



Claim Drafting Seminar

Testing the Validity of a Claim

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Testing the Validity of a Claim

1. **Clarity (Art. 84 EPC)**
2. **Sufficient Disclosure (Art. 83 EPC)**
3. **Unity (Art. 82 EPC)**
4. **Problem-Solution-Approach (Art. 56)**



Clarity - 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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clarity - Art. 84 EPC

- important not only for validity but also for enforcement
- invention should be clear from wording of claim alone
- meaning of words - if necessary definition in description
- claim should define a solution, not a problem!
- no ground for opposition!

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Art. 84 EPC - claims must be clear

- technical features_R. 29(1) EPC
- claim must comprise ALL essential features!
- structural features
- functional features
- trade marks if unavoidable and precise meaning
- relative terms (big, thin, about, etc.) : only if clear
- definition by reference : only if absolutely necessary (R. 29(6))
- parameters : only if no other definition and clear
- physical value : SI - units
- reference signs (from figures) in claims (R. 29(7))

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Art. 84 EPC - claims must be concise

- claim as such must be concise (multiple alternatives within one claim)
- number of claims : no rules, depends on case
- grouping of claims (as appropriate)

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Art. 84 EPC - claims shall be supported by description

- Support in the description for every claim
- Support over the whole breadth of the claim
- not every aspect has to be proven by example, claims may cover all obvious modifications and equivalents
- no contradictions

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Art. 83 EPC - Sufficient Disclosure I

Art. 83 EPC

The application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

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Art. 83 EPC - Sufficient Disclosure II

- in description, claims and figures (not abstract!)
- sufficient disclosure in application as filed
- not sufficiently disclosed if
 - essential facts are missing
 - invention technically not possible (perpetuum mobile)
 - if solution is objectively not obtainable
 - references possible

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Art. 83 EPC - person skilled in the art

- "to be carried out by a person skilled in the art"
- same one as for inventive step
- average practitioner aware of the complete general knowledge at the relevant date,
- may be a team of people
- can do routine experiments
- must understand the invention clearly

Guidelines C-IV, 9.3.



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Art. 82 EPC - Unity I

Art. 82 EPC

The EP patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

R. 30 EPC

Where a group of inventions is claimed, there must be a technical relationship among those inventions involving the same or corresponding special technical features. These special technical features are those which define a contribution over the prior art (independent of the fact whether claimed as alternatives in one claim or in several independent claims)

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Art. 82 EPC - unity II

- special technical features:
 - common structural features
 - common property or activity
- Lack of unity
 - a priori
 - a posteriori (after taking into consideration prior art)
- Search Division: additional search fees to be paid
- Examination Division: Deletion of claims / Divisional application
- not a ground for opposition!

Guidelines : C-III, 7

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Problem Solution Approach

1. Determine the "closest prior art"
2. Establish the "objective technical problem" to be solved, and
3. consider whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person

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Example: Lawn Mower

invention: "Machine for cutting plants, in particular grass, characterized in that it comprises means for pedaling and a seat"



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Lawn Mower - Prior Art

You receive an Office Action of the EPO which cites a document disclosing a conventional lawn mower, a second document disclosing a bike and a third document disclosing a motor driven lawn mower with seat resembling a motor bike. According to the Examiner, your claim is not inventive.... How do you argue?

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You use the PROBLEM SOLUTION APPROACH!



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Lawn Mower - Problem Solution Approach

- Closest prior art: motor driven lawn mower with seat
- Difference between prior art and invention: means for pedaling
- Technical Effect : physical exercise and no pollution/noise
- Objective technical problem: lawn mower with seat whereby you exert physical exercise and don't produce any pollution/noise

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Lawn Mower - Problem Solution Approach

- 2nd prior art: bike : no indication to lawn mower
- or
- 2nd prior art: conventional lawn mower: no indication to pedals
- combine both documents : inventive? NO

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Summary of validity of claims

- patentable subject matter
- new, inventive, industrially applicable
- clear and concise
- supported by description
- sufficiently disclosed
- unity

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