

**STANDING ADVISORY COMMITTEE
BEFORE THE EUROPEAN PATENT OFFICE**

**SUB-COMMITTEE ON PATENT DOCUMENTATION AND
INFORMATION (SACEPO/PDI)**

33rd meeting
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1. ADOPTION OF THE AGENDA / WELCOME

The Chairman opened the meeting by welcoming the participants.

The participants agreed to the agenda.

2. REPORT ON ACTIONS RESULTING FROM THE 32nd SACEPO/PDI SUB-COMMITTEE MEETING

2.1. STATUS REPORT FROM THE EPO

The members took note of the EPO's report on the actions from the previous meeting - see document SACEPO/PDI 2/16 - without further comments.

2.2. STATUS REPORT FROM THE MEMBERS' COORDINATOR

The members' coordinator, Mr Kallas, thanked the EPO for having responded to all topics. All open issues were on the operational level.

Action 42 – Regarding data from Korea, the EPO was analysing the gaps and continued to make efforts to obtain the missing data.

Action 51 – Mr Kallas proposed to keep the topic “patent statistics on technology trends in China” dormant and to raise the topic again when there was more detailed information on requirements.

Action 53 – Mr Kallas underlined that industry was increasingly interested in legal status data from Iran.

Action 54 – Concerning Y codes, Mr Frers reported on a communication with PATON Ilmenau. Students had found that there was a decrease in patent publications in these classes. This result could be reproduced. Having analysed the issue in-depth, it came out that the last update of Y classification codes happened in January 2015, although updates should take place at least twice a year. The key issue was that update information needed to be published to allow users to validate search results and avoid completely wrong conclusions. The information was available on the EPO's website, but difficult to find. Ms de Jong reported that the issue had been discussed during the EPO/USPTO CPC meeting on 16 March 2016. The aim was to have four updates per year. Y codes were applied by algorithms, based on CPC and keywords, not manually. This should allow regular updates, four times a year. Due to technical reasons there was only one update in 2015. It was important to make known when the last update took place. Mr Kallas enquired on what data the climate change mitigation report was based. Ms Thulin remarked that CPC was suitable for searching but not for statistics. The Office proposed to investigate how early and up-to-date information could be obtained and

possibly be published in a patent-information-related area (for example a user forum).

Action 55 – The Office reported that some steps had been made towards the request for changes to section names in the European Patent Register.

Action 56 – Mr Kallas reported that PDG IMPACT had created a task force to work on the standardisation of applicants' names. There was no great expectation of achieving results fast, but the group hoped for some progress. There was a need to discuss with national offices, patent attorneys and other stakeholders.

Action 57 – It was decided to close this point on legal status data from Japan.

Action 58 – Concerning statistical reports from the EPO, the Office reported that it planned to publish additional material.

Action 59 – The Office reported that some measures had been taken regarding reported inconsistencies in the Federated Register and proposed to discuss the issue under the related agenda point.

Action 60 – Mr Kallas underlined that delays and outdated data in the context of PCT cases entering the national or regional phase were an item of some concern. Users hoped for solution during technical debates in a meeting later in 2016, where WIPO and the EPO would participate. Data was out of date for ten countries. PDG would bring the topic forward and would be grateful for the EPO's support.

3. POLICY MATTERS

3.1. REPORT OF THE CHAIRMAN

Referring to various publications on the EPO in the media, the Chairman underlined that Patent Information in Vienna had a clear mandate and very good relations with the users. Vienna would keep on working according to the clear strategy to provide excellent patent information services to the public.

The Chairman reported briefly on the ISO certification, the progress regarding the unitary patent and the meeting of PDG with the EPO President during the EPO Patent Information Conference in Copenhagen.

A particular topic of interest for the members was the co-operation between the Office and WIPO. A meeting of the EPO President and the Director General of WIPO had taken place in 2015, where among other items, they had discussed the discrepancies in data collections in both organisations. It had been decided to use Mexican data as a pilot to

investigate differences and the reasons for them. In a next step, data from Brazil would be analysed by September 2016. The results would be presented in the following WIPO governing body meeting, in the hope of having the basis to tackle the remaining countries.

3.2. UNITARY PATENT

The Office confirmed that it was aware of the discussions in the last PDI meeting addressing how unitary patents could be identified by the users in the databases. Several ideas had been brought forward, ranging from specific document codes to a new country code. Other users preferred a more pragmatic approach. It was essential to understand the users' needs to come to a full and clear picture.

All options had been analysed and discussed within the Office, leading it to draw the following conclusions:

- Allocating a new kind code would only be possible if an associated document was created. From a legal point of view, there was no way to establish such a new document. Unitary effect did not create a new legal title in the strict sense. Creating a dummy document, for instance a first page, would lead to confusion amongst the users. Therefore, a new kind code was not appropriate or feasible for legal reasons.
- In order to satisfy the legitimate interest of the users to a maximum extent, there should be a new icon showing clearly the unitary effect in the hit lists and records in the register, together with some relevant data like the registration date. This would provide the most important information, also for statistical analyses.

Mr Indahl expressed his disagreement with the conclusion that a new document or legal title was needed to create a new kind code. If one looked at the European patent today, the same patent was validated in various countries and it was quite common that national offices created a publication. He saw no difference between this case and the case of the unitary patent. It was important to have such a document for practical purposes, for example for enforcement or for showing the value of a patent within the company. The user community was used to having validated patents as publications. There was also a political dimension: in the competition at a global level, a document would have more weight.

Ms Helliwell underlined that the information on unitary effect needed to be available also in non-EPO databases, for example patent family databases. An icon was not searchable. Users needed to know in the context of a patent family if a patent had unitary effect.

Turning to the issue of commercial databases, Mr Frers stressed that providers needed to be brought on board early to be able to integrate the

data into their databases. This would ensure the same level of service quality.

Mr Provvisionato stated that the Office's arguments for not introducing a new code were not convincing.

Although understanding the psychological aspects, the Office explained that the legal situation with the unitary patent was not entirely comparable with national validations. The pre-requisite for a kind code was the existence of a document. The Office, however, saw no added value in having a new document.

Mr Bodart brought forward the argument of PCT documents. When a PCT application entered the European phase, there was also no new information, but the EPO assigned a publication number nevertheless.

Mr Indahl added that due to the accession of further countries over time it was a good argument to publish the list of countries affected by the unitary patent protection at that point in time. Otherwise there might be confusion as to the countries covered by the unitary effect.

The legal framework for litigation was completely different, Mr Provvisionato said. Therefore it was important to state clearly what the jurisdiction was for purposes of litigation.

The Office confirmed that it understood that this was vital information and agreed to reconsider how this could be addressed in an appropriate way. Whether there was a new legal title or not, was less convincing, but the scope of legal protection and the jurisdiction was a legitimate point. Basically there were three aspects: the legal basis, the political visibility of the unitary patent and the technical realisation, satisfying the users' needs. The data would be fully available to commercial providers via the EPO's databases so that they would have everything needed to present the information in the way they choose.

Referring to the technical implementation Ms Helliwell asked what date would be indicated in the databases as the date of legal effect: the request for unitary effect, or the grant date for European patent specification and whether there would be two dates in the patent families. She stressed the need for the right technical presentation based on the legal framework.

The Office recalled that use cases had been collected and that the respective input had been very valuable. The majority of use cases described could be covered by the current solution.

Ms Thulin asked whether providers had been informed that they would need an extra field for the individual countries.

Summarising, Mr Kallas said that the minimum agreed was that an approach was needed that allowed to find unitary patents in the legal status and the bibliographic databases. Commercial providers should be given a clear indicator to avoid creative solutions, differing from provider to provider.

Adding to that, Mr Frers stressed that standards needed to be set now and Mr Dumarey asked the EPO not to decouple both routes.

To illustrate the planned solution, the Office presented mock-ups with the register for unitary patents being a new chapter in the European Patent Register.

Mr Bodart commented that this solution would not allow users to perform statistical analyses easily, for example to find out how many patents a particular company had in France.

Answering to a question from Mr van de Kuilen where information on opt out could be retrieved, the Office replied that this was a decision of the Unitary Patent Court which would be provided in their register. The EPO would find a way to present the same information in the European Patent Register.

Mr Frers said he understood that the EPO would have a clear indication icon for unitary patents. Daily business in companies was, however, to answer management enquiries regarding retroactive statistics, like the number of patents a competitor had. The presented solution would require to type in a range of dates and check each hit for whether there was a unitary effect. This would not allow getting required lists easily. The Office replied that filtering by request date was possible via the advanced search screen.

Mr Indahl asked whether the section on unitary effect would only be activated when unitary effect was requested, and if information would be published if no request was filed. The Office answered that the field would be greyed out and would only become active within a month, once the request was filed. No indicator was planned if no request was issued. Mr Indahl furthermore commented that it would be helpful if the information on a positive or negative decision on unitary effect would be searchable in the advanced search.

Mr Andersen stated that it was nearly impossible to search for an icon and asked if the Office could harmonise the date codes which currently were very different.

Taking into account the number of points raised in the discussion, the Office proposed to establish a wish-list. Mr Kallas offered to collect the proposals and send them to the EPO after the meeting. He underlined that searches did usually not start in registers, but elsewhere, and it was

essential to see in other resources whether there was unitary effect or not **(Action point)**.

Ms Chabrelie underlined once again that it was important to get commercial providers on board as soon as possible to reach a harmonised approach.

Answering to a question from Ms Thulin, the EPO confirmed that unitary patents will be published in the European Patent Bulletin.

Mr Provvisionato commented that the icon solution was simple. Nevertheless, a more sophisticated approach, sustainable in the future, should be considered. He proposed a country code.

Mr Luoto asked about the plans concerning Espacenet, in particular for searching portfolios. The Office explained that each patent information search tool had its own purpose. Espacenet was meant to search prior art and was linked to the European Patent Register for retrieving legal status information. The EPO would compare the situation now with the one in the future when the unitary patent was in place in order to ensure that the same type of information was available with the unitary patent.

Mr Indahl reiterated that a new publication would solve all the issues. The regulations indicated what must be provided but they did not restrict what could be done.

Mr Bodart stated that it was crucial to have information on the country coverage. If there was no country code or publication this would become difficult.

Adding to that Ms Sørensen emphasised that users would see the unitary patent not only as a legal event but as a new patent.

Mr Kallas stated that the users had obviously failed to describe all their use cases and a new attempt should be undertaken to re-define them.

The Office welcomed this initiative in order to understand precisely what was missing from the present concept.

Mr Luoto invited the EPO to think of Espacenet not too restrictively. It had developed to a powerful tool and should be fit for the future.

Mr Kereszty mentioned that a country code would be very important for patent attorneys, as it was used for managing the files. Attorneys would definitely open a new file for patents with unitary effect. The country code was more important than a new document.

Ms de Jong thanked the Office for the proposal but stated that it would not solve all the use cases. Nevertheless, for a detailed legal analysis it was suitable.

Concluding the discussion on this agenda point, the Office reiterated that it wished to understand how work was done today and what was expected in the future. Regarding the Bulletin a special chapter was planned. Mock-ups would be distributed. The Office thanked for the numerous contributions, and looked forward to receiving the wish-list and to the opportunity to adjust the proposals. It committed to try its best to find a solution meeting the needs. **(Action point)**

3.3. REPORT FROM THE MAIN SACEPO MEETING, JUNE 2015

The Office gave an oral report on the 47th SACEPO meeting which had been held on 18 June 2015 at the EPO in Munich.

Constructive feedback was given on the several topics, including:

Changes to the EPC's implementing regulations – R. 82 and R. 147 EPC

Rule 147 EPC related to the preservation of files at the EPO.

Several SACEPO members pleaded for keeping files in bitmap form, not as an OCR scan. The Office confirmed that the original file was kept as an image file.

Asked about the possibility to file colour drawings, the Office replied that currently, discussions are ongoing on PCT level and once allowable, it could be harmonised with the EPC (R. 46). This was appreciated by the members.

Early certainty from search

The Office informed that in 7% of all applications, PACE was requested (approximately 8.000 in search and 13.000 in examination).

The EPO was asked why third party observations had to be filed non-anonymously in order to lead to an accelerated prosecution. The idea was to avoid abuse, and – nevertheless - an agent / patent attorney can file such third party observations if the applicant is not in a position to file them due to contractual obligations.

The objectives of ECFS were once more appreciated by the members and the Office announced that it aims at getting rid of its backlog within two to three years.

A member stated that focus should also be put on further accelerating the grant procedure, the average duration of five years was felt too long.

IP 5 projects / Harmonisation of patent law and procedures

As concerns the PHEP, it was stated by a member that it should not be the aim to re-invent the PCT. The Office answered that the idea was to use the PCT notion as a starting point and that it aims at having the PCT rules applied in a uniform way by all Offices.

Asked about the difference between PPH and PACE, the EPO replied that there are different basic concepts: While PACE is a purely acceleration tool, in PPH earlier work results are being re-used.

Structural reform of the EPO's Board of Appeal

Some SACEPO members suggested the EPO to get input from outside with regard to the structural reform, i.e. expertise from people having a professional background working in/with Courts.

Validation agreements

One question related to the additional income for the EPO. The Office stated that the aim was not to increase its income. Only a small part of the validation fee (25%, i.e. EUR 60) remained with the EPO.

Unitary patent – progress report

The EPO gave a brief report on the latest developments. The new proposal “true TOP 4” was appreciated by members. It was furthermore stated in answer to a question raised that the EU Commission supported the proposal, and according to the EC's interpretation, only this proposal fulfilled the legal requirements. It was announced that in the coming week's meeting of the Select Committee, a formal decision on the level of renewal fees was expected.

Substantive Patent Law Harmonisation

The EPO gave a presentation on SPLH. Business Europe stated that the paper provided by the Industry Trilateral was a policy paper and not a direct proposal for legislation, rather a “toolbox” for the discussion. The patent working group of BE would be involved further.

A SACEPO member from industry criticised that mainly elements desired by the US had been taken on board, while the European positions were not reflected accordingly. Asked about the issue of the grace period in the context of TTIP, the EPO answered that it was not aware of the latest state of affairs since the EU Commission is in charge of these negotiations. However, the EPO was asked for advice in patent-related questions.

IP5 projects: CPC, Global Dossier

On CPC, a SACEPO member criticised that when the EPO performed searches on behalf of NPOs, no CPC classification symbols were provided with the search reports. The EPO replied that once the corresponding national applications were published, these symbols were made available for everybody, via, for instance, Espacenet.

With regard to Global Dossier, the EPO emphasised the importance of close and regular contact with users – therefore, the Global Dossier Taskforce was going to hold meetings on a yearly basis. Also, it was stated that the EPO continued to work with its IP5 partners to further improve the services, i.a. by harmonising the way of how to standardise applicant names.

Update on PCT matters

The Office gave an oral report on the PCT Working Group and a presentation on PCT Direct.

While the idea of a “one-stop-shop” in the context of PCT Direct was appreciated by users, the idea to open PCT Direct for other receiving Offices was criticised since it would make EP applicants subsidise applicants from outside of Europe. It was not felt desirable encouraging applicants, especially in the US, using the EPO and benefitting from the high quality levels provided by the EPO, since the fees charged would not cover the costs. The EPO replied that it assumed that those applicants who use PCT Direct would most probably be interested in entering the EP phase and get an EP patent later on. Furthermore, it was the political aim of the EPO to be an attractive PCT Authority and have an important share on the PCT market. It was also recalled that 67% of all ISA/EP users were Europeans, and 66% of all files where the EPO was ISA entered the EP phase.

Reports from SACEPO Working Party on Rules, Guidelines, and the sub-committee on Patent Documentation and Information

The EPO gave oral reports from the SACEPO WPs and sub-committee on PDI.

It was furthermore announced that a new sub-committee on “E-patent process” was created, gathering slightly different user groups than the existing Working Parties (e.g. Non-European PCT applicants who do not use epi-attorneys). The first meeting took place on 13 January 2016, in The Hague. The EPO wanted to engage with users on a technical business point of view. Focus was on operational matters related to the electronic processing of patent applications and on electronic communication during the patent grant process.

Adding to this point, the chairman asked to briefly present the report on the first meeting of the SACEPO/EPP subgroup (item 3 of agenda point 6: Any other business).

The office reported that the main subject of the group was the electronic business process between the EPO and patent applicants and/or attorneys related to their filed patent applications. At the meeting relevant interactive patent information tools had also been presented. The group participating was different to SACEPO/PDI and their focus was mainly on the patent grant process. There was not much overlap with SACEPO/PDI topics, but it made sense to keep each subgroup informed on the other's discussions.

3.4. ISO CERTIFICATION

The Office presented document SACEPO/PDI 3/16 and reported that in addition to the patent granting process an ISO 9001 certificate had also been obtained for patent information and post-grant services. No comments were made on this topic.

4. CURRENT PATENT INFORMATION PROJECTS

4.1. PATSTAT ONLINE AND THE EPO'S PATSTAT PRODUCT LINE

The Office presented document SACEPO/PDI 4/16 and subsequently document SACEPO/PDI 14/16 (agenda point 5, last bullet).

Regarding the harmonisation of applicants' names, Mr Kallas was interested in knowing more details, The Office offered to help by establishing contacts with the Catholic University of Leuven. **(Action point)**

Ms de Jong enquired who the main users of the PATSTAT product line were. The Office answered that it had identified that there was interest but many people did not understand how to use the PATSTAT products. Patent information specialists struggled to use patent intelligence to draw meaningful conclusions. For this purpose the EPO offered training on the tools and services as well as in interpreting and presenting the results.

Answering to Ms Thulin's question about the update frequency, the Office replied it was twice a year. Ms Thulin found that this was not enough. **(Action point)**

Ms de Jong remarked that there were a lot of commercial tools which provided patent statistics in a user-friendly way.

The Office explained that there were search tools complemented by statistical functionality. PATSTAT was rather different in that it had been

specifically designed for statistical work rather than an add-on to search work. This meant it was a powerful tool, but its users needed to spend time getting familiar with how to use it.

4.2. MOBILE PATENT INFORMATION SERVICES

The Office presented document SACEPO/PDI 5/16.

Mr Luoto reported some bugs, for example that users were forced to enter two search criteria. The service seemed to be a bit unstable. He asked whether the Office had considered offering native apps.

Hinting at the exchangeability of devices, the Office explained that the apps would exist in parallel to the mobile web version. The EPO encouraged users to report any problems with the mobile versions.

Mr Indahl welcomed the concept of native apps. This could bring patent information to new user groups, he said.

4.3. REGISTER FOR THE UNITARY PATENT

This topic was addressed and discussed extensively in the context of agenda item 3, bullet point 2.

4.4. EPO PILOT ON PUBLICATION OF SEARCH STRATEGIES

The Office presented document SACEPO/PDI 7/16.

Mr Kallas offered to collect feedback from the PDG before the summer break. **(Action point)**

5. UPDATE ON EPO PATENT INFORMATION PRODUCTS AND SERVICES

5.1. EPO PUBLICATIONS

The Office presented document SACEPO/PDI 8/16.

Referring to the publication of the European Patent Convention Mr Provvionato asked if the Office had considered having a running publication in PDF that reflected changes as soon as the Administrative Council adopted changes.

The Office explained that the concept was to align the PDF with the current printed version, rather than modifying the PDF whenever amendments took effect. It was, however, working on a HTML file that

was always up to date and hoped that this would be in place before the end of 2016.

In Denmark the solution was a USB stick, Mr Andersen reported.

Mr Frers enquired about the correctness of some figures in table 1.2 and the Office said it would check this. [After the meeting a revised version of SACEPO/PDI 8/16 was distributed to the members].

5.2. INTERNATIONAL PATENT DOCUMENTATION (INPADOC)

The Office presented document SACEPO/PDI 9/16. The Office reported that the move from SGML to XML for extractions from the Worldwide Legal Status Database had been discussed with commercial providers to ensure that they could cope with the transition properly.

Referring to US patents, Mr Thulin asked if information on the respective date could be added to the notice on abandonment. This would avoid users needing to go to US PAIR to get this information. She also wanted to know whether disclosure statements were included in the US citations. The Office was not sure whether they had information on the abandonment date. All information in citations was taken from the flow from USPTO. The Office said it would check the details and report back.
(Action point)

Mr Kallas appreciated that there had been great progress regarding SACEPO/PDI's wish-list. Two remaining issues were Indian data and abandonment information from US PAIR. Commercial providers seemed to have this information, so it was surprising that the EPO did not get it. It was agreed that Mr Kallas would send an example of what users would like to have. **(Action point)**

Concerning data from India, the Office reported that it had received some test data. The aim was to come to a regular delivery.

Mr Frers stated that there were a lot of providers delivering legal status information. He asked whether there were any initiatives to compare the EPO's activities with those from others. The Office responded that there were no systematic analyses or checks as to data resources or data enrichment by commercial providers. To the EPO's knowledge, respective products were mainly based on EPO data. If providers improved the data to achieve better results, this was certainly legitimate and the task of the commercial sector.

Adding to the agenda point, the EPO reported that a task force of the Committee on WIPO Standards (CWS) was working on a categorisation of legal events. A working group was exchanging respective information. There was a trend towards harmonisation, but progress was slow. Mr Kallas mentioned that PDG was part of the same task force.

5.3. EPO WEBSITE

The Office reported on the recent re-design of the “Searching for patents” area. The restructured pages aimed at better reflecting the landscape of patent information products. Products were now presented by use and useful support features had been added. Irrelevant information had been removed. A survey was planned to collect users’ feedback. Patent searching facilities had also been added to the mobile website. In the past year the Office had observed a nine-fold increase in the mobile website usage. Patent searching was now the most-used feature on the mobile website.

In the future, the Office was planning some changes to the entire website, including a clean-up of the header section, and the fly-out navigation menus.

The Office was also looking into providing an archive for legal texts, starting with the EPC. Recently, a survey had been conducted and the Office was now analysing the result in order to define the next steps.

In the long term, a complete relaunch of the EPO website as a responsive website was planned, where the display of the website adapts automatically to the devices used.

Mr Provvionato reiterated that searches in legal texts were presently very difficult. He proposed that users should be able to limit their search to specific areas. The Office confirmed that this was planned. Certain possibilities already existed within the advanced search. **(Action point)**

Turning to Board of Appeal decisions, Mr Dumarey stated that legal references existed but there was no indication of the version of the respective rule or article in force at that time. The Office took note of the request and would look into it. **(Action point)**

Mr Kallas asked whether there were any news regarding an archive for presentations at events. The Office responded that there were no news, but took note of the request. **(Action point)**

5.4. ESPACENET SERVICE, INCLUDING CCD

The Office presented document SACEPO/PDI 10/16.

Answering to a question from Mr Indahl, whether French and German collections were bulk-translated into English, the Office replied that its priority was to translate non-official language documents into English.

Ms Thulin enquired what machine would be used for bulk translation. The EPO stated that it was basically the same machine as for Patent Translate.

Concerning search options in full text, Mr Frers asked whether this would cover the whole collection. The Office responded that everything available in full text would be searchable, The Quality at Source (QaS) project would encourage offices to provide their data and fill in any gaps.

Referring to URL formatting for directly accessing and linking to documents in Espacenet, The Office underlined that the use of direct URLs might be interpreted as robot access by the traffic control. The EPO planned to make the traffic management regarding robot checks more intelligent.

Mr Provvionato asked the Office to communicate any changes in the URL to users as they transmit the URL to provide clients with a direct link to a document.

5.5. EUROPEAN PATENT REGISTER, FEDERATED REGISTER AND GLOBAL DOSSIER

The Office presented document SACEPO/PDI 11/16.

Referring to point 59 on the SACEPO/PDI action list, Ms Thulin reported on inconsistencies between the Finnish and the Federated Register Services. Although an EP patent was validated in Finland and the correct information was available in the online register of the Finnish office, the entry in the Federated Register indicated “no data provided”. In another example a patent was not validated in Finland, but the Federated Register showed the information “ongoing proceedings”.

The Office agreed to investigate the problem **(Action point)**. Indeed there was a risk that at a certain moment the national web service, necessary to retrieve the national register data, was not working, Further quality assurance measures needed to be implemented in coordination with the national offices.

Ms Thulin underlined that it was important to have a distinctive message when a technical problem occurred. A different message was needed when the technology worked, but no data were available **(Action point)**.

Mr Gundertofte requested that additional information should be made available, for example national publication numbers and information on SPCs. The Office explained that national numbers were available and it was working on the SPCs.

5.6. OPEN PATENT SERVICES (OPS)

The Office presented document SACEPO/PDI 12/16.

Mr Dumarey enquired whether robot access to Espacenet had been reduced through OPS and whether there was a difference in the data provided.

The Office responded that for automated access, it preferred to steer users to OPS. The need to register might, however, motivate users to turn to Espacenet. Therefore, robot control was necessary for Espacenet. Concerning the data, full text was not always available in OPS, due to legal restrictions on the provision of full text for certain offices in bulk.

5.7. PATENT INFORMATION FROM ASIA

The Office presented document SACEPO/PDI 13/16.

The EPO reminded members about the East meets West event, taking place on 21-22 April 2016 in Vienna. It acknowledged the request to include Iran in the Asian patent information services.

Mr Dumarey thanked the Office for the useful information made available via the EPO's Asian webpages. Due to the variety of information regarding China, it was easy to lose the overview and it was difficult to make an informed choice on the use of a particular tool or service. An indicator as to what were official sources would be useful.

The Office referred to the search guides and explained that all information on the EPO's Asian web pages were from official sources and not from commercial providers.

6. ANY OTHER BUSINESS

6.1. STATUS REPORT ON CERTIFICATION

Ms de Jong reported that the working group was making progress and focussed on getting sufficient support from the people concerned. The draft articles and rules had been published last year and a lot of varied feedback had been received. Careful explanation of the drafts could convince people in some cases, in other cases the feedback was taken on board and would result in amended articles and rules.

One of the main points of the negative feedback was that requirements were too strict. These were currently being considered, but even when people would not meet the requirements but felt they should be admitted,

there was already a hardship clause included. It was necessary to explain that the certification would not be a requirement for patent information professionals.

The recognition of prior experience and the identification of the candidates before exams was also an issue, in the worldwide context of the initiative.

A good suggestion was to set up an advisory committee, consisting of representatives from various organisations. That committee would appoint the supervisory council and give advice. It would also be responsible for communicating back to the organisation they represent.

A lot of resistance had been observed regarding the requirement for legal knowledge. The working group was, however, convinced that patent searchers needed a certain level of legal knowledge to assess the documents found during a search.

Continued professional development (CPD) was also a point of contention. Here, changing the order of the list of point-earning activities and providing examples seemed to have helped. It was also decided to start with a transition period to test the CPD requirements and the registration system.

Finally, it was appreciated that a group of well-known experts started addressing statistical analyses and patent landscaping.

A revised version of the articles and rules was expected to be ready soon. The working group hoped that this was the final version.

6.2. INNOVATION CYCLE PROJECT

The EPO reported on a recently launched project which aimed at investigating who the players in the innovation process were, and what role patent information could play for them in each of the phases. With the project, the EPO was trying to identify people in the innovation process in industry and universities, who used (or should use) patent information, what channels existed to contact them and how they currently used patent information. The Office had engaged a contractor, who had interviewed several dozen of these players. The next step was designing a questionnaire to be placed on the internet. The goal was to contact the innovators themselves and not necessarily the IP or patent information experts. The EPO planned to provide a summary of the findings in due course.

Turning to the SACEPO/PDI members, the Office asked for permission to contact them in the context of this work.

Mr Indahl said the initiative sounded very good and proposed to broaden the target group by contacting inventors named in patent applications over

the past five years. The Office said, data protection issues had to be considered and users of patent information were not necessarily applicants.

Mr Luoto referred to his work with start-ups. He observed that they were not aware of the patent system and patent information. He asked which kind of questions would be put in the questionnaire. The Office replied that the questions were not yet fully defined. In the first qualitative round questions focused on what innovators did exactly and where they would get the information they needed.

Mr Andersen stated that it was difficult to attract innovators. Usually only monetary arguments convince them.

Mr Indahl suggested further sources such as networks for entrepreneurship and business schools in the member states.

Mr Luoto added that business angels could be approached.

6.3. FURTHER COMMENTS

Mr Frers referred to the statistics in the EPO's annual report and reminded of his intervention in the previous meeting regarding the presentation of filing and application statistics. He proposed to present these figures in two columns: one for EP-direct applications and one for PCT applications. This way, users could check any "double-counting" and verify their own statistics.

The Office said it was aware of the issue. The Controlling Office had been alerted. Before the publication of the annual report the Office had consulted the top 150 applicants individually to consolidate the figures. The issue was outside the mandate of patent information and needed to be tackled at a political level.

Mr Indahl supported the concept of differentiating between "worldwide statistics", which would cover the filings and "EPO statistics" to cover European applications.

Mr Dumarey suggested presenting a ranking of grants as well.

The EPO committed to forward the proposals to the Controlling Office.
(Action point)

Mr Moradei proposed to include topics related to the European Patent Academy in future SACEPO/PDI agendas.

Ms de Jong stated that many patent information experts had a knowledge gap regarding legal aspects. Mr Provvionato suggested that a light version of the EQE Pre-exam could help to bridge this gap.

The EPO said it would look into the matter. **(Action point)**

Finally the Office touched briefly upon the new developments in Espacenet. Phase I would allow searching in different languages. Phase II was planned to introduce some new concepts, some of which, e.g. semantic searching would be investigated soon. The EPO invited SACEPO/PDI to support the development by participating in focus groups and to give input in surveys.

6.4. DATE OF NEXT MEETING

It was provisionally agreed to hold the next SACEPO/PDI meeting on **23 March 2017.**

Actions resulting

Nr	Area	Action point	Creation date	Status	Status date	Responsible
1.1	General issues	Mr Adams described a system (ORCID) that journal publishers were working on to create a universal author identifier. It would, he said provide a solution for accurate standardisation and transliteration of names, and proposed that the EPO looked at providing an extra field on the application form for inventors to enter their unique identifier. He agreed to monitor the ORCID project and report on further progress.	Before 2015	<p>Presently the EPO has various emerging projects looking into “standardisation” i.e. new Account Management, and IP5 – ANS as well as Standardisation of Bibliographic Data.</p> <p>These projects are looking into a continuation of further standardisation of the steps that are already taken in 2015.</p> <p>Regarding the harmonisation of applicants’ names, SACEPO/PDI was interested to know more details, The Office offered to help by establishing contacts with the Catholic University of Leuven.</p>	March 2016	EPO
1.2	General issues	The Office had information that WIPO's idea on PCT minimum documentation was to automatically include the national patent documentation of any PCT Contracting State as part of the PCT minimum documentation, provided that it was made available reliably in a suitable electronic format. Members asked the EPO to clarify if the intention of WIPO was to include ALL 147 PCT contracting states in the PCT minimum documentation, or only those accepted as an ISA.	Before 2015	This issue was part of discussions during the last Meeting of International Authorities in January 2016 in Chile. The aim is to include the national documentation of as many PCT Contracting States as possible as part of the minimum documentation. The participating Authorities welcomed that the PCT minimum documentation task force was reactivated. A task-force leader will be nominated soon.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
1.4	General Issues	Regarding statistics an issue was raised about the EPO's statistics on ranking of companies on the website. It was proposed to split ranking into two columns: direct European and PCT applications. Double counting was problematic and should be avoided. The EPO agreed to check the methodology of counting EP and PCT applications. The Office proposed to cross-check and align figures with big companies before publication. One further issue is the distinction between "filings" and "applications" in the EPO's statistics. "Filings" included PCT filings which had not entered the European phase.	March 2015	The EPO patent application statistics are primarily based on the count of requests for European patent (labelled "applications"). The number consists of the number of European direct applications and the number of Euro-PCT applications that entered the European regional phase during the period. This serves also as a basis for the ranking of applicants as presented in the context of the annual report. In order to present a meaningful list of leading applicants, the EPO approaches the enterprises likely to appear in the ranking, seeking their support to determine the perimeter of consolidation of group companies to be applied to better reflect the patenting activity of these enterprises at the EPO. The EPO refers to the number of "filings" (count of European direct applications and international PCT applications) as a trend indicator for the potential interest of applicants for the European market, while the count of "applications" reflect the actual decision to enforce protection in Europe by requesting European patents. The Controlling Office will be contacted concerning proposals to separate the statistics on filings and applications, and to provide a ranking according to grants.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
1.5	General issues	SACEPO/PDI voiced its impression that USPTO was not fully following the practice of CPC. CPC information was missing on many US documents published after 2013. This was unfortunate as these documents were then missed in alerts based on CPC classification. In Espacenet the documents had CPC symbols as EPO examiners assigned them. The PDG was discussing the issue.	March 2015	With the entry into force of the CPC on 1 January 2013, the EPO has not changed its earlier practice consisting of classifying all US publications. Since then and only from 2014 onwards, the classification of US publications by the EPO was stopped only in a few technical areas where the quality compliance level was deemed to be fit for purpose. CPC classification for the US documents referred to under 1.5 was made available by the EPO. Users should be reminded to look up for up to date CPC allocations in electronic databases (e.g. Espacenet, or DOCDB products) and not on paper copies of publications.	March 2016	SACEPO/PDI, EPO
1.7	General issues	Many patent information experts have a knowledge gap regarding legal aspects. A light version of the EQE Pre-exam could help to bridge this gap.	March 2016	The EPO will look into the matter.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
2.1	INPADOC and other EPO databases	The EPO was making progress on obtaining Italian data, but it was agreed there was much still to be done. The EPO will report progress to the next meeting.	Before 2015	The Italian Patent Office is presently migrating to a new bibliographic data extraction process. The EPO is thus currently not receiving regular updates for bibliographic data, however regular deliveries should be resumed shortly. Additionally the EPO received recently a batch of granted patents for the years 2012 and 2013 (B documents). It is expected that gaps for the missing bibliographies of A and B documents will be filled in soon. Concerning the delivery of full texts or images there are currently no news to report.	March 2016	EPO
2.2	INPADOC and other EPO databases	The EPO will negotiate with INPI about providing French granted documents in its databases.	Before 2015	The INPI has provided 240.000 French granted documents in facsimile to the EPO. The loading of these documents is ongoing (around 90.000 loaded so far, they are already available on the EPO's platforms Espacenet and OPS).	March 2016	EPO
2.5	INPADOC and other EPO databases	PatentScope includes some data that is not available in INPADOC	Before 2015	The EPO and WIPO are in regular contact on this matter and initiatives have started in order to identify more clearly where the differences are and how to fill in the gaps.	March 2016	EPO/PDG

Nr	Area	Action point	Creation date	Status	Status date	Responsible
2.6	INPADOC and other EPO databases	There seem to be some problems with the inclusion of Indian documents in patent families. These have been solved by some commercial providers, but not in INPADOC.	Before 2015	The contacts with the Indian Patent Office have intensified recently and the delivery of a first batch of bibliographic and full-text data took place in late 2015 (26,000 documents). These documents have been loaded and are now available from the EPO databases and services. It is expected that new and more regular deliveries will take place soon.	March 2016	EPO
2.7	INPADOC and other EPO databases	Add post-refusal data for Japan to the INPADOC legal status database.	Before 2015	Although investigations have been made in this sense, the information requested does not appear to be available for loading into INPADOC. The corresponding data could not be retrieved so far.	March 2016	EPO
2.8	INPADOC and other EPO databases	US patents: it would be useful if information on the respective date could be added to the notice on abandonment. This would avoid that users needed to go to US PAIR to get this information.	March 2016	The Office will check if information on the abandonment date for US patents is available and whether disclosure statements were included in the US citations. SACEPO/PDI will send examples of what users would like to have.	March 2016	EPOSACEPO/ PDI

Nr	Area	Action point	Creation date	Status	Status date	Responsible
3.1	EPO website	SACEPO/PDI members will prepare a proposal indicating the types of statistical information from the EPO that would be useful to them. The EPO will then respond on the feasibility of providing this information.	Before 2015	The EPO remains interested in this area of work and would be pleased to receive further input from SACEPO/PDI members.	March 2016	SACEPO/PDI
3.2	EPO website	With regard to the database of professional representatives, it was agreed that the members representing <i>epi</i> should submit a consolidated list of proposals for changes (e.g. data such as date and change of address, company, "member since ...", exportable list of <i>epi</i> members per country).	Before 2015	The EPO would be pleased to receive further input from SACEPO/PDI members.	March 2016	SACEPO/PDI
3.3	EPO website	Could the events calendar be improved in future?	Before 2015	The new interface which was announced was prepared on the assumption that the EPO will still want to promote third party events. Since this is no longer the case, this project was put on hold.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
3.4	EPO website	On archiving policy, members asked the Office to look into alternative solutions that would keep archive documents available, for example by means of a "search in the archive" option.	Before 2015	As indicated last year, a new media centre is now part of the website which allows searching press releases back to 2009. Work on the archive of legal texts in the HTML format is making some progress: first concepts were prepared and a survey was run based on these concepts with real users.	March 2016	EPO SACEPO/PDI
3.5	EPO website	It would be useful to have "snapshots" of certain moments in time for retrieving older versions of documents like fees, ancillary regulations, and past editions of important documents (e.g. using the "legifrance.gouv.fr" website as a model for this).	Before 2015	This is currently under investigation for legal texts. Past fees (from the year 2000 onwards) valid at a certain date can be retrieved in the interactive schedule of fees. Work on the archive of legal texts in the HTML format is making progress as indicated above.	March 2016	EPO
3.6	EPO website	Office said that an improved online search system was in planning for all legal texts on the EPO website, including the database of professional representatives.	Before 2015	The Office is looking into providing an archive for legal texts, starting with the EPC. Recently a survey had been conducted which was now being analysed to define the next steps. This activity is ongoing.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
3.7	EPO website	It was requested to enhance the availability of more archived material from EPO Patent Information Conferences as this included many interesting presentations, at least to keep particularly relevant presentations.	March 2015	The Office confirmed it would discuss and find a solution. This activity is ongoing.	March 2016	EPO
3.8	EPO website	It was proposed to include the new website search and complex RSS feeds in the webinar programme.	March 2015	The Office welcomed this idea and agreed to look into it. This activity is ongoing.	March 2016	EPO
3.9	EPO website	The subgroup asked about a possibility of providing more information in the RSS feeds. The information transmitted by the EPO was much thinner than from other sites.	March 2015	The Office said it would look into the matter, but could not promise a solution. This activity is ongoing.	March 2016	EPO
3.10	EPO website	Searches in legal texts are presently very difficult. Users should be able to limit their search to specific areas.	March 2016	Certain possibilities exist within the advanced search. The limitation of searches to specific areas is planned.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
3.11	EPO website	Board of appeal decisions: legal references to rules and articles exist but there is no indication as to the version of the respective rule or article in force at the time of the decision	March 2016	The EPO will look into the matter	March 2016	EPO
4.2	Espacenet, GPI and other products	The Office agreed to see if it was possible to identify common family members among the cited documents in the CCD.	Before 2015	The EPO continues working on this issue. Easier navigation to CCD will be implemented. The online documentation and access to online help will be improved. A download function will be developed to download the family members and their citations.	March 2016	EPO
4.3	Espacenet, GPI and other products	Regarding PATSTAT, members proposed to increase the update frequency to provide users with a more up-to-date tool for statistical analyses.	March 2'016	The EPO will investigate possibilities to increase the update frequency for PATSTAT.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
5.1	EPO publications	<p>Regarding European patents with unitary effect options for coding and publication were discussed (for example a separate country or kind code, publication of a front page or a set of bibliographic data).</p> <p>Users are strongly in favour of a separate document code, as this is important for preparing statistics.</p>	Before 2015	<p>Following the discussion conducted with internal and external stake holders, different options have been elaborated taking into account technical, legal and business-users constraint. A survey was carried out in summer 2015, to which SACEPO/PDI gave input. The Unitary Patent Protection Register (UPPR) will provide distinctive features to identify EP patent with unitary effect, in the results list and in the different UPPR panel views by means of a UPP icon and preceding the panel identification with "UP".</p> <p>Following discussions and taking into account users' concerns regarding the proposed solution to introduce an icon to identify patents with unitary effect, SACEPO/PDI will establish a list of proposals reflecting the users' needs.</p> <p>A final decision is not taken yet regarding the use of a code to identify European patents with unitary effect.</p>	March 2016	EPO SACEPO/PDI

Nr	Area	Action point	Creation date	Status	Status date	Responsible
5.2	EPO publications	In addition to the statistical information on publications already provided, other indications might also be useful, such as: the time between publication of the A and B document; and the time between request for examination and the first communication (setting time for divisional application and thus relevant), also showing variations between technical fields.	Before 2015	Statistical information like the time span between A and B publications are very informative as it can help patent searchers take decisions on search strategies. For risk assessment it would be useful to have detailed information between different actions and publications. The statistics on timespan between request for examination and first communication have not been updated. If there is a request, the EPO can provide it. For PCT applications, there is no real reference about when to expect publication. This confirms that it is a difficult task to assess time-lag, etc. As there is a need to assess the risk between 31 months period and entry into European phase the EPO is asked to provide such type of data for PCT publications. The Office invites the sub-committee to specify exactly which data they needed.	March 2016	SACEPO/PDI

Nr	Area	Action point	Creation date	Status	Status date	Responsible
5.3	EPO publications	The EPO was asked to release mock-up pages of the new register for unitary patents for the user community to comment. The Office confirmed that this was possible in principle, but there was no real data yet.	March 2015	Mock up pages will be communicated as soon as they are ready. Slides for illustrating the mock ups were presented during the meeting.	March 2016	EPO
5.4	EPO publications	The EPO is interested in users' views regarding the pilot on publication of search strategies and the usefulness for the public.	March 2016	SACEPO/PDI will collect users' feedback on the publications of search strategies by summer 2016.	March 2016	SACEPO/PDI
6.1	European Patent Register and Global Dossier	The citations tab of a record currently excludes any documents cited during the appeal procedure. Can it be changed?	Before 2015	It is planned to provide citations during appeal (meaning other appeal case numbers and patents cited) to the EP Register via EPODOC. The action is ongoing.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
6.2	European Patent Register and Global Dossier	<p>The current Table of Contents often includes many un-informative titles such as "Matter concerning the application", "Translation", etc. Can this be improved? Would it at least be possible to refer to documents by their number ("D1", "D2", etc)?</p> <p>Could translations indicate the language (e.g. "translations into English" rather than "translation")?</p> <p>For documents filed online, would it be possible automatically to take over the title as typed by the applicant? The Office said one thing it could look into would be to break down the list into sub-lists of documents submitted by the different opponents. Mr Indahl suggested having an overview document listing the documents in the file and any renumbering that may have taken place.</p>	Before 2015	New titles in file inspection are created as informative as possible. Revision of old titles are on hold for the time being.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
6.3	European Patent Register and Global Dossier	It would be helpful if the Register could include data on nullity or invalidation proceedings in the national courts. Initial analysis by Mr Adams indicates that the vast majority of such proceedings are held in one of only seven courts around Europe, so it might be feasible to collect data from these. The chairman suggested that Mr Adams submit a list of possible sources to the Office for further study.	Before 2015	A list of possible sources will help us very much to clarify this topic. Case law information on European patents may be provided by the ECLI search tool. A number of member states are already actively participating in the ECLI search tool and we believe that this tool will prove very useful to all legal practitioners when publicly available. Currently the service is under external testing phase. Stephen Adams offered to provide a respective document. EPO needs to double check sources with the ECLI web site once it is in PROD. A document from Stephen Adams is more than welcome.	March 2016	EPOS. Adams

Nr	Area	Action point	Creation date	Status	Status date	Responsible
6.4	European Patent Register and Global Dossier	In its current form, the "latest event" feature is not useful: some events were not included in the "latest event" notification (e.g. in the case of an extension to the time for reply on the examination report, the reply is not notified); other notifications came at the wrong time compared to the publication of the information they referred to. The EPO will see how it can improve the service. Some problems persist in the synchronisation of notifications with the appearance of corresponding documents in PDF format, mainly with documents coming from outside the EPO, especially when not specific to the examination procedure, such as a letter about a change of representative.	Before 2015	This is an ongoing activity, when it is considered that a predated communication should be postponed until the date on which the notification is made the publication of the event is kept in the so-called "waiting pot". Information on the events that are kept on the waiting pot is reflected as an attribute in the events lists provided in the EPO website (see Mr Adams offered to provide a paper describing his understanding of the situation. The Office proposed consolidating the document with other input. The Office briefly reported on the European Commission's ECLI project on European case law identifiers. In addition, the EC intended to create a single access point to case law via the ECLI website. The Office also reported on an initiative of the EPO's European Co-operation department on the provision of case law information by member states. The Office would need to clarify how far it could extend co-operation to courts. A bilateral approach might yield data as well. The EPO would appreciate concrete examples to reproduce and solve concrete cases.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
6.5	European Patent Register and Global Dossier	Automatic e-mail alerts sent by the Register Alert service are not secure, as e-mails are never secure. The EPO said this was certainly a matter that required further reflection.	Before 2015	The Office is in the process of clarifying what options exist for a more secure notification. This activity is ongoing.	March 2016	EPO
6.6	European Patent Register and Global Dossier	The Register should not confuse the data it contains: on the one hand, there is the official data, which is by definition correct (because the Register is in law the authoritative source) and on the other hand there is the data just provided as general information. Different colours could be used or a warning provided to stress this point.	Before 2015	The Office is considering using a disclaimer on the European Patent Register to clarify this point.	March 2016	EPO

Nr	Area	Action point	Creation date	Status	Status date	Responsible
6.7	European Patent Register and Global Dossier	The EPO agreed to look into making the documents in file inspection available as text, rather than scanned PDF, so that these texts could then be available for Patent Translate. Members also suggested that any OCR'ed text created by examiners could be added to the file.	Before 2015	The Office is in the process of clarifying if the option of providing documents from the file in txt is feasible. This activity is ongoing.	March 2016	EPO
6.9	European Patent Register and Global Dossier	The importance of early availability of CN examination reports in Global Dossier was stressed. The reply deadline for a SIPO office action was usually four months, so it would be really helpful to have the office action on line in time. This would save up to USD 900 per office action in translation costs. This information is also not available earlier on SIPO's website.	March 2015	A dialogue on the subject of timeliness of data via Global Dossier with all the IP5 offices has been started.	March 2016	EPO
6.10	European Patent Register and Global Dossier	Federated Register: Users identified some inconsistencies between information contained in the Federated Register and the national register concerning EP patents validated in Finland.	March 2016	The EPO will investigate what is the reason for the inconsistencies. It will also look into possibilities to provide differentiated messages for cases where no data are available and where there is a technical failure.	March 2016	EPO

**STANDING ADVISORY COMMITTEE
BEFORE THE EUROPEAN PATENT OFFICE**

**SUB-COMMITTEE ON PATENT DOCUMENTATION AND
INFORMATION (SACEPO/PDI)**

33rd meeting
Vienna, 17 March 2016

Subject: Annex 1: List of participants
Drawn up by: European Patent Office
Addressees: Members of SACEPO/PDI

33rd meeting of the SACEPO sub-committee on Patent Documentation and Information - Vienna, 17 March 2016

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