



## Guidelines for prosecution of European patent applications

The prosecution of European patent applications differs from the prosecution in other countries. Therefore, it is sometimes difficult or even impossible to realize the instructions of our foreign clients and associates. The following guidelines are therefore intended for giving our foreign clients and associates a better understanding of the principles of prosecution before the European Patent Office (EPO).

### I. Claim amendments

The EPO is very strict with regard to the admissibility of claim amendments. The subject-matter of amended claims needs to be disclosed in the original application documents either literally or unambiguously derivable. For example, the following claim amendments are generally not admissible:

- Claiming a feature which is merely shown in the original drawings.
- Generalizing an originally disclosed feature (e.g. "transistor") to a general term (e.g. "switching element").
- Picking a single feature from an originally disclosed combination of features ("cherry picking").
- Picking a feature from the abstract of the patent application.

Further, the applicant is obliged to indicate the support for amended claims in the original application documents, i.e. the applicant should file a working copy of the amended claim set showing the amendments vis-à-vis the original claim set.

Therefore, if you propose claim amendments, please

- make sure that the subject-matter of the amended claims is disclosed in the original application documents either literally or unambiguously derivable, and
- indicate the support for the claim amendments in the original application documents, and
- provide a working copy of the proposed new claim set showing the amendments vis-à-vis the original claim set.

### II. Number of independent claims

In general, a European patent application may not contain more than one independent claim in each category (apparatus/method). Therefore, it is generally not admissible to have more than one independent apparatus claim and/or more than one independent method claim (cf. Rule 43 (2) EPC).

However, there are the following rare exceptions:

- The independent claims refer to a plurality of interrelated products (e.g. a socket and an adapted plug, a transmitter and an adapted receiver).
- The independent claims refer to different uses of a product or apparatus.



- The independent claims define alternative solutions to a particular problem where it is inappropriate to cover these alternatives by a single claim.

Therefore, please do not propose claim sets comprising more than one independent claim in each category (apparatus/method) unless there is clearly one of the afore-mentioned exceptions.

### III. Reference signs in the claims

Where the European patent application contains drawings including reference signs, the technical features specified in the claims shall be followed by such reference signs relating to these features, placed in parentheses. These reference signs shall not be construed as limiting the scope of protection (cf. Rule 43 (7) EPC).

Therefore, please insert reference signs in the claim set if you provide a proposal for an amended claim set. Otherwise, we have to insert the reference signs in the claim set, which is time-consuming and therefore leads to additional costs.

### IV. Unity of invention

If the claim set of a European patent application comprises a group of inventions (e.g. several independent claims, alternatives in an independent claim), the requirement of unity of invention is fulfilled only if there is a special technical relationship between the inventions. The expression "special technical features" shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art (cf. Rule 44 EPC). In other words, the independent claims of a European patent application generally need to have a distinguishing feature in common.

Therefore, please do not propose amended claim sets comprising several independent claims which are not linked by a common distinguishing feature.

### V. Information disclosure statement

If a European patent application claims priority of an earlier application, the applicant is obliged to file an information disclosure statement including copies of the results of any prior art search relating to the earlier application (cf. Rule 141 EPC). Further, please note the following:

- The applicant has to file copies of the official communications (e.g. search report, office action). It is not sufficient to compile a list of the cited prior art references.
- The information disclosure statement has to be updated as long as the European patent application is pending before the EPO.
- It is not necessary to prepare translations into one of the official languages of the EPO.
- It is not necessary to file copies of the cited prior art references.
- This obligation does not cover the official search results relating to other patent family members claiming the same priority.

- This obligation applies to all European patent applications having a filing date on or after January 1, 2011.

Therefore, please send us copies of all official communications (e.g. search reports, office actions) relating to the priority application of a European patent application, if prior art references are cited therein.

#### VI. Claims fees

The EPO charges claims fees in the amount of EUR 210,00 for each claim exceeding 15 claims and EUR 525,00 for each claim exceeding 50 claims. For example, a claim set of 55 claims results in official claims fees in the amount of EUR 9.975,00.

Therefore, any European patent application should be filed with a claim set comprising not too many claims.

#### VII. Divisional patent applications

The EPO has introduced official terms for filing divisional patent applications. These official terms generally expire two years after the delivery of the first office action issued by the Examining Division.

Therefore, please inform us in due time if you wish to file a divisional patent application.

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For further questions please contact:

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