

European Patent Office

Working Group on Multiple Invention Disclosures and Complex Applications under the SCP

I. General comments

The EPO recognises the need for measures to deal with applications that cause undue burden to examiners, *particularly during search*. In July 1999, the EPO announced¹ that the provisions of Articles 5 and 6 PCT would be applied strictly in the International Preliminary Examination and more frequent use would be made of the provisions of Article 17(2) PCT to issue a declaration (which is usually a reasonable limitation of the scope of the search). This was followed in May 2000 by the EPO publishing its new approach², in the form of amended Guidelines, for dealing with complex applications, in particular applications having many claims, Markush formulae, broad claims (*desiderata*) and/or parametric definitions. The approach has some implications for dealing with non-unitary applications as well. Details of the new approach are referred to in the comments below.

In practice, examiners at the EPO receive guidance - while basing the search on the claims (eg. cf. Article 15(3) PCT) - on how to focus their search effort on the disclosed invention(s), rather than the *exact* structure and wording of the claims. Where the examiner finds that these inventions differ so much from the wording of the claims that the search cannot represent a complete meaningful search of the whole scope of the claims, in some of these cases, a measure under the complex applications approach may be appropriate.

In the points below, the specific concerns raised in the WIPO invitation are considered. Some tentative suggestions are proposed. A promising option appears to be the possibility of requesting amendments before search, applying the *standards presently used* by the EPO under the new approach for dealing with complex applications.

II. Specific issues

1. Unity of invention

The PCT protest procedure is cumbersome, requiring the initiation of a review procedure, which is time-consuming and requires a very detailed and extensive reasoning by the examiner. No such review procedure exists under the EPC, although there is the possibility that when the substantive examiner does not uphold a lack of unity made by the search examiner, then the Applicant may request reimbursement of additionally paid search fees (Rule 46(2) EPC).

¹ See http://www.european-patent-office.org/epo/pubs/oj99/7_99/7_4259.pdf, OJ 7/1999, page 426

² See http://www.european-patent-office.org/epo/pubs/oj000/5_00/5_2280.pdf, OJ 5/2000, pages 228-234

One of the problems in EPO practice is specific to the EPO in that present EPO case law on PCT non-unity protests (see Decision W1/97) rules out the possibility to ask for further additional search fees after a first invitation to pay additional search fees on the grounds that there is no explicit provision in the PCT allowing such a further invitation. It is often impossible to judge at the time of the first invitation what the different inventions are.

In substantive examination, if a partial search report is issued, (*i.e.* additional fees are not paid, Rule 46(1) EPC) then only that subject matter which has been searched is examined, and the non-searched, *i.e.* non-unitary subject-matter must be deleted, with no possibility of diverting to subject-matter not contained in the first mentioned and searched invention. If all search fees are paid, the applicant may elect which invention is to be examined, and the other inventions must be deleted but may be the subject of one or more divisional applications.

Possible solutions:

- *Thought should be given to streamlining the PCT protest procedure and eventually eliminating it altogether.*
- *The filing of divisional applications under the PCT should perhaps be considered.*
- *The PCT Rules could contain an express provision allowing examiners to issue a further invitation to pay additional search fees if further lack of unity is noted in the course of the search, after the first invitation has been sent.*

2. Linking of claims

The EPO has no specific rules on multiple dependencies, and they are allowable, hence Rule 6.4(a) PCT, fourth sentence does not apply.

In practice, multiple dependencies and -more in general- the structure and/or size of the 'claims tree' and/or the wording of the claims, may pose significant difficulties for search and also in substantive examination when trying to establish what the subject-matter is for which protection is sought. Under the EPO's approach on complex applications, examiners may -in very complex cases- invoke Article 17(2) PCT and restrict the subject of the search in such cases, based on lack of clarity and/or conciseness (Article 6 and Rule 6.1(a) PCT). However, even with the new approach on complex applications, substantial analysis of the claims is still needed before Article 17(2) PCT can be invoked, or before lack of unity can be established. In some technical fields, the overall complexity of applications is now such that both Article 17(2) and Article 17(3) PCT are invoked during the International Search.

In substantive examination, the examiner has the option of raising a clarity and/or conciseness objection in the first letter before continuing with the examination of the other requirements. Moreover, substantive examination concentrates on the patentability of independent claims anyway.

Possible solutions:

- *Guidance similar to that provided by the EPO on complex applications may make it simpler for examiners - in case of unduly complex claims trees - to restrict the subject of the search to, for example, what the description defines as the invention.*
- *It might also be possible to introduce a Rule which gives guidance on limitation of linking to no more than one other claim category.*
- *Requiring the applicant to diminish the complexity of the claims tree before a search is carried out ("amendment before search") would also provide a satisfactory solution. This would not necessarily involve amendment of specific claims, but could for example be restricted to simply deleting certain claims. Problems of added subject-matter would then be obviated. (If at some future date, there was no procedural separation between International Search and International Preliminary Examination, the issue of how to introduce amended claims could perhaps be reconsidered).*

3. Number of claims

The EPO has no limit on the number of claims. However, the number of claims in an application can be objected to under Article 84 EPC (lack of clarity/conciseness, see *EPO Guidelines for Examination in the European Patent Office*, C-III, 5), and under the new Rule 29(2) EPC, which states that there should be, in principle, only one independent claim per claim category. Any exception to this rule must be convincingly justified by the Applicant. In the case of a high number of dependent claims, provided that they are all truly dependent as defined in Rule 29(4) EPC, then the substantive examination will concentrate on the independent claims.

A limit on the number of claims has been discussed in the context of the new approach on complex applications. However, this does not seem to be a useful or workable option³. A simple move from multiple claims to various alternatives within a single claim would circumvent such a requirement. An additional limit on the number of embodiments falling within the scope of one claim would not seem workable either, as this unduly restricts Markush formulations and is impossible to apply where functional or Markush definitions are used, because it is virtually impossible to establish the number of embodiments. On the other hand, it is not only the number of claims *per se* that gives rise to a problem, but also in particular their status (*i.e.* independent or dependent).

Possible solution:

- *Introduce a Rule into the PCT similar to Rule 29(2) EPC, allowing in principle only one independent claim per claim category.*

³ The same issue was raised by the USPTO in October 1998 as proposal number (4) in order to Implement its Patent Business Goals. Under this, the USPTO was considering limiting the number of claims in an application to forty, with a maximum of six independent claims. When consulted, US applicants rejected this proposal. The reasons were mostly that the applicants must have the freedom to draft the applications according to their needs and the USPTO had already sufficient means for dealing with this issue.

4. Requirement of “clear and concise” claims

Since the introduction of the complex applications approach, and the introduction of new *Guidelines* (OJ 5/2000, p228-234), a more rigorous application of the basic provisions of the EPC has been provided for. For claims defined by parameters, where these claims use non-standard parameters against which a meaningful comparison with the prior art cannot be made, a lack of clarity under Article 84 EPC is the objection of first instance, as the parameter chosen does not allow a proper comparison with the prior art. Also, desideratum claims, which attempt to define the product by reference to a result to be achieved lack clarity under Article 84 EPC and possibly sufficiency of disclosure under Article 83 EPC (see the *Guidelines*, C-III, 6.4, based on the EPO BoA decision T409/91). Conciseness is also directly referred to in the amended *Guidelines* (see C-III, 5).

Although the amended EPO *Guidelines* have clarified the situation considerably, and specifically addressed these problems, Article 84 EPC objections often give rise to lengthy and subjective discussions with the applicant during substantive examination as to what exactly is clear and concise. Considerable scope for interpretation of the requirements of Article 84 EPC means that after a partial search report has been issued, the substantiation of the objection often requires more than one communication before novelty and inventive step can even be addressed.

Possible solution:

- *Guidelines for the specific interpretation of clarity and conciseness in this context would be desirable, such that a consistent practice for limiting claims which lack either one or both requirements could be applied.*

5. Special procedures to treat complex applications, such as mega-applications, or large sequence listings

EPO practice regarding complex applications has two strands:

Search

In the search phase, the examiner may issue a partial search report and limit the subject of the search if it is impossible to carry out a meaningful search because of deficiencies regarding support, disclosure, clarity and/or conciseness (Articles 83 and 84 EPC). This applies, as set out above, to several types of applications, where the terms of the claim are very general, or where the scope is extremely wide, including the more extreme cases of applications with many claims, Markush formulae, unduly broad desiderata, unusual or inaccessible parametric definitions. Normally the search is restricted to the subject-matter which is disclosed, supported, clear and concise, for example certain dependent claims or a generalization of the enabled embodiments. Only in the most extreme cases will no search be carried out at all.

Substantive examination

In substantive examination a stricter application of the requirements of disclosure, support, clarity and conciseness is in force. Where a partial search report has been issued, the substantive examiner will normally take over the observation made during the search on these substantive issues. Where the claimed concept has diverted from the subject-matter of the initial search, it is not allowed under the EPC to amend to subject-matter which has not been searched if it is not unitary with the searched subject-matter (Rule 86(4) EPC).

The amendments to the *Guidelines C-II*, 4.1 and 4.9 have allowed for more precise objections to be made under sufficiency of disclosure. If the examiner does not feel that substantially all of the embodiments falling within the wording of a claim are enabled by the description, then a reasoned case must be made, and the onus is on the applicant to show the contrary.

However, lack of support objections tend to lead to long discussions with the applicant, who may take the position that one worked example in the description provides support, or that a verbatim repetition of the claim wording in the description constitutes support, or that so-called "paper examples", *i.e.* without data, are sufficient. For Markush claims, it is particularly difficult to judge what constitutes support, especially where there are many preferred embodiments in dependent claims, which may have no exemplification in the description. Rule 23e(3) EPC states that the industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application, which provides a concrete basis for objections in such applications.

Possible solutions:

- *A requirement similar to Rule 86(4) EPC would overcome the concern expressed by the US delegation regarding re-searching where the claimed concept has diverted from the subject-matter of the initial search.*
- *In general, the so-called "amendment before search" option is seen as a desirable remedy, as in fact, the problems encountered in search are much greater than in examination.⁴ It could be an option in cases of applications containing unduly complex claims, Markush claims (similar to the US 'election of species' practice), large numbers of claims, unusual parameters, or -in general- in those cases where a meaningful search is not possible due to deficiencies under the disclosure, support, clarity and/or conciseness requirements. The problem of observance of time limits is an important procedural factor to be considered in any implementation of this option.*

⁴ A proposal has been made for the creation of a new EPC Rule 86(5) which would allow "amendment before search".