

European patents

Align U.S. and European patent filing strategies for maximum efficiency

Filing patent applications with the European Patent Office (EPO) requires a different approach than when filing solely in the U.S. The differences range from administrative to technical. There are, however, filing strategies that will save applicants time and improve their chances of success.

“There are many ways to adjust your drafting technique for your U.S. patent application that won’t hurt you when submitting it in America, but will align it with European standards. A little more work up front will save you a lot of money down the road,” says John Ling, partner at Fay Sharpe LLP.

Smart Business spoke with Ling about how to save money and ensure success when filing patents with the EPO.

How should companies approach filing patents in multiple countries?

Some companies file informal provisional patent applications that establish an early effective filing date in the U.S. and then file a Patent Cooperation Treaty (PCT) application, which makes it possible to seek patent protection simultaneously in many countries, on or before the 12-month deadline from filing the provisional application. This identifies individual countries and/or regions in which the company desires patent protection.

Let’s say a company files a provisional patent application in the U.S., files the PCT application a year later, and then elects to file national stage patent applications in Europe, the U.S., and China. In this scenario, the company has postponed the expense of the national stage filings by several years, which permits the company to evaluate whether the invention is still commercially valuable before it elects to pursue a potentially

expensive patent application elsewhere.

In this instance, it can be advantageous to draft the U.S. provisional application in a somewhat universal manner so that minimal alterations to the invention are required when filing in multiple countries.

What are some key ways to save money and time when filing with the EPO?

Some patent attorneys draft lengthy and redundant patent applications. They write patent specifications that are 50 or more pages, taking multiple pages to describe an embodiment and then copy and paste that multi-page description in when describing only minor alterations to the embodiment. This approach lacks foresight when the intention is to file in multiple countries because the application potentially will need to be translated into several languages. Translation services typically charge by the word or page, so brevity can be beneficial.

Additionally, European patent practice permits the use of multiple-dependent claims — dependent claims further narrow the scope of the independent claim — without additional fees. If you make multiple dependent claims in the U.S., they’re filed separately and incur costs separately. In Europe, however, you can essentially bundle dependent claims together by claiming multiple dependency from ‘any one of the preceding claims,’ rather than from a specific



JOHN LING

Partner
Fay Sharpe LLP

(216) 363-9000
jling@faysharpe.com

Insights Legal Affairs is brought to you by **Fay Sharpe LLP**

single claim, giving you more claim scope coverage. Just make sure that each multiple dependent claim has a basis in the claims from which it depends.

What should patent applicants consider before filing for patent rights with the EPO?

In Europe, the examiners apply a problem-solution approach when examining patent applications. Applicants, therefore, must be able to point to a technical solution, described in the patent application, to a problem when defending claims.

Different art groups handle unique areas of patent processing. Some are more liberal than others in their problem-solution approach. Savvy companies craft claims to appeal to specific art units, which is important since once an application is assigned to an art group it stays there.

If one applicant repeatedly files applications directed toward subject matter known to be difficult to patent in the EPO, that applicant will get a reputation with an art group for filing unpatentable inventions. Over time, those examiners may recognize that and the applicant will lose credibility.

Smart businesses do their analysis early to determine whether and how to pursue a European patent. Find an attorney to help determine your chances of success. No one likes bad news, but it’s better than the cost of rejection. ●