

REGISTRATION FORM

MUNICH - February 22, 2013
Isar Building of European Patent Office
Erhardtstrasse 27, 80469 Munich
Plenarsaal, room 102

UNION-IP ROUND TABLE

Amending patents

– a booby trap in the European procedure

→ **Yes**, register me for the Round Table:

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| Name | |
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| Date | Signature |

→ **Fee:** € 100 for **union-IP** members and
€ 150 for non-members.

The fee includes a buffet lunch and coffee breaks.

→ **Bank:** Bank transfer (free of charge for the recipient)
to UNION-IP | ABN AMRO Bank N.V.,
Veerplein 2-4, Postbus 62, NL-3130 AB Vlaardingen
Account No.: 50 69 25 803 | Bank Code: 200 303 00
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on or before: **February 19, 2013.**

Accommodation is not provided.
Please send the completed form to the
Secretariat of the Round Table c/o:

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WHAT IS "UNION-IP"

union-IP is an association of practitioners in the field of Intellectual Property, that is, of individuals whose principal professional occupation is concerned with Patents, Trade Marks or Designs and related subjects and who carry on their profession independently or as employees. **union-IP** is a private, free, international association that is not dependent on any national or international authority: it approves its own members, in accordance with its statutes, in total independence, and likewise decides on its own activities and its own budget.

It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improvement of professional and personal understanding between European practitioners in the Intellectual Property field in different countries and different branches of the profession.

WHAT IS A "UNION-IP ROUND TABLE"

A **union-IP** Round Table offers the opportunity for practitioners to hear from authoritative speakers on topics of interest in the European IP field, and just as importantly to interact with and influence them by feeding back their own practical experience. The integral Question and Answer sessions and friendly discursive nature of the event, with the opportunity to chat during breaks, lead to real exchange and development of views on both sides.

Participants tend to find these practitioner-lead events a real and useful antidote to the more commercial seminars familiar to all.

If you are not yet a member of **union-IP** and would like to join this friendly, active and interesting organization please go to our website where you can join online. Membership also entitles you to reduced prices for this, and other, **union-IP** events.

For more information:
<http://www.union-ip.com>



OF EUROPEAN PRACTITIONERS IN INTELLECTUAL PROPERTY
EUROPÄISCHER BERATER FÜR GEISTIGES EIGENTUM
DES PRATICIENS EUROPÉENS EN PROPRIÉTÉ INTELLECTUELLE

ROUND TABLE

Amending patents – a booby trap in the European procedure

Munich
February 22, 2013

European Patent Office
Isar Building, Erhardtstrasse 27

Organized by the Patents Commission of UNION-IP



Union

Round Table Program, February 22, 2013

Program Amending patents – a booby trap in the European procedure

09:00 Registration

09:30 Welcome word by UNION-IP

Nils T. F. SCHMID - Patent Attorney at Boehmert & Boehmert (DE), President-**union-IP**

09:40 Added subject matter and file wrapper estoppel

Chair:

Sabine ROJAHN - Taylor Wessing (DE), President-**union-IP** Litigation Commission

Is the European Patent System balanced in view of the disclosure requirements?

Heli PIHLAJAMAA - Director of Directorate Patent Law, European Patent Office

Dutch perspective on added subject matter and file wrapper estoppel

Senior Judge E.F. BRINKMAN - Senior Judge Dutch court of 1st instance in The Hague

Q&A

10:50 Coffee Break

11:10 Added subject matter and file wrapper estoppel

Chair:

Sabine ROJAHN - Taylor Wessing (DE), President-**union-IP** Litigation Commission

UK perspective on added subject matter and file wrapper estoppel

His Honour Judge BIRSS Q.C. - England and Wales Patent County Court

German perspective on added subject matter and file wrapper estoppel

Presiding Judge Peter MEIER-BECK - Presiding Judge at the German Federal Court of Justice

13:00 Lunch

14:00 Consequences for the practice

Chair:

Reinier WIJNSTRA - Patent Attorney at EP&C (NL), Vice President-**union-IP** Patent Commission

What is a quality EP Patent Application in view of Art. 123(2) EPC?

Ursula KINKELDEY - Former Chairwoman Technical Board of Appeal 3.3.04 of the European Patent Office and former member of the Enlarged Board of appeal

Practical experience in prosecution/enforcement of European patents

Francesco MACCHETTA - Director Intellectual Property Bracco Imaging SpA (Italy)

Do's and don'ts when drafting and prosecuting a patent application to avoid Art. 123(2) EPC

Cyra NARGOLWALLA - Patent Attorney, Cabinet Plasseraud (FR)

Q&A

16:00 Closing of the Round Table

by **Jochen KILCHERT** - Meissner Bolte (DE), President-**union-IP** Patent Commission

Maximum legal security for third parties and little room to manoeuvre for the IP owner – **added subject matter** is an objection IP owners strongly fear in proceedings before the EPO. Is the European Patent System still balanced when it comes to amendments?

On the other hand, arguments submitted in the proceedings to counter such an objection or any other objection that concerns the patentability of an invention often involve interpreting construction of the claims. How high is the risk that a statement filed during prosecution influences the outcome of a later multinational litigation proceedings?

File wrapper estoppel is a principle applied by Dutch courts which emanates from U.S. practice. In interpreting construction of the claims, what the cited prior art discloses and why the claims are inventive over that prior art etc., the Proprietor cannot take an opposing position when enforcing the patent in the court. In Germany whether or not to apply file wrapper estoppel remains an open issue after BGH Okklusionsvorrichtung. The UK practice is not to apply file wrapper estoppel as a rule, but the Court may expect to hear a convincing explanation from the Proprietor of the justification for changing his position at the enforcement stage.

Arguments or amendments not only in context with Art. 123(2) EPC but also in context with other patentability requirements that involve a construction of the claims therefore require careful consideration.

It is the aim of the **UNION Round Table 2013** to investigate how amendments before the EPO pose a risk to European Patents both in terms of validity and enforcement in different jurisprudences and what consequences can be derived for the practitioner.