Guidelines 2019
Summary of main changes in examiner procedures
Types of amendments in the Guidelines 2019

- **Revised practice**
  Revised procedures where the timing of the change in procedure coincides with the revision timeline; therefore few cases

- **Clarifications**
  Amendments resulting from external/internal user comments, more explanation regarding misunderstood or incomplete statements

- **Incorporating case law**
  Information from Board of Appeal decisions published since the last revision which are found to complement the information in the GL

- **Aligning the text with current procedures**
  Brought in line with the procedural changes which took place since the previous revision (changes published in OJ Notices)
### Overview of updates relevant for examiner procedures

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Overview of updates relevant for **examiner** procedures

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Novelty of sub-ranges in selection inventions 1/3

Former versions of G-VI, 8 (ii), developed based on T 198/84 and T 279/89, listed three criteria for considering a sub-range selected from a broader numerical range of the prior art novel:

(a) the selected sub range is narrow compared to the known range;

(b) the selected sub range is sufficiently far removed from any specific examples disclosed in the prior art and from the end points of the known range;

(c) the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new technical teaching).

Revised practice

Case law

G-VI, 8
G-VII, 12

→ Art. 54 EPC
Novelty of sub-ranges in selection inventions 2/3

The validity of the criterion (c) was questioned in a sequence of T decisions from various Technical Boards of Appeal over a course of years.

In the majority of the more recent jurisprudence, the view was expressed that the criterion (c) went beyond the comparison of the invention defined in the claims with the disclosure of the prior art, because it considered the presence of an effect of the claimed invention. Whether the claimed selection was purposive or not was thus more a question of inventive step than of novelty.

Examples: T 1233/05, T 230/07, T 492/10, T 1130/09, T1999/11, T 673/12, T 1409/12, T 1948/10, T 378/12, T261/15, T 305/16
Novelty of sub-ranges in selection inventions 3/3

Following this series of decisions, criteria (iii) regarding that the selected range is a purposive selection is no longer required for establishing novelty of a sub-range selected from a broader numerical range of the prior art.

The requirement for a sub-range to represent a purposive selection is a matter of inventive step and is not necessary for establishing novelty.

When analysing novelty of a sub-range, only the following two criteria have to be considered:

a) whether the selected sub-range is narrow compared to the known range;

b) whether the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end points of the known range.

Revised practice

Case law

G-VI, 8
G-VII, 12

→ Art. 54 EPC
Deletion of alternatives from more than one list

The deletion of alternatives from more than one list is only allowable if this does not result in the creation of new technical information that is not directly and unambiguously derivable from the application as originally filed.

Limitations that do not result in the singling out of a particular combination of specific features but maintain the remaining subject-matter as a generic group which differs from the original group only by its smaller size will normally fulfil the requirements of Art. 123(2).

Former restrictive wording based on T 12/81 is replaced with the criteria defining when it is allowable to delete alternatives from more than one list in line with recent jurisprudence.
Combination of specific features

An amendment leading to a combination of specific features may be allowable if the application as filed provides a pointer towards that particular combination, e.g. by reference to preferred embodiments.

These principles also apply to the combination of features resulting from dependent claims.

An example modified from case law is added to illustrate a case where a combination defined in an amended dependent claim is not allowable.
Unpublished document cited in the application

- The application cites a document not accessible to the search division; and
- The document is essential to a correct understanding of the invention and for a meaningful search

Search division issues an invitation under Rule 63

The rest of the procedure depends on applicant’s reply, which may be one of the following:
- submit a copy of the document
- argue that the document is not essential for a meaningful search
- indicate a part of the application to be searched for which the document is not essential

Clarification

B-IV, 1.3

→ Rule 63 EPC
Broad claims and Rule 63 invitation

- Broadness of a claim alone is not a reason for limiting the search

- Broadness may render a meaningful search impossible only if at least part of the scope of the claim is speculative, i.e. not supported by the disclosure of the application

- Rule 63 invitation is sent for such claims lacking sufficiency of disclosure and support (Art. 83 and 84)

- This may result in limiting the search only to (one or more of) the specific examples disclosed
Non-unity and the right to be heard

When raising a finding of lack of unity or upholding an earlier one objected by the applicant on the basis of unconvincing reasons, the examining division invites the applicant to limit the application.

The amended text clarifies that:

- The applicant may contest the finding of non-unity that is raised for the first time in examination
- The applicant’s right to be heard must be respected by communicating why the arguments are not convincing and why the non-unity objection is upheld
Excluding non-patent literature from file inspection

The opposition division accepts a party’s request not to make a non-patent literature document available via file inspection for reasons of copyright only if both are true:

- the non-patent literature document is easily retrievable (including against payment); and
- the copyright owner is not a party to the proceedings

- A scientific article is usually easily retrievable
- A company brochure is not; the request is refused if the copyright is owned by a party
- The page covering bibliographic details (normally the cover page) will always appear in file inspection
Definition of “late-filed” for grounds, facts and evidence

Any ground, fact and evidence filed by the opponents after the expiry of the opposition period are considered as late-filed unless they are due to a change in the subject of the proceedings.

The parties in inter partes cases are subject to a particular duty to facilitate due and swift conduct of the proceedings.

Clarification

D-VI, 1
Case Law book IV.C.4.3

→ Art. 114(2) EPC
Late submissions

- The divisions have a discretion to disregard new facts or evidence filed after the date indicated in the summons under Rule 116 (unless the subject of the proceedings has changed).
- The possibility of abuse of the procedure is also considered before admission.
- An example of abuse is where opponent knowingly abstains from raising an assertion of public prior use, based on its own activities, until late in the proceedings, even though the evidence in its support had become fully available earlier.

Amended text clarifies that only active and intentional withholding of information could qualify as abuse of proceedings.
Oral proceedings

The following clarifications have been added related to oral proceedings:

≥ A decision to refuse postponement of oral proceedings must be reasoned – E-III, 7.1.1

≥ If the a request to hold the oral proceedings by videoconference is refused, the reasons must be given in the summons to oral proceedings or in a separate communication (if the request arrived after the summons) – E-III, 11.1.1
Information on maintenance of oral proceedings

In examination proceedings
If oral proceedings are not cancelled following the submissions from the applicant,
} the division informs the applicant that the date and time set for the oral proceedings are maintained.
Oral proceedings held by video conference

The date, time and the videoconference contact details to be used to establish the connection will be communicated by the formalities officer by means of a written communication, fax or email.

At the time so arranged, it is the applicant who has to establish the connection with the EPO.

Updated procedure resulting from the decommissioning of ISDN technology
Drafting decisions – Form and Content

- The order (or "operative part") of the decision must clearly state
  - the request of the parties, and
  - the extent to which this request is met.

- A ruling to allow a separate appeal must be part of the order of the decision.

Case law

E-X, 1.3.1

T 756/14

→ Art. 113(1); Rule 111(2) EPC
What is meant by "claim-like clauses"

- Clauses in the description which use claim language
  Examples:
  - "according to the preceding clause"
  - "characterised in that"
- Usually at the end of the description and/or
- In the form of numbered paragraphs

} These clauses must be deleted prior to grant.
Characterisation of a product by parameters 1/2

Where a product is characterised by parameters, the following requirements must be met:

(i) the claims must be clear in themselves when read by the skilled person (not including knowledge derived from the description);

(ii) the method for measuring a parameter (or at least a reference thereto) must appear completely in the claim itself; and

(iii) the applicant must ensure that the skilled person can easily and unambiguously verify whether they are working inside or outside the scope of the claim.

Case law

F-IV, 4.11
T 849/11
Case Law book II.A.3.5

→ Art. 84 EPC
Requirement (ii) can be met if it can be convincingly shown that:

a) the measurement method to be employed belongs to the skilled person's common general knowledge

b) all the measurement methodologies known in the relevant technical field for determining this parameter yield the same result within the appropriate limit of measurement accuracy

– T 849/11 summarises the case law about parameters in a clear and concise manner and therefore formed the basis for the new text of F-IV, 4.11.
– The content of former F-IV, 4.18 is also incorporated into F-IV, 4.11.
– The information about unusual parameters is moved to a new section F-IV, 4.11.1.
Unusual parameters

An unusual parameter may have been employed:
(i) in place of other generally recognised parameters
(ii) to measure a property that was not measured before

β Unusual parameters employed in situation (i) are *prima facie* objectionable if
   - no straightforward conversion to the generally-recognised parameter is possible, or
   - a non accessible apparatus for measuring the unusual parameter is used

β An example is added to illustrate an allowable unusual parameter employed in situation (ii).
Product claim with process features

<table>
<thead>
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<th>A claim to a product comprising both</th>
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<td>• product features and</td>
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<tr>
<td>• features for a process to manufacture the product</td>
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- Does not contravene the requirements of Art. 84 per se.
- The process features can establish the **novelty** of the claimed product only if they cause it to have different properties from known products.
- The burden of proof for an allegedly distinguishing "product-by-process" feature lies with the applicant.
Interpretation of expressions stating a purpose (1/2)

Separate sections are introduced to explain the limitations defined by statements of purpose:

β "Apparatus for", "product for"
β "Means for"
β "Method for"

Examples are provided for means-plus-function features

→ Art. 84, 54 and 56 EPC
Interpretation of expressions stating a purpose (2/2)

For a method claim, a distinction is made between two types of statements of purpose:

(i) stating the application or use of a method
(ii) stating a technical effect arising inevitably from the remaining steps of the method and is thus inherent in those steps

The purpose statement in (i) requires additional steps which are not implied by or inherent in the other remaining steps, and without which the process would not achieve the purpose → limiting

The purpose statement in (ii) does not limit the subject-matter of the claim; it is implicit from the method steps

Case law

Clarification

F-IV, 4.13.3
(new section)

T 1931/14

→ Art. 84, 54 and 56 EPC
Terms in mathematical methods

β If terms in mathematical methods are used in significantly different ways (within the application or prior art documents), this may be an indicator that the terms have no well-recognised meaning and render the claimed subject-matter unclear (for an example, see §6-9 in T1565/17).

β Further, these unclear terms, due to their abstractness, might lead to a finding of lack of technical character of related features (for an example, see §15 in T1565/17).

An objection of a lack of clarity of a term requires reasoning. This can be done by indicating the different senses in which the term is used.
Technicality and computational efficiency in CII

- A technical effect may be established by a mathematical method when it is applied to a field of technology and/or adapted to a specific technical implementation.
- The computational efficiency of the steps affecting such an already-established technical effect also contributes to the technical character of the invention.
- The same applies to the computational efficiency of an algorithm affecting an already-established further technical effect of a computer program.

If a computer-implemented mathematical method serves a non-technical purpose (e.g. “for calculating fees”) by a generic technical implementation (e.g. “using a processor”), the argument that the mathematical method steps are more efficient than prior-art mathematical methods is not sufficient to establish a technical effect.
Exclusions of plant and animal varieties

For living matter to be patentable, it must be possible to reproduce it in a way that has exactly the same technical features [G-II, 5.4].

Controlled hybrids with inbred parents are excluded from patentability under Article 53(b), as they define either a seed or a plant which necessarily belongs to a particular plant grouping within the meaning of plant variety pursuant to Rule 26(4) [G-II, 5.4.1].

A claim cannot escape the exclusion of plant varieties under Article 53(b) by consisting of a large number of varieties, not even if there are hundreds of them. Only if the subject-matter of the claim comprises at least one embodiment which does not constitute a variety is the claim allowable under Art. 53(b) (see T 1208/12) [G-II, 5.4.1].

Self-fertilization (selfing) of a transgenic plant is also excluded from patentability, as selfing, like crossing, is the mixing of entire genomes [G-II, 5.4.2].

The abbreviation NBT stands for “new breeding techniques” and has no relevance in terms of patentability [G-II, 5.4.2].
Assessment of obviousness

Could/would approach
- "Expectation" of improvement or advantage
- Reference to "hope" is removed

In the field of biotechnology
- Obvious is if the skilled person would have followed the teaching of the prior art with a "reasonable expectation of success"
- Not obvious if non-trivial decisions are required (with the "hope to succeed")

"Expectation of success" is not to be confused with the "hope to succeed"

Clarification:
- G-VII, 5.3
- G-VII, 12
- G-VII, 13 (new section)

→ Art. 56 EPC
Amendment procedure by filing replacement pages

- Where whole paragraphs have been added or deleted, it is not necessary to renumber the paragraphs throughout the entire application or patent.

- If handwritten amendments are filed during OPs in opposition, the proprietor is invited in a Rule 82(2) communication to submit replacement paragraphs and/or claims only, and not replacement pages.

No need for paragraph re-numbering for the printing copy.
Questions

now  via chat

later  via email  patentlaw@epo.org