



CONVERGENCE OF PRACTICE

CLAIM DRAFTING AND STRUCTURE

IOANA FINTOIU | PATENT EXAMINER DIR. 1213 | 9 OCTOBER 2023

COMPOSITION OF WORKING GROUP 5

"Claim drafting and structure"

22 participating contracting states + 1 extension state

AT, BG, CZ, DE, DK, ES, FI, FR, GB, GR, HR, HU,
IT, LT, LV, ME, NL, NO, PL, PT, SE, SM + BA



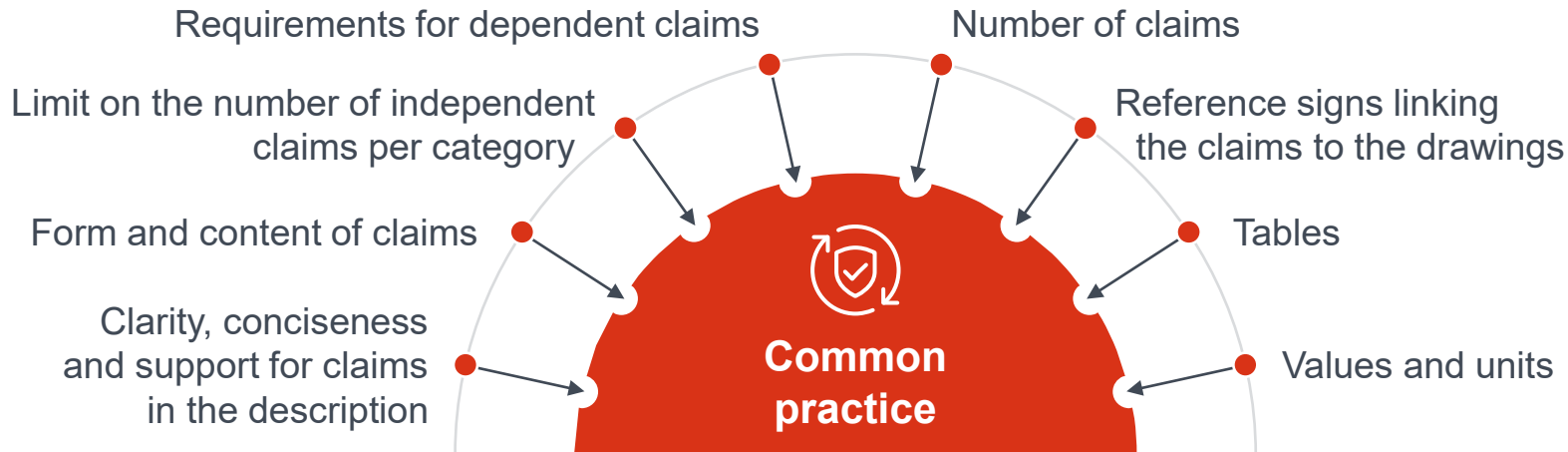
EPO



Observers

epi, BusinessEurope

BREAKDOWN OF EIGHT-PART RECOMMENDATION



CLARITY, CONCISENESS, AND SUPPORT FOR CLAIMS IN THE DESCRIPTION

- Clarity, conciseness, support in the description not (explicitly) required by some jurisdictions
- Alignment of these requirements would be very advantageous as it would ensure consistent practice and case law
- Recommendation of the WG:
 - Offices are to provide that the claims are clear and concise and are fully supported by the description, in line with the provisions of the Patent Cooperation Treaty (Article 6 PCT).

FORM AND CONTENTS OF CLAIMS: TECHNICAL FEATURES

- In a few States there is no express provision in their legislation to that effect.
- WG recommends that Offices are to provide that the claims define the matter for which protection is sought in terms of the technical features of the invention, in line with Rule 6.3(a) PCT.
- This means that claims are not to contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose are to be allowed if they assist in defining the invention.

FORM AND CONTENTS OF CLAIMS: TWO-PART FORM OF CLAIMS

- Most of the Offices prescribe the two-part form. But there are exceptions/special reasons for not using it. In one Office, the two-part form is not explicitly prescribed but is adopted in practice. One Office stated that it is left to the discretion of the applicant whether to use it and one Office replied that no form is prescribed.
- In view of these discrepancies, the WG recommends that Offices adopt the two-part form for claims, wherever appropriate, in line with the provisions of the PCT.
- Rule 6.3(b) PCT defines the two-part form which a claim should take "whenever appropriate".
 - The first part should contain a statement indicating the designation of the subject-matter of the invention, that is, the general technical class of apparatus, process, etc. to which the claimed invention relates, followed by a statement of those technical features "which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art".
 - The second part or "characterising portion" should state the technical features which, in combination with the features stated under the first part.

FORM AND CONTENTS OF CLAIMS: HANDWRITTEN CLAIMS

- A few Offices responded that handwritten claims are accepted.
- WG recommends that Offices are to provide that claims are typed or printed as this facilitates the electronic processing of patent applications. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be drawn or written by hand.
- This is without prejudice to any more liberal requirements of the Offices as regards the accordance of a date of filing of a patent application.
- Applicants may file applications containing claims that are not typed or printed for the purpose of obtaining a filing date. However, at a later stage, Offices may require applicants to file typed or printed claims as a formal requirement.

LIMIT ON THE NUMBER OF INDEPENDENT CLAIMS PER CATEGORY

- Most national Offices have no limit imposed in their jurisdiction. In some Offices, generally only one independent claim per category is permitted. Most of these Offices also outlined some exceptions to this general requirement.
- Recommendation's aim: simplified discussion with the applicants on inadmissible claim proliferation but without changing the scope of protection obtainable.
- Too many claims make it difficult for third parties/judges to determine the scope of protection conferred by the patent. If the number of independent claims in a patent application gives rise to objections under the requirements of clarity and conciseness of the claims (Article 6 PCT), an examiner can insist on a limitation of this number by strictly applying these requirements.
- However, they must provide detailed reasons demonstrating that the objections are a direct consequence of the presence of excessive independent definitions of the subject-matter for which protection is sought.
- Considerable increase of procedural efficiency if the examiner has at their disposal a requirement imposing a clear limitation on the number of independent claims.

LIMIT ON THE NUMBER OF INDEPENDENT CLAIMS PER CATEGORY

- Recommendation sets up and defines the principle of "one independent claim per category" (see Rule 43(2) EPC). The only admissible exceptions are explicitly stated in the recommendation. This relieves the examiner of the requirement to provide lengthy substantive reasoning.
- An applicant wanting more than one independent claim in the same category must, if an Office objects, convincingly demonstrate that all the additional independent claims come under one of the exceptions explicitly given in the recommended provision. So the onus is on the applicant.
- Examples of typical situations falling within the scope of the exceptions from the principle of one independent claim per category can be shown in examination guidelines or similar texts. The EPO Guidelines for Examination contain examples of the specific circumstances as well as some examples of allowable claim types.
- Examples of a plurality of interrelated products (sub-paragraph (a) of the recommendation) are: plug and socket; transmitter – receiver; intermediate(s) and final chemical product; gene – gene construct – host – protein – medicament.

REQUIREMENTS FOR DEPENDENT CLAIMS

- No full alignment as regards the placement of the reference to another claim at the beginning of the dependent claim, if possible.
- WG recommends that Offices are to provide that any claim which includes all the features of one or more other claims ("dependent claim") does so by a **reference**, if possible at the beginning, to the other claim or claims and then states the additional features claimed, in line with the provisions of the Patent Cooperation Treaty (see Rule 6.4(a) PCT).
- WG also recommends that Offices provide that all dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, are **grouped together** to the extent and in the most practical way possible, in line with the provisions of the PCT (Rule 6.4(c) PCT).
- Arrangement must be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed.

NUMBER OF CLAIMS

- All Offices replied that there is no explicit limit imposed on the **overall number of claims** in an application. Some Offices highlighted further that their jurisdiction foresees generally that the number of claims may be limited in some way.
- WG recommends that Offices are to expressly provide that the number of claims is reasonable in consideration of the nature of the invention claimed.
- "Reasonable number" depends on the facts and circumstances of each particular case. The interests of the relevant public must also be borne in mind. The presentation of the claims must not make it unduly burdensome to determine the matter for which protection is sought (see also Rule 6(1)(a) PCT)

CLAIMS FEES

- Most replies from the Offices show that an **additional fee** is prescribed where the applicant exceeds a certain number of claims. Responses were varied as to the number of claims triggering an additional fee.
- WG is of the opinion that there should be an incentive for applicants not to exceed a certain number of claims. It therefore recommends in particular that Offices are to provide that the applicant is to pay a fee if they exceed a certain number of claims, which is to be determined by the Offices in accordance with the applicable national law. The amount of this fee is also to be determined by the national Offices.

APPLICATIONS CONTAINING DRAWINGS: REFERENCE SIGNS LINKING THE CLAIMS TO THE DRAWINGS ("REFERENCE SIGNS")

- A few national Offices responded that they do not have any requirements regarding the use of reference signs in claims.
- WG recommends: if a patent application contains drawings and the technical features of the claims would be rendered more intelligible by relating those features to the corresponding features of the drawings, this is preferably to be done by placing the appropriate reference signs in parentheses after the features in the claims (see Rule 6(2)(b) PCT).
- These reference signs should not, however, be construed as limiting the scope of a claim, but merely as aids for more easily understanding the defined subject-matter.

TABLES / VALUES AND UNITS

- A few Offices answered that the claims are not allowed to contain **tables**
- WG recommends that Offices are to provide that the claims may contain tables only if their subject-matter makes the use of tables desirable. In view of the use of the word "desirable", the examiner should not object to the use of tables in claims where this form is convenient
- Not all Offices provide a list of the accepted standards for **values and units**.
 - WG recommends that Offices are to provide a list or overview of units recognised in international standards and complying with national requirements (see the EPO Guidelines for Examination at the EPO, F-II, Annex 2 for an example of such a list)
 - conducive to a common understanding and makes examining procedure more efficient and transparent for all parties.
 - enables the examiner of each Office to more easily raise deficiencies regarding values in a claim that are not expressed in units conforming to international standards.

THANK YOU FOR YOUR ATTENTION

Ioana Fintoiu

Patent Examiner Dir. 1213