Examination Matters 2019 – webinar series

Clearing the path to examination –
How to overcome clarity issues efficiently

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Clearing the path to examination

How to overcome clarity issues efficiently

Using adaptive search strategies to optimise the time and quality of a search.

- During EPO examination proceedings (pre-grant)
- During EPO opposition proceedings (post-grant)
Presenting today

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Clearing the path to examination – How to overcome clarity issues efficiently

Agenda

- Clarity at the examination stage
- Clarity at the opposition stage
- Bonus Question
Clarity at the examination stage

Legal Background

Art. 84 EPC

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

It ensures legal certainty.
Clarity at the examination stage

Legal Background (2)

Legally it is of vital importance to know the exact meaning:

Let's eat, children!

Let's eat children!
Clarity at the examination stage

Some General Principles

- Claims should be clear in themselves
- Claims are supported by description
- No contradicting claims

Clear Scope of Protection
Clarity at the examination stage

Clear in themselves (1)

Words should be given the meaning and scope which they normally have in the relevant art ("to be read with an attempt to make technical sense out of it")

But if the description gives the words a special meaning, the meaning has to be clear from the wording of the claim alone.
Clarity at the examination stage

Clear in themselves (2)

Chemical composition comprising an *organic* compound ...

Q: What is the correct interpretation here?

A: Natural, organic labelled food
B: Carbon containing molecule
C: Living matter
**Clarity at the examination stage**

**Essential features**

**Example:**

<table>
<thead>
<tr>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>ß Plurality of concentric recessed portions […]</td>
</tr>
<tr>
<td>ß Problem = allowing to receive and firmly hold cups having different diameters</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Claim 1</th>
</tr>
</thead>
<tbody>
<tr>
<td>Saucer, wherein at least one concentric recessed portion is provided …</td>
</tr>
</tbody>
</table>

} Q: Which essential feature is missing here?

EPC Guidelines, F.IV, 4.5
## Clarity at the examination stage

### Essential features

**Example:**

<table>
<thead>
<tr>
<th>Description</th>
<th></th>
</tr>
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<tbody>
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<table>
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<tr>
<th>Claim 1</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Saucer, wherein a <strong>plurality of</strong> concentric recessed portions <strong>are</strong> provided...</td>
<td></td>
</tr>
</tbody>
</table>
Clarity at the examination stage

Result to be Achieved (RtbA)

Example

"Ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray"

Acceptable,

- if it is not possible to define more precisely AND
- if the result can be directly verified by routine test procedures
Clarity at the examination stage

Functional features

Example

"Terminal position detecting means"

Acceptable,

- if the skilled person would appreciate that other means could be used for the same function
- if application does not convey impression that a function is to be carried out in a particular way
Clarity at the examination stage

**RtbA vs Functional feature**

**Example:**

"An implanted heart device, comprising premature contraction exclusion means that excludes from the heartbeats those heartbeats that relate to premature contractions"

} Q: Is this RtbA or Functional feature?

Please select

• for RtbA or

" for Functional Feature."
Clarity at the examination stage

RtbA vs Functional feature

Example:

"An implanted heart device, comprising premature contraction exclusion means that excludes from the heartbeats those heartbeats that relate to premature contractions"

Different criteria so not just an academic discussion ...
Clarity at the examination stage

Claims that contradict each other

<table>
<thead>
<tr>
<th>Q: Can you find the contradiction here?</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Claim 1</strong></td>
</tr>
<tr>
<td><strong>Claim 7</strong></td>
</tr>
</tbody>
</table>
Clarity at the examination stage

Claims that contradict each other

Q: Can you find the contradiction here?

<table>
<thead>
<tr>
<th>Claim 1</th>
<th>A method for contactless measurement of soil properties, including its structure and the surface profile, using a radar and a lidar to provide signals, which signals are later analysed by a computer that builds a model of the soil.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Claim 7</td>
<td>The method of claim 1 further comprising a mechanical penetrating probe, able to measure the electrical resistance of the soil at different depths.</td>
</tr>
</tbody>
</table>
Clarity at the examination stage

Support by / Adaptation of description

**Claim**  "Surgical stapler ... with feeder shoe **bent along its longitudinal axis**"

A) its longitudinal axis is bent

B) the bend extends along the longitudinal axis of the feeder shoe

Q: What is the correct interpretation?
Please select 
• for A) or 
" for B)
Clarity at the examination stage

Clarity and Cll

4 types of claim formulations are acceptable in one application:

- method; apparatus; computer program; computer readable medium.

"A processor comprising means for ..."

to be interpreted as means adapted to carry out these steps/funcions; not as merely suitable for carrying them out.
Clarity at the examination stage

Clarity and CII (2)

But when **not all method steps can be executed on a generic computer** (e.g. medical devices, measuring, optics, electro-mechanics, industrial production processes):

possible **Article 84 EPC** (lack of essential features).
Clarity at the examination stage

Clarity and CI (3)

1. A method of determining oxygen saturation in blood in a pulse oximeter, comprising....

2. A pulse oximeter having an electromagnetic detector and means adapted to execute the steps of the method of claim 1.

3. A computer program comprising instructions to execute the steps of the method of claim 1.

Q: Is there a clarity problem?
Clarity at the examination stage

Clarity and CII (3)

1. A method of determining oxygen saturation in blood in a pulse oximeter, comprising....

2. A pulse oximeter having an electromagnetic detector and means adapted to execute the steps of the method of claim 1.

3. A computer program comprising instructions to cause the device of claim 2 to execute the steps of the method of claim 1.

Art. 84 without this statement; this program would not work on my PC
Clarity at the examination stage

Clarity and CII (4)

β Artificial Intelligence: Black Box?

β Example:

Determining the IQ of a person by means of a neural net trained on images of fingerprints

β Art. 84 EPC? Art. 83 EPC? Art. 56 EPC?
Clarity at the examination stage

Exercise

Q: How many clarity problems do you spot here?

A communication between a remote device and a radiation level detector in a cell phone, the radiation level detector comprising

- a flux capacitor,
- a sensor element and a handle located on about the middle part of it, and
- a processor compressing the measured data yielding better quality than .zip compression
Clarity at the examination stage

Exercise

Q: How many clarity problems do you spot here?

A communication between a remote device and a radiation level detector in a cell phone, the radiation level detector comprising

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- Clarity at the opposition stage
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Clarity at the opposition stage

Clarity in Opposition?

Clarity can be of importance after grant insofar as the claims:

(1) get amended; and...

(2) remain unchanged.
Clarity at the opposition stage

Claims are amended (1)

Art. 101 EPC:

(3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the European patent during the opposition proceedings, the patent and the invention to which it relates

(a) meet the requirements of this Convention, it shall decide to maintain the patent as amended, …;

(b) do not meet the requirements of this Convention, it shall revoke the patent.

Including Art. 84 EPC
Clarity at the opposition stage

Claims are amended (2)

The Opposition Division will only examine clarity if

1. features are taken from the description and inserted into a granted claim by way of amendment; or

2. a feature from a dependent claim as granted is introduced into an independent claim as granted and this feature was previously connected with other features of that dependent claim and an alleged lack of compliance with Art. 84 is introduced by the amendment.
Clarity at the opposition stage

Claims are amended (3)

Real case, what if:

1. During the OPs it was established that product claim 1 as granted is not novel. Independent method claim 7 is however novel;

2. Patentee files auxiliary request 1, in which he amends claim 1 with features taken from the description; and

3. Opponent objects to independent claim 7 on lack of clarity.

Q: Can this objection be admitted?

Please select " for A) or " for B)
Clarity at the opposition stage

Claims are amended (4)

According to G 3/14, the amendment of one claim or part of a patent cannot lead to a re-examination of other parts of the patent which have not been amended.

Only if the clarity problem has been caused by the amendment an Art. 84 EPC objection can be raised.

Of course, there is always a grey area, i.e. when not amended dependent claims can be affected by an amendment on the independent claim (the new features introduce a contradiction?).
Clarity at the opposition stage

Claims remain unchanged (1)

Q: Is a clarity objection possible?

} No, but if the granted claim didn’t comply with the requirements of Art. 84 EPC, the lack of clarity may still be of relevance in opposition proceedings if it influences any decision taken under Art. 100 EPC.
Clarity at the opposition stage

Claims remain unchanged (2)

Examples according to G 3/14 for a profound effect of Lack of Clarity on the Outcome of grounds for opposition under:

(i) Art. 100 (b) / Art. 83 EPC (Lack of Sufficiency)
   T 684/89, reasons 2.1.2; T 5/99 reasons 2; T 126/91, reasons 2.1; T 59/10, reasons 4

(ii) Art. 100 (a) / Art. 54 EPC (Lack of Novelty)
    T 57/94, reasons 2.1; T 525/90, reasons 2.1; T 892/90, reasons 2; T 617/92, reasons 2.2

(iii) Art. 100 (a) / Art. 56 EPC (Lack of Inventive Step)
    T 892/90
Reversible plough (1) having a plough frame and having [...] plough bodies (6), [...] and/or similar functional plough parts [...] fastened to the plough frame (2) by way of mounts (7), wherein the mounts (7, 24) of functional parts are screwed to one [...] or two side walls of the plough frame (2), [...] characterized in that the wall regions of the plough frame (2), which in the operating position of the plough adjoin one side wall or side walls and point towards the soil and point away from the soil, are configured so as to be free of mounts (7, 24) of functional parts.
Clarity at the opposition stage

Claims remain unchanged (4)

Document D1 (cited in examination) was also used by the opponent as novelty destroying:

Q: Are the screw and nut (part of) the mount or fastening means?

Please select for A) or for B)
Clarity at the opposition stage

- Examiner considered that the screw and nut were part of the mount, and therefore granted the application;

- Opponent used the same document for novelty objection, stating that the screw and nut were simply the fastening means of the mount, and not part of the mount itself;

- Both interpretations were possible
  - Ambiguity lead to unclear scope of protection!

- Opposition division agreed with opponent.
Clearing the path to examination – How to overcome clarity issues efficiently

**Agenda**

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- Clarity at the opposition stage
- **Bonus Question**
Bonus Question

Q: How would you phrase the test for checking whether the claimed subject-matter is clear?

} The subject-matter of the claim is clear if .........
Questions

now via chat

later via mail academy@epo.org