

Auxiliary requests – when and how?

Practical cases

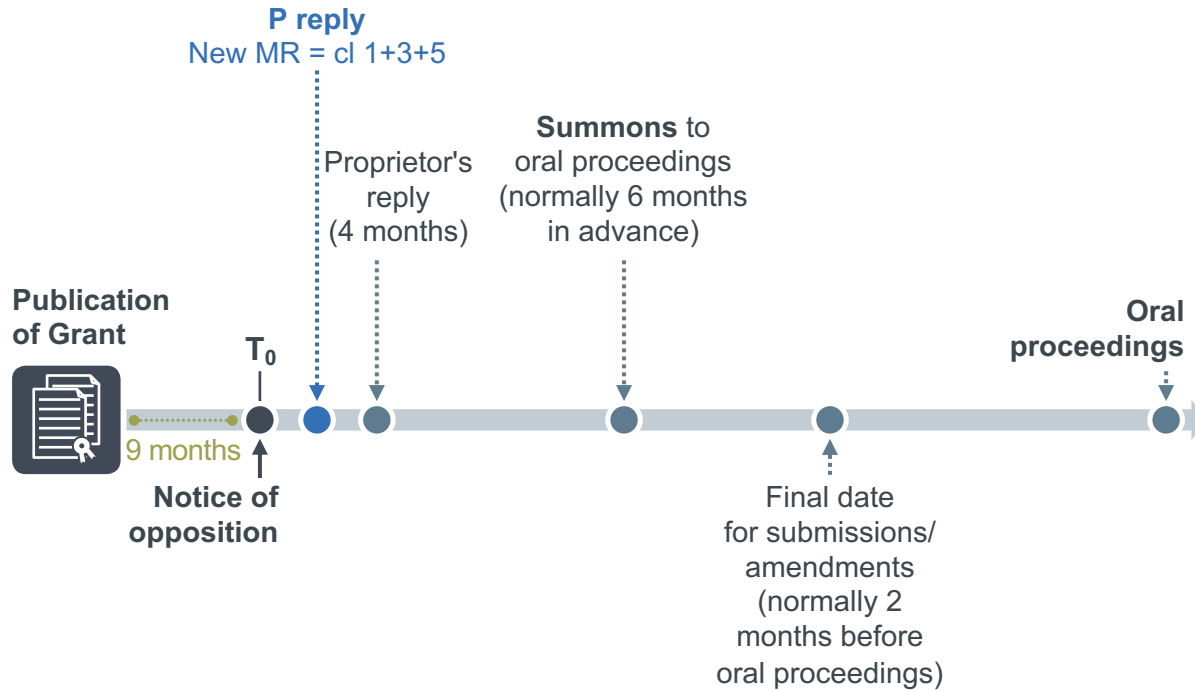
Margarita García Martín
Alexandre Bitton



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 second new MR as a late filed request or will admit it? What about AR1?

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

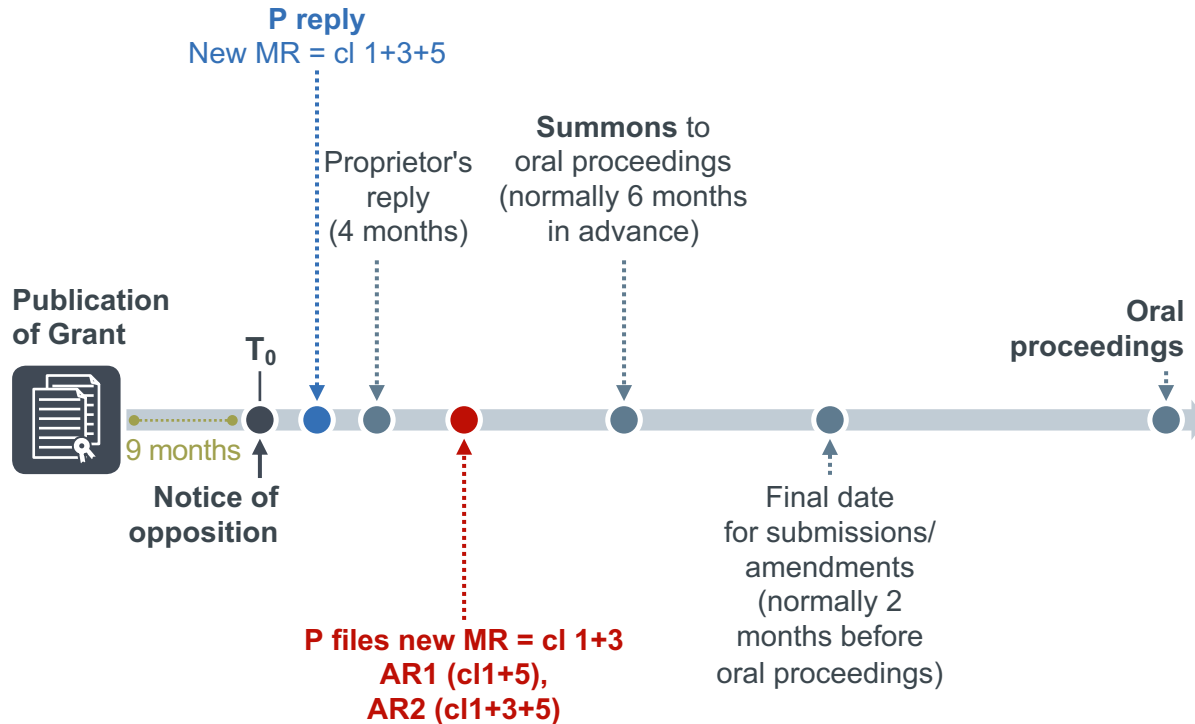
P files the following AR:

new MR = cl 1+3

AR1 = cl 1+5

AR2 = cl 1+3+5

Case 1a

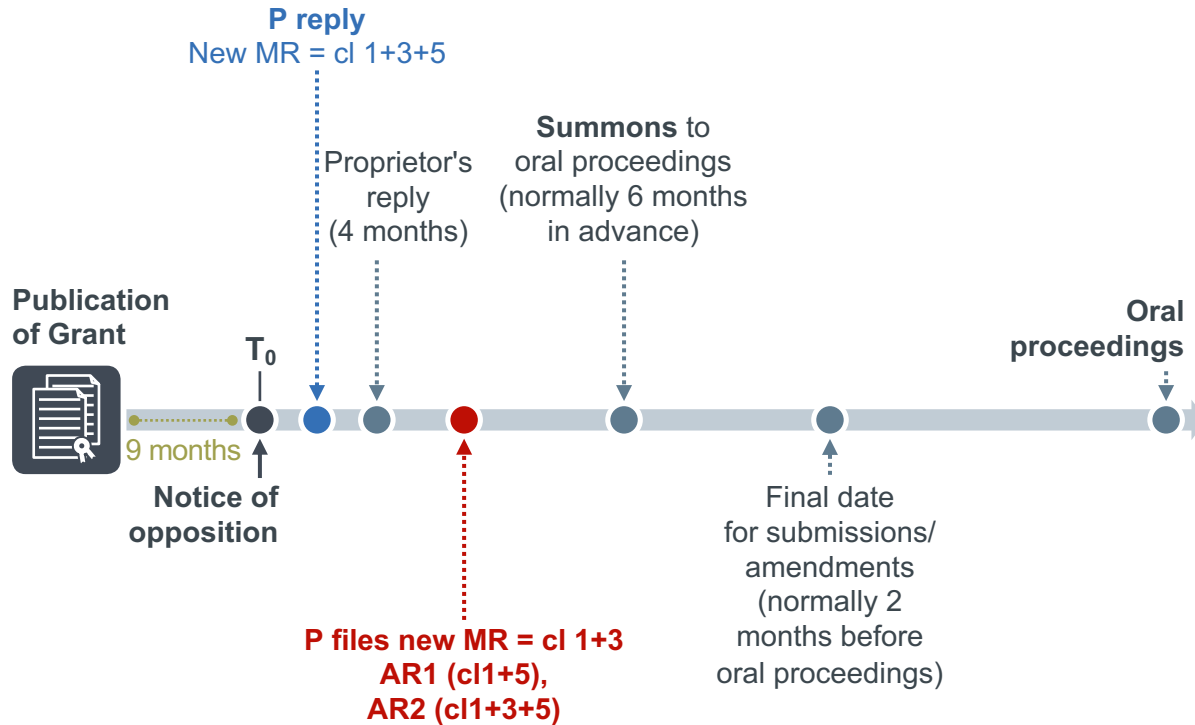


Will the OD admit the new MR and AR1 into the proceedings?

Please vote



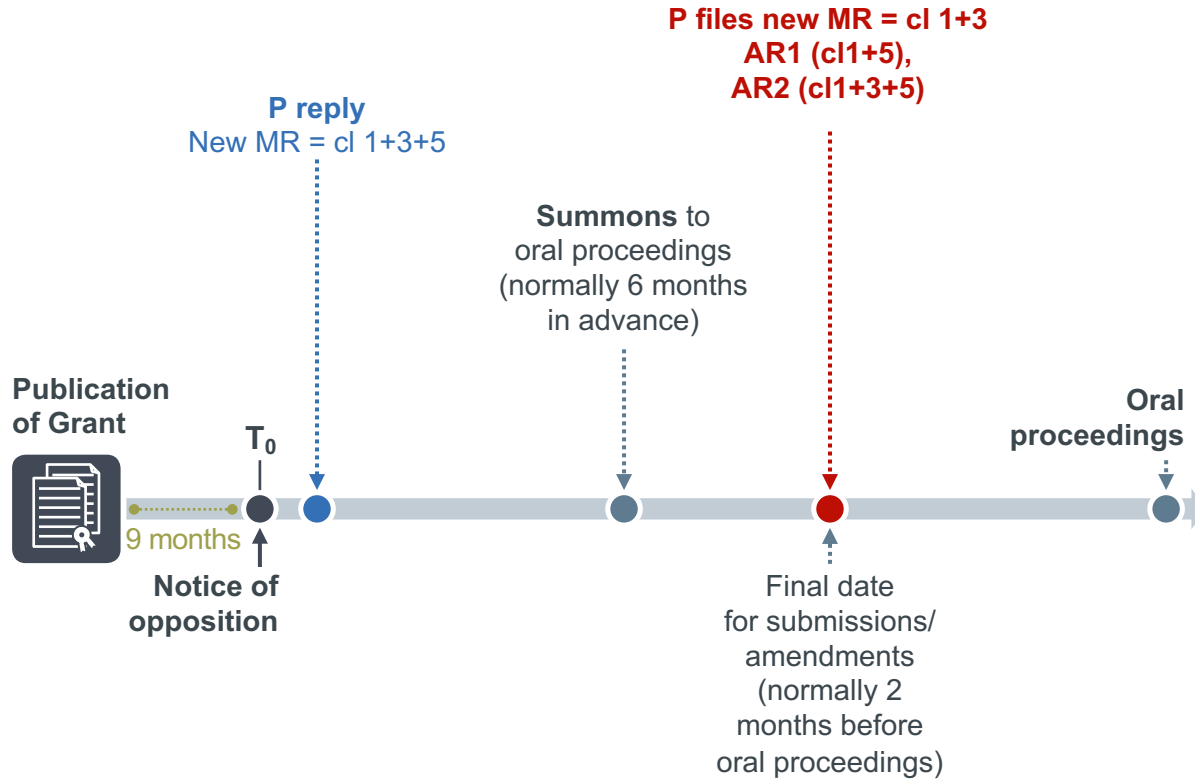
Case 1a



Will the OD admit the new MR and AR1 into the proceedings?



Case 1b

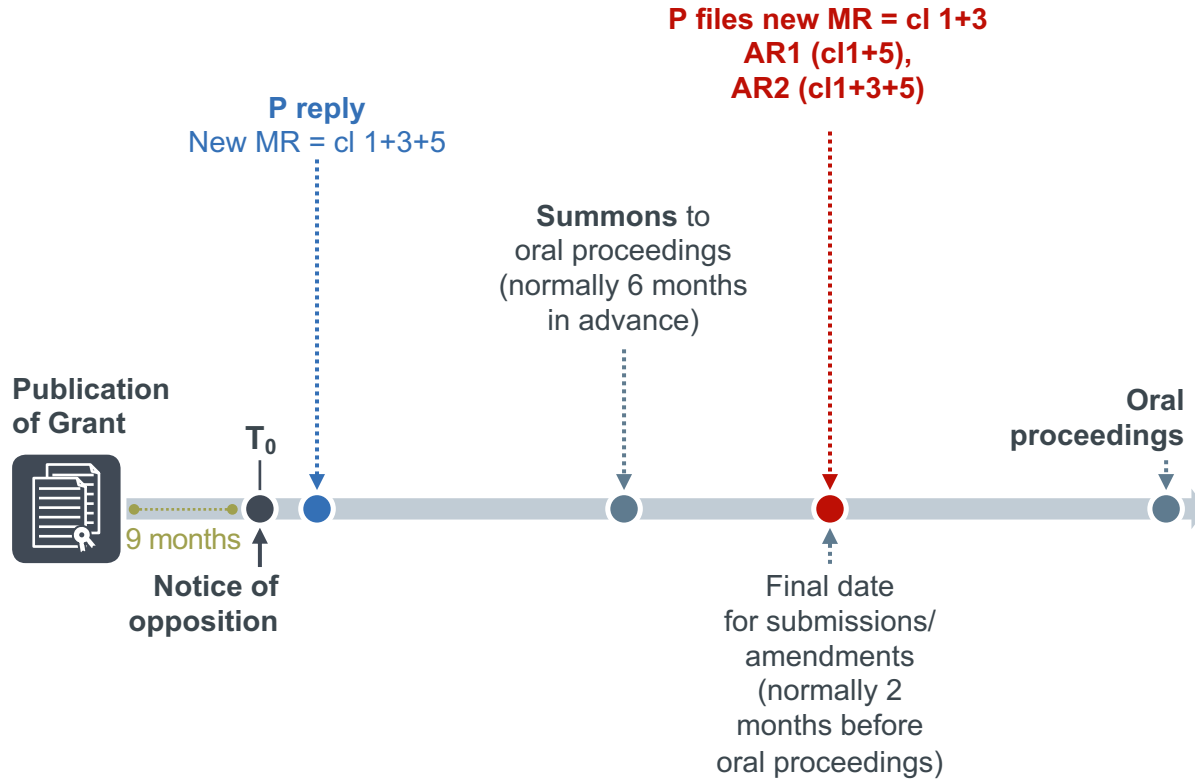


Will the OD consider the MR and AR1 as a late filed request?

Please vote



Case 1b

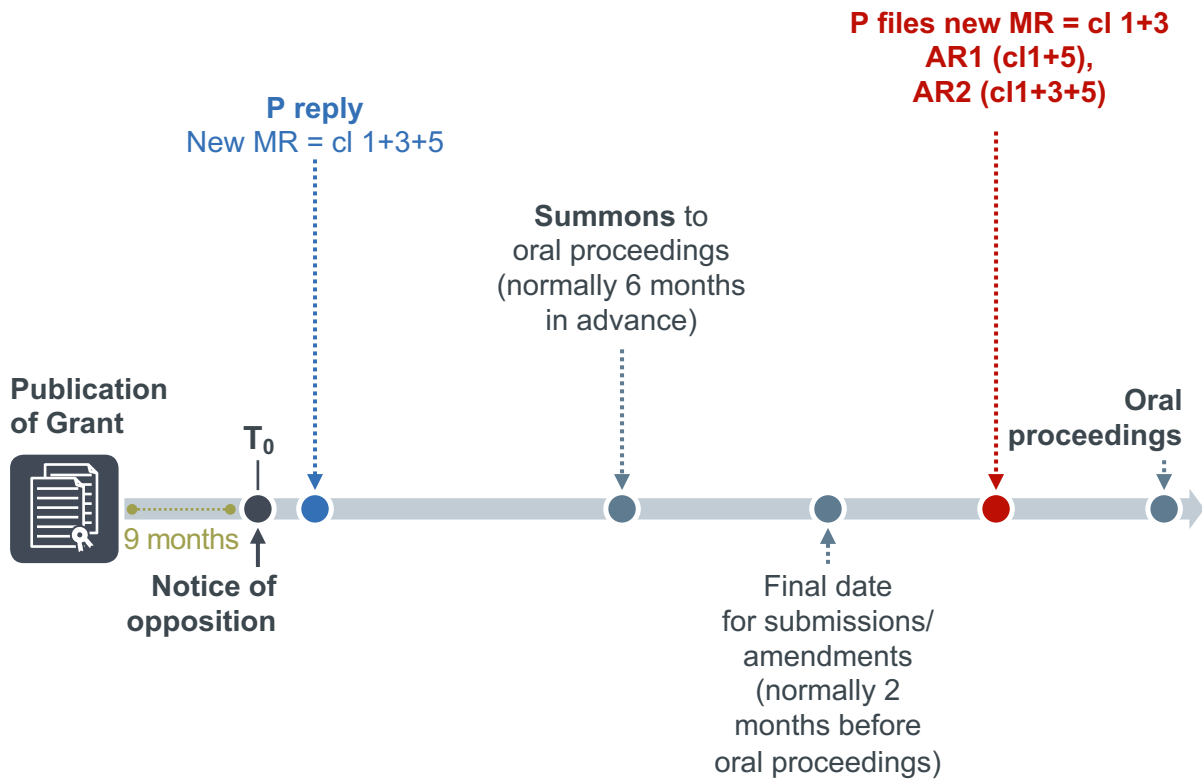


Will the OD consider the MR and AR1 as a late filed request?



... BUT ...

Case 1c

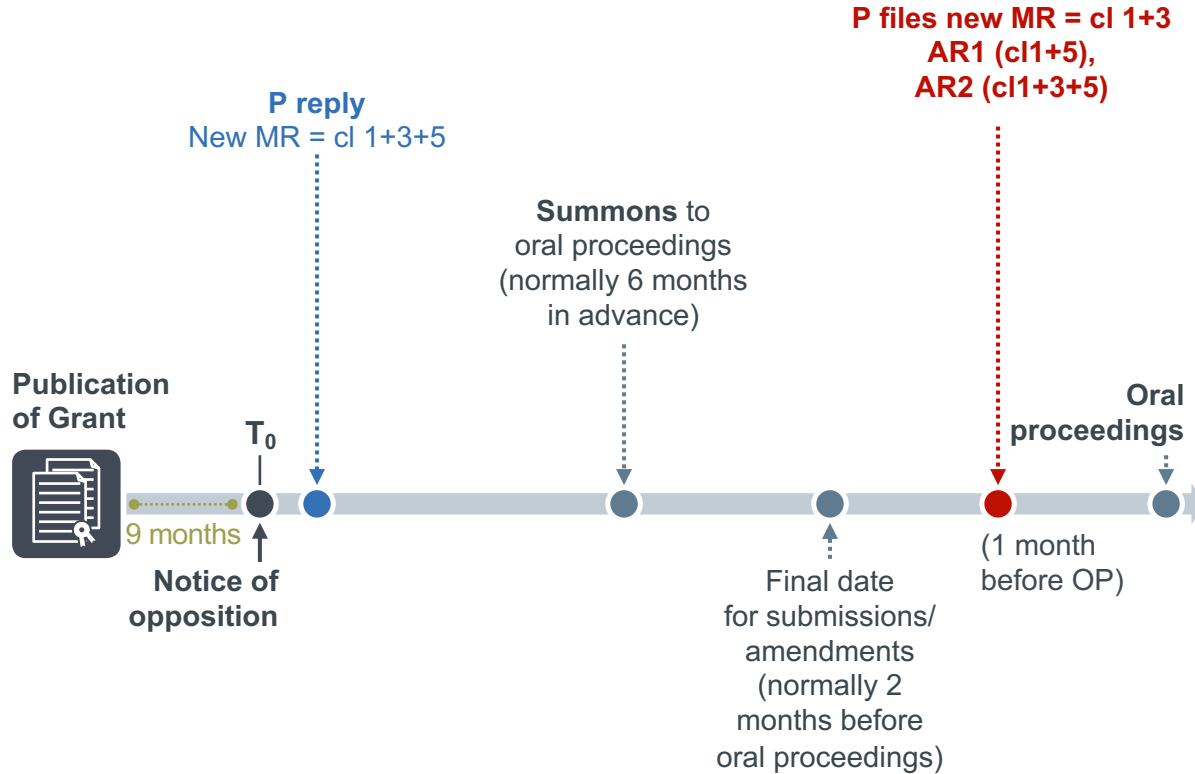


Will the OD admit the new MR and AR1 into the proceedings?

Please vote



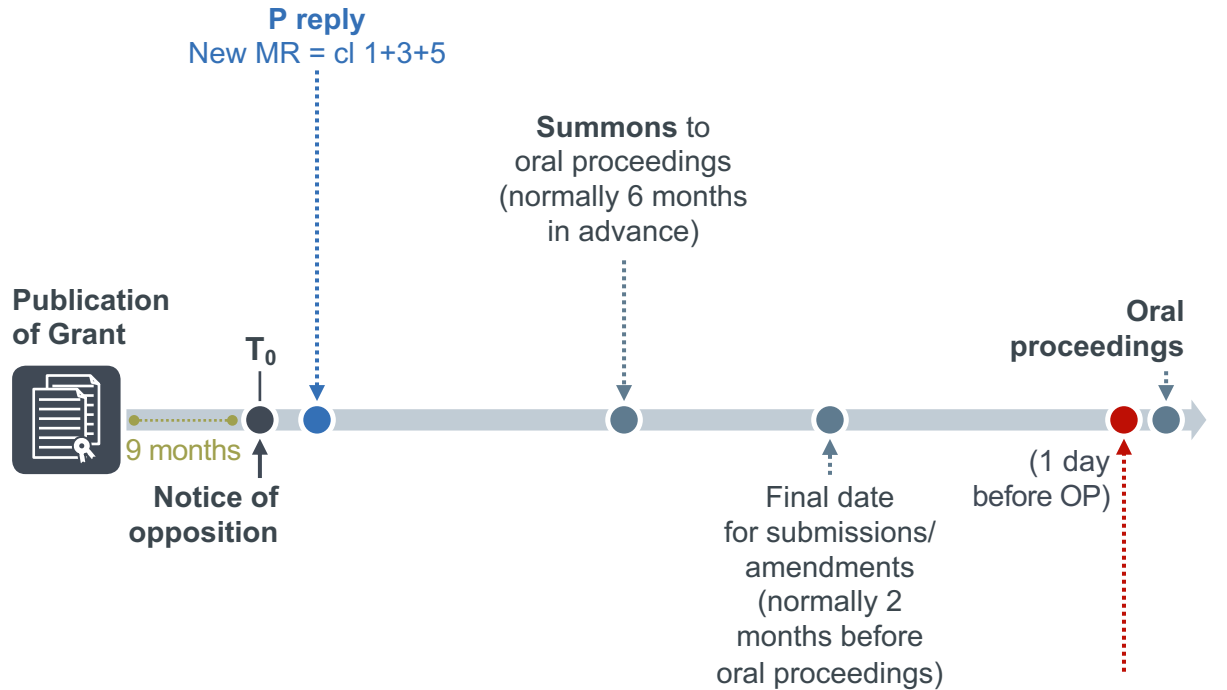
Case 1c



Will the OD admit the new MR and AR1 into the proceedings?

- MR and AR1 are not convergent
- Unlikely that both MR and AR1 are accepted, but one of them could be

Case 1d

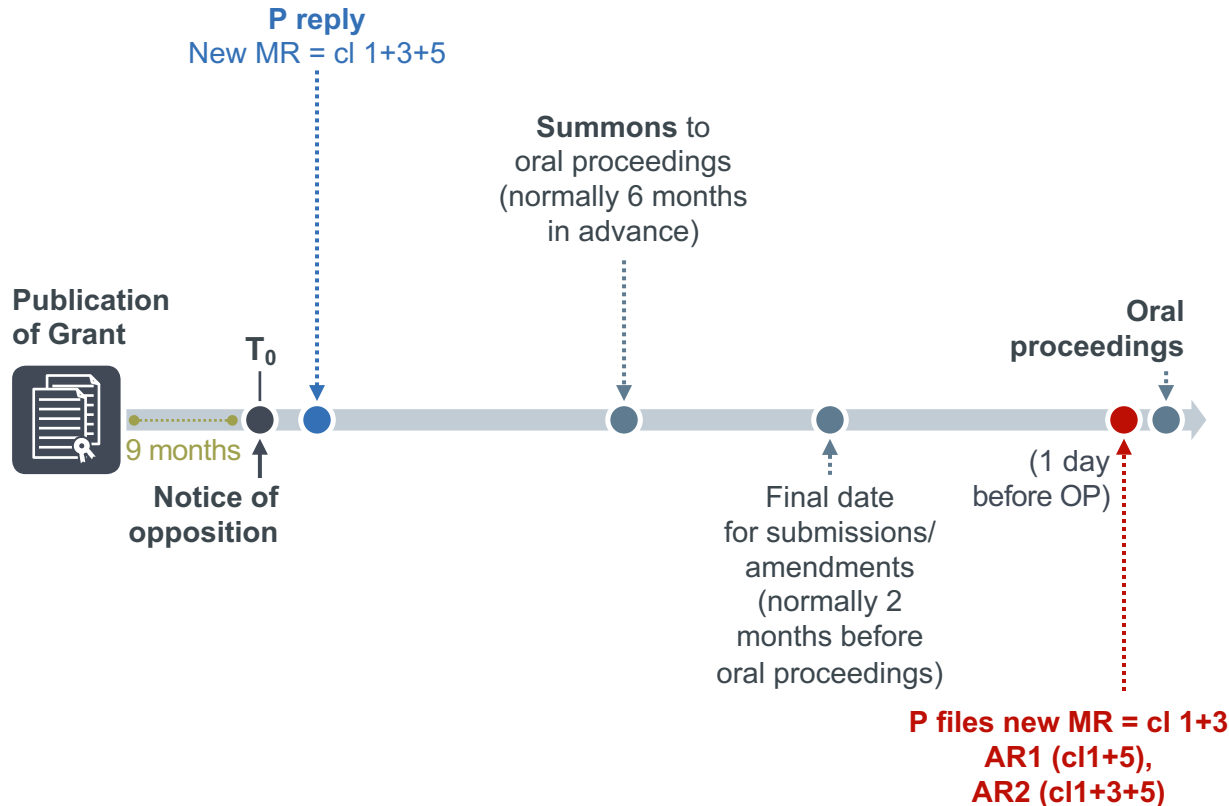


Will the OD admit the new MR and AR1 into the proceedings?

Please vote



Case 1d



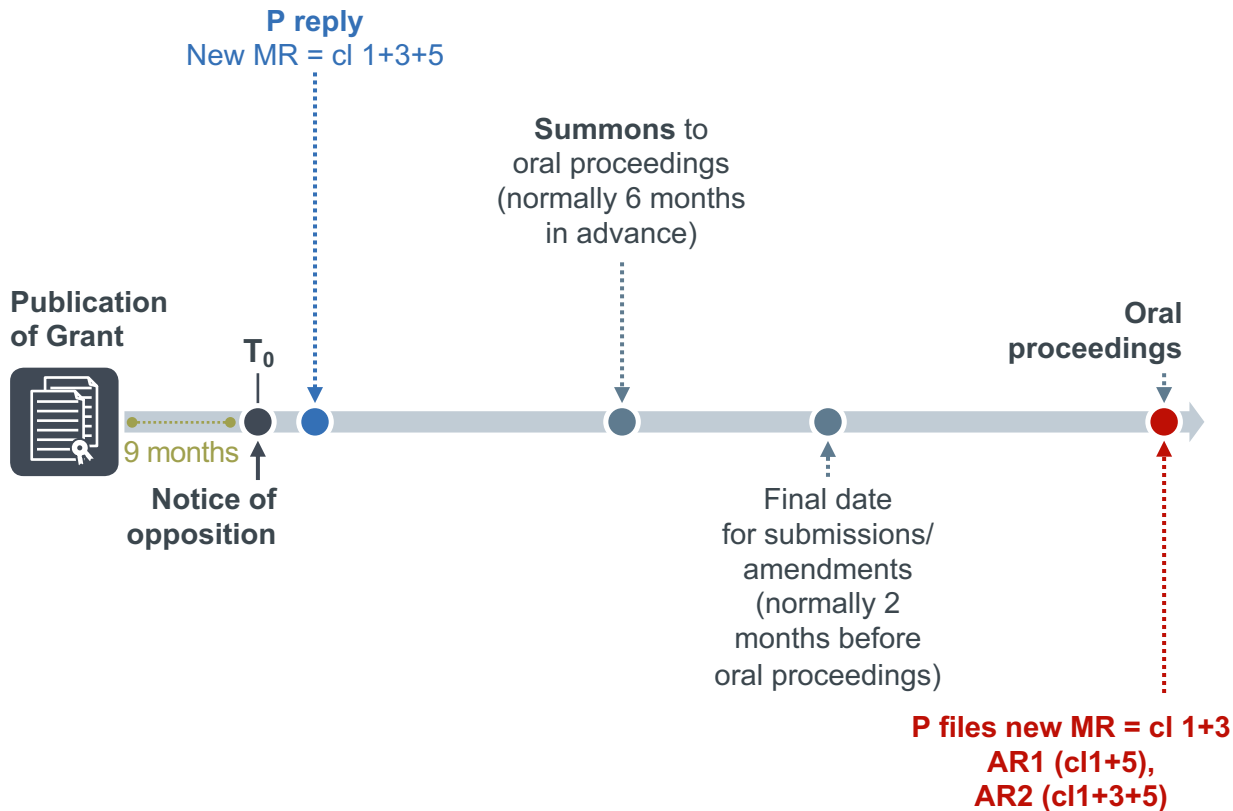
Will the OD admit the new MR and AR1 into the proceedings?

- Most likely



- Justification of late filed needed
- It is unlikely that MR or AR1 are accepted

Case 1e

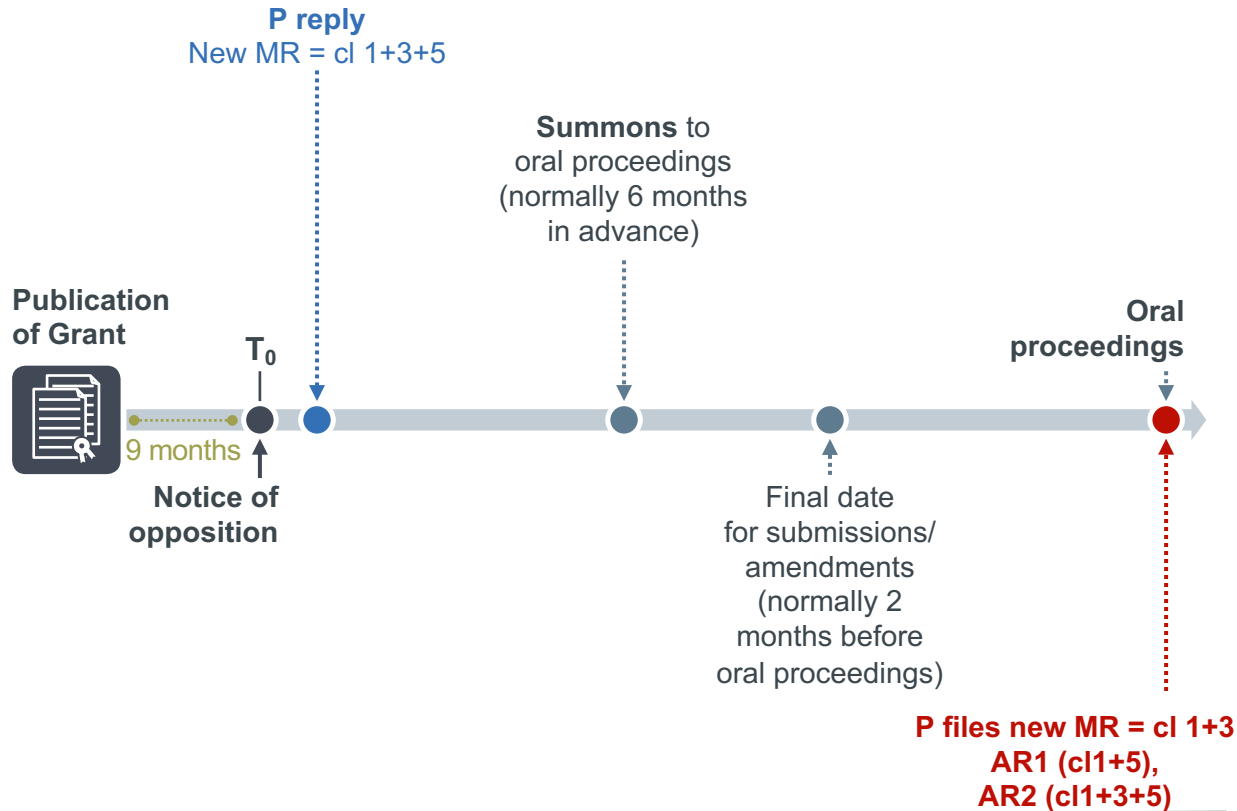


Will the OD admit the new MR and AR1 into the proceedings?

Please vote



Case 1e



Will the OD consider the MR and AR1 as a late filed request?

- Same situation as previous case

- Most likely

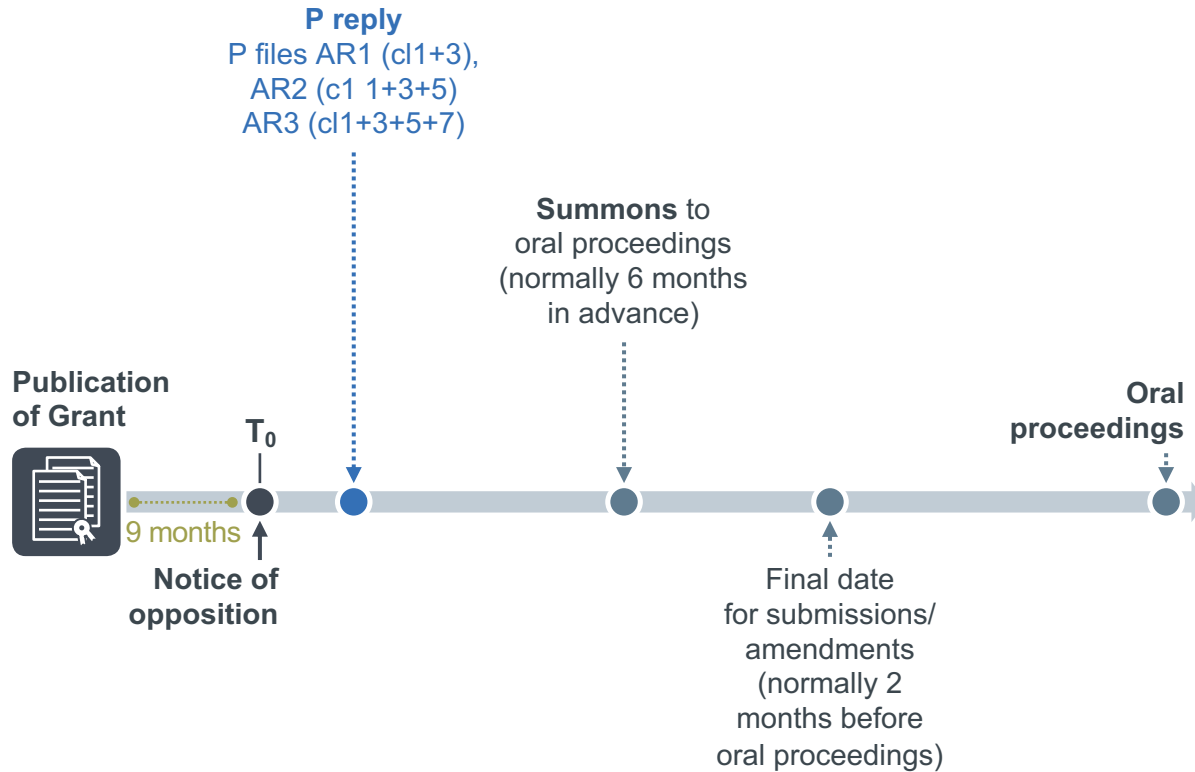


- Justification of late filed needed
- It is unlikely that MR or AR1 are accepted

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 ARs as late filed requests or will admit them?
 - 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



In reply to a NoO, P files several AR combining granted claims

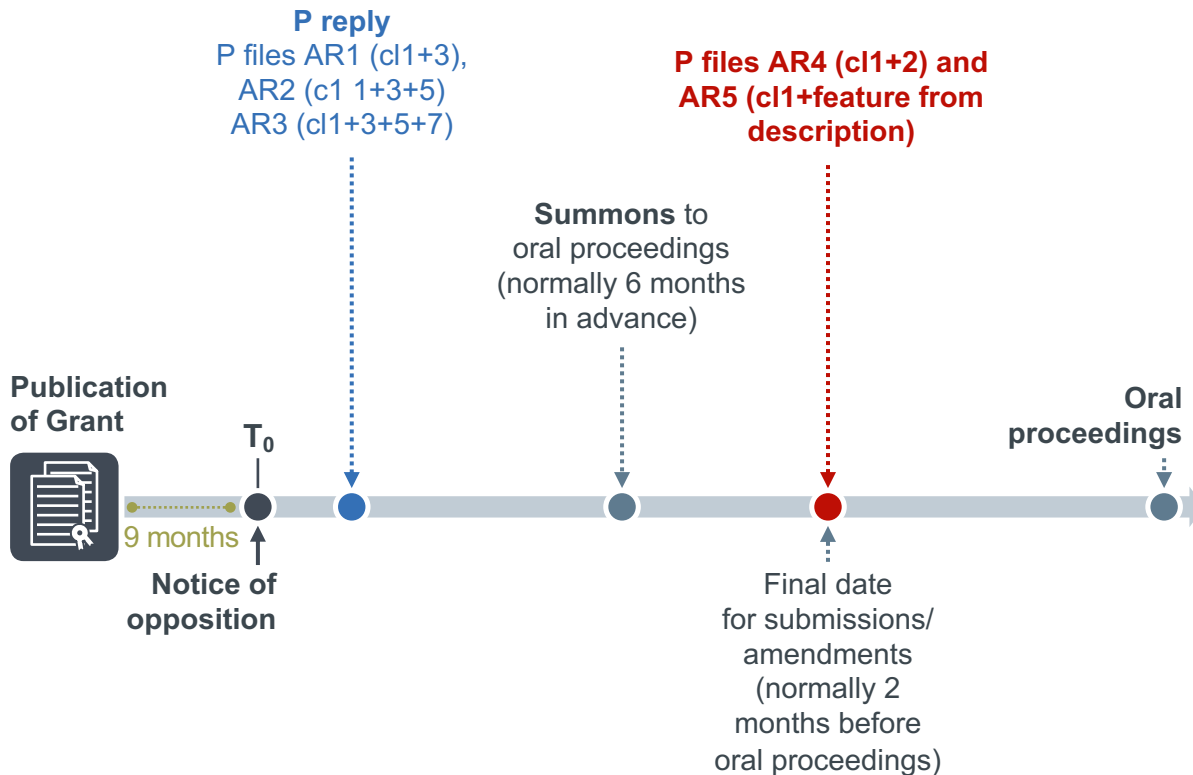
Preliminary opinion from the OD: all AR are novel, but seem not inventive

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

Case 2a

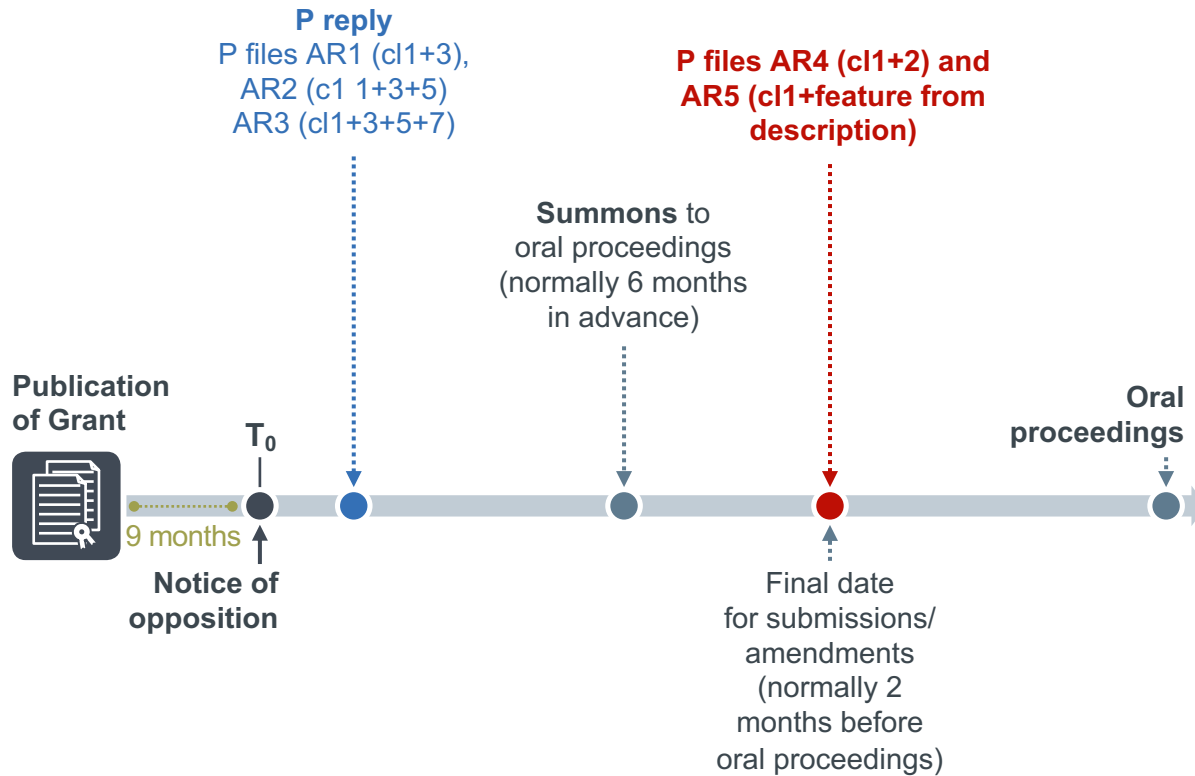


Will the OD admit the AR4 and AR5 into the proceedings?

Please vote



Case 2a

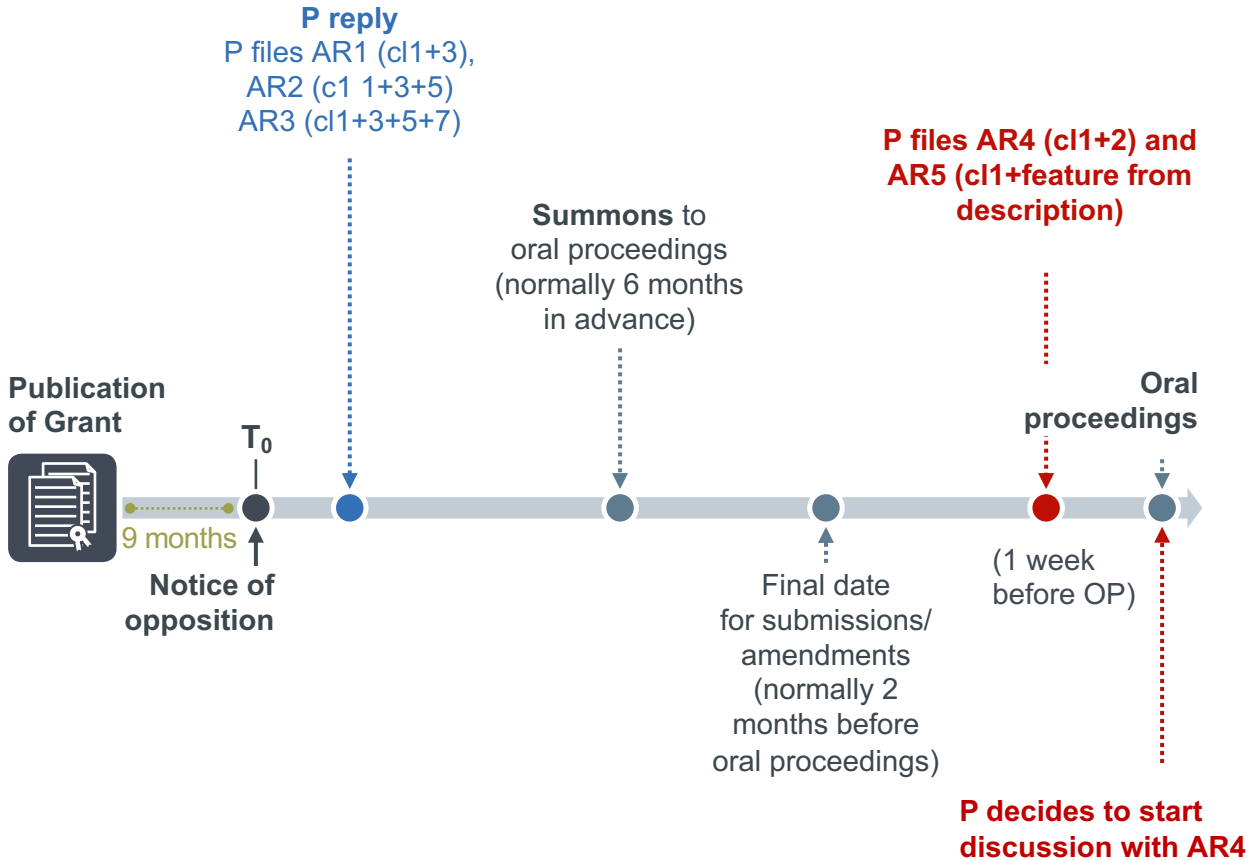


Will the OD admit the AR4 and AR5 into the proceedings?



(GL, E-VI, 2.2.b)

Case 2b

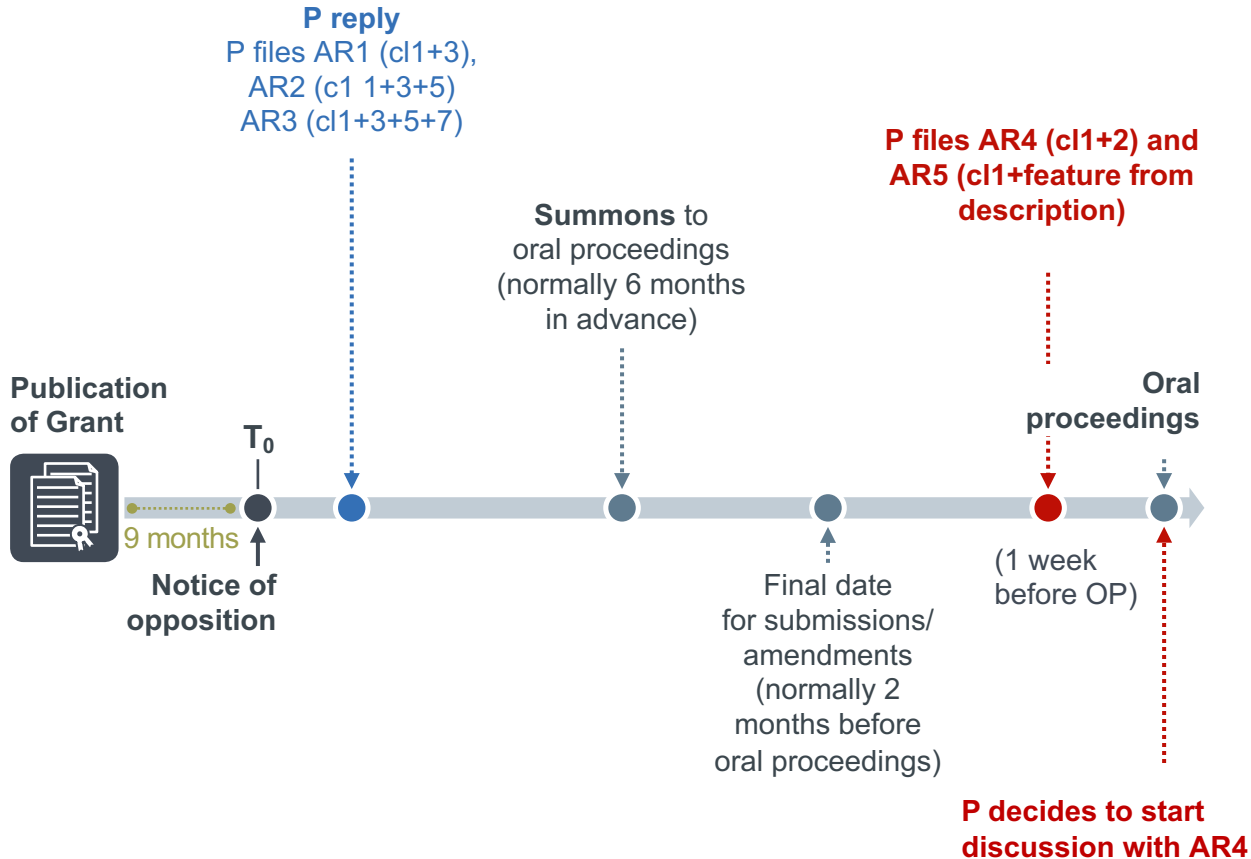


Will the OD admit the AR4 into the proceedings?

Please vote



Case 2b



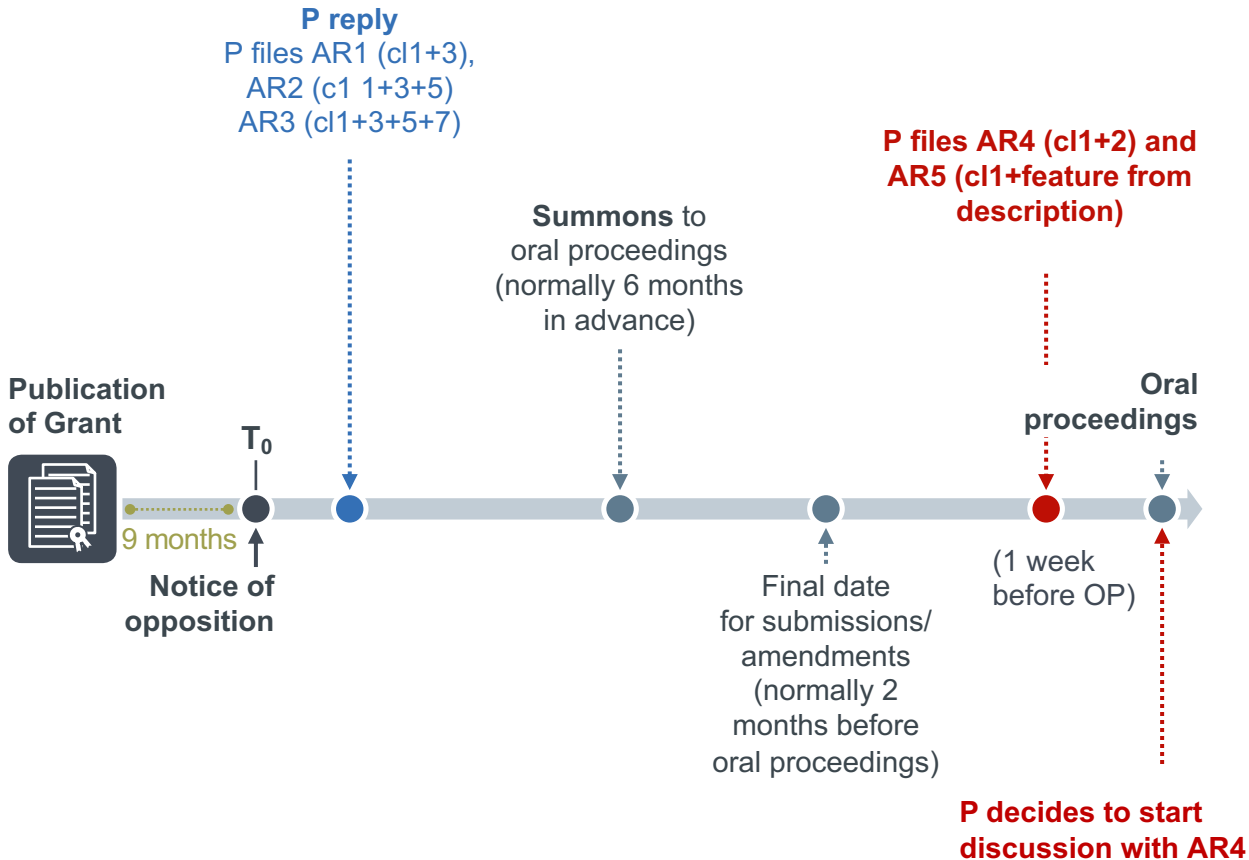
Will the OD admit the AR4 into the proceedings?

Normally



(GL, E-VI, 2.2.c)

Case 2b

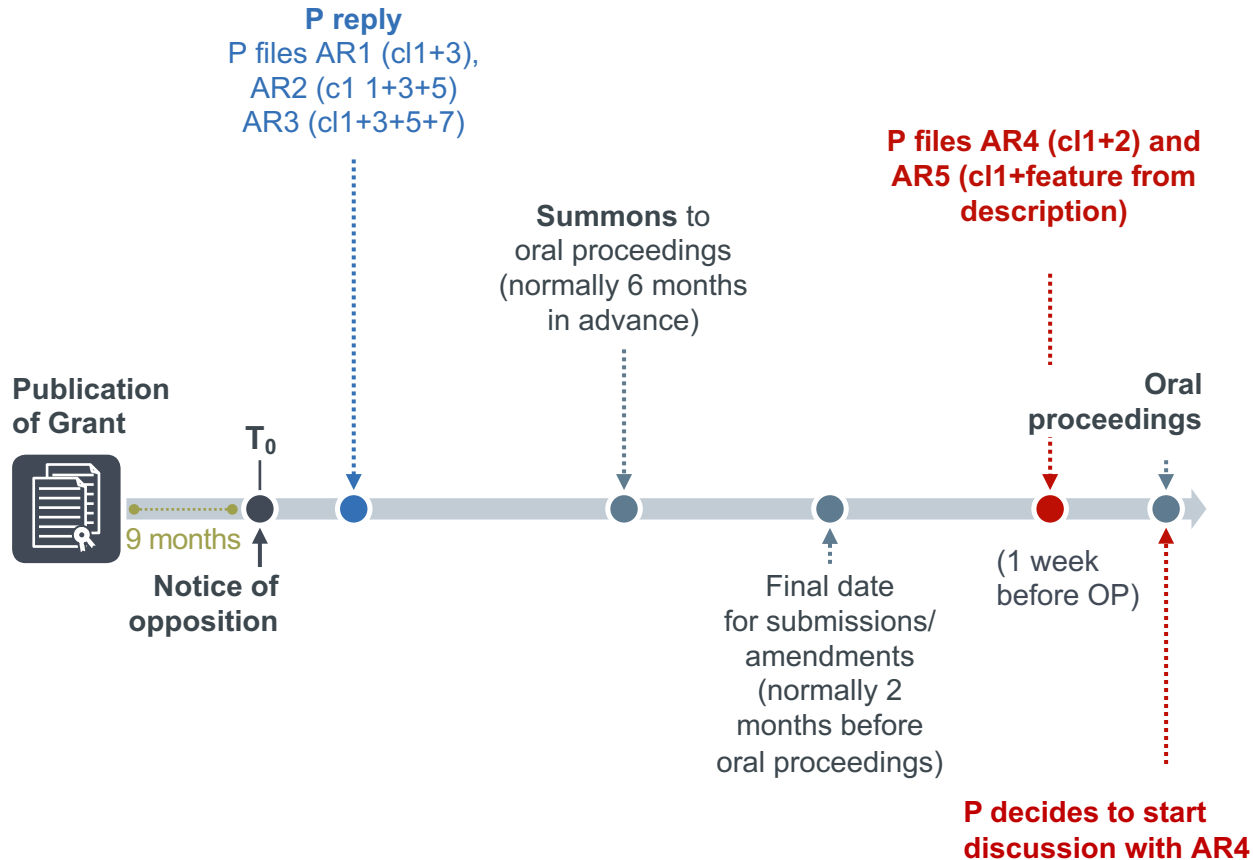


Will the OD admit the AR5 into the proceedings?

Please vote



Case 2b

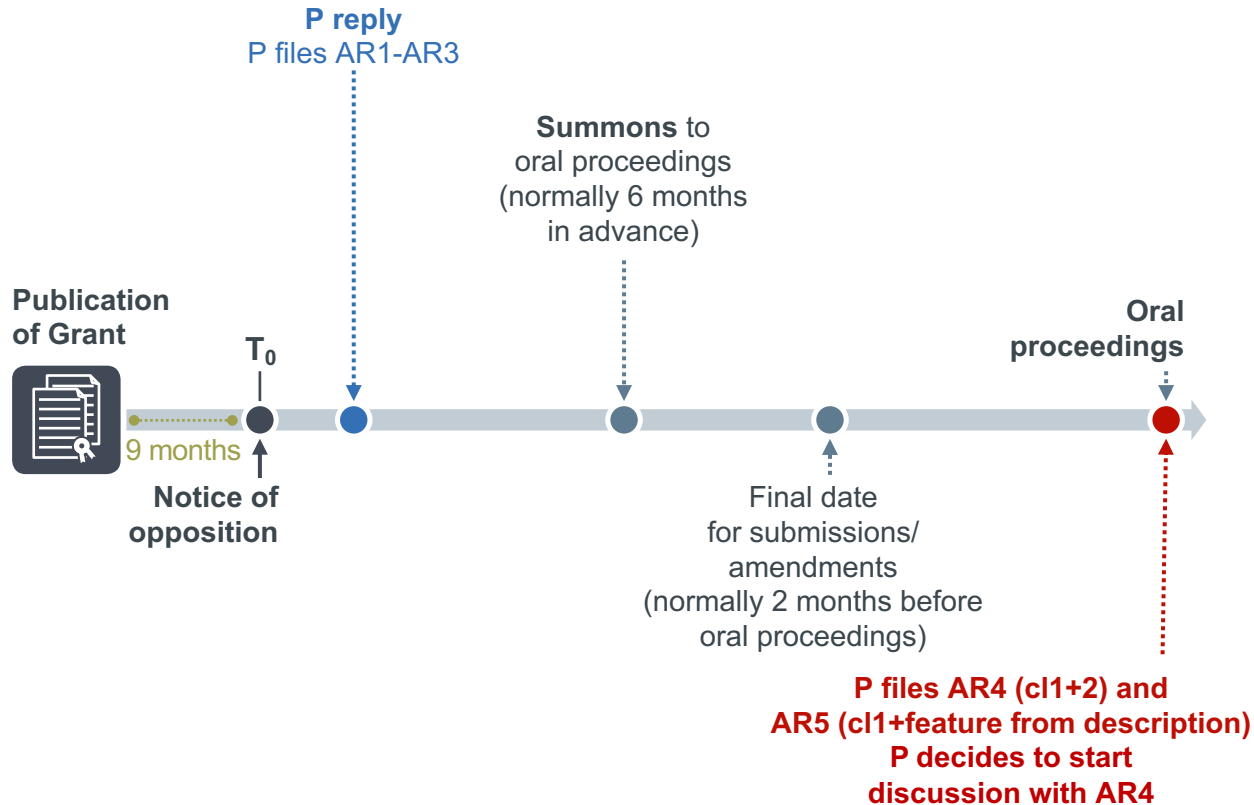


Will the OD admit the AR5 into the proceedings?

Normally



Case 2c

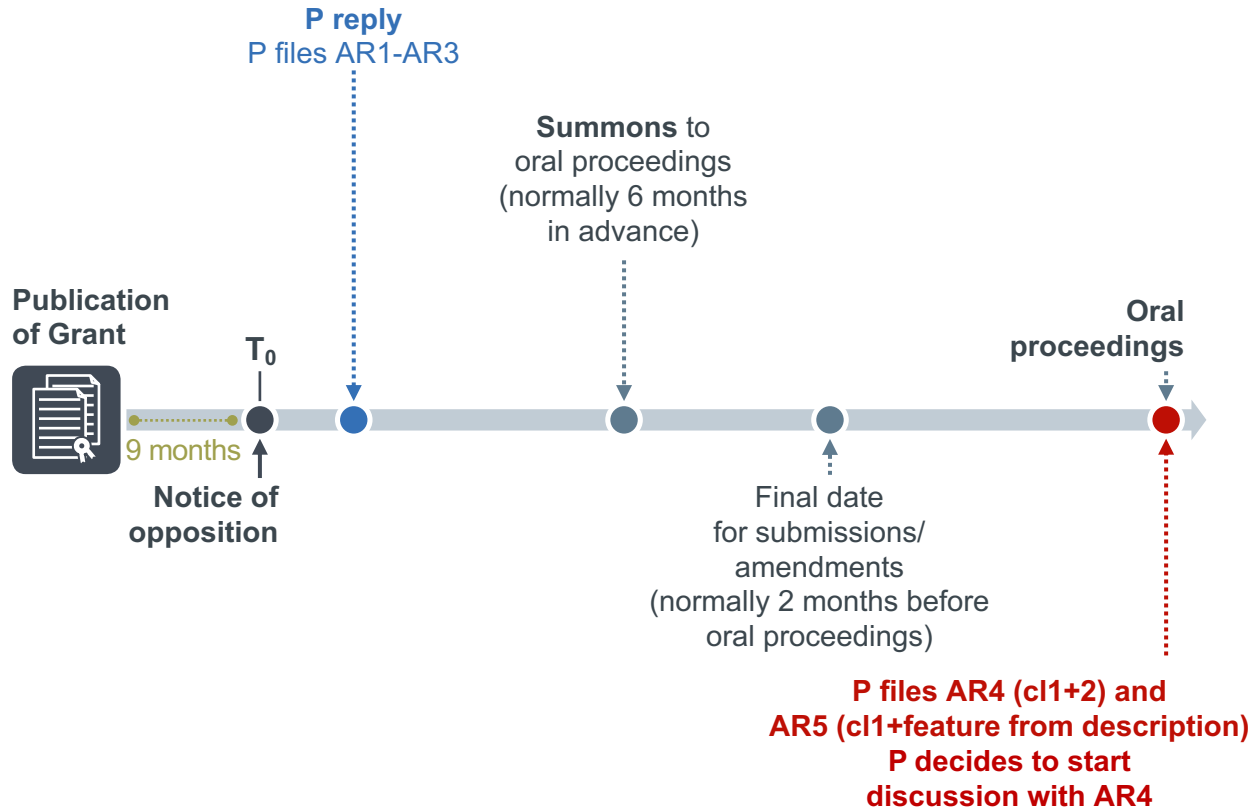


Will the OD admit the AR4 into the proceedings?

Please vote



Case 2c



Will the OD admit the AR4 into the proceedings?

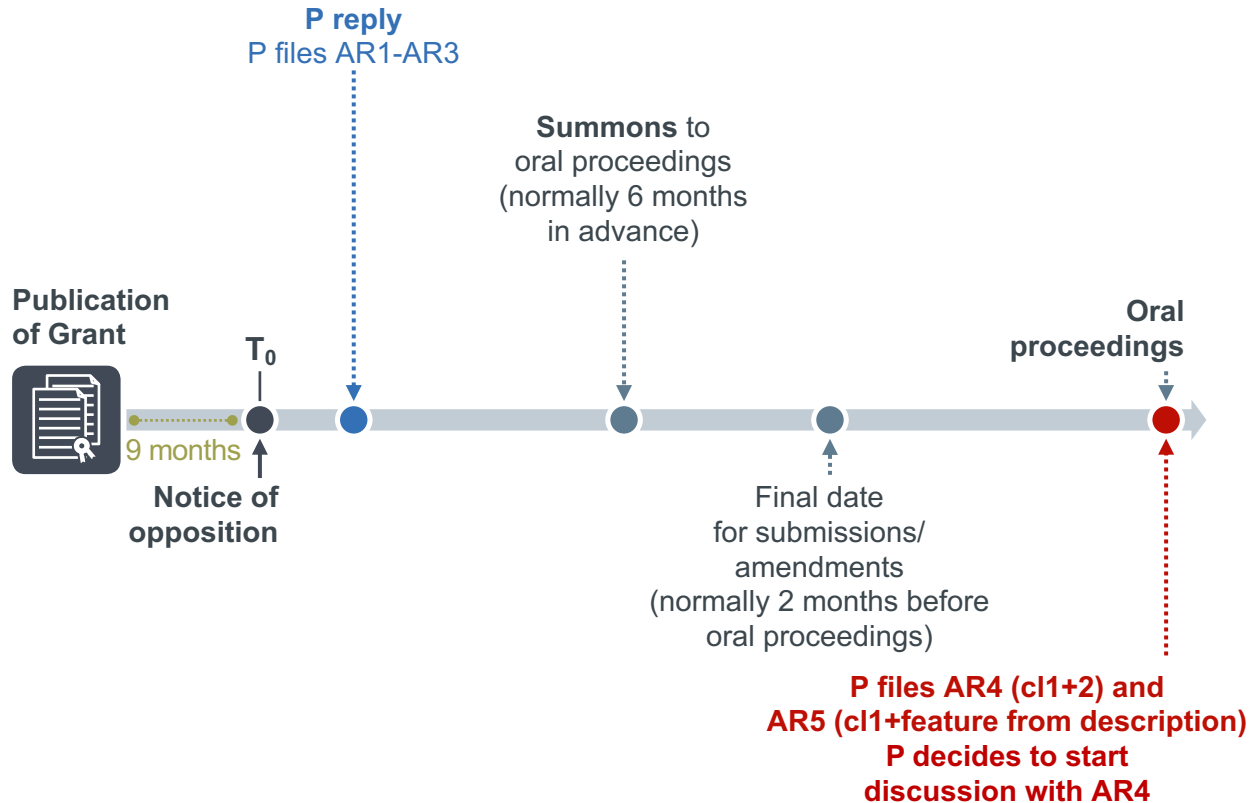
AR4 would possible



... IF ...

(GL, E-VI, 2.2.c)

Case 2c

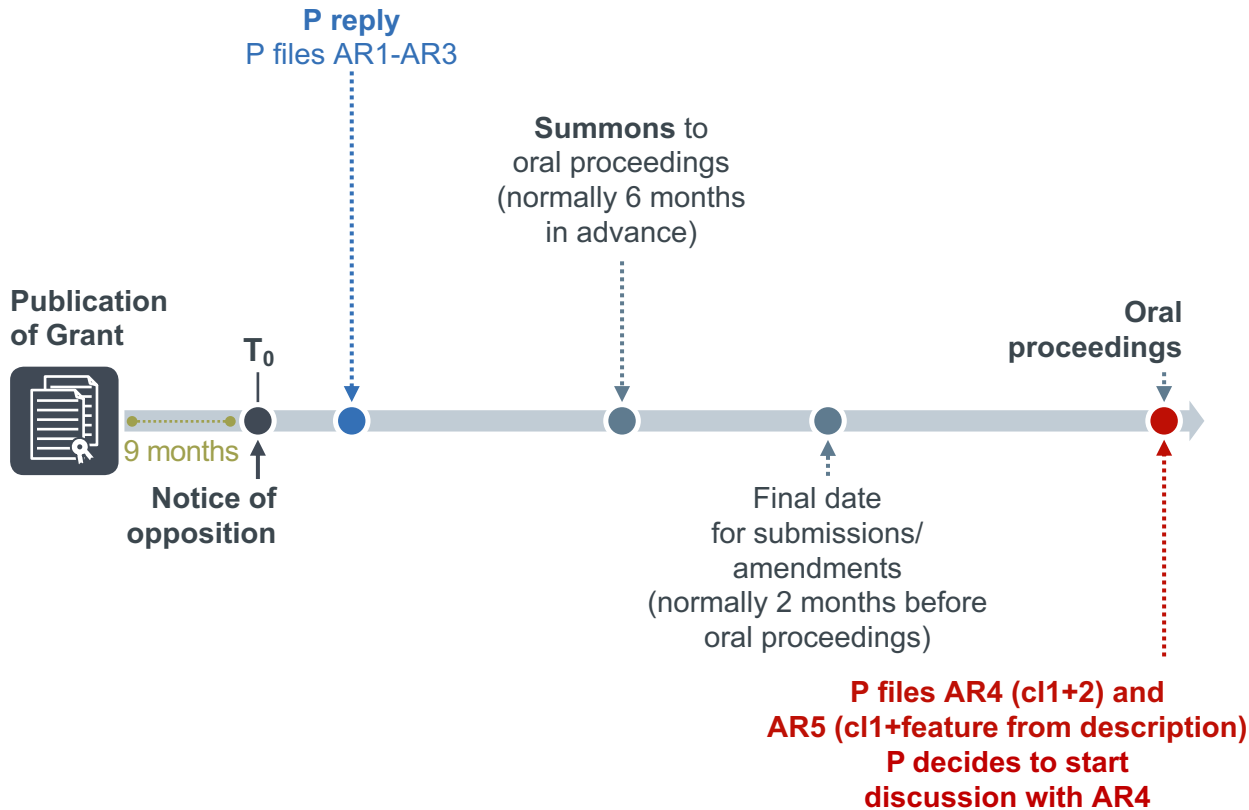


Will the OD admit the AR5 into the proceedings?

Please vote



Case 2c



Will the OD admit the AR5 into the proceedings?

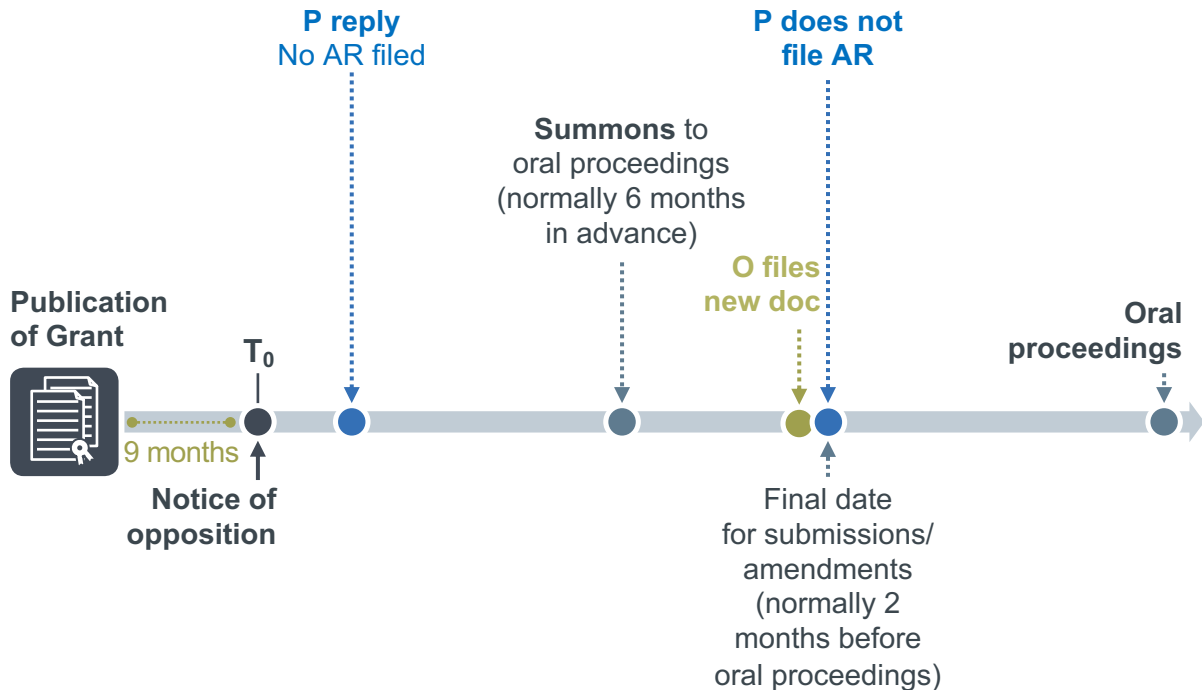
Normally



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 or will admit them?

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

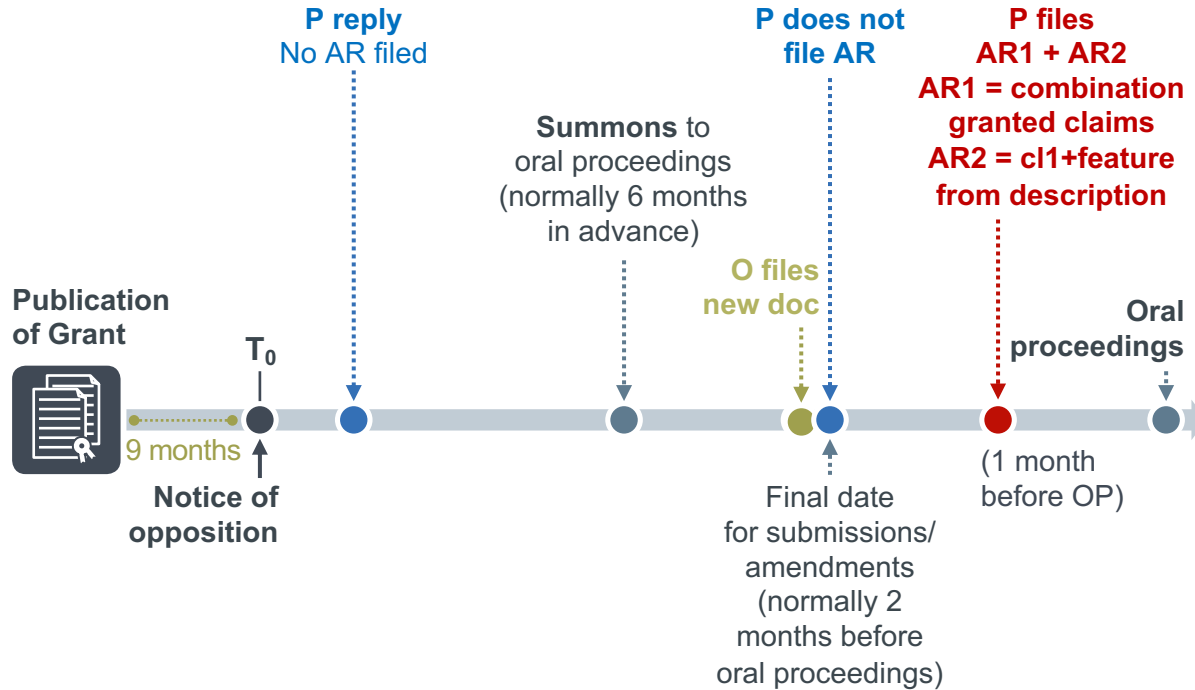
P does not file any AR within the R116 deadline

After the R116 deadline, P files ARs:

AR1 = combination of granted claims

AR2 = cl 1+ feature(s) taken from the description

Case 3a

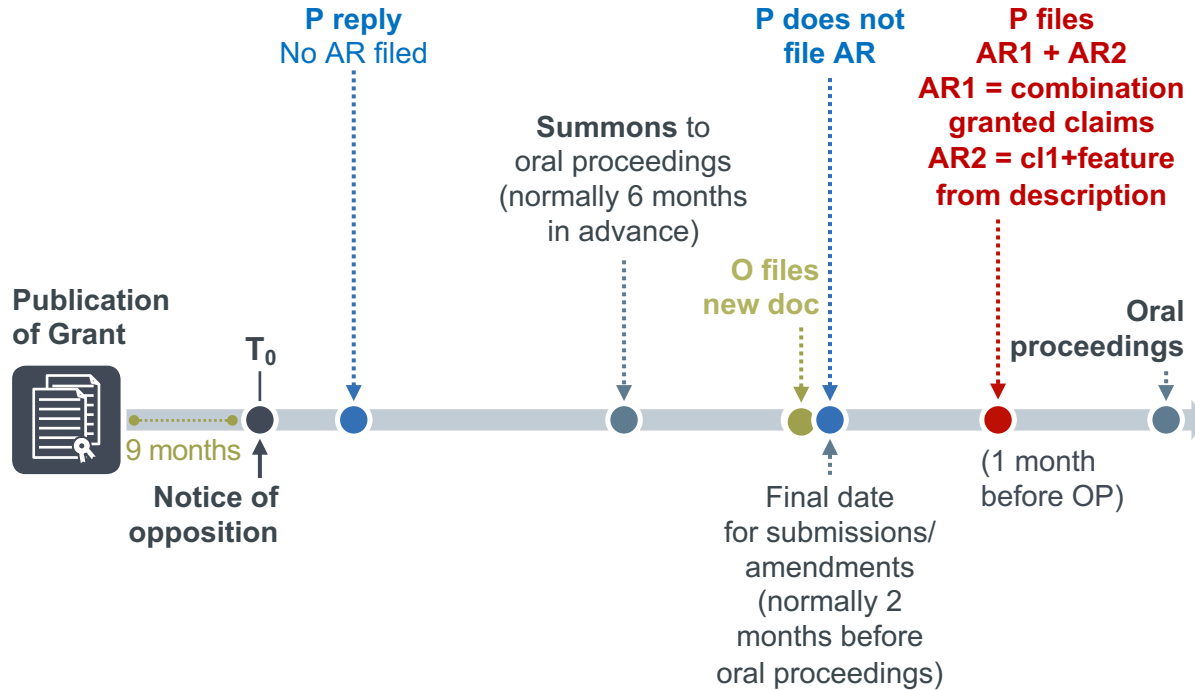


Will the OD admit the AR1 and AR2 into the proceedings?

Please vote



Case 3a



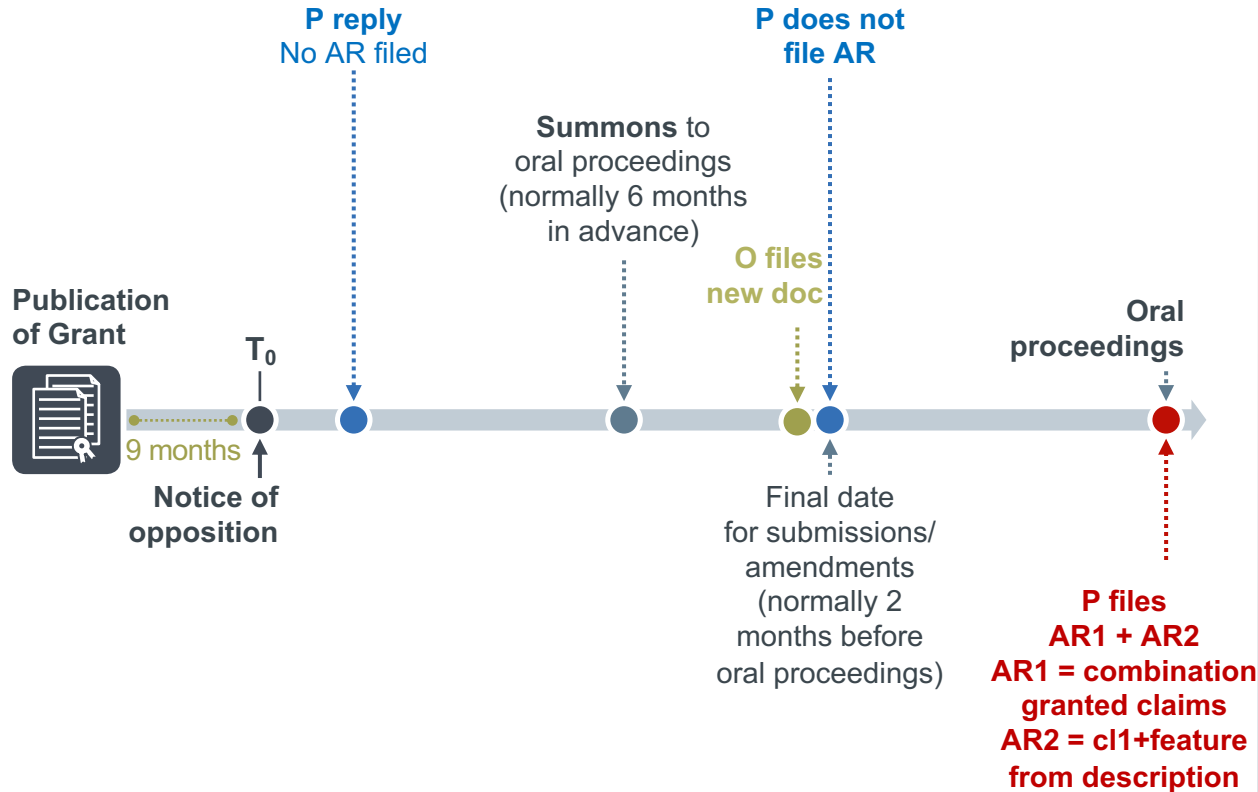
Will the OD admit the AR1 and AR2 into the proceedings?

Normally



(GL, E-VI, 2.2.a)

Case 3b

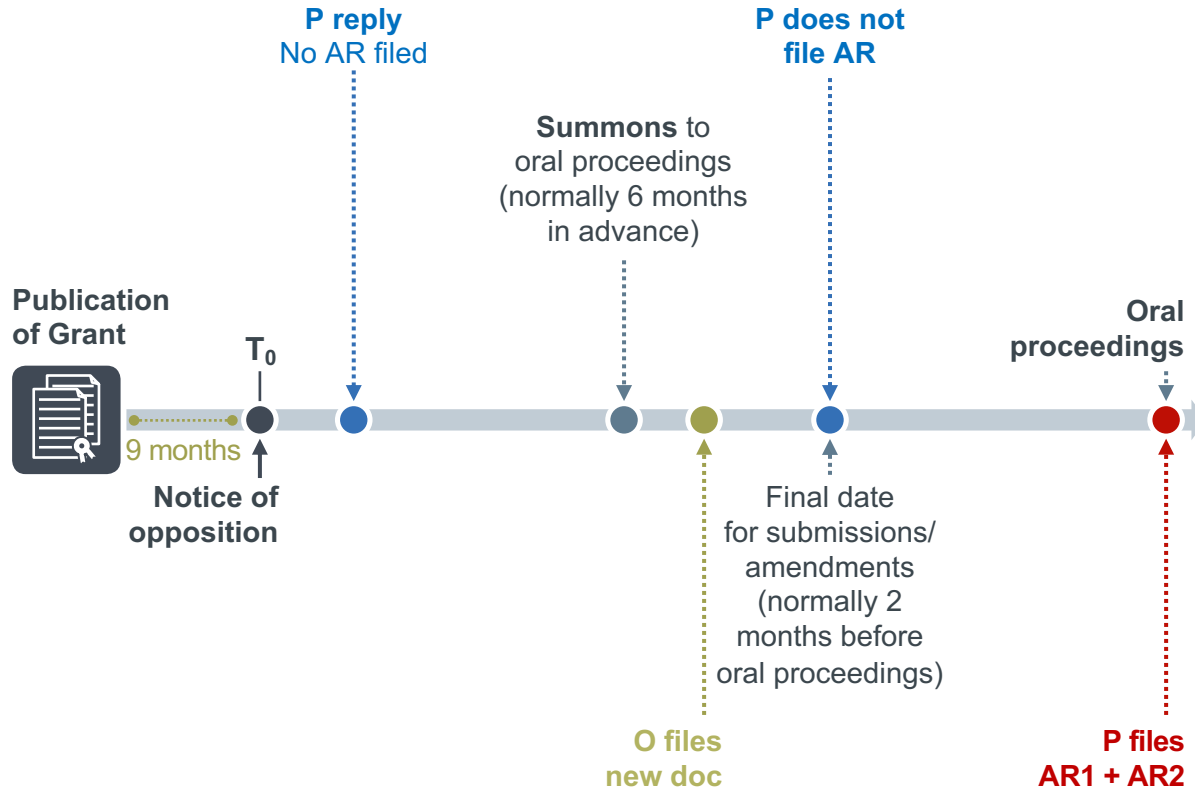


Will the OD admit the AR1 and AR2 into the proceedings?

Please vote



Case 3b

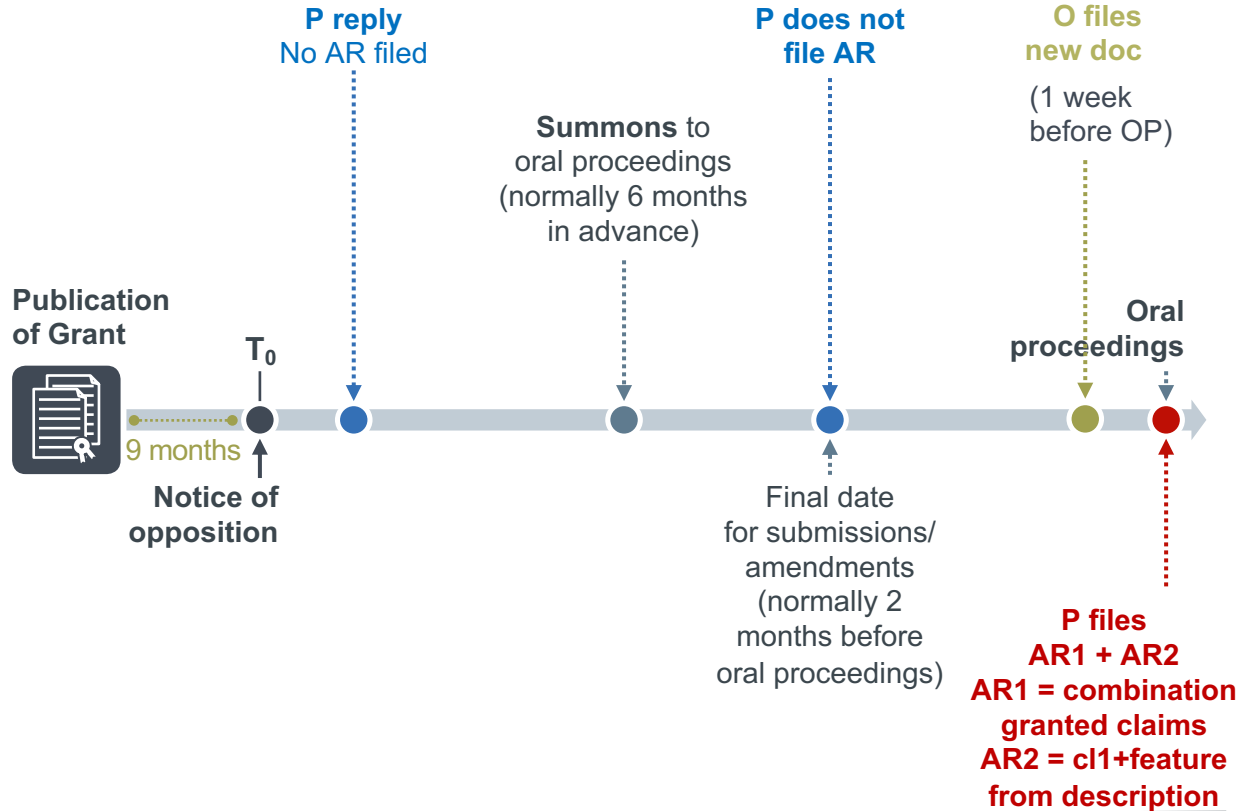


Will the OD admit the AR1 and AR2 into the proceedings?

Normally



Case 3c

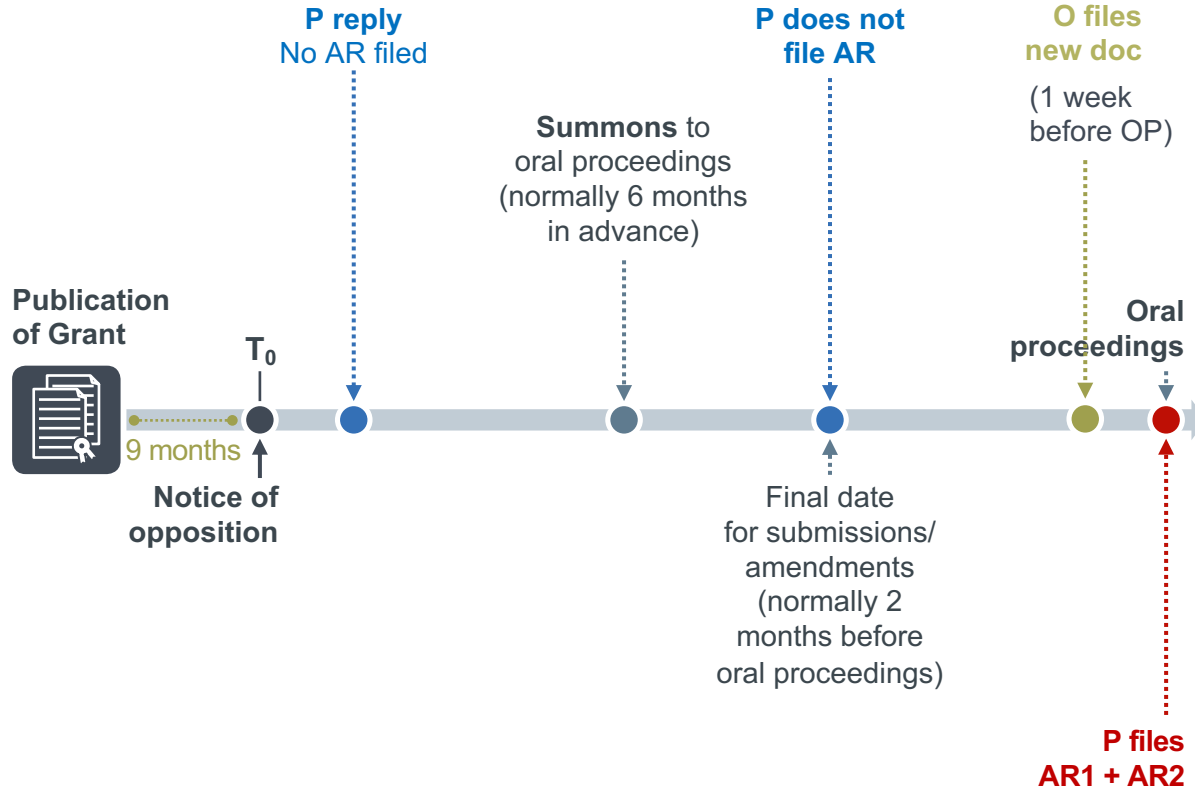


Will the OD admit the AR1 and AR2 into the proceedings?

Please vote



Case 3c



Will the OD admit the AR1 and AR2 into the proceedings?

If prima facie relevant new document will be admitted, and then

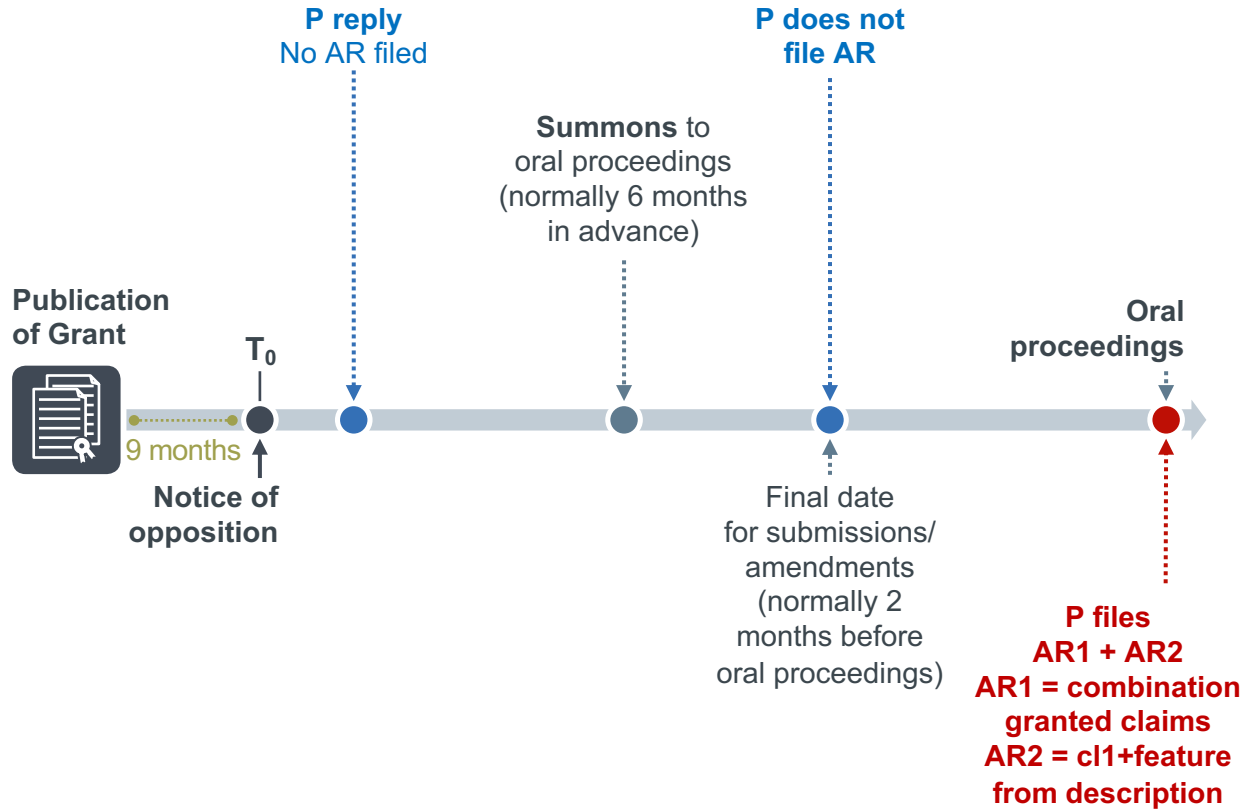
AR1 and AR2



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
- How will the OD react? Will the OD consider the AR as late filed requests or will admit them?
 - Will the OD accept **both** AR?
 - Will the answer be the same if **both** AR are based on granted claims?

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

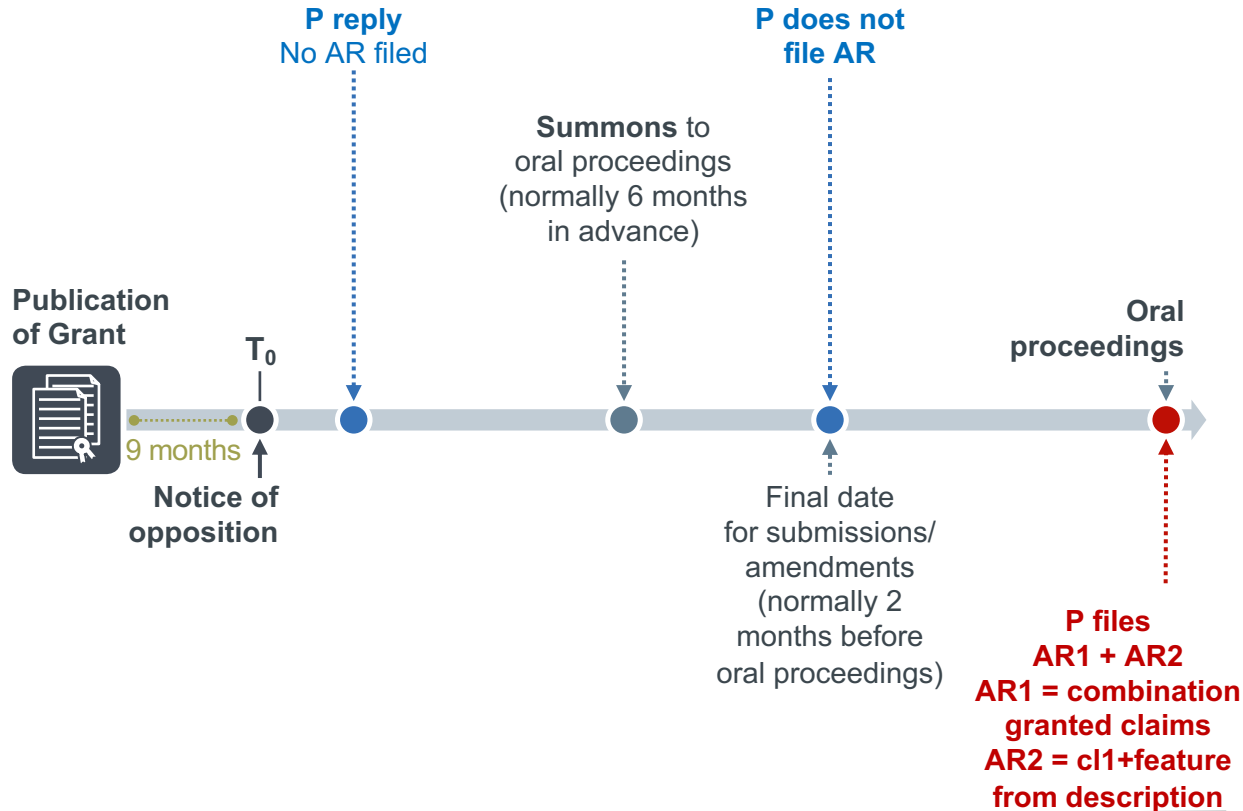
During OP, the OD comes to the conclusion that none of the requests on file is inventive

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

Case 4

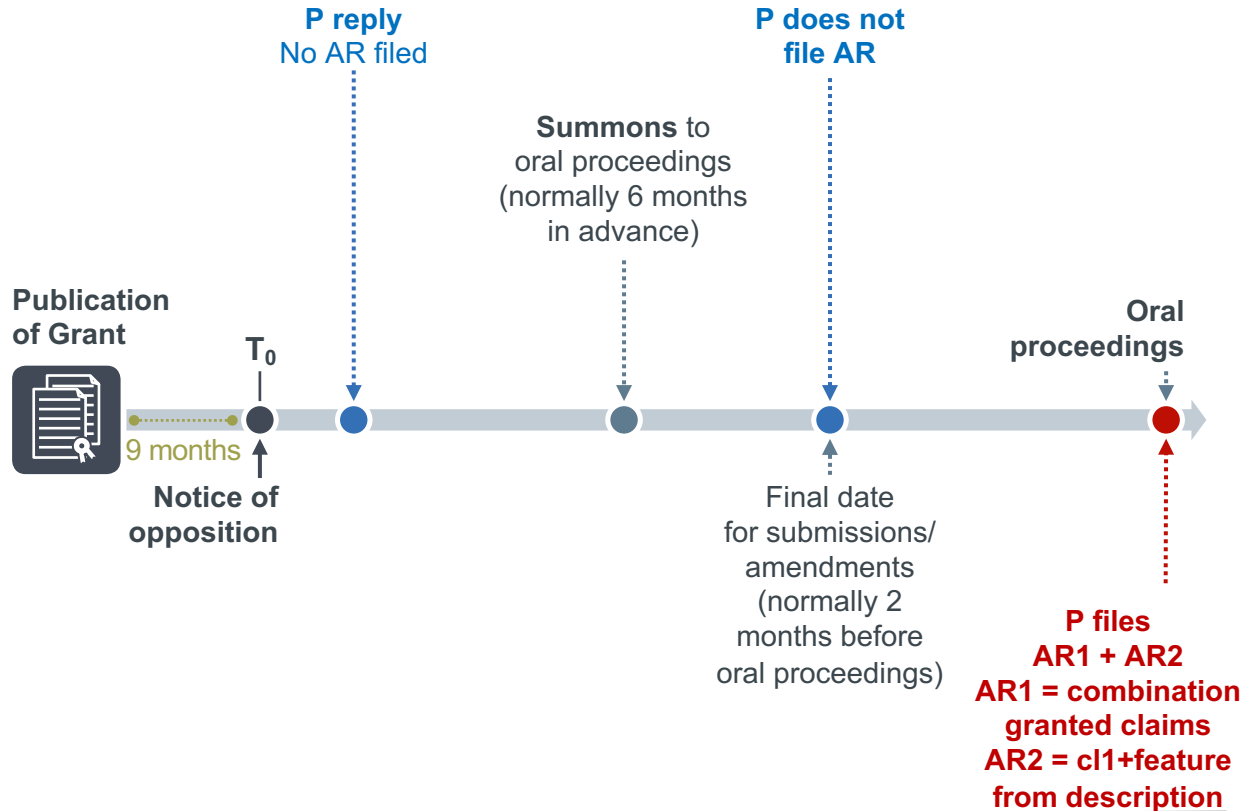


Will the OD admit the AR1 into the proceedings?

Please vote



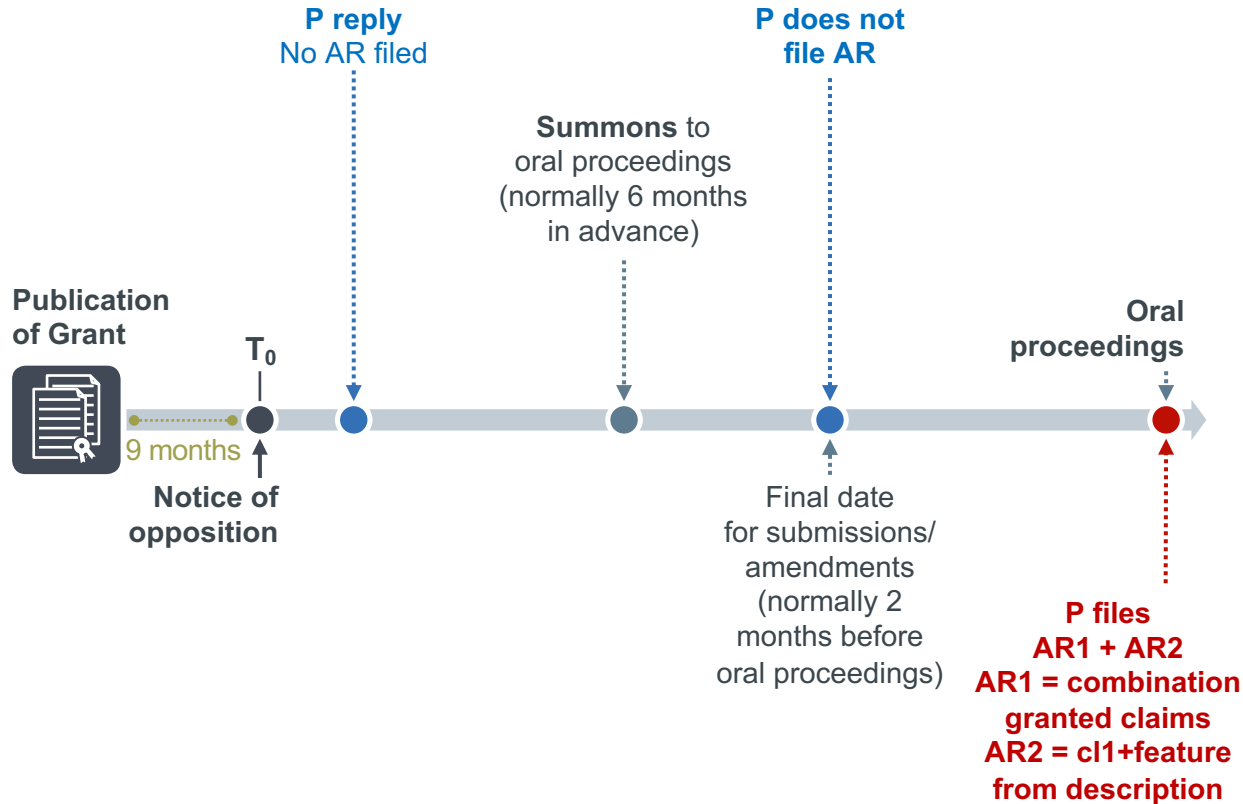
Case 4



Will the OD admit the AR1 into the proceedings?



Case 4

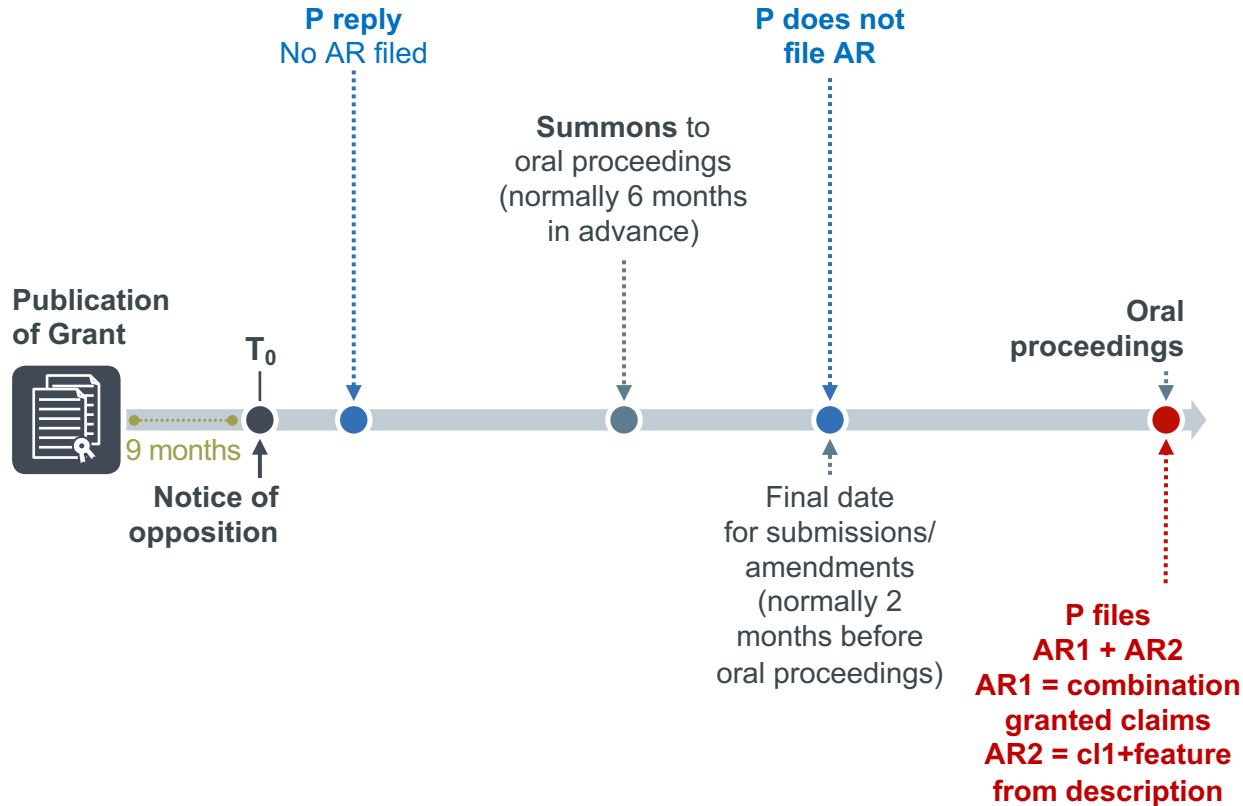


Will the OD admit the AR2 into the proceedings?

Please vote



Case 4



Will the OD admit the AR2 into the proceedings?



... unless special circumstances

...BUT...

if AR2 is based on granted claims

.....normally

