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Examination Matters 2017 Webinars

Amendments and unsearched subject-matter



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Amendments and unsearched subject-matter



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Amendments and unsearched subject-matter



Agenda

- Objectives
- Scenario "rubber saucer"
- Toolbox on Rule 137(5) EPC
- Scenario "anti-skid saucer"
- Prevention and remedies
- Conclusions
- Questions

Amendments and unsearched subject-matter



Objectives

- Exploring the legal framework surrounding Rule 137(5) EPC
- Gaining awareness of practical implications
- Identify strategies to handle and prevent objections

Rule 137(5) EPC

Amendments and unsearched subject-matter



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- ✓ Objectives
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Scenario "rubber saucer"



Scenario

solution:



- ▶ **Problem:**
Provide saucer that can be used with cups of different sizes

Scenario "rubber saucer"



Scenario

Claim 1

Saucer having a plurality of concentric recesses

Claim 2

... with the recesses in a stepped configuration

Description

Made of rubber – no slipping of cups ...

- ▶ **Problem:**
Provide saucer that can be used with cups of different sizes

Scenario "rubber saucer"



Scenario

Claim 1	A
Claim 2	A + B
Description	C to improve A
EPO (search)	A not new
Amended claim 1	A + C
Amended claim 2	A + C + B
EPO (exam.)	Not admitted (R137(5)).

▶ Do you think that this objection is justified?

yes no

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Toolbox – analysis



Amendment of the European patent application

- Amended claims may not relate to unsearched **subject-matter**
- which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.
- Nor may they relate to **subject-matter** not searched in accordance with Rule 62a or Rule 63.

Rule 137(5) EPC

Toolbox – "unsearched subject-matter"



Drawing up of the European search report

*"(...) a European search report (...) on the basis of the claims, **with due regard** to the description and any drawings."*

Article 92 EPC

Toolbox – "unsearched subject-matter"



Searched subject-matter includes ...

- ... subject-matter of the claims
- ... essential features
- ... feature making contribution to the effect of the features of originally claimed invention

Article 92 EPC

GL B-III, 3.5

GL H-II, 6.2

(GL = Guidelines)

Toolbox – "unsearched subject-matter"



Unsearched subject-matter results from ...

- ... technical features from description with effects unrelated to the effects of the features of originally claimed inventions

GL H-II, 6.2

Toolbox – "single general inventive concept"



Assessment

- Compare subject-matter of original claims and amended claims,
- and check if there is lack of unity between the amended claim and the original claims.

GL H-II, 6.2

Toolbox – "single general inventive concept"



Further indicators: does added feature ...

- ... change the nature of the invention?
- ... fall under original general inventive concept ?

T 2334/11

T 0345/13; T 274/03

Toolbox – special cases



Rule 62a and/or Rule 63 EPC cases

- Amended claims may not relate to subject-matter not searched under Rule 62a or Rule 63. The presence of this subject-matter in the description cannot be used for its reintroduction into claims.

Rule 137(5) EPC
GL, H-II, 6.1

Toolbox – summary



Rule 137(5) EPC

- Amended claims may not relate to unsearched subject-matter
- which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.
- Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63.

Content



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- ✓ Introduction
 - **Scenario "rubber saucer"**
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Scenario "rubber saucer"



Scenario

Claim 1	A
Claim 2	A + B
Description	C to improve A
EPO (search)	A not new
Amended claim 1	A + C
Amended claim 2	A + C + B
EPO (exam.)	Not admitted (R137(5)).

▶ Is objection justified?

yes no

▶ Not justified.

The feature "C" is deemed to be part of the searched subject-matter since this feature is disclosed as a particular advantageous improvement of the technical effect of the feature "A" present in claim 1.

Amendments and unsearched subject-matter



Agenda

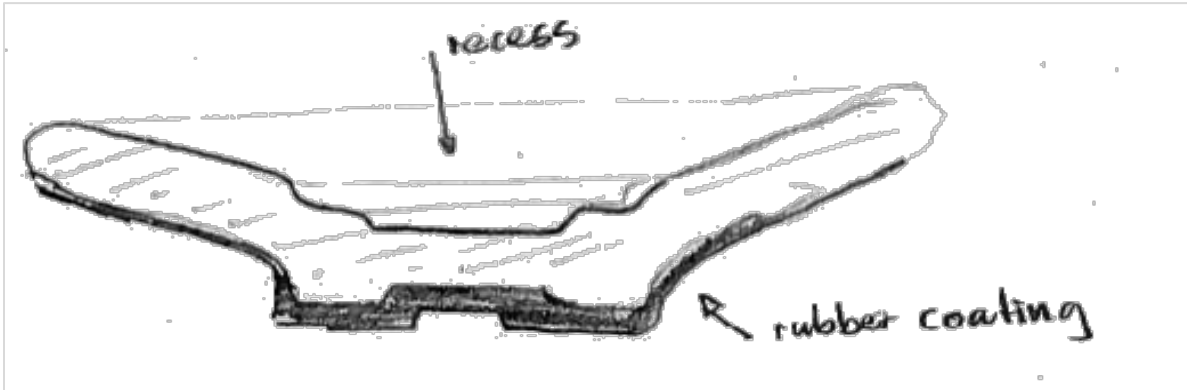
- ✓ Introduction
- ✓ Scenario "rubber saucer"
- ✓ Toolbox on Rule 137(5) EPC
 - **Scenario "anti-skid saucer"**
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Scenario "anti-skid saucer"



Scenario

Solution:



- ▶ **Problem:**
Provide saucer that can be used with cups of different sizes

Scenario "anti-skid saucer"



Scenario

Claim 1

Saucer having a plurality of concentric recesses

Description

Rubber coating on lower surface – no slipping on table

- ▶ **Problem:**
Provide saucer that can be used with cups of different sizes

Scenario "anti-skid saucer"



Scenario

Claim 1	A + B
Description	A + C (with C different effect from A or B)
EPO (search)	A + B not inventive
Amended claim 1	A + C
EPO (exam.)	Not admitted (R137(5)).

▶ Is objection justified?

yes no

▶ Justified.

The feature "C" is unrelated to the effects of the features of the originally claimed invention.

Amendments and unsearched subject-matter



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Amendments and unsearched subject-matter



Prevention and remedies

- **When drafting the application**
 - important features to be in the claims, preferably in "first branch".
 - indicate how feature contributes to technical effect of invention.
- **When filing amendment**
 - argue why the amended feature further defines a feature already present in the original claims and contributes to their effect.

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Conclusions

- A valid objection under Rule 137(5) EPC, first sentence, requires both conditions to be met:
"unsearched" AND "not single inventive concept"
- Unsearched feature (in claim/description) does not necessarily mean unsearched subject-matter in the sense of Rule 137(5) EPC

Rule 137(5) EPC

Amendments and unsearched subject-matter



Conclusions

- To avoid objection:
 - explain in the description the technical relationship of sub-features with regard to the inventive concept
 - order claims to present most important embodiments first.

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- ✓ Conclusions
- **Questions**

Questions



Questions

now

via chat to “All participants”

later

via mail → academy@epo.org