

## Smart in C - Update Summer 2017

### G 1/15

In view of the decision G 1/15 of the Enlarged Board of Appeal, chapter 6.2 has been amended (new text underlined) and a new chapter 14.3.4 has been drafted.

#### 6.2 Patent to be attacked claims priority

In this case, it has to be checked for each claim separately whether the priority is validly claimed or not. If a claim contains alternatives, e.g. a list of features separated by 'and/or', it may be that different features have different effective dates depending on whether the features are entitled to priority or not, e.g. because the feature was not disclosed for the first time when filing the application (see GL F-VI 1.5). So, the validity of the priority claim has to be checked for each alternative separately.

So, a single claim can have several different effective dates.

In view of G 1/15, it is even possible that a claim which does not contain clearly identified alternatives has multiple different effective dates. This is the case if a claim in the subsequent application or in a second priority document is broader than the disclosure of the (earlier) priority document. In that case, that claim falls apart into two claims: one that contains the subject-matter which has the first effective date and one that contains the subject-matter which has the second effective date. For example, if the priority document only discloses "hardened steel" and claim 1 of the subsequent application contains the feature "steel", claim 1 falls apart into a first claim having the feature "hardened steel" and a second claim having the feature "non-hardened steel" (even if the feature "non-hardened steel" is not mentioned in the subsequent application).

The easiest way to deal with claims that have multiple effective dates is to assign each alternative a separate claim number, e.g. by referring to the alternatives as claim 5a, claim 5b and so on. Claim 5a can have a different effective date than claim 5b, and claims 5a and 5b are to be attacked separately. You can say that claim 5 falls apart into claims 5a and 5b.

The situation is different if two features are required to be present in combination, rather than in the form of alternatives, for example if a European application is based on one priority application disclosing feature A and a second priority application disclosing feature B and none of the priority documents discloses the combination "A and B", a claim to that combination will, normally, be entitled only to the date of filing of the European application itself. In other words, it is not permitted to "mosaic" priority documents.

If the priority is validly claimed for a certain claim or a certain alternative within a claim, the effective date of that claim or alternative is the priority date.

If the priority is not validly claimed for a certain claim or a certain alternative within a claim, the effective date of that claim or alternative is the filing date.

The criterion used to establish whether a claim is entitled to priority is whether the requirement in Article 87(1) EPC of "the same invention" is fulfilled (see G 2/98 and GL F-VI, 1.3 and 2.2). Note that if the client raises the issue in his letter, you should investigate the matter. Sometimes another part of the priority application, e.g. the description or a drawing, provides support for the subject-matter of

a claim that was not present in the priority document, but was present in the application as filed of the patent to be attacked.

If the claims set of the patent to be attacked contains claims with different effective dates, mark the claims of the patent to be attacked accordingly. For example, you could mark the numbers of a claim that is not entitled to priority with a highlighter or draw a circle around the number of the claim and write in the margin next to that claim something like “not entitled to priority” or “effective date = filing date”. You could also mark those claims this way in your simplified novelty matrix if this works well for you.

Priority issues often come up in paper C and are considered very important by the Exam committee. You need to demonstrate that you know how priority works in order to show that you are fit to practice, and therefore: to pass the exam.

So, make sure you know all about priority!

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#### **14.3.4 Generic “or”-claims - claims which have been broadened relative to the priority document (G 1/15)**

G 1/15 deals with the situation in which a subsequent application contains a claim which has been broadened as compared to the disclosure of the priority document. The teaching of G 1/15 can be best explained in the form of an example.

Consider the situation in which the priority document only discloses a knife made of hardened steel. Claim 1 of the subsequent document (which claims priority) contains the feature of a knife made of steel.

In accordance with G 1/15, this claim 1 should now be regarded as containing the features “a knife made of hardened steel or a knife made of non-hardened steel” instead of the feature “a knife made of steel”. Therewith, claim 1 falls apart into two claims: a claim 1a containing the feature “a knife made of hardened steel” and a claim 1b containing the feature “a knife made of non-hardened steel”. For this, it is not required that the subsequent application explicitly discloses “a knife made of non-hardened steel”. The claim is called a “generic “or”-claim” because it only mentions the generic feature (“knife made of steel”) while it actually should be seen as an “or”-claim.

The future will tell how exactly G 1/15 will be applied in practical situations. Should a claim to which G 1/15 applies however show up in a C paper, it currently appears that the safest way to deal with such a claim would be to split it up into a claim which is entitled to priority and a claim which not entitled to priority and deal with it the two claims separately, just like you would do with a regular “or”-claim.

## Public Prior Use - New chapter 14.11

### 14.11 Attacks based on public prior use

In some recent papers, an attack based on public prior use was expected. In these papers, one of the Annexes contained evidence of public prior use. This particular Annex could for example be a copy of a user manual or general information which was enclosed with a product that was sold, or an article about a trade fair which took place, in which it was said that a particular product was sold at the trade fair.

Such an Annex should be treated somewhat different from a “regular” Annex, such as a patent application.

First of all, there is the status of the Annex to consider: is the Annex itself prior art, or is it evidence of a public prior use? This has an influence on which you refer to the Annex in your argument, as well as for the relevance of its publication date. For example, a document which has been published after the effective date of a particular claim can still be used to attack this claim if it provides evidence of public prior use which occurred before the effective date of the relevant claim.

If the Annex is used as evidence for prior art rather than as prior art in itself, this should be mentioned in the attack. If the Annex was published after the effective date of the claim which is attack, it should be explained in your attack why this document can be used in the attack. For example, mention in your attack that the Annex provides evidence of a sale before this effective date, and that a single unconditional sale suffices to make something publicly available. If the claim contains features which are not immediately evident from the sold product, mention that those features are still disclosed if they can be found by further analysis of the product, even if the buyer had no reason to perform such an analysis. Preferably refer to the relevant part of the GL in your attack (in this example, that would be GL G-IV, 7.2.1).

Furthermore, in your attack refer to “the disclosure by the public prior use of which Annex X provides evidence” instead of “the disclosure of Annex X”.

GL G-IV, 7.2 says that three elements of public prior use have to be determined by the Opposition division. These three elements are:

- date of the disclosure,
- What has been disclosed?
- Circumstances relating to the use (e.g. with respect to confidentiality).

Address all these elements in your attack.

Please keep in mind that a disclosure by public prior use not only be used for an attack for lack of novelty, but also for an attack for lack of inventive step.

In addition, make sure you distinguish between cases in which the Annex provides evidence of public prior use, e.g. by a sale of a product (GL, G-IV, 7.1 and 7.2), and cases in which the Annex provides evidence of what was said in an oral disclosure (GL G-IV, 7.3).

Furthermore, an easy mark is scored if you offer to file additional evidence later in your attack. Sometimes, it is proper to offer the hearing of a witness. You can do that if for example in the Opponent’s letter the name is mentioned of a person who could tell more about the public prior use. When you do this, mention the person’s name and tell why he or she can provide additional information. Only offer to hear witnesses if your client knows the witness.

## Claims with optional features - paragraph 14.3.3 updated

### 14.3.3 Claims containing a word like “preferably”, “optionally”, “for example”, “e.g.”, “in particular”

This type of claim is for example formulated like:

“Claim Z: Device comprising A, B and preferably C”.

In accordance with GL F-IV 4.9, optional features do not limit the scope of the claims. An optional feature is a feature which is in the claim preceded by words like “preferably”, “optionally”, “for example” or “in particular”. Theoretically, you could disregard the optional feature when attacking the claim. However, it is highly likely that also an attack is expected on a claim which also contains the optional feature. An attack that disregards the optional feature is likely to be considered as an attack that can be easily overcome by the patent proprietor. In such a case, usually a second attack on the claim is expected.

The most straightforward way to deal with this is to regard the claim as an “or”-claim, and deal with it in the same way. In this approach, such a claim encompasses two different combinations of features:

- o Claim ZA: Device comprising A and B;
- o Claim ZB: Device comprising A, B and C.

The approach of the attack on this claim Z is similar to the ones discussed in the previous paragraphs. So, the structure of the attack on a claim Z containing a word like “preferably”, “optionally”, “for example”, “e.g.”, “in particular” is for example:

- o Claim Z contains the features A, B and preferably C.

Claim Z therefore encompasses two variants, which are:

- o Claim ZA: Device comprising A and B;
- o Claim ZB: Device comprising A, B and C.

*The attacks on claim variants ZA and ZB will be discussed separately below.*

- o Claim ZA lacks novelty in view of Annex 3

*(write out the novelty attack as for a normal claim)*

- o Claim ZB lacks inventive step in view of a combination of Annex 3 and Annex 4

*(write out the inventive step attack as for a normal claim)*