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SUBJECT: Convergence of Practice

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

With the adoption of the Strategic Plan 2023, it was decided to launch discussions on a convergence of administrative practice. The document provides a draft concept of possible topics, their prioritisation and the possible working method.

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I. STRATEGIC/OPERATIONAL

1. Operational

II. RECOMMENDATION

2. The Committee on Patent Law is requested to give its opinion on the proposed possible concept of the convergence of practice below.

III. MAJORITY NEEDED

3. Simple

IV. CONTEXT

4. With the adoption of the Strategic Plan 2023, it was decided to launch discussions on a convergence of administrative practice (Convergence of Practice). In the Strategic Plan 2023, several possible topics, as well as a first general working method were presented. In order to launch the Convergence of Practice it is required to finalise and prioritise the topics, and to agree on a working method.

V. ARGUMENTS

A. INTRODUCTION

5. In Europe, applicants seeking patent protection are confronted with diverging practices before national patent offices and the EPO, which complicate the existing European patent system.

6. The cooperation project on Convergence of Practices aims at reducing or possibly overcoming these differences by setting best practices in identified areas where it could be expected that a more uniform approach would provide the most beneficial results for users and patent offices. This is of particular importance for SMEs as differences in practice are generally qualified as a critical obstacle for them in operating internationally.

7. The Convergence of Practice could particularly result in the following benefits:

- The cost savings made from the Convergence of Practice could be used by applicants for additional R&D and patent protection, possibly leading to higher maintenance rates and thus more income for patent offices;

- Aligned practices could facilitate patent protection by SME's extending their market activity from national to European level;

- Better use could be made of earlier searches, enhancing work sharing between the Office and the national offices;

- More aligned workflows in the relevant patent procedures could have a positive impact on the harmonisation of IT tools;

- Convergence would facilitate knowledge cooperation and training for the staff of the national offices;

- The EPO and the Contracting States could speak with one voice in future discussions on practice harmonisation at international level.

8. The topics for the Convergence of Practice are to be set on a consensual basis by the national patent offices and the EPO. Best practices will be inspired either by the practice of national offices or that of the EPO.

B. PROPOSED TOPICS

9. During the consultation phase on the EPO Strategic Plan 2023, both the national offices of the Contracting States and users proposed topics to be assessed for the Convergence of Practice. Based on this input and considering the work done *i.a.* at the level of the IP5, the Office has already presented a number of possible topics for the Convergence of Practice at the last annual cooperation meeting held in Kilkenny (13 and 14 May 2019). These proposals were generally well received and a number of delegations proposed additional topics to be considered.

10. Based on all the input received so far the Convergence of Practice could start with the following topics:

- Examination of unity of invention
- Designation of the inventor,
- Accordance of priority date,
- Re-establishment of rights,
- Claim drafting and structure,
- Examination practice for computer-implemented inventions and artificial intelligence.

11. An overview of the various topics together with a first preliminary analysis regarding the issues which would need to be addressed collectively can be found in the Annexes of this document.

12. However, should the Contracting States wish to put forward any other topics which they consider might be beneficial, they are encouraged to do so at their earliest convenience.

C. WORKING METHOD

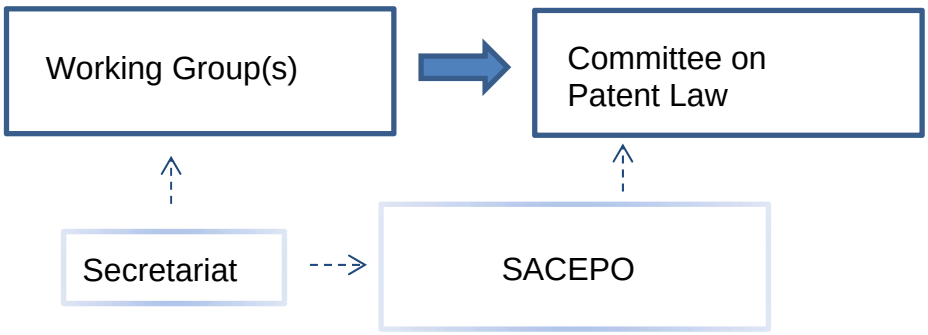
13. In order to make the process manageable, it is proposed to gradually roll out the topics under discussion in pairs. It is suggested to start the discussions with two topics for which the establishment of best practice could swiftly bring about positive results for the European patent system. It is proposed to start with "examination of unity of invention" and "designation of the inventor".

14. Subsequently, the following topic pairs could be rolled out:

- "Accordance of a priority date" and "Re-establishment of rights",
- "Claim drafting and structure" and "Examination practice for computer-implemented inventions and artificial intelligence".

15. The proposed working method follows the general principles for co-operation management as indicated in the EPO Strategic Plan 2023.

16. It is proposed for dedicated Working Groups to examine the existing practices in the various offices, analyse the disparities, determine and agree on best practices with regard to these areas. However, the implementation of any given agreed common practice by the Contracting States and the EPO will take place on a voluntary basis. These Working Groups should regularly report to the Committee on Patent Law and, as part of the reporting on the implementation progress of the EPO Strategic Plan 2023, to the Administrative Council.



17. All Contracting States would be invited to participate in any Working Group they wish, either as an active or a passive member. Active members should commit to actively contribute to the work while passive members may take the role of an observer, although they might occasionally be invited to provide informal information as to their own practices. The Working Groups should be composed of representatives of Contracting States aiming to implement the common practice agreed within the project.

18. As concerns the composition of the Working Groups, a careful balance should be struck between the need for adequate geographic and other representation and the operational efficiency required to secure results. To enable good progress, the same individuals should normally participate throughout the project as members of a Working Group, avoiding substitutions as far as possible.

19. The Working Groups should be chaired by a representative of a Contracting State, while the EPO should provide the secretariat.

20. A Contracting State may decide to join a particular Working Group at any time. Contracting States which are not part of a Working Group should be kept involved and informed via the Committee on Patent Law.

21. Users should be consulted throughout the process via the SACEPO Working Party on Rules (SACEPO WP/R), with a first discussion to this effect having already taken place on 18 September 2019. In parallel and as the project moves forward, the national offices participating in a given project could also consult with their national user associations.

VI. ALTERNATIVES

22. N/A

VII. FINANCIAL IMPLICATIONS

23. None

VIII. LEGAL BASIS

24. Article 10(2) EPC

IX. DOCUMENTS CITED

25. CA/65/19

X. RECOMMENDATION FOR PUBLICATION

26. Yes.

ANNEX 1 UNITY OF INVENTION

1. The requirement of unity of invention for patent applications finds support in the Paris Convention (Art. 4.F) and is prescribed in nearly all jurisdictions.

2. The EPC and the national laws of many Contracting States are aligned to the requirement of unity embedded within the PCT.

3. Accordingly, a patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (Rule 13.1 PCT). This is fulfilled where there is a technical relationship between those inventions involving one or more of the same or corresponding special technical features (Rule 13.2 PCT).

4. The expression "special technical features" refers to those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (Rule 13.2 PCT).

5. The determination of whether a group of inventions is so linked as to form a single general inventive concept is made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim (Rule 13.3 PCT).

6. Based on Rule 13.4 PCT, dependent claims are in principle considered unitary among themselves, as the common independent claim represents the single general inventive concept.

7. Even if the EPO and most Contracting States share this legal framework, differences exist as to its practical application. For instance, the reasoning of non-unity is presented in a different manner or the interpretation of what is to be construed as "same" and "corresponding" special technical features varies. Further, the phases of prosecution in which the non-unity objection is raised might deviate. Non-unity objections can be raised "a priori" or "a posteriori".

8. Unity of invention has been one of the topics on which the IP5 Patent Harmonisation Expert Panel (PHEP) has worked since 2012. This exercise was finalised in November 2018 and results were presented at the 50th meeting of the Committee on Patent Law on 19 February 2019. Consequently, all IP5 examiners are to follow the same, consistent, step-by-step methodology when assessing non-unity of international applications.

ANNEX 2 DESIGNATION OF INVENTOR

1. Inventors have the right, vis-à-vis the applicant or patent owner, to be mentioned as such before the patent offices. This right, which is anchored in Article 4*ter* Paris Convention, is of fundamental importance as it characterises the expression of the inventor's so-called moral right. Another key issue is the publication of the designation of inventor and concerns the protection of the inventor's personal data. At present, these two important aspects of the protection of the inventors' rights are subject to certain differences in practice.

2. Under the EPC and the legislation of the member states, inventors' moral rights are safeguarded by the applicant's obligation to designate the inventor when filing an application. Under the PCT, the request for an international application contains the name of and any prescribed data concerning the inventor (including the inventor's address), where at least one of the national laws of the designated states requires that these indications be furnished at the time of filing a national application.

3. Some national laws go a step further by obliging the applicant to indicate the origin of the right to the patent when they are not the sole inventor. Submitting evidence in support to this information may also be required by law.

4. A few jurisdictions only notify the inventor of the data contained in the document designating the inventor. This measure aims to provide inventors with the information about their designation at an early stage to facilitate the initiation of corrective action when necessary. Inventors can nowadays usually easily access all necessary procedural information on patent applications via the national/European registers and file inspection accessible online.

5. The control over the personal information available in the Internet and the possible use of it by third parties has become a growing concern over the years. In this regard, inventors may have a legitimate interest in being mentioned as such in the application and ensuing patent, but not with the full set of their personal data, in particular the unlimited access to their address. The General Data Protection Regulation (EU) 2016/679 ("GDPR"), applicable since 25 May 2018 in 28 of the EPC member states, might be of relevance.

6. The form and the conditions for publishing inventor data vary from one regime to the other. For example, Offices may not display personal address data in the bibliographic data of applications with the consequence that such data are not indexed or displayed by internet search engines. Others may display all data related to inventors via their online registers. Usually, the full inventor's address can however be viewed in image format either on the front page of the published applications or patents; in any event this information can be retrieved from other documents available through online file inspection, such as the designation of inventors. In some jurisdictions, the designation of inventors may be excluded from file inspection. This however presupposes the existence of a mechanism offering inventors the possibility to waive their right to be mentioned. Inventors may benefit from even more flexibility in some member states by being able to waive their right to have their address being published only.

ANNEX 3 ACCORDANCE OF A PRIORITY DATE

1. The basic formal and substantive requirements for the accordance of a priority right are laid down in Article 4 of the Paris Convention. This provision is binding on both the EPO and the member states but has resulted in different interpretations or practices. These concern different aspects of the principles governing the priority right.

2. A first area concerns the internal priority. The Paris Convention is merely concerned with priorities from foreign applications. It therefore does not cover the priority claimed from earlier applications filed with the same office ("internal priority"). Some jurisdictions thus see no legal obstacles for claiming an internal priority, which means that both applications may proceed in parallel, subject to the sole limitation of the prohibition of double patenting (where it exists). Some national laws however, do not provide for such a possibility.

3. A further domain where divergences exist concerns the definition of the requirement of "same invention". This criteria which is embedded in Article 4C(4) of the Paris Convention, is assessed differently by the national jurisdictions have different approaches. In some jurisdictions, the term "same subject" or "same invention" is interpreted narrowly, while in other this requirement is interpreted in a broader manner.

4. As defined in Article 4A(1) of the Paris Convention, the right to claim priority belongs to the applicant or his successor in title only. Compliance with the requirement of "same applicant or successor in title" is nevertheless assessed differently.

5. The requirement of the identity of applicant or successor in title between the earlier and subsequent filing is examined *ex officio* in some member states, while in others it is not. Where examined, differences of practice exist e.g. in cases where the earlier application was filed by joint applicants. In some jurisdictions all the previous applicants or their successors in title must be amongst the joint applicants for the subsequent patent application, while in others this is not required.

6. The criteria used in the examination of whether the right of priority has been validly transferred also vary from jurisdiction to jurisdiction. Differences exist with regard to matters such as the law applicable to the assignment and the date by which it must have been completed. As an example, some Contracting States allow retroactive assignments.

7. Finally, differences exist with regard to the remedies available for the loss of the priority right. This applies in particular to the possibility to request restoration or re-establishment of the priority right in case of delayed filing of the subsequent application. In some of the Contracting States, this extraordinary legal remedy is available, while in others it is not.

ANNEX 4 CLAIM DRAFTING AND STRUCTURE

1. All national laws as well as the EPC contain legal provisions governing the structure and the drafting of the claims. These legal requirements are in particular aimed at ensuring that the essential features needed to define the invention as well as their meaning are clear and serve the overriding purpose of legal certainty. The way these requirements are implemented and interpreted may differ in practice.

2. As a matter of principle, claims must be clear and concise (Article 6 PCT). Compliance with these basic requirements is essential to ensure a harmonised and consistent interpretation of the scope of protection defined by the claims. The use of relative terms is generally accepted but the way these are interpreted is subject to variations.

3. In the same vein, it is a common requirement that claims are to be drafted in terms of the technical features of the invention. These features are normally expressed in a positive manner. Negative features may also be added to exclude certain embodiments or areas. The allowability of such features in general and, more specifically, the conditions these may be subject to, differ in practice.

4. Concerning the structure of the claims there are also different approaches. The two-part form is required (i.e. preamble and characterising portion) in some jurisdictions for independent claims, but it is only voluntary in most of them.

5. The category of claim has a significant impact on the drafting. Nearly all national legislations define different categories of claims. These categories mainly refer to physical entities (apparatus, product) and activities (processes, uses). Furthermore, a distinction is made between independent and dependent claims, and practice qualifies additional sub-categories of claims, such as product-by-process claims or functional claims. There is however no uniform approach in Europe as regards the categories of claims and other related matters, such as the extent to which mixed types of claims (for instance, claims including both features relating to physical activities and features relating to physical entities) are admissible.

6. The categories of claims may also be linked to the limitation of the number of claims. In some jurisdictions the number of independent claims is limited to one independent claim in each category. The exceptions to that rule, such as in case of the plurality of interrelated products, are often defined differently.

7. Another aspect where variations exist relates to the impact of claims fees on application drafting and the measures taken by patent offices to deal with this situation. To avoid the payment of claim fees, some users strive to compress the whole content of the claims into the claims for which no fees are payable or in the description. This results in long and complex applications, and, consequently, has an impact on the efficiency of the search or the examination.

ANNEX 5 EXAMINATION PRACTICE FOR COMPUTER-IMPLEMENTED INVENTIONS AND ARTIFICIAL INTELLIGENCE

1. Patent offices are increasingly confronted with applications including computer-implemented inventions (CII). These inventions involve the use of computers, computer networks or other programmable apparatuses and may presently concern all fields of technology. Apart from the examination of the patentability requirements, the assessment of whether the claimed subject-matter has technical character has a particular relevance. This holds particularly true in the case of Artificial Intelligence (AI), where the inventions involve algorithms, i.e. mathematical methods, mental acts and computer programs.

2. The divergences between the EPO and the Contracting States in this field are due, in the first place, to differences in the legal framework. Mathematical methods, mental acts and computer programs are not considered "inventions" in some jurisdictions, because they are considered to lack technical character, and are thus excluded from patent protection if they are claimed "as such". In such cases, patents may only be granted for such non-technical subject-matter if it is "computer-implemented", i.e. implemented in a technical way. Other Contracting States do not however foresee such limitations, so that patents may be granted for non-technical matter claimed as such. In another States, in turn, the aforementioned limitation as to what is claimed "as such" is not set in the law, but has been introduced by the practice of the courts.

3. Even where the legal framework is harmonised, the practice of the Contracting States may diverge. In those jurisdictions where there is no substantive examination there is a tendency to interpret exclusions broadly in order not to rely on the assessment of inventive step. And different approaches exist as to the determination of the technical character of the claimed subject-matter.

4. A convergence of laws and practice would increase legal certainty regarding patent protection in this field, which is again the focus of attention due to the discussions regarding patent protection of AI.

5. AI is a particular type of CII involving machines which exhibit "intelligent behaviour". The main enabler of such behaviour is machine learning, i.e. algorithms allowing computers to self-improve at solving computational tasks.

6. Presently, there are no special rules on the patentability of inventions related to AI. They however raise questions with regard to inventorship and ownership, assessment of inventiveness and sufficiency disclosure.

7. In most national laws, the idea of inventorship is limited to human beings. However, in certain member states an inventor can also be a legal person or inventorship is not restricted to human beings. Furthermore, there are differences among the Contracting States on how the rights to the invention can be transferred.

8. The inventive step criterion requires that the claimed invention solves a problem in a manner that would not be obvious to a person skilled in the art. The use of AI could have an impact on the determination of the person skilled in the art and may in particular leads to the extension of the knowledge that ideal person is considered to have. This could eventually raise the question of whether a machine can be recognised as the skilled person.

9. As regards the disclosure of the invention, the law requires that it is enabling. In some jurisdictions, this implies that the obligation to describe the invention not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. However, in case of AI it is often difficult to describe the function, i.e. how the AI algorithm works. The approaches taken to this issue of "black box" patenting vary. In some cases, only the requirement of sufficiency of disclosure is applied, whereas in other cases it is the clarity requirement which is coming into play.

ANNEX 6 RE-ESTABLISHMENT OF RIGHTS

1. Re-establishment of rights is a legal remedy known in many jurisdictions worldwide. It is available for curing loss of rights resulting from the failure to meet specific deadlines during patent grant proceedings. Both the EPC and the PCT contain legal provisions governing restitutio in integrum, as do the national laws of the EPC member states. In this context, it is noted that Article 12 PLT obliges all contracting parties to provide for reinstatement of rights with respect to an application or patent upon request by the applicant or owner.

2. Requests for re-establishment of rights are usually subject to specific requirements regarding their admissibility and allowability. Even if the national laws may apply similar standards, variations exist within the different legislations and practices. One of the most important differences concerns the standard applied for assessing the merits of the request. While in some jurisdictions it is merely necessary to demonstrate that the failure to meet the deadline was "unintentional", other national laws require the party to demonstrate that the failure to meet the deadline occurred despite "all due care" having been taken. The possibility to apply one or the other criterion is reflected in both the PCT and the PLT.

3. Under the EPC, re-establishment of rights is governed by Article 122 and Rule 136. Under the well-established practice of the EPO, all due care is considered to have been taken if non-compliance with the time limit resulted either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system.

4. Apart from some exceptions, the criterion of due care is broadly applied, even if national provisions may describe it in slightly different terms (e.g. "through no fault of their own" or "legitimate excuse").

5. The meaning of all due care (or equivalent) is however not prescribed by law and is thus subject to differences in interpretation. Divergence within the practices may exist with regard to what constitutes "due care" but also to the quantum of due care to be demonstrated, depending on the situations.

6. The threshold for demonstrating all due care can be set low. Some national practices may thus excuse the failure to meet a time limit if it results from an accidental occurrence or, more generally, a cause foreign to the applicant, which is neither attributable to their will nor their fault or neglect. In other jurisdictions, the standard set is much higher, i.e. the ability to show an isolated mistake within a normally satisfactory system. Exceptional circumstances may be acknowledged but differ in their types and in the criteria applied (e.g. illness or transfer of rights).

7. Divergence in practices also exists in cases where an applicant is represented by a professional representative or has entrusted a third party with the completion of procedural steps. In some jurisdictions, the duty of all due care applies to the applicants themselves and their professional representatives as well as to any third parties entrusted with a patent application. As a consequence, the request for re-establishment can only be acceded to if all parties involved can show that they have exercised the due care required. In other national laws, request for re-establishment are granted when the failure is imputable to a qualified representative, as it is considered that the possible failure is rendered unpredictable for the applicant/proprietor because of that qualification. In this context it is noted that the quantum of due care to be exercised by a professional representative may be examined in the light of the agreement concluded with the applicant so that, depending on the national practices, the degree of responsibility of the professional representative may be assessed differently.

8. Another area where differences are known concerns the delegation of tasks to assistants and the conditions under which a request for re-establishment can be granted in the event of a culpable error on the part of an assistant.

9. Variations in practices may also exist with regard to some admissibility requirements. This in particular concerns the establishment of the removal of the cause of non-compliance, and, for that purpose, the identification of the person responsible (i.e. the patent applicant or proprietor or his authorised agent).