Rejections:

Reasons for Rejections and Proper Drafting of Rejection Rulings

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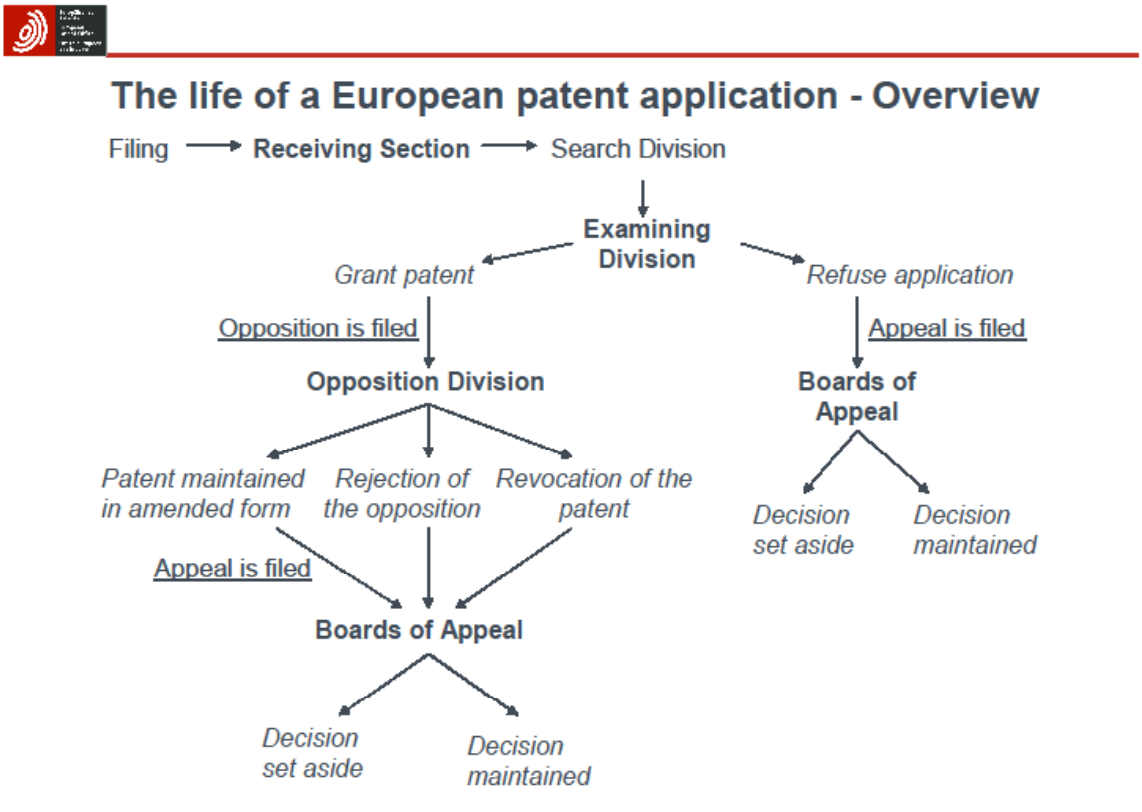
Dr. Wolfgang Tauchert
Former Presiding Judge at the German Fed. Patent Court

Process of Patent Examination - Schedule



Final Decisions: Grant / Rejection (Refusal)

Final decisions or judgements which terminate a procedure before the office:

1) Decision to grant a patent, i.e. a judgement that the application meets all legal requirements.

2) Decision to refuse/reject an application, i.e. a judgement that discussion has ended and a patent cannot and will not be granted for lack of one legal requirement (one is enough, even if there are more).

Reasons for Rejections (Refusals)

An application is rejected, because the law – e.g. art. 97(1) of EPC – requires the examiner/patent office to reject it:

„If the application or the invention to which it relates does not meet the requirements of the Convention and no other sanction is provided for by the Convention“.

Prerequisite: Fair trial – following the basic rules. Decision to reject an application occurs generally after two (or more) actions (letters, oral proceedings...).

Basic Rules Governing Applicant-Office Communication in the Examination Process

1) Principle of request (petition):
Applicant decides what to claim and how to request (defining the subject matter and the wording of the claim)

2) Principle of investigation;
Office (examiner) has to check the subject matter as claimed in its entire scope and make objections as to the criteria of patentability.

3) Principle of full hearing („right to be heard“, due process of law, „fair trial“):
Decisions differing from applicants requests – like rejections – must be based on grounds the applicant has been informed of before, giving him opportunity to argue and to amend).

Rejection – Preparatory Communication

Types of rejections:

1) Decision with a full reasoned explanation;

2) decision to refuse an application according to the state of the file:
(Examiner has raised defects and amendments in the application and stated lack of patentability without reaction of the applicant).
=> short form of rejection (with reference to the previous communication)

Rejection – Checks before Communicating to Reject (Due Process of Law, Fair Trial)

- Had applicant the opportunity to comment on grounds and evidence for the refusal?

- Request for oral proceedings pending?

- Are there any allowable auxiliary requests?

- Has applicant got a warning of impending rejection?
- Were relevant prior art documents published in time? (priorities in case of Art 54(3) – documents!)

- Is the refusal an appropriate response with regard of at least one of the reasons communicated so far

Communicating to the Applicant the Decision to Reject theApplication

Two step structure of the decision :

1) Summary of facts and submissions

(with or without mentioning the announcement of the decision to refuse during oral proceedings)

2) Reasons for the decision

Object of the reasoning: Actual request(s)

If there is only one request (as usual):
Listing of the last set of documents;
If there are subsidiary requests:
Separate lists for each request)

1) Summary of facts and submissions - Draft:

a) Repeating of the grounds and evidence already communicated in official communications or oral proceedings by mentioning
- the date of the official communication
- the objections raised in it and
- the prior art documents used

b) Stating in summary
- the arguments from the applicant pertinent to the decision now being taken
- wether the applicant has amended the application in response or has presented arguments in reply

2) Reasons for the Decision - Draft

a) Stating of the main ground for the refusal (e.g. subject matter of claim 1 is not new/ not inventive / contrary to the requirement of Art. 52(1) and 54.

b) Stating in detail all the facts, evidence and arguments relevant to the main reason for refusal

c) Dealing with each counter argument of the applicant by
- explaining why each cannot be accepted
- basing the reasoning on the text of the official communication

Rejection According to the State of the File;
(the Name of the Game is the Claim)

Applicants request of „a decision on the state of the file“ leads often to a rejection of the

application by a simplified procedure. But there

are also some points to check beforehand:

Rejection according to the state of the file
- checks -

Application grantable without amendment? **Yes => Grant**

No

Amendments made with request? **No => Formal rejection**

Yes

Amendments influence grounds for refusal? **Yes => Continue examination**

No

Proceed to full reasoned refusal

Example of a reasoned Explanation to a Decision to Reject – case and claim presentation

Application 89 765 432.1 was filed on 28/07/89 with a claim to priority from GB – A-1 234 567 filed on 28/07/88 The applicant requests the grant of a patent based on the following documents:

Description pages 1 – 4 as originally filed;
claim 1 filed with the letter of 30/10/93;
claim 2 – 5 as originally filed,
drawing sheets 2/2 as originally filed

Independent claim 1 reads as follows:

„A dining table having legs evenly distributed around the periphery of the table top, which legs do not protrude beyond said periphery, characterized in that the table has three legs.“

Dependent claims 2 – 5 relate to further constructional details of the table of claim 1.

Example of a reasoned Explanation to a Decision to Reject – Summary of facts and submissions

Application 1234567 was filed on dd/mm/yy with a claim to priority from DE- A-1 456789 filed on ../../.. .

In communications dated ../../../ and ../../../ the applicant was advised that the subject matter of claim 1 lacked novelty with regard to US-A-2 345 678 and the subject matters of the dependent claims lacked an inventive step with regard to a combination of US-A-2 345 678 GB A-8 765 432.

In the letter of ../../../ the applicant filed arguments in reply to the objections raised together with an amended claim 1, and with the letter of ../../../ the applicant filed further arguments in favour of patentability. Oral proceedings have not been requested.

The applicant requests the grant of a patent based on the following documents:

Description pages 1 – 6 as originally filed;
claim 1 as filed with the letter of ../../.. ;
claims 2 – 5 as originally filed;
drawings sheets 2/2 as originally filed.

Independent claim 1 reads as follows: ... ...
Dependent claims 2 – 5 relate to further constructional details of claim 1.

Example of a reasoned Explanation to a Decision to Reject – Reasons for the decision

- The present application does not meet the requirements of Art. 52(1) and 54(1) and (2) of EPC, because the subject matter of claim 1 is not new with regard to the disclosure of US- A-2 345 678.
- US- A-2 345 678 (Fig. 3) shows a table having four legs evenly distributed around the periphery of the tble top and the legs do not protrude beyond the periphery. Since a table which has four legs inevitably has three legs(plus one) the subject matter of claim one is not new.
- The applicant argues that the claim implies that only three legs are present. However this cannot be accepted, since, as was stated in the communication of ../../.. , the word „only“ does not appear in the claim and thus the claim is not so limited.
- Even if claim 1 were amended to clearly state that only three legs were present, the subject matter of claim 1 would not involve an inventive step.
- DE -A-8 765 432 shows a table having three legs acc. to claim 1. The difference to this subject is that the legs do not protrude beyond the periphery of the table. US- A-2 345 678 also deals with the problem of protrudung legs and clearly states (at colmn 5, lines 20 – 30) that this problem is to be avoided by arranging the legs in a non-protruding way.
- Thus it is obvious for a skilled person to modify the three legged table of DE -A-8 765 432 using the information from US- A-2 345 678 and thereby arrive at the subject matter of claim 1. Claim 1 cannot be allowed for lack on inventive s
Claims 2 – 5 describe various constructional details readily visible in both documents mentioned above and therfore do not add to claim 2 any matter which which could involve an inventive step over the combination of the cited documents.
Since the aplication does not meet the req. of EPC it is rejected (Art 97(1))

Article 52 EPC:

(1) European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information.

(3) Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

Article 54 EPC (Novelty):

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of written and oral description, by use or in any other way, before the date of filing of the European patent application.

(3) Additionally the content of European patent applications as filed, of which the date of filing are prior to the date referred to in paragraph 2 and which were published under article 93 on or after that date, shall be considered as comprised in the state of the art.

Article 56 EPC (Inventive step):

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of the Article 54, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

Thank You!

? Questions ?