Examination Matters 2017 Webinars

Amendments and unsearched subject-matter

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Amendments and unsearched subject-matter

The presenters

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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
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
Scenario "rubber saucer"

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

solution:
Scenario "rubber saucer"

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>Claim 1</td>
<td>Saucer having a plurality of concentric recesses</td>
</tr>
<tr>
<td>Claim 2</td>
<td>... with the recesses in a stepped configuration</td>
</tr>
<tr>
<td>Description</td>
<td>Made of rubber – no slipping of cups ...</td>
</tr>
</tbody>
</table>

**Problem:**
Provide saucer that can be used with cups of different sizes
## Scenario "rubber saucer"

<table>
<thead>
<tr>
<th>Scenario</th>
<th></th>
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<tbody>
<tr>
<td>Claim 1</td>
<td>A</td>
</tr>
<tr>
<td>Claim 2</td>
<td>A + B</td>
</tr>
<tr>
<td>Description</td>
<td>C to improve A</td>
</tr>
<tr>
<td>EPO (search)</td>
<td>A not new</td>
</tr>
<tr>
<td>Amended claim 1</td>
<td>A + C</td>
</tr>
<tr>
<td>Amended claim 2</td>
<td>A + C + B</td>
</tr>
<tr>
<td>EPO (exam.)</td>
<td>Not admitted (R137(5)).</td>
</tr>
</tbody>
</table>

Do you think that this objection is justified?

☑️ yes  ❌ no
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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.
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."
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
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.
Toolbox – "single general inventive concept"

Further indicators: does added feature ...

- ... change the nature of the invention?
- ... fall under original general inventive concept?
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.
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
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✓ Toolbox on Rule 137(5) EPC
  - Scenario "anti-skid saucer"
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### Scenario "rubber saucer"

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<td>Description</td>
<td>A</td>
</tr>
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<td>EPO (search)</td>
<td>A</td>
</tr>
<tr>
<td>Amended claim 1</td>
<td>A + C</td>
</tr>
<tr>
<td>Amended claim 2</td>
<td>A + C + B</td>
</tr>
<tr>
<td>EPO (exam.)</td>
<td>Not admitted (R137(5))</td>
</tr>
</tbody>
</table>

- **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.
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Scenario "anti-skid saucer"

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

Solution:
Scenario "anti-skid saucer"

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

Claim 1
Saucer having a plurality of concentric recesses

Description
Rubber coating on lower surface – no slipping on table
Scenario "anti-skid saucer"

<table>
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<th>EPO (search)</th>
<th>Amended claim 1</th>
<th>EPO (exam.)</th>
</tr>
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<tbody>
<tr>
<td>Claim 1</td>
<td>$A + B$</td>
<td>$A + B$</td>
<td>$A + C$</td>
<td>Not admitted (R137(5)).</td>
</tr>
<tr>
<td>Description</td>
<td>$A + C$ (with C different effect from A or B)</td>
<td>$A + B$ not inventive</td>
<td></td>
<td></td>
</tr>
<tr>
<td>EPO (search)</td>
<td></td>
<td></td>
<td></td>
<td></td>
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<tr>
<td>Amended claim 1</td>
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<td></td>
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Is objection justified?  
☑️ yes  ☒ no

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

▪ Questions
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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
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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Questions

now via chat to “All participants”

later via mail ➔ academy@epo.org