



The Rule 164 Problem

Non unity objections as made by the EPO,
and potential remedies

Presentation at VPP Bezirksgruppenveranstaltung
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M I C H A L S K I  H Ü T T E R M A N N
P A T E N T A T T O R N E Y S



Preface

- This presentation does not relate to patent applications, which lack novelty “**a priori**”, i.e., which have two or more independent claims related to different inventions.
- Today’s topic is a new search practice as exerted by the EPO towards “conventional” patent applications, under which, in case a dependent claim has been found to lack patentability, search is stayed and non-unity objection with respect to dependent claims is issued (“**a posteriori unity objection**”).



Overview

- The Problem
- Case Studies
- Remedies
- Further Problems
- Our Initiatives

The Problem

- Legal basis related to the establishment of non-unity (Art. 82, Rule 44), has not changed in EPC 2000.
- Consequences related to establishment of non-unity during search have changed with new Rule 164 EPC (amended from former Rule 112).
- Non-searched matter can no longer be referred to during prosecution, and additional search is no longer possible during examination.
- Furthermore, EPO has changed its search policy, insofar that in case a dependent claim has been found to lack patentability, search is stayed and non-unity objection with respect to dependent claims is regularly issued, combined with request to pay additional search fees for the alleged subinventions.
- Problem occurs both with EPO first and second filings as well as with PCT phases in which EPO acts as ISR.

Rule 164 EPC

- (1) Where the European Patent Office considers that the application documents (...) do not meet the requirements of unity of invention, a supplementary search report shall be drawn up on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, **first mentioned** in the claims.
- (2) Where the examining division finds that the application documents (...) do not meet the requirements of unity of invention, or protection is sought for an invention not covered by the international search report or, as the case may be, by the supplementary search report, it shall invite the applicant to **limit the application to one invention covered by the international search report** or the supplementary search report.

Art 17 PCT (3)

- (a) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. The International Searching Authority shall establish the international search report on those parts of the international application which relate to the **invention first mentioned in the claims** ("main invention") and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.
- (b) The national law of any designated State may provide that, where the national Office of that State finds the invitation, referred to in subparagraph (a), of the International Searching Authority justified and where the applicant has not paid all additional fees, those **parts** of the international application which consequently have **not been searched** shall, as far as effects in that State are concerned, **be considered withdrawn** unless a special fee is paid by the applicant to the national Office of that State.



How it used to be

claim set is searched

- claim 1 (independent)
- claim 2 (dependent)
- claim 3 (dependent)
- claim 4 (dependent)
- claim 5 (dependent)
- claim 6 (dependent)



**search finds claim 1
anticipated by prior art
examiner continues search**

- ~~claim 1 (independent)~~
- claim 2 (dependent)
- claim 3 (dependent)
- claim 4 (dependent)
- claim 5 (dependent)
- claim 6 (dependent)



**examiner suggests that e.g.,
combination of claims 1 and 4
might be novel**

- > claim 1 + 4 (independent)
- claim 2 (dependent)
- claim 3 (dependent)
- claim 4 (dependent)
- claim 5 (dependent)
- claim 6 (dependent)



How it is now

claim set is searched

claim 1 (independent)

claim 2 (dependent)

claim 3 (dependent)

claim 4 (dependent)

claim 5 (dependent)

claim 6 (dependent)



**search finds claim 1
anticipated by prior art,
examiner stays search**

~~claim 1 (independent)~~

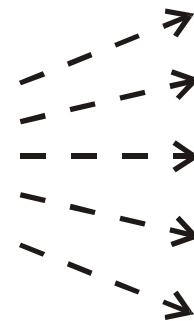
claim 2 (dependent)

claim 3 (dependent)

claim 4 (dependent)

claim 5 (dependent)

claim 6 (dependent)



**examiner states that
dependent claims have no general
inventive concept**

claim 2 (independent)

claim 3 (independent)

claim 4 (independent)

claim 5 (independent)

claim 6 (independent)

Consequences

- Applicant is invited, in a Rule 64 EPC/Rule 40 PCT communication, to pay additional search fees .
- Applicant must decide, in a 2 months term, if he wants to pay these fees for all, or at least some, of the alleged subinventions.
- Time limit is extremely short to determine which of the alleged subinventions has sufficient commercial use / potential to support patentability.
- Subinventions for which no additional search fees have been paid can not be referred to in the further prosecution to establish patentability.
- If novelty objection is maintained in prosecution, and additional search fees have not been paid, or only for “useless” subinventions, applicant must file divisional (cave: new time limit !).
- Applicant may pay the additional fees under protest (Rules 40.2 e) and 68.3 e) PCT, Rule 158 (3) EPC), this comes at additional fees of 790,- €

Digression (I): T 708/00

2. **„Die Neuheitsschädlichkeit einer Entgegenhaltung für einen bestimmten beanspruchten Gegenstand ist kein hinreichender Grund, um a posteriori auf mangelnde Einheitlichkeit der beanspruchten Gegenstände zu schließen.** Für die Feststellung der mangelnden Einheitlichkeit müßten diese Ansprüche eine "Gruppe von Erfindungen" definieren, d. h. verschiedene erfinderische Alternativlösungen oder konkretere erfinderische Ausführungsformen, die ursprünglich Teil derselben bekannten allgemeinen Idee waren. [...]"

3. **„Eine Änderung, mit der der Gegenstand des Hauptanspruchs durch zusätzliche, in der ursprünglich eingereichten Anmeldung offenbarte Merkmale nachträglich beschränkt werden soll, beeinträchtigt generell weder nach R. 86 (4) noch nach R. 46 (1) EPÜ die Einheitlichkeit der Erfindung.** Eine derartige Änderung stellt eine normale Reaktion eines Anmelders auf einen Einwand gegen die Patentierbarkeit desselben, nicht beschränkten Gegenstands dar [...]"

Digression (II): W 0036/90

3.1 “Moreover, in the Guidelines for International Search [...] it is stated that in cases of lack of unity, especially in an "a posteriori" situation, the search **examiner may decide to complete the international search for the additional invention(s) together with that for the invention first mentioned, in particular in those cases where the inventions are conceptually very close and none of them requires search in separate classification units.** If the search examiner exercises his discretion in this manner then all results should be included in the international search report and no objection of lack of unity of invention should be raised (cf. Chapter VII, point 12).

In the Board's judgement, **the present case is clearly one in which the search examiner should have exercised his discretion** in agreement with the above Guidelines since both these prerequisites are met in the present case (C 07 H 15/252)”.

Public discussion

- Problem has been addressed at the EPO/epi Biotech committee meeting 2008, and the epi complained that the examiner's approach is very formal, rather than common sense.
- Issue is discussed in epi information 1/2009, but emphasis is laid on the fact that Euro PCT phases are treated differently by the EPO, depending on the respective ISA (EPO or others).

Case study (I)

- Independent Claim: Diagnostic method
- Dependent claim: 1400 oligonucleotides which can be used for purpose of independent claim
- First filing at EPO
- R 64 communication finds claim 1 anticipated by prior art, 1400 additional search fees are requested
- Examiner makes no attempt to consider whether or not subject matter of independent claim together with a few oligonucleotides from dependent claim might be novel
- Term to pay additional search fees: 1 month (Rule 64 term has been amended to 2 months by April 1, 2010)
- Applicant decided, for practical reasons, not to pay additional search fees (how many ? for which oligo ?)
- Applicant hopes that, during the examination, he can convince the examiner that claim 1 is novel. Otherwise, applicant has to file divisionals (how many ? for which oligo ?)



Case study (II)

- Independent Claim: Surface coating method
- Dependent claims relate to preferred embodiments
- PCT application with EPO as ISR
- R. 40 PCT communication finds claim 1 anticipated by prior art, stays search, identifies seven subinventions and requests additional search fees
- Examiner makes no attempt to consider whether or not subject matter of independent claim together with subject matter from selected dependent claims might be novel
- Term to pay additional search fees: 1 month (now: 2 months, see supra)
- After discussion with patent attorney, applicant decides to pay additional search fees for subinvention 1 (dependent claim 13) only, because the latter recites the technical embodiment which will be put into practice, and, after patent attorney has conducted an additional novelty search, seems to meet the novelty requirement
- ISR + written opinion finds combination of claim 1 + 13 novel

Digression: Unsearched matter problem

Regel 137 EPÜ: Änderung der Europäischen Patentanmeldung

(3) Weitere Änderungen können nur mit Zustimmung der Prüfungsabteilung vorgenommen werden.

(5) Geänderte Patentansprüche dürfen sich nicht auf nicht recherchierte Gegenstände beziehen, die mit der ursprünglich beanspruchten Erfindung oder Gruppe von Erfindungen nicht durch eine einzige allgemeine erfinderische Idee verbunden sind. Sie dürfen sich auch nicht auf gemäß Regel 62a oder Regel 63 nicht recherchierte Gegenstände beziehen.

Regel 36 EPÜ: Europäische Teilanmeldungen

(1) Der Anmelder kann eine Teilanmeldung zu jeder anhängigen früheren europäischen Patentanmeldung einreichen, sofern:

a) die Teilanmeldung vor Ablauf einer Frist von vierundzwanzig Monaten nach dem ersten Bescheid der Prüfungsabteilung zu der frühesten Anmeldung eingereicht wird, zu der ein Bescheid ergangen ist, oder

b) die Teilanmeldung vor Ablauf einer Frist von vierundzwanzig Monaten nach einem Bescheid eingereicht wird, in dem die Prüfungsabteilung eingewandt hat, dass die frühere Anmeldung nicht den Erfordernissen des Artikels 82 genügt, vorausgesetzt, sie hat diesen konkreten Einwand zum ersten Mal erhoben.

Possible Remedy: Unsearched matter problem

- Provoking non-unity objection during examination for triggering additional term according Rule 36 (1) EPC for filing a divisional application
- Advantage: unsearched matter can be claimed in a later stage
- Drawback: additional fees, long period of time until grant
- Risk: non-acceptance of new claim(s) according Rule 137 (3) EPC without non-unity objection leading to potential total loss of claimable subject matter

Remedies: Overview

- I. Discussion with search division
- II. One-claim approach
- III. Feature-pool approach
- IV. Claims chain approach
- V. Let others search-approach
- VI. Search first and draft narrow-approach
- VII. Identify potential subinventions-approach
- VIII. Political approach

Remedies (I): Discussion with search division

- Filing arguments for the presence of unity and requesting corrected search report ex officio within the 2-month term according R. 64 (1) EPC.
- Advantage: no fees
- Drawback: success unlikely
- When in connection with a paid additional search fee arguments will be considered more likely.
- For a PCT-application paying additional search fee under protest is possible (protest fee: 790,- EUR).

Remedies (II): „One claim approach“

- After drafting EP- or PCT-application in a conventional manner (i.e., different independent claims with several dependent claims each), make sure that the respective subject matter is disclosed in the specification, then delete all claims except independent claim 1.
- Advantage: Rule 63 (3)/164 trap is avoided. Search Report cannot object unity of invention, as required by Rule 63 (3)/164. Patent prosecution can be done on the basis of the complete disclosure. “Unsearched matter” objection unlikely.
- Drawback: Search report will be almost useless, as it does not help to identify patentable embodiments from the dependent claims.
- Risk: non-acceptance of new claim(s) according Rule 137 (3) EPC



Remedies (III): „Feature-pool approach“

- In addition to one claim approach, submit one (1!) dependent claim which contains the subject matter of all possible dependent claims, logically linked by “and”.
- Make sure that, in the specification, the different embodiments of the dependent claims are disclosed as independent alternatives.
- Advantages: search will also cover the maximally restricted embodiment of the dependent claim; unsearched matter ruled out
- Drawback: inventive feature not identified
- Risk: non-acceptance of new claim(s) according Rule 137 (3) EPC

Remedies (IV): „Claims chain approach“

- All dependent claims refer back to the directly preceding claim only without referring to other claims in the alternative.
- Make sure that, in the specification, the different embodiments of the dependent claims are disclosed as independent alternatives.
- Advantages: no alternative inventions; search will also cover the restricted embodiments of the invention; unsearched matter problem ruled out
- Drawback: identified inventive feature only in combination with all preceding claims
- Risk: non-acceptance of new claim(s) according Rule 137 (3) EPC

Remedies (V): „Let others search-approach“

- Submit first filing at GPTO (if specification is German) or UKIPO (if specification is English) together with examination/search request. Search/examination report will most probably cover the complete set of claims.
- Submit PCT filing according to “one claim approach” or “feature pool approach” or “claims chain approach”.
- Advantage: In addition to “one claim approach” etc., additional knowledge about novelty of preferred embodiments is available.
- Bonus advantage: Filing/search fees charged by GPTO (310,-/410,- €) or UKIPO (130,- £) are considerably lower than those charged by EPO

Remedies (VI): „Search first and draft narrow-approach“

- Carry out full-featured prior art search prior to drafting and draft the set of claims in such way that independent claims meet novelty/inventive step requirement in view of the prior art found.
- Advantage: Reduced risk that Rule 40 PCT/Rule 64 EPC communication is provided
- Drawback: broadening of independent claim only in line with Art 123 EPC possible; no search results for broadened claim
- Risk: disregarding of important features due to clarity objections; if EPO finds prior art for independent claim, non-unity objection will be provided nonetheless.



Remedies (VII): „Identify potential subinventions-approach“

- During drafting, the potential subinventions can be identified, recorded and ranked, so that, after receiving a respective Communication, a decision can be made quickly for which subinventions additional search fees are to be paid.
- If the most important subinvention is placed first in the set of claims, chances are that this subinvention will be searched, and additional search fees, or even divisional applications, may turn out obsolete.



Remedies (VIII): „Political approach“

- Political initiative: GPTO could become ISA for PCT-applications (see Art.16(3)(c), R. 34, 36 PCT).
- ISR carried out by GPTO would most probably cover the complete set of claims.
- Being ISR could be attractive for the GPTO, as search fees requested by the EPO are much higher than examination fees currently requested by GPTO (1700,- € vs. 350,- €).
- GPTO would probably have to accept PCT filings in English language.
- Advantage: Search fees probably lower, and search will most probably cover all claims.

Remedies: Summary

No	Name	Essentials
I.	Discussion with search division	Filing arguments and requesting corrected search
II.	One-claim approach	Only one independent claim, i.e. no Rule 64 communication can be issued
III.	Feature pool approach	One independent claim + dependent feature pool claim, i.e. risk of Rule 64 communication reduced
IV.	Claims chain approach	Only one dependency to preceding claim of dependent claims, i. e. no alternative inventions
V.	Let others search-approach	First filing + search/examination request with full set of claims in UK or DE, then EP- or PCT-filing with approach I. or II.
VI.	Search first and draft narrow-approach	Draft claim narrow according to prior art found to avoid novelty objection
VII.	Identify potential subinventions-approach	Identify subinventions to prepare for Rule 64 communication
VIII.	Political approach	Try to make GPTO a PCT ISR



Further problems (I): Rule 36 EPC

- Under new Rule 36 EPC, divisional applications can, from April 2010, only be filed within a time limit of 24 months from the first office action in the parent application.
- New Rule 36 applicable to all pending applications
- Transitional term for then still pending applications until 1 October 2010.
- New Rule 36 makes a quick examination procedure necessary, in order to be able to file a divisional prior to grant/rejection.



Further problems (II): T 307/03

- T 587/98 confirmed that there is no basis in the EPC prohibiting double patenting, and that there is no problem if parent application has a main claim with all features of the main claim of a divisional, plus an additional feature.
- Example: It appears quite often that parent application had main claim A + B, and was restricted to A + B + C, e.g., during oral proceedings, in order to accelerate grant. Applicant has earlier submitted a divisional in order to open up a new examination, to eventually get A + B granted as well.
- T 307/03 disagrees with T 587/98 (although case constellation was vice versa, i.e., parent application has been granted with main claim A + B, and divisional had A + B + C as main claim).



Further problems (II): T 307/03

2. “Decision T 587/98 (OJ EPO 2000, 497) to the effect point 3.6) that there is no basis in the EPC prohibiting "conflicting claims" not followed”
3. “A double patenting objection can be raised also where the subject matter of the granted claim is encompassed by the subject matter of the claim later put forward (*in the divisional application**), that is where the applicant is seeking to re-patent the subject-matter of the already granted patent claim [...].”
3. (cntd‘) „In particular, where the subject matter which would be double patented is the preferred way of carrying out the invention both of the granted patent and of the pending application under consideration, the extent of double patenting cannot be ignored as de minimis.“

* added by editor

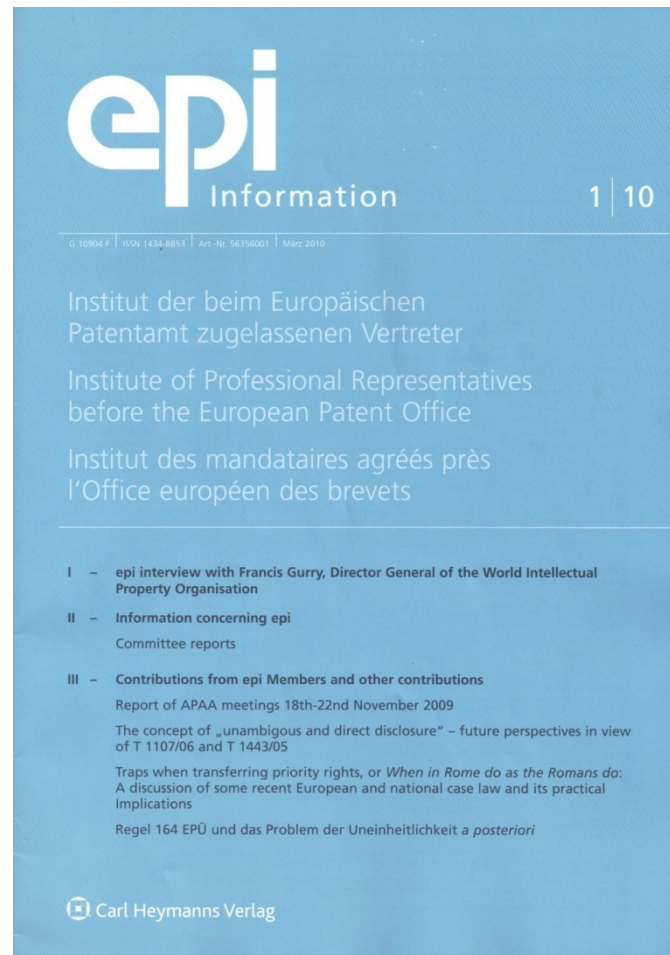
Our initiatives

- Our initiative letter has been forwarded to VCI by BASF and Henkel heads of IP.
- Journal article has been published in epi information.
- Firm has commenced a comparative study in which we file, for clients who want to have an EP first filing, simultaneously a UK application (if specification is in English), or a DE application (if specification is in German), on our own costs, in order to compare quality of search report. First results are to be expected within short.
- New Secretary of Justice, Mrs. Leutheuser-Schnarrenberger, is former senior employee of the GPTO. Mrs. Leutheuser-Schnarrenberger will probably support an initiative to promote the GPTO as ISA.



Rule 164 EPC

Further reading





Rule 164 EPC

Invitation

Michalski  Hüttermann
PATENTANWÄLTE

3. Rheinisches Biopatent-Forum, 2. Juni 2010

Vorabend, 18:30 „Feierabendbier“ für die am Vorabend angereisten Teilnehmer/innen
Restaurant „Meerbar“, Neuer Zollhof 3, 40223 Düsseldorf

9.00 – 9.30 Begrüßung, Registrierung, Kaffee
FA Dr. Ulrich Storz, Patentanwälte Michalski - Hüttermann & Partner

9.30 – 10.15 Neues aus der Life Science-Rechtsprechung
FA Dr. Andreas Hasel, Patentanwälte Michalski - Hüttermann & Partner

10.15 – 11.00 Der offenbare Schutzbereich – Überlegungen zu den Auswirkungen von „Olanzapin“ auf die Praxis des Verletzungsprozesses
Dr. Tilman Böttner, Richter am LG Düsseldorf
Chairman: Dr. Aloys Hüttermann, Patentanwälte Michalski - Hüttermann & Partner

11.00 – 11.30 - Kaffeepause -

11.30 – 12.15 Technologietransfer aus den Instituten in die Industrie – aus der Pflanzendiversität
Dr. Jürgen Wolfenbarger, Pflanzendiversität
Chairwoman: Dr. Sonja Althausen, Patentanwälte Michalski - Hüttermann & Partner

12.15 – 13.45 - Mittagessen -

13.45 – 14.30 Erteilung und Schutzbereich von Biosequenzansprüchen
FA Dr. Ulrich Storz, Patentanwälte Michalski - Hüttermann & Partner

14.30 – 15.15 Das neue ArtErFG: Erste Erfahrungen aus der Praxis **Patentlandschaft im Bereich „molekular diagnostic“**
alt:
RA Dr. Martin Quastbach, CEPI Dr. Johannes Driehaus, Patentanwälte Michalski - Hüttermann & Partner
Rechtsanwälte, Köln

15.15 – 16.00 - Kaffeepause -

16.00 – 16.30 Upcoming FDA regulations on Follow-on Biologicals/Biosimilars
Mary Ann Merchant, Ballard & Spahr
Chairman: Dr. Uwe Albenmeyer, Patentanwälte Michalski - Hüttermann & Partner

16.30 – 17.00 offene Diskussion ***

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Thank you very much for your kind attention



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P A T E N T A T T O R N E Y S