

# EUROPEAN PROSECUTION & OPPOSITION

An exercise in *hypertextualism*

# Hypertextualism

*Textualism* is a formalist theory of statutory interpretation, holding that a statute's ordinary meaning should govern. Its interpretation, as opposed to inquiries into non-textual sources such as the intention of the legislature in passing the law, The problem it was intended to remedy, or substantive questions of the justice and rectitude of the law



EPO reading of specification and claims .... **ONLY WORSE**

SUPPORT, SUPPORT,  
SUPPORT

# FOCUS

- ▣ Article 83 : sufficiency of disclosure
  
- ▣ Article 123(2) : “added matter”

# Article 83 EPC

*The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.*

# Rule 42(1) EPC

The description shall:

...

(c) disclose the invention, as claimed, in such terms that the **technical problem**, even if not expressly stated as such, and **its solution** can be understood, and state **any advantageous effects** of the invention with reference to the background art;

....

# Notes to the US practitioner

- ▣ Remember that the invention is put in terms of the problem-solution approach
- ▣ Invention is determined vis-à-vis the closest prior art
- ▣ What the inventor thinks he has invented is basically irrelevant in EPO

# Notes to the US practitioner

- ▣ Invention can change in view of prior art
- ▣ US practitioners do not like “characterizing the prior art”

# Rule 42(1) EPC

The description shall:

...

(e) describe in detail at least one way of carrying out the invention claimed, using examples where appropriate and referring to the drawings, if any;

....

# What to do with broad claims

- ▣ Are they sufficiently disclosed ?
- ▣ Article 83
  
- ▣ Are they sufficiently supported by the description?  
Article 84

# Article 84

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

# “Times They Are A- Changing”

▣ From

“one example is enough !”

to

“enough, to perform the invention **over the whole area claimed** without undue burden and without needing inventive skill” (T727/95)

# “Times They Are A- Changing”

- ▣ Depends upon the technology, obviously !

- ▣ Another route of attack

T939/92 Triazoles/ AgrEvo)

Show that inventive step applies over the complete range of the claim

# What's in and what's out

- ▣ When claim is defined purely by structural features, no issue with Article 83 versus Article 84
- ▣ When a claim has functional language, the distinction becomes less clear.
- ▣ Claims defined by a parameter that needs to be measured, it becomes even less clear

# “ The teeth of Article 83”

- ▣ During examination, the Examiner is handicapped
  - Limited time
  - Pro-patentee attitude of the EPO
  - No availability of technical means to verify the statements in the patent application

# “the teeth of Article 83”

- ▣ Article 83 : OPPOSITION
- ▣ However, EPO is stimulating now observations by third parties under Art 115 !! (see notice OJ 072011 concerning filing of third party observations)

# Shift in case law (old)

T 0960/98 (Unilever, opposed by L'Oreal, et al)

EP 485212 "DETERGENT COMPOSITIONS"

"A rinse off hair condition composition substantially free from anionic surfactant comprising:

- a) 0.05 to 5 % by weight of a cationic surfactant selected from ...
- b) 0.01 to 10 % by weight of an emulsion polymerised dimethiconol ...
- c) water, **wherein the viscosity of the dimethiconol lies in the range 1 – 20 million centistokes.**"

# Shift in the case law (old)

## Reasons 3.3

*In the absence of further specific indications, the claim implies that the skilled person will choose those measuring methods and apparatus, which according to the guidance given in the patent in suit are available to him and are most appropriate to meet their needs in the determination of viscosities.*

.... in other words, the person skilled in the art will figure it out.

# Shift in case law (new)

T0466/05 Merck & Co, Inc. v. SmithKline Beecham Biologicals SA

EP 497524 "Polysaccharide antigens from streptococcus pneumoniae"

## Claim 1

1. A capsular polysaccharide of Streptococcus pneumoniae having on average less than about 1200 repeat units per molecule and a polydispersity between about 1.0 and 1.4, a molecular weight between about  $1 \times 10^5$  and  $1 \times 10^6$ , and a level of contamination by pneumococcal group-specific C-polysaccharide below 3.0 % of the type-specific polysaccharide

# Shift in the case law (new)

## Reasons 4.4

...In other words, the necessity of identifying a population of polysaccharides exhibiting this specific molecular weight belongs to the core of the claimed invention.

## Difference between Article 83 and Article 84

## Reasons 4.7

However, the question at stake in the present case is not the question of the boundaries of the claimed subject-matter, but whether the lack of indications in Claim 1 in respect to the **core of the claimed invention** does not amount to an undue burden for the skilled person trying to reproduce the invention.

# Shift in case law (new)

T1072/06 Werner & Mertz GmbH v Sara Lee/DE N.V

EP 1000990 “Lederplegemittel”

Claim 1

Leather care agent which is substantially free from volatile organic solvents and contains an emulsion of wax, water and emulsifier, characterized in that, in the creep-recovery measurement as described in the specification, it exhibits a maximum deformation  $y$  of 0.1 or less when subjected to the effect of a shear stress of 750 Pa for 5 minutes, and a permanent deformation of not more than 50 % of the maximum deformation after 5 minutes' relaxation, in each case at a temperature of 23 °C.

# Shift in the case law (new)

- ▣ “aufgabenhaft”
- ▣ Referring to the problem that needs to be solved (desiderata claim)
- ▣ There the measurement is core to the claimed invention => attackable under Article 83 !

# Article 123(2) EPC

The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

# Amendments

- ▣ Unallowable if information is NOT DIRECTLY AND UNAMBIGUOUSLY DERIVABLE from what was previously presented by the application
- ▣ The Applicant does NOT have the benefit of the doubt in matters of Art 123(2)

# Amendments

- ▣ No “intermediate generalization”
- ▣ No “decontextualization”
  
- ▣ Feature only described in the context of a certain embodiment or example, not necessarily “exportable” to just any claim to amend the claim.

WHY DOES THIS MATTER  
NOW MORE THAN  
“YESTERDAY”

PROSECUTION

# Rule 137(5)

Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63.



“Abide by Rule 43, paragraph 2”



“Impossible to carry out a meaningful search”

# Rule 43(2)

Without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) **only if** the subject-matter of the application involves one of the following:

- (a) a plurality of interrelated products
- (b) different uses of a product or apparatus
- (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

# Rule 137(5)

- ▣ 2<sup>nd</sup> sentence applicable to applications for which a search report has been drawn up since April 1, 2010
- ▣ Objection under Rule 137(5) can be raised if a technical feature is taken from the description, which has an effect unrelated to the effects of the originally claimed invention(s)

# Notes to the US practitioner

- ▣ You have to make AMENDMENTS !!! when entering the European phase
- ▣ Less claims in general
  - Rules relating to Fees
    - Claims fee for the sixteenth and each subsequent claim = 210 Euro (~ \$ 300)
    - Claims fee for the 51<sup>st</sup> and each subsequent claim = 525 Euro (~\$ 750)

# Notes to the US practitioner

- ▣ Less independent claims (Rule 42(3))
- ▣ The best way to avoid amendments is to have the claims in the EPO format before entering into the EPO regional phase
- ▣ Please use the multiple dependent claims !!

WHY DOES THIS MATTER  
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OPPOSITION

# Article 100 (b) EPC

Opposition may only be filed on the grounds that:

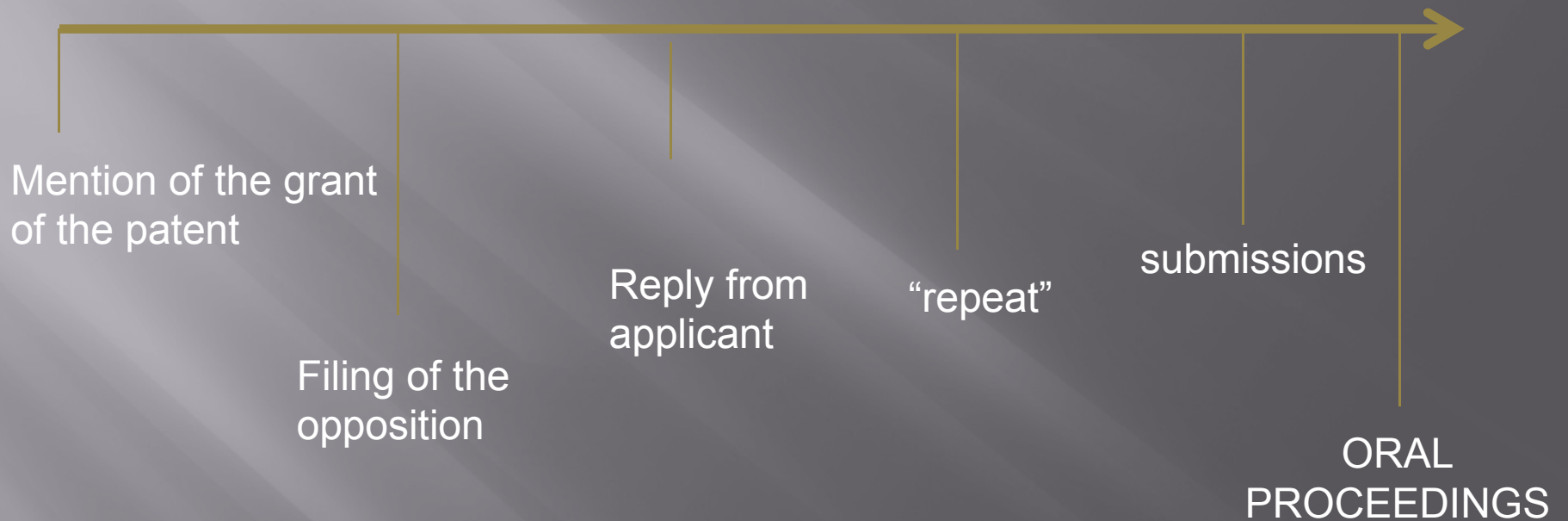
...

(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

# Article 100 (b) EPC

- ▣ Mimics the words of Article 83 EPC
- ▣ HOWEVER... Article 84 EPC is NOT a ground for opposition
- ▣ Initial burden of proof is on the opponent
- ▣ HOWEVER, once proven, the onus should shift back to the patent proprietor

# Opposition Procedure



# Oral Proceedings

- ▣ MAIN REQUEST
  - Article 123(2)
  - Article 100(b)
  - Novelty
  - Inventive Step
- ▣ AUXILIARY REQUEST 1
  - Article 123(2)
  - ....

# Oral Proceedings

- ▣ Opposition division uses the “salami technique”
- ▣ After every issue that has been argued, the opposition division will take a decision
- ▣ If Opposition division sides in that issue with the patent proprietor, up to the next issue
- ▣ Once, the Opposition finds 1 ground for revocation, it declares the patent revoked without looking at the other grounds for opposition !

# Oral proceedings

- ▣ Decision is taken at the end of the proceedings
- ▣ Amendments need to satisfy ALL articles of the EPC

# Conclusion

- ▣ Article 123(2) always has been a fearful weapon
- ▣ Article 83 is regaining some of its force

# Conclusion

- ▣ SUPPORT, SUPPORT, SUPPORT
- ▣ More “narrower” patents rather than a broad patent
- ▣ Use Article 123(2) and Article 83 as “artillery”

*That's it, folks !*

**QUESTIONS !**

**ANSWERS ?**