MICHALSKI HÜTTERMANN

PATENT ATTORNEYS
DÜSSELDORF • MUNICH

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When are the claims of a patent not prejudicial to novelty?

A recent appeal decision issued at the European Patent Office, T 1658/12, concerns the question, which part or parts of a patent application define relevant disclosure that can become prior art for subsequent applications.

During examination of the application underlying this decision, the Examining Division had identified a combination of features in the claims of a patent application that had been published earlier. This combination of features was regarded as anticipating the claims of the patent application at issue. However, this combination of features was only found in the claims and in the section "Summary of the Invention" of the earlier patent application.

The applicant appealed this decision by arguing that no corresponding disclosure limited to only this combination of features could be found within the detailed description of the earlier patent application – and was successful.

The Board of Appeal emphasised that a main role of the claims of a patent application lies in the attempt of achieving a scope of protection that is as broad as possible. The section "Summary of the Invention" of a patent application generally merely recites the claim wording.

The relevant teaching on an invention that allows the skilled artisan to carry out the same can only be found in the detailed description of a patent application.

If a particular combination of features can only be found in the claims or the section "Summary of the Invention", it should be carefully examined whether this combination of features really corresponds to the technical teaching of the description, or whether it is simply a result of

The "notional business person" – a new figure in patent law (?)

Another interesting decision recently issued by a Board of Appeal at the European Patent Office concerns the extent to which declarations made by non-technical experts – in this case, bankers – can be relevant in proceedings before the European Patent Office.

The case at issue, T 1463/11, concerned a computer-implemented invention in the area of payment systems. More precisely, the question arose whether there was a prejudice in the art at the priority date against using certain plugins on a centralised system, rather than on the seller's system.

The applicant presented a number of sworn statements given by bankers in order to support its argumentation.

In its reasoning, the Board of Appeal defined a "notional business person" as a new abstraction, in order to distinguish technical and non-technical features.

The main difference between a "notional business person" and a real businessman is the fact that the notional business person does not possess any technical knowledge, as a contrast to the skilled artisan.

In the present case, it was also assumed that this notional business person was a superior to the skilled artisan, who, however, does not provide technical instructions to the latter regarding how certain requirements are to be achieved.

Under these conditions the sworn statements were accepted by the Board, and effectively lead to a positive assessment of inventive step. While the declarations were given by business

And in our own affairs…

On the 8th June 2017, the 10th Rhineland Biopatent Forum is scheduled to take place in our offices. Speakers at the event include: Tarun Gandhi, Chada & Chada (India) Atushi Shiomi, Tsukuni & Associates (Japan), Tilman Breitenstein, Director DSM Innovation Center Intellectual Property, Violeta Georgieva, Legal and Regulatory Manager, EuropaBio Brussels, Dr. Bettina Wanner, Bayer Intellectual Property GmbH, as well as some members of our practice.

The event is free to attend. For the complete programme and to register your attendance, please respond here.

Proposals and Questions

If you have any proposals or questions, please don't hesitate to contact us here.

drafting the claims in a broad manner.

In the instant case, the Board of Appeal found that according to the detailed description, an additional feature was required. The claims as such lacked this feature and could therefore not qualify as novelty-destroying for the later application at issue.

While this decision may appear as a surprise at first glance, it is nevertheless in line with case law of the Boards of Appeal with regard to the requirement that any prior art, and also a priority document, must be an enabling disclosure.

In this regard, decision T 1080/99 issued in 2001, held that the abstract of a patent application needs to be read in light of the description. In particular, a published English translation of a Japanese abstract – which was in this case an incorrect translation should not be read in isolation, but instead in the light of the original document.

The practical implications of this decision are that the claims of a patent document alone should not be relied on, when attacking a patent in opposition. It should always be verified that basis in the form of corresponding passages in the description can be found.

persons, they allowed conclusions with regard to technical considerations at the priority date.

It remains to be seen whether the “notional business person” will be a one-time figure, or whether he/she will take a permanent role in the case law of the European Patent Office.

In any case, the “notional business person” used in T 1463/11 provides an interesting approach on how to distinguish technical and non-technical features of a claim.