

Patent Disclosure Meeting Expectations – EP point of view

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Legal Basis

Art 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.

Art 83 EPC

- Sufficiency of disclosure is assessed on the basis of the application as a whole
- Can person skilled in the art put the invention into practice ?
- Common general knowledge → NOT directly and unambiguously derivable

Art 83 EPC

- Indication of at least one way to carry out the invention (= Rule 42(1)(e) EPC)
- Invention to be performed over the whole range claimed

Legal Basis

Art 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.

Art 123(2) EPC

- Relevant: disclosure of the invention in the description, the claims and the drawings, but NOT the abstract
- Disclosed is what any person skilled in the art would consider necessarily implied by the application
- Clearly and unambiguously derivable
- Drawings: clearly, unmistakably and fully

Art 123(2) EPC

Areas of concern

- Identical disclosure ✓
- Identical wording
 - Different context
 - Non-disclosed combination
- Different wording
 - Same feature in other words
 - Translation issue
 - Equivalents

Art 123(2) EPC

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 - Deletion of feature from claim → only if not essential feature

Art 123(2) EPC

- Different context
 - Deletion of feature from claim → only if not essential feature
 - Beware of Rule 43(3) EPC: any claim stating the essential features of the invention ...

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 - Specific selection from broad range

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Art 123(2) EPC

- Different context
 - Non-disclosed combination
 - Specific selection from broad range
 - Concept of ***intermediate generalisation***
 - Undisclosed combination lying somewhere between an originally broad disclosure and a more limited specific disclosure (T 1408/04, T 879/09)

Art 123(2) EPC

- Other wording
 - Translation issues
 - Equivalents: no inclusion

Some examples

Tip rack example

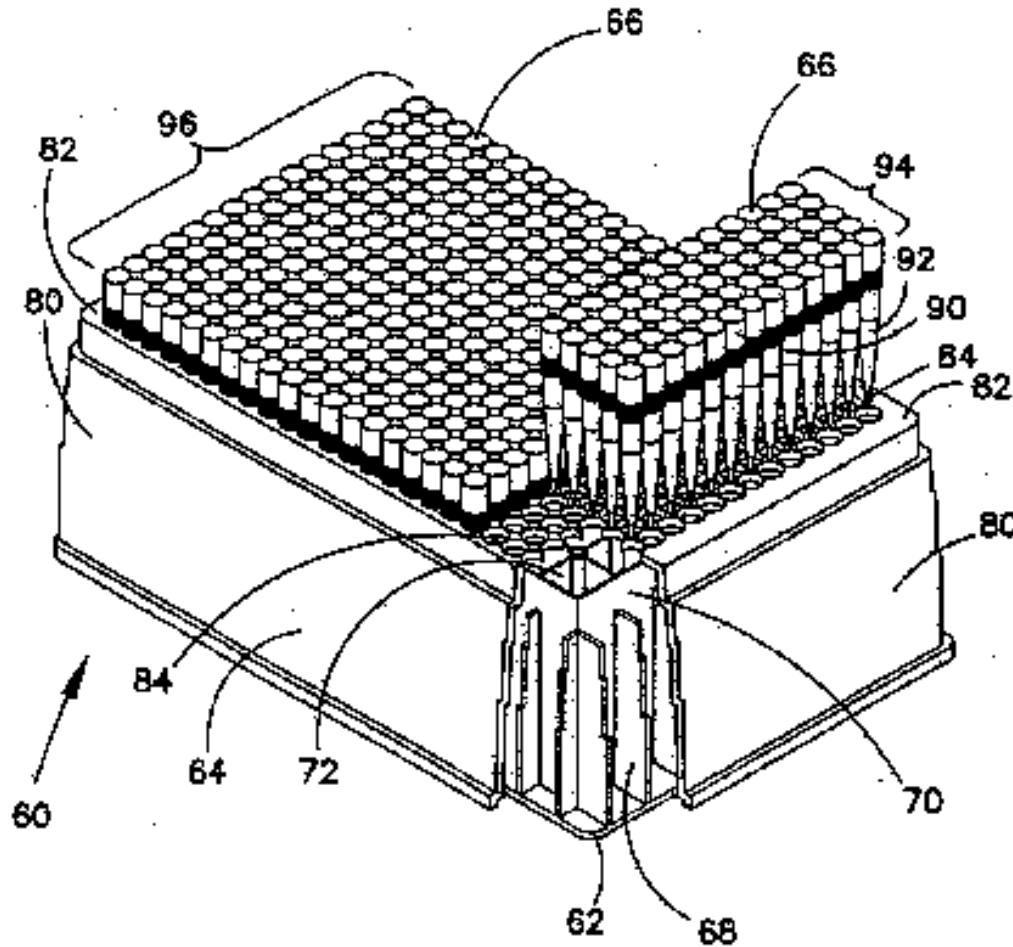
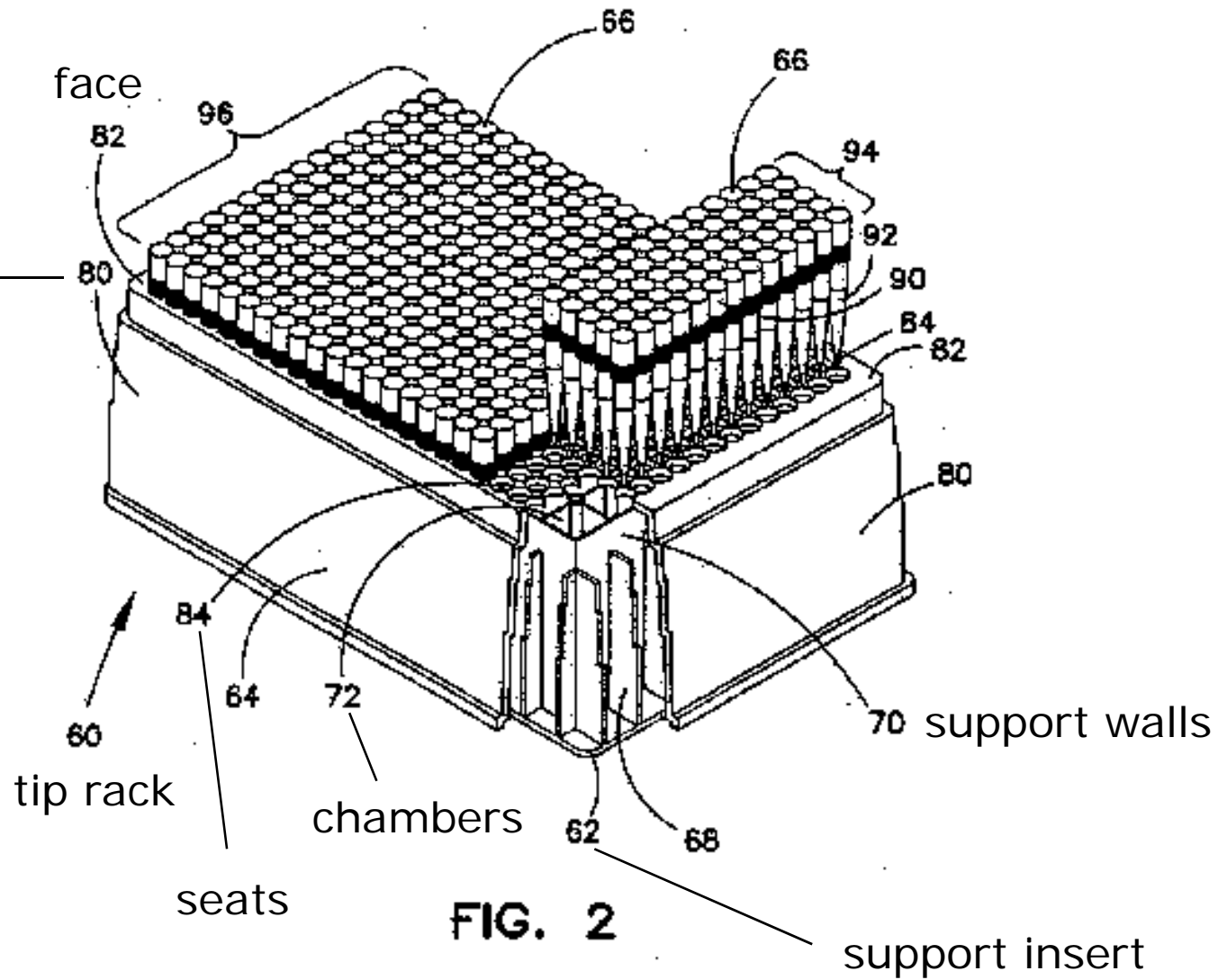


FIG. 2

Tip rack example

side wall



Tip rack example

Claim 1

A tip rack for holding a plurality of pipette tips, ...
a face having a plurality of seats formed thereon
for holding pipette tips
at least one sidewall depending from the face ...

Tip rack example

Claim 2

A tip rack according to claim 1 wherein the face and the at least one sidewall form a one-piece conductive outer shell, and the tip rack further comprises a support insert connected to the conductive outer shell such that the support insert is covered by the conductive outer shell.

Tip rack example

Claim 3

A tip rack according to claim 2
wherein the support insert comprises a plurality of support walls that form chambers dimensioned to receive the pipette tips.

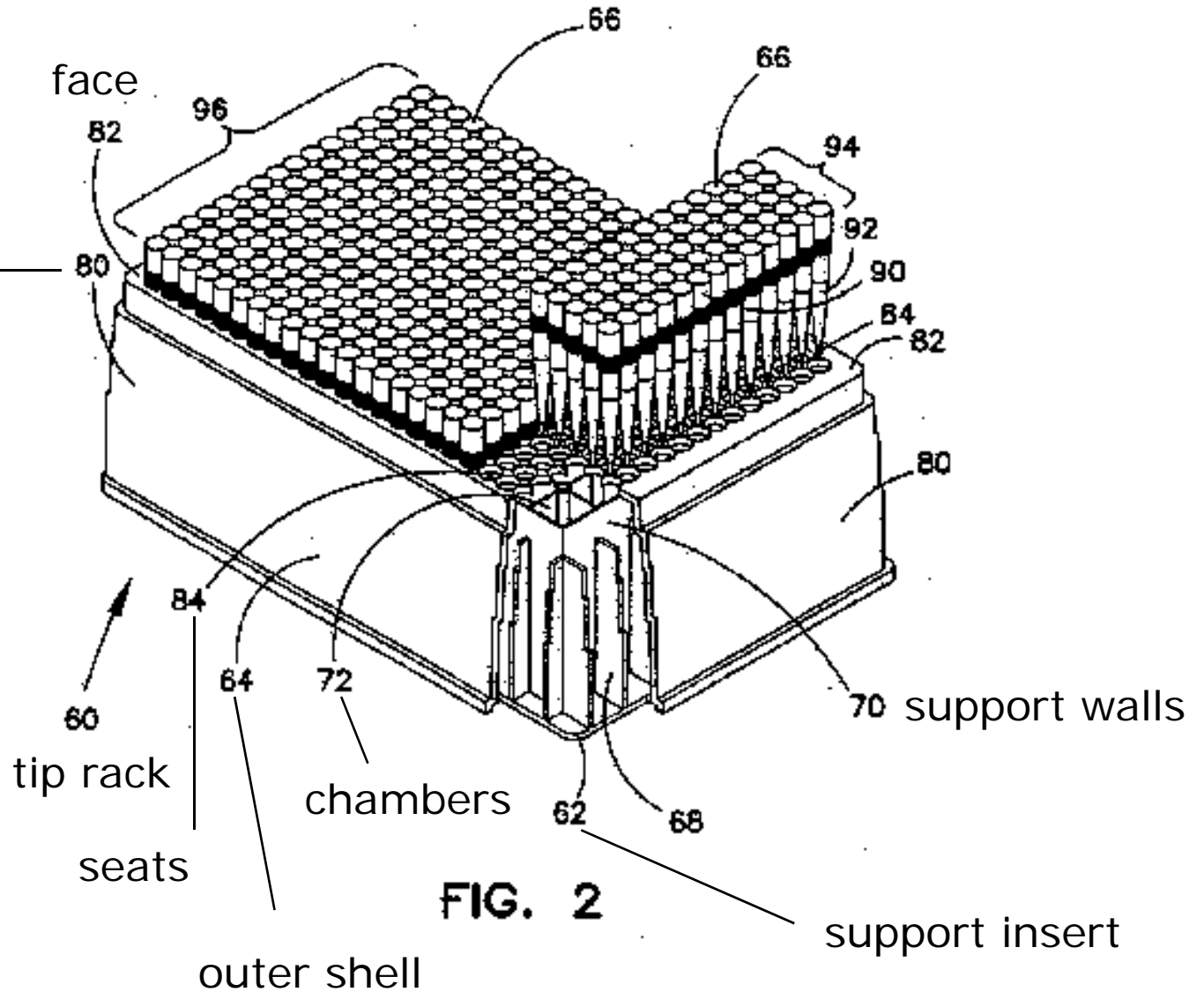
Tip rack example

Main request

A tip rack for holding a plurality of pipette tips, ...
a face having a plurality of seats formed thereon
for holding pipette tips
at least one sidewall depending from the face ...
wherein the tip rack comprises a plurality of
support walls that form chambers dimensioned to
receive the pipette tips.

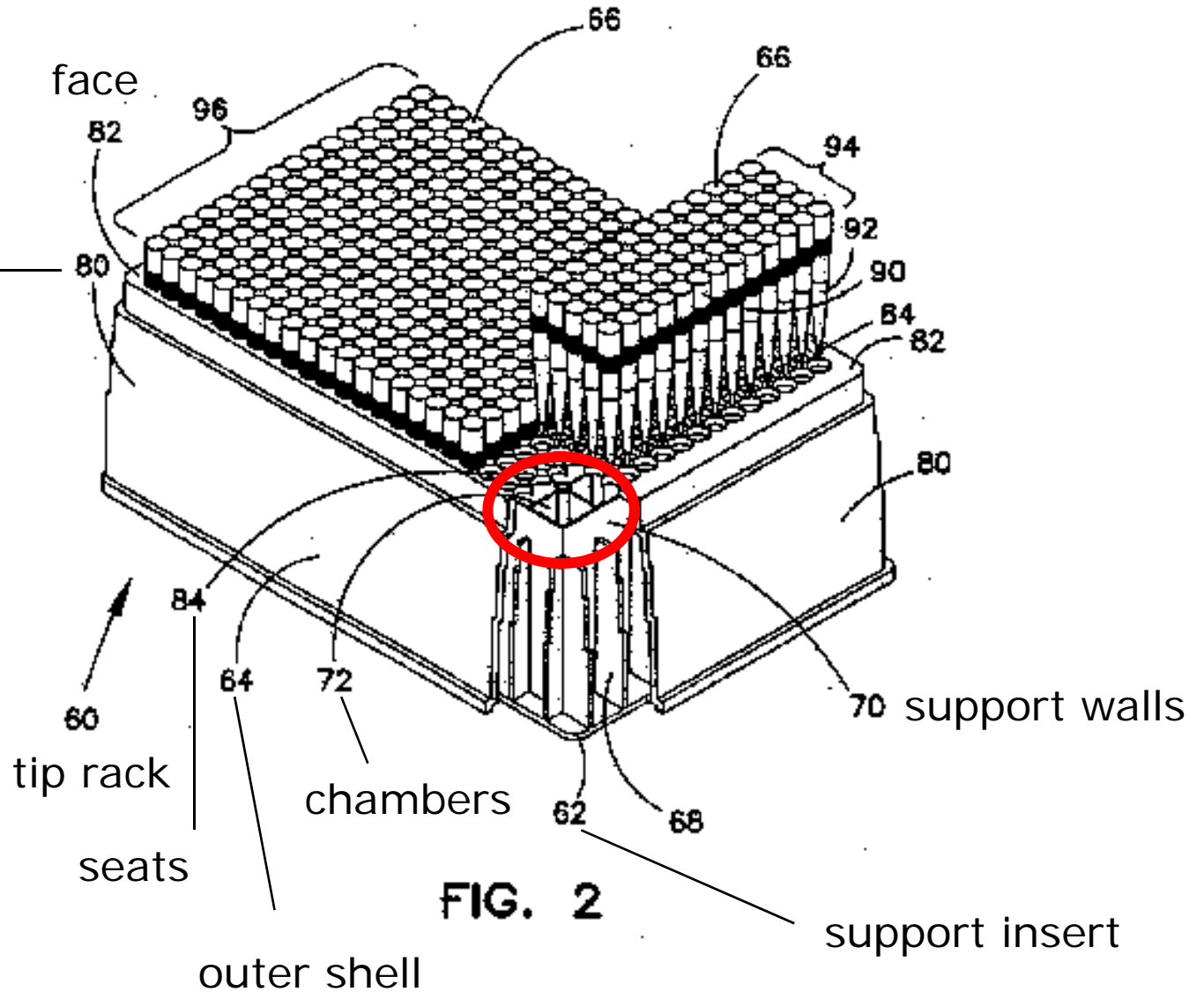
Tip rack example

side wall



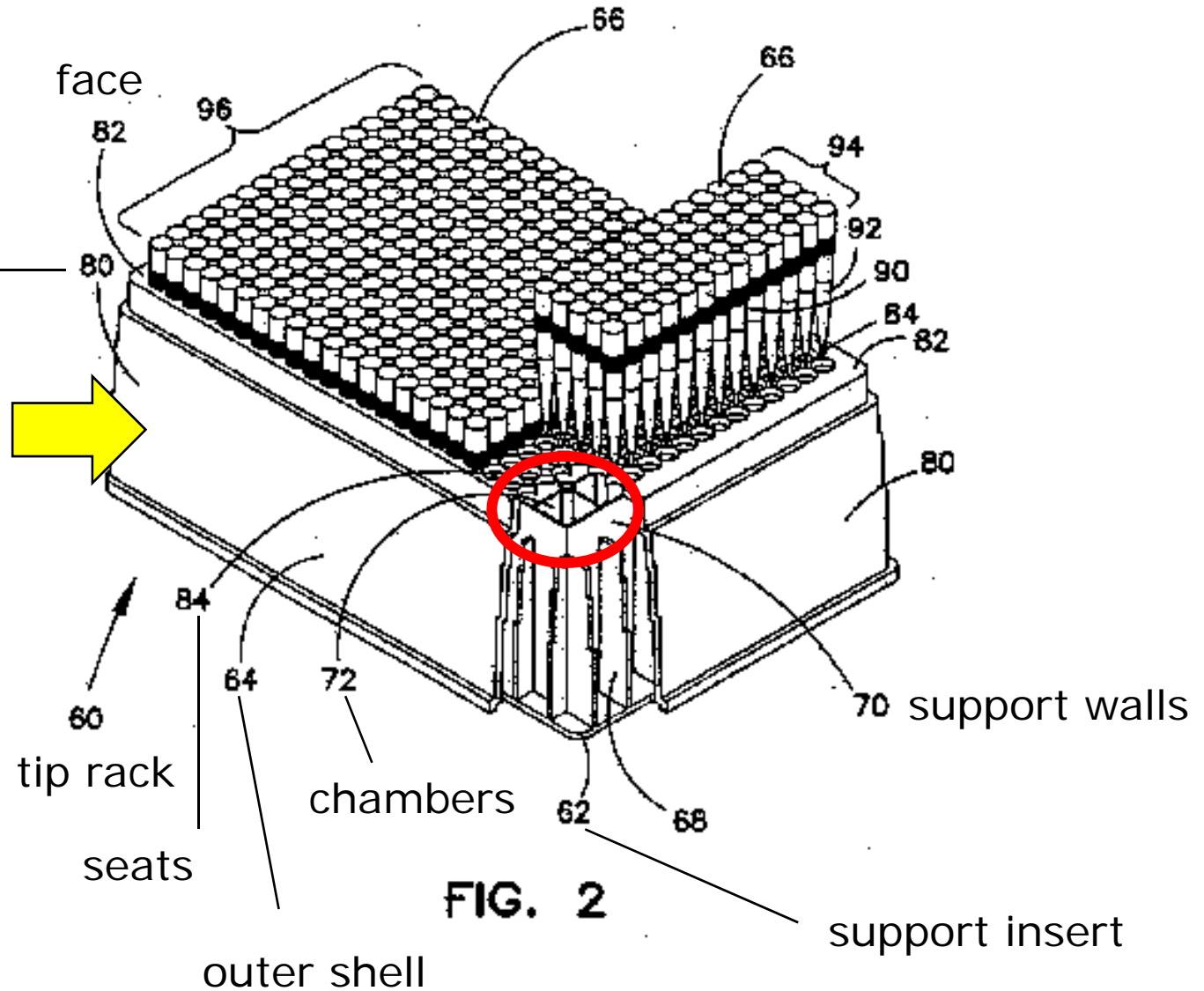
Tip rack example

side wall



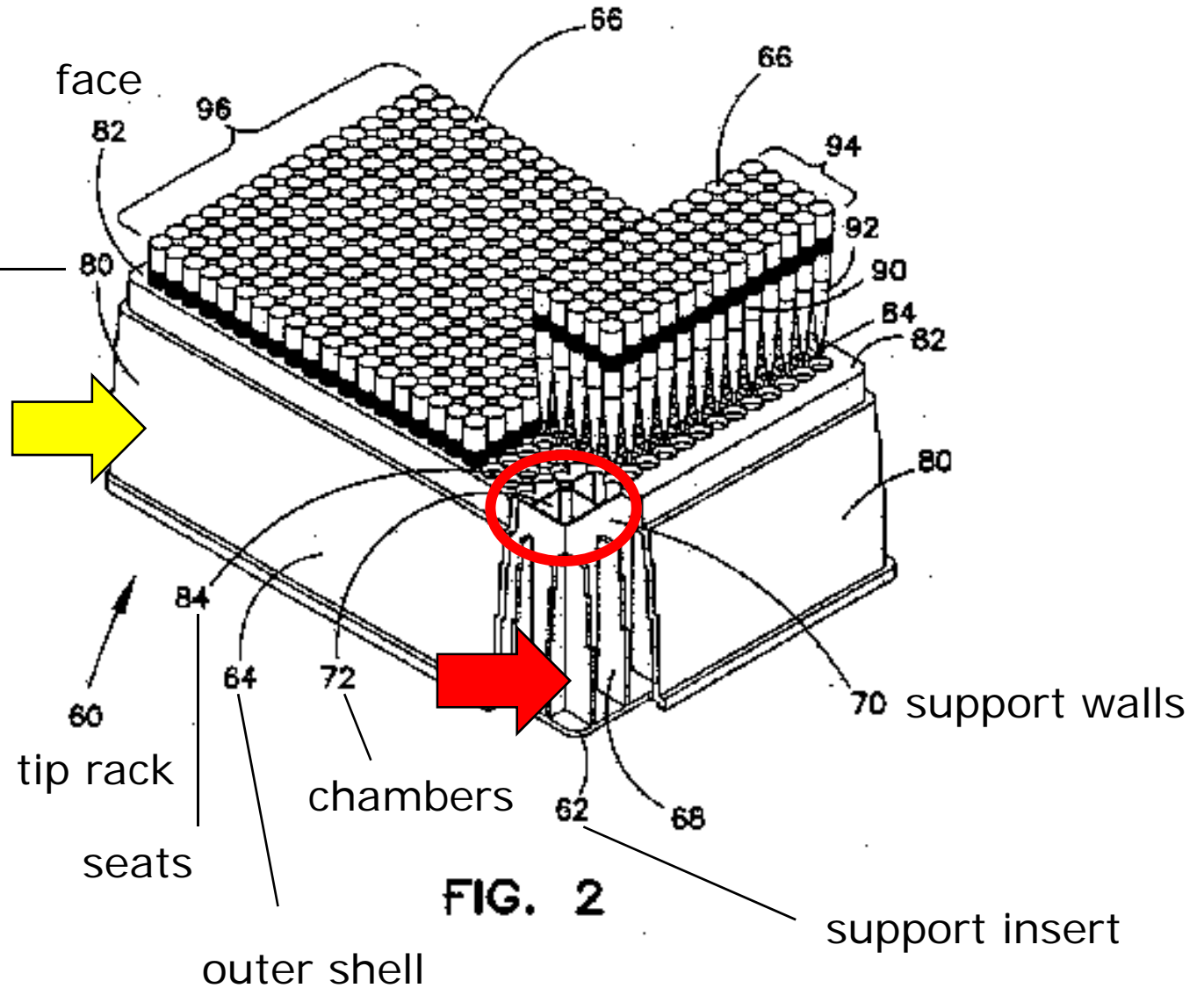
Tip rack example

side wall



Tip rack example

side wall



Tip rack example

Proprietor's argument:

The phrase "***For example, the rack may be a single moulded conductive piece and need not be comprised of an insert with a conductive outer shell***" is support for an embodiment in which the tip rack comprises one component having a plurality of support walls.

Tip rack example

Opposition Division:

- support walls are only disclosed in combination with the insert;
- the cited passage does not unambiguously disclose an embodiment corresponding to a combination of original claims 1 and 3 → it could just as well disclose an embodiment in which the rack does not comprise an insert at all.

Still: Tip rack example

Original disclosure:

- **whereby** static electricity deposited on the pipette tips is discharged through the tip rack when the pipette tips contact the tip rack

Still: Tip rack example

Original disclosure:

- **whereby** static electricity deposited on the pipette tips is discharged through the tip rack when the pipette tips contact the tip rack

Claim language:

- **such that in use,** static electricity deposited on the pipette tips is discharged ...

Still: Tip rack example

Opposition Division:

→ Not properly disclosed,

→ Wording had to be changed back into „whereby“

Another Example

13. A method of making an array of materials,
- (a) delivering a first component of a first material and a first component of a second material to first and second regions on ***a*** substrate;
 - (b) delivering a second component of said first material and a second component of said second material to said first and second regions on said substrate; and
 - (c) ***simultaneously*** reacting said components to form at least two materials.

Another Example

71. A method of making at least two different arrays of materials,
- (a) delivering a first component of a first material to a first region on **a first** substrate and delivering ... to a first region on **a second** substrate;
 - (b) delivering a first component of a second material to a second region on said first substrate and ...
 - (e) reacting said components on said first substrate under a first set of reaction conditions and said components on said second substrate under a second set of reaction conditions ...

Another Example

Opposition Division:

Since these two claims were originally presented as two independent claims, there must be a clear pointer in the description that these two separate embodiments can be combined.

Another Example

Opposition Division:

- Claim 13: An array is made on a substrate with several regions
 - Claim 71: Multiple arrays are made on several substrates
 - Claim 13: Components are reacted simultaneously which is not mandatory in claim 71
- ➔ Claim 71 cannot be made dependent on claim 13

Still the same Example

Further features added to claim 13:

production of array of non-biological organic polymers further comprising

- (i) polymerizing the components in the regions and
- (ii) allowing the polymerization reaction to proceed ...

Still the same Example

Disclosure for this amendment:

"in addition, organic polymers can be prepared by delivering a monomer (or monomers) of interest to predefined regions on the substrate usually in the form of a solution. Once the monomer of interest has been delivered, an ***initiator*** is added to each region on the substrate. The polymerization reaction is allowed to proceed until the initiator is used up, or until the reaction is terminated in some other manner."

Still the same Example

Opposition Division:

The presence of the initiator and its depletion by the reaction (middle sentence) has been omitted and only the first and third sentence of this passage have been used in granted claim 1.

Still the same Example

Opposition Division:

The presence of the initiator and its depletion by the reaction (middle sentence) has been omitted and only the first and third sentence of this passage have been used in granted claim 1.

→ Disclosure clearly includes the use of an initiator and its depletion, and it is not obvious to the skilled person that the use of the initiator could be seen as independent from the other steps of this passage

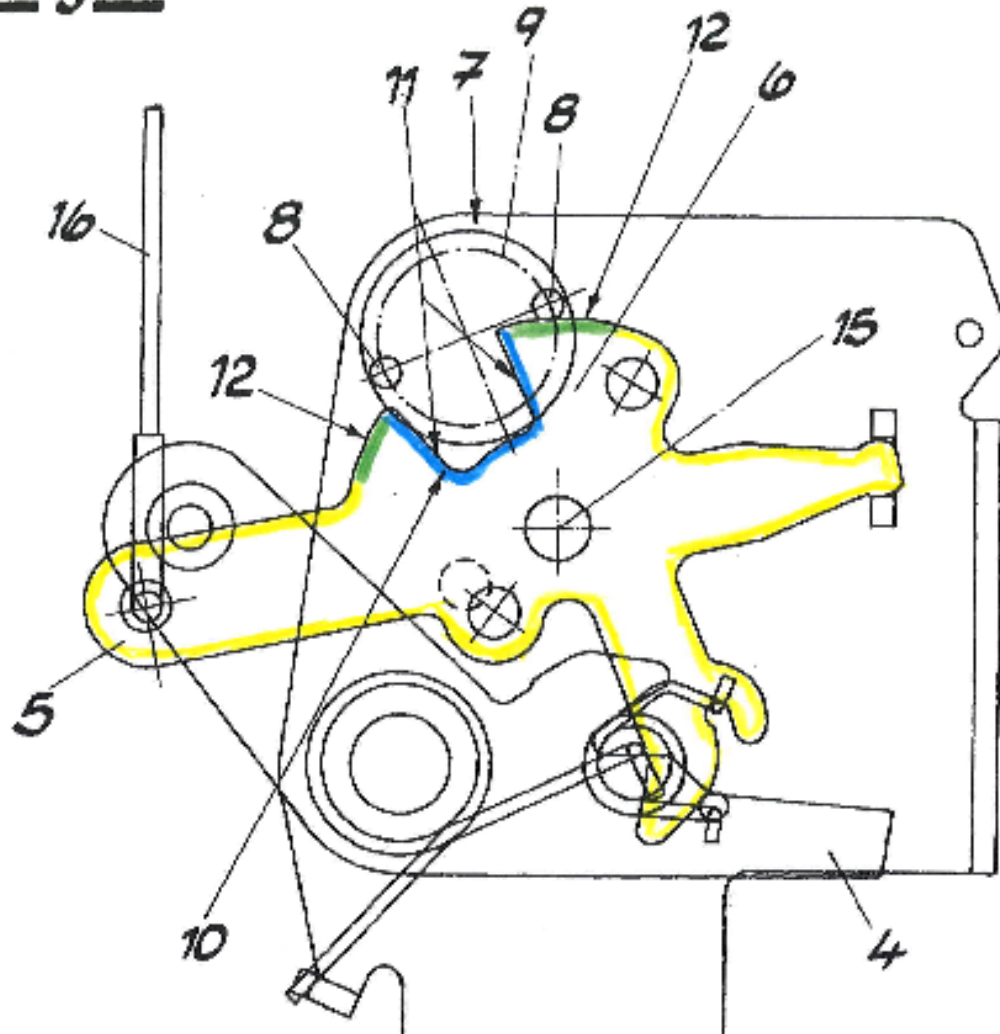
Still the same Example

Opposition Division:

Thus, selection of two out of three steps disclosed adds subject matter.

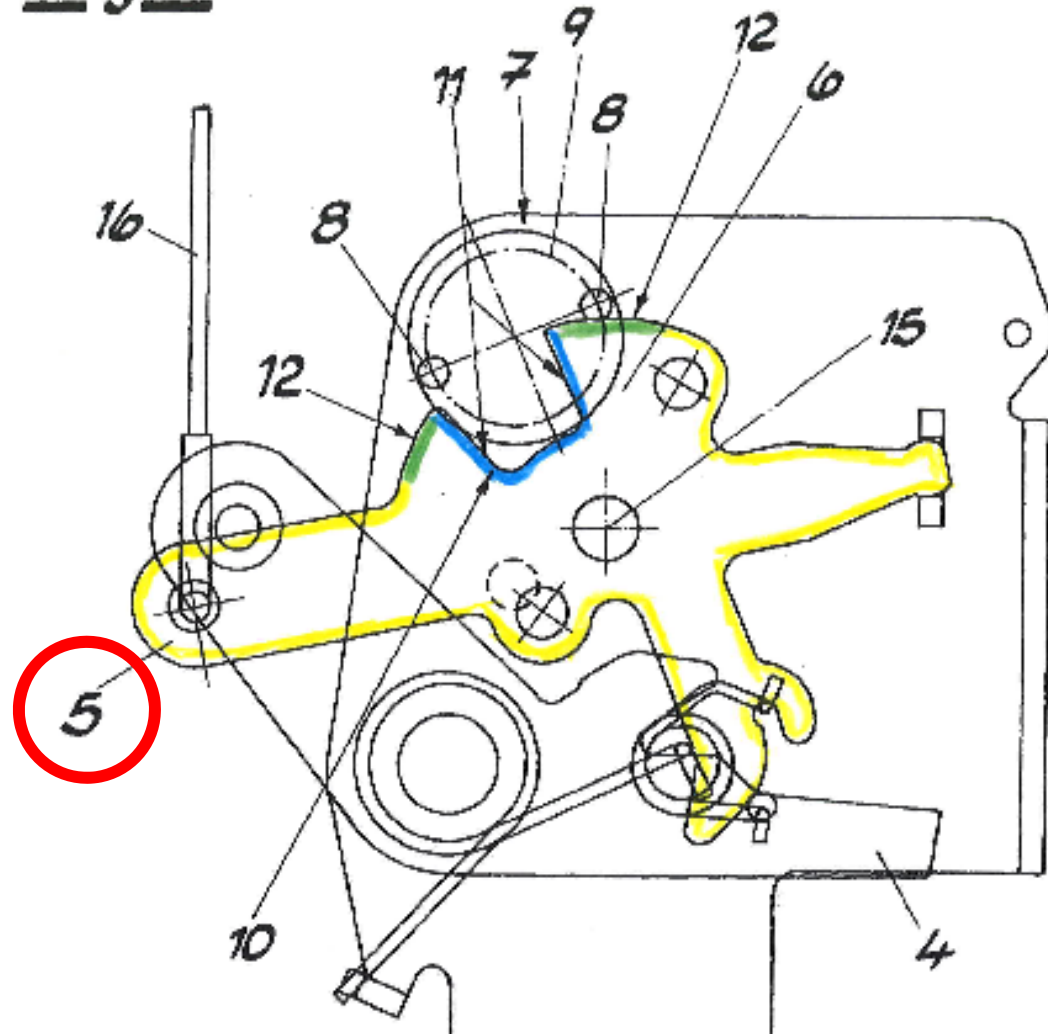
Example
from
Germany

Fig.4



Example from Germany

Fig.4

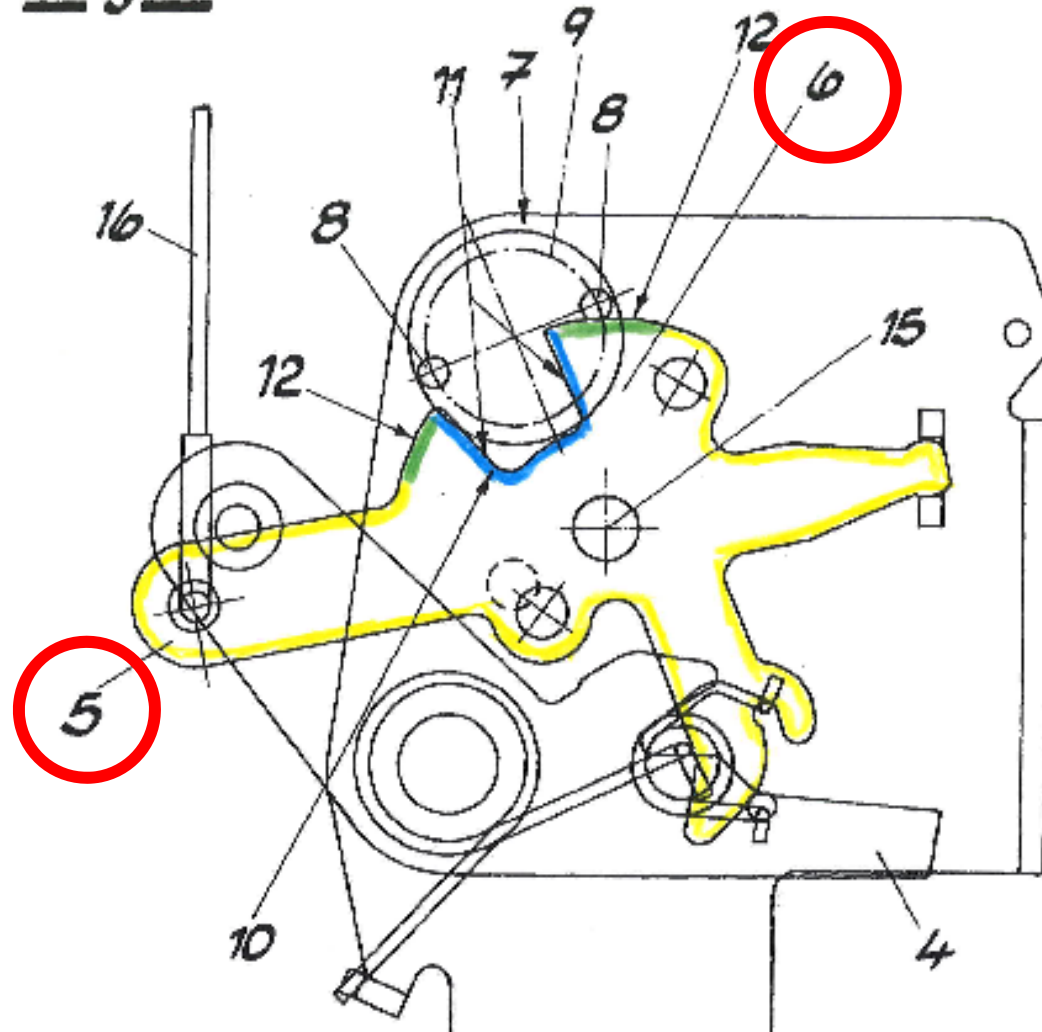


interior locking
lever

Example from Germany

Fig.4

central locking
element



interior locking
lever

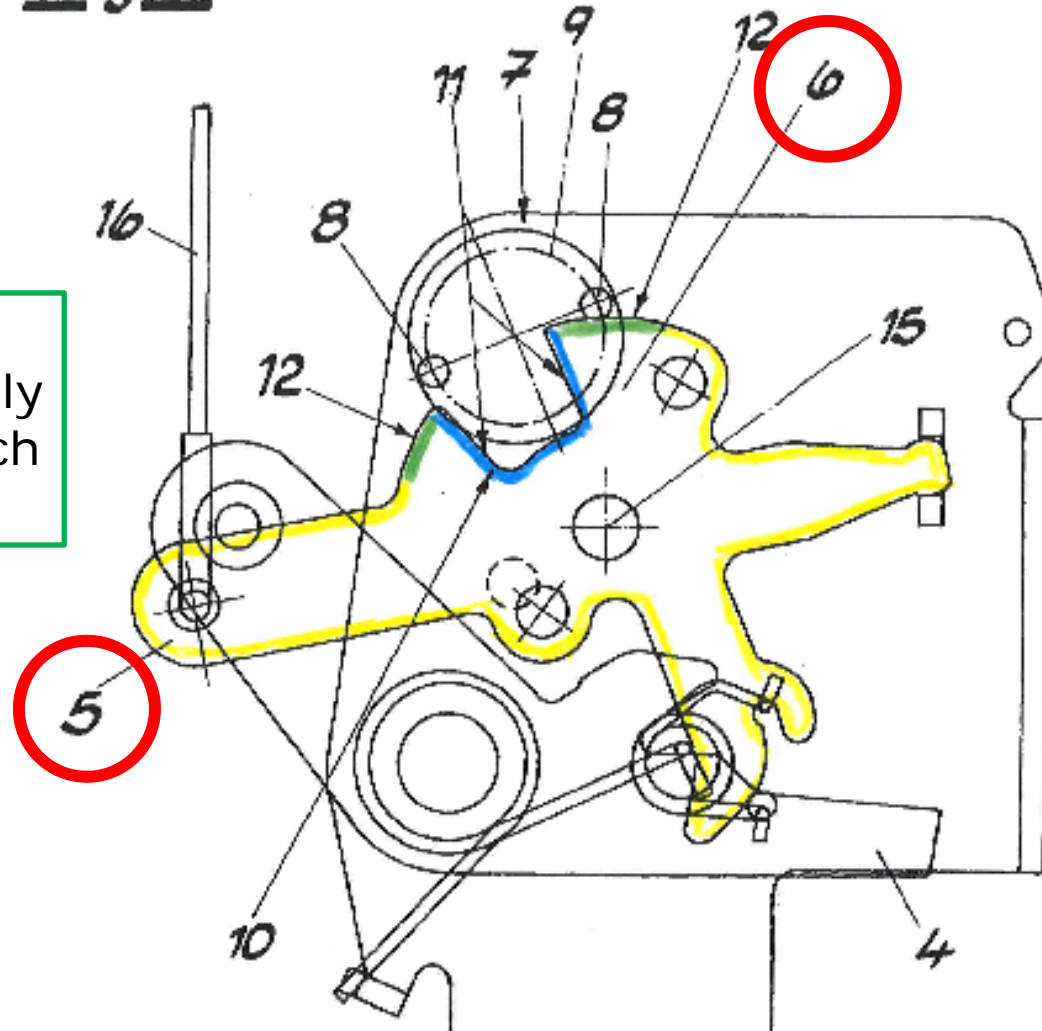
Example from Germany

text disclosure:
5 and 6 are rigidly
connected to each
other

interior locking
lever

Fig.4

central locking
element

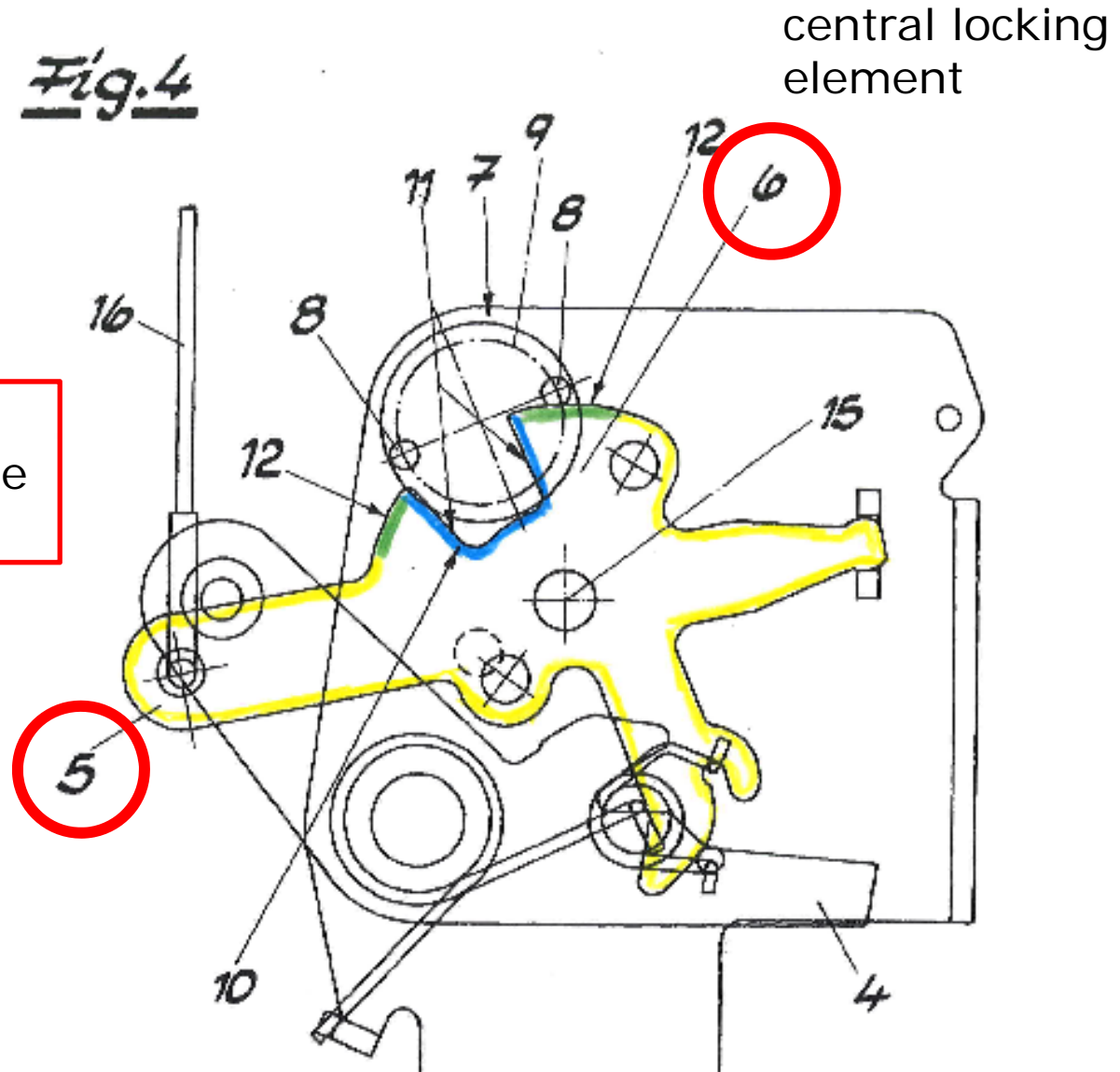


Example from Germany

granted claim 1:
5 and 6 are made
in **one piece**

interior locking
lever

Fig.4



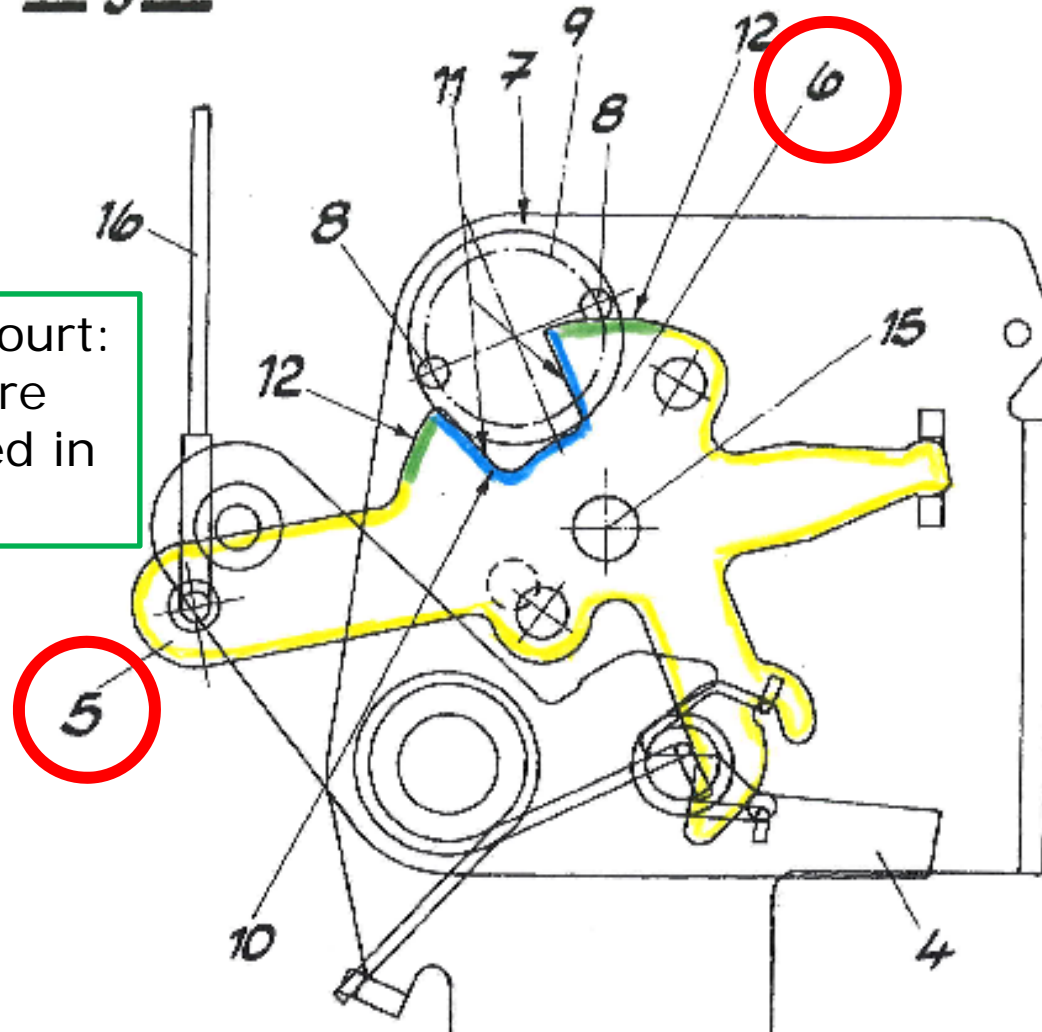
Example from Germany

Fig.4

central locking
element

Federal Patent Court:
one piece feature
properly disclosed in
drawing !

interior locking
lever



What to learn ?

- Explain features in different words (but be aware of clarity)
- Make sure combination of features of independent claims has a basis in the description
- Disclose features distinctly from each other (short sentences, short paragraphs) and/or use „and/or“
- Be aware of to much „may“ language
- File in original language for better fallback (applies automatically for PCT)

FICPI Resolution ExCO Rome 2011

FICPI urges patent authorities to avoid a purely literal and formalistic analysis of the original application and instead to adopt a ***reasonable and balanced approach***, at least by taking into account the common general knowledge of persons skilled in the art, supported if necessary by evidence, and therefore allowing any legitimate amendments which such persons would consider not to extend beyond the content of the application as filed.

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Patentanwälte

Thank you !

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