

# Questions from Swedish users with comments from EPO

Remaining questions from Swedish users

I have been trying to collect the feedback on all the remaining questions you sent in order to provide you with a consolidated feedback, however, the colleague in charge of the patent law harmonisation / Tegernsee project would need some more time to prepare an answer. Therefore, in the meantime, please find below the feedback on the questions related to the EPO practice:

## 1) Quality and skills of examiners with focus on the problem described

- Feedback from the appeal procedure

First of all it is important to address what seem to be a prejudice. There is no direct link between the quality of the examiners work and appeals. Several studies in this respect have shown this lack of correlation, in particular the disconnection between the quality of opposition divisions work and patentees or opponents decisions to lodge an appeal. Nevertheless, decisions of the Boards of Appeals are systematically screened and those, where a substantial procedure violation has been spotted, are carefully analysed. This review of the Boards of Appeal decisions is made by practice and procedure experts in DG1 and lawyers in DG5 and regularly discussed in the Practice and Procedure Committee leading where appropriate to improvement in the Guidelines and training to examiners. Of course examiners and managers are aware of decisions of the Boards of appeal on their decisions and individual feedback is provided by the managers whenever necessary with sometime individual training.

It must be said that when the Boards of Appeals overturn decisions of examining or opposition divisions, this much more often results from new facts and submissions filed by the parties during the appeal procedure than wrong decisions of the first instance.

## 2) Closest prior art

The examination of whether the claimed invention is new and inventive or not is made on the basis of the prior art revealed during the search.

For assessing whether the invention involve an inventive step, examiners applies the so-called "problem-and-solution approach". While this test is not prescribed by the convention it is the long established practice to use it. This practice has been confirmed by the case-law and is enshrined in the Guidelines (see G-VII, 5), which explicitly indicate that *"the so-called "problem -and -solution approach" should be applied. Thus deviation from this approach should be exceptional"*.

The first step of the problem-and-solution approach is to determine which is the closest prior art. How this closest prior art is determined by the examiners is also defined in the Guidelines (see G-VII, 5.1).

Therefore, the determination of the closest prior art is a key milestone in the examination of the invention patentability. In order to ensure proper information of the third parties, it is necessary to indicate in the published granted patent what is considered to be the closest prior art and what is the contribution of the invention over this closest prior art. This results from the provisions of Rules 42(1) (b) and (c) EPC. The long established practice to cite in the description the closest prior art revealed by the search and on which the presence of an inventive step has been assessed practice is explicitly indicated in the Guidelines F-II, 4.3.

Similarly, the Guidelines (see F-IV, 2.2) indicates that the wording of the independent claim(s) should reflect whenever applicable which features were known from the closest prior art (in

the preamble of the claim) and which are those charactering the invention (in the characterising part of the claim). This is also enshrined in Rule 43(1)(a) and (b) EPC.

It is very well understood that sometimes *“the Applicant does not want to point out what is considered to be the closest prior art”*, in particular during litigation in front of national court. However, EPO has also a duty to inform the public as to what is the basis for the decision to grant a patent. A public reasoning being only requested for negative decision, providing these key information in the description and through the claims wording ensure that a fair balanced is kept between the applicants and third parties interests.

3) **Changes in the description**

*“How a patent scope is decided in court”* is defined in Article 69 EPC completed by the Protocol on the Interpretation of Article 69 EPC. However, interpreting the scope of protection provided a granted patent is not the duty of EPO and specifically not of examiners. Examiners duty is to ensure that granted patents are based on clear description and claims consistent one with another (Articles 83 and 84 EPC).

This requires that when a patentable set of claims is in sight and before a patent is granted, the description is adapted to final set of claims as very often this one substantially differs from the originally filed claims. This ensures that patentees, third parties and national courts can meaningfully define what should be the scope of protection provided by European patents.

Amending the application documents is the responsibility of the applicants. Examiners may suggest amendments which could be acceptable by the applicants and would facilitate the grant of a patent. This happens mostly at the end of the examination procedure in the communication under Rule 71(3) for adapting the description to the last set of claims filed by the applicants. However, examiners only suggest amendments and applicants must approve them before they can formally be considered as amendments. This is consider to be good practice and expedient for closing examination. Generally, applicants and their representatives very much appreciate this service provided by examiners.

I hope this helps and I will try to provide you with an answer to the questions related to the Tegernsee project as soon as possible.