

EPO Guidelines March 2022 – The Key Updates

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Mewburn in numbers

- Over **300** strong - we're made up of **100+** scientists and engineers, as well as trade mark and legal specialists and business management experts.
- We have **5** growing offices in the UK and Europe.
- We've seen almost **40%** growth in the last three years.
- New people join us and stay, our staff retention rate for the last 12 months was **86%**.
- Almost **50%** of our technical trainees are women (national average of women graduating in STEM subjects in 2019 according to UCAS was 26%).
- Some of the brightest and best minds in the business work at our firm. Nearly **70%** of our partners have PhDs.
- We are '**Top Tier**' in Legal 500 and MIP IP Stars, '**Band 1**' in Chambers & Partners UK, '**Gold Ranked**' in IAM Patent 1000 and '**Recommended**' in WTR.
- We work in more than **50** specialist technical areas for over **3000** active clients.
- We have over **25,000** active cases and more than **800** dispute resolution cases ongoing.
- We work with **8** out of the **Top 10** Universities in the UK as well as more than **1500** Start-ups and SMEs.
- More than a third of our clients have worked with us for over **20** years.
- Our clients stay with us, our client retention rate over the last three years is **78%**.
- Our oppositions success rate is enviable. Only **7.4%** of patents we have opposed in the last 15 years have been maintained as granted, compared with an EPO average of 24.6%. We're even more effective if the case goes to appeal, our maintained as granted rate is **2.7%** at appeal compared to an EPO average of 11.9%.*
- Our clients scored us **9/10** for outstanding service delivery & overall satisfaction**

*Source: Statistics provided by IpQuants AG

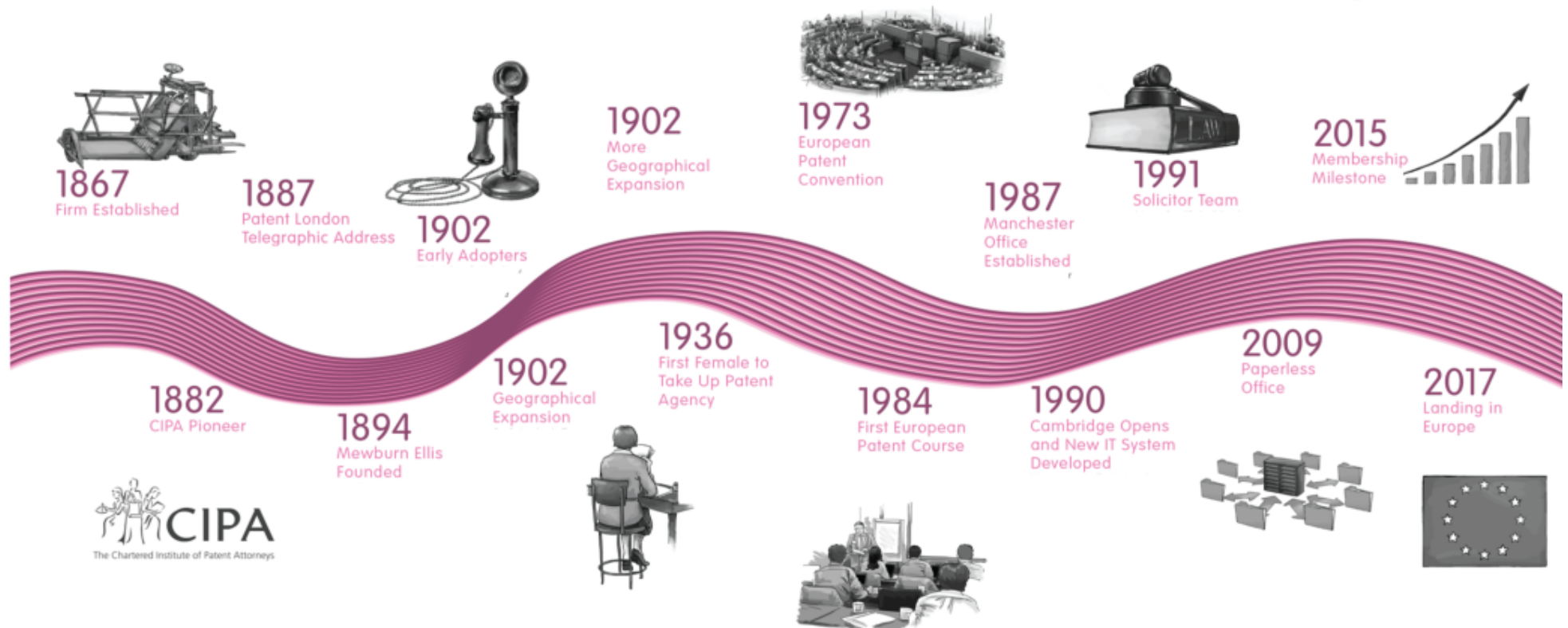
**Source: Acritas independent survey 2021

Founded on a passion for science & technology



We can trace our history back to 1867, when the talented and enthusiastic John Clayton Mewburn founded an IP office in London aged just 27 years old. He knew an opportunity when he saw one. The Industrial Revolution was still in full swing, with technological and scientific innovation at its height. There were more people looking to protect their inventions and ideas and it was easier and cheaper to do so than ever before.

In the 1890's he joined forces with George Beloe Ellis – a solicitor who shared his passion for new inventions and industrial property. Together the two men set about fulfilling their desire to protect the technologies they loved. Additional offices were established in Bristol in the 1920s, in Manchester in the 1980s and in Cambridge in 1990. Our first office in mainland Europe was opened in 2017, in Munich, Germany.



Law and practice library available to all

- Fully searchable, our Law and Practice Library consists of over 100 guides all available online and covering a huge range of IP topics.
- In the spirit of openness and information sharing we have decided to keep them openly available to all.
- These are so good our competitors use them as reference – we know because they've told us!

ACCELERATED PROSECUTION

Our pages 'UK Patents - The Basics' and 'European Patents - The Basics' set out in detail the various procedural steps involved in obtaining UK and...

COMPENSATION OF INVENTORS ACCORDING TO THE PRINCIPLES OF THE GERMAN COMPENSATION GUIDELINES

Type (lump sum or instalments) and amount of compensation are determined by an agreement between the employer and employee. The calculation of a...

CONFIDENTIALITY

Download Confidentiality Agreement Form

Often you may wish to tell other people about your invention, for example if you are trying to license or...

COPYRIGHT IN TRADE MARKS

When a trade mark contains or consists of a logo, it is likely that there is copyright in the trade mark. If so, it is important that the trade mark...

DEFERRED PATENT EXAMINATION SYSTEM

Several Patent Offices operate a deferred patent examination system under which patent applications remain dormant until the applicant takes steps...

DEFERRED PATENT EXAMINATION SYSTEM - GERMANY

The German Patent Office operates a deferred patent examination system under which patent applications remain dormant until the applicant takes steps...

DESIGNATION OF THE EU VIA THE MADRID PROTOCOL

The European Union is a member of the Madrid Protocol and so the European Union can be designated in an International Registration so as to seek...

DESIGNATION, EXTENSION AND VALIDATION STATES FOR EUROPEAN PATENT APPLICATIONS

For European patent applications filed since 2009, all available EPC member states are designated by payment of one designation fee.

The EPO has a...

DIRECT EUROPEAN PATENT APPLICATIONS: EARLY STAGE PROCEDURE AND PAYING SEARCH FEES

Download flow chart - EP Early Stage Procedure & Paying Search Fees - Decision chart for action after issuance of a partial search report on a direct...

DISCLOSURE OF SEARCH RESULTS

From 1st July 2004 the UK Intellectual Property Office has been requesting the results of official searches produced by other patent offices to be...

DOMAIN NAMES

The importance of trade marks is being increasingly highlighted by the rapid growth in use of the Internet. This page explains the process and some...

DUTY OF DISCLOSURE

Failure to disclose relevant information to the United States Patent and Trademark Office (USPTO) can result in a patent becoming invalid and...

We have a responsibility to ensure our business has a positive impact on the people, communities and environment around us so have launched the Forward Community Programme.

Diversity & Inclusion

Chief I&D Officer &
Collaboration Group
I&D Audit
Gender Pay Gap Reporting
Sponsorship of CREST Awards
Wellness Committee
Mentoring of school age
children
Sponsorship of BSA 'Smashing
Stereotypes' campaign

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Sustainability

We aim to be a carbon neutral
business by 2025
We've introduced a 5 step
climate action plan in order to
achieve our goals
We plant a tree for every new
matter we open
We support sustainable
charities

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Community

1% profit - £150,000 to charity
300 CSR Days
Coronavirus Support
National Partnership with
British Science Association
Support for local charities
covering: cancer, end of life care
for children,
homelessness, mental health,
poverty & equality

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- BA and MSci in Natural Sciences from Cambridge University; DPhil from Oxford University; Post Doctoral Research at Kyoto University
- Qualified 2017; partner 2022
- Lived in Japan for one year, speak some Japanese; now visit Japan for 1-2 weeks most years
- Involved with JIPA since joining the profession
- Practice: Chemistry specialising in sustainable technologies, food chemistry, polymers and small molecule pharmaceuticals
- Passionate about the role technology can play in sustainability
- Major clients: Japanese food and drinks companies, Japanese polymer companies, Sustainable technology SMEs and pharmaceutical companies from start-ups to global corporations
- Significant experience of EPO opposition and appeal work



Changes to the EPO Guidelines for Examination – March 2022

Updates to the EPO Guidelines

- Periodically the EPO updates the Guidelines for Examination
- Updates include changes to reflect decision of the Enlarged Board of Appeal, changes to internal practice and changes to the rules of the EPC
- Changes can be made that effect the application of formalities and procedural requirements as well as the application of patentability requirements.
 - So the changes can be very important for applicants and attorney
- This year, the updates made do not represent a big change in practice for the EPO
- Nevertheless there are some important and interesting changes to consider

Summary of Changes to the Guidelines

- Key Changes For Applicants and Attorneys

- Address of inventor
- Description amendments (T 1989/18)
- Partial priority (G 01/15)
- Double patenting (G 04/19)
- Computer-implemented inventions (G 01/19)

A-III, 5.3; 5.4 (Formalities)

F-IV, 4.3; 4.4 (EP applications)

F-VI, 1.5 (EP applications)

G-IV, 5.4 (Patentability)

G-II; G-VII, 5.4 (Patentability)

- Other notable mentions

- Reply to examination
- Extension of time
- “approximately” and “substantially”
- Public order and morality (G 01/03; T 315/03)

C-IV, 3 (Examination procedure)

E-VIII, 1.6.2.3 (General procedure)

F-IV, 4.7 (EP applications)

G-II 4.2; 5.2 (Patentability)

Key Changes for Applicants and Attorneys

A-III, 5.3 (Formalities) – Inventor's location

- **Key message:** EPO's practice of accepting the place of the applicant to be given for the inventor is now formalised in the guidelines.

5.3 Designation filed in a separate document

Where the designation is filed in a separate document it must contain the ~~surname~~ family name, given names and country and place of residence ~~full address (to meet the customary requirements for postal delivery)~~ of the inventor. The place of residence is the city or municipality, i.e. not the province or region, where the inventor permanently resides and should preferably include the postal code (see the Notice from the EPO dated 22 February 2021, OJ EPO 2021, A12). The country and place of residence may also be that of the applicant (e.g. a company). Furthermore, the designation must contain the statement, referred to in Art. 81, indicating the origin of the right to the patent and the signature of the applicant or the appointed representative.

F-IV, 4.3 (Applications) – Description amendments

- The EPO has always required *some* amendment of the description before grant of an application
- In 2021 the EPO updated the guidelines for Examiner to make the requirements for these amendments more onerous
- In a user consultation in 2021 many of the responses were on description amendments
- The 2022 changes to the guidelines include some updates but perhaps not the ones Applicants and Attorneys were hoping for....
- but T1989/19 issued after the Guidelines were updated suggests this issue might not be completely resolved

F-IV, 4.3 (Applications) – Description amendments

- **Key message:** The substance of the requirements remain mostly unchanged
 - This section is simply reworded and clarified

4.3 Inconsistencies

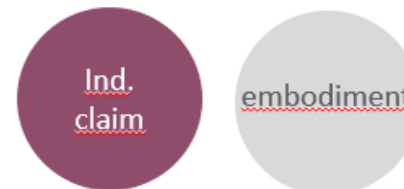
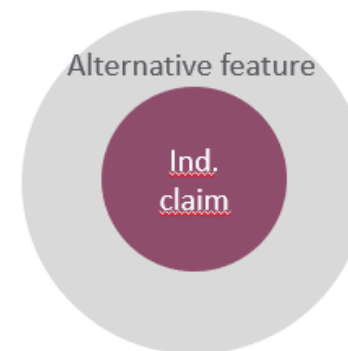
Any inconsistency between the description and the claims must be avoided if it ~~may~~ could throw doubt on the ~~extent of subject-matter for which protection is sought~~ and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence. Such inconsistency can be of the following kinds:

- (iii) Part of the ~~subject-matter of the~~ description and/or drawings is ~~not covered by the claims~~ inconsistent with the subject-matter for which protection is sought

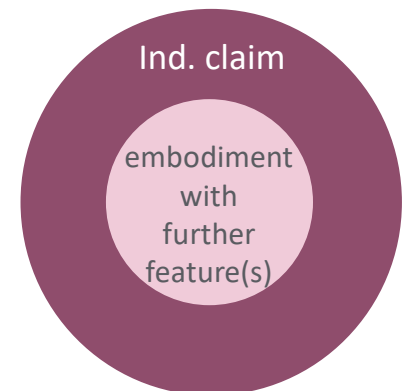
The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where an inconsistency can be removed by broadening the claims.

The terms "disclosure", "example", "aspect" or similar do not necessarily imply that what follows is not encompassed by an independent claim. Unambiguous expressions have to be adopted to mark an inconsistent embodiment (e.g. by adding "not encompassed by the wording of the claims", "not according to the claimed invention" or "outside the subject-matter of the claims") instead of replacing the terms "embodiment" or "invention" by one of the aforementioned terms.

• Inconsistency



• No Inconsistency



F-IV, 4.3 (Applications) – Description amendments

- **Even more stringent:** Use of generalised statements regarding what does and does not fall under the invention are now explicitly forbidden

An inconsistency between the description and the claims cannot be removed by introducing at the beginning of the description a **generic** statement such as "embodiments not falling under the scope of the appended claims are to be considered merely as examples suitable for understanding the invention" without indicating which parts of the description are no longer covered. To remove the inconsistency, such a statement has to refer to **specific** embodiments (e.g. "Embodiments X and Y are not encompassed by the wording of the claims but are considered as useful for understanding the invention").

- **“Softening”:**
 - “not covered by the claims” is replaced by “inconsistent with the claims”

Part of the ~~subject-matter of the~~ description and/or drawings is ~~not covered by the claims~~ inconsistent with the subject-matter for which protection is sought

- In borderline cases, the benefit of the doubt is given to the applicant

For borderline cases where there is doubt as to whether an embodiment is consistent with the claims, the benefit of the doubt is given to the applicant.

- **T 1989/19:** There is no legal basis in the EPC for the requirement to amend the description in line with the claims.
 - The examining division refused the application because it considered that the description of the application in the form of the main request (with specific amendments) did not comply with the requirements of Article 84 EPC
 - The amended subject matter was considered "broader than the subject-matter of the allowable claim"
 - The board of appeal (3.3.04) did not agree:
 - Art. 84 EPC: if the claims are clear in themselves and supported by the description, their clarity is not affected if the description contains subject matter which is not claimed
 - Art. 69 EPC and Rules 42(1)(c) and 48(1)(c) EPC cannot serve as legal basis for a refusal, as well
- Currently not reflected in the guidelines, because
 - T 1989/19 was published after the amendments were made to the guidelines; and
 - T 1989/19 is clearly diverging, i.e., the case law is far from settled on the point

F-VI, 1.5 (Applications) – Partial priorities

- **Key message:** EPO's approach to partial priorities is **not** changed
 - The section is updated to make the approach clearer in line with the earlier decision in G 1/15

1.5 Multiple priorities and partial priorities

"Multiple priorities may be claimed" – i.e. a European application may claim rights of priority based on more than one previous application (G 2/98).

"Partial priority" refers to a situation in which only a part of the subject-matter encompassed by a generic "OR" claim is entitled to the priority date of a previous application (G 1/15).

...

In assessing whether subject-matter within a generic "OR" claim may enjoy partial priority, the first step is to determine the subject-matter disclosed in the priority document that is relevant, i.e. relevant in respect of prior art disclosed in the priority interval. This is to be done in accordance with the disclosure test laid down in the conclusion of G 2/98 and on the basis of explanations put forward by the applicant or patent proprietor to support the claim to priority, in order to show what the skilled person would have been able to derive from the priority document. The next step is to examine whether this subject-matter is encompassed by the claim of the application or patent claiming said priority. If the answer is yes, the claim is *de facto* conceptually divided into two parts, the first corresponding to the invention

Definition of "partial priority"

Test for assessing whether a partial priority arises

F-VI, 1.5 (Applications) – Partial priorities

- **Key message:** EPO's approach to partial priorities is **not** changed
 - The section is updated to make the approach clearer in line with the earlier decision in G 1/15

The rationale of decision G 1/15 also applies in the context of deciding whether an application from which priority is claimed is the first application within the meaning of Art. 87(1). Just as a priority application and a patent claiming priority from it may partially relate to the same invention, the priority application and an earlier application filed by the same applicant may also partially relate to the same invention. In that case, the priority application would be the first application in respect of only that part of the invention which is not the same as in the earlier application (T 282/12).

Partial priority may also be transferable separately. This, however, has consequences for the remaining priority right because the assignor is left with a limited right and may no longer keep claiming that partial priority (an applicant can only claim a right which they own). The transfer agreement of the partial priority gives a respective partial priority right to the assignor and the assignee corresponding to two clearly distinct and precisely defined alternatives.

Deciding whether an application is the first application

Partial priority may be transferable separately

G-IV, 5.4 (Patentability) – Double patenting

- **Key message:** The section is updated in light of G 4/19.

5.4 Double patenting

~~The EPC does not deal explicitly with the case of co-pending European applications of the same effective date filed by the same applicant. However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention. As acknowledged by the Enlarged Board, the prohibition on double patenting is applicable under Art. 125 [G 4/19]. It is a principle of procedural law generally recognised in the contracting states that two patents cannot be granted to the same applicant for the same subject-matter. The Enlarged Board of Appeal has accepted obiter dictum that the principle of the prohibition on double patenting is based on the notion that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject matter if the applicant already possesses one granted patent for that subject matter (see G 1/05, and G 1/06).~~

G-IV, 5.4 (Patentability) – Double patenting

- **Key message:** No substantial change in practice

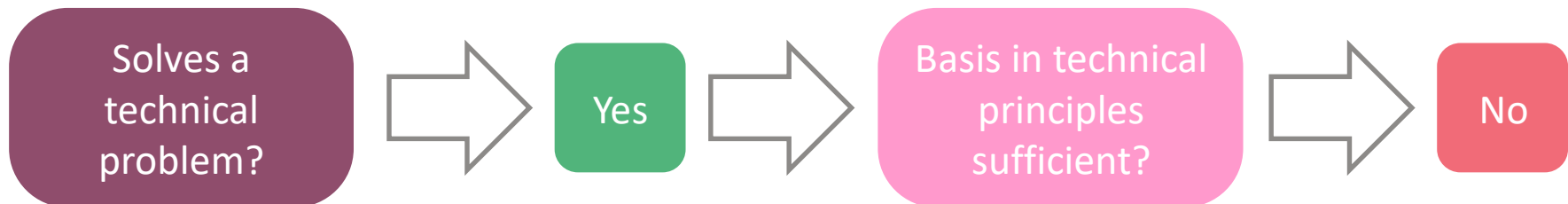
Headnote of G 4/19

1. A European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC.
 2. The application can be refused irrespective of whether it
 - a) was filed on the same date as, or
 - b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or
 - c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted.
- The decision in G 4/19 does not substantively change the EPO's approach to double patenting, although the reasoning is slightly different
 - The guidelines are changed to reflect G4/19 – we do not expect to see significant change in the EPO's approach although perhaps we will see objections under double patenting more often

Computer-implemented inventions

Two-hurdle approach (G 01/19)

- The case referred related to a computer simulation of pedestrian movements
- The questions put to the EBoA were:
 - In the assessment of inventive step, can a simulation solve a technical problem by producing a technical effect that goes beyond its implementation on a computer?
Answer = Yes
 - If yes, is it sufficient when demonstrating inventive step that the simulation is based, at least in part, on technical principles underlying the simulated system or process?
Answer = No (neither necessary nor sufficient)



G-II, 2 – Two-hurdle approach

- First “hurdle” (Art. 52 EPC):
 - Claimed subject-matter must not fall under non-patentable subject matter of Art. 52(2) and Art. 52(3) EPC
 - One technical feature is sufficient for eligibility under Art. 52(1) EPC.
 - Assessment is made without reference to the prior art
- Second “hurdle” (Art 56 EPC):
 - Determines which features are technical and which non-technical
 - Assessment of inventive step using the COMVIK approach (see also **G-VII, 5.4**)
 - Only features contributing to the technical character of the invention are considered for inventive step

Other Notable Changes

- **C-IV, 3** – Examination of replies
 - Updated to clarify that a **request for a decision** on the state of the file qualifies as a **reply within the meaning of Article 94(4) EPC** (so that the application will not be deemed to be withdrawn)
- **E-VIII, 1.6.2.3** – Extension of time
 - additional types of period now expressly **covered** by extensions under Rule 134 EPC:
 - opposition period under Article 99(1) EPC
 - period for entry into the European phase under Article 159(1) EPC
 - expiry of the period to pay renewal fees with an additional fee (Rule 51(1) EPC) and renewal fees (Rule 51(2) and (3) EPC)
 - additional types of period now expressly **excluded** by extensions under Rule 134 EPC:
 - the due date and the start of the four-month period under Rule 51(3) and 51(4) EPC
 - the date of the start of the search

- **F-IV, 4.7** – Terms “approximately” and “substantially”
 - Updated to recognize the use of “substantially” or “approximately” beyond a structural unit of an apparatus
 - Where the terms imply that a certain effect or result can be obtained within a certain tolerance which the skilled person would know how to obtain, such wording is recognized
- **G-II, 4.1, 5.2** – Exclusion due to ordre public and morality
 - Updated to include principles set out in G 01/03: An objection under Article 53(a) might arise because not everything done to other living beings (e.g. selection of offspring based on certain properties) can be done to humans
 - Updated to include principles set out in T 315/03: Regarding Article 53(a), animal suffering and possible risks to the environment must be weighed up against the invention’s usefulness to mankind

Future Changes

- **UP and UPC**

- The UP/UPC is expected to come into force later in 2022 or early 2023
- This is a significant change to patent practice in Europe
- I expect many of you will have heard about the UP/UPC from your European colleagues
- I know you have had at least one talk on the subject through JIPA this year (from Kuhnen & Wacker)
- I am happy to answer any questions you have on the topic, please email me

- **G1/22 and G2/22 – Questions referred on Entitlement to Priority**

- Two questions were referred to the Enlarged Board
 - Do the EPO have jurisdiction to decide on priority right
 - If yes, does listing the priority owner as applicant for the US only confer the right to priority in the EPO? [This is the “joint applicants approach”.]
- The President of EPO recently commented that he considers the EPO do have the right to decide on priority and that the joint applicants approach should work.



Thank you for listening

If you have any questions please contact me

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- EPO regularly updated COVID-19 information page: www.epo.org/news-events/covid-19/oral-proceedings-examination-opposition.html
- Frequently asked questions: www.epo.org/service-support/faq/procedure-law/oral-proceedings-by-videoconference.html



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