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)

As we enter a new decade, we wish our readers all the very best for a period which will no doubt see many changes in general and in IP in particular. As I write this I make no excuses for mentioning that I have escaped the rigours of the worst winter in the U.K. for 30 years for the welcome heat of the Marlborough Sounds in New Zealand, so apologies for any sign of heat stroke!

That there are unforeseen climatic effects like the U.K. winter is beyond doubt, and this is reflected in our own field. Lead by the EPO, there will be a welcome future emphasis on patents for „green" technology and the decrease of CO2 emissions. WIPO (see interview in this issue with Francis Gurry, Director General) has similar objectives, as well as fostering and developing the debate on Traditional Knowledge and genetic resources.

On the political front, on 4th December 2009, EU politicians approved the principle of a unitary European Patent. This is to be coupled with a single European Patent Court. In theory, these new provision should provide applicants with more choice, and (perhaps?) less cost in obtaining patents in Europe, which should be of benefit to SMEs, universities, and individuals (as well a established „big business"). Coupled with this, it seems self-evident that the global economic crisis has had an effect on patenting world-wide (and not just in Europe). Companies are now it seems more selective in their approach to using the system. They now concentrate on „favourite" or core inventions, and are more willing to let applications and patents lapse by failure to renew those considered to be non-essential to core business. This will have an effect on the revenues of Patent Offices, not least the EPO. But it behoves us as patent attorneys to have a strategic awareness of what the patent system can do for clients, so that we can offer sound, commercial, advice so as best to enhance the „bottom line" of our clients' businesses. I make no apology for stressing that this in my (continued) view is an important aspect of the service we should provide to our clients. Gone are the days of merely filing a patent application and getting it granted. That is just a part of the process. With the advent of the unitary European patent, EPO Examiners should also be aware that granting of a patent is not the end of the road. It is but the beginning of the enhancement of the business of a client. The *epi* and the Examining body should look to ways of working together to provide a proper focus on the way that the patent system can benefit business in the future.

In that regard, the EPO clearly needs to have a new President to carry on the excellent work of Alison Brimelow. As this is being penned, (early February, 2010),we are sorry to report that the AC meeting on 2-3 February failed to vote one of the three candidates (Ms Sivborg (SE), Mr. Battistelli (FR) and Mr.Grossenbacher (CH), the necessary ¾ majority. The next AC meeting is on March 1st. We hope a conclusion can be reached so that the EPO and its new President can forge ahead into the decade. Indeed, we hope that all our readers can do the same!

STOP PRESS: at the proof stage of this issue, we heard of the election of Mr. Battistelli (FR) as the new President of the EPO, effective 1st July, 2010. We offer him and the EPO our sincere congratulations.

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 **12. Mai 2010**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about any subject you want to publish. Deadline for the next issue of epi Information is **12th May 2010**. 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 **12 mai 2010**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

epi Interview with Francis Gurry, Director General of the World Intellectual Property Organisation, Geneva 14th January, 2010

T. Johnson, Editorial Committee
Interviewer/Reporter

Dhillon Photographics

As part of *epi*'s aims to interview the important players in the world of IP, Francis Gurry agreed to be interviewed, on his and WIPO's role in the current and emerging world of IP. Kim Finnilä and your reporter took part. Prior to the interview some topics were forwarded to the DG. These topics, set out below, were intended more as an aide memoire rather than specific questions, and we believe they assisted in facilitating a free-ranging discussion.

The topics were:

1. Follow-up on the July 2009 conference on „IP and Public Policy Issues":-WIPO initiatives
2. Traditional knowledge and genetic resources
3. The benefit of IPRs for developing countries
4. Interaction between WIPO, WTO and WHO
5. The future of PCT; the PCT Roadmap
6. Trilateral and IP5
   a. PPH and PCT products
   b. The ten foundation projects
   c. The role of WIPO
7. Extending the EPO project „Raising the bar" to the PCT
8. The EU patent projects; the EU Patent Regulation [in relation to EPC and PCT]
9. Global harmonisation – how should it be defined today
10. Client-attorney privilege
11. Chairing the CEIPI Administrative Council and the future of CEIPI

The Director General took office on 1st October, 2008, for a six year term. We accordingly asked him at the start of the interview if he would give us an overview of his considered aims and achievements of his first year in office. His response was that the new WIPO building under construction in Geneva is a perfect metaphor for what is going on, namely that while there are several different building elements that have to be managed and assembled, a beautiful structure will in due course emerge. With that in mind, the DG has set in train in the first year:

a) a review of administration and management. This aims to make the organisation „user friendly" both internally for the staff, for the Member States, and for the users.

b) Staff: A performance and staff management system has been initiated, there being about 1200 staff at the present count. This system involves *inter alia* an analysis and understanding of change management, and embraces enhancing customer service structure. This will overall be a continuing one over several years but when completed WIPO should be a streamlined and efficient organisation with a staff which is contented and even more efficient than it is now.

c) Finance: A new set of accounting principles is being developed, with ultimately the implementation of IPSAS. This in turn means a review of IT, and a new IT module is accordingly being developed.

d) Environment: The Office is being overhauled so that it can move to being carbon neutral. Equally, access for the disabled is being improved and this includes steps to ensure that visually-impaired users can have as full recourse as is possible to WIPO documents and facilities.

e) Substantive issues: On the whole there has been some progress in this area. There has been a major step forward in the field of *Traditional Knowledge and Folklore which is on the path of text-based negotiations*, there is hope for advances in the copyright area, e.g norms regarding audio-visual performances, protection of broadcasting organizations, and efforts to enhance access to published works by the visually impaired. WIPO hosted a Conference on Intellectual Property and Public Policy Issues which addressed issues relating to the interface of intellectual property with other areas of public policy, notably health, the environment, climate change and food security.

f) Good progress in creating a more robust and coherent global IP infrastructure. In 2009, WIPO launched an *enhanced online patent information service* to improve public access to information on patents filed and granted around the world. WIPO's *PATENTSCOPE®*, which currently hosts data on more than 1.6 million international patent applications filed under the Patent Cooperation Treaty *(PCT)*, was extended to include several collections of national and regional patent information. The patent data collections of eight patent offices: African Regional Intellectual Property Organization *(ARIPO)*, Cuba, Israel, Republic of Korea,

Mexico, Singapore, South Africa and Vietnam were added in 2009. Also, the *Access to Research for Development and Innovation (aRDi)* program – a new public-private partnership that provides industrial property offices, universities and research institutes in least developed countries with free access and industrial property offices in certain developing countries with low cost access to selected online scientific and technical journals – was launched in 2009.

g) Service areas: WIPO had experienced a small downturn in business in 2009 owing to the decline in the global economy, for reasons which have been well-documented, e.g. applicants reduce budgets and only protect perceived „better" inventions, so fewer applications are filed. Thus there was in 2009 an approximately 5 % decrease in PCT applications and a 10 % decline in Madrid (Trade Marks) usage, but the overall decline is less in general than that suffered by National Offices.

WIPO operates on a biennial system, and for the one just ended WIPO has essentially managed to navigate the financial crisis and ended with a small surplus, as a result of careful financial and budgetary management.

So this first year has been hectic, and many challenges faced, and overcome or are in the process of being overcome. It is to be remembered that WIPO is a strategic organisation which has two roles, one being as a normative agency which must be adequately funded to support a service economy. To do this it must build confidence in the IP system with users, the public, and the staff.

WIPO also has an important role as a Development Agency, particularly for promoting IP in least developed and developing countries. As in the service area, delivery and communications are important areas for WIPO.

The future is as important as the year just completed. With that in mind, the DG said that the IP system is one with a global infrastructure, to be overarching with regard to multilateral and bi-lateral arrangements. Clear examples of this are the PCT, Madrid and The Hague (designs) systems, all of which are global in their reach and infrastructure.

The DG gave his view that *platforms* can be as important as Treaties in the current environment. The UDRP (Uniform Dispute Resolution Procedure) is a good example of such a platform. It provides a user-friendly, efficient system for handling disputes in relation to domain names. Whilst this may be a field outside the usual field of activity of some epi members, it does give an example of a platform which gives a result without costly and lengthy litigation, and one which fulfils one of WIPO's core roles of providing a technical service to the IP community. This „platform" system could be extended to other areas such as providing access via IT to books etc. to the visually impaired. Such „platforming" initiatives require the harmonisation of IT standards rather than the promulgation of new laws.

In short, there is a need for development and coordination of a global infrastructure, which WIPO is well-placed to implement as part of its core business.

Turning to agenda items in particular:

1/2. WIPO can, and within the framework of globalisation, tailor IPR requirements of different countries. For example, a developing country may not at the moment need in an in-depth legal framework for say biotech inventions, but may need one for say water treatment. WIPO can assist.

With regard to traditional knowledge and genetic resources, the developed countries need to be sympathetic to the views of developing countries, and *vice versa.* It is an international problem, but does need to be solved territorially, all IP essentially being territorial in effect. International cooperation is required, and WIPO can be a leader and facilitator.

3. With regard to the benefit of IPRs for developing countries, the DG acknowledged that IPRs have, in some media and fora, had a bad press. This can be attributed to corporate overreach in some sectors and public sector slowness, citing the example of huge patent backlogs in some Offices. There is also a communications problem in IP – the profession has not collectively promoted the idea that IPRs ultimately benefit society as a whole. The problems are exacerbated by what was previously a specialised area and which is now of general interest to the public at large. We must go to the reasons why we have IP – to promote innovation and culture (financing of culture).

Everyone is now involved in IPRs. There has been some polarisation, for example TRIPs tried to provide a comprehensive, single form of economic system, but this has created strains in what for patents in particular is a sophisticated procedure which does now impact on society, for example job creation in developing countries. WIPO can assist globally in providing an IPR structure which can benefit developing and developed countries alike, so that ultimately all countries have a strong and effective IPR system. As the DG said „If you have no oil now, you can never have oil!"

5/6. As regards the PCT, the DG is of the view that there is at present a clear window of opportunity for developing the system. There have been attempts to „design round" the system which have not been entirely successful, though major offices have agreed to utilise the potential of PCT work products, which should help to promote the PCT. One major Office (the EPO) has said that it will continue to reinforce the PCT as the main platform for work-sharing between major Offices. WIPO hopes that the USPTO and JPO will accept WIPO's own international search and examination results in the national phase, so as to reduce duplication of effort and costs to applicants.

It might be envisaged in the future that, to accommodate the linguistic diversity of the prior art, a single, coordinated international search might be undertaken

by several international authorities. Such an international search might be undertaken by a lead agency search, with other offices carrying out linguistically based searches. Whilst the DG acknowledged the increasing difficulty in dealing with developing technology, the PCT might, in this way, provide for a single international search authority which should help to reduce duration of pendency for applicants. Such a development, however, was a long way from being agreed.

7/8. Francis Gurry gave his view that it is not always clear what „raising the bar" entails for Offices or users. For PCT international authorities, quality is often discussed in terms of processes rather than norms. The measure of quality is not applied to output. WIPO is well-placed to assist in the discussion, on both formality issues and issues of substantive law.

If an EU patent comes into being, the PCT might require adjustment for the EU to accede. As a result of the Lisbon Treaty, the European Union replaced and succeeded the European Community and has a legal personality.

The DG expressed the firm and positive view that the EU would be welcomed by the International Community in the EU's participation in WIPO and the PCT. There is a will on all sides for such a development.

10. The DG views the client-attorney privilege project as „beautiful"! There are one or two technical problems for example that in some countries there is a fear that privilege could reduce protection for applicants and some civil law countries do not see the need for an international accord on the topic. The input of NGOs is important, they must actively engage in the discussion as the topic is part of society now, the public interest having always to be addressed.

11. CEIPI: The DG is also Chair of the Administrative Council of CEIPI. There has been a long-standing cooperation between WIPO and CEIPI. In the DG's view the importance of CEIPI cannot be over-stated, training of the profession of patent attorneys being paramount. Moreover, CEIPI not only imparts a high standard of loyalty among its staff, collaborators and users but it also has a respect for the „European Idea" of cooperation without artificial barriers. The Director General gave it as his view that the epi was important for the continuing operation CEIPI.

On a practical level, CEIPI is an institution which can address the „capacity" problem in patents world-wide as it has an „outreach" which can influence training via its courses, and carries out research work in IP for public institutions like the EU and WIPO. The DG expressed the firm view that he is very happy to be Chair of such an institution, which he sees as going from strength to strength.

Finally, the DG was asked for his views on epi. He could have chosen not to answer (!) but did give his view that our Institute is nowadays a strong and respected part of the IP scene, and has a voice which is listened to, one example among many being its role in supporting CEIPI as above.

Also, the DG said he would be very happy to provide WIPO speakers at for example future epi events and meetings.

WIPO is clearly in safe hands and, to mix metaphors, has a steady hand on the tiller. WIPO is it seems well-placed to fulfil its core function for patents of addressing demand management of the system in such a manner that that system can be truly global with a development agenda which meets the requirements of all countries, developing and developed alike.

We are confident that WIPO will also go from strength to strength under the leadership of Francis Gurry. It goes without saying that bearing in mind the challenges ahead, we at the epi should feel extremely privileged in being granted the interview, and are grateful to Francis for giving his valuable time to us.

How to find one's way round the EPO

Addresses and directions of the EPO locations in Munich, The Hague, Berlin and Vienna can be found on the EPO website at:
http://www.epo.org/metanav/contact.html

Report of the *epi* Committee on Biotechnological Inventions

S. M. Wright (GB), Secretary
A. De Clercq (BE), Chair

This report mainly summarizes the last yearly meeting of the Biotech Committee meeting on November 3, 2009 in Munich.

Attended:

Francisco Bernardo Noriega (ES)
Alberto Canelas (PT)
Ann De Clercq (BE) – Chair
Anne Desaix (FR)
Ludmila Gerasimovic (LT)
Roman Hak (CZ)
Anna Hally (IE)
Thorlakur Jonsson (IS)
Pierre E.J. Kihn (LU)
Sisko Knuth-Lehtola (FI)
Arpád Pethö (HU)
Bart Swinkels (NL)
Dieter Ernst Wächter (CH)
Simon Mark Wright (GB) – Secretary
Olga Capasso (IT) – Associate member
Gabriele Leissler-Gerstl (DE) – liaison person EPPC and Associate Member

Absent (Apologies):

Burkhard Bogensberger (LI)
Damjan Hodzar (SI)
Lars Höglund (SE)
Bo Hammer Jensen (DK)
Gunter Keller (DE)
Sandra Kumaceva (LV)
Katarina Makel'ová (SK)
Onur Mutlu (TR)
Christina Popa (RO)
Albin Schwarz (AT)
Jadwiga Sitkowska
Gabriella Staub (IT)
Stanislava Stefanova (BG)
Slavica Tomsic Skoda (HR)
Andreas Oser (DE) – Associate member
Daniel Pieraccioli (IT) – Associate member
Hans-Rainer Jainichen (DE) Associate member

The following issues were discussed:

Rule 30 and sequence listings

The Biotech Committee continues to press SACEPO to place the issue of Rule 30 EPC (sequence listings) on their agenda, and to consider our suggested Rule changes. SACEPO suggested that we propose a paper. We should thus do this jointly with EPPC. The biotech Committee agreed to prepare a draft for the EPPC Committee.

The committee will seek for concrete examples (5-10, if possible) to present to the EPO. It will be argued that one should be able to correct obvious errors in listings.

Mr. Swinkels mentioned ex-PCT EP cases where sequence listings had been filed at non-EPO Receiving Offices. WIPO had then not sent a copy to the EPO, and so the EPO had then requested a listing and €200. Refunds were later secured if a listing was filed with the PCT case, but not if filed later. We do not mind providing an extra copy of the listing, but we resent paying the fee (especially if it is not the applicant's fault).

Divisionals

It was concluded that there is already difficulty in calculating the 2 year deadline. It was suggested that members could write to the EPO to ask them for a list of their cases and the deadline (or at least for the EPO to place the deadline on the online register). Even when drawing up the amended Guidelines there seems to be a lack of clarity on when the 2 year time limit starts (e.g. after disunity communicated in an interview, by teleconference or Oral Proceedings, and does the 10 day notification period apply to any of these?) The amended Guidelines are expected to be published at the beginning of next year (the timing will determine if they are examined in the next EQE).

Rule 71(3) EPC

A proposal for amendment is on the Agenda for the next CPL meeting. If an Applicant makes amendments, we may not need to file the translations of the claims and pay fees until the ED has allowed the amendments.

EU Biotechnology Update

There seems to be no progress in Italy. There is still some doubt as to whether the national legislation will affect EP cases as well as national applications.

Case Law

Mr. Pieraccioli (associate member) had mentioned in an email decision T1063/06 (Board 3.3.10) which rejected reach-through claims for insufficiency. This, of course, now sets a precedent.

Mr. Wright mentioned that the HGS EP patent had been upheld in amended form (so positive for industrial applicability) even though the equivalent patent had been revoked in the UK by the High Court.

It was decided that we could ask the EPO (during a meeting which was to be subsequently held on November 4, 2009) which decisions they think are important (or ones that they are not following).

G2/08 (Dosage Regimes) – 94306847.8 (Kos Life Sciences)

Mr. Wright will attend this hearing in name of the *epi* Biotech Committee. The *epi* has filed an amicus curiae brief. Ms. Leissler-Gerstl (EPPC liaison person) would also attend. The Enlarged Board will ask the parties questions, but will not make a decision on the day. Usually the EPO President sends one or more lawyers to speak on her behalf. The applicant will also be able to speak.[1]

G1/07 (Diagnostic Methods)

Mr. Wright will attend this meeting as well in name of the epi Biotech Committee. Again, the epi filed an amicus brief. [2]

G2/07 (Essentially biological processes)

This decision is being deferred in view of the others currently being considered.

Stem cells (WARF)

It seems that the EPO will accept that a deposited stem cell line will overcome the morality objection. It is not clear whether evidence of such a deposit (or otherwise being able to obtain the cells without destruction of an embryo) in the specification is needed, though.

EU Pharma Sector Enquiry

The original draft report was changed significantly to arrive at the final report, following considerable submissions from pharmaceutical companies. The EPO seems to have used parts of the report as justification for their new Rules on divisionals, but criticised other parts (e.g. the calculation of the number of patent applications).

1 The decision in this case has been made public in the meanwhile on February 15, 2010 and the epi Biotech Committee will study it further. Ms. De Clercq, Mr. Wright and Mrs. Leissler-Gerstl attended the quite extensive and interesting hearings.

2 The decision in this case has been made public in the meanwhile on February 15, 2010 and the epi Biotech Committee will study it further. Ms. De Clercq and Mr. Wright attended the quite extensive and interesting hearings.

„Raising the bar" Initiatives

Rule 70a is seen as a major problem. It is rather odd that one has to reply to an Examiner's report at the same time that you request examination. Also, what happens if you do not respond to *all* the points raised – is the case then deemed withdrawn? Also of concern is the point at which you can make amendments voluntarily. After this opportunity, we are concerned that further amendments will be refused (and/or the EPO will issue a summons). Are we heading towards a „no second chance" system?

Another problem is for cases filed before July 2005 where there will only be a Search Report, and no written opinion. Will one still need to file a response?

Manual of Best Practice

The epi has decided to co-operate in preparation of this manual – the EPO seems keen on the project. The manual will now to include best practice for Examiner's, too.

Disunity Practice

This seems to be getting worse. Disunity seems to be far more prevalent for biotech cases (perhaps as many as 30 % of cases, compared with 6-7 % for *all* EP cases). We think the EPO is „training" Examiners better to spot disunity and clarity at an earlier stage.

EPO President

There was a general discussion of candidates for the Presidency at the Admin. Council. Members were requested to contact, and influence, their national delegations, as appropriate.

Meeting with EPO

This was scheduled for the day after the committee meeting. An agenda, with a list of topics has been produced and sent to the EPO and this was discussed (with a reduced membership) after the main biotech committee meeting. A separate report of the meeting with EPO Directors will be made and published.

February 24, 2010-02-25

Corrigendum

Further to our communication last year in epi Information 4/2009, please be informed that the address to SIPF, the Association of IP Professionals in Swedish Industry now has changed to c/o Cinnober Financial Technology AB, Kungsgatan 36, SE 111 35 Stockholm.

Next Board and Council Meetings

Board Meetings

83rd Board meeting on 12 June 2010 in Oslo (NO)
84th Board meeting on 25 September 2010 in Budapest (HU)

Council Meetings

68th Council meeting on 24 April 2010 in Dublin (IE)
69th Council meeting on 20 November 2010 in Berlin (DE)

2010 Summer Tutorial

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

In this year's summer tutorial the EQE papers of the years 2008 and 2009 papers will be taken.

The schedule is as follows:

The deadline for returning the enrolment form is May 15, 2010.

(Send to the *epi* Secretariat Fax +49 89 242052-20; info@patentepi.com)

Tutees must send their papers to their tutors not later than June 12, 2010.

Personal feedback is planned be given to the tutees before August 1, 2010.

Fees:

180,00 € per paper for non *epi* students
90,00 € per paper for *epi* students

Tutors wanted

epi organises a number of activities for assisting candidates to better prepare themselves for the EQE. Particularly *epi* organises twice per year the so-called „*epi* tutorials". The tutorial offers EQE candidates to write the last two years exam papers (at home or at their offices) and have their exams corrected and commented on by *epi* tutors. Usually we have small groups of 3–5 tutees in order to maximise the learning experience. The tutorial itself can be either via telephone or teleconference or tutor/tutees could decide to have a meeting in person.

Further *epi* organises Mock EQE exams. Last year we did one such mock in Helsinki and one in Munich. At the three day mock exam the candidates write the chosen papers under exam like conditions. The papers are reviewed by *epi* tutors. About a month later their papers are discussed with the *epi* tutors in small groups of three to five tutees during again a three day session.

epi tutors are invited to the yearly held tutors' meeting at which meeting members of the examination committee discuss that year's EQE exam.

These *epi* tutorials and mock EQEs have been found to be very valuable by the tutees. In particular tutees appreciate the personal feedback on their exam papers which is not offered elsewhere. Our tutors find it a very rewarding and stimulating activity to assist patent attorney trainees to better prepare them for the exam and becoming a good patent attorney.

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).

For any further queries, kindly contact the *epi* Secretariat (Tel: +49 89 242052-0; info@patentepi.com).

Report of APAA 15th General Assembly and 56th and 57th Council Meetings 18th – 22nd November 2009 Hong Kong

T. Johnson (GB)

APAA maintained its welcome tradition of inviting as guests sister organisations, of which the *epi* is one, to its meetings.

I had the honour and privilege of representing our Institute. Another APAA tradition is that of their President hosting a lunch for senior members of APAA and the invited guests, the latter of whom are further invited to give a short presentation of the current activities of their respective organisations. When it was *epi's* turn, I brought greetings from our organisation to APAA for continuing success, particularly as this year is the fortieth anniversary of its founding, so I wished APAA a happy 40th, observing that there is an expression in English that „ life begins at forty " ! I added that APAA has clearly had an active life in its first forty years and that the *epi* was confident that it would go from strength to strength in its next forty years. On a more substantive note, I mentioned that a report of our interview with Ms. Alison Brimelow would be published in issue No. 4/2009 of epi information, and that *epi* had taken the initiative in interviewing the four candidates for the EPO Presidency. I briefly explained the election format, advised that the texts of the interviews were on our website and presented a paper copy of each one to the APAA President. I also mentioned that in view of the lack of a clear result in the first round of voting, there would be a second round at the December meeting of the AC.

I should add that the *epi's* initiative in holding the interviews was very well received indeed; many favourable comments were made to me by APAA and other guests.

There was a full working programme, including two workshops, the first on mediation and arbitration. One of the speakers was Erik Wilbers, Director of the Arbitrator and Mediation Centre of WIPO. He gave a very illuminating talk. It seems that the WIPO Arbitration and Mediation services is being increasingly used by parties in contention as it is perceived as being quicker and less expensive than litigation.

The second workshop was on „The Working and Future of the PCT", one of the speakers being Matthew Bryan, who is Director of the PCT Legal Division at WIPO, where he reports directly to Director General Dr. Francis Gurry. The PCT is increasingly popular, there being 164,000 applications in 2008 and 100,000 up to August 2009. There are 142 PCT members, Thailand's membership becoming effective on 24th December, 2009.

The top 5 users of the system are the U.S., JP, DE, KR and CN, in that order. Mr. Bryan reported that the PCT roadmap had generally good support.

WIPO is it seems also in favour of the Patent Prosecution Highway (PPH). There will be a pilot study starting in January 2010 which will aim for a positive search report and examination leading to PPH in the Trilateral Offices. Among practical initiatives is the creation of a PCT case law database, which is open to applicants to access.

There are six standing committees of APAA. I attended the Patents Committee, which was discussing Harmonization of client-attorney privilege. There was a lively debate, including discussion of a draft resolution supporting the establishment of a WIPO Working Group on the topic.

APAA currently has about 2300 members in 24 Asian countries, so as the only international IP Group in the region is well-placed to take a leading role in IP in the ensuing years, which are expected to see the revival of the global economy being led by Asia, IP being an important aspect of that revival.

The term of an APAA President is three years, from General Assembly to General assembly. As this was the 15th General Assembly, Al Ancheta (the Philippines) stepped down, the new President, until 2012, being Mr. Kenji Yoshida from Japan.

APAA Council Meetings are held annually, the one in 2010 will be in Korea, the one after will be in Manila, and the next General Assembly will be in Thailand.

All together a very successful meeting and one which helped to strengthen the links between APAA and our Institute.

A view from the other side

T. Johnson (GB)

As an *epi* Member of the Disciplinary Board of Appeal of the EPO, most of my cases have been determined in writing. However, I recently had the opportunity to attend Oral Proceedings as a Member of the Board. As a practising attorney who has attended many Ops as a representative, this was a novel, but illuminating experience. Clearly I cannot give details of the case, my purpose in writing this note is to say to all those acting as representatives in any Oral Proceeding procedure that Boards take their task extremely seriously indeed, and make sure to be well-versed in all aspects of the case.

Moreover a Board gives the representative a full and generous hearing. The Board will also try to assist a representative on any „difficult" point by giving their view on the point, while giving full and generous attention to the view of the representative. The Members of the Board in my experience also had a very pleasant confraternity which made for a smooth running of the proceedings. All-in-all, a positive experience, which I was pleased to be able to take part in.

Next time I am a representative, I shall try to remember what it is like to be a Member of a Board in Oral Proceedings!

Never ending notices of the EPO with respect to changes of the EPC coming into force on April 1st, 2010 – addendum to the article in epi information 3/2009

S. Frischknecht (CH)
H. Kley (CH)

The authors of the article in epi information 3/2009[1] (published in German, English version available on the homepage of epi[2]/the authors[3] [4]) finished their work at a moment where further, hopefully elucidating notices of the EPO were not yet available. However, after the sequential publication of four notices in three different Office Journals a further darkened and confusing picture emerges.

The relevant notices from the European Patent Office are as follows:

I. Notice from the European Patent Office dated 20 August 2009 concerning amended Rule 36(1) and (2) EPC (European divisional applications) and consequential amendments to Rules 57(a) and 135(2) EPC; OJ 2009,481.

II. Notice from the European Patent Office dated 15 October 2009 concerning amendments to the Implementing Regulations to the European Patent Convention (EPC); OJ 2009,533.

III. Notice from the European Patent Office dated 22 October 2009 concerning the refund of the examination fee (Article 11 of the Rules relating to Fees); OJ 2009,542.

IV. Notice from the European Patent Office dated 26 October 2009 on the establishment of the date of the Examining Division's first communication for calculation of the time limit under Rule 36(1)a) EPC as from April 1st, 2010; OJ 2009,601.

All notices contain passages which are unclear and raise questions with respect to the correct interpretation and application of the new provisions coming into force on 1st April 2010.

The following examples from the different notices shall prove evidence of these unclarities and legal uncertainty arising thereof.

I Notice dated 20 August 2009

This notice deals with the filing requirements for divisional applications filed on or after April 1st 2010.

1. Rule 36(1)a) – voluntary division

According to R 36(1)a) a divisional application may be filed on the basis of a pending earlier application before the expiry of a time limit of 24 months from the examin-

1 http://216.92.57.242/patentepi/data/epi_03_2009.pdf
2 http://www.patentepi.com
3 http://www.fripat.de
4 http://www.kley.ch

ing division's first communication in respect *to the earliest application for which a communication has been issued.*

In the notice, however, another formulation was chosen, namely that in case of a sequence of divisional applications the 24-month time limit is to be calculated from the date on which the examining division's *first communication was issued for the earliest application in the sequence*, e.g. the grandparent application.

It thus remains unclear which application is to be regarded as the „earliest application for which a communication has been issued" in cases where a first communication of the examining division is issued for a divisional application and not for the very first (grand)parent application of a sequence of divisional applications.

Example:

EP1 filed on 01.04.2010.

EP2, divisional from EP1, filed on 15.04.2010.

For EP1 a slow procedure is chosen by the applicant; for EP2 the examination fee is paid immediately and PACE is requested.

This leads to the situation, that a first communication of the examining division is issued first for EP2 (child) and later for EP1 (parent).

Suppose two different cases:

Case 1: the first communication for EP2 is dated 30.04.2012 and the first communication for EP1 is dated 31.08.2012.

Case 2: the first communication for EP2 is dated 30.04.2012, EP1 was withdrawn in February 2014 and no first communication was issued for EP1.

EP1 and EP2 are in both cases still pending at the beginning of 2014 and the applicant decides to file a further divisional application EP3 based on EP2 as the earlier application. The applicant asks in March 2014, when EP3 has to be filed at the latest.

When answering this question for *case 1*, one recognizes that R. 36(1)a) is *ambiguous*:

Interpretation A: The time limit of 24 months can be calculated from the issue date 30.04.2012 (EP2), as EP2 is regarded as „earliest application for which a first communication has been issued" in the sense that the first communication for EP2 was the earliest communication ever issued in the sequence of EP1 and EP2.

Interpretation B: Alternatively one can interpret R 36(1)a) in the sense that EP1 is, in an absolute sense, the „earliest application" (very first filing) and a first communication was issued for this application.

It is thus unclear whether the condition „for which a first communication was issued" has to be read as a simple addition to the „earliest application" (interpretation B) or as a condition having an influence on the determination of „earliest" (interpretation A), and the end date can either be 30.04.2014 (based on EP2; interpretation A) or 31.08.2014 (based on EP1; interpretation B)

According to the mentioned formulation chosen in the notice of the EPO, namely „the 24-month time limit is to be calculated from the date on which the examining division's first communication was issued for the earliest application in the sequence", for *case 1* the date of the first communication of EP1 is the relevant date, as there exists a first communication which was issued for the earliest application (EP1 = very first filing) in the sequence. According to the notice there is only one end date, namely 31.08.2014 (based on EP1). The EPO seems to apply Interpretation B for R. 36(1)a).

In *case 2*, EP1 remains still the „earliest application" of the sequence of divisional applications in absolute terms (very first filing). However, as there exists no first communication for EP1, there is no starting date of the time limit of 24 months based on EP1. Interpretation B of R 36(1)a) is then not applicable. So, in order to be able to calculate a time limit of 24 months at all, interpretation A seems to be relevant, as there exists only one first communication, namely that for EP2. EP2 is then regarded as „earliest application for which a first communication has been issued". Is the EPO allowed to apply interpretation A for case 2, when interpretation B is published in the notice? Supposing a consistent application of interpretation B (as contained in the notice), in case 2 there would be never a starting date for the time limit of 24 months, so that there would exist a legal circumvention of the time limit of 24 months for filing divisional applications. This, however, was certainly not the intention of the EPO striving for a reduction of the divisional applications.

As can be seen from cases 1 and 2 and interpretations A and B of R 36(1)a), the legislation with respect to voluntary division has severe defects and is in no way consistent and concise for all supposable cases. The notice of the EPO causes confusion with respect to the interpretation of R. 36(1)a). The new provisional Guidelines[5] give in A IV 1.1.1.4 some guidance, but they reflect only the opinion of the EPO and some standard cases. The true intention and meaning of „first communication of the earliest application for which a communication has been issued" has to be given by a decision of a board of appeal. However, until such a case will arise and be decided there remain several years of legal uncertainty.

2. R. 36(1)b) – mandatory division

The mandatory filing of a divisional application only within a time limit of 24 months seems to be in clear contradiction to Art. 4G(1) of the Paris Convention (PC). In contrast to PC Art. 4G(2) applying to the voluntary filing of a divisional, PC Art. 4G(1) does not impose the possibility, that each country of the Union shall have the right to determine the conditions under which such division shall be authorized. Therefore, the 24-month term for mandatory division as contained in R 36(1)b) is not in accordance with the PC and violates Art. 19 of the

5 http://www.epo.org/patents/law/legal-texts/guidelines-2010.html

PC that does not allow legislations of the union countries in contradiction to the PC.

As already outlined in the previous article, a severe defect of the EPC becomes obvious, since there exists no instance (court or the like) to check the conformity of the EPC with other treaties, such as the Paris Convention.

3. Further questions

Other important questions concerning the new time limit of 24 months remain open, such as:

– Is the time limit of 24 months interrupted or suspended in case of a request for re-establishment of rights for the earlier application? Such requests take easily a time period of 12 and more months. What is he meaning of Art. 122(3) in this particular context:

  „If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued"?

  It is very likely that the time limit of 24 months will expire after a grant of a request pursuant Art. 122. For a request the applicant has to complete the omitted act within the relevant time limit for filing request for re-establishment of rights (and to state the grounds on which the request relies and to set out the facts). However at this moment of filing a request for re-establishment of rights a precautionary filing of a divisional, fails, since the parent application is at this moment no longer pending.

  We exclude here in particular the case, where an applicant may request re-establishment of rights in respect of having missed the 24 month time limit for filing a divisional application.

– When a board of appeal (in ex-parte proceedings) states that claimed subject matter in a application is not in conformity with EPC Art. 82, is such a statement a first communication in the sense of the new R 36(1)b)?

II Notice dated 15 October 2009

The Notice from the European Patent Office dated 15 October 2009 raises unavoidably questions about „what is an amendment in the context of the EPC":

– In point 3.2 of this notice it is correctly stated that under EPC R 137(1) the application cannot be amended at this stage. But an appropriate response to an invitation under EPC R 63 might therefore be an improvement of the wording of the claims so as to remedy the defects. This improved wording will then be formally introduced to the proceedings as an amendment together with the reply to the extended European search report EESR. How is it possible to file an improvement of the wording without amending the claims? This passage of the notice is in contrary to R 137(1). The EPC gives no basis for a distinction between „amendments" and „improvements" and furthermore, no basis for „filing improvements" at this stage of the procedure. Furthermore, it is unclear, how the „improved wording" will be formally introduced to the proceedings. Does the filing of an „improvement" in reaction to an invitation under R 63 EPC automatically imply the formal introduction of this „improvement " as an amendment in a later stage of the proceedings?

– In point 5.2.2 of this notice it is stated:

  „Amendments which are filed on entry into the European phase are deemed to be a relevant response, so there is no need to reply to the EPC Rule 161(1) communication."

  Will in this particular case the EPO nevertheless issue such a communication? The answer must be affirmative, since according to PCT Art. 28(1) (for Designated Offices DO) and according to PCT Art. 41(1) (for Elected Offices EO) the EPO is obliged to issue a communication. It is up to the applicant/representative to decide, whether his amendments on entry of the European Phase were sufficient in order not to be obliged to respond substantially to the R 161(1) communication. However, the question remains what is an amendment in this particular case? Many applicants/representatives cut the number of claims and/or rearrange the claims to a number of 15 claims only in order to avoid paying additional claim fees. This amendment of claims by entering European phase does in general not answer to the issues raised in the WO-ISA. If the decision of the applicant/representative is wrong, the application shall be deemed to be withdrawn, since the applicant does not comply with the new R 161(1).

Furthermore, the notice from the European Patent Office dated 15 October 2009 gives no answers regarding procedural consequences due to the new R 70a(1) (mandatory response to the EESR):

Even with a response to a communication pursuant R 70a within the prescribed time limit there is potentially a risk that the examining division could refuse the application. Here every applicant/representative is well advised to put auxiliary requests, that in case oral proceedings are requested before the application should be refused.

III Notice dated 22 October 2009

The Notice from the European Patent Office dated 22 October 2009 concerning the refund of the examination fee (Article 11 of the Rules relating to Fees RRF); OJ 2009,542 must be considered as arbitrary and superfluous. RRF Art. 11 provides itself clear conditions regarding the refund of the examination fee, which remains also applicable under the new provisions as from April 1st 2010. Nevertheless, the EPO introduces by this notice new time limits for different cases (Euro direct filing, Euro-PCT application without or with the EPO as ISA) in order to get the 75 % refund of the examination fee when withdrawing the application. These time limits are arbitrary set and they are in contradiction to RFF Art. 11. It is normally unlikely that the EPO will start with the substantive examination within these

time limits. All applicants/representatives know cases, where the first communication pursuant EPC Art. 94(3) is issued years later after the mention in the European Patent Bulletin of the publication of the European search report. Obviously an applicant has no possibility to recognize if the substantive examination has begun or not. Up to today the principle of good faith has to be applied for the relationship of both partner's applicant/representative and the Patent Office when deciding over the 75 % refund of the examination fee. With its notice dated 22 October 2009 the EPO needs obviously to clarify the relationship between itself and the applicants/representatives, since the EPO no longer likes to apply the principle of good faith with respect to the 75 % refund of the examination fee.

IV Notice dated 26 October 2009

The notice from the EPO dated 26 October 2009 on the establishment of the date of the Examining Division's first communication for calculation of the time limit under EPC Rule 36(1)a) as from 1.4.2010 is only an advertisement for EPO-Products. This notice does not help the applicant/representative to establish the date of the first communication of the examining division. As the data on such products may contain errors, the applicant/representative is obliged to check the right date by file inspection. It seems for the authors that the leading people of EPO intend to dismiss the applicants/representative.

V Summary

As already concluded in the previous article (epi 3/2009)[6], the amendments of the implementing regulation result in a considerable higher complexity of the proceedings and increase the procedural costs. The EPO, probably recognizing some difficulties in these amendments, has tried to retrieve the situation by issuing its notices. However, the notices issued so far by the EPO raise even more questions, uncertainty and ambiguity. As the notices are not part of the legal framework to be regarded by the boards of appeal, the applicant/representative is well advised to base his/her decisions only on the new rules, especially according to worst case scenarios, and to act very careful.

It is hoped that the EPO will recognize that the amendments coming into force on April 1st 2010 are legally not mature and will lead to artificially complicated and complex procedures as well as many cases before the boards of appeal. *The amendments of the implementation regulation coming into force on April 1st should be withdrawn* – this would be a reasonable and courageous action in order to avoid many problems for all persons involved (applicants, representatives and EPO staff) in the procedures before the EPO.

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Nicht erledigte Patentanmeldungen: eine fortwährende Geschichte

A. W. Kumm (DE)

Zur Lage

Das Problem ist alt: Seit mehr als einhundert Jahren schieben materiellrechtlich prüfende Patentämter Berge noch nicht erledigter Patentanmeldungen vor sich her, denn seit den industriellen Großproduktionen im 19. Jahrhundert wachsen ständig die zu patentierenden technischen Erfindungen. Zwar erhöht sich gleichermaßen die Zahl der Prüfer, dennoch stapeln sich Arbeitsrückstände.

Das deutsche Patentgesetz von 1968 normierte erstmals zwei verschobene Prüfstufen in der Erwartung, dass sich nach der ersten Stufe, der Ermittlung öffentlicher Druckschriften, die recherchierten Anmeldungen merklich mindern würden. Das Europäische Patentübereinkommen von 1973 (EPÜ) übernahm dieses Modell.

Die Erwartungen erfüllten sich nicht. Die Anmelder mussten alsbald wieder Rückstände hinnehmen, wie zuvor schon (und von anderen Patentämtern noch gewohnt).

Richtlinien zur Steigerung der Wirksamkeit des EPA

Das Europäische Patentamt (EPA) und der Verwaltungsrat (VR), bemühen sich seit drei Jahren, die „Produktivi-

6 http://216.92.57.242/patentepi/data/epi_03_2009.pdf

tät" des EPA zu steigern und den Aktenstau abzubauen, indem sie weitere Regeln in die Ausführungsordnung (AO) zum EPÜ 2000 einfügen. Zuletzt wurden Aufgaben der Recherche- und der Prüfungsabteilung verquickt und höhere und neue Gebühren sowie kürzere und neue Fristen verordnet.[1, 2]

Die Effizienz des EPA ist aber ein grundsätzliches und kein formalrechtliches Problem. Die Wirksamkeit des EPA lässt sich daher nicht durch Steigerung der AO-Regeln – EPÜ und AO umfassen bereits über 400 verschachtelte Vorschriften – steigern, auch nicht durch ein zusätzliches EPA-Handbuch der optimalen Praktiken.

Feststellungen und Thesen zu einem rationellen Erteilungsverfahren

1. Das Gestalten eindeutiger Patente auf technische Erfindungen obliegt der natur-wissenschaftlich-technischen („technologischen") Begriffs-, Definitions- und Schlusslogik; ihre Ergebnisse sind den erkenntnistheoretischen Wahr-Falsch-Kriterien unterworfen.[3] Die Jurisprudenz kann dagegen nur gute formalrechtliche Normen (Verfahrensregeln) bereitstellen. Sie sind nach Ermessen festgesetzt und können daher nur nach ihrer Zweckmäßigkeit (und nicht als wahr-falsch) bewertet werden.
2. Seit jeher schreiben alle Patentgesetze mit Prüfverfahren vor, so auch das EPÜ, dass die Anmeldungsunterlagen auch Patentansprüche enthalten müssen.
3. Für die allermeisten Anmelder ist es zweckdienlich und sogar ratsam, diese ersten Ansprüche zunächst technisch-begriffslogisch viel zu allgemein (quasi als Luftblasen) zu fassen, zumal sie oft noch nicht gegen Bekanntes abgrenzbar sind. Die Vertreter amerikanischer u. ä. Nachanmeldungen reichen zur eigenen Sicherheit zumeist die ursprünglichen einteiligen (oft nur geringfügig veränderten) Ansprüche ein; diese wiederholen sich inhaltlich zum Teil. Für einen umfassenden Patentschutz mit diesen einteiligen Ansprüchen sind zum Beispiel für *ein* Erfindungsprinzip mit *n* Ausgestaltungen 2^n claims nötig. (Das „europäische" zweiteilige Schema erfordert hierfür nur *1+n* – freilich technologisch exakt definierte – Ansprüche (*ein* Hauptanspruch und *n* technisch sinnvoll zurück bezogene Unteransprüche).[3]
4. Die ersten Ansprüche haben also in der Regel technologisch nur einen vorläufigen Charakter; sie sollen insgeheim nur der Anmeldevorschrift genügen.
5. Eine Recherche, die nur auf Patentansprüche ausgerichtet ist, ist regelmäßig nicht effizient, zumal den „Luftblasen" oft vielerlei fragwürdige, letztlich nur Kosten treibende Druckschriften entgegen gehalten werden.
6. Für eine pure Recherche sind also Patentansprüche noch nicht nötig, zumal der Anmelder zweifellos *alles* geschützt haben will, was er hinreichend offenbart hat.
7. Allein auf Grund dessen, was hinreichend offenbart ist, können ein für allemal die grundlegenden Erfindungsmerkmale festgestellt *und* festgesetzt werden, nämlich (a) ob der Erfindung ein neues naturgesetzliches Prinzip zu Grunde liegt, (b) welche technische Gesamtwirkung mit diesem Prinzip erzielbar ist und (c) welche technischen Mittel dafür offenbart wurden. Diese müssen wenigstens *ein* unabdingbares Erfindungsprinzip – evtl. mit noch *n* abdingbaren Ausgestaltungen – definieren. Dann kennzeichnen diese *1+n* Realdefinitionen, die allein schutzfähig sind, eindeutig ein *technisches* Objekt (Vorrichtung und/oder Verfahren). Wenn mehrere Erfindungsprinzipien samt jeweiligen Ausgestaltungen offenbart worden sind – sie müssen „einheitlich" sein (gleiche technische Gesamtwirkungen der Erfindungsprinzipien) – dann liegen mehrere „einheitliche" technische Objekte vor.[3, 4]

Eine solche technische Analyse mit anschließender Neuheitsprüfung ist zwar intellektuell anspruchsvoller und zeitaufwändiger als die schnelle Recherche aufgeblasener, vorläufiger Ansprüche. Dennoch ist sie für alle Beteiligten effizienter, denn ihre begrifflichen Ergebnisse stehen ein für allemal fest – auch für noch abzugrenzende Ansprüche –, was immer auch die zweite Prüfstufe ergeben wird.[5]

8. Evident ist also: Ein zweistufiges Prüfungsverfahren wird am wirkungsvollsten, wenn die Prüfung konsequent von zunächst minimalen zu optimalen Anmeldungsunterlagen schreitet: (a) Eingangs nur Unterlagen im minimal nötigsten Umfange (eine Alles schon abschließend offenbarende Beschreibung, evt. Zeichnung, evt. aussagefähiges Abstrakt, noch keine Ansprüche). (b) Nach der Recherche eine sachlich maximal erforderliche Patentakte (treffender Zustand der Technik, die schon eingereichte Beschreibung, evtl. Zeichnung und erst jetzt Patentansprüche in Form zweiteiliger, abgegrenzter, patentierbarer Realdefinitionen).[6]

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1 Frischknecht, S. und Kley, H: Änderungen ohne Ende an der Ausführungsordnung des EPÜ 2000 – Was will der Verwaltungsrat der Europäischen Patentorganisation? In: epi Information, 3/09, 93–99. Dazu die Kommentare von P. Roos und von I. Heinzelmann, beide in epi Information, 4/09, 140.

2 Die neue Regel 70a des VR unterwandert die Artikel 17, 18, 92 und 94 des EPÜ 2000. Sie ist gesetzwidrig, denn die legislative Hoheit liegt nur bei der „Patentorganisation" = Vertragsstaaten. Gleichwohl ist es ökonomischer, die gesamte Patentprüfung *einer* Prüfstelle anzuvertrauen, denn jede Recherche ist als Neuheitsprüfung bereits eine materiellrechtliche Prüfung.

3 Vgl. die erkenntnistheoretisch begründete Zusammenfassung von Kumm. A. W.: Wie fortschrittlich ist die Patentrechtswissenschaft? In: Mitteilungen der deutschen Patentanwälte, 78 (1987), 234-236 (mit weiteren Literaturhinweisen).

4 Diese notwendigen Kennzeichen erschließen sich nicht aus den ersten, noch bestimmungsgemäß eingereichten Ansprüchen: Diese sind insofern für eine sofortige, umfassende Prüfung irrerelevant.

5 Die zweite Prüfstufe – mit ihrem Hin und Her um die begabungspsychologische, nicht operable „Erfinderische Tätigkeit" – könnte auch noch effizienter werden. Ein leitender Prüfer des Deutschen Patentamtes bezeichnete sie kürzlich in einem Vortrag als die „Sphinx des Patentrechts".

6 Postskripta: (1) Das zeitgenössische Patentrecht wird geprägt von zahllosen Formvorschriften und von übersättigenden richterlichen Einzelfall-Entscheidungen. (Anscheinsbeweis: Vergleich des Umfangs der Erstauflagen des „Benkard" mit dem der Zehnten von 2006.) Die Einzelfall-Richtersprüche beanspruchen quasi normative Rechtswirkungen. Wegen dieser unübersichtlichen Vielfalt ist für viele Erfinder, Forscher und Entwickler das Patentwesen nur noch ein technikfernes, filigranjuristisch abgeschlossenes System mit bloß internen Dynamiken. (2) Einflussreiche Weltwirtschaftler lehnen das heutige Patentwesen ungewöhnlich scharf ab. Warum? Sehr viele Patente dienen nur als Massen- Kampfmittel im Wirtschaftskampf der ganz großen, global tätigen Konzerne. Daher ist es letztlich egal, ob die patentierten Erfindungen technisch belanglos sind, ob die Patente nur naturgesetzliche Wirkungsweisen, nur technische Funktionsweisen oder nur Gedankenfolgen (Algorithmen mit ihren vermeintlich „technischen" Effekten) schützen; Hauptsache: Alles ist vom fiktiven „Fachmann" mit seinem nicht widerlegbaren Wissen und Können – als ohne weiteres realisierbar – abgesegnet.

The concept of „unambiguous and direct disclosure" – future perspectives in view of T 1107/06 and T 1443/05[1]

A. Koch (DE)[2] and G. Weinzierl (DE)[3]

After the Enlarged Board of Appeal's decision G 2/98 was handed down, it has become clear that claiming priority of the ‚same invention' is possible only if the subject matter claimed in the later application can be derived directly and unambiguously from the earlier application as a whole, using common general knowledge.

Up to that decision of the Enlarged Board of Appeal there have been essentially two lines of cases in the EPO concerning the basis required for a claim to be entitled to priority. In one line of cases a narrow and strict interpretation of the concept of the ‚same invention' was applied – it was held that for a valid priority claim the relevant subject matter must be present either expressly (*expressis verbis*) or implicitly in the earlier application. The other line of cases suggested a broader and less strict interpretation of the concept of the ‚same invention' – it was held that the presence of an additional feature in a claim is excusable if that feature is a mere disclaimer or if that feature is a matter of ordinary choice for the skilled person. In either case the additional feature, which as such was not disclosed in the earlier application, must not be related to the function and effect of the claimed invention. If the latter requirement is fulfilled, the aditional feature is not detrimental for validly claiming priority, since it does not change the character and nature of the claimed invention.

The President of the EPO decided that the two lines of cases were in conflict and asked the Enlarged Board of Appeal to advise whether a narrow and strict interpretation or an extensive and broad interpretation of the priority test was legally correct.

The Enlarged Board of Appeal decided that the priority test has to be narrow, and that priority can be acknowledged only if „…the skilled person can derive the subject matter of the claim directly an unambiguously, using common general knowledge, from the previous application as a whole".

Therefore, in order to give rise to entitlement of priority the disclosure of the essential elements of the invention must either be literally expressed, or be directly and unambiguously implied by the earlier application as whole.

The concept of direct and unambiguous disclosure is also applied in the assessment of whether or not an amendment made to a claim (or the specification) adds matter; see, for example, T 1206/01 or T 731/03.

Specifically, Article 123(2) EPC requires that „a European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed."

Case law has provided guidance on the meaning of subject-matter, which extends beyond the content of the application as filed and it turned out that the test for an allowable amendment is similar to that for a valid claim to priority for the ‚same invention'. Indeed, an amended claim may also be directed to such subject matter only which is directly and unambiguously derivable from the application as filed. Common general knowledge is to be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document. Implicit disclosure, thereby, relates to matter which is not explicitly mentioned, but is a clear and unambiguous consequence of what is explicitly mentioned.

Apparently, the same standard is applied for assessing as to whether a priority claim is valid under Article 87 EPC, or an amendment of the European patent application is admissible under Article 123 (2) EPC. In all these cases the boundaries of what is admissible are set by what is directly and unambiguously disclosed in the respective document. Thus, the amendment must not present the skilled person with information which is not directly and unambiguously derivable from the application as filed, even when account is taken of matter which is implicit to a skilled person.

Two recent decisions T 1443/05 and T 1107/06, however, could shed new light on the concept of unambiguous and direct disclosure, in particular on possible differences of this concept in regard to the assessment of priority and the assessment of whether or not an application/patent contains new matter.

In T 1443/05 the competent Board had to decide whether or not the subject matter of the main claim was disclosed in the earlier application in order to validly claim priority.

The earlier application disclosed a biocide composition as an additive to materials which can be attacked by harmful microorganisms containing at least two biocidal active agents, one of them is 2-methylisothiazoline-3-one (MIT) and further comprising 1,2-benzoisothiazoline-3-one (BIT).

5-chloro-2-methylisothiazoline-3-one (CMIT) was disclosed in the specification as another additional active agent of the claimed composition.

The application as filed concerns the same composition, apart from disclaiming a composition comprising

1 The authors' view is their personal view
2 Patentanwalt, European Patent Attorney, df-mp
3 European Patent Attorney, df-mp

CMIT as another additional active agent of the claimed composition.

Board 3.3.01 stated in their reasons in points 4.1.5 and 4.1.6 of T 1443/05:

„In accordance with the case law of the Enlarged Board the requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole (G 2/98, OJ EPO 2001, 413).

The Board, in contrast to the contested decision, does not regard this requirement as being fulfilled merely because of the fact that the claimed compositions including the disclaimer would not extend the disclosure content of the priority document. A limitation as such is thus not sufficient to acknowledge the priority right if the limited subject matter cannot be unambiguously and directly from the priority application. [authors' translation]

Thus, the Board denied entitlement to priority, and they held that the invention as disclosed in the application as filed is not the same invention as in the earlier application, because of the disclaimer for CMIT.

In T 1107/06, the Board had to decide as to whether or not a disclaimer (not having a literal basis in the application as filed) for a specific embodiment would offend Article 123(2) EPC. Board 3.3.04 ruled that

„A disclaimer does not infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed".

Put in other words, decision T 1107/06 allows re-formulating an embodiment disclosed in positive terms as a disclaimer (i. e. in negative terms) without the violation of Article 123(2) EPC.

The Board was well aware of previous decisions from other Boards of Appeal that refused undisclosed disclaimers, i. e., disclaimers that are not disclosed in the application as filed, not even in positive terms, and concluded that the rules set out in G 1/03 as regards undisclosed disclaimers would merely apply to „truly" undisclosed disclaimers:

„As already set out above, the Enlarged Board restricted its analysis to so-called undisclosed disclaimers which, in the light of the questions referred, were not meant to include disclaimers excluding subject-matter originally disclosed as embodiments in positive terms." (point 43 of the Reasons)

In their next step, the Board analyzed whether the application as filed provided support for the disclaimer (as an embodiment described in positive terms):

„The board therefore considers that the decisive question to ask in the present circumstances under Article 123(2) EPC is not whether the skilled person could infer from the original disclosure that the applicant intended to exclude the subject-matter of the disclaimer from the scope of protection. Rather it has to be ascertained whether there is a clear and unambiguous disclosure of the subject-matter remaining in the claim. Applying the established yardstick to be used in the framework of Article 123(2) EPC, such disclosure may be explicit or implicit. Implicit disclosure includes what any person skilled in the art would consider necessarily implied by the patent application as a whole" (see T 860/00 of 28 September 2004, point 1.1).

The board takes the view that when there is a generic disclosure of the invention together with a specific disclosure of an illustrative or preferred embodiment falling under the generic disclosure, the skilled person will normally imply that all the other embodiments comprised in the generic disclosure without being mentioned specifically also form part of the invention. The non-exemplified or non-preferred embodiments are thus implicitly disclosed as the logical complement of the exemplified or preferred embodiments (points 45 and 46 of the Reasons).

In essence, T 1107/06 rules that if an embodiment is disclosed in positive terms, it is concurrently disclosed in negative terms. Thus, a disclaimer when drafted on the basis of an „implicitly" disclosed „negative" embodiment is not an undisclosed disclaimer and, consequently, the rules set out in G 1/03 for undisclosed disclaimers are not applicable.

What could be the consequences of the rulings set out in T 1443/05 and T 1107/06?

There seems to be a different standard regarding the interpretation of an unambiguous and direct disclosure in the assessment of priority entitlement and added matter. In T 1443/05, the Board took the view that the inclusion of a disclaimer which as such is only based on an element which was positively disclosed in the earlier application alters the invention to such an extent that the priority claim is no longer valid. Obviously, the Board was not of the opinion that a technical teaching based on a „positively" disclosed element directly and unambiguously discloses the very same technical teaching in relation to the same element disclosed in „negative" terms. In T 1107/06, however, the Board was of the opinion that a technical teaching based on an element disclosed in positive terms, directly and unambiguously discloses a technical teaching based on said element disclosed in negative terms as well.

Accordingly, if the *ratio decidendi* of T 1443/05 is applicable, then a claim containing a disclosed disclaimer (either a literally or „implicitly" disclosed disclaimer) cannot validly claim priority.

By the same token, if the *ratio decidendi* of T 1107/06 is applicable, i. e., an embodiment disclosed in positive terms can be excluded by way of disclaimer, and bearing concurrently in mind the *ratio decidendi* of T 1443/05, then that claim containing the disclosed disclaimer (implicitly disclosed by way of a positively disclosed embodiment) would not be entitled to the earlier application.

If, however, the Board's rulings in T 1107/06 were to be applied to the case underlying T 1443/05, then prior-

ity would have had to be acknowledged. In fact, the earlier application underlying the patent under dispute disclosed in positive terms what the application as filed then disclaimed. By way of disclosing the „positive" embodiment, the earlier application would – in accordance with decision T 1107/06 –disclose its „negative" offprint as well. Thus, the priority document would implicitly disclose the then-disclaimed embodiment and, as a result, the application as filed could have validly claimed priority. However, Board 3.3.1 ruled the opposite.

Given the above, though T 1443/05 ruled on the standard regarding the interpretation of an unambiguous and direct disclosure in the context of the assessment of priority entitlement and T 1107/06 ruled on that in the context of the assessment of added matter, there seems to be different standards regarding the interpretation of an unambiguous and direct disclosure in the assessment of priority entitlement and added matter. Therefore, care must be taken to make sure that when amending claims by way of a disclosed disclaimer (T 1107/06) the very same amendment could concurrently cause the loss of priority entitlement (T 1443/05).

Traps when transferring priority rights, or *When in Rome do as the Romans do*: A discussion of some recent European and national case law and its practical implications

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Summary:

Severe problems with assignments of priority rights are illustrated by discussing recent French, British, US and EPO case law. Assignments of priority rights in many countries are subject to the national law of the country of the subsequent application, and are not assessed by using the law applicable by virtue of the contractual situation. The requirements for a valid assignment of the priority right in different countries differ significantly, and since the assignment of a priority right has to have taken place before a subsequent application is filed in another country, the assignment of a priority right cannot be rectified retroactively later on. What makes things even more delicate is that if an assignment of a priority right is invalid under national law requirements, such a defect can be invoked by any third party in a nullity proceeding. The assignment documents to be prepared in the priority year thus have to comply with all the different national requirements in all the countries where subsequent applications shall be filed in order to be valid everywhere. At the end some advice is given how to avoid problems with assignments of priority rights.;

I. Outset and practical example

US provisional applications are quite often filed by Europe based companies as priority applications for patent families. This is mainly due to the Hilmer doctrine which attributes no defensive effect to a priority application if it has not been filed in the US and does not have a US filing date.[1] Like any other application in the United States, US provisional applications have to be filed in the name of the inventors. A US provisional application goes abandoned 12 months after its filing date and subsequent US or other national applications have to be filed prior to the expiration of these 12 months if ultimately protection is desired. After the filing of US provisional applications it is thus neither necessary nor usual to record a transfer of such a provisional applica-

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1 For a subsequent regular national US application the claim to a priority application filed outside of the US only has the effect that the applicant can avoid state of the art published in the priority interval. It can however not prevent that a third party may obtain a patent to the same invention based on an application with a US filing date in the priority year (no defensive effect. „Priority is a shield but not a sword"). If however a US priority application, e.g. a US provisional application, is filed as a priority application, the priority date is a US filing date and thus the priority also has defensive effect. For details see MPEP or e.g. R.L. Mayer, Das US Patent, 3. Auflage, Heymanns Verlag 2003, 314-318.

tion to a successor in title of the inventors, i.e. to an employer or a cooperation partner.

According to Art. 4 Paris Convention the right to priority can only be exercised by the applicant of the priority application or by the successor in title of this applicant. If therefore a subsequent application is not to be filed in the name of the inventors but for example in the name of an employer (company) of the inventors or of a buyer of the application, prior to the filing of the subsequent applications a so-called assignment of the priority right has to take place.[2]

According to Swiss law, just to give one example of a possible national law, an assignment of property does not require to fulfil formal requirements unless expressly provided for in the law.[3] An assignment can therefore also be valid if there is mutual oral agreement or if there is mutual agreement manifested by conclusive action.[4]

While a written requirement is provided for in Switzerland for the assignment (obligation and transfer) of patent applications or granted patents,[5] there is no such requirement for the assignment of the right to the patent[6] or for the assignment of a priority right.[7] A priority right can therefore be assigned without particular formal requirements to be fulfilled. The assignment can be valid if there is mutual oral agreement or agreement manifested by conclusive action.

If nevertheless the transfer is put down in writing, according to Swiss law it is furthermore not necessary that both parties, assignee and assignor, sign such an act. It is sufficient, provided the assignee does not undertake a specific obligation such as a payment in return, that the assignor signs such a transfer document.[8] The new owner thus does not necessarily have to expressly accept the transfer by signature for the contract to be valid.

In practice it is quite common that the transfer of „inventions" or of priority rights is very generally provided for, e.g. at the beginning of a cooperation or the like, in a cooperation agreement. The specific assignments are prepared later on as separate, specific, and often brief standardised assignment declarations prepared by the attorney. These assignments are normally prepared just for the sake of registration with the patent offices without disclosing the details of the confidential contractual details. Since the assignee does not undertake a further obligation in these cases, such assignments are often signed by the assignor only, i.e. only by the applicant of the priority application.

To come back to the above example, it at first sight seems reasonable to assume that if a US provisional application or the priority right provided thereby is to be transferred from a Switzerland based applicant of the priority application to a Switzerland based assignee, it should be validly transferred if the assignment complies with Swiss national law.

In such a situation it should therefore be sufficient if it can be shown that according to Swiss law the priority right of the US provisional application has been validly transferred before the filing of a subsequent application to validly claim its priority in any other country. The validity of such an assignment is, as shown above, neither dependent on written form, nor, if in written form, dependent on the fact that both parties to the contract have signed the contract: it is often sufficient if just the applicant of the priority application signs the assignment.

The same should hold true if the priority application is not a US provisional application but a first application in any other country, e.g. in France or Germany, and if this first application is transferred with the corresponding priority right or if just the priority right is assigned.[9] An informal assignment of the priority right seems to be sufficient here as well under Swiss law.

The considerations given for Swiss law here can of course be extended by analogy to any other „country of origin" of the invention and the corresponding law. If there are for example a German based applicant of the priority application and a German based assignee of the priority right, German law should apply.[10]

Generally speaking, the key issue is the question which law is applicable to an assignment of a priority right, and the basic problem here is that it is most likely not the (single) law of the country of origin of the contract but the (multitude of) laws of the countries of the subsequent applications.

II. Recent case law dealing with the assignment of priority rights

Recent case law shows that one may not be able to rely on a single national law understanding of a legally valid transfer of the priority right, or of an application together with the associated priority right: there is a danger that it may normally not be sufficient if according to a single national law[11] a priority right is validly transferred.

2 In fact the expression „assignment of priority right" for most situations is not precise. What is generally meant by this expression is the transfer of the right to the patent in other countries claiming the priority of the priority filing. The right to the patent in other countries and the priority right in principle can be distinct from each other, for example if the priority application has been filed by a non-entitled applicant.

3 Art. 11 Swiss code of obligations, a written form requirement has to be given narrow interpretation, see e.g. Federal High Court decisions BGE 116 II 127; BGE 113 II 404.

4 Art. 1(2) Swiss code of obligations. Conclusive e.g. if acts are performed which fulfil the mutual obligations.

5 Art. 33 (2bis) Swiss Patent Law.

6 Art. 33(1) Swiss Patent Law.

7 At least according to doctrine, there seems to be no Swiss case law, see e.g. P. Heinrich, PatG/EPÜ, 1. Edition 1998, PatG 33 N 33.06 ; Thierry Calame in SIWR IV 177, as well as footnote Fn 40 therein.

8 See e.g. P. Heinrich, PatG 33 N 33.04

9 According to Swiss law the priority right can be assigned independent from the priority application (see e.g. Heinrich PatG 18 N Rn 18.01; in agreement with G.H.C. Bodenhausen, Guide d'Application de la Convention de Paris pour la Protection de la Propriété Industrielle, Genf 1969, 38 and 40; R. Wieczorek, Die Unionspriorität im Patentrecht, Heymanns Verlag 1975, 136). This view can be based on Paris Convention Art. 4 A (3), which states that the subsequent fate of the initial application dose not influence the right to claim its priority. Also the European Patent office seems to share this view, see T0062/05, R 3.6. Certain countries impose restrictions under certain situations, e.g. France, where according to CPI Art. L. 614-14 a French priority application and its priority right for a subsequent European application can only be transferred together.

10 Also in Germany such an assignment of a priority right does not have to be in written form according to §§ 413 and 398 BGB, see in this respect G. Benkard, Patentgesetz, 10. Auflage, Verlag C.H. Beck, IT 35.

11 be it a national law of a country of origin, i.e. of the country where the first filing is made, or a law in accordance of the assignment deed.

1. European case law, in particular T0062/05

Recently the Boards of Appeal of the European patent office, in decision T 0062/05, have applied a much more severe standard for a valid transfer of the priority right of a first filing. The Board stated that in view of the importance of the validity of the transfer of the priority right the same standard has to be applied for such a transfer as for the transfer of a European patent application. The conditions for a valid transfer of a European patent application are defined in Art. 72 EPC. According to this decision a valid transfer has to be in writing and has to be signed by both parties.

In the specific case, a Japanese priority application was filed in the name of Nihon GE Plastics K.K., the subsequent European application however in the name of General Electric Co. An assignment document for the priority right dated prior to the filing date of the European subsequent application could not be produced by the patentee. The attempts of the patentee to prove that the assignment had actually taken place implicitly and this by reference to later documents, which unfortunately did not specifically mention the patent in suit, failed. So did the attempts to prove that the filing strategy was common policy within the group and transfer proven by conclusive action. The Board stated that in view of the importance of the priority its transfer needs to be proven formally, and that therefore the same standard as for the transfer of European patent applications, namely the one as defined in Art. 72 EPC, has to be applied. Therefore assignment must be in writing and it must be signed by both parties. The Board even specifically pointed out:[12] *Thus, even if an intention to transfer priority rights might have been be discerned from documents D33a and D33b, the Board can only state that this intention has not been finalized in a form which would indubitably establish that the transfer of the priority rights for the filing of an European patent application on the basis of the Japanese patent application JP 24986597 has taken place before the end of the twelve month period starting on 29 August 1997*. It was not even addressed in the decision that for the question of validity of the transfer a legal framework (like in this specific case for example Japanese law) could be applicable other than the legal framework of the European patent Convention. It would be desirable to have a further decision clarifying this issue.

In particular as there is well established older European case law dealing with this question, which is even discussed in the official collection „Case Law of the Boards of Appeal (Fifth edition 2006)", and which is mentioned in the Guidelines for Examination.[13]

Specifically in J 0019/87 the issue was a case where a first GB priority application was filed in the name of A, this application was subsequently transferred with all rights derived therefrom to a B, and was, still within the priority year, transferred back to A. The European subsequent application filed in the name of A and claimed priority of the GB priority application. The first assignment document from A to B on file was in writing and signed by both parties, while the second assignment document from the interim assignee, B, back to A was not signed by the latter, so it was only signed by B.

Under Art. 114 (1) EPC the Board requested a legal opinion as to whether according to English law indeed A is the successor in title of B and whether consequently A is entitled to validly claim priority. In the legal opinion from an English patent barrister it was found that in spite of the lacking signature of A, of the final assignee, the transfer back was valid according to English law. The Board concluded that the transfer was valid and that the priority was validly claimed.

The Boards of Appeal in this decision J 0019/87 thus did not apply the more severe standard of Art. 72 EPC but verified whether according to national, in this case English law there was a valid transfer.[14] This older decision therefore seems to be in contradiction with the above decision T 0062/05.

Decision J 0019/87 was followed by T 1008/96. In the latter case at the end the documents produced by patentee and opponent as concerns the valid transfer of the priority (Italian utility models as priority applications and subsequent European application were not filed by the same person) were however inconsistent. At the end therefore the Board came to the conclusion that the documents proving transfer of the priority right *according to Italian law* were not sufficiently convincing. Consequently the priority was not validly claimed and the patent revoked due to a public prior use of the patentee within the priority year.

European case law therefore seems somewhat contradictory. This even more so as the two earlier and established decisions J 0019/87 and T 1008/96 are not even mentioned in the more recent decision T 0062/05. It would therefore be desirable to have additional decision clarifying this aspect which from a practical point of view is highly important for applicants.

2. French case law, TGI Paris, 30.1.2009

In France recently another decision was issued which shows the peril of such situations: In this case the company Telecom PTT (today Swisscom AG) in the mid-90s acquired, from a group of academic inventors, an invention, and the inventors, as prescribed by US law, filed a US provisional application in their name in 1996. Subsequently an international application[15] was filed in the name of Telecom PTT claiming priority of this US provisional application. Prior to the filing of the sub-

12 T0062/05, R 3.16. This decision was followed in T 382/07, in which only after a transfer document has been produced, in which all rights were transferred and which carried a date prior to the filing date of the subsequent application and which carried the signature of all parties, the transfer of the priority right was accepted as valid.

13 Case Law of the Boards of Appeal (Fifth edition 2006), München 2006, 337-338. The decision J 0019/87 was even mentioned in the EQE part D-II of 2007 and was an element of the model solution thus expected to be known by the candidates.

14 Validity of the transfer of the priority right according to national law is also expressly the requirement imposed on such transfers in the Guidelines for Examination in the European Patent Office A-III 6.1

15 WO 98/10560, see www.espacenet.org

sequent application the inventors had signed a transfer document related to the US provisional application, in which the application and all rights deriving from this application for the United States, subsequent applications, continuations inclusive of continuation-in-parts were transferred. The inventors were informed about the filing of the international application claiming priority to their US provisional application and they had duly signed authorisations for the patent attorney. All these further documents however were signed after the filing date of the international application and in none of these documents there was an express statement that not only the US-application and US follow-ups but also the priority right derived therefrom was transferred. On the other hand apparently none of the inventors had anything against the filing of the international application. Consequently there seems to have been agreement by conclusive action, because in case of such academic inventors one may reasonably assume that they knew about the claim to priority, in particular as they themselves, within the priority year, published a scientific article disclosing the invention.

The international application entered the European regional phase, was granted in 2004, and subsequently was validated in France. All this without there ever being a question whether the priority was validly claimed, in spite of the fact that apparently the priority application was not filed in the name of the applicant of the international application.

The company Magic Technologies in 2005 then initiated a nullity action before the Tribunal de Grande Instance in Paris against the French part of this European patent. Among other reasons it was raised that the right to priority was not valid because the transfer of the priority right had not validly taken place before the filing of the international application.

In the final decision of the French court the patent was revoked because the assignment of the priority right was considered to be invalid and because consequentially the scientific publication of the academic inventors within the priority year was novelty destroying.[16]

Unfortunately the decision is far from being clear and was criticised repeatedly.[17] The question of which law has to be applied for the assessment of the validity of the assignment of the priority right is raised. The patentee produced a legal opinion of a renowned Swiss attorney at Law and expert in the field that according to Swiss law clearly there is a valid assignment of the priority right in view of the conclusive action of the parties. At the end however the court did not even deal with the question of applicable law but merely decided based on considerations about proof.

It is important to note first that according to French case law the priority right is not an accessory to a priority application. So if a priority application is transferred, the associated priority right is strictly only transferred if the transfer of the priority right is expressly mentioned.[18] Without indicating at the end which law has to be applied, the French court in this case judged that there was insufficient proof of transfer of the priority right. Interestingly without referencing to the above French case law but in specific distinction to the above discussed European decision T 0062/05, since it is expressly stated in the decision that this European case law was not relevant and that the written requirement and the signature of both parties were not necessary as long as, using any kind of proof, it was sufficiently clear and sure that the priority right was transferred.[19]

So the bottom line is the following: in spite of the fact that the transfer of the priority right was sufficiently proven according to Swiss law, the French court applied a more severe standard (the priority right needs to have been *expressly* transferred) and consequently it revoked the patent based on state-of-the-art published in the priority interval. Furthermore the French court has expressly applied a different standard than the one applied by the European patent office as given in T 0062/05 in spite of the fact that the French part of a European patent was at stake.

3. English case law, High Court of Justice, 12.6.2009

There is another recent case law, the English decision, Edwards Lifesciences AG v Cook Biotech Inc. of 12.6.2009[20], dealing with the question of a valid transfer of the priority right. A US priority application was filed in the name of an employee of Cook Biotech as well as in the name of two further inventors who were not employees of Cook Biotech. A subsequent PCT application claiming the priority of this US priority application was filed in the name of Cook Biotech, entered the European regional phase and was granted. The English part of this granted European patent was at issue here.

The only assignment document between the two further inventors and Cook Biotech which seems to have been in these English proceedings was a document which was dated after the filing date of the PCT application.

LJ Kitchin in this particular case first states that the rights of the employee inventor indeed belonged to Cook Biotech at the time of filing the PCT application.[21] Referring only to PCT (Art. 8 PCT) and its reference to the

16 TGI Paris, 3eme chambre 2eme section, Jugement du 30.1.2009, res iudicata

17 Jacques Raynard, Propriété industrielle no 9, Septembre 2009, comm. 49, as well as Jacques Raynard, Propriété industrielle no 12, Décembre 2009, comm. 92 et 93

18 TGI Valence, 16.2.1962; translated in German in GRUR Ausl. 1965, 627; see also Wieczorek 137, as well as O. Ruhl, Die Unionspriorität, Heymanns Verlag 2000, N 258ff.

19 TGI Paris, 30.1.2009 : "… la preuve de la cession de priorité n'est pas soumise à l'exigence de l'écrit signé par les parties au contrat, posée par l'art 72 CBE pour la cession de la demande de brevet européen, mais doit être rapportée par tout moyen suffisant à en établir l'existence de manière claire et certaine"

20 High Court of Justice, 12.6.2009, EWHC 1304 (Pat), Edwards Lifesciences AG v Cook Biotech Incorporated.

21 At least looking at the matter from the outside and not having the full file at hand this seems rather generous unless there was a specific assignment document in the file in which the employee inventor assigned the rights to his employer. According to US law, the inventor owns the invention and the associated patent rights, even though the invention was made during the course of employment. Although the inventor may have an obligation to assign (for example, because of an employment contract), the invention does not automatically belong to the employer.

Paris Convention (Art. 4 PC), in a side remark mentioning the European Patent Convention, and referring to national law (Patents Act 1977) he concludes that the transfer had taken place too late, as at the moment of filing the PCT application Cook Biotech was not the successor in title of all inventors of the priority application. LJ Kitchin expressly excludes the possibility of subsequent remedy in such a situation, so a transfer document signed after the filing of the subsequent application was declared insufficient. Also in this case at the end the patent was revoked, among others, because of documents which only were published in the priority interval.

It is not controversial to find that the assignment of the priority right has to take place before the filing of the subsequent application. What is interesting about this decision is that at no place a remark is made that for the validity of the transfer of the priority right another legal framework than the national one (Patents Act 1977) or the corresponding international law (in particular the EPC) could be applicable. In spite of the fact that the first application was a US application and the applicant was a US company the question was not even raised that the transfer could be subordinated to US-law. Consequentially the law of the country of protection (lex protectionis) is applied.

4. US-case law, CAFC Boston scientific Scimed, Inc. v. Medtronic Vascular, Inc.

Of course the US-view in such issues is completely different than the European view. While in Europe only the applicant of the priority application is compared with the applicant of the subsequent application, in the United States an inventor based view is taken.

According to 35 U.S.C. 119 the benefit of an earlier filing date is accorded to a subsequent US application if its applicant person has, or his legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country.

Here so to speak the reverse problem arises in practice, namely that normally foreign priority applications are filed in the name of companies (as successors in title of the inventors) while a subsequent US-application claiming priority of these foreign applications must be filed in the name of the inventors.

According to established US case law[22] this right of priority is personal to the United States applicant, in other words to the inventor(s), and due to the personal nature of this right the applicant for the U.S. patent may only benefit from the priority of a foreign application if it was filed by the US applicant or on his behalf. This is in contrast to European case law and practice, where a purely and strictly applicant oriented view is taken.[23]

In the above-mentioned recent US decision dealing with an interference case, two inventors had filed a US application which claimed priority of two earlier European applications which both had been filed in the name of a French company. At the time these European applications were filed no provable legal relationship existed between this company and the inventors, nor was there any proof that the company was acting on behalf of the inventors. The question arose whether it was necessary that *at the moment of filing the initial foreign priority application* this foreign application must have been filed on behalf of the applicant of the subsequent US-application.

The decision clearly confirms that the applicant for a United States patent can rely for priority only on a first filed application by an assignee on the inventor's behalf. Specifically it is confirmed to be impossible in a US application which is transferred subsequent to filing to an assignee, to claim priority from a foreign application filed by the same assignee unless the same inventors are involved in the first foreign application as in the subsequent US application. Furthermore the decision in addition to that states that a nexus must exist between the inventor and a foreign applicant *at the time the foreign application was filed*. Therefore a foreign application may only form the basis for priority if that application was filed by either the US applicant himself or by someone acting on his behalf at the time the foreign application was filed.

Therefore if a company files a priority application outside of the US not in the name of the inventors (which is usually the case for employer companies) it must establish that this priority application *at the time of its filing* was filed on behalf of the inventors which are the applicants of the subsequent US-application claiming priority thereof.

For the reverse situation to the one given at the very beginning of this article, so for a situation where the priority application is a non-US application and priority is to be claimed for a subsequent US application care has to be taken about the legal situation already at the moment of filing of the priority application!

III. General considerations as to the law applicable to assignments of priority rights

What is the legal situation in view of the above and what can you finally rely on? Concerning the law applicable to such assignments a few more general observations can be made. The Paris Convention does not comprise any indication as to the law applicable to assignments of industrial property rights and is therefore of no help. General international conflict of law principles from contractual law[24] such as e.g. the application of the law of the country where a contract is concluded (locus

22 Vogel v. Jones, 486 F.2d 1068 (CCPA 1973)

23 see in particular T 0005/05 and T 0788/05 and the critical discussion given by R. Teschemacher in Mitt. 12/2007, 536

24 See e.g. Art. 4 Rome convention on the law applicable to contractual obligations, or for Switzerland for general contracts see Swiss International Private Law (IPRG) Art. 117 defining the law with the closest connection with the contract as long as the parties have not chosen a law according to IPRG Art. 116.

regit actum), of the „country of origin" (lex originis) or more generally of the country with which the contract and its parties have the closest connection are, upon closer inspection, not straightforward:

In the country of the subsequent application (and not in the country where the priority application is filed) the right to the patent is a territorial right and a right in rem, so it should be governed by the law of the territory.[25] This just as any other substantive requirement like novelty, inventiveness, duration, scope of protection and infringement which are always assessed using the law of the country where protection is sought. Regulation of ownership of intellectual property is also substantive law and thus should be governed by the law of the country of protection (lex protectionis).

On the other hand it would be much more simple and reliable for the parties to an assignment of a priority right, if the law determined according conflict of law principles from contractual law was applied.

For example Switzerland has clearly opted for the latter solution: According to Art. 122 of the Swiss International Private Law, for the transfer of an intellectual property right – and thus also of a priority right – not just the law of Switzerland, so the lex protectionis, is applied, but generally the law of the normal residence of the assignor[26] Interestingly enough this also is not the general contractual choice of law, but a more special choice which is not necessarily identical to the law of the country with which the contract and the parties have the closest connection. So again we are facing a special choice of applicable law here, but this has the advantage of being pragmatic and clear, which is important for the following reasons: in case of patent applications it is often not straightforward to determine the law of the country with which the contract has the closest connection. If e.g. a Swiss applicant resident in Switzerland files a US provisional application in the US and transfers the priority right for the filing of a subsequent application in France, it would be possible to find that US law needs to be applied (closest connection of the contract given by the filing of the US provisional in the US, lex originis), or to find that Swiss law needs to be applied (closest connection of the contract given be the residence of the assignor, purely contractual choice), or to find that French law needs to be applied (closest connection of the contract given by the place of location of the right in rem, the application in France, lex protectionis).

Indeed it seems that in international patent matters the question of which law is to be applied to an assignment is answered differently in different countries. Quite unambiguously German case law and doctrine find that the law of the country of protection is applicable, so the assignment of a priority right is assessed using German law (lex protectionis)[27]. Also the above UK decision seems to apply UK law, so the law of the country of protection is applicable. In fact this seems to be inline with the Paris Convention, as it only puts the foreign applicant into the same position as the national applicant (national treatment principle, see Art. 2(1) PC). One may argue that if based on more „generous" foreign contractual law the requirements for assignment of the foreign applicant were more favourable, this would even contradict the Paris Convention.[28]

On the other hand Switzerland does not apply the lex protectionis principle and French doctrine speaks in favour of the determination of the applicable law by using contractual principles[29]. European case law on the other hand seems to be dangerously inconsistent.

It is interesting to have a glance at the corresponding discussion in the copyright field, where questions of ownership of specific rights of use and their handling on an international level are very important. Also here, the corresponding international treaty, the Revised Berne Convention, does not address the question of applicable law to assignments.[30] But the Berne Convention provides for a clear attachment of the origin of the protective right to a country: the right is generated by the act of first publication in the country of the first publication (Art. 5(4) RBC). Correspondingly in copyright this law of the country of origin (lex originis) is often applied to assignments of the protective rights. Transferred to the situation of patents this would then have to be the law of the country where the priority application is filed.

But also in the copyright field the situation is handled differently in different countries. E.g. in France in the famous Huston decision from the nineties the Cour de Cassation in principle applied the law of the country of origin (lex originis)[31], but the law of the country of origin was supplemented – by invoking *Ordre Public* – with aspects which according to French principles are mandatory. In contrast to this in Germany traditionally also in this field German law is applied, so the law of the country of protection (lex protectionis)[32].

So also in the copyright field different countries take different views, in spite of several attempts to harmonize this important question on an international level.

To summarize it seems that from a dogmatic point of view the application of the lex protectionis to the assignment of a priority right seems correct, but from a practical and more pragmatic point of view seems highly unsatisfactory. In case of application of the lex protectionis the inventor and the successor in title are expected to check at a very early stage, namely before the filing of

25 Vgl. Art. 4(3) Rome convention or the Swiss regulation for immovable property IPRG Art. 119.

26 IPRG Art. 122 Abs. 1: Contracts in relation with intellectual property rights are subject to the law in which the one transferring the right or allows the use of it has his normal residence.

27 Vgl. z. B. Wieczorek, 146, as well as Ruhl, Rn 260 an references therein, as well as Benkard IT 35. For Switzerland see IPRG Art. 110.

28 See PC Art. 2 (1) in fine, where it is expressly stated that foreign applicants have to fulfil the same formalities as the nationals.

29 Vgl. Fn 17.

30 RBC Art. 5 corresponds roughly to PVÜ Art. 2 as concerns the national treatment.

31 Cass. 28.5.1991 Huston v. TV5

32 See e.g. Lara's Tochter, 1999, GRUR 984, for a general overview over the situation in copyright see e.g. Mireille van Eechoud, Alternatives to the lex protectionis as the choice of law for initial ownership of copyright, Intellectual Property and Private International Law, IIC Studies Vol. 24, S. 289–307 (2005)

subsequent applications, which formal and substantive requirements have to be fulfilled in all the countries where finally protection shall be sought. In the author's view therefore it would be desirable not to apply the lex protections but to have an internationally harmonized contractual choice of law.

IV. Consequences for practice and some advices

The consequences of the above are quite simple: In the general spirit of the Paris Convention to simplify and enable international protection one would suppose and hope – to the benefit and safety of the inventor and the successor in title – that an assignment of a priority right is assessed using *one* law and hopefully a law as determined by general contractual principles so one which can be anticipated and controlled by the parties to the assignment. By contrast there is a danger that the single document for the assignment of a priority will be interpreted and assessed using a multitude of different laws, a different one in each country of subsequent application. Any deficiency of an assignment of a priority right found on a national level due to particularities of the corresponding national law can – and to make things worse, being overly formalistic and even seems to be against all reason – lead to an invalid priority claim even if the parties to the assignment always have, are and will be in perfect agreement about the assignment of the priority right.

As the above cases show, in particular the French case, this has serious consequences. Normally[33] problems associated with entitlement can only be invoked by the truly entitled party. Specifically only the true inventor or the successor in title may claim back an application filed by a non-entitled person or may ask it to be revoked for this reason (see Art. 138 EPC). As the EPO case and the French case show, this principle doesn't hold true for an assignment of a priority right: any third party, whether entitled or not, may use a deficiency found with an assignment of a priority right to have a priority claim declared invalid. As further according to the Paris Convention the assignment needs to have validly taken place before the subsequent applications are filed, a deficient assignment cannot be remedied after the filing of the subsequent applications for reasons of principle. Not even if there was perfect mutual agreement of the parties to the assignment at all times.

For practice this simply means that an assignment of a priority right should be made by taking into account all national requirements of all potential countries of subsequent filings – or at least it should be drafted by taking as many national particularities into account as possible.

The above case law seems to indicate that at least the following elements should be taken into account for an assignment of a priority right:

The assignment document must be *in writing*, must be *dated before the filing of the subsequent application(s)*, and it must be *signed by all parties to the assignment*.[34, 35] It should clearly state that not only the right to priority but also the right to the patent in the same (internal priority) and in all other countries (worldwide) is assigned. The priority application(s) must be specifically given by indicating the country of filing, the filing date and the filing number. If a priority application is assigned, it must expressly be stated that not only the priority application but also the priority right derived therefrom is transferred.[36] Further it seems advisable to indicate which law governs the assignment.[37, 38]

For the above case of a US application having been filed as a priority application and in the name of the inventors it may in practice, if it is not possible to prepare a proper assignment document in time, i. e. before the filing of a subsequent application, be safer to file the subsequent application in the name of the inventors of the priority application and assign the application later on. Of course this would definitely require observation of national requirements in the countries of protection.

However, in view of the above US case it seems worthwhile to again point out that care about assignment documents not only has to be taken before filing the subsequent applications but even before filing priority applications! If e.g. in quite a standard situation a priority application is filed in Europe in the name of a company, a subsequent application for the US will by law have to be filed in the name of the inventors.[39] As the above case shows it is then mandatory that one will be able to show that the priority application was filed by an assignee or by someone acting on the inventor's behalf.

33 Exception USA with patents, where non-entitlement can be invoked by any third party, see 35 U.S.C. 102 (f).

34 Note that in case a priority application is filed in the name of A+B and a subsequent application is filed in the name of A only, to be on the safe side an assignment document should be prepared which is signed by A+B and by A (A signs twice!). Also if a priority application is filed in the name of A and a subsequent application is filed in the name of A+B, if a very formalistic view is taken it might even be necessary to provide an assignment document with is signed by A as well as by A+B (party A signs twice!)

35 Care also has to be taken if employee inventors are involved in countries and/or with employment contracts under which inventions are not automatically assigned to the employer but where there is only an obligation to assign inventions. Under these circumstances there also must be a specific assignment document in place before the filing of the subsequent application takes place.

36 In turn if just the priority application is to be transferred but not the right to priority, it should be expressly indicated, as in some countries absent express statement the transfer of the priority application implies transfer of the priority right therefrom.

37 If the target country applies the lex protectionis severely this will maybe not help. As the above cases show, in many cases however the courts are not completely clear and certain about the applicable law, so one may hope that such a statement will convince the court to apply the chosen law if desired so by the parties to the contract.

38 The tips given here cannot exclude that in some country of subsequent filing there may be problems. If e.g. a country requires an assignment document to be legalized before the filing of the subsequent application or if a payment price has to be indicated etc. If therefore a subsequent country is of particular interest specific information on the requirements in this country should be looked for and taken into account.

39 In cases where inventions are made by employees and are by law the property of the employer (e.g. the case in Switzerland or UK if the invention is made in the course of the normal duties of the employee), the filing in the name of the inventors as prescribed by US law seems somewhat inconsistent as the invention is actually filed by someone who is not the owner of the invention anymore. Also the inventor has nothing to assign later on. In practice however this doesn't seem to be a problem in the US.

To be on the safe side and if the inventors include persons which e.g. are not employees of the company which files the priority application, assignment documents should be prepared before filing the priority application.

Regel 164 EPÜ und das Problem der Uneinheitlichkeit *a posteriori*

U. Storz[1] (DE)

In der Ausgabe 1/2009 der epi information hat Mr. Kennigton einige Probleme angesprochen, die die mit Inkrafttreten des EPÜ 2000 am 13. Dezember 2007 eingeführte Regel 164 EPÜ aufgeworfen hat („problems arising from Rule 164 EPC", epi information 1/2009, S. 6–10). Die Kernaussage von Mr. Kenningtons Beitrag war die, dass unter der neuen Regel 164 Euro-PCT-Anmeldungen, für welche das EPA nicht als Internationale Recherchenbehörde (ISR) fungiert hat, erheblichen Nachteilen unterworfen sind. Leider gehen die durch Regel 164 EPÜ aufgeworfenen Probleme weit über diesen Aspekt hinaus. Der folgende Beitrag widmet sich eben diesen weiteren Problemen.

1. *Bemühungen des EPA zur Reduzierung des Recherchenaufwandes*

Einige der jüngst in Kraft getretenen Änderungen des EPÜ bzw. der Ausführungsordnung sind insbesondere dem Ziel der Reduzierung des Recherchenaufwandes verpflichtet. Diese Änderungen können als eine Reaktion des EPA auf extrem breit gefasste Patentanmeldungen verstanden werden, die, so das EPA, in jüngster Zeit erheblich zugenommen haben, und die auf Seiten des EPA zu einem Arbeitsrückstand geführt haben (siehe z. B. Jahresbericht 2007 des EPA).

Eine dieser Änderungen ist die Erhöhung der Anspruchsgebühren, die am 1. April 2008 in Kraft trat. Durch die neue Gebührenstruktur wurde die Anzahl der einzureichenden Ansprüche *de facto* auf fünfzehn beschränkt, da in der Praxis die meisten Anmelder Wert darauf legen, das Anfallen von Anspruchsgebühren zu vermeiden.

Eine andere Änderung, die dem genannten Ziel verpflichtet ist, wird die neue Regel 141 EPÜ sein, die am 1. Januar 2011 in Kraft tritt und gemäß welcher der Anmelder verpflichtet sein wird, das EPA über Recherchenergebnisse aus parallelen Patentverfahren in anderen Rechtskreisen zu informieren.

Ebenso zu verstehen ist die neue Regel 62a EPÜ (das EPA kann den Anmelder bei mehreren unabhängigen Ansprüchen in einer Kategorie auffordern, einen der unabhängigen Ansprüche für die anschließende Recherche auszuwählen), sowie die geänderte Regel 63 (Aufforderung zu Angaben zu dem zu recherchierenden Gegenstand bei unklaren Anmeldeunterlagen).[2]

Weitere Änderungen sind in diesem Zusammenhang die geänderte Regel 70a (obligatorische Stellungnahme zum erweiterten Europäischen Recherchenbericht), die geänderte Regel 137 (4) EPÜ (Kennzeichnung von Änderungen) sowie die neue Regel 161 EPÜ (obligatorische Stellungnahme auf den ISA).[3]

Nach Erfahrung des Autors wird auch in Anmelderkreisen durchaus akzeptiert, dass einige Anmelder in der Vergangenheit den Bogen überspannt und vermehrt extrem breit gefasste Patentanmeldungen eingereicht haben, die das EPA vor erhebliche Probleme stellen. Daher wird auch ein Großteil der oben geschilderten Änderungen von den Anmeldern als vernünftig und zumutbar hingenommen, auch wenn sie in der Literatur nicht kritiklos akzeptiert werden[4]. Etwas anderes gilt jedoch, wie im Folgenden geschildert wird, für die neue Regel 164 EPÜ bzw. für die damit verbundene neue Recherchenpolitik des EPA.

2. *Feststellung der Uneinheitlichkeit a posteriori – neue Recherchenpolitik des EPA*

Nach Inkrafttreten der neuen Regel 164 EPÜ, die auf der alten Regel 112 (EPÜ 1973) basiert, aber erheblich abgeändert wurde, versendet das EPA in seiner Funktion als ISA vermehrt Aufforderungen nach Regel 40.1 PCT, in welcher Anmelder mit einer Frist von einem Monat zur Zahlung von weiteren Recherchengebühren aufgefordert werden.[5]

Hintergrund der Aufforderung gemäß Regel 40.1 PCT ist in den meisten Fällen die Feststellung der Uneinheitlichkeit *a posteriori*. Dabei verfährt das EPA so, dass in einem ersten Schritt der Hauptanspruch zunichte recherchiert wird. Wegen des Wegfalls des Hauptanspruchs sind die in den Unteransprüchen dargestellten bevorzugten Ausführungsformen nach Auffassung des EPA nicht mehr in der Weise verbunden, dass sie eine einzige allgemeine erfinderische Idee verwirklichen, so dass die Anmeldung in mehrere Untererfindungen zerfällt. Daraus leitet das EPA dann die Forderung zur Zahlung von weiteren Recherchengebühren ab.

Das EPA stellt dabei nach Auffinden der für den Hauptanspruch vermeintlich relevanten Entgegenhaltung die Recherche zunächst ein, ohne dem Anmelder irgendwelche Hinweise auf die Schutzfähigkeit der in den Unteransprüchen formulierten bevorzugten Ausführungsformen zu liefern.

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2 Änderungen anwendbar für europäische Patentanmeldungen, zu denen der europäische Recherchenbericht ab dem 1. April 2010 erstellt wird

3 Änderungen treten ab 1. April 2010 in Kraft

4 siehe z. B. Kley und Frischknecht, epi information 3/2009, S. 93

5 bei der Recherche von EP-Anmeldungen verfährt das EPA genauso, versendet in solchen Fällen jedoch eine Mitteilung nach Regel 64 EPÜ

Die gewährte einmonatige Frist ist zudem äußerst kurz bemessen. So müssen die betroffenen Anmelder zunächst den Sachverhalt klären und dann aus den angeblichen Untererfindungen diejenigen identifizieren, für die sich die Ausgabe einer zusätzlichen Recherchengebühr lohnt. Maßgeblich hierfür ist erstens, ob es aussichtsreich ist, die betreffenden Merkmale zur neuheitsstiftenden Abgrenzung des Hauptanspruchs heranzuziehen, und zweitens, ob die betreffenden Merkmale überhaupt in einem zu vermarktenden Produkt bzw. Verfahren vorkommen, letzteres von einem entsprechend abgegrenzten Ansprüche also überhaupt noch geschützt wird. Häufig sind diese Fragen in der gewährten Frist nicht zu beantworten, sodass Anmelder gezwungenermaßen nicht selten auf die Zahlung weiterer Recherchengebühren verzichten.

Die vom PCT-Vertrag immerhin eingeräumte Möglichkeit der Zahlung der zusätzlichen Recherchengebühren unter Widerspruch (Regeln 40.2 e) und 68.3 e) PCT, Regel 158 (3) EPÜ) wird in der Praxis nur selten wahrgenommen, da sie mit der Zahlung einer Widerspruchsgebühr von derzeit 750,- € verbunden ist, was angesichts bereits hoher zusätzlicher Recherchengebühren bei Anmeldern selten auf Gegenliebe stößt.

3. Die Auswirkungen der neuen Regel 164 EPÜ

Obwohl nach Erfahrung des Autors die oben geschilderte Praxis auch vor Inkrafttreten der neuen Regel 164 EPÜ vorkam, führte erst letzteres zu drastischen Konsequenzen, die dadurch bedingt sind, dass nach Regel 164 (2) EPÜ der Anmelder die Anmeldung im Prüfungsverfahren nunmehr auf die Erfindung abgrenzen muß, die im Recherchenbericht behandelt wurde. Wollte oder konnte der Anmelder also der Aufforderung nach Regel 40.1 PCT nicht fristgerecht nachkommen, und hält die Prüfungsabteilung – wovon in der Regel auszugehen ist – den Neuheitseinwand gegen den Hauptanspruch aufrecht, bleibt dem Anmelder nur die Einreichung von einer oder mehreren Teilanmeldungen, die allein Amtsgebühren von jeweils ca. 3.000,- € verursachen, und die überdies dem engen zeitlichen Rahmen der geänderten Regel 36 EPÜ unterworfen sind.

Hat hingegen der Anmelder eine oder mehrere zusätzliche Recherchengebühren gezahlt, und lässt die Prüfungsabteilung – was nicht sehr wahrscheinlich ist – den Neuheitseinwand gegen den Hauptanspruch fallen, fällt zwar der Uneinheitlichkeitsgrund *a posteriori* weg, allerdings hat der Anmelder keinerlei Anspruch auf Rückerstattung der bereits gezahlten zusätzlichen Recherchengebühren.

Durch die neue Praxis wird der eigentliche Sinn des Recherchenantrags – nämlich der, dem Anmelder eine zuverlässige Einschätzung der Schutzfähigkeit seiner Erfindung zu liefern, und ihm bei der Entscheidung zu helfen, ob nach Ablauf der 30-Monate Frist nationale Phasen eingeleitet werden sollen – ins Absurde geführt.

Im Extremfall hat der Anmelder eine Recherchengebühr in Höhe von 1.700,– € dafür gezahlt, dass ihm der EPA-Prüfer genau eine Entgegenhaltung vorlegt, die lediglich den Gegenstand des Hauptanspruchs vorwegnimmt. Damit ist natürlich der Informationsbedarf des Anmelders in keiner Weise gestillt. Weitere Informationen erhält er jedoch nur gegen Zahlung weiterer Recherchengebühren.

In Gesprächsrunden zu diesem Thema wurde in Anwesenheit des Autors die geschilderte Praxis der Kombination aus Feststellung der Uneinheitlichkeit *a posteriori* und neuer Regel 164 EPÜ vielfach beklagt.[6] Selbst in der Kanzlei des Autors sind Fälle aufgetreten, in denen Anmeldungen, die sich keineswegs durch eine außergewöhnlich breite Anspruchsfassung auszeichneten, eine Uneinheitlichkeit *a posteriori* bescheinigt und alsdann zwischen vier und sieben zusätzliche Recherchengebühren verlangt wurden – mithin also Beträge, die leicht die 10.000 €-Grenze übersteigen.

4. Verstoß gegen geltende Rechtsprechung der EPA Beschwerdekammern

Die neue Praxis der Feststellung der Uneinheitlichkeit *a posteriori* verstößt auch gegen geltende Rechtsprechung der EPA-Beschwerdekammern. So führt die Entscheidung T 708/00 aus, dass die Neuheitsschädlichkeit einer Entgegenhaltung für einen bestimmten beanspruchten Gegenstand kein hinreichender Grund sei, um *a posteriori* auf mangelnde Einheitlichkeit der beanspruchten Gegenstände zu schließen (2. Leitsatz), und dass eine Änderung, mit der der Gegenstand des Hauptanspruchs durch zusätzliche, in der ursprünglich eingereichten Anmeldung offenbarte Merkmale nachträglich beschränkt werden soll, generell nicht die Einheitlichkeit der Erfindung beeinträchtige, sondern eine normale Reaktion eines Anmelders auf einen Einwand gegen die Patentierbarkeit desselben, nicht beschränkten Gegenstands darstelle (3. Leitsatz). Mit Spannung ist zu erwarten, wie die große Beschwerdekammer diesen Sachverhalt bewertet, sollte ihr ein entsprechender Fall vorgelegt werden. Dies ist insbesondere deswegen interessant, weil sich die neue Praxis keineswegs automatisch aus der neuen Regel 164 EPÜ ergibt. Es kann daher nicht argumentiert werden, dass die Entscheidung T 708/00 wegen der neuen Regel 164 EPÜ nicht mehr anwendbar sei.

5. Abhilfe

Die oben geschilderten Probleme ergeben sich erst aus der Kombination der neuen Regel 164 EPÜ und der nunmehr etablierten Praxis der Feststellung der Uneinheitlichkeit *a posteriori*. Würde das EPA zu seiner ursprünglichen Recherchenpolitik zurückkehren – was es ohne weiteres könnte – käme Regel 164 EPÜ überwiegend nur noch für Fälle der Uneinheitlichkeit *a priori* zur Anwendung, Fälle also, bei welchen ein Anmelder willentlich mindestens zwei nebengeordnete Ansprüche einreicht, die untereinander nicht in der Weise verbunden sind, dass sie eine einzige allgemeine erfinderische Idee verwirklichen. Gegen eine solche Praxis würden die wenigsten Anmelder Einwände haben.

6 So wurde etwa polemisiert, dass sich das EPA „ein System zum beliebigen Eintreiben von zusätzlichen Recherchengebühren" geschaffen habe, und dass die neue Praxis des EPA „an Arbeitsverweigerung" grenze

Die neue Praxis zwingt Anmelder nunmehr jedoch dazu, ihre Anmeldestrategien grundlegend zu überdenken. Ein Weg, der oben genannten Problematik vorzubeugen, wird der sein, wieder vermehrt auf enger gefasste Anspruchssätze zurückzugreifen, die mit Hilfe einer Vorabrecherche so verfasst wurden, dass die unabhängigen Ansprüche bei der Amtsrecherche weniger leicht neuheitsschädlich getroffen werden und so die Feststellung der Uneinheitlichkeit *a posteriori* weniger wahrscheinlich ist. Insbesondere in den Bereichen der Chemie und der Life Sciences, wo anders als in anderen Technikbereichen zu einem Zeitpunkt angemeldet wird, zu welchem noch recht wenig über das konkrete Produkt bekannt ist, ist dieser Weg jedoch nicht zielführend. Es besteht immer die Gefahr, dass der unabhängige Anspruch von Anfang an zu eng gefasst wird, was extrem schmerzhaft sein kann, da eine nachträgliche Schutzbereichserweiterung durch Streichen eines Merkmals aus dem Hauptanspruch im Prüfungsverfahren regelmäßig als Verstoß gegen Art. 123 (2) EPÜ gewertet wird.

Die derzeitige Praxis des EPA wird jedoch mittelfristig dazu führen, dass Anmelder wenn immer möglich das EPA als Recherchenamt zu umgehen versuchen werden. Beispielsweise könnten Erstanmeldungen beim DPMA (wenn in deutscher Sprache) oder beim UKIPO (wenn in Englischer Sprache) eingereicht werden. Beide Ämter stellen innerhalb des Prioritätsjahrs Recherchen- oder Prüfberichte „alter Schule", d. h. ohne Feststellung einer Uneinheitlichkeit *a posteriori*, aus, die in der Regel sämtliche Ansprüche des Anspruchssatzes erfassen und bewerten. Ein solcher Recherchenbericht könnte als Basis für einen entsprechend eingeschränkten Anspruchssatz herhalten, der dann im Verfahren vor dem EPA im Rahmen einer PCT-Anmeldung verwendet werden könnte, um die Gefahr der Feststellung der Uneinheitlichkeit *a posteriori* zu umgehen.

Derzeit können beispielsweise deutsche Anmelder PCT-Anmeldungen lediglich beim DPMA, beim EPA oder beim IB einreichen, wobei in allen Fällen allein das EPA als ISA fungiert. Für Britische oder Französische Anmelder gilt im Übrigen vergleichbares. Was PCT-Anmeldungen betrifft, führt daher derzeit kein Weg am EPA vorbei.

Allerdings muß die Frage erlaubt sein, warum nicht auch das DPMA oder das UKIPO als ISA-Recherchenbehörden fungieren, was gemäß Art. 16(3)(c), R. 34, 36 PCT möglich sein könnte. Es ist nicht zu erwarten, dass diese Ämter die vom EPA etablierte Praxis der Feststellung der Uneinheitlichkeit *a posteriori* verbunden mit einer unvollständigen Recherche übernehmen würden. Gleichzeitig wäre eine solche Lösung sowohl für das DPMA als auch für das UKIPO aufgrund der Erlöse, die mit dieser neuen Aufgabe erzielt werden könnten, sehr attraktiv (derzeit verlangt das EPA 1.700,– € Gebühren für eine internationale Recherche, während das DPMA 350,– € Prüfungsgebühr und das UKIPO 130,– Anmelde- und Recherchengebühr verlangt). Zwar sprechen wohl vor allem politische Gründe gegen eine solche Lösung, es ist jedoch nicht auszuschließen, dass, sollte das EPA seine oben geschilderte Praxis beibehalten, Anmelder einen entsprechenden politischen Gegendruck aufbauen könnten, der eine solche Lösung in greifbare Nähe rücken würde. Natürlich hat das EPA es selbst in der Hand, solche Bestrebungen einzudämmen, indem es wieder zur alten Recherchenpolitik zurückkehrt.

Eine weitere Abhilfemöglichkeit könnte sich durch Regel 45bis.3 PCT auftun, gemäß welcher ein Anmelder eine ergänzende Internationale Recherche (SIS) bei einer Recherchenbehörde (SISA) seiner Wahl verlangen kann. Derzeit bieten das Russische, das Finnische, das Schwedische und das Nordische Patentamt einen solchen Service an. Letzteres berechnet für die Recherche derzeit beispielsweise 2.574,– CHF, hinzu kommt eine Servicegebühr von 200,– CHF. Die Kosten bewegen sich also in ähnlichen Größenordnungen wie beim EPA. Obwohl bislang wenige Erfahrungen mit dieser Option existieren, ist es nicht ausgeschlossen, dass die betreffenden Ämter – anders als das EPA – auch bei Fallen des Hauptanspruchs eine vollständige Recherche durchführen.

Zwar ist in Regel 164 EPÜ lediglich vom „Internationalen Recherchenbericht" und vom „ergänzenden Recherchenbericht" die Rede (wobei mit letzterem der ergänzende Europäische Recherchenbericht gemeint ist), allerdings müsste nach Auffassung des Autors auch der SIS dann, wenn er die gesamten Ansprüche erfasst, dem Kriterium der Regel 164 EPÜ genügen, sodass es möglich sein müsste, den Hauptanspruch im Prüfungsverfahren mit Merkmalen aus Unteransprüchen abzugrenzen, die zwar nicht durch den ISA, wohl aber durch die SIS erfasst sind. Leider existieren nach Kenntnis des Autors noch keine Erfahrungen mit dieser Option, aber es dürfte interessant sein, wie die Beschwerdekammern einen Fall entscheiden werden, in dem es der Prüfer einem Anmelder verwehrt hat, seinen Hauptanspruch mit Merkmalen aus einem Unteranspruch abzugrenzen, der zwar nicht im ISA, dafür aber im SIS behandelt worden ist.

Der Autor und seine Kollegen haben in Gesprächen mit Anmeldern weitere Strategien diskutiert, die zumindest theoretisch geeignet wären, dem oben geschilderten Problem beizukommen, die angesichts ihrer Brisanz aber in der Praxis wohl kaum auf Akzeptanz stoßen werden. So wurde der Vorschlag geäußert, eine Anmeldung einschließlich Anspruchssatz in konventioneller Art zu verfassen, und dabei Sorge zu tragen, dass die Gegenstände der Unteransprüche in der Beschreibung offenbart sind. Alsdann, so der Vorschlag, solle man sämtliche abhängigen Ansprüche aus dem Anspruchssatz streichen, und die Anmeldung mit nur einem unabhängigen Anspruch einreichen. Im Recherchenverfahren wäre dann die Feststellung der Uneinheitlichkeit durch das EPA unmöglich, selbst dann, wenn der unabhängige Anspruch neuheitsschädlich getroffen wäre. Die Vorschrift gemäß Regel 164 EPÜ wäre also nicht anwendbar, und der Anmelder könnte sich im Prüfungsverfahren aus dem kompletten Offenbarungsgehalt bedienen, um den unabhängigen Anspruch neuheitsstiftend abzugrenzen. Ein Einwand nach Regel 137 EPÜ („unrecherchiertes Material") sei dabei, insbesondere im

Hinblick auf die oben bereits diskutierte Entscheidung T708/00, voraussichtlich unberechtigt. Allerdings ginge dabei der Sinn des Recherchenberichts vollends verloren, da letzterer keinerlei Aussage über etwaige schutzwürdige Gegenstände aus dem Anspruchssatz mehr erlauben würde.

Dieser Ansatz, so weiter, mache jedoch insbesondere für eine PCT-Nachanmeldung Sinn, wenn die prioritätsbegründende Anmeldung nicht beim EPA, sondern beispielsweise beim DPMA oder beim UKIPO unter Verwendung des vollen Anspruchssatzes eingereicht und Prüfungs- oder Recherchenantrag gestellt wurde. In diesem Fall würde der betreffende Bericht voraussichtlich sämtliche Gegenstände des Anspruchssatzes erfassen, so dass der rudimentäre internationale Recherchenbericht verschmerzbar wäre.

6. Resumee

Die neue Regel 164 EPÜ, kombiniert mit der Feststellung der Uneinheitlichkeit *a posteriori*, ist als Versuch des EPA zu verstehen, der oft beklagten Praxis der zu breiten Patentanmeldungen entgegenzuwirken. Nach Meinung des Autors hat das EPA dabei jedoch den Bogen etwas überspannt.

Die nunmehr angewandte Praxis zwingt einen Anmelder dazu, den Hauptanspruch einer Anmeldung bereits zum Anmeldetag sehr stark einzuschränken, um so eine Feststellung der Uneinheitlichkeit *a posteriori* zu antizipieren. Da er den so festgezurrten Schutzbereich später nicht mehr erweitern kann, wird dieser Weg seinen Bedürfnissen nach größtmöglichem Schutz in keiner Weise gerecht.

Es ist jedoch selbstverständlich das Recht des Anmelders, dass sich ein Prüfer als Gegenleistung für die gezahlte Recherchengebühr eingehend mit der angemeldeten Erfindung auseinandersetzt und seine Arbeit nicht allein darauf beschränkt, neuheitsschädliches Material gegen den Anspruch 1 zu sammeln, um so anschließend weitere Recherchengebühren einzufordern.

Dabei bleibt abzuwarten, wie die Beschwerdekammern einen Fall entscheiden werden, in dem es der Prüfer einem Anmelder verwehrt hat, seinen Hauptanspruch mit Merkmalen aus einem Unteranspruch abzugrenzen, der zwar nicht im ISA, dafür aber im SIS behandelt worden ist. Ähnlich interessant dürfte die Frage sein, wie die große Beschwerdekammer einen Fall entscheiden wird, in welchem ein Anmelder gegen die Praxis der Feststellung der Uneinheitlichkeit *a posteriori* und die sich damit aus Regel 164 EPÜ ergebenden Konsequenzen vorgeht, insbesondere im Hinblick auf den Verstoß dieser Praxis gegen die Entscheidung T 708/00.

Sollte das EPA seine Recherchenpolitik beibehalten, werden Anmelder früher oder später nach Alternativen suchen, was letzten Endes das Recherchenvolumen des EPA reduzieren und so den beklagten Arbeitsrückstau beseitigen könnte – freilich auf eine Art, wie sie dem EPA nicht recht sein kann.

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3	BG	75	0,78
21	LT	31	0,32
4	CH	415	4,30
22	LU	18	0,19
5	CY	13	0,13
23	LV	21	0,22
6	CZ	109	1,13
24	MC	3	0,03
7	DE	3.252	33,70
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13	GB	1.880	19,48
31	RO	79	0,82
14	GR	27	0,28
32	SE	298	3,09
15	HR	27	0,28
33	SI	31	0,32
16	HU	102	1,06
34	SK	39	0,40
17	IE	59	0,61
35	SM	3	0,03
18	IS	22	0,23
36	TR	105	1,09
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