



Auxiliary requests – when and how?

Practical cases

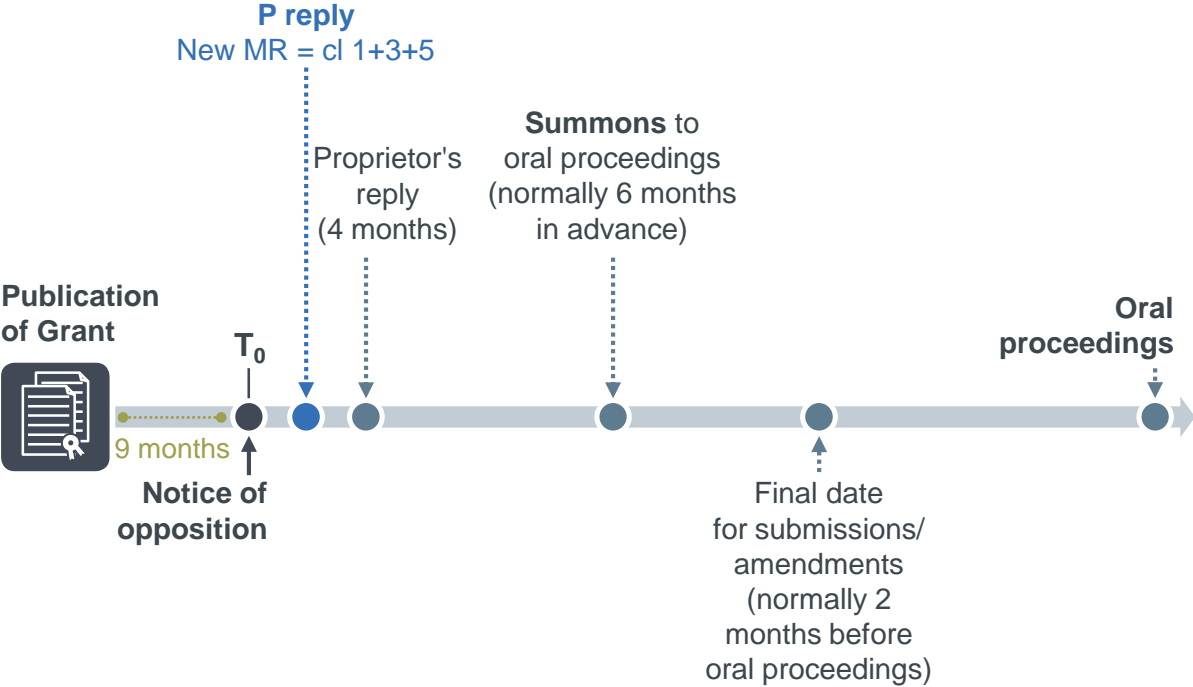
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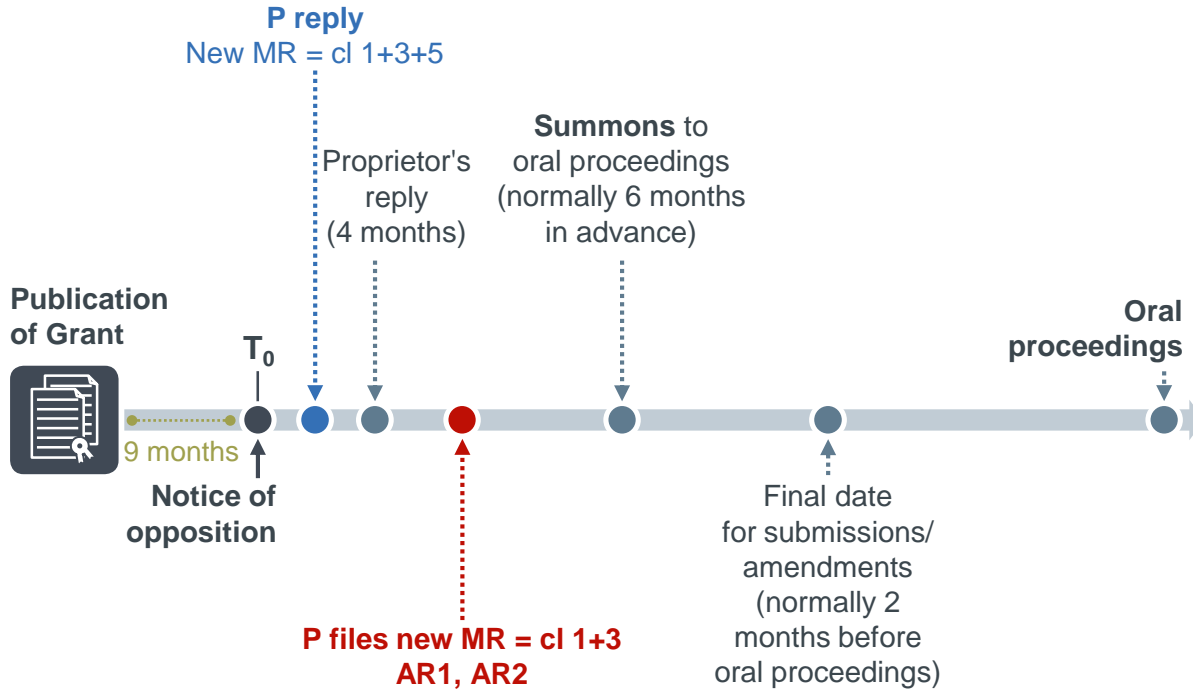
Case 1

- In reply to a NoO, P files a new MR combining granted claims 1+3+5
 - P realizes that the new MR is too restrictive and that broader claims may be allowable
 - P files the following AR:
 - new MR = cl 1+3
 - AR1 = cl 1+5
 - AR2 = cl 1+3+5
- How will the OD react? Will the OD consider the MR as a late filed request? What about AR1?

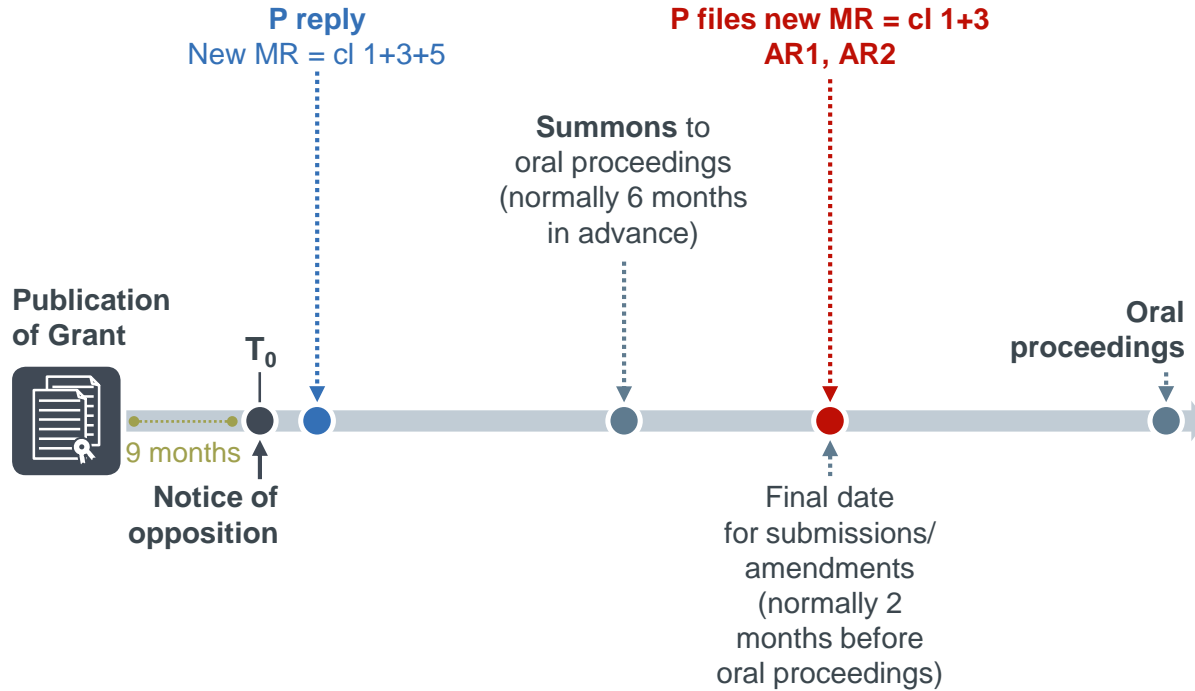
Case 1



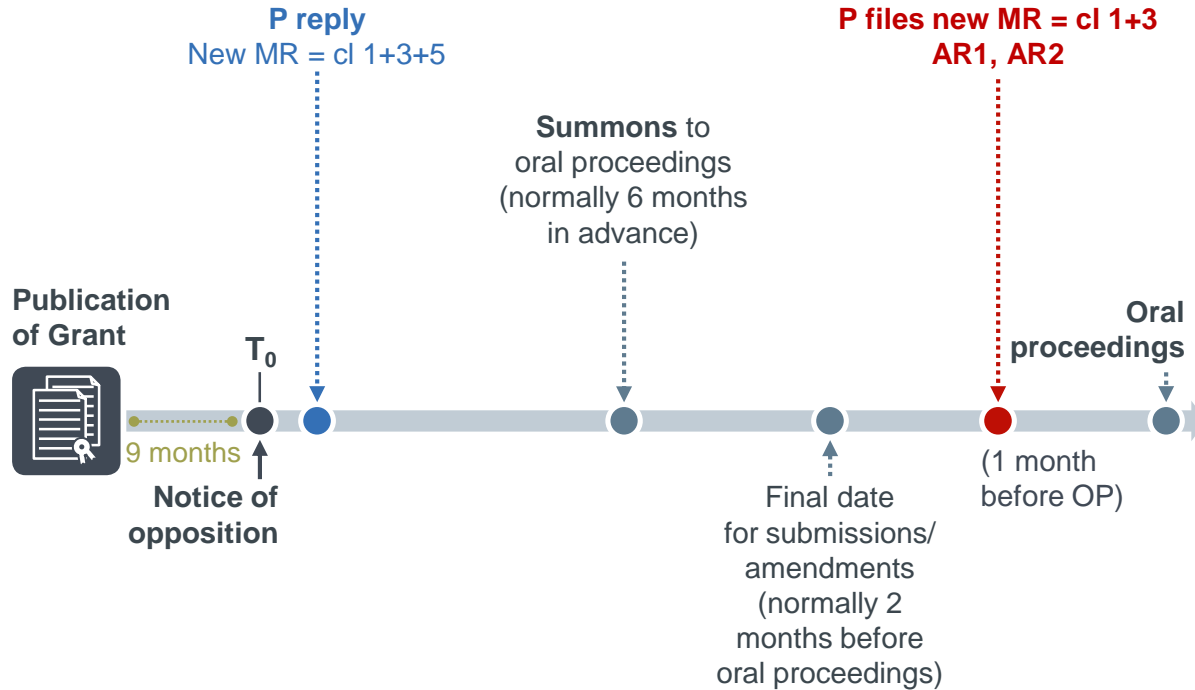
Case 1a



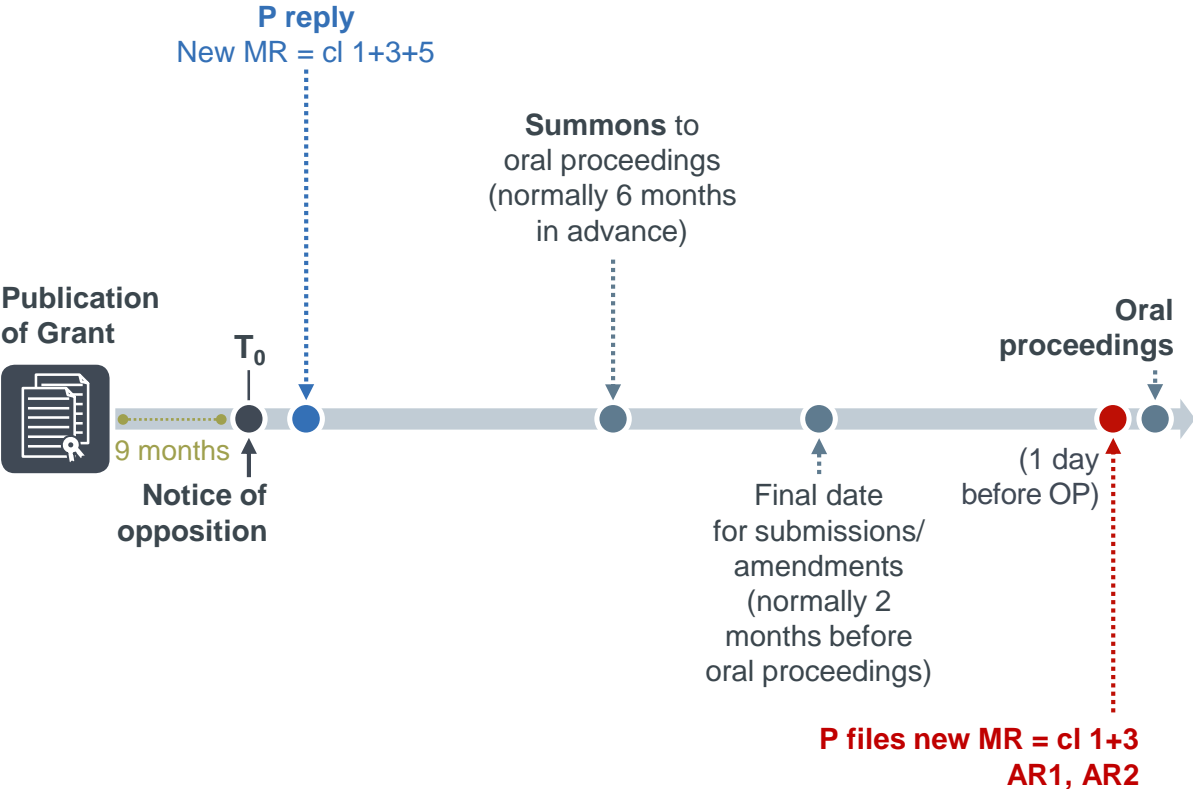
Case 1b



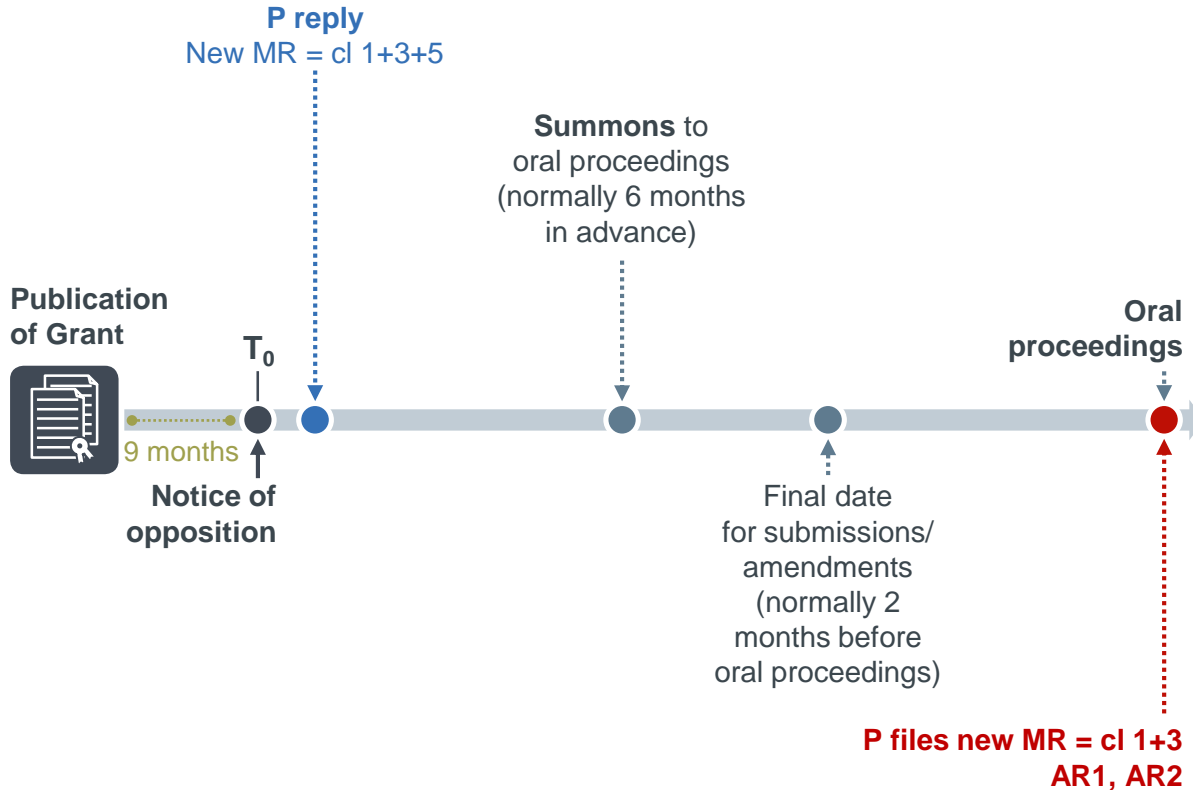
Case 1c



Case 1d



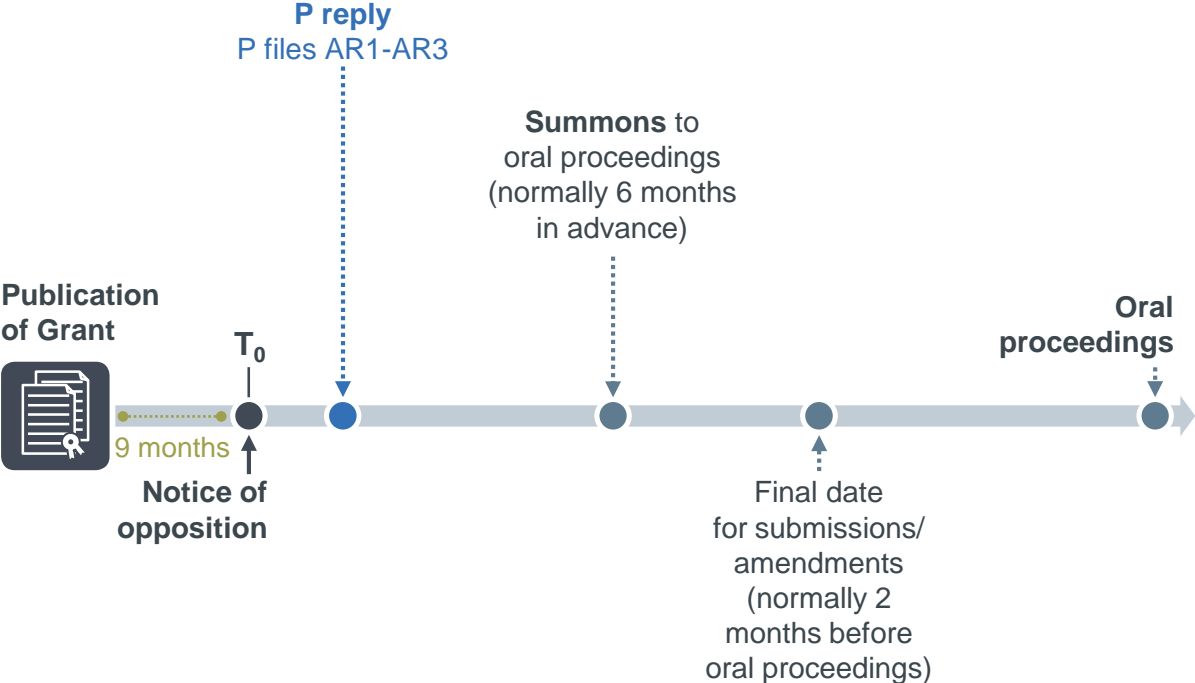
Case 1e



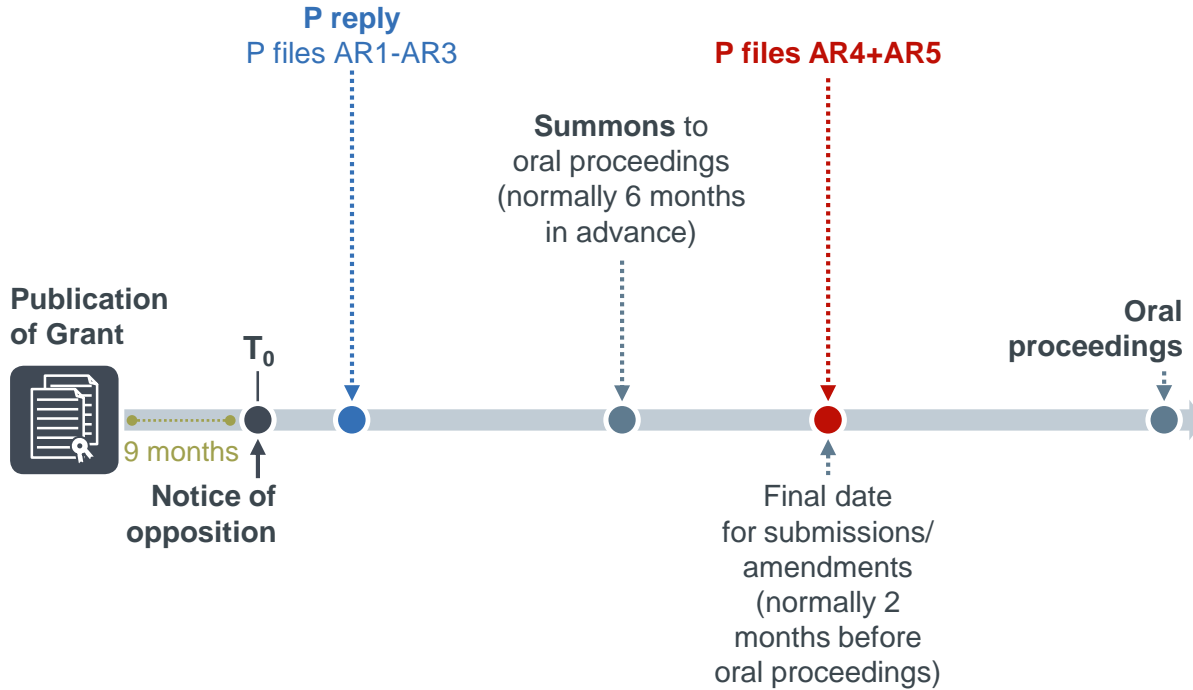
Case 2

- In reply to a NoO, P files several AR combining granted claims
 - AR1 = cl 1+3
 - AR2 = cl 1+3+5
 - AR3 = cl 1+3+5+7
 - Preliminary opinion from the OD: all AR are novel, but seem not inventive
 - In preparation for R116 and OP, P realizes that would be easier to defend IS with another combination of features and changes strategy by filing 2 additional AR
 - AR4 = cl 1+2
 - AR5 = cl 1 + feature taken from the description
- How will the OD react? Will the OD consider the AR as late filed requests?
 - Will the reaction of the OD be the same if the new strategy implies the selection of a different document as the closest prior art?

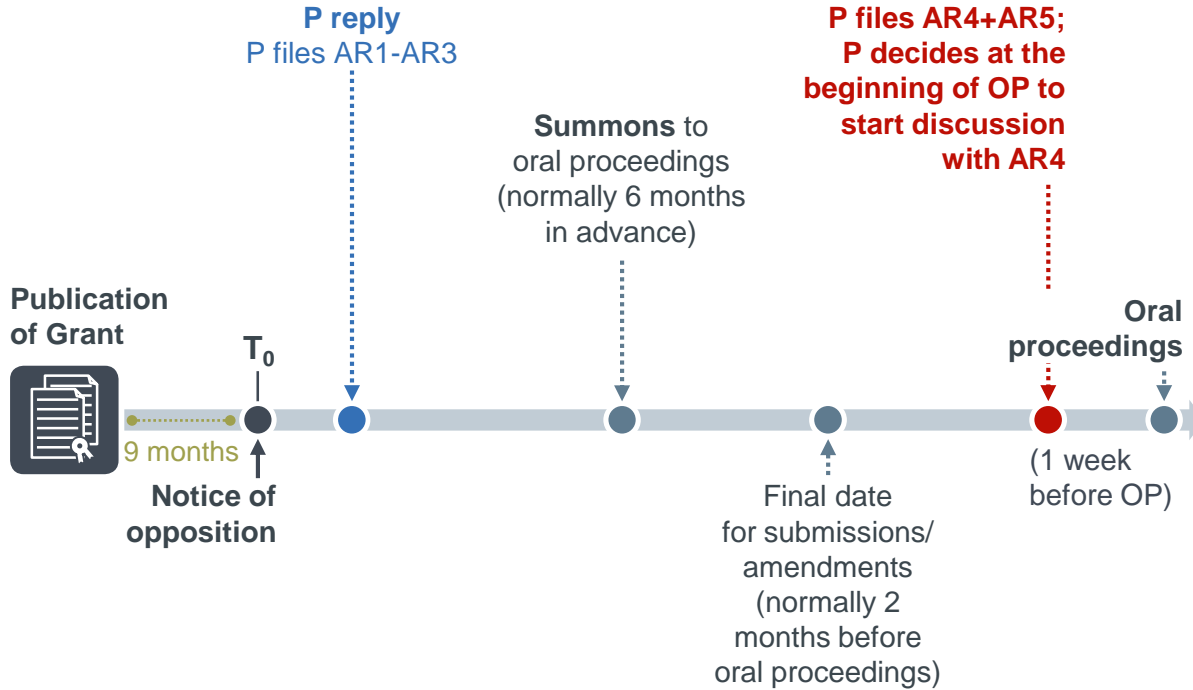
Case 2



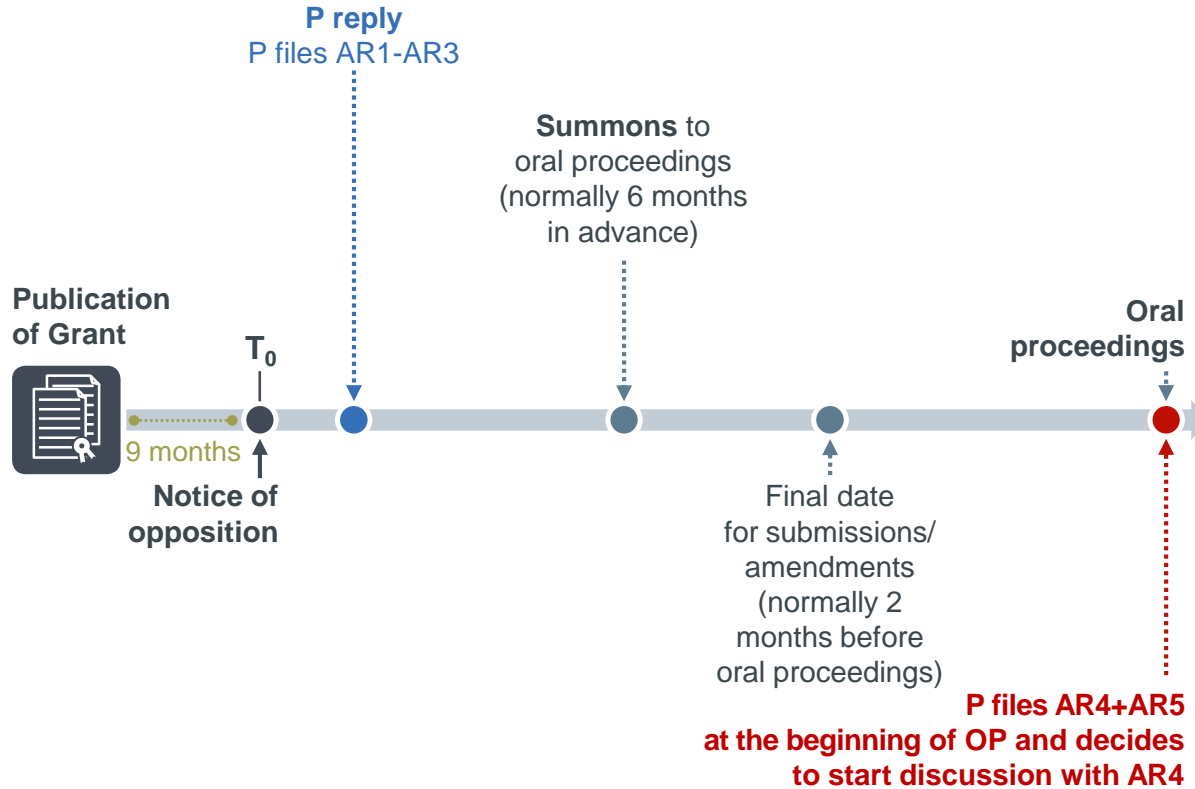
Case 2a



Case 2b



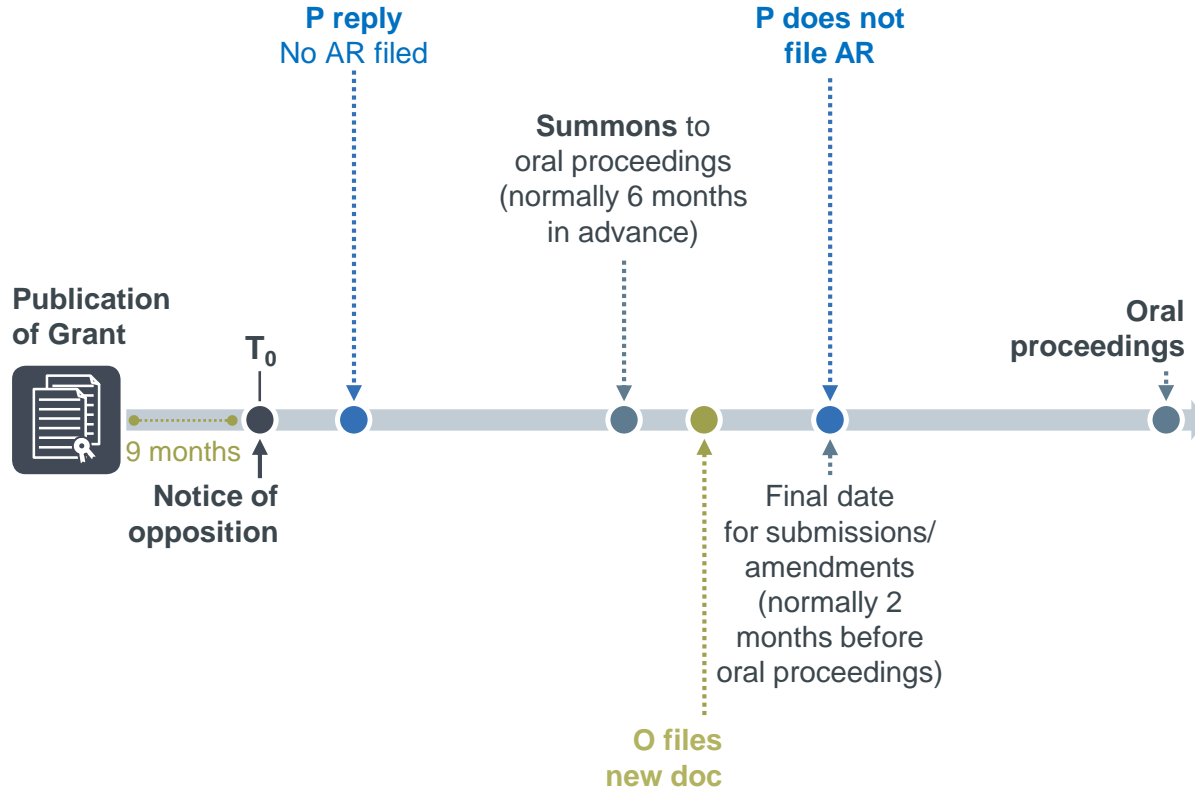
Case 2c



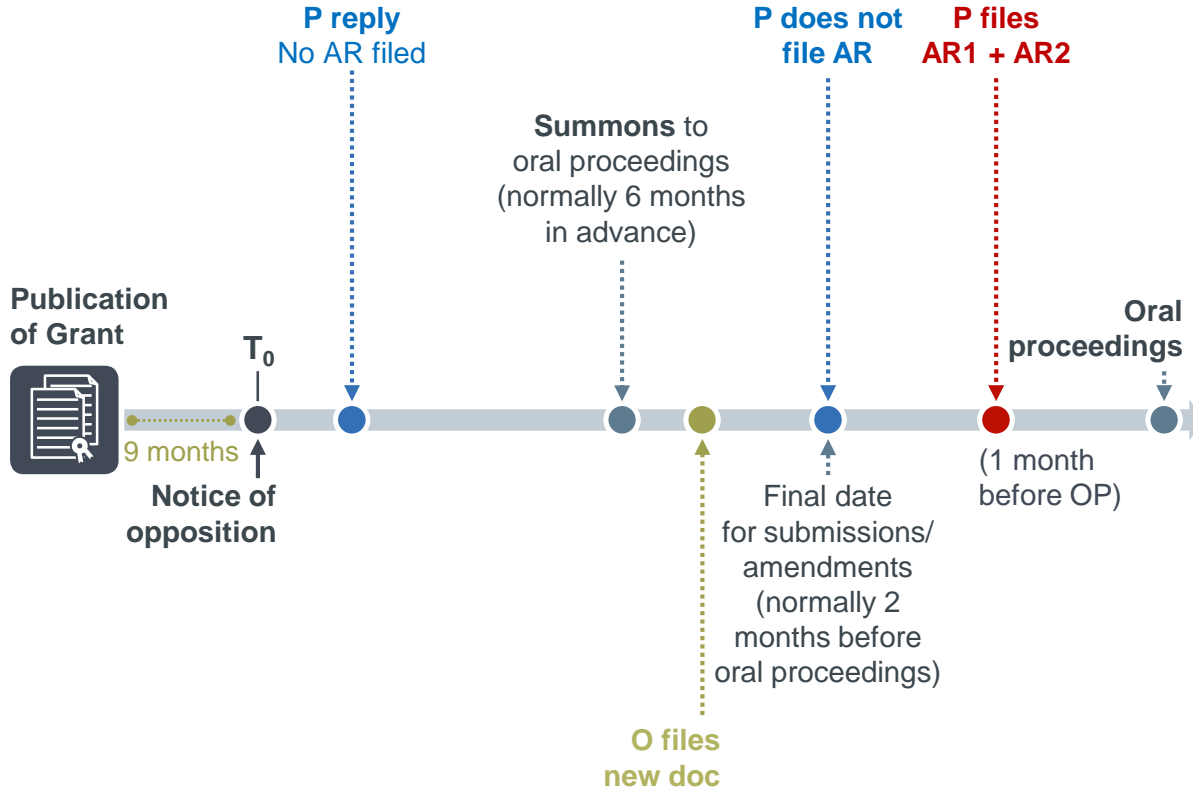
Case 3

- In reply to a NoO, P does not file any AR
 - Preliminary opinion from OD indicates that claims are novel and inventive
 - In reply to the summons to OP:
 - O files a new novelty destroying document
 - P does not file any AR within the R116 deadline
 - After the R116 deadline, P files AR to overcome the objections based on the new document
 - AR1 = combination of granted claims
 - AR2 = cl 1+ feature(s) taken from the description
- How will the OD react? Will the OD consider the AR as late filed requests?

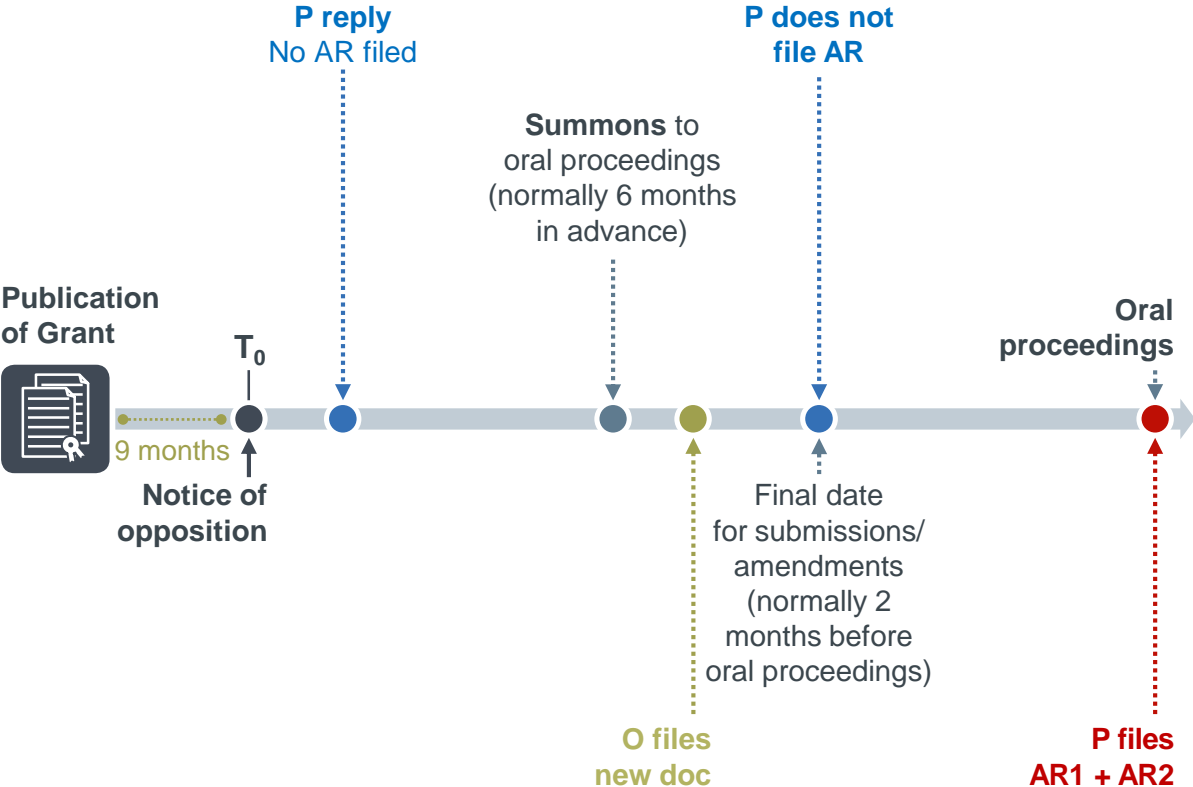
Case 3



Case 3a



Case 3b



Case 4

- In reply to a NoO, P files some AR
 - Preliminary opinion from OD indicates that MR and all AR are novel and inventive
 - During OP, the OD comes to the conclusion that none of the requests on file is inventive
 - In reaction to the conclusion from the OD, P decides to file **2 AR**
 - AR1 = combination of granted claims
 - AR2 = cl 1+ feature taken from the description
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- How will the OD react? Will the OD consider the AR as late filed requests?
 - Will the OD accept **both** AR?
 - Will the answer be the same if **both** AR are based on granted claims?

Case 4

