



IP LAW ADVISORY

July 15, 2008

What's "New" in Europe?

By James C. De Vellis, Esq.

The decision to file a foreign patent application is often made after a patent application has been prepared and filed by a United States patent attorney in the United States Patent and Trademark Office (USPTO). This business decision is driven by case-specific factors including markets for the invention, client and competitor locations, enforcement considerations, and costs over the life of the application and any resulting patent.

Concerns regarding prosecution of an application in Europe can be missed when reviewing a patent application drafted for the USPTO, even though the same patent application may subsequently be filed with the European Patent Office (EPO). A brief review, prior to a first filing with the USPTO, which considers the European analysis of amended claims for potential "new matter" pitfalls can forestall fatal problems during EPO prosecution.

Much like the USPTO, the EPO includes a new matter prohibition, which requires that support for the subject matter of claim amendments made during patent prosecution be found in the application as originally filed. In other words, claim amendments cannot introduce anything new into a patent application. The EPO applies a particularly high level of scrutiny when determining if amended claims are supported by the application as filed. This can catch applicants off guard, leading to problems regarding new matter in Europe that are difficult to overcome.

When deciding if a claim has been impermissibly amended to include new matter, the legal standard applied by the EPO is whether or not a claim amendment is directly and unambiguously derivable from

the application as filed. If the language of the claim amendment is not recited verbatim in the application, reliance on inherent or implicit disclosure is sufficient only if it is a clear and unambiguous consequence of what is explicitly mentioned.

Absent literal, verbatim disclosure, deliberately ambiguous language in a patent application that describes alternative or indeterminate terminology (e.g., "or" or "may") for multiple features of the invention in a single phrase cannot be used as implicit support for a claim amendment directed toward one of those many features. The EPO takes the position that such an amendment is not unambiguously derivable from the application. The EPO makes it clear that implicit support for an amendment must inevitably lead to, and only to, the amendment. When relying on implicit, as opposed to verbatim, support for a claim amendment directed toward one feature, ambiguous disclosure of several features lumped into a single phrase of the patent application is insufficient because it leads to many possible conclusions. The EPO considers this to be ambiguous.

As patent applications are drafted to preserve claim amendment flexibility regarding various features or embodiments of the invention, applicants interested in Europe should review their patent applications prior to filing in any patent office to see if ambiguous language is used to provide support for multiple features of the invention. Although some use of this language can be desirable from a U.S. viewpoint, supplementing it with several

(continued →)

This material is for general information purposes only, is current only as of the indicated date, and should not be regarded as legal advice. Providing this information is not intended to create an attorney-client relationship. You should not act upon this information without seeking professional legal advice.

What's "New" in Europe?

(continued)

affirmative statements, each of a single feature, can facilitate an EPO finding of implicit support for a claim amendment directed toward that feature.

With this simple review, proactive applicants, aware of the level of scrutiny applied by the EPO regarding support in the application for claim amendments, can draft a robust and flexible patent application suitable for both U.S. and European patent prosecution.

If you would like to discuss these issues, you may contact James De Vellis at JDeVellis@LL-A.com.