

**Examination strictness
under the EPC
and
the German Paten Act**



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November 2020

Overview on Strictness of Examination Claim Interpretation

EPC

Basis:

- Under the EPC, the value of legal certainty of granted patents is paramount, and therefore a strict “**Definitional Approach**” should be applied when reading and understanding a claim (*T1279/04, T1534/12*);
- Art. 69 (1) EPC being only related to patent infringement, although requiring a consideration of the description and drawings for claim interpretation, is not directly applicable in the procedures under the EPC (*T1279/04, T1646/12*);
- nevertheless, a claim interpretation should be technically sensible, take into account the whole disclosure of the application/patent and be attended by a mind willing to understand (*T383/14, T1477/15*);

Overview on Strictness of Examination Claim Interpretation

EPC

Practice:

- according to some decisions, interpretations which are illogical or which do not make technical sense should be ruled out;
- other decisions express the opinion that only technically illogical interpretations should be excluded;
- several decisions state that, if a claim term has a clear technical meaning, the description cannot be used for a different interpretation;
- a “product-by-process“ definition is not a subject of interpretation for completing the claim by features in addition to those available in the application for defining the product satisfactorily by reference to its features like composition, structure or other testable parameters.

Overview on Strictness of Examination

Claim Interpretation

Germany (PatG)

Basis:

- § 14 PatG prescribes a consideration of the description and drawings when interpreting (construing) claims of both, a granted patent and a patent application
- therefore, a claim interpretation in consideration of the description and drawings is also obligatory during examination (*BGH GRUR 15, 868*) - “**Interpretational Approach**”

Practice:

- starting point is the claim wording; parts of the description and drawings unrelated to the claim’s framework are to be disregarded
- claims are to be interpreted not literally but purposively (“function-oriented”)
- however the meaning of device features cannot be reduced to their pure function

Overview on Strictness of Examination

Claim Interpretation

Germany (PatG)

Practice:

- an interpretation being narrower than the technically understood meaning of a claim is inadmissible, even if the examples of the invention given in the description are limited to only few embodiments
- numerical and measurement data can be interpreted beyond their unequivocal meaning only in exceptional cases (value being uncritical for the effect/function of the invention, consideration of common tolerances, etc.)
- the process part of a “product-by-process“ definition limits a product to one having characteristics resulting from the process, but not to one being necessarily obtained by this process
- the indication of a particular use/functionality of the claimed subject is in general not limiting, unless it supposes the presence of technical features in addition to those mentioned in the claim

Overview on Strictness of Examination Clarity

EPC

Basis:

- claims shall be clear as such (Art. 84) – “**Definitional Approach**” (!)
- clarity is of “utmost importance” (Guidelines EPO F-IV 4.1)

Practice:

- parameter “which may be determined by different methods yielding different results” is unclear
- reference to a standard (ISO) of indefinite date is unclear
- reference to feature(s) outside the claimed subject-matter is unclear
- missing essential features in the claim (claim broadness) cause lack of clarity

Overview on Strictness of Examination Clarity

Germany (PatG)

Basis:

- claims shall indicate what is to be protected (§ 34(3), No.3 PatG)
- however, German patent law does not require “clarity” as such (GRUR-RS 2018, 36049)
- clarity is to be obtained by claim interpretation (BGH GRUR 86, 803) – “**Interpretational Approach**” (!)

Practice:

- lack of clarity in the claim is not an independent ground for rejection
- a claim feature is to be considered clear if it is unambiguously understandable to the skilled person
- apparent discrepancies and contradictions in a claim can be removed by interpretation
- claims containing only a definition of a problem, and unintelligible terms being neither known to the skilled person nor explained, can be rejected (enablement issue)
- lack of clarity may induce lack of sufficiency of disclosure (enablement) and/or novelty

Overview on Strictness of Examination

Sufficiency of Disclosure (Enablement)

EPC

Basis:

- disclosure of the invention (whole application) shall be “sufficiently clear and complete for it to be carried out by a person skilled in the art” (Art. 83 EPC)
- the skilled person should be enabled to carry out the invention without undue burden over the whole range claimed (Guidelines EPO, F-IV 6.4)

Practice:

- lack of information putting undue burden on the skilled person to find out how to carry out the invention indicates insufficiency
- in case of a functionally defined compound, all substances falling under this functional definition must be available to the skilled person
- all variants of the invention falling under the claimed teaching should be able to solve the problem of the invention

Overview on Strictness of Examination

Sufficiency of Disclosure (Enablement)

Germany (PatG)

Basis:

- disclosure of the invention shall be “sufficiently clear and complete for it to be carried out by a person skilled in the art” (§ 34(4) PatG)
- the skilled person should be enabled to repeatedly carry out the invention to a sufficient extent and without undue burden over the whole range claimed

practice:

- the invention has to be workable to a sufficient extent and without undue burden
- sufficiency is given if at least one way to carry out the invention is provided in the description
- it is allowable to supplement the disclosure by general knowledge or orientating tests
- no sufficiency if lack of guidance in the description and, also if it is unknown to the skilled person by what kind of means a functionally defined claim feature can be achieved;
- reproducibility does not need to cover all embodiments conceivably encompassed by the claim

Overview on Strictness of Examination

Allowability of Amendment

EPC

Basis:

- no subject-matter which extends beyond the content of the application (Art. 123(2) EPC)

Practice:

- imperative requirement of “direct and unambiguous” disclosure
- claimable is only what a skilled person considers necessarily implied by the application
- amendment might not create novel subject-matter (novelty test)
- “intermediate generalization” admissible only if recognizable by the skilled person without any doubt
- no combination of features belonging to different embodiments (lists) if such combination is not specifically (individually) disclosed

Overview on Strictness of Examination

Allowability of Amendment

Germany (PatG)

Basis:

- no broadening of the subject-matter of the application (§ 38 PatG)

Practice:

- allowable if a new feature combination can be recognized by a skilled person as a possible variant of the invention
- not allowable if the amendment results from the skilled person's own considerations based on his own specialized knowledge

Overview on Strictness of Examination

Novelty – Interpretation of Prior Art

EPC

Basis:

- new if the invention does not form part of the state of the art (Art. 54 EPC)

practice:

- it is not allowed to complete a prior art teaching by equivalents
- non-individually disclosed single values within a range do not belong to the prior art unless the skilled person would seriously contemplate using them

Overview on Strictness of Examination

Novelty – Interpretation of Prior Art

Germany (PatG)

Basis:

- new if the invention does not form part of the state of the art (§ 3(1) PatG)

Practice:

- “habitual equivalents” may be used to supplement the prior art
- prior art may be supplemented by non-specifically mentioned compounds under a general formula, if these compounds are recognizable by the skilled person as existing and obtainable
- a range mentioned in the prior art is to be considered as disclosing all imaginable particular numerical values within this range; an exception only exists in the field of chemistry with regard to a general structural formula

Overview on Strictness of Examination

Inventive Step (Non-Obviousness)

EPC

Basis:

- inventive step if, having regard to the state of the art, the invention is not obvious to a person skilled in the art (Art. 56 EPC)

Practice:

- the assessment method of the “problem and solution approach” is strictly applied
- a comparison with the “closest prior art” delivers the new features
- an “objective problem” to solve is elaborated on the basis of the particular effects (disclosed in the specification) caused by the new features
- the invention is obvious only if, when starting from the “closest prior art”, the skilled person being aware of the rest of the prior art and hoping to solve the “objective problem” would have arrived - “could” is not enough (!) - at the invention
- level of probability behind “would” can be below 100% (“one-way street”)

Overview on Strictness of Examination Inventive Step (Non-Obviousness)

Germany (PatG)

Basis:

- inventive step if, having regard to the state of the art, the invention is not obvious to a person skilled in the art (§ 4 PatG)

Practice:

- invention is to be assessed as a whole; no claim dissection into generic and new features
- no determination of a “closest prior art” as a starting point
- main question to answer: was there an inducement toward the invention ?
- weighing-up pros and cons as to if the skilled person would have arrived at the invention
- no explicit commitment to the EPO’s “problem and solution approach”;
- only implicit use of the “problem and solution approach”, even though fragmentary and less consistent
- depending on the technical field, the assessment can be more or less strict

Implemented Strictness of Examination EPC

EPO - Examining and Opposition Divisions

- sticking to the EPO's Guidelines and weak knowledge of the case law of the BoA
- very strict attitude to Claim Interpretation, Clarity, Enablement and Allowable amendments resulting in putting considerable claim-limiting pressure on applicants
- in general, adequate examination of Novelty ("photographic" comparison with prior art teachings)
- mostly appropriately applied and well-structured "problem-solution" approach resulting in more predictable results of assessment of Inventive Step

Implemented Strictness of Examination EPC

EPO – Boards of Appeal (BoA)

- in general, well-balanced examination by the respective Board based on a profound knowledge of the case law of the BoA
- more balanced and well carefully considered Claim Interpretation and assessment of Clarity, Enablement and Allowable amendments
- sound and well-structured use of the “problem-solution” approach
- only occasionally diverging attitudes of the particular Boards

Implemented Strictness of Examination Germany (PatG)

GPTO – Examiners and Opposition Divisions

- more diversified attitudes of the examiners, lack of detailed guidelines for examination, however more receptivity for arguments based on case law
- in general, accommodating attitude to Claim Interpretation and assessment of Enablement and Allowable amendments
- However, occasionally insistence on Clarity of the claims
- slightly overlapping assessment of Novelty and Inventive Step
- as mostly, no use of EPO's "problem-solution" approach, no particularly structured and diversified attitudes towards assessment of Inventive Step

Implemented Strictness of Examination Germany (PatG)

German Federal Patent Court (BPatG)

- slightly diversified examination attitudes of the Senates (panels)
- clear denial of Clarity as independent legal requirement
- more thoughtful consideration of claim clarity issues in Claim Interpretation and assessment of Enablement and Allowable amendments
- clearer separation of the Novelty assessment from that of Inventive Step
- more diligent and consistent assessment of Inventive Step, although not particularly structured and close to EPO's "problem-solution" approach

Implemented Strictness of Examination Germany (PatG)

Federal Court of Justice (BGH)

- diligent, well-balanced and consistent examination
- holistic approach to Claim Interpretation and assessment of Enablement and Allowable amendments in consideration of possible claim clarity issues
- very thoughtful holistic assessment of Inventive Step increasingly following the principles of EPO's "problem-solution" approach, however without sticking to a particular "closest prior art" as starting point.

Conclusions

- (1) Strictness of the patent examination of European and German patents largely depends on the legal approach to claim interpretation (construction).
- (2) The more formalistic “Definitional approach” under the EPC is the reason for a stricter assessment of the requirements of Clarity, Sufficiency of Disclosure (Enablement) and Allowable Amendment, preceding the substantive part of the examination.
- (3) Due to its “Interpretational approach”, the German legal attitude appears to be less strict, but more diligent and accommodating for applicants than EPC regarding the requirements of Clarity, Sufficiency of Disclosure (Enablement) and Allowable Amendment .

Conclusions

- (4) The different approach towards interpretation appears to be also the reason why applicants have to accept more strictness and a higher hurdle in the examination of Novelty under the German Patent Act (PatG) than under the EPC.
- (5) While the assessment of inventive step under the EPC is more structured, the same under the German Patent Act (PatG) is more diversified and thus, depending on the particular technical matter it may result in more, but also in less strictness of the patentability examination.
- (6) Strictness of Examination is also differently practiced by the particular deciding instances at the EPO and in Germany. This circumstance is of further importance to consider when taking strategic decisions to place patent prosecution under the EPC or the German Patent Act (PatG).

Thank you for your kind attention
&
Please feel free to ask questions

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