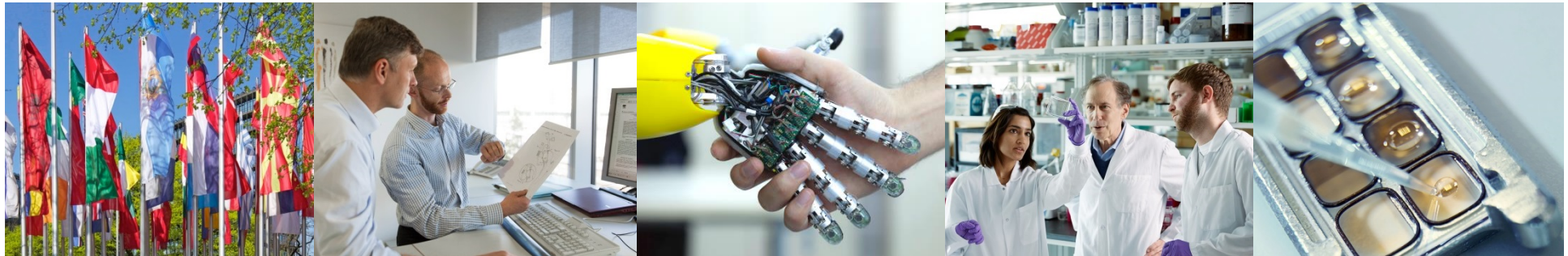




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Essential features



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Presenting today



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- § Studied aeronautical engineering at “La Sapienza” University in Rome and business administration at the Erasmus University in Rotterdam (master’s).
- § Joined the EPO in 1999.
- § Worked as an examiner in the area of big industrial machines and as a quality auditor.
- § Since June 2013, in Patent Procedures Management directorate, where he is entrusted mainly with the development of patent procedures and the co-ordination of the yearly review of the Guidelines.
- § Passed the EQE in 2006.



Essential features



Agenda

- § *What is an "essential feature"?*
- § Essential features and Art. 84 EPC
- § Essential features and Art. 56 EPC
- § Working example
- § Essential features and Art. 123(2) EPC

Essential features



What is an "essential feature"?

§ Meaning of the adjective *"essential"*:

"Absolutely necessary, indispensably requisite"
(Oxford English Dictionary – online version)

§ An *"essential feature"* is a technical feature necessary to carry out the invention disclosed in the application as filed (Guidelines F-IV, 4.5.2)

§ What is an "invention"?

Guidelines F-IV, 4.5.2

Essential features



What is an "invention"?

- § The EPC does not define what an invention is
- § The EPC requires the application to contain a description of the invention (Art. 78(1)(b)EPC), and the description to disclose the invention in such terms that the technical problem and its solution can be understood (Rule 42(1)(c) EPC)
- § An **"essential feature"** is a technical feature necessary for achieving the technical effect underlying the solution of the technical problem with which the application is concerned (Guidelines F-IV, 4.5.2)

Art. 78(1)(b)EPC
Rule 42(1)(c) EPC
Guidelines F-IV, 4.5.2

Essential features



Essential features in examination

Essential features are used in assessing if an application fulfils the requirements of:

Art. 54 EPC	Novelty
Art. 56 EPC	Inventive step
Art. 83 EPC	Sufficiency of disclosure
Art. 86 EPC	Clarity of claims
Art. 87 EPC	Right to priority
Art. 123(2) EPC	Extension of subject-matter

Art. 54 EPC
Art. 56 EPC
Art. 83 EPC
Art. 84 EPC
Art. 87 EPC
Art. 123(2) EPC

Essential features



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- § Essential features and Art. 56 EPC
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Essential features and Art. 84 EPC



Why Art. 84 EPC?

- § In the patent it needs to be defined a common understanding of what is the invention. The purpose primarily served by this provision is legal certainty.
- § In the EPC, the extent of the protection conferred by the patent or patent application is determined by the claims (Art. 69 EPC), which *"shall define the matter for which protection is sought"* (Art. 84 EPC, first sentence)
- § This matter must be presented in such a way that the claims *shall be clear and concise and be supported by the description* (Art. 84 EPC, second sentence)

Art. 69 EPC

**Art. 84 EPC,
first sentence**

**Art. 84 EPC,
second sentence**

Essential features and Art. 84 EPC



Art. 84 EPC and missing essential features (1)

- § Art. 84 EPC requires that the claims define the matter for which protection is sought; Rule 43(1) EPC requires that the matter is defined in terms of the technical features of the invention, i.e. the physical features which are essential to it (G 2/88, Reasons 2.5; G 1/04, Reasons 6.2)

- § Art. 84 requires the claims to be clear, i.e. to define clearly the object of the invention, i.e. to indicate all the essential features thereof (T 32/82, T 622/90)

Art. 84 EPC

Rule 43(1) EPC

G 2/88, Reasons 2.5

G 1/04, Reasons 6.2

T 32/82

T 622/90

Essential features and Art. 84 EPC



Art. 84 EPC and missing essential features (2)

- § The independent claims must contain all the essential feature of the invention (Rule 43(3) EPC)
- § This applies except insofar as such features are implied by the generic terms used (Guidelines F-IV, 4.5.4)
- § The requirement that an independent claim must contain all essential features of the invention is independent from any consideration of patentability of the same claim
- § An objection of "missing essential feature" can be raised by an examining division at its discretion also against claims that are not patentable

Rule 43(3) EPC
Guidelines F-IV, 4.5.4

Essential features and Art. 84 EPC



Objection "missing essential features"

- § This type of objection is discussed extensively in Guidelines F-IV, 4.5 to F-IV, 4.5.5
- § In reaction to such an objection the applicant can
 - either introduce the indicated features in the independent claim
 - or reformulate the objective technical problem to be solved by the invention
- § In the latter case, to be taken into account that the problem must be derivable from the application as filed (Guidelines G-VII, 5.2)

**Guidelines F-IV, 4.5
to F-IV, 4.5.5**

Guidelines G-VII, 5.2

Essential features



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Essential features and Art. 56 EPC



Art. 56 EPC and missing essential features

- § If the subject-matter of an independent claim does not solve the objective technical problem stated in the application, the claim lacks inventive step, because it does not solve anything
- § If an essential feature of the invention is missing, the above applies
- § In reaction to such an objection the applicant can
 - either introduce the indicated features in the independent claim
 - or reformulate the objective technical problem to be solved by the invention

Essential features and Art. 56 EPC



Art. 56 EPC and implicit features

- § Implicit features cannot on their own confer inventiveness to the subject-matter of a claim, since they and their application are obvious for the person skilled in the art
- § The same person skilled in the art assesses the fulfilment of the requirements of Art. 83 EPC and Art. 56 EPC (Guidelines G-VII, 3)
- § If an implicit feature fulfils the requirements of Art. 83 EPC because it is obvious for the person skilled in the art, it is obvious for the person skilled in the art also when assessing Art. 56 EPC

**Art. 83 EPC and Art. 56 EPC
(Guidelines G-VII, 3)**

Essential features



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Working example



Claim 1

Claim 1 reads:

"Bandsaw blade (1a) comprising a strip and teeth (1-9) projecting therefrom, which teeth (1-9) are arranged in recurring main groups, each main group comprising at least two recurring setting subgroups, characterized in that the overall set magnitude is the same for each one of the setting subgroups"

Does claim 1 contain all essential features of the invention?



yes no

Please tick

yes no

Working example



How to assess if all the essential features are present

- § What is the objective technical problem indicated by the applicant?
 - The purpose of the present invention is to create a bandsaw blade which is durable [*paragraph [0008]*]

- § Which technical features solve this problem based on the application?
 - The total set magnitude is the same for each one of the setting subgroups
 - The tooth heights and set magnitudes are inversely related

paragraph [0008]

Working example



Why? (1)

Do you agree with my assessment?



yes no

The feature "*the total set magnitude is the same for each one of the setting subgroups*" is present in claim 1 and hence by definition essential.

Do you agree?



yes no

Please tick

yes no

Working example



Why? (2)

Paragraph [0026]:

By the present invention the concept of low teeth being set heavier than high teeth is utilized. In this way the load applied against each tooth becomes more uniform, so that uniform abrasion occurs, the saw blade is more resistant to veering from a straight cut, and the life of the blade is extended.

Do you agree that the feature "*the tooth heights and set magnitudes are inversely related*" is indicated as making the blade durable?



yes no

paragraph [0026]

Please tick

yes no

Working example



Conclusion

- § Both features are indicated as making the blade durable and hence both need to be in claim 1

Is it possible to reformulate the problem so to make one of the features non-essential?



yes no

- § If yes please send the reformulated problem and on which paragraphs of the description it is based

Please tick

yes no

Working example



Further essential features (1)

Is the fact that the sub-group is made of three teeth an essential feature?



yes no

§ Please note that all examples have three teeth, and no other subgroup is presented

§ Paragraph [0010]: *"The said at least one recurring geometrical subgroup may be the same as the said recurring main group"*

Please tick

yes no

Working example



Further essential features (2)

- § Is the specific sequence of teeth an essential feature?
- § Is the fact that each third teeth is unset essential?
- § Is the fact that offset teeth are always in group of two with opposite setting essential?

Working example



Further essential features (3)

- § The answer to the previous questions depends on the factual technical effect due to the above technical features.
- For example the opposite setting keeps the saw balanced and hence reduces lateral forces.
 - The reduction of lateral forces makes the saw live long, i.e. makes it more durable
- § Of course the examining division must reason why a feature is essential and the applicant can object to it

Essential features



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Essential features and Art. 123(2) EPC



Removal of a feature from an independent claim

In case of removal or replacement of a feature from a claim, the requirements of Art. 123(2) EPC are only met if the subject-matter remaining in the claim

§ lies within the limits of what a skilled person would derive directly and unambiguously from the whole of the application documents,

§ using common general knowledge, and

§ seen objectively and relative to the date of filing

G 3/89, G 11/91 and G 2/10

G 3/89, G 11/91 and G 2/10

Essential features and Art. 123(2) EPC



Removal of an essential feature from a claim

- § The subject-matter remaining in the claim cannot by definition solve the objective technical problem stated in the application
- § The remaining subject-matter solves a new objective technical problem and hence defines a new invention
- § Unless the new objective technical problem is derivable directly and unambiguously from the application as filed, the person skilled in the art could not have foreseen that the remaining subject-matter constitutes an invention
- § The amendment does not fulfil the requirements of Art. 123(2) EPC

Art. 123(2) EPC

Essential features and Art. 123(2) EPC



Essentiality test

- § Described in Guidelines H-V, 3.1
- § Compliance with the essentiality-test does not necessarily mean that the requirements of Art. 123(2) EPC are fulfilled
- § The essentiality test only indicates whether the replacement or the removal of a feature contravenes the provisions of Art. 123(2) EPC. It does not indicate whether the amendment complies with the provisions of Art. 123(2) EPC

Guidelines H-V, 3.1
Art. 123(2) EPC

Essential features and Art. 123(2) EPC



Example

§ Let's assume:

1. Application as filed discloses embodiments with a combination of two features and embodiments without both features
2. The claim as filed contained both features
3. The applicant during prosecution deletes only one of the two features

§ The essentiality test is passed.

- However an embodiment with only one of the two features cannot be derived directly and unambiguously from the application as filed

The amendment **does not fulfil** the requirements of Art. 123(2) EPC



Art. 123(2) EPC

Questions



Questions

now

via chat to "All participants"

later

via mail è academy@epo.org

**Question & answer
session**