

Institut der beim Europäischen
Patentamt zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

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Editorial

T. Johnson (GB)

Many **epi** members, particularly 'grandfathers', will remember the excitement in the office when the first photocopier arrived, particularly as in my case when the machine spontaneously combusted on occasion when it sat in a corner waiting to be used! Technology progresses, we live in an electronic age now, though we understand that there are still some national or Supranational bodies that do not accept electronically filed applications, preferring rather to rely on facsimile communications. Things do, however, move on. Members will be aware, and hopefully will be pleased to note, that a new communication package, the "notification package" comes into force on 1st April, 2015 by which notifications of decisions, summonses and other communications will be sent to EPO users electronically by the Office. The "notification package" is essentially an updating amendment of the Implementing Regulations, adopted by the Administrative Council on 15th October, 2014, document CA/47/14. The new "package" deems

inter alia that an electronic "letter" is considered to have been received on the tenth day after it is sent to a user, for example to an opponent. So, just like in the days of 'snail' mail, but applicable to the age in which we now operate. Indeed there is a new Rule, Rule 127, which we understand has the ambition to embrace a swathe of technical systems from current postal mail to existing and future electronic systems. It is virtually impossible to foretell all possible developments in the art, (has the perfect claim been drafted?), but a valiant attempt nevertheless.

It will be up to our members to decide whether the "communication package" is a tool which should be welcomed, but from our perspective, it seems a move in the right direction, a desirable adjunct to the way the EPO communicates with its users, and one which unlike those copier machines of old is not likely to blow up in our faces!

Report of the Harmonisation Committee (HC)

F. Leyder (BE), Secretary

This report completed on 13 February 2015 covers the period since my previous report dated 26 August 2014.

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

Workshop on the economic effects of introducing a grace period in Europe

Initiated by the EPO Economic and Scientific Advisory Board (ESAB), this workshop was held at the EPO on 26 November 2014.

Many European Patent Attorneys participated, but only two participants were indicated as affiliated with **epi**, namely Tony Tangena and Francis Leyder (rapporteur). The Report of the Workshop was not yet available at the time of finalising this report.

EPO Tegernsee Symposium

The European Patent Office held a symposium in Munich on 12 February 2015, entitled "EPO Symposium on

Harmonisation: Tegernsee and beyond". The presentations were not yet available at the time of finalising this report. A report will be prepared by the EPO.

32 organisations, companies and Offices were represented. **epi** was represented by Gabriele Leissler-Gerstl, John Brown, Francis Leyder and Naoise Gaffney. John Brown made concluding remarks on behalf of **epi**.

22nd Session of the SCP

The 22nd session of the Standing Committee on the Law of Patents (SCP 22) will be held in Geneva, from the 27th to the 31st of July 2015. No working papers are yet available on the WIPO website.

Next committee meeting

No date has yet been set.

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair

This report completed on 13.02.2015 covers the period since my previous report dated 07.11.2014.

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

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

1. G3/14

In my previous report, I reported that no *amicus curiae* brief had been timely sent by **epi** for pending case G3/14, because no volunteer had stepped forward. When a volunteer later circulated a draft, the discussion quickly involved many members, and a brief was finally sent (late) on 24.11.2014. It has already been published in **epi** Information 4/2014, pages 162-4.

2. EPPC meeting

The EPPC met on 02-03.02.2015. The Committee discussed guidelines and unitary patent protection (see below), and held preliminary discussions in preparation of the PCT Working Group (a meeting of the PCT sub-committee is being planned for when the working papers will be available). The **epi** Secretariat had organised a dinner.

On the second day, the EPPC discussed the independence of the Boards of Appeal in the light of R19/12, and agreed on the sending of a proposal. The EPPC was then honoured by the visit of our President, who led a discussion on the matter of hand-written amendments during oral proceedings. Further topics handled during the meeting include patents and standards (see below), poisonous priorities and divisionals (in preparation of the expected referral to the Enlarged Board of Appeal)

3. Patents and standards

In response to the public consultation on "Patents and Standards" launched by the European Commission (DG Enterprise), the EPPC prepared observations that were sent on 06.02.2015 (the deadline which was initially 31.01.2015 had been extended to 15.02.2015). The observations are attached.

4. Enlarged Board of Appeal

After R19/12, the question of the independence of the Enlarged Board of Appeal (EBoA) in review proceedings has become of interest. This prompted the relevant sub-committee to trigger the sending of a letter to the Chairman of the AC to advocate for having the EBoA comprise one external member in its composition under Rule 109 (2) (a) EPC and three in its composition under Rule 109 (2) (b) EPC.

5. Thematic groups

Two thematic groups are up and running: one in the field of Pure and Applied Organic Chemistry (PAOC), which includes medical uses, the other in the field of Computer-Implemented Inventions (CII). The fields covered by thematic groups should correspond to Principal Directorates: the CII group is thus being expanded to Information and communications technology (ICT). At the EPPC meeting, we started setting up a group dealing with the mechanical field.

Thematic groups are normally composed with EPPC members. Since we appear not to have enough members to set up all thematic groups, I made a call for candidates amongst the Council members at the last meeting. Council members who are specialising in one of the technical fields are kindly invited to contact me at epcc@patentepi.com.

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

The actions of Spain against both Regulations (C-146/13 and C-147/13) were still pending before the Court of Justice of the EU at the time of finalising this report.

The SC (Select Committee of the Administrative Council of the EPOrg) held its 11th meeting on 09.12.2014.

One agenda item was particularly relevant to the EPPC, namely a decision on the Draft rules relating to unitary patent protection. The Committee in principle approved draft Rules 1 to 24, agreeing that draft Rule 25 is put into brackets and would be addressed in the context of further discussions of the budgetary and financial issues of unitary patent protection. The consolidated version of the draft Rules has been made available on the EPO website (<http://www.epo.org/about-us/organisation/select-committee/documentation.html>).

The SC then resumed discussions on simulations relating to fee levels, and noted some presentations given by the EPO on simulations of unitary fee levels and their impact on EPO income.

In closed session, the SC held a first exchange of views on the distribution key for the repartition of renewal fees between the participating member states. The 12th SC

meeting will deal exclusively with the methodology relating to the distribution key, again in closed session, on 19.02.2015.

The next meetings would be held in the margins of the AC meetings in March and June 2015 and of the BFC meeting in May 2015. The June meeting would see final decisions on all items.

7. SACEPO/WPG11

The annual meeting of the Working Party on Guidelines was held on 25.11.2014. Our delegates are happy about the constructive spirit of the WPG meetings. Of course, not all of our proposals for amendment of the Guidelines were accepted, but we will continue to press for the ones we feel most important.

Noteworthy is that the EPO proposed to introduce a separate set of Guidelines for PCT procedures before the EPO. This was warmly welcomed by the users, because the Euro-PCT Guide for Applicants does not have the status of Guidelines. These "PCT-EPO Guidelines" would follow the structure of the "Guidelines for Examination in the EPO", and would contain those parts of the Internal Instructions relating to PCT procedures which are of interest and importance to the public.

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

8. SACEPO/WPR 12

We have received the invitation to the 12th meeting of the Working Party on Rules, to be held on 31.03.2015, but have not received the agenda at the time of finalising this report.

As promised, the EPPC will provide its updated "wish list" for rule amendments for consideration at the meeting.

9. Next meeting

The next EPPC meeting is intended to take place after the summer. In the meantime, in response to an offer from the EPO, a Partnership for Quality meeting will be organised with quality and IP5 harmonisation as key topics.

For further information see attachment in the section "Articles", page 14 "Observations of the **epi** on Patents and Standards"

Report of the Professional Education Committee (PEC)

P. Rambelli (IT), Chair

Summary of educational activities in 2014

Annex 1 summarises statistical data on participation to the 2014 **epi** and **epi**/EPO training events, splitted according to the education targets, namely:

- training of the EQE candidates:
 - summer and autumn tutorial
 - Mock EQE;
- Training of **epi** members:
 - specific CPE and basic seminars
 - CPE webinars recording.

In total, about 681 **epi** members and 149 **epi** students benefited from our training events. The number (123) of non-**epi** members and non-**epi** students who participated in our events relatively high. This is mainly due registrations for the webinar/recording series and specific seminars in Turkey and Spain, where a number of attendees appears were EQE candidates who are not **epi** students.

Looking at the data for the seminars, it appears that a relatively high number of EQE candidates or potential EQE candidates do not register as **epi** students, particularly in countries where the EQE pass rate is low. This confirms that there is still a high need and demand for training in such countries.

UP and UPC education

We released two video presentations, “**epi** video update on the Unitary Patent” and “**epi** video update on the Unified Patent Court”, in the middle of November 2014. The Working Group UP/UPC education, set up by PEC, EPPC and LitCom, organised and supervised the presentations.

These presentations are available free of charge in the **epi** members section of the **epi** website. They complement the information in the EPO webinars on the same subject, available free of charge on the EPO website.

Education activities under the EPO/epi MoU (Memorandum of Understanding) and related working plan, in 2015

The MoU and relating working plan has not yet been signed for administrative reasons. However, the agreed 2015 activities are proceeding as planned.

Opposition and Appeal seminars

About 350 persons have already registered for the Opposition and Appeal seminars, organised by **epi** with the EPO support.

The seminars will be held in London, Munich, Stockholm and Helsinki, from 24 February to 19 May 2015.

GL2DAY and Art. 123 (2) EPC seminar roadshow

On 27 January 2015 EP Academy representatives, PEC representatives and EPO/**epi** appointed speakers attended a kick-off meeting in Munich. The meeting defined the agenda for the seminars. The speakers are developing their relevant presentations for the first seminar, in The Hague on 15 April 2015.

Examination matters workshop

The workshop, organised by the EPO with **epi** support, will be held on 16 and 17 April 2015. It is already fully booked.

In view of the overwhelming demand, the EPO is considering repeating it in 2015.

epi cooperation with CEIPI

On 27 January 2015, **epi** and CEIPI held a meeting at CEIPI in Strasbourg. The President, the Vice-president Mihaela Teodorescu, the Treasurer and the PEC Chair attended on behalf of **epi**. Prof Christophe Geiger and Mr. Thierry Debled attended on behalf of CEIPI.

The purpose of the meeting was to review current joint activities, to confirm the need for an agreement, defining respective roles and duties, and to explore the possibility of further co-operation.

At present **epi** and CEIPI co-operate on the Litigation Course, which is expected to lead to the establishment of the litigation certificate, and the **epi**/CEIPI basic training course, which has been running since 1986.

The parties agreed they wished to continue these courses, and that an agreement (a bilateral MoU) is necessary for that end. The parties also agreed on the need for a revision of the organisational and to financial responsibilities. **epi** and CEIPI will continue to work on this in 2015.

Statistical data on participation to recent **epi** training events

Training for EQE candidates

Training	No. of Candidates	No. of Papers	Involved epi Tutors
Summer tutorial	14	47	11
Autumn tutorial	41	123	38
Mock EQE in Stockholm and Helsinki	14	23	4
	69	193	53

Training for **epi** member and interested public

Seminars

Country	City	Date	Topic	Total no. part.	epi member	epi students	other
GB	London	11.02.2014	Opposition & Appeals	72	62	10	–
RO	Bucharest	3./4.03.2014	Prosecution	21	7	6	8
NO	Oslo	10.04.2014	Mock Oral Proceedings	37	28	–	9
TR	Istanbul	12./13.05.2014	Pre-drafting + Drafting	53	–	26	27
NO	Oslo	17.06.2014	Opposition & Appeals	22	15	1	6
ES	Barcelona	09.09.2014	Opposition & Appeals	59	29	1	29
NL	Eindhoven	21.11.2014	Opposition & Appeals	163	148	8	7
RO	Bucharest	21.11.2014	Opposition	8	3	3	2
				435	282	55	88

Webinar/Recording

Topic	Total no. part.	epi member	epi students	other
Guidelines2DAY – Virtual classroom	198	189	9	–
Guidelines2DAY – Recorded session	251	200	16	35
	449	389	25	35

epi Seminar supported by the EPO on Opposition & Appeal on 24 February 2015, London

Due to the overwhelming response in London to the Opposition & Appeal seminar in 2014, **epi** repeated the seminar in February 2015, once again at CIPA in London.

Cees Mulder (for the **epi**) and Markus Müller (for the EPO) presented the topic in an interactive and engaging way to 62 participants, mainly from the UK.

CIPA President, Catriona Hammer, opened the seminar and moderated the morning session.

Jon Gowshall, UK PEC (Professional Education Committee) member moderated the afternoon session.

The post-seminar feedback particularly highlighted that the presenters shared a wealth of personal experience, insights, hints and tips. This enriched the experience and made learning more enjoyable.

epi now takes this successful seminar to Munich, Stockholm and Helsinki. This is your chance to take part!

We will keep all our members informed on these and other scheduled seminars. You can find details in the

“Education and Training” section of our website www.patentepi.com.

For the first time we went “paperless”, which means no printed handouts. This was well received by the participants, who found the handouts on USB sticks a good and convenient way to receive the course materials.

Among their other duties, PEC members are responsible for setting up national seminars. If any **epi** member would like to have a seminar organised in their city/country, they should get in touch with their respective PEC member. To contact your PEC member, please log onto our website, and the email addresses of the PEC members will be visible. Please note that the email addresses on our website may not be used for any other purpose than communication on educational/PEC matters.

Forthcoming **epi** educational events

epi seminars with support of the EPO

Seminar series “Opposition and Appeal”

14 April 2015 – Stockholm (SE)

19 May 2015 – Helsinki (FI)

EPO seminars with support of the **epi**

Seminar series “Guidelines2day & Article 123(2) EPC

15 April 2015 – The Hague (NL)

27 April 2015 – Copenhagen (DK)

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

The part on Art. 123 (2) EPC will cover a short theoretical background, recent caselaw and general

examples, i.e. where no field-specific technical knowledge is required to comprehend them. If there is sufficient demand, field-specific examples can be covered in follow-up virtual classrooms.

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

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

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 2016

- 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 (2015) wir schriftlich kommentieren.

Aufteilung des Kurses:

Modul 1 (ab Juni 2015)

Die Kandidaten erarbeiten zu Hause schriftlich Lösungen zu den Prüfungsaufgaben des Jahres 2014. 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): 01.06.2015

Modul 2 (September 2015)

Vorstellen von Prüfungstechnik und -strategien für die einzelnen Teile. Ausführliche Besprechung der Fragen zu Prüfungsaufgaben 2014 und, wo erwünscht, Fehleranalyse der Kandidatenarbeiten.

Modul 3 (Anfang November 2015)

Die Kandidaten können zur Vorbereitung an Modul 2 teilnehmen. Modul 3 umfasst die Durchführung einer simulierten, dreitägigen Prüfung mit den Prüfungsaufgaben von 2015. 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): 01.09.2015

- **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**

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Contact Data of Legal Division

Update of the European Patent Attorneys database

Please send any change of contact details using EPO Form 52301 (Request for changes in the list of professional representatives: <http://www.epo.org/applying/online-services/representatives.html>) to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 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):

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www.epo.org

Thank you for your cooperation.

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

Next Board and Council Meetings

Board Meetings

93rd Board meeting on September 19, 2015 in Porto (PT)

94th Board meeting on March 12, 2016 in Tallinn (EE)

Council Meetings

78th Council meeting on April 25, 2015 in Barcelona (ES)

79th Council meeting on November 14, 2015 in Cologne (DE)

80th Council meeting on April 30, 2016 in Athens (GR)

Nächster Redaktionsschluss für **epi** Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **8. Mai 2015**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for **epi** Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of **epi** Information is **8th May 2015**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour **epi** Information

Veillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de **epi** Information est le **8 mai 2015**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

epi Artists Exhibition 2015

The **epi** was very pleased to invite for the 10th time all creative spirits among the **epi** members to the **epi** Artists Exhibition in Munich organized by Ms Sadia Liebig and Ms Vernessa Pröll from the **epi** Secretariat. The exhibition took place in the Foyer of the EPO (Pschorrhöfe) in Munich from 2–13 March 2015 and was opened on 2 March 2015 by Mr Zeljko Topić, Vice President DG4 from the EPO and Ms Gabriele Leissler-Gerstl, Vice President of the **epi**.

More than 150 persons accepted the invitation to the opening and the **epi** was very proud to welcome most of the participant artists on site. This year 17 **epi** members from all over Europe were presenting their artworks and the contributions ranges from pictures to photographs, jewelry and sculptures. The opening gave space for many fruitful discussions and exchange of ideas and the premises of the EPO were once again full of atmosphere.

The **epi** Artists Exhibition was then open for the public for two weeks and was well attended by all interested people.

The great popularity of this exhibition has confirmed that the **epi** Artists Exhibition has become a tradition in the cultural life of the **epi** and the EPO.

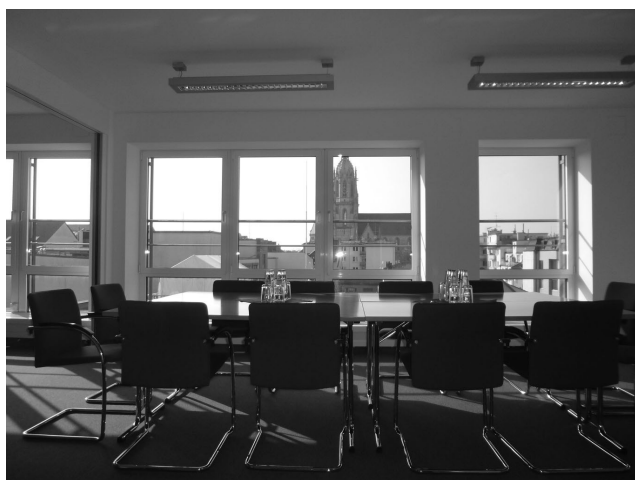
The **epi** would like to take the opportunity to thank all artists for providing their contributions so that the exhibition could have been so successful.

The **epi** is very honoured by there extraordinary artists contributing to our **epi** Artists Exhibition and we are very much looking forward to continuing this successful tradition in 2018.





News from the **epi** Secretariat



- **New premises since January 2015**
- **Same address, 5th floor**
- **New meeting rooms – available soon**

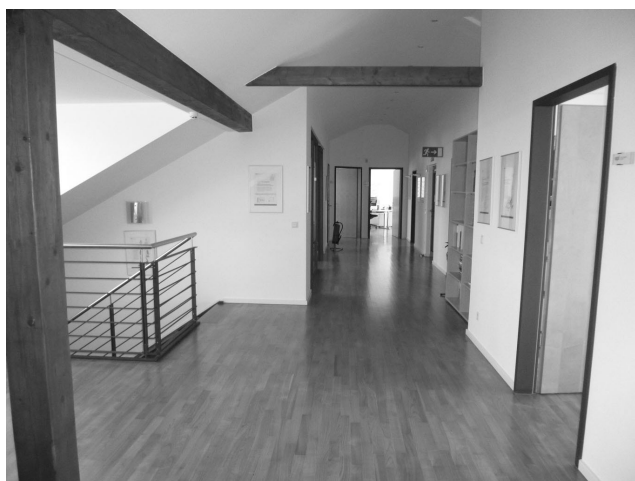
Please note, as of January 2015 we have relocated to new premises. However our street address has not changed only the floor location which is now on the fifth floor.

We are excited to announce that this relocation has allowed us more space especially including our meeting rooms which will be available for your convenience very soon.

Additionally please be aware that we no longer have the Post Office Box.

We are very much looking forward to your visit in our new office!

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Observations of the epi on Patents and Standards

This observation was sent by an official letter from the President of the epi, Mr Tony Tangena, to the European Commission, DG Enterprise and Industry, Unit A4 – Industrial Competitiveness Policy for Growth, Brussels, on 6th February, 2015

Respondent profile

This response is submitted on behalf of the Institute of Professional Representatives before the European Patent Office (epi), which is an international non-governmental public law corporation. The Institute came into existence pursuant to the European Patent Convention (EPC) upon provisions adopted by the Administrative Council of the European Patent Organisation.

At present, the Institute comprises more than 11 000 members from the 38 European countries contracting to the European Patent Convention. The members are both from industry and private practice and represent clients from all fields of technology and of all sizes, including start-up companies, single inventors, SMEs, and multinational corporations. Thus, epi members regularly act in their professional capacity on behalf of many contributors to open standards as well as standard users.

The epi headquarters are located in Munich, Germany.

At present, the Institute is not registered in the EU Transparency Register.

In the following, epi has elected to comment on a few of the key issues listed in the Consultation which it considers most relevant to its competence area.

Key issue 2: Rules and practices governing standardisation involving patents

Open standardisation carries many benefits for example in terms of interoperability, access for new entrants to the field, and increased consumer choice. In epi's view, when a standard relates to complex technology, it is both logical and desirable that inventive and patentable solutions are developed as a part of the standardisation process. These solutions constitute advances in technology that can provide significant added value to users of the standard.

Seeking a patent for such solutions is a way of obtaining, through out-licensing, a fair return on the investment in research and development that was required to invent them in the first place. Patent pools can sometimes be an option, and in special cases such pools may even work on a royalty-free basis if the parties can agree. However, such arrangements will not always be viable from a business perspective. If obtaining a return on innovation were excluded for standard essential patents, this would in many cases lead to a reduced incentive to continue investing in innovative contributions to the standard.

epi have no position on evaluation of a value of a Standard Essential Patent (SEP).

With this in mind, where SEPs are concerned a balance needs to be struck between the possibility for the patent holder to get a fair return on his innovation, and the possibility for a user to gain access to the standard. FRAND-based licensing provides one way of ensuring such a balance, and is a mechanism that should be kept.

One situation that raises concerns in the context of FRAND is that a Standard Setting Organisation (SSO) might unknowingly adopt a solution that later turns out to be patented by a non-SSO member, who is not bound by the associated FRAND licensing commitment. For this situation there are in principle two possible solutions. One solution is that the non-SSO member accepts FRAND, or even becomes an SSO-member. If that turns out to be unacceptable to the patent owner, then the solution is to remove the patented feature from the standard.

Further, it should be noted that the situation is different between SSOs in different fields. In all cases SSOs must adopt a patent policy to provide clarity.

Key issue 3: Patent transparency

The questionnaire defines transparency as comprising several factors, such as the existence of specific patents, their scope, ownership, validity, enforceability and essentiality. The comments below focus mainly on validity and scope.

With respect to patent validity, a definitive answer in any given case can ultimately only be given by a court. However, epi considers the quality of the grant procedure to be of key importance to the question of validity in general. A high-quality and reliable patent system produces strong patents with clear scope protecting truly innovative solutions, entitling the patent holder to fair compensation in return for a license.

In other words, a comprehensive search and examination procedure greatly increases the likelihood that the presumption of validity is in fact correct, should it be put to the test. A number of patent authorities, such as the European Patent Office, are already widely regarded as offering high-quality services. However, epi believes that a continued emphasis on patent quality is important. Furthermore, increased harmonisation, collaboration and work sharing between patent offices are measures that could further enhance quality and reliability, and hence improve patent transparency. A concrete example is the pilot project on collaborative search and examination between certain PCT offices, where promising results have been reported from the first two phases. Joint handling of an application by examiners from different offices increases the chance that relevant prior art is found, especially if the examiners have access to complementary documentation and perform their search in different languages. Another advantage of such collaboration is that it increases the chance that a patent is granted with similar scope in different jurisdic-

tions (or alternatively, rejected on similar grounds in those jurisdictions). This would contribute to a more uniform patent landscape, making it easier for prospective new entrants to assess the patent situation with respect to international standards.

In this respect it is also noted that the EPO search documentation databases include documentation, such as standard contribution papers, from certain SSOs (in particular ETSI). This contributes to a higher quality prior art search in those areas and similar projects should be encouraged and, where possible, expanded.

It is further noted that the towering backlogs and long time-to-grant which are currently seen in many patent offices reduce transparency, as the scope of protection is not fully clear to third parties until a final decision on an application is reached. This is also problematic against a background of global standards, as it could create international market distortions that may become trade issues.

Increased efficiency and/or additional resources for patent offices may alleviate this problem. One way of increasing efficiency without raising costs is by mandating reuse of work products between offices, for example within the scope of the existing Patent Prosecution Highway (PPH) program.

To reduce pendency times, PPH and other acceleration programs might be expanded. As a concrete measure to shorten the period of uncertainty with respect to the scope and potential validity of standard-related patents, patent treaties and agreements could be amended to require patent offices to expedite the processing of patent applications that have been declared to an SSO as standard essential.

Key issue 8: Protection for patent holders and injunctions

The right for a patentee to exclude others from using the patented solution is a cornerstone of the patent system, and one way of enforcing this right is by requesting an

injunction when a patent is infringed. However, standard essential patents are a special case, as excluding prospective users from the standard could reduce standardisation impact, and may also give rise to competition issues if done in a discriminatory manner.

FRAND-based IPR policies provide a solution where the patent holder undertakes to license standard essential patents under fair, reasonable, and non-discriminatory terms. However, in practice a user of the standard will have little incentive to enter into or honor a FRAND-based agreement if no negative consequences could ensue from “holding out” by delaying negotiations or refusing to pay royalties, which would outweigh the economic benefits of such behavior.

Hence, provided that the standard essential patents holder has attempted negotiations and offered a license under FRAND terms, seeking an injunction against an unwilling licensee cannot be considered as an abuse. On the contrary, a bar on injunctions against unwilling licensees would create an imbalance where the chances for holders of standard essential patents of getting any return on their innovative contributions to the standard would be severely limited.

On the other hand, a potential licensee who is objectively willing to conclude a FRAND-based licensing agreement should also have the possibility, if negotiations fail, to request a third party to determine the appropriate FRAND rate.

FRAND principles should be applied to promote the use of the standard by preventing unreasonable, unfair or discriminatory royalties, while at the same time enabling a fair return on innovation for the patent holder. Both parties should be required to act in good faith and without using delay tactics. However, if the parties cannot come to agreement on what constitutes a FRAND rate, this will ultimately have to be decided by a court

Representation and Human Rights

J. Boff (GB)

A libertarian leads off

The consultation on rights of audience before the UPC has revived a matter that has long bothered me. How are laws requiring compulsory representation, and prescribing who may provide legal representation, compatible with Articles 6 and 10 of the European Convention on Human Rights?

Article 6 (1) ECHR states that "**In the determination of his civil rights and obligations or of any criminal charge against him, everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law.**"

To me this would seem to imply a right of direct and unmediated access to the court so that you can be heard. Otherwise the very essence of the right (the right to be heard) could be compromised by the mouthpiece (legal representative) you are forced to use.

Further, if you only have freedom of choice among representatives approved by the State, you do not have freedom to choose someone with the qualifications **you** think appropriate rather than someone with the qualifications **the State** thinks appropriate.

I note that under Article 6 (3) (c) ECHR everyone charged with a criminal offence has the right "**to defend himself in person or through legal assistance of his own choosing**".

To me it seems inconceivable that a person might have significantly lesser rights in civil proceedings, particularly as this would offer an easy way for a state to avoid the provision by making all actions civil actions [witness the oppressive use of libel laws in some countries].

Now it is often said that the person who represents themselves has a fool for a client. On the contrary interpretation that Article 6 (3) (c) is specific to criminal cases, and states can apply lesser rights in civil cases, one reaches a conundrum. Why would one be allowed to be a fool when one's liberty is in question, but not when one's patent is in question?

Further it seems strange that the State (or Court) can impose limitations on the legal assistance that one chooses. Do you have a right to have **your** case heard if you are limited as to how, or through whom, you present it?

Article 10 provides for the right of freedom of expression and information and states that "*Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to **receive and impart information and ideas without interference by public authority** and regardless of frontiers.*". Although there are exceptions [e.g. "*for maintaining the authority and impartiality of the judiciary*"] these do not readily read on to presenting one's case before a court.

Limiting a person's right to represent themselves is necessarily interference by public authority in a person's right to "*receive and impart information and ideas*" in the way they want [as opposed to the way their representative wants].

Limiting a person's pool of potential representatives to those approved of by the State, is also interference by public authority in a person's right to "*receive and impart information and ideas*" in the way they want.

In short, judicial **convenience** is not a ground for abrogating a person's right to present their case in any way they choose through any representation they choose, no matter how foolish that choice.

Further, Article 17(2) of the Charter of Fundamental Rights of the European Union states that "*Intellectual property shall be protected*".

Article 47 of the Charter states that "*Everyone shall have the **possibility** of being advised, defended and represented*". Thus in defending the fundamental right to protection of intellectual property it should not be **mandatory** to be represented.

Article 48 of the UPC Agreement requires that parties be represented by lawyers, or by European Patent Attorneys with appropriate qualifications such as a European Patent Litigation Certificate. The only exception is in challenging actions concerning decisions of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012 (scarcely likely to be very common).

It appears that there is a conflict between the UPC Agreement requirement for mandatory representation, and the freedoms given by both the ECHR and EU law.

Revocations by the Board of Appeal – statistics and analysis

M. Nollen (NL)¹

1. Introduction

Deliberately, the European Patent Convention (EPC) was designed to have opposition proceedings after grant. The reason was to ensure that the granting of a European patent would not be delayed endlessly, and the patent proprietor should wait in the meanwhile for the grant.² This “early grant” entails the risk that invalid patents are granted. The profound technical knowledge of examiners³ is to be a guarantee that the examination is sufficiently strict and that the percentage of unjustified granted patents is kept at a minimum, so as to set a gold standard for examination. Furthermore, the patent attorneys are tested in the EQE on their procedural knowledge and basic skills in claim drafting, prosecution and opposition.

The EPO refers in its annual reports to the low and constant rate of oppositions, between 4 and 5%⁴, which could imply that this is an indicator of high quality. However, this rate is dependent on much more factors than the examination quality. First, the grant of a patent does not at all imply that the protected invention is commercially valuable. Secondly, the filing of an opposition provides the proprietor with commercially relevant (and new) information, i. e. that he holds an important patent that the opponent likely infringes now or in future. This indicator function seems one of the reasons for the very low numbers of oppositions in physics and electricity. Thirdly, the opposition rate varies significantly over the technical fields.⁵

The practice of opposition proceedings indicates deviation from the gold standard. In opposition, 31 % of the patents is maintained as granted, while 40 % is upheld in amended form and 29 % is revoked.⁶ But after appeal, the percentage of patents that are maintained as granted is reduced to 13 %, whereas the total revocation rate is more than 52 %. The remaining 35 % is main-

tained in amended form.⁷ The revocation rate in appeal is particularly large. In 2013, one in four decisions (25 %) of the Boards was such a revocation “at appeal level only”.⁸

This high revocation rate at appeal level is a problem, both from the perspective of the proprietor and of a third party interested in the patent. A revocation at appeal level occurs between 8 and 15 years after filing⁹ the application. It is hard to explain to a patent proprietor with a genuine invention, that his patent is revoked in its entirety so long after the filing and long after grant. The explanation to the public is equally hard (or even harder): how to justify that so many patent proprietors have had a privilege of a patent protected monopoly for a patent that turns out to be invalid?

Four potential reasons for the high revocation rate are:

- (a) The proprietor – or his representative – made mistakes or did not see, how to maintain the patent;
- (b) The opposition division should have revoked the patent, because it was inherently weak;
- (c) The opponent presented new evidence and/or new arguments at the appeal stage, and/or the proprietor presented new requests that changed the case;
- (d) The boards of appeal are unreasonably strict.

This article provides an overview and analysis of the revocations at appeal level¹⁰ only, and will discuss whether those potential reasons appear true. The article is based on a review of the 175 revocation decisions of the Board¹¹ published in 2014¹² (20 % of the total), and further related statistical data.

7 O. Randl, K’s blog, „Looking back on 2012 (part 2)”, 25 May 2013, <http://k-slaw.blogspot.be/2013/05/looking-back-on-2012-part-2.html>. Please note that these percentages relate to decisions in the opposition appeal proceedings. The 2013 EPO annual report mentions 2176 decisions in opposition in 2013. 1315 appeals are filed in opposition appeal (60 %), and 1124 opposition appeals are settled. 747 decisions were given and 377 appeals were settled otherwise. Hence, the number of decisions in opposition appeal is about one third of the decisions in opposition.

8 M. Müller & C. Mulder, reader *epi*/EPO seminar „Opposition & Appeal”, Eindhoven 21-11-2014. These data will also be part of the forthcoming book of these authors, *Proceedings before the European Patent Office, a practical guide to success in Opposition and Appeal* (Cheltenham UK: Edward Elgar, 2015), pages 96–102.

9 Based on quick review of the application numbers (indicating filing year) of the 2014 decisions in appeal to revoke a patent.

10 To be clear: the term „revocation at appeal level” is used for a decision of the Boards of Appeal in opposition proceedings, wherein the decision of the Opposition Division (to maintain the patent in some form) is set aside and the patent is revoked.

11 Here and in the following, the ‘Board’ refers to the Technical Boards of Appeal. Ex parte appeals (examination) are left outside consideration, also if this is not mentioned explicitly.

12 Year of publication at the website of the EPO. No other sources of information were used for the analysis. Use has been made of keywords searches in French, English and German. The search was further limited by advanced search options of 2014, selected boards (mechanics/chemistry/physics/electricity), and T-decision. The keywords were „opposition”, „is set aside” and „is revoked” in English, „Einspruch”, „wird aufgehoben”, „wird

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2 Singer/Stauder (eds.), *Europäisches Patentübereinkommen* (2. Auflage, 2000), page 451–452.

3 The EPO hires examiners with the message: „Are you an engineer or scientist interested in joining an international team at the forefront of technology?” According to the EPO, „[t]he job of a European patent examiner demands a unique combination of scientific expertise, analytical thinking, language skills and an interest in intellectual property law. <http://www.epo.org/about-us/jobs/examiners/profile.html>.

4 Annual report of the EPO, 2013, section “Searches, examinations, oppositions”, opposition rate in 2012 was 4.7 % and in 2013 4.5 %.

5 G Scellato et al., *Study on the quality of the patent system in Europe*, March 2011, there in Table 35, page 67–68, available at http://ec.europa.eu/internal_market/indprop/docs/patent/patqual02032011_en.pdf

6 Annual report of the EPO2013

2. The overall statistics

2.1 year-to-year comparison

The overall statistics for opposition appeal (OA) proceedings in 2012–2014 are presented in Table 1.

Year ¹³	No of decisions in opposition appeal (OA)	No with outcome: "OD ¹⁴ decision is set aside"	No with outcome: „OD decision is set aside and patent is revoked"
2012	723	424 (59 %)	187 (26 %)
2013	722	391 (54 %)	176 (24 %)
2014	895	481 (54 %)	175 (20 %)

Table 1 – overall statistics in opposition appeal in 2012–2014¹⁵

The table shows a positive trend, in that the revocation rate at appeal level is reduced from 2012 to 2014. The percentage of decisions that are overturned remains the same, and the number of decisions has strongly increased. This increase seems exaggerated and may partially be due to the data set as used (i. e. based on publication date of the decision). A comparison with other data reported elsewhere was made to test the reliability. The number of decisions for 2012 and 2013 turned out slightly lower than reported elsewhere¹⁶. The percentages of decisions set aside and revoked at appeal level are well in agreement with data reported elsewhere.¹⁷

Table 2 indicates the duration of the OA proceedings, for the 175 cases resulting in revocation in 2014.¹⁸ The average duration is about three and a half years, up to publication of the decision on the EPO website. In about 10 % of the cases, the appeal proceedings took five years or more.¹⁹

Year in which appeal was filed	No	%
2008 or earlier	12	7 %
2009	21	12 %
2010	65	37 %
2011	43	25 %
2012	29	16 %
2013	5	3 %

Table 2 – duration of opposition appeal (OA) proceedings, for the cases in which the decision to revoke the patent was published in 2014.

widerrufen" in German, and „opposition" „est annulée" „est révoqué". These are the key terms in the revocation decisions of the Boards.

13 This is the year of publication of the decision on the EPO website. This publication date (rather than the date of the decision) is offered by the EPO website as a search tool.

14 OD = Opposition Division

15 For sake of completeness: the other possible outcomes are dismissal of the appeal, rejection of the appeal as inadmissible and termination of the appeal.

16 According to the annual reports of the EPO, 750 decisions were taken in opposition appeal proceedings in 2012 and 2013, rather than 720. This difference seems to indicate a delay in publication. It was seen that the decision date in the register for some of the revocations published in 2014 was years earlier. A specific example was T36/95, with a decision date in 1999. This decision was excluded from the statistics.

17 Mulder & Müller mention a revocation rate in 2013 of 25.6 % rather than 24 %. This corresponds to 192 revocations out of 749 decisions in total. The rate of setting aside a decision was 57 % (426 decisions) rather than 54 %.

18 The filing year is indicated in the case number. For sake of simplicity, the phrases „2014 decision", „revocation in 2014" are used hereinafter, but it actually refers to the decisions with a publication date in 2014.

19 Many of the 21 appeals filed in 2009 (such as T2370/09) were filed in late 2009. Since the publication date of their decision was anytime in 2014, the duration up to publication is often less than five years.

2.2 Distribution over the Boards

The distribution of the OA decisions over the Boards is shown in Table 3. Most decisions are taken by the Boards in Mechanics and Chemistry (each 45 % of the total). A single board in Mechanics has thus taken on average 47 decisions in opposition appeal, and in Chemistry 40. The total number of such decisions in Physics (3 Boards) and Electricity (5 Boards) is roughly the same as that of a single Board in mechanics. In view thereof, physics and electricity are hereinafter dealt with as a single category²⁰.

Board	No of Boards	Field	No of decisions in OA	No with outcome: „OD decision is set aside"	No with outcome: „OD decision is set aside and patent is revoked"
3.2	8	Mechanics	379	198 (52 %)	68 (34 %) ²¹
3.3	10	Chemistry	397	222 (56 %)	88 (40 %)
3.4	3	Physics	46	28 (61 %)	4 (14 %)
3.5	5	Electricity	53	33 (62 %)	15 (45 %)

Table 3 – distribution of the 2014 decisions in OA proceedings over the Boards

Roughly 55 % of the decisions of the Opposition Division is set aside, regardless of the technical field. The revocation rate appears to vary more between the technical fields. This variation in revocation rate is much stronger at the level of the individual Boards.

The "top 6" in revocation is shown in Table 4. The six Boards listed in Table 4 are responsible for nearly 50 % of the revocations at appeal level in 2014. All of them have taken more than 45 decisions in opposition appeal, i. e. at least one per week. Together, they are responsible for 38 % of the decisions in OA proceedings. In short, these Boards, which are more than average productive and/or more active in OA proceedings, have a more than average revocation rate.

Board	Technical area ²²	No of decisions in OA	No with outcome: „OD decision is set aside and patent is revoked"
3.2.07	Performing operations & metallurgy	57	21 ²³
3.3.07	Dentistry, cosmetics	48	14
3.3.01	Pharma	45	14
3.2.04	Engines	50	13
3.2.06	Equipment and other	79	12
3.3.09	Various	58	12

Table 4 – Top 6 of Boards w.r.t. revocation of patents at appeal level in 2014.

20 I observe that the number of revocations on appeal level in physics and electricity after combination (19) is actually too small for reliable statistics.

21 The % indicates the percentage relative to the corresponding „OD decision set aside", i. e. 68/198

22 The EPO identifies the technical areas of the Boards by means of IPC classifications, with one Board being active in various IPC classes or IPC subclasses. The specified technical area is a rough summary of the author

23 Percentages are here not given, because the correct comparison is with the number of „OD decision set aside".

Three of the six Boards are in mechanics, the three other in chemistry. Within the chemistry area, the fields of pharma and cosmetics are present. These are highly competitive areas, wherein a patent typically identifies a real monopoly with high value. The higher revocation rate may indicate that the opponents put more effort into the proceedings, for instance by means of the submission of additional evidence. Within mechanics, no clear technical or business background is apparent for the high rate of revocations, other than that Board 3.2.07 appears to work close to the chemistry field.

3. Non-admission of late filed requests

As stated in the Rules of Procedure of the Boards of Appeal, parties should set out their case in the grounds of appeal or the response thereto²⁴. This also applies to auxiliary requests, which thereafter will be considered at the Board's discretion²⁵. The Boards' intention is to ensure that proceedings are fair and that parties do not have a chance to use tactics to surprise the Boards and the other party²⁶.

3.1 Late filing of requests

Analysis of the decisions clearly signals that late filing of auxiliary requests remains a major issue. Admission after late filing is a topic in nearly 50 % of the decisions resulting in revocations at appeal level, as shown in Table 5. Typically, in 62 % of the cases, none of the late-filed requests is admitted into the proceedings. In 18 % of the cases, some of the late filed requests are admitted, while some are not. And only in 20 % of the cases, the late-filed request(s) are admitted into the proceedings.

Filing and admittance of Auxiliary Requests (AR)	No	% of revocations in appeal	% of decisions with late filed AR
Revocation decisions in which no AR was late filed	86	52 %	–
Revocation decisions with one or more late filed AR	79	48 %	–
No late filed requests admitted	49	28 %	62 %
Some admitted and some not	14	8 %	18 %
All late filed requests admitted	16	10 %	20 %
Submission of AR during Oral Proceedings	20	12 %	25 %
No substantiation for late-filed requests	3	2 %	4 %

Table 5 – late filed requests and admission for the 175 revocations at appeal level

24 Art. 12 (2) of these Rules (RPBA) reads: „The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on".
 25 Art. 12 (4), 13 (1) and 13 (3) RPBA. Art. 13 (3) relates to submissions after summons to Oral Proceedings have been sent out. It is most strict and the practical implementation is prima facie allowability. See for instance T2164/10, T1713/10, T1247/11.
 26 See f.i. headnote of T1732/10: *Not reacting in substance to the appeal of the opponent, but waiting for the Board's preliminary opinion before any substantive reaction is filed, is regarded as an abuse of procedure. It is contrary to the equal distribution of rights and obligations upon both sides in inter-partes proceedings and to the principle that both sides should set out their complete case at the outset of the proceedings. (...)*

It is easily alleged that the Boards would be too strict, but the data seem to indicate otherwise. In fact, in 25 % of the cases, the late-filed requests were filed during Oral Proceedings before the Board of Appeal. This is on average 3.5 years after the filing of the appeal (see Table 2), which constitutes second instance proceedings. That is very late, and it cannot be a surprise that the Boards object to this practice. In three cases, the Boards refused the admission of all requests, including the main request. This unfortunate situation for the patentee was due to lacking substantiation of the requests.²⁷

3.2 Number of requests and effect of non-admission

It is highly probable that the non-admission of late filed requests results in more revocations. However, the number of requests on file is in many cases rather low, and lower than expected. In 13 % of the cases, no auxiliary request has been submitted at all. In 16 % of the cases, only 1 auxiliary request was submitted. The statistics indicate that such low number of requests occurs less frequently in chemistry than in mechanics, physics or electricity.

No of Auxiliary Requests (AR) submitted	No	%	Mechanics	Chemistry	Physics + Electricity
Total number	175		68	88	19
No Main Request ²⁸	11	6 %			
0 AR	23	13 %	19 %	7 %	28 %
1 AR	28	16 %	13 %	18 %	28 %
2 AR	23	13 %	16 %	9 %	17 %
3 AR	23	13 %	17 %	14 %	5 %
4 or more AR	67	39 %	35 %	52 %	22 %

Table 6 – number of admitted auxiliary requests for the revocations at the appeal level in 2014²⁹

The effect of the non-admission of late-filed requests is clear from Table 7. This Table shows the number of auxiliary requests that are admitted into the proceedings. In half of the cases, this number is less than two³⁰. Where late-filing was an issue, this percentage is as high as 62 %.

27 See T1732/10 headnote: "(...) This [abuse of proceedings] is all the more so if the substantiation for all the requests, which were filed after summons to oral proceedings have been sent, is filed only shortly before the oral proceedings before the Board. Such requests – which are not self-explanatory – are considered by the Board as submitted only on the date of their substantiation (...)."
 28 These are decisions in which the appeal is terminated or wherein the decision merely states "no request on file". They are in the following left outside consideration for the statistics
 29 Please note that the underlying numbers of decisions are (relatively) low, so that the percentages are indicative only.
 30 I.e. main request and 1 auxiliary request; only a main request; and no main request

No ARs remaining after non-admittance	No	%	No in cases without late filing	No in cases with late-filing
No main request	3	2 %	0	3
0 AR	45	28 %	21	24
1 AR	34	20 %	20	14
2 AR	17	10 %	12	5
3 AR	20	12 %	11	9
4 or more AR	45	28 %	34	11

Table 7 – number of admitted auxiliary requests for the revocations at the appeal level in 2014

3.3 Some individual decisions

Several decisions point out that the proprietor should not wait for the Boards' preliminary opinion, but set out his case himself³¹. This includes the submission of auxiliary requests for the event that the Board would decide differently than the proprietor hopes or expects. In T1150/09, the Board made explicit that the proprietor's expectation that board will follow him is no reason for not filing any auxiliary request. The late-filed auxiliary request was not admitted and the patent was revoked. Similar situations occurred in T945/10 and in T210/12, and also in explicit terms in T1674/12 (reason 4.1–4.3, French language).

The Boards particularly object to late filing in cases, wherein the opponent made an argument consistently through the appeal proceedings. One example is T1647/10 where the first auxiliary request was admitted, since the argument had only been put forward during oral proceedings, and the proprietor should be given a chance for response. The second auxiliary request was however a response to an argument discussed in the written proceedings and could have been filed earlier. It was therefore not admitted.

A reason for late-filing is however not sufficient for its admission. The late-filed request should further be prima facie allowable, not only when filed during Oral Proceedings, but also when filed one month in advance thereof, as indicated in T1713/10. An auxiliary request corresponding to the claims upheld by the Opposition Division is not prima facie allowable, when re-submitting during Oral Proceedings, as decided in T945/10. Furthermore, the requests should be converging and should clearly specify what the proprietor sees as his case and ultimately desires to have protected. Examples of non-convergence and resulting non-admission are given in T1134/11 and T926/10.

4. Reasons for revocation

Table 8 provides an overview of the reasons for revocation, in the set of 175 decisions of 2014. The most frequently occurring reason for revocation is inventive step, which is not a surprise. The second most important reason is added matter. In chemistry, sufficiency is the third reason, but in mechanics this is novelty. Added matter appears a bigger issue in mechanics than in

chemistry, although the statistics are not based on very big numbers. This higher occurrence in mechanics is not a real surprise, as patenting in mechanics is an art of finding words for construction and processes that inventors tend to present primarily in drawings. That seems more delicate than the generalisation of examples into ranges and formula, that is typical for chemistry.

	Total	Mechanics	Chemistry	Physics + Electricity
Added matter	38 (19%)	20 (25%)	17 (17%)	1 (4%)
Extension of scope	3 (1%)	0	3 (3%)	0
Prohibition of reformation in peius	7 (3%)	4 (5%)	3 (3%)	0
Clarity	9 (4%)	2 (3%)	6 (6%)	1 (4%)
Sufficiency	14 (7%)	3 (4%)	10 (10%)	1 (4%)
Novelty	26 (13%)	13 (16%)	9 (9%)	4 (18%)
Inventive step	105 (52%)	37 (47%)	52 (51%)	16 (70%)
Industrial application	1 (1%)	0	1 (1%)	0
TOTAL	203	79	101	23

Table 8 – reasons for revocation in the revocations at appeal level in 2014³²

4.1 Denial of inventive step

The reasons for denial of inventive step are different in chemistry than in mechanics. In chemistry, the most common reason (50% of the cases) is that the problem is not solved, as a result of which the problem is reformulated to the provision of an alternative. The solution of this less ambitious problem is then considered obvious by the Board. This logic has been explained before by G. Raths, chairman of Board 3.3.06, in *epi-Information*.³³

Outside chemistry, the most common reason is plain obviousness. T2405/11 refers to an obvious variation. T1574/11 states that the choice of a specific known sensor for a known purpose without overcoming a prejudice and without inventive effect is obvious. In T661/09, the claim merely defined desiderata in the view of the Board, rather than a way to obtain these desiderata. In T582/12, the benefit of the distinguishing feature was clear, so that the implementation did not require inventive skill.

Not merely the problem or its solution is relevant, but also the disclosure in the closest prior art, and the scope of claim 1. The Board's interpretation is regularly broader than that of the proprietor. As a consequence, the skilled person then arrives without inventive skill at the claimed subject matter – see for instance T405/13, T672/12 and T1788/10. In some situations, the subject matter is not even novel – T1650/12, T176/11.

Overall, the Boards seem to 'deconstruct' many alleged problems and advantages. The Board do not follow the proprietor that there would be a special effect or a very demanding situation for the skilled person, and

31 Most explicitly in T1732/10, cited above.

32 note that a single decision can mention more than one reason. As a result, the total number of reasons is bigger than the total number of revocations.

33 G. Raths, "Methodology for structuring the assessment of inventive step", *Epi-information*, 2/14, page 68–76.

deny a monopoly. A large number of auxiliary requests then does not help: in T1836/11, T1643/12 and T365/11 all 7 or more requests on file were found to lack inventive step³⁴.

4.2 Changes between the opposition and the appeal?

Even though the Boards emphasize that they are a second instance body with the task to review the first instance proceedings³⁵, most decisions do not discuss the decision of the opposition division explicitly. Rather, they provide their independent judgement starting from the facts of the case. Moreover, the decisions do not facilitate to review quickly, whether the facts and the requests in appeal are identical to those in appealed opposition.

Notwithstanding, the situation is clear in 25–30 % of the cases, as shown in Table 9. Sometimes, the framework in appeal is clearly different. This occurs when new and highly relevant evidence is submitted and admitted into the appeal proceedings. Such evidence most often leads to revocation. This not only involves lack of novelty, but also lack of inventive step. In T427/11, late filed document E20 was admitted and seen as a pointer to the invention.

	nr	%
No of cases wherein admission of new documents/evidence is discussed	24	15 %
Explicit discussion of decision of the OD by the Board	19	12 %

Table 9 – specific reasons for the changed decision at appeal level

In other cases, the framework has not changed and the Board presents some observations on the decision of the Opposition Division. This is often another interpretation of a document or feature (T2111/08, T786/11, T672/12), sometimes a more critical view (T1686/10, T425/11, T532/11), but sometimes strong criticism (T427/11, T881/11).

5. Conclusions

An analysis has been made of the 175 decisions of the Boards of Appeal in 2014, wherein the Boards set aside the decision of the opposition division and revoked the patent. Although the revocation rate in 2014 is somewhat lower than in 2012 and 2013, it is still very high. Four potential reasons were indicated as possible explanations of the high revocation rate: (1) the conduct of opposition appeal proceedings by the proprietor or its representative; (2) errors by the opposition division; (3) a change in the legal and/or factual framework; (4) a too strict approach of the Boards of Appeal.

Reason 1: conduct of opposition appeal proceedings

The proprietor’s way of conducting opposition appeal proceedings seems open for improvement. Auxiliary requests are frequently late-filed and not admitted. Late filing of auxiliary requests is discussed in nearly 50 % of all the reviewed decisions. Typically, the late-filed request is not allowed for reasons that appear reasonable, taking into account the *inter partes* character of opposition (appeal) proceedings and the Rules of Procedure of the Boards of Appeal. Many decisions are based on zero or merely one auxiliary request. In 20 % of the cases, 0 or 1 auxiliary request was submitted. In 50 % of the cases, 0 or 1 auxiliary request remained as a consequence of non-admission of late filed requests.

It is observed, that these high numbers are likely not representative of all opposition appeals, since merely revocations were studied. However, it has been written down in several cases that the patent was revoked in the absence of an allowable request. In other words, the board saw an invention, which was however not specified in one of the admitted requests.

Reasons 2 & 3: errors by the Opposition Division and change in facts

The most frequent reason for revocation is inventive step, following by added matter. The denial of inventive step is often based on a deconstruction of the alleged advantages. The Board then arrives at the view that the problem is not solved and is to be reformulated into the provision of an alternative, or that the solution does not require inventive skill. The Boards regularly adopt a broader view on a document than the parties (or the opposition division), bringing the solution very close to the known subject matter.

The Boards criticize the opposition division explicitly in about 10 % of the cases. However, they more often disagree. Particularly, the Boards did regularly not accept the inventive step argument of the proprietor, which the opposition division apparently had accepted. In many cases, the Board’s language is quite clear, so that the question turns up why the opposition division had not seen this. In 15 % of the cases, the Boards decide after admission of new evidence that changes the case.³⁶

Reason 4: strict, but not too strict or unreasonable approach by Boards

The present analysis does not provide any indication to believe that the Boards are too strict. The reasons underlying the decisions are quite consistent and indicate that the Boards fulfil their function in an adequate manner. While the Boards’ approach is strict, it is not unreasonably strict, and should not be unexpected.³⁷

34 I observe that the cited three decisions relate to Mechanics, Chemistry and Electricity. This logic is thus not broadly applied.

35 See art 12 (4) RPBA, and various case law, shortly summarized in T1732/10, page 11.

36 In several cases, the framework changed, because the proprietor filed new requests, so that the main requests (and/or auxiliary requests) was no longer identical to that in opposition). However, this was not investigated explicitly.

37 Many thanks to Cees Mulder (University of Maastricht) for comments on an earlier version of the manuscript.

Zusammenfassung

Dieser Beitrag handelt über die hohe Rate, in der Patente, gegen die Einspruch eingelegt worden ist, erst durch die Beschwerdekammer widerrufen werden. 20 % der Entscheidungen der Beschwerdekammer zu Einsprüchen 2014, endeten mit einer derartigen Widerrufung. Die Analyse der 175 Widerrufungen zeigt, daß die Zulassung der spät eingereichten Hilfsanträge in 50 % der Fälle ein Thema war, und meistens verneint wurde. Dies führte dazu, daß der Patentinhaber in der Hälfte der Fälle sein Patent bloß mit höchstens einem Hilfsantrag verteidigte. Die Analyse zeigte außerdem, daß erfinderische Tätigkeit am häufigsten der Grund für die Widerrufung ist. Die beanspruchte Materie wird nicht als erfinderisch angesehen, weil das Problem nicht gelöst ist oder die Lösung naheliegend ist. In etwa 10 Prozent wird Kritik an der Einspruchsabteilung geäußert. In etwa

15 Prozent wurden Dokumente eingereicht und zugelassen, welche die Grundlage für die Entscheidung änderten.

Résumé

Cette contribution présente une analyse des décisions des Chambres de Recours de 2014, et plus précisément, des 175 décisions de révocation prises par les Chambres (20 %), bien que le brevet ait été maintenu par la division d'opposition – sous forme modifiée ou non. L'analyse montre que les règles des Chambres concernant l'admission de documents et requêtes soumis tardivement ne sont pas suivies dans la moitié des cas. Par conséquent, le nombre des requêtes subsidiaires admises dans la procédure est faible. En outre, souvent les Chambres ne reconnaissent pas le caractère inventif que la division d'opposition avait affirmé.

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
2/2015	8 May, 2015	30 June, 2015
3/2015	7 August, 2015	30 September, 2015
4/2015	6 November, 2015	31 December, 2015

The Doctrine of Partial and Multiple Priorities, especially from the standpoint of Toxic Priority

M. Lawrence, (GB), European Patent Attorney

"It's never as simple as it seems at the beginning, or as hopeless as it seems in the middle...or as finished as it seems at the end."

0. Introduction & Overview

0.1 Priority is a fundamental issue for IP practitioners. Its importance is marked by case law of the Enlarged Board of Appeal (EBA) in mid-1994 (G0003/93) and mid-2001 (G0002/98) and by a greater number of lower board decisions spanning longer. But this doesn't stand priority out much from the crowd: it might be seen as normal background noise, with one or two louder highlights, to be expected following the reforms of the 1970's.

0.2 Self-publication has always been the most dangerous form of anticipation risk – who else is more likely to be in a position to disclose the precise subject-matter on which an innovator is working than the innovator himself. The good news is it can be controlled – policy and process can anticipate what can go wrong and ensure it doesn't happen unacceptably often. Toxic Priority¹ is self-publication without the good news. Its existence was unrealised and so beyond control. Once realised, implementation of its management required a lot of thought and much delay. There was also historic toxicity requiring consideration. Toxic Priority therefore received a lot of concerned "*public*" attention, which explains why, in a paper about the wider topic of partial/multiple priorities, centre stage is occupied by that sub-topic and solutions for it.

0.3 A recap and overview may be helpful, particularly with readers outside EPC in mind:–

- So-called *whole contents* anticipation occurs in EPO proceedings if a claim in patent/application A encompasses subject-matter disclosed in patent/application B and the priority date of the claimed matter in A falls between the publication and priority dates of the cited matter in B.
- The citation has no effect unless published but the effect is as of the cited subject-matter's priority date.

- The two patents/applications may be members of a divided family or priority group, in which case priority is said to be "*toxic*".
- Toxicity may occur eg when a claim is broadened on parent filing relative to the priority document and the parent later divided; the broadening results in the parent claim losing priority whilst the division produces a specification some content of which retains priority and falls within the parent claim as an anticipation (T1496/11). The toxicity may be worse when a claim is narrowed by inclusion of features not disclosed in the priority document.
- In the case of a divided family, the citation is any published family member, as in the example just given. In the case of a priority group, it is a published priority document.
- The root of the problem resides in the priority system on which EPC relies. The solution is in the same place².
- Priority-based solutions rely on a less than wholly clear set of precedents on assessment of partial/multiple priority date entitlement. However, recent case law sets out a convincing new approach. If adopted as the rule, this provides a helpful framework for addressing Toxic Priority although, as explained in this paper, it is not a solution for every instance.

Radical changes in legal landscape – new legislation or EBA opinion – have been suggested. These offer no speedy assistance, are unlikely to be retroactive, depending on reach are arguably unnecessary³ and could be retrograde (eg special treatment of divided families/priority groups, creating tiers of proprietor and risk of abuse).

1. FICPI Memorandum to T1222/11

1.1 FICPI Memorandum

1.1.1 The FICPI Memorandum⁴ summarizes the 1973 position of the contracting states. It sets out the strategic proposition that "OR" claims should conditionally be entitled to enjoy⁵ plural priority dates reflecting different subject-matters⁶. The individual *domains* would fall to be tested against prior art individually based on their priority dates and subject-matter content.

2 Disclaimers (not covered here) may also prove useful

3 The front line question of how partial and multiple priority date entitlement should be assessed is, to the contrary, highly desirable

4 *Memorandum M/48/II, Section C, Préparatoires Travaux EPC1973* (<http://tinyurl.com/oaey9ry>)

5 The FICPI Memorandum is the antecedent of Article 88 (2) EPC and both are about *claiming* priority. Article 88 (3) EPC is about what subject-matter will *enjoy* the priority right claimed. As the FICPI Memorandum continues, its direction changes towards *enjoyment* of priority rights

6 FICPI Memorandum, Section I, page 1 (opening paragraph in particular) and page 2 (central part dealing with "OR" claims)

1 Submitted October 2014, re-submitted February 2015

See the following 2010 and 2011 papers and EPO Appeal Decision T1496/11 :-

(1) "*Poisonous EPC Divisionals (Just as you thought it was safe ...)*", Malcolm Lawrence, *Inventive Steps*, Issue No 2, HLBBSHaw, December 2010 [<http://tinyurl.com/krlgwt5>]

(2) "*Poisonous EPC Divisionals – Implications for Risk Management and Opportunistic Advantage*", Malcolm Lawrence & Marc Wilkinson, *Journal of the European Patent Institute (EPI Information)*, Volume 2/11, June 2011, 54–61 [<http://tinyurl.com/luan2s4>]

1.1.2 The rationale for the proposition⁷ is that proper enjoyment of priority rights requires statutory permission for plural priorities for a single claim to avoid to the less desirable use by patentees of claim multiplicities to maximize priority opportunities.^{8,9}

1.1.3 The memorandum gives separate visibility to “*partial priority*” (where a domain of the claim is disclosed in a priority document but the remainder of the claim scope is not) and “*multiple priorities*” (where basis for different domains is supplied by respective priority documents). However, the memorandum¹⁰ seems clear they should receive the same treatment¹¹.

1.1.4 In addition to introducing the broad idea of partitioning claims into domains, the FICPI Memorandum makes specifically clear that some claims should be partitioned into *virtual* domains across broadly defined integers.¹²

1.1.5 Examples (a), (b) and (c) of the memorandum contain useful illustrations. They are properly referred to by others (eg T1222/11). But it isn’t necessary to drill through the memorandum’s strategic sweep into this supporting detail to discern the strategic legislative intent of Article 88(2) EPC. There’s a tendency to attach too much weight to the FICPI Examples (eg see both the opposed positions in Pearce & Fulconis¹³).

1.2 Article 88 (2) EPC

1.2.1 The FICPI Memorandum concludes by proposing language providing for multiple priorities in EPC. This language was adopted largely unchanged in EPC:

FICPI proposal: “... *Where appropriate, multiple priorities can be claimed for one and the same claim of the European patent*”

Article 88(2) EPC: “... *Where appropriate, multiple priorities may be claimed for any one claim. Where ...*”

1.2.2 The FICPI Memorandum makes a separate proposal for “*partial priority*”, not taken up in EPC. In the context, the EP filing itself supplies the priority date for

subject-matter not disclosed in a priority document. EPO appeal board opinion is that partial priority needs no legislative platform beyond Article 88(2),(3) EPC¹⁴.

1.2.3 Making assignment of priority dates to parts of claims subject to the qualifying phrase: “*Where appropriate ...*” was motivated by perception that multiple priorities for “*AND*” claims needed to be excluded¹⁵. However, the wording agreed by member states is self-evidently more general; it’s clear that the wider scope was intended by the contracting states, precise implementation to be left to EPO tribunals.

1.3 Interaction of EPC with the Paris Convention (“PC”)

1.3.1 EPC is a “*special agreement*” under Article 19 PC. The latter provides that such agreements are subject to the proviso that they “*do not contravene the provisions of*” PC. The position of EPO appeal boards has always been that EPC complies with this proviso.

1.3.2 But it may be wondered how Article 88 (2) EPC complies with Article 4B PC, which provides priority-claiming applications with what at a glance is general immunity from acts during the priority interval:–

“... *any subsequent filing ... before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention ...*”

1.3.3 The generally stated objective in Article 4B PC must be interpreted having regard to other provisions of PC, which make clear that there are circumstances where priority may be prejudiced:

- Article 4H PC qualifies Article 4B PC and provides, according to G0002/98, Reason 4, that priority for a claim can be refused “... *if the subject-matter of the claim ... “is not” ... specifically disclosed ... in the application documents relating to the disclosure ... of the application whose priority is claimed*” – for example, by the claim encompassing an embodiment not disclosed in the priority document.
- Article 88 EPC (construed per G0002/98) disapplies priority only in more restricted circumstances than permitted by Article 4H PC (ie only when the situation is, to paraphrase Article 88 (2) EPC, not one “*Where (it is) appropriate*”). This makes Article 88 (2) EPC compliant with Article 4H PC and thus, indirectly, with Article 4B PC.

1.3.5 Seen at the highest level, of course, treaties on the scale of EPC tend to have lives of their own and function with a degree of prepossession; appeal boards have always been firm that EPC contains “*a complete self-contained code of rules of law on the subject of claiming priority*” (G0002/098; J0015/80; T02473/12).

7 The memorandum builds the proposition in the series of paragraphs commencing with that bridging pages 1 and 2

8 Plural priorities for a single claim and claim multiplicities are doubtfully perfect equivalents: it would be a rather idealised claim multiplicity which achieved entirely what the flexibility of permitting plural priority dates for one and the same claim can achieve, even taking account of restrictions imposed on the latter by the “*limited number*” test of G0002/98, Reason 6.7. Depending on when such a claim multiplicity is added to a specification, one might also expect sizeable challenges in terms of new subject-matter objections (Article 123(2) EPC)

9 The key paragraph bridges pages 3 and 4; claim multiplicities are described as “*frivolous*”

10 FICPI Memorandum, page 6, second sentence

11 Reason 11.6 of T1222/11 also makes clear that “*partial priority*” and “*multiple priorities*” are to be treated in principle in the same way. The EPO Guidelines for Examination (in both the September 2013 and November 2014 versions) are curiously silent on the concept of “*partial priority*”, but this is no doubt because no procedural matter turns on it and because the interaction of priority and the state of the art can be exemplified without reference to it

12 FICPI Memorandum, page 2, second paragraph following central panel, expressly stating that “*it is, of course, immaterial whether the word ‘or’ actually occurs in the claim*”

13 “*Opposing Views on Partial Priority*”, David Pearce and Renaud Fulconis, Journal of the UK Chartered Institute of Patent Attorneys (CIPA Journal), Volume 42, No 12 (December 2013), 716–720

14 According to Reason 11.6 of T1222/11, assessment of priority is no different whether there is a single or multiple priority dates claimed

15 FICPI Memorandum, page 5, second paragraph and central panel

1.4 G0002/98 and T1127/00 vs T1222/11

1.4.1 G0002/98 interprets the imprecise language of Article 88(2) EPC, stating that generic terms may be used to encompass domains of different priority date only if the “*limited number*” and “*clearly defined*” tests of Reason 6.7 are satisfied:

Reason 6.7 of G0002/98 (partial, emphasis and [] added): “... these two priorities may also be claimed for a claim directed to C, if the feature C, either in the form of a generic term or formula, or otherwise, encompasses feature A as well as feature B. The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters [ie domains].”

1.4.2 Where the limited number of clearly defined alternative subject-matters are to be found is not specified. There are two alternatives:

T1222/11: the domains of a claim are clearly defined bodies of subject-matter which, in the case of domains which enjoy priority, are disclosed in a priority document as seen through the lens of the G0002/98 Conclusion test^{16, 17}; as contained in the priority document, the latter may conveniently be termed “*pre-domains*”.

T1127/00: G0002/98 intended the domains *inter alia* to be “*clearly defined*” in the specification whose claims are under priority date assessment¹⁸ – as well as disclosed in the priority document.

1.4.3 At the general level, Reason 11.5 of T1222/11 accepts the principle of the “*limited number*” and “*clearly defined*” tests; the tests are expressly accepted at Reason 11.5.3 as “*obviously necessary*”.

1.5 Support for, and views against, the T1222/11 approach

1.5.1 The approach set out in T1222/11, advocated elsewhere¹⁹ by this writer as the preferred approach, has now been approved by another appeal board in T0571/10 (November 2014). The decision is in line with what is understood²⁰ to be *general* EPO Technical Boards of Appeal sentiment towards the T1222/11 approach to

split priority. It appears to be the only appellate EPO decision in support of T1222/111 so far. However, T1222/11 was decisively applied by an opposition division in December 2013 in the case of EP2157457, the opposition division having issued a preliminary view in favour of the patentee after having issued an unfavourable view before becoming aware of T1222/11²¹.

1.5.2 Moreover, there seems to be good intellectual and practical support for the T1222/11 approach, which makes much more sense than T1127/00 *et al*:–

- The language in Reason 6.7²² refers to claimed “*features*” A and B as entitled to the priority dates of priority documents respectively disclosing them, even when a generic expression C encompassing them is used in the claim. The EBA is referring to the “*elements*” of the claim, in the sense of *embodiments*, mentioned in Article 88 (3) EPC²³ and uses the term “*features*” with this intent. In this context, the proviso that the expression C must “*give rise to*” only a “*limited number of clearly defined alternative subject-matters*” logically refers to the domains of the claim, and the *embodiments* they define, visualised with reference to (the pre-domains of) the priority documents according to Article 88 (3) EPC, without the additional qualification of T1127/00.
- The “*alternative subject-matters*” referred to in G0002/98 cannot sensibly refer to members of the theoretical mass of features a generic expression comprehends. Although finite in number, their numerousness in many cases would make compliance with the “*limited number*” test unrealistic, and it could not have been intended²⁴ by the legislature or G0002/98 that claims using broad generic terminology should not benefit from Article 88 (2), (3) EPC. According to T1222/11, the number of domains is limited by the number of pre-domains chosen²⁵ in the priority document(s).
- G0002/98 expressly states that a claim may be split across the scope of a generic expression for priority date assessment purposes. It would be a contradiction in terms to construe the decision as requiring the *claim* concerned then to identify – ie “*clearly define*” – the

16 T1222/11, Reason 11.5.2, second sentence: “... the words ‘gives rise to the claiming of a limited number of clearly defined alternative subject-matters’ refer to the ability to conceptually identify by said comparison [of the claimed subject-matter of that „OR“-claim with the disclosure of the multiple priority documents] a limited number of clearly defined alternative subject-matters to which the multiple rights of priority claimed can be attributed or not.” Note that resolution of the claim into domains includes those not entitled to priority

17 G0002/98’s Conclusion stipulates that the test for whether subject-matter is disclosed in a priority document is the same as the test applied when assessing whether an amendment to a patent/application adds subject-matter

18 T1127/00, Reason 6

19 “A Review of priority Date Assessment under EPC”, Malcolm Lawrence, Journal of the European Patent Institute (EPI Information), Issue 3/13, September 2013, 89–102

20 Personal communication

21 T1222/11 was applied to address a Toxic Priority attack

22 To understand the proviso to Reason 6.7 of G0002/98, it’s essential to read the whole Reason to gather context

23 G0002/98, Reason 4, second paragraph establishes correspondence of meaning between “*element*” and “*embodiment*”. It is suggested by this writer that both are also equivalent to “*subject-matter*” – Reason 11.8 of T1222/11, for example, refers to “*subject-matter*” (in the sense of “*alternative subject-matters*” as used in Reason 6.7 of G0002/98) and reads in part: “It is therefore concluded that ... the decision on whether priority can be acknowledged for this **subject-matter**, i.e. for this **embodiment** covered by the „OR“-claim, is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the „OR“-claim of the European application as a separate alternative embodiment.”. In short, *element* = *embodiment* = (*alternative*) *subject-matter* = *pre-domain* = *domain*

24 See “A Review of priority Date Assessment under EPC”, *supra*, Paragraph 4.2 (ii)

25 See Paragraph 2.3

“*alternative subject-matters*” (per T1127/00 *et al*) which would result.^{26, 27}

- Whether (i) subject-matter claimed in a priority application is entitled to priority and (ii) an application (P1) from which it claims priority is, as between it and an even earlier application (P0), the first application for the purpose of Article 87 (1) EPC, must be tested in consistent manner – see G0002/98, Reason 8.4 *et seq*²⁸. The test in (ii) is a novelty test on P1 and does not depend on whether the relevant subject-matter disclosed in application P0 is *identified* in the P1 application. The T1222/11 approach is consistent with G0002/98, Reason 8.4 *et seq*²⁹ – those in T1127/00 *et al* are not.

1.5.3 The T1222/11 approach seems supported by Kitchen J in *Novartis AG v Johnson & Johnson Medical Limited* [2009] EWHC 1671 (Pat) in the UK Patents Court. Paragraph 122 of the judgement includes the following passage which, though falling short of saying that that a domain does not have to be identified as such in the patent under assessment, is so framed as to leave not much doubt that it was intended to express *all* the conditions for a virtual domain to benefit from the multiple priority provisions of Article 88 EPC:–

“I discern from this passage that the EPO considers it is permissible to afford different priority dates to different parts of a patent claim where those parts represent a limited number of clearly defined alternative subject-matters and those alternative subject-matters have been disclosed (and are enabled) by different priority documents. Further, this principle applies even if the claim has adopted a generic term to describe and encompass those alternatives. I do not detect anything in the decisions of the Court of Appeal in Pharmacia and Unilin Beheer which is inconsistent with this approach and in my judgment is one which this court should adopt.”

1.5.4 On the negative side, the deciding board in T2311/09 (September 2013) did not follow T1222/11, denying partial priority in Reason 4 based on the approach in the T1127/00 decision cluster. Lessening the authority of T2311/09, T1222/11 appears not to have been asserted and the board did not have the benefit of hearing oral argument as there were no oral proceedings.

1.5.5 In addition, in terms of professional community debate, *Pearce & Fulconis* (“*Narrow Interpretation*”) *supra*³⁰, argues against T1222/11:–

26 This particular criticism of T1127/00 evaporates if the view taken is that this case law calls for the “*alternative subject-matters*” to be identified elsewhere in the specification than the claim in question

27 See „*European Patent Office (Technical Board of Appeal 3.3.07): Poisonous divisional applications – is the bogey going to disappear? (Decision of December 4, 2012 – Case T 1222/11 – Hair cosmetic composition/KAO)*”, Rudolf Teschemacher, IP Report 2013/IV, Autumn 2013, Bardehle Pagenberg

28 See also T0477/06, Reason 4 and T0454/01, Reason 2.4.4 and the subsequent discussion of selection novelty in the context of applying Article 87(1),(4) EPC

29 See T1222/11, Reason 11.8

30 *Pearce & Fulconis* appears intended by its authors to be provocative in the interests of further debate

- The concept of “*imaginary claim splitting*” is argued to be irreconcilable with the “*disclosure test*” as particularly set out as the so-called “*golden standard*” in G0002/10³¹. This is incorrect:

- The combination of the FICPI Memorandum, Article 88 (2) EPC and Reason 6.7 of G0002/98 make it clear that parts of a claim are to be recognised as different “*subject-matters*” enjoying different priority dates – even if they fall within a generic expression the claim uses to encompass them as opposed to being specifically disclosed in it. This powerful trio takes outside the disclosure test the question of visualizing virtual domains in a claim.

- G0002/10 (eg Reason 4.5.3, partially quoted in *Pearce & Fulconis*), concerns subject-matter changes arising from either transiting a specification from original to amended form or from priority document to priority-claiming application. Contrastingly, virtualisation of a domain within a claim does not occasion any such tangible action and does not even involve exercise of linguistic expression – it’s merely an intellectual exercise.

- The “*limited number*” and “*clearly defined*” tests of G0002/98 are asserted to be a “*silent condition, which is necessarily met and can therefore be ignored in practice*”.³² This is also incorrect:

- There is a real risk one or both tests may be failed, as explained later in this paper³³.

1.6 Looking Forward

1.6.1 The conflict between T1222/11 and the T1127/00 cluster of decided cases has now been referred to the EBA by the responsible board in T00557/13, with both parties to the opposition appeal consensual³⁴. The conflicting decisions had been debated in some depth in writing and at oral proceedings. The context is a fuel containing 0.001 % to 1 % to of a cold flow improver defined by reference to a formula. The priority document recites a narrower 0.01 % to 1 % range for the content of flow improver and defines the flow improver itself in several ways, the formula in the claim of the opposed patent having been held by the opposition division to be an intermediate limitation. The patentee seeks to resolve the claim virtually into a priority-entitled domain which recites the flow improver chemically and quantitatively as submitted to be disclosed in the priority document, and a non-priority domain for the remainder of the claim.

1.6.2 Things are looking hopeful. But prophecy is never easy, and notwithstanding the merits of T1222/11 and the latest appellate support for it in T0571/10 *supra*, too

31 *Pearce & Fulconis* (“*Narrow Interpretation*”), page 719, Column 1, penultimate paragraph and the next paragraph bridging onto Column 2

32 *Pearce & Fulconis* (“*Narrow Interpretation*”), page 719, Column 1, fourth paragraph

33 It follows that the *contra* argument of *Pearce & Fulconis* (“*Broad Interpretation*”) that T1222/11 provides a complete solution for Toxic Priority is also not correct

34 See <http://tinyurl.com/pyr4uwv>. Strictly speaking, at the time of writing, the relevant board had merely made the decision (at December 17, 2014 oral proceedings) that questions of law be referred to the Enlarged Board – the content for the referral had not at that time been drafted and it appears that the referral might involve one or more other issues

much presumption is, for two reasons, a temptation to be resisted.

1.6.3 The first is the uncertainty as to what the EBA will rule and in the meantime the extent to which T1222/11 will be embraced by EPO and national tribunals, in well-argued cases. Secondly, there remains more to learn about how Article 88 (2) EPC should be implemented and the extent to which the “*limited number*” and “*clearly defined*” tests challenge success in virtualising alternative subject-matters. In this connection, for example, T1222/11 almost certainly is not a complete solution to Toxic Priority³⁵, as explained later in this paper.

1.6.4 Avoidance of T1127/00’s restriction that a domain in a claim must have basis in individualized form in the specification containing that claim substantially magnifies the pool of priority document content which can be used to construct a domain – see later paragraphs of this paper. Assuming T1222/11 is adopted as the correct approach, it’s therefore outcome-changing in ways which should be very meaningful in crowded technology areas where multiple priorities are common, commercial significance high and much depends on parties succeeding with priority assertions in dealing with cited art.

1.6.5 It’s worth taking stock at this point, however, by asking two questions:–

- Is Toxic Priority a valid issue worth worrying about?
- Is it a material or an orphan issue?

Validity of Toxic Priority as an IP Risk

1.6.6 The most common challenge to Toxic Priority as a valid IP risk has been that it was never intended that members of a divided family should come into *whole contents* conflict under Article 54 (3) EPC³⁶ (*Poisonous Divisions*), with analogous challenge to member-to-member conflict in priority groups (*Poisonous Priority Documents*). The absence of carve out provisions³⁷ weakens both propositions. However, the most formidable argument against the first is that treating divided families in a privileged way would create two tiers of patent applicants³⁸. Those who file applications divided in prosecution would experience an attenuated application of Article 54 (3) EPC; those who pre-empt division by

filing separate applications at the outset would face its full force. The principle of fairness requires the two applicant constituencies to be treated in an equivalent way. If this argument is correct, it’s hard to take a different position on treatment of priority groups.

Materiality of Toxic Priority

1.6.7 How many patent applications claim partial or multiple priorities? There are no statistics obviously available from WIPO on the latter subject and one might speculate on the former, on which there are none at all, that incidence might be about the same.

1.6.8 Limited and informal research to determine the proportion of PCT applications claiming plural priority dates shows the following indicative figures for slices of 200 consecutively published PCT applications published, respectively, in 2003 and 2014:

- 2003: 14.5 % of the applications in the slice claim two or more priority dates
- 2014: 21.5 % of the applications in the slice claim two or more priority dates

A repeat of 2014 for a different slice of the same size gave a figure of 17.5 % for applications claiming two or more priority dates.

1.6.9 Applying a filter to limit to slices of 200 consecutively published applications each of which claims the date of a US patent application, produced the following indicative result:

- 2003: 25 % of the applications in the slice claim two or more priority dates.
- 2014: 30 % of the applications in the slice claim two or more priority dates.

A repeat of 2014 for a different slice of the same size gave a figure of 39 % for applications claiming two or more priority dates at least one of which is a US application.

1.6.10 Whilst the above falls short of statistically conclusive evidence, it’s a clear indicator that events calling for assertion of Article 88 (2) EPC are very unlikely to be orphan events.

2. Domain Structure

2.1 Rationale

2.1.1 T1222/11, if it is generally adopted as setting out the right approach, appears to provide basis for a general *domain-based* strategy for addressing Toxic Priority, as well as having broader relevance.

2.1.2 It’s worth questioning how wide a framework it provides. The answer is that it’s quite broad but with limitations. This Paragraph 2, and much of what follows it, looks at domain structure to try to suggest what might and might not work – to some extent in an experimental way.

35 See in particular “*Review of Toxic Priority: The Poisonous Divisions Concept (et al) following EPO Appeal Decisions T1496/11 and T1222/11 and Nestec v Dualit*”, Malcolm Lawrence, Journal of the Chartered Institute of Patent Attorneys (CIPA Journal), Volume 42, No 9, September 2013, 518 – 527

36 The idea of what might be called “*divisional privilege*,” arose in the opposition to EP2157457 referred to earlier (Paragraph 1.5.1). The Opposition Division adopted the T1222/11 interpretation of Reason 6.7 of G0002/98 but gratuitously decided additionally to express some principles in favour of special treatment of divided families – doing so in a brief paper which it supplied to the parties at oral proceedings. The Opposition Division opined that the Poisonous Division effect goes “*beyond the legislative purpose of Article 54(3) EPC*”, and that it would be “*illogic (sic) to consider a parent application (or a divisional) among the documents mentioned in Article 54(3) EPC*”.

37 Article 55 EPC (Non-Prejudicial Disclosures) provides a statutory site for such a carve out, together with the carve outs already stated there

38 This is effectively the end-game of the often articulated contention that a divisional is not “*another*” application in the sense of Article 54(3) EPC (it being generally accepted that the word “*another*” is there implicit). This tends to be justified by reference to avoidance of double patenting as the legislative intention of Article 54(3) EPC. But, again, this leaves one asking the unavoidable question as to why an applicant who has divided should be better off than one who filed separate applications at the outset

2.2 A starting point

2.2.1 Neither Article 88 (2), (3) EPC nor G0002/98 provides structural information on how a claim may be envisaged in domain terms. However, T1222/11, Reasons 11.5.5–11.5.7 discuss this in the settings of the FICPI Examples.

2.2.2 The working hypothesis emerging from that discussion is that one takes the broadest *relevant* priority document disclosure and, treating it as a pre-domain³⁹, envisages it as a priority domain within the claim concerned. A balancing domain consists of the rest of the claim. There are therefore just two domains (“*alternative subject-matters*”) and they are mutually exclusive (abutting)⁴⁰.

2.2.3 Arrowsmith & Faulkner⁴¹ suggests a solution which involves *expressing* domains rather than virtualising them (at the same time doubting the legal validity of Toxic Priority as an IP concept). T0571/10⁴² *supra*, in a slightly more complex situation, applies the principles of T1222/11. This involved a claim to a coated tablet composition of an active pharmaceutical ingredient (API) in acid or pharmaceutically-acceptable salt form together with an inorganic salt stabilizer. The board resolved the claim into (i) a priority domain in which the API is in zinc salt form and the stabilizer is in triphosphate salt form and (ii) a further (non-priority) domain representing the rest of the claim.

NOTE 1

Taking the T0571/10 model, there will be many straightforward cases where Toxic Priority is remediable by unproblematic assertion of a domain structure. This has been facilitated by T1222/11. Contrastingly, adopting the approach of the T1127/00 stable of cases, there are significant additional obstacles to asserting such domain structure, as illustrated by those cases.

2.3 Patentee choice in determining Domain Structure

2.3.1 On balance, nothing in T1222/11 or Article 88 (2) EPC gives an overall impression that the approach summarised in Paragraph 2.2.2 is prescriptive as opposed to illustrative. In fact, T1222/11, Reason 11.5.3 supports the notion that domain generation will normally be citation-driven in patentee hands⁴³ having at least some freedom of choice. This is consistent with the broadly defined benefits of Article 88 (2) EPC⁴⁴ and is aligned with the rationale at the heart of the FICPI Memorandum – that multiple priorities are a preferred option to claim multiplicities, over which a patentee would enjoy wide freedom of choice on claim content⁴⁵.

2.3.2 Figure 1 and Table 1 illustrate how freedom of choice might be used in a somewhat more complex situation than those discussed in Paragraph 2.2. In the illustration, the patent and priority document claim/disclose chemical subject-matter, an integer of which recites an alkyl group by reference to carbon atom content:–

- The claim (C1–C20 alkyl) may be resolved into:
 - abutting Domains I and II or
 - (i) Domains I, III, IV and (ii) a domain (not shown as such) representing the rest of the claim
- Domain I at E (C5–C20 alkyl) corresponds to the priority document subject-matter at B but the priority document subject-matter at C (C9–C21 alkyl) falls partly outside the claim (C1–C20 alkyl) and thus is not a pre-domain.
- Domain I should be entitled to priority. Domains III and IV correspond to the narrow pre-domains (C3 and C2 alkyl) at D in the priority document and so are also entitled to priority. Domain II (C1 to C4 alkyl) is not so-entitled as there is no corresponding pre-domain in the priority document⁴⁶.
- The latter shows that, despite having only slight narrowness at one end relative to the priority document, the claim must seek pre-domains in the lower levels of the descriptive hierarchy of the priority document if it is to maximise priority opportunities.

39 The topic and its analysis is advantaged by having its own language; the expression “*pre-domain*”, as noted in Paragraph 1.4.2, seems apposite to refer to the precursor in a priority document of the “*domain*” in the claim

40 T1222/11 makes clear that in partitioning a claim into domains for the purposes of Article 88 (2) EPC, the domains in aggregate, counting both priority and non-priority domains, represent the whole of the claim (Reason 11.5.5, final sentence). See also Teschemacher *supra*, “Remarks” section

41 “*An antidote to poisonous division(al)s*”, Peter Arrowsmith and Tom Faulkner, Journal of the Chartered Institute of Patent Attorneys (CIPA Journal), March 2012

42 The decision has been reported as one in which a divisional claim was challenged by subject-matter of earlier priority date in a parent. This is inaccurate as the claim, although in a divisional application, was in fact challenged by matter in a Euro-PCT application of common priority date claim, common filing date and almost identical content but which fell outside the divided family

43 T1222/11, Reason 11.5.3: “... it is not the task of the European Patent Office to determine *ex officio* to which parts of an “OR”-claim can be attributed the right(s) of priority claimed ...”

44 But the subject is sufficiently challenging that it’s foreseeable that eg the EPO will exercise some kind of limited discretionary jurisdiction

45 As noted earlier (Paragraph 1.1.2, Footnote 8), it would be a rather idealised claim multiplicity to achieve what permitting plural priority dates for one and the same claim can achieve. But the argument that a migration of the law from one regime to the next should not materially lessen the fundamentals of patentee freedom of choice on claiming seems persuasive

46 Put alternatively, priority is not enjoyed for *either* of two reasons: first, some of the subject-matter of Domain II falls outside the scope of the priority document and secondly the Domain II subject-matter which falls within its scope, which is a combination of Domains III and IV and what lies to the right hand side of them (C4), is not as *such* disclosed in the priority document

Figure 1 – Domain (Grafik)

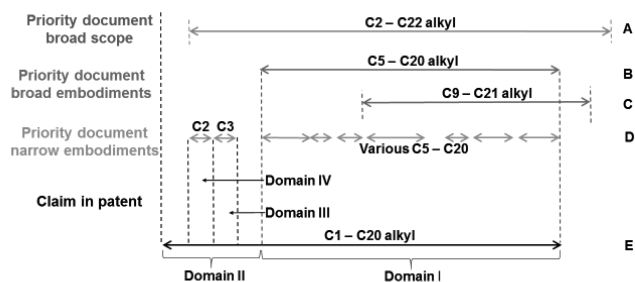


Table 1

A	C2–C22 alkyl	Priority Document	Scope mismatch with Claim
B	C5–C20 alkyl	Priority Document	Pre-domain
C	C9–C21 alkyl	Priority Document	Not pre-domain: straddles Claim boundary
D	C2, Cs alkyl/ various C5–C20 alkyl	Priority Document	Pre-domain
E	C1–C20 alkyl	Main Patent Claim	Non-priority: straddles priority document boundary
Domain I	C5–C20 alkyl	Claim domain	Priority
Domain II	C1–C4	Claim domain	Non-priority: straddles priority document boundary
Domain III	C3 alkyl	Claim domain	Priority
Domain IV	C2 alkyl	Claim domain	Priority

2.3.3 If the reasoning set out above in this Paragraph 2.3 is sound, it follows that if a patentee faces prior art relevant only to the subject-matter of say Domain IV, his freedom of choice may be even wider: he can virtualise a domain structure consisting of Domain IV and a domain consisting of the rest of the claim which abuts Domain IV on all sides – the patentee thus going no further than asserting a priority domain broad enough to ring-fence the citation. In the context of Toxic Priority, such prior art may be created through division specifically to protect the matter of Domain IV in a divisional, the latter then being citable as a *whole contents* citation against the parent.

NOTE 2

In asserting split priority, a minimalist approach to resolving the claim into domains appears allowable, and seems likely always to be wisest – taking a position on domain structure more than this would be unnecessary and might conceivably conflict with a position that might need to be taken in some later context.

2.4 Estoppel

2.4.1 It is uncertain, once a domain structure choice is made by a patentee, whether there may be circum-

stances where he is estopped from taking a different position in a different prior art context.

2.4.2 Where a patentee has asserted a domain to have a particular priority date to avoid a citation, it seems appropriate that there should be estoppel (extending beyond tribunals of coordinate jurisdiction) from later asserting it to have a different one. However, for estoppel to go further, the benefits of Article 88(2), (3) EPC would to some material extent be withheld, without the justification of a public interest need not already addressed by Reason 6.7 of G0002/98.

3. What do the terms “limited number” and “clearly defined” really mean?

3.1. General

3.1.1. Reason 6.7 of G0002/98 is central to the issue of partial and multiple priorities, and the “*limited number*” and “*clearly defined*” tests in its proviso have given practitioners trouble.

3.1.2. Despite T1222/11, it is still not entirely clear how these tests should be implemented in practise. There is little sign that these areas of the topic will be officially much illuminated in the immediate future.

3.2. The „limited number” test

3.2.1. The driving force for the “*limited number*” test is no doubt a legislative desire to avoid the interested public being faced with too complex a task when assessing priority for the purposes of the validity dimension of an FTO exercise⁴⁷.

3.2.2. In practise, there will be few contexts where the “*limited number*” test will be hard to satisfy. In most cases of Toxic Priority, it should be possible to assert a limited number of priority domains which neutralise cited art, whilst in others it will either not be possible or not be necessary to assert any domain structure that helps; this is illustrated in Paragraph 4. However, asserting many domains will presumably not normally be acceptable implementation of Article 88 (2) EPC.

3.2.3. In particular, it’s probably not accurate to say that plural claimed dates *necessarily* means complexity in the sense of the “*limited number*” test. The extent to which resolving a claim into domains reflecting priority dates of many claimed will depend on exercise of patentee choice as informed by needs arising from citations facing him⁴⁸ – plural claimed dates give capacity for many domains but, generally, not all priorities need to be asserted. However, there may be a clarity issue – see Paragraph 3.3.2.

47 T1222/11, Reason 11.5.3: “... a limited number of clearly defined alternative subject-matters is obviously necessary in order to identify which parts of the claims benefit from the effect of the priority right ...” The decision is not as direct as the opinionated comment in Paragraph 3.2.1, but it’s a good approximation

48 This is a more developed view than the view by this author in Paragraph 6.2 of „*Toxic Priority – A 2013 Epilogue*”, Malcolm Lawrence, Journal of the UK Chartered Institute of Patent Attorneys (CIPA Journal), Volume 43, No 3 (March 2014), 142-149

3.2.4. The judge in the 2013 *HTC v Gemalto*⁴⁹ UK case was less than supportive of the “*limited number*” test of G0002/98. The judge commented in Paragraph 160 of his judgement:

“In **G2/98** the EPO Enlarged Board held that multiple priorities in a single claim were possible as long as the claim related to a limited number of clearly defined alternative subject-matters⁵⁰. Although one can sympathise with the desire for a limited number, I doubt there is any principled basis for such a requirement ...”

3.2.5. It would be wrong to attach excessive importance to the comment as the point has not been debated at any length in case law and, in the trial in question, the judge did not need to decide the point. But it’s worth keeping in mind; perhaps it alludes to the point made in Paragraph 3.2.2.

3.3. The “clearly defined” test

3.3.1. Lack of clarity in a priority domain presented as neutralizing a citation is, of course, fatal to an entire split priority strategy as it would leave the claim anticipated by the citation concerned. However, as the “*clearly defined*” test is expressed as a requirement of the overall claim splitting, presumably the “*clearly defined*” test is not satisfied if resolving generic terminology into the *necessary* domains “*gives rise to the claiming of*” any subject-matter domain which is not clearly defined.

3.3.2. The risk in this respect is illustrated in *Nestec*⁵¹ where the court held that domains beyond those which had basis for priority purposes in the priority document were not clear alternative subject-matters⁵². The consequence was that no part of any claim was attributed the claimed priority date. If it is correct that this view of the court goes to clarity as opposed to some other relevant issue, the point may be that the boundaries of a priority domain are rendered uncertain if the domains which border it are not themselves clearly defined. As case law stands, this points to a clear risk of adverse outcomes, at least in the UK Patents Court. Importantly, although not taken into account in *Nestec*, it does not appear that T1222/11 would have changed the court’s view on clarity as T1222/11 adds nothing to that facet of split priority doctrine.

49 *HTC Corp v Gemalto* [2013] EWHC 1876 (Pat)

50 This wording is somewhat general: G0002/98 applies the “*clearly defined*,” and “*limited number*,” tests only in the context of claim splitting across generic expressions. Presumably, when the claim recites specific alternatives as opposed to covering them within a generic expression, the specific alternatives will have been tested earlier as meet the “*clearly defined*” test anyway

51 *Nestec SA & Others v Dualit Ltd & Others* [2013] EWHC 923 (Pat)

52 In *Nestec*, the judge concluded in Paragraph 96 of the judgement that “*Option (iii)*” (in which the “*housing*” in the extraction system was distributed between the “*movable part*” and the “*fixed part*” of the system) covered a “*whole range of different arrangements*”, those at the extremes being “*quite similar*” to the respective other options (“*Option (i)*” and “*Option (ii)*”) – so that it was not a clearly defined alternative to the other options. On another feature, the judge took a similar view that “*inclined*” orientations of the capsule were not clearly defined alternatives to non-inclined orientations (Paragraphs 97 *et seq.*, in particular Paragraph 103)

3.3.3. Whilst the standard to be adopted for the “*clearly defined*” test is a debating point, it is suggested that logically it ought perhaps to be applied as an Article 84 EPC clarity test. Just as different claims do, different *domains* of a claim interact differently with validity considerations according to their priority dates, and interact differently with potentially infringing commercial proposals according to their included subject-matter. It should follow therefore that the same public interest issues arise in terms of where boundaries are regardless of whether the boundaries are those of a *claim* or of a *domain of a claim*.

3.3.4. It can alternatively be argued that there is a distinction, albeit a fine one, between the words “*clearly defined*” used in G0002/98 and the language “... *sufficiently clear and complete* ...” which is used in Article 84 EPC, and that there is no sufficient difficulty in construing what the test means to require any recourse to Article 84 EPC⁵³. Although appealing on the language, this approach to a clarity standard could lead unsatisfactorily to application of different standards of clarity as between claims on the one hand and domains defined within claims on the other. The legislative intention *per* the FICPI Memorandum appears to have been to provide split priority as an alternative to claim multiplicities; it would be surprising if this broad aim were considered *appropriately* met if accompanied by relaxation for domains of the clarity standard which would apply to a claim multiplicity. The *Nestec* approach (Paragraph 3.3.2) seems most aligned with the stricter standard.

3.3.5. Consider a prosecuted priority document claim to a chemical composition comprising (i) component A and (ii) additional component X *not* clearly defined. This might be objected to under Article 84 EPC in official examination. Consider then a claim in an application claiming the date of that priority document and reciting a more broadly defined composition comprising (i) a genus consisting of A or B plus (ii) component X *clearly defined*. The latter claim could be resolved into domains including one corresponding to the priority document’s claim. It cannot be right for this to satisfy the clarity test of G0002/98 even though a corresponding claim fails under Article 84 EPC.

4. Paragraphs 2 and 3’s Ideas in Action

4.1 Consider the following alternative scenarios. In each, a patent of filing date F is a member of a priority-claiming divided family, claims a range 1–20, seen as a whole is disentitled to priority and faces challenge from three citations:

Alternative scenarios

- 1: priority document P1 discloses “5–10” + specific values in range 5–10
- 2: priority document P1 discloses “*not more than 10*” + those specific values

53 This is a valid alternative not recognised in this writer’s earlier thinking – see Paragraph 5 of “*Toxic Priority – A 2013 Epilogue*”, *supra*

Citations

- 1: conventional intermediate date⁵⁴ citation disclosing the above specific values
- 2: *whole contents* matter of the priority document
- 3: *whole contents* matter of an identical other member of the divided family

4.2 In Scenario 1, novelty in Toxic Priority and other contexts can be rescued by using split priority tools to virtualise the domain “5–10” and an abutting domain representing the rest of the claim. None of the Citations prevails as an anticipation⁵⁵ and it isn’t necessary to virtualize any further domains:

- The split priority tools create a “5–10” domain having a priority date earlier than that of Citation 1 and a balance domain distinguished in subject-matter terms.
- That date of the “5–10” domain is the same as that of the potentially anticipatory matter in Citation 2 (range “5–10” and specific values).
- The disclosure of range “1–20” as disclosed in Citation 3 on the one hand and the overall claim on the other have the same date and so do not come into conflict.

NOTE 3

It’s perhaps obvious but worth underlining that the first step in novelty assessment having regard to a particular disclosure in a citation, prior to implementation of the split priority tools of Article 88 (2) EPC, is to ask of the claim whether the citation anticipates it. If the answer is YES, the split priority tools are then applied and each domain individually assessed for novelty.

- The priority date of Domain “5–10” is also the same as that of the specific values in Citation 3 (if disclosed there); it would not be necessary to assert narrower domains reflecting the disclosure of specific values in the priority document.

4.3 In Scenario 2:

- Citation 1 anticipates the patent by virtue of its specific value disclosures.
- Citation 2 anticipates the patent by virtue of its disclosures of the range “not more than 10” and its specific value disclosures.
- As illustrated, there isn’t a domain which can be virtualized using split priority tools to neutralize both Citations 1 and 2. The priority document disclosure “not more than 10” falls partly outside the parent claim and is thus not a pre-domain. Even if to do so would be otherwise viable, resolving the claim into a discontinuous plurality of specific value domains and a domain consisting of the rest of the claim would leave the latter (and in particular the matter in the interstices between specific value domains) exposed to anticipation by Citation 2’s general disclosure.
- In case of Citation 3, the F-dated broad range has the same subject-matter content and priority date as the

broad range claimed in the challenged claim and would not be citable against it. The citation is relevant only for the specific values it discloses.

- Although successfully resolving the claim into plural specific value domains would theoretically address the vestigial *Poisonous Divisions* problem of specific value disclosures in Citation 3, the “limited number” test of G0002/98, Reason 6.7 would need to be considered. This might resist solution if the tribunal considered the number of domains to be an undue burden; there may also be a clarity issue depending on the context in which the specific values sit.

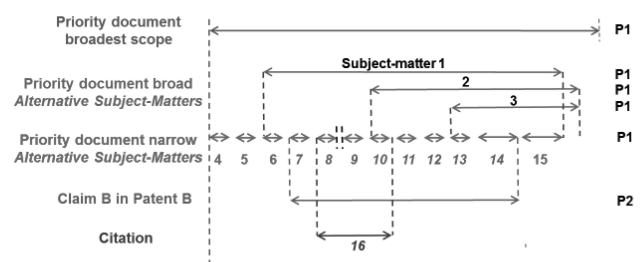
5. Ineffective domain structures

5.1 Narrowing relative to Priority Document

5.1.1 Claims are commonly broadened in the priority interval. Various drivers for this include new information and/or simply the opportunity for reconsidering the approach to protection taken in the first instance, often under time pressures limiting preparation time⁵⁶. It is also, however, not uncommon for claims to be limited during that interval, or subject-matter basis for doing so added then and deployed later, with similar drivers.

5.1.2 Although G0002/98, in common with the FICPI Memorandum, focuses on broadening to the exclusion of narrowing (as far as Article 88 (2) EPC is concerned), both have subject-matter change at their core and should benefit from the provisions of Article 88 (2) EPC in the same way. Beyond this generality, however, there are differences between the way claim broadening and narrowing experience the implementation of those provisions, as can be seen from the illustration in Figure 2 below.

Figure 2
Domain (un)availability in case of Narrowed Claims



5.1.3 As Figure 2 shows, Claim B is not only narrower than the broadest claim scope in the originally filed specification but, as can happen, is also narrower than Subject-Matter 1 and straddles a boundary of each of Subject-Matters 2 and 3. In the result, none of these P1-dated subject-matter blocks is a pre-domain serving to generate priority domains within Claim B; the claim must look to lower levels in the priority document scope

54 ie Citation 1 published immediately before F and after P1
 55 Although *whole contents* citations are not citable under an inventive stop head (Citations 2 and 3), Citation 1 remains prior art under this head so far as subject-matter claimed beyond the domain [5–10] is concerned

56 The point that much can change between a first and second commonfamily filing is made well in “Self-collision of European patent filings: an accident waiting to happen?”, Jane Wainwright (Potter Clarkson LLP), Life Sciences Intellectual Property Review (LSIPR), May 31, 2013

hierarchy to identify viable pre-domains. There are two problems which can arise from this.

5.1.4 As illustrated by Figure 2, one of these problems is that a patentee may be forced to assert a discontinuous fragmentary domain structure which may well make the split priority tools of G0002/98 in many cases ineffective in dealing with citations. For example:–

- Consider Citation 16 against Claim B, assumed for the purposes of this illustration to have an (effective) publication date earlier than Claim B's P2 date but later than P1. The citation is broader than the sum of the domains generated by P1-dated Pre-domains 8, 9 and 10 (as it also encompasses the interstices). It thus cannot be captured by the fragmentary domains which those pre-domains may virtualise in Claim B. Citation 16 may be an early publication by the inventor team, perhaps a poster.
- The problem can also be found in Toxic Priority contexts. Publication of the priority document would place in the state of the art, as of the relevant priority date, various specific and more general P1-dated subject-matter encompassed by Claim B. This is anticipatory as the claim is only entitled to date P2. No domain structure can be asserted which satisfies the three-fold test that it must capture this matter, be disclosed in the priority document and fall wholly within Claim B.

5.1.5 Secondly, the less rigorous language which can sometimes be used at the lower levels of a priority document's descriptive hierarchy could make it challenging to satisfy the "clearly defined" test. In the case of a rather limited claim, there may be no other relevant priority document disclosures on which to rely.

NOTE 4

Claims which have been narrowed relative to a priority document produce potentially more dangerous scenarios than claims that have not. As claims become narrower, they "push" the search for pre-domains towards the bottom of the descriptive hierarchy of the priority document where the ration of possible pre-domains is leaner, pre-domains may be too fragmented to match citations and language may lack the rigour to satisfy the "clearly defined" test.

5.2 Non-Specific Embodiment Domains which challenge the "clearly defined" test

5.2.1 Using Figure 2 and the following facts, the point made in Paragraph 5.1.5 can be illustrated in a *Poisonous Divisionals* context (ignoring issues arising from other facets of the fact pattern). Patent B is a member of a divided family and the specifications of the members are assumed to have the same content. Subject-Matters 7–14 in another member have date P1, fall within the scope of Claim B and anticipate it unless Article 88 (2), (3) EPC provides a solution. These bodies of subject-matter may not have been drafted with the rigour no doubt reflected in claims and key consistory clauses. If they not satisfy the clarity test of G0002/98, Reason 6.7, the

corresponding content in the priority document will not provide pre-domains useful in implementing Article 88 (2) EPC, leaving Claim B anticipated.

5.2.2 Chemical and life sciences subject-matters are by their nature more likely to experience Toxic Priority risks. However, so can subject-matter in other areas. In a mechanical case, for example⁵⁷, an assembly of members was claimed as an "array" but no array was disclosed as such in the priority documents except in an informal diagram in the setting of loosely drafted description, the overall combination being unclear but its counterpart in a divisional anticipatory of the parent claim.

5.2.3 Case Study 1 below provides a further illustration, again in a mechanical context. Passages such as the disclosure "... and elongate secondary member(s) which are relatively rigid and pressed from thin sheet to convenient shape" are all too easily included in patent specifications, especially those necessarily filed with urgency and with less than complete information. This is drafting practice worth revisiting, especially if (as may be the case) it serves little purpose in terms of conferring enablement or opportunities for later amendment.

NOTE 5

Suggested drafting rule: No content should be included in both a priority document and an application claiming its priority date which could form basis for an anticipation attack against another member of a divided family unless, were it a claimed feature, it would comply with Article 84 EPC. Only in that case would the content in question be capable of giving rise to a protective virtual domain in the claim with prospect of success.

CASE STUDY 1 – A's Patent

Context

A's Patent was the parent in a divided family whose members claimed a common priority date. Both parent and divisional main claims originally corresponded to the broadest priority document claim but were limited in prosecution based on substantial additions on filing the priority-claiming application. The resulting main claim in each application thus did not as a whole enjoy priority. A preferred embodiment: "Apparatus comprising ... and elongate secondary member(s) which are relatively rigid and pressed from thin sheet to convenient shape" was common to all family members and within the claim scope. In the parent and divisional, it was linked to the invention in both its original and limited scopes, and was generally linked to other features in the priority document.

Analysis

The above preferred embodiment (the "missile") was entitled to the priority date and thus reciprocally citable under the "whole contents" rules – each of the parent and divisional was a "target" for the "missile" in the

57 Personal communication

other. But, as a pre-domain, it was sufficiently vague that it probably failed the G0002/98 “clearly defined” test. Therefore, it could not safely be used to envisage a priority domain to neutralise the citation and avoid Toxic Priority.

Solutions

To protect the parent from attack by the divisional in the above specific scenario, the preferred embodiment could have been omitted from the divisional specification. However, as the main divisional claim was not entitled to priority and embraced the same priority-entitled “missile” in the parent, the divisional would be left exposed so that this approach needed to be combined with other action.

The parent and divisional but not the priority document disclosed the generally applicable preferred presence of 2 to 10 elongate members. Limiting the divisional claim to this feature would distinguish the divisional claim from the parent “missile”. The combination of the parent “missile” with the 2 to 10 elongate member count feature would not destroy the divisional claim’s novelty; not being disclosed in the priority document, it lacked the priority date necessary for citability.

Fortunately, this also applied to the specific embodiment described with reference to the drawings, which had been revised on parent filing.

5.3 “Specific Examples” as priority domains

5.3.1 Much has been written about the damaging role of priority-entitled Examples (and other specific embodiment material) as prior art in Toxic Priority contexts. This is valid although there has been a certain amount of over-reaction.

5.3.2 The suitability of the language of an Example for inclusion in a claim is normally poor and it is suggested that, in most cases, it will not satisfy the “clearly defined” test when used to define a priority domain. However, to keep perspective, the need to visualise a domain corresponding to, as opposed to subsuming, an Example is not likely to be very common. Where the subject-matter of an Example has been added to the state of the art before the priority date of the claim it challenges (eg in a Toxic Priority context), domain selection should result in visualization of the broadest, appropriately early dated, priority domain enveloping that subject-matter. In most cases of reasonably well drafted specifications, this will not mean relying on the Example in the priority document as a pre-domain itself; usually, although not always, the priority document will disclose tiers of intermediate limitations at least some of which can serve instead of the Example as broader pre-domains and so define suitably early priority domains in the challenged claim⁵⁸.

5.3.3 Nestec illustrates the exception, and in doing so again demonstrates that mechanical subject-matter is

not immune to difficulties in implementing Article 88 (2) EPC:–

- The court held the claims had been broadened to cover three alternatives for housing configuration and three for capsule disposition. The priority document disclosed only one of the three alternatives in each case.
- The claims had also been limited to recite a capsule flange to guide it within the extraction system claimed. This feature was disclosed in the description of the priority document with reference to the drawings but not in any broader setting⁵⁹.
- To produce a priority domain in the claims concerned, a pre-domain would need to be identified in the priority document which was limited to:
 - Embodiments in which the capsule has a flange (otherwise the domain it gives rise to would not fall wholly within the claim concerned)
 - The single housing configuration and the single capsule disposition disclosed in the priority document.
- No such pre-domain was disclosed in the priority document other than the specific embodiment described with reference to the drawings.

5.3.4 Case Study 2 below, further illustrates the risks posed by anticipatory specific embodiment subject-matter when there is no supply of suitable intermediate limitation in the priority document.

5.3.5 In his late 2013 paper, *supra*, Rudolf Teschemacher appears to demur from the idea that an Example is likely to be unsuitable as a domain former. The paper states in its “Remarks” section that “... Within the meaning of G0002/98, the specific example is one clearly defined alternative subject-matter; the other alternative is the generic rest of the claim ...” However, this may be referring to specific embodiments in a more general sense than specific Examples or description referring to drawings. A similar situation arises in the context of T0571/10 *supra* which refers to “specific embodiments” as domain-forming (Headnote, Paragraph 2; Reason 4.5.12), but Reason 4.5.3 makes clear specific Examples and description with reference to drawings are not intended.

CASE STUDY 2 – B’s Patent

Context

The claimed laminate product had a pre-formed film adhered upon a non-planar surface having two surface levels connected at a bevel. The priority document, a UK application which had published prior to being abandoned in favour of a UK designation in an EPC application claiming its date, gave no general information on bevel radius, although specific embodiments described with reference to drawings recited specific radii. More general bevel angle information comprehending the specific embodiments (Examples) was added at the

58 See Paragraph 9 of “Toxic Priority – A 2013 Epilogue”, *supra*

59 The capsule flange point is not really featured in the judge’s reasoning per the judgement

time of filing the EPC application. Some of this found its way into the EP's independent claims during prosecution, with loss of overall priority.

Analysis

The published UK priority document contained specific embodiment disclosures falling within the scope of the granted EP claims. The specific embodiments in the priority document and the patent were identified as engendering in the claims corresponding priority domains. Arguably, these were too numerous to satisfy the "limited number" test. With less reservation, they lacked the clarity expected by the "clearly defined" test as they referred to various proprietary materials by means of trade designations and the protocols set out relied on interpretation and adaptive implementation by the skilled man.

Outcome

The EP was therefore (probably) invalid (for anticipation in a *whole contents* sense by the priority document) so far as the UK was concerned, leaving no valid protection in the patentee's single significant market. Interestingly (and of significant practical value in any commercial setting), an easy alternative to bringing a formal action for revocation existed in the UK by which a third party had the right to draw to the attention of the UK Intellectual Property Office (IPO) possible invalidity of a UK patent (eg an EP(UK) patent) based on a *whole contents* citation and to request revocation of the patent on that basis.

Case Study 2 illustrates the danger of allowing priority documents to publish, and to become state of the art for the purposes of *whole contents* anticipation, motivated in this case by desire to maintain the UK application until the EPC application appeared likely to succeed. Different motivations apply in the more damaging context of EPC applications claiming priority from an earlier EPC application.

6 Changing the law?

6.1 Comments have been made on whether the law should be changed. Although none is preferred by this writer, they add value to the debate. Two recent opinions are briefly referred to below.

6.2 Bobzien & Drope⁶⁰ is correct in stating that conventional belief has been that claim broadening on filing a priority-claiming application would not give rise to *whole contents* conflicts between family members. This, however, was based on a perception that the tests for priority entitlement would result in symmetrical priority across eg a divided family. This isn't so. Bobzien & Drope also states that there are no comparable decisions to T1496/11 *supra* in jurisdictions outside EPC. In fact, apart

from UK Court decisions mentioned in the present paper, Toxic Priority has been addressed by the Australian Federal Court in a case involving the same patentee as in T0571/10 and patents equivalent to the family that decision features⁶¹. Bobzien & Drope suggest that the law should be changed by means of an EBA Decision to excuse anticipation pursuant to Toxic Priority – in essence, a carve-out. However, no basis for the EBA so deciding is given. The EBA referral from T0557/13 may or may not go that far.

6.3 Wohlmuth⁶² looks at national law change for solutions in relation to Unified Patents, requiring agreement across the participating states. But this is a long term suggestion which, in any event, offers no remedy for the more likely encountered aggregate challenge to an EPC patent application which could come from another EPC member of the same family. Wohlmuth's analysis of T1222/11 adopts the same views in principle as those which are used to support T1222/11 in Pearce & Falconissupra, in this writer's view erroneously. With existing toxicity in mind, Wohlmuth suggests reformulation of claims as "OR" claims and deployment of disclaimers, an approach that will depend on the merits in each particular circumstance but which, on the face of it, might be less attractive than an approach based on the T1222/11-centred ideas in the present paper.

7 Round-Up

7.1 The concepts of partial and multiple priorities have lacked the operational clarity needed to make them workable in the manner business users of the European (EPC) IP system expect. Some commentators argue that parties have not brought the issue before tribunals with sufficient frequency or depth. This in turn can be argued to be because the issue does not arise often (and when it does, that cases are necessarily fact-specific and decisions necessarily case-specific). There is some truth in these arguments but it can also be argued that G0002/98 missed an opportunity of examining the issue of partial and multiple priorities in depth, setting out instead an interpretation of Article 88 (2) EPC which took lower appeal boards down a 10 years long uncorrected wrong road which masked the fundamental concepts needing debate.

7.2 Abandoning the notion that a specification whose claims are under priority date assessment must exhibit content rendering a domain of the claim recognisable as such, massively expands the effective scope of Article 88 (2) EPC as a useful apparatus. That in turn gives rise to a need for protocols on how the resulting freedoms are exercised and questions on what their effects will be. Apart from anything else, G0002/98's tests look different in the new milieu hopefully created post-T1222/11. This is not easy territory. But the challengingly algebraic

60 "Divisionals Reloaded: T 1443/05 and Poisonous Divisionals", C Bobzien and R Drope, Journal of the European Patent Institute (EPI Information), Issue 3/14, September 2014, 110-111

61 "Poisonous Priority Arrives in Australia and New Zealand", Michael Caine, Davis & Collison, November 2014 (<http://tinyurl.com/lhoodjw>)

62 "Potential Solutions for prior art under Art. 54 (3) EPC of the same patent family", J Wohlmuth, Journal of the European Patent Institute (EPI Information), Issue 3/14, September 2014, 112-114

thinking needed for the document comparisons involved in implementing Article 88 (2), (3) EPC will inevitably be so; the alternatives are less attractive. The recent referral to the EBA is a welcome event which may move the situation towards the end of the quotation at the head of this paper.

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Dr Kinkeldey is a European Patent Attorney; a former Permanent Member of the EPO Enlarged Board of Appeal and the former Chair of EPO Technical Board of Appeal 3.3.4.

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Professor Sir Robin Jacob, formerly Lord Justice Jacob of the Court of Appeal of England & Wales, as a very early peer reviewer.

The views in this paper are those of its author and no-one else

New Year, New Chinese Specialized IP Courts, Relevant for EP-Stake Holders

F. Gao (US-Attorney at law) and P. Rosenich (EP-Patent Attorney, LI)

In order to improve the quality and consistency of IP case judgments as well as the efficiency of IP case handling, China has put legislation in place to address these efforts. It seems that China is overtaking European UPC-activities by far in terms of speed:

On 31 August 2014, the National People's Congress of China released the *Decision of Establishing Specialized IP courts in Beijing, Shanghai and Guangzhou*. ([See the original press release](#)). Subsequently, on 31 October 2014, the China Supreme People's Court issued the *Provisions on the Case Jurisdictions of Intellectual Property Courts in Beijing, Shanghai and Guangzhou*. ("[Provision](#)")

The Provision has in total 8 Articles and addressed the issues of IP case jurisdiction and IP trial court hearing levels, including jurisdiction of first and second instance and appeal cases, cross-regional jurisdiction, exclusive jurisdiction, the treatment of existing pending cases, etc.

The three specialized IP courts will have jurisdiction over the following first instance cases:

Civil and administrative cases involving patents, new plant varieties, layout design of integrated circuit, technological secrets and computer software;

- Administrative cases involving copyright, trademark, unfair competition and other administrative action against department of the State Council or local people's governments that are above the county level;
- Civil cases regarding the recognition of well-known trademarks.

The three specialized IP courts will have jurisdiction over second instance civil and administrative cases involving copyright, trademark and unfair competition cases heard at first instance by local people's courts.

Beijing IP court has exclusive jurisdiction over the following appeal cases:

- IP rights ownership dispute decision involving patents, trademarks, new plant varieties, layout design of integrated circuit;
- Compulsory licensing decisions and compulsory licensing royalties or compensations awards relating to patents, new plant varieties, and layout design of integrated circuit;
- Other administrative actions involving the authorization and determination of IP rights.

The Beijing and Shanghai IP courts will have jurisdiction over the cases in their respective cities, while Guangzhou IP Court will have cross-regional jurisdiction over the entire Guangdong province.

As to now, all the three IP courts have been successfully established and have started hearing cases. To break down, Beijing IP Court has 22 judges, was established on 6 November 2014 and started hearing cases on the same day. Guangzhou IP Court has 10 judges, was established on 16 December 2014 and started hearing cases on 21 December 2014. Shanghai IP Court has 10 judges, was established on 28 December 2014 and started hearing cases on 1 January 2015.

From this recent development, we can see China's determination of overturn its once upon a time reputation as "copy cat" and focus on encouraging and strengthening IP. For European companies, it means that, when a Chinese company infringes their IP rights, a more experienced and specialized judge will hear that case and one can expect IP rights being respected by the justice. However, it is also very important to raise our attention to this strategic market once again and revisit any doubts like "Do I need to register my IP rights in China?".

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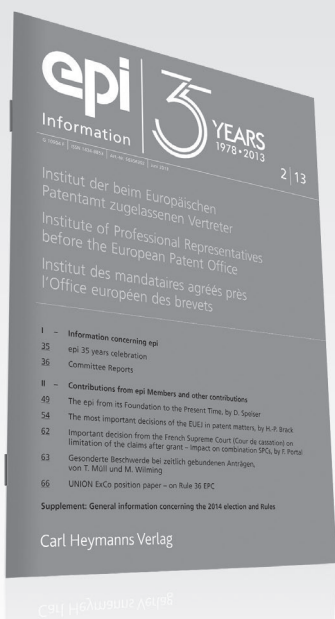
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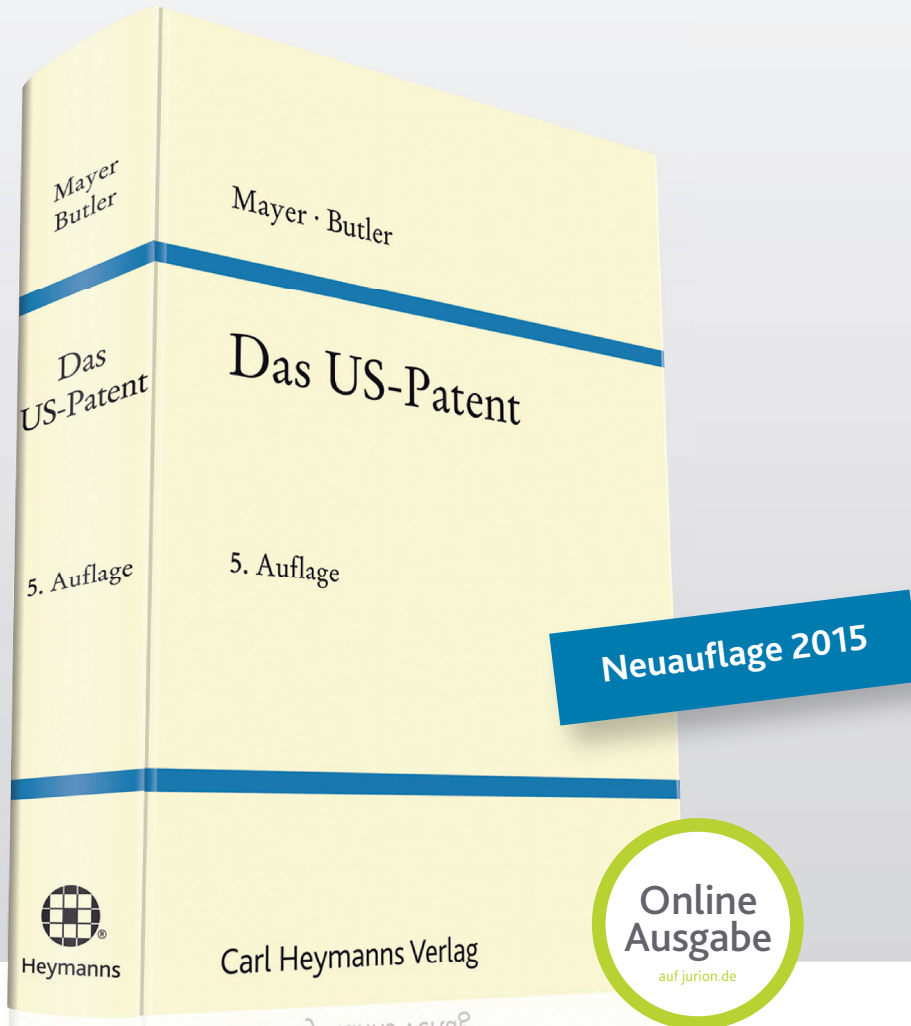
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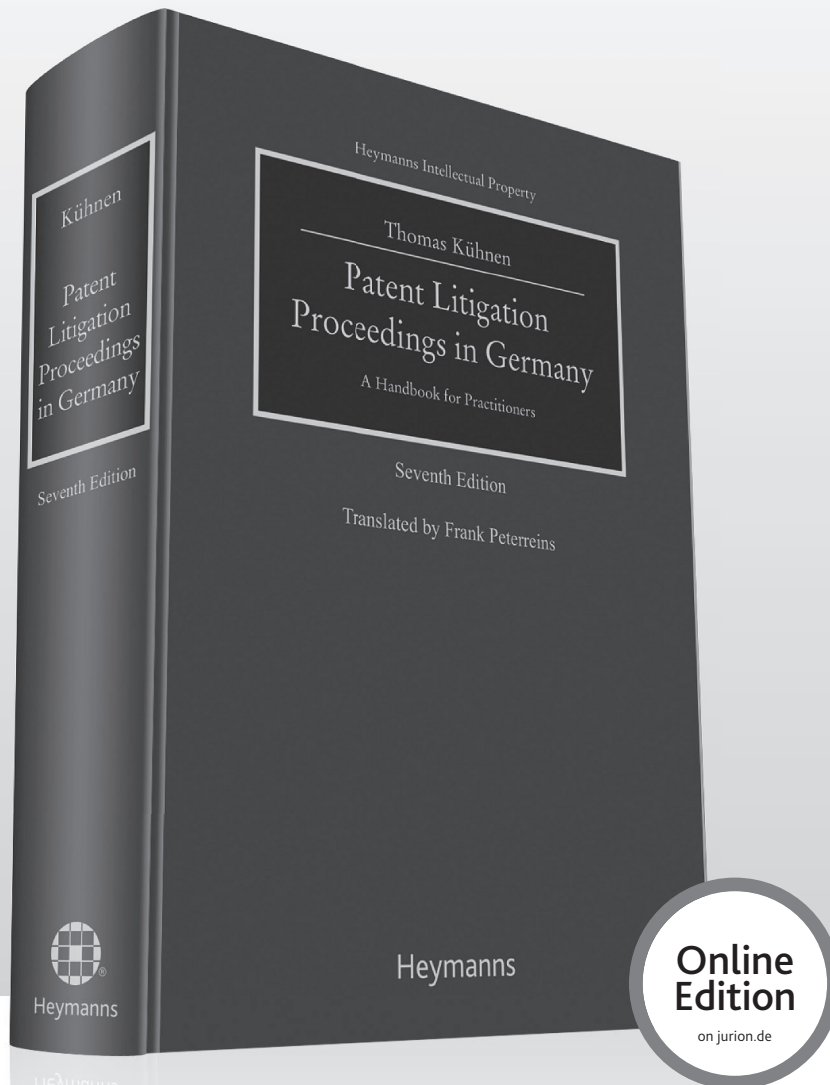
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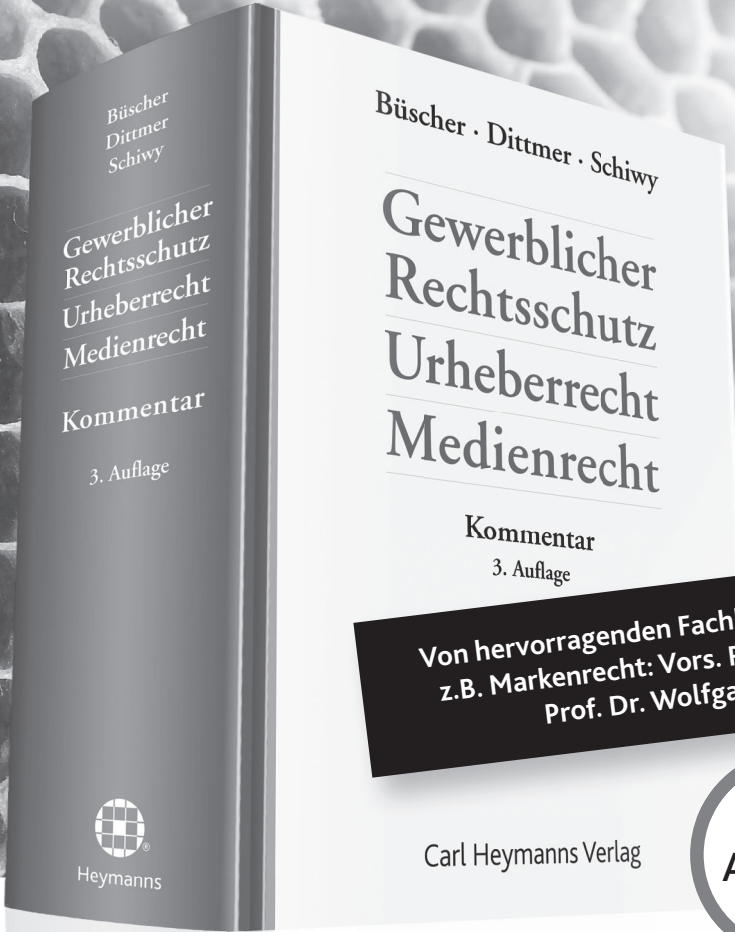
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