 2000.

A.ii.b. Arguments of PatenteeBrüstle in patent nullity trial

The patentee defendant, Brüstle, requested that the claim to invalidate its patent be dismissed, and in addition auxiliary requests were filed in which the patent claims 1, 12, and 16 were limited to precursor cells obtained from pluripotent embryonic stem cells (Auxiliary Request 1) or stem cells existing as embryonic stem cell lines (Auxiliary Request 2).

Furthermore the patentee argued that the invention concerned precursor cells obtained from pluripotent embryonic stem cells and that such stem cells were not equivalent to embryos according to the Art. 8, para.1 of the ESchG of 1990. It was further argued that the patent claims were not directed to the industrial or commercial uses of human embryos as excluded from patentability by the revised PatG from 2005. The argument was made that the first method step of the patent claims concerned much more the cultivation of pluripotent embryonic stem cells to embroidal bodies, and that the fact that this could include the possibility that human embryos might have been used in an earlier and unclaimed step was no reason to consider that the invention as claimed was contrary to public policy or morality. Further the patentee argued that it could not be in contradiction with public policy to have applications of embryonic stem cells that were explicitly allowed by public policy in various compliant research projects funded at the national and EU level. An additional argument provided was that the technology existed to harvest embryonic stem cells without destroying human embryos. For these reasons, the patentee argued that surely all of these various allowed applications could not be in contradiction with public policy and morality.

A.ii.c. Decision of the German Federal Patent Court in the patent invalidation trial

In its decision 3 Ni 42/04[5] of 05.12.2006, the German Federal Patent Court allowed in part the application made by Greenpeace and declared the patent filed by Mr Brüstle invalid in so far the first claim relates to precursor cells obtained from human embryonic stem cells and the twelfth and sixteenth claims relate to processes for the production of precursor cells. The legal basis provided for this decision was Art. 22, para.1 and Art. 21, para.1, Nr. 1 of PatG in view of Art. 2, para.1 and para. 2, sent. 1, Nr. 3 of PatG, as revised on 21.01.2005.

The court indicated in reason II.2 of its decision that this nullity ground was more concerned with the commercial exploitation of the invention after grant of the patent. For this reason, the Court held that the provisions of the revised German patent law from 2005 were operable for the present proceedings. In point II.3 the Court stated that even if one were to consider that the applicable law for deciding on the nullity of the patent was the law in effect during the time of the granting procedures it would have no effect on the outcome of its decision. For example, the exceptions to patentability provided under Directive 98/44/EC and the ESchG of 1990 should have been taken into account by the German Patent Office in their interpretation of the earlier exceptions to patentability under Art. 2 Nr. 1 of the PatG in effect at the time of grant (29.04.1999) of the patent in question.

The Court also did not agree with the patentee's contention that the use of human embryos in obtaining the claimed precursor cells using the claimed methods was just a hypothetical possibility. The Court stated that claim 8 together with the description of the contested patent made clear that human embryos were the precursor intended by the claimed invention.

Concerning the patentee's contention that there existed numerous alternative methods to obtain human embryonic stem cells without destroying blastocysts, the

2 Gesetz zum Schutz von Embryonen (Embryonenschutzgesetz – ESchG), 13.12.1990.

3 see, for example, F.-J. Zimmer and S. Sethmann, Act implementing the Directive on the legal protection of biotechnological inventions in Germany (BioPatG), available on-line, accessed 25.05.2012, at <*http://www.grunecker.de/download/publications/biorili.pdf*>.

4 Gesetz zur Sicherstellung des Embryonenschutzes im Zusammenhang mit Einfuhr und Verwendung menschlicher embryonaler Stammzellen (Stammzellgesetz – StZG).

5 (a) Bundespatentgericht Urteil 3 Ni 42/04 in der Patentnichtigkeitssache; see also (b) Deutschland –Teilnichtigkeit eines Patents für embryonale Stammzellen, GRUR Int 2007, 88.

Court found this argument irrelevant despite the fact that such stem cells might possibly have equivalent potency. According to the Court, such alternative methods were per se excluded by the definition of "precursor cells from human embryonic cells" according to the contested patent, and thus they were out of the scope of the nullity decision.

The Court also indicated that they were unconvinced by arguments from the patentee concerning distinctions between totipotent as opposed to pluripotent stem cells in terms of their ability or lack thereof to develop into an entire organism such as a human being, or between embryonic stem cells and stem cell lines. The reasoning provided was that on the application date of the patent it had been necessary to have originally destroyed an embryo at some point anyways in the entire method to produce precursor cells in all of these cases. Furthermore the Court reasoned that the method to produce a product comprised all of the activities – from the very beginning – concerned with the creation of the product. Related to this point the Court found that the contested patent also did not disclose any method alternative to harvesting stem cells from blastocysts, thus necessitating their destruction.

Quite importantly the Court reasoned that it was necessary to interpret the provisions of Art. 2, Para. 1, first sentence of the PatG of 2005 quite broadly in accordance with the embryo protection act (ESchG), which explicitly and broadly forbids the creation of human embryos for research purposes and all applications of human embryos that were not concerned with preserving the life of the embryo and being of use to it. According to the Court this then included the forbidding of applications concerned with obtaining totipotent or pluripotent stem cells from human embryos. Similarly the Court reasoned that the provisions of the European Directive providing for non-patentability of uses of human embryos for industrial or commercial purposes should also be interpreted broadly so that exceptions and patentability should be strictly limited to those inventions for therapeutic or diagnostic purposes which are *applied to the same individual (donor) embryo* and are useful to it.

Additionally, the Court expressed the opinion that the legislators had put very strict requirements in StZG on the limited allowance for the importation and use of stem cells from cell lines existing before 01.01.2002 for research purposes. Therefore the Court dismissed the patentee's arguments that the StZG might therefore somehow provide a quasi "automatic" allowance for patentability of uses of human embryos for commercial purposes, particularly for those related to research. On this point, the Court stated that the constitutionally-guaranteed fundamental right to human dignity of human embryos did not allow for a differentiation to be made between an embryo's origin (domestic vs. foreign) or based on the date of their use in harvesting embryonal stem cells.

The request of Greenpeace for a declaration of nullity was disallowed however as far as claim 1 related to precursor cells and claims 12 and 16 related to methods for preparing precursor cells from primordial germ cells. Such cells and methods were indicated as being patentable in the Court's decision. The reasoning of the Court was that such primordial germ cells are obtained from human fetuses miscarried within a few weeks after fertilization of the egg, and therefore they did not necessitate the (intentional) destruction of blastocysts or human embryos. Therefore according to the Court such primordial germ cells did not fall within the scope of the definition of the human embryo provided by Art. 8 of ESchG.

A.iii. Appeal of decision in patent nullity proceedings to the Federal Court of Justice

Prof. Brüstle appealed against the above first instance decision of the Federal Patent Court to the Federal Court of Justice (BGH). The patentee requested that the entire declaration of nullity be set aside. In addition, amended claims were filed as auxiliary requests.

In this case (XaZR 58/07)[6], the BGH considered that the outcome of its proceedings depended on the interpretation of certain provisions of Directive 98/44/EC. In accordance with Art. 267 of the Treaty on the Functioning of the European Union[7], the BGH decided on 17.12.2009 to refer the following questions to the Court of Justice of the European Union (CJEU), and on 26.01.2010 proceedings at the BGH were stayed [6,8].

Questions referred:

What is meant by the term 'human embryos' in Article 6(2)(c) of Directive 98/44/EC?

(a) Does it include all stages of the development of human life, beginning with the fertilisation of the ovum, or must further requirements, such as the attainment of a certain stage of development, be satisfied?

(b) Are the following organisms also included:

  (1) unfertilised human ova into which a cell nucleus from a mature human cell has been transplanted;

  (2) unfertilised human ova whose division and further development have been stimulated by parthenogenesis?

(c) Are stem cells obtained from human embryos at the blastocyst stage also included?

What is meant by the expression 'uses of human embryos for industrial or commercial purposes'? Does it include any commercial exploitation within the meaning of Article 6(1) of the Directive, especially use for the purposes of scientific research?

6 Bundesgerichtshof Beschluss 17.12.2009, XaZR 58/07.

7 Consolidated Version Of The Treaty On The Functioning Of The European Union, O.J.E.U. C 115/47, 09.05.2008.

8 Reference for a preliminary ruling from the Bundesgerichtshof (Germany) lodged on 21.01.2010 – Prof. Dr.Oliver Brüstle v. Greenpeace e.V. (Case C-34/10).

Is a technical teaching to be considered unpatentable pursuant to Article 6(2)(c) of the Directive even if the use of human embryos does not form part of the technical teaching claimed with the patent, but is a necessary precondition for the application of that teaching,

(a) because the patent concerns a product whose production necessitates the prior destruction of human embryos,

(b) or because the patent concerns a process for which such a product is needed as base material?

B.i. Opinion Of The Advocate General (CJEU)

On 10.03.2011 the Opinion of the Advocate General (AG) was delivered in case C-34/10[9]. In his conclusion, the AG proposed that the Court give the answer that Article 6(2)(c) of Directive 98/44/EC must be interpreted such that the concept of a human embryo applies from the fertilisation stage to the initial totipotent cells and to the entire ensuing process of the development and formation of the human body, therefore including the blastocyst.

He opined that the referred question on this matter was a difficult one but nonetheless exclusively legal in nature. Further he indicated that the proposed solution or answer would be applicable only at the time that it was made and that future advances in knowledge might lead to it being modified in the future. The observations submitted by the Governments of the Member States, Ireland, Portugal, Sweden, and the UK, indicated that they tended to take the view that the definition of a human embryo should be left to their discretion. The AG disagreed with that opinion indicating that the preamble of the Directive indicated that its purpose was to achieve "effective and harmonized protection throughout the Member States". Furthermore the AG provided three additional arguments as to why the definition of a human embryo must be on a Community basis: Firstly, according to established case law if a provision of EU law makes no express reference to the law of the Member States for the purpose of determining its meaning and scope, then the need for a uniform application of EU law and the principle of equality requires that the terms of the EU provision must be given an autonomous and uniform interpretation throughout the EU. Secondly, in the decision of the unsuccessful action to annul Directive 98/44/EC in Netherlands v Parliament and Council (Case C-377/98[10]), the Court pointed out that the Directive aimed to prevent potential damage to the unity of the internal market resulting from some Member States unilaterally deciding to grant patent protection and others refusing to do so. Thirdly the Court also ruled in that case that there was no discretion for the Member States to decide for themselves on the unpatentability of the processes and uses listed under Art. 6(2) of the Directive.

Concerning the definition of the concept of a human embryo, the AG noted that the Directive and its drafting history give no insight into this definition. Furthermore the AG discussed that no uniform definition existed in the legislation of the Member States either. Therefore he concluded that only the provisions of the Directive itself, as well as other relevant international legislation, and current scientific information would provide the definition of a human embryo for interpreting the Directive. He noted that the Directive took care to avoid terminology concerned with "Life" but instead focused the provision and its protection on "the human body, at the various stages of its formation and development". Therefore the AG proposed that the appropriate question was what form and stage of development of the human body should be given the legal categorization of "embryo". He noted that the aspect of ethics was also of importance, as the preamble of the Directive indicates the importance of the fundamental principle of safeguarding the dignity and integrity of the person.

The AG noted that the scientific understanding within the Member States was that conception begins with a few totipotent cells whose main characteristic is that each cell has the capacity to develop into a complete human being. He stated the view that totipotent cells represent the first stage of the human body, and they must be legally categorized as embryos, no matter by what means they are obtained or with what intent. Therefore he concluded that every totipotent cell is an embryo regardless of how it was obtained. For this reason, he stated in his conclusion that "Unfertilised ova into which a cell nucleus from a mature human cell has been transplanted or whose division and further development have been stimulated by parthenogenesis are also included in the concept of a human embryo in so far as the use of such techniques would result in totipotent cells being obtained.".

In order to give consistency and to make sure that protection of the human body would not diminish as its growth and development progressed, he opined that the blastocyst and all development stages of the human body before and after it must therefore also be categorized as an embryo. The AG argued then that consistency required that a pluripotent cell, such as an embryonic stem cell, in isolation cannot be regarding as an embryo since it lacks the capability to develop into a complete human body by itself. For this reason, he proposed that such cells must be regarded as elements isolated from the human body within the meaning of Art. 5(2) of the Directive. Therefore he concluded that "Taken individually, pluripotent embryonic stem cells are not included in that concept (of the embryo) because they do not in themselves have the capacity to develop into a human being."

However the AG stated that one could not simply ignore the origin of pluripotent embryonic stem cells, as their removal from the blastocyst – which constitutes an embryo – requires its destruction. He stated that he did not follow the argumentation of the patentee in this regard that the question of patentability was only concerned with the embryonic stem cell and that the means and consequences of its removal were of no importance. His view on why these aspects needed to be taken into

9 Opinion Of Advocate General, delivered 10.03.2011 in Case C-34/10, Oliver Brüstle v. Greenpeace eV, authentic language French.

10 Judgement of 09.10.2001, Case C-377/98.

account related to the issues of *order public* and morality. The AG stated that patentability must be excluded in cases where the patent claims did not specify that human embryos are used for the exploitation but in reality they actually are. To rule otherwise would deprive the Directive of its effectiveness, and one could then simply circumvent its provisions by not specifying in the patent claims that human embryos were used or destroyed. In addition he stated that making an industrial application of an invention using embryonic stem cells would amount to using human embryos as a simple base material, which would clearly be in contradiction with ethics and *ordre public*. Therefore in his conclusion, the AG stated that "An invention must be excluded from patentability where the application of the technical process for which the patent is filed necessitates the prior destruction of human embryos or their use as base material, even if the description of that process does not contain any reference to the use of human embryos.".

The AG noted that the Directive did however provide an exception to the prohibition of patentability based on its drafting history and recital (42) of its preamble which states clearly "Whereas, moreover, uses of human embryos for industrial or commercial purposes must also be excluded from patentability; *whereas in any case such exclusion does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it*". As this provision provides an exception rather than a general rule, the AG opined that it needed to be interpreted quite strictly and reserved only for the specific case stated. Therefore the AG concluded that "The exception to the non-patentability of uses of human embryos for industrial or commercial purposes concerns only inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it.".

As will be discussed in more detail in the next section, it is interesting to note that the AG made little reference to the EPC or case law of the EBoA of the EPO. He only briefly mentioned the exclusions from patentability due to contradictions with "ordre public" or morality provided by Art. 53 (a) EPC. He was noticeable silent on the fact that the R. 26 – 29 EPC take over many of the provisions of the Directive, and that the EBoA of the EPO had recently ruled on several of the same questions referred to the CJEU in the decision of the EBoA in G2/06, which had been published only two years before in May 2009.

B.ii. Judgement of the Court (CJEU) in C-34/10

On 18.10.2011, the Grand Chamber of the CJEU delivered its judgement in case C-34/10[1]. To a large extent, the Court followed the Opinion of the AG, discussed earlier. Therefore the judgement will be discussed primarily in the points in which it differs from that opinion.

Concerning the definition of a human embryo, the Court largely followed the logic of the AG in his opinion; however, the Court placed great emphasis (point 34) on the EU legislature's intent to exclude patentability where respect for human dignity could be affected. Thus they stated that the concept of "human embryo" must be understood in a wide sense. Probably for this reason, they were somewhat broader that the AG in the language used in their interpretation of "human embryo", and emphasized that the starting point in the development of a human body for the definition of "human embryo" was any human ovum as soon as it is fertilized (point 35). Interestingly they focused their language more on the development of a *human being*, rather than on the development of a *human body* as the AG had. Similar to the AG though, they included in this categorization of human embryos also human ovums resulting from techniques such as *in vitro* fertilization or in which a nucleus from a mature cell is implanted („Dolly" method) or parthenogenisis. Although such organisms have not strictly speaking been the object of fertilization, they are nonetheless capable of commencing the process to form a human being. For these reasons, they stated in their ruling that article 6(2)(c) of the Directive must be interpreted as meaning that „any human ovum after fertilisation, any non-fertilised human ovum into which the cell nucleus from a mature human cell has been transplanted, and any non-fertilised human ovum whose division and further development have been stimulated by parthenogenesis constitute a 'human embryo';".

The Court differed however from the Opinion of the AG, who had opined that taken individually pluripotent embryonic stem cells are not included the definition of "embryo" since they do not have the capacity to alone develop into a human being. Rather than agreeing with or contradicting the AG, they in fact ruled that the decision should be left to the national court on this question: "it is for the referring court to ascertain, in the light of scientific developments, whether a stem cell obtained from a human embryo at the blastocyst stage constitutes a 'human embryo' within the meaning of Article 6(2)(c) of Directive 98/44."

In contrast to the opinion of the AG, the Court directly addressed in their decision the question of whether the exclusion of "uses of human embryos for industrial or commercial purposes" in Art. 6 (2) (c) might not apply to uses for scientific research. The argument of the patentee was that in such a case then scientific research making use of human embryos would be susceptible to patent protection. As the AG had done in his opinion, the Court pointed out that the preamble of the Directive in recital 42 provided only for a very limited and specific exception to this exclusion, namely for therapeutic or diagnostic purposes that are useful to the embryo. According to the Court there is nothing to imply from this text that scientific research would be similarly exempt. Furthermore the Court stated that the grant of a patent implies, in principle, its industrial or commercial application. This is because the rights of a patent are connected with acts of an industrial or commercial nature, in that a patent provides, as, for example, in Art. 9 PatG, the patentee with the right to prohibit

others from such industrial or commercial acts as making, offering, putting on the market or using an invention etc. without his consent. The Court noted that their interpretation of Art. 6(2)(c) of the Directive was identical to that made by the EBoA of the EPO in their interpretation of the identically worded R. 28(c) EPC in G2/06. For these reasons, the Court ruled in point 2 that "The exclusion from patentability concerning the use of human embryos for industrial or commercial purposes set out in Article 6(2)(c) of Directive 98/44 also covers the use of human embryos for purposes of scientific research, only use for therapeutic or diagnostic purposes which is applied to the human embryo and is useful to it being patentable.".

Concerning the third question, the Court followed the argumentation of the opinion of the AG, and indicated that an invention must be regarded as unpatentable if its implementation required the destruction of human embryos, even if the claims of the patent do not concern the use of human embryos. For example, stem cell lines are families of constantly dividing cells produced from a single group of stem cells and that can replicate in vitro over long periods of time. However the Court considered the fact that the destruction of the particular human embryo for developing a particular stem cell line may have occurred long ago irrelevant. The Court also mentioned that it was necessary to make this interpretation because otherwise the Directive and its provisions and purposes could simply be avoided by skillful drafting of patent claims. Interestingly the Court also mentioned specifically in paragraph 51 of their ruling that the EBoA of the EPO had reached the same conclusion in their interpretation of R.28(c) EPC, which has an identical wording to that of Art. 6(2)(c) of the Directive. Therefore quite similarly to the opinion of the AG, the Court ruled that "Article 6(2)(c) of Directive 98/44 excludes an invention from patentability where the technical teaching which is the subject-matter of the patent application requires the prior destruction of human embryos or their use as base material, whatever the stage at which that takes place and even if the description of the technical teaching claimed does not refer to the use of human embryos.".

Through their ruling in C-34/10, the CJEU has provided important clarification concerning the interpretation of important aspects of the Directive 98/44/EC on the legal protection of biotechnological inventions. Quite importantly, the CJEU shows in their ruling that when it comes to balancing the interests of society in fundamental rights and the dignity of the person versus industrial property rights, such as patent rights, that the fundamental rights have supremacy. Such fundamental rights are generally enshrined in Europe in national constitutions and in the fundamental rights charter of the treaty of Lisbon at the EU level and thus belong without presumption to all human beings under said jurisdiction. Therefore it is not surprising that the CJEU in its ruling has given supremacy to such rights. Furthermore in this balancing of these rights, the CJEU has been careful to err on the side of broader basic rights protection at the expense of narrower industrial property rights protection. In addition, it is a basic rule of Community law that a directly effective provision of Community law, such as a directive, prevails over a provision of national law, such as a national patent law.

Some necessary clarification has been provided by the CJEU of the definition of the term "embryo" and thus exclusions from patentability related to the interpretation of that term in the Directive. Disappointingly however, the Court – unlike the AG – declined to rule on whether individually pluripotent embryonic stem cells fall within the scope of this term. Therefore unfortunately there may be different national rulings on this point in the future.

C. German Federal Court Of Justice Decision of November 27, 2012 in X ZR 58/07

In the specific Brüstle case (XaZR 58/07), the Federal Court of Justice (BGH) has decided now[11] on Prof. Brüstle's appeal of the partial nullity decision since the necessary clarification on the interpretation of European law has been provided by the CJEU in C-34/10. The Court at the BGH has overruled the German Federal Patent Court's finding of partial invalidity at first instance, and the patent has been maintained with amended claims. As will be discussed, the BGH has adopted a reasonable middle-ground position in light of the CJEU ruling, and certainly some of the initial panic and more extreme fears of some practitioners and industrial interests concerning the CJEU ruling do not appear to have been justified.

In the amended claims a disclaimer was introduced to the independent claims in which it was specified that no human embryos were destroyed in the production of the isolated, purified precursor cells claimed or in the claimed processes to produce said cells. The Court commented that although methods for the harvesting of stem cells from embryos was typically associated with the destruction of the embryo on the priority date of the patent, the patent disclosed, for example, a method of obtaining embryonic stem cells from embryonic germ cells which did not necessitate this destruction of a human embryo.

Furthermore the Court noted that publications submitted as evidence indicated that human embryonic stem cells were also obtainable from non-viable embryos that were not capable of developing further into a human being. The Court decided that such processes were not prohibited from patentability because no "human embryo" was destroyed. The reason provided by the Court was that according to the CJEU decision such a non-viable embryo was not a 'human embryo' within the meaning of Article 6(2)(c) of Directive 98/44 because the non-viable embryo lacked the capability to develop further into a human being. The Court applied a similar logic in stating that a stem cell obtained from a human embryo at the blastocyst stage likewise did not constitutes a 'human embryo' since it lacked this same

11 Bundesgerichtshof Urteil 27.11.2012, Case X ZR 58/07.

capacity. The Court further indicated that this designation was unchanged by the fact that such stem cells might be reprogrammable so that they could develop into a human being if they were appropriately treated by external means such as through a combination with other cells.

The Court at the BGH appears to have taken a reasonable middle ground position in how extensive the exclusions to patentability should be in light of the CJEU ruling. In fact, this decision has generally received positive reviews from practitioners and the industry[12].

D. Looking To The Future For Patent Practitioners After The CJEU Decision in C-34/10

The decision of the CJEU was reviewed by several patent practitioners[13-14(a)], and they had been for the most part been fairly critical of the decision due to its perceived potential negative effects on the biotech industry in Europe. However one could argue that the situation in Europe for carrying out embryonic stem cells research is more favorable than in the US in some respects. In the US, companies and some academic investigators may find themselves blocked due to the generally very narrow and strictly limited experimental use exception for the use of patented inventions. In Europe, the embryonic stem cell investigators will in contrast be relatively unblocked by the patents of others, but, of course, they will need to comply with the relatively stringent provisions of their national and Community law concerning allowable research in this area. In addition, the critics have pointed out that considerable legal uncertainties remain despite this decision and also concerning its implementation at the national level or European level, such as potentially at the EPO[14].

Since the Brüstle patent has an early priority year of 1997 relative to the rapid developments in the field of stem cells, it is questionable how closely national courts of the Member States will follow the C-34/10 decision on more recent patent applications if the facts are sufficiently different. For example, some of the national courts might take the more liberal recent approach of the EPO. The EPO's recent policy has apparently been that if the earlier of the priority or filing date of the European patent application is later than May 9 2003, then R.28 (c) EPC does not apply and the invention is not excluded from patentability under Art. 53(a) EPC. The reason for this was that stem cell lines became publicly available as of this date according to an Examiner decision based on convincing patent attorney arguments provided during the prosecution of European Patent Application No. 05740642.3 (Axiogenesis)[14(b)].

Despite the remaining uncertainty, it would appear that patent practitioners can perhaps deal with the current legal situation to some extent by careful drafting of the claims and description of their patent applications. For example, practitioners may be able to make use of disclaimers to disclaim what is excluded from patentability, as was seen in the BGH ruling, or they may positively claim what is allowed to patent. Such drafting practice is common in the medical technology field, for example, in dealing with the exceptions from patentability provided by Art. 53(c) EPC. Due to the CJEU ruling in C-34/10 and remaining legal uncertainty in many jurisdictions, such disclaimers may need to be quite extensive though.

The ruling of the CJEU that the use of human embryos for therapeutic or diagnostic purposes which is applied to the human embryo and is useful to it is patentable in their answer to the second question does not seem to be particularly helpful to practitioners in attempting to draft patent claims that positively claim what is patentable. This is because this positive indication of patentability would appear to be in direct contradiction with the above-mentioned exceptions to patentability at the European and national level for therapeutic, surgical and diagnostic methods on the human body (e.g. Art. 53(c) EPC or Art. 2a (1) 2. of the German PatG). Furthermore a provocative question has even been raised on this topic by one practitioner as to when is a treatment "useful to an embryo"[13(e)]. For example, in the case of methods involving prenatal or pre-implantation diagnostics, the answer to this question for the specific embryo may arguably depend on the diagnostic outcome of the relevant method.

Some legal uncertainty also remains in most jurisdictions concerning the patentability of potential future

12 See for example, (a) „Good News For Stem Cell Patents In German Brüstle Ruling, Managing Intellectual Property, 03.12.2012, available on line, accessed 20.03.13 at *http://www.managingip.com/Article/3125909/Good-news-for-stem-cell-patents-in-German-Brstle-ruling.html*>, (b) „German Federal Court of Justice Decides on Patentability of Stem Cells – Decision of 27 November 2012 – X ZR 58/07" Latham & Watkins Client Alert, Nr. 1486, 13.03.2013; (c) „German Federal Court of Justice decides in favour of stem cell patent", Marks & Clerk UK, available on-line, accessed 20.03.2013 at <http://www.marks-clerk.com/uk/attorneys/news/newsitem.aspx?item=42-9>.

13 See for example, (a) C. Langer, „The European Court of Justice Bars Stem Cell Patents In Landmark Decision", Berkeley Tech. L.J. Bolt (January 5, 2012), available on-line, accessed 27.05.2012, at <*http://btlj.org/?p=1646*>, (b) T. Friede, „1. Court of Justice of the European Union: Exclusion from patentability of all human embryonic stem cell-related inventions in Europe (decision of October 18, 2011 – Case C-34/10 – Brüstle v Greenpeace), in BardehlePagenberg IP Report 2011/V p. 4, available on-line, accessed 27.05.2012, at <*http://www.bardehle.com/fileadmin/contentdocuments/ip_reports/IP_Report_2011_V_D.pdf*>; (c) L. Holliday, „CJEU Decision C-34/10 A Kiss Of Death For The European Stem Cell Industry", D Young & Co Patent Newsletter No. 26, Dec. 2011, p. 2, available on-line, accessed 27.05.2012, at <*http://www.dyoung.com/article-c3410brustle*>; (d) S. Blance, „Brüstle v Greenpeace (C-34/10): The End For Patents Relating to Human Embryonic Stem Cells in Europe?", IP Europe Quarterly, Avidity IP Ltd March 2012, available on-line, accessed 27.05.2012, at <*http://www.avidity-ip.com/assets/pdf/Brustlemar12.pdf*>; and (e) B. Quest and F.-J. Zimmer, „The European Court of Justice Rules on the Patentability of Human Embryonic Stem Cells: No Patents for inventions relying on Human Embryos as Source Material", Grünecker Patent- und Rechtsanwälte, Publikationen, available on-line, accessed 27.05.2012, <*http://www.grunecker.com/DE/files/ipinformation/402.shtml*>.

14 (a) *epi* Position Paper on Patentability of Human Embryonic Stem Cells, *epi* Information 1/12, p. 9; available on line, accessed 18.05.2012, at <http://www.patentepi.com/downloads/Information/epi-Information_01-2-012_eP.pdf>
(b) S. Wright, „Minutes of EPO/*epi* Meeting on 15 November 2010", *epi* Information, 3/11, p. 91, available on-line, accessed 27.05.2012, at <*http://www.patentepi.com/downloads/Information/epi-Information_03-2011_eP_korrigendum.pdf*>.

14 (b) S. Wright, „Minutes of EPO/*epi* Meeting on 15 November 2010", *epi* Information, 3/11, p. 91, available on-line, accessed 27.05.2012, at <*http://www.patentepi.com/downloads/Information/epi-Information_03-2011_eP_korrigendum.pdf*>.

advances in methods for harvesting embryonic stem cells that do not require destruction of the human embryo. One could disclose such methods in the description and positively include such methods as technical features in the patent claims. However even such an approach would nonetheless lack legal certainty as the CJEU in their answer to the referred question 1 (c) left it to the national courts to ascertain in light of scientific developments as to whether a stem cell obtained from a human blastocyst constitutes a "human embryo". Therefore different national courts may decide differently on this question. In addition, the technical teaching of the patent claims in such a case arguably still requires the use of human embryos as a base material, even though the human embryos are not themselves destroyed, and it is not yet clear how the various jurisdictions will rule on this aspect.

Another legal uncertainty concerning the practice of European patent attorneys relates to the stated intent of the EPO president that "If the judges (of the BGH) rule in favour of a restrictive interpretation of biotech patentability provisions, the EPO will immediately implement it."[15]. As discussed earlier, it is quite questionable as to what relevance a CJEU ruling should have – if any – for a non-EU international organization like the EPO. In particular, this statement of the EPO president is of concern to the Institute of Professional Representatives before the European Patent Office, or European Patent Institute (*epi*), in that the EPO is not an EU organization and therefore not legally bound by the CJEU. Furthermore it is still unclear even how the national courts of the EU member states will apply the CJEU ruling, and the EPO BoA, as the highest EPO instance, is the appropriate organ for providing legal clarification in this area[14(a)]. Such statements by the EPO, as well as any EPO rash implementation of a restrictive interpretation, create considerable potential or real legal uncertainty. For example, the validity of pending EP patent applications and granted EP patents having priority (or filing) dates later than May 2003 may now be called into question. Therefore the EPO would be well advised to not change its current practice yet, but instead it should wait for a decision and clarification from its highest instance, the BoA.

In conclusion, the decision C-34/10 is of considerable importance in patent matters. This importance results from a variety of factors such as Directive 98/44/EC being the only EU Directive directly concerned with patent matters, the importance of the biotech industry to the European economy, as well as the decision's concern with the fundamental question of what is patentable and important societal questions related to human life and dignity. The CJEU has ruled to give supremacy to fundamental basic rights of human dignity and integrity rather than to industrial property rights. Some patent practitioners and some of those in the biotech industries may nonetheless unfortunately be disappointed and left feeling that the effect of the ruling has been to clarify that too much is excluded from patentability in the area of embryonic stem cell technology in Europe.

Although the Federal Court of Justice (BGH) has referred well-formulated questions to the CJEU, the CJEU has provided clear answers to nearly all of the questions, and the BGH has taken a moderate approach in its final decision, some modest legal uncertainty remains. This legal uncertainty at the national level will need to be addressed by the national courts of the EU member states, perhaps with the help of further references to the CJEU. Legal uncertainty at the EPO should rightly be addressed by future decisions of the Boards of Appeal and Enlarged Board of Appeal of the EPO or by revision of the EPC by the Administrative Council or a Diplomatic Conference.

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15 (a) *epi* Position Paper on Patentability of Human Embryonic Stem Cells, *epi* Information 1/12, p. 9; available on line, accessed 18.05.2012, at <http://www.patentepi.com/downloads/Information/epi-Information_01-2-012_eP.pdf>
(b) S. Wright, „Minutes of EPO/*epi* Meeting on 15 November 2010", *epi* Information, 3/11, p. 91, available on-line, accessed 27.05.2012, at <*http://www.patentepi.com/downloads/Information/epi-Information_03-2011_eP_korrigendum.pdf*>.

14 (a) *epi* Position Paper on Patentability of Human Embryonic Stem Cells, *epi* Information 1/12, p. 9; available on line, accessed 18.05.2012, at <http://www.patentepi.com/downloads/Information/epi-Information_01-2-012_eP.pdf>.

Important decision from the French Supreme Court (Cour de cassation) on limitation of the claims after grant – Impact on combination SPCs

F. Portal (FR)

SYNGENTA v. INPI (French Patent and Trademark Office), French Supreme Court, March 19, 2013

French Patent Law (art. L 613-24) was amended on August 4, 2008 enabling the Patentee to request a limitation of the claims of a Patent. Before this amendment, it was only possible for a Patentee to request cancellation of one or several claims.

This amendment of Law opened two possibilities:

1. to request the limitation of the claims of a National French Patent ;
2. to request the limitation of the claims of a French part of a European Patent.

The second possibility implements art. 138(3) requirement (EPC 2000) stating the following:

In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims.

There are two ways to request the limitation of a National part of a European Patent:

1. Before the EPO – The decision to limit the European patent shall apply to the European patent in all the Contracting States in respect of which it has been granted (Art. 105a EPC 2000). In other words, it shall limit the claims in all designated Contracting Sates.
2. Before a National competent court or authority – The decision to limit the National part of a European patent shall apply to the Contracting State of this competent court or authority. In other words, it shall limit the claims only in one Contracting State.

Syngenta requested to limit the claims of a French part of a European patent before the French Patent and Trademark Office ("INPI").

The limited claim (claim 8 – first independent claim on a composition) was originally directed to a composition comprising an active ingredient A and excipients.

The description of the Patent also recited the optional presence of a second active ingredient B (namely a list of different kind of active ingredients).

The request for limitation aimed to limit claim 8 as follows:

A composition comprising an active ingredient A, **and a further active ingredient B** and excipients. (B being an exhaustive list of active ingredients)

The request was rejected by the INPI, notably on the basis that no claim was directed to a further active ingredient B, and that such an amendment would enlarge the scope of claim 8 by covering a huge number of combinations of different active ingredients.

The Paris Appeal Court affirmed this decision.

Now the Supreme Court decided on March 19, 2013 to revoke the decision of the Paris Appeal Court. The reasons may be summarized as follows:

– A modification may be **derived directly and unambiguously from the description** of the Patent, not only from the claims as interpreted by the Paris Appeal Court.
– The limitation had to be examined according to the European Patent Convention (art. 69) and the French IP Code (Code de la Propriété Intellectuelle). Claims should be interpreted by the description and drawings. Therefore the **description may serve as basis for post grant limitation** of the claims.

This decision is important not only because it affirms the well-known principle of interpretation of the claims by the description and drawings, but also accepted the principle of introducing a limitation of the claims after grant based on features described only in the description and drawings.

This decision is also very important because, for almost 10 years, a battle on combination SPCs exists between different Patent Offices of the European Union, also including pharma-patent owners and generic companies. The recent EUCJ decision in Medeva (C322/10) affirmed the principle that EC regulationon SPC(n°469/2009) precludes grant of SPCs on active ingredients which are not specified in the wording of the claims of the basic patent relied on in support of the application for such SPC.

The Patent limited by Syngenta was also a "basic patent" for a combination SPC on a phytopharmaceutical product. To follow the UECJ decision one would have to consider limiting the claims to properly support the combination of active ingredients. This procedure was followed by Syngenta and the limitation of composition claims to a combination of active ingredients already described in the description appears rightly grounded by the present French Supreme Court decision. The issue of this litigation on limitation of the claims will have a deep impact on professional's practice requesting combination SPCs.

To conclude, obtaining a **combination SPC** is possible in case the basic Patent does not specify in the claims the combination of active ingredients but describes this combination in the description. This possibility provided by **limiting the claims** by a limitation procedure so as to specify the **combination of active ingredients** in the wording of the composition claims.

Gesonderte Beschwerde bei zeitlich gebundenen Anträgen

Die Entscheidung T 1849/12 – 3.2.05: (Noch immer) Keine Erteilung vor Ablauf von 18 Monaten

T. Müll (CH)[1] und Dr. M. Wilming (CH)[2]

1. Zum Hintergrund

Eine rasche Patenterteilung kann oftmals von grossem Nutzen sein. Wenn der Recherchenbericht des EPA vollständig positiv ist, sollte die Patenterteilung auch vor Ablauf von 18 Monaten ab dem Anmelde- bzw. Prioritätstag erfolgen können. Diese Möglichkeit sieht Art. 93(2) EPÜ ausdrücklich vor. Es hat sich jedoch in den letzten Jahren beim EPA schleichend die Praxis ergeben, dass vor Ablauf dieser 18 Monate eine Patenterteilung verweigert wird. Dies sei gemäss Einschätzung zumindest einiger Prüfungsabteilungen nötig, da noch nicht alle unter Art. 54(3) EPÜ potentiell relevanten PCT Anmeldungen in die Recherchendokumentation aufgenommen seien. Diese Praxis wurde bereits in *epi* Information 1/2011, S. 31f kritisch diskutiert.

Gegenstand der Entscheidung T1849/12 ist die Beschwerde einer Anmelderin gegen die Weigerung der Prüfungsabteilung, unverzüglich – noch vor Ablauf von 18 Monaten – eine Mitteilung nach Regel 71 (3) zu übersenden. Die Anmelderin hatte eventualiter den Antrag gestellt, es sei eine beschwerdefähige Entscheidung zu erlassen, falls die Prüfungsabteilung ihrem Hauptantrag nicht stattgeben sollte. Die Prüfungsabteilung lehnte beide Anträge mit Verweis auf mangelnde rechtliche Grundlage ab.

Die technische Beschwerdekammer hat sich (in erweiterter Besetzung gemäss Art. 21(3) b) EPÜ) unter Verweis auf G8/95 (Erw. 4 und 5) für zuständig erachtet, da die ablehnende Mitteilung der Prüfungsabteilung unmittelbar den Zeitpunkt betrifft, zu dem die Prüfungsabteilung die Erteilung des Patents beschliesst – also den Erteilungsbeschluss. Sie ist zwar auf die Beschwerde eingetreten, hat diese aber materiell als unbegründet zurückgewiesen. Es ist bereits bemerkenswert, dass die Beschwerde für zulässig befunden wurde. Die Entscheidung ist jedoch auch von weitergehendem Interesse hinsichtlich der Zulässigkeit von Beschwerden im Allgemeinen.

2. Zulassung der gesonderten Beschwerde bei zeitlich gebundenen Anträgen

Entscheidungen der Prüfungsabteilung sind mit der Beschwerde anfechtbar (Art. 106(1) EPÜ). Wenn die Entscheidung das Verfahren nicht abschliesst (sog. Zwischenentscheid), ist sie nur zusammen mit der Endentscheidung anfechtbar, sofern nicht in der Entscheidung die gesonderte Beschwerde zugelassen wurde (Art. 106(2) EPÜ). Der Begriff der Entscheidung ist im EPÜ nicht definiert. Die Beschwerdekammern haben jedoch mehrfach festgehalten, dass es auf den Inhalt ankommt, nicht auf die Form oder die Bezeichnung (vergl. J 08/81, ABl. EPA 1982, 10; J 26/87, ABl. EPA 1989, 329).

So auch in diesem Fall: Die Prüfungsabteilung habe durch die Ablehnung des Hauptantrages der Anmelderin eine endgültige und rechtlich bindende Feststellung getroffen, was inhaltlich den Charakter einer Entscheidung habe (Erw. 2.1.3, erster Absatz). Da die Prüfungsabteilung es ablehnte, unverzüglich eine Mitteilung nach R. 71(3) EPÜ zu übersenden und damit eine zeitnahe Patenterteilung und die damit verbundene Verleihung der Rechte nach Art. 64 EPÜ nicht ermöglicht habe, lag auch eine Beschwerde vor (Erw. 2.1.3, zweiter Absatz sowie 2.2.2, zweiter Absatz).

Die als Entscheidung zu wertende Mitteilung der Prüfungsabteilung hat jedoch das Verfahren offensichtlich nicht abgeschlossen, sondern lediglich die weitere Bearbeitung aufgeschoben. Da die gesonderte Beschwerde von der Prüfungsabteilung nicht zugelassen wurde, wäre diese eigentlich nur zusammen mit der Endentscheidung anfechtbar gewesen. Dennoch hat die Beschwerdekammer die Beschwerde der Anmelderin für zulässig erachtet (Erw. 2.2). Dem erstinstanzlichen Organ stehe ein pflichtgemässer Ermessensspielraum bei der Zulassung der gesonderten Beschwerde zu. Die Beschwerdekammer dürfe sich über eine solche Ermessensentscheidung nur dann hinwegsetzen, wenn sie der Auffassung ist, dass das erstinstanzliche Organ sein Ermessen nicht nach Massgabe der richtigen Kriterien oder in unangemessener Weise ausgeübt und damit seinen Ermessensspielraum überschritten hat (Erw. 2.2.1, letzter Absatz mit Verweis auf G 7/93). Dem Begehren der Anmelderin, durch unverzügliche Übersendung einer Mitteilung nach R. 71(3) EPÜ eine zeitnahe Patenterteilung zu ermöglichen, hätte im Falle einer erfolgreichen Beschwerde zusammen mit der Endentscheidung über die Erteilung aber gar nicht mehr sinnvoll entsprochen werden können. Die als Entscheidung zu wertende Mitteilung der Prüfungsabteilung hat somit eine Beschwerde geschaffen, die mit einer Beschwerde gegen die Endentscheidung/den Erteilungsbeschluss nicht mehr entfallen konnte. Ein anderer

1 Rechtsanwalt bei Hepp Wenger Ryffel AG in CH-9500 Wil
2 European Patent Attorney; Partner bei Hepp Wenger Ryffel AG in CH-9500 Wil

Rechtsbehelf als die Beschwerde stand der Anmelderin auch nicht zur Verfügung (insbesondere, weil dem EPÜ eine Untätigkeitsbeschwerde fremd ist). Die Beschwerdekammer kam somit richtigerweise zum Schluss, dass die Prüfungsabteilung die gesonderte Beschwerde hätte zulassen müssen, und sah die als Entscheidung zu wertende Mitteilung der Prüfungsabteilung unmittelbar als gesondert beschwerdefähig an.

3. Keine vorzeitige Erteilung: Wie lange noch?

3.1 Erwägungen der Beschwerdekammer

Materiell ist die Anmelderin mit ihrem Antrag auf Erteilung vor Ablauf von 18 Monaten jedoch nicht durchgedrungen, aus folgenden Gründen:

a) Die Auffassung der Prüfungsabteilung

Die Beschwerdekammer verweist zunächst darauf, dass die Prüfungsabteilung gemäss Art. 97(1) die Erteilung beschliesst, *wenn* sie zur Auffassung gelangt ist, dass die Anmeldung und die Erfindung, die sie zum Gegenstand hat, den Erfordernissen des EPÜ genügt. Dies sei vorliegend explizit (noch) nicht der Fall gewesen, weshalb die Prüfungsabteilung die Erteilung nicht – entgegen ihrer dem Anmelder dargelegten Auffassung – beschliessen konnte (Erw. 3.1).

Dies vermag nicht vollends zu überzeugen. Zwar ist durchaus einsichtig, dass nicht dem Anmelder selbst die Entscheidung darüber obliegen kann, ob die Sachprüfung auch sämtlichen Stand der Technik gemäss Art. 54(3) EPÜ abdecken soll oder nicht. Dies dem freien Ermessen jeder einzelnen Prüfungsabteilung zu unterstellen, erscheint jedoch ebenso wenig zielführend. Vielmehr sollte über den Umfang der Recherchendokumentation auch in ihrer zeitlichen Abdeckung von Anfang an unbedingte Klarheit herrschen. Unsicherheiten in dieser Hinsicht – je nachdem, an welche Prüfungsabteilung man gelangt – werden Nutzern des EPÜ auf Dauer nicht vermittelbar sein.

b) Art. 93(2) bedingt kein Recht auf vorzeitige Erteilung

Die Beschwerdekammer hat weiter festgestellt, dass Art. 93(2) EPÜ lediglich die *Möglichkeit* einer Patenterteilung vor Ablauf von 18 Monaten regelt; nicht hingegen, dass es ein *Anrecht* darauf gebe. Die Patenterteilung könne vor Ablauf von 18 Monaten erfolgen, *wenn* denn die Prüfungsabteilung zu diesem Zeitpunkt zur Auffassung gelangt ist, dass die Anmeldung den Erfordernissen des EPÜ genügt (gemäss Art. 97(1) EPÜ).

Dass sich hierdurch eine Unklarheit hinsichtlich der relevanten Recherchendokumentation ergibt, lässt die Beschwerdekammer leider unkommentiert.

Die bestehende Praxis wurde jedoch in den letzten Jahren institutionalisiert u. a. durch Aufnahme expliziter Regelungen bspw. in die Richtlinien für die Sachprüfung (C-IV, 7.1: *„Kann der Prüfer diese abschliessende Recherche […] nicht zu Ende führen, so hat er sicherzustellen, dass sie abgeschlossen wird, ehe sein Votum ergeht, dass die Anmeldung die Voraussetzungen für die Erteilung eines Patents erfüllt."*); ob eine Prüfungsabteilung im Lichte solch zwingender Bestimmungen in den Richtlinien überhaupt noch ein Ermessen ausüben kann, erscheint fraglich. Oder können Prüfungsabteilungen zwar nach freiem Ermessen die vorzeitige Erteilung verweigern, nicht jedoch gewähren?

c) Zugänglichkeit von Art. 54(3) Stand der Technik aus PCT Anmeldungen

Die Anmelderin hatte darauf verwiesen, dass dem EPA einerseits ein Grossteil der potentiell relevanten PCT Anmeldungen bereits vor Ablauf von 18 Monaten vorliegen würden, und andererseits die Relevanz einer Vielzahl von PCT Dokumenten auch nach Ablauf von 18 Monaten noch nicht absehbar sei (aufgrund von Sprachbarrieren und wegen der Unklarheit, ob die regionale Phase beim EPA eingeleitet wird). Die zeitliche Grenze von 18 Monaten sei daher willkürlich.

Auch diesem Argument ist die Beschwerdekammer nicht gefolgt. Nach 18 Monaten seien dem EPA die relevanten PCT Anmeldungen grundsätzlich zugänglich. Wenn der Prüfungsabteilung auf dieser Basis bereits ersichtlich werde, dass sich hieraus kein relevanter Stand der Technik unter Art. 54(3) mehr ergeben könne, so könne sie die Erteilung verfügen. Diese Herangehensweise beruhe (immerhin) auf *„nachvollziehbaren Gründen."*

3.2 Rahmenbedingungen des EPA

Zwar ist die Entscheidung überaus klar darin, dass die Beschwerdekammer keine Bedenken hegt hinsichtlich der Vereinbarkeit der beanstandeten Praxis einiger Prüfungsabteilungen mit dem EPÜ. Dennoch verbleibt ein schaler Nachgeschmack.

a) Die selbstverschuldete Unvollständigkeit der Recherchedokumentation

Die Beschwerdekammer merkt an, dass das EPA als Bestimmungsamt von der Möglichkeit einer systematischen vorzeitigen Übermittlung nach Art. 13(1) PCT in Verbindung mit R. 31.1 a) PCT keinen Gebrauch macht. *Deshalb* könne sich die Prüfungsabteilung erst 18 Monate nach dem Anmelde- bzw. Prioritätstag der zu prüfenden Patentanmeldung ein vollständiges Bild über die potentiellen älteren Rechte machen (Erw. 3.3).

Man fragt sich unvermittelt, weshalb denn kein Gebrauch von dieser Möglichkeit gemacht wird, die der PCT bietet. Nach 12 Monaten könnte für die Prüfungsabteilungen Zugriff auf alle relevanten Dokumente bestehen – wenn das EPA als Bestimmungsamt dies beantragen würde.

b) Technische Hürden für den Erlass einer Mitteilung nach R. 71(3) vor Ablauf von 18 Monaten?

Die Anmelderin hat im Beschwerdeverfahren auf Fälle der jüngeren Vergangenheit hingewiesen, in denen eine Erteilung vor Ablauf von 18 Monaten erfolgte. Bemerkenswert an diesen Fällen ist, dass im Register die

Löschung eines Prioritätsanspruchs vermerkt ist – obschon aus der Akteneinsicht nicht ersichtlich ist, dass überhaupt jemals eine Priorität beansprucht wurde. Die Anmelderin hat die Vermutung geäussert, dass eine technische Hürde im EDV System des EPA besteht für das Erzeugen einer Mitteilung nach R. 71(3) EPÜ vor Ablauf von 18 Monaten ab dem Anmelde- bzw. Prioritätstag. Diese Hürde sei möglicherweise mit dem Eintrag eines fiktiven Prioritätstags umgangen worden, wobei der Prioritätseintrag anschliessend wieder gelöscht worden sei.

Die Beschwerdekammer nimmt hierzu in ihrer Entscheidung leider nicht Stellung. Sie hat jedoch unmissverständlich festgehalten, dass die Entscheidung, ob und wann eine Patenterteilung erfolgt, ausschliesslich in den Händen der Prüfungsabteilung liegt. Vor diesem Hintergrund wäre es sehr befremdlich und mit dem Tenor der Entscheidung der Beschwerdekammer nicht vereinbar, wenn tatsächlich eine technische Barriere den Prüfungsabteilungen die Ausübung ihres Ermessens vor Ablauf von 18 Monaten verunmöglichen würde.

3.3 Wie weiter?

Die Beschwerdekammer hat die Entscheidung über den Zeitpunkt der Erteilung unmissverständlich dem Ermessen der Prüfungsabteilungen unterstellt (Leitsatz 2). Nutzer des EPÜ dürfen jedoch zu Recht erwarten, dass in diesem formalen Aspekt, der den zeitlichen Umfang der Recherchendokumentation betrifft, eine einheitliche Praxis herrscht. Offensichtlich unangemessen wäre es jedoch, eine einheitliche Praxis durch technische Hürden beim Erlass von Mitteilungen nach R. 71(3) zu erzwingen.

Vielmehr sollte das EPA von der Möglichkeit einer systematischen vorzeitigen Übermittlung nach Art. 13(1) PCT in Verbindung mit R. 31.1 a) PCT Gebrauch machen. Somit stünden den Prüfungsabteilungen nach 12 Monaten alle relevanten PCT Dokumente zur Verfügung. Die Patenterteilung könnte somit immerhin bis zu 6 Monate früher als derzeit erfolgen. Zudem wären bei diesem Modell auch die letzten Bedenken der Beschwerdekammer hinsichtlich der Möglichkeit der Einschätzung der Rechtsbeständigkeit noch innerhalb der Einspruchsfrist überwunden (Erw. 4): Die Einspruchsfrist könnte frühestens 21 Monate ab dem Anmelde- bzw. Prioritätstag ablaufen; dann sind aber auch alle potentiell relevanten PCT Anmeldungen seit mindestens 3 Monaten publiziert. Dies entspricht immerhin der Dauer der gesamten Einspruchsfrist bspw. gegen ein Patent in Deutschland. Bereits in der Fassung des EPÜ von 1973 war es nicht zwingend, dass für Art. 54(3) EPÜ allenfalls relevanter Stand der Technik aus PCT Anmeldungen während der gesamten Einspruchsfrist recherchierbar sein muss, denn sonst hätte Art. 93(2) EPÜ eine Patenterteilung vor Ablauf von 18 Monaten gar nie vorgesehen.

4. Implikationen über die vorzeitige Erteilung hinaus

Wird ein zeitlich gebundener Antrag abgelehnt, so ist darüber die gesonderte Beschwerde zuzulassen, wenn nur so eine Beseitigung der Beschwerde erreicht werden kann. Könnte inskünftig also bspw. die Ablehnung eines Antrags auf Verlegung einer mündlichen Verhandlung mit einer gesonderten Beschwerde angefochten werden? Der Leitsatz von T1849/12 könnte die Phantasie beflügeln. Die Praxis wird zeigen, wo die Grenzen liegen.

Folgende Aspekte könnten Bedeutung erlangen:

4.1 Abhilfe

Gemäss Art. 109 EPÜ muss das Organ, dessen Entscheidung mittels Beschwerde angefochten wird, in nichtkontradiktorischen Verfahren insoweit Abhilfe schaffen, als es die Beschwerde für zulässig und begründet erachtet. Der Zeitrahmen wird in Art. 109(2) EPÜ festgelegt, wonach das Organ der Beschwerde innert drei Monaten Abhilfen schaffen muss, andernfalls es die Beschwerde unverzüglich der Beschwerdekammer vorzulegen hat.

Soweit ersichtlich wurde in der Literatur bislang die Meinung vertreten, dass die nicht rechtzeitige Weiterleitung an die Beschwerdekammer keine rechtlichen Folgen habe. In dieser Pauschalität kann dies nun nicht mehr gelten. Der vorliegende Beschwerdekammerentscheid schränkt den zeitlichen Spielraum der Prüfungsabteilung insoweit ein, als dass sie nach Eingang der Beschwerde unverzüglich zu prüfen hat, ob es sich um eine zeitgebundene Angelegenheit handelt. Ist dies der Fall, hat das zuständige Organ, sollten die weiteren Voraussetzungen gegeben sein, unverzüglich Abhilfe zu schaffen. Sind die Voraussetzungen nicht gegeben, so muss die Beschwerde unverzüglich der Beschwerdekammer vorgelegt werden, um jedenfalls eine Entscheidung über die Beschwerde zu einem Zeitpunkt zu ermöglichen, in welchem die Beschwerde noch beseitigt werden könnte.

4.2 Obligatorische Teilung

Falls die Frist für die freiwillige Teilung gemäss R. 36(1) a) bereits abgelaufen ist, steht Anmeldern nur noch die obligatorische Teilung gemäss R. 36(1) b) zur Verfügung. Aus der Praxis sind Fälle bekannt, in denen Prüfungsabteilungen keinen Einwand wegen mangelnder Einheitlichkeit erheben, obschon die Nicht-Einheitlichkeit offensichtlich ist. In solchen Fällen könnte nun erwogen werden, einen Antrag auf Feststellung der Nicht-Einheitlichkeit zu stellen. Dieser Antrag wäre offensichtlich zeitlich gebunden. Wird ihm nicht stattgegeben, so liegt auch eine Beschwer vor, da die Einreichung einer weiteren Teilanmeldung verunmöglicht ist. Im Lichte der Entscheidung T1849/12 sollte die gesonderte Beschwerde demnach zwingend zugelassen werden müssen.

UNION ExCo Position paper
Rule 36 EPC
entered into force on 01.04.2010

I. Introduction

UNION is an Association of practitioners in the field of Intellectual Property, that is of individuals whose principal professional occupation is concerned with Patents, Trade Marks or Designs and related questions and who carry on their profession independantly or as employees. UNION is a private, free,international Association which is not dependent on any National or International Authority: it approves its own members, in accordance with its Statutes, in total independence, and likewise decides on its own activities and its own budget. It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improvement of professional and personal understanding between European Practitioners in the Intellectual Property field in different countries and different branches of the profession.

In the years after its foundation in 1961, UNION was one of the organisations which participated most actively in the preparations for the European Patent System. Since that time it has continuously pursued its activities in the Patent field, particularly in arranging Round-Table discussions on current Patent problems. It has contributed prominently to the debate on the application of the Patent System to Biotechnological Inventions. In addition it has dedicated its activities to other areas of Intellectual Property in Europe, especially the harmonisation of Trade Mark and Design Laws as well as the Community Trade Mark and Community Design. It has taken the initiative in bringing forward discussions of the existing and newly created Utility Model or Short Term Patent Laws in numerous European countries and raising the question whether these laws should be harmonised or whether a European Utility Model should be created.

UNION maintains close contacts with International Authorities such as WIPO (The World Industrial Property Organisation) and the Commission of the European Union, and it is invited to their consultations and discussions. It participates regularly as a non-governmental organisation with observer status at International Conferences.

II. Comments

In the year 2010, the EPO amended Rule 36 EPC regarding the time limit to file divisional applications. In its previous form, an applicant was entitled to file a divisional application relating to "any pending earlier European patent application". However, the 2010 amendment imposed two alternative additional conditions: the first one, related to the filing of voluntary divisionals, was a time limit of 24 months from the Examining Divisioń s first communication in respect of the earliest application for which a communication has been issued. As from the beginning, this additional condition proved to imply a lot of practical difficulties in its implementation: In an ideal system where the first communication in respect of the parent application is issued before the first communication in respect of the divisional, the situation is more or less clear. However, in the real world the situation is frequently far from ideal, and particularly the situation worsens when the first communication in respect of the divisional is issued earlier than the first communication of the parent application, and it is even worse if the parent application has been withdrawn or deemed withdrawn before a first communication for it has been issued. In those cases, the term "earliest communication for which a communication has been issued" may not have a consistent meaning in all conceivable cases, with the consequent legal uncertainties for third parties.

Another kind of problem may appear in those cases where the examination procedure suffers considerable delays, as more frequently than not happens before the EPO: For instance, in the case where a very relevant prior art document suddenly appears during the examination procedure when the time limit to file divisionals has lapsed, the applicant may lose any possibility to obtain a patent to his or her invention.

The amendment to Rule 36 EPC introduced a further alternative, directed to the possibility to file mandatory divisionals: a time limit of 24 months from a non-unity communication. This implies that the period for filing a divisional application in a given patent family may re-open after having been closed, which introduces further possibilities of legal uncertainties for third parties, such as when a Freedom-to-Operate opinion is sought. Moreover, it is in some cases up to the discretion of the examiner whether or a non-unity objection would be raised. If the application contains multiple and non-unitary independent claims in the same category, the examining division might refuse the application for having multiple independent claims in the same category, instead of non-unity, so that the period for filing a divisional application would not (re-)open.

The intention of the EPO for amending Rule 36 EPC was to stop the alleged abuse of a few, unidentified applicants who filed numerous consecutive divisional applications and kept the public in an unknown situation about the scope of the claims to be granted. However,

the abusers of the old system will still be able to abuse the present system: In the first alternative, the applicant may rely on doing the necessary to avoid a first communication for the first application; in the second alternative, the applicant may intentionally introduce non-unitary claims in the attempt to give rise to a further period for filing divisionals as it is up to the discretion of the Examining Division to raise an objection under rule 137 (5) EPC or Article 82 EPC. Another purported intention of the EPO was to avoid the practice of filing of a divisional on the day before oral proceedings to maintain pendency; however this practice has presently been made for the most part unnecessary by Decision G 1/09 which allows for divisionals to be filed after refusal and up to the time limit for filing a notice of appeal. In any case, the final target of the EPO has not been finally achieved, and this is evidenced by the statistics: Even though the number of second and subsequent generation divisionals has been reduced, however the number of first generation divisionals has greatly increased.

It is clear that the present wording of the Rule is complex, onerous both on the side of the EPO and of the applicants, and increases the legal uncertainty for third parties, with no perceivable practical benefits.

III. Position of UNION

It is therefore the position of UNION that Rule 36 EPC should revert to its previous wording, so that a divisional can be filed while the parent European patent application is pending.

In addition thereto UNION **suggests** to adopt the practice of the Australian Patent Office to restrict in practice the multiple filing of divisional applications to keep an application pending for as long as possible. This solution does only require modification of the Guideliness. The modified Guidelines could stipulate that:

- any divisional application will be immediately put on the top of the work list of the examiner who is/was dealing with the relevant parent application;
- the examiner will determine whether the main claims of the divisional application are substantially the same as claims that already have been examined for the parent application and/or previous divisional applications;
  - if not, then the application will be normally (searched and) examined;
  - if the claims are substantially the same, the examiner will issue a communication,
    - merely referring to the objections of the earlier communication in the parent and/or previous divisional application;
    - inviting the applicant to amend the claims into a form different from any of the main claims examined in the parent and/or previous divisional application;
    - announcing a refusal if the applicant does not amend into a form which differs from all of the main claims examined in the parent and/or previous divisional application
    - giving a term of 2 months to reply (is already possible under Rule 132(2)
    - allowing only one extension of 1 month

On Behalf of the UNION ExCo
The Patents Commission of UNION

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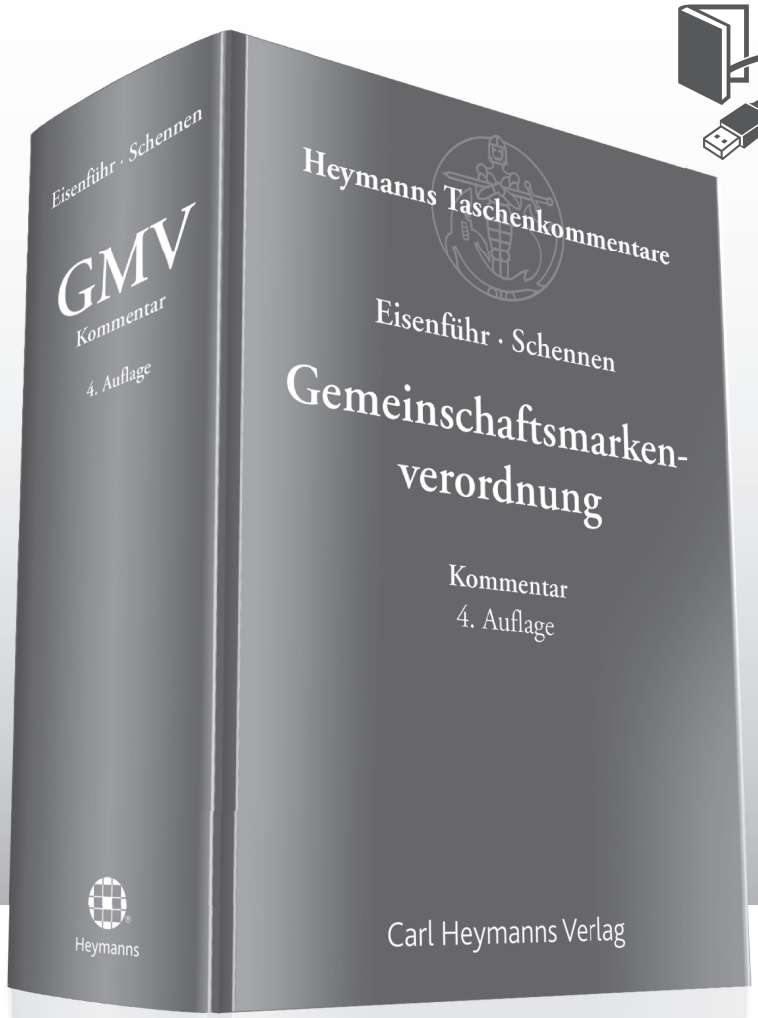

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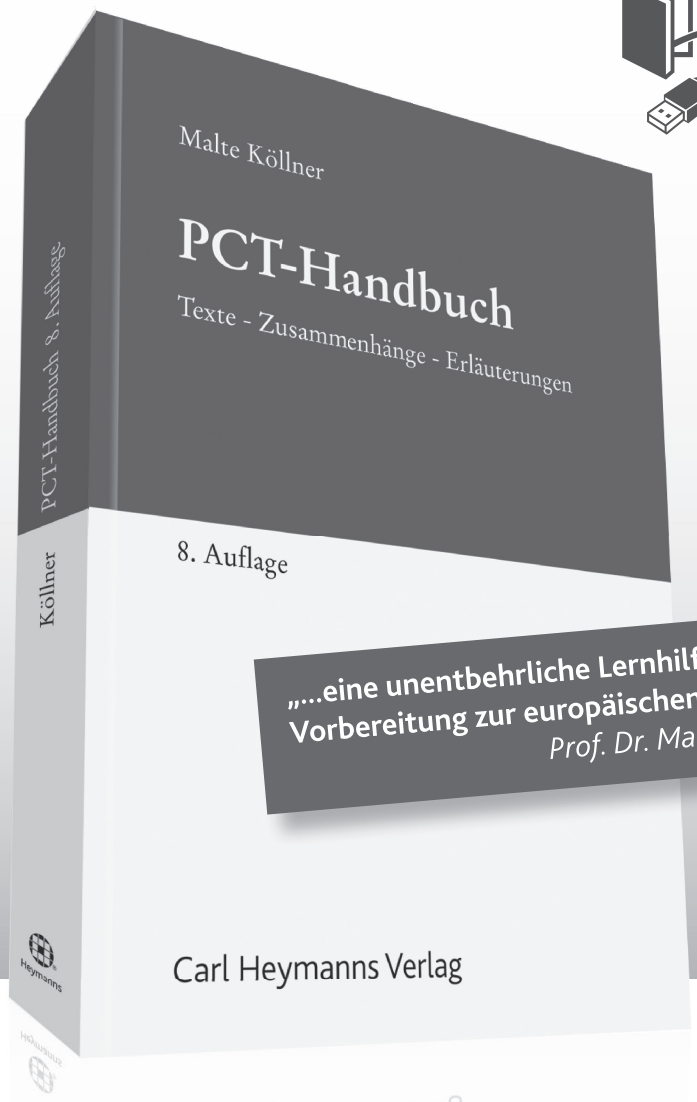

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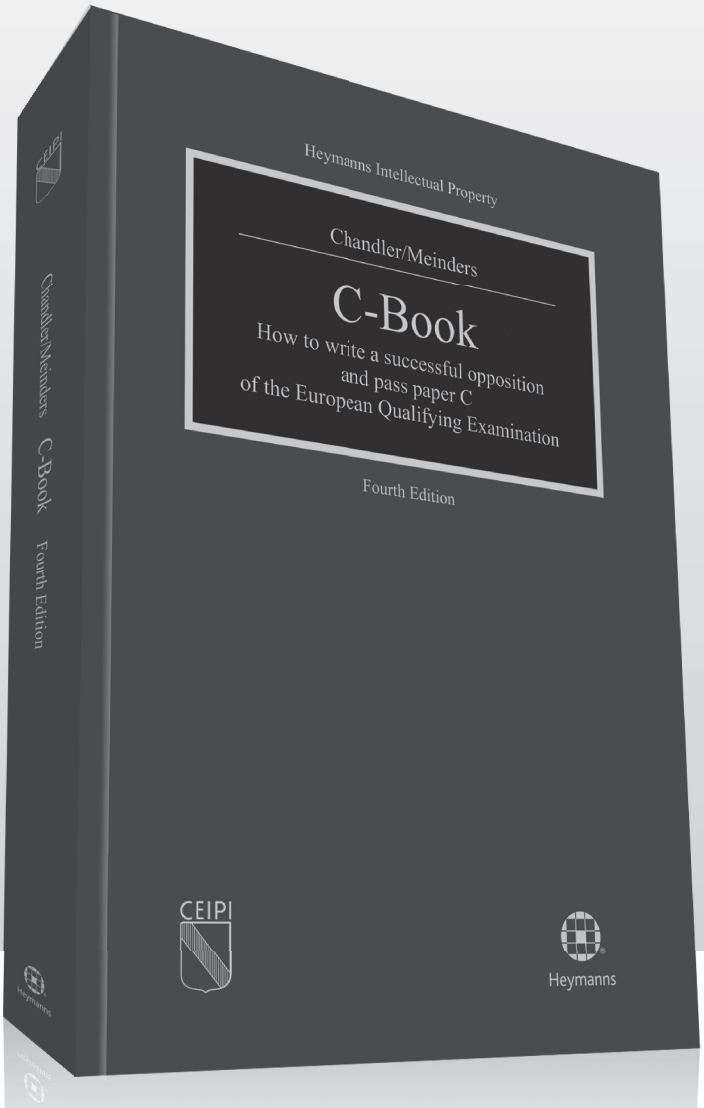

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