

Some questions about EP applications and EP patents



Pablo Calvo Ramón
Head of Technical Department

Guillermo Criado
Partner

Saiko Shimazaki
Responsible for Japan

•RYUKA•



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- The scope of protection of an EP Patent
- Amendments under EPC2000



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The scope of protection of an EP Patent

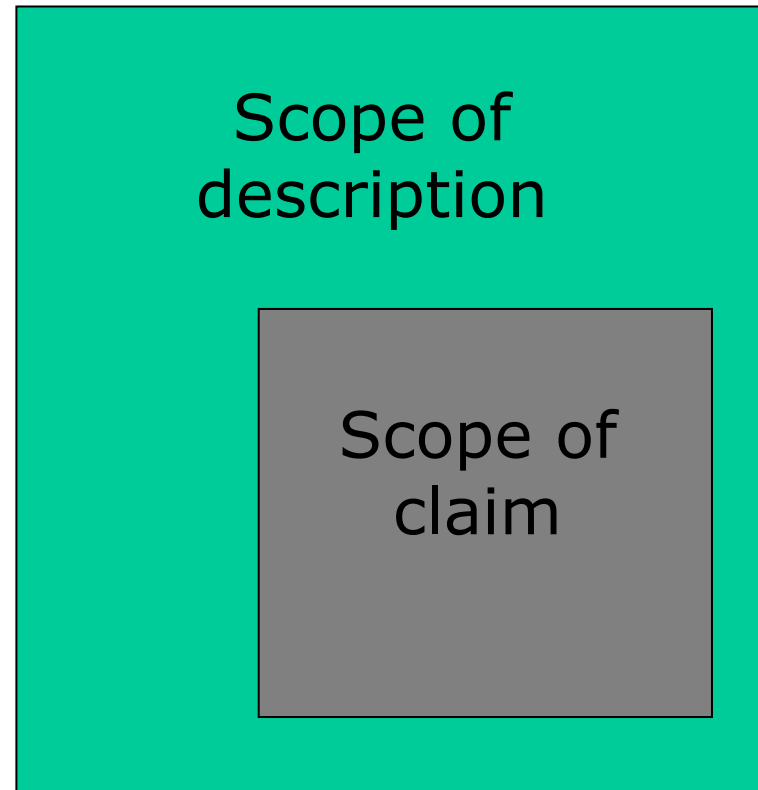
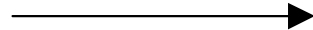
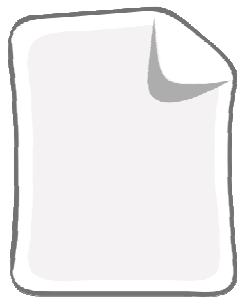
- Art. 84 EPC.
The claims shall define the matter
for which protection is sought.

They shall be clear and concise
and be supported by the
description.



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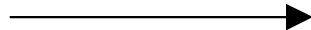
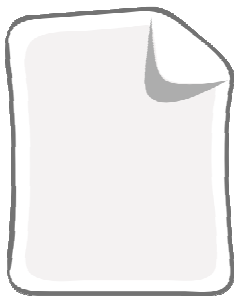
EP application



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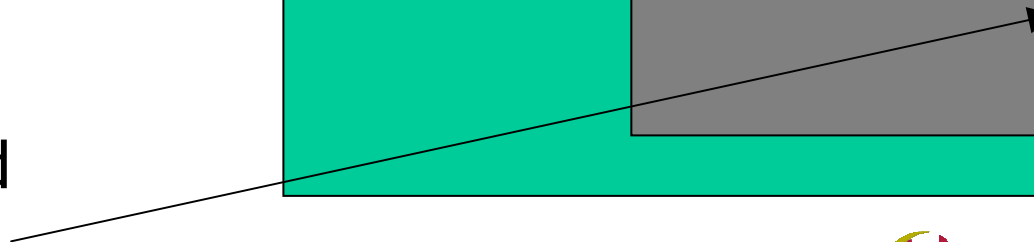
EP application



Scope of
description

Scope of
claim

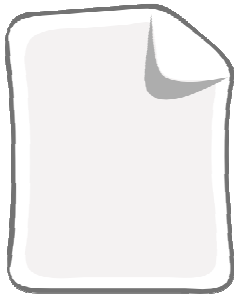
Unsupported
on the
description



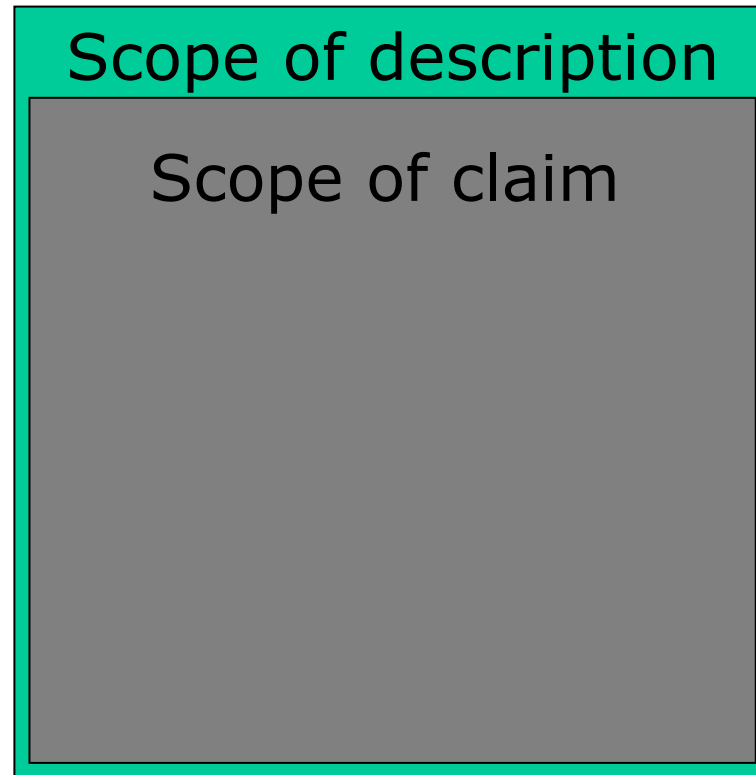
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EP patent



Good
protection



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Literal Infringement.

- **All elements rule:**

There exists literal infringement of a claim if **all technical features** of the claim are present in the questioned product/method.

There is not infringement if only a subcombination of technical features is present.



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Literal Infringement.

- **T175/84; OJ EPO 1989, 71**

“In the absence of any indication to the contrary in the wording, it should be assumed when examining a claim for inventive step that it is directed solely to the **simultaneous application of all its features.**”



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Art 69 EPC. Extent of protection

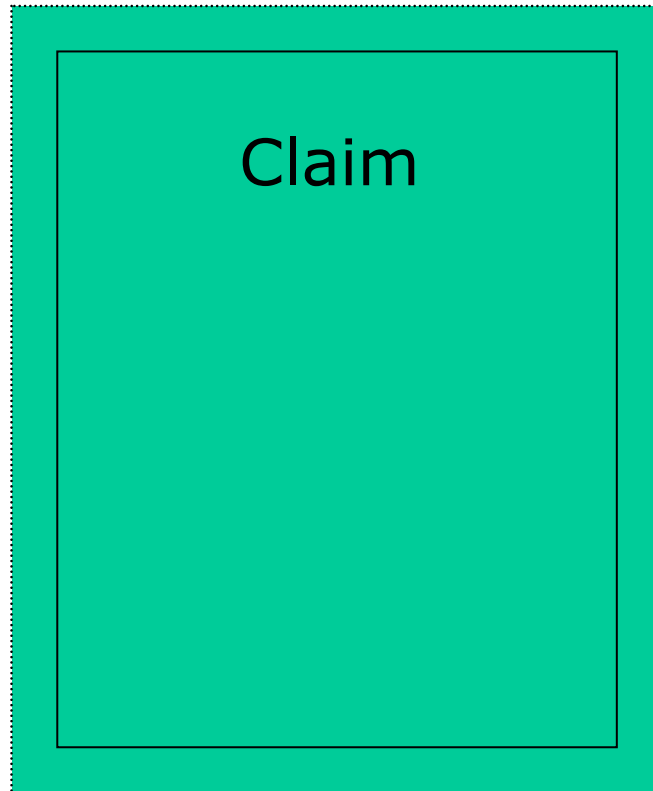
- **Art 69(1) EPC 2000**

The extent of the protection conferred by a European patent of a European patent application shall be determined by **the terms of** the claims.

Nevertheless, the description and drawings shall be used to interpret the claims.



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Under new Art 69EPC
not only literal
infringement is
considered.

- **Protocol on Interpretation of Article 69 EPC**

Art 1. General principles

Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, **literal meaning** of the wording used in the claims, the description and drawings being employed only for the purpose of resolving and ambiguity found in the claims. Nor should it be taken to mean that **the claims serve only as a guideline** and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated.

On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.



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- **Protocol on Interpretation of Article 69 EPC**

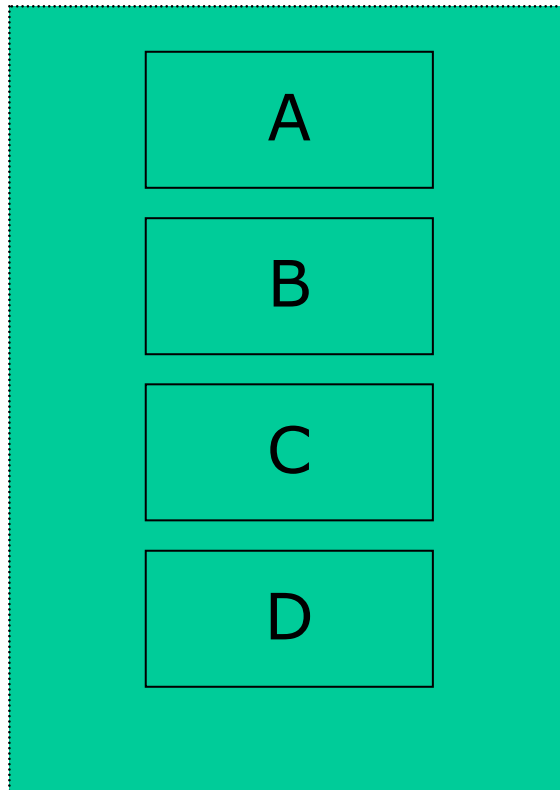
Art 2. Equivalents (The doctrine of equivalents)

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of **any element** which is **equivalent to an element** specified in the claims.

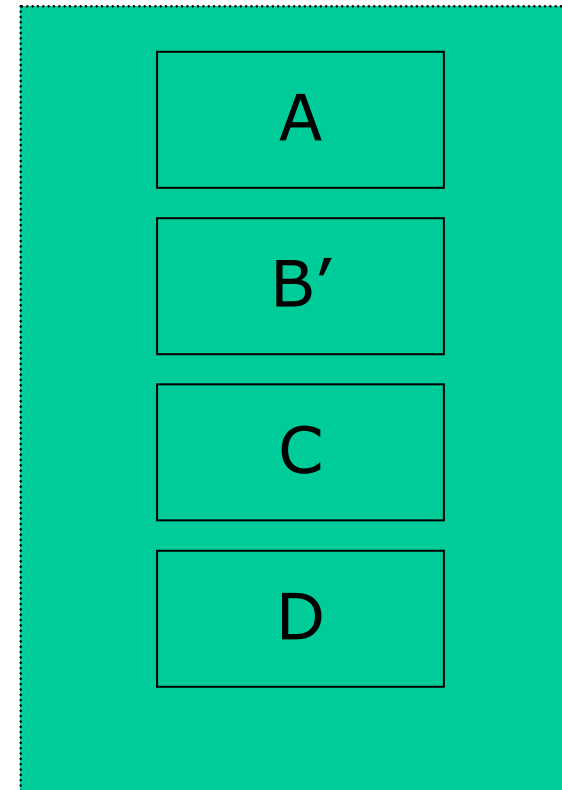


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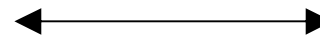
Claim



Product



Infringement



Infringement if B equivalent to B'



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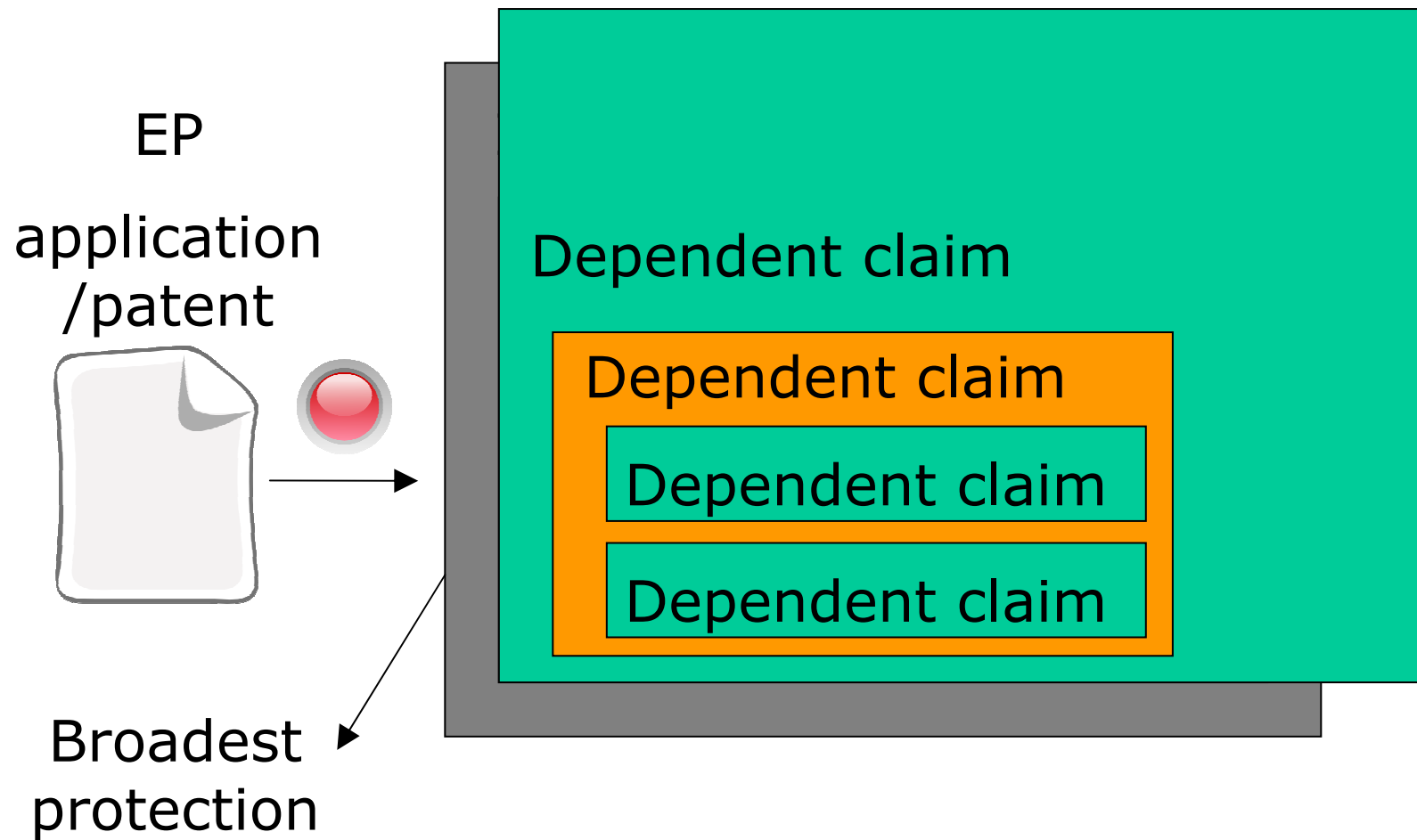
The role of dependent claims

- Rule 43(3) EPC

Any claim stating **the essential features** of an invention may be followed by one or more claims concerning **particular embodiments** of that invention.



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The scope of protection of an EP Patent

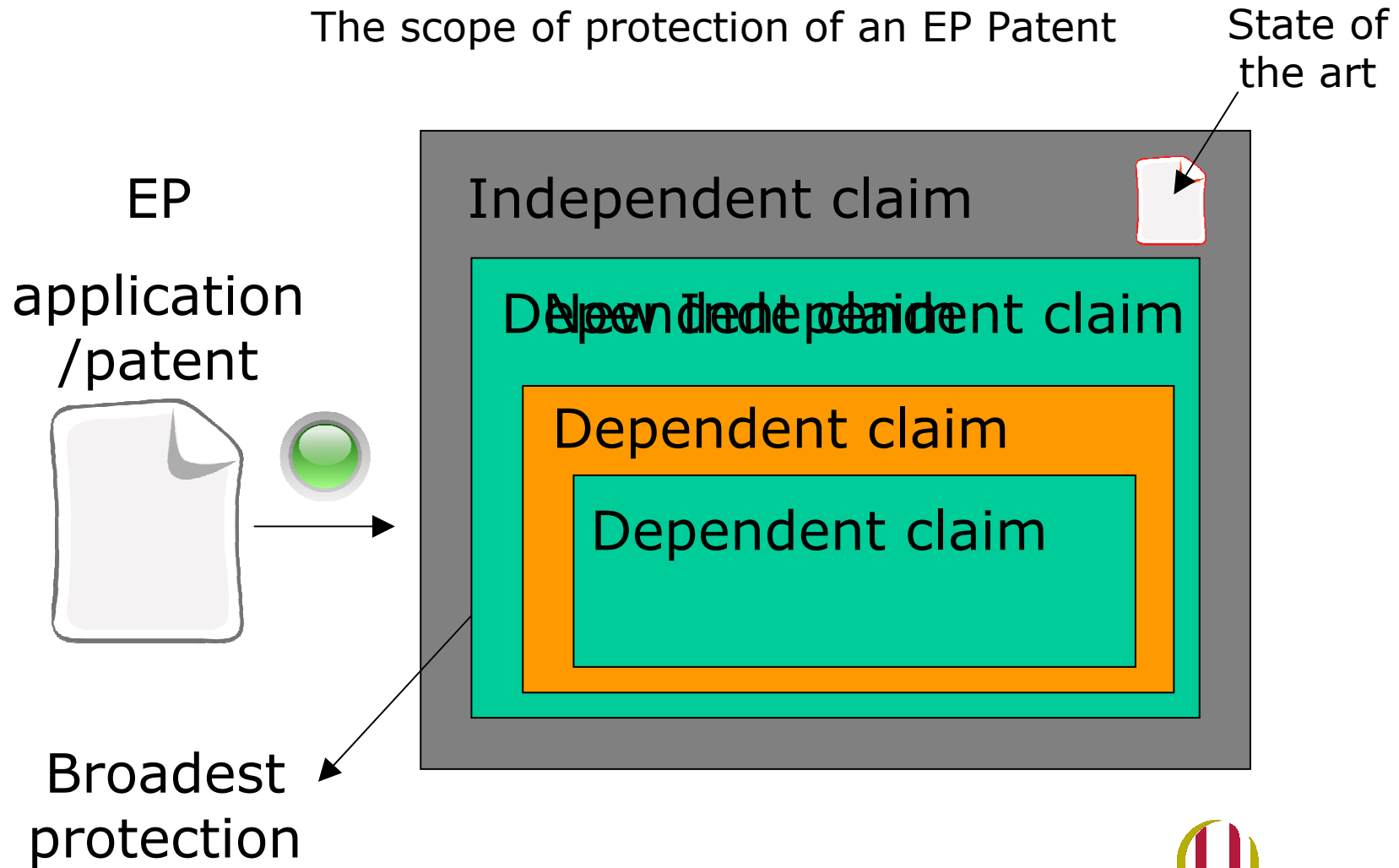


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- Dependent claims have to be designed as **real fallback positions**, not just small details about particular embodiments.



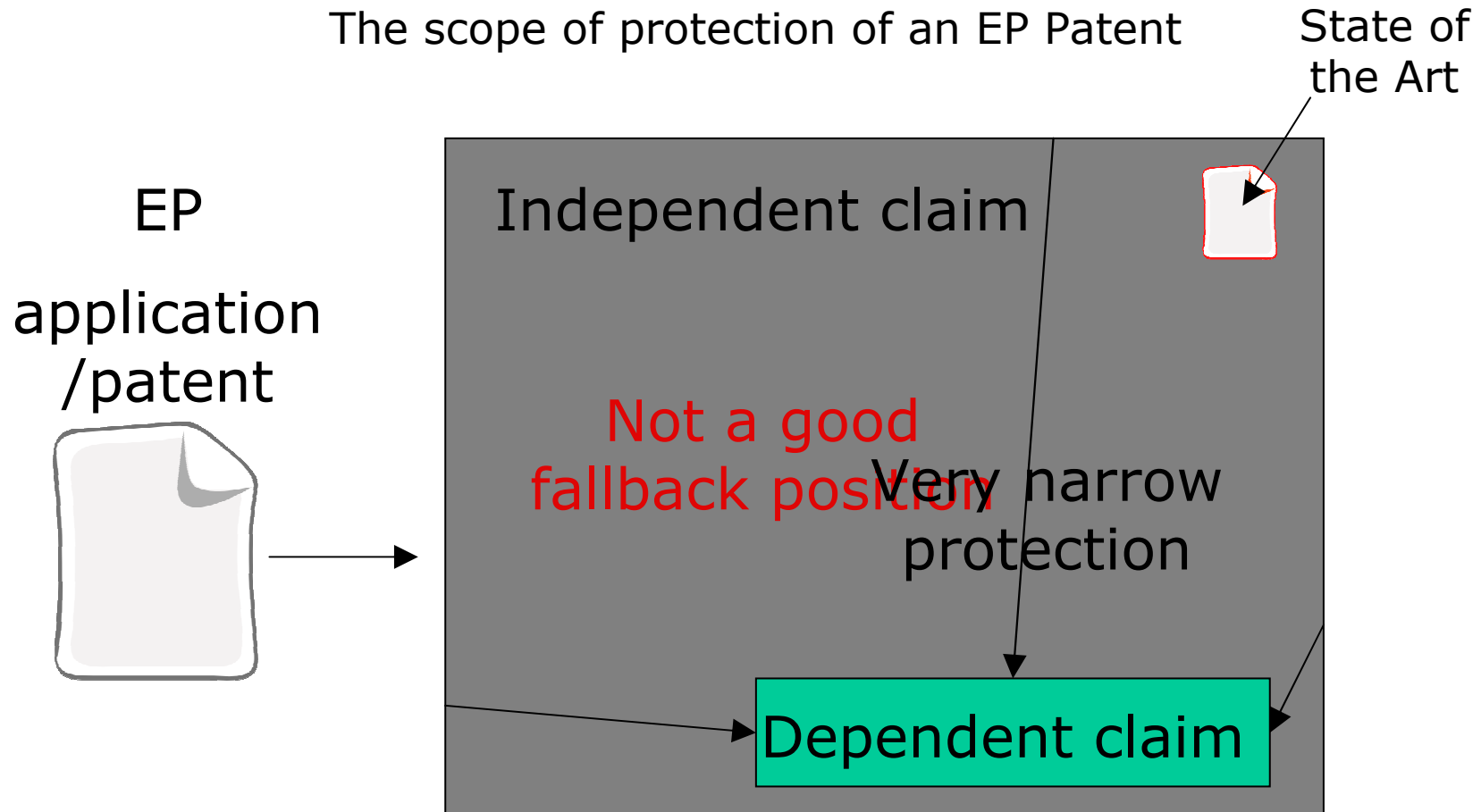
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The scope of protection of an EP Patent



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The scope of protection of an EP Patent

Amendments in EP applications and EP patents under EPC2000

- When?
- What are the conditions?
- The trap or Art. 123 EPC

Section 17bis(17-2)(3) JP Law



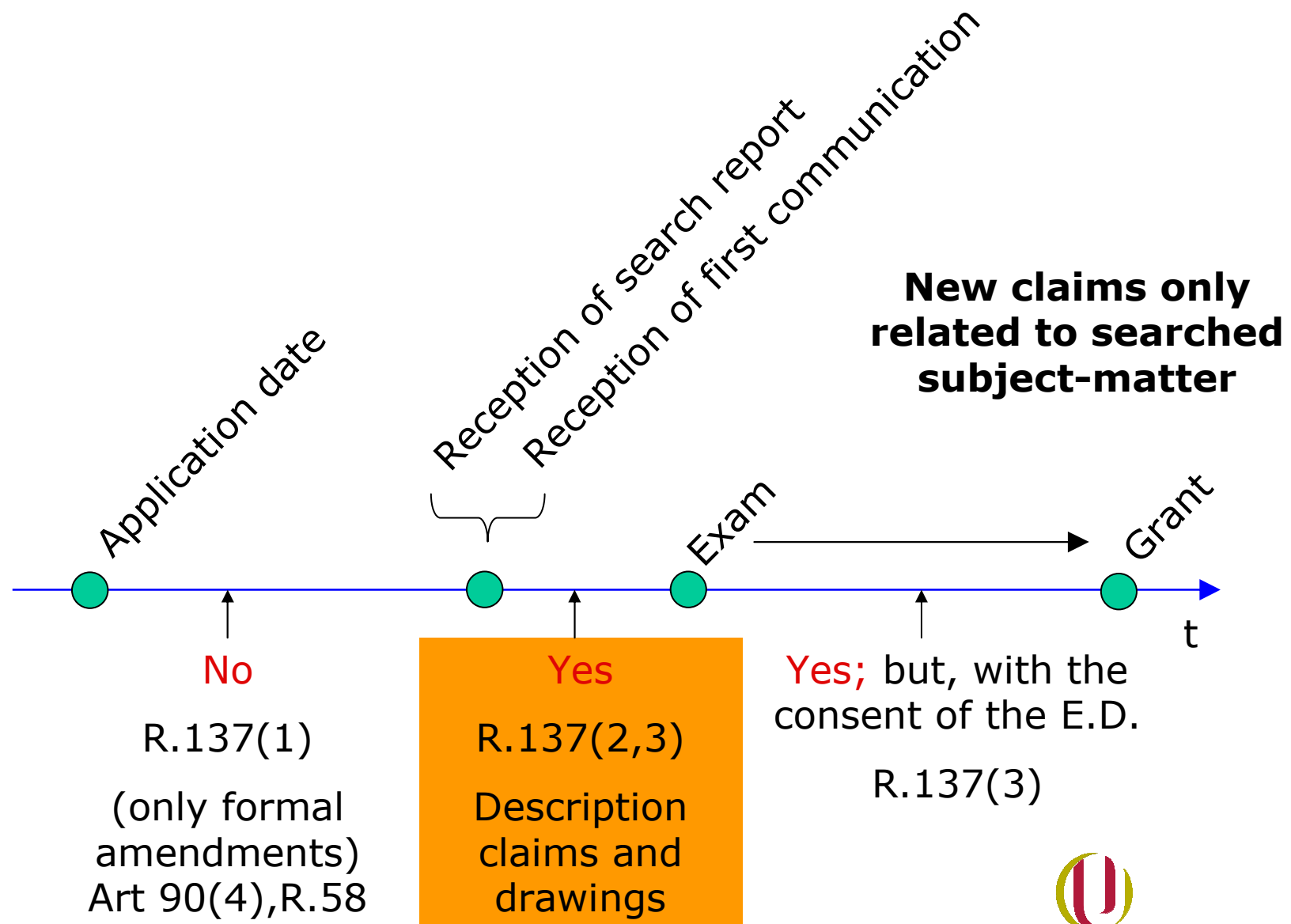
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- **Art. 123(1) EPC.**

The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. In any event, the applicant shall be given **at least one opportunity to amend the application of his own volition.**



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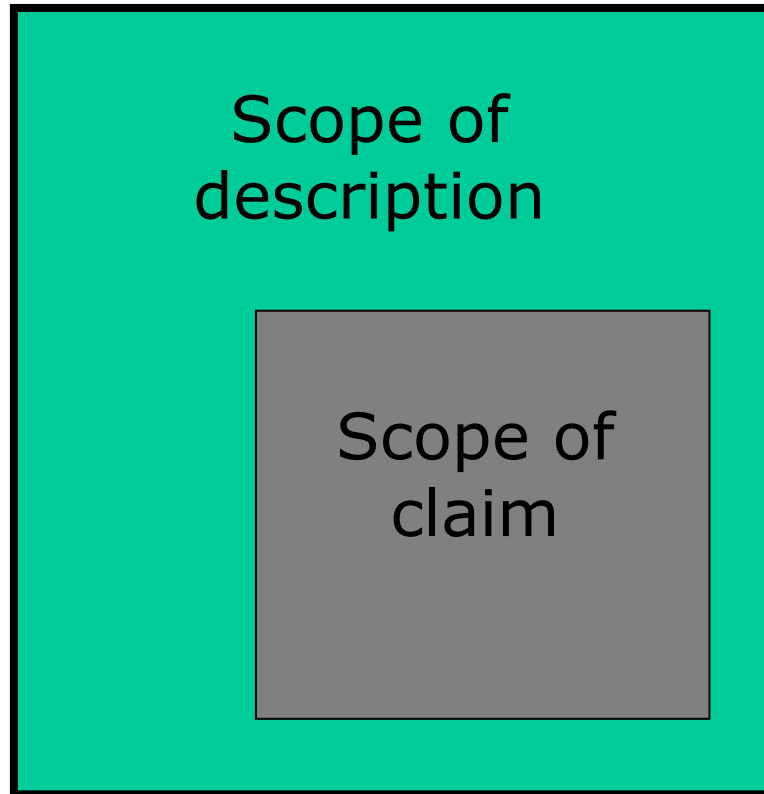
- **Art. 123(2) EPC.**

The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

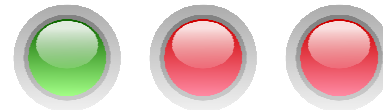
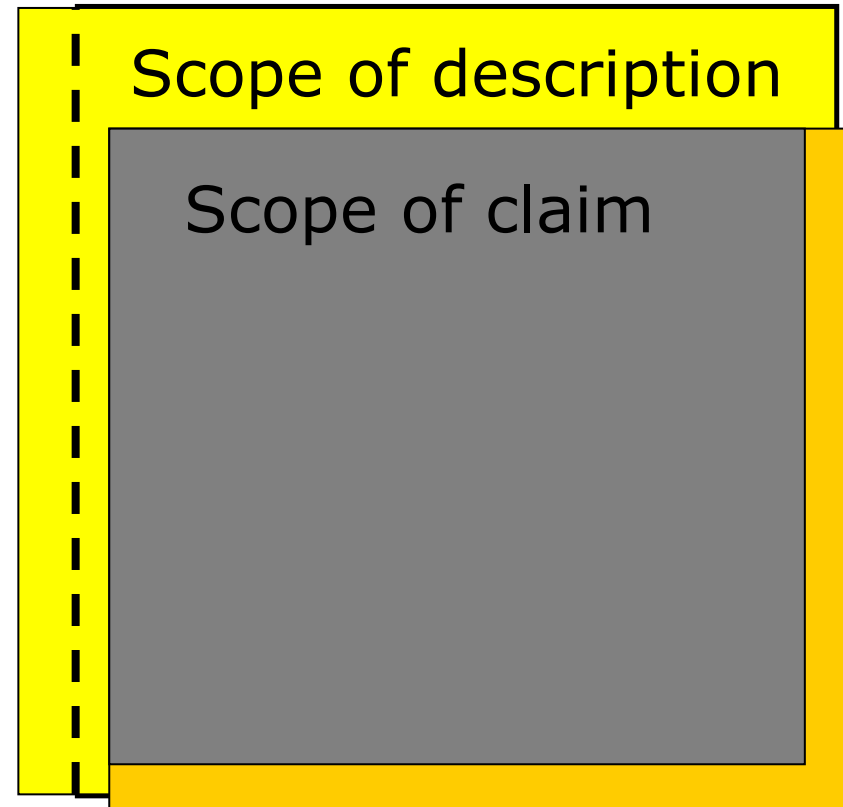


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Before the amendment



After the amendment



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Amendments in EP applications under EPC2000

How can we know that the amendment is in such a way it contains subject-matter which **do not extends beyond the content of the application as filed?**

 Test



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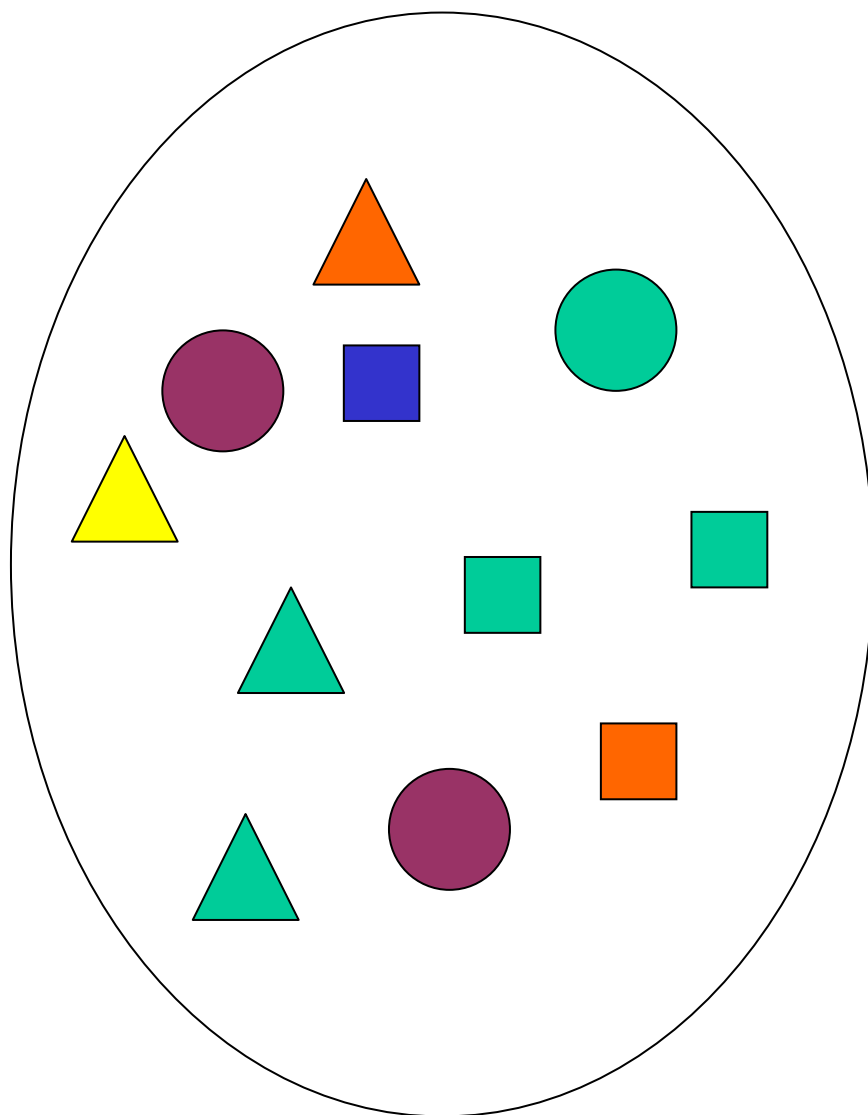
General rules

When a technical feature is removed from a claim, the scope of the claim is increased.

When a technical feature is added to a claim, the scope of the claim is reduced.



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It is a figure

It is a polygonal figure

It is green



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Guidelines [VI-C-5.3.10]

Replacement or removal of a feature from a claim

The replacement or removal of a feature from a claim does not violate Art. 123(2) EPC if the skilled person would directly and unambiguously recognise that:

- i. the feature was not explained as essential in the disclosure; [subjective]
- ii. the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve; and [objective]
- iii. the replacement or removal requires no real modification of other features to compensate for the change.
[objective]



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In case of a replacement by another feature, the replacing feature **must of course find support in the original application documents**, so as not to contravene Art. 123(2) (see T331/89, OJ 1-2/1992, 22)

Drawings can be **carefully** used to find support for the claims.



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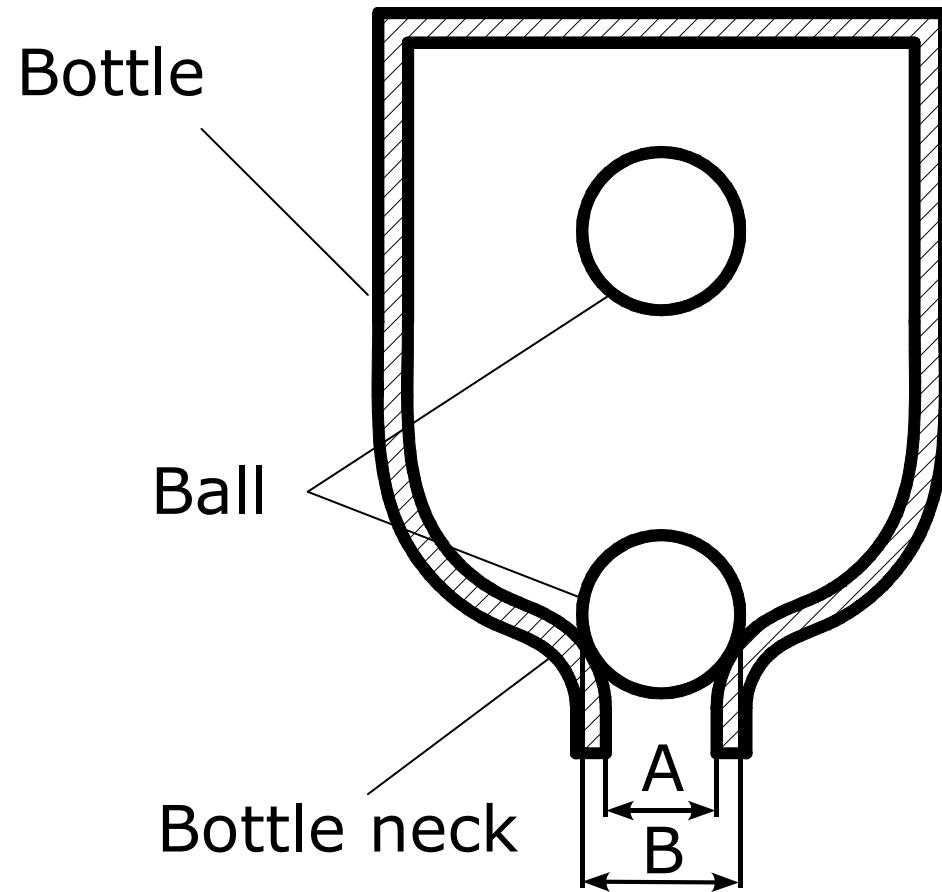
Examples of features supported/unsupported by drawings

The ball is able to close the bottle neck [supported]

The ball is bigger than the bottle neck opening [supported]

The diameter of the ball is B [unsupported]

The ratio between the diameter of the ball and the bottle neck opening is B/A [unsupported]



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Examples of features supported/unsupported by description

Description

"The plate is a metallic laminar body"

Claim as filed

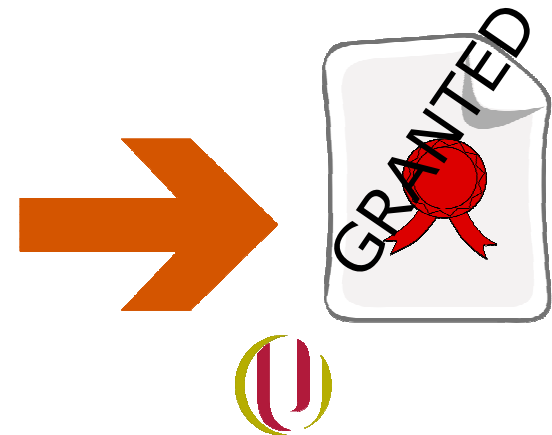
"The plate is a metallic laminar body"

Amended claim

"The plate is a laminar body of aluminum
[unsupported = contravene Art 123(2)EPC]

New Amended claim before grant
(if the examiner realizes about lack of support)

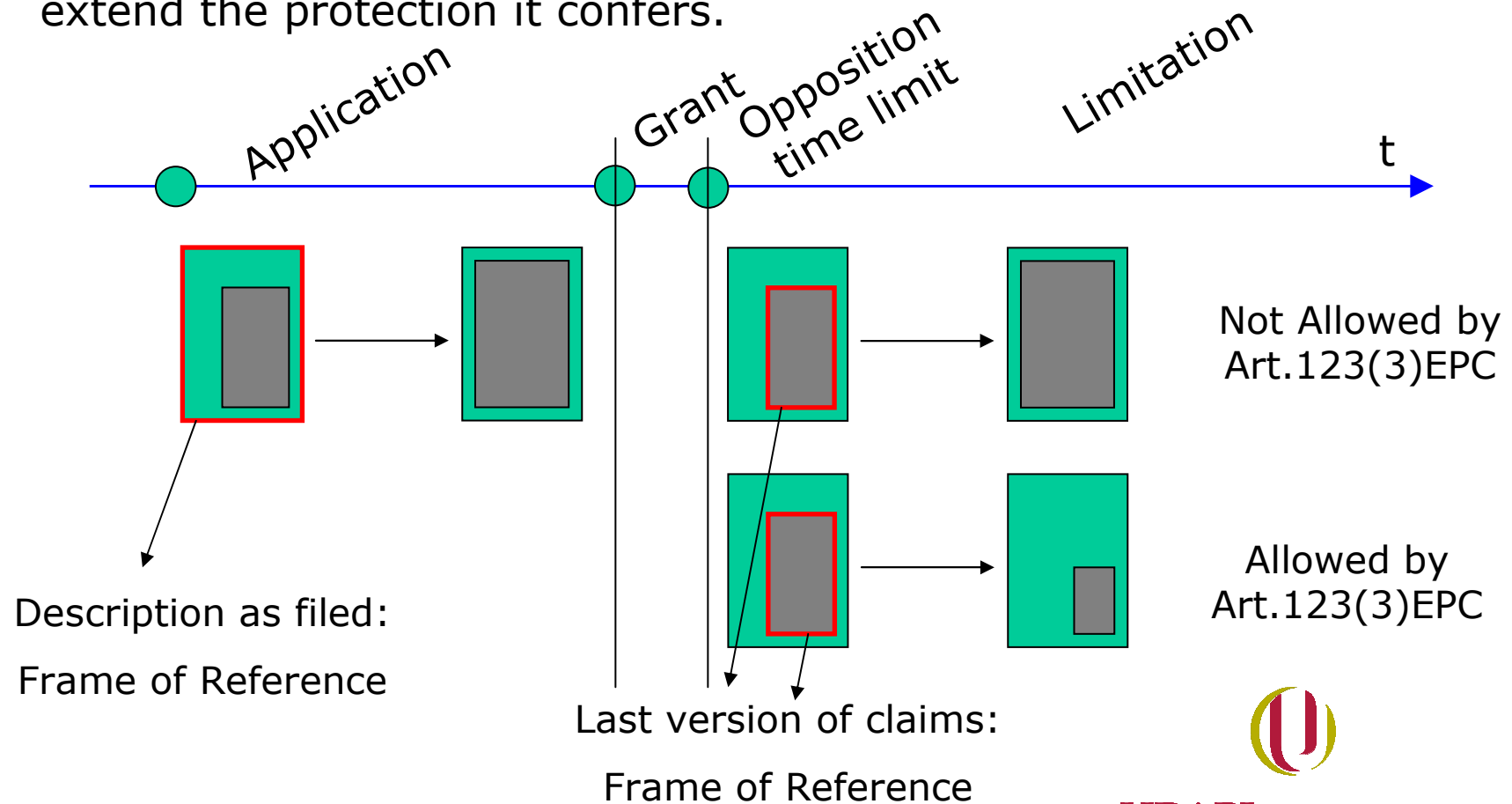
"The plate is a metallic laminar body"



Examples of features supported/unsupported by description

Art 123(3)EPC

The European patent may not be amended in such a way as to extend the protection it confers.



Amendments in EP applications under EPC2000

The Art.123EPC trap

Description

"The plate is a metallic laminar body"

Claim as filed

"The plate is a metallic laminar body"

Amended claim and now not re-amended

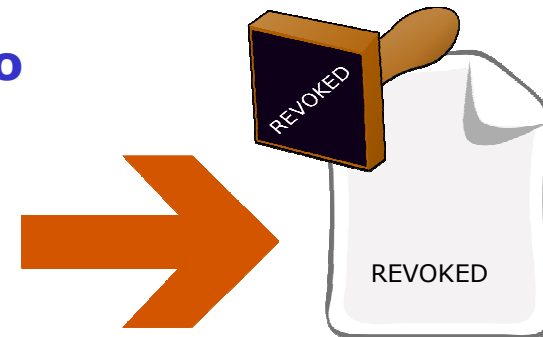
"The plate is a laminar body of aluminum
[unsupported = contravene Art.123(2)EPC]



During Opposition/Limitation there is no solution

- The word "aluminum" can not be removed
[contravene Art.123(3)EPC]
- The word "aluminum" can not be kept
[contravene Art.123(2)EPC]

TRAP



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Amendments in EP applications under EPC2000

Warnings

- Before applying amendments, Art.123(2)EPC must be checked. Fresh subject-matter is unallowable.

Dangerous if the solution needs to remove a technical feature [contravene Art.123(3)EPC during opposition -> The trap]

- E.D. is not responsible before the applicant to ensure the granted patent do not contravene Art.123(2)EPC.



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本日は、どうも有難うございました。



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