epi®
Information

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

ISSN 1434-8853

March 2021 1|21

epi welcomes its first Executive Director

Cover:
Windmühle auf Kinderdijk/Holland
Acryl/Öl; Format 80 x 60 cm
This picture painted by
Jürn Antritter
(European Patent Attorney, DE)
was part of the **epi** Artists Exhibition 2018 at the EPO, Munich

Jürn Antritter

Jürn D. Antritter was born in 1942. His career as a patent attorney commenced in 1989 and he was admitted as a Professional Representative before the European Patent Office in 1993. He retired in 2008.
Jürn D. Antritter has been painting and drawing regularly since 1976. From that time to the present, he has attended various painting and drawing courses including at the Münchner Volkshochschule (the Munich Adult Education Center). Under the guidance of his current art teacher, Elmar Siegesleitner, he has undertaken numerous painting trips to many locations including France, Italy, Spain, Greece and the Czech Republic during which he painted a large number of pictures exhibited at the epi Artists Exhibition. Jürn D. Arntritter has already participated in 9 of the epi Artists Exhibitions.

Jürn D. Antritter wurde 1942 geboren, Ab dem Jahr 1989 war er als Patentanwalt tätig und wurde 1993 zugelassener Vertreter vor dem Europäischen Patentamt. Seit 2008 befindet er sich im Ruhestand.
Jürn D. Antritter malt und zeichnet seit dem Jahr 1976 regelmäßig. Ab diesem Zeitpunkt besuchte er bis heute verschiedene Mal- und Zeichenkurse, unter anderem an der Münchner Volkshochschule. Unter Leitung seines derzeitigen Mallehrers Elmar Siegesleitner hat er zahlreiche Malreisen unter anderem nach Frankreich, Italien, Spanien, Griechenland und Tschechien unternommen, während denen er einen großen Teil, der bei der epi Artists Exhibition ausgestellten Bilder gemalt hat. Jürn D. Arntritter hat bereits an 9 epi Artists Exhibitions teilgenommen.

Jürn D. Antritter est né en 1942, Il a commencé à travailler comme conseil en brevets en 1989, et son inscription sur la liste des mandataires en brevets européen remonte à 1993. Il a pris sa retraite en 2008. Jürn D. Antritter peint et dessine régulièrement depuis 1976. De cette époque jusqu'à aujourd'hui, il a suivi divers cours de peinture et de dessin, entre autres à la Volkshochschule de Munich. Sous la direction de son professeur de peinture actuel, Elmar Siegesleitner, il a entrepris de nombreux voyages d'étude en France, en Italie, en Espagne, en Grèce et en République tchèque, entre autres, au cours desquels il a peint une grande partie des tableaux exposés à l'exposition d'artistes de l'epi. Jürn D. Arntritter a déjà participé à 9 des expositions d'artistes de l'epi.

Table of Contents

Introduction

Patent Practice

Case Law

CONTRIBUTIONS FROM epi MEMBERS AND OTHER CONTRIBUTIONS

Educational Events

Committee Reports

General Information

Editorial

Un air de déja vu?

M. Névant (FR), Editorial Committee

As this issue of **epi** Information goes to press, the Covid-19 pandemic will have entered Year 2, and there is little progress in the vaccination rate across the European Union. Some observers (or ill-advised politicians) regrettably blame pharmaceutical companies for not wanting to give away their IP rights on vaccines, and, instead, urge for compulsory licenses as a remedy to all deficiencies. Whereas the failure of the European Union to protect its citizens appears to result from a lack of investment in manufacturing facilities over (at least) the last 20 years…

Marc Névant

Another paramount event will also have taken place, namely the first ever pre-eEQE/eEQE. When the EQE Supervisory Board cancelled the EQE last year, there was no guarantee that a (pre-) EQE could be held in 2021. We are proud that **epi** pushed for the examination to take place, and express our thanks to all **epi** members who made this possible. We also congratulate all the candidates who had to sit an on-line examination in addition to mastering the platform and browser selected for the examination. We hope the EQE Examination Committees and Board will keep this in mind when marking the papers and deciding on the grades allotted to candidates.

The end of last year marked another milestone in the non-cooperation between the Boards of Appeal and users of the system. It was genuinely thought that the consultation on the proposed amendment of the Rules of Procedure of the Boards of Appeal would be the occasion for a true exchange of views. **epi** and Business Europe voiced their concern about the proposed wording of Article 15a RPBA, **epi** suggesting that this article should only remain in force during the pandemic and should subsequently be removed from the RPBA. Alas, the Board of Appeal Committee adopted the amendment of the RPBA with only minor changes to the initial wording of Article 15a, essentially ignoring the comments from two major stakeholders of the patent system in Europe. It is obvious that the decision had already been made, and that the consultation was nothing more than window dressing. The amendment has, of course, to be adopted by the Administrative Council of the EPOrg (AC) - as required by the Decision of the AC dated 30 June 2016 (CA/D 7/16) – but this will likely be a mere formality.

Interestingly, a Board of Appeal has recently referred to the Enlarged Board of Appeal (EBA) the question (derived from Case T1807/15) of whether the conduct or oral proceedings as a videoconference without the consent of all parties is compatible with Article 116(1) EPC. Could this mean that there is no consensus within the Boards of Appeal as to the legitimacy of Article 15a RPBA? Or else that the Board of Appeal wants the practice of mandatory appeal hearings via video conference be set in stone? [Note from the Editor: as we go to press it seems that the composition of the EBA in this case includes members involved in drafting Article 15a RPBA, casting doubt on a fair and transparent outcome.]

From a general perspective, it is hardly understandable why the highest judicial body of the EPO (the EBA) is not comprised of independent members, i.e. members who do not handle a single appeal case and whose only task should be to review potential flaws in a decision under appeal. I believe that it is time for the AC to comprehensibly address this issue so that the word "independence" can truly be regarded as the hallmark of the Boards of Appeal.

I incidentally note that it is still common practice for the composition of an Opposition Division to include the first member of the Examining Division responsible for granting the opposed patent. I do not believe that there is a single European country in which the same matter is decided at two different levels by the same judges. Why should that be the case in opposition proceedings?

From an internal perspective, you may already know, that the position of Executive Director (created by a decision from Council, see e.g. the report of C87 in **epi** Information 4/2019) has been filled since 01 February 2021[1]. On behalf of the Editorial Committee, I congratulate Ms. Tatjana Lissak on her appointment and wish her every success in her new role.

You will also note from the next pages that the Editorial Committee, with the support of the Presidium, is working this year with a communication agency to strengthen **epi**'s capacity to deliver information to its members. This will include developing the use of social media and reorganizing the content platform of the website. We are hopeful that the first results will be visible by summer time.

1 https://patentepi.org/r/info-2101-01

epi welcomes its first Executive Director

In order to meet current economic and structural needs and challenges, **epi** reinforces its Secretariat with the creation of a new position of Executive Director.

Implementation of Council decisions

epi has some 12,500 members in 38 countries, with many volunteer members who contribute to its operations, supported by a Secretariat of 17 employees.

As it has been increasingly difficult to find volunteers for the Board who can combine their professional activity with their duties as Board members, it has been deemed necessary to strengthen the support that the Secretariat provides.

In May 2019, Council unanimously approved the recruitment of an Executive Director (C86, decision 22). In November 2019, Council approved proposed amendments of the By-Laws and further regulations with regard to the Executive Director, including a proposed transitional provision (C87, decision 12). Finally, the Presidium approved on 29th January the entry into force of the amended By-Laws as of today (P2020-02, decision 2).

The Secretariat's organisational chart is therefore modified with the creation of the new position of Executive Director.

Appointment of Ms Tatjana Lissak to the position of Executive Director

Starting today, our new Executive Director is Ms Tatjana Lissak, reporting to the Presidium. An economist by training, she has 20 years of international corporate and association experience with a focus in organizational development and process optimization. Her entrepreneurial thinking and customer- and service-orientation are matched with social competence, communication skills and team orientation.

Our President, Francis Leyder, said: "We are excited to welcome Tatjana to lead the Secretariat's excellent team. She impressed the Presidium during the selection process and we are so thrilled we were able to hire her."

Ms Lissak said: "I am honoured to join **epi** as Executive Director and look forward to leading the Secretariat. I am excited to support the Board, the Council and the Committees with an excellent team to further consolidate **epi**'s success and serve its members through relationships built on trust and solid communication."

"I thank the Presidium for the confidence they have shown in me and I very much look forward to the collaboration with the Secretariat staff and the members of the Council." Ms Lissak added. "Together, we will lead **epi** with a renewed motivation into the next era of success. I am very enthusiastic to get to know each one of you and work closely with you on our shared objectives."

3 questions to Ms. Tatjana Lissak

Can you tell us a few words about your professional career?

After completing my studies in Business Administration and Social Economics at Augsburg University in the late 90's, I started as a Business Consultant at the Global Top-Management Consulting Firm, now called Kearney. As a consultant, you typically work on a variety of topics and projects simultaneously. Hard specialist knowledge, methodological skills, and soft skills are a basic prerequisite for good consulting. Those experiences laid the foundation for my career.

As I always had a strong interest in organisational development and process optimisation, I wanted to implement recommendations and see their practical results. I decided to transfer to Inhouse Consulting, the internal consultancy of EON Group, one of Germany's biggest energy and utility companies. After being there for over 10 years until the closing of the headquarters in Munich, I moved to Germany's biggest motoring association, ADAC with almost 21 million members and a complex governance structure involving volunteers as well as employees. Being a Senior Organisational Consultant at ADAC, I was able to apply my hard and soft skills as Interim Executive Director in one of the subsidiaries of the ADAC Air Rescue while at the same time still being a Senior Consultant at the Headquarters.

What was your motivation to apply for an organization such as epi?

When I learned that **epi** was looking for someone with leadership experience in an association, it immediately awakened my interest. More so as I realized that at **epi** I had the opportunity to work in an international environment, which I have always loved to do. The size of **epi** is similar to the size of the organisation where I was Executive Director and where I could move projects forward successfully.

During the hiring process, I learned how much I could add to the success of **epi** in the newly created position of Executive Director. The objective of the role is not only to unburden the volunteers but also to actively re-engineer processes, to build a winning team in utilising all key competencies within the Secretariat's excellent team, and to strengthen successful communication management with all parties involved in order to better serve **epi**'s members. I saw that it will require a change management process not only within the Secretariat but also in the Board, as time-consuming operational activities are being transferred from the Secretary General and the Treasurer to the Executive Director. I accepted the job because my skills for working simultaneously and prudently on a variety of topics and projects are matched with my ambition for taking on challenges and making things happen.

How do you view your role in the short- to mid-term?

Now the "Pole Star" in the Secretariat is to bring operational key processes to the next level of effectiveness. The growing demands of the current economic and structural needs and challenges require greater focus on leadership and organization within the Secretariat and communication to the Board, the Council, and the Committees. The primary goal is and should be to serve **epi**'s members across all member states. This can be supported via efficient and effective operation of and coordination by the Secretariat.

One requirement is an organisational manual that fully documents processes. A prerequisite is to first define major processes, to assign individuals responsible who perform the work and point out who is accountable for each activity of every single process. I look forward to focusing on this crucial task over the next couple of months and counting on the support of the Secretariat and the Board for this exercise. This analysis will result in clearer, more transparent and fully implemented processes benefitting the efficiency of the Secretariat and increasing the impact of the entire **epi** organization. As a result, the Board and in particular the Secretary General and the Treasurer will be unburdened from operational duties and can move on to vision and strategy for **epi**.

Since this effort involves a change management process, we need to give those developments time, and not all processes can be worked on simultaneously. As daily business requires, priorities need to be set among many: be it for financial or accounting matters, organizing a Council meeting, rethinking **epi**'s IT strategy or communications with the broader **epi** membership, and many other business matters at hand. To further consolidate **epi**'s success, it is vital to convince and motivate those involved in the respective processes of how those processes can be adapted to be more effective and efficient and in a way that creates a win-win situation for all stakeholders.

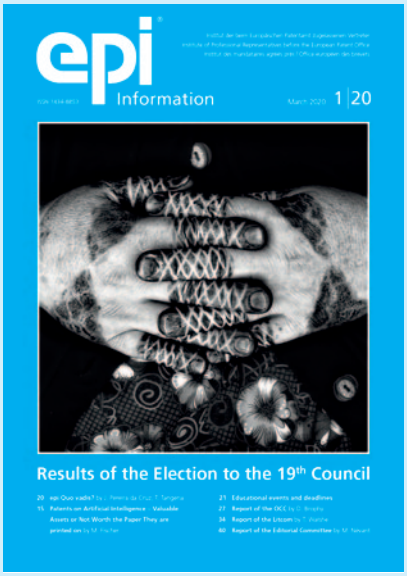
I am very confident that, together, we will lead **epi** with a renewed motivation into the next era of success. My job is a little bit like a gardener. You need to sow good seeds on fertile soil and then nurture them carefully and caringly, by knowing what is needed at the right time for growing them in a proper way. Over time, you can then bring in the desired harvest.

What are you up to these days?

Become a journalist! Your quarterly journal **epi Information** **is looking for authors**. Assist the Editorial Committee for a professional magazine!

Make yourself known to your colleagues! Share your expertise, explain the specificities of IP in your country, tell your stories, explain good practices, comment on a case law, present a professional work...

Connect with **epi**'s 12,500 members in 38 countries!!



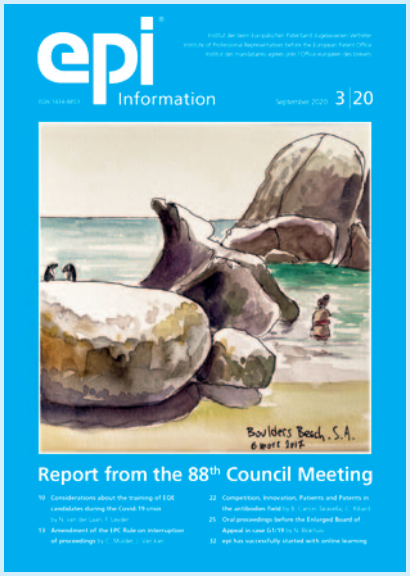
Your article will be published in your **epi Information** journal and/or on the **epi** website. And who knows, maybe make the front page of **epi Information**?

A dedicated team can help you with the structure of your article.
Wake up the journalist in you!

How can you do this?
Submit your subjects to
editorialcommittee@patentepi.org

Don't hesitate to consult the editorial guidelines[1] and previous issues of **epi Information**[2].

1 https://patentepi.org/r/info-2101-010
2 https://information.patentepi.org



Was machen Sie zur Zeit?

Werden Sie Journalist! Ihre vierteljährlich erscheinende Mitgliederzeitschrift **epi Information** **sucht Autoren**. Unterstützen Sie den Redaktionsausschuss einer Fachzeitschrift!

Machen Sie sich bei Ihren Kollegen bekannt! Teilen Sie Ihr Fachwissen, erklären Sie die Besonderheiten des gewerblichen Rechtsschutzes in Ihrem Land, erzählen Sie Ihre Geschichten, erläutern Sie bewährte Vorgehensweisen, kommentieren Sie Rechtsprechung, präsentieren Sie Ihre Arbeitsergebnisse...

Vernetzen Sie sich mit den 12.500 **epi** Mitgliedern in 38 Ländern!

Ihr Artikel wird in der Zeitschrift **epi Information** und/oder auf der **epi**-Website veröffentlicht. Und wer weiß, vielleicht sogar auf der Titelseite von **epi Information**?

Ein engagiertes Team kann Ihnen bei der Strukturierung Ihres Artikels helfen.
Wecken Sie den Journalisten in Ihnen!

Wie können Sie das tun?
Senden Sie Ihren Beitrag per Email an
editorialcommittee @patentepi.org

Zögern Sie nicht, den Leitfaden für Autoren[1] und frühere Ausgaben der Zeitschrift **epi Information**[2] zu konsultieren.

Que faites-vous ?

Devenez journaliste ! Votre revue trimestrielle **epi Information** **recherche des auteurs**. Soutenez la Commission de rédaction d'une revue professionnelle !

Faîtes-vous connaitre auprès de vos confrères ! Faîtes savoir votre savoir-faire, expliquez les spécificités de la PI dans votre pays, racontez vos anecdotes, expliquez les bonnes pratiques, commentez une jurisprudence, présentez un ouvrage professionnel…

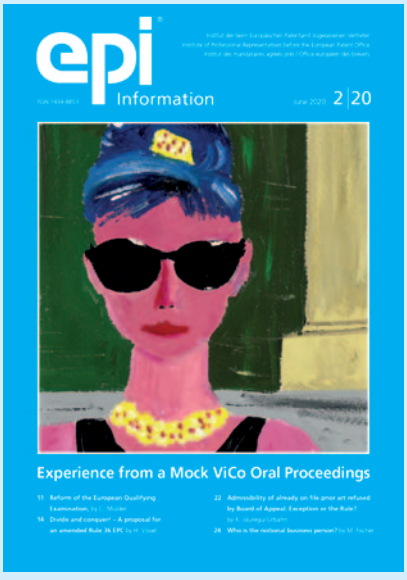
Tissez des liens avec les 12 500 lecteurs membres de l'**epi** répartis dans 38 pays !

Votre article, celui-ci sera publié dans votre revue **epi Information** et/ou sur le site de l'**epi**. Et peut-être faire la Une de **epi Information** ?

Une équipe dédiée pourra vous accompagner dans la structure de votre article.
Réveillez le journaliste en Vous !

Comment faire ?
Proposez vos sujets à
editorialcommittee@patentepi.org

N'hésitez pas à consulter la charte éditoriale[1] et à consulter les précédents numéros de **epi Information**[2].



epi modernises its communication media and optimises content for its members

As **epi** is mainly made up of volunteers, and even though their contributions are highly appreciated, the nature of voluntary activity means that there are limitations on organised, structured and effective communication.

The efforts of our members have been stretched to the limit when it comes to modernizing and developing **epi** communication network, as well as publicizing the work of **epi** committees to its 12,500 members in 38 countries.

For this reason, **epi** has asked the Communications Agency Fargo (https://en.fargo.agency) to professionalise and structure its communication with its members and, to a lesser extent, with external institutions.

The objectives and challenges are to strengthen communication between you and the epi

This will include: making the website an essential source of information for members reviewing the organisation and ergonomic aspects of the websites, and reviewing the other communication tools used by **epi**, such as the annual report and the slideshow/country.

To this end, this new communication strategy will involve creating and enriching communication channels in order to raise awareness:

1) to inform the members of the work of **epi** (committee news, "**epi** Information")
2) to encourage members to consult **epi**'s main online communication channels (website, LinkedIn).

Then, we will focus on the optimising:

1) professional expertise, by means of members' articles and
2) the institutional content emanating from the various committees and the management of **epi**.

Finally, we will adapt the content for the various distribution channels and assist in publication on the appropriate media:

1) website,
2) **epi** information, LinkedIn, each linked to the other.

Note from the Editorial Committee: We are grateful to Fargo for providing the above summary of the work on which they are about to embark on our behalf. We on the Editorial Committee have had two useful meetings with Fargo already, and we look forward to seeing how they can assist us in sharing news, information and opinions with our fellow members. We are open to all ideas.

Election of a new Secretary General

We would like to inform you that, after having organised the successful online election of the committees for the period 2020-2023, our Secretary General, Cornelis (Cees) Mulder, decided on 13th January to leave the Board with immediate effect because of a fundamental difference of opinion about the Institute's internal processes and strategy. We thank Cees for his valuable contributions and strong commitment to the Institute and wish him all the best in his future personal and professional endeavours. Cees will remain a full Council member and we look forward to relying on him for further valuable input in other areas of our Institute.

Our Deputy Secretary General Magda Augustyniak is carrying out the duties of the Secretary General.

There will accordingly be an election of a new Secretary General during the next Council meeting on 8th May (C90) and, possibly, also of a new Deputy.

Details of the election procedure will be announced as soon as possible.

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

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

European Patent Institute · Bayerstrasse 83 · 80335 Munich · Germany

Mr António Campinos
The President
European Patent Office
Bob-van-Benthem-Platz 1
80469 München

via email: president@epo.org
cc: president@patentepi.com, committees-support@patentepi.org

22 December 2020

Dear Mr. President

Document CA/PL 5/20 referring to an "Update of legal aspects of artificial intelligence and patents" was submitted to the Committee on Patent Law on October 23, 2020. The document provides important insights into the EPO's thought process on and developments in relation to inventions involving the use of artificial intelligence (AI).

epi shares the view that AI may be considered a key technology in the fourth industrial revolution. In representing more than twelve thousand European Patent Attorneys from all member states of the EPC, **epi** would like to present its attached comments on this important document (CA/PL 5/20), prepared by the **epi**'s technology subcommittee on ICT for your perusal.

In an attempt to establish a broader understanding of **epi**'s position, we are providing the same document to the Chair of the Committee on Patent Law for distribution to the Committee.

epi and in particular its technology subcommittee would welcome further discussions on the matter, where considered helpful.

We extend our best wishes for the coming holiday season and the new year.

Chris Mercer
Chairman EPPC

Michael Fleuchaus
Chairman ICT subcommittee

Chair Chris Mercer
epi Secretariat · Bayerstrasse 83 · 80335 Munich · Germany
Phone +49 89 242052-0 · Fax +49 89 242052-220
info@patentepi.org · www.patentepi.org

Direct Phone: +44 1 483504336
EPPC@patentepi.org

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

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

22 December 2020

epi's technology subcommittee on ICT's comments on CA/PL 5/20

The below comments follow the section numbering in document CA/PL 5/20 of October 23, 2020.

IV. CONTEXT

epi together with Business Europe had a meeting in July 2020 with the EPO on a number of specific AI related cases that the EPO considers using as positive and negative examples in the Guidelines. This meeting isn't mentioned in the article nor are the outcomes or the intent by the EPO to add examples to the Guidelines that have been assessed in a collaborative environment with **epi**, Business Europe and the EPO.

However, the EPO's practice over the past years to involve, *inter alia*, the **epi** has been widely acknowledged and considered valuable. It would thus be suggested to supplement this section with a corresponding note.

VI. INVENTORSHIP

It seems that currently only inventions as per category 1) are relevant and the issue of a non-human inventor has not truly arisen—safe for the purported DABUS cases where, however, the contribution of the machine has in no way been explained/reasoned about and appears spurious. It is not discussed in the DABUS specification, how the purported invention was devised. If it really was by the machine, there is no explanation to that extent in the patent specification nor has it been given throughout the procedure.

Accordingly, for the time being, it seems that inventions are made by individuals (e.g. software developers or engineers), who set up an AI system, who trained the machine with data, who interpreted the output of an ML algorithm, who improved the ML algorithm to obtain a certain technical effect or who identified the technical application of the output of an AI system (or a combination thereof).

It seems that a case in category 2), let alone category 3), hasn't really occurred yet (at least the members of the ICT subcommittee of the **epi** have not dealt with any such cases that weren't speculative). It would also appear hard to believe that even for category 2) in which an individual specified a problem, a machine would return a solution to the problem despite the huge non-linearity of neural networks, without such solution having been intended by the individual during the

Chair Chris Mercer
epi Secretariat · Bayerstrasse 83 · 80335 Munich · Germany
Phone +49 89 242052-0 · Fax +49 89 242052-220
info@patentepi.org · www.patentepi.org

Direct Phone: +44 1 483504336
EPPC@patentepi.org

design of the system and/or having been reiterated and improved by adapting the ML algorithm and/or the training dataset.

It would thus appear that, currently, technology has not yet progressed from a phase of AI inventions in category 1) to category 2). If such were the case, then applications appear to have failed so far to teach how in fact a machine may have made an invention that extended in a non-obvious manner beyond the contribution of the individual(s) who set-up, trained, interpreted and improved the machine before using the results it provided.

Therefore, the ICT subcommittee of the **epi** sees no reason for amending the current practice.

In order to ensure that movements in this area aren't missed, however, there might be a certain interest in "sub-designating" a machine to an inventor, i.e. specifying that a machine contributed to the invention under the control of one inventor. In such case, the application would need to disclose the contribution of the machine and how/why the machine has **contributed** to the **actual invention process** beyond the human inventor. Safe for a potential benefit to a sufficient disclosure, this may pave the way for a controlled observation when inventions are indeed moving from category 1) to category 2) and prompt a legislative process at the appropriate time and without undue experiments.

VII. OWNERSHIP

As a consequence of the comments to section VI. the ICT subcommittee of the **epi** sees no motivation for a change of practice.

However, it is noted that "Accordingly, if the natural person who trains the AI system is the inventor, ..." (section 20 of CA/PL 5/20) appears to be too narrowing a statement; it only considers inventions where the core contribution lies in the training data and how to train the system. However, finding new topologies for AI systems which can lead to a technical effect would be excluded (an invention can also lie in the structure of the AI system which may be superior to learn new functions for more accurate classification/regression etc.).

We consider this statement an unintentional error as the EPO's day-to-day practice does not seem to exclude inventions based on new topologies. Suitable amendment is suggested to be made.

IX. POTENTIAL REVIEW OF THE PRINCIPLES OF INVENTORSHIP AND OWNERSHIP

As a consequence of the comments to section VI. and VII. the ICT subcommittee of the **epi** sees no motivation for a change of practice.

X. INVENTIVE STEP

It appears relevant—more than otherwise—to closely match the requirement for a sufficient disclosure by an application referring to AI to the disclosure in the prior art. A prior art disclosure should be very carefully assessed as to it sufficiency in terms of a technical teaching that enables a skilled person to carry out a certain process to receive an intended result.

A certain imbalance between an assessment of an application by an EPO examiner and the prior art that has been found relevant to such application has been raised by the ICT subcommittee of the **epi** as an issue before, namely, the prior art disclosure being allowed to be very patchy, incomprehensive and only disclosing a result rather than a technical teaching but still considered as a broad and complete disclosure.

Moreover, the ICT subcommittee of the **epi** raises concerns with regard to section 30 of CA/PL 5/20: "Therefore, content generated by AI qualifies as prior art as long as it was made available to the public.": Fundamentally, the concept of disclosure is of course not objected to; however, it is of utmost importance that such content generated by AI is analysed with a high bar in terms of sufficiency and enablement of the disclosure to make sure it does indeed disclose a workable technical teaching that would have enabled a skilled person to carry out a certain process to receive an intended result.

Without that, nonsensical/insufficient disclosures produced by, e.g. http://allpriorart.com/ which automatically produces an endless stream of "prior art" may be read onto a claim of a true technical teaching while itself being completely spurious.

It appears incorrect to base an obviousness argument on such a disclosure as it is made purely by chance and without the idea behind the problem-solution-approach to actually address a technical problem by applying technical considerations. In the case of AI, this includes, as indicated above, the—human—process of setting up an AI system, who is trained with data, whose algorithmic output is interpreted and improved, to obtain a certain technical effect. None of these can be derived from machine generated "prior art", such as by allpriorart.com.

Therefore, it is held that the requirement of a sufficient and enabling disclosure of "prior art" generated by an AI system must be high enough to warrant that the purported "invention" made by such system can be carried out by a skilled person.

XI. DISCLOSURE OF THE INVENTION

In T 0161/18 the BoA determined that, for a sufficient disclosure, the training of an AI system has to be disclosed in sufficient detail. Merely disclosing inputs and outputs of the system was considered insufficient. Many AI solutions depend strongly on the training data set; correct training is often decisive for achieving the claimed technical effect. This does not apply to AI inventions where the

contribution lies in the topology/structure of the AI, but where existing backbones are used—more or less unmodified—with training data that is tailored to the application.

While a description of the nature of the training data (e.g. which types of images are used, which data augmentation methods, etc.) can be given and **may** be sufficient, often a much higher degree of **specificity** of the training data set (e.g. image data) is required to provide an enabling disclosure. In such cases, it might be beneficial for both the applicant (to meet the sufficiency/enablement and/or clarity requirements) as well as the public (to be sure that the requirements for the grant of a monopoly are indeed met), if such training data could be submitted to be stored in association with an application.

Within the current framework of the EPO, this appears impractical in most cases, in particular also because of the substantial page fees that are charged by the EPO for applications (where such disclosure could be added to an application) as well as the fact that non-written material (images data, audio data, etc.) cannot be submitted. Training data is often very voluminous and impractical for printed publication.

The ICT subcommittee of the **epi** suggests that the EPO reviews the possibility to allow filing of additional data containers, e.g. in XML format as accompanying documents with the filing of a patent application free of charge. Similar concepts are available for the filing of sequence listings and have proven useful.

On another note, section 33 CA/PL 5/20 appears to be worded incorrectly (presumably inadvertently): It says *"The field of technology must be given in the application and the **objective** technical problem must be **directly derivable** from the application documents. This information allows the determination of the level of knowledge of the skilled person."* – emphasis added.

The **objective** technical problem is what is derived from the comparison of the closest prior art vs. the claim via the definition of a technical effect that the delta brings about. Asking that the application documents must allow deriving the **objective** technical problem can be construed to mean that the application needs to start out from the closest prior art. This, however, is often unknown at the time of drafting but may only be uncovered during the search phase.

The **objective** technical problem is, indeed, a legal construct designed by the BoA in the creation of the Problem-Solution approach. Demanding that this be **directly derivable** from the application documents may mean there may be consequences if an application does not happen to match the objective technical problem in view of the—later searched—prior art (as the consequence may then be that the skilled person's level of knowledge cannot be determined correctly).

The ICT subcommittee of the **epi** questions why this suggestions/statement is made and why there is a deviation from the existing approach (a) define closest prior art, (b) define technical effect of the delta, (d) define objective technical problem from the technical effect, (e) define the skilled person and its knowledge, (f) check if there is an inventive step.

It is assumed the EPO intended to say that the application must disclose a technical problem it is trying to solve (which necessitates the description of the technical field the purported invention is applied in) but the ICT subcommittee of the **epi** cannot see the notion that the **objective** technical problem and the skilled person's knowledge is required to be **directly derivable** from the application (alone).

Leaving the document unamended in this form would be considered a reason for significant concern by the ICT subcommittee of the **epi** given its potential to confuse what is rightfully considered a very stable approach to determining inventive step in CII.

XII. USE OF AI IN PUBLIC ADMINISTRATION AND ACCOUNTABILITY FOR DECISIONS

AI decisions cannot be assessed for reasons and there is no "reasoning" coming with it. As such, there is also no reasons for a decision that could be verified by an adversely affected party or a higher instance.

Sometimes AI decision making processes go phantastically wrong and are or become unstable. As long as an AI cannot produce a line of arguments explaining its reasons for a certain decision—and this will take at least until inventions of category 3) are available—there is no room for a decision-making process in patent prosecution or legal decision making in general for the mere reason alone that these decisions are not verifiable.

European Patent Office | 80298 MUNICH | GERMANY

Mr Chris Mercer
Chairman EPPC
and
Mr Michael Fleuchaus
Chairman ICT subcommittee
European Patent Institute
Bayerstrasse 83
80335 München

Via email:
mf@fleuchaus.com
chrispmercer@btinternet.com

European Patent Office
80298 Munich
Germany

Office address
Bob-van-Benthem-Platz 1
80469 Munich
Germany

epo.org

The President

Tel. +49 (0)89 2399 - 1000
Fax +49 (0)89 2399 - 2892
president@epo.org

Date: 27.01.2021

Letter dated 22.12.20 - Comment on CA/PL 5/20

Dear Mr Mercer and Mr Fleuchaus,

Many thanks for sharing the comments prepared by epi's technology subcommittee on ICT on the document CA/PL 5/20 referring to an "Update of legal aspects of artificial intelligence and patents". epi remains one of the EPO's most valued partners providing vital insights into the views of the patent community. In the meeting you refer to, epi and other users have contributed to the preparation of examples with model solutions to illustrate the treatment of applications involving artificial intelligence and machine learning. Latest versions of these examples taking into account the results of the discussions and further internal review, were recently forwarded to you. Once the examples are finalised, we plan to share them with the public, acknowledging the valuable contribution of our partners.

We appreciate that epi sees no reason for amending the current practice as regards inventorship and ownership and shares the EPO position with respect to the use of AI in public administration. We are working with our partners from other patent offices and users in ensuring a shared understanding of the issues relating to patenting AI and taking advantage of the opportunities offered by AI. The examination practice of computer-implemented inventions, to which AI inventions belong, is well-established at the EPO, and explained in the regularly updated Guidelines for examination. Internal alignment of practice in view of emerging issues, such as AI-generated content as prior art in the assessment of inventive step, is ensured through continuous training and dialogue.

While we take note of all the valuable comments you shared, please allow us to address two of them in more detail.

You suggest that it should be possible to file large datasets of training data free of charge, e.g. in XML format. The practice of the EPO sets clear principles for the scope of disclosure, as recently also confirmed in the Board of appeal decision T 161/18 mentioned. For now, case law does not introduce a categorical requirement to disclose large datasets. We continue to monitor the developments and would immediately inform the users if a change is to be expected.

We also note epi's call for clarification of the statement as to the definition of the objective technical problem in paragraph 33 of CA/PL 5/20. As pointed out in your comments, the approach to determining inventive step in CII is well-established and stable. This approach is not put into question by any statements made in the document. While CA/PL 5/20 describes the practice based on the EPC and reflected in the Guidelines for examination, the detailed explanation of the problem-solution-approach is not in the focus of that particular section of the document. The questioned statement was not meant to deviate from the EPO practice of assessing inventive step.

We look forward to continuing the fruitful dialogue with epi in the coming months. Let me thank you for the good cooperation in 2020 and wish you and the epi members a healthy and prosperous year ahead.

Yours sincerely,

António Campinos

Patent Practice

Patenting of Antibodies in the European Patent Office and the New "Guidelines" – Boon or Bane?

M. Kawczyńska (PL), European and Polish Patent Attorney, Polservice Patent and Trademark Attorneys, Warsaw
J. Meier (DE), European and German Patent Attorney, Vossius and Partner, Munich

Antibody technology, whether in the context of biotechnological research tools or in pharmaceutical settings, is a rapidly developing and ever evolving field, as demonstrated by the current COVID-19 pandemic. Appropriate IP protection for inventions based on these conventionally large proteinaceous molecules is of paramount importance for innovators, in particular considering the extensive, time consuming research and development processes, not to mention huge investment costs, before an actual product enters the market.

The EPO is rightfully considered as one of the key Intellectual Property Offices for patent examination. It is globally recognized not only for the quality and reliability of its procedures and its consistency and transparency, but also for the well-established case law of the (Technical) Boards of Appeal. This reputation, also in the life science field, is also based on the comprehensive "Guidelines for Examination". These are made available internally to EPO examiners, but more importantly also to the public, in particular patent applicants, their representatives and all other interested parties. The latest version of the "Guidelines" enters into force on 1 March 2021 and now includes a highly welcomed section directed explicitly to the patentability of antibodies, section G II, 5.6.

The specificity and complexity of antibody inventions made it at times difficult to directly apply the previous "Guidelines". Specifically, these were drafted primarily in view of other fields of technology, including e.g. pharmaceuticals based on so called "small (chemical) molecules". However, antibodies and antibody-derived proteinaceous constructs tend to be rather complex molecules that may elicit different and complex physiological responses or functions, especially in a therapeutic and/or diagnostic setting. Whereas naturally occurring antibodies are conventionally characterized as large biological "Y-shaped" molecules composed of two identical

"heavy chains" and two identical "light chains", new antibody formats and/or antibody derivatives have made their important entrée in the world of pharma. Both conventional antibodies as well as these new formats and derivatives are considered "biologics". Although it is evident that these biologics are subject to the same patentability requirements as other products (with the exception of the specifics of Rules 27 to 29 EPC[1] which mirror the provisions of European Union Directive 98/44/EC on the legal protection of biotechnological inventions (the 'Biotech Directive')), the unique biological and/or physiological features of these active molecules also need to be considered when assessing patentability before the EPO. Therefore, the updated version of the "Guidelines" now comprises detailed information on the approach of the EPO to antibody patentability, in particular in relation to the allowable claim formats and the assessment of "inventive step". This newly introduced section G-II 5.6 provides parties with guidance as to how antibodies/antibody constructs may be defined, e.g. by their own structure (the "Guidelines" relate here to amino acid sequences or to encoding nucleic acid sequences), by reference to the (target) antigen and/or the "epitope", by the production process, or by reference to their functional and structural features. In sections G-II, 5.6.1.2 and 3, the "Guidelines" provide that an antibody can be, for example, functionally defined by the antigen it binds to, but, in addition, may also be characterised by functional features defining further properties. As examples, the "Guidelines" refer here to binding affinity, neutralizing properties, induction of apoptosis, internalisation of receptors, and inactivation or activation of receptors. The "Guidelines" now caution that, if an antibody is exclusively defined by functional properties, the EPO is to carefully assess "whether the application provides an enabling disclosure across the whole scope claimed" and "whether the functional definition allows the skilled person to clearly determine the limits of the claim".

The EPO's current examination practice and its well-established case law on the patentability of antibodies have found an adequate reflection in these new "Guidelines".

The newly introduced section appears to be balanced, recognizing the complexity and peculiarities of the field, while providing reasonable options for antibodies to be defined without hampering further developments and inventions in this field.

It is of note that prior to the development of the new "Guidelines", the EPO also routinely and rightfully granted patents for antibodies that were the "forerunners" in the field, taking "functional features" of such forerunners into account. The allowability of functional features was considered and confirmed in very early decisions of the Technical Boards of Appeal, such as inter alia *T 430/92 'Growth of Tulips/SUMITOMO' and T 412/06 'Proteinase inhibitor/MAX-PLANCK-GESELLSCHAFT'*.

Compound claims reciting "functional features" of a novel and inventive antibody accepted by the EPO may have a broad scope of protection because they do not limit the claimed antibody to any particular structure (and thus potentially encompass a wide variety of amino acid sequences). However, one must be able to distinguish the claimed antibody from those known in the art based on their clearly defined and specific (biological/biophysical) activity. Such distinguishing functional features may potentially include any feature identified by the inventor, as long as these features are novel, inventive and enabled over the full range as claimed. Such features may correspond to in vivo and/or in vitro activities and also include those determined in cell-free assays (e.g. antibody affinity, cross-reactivity) and/or in cell cultures (e.g. anti-proliferative or stimulatory activity). It is also understood that the selection of a specific type of antibody for further study, for example in clinical trials, may be based on (a) feature(s), which will differentiate the antibody under investigation from already known antibodies with known properties.

In accordance with the new "Guidelines", it appears to be feasible that functionally defined antibody claims and claims directed to a novel and inventive (biological, medical and/or diagnostic) use of an antibody can meet the patentability requirements before the EPO, provided the description in the application and the knowledge already available in the prior art allow the skilled person to find such antibodies. In this respect, the time it takes to obtain, screen for and/or make corresponding antibodies seems to be of minimal consideration. This is in line with case law of the EPO and, in this regard, it may be decisive, again, that the application as filed comprises enough technical guidance 'to reproduce the invention to practice without undue burden'. As reflected in the "Guidelines", this is nothing exceptional and is based on several decisions of the Technical Boards of Appeal, e.g. *T 617/07 'Monoclonal NGF-antagonist antibodies/LAY Line'* or *T 1300/05 'RET screening assay/PROGENICS'*, e.g. illustrating that functional features, in particular specific binding, can characterize claimed antibodies.

1 Rule 28 EPC relates to exceptions to patentability. It provides that European patents shall not be granted in respect of biotechnological inventions which concern either the cloning of human beings, modifying the germ line genetic identity of human beings, the use of human embryos for industrial or commercial purposes, or modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal. Accordingly, neither nucleic acids nor proteins, including antibodies, are affected by the exclusions established in Rule 28 EPC.

Furthermore, Rule 29(2) EPC makes it clear that an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of said element is identical to that of a natural element. In *T 272/95 'Relaxin/HOWARD FLOREY INSTITUTE'*, it was confirmed that inventions falling under this category, i.e. even naturally occurring elements, are not excluded from patentability. This was also acknowledged, inter alia, in *T 1213/05 'Breast and ovarian cancer/UNIVERSITY OF UTAH'*.

It should also be noted that, in our opinion, there is no harm to third parties (or the public) in claiming antibodies based on functional features, e.g. the specific binding to a novel and inventive antigen/epitope/target/etc. The EPO, again rightfully, considers that an inventor is entitled to patent protection for an 'antibody specifically binding to a defined antigen/epitope/target' when a novel and inventive antigen/epitope/target/etc. is provided. This is because the EPO sees the preparation of antibodies, such as polyclonals or monoclonals, as a routine technique readily mastered by the skilled person. However, if functionally defined antibodies are claimed, and the claimed function goes beyond 'specifically binding', additional support in the experimental part of the application will be required. Again, in our opinion, the public is protected from allegedly "senseless" antibody claims because the Technical Boards of Appeal have repeatedly emphasized that an effort to define a feature in functional terms had to be abandoned where it would jeopardize the clarity of a claim as required by Article 84 EPC.

Examples of the EPO's previous correct approaches to the patentability of (allegedly) broad antibody claims, e.g. when a novel and inventive antigen and/or antibodies targeting such novel "antigens" are found, are inter alia, illustrated by *T 18/09 'Neutrokine/HUMAN GENOME SCIENCES' or by T 1902/11, 'Human IL-23/MERCK SHARP & DOHME'* (see Reason 56).

In light of the plausibility concept applied by the EPO, functionally defined antibody claims are often contested as allegedly attempting to monopolize antibodies that have certain properties 'to be achieved' ('desiderata'). However, the Technical Boards of Appeal have scrutinized functional claims and have considered them permissible as long as the patentability requirements of novelty, inventive step, enablement and industrial applicability were met, and the teachings provided by the applicant were 'plausible' at the relevant filing date. This also holds true for antibody claims directed to a novel and inventive epitope/target/antigen.

Nevertheless, this patentability approach finds its limitations where it is not plausible from the application as filed that specific antibodies to said antigen can be obtained with 'routine methods known in the art'. On the other hand, inventive step of a claim to a novel antibody specific for a known antigen is typically rejected by the EPO unless there is tangible evidence to doubt that the novel antibody could have been obtained by mere routine methods. Accordingly, and considering that the EPO does not accept a 'structural non-obviousness approach'[2] as applied by the USPTO, the provision of further antibodies with novel CDRs or novel variable regions (such as humanized antibodies) by applying such routine methods is not normally considered as inventive. Rather, it needs to be made plausible that these novel antibodies have an unexpected technical effect and/or superior properties for inventive step to be acknowledged. This principle was summarized in *T 735/00 'Anti-CRP antibodies/IATRON LABORATORIES, INC.'* as follows:

> "The case law in this field acknowledges inventive step if and when there is evidence that a claimed monoclonal antibody prepared by routine methods shows unexpected properties (cf decision T 645/02 of 16 July 2003). If, however, there are no unexpected effects achieved with a further monoclonal antibody compared with a [prior art] monoclonal antibody with essentially the same properties as desired the case law denies inventive step (cf decision T 512/94 of 23 June 1998)."

The holding of *T 735/00* has been acknowledged as 'established jurisprudence in the field of antibodies'; see, e.g. *T 605/14, 'Anti-angiopoietin-2 antibodies/MEDIMMUNE'*, see in particular Reason 25.

Accordingly, the new "Guidelines" basically confirm previous case law of the EPO and make clear that strictly structural definitions by amino acid or nucleic acid sequences are not the sole allowable definitions for antibodies. Rather, functional definitions, e.g. by reference to the target antigen, and in certain circumstances, the use of sequence identity limitations, are also accepted. Therefore, and as mentioned in new section G-II 5.6.1.4. of the "Guidelines", allowable antibody definitions may also comprise combinations of both structural and functional features. For example, it is possible "to claim antibodies by the sequences of both the variable domains or CDRs with less than 100% sequence identity when combined with a clear functional feature". Again, as also recited in the new "Guidelines", the corresponding functional feature is not limited to the (specific) binding to a target, but may, illustratively, comprise binding affinity, neutralising properties, induction of apoptosis, internalisation of receptors, and inhibition or activation of receptors (see, section G-II 5.6.1.3 of new "Guidelines" also referring to e.g., *T 299/86*, Reasons 3-6 and *T 1300/05*, Reasons 4-7).

Marta Kawczyńska

Jürgen Meier

2 The EPO does not accept the principle of 'structural non-obviousness'; see, e.g., Technical Board of Appeal, decision in *T 605/14* of 7 June 2018, *'Anti-angiopoietin-2 antibodies/MEDIMMUNE'*, Reason 24 , and Technical Board of Appeal, decision in T 187/04 of 11 January 2007, *'Antikörper/KREBSFORSCHUNGSZENTRUM'*, Reason 11.

Antibody claims reciting functional features that do not limit the antibody to any particular structure but potentially distinguish the claimed antibody from those already known in the art are normally based on one or more specific and unique activities. Such distinguishing and potentially superior functional features can comprise any feature identified by the applicant/patentee. However, the new "Guidelines" also caution that "if an antibody is claimed exclusively by functional features and the prior art discloses in an enabling manner an antibody directed to the same antigen using an immunisation and screening protocol that arrives at antibodies having the claimed properties, it has to be assumed that the prior-art antibody inherently displays the same functional properties as the claimed antibody, which thus lacks novelty"; see, again, G-II 5.6.1.3.

At least since decision *T 1329/04 'Factor IX/Johns Hopkins'*, the 'plausibility approach' has become a further "standard" in the assessment of patentability. In the context of this "plausibility approach", the EPO does not bar the patenting of antibodies by reference to functional features, including affinities to the target molecule, avidity, inhibitory or activating functions, binding specificities and the like. Nevertheless, and as now also reflected in the "Guidelines", such technical features may be contested by examiners as not having been demonstrated for the entire class of antibodies covered by the claims, in particular, where the claims do not comprise additional (limiting) structural features. Accordingly, it is advisable to have a plausible/technical teaching in the patent application that supports the corresponding functional feature. As discussed above, these functional features are also critically scrutinized by the Examining Divisions/Opposition Divisions of the EPO for clarity and completeness of disclosure. Technical features expressed in functional terms must be able to be verified by tests or procedures adequately specified in the description, or generally known to the skilled person. Such tests and/or screening assays further need to be reproducible, and the specification has to provide means and methods allowing a skilled person to reliably obtain the corresponding parameters and/or concrete comparative values, e.g. binding or affinity constants. This appears to be a fair approach taken by the EPO.

As is evident in previous EPO decisions, e.g. *T 617/07 or T 1300/05*, and as now reflected in the "Guidelines", the consideration of "functional" definitions during examination will also focus on whether disclosure is enabling and/or plausible so as to merit protection over the entire scope claimed. In the case of definitions by a combination of both structural and functional features, it is also envisaged that recitation of the variable domain sequence or sequences of six CDRs might not be required. Another allowable definition format, under certain conditions, is a definition of an antibody by the process of its production, e.g. immunization protocol, specific cell line used for the production, or deposited hybridoma producing the antibody. In light of the above, a further allowable claim format is the definition of an antibody by its binding partner/antigen/epitope, provided that its binding partner/antigen/epitope as such is sufficiently disclosed and clearly defined, for example by its specific amino acid residues or a clearly defined sequence fragment.

It is also of note that third parties are not barred from obtaining (additional) patent protection for specific (novel and inventive) antibodies that are, for example, characterized by clearly limited structural features. For these types of inventions it should be documented in the patent application that the claimed specific antibody has an unexpected, advantageous effect. Such exemplary effects can include its binding properties, activity in combination with other drugs, the provision of a truly novel clinical situation (then often in combination of a "second medical use claim") and the treatment of a specific disease. Along these lines in a more restricted claim scope, for example the use of a specific (surprisingly advantageous) antibody in the treatment of a specific disease, even the same therapeutic antibody could be claimed in the use of the same disease as disclosed in the prior art. This is, inter alia, of particular relevance when a novel technical effect, not previously elucidated, is obtained by a biologic, like an antibody. Relevant decisions in this context are *T 836/01 'Interferon-beta2/YEDA RESEARCH AND DEVELOPMENT CO. LTD.' and T 1642/06 'Sigma receptor/SPRUCE/BARBARA, et al.'*.

The EPO's approach to establish inventive step does not appear to be entirely comparable to a "structural non-obvious approach" as applied by the USPTO. Yet, in both jurisdictions, patent protection for a specific antibody is achievable even where a certain "genus" of corresponding antibodies was known in the prior art. However, the approach for "inherent disclosure" before the USPTO and for "selection inventions" before the EPO are rather different. In the practice of the EPO, "unexpected technical effects" of a selected species merits patent protection even if the "genus" was known. In contrast, because there is no predictable relationship between the sequence of an antibody and its function, the USPTO takes the view that an antibody with a distinct sequence is likely to be patentable, even if it performs the same function as an antibody which is already known. This is, partially, based on the so-called doctrine of structural non-obviousness.

As also reflected in the new "Guidelines", the EPO would allow patent protection for antibodies that are, for example, identified and/or elucidated via *non-routine* methods and/or when it can be plausibly documented that "routine methods of production" would not lead to success, i.e. defining antibodies by their "production process". An example for corresponding case law is *T 1280/08 'Immunoglobulin products/STATENS SERUM INSTITUT'*. Here, the Board considered a process for purifying immunoglobulin G (IgG) from a crude immunoglobulin-containing plasma protein fraction. It followed the patentee's argumentation for patentability in that the provision of the required new process for purifying IgG from plasma

was not an easy task due to the high complexity of the starting material and the fragility of the immunoglobulins.

Additionally, in the case of assessment of inventive step of antibody inventions, the approaches taken by the Examining Divisions, the Opposition Divisions as well as the Technical Boards of Appeal, in particular the long established "problem-solution-approach", seem to be fairly balanced and flexible. Specifically, any novel antibody can be considered inventive if it provides for an unexpected (surprising) technical effect and if the application shows that such effect was obtained or at least made plausible. Again, this consistent approach of the EPO appears to be well reflected in the new "Guidelines", providing an illustrative, non-exhaustive, list of surprising technical effects that may be considered. It must be noted, however, that the existence of a surprising technical effect is not necessarily required for an acknowledgement of inventive step. Art. 56 EPC does not require that the problem to be solved by the invention be new. In accordance with the established case law, an alternative solution to a known problem might be inventive provided that the problem has been solved in another, non-obvious way; this is also reflected in the "Case Law of the Boards of Appeal" book (2019) under "Inventive Step" I.D.4.5 on page 195 and referring in this context to *T 92/92*[3], with reference to *T 495/91*[4], *T 780/94*[5], *T 1074/93*[6], *T 323/03*[7], *T 824/05*[8]. What is especially evident in view of, e.g. T 588/93[9], is that for an acknowledgement of inventive step, it was not necessary to show any improvement over the prior art. Thus, a prior art solution to the technical problem does not automatically preclude that a later, different, solution possess an inventive step (*T 1791/08*[10]). The condition for acknowledgement of inventive step in such a case is that the alternative solution must solve the problem in another, non-obvious way.

According to the new "Guidelines", structural non-obviousness, or unpredictability, does not justify inventive step of a novel antibody binding to the same antigen as known antibodies if the novel antibody is solely structurally different from the known antibodies. As explained in the "Guidelines", a sole structural difference of an antibody binding to the same antigen as known "prior art" antibodies is thus not sufficient to acknowledge inventive step. This is premised on the position that using known methods to produce alternative antibodies is considered obvious for the skilled person, even though the structural features of such antibodies, i.e. their amino acid sequences, are different from and not predictable based on the known antibodies (see "Guidelines" G-II 5.6.2, also *T 605/14 'Anti-angiopoietin-2 antibodies/ MEDIMMUNE'*).

A purely "structure-based inventive step" approach[11], i.e. only based on a change in structure, even a minor one, without any shown or plausible unexpected technical effect or without any contribution to the state of the art may bear the danger of leading to a certain increase of "me-too patents". Such "me-too patents" could potentially devaluate the patent of the original invention. Whereas this may lead to an overall weakening of the underlying incentive, the patent system is conceived to support the high investments required to develop new and innovative antibodies. Therefore, each antibody claim needs to be assessed (and examined) individually and even a minor modification of a previously provided "structure" may lead to a novel and inventive "functional feature", as also reflected in *T 67/11 'Humanized antibodies / CENTRO DE INMUNOLOGIA MOLECULAR'*, e.g. in Reason 24.

In any event, and also in the light of the new "Guidelines, the good news is that any antibody invention before the EPO can still be considered inventive if the application itself demonstrates or renders it plausible that a technical problem has been overcome by the provision of said antibody and/or that difficulties of technical nature in obtaining said antibody or difficulties in its production process have been successfully overcome.

3 https://patentepi.org/r/info-2101-02
4 https://patentepi.org/r/info-2101-03
5 https://patentepi.org/r/info-2101-04
6 https://patentepi.org/r/info-2101-05
7 https://patentepi.org/r/info-2101-06
8 https://patentepi.org/r/info-2101-07
9 https://patentepi.org/r/info-2101-08
10 https://patentepi.org/r/info-2101-09

11 A comparison to the practice of the USPTO is not helpful in this context because it would require a more holistic comparison of the whole patenting processes by the EPO and the USPTO, e.g. on inherent disclosure and selection inventions (s.a.).

Summary

In recent years, the field of inventive antibody products has evolved dynamically and successfully. As the relevance and economic value of antibody patents progressively increases, an appropriate IP protection of inventions directed to antibody products is becoming more pivotal. Transparent and well-established patentability assessment criteria, as well as consistent practice applied by the EPO, play a crucial role therein. The current EPO approach to patentability of antibody inventions, as reflected in the new "Guidelines" and newly introduced section G-II 5.6, as well as its well-established case law, is fairly-balanced, providing for sufficient flexibility for claiming and patenting of antibody based inventions, needed and expected in view of their specificity and complexity, as well as multifaceted development.

Attending ViCo Oral Proceedings as a Member of the Public

C. Mercer (GB)

A number of enquires have been received regarding attending ViCo oral proceedings as a member of the public. My understanding of the situation, following discussions with the EPO, is as follows.

As in face-to-face oral proceedings the Guidelines at GL E-III, 8.1 are followed.

Members of the public can follow oral proceedings held by videoconference remotely upon giving prior notice. The request must be submitted via email to the EPO at support@epo.org at least three working days prior to the date indicated in the summons to oral proceedings. A ticket is created and this is placed in the non-public part of the file. This means the Opposition Division or Board knows who plans to attend as member of the public. This information is only used in exceptional situations e.g. where the observer does not behave appropriately and the Division or Board needs to ascertain who that person is.

Chris Mercer

Members of the public attending oral proceedings by ViCo are advised to identify themselves as being a member of the public by entering a user name starting with "PUBLIC" after launching the ViCo platform. Neither the Division nor the Board checks the ID of the member of the public during the oral proceedings.

Participation of the member of the public is restricted to listening to the sound and watching the images transmitted during the videoconference. The member of the public must not switch on his or her microphone or camera, unless requested to do so by the chair. Members of the public are not entitled to speak or otherwise become involved in the videoconference (e.g. by entering messages in the chat box), unless specifically invited to do so by the chair.

Regarding anonymity, as mentioned on the EPO website about public access, point B-3:

> "If so requested by the chairperson, the member of the public must temporarily switch on their camera to allow the videoconference participants to ascertain their identity just as if they were taking part in person on the premises of the EPO".

This will only be done in exceptional cases and merely makes the ViCo situation correspond to the situation for face-to-face oral proceedings where the member of the public can be seen. However, the ID of the member of the public is not checked, as is the case in face-to-face oral proceedings.

The member of the public can use any name to be displayed in the ViCo oral proceedings. In order to help the Division or Board to identify who is a member of the public and who is a party to the oral proceedings, the FAQ published by the EPO on the internet advises members of the public to enter a name starting with PUBLIC (https://www.epo.org/service-support/faq/procedure-law/oral-proceedings-by-videoconference.html). Therefore, is not only possible but even recommended to use a name which does not identify the member of the public to the Division, Board or parties. Thus, Buzz Lightyear could be the identity of the member of the public!

The easiest way to achieve anonymity is join the ViCo with name "PUBLIC". However, be aware that changing name in Zoom® before entering the meeting is sometimes a bit cumbersome. Zoom® has the tendency to keep the information from your last connection and does not ask how you want your name to appear. The box "remember my name" is crossed by default in Zoom® and people do forget to uncross it. Therefore, if you have already had an oral proceedings via Zoom® representing a party, then your real name might appear once you connect. It is therefore advisable to become familiar with changing your name in Zoom® before connecting. It depends on the way you connect so you should check on the internet how to do so.

In summary, attending ViCo oral proceedings as an anonymous member of the public is possible but you need to make sure that you understand Zoom® before you unwittingly give away your identity.

WIPO Online System – WIPO Proof

O. Boncea (RO), on behalfe for the Online Communications Committee

WIPO has launched a new online service called WIPO PROOF, that produces tamper-proof evidence which can be used to prove that a digital file existed at a specific point in time. Proving when a digital content was created by, or was available to a user is, in most of the cases, cumbersome. In this regard, WIPO PROOF provides an easy to use and trusted service that associates to any digital file a WIPO PROOF token – a date and time-stamped digital fingerprint of said file, which can be used as evidence, for example in the context of legal dispute.

Here are the answers to some relevant questions related to the service (for more information visit https://wipoproof.wipo.int/wdts):

How does WIPO PROOF work?

1) A first use of the service is to create a WIPO PROOF token with a specific date and time stamp, to certify that a certain file (e.g. **test.docx**) was existing and in the possession of the user at that specific date and time.

Initially, the user has to connect to the WIPO PROOF web application by using any modern browser, via the url: *wipoproof.wipo.int*. In order to use the service, the user needs to have a WIPO account or otherwise create a new one. After logging in, the user is prompted to select the file to be timestamped. After selecting the file **test.docx**, the user is guided to the payment module and finally the token is generated.

When a WIPO PROOF token is generated, the user receives an online acknowledgement that the token has been created and a confirmation email, including a link to download the token. The date and time associated to the file represent the moment when the user requests the token. Tokens cannot be back-dated.

2) A second use of the WIPO PROOF service is to verify the validity of a token, that is to verify the existence of the digital file test.docx at a specific point in time, based on the associated token. For this part of the service, the original file test.docx and the WIPO PROOF token generated therefor must be available.

It is important to know that the file (in our case test.docx) is never uploaded to WIPO PROOF. The user retains full possession of the digital file (which is good for confidentiality) but also is the only one who controls whether the file remains available for a future verification process (which is a responsibility on the user). Any alteration to the original file, e.g. a slight format change, will invalidate the token verification process. **Thus, it is essential that the original file together with the original token are kept safe, without any alteration.** .

Professional users must therefore establish procedures to safeguard these rights for future need. A simple recommendation of the service provider is to download the token form the link received with the confirmation email and to store the email, token and original digital file together in the same folder (with suitable backup), for easy retrieval. It is also recommended that each element is appropriately named, in order to easily identify them as a package. Case management/document management.

With one token, digital evidence in 10 different languages may be obtained. Both the online verification pages (free) and the premium certificates are available in 10 different languages. For those conducting business internationally, such a benefit may be essential in the case of cross-border disputes.

What can WIPO PROOF safeguard?

Any digital file may be provided with a trusted WIPO PROOF token, for example creative works and designs, trade secrets and know-how, a collection of research data and results, lab notes, version history of agreements or contracts and many more.

What are the benefits of the service?

Getting verifiable, trusted and indefinitely valid evidence that an intellectual asset or other digital assets existed at a specific point in time. Even more, countries have started to legally recognize and accept certified digital evidence as an alternative to the classic notary service.

What are the costs for using the service?

The cost of one WIPO PROOF token with indefinite validity and 5 years of token storage on WIPO servers (it may be that after 5 years, a further fee for storage is needed to be paid) is 20CHF, including taxes and fees. Other options exist, e.g. buying a bundle of 10 tokens for a discounted price or asking for a premium certificate. The online verification of a WIPO PROOF token is free of charge.

Interview mit Martin Wilming

Interview: M. Thesen (DE), Member of the Editorial Committee

Herr Wilming, erzählen Sie doch mal ein paar Dinge zur Arbeit an den Richtlinien!

Martin Wilming: Die Richtlinien werden sehr regelmäßig überarbeitet, und eine Arbeitsgruppe des **epi** liefert dem EPA hierbei wertvollen und auch sehr willkommenen Input. Seit 2020 wird sogar mit einer öffentlichen Konsultation systematisch Feedback der Nutzer eingeholt – so auch in diesem Jahr wieder, bis voraussichtlich 12. April 2021. Da gilt es stets, in recht kurzer Zeit ziemlich viele Änderungen zu sichten und kritisch zu hinterfragen.

Inwiefern ist diese Arbeit relevant für unsere Praxis?

Martin Wilming: Das ist keine Arbeit im Elfenbeinturm. Die Richtlinien sind für erstinstanzliche Verfahren das Maß der Dinge. Korrekte und umfassende Richtlinien schaffen Rechtssicherheit: Nutzer dürfen darauf vertrauen, dass die erstinstanzlichen Verfahren gemäß diesen Richtlinien ablaufen. Gegen die Richtlinien zu argumentieren, ist hingegen kaum je erfolgreich. Rechtsfortbildung, in Abweichung von den Richtlinien, ist Sache der Beschwerdekammern.

Bitte nennen Sie uns doch ein paar Beispiele für Punkte, in denen Sie als epi-Vertreter Einfluss nahmen oder nehmen.

Martin Wilming: Da fallen mir spontan zwei Punkte ein, die mir letztens am Herzen gelegen haben und in denen wir etwas bewegen konnten.

i) *In E-XII, 7.1 betreffend Abhilfe ist vor ein paar Jahren ohne grosses Aufsehen der Halbsatz gestrichen worden, dass Abhilfe auch möglich ist, wenn alle Einsprechenden die Einsprüche zurückgezogen haben. Das war auch tatsächlich mit einer Praxisänderung verbunden: Die ersten Instanzen haben in solchen Fällen nicht mehr abgeholfen. Mittlerweile hat eine Beschwerdekammer aber entschieden, dass das ein schwerwiegender Verfahrensfehler ist (T1558/18). Die Guidelines wurden nun wieder entsprechend geändert.*

ii) *In G-II, 4.2.1.1 geht es darum, was ein chirurgisches Verfahren ist. Abgesehen vom Wortlaut der G1/07 waren dort sehr lange nur Beispiele angeführt, die als chirurgisch anzusehen sind. Das war bei Grenzfällen in der Praxis nicht sehr hilfreich. Mittlerweile wurde ein Beispiel aufgenommen aus der Rechtsprechung der Beschwerdekammern (T2699/17), das als nicht chirurgisch qualifiziert. Die Grenze wird somit (hoffentlich) klarer.*

Martin Wilming ist Mitglied der epi-Delegation im Standing Advisory Committe before the EPO (SACEPO), und zwar in den Arbeitsgruppen Working Party on Rules (WP/R) und Working Party on Guidelines (WP/G). Er ist Partner der Kanzlei Hepp Wenger Ryffel in der Schweiz und betreibt einen Blog über Patentstreitfälle; www.patentlitigation.ch.

In seiner Freizeit widmet er sich der Photographie und ist begeisterter Velofahrer.

Case Law

T844/18 – the CRISPR case – confirms legal certainty in the EPO's consistent interpretation of priority under Art. 87(1) EPC

G. Schlich (GB), European Patent Attorney, UK Chartered Patent Attorney and Chartered Trade Mark Attorney

For a valid claim to priority[1] under the EPC, the later application has to be filed by the same applicant or the same applicants[2] (meaning all of the applicants, omitting none) who filed the earlier application. Thus, for a first filing by multiple applicants but a subsequent application by only one or some of those applicants it has to be shown that the priority right held jointly by the multiple earlier applicants had been transferred to the sole applicant or the group of applicants[3].

1 Herein, 'earlier application' or 'first filing' is the patent application from which priority is claimed and 'later application' or 'subsequent application' is the priority-claiming application
2 This phrase referring to the same applicant(s) or their successor(s) in title
3 T788/05, T382/07

Overview of decision

All those with an interest in the technology referred to generically as CRISPR[4] will be aware of a plethora of patents and patent applications covering all manner of its fundamental aspects and variations thereof and may also be aware of the many related opposition and appeal proceedings at the EPO concerning CRISPR patents.

In October 2020 the Nobel Prize in Chemistry was awarded to Emmanuelle Charpentier and Jennifer Doudna "for the development of a method for genome editing", noting

4 Various types exist though most patents focus on CRISPR/Cas9 and its genome editing applications

these two "discovered one of gene technology's sharpest tools: the CRISPR/Cas9 genetic scissors"[5].

In fact, while many CRISPR patents have already been variously upheld or revoked or maintained in amended form at opposition level, there have been (to my knowledge) no final decisions by EPO Technical Boards of Appeal (TBA) concerning ***technical*** elements of CRISPR technology. There has been, however, a final TBA decision concerning ***legal*** elements of the law of priority under the EPC arising from one CRISPR patent.

This decision, T844/18, addressed whether the EPO has the power to examine priority, how "celui qui" is to be interpreted and which law determines the identity of the person who "duly filed" the earlier application from which priority is claimed (see *The Three Questions* later in this article).

While the decision was announced orally at the end of the hearing on 16 January 2020 and published in the minutes less than a week later on 23 January 2020 it was not until nearly ten months later, on 6 November 2020, that the TBA formally (and finally) handed down its written decision and confirmed revocation of the Broad Institute Inc's CRISPR/Cas9 patent EP2771468[6].

Much analysis was circulated in the period immediately following the oral decision. Herein, the formal, written decision is reported more or less without analysis: the decision speaks for itself.

The case at both opposition and appeal levels centred on interpreting Paris Convention Article 4A(1) and EPC Article 87(1) EPC, which read respectively (French and English for the former, English only for the latter):

> "**Art. 4A (1)** Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un modèle d'utilité, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des pays de l'Union, ou son ayant cause, jouira, pour effectuer le dépôt dans les autres pays, d'un droit de priorité pendant les délais déterminés ci-après"
>
> – Paris Convention, Article 4A, Stockholm version, 1967, French text.

> "**Art. 4A (1)** Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed"
>
> – Paris Convention, Article 4A, Stockholm version, 1967, English text.

> "**Art. 87(1)** Any person who has duly filed, in or for
> (a) any State party to the Paris Convention for the Protection of Industrial Property or
> (b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application".
>
> – European Patent Convention, Article 87(1), 2000, English text.

The EP patent in suit[7] originated from a PCT filing, with the consequence that the Paris Convention prevails[8] with respect to the right to claim priority, but the decision found, in effect, this made no difference to the interpretation of Article 87(1) EPC, noting:

> *"… in order to interpret 'any person' in Article 87(1) EPC, it is necessary to interpret the legal concept of 'any person' in Article 4A Paris Convention, the interpretation given in both treaties needing to be the same"*[9].

The decision also centred on the EPO's 'all applicants' interpretation of Article 87(1) EPC, namely, to require there to be identity of applicant(s) – taking account of successor(s) in title – between the applicant for the earlier priority–establishing application and the applicant for the later, priority–claiming application[10].

In relation to the priority provision in EPC Article 87(1), the TBA stated:

> *"the instances of the EPO have without exception adopted a consistent interpretation of Article 87(1) EPC since the inception of the European patent system"*[11],

and in relation to the EPO's 'all applicants' approach:

> *"[t]he continuation of such long standing and rationally based practices can be considered as an aspect of legal certainty"*[12].

5 https://www.nobelprize.org/uploads/2020/10/press-chemistryprize2020.pdf and https://www.nobelprize.org/uploads/2020/10/advanced-chemistryprize2020.pdf

6 In the name of The Broad Institute, Inc., Massachusetts Institute of Technology and President and Fellows of Harvard College

7 EP2771468

8 PCT Art. 8(2)(a)

9 T844/18 (hereinafter "Decision"), para. 36

10 See e.g. Case Law of the Boards of Appeal, Ch. II, D, 4.2 "Identity of applicant"

11 Decision, para. 121

12 Decision, para. 86

The patent was revoked in opposition for lack of novelty, with the priority claim invalid. The Patentees appealed and the appeal was dismissed, the Board confirming the earlier decision of the Opposition Division and agreeing with the EPO's long-standing practice in interpreting Paris Convention Art. 4A(1) and EPC Article 87(1):

> ***For a valid claim to priority under the EPC, the later application has to be filed by the same applicant or the same applicants[13] (meaning all of the applicants, omitting none) who filed the earlier application. Thus, for a first filing by multiple applicants but a subsequent application by only one or some of those applicants it has to be shown that the priority right held jointly by the multiple earlier applicants had been transferred to the sole applicant or the group of applicants[14].***

In more detail

Missing Applicant

Of course, many prosecutions, oppositions and appeals turn on whether a priority right is validly claimed. Examination of priority under the EPC allows the priority date to be substituted for the filing date for determining the prior art[15] and includes determining whether the later application is directed to the 'same invention'[16] and has been filed by the 'same applicant'[17].

In this case, the applicants for the patent in suit were not the same as those for the priority application[18]. Rather, one applicant was missing from the patent application and had not transferred its priority right to the remaining applicants[19]. This omission was, however, a *"deliberate choice"*[20] of the Patentees.

13 This phrase referring to the same applicant(s) or their successor(s) in title
14 T788/05, T382/07
15 EPC Art. 89
16 EPC Art. 87(1)(a) "… in respect of the same invention, a right of priority …"
17 EPC Art. 87 (1)(a) "Any person who has duly filed … an application for a patent … shall enjoy … a right of priority"
18 This is a simplification. For more details see Decision, para. II
19 See e.g. EPO explanation at https://www.epo.org/law-practice/case-law-appeals/communications/2020/20201106.html
20 Decision, para. 60

The Three Questions

The Patentees argued the priority right was nevertheless valid, dividing its submissions into three prongs[21], characterised by the TBA in its decision as the questions:

1. Should entitlement to priority be assessed by the EPO?
2. How is the expression "any person" in Article 87(1) EPC to be interpreted?
3. Does national law (in this case US law) govern the determination of "any person" who has "duly filed" in Article 87(1) EPC?

In the discussion below I have separated out the three answers, though in the proceedings many lines of argument were interwoven as they applied to more than one question.

Importance of Formal Requirements

The Patentees' submissions covered how the test under Article 87(1) EPC included formal aspects. The Decision divided the test into four requirements, namely 'who', 'where', 'what' and 'when'[22].

Noting that the position of the Patentees was that the EPO should not concern itself with the "who" issue, the Board disagreed, stating that the EPC clearly sets out a requirement that the EPO examines the "who" issue of priority entitlement[23] to determine who is the "any person" of Article 87(1) EPC.

As to the extent to which "who" is examined, the decision noted that the EPO does not go beyond a formal assessment of the person who has performed the act of filing the patent application[24]. The Board noted that the EPC sets out many formal requirements and the failure to comply with a formal requirement of the EPC can destroy a patent or patent application, irrespective of whether it satisfies the substantive requirements for patentability[25].

21 Decision, Section X
22 Decision, para. 12
23 Decision, para. 14
24 Decision, para. 15
25 Decision, para. 16

George Schlich is a European Patent Attorney and a UK Chartered Patent Attorney and Chartered Trade Mark Attorney, with a degree in Natural Sciences from Cambridge University, UK, specialising in biology of cells, chemistry, pathology, physiology, mathematics, pharmacology, and history and philosophy of science. George is principal of Schlich Ltd, located in Littlehampton on the south coast of England and on the board of the Irish start-up NK cell company ONK Therapeutics Limited. In the opposition and appeal proceedings culminating in T844/18 George represented Opponent no.1.

The Board was unsympathetic with the argument that formal matters can lead to loss of rights, stating the Patentees:

> *"…chose the named applicants in a way that did not comply with the well-established practice of the EPO"*[26]

and

> *"It is not for the Board to repair such errors, omissions or deliberate choices of a party"*[27].

Concerning the object and purpose of the Paris Convention, the Patentees argued it would be contrary to the convention if a formal requirement could destroy patent rights. The Board disagreed, holding that:

> *"the difficulty that the Board has with such an argument is that any formal requirement for patenting […] could be considered contrary to the above object and purpose"*[28].

—— The answer to the first question was thus, essentially, "yes".

"Celui qui"

The authentic text of the Paris Convention is French, more or less unchanged since 1883[29] and only translated into English in 1958[30]; hence, much focus came to bear on the words "celui qui" from its Article 4A, the same words being found unchanged today in the French text of Article 87(1) EPC. While these French words were said not on their own to be determinative, the Board was nevertheless able to say:

> *"the Board is of the view that the authentic French text of the Paris Convention tends, if anything, to support the 'all applicants' approach"*[31]

and more positively that:

> *"the 'all applicants' approach is certainly a plausible interpretation of this term"*[32].

Decades of EPO Practice vs. A Request for a Change

Ultimately, the Patentees' submissions and the case law led the Board to identify parallels. The Board was faced with, in its own words, *"many decades of EPO and national practice supporting the 'all applicants' approach"* and noted *"no evidence on file that any states that are current member states of the EPC have ever adopted anything but the 'all applicants' approach"*[33].

The parallel from the Patentees' side was, the Decision noted:

> *"the appellants do not contest that the practice of the EPO is, and has been, to require identity between the Applicants for the priority application and the Applicants for the subsequent application"*

and

> *"the appellants argue for a change of practice"*[34].

But the Board found in response that:

> *"the current practice can be considered to have a rational foundation that derives from a conventional approach to interpreting legal texts"*

and

> *"as the priority provisions of the Paris Convention have remained essentially unchanged since 1883, the Appellants are faced with over 100 years of consistent case law and practice adopting the 'all applicants' approach that they need to show as incorrect. This is a considerable burden"*[35].

Public Policy Issues: sinister acts and double patenting

Various public policy points were made by the Patentees, and the Board dealt with these one-by-one. One characterization of the fact pattern was:

> *"A and B are applicants for the priority application. A alone is the applicant for the subsequent application. Is a priority claim valid even without any assignment of priority right from B to A?"*[36]

To the argument that "one of the applicants is holding the other[s] to ransom by refusing to join in as an applicant for the subsequent application"[37] the Board replied:

> *"[allowing A to file alone without involving B] … could of course result from an agreement between A and B, it could however equally result from more sinister circumstances, such as A trying to deprive B of its rights to a patent in another country. This second scenario can hardly be thought of as one that the law should seek to protect"*[38].

T15/01 has held that there is no doctrine of the exhaustion of the priority right, and the Board agreed, saying:

> *"the priority mechanism was not meant to, and in certain circumstances is unable, to prevent multiple applications",*

but found:

> "the possibility of a multiplication of proceedings and double patenting identified by the opposition division to be plausible and to be avoided"[39].

26 Decision, para. 16
27 Decision, para. 16
28 Decision, para. 48
29 Decision, para. 53
30 Decision, para. 41
31 Decision, para. 42
32 Decision, para. 83
33 Decision, para. 85
34 Decision, para. 27
35 Decision, para. 53
36 Decision, para. IX
37 Decision, para. 32
38 Decision, para. 49
39 Decision, para.s 81 and 84

In their conclusions to this section of the decision the Board noted:

- "the 'all applicants' approach has been applied […] without exception since at least the early twentieth century, by states that are currently member states of the EPC, and by the EPO since its inception"
- "such a practice can be seen to have a rational basis"
- "[this practice] is based on a reasonable interpretation of the legal texts"
- "The bar to overturning long established case law and practice should be very high because of the disruptive effects a change may have"
- "The continuation of such long standing and rationally based practices can be considered as an aspect of legal certainty"[40].

—— The answer to the second question upheld the existing law and practice.

The Paris Convention vs. National (in this case, US) Law

The third question addressed the extent to which national law could be used to determine the answer to the question of 'who' filed the first priority-establishing patent application.

The Board accepted national law determines what is a duly filed application and whether a filing is one that establishes a filing date[41].

The Board concluded, however, with respect to who duly filed the application that:

> *"the Paris Convention is part of the 'supreme law' of the land in the US"*[42]

and, noting that the Paris Convention makes no reference to the inventor or the applicant but refers instead to the person who has carried out an act, of filing a patent application[43], that:

> *"It is thus clear that the Paris Convention, being an integral part of US law, determines who "any person" is, and this determination is a purely formal one"*[44] *{emphasis added}.*

This position was also found to be the intention of the drafters of the Paris Convention[45].

We are then left with what can only be a warning:

> *"it is clear that applicants wishing to use US provisional applications should be aware of the difficulties they may face if they use these applications to claim priority for a European patent application. This is simply a consequence of the US's adhesion to the Paris Convention. The Notice from the President of the EPO*[46] *cannot exempt the EPO from applying the Paris Convention and there is no evidence that this was its intention"*[47].

—— The answer to the third question found no role for national law but a formal role for the Paris Convention.

The Three Answers

The TBA's decision, already reported previously on the basis of the minutes of the proceedings, published on 23 January 2020, was then enunciated as follows[48] (using the same numbering as the questions posed) in the three answers:

1. **The Board is empowered to and must assess the validity of a priority right claim as required by Article 87(1) EPC.**
2. **The Board's interpretation of the expression "any person" in Article 87(1) EPC confirms the long-established "all applicants" or the "same applicants" approach.**
3. **The National law does not govern who is "any person" as per Article 87(1) EPC, the Paris Convention determines who "any person" is.**

EBA Referral?

Two possibilities for a referral exist under the EPC: (i) ensuring uniform application of the law, and (ii) if a fundamental point of law arises[49], and the Patentees raised both as grounds for a referral.

The Board held:

> *"The uniform application of the law point does not apply in this case as the instances of the EPO have without exception adopted a consistent interpretation of Article 87(1) since the inception of the European patent system*[50]*"*

and

> *"The Board has a discretion whether to refer questions, even if a point of law of fundamental importance is concerned […] In this case the Board has been able to answer the questions raised beyond doubt, hence no referral is necessary"*[51].

The appeal and the request for a referral were thus both dismissed, the Board confirming the earlier decision of the Opposition Division and agreeing with the EPO's long-standing practice in interpreting the Paris Convention Article 4A(1) and the EPC Article 87(1) and confirming that the EPO's interpretation of priority under Art. 87(1) EPC provides consistency and legal certainty.

40 Decision, para.s 86 and 53
41 Decision, para. 106
42 Decision, para. 104
43 Decision, para. 108
44 Decision, para. 110
45 Decision, para. 109
46 OJ EPO, 1996, 81
47 Decision, para. 114
48 Decision, Headnote
49 EPC Article 112
50 Decision, para. 121
51 Decision, para. 122

G 1/19 released: The Enlarged Board of Appeal decides on the Patenting of Computer-implemented Simulations and Designs

Dr. D. Herrmann (DE), F. Hermann (DE), BOEHMERT & BOEHMERT,
European Patent and Trademark Attorneys, Patentanwälte

The Enlarged Board of Appeal of the EPO has just now released its decision G 1/19 and concludes that computer-implemented numerical simulations and designs of a system or process should not be treated any different from any other computer-implemented invention. In particular, the Enlarged Board clearly rejects the Board's view in the referral decision T 0489/14 that a technical effect provided by a simulation requires, at a minimum, a direct link with physical reality. However, G 1/19 also makes it clear that the widely discussed decision T 1227/05 should not serve as a lighthouse decision providing general guidance for all cases of computer-implemented simulations and design processes. G 1/19 states that it is not decisive whether the simulated or designed system or process is technical or not. Rather, it is relevant whether the simulation or design process as part of the claimed invention contributes to the solution of a technical problem. This question must be answered using the same criteria as for any other computer-implemented invention. G 1/19 further concretizes the criteria to be applied when assessing inventive step for computer-implemented inventions and provides useful examples for technical aspects of computer-implemented simulations and design processes.

I. Background of G 1/19

According to EPO standards, a mathematical method, to which software for simulations and design processes are assigned, may contribute to the technical character of an invention, i.e. contribute to producing a technical effect, by its technical application/purpose and/or by being adapted to a specific technical implementation (EPO GL 2020, G-II, 3.3).
In 2006, Board 3.5.01 of the EPO Boards of Appeal issued a decision, T 1227/05, which acknowledged technical character of all features claimed in context of a specific simulation of an electronic circuit subject to 1/f noise. According to T 1227/05, a claimed invention being functionally limited to a computer-implemented simulation of the performance of an electronic circuit subject to 1/f noise qualifies as such technical purpose conferring technical character to the simulation. Also, T 1227/05 found that such computer-implemented simulation methods could not be denied a technical effect merely on the ground that they precede actual production or do not comprise a step of manufacturing the physical end product.
In 2018, the EPO significantly revised the sections of the Guidelines for Examination (EPO GL, G-II, 3.3; G-VII, 5.4.2.4) dealing with the patenting of mathematical methods in accordance with T 1227/05.
In 2019, Board 3.5.07 of the EPO Boards of Appeal in T 0489/14 disagreed with the findings and the criteria set out in T 1227/05 and demanded strict minimum requirements to acknowledge technical character.
In the case underlying T 0489/14, the claims of the main request were directed to a computer-implemented method of modelling pedestrian movement in an environment. The claimed invention focused on operations of simulating movement of pedestrians through the environment. On the one hand, the Board tended to consider the features relating to the simulation as mental acts, and thus as non-technical features. (see Reasons 5 to 8, 12 and 17). In particular, the Board argued that a technical effect would require a direct link of the simulation to physical reality, such as a change in or a measurement of a physical entity (Reasons 11 and 23). On the other hand, the Board also acknowledged the findings of T 1227/05 and concluded that the features relating to the simulation would be technical features contributing to the solution of a technical problem when following the reasons of T 1227/05 (see Reasons 13 to 15 of T 0489/14). Overall, the Board concluded that both, the question of patentability of simulation methods would be a point of law of fundamental importance and the Board's intended deviation from the findings in T 1227/05 and referred the following questions to the Enlarged Board in G 1/19:

1. In the assessment of inventive step, can the computer-implemented simulation of a technical system or process solve a technical problem by producing a technical effect which goes beyond the simulation's implementation on a computer, if the computer-implemented simulation is claimed as such?
2. If the answer to the first question is yes, what are the relevant criteria for assessing whether a computer-implemented simulation claimed as such solves a technical problem? In particular, is it a sufficient condition that the simulation is based, at least in part, on technical principles underlying the simulated system or process?
3. What are the answers to the first and second questions if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design?

One of the authors has published an article with more details about the above and other T decisions, the 2018 revisions of the Guidelines for Examination regarding the patenting of mathematical methods as well as this referral on pages 19-25 in issue 2/2019 of this journal.

II. The Decision G 1/19

II.1 Admissibility of the Referred Questions

The referred questions have been interpreted by the Enlarged Board as follows:

Question 1: In the assessment of inventive step, can the computer-implemented simulation of a technical system or process solve a technical problem by producing a further technical effect that goes beyond the normal physical interaction between a program and a computer on which the simulation is run, if the computer-implemented simulation is claimed as such (G 1/19, see, e.g., Reasons 47 and 50)?
Question 2: If the answer to the first question is yes, what are the relevant criteria for assessing whether a computer-implemented simulation process comprising only numerical input and output (irrespective of whether such numerical input/output is based on physical parameters), i.e. without interaction with external physical reality, solves a technical problem ("Question 2A" of G 1/19)? In particular, is it a sufficient condition that the simulation is based, at least in part, on the scientific (e.g. mathematical and physical) principles applied within the boundaries set by the (natural or technical) system or process ("Question 2B" of G 1/19, see, e.g., Reasons 47 and 53)?
Question 3 has been interpreted along the same lines as questions 1 and 2. Out of the three referred questions, the Enlarged Board accepted questions 1 and 3, and question 2B only. The question 2A has not been admitted, since the Enlarged Board considers it impossible to give an exhaustive list of (positive or negative, alternative or cumulative) criteria, and this question must not be answered for the referring Board to be able to come to a conclusion in T 0489/14.

II.2 Technical Character of Computer-Implemented Simulations and Design Processes

II.2.1 The Decisions T 1227/05 vs. T 0489/14

On the one hand, the Enlarged Board indicates with regard to T 1227/05 that limiting a claim directed to a simulation software to the purpose of stimulating a real technical device or process is normally not sufficient to acknowledge a technical character of all features claimed in context of the simulation. G 1/19 gives multiple reasons in this regard.
Firstly, the invention claimed is not the technical device or the process to be simulated, but rather the simulation of the system or process itself. Accordingly, it is the claimed simulation of the system or process that must meet the requirements of the EPC and must therefore be novel and inventive over the prior art (G 1/19, Reasons point 125).

Secondly, referring to G 3/08, the Enlarged Board acknowledges that a simulation is necessarily based on the principles underlying the simulated system or process and that technical considerations associated with the system or process to be simulated typically form the basis of the mental act of establishing the model of the technical device or process being used in the simulation. The Enlarged Board holds that such mental act of establishing the model (and equations/algorithms) underlying the simulation is devoid of technical character. Thus, the model underlying a simulation forms constraints (technical or not) which are not technical for the purpose of the simulation itself. This is because the technical considerations being used when establishing the model underlying the simulation do normally not translate into a technical effect being rendered by the execution of the simulation (G 1/19, see, e.g., Reasons 106-112, 121, 137, 141).

Therefore, the technical considerations relevant for the assessment of inventive step are only those technical considerations that pertain to the invention, i.e. to the simulation of the device or process, rather than the simulated system or process (G 1/19, Reasons point 125).

Thirdly, simulating a property/ behavior of a technical system or process produces data, which may or may not be used for achieving a technical effect in the real world, e.g. the control or development of the technical device or process (G 1/19, Reasons 98, 129). This is problematic in the light of the well-accepted principles of T 939/92 that essentially all embodiments falling within the scope of independent claim must credibly provide the technical effect and solve the technical problem argued as part of the problem-solution-approach (G 1/19, Reasons 82, 98). In other words, if only some but not all of the embodiments of the claimed subject matter credibly provide the argued technical effect to be relied on the independent claim must be limited to the embodiments providing basis for this technical effect (G 1/19, Reasons point 82). Unless the data generated by the simulation exceptionally imply their technical use which can be the basis for an implied technical effect, the data generated by the simulation can typically not be attributed a potential technical effect associated with an intended but not claimed technical use. Therefore, in general, a claim not involving a technical link to the real world (e.g. by the control of the technical system or process being simulated) normally encompasses embodiments

Dr. Daniel Herrmann

Felix Hermann

where the data produced by the simulation can be used also for non-technical purposes, such as for scientific insights (G 1/19, Reasons 98, 129).

In discussing T 1227/05, the Enlarged Board takes the view that calculated (numerical) data reflecting the physical behavior of a system modelled in a computer usually cannot establish the technical character of the invention in accordance with the COMVIK approach (T 641/00, hn.), even if the calculated behavior adequately reflects the behavior of a real system underlying the simulation. Only in exceptional cases may such calculated effects be considered implied technical effects, for example, if the potential use of such data of the simulation is limited to technical purposes (G 1/19, Reasons point 128). However, the Enlarged Board does not consider its role to re-assess T 1227/05 and agrees with the findings of T 1227/05 if they are understood as being that the claimed simulation process of this particular case possessed an intrinsically technical function. Moreover, the Enlarged Board emphasizes that the often-quoted criterion of T 1227/05 that the simulation constitutes an adequately defined technical purpose for numerical simulation method if it is functionally limited to that purpose should not be taken as a general applicable criterion in applying the COMVIK approach to computer-implemented simulations, since the findings of this decision were based on specific circumstances which do not apply in general (G 1/19, Reasons 128, 133) and thereby took the lighthouse character away from this decision. Accordingly, a revision of the EPO Guidelines for Examination seems probable.

On the other hand, the Enlarged Board clearly states that a direct link with (external) physical reality, as demanded by T 0489/14, is not a requirement or necessary condition to acknowledge a technical character of the features claimed in context of a simulation or design process, even though such a link would in most cases be sufficient to establish technicality of those features (G 1/19, Reasons 88, 139, 85).

Firstly, this is because a technical effect can also occur within the computer-implemented process itself. A simulation without an input or output having a direct link with physical reality can still solve a technical problem, for example by adaptation of the simulation software to the internal functioning of the computer system or network (e.g. to achieve better use of storage capacity or bandwidth, G 1/19, Reasons 85, 115-116).

Secondly, potential technical effects, i.e. effects achieved only in combination with non-claimed features, can be considered in course of assessing the technical character of the claimed features. Those potential technical effects are to be distinguished from virtual or calculated effects, i.e. technical effects which are not achieved through an interaction with physical reality, but are calculated in such a way as to correspond closely to "real" technical effects or physical entities, and direct technical effects on physical reality. Such potential technical effects may, for example, be attributed to data or data structures which are especially adapted for the purposes of its intended technical use. In such cases, either the technical effect that would result from the intended use of the data could be considered implied by the claim, or the intended use of the data could be considered to extend across substantially the whole scope of the claimed data processing method (G 1/19, Reasons 89-97).

To the relief of many applicants, G 1/19 did therefore not accept the strict requirements for the acknowledgment of technical character of features claimed in the context of a computer-implemented simulation as demanded by T 0489/14.

II.2.2 Implications for the Referred Questions

The "de-facto standard" at the EPO for the assessment of inventions having a mix of technical and "non-technical" features as defined in the headnotes of T 641/00 (COMVIK approach) is also considered by the Enlarged Board to be suitable for the assessment of computer-implemented simulations. According to the COMVIK approach, the decisive question for the assessment of which features of a simulation of a system or process are technical features, and thus relevant for the assessment of inventive step, is whether the simulation or design process contributes to the solution of a technical problem by producing a technical effect.

In line with this understanding of computer-implemented simulations being not different from other computer-implemented inventions, and in view of the above outlined discussion of T 0489/14, it appears consequent that the Enlarged Board answers questions 1 and 3 in the affirmative, noting that the Enlarged Board does not recognize there being any relevant differences between a computer-implemented simulation or a computer-implemented design process, in particular a process for verifying a design. Similarly, it appears also consequent in consideration of the COMVIK approach and the above outlined discussion of T 1227/05 that question 2B is answered by the Enlarged Board in the negative noting that it is neither a sufficient nor a necessary condition that a numerical simulation is based, at least in part, on technical principles that underlie the simulated system or process. The same applies to a design process (G 1/19, Reasons 138-144).

In applying the COMVIK approach, the Enlarged Board finds that only those features of the claimed simulation contributing to a technical effect achieved by the simulation may be considered technical and relevant for the inventive step assessment. Therefore, the question arises which criteria the Enlarged Board considers generally applicable to the assessment of the technical contribution made by a computer-implemented (numerical) simulation or design processes. The following summarizes the guidance provided by the Enlarged Board in G 1/19. The Enlarged Board indicates that features of the simulation or design process may contribute to the technical character of the invention, if, for example, they provide basis for:

- technical input, such as a measurement from a sensor (G 1/19 Reasons point 85),
- technical output, such as a control signal used to control a machine (G 1/19, Reasons point 85),
- output of "functional data" intended for controlling a technical device, when being specifically adapted for purposes of its intended technical use (G 1/19, Reasons points 92-94),
- adaptations of the design or simulation (software) to the computer or its operation which result in technical effects, such as better use of storage capacity or bandwidth (G 1/19, Reasons points 85, 115-116), or
- adapting the computer or its functioning to the simulation (G 1/19, Reasons points 110, 137).

In summary, technical effects can occur within the computer-implemented simulation or design process and at the input and the output of this simulation or design process, wherein the Enlarged Board emphasizes, that this would not be an exhaustive list.

To the disadvantage of many applicants, the Enlarged Board states that whether a simulation contributes to the technical character of the claimed subject-matter does not depend on the quality of the underlying model or the degree to which the simulation represents "reality". Another remarkable consideration of the Enlarged Board in connection with the accuracy of a simulation is the finding that the accuracy of a simulation is a factor that may nevertheless have an influence on a technical effect going beyond the simulation's implementation on the computer and may therefore be taken into consideration in the assessment of inventive step under Article 56 EPC. For the purposes of Article 56 EPC, it can be that an alleged improvement is not achieved if the simulation is not accurate enough for its intended (technical) purpose, and the claimed simulation process may be considered non-inventive as a consequence even if the simulation contributes to the technical character of the invention. Even more, if an improvement or a specific function is reflected in the claim and cannot be achieved by means of a simulation that does not reflect "reality" accurately enough, objections to lack of enablement under Article 83 EPC may arise if the skilled person is unable to find the necessary models and equations without undue burden (G 1/19, Reason point 111).

II.3 Answers to the Questions referred to the Enlarged Board of Appeal

In summary, the Enlarged Board decided that the questions of law referred are answered as follows:

1. A computer-implemented simulation of a technical system or process that is claimed as such can, for the purpose of assessing inventive step, serve a technical problem by producing a technical effect going beyond the simulation's implementation on a computer.

2. For that assessment it is not a sufficient condition that the simulation is based, in whole or in part, on technical principles underlying the simulated system or process.

3, The answers to the first and second questions are no different if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design.

Conclusions

The Enlarged Board's statement that computer-implemented simulations and design processes are not different from any other computer-implemented processes, and the reliance and strict application of the principles of the COMVIK approach, once again confirm and manifest the EPO's established case law on computer-implemented inventions. While the good news for applicants is that the Enlarged Board did not follow the strict proposal by T 0489/14, the Enlarged Board confirmed the overall strict praxis of the assessment of computer-implemented inventions under the case law of the EPO Boards of Appeal also for computer implemented simulations and design processes.

As simulation and design processes are often developed to run on conventional computer hardware, it will become even more difficult for applicants to claim and protect the simulation or design process independent of a particular and specific technical input or output or (implied) use of the results of the simulation or design process, e.g. for controlling a machine or manufacturing a product. This also imposes that applications in this field have to be carefully drafted in consideration of whether the technical character of the invention is arguably based on a technical effect achieved by the simulation or design software when running on the computer. Furthermore, the accuracy of the simulation or design process may also impact the credibility of the simulation or design process achieving the argued technical effect, which requires applicants to carefully consider the level of detail of the simulation and design method that needs to be disclosed in the application and also the number of alternatives that must be disclosed to support the invention over a broader scope than a single specific example implementation.

Educational events

Life of a patent distance learning course 2021

Have you ever thought about all the things to consider before drafting and filing a patent application up to the last step of the grant process? Join our distance learning course on Life of a patent. This distance learning course is intended for beginners in the profession but also for patent practitioners/patent engineers in industry that would like to refresh their EPC knowledge and skills. Participants find out about the main steps of pre-drafting and drafting a European patent application, together with the formal and substantive aspects of prosecution.

The course was jointly developed by the European Patent Academy with the support of **epi** Experts. The scheduled virtual classroom sessions allow a direct interaction with **epi** experts. Introductory videos and guide you through the different topics which are discussed at conceptual level and illustrated with practical examples. The course includes tests (quizzes) and assignments. After successful completion of the quizzes, you have the possibility to obtain a certificate for this course.

The official course start is 19 April 2021 and end 22 June 2021.

All members will be informed by email as soon as the registration is available.

EQE Training Courses in Maastricht

N. Blokhuis (NL), N. Duhayon (BE), I. Surdej (BE) and J. Declerck (BE)

Since 2014, Maastricht University has been preparing candidates for the European Qualifying Examination (EQE). This training is for candidates who already have a basic understanding of European patent law. One of the cornerstones of our courses is the interactivity: two tutors and group sizes limited to 16 participants stimulate the exchange of ideas and learning from each other.

The Pre-Exam methodology encompasses a 2-day workshop focusing on Claim Analysis, followed by a 1-day workshop for the Legal Questions of the Pre-Exam. The training for each of the main exam papers starts with a 3-day workshop (A and B are combined). For each of the courses, we have developed new methodologies to solve the current papers using a pragmatic and efficient approach. After providing some background and theory, the most important aspects of the methodologies are illustrated by solving cases. Materials are provided electronically during the course to reduce the books needed and to facilitate electronic note-taking.

If possible, the workshops will take place live in Maastricht. However, if necessary or preferable, the workshops may take place via Zoom.

Following each of the training courses, access is provided to Maastricht University's electronic learning environment for online support from fellow students and the tutors all the way up to the EQE. The presentations, cases and model solutions are also available for subsequent study. Assignments are set to improve the skills of the participants and to boost their confidence. Discussion of experiences and possible answers are encouraged.
Of course, the tutors closely follow all developments in the EQE. The methodologies are continuously adapted to accommodate for such developments, including the e-EQE and the new exam format in which some of the papers are split up into multiple parts. But also more subtle changes in the structure of the exams and/or the desired answering structure are taken into account.

Training for the Pre-Exam

Pre-Exam – Claim Analysis
The teaching encompasses how to apply the theoretical concepts such as scope of protection, novelty, inventive step, clarity and allowability of amendments in a practical way to the type of questions asked in the Pre-Exam.

Workshop duration: 2 days: Monday 8 and Tuesday 9 November 2021. Online learning trajectory: from November 2021 to March 2022: about 7 assignments will be set out.

Pre-Exam – Legal Questions
The legal questions of the Pre-exam require you to quickly and correctly apply your legal knowledge to a legal situation presented in each of the 10 questions. The one-day course will teach you a practical methodology for answering multiple-choice legal questions.

Workshop duration: 1 day: Wednesday 10 November 2021. Online learning trajectory: from November 2021 to March 2022: about 6 assignments will be set out.

For detailed information of and registration for the Pre-Exam courses, see:
www.maastrichtuniversity.nl/education/course/eqe-pre-exam-training

Training for EQE Papers A and B

In Paper A, a set of claims and the introductory portion of a European patent application have to be drafted. In Paper B, a response to a communication from the examining division has to be drafted, while taking account of the cited prior art and the instructions from the client. The training covers the skills needed to tackle both electricity-mechanic and chemical aspects of the current combined-technology papers. The methodologies borrow from real-life skills and approaches to drafting applications and answering office actions to provide an intuitive approach. We apply them step-by-step as a group to A and B papers and cases covering combined-technologies, focussing on the parts of the answer where most of the marks can be gained.

Workshop duration: 3-days: Monday 22 - Wednesday 24 November 2021. Online learning trajectory: from November 2021 to March 2022: about 8 assignments (1 A and 1 B case, 2 full A/B papers with combined-technologies, 1 full A and 1 full B chemistry paper, 1 full A and 1 full B electricity-mechanics paper); one of the assignments will be marked by one of the tutors.

Training for EQE Paper C

In Paper C, a notice of opposition has to be drafted following the grant of a European patent. In the course, a newly developed, simple and efficient methodology for tackling Paper C will be taught, which has been successfully applied by many of our previous candidates. The methodology will be put into practice with various example cases.

Maastricht University Leading in Learning!

Workshop duration: 3-days: Monday 25 - Wednesday 27 October 2021. Online learning trajectory: from October 2021 to March 2022: about 8 assignments (6 C cases and 2 full C Papers); one of the cases will be marked by one of the tutors.

Training for EQE Paper D

In Part I of Paper D, a set of legal questions have to be answered. In Part II, a legal opinion must be drafted following an inquiry from a client. An intuitive methodology will be taught for answering Part I questions and for analysing and preparing a response to the inquiry in Part II. The methodology will be put into practice with example questions and cases.

Workshop duration: 3 days: Monday 11 - Wednesday 13 October 2021. Online learning trajectory: from October 2021 to March 2021: 2022 assignments (6 with a set of Part I questions, 1 Part II case and one full Part II paper); one of the assignments will be marked by the tutor.

For detailed information of and registration for the Main Exam training courses, see:
www.maastrichtuniversity.nl/education/course/eqe-exam-training

CEIPI preparation courses for the European Qualifying Examination 2022

A complete range of high-quality courses using proprietary high-quality training material

CENTER FOR INTERNATIONAL INTELLECTUAL PROPERTY STUDIES

Preparation for the EQE pre-examination 2022

Preparatory seminar for the EQE pre-examination from 8 to 12 November 2021 in Strasbourg or online
Fee: 1.700 €. Closing date for receipt of applications: 15 October 2021.*

Intensive course "Mock examination" for the pre-examination on 27 and 28 January 2022 online
Candidates take two complete CEIPI mock exams under examination conditions and discuss their papers with the tutors
Fee: 750 €. Closing date: 10 December 2021.*

Preparation for the EQE main examination 2022

Introductory "Methodology" courses on papers A+B, C and D in Paris or online
Papers A+B: 17 September 2021
Paper C: 18 September 2021
Paper D: 15 – 16 September 2021
Each part (A+B, C, D) can be attended separately. Fee: papers A+B or C: 600 €, paper D: 900 €.*
Closing date: 13 August 2021.

Preparatory seminars for papers A+B, C and D in Strasbourg or online
Papers A+B and C: 25 to 29 October 2021
Paper D: 10 to 14 January 2022 in Strasbourg or 17 – 21 January 2022 online
Fee: 1.700 € for each five-day seminar (ABC or D), 875 € for the A+B or C part, respectively.*
Closing date: 17 September 2021.

Intensive courses "Mock examination" for papers A+B, C and D online
Candidates take mock exams under examination conditions and discuss their paper with the tutors
Papers A+B: 24 & 25 (pm) January 2022
Paper C: 25 & 26 (am) January 2022
Paper D: 27 & 28 January 2022
Courses A+B, C or D can be attended separately. Fee per course: 750 €. Closing date: 10 December 2021.*

**The CEIPI offers reduced package prices for candidates enrolling simultaneously for the complete range of courses preparing for one or more papers of the EQE. Further information about the courses and enrolment is available in OJ EPO 3/2021 and on our website: www.ceipi.edu.*

Contact: Christiane Melz, CEIPI International Section, tel. +33 (0)368 85 83 13, email: christiane.melz@ceipi.edu

VESPA
Verband der freiberuflichen
Europäischen und Schweizer Patentanwälte

VIPS
Verband der Industriepatentanwälte
in der Schweiz

organisieren auch in diesem Jahr ein

PRÜFUNGSTRAINING FÜR DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 2022

- Der Kurs versteht sich als letzte Etappe vor der Eignungsprüfung und als Ergänzung zu den eigentlichen Ausbildungskursen.
- Die Lehrfunktion des Kurses beschränkt sich demgemäss auf das Durcharbeiten konkret gestellter Prüfungsaufgaben der Teile A bis D und die Instruktion der Prüfungstechnik und -strategie durch erfahrene Europäische Patentanwälte.
- Die Aufgaben können nach Wunsch auf deutsch, englisch oder französisch bearbeitet werden, Modul 2 wird auf deutsch durchgeführt.
- Die Bewertung erfolgt vertraulich anhand der bei der Eignungsprüfung angewandten Kriterien. Eine schriftliche Korrektur wird abgegeben, Fragen an die Tutoren sind möglich.
- Der Kurs ist aus drei zeitlich getrennten Modulen aufgebaut (Module 1 und 3, jeweils einschliesslich Modul 2, können auch einzeln belegt werden) und umfasst je die Teile A bis D der Europäischen Eignungsprüfung.
- Teilprüfungskandidaten können auch einzelne Teile (A, B, C oder D) belegen, wobei die Kursgebühr entsprechend reduziert wird.
- An den Modulen 2 und 3 können auch Resitter teilnehmen (auch an einzelnen Teilen), deren nicht bestandene Prüfungsarbeiten wir im Rahmen von Modul 3 schriftlich kommentieren.

Aufteilung des Kurses:

Modul 1 (ab Juni 2021)
Die Kandidaten erarbeiten zu Hause schriftlich Lösungen zu einer früheren Prüfungsaufgabe. Die eingegangenen Arbeiten werden schriftlich korrigiert, bewertet und den Kandidaten wieder zugestellt, die Kandidaten können nach Erhalt der Korrekturen den Tutoren Fragen stellen und an Modul 2 teilnehmen.
Anmeldeschluss Modul 1 (und 2): 01.06.2021

Modul 2 (September 2021)
Vorstellen von Prüfungstechnik und -strategien für die einzelnen Teile. Besprechung der Fragen zu der früheren Prüfungsaufgabe und, wo erwünscht, Fehleranalyse der Kandidatenarbeiten.

Modul 3 (Anfang November 2021)
Die Kandidaten können zur Vorbereitung an Modul 2 teilnehmen. Modul 3 umfasst die Durchführung einer simulierten, dreitägigen Prüfung - wenn möglich online-EQE - mit den Prüfungsaufgaben von 2021. Die an Modul 2 erarbeitete Strategie kann gezielt in Modul 3 geübt werden. Die Lösungen der Kandidaten werden korrigiert, bewertet und den Kandidaten zugestellt. Die Kandidaten können nach Erhalt der Bewertung zu ihren Aufgaben den Tutoren Fragen stellen.
Anmeldeschluss Modul 3 (und 2): 01.09.2021

- **Kursgebühr Modul 1 (inkl. Modul 2 für alle Teile A-D): CHF 600.-**
- **Kursgebühr Modul 3 (inkl. Modul 2 für alle Teile A-D): CHF 600.-**
- **Kursgebühr alle Module (1, 2 und 3 für alle Teile A-D): CHF 1050.-**
- **Beim Belegen einzelner Teile wird die Gebühr entsprechend reduziert**

Auskunft / Anmeldung:
Regula B. Müller, Müller Steuer & Rechtspraxis AG, Genferstrasse 33, CH-8002 Zürich
Tel.:+41(0)44 206 16 60; Fax:+41(0)44 206 16 61; E-Mail: regula.mueller@mueller-praxis.ch

Committee Reports

Report of the IP Commercialization Committee

F. Stöckle (DE), J. Lessard (GB), K. Vavekis (GR)

The ability to protect and develop intellectual property - IP Commercialization - is key for enterprises around the world to serve their respective societies and provide social and economic progress

Successful IP commercialization happens when IP, innovation, and entrepreneurship act in concert and its impact multiplies manyfold in driving the growth of a knowledge-based economy.

To better address this issue, the need was felt to establish an IP Commercialization Committee (IPCC) which was set up at the C89 Council meeting in November 2020.

The IPCC's goals are to consider and advise on all questions pertaining to, or connected with, IP commercialization including but not limited to matters such as IP valuation and monetarization, portfolio optimization, assignment of IP rights and licensing matters.

To this end, two working groups were formed, one of which focuses on licensing education and certification for European Patent Attorneys, and the other of which deals with facilitation of licensing.

Working Group Licensing Education and Certification

European Patent Attorneys (EPAs) undergo extensive training and examination to develop the necessary competencies for preparing, filing and prosecuting European patents. This highly specialized skillset provides them

with a unique insight into the strengths, weaknesses and potential uses of these intellectual property rights (IPRs).

However, patents only have value if they are exploited, typically by commercializing the products they protect or through licensing. Whilst training is available for the commercialization of patents and other IPRs, it is normally focused on particular aspects of commercialization and often not directed to EPAs.

The aim of this working group is to establish a certificate in commercialization. The main topics that will be covered by the certification include patent strategy, licensing, evaluation and valuation.

Members of the working group are currently investigating existing training programs, with a view to incorporating aspects of these programs into the curriculum for certification. The working group is also liaising with the Professional Education Committee (PEC) to incorporate the certification program into the institute's education framework.

The intention of this certification is not to provide the accredited individual with the competencies necessary to prepare licenses or conduct valuations. Rather, it is intended to demonstrate the knowledge required to contribute effectively, with the EPA's unique insight, in a professional team carrying out such activities.

Working Group Facilitation of Licensing

This working group was established aiming to identify the EU priorities concerning patent licenses and commercialization strategies. Its first task is the critical review of the EU action plan concerning Compulsory Licensing and Standard Essential Patents (SEP's).

The emphasis of the EU plan is on achieving high transparency, predictability and legal certainty for groups of patents forming a technical standard necessary for the development of specific fields of technology. The declaration, licensing, enforcement and litigation of SEP's are currently attracting great interest because of the technological developments in many fields, such as IoT and automotive connectivity. Since these are tasks involving patent attorneys, the subcommittee is actively involved in educating EPA's with the necessary knowledge and skills. The working group also intends to collaborate with the Litigation Committee on these tasks.

In addition, the members of the subcommittee are working on the position of the EU action plan to enforce a "rapid pooling of critical IP in times of crisis system" meaning a European Compulsory Licensing. Until now this was only handled by National Law of the member states and this might cause an opposition by the pharmaceutical sector.

Florian Stöckle

Finally, the working group will attempt to establish and promote EU funding initiatives for research and development competitive programmes on the IPR sector and will prepare European Patent Attorneys with the necessary skills.

Konstantinos Vavekis

Nächster Redaktionsschluss für **epi** Information	Next deadline for **epi** Information	Prochaine date limite pour **epi** Information
Bitte senden Sie Ihre Beiträge zur Veröffentlichung in der nächsten Ausgabe der **epi** Information an den Redaktionsausschuss. Alle Artikel oder Anfragen schicken Sie bitte an folgende Email Adresse editorialcommittee@patentepi.org bis spätestens **10. Mai 2021**. Weitere Informationen finden Sie in unseren „Guidelines for Authors" auf der **epi** Webseite: https://patentepi.org/r/guidelines-epi-info	The Editorial Committee invites contributions for publication in the next issue of **epi** Information. Documents for publication or any enquiry should be sent by eMail to (editorialcommittee @patentepi.org) no later than **10 May 2021**. Further information can be found in our "Guidelines for Authors" here: https://patentepi.org/r/guidelines-epi-info	La Commission de Rédaction vous invite à lui faire parvenir vos contributions pour publication dans le prochain numéro d'**epi** Information. Les documents pour publication ou toute demande d'information doivent être envoyés par courriel (editorialcommittee@patentepi.org) au plus tard le **10 mai 2021**. De plus amples informations sont disponibles dans nos « Directives pour les auteurs » à l'adresse : https:// patentepi.org/r/guidelines-epi-info

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

1 At the inaugural meeting on 7 December 2020 of the newly composed committee election of officers was completed: Chair: Ann De Clercq, Secretary: Simon Wright, liaison persons: for EPPC: Chris Mercer; for Presidium: Heike Vogelsang-Wenke.

2. Election/admission of previous and new associate members: New candidate associate members admitted: Marcus Wolfram, Alessandro Berti, Denise Nestle-Nguyen, Chris Mercer, Anette Hegner.

3. Re-election of previous associate members: Hans-Rainer Jaenichen, Heiko Sendrowski, Jan Desomer, Gautier Obrecht, Willemijn Maria Gommans, Thea van der Wijk, Philip Weinzinger, Adrian Tombling, Elisa Turri, Markus Grammel, Rafal Witek, Lynne Kamibayashi, Heike Vogelsang-Wenke, Andreas Oser.

Ann De Clercq

4. Meeting with DG1 on 12 February 2021. Discussions about the biotech changes in the GLs for examination for large part.

5. Plants: the feedback from the CPL52 meeting and opinion, Biotech Committee on disclaimers, propagation material, random mutagenesis, any other ongoing national or court debates were briefly discussed. We will keep on following up the situation and will comment on request in the future.

6. We took note of a point from BIA (Simon Wright explained) relating to a concern that transgenic animal industry could be adversely affected by G3/19.

7. WIPO Standard 26 for sequence listings was discussed and a new ad-hoc working group to share available documents was set up. We will share documents in a separate thread on the **epi** website Biotech Committee forum. There is a concern that we will have to use BISSAP in the future.

8. **epi** Biotech members or externals may lecture on biotech in webinars of **epi** (on request from Paolo Rambelli PEC to all Committee Chairs).

9. Next meeting date: a further committee meeting can be held digitally as soon as new discussion topics arise.

Survey on Oral Proceedings by Videoconference

J. Gray (GB), Chair of the Online Communications Committee

Introduction

In 2018, before the Covid-19 situation erupted, **epi** Council resolved that attendance at oral proceedings by videoconference (ViCo) should be a voluntary choice by the party and their representative. This was informed by a 2018 survey, predecessor to the present one. Thanks to the Covid-19 pandemic, however, the year 2020 saw rapid developments in the EPO's approach to conducting Oral Proceedings by ViCo. Examining Division (*ex parte*) proceedings moved entirely online, and Opposition Division (*inter partes*) proceedings went online for the first time.

During November-December 2020, **epi** surveyed its members to find out what they like/dislike about the current and evolving rules and proposals. Vice-President Heike Vogelsang-Wenke, EPPC Chair Chris Mercer and OCC Chair

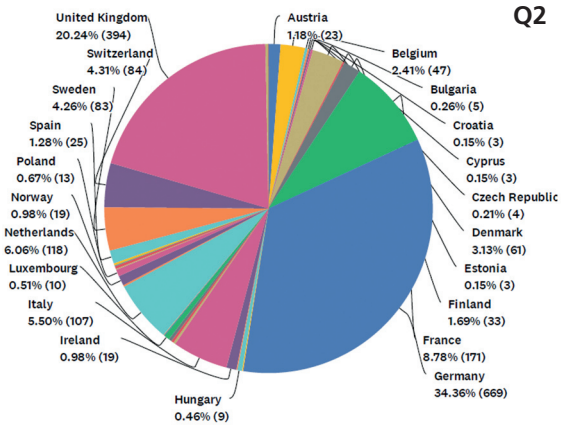
John Gray developed the survey with the assistance of other contributors and the Secretariat. Nearly 2000 people responded to some or all of the 25 questions, including thousands of written comments. After digesting these responses with the help of a team of volunteers, we present the key findings in this article.

The Questions

The survey included 25 questions, exploring the attitudes of EPAs to ViCo hearings generally, and to the sudden compulsion to attend hearings by ViCo, which was the EPO's response to the pandemic. A number of questions were addressed specifically to those who already had experience of oral proceedings by ViCo, for example to compare experience between the different platforms (Skype for Business or the new choice, Zoom) and types of hearing.

The Respondents

The 1947 respondents included 1327 (68%) European Patent Attorneys (EPAs) in private practice, and 590 (30%) in-house/industry. As the chart shows, responses from 22 countries were received overall. About one third were from Germany, then United Kingdom, France, Italy and Netherlands, all having more than 100 responses. The 30 non-EPA respondents were perhaps student members, as their responses corresponded broadly with the pattern of EPAs' responses.

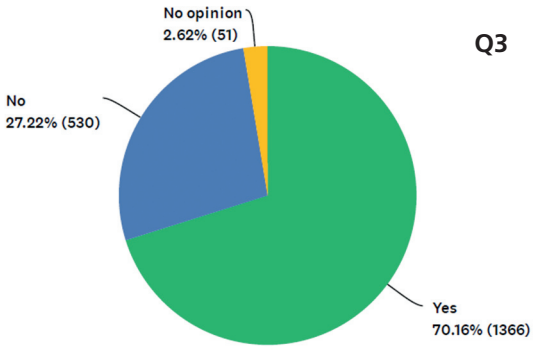


Q3-Q7: Policy Questions – the Right to a hearing vs the pandemic

In **Question 3**, respondents were asked if they agree with the November 2020 **epi** Council resolution (emphasis added):

> *"Council considers that, **after** the Covid-19 pandemic is over, **oral proceedings should** as a rule **be held face-to-face** but **any party should be free to attend oral proceedings by videoconference**, even if the other parties are attending in person."*

More than two thirds did agree with this resolution, as shown in the chart:



More than 600 written comments were provided. The vast majority think that face-to-face should be the default, some even want face-to-face to be mandatory at least in *inter partes* proceedings. With regard to "hybrid" proceedings (one or more parties face-to-face, one or more parties ViCo), most participants believe a party present in person will have an advantage over a party attending by ViCo. Many believe that either all parties should attend in person, or all parties attend via ViCo. A party choosing to attend hybrid proceedings by ViCo should not complain about any perceived disadvantage compared to face-to-face.

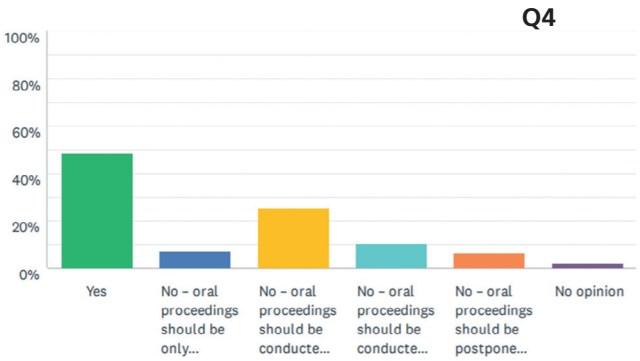
John Gray

Comparing the answers by country, EPAs from the United Kingdom had a significantly greater percentage of "No" answers (43% compared with the average 27%).

In **Question 4**, participants were asked whether they **agree with the measures taken by the EPO** to keep backlogs in opposition and appeal proceedings manageable **during the pandemic**. Specifically for all cases before an Examining Division or an Opposition Division, all oral proceedings until 15th September 2021 will be by videoconference only. Options for response were:

- Yes (i.e. agree)
- No – oral proceedings should be only conducted in person (with Covid safety measures)
- No – oral proceedings should be conducted in person (with Covid safety measures) unless a party requests to attend by videoconference
- No – oral proceedings should be conducted in person if a party provides reasons why
- No – oral proceedings should be postponed until the restrictions are lifted

The responses are summarised in this chart:



Just less than half (49%) agreed with the EPO decision, while a quarter believed oral proceedings should be conducted in person (with Covid safety measures) unless a party requests to attend by ViCo.

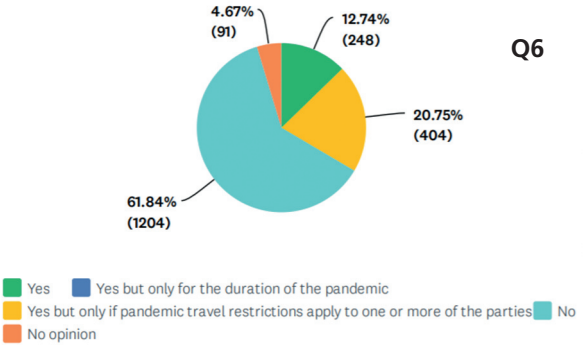
Drilling into the text comments, many respondents differentiated the situation for *ex parte* and *inter partes* oral proceedings. They commented that ViCo is suitable for oral proceedings with the Examining Division but for opposition proceedings face-to-face should take place.

Comparing the responses by country, respondents from the United Kingdom and Italy were much more likely to agree with the interim practice of the EPO (GB 70%, IT 63%).

Question 5 asked whether the measures adopted by the **Boards of Appeal during the pandemic** should be the same as for Examining and Opposition Divisions. 70% said Yes and 22% said No. In the comments, both those who answered 'Yes' and 'No' highlighted their preference for face-to-face oral proceedings during Appeal and noted that i) Appeal is the last instance, ii) face-to-face should be the default, in particular for *inter partes* proceedings, and iii) ViCo should be an option upon agreement of the parties.

Question 6 asked whether Examining Divisions, Opposition Divisions or Boards of Appeal should have the **power to require** a party to attend oral proceedings **either in person or by videoconference**, **against the wishes** of that party.

There is a clear majority against this power, although about 20% recognised some need to enforce participation to maintain the flow of justice *during the pandemic*.

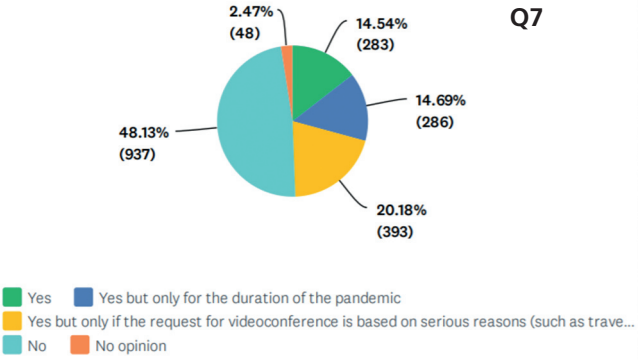


Comparing the opinions by country, respondents from Germany and United Kingdom were most likely to answer 'No' (68% DE, GB), but that could be because they don't want to be forced to attend by ViCo or because they don't want to be forced to attend face-to-face.

Prompted by the consultation on amendment to the RPBA, **Question 7** asked whether in ***inter partes*** cases an Opposition Division or Board of Appeal should have the power to **require ALL** parties to attend oral proceedings by videoconference, **if ONE party requests to attend by videoconference** (thereby to avoid "hybrid" proceedings). The options for response were:

- Yes
- Yes but only for the duration of the pandemic
- Yes but only if the request for videoconference is based on serious reasons (such as travel restrictions or quarantine)
- No

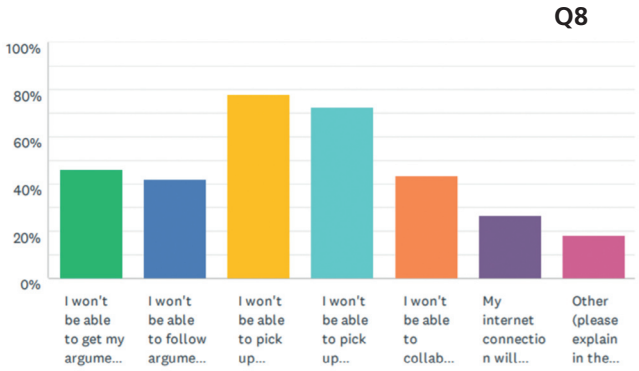
Just under half of the respondents said 'No', while the other half were sympathetic to this, particularly when necessitated by the pandemic.



Comparing answers by country, respondents from Germany and Netherlands were most strongly against this power (64% 'No', 54% 'No').

Q8 & Q9: Pros and cons of Oral Proceedings by ViCo

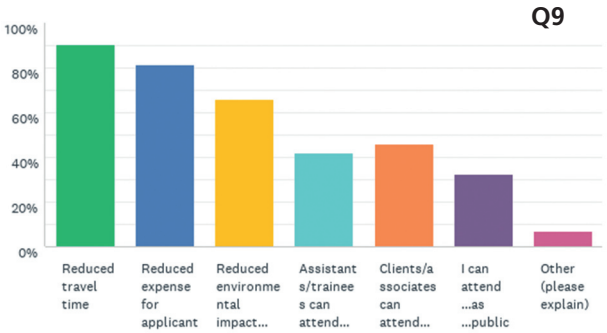
Question 8 asked, what would be the **main concerns of respondents**, if they were **required to attend oral proceedings by ViCo against their wishes**? A number of typical concerns were offered, with space to specify 'other'. 147 respondents indicated no concerns. The 1800 responses are summarised in the chart:



Many detailed comments were received, too numerous to reproduce here. In addition to the provided options, there were many comments on the **inability of the EPO to prevent recording** of ViCo OP (based on concerns that a recording could be made and used in proceedings in another jurisdiction).

Comparing by country, respondents from Italy were *least* likely to worry about getting their point across (20%) and Germans were *most* likely to worry (56%). Respondents from France were most likely to worry about their internet connection (39%), while respondents from Italy and United Kingdom were less worried (22%). In the other aspects, the concerns were roughly the same across all countries.

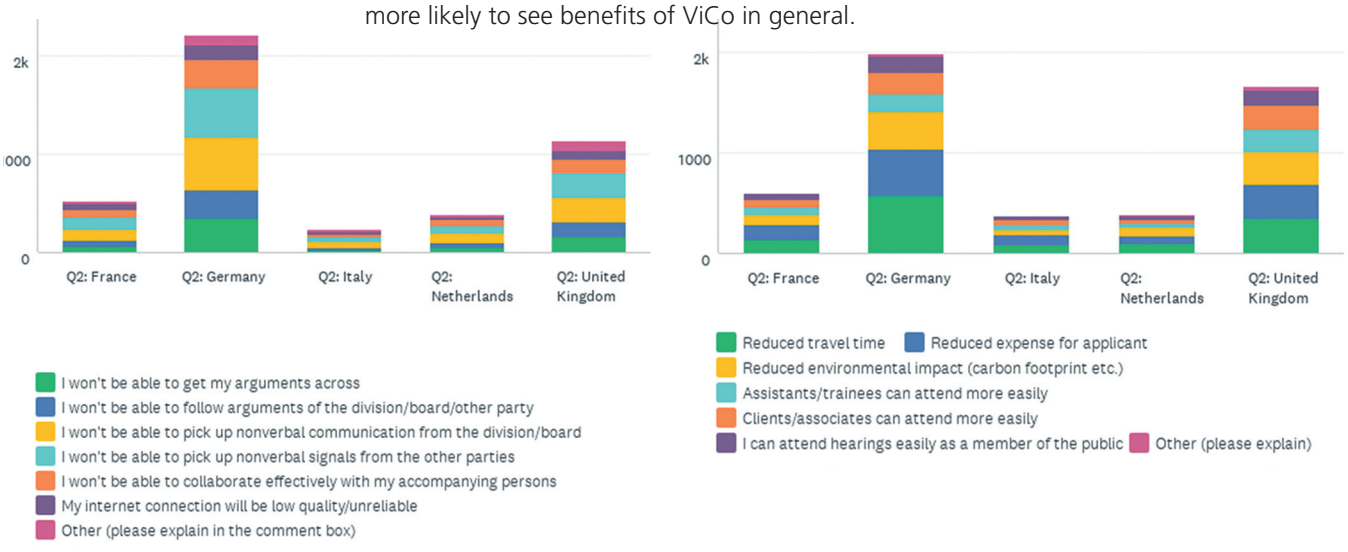
Conversely, **Question 9** asked respondents what they think are the **main benefits of oral proceedings being possible by ViCo**. Again a number of typical benefits were offered, and space for 'other' to be specified. 71 indicated no benefit, while the 1876 responses are summarised in the chart:



Among 272 comments, participants presented other reasons in favour of ViCo, including: working at office is more convenient; the normal pace of the Boards is maintained; not favouring representatives in EPO locations; enabling those who would have difficulties to travel (for example new parents).

Comparing by country, the vast majority of respondents recognised reduced cost and reduced travel time as main benefits. Reduced environmental impact was cited by 84% of respondents from the United Kingdom, 68% from Netherlands, but only 52% from Italy. Respondents from the United Kingdom were also more likely to see benefit in ease of attendance by trainees (56%) and ease of attendance by clients (64%).

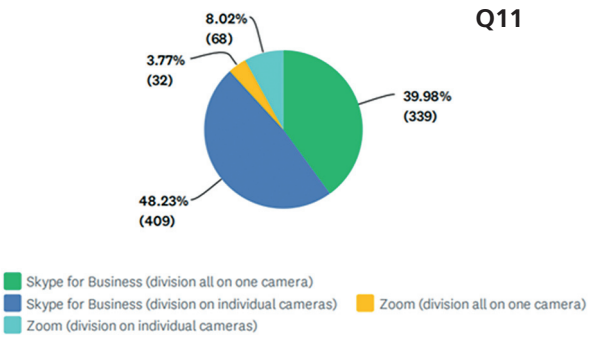
Comparing the numbers across Q8 and Q9, as well as by country, we see that respondents from United Kingdom definitely had concerns about having to attend oral proceedings by ViCo against their wishes, but were much more likely to see benefits of ViCo in general.



Q10-Q16: Experience of Oral proceedings by ViCo

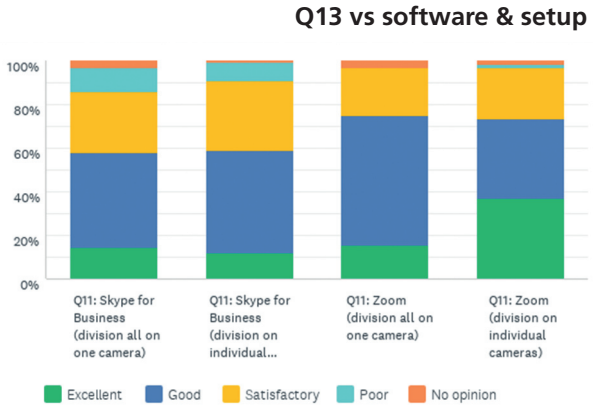
Question 10 asked participants whether they have **experience of EPO oral proceedings by videoconference**, and what type was their **most recent experience. Questions 11-15 are specifically about that experience**. 848 of the respondents (45%) indicated some experience. For 555 (28%) their most recent experience of ViCo proceedings was with an Examining Division, 226 (12%) Opposition Division, 22 (1%) *ex parte* Appeal (Examination) and 57 (3%) *inter partes* Appeal (Opposition).

Question 11 asked **which software** (Skype for Business ("SfB") or Zoom) was used for the most recent hearing, and whether the format was with the division/board members all on one camera or on individual cameras. As Zoom was a relatively new platform for the EPO, only 100 respondents indicated experience of Zoom at the time of the survey, while 748 had experienced SfB.



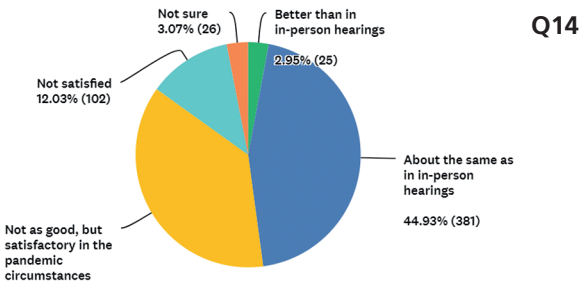
According to **Question 12**, two thirds of respondents would like filing of documents to be done within the videoconferencing application, but the existing email method is generally found to be satisfactory.

Question 13 asked respondents to **rate the software used for ease of use and audio/video quality**. 90% reported that the software was either Satisfactory (29%), Good (45%) or Excellent (15%), but 9% rated the software Poor. But which software? The following chart breaks these answers down:



Comparing the responses according to the different platforms, we see clearly that **Zoom provides a better experience** for the users (97% Satisfactory, Good or Excellent), compared with Skype for Business (85%). Moreover, **the proportion of users rating the software 'Excellent' more than doubles (to 37%) when every person has an individual camera. (NOTE**: The chart shows percentages but the number of respondents using Zoom was smaller, presumably due to the very recent introduction of Zoom (100 Zoom experiences vs 748 SfB).)

Question 14 asked whether the respondent was **satisfied that they could get their points across** to the division (compared with their experience of in-person hearings). Only 48% felt they could get their point across about the same as in in-person hearings, or better. 12% were not satisfied, while 37% were satisfied, *given the circumstances of the pandemic*.

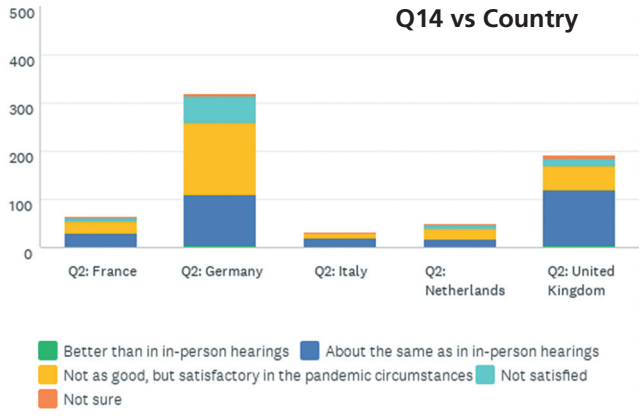


Much more detail was given in the textual comments. A number of respondents pointed out that nonverbal communication is impaired in videoconferences. The conduct of the procedure requires a lot more care by the chair. Some respondents noted that their experience only relates to "simple/relatively straightforward" cases and suggest that videoconferences might be less suited for more complex cases.

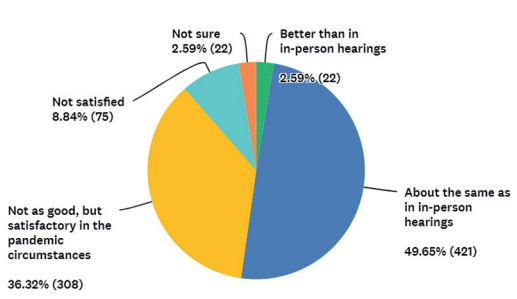
Comparing the responses according to the different answers given in Q11 (**software setup**), we see that those who experienced OP via Zoom felt they could get their points across a *little* better than those experiencing Skype for Business. Just over half of the Zoom users felt that the experience was at least as good as in in-person hearings, while 87% felt that the experience was, at least, satisfactory in the *circumstances of the pandemic*. On the downside, 35-40% of the Zoom users and 50% of the SfB users felt they were not able to get their point across as well as in in-person hearings, and consistently around 11-13% were not satisfied in any of the ViCo platforms.

Comparing the responses according to the different answers given in Q10 (**type of hearing**), we see a higher level of satisfaction in Opposition Division hearings than in other types of hearing. The type of hearing and the type of software are, in practice, linked. Also the setup and training of the Opposition Divisions may have an influence. It will need to be reviewed over time whether the experience with Examining Division and Board of Appeal hearings is better in Zoom.

Comparing the same answers by the **country** of the respondent (Q2), the level of satisfaction reported by respondents from Italy and United Kingdom was much higher (62% same as or better than face-to-face hearings) than that reported from Germany or the Netherlands (34-35%). (Interestingly, this difference in responses informed by *experience* of a few respondents, bears out the difference in *expectation* between those countries that was seen in Question 8.)



Question 15 asked, **whether participants were satisfied that they could follow the points** made by the division or other participants (compared with your experience of in-person hearings)? The proportions satisfied were very similar to those reported in Q14.

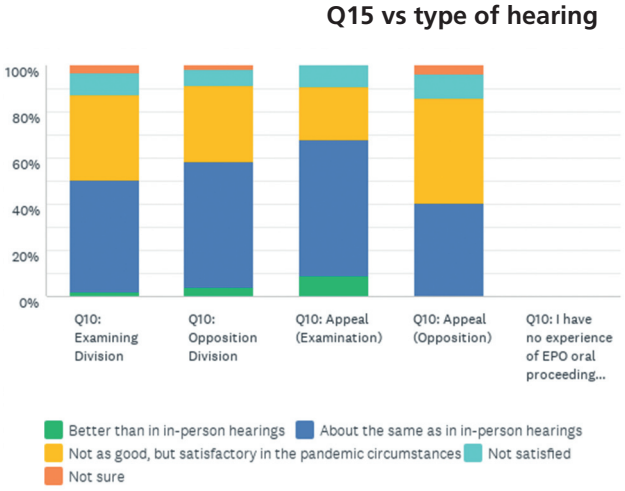


Similar to the comments on question 14, respondents noted that nonverbal communication is impaired and that the faces of individual participants, especially examiners/board members, are not clearly visible. This highlights the preference that each examiner/board member should have their own camera. Some noted audibility problems, while others noted that audibility is improved by videoconference, for example because the volume can be adapted to the volume of the person who is speaking.

Comparing the Q15 responses according to the different answers given in Q 11 (**software setup**), we see a pattern very similar to Q14: those who experienced OP via Zoom felt they could follow the points made by others a little better than those experiencing Skype for Business. In fact, 60% of the Zoom-on-individual cameras users felt that the experience was as good as in-person hearings, while 92% felt that the experience was, at least satisfactory *in the circumstances of the pandemic*. Conversely, however, 38-43% of the Zoom users and 45% of the SfB users felt they were not able to follow the points being made as well as they would face-to-face.

Comparing the responses according to the different answers given in Q 10 (**type of hearing**), we see a pattern even more extreme than in Q14: of those who experienced OP in Opposition Appeal, only about 40% felt they could follow the points made by others as well as they would in in-person hearings. Over 10% were not satisfied that they could follow the points being made as well as they would in-person hearings.

(**NOTE:** 90% of the Opposition Appeal hearings had been experienced in Skype for Business, i.e. 52 vs only 5 experiences of Zoom hearings. It is to be hoped that the experience with Board of Appeal hearings is better in Zoom.)



Comparing the responses by country, the satisfaction level is higher in Italy and United Kingdom, similarly to Q14.

Question 16 invited further comments about experience. Most comments were in support of ViCo, but with a decline of support from Examination > Opposition > Appeal. It seems that the **skill of the division/board** in handling proceedings is in general more important than whether the proceedings are conducted face-to-face or by ViCo.

Q17-Q25: Other questions

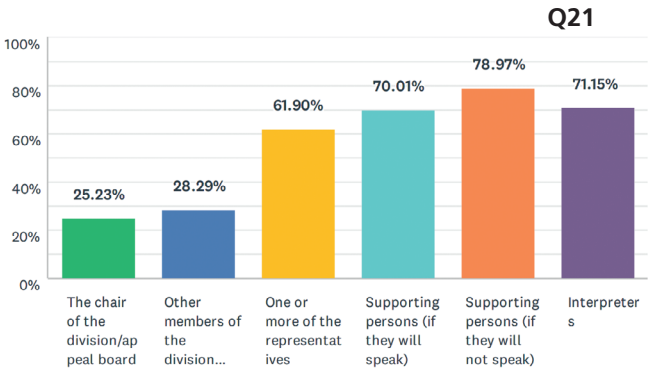
Under the Covid restrictions, **amended patent documents filed during Oral Proceedings can only be filed by email**. Answering **Question 17**, 75% of those who responded felt that email is sufficient, although 20% wanted the alternative of fax to be allowed. 184 respondents provided explanatory comments, with many suggesting that fax is outdated/unreliable.

In reply to **Question 18**, 40% of those responding thought it 'Essential' that the **videoconference application allow screen sharing and 'whiteboard' functions** for use by parties (subject to the established guidelines). A further 49% thought it 'Useful (but not essential)'. A few were concerned about, for example, security restrictions in their company setup, keeping a record of what is shown, and possible misuse.

In reply to **Question 19**, 65% of those who answered would prefer that **the same videoconference application provided private 'rooms' for internal discussions** (so that additional communication means for internal discussions within their team could be superfluous). 24% would still make other arrangements.

In reply to **Question 20**, 20% of those responding indicated that **some videoconferencing software or other is prohibited in their workplace** IT systems. In order of most prohibited among the four major packages, these are: Zoom (13%) Skype/Skype for Business (4%) Teams (3%) Webex (3%). 48 out of 1844 say they are prohibited from using both Zoom and Skype for Business. Comparing answers between **private practice and in-house** members (Q1), the restriction on installing software seems to be more of a problem for those in-house (>40% vs. <10% of those in private practice). The solution that most respondents adopt, when faced with these prohibitions, is to use their own personal devices, or devices not linked to the company's network, to participate in a videoconference. Several such respondents indicated that they are allowed to use Zoom for oral proceedings as an exception to the general prohibition.

Question 21 looks ahead to **face-to-face hearings** (when circumstances allow) and asks, **which participants (if any) should be allowed to join by videoconference** if they choose? 1764 respondents expressed an opinion.



Comments reflected the diverse opinions that proceedings by ViCo should, on a voluntary basis, be possible for all parties and their representatives, and/or that mixed/hybrid proceedings should be avoided. With respect to possible additional participants by ViCo (beyond those mentioned in the survey) the public was mentioned in about 10 % of the responses.

A surprisingly uniform opinion, however, relates to the presence of the deciding panel, i.e., the members of the Opposition Division or Board of Appeal: for in-person hearings their physical presence "in person" is strongly demanded by most of the commentators. Furthermore, the prevalent opinion is that the members of that panel should sit together in order to allow for a lively, possibly contentious, but productive discussion between the members of the Division or Board. Generally, it is asked that the parties and the members of the deciding panel communicate their way of participation well in advance to the other party and panel, in order to avoid somebody travelling from a distant location to Munich or The Hague solely to see that s/he is facing video screens rather than a panel or an adverse party!

Asked **which ViCo software they use regularly in their work (Question 22)**, more than three quarters (77%) use **Teams** regularly, and more than half (54%) use **Zoom** regularly. Asked which is their **preferred hardware (Question 23)**, over 70% prefer to use their normal work computer or laptop (albeit with additional screens, audio headset etc); 36% prefer a dedicated videoconferencing room installation.

In the event that the connection is lost during a videoconference and cannot be re-established, a majority (64%) of those responding would prefer that simply a second date be scheduled, although 20% would prefer to receive a new Summons.

Question 25 invited final free text answers, and 243 comments were received and reviewed.

Conclusions

It is difficult in the space available to do justice to the range and depth of comments received, and the diversity of situations and experiences. The detailed submissions serve as a valuable resource that will not be lost, and that is available to be consulted by interested members.

Some broad conclusions are drawn, namely:

- A majority of respondents recognise the suitability of ViCo between willing participants and for simpler cases but believe that it is not as effective as face-to-face hearings and should not be forced upon unwilling participants after the pandemic.
- A substantial minority disagree and favour ViCo as the default, for reasons such as "level playing field" and carbon footprint.
- On some questions, we see significant differences in opinion between participants from different EPC countries, including differences in the relative weighting of the various drawbacks and benefits of ViCo vs. face-to-face hearings.
- Some very positive experiences are reported, but also some less optimal (including with Boards of Appeal).
  - Some software platforms and arrangements work better than others, particularly Zoom with all participants on individual cameras.
  - Acceptance and success depends heavily on the careful preparation, training and conduct of the proceedings.
  - Technical guidelines should be realistic and not arbitrary.
- EPO does not seem to have a solution to the problem of illicit recording by "public", when recording is not allowed by the participants themselves.
- There is a strong belief that hybrid proceedings bring too many additional hazards in the conduct of the hearing, and probably disadvantage the remote party. Hybrid should be avoided unless the remote party really prefers it that way and accepts the risks.

Thanks to the team who helped in analysing the many responses, including Heike Vogelsang-Wenke, Chris Mercer, and John Gray plus David Brophy, Friedrich Scheele, Nada Herak, Manolis Samuelides, Konstantinos Vavekis, Gianni Masciopinto, Martin Bierbaum, Michael Kisters, Wolfgang Wilhelm.

Results of the online survey and full statistics can be found on the **epi** website:
https://patentepi.org/r/vico-survey

A report including full statistics and summaries of the free text comments can be found on the **epi** website:
https://patentepi.org/r/vico-survey-comments

General Information

epi Board

Präsident / President / Président
BE – LEYDER Francis

Vize-Präsident(in) / Vice-Presidents / Vice-Président(es)
MK – ILIEVSKI Bogoljub
DE – VOGELSANG-WENKE Heike

Generalsekretär / Secretary General / Secrétaire Général
– Vacant

Stellvertretender Generalsekretär
Deputy Secretary General / Secrétaire Général Adjoint
PL – AUGUSTYNIAK Magdalena

Schatzmeister / Treasurer / Trésorier
CH – THOMSEN Peter

Stellvertretender Schatzmeister / Deputy Treasurer
Trésorier Adjoint
HU – SZENTPÉTERI Zsolt

Next Board and Council Meetings

Board Meetings
115th Board meeting by videoconference on 9 April 2021

Council Meetings
90th Council meeting by videoconference on Saturday 8 May 2021
91th Council meeting in November 2021

Disciplinary Bodies, Committees and Audit

Disziplinarorgane, Ausschüsse und Rechnungsprüfung · Organes de discipline, Commissions et Vérification des comptes

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de Discipline (epi)
AL – NIKA Melina	FR – NEVANT Marc	MK – DAMJANSKI Vanco
AT – POTH Wolfgang°°	GB – GRAY John	MT – SANSONE Luigi A.
BE – DEBLED Thierry	GR – TSIMIKALIS Athanasios	NL – VAN LOOIJENGOED Ferry A.T.
BG – PAKIDANSKA Ivanka Slavcheva	HR – MARSIC Natasa	NO – THRANE Dag
CH – REUTELER Raymond	HU – KOVÁRI Zoltán	PL – ROGOZIŃSKA Alicja
CY – ROUSOUNIDOU Vasiliki	IE – SMYTH Shane	PT – DIAS MACHADO António J.
CZ – FISCHER Michael	IS – HARDARSON Gunnar Örn	RO – FIERASCU Cosmina
DE – FRÖHLING Werner°	IT – MAZZINI Giuseppe	RS – BOGDANOVIC Dejan
DK – FREDERIKSEN Jakob	LI – ROSENICH Paul*	SE – KARLSTRÖM Lennart
EE – KAHU Sirje	LT – GERASIMOVIC Jelena	SI – JAPELJ Bostjan
ES – STIEBE Lars Magnus	LU – KIHN Pierre	SK – LITVÁKOVÁ Lenka
FI – WESTERHOLM Christian	LV – SERGEJEVA Valentina	SM – MARTINI Riccardo
	MC – HAUTIER Nicolas	TR – YURTSEVEN Tuna**

Disziplinarausschuss (EPA/epi)	Disciplinary Board (EPO/epi)	Conseil de Discipline (OEB/epi)
epi Mitglieder	epi Members	Membres de l'epi
BE – CAMPABADAL Gemma	DE – MÜLLER Wolfram	IS – VILHJALMSSON Arni
	FR – QUANTIN Bruno	

Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi)	Disciplinary Board of Appeal (EPO/epi)	Chambre de Recours en Matière Disciplinaire (OEB/epi)
epi Mitglieder	epi Members	Membres de l'epi
DE – REBBEREH Cornelia	GB – JOHNSON Terence L.	NL – HOOIVELD Arjen
FR – GENDRAUD Pierre H.	HR – KORPER ŽEMVA Dina	TR – ARKAN Selda
	IT – COLOMBO Stefano	

Ausschuss für Berufliche Bildung	Professional Education Committee	Commission de Formation Professionnelle
Ordentliche Mitglieder	Full Members	Membres titulaires
AT – SCHARDMÜLLER Robert Claudius	GB – GWILT Julia Louise*	MT – PECHAROVÁ Petra
BE – VAN DEN HAZEL Hendrik Bart	GR – LIOUMBIS Alexandros	NL – VAN WEZENBEEK Lambertus A.C.M.
BG – KOSSEVA Radislava Andreeva	HR – PEJCINOVIC Tomislav	NO – BERG Per Geir
CH – KAPIC Tarik	HU – TEPFENHÁRT Dóra Andrea	PL – DARGIEWICZ Joanna
CY – THEODOULOU Christos A.	IE – SKRBA Sinéad	PT – CARVALHO FRANCO Isabel
CZ – HARTVICHOVA Katerina	IS – GUDMUNDSDÓTTIR Anna Valborg	RO – TEODORESCU Mihaela
DE – POTT Thomas	IT – RAMBELLI Paolo	RS – PLAVSA Uros
DK – STAHR Pia	LI – ALLWARDT Anke	SE – HERBJØRNSEN Rut
EE – SARAP Margus	LT – GERASIMOVIC Liudmila	SI – FLAK Antonija
ES – PATO COUR Isabel	LU – MELLET Valérie Martine	SK – MAJLINGOVÁ Zuzana
FI – KONKONEN Tomi-Matti Juhani	LV – KROMANIS Artis	SM – AGAZZANI Giampaolo
FR – COLLIN Jérôme	MC – THACH Tum	TR – ATALAY Baris
	MK – PEPELJUGOSKI Valentin	
Stellvertreter	Substitutes	Suppléants
AT – GEHRING Andreas	FI – NIELSEN Michael Jon	LI – HOFMANN Markus Günter
BE – DUYVER Jurgen Martha Herman	FR – FERNANDEZ Francis Lionel	NL – OP DEN BROUW-SPRAKEL Vera Stefanie Irene
BG – BENATOV Samuil Gabriel	GB – MACKETT Margaret	PT – DO NASCIMENTO GOMES Rui
CH – RUDER Susanna Louise	GR – KOSTI Vasiliki	RO – BONCEA Oana-Laura
CZ – HALAXOVÁ Eva	HR – HADZIJA Tomislav	SI – BORIC VEZJAK Maja
DE – STORK Martina	HU – RAVADITS Imre Miklós	SK – MISKOVICOVÁ Ivica
EE – KOPPEL Mart Enn	IE – GILLESPIE Richard	SM – PRIMICERI Maria Vittoria
ES – SÁNCHEZ Ruth	IT – MORABITO Sara	TR – AGCA KIZIL Tugce

*Chair/ **Secretary °Vice-Chair / °°Vice-Secretary

Ausschuss für Europäische Patent Praxis	European Patent Practice Committee	Commission pour la Pratique du Brevet Européen
AT – VÖGELE Andreas	FR – THON Julien	MK – FILIPOV Gjorgji
BE – RACINE Sophie Christiane Carol	GB – MERCER Christopher Paul*	NL – KETELAARS Maarten F.J.M.
BG – TSVETKOV Atanas Lyubomirov	GR – SAMUELIDES Emmanuel	NO – REKDAL Kristine
CH – WILMING Martin	HU – LENGYEL Zsolt	PL – KAWCZYNSKA Marta Joanna
CY – THEODOULOU Christos A.	IE – MCCARTHY Denis Alexis	PT – PEREIRA DA CRUZ Joao
CZ – BUCEK Roman	IS – FRIDRIKSSON Einar Karl	RO – NICOLAESCU Daniella Olga
DE – FLEUCHAUS Michael A.	IT – MODIANO Micaela Nadia	RS – HERAK Nada
DK – HEGNER Anette	LI – GYAJA Christoph Benjamin	SE – MATTSSON Malin Pernilla
EE – TOOME Jürgen	LT – PAKENIENE Ausra	SK – MICHALÍK Andrej
ES – SÁEZ GRANERO Francisco Javier	LU – OCVIRK Philippe**	SM – TIBURZI Andrea
FI – HONKASALO Terhi Marjut Anneli	LV – FORTUNA Jevgenijs	TR – MUTLU Aydin
	MC – SCHMALZ Günther	
Technical Field: Information and Communication Technologies		
CH – KAPIC Tarik	GB – ASQUITH Julian Peter	MC – SCHMALZ Günther
DE – BITTNER Peter	GR – SAMUELIDES Emmanuel	NL – VAN WOUDENBERG Roel
DE – FLEUCHAUS Michael A.*	IT – PES Matteo	PL – BURY Marek
FI – HONKASALO Terhi Marjut Anneli	LT – PAKENIENE Ausra	SM – PERRONACE Andrea
Technical Field: Pharmaceuticals		
CH – WILMING Martin*	FR – TARAVELLA Brigitte	HU – SZENTPÉTERI Zsolt
DE – NESTLE-NGUYEN Denise Kim-Lien Tu-Anh	GB – SARDHARWALA Fatema Elyasali	IT – MACCHETTA Francesco
		PL – KAWCZYNSKA Marta Joanna
FI – KARLSSON Krister	GR – VARVOGLI Anastasia Aikaterini**	RS – HERAK Nada
Technical Field: Chemistry		
BE – LUYTEN Ingrid Lena Rene	FI – KOKKO Antti Ohto Kalervo	LU – MELLET Valérie Martine**
CH – COGNIAT Eric Jean Marie	GB – BOFF James Charles*	SE – CARLSSON Carl Fredrik Munk
DE – KREMER Véronique Marie Joséphine	HU – LEZSÁK Gábor	
Technical Field: Mechanics		
CZ – BUCEK Roman	FI – HEINO Pekka Antero	NL – COOLEN Marcus Cornelis Johannes
DE – DÜRR Arndt Christian	GB – DUNN Paul Edward	
DE – STORK Martina	IT – PAPA Elisabetta	PL – LEWICKA Katarzyna Dorota**
DK – CARLSSON Eva*		RO – VASILESCU Raluca

Geschäftsordnungsausschuss	By-Laws Committee	Commission du Règlement Intérieur
Ordentliche Mitglieder	**Full Members**	**Membres titulaires**
AT – FORSTHUBER Martin	FR – MOUTARD Pascal Jean*	IT – GERLI Paolo
DE – MÜNCH Volker	GB – WRIGHT Simon Mark	
Stellvertreter	**Substitutes**	**Suppléants**
MC – SCHMALZ Günther	MK – VESKOVSKA Blagica	

Ausschuss für epi-Finanzen	epi-Finances Committee	Commission des Finances de l'epi
BE – QUINTELIER Claude	GB – POWELL Timothy John	PT – PEREIRA DA CRUZ Joao
CH – BRAUN André jr.	IT – RAMBELLI Paolo	RO – TULUCA F. Doina
DE – WINTER Andreas	LU – BEISSEL Jean	
EE – SARAP Margus	PL – MALEWSKA Ewa	

Ausschuss für EPA-Finanzen	Committee on EPO Finances	Commission des Finances de l'OEB
DE – WINTER Andreas**	MC – THACH Tum	DE – SCHOBER CHRISTOPH D.
GB – BOFF James Charles*	**Substitutes**	GB – FÈ LAURA
IE – CASEY Lindsay Joseph	BE – KELLENBERGER JAKOB	IT – FATTORI MICHELE

*Chair/ **Secretary °Vice-Chair / °°Vice-Secretary

Ausschuss für Standesregeln / Professional Conduct Committee / Commission de Conduite Professionnelle

Ordentliche Mitglieder / Full Members / Membres titulaires

AL	–	SHOMO Vjollca	HR	–	DLACIC Albina
AT	–	PEHAM Alois	HU	–	SOVARI Miklos
BE	–	VAN DEN BOECK Wim	IE	–	MCCARTHY Denis Alexis
BG	–	SIRAKOVA Olga Rousseva	IS	–	DAVIDSSON Snaebjorn H.
CH	–	MAUÉ Paul Georg	IT	–	CHECCACCI Giorgio*
DE	–	STORK Martina	LI	–	KÜNSCH Joachim
ES	–	JORDÁ PETERSEN Santiago	LT	–	PETNIUNAITE Jurga
FI	–	SAHLIN Jonna Elisabeth	LV	–	SMIRNOV Alexander
FR	–	DELORME Nicolas	MC	–	THACH Tum
GB	–	POWELL Timothy John	MK	–	KJOSESKA Marija

NL	–	BOTTEMA Johan Jan
NO	–	THORVALDSEN Knut
PL	–	KREKORA Magdalena
PT	–	CORTE-REAL CRUZ António
RO	–	NICOLAESCU Daniella Olga
RS	–	PETOSEVIC Slobodan
SE	–	HOLMBERG-SCHWINDT Tor Martin
SM	–	MAROSCIA Antonio
TR	–	CAYLI Hülya

Stellvertreter / Substitutes / Suppléants

AT	–	FOX Tobias	ES	–	SATURIO CARRASCO Pedro Javier
BE	–	WÉRY François	FI	–	VÄISÄNEN Olli Jaakko
BG	–	BENATOV Samuil Gabriel	FR	–	TARAVELLA Brigitte
CH	–	KÖRNER Thomas Ottmar	GB	–	DUNN Paul Edward
DE	–	WINTER Andreas	LI	–	BAZZON Andreas

MK	–	VESKOVSKA Blagica
NO	–	HJELSVOLD Bodil Merete Sollie
PL	–	CHIMIAK Monika
SE	–	BJERNDELL Per Ingvar
SM	–	AGAZZANI Giampaolo

Ausschuss für Streitregelung / Litigation Committee / Commission Procédure Judiciaire

Ordentliche Mitglieder / Full Members / Membres titulaires

AL	–	PANIDHA Ela	FR	–	NUSS Laurent
AT	–	STADLER Michael	GB	–	RADKOV Stoyan Atanassov
BE	–	JAEKEN Annemie	GR	–	VAVEKIS Konstantinos
BG	–	GEORGIEVA-TABAKOVA Milena Lubenova	HR	–	VUKINA Sanja
			HU	–	TÖRÖK Ferenc
CH	–	THOMSEN Peter René*	IE	–	WALSHE Triona Mary**
CY	–	THEODOULOU Christos A.	IS	–	INGVARSSON Sigurdur
CZ	–	HALAXOVÁ Eva	IT	–	COLUCCI Giuseppe
DE	–	PFRANG Tilman	LI	–	HARMANN Bernd-Günther
DK	–	THORSEN Jesper	LT	–	VIESUNAITE Vilija
EE	–	KOPPEL Mart Enn	LU	–	BRUCK Mathis
ES	–	ARIAS SANZ Juan	LV	–	OSMANS Voldemars
FI	–	FINNILÄ Kim Larseman°	MC	–	SCHMALZ Günther

MK	–	PEPELJUGOSKI Valentin
MT	–	GERBINO Angelo
NL	–	LAND Addick Adrianus Gosling
NO	–	SIMONSEN Kari Helen
PL	–	LEWICKA Katarzyna Dorota
PT	–	CRUZ Nuno
RO	–	PUSCASU Dan
RS	–	ZATEZALO Mihajlo
SE	–	PRESLAND Torbjörn
SI	–	OSOLNIK Renata
SK	–	NEUSCHL Vladimir
SM	–	BALDI Stefano
TR	–	TAS Emrah

Stellvertreter / Substitutes / Suppléants

AT	–	HEDENETZ Alexander Gernot	FR	–	MELLET Valérie Martine
BE	–	RACINE Sophie Christiane Carol	HR	–	DLACIC Albina
BG	–	NESHEVA Valentina Velikova	IE	–	WHITE Jonathan Patrick
CH	–	KÖRNER Thomas Ottmar	IT	–	DE GREGORI Antonella
CZ	–	GUTTMANN Michal	LI	–	HOLZHEU Christian
DE	–	TÖPERT Verena Clarita	LU	–	PEETERS Jérôme Pierre
FI	–	KARLSSON Krister	LV	–	FORTUNA Jevgenijs

PL	–	DARGIEWICZ Joanna
PT	–	SILVESTRE DE ALMEIDA FERREIRA Luís Humberto
SM	–	PETRAZ Davide Luigi
TR	–	DERIS M.N. Aydin

Ausschuss für IP-Kommerzialisierung / IP Commercialization Committee / Commission de commercialisation de la propriété intellectuelle

CH	–	BLÖCHLE Hans	ES	–	DURÁN MOYA Luis-Alfonso
CH	–	RUDER Susanna Louise**	ES	–	IGARTUA Ismael
DE	–	MÜLLER Hans Jörg	GB	–	LESSARD Jason Donat
DE	–	STÖCKLE Florian*	GR	–	VAVEKIS Konstantinos°

HR	–	MARSIC Natasa
IT	–	BARACCO Stefano

*Chair/ **Secretary °Vice-Chair / °°Vice-Secretary

Ausschuss für Biotechnologische Erfindungen	Committee on Biotechnological Inventions	Commission pour les Inventions en Biotechnologie
AL – SINOJMERI Diana	GB – WRIGHT Simon Mark**	PL – KAWCZYNSKA Marta Joanna
AT – PFÖSTL Andreas	GR – KOSTI Vasiliki	PT – TEIXEIRA DE CARVALHO Anabela
BE – DE CLERCQ Ann G. Y.*	HR – MARSIC Natasa	RO – POPA Cristina
BG – TSVETKOV Atanas Lyubomirov	HU – PETHO Arpad	RS – BRKIC Zeljka
CH – SPERRLE Martin	IE – HALLY Anna-Louise	SE – MATTSSON Niklas
CZ – HARTVICHOVA Katerina	IS – JONSSON Thorlakur	SK – MAKELOVÁ Katarína
DE – EXNER Torsten	IT – TRILLAT Anne-Cecile	SM – PRIMICERI Maria Vittoria
DK – SCHOUBOE Anne	LI – BOGENSBERGER Burkhard	TR – YALVAÇ Oya
ES – BERNARDO NORIEGA Francisco	LT – ARMALYTE Elena	
FI – VIRTAHARJU Outi Elina	MK – VESKOVSKA Blagica	
FR – TARAVELLA Brigitte	NL – SWINKELS Bart Willem	

Harmonisierungsausschuss	Harmonisation Committee	Commission d'Harmonisation
CZ – ZEMANOVÁ Veronika	FI – KÄRKKÄINEN Veli-Matti	IE – ROCHE Dermot
DE – LEISSLER-GERSTL Gabriele	GB – BROWN John D.*	IT – SANTI Filippo**
DE – WEINGARTEN Ulrich	IE – HANRATTY Catherine	PL – KREKORA Magdalena
ES – DURÁN MOYA Luis-Alfonso		

Ausschuss für Online-Kommunikation	Online Communications Committee	Commission pour les Communications en Ligne
AT – GASSNER Birgitta	DE – SCHEELE Friedrich	IT – MEINDL Tassilo
BE – BIRON Yannick**	FR – MÉNÈS Catherine	PL – LUKASZYK Szymon
CH – VAVRIN Ronny	GB – GRAY John James*	RO – BONCEA Oana-Laura
DE – GRAU Benjamin	IE – BROPHY David Timothy°	

Wahlausschuss	Electoral Committee	Commission pour les Élections
CH – MÜLLER Markus Andreas*	GB – BARRETT Peter	IS – VILHJÁLMSSON Arni

Redaktionsausschuss	Editorial Committee	Commission de Rédaction
BE – BLANCHE Emilie	DE – THESEN Michael	GB – MURNANE Graham John
DE – HERRMANN Daniel	FR – AMIRA Sami	IE – CASEY Lindsay Joseph**
DE – SCHMID Johannes	FR – NEVANT Marc*	

Zulassungsausschuss für epi Studenten	epi Studentship Admissions Committee	Commission d'admission des étudiants de l'epi
AT – SCHWEINZER Friedrich	GB – MERCER Christopher Paul*	NL – VAN WEZENBEEK Lambertus A.C.M.
CH – FAVRE Nicolas	IT – MACCHETTA Francesco	
DE – LEISSLER-GERSTL Gabriele	IT – PROVVISIONATO Paolo	

Rechnungsprüfer	Auditors	Commissaires aux Comptes
Ordentliche Mitglieder	Full Members	Membres titulaires
CH – KLEY Hansjörg	FR – CONAN Philippe	
Stellvertreter	Substitutes	Suppléants
AT – HEDENETZ Alexander Gernot	LV – FORTUNA Larisa	

*Chair/ **Secretary °Vice-Chair / °°Vice-Secretary

Ständiger Beratender Ausschuss beim EPA (SACEPO)	Standing Advisory Committee before the EPO (SACEPO)	Comité consultatif permanent auprès de l'OEB (SACEPO)
epi-Delegierte	epi Delegates	Délégués de l'epi
BE – LEYDER Francis DE – VOGELSANG-WENKE Heike DK – HEGNER Anette	GB – BOFF James Charles GB – GRAY John James	GB – MERCER Christopher Paul MK – ILIEVSKI Bogoljub

SACEPO – Arbeitsgruppe Regeln	SACEPO – Working Party on Rules	SACEPO – Groupe de Travail Règles
DE – WILMING Martin	GB – MERCER Christopher Paul	FI – HONKASALO Terhi Marjut Anneli

SACEPO – Arbeitsgruppe Richtlinien	SACEPO – Working Party on Guidelines	SACEPO – Groupe de Travail Directives
DE – WILMING Martin	DK – HEGNER Anette	GR – SAMUELIDES Emmanuel

SACEPO – Arbeitsgruppe Qualität	SACEPO – Working Party on Quality	SACEPO – Groupe de Travail Qualité
MK – ILIEVSKI Bogoljub	DE – VOGELSANG-WENKE Heike	

SACEPO – PDI	SACEPO – PDI	SACEPO – PDI
AT – GASSNER Birgitta BE – LEYDER Francis	GB – MERCER Christopher Paul	IT – PROVVISIONATO Paolo

SACEPO – EPP	SACEPO – EPP	SACEPO – EPP
BE – BIRON Yannick	FI – HONKASALO Marjut Anneli	

Contact Data of EPO Legal Division

Update of the European Patent Attorneys Database

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the Legal Division of the EPO (Dir. 5.2.3) of any change in your contact details.

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

European Patent Office
Dir. 5.2.3
Legal and Unitary Patent Division
80298 Munich
Germany

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

The relevant form(s) to be submitted in the case of changes can be downloaded from the EPO website: https://www.epo.org/applying/online-services/representatives/changes.html

Further information and forms relating to the list of professional representatives can be found on the EPO website (https://www.epo.org/applying/online-services/representatives.html) and in the FAQ section of the **epi** website (https://patentepi.org/en/faq).

Thank you for your cooperation.

IPRISK Professional Liability Insurance for **epi** Members

Why?

European patent attorneys handle National, European and Foreign patent applications and patents. Those patent applications and patents may have a high commercial value and the loss of those patents might cause their proprietor serious damages for which the patent attorney might be liable. In particular for those working in private practice it is thus highly recommended to have a professional liability insurance.

At **epi** we realized that it was not always easy, and in particular not cheap, for our members to subscribe an appropriate professional liability insurance, so we decided to help our members in offering them a product tailormade for them.

What?

In line with the **epi** Council decisions, **epi** negotiated and agreed a framework contract for a professional liability insurance setting out general principles and conditions applicable in all 38 EPC Contracting States. The framework contract was signed with RMS, a Coverholder at Lloyd's, and placed by certain Underwriters at Lloyd's of London.

Any **epi** member offering services to external clients can benefit from this insurance. The insurance premium to be paid is calculated on the basis of the turnover of the insured **epi** member and depending on the insurance coverage selected.

Which are the advantages for epi members?

- An insurance coverage selectable between 500 000€ and 5 000 000€ per incident, per year and per insured member
- Covers the work done by the support staff of the patent attorney
- Covers the work of the patent attorney before the EPO and the national offices in Europe before which the **epi** member is entitled to act
- Additional coverage for trademarks and design work can be obtained with the payment of an additional premium
- Competitive conditions and premiums
- Possibility to have a retroactive coverage
- Knowledge of the profession on the side of the insurance company

More information needed?

Please have a look at the **epi** website https://patentepi.org/r/iprisk where you can also find a questionnaire which you can fil in to obtain a price offer.

For further information you can also send an email to insurance@patentepi.org

---

RMS RISK MANAGEMENT SERVICE

Under Framework Agreement with epi®

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

Postanschrift / Mailing address / Adresse postale
epi
Bayerstrasse 83
80335 Munich
Germany
Tel: +49 89 24 20 52-0
Fax: +49 89 24 20 52-220
Email: info@patentepi.org
www.patentepi.org

Layout und Satz / Layout and composition / Mise en page et ensemble
SIMIUS New Media GmbH
Am Söldnermoos 17
85399 Hallbergmoos
Tel: +49 (811) 1283 4089
Email: info@simius.de
www.simius.de

European Patent Institute
Bayerstrasse 83
80335 Munich | Germany