



Europäisches
Patentamt
European
Patent Office
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des brevets

Guidelines2day and Article 84 EPC

Roadshow for professional representatives

Programme

European Patent Academy

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Foreword

In 2015 EPO lawyers from Directorate Patent Law and examiners from Directorate Patent Procedures Management visited 12 European cities to host the Guidelines2day and Article 123(2) EPC roadshow. Attended by over 900 professionals from private practice and industry, this roving seminar drew participants of all levels of experience, from newcomers to the profession to senior patent attorneys. The common denominator at all events was active attendee participation. And no matter where the roadshow went, the thing that participants wanted was always the same: a better – and more detailed – understanding of EPO procedures and how to improve efficiency in all situations.

Our experience and feedback from these events have strengthened our conviction that the EPO must be active in all member states, and that openness towards our main stakeholders is a vital part of our public service mission.

Buoyed by our success in 2015, we have now refocused our format in two respects. First, we will devote even more time than before to interaction, by inviting participants to discuss practical examples. In particular, in the afternoon session,

we will flip the classroom, i.e. invite participants to study a few cases of (potentially) unclear claims at home beforehand and express their opinion on them at the seminar. A possible solution will then be presented – if the participants themselves have not already identified it – and the relevant provisions in the Guidelines and the applicable case law will be outlined. Secondly, as participant feedback reveals that examples are the essence of this learning experience, we will spend more time discussing concrete cases. One thing that will remain the same, however, is the close and fruitful co-operation we enjoy with the European Patent Institute (epi). This means that senior European patent attorneys will be on hand alongside EPO experts to showcase practices and procedures from the user's perspective.

Will these changes be welcomed? We truly hope so, and trust our participants will share their impressions with us so that we can meet the needs of European patent attorneys and contribute fully to their continuous professional development.

Jean-Michel Zilliox
Director Programme
European Patent Academy

- 08.30 Registration
- 09.00 **Welcome address**
- 09.15 **Introduction to the new Guidelines for Examination**
- Outline of major changes in the Guidelines
 - Update on Article 123(2) EPC
 - Statistics on procedural actions
- 10.00 **How to communicate with the examining division**
- Phone calls and interviews
 - Oral proceedings as a videoconference
 - E-mail during a videoconference
 - Summonses to oral proceedings
- 10.45 Coffee break
- 11.15 **Stepping up the pace of prosecution**
- PCT direct
 - Early entry into the European Phase
 - Waivers
 - PACE
 - Patent Prosecution Highway (PPH)
 - Third-party observations
- 12.15 **Questions and answers**
- 12.30 Lunch break

- 13.45 Amendments – what, when, how?**
- Right to amend European patent applications and patents
 - Temporal and procedural restrictions of the right to amend
 - Other restrictions: basis for amendments and unsearched subject-matter
 - Correction of errors
 - Amended Rule 82 EPC
- 14.30 Clarity – introduction to the requirement under Article 84 EPC**
- Clarity and claim interpretation
 - Use of the description and Article 69 EPC
 - Discussion of example cases (handouts)
 - Functional features vs desiderata
 - Relative terms
- 15.30 Coffee break
- 16.00 Clarity – continued**
- Broad claims
 - Complex claims
 - Clarity in opposition – G 3/14
 - Interplay Article 84 EPC with Articles 83, 56 and 54 EPC
- 17.00 Questions and answers**
- 17.30 End of event

Roadshow speakers



Roland Böhler, DE, lawyer, Patent Law, EPO Munich. Studied law and business administration in Bayreuth and Birmingham, and holds a PhD in law. He lectured at the University of Erlangen and worked as an attorney-at-law for Hogan Lovells in Munich and Düsseldorf focusing on patent litigation and IP transactions. In 2012 he joined the EPO, where he works as a lawyer in Directorate Patent Law. He is co-author of the book “Concise International and European IP Law”.



Jochen Moser, DE, administrator, Patent Procedures Management, EPO Munich. Studied electrical engineering at the universities of Karlsruhe and Southampton and at the ESIEE Paris. Passed the EQE in 2006. Work experience as a software developer for telecommunications networks in Germany. In 2000 he started at the EPO, where he worked as an examiner in telecommunications before joining Directorate Practice and Procedure. He is currently in charge of co-ordinating procedural changes and associated work instructions for examiners.



Luigi Petrucci, IT, administrator, Patent Procedures Management, EPO The Hague. Studied aeronautical engineering at “La Sapienza” University in Rome and business administration at the Erasmus University in Rotterdam (master’s). Joined the EPO in 1999. Worked as an examiner in the area of big industrial machines and as a quality auditor. Since June 2013, he has been working in the Patent Procedures Management directorate, where he is entrusted mainly with the development of patent procedures and the co-ordination of the yearly review of the Guidelines. Passed the EQE in 2006.



Heli Pihlajamaa, FI, Director Patent Law, EPO Munich. Studied law at Helsinki University and at the Max Planck Institute in Munich. Work experience at the Finnish Patent Office and a patent attorney’s office in Helsinki. Joined the EPO in 1996 and became Director in 2011. She acts as a legal member in opposition cases and advises EPO higher management on policy issues and legal amendments. She has written books and articles on patent law in Finnish.



Carmen Salvador, ES, lawyer, Patent Law, EPO Munich. After studying Law at the University of Valencia, she worked for several years as a research fellow there and then at the Max Planck Institute for Intellectual Property, Competition and Tax Law in Munich. She received her PhD in 2001 and joined the EPO in the Patent Law directorate in 2002. She has also been a member of the EQE Examination Committee since 2007.



Marko Schauwecker, DE, lawyer, Patent Law, EPO Munich. Studied law in Berlin, Paris, Munich and Berkeley. Prior to joining the EPO in 2009, he worked as a research fellow at the Munich Max Planck Institute for Innovation and Competition, the University of California Berkeley School of Law and Stanford Law School. At the EPO Marko specialises in patent issues related to biotechnology.



Doris Thums, DE, lawyer, Patent Law, EPO Munich. Studied law in Freiburg and Munich. She received her PhD in patent law in 1993. Worked as a freelancer for the Max Planck Institute for Intellectual Property, Competition and Tax Law between 1993 and 1997. In 1991 she joined the German Patent and Trade Mark Office and worked there in the legal department and as a trade mark examiner. Joined the EPO and Directorate Patent Law in 1997, where she is head of section for opposition, substantive patent law and CII. She is a co-author of the Benkard EPC commentary.



Cyril Valfort, FR, administrator, Patent Procedures Management, EPO Munich. Studied mechatronics. Joined the EPO in 1999. Passed the CEIPI exam in Strasbourg in 2001 and the EQE in 2004. Worked as an examiner in the area of artificial ventilation and inhalers (medical technology). Since 2013, he has been working as an administrator in the Patent Procedures Management directorate, where he is entrusted with the development of patent procedures. He is a member of Working Group 2 (Global Dossier and patent information) within the framework of IP5.



Piotr Wierzejewski, BE/PL, administrator, Patent Procedures Management, EPO The Hague. Studied computer science. Worked as a university lecturer and IT/telecom consultant. Joined the EPO in 2003. Worked for nine years as an examiner in the area of computer-implemented inventions. Since 2012, he has been working as an administrator in the Patent Procedures Management directorate, where he is entrusted with the development and implementation of patent procedures and maintenance of the Guidelines for Examination. He also co-ordinates procedural aspects of international co-operation within the PCT legal framework as well as in the context of IP5.



epi Mathieu de Rooij, NL, European patent attorney, partner at ZBM Patents & Trademarks in Barcelona. Studied aerospace engineering at Delft University of Technology. Worked at the EPO from 2002 to 2008 as an examiner in the field of gas and steam turbines and wind energy in the Directorate Civil Engineering and Thermodynamics. CEIPI and epi tutor.



epi Andrew Hards, DE/UK, German, UK and European patent attorney. Studied chemistry and physics in Germany and Japan. He is a partner at Global IP Europe in Munich, which specialises in worldwide patent prosecution. He is an experienced lecturer for the EQE pre-examination online course and the European Patent Academy.



epi Didier Lecomte, BE, European patent attorney, European and Benelux trade mark attorney and authorised representative at the LU and BE patent offices. He has a master's in mechanical and electrical engineering from the University of Liège and also specialised in applied thermodynamics for one year at the University of Aachen. He worked for seven years as a patent examiner at the EPO in Munich. He then joined a private practice in 2005 before eventually founding his own firm in 2007. He has recently obtained a diploma in patent litigation in Europe from CEIPI.



epi Cees Mulder, NL, European patent attorney. In 2001, he was one of the founding partners of DeltaPatents. Since 2009, he has been Associate Professor of Intellectual Property Law at the Faculty of Law of Maastricht University. He is the author of the book “The Cross-Referenced Patent Cooperation Treaty” (published annually) and co-author of the book “Proceedings before the European Patent Office - A Practical Guide to Success in Opposition and Appeal” (2015). He holds a PhD in physics (1982) and in law (2011).



epi Leythem Wall, GB, chartered UK and European patent attorney. Studied chemistry at the University of Oxford, holds a certificate in IP law from the University of London and a diploma in patent litigation from the University of Strasbourg. He works in the London office of the international law firm Finnegan, and before this was an in-house IP law attorney for ExxonMobil in Brussels. He is a Chartered Scientist and a frequent lecturer on intellectual property at the Royal Society of Chemistry.

Venues 2016

Berlin, 5 April

Oslo, 7 April

Lyon, 9 May

Barcelona, 23 May

Frankfurt, 4 July

London, 12 September

Turin, 17 October

The Hague, 10 November

Vienna, 6 December

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