

For a kind attention of Mr. Paolo Rambelli, the Chair of Professional Education Committee (PEC)

## EPPC Thematic group Mechanics of the epi – **Topics proposed for possible epi webinars**

### Clarity/Added subject-matter

There is sometimes some misunderstanding between the applicant and the examiner (or examining division) about the meaning of some terms, even if the term is defined in a dictionary. Clearly such misunderstanding may occur, when the meaning of the terms is not (yet?) well established.

There are at least two options to try to overcome this problem:

1) Add additional clarifications to the claim to make it more clear. However, sometimes the examiner indicates that the additional clarifications pose a problem of clarity, for one reason or another. Most often a purpose of such clarification is not to limit the claim, whereby their meaning may be considered unclear. However, removing the additional clarifications may be hard in view of added matter.

2) Write the clarifications to the description and add them in due course. However, in such case the question is, whether the additional clarifications have been presented only in a certain context, or can they be regarded as a general teaching applying to all embodiments.

A third option of using clearer wording without the additional clarifications of point (1) seems not possible, since even the meaning given in a dictionary cannot be relied upon.

Based on discussions with EPO directors and examiners during the 2019 meeting with the EPPC Mechanics group, our impression is that the EPO is not keen on having a “EPO-dictionary” for some commonly used phrases.

**Thus, both these options seem to have their own problems. Some kind of guidance would be beneficial.**

We are aware of the webinar directed to clarity, which was organized this year by the epi - it was called “Clarity at the EPO: G3/14”.

However, our present suggestion is more directed to a webinar giving practical advice on clarity issues than a discussion of case law.

### Claim Drafting, especially in the field of mechanics

We would enjoy a webinar on claim drafting, especially in the field of mechanics. Maybe also an additional webinar for claim drafting in the field of chemistry could be nice.

The webinar should be directed to patent attorneys with some experience in claim drafting. The presenter could be a mixed EPO/epi-team. For example, the EPO-presenter could present some

common mistakes / bad examples of claim drafting in the respective field and a suggestion could be made by both presenters.

From the 2019 meeting of the EPPC Mechanics group with the EPO, we remember that such drafting seminars have been already held in the past but we do not know the presenter.

### Financial supports designed to filing European patent applications and/or processing with the EP applications

A lot of SME clients are interested in financial support designed at least for filing European patent applications.

We as professional representatives have observations that inventors and companies find EPO fees unaffordably high.

They as the users of the European patent system are indeed convinced that the EPO fees are too high and that the situations in which they receive discounts are few.

Additionally, they claim that conditions which are necessary to fulfill in order to be granted the financial support lack coherence from one institution to another, and from one country to another.

**Although there are some unharmonized national schemes supporting some patenting activities, it would be interesting to get some concentrated information on the best generally available financial support schemes for SMEs and individuals.**

Related to this issue are the costs involved with attorney work in the EPO proceedings.

For example, during the 2019 meeting of the EPPC Mechanics group with the EPO, we have discussed with the EPO about amendments to description already in an early phase of examination.

Particular costs related to such work seem to be annoying to applicants, since there is no guarantee that a patent will ever be granted.

**It would be appreciated to ask the EPO potential speaker about whether in the course of examination the EPO examiners take into account the financial aspects of the patent proceedings they create for every individual EP application case, and if yes then how they deal with these issues.**

The topic is of utmost importance as the financial issues of the European patent system are the core issues of the whole system.

### “Mixed-type inventions”

In the last 2019 meeting in person of the EPPC Mechanics group with the EPO, we had a very interesting discussion concerning “mixed-type inventions”, with particular reference to the assessment of inventive step.

The Minutes of said portion of the meeting are copied below.

\* \* \*

a. Inventive step Art. 56 EPC / Problem-solution-approach Art. 56 EPC

*Ms. Elisabetta Papa (IT) posed the issue of “mixed” type inventions defined cumulatively by technical and non-technical features and requested for clarification on how the examiners separate technical and non-technical features, which is especially crucial for formulation of the objective technical problem when problem-solution-approach is applied to check the inventive step requirement under Art. 56 EPC.*

*The discussion for this topic started with the presentation delivered by Mr Roberto Vacca – Director Operations Mobility & Mechatronics on two interesting exemplary patent applications in which independent claims comprised both technical and non-technical features. The presenter mentioned again that nowadays more than a half of the patent applications include CII aspects, which results in the need to examine every patent application individually and with dedicated attention.*

*During discussion about the exemplary patent applications Ms. Raluca Vasilescu (RO) observed that when drafting the patent application the wording of the claims including names of structure elements and assemblies and functions of means applied is for the inventions with CII and AI aspects even of higher importance than in other patent applications. For instance, as presented in one of the exemplary patent applications “inferring system” is a guess even if an educated guess while “calculation system” is not a guess and that is why with the latter wording the patent application could probably avoid objections from the EPO side. This observation was confirmed by the presenter.*

*It was further noted that the closest prior art document shall be connected with the technical contribution of the invention under examination and the prosecution shall go in the direction of the technical features of the invention and not of the non-technical ones.*

\* \* \*

In the meantime, discussions have been in place concerning the definition of “person skilled in the art” and “common general knowledge”, particularly as to the issue whether or not they should also be aware of / comprise non-technical notions.

**We think that this may be an interesting issue for the epi seminar.**

Speaker from within epi could come along with an interesting agenda together with an EPO Examiner as “sparring partner”.

## Priority at the EPO

We are aware of the epi seminar entitled “Priority at the EPO” and delivered in the summer time of 2019.

However, the subject may be further investigated by gathering related sub-topics or related issues.

One of them could be the following issue of interests for the professional representatives before the EPO, namely:

How does the EPO search (upon application) takes place when there are several priority applications with different application dates? Would the EPO assess the dates of the indispensable technical features of claims in the EP application in the light of the priority dates?

**We would appreciate to receive some guidelines on how the search examiners are dealing with the above issue.**

### **Problem-solution approach before the EPO**

How should one respond to EPO communication (94(3)) during examination in which the examiner does not use the problem-solution method when referring to the obviousness of the invention, but basically states that this is self-evident (in the light of combined documents alone or together with common knowledge)?

### **Phone Consultation with the examiner**

How to prepare for a telephone conversation with an examiner about ambiguities in a 94(3) communication: if the applicant would like to receive a more detailed or clearer submission of the examiner's opinion ?

### **Article 83 EPC / Sufficiency of the invention disclosure**

When an invention should be considered sufficiently and clearly disclosed and when the specification would be considered too abstract?

### **Article 82 EPC / Single general inventive concept**

How to properly interpret Art. 82 when a set of claims comprises several independent claims (in different categories or in the same)?

*collected and slightly reworded by Katarzyna Lewicka and Eva Carlsson,  
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