

Minimizing costs in Europe



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I. Minimizing filing costs

- Claims fees
- Excess page fees



1. Claims fees

- Official fee of \$300 for each claim over 15
- \$750 for each claim over 50
- Application with 35 claims attracts claims fees of \$6000
- 90 claims costs around \$40,000!
- What can be done?

Reducing number of claims

- Multiple claim dependencies
- “*Apparatus according to any of the preceding claims, wherein...*”

Reducing number of claims

- Multiple categories for dependent claims
- *“Apparatus or method according to any of the preceding claims, wherein...”*
- *“A computer program comprising code portions which, when executed on a processor, cause it to carry out the method of any of the preceding claims”*

Reducing number of claims

- Alternatives in one claim
- “*and/or*”
- “*preferably*”

Example



1. A cuddly toy with fur
2. A cuddly toy according to claim 1, wherein the fur is brown
3. A cuddly toy according to claim 1, wherein the toy is a bear
4. A cuddly toy according to claim 3, wherein the bear is a teddy bear

Example



1. A cuddly toy with fur
2. A cuddly toy according to claim 1, wherein the fur is brown and/or wherein the toy is a bear, and preferably a teddy bear.

Reducing number of claims

- Move subject matter to description
- Less important claims
- Claims containing subject matter which is in the prior art
- Note new post grant central limitation procedure

2. Page fees

- Official fee of \$18 for each page over 35
- 150 pages attracts page fees of \$2000
- Reformat text to fit more on one page
- Reduce font size (11 point)
- Excise unnecessary text
- Can also save translation costs later on

Page fees, cont.

- Note – page fees payable on entry into European regional phase based on International application *as published*
- Unless amended specification filed at time of entry

II. Minimizing Prosecution Costs

- Try to reduce number of office actions
- How?



1. Independent claims

- EPO normally only allows one independent claim in any one category
- Multiple independent claims may result in an additional office action
- Note – from April 2010 EPO will only search one independent claim
- Could limit available scope of protection

Reducing number of independent claims

- Try to include a single generic independent claim from the outset
- Means plus function language given a broad interpretation in Europe
- Re-write the narrower independent claims as dependent claims
- Multiple independent claims may be allowed for “interrelated products” (e.g. transmitter and receiver)

2. Formal matters

- Add reference numerals to claims on filing
- Use two-part form of claim
- Adapt description to claims
- *“According to a first aspect of the present invention there is provided an apparatus according to claim 1”*

3. Substantive matters

- Amend early to distinguish over known prior art
- Bear in mind differences in national laws (e.g. added subject matter; excluded subject matter)
- Provide basis for claim amendments

Note new rules from April 1, 2010

- Need to respond to search opinion when requesting substantive examination
- Need to respond to Written Opinion when entering European regional phase if EPO was ISA

III. Minimizing costs after grant

- Consider carefully where to validate
- Germany, France and UK all London Agreement countries,
- but many others are not
- Reduce amount of text to reduce translation costs in non-London Agreement countries

Other measures?

- UK and German national phases from PCT
- German/Italian utility models

