

Institut der beim Europäischen  
Patentamt zugelassenen Vertreter

Institute of Professional Representatives  
before the European Patent Office

Institut des mandataires agréés près  
l'Office européen des brevets

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## Editorial

T. Johnson (GB)

It is with no little regret that the Editorial Committee received the news that Alison Brimelow has announced that she does not intend to stand for a further term as President of the Organisation. She has brought new ideas and thinking to the running of the Office and the patenting of inventions in Europe. The Committee does not always agree with decisions made, for example on the new arrangements for divisional applications. More divisionals could be filed as a result, rather than fewer which would probably have been the case under the old system. It is some time before Alison Brimelow steps down, there are challenges to be met before then which we are sure she will meet with her customary vigour. These include the proposal for an introduction of deferred examination, the possible re-structuring of the

structure of fees paid by applicants, the debate on „raising the bar“ on patent „quality“, and many others. All these will have a bearing on the working lives of members of the *epi*, and no doubt Council will submit position papers at the relevant time. Our own President has been active too in trying to enhance the effect and efficiency of the *epi*, for example holding a Council meeting on a single day, liaising with National Groups, and consolidating contacts with sister organisations.

There is no time for complacency, and never a dull moment, but batteries must be re-charged, so we take this opportunity of wishing Alison Brimelow, Kim Finnilä and all our Members a restful, reflective and well-earned holiday as the holiday season approaches!

### Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionssausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **17. August 2009**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum 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 **17th August 2009**. Documents for publication should have reached the Secretariat by this date.

### Prochaine date limite pour epi Information

Veillez 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 **17 août 2009**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

## Bericht über die 66. epi-Ratssitzung Luxemburg, 23. Mai 2009

Seit jeher hielt der Rat eine eineinhalb Tage dauernde Sitzung ab – den gesamten Montag sowie Dienstagvormittag; hinzu kam ein geselliger Ausflug am Sonntag vor der Sitzung. Zum ersten Mal hat sich nun der Rat zu einer eintägigen Sitzung am Samstag getroffen, mit nachträglichem Sonntagsausflug, für diejenigen der Delegierten, die teilnehmen wollten. Trotz anfänglicher Zweifel bei einigen Teilnehmern konnte die Tagesordnung innerhalb eines Tages erledigt werden. Eine Meinungsumfrage unter den Ratsmitgliedern während der Sitzung ergab, dass die Mehrheit der Anwesenden eine Ratsitzung am Samstag einem sonstigen Wochentag vorzieht. Eine Konsultation im Extranet wird abwesenden Ratsmitgliedern ermöglichen, ihre Sicht der Dinge zum Ausdruck zu bringen.

Die Sitzung beinhaltete auch zwei Präsentationen von Herrn Ingwer Koch, Direktor *ad interim*, Internationale Rechtsangelegenheiten und Patentrecht des Europäischen Patentamts. Das Thema der ersten Präsentation war „Aufgeschobene Prüfung von europäischen Patentanmeldungen“, ein Vorschlag der deutschen, dänischen und holländischen Delegationen im Verwaltungsrat der Europäischen Patentorganisation. Der Verwaltungsrat wird noch ein Diskussionspapier für die interessierten Kreise herausgeben. Während der anschließenden Debatte schien es, dass eine kleine Mehrheit der anwesenden Ratsmitglieder nicht überzeugt war, dass eine aufgeschobene Prüfung notwendig ist. Es wird auf weitere Nachrichten aus dem Verwaltungsrat gewartet.

Die zweite Präsentation von Herrn Koch behandelte die Gebührenreform und die nachhaltige Finanzierung des europäischen Patentsystems. Die Ratsmitglieder wurden darüber informiert, dass der Verwaltungsrat auch hierzu ein Diskussionspapier erarbeiten wird. Es scheint, dass die Delegierten der Vertragsstaaten im

Verwaltungsrat derzeit die Meinung vertreten, dass eine allgemeine Erhöhung der Gebühren abzulehnen ist, dass aber die Gebührenstruktur überarbeitet werden könnte. Das EPA Finanzkomitee des *epi* wird diese Entwicklung weiter beobachten.

Der Rat hat Herrn Dana Marlin als Rats- und Vorstandsmitglied für Malta willkommen geheißen.

Der Schatzmeister hat den Jahresabschluss für 2008 sowie das Budget für 2009 vorgelegt, wobei letzteres auf 9.200 Mitgliedern basiert. Der Mitgliedsbeitrag bleibt mit 160 Euro unverändert. Das Finanzkomitee des *epi* billigte den geprüften Jahresabschluss für 2008 sowie das Budget für 2009. Der Rat erteilte mit eindeutiger Mehrheit den Mitgliedern des Vorstands im Allgemeinen sowie dem Schatzmeister im Besonderen die Entlastung für das Finanzjahr 2008.

Um die Ausgaben innerhalb des Budgets zu halten, wurden die Vorsitzenden der Komitees aufgerufen, die Anzahl der Treffen gering zu halten und die Arbeit der Komitees so effizient wie möglich zu gestalten.

Ein weiterer Vortrag wurde von Henk Hanneman, dem *epi* Direktor für den Bereich Ausbildung, gehalten. Die sehr informative Präsentation mündete unter anderem in eine Diskussion darüber, ob kontinuierliche berufliche Weiterbildung erwünscht ist. Herr Hanneman wird für die nächste Ratsitzung ein Papier zu diesem Thema erarbeiten.

Aufgrund eines Berichts des Redaktionsausschusses genehmigte der Rat mit großer Mehrheit die Restrukturierung der *epi* Website.

Weitere Komiteeberichte finden sich an anderen Stellen dieses Heftes oder auf der *epi* Website.

Die nächste Ratsitzung findet am 10. Oktober 2009 in Düsseldorf statt.

### epi Information 3/2009 – Themed edition

#### „The Patent System in the age of global economic decline“

We would greatly appreciate receiving your contributions on this topic.  
Please forward any contributions to the Editorial Committee  
epi Secretariat – P.O. Box 260112 – D-80058 München  
info@patentepi.com

**Submissions are requested as soon as possible.**  
The deadline for provision of articles is 17 August 2009.

## Report of the 66<sup>th</sup> epi Council Meeting Luxembourg, 23 May 2009

Historically, the Council has met over a day and a half – all Monday, half day Tuesday, with a social pre-meeting on the Sunday. For the first time, the Council met on one day, Saturday, with a post-meeting excursion on Sunday morning for those delegates who wished to participate. Despite doubts in some quarters, the Agenda was completed in one day. A straw poll of members during the meeting showed that the majority of those present favoured Council Meetings on a Saturday over any other weekday. A consultation over the Extranet will be held so that those members who were absent can add the views to the debate on Saturday – only working.

The meeting included two presentations from Mr. Ingwer Koch, Principal Director *ad interim*, International Legal Affairs and Patent Law, EPO. The first presentation was on Deferred Examination of European patent applications, a proposal from the delegations of DE, DK and NL to the AC. A paper has yet to appear from the AC for discussion by interested parties. Following a discussion after the presentation it seemed that a small majority of the Council Members present were not convinced that some form of deferred examination is necessary. Further news from the AC is awaited.

Mr. Koch's other presentation was on fee reform and sustainable financing of the European patent system. Again, the AC will, the meeting was informed, produce a fees' paper for discussion. It seems that the current view in the AC is that delegations of Member States are against any overall increase in fees, but the fee structure

could be re-examined. The epi's EPO Finance Committee will continue to monitor this topic.

The meeting welcomed Dr. Dana Marlin as the Council, and Board, Member for Malta.

The Treasurer General presented the accounts for 2008 and budget for 2009, which was based on 9,200 members. The membership fee would remain at 160 Euros. The epi Finance Committee approved the audited accounts for 2008 and the budget for 2009. The Council voted by a clear majority to release the Members of the Board in general, and the Treasurer General in particular, from liability for the financial year 2008.

In a drive to keep expenses within bounds, the chairs of all epi Committees were urged to exercise discretion on the Number of Meetings and to be as efficient as possible in the conduct of meetings.

There was also a presentation to the meeting by Hank Hanneman (NL), epi Director of Education. A very informative presentation resulted *inter alia* in a discussion concerning the desirability of Continuing Profession Education, CPE. Mr Hanneman will produce a paper on the topic for consideration at the next Council meeting.

Following a report by the Editorial Committee, Council approved by a large majority a re-launch of the epi Website.

Reports of Committees appear elsewhere in this Journal and on the website.

The next Meeting is in Düsseldorf, 10 October, 2009.

## Compte-rendu de la 66ème réunion du Conseil de l'epi Luxembourg, 23 mai 2009

Jusqu'à présent la réunion du Conseil durait une journée et demie – toute la journée du lundi et le mardi matin – avec un programme social le dimanche précédant la réunion. Pour la première fois, la réunion du Conseil s'est tenue un samedi et fut suivie d'une excursion le dimanche matin pour les personnes intéressées. Malgré des doutes de la part de certains membres, tous les points de l'ordre du jour ont pu être traités en une journée. Un vote informel des membres du Conseil lors de la réunion a montré qu'une majorité des personnes présentes préféreraient que la réunion ait lieu le samedi plutôt qu'un autre jour de la semaine. Une consultation des membres du Conseil via l'extranet permettra aux membres du Conseil qui étaient absents de s'exprimer sur cette question.

La réunion comprenait deux présentations par M. Ingwer Koch, Directeur *ad interim* du département „Affaires juridiques internationales et Droit des brevets“ de l'OEB. La première présentation avait pour thème l'examen différé des demandes de brevets européens, proposition faite auprès du Conseil d'Administration par les délégations de DE, DK et NL. Un document est en cours de préparation que le Conseil d'Administration proposera pour discussion aux parties intéressées. Au cours de la discussion qui suivit la présentation, il semble qu'une faible majorité des membres du Conseil n'était pas convaincue de la nécessité d'une certaine forme d'examen différé. On attend de nouvelles informations du Conseil d'Administration.

La seconde présentation faite par M. Koch concernait la réforme des taxes et le financement durable du système du brevet européen. Là aussi, le Conseil est informé qu'un document pour discussion, sur la question des taxes, est en cours de préparation par le Conseil d'Administration. Il semble que l'opinion actuelle au sein du Conseil d'Administration est que les délégations des Etats Membres sont opposées à une augmentation globale des taxes mais que la structure des taxes pourrait être re-examinée. La commission de l'*epi* pour les Finances de l'OEB va continuer son travail d'observateur en ce qui concerne cette question.

Les membres du Conseil souhaitent la bienvenue à M. Dana Marlin, nouveau membre du Conseil et du Bureau.

Le trésorier présente les comptes pour l'exercice 2008 et le budget pour l'année 2009, ce dernier étant basé sur l'affiliation de 9.200 membres.

Afin de mieux contrôler les coûts des commissions, les présidents des commissions de l'*epi* sont invités à réfléchir sur le nombre des réunions et à optimiser l'efficacité du travail de leur commission.

Le Directeur de l'*epi* pour „l'Enseignement et la Formation“, M. Henk Hanneman (NL) fit également une présentation très informative. Celle-ci fut suivie entre autres d'une discussion sur l'intérêt de la Formation Professionnelle Continue. M. Hanneman préparera un document sur ce sujet, lequel sera présenté au Conseil lors de sa prochaine réunion.

A la suite de la présentation du rapport de la Commission de rédaction, le Conseil approuve à une forte majorité la restructuration du website.

Les rapports des commissions sont publiés dans cette édition et sur le site web de l'*epi*.

La prochaine réunion du Conseil se tiendra le 10 octobre 2009 à Düsseldorf.

## Treasurer's report

C. Quintelier (BE)

### A. 2008 accounts

#### A.1 Income

A surplus of 9 % over the budgeted account was realized over the 2008 budget. This was due to the increase of the total number of *epi* members (9 038), a higher return on assets, a higher income on the budgeted education income, an increased number of *epi* students and less subscription write off.

The fact that *epi* students benefit from a 50 % reduction when they enroll for an *epi* seminar was again in 2008 beneficial for attracting more *epi* students. As seminars (CPE seminars and the CEIPI/*epi* litigation course) were well attended, there was a 45 % more income over the budgeted amount on education. Those seminars however caused an overall cost which consequently was also over budget. On balance the education post caused a deficit of 1 578€, which is acceptable. At this stage I would like to thank the *epi* secretariat staff who did an excellent job not only in the organization of the seminars, but also in taking care that the participants did timely pay. The policy not to admit participants, who did not pay beforehand, really proved this effect.

Due to the fact that, in particular in the second half of 2008, the DWS investment showed a considerable drop in the interest rate, less interest, than budgeted, were obtained on this investment. The financial market situation in 2008 caused a change during the year in the

investment policy and it was opted for short term investments with fixed rates, of course with guaranteed capital. In February of 2009 it was even decided to stop with the DWS investment formula and to invest the money in short and medium term investment, which provides a better return on investment. All together it was possible to obtain an acceptable return on investment despite the financial crisis.

#### A.2 Expenses

On the expense side the costs of committees increased substantially (36 %) over the past year and were 26 % above the budgeted amount. Several reasons caused this increase, so for example the travel costs for EPPC and Biotech meetings showed a substantial increase, mainly due to more members participating. The creation of the litigation committee, the higher number of members due to the increase of the number of EPC contracting states, all this caused more travel costs which had to be reimbursed. Also PQC showed an increase, which finds its origin i. a. in the REE discussions, the different working groups (study guide, on-line programs, working visits), and the nomination of the director of education. In combination with SACEPO and delegates, the committees had a cost of 224 910€, which is about 14 % of the total expenses. In comparison the costs for Council, Board and Presidium meetings were 351 323€, which is about 22 % of the total expenses. The question may thus be raised if those committee costs are still justified?

At least some efforts should be done to lower those costs, in particular the travel costs. The increase of Committee meetings was discussed with the finance Committee. It was decided that the treasurer should write a letter to the Committee chairpersons informing them of the costs of their Committee in 2008 and asking them to control the cost.

The raise of the costs for the personnel at the secretariat is mainly due to a legal arrangement leading to a payment (70 000€) to a pension fund for one of the employees. Also the hiring of two students who worked at the secretariat in 2008 caused some increase on the personnel costs.

The higher post costs were due to the elections. The amount initially budgeted for the office manager was spent for an audit, as agreed during the Munich council meeting in November 2008.

The amount on the post 5.2 (non-foreseeable) is caused by rate differences on the assets. For bookkeeping reasons they have to be booked, but in reality they can be considered as a fictive expense in 2008.

## B. 2009 Budget

Contrary to what had been agreed with the firm who did the audit at the secretariat, they have sent their invoice in 2008 rather than in 2009. Consequently the costs for the audit were booked in 2008, this post can then be removed from the 2009 budget.

After discussion with the finance Committee the 2009 *epi* budget has been modified.

### B.1 Income

The subscription income is now based on a number of 9,200 *epi* members leading to an income on subscription of 1 472 000€. The changes in the investment policy caused an adaptation in the income from investments, which now has no longer DWS investments but a post (4) called other interest. The organization of a Mock EQE in Munich and courses to be given by the „trained trainers“ in the new contracting States will provide an estimated income of 100 000€.

### B.2 Expenses

The reserved amount for SACEPO was reduced by 3 000€ which seems justified in view of the 2008 expenses. This amount was added to the Treasurer's budget, which is needed in view of the expanded co-operation between the EP Academy and *epi*.

In the secretariat budget several changes were introduced. A reduction of 1 500€ on phone costs, 5 000€ on office supply and 3 000€ on furniture.

As the office manager could not be found, a 20 000€ was deduced and allotted to a „head hunter“ (4.14), which should be hired to find an office manager. In view of a possible relocation of the *epi* secretariat, a sum of 125 000€ has been budgeted (4.15).

On education a cost of 110 000€ is budgeted. The budgeted promotional activity (5.3) was reduced by 5 000€.

## *epi* Home Page

### News Section

We wish to provide information quickly and unofficially in particular as to

- the EPO,
- national decisions,
- other news of interest to *epi* members

Please support our efforts and

**send any such information in the form of summaries in one of the three official languages to:**

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## epi Balance Statement on 31st December 2008

### Assets

	€	<u>2007</u> T€
<b>A. Fixed assets</b>		
I. Intangible and tangible assets		
Office machines and equipment, Software	1,-	—
II. Financial assets		
Securities portfolio	<u>1.215.881,40</u>	<u>1.707</u>
	<u>1.215.882,40</u>	<u>1.707</u>
<b>B. Receivables</b>		
I. Others current assets	<u>102.645,65</u>	<u>97</u>
II. Bank & Cash (incl. money deposits)	<u>1.767.944,52</u>	<u>1.062</u>
	<u><u>3.086.472,57</u></u>	<u><u>2.866</u></u>

### Liabilities

	€	<u>2007</u> T€
<b>A. Net assets</b>		
as of 01.01.2008	2.520.610,33	2.242
results for the year	68.736,61	278
	<u>2.589.346,94</u>	<u>2.520</u>
as of 31.12.2008		
<b>B. Debts</b>		
I. Provisions	<u>149.800,00</u>	<u>60</u>
II. Liabilities		
1. Deliveries and services	50.121,54	35
2. Others	<u>297.204,09</u>	<u>251</u>
	<u><u>347.325,63</u></u>	<u><u>286</u></u>
	<u><u>3.086.472,57</u></u>	<u><u>2.866</u></u>

## Expenses and Income

for the period from 1 January to 31 December 2008

	2007	2008	
	T€	€	€
<b>I. Income</b>	1.380	1.427.120,94	
1. Subscriptions	60	53.448,79	
2. Bank Interests	40	<u>63.926,77</u>	1.544.496,50
3. Others			
<b>II. Expenses</b>	506	584.027,47	
1. Meetings	102	130.120,23	
2. Other performances	25	25.149,39	
3. President	32	40.281,81	
4. Treasurer and Treasury	534	658.247,82	
5. Secretariat	3	<u>37.933,17</u>	1.475.759,89
6. Extraordinary expenses			
<b>III. Surplus of receipts</b>	<u>278</u>		<u>68.736,61</u>

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# Report of the EPO Finances Committee

J. Boff (GB)  
Chairman

A fee strategy debate started at the March Administrative Council (AC) and will require a lot of attention this year. The Office will be consulting widely on sustainable financing of the European patent system.

EPO Paper CA/72/09 and its many annexes present some overall discussion on fee policy, and CA/59/09, CA/62/09 and CA/51/09 make some contribution.

I quote from CA/64/09 which summarises the results of the AC discussions and comment below: –

34. *After a lengthy debate during which the delegations stressed the quality of the Office's preparatory work, the chairman, noting that areas of broad consensus had emerged, summed up as follows:*

### 35. I. Perspective

*The delegations agreed on the need to take account of the economic and financial context in Europe and worldwide. That meant not adding to the financial burden on industry, and that the Office had to master its costs in order to assure its future.*

COMMENT – Good news.

### II. Tackling costs the priority

*The Office's priority had to be to increase output and productivity, setting itself annual target figures. Salary trends had to be correlated with productivity, and discussions initiated on reforming the „social package“ (pension and social-security schemes).*

COMMENT – Good news.

### III. IFRS

*The delegations took the view that whilst the use of IFRS as the „generally accepted accounting principles“ under Article 42(1) EPC could not be called into question, thought should be given to how they were applied and what conclusions were drawn. The main aim was to maintain and strengthen the Office's operational capacity. That meant, in particular, an active HR management policy and investment in electronic tools. Lastly, the delegations felt that negative equity of about 80% could be considered acceptable.*

COMMENT – epi have been saying to the EPO for some time that IFRS does not make decisions, it presents data from which decisions can be made.

### IV. Fees

*The delegations were against any overall increase in fees, but prepared to re-examine their structure. Any fee increase had to be preceded by lower costs and higher productivity, and the balance kept between procedural and renewal fees.*

COMMENT – Good news on the overall increase in fees. However the balance issue needs to be investigated. It is not clear whether „renewal fees“ means renewal fees

on granted patents or includes renewal fees on pending applications.

### V. Structures and behaviour

*The delegations recommended studying, as part of the general objective of „raising the bar“, any measure likely to facilitate the Office's work by easing, streamlining and simplifying procedures and processes. Also, fee adjustments could be used to counter procedural abuse by users.*

COMMENT – This is good news if the fee adjustments are chosen with appropriate regard to applicant behaviour, but this has not happened before. The claims fees fiasco occurred despite the user community making it clear that the increase in claims fees would result in extreme responses from applicants. It also appears that no account has been taken in CA/35/09 (Basic Assumptions for the Business Plan and Budget 2010) of the increase in filings in 2010 that will be a consequence of the transitional provisions in CA/D2/09 introducing deadlines for filing divisional applications. This makes budget forecasts unreliable.

eipi continues to press for greater involvement in the decision making process.

### VI. Harmonisation of renewal fees

*One idea here was to re-examine the minimum amounts, with a view to bringing their levels closer to the thresholds required. The ongoing Community patent discussions could have a positive effect. Amending the distribution key was out of the question.*

COMMENT – This is very tricky. Harmonising fees may affect Member States ability to support innovation in their territory, and may have a negative effect in view of the widely different populations of the Member States. For example, if the same harmonised fee applied to Luxembourg and Germany the cost per customer paid by users would vary enormously leading to even greater differences in validation rates. Similarly the Community patent discussions could have some nasty effects on national patent offices.

*36. In the light of that, the Council asked the Office to make, as soon as possible, specific proposals for the different areas identified and in line with the approach outlined.*

37. These proposals would be examined in accordance with standard Council procedure, i.e. passing via the appropriate committee (Budget and Finance; Patent Law; Technical and Operational Support) for the topics in question.

38. In line with its brief, the Council's Board would monitor the Office's elaboration of proposals meet-

ing these recommendations, to facilitate the Council's subsequent decision-making.

COMMENT – The next BFC and CPL meetings will be busy.

It should also be noted that the Office will be producing a paper based on CA/51/09 [deferred examination] for discussion at the Committee on Patent Law. Such a paper will have financial effects. A large part of the Office's negative equity is prepaid fees for examination [~28% at end 2007]. A deferred examination system, over time, could remove this negative equity and so make the accounts look less alarming to those more concerned with numbers than facts. However, it will also

affect cash flow and interest income from the amounts on deposit. The effects are not easy to separate and will need a great deal of thought when the Office produce their paper.

The BFC meeting in May approved some proposals concerning implementation of Supplementary International Searches under the PCT. Although these proposals are largely beneficial as a long term aim, there is basis to believe that it can only be detrimental to performance of the EPO in the near term.

In summary, the current economic crisis, and the perception within the Office that their finances need attention, may lead to much debate in the near future.

## Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE)  
Chairman

This report covers the period following my last report dated 25.11.2008.

### REFERRALS TO THE ENLARGED BOARD OF APPEAL

Referrals can be downloaded from the EPO website: <http://www.epo.org/patents/appeals/pending.html>

Third parties have the opportunity to file written statements (*amicus curiae* briefs) in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal. These can also be found on the EPO website.

#### 1. G4/08 – „Language of the proceedings“:

The Legal Board of Appeal 3.1.01 referred some following points of law to the Enlarged Board of Appeal with an interlocutory decision of 8 December 2008 in case J 8/07. The questions relate to (i) the possibility of filing, on entry into the regional phase before the EPO, a translation of the application into one of the other EPO official languages, (ii) the possibility for the EPO to use, in written proceedings an EPO official language other than the language of proceedings used for the application, and (iii) if applicable, the criteria to be applied.

The EPPC has prepared a brief that has been approved by the Board and sent to the Registrar of the Enlarged Board of Appeal on 27.04.2009.

#### 2. G3/08 – „Software patents“:

On 22.10.2008, the President of the EPO referred a set of questions relating to Computer-Implemented Inventions to the Enlarged Board of Appeal.

As instructed by the Council, the EPPC has prepared a position paper that has been approved by the Board and sent to the Registrar of the Enlarged Board of Appeal on 27.04.2009.

#### 3. G2/08 – „Dosage regimen“:

The EPPC has prepared a position paper that was filed on 20.03.2009.

### LIAISON SUB-COMMITTEE

#### 4. Annual meeting with the VP of DG1

A meeting with Mr Hammer, Vice-President of DG1, was held on 29.01.2009. Topics discussed included:

- Personal contacts between examiners and applicants/representatives: Mr Hammer confirmed that they are encouraged when they allow to move more easily and to reach the conclusion faster.
- Rule 164: Mr Hammer conceded that the possibility to pay further search fees was deliberately removed. The intention was not to advantage those applicants over those who have the EPO as ISA. However, the EPO might consider an amendment of R. 164 if there are severe problems.
- Rule 71(3): the EPO has ideas on how to amend it. [Note: this subject has indeed been included in the

agenda of the SACEPO/WPR meeting of 05.06.2009]

- Documents filed during oral proceedings: (i) *epi* mentioned that they should be accessible in the public file on the next day or so; this was agreed. (ii) the printers have difficulty in reading some manuscript amendments; *epi* mentioned the lack of printers in most attorney rooms.
- Customer service.

#### PCT SUB-COMMITTEE

##### 5. PCT Working Group

The PCT Working Group met in Geneva from 04.05.2009 to 08.05.2009. All working documents and the meeting report are available from the WIPO website: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=17449](http://www.wipo.int/meetings/en/details.jsp?meeting_id=17449)

#### COMMUNITY PATENT SUB-COMMITTEE

##### 6. Community Patent Regulation

A new draft Regulation dated 07.04.2009 has been circulated to the EPPC members.

#### EPC SUB-COMMITTEE

##### 7. Report from AC117

In a nutshell, the AC adopted a proposal to amend R. 36 (divisionals) and some other rules, essentially trying to improve the quality of the search and imposing a mandatory response to the written opinion.

The AC took note of a proposal to introduce a system of deferred examination, made by DE, DK and NL, which will be further discussed in the CPL. [Note: this subject has also been included in the agenda of the SACEPO/WPR meeting of 05.06.2009]

#### LABELLED MEMBERS OF EPPC:

During the last EPPC meeting, on 11.03.2009, the following elections took place:

Ms Skeppstedt: vice-chair, in charge of the Community Patent sub-committee;

Mr Lampe: vice-chair, in charge of the EPC sub-committee; and

Mr Samuelides: vice-chair, in charge of the PCT/Trilateral sub-committee.

## Report of the Harmonisation Committee

F. Leyder (BE)  
Secretary

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

1. The 13<sup>th</sup> Session of the Standing Committee on the Law of Patents (SCP) was held in Geneva from 23<sup>rd</sup> to 27<sup>th</sup> March 2009. The Chairman's Summary is available from the WIPO website. ([http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=17448](http://www.wipo.int/meetings/en/details.jsp?meeting_id=17448))

This session dealt mainly with four topics, namely dissemination of patent information, exceptions from patentable subject matter and limitations to the rights, patents and standards, and Client-attorney privilege. The only topic discussed which met with general approval was the „privilege“ issue, with only one Member State (Columbia) and one NGO (Third World Network) against progressing this.

Our delegate, John Brown (who also chairs this committee), reported that it was a very tedious meeting, with a massive amount of time lost whilst various groups had meetings; he made a statement on behalf of *epi*, welcoming the fact that SCP is

looking very seriously at the problems caused by the non-uniform privilege provisions around the world.

In a nutshell, the official report mentions that SCP reaffirmed that the non-exhaustive list of issues identified at its last two meetings would remain open for further elaboration and discussion at its next session. It also decided to include two further issues in the list, namely „patents and the environment, with a particular attention to climate change and alternative sources of energy“ and „patent quality management systems“.

2. At the suggestion of the SCP, the 2008 General Assembly of WIPO endorsed a recommendation to convene in 2009 a conference on issues relating to the implications of patents on certain areas of public policy, such as health, the environment, climate change and food security. The Conference on Intellectual Property and Global Challenges will be held on 13<sup>th</sup> and 14<sup>th</sup> July, 2009, at the Centre International de Conférences in Geneva. *epi* will be represented by its President and by the Secretary of this committee.

## Report of the Litigation Committee May 2009

E. Lyndon-Stanford (GB)  
Chairman

### The Officers

Dr. Ferenc Török (HU) has been elected Vice-Chairman and Dr. Rainer Beetz (AT) has been elected an Associate Member. Associate Members receive committee papers and can participate in discussions but cannot vote and must pay their own expenses for attendance at meetings. Dr. Gilbert Voortmans has been appointed the liaison member for the Editorial Committee.

### LitCom meetings

In order to avoid the cost and consumption of time in holding formal meetings, the Committee has been experimenting with e-mail debates, an Extranet debate and a mixed Extranet and e-mail debate, but no completely satisfactory procedure has yet been found.

### The European and Community Patents Court and Court Statute, draft agreement

The latest draft agreement is 7928/09, dated 23<sup>rd</sup> March 2009. For the May 2009 Board meeting, the Litigation Committee did not have time to fully study and debate the draft agreement but made initial comments.

We noted that Article 15(a)(2)(b) has not been amended so that there can be split jurisdiction. We

noted that the Court Rules of Procedure will no longer be attached to the agreement and will be adopted by the Mixed Committee (Article 22).

We considered that present Article 28 (representation) is the best we can achieve. The language of Article 28(2) has been clarified and it is clear that EPA's „with appropriate qualifications“ will be able to represent, i.e. the EPA's need not have any representation rights in their own countries. The Rules of Procedure will determine the extra qualification an EPA must have. Article 28(2) is an important provision and would be susceptible to attack by attorneys-at-law. The conclusion of the Board was that it was essential for EPA's to lobby their national institutes and their government representatives, which is a task the individual members of the Board have assumed. The right of patent attorneys to assist has been re-inserted, Article 28(2a). The definition of what a patent attorney is will be in the Rules of Procedure.

Article 58 specifies how the opt-out operates in the seven year transitional period. This has not been changed although the *epi* requested that the opt-out should not be limited in time. The opt-out is for EPC applications filed or EPC patents granted before the entry into force. If patentees wish to continue to use national courts, they will have to file national patent applications.

## Report of the Online Communications Committee (OCC)

R. Burt (GB)  
Chairman

Two meetings have been held of the OCC with the EPO team lead by Mr François Knauer since the November 2008 Council meeting.

### Update on statistics

1) In the latest available figures (February 2009), 58 % of all filings are being carried out online (up from 55 % in September 2008). This headline figure

breaks down as 62 % of PCT applications, 54 % of direct EP applications, and 59 % of Euro-PCT applications filed online.

2) Since the launch of the opposition plug-in on March 5 2009, a total of 156 submissions had been filed online in opposition proceedings been made in this way by April 26. It was clarified that these numbers do not necessarily represent complete oppositions filed online. 75 submissions were filed in appeal

proceedings by April 17 2009 using the 1038 mechanism.

- 3) Version 4 of the online filing software is currently being used for 94 % of all filings. Users are reminded that version 3 will cease working on October 1, 2009.
- 4) Online fee payments also show slow continued growth: 35 % of fee payments were made online in March 2009 (up from 33 % in October 2008). 12 % were made using diskette submission (up from 9 %) and 10 % using automatic debiting (up from 9 %).

### New Product Status

- 1) *eOLF Gateway*: This will provide a connection between the data in users' patent management systems (PMS) and the online filing software. The EPO development team is in contact with three providers of PMS systems and will provide certification to approved systems.
- 2) *Updates required for April 2009 fee changes*: Mr Knauer apologised for the slight delay (about 5 working days) in catering for the April 1 fee changes, the delay being attributable to the complexity of some of the changes. The fee changes are now fully taken into account in the software.
- 3) *Online Filing Browser Version (Portal Version)*: This will enable the user to employ a standard browser to communicate with online filing software hosted on an EPO server. This is planned only for standalone installations and there is no plan for a networked or group version. There is also no current plan to integrate with PMS systems. A pilot test will be run with a single company over the summer, with plans for general release in September 2009.
- 4) *Secure Access to Mailbox and Unpublished Files*: The objective is to have a mailbox which will receive electronic communications directed to the representative. Problems arise in ensuring confidentiality while also allowing other users from the same firm to access this mailbox, as well as in managing the data relationship between the application file and the smartcard owner (e.g. if a smartcard owner changes company but responsibility for an application is not to be transferred). It is envisaged that one mailbox will be provided per smartcard user, with administrators in a firm being permitted to assign redistribution and access rights among smartcard users. Implementation will not occur before 2010 and will probably occur as part of the SPP initiative (see below).
- 5) *Machine Translations*: The objective of this programme is to provide translations allowing comprehension of technical content, rather than providing legally effective translations. The current status is that machine translations are available into English from German, French, Italian and Spanish specifications via Espacenet (when viewing the text of the

description or claims use the „Translate this text“ button).

Work is continuing on increasing the number of languages available for machine translation. Rather than using English as the sole „pivot language“ (into and from which all other languages are translated) it is now intended to also use French and German as pivot languages.

### Recent Problems encountered by epi Members

- 1) *Upgrading to version 4*: The EPO commented that problems in upgrading to version 4 of the OLF software were almost always solved if the existing installation was first updated to version 3.20. Support staff in the EPO are fully aware of this issue and ready to advise users.
- 2) *Vista compatibility*: Problems were reported by members using Windows Vista, as compatible smartcard drivers and libraries were not originally provided on the installation CD. The EPO confirmed that all new CDs now contain all of the required software for Vista.
- 3) *Register Plus*: The timeliness of documents being available for viewing/download after the updating of the Register Plus data was again raised. EPO staff advised that the Register database is being fully rebuilt which will bring the two systems into line.
- 4) *Translations from non-European languages*: It appears that Examiners have access to machine translations of Asian language documents (e.g. Korean) and sometimes rely on such translations without supplying the applicant with the translation. This is due to EPO personnel having restricted access to the facilities of foreign offices. It may require agreement at an inter-office level to allow distribution of the translations.
- 5) *Technical Support*: OCC members reported difficulties and slow responses from EPO support. Online filing is now, for many users, a „mission critical“ part of their practice. The EPO confirmed that if a problem is preventing a user from filing or from meeting a deadline, it is viewed as critical and should be immediately escalated to Level 2 support where it will receive expert attention. It was suggested that if support problems were encountered, this could also be reported to the user's Key Account Manager who would help with EPO support. It was reported that, in future, the intention was to have more comprehensive and topic-based web support to assist in resolving common queries.
- 6) *Confidential documents available for viewing*: An example was given of a PACE request being publicly available, when such requests are supposed to be excluded from the public file. The error would appear to have arisen when the formality officer failed to flag the document as private. The EPO team suggested that they should prevent public and non-public submissions from being simultaneously filed, with PACE requests being flagged within the OLF

software as being non-public, and the EPO team will work on this.

- 7) *Email Correspondence with Office Personnel*: An instance was noted where an EPI Member was repeatedly unable to make telephone contact with an EPO examiner responsible for a file. The Member was eventually advised to contact the examiner by email and was given the email address to do so, but no response or acknowledgement of that email ever appeared. The EPO team confirmed that emails to the office are not tracked or monitored to ensure that the recipient takes action. The advice given was to use the 1038 submission mechanism since this at least ends up on the file.
- 8) *Colour Drawings*: The prospect of submitting colour drawings was raised, noting that foreign offices such as South Korea, allowed such drawings. While this would involve a rule change as regards application drawings, the EPO team confirmed that one could always use the pre-conversion archive to include the colour version of black-and-white drawings, and added that the opposition divisions were considering the submission of colour documents and evidence.

### **Focus Group Development**

The formal introduction of a focus group to work on online and electronic developments, based loosely on the present EPO/OCC meeting format has previously been suggested. A revised proposal is to be submitted for approval by the EPO management, including a structure which will allow the EPO team to make commitments to expenditure and investment of resources on behalf of the Office.

### **Future Patent Tools (FPT) and Single Patent Programme (SPP)**

Mr Knauer presented an update on Future Patent Tools project. The FPT proposal was reviewed internally in the EPO in February. Changes were suggested to include a greater concentration on the underlying business processes, development of the tools to meet business objectives, and a basic review of the underlying patent granting process itself.

The response is a new project which has been proposed with the goal of ensuring that the EPO can increase its efficiency and can respond more quickly to changes, while still maintaining the quality of its searches in the future. The new proposal is the Single Patent Programme (SPP).

The main elements of the SPP will be team working, collaboration, and direct communication between examiner and applicant. It is also intended to increase collaboration between examiners in the IP5 offices (EP, US, JP, KR and CN). The envisaged tools will include a common workbench accessible by both examiner and applicant allowing collaborative proposals to be worked on at all stages. The SPP proposal will be defined in more depth before going forward to an internal EPO review and approval process. The tentative timetable for release of the first elements is 2010.

### **International Collaborative Examination (ICE) presentation from IBM**

Mr Burt introduced an IBM presentation for a proposed tool (ICE) for use by patent offices. The tool allows examiners in different patent offices to share the results of their searches and examinations of counterpart patent applications.

Each examiner updates a shared workspace with details of search citations, objections raised, a summary of the current claim amendments, etc. The result is that a more unified approach to examination is achieved across different offices, with the applicant being presented with the best art earlier. Each examiner will of course continue to apply the references in a manner consistent with the law of that jurisdiction.

The ICE proposal is built on the premise that any such tool should give examiners access to the information they need using the tools they would like to see in front of them. The presentation has been given to, or will soon be given to, each of the other IP5 offices as a suggestion for development of common shared systems.

### **Key Account Managers**

The EPO gave a brief update on the Key Account Managers (KAMs) – a team responsible for liaising with the heaviest users of the online systems of the EPO. The technical team has now merged with the marketing team and there are 5 full-time and 2 part-time KAMs. In 2008 the KAMs provided 40 days of training to a total of about 500 users.

It was suggested to the EPO team that often the people most familiar with their KAM contacts are the paralegals and IT staff; in many cases the attorneys were entirely unaware that their firm had a KAM as an EPO contact point. It was suggested that a letter might be sent to the attorneys (re)introducing the assigned KAM to raise awareness of this resource.

## Report of the Patent Documentation Committee (PDC)

Peter Indahl (DK)  
Chairman

A Trilateral Round Table meeting on patent documentation was held on 28 October 2008 in Stockholm where Mr. Bart van Wezenbeek represented PDG. Being the first meeting of this kind the contents were rather general. USPTO, JPO and EPO presented their patent information policies and asked for comments from the users. PDG expressed interest for an Internet publication server, and asked whether users could obtain access to search in the same prior art as the examiners.

The annual SACEPO/PDI meeting with the EPO was held on 19 March 2009 in Vienna. Ms. Gassner, Mr. Langenskiöld and Mr. Indahl represented PDG. The new Principal Director Richard Flammer gave a most positive impression. The EPO's Principal Directorate Patent Information has been moved from DG4 (General Administration) to DG5 (Legal and International Affairs).

At IP5 meetings (trilateral + CN and KR) the offices have begun to look into their patent documentation bases in order to clarify whether a common documentation base may be established. The EPO is active in this respect, but it can be expected to take time to obtain results. JPO reported a decline of 10 to 15 % in Japanese patent applications filed in December and January compared to the same months in 2007-08.

INPADOC: Patent data from Hong Kong are now included. Brazilian patent data are being retyped or corrected. Brazilian data have errors in the patent family information (also data from South Korea and Argentina are known to have errors in the patent families). Please be aware that patent data are not perfect data. Although the EPO is doing its utmost to ensure a very high level of quality in the data, errors do occur, also in the patent family data. But we need to be aware that the data are not perfect. If a country like Brazil is important, then you will need to redo the relevant patent family searches.

*Esp@cenet*: The new search window on the front page of [ep.espacenet.com](http://ep.espacenet.com) is for smart searching and allows date ranging and proximity operators and combined search queries (an example: *ta = „mouse trap“ AND pd <= 20020118 AND ap=cn* provides Chinese patent and utility models published on or before 18 January 2002 and having mouse trap in title or abstract). More detailed information is provided on *Esp@cenet*.

Automatic translation of patents (machine translation on *Esp@cenet*) is now in place for German and Spanish. Work is in progress for dictionaries for French, Swedish, Italian and Portuguese. The next languages are expected to be Greek, Dutch and Finnish. The plan is develop the system with German and French are core languages in addition to the present English core language.

Our request for an EPO Internet Publication Server was discussed and Mr. Flammer will obtain views from the EPO examiners etc. on the matter and then our proposal will be debated again.

Of other news we may report that the EPO has made progress on translation of Asian patent documents. The internal EPO search tools now include machine translated English full text of 2.7 million Japanese documents (out of a total of 10.2 million). Abstracts of all Chinese Utility Models from 1985 to 2007 are being translated manually into English.

WIPO has proposed to revise the IPC8 system in order to phase out the „core level“ classification and replaced it by the main group from the advanced level classification. WIPO has planned a seminar for users in February 2010 and following this, the new structure of the IPC is to be adopted.

WIPO and IP5 are working on a common classification system. The idea is to modify the IPC classes so that some features of the US classification system and of the Japanese classification system are integrated into the IPC (called a hybrid classification system). It is a long-term object to complete this, at least 10 years are considered for the project.

Patentscope is to be modified during 2009 to include most of the correspondence in the international phase of PCT applications, at least to the extent the documents may be obtained from the ROs and the ISAs.

The EPO has changed the patent family concept applied in DOCDB, but the new concept is unfortunately not applied to the complete set of patent documents, but only to documents added during the last year or so.

The French Patent Office, INPI, has in April 2009 opened for free access to legal status information. And they plan to open for file inspection in the second half of 2009 and to online access to the historical archive of French patents (1791-1844) in the first half of 2010.

# Report of the Professional Qualification Committee (PQC)

F. Schweinzer (AT)  
Chairman

PQC had a regular meeting on March 23, 2009 in Munich, where also our president Kim Finnilä and Chris Mercer were present for part of the time.

## 1. EQE 2009

A first reaction from candidates and tutors was that this year the papers were more difficult than in previous years (or only 2008?). In some respect now the EPO wants *epi* to contribute financially. A special topic was the Award Ceremony, which was planned to cost EUR 45,000. As nothing has been reserved in our budget, *epi* denied any contribution. Thus the award ceremony was cancelled at least for this year.

## 2. REE and IPREE

Our members in the new created Examination Supervisory Board are Chris Mercer and Francesco Macchetta. Chris Mercer gave a presentation of the latest status. The IPREE is not yet finally decided, however it has already been agreed that the requirement for the qualification is a 3 years university degree. Further the first pre-examination will most likely be only in 2012. There are ongoing discussions about the content of such pre-examination and now it is thought to have a short question relating to preparing an application (small paper A question) and further legal questions (similar to a „light“ paper DI) (by Chairperson PQC and Chris Mercer).

## 3. Memorandum of Understanding (Joint activities CEIPI-epi-EPO)

A meeting with the European Patent Academy was held on March 4, 2009. The main result was that due to restricted resources from the EPO (cut of available „examiner days“ by 50%) only a few projects can be carried out. The main project now is the new study guide which shall be available in the near future. Also an

e-learning program for paper DI has been established and for paper A is in progress. A brochure „My preparation for the EQE“ with the personal experiences of some 20 candidates who passed the EQE is in preparation. In addition a mentors meeting shall be organised.

## 4. CPE

A „train the trainers“ seminar for new countries now has started in March with the first module and 23 participants. The next modules will take place in May and June. Starting in autumn the candidates shall conduct seminars in their own countries to train their colleagues on the EPC.

A proposal for seminars to be held in the next time is prepared by the PQC working group on CPE.

## 5. epi tutorials

The PQC Working Group on *epi* tutorials has studied the situation with questionnaires to past tutors and past tutees. It was now decided to use the papers of the current year for the autumn tutorials and have them later, e.g. in December to allow the tutors to participate in the tutors meeting, which takes place normally mid November and covers the examination of the current year.

Further a special tutorial was held in Helsinki in November and December 2008 in the form of a mock EQE and a subsequent meeting with tutors discussing the taken papers. A further mock EQE is planned for September 2009 in Munich and probably again in Helsinki.

## 6. European Patent Academy

It was decided to have a closer look to the activity of the European Patent Academy by the PQC chair.

## epi educational events

H. Hanneman (NL)  
Director of Education

In the second part of this year the following educational events are scheduled or are expected to be scheduled.

### EQE-related:

- *Mock-EQE* held at Munich, September 7-9, 2009 open for all *epi* student members and all other EQE candidates. Tutoring sessions: Munich, October 19-21, 2009.
- *Mock-EQE* held November 10-12, 2009 at Helsinki, Finland open for in particular Finnish *epi* members and other EQE candidates. Tutoring sessions: Helsinki, January 20-22, 2010.

The same papers will be used at both mock EQES.

The mock EQE provides participants with the chance to sit the EQE exams under exam-like circumstances. The participants will sit the various exams (A[Ch], A[E/M], B[Ch], B[E/M], C and D) in the same order as the real exam and will be given exactly the same time to sit the paper. The exam papers will be selected from previous EQE exams and are chosen for their didactic value. The papers will be reviewed by experienced *epi* tutors. About one to two months after the mock EQE the tutors will discuss the papers in small groups. Each participant will receive personal feedback on his/her work.

Participants may sit any combination of papers.

- *Autumn epi tutorials*: privately writing one or more of the EQE papers of 2008 and/or 2009 and having papers reviewed and discussed by experienced *epi* tutor; registration by September 25, 2009 at the *epi* Secretariat. For further details see elsewhere in this issue of *epi* Information.
- *Meeting for supervisors of European patent attorney trainees*, held November 12 and 13, 2009 at Berlin

Training to become a qualified Representative before the European Patent Office (a „European patent attorney“) is a very demanding undertaking. Challenges during the training period are numerous. For the trainee, this first of all means getting intensively engaged in acquiring all relevant legal aspects related to the prosecution of European (and national) patent applications and requires high personal commitment. On the other hand, this training also demands dedicated support from the side of the trainee's supervisor, who assesses the trainee's daily work and determines when the trainee can sit the European or national exams and – even more important – can be left on his or her own to represent a client's interest. Many supervisors of European patent attorney trainees are not completely aware of what needs to be done in order to make sure his or her trainee will become a successful patent attorney.

The European Patent Academy, in cooperation with the *epi* and CEIPI, will be holding a meeting for supervisors of European patent attorney trainees.

This meeting is dedicated to supervisors who prepare trainees for entering the profession of a Representative before the EPO, and aims at providing guidance and information on how to structure a trainee's preparation period including the preparation for the EQE. A number of existing supervising models will be presented in order to give an overview of various forms of support and training. Emphasis will also be given on how to master the challenging double act of dealing with a high amount of daily work and, in parallel, preparing for the examination. The meeting will also give opportunity for an exchange of best practices, address the question of how much time and effort needs to be invested by supervisor and trainee, and other aspects to ensure that those who enter the profession will be adequately prepared.

### Continuous professional education

- *epi seminar* on „PCT – filing, prosecution, entry into the regional EP phase“ at Eindhoven, the Netherlands on November 20, 2009. Speakers from WIPO (to be announced) and EPO (Mr. Rob Cramer).
- *epi seminar* at Lisbon, Portugal (to be confirmed)
- *epi seminars for experienced national patent attorneys*

The extensive 14 days „Train the Trainers“ seminar for experienced national European patent attorneys organised by the *epi* in cooperation with the EPO Academy has been attended by 23 participants from the following countries: Bulgaria, Croatia, Estonia, Hungary, Latvia, Lithuania, Poland, Rumania, Slovenia and Turkey. The seminar ended on June 19, 2009.

The following participants have been certified „national trainers“ on June 19th, 2009:

Mr. Samuil Benatov (BG), Mrs. Radislava Kosseva (BG), Mrs. Emilia Vinarova (BG); Mr. Tihomir Dragun (HR), Mrs. Tatjana Sucic (HR); Mr. Mart Enn Koppel (EE), Mr. Margus Sarap (EE); Mr. Zsolt Szabo (HU); Mr. Jevgenijs Fortuna (LV); Mrs. Liudmila Gerasimovic (LT), Mrs. Jurga Petniunaite (LT); Mrs. Lidia Chlebicka (PL), Mrs. Krystyna Chochorowska-Winiarska (PL), Mrs. Malgorzata Gizinska-Schohe (PL), Mr. Ludwik Hudy (PL), Mr. Piotr Kaminski (PL), Mrs. Katarzyna Dorota (PL), Mr. Piotr Malcherek (PL); Mrs. Ileana-Maria Florea (RO), Mrs. Mihaela Teodorescu (RO); Mr. Dusan Borstar (SI), Mrs. Renata Osolnik (SI); Mrs. Ayse Ünal Ersönmez (TR).

It is to be expected that the trainers will organise *epi* seminars in their respective countries. The *epi* secretariat will mail an invitation to *epi*-members in various countries as soon as the seminars have been prepared by the national „trained trainer“.

## *epi* Autumn tutorials: EQE 2009 included!

For the first time EQE candidates who sat current years' EQE are offered an opportunity to have their papers reviewed by an experienced *epi* tutor before taking the next exam (March 2010). Also the autumn tutorial offers to sit last year's exam (EQE 2008).

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

The schedule is as follows:

1. Candidates enrol as soon as possible but not later than September 25, 2009 indicating the papers they want to sit (the registration form can be downloaded from the *epi* website at <http://216.92.57.242/patentepi/english/300/320/>). The enrolment is confirmed by the *epi* secretariat and the candidates are informed about the assigned tutor(s). Two different tutors may be assigned for papers A/B and for papers C/D. A tutor will be assigned to a group of not more than 3 to 5 candidates to allow intensive discussions.
  2. In a first round candidates write the papers privately (it is recommended to do so in the time the EQE allows for the particular paper). This years' autumn tutorial will offer the EQE 2009 and EQE 2008 papers. The papers can be downloaded from the EPO website <http://www.epo-org/patents/learning/qualifying-examination.html>
- They are also available on CD-ROM.
3. Candidates send their paper(s) to the tutor they have been assigned to by the *epi* Secretariat not later than October 26, 2009. The tutor reviews the paper(s). Candidates who do not get an answer to their papers from their tutor by the due date are requested to contact the *epi* secretariat immediately.
  4. In a second round discussions are scheduled for papers A/B and C/D respectively. The papers are discussed in general, particular problems are addressed, individual solutions commented on and questions answered. The format is flexible: it is up to the tutor and the particular group candidates to decide upon a commonly agreeable form for the tutoring session. In case it is decided that a meeting should be held with all candidates, time and place is to be agreed upon by the tutor and the candidates. The candidates provide in this case their own travel expenses as well as the travel expenses of their tutor. Alternatively a telephone conference could be arranged, but as indicated it is up to the tutor/candidates to agree upon a suitable format.
  5. After the tutorial all candidates and tutors will be requested to fill out an evaluation form.
  6. Fees for the tutorials: Please refer to the relevant text of *epi* Information 1/2009 or to the *epi* website at <http://216.92.57.242/patentepi/english/300/320/>

## 7<sup>th</sup> CEIPI-*epi* Course on Patent Litigation in Europe

The programme of the 2009/2010 CEIPI-*epi* Course is available on the *epi* website [www.patentepi.com](http://www.patentepi.com) as well as on the CEIPI website [www.ceipi.edu](http://www.ceipi.edu)

Any question should be put to the *epi* Secretariat.

## Next Board and Council Meetings

### Board Meetings

80th Board meeting on 12 September 2009 in Ljubljana (SI)  
81st Board meeting on 28 November 2009 in Munich (DE)

### Council Meetings

67th Council meeting on 10 October 2009  
in Düsseldorf (DE)

## Relocation of the epi Secretariat

The *epi* Secretariat is moving. As from 7 September 2009 the *epi* Secretariat will be located at:

Bayerstrasse 83  
80335 Munich  
Germany

The mail address remains for the time being unchanged:

P.O. Box 260112  
80058 Munich  
Germany

Fax and telephone numbers remain unchanged:

Tel.: +49 89 242052-0  
Fax: +49 89 242052-20

## Report of FICPI World Congress and Executive Committee Meeting Washington D.C, 5<sup>th</sup>–11<sup>th</sup> June, 2009

T. Johnson (GB)

Our institute was invited by The International Federation of Intellectual Property Attorneys (FICPI) to attend its World Congress, and Executive Committee Meeting in Washington D.C. This FICPI World Congress takes place every three years. FICPI invites the Presidents of sister organisations such as ours to attend. I had the privilege of representing our President and, through him, the Bureau, Council and *epi* as a whole.

There was a full technical program at the Congress, covering a diverse range of topics such as „Are Patents Worth the cost of obtaining them?“, „Addressing the Backlog (in Patent Offices)“, and „Being a Business Partner with your client“, one of the speakers on that topic being the Associate General Counsel for IP Law at IBM. This session attracted a good audience, as did a session on „Do Business Method and Software Patents

make sense?“ This took the form of a mock trial, the „Judge“ being Chief Judge Paul Michel, of the US Court of Appeal for the Federal Circuit. One of the advocates was an *epi* member, Alexander Esslinger (DE). The social program was up to the usual FICPI standard, with an opening Dinner for the Ex-Co at US Supreme Court, and during the Congress, dinner at the Udvar-Hazy Air Space Center, where the tables were arranged under the space shuttle „Enterprise“.

During the Ex-Co, FICPI admitted a new Indian section, so India is now represented at the Executive Committee (as is China). Sister organisations present were AIPPI, APAA, AIPLA and UNION as well as *epi*. Each sister organisation gave a short presentation, so on behalf of the *epi* I thanked FICPI for its invitation, wished both the Ex-Co and Congress well for successful meetings, and

gave a brief update on our agenda, including the installing of a Director of Education and expressing a desire to exchange views with FICPI on any discussion paper which might emanate from the EPO AC on deferred examination. A FICPI president has a three year term

between Congresses. Therefore Danny Huntington (US) stepped down and handed over to Peter Huntsman (AU) for a term expiring in 2012 at the next World Congress which will (probably) be in Australia.

## Study of priority right under EPC: same invention /disclaimers

F. Portal<sup>1</sup> (FR)

### I – Preamble/Introduction

As old as 1883, the „Paris Convention“ for the protection of Industrial Property established a Right of Priority of one year, relating to the same invention for which a protection is sought in different countries. The EPC priority right of article 87 is entirely based on the mechanism and interpretation of the Paris Convention and EPO's decisions on the priority right often refer to the Paris Convention interpretation.

Priority right is one of the essential mechanisms of the Patent Law, but also one of the most difficult to appreciate.

To show this complexity we just have to refer to the recent past. A person may benefit a priority right in respect of a „same invention“, but contrary decisions were rendered on the interpretation of the concept of the „same invention“ until the Enlarged Board of Appeal's G2/98 decision rendered in 2001.

Very recently, a Board of Appeal rendered a decision T1443/05 on the interpretation of the „same invention“. In this particular case 2 successive EP applications were filed, one claiming the priority of the earliest one.

### II – Board of Appeal („BA“) decision T1443/05 – FACTS

This is one important most recent decision from the BA on the priority right. This decision was held on EP 1 005 271 (EP2) wherein claim 1 is basically directed to a biocide composition including at least two active ingredients, namely 2-methylisothiazolin-3-on (MIT) and 1,2-benzisothiazolin-3-on (BIT), excluding compositions including 5-chloro-2-methylisothiazolin-3-on (CMIT).

This EP2 is a Euro-PCT application claiming the priority of an earlier EP application (EP1) published by the EPO under EP 0 900 525. The earlier EP1 was directed to biocide compositions including at least two active

ingredients, namely 2-methylisothiazolin-3-on (MIT) and 1,2-benzisothiazolin-3-on (BIT). According to the description these compositions may comprise other biocides such as CMIT.

Thus, according to EP1, CMIT is a further possible biocide agent of the composition, but CMIT is excluded from the scope of claim 1 of EP2 by a disclaimer (i) to overcome a document from the prior art, namely JP 01-224306, discovered in the Search Report, and (ii) justified further by alleged allergic properties of CMIT.

### III – Board of Appeal position in T 1443/05

The Board held that the priority is not valid because the invention claimed in EP2 is not the same as the invention described in the earlier EP1.

Article A. 87(1)(b) EPC states that a person may benefit of a priority right in respect of a „same invention“. According to G2/98, a narrow and strict interpretation of the „same invention“ is appropriate. For such an interpretation the claims for which a priority is claimed should be directly and unambiguously derived from the disclosure of the priority application.

The Board interpreted that the invention claimed in EP2 is not the „same“ as the invention disclosed in the priority EP1 because of the disclaimer of CMIT. Thus the board held that the priority is not valid.

On this basis the Board considered that the earlier European patent application EP1 is opposable as regard to novelty of the subsequent EP2 according to A.54(3) EPC (prior rights).

Because the examples of the earlier EP1 disclose a combination of MIT and BIT without CMIT, the Board held that the priority document EP1 destroys novelty of EP2's claims, and revoked EP2.

<sup>1</sup> Frédéric Portal, European Patent Attorney, Chemistry, Chemical Engineering, Life sciences at Cabinet Beau De Loménie, Paris.

#### IV – Discussion of this Board of Appeal's decision T1143/05:

1 – In T1143/05, the Board held that EP1 is opposable as prior art against EP2. This legal consideration is right *only if the priority is invalid*.

Thus, as a consequence of invalidity of the Priority Right, EP1 becomes a prior art falling within the definition of Article 54(3) (prior rights). No basis is given in the EPC to consider the contrary.

According to the Board's assertion that the priority is invalid, the examples of EP1 disclosing the combination of MIT and BIT *destroy the novelty* of the subsequent EP2.

This position is in our opinion contradictory, notably in the present case where a particular embodiment is excluded from the scope of claim 1.

Indeed, the priority EP1 destroys novelty of EP2 claims only if new matter is added in EP2. Accordingly what is important is to study whether new matter was added between EP1 and EP2.

We will debate this later on, after examining direct consequences and our proposed recommendations further to the Board's interpretation.

2 – First, this Board's decision may apply to any amendment performed after the filing of a first European application EP1 and introducing new subject matter in the main claim of a subsequent European application EP2. Accordingly, new fall-back positions in a subsequent European application EP2 claiming the priority of EP1 render highly probable the priority invalid and EP1 opposable to EP2.

As a result EP1 priority application text is a killing prior art under Art. 54(3)EPC against EP2. Therefore it is recommended to include all fall-back positions in the priority application. We thus insist on the importance of a careful drafting of the priority application EP1 for ensuring the full validity of the future priority claim.

This decision T1443/05 is all the more important as, according to EPC2000, EP1 is opposable under Art. 54(3) for all contracting states, so that EP2 will be invalid for all contracting states.

3 – A legal remedy to the above described situation is the withdrawal of the priority application EP1 before publication to avoid EP1 publication. In this case EP1 will not be opposable to EP2. This has been confirmed in the EPO's decision J5/81 (Hoermann KG Brockhagen).

4 – Further, it should be avoided to file of a European or of a PCT application as a first filing to avoid the above situation or to file a priority national Application to limit its impact to the (European) country of the first filing.

5 – Besides, this BOARD's decision is disadvantaging the EP first filing European Applicants as compared to National Applicants who are not concerned by such a legal problem since the priority *National* application is not opposable under Art. 54(3) to the subsequent European patent. It is probable that not all national Courts will follow this EPO's decision T1143/05. Further, the „non-European“ priority application is not opposable to the subsequent European application, so that non-Euro-

pean applicants do not have to take into account this decision and interpretation of the EPC.

6 – In T1143/05, the Board interpreted in much more restrictive manner than in G2/98 the terms „same invention“.

In T1143/05, the Board held that the same invention means more or less the *same wording*.

In addition, the Board held that the *technical problem* is to provide a biocide composition comprising MIT and BIT *but not inducing allergy*. Accordingly, for the Board, the technical problem defined is clearly not the same as the one defined in the priority EP1 and the priority is invalid.

But we consider that the Board's assertion that the EP2 is not claiming the same invention as the priority EP1 should not be held as acceptable because the disclaimer of CMIT is not changing the invention nor the technical problem solved, i. e. the technical problem of providing a biocide composition showing a *synergistic effect* between MIT and BIT.

The closest prior art was a Japanese Patent Application JP 01-224306 („JP“) disclosing biocide compositions showing a synergistic effect and comprising MIT, BIT *and CMIT*.

No reference was made to any synergy of MIT and BIT in this JP. Accordingly, it cannot be obviously deduced from the JP prior art that MIT and BIT show a synergistic effect.

It is apparent that the disclaimer was introduced in EP2 to overcome this JP prior art disclosure. It is also understandable that limiting the invention of EP2 to biocide composition comprising *only* or *exclusively* MIT and BIT as biocide agent would have no or very limited commercial interest.

In the present decision T1143/05, the working examples of both the subsequent EP2 and the priority EP1 show the *synergy* of biocide compositions comprising *only MIT and BIT*. Other biocide agent are presented as further possible biocide agents.

Accordingly, there is no ground to consider that a skilled person would not have derived directly and unambiguously from the disclosure of EP1 that the priority EP1 disclosed the invention, i. e. biocide compositions comprising MIT and BIT. It should not be forgotten that Article 87 EPC refers to the „same invention“.

A skilled person would understand at the time of filing that essential means of EP1 are the synergistic presence of MIT and BIT, and that all other biocide ingredients are optionally present, i. e. may be excluded from the composition.

We believe that an embodiment disclosed in an application may be excluded if this embodiment is not one essential technical feature claimed or presented as essential in the application. This is line with T1139/00 which held that „[t]he effect of a disclaimer in the claims is to exclude one particular process from the group of processes, to leave a more limited group, which merely narrows the scope of the claims“.

It becomes undisputable that in T1143/05 the invention disclosed in EP2 is the same as in EP1: biocide compositions showing a *synergistic effect between MIT and BIT*.

7 – The legal problem raised by this decision is also: is a disclaimer acceptable when it is introduced in a subsequent patent application but absent from the priority document? This question has not been debated by the Board of Appeal in the present case.

The decision T1443/05 shows the EPO's will to accept to grant a disclaimer only in a very restrictive number of cases. It is interesting to note that the Board did not refer to the Enlarged Board of Appeal decision G1/03 on Disclaimers. This absence of any reference to G1/03 may be explained by the non application of this decision to the present case since the decision G1/03 deals with a *disclaimer not present* in the application as filed but *introduced during the prosecution*.

In T1443/05, the „disclaimer“, or in fact the exclusion, was present in the original text of EP2 at the time of filing. Thus, this is not a „disclaimer“ in the sense of G1/03.

8 – We believe that G1/03 cannot apply to discuss the priority right when a disclaimer was introduced in a subsequent EP2.

Indeed, the ruling for allowing a disclaimer as set forth in G1/03 should not apply between the priority EP1 and the subsequent EP2 because there is no ground in the EPC not to accept a disclaimer INITIALLY present in an application.

But following T1443/05, if this disclaimer is absent from the priority EP1, the priority might be invalid for studying validity of EP2.

Again, this consideration appears to be right if the invention of the subsequent EP2 is not *the same*.

We believe that in T1443/05, the question whether the invention is the same has not been correctly debated and our conclusion is that the invention of EP2 is the same as the invention of EP1. This is all the more justified because the 10 working examples from the priority EP1 are included in the subsequent EP2 and that the patentability was resulting from the synergy of the combination of *MIT with BIT* already disclosed in EP1.

9 – Another approach to this legal situation is to consider that all common parts between the priority EP1 and the subsequent EP2, CAN NOT destroy the novelty of EP2's claims where the EP2's claims encompass the subject-matter of EP1.

One may see in EP2's claim 1 an infinity of embodiments covering compositions comprising MIT+BIT but not those comprising CMIT. According to this reasoning, the priority may be valid since EP1 covers an infinity of compositions comprising MIT+BIT excluding CMIT and compositions comprising MIT+BIT+CMIT.

Such an approach has been taken in T665/00 (L'Oréal vs. Parfums Christian Dior), but this decision has not been followed since considered erroneous including by the Doctrine (Notably P. Vigand) and appears to be yet overruled by T1443/05.

We do believe that the priority document is not any document from the prior art but a specific one from the

same Applicant/inventor(s) which serves to establish the priority and the benefit from an earlier filing date, under Paris Convention.

10 – In the decision, the board identified a new technical problem solved by the invention as claimed in EP2. We believe that studying the technical problem when assessing the validity of a priority is not appropriate because the technical problem may change depending on the prior art, and especially of the closest prior art as identified in the problem-solution approach.

The invention is relating to the *technical features* not to the technical problem. The technical problem is only of interest to appreciate the patentability of the technical feature(s). Accordingly, what is only to be taken into account is the disclosure of the technical feature(s) in the priority document. Accordingly, The Board was mistaken in decision T1443/05.

## V – Conclusions

1. As a first conclusion, care should be taken not to apply this decision T1443/05 to the case where the technical features are the same in the priority document and in the subsequent Patent, even if a disclaimer is present in the subsequent Patent.
2. We believe that the EPO's decision T1443/05 may apply only when the technical features of the subsequent application or patent are different from the priority document. In T1443/05 the Board considered that the technical problem has been changed during the priority year and that the invention was not the same. This explains why the priority was held invalid.
3. However we believe that this EPO decision should not be legally acceptable because the facts appear to show that the „invention“ in the priority document and the subsequent application were the same, even if a disclaimer was introduced.
4. To invalidate a priority claim because the technical problem is not the same as the priority document is not appropriate. The invention is relating to the *technical features* not to the technical problem. The technical problem is only of interest to appreciate the patentability of the technical feature(s). Accordingly, what is only to be taken into account is the disclosure of the technical feature(s) in the priority document. Accordingly, The Board was mistaken in decision T1443/05.
5. Besides, this decision may apply to a very wide number of cases but should not be followed.

Care should be taken not to be entrapped in a legal situation where the patent system is far away from the problems of industry. This may be the case here where an invention is unpatentable because of the existence of a prior art not known at the priority date and discovered by the Search Report before the PCT or European Patent application filing. Since under T1443/05, the priority claimed in EP2 may be held invalid and the priority EP1 is becoming prior art under art 54(3), it follows that EP1 would destroy

the subsequent EP2 if EP1 is not withdrawn prior to publication.

This decision applies especially in the chemistry/biotechnology field, where disclaimers are not only a

legal opportunity to avoid undue limitations of the scope of the claims, but also a real means to define a valuable invention which may be lost without such a disclaimer.

## Belgium on the way to ratification of the London Agreement?

G. Voortmans (BE), G. Narmon (BE)  
and M. Messely (BE)

In an article that appeared in EPI Information 4/2008, titled „The London Agreement and the language situation in Belgium“, the author of that article, Mr. Gevers, has attempted to explain to the European patent profession why ratification of the London Agreement (LA) would form an impossible mix with the Belgian Linguistic situation. In the article, it is further stated that the LA is very difficult to accept by the Flemish, who form the majority of the Belgian population. According to Mr. Gevers, this would in particular be so because after ratification of the LA, since Belgium has French in common with the official languages of the EPO, no translation of the claims into Dutch could be asked for, hence leaving the majority population of Belgium without a translation of the claims into their mother tongue.

Mr. Gevers opinion is not one that is shared by the majority in Belgium. Indeed, an overwhelming majority of the Belgian industry, including enterprises operating in the Flemish region already have expressed their support to ratification of the LA by Belgium. Already in 2006 have the Union of Belgian Enterprises (VBO), Flanders' Chamber of Commerce (VOKA), VOB/UEB (Brussels) and Union Wallonne des Entreprises Wallon (UWE) requested in a joint declaration that Belgium would ratify the LA. It is likewise supported by many patent professionals in private practice.

Likewise are the Belgian Companies and their respective associations in favor a European Union Patent, as well as of a European Union Patent Court. The willingness of the Belgian industry to ratify the LA is a strong signal that Belgium does not wish or want to have a language issue get in the way of establishing a European Union Court and a European Union Patent.

The ratification has also been positively advised on by „de Hoge Raad voor IE“, an advisory body to the Minister of Economic Affairs. Following this positive advice, the ratification law has been introduced in the Belgian Senate. It is therefore to be expected that Belgium will ratify the LA.

There is also no reason why Belgium should not ratify the LA. Like in any other Member State of the EPC, ratification generally means a reduction in cost of vali-

dation of the European Patent in the relevant Member State, hence making the European Patent more affordable. The situation in Belgium is no more or less complicated than in other Member States. The fact that the Flemish community would be left without translation of the claims in Dutch is one that has existed for many years prior to the entry into force of the LA and is one that will continue to exist until Belgium ratifies the LA. Indeed, validation in Belgium is typically done by the filing of a translation of the European Patent into French. It is unlikely that anything will change in this respect if Belgium would not ratify the LA. If a patentee would wish to validate in Belgium, he could still do so, and likely would, file a French translation rather than a Dutch, particularly now that the Netherlands no longer require a Dutch translation.

Further, as Mr. Gevers acknowledges, many patents ratified in Belgium would also be ratified in the Netherlands. The Netherlands have ratified the LA and require a Dutch translation of the claims. Hence, those that need or want to read a Dutch translation of the claims, could simply consult the Dutch validation of the European Patent. Why then insist on a Dutch translation of the claims for what allegedly would be a minority of cases where there would not be an equivalent in the Netherlands?

Where then is this opposition in Belgium to the ratification of the LA coming from? The answer can perhaps be found in an article of Bruno Van Pottelsberghe<sup>1</sup>. In this article, it is stated that the LA provides a cost reduction of about 3 600 Euros per patent validated in 5 countries. This amounts to an overall translation business of 220 million Euros or 8 million Euros for the Belgian translation business, which in Belgium is divided up between only few firms. It is understandable that this leads to some resistance against the ratification of the LA, but it should not weigh up against the genuine interest of the applicants to a more affordable European Patent System. It is therefore hoped that the strong support existing in Belgium for ratification of the LA precipitate in a ratification law soon rather than late.

<sup>1</sup> Les traductions de brevets européens : une résistance vénale et myope, Bruno Van Pottelsberghe, L'Echo, January 2009

# A 'New Motivation' – Quality, Backlogs and Fees at the EPO

C. Treleven<sup>1</sup> (GB)

## 1. Introduction

The EPO's 2007 Annual Report stated the following:

*'one of the most critical challenges of the moment is the accumulation of backlogs in the patent system. In addition, the Office is receiving fewer patent applications drafted in accordance with the EPC standard, which makes the applications substantially more difficult for examiners to process and quality patents more difficult to achieve.'*

This is a short, powerful summary of a situation that is very clearly in need of solution. The quotation focuses on the backlogs as being a challenge to the EPO. However, backlogs also have very significant negative effects on representatives, applicants and the general public.

This article looks at the links between backlogs at the EPO, the quality of granted patents and the EPO's fee structure. The EPC2000 revisions were intended to allow the EPO far greater freedom to change the way in which it operates. This article therefore also considers what the EPO could do with those powers, specifically at opportunities for building on the incentives introduced by the recent re-structuring of claims fees.

The author of this article has worked as a European Patent Attorney both in private practice and in industry, and as an economics consultant.

## 2. Background

The EPO has operated with significant backlogs in search, examination, opposition and appeal for much of its 30 year history. The backlog in search dates back to the mid 1980s. Considering examination, the EPO's 2008 Annual Report states that, during 2007, *'the number of European Examination files awaiting a final outcome rose by 5.9% to 485700'*.

To their great credit, the staff at the EPO have faced this situation with resolve. For more than twenty years, including ten years in the 1980s and 1990s when the author of this article was an EPO examiner, the EPO has sought to raise its efficiency. Increases in efficiency have often involved a 'getting more from each examiner' approach.

Recently, there has also been major progress on making the EPO more effective, effectiveness not being the same as efficiency.

Since 1st April 2008, a fee of Euro200 per claim has been payable for the 16th and each subsequent claim. From 1st April 2009, there has been a fee of Euro500 for the 51st and each subsequent claim. These claims fees

now provide a strong incentive for applicants to review the number and structure of claims. This incentive is likely to bring significant changes to many European Patent Applications that are either based on an earlier national patent application, or which are based on an International Application filed through the PCT.

A European Patent Attorney now has convincing arguments with which to persuade an applicant that it is worth investing time to amend claims, before an application reaches the EPO. This was not the case under the system of claims fees in force before April 2008. Under that system, any attempt by a European Patent Attorney to spend time amending claims before filing a European Patent Application would almost always cost more in 'chargeable time' than it would have saved in EPO claims fees.

The new claim fee structure demonstrates that applicants can be given strong incentives to be proactive, very early in the substantive examination process. However, the claim fee structure is simply one step towards improving the situation that *'the Office is receiving fewer patent applications drafted in accordance with the EPC standard'*, see the quote in the introduction.

Prior to filing, a European Patent Attorney in private practice still has few arguments available with which to persuade an applicant to do more than just react to the claims fees. Applicants know that many EPO examiners will produce a neat list of requirements, which the applicant can then address. The applicant needs only to expend time, and hence money, to make changes during substantive examination. A large majority of representatives are in private practice. So extensive work to bring a national or a PCT application into agreement with the EPC, prior to filing as a European Patent Application, is still unlikely to be the norm.

The incentives introduced by the new claims fees show that further variations to the EPO's fees would have strong effects on the condition of patent applications that are filed at the EPO. This would cut the workload for examiners, and also the time to reach grant. Here 'condition' means how close the patent application is to meeting the requirements of the EPC.

## 3. What are the real effects of the backlogs?

The effects of backlogs at the EPO are very great. However, because large backlogs have been part of the patent system for so long, it is hard for many people to see how they affect patent quality, and how much they cost.

<sup>1</sup> C. Treleven, European Patent Attorney, colin.treleven@optimus-patents.com

### 3.1 Effects on EPO staff and European Patent Attorneys

One effect of the backlog in examination is that, often, 12 months elapse between an examiner issuing a communication and the examiner being able to read the representative's response. So the examiner has to invest significant time in re-familiarising himself with the case.

A far less well understood issue is that the backlog in examination leads to many European Patent Applications not remaining with the same patent examiner for the whole time period up until grant. It is even more likely that there will be a change of representative between an invention being submitted by an inventor for drafting as a patent application, and the eventual grant of a European Patent.

The main reasons for changes in responsibility between examiners or representatives over a timescale of 3-7 years are: staff resigning; staff retiring; staff moving to a new role, such as the EPO Board of Appeal or litigation in a patent firm; extended illness; maternity leave; setting up work dockets for newly recruited staff; peaks and troughs of workload requiring the hand-over of work between colleagues.

Each time that responsibility for a patent application passes from one patent examiner to another:

- (i) There is a need for the new examiner to read the application, and to familiarise himself with everything that has happened in the case so far.
- (ii) There is a significant risk that the new examiner will only partially understand the relevance of the prior art, which is often extensive and may have to be read and decided upon all in one go.

Point (i) is an enormous drain on the time of highly qualified staff. Point (ii) leads to decisions of poorer quality than would otherwise be the case.

Points (i) and (ii) also apply to European Patent Attorneys who take over cases. The duty of care on representatives in private practice requires them to take great care when taking over responsibility for a patent application, either within their own firm or from another firm. As a result, much time is wasted, each time that an application passes from one representative to another. That time usually cannot be charged to clients.

A representative who takes over a patent application also needs to try and understand the commercial motivation for prosecuting a patent application. The representative who drafted the application may have spent several hours with the inventor, and may have worked for several years with the company that provided the invention. Such knowledge of an applicant's needs is not available to a new representative. So the new representative may typically have to spend a great deal of time understanding which claims to pursue, in order to achieve the grant of claims that are of greatest value to the applicant. The risk is always that claims may be pursued when an application really should be dropped, or even that an application is dropped that still has value.

Often, the most significant issue for European Patent Attorneys is the need to contact the applicant or inventor, prior to drafting a response to an EPO communication. The issues in the preceding paragraph are made

much worse by the fact that, in large industrial companies, inventors have usually either left a company or moved to a new part of a company, 3-7 years after the filing of a patent application. So a frequent task for a representative is to try and find another employee who knows whether or not an application is still important. Persuading someone in industry to put time into someone else's patent application, for which filing awards have often already been paid, is a skill in itself.

In addition to these practical difficulties, the negative effects on motivation of taking over large backlogs of partially examined cases are very great, both for EPO examiners and European Patent Attorneys. Most people in the patent system have experienced the sinking feeling of knowing that a colleague is leaving, and that that colleague's workload now needs to be divided up amongst those people who are left.

### 3.2 Assessing an invention years later

A major problem arises from the total amount of time between an application being filed and a final decision whether or not an invention was 'non-obvious' at the time of filing.

The biggest issue for quality, many years after an application was filed, is that it becomes increasingly difficult for examiners or representatives to provide convincing arguments whether or not a claim was 'non-obvious' many years ago. Many people have sat in an oral proceedings at the EPO and have had to imagine what was known and 'common general knowledge' many years previously.

### 3.3 What effects do backlogs have on the other parties involved?

Returning to the figure of 485700 European Examination files awaiting examination, it is clear that these cases create great uncertainty for third parties.

Any company wishing either to commence production or a service in Europe will be faced with hundreds, or possibly thousands, of pending patent applications. Any single one may affect the viability of that company's planned project. So large backlogs provide a hugely uncertain commercial environment. Uncertainty is the enemy of business planning. Inevitably, this uncertainty raises risk, and hence the cost of entering markets, which is exactly the opposite of what is needed. Ironically, patent proprietors also suffer from this uncertainty, since they have little hope of valuing the licensing potential of a European Patent Application at most stages up until grant.

### 3.4 Do backlogs bring any benefits?

Backlogs represent a form of deferred examination by default. However, the amount of deferral for an individual application is unknown, since it depends on the backlog in the particular technical field. So this is effectively deferred examination by lottery.

In addition, there is no mechanism for a third party to request examination of a patent application that is of concern to a business' planned activities. A party submitting observations under Art. 115 EPC does not

become a party to the examination proceedings, and those observations do not lead to the application being examined sooner than others in the backlog.

#### 4. A proposed solution: 'Expedited Examination'

This article proposes a solution that can substantially eliminate the negative effects in section 3 above. In particular, the time wasted by examiners and European Patent Attorneys can be greatly reduced, hence saving costs to the EPO and applicants. There would also be gains in patent quality.

It's first necessary to accept that, for many patent applications, the applicant currently has great economic incentives to allow the examination process to last as long as reasonably possible. The fact that the EPO is not deluged by applicants complaining about delays in examination provides another strand of evidence for this.

In essence, most representatives experience work with the EPO as a two step process. Firstly, a significant fee has to be paid to initiate a phase of work, e.g. examination or opposition. Then that phase of work begins. Importantly, the examiner's time is 'free at the point of use' for the representative during that phase of work. The same examination or opposition fee is payable, no matter how many hours of an examiner's time are needed to settle the case. So a 'direct grant', in which the EPO does not even issue an examination communication, costs the same examination fee as an application which requires two examination communications and oral proceedings, spread over three years.

Once it is understood that the fee paid by an applicant or opponent is not correlated with the workload per case, then it becomes clear that solutions are possible. What is needed is an incentive for applicants to bring their applications into conformity with the EPC much sooner than is currently the case, or for opponents to act more quickly in opposition proceedings. That incentive must be greater than the incentives to delay as long as possible.

The proposals shown in Table 1 below offer a solution. Table 1 explains three new options for applicants and opponents. These options are henceforth collectively termed 'Expedited Examination'. These options differ from the EPO's 'PACE' measures, in that their use would reduce costs significantly.

None of the three options would be compulsory. These options are politically easy to implement, precisely because they are simply additional choices. Importantly, they would be attractive to SMEs, which the EPO has a particular duty to help. However, any applicant wishing not to use them would be free to continue as presently.

Expedited Examination has two interlinked aims. These are:

- (i) To encourage applicants to submit requests for examination earlier, and, once examination has started, to respond earlier to any communication issued by the EPO.
- (ii) To provide as many applicants as possible with a strong financial incentive to be proactive, early. Here

'proactive' means both putting an application in order for grant as early in the application process as possible, without prompting, and responding as completely as possible to any objections that are eventually raised by the EPO.

**Table 1: Expedited Examination**

<p><i>1. Examination fee refund</i></p> <p>The examination fee would be refunded, if:</p> <ol style="list-style-type: none"> <li>a) An applicant makes a request for examination within one month of transmittal of the search report;</li> <li>b) The EPO grants the patent either without issuing an examination report, or with only one examination report having been issued, and without oral proceedings;</li> <li>c) When one examination report is issued, the applicant provides a comprehensive reply to that report within one month.</li> </ol>
<p><i>2. Opposition fee refund</i></p> <p>The opposition fee would be refunded to any opponent who:</p> <ol style="list-style-type: none"> <li>a) Filed their opposition within one month of the mention of grant of a European Patent;</li> <li>b) Replied within one month to any communication from the opposition division; and</li> <li>c) States in any request for oral proceedings that they would attend at one month's notice, and subsequently does attend if they accept an invitation.</li> </ol> <p>The opposition fee would only be refunded if an amendment were made to the granted patent, or the patent were revoked, as a consequence of at least one of the grounds cited by the opponent.</p>
<p><i>3. SME refund</i></p> <p>Where the conditions for refund of an examination fee were met, and the applicant was an SME, the applicant would also be entitled to a refund of the search fee if:</p> <ol style="list-style-type: none"> <li>a) All the independent claims, as originally filed, were granted without amendment of their scope.</li> </ol>
<p>In each of refunds 1-3 above, the applicant or opponent would have to request a refund at the start of the relevant procedure, and would have to state in that request that they intended to abide by the conditions given above.</p>

Refund of the examination fee would only be made when the applicant has submitted translations of the claims, and paid the fees due under Rule 71(3), (6) and (9) EPC.

The proposal for opposition fee refund would not change the maximum time of nine months permitted by Art. 99 EPC for submitting an opposition. However, once a stage had been reached when the majority of oppositions were filed within one month, the maximum time permitted should be cut to four months and the opposition fee increased. The advent of on-line databases of prior art has reduced radically the time necessary to gather prior art for inclusion in an opposition, since the EPC was originally drafted, and these changes should be seen in the light of that.

It is also important to realise that many proprietors would be better placed if they received the prior art cited in an opposition only one month after grant, rather than nine months after grant. This reduces uncertainty for them.

The SME refund would provide a much greater incentive for applicants to search thoroughly, before filing cases at the EPO. Many more SMEs would change their claims after receiving a search report from a national office, before applying to the EPO. Others will carry out more thorough searches themselves. European Patent Applications resulting from such preparation would then

usually have very relevant prior art cited in them, and the claims will have been (re-) drafted in the light of that prior art.

## 5. Discussion

Expedited examination would bring the median time to grant of European Patents down by between 1 and 1.5 years. Currently the EPO's 2008 Annual Report quotes that 'On average, a granted patent was published 43 months after the application was received'. However, this is not the time from the priority date. The 43 month figure also disguises the many cases that stay in the system for 4-7 years before being abandoned, refused, or granted after many attempts at amendment.

Once the EPO had cleared existing backlogs, many applications would be granted within 2 years of their priority date.

So what would be the costs and benefits of Expedited Examination?

In 2007, the EPO's fees from 'examination and grant' were 15 % of all EPO income. If 50 % of applicants manage to meet the 1 month deadlines given in Table 1, and obtain grant after at most one EPO communication, then examination fee refunds would reduce total EPO income by approximately 4%. Notably, the 500 Euro designation fee, 790 Euro grant fee and any claims fee would still be payable. The examination fee is 1405 Euros.

Against this 4% reduction in EPO income, there would be a very major reduction in the time spent by EPO examiners, through four different effects. Each of the following four effects would result in a significant time saving for examiners, although the first effect is the most important:

- (i) There would be many cases in which fewer examination communications would need to be issued, and those communications would need to cover fewer issues. This is because applicants will submit European Applications in better condition for grant, in order to try and gain a refund of the examination fee. If a first EPO communication does have to be issued, then applicants would, for example, be likely to take exceptional care not to add subject matter in their response.
- (ii) The reduction in time for an examiner to re-familiarize himself with an application. This is because the representative's response would come back one month after an EPO communication is issued, rather than the usual four to six months.
- (iii) The reduction in the large number of old cases that are handed over from one EPO examiner to another. This would also save time for representatives.
- (iv) The elimination of oral proceedings for those cases that receive a refund of the examination fee.

Considering cash flows, the EPO would also gain through increases in the remittals of 50 % of each national renewal fee. Proprietors of granted patents will pay these fees to the national offices sooner for each application that qualifies for an examination refund,

than otherwise would have been the case. Clearly, the national offices will also gain significant revenue from this. The increase in the net income to the EPO from national renewal fees would however be partially offset by the fact that applicants would pay fewer annual Art. 86 EPC renewal fees directly to the EPO, while the application was pending. The exact calculation may result in a benefit or a cost, since the typical number of member states in which granted European Patents are validated is likely to change significantly with awareness of the London Agreement.

Similar analyses apply to the 'Opposition Fee Refund' and 'SME refund' in Table 1.

Expedited examination would contribute to a major reduction in the uncertainty created by undecided patent applications, and hence to the hidden costs to Europe's companies. This effect may well be the greatest overall, but is the hardest to turn into monetary values.

Concerning the SME refund, it is useful to compare the proposal with the 50 % reduction in most fees that the USPTO offers to SMEs. That refund is not linked to any proactive patent prosecution work by the applicants, but is simply dependent on their size. Other patent systems, such as the Indian system, also offer large percentage reductions in fees, based on the status of the applicant. In contrast, the SME refund in Table 1 would change the way that SMEs prepare and prosecute their patent applications, in return for the additional fee refund that they might eventually receive.

## 6. Conclusion

At present, a European Patent Application is likely to have been the responsibility of several different people, before being granted. It is also likely to have been amended on several occasions, spaced apart by 1-4 years. This is not conducive to producing quality patents.

The European Patent Convention currently offers little motivation to put an application in order for grant, or to settle an opposition quickly. There is a great difference between having the *motivation* to take an action as soon as possible, and the fact stated in Enlarged Board of Appeal Decision G1/93 that '*an applicant is responsible for amendments made...*'. What is needed is a new motivation.

The system of Expedited Examination presented in Table 1 above offers a net 'win-win' outcome. A key issue is that Expedited Examination would be optional, since it is then not forced on any applicant or opponent. The three main effects would be:

- (i) Many more cases being granted with fewer, or no, EPO communications having been issued.
- (ii) Eliminating the duplication of work, which currently simply wastes time; and
- (iii) Bringing forward the point in time when many European Patent Attorneys do most of their work on an application.

Speeding up the process from the start of examination through to grant would almost entirely eliminate the routine passing-on of unsettled cases between exam-

iners, representatives and technical experts in firms. There would be a corresponding, and important, increase in patent quality, together with greatly reduced uncertainty for third parties.

If we consider a typical European Patent that is allowed to lapse ten years after its priority date,

Expedited Examination would mean that the granted patent would be in force for the final eight years of that period, and would only have been an application for the first two years. This is a much more desirable situation than an application that pends for four and a half years, and then is in force for five and a half years.

## „It is a truth universally acknowledged ...“

or

## Double patenting and the EPC

D. Harrison (GB)<sup>1</sup> and T. Breimi (CH)<sup>2</sup>

The quoted words are the famous opening of Jane Austen's „Pride and Prejudice“. She was writing about the evident need for a moneyed bachelor to have a wife. There are complications, but it all ends happily.

The subject here is double patenting – there are certainly complications and it may not end happily, but it also has in common a universal acknowledgment, in this case that it is a Bad Thing. Such acknowledgments have the uncomfortable tendency to suffer by virtue of their universality from a lack of investigation into the veracity of that „truth“.

Everyone agrees that double patenting is an evil; but ask what it is, and why it is bad, and you do not usually get a coherent answer.

To start with, it is notoriously not stated in the EPC what you do if faced with – adopting a provisional definition for the sake of argument – two applications from the same source, of the same date, and relating to the same invention. The original Travaux Préparatoires of the Convention are rather unhelpful; there seems to have been universal acknowledgment that double patenting (without deciding what it was) was deplorable to the extent that it was felt unnecessary to legislate against it in the EPC!<sup>3</sup> The only specific discussion in the Travaux Préparatoires in this respect however seems to be in relation with Art. 139, dealing with the conflict of European patents with national patents. There it is expressly stated that the permission or prohibition of simultaneous protection could be left to each of the contracting states,<sup>4</sup> and in 1972 the Conference decided to retain the rights for the contracting states to provide for simultaneous protection.<sup>5</sup> As the coexistence of the

European and the National systems is a heavily political issue, the discussion around Art. 139 can however not be directly compared with the conflict between two European patents. The question does not seem to have been discussed during the 2000 revision.

We get some, but not very consistent, guidance from the case-law and the Guidelines.

### The Case-Law

The Boards of Appeal of the EPO had never until very recently directly confronted the question of double patenting. There is a reference in T 0441/92, but a much fuller and more interesting discussion in T 587/98, where the question was whether a divisional application could have a main claim which was wider than, and completely included, the main claim of its parent. The divisional had been refused by the examining division on the basis of Article 125 EPC: there was allegedly a „general principle“ in the contracting states that double patenting – which the Examining Division, without attempting any definition, took this to be an example of – was not allowable.

The Board did not have much difficulty with this; Article 125 relates to procedural matters and this is substantive (Reasons 3.6; see also T 307/03, Reasons 2.7, last sentence), but it dealt also with the substance, pointing out in Reasons 3.4;

*„Given that this kind of „overlap“ is not prohibited under the EPC in the situations outlined immediately above [namely an Article 54(3) scenario], it is not apparent to the board why it should be prohibited between divisional and parent applications. It may perhaps be thought that such a prohibition is desirable to prevent the proliferation of patents for obvious variants, but it would appear invidious to make a distinction between copending applications in an Article 54(3) EPC relationship and*

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3 Travaux Préparatoires, 3076/IV/62-D, page 115, first paragraph: ... weil die Arbeitsgruppe vom Koordinationsausschuss angehalten worden sei, vom grundsätzlichen Verbot der Patenthäufung auszugehen...

4 Travaux Préparatoires, BR/7 e/69 kel/PA/mk, page 8

5 Travaux Préparatoires, BR/168 e/72 oyd/KM/gc, page 9

*divisional applications in this respect. Above all such a prohibition would require a legal basis.*"

And, we add, equally invidious to distinguish between the divisional situation and that of double patenting where, as in the parent/divisional pairing, there is no difference of date.<sup>6</sup>

More recently decision T 307/03 has confronted double patenting head-on, but in a manner which can be severely criticized.<sup>7</sup>

The facts were peculiar, and lend force to the cynical old saying of English lawyers „Hard cases make bad law“.

The application was a divisional. Its parent was in due course granted but then revoked in opposition. That revocation has been appealed and at the time of writing the appeal is pending under number T 334/07.

Meanwhile the divisional application was refused by the Examining division for lack of novelty (of no relevance to the present discussion) and once this appeal, T 307/03, had been launched against that refusal, new claims were introduced into the divisional which effectively identically reproduced the revoked claims of the parent.

It is hardly surprising that the Board intensely disliked this course of action; as it pointed out (Reasons 3.2) the applicant/patentee was attempting to appeal against the revocation of the parent without the participation of the opponent. But how to deal with it?

The Board could have stayed this appeal to await the outcome of the other, or possibly could have consolidated the two.

Instead, the Board chose to base itself on A60(1) EPC. After quoting the opening words of the Article in all three official languages:

*„The right to a European patent shall belong to the inventor or his successor in title“, „Das Recht auf das europäische Patent steht dem Erfinder oder seinem Rechtsnachfolger zu.“ „Le droit au brevet européen appartient à l'inventeur ou à son ayant cause.“*

the Board then said:

*„From this the Board deduces that under the EPC the principle of prohibition of double patenting applies and that the inventor (or his successor in title) has a right to the grant of one and only one patent from the European Patent Office for a particular invention as defined in a particular claim.“*

When it quoted the Article the Board apparently failed to notice that both the French and German texts clearly refer to *the* European patent – the one under consideration. There can be no doubt whatsoever that this Article is dealing with the question „Who owns the right

to this patent?“, and has nothing to do with questions of patentability.

The Board then continues:

*„Once a patent has been granted to the inventor (or his successor in title) this right to a patent has been exhausted, and the European Patent Office is entitled to refuse to grant a further patent to the inventor (or his successor in title) for the subject-matter for which he has already been granted a patent.“*

This echoes decision T 998/99 (exhaustion of priority right) where a Board construed the English „a“ to mean „one only“ (ne bis in idem). An English legislator with that intention would say explicitly „one“ or „one only“.

Just as decision T 998/99 has been criticized<sup>8</sup> (see e.g. T 15/01 and T 5/05) so can the present decision be criticized in this respect also?

The Board in T 307/03 then acknowledges that there is no express provision in the EPC dealing with double patenting, points out that some national legislations do have such a prohibition and quotes by way of example S18(5) of the United Kingdom Patents Act („UKPA“) 1977. We shall return to its text later. The Board then argues that

*„... double patenting is expensive and most patent proprietors would not wish to incur the expense. The legislator cannot be expected to have made provisions to regulate what will on grounds of economics alone be a very rare occurrence.“*

It is not clear why the European legislator cannot be expected to legislate in such a very rare case when the national one has, but there is a stronger argument *a contrario*. If there is national legislation but no European, is that not indicative of a deliberate omission on the European level? See also the Travaux Préparatoires at the places given above. Furthermore, is the Board not holding that A60 is such legislation?

### What is double patenting?

In all this discussion so far neither we, nor the Boards, have decided what double patenting is; even in T 307/03 there are two different suggestions. One is found in Reasons 2.3:

*„...two or more identical patents with the same claims and the same priority dates...“*

and another in Reasons 2.1:

*„... a further patent to the inventor (or his successor in title) for the subject-matter for which he has already been granted a patent“.*

The latter includes the case where one patent includes any part of the subject matter of the other. Consistently with this T 307/03 goes on to criticize T 587/98 for allowing „conflicting claims“ to coexist in parent and divisional.

<sup>6</sup> Note that T 307/03 also seems not to limit its view to the situation of divisional applications as reference is made to applications having the same priority date, see reasons 2.3 and 2.5.

<sup>7</sup> Please also note the comments on T 307/03 by Privat Vigand in: JurisClasseur Propriété Industrielle N°5, mai 2009 page 43-45, „Interdiction de la double protection (double patenting)“ as well as the one by Derk Visser in Mitt. 5/2009. Stimulating discussions between TB and Derk are thankfully acknowledged.

<sup>8</sup> See Bremi and Liebetanz, „Kann man ein Prioritätsrecht „verbrauchen“?“, Mitteilungen der deutschen Patentanwälte, 4/2004, p. 148ff. as well as Bremi and Liebetanz, „No exhaustion of priority rights!“, epi Information, 4/2005, S. 139.

The Guidelines have two passages dealing with it: C IV 7.4 and C VI 9.1.6. The latter relates to divisional applications and says that parent and divisional

*„may not claim the same subject-matter (see IV, 7.4). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable.“*

The former applies this to double patenting specifically;

*„However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States (by confirming the designation through payment of the relevant designation fees) and the claims of those applications have the same filing or priority date and relate to the same invention (the claims conflicting in the manner explained in VI, 9.1.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant.“*

No authority is given for this requirement, but at least there is a definition there. Interestingly the recently updated Guidelines<sup>9</sup> have remained completely unchanged in this respect and do not mention decision T 587/98 which seems to have taken a much more liberal view.

Two legs of the definition present problems. „Same applicant“ will have to be strictly interpreted – see J 2/01 applying Article 118 – and so the addition of an applicant will get outside it; more seriously, the prohibition against claiming „the same invention“, if as defined in C IV 7.4 leads to anomalies.<sup>10</sup>

Consider the case of an applicant who makes a first application and then, before publication, a second, not claiming priority from the first and differing from it only in some trivial detail. Provided that detail is included in an otherwise identical main claim of the second application it will proceed legitimately to grant; it has bare novelty as required by Article 54(3). Are these not „claims of substantially identical scope“? And the further requirement that the „subject matter“ claimed in one must not also be claimed in the other is also met since one includes the other.

Remembering that we were discussing applications of different date where Article 54(3) requires a distinction between them and that in the case of double patenting there is no such requirement in the Convention, what is the reason that there should be equally – or perhaps more – onerous conditions when there is identity of date than when there was prior art?<sup>11</sup>

A further serious problem if we adopt the Board’s point of view is which two claims have to be compared with each other and at which moment in time. In T 307/03 the later claims put forward in the divisional application are compared with the claims as initially granted for the parent application (B1 publication). The Board indicated that they would maintain the double patenting objection even if the parent patent were abandoned.<sup>12</sup> When trying to avoid double protection shouldn’t one rather compare with the version as finally maintained (B2 publication)? Or maybe with the version after a limitation proceeding? As a matter of fact it seems impossible without making an unacceptably arbitrary choice to define which claim is to be compared with which. The whole discussion of double protection should be left to when a question of infringement or revocation is before a national court as only then there is the possibility of assessing whether indeed there is double protection, and if there is, what action should be taken.

Decision T 587/93 if it is correct (as we submit it is) throws doubt on the correctness of the Guidelines C IV 7.4 since protection was given to the same subject-matter (the narrower claim) in two patents, and of C VI 9.1.6 where it is said that one application „must not claim the subject-matter claimed in the other, even in different words“.

Referring to Figure 1 the possible relations between a main claim of the parent (solid line) and of the claim put forward in a divisional or other „double application“ (dotted line) are discussed. So in a) parent and divisional claim essentially the same subject matter, in b) the claim in the parent encompasses the divisional, in c) the claim later put forward in the divisional encompasses the claim in the parent, in d) there is partial overlap and in e) the claims are disjunct.

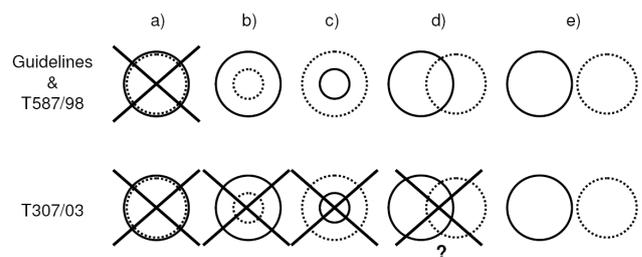


Figure 1: schematic representations of possible relationships between claims of a parent (solid line) and of a divisional (dotted line)

It seems that only in scenario a), where essentially the same invention is claimed in the divisional, a refusal of the application would be appropriate if we interpret the Guidelines in the light of decision T 587/98.

According however to the new decision T 307/03 it seems that not only scenario a) would be prohibited but certainly also c), as this is the situation of the second auxiliary request which was refused entry into the appeal. So a case c) where the claim of the divisional

9 Version April 2009, see [www.epo.org](http://www.epo.org)

10 Using the wording „same invention“ in the Guidelines implies a very narrow interpretation along the line of G2/98.

11 See T587/98 reasons 3.4 discussed above.

12 Reasons 3.2.

encompasses (i. e. is broader than) the claim of the parent is on this basis considered an objectionable double patenting.

Furthermore, In view of the discussion in T 307/03 in reasons 5.4 where it is stated:

*„To avoid this objection of double patenting the appellants would have had to confine the claimed subject-matter in the present application to subject matter not already patented in the patent granted on the parent application. This would then allow the examination procedure to focus on the question of whether this claimed subject-matter (for which there is not already a granted patent) meets the requirements of Articles 123(2) and 83 EPC, as well as the other requirements of the EPC.“*

scenario b) also seems to meet an objection of double patenting, as here the divisional tries to protect subject matter already patented in the parent.

This wording of T 307/03 may even suggest that scenario d) would also be objectionable, as the claim put forward in the divisional (partly) claims subject matter which is already patented in the parent (intersection of the two circles). In view of the fact that this partial overlap is however a common situation in case of non-unity, where dependent claims of a parent and the divisional often relate to the same subject matter, this should probably not be the case. Unfortunately T 307/03 in reasons 5.4 casts doubt on that issue.

It is submitted that double patenting exists, quite probably as intended by the authors of GL C VI 9.1.6, when, given identity of patentee and date, two patents exert the same scope of protection, in the sense that what comes within the scope of one comes within the scope of the other, both ways.

This is the effect of S18(5) UKPA 1977, which reads:

*„Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.“*

because additionally, S 125(1) UKPA 1977 provides that:

*„...an invention...shall...be taken to be that specified in a claim...“.*

That is, an equivalence is established between invention and claim in a way that is never done in the EPC. It follows that the effect of S18(5) is to prevent the grant of two patents of the same ownership and date having *the same* claims. Even though there could in some circumstances still be room for argument about what is „the same“, it is clear that the provision is extremely limited.

Taking this as our definition of double patenting, can it be prevented in the EPO?

The Board in T 0587/98 noted that legislation would be needed to prevent what it called „overlap“.<sup>13</sup> And the Enlarged Board referred to double patenting in G 1/05,

the Divisional decision. It shared the universal acknowledgement when it said, at Reasons 13.4;

*„The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject matter if he already possesses one granted patent therefor“.*

This obiter observation sits at first sight oddly in a decision in which in the very next paragraph the Board said (emphasis added);

*„On Article 76(1) and Rule 25 EPC as presently worded the Enlarged Board of Appeal sees no adequate basis for defining any additional requirements to be imposed on divisional applications beyond the requirements that all applications have to fulfil as well.“*

In other words, if there is no statutory prohibition, it must be let go. But then we look again at the first quoted passage; there is only a *principle* of prohibition, not an actual prohibition in the EPC.

The Enlarged Board no doubt had in mind the provisions of Article 52(1);

*„European patents shall [i. e. must] be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application“.*

Our double patenting application meets all of those criteria, and therefore must be granted.

### What is the vice?

Why would it be Bad to allow such patents? The usual answer is that there would be „Double Prejudice“; that is, a defendant having successfully defended himself against a charge of infringement finds himself being sued again by the same patentee in respect of the same infringement, but this time under his second, „double“, patent.

Consider the Article 54(3) scenario above, and assume that an infringer is within the scope of both patents. Nothing prevents the patentee from suing under only one of them and then, having failed for some reason, suing in respect of the same infringement under the other. If both actions were within the same country a Court might find that abusive, but the patents are verbally distinct and there could theoretically be separate issues. And if the actions were in different countries, as might very well be possible since the patents are distinct, there seems to be even less likelihood of the second action being stopped – at least until there is a common European Patents Court. This is in substance „Double Prejudice“; so why is that raised as an objection only against „double“ patents?

„Absence of legitimate interest“ is probably subsidiary to the above, but nevertheless it must be observed that the Enlarged Board in G 3-4/97 gave no indication that interest, in the sense of *locus standi*, had any applicability in the context of the EPC. And any idea that the EPO should enquire as to the „interest“, in the sense of the

<sup>13</sup> See T0587/98, reasons 3.4

motivation, of all applicants would probably be unpopular.

## Discussion

What are we facing now in view of T 0307/03? Is there going to be another chain of deplorable decisions restricting applicants' rights as in the run-up to G1/05? Is there then, as soon as pressure has risen sufficiently, going to be another decision of the Enlarged Board of Appeal in order to overturn this chain of decisions as happened with G1/05? Will it again be found that the referring decisions lack a legal basis (*ultra vires*) for defining any additional requirements to be imposed on divisional applications?<sup>14</sup> And are we then going to face another amendment of the Implementing Regulations concerning divisional applications which is further going to severely restrict the applicant's possibilities?

Let's hope not.

Decision T 0307/03 was taken at a time when the change in the Implementing Regulations to enter into force on 1.4.2010 was not yet decided.<sup>15</sup> Indeed the first office action to the parent application in this specific case was issued more than 24 months before the divisional application was filed. Under the new Implementing Regulations there could not have been a divisional application in this specific case. The new and coming

Implementing Regulations are a severe restriction to the possibilities of applicants to get well-deserved protection for their inventions. The change to the Implementing Regulations was introduced due to a very few users who were allegedly abusing the system but the change will be affecting all users. Further changes with further restrictions are certainly undesirable.

Hopefully therefore the same route will be taken by the Boards of Appeal as with T 998/98, where the decision was criticised and simply not followed by later decisions.<sup>16</sup> If indeed abuse of the system is made by filing divisional applications claiming the same subject matter as a refused or revoked parent, the European Patent Office nevertheless gets the fees and may simply refuse the divisional application by referring to the decision in the parent case.

## Conclusion

It remains unclear what precisely may be the fundamental objection to double patenting. Double patenting is no ground for refusal of the grant of a European patent, and T 307/03 should not be followed. If national legislatures find double patenting of European patents to be objectionable national legislation against it should use national criteria, as is permitted by A 139(3)EPC in conjunction with A 139(2) EPC.

<sup>14</sup> See G1/05, reasons 13.5

<sup>15</sup> Decision of the administrative Council dated 25.3.2009 amending, among others, R 36 of the Implementing Regulations.

<sup>16</sup> See T15/05 and T 5/05.

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