

# Tips for US applicants at the EPO

The EPO's strict rules on amendments and added matter can be frustrating for US applicants. However many of the nuisances and annoyances experienced by US applicants at the EPO can be reduced or even avoided.

The pointers outlined below give some ideas on how US applicants can save time and money during prosecution and, in some cases, improve their chance of obtaining the broadest patent protection for their invention.

## Claims - content

Both Europe and USA allow claims of broadly similar types: apparatus, methods, kits, etc. However, there are some things that can be claimed in USA that cannot in Europe. For instance, there are statute bars in Europe against patenting methods of medical treatment by surgery or therapy, diagnostic methods, computer programs, mathematical methods, business methods, presentations of information and aesthetic creations.

Whilst these statute bars should very much be considered when drafting claims for Europe, it is important to bear in mind that they are narrowly applied. The exclusion against computer programs, for example, does not mean that a computer readable medium embodying instructions to perform a novel and inventive (technical) computerised method cannot be patented. Similarly, the exclusion against methods of medical treatment does not mean that products for use in medical methods cannot be patented - there is an explicit statement in European law which says they can.

Indeed, some claim types are allowable in Europe, which may not be in USA. Examples of these would be 'Product X for use in the treatment of disease Y', (second medical use) and 'Product X for use as a medicament' (first medical use claim). Such medical use claims are driven by the exclusion against patenting of methods of treatment or diagnosis, and essentially provide applicants with a loophole to protect known products for a new use. Similarly, it is also sometimes possible to claim the use of a known product to achieve a new non-medical effect, whereas in the USA this would need to be presented as a method claim with at least one method step.

It is good practice in US claim drafting to positively recite structural features, followed by the definition of how the various integers interact. In Europe the claim structure can be a little more fluid, but a US type apparatus claim will be perfectly acceptable in Europe (although see note later on the two-part form).

## Claims - form and fees

The EPO has a number of quirks when it comes to claims, including claims fees, multiple dependencies and a dislike of excess independent claims.

- Claims fees are charged for each claim in excess of 15. At present, the official fees are €235 each for the 16th to 50th claims and €580 for the 51st and each subsequent claim. With official fees at these levels, it is often worth taking time to reduce the number of claims that are presented to the EPO when entering the European regional phase, or when the EPO gives you the option to make voluntary amendments a few months later.
- There are no fee penalties for a high number of independent claims in Europe. However, there may be clarity and/or unity issues with these, and so it can be worth considering whether all the independent claims are appropriate despite the lack of fee penalty (see below).
- Reducing the number of dependent claims can often be relatively straightforward because the EPO allows multiple dependent claims (i.e. claims which depend from more than one earlier claim). The EPO also permits multiple dependent claims to depend from other multiple dependent claims - there is no fee penalty for doing this.
- If multiple dependencies alone are not sufficient to reduce the claims fees to affordable levels, then there are other tactics which can be used, such as Markush groups, combining several dependent claims together as options within a single claim, or including the features of one dependent claim as "optional" or "preferable" features in another.
- As discussed above, some types of claim are not patentable at the EPO (methods of surgery, for instance). There is generally little benefit to paying fees to maintain claims to statute-barred subject matter in an application if it is certain that they will need to be deleted later. It is thus worth considering on filing whether any such claims should be deleted prior to paying claims fees.
- Claims fees are only payable on filing and on grant. Therefore combined claims can be separated out during examination without incurring additional fees. It is only if the number of claims at grant exceeds the number of claims on filing that further claims fees must be paid. Reducing the number of claims on filing thus often results in a total saving overall, as well as being cost effective in the short term.

### More than one independent claim- is it a problem?

The EPO will object to an application that contains more than one independent claim in the same category (apparatus, method, etc.) unless the claims fall into one of the three very narrow legal exceptions to this rule. The exceptions are: (a) the claims cover interrelated products (e.g. a plug and a socket), (b) the claims cover different uses of a product, or (c) the claims cover alternative solutions to a problem which cannot be claimed in a single claim. It is very rare for the EPO to agree that any of these exceptions apply.

In ex-PCT cases if an application includes more than one independent claim in a given category on filing (e.g. three independent product claims), the EPO will generally issue an official action requesting that the applicant indicate which of the independent claims the EPO should search. That is, in many cases the EPO will not even search excess independent claims, meaning that those unsearched claims will need to be deleted during prosecution. It can thus save time and money to settle on a claim set on filing which only includes one independent claim in each category.

"In each category" is important, because the EPO generally *will* allow independent claims to both a method and a system in one application, so long as both claims relate to the same invention.

Divisional applications can be filed for deleted claims if required.

### What is the two-part form?

*The EPO prefers independent claims to have a "two-part form". This involves splitting the claim into two parts: a first part setting out the features of the invention found in a single prior art document, and a second "characterising" part setting out the inventive features.*



*Applicants can often be reluctant to use the two-part form. It can feel uncomfortable to admit prior art in the pre-characterizing part of the claim. It is also important to remember that the pre-characterising part of the claim is still part of the claim, and does limit the scope of protection.*

*We have found that it is often possible to argue against the use of the two-part form on clarity grounds (i.e., its use would result in a confusing claim), or on the ground that the prior art is already identified in the description. We therefore often suggest making amendments to the description to identify the prior art rather than amending the claims in response to a two-part form request.*

## Amendments and added matter

A 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. The EPO takes this rule very seriously. When making amendments it is necessary to specify where in the application as filed there is support for the amendment. If the requested amendment does not reflect the exact wording of the part of the specification which is offered as support then typically the EPO will object. Using exact wording is not actually a requirement of European law (the test is whether the amendment is clearly and unambiguously derivable from the application as filed), but European examiners interpret the added matter rules strictly, and using exact wording, if possible, will make prosecution easier.

Failure to provide any support for amendments will often result in an official action being issued which defers further examination until support is provided. It is therefore important to consider added matter carefully when making amendments and, if possible, when drafting the application at the outset.

One area that can be particularly problematic is claiming combinations of features that were disclosed in the as-filed application, but only in combination with other features. For example, if the description shows an embodiment with features a, b, c, d, e and f and no indication as to which are essential and which are non-essential, under EPO practice an applicant would find it difficult to isolate just some of the combined features without the others in the claims. That is, unless there is a basis in the text for indicating that features a, b and c, for example, can be combined independently of features d, e and f, the EPO will object to an attempt to claim only features a, b and c (and delete features d, e and f) as adding subject matter.



It can often be difficult to escape such added matter traps by the time substantive examination has begun. Considering the EPO rules on added matter whilst drafting can help to avoid such problems later. For instance, including statements of invention to all of the potentially important features mentioned in the specific description can provide support for introducing a feature into a claim separately from any other.

Bear in mind though that some EPO examiners can be awkward about the word "embodiment" when it is used in the specific description. It is often better to reserve the word "embodiment" for the statements of invention only, and use the word "example" in the specific description instead.

A final added matter issue to bear in mind is known as the Art 123(3) trap. This comes into play after grant, usually during opposition proceedings, but can also be relevant during revocation actions in national courts. Added matter is a ground for revocation under European law. However, Art 123(3) EPC states that the scope of a claim cannot be broadened after grant. The Art 123(3) trap comes into play when an amendment was made to the claims during examination which, after grant, is found to be unallowable for adding matter. In that case, standard European law would require the amendment to be deleted in order to remove the added matter. Art 123(3) would prevent the deletion however, as it would extend the protection conferred by the patent as granted. This can result in a patent being incurably invalid, meaning revocation would be unavoidable. For this reason all amendments during examination should be carefully scrutinized for potential added matter, even those which are not explicitly objected to by the examiner.

## Unsearched subject matter

A final point on amendments that is worth noting concerns unsearched subject matter. The EPO will object to claims which relate to unsearched subject matter. For instance, if an amendment is made which introduces unsearched subject matter into a claim or a new claim is presented that concerns an unsearched invention, then the EPO will refuse to allow that amendment on the ground that the subject matter has not been searched.

This is most often an issue where an application originally included multiple independent claims, only one of which was searched - it is not possible during substantive examination to go back and get an unsearched independent claim searched. The only way to obtain protection for an unsearched invention at the examination stage is to file a divisional application. It is therefore worth taking the time to get the claims right on entry to the European regional phase.

## Common formal issues

Some formal amendments come up regularly, and considering these when drafting can save cost during prosecution.

- The EPO expects to see reference numbers in the claims, and they are not limiting to the scope of the claims. Unless there is a good reason not to include them it is usual to include reference numbers.
- Use of SI units is compulsory in Europe. Non-SI units can be used as well if required (e.g. placed in parentheses after the SI units), but if only non-SI units are used the EPO will request that they be replaced. Doing this at the outset, i.e. during drafting, could save time and money as compared with doing it in response to a later EPO official action.
- The EPO does not like to see general statements relating to the “spirit” of the invention, because it is felt that such statements make it unclear what it is that the applicant considers the scope of his invention. Accordingly, the EPO will insist that such statements are excised from a specification before it will grant a patent.
- EPO examiners often request that the words “hereby incorporated by reference” are removed from a specification before it will grant a patent. Subject matter which is incorporated into a patent application in this way generally won’t be accepted as support for an amendment introducing a feature that is disclosed in the reference document but not in the application itself, particularly if that feature is being taken in isolation from a particular embodiment disclosed in the reference document. If there is a chance that the content of the reference document may be needed to provide support for amendments, then the safest thing to do would be to draft the would-be European patent application to explicitly include the relevant material cited in the reference document.
- Excess pages fees apply for applications that have more than 35 pages. Also, some European countries still require a full translation on grant. Thus the longer your application is, the more expensive it will be to translate.

## Inventive step - a whirlwind guide

The EPO’s standard approach to inventive step is known as the problem and solution approach. This involves formulating a problem with the state of the art based on the differences between the claimed invention and a single “closest” prior art document, and then deciding whether the solution to that problem provided by the claims of the patent application in question is obvious. This approach is somewhat formulaic, but following it can often be the best way to respond to obviousness objections at the EPO.

The EPO’s fondness of the problem and solution approach means that it will often be more responsive to arguments that point out an advantage provided by the invention over the prior art than to arguments which simply identify the features which do not appear in the prior art. Unlike the US PTO however, the EPO can be reluctant to combine a large number of documents when attacking a claim - arguments that a cited document originates in an unrelated field and so would not be considered by the skilled man can be more effective in Europe than in USA.



In the case of inventions including a mixture of technical (i.e. potentially patentable) subject matter, and subject matter which the examiner considers to be “non-technical” (i.e. statute barred), the EPO’s current approach is to ignore any allegedly non-technical features when applying the problem and solution approach, on the ground that non-technical features cannot contribute to inventive step.

## Further hints & tips

In the case of inventions including a mixture of technical (i.e. potentially patentable) subject matter, and subject matter which the examiner considers to be “non-technical” (i.e. statute barred), the EPO’s current approach is to ignore any allegedly non-technical features when applying the problem and solution approach, on the ground that non-technical features cannot contribute to inventive step.

- **Assignments** need two signatures at the EPO and ideally the name and position of the signatories. Poland can be especially awkward about the signatory having to right to act on behalf of the company – it’s worth checking if you’re assigning in Poland.

- **Assignment of right to claim priority between provisional application and PCT filing** – the Paris Convention gives a priority right for the same invention to the same applicant, or their successor in title. If the applicant for the PCT is different from the provisional, did they have the right to claim priority at the filing date of the PCT? If not, the priority claim is bad and probably can't be fixed. This is most problematic when the PCT is filed in the name of a third party, arms' length company (i.e. a putative licensee) before a deal has actually been done. The Edwards vs Cook UK court case covers this. The issue is less common now that the AIA allows the provisional to be filed directly in the company name.
- **Design patents and representations** – the EUIPO only counts the first seven representations of any design as determining the registered design. Therefore, it helps if you order the drawings to show the views that matter in the first seven, or only file seven drawings per design. An application can have multiple designs and it is less expensive to have a six design application than six separate applications.
- **Refunds of official fees at the EPO** – you can get back all or some of the search and exam fees if the application is abandoned before the EPO does the relevant work.
- **Extensions of time at the EPO** – two months extension are often available for an official action with no official fee, but not always. It depends on the type of office action. Further processing, which could be considered to be a paid for two or three month extension, is available on some office actions but not all.
- **Correcting errors** – this can be done, with proof of what the correction should be. In the patent specification, the reader needs to be able to self-correct when reading it, and then the error is correctable. If the reader can't tell what the correction should be, then it won't be possible.

### **Don't want to be a European attorney? Don't worry!**

While it can often be cost effective to consider the issues above when drafting, it is by no means essential. We regularly review claim sets for our US clients and can propose amendments to reduce the total number of claims, either on entry to the regional phase (if there is time) or when offered the chance to file voluntary amendments by the EPO a few months later. We can also advise on the likelihood of objection to any multiple independent claims or statute barred subject matter, and can of course provide input on the problem and solution approach and added matter at any stage during prosecution.

All our European attorneys have many years' experience of dealing with all the issues outlined above (and many more). If you have a specific question or concern, please ask your usual Barker Brettell attorney or call +44(0)121 456 0000.