Contents and experts

Workshops
Knowledge cafés
Workshop WS01

Auxiliary requests from the division's perspective

Field: procedural  
Technical area: suitable for all technical areas

In examination, opposition and limitation proceedings, parties may submit a main request followed by one or more auxiliary requests.

How do EPO examiners approach auxiliary requests? What are the differences, if any, between auxiliary requests handled in the written procedure and in oral proceedings? Do examination proceedings and opposition proceedings offer different perspectives in relation to auxiliary requests?

This workshop will shed light on how the first instance of the EPO handles auxiliary requests in relation to the above questions. The workshop will also offer the opportunity to discuss the perspective of applicants and their representatives regarding auxiliary requests, with possible strategic changes in view of the Rules of the Board of Appeal, in force from 1 January 2020.

In addition, based on a simple mechanical example, mock-up oral proceedings will provide volunteers among the participants with the opportunity to form an examining division in front of the presenters playing the role of professional representatives with various auxiliary requests at hand. This role inversion will highlight peculiar aspects of handling auxiliary requests during oral proceedings.

Frédéric Cavallo, FR, examiner, sector Mobility and Mechatronics, EPO The Hague. Studied engineering at the Engineering School of La Rochelle and intellectual property law (LLM) at the University of Edinburgh. Worked as an embedded software engineer, control engineer and project manager, mainly in the automotive industry, for 10 years. Joined the EPO in 2009 and worked as an examiner in the field of control systems for hybrid vehicles before switching to vehicle suspension arrangements. Passed the EQE and obtained the Diploma on Patent litigation in Europe from CEIPI in 2018.

Alexandre Bitton, FR, examiner, sector Mobility and Mechatronics, EPO The Hague. Studied material science at Ecole Européenne d'ingénieurs en Génie des Matériaux, Nancy, and at Luleå Tekniska Universitet. Worked at Saab Automobile AB (Trollhättan, Sweden) as a test engineer. Joined the EPO in 2001 as an examiner in the field of locks and keys. Currently working in the field of Furniture and Show Stands. Has been involved in coaching newcomers. Member of the Opposition directorate. Passed the EQE in 2008 and obtained the Diploma on Patent litigation in Europe from CEIPI in 2018.
Workshop WS02

Is it (really) too late?

Field: procedural  
Technical area: suitable for all technical areas

Parties' timeliness when filing submissions may play a significant role in how opposition proceedings develop, and dramatically affect their outcome. The consequences of late filing are far-reaching as subsequent appeal proceedings may also be impacted.

This workshop illustrates the different types of submissions and the admissibility requirements that apply to them. With the aid of practical examples, how the opposition division exercises its discretion to admit late-filed submissions is analysed. Relevant case law is also discussed.

Roberto Menchaca, ES, examiner, Team Chemistry 2 and C07C/F Compounds, EPO The Hague. Studied chemistry at Universidad Complutense de Madrid. PhD in organic chemistry from the same university. Worked for five years in R&D for two pharmaceutical companies. Joined the EPO in 2005. Passed the EQE in 2010. CEIPI tutor for the EQE since 2011. Experience as a chairman in opposition proceedings.

Workshop WS03

Preparing a Rule 71(3) communication – behind the scenes

Field: procedural
Technical area: suitable for all technical areas

The Rule 71(3) communication (intention to grant) might appear simple enough, but preparing it involves all members of an examining division, each entrusted with a specific task.

This workshop will guide you through all the various steps, from when the first examiner considers the application ready for grant to when the intention to grant is approved by all members of the division and is ready to be sent to the applicant.

Along the way, you will be shown some hands-on examples to give an insight into the entire process.

Martijn Lantsheer, NL, examiner, Mobility and Mechatronics, EPO The Hague. Studied aerospace engineering at Delft University of Technology and is a qualified European patent attorney. Joined the EPO in 2012 as an examiner and is involved in search, examination and opposition.

Franz Friedrich, DE, examiner, Team Surgery, EPO The Hague. Holds a master's degree in mechanical engineering from the Technical University Munich and graduated as an "ingénieur généraliste" from the École Centrale de Lyon. Worked in the development of surgical instruments in Switzerland prior to joining the EPO in 2012. Involved in search, examination and opposition. Passed the EQE in 2017 and obtained a diploma in Patent Litigation in Europe from the Université de Strasbourg in 2019.
Workshop WS04

Efficient application drafting in the light of Rule 42(1)(c) EPC

Field: procedural  
Technical area: suitable for all technical areas

Rule 42(1)(c) EPC represents not only a legal requirement for the content and the configuration of the description, but also the provision of the EPC which is closest to an operative definition of the concept of “invention”. In examination practice before the EPO, it has been noticed that applicants tend to focus on the requirements of novelty and inventive step while often neglecting the provision of Rule 42(1)(c) EPC. This approach leaves the applicants without the necessary support for their fallback positions and bring many applications to an unexpected refusal.

This workshop aims at presenting to the applicants a strategic manner for writing patent applications, specifically in view of the subsequent substantive examination under the law and practice of EPO.

By providing in the description a solid chain of logical step based on the features, their technical effects and the corresponding purposes in the setting of the invention, the applicant will, not only comply with the requirements of Rule 42(1)(c) EPC, but also prepare a framework in which the skilled person (and hence the substantive examiner) will operate to judge matters such as technical contribution and inventive step of the disclosure.

The workshop will present interactive examples taken from different technological fields.

Christoph Weiss-Schaber, DE, examiner, Team Medical Diagnosis 2, EPO The Hague. Studied physics in Munich, Nijmegen and Grenoble. Obtained a PhD in bio-physics and life sciences at Grenoble, and a LLM in IP law & management in Strasbourg. Joined the EPO in 2013 and works in the field of medical diagnosis and medical devices. Passed EQE in 2019. Internal instructor at the EPO.

Luca Signorini, IT, examiner, Team Chassis and Steering, EPO The Hague. Studied physics at Bologna University. Obtained a PhD in solid-state physics, with specialisation in nanomaterial, from the same university. Marie-Curie Fellowship in 2004 at University Paris VI. Worked as a European patent, trademark and design attorney for eight years in an Italian IP firm. Joined the EPO in 2013 and works in the fields of steering, automatic parking and autonomous vehicles. Instructor for the European Patent Academy (courses on introduction to IP rights), experienced first member in opposition and member of the taskforce of the European Inventor Award.
Knowledge café WS05

Inside the mind of the opposition division

Field: procedural  
Technical area: suitable for all technical areas

Are you curious as to what goes on behind the scenes in opposition proceedings at the EPO? Have you ever wondered what examiners talk about during breaks in oral proceedings? Would you like to know more about how examiners work together in the opposition division and what the roles of the different members are? Wonder no more, because you can experience it in this knowledge café.

The main topic of discussion will be how divisions react to and decide on submissions from the parties, and why. We will provide real life scenarios for you to work on and discuss together, as if you were in the shoes of the division. As experienced opposition chairpersons and instructors, we will share our work, insights and lessons learned with you.

Our focus will be on situations often encountered in opposition proceedings. Anyone who is curious about what goes on inside the mind of the opposition division is welcome to join.

**Emmeline Marttin**, NL, examiner, sector Healthcare, Biotechnology and Chemistry, EPO The Hague. Has a PhD in bio-pharmaceutical sciences from Leiden University (Netherlands) and worked at Jansen Pharmaceutica in Belgium before joining the EPO in 1999. At the EPO she currently works as a patent examiner in detergents and previously in the fields of galenics and diagnostics. She is an experienced opposition chairperson in the fields of detergents, cosmetics, food, pharmacy and biomaterials.

**Eberhard Strack**, DE, examiner, Pharmacy, EPO The Hague. Before joining the EPO in 2002, he obtained a PhD in Pharmacology from Goethe University, Frankfurt and worked internationally as a project manager in the pharmaceutical industry. Drafter and instructor for examiner courses, in particular for chairpersons in opposition proceedings. Opposition chairman since 2008. Passed the EQE and tutored professional representatives (“Praktika Intern”).
Knowledge café WS06

How to overcome clarity issues efficiently

Field: procedural
Technical area: suitable for all technical areas

When trying to get a European patent sometimes clarity objections seem to be the main reason for substantial restrictions of the scope of protection. In particular, frustration can arise when those restrictions enable a competitor to easily bypass the patent, e.g. by slightly changing the amended feature, calculation or parameter.

In order to deal efficiently with clarity issues it is important to understand how EPO examiners see clarity and where the main focus of their clarity analysis lies. This workshop aims to give the examiner's perspective on clarity issues, in order to help you to solve them in a way that makes for an efficient examination procedure:

- What is the intent of Article 84 EPC?
- How does an EPO examiner identify and treat clarity issues?
- What are the best solutions for the most common clarity objections raised by examiners?
- How do you overcome those objections with minimal restriction of the scope of protection?
- What other types of objection have to be distinguished from clarity objections?

Using practical examples, several possible scenarios will be discussed interactively to give an insight into how and why an examiner raises clarity objections. We will address how applicants might respond to overcome clarity objections with minimal effort and minimal restriction of the scope of protection.

Kris Loveniers, BE, team manager, Team Medical Diagnosis, EPO The Hague. Studied electromechanical engineering at the University of Leuven. Postgraduate degree in biomedical engineering. Worked as a research engineer at KUL and Materialise NV. Joined the EPO in 2003. Deals with patents for medical devices. Involved in developing the new classification system (CPC) for therapeutic devices. Member of the EPO Guidelines working group on computer-implemented inventions. Gives in-house training courses and teaches at the European Patent Academy. Master's degree in political science from the University of Leiden.

Ricardo Oltra García, ES, team manager, Team Agricultural Machinery, EPO The Hague. Studied mechanical engineering at the Polytechnic University of Madrid and physics at the UNED (National Distance Education University), also in Madrid. Worked as an engineer for Robert Bosch and John Deere in Spain. Joined the EPO in 2002. Deals with patents for agricultural machinery. Involved in coaching and assessing new patent examiners since 2005. First member in opposition cases since 2006. Involved in developing the new classification system (CPC) for his technical area. As part of the Continuous Knowledge Transfer team, gives in-house training courses to fellow examiners.
Knowledge café WS07

Multiple auxiliary requests in opposition proceedings

Field: procedural
Technical area: suitable for all technical areas

The changes to the Rules of Procedure of the Boards of Appeal of the EPO which enter into force on 01.01.2020 make the admissibility of amendments dealt with in opposition dependant to a significant extent on their admission into the proceedings before the opposition division. Anecdotal evidence suggests that this has increased the incidence of cases where large numbers of auxiliary requests are filed in first instance opposition proceedings.

This knowledge café is intended to explore the situation together with you. Does our observation match the observations of the parties to oppositions and attorneys? What is your experience so far?

We would also like to explore how divisions and parties to oppositions can work together to minimise the risks at second instance for all parties involved (patentees, opponents and the opposition divisions) in the first instance opposition procedure. We will focus on the admissibility of auxiliary requests in first instance opposition proceedings before the EPO.

Peter Watchorn, UK, senior expert, Healthcare, Biotechnology and Chemistry, EPO The Hague. Graduated with a BSc Honours degree in biochemistry and molecular biology from the School of Biological Sciences of Manchester University. Joined the EPO in 1989 and has worked as an examiner in the field of pharmaceutical chemistry for 30 years, specialising in steroid chemistry. Passed the EQE in 1997. From 2003 until 2012 he worked part time for the EPO department Practice and Procedure, drafting public Guidelines and Internal Instructions for examiners, as well as participating in the project preparing the EPO for the coming into force of major amendments to the EPC in 2007. From 2012 to 2014, he worked part time for the EPO legal department, International PCT Affairs. From 2015 he was promoted to senior expert.

Sjoerd Hoekstra, Director, Operations, Health, Biotechnology and Chemistry, EPO The Hague. Educated as plant molecular biologist. Joined the EPO in 1990. Became an all-round examiner with tasks ranging from classification and documentation via substantive examination to opposition work. Since 2003 leading a directorate responsible for the patent grant procedure from search to grant in the fields of pure chemistry, second medical use of small organic molecules, in vivo diagnostics, conjugated and targeted medicines, galenics and chemical aspects of biomaterials. Lecturing for the EPO's internal Examiners Academy and on the occasion of biotech patenting conferences throughout Europe. Chair of the Examination Matters Organising Committee.

Giuseppe Colucci, European patent attorney
Workshop WS08

Product-by-process claims in additive manufacturing: pitfalls and remedies

Field: substantive chemistry
Technical area: materials processing

Additive Manufacturing (AM), also known as 3D printing, is a disruptive technology enabling the production of articles with various complex shapes and from a wide range of different materials, like plastic, metals, ceramics and biomaterials.

The applications of products made by additive manufacturing range from prosthetic implants to aerospace components and in the last five years the amount of patent applications filed in this field literally “exploded”, challenging patent prosecution on many aspects among which clarity and product-by-process claims.

But what is exactly additive manufacturing? And what is 3D printing?

This workshop focusses on showing how Article 84, 54 and 56 EPC are applied in the examination of product-by-process claims involving additive manufacturing by:

- raising awareness about the field related terminology and how to avoid clarity objections due to excessively broad claims
- pointing out how novelty of products made by additive manufacturing is assessed
- suggesting a list of pointers towards non obviousness

Real cases and relevant case law will be used to support the discussion and put the principles presented into practice.

Valentina Morra, IT, examiner, sector Health, Biotechnology and Chemistry, EPO The Hague. Studied Chemistry at the University of Turin and completed a PhD in materials engineering at the Technical University of Delft. Working experience as a researcher and project leader in the aluminium and aerospace industry. Joined the EPO in 2005, where she works in the field of metallurgy, in particular additive manufacturing of metal objects. Chairperson in examination and opposition proceedings, passed the EQE in 2016. In 2018 she obtained the CEIPI Diploma on Patent Litigation in Europe at the University of Strasbourg.

Nathalie Pierre, FR, examiner, sector Mobility and Mechatronics, EPO The Hague. Graduated in plastic processing from École des Mines de Douai in France. After a PhD in plastic processing at Lyon’s Claude Bernard University for plastics firm Plastic Omnium, she studied intellectual property at CEIPI, Strasbourg. She joined the EPO in 2001 and works as a patent examiner in search, examination and opposition. She has been involved in several reclassification projects in the field of additive manufacturing (B29C67, B33Y and B29C64).
Workshop WS09

Post-filing of experimental data and the burden of proof

Field: substantive chemistry  
Technical area: industrial chemistry

The post-filing of experimental data, at the request of the EPO or on applicant's own initiative, is a useful tool for shifting the burden of proof in examination/opposition proceedings.

In the first part, the burden of proof will be defined. Then, various situations are considered which may arise after objections under Articles 83, 54 or 56 EPC have been raised, as for example:

- unusual parameters
- measurement methods of parameters
- product-by process claims
- closing the gap with common general knowledge
- enabling disclosures and implicit features

In the second part, the post-filing of experimental data will be analysed at the various stages of the problem-solution approach used in inventive step argumentation, to show where it can be beneficial for the parties.

Interactive examples follow which develop scenarios, with and without additional data, to underline the requirements for successful comparative tests.

Karin Marchand, FR, examiner, Team Catalysis, EPO Munich. Holds engineering degrees from ESPCI Paris and the IFP School (ENSPM), with refining and chemical engineering as her major. Holds a master's in kinetics and catalysis and a PhD in inorganic chemistry. Worked as a research engineer and project leader in the refining industry in France for ten years, designing new industrial catalysts and processes. Joined the EPO in 2010, obtained a CEIPI diploma (patents) in 2017 and passed the EQE in 2018.

Eveline Lançon, FR/DE, examiner, sector Healthcare, Biotechnology and Chemistry, EPO Munich. Member of the Opposition Directorate. Graduated in chemistry from Ludwig Maximilian University and the Technical University Munich and has a "mastère spécialisé" in business strategy and industrial marketing from EMLyon Business School. Joining the EPO in 2005, she is experienced in opposition procedures and is also an expert in Asian documentation matters and a member of the Asia Patent Expert Group. She has passed the EQE.
Workshop WS10

Biomaterials: How is a medical use affecting examination?

Field: substantive chemistry
Technical area: medical technology

The field of biomaterials is rapidly growing (+800% in 10 years) and covers materials going from soft polymers (hydrogel, silicone) used for artificial organs and tissues to stiff materials with high mechanical strength (metal, ceramic, hard polymer) for orthopaedic implants, dental implants, stents etc.

Applicants face challenges because they often draft either manufacturing claims which contain methods of treatment steps (Article 53(c) EPC) or claims relating to medical devices defined by a use in methods of treatment on the human or animal body (Article 53(c) and 54(4),(5) EPC).

This workshop aims at:

• giving tips and suggestions on how to reformulate a claim containing method-of-treatment steps
• answering to which extent certain medical products could fall under the definition of a substance or composition in order to fulfil the criteria of novelty under Article 54(4), (5) EPC, i.e. to which extent are the claimed medical products limited by their medical use.

The presenters will review recent case law to highlight how a difference between substance/composition or medical device can be made. The examples will be restricted to medical devices such as stents, scaffolds for tissue engineering (for instance 3D printed scaffolds), and implants.

Heidi Van den Bulcke, BE, examiner, Healthcare, Biotechnology and Chemistry, team Biomaterials, EPO The Hague. Studied “Life, science and technology” at the Universities of Leiden and Delft, followed by biomolecular sciences at the University of Utrecht. Joined the EPO in 2007, and working since then in the field of biomaterials, which focusses on the biocompatibility or therapeutic effect of medical devices, implants and bandages. Also involved in examination and opposition proceedings in the field of galenics.

Marjorie Chopinaud, FR, patent examiner, Healthcare, Biotechnology and Chemistry, EPO Munich. Graduated in mechanical engineering in France, Germany, the USA and Switzerland. Joined the EPO in 2002 and works as a patent examiner in the field of medical technology. In addition to her work as an examiner, she has been teaching and giving presentations on intellectual property protection and the EPO patent granting process at companies, national patent offices and universities. She is also actively involved in the European Inventor Award.
Workshop WS11

Sufficiency of disclosure and enablement in pharmaceuticals

Field: substantive chemistry
Technical area: life sciences and chemistry

This workshop will explore issues surrounding sufficiency of disclosure in the field of pharmaceuticals and chemistry.

A number of case studies will be used as the starting point for discussing the plausibility requirement and in particular whether and under which conditions an objection of insufficiency of disclosure can be overcome by submitting post-published evidence.

Considerations concerning the use of clinical trials as prior art, including when such clinical trials are considered to be enabled as well as the concept of an additional technical teaching will also be discussed.

Sally Collins, GB, examiner, team Small peptides and Second Medical Use, HBC, EPO The Hague. Studied chemistry with medicinal chemistry at Imperial College, London. Obtained a PhD in Organic Chemistry from the Technical University of Munich (TUM). Joined the EPO as examiner in pharmaceuticals in 2006, experience as first member in opposition procedures. Passed the EQE in 2013, member of the EQE committee for paper C.

Miren Langer, DE, examiner, team Targeted drugs and Chemistry, HBC, EPO The Hague. Studied Pharmacy at the University of Marburg, University of Paris and University of Santiago de Compostela. Obtained a PhD in pharmacology from the University of Munich (LMU). Prior to joining the EPO, she worked 3 years as a project manager (medical department) in the pharmaceutical industry. Since 2006 examiner at the EPO in the field of 2nd medical use and targeted drugs, experience as chairman and first member in opposition procedures. Passed the EQE in 2012.
Workshop WS12

Borderline cases in cosmetics

Field: substantive chemistry  
Technical area: suitable for all technical areas

Claims directed to cosmetic uses and those directed to the therapeutic uses in the field of cosmetics often overlap or are difficult to separate.

How are these cases tackled in the field of cosmetics?

Can we clearly distinguish between the therapeutic and cosmetic applications for sunscreens, toothpastes, anti-ageing and anti-microbial compositions?

The workshop will focus on the grey zone between the therapeutic/non-therapeutic applications by using practical examples which will provide an insight on how the EPO assesses the compliance with Article 53 (c) EPC in the field of cosmetics.

Ilknur Durand-Oral, TR/FR, examiner, Team Cosmetics C (HBC), EPO Munich. Studied food engineering in Middle East Technical University, Ankara. Master degree in Organic Chemistry at Université de Haute Alsace, Mulhouse. Worked in an Anti-Infective Research Company in Basel before joining the EPO in 2008. Completed Praktika Extern in Industry in 2018, wherein one of the main discussion topics was the borderline cases in cosmetics for medical use indications. Instructor for the EPO internal Talent Academy.

InmaEstañol, ES, examiner, sector Health, Biotechnology and Chemistry, and Opposition Directorate, EPO Munich. Pharmacologist, Master in food engineering and PhD in pharmacy/microbiology. CEIPI. Worked in R&D and as Director of Quality and Marketing in the food industry before joining the EPO in 1991. Active in working groups and as CKT lecturer for harmonising the practice in borderline cases on second medical use in cosmetics, medical devices and food. Coach for examiners of national patent offices, national judges, patent attorneys in Praktika Intern and newcomers at the EPO. IP expert representing the EPO in symposia and events related to the patentability of medical indications, post-granting procedures, the protection of traditional knowledge and the worldwide harmonisation of the patent prosecution practices.
Workshop WS13

Defining materials using parameters or manufacturing methods

Field: substantive chemistry  
Technical area: materials science, chemistry, physics

It is becoming increasingly more frequent, that a new material can be defined only using parameters, usual or unusual, and/or its method of manufacture. This type of definition leads to specific issues with respect to clearly and sufficiently determining the scope of protection. This workshop aims to discuss the most common issues and give a better indication on what is required for such claims to meet the requirements of Article 84 EPC and the consequences that a lack of clarity can have on the assessment of novelty and inventive step.

We will explore relevant case law decisions with interactive examples and thereby give guidance on how to effectively deal with Article 83 and 84 objections.

Raquel Gomes Pinto Fernandes, PT, examiner, EPO The Hague. Studied chemistry at the New University of Lisbon (FCT/UNL) and holds a PhD in physical chemistry. Postdoctoral researcher in nanochemistry and materials at University of Ghent and in the Karlsruhe Institute of Technology. Joined the EPO in November 2013 and has since then carried out search and examination of patent applications, in the field of batteries and fuel cells and powder metallurgy. Passed the EQE in 2018. In July 2019 she started working in opposition procedures.

Inga S. Helgadóttir, IS, examiner, EPO The Hague. Studied chemistry at the Jacobs University Bremen followed by Materials Science at the Technical University Munich, the Ludwig Maximilian University Munich and the University of Augsburg. Obtained a PhD in nanotechnology from the Université Claude Bernard Lyon I. Joined the EPO as a patent examiner in November 2013 in the field of powder metallurgy. Passed the EQE in 2018.
Knowledge café WS14

Applications in cloud computing and related technologies

Field: substantive CII
Technical area: suitable for all technical areas

This workshop will show how to deal with cloud computing technologies in the context of European patent applications.

It will consider:

- current search and examination practice for applications related to cloud computing
- issues related to technical vs non-technical features in claims, with examples
- common pitfalls in drafting cloud computing applications

Infringement aspects of applications related to cloud computing technologies will also be discussed, in the light of relevant national case law.

Nicholas Papanikolaou, GR/EN, examiner, Data Retrieval, EPO The Hague.
Studied computer systems engineering at the University of Warwick, followed by postgraduate studies in computer science, leading to a PhD from the same institution. Before joining the EPO, worked for several years as a research scientist in academia and at the Cloud and Security Lab at HP (Hewlett-Packard Enterprise). Currently a coach for new examiners and chairman in examination of patent applications. Contributes to the EPO Guidelines working group on computer-implemented inventions.

Till Andlauer, European patent attorney
Workshop WS15

Computer-implemented inventions in healthcare

Field: substantive CII
Technical area: medical technology

Since 2009, the number of patent applications in medical technology at the EPO increased by over 38%. As in most other fields, computer-implemented inventions are gaining more and more importance. Especially, advancements in artificial intelligence algorithms allow automation of tasks that had to be performed by an expert before.

At the EPO the inventive step of computer-implemented inventions is assessed based on the so-called COMVIK approach for which a technical purpose has to be identified.

In this workshop the current EPO practice of assessing inventive step of computer-implemented inventions is demonstrated. Examples for technical purposes in the field of medical technology are discussed. Through an interactive example that develops during the course of the workshop it is illustrated how a patentable claim can be formulated and how known pitfalls can be avoided.

The participants’ specific questions and examples will be discussed and shared.

Georg Wimmer, AT, examiner, Team Bioinformatics/Healthcare Informatics, EPO Munich. Studied at the Universities of Vienna and San Francisco, graduated with a PhD in molecular biology. Additional education in informatics, and work as computer programmer. Joined the EPO in 2000 as examiner in the field of molecular biology, since 2014 in the field of bioinformatics. Conducted numerous missions to industry and law firms to inform about EPO examination approach for computer-implemented inventions, and member of the internal (“CII 2nd line support”) group for harmonising the approach to examination of computer-implemented inventions among examiners.

Bernhard Reinbold, DE, examiner, Team Healthcare Informatics, EPO Munich. Studied mathematics at the Technical University of Munich and graduated with a PhD in computer science. Worked two years in IT management consulting and joined the EPO in 2017. Conducted several missions to industry to inform applicants about EPO examination approach for computer-implemented inventions and inventions involving artificial intelligence with a focus on medical technology.
Patent protection for data?

Field: substantive CII
Technical area: suitable for all technical areas

In emerging technologies such as additive manufacturing and artificial intelligence, innovations may often take the form of digital data, for instance 3D printing data representing a new and inventive product, or an improved training dataset for a machine learning task. But is it at all possible to protect data by patents?

We will first review the established case law on claims directed to computer programs, databases and data structures, as clarified in the Guidelines 2019. From there, we will explore and discuss various ingenious attempts which have been recently made to get patent protection for different kinds of datasets, either directly or indirectly via Article 64(2) EPC, in fields as diverse as artificial intelligence, industrial processes, video coding and medical diagnosis.

A current practical challenge will be considered: Will we be able to find together a promising claim formulation for 3D printing data corresponding to a new and inventive physical product? Your creativity will be required!


Workshop WS17

The patentability of artificial intelligence at the EPO

Field: substantive CII  
Technical area: suitable for all technical areas

As applications depending on artificial intelligence (AI) and algorithmic steps increase in range and number, the need to provide the applicant with clear guidance on the patentability of such inventions becomes more and more relevant. The EPO has developed a comprehensive framework to tackle the substantive examination of inventions relying on algorithmic processes.

This practice is reflected in the Guidelines for Examination (in force since 1 November 2018) that include a new section dedicated to the treatment of inventions employing artificial intelligence.

This workshop will be of practical benefit to IP practitioners and will present an overview of the EPO’s established practice in relation to the examination of AI inventions.

Workshop WS18

Lines of argumentation for technicality objections

Field: substantive CII
Technical area: suitable for all technical areas, information and communications technology (ICT)

The workshop is aimed at providing practitioners with practical guidance on how to argue when faced with technicality objections from examiners under Article 52 or 56 EPC.

Participants are expected to be familiar with the problem-solution approach and basic principles of examination practice in the area of computer-implemented inventions, and should become more confident in identifying promising lines of argument.

After a brief summary of the two-hurdle approach and the typology of technicality objections, the workshop will focus on identifying possible "repair" strategies for the applicant. We will first discuss the argumentation fallacies identified in recent years by the boards of appeal and relating to often used but mostly unsuccessful lines of argument brought forward by the applicants.

Second, guidance will be provided on how to avoid engaging in such unpromising boilerplate lines of argument by discussing arguments and features that might possibly overcome technicality objections, thereby also stressing the importance of a well-drafted original application offering fallback positions.

This workshop combines an interactive presentation with questions and practical work on examples prepared by the presenter. Examples will be mainly from ICT, but simplified to suit a wider audience.

Susanne Alt, DE, examiner, Team Applied Mathematics and Natural Language Processing, EPO Berlin. Studied computational linguistics in France and Germany, graduating with a PhD in information technology. Worked in both public and private R&D before joining the EPO in 2007. Passed the EQE in 2018. Works in the field of language processing and user interfaces, chairs oral proceedings, is part of the artificial intelligence core team and teaches at the European Patent Academy.

Peter Bittner, European patent attorney
Workshop WS19

Re-establishment of rights (Article 122 EPC)

Field: substantive other  
Technical area: suitable for all technical areas

Re-establishment of rights proceedings at the EPO are a remedy of last resort to rectify a missed deadline. Failure to successfully re-establish a patent right results in the loss not only of the patent application but often also of an opportunity for financial gain. Therefore, every patent practitioner needs to know how best to navigate this remedy, which has been shaped by more than 400 decisions of the boards of appeal of the EPO.

The aim of this workshop is to provide an overview of EPO practice to help participants both identify the key issues and parameters that need to be taken into account when considering this legal remedy and assess the chance of success. Although the EPO has sought to clarify the most relevant aspects in the Guidelines for Examination, a number of crucial issues require particular attention, such as the criteria governing the admissibility of the request, the standard of proof and the definition of due care. The most relevant case law and recent trends will also be highlighted.

Finally, some practical guidance will be provided on how to best organise a patent law firm or patent department to minimise the risk of missing a deadline and thus maximise the probability that a request for re-establishment, where necessary, will be successful.


Rainer Viktor, DE, European patent attorney, German patent attorney, Munich. Studied electrical engineering and information technology in Munich. Partner at the IP law firm Vossius & Partner in Munich. Extensive experience in EPO examination and opposition (appeal) proceedings in the fields of electronic devices, medical devices and healthcare products. Frequently advises and lectures on re-establishment of rights proceedings and is author of a patent practitioner manual on the topic.
Non-unity: requirements and remedies

Field: substantive other
Technical area: suitable for all technical areas

Non-unity has often been considered to be a grey area in patent prosecution. In particular, non-unity objections seem hard to predict for applicants, thereby giving rise to the widespread belief that getting a non-unity objection is just “bad luck”. Even though the EPC and the PCT make it clear that a statement on lack of unity can be objected to at the examination stage and in PCT Chapter II, the perceived arbitrary nature of non-unity reasoning renders a tentative rebuttal of the objection less attractive. As a consequence, the examiner’s reasoning behind the non-unity objection is rarely challenged by the applicant.

This workshop is designed to give patent professionals an overview of the legal basis for non-unity, and offers insight into why and how an examiner drafts a non-unity objection (illustrated by a real-life case). It provides guidance on how to draft amendments so as to preclude an objection under Article 82 EPC or Rule 68 PCT when the EPO is acting as IPEA, and how to react to an examination report raising a new objection of lack of unity.

Jérôme Bonnet, FR/CH, examiner, Team Messaging, Topology and Access, EPO Munich. Studied communication systems at the Swiss Federal Institute of Technology in Lausanne. Prior to joining the EPO, worked for two years at DoCoMo Euro-Labs on innovative receiver designs for mobile communication within the framework of the EU FP6 WINNER project. Joined the EPO in 2006 as an examiner in the field of data switching networks. Is responsible for CPC classification in H04L12, has coached several examiner assistants and provides training to external stakeholders, e.g. national patent offices. Presenter at various events, e.g. Search Matters and Examination Matters.

Koen Vanhalst, European patent attorney
Workshop WS21

Hindsight and other dangers when assessing inventive step

Field: substantive other
Technical area: suitable for all technical areas

It is a fact that a patent can only be evaluated with forehand knowledge of the invention.

It is another fact that any individual knowing what happened after an event cannot forget this knowledge when making a judgment. This is known as hindsight bias.

Does hindsight consequently make it impossible to judge whether an invention would have been obvious to somebody who has not been told how it works?

Tremendous efforts have been developed in the patent world in order to prevent the denial of an inventive step based on an ex-post facto analysis. At the EPO, this is assured by applying the problem-solution approach.

This workshop will first confront the participants with an example taken from outside the patent world. It will then explain how an examiner is told to minimise the risk that his decision is influenced by hindsight. It will also cover what may put in danger a line of argument, e.g. the selection of the closest prior art. Mixed-type inventions will also be briefly discussed.

Participants will learn through live interactions how to improve their “story telling” to convincingly argue on inventive step, and, how better to challenge arguments from examining divisions and opponents alike that appear to rely on hindsight.
