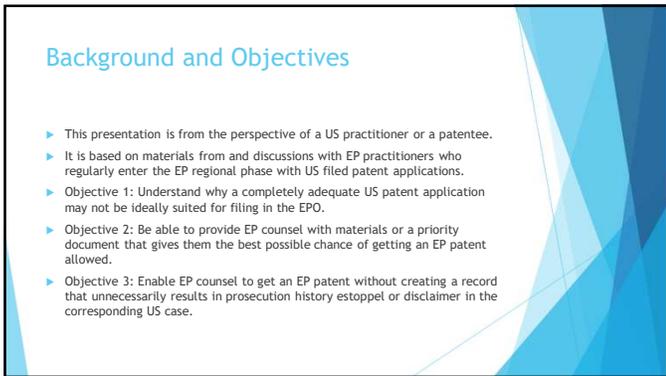
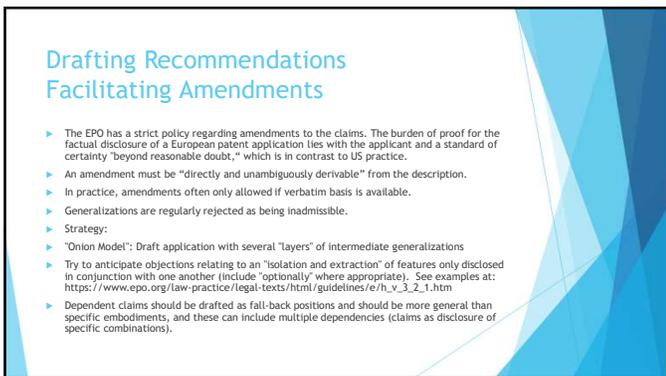




1



2



3

Claim Drafting

- ▶ In General
 - ▶ Draft broad independent claims in all categories.
 - ▶ Draft dependent claims providing fallback positions and achieving technical effects beyond the effects of the independent claims.
- ▶ Intermediate Generalization
 - ▶ From the perspective of some EP counsel, US style applications often lack this "layer."
 - ▶ Use claim-like language to more generally describe concepts of preferred embodiments.
 - ▶ Support important terms and features in view of possible future clarity objections.
- ▶ Specific Embodiments
 - ▶ Describe technical effects and advantages associated with the claimed subject matter.
 - ▶ Non-mandatory features should be described as optional. Anticipate objections regarding an inadmissible "isolation and extraction" of features.

4

Drafting recommendations to avoid objections of lack of clarity

- ▶ EPO adopts a strict standard regarding clarity of the terminology used in the claims that differs considerably from the USPTO.
- ▶ While lack of clarity is not a ground for opposition, Examiners often raise clarity objections during examination proceedings, and rich dependent claims help the applicant avoid clarity challenges during opposition if amendments can be taken directly from dependent claims.
- ▶ Literal consistency between the claims and the description (including the examples/figures) is a best practice.
- ▶ Most clarity objections can be avoided by appropriately drafting the application.

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More on Clarity

- ▶ Provide literal support for all important terms used in the application, in particular all terms used in the claims.
- ▶ Ideally, explanations of terms should be claim-like.
- ▶ Explain terms in a functional manner.
- ▶ Provide alternative wording and explanations of important terms in the description, ("In other words, ...")
- ▶ Avoid relying on vague terms (e.g. thin, small).
- ▶ Use terminology consistently throughout the application.
- ▶ Avoid using different terminology in claims/description.
- ▶ Avoid inconsistencies arising from inaccurate translations.

6

Inventive Step

- ▶ Inventive step at the EPO will be assessed using the “problem-and-solution approach.”
- ▶ In this approach, the technical effects/advantages of distinguishing features are of significant importance.
- ▶ When arguing inventive step before the EPO, the applicant needs to be able to explain the technical effects and advantages of the claimed subject-matter convincingly.
- ▶ The objective technical problem will be formulated in view of the technical effects and advantages of the distinguishing features.
- ▶ Describe in detail all technical effects and advantages of the distinguishing features.
- ▶ To the extent possible, when including technical effects and advantages, attempt to draft the description in such a way as to minimize detrimental impact on a parallel US application. Hat tip to US practitioners from our EP colleagues.

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More on Inventive Step - Computers

- ▶ Inventive step for computer-implemented inventions can only be based on “technical” features providing a technical solution to a technical problem.
- ▶ Non-technical features such as administrative or business aspects cannot contribute to inventive step.
- ▶ Strategy:
 - ▶ Describe the invention from an “implementation perspective.”
 - ▶ Describe in detail all technical aspects of the invention.
 - ▶ Avoid business aspects - even the words “business” or “cost.”
 - ▶ Implementation of the business aspect on a computer might nevertheless contain technical considerations supporting an inventive step.
 - ▶ Mentioning technical considerations might be decisive.

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Procedural Practice Pointers

- ▶ For applications entering the EP phase well before the 31 month deadline, explicitly request early processing under Art. 23 PCT
- ▶ (Waive 161 Right)
- ▶ For EP phase applications, consider waiving the right to receive the communication under R. 161 EPC
- ▶ If right to communication under R. 161 EPC is not waived, file brief response to R. 161 EPC communication requesting that the EPO start drawing up the EESR
- ▶ (To mitigate effects of possible lack of unity objections)
- ▶ In case of lack of unity, the EPO will draw up the search report for the first invention mentioned in the claims
- ▶ In order to ensure that the most important invention will be searched without payment of additional search fees, reorder the claims so that most important invention is the first invention mentioned in the claims

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Procedural Practice Pointers - Claims

- ▶ Reduce number of claims to 15 if possible:
- ▶ EPO charges high claim fees of EUR 235 for the 16th and each subsequent claim.
- ▶ Attempt to reduce the total number of claims to around 15 in order to avoid payment of excessive claims fees.
- ▶ Independent claims:
- ▶ Generally, only one independent claim per claim category is allowed (product, process, apparatus or use), R. 43(2) EPC.
- ▶ Unless one of the exceptions listed in R. 43(2) (a)-(c) EPC is applicable, file only one independent claim per category to avoid a (costly) time delay resulting from an unnecessary communication under Rule 62a EPC.

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Prosecution and Impact on US Case

- ▶ After the best practices above have been applied, our EP colleagues will nevertheless still most likely need to present arguments to the EPO regarding patentability.
- ▶ The problem-solution approach, step 1: "determining the closest prior art."
- ▶ Such a determination should be made carefully as while this is merely the starting point for an analysis with the EP examiner, nevertheless it could potentially result a factual admission by the patentee regarding the state of the art, which can result in prosecution history disclaimer.
- ▶ The Federal Circuit cautions against "indiscriminate reliance" on foreign prosecution: *AIA Eng'g Ltd. v. Magotteaux Int'l S/A*, 657 F.3d 1264, 1279 (Fed.Cir.2011) especially when statements relate to different foreign legal standards.
- ▶ Nevertheless, the Federal Circuit held that the ITC correctly considered statements made by the patentee before the EPO in prosecuting foreign counterparts when determining infringement: *Tanabe Seiyaku Co. v. ITC*, 109 F.3d 726, 733 (Fed.Cir.1997), especially relating to factual statements or blatant admissions that are relevant to prosecution history estoppel or disclaimer (rather than claim construction).

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Thank you!

Sources

- ▶ European Patent Office Case Law of the Boards of Appeal
 - ▶ <https://www.epo.org/law-practice/case-law-appeals/case-law.html>
- ▶ Müller Bore & Partner
 - ▶ <https://www.mueller-bore.de/law-firm>
- ▶ EP practitioner colleagues



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