

European Practice for Overseas Attorneys

European patent law differs in some significant aspects from the law in other countries, in particular the United States. This note sets out some important features of European patent law to remember when preparing patent applications for Europe. For more detailed drafting tips, see our briefing note "[Drafting Patents for Europe](#)".

Novelty

According to European patent law, an invention is considered new if it has not been made available to the public anywhere in the world before the priority date of the patent application. An invention is "made available to the public" if knowledge of the claimed features of the invention was available to any person who was not under an obligation to keep the invention confidential.

A novelty-destroying disclosure can be in any form, for example an oral description or a public display of the relevant features of the invention, as well as printed publications. This means that public prior use of the invention anywhere in the world before the priority date will deprive the European patent application of novelty. There is no grace period for filing an application following disclosure, except in the case of a disclosure in breach of confidence. In this situation a European application must be filed within six months of the disclosure in order to benefit from this non-prejudicial disclosure provision. However, the case law on this provision sets a high threshold for demonstrating that such a breach has occurred.

In addition to prior art that was published before the priority date of the patent application, European patent applications published after the priority date but claiming an earlier priority date are also citable. However, such documents are citable only for the determination of novelty, and not for inventive step.

Claiming priority

The European rules on claiming priority are in accordance with the Paris Convention, so that priority can be claimed within one year of the first regular national filing in a Convention country. If a second priority application is filed and the European application is filed within one year of the second but not the first application, priority is lost for matter which was in the first priority application, and it has the date of the European filing only. This most commonly occurs when the second application is a Continuation-in-Part (CIP) application and can be very serious if there is a European (or PCT) application corresponding to the US parent, as this will be at least novelty-only prior art. The rule to follow is always to file foreign applications within one year of the first disclosure of the subject matter in a patent application.

Inventive step

An invention is considered to involve an inventive step if it would not have been obvious to the skilled person in view of the state of the art at the priority date. In practice, the EPO applies the "problem-solution" approach to determining inventive step, which has three stages:

- Identify the closest prior art document, usually the document that has the most features in common with the claimed invention.
- Define a problem solved by the invention in view of the closest prior art.
- Determine whether the prior would have prompted the skilled person to solve the problem in the same way as the claimed invention. If not, the invention is considered to involve an inventive step.

In arguing for inventive step before the EPO, the key is usually to define the problem in such a way that the claimed solution is clearly not obvious in view of the remainder of the cited prior art.



Because the problem is a theoretical problem defined in view of the closest prior art, it does not have to relate to the actual task faced by the inventor at the time the application was drafted. In general, the EPO is unimpressed by secondary indicia of inventive step, such as commercial success, a long-felt want, etc.

Sufficiency

To meet the requirements of sufficiency (enablement), a European application must describe the invention clearly and completely enough for it to be carried out by the skilled person, and it must do this at its filing date. This means that it is not possible to rely on cross-references to subject matter in co-pending applications which were unpublished at the filing date of the European application. If the material is essential for sufficiency, a copy of the referenced document must be supplied to the EPO on the filing date of the European application or, preferably, the necessary subject matter should be explicitly included in the specification before it is filed.

There is no best mode requirement at the EPO, but the application as filed must provide sufficient information to allow the skilled person to practise the invention across the whole scope claimed. This is particularly important if the invention is defined by reference to parameters which must be determined experimentally according to a test procedure. In such cases, the application must include all necessary details of the relevant test procedure.

Added subject matter

The EPO takes a very strict approach when assessing the basis for any amendment to an application. Amendments must be clearly and unambiguously derivable from the application as filed.

Problems can arise with "implied added matter" and "intermediate generalisations". Added matter is implied if an attempt is made to broaden the scope of a term in a claim. For it would not be permissible to amend "electric light bulb" to "light generating means" if there is no more general disclosure in the application.

An example of an unacceptable intermediate generalisation would be the situation where claim 1 is directed to a composition comprising A+B, claim 2 is directed to the composition of claim 1 further comprising C+D, and the application contains no more general disclosure. An amended claim to the composition comprising A+B+C would be considered to add subject matter because there is no disclosure of the combination of A+B+C, without D, in the application as filed.

Post grant, claims cannot be broadened in scope. If a claim is limited during prosecution using added subject matter, not only is the granted claim invalid, but it may not be possible to remove the limitation if that would broaden the scope of the claim. This can result in the patent becoming irreversibly invalid.

Further advice

If you would like any further advice please contact us at Dehns using the details below.

United Kingdom

Dehns
St Bride's House
10 Salisbury Square
London
EC4Y 8JD

T: +44 (0)20 7632 7200
F: +44 (0)20 7353 8895
E: london@dehns.com

Dehns
Aspect House
84-87 Queens Road
Brighton
BN1 3XE

T: +44 (0)1273 244200
F: +44 (0)20 7353 8895
E: brighton@dehns.com

Dehns
Willow Court
West Way
Oxford
OX2 OJB

T: +44 (0)1865 305100
F: +44 (0)20 7353 8895
E: oxford@dehns.com

Germany

Dehns
Singlspielerhaus
Sendlinger Str. 29
80331 Munich

T: +49 89 2422 8130
F: +49 89 2422 8140
E: munich@dehns.com

www.dehns.com