Preparing European Priority Applications for Stronger U.S. Patents

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The current U.S. patent climate mandates a heightened focus on quality prosecution. For consumer product companies headquartered in Europe, and for those that regularly innovate there, this means preparing and filing European patent priority applications that will produce U.S. patents that withstand the scrutiny of PTAB challenges, like *inter partes* review and post-grant review. It also requires priority applications that provide U.S. practitioners with the flexibility to obtain stronger claims that cover all aspects of the invention and avoid easy design arounds. Without first aligning EP priority cases with U.S. best practices, the most important patents in your portfolio may fail to deliver the maximum return on investment.

Nothing is a substitute for a comprehensive global prosecution strategy that aligns best practices in all jurisdictions. But here are a few quick tips for preparing EP priority applications with stronger U.S. patents in mind:

1. **Use EP appropriate claims, but have claims suitable for the U.S. at the ready.** Rules 43(2) and 62(a) of European Patent Convention guidelines limit the form and content of claims to no more than one independent claim in the same category (product, process, apparatus or use). Restrictive European Patent Office claim fees often limit the number of claims presented as well. This can lead to initial claim sets for the U.S. application that are unnecessarily narrow and abbreviated. Budget constraints notwithstanding, EP practitioners should consider additional claims that use different vantage points for describing the invention and that vary claim scope to adequately cover all features of the invention. Under Rule 43(1) EPC two-part style claims are required “wherever appropriate”. In many cases this format may be added later on during EP examination. In order to avoid unnecessarily limiting future U.S. claim strategies, EP practitioners should consider using a U.S. friendly claim style whenever possible. This includes using variety in claim preambles. For consumer product inventions, one strategy is to avoid only using simple preambles (e.g., An apparatus, comprising), and instead provide more meaningful, but no more limiting, preambles that provide clarity of the invention while also landing your application in the most appropriate art unit.

2. **Draft your specification with a more robust disclosure.** Even when fewer claims are presented in an EP priority application, practitioners must avoid allowing this decision to restrict the description of the invention. The specification should describe as many details as possible, including additional embodiments, possible design arounds that go beyond the commercial embodiment, and fall back positions and ranges, for example. A complete disclosure will limit exposure to new matter rejections during U.S. prosecution, which, in turn, will reduce the risk of priority attacks and intervening prior art in PTAB challenges. A full disclosure will allow for more voluminous claims sets that can also be an effective deterrent to patentability challenges.

3. **Increase attention on the figures.** EP patent practice is not as reliant on the specification figures as U.S. practice, where drawings often form the basis for claim amendments. For consumer products in mechanical technologies, drawings may have heightened importance. To maximize prosecution flexibility in the U.S., EP counsel should consider using more figures than required, making sure they are well prepared and technically...
accurate. The figures should include, and have reference to, all elements that could possibly be claimed later in order to avoid pesky drawing objections from U.S. examiners under 37 CFR 1.83(a). As an added benefit, a complete set of drawings can compensate for textual shortcomings that often result from translations.

4. **Consider effects of recent U.S. case law.** Over the last several years, a number of impactful patent cases have changed the way U.S. practitioners approach application preparation. EP priority cases should adopt these strategies whenever possible. Claims must be definite, and EP priority cases should be mindful when using subjective terms and terms of degree (e.g., “substantially”, “near”) in independent claims, at least when not also including alternative language and examples in the specification and in dependent claims. The priority specification also should enable claims that utilize different infringer vantage points along the product stream of commerce and that avoid divided infringement issues when possible.

5. **Ensure global counsel communication.** Perhaps the most important – and easiest – strategy to implement is one that establishes effective communication among your global prosecution team. While exchanging drafts of the priority application is not always practical, an annual presentation that educates global co-counsel on the latest U.S. case law and developments at the PTAB may be more realistic. The ensuing open dialogue and sharing of ideas will lead to consistently well drafted priority cases in the EP, the U.S., and wherever else the application may be filed.

Of course, many other techniques are useful in preparing the strongest possible EP priority case. Having a complete strategy will increase the likelihood of withstanding future patentability challenges in the U.S. and will improve overall quality of the patent portfolio in a way that facilitates prosecution in all targeted jurisdictions.

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