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European Patent Practice – The Good, The Bad and The Ugly

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European Patent Practice – The Good, The Bad and The Ugly

Speakers:

Pia Bjork, *European Patent Office*

Joanna Thurston, *Withers & Rogers LLP*

November 16, 2016

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- AUTM Licensing Activity Survey (currently for United States and Canada)
- AUTM Update

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- Meetings at national and regional levels

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Pia Bjork

European Patent Office

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Joanna Thurston

Withers & Rogers LLP

European Patent Practice

The Good, the Bad and the Ugly

Pia Björk – Director, European Patent Office
and
Joanna Thurston – Partner, Withers and Rogers LLP

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- Fundamental Concepts
- Novelty
- Inventive Step
- Clarity
- Amendments
- Procedural issues
- Third Party Provisions
- Unitary Patent

European Patent Office

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The Basics

Drafting Styles

- Consider International perspective when drafting any application
  - Often not clear at drafting stage whether it will be a local application only, or be filed elsewhere
- Can review for this at priority filing stage or PCT preparation stage
- EP drafting style is useful for Chile, India, Japan, Australia, New Zealand, and national filings in European states
- US drafting style is useful for Brazil, China, Korea, and Canada

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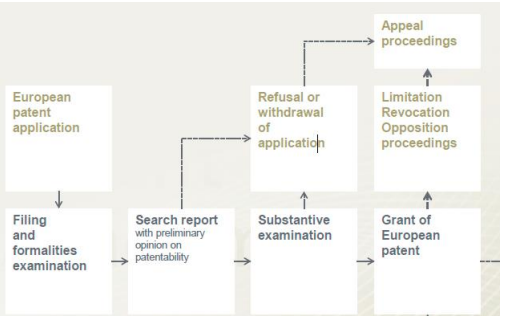
Key Differences between drafting styles in the US and Europe

- Grace period
- Claim structure – claims fee structure (15 claims or fewer), multiple dependencies, limited independent claims
- Use claims allowable in Europe, but methods of medical treatment are not
- Inventive step approached differently – for Europe need to state advantages of fall-back positions; non-technical features ignored for inventive step
- Need to draft with added matter in mind in Europe – multiple fall back positions

Overview of The European Patent Process



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Overview of The European Patent Process

- 38 member states, 2 extension states, 2 validation states
- about 6800 employees, of which some 4000 examiners
- Munich (DE), The Hague (NL), Berlin (DE), Vienna (AT)
- 3 official languages (English, German, French)
- divisions of 3 technically qualified examiners
- 160 000 patent applications in 2015
- PCT: 38% of all international searches, 56% of all preliminary examination

Novelty

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Law – Art.54(1) and (2) EPC

- Art.54(1) and (2) EPC:

  (1) An invention shall be considered to be new if it does not form part of the state of the art.

  (2) The state of the art shall be held to comprise 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 of the European patent application.

- Absolute novelty (not equivalents)

Novelty Only Prior Art

- Art.54(3) EPC:

  (3) Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

- Not considered when assessing inventive step (Art.56 EPC)
- Disclaimers
- For Unitary patent: also national (EU) patent applications?

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How to Deal with Novelty Only Prior Art

- Bare Novelty
  - The difference can be very small
- Disclaimers with basis
  - ... an advantage of the invention is that grommet X, or surfactant Y are not required
  - Negative claiming possible but discouraged

How to Deal with Novelty Only Prior Art

- Disclaimers without basis are possible in the following circumstances:
  - Restore novelty over novelty only prior art
  - Restore novelty over "accidental anticipations"
  - Disclaim excluded subject matter
- Advise against using unless absolutely necessary
  - There are risks of adding subject matter by disclaiming too much

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Inventive Step

Problem – Solution Approach

- Identify closest prior art
- What is the difference?
- What is the **technical effect** offered by the difference?
- Formulate the **technical effect** as the objective technical problem
- Would it be obvious to the skilled person using his common general knowledge and the prior art to solve the objective technical problem in the way claimed?

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Working with the Problem-Solution Approach

Background to Invention

- Ideally cast in terms of:
  - Problems with the prior art
  - How the prior art fails to solve the problem of the invention
  - How it addresses a different problem to the problem solved
- Can require a “magic looking glass”
  - Will only be effective if have a good idea of the prior art

Statements of Invention

- State feature and state its advantage
- Provides basis for arguing inventive step based on that feature
- And for formulating the objective technical problem based on that advantage
- Include an example illustrating the advantage at work
  - To make the effect plausible
  - If not plausible may not only be found to lack inventive step, but may also lack sufficient disclosure

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Evidence of Inventive Step

- Often need to prove that there is a benefit when compared to the closest prior art
  - Often not described in application as closest prior art determined after drafting
- Or that the technical effect is present across the "whole scope" of the claim
  - Claim scope not justified if it includes within it's scope embodiments which do not work
  - Often an issue in chemical cases
  - Opponents love this requirement!
- Data often requested
  - Important to prepare the data requested if necessary

Clarity

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Claim Content

- Art.84 EPC:

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

- Not a ground for opposition
- Often linked to other issues: insufficient disclosure of invention, lack of novelty, lack of inventive step
- Broad claims not necessarily unclear

Claim Content

- Avoid relative terms (thin, strong, wide)
  - Provide definitions in the specification for insertion into the claims if needed
- Avoid vague terms (about, approximately, substantially)
  - Likely to require deletion from the claims
- "suitable for" largely non-limiting
  - But can generally be recast as a "use" claim

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Claim Content

- Functional Terms
  - Can be used, but care is needed
  - Important to include broad physical/chemical definitions of the terms in the description
  - Avoids unnecessary loss of claim scope

Amendments

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EPO Interpretation

- Applicant can amend once on his own volition, after that under discretion of the examining division (Rule 137 EPC)
- Guiding principle: result of the amendment must be seen as having been unambiguously disclosed in the application as filed
- Correction of errors: the correct version/value must be unambiguous; point of time in the procedure when errors are corrected also relevant

Working with the EPO Interpretation

- Added Subject Matter is a significant problem
  - Ground for opposition
- Often rests in subtleties of wording
- Text read simply
  - Difficult to "interpret" text to provide basis for an amendment, although easier in mechanical field than in chemical and life sciences fields

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Working with the EPO Interpretation

- Literal basis not required but disclosure must be unambiguous
- Figures of little use as basis
- Difficult to remove essential features
  - Often useful to have statements of invention that are broader than the claims (even if clearly not novel)

Picking Features

- Important not to link multiple features in description as these cannot be used for single feature amendments
  - EPO will ask if the features must essentially be present in combination
- Can't take selected features from examples
- Graduate fall-back positions

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Combining Features

- If not disclosed together, difficult
  - But important not to "link" - need balance
- Avoid using the term "in ... embodiments" as difficult to combine features from different embodiments
- Try to claim all important features
  - Claims generally regarded as disclosed in combination unless reason why can't be interpreted this way (e.g. alternatives)
  - Worth changing to multiple dependency at PCT stage?
  - Or making "claim clauses" multiply dependent?

Procedural

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Claim Structure

- Can condense at time of European national phase entry to group together alternatives (Markush groupings)
  - Deliberate introduction of a lack of clarity possible, to avoid deletion of features present in original claim set
  - For instance by combining nested claims using the term “optional” – discouraged by EPO but avoids claims fees at filing and can be remedied later when true independent claim scope (and so dependent claims of interest) is more apparent

Claim Structure

- How to deal with European Requirements?
- Multiple dependencies can help with added subject matter
  - Evidence that features can be combined
- Don't waste claims on non-inventive features

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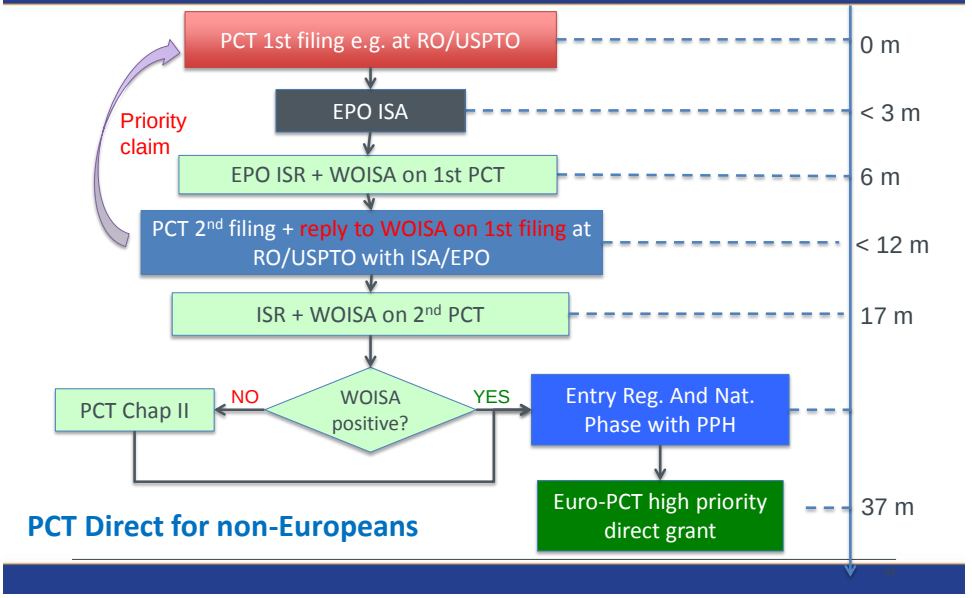
Acceleration Mechanisms

- Early Certainty: 6 months for search, 12 months for examination, 15 months for opposition (average)
- PACE (Program for Accelerated prosecution of European patent applications)(OJ 2015, A93 and A94): separate requests for search and examination; also possible for opposition and appeal (with arguments) – for free, not in public part of file
- PPH
- Waivers for certain formal communications
- PCT Direct
- Third party observations (non anonymous)



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Acceleration Strategies

- We recommend PACE over PPH
- PPH has not been found to accelerate examination relative to PACE and increases costs because of the evidential requirement imposed at the time of requesting PPH
- PACE requires the completion of a simple form
- PACE requests do not appear on the public record
- PCT Direct of most interest with European originating cases
  - Can be a powerful tool where the PCT will be national phased in multiple countries

Mechanisms for contacting the Examiner

- Telephone – ticket system (First Line Customer Service)
- Telephone minutes in file
- e-mail content copied into telephone minutes form if procedurally relevant
- Informal interviews
- Oral proceedings
- Oral proceedings by video conference

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Contacting the Examiner

- We find that most examiners are prepared to discuss a case by telephone or in person
- This is at their discretion and some do decline
- Whether and when they accept a call depends on the examiner, some prefer to wait until after a response has been filed and considered and essentially provide verbal feedback, some are happy to enter into a true discussion

Contacting the Examiner

- Oral Proceedings by video conference have been rare due to lack of facilities at the EPO
- Unless a client is cost sensitive we prefer to attend in person as “human” interaction is lost and it can be more difficult to discuss the case

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Third Party Provisions

Third Party Observations

- Can be filed on-line
- Can be filed at any point in the procedure, up to when proposal for grant is sent to the postal service
- Anonymously or non anonymously (acceleration)
- Third Party Observer not party to proceedings
- Examiner obliged to consider (trace in file)

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Opposition

- Centralised, post-grant procedure, has to be started within 9 months of announcement of publication of grant
- Anyone can oppose (except the patentee – see next slide)
- Full party to proceedings
- Accused infringer can enter pending opposition also after the 9 months time limit as opponent
- Grounds for opposition: patentability, added subject matter, sufficiency – not a “re-examination”
- Streamlining since 1.7.16 (aim at 15 months average)(OJ 2016, A42)

Limitation / Revocation by Patentee

- At any time after the grant the patentee may request limitation of the patent by filing a new set of claims. However, opposition proceedings have precedence .
- The patentee may request revocation of the patent at any time after grant.
- The effect of the decision to limit the patent or to revoke it applies *ab initio* to all contracting states in respect of which the patent was granted.

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Interplay between Third Party Observations and Opposition

- Third party observations
  - Generally need strong (usually clearly novelty destroying) arguments to be persuasive
  - Low cost, roughly to prepare and file $3000 - $5000
  - Indication of effectiveness within around 1 year
  - Can be anonymous

Interplay between Third Party Observations and Opposition

- Opposition
  - Although an opponent must be identified, can hide identity of party with commercial interest – Straw Man
  - Costs higher than third party observations $30,000 - $50,000 for whole procedure
  - 18-24 months procedure with appeal possible – can take 3-4 years to resolve

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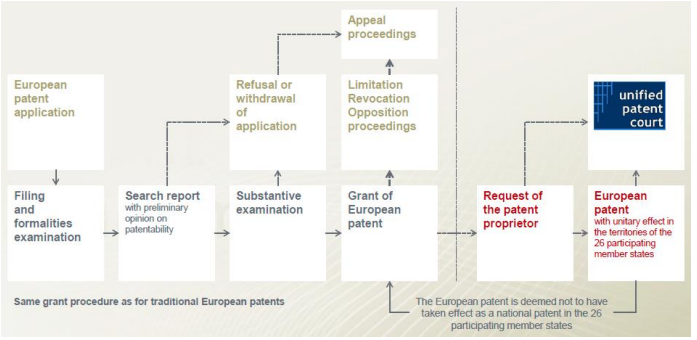
Unitary Patent and UPC



Unitary Patent and UPC

- Unitary patent is a "European patent with unitary effect" for the 26 participating states (not Spain, Croatia)
- On request of the patentee (1 month after mention of grant is published)
- Single EPC procedure for European and "unitary patents"
- Transitional translation arrangements
- Unitary Patent Court (UPC)
- Opt-out option (7 years) for existing EP patents when entry into force of the unitary patent

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Strategies for the Unitary Patent

- Three options, national filings, "traditional" European Patent and Unitary Patent
- Choice will depend upon:
- Number of countries of interest
  - If interested in less than 4/5 a traditional European filing or national filings may be preferred

Strategies for the Unitary Patent

- Litigious environment
  - UP will be litigated in the central Unified Patent Court – can find infringement (and invalidity) for all EU member states
  - Licensing models may benefit, can get protection in whole EU for cost of 4 countries and can license country by country (can't assign country by country though)
  - Brexit is causing strategic uncertainty

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Thank you

Questions?

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Questions? Comments?

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