

M I C H A L S K I



H Ü T T E R M A N N

P A T E N T A N W Ä L T E  
D Ü S S E L D O R F • M Ü N C H E N

## **Dos and Don'ts in European Patent Prosecution**

A practical guide to achieving valuable patents and  
having success in infringement actions



## **Presentation focuses on practical advices in order to be in a good position for patent litigation**

- Patent prosecution before the EPO differs from other countries in multiple ways:
  - Not complying with the European practice hampers and delays the examination proceedings
  - If the application has not been prepared considering the Guidelines of the EPO or if an objection of the EPO is not addressed in the appropriate way, there might be a drastic reduction of scope of protection, if a granted patent can be achieved at all



## An „ideal“ EP application has:

- Not (many) more than 15 multi-dependency claims
- Not (many) more than 35 pages total incl. description, claims, abstract, figures
- All claims are literally listed in the description
- Explanation of each claim, terms of the claims, advantages of the claims and alternate embodiments of each claim
- Description of one problem to be solved as the object of the invention
- Figure description with same terms previously used and additional, more precise terms for exemplary embodiment
- Small prior art section in the introduction



## EP claims fees and multi-dependencies

- EPO charges claim fees of € 255 for the 16th and € 555 (!) for the 51th and each subsequent claim
- Thus, use multidependency claims or enter the European phase with multidependency claims
  - E.g. PCT has no multi-dependencies, but 20 claims: Amend claims for PCT-EP to 15 multi-dependency claims, but have disclosure for supporting the amendment!



## EP claims fee strategy

- Claim fees can be deferred to answering the Rule 161/162 EPC communication, around 6-8 months after PCT-EP entry
- Claim fees paid will not be refunded during examination, but claims can be added during examination (and paid at grant)
- Thus, reduce claims in order to avoid claim fees, but:

*“Amended claims [during prosecution] may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept” (Rule 137 (5) EPC)*



## EP claims – independent claims

- EPO is very strict in granting more than one independent claim in the same category (product, process, apparatus or use), except application relates to
  - a) a plurality of interrelated products,
  - b) different uses of a product or apparatus,
  - c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim
- No complying with this requirement may lead to rejection of the application since applicant has to present a grantable set of claims (e.g. main and auxiliary requests)



## Amending European Patent applications Compliance with Art. 123(2) EPC is key

- Rule 137(4) EPC has made it mandatory for applicants to indicate basis in the application as filed for any amendments made
  - i. an identification of the amendment and
  - ii. an indication of *specific* basis for the amendment in the application as filed
- Failure to comply may lead to the application being deemed withdrawn
- However, EPO is very strict in regard to amendments



## Amending European Patent applications //2 Compliance with Art. 123(2) EPC is key

- Example for identification:

*"basis for the amendment to line 5 of claim 1 can be found at page 4, lines 11-14 of the application as originally filed"*

- EPO Guidelines state that

*"non-specific indications such as 'see the description as filed' or 'see the claims as filed' or 'see the examples as filed'"*

is "improper basis" within the meaning of Rule 137(4) EPC



## Amending European Patent applications //3 Compliance with Art. 123(2) EPC is key

- Art. 123(2) EPC specifies that a

*“European application may not be amended in such a way that it contains subject matter which extends beyond the application as filed”*

- For complying with Art. 123(2) EPC, all amendments must be shown to be

***“directly and unambiguously” derivable from the application as originally filed“** G 1/06 (SEIKO)*



## Amending European Patent applications //4 Compliance with Art. 123(2) EPC is key

- In practice, the EPO often insists that the amendment must have literal basis (word for word basis) in the application as originally filed
- Where an amendment does not have literal basis, it can often be very difficult (but not impossible) to persuade the EPO to allow the amendment
- The EPO's test is widely considered to be much more strict than the USPTO and the JPO, for example
- So, amendments which are allowable elsewhere may not necessarily be allowable at the EPO



## The “is it essential?” test for Article 123 (2) EPC

- The so called “is it essential?” test has been developed by case law for evaluating whether the deletion of a feature from a claim is allowable in view of Article 123 (2) EPC
- Replacement/removal of a feature from a claim may comply with Article 123 (2) EPC if the skilled person would directly and unambiguously recognize that
  - 1) the feature was not explained as essential in the disclosure,
  - 2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and
  - 3) the replacement or removal required no real modification of other features to compensate for the change



## Intermediate generalisation - non-disclosed combinations

- **Problem:** Incorporation of a feature into a claim when this feature is only disclosed in combination with other features, i.e. in a preferred embodiment/working example
- **EPO:** A feature taken from a working example may be combined with other features disclosed in a more general context without necessarily creating an objectionable intermediate generalization only if the man skilled in the art could recognize without any doubt from the application as filed that those characteristics were not closely related to the other characteristics of the working example and applied directly and unambiguously to the more general context
- **Advice:** Have a broad general part of the description where each feature is described on its own and to be combineable with the other features



## The „inescapable trap“

- European patent contains a feature not disclosed in the application as filed (i.e. contravention of Article 123(2) EPC)
- Removal of said feature in opposition procedure would extend the scope of protection beyond the scope conferred by the patent as granted (i.e. contravention of Article 123(3) EPC)
- For such case, the European patent has to be revoked by the EPO (!)
- It does not matter if the examiner approved the amendment during prosecution; responsibility for amendments remains with the applicant!



## No „inescapable trap“ in Germany

- GPTO and German patent courts allow incorporation of a disclaimer in case if feature was not originally disclosed
- Disclaimer:
  - the feature not originally disclosed may not considered to delimit the invention from the prior art, however
  - the feature not originally disclosed has to be considered for assessing the scope of protection



## EPO: Disclaimer for „accidental anticipation“

- A disclaimer may not be considered to be added subject matter if the disclaimer restores novelty by delimiting a claim against an accidental anticipation
- An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention
- A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure is considered to constitute added subject-matter



## EP claims – unity of invention

- „Avoid“ objections in regard to unity of the invention: Do not prosecute more than one invention per application:
  - Non-patentability of claim 1 might lead to non-unity objection a posteriori in search phase, i.e. additional search fees become due
  - Avoid non-unity objection a posteriori by conducting a prior art search before filing and by restricting the claims according to the prior art identified - don't be too broad!
- Provide the sub claims in an order of most preferred embodiments



## Non-unity a posteriori – an example

- Independent Claim 1: Product comprising A and B.
- Dependent Claim 2: Product comprising A , B and C.
- Dependent Claim 3: Product comprising A, B and D.
  
- A product comprising feature A and B is known from the prior art or does not comprise an inventive step.
- The EPO therefore raises an objection of lack of unity between claim 2 and claim 3 since two different inventions are claimed, i.e. combination with C or with D, respectively.
- As a result, claim 2 is searched, while claim 3 requires a further search fee or is not searched at all (for Euro-PCT).



## Non-unity a posteriori – an example //2

- During prosecution, claim 1 was amended to incorporate feature D
- The combination of features A, B and D found clear and unambiguous basis in the description as originally filed
- Nevertheless, an objection under Rule 137(5) EPC was raised, and later maintained, on the basis that feature D related to unsearched subject-matter because claim 3 was not searched



## EP claims

### Other points to consider for speeding up examination

- Use reference numerals in the claims, they will not restrict the scope of protection
- Avoid „preferably“, „in particular“, etc. in the claims, use regimes (e.g.  $80 \leq \text{angle} \leq 100$ ) instead
- Use two part form of the claims, this will not restrict the scope of protection (some exceptions might apply to method claims)
- Alternate expressions can make the application unclear and usually do not help to broaden the scope of protection, instead be clear and describe what else is meant in clear terms
- „Incorporation by reference“ not possible for EP and needs to be removed



## Claims fees - example

- English PCT application with 70 claims; client wants to file nationalize PCT in Germany
  - Claim fees have to be paid for 60 (!) claims, around € 1200
  - Full translation has to be provided in German language (e.g. € 1000 for 4000 words)
- For such case, an EP becomes far more attractive:
  - Generally, EP is „cheaper“ if client wants to file in three or more European countries, sometimes even for two countries, due to reduced translation costs and possibility to amend claims on EP entry



## EP description and page fees

- Page fees apply (only EPO) for the 36th and subsequent page of € 14 per page
- Regardless of the language of EP publication, the page fee is based on the PCT as published (e.g. in JP language)
- Amended claims, under Article 19/34 PCT and/or filed for the European phase, and/or amended description is/are also taken into account, unless the applicant has indicated that the procedure in the European phase is not to be based on them
- Thus, not much for a few pages, but 100 page application has already around € 900 page fees

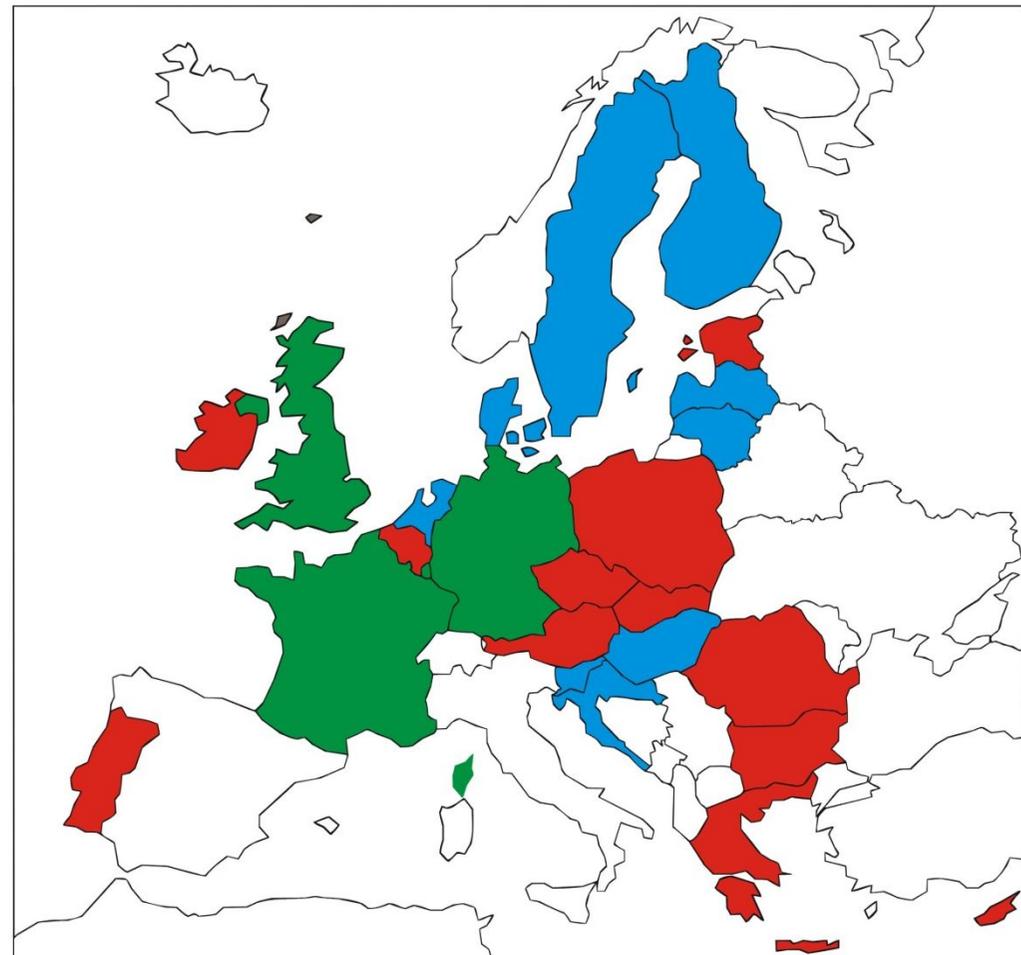


## Validation strategies - where to validate and whether to utilize unitary patent (UP) system

- EP versus UP (colored countries):

- No translation ...
- Claim translation ...
- Full translation ...

... for classical EP validation





## Validation strategies //2

- UP Annuities rather high (member states' income from annuities should not change versus today)
- No „reduction“ of countries possible with UP during patent duration
- But, at some point additional countries are free of charge for UP due the “marginal cost effect”
- So, what is the recommendation?



## Validation strategy – today and in the future

- EP traditional validation rather attractive by less than 5 countries, small description and „reduction“
- UP rather attractive for many countries with full translation, long description, short duration or long duration without „reduction“
- However, UP is not only about costs:
  - UP bound to UPC: Better options against infringers in some countries as plaintiff can be filed in different country than infringement e.g. Düsseldorf



## Effects of cross boarder e-Commerce

- While, e.g., Japan and Switzerland define an international exhaustion, in the European Union, the free movement rules of Articles 28 and 30 of the EC Treaty mean that patent exhaustion cannot be limited to individual jurisdictions in which a patent is granted but must extend to the whole of the European Union (regional exhaustion)
- A patent which has been issued in one EU Member State shall be exhausted if that product is sold in any other Member State, provided that the initial sale took place with the consent of the patentee



## **Excursus: Cross border injunctions**

**Future:** Unitary patent allows for injunctions for all member states

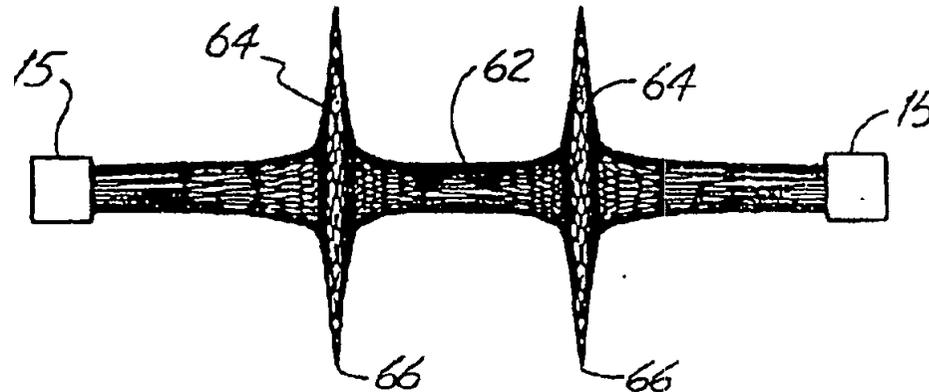
**Today:** Patents only country by country, however, EU regulations for trademarks (CTMs) and designs allow for EU-wide injunctions if legal action is taken in a country where the opponent has its place of business or at least a subsidiary

**Example:** Apples request for preliminary injunction against Samsung's Galaxy Tab 10.1 in 2011 in Düsseldorf



## Decisions relating to patent drafting: BGH Occluding Device

Infringement in a literal sense or under the doctrine of equivalence



The claim:

- Clamps are provided at the opposed ends of the device

The alleged infringement:

- A single clamp is provided at one end of the device



## BGH Occluding Device (continued)

The Higher District Court:

- Patent infringement affirmed
- Clamps (plural) is a generic name and not to be understood literally
- The literal sense would be “a clamp where required”



## BGH Occluding Device (continued)

- Claim construction:
  - Description
  - Figures
  - Prior art mentioned in and on the patent document
- Description: Embodiment with one clamp
- However: This embodiment is not part of the claim
- Federal Supreme Court: no literal patent infringement

Embodiments which are not encompassed by the literal sense of the claim may not be used for claim construction



## BGH Occluding Device (continued)

- Patent infringement under the doctrine of equivalence requires equivalent substitute means
  1. which has the same function,
  2. which can be found by the man skilled in the art without inventive activity on the basis of the patent description and the prior art, and
  3. which is consistent with the general idea of the invention
  
- Federal Supreme Court: Precondition 3 not fulfilled



## **BGH Occluding Device (continued)**

No patent infringement under the doctrine of equivalence since

- the idea (one single clamp) is disclosed in the patent, but
- has not become part of the subject-matter of the claim.

Advice: Thoughtful drafting of claims and description:

**“Less can be more”**



## BGH Diglycide Compound

### Infringement under the doctrine of equivalence only if

“Occluding Device” is fulfilled, and

-if the differences between the subject-matter of the claim in a literal sense and the other embodiments in the description which are not part of the claim

-are generally the same as

-the differences between the equivalent use and the other embodiments



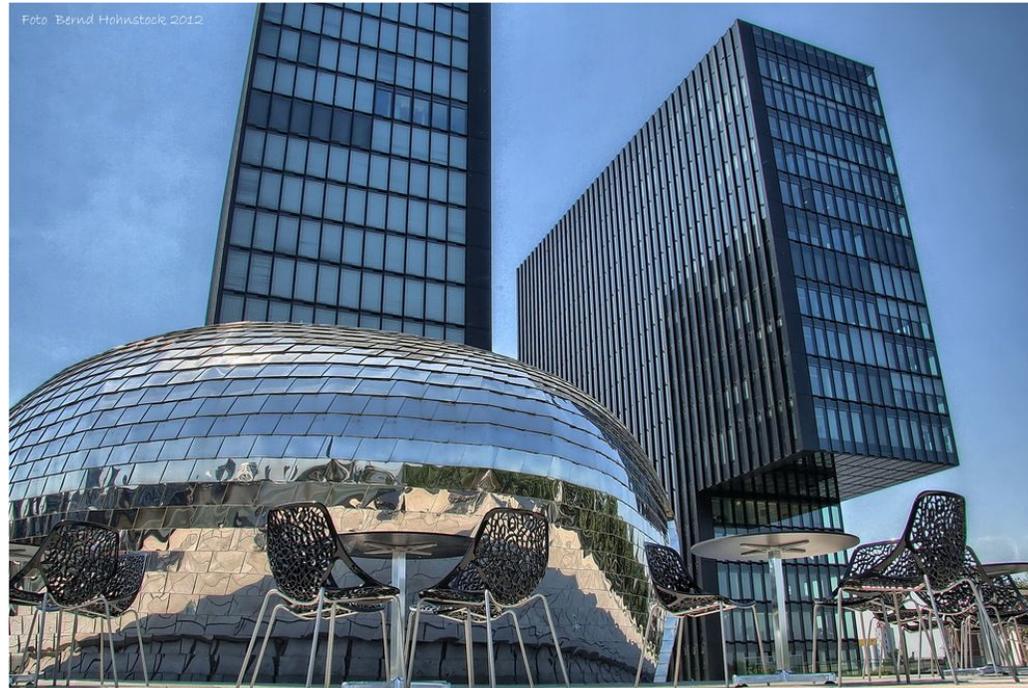
## **Latest EPO News:**

### **Amendments of the Rules relating to divisional applications**

- Rules 36 and 38 EPC will probably be amended
- Applicable for applications filed on or after April 1, 2014
- The EPO proposes to amend Rules 36 EPC to allow the filing of divisional applications as long as the earlier application is pending.
- Additional fee as part of the filing fee in the case of divisional applications filed in respect of an earlier application which is itself a divisional application, by amending Rule 38 EPC



**Thank you very much for your kind attention**



Michalski · Hüttermann & Partner  
Speditionstrasse 21  
D-40221 Düsseldorf  
Phone +49 211 159 249 0  
Fax +49 211 159 249 20  
Mail [mail@mhpatent.de](mailto:mail@mhpatent.de)  
Internet [www.mhpatent.de](http://www.mhpatent.de)

M I C H A L S K I  H Ü T T E R M A N N  
P A T E N T A T T O R N E Y S