

European Patent Drafting & Tricks for reducing official fees

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Presentation Structure

(1) European patent drafting

- basic requirements
- recent case law
- European quirks

(2) Tricks to reduce EPO official fees

- understanding EPO Search and Excess Claims fees
- anticipate problems, and save fees



European Patent Drafting

- The description serves two principal functions
 - (1) To enable the reader to understand the inventive contribution
 - Background art (Rule 27(b) EPC)
 - Technical problem/ solution must be ‘understood’, and advantages stated *vis-a-vis* the art (Rule 27(c) EPC)
 - ‘Exploitation in industry’ (Rule 27(f)/ 23e(3) EPC)
 - (2) To enable a skilled person to effect the invention
 - ‘At least one way’ (Rule 27(e) EPC)
 - Incorporation by reference – is the feature essential?
 - Biological material deposits



European Patent Drafting – Article 83 EPC

- How much common general knowledge is attributable to a SP?
 - Adequately described essential features?
 - T755/00; T222/00; T397/02; T891/02; T792/00; T843/03
 - Inutility within a claim?
 - T731/00; T857/03
 - Broad claim language?
 - T137/01; T616/03; T965/01; T609/02
 - Use of separate publications (incorporated by reference)?
 - T558/03
 - Evidence of technical effect (disguised Article 84 EPC?)
 - T157/03



European Patent Drafting – Article 83 EPC

- Summary
 - Carefully characterise essential features (ICOS – ‘specific, credible function’; more than just *in silico* evidence)
 - With functional claim language, include sound disclosure of species within the genus
 - Include at least one working Example
 - Include a ‘test’ for confirming workable embodiments
 - Possibly a recent EPO trend - supplementary evidence is manifestly incapable of curing an insufficient disclosure (T222/00; T792/00; T965/01; T609/02), though there may still be hope (T157/03)
 - Traditional sufficiency (how?) versus a disguised ‘support’ issue (show me?)



European Patent Drafting – Article 84 EPC

- The “claims shall be ... supported by the description”
 - Historically ‘support’ has been generally interpreted as a formal matter to ensure that the description and claims are co-extensive
 - However, more recently (at least for biotech inventions), the bar appears to have been raised
 - At the very least, a basic ‘proof of principle’ in the specification as filed appears to be necessary
 - T127/02; T609/02
 - OK to supplement ‘proof of principle’ with additional data
 - T609/02; T157/03



European quirks

- Methods of medical treatment (by therapy or surgery)
 - ‘Real and defined’ medical condition/ disease (T241/95)
 - ‘Therapy’ embraces prevention (eg. immunisation) – (T774/89)
 - ‘Surgery’ embraces “any non-insignificant, intentional physical intervention” (T182/90; T1077/93)
 - Surgical, non-therapeutic method claims are ok (T383/03) – is method potentially suitable for maintaining or restoring the health, physical integrity or physical well-being of an animal?
 - Disclaimer (G1/03)
- Methods of diagnosis performed on an animal body
 - Explicit written basis for ‘sample’ or ‘*in vitro*’
 - Disclaimer (G1/03)
- Added-matter
 - Explicit written basis for all combinations
 - Multiple claim dependencies



(2) Tricks to reduce EPO official fees

- Can the total number of claims be reduced?
 - Remove/ convert ‘method of treatment’ claims
 - Introduce multiple claim dependencies (written basis?)
 - Reduce multiple independent claims (Rule 29(2) EPC) where they are in the same claim category
 - Unity objections (from the EPO) during the International phase will be repeated by way of Rule 112 EPC, so why pay for excess claims that will require a divisional filing?





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