

Directly and Unambiguously the Same

The test used by the EPO to assess
novelty, priority and adequate support

Dr. Albrecht v. Menges

Overview

This presentation covers the following topics:

- (1) The significance of the test for examination, opposition and nullity proceedings.
- (2) Examples of the test as applied by the Boards of Appeal.
- (3) Consequences.

Significance

The “directly and unambiguously the same“ test is used to compare the features defining the claimed embodiments:

- with the prior art to assess novelty;
- with the priority application to assess priority; and
- with the patent application to assess adequate support;

Significance

Understanding the "directly and unambiguously the same" test is highly relevant, as:

- the test is strictly applied by the EPO in assessing three aspects of patentability;
- the failure to understand the test can cause significant problems in opposition and nullity proceedings;
- the test differs from the respective legal tests used by other Patent Offices, for example from the test as used by the USPTO.

Examples

The full text of decisions can be downloaded from the EPO website using the following link:

<http://www.epo.org/patents/appeals/search-decisions.html>

The Fifth Edition of the book summarizing Case Law of the Boards of Appeal can also be downloaded using the following link:

<http://www.epo.org/patents/appeals/case-law.html>

Examples - Novelty

T 0004/00 – Implicit Features

“The Board is of the opinion that to be novelty destroying for the claimed ranges of the components of the gas mixture, the skilled reader should be able to directly and unambiguously derive from this part of the graph at least one specific gas mixture composition relevant for the claimed ranges.

...

Thus the graph ... cannot be considered to be sufficiently accurate to derive any specific percentages for helium and carbon dioxide from it.”

Examples - Novelty

T 0598/01 – Implicit Features

“... it should be noted as a preliminary point that features which are not expressly mentioned in a prior-art document, such as ..., could only be considered as implicitly disclosed if they were directly and unequivocally derivable from that particular document.”

Examples - Novelty

T 1080/01 – Taq DNA Pol. – Inherent Features

“In accordance with the case law ..., if carrying out a process specifically or literally disclosed in a prior art document inevitably results in a product which is not described, then this amounts to a disclosure which deprives of novelty a claim covering said product. ... it must of course be possible to detect the product in a clear and unambiguous manner.”

Examples - Novelty

T 0158/96 – Implicit Medical Use

“The information in a citation that a medicament is undergoing a clinical phase evaluation for a specific therapeutic application is not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament if such information is plausibly contradicted by the circumstances and if the content of said citation does not allow any conclusion to be drawn with regard to the actual existence of a therapeutic effect or any pharmacological effect which directly and unambiguously underlies the claimed therapeutic application.”

Examples - Priority

G 2/98 – The Same Invention

“The requirement for claiming priority of ”the same invention”, referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim **directly and unambiguously**, using common general knowledge, from the previous application as a whole.”

Examples - Priority

T 0301/87 – IFN alpha – Implicit Features

“... if an entity itself is disclosed to the skilled person, this does not necessarily mean that a component part is also disclosed for the purpose of priority if this is not envisaged directly and unambiguously as such, and requires considerable investigation to reveal its identity.”

Deposited plasmid does not support sequence of a specific part of the plasmid.

Examples - Priority

T 0923/92 – h tPA – Inherent Features

“Thus, the primary amino acid sequence of a protein (or the nucleotide sequence of a DNA) constitutes a true technical feature and relying on a given sequence rather than on another one for the definition of the subject-matter of an invention in a claim makes a critical difference.”

Three amino acid changes were made in a sequence of several hundred amino acids and lead to the conclusion that the claim no longer is entitled to the priority.

Examples - Priority

T 0077/97 – Implicit Features

“Although there was no doubt that the priority document described a very narrow group as being preferred, it did not, however, distinguish between the four compounds of this group, and neither did it specify that the formula of claim 3 had to be considered as an "abridged" formulation of a list or table indicating four individual chemical compounds.”

A disclosure of a formula covering 4 members does not provide support for each member separately.

Examples – Adequate Support

T 1366/04 – Implicit Disclosure

“...the feature “inhalation aerosol” is not disclosed in the application. ...drug compounds are described as suitable for inhaled administration. However, the feature “inhaled” is only disclosed as a requirement for determining the drug compounds to be selected, whereas the feature is used in claim 1 to determine the use of the claimed suspensions ...”

Examples – Adequate Support

T 1067/02 – Implicit Disclosure

“In conclusion, in the board's judgement, the unclear nature of the amendment introduced upon grant in claim 1 as filed, i.e. the introduction of the term "*complete*", allows two different interpretations and, although they are both technically sensible, neither of them is **directly and unambiguously** derivable from the general disclosure of the application as filed.”

Examples – Adequate Support

T 0727/00 – Selection from Lists

“This combination of one member from each of two lists of features, which combination is not supported by the disclosure of the application as filed, results in a claimed embodiment that falls logically under the scope of the application as filed but is not disclosed therein in individualized form.”

Examples – Adequate Support

T 0500/01 – PDL – Amending the Description

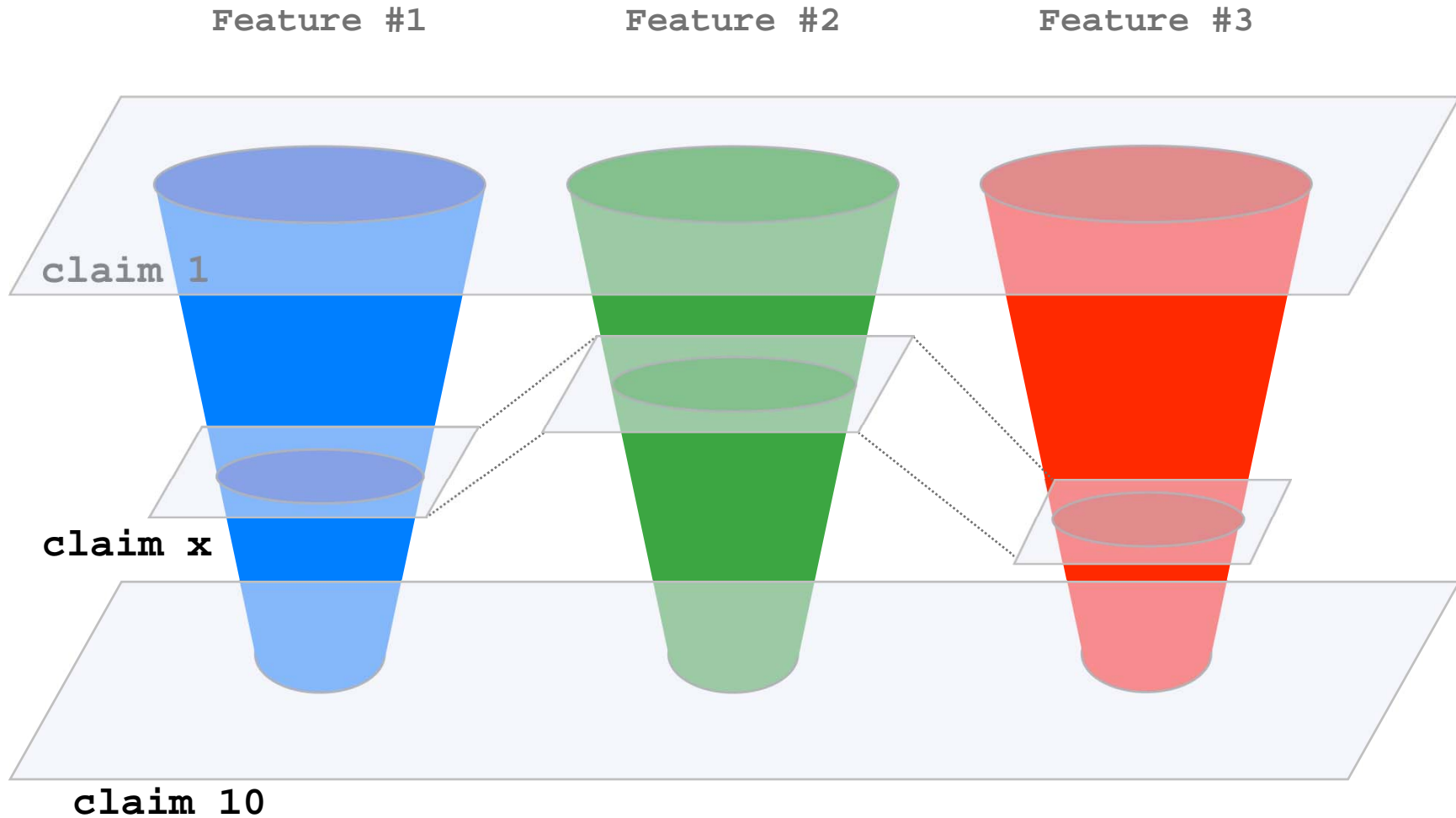
“A claim, the wording of which is essentially identical to a claim as originally filed, can nevertheless contravene the requirements of Article 123(2) EPC, if it contains a feature whose definition has been amended in the description in a non-allowable way.”

Examples – Summary

In summary, the “directly and unambiguously the same“ test:

- is used to compare the features defining the claimed embodiments with the prior art to assess novelty, with the priority application to assess priority and with the patent application to assess adequate support;
- does not require literal identity but identity in substance;
- will not be answered in the affirmative if the features defining the claimed embodiments can be considered to differ from the features disclosed in the document used for the comparison.

Consequences – Drafting Strategy



Consequences – Drafting Strategy

When generating a patent application which is to claim priority to an earlier application, always incorporate the entire text of the earlier application. Disclosure can be added, but should not be deleted or substituted.

Exception:

When there is a serious technical error in the priority application, delete the error.

Consequences – Amendments

Do not amend the text of the claims or the application or the patent unless absolutely necessary to overcome an objection. Introduce the least amendment necessary to overcome the objection.

THANK YOU!

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