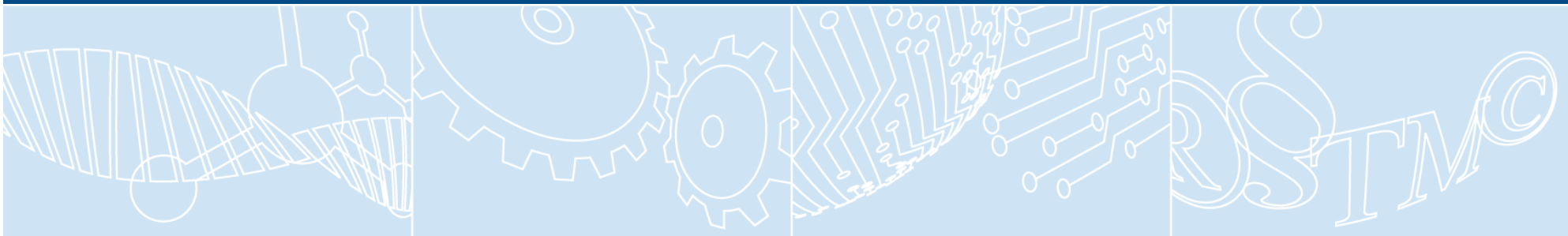


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The Same Invention or Not the Same Invention?

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The Same Invention or Not the Same Invention?

- Practical Problems
 - The standard of sameness – the skilled person vs. legal certainty
 - Recent TBA decisions on Art 123(2) EPC

- Logical Problems
 - Amendments vs. novelty
 - Selection inventions
 - Scope of protection vs. extent of disclosure

Practical Problems: Amendments - Art 123(2) EPC

- An amended claim is admissible under Art. 123(2) EPC if there is a clear and unambiguous disclosure of the same subject-matter in the application as filed.
- Who decides on sameness, clarity and unambiguity of disclosure? – The answer is given by the **skilled person** ... a beautiful but unfortunately quite fictitious creature.
- In reality, the answer is provided by an examination or opposition division or a technical board of appeal.
- These boards should simulate the skilled person ...
- ... but at times it seems that they feel more bound to earlier case law, EPO guidelines and the principle of legal certainty that underlies Art. 123(2) EPC than to the concept of a “skilled” person.

Picking up the ball – T 2017/07

- Original application

A hair dye composition which comprises

(A) an acid dye and

*(B) an alkylene carbonate having 3-5 carbon atoms in total, ...
wherein the content of the alkylene carbonate having 3-5 carbon atoms in total is 0.5-50% by weight. ...*

Description:

The alkylene carbonate having 3-5 carbon atoms in total can be ethylene carbonate, propylene carbonate and butylene carbonate ...

The hair dye composition of the present invention may optionally contain further ingredients such as inorganic salts ...

Picking up the ball – T 2017/07

- Amended claim
 - A hair dye composition consisting of*
 - (A) an acid dye*
 - (B) propylene carbonate in an amount of 0.5-50% by weight*
 - (C) optionally inorganic salts...*

- Would a skilled person understand that the same composition was disclosed in the application as filed?
- Not so, said the Board of Appeal.
 - The application as filed did not disclose the words “consisting of”
 - No disclosure that other components could also be excluded
 - Comprising and consisting of have different *legal effects*

Does “comprising” disclose “consisting of”?

- T 457/98, no. 2.1 of the Reasons:
 - *The significance of the word "comprising" is generally interpreted such that all of the specifically mentioned features and any optional, additional and unspecified features are included, while the term "consisting of" includes only those features that are specified in the claim. Therefore, in the opinion of the Board, the term "comprising" includes the expression "consisting of" such that the amendment from the first to the latter does not result in a subject matter that goes beyond the content of the application in the originally filed version, even if there was not an explicit disclosure of this.*
- Same reasoning followed in T 425/98
- However, T 1063/07 and T 2017/07 arrive at opposite conclusions
- Has the skilled person changed over the last couple of years?

Another very practical question re T 2017/07

- Amended claim (not allowed by TBA)
A hair dye composition consisting of
 - (A) *an acid dye*
 - (B) *propylene carbonate in an amount of 0.5-50% by weight*
 - (C) *optionally inorganic salts...*
- **Why did applicant not amend the claim to read?**
A hair dye composition comprising
 - (A) *an acid dye*
 - (B) *propylene carbonate in an amount of 0.5-50% by weight*

The answer is: He tried...

- **Applicant's claim**

A hair dye composition which comprises

(A) an acid dye

*(B) an alkylene carbonate having 3-5 carbon atoms in total, ...
wherein the content of the alkylene carbonate having 3-5 carbon
atoms in total is 0.5-50% by weight, **wherein the alkylene
carbonate is propylene carbonate***

- **Claim 1 as granted**

A hair dye composition which comprises

(A) an acid dye and

*(B) an alkylene carbonate having 3-5 carbon atoms in total, ...
wherein the content of the alkylene carbonate having 3-5 carbon
atoms in total is 0.5-50% by weight. ...*

...but the Board did not admit this claim either!

DIGRESSION

Where is the problem with this amendment?



The Board said, it is here:

- Claim 1 as granted included the restriction that whenever an alkylene carbonate is present, then its amount is 0.5-50% by weight.
- In the Board's reading, claim 1 as amended only specified that propylene carbonate is present in an amount of 0.5-50% by weight.
- Hence, claim 1 as amended was no longer limited with regard to the amount of other alkylene carbonates.
- Therefore, other alkylene carbonates might now be covered by the "open" claim 1 in amounts beyond 50% by weight.
- No "one-off": reasoning confirmed in T 1312/08. However, seems to be at odds with earlier practice and T 1144/08.

Lessons from T 2017/07 etc. – Art 123(2) EPC

- The skilled person does not seem to realize that “comprising” also includes the possibility that other components than those recited in the claim are not present.
- The skilled person understands a “consisting of” claim as implying a sort of “criticality” which must be expressly disclosed in the application as filed.
- When drafting a new application, always add a sentence that “comprising” includes the case of “consisting only of” – otherwise you may later be in trouble.

Lessons from T 2017/07 etc. – Art 123(3) EPC

- If the addition of the „wherein“ clause broadens the scope of the patent, then a dependent claim can have a broader scope of protection than the underlying independent claim:
 1. *A hair dye composition which comprises*
 - (A) *an acid dye*
 - (B) *an alkylene carbonate having 3-5 carbon atoms in total, ... wherein the content of the alkylene carbonate having 3-5 carbon atoms in total is 0.5-50% by weight.*
 2. *The hair dye composition according to claim 1, wherein the alkylene carbonate is propylene carbonate.*
- In T 1144/08 such an amendment based on a dependent claim was found not to infringe Art. 123(3) EPC, but the reasoning of T 2017/07 was avoided.

Where Does This Leave the Users of the EPO?

- When discussing Art. 123(2) EPC, most decisions do not refer to the skilled person's understanding at all.
- Legal certainty (= need for literal disclosure) seems to trump everything, when it comes to Art. 123(2) EPC
- Trying to fix a missing literal disclosure by a skilled person's common general knowledge is bound to end in disaster
 - the standard is "beyond reasonable doubt" (T383/88)
 - but when has common general knowledge ever been "beyond reasonable doubt" in opposition proceedings?
- The boards are highly suspicious if the skilled person is supposed to draw the slightest inference beyond that which is literally disclosed
 - Even undisclosed combinations of disclosed preferred embodiments may be unallowable – T 1410/05

The killer argument is ...



- But is cherry picking (selective read-out of information) not something that any real-world skilled person automatically does (to some extent) when reading a document?
- When a document discloses three features A, B, C in combination and one preferred embodiment A', B', C' for each feature, would a skilled person conclude that a combination of these preferred features is not part of the disclosure of the teaching of this document?

Selection Inventions

1. Inconsistencies between various types of selection inventions
2. Collisions regarding the concept of “the same invention” between novelty and amendments
3. Should a patent be entitled to protection for something that it does not disclose?

Inconsistencies in Selection Inventions

1. Selection of substances: C1-C4 alkyl does not disclose (anticipate) C2 or n-butyl alkyl (T 181/82)
2. But a numerical range is not novel just because it has narrower limits (T 198/84) – “Three part test”

... the purpose of Article 54(1) EPC, ... is to prevent the state of the art from being patented again, as already laid down in T 12/81. Since novelty is an absolute concept, a definition of invention which differs only in its wording is insufficient; what has to be established in the examination as to novelty is whether the state of the art is likely (*geeignet* = suitable) to reveal the content of the invention's subject-matter to the skilled person in a technical teaching.
3. For example: 80-170°C anticipates 85-115°C (T 247/91)

Board saw no reason to exclude this narrower range from the disclosure of the prior document – but why should then C2 be excluded?

A few provocative questions (I)

- Is the skilled person aware of the rules of arithmetic?
- If so, does he read a technical disclosure of ranges with these rules in mind?
- Is the skilled person able to understand that the term “halogen” is synonymous for F, Cl, Br, I and will he therefore understand that the generic term “halogen” clearly and unambiguously discloses each of these elements?
- How about the terms “organic compounds”, “aromatic esters”, “esters with C2-C5 aliphatic alcohols”, “salts”, “pharmaceutically acceptable acid addition salts”, “alkali salts”?

A few provocative questions (II)

- According to T 247/91, a prior art temperature range of 80-170°C anticipates a claimed range of 85-115°C, even if there are no working examples within this range in the prior art document.
- The disclosure of a prior art document as a whole was considered “to make available to the skilled person as a technical teaching the subject-matter for which protection was sought”. “A skilled reader of the cited document had no reason to exclude the range of 85 to 115°C claimed in the patent in suit when carrying out the invention disclosed in the citation”.
- Thus, the prior art document disclosed “the same invention”, did it not?
- But: could the applicant of the prior art application have amended his range of 80-170°C to 85-115°C?

A Quick Look into German Case Law

Olanzapin X ZR 89/07 (2009)

Novelty of a Selected Chemical Compound Affirmed

1. An assessment as to whether the subject matter of a patent is anticipated by a prior published document requires that the entire content of the prior published document be ascertained. The decisive factor is the technical information disclosed to the person skilled in the art. **The concept of disclosure in this context does not differ from that applied otherwise in patent law** (continuation of the judgment "*Fahrzeugleitsystem*" of the Chamber dated December 16, 2003 – X ZR 206/98 – GRUR 2004, 407).

LOGICAL PROBLEMS

2. A disclosure may also include that which is not expressly mentioned in the patent claim or the description, but which, from the point of view of the person skilled in the art, is quite evidently required to carry out the protected teaching, and therefore does not need to be specifically disclosed, but will be “read in”. **The inclusion of plainly evident subject matter does not, however, permit the disclosure to be supplemented by expert knowledge.** Just as when the literal meaning of a patent claim is ascertained, such an inclusion is only for the purpose of full ascertainment of the content and its meaning, i.e. the technical information the expert reader, based on his expertise, will find in the source (continuation of the decision “*Elektrische Steckverbindung*”, BGHZ 128, 270).
3. **As a matter of principle, the individual compounds falling under a chemical structural formula are not yet disclosed when said formula is disclosed** (continuation of the decision “*Fluoran*”, BGHZ 103, 150).

Inkrustierungsinhibitoren – X ZR 40/95 (1999)

Novelty of a Selected Numerical Range Denied

- a) The comprehensive indication of a numerical range, e.g. a molecular weight range, also contains in principle an equally comprehensive disclosure of all conceivable sub-ranges.
- b) Any exceptions to this rule will only be possible under particular circumstances to be stated by the applicant of a patent and verified if necessary.
- c) These principles may also be applied to a European patent, deviating from the case law of the European Patent Office (e.g. T 666/69, Official Journal EPO, 1993, at 495, 502 *et seq.* “Washing Composition”).

The Same Invention and Disclaimers – T 1443/05

- a) EP 1 was directed at biocidal compositions comprising MIT and BIT. Various examples disclosed various mixtures of MIT and BIT (all without CMIT).
- b) EP 2 claimed priority of EP 1. Same examples and almost the same claims except for a disclaimer of compositions comprising MIT and BIT and containing CMIT. The description of EP 2 (not of EP 1) mentioned that CMIT is has good biocidal activity, but is allergenic.
- c) EP 1 was filed before but published after the filing date of EP 2, i.e. EP 1 is state of the art under Art. 54(3) EPC unless EP 2 is entitled to the claimed priority of EP 1.

The Same Invention and Disclaimers – T 1443/05

- a) TBA held that EP 2 is NOT entitled to priority of EP 1 since it is not the “same invention”. Namely, the disclaimer was not clearly and unambiguously disclosed in EP 1, which even expressly disclosed that CMIT may be added to the composition of the present invention. No disadvantages of CMIT were taught in EP 1. The disclaimer could also not be derived from the examples, even though these did not contain CMIT, because EP 1 permitted adding other compounds such as CMIT later.
- b) Hence, examples of EP 1 anticipate the subject-matter of claim 1 of EP 2 (which has the same examples as EP 1 and claims priority of EP 1).

The Same Invention and Disclaimers – T 1443/05

How does a skilled person understand the teaching of EP 1 that CMIT may be added to the composition of the present invention?

- a) The exclusion of CMIT is possible but not critical according to EP 1, whereas it is critical in EP 2. Hence, EP 1 and EP 2 are NOT the same invention.
- b) CMIT may or may not be present in compositions of EP 1. Thus, the variant that CMIT is not present in the compositions of EP 1 is also a part of the disclosure of EP 1. Hence, EP 1 and EP 2 concern the same invention in so far, with EP 2 being directed at a part of the invention of EP 1.

Disclosure and Scope of Protection

- Doctrine 1: An inventor deserves a patent as a reward for **disclosing** a patentable invention to the public, rather than keeping it secret, thus contributing to technical progress.
- Doctrine 2: A patent is a temporary monopoly which is granted for a maximum of 20 years.
- Doctrine 3: Whoever manufactures, offers or sells an individual compound that falls under the scope of a broad generic claim, **commits literal infringement** of such claim.
- Doctrine 4: A broad generic claim does not **disclose** each and every compound that falls under it.

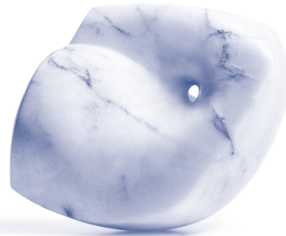
Disclosure and Scope of Protection

- Consequence 1: A patent may protect an “invention” (e.g. a specific compound) that it does not disclose.
- Consequence 2: A second patent may validly protect “the same invention” (the same specific compound) as a selection invention.
- Consequence 3: This specific compound may be monopolized for significantly more than 20 years!

Disclosure and Scope of Protection

- Should we accept this situation?
- If not, how should we deal with it?
 - Give up the concept of selection inventions?
 - Limit scope of protection to extent of disclosure?
- Many questions, but not that many satisfactory answers

THANK YOU FOR YOUR ATTENTION



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