EPO Mobility & Mechatronics Seminar

Win-win solutions – drafting Successful Applications for the EPO
The EPC recognizes **four** categories of claims of two basic kinds:

<table>
<thead>
<tr>
<th>Physical entity</th>
<th>Activity</th>
</tr>
</thead>
<tbody>
<tr>
<td>Product</td>
<td>Process</td>
</tr>
<tr>
<td>Apparatus</td>
<td>Use</td>
</tr>
</tbody>
</table>

- Including substances, compositions, devices, systems, etc.
- Including methods and actions, exercised over entities or other processes

Special provisions apply to **Computer-Implemented Inventions** (i.e. where at least one claimed feature is realized by a program)

See CII index on EPO website
European patent examination in a nutshell

- The European examination procedure aims at arriving at a clear definition of the invention in terms of its **technical features**.

- This requires restricting the scope of the claims to a combination of technical features that is **novel** and **inventive** over the prior art.
Independent vs dependent claims

- **Independent claims:**
  - Focus on the **essential technical features** of the invention
  - Limited to **1 per category** (with some exceptions)
  - Should cover **all** embodiments of the invention
  - Related Rules are R62a and R43(2) EPC

- **Dependent claims:**
  - Relate to optional or non-essential technical features
  - Must be of the same category as their parent claim
  - May relate to individual embodiments
  - Represent safe fallback positions during the procedure
Claims – Attorney comments

✎ Include all required claims in the priority application (and dependencies)

✎ Amend to put high priority claims at the start on EP reg. phase (and dependencies)

✎ Relatively common to be able to retain multiple independent claims in same group (Rule 43 EPC exemptions)

✎ Question the ‘essentiality’ of the features requested by EPO

✎ Clarity objections sometimes given preference over, and raised in advance of, novelty/inventive step objections in Examination Reports
Allowability of amendments - Art. 123(2) EPC

The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

Gold standard: “directly and unambiguously”

directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.
Conclusion: in practice

- Clearly NOT allowable
  - Omitted feature presented as or clearly essential

- Clearly allowable
  - Omitted feature explicitly presented as optional or replaceable
Recommendation

Draft claims with **multiple dependencies** to provide fall-back positions for amendments or description of US application should contain support for claims with multiple dependencies.

**Combinations** of technical features should be **explicitly disclosed** in the description, including an omnibus clause allowing all possible combinations of features.

Clearly disclose possible fall-back positions in the description, preferably in combination with other technical features.
Amendments (1) – Attorney comments

- EPO case law has led to a stricter approach. Applying a ‘gold’ standard
- There is no ‘pick and mix’ of features from the specification/claims
- Need a credible ‘link’ between the features
- Ideally amendments should come from a claim – provides clearer basis for Examiners
- On drafting ensure the commercial combinations are clearly evident and supported – this allows for amendment later.
- Intermediate generalisations – sometimes more needs to be added to overcome added matter objections.
Amendments (2) – Attorney comments

- Gray area is a common place applicants find themselves.
- Especially when aiming to mirror US claims.
- On drafting priority application think ahead about EPO prosecution.
- Combination of features, basis for the combination, technical effect.
- Avoid serial ‘may’ wording. Is this feature truly optional?
"Incorporated by Reference"

Where the reference document relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus), then the examiner should first consider whether knowing what is in the reference document is in fact essential for carrying out the invention as meant by Art. 83 (Sufficiency of disclosure).

If not essential, the usual expression "which is hereby incorporated by reference", or any expression of the same kind, should be deleted from the description.
Recommendation

Relevant technical features of a reference, should be included in the description of the application *expressis verbis*.

Later introduction of such features usually leads to an added matter objection (Art. 123(2))!
Incorporated by Reference

- In practice, very hard to rely on at the EPO.
- Basis is required in the application itself.
- What does the skilled person derive from the application?
Formal issues

Prior art in description;
relevant background should be briefly discussed

Spirit of the invention;
lack of clarity of the claims when the description is used to interpret the claims

Two-part form; features known in combination from the prior art being placed in the preamble and the remaining features being included in the characterising part

Reference signs;
The features of the claims should be provided with reference signs
Formal Issues

- If in front of EPO as ISA/IPEA defer formal issues to National/Regional Phase.
- There are a number of arguments that can be used to support maintaining the one-part form.
- Reference signs are not used for interpretation at EPO.
General Comments

- EP requirements allow for varied speed of prosecution
  - Use the procedural steps to speed up or slow down prosecution
  - Extensions of time are more limited now
  - EPO as ISA can lead to extremely fast grant in Europe

- EPO correspondence goes on the public record
- Cross-contamination
- Plan the priority application for international use (not – US centric)
For discussion during the exercise
Undisclosed Limitation – single claim dependencies

Claim

Claim 1. Device comprising feature A

Claim 2. Device of claim 1, further comprising an feature B

Claim 3. Device of claim 1, further comprising a feature C

Amended Claim:
Device comprising feature A, feature B and feature C → NO
Admissible Limitation – multiple claim dependencies

<table>
<thead>
<tr>
<th>Claim</th>
<th>A</th>
<th>B</th>
<th>C</th>
</tr>
</thead>
<tbody>
<tr>
<td>Claim 1. Device comprising <strong>feature A</strong></td>
<td>✓</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Claim 2. Device of claim 1, further comprising <strong>feature B</strong></td>
<td>✓</td>
<td>✓</td>
<td></td>
</tr>
<tr>
<td>Claim 3. Device of <strong>claim 1 or 2</strong>, further comprising a <strong>feature C</strong></td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
</tbody>
</table>

**Amended Claim:**
Device comprising feature A, feature B and feature C → Yes
Inventive Step: The EPC

Article 52 "Patentable inventions":
(1) European patents shall be granted for any inventions ... provided that they ... involve an inventive step ...

Article 56: An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

Inventive step is a substantial issue: "Application and Patent in suit" are used interchangeably.
The skilled person evaluates:

- basic handbooks and textbooks
- scientific periodicals addressed primarily to qualified professionals and enjoying worldwide repute
- articles in technical journals can be representative of common general knowledge, in particular articles providing a broad review or survey of a topic

Numerous publications in the specialist press over a short time, reporting on meetings and research in a particularly active field of technology, could reflect common general knowledge in this field at that time.
Inventive Step – Attorney Comments

- Important to have beneficial effects as “hooks” to hang inventive step arguments on.
- During prosecution not much “mileage” in arguing wrong document selected as closest prior art.
- Presenting in a helpful format assists Examiner in defending grant to the other members of the Examining division.