
Guidelines to Avoiding Difficulties at the European Patent Office

Applications being prepared for filing in national Patent Offices, to found a priority date, or for filing by way of the International (PCT) system, as well as cases for filing first in the European Patent Office (EPO), may all ultimately be prosecuted in the EPO.

Prosecution in the EPO uses strict standards of inventiveness and may involve very technical objections. In addition, courts in Europe, particularly the English High Court, revoke a disproportionate number of European patents for technical reasons, for example, because subject matter was deemed to have been added during prosecution.

To minimise, or even avoid, such problems, the initial application needs to be prepared with care. There follow the Beck Greener guidelines and checklist developed by the participants of the firm's Management Meeting. Use these guidelines to ensure that all necessary issues are dealt with when European patent applications are being prepared.

Inventors

- The inventors named on a European patent application should be the actual devisers of the invention. These may be different from the authors of a related academic paper.
- The EPO needs to know a current correspondence address for each inventor. This is often the inventor's home address, but a business address can be given if preferred.
- It is recommended that inventors be identified at an early stage, and that any possible disputes are found and dealt with.

Ownership

- Ownership of a European patent application is determined under the inventor/applicant's local law rather than under European patent law.
- Where the owner of a European patent application is not the applicant, their right to the invention is normally obtained via employment or assignment.
- Formal assignments should be executed by all parties for each case to ensure that the applicant is entitled to ownership of the application. This is particularly important where a priority application has been made in the name of the inventor(s).
- In accordance with the International Convention, it is essential to have an assignment executed before applications which claim priority from earlier cases, for example PCT applications, are filed. If this is not done, the right to ownership may be irretrievably lost. If this is not possible, it may be necessary to file a priority-claiming application in the name(s) of the inventor(s) or other original applicants. Ideally, in every case where the applicant is not the inventor, an assignment should be executed before the very first application is filed.
- An assignment should include assignment of the right to claim priority, as well as the right to the invention and any patent applications.
- It is important to check very carefully that the applicant entity has been correctly identified, especially where the applicant is part of a multi-national company with various subsidiaries. This is particularly important when the applicant obtains the right to the invention via employment of the inventor(s). In such cases, incorrect identification of the employer entity could lead to loss of rights.

Priority

- Priority claims in European patent applications must (with very limited exceptions) be made within 12 months of the earliest application for the subject matter in question. Difficulties are likely to arise when claiming priority from a United States continuation-in-part application.
- Priority claims in European patent applications will in general only cover subject matter which is explicitly included in the priority application. To be sure that this applies, the subject matter should have word-for-word basis in the priority application. Thus, it is important to include independent claims or statements of invention, as well as fallback positions, in the priority application.
- Where the text of a priority-claiming application differs from the text of the priority application, it is useful to prepare a summary of the changes which have been made, for example in the form of a tracked changes version of the text.
- Where a priority application is abandoned and refiled to establish a new priority date, it is essential that no rights from the first application are left outstanding, and that the application is refiled in the same country as the first application.

Novelty

- The EPO applies an absolute standard of novelty. This means that disclosures made anywhere in the world, by any means (including use and verbal disclosure) are citable as prior art.
- Before the EPO, prior art originating with the inventor or applicant is treated in the same way as prior art from any other source.
- Under European law, only very limited grace period provisions apply. These may be relevant where a malicious disclosure of the invention has been made or where the invention has been shown at certain international exhibitions.
- Under European law, earlier European patent applications which are unpublished at the priority date are in principle citable for novelty but not inventive step purposes. Again, this applies whether or not the earlier application originates with the inventor or applicant.
- Certain types of claim are interpreted in particular ways under European law, and this may lead to unexpected novelty objections. In particular, product-by-process claims are interpreted to cover any product that could be obtained by the specified process, whatever the history of the product. Claims in the form “Apparatus for...” are in general interpreted to cover any apparatus suitable for the stated purpose, whether or not such a purpose is disclosed.
- There is detailed European case law on novelty in particular situations including overlapping numerical ranges, selections from lists, newly isolated natural products and new medical indications.

Inventive Step

- The EPO applies the “problem/solution” approach. When drafting an application which will be prosecuted before the EPO, it can be helpful to include a statement of the problem which the invention seeks to address and the solution provided by the invention.
- It can also be very helpful to include evidence in the application that the stated problem is solved. Such evidence can be presented separately at a later stage, but this is less likely to be successful. Ideally the evidence should show that the problem is solved across the whole scope of the claim.

Patentable Subject Matter

- Major categories of subject matter which are excluded from patentability before the EPO are as follows:
 - business methods
 - computer programs
 - certain plant or animal varieties and essentially biological processes for the production of plants or animals
 - methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body
- In some cases it is possible to obtain patent protection for such inventions provided that claims are drafted in a particular format. Such claims should be included on filing.

The Ideal Specification

The following is a summary of features of an ideal specification for prosecution before the EPO. It is very important to draft the specification correctly because of the strict added subject matter standard applied by the EPO. In many cases, problems cannot be corrected by amendment after filing.

- The specification should ideally describe and claim one invention (although in certain cases it may be worth including a second invention which would not merit filing a separate patent application).
- Claims fees are payable over 15 claims, and are very high where there are more than 50 claims. Thus, there should ideally be no more than 15 claims.
- The claims should not normally include more than one independent product claim or more than one independent process claim.
- Alternatives within a claim are permitted.
- Independent claims should contain no inessential features.
- Each dependent claim should add a feature which is thought to be independently novel and inventive. Dependent claims which specify only a result to be achieved are unlikely to be acceptable.
- Dependent claims should provide a sequence of progressively narrower fallback positions (so-called “intermediate generalisations”).
- Multiple dependencies can be used, but basis for adding such dependencies must be identified in the text of the application as filed.
- It may be useful to include additional statements of invention in the description as basis for amended claims.
- Relative terms e.g. “lower alkyl” should be avoided or defined.
- Metric units should be included in the text. Where they have been converted from non-metric units, the metric units should appear in parenthesis.

Amendment

- The EPO takes an exceptionally strict approach to the question of added subject matter. Ideally, word-for-word basis should be identified for any amendments in the text of the application as filed. When filing amendments at the EPO, identify and file details of such basis.
- It is particularly important to avoid making a limiting amendment which adds subject matter because of the prohibition of post-grant broadening. Where such an amendment is made, a situation can arise after grant where a limitation cannot be maintained because it adds subject matter, and cannot be deleted because the claim would be broadened. In such cases, claims can be held to be incurably invalid.
- It is not in general possible to amend an application to include previously unsearched subject matter.
- It is particularly helpful to obtain details of any commercial product, and comments on the scope of claim needed for useful protection, so that this can be taken into account when making any amendments.

Divisional applications

- When filing a divisional application, it is recommended that all subject matter in the parent application as filed be retained. This is useful in cases where further divisionals are needed.
- When filing a divisional application, it is important not to add subject matter to the text of the parent application as filed. This means that the claims of the divisional application need to be very carefully drafted.
- Where subject matter is claimed in both a parent and a divisional application, the EPO will in some cases raise a double patenting objection. Note that the law in this area is still developing.
- From 1st April 2010 all divisional applications from a parent have to be on file within 2 years of the first communication from the EPO Examining Division.

PCT Issues

- When filing a PCT application, at least one applicant must be a resident or national of a PCT contracting state.
- The correct Receiving Office for a PCT is determined by the residence or nationality of the applicant(s). Any applicant can file a PCT application at the International Bureau of WIPO as Receiving Office. However, even where the International Bureau acts as Receiving Office, the representative must be qualified to act before the National or Regional Patent Office of at least one applicant. Thus, where all applicants are European, it is not possible for a non-European attorney to act as representative during the International Phase.

- Where there is a choice of International Searching Authority, different Searching Authorities are likely to give different results in terms of cost, quality of search and time taken for search. This is partially dependent on the technical subject matter.

Checklist before filing a European application

- Are formal assignments in place?
- Are there a maximum of 15 claims including no more than one independent product claim and one independent process claim?
- Where the claims have been amended, does each claim have indicated word-for-word basis in the text of the application as filed?
- Does the specification include word-for-word basis for fallback positions?
- Does the specification identify the problem addressed by the invention and provide evidence that the problem has been solved?
- Where there are non-metric units, have metric equivalents been included in parentheses?

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