



Topic 6 – Options in View of New Prior Art

**Bangkok
24 January
2019**

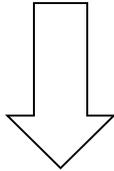
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Let's say...

File a new patent application

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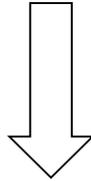
File a new patent application



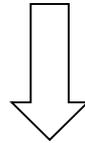
Prior art is found

Let's say...

File a new patent application



Prior art is found



Independent claim 1 is not novel

What are the options?

- Argue against the prior art assertion
- Amend the independent claim to be patentable
- Withdraw and re-file patent application

1. Argue against the prior art assertion

- Don't automatically assume that the objection is correct
- Check:
 - Is this proper prior art?
 - Is the publication date before filing date?
 - Are grace periods available?
 - Does the disclosure really invalidate the claim?

2. Amend the claim

When can you amend a claim?

- Generally, voluntary amendment is possible once search has been completed
- Further voluntary amendments may only be possible at the discretion of the Examiner
- Exceptions:
 - on entering national/regional phase (for example, in EP to reduce claim numbers)
 - Restriction requirement (US)

2. Amend the claim

Remember:

- No new subject matter can be added to a patent application after the filing date

 - Any amendments must be based on subject matter in:
 - Dependent claims
 - The specification
- > the description of an invention must contain enough information when the patent application is filed

2. Amend the claim

Big differences between EP and US practice

- EP

- Very strict – often literal basis is required

- US

- Verbatim wording is not required

- Implications in how patent applications are drafted

2. Amend the claim

- Options:
 - Incorporate subject matter from a dependent claim
 - Incorporate subject matter from the description
- Very common during prosecution
 - Does not mean that the claims were poorly drafted

2. Amend the claim – example 1

1. An apparatus comprising
a pencil; and
an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising
a light attached to the center of the pencil

Prior art cited before priority date:



2. Amend the claim – example 1

1. An apparatus comprising
 - a pencil; and
 - an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising
 - a light attached to the center of the pencil

Prior art cited:



2. Amend the claim – example 1

1. An apparatus comprising
 - ✓ a pencil; and
 - ✓ an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising
 - ☐ a light attached to the center of the pencil

Prior art cited:



2. Amend the claim – example 1

1. An apparatus comprising
a pencil; ~~and~~
an eraser attached to one end of the pencil; and
- ~~2. The apparatus of claim 1, further comprising
a light attached to the center of the pencil~~

Prior art cited:



2. Amend the claim – example 2

Method of brewing tea

Inventive feature – brewing at 50°C



2. Amend the claim – example 2

1. A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.
2. The method according to claim 1, wherein the tea leaves are provided in a bag.
 1. The method according to claims 1 or 2, wherein the water temperature is at least 65°C.
 2. The method according to claim 3, wherein the water temperature is between 75°C and 85°C.

2. Amend the claim – example 2

Prior art found:



2. Amend the claim – example 2

1. A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.
2. The method according to claim 1, wherein the tea leaves are provided in a bag.
 1. The method according to claims 1 or 2, wherein the water temperature is at least 65°C.
 2. The method according to claim 3, wherein the water temperature is between 75°C and 85°C.

2. Amend the claim – example 2

1. A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.
2. The method according to claim 1, wherein the tea leaves are provided in a bag.
1. The method according to claims 1 or 2, wherein the water temperature is at least 65°C.
2. The method according to claim 3, wherein the water temperature is between 75°C and 85°C.

2. Amend the claim – example 2

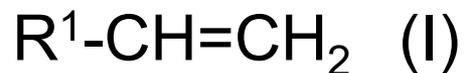
1. A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C.
- ~~2. The method according to claim 1, and wherein~~
the tea leaves are provided in a bag.
3. The method according to claims 1 or 2, wherein the water temperature is at least 65°C.
4. The method according to claim 3, wherein the water temperature is between 75°C and 85°C.

2. Amend the claim – example 2

1. A method of brewing tea, comprising steeping tea leaves in water at a temperature of at least 50°C, wherein the tea leaves are provided in a bag.
2. The method according to claim 1, wherein the water temperature is at least 65°C.
3. The method according to claim 2, wherein the water temperature is between 75°C and 85°C.

2. Amend the claim – Markush claims

1. A compound of formula (I)

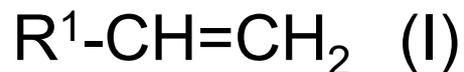


wherein R¹ is H, methyl, ethyl, or propyl.

Prior art is: $\text{H}_3\text{C-CH=CH}_2$

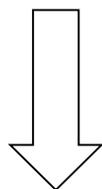
2. Amend the claim – Markush claims

1. A compound of formula (I)

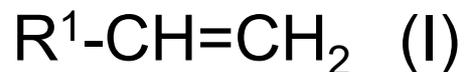


wherein

R¹ is H, methyl, ethyl, or propyl.



1. A compound of formula (I)



wherein

R¹ is H, ethyl, or propyl.

2. Amend the claim – from the description

Watch out:

- Not all amendments from the description are allowable in certain jurisdictions (EP)
 - Amendments from figures
 - Generalization from specific embodiments
 - Selections from multiple lists

- When drafting, try to include
 - Specific embodiments
 - Pointers (preferably, even more preferably ...)

2. Amend the claim – from the description

Example:

Claim 1:

A water disposable and flushable absorbent article, comprising [...] first and second fibrous assemblies [...]

Amended claim 1:

A water disposable and flushable absorbent article, comprising [...] first and second fibrous assemblies [...], **wherein each of the first and second fibrous assemblies is a wet laid tissue.**

2. Amend the claim – from the description

Amended claim 1:

A water disposable and flushable absorbent article, comprising [...] first and second fibrous assemblies [...], wherein each of the first and second fibrous assemblies is a wet laid tissue.

- “a wet laid tissue” was always disclosed in combination with
 - the feature that the tissue is apertured (see original claim 1), or
 - the feature that the tissue is provided with fibrils (see original claim 14) or
 - the feature of sufficient inherent porosity (see page 21, lines 1 to 25).

3. Divisionals

- Divided out from the original filing
- Therefore has the same subject matter – cannot add subject matter
- Reasons for filing
 - Keeping application alive if under litigation so that you can amend to something that might be considered valid after proceedings
 - Prosecuting non-unified subject matter
 - Prosecuting broad claims when you already have allowance of a narrow claim.

3. Divisionals

When:

- Before the parent application has been granted

4. Other options – 1

Withdraw and re-file

- Can you reframe the claims and/or add new material to address the cited art?
- Very short window to re-file: after the international search and before preparations for international publication have been finished.

4. Other options – 2

Conversion to utility models

- Available only in certain countries (China, Germany, Austria, Greece, Italy, Ireland...)
- Less stringent requirements for examination (if any)
- Shorter terms
- In some countries, can only be obtained in certain technologies – some countries only allow for apparatus or mechanical inventions, and not processes.

Other considerations

- Costs
- Timeframes
 - Are other filings possible (for example to improvements)?

Other considerations

- Degree of amendment varies depending on jurisdiction (EPO is very strict – USPTO more lenient) so ensure you have appropriately complete description of the invention in the patent application as filed

Other considerations

- Remember:
 - Prior art can be own prior art
 - Publication = publication to everyone
 - Grace periods are only available in some jurisdictions so don't rely on these unless absolutely necessary

■ Thank you!

Examples of problems – 1

1. A machine readable security element comprising a mixture of at least two pigments,

wherein a first pigment comprises a first substance comprising a luminescent dopant ion that emits electromagnetic radiation; and

a second pigment comprises a second substance comprising a second luminescent dopant ion;

[...]

wherein the second dopant **largely** quenches the emission from the first dopant at one or more emission peak.