



Topic 11: **Rejections**

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Overview

- Procedural principles
- Reasons for rejections

Termination of an application

Depends on individual patent law, e.g.

- Deemed to be "withdrawn"/"abandoned": no examiner action involved; becomes effective after the applicant has failed to take an action
- Rejected/refused: action/decision by examiner (examination division/registrar/commissioner)

Procedural principles

■ Principle of party disposition

- Applicant determines beginning, end and extent of proceedings through requests

■ Applicant's requests determine the extent of each proceeding

- Binding effect for examiner as to content and sequence of requests, e.g. examiner can grant only claims with wording that the applicant requests
- Examiner to decide either “**Yes**” or “**No**”
- Examiner cannot amend and grant the application without the consent of the applicant

Procedural principles

■ Principle of “ex officio” examination

- Granting or maintaining a patent affects the rights of third parties
 - Examiner’s obligation to examine facts and evidence within the extent of proceedings and according applicable law, rules, regulations, case law
- Patent can only be granted when certain requirements are met, otherwise it has to be rejected.

Reasons for rejecting applications

■ Lack of

- Technical nature
- Unity
- Exemptions/exclusions
- Industrial applicability
- Novelty
- Inventive step
- Sufficient disclosure
- Legal certainty of claims (clarity)
- Additions to initial disclosure

Should be checked before prior art search

Requires prior art search

Fundamental procedural principle

■ Right to be heard, fair trial

- Guaranteed by constitution, international treaties, European Human Rights Charta
- Adverse decisions like a rejection can only be based on reasons that
 - were previously communicated to applicant, and
 - if he has had an opportunity to respond it (it is not necessary that he did respond)

When ?

Rejections are due when the examiner thinks

- Amendment(s) of the application submitted by the applicant are not sufficient to the objections raised by the examiner
- The case is sufficiently discussed between the applicant and the examiner, i.e. if an agreement is not likely and further discussion would delay the case
- No further request are pending

Rejection rulings

The rejection ruling should enable the body in charge of the potential appeal to get a comprehensive picture of the recent procedural steps that have lead to the rejection, i.e. it should include as a **first part** a summary of the

- Latest request(s) of the applicant and when they were submitted
- Objections raised by the examiner and when they were communicated
- Relevant prior art, if necessary
- Recent response of the applicant, including his reasons/views and whether he amended his request

Rejection rulings cntd

The second part includes the detailed ruling including

- The main ground of rejection
- Facts and evidence that are relevant for the ground of rejection and a reasoning why the ground of rejection is given in view of these facts
- An explanation why the reasoning of the applicant is not acceptable/pertinent

Sample ruling – part 1

Application 1234567 was filed on dd/mm/yy with a claim to priority from DE- A-1 456789 filed on .././.. .

In communications dated .././../ and .././../ the applicant was advised that the subject matter of claim 1 lacked novelty with regard to US-A-2 345 678 and the subject matters of the dependent claims lacked an inventive step with regard to a combination of US-A-2 345 678 GB A-8 765 432.

In the letter of .././../ the applicant filed arguments in reply to the objections raised together with an amended claim 1, and with the letter of .././../ the applicant filed further arguments in favour of patentability. Oral proceedings have not been requested.

The applicant requests the grant of a patent based on the following documents:

Description pages 1 – 6 as originally filed;
claim 1 as filed with the letter of .././.. ;
claims 2 – 5 as originally filed;
drawings sheets 2/2 as originally filed.

Independent claim 1 reads as follows:

Dependent claims 2 – 5 relate to further constructional details of claim 1.

Sample ruling – part 2

The present application does not meet the requirements of Art. 52(1) and 54(1) and (2) of EPC, because the subject matter of claim 1 is not new with regard to the disclosure of US-... - US-.... (Fig. 3) shows a table having four legs evenly distributed around the periphery of the table top and the legs do not protrude beyond the periphery. Since a table which has four legs inevitably has three legs (plus one) the subject matter of claim one is not new.

- The applicant argues that the claim implies that only three legs are present. However this cannot be accepted, since, as was stated in the communication of/.. , the word „only“ does not appear in the claim and thus the claim is not so limited.
- Even if claim 1 were amended to clearly state that only three legs were present, the subject matter of claim 1 would not involve an inventive step.
- DE-... shows a table having three legs acc. to claim 1. The difference to this subject is that the legs do not protrude beyond the periphery of the table. US-.... also deals with the problem of protruding legs and clearly states (at column 5, lines 20 – 30) that this problem is to be avoided by arranging the legs in a non-protruding way.
- Thus it is obvious for a skilled person to modify the three legged table of DE-... using the information from US-.... and thereby arrive at the subject matter of claim 1. Claim 1 cannot be allowed for lack of inventive step.

Claims 2 – 5 describe various constructional details readily visible in both documents mentioned above and therefore do not add to claim 1 any matter which could involve an inventive step over the combination of the cited documents.

Since the application does not meet the req. of EPC it is rejected (Art 97(1))

Thank you