Kluwer Patent Blog

Top 10 changes to the 2019 EPO Guidelines for Examination

Laurence Lai (Simmons & Simmons LLP) · Tuesday, October 1st, 2019

The European Patent Office has today published an advance preview of its annual update to the Guidelines for Examination which will come into force on 1 November 2019.

This year, there have been some tweaks to sections on how novelty, inventive step and clarity are assessed. The updates also add detail to discussions on formalities and procedural aspects, including helpfully giving extended examples, such as deadline calculations after resumption of proceedings.

Before diving into this year's main changes, some readers may be wondering about the elephant in the room:

The Rules of Procedure of the Boards of Appeal 2020

No changes have been made in view of the new Rules of Procedure of the Boards of Appeal that will come into force on 1 January 2020, although this is not surprising given the timing in the annual Guidelines revision cycle. It will be interesting to see how next year's Guidelines reflect the new Rules.

For example, since remittal from appeal back to first instance divisions will soon require *"special reasons"*, it appears more likely that a Board of Appeal would decide on an issue that is heard for the first time in an appeal, leaving no option for challenging the decision on the issue.

This has led many to wonder whether future Guidelines will put any expectations on first instance divisions to discuss all grounds at oral proceedings, beyond the minimum necessary to reach a decision, and include *obiter dicta* in decisions.

Indeed, the 2019 edition of the Case Law of the Boards of Appeal already includes a new subsection dedicated to *obiter dicta* which hints at what the Boards of Appeal would like to see: *"Obiter dicta are sometimes included in first instance decisions in order to avoid remittal"*.

Top 10 changes

1. Technical character of artificial intelligence inventions

Last year, a new section discussing the patentability of AI and machine learning claims was added. This has already been updated in the new Guidelines to soften the stance on features such as

"support vector machine", *"reasoning engine"* or *"neural network"*.

Previously considered to usually be devoid of technical character, EPO examiners are now expected to take into account whether the context of these features contribute to the technical character of a claim as a whole. A positive finding on technical character is an important factor in establishing an inventive step.

Additionally, the computational efficiency of an algorithm is now considered to contribute to the technical character of an invention if a technical effect of the computer program has already been established.

The EPO is therefore taking a step forwards towards recognising contributions that machine learning and efficient algorithms can make as patentable inventions.

In full: G-II, 3.3 – Mathematical methods and G-II, 3.3.1 – Artificial intelligence and machine learning

2. Novelty of subranges

Following T261/15, the formerly three-step test for assessing novelty of a sub-range has dropped the last step which required assessment of whether a claimed selection is purposive. This step was considered to be more a question of inventive step than of novelty because it considers the presence of an effect of the claimed invention.

The now two-step test will make it easier to demonstrate novelty of claim that includes a sub-range, particularly in chemistry and pharmaceutical cases.

In full: G-VI, 8 – Selection inventions

3. No longer enough for skilled person to "hope" to succeed

A small but significant inconsistency between the Guidelines and case law has been removed from the discussion of the last stage of the problem-solution approach. This stage involves considering whether any teaching in the prior art would have led the skilled person to arrive at the claimed subject matter when trying to solve the objective technical problem.

The established case law in T2/83 sets out that it would be obvious for the skilled person to modify the closest prior art in the *"expectation of some improvement or advantage"*. However, the Guidelines previously conflated this with whether the skilled person would have modified the closest prior art in the *"hope of solving the objective technical problem"*.

"Hope" and *"expectation"* have different meanings – a *"reasonable expectation"* is based on a scientific appraisal of available facts whereas a *"hope to succeed"* is merely the expression of a wish. This issue was flagged in the 2017 article *"A hope to succeed – are the EPO Guidelines misleading?"* in the Journal of Intellectual Property Law & Practice.

By removing the phrase *"hope of solving the objective technical problem"*, the could-would approach has been clarified and should lead to a more consistent application of problem-solution in inventive step.

The 2019 edition of the Case Law of the Boards of Appeal has similarly been updated to remove

reference to a *"hope"* to succeed.

In full: G-VII, 5.3 – Could-would approach

4. Obviousness in biotechnology research

A new section discusses what would be obvious to a skilled person in the field of biotech research – that there is no inventive step if the skilled person would have conducted research following the teaching of the prior art with *"a reasonable expectation of success"*.

The difference between a *"reasonable expectation of success"* and a *"hope to succeed"* is also clarified in the context of research. Specifically, if non-trivial decisions need to be made in the course of research, this goes beyond a *"reasonable expectation of success"* and may be indicative of an inventive step.

Nothing in the new section is specific to biotech research, and so it appears that this approach to inventive step analysis could be extended to other fields of research, such as pharmaceuticals.

In full: G-VII, 13 – Inventive step assessment in the field of biotechnology

5. Completing procedural acts without taking over representation

Procedural acts including paying the grant fee and filing claim translations can now more easily be carried out by a professional representative that is not the one on record. The EPO will no longer require a signed authorisation from the applicant if a non-appointed representative makes it clear when performing the procedural act that they do not intend to take over representation, and that they are acting on the request of the applicant.

This will make more straightforward, for example, for validation companies to extend their services to cover all stages in the grant process after receipt of a notification of intention to grant.

In full: A-VIII, 1.5 – Signed authorisation

6. Filing and examination fee discounts extended to joint applicants

A 30% reduction for the filing and examination fees is available for entitled applicants such as SMEs, natural persons and universities from an EPC contracting state having an official language different from one of the official languages of the EPO.

Previously, if there were joint applicants, the EPO required that each applicant met both the type and language criteria.

Following J4/18, the Guidelines have been updated to clarify that if there are joint applicants, each must be an entitled type of applicant, but only one needs to meet the language requirement.

This reduction currently represents a saving of up to €547.50 per examination request for entitled applicants. Whilst this similarly opens up the possibility of a reduction for the filing fee, as the patent specification would have to be filed in a non-EPO language, the cost of translations would likely outweigh the fee savings.

In full: A-X, 9.2.1 – Reduction under the language arrangements

7. Clarity of parameters in claims

The discussion on assessing clarity of a product claim defined by parameters – physical properties of the product – has been restructured. Previously, it jumped straight into the requirement of including a method for measuring the parameter values in the claim where needed.

Based on T849/11, the revised section discusses two additional criteria for establishing clarity of a product defined by parameters. In particular, that the claims should be clear to the skilled person without relying on the description, and that it should be ensured that *"the skilled person can easily and unambiguously verify whether they are working inside or outside the scope of the claim"*.

Further, a dedicated subsection on unusual parameters more clearly categorises types of unusual parameters and how these can be compared to the prior art.

These amendments should improve consistency when approaching claims with parameter features, leading to clearer claims when parameters are used.

In full: F-IV, 4.11 – Parameters

8. Clarity of purposes in claims

The interpretation of method claims expressed as being for a purpose, as well as means-plus-function features of claims both receive attention in this year's updates.

In general, means-plus-function features of a claim are anticipated by any prior art features suitable for carrying out the function. For example, *"means for fastening metal plates together"* is anticipated by rivets and bolts. The updated Guidelines clarify an existing exception to this general principle for computer-implemented inventions.

Specifically, where the function of the means-plus-function feature is carried out by a computer, this is interpreted as the means being specifically arranged to carry out the function. Accordingly, a relevant prior art document must disclose an apparatus that carries out the claimed steps, not just an apparatus suitable for carrying out the steps.

For method claims expressed as being for a purpose, the Guidelines now distinguish more clearly between two types: a first type that defines the application of a method, e.g. a method for forming ice cubes, and a second type that defines an effect arising from the step of the method, e.g. a method for strengthening ice cubes.

In the first type, the claimed purpose is taken to be a step of the method itself. On the other hand, in the second type, as the effect should inevitably arise from the steps of the method, the claimed purpose is not considered to be a limiting feature. This means that prior art can read on to such a method claim even if it does not disclose the specifically claimed purpose.

These clarifications on interpretation will particularly affect computer implemented-inventions which are typically claimed as methods for carrying out a purpose, and as apparatus with means-plus-function features.

In full: F-IV, 4.13 – Interpretation of expressions stating a purpose

9. Expanded section on European regional phase of PCT applications

The entire chapter dealing with Euro-PCT applications has been extensively revised to add helpful detail and examples on the various procedures to be completed when entering the European regional phase.

For practiced hands, there should be nothing new or surprising in the extended discussions on topics including translations required when entering the regional phase, early processing, or responding to the Rule 161 communication.

But the extra detail makes this a particularly useful reference for less commonly encountered scenarios such as restoration of priority when entering the European regional phase, or review and rectification of errors made by the receiving Office or the International Bureau.

In full: E-IX – Applications under the Patent Cooperation Treaty (PCT)

10. Skype for Business oral proceedings

The EPO switched over to Skype for Business earlier this year for examination oral proceedings held by video conference. Since then, summons to such oral proceedings no longer include a number for establishing the video conference connection.

Instead, the applicant must respond by filing the technical details and contact information requested on the summons. In particular this should include an email address. The EPO will then send a calendar appointment for the oral proceedings with a Skype for Business link to the email address.

Applicants using SIP or H.323 video conference systems can still connect to Skype meetings by appending the conference ID in the received calendar appointment with "@pvc.epo.org".

In full: E-III, 11.2 – Preparations for the videoconference

Honourable mentions

- Changed stance on the deletion of alternatives from more than one list – such a deletion adds matter if it results in the creation of new technical information that is not directly and unambiguously derivable from the application as filed. In full: H-V, 3.3
- Modified three-step test for whether replacement or removal of a claim feature adds matter – it no longer needs to be *"directly and unambiguously"* recognisable by the skilled person that no modifications are required to compensate for the replacement or removal. In full: H-V 3.1
- Updates regarding procedure for requesting that the EPO retrieve a priority document using the WIPO Digital Access Service (DAS). In full: A-III 6.7
- Clarifications on reformatting pages and effect on calculation of page fees on filing or European regional phase entry. In full: A-III, 13.2
- Clarifications regarding file formats when filing sequence listings. In full: A-IV, 5

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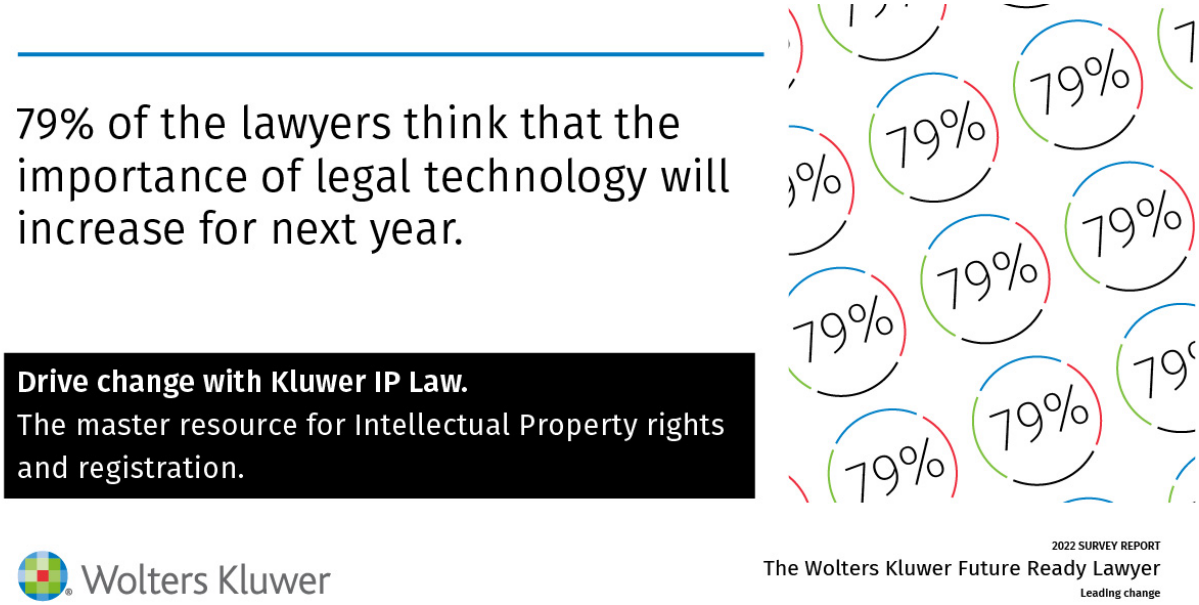

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