

# Differences Between US and EPO Practice, Part I

# European law, procedures and culture are very different

- Knowledge of the differences in the law and procedure is essential -
  - To avoid significant loss of rights
  - To avoid falling foul of the procedures
  - To minimize misunderstanding



# Today's Goals

- Context - What you need to know
- Actions - Things you can do to help you work with your EP Attorney
- Formalities – getting things in perspective

# The Landscape in Europe

- The European Patent Office is a transnational body. The member states extend beyond the EU e.g. Switzerland, Norway
- EPO provides for granting, opposition, and post grant amendment
- The EPO has no jurisdiction over disputes (infringement or revocation actions\*)
- National Patent Offices grant national patents and hear revocation actions for national and EPO granted patents
- National courts handle all disputes - enforcement and invalidity

# The European Patent Convention Countries

Map showing the geographic coverage of European patents as of 1 November 2019

## ■ Member states (38)

- Albania
- Austria
- Belgium
- Bulgaria
- Croatia
- Cyprus
- Czech Republic
- Denmark
- Estonia
- Finland
- France
- Germany
- Greece
- Hungary
- Iceland
- Ireland
- Italy
- Latvia
- Liechtenstein
- Lithuania
- Luxembourg
- Malta
- Monaco
- Netherlands
- North Macedonia
- Norway
- Poland
- Portugal
- Romania
- San Marino
- Serbia
- Slovakia
- Slovenia
- Spain
- Sweden
- Switzerland
- Turkey
- United Kingdom

## ■ Extension states (2)

- Bosnia and Herzegovina
- Montenegro

## ■ Validation states (4)

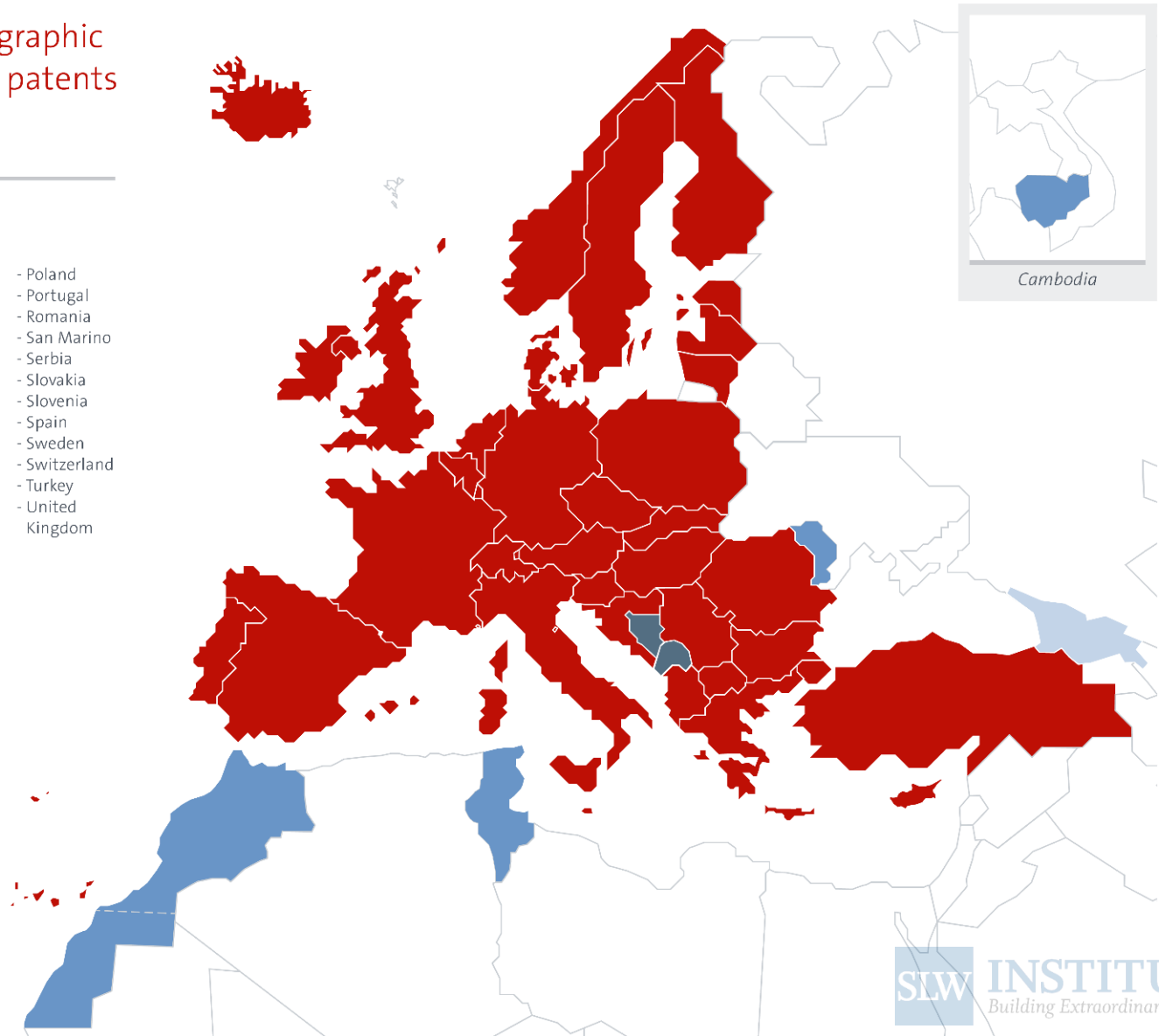
*Agreement in force*

- Cambodia
- Republic of Moldova
- Morocco
- Tunisia

## ■ Future validation states (1)

*Agreement signed but not in force yet*

- Georgia



# Searching

- The EPO has the right to refuse to search inventions that they deem are clearly excluded e.g. business methods
- They will search the first invention they identify defined in the claims (see Unity)
- Whether the application is a European convention application (Euro-direct) or the regional phase of a PCT application (Euro-PCT), the applicant will be given the chance to pay further search fees for other identified inventions\*
- Only searched subject matter will be examined. Unsearched subject matter can only be protected in divisional applications.

# Examination

- First examination for compliance with EPC
  - Search opinion (inc. supplementary search)
  - WOISA/IPRP
  - IPER
- “Examination Report” is an office action requiring a response
  - Pursuant to Rule 69/70 & 70a
  - Pursuant to Rule 161
  - Pursuant to Art 94(3)
- EPO is thus closer to the US practice than it used to be\*
- Can arrange a call with the Examiner  
even visit in person

## Examination - cont

- Examination is concluded when the Examining Division issues a communication under Rule 71(3) EPC which contains the text that they propose to allow and ONLY when the applicant approves the text or proposes minor acceptable amendments.
- The applicant has a right to Oral Proceedings before the Examining Division but only if requested – precautionary request needed in official letter responses
- If Division cannot see a way forward (and Oral Proceedings requested), Summons issues – closest thing to a Final OA \*
- OP can be done as a video conference or in person – not public if before Examining Division



# Grant

- For the patent to be granted the Grant Fee must be paid and translations of the claims into French and German must be filed in response to Rule 71(3) communication.
- Within 3 months after the Notice of Grant the patent must be validated in each designated state in which a valid patent is required
  - Appoint address for service in each country
  - File translations (if necessary) – London Agreement has reduced the countries requiring full translations
  - Pay fees if necessary

# Typical objections

- Patentability
  - novelty,
  - inventive step,
  - excluded subject matter
- Unity
- Sufficiency
- Clarity



Schwegman Lundberg Woessner Limited  
Hillington Park Innovation Centre  
1 Ainslie Road  
Glasgow G52 4RU  
ROYAUME-UNI

Application No. 14 770 112.2 - 1209	Ref. 3621
Applicant Daqri, LLC	

Communication pursuant to Article 94(3) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified



European Patent Office  
80298 MUNICH  
GERMANY

Questions about this communication?  
Contact Customer Services at [www.epo.org/contact](http://www.epo.org/contact)



Schwegman Lundberg Woessner Limited  
Hillington Park Innovation Centre  
1 Ainslie Road  
Glasgow G52 4RU  
ROYAUME UNI

Date: 19.08.19

Reference 4218.422EP1	Application No./Patent No. 18713732.8 - 1216
Applicant/Proprietor Snap Inc.	

Communication pursuant to Rules 161(1) and 162 EPC

1. Correction of deficiencies noted in the written opinion and amendment of the application (R. 161(1) EPC)

The above-mentioned international (Euro-PCT) application has entered the European phase.

The EPC as International Searching Authority and, where a demand under Article 31 PCT was filed, also as International Preliminary Examining Authority has drawn up a written opinion on this application or the EPO as Supplementary International Searching Authority has issued explanations pursuant to Rule 45bis.7(e) PCT to the supplementary international search report.

You are invited to correct any deficiencies noted in the written opinion of the International Searching Authority or in the International Preliminary Examination Report, or in the explanations to the supplementary international search report and to amend the description, claims and any drawings within a **non-extendable period of six months** after notification of the present invitation.

Should you not comply with or comment on this invitation within the time limit, **the application will be deemed to be withdrawn** in accordance with Rule 161(1) EPC.

2. Amendment of application

Under Articles 28, 41 PCT and Rules 52, 78 PCT the application may be amended before a designated or elected Office, and in accordance with Rule 137(2) EPC the applicant may amend the description, claims and drawings of his own volition together with any comments, corrections or amendments made in response to the communication under Rule 161(1) EPC.

Whether or not you have already done so, you now have a further opportunity to file amended claims or other application documents within the above-mentioned period.

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting

# Patentability (Article 52 v 35 USC 101)

- No definition of an “invention” except Art 52(1) EPC
  - states that patents must be allowed for inventions in “all fields of technology”
- Art 52(2) – non-exhaustive list of things that are not “inventions”, including
  - discoveries, scientific theories and mathematical methods
  - aesthetic creations
  - schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers
  - presentations of information
- Art 52(3) qualifies that Art 52(2) only applies to those things as such – contrast with patent eligibility in US

# The EPO Approach to Identify a Patentable Invention

Involves inventive step as a key test

1. *Excluded subject matter*: Does the invention involve technical means? If not, it is excluded under Art 52.
2. *Novelty*: Identify the closest prior art. What are the differences between the invention and the prior art? If none, not novel under Art 54.
3. *Inventive step*: The technical problem/solution approach

# The Technical Problem/ Solution Approach

## – Art 56 v 35 USC 103

- What is the problem addressed by these differences/the invention that is not addressed in the prior art. Is the problem technical?
- The field of the person who would be concerned with the problem should be identified. Is the field a technical field?
- Non-technical features cannot form part of the technical solution, are disregarded for the purposes of inventive step
  - being deemed merely business requirements given to a skilled person attempting to solve the technical problem.
- If no technical solution, not inventive under Art 56.

# Medical Methods

- Methods of diagnosis, therapy and surgery are not patentable
- Article 53(c) EPC provides that patent shall not be granted for *methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body*
- This is a matter of policy. The intention is to prevent non-commercial and non-industrial medical and veterinary activities from being restrained by patent rights (G 5/83)
- A claim is not allowable if it includes a\* treatment step or surgical step

# Medical Methods

- Diagnostic methods only excluded where they immediately make it possible to decide on a particular course of treatment and a patient is necessarily present.
- Allowable
  - Surgery involving the death of an animal – no ‘treatment’
  - Cosmetic surgery
  - Contraceptive methods
  - Apparatus for use in surgery, therapy or diagnosis

## Novelty – Art 54 v 35 USC 102

- Article 54 EPC states that an invention shall be considered to be new if it does not form part of the state of the art.
- The state of the art is defined as *everything **made available to the public** by means of a written or oral description, by use, or in any other way* before the date of filing.
  - The *public* comprises any person free to use the information or disclose it to another
  - The disclosure must be *sufficient*
  - Secret prior use is not making *available to the public*
  - If the invention is made available, no matter that no one actually saw it
- EPO does not require an Information Disclosure Statement



# Novelty – Art 54 v 35 USC 102

- Prior filed but not published applications – prior art for novelty only
  - Article 54 EPC - the contents of European patent applications as filed having an earlier filing date and which were published on or after the filing date are part of the state of the art but only for **novelty** purposes
- New use of a known substance or composition is novel
  - Article 54 EPC further provides that substances or compositions which are known are not novelty destroying for a new use of the substance or composition for use in a method of treatment or diagnosis, provided that use is new

# Novelty – Art 54 v 35 USC 102

- No grace period – BUT limited exceptions
  - Article 55 provides a 6 month grace period where the invention was disclosed as a result of evident abuse or in an officially recognised international exhibition – this must be claimed when filing
- First to file system
- No on sale bar – an offer for sale (commercial use) is not necessarily prior art. Made available to the public?
- An applicant's own prior unpublished EP applications are prior art against their later EP applications
- Public use anywhere in the world is prior art

# Unity of Invention

- Article 82 EPC - “The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”
- An inventive concept - a solution to a technical problem.
  - If the problem is new - the invention can be the identification of the problem.
  - If the problem is not new - each solution is likely to constitute a separate inventive concept.

# Sufficiency

- Article 83 - the patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- No incorporation by reference – be specific or avoid
- there is no requirement for *best mode* in examination at the EPO

# Clarity

- Article 84 EPC requires the claims to be clear and concise.
- “vague” language
  - “spirit” of invention
  - “equivalents” of claims (Art 69 on interpretation “instead”)
  - “incorporated by reference” (delete if not actually essential for carrying out the invention – Art 83)

# Amendments

- Rule 137(1) & (2) EPC - voluntary amendments allowed as of right at any time after receipt of the search report up until the response to the first substantive communication\*.
- After this, amendments can only be made at the consent of the examining division. (R137(3))
- There is no estoppel in Europe. Arguments and amendments can be reformulated.

# Amendments

- Article 123(2) EPC forbids amendments to applications or patents that extend the subject matter beyond the content of the application as filed.
- Article 123(3) EPC forbids amendments to the claims post-grant (i.e. during opposition proceedings) that extend the scope of protection conferred beyond that granted.
- Thus the requirement for basis/support.

**BEWARE THE ADDED SUBJECT MATTER TRAP**

# Description

- Closest prior art must be acknowledged in the introduction
  - Can be added during examination
  - Often newly cited prior art considered the closest and added during examination
- Incorporation by reference not allowed (Art 83) – will not save sufficiency or provide basis for claims.
- The description must describe the technical features of the invention in detail to avoid possible exclusions e.g. business method, mathematical method, presentation of information etc.



# Claims

- Only a single method and a single apparatus claim normally allowed
  - Exceptions e.g. a plug and a socket, a client and a server, a transmitter and a receiver
- Multiply dependent claims allowed – fees only paid based on the actual number of claims not their dependencies.
- ‘Means-plus-functions’ claims not limited in scope.
- Claims allowed to carrier media, computer programs and signals.
- Renumbering preferred

# Claims

- Very narrow claim amendments allowed during examination.
- Beware claims fees - 235 Euro per claim above 15 (to 50)
  - for each claim above claim 50, 585 Euro.
- Reference signs required in the claims – can be added during examination.
- S.I. units (claims and description)

## Two Part claim form

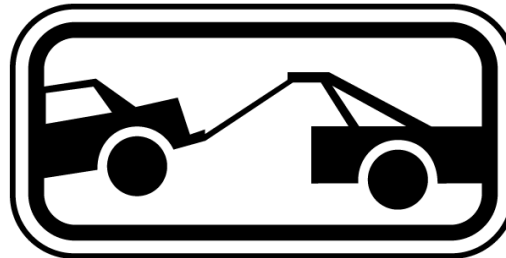
- **Wherever appropriate**, the claims shall contain the subject matter necessary for the definition of the invention but which forms part of the prior art and a characterising portion beginning with “characterised in that” or “characterised by” and specifying the technical features for which protection is sought (Rule 43(1))
  - e.g. Apparatus for processing an image comprising input means, first filter means, and output means, characterised by second filter means.
- Not strictly required – avoid to reduce scope for estoppel in US for equivalent US application

# Claim Scope

- Article 69 EPC states that the scope of protection is determined by the claims but the description and drawings shall be used to interpret the claims
- Protocol on the Interpretation of Article 69 EPC states that extent of protection is a position between the strict literal meaning of the wording used in the claims and a position in which the claims are merely used as a guide
  - Fair protection for the patent proprietor and a reasonable degree of legal certainty for third parties
  - Due account shall be taken of any element which is equivalent to an element in the claims
- Non uniform approach in national courts

# Take-aways

- Day-to-day EP practice is broadly similar to US
  - Differences in approach but similar concepts of novelty, etc.
- Road to grant is different in EPO
  - But we are driving on the same side of the road (mostly)
  - Most of the way is freeway
  - We have similar signs at the same sorts of places
  - Just watch where you park



**Thanks for listening.**

**Any questions?**

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