

How to Defend Unsearched Dependent Claims in Prosecution

Kluwer Patent Blog
November 24, 2018

Thorsten Bausch (Hoffmann Eitle)

Please refer to this post as: Thorsten Bausch, "How to Defend Unsearched Dependent Claims in Prosecution", Kluwer Patent Blog, November 24, 2018, <http://patentblog.kluweriplaw.com/2018/11/24/how-to-defend-unsearched-dependent-claims-in-prosecution/>

Setting the record straight concerning the right to dependent claims under the EPC

by Thomas Wyder and Stephan Steinmüller (Hoffmann Eitle)

EPO Examiners sometimes urge Applicants to delete dependent claims considered to relate to "unsearched subject-matter" after having raised a unity a posteriori objection. We are investigating in how far the EPC justifies forcing an Applicant to delete dependent claims as well as possible counter-arguments for defending them.

Legal basis

Rule 164(2)(c) EPC authorizes the Examiner to force an Applicant to excise subject-matter and to focus on one invention for Euro-PCT applications. If an Applicant was invited to but did not pay further search fees, the searched invention is considered elected. An analogous provision does not exist for "direct" European patent applications. However, according to G 2/92, if no additional search fees are paid for an EP application, then the searched invention is considered elected, and the Applicant must excise the remaining inventions. One might thus state that Rule 164(2)(c) EPC may be applied analogously to direct European applications. Rule 63(3) EPC sees to a case in which an Applicant is forced to excise subject-matter after receiving an incomplete (a partial) search report because a meaningful search cannot be carried out. Thus, one might argue that G 2/92 implies that Rule 63(3) EPC is to be applied analogously to direct applications for which a unity objection a posteriori was raised when no additional search fees were paid.

Coming from a different angle, Rule 137(5) EPC stipulates:

"Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63".

It is to be emphasized that this provision requires two criteria to be fulfilled if subject-matter is to be forbidden in an amended claim. The subject-matter must be unsearched as well as not forming a single inventive concept with the originally claimed invention. Stating that an amended claim contains unsearched subject-matter is not sufficient for an Examiner to justify insisting on a deletion of the claim based on Rule 137(5) EPC.

"Searched" and "unsearched" dependent claims

Diversities in dependent claims are unproblematic with regard to lack of unity a priori. The Guidelines for Examination, Part F, V, 9, state that "no objection on account of lack of unity a priori is justified in respect of a dependent claim and the claim on which it depends, on the ground that the general concept they have in common is the subject-matter of the independent claim, which is also contained in the dependent claim". Claims depending on a novel and inventive claim are linked by a single inventive concept. This may serve as a first guiding principle when dealing with a lack of unity a posteriori objection.

When an independent claim is considered novel and inventive, there is no need to direct a (further) search at the dependent claims (Guidelines for Examination, Part B, III, 3.7). In other words, although no specific actual search has been carried out for the dependent claims, they are usually deemed to have been searched, i.e., "searched by fiction". This may serve as a second guiding principle for a scenario involving a lack of unity a posteriori objection.

It follows that the issue of whether a particular dependent claim is considered searched or not does not necessarily depend on whether an actual search has been performed for the subject-matter of the claim. Whether a claim is searched is primarily a legal and not a factual question.

When a lack of unity a posteriori objection is raised and an Applicant does not pay all additional search fees, the Examiner will often request the Applicant to fully delete those dependent claims that he/she thinks have not been searched. However, by simply following this request, the Applicant may unnecessarily surrender subject-matter, as will be explained by means of the following example.

An application as filed contains independent claim 1 and dependent claims 2 and 3, the latter depending on claims 1 and 2. A lack of unity a posteriori objection is raised since claim 1 is not considered patentable and dependent claims 2 and 3 are deemed not to relate to the same inventive concept. No further search fee is paid by the Applicant, and the search is restricted to claims 1 and 2. The subject-matter of claim 2 is held by the Examiner to be novel and inventive, while the subject-matter of claim 3 is deemed to constitute unsearched matter. Thus, the Examiner requests the Applicant to excise this latter subject-matter from the application.

If Applicant follows this request, he may later be barred from amending claim 1 by including therein the feature(s) of original claim 3, even if there is a basis for such a combination in the description. Such a feature combination would constitute unsearched subject-matter which does not combine with the originally claimed invention (feature combination of original claims 1 and 2) to form a single general inventive concept, thus violating Rule 137(5) EPC. Hence, the dependency of claim 3 on claim 1 can be coined an "unsearched dependency". However, the Applicant may amend claim 1 by including therein the feature(s) of original claim 2, thereby arriving at an amended claim 1 whose subject-matter is novel and inventive. In this case, original claim 3 can be maintained in the application as a new dependent claim 2 which is dependent on amended claim 1. Hence, the dependency of claim 3 on claim 2 can be termed a "searched dependency".

Keeping the "searched dependency" does not violate Rule 137(5) EPC. As previously explained, this provision requires two criteria to be fulfilled to warrant the deletion of a dependent claim. The requirement of not combining with amended claim 1 to form a single inventive concept is not met for amended claim 2 in our example. Specifically, amended claims 1 and 2 have in common the subject-matter of amended claim 1. Further, this approach is also in line with the search principles of the Guidelines for Examination, Part B, III, 3.7 (see the above-mentioned second guiding principle). Since the subject-matter of (amended) independent claim 1 is novel and inventive over the prior art, the subject-matter of (amended) dependent claim 2 should be considered searched, although no actual search may have been carried out for the feature(s) of original claim 3.

Defending "unsearched" claims

A central underlying aim of the requirement of unity lies in preventing grant of a single patent (separately) protecting two (or more) inventions. Keeping the two identified guiding principles in mind, one may conclude that claims depending on a novel and inventive claim share a common inventive concept, and that a dependent claim, although no specific actual search has been carried out for that claim, may at least be deemed to have been searched.

The question whether a claim has been actually searched or not should not be crucial in deciding whether a claim ought to be deleted. Considering the legal situation as a whole, rather than focusing on isolated provisions, one may conclude that an unsearched claim should be deleted only when there is no connection to the single inventive concept addressed by the originally searched claims.

Moreover, the question whether a claim is to be considered searched is a legal rather than a factual question. This should open up the possibility to argue that claims should be considered searched by fiction, i.e. that they are deemed to have been "searched".