

Summary of New EPO Guidelines for Examination – November 1, 2014

EPO has implemented new Guidelines for Examination (the “EPO Guidelines”) as of November 1, 2014. <http://www.epo.org/law-practice/legal-texts/guidelines.html>. The new EPO Guidelines have been updated to reflect recent interpretations of EPO Law by the Boards of Appeal.¹

The changes are generally mixed, in terms of their impact on patent applicants. Some will make patentability easier, while others will make it more difficult. The following are the highlights:

- 1) Inventive Step and Sufficiency: The new EPO Guidelines tighten the standards for achieving an inventive step (Art. 54) and sufficiency of disclosure (Art. 83). These changes will likely make it more difficult for applicants to address inventive step and sufficiency issues.
 - a. *Tougher Inventive Step – more “problem/solution” starting points.* The EPO’s historical test for inventive step relies on a methodology known as the “Problem – Solution Approach.” As part of the methodology, a single prior art reference D1 is used as the starting point. But, under the new EPO Guidelines, the Examiner can use any of “several equally valid starting points for the assessment of inventive step . . .” Hence, the new EPO Guidelines allow an Examiner to more liberally assert multiple prior art grounds as starting points for assessing inventive step. (See Part G, VII, 5.1)
 - b. *Heightened Claim Scope Standards for Inventive Step and Sufficiency.* The new EPO Guidelines implement the EPO’s well-known *Agrevo* case (T939/92) and the Enlarged Board of Appeals decision G1/03. *Agrevo* permits the Examiner to raise inventive step rejections (Art. 56) if the alleged technical effect of a claim is not achieved across the full scope of the claim. Similarly, under G1/03, when a technical effect is recited in a claim, the Examiner can raise enablement/sufficiency rejections (Art. 83) if the technical effect is not achieved across the full scope of the claim. Hence, Applicants must carefully consider their claims during prosecution and confirm that the technical effect is commensurate with the scope of the claims requested. (See Part F, III, 12.)
- 2) Added Subject Matter: The EPO has relaxed its standard under Article 123 EPC for avoiding “added subject matter.” The infamous Article 123 requires that any amendments to an application must be “directly and unambiguously derivable” from the application as originally filed. Over the recent years, the EPO has enforced this requirement with increasing fervor, requiring literal basis for amendment support. The new EPO Guidelines, however, steer Examiners away from that approach. In particular, the new EPO Guidelines state that an “*Examiner should avoid disproportionately focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole.*” While this suggests a relaxation of the strict application of

¹ The EPO Guidelines are similar in purpose to the USPTO Manual of Patent Examining Procedure (MPEP), which provides guidance to U.S. Examiners on how to conduct substantive and procedural examination of patent applications.

Article 123 by Examiners, it is not clear to what extent the Opposition Division or Boards of Appeal will change their approach to evaluating added subject matter. (See Part H, IV, 2.3.)

- 3) **User Interface Inventions:** The new EPO Guidelines introduce a tighter standard for patenting user interface claims. Implementing the Technical Board of Appeal decision T 756/06, the EPO Guidelines now state “*a visual indication aimed exclusively at the mental activities of the viewer, in particular at preparing the relevant data for a non-technical decision making process by the user...is usually not regarded as making a technical contribution.*” (See Part G, II, 3.7.) There is no guidance yet on how this standard will be applied. Applicants should ensure that user-interface type claims impact more than mental activities of a viewer.
- 4) **New Search Procedure:** New EPC Rule 164 allows an applicant of a Euro-PCT application (i.e., a PCT application that nationalizes into the EPO) to pay a fee and submit additional claims for searching when entering the EPO phase or in response to a Rule 161 communication. Those newly submitted claims will then be searched, and the applicant will elect one of the searched claim sets to be examined, with the option to pursue the unelected claims in a divisional application. This revised approach allows an applicant to have new claims searched for patentability before deciding whether to file a divisional application. (See Part F, V, 13.1-3 and Part H, II, 7.4.2.)
- 5) **Medical Use Claims:** The new EPO Guidelines clarify the form of medical use claims including examples of acceptable claim language. This change is more of a formality than a substantive change. (See Part G, VI, 7.1.)

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