Patenting Information and Communication Technologies in Europe
Event for patent professionals
14 September 2016
New York City

In co-operation with Intellectual Property Owners Association
Foreword

The advances made in information and communication technology (ICT) have the potential to change our lives. Broad in definition and scope, it is a sector in which there are many truly astounding innovations. But such developments rely on solid, legally robust patents that provide intellectual property protection to reward the investments that have been made. Obtaining effective patent protection in Europe is therefore of crucial importance to our US users.

In order to facilitate this process, the European Patent Office is holding a seminar for the first time in the United States which has been specifically designed to offer extra insight to American users on the specificities of EPO procedures. Those attending will benefit from a series of breakout sessions which will deal with subjects such as claim drafting in the areas of healthcare and life sciences and guidance on EPO procedures for US applicants in the field of computer-implemented inventions. But in addition to these specialised sessions, participants will be given the most up to date information on issues set to influence patent applications in the future, such as the EPO’s focus on timeliness. Those attending will also gain comprehensive insight into how the decision to choose the EPO as International Authority results in a high-quality search and examination procedure for international applications.

With further insight into current practices and the newest initiatives at the EPO, we aim to ensure that US based applicants continue to be well-equipped to make the most of the EPO’s services, potentially saving time and money.

I wish you all a very enjoyable and constructive day in New York City.

Benoît Battistelli
President, European Patent Office
Preface

In the modern global economy, patent systems around the globe play a crucial role in spurring innovation and driving the development of new technology. Especially for multi-national companies, looking to grow their business around the world, the decision to invest the time and resources in the research and development needed to create inventions and to turn them into new products is a risky proposition. The costs can be high, success uncertain, and any payoff, if it comes at all, will be only after the investments are sunk. Patents help make these investments in innovation happen. Patents provide the legal protection that industry needs in order to have a chance to obtain a fair return on the time, effort and money needed to create inventions and to bring them to marketplaces across the globe. Patents provide the legal foundation upon which innovators safely can make the investments in research, development, manufacturing, and jobs that can turn an invention into a business. That is particularly true of the information and communication technology sector (ICT). The degree and speed of innovation in the ICT space is truly remarkable. Having an effective, efficient and global approach to IP protection in the ICT sector can make all the difference between business success and failure. An integral element of a comprehensive, global patent protection strategy for ICT and other technologies includes securing prompt, high quality patent rights in Europe. That is the focus of this seminar. I hope you are as excited by the opportunity to hear from our outstanding list of presenters as I am. Whether you are in private practice, a corporate law department, or otherwise interested in learning more about best practice in the EPO, this program promises to deliver topical, essential and practical information on protecting innovation through the EPO.

Kevin Rhodes
President, Intellectual Property Owners Association
13 September 2016

17.30 - 19.30 Networking drinks reception at Herb N’Kitchen
Co-hosted by the European Patent Office (EPO) and Intellectual Property Owners Association (IPO)

14 September 2016

The plenary session will be moderated by Albert Keyack and include time for Q & A

07.30 Registration

Plenary session
Beekman Sutton North

08.20 Welcome addresses
Benoît Battistelli, President, EPO
Kevin Rhodes, President, IPO

08.30 One-stop shop: the EPO at the centre of European innovation
Benoît Battistelli, President, EPO

09.00 European patent protection as an essential element of a global IP strategy for US based companies
Kevin Rhodes, President, IPO

09.30 Coffee break

10.00 A new focus on timeliness
Grant Philpott, Principal Director, Information and Communication Technologies, EPO

10.30 Computer-implemented inventions (CII) at the EPO
Christian Platzer, Director, Information and Communication Technologies, EPO
Breakout sessions

11.15  Guidance on EPO procedures for US CII applicants

Breakout session 1: Healthcare and life sciences
Nick Wallin, European patent attorney
Charlotte Nessmann, Director, Information and Communication Technologies, EPO
Clinton

Breakout session 2: Business methods
Michael Fleuchaus, European patent attorney
Christian Platzer, Director, Information and Communication Technologies, EPO
Nassau East

Breakout session 3: Presentation of information and human-computer interfaces
George Whitten, European patent attorney
Gino Herreman, Director, Information and Communication Technologies, EPO
Nassau West

12.15  Lunch
Sutton Center/South

13.00  Lunch address: The unitary patent package
Raimund Lutz, Vice-President Legal and International Affairs, EPO

13.45  Fit-for-practice: Claim drafting

Breakout session 4: Healthcare and life sciences
Nick Wallin, European patent attorney
Charlotte Nessmann, Director, Information and Communication Technologies, EPO
Clinton
Breakout session 5: Business methods
Michael Fleuchaus, European patent attorney
Christian Platzer, Director, Information and Communication Technologies, EPO
Nassau East

Breakout session 6: Presentation of information and human-computer interfaces
George Whitten, European patent attorney
Gino Herreman, Director, Information and Communication Technologies, EPO
Nassau West

15.15 Coffee break

Plenary session
Beekman Sutton North

15.45 Panel discussion: The EPO as International Authority under the PCT
Camille Bogliolo, lawyer, European and International Legal Affairs – PCT, EPO
George Whitten, European patent attorney
Michael Fleuchaus, European patent attorney
Robert Sterne, US patent attorney
Gino Herreman, Director, Information and Communication Technologies, EPO
Moderated by Albert Keyack

17.00 Closing remarks by the EPO and IPO
Raimund Lutz, Vice-President Legal and International Affairs, EPO
Mark W. Lauroesch, Executive Director, IPO

17.15 End of the conference
Keynote speakers

Kevin Rhodes is a Vice President and the Chief Intellectual Property Counsel of 3M Company, and the President and Chief Intellectual Property Counsel of 3M Innovative Properties Company in St. Paul, Minnesota, where he is responsible for managing the global intellectual property assets of 3M Company and its worldwide affiliates.

Mr. Rhodes currently serves as the President of the Intellectual Property Owner’s Association. He also is a member of the Board of Directors of the Intellectual Property Owner’s Association Education Foundation and the Executive Committee of the Association of Corporate Patent Counsel. He is a past member of the Board of Directors of the American Intellectual Property Law Association.

Mr. Rhodes serves on the Steering Committee of the Coalition for 21st Century Patent Reform and he has testified before Congress and administrative agencies, and has spoken widely, on issues of intellectual property law and policy. Prior to joining 3M in 2001, Mr. Rhodes was a partner at Kirkland & Ellis in Chicago, where he specialized in intellectual property litigation.

Mr. Rhodes received his J.D., magna cum laude, from Northwestern University. He is a registered patent attorney, with an undergraduate degree from Grinnell College.
Raimund Lutz is Vice-President of the Directorate-General Legal and International Affairs since 2011. On completion of his law degree he worked for three years as a judge and public prosecutor in Munich before joining the Division for Commercial and Economic Law at the Federal Ministry of Justice, Bonn. In 1989, he moved to the German Patent and Trade Mark Office as Head of the Berlin division and from 1997 he also took on the post of Director of the Trade Mark Division at the Office in Munich. From 2000-2005 he was Deputy Director-General for Commercial, Economic and Intellectual Property Law at the Federal Ministry of Justice in Berlin. In 2006, he was appointed President of the Federal Patent Court in Munich where he worked until joining the European Patent Office.
Mark Lauroesch is the Executive Director of Intellectual Property Owners Association where he lobbies for improvements to IP laws worldwide. Mark previously had a long career with Corning Incorporated, where, as Vice-President & General Intellectual Property Counsel, he directed all IP matters worldwide. His accomplishments for Corning included growing the IP department three-fold while aggressively pursuing Corning’s IP interests in US and international markets; crafting global IP strategies through assessment of the evolving competitive environment; developing patent portfolio management strategies and procedures to achieve a 25,000+ patent portfolio; negotiating IP arrangements of all types; and successfully resolving dozens of intellectual property disputes in US and foreign courts. Earlier in his career, Mark was an Associate at Finnegan, Henderson, Farabow, Garrett & Dunner; Judicial Clerk to Chief Judge Paul Michel at the US Court of Appeals for the Federal Circuit; and Senior Research Engineer at Northrop Grumman Corporation.

Mark received his Juris Doctor with honors from George Washington University Law School; his Master of Science in Mechanical Engineering from the University of Massachusetts; and his Bachelor of Science, cum laude, with Highest Honors in Physics from St. Lawrence University.
Abstracts and speakers’ profiles

A new focus on timeliness

Patent offices worldwide have difficulty coping with the growing number of applications. Recognising that backlogs seriously hinder the transparency and effectiveness of the patent system, the EPO now has a raft of measures in place to ensure faster processing in search, examination and opposition, and the first results are impressive. In this session the speaker will outline the internal work-prioritisation categories that have been introduced and explain how the applicant can optimise the operation of this system for specific types of applications. The session will then look at the benefits of using the PCT-Direct route in order to expedite completion of the examination procedure in the regional phase. Finally, he will take a brief look at the various waiver options and request for early processing as further means for accelerating the overall procedural timeline.

Grant Philpott has been a Principal Director in the search and examination area of the European Patent Office (EPO) since March 2012. In 2014 he brought together the EPO’s computer and telecommunications patenting operations, and now manages the resultant information and communication technology unit comprising over 700 highly qualified patent examiners based in The Hague and Munich. Prior to 2012 Grant was responsible for the EPO’s semiconductor patenting directorate in Munich. During his 25 years at the EPO he has worked across a broad range of technical fields including mechanics and industrial chemistry, as a member of the committee responsible for organising the European qualifying examination for patent attorneys, in the EPO’s Controlling Office and on several automation projects. Before joining the EPO, Grant spent several years as director of the Brazilian subsidiary of a German electrical components manufacturer and as an engineering officer in the British Army. He holds an engineering degree from Cambridge University.
Computer-implemented inventions (CII) at the EPO

A computer-implemented invention is one which involves the use of a computer, computer network or other programmable apparatus, where one or more features are realised wholly or partly by means of a computer program. As technology advances and matures, computer-implemented inventions are used increasingly in all fields of technology. In many cases the innovative part of a new product or process may well lie in the method underlying a computer program and/or its computational implementation. Undoubtedly, the patentability of such inventions poses a special challenge to patent offices around the globe. The European Patent Office has developed an approach which is stable and reliable in its results, thereby providing a high degree of predictability for applicants filing computer-implemented inventions. In this session the methodology will be explained, starting from the fundamental provision that a patent should be granted for any invention, in all fields of technology, provided that it is new, involves an inventive step, is susceptible of industrial application and is not expressly excluded from patent protection (Article 52 EPC).

Christian Platzer is Director of the joint cluster Computers at the EPO, managing the operational area which deals with applications in the field of business methods. He studied electrical engineering and computer science at the Technical University in Vienna, Austria. After developing microcontroller designs for industrial applications, he joined the EPO in 1990 as an examiner in the field of computer-implemented inventions and examined patent applications in the fields of processor architectures, memory management, medical informatics and business methods. Christian has represented the EPO in co-operation activities with various European countries and in Canada, China, India, Singapore, Taiwan and the USA. He has lectured at the ETH Zurich on the topic of patentability of business methods and computer-implemented inventions at the EPO.
Breakout session 1 and 4: Healthcare and life sciences

ICT inventions are becoming more and more prevalent in healthcare and life sciences. Yet understanding the EPO’s approach to patentability in this area is often difficult, as the applicant not only faces the exclusion from patentability of treatment and diagnostic methods carried out on the living human or animal body, but also has to contend with the particularities of computer-implemented inventions.

In the morning session we will provide an overview of the particularities of healthcare and life sciences involving information processing, based on the relevant articles of the EPC. The exceptions to patentability will be presented and corresponding recent case law will be discussed.

In the afternoon session, we will look at the EPO’s patenting practice with respect to healthcare and life sciences. We will outline the hurdles which have to be overcome in order to patent medical practices (diagnostic methods, methods for treatment by surgery) and technicality (mathematical methods, presentation of information, simulation, business methods), and give examples.

Charlotte Nessmann, Director ICT, EPO The Hague. PhD in physics from the University of Graz after studies in Graz, Bielefeld and Paris. Post-doctoral research fellow at the University of Pennsylvania, Philadelphia and at Yale University, New Haven. In 1988 she joined the EPO in Munich as an examiner in the field of controlling and monitoring. In 2002 she became director in the principal directorate ICT, heading a directorate responsible, inter alia, for medical informatics. She is active in the working party on procedural matters and Guidelines for Examination in the EPO and is also involved in organising the European qualifying examination for patent attorneys.
Nick Wallin heads up the Electronics, Computing & Physics group, the largest practice group at Withers and Rogers LLP. He is also an experienced patent litigator who has handled cases before the Court of Appeal, the High Court and the Patent County Court. He works for a wide range of predominantly direct UK-based clients, in fields ranging from electro-surgery and medical imaging through to sensors for defence purposes or the oil and gas industry. With a technical background in electronics, software, and communications, Nick spent time working at BT labs before joining the patent profession in 1997, and returned to BT for a spell as in-house patent counsel before joining Withers & Rogers in 2004. He is also a qualified patent attorney litigator, entitled to conduct IP litigation in any UK court. In 2008 and 2009 Nick put this ability to good use in the Symbian case (see Symbian Limited’s Application http://www.bailii.org/ew/cases/EWCA/Civ/2008/1066.html) concerning the patentability of computer operating systems. Since that time he has focused his litigation practice on the IPEC (formerly the Patents County Court), confirming his belief that the IPEC provides a world class forum for cost effective resolution of IP disputes. On the patent prosecution side, he specialises in developing and executing cost-effective IP procurement strategies for domestic businesses, marrying his in-house and private practice experience together as “outsourced in-house” IP counsel for his direct clients.
Breakout sessions 2 and 5: Business methods

It is a widespread misconception based on the wording of Article 52 EPC that innovation in the field of business methods cannot be protected by patents in Europe. Whilst the grant rates are low, with the right approach it is possible to get a patent in this area provided that technical innovation is involved. Starting from the established examination practice for applications having a mix of technical and non-technical features, we will illustrate how examiners analyse patent applications relating to business methods and what exactly they look at when deciding on the allowability of a claim. We will also compare the US post-Alice subject-matter eligibility criterion and the approach applied at the EPO. In the morning session, we will explain the examination methodology using concrete examples where the outcome has been mostly negative, and in the afternoon session on claim drafting we will provide guidelines as to what can be done to improve the likelihood of a positive outcome.

Christian Platzer, see CV above for a previous presentation

Michael Fleuchaus, German patent attorney and European patent attorney, holds a degree in technical physics from the Technical University of Munich. Michael is frequently involved in contentious litigation matters but also handles a diverse prosecution portfolio with a particular focus on CII (computer-implemented inventions), ICT (information and communications technology), and medical apparatus technologies. Michael also has substantial hands-on experience in the computer sector, specifically in system architecture, database and data transmission applications, as well as user interface design. He has been an active member of the epi’s European Practice Committee since 2011 and has chaired the ICT sub-committee since 2013.
Breakout sessions 3 and 6: Presentation of information and human-computer interfaces

There is strong demand for patent protection of inventions relating to data visualisation and user interfaces in a wide variety of technical fields including computer applications, smartphones, automotive user interfaces and measurement devices. But what kind of contribution over and above the prior art do these inventions need to make to be patentable, in particular given the EPO’s approach to computer-implemented inventions? A key issue here is what aspects of the contribution qualify as “technical” as only these aspects can support the presence of inventive step.

In the morning session, we will look at the problem-solution approach applied at the EPO, and more specifically how it is used for applications containing a mixture of technical and non-technical features. We will then turn our attention to some decisions of the boards of appeal, focusing on applications that deal with the presentation of information and human-computer interfaces.

In the afternoon session, the EPO’s practice as set out in its Guidelines for Examination will be explained for this particular technical area. The emphasis will be on improving the participants’ feel for what is patentable so that they can take this into account when drafting claims that are likely to be acceptable to the EPO. Arguments that can be put to effective use in proceedings before the EPO will also be presented. We will look at (non-)examples of all points discussed.
**Gino Herreman**, Director ICT, EPO The Hague
He graduated in 1983 as a mechanical-electrotechnical engineer specialising in electronics at the Free University of Brussels, Belgium.
In 1986 Gino joined the European Patent Office as an examiner in the area of fault detection and correction, fault tolerance and monitoring, a computer-related field. From the mid-nineties, he was also active as a coach and instructor for newcomers to the EPO.
In 2004 he became a director at the EPO, heading a directorate responsible for ICT applications, including applications for human-computer interfaces and portable devices. Over the past 12 years, Gino has been active in many working parties, including one responsible for redrafting the EPO’s Guidelines for Examination. He is also a regular guest speaker, giving presentations worldwide on such topics as the patentability of computer-implemented inventions.

**George Whitten** is one of only a handful of patent attorneys in the UK with the triple qualification of patent attorney, patent attorney litigator and patent attorney advocate. He has worked in both private practice and in industry. His practice has covered such diverse technology fields as image processing, special effects for television and film, and barcode scanners. He has a broad understanding of the wide range of technologies associated with the cellular communications ecosystem.
George’s responsibilities are international and cover a diversity of activities including high-value patent litigation, licensing, strategic analysis, patent acquisition, and portfolio management. His ability to work across different jurisdictions helps provide a bridge between his colleagues in the USA and lawyers in other countries. He works with multidisciplinary teams throughout the world – from the USA, through the UK and Europe, to Asia and New Zealand.
Panel discussion: The EPO as International Authority under the PCT

In this panel key experts and decision makers will exchange their views on EPO’s new services in the area of PCT as well as discuss current initiatives aimed at strengthening the PCT system. The session will ensure that participants can also express their opinion and ask questions to the panellists. The discussions will focus on the following three subjects, each first being briefly introduced by a PCT expert from the EPO:

– **The one-stop shop theory ... in practice.** The EPO has put into place a comprehensive approach by ensuring that the PCT provides a smooth and easy step in a standard patent prosecution strategy with new services offered during the international phase such as PCT Direct or top-up search in Chapter 2, and measures aiming at facilitating entry into the European phase. It thus appears more convenient for users to have the EPO as unique partner for the whole procedure.

– **Is the EPO really expensive?** It is common to hear that EPO services are very good but expensive. The reason is that EPO’s PCT search and examination fees are indeed higher than most other major Offices. However, this assumption does not appear to hold when looking beyond the sole international phase. On the basis of filing scenarios, the panellists will have an in-depth discussion on whether the EPO is competitive on price when taking the overall prosecution strategy into consideration.

– **Looking beyond.** EPO’s efforts to strengthen the quality of its services goes hand in hand with global initiatives to answer applicants’ needs. In the framework of the PCT, the EPO and its four IP5 partner offices acting as International Searching Authorities launched in June 2016 a pilot to test a new concept of collaborative search and examination which could potentially bring higher legal certainty at an earlier stage of the procedure.
Camille Bogliolo, lawyer, European and International Legal Affairs – PCT, EPO Munich, graduated from Sciences Po, Paris. He also holds a Master of Arts in European studies from the University of Kent, Canterbury, and a Master of Laws in European and comparative law from the University of Maastricht. From 1999, he worked at the French Patent Office as a lawyer in international and European legal affairs. In 2001, he joined WIPO and specialised in the PCT. He co-ordinates work on PCT affairs at the EPO, where he has worked since 2006.

Robert Greene Sterne is a founding director of Sterne, Kessler, Goldstein & Fox P.L.L.C., a premier intellectual property law firm based in Washington, D.C. He has extensive expertise in AIA post issuance proceedings and concurrent patent litigation, USITC 337 investigations, Federal Circuit appeals, EU enforcement, reexamination, patent monetization and licensing, and corporate intellectual property best practices (CIPO and Board of Directors). Robert is a registered US patent attorney, has spoken and written extensively on these topics throughout the past 39 years, and was named in 2015 by the Financial Times as one of the “Top Ten Legal Innovators in North America.” Most recently, he was named by Law360 as one of “The Top 25 Icons of IP”.

George Whitten, see CV above for a previous presentation
Michael Fleuchaus, see CV above for a previous presentation
Gino Herreman, see CV above for a previous presentation
Moderator

Albert Keyack is the EPO Attaché to the United States. He previously served as Attaché for the USPTO to Latin America. Albert began his career in 1987 at a law firm where his practice included both patent prosecution and litigation. More recently he has practiced in law firms and as in house counsel, clients in matters involving patents as well as in a variety of transactional matters. Albert earned a degree in Mechanical Engineering from Villanova University and a law degree from the Rutgers University School of Law.

The EPO patent information stand

Quality is the hallmark of the European Patent Office. On the stand the EPO will be presenting the quality improvements to its search and examination standards, especially those concerning the coverage of Asian documentation and the new options and services available for PCT applicants filing with the EPO. The Office will also present its Federated Patent Register and Global Dossier projects, both of which bring together reliable legal status information from multiple patent registers.

Dan Shalloe, a mechanical engineering graduate, joined the European Patent Office as a patent examiner in 1989 and moved to the newly formed Vienna office in 1991. Since that date, Dan has specialised in patent data and patent search tools. He is the editor of the EPO’s Patent Information News newsletter and project manages the EPO’s Patent Information Conference.
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IPO's Annual Meeting offers a mix of educational programs led by distinguished presenters as well as committee meetings, exhibit hall, and networking functions.

SPECIAL EVENT
DINNER RECEPTION AT THE MUSEUM OF MODERN ART

KEYNOTE SPEAKERS

MONDAY
Hakeem Jeffries
U.S. Congressman
8th District of New York

TUESDAY
Benoît Battistelli
President
European Patent Office

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