

# Preparing a US Patent Application with European Filing in Mind

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# Motivation

- Why consider filing in Europe?
  - Large Market
    - Greater population than the US
    - Slightly higher combined GDP than US
    - Note – This is all EPC contracting states combined
      - Currently 38 states
    - As a practical matter, protection is often only sought in a few of the larger markets or in countries where competitors are located

# Motivation

- Language / translation no longer as big an issue
  - London Agreement
    - Went into force on 1 May 2008
    - 18 contracting states (including, e.g., Germany and France, but not, e.g., Spain and Italy)
    - In many (but not all) no translation of the specification is needed if supplied in English

# European Patent Court

- Following decades of discussion, new agreement this year
  - Approved by European Parliament yesterday
- Unitary EU Patent
  - 25 Countries
  - Starting in 2014
- Unitary EU Patent Court
  - Main seat in Paris, with secondary seats in London (primarily for pharma) and Munich (primarily for mechanical)

# European Patent Court

- Spain and Italy have refused to sign on
  - Language issue – they argue that the new regime unfairly favors English, French, and German
  - Complaint filed with EU Court of Justice

# European Patent Court

- Unclear what procedures will look like
  - In theory, procedures to be in place by April 2014
- Currently no real body of “European” law for enforcement of patents
  - Could follow patent-holder friendly standards (e.g., Germany), or not (e.g., UK)
- Could we see a shift in the focus for patent litigation from the US to Europe?
  - Probably not right away...

# Motivation

- Given all this, it is probably time to make sure that your patents will be solid and enforceable in Europe
- Problems
  - Many US “best practices” are harmful in Europe
  - Many European “best practices” are harmful in the US

# Why adjust US drafting to accommodate European filing?

- Cost
  - Being aware of the differences, and properly handling them when drafting and prosecuting your application in the US can save costs when later filing in Europe
- Can lead to easier prosecution in Europe
- Can lead to more solid patents in Europe
- All, hopefully, without sacrificing protection in the US



# Drafting the Application

- Claims
- Specification
- Drawings
- Prosecution
- Misc.

# Claims

- Overview
  - Numerous differences
  - Probably don't want to use the same set of claims in the US and Europe
  - Probably best to leave this to a European patent attorney
  - But there are some things that can be done to make the job easier and less expensive

# Claims – Independent Claims

- Rules 43(2) and 62a EPC
- Only one independent claim per category (with exceptions)

# Claims – Independent Claims

- This is not a problem in the US
- Numerous independent claims per category allowed
- Permits multiple independent claims of varying scope

# Claims – Independent Claims

- How to handle this difference
- In your US application include a broad independent claim in each category that is intended to serve as the basis for a European claim
  - Slightly more "functional" language - see below
  - Cover all important features and embodiments
  - These practices may also be in line with US practice
  - If the number of independent claims needs to be limited, consider putting the wording for these claims in the specification

# Claims – Unity of Invention

- Rule 44 EPC
  - Where a group of inventions is claimed, for unity of invention, there must be a technical relationship among those inventions involving one or more of the same or corresponding special technical features.
    - i.e. – independent claims need a distinguishing feature in common
    - Applies whether inventions claimed in separate claims or as alternatives in a single claim
- So - claims should have a common distinguishing feature

# Claims – Functional Language

- Functional language is given a broad interpretation in Europe
  - Unfortunately, this is true during prosecution, as well as in litigation
- In US, “means plus function” language is avoided (at present)
  - Interpretation is often narrow
  - Want to avoid 112 paragraph 6(or 112(f) under the AIA)

# Claims - Functional Language

- So -
  - We want functional language in Europe
  - We do not want it in the US
  - So - just add it when filing in Europe?
    - PROBLEM - generalization, like adding “means plus function” claims when filing in Europe needs adequate support in the originally-filed (i.e., US) application
    - Support in specification must be (almost) literal



# Claims – Functional Language

- Make sure that there is literal support for functional claims
- Provide literal support for both broad and intermediate scope functional claims
  - Provides fallback position if broad interpretation of functional claims leads to novelty or inventive step issues
- Draft independent claims using functional language
  - But generally avoid "means plus function" in the US

# Claims – Two-Part Form

- Rule 43(1) – two-part form
- Start with "closest prior art" in preamble, and put distinguishing features in "characterizing" portion
- Like a US Jepson claim
  - Usually avoided in US practice

# Claims – Two-Part Form

- How to handle this
- Don't use two-part form in the US
- Use two part form in Europe only if demanded by the Examiner
  - Even if the Examiner requests this, you can probably argue around it
  - ... Applicant believes that separating the claim into a preamble that reflects the prior art and a characterising portion would be unduly burdensome, and would make the claim less clear ...

# Claims – Number and Costs

- Fewer claims in Europe
- Due to cost
  - Each claim above 15 costs EUR 225
  - Each claim above 50 costs EUR 555
- But multiple dependent claims and alternative claiming are the norm
- This can be used to reduce the number of claims by combining claims from the US application

# Claims – Number and Cost

- Do not "waste" dependent claims
- When writing the US dependent claims, note which ones provide an inventive distinction
- These can form the basis for a greatly reduced claim set in Europe
- Put the rest of the claims and fallback positions in the specification, so you can (perhaps) amend to them, should that prove necessary

# Claims

- Claims in Europe usually include reference numbers
  - Usually not a problem to just add these when preparing the application for European filing
  - Do not use these in your US application
  - But make sure that the main elements that you intend to claim are included in the drawings, and have reference numbers
  - Probably need to do this in the US application anyway

# Specification

- Overview
- There are some differences - but they can be handled

# Specification - Background

- Rule 42(1)(b) - Prior art needs to be specifically acknowledged in the background
- It is also common to lay out the problem to be solved in Europe
  - This provides support for arguing inventive step according to the "problem solution" approach



# Specification - Background

- Both these are typically avoided in the US
- "Best practice" is to keep the background minimal
- Some leave the background out entirely

# Specification - Background

- How to handle this?
  - Include a background
  - Discuss the most relevant prior art
    - Avoid characterizing the art
    - Use quotes, e.g., from the abstract or summary
    - Background can look like a list of prior art

# Specification - Summary

- Should discuss the advantages and technical effects in a European application
  - This sets up the advantages and technical effects that can be argued during prosecution
  - Advantages argued during prosecution are given little or no weight if not in the original application

# Specification - Summary

- This is contrary to US practice
  - Avoid discussing advantages
  - Might be limiting or lead to a narrow claim construction

# Specification - Summary

- You can still discuss technical effects and advantages in a US application - but be very careful
  - Avoid linking advantages to specific features
  - Use "non-binding" language (e.g., "may")
  - This can be put into the detailed description, rather than the summary

# Specification – Detailed Description

- Main concerns when dealing with US applications:
  - Art. 123(2) EPC – “The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.”
    - Need essentially literal support for the claims and for any amendments
    - Must be able to “directly and unambiguously” derive the amended feature from the original text

# Specification – Detailed Description

- Main concerns when dealing with US applications:
  - Combinations
    - Not as flexible as in the US
    - Difficult to amend to select a single feature from a disclosed combination
    - Difficult to add features from other embodiments into a combination

# Specification – Detailed Description

- Main concerns when dealing with US applications:
  - Difficult to use general terms (e.g., “connector”) in claims (esp. when amending claims), when feature is disclosed using specific term (e.g., “nail”)



# Specification – Detailed Description

- How to handle these concerns:
  - Make sure that features are not described in the context of just a single example, and then claimed in a broad manner or in a manner that applies to combinations that were not explicitly disclosed
  - Use the language that you intent to use in the claims
    - Provide sufficient fallback positions
  - Note – These are probably good practice in the US

# Specification – Misc.

- Use SI Units
- Do not incorporate by reference

## Note - “Inescapable Trap”

- Careful of the “inescapable trap”
- Occurs in opposition proceedings
  - Cannot extend the scope of protection after grant
  - If an allowed limiting amendment during prosecution added new matter, that matter must be removed
  - But removing the new matter would extend the scope of protection...

# Drawings

- Good news – US is normally more strict about drawings than the EPO
- Typically, US drawings will not need to be changed
- Note – Keep in mind that it is very difficult in Europe to base an amendment or a claim feature only on a drawing
  - You need descriptive text

# Prosecution

- Information Disclosure Statement
  - Rule 141 EPC
  - For all European applications having a filing date after 1 January 2011, must file copies of searches (i.e., search reports, office actions) from applications from which priority is claimed
  - This is an ongoing obligation (during pendency before the EPO)

# Prosecution

- Divisionals
  - Earlier application must be pending
  - For voluntary divisionals, 24 months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued
  - Mandatory divisionals - 24 months from any communication in which the Examining Division raises a non-unity objection, provided it was raising that specific objection for the first time

# Prosecution

- Amendments
  - After filing, claims cannot be amended until the search report is received
  - Only one opportunity to amend as of right
  - Further amendment only with consent of the Examiner
  - Explicit support needed (see above)
  - Cannot amend with subject matter that was not subject to a search

# Prosecution

- No prosecution estoppel in Europe
- But statements made in prosecuting a European application might affect US litigation
  - So – be careful during European prosecution
  - Work (if possible) with European counsel who understand this risk



# Special Issues

- Computer Implemented Inventions
- Art. 52(2)(c) – excludes patentability of “schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers”
- Only excluded to the extent that the application “relates to such subject-matter or activities as such” (Art. 52(3))

# Special Issues

- So - Computer Implemented Inventions can be patented in Europe
  - Must show “further technical effect”
  - further technical effect which goes beyond the normal physical interactions between the program and the computer.
  - e.g. the control of an industrial process or in processing data which represent physical entities, or, e.g., affecting the efficiency or security of a process, the management of computer resources required or the rate of data transfer in a communication link.

# Special Issues

- Computer Implemented Inventions
  - Careful of computer implemented business methods – these can be very difficult in Europe

# Special Issues

- Art. 53(c) – Excludes from patentability methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body
  - purpose-related product protection for any further specific use of a known medicament is permitted (Art. 54(4))
  - e.g., A substance X for use in a treatment of disease Y in a manner Z
  - may derive notional novelty and inventiveness solely from the particulars of the specifically claimed use

# Conclusion

- US applications can be drafted in a way that will make obtaining protection in Europe easier / less costly
  - Can be done without any major negative impact on protection in the US, if done carefully
- If European filing will be important, consider reviewing applications early in the process – possibly before US filing – for European issues.

- Questions?