DIFFERENCES BETWEEN US AND EUROPEAN PATENT APPLICATIONS

Marianne Holme
Holme Patent A/S

The differences in the ways US patent and European patent (EP) applications are drafted often pose problems during substantive examination when an EP application is filed based on a US application.

In general, only a single independent claim in each category (product, process, apparatus or use) is allowed in an EP application but multiple dependent claims are possible. The advantage of using multiple dependent claims is that it is possible to define many different embodiments using a limited number of claims.

In contrast to EP practice, US applications may have a multiplicity of independent claims, for example due to a very specific prior art reference precluding consolidation of some independent claims into a more generic independent claim. In the majority of US applications, dependent claims refer to just one main claim and although multiple dependent claims are possible they are subject to extra fees and are rarely used.

Upon entry of the US application into the regional stage at the European Patent Office (EPO) the number of US claims can be and often are reduced using multiple dependent claims. But often the various main claims of the US application use different terminology to identify a feature. This makes it difficult and sometimes impossible to redraft the main US claim to a dependent EP claim.

A further problem is that an embodiment defined in a new claim consisting of the main claim and two separate claims, where each is dependent only on the main claim, need not automatically be part of the original disclosure.

Therefore, conferring features from main claims to dependent claims, introducing multiple dependent claims and compiling a main claim with more that one claim depending on it, should be done very carefully. Amending a species to a genus, which is sometimes possible in a US claims, is in general impossible in EP claims.

A meticulous and careful study of the overall disclosure of the EP application is essential to avoid violation of Article 123(2) of the European Patent Convention during substantive examination. It can be very difficult to remedy deficiencies associated with the addition of subject matter once the EP patent is granted, making the EP patent vulnerable to revocation in opposition proceedings.

EP claims written in means-plus-function language normally cover all means for performing a recited function. In the US claims, means-plus-function language is limited to the specific structures, materials, or acts disclosed in the specification, plus any equivalents that are clearly linked to performing the function.

"SINCE A FEATURE NORMALLY CANNOT BE ISOLATED FROM AN EMBODIMENT, THE CLAIMS THAT EVENTUALLY GET GRANTED HAVE A LIMITED SCOPE OF PROTECTION."

A further difference is the way the descriptions are drafted in US and EP applications.

An EP patent application includes a general description serving as a 'claim implementation'. Advantages of the features of each claim are carefully discussed in view of providing reference and support for later arguments about inventive step using the EPO's problem-solution approach to overcome some prior art references deemed pertinent to the invention.

The US application is structured differently. As set out by The Federal Circuit, claim construction in a US application should be done using parts of the description. Certain sections of the specification are more likely to contain statements that support a limiting definition of a claim term than other sections. Therefore objectives are often deliberately left out and advantages not discussed in the general description of a US application, so the European patent attorney must turn to the detailed description of the various embodiments for identifying inventive features and find support for arguments favouring novelty and inventive step of this feature. Since a feature normally cannot be isolated from an embodiment, the claims that eventually get granted have a limited scope of protection and often the possibility of filing divisional applications has expired.

Consideration of EPO requirements during preparation of an original US application is often not optimal to the applicant, since EPO requirements seem to conflict with US requirements.

One solution is to draft separate US and EP applications. Another solution is to revise and adapt the text of the original US application to comply with EPO requirements within the priority year and use the revised text for either an EP application or a Patent Cooperation Treaty application.

These approaches can save considerable time and cost, and increase the likelihood of obtaining broad, valid and enforceable EP claims. ■

Marianne Holme is a European patent attorney and partner at Holme Patent A/S. She can be contacted at: mh@holmepatent.dk