# epi Information

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Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets


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# Editorial

T. Johnson (GB)

The Greek philosopher Heraclitus proposed the doctrine of change being central to the Universe, summed up by the expression, "change is the only constant". This dictum can be applied to many areas, not the least the EPO where several changes have taken place recently. This year for example, the Office is publishing its annual report online, a boon for users. The report shows that despite the economic crisis, patent applications reached 244 000 in 2011, an increase of 3.7 %. That year too, 62115 EPs were granted, a 7 % increase over 2010.

In addition, the EPO and Logica have signed an agreement which is aimed at helping the Office establish a management system for digitally processing patent applications. This is intended to cover all stages of an application's life up to grant, and also to manage oppositions and appeals. The system is due to be rolled out gradually from April 2013 with full implementation during 2015.

Another change was the joint launch with Google earlier this year of Patent Translate, which could simplify the patent system, including the unitary patent when (?) it comes into force.

Yet another EPO agreement was the one signed in February this year with the JPO whereby Japanese documentation will be supplied for use in the EPO machine translation project.

These are just some of the changes taking place and we believe support Heraclitus' doctrine, which does not include the idea of "change for change's sake". The projects we have mentioned are, we believe, innovative and to be encouraged as they should improve the EPO system for all who are involved in it, including applicants. Our Institute being part of the European Patent Organisation will be following these changes with constructive interest.

Lest it be thought that our Institute is not changing we can give one example of a change which is aimed to provide improved access to the Institute for all our membership and other interested parties. This change is for a radical re-design of the Institute's website, which is an exciting project which if realised will benefit all the users of the system too, or so we on the Editorial Committee believe.

Heraclitus lives on!

## 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 **10. August 2012**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

## Next deadline for *epi* Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi* Information is **10th August 2012**. Documents for publication should have reached the Secretariat by this date.

## Prochaine date limite pour *epi* Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de *epi* Information est le **10 août 2012**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

# Report of the Disciplinary Committee

P. Rosenich (LI), Chair of Disciplinary Committee

## 1. Disciplinary Case CD 5/10 (San Marino)

At the last Council the Chairman of *epi* Disciplinary Committee was asked about a Complaint which was filed with and decided by a Chamber of the Disciplinary Committee regarding the surprising high number of Grandfathers entering the *epi*-Member-List when San Marion acceded.

Without going into details it can be stated that the Chamber Westerholm decided in their decision CD 5/10 to hand over this case to the Disciplinary Board. Since then the case is pending before the Disciplinary Board (the second half of the first instance in disciplinary matters).

## 2. Procedure when matters are sent to the Disciplinary Committee „just for information" by an *epi* Member.

The Chairman of the Disciplinary Committee decided to not hand over a letter containing information with some relevance to disciplinary Questions to a Chamber unless said *epi* Member sends a detailed complaint.

*The situation was this:*

A first European Patent Attorney filed a claim "Strafanzeige" against another European Patent Attorney with a local executive body.

The first European Attorney sent a plain copy of said claim to the *epi* Disciplinary Committee. No request regarding disciplinary proceedings was attached and no reasoning with regard to *epi*'s Code of Conduct was provided. The Chairman of the Disciplinary Committee decided not to hand over the copy to a Disciplinary Chamber but to ask in writing if said first Attorney requested disciplinary proceedings.

*The reason for this decision was:*

a) Local executive bodies like Police or Courts have better investigative powers than the Disciplinary Committee. From this follows that said bodies may easier investigate what really happened. When the facts of the case are then available, the Disciplinary Committee can eventually use these facts in later disciplinary procedures. For that reason it does not make much sense to keep disciplinary proceedings running in parallel to Police or Court actions/proceedings.

b) Said claim did not contain a reference to the Code of Conduct and to a concrete **disciplinary** misbehavior of the Defendant. For that reason it was not prima facie obvious in which way the defending Attorney acted against the *epi* Code of Conduct.

c) If an *epi* Member (European Patent Attorney) files a request for disciplinary proceedings against another *epi* Member it is expected that the complaining Member should provide a detailed and substantiated request based on the provisions of the Code of Conduct.

## 3. Request for Court-experts from *epi* (DC)

An *epi* attorney asked NOT for a Decision by a DC-Chamber BUT for an advice and an Expert for a Court hearing in a Civil Court Action against another *epi* Member. The Chairman of DC decided that such advice could not be given from DC and proposed that the attorney contact the Professional Conduct Committee. Its Chairman gave some advice related to proper e-mail correspondence between *epi* Members and clients. The President agreed that *epi* Experts could present *epi* practice in Court hearings within the frame defined by the Chairman of the Professional Conduct Committee. Two Members of DC volunteered to act as Experts. The requesting *epi* Attorney received the names of these Experts and thanked the *epi* for its help. It seems that at this stage of proceedings the Experts will not be invoked in the Court hearing.

## 4. DC-Meeting 10th-11th June in Athens

The main topic will be: Mediation Training for the (new) Members of DC.

Also a proposal of Edward Lyndon-Stanford will be discussed regarding a possibility to publish cases if the defendant is frequently found guilty in breaching the Code of Conduct.

## 5. Cyprus has not yet nominated a member for DC. The Chairman found and proposed a Member from another Country who was willing to work in DC on the CY-seat.

The CY-Council Member promised alternatively to try a final time to find a member from Cyprus. The Secretary General and the Chairman agreed to this procedure.

## 6. French Chamber Debled lost it's Rapporteur due to professional work overload. The Chairman asked successfully for a substitute Member from another Chamber to fill the gap.

# Report of the EPPC to the *epi* Council

F. Leyder (BE), Chair of EPPC

This report completed on 09.05.2012 covers the period since my previous report dated 10.02.2012. There is little to be added.

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

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

**DG3**

*1. Meeting with VP3*

A delegation of Presidium and EPPC members met Mr van der Eijk, new Vice-President DG3 and Chairman of the Enlarged Board of Appeal since 01.12.2011.

**UNITARY PATENT**

*2. European patent with unitary effect in the participating Member States*

No new document has been posted on the website of the Council (http://register.consilium.europa.eu/).

On the website of the Parliament (http://www.europarl.europa.eu/), both procedures are still flagged "Awaiting Parliament 1st reading/single reading/budget 1st stage", but with an indicative date that has now been postponed *sine die*.

**PCT**

*3. PCT Working Group*

The 5th session of the PCT Working Group is summoned for the week from 29 May to 1 June 2012 in Geneva, Switzerland (where Monday 28 May is a holiday). The working documents will timely be posted on the WIPO website: http://www.wipo.int/meetings/en/details.jsp?meeting_id=25017

By the time this report will be published, a 'Summary by the Chair' should also be available.

In terms of future developments of the PCT system, I can mention a proposal to allow the Written Opinion by the ISA to be available as of the date of international publication (or even included in the international publication of the application), a proposal to conduct a top-up search in the international phase and to provide for an accelerated international search and examination, a proposed interim arrangement for filing of color drawings at offices that do not accept color drawings, and a proposal to distinguish in the ISR the documents that are destroying inventive step when taken alone from documents that destroy inventive step when combined with other documents.

**EPC**

*4. 41st CPL meeting*

At the 41st meeting of the Committee on Patent Law, the EPO submitted a proposal to amend Rule 53(3) EPC, pretty much in the line with the proposal posted on 15.12.2011 on the EPO website for public consultation, despite the objections raised by *epi* at the 6thSACEPO/WPR meeting. We submitted further comments. The proposal is now intended to be submitted to the Administrative Council at its June meeting.

# Report of the Harmonisation Committee

F. Leyder (BE), Secretary of Harmonisation Committee

This report covers the period since my previous report dated 12.02.2012.

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

## 1. AIPLA-*epi* meeting

On 8 March 2012, a delegation of AIPLA met a delegation of the *epi*. Less than two weeks before the meeting, the President invited the members of the committee who had attended the "Hearing of European Users on the Implementation of the 'America Invents Act' 2011 in Light of Harmonization Issues" on 16th February 2012 to join the *epi* delegation, as that Act was (of course) on the agenda.

The meeting was planned for two hours, with presentations by both delegations. In a nutshell, we understood that AIPLA expressed that it is time to start negotiating.

## 2. Committee meeting – Hearing at the EPO

As reported previously, Mr Lutz, Vice-President DG5, issued an invitation to a "Hearing of European Users on the Implementation of the 'America Invents Act' 2011 in Light of Harmonization Issues" on 16th February 2012.

An invitation was sent on 25th January 2012 to the committee members to join the *epi* delegation. The *epi* delegation comprised our President and both Vice-Presidents, four committee members, and a former committee member. The delegation met in the morning to prepare the afternoon hearing.

During the hearing, *epi* reaffirmed its opposition to any kind of grace period in the very interest of the inventors. It was interesting to note that BusinessEurope, to the contrary, appeared to support the idea of a grace period. There seemed to be a consensus that rulemaking could not change the fundamental issues that European users appear to have with the AIA.

Incidentally, we understood that the EPO would welcome any comments on derivation that the European users might wish to make.

## 3. 41st CPL

The EPO reported on the fact finding exercise carried out by the "Tegernsee Experts' Group" (see previous report). A further "Tegernsee Meeting" is planned after the summer.

## 4. Standing Committee on the Law of Patents (SCP)

At the 18th Session of the SCP (21st to 25th May 2012), John Brown and Francis Leyder represented *epi*. The SCP/18 working documents are available from the WIPO website: http://www.wipo.int/meetings/en/details.jsp?meeting_id=25016

At the time of writing this report, no progress had been made, and none could be foreseen.
By the time this report will be published, a 'Summary by the Chair' should be available.

# Report of the Litigation Committee

A. Casalonga (FR), Chair of Litigation Committee

The Litigation Committee prepared comments on the draft Rules of Procedure (RoP) for the new UPC. The comments were based on the eighth draft of the RoP dated March 30, 2012.

A position paper based on these comments was sent, after approval by the Presidium, to the Working Group on the future Rules of Procedure as well as to the EU Commission.

The position paper contains general remarks and specific comments on the draft Rules themselves.

Below are the general remarks.

## 1. Litigation cost

The *epi* considers essential that the overall costs of the procedure before the court be reasonable.

Therefore, the Rules of procedure should be drafted with the final aim of reaching a cost level approximately similar to the overall costs of Court Litigation in Continental Europe for example in France or Germany.

This aim is not only important in principle but also in view of the fact that parties will have the choice between the UPC and National Courts during a relatively long transitional period.

**2. Litigation duration**

The *epi* also considers that the overall duration of the Court procedure should be reasonable. It is important not only for both parties, plaintiff as well as defendant, but also for the acceptability and sustainability of the entire patent system in Europe that decisions of the first instance could be issued within approximately one year.

In the same way, decisions of the Court of Appeal should, in normal cases, be issued within approximately one year.

**3. Role of the Judges**

The Rules of procedure should allow the various Divisions of first instance, having panels with different national experiences, to apply the same rules. However, the Rules of procedure should not be so detailed that the Judges are caught in a network of rules that do not allow them to take short cuts in the procedure and to discard arguments of minor importance and unjustified extension of time requests. On the contrary, the Rules of procedure should allow the Judges to exercise a certain freedom and personal authority to conduct an efficient procedure.

The *epi* noted with satisfaction that Practice Directions are also contemplated to deal with the details of the procedure thus avoiding incorporation of too many details in the Rules of procedure themselves.

**4. Damages and costs**

In order to arrive at a reasonable duration of the overall Court procedure, the *epi* considers that each time it is possible, the determination of damages as well as costs to be paid by the losing party should be made by the Court and decided in the decision on the merits. Initiating a separate procedure for the determination of damages and costs should only be necessary in specifically complicated cases where an extension of the duration of the procedure could be accepted.

**5. Appeal procedure**

The *epi* considers essential that final decisions be of high quality i. e. clear, logical and accurate, fully taking into account the technical aspects of the patent. Taking into account the number of different Local and Regional Divisions which is to be expected and the proposed composition of the panels of those Divisions, the *epi* considers that the appeal procedure with a single Appeal Court and panels of five judges including technically trained judges is probably the most important aspect of the entire organisation.

Consequently the *epi* considers that the procedure before the Court of Appeal should allow both parties to present again the entire situation of the litigation including possible new facts and evidence which could not reasonably have been filed before the first instance court, as well as new nullity grounds if necessary. The appeal procedure should therefore not be a simple revision of the decision at First Instance. Only obvious abuses of the procedure and unjustified late presented grounds, facts and evidence should be rejected at the discretion of the Court.

**6. Witnesses and experts of the parties**

In order to limit as far as possible the costs and duration of the procedure, the *epi* considers that evidence by witnesses and experts of the parties should be strictly limited to the establishment of factual situations and technical questions. Witnesses and experts of the parties should not present legal arguments for example on obviousness, skilled person or on interpretation of patent claims or prior art documents. The procedure should be organised in such a way that the oral testimony of witnesses and experts of the parties is avoided unless really necessary, at the discretion of the Court.

Questions presented to a witness or an expert of one party during an oral examination should only be presented if agreed by the presiding judge.

**7. Preserving evidence**

The preservation and determination of evidence of an alleged infringement is considered by the *epi* as an essential feature of an efficient procedure. The Rules of procedure should therefore clearly authorize a plaintiff to proceed with the inspection of an alleged infringement as well as a description of said alleged infringement in all cases where it is necessary, at the discretion of the Court and without excessive consideration of the risk of destruction of evidence.

7.1 The Rules of procedure should make it easily possible for a plaintiff, based on reasonable arguments concerning the necessity of affording evidence of infringement, to obtain from the Court, without the other party being heard in advance, an order to proceed with an inspection, in accordance with Article 35a(4) of the draft Agreement.

This should permit the plaintiff to present to the Court a complete and detailed description of the alleged infringement.

7.2 This procedure (known in certain countries as "saisie" should however be carefully balanced, taking into

consideration the interests of the plaintiff as well as the interests of the defendant.

7.3 It should be limited to obtaining evidence of an alleged infringement and only

a) few samples of infringing products or

b) few samples of products used in an infringing process should be allowed.

7.4 The procedure should be handled by an independent person nominated by the Court possibly assisted by representatives of the plaintiff duly submitted to their professional rules of conduct including secrecy provisions. No employee of the plaintiff should be allowed to participate to this procedure.

7.5 Provisions should also be introduced in the Rules of procedure for safeguarding de confidentiality of certain documents and information. For example, it could be provided that photocopies of alleged confidential documents be kept in a sealed envelope or the equivalent by the independent person nominated by the Court so that the Court (the Judge Rapporteur) may decide subsequently whether those documents can be wholly or partly communicated to the plaintiff (if necessary only to certain specific employees of the plaintiff under a protective order).

# Biotech Committee
# Minutes of EPO/*epi* Meeting held on 10 November 2011

A. de Clercq (BE), Chair of Biotech Committee

**In Attendance:**

Thanos Stamalopoulos (GR)
Bernd Isert (BI, dir. 2404)
Uli Thiele (UT, dir. 2402)
Siobhán Yeats (SY, dir. 2403)
Victor Kaas (VK, dir. 2401, Munich)
Francisco Fernandez y Brañas (dir. 1222, the Hague)
Sjoerd Hoekstra (SH, dir. 1223, the Hague)
Maria Fotaki (MF, dir. 2405, Munich)
Aliki Nichogiannopoulou (AN, dir. 2406, Munich)
Imogen Scruton-Evans (GB, dir 2117, JCPAOC)

Ann de Clercq – BE
Günter Keller– DE
Bart Swinkels – NL
Anne Desaix – FR
Arpad Pethö – HU
Anne Schouboe – DK
Niklas Mattsson – SE
Dieter Wächter – CH
Anna Hally – IE
Olga Capasso – IT
Sisko Hillevi Knuth-Lehtola – FI
Liv Heidi Thoresen – NO
Simon Wright – GB

**Associate Members**

Gabriele Leissler-Gerstl (liaison member of EPPC) – DE

**Introduction**

Mr Stamalopoulos gave a warm welcome. He said that from the EPO's point of view this is a nice event and it fits in well with their policy to meet users. As a service provider, the EPO aims to give a good service. Any newcomers to such EPO/*epi* annual meetings were welcomed, including the Director from the Pure and Organic Chemistry Joint Cluster.

1. *Developments since the WARF decision (G2/06), and possible impact of the ECJ decision on stem cells.EPO policy on stem cells.*

The recent CJEU Brüstle decision (C34/10) was discussed. The decision is somewhat vague, although potentially it might exclude any invention which at some stage necessarily involved the destruction of an embryo. At the time of the meeting the EPO's policy was that the morality exclusion can be overcome if one can refer to a public hESC cell line deposited after May 2003. There have been a handful of cases going to grant on this basis. Note that in the WARF decision G2/06 the EPO decided it could not refer any questions to the ECJ, as the EPO was not a court of a national state.

The Brüstle decision answered three questions. For the first time it gave an EU-wide definition of an embryo. The EPO is currently evaluating its practice, and a document may be prepared by the Legal Department to be submitted to the CPL meeting in December. The decision may be incorporated into the new Guidelines.

Note that the EPO adopted the EU legislation (Biotech Directive) for harmonization reasons. Whilst the EPO may not be able to refer such matters to the CJEU, that

doesn't mean to say that it cannot follow an ECJ decision. It was argued that the EPO should not grant patents that would be potentially invalid in national states. If we have different claims for different states then that could be seen as disharmonious. It was noted that President Batistelli had commented on the decision in his blog, and suggested that the EPO would follow the ECJ decision.

*2. Impact of EBA decisions G1/07 and G2/08 (Broccoli and Wrinkly Tomatoes), and further developments.*

These decisions effectively said that the breeding methods for plants that involve sexual selection are excluded. Adding additional steps may not make the method patentable, and back-crossing techniques may also be excluded. Both cases were referred to the TBA, and on the Broccoli case Oral Proceedings were due to take place on 26 October 2011. The Board of Appeal cancelled the Oral Proceedings in the Broccoli case due to the filing of amended requests and the case will continue in writing. In the tomato case a hearing was held before Board 3.3.04 on November 8, 2011 and the Applicant had removed all claims to crossing and selection, and so had retained only product claims. Unilever, the Opponent, argued that it would be improper for the EPO to grant claims on products if methods of producing them were unpatentable. The Board said that it would refer this issue back to the EBA. The questions have not yet been formulated, but Unilever have suggested some. This is the first time ever that one particular case has received two referrals to the EBA. Note that the EPO has only a handful of cases on pure breeding methods (one relates to melon, and the other to lettuce). On a sunflower case there was a decision last March, but this concerned whether what is claimed is a variety (or not).

*3. EPO's new rules: impact on applicants*

Concern was expressed by the *epi* at President Batistelli's blog, stating that the grant rate in biotech (about 28 %) was lower than the EPO average grant rate. It was noted, though, that about 90 % of biotech cases do not have ethical/morality issues. The biotech cluster performs about 10,000 searches a year, and grants about 3,000 cases.

Generally speaking, the change to a 6 month term for the Rule 161 Communication was welcomed. There was, however, little experience of practice under Rules 62 and 63, and such issues have not been raised on that many cases. It was uncertain whether Rule 63(2) could be raised as a reason for not searching.

It was noted that some Applicants are now contacting Examiners just before the 2 year deadline after the Examining Division's first communication, in order to clarify the situation on disunity. This is to decide whether divisional(s) were required. It was noted that if one restricts to the first invention during examination, and then one gets a further disunity objection, then that objection should be treated as a new one, under Rule 36 (1)(b).

The *epi* called for an end to "precautionary" disunity objections, for example where Examiners suggest that one might be raised later. The *epi* welcomed the EPO asking Examiners to include a standard clause explicitly stating if a new disunity objection is being raised. Examiners have now been asked to do this wherever a new disunity objection is going to appear, as a result of internal instructions.

*4. Disunity practice*

The *epi* said that their perception is that disunity objections have increased, and that Examiners are now less likely to accept a common inventive concept. The EPO remarked that there were lots of cases with large numbers of sequences, and that applicants should try to ensure that these sequences have a (smaller) common sequence, as well as a common function (if possible). The *epi* thought that Examiners seem too ready to accept lack of novelty, and can use (lack of) clarity and support issues in order to justify disunity. These are substantive issues which are perhaps better suited to examination, rather than the search stage. It was noted that applicants cannot challenge the Examiner's view at the search stage, and even if one tries they rarely change their minds.

The protest procedure now involves three people from the EPO. A workshop or other follow-up on the issue of disunity may be pursued, perhaps through the EP academy. The EPO requested concrete examples from the *epi*, and possibly some statistics, where disunity has been wrongly raised. The EPO said that they will tackle inconsistency, but need examples first. They were sympathetic over the short two year divisional deadline, and it was agreed that before long we may see a test case where the only reason for a refusal was under Article 82.

*5. Restricted admissibility of functional features in order to seek broad protection*

The *epi* is seeing many objections based on lack of support and/or lack of inventive step and sufficiency across the breadth of the claim. The EPO may have only searched the exemplified embodiments and argue that the claim should be limited to these exemplified embodiments.

Functional features will be allowed, but structural features are preferred. Inherently, it was argued, claims to compounds defined by functional features have an indefinite number of possibilities (this was agreed, but that is not necessarily the issue, especially if that does not necessarily lead to sufficiency problems). Claims with functional features, but no structural ones, can be more difficult to search. For example, what happens if a compound in the prior art has that function, inherently, but that function is not disclosed in the prior art?

*6. Sequence listings and fees payable therefor.*

Changes were announced in the Notice of the President in OJ 6/2011, 376, without prior consultation with the *epi*.

The EPO said that divisionals need their own sequence listings as the description or claims may be different from the parent application. It is still not clear to the *epi*, though, why one cannot refer to a sequence listing on a

parent case, if the sequence listing to be filed on a divisional application is identical to that filed on the parent.

It was noted for e-filed PCT cases at the EPO, subsequent documents (such as sequence listings!) could not be e-filed. This will be taken up within the EPO.

*7. Conducting Oral proceedings*

It was noted that some Examiners are setting very short deadlines, with little more than the minimum of 2 months. The EPO suggested that Applicants could ring Examiners if they would like to re-schedule, and indeed most Examiners should re-schedule if requested. It was noted that new objections in Summons were neither discouraged nor encouraged.

*8. Inventions in the area of pharmacogenomics:*

This concerns cases which are based on a genetic marker to treat a disease, for example methylation profiles. It can involve a new patient group defined by an SNP. The EPO said that often the claims can lack novelty, as one patient will have inevitably been treated with the SNP, even if the art does not explicitly say so.

*9. Third party observations (TPOs): does the new online tool encourage more third party observations?*

Examiners will now always comment on the TPOs, even if it just to say that the observations are no barrier to grant. The EPO will now accept observations after issue of the Rule 71(3) notice. However, they will not be considered after the decision to grant notice has been issued. It was noted that observations were most often filed on vaccine and antibody cases, and occasionally on plant applications.

*10. Changes regarding the two types of 2nd medical use claims*

It was noted where there may be an issue of double patenting for Swiss-style and EPC 2000 style claims. In other words, would one be able to get two separate European patents, one for each type? There is likely to be a test case on this. It was noted that one cannot switch between these two types of claims post-grant.

The meeting closed at 12 noon.

# Mock EQEs 2012

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

Participants may sit any combination of papers.

**Scheduled events:**

Helsinki:

| | |
|---|---|
| Mock EQE: | 15–17 October 2012 |
| Feedback session: | 14–16 November 2012 |

Further information to follow on *epi* website:
www.patentepi.com –> EQE and Training

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

| Issue | Deadline | Publication |
|---|---|---|
| 3/2012 | 10 August 2012 | 30 September 2012 |
| 4/2012 | 02 November 2012 | 30 December 2012 |

# Training for the EQE pre-examination 2013

A. Zellner (DE), EPO, European Patent Academy

Starting in September 2012 candidates will again have the opportunity to take a comprehensive online course jointly developed by the *epi* and the European Patent Academy. An EQE pre-examination training course ran for the first time in 2011-2012. The new course will be a considerably extended version of the original one.

The 2012/13 course is aimed at students preparing for the pre-examination on 25 February 2013. It comprises various e-learning components including:

– in-depth articles on major examination topics plus multiple-choice questions to ensure that the important points of each topic are fully understood
– recorded lectures
– further sets of multiple-choice questions
– in-depth case studies
– virtual classroom sessions to give students an opportunity to ask selected experts questions in real time
– access to the *pre-examination course forum*, a dedicated support area monitored by the course tutors.

Registration starts in July 2012, at which point a preview of the course content will also be available. It will contain a course outline and at least one full topic plus questions.

To receive notification and latest updates, please sign up at www.eqe-online.org/pre-exam/course/.

# Seminars introducing the EQE to potential candidates

A. Zellner (DE), EPO, European Patent Academy

The European Patent Academy jointly organises seminars with the *epi* and the CEIPI that are designed to raise awareness of what is tested in each of the different examination papers and the knowledge and skills required to pass. The participants get an understanding of the concepts behind the different papers and an insight into the critical factors, along with information on how to structure their preparation. They also get a basic understanding of what the examination committees expect by way of a correct answer.

This year a session took place in Oslo on 15 May. Registration will soon open for a second session to take place in Warsaw on 5 October. Other locations and dates can be arranged on request.
Contact: *profrep@epo.org*

# Take a look at the EQE Forum

A. Zellner (DE), EPO, European Patent Academy

When launched in 2006, the Forum was intended to facilitate discussion amongst EQE candidates. In the meantime, it has been developed to become a central information and training platform. More than 12 000 posts in almost 3 000 different threads are currently available to users. Since the beginning of 2010, there have been over 200 000 visitor sessions. To run through the services it offers, see: www.eqe-online.org

## Tutors wanted

As *epi* is always looking to add new tutors to its current group we would like to know whether you are – in principle – interested in participating in this activity. In case you decide to volunteer your commitment is conditional: you will always be asked whether you are willing to tutor in a specific event.

Please volunteer by filling in the form available on the *epi* website (*www.patentepi.com* –> EQE and Training).

For any further queries, kindly contact the *epi* Secretariat (*education@patentepi.com*).

## 10th CEIPI *epi* Course on Patent Litigation in Europe

The programme of the 2012/2013 CEIPI *epi* Course is available on the *epi* website *www.patentepi.com* as well as on the CEIPI website *www.ceipi.edu*

For further information or application, please refer to Walter Holzer (Course Coordinator) *WHolzer@gmx.at*

## CEIPI preparation courses for the EQE pre-examination and main examination 2013

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

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

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

The main seminar will take place from 5 to 9 November 2012. It will cover relevant topics which can be expected for the pre-examination. It will give participants the opportunity to apply their knowledge in a mock examination.

The course fee is EUR 1 400. Closing date for enrolment is 1st October 2012. More information can be obtained from christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

As a complement to this seminar, the CEIPI offers a pre-exam "Cramming Course" as a last minute opportunity to candidates wishing to improve their skills in respect of this paper. Participants will sit a paper under exam conditions, followed by a discussion of the drafted papers with the tutor. This Cramming Course will take place on 8 February 2013 inStrasbourg.

The course fee is EUR 500. Closing date for enrolment is 4 January 2013. More information can be obtained from christiane.melz@ceipi.edu or from the CEIPI website at www.ceipi.edu

For all papers to the EQE **main examination** 2013 (AB, C and D), the programme starts with "Introductory Courses" in the early autumn of 2012, in a number of different cities in Europe (Strasbourg, Paris, Copenhagen, Milan), so as to set candidates on the rails, as early as possible, in preparing themselves.

The introductory courses are followed by the "Preparatory Seminars" in November 2012 and January 2013, centrally in Strasbourg, France, which build up on the introductory courses and expand on the issues treated, as well as provide for working on a mock exam under exam conditions, which is then compared with a CEIPI "model solution".

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

For paper C, which every year appears to be one of the major stumbling blocks of the EQE, this programme is

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

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

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

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

The program is as follows (more extensive information is contained in OJEPO 4/2012):

**„Introductory Courses" 2012:**

| Paper | Milan (EN) | Copenhagen (EN) | Paris (FR) | Lyon (FR) | Strasbourg (EN, DE) | Paris (EN) |
|---|---|---|---|---|---|---|
| AB | 21./22.09. | 21./22.09. | 28.09. | | 29.09. | 28.09 |
| C | 5./6.10. | 5./6.10. | 29.09. | | 28.09. | 29.09 |
| D | 12./13.10. | 12./13.10. | 7./8.09. | 14./15.09 | 26./27.09. | 26./27.09 |

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

Closing date for enrolment is 20 July 2012.

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

**„Preparatory Seminars" 2012/2013:**

The AB seminar will be held in Strasbourg, from 26 to 28 (am) November 2012, the C seminar from 28 (pm) to 30 (pm) November 2012. Both parts can be booked separately.

The D seminar will be held twice in Strasbourg, from 7 to 11 January 2013 and from 21 to 25 January 2013. All seminars are intended for those who wish to sit the EQE main examination in 2013.

The fee is EUR 1 400 for the five-day courses (ABC or D); for the AB or C part on its own the fee is EUR 725.

Closing date for enrolment is 1st October 2012.

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

The "Special C-Resitter" course 2012 will be held in Strasbourg on 23 and 24 November 2012.

The course fee is EUR 850. The price includes the "C-Book", 3rd edition.

Closing date for enrolment is 1st October 2012.

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

The "Cramming" course 2013 will be held in Strasbourg (EN, DE) on 7 and 8 February 2013 and in Paris (FR) on 2 February 2013.

The fee for the Strasbourg course is EUR 650, for the Paris course EUR 500.

Closing date for enrolment is 4 January 2013.

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

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

# Next Board and Council Meetings

**Board Meetings**

87th Board meeting on 6th October 2012 in Istanbul (TR)
88th Board meeting on 23 March 2013 in Stockholm (SE)
89th Board meeting on 28 September 2013 in Riga (LV)

**Council Meetings**

73rd Council meeting on 10th November 2012 in Hamburg (DE)
74th Council meeting on 19/20 April 2013 in Vienna (AT)

# News from *epi* Council

At the 72nd Council meeting the following elections were carried out:
Mr Lars Estreen (SE) was elected Board member for Sweden
Mr Luigi Sansone (MT) was elected Board member for Malta
Ms Valérie Mellet (LU) was elected substitute Council member for Luxembourg
Mr Filippo Santi (IT) was elected full member of Harmonisation Committee
Mr Enrique Armijo (ES) was elected full member of Litigation Committee
Mr Gian Giuseppe Masciopinto (SM) was elected full member of Litigation Committee
Mr Inigo Elosegui (ES) was elected substitute member of Lititgation Committee

# *epi* meeting room

The *epi* Secretariat provides a convenient meeting room free of charge for all *epi* members. You can use the room to meet with your clients or prepare for oral proceedings.

Located within walking distance to the EPO Building PschorrHöfe and only a few minutes walk from the central station you will find a light and airy room equipped with:

- Flipchart
- Whiteboard
- Wireless Internet
- Video projector
- Catering on request (at own charge)

Size: 31 qm
Persons: max. 14
Seating: flexible
Open: Mo – Fr
8am to 5pm

# Contact Data of Legal Division

# Update of the European Patent Attorneys database

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by *epi*. Therefore, to make sure that *epi* mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 523 of any change in your contact details.

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

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

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

Thank you for your cooperation.

# FICPI World Congress and Executive Committee Meeting, Melbourne, 15–21 April 2012

T. Johnson (GB)

The FICPI World Congress takes place generally every three years, usually in conjunction with a meeting of the Executive Committee, the FICPI body effectively equivalent to the *epi* Council. I attended both meetings.

The Congress theme this time was Communication and Co-operation, with a sub-text of contending with creeping centralisation in contracting countries. There were several Congress sessions to address these themes, including "Judges Without Borders – how Judges use Decisions from other countries"; "Offices Working Together with Users for a Better IP World"; "A Single Patent in Europe (at Last?)"; and "Centralised IP: Where is the Profession Going?". The background papers will be available on the FICPI website, www.ficpi.org.

FICPI invites sister organisations, of which our Institute is one, to these meetings. I had the honour of representing the *epi* in place of our President. In addition to sister organisations the official side is also invited; Philippe Baechtold of WIPO gave a presentation of the latest work being undertaken by WIPO, for example continuing work on the Roadmap, and taking steps to enhance International Preliminary Examination .

For our Institute I gave a brief report to the Executive Committee on Council position papers of mutual interest, namely on the UPC, stem cell patenting, how we co-operate with the EPO, the Praktika Extern Programme, and our appointment of a Director of Education, Karl Rackette. I gave a resume of his role and mentioned that Karl is a FICPI member too. As readers will appreciate most of the themes I have mentioned are also of interest to FICPI too, particularly that of providing a quality qualified profession in each country.

The World Congress marks the end of one term of the International President of FICPI and election of his or her successor for the ensuing three years. In Melbourne Peter Huntsman (AU) stepped down as President and Bastiaan Koster (ZA) was unanimously elected as the new President of FICPI for the next three years. The next World Congress is scheduled to be held in South Africa, probably in Cape Town, in 2015.

# Statistics, their use and abuse, and the EQE

J. Boff (GB)

In *epi* Information 4/2011 G. Checcacci gave an interesting and detailed article on the calculation of EQE pass rates, showing how the current system could give many false impressions, and warning that the new pre-examination may require additional care in analysis.

Concentration on numbers can be unhealthy, particularly if they are the wrong numbers, and perhaps it is time to step back and consider what information provides the best information to all of the parties involved: the candidates; their employers; their trainers; and the EPO.

**To each candidate**, what is most important is *when* they become fully qualified. The candidate is interested in qualifying in the minimum possible time, with the minimum number of examinations. At present candidates can only guess how long this might take, and their guesses may be heavily influenced by those they are working with. This means that it can be difficult for a candidate to assess the quality of their own training.

**For employers** the time to qualification is most important, as this determines when the candidate can act independently. Employers are also interested in the candidate's preparation and examination incurring the minimum cost and disruption, and so the number of times a candidate sits is of interest.

**For trainers** [and this includes employers, independent trainers, national constituencies and associations] the time to qualification reflects on whether their training regime is sufficient to get candidates qualified in a reasonable time. The pass rate of given papers may be of interest for trainers who concentrate on preparing candidates for particular papers: but for those involved in the complete training of a candidate, the pass rate will be of less relevance.

**For the EPO** the most important statistic is the number of times candidates sit the exam. Each exam paper sat costs the EPO money (although this may change as the number paying extortionate fees for fourth and subsequent resits escalates). The candidate that is well prepared and qualifies with few or no resits incurs lower costs to the EPO than the candidate who frequently resits. That is why escalating examination fees have been introduced. Although escalating examination fees punish candidates who sit the examination "too early", they do not provide information to the candidate as to when "too early" might be.

The pass rate for a given paper in a given year does provide some limited information; but not as much as one would at first think [see the Checcacci article].

Thus it appears that there are two statistics that would be widely useful [time to pass, and number of times sat] and one that appears of only narrow use [percentage pass rate].

Accordingly I suggest that in addition to the pass rates, further more useful statistics be presented each year.

**The first statistic** would be an indication of how long the passing candidates and the failing candidates [for each paper, and the examination as a whole] have been in the profession.

This information is in principle readily calculable, requiring just one date for each candidate, determining the difference from the date the results issue, and then a simple average. Expressing this average in years from entry into the profession is possible, although expressing it as a number of days may make it easier to understand.

A candidate cannot pass within 1000 days from entry into the profession [due to the three year qualification period] but it would be nice to know whether the candidate can expect to be qualified in 2000 days. If the average time to pass exceeds 3000 days then there is a problem, particularly for those candidates who enter the profession late in life.

The average time from entry into the profession for those passing provides useful information to the candidates, and would be less liable to violent swings than the pass rate in any given year. This would be less likely to spread alarm and despondency than does the current concentration on pass rates.

Such statistics would also be useful in analysing the quality of the examination and the adequacy of training.

If the average time from entry into the profession for those passing is lower than for those failing, then there may be some problem candidates.

If the average time from entry into the profession for those passing is higher than for those failing, then candidates are on average taking the examination too early.

If the average time from entry into the profession, for passing and failing candidates, are identical; then it may indicate a reasonably balanced examination, even if the candidates are unbalanced, with some passing sooner than the average, and some later.

Having an average time to qualification allows candidates to assess themselves [and their trainers] on a more informed basis. Having a clearer understanding of where a candidate is compared to the average, will assist better decision making.

If the average time from entry into the profession for those passing differs significantly and consistently between papers, then it may indicate problems with some papers, but more likely it will indicate that some skills take more time to master than others, and candidates could consider this when deciding when to sit particular papers.

Of course, averages hide a lot of detail, and it could be worth including, for both passing and failing candidates,

additional information excluding extreme candidates [e.g. the range of average time from entry into the profession excluding the top and bottom deciles].

**The second statistic** would be the average number of times passing and failing candidates have sat each paper. Again a simple average may be applied.

Candidates currently have to indicate how many times they have previously sat a paper since 2010, so as to permit calculation of fees. There would be little difficulty in requiring them to provide the information for earlier years so as to ensure availability of statistics.

For the candidate, multiple sittings of a paper not only takes time and emotional energy, it costs more. The average number of sittings required to pass a particular paper, in combination with the average time to pass, will provide useful information to determine the extent of preparation required for each paper.

The benefits to be expected from better statistics include:-

- better candidate choices and preparation;
- lower costs and greater predictability for all parties;
- improved training;
- fewer rumours; and possibly,
- better structuring of the examination.

# Rule 137(5) EPC – An Irresistible Temptation?

Y. Robin (GB)* and P. Chapman, T. Hargreaves (Co-authors**) (GB)

## Background

European patent attorneys are familiar with the requirements of Article 123(2) EPC, according to which a European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the European application as filed.

A further limitation to the opportunity to amend the claims is determined by Rule 137(5) EPC, which recites as follows (emphasis added):

> Amended claims may not relate to *unsearched* subject-matter *which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept*. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63.

Rule 62a relates to limitations of the European search in the case of a plurality of independent claims in the same category. Rule 63 relates to limitations of the European search in the event that it is impossible to carry out a meaningful search.

A recent increase in the number of objections raised by European Examiners under Rule 137(5) EPC has been observed. In this article the author discusses the nature of and legal basis for such objections, and suggests a number of practical measures to reduce the risk of triggering objections under Rule 137(5) EPC.

* Yann Robin is an associate at the Glasgow office of Marks & Clerk LLP
** Paul Chapman and Tim Hargreaves are European Patent Attorneys and partners at the Edinburgh office of Marks & Clerk LLP

The following are simplified real life examples of claim amendments which triggered objections under Rule 137(5) EPC.

### Example 1

| | |
|---|---|
| Independent Claim 1: | Product comprising A + B. |
| Independent Claim 2: | Product comprising A + C. |
| Dependent Claim 3: | Product according to claim 2, further comprising D. |

A product comprising feature A is known from the prior art. The EPO therefore raised an objection of lack of unity between claim 1 and claim 2. As a result, claim 1 was searched, while claims 2 and 3 were not searched.

During prosecution, claim 1 was amended to incorporate feature D. The combination of features A, B and D found clear and unambiguous basis in the description as originally filed.

Nevertheless, an objection under Rule 137(5) EPC was raised, and later maintained, on the basis that feature D related to unsearched subject-matter because claim 3 was not searched.

### Example 2

| | |
|---|---|
| Independent Claim 1: | Product comprising A + B. |
| Dependent Claim 2: | Product according to claim 1, wherein B comprises B1. |
| Independent Claim 3: | Product comprising A + C. |
| Dependent Claim 4: | Product according to claim *3*, wherein B further comprises B2. |

A product comprising feature A is known from the prior art. The EPO therefore raised an objection of lack of unity between claim 1 and claim 3. As a result, claims 1 and 2 were searched, while claims 3 and 4 were not searched.

During prosecution, claim 1 was amended to incorporate the subject matter of claim 2 (B comprises B1), and also to recite that B further comprises B2. This amendment found clear and unambiguous basis in the description as originally filed, and the combination of features A, B1 and B2 was clearly and unambiguously derivable from the description. It was clear that original claim 4 incorrectly depended upon claim 3, and should have depended upon claim 1.

Nevertheless, an objection under Rule 137(5) EPC was raised, and later maintained, on the basis that feature B2 related to unsearched subject-matter because claim 4 was not searched.

**Legal Basis**

When does an amendment fall foul of Rule 137(5) EPC, and were the above objections justified?

**Origins**

New Rule 137(5) EPC was established by a Decision of the Administrative Council dated 25 March 2009 (CA/D 3/09, OJEPO 2009, 299). It is noteworthy that Rule 137(5) EPC was introduced with a "Notice from the EPO dated 15 October 2009 concerning amendments to the Implementing Regulations to the EPC" as part of "Raising the Bar". Paragraph 7.4 of this Notice states: "Where the claims have been limited under Rule 62a(2) or Rule 63(3) EPC, amendments based on non-searched subject-matter can *no longer be derived from the description* at a later stage of the grant procedure. The subject-matter excluded from the search under Rule 62a or Rule 63 EPC may, however, be prosecuted in divisional applications, which must be filed by the deadline laid down in Rule 36(1)(a) EPC." This confirms that the mere fact that the subject-matter in question can be found in the description is not sufficient to overcome the requirements of Rules 137(5) EPC, second sentence.

**Guidelines for Examination in the EPO**

*C-VI, 5.2*

"If amended claims are directed to subject-matter which has not been searched (e.g. because it only appeared in the description and the Search Division did not find it appropriate to extend the search to this subject-matter, see B-III, 3.5) *and which does not combine with the originally claimed and searched invention or group of inventions to form a single general inventive concept*, such amendments are not admissible"

Paragraph C-VI, 5.2 of the Guidelines appears consistent with the wording of Rule 137(5) EPC, first sentence. This section of the Guidelines further directs the reader to paragraph B-III, 3.5 for an interpretation of what constitutes unsearched subject-matter:

*B-III, 3.5*

"In principle, and insofar as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed *or to which they might reasonably be expected to be directed after they have been amended*"

Paragraph B-III, 3.5 of the Guidelines clarifies that the search should cover not only the subject-matter of the claims, but also the subject-matter which might reasonably form the basis for a possible amendment. However, this passage opens up a broad range of possible interpretations in respect of the phrase "*to which they [the claims] might reasonably be expected to be directed after they have been amended*".

It follows that an important point to consider is: When can a feature which is not present in the claims nevertheless be deemed to have been searched by the Search Division?

*Case Law of the Boards of Appeals*

The Case Law of the Boards of Appeals provides some helpful clarification on this issue.

**G2/92** explains that "An applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC cannot pursue that application for the subject-matter in respect of which no search fees have been paid". Further, "the Search Division then has to draw up the search report "for those parts of the European patent application which relate to *inventions* in respect of which search fees have been paid"."

G2/92 further clarifies that the Examining Division is provided with a certain amount of flexibility in the judgement it may apply in each case: "If the Search Division had previously considered that the application did not comply with the requirement of unity of invention, and had requested and received payment of one or more additional search fees, then during the examination stage in accordance with Rule 46(2) EPC, the applicant may request and receive a refund of such additional search fees if the Examining Division finds (contrary to the Search Division) that the application does meet the requirement of unity of invention in Article 82 EPC".

Therefore, it appears that the subject-matter to be examined must relate to an *invention* for which a search fee has been paid.

**T613/99** confirmed G2/92, and stated that Rule 86(4) EPC 1973 (Rule 137(5) EPC 2000) referred to a particular situation, i.e. where the patentability of fresh claims could not be examined in the context of the original application, since this would have amounted to a derogation from the principle endorsed in G2/92.

**T274/03** perhaps provides the most useful summary of what constitutes unsearched subject-matter:

"(…) it is clear that post-search "switching" of subject-matter clearly implies a *significant change in the nature of the subject-matter being claimed* which is not normally comparable to the addition of features taken from the description to further define an element that was already a feature of the original main claim.

In accordance with the case law of the Boards of Appeal (T 377/01, point 3.1 and T 708/00, point 17, both decisions not published in OJEPO) the Board is of the opinion that an amendment amounting to the restriction of an original main claim by including complementary features from the original description into the claim represents an admissible reaction of an applicant vis-à-vis an objection against the patentability of the unamended claim and does not constitute an abuse of the system of the nature which Rule 86(4) EPC was introduced to prevent. *This type of amendment should not therefore in general be judged as contravening the requirements of the rule, even though an additional search may be required*".

The recent *T1285/11* Decision also confirms that incorrect findings by the Search Division are *not* binding on the Examining Division:

"According to the practice of the EPO, as set out in the Guidelines for Examination (C-III, 7.10, first paragraph) and explained in detail in decision J3/09 (see Reasons, points 3.5.4 to 3.5.7, in particular point 3.5.6), the responsibility for establishing whether or not the application meets the requirements of unity of invention ultimately rests with the examining division, *and the opinion of the EPO acting as the ISA on lack of unity is not final or binding on the examining division*. The fact that the applicant did not pay further search fees or protest fees in the international phase cannot therefore be seen as a tacit agreement with the findings of non-unity of the ISA, as submitted by the examining division in the decision under appeal.

To the extent that an objection of non-unity raised by the ISA turns out to be unjustified, the applicant is entitled as of right to have the whole subject-matter of his unitary invention searched. If need be, an additional search would have to be performed (see Guidelines for Examination, C-III, 7.10, third paragraph, last sentence, and 7.11.1(v); decision J 3/09, Reasons, points 3.5.6 and 5.2), regardless of whether or not this might involve an additional effort."

**Discussion**

From a close inspection of the Guidelines and the relevant case law, it appears that the mere fact that a claim was not searched does not necessarily mean that some subject-matter (e.g. a specific feature) contained within that claim, was not searched. In other words, unsearched claims should not always imply unsearched subject-matter.

Nevertheless, EPO Examiners appear to be increasingly prompt to raise objections under Rule 137(5) EPC on the basis that a claim was not searched, sometimes with apparently little consideration as to whether the subject-matter of that claim was, or should have been, searched.

A practical implication for European attorneys is: can anything be done to reduce the risk of an objection being raised under Rule 137(5) EPC? Although T1285/11 confirms that incorrect findings from the Search Division are not binding on the Examining Division, it is a generally accepted principle that prevention is better than cure.

Since this type of objection is normally raised when an Examiner considers that the subject-matter of a claim has not been searched, one should try to ensure that all claims presented on filing can reasonably be expected to be searched.

As part of "Raising the Bar", the EPO is becoming increasingly strict on enforcing compliance of the claims with the EPC, including Article 82 EPC (unity of invention), and Rule 43(2) (plurality of independent claims in the same category).

Even when a set of claims satisfies the requirements of unity of invention, it is not uncommon for it to also contain several independent claims in the same category on filing. It is tempting to perceive such claims sets as potentially increasing the flexibility of amendment during prosecution. The ultimate client may also deliberately opt to maintain multiple independent claims in one category because they may not yet know which independent claim covers best the product(s) which will be finally put on the market.

Nevertheless, with the recent trend relating to Rule 137(5) EPC objections, it could be argued that such sets of claims may potentially diminish the flexibility of amendment during future prosecution. This is because, unless such claims clearly fall within one of the exceptions listed under Rule 43(2) EPC, it is likely that only one of these claims will be searched pursuant to Rule 62a EPC. This could potentially limit an Applicant's opportunity to amend the claims to introduce subject-matter which was present in those claims under Rule 137(5) EPC, second sentence, based on the current application of this Rule by the EPO.

On the other hand, if no such multiple independent claims in the same category were present on filing, and the description of the application as filed clearly and unambiguously discloses the subject-matter of the amendment in combination with the claims searched by the Search Division, then no objection under Rule 137(5) EPC, second sentence, should be raised. Further, amending the claims to incorporate that subject-matter may be allowable under Article 123(2) EPC.

Compliance with Article 123(2) EPC is not, of course, the sole requirement as to whether or not an amendment is allowable.

It is easy to envisage an amendment to a preferred feature which would find clear and unambiguous basis in the description as originally filed, yet which would be deemed not to combine with the originally claimed invention to form a single general inventive concept, i.e. which would lack unity. In such a case, the amendment would likely not be permissible under Rule 137(5)

EPC, even if that feature was *not* part of any of the original claims.

Another concern emerging from the recent increase in the number of objections under Rule 137(5) EPC relates to the new Rules regarding the filing of divisional applications under EPC 2000. Under Rule 36(a) EPC, any voluntary divisional application must be filed before the expiry of 24 months from the Examining Division's first communication in respect of the earliest application. This additional hurdle now creates the risk that an objection under Rule 137(5) might be raised late in proceedings in view of an amendment made by the Applicant, and that, at the time the objection under Rule 137(5) is raised, it is already too late to file a divisional application. This is particularly relevant when the application relates to a technical field in which the EPO still has a significant backlog of applications to be examined. When concerns arise as to whether or not an objection under Rule 137(5) EPC might be raised in relation to a particular amendment, it may be prudent to request accelerated examination under the 'PACE' procedure at the same time as responding to a first communication from the Examining Division. By doing so, the Applicant will likely receive a further Communication from the Examining Division within 24 months of the first Communication, and will therefore have the opportunity to file a voluntary divisional application to overcome any objection that might be raised under Rule 137(5) EPC.

As discussed earlier, one practical option to reduce the risk of an objection under Rule 137(5) EPC being raised *may* be, in some circumstances, to minimise the number of independent claims in each category. A number of possibilities exist to make use of this option. For example, one could delay the filing of claims until an invitation under Rule 57(c) is received to allow additional time to finalise the claims. In the case of Euro-PCT application where the EPO was not the ISA, one could amend the claims in response to a communication under Rule 161(2), before the EPO draws up a supplementary search report.

Another potentially helpful measure *may* be to include as many features in dependent claims as possible on filing, using 'alternative' (and/or) language or 'optional' language in order to avoid excess claims fees. Unfortunately, this may lead to possible clarity objections under Article 84 EPC.

Therefore, there are numerous parameters to be considered when preparing claims for filing a European application, or for entering the European regional phase of a PCT application for which the EPO was not the ISA. It may be too early to decide whether or not the increasing frequency of objections under Rule 137(5) EPC, should influence the form of the claims we, European Patent Attorneys, chose to present on filing European patent applications. However, it appears that the choice of strategy adopted in each case may have an influence on the Applicant's opportunity to amend the claims during examination, and should therefore not be overlooked. This issue should therefore be considered with great care until such time that a consistent approach as regards implementation of Rule 137(5) EPC is adopted by the EPO.

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# Die Erfinderische Tätigkeit (inventive step etc.) ist wissenschaftlich erledigt

Dr. A. W. Kumm (DE)

**I.**

Kant: „Die so niemals selbst denken, besitzen dennoch die Scharfsichtigkeit, alles, nachdem es ihnen gezeigt worden, in demjenigen, was sonst schon gesagt worden, aufzuspähen, wo es doch vorher niemand sehen konnte“[1].

**II.**

Die Erfinderische Tätigkeit- inventive step, Isobretátelskij úroven, jin bu xing etc. – ergäbe sich für „den Fachmann“ als nicht nahe liegend (z. B. Art. 52 und 56 EPÜ).

Dieser „Fachmann“ hat freilich überhaupt nichts zu tun mit einem der vielleicht ein paar Millionen realer Spezialisten- den wahren technischen Fachleuten der Erde-, die in einigen hundert technischer Fachgebiete verschiedener Größe tätig sind[2]. Er ist vielmehr ein fiktives Gesetzeskonstrukt, ein Phantom, das verkörpert

1 Immanuel Kant, 1724 – 1802, der geniale Denker in Königsberg in Preußen. Zitat aus „Prologemina“ von 1783.

2 Ein realer Fachmann ist imstande auf einem eindeutig definierten technischen Probleme durch selbständiges und Handeln zu erkennen, zu lösen und zu beurteilen. Das Wissen und Können dieser Spezialisten ist gaußisch-normalverteilt. Sie gliedern sich folglich in unterdurchschnittliche Fachleute mit nur applikativer Eignung oder in durchschnittliche Fachleute mit adaptiver Befähigung oder in überdurchschnittliche Fachleute mit talentierter bis genialer Begabung.

wird von einem, von drei, vier, fünf, sogar sieben amtlich bestellten Prüfern/Richtern, also von Nichtfachleuten[3].

Diese bewerten eine selbst und nachträglich konstruierte fiktive Handlungsweise, die der reale Erfinder gehabt hätte.

Die zwei gesetzlichen Normen sind jedoch nicht operabel (nicht widerspruchsfrei festzustellen), denn jenes Werturteil ist keine objektive (vom Beurteiler unabhängige) technische Feststellung, sie ist keine objektive Realdefinition. Die erfinderische Tätigkeit (etc.) ist sonach wissenschaftlich erledigt[4].

**III.**

Die Rechtsanwender verleugnen einfach die beiden nicht operablen Normen und setzen ohne erkenntnistheoretische Zweifel einfach dies fest: „Die Beurteilung der erfinderischen Tätigkeit erfolge auf objektiver Grundlage und sei ein objektives Kriterium"[5] sie werde „an einem objektiven, fiktiven Maßstab gemessen, nämlich der Kunstfigur des Fachmannes"[6].

Das ist jedoch ein logischer Widerspruch, denn etwas Fiktives ist nie objektiv. Ohnehin sind alle Aussagen der Spruchstellen nur Zirkelschlüsse; ihre singulären ad-hoc-Entscheidungen sind keine Präjudizien und sie sind, wie schon Aristoteles uns lehrte, nicht induktiv zu verallgemeinern[4]. Damit fallen auch alle Hypothesen, in denen „der Fachmann" eine Rolle spielt, etwa die could-would-Konstruktion des EPA oder die alten, unbedarften Hilfskriterien[7].

Kurzum: Alle Aussagen sind bloß ermessensgemäße, subjektive (vom jeweiligen Beurteiler abhängige) Festsetzungen, sie sind nur subjektive Normierungsdefinitionen.

**IV.**

Gegen diese ablehnende Feststellung der erfinderischen Tätigkeit wird eingewendet: Die erfinderische Tätigkeit sei nach der Rechtsprechung von Bundespatentgericht, Bundesgerichtshof, Beschwerdekammern und Großer Beschwerdekammer des EPA „rein objektiv" zu verstehen. Das ist freilich das untaugliche „Autoritäts-Argument" der Rhetorik, denn noch so glanzvolle Namen ersetzen keinen Beweis. Zudem ist es wissenschaftlich belanglos, wie jemand etwas „versteht"; wesentlich ist, was es „ist".

Weiterhin wird gesagt, „der Fachmann" sei zwar eine Fiktion, aber Fiktionen seien in Gesetzen durchaus üblich. Worin liegt der Denkfehler? Eine Fiktion ist ein Als-ob-Konstrukt, mit der man einen irrealen oder unwahrscheinlichen Sachverhalt als wahr postuliert. In einem Gesetz wird eine Fiktion formell „als ob real" unterstellt. Doch das ist ontologisch nur statthaft, wenn es um Sachen geht. Dreht es sich dagegen um die intellektuelle Fähigkeit eines Menschen, dann ist eine Fiktion abwegig. Insbesondere „der Fachmann", als Irrealität, lässt sich so niemals zu einer realen, aussage- und zeugnisfähigen natürlichen Person ontologisch umfunktionieren[8].

**V.**

Kein einziger der millionenfachen Fachleuten, der in einem der zu hunderten zählenden technischen Fächern tätig ist, kann im Voraus sagen, ob, wann, wie und wodurch irgendein Kollege des Fachgebietes eine bestimmte fachliche Leistung erbringen wird. Er kann an Hand objektiver technischer Daten nur objektiv feststellen, ob ein vorgelegtes Objekt einen technischen Fortschritt zeitigt oder ob es zwar neu, aber sozio-ökonomischer[9] Schrott oder Unsinn ist.

Nicht eine vage erfinderische Tätigkeit, sondern der erzielte technische Fortschritt ist das primäre, das notwenige und hinreichende objektive Merkmal einer Erfindung.

Die objektive Realdefinition des Fortschritts wurde schon früher aufgespürt, etwa seine Größenklassen, die Beziehungen zu den geistigen Leistungen oder eine Wertzahl für die Größenklasse mit nur zwei objektiven Zahlenwerten für die Gesamtwirkungen.[10,11] (Die „Neuheit" ist nur ein sekundäres, hinreichendes Merkmal)[12].

Das USA-Patent ist zwar auch an die irrealen „Fachmann" gebunden. Diese *person having ordinary skill* ist aber nicht gleich dem esoterischen europäischen Allesbesser-Wisser. Daher werden nur etwa 10 % der Anmeldungen verworfen, die das Bekannte oder das sozio-ökonomisch törichte Neue betreffen. Alles andere wird zugelassen, vor allem auch das eklatant Nichttechnische. Die means-for-Ansprüche erlauben zudem jede Interpretation, etwa was „standardessentiell" sei.

Die Schweiz lässt offen, wem sich das „in nahe liegender Weise ergibt". Dort könnte man also mittelbar mit dem technischen Fortschritt arbeiten[11].

Das Patentgesetz der VR China kennt sehr wohl den technischen Fortschritt, denn der normierte „Erfindergeist" (nicht operabel) ist durch den normierten „bemerkenswerten Fortschritt" (operabel) gekennzeichnet.

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3 Ein technischer Prüfer/Richter ist ein Fachmann, der auf verwandten technischen Gebieten einsetzbar ist, der spürsinnig ist und der interdisziplinär denkt; er ist sachkundig für Analysen von unterschiedlichen technischen Sachverhalten und für technisch-begriffliches Abstrahieren und juristisches Subsumieren. Er ist ein Generalist und kein Spezialist. Der nur Rechtskundige ist ein Nichtfachmann.

4 Kumm, A. W.: Die Crux mit der erfinderischen Tätigkeit. In *epi* Information, 4/2011, S. 151.

5 Aus einer Entscheidung von 1983 des EPA.

6 z. B. Benkard, Patentgesetz, 10. Aufl., Beck 2006, S. 243.

7 So schon Kumm, A. W.: Die Bewertung der erfinderischen Tätigkeit, ein rational unlösbares Jahrhundert-Problem. In: *epi* Information, 1/1998, S.23. (Auf einen Artikel von R. Teschemacher, *epi* Information, 3/1997, S. 25).

8 Der „Durchschnittsfachmann" ist auch nur ein statistisches Abstrakt der realen Fachleute-Gesamtheit eines speziellen technischen Fachgebietes.

9 Das ist ein treffender Ausdruck statt des altertümlichen „gewerblich anwendbar".

10 Vgl. Kumm, Altred W.: Inventionsmanagement 1995. ISBN 3-8248-0142-6. Dito: Vom Spezialisten zum Generalisten der Technik. 2003. ISBN 3-89846-264-1.

11 Kumm, A. W.: Die Crux mit der erfinderischen Tätigkeit und die schweizerische Chance ihrer operablen Bewertung. In: *epi* Information, 1/2012, S. 22.

12 Was technisch fortschrittlich ist, ist denknotwendig auch neu, aber ein Neues ist nicht unbedingt auch fortschrittlich.

# Der Fachmann: die notwendige Fiktion im System

T. Fox (AT)[1]

Von den zahlreichen Rechtsfiktionen, die das EPÜ und Verfahren vor dem EPA strukturieren, ist die des Fachmanns wohl die am häufigsten in Literatur und Rechtsprechung diskutierte. Andere „bewußt gesetzte, falsche Annahmen"[2] wie die verschiedentlich ausgelösten Rücknahmefiktionen im Anmeldeverfahren vor dem EPA fordern offenbar weniger heraus als die Vorstellung einer Person, die nichts weiter als Vorstellung bleibt.

Dient der Fachmann der Vereinfachung der Rechtsanwendung? Wenn dem so wäre, ließe er sich vermutlich durch andere Hilfsmittel ersetzen.

Ist die erfinderische Tätigkeit eines Anmeldungsgegenstandes ohne den Fachmann einschätzbar? Wenn ja, was ist dann mit den zahlreichen anderen Stellen des EPÜ, an denen der Fachmannbegriff eine Rolle spielt?

Dies ist ein Plädoyer dafür, daß der Fachmann nicht einer einfacheren Rechtsanwendung dient oder ein willkürliches Hilfsmittel darstellt, sondern daß sein Begriff für eine Einheitlichkeit des EPÜ sorgt.

Um dies zu verdeutlichen und um den Zweck dieser Fiktion besser erklären zu können, erscheint es sinnvoll, zunächst die Wegkreuzungen kenntlich zu machen, an denen bei der Anwendung des EPÜ der Fachmann angetroffen wird. Dies wird im folgenden getan, um anschließend anhand der Art, wie der Begriff zu seinen Eigenschaften kommt, zu prüfen, welche allgemeine Funktion der Fachmann im Recht hat oder haben kann.

Da er allseits als Fiktion bezeichnet wird, kann der Fachmann keine reale Person sein. Wie dem Abschnitts D7 in der EPA-Publikation „Rechtsprechung" zum Begriff des Fachmanns zu entnehmen ist, driften oder spezialisieren sich seine Eigenschaften mit der Zeit und mit den Entscheidungen, sein Nichtsein bleibt jedoch konstant. Doch selbst wenn in einem Einzelfall einmal eine Frau oder ein Mann anzutreffen wäre, der oder die tatsächlich jede geforderte Eigenschaft des Fachmanns erfüllen würde (inkl. seiner Phantasielosigkeit trotz ansonsten ungewöhnlich breiter Sprach- und Technikkenntnisse), wäre es einfach überflüssig, diese Person als Zeuge in einem Einspruchsverfahren zu befragen. Ebenso ist es überflüssig, auf natürliche Personen und ihre Fähigkeiten und Fachkenntnisse zu verweisen, um vermeintlich zu zeigen, daß der Fachmannbegriff angesichts der Realität widersprüchlich wäre; lebende Beispiele sind schlicht wirkungslos für theoretische Begriffe.

Ist aber einmal erlernt, daß der Fachmann ein reiner Begriff ist, so ist zu seinem Verständnis nicht mehr zu sagen, als daß er ein Bündel von Eigenschaften ohne Kondensationskern ist. Da es sich um keine Person handelt, die uns im täglichen Leben oder anderswo als schlüssiger Charakter gegenüberstehen soll, sind seine Eigenschaften auch (fast) frei wählbar. Und so haben die Merkmale des Fachmanns trotz seiner Virtualität bereits Kommentatoren dazu hingerissen, ihn als sehr merkwürdigen Zeitgenossen zu bezeichnen.[3] Dies hat aber in der Rechtsanwendung keinerlei Auswirkung. Es ist nur verwunderlich, daß die ähnlichen Begriffe des informierten Benutzers im Geschmacksmusterrecht oder der angesprochenen Verkehrskreise im Markenrecht keine derartigen Spekulationen auslösen, obwohl es gleichermaßen künstliche Personengruppen sind.[4]

Die Literatur wagt es kaum, diese Fachmann-Stellen im EPÜ erschöpfend aufzuzählen.[5] Doch klar sind beispielsweise die folgenden Orte: Nach Artikel 56 EPÜ darf eine Erfindung dem Fachmann angesichts des Standes der Technik nicht naheliegen, um als erteilbar beurteilt werden zu können. Die Erfindung ist gemäß Artikel 83 so deutlich und vollständig zu offenbaren, daß ein Fachmann sie ausführen kann. Das Kriterium der zulässigen Änderung einer Patentanmeldung nach Artikel 123 hängt ebenso vom Fachmann ab, da es an ihm und dem Umfang seines Wissens liegt, was noch unmittelbar und eindeutig in der ursprünglich eingereichten Fassung einer europäischen Patentanmeldung enthalten ist und somit hinzugefügt werden darf.[6]

Soweit die drei am häufigsten erkannten Stellen, die den Fachmann involvieren. Doch hängt auch die Auslegung des Artikel 54 von ihm ab: neuheitsschädlich können Merkmale sein, die in einem Dokument des Standes der Technik nicht direkt enthalten sind, sofern sie der Fachmann nur mit seinem geistigen Rüstzeug, seinem Wissen und weiteren Fähigkeiten implizit mit erfaßt.[7]

Derselbe Rückgriff erfolgt beim Vergleich einer europäischen Anmeldung mit ihrer vermeintlichen Prioritätsanmeldung, so daß wiederum in Zweifelsfällen der Fachmann entscheidet, ob sich alle Merkmale des Gegenstandes der Nachanmeldung unmittelbar und eindeutig aus dem Prioritätsdokument herausziehen lassen.[8]

Ganz ähnlich geht es, wie man sich leicht vorstellen kann, bei Teilanmeldungen zu. Die technischen Angaben einer Teilanmeldung muß nicht die Allgemeinheit oder der Erfinder, sondern niemand anderes als der Fachmann auch aus der Stammanmeldung entnehmen können.[9]

1 Europäpischer Patentanwalt, Schütz u. Partner, Wien; fox@brezialisten.org.

2 Duden Fremdwörterbuch, Mannheim 1990, zur Bedeutung von „Fiktion".

3 Robin Jacob, Der Fachmann, Sonderausgabe 1 zum ABl. EPA 2009, 83; Graham Ashley, Der Fachmann im Europäischen Patentübereinkommen, ebenda, 95.

4 Der informierte Benutzer im Gemeinschaftsgeschmacksmusterrecht: Art. 6(1) und 10(1) sowie Präambel GemGMG.

5 Graham Ashley, a. a. O., 94.

6 Richtlinien für die Prüfung im EPA, April 2010 (kurz RiLi) C-VI, 5.3.1 und 5.3.10; G 3/89 und G 11/91.

7 siehe die Zusammenfassung bei Spangenberg in Singer/Stauder, EPÜ, Köln 2010, S. 208 ff.

8 G2/98 zu Artikel 87 EPÜ.

9 T 402/00, T 423/03.

Im Auslegungsprotokoll zu Artikel 69 EPÜ ist der Fachmann wiederum direkt genannt, wenn es heißt, der Schutzbereich eines europäischen Patents erstrecke sich zwar auf mehr als auf die wortgenaue Bedeutung der Ansprüche, aber wiederum auf weniger als das, „was sich dem Fachmann nach Prüfung der Beschreibung und der Zeichnungen als Schutzbegehren des Patentinhabers darstellt." Der Schutzbereich liegt vielmehr zwischen diesen beiden Polen. Die Fähigkeiten des Fachmannes bestimmen einen dieser Pole, wodurch der Schutzbereich indirekt erweitert oder verringert wird, wenn sich ebenso die fachmännischen Fähigkeiten verbessern oder verschlechtern. Jedoch auch ohne Auslegungsprotokoll könnte man den Schutzbereich eines europäischen Patents direkt mithilfe des Fachmannbegriffs bestimmen, wie es beispielsweise bei deutschen Patenten bereits üblich ist.[10] Somit hängt Wohl, Wehe und Wirkung eines europäischen Patents in allen Verfahrensteilen vom Fachmann ab: im Prüfungsverfahren, bei den Einspruchsgründen und der Begrenzung der Änderungsmittel im Einspruchsverfahren, sowie bei der Festlegung des Schutzbereichs.

Form, Klarheit und technische Auslegung der Ansprüche bringen erneut den Fachmann ins Spiel, weswegen die Erfüllung der Regel 43 auch zu den Bestimmungen zählt, die erst durch diese Kunstfigur zum Leben erweckt werden.[11]

Die Klarheit einer Anmeldung insgesamt steht unter der Bedingung, daß die Ansprüche durch die Beschreibung gestützt sind.[12] Wer aber darüber entscheidet, ob eine bestimmte Formulierung in der Beschreibung zur klaren Erläuterung der Bedeutung eines beanspruchten Merkmals ausreicht, ist natürlich der Fachmann.

Das EPÜ ist trotz rarer Nennung des Fachmanns von diesem Konzept durchsetzt. In extremen Fällen hängt sogar die gewerbliche Anwendbarkeit einer Erfindung vom Begriff des Fachmanns ab: Sie muß technisch derart solide sein, „daß für den Fachmann ersichtlich ist, daß ihr Beitrag zum Stand der Technik in eine praktische gewerbliche Verwertung münden kann (T 898/05)."[13] Somit kommt keines der Hauptkriterien der Patentierbarkeit (Neuheit, erfinderische Tätigkeit, gewerbliche Anwendbarkeit, Klarheit und ausreichende Offenbarung) ganz ohne fachmännische Hilfe aus.

Damit nicht genug. In speziellen Zusammenhängen bedarf es fachmännischen Rats, ob biologisches Material im Rahmen einer entsprechenden Anmeldung ausreichend schriftlich beschrieben werden kann und ob es alternativ frei zugänglich ist oder ob es doch lieber in natura hinterlegt werden sollte.[14]

Zuletzt eine weitere Nutzung der Fachmannsfiktion, nämlich als Figur, die sich das gleiche technische Gebiet mit Prüfern des EPA teilt: Wenn im Kontext einer einzelnen konkreten Erfindung Fachmänner auf mehreren technischen Gebieten angesprochen sind, können laut Prüfungrichtlinien auch entsprechend viele Prüfer, bzw. Prüfer auf den jeweils wichtigen technischen Gebieten bei der Recherche der Anmeldung erforderlich sein.[15]

Es ist festzuhalten, daß es eine verwunderliche Absichtslosigkeit wäre, den Fachmann an derart vielen Stellen des EPÜ eine Rolle spielen zu lassen.

Die Attribute des Fachmanns werden meist in der Rechtsprechung festgelegt. Manche sind so speziell, daß sie in ihrer Bedeutung kaum mehr als über einen einzelnen Streitfall entscheiden.

Erhält der Fachmann im Laufe sich entwickelnder Rechtsauslegung weitere Eigenschaften, dann gelten sie nicht nur in Zusammenhang mit der anlaßgebenden Gesetzesstelle, sondern überall (wenn in einem weiteren konkreten Fall nicht besondere Gründe dagegensprechen sollten). Nochmals die bekannte Teamfähigkeit: wenn die erfinderische Tätigkeit eines Gegenstandes an einer Arbeitsgruppe von Fachleuten gemessen werden kann, so kann auch die unzulässige Erweiterung (einer beliebigen anderen Anmeldung) oder die Bestimmung des Schutzbereiches eines Patents von einem jeweils angemessenen Fachteam abhängen.

Darin besteht keine Notwendigkeit. Die Gesetzgebung könnte sich gleichermaßen dazu entschließen, eine bestimmte Eigenschaft des Fachmanns nur auf einen bestimmten Artikel anwendbar zu halten. Daß dies nicht geschehen ist, kann man auch so auslegen, daß dies Absicht ist, und man bewußt keine Vervielfältigung von Fachmännern zuläßt. Beispielsweise ist vermieden worden, dem Fachmann in Zusammenhang mit der vollständigen Offenbarung (Artikel 83) ein Auslegungswissen zu geben, das ihm dann im Rahmen der zulässigen Erweiterung (Artikel 123) nicht mehr zur Verfügung steht. Bei der Konkurrenz der beiden Artikel hat man es vorgezogen, statt zweierlei fachmännischer Maßstäbe und somit der Erschaffung zweier verschiedener Fachmannbegriffe lieber zwei Offenbarungstypen zu definieren: Zur Erfüllung des Artikel 83 ist die Erfindung für den Fachmann „deutlich und vollständig" zu offenbaren, während dem Artikel 123(2) genüge getan ist, wenn die Anmeldung nichts enthält, was dem Fachmann ursprünglich „unmittelbar und eindeutig" gelehrt war. Deutlichkeit und Vollständigkeit bedeuten nicht dasselbe wie Unmittelbarkeit und Eindeutigkeit. Die zweite Offenbarungsart ist enger auszulegen.[16] Der Fachmann könnte demnach durchaus einen Gegenstand als reproduzierbar offenbart in einer Anmeldung herauslesen, jedoch das für ihn implizit Offenbarte dürfte nicht in einer nachträglichen Explikation eingefügt werden. Dies erzeugt keinen Widerspruch oder einen anderen Reparaturbedarf im EPÜ, sondern ist schlicht zur Kenntnis zu nehmen. Auf diese Weise entstehen aber zwei Offenbarungsbegriffe – unter Beibehaltung desselben Fachmanns.

Es gilt offenbar der unausgesprochene Grundsatz, wonach es nur einen Begriff des Fachmanns geben darf. Der Vermutung, daß sich die Begründer des EPÜ zu einer

10 Rainer Schulte, PatG, Köln 1994, § 14, Randnr. 18.
11 siehe RiLi C-III, 2.1 und 4.
12 RiLi C-III, 6.3.
13 RiLi C-IV, 5.4.
14 R. 31EPÜ AO, RiLi C-II, 6.2.
15 vgl. T 57/86, T 460/87, T 99/89 und RiLi B-I, 2.
16 siehe Blumer in Singer/Stauder, EPÜ, Köln 2010, Art. 123, Randnr. 12, S. 1040f.

unteilbaren Fiktion des Fachmanns aus Gründen der Einfachheit entschlossen hätten und weiterhin entschließen würden, ist streng zu widersprechen. Das EPÜ und die umliegenden Rechtsquellen sind seit 1973 kontinuierlich komplexer geworden, deutlich auch wieder mit der Einführung des EPÜ 2000 oder der Regelung von Teilanmeldungen. Dem Ziel der Einfachheit werden stets andere Ziele vorgezogen, sicher auch ehrwürdige wie u. a. eine gesteigerte Gerechtigkeit für Anmelder, Rechteinhaber usw.[17] Folglich wird wohl niemand mit dem Einfachheitsargument für die Einsamkeit des Fachmanns stimmen.

Solange sich alle fachmännischen Eigenschaften zusammengenommen nicht widersprechen, kann der Fachmann für jede Rechtsstelle z. T. verschiedene Eigenschaften haben und bleibt doch derselbe Fachmann. Beispielsweise kann die Eigenschaft, Routineversuche durchführen zu können und damit die Bedingung der erfinderischen Tätigkeit nach Artikel 56 zu verschärfen, schlummern, während derselbe Fachmann ein Dokument des Standes der Technik auf indirekt genannte Merkmale prüft. Beide Fähigkeiten – Versuchstätigkeit und das Mitlesenkönnen nichtgenannter Dinge – bestehen gleichzeitig widerspruchsfrei im Fachmannbegriff und werden nur aktiviert, falls angemessen. Niemand wird daran Anstoß nehmen.

Es bei einem Fachmannbegriff zu belassen, hat einen besonderen Effekt: er sorgt für einen engeren und konsistenten Zusammenhang ansonsten getrennter Bestimmungen des EPÜ. Der Fachmann vereinheitlicht das EPÜ zu einem organischen Ganzen. Es ist ja auch sinnvoll, das gesamte Patentierungsverfahren nur einer Einrichtung gegenüberzutellen, welche den Stand der Technik und seine Grenzen gleichermaßen widerspiegelt. Der Fachmann als halb menschenähnliches und halb enzyklopädisches Geschöpf erweist sich dabei als ein sehr wirkungsmächtiger Maßstab. Auch andere wiederkehrende Termini wie etwa die Begriffe „Neuheit" oder „Stand der Technik" dienen dem einheitlichen Zusammenhang des EPÜ, sofern sie an verschiedenen Anwendungsorten denselben Begriffsinhalt aufweisen.

Es ist daher unter anderem richtig, bei weiterer Harmonisierung nationaler Patentrechte in materieller Hinsicht dies mit dem Fokus auf den Fachmannbegriff zu tun, wie bereits vorgeschlagen wurde.[18] Man kann wohl sagen, daß sich zwei Patentgesetze dann in hohem Maß gleichen, wenn sie auf einem übereinstimmenden Fachmannbegriff fußen und ihn an denselben Stellen zur Anwendung bringen. Auch richtig ist es, diesen Begriff detailiert zu kommentieren, da er die unauffällige Klammer des europäischen und vermutlich fast aller nationaler Patentgesetze ist.

Der Rückgriff auf den Fachmann mag auch anderen Zwecken dienen, wie etwa didaktischen Gründen, einer Vereinfachung hinsichtlich der Anschaulichkeit mancher Umstände oder der Verkürzung eines Arguments.[19] Diese Ziele sind jedoch leicht durch alternative Einzelkriterien oder Kunstgriffe ersetzbar, weswegen die einheitsstiftende Wirkung als primäre Aufgabe des Fachmanns bestehen bleibt.

Zudem ist das EPÜ durch den Fachmann austariert, da eine theoretische Veränderung seiner Eigenschaften an einer ersten Stelle zu einer sinnvollen Verschiebung an damit vernetzten anderen Orten des EPÜ führt. Ist beispielsweise das Wissen des Fachmannes als umfangreicher als bisher anzusetzen – was z. B. durch Rechtsprechung zur Auslegung des Offenbarungsgehaltes eines Dokuments des Standes der Technik nach Art. 54(2) motiviert sein könnte –, dann sind in der Folge anzumeldende Gegenstände entsprechend weniger genau zu beschreiben: schließlich liest der angesprochene Fachmann nun mehr aus einer knapperen Beschreibung heraus. Es wird aber auch für alle angemeldeten Gegenstände schwerer, die Bedingung der erfinderischen Tätigkeit zu erfüllen, denn der Fachmann würde mehr Merkmale im Stand der Technik erkennen als bisher. Sofern die weiteren Randbedingungen gleich bleiben, sollten daher in diesem Gedankenbeispiel weniger Patente erteilt werden. Einmal erteilte Patente genössen jedoch eine höhere Schutzwirkung, weil wiederum der Fachmann (wie oben ausgeführt) diese beeinflußt. Man stelle sich vor, es wäre umgekehrt: eine Manipulation des Fachmann-Konzepts führte zu einer geringeren Zahl von Patenten, die dann auch noch einen geringeren Schutzumfang hätten. Der Wert eines durchschnittlichen europäischen Patents würde auf einen Schlag abnehmen. Doch analog wie in diesem Beispiel federn sich die vernetzten Funktionen des Fachmanns im gesamten EPÜ ab.

Wäre dem nicht so, müßten Teile des EPÜ neu konzipiert werden – oder aus einem Begriff des Fachmanns müßten viele gemacht werden, etwa multipliziert in einen FM56, FM83, FM123 usw., was wiederum der Einheitlichkeit des EPÜ nicht förderlich wäre. So bleibt es bei einem einzigen Fachmann, der mit seinem unübersichtlichen Eigenschaftsbündel wie eine unheimliche Kreatur anmutet. Aber wie Adorno schon sagt: „Jedes Kunstwerk ist eine abgedungene Untat."[20]

17 Teilweise vereinfachte Anmeldevoraussetzungen oder eine einfachere Benennung von Mitgliedstaaten widersprechen der globalen gesetzlichen Verkomplexierung der dahinterstehenden Regelungen nicht.

18 S. Gedeon, Der fiktive Fachmann im Patentrecht, *epi* Information 2011, 76-81.

19 Bernard Carboz, Der Fachmann, Sonderausgabe 1 zum ABl. EPA 2009, 91.

20 Theodor W. Adorno, Minima Moralia, Frankfurt am Main 1951, 201.

# European Inventor Award, Press release, EPO

European Inventor Award presented to outstanding inventors from Germany, France, Denmark and Australia

- European Patent Office pays tribute to ground-breaking inventions in laser eye surgery, fuel cell technology, hepatitis B therapy, hearing aid devices and wireless telecommunications
- EPO President Benoît Battistelli: "With their brilliant inventions, this year's laureates have created great economic value and thousands of jobs."

**Copenhagen, 14th June 2012** – The European Patent Office (EPO) today honoured outstanding inventors for their contribution to social, economic and technological progress with the presentation of the *European Inventor Award (EIA)* – Europe's most prestigious prize for innovation. The Danish Crown Prince and Princess, around 350 economic and political decision makers, researchers, scientists and intellectual property specialists attended the award ceremony at the Royal Danish Playhouse in Copenhagen.

The EIA is presented in five categories: "Industry", "Research", "Small and Medium-sized Enterprises (SMEs)", "Non-European countries", and "Lifetime achievement". The five winners of the European Inventor Award 2012 come from Germany (2), France, Denmark and Australia, and represent the fields of ophthalmology, fuel cell technology, medical research, medical technology and telecommunications.

"With their brilliant inventions, this year's laureates have created great economic value and thousands of jobs. Above all, they have improved people's lives", said EPO President Benoît Battistelli. "The EIA pays tribute to these creative and entrepreneurial minds for their significant contribution to technological progress, social development and economic growth."

## Winners of the European Inventor Award 2012

In the "Lifetime achievement" category, the award went to Prof. Josef Bille from the University of Heidelberg in Germany, who has filed almost 100 patents in the field of ophthalmology and paved the way in the field of laser eye corrections. Prof. Bille's ground-breaking invention of wavefront technology for laser eye surgery enables the mapping of aberrations in the iris and thus helps correct short-sightedness, long-sightedness, and astigmatism for millions of people worldwide.

In the "Industry" category, the EPO honoured the Danish team Jan Tøpholm, Søren Westermann and Svend Vitting Andersen of Widex for developing a computer-aided method to manufacture individually-fitted, comfortable hearing-aid devices. The unique stereolithographic manufacturing method CAMISHA (Computer-Aided Manufacturing of Individual Shells for Hearing Aids) has revolutionised hearing aids since its introduction. The majority of all hearing aid devices worldwide now use this technology.

The award in the "Research" category went to Dr. Gilles Gosselin and Prof. Jean-Louis Imbach at the French National Center for Scientific Research (CNRS) and Dr. Marti L. Bryant who developed an effective drug for the treatment of hepatitis B that has now been successfully commercialised. One hundred times more infectious than HIV, hepatitis B is a particularly persistent disease that chronically affects 350 million people worldwide.

Dr. Manfred Stefener (Germany), founder of Smart Fuel Cell AG (SFC), Oliver Freitag and Dr. Jens Müller received the award in the "SMEs" category for the development of the first fuel cell for portable use, the so-called direct methanol fuel cell or DMFC. Today, these fuel cells are used in a vast array of applications, including traffic management, security and surveillance systems as well as to power isolated environmental data stations. They are also recognised for their environmental friendliness.

In the "Non European Countries" category the EPO honoured Dr. John O' Sullivan, Graham Daniels, Dr. Terence Percival, Diethelm Ostry and John Deane from Australia who laid the foundation for today's wireless networking technology (Wi-Fi). The researchers from the Commonwealth Scientific and Industrial Research Organisation (CSIRO) created a technology that made the wireless LAN fast and robust so it would be as powerful as the cabled solutions of the time. Their technology forms the standard today of almost all wireless networks.

…

**For comprehensive and detailed information (text, facts & figures, photo, TV footage) on the inventions, their authors and the corporations involved, please visit www.epo-presschannel.com**.

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