

Drafting Patents for Europe

European patent law differs in some significant aspects from the law in other countries, in particular the United States. Our briefing note on “European Practice for Overseas Attorneys” discusses some more general issues to bear in mind when drafting. This note provides some more detailed tips on drafting European patent applications so that some common problems can be avoided.

Introduction

Bearing in mind certain aspects of European patent law and practice when drafting a patent application for Europe can help simplify prosecution and minimise costs. The European Patent Office (EPO) charges an extra fee on filing for each page of the application over 35 and each claim over 15. Once granted, validation in many of the designated states still requires a translation of the granted patent into the local language. Over-lengthy specifications can therefore incur significant extra fees and translation costs. On the other hand, if a specification does not provide sufficient detail, problems may arise with sufficiency (enablement) or when seeking to amend the application during prosecution.

Any amendments to a European application made during prosecution must have basis in the application as filed, that is they must be clearly and unambiguously derivable from the application as filed. When drafting, it is therefore important to provide sufficient basis for possible amendments in the application.

Claim interpretation

In Europe, there is no explicit doctrine of equivalents, so all of the features in the independent claims should be specified broadly. Claims are interpreted fairly literally, but with reference to the description for clarification. “Means plus function” claim language is interpreted as covering anything that can carry out the specific function. It can be advisable therefore to use such functional definitions to obtain broad claims.

Formal requirements of the claims

Independent claims in different categories, such as claims to apparatus and processes, are allowed in the same application. However, only one independent claim in each category is generally acceptable, with some narrow exceptions. In any event, for unity of invention all claims must have a common inventive concept, i.e. a common set of features that are novel and inventive over the prior art. If multiple independent claims are necessary, the broadest claim should be first, as this will be searched, and the broadest claim should be sufficiently wide to cover all of the other claims.

In cases claiming chemical compounds, process and use claims can also be included. It is also possible to claim chemical intermediates in the same application if they confer the inventive properties on the product. A process claim can refer to the general formula of claim 1: there is no need to repeat it in full.

European Examiners often expect independent claims to be written in characterised form (prior art features + “characterised in that” + novel features), but this can be done during prosecution once the closest prior art has been determined. Claims are also required to include reference numerals in parentheses. Again, this can be done during prosecution. The inclusion of reference numerals does not limit the scope of the claims.

Points to remember when drafting

It is important to make clear in the description what is essential to the invention and what is not. The EPO takes the invention to be that defined in claim 1 or the statement of invention. If the application identifies a feature as essential, for example it is required to meet an object of the invention, there is a risk of adding matter if a claim is amended to omit this feature.

Background to the invention

Avoid reciting large amounts of prior art unless it is very relevant, as this will add to the eventual translation costs after grant. There is no explicit duty of disclosure in Europe and the European Examiner will independently identify what is considered to be the closest prior art during prosecution.

Use the background of the invention to describe a problem with the prior art which is not obvious for the invention to solve, so that the statement of invention appears inventive.

Ensure the discussion of the problems in the prior art does not hint at the solution provided by the invention.

Only include objects of the invention that are met by the invention as defined in claim 1.

Alternatively, rephrase statements of object as advantages of the invention, or of the preferred embodiments, and include these after the statement of invention.

Further advice

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



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