

The EPO and USPTO:

Two Offices Divided By A Common Language

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A large, abstract green graphic on the left side of the slide, consisting of overlapping curved shapes in various shades of green, from dark to light, creating a sense of depth and movement.

Agenda

Inventions

Novelty

Obviousness

Priority

The Description

The Claims

New Matter

European Patent Office

- European Patent Convention (EPC)
 - Convention on the Grant of European Patents of 5th October 1973 (as revised in 2000)
- The Implementing Regulations to the Convention on the Grant of European Patents (Rules)
- T, J, G Decisions of EPO Boards of Appeal
- Guidelines for Examination in the European Patent Office (Examination guidelines)
- European Patent Attorney

USPTO

- United States Code
Title 35 – Patents
- Code of Federal Regulations 37: Chapter 1
- Case law
- Manual of Patent Examining Procedure
- Patent Agent or Patent Attorney

EPO

- EPC says what is **not** an invention
- Art 52(1) “inventions, in all fields of technology”
- Art 52(2) not inventions as such:
 - 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

USPTO

- 35USC § 101 says what **is** an invention
 - Any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof
- *In re Bilski*

EPO

- Patents not granted for (Art53)
 - Inventions for which commercial exploitation would be contrary to “ordre public” or morality
 - Plant or animal varieties or essentially biological process for production of plants or animals
 - Methods for treatment of human or animal body by surgery or therapy and diagnostic methods practised on human or animal body

USPTO

- No public order or morality exclusion
- 35USC Chapter 15 – Plant Patents
- Surgical methods patentable

- Neither permits patenting of abstract concepts
- Useful *cf.* Technology
- EPC prevents patenting of discovery as such, but USC35 considers discoveries to be inventions – in practice little difference
- At EPO rules relating to claims impart further requirements:
 - Claims define protection in terms of technical features (R43(1))
 - Independent claim includes the essential features of an invention (R43(3))
- Can get round exclusions using formal wording
- Exclusions then ‘bite’ during assessment of obviousness
- Meaning of “as such” develops through case law
- Rule of thumb:
 - Claim a non-obvious technical solution to a technical problem

EPO

- No grace period for public disclosure of invention (Art54(2))
- 6 month grace period for disclosure in breach of confidence (Art55)
- 'Enabling' public disclosure to destroy novelty
- EP applications filed before your application but published after filing of your application are citable against novelty only (Art54(3))
- Only documents published before your priority date can be cited against obviousness (Art56)
- Your own earlier applications can be prior art against your own later applications
- First to file system – no swearing back to date of invention

USPTO

- One year grace period § 102(b)
- First to invent system § 102(a)
- Can ignore your own prior filed applications § 102(e)
- No interference § 102(g) at EPO – double patenting by different parties possible
- All prior art citable against obviousness § 103(a)

EPO

- Very structured approach to obviousness – problem and solution
- Do novel technical features of claim define a non-obvious solution to a technical problem?
- Non-technical features of claim given no weight when assessing obviousness

USPTO

- Differences between invention and prior art obvious to PHOSITA § 103
- KSR – obvious to try *cf.* teaching, suggestion, motivation

EPO

- Can claim priority from WTO and Paris Convention countries
- Must claim priority within 12 months from first filing which gives rise to right to claim priority
- No equivalent to domestic priority § 120
- Can now make late declaration of priority or correct priority claim within 16 months, but still need to file within 12 months
- Beware of US provisional applications: priority right needs assigning from inventor(s) to applicant before EPO filing

USPTO

- Can make domestic priority claim while case still pending § 120
- International priority claims similar to EPO § 119

EPO

- Needs to sufficiently clearly and completely describe an embodiment of the invention so that it can be worked (Art83 & R42(1)(e))
- Should indicate and cite the closest background art (R42(1)(b)) – usually that found by the EPO search
- Should disclose the invention so that the technical problem solved and solution can be understood – beware of identifying different problems, too specific a problem or the wrong problem (R42(1)(c))
- Incorporations by reference only allowed in very limited circumstances and generally should be avoided (see Exam Guidelines)

USPTO

- Beware of incorrectly identifying prior art
- Section titles required
- Incorporations by reference generally allowable
- Similar sufficiency requirement, but best mode also required

EPO

- Generally only one independent claim allowed in each category (method or apparatus) (Art84 and R43(2))
- Only one invention claimed in any application - each independent claim must relate to that same invention (determined by novel features of each invention) (Art82 & R44)
- Two part form of claims (prior art features **characterised by** novel features) preferred (R43(1))
- Multiply multiply dependent claims are possible
- Claims should include reference signs (R43(7))
- Claim fee of US\$250 for each claim > 15th
- EPO will only examine searched features

USPTO

- Means + function has particular meaning § 112, 6
- Can have multiple independent claims in same category
- Multiply multiply dependent claims not allowed
- In a system, the method of . . . considered clear
- Unity of invention determined by search in same art unit not claim features
- Claim features should be in drawings

EPO

- Cannot amend specification to include subject matter extending beyond content of specification as filed (Art123(2))
- Can broaden claims during prosecution if does not add matter
- Cannot broaden granted claims (Art123(3)) e.g. during opposition
- Applied very strictly – matter must be directly and unambiguously derivable
 - Probably need to use wording lifted from specification
 - Intermediate generalisations not allowed
 - Combinations of features not originally specifically disclosed not allowed

USPTO

- No amendment shall introduce new matter into the disclosure of the invention § 132(a)
- “an issue of new matter will arise if the content of the amendment is not described in the application as filed” (MPEP 2163.06)

Procedural Differences

EPO

- You are entitled to a hearing before refusal of an application by an Examining Division
- Decision to refuse is finally appealable to a Technical Board of Appeal
- Post grant opposition of patents within 9 months of grant
- Central limitation or revocation procedure for proprietor

USPTO

- Board of Patent Appeals (and Interferences) similar role to Technical Board of Appeal
- Possibility of Re-Issue
- Possibility of ex-parte and inter-partes re-examination
- Interference Proceedings

Top Ten EPO Tips

- Assign all priority applications in writing to the applicant before foreign filing
- Don't incorporate by reference things needed to sufficiently describe the invention
- Don't claim trivial things which are described: you are wasting money
- Your claim and description terminology should be consistent: avoid 'in-house' terms
- Try and describe features in isolation and at different levels of generality.
- Claim each different invention as apparatus and/or method separately (but be prepared for divisionals)
- Claim how the technology works not simply what it can do
- When amending, don't make up new wording, use the best existing wording
- For obviousness, being different to the prior art is not enough: how does your invention work differently, what single problem does that solve, and why would it not be obvious to modify the prior art to work in the same way?
- Don't expect to be able to do at the EPO what you did at the USPTO

- EPC + Rules
 - <http://www.epo.org/patents/law/legal-texts/epc.html>
- EPO Examination Guidelines
 - <http://www.epo.org/patents/law/legal-texts/guidelines.html>
- Case Law Book
 - <http://www.epo.org/patents/appeals/case-law.html>
- Searchable Case Law of EPO Boards of Appeal
 - <http://www.epo.org/patents/appeals.html>
- European Patent Register and Online File Inspection
 - <http://www.epoline.org/portal/public/registerplus>

Thank you
Questions?

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