



WSPLA (Wash. State Patent Law Assoc.) Lunch Seminar

**Date: March 15, 2017
12:00-1:30~2:00**

**Place: Seattle, WA
(Washington Athletic Club
1325 6th Ave. Seattle 98101)**

Dos and Don'ts of US Inbound & Outbound Applications

Striking the balance between meeting EP/CN/JP requirements and complying with US practice

(Panel Discussion by EP/CN/JP/US Patent Counsel)

Panel:

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OUTBOUND

Best Practices for Preparing US Applications Destined for EP/CN/JP

- A. Common formality problems EP/CN/JP counsel see in US applications
(Curable on or after EP/CN/JP filing)
- B. Common substantive problems EP/CN/JP counsel see in US applications
(Possibly Incurable)

A. Common formality problems EP counsel see in US applications

- Reference numbers not in claims/abstract
- References to the “spirit” of the invention and other language which suggests that the scope of protection extends beyond the claims
- Claims not in 2-part form (but please do not use this form before filing)
- Incorporating documents by cross-reference is usually objected to
- Large numbers of claims (€235 for each claim over 15 increasing to €585 for each claim over 50)

A. Common formality problems EP counsel see in US applications

- Multiple independent claims in the same category are not permitted unless the application involves:
 - a) a plurality of interrelated products;
 - b) different uses of a product or apparatus; or
 - c) alternative solutions to a particular problem where it is inappropriate to cover these alternatives by a single claim.

A claim that does not satisfy these conditions is wasting one of the 15 free claims.

The EPO will not permit two (or more) independent claims in the same category that use different wording to cover the same thing.

A. Common formality problems CN counsel see in US applications

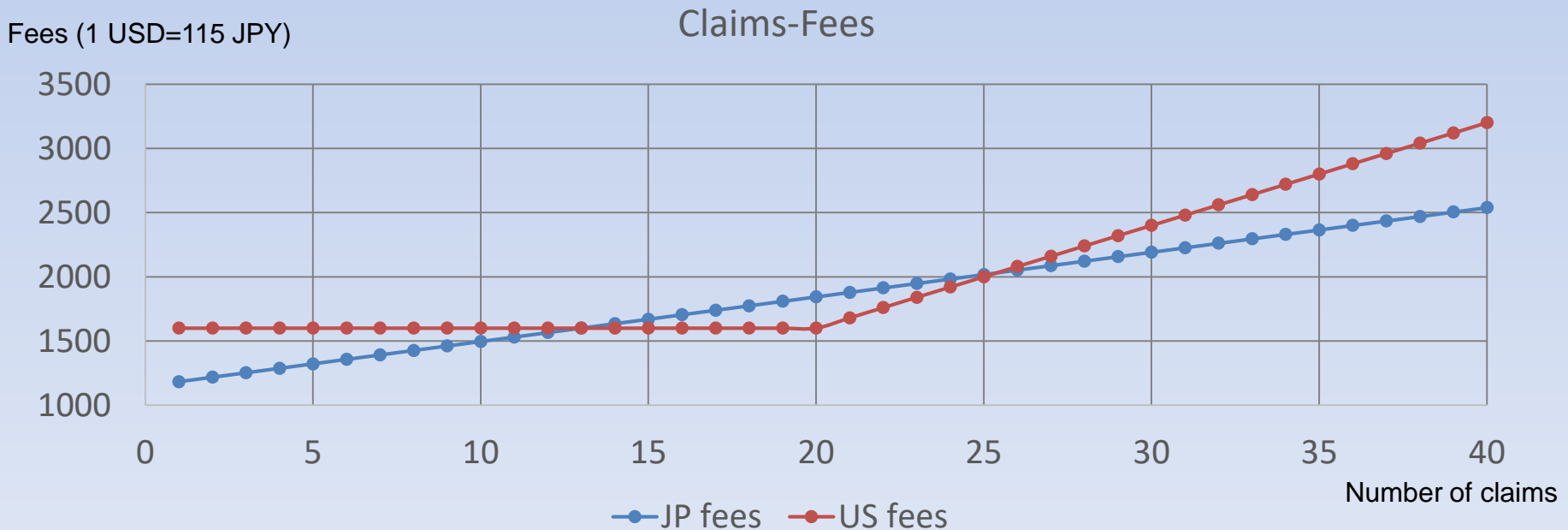
- Little or no background information—correctable, if something may be found in the description
- Too many claims, costly!
 - Extra claim fees charged for all claims included in PCT publication, and no reduction of fees by subsequently reducing the claims upon national entry into CN
- Claims for non-patentable subject matter
- Claims for a utility model (UM) patent – a term of 10 years
 - UM patent subject only to formality examination (easier to obtain)
 - No functional language allowed in UM claims
- Multiple dependency—Chinese practice is the same as in US

A. Common formality problems CN counsel see in US applications

- Informal drawings as part of initial disclosure
 - Late filing of “formal” drawings cannot introduce any matter that are not clearly disclosed in the informal drawings
- Inventor as “applicant “ in PCT, especially when the inventor has a Chinese name
 - May flag a possible violation of technology export regulation & secrecy examination rules
- Cross Reference and claiming of priority to previous US applications in the US specification has no legal effect in CN
- Non two- part claim is not always objected to, although two-part claim is required

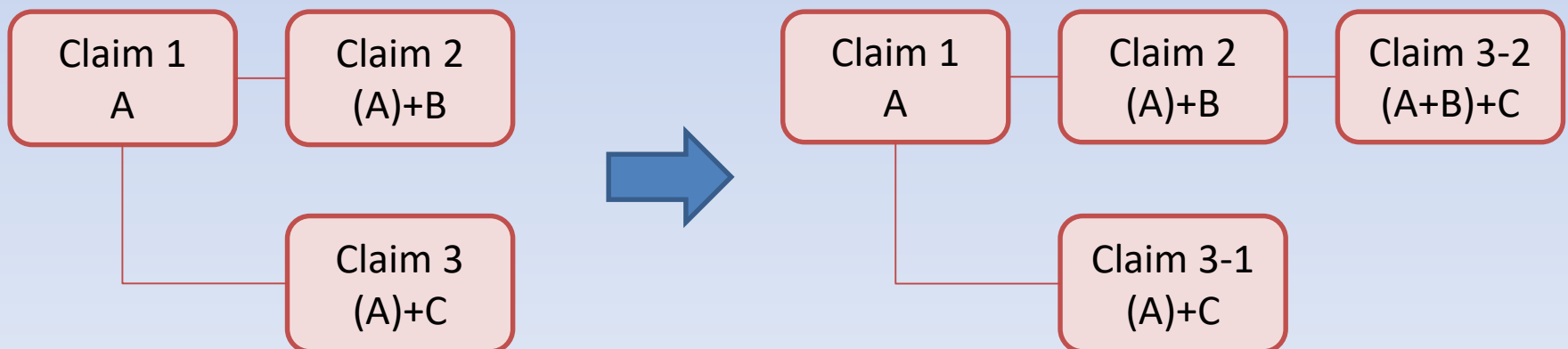
A. Formality benefits that US applicants sometimes fail to reap

- JP fees are proportional to the number of claims.
- Some JP applications from US have exact 20 claims.



A. Formality benefits that US applicants sometimes fail to reap

- JP is generous to multiple or multi-multi dependent claims.
- Some US applications do not have such chains of claims.
- Robust chains of claims might deter the office action regarding lack of unity of invention.



B. Common substantive problems EP counsel see in US applications

General Claim Problems

- Overly broad claims can result in a finding of lack of unity a posteriori and a request by the EPO for lots of extra search fees (€1300 each).
- Dependent claims are often dismissed without analysis by the EPO because they recite seemingly conventional features. The chance of this can be reduced by explaining in the description the problem to be solved by the feature and why use of a conventional feature in that context would be unexpected/advantageous.

B. Common substantive problems EP counsel see in US applications

Added Subject-Matter Problems (1)

- Intermediate generalisations constitute added subject-matter under EP law. Write the description and the dependent claims at different levels of generalisation.
- Combining claims can constitute added subject-matter unless in accordance with a specified claim dependency. Use multiple claim dependencies in the original US application (for priority) and the EP filing.
- EPO examiners often will not accept that features/processes with different names are actually the same, so the description of one cannot be used to amend claims to the other. Use consistent terminology throughout the description and claims.

B. Common substantive problems EP counsel see in US applications

Added Subject-Matter Problems (2)

- We see many US-originating applications in which every feature in the description is optional and possibly part of a different embodiment.

“In an embodiment, the system may comprise In an embodiment, the system may comprise.....”

Some EPO examiners are objecting that descriptions written in this way provide no support for any amendment of the claims because there is no basis for the combination of the originally claimed features with a feature selected from the multitude of unrelated features in the description.

The examiners equate it with a filing a dictionary and stating that the invention comprises any combination of the words therein, without any guidance . This is a particular problem, if the description does not explain the technical problem to be solved by the invention and how the individual features and combinations of features contribute to solving that problem.

B. Common substantive problems EP counsel see in US applications

Priority Problems

- The test for entitlement to priority is applied in the same strict way as the test for added subject-matter.
- This can lead to priority problems with provisional applications that are not written as full patent applications with claims.

B. Common substantive problems EP counsel see in US applications

Inventive Step Problems

- Failure to describe the technical problem to be solved and the technical advantages of features can lead to lack of inventive step objections and make it difficult to rebut these objections.

This is especially true for computer program inventions.

- **Aside:** In the computer software field, signal claims are permitted at the EPO, so remember to include them

B. Common substantive problems CN counsel see in US applications

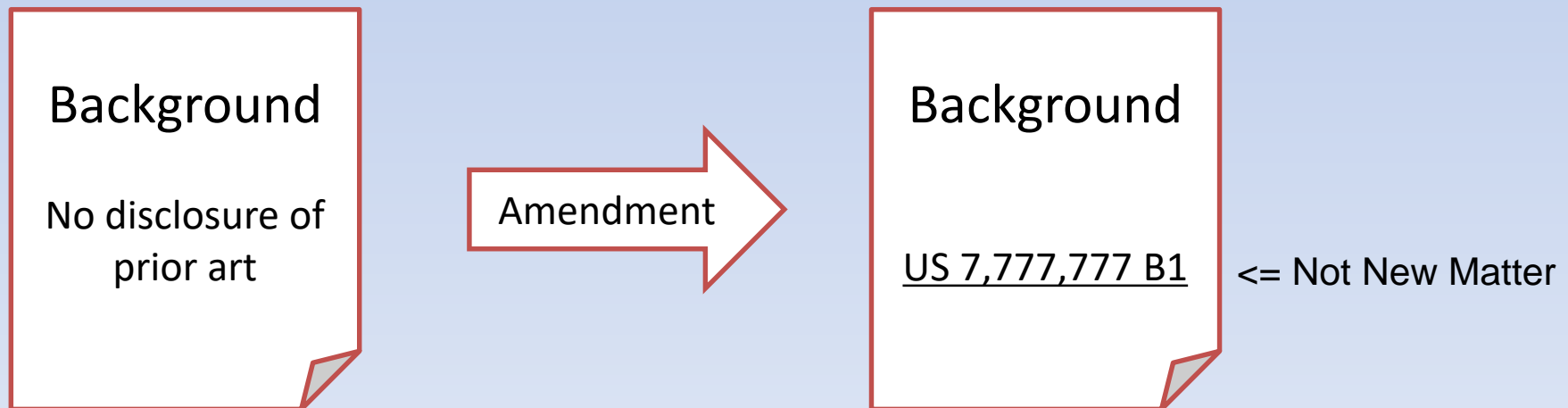
- Background: missing prior art information—Technical problem
- No clear indication of inventive features—Technical solution
- No indication of advantages over prior art—Technical effects
- Any terms in claims, not in specification—Support (literal)
- Less concrete/broad description of embodiments—Support
- Missing test data, examples, comparison, preparation process & conditions (chem. or pharma.)—maybe “fatal”
- Alternative sets of claims, not sharing common inventive features, are subject to “unity objection” & divisional application

B. Common substantive problems CN counsel see in US applications

- Method claims for treatment or diagnosis are not allowed in CN, and maybe fatal if the description contains nothing else to be claimed
- Missing flowchart or functional blocks—Software invention
- Divisional application(s) can be filed voluntarily at any time before termination of the parent application. Further divisional(s) may be filed only if the examiner raises a unity objection.
 - Claims for divisional application must be substantially supported by the original disclosure
- Voluntary amendment & added contents must be clearly & undoubtedly derivable from the original disclosure

A. US minimalist drafting is generally no problem and sometimes even effective in Japan.

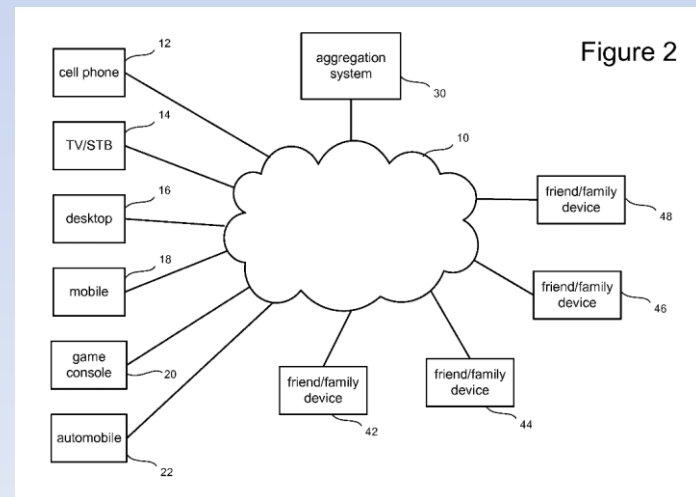
- Minimum disclosure as such is not a problem in Japan.
- Minimalist drafting might avoid narrow claim construction.
- Lack of disclosure of prior art is curable.



B. US minimalist drafting is generally no problem and sometimes even effective in Japan.

- In some judicial cases the claim was constructed narrowly based on the problem to be solved.
- Section of “Problem to be Solved by Invention” is considered necessary in JP practice.
- Specific problems must be described in the US application?
Minimalist drafting does not work in Japan? Actually it works!!

Example



Example

BACKGROUND

[0001]

With the widespread adoption of the Internet, more people have access to more information than ever before. For example, people can track friends, musical groups and public figures on social networking sites, websites that aggregate content, and online communities ... **Despite all of these sources of information, people still miss events and experiences that they would have wanted to participate in.**



US => JP

BACKGROUND

[0001]

With the widespread adoption of the Internet, more people have access to more information than ever before. For example, people can track friends, musical groups and public figures on social networking sites, websites that aggregate content, and online communities. ...

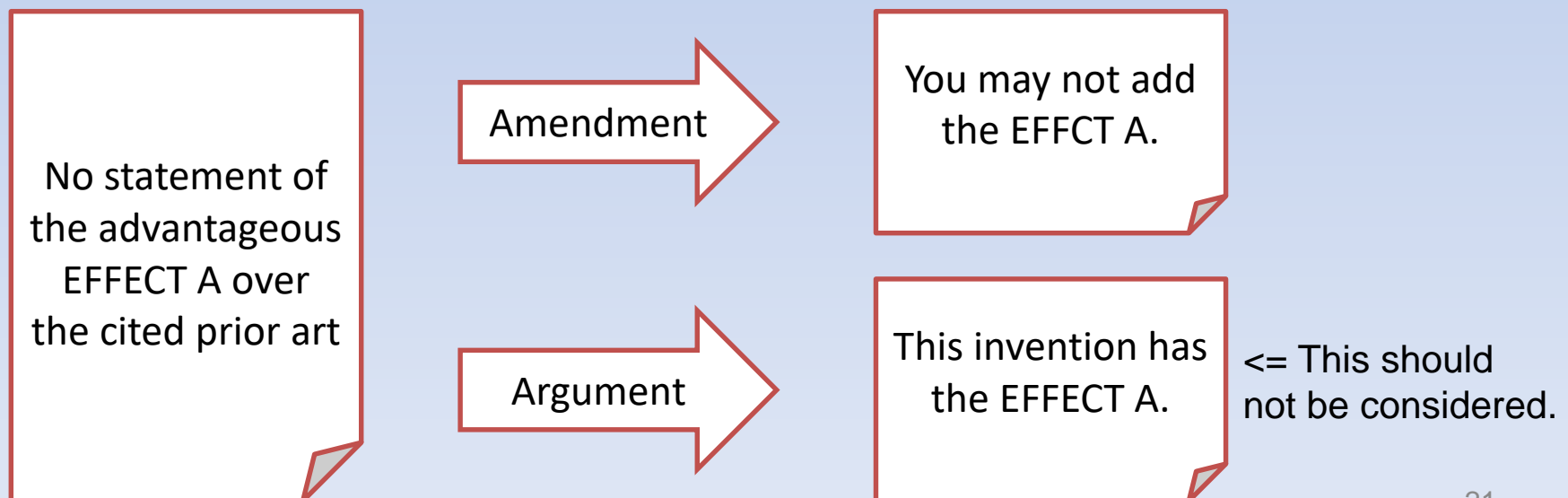
PROBLEM to be SOLVED by INVENTION

[0002]

Despite all of these sources of information, people still miss events and experiences that they would have wanted to participate in.

B. But there are some drawbacks in US minimalist drafting in Japan.

- JPO examiners will not take account of advantageous effects in the written argument against lack of inventive step if such effects are not in or inferred from the specification.



B. But there are some drawbacks in US minimalist drafting in Japan.

- Minimalist drafting sometimes cause a communication problem.
 - Sometimes JPO examiners cannot follow the story.
 - It is more likely to evoke lack of clarity or other description requirement problem.
 - Poor quality translation make this problem worse.
- It seemed to me that JP attorneys also didn't follow the story.

Prior Art
Problems

Embodiment

Effects

- Examiners like a traditional drafting style.

B. But there are some drawbacks in US minimalist drafting in Japan.

- The recent IP High Court case can affect US drafting.
- US minimalist drafting might narrow equivalent scope.
- If prior art described in the specification is objectively insufficient, the court looks to other prior art not described in the specification (often submitted by the accused infringer), finds the invention's contribution over the prior art to be small and interprets the “essential part” of the invention narrowly. The “essential part” cannot be broadened under DOE.

| | Essential part (literal infringement req'd) | Non-Essential part (DOE applicable) |
|--------------------------------|---|-------------------------------------|
| Patentee's contention | Manufacturing Process | Starting Material |
| Accused Infringer's contention | Manufacturing Process & Starting Material | |



Cf. Requirements for Doctrine of Equivalence in Japan

- The difference is a non-essential part;
- The same function and effect can be achieved by the replacement;
- The replacement is obvious by a PHOSITA at the time of production;
- The product is not identical to the technology in the public domain at the time of filing or could not have been easily conceived at that time by a PHOSITA;
- No special circumstances such as prosecution history estoppel.

C. Recent Supreme Court case can affect US drafting

- Product-by-process (PBP) claim might evoke lack of clarity problem, although it's not common in US because of *Abbott Lab. v. Sandoz*.
- PBP claim is permitted only when there are special circumstances that make it impossible or impractical to define the product without PBP.
- PBP claim is constructed to include any products resulting from the process.



INBOUND

Best Practices for having US-destined applications prepared in EP/CN/JP

- C. Common formality problems found in EP/CN/JP applications
(Curable on or after US filing)
- D. Common substantive problems found in EP/CN/JP applications
(Possibly Incurable)

C. Common formality problems found in EP/CN/JP applications

- 2-part form claims
- Multiple dependent claims
- Reference numbers in claims/abstract
- Means-plus-function format claims (...section, unit, module, device, etc.) → amendable so as not to trigger 112(6)
- Too few claims → increase up to 20/3

D. Common substantive problems found in EP/CN/JP applications

- Extensive background information – lengthy and detailed
 - In the US, background may be deemed admitted prior art, so it's better to limit to discussing close prior art only, and only paraphrasing the abstract of the prior art as opposed to explaining, characterizing, criticizing, comparing the prior art
- Question to EP/CN/JP counsel: how much background is needed in your jurisdiction, really?

D. Common substantive problems found in EP/CN/JP applications

- Extensive discussion of the technical problem to be solved and the technical advantages of the invention (“inventive features”)
 - In the US, the claims may be narrowly construed to cover only those embodiments that solve the discussed problem or have the recited technical advantages.
 - The discussion of the “inventive” features may be read into the claims to narrow the claim scope, even if the claims are broadened, e.g., via amendments.
 - **But** discussion of these is now advantageous to rebut 101 rejections (e.g., computer program inventions) and 103 rejections. Still, the discussion should be in general, non-absolute terms.
 - Question to EP/CN/JP counsel: how detailed or specific (absolute) should the discussion be in your jurisdiction?

Thank you!