

Coordinating patent prosecution in the US and Europe

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In today's connected global economy, obtaining patent protection in multiple jurisdictions is the best way for companies to protect their intellectual property on a global scale. However, different countries have different patentability requirements and prosecution schemes, and these differences can significantly complicate the coordination of a global patent strategy. For example, companies pursuing patent protection in both the US and the EU should keep in mind a few key differences between these two jurisdictions to avoid losing valuable IP rights.

Inventorship

Inventorship in the US is a critical component of patent ownership. When applying for a patent at the USPTO, the applicant must name all inventors of the invention claimed in the patent application.

Because each inventor owns a complete and undivided interest in the entire patent application and resulting patent, the applicant (such as an employer) should obtain an assignment from each inventor to perfect the applicant's rights in the application, such as the right of priority and the rights to license and enforce the granted patent.

Absent an assignment, each joint inventor may exploit the invention without the permission of, and without accounting to, the other joint inventors. One joint inventor cannot stop another from independently selling,

conveying, assigning, or licensing the patent. Incorrect inventorship or improper assignments in the US can cast doubt on a patent owner's rights and can render a patent unenforceable, e.g., if one or more inventors intentionally omit another inventor.

In Europe, on the other hand, inventorship is far less important. While the right to a European patent belongs to the inventor or his or her successor in title, the applicant is deemed to be entitled to exercise the right to a patent before the EPO, and assignments or employment agreements are not examined.

Lack of entitlement is not a ground for revocation before the EPO but is a ground for invalidity in national nullity proceedings in some European countries. However, this ground can only be invoked by the person whose rights have been violated. Among the grounds for revocation, such as lack of enablement or lack of patentability over the prior art, lack of entitlement is by far the least common.

Practice tip

- In the US, be sure to get inventorship correct to avoid problems in the future.

Right of entitlement

Under the Paris Convention and the PCT, whoever files an application is called the applicant. The applicant must have had the right to file the application at the time of the filing based on the law of the nation where the invention occurred. The right to file a subsequent application is presumed to vest in the earlier applicant unless there is a written transfer of ownership.

However, whether ownership actually transferred is also based on the law of the nation governing title to the invention. In the US, transfer of ownership requires a written assignment, and only an actual assignment – rather than merely an obligation to assign – transfers title. In some countries, title to an invention transfers automatically to the inventor's employer, but this is not the case in the US

Practice tip

- In the US, make sure to obtain assignments from all inventors, preferably before filing the foreign application, but certainly before filing the PCT or EPO application.

Right of priority

The right to claim priority to an earlier application filed in another country flows from the Paris Convention. This right belongs to the entity that filed the earlier application (i.e., the applicant), and must be exercised within 12 months of the date of the original application. The PCT authorises an international application to be

filed with a priority claim under the Paris Convention and then the PCT application can later be nationalised in different countries for examination and grant while claiming the priority date of the original application.

In Europe, the right of priority is based on the three requirements of Article 87(1) EPC: (a) same applicant, (b) same invention, and (c) first application.

a) **Same applicant:** The US considers the right of priority to vest with each applicant, meaning that any applicant may exercise the right. The EPO considers the right of priority as pertaining to all of the named applicants together, meaning that a priority claim can be made only by all of the applicants in the priority application (or their assignees). While additional applicants may be added, all of the original applicants must be among the applicants listed in the subsequent application that claims priority from the priority application.

b) **Same invention:** According to decision G 2/98 by the EPO Enlarged Boards of Appeal, the test for the same invention is whether a skilled person can derive the subject matter of the claim directly and unambiguously, using common general knowledge, from the previous, priority application as a whole. The invention claimed in the later application must already be disclosed in the priority application in an enabling manner (i.e., sufficiently clear and complete that a skilled person can carry it out). The requirements for the same invention to support priority are similar in the US and are determined on a claim-by-claim basis.

c) **First application:** A first application is the application from an applicant that discloses for the first time any or all of the claimed subject matter. However, in some situations, the applicant may determine that the original application is no longer favorable and may wish to start over. Re-starting the clock in this way is permitted by the EPO if, at the date of the subsequent application's filing, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. An applicant may also abandon a US provisional, which is never published, or a US utility application that has not yet been published.

The right of priority in Europe can easily be lost based on minor changes in the subsequent application or the wording of the claims, which can result in a failure to meet one or more of these requirements.

Practice tips

- Absent an intervening assignment you must name the same applicants in the priority application and later application to ensure the right of priority.
- Do not remove an applicant listed on a priority application when filing a later PCT or EPO application absent an assignment from the removed priority applicant to a new applicant listed on the later filed application.

- You can add a new applicant to the later filed application without losing the right of priority and without the need for any assignment, as long as you also list all original applicants.
- In the later application, include the complete disclosure of the priority application; if the invention has evolved, leave the disclosure of the priority application untouched and add new subject matter.
- When intending to restart the clock, ensure that the first application is abandoned with no further rights outstanding.

Claim drafting

Generally, the differences in claim drafting between the US and Europe are a matter of claim coverage. In Europe, claims tend to cover the invention with a high degree of precision and with fewer claims than typically filed in the US (e.g., because of higher excess claim fees). In the US, a variety of claims are typically used to cover the invention with differing scopes of protection.

For example, in the US you can include various types of claims (e.g., method claims, composition claims, and device claims) that cover various aspects of the main invention. This strategy ensures that in a typical US application prior art that anticipates or renders obvious specific claims leaves other claims intact.

Other high-level similarities and differences include:

US claiming style

- Multiple independent claims
- One-part format
- Short preambles
- Focus on structure whenever possible
- Avoid functional limitations
- Avoid recitations of intended use (e.g., “for...”)
- Avoid using different terms for the same elements
- Avoid multiple dependencies

European claiming style

- Generally one independent claim per category
- Two-part format preferred
- Much longer preamble in the two-part format
- A characterising portion contains the features distinguishing the claims from the primary reference
- Focus on structure whenever possible
- Avoid functional limitations
- Avoid recitations of intended use (e.g., “for...”)
- Avoid using different terms for the same elements
- Multiple dependencies are permissible and helpful in view of the support standards

Functional claims

Functional claim elements (also known as means plus function claim elements in the US) are permissible in both jurisdictions. In the US, claim elements that in-

clude the language “means for” or “step for”, or words such as “mechanism,” “module,” “device,” “unit,” “member,” and the like, followed by a function rather than structure can be interpreted under Section 112(f). Given this interpretation, the scope of such claim elements is limited to cover only the corresponding elements or examples recited in the specification and equivalents thereof, which can be a narrower scope than absent the 112(f) interpretation. For example, if the specification includes only one example of a given claim element, then the scope of that claim element may be quite narrow. On the other hand, if the specification includes no examples at all, then this could raise a far more significant problem, e.g., lack of enablement, which could render an application unpatentable, or a patent invalid.

Functional claims are more common in Europe, which can pose challenges for applications drafted in the European style and later filed the US. It is therefore important to review both the claims and the specification carefully when preparing a US national application to find and evaluate any possible functional claim elements.

The Boards of Appeal (BoA) of the EPO commonly distinguish between two types of functional features: (a) process steps that are known to the skilled person and may be performed easily by that person, and (b) process steps that recite the result to be achieved. The latter type is permissible only if (i) from an objective viewpoint, such functional features could not otherwise be defined more precisely without restricting the scope of the invention; and (ii) these features provide instructions that were sufficiently clear for the expert to reduce them to practice without undue burden, including with reasonable experiments if necessary (*T 68/85*).

Practice tips

- Draft applications to cover all important feature combinations to meet both US and European requirements.
- Use multiple independent claims to cover various aspects of an invention for US practice but ensure that the main claims also meet EPO requirements.
- Use consistent terminology in the claims and specification.

Amendments

In Europe, Article 123(2) EPC sets very strict requirements for amendments to patent applications. Generally, European patent applications and patents (in opposition) may not be amended in such a way that they contain subject matter that extends beyond the content of the application as filed or that extends the protection conferred. The legal standard for claim amendments is that the added claim language has direct and unambiguous derivability from the application as filed (ideally, this would be verbatim support).

Lack of support issues are common in European patent prosecution but can be avoided through effective application drafting. For example, taking features from the drawings or a particular embodiment and adding them to the claims may be prohibited if considered to be an unallowable generalisation. However, such intermediate generalisation is not an issue when (a) the feature is not related or inextricably linked to the other features of a specific embodiment, and (b) the overall disclosure justifies the generalising isolation of the feature and its introduction into the claim. Applicants should thus draft applications covering all important feature combinations and include reasonable intermediate features and sub-combinations of features into the description.

Similarly, applicants should not delete an essential feature from an independent claim as originally filed. Deleting such a feature from an independent claim is permissible only if (a) the replaced or removed feature was not explained as essential in the originally filed disclosure, (b) the feature is not, as such, indispensable for the function of the invention in the light of the technical problem solved by the invention, and (c) replacement or removal requires no modification of one or more features to compensate for the change. This is a difficult test to pass, so applicants should include only the most important features into their independent claims.

During EPO prosecution, you should not amend your main claim to add a limiting feature that lacks verbatim support to help avoid the so-called inescapable trap during opposition. In this scenario, you cannot remove that limitation, because that would broaden the claim, which is not permitted in an opposition. In addition, you cannot leave the feature in the claim, as that is also not permitted if you have insufficient written support. Thus, in this scenario, the patent can be revoked in its entirety.

In the US, patent law also prohibits adding new matter when amending a claim or the specification, but the support requirements are quite a bit more relaxed than in the EPO. For example, claims can be amended to add subject matter that is recited in the specification, examples, and figures, and there is no requirement for verbatim support. However, the applicant must still show that there is some factual support in the application to avoid the claims from being rejected for including subject matter that was not originally described in the application.

Practice tips

- Describe intermediate combinations and sub-combinations of features in the specification.
- Specify the technical effects that flow from the invention for best support in European practice, and this may be helpful for US prosecution as well.
- Do not amend a claim in a European patent application to add a limiting feature that lacks verbatim support.
- If elements shown in figures are likely to be important, describe those elements (preferably in claim-like language) in the description in detail.

Declarations and post-filing data

In the US, post-filing data can be submitted in the form of declarations. Submission of declarations is common in US patent prosecution practice. For example, Rule 132 declarations, can be used by patent applicants to:

- Rebut Section 101 rejections
- Rebut Sections 102 and 103 rejections, such as by showing test results, commercial success, inoperability of the referenced combination, long-felt unresolved need, or mischaracterisation of a reference by the examiner
- Rebut Section 112 rejections, such as by establishing the level of knowledge in the field
- Rebut a holding of undue experimentation
- Rebut allegations of inherency in prior art disclosures

Rule 130 declarations can also be used by the applicant to avoid prior art published less than one year before the filing date. This can be accomplished by establishing entitlement to the one-year grace period or by disqualifying a prior disclosure as not being a part of the prior art. To disqualify a prior disclosure, the declarant can (a) show that the disclosure was made by or obtained from the inventor(s) (declaration of attribution), or (b) establish that disclosure had, before such disclosure was made or effectively filed, been publicly disclosed by the inventor(s) (prior disclosure declaration). Such prior disclosure declarations are referenced on the face of the patent and are not recommended for applications that will subsequently be filed in Europe, because such admissions can be used to extinguish foreign patent rights.

In the US, the general rule of admissibility for post-filing data is that the patent examiner should accept as true what is submitted in a declaration unless he or she has a reason not to accept the truth of the declaration. In the US, the prohibition against inequitable conduct can be used to challenge declarations later in litigation. However, this is not the case in Europe. Rather, the admissibility of post-filing data in Europe depends upon whether the application as filed provides a plausible disclosure to the problem that has been put forward in the application. As a result, the ability to submit post-filing data is comparatively limited in Europe.

The root of the plausibility doctrine in Europe comes from the 2005 BoA decision *T 1329/04*, which defines an invention as being a contribution to the art, i.e. as solving a technical problem, and requires that: “it is at least made plausible by the disclosure in the application that its teaching solves indeed the problem it purports to solve.”

To have an invention, the applicant must therefore show that the application at least makes it plausible to conclude that a problem has been solved rather than merely identified. If an effect is found not to be plausi-

ble in view of the application as filed, the plausibility issue cannot be remedied using post-filing evidence under many circumstances.

Practice tips

- Include all available data relevant for the invention in the application to be filed.
- Link the data to the technical teaching.
- Strike a balance between securing an early filing date and trying to clear the plausibility hurdle in later prosecution.

By keeping in mind the differences and similarities between the patentability requirements and prosecution schemes in the US and in Europe, applicants can prepare patent applications that will best serve their needs in both jurisdictions.



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