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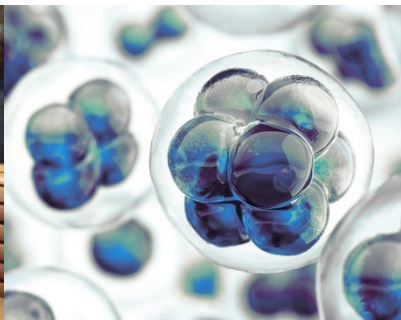
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Examination Matters 2021

How to overcome clarity issues efficiently



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Clearing the path to examination



How to overcome clarity issues efficiently

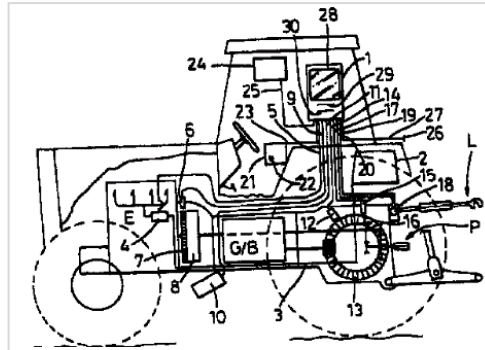
- During EPO examination proceedings (pre-grant)
- During EPO opposition proceedings (post-grant)

Presenter



Ricardo Oltra-García

- Masters in Engineering and in Physics
- Worked for Robert Bosch and John Deere
- Started at the EPO in June 2002
- Team manager
- Chairman in opposition, coach of newcomers

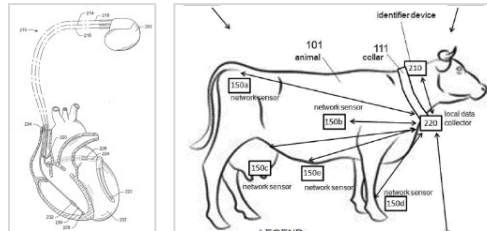


Presenter



Kris Loveniers

- Masters in Engineering and Biomedicine
- Worked for KUL and for Materialise
- Started at the EPO in 2003
- Team manager
- European Patent Academy, instructor for new examiners, CII working group



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

Agenda

- **Introduction**
- Clarity at the examination stage
- Clarity at the opposition stage
- Bonus question

Introduction




Do you often get clarity objections raised during procedure?

How many of you have ever had an application refused on grounds of clarity?

yes

no

 = yes

Introduction

Legal background (1/2)

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.

Introduction

Legal background (2/2)

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

Let's eat, children!

Let's eat children!

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

Agenda

- Introduction
- **Clarity at the examination stage**
- Clarity at the opposition stage
- Bonus question

Clarity at the examination stage

Some general principles



Clarity at the examination stage

Clear in themselves (1/2)

- 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.

EPC Guidelines, F-IV.4.2

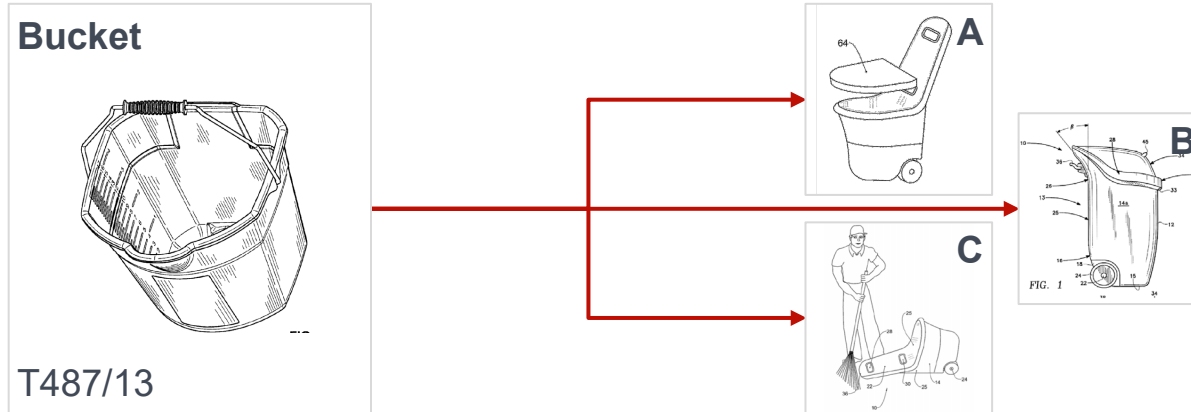
Clarity at the examination stage

Clear in themselves (2/2)



A **bucket**...characterised in that it is adapted for nested stacking and comprises at least two wheels at the back face.

POLL



Which is the correct interpretation?

- A, B or C
- Answer: A or B

Clarity at the examination stage

Essential features (1/2)



Example:

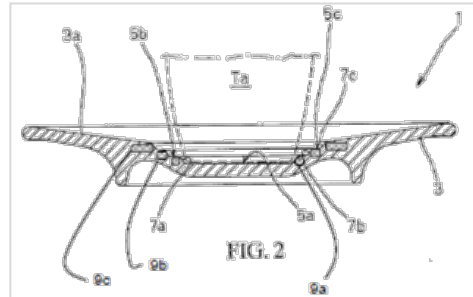
Description

- Plurality of concentric recessed portions [...]
- Problem = allowing to receive and firmly hold cups having different diameters

Claim 1

Saucer, wherein at least one concentric recessed portion is provided ...

Which essential feature is missing here?



CHAT

EPC Guidelines, F.IV, 4.5

Clarity at the examination stage

Essential features (2/2)



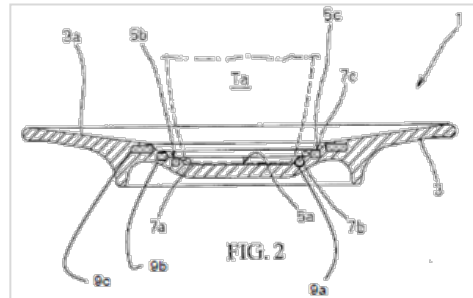
Example:

Description

- Plurality of concentric recessed portions [...]
- Problem = allowing to receive and firmly hold cups having different diameters

Claim 1

Saucer, wherein **a plurality of** concentric recessed portions **are** provided...



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"

"A wind resistant solar panel"

Acceptable,

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

EPC Guidelines, F-IV.4.10

Clarity at the examination stage

Functional features

Example

"Terminal position detecting means"

"Locking means"

EPC Guidelines, F-IV 6.5

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 (1/2)



Example:

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

Is this RtbA or Functional feature?

RtbA

Functional feature

POLL

Clarity at the examination stage

RtbA vs Functional feature (2/2)



Example:

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

GL, F-IV.4.,10 "The above-mentioned requirements for allowing a definition of subject-matter in terms of a result to be achieved differ from those for allowing a definition of subject-matter in terms of functional features".

Clarity at the examination stage

Claims that contradict each other (1/2)



Can you find the contradiction here?

Claim 1

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.

Claim 7

The method of claim 1 further comprising a mechanical penetrating probe, able to measure the electrical resistance of the soil at different depths.

ANSWERS VIA CHAT

Clarity at the examination stage

Claims that contradict each other (2/2)



Can you find the contradiction here?

Claim 1

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.

Claim 7

The method of claim 1 further comprising a **mechanical penetrating probe**, able to measure the electrical resistance of the soil at different depths.

Clarity at the examination stage

Adaptation of description

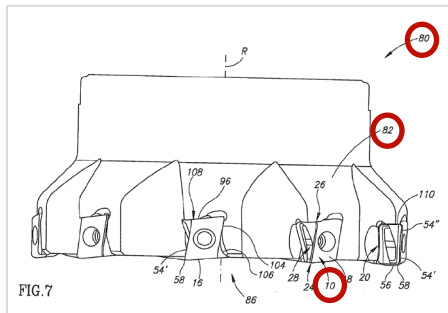
T1354/17

Claim

"A milling cutter (80) comprising... a cutting insert (10);
... a cutter body (82)..."

Description

"cutting insert *in accordance with (a first embodiment of) the present invention*"



In accordance with a first ^{cutting insert} embodiment of the present invention, in an end-view of the cutting insert the projecting abutment surface is generally rectangular in shape having two parallel long edges extending between two short edges, the long edges making an angle of β with the major plane P2.

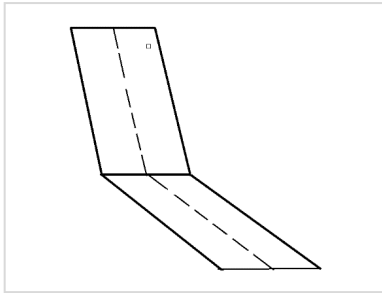
Clarity at the examination stage

Adaptation of description (+Support)

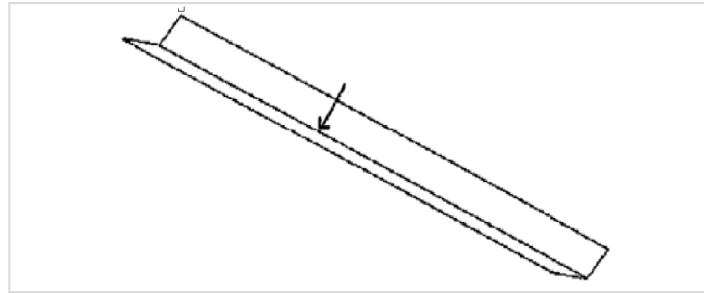


Claim 1

"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

What is the correct interpretation?

A

B

Both answers are valid depending on the interpretation.

POLL

Clarity at the examination stage

Clarity and CII (1/4)

- 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/functions;
not as merely suitable for carrying them out

EPC Guidelines, F-IV, 3.9

Clarity at the examination stage

Clarity and CII (2/4)

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).

Article 84 EPC

Clarity at the examination stage

Clarity and CII (3/4)

1. A method of determining oxygen saturation in blood in a **pulse oximeter**, comprising receiving in an electromagnetic detector first and second electromagnetic radiation signals ...
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.

ANSWERS VIA CHAT

Which clarity problem do you see (if any)?

Clarity at the examination stage

Clarity and CII (3/4)

1. A method of determining oxygen saturation in blood in a pulse oximeter, comprising **receiving in an electromagnetic detector first and second electromagnetic radiation signals ...**
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: this program would not work on my PC)

Clarity at the examination stage

Clarity and CII (3/4)

1. A computer-implemented method of determining oxygen saturation in blood in a pulse oximeter, comprising **receiving data representing first and second electromagnetic radiation signals acquired by an electromagnetic detector**.
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 which, when the program is executed by a computer, **cause the computer** to execute the steps of the method of claim 1.

(this method can be carried out by generic data processing means)

Clarity at the examination stage

Clarity and CII (4/4)

- Artificial Intelligence: Black Box?

- Example:

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

- Art. 84 EPC? Art. 83 EPC? Art. 56 EPC?

EPC Guidelines, F-IV, 6.4

Clarity at the examination stage

Exercise

How many clarity problems do you spot here?

ANSWERS VIA CHAT

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

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**

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

Agenda

- Introduction
- Clarity at the examination stage
- **Clarity at the opposition stage**
- Bonus question

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.
-

Is clarity a ground in opposition?

- Yes
- No, clarity is NOT a ground in opposition**

POLL

Clarity at the opposition stage

Claims are amended (1/4)

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 (2/4)

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.

EPC Guidelines, D-V, 5

Clarity at the opposition stage

Claims are amended (3/4)



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 claim 1 is amended with features taken from the description; and
3. Opponent objects to independent claim 7 on lack of clarity.

Can this objection be admitted?

Yes

No, this objection CANNOT be admitted (unless...)

POLL

Clarity at the opposition stage

Claims are amended (4/4)

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?).

G 3/14

Clarity at the opposition stage

Claims remain unchanged (1/5)



Is a clarity objection possible?

Yes

No

ANSWERS VIA CHAT

Clarity at the opposition stage

Claims remain unchanged (1/5)



Is a clarity objection possible?

Yes

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 (2/5)

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

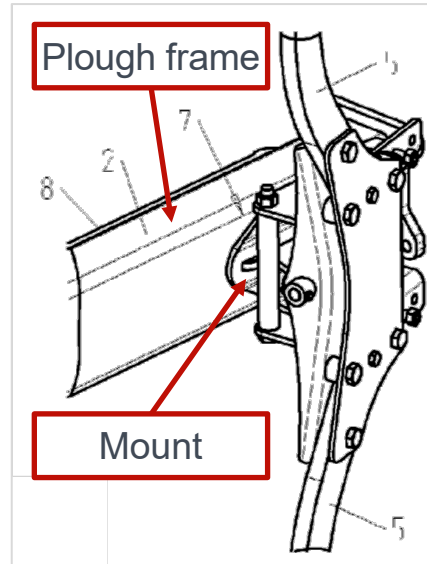
(iii) Art. 100 (a) / Art. 56 EPC (Lack of Inventive Step)

T 892/90

Clarity at the opposition stage

Claims remain unchanged (3/5)

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), [...] characterised 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.



EP2705738

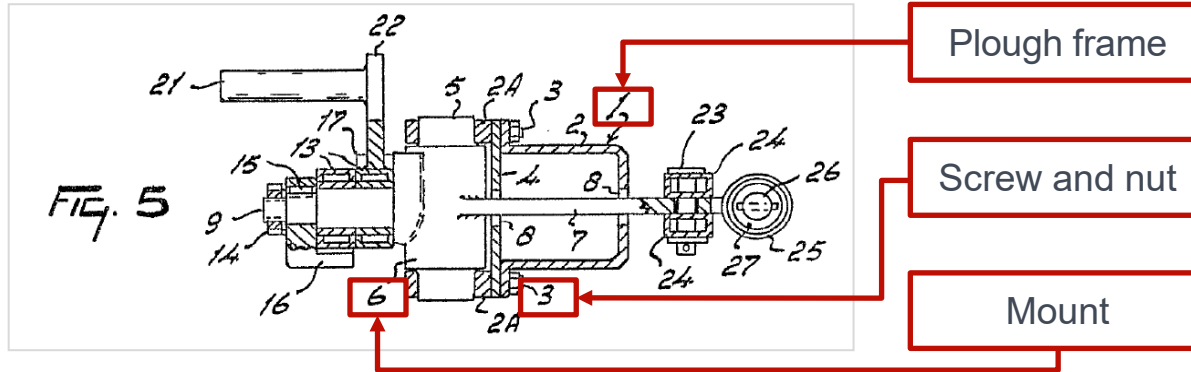
Clarity at the opposition stage

Claims remain unchanged (4/5)



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

POLL



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

- Mount
- Fastening means

Answer: Let's discuss!

Clarity at the opposition stage

Claims remain unchanged (5/5)

- After discussion it was accepted that the screw and nut were not part of the mount, but **fastening means**. Therefore an intention to grant was written;
- Opponent used the same document for a novelty objection, stating that the screw and nut were fastening means of the mount, and hence also **part of the mount**;
- 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

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- **Bonus question**

Bonus question



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

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

ANSWERS VIA CHAT