

**Notes in preparation to Mechanics Group e-meeting on March 2<sup>nd</sup>, 2021  
15:00-16:00 hrs CET**

**after Technical meeting epi – DG1 / 12 February 2021**

Steve Rowan – organizer, Vice-President EPO, DG1  
John Beatty - Director - Procedural Support  
Roberta Romano-Götsch COO Healthcare, Biotech and Chemistry  
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**1. Oral proceedings and Covid**

**2. Interpretation, clarity and sufficiency**

The role of the skilled person and of common general knowledge. There is a perception that the Boards of Appeal are more generous than the first instance

An issue is that clarity requirements are not uniformly applied within the EPO and in consequence the amount of clarity objections very much depend on the technical field.

Given that the clarity requirement already existed years ago, the point raised by our colleagues regards the actual trend: increasing number of clarity objections.

There is frequently the impression that "clarity" is sometimes used as a veil for an objection of unease of claim broadness.

One of example is the term "crystallization" which was meant to be unclear according to the examiner. It's a basic process technology covered in basic courses and mastered by humanity since salt has been obtained from the seas. It is extremely difficult to discuss with examiners who refuse to accept basic curriculum terms.

Most of the discussions in oppositions are actually about undesirable scope which should not be the case. However, sometimes the debate is used to make the claim look broader than it is for easier attack. A very significant problem is the following: the Boards' jurisprudence says, in a nut shell, that the claims are to read as they would be read by a person skilled in the art based on their wording. The description is not normally taken into account. Practised like this by Examiners. But in national proceedings it would be. For instance, the claim might say "protein-free" but the description says "protein-free means that amounts of recombinant proteins ... can be contained". The latter would typically be ignored in the assessment of patentability in the EPO but not, e.g., in German litigation. This is not useful.

The skilled in the art person shall understand a specific term used in claims over the description and the common knowledge.

It is about the skilled person who reads the claim with the intention to understand the technical meaning. This willingness often seems to be missing when reading clarity objections.

From an opposition division point of view a lot of the discussion is actually about what the claim scope is. This is often related to a (potentially) unclear granted claim. There are often quite different interpretations about the meaning of the claim from the parties - whether these views are honest and objective or driven by a desire to win the case on novelty or inventive step is another question.

Clarity is not so much as a concern for the opposition division or courts because they have the option to decide on what the terms means. Third parties however do not have that luxury.

Third parties have to decide for example whether to make investments depending on what the claimed scope means. So clarity remains important.

Doing a FTO and finding an "apparatus" or "power tool" can make interpretation of relevancy much more challenging.

Did not the EBoA say (paraphrased a bit) in G 3/14 that one of the reasons for clarify not being a ground of opposition is that you can endlessly debate about it. So, they basically said: "if clear enough to the skilled person, it is OK" – they did not require an absolute up-to-the-hilt clear claim?! So, should the examining division also not use a "sufficiently clear" approach rather than "absolutely clear without any possibilities for different interpretation" approach. (Balance of probabilities is the common principle in the 1st instance in most substantive aspects)

G 3/14, reason 69: "It seems likely that it was also thought unwise to enable an opponent to assert (perhaps numerous) clarity objections in opposition proceedings and thus delay them, although this cannot be said with quite the same degree of confidence".

Positive examples in Guidelines of "clear enough" would be helpful.

The claim terms should be understood with their normal meaning, not with some unusual meaning which the applicant has included in the description.

Good point on understanding the invention before looking to whether it is clearly expressed. If you start with linguistic rather than technical analysis you are heading for trouble.

### **3. Effect of new RoPBA**

Has the introduction of the new RoPBA had any adverse effects on the proceedings in DG1?

The number of aux requests has been increased by 20% since 2017. Has also the LENGTH of the requests been increased / the total number of pages - as each requests needs to be substantiated to be admissible (so, every aux req needs full nov and inv step arg)?

Many new requests filed on the day of the proceedings may result in not admitting them.

An epi member reported that an opposition division said in the oral proceedings that they would not proceed unless particular auxiliary requests are withdrawn.

It was agreed on in the meeting that the opposition division cannot force someone to withdraw claims without a severe violation of procedural rules. Swapping the auxiliary requests may be possible during the proceedings instead of withdrawing them.

#### **4. Search reports and examination reports lacking reasoned objections**

Are the requirements set out in T697/17 not being followed?

EPO speaker said that based on commonly heard users' feedback, the EPO elaborated prescriptions for search and examination examiners.

Complete search reports shall cite all relevant docs and cover all claims. Coverage of all dependent claims in search report and written opinion is now obligatory for examiners. Core of the invention should be searched as well as the claims.

More interviews and phone consultations are encouraged.

Communications should be complete that is should address all claims and objections. Only additional post-filing date citations should be brought forward during examination phase.

Objections should be clear and substantiated and more suggestions for overcoming objections raised, e.g. Art. 84 and 123(2) EPC.

During the opposition proceedings – inconsistencies between examining and opposition divisions, mainly Art. 123(2) EPC, shall be avoided.

It is essential that the opposition divisions deliver high quality summons, decisions and minutes.

It was emphasized that the EPO recommended to examiners and members of the opposition divisions to avoid over-formalistic approaches to Art. 82, 84, 123(2) EPC.

#### **5. Providing input to DG1 – feedback not complaint etc.**

374 complaints in 2020 and constant increase within last years

49% complaints from private entities like inventors, third parties

56% complaints justified or partially justified

23% complaints from Mechanics & Mechatronics in 2020

155 of these complaints appeared to be justified.

The EPO is currently working on a tool allowing giving “feedback” not only “complaints”. This enables also positive feedback. A difference between feedback and complaint is also that a feedback does not necessarily require a reply. For a complaint, a response will be sent within 20 days.

EPO speaker encouraged to send them proposals for improvements and to phone consultations.

It would also be convenient and advantageous for the EP system if there is an intermediate: during search, possible communication with the search examiner and request to him/her to discuss the case at the search stage with his/her (future) division.

It was confirmed that the EPO is working on development of the early division collaboration.

That may e.g. then result in extending the search if only clarity was addressed but not novelty and inv step - still in search and not (at quite an additional cost for the applicant) only during examination.

A "positive" search opinion must also be agreed upon by the chairman of the examining division to avoid disappointment at examination stage. Only 54(3) docs could show up, thus the effort on early classification (convergent efforts).

## **6. Colour Documents**

If colour documents are filed in opposition, the copies of the documents in colour can be obtained from the EPO, in online file inspection and Register the black-white versions are available. The same applies to priority documents and any documents or drawings filed.

This feature to identify where there is a colour drawing is not yet available in on-line file inspection;

however, normally there is a sign for a model in the public file inspection when there are colour documents.

## **7. EU Commission IP action plan**

Any views of the EPO on that? Direct/indirect impacts for EPO foreseen?

### **Third Parties Observations by Suzanne Herrera**

Acceleration of the European procedure is automatic in the case when the TPOs are filed. Therefore, the public uses TPOs as a means to accelerate the proceedings.

EPO receives about 1700 TPOs per year.

TPOs bring new perspective to examiners on subject-matter inventions as they present new objections and new prior art, and all recent TPOs are substantiated.

New prior art often comprises non-patent literature and "exotic" documents like brochures, dissertations, presentation, etc.

The vast majority of objections raised in TPOs concern Art. 54(2) and 56 EPC requirements, and then Art. 84 EPC.

In about half of the cases, after filing TPOs amendments are entered into claims. There are also some withdrawals due to TPOs.

TPOs are a sign of the technical and business significance of applications. When TPOs are filed, the applications are of higher likelihood of being granted patents, but these applications are also 10 times more opposed then.

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**4.1. Criteria for the application of Rule 63(1) EPC**

**A question about “or” clauses in claims**

It was noted that percentage of clarification requests from search divisions on EP searches has decreased since 2018 up to 2020 in M&M field.

Among clarification requests, about 60% to 80% constitute requests under Rule 62 EPC, about 10% to 30% constitute requests under Rule 63 EPC, and about 5% to 10% constitute requests under both Rule 62 and Rule 63 EPC.

**4.2 Criteria for the application of Rule 62a(1) EPC**

**Multiple independent claims in the same category**

**4.3 Use of “and/or” in claims**

“or” OK while “and/or” still frequently used. Although “or” is not understood as a mathematical “xor”, applicants are regularly using the expression “and/or”.

Examining divisions remark a frequent use of “and/or” in dependent claims entered in order to reduce their number under 15, e.g. when entering the European phase of PCT applications.

“and/or” expression does not prevent the recognition of a non-unity objection under Art. 82 EPC in a single independent claim.

However, this requirement is not applicable in opposition proceedings acc. G 1/91.

“and/or” expression is sometimes used in the single independent claim in order to avoid from the search division invitations under Rule 62a EPC or Rule 43(2) EPC.

The repetition of “and/or” expression in a claim may lead to an exponential growth of the number of feature combinations to be searched, which may provoke the search examiner to issue invitation under Rule 63 EPC.

The repetition of “and/or” expression in a claim may also lead to objections under Art. 84 or Art. 123(2) EPC “and” or “or” combinations of features are not supported by the description.

All dependencies demanded in claims shall be supported by the original description.

According to the EPO number of communications under Rule 62 and Rule 63 EPC has been decreasing since 2012 in M7M field.

The EPO asks for providing them with cases of “problematic” examiners!

However, at the moment no separate feedback tool is available, only complaints at the link below

<https://forms.epo.org/service-support/contact-us/formalcomplaint-form.html>

EPO members encouraged to write them an email or contact by phone call to draw their attention to any “problematic” case, namely

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## Other issues

### **In the course of the opposition proceedings – significant change in the opinion on the invention patentability at the side of the opposition division**

as Martina pointed out:

Regarding quality of the preliminary opinion before oral proceedings, it happens quite often that the opinion of the Division presented in the decision made at the end of the oral proceedings significantly differs from that presented in the summons for oral proceedings, and also the course of the oral proceedings differs from that which would reasonably be expected over objections and argumentations of the preliminary opinion.

Sometimes, during oral proceedings the member of the Division do not even give any hint that they changed their view but it is obvious when the decision is made. They just let the parties bring forward their arguments (there were no new arguments) and, then, made a decision that was contrary to the preliminary opinion.

Judging from the decisions made, the opposition division seemed to have completely changed their preliminary views - without that new arguments or facts had been brought forward in the meantime. It seemed that the preliminary opinion are drafted only by one member of the Division and are not discussed with the other members at that time.

The reason for that may lie in that the preliminary opinion as presented in the summons is elaborated at the beginning of the opposition proceedings and then close to the oral proceedings the Division change their opinion on the invention patentability during preparatory phase before the oral proceedings.

This course of actions at the side of the Division leads to not fair way of the proceedings, obviously is harmful to the economy of the opposition proceedings and in the end affects negatively all parties involved.

It was conveyed to the EPO speakers that if the Division change their opinion it shall certainly be presented to the parties asap and in good advance of the oral proceedings, e.g. 2-3 days upfront, to give the patentee a chance to focus on the critical issues and present then a new set of Auxiliary Requests, and the opponent party to prepare adequately to the oral proceedings.

Otherwise, especially the patentee is taken by the Division by surprise and his efforts in elaborating Auxiliary Requests in response to the earlier preliminary opinion are mostly useless.

The EPO speakers explained that the preliminary opinion as presented in the summons is drafted by the first member only, but the opinion is checked by the chairman and also signed by the chairman and the second examiner. So the chairman should have a responsibility for the opinion. However, an intense discussion of the case at that time is not possible due to efficiency reasons.

It was agreed on that the chairman should at least tell the parties during the oral proceedings when the opinion changed. It is not clear if noticing the parties a few days before the oral proceedings is possible or would lead to other problems.

The idea from Eva was to formulate the preliminary opinion in more open form to reserve a space for any alternative developments of objections and arguments to be then confirmed by the Division close to the oral proceedings.

### **Communication under Rule 71(3) EPC and amendments by the examiner**

Sometimes the amendments proposed/entered by the examiner in communication under Rule 71(3) EPC are not acceptable by the applicant and create a risk for further “added-subject matter” objections or other objections.

epi speakers asserted that it would be useful and efficient for the proceedings to receive upfront a phone call from the examiner in order to settle amendments acceptable by the examiner and the client.

EPO speakers confirmed that indeed in M&M and ICT fields amendments by the examiners are very frequent both in claims and in description.

For example, in 2019 in M&M field only 8% of cases did not comprise amendments by the examiner in communications under Rule 71(3) EPC. Among cases with amendments by the examiner the majority are amendments in claims, which do not change the scope of the claims, however, there are indeed also amendments which change the scope of the claims including these that are not in compliance with Guidelines.

*prepared by Katarzyna Lewicka, February 17<sup>th</sup>, 2021  
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