



Topic 2 - New prior art

Possibilities to Amend / 'Rescue' an application when new prior art is found

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Becky White
Patent Attorney

Let's say...

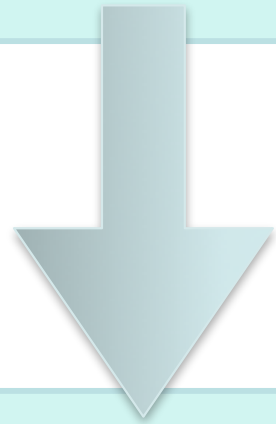
File new patent application



Prior art located

Let's say...

File new patent application



Prior art located

= *Independent claim 1 is not novel*



Uh oh...

■ Is everything lost?



Uh oh...

- ~~Is everything lost?~~
- No! But the outcome depends on a few things...



What are the options?



What are the options?

- **Argue** against the prior art assertion
- Withdraw and **re-file application**
- **Amend** claim 1 to be patentable



1) Argue against the prior art assertion

- Don't automatically assume the objection is correct

- Check:

- Is this proper prior art?

- Publication date

- Grace periods

- Does it really invalidate the claim?

- What options are there to argue?

- Search report or examiner cited art?

- Cited during litigation?

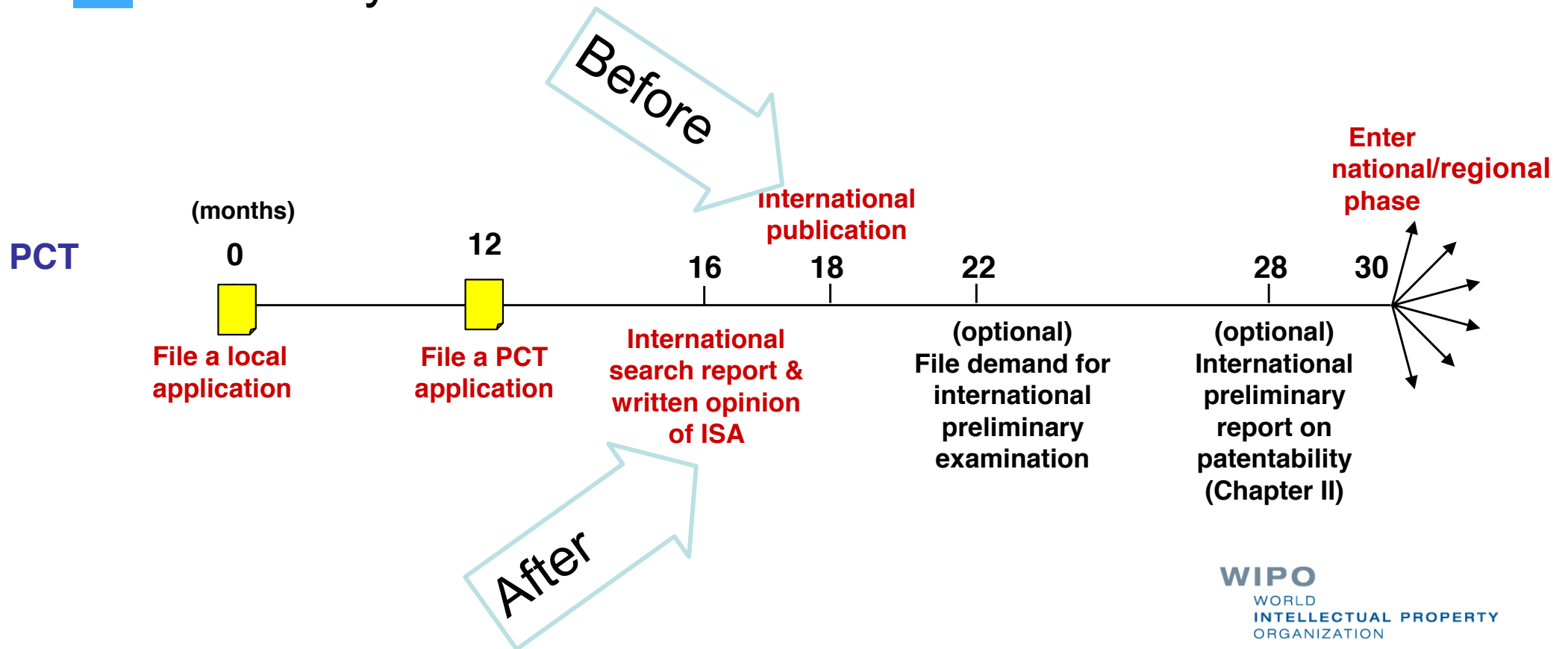
2) Withdraw and re-file the application

- Possibility to reframe claims and/or add new material to address the cited art?
- Often very short time to achieve this

2) Withdraw and re-file the application

■ Possibility to reframe claims and/or add new material to address the cited art?

■ Often very short time to achieve this



3) Amend the claim

The rule on 'new matter'

- No new matter can be added to a patent application after the filing date
- Therefore amendments must be based on what you have in:
 - Dependent claims
 - The specification
- Therefore the description of the invention must be of a **sufficient depth** when the patent application is filed

3) Amend the claim

Options

- Incorporate subject matter from a dependent claim
- Incorporate subject matter from the description

Very very very very common during prosecution

- It does not mean the claims were poorly drafted

“If your patent claims go to grant immediately, then they were drafted poorly”





How to amend claims

1. An apparatus, comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising a light
attached to the centre of the pencil.

Prior art located =



Check - is the prior art valid?

Claim 1 elements	Prior art?
Apparatus	
Pencil	
Eraser	
Eraser attached to one end of the pencil	



= valid prior art
Claim 1 is anticipated

(Assumed published before priority date)

Check - is the prior art valid?

Claim 2 elements	Prior art?
Claim 1 elements	✓
Light	✗
Light attached to centre of the pencil	✗



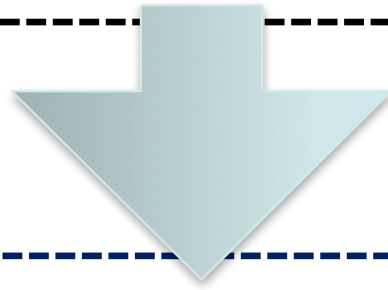
**Claim 2 is novel
(not anticipated)**

(Assumed published before priority date)

How to resolve???

1. An apparatus, comprising:
 - a pencil;
 - an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising a light attached to the centre of the pencil.

1. An apparatus, comprising:
 - a pencil;
 - an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising a light attached to the centre of the pencil.



1. An [~~The~~] apparatus [~~of claim 1~~], [~~further~~] comprising:
 - a pencil;
 - an eraser attached to one end of the pencil; and
 - a light attached to the centre of the pencil.

Other considerations

- Costs
- Timeframes
- Are other filings possible? (e.g. improvements)
- Other IP protection options?
 - Utility models
 - Design registrations
 - Others such as branding?
- Educate for next time
 - Prior art can be 'self-prior art'
 - Publication = publication to anyone
 - Note: grace periods are only available in some jurisdictions and it is recommended only to rely on these when absolutely necessary

Another example - amendment

- New invention - tea brewing method
- Key feature: brewing at 50°C



Dependent claims at filing

1. *A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.*
2. *The method according to claim 1, wherein the tea leaves are provided in a tea bag.*
3. *The method according to claim 1 or 2, wherein the water is at least 65°C.*
4. *The method according to claim 3, wherein the water is between 75°C and 85°C.*

Prior art



How might you amend the claims?

1. *A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.*
2. *The method according to claim 1, wherein the tea leaves are provided in a tea bag.*
3. *The method according to claim 1 or 2, wherein the water is at least 65°C.*
4. *The method according to claim 3, wherein the water is between 75°C and 85°C.*

How might you amend the claims?

1. A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.
2. The method according to claim 1, *wherein the tea leaves are provided in a tea bag.*
3. The method according to claim 1 or 2, *wherein the water is at least 65°C.*
4. The method according to claim 3, *wherein the water is between 75°C and 85°C.*

Amending the claims

1. *A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.*
2. *The method according to claim 1, wherein the tea leaves are provided in a tea bag.*



1. *A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C, wherein the tea leaves are provided in a tea bag.*

Amending the claims (continued...)

3. The method according to claim 1 or 2, *wherein the water is at least 65°C.*
4. The method according to claim 3, *wherein the water is between 75°C and 85°C.*



2. The method according to claim 1, *wherein the water is at least 65°C.*
3. The method according to claim 2, *wherein the water is between 75°C and 85°C.*

Pitfalls

1. *A method of brewing tea, comprising steeping tea leaves in liquid at a temperature of at least 50°C.*
2. *The method according to claim 1, wherein the liquid is at most 80°C.*
3. *The method according to claim 2, wherein the liquid is between 75°C and 85°C.*

Pitfalls - suggestion 1

1. *A method of brewing tea, comprising steeping tea leaves in liquid at a temperature of at least 50°C.*
2. *The method according to claim 1, wherein the liquid is at most 80°C.*
3. *The method according to claim 12, wherein the liquid is between 75°C and 85°C.*

Pitfalls - suggestion 2 (better?)

1. *A method of brewing tea, comprising steeping tea leaves in liquid at a temperature of at least 50°C.*
2. *The method according to claim 1~~2~~, wherein the liquid is between 75°C and 85°C.*
3. *The method according to claim 1 or claim 2, wherein the liquid is at most 80°C.*

(Claims 2 & 3 reordered)