

# Kluwer Patent Blog

## Top 9 changes to the 2018 EPO Guidelines for Examination

Laurence Lai (Simmons & Simmons LLP) · Monday, October 1st, 2018

The European Patent Office published an advance preview today of its annual update to the [Guidelines for Examination](#) which will come into force on 1 November 2018. Here are the main changes and what they mean for users of the European patent system:

### 1. More definitive language

Throughout the new version of the Guidelines, some of the language has been updated to replace terms such as “should” with more definitive language including “is”, “must” and “needs to”. These changes improve certainty for applicants on how examiners are to interpret these Guidelines.

For example, regarding documents incorporated by reference, F-III, 8 now states that “the usual expression ‘which is hereby incorporated by reference’, or any expression of the same kind, ~~should~~ needs to be deleted from the description.” Or in the context of claim interpretation, “claims which attempt to define the invention by a result to be achieved are ~~should~~ not be allowed” (F-IV, 4.10).

### 2. Re-written section on unity

The revised unity discussion introduces a new two-step test – first, any common technical features of the claimed inventions are identified, and then these common technical features are examined to see if any of them are ‘special’ technical features.

A lack of unity objection can then be raised if there are no common technical features present among the claimed inventions, or if the common technical features are not ‘special’. ‘Special’ technical features are those that define the contribution which the invention, considered as a whole, makes over the prior art. In this update, it is now specified that this means over the prior art in terms of novelty and inventive step.

The new test is a distinct shift from the current practice where examiners start with identifying any ‘special’ technical features of each invention, before determining whether there is a technical relationship between the inventions and whether this relationship involves these ‘special’ technical features. This was a somewhat circular

approach in which examiners would need to decide there was more than one invention so they could work out what the 'special' technical features were, and then determine whether there was more than one invention based on the 'special' technical features.

As the new test is set out in a more logical order, this should lead to a more consistent approach from examiners when assessing unity. If this leads to examiners finding fewer disparate inventions, this could reduce the number of additional search fees faced by applicants.

In full: [F-V, 2 - Requirement of unity of invention](#)

### **3. What is 'technical'**

The prevalent question of what is 'technical', in particular with respect to computer-implemented inventions, comes a step closer to being answered in the new Guidelines.

The updates include a wide range of examples of what are and are not considered 'technical' features in claims involving subject matter including machine learning, simulation, business methods, information modelling, methods for playing games, and data retrieval. For example, machine learning algorithms may contribute to the technical character of an invention if they serve a technical purpose such as the classification of digital images based on low-level features such as edges.

The new examples and accompanying commentary in the Guidelines will harmonise practice on what examiners consider to be technical and non-technical, and should lead to more predictable outcomes for computer-implemented inventions.

In full: [G-II, 3.3 to 3.6 - Patentability of mathematical methods, mental acts, business methods, and programs for computers](#)

### **4. Summons to oral proceedings as the first action in examination**

The 2017 Guidelines set out a procedure for an examining division to summon an applicant as the first action. At the time, there was concern amongst some representatives, especially from those not in easy reach of Munich or The Hague, that this would cause an increase in oral proceedings at the expense of their clients.

Anecdotally, some representatives have seen an increase in summons to attend oral proceedings as a result of this policy in cases where it was perceived that written procedure had not yet been exhausted. This sentiment may have been picked up by the EPO - the amendments to the Guidelines appear to be aimed at making it more onerous on examiners to issue summons as a first action.

Specifically, the updates clarify as an explicit requirement that the examining division have to take into account the applicant's reply to the search opinion. They also set out more burdensome substantiation requirements in the preliminary opinion that is to accompany the summons. It is also suggested in the amendments that the examining division call the applicant before issuing summons as a first action.

Hopefully these changes will allay fears of any perceived mis-application of this

procedure.

In full: [C-III, 5 - Summons to oral proceedings as the first action in examination](#)

## **5. Closest prior art in opposition**

Following T320/15, the Guidelines now state that applying the problem-and-solution approach starting from different prior art documents requires it first to be shown that these documents are equally valid springboards. In other words, the same inventive step arguments should be able to be made when starting from any of the documents cited as being the closest prior art.

The effect of this in opposition proceedings is that opponents cannot take a shotgun approach to inventive step attacks that start with different prior art documents and have different arguments.

In full: [G-VII, 5.1 - Determination of the closest prior art](#)

## **6. Claim formulation for cloud computing**

A new section formalises current practice that multiple claims in the same category, e.g. device or method, are allowed for claims directed to distributed computing systems which generally include a server and a client device. It is often desirable to draft separate claims for each side of a distributed system to more easily cover activities of an infringing party.

The EPO has set out that separate client and server claims, as well as one for the whole system, may be allowed to appear in one application for the same reasons as plug and socket claims - they are interrelated products. Each independent claim would have to stand on its own in terms of novelty, inventive step and clarity as normal.

In full: [F-IV, 3.9.3 - Cases where the invention is realised in a distributed computing environment](#)

## **7. Apportionment of costs in opposition**

Generally, each party to an opposition must bear the costs it incurs. However, an opposition division may order an apportionment of costs, for example, when a party causes costs to be culpably incurred as a result of irresponsible or malicious actions.

A subtle change to the Guidelines shifts the responsibility of fixing the amount of costs from the opposition division to a formalities officer who acts for the opposition division. This should reduce the burden on the opposition division so that they can focus on technical and legal issues.

In full: [D-IX, 2 - Procedure for the fixing of costs](#)

## **8. Modified test for removal or replacement of a claim feature**

The three-step test for whether the replacement or removal of a feature from a claim

adds matter was established in T331/87. This has been updated in the Guidelines to clarify that if any one of the steps is failed, then the replacement or removal adds matter.

Additionally, the first step of demonstrating that the feature was not explained as essential in the original disclosure has been amended to remove the requirement that this must be directly and unambiguously recognised by the skilled person.

These changes may make it easier for examiners to raise added matter objections when analysing features removed or replaced from a claim. That said, the more recent case T1852/13 found that the Gold Standard of the subject matter being directly and unambiguously derivable should be used instead of the original three-step test. It will be interesting to see whether examiners will apply this modified test going forwards.

In full: [H-V, 3.1 - Replacement or removal of features from a claim](#)

## 9. Undisclosed disclaimers and patentability requirements

The changes emphasise that when using an undisclosed disclaimer to restore novelty over accidental anticipation or novelty-only prior art, or to remove excluded subject matter, examiners must evaluate inventive step disregarding the undisclosed disclaimer. Additionally, the undisclosed disclaimer may not be or become relevant for the assessment of sufficiency of disclosure.

Whilst these appear to be clarifying amendments to the Guidelines, it may see a stricter approach being adopted by examiners.

In full: [H-V, 4.1 - Disclaimers not disclosed in the application as originally filed](#)

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