

PACK SMARTER WHEN PREPARING A PATENT APPLICATION FOR EUROPE

Startup Blog Alert
August 9, 2016

Packing for a trip can be tricky. You need to plan for unexpected events, changes in the weather, and deviations from your planned itinerary. Drafting a U.S. or Patent Cooperation Treaty (PCT) patent application that may eventually turn into a European patent application is similar. Unwary U.S. applicants can draft a patent application well-suited for familiar U.S. rules that will encounter problems or complications at the European Patent Office (EPO).

There are ways to “pack” a U.S. or PCT patent application that make it easier to successfully file and prosecute before the EPO. Nathaniel Lucek recently posted a white paper (co-written with Phillip Sanger at Vault IP in the U.K.) that gives some packing tips. Here is a quick packing checklist.

- If your patent application includes software, take time to include some extra detail demonstrating that the inventive step is technical in nature, explaining any connections with hardware, and emphasizing how these details are related to your technical problem.
- If your patent application includes a business method, remember to include technical details about how the method operates, interactions with any hardware, and how the details of your method relate to your technical problem.
- If your patent application falls in the biotech space, be prepared to play by different rules. You may need to remove claims that aren’t allowed by the EPO. Prepare the U.S. or PCT application to have support for desired (and permitted) claim scope in Europe.
- Don’t list a component as “essential” or “necessary” unless it truly is. Otherwise, a European examiner may require this component be added to the claims.
- European patent applications are allowed fewer pages and claims before being subject to additional fees than their U.S. counterparts. To avoid additional costs, plan your claim support so that your desired claim scope fits into fewer claims.
- Including two independent claims of the same type (e.g., two apparatus independent claims) is generally not allowed in Europe. Draft a broader independent claim that covers both independent claims of the same type or be prepared for a divisional application.

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- Consider adding means-plus-function support in your specification, in claims of a PCT application, or exemplary claims in a U.S. provisional application. While not usually seen in the U.S., this claim style can potentially provide broad protection in Europe.
- Make sure all your features are positively claimed. Use the preamble, “configured to” language, or “arranged for” language to show interactions with unclaimed features.
- Try to provide explicit support in the specification for any fallback positions that may be used as future claim amendments.
- It can be difficult in Europe to amend a claim to include only part of an invention when it appears to be linked to other unclaimed components. Use details in a dependent claim or explanation in a specification to show that a particular feature can be used separately from the rest of the claimed invention or that the particular feature can work with any embodiment. Otherwise, a European examiner may request that the other components used with this feature be included in a claim amendment.
- Consider using multiple dependencies in a U.S. provisional application or a PCT application so that claim support exists when filing a corresponding European patent application.

Extra time packing your suitcase can mean the difference between a rewarding visit to Europe and a money-wasting disaster that is abandoned early. The same goes for patent applications. The minor tweaks to the specification and claims explained in the white paper typically will not add pages or impact U.S. prosecution. Some may even help prosecution in the U.S. or in other countries like China or Japan, which can justify any increased costs. If Europe is or may be a destination for your patent application, careful packing can streamline prosecution, save time, and reduce future attorney fees.