
Articles

European and Japanese Patent Practice

Jeremy Webster*

This paper discusses some differences between patent practice in Japan and Europe. It is hoped that the discussions and examples provided in the paper provide useful guidance to Japanese patent professionals who use or may wish to use the European patent system to obtain patent protection in Europe. When discussing European practice, reference is made, where appropriate, to the provisions of both the European Patent Convention (EPC) and the revised version of the EPC, EPC2000, which will come into force on 13 December 2007. (For guidance, EPC2000 changes the numbering of the Rules but not the numbering of the Articles).

Naturally, a discussion of differences between Japanese and European patent practice could be the subject of many papers and so, in order to make this paper more manageable, the focus is on those points of European patent practice that may be of particular interest to Japanese patent attorneys, attorneys at law and other patent professionals.

Many Japanese patent professionals will already have experience of the numerous differences between patent practice at the Japan Patent Office (JPO) and at the European Patent Office (EPO). Some of these differences can be explained by the nature of the European patent system, which gives rise to a collection of national patents, as compared to the national system in Japan. Other differences reflect the way in which patent applications are examined by the respective patent offices.

This paper looks at a selection of the more noticeable differences between the two systems and also provides suggestions from a European perspective as to how some of the EPO pitfalls might be avoided. Also, it discusses some of the imminent changes under EPC2000 and suggests how these might be dealt with. Naturally, the topics discussed in this paper are not comprehensive and on a case-by-case basis there will of course be significant (and no doubt frustrating) differences in the progress of corresponding applications at the two patent offices.

* European and UK Chartered Patent Attorney, Mewburn Ellis LLP (www.mewburn.com)

This paper starts with a brief overview of the European Patent System and an update on various proposals intended to make Europe a more cost-effective place to obtain and enforce patent rights.

It then goes on to look at differences between EPO and JPO practice in terms of filing a new patent application, procedure, substantive law, and prosecution practice.

Introduction

1. Review of the European Patent System

Unfortunately, there is still no unitary (single) patent to cover all of the countries in Europe. In the last five years or so, there has been considerable discussion about a possible "Community Patent" to cover all member states of the European Union (which are all contracting states of the EPC). However, progress on this proposal has stopped and there does not appear to be any chance of a Community Patent in the foreseeable future.

National patent applications and the EPC therefore remain the only options for obtaining patent rights in Europe.

The EPC provides a centralized system of examining and granting patent applications, which results in a collection of national patents. At present, there are 32 contracting states to the EPC. Norway will join as the 33rd contracting state on 1 January 2008. The EPC therefore provides a route to patent protection across a very substantial part of Europe.

In fact, for most contracting states to the EPC, a national patent will only come into force if further procedural steps are

carried out after grant of the European patent at the EPO. Thus, with a few exceptions, a patent granted under the EPC does not have effect in the contracting states of the EPC until it has been validated in each of the contracting states of interest, as discussed below.

The EPC system therefore provides a three step procedure for obtaining one or more national patents:

- (1) Filing and Prosecution
- (2) Grant
- (3) Validation

Steps (1) and (2) take place at the EPO. Step (3) takes place in each of the national patent offices where a national patent is desired.

Validation step (3) includes, for nearly all of the EPC contracting states, one or more of the following:

- (i) paying an official fee to the national patent office
- (ii) filing a translation of the patent (unless the language of the granted EP patent is acceptable in that country); and
- (iii) providing an address for service.

After step (3), national law applies to each of the national patents. This means that national patent offices and courts determine validity

However, there is an exception: the EPO opposition procedure, which is discussed below.

In contrast to the European system, the structure of the Japanese patent system is more straightforward, as might be expected from a national patent system.

Thus, there is no need for a "validation" (step 3) procedure, although "grant

fees” are due before a patent can come into force.

Naturally, national law applies to validity after grant in Japan. The JPO has jurisdiction over challenges to validity, except in response to an infringement law suit, in which case the District Courts will hear the case.

1) EPO Opposition Procedure

Within 9 months of the grant of a European patent, any person can oppose the European patent. This means that even though a patent may have been validated in one or more contracting states (possibly at considerable expense), and is therefore governed by national law in those countries, it is still possible to challenge the validity of the patent at the EPO.

This means that infringement and validity law suits can be pending in national courts at the same time as opposition proceedings at the EPO are taking place. In order to avoid this situation, some national courts will delay hearing an infringement/validity case until EPO opposition proceedings have been completed. However, in the UK, the courts have recently moved towards proceeding with the national litigation without waiting for the EPO opposition to be resolved. A significant factor in the UK courts’ decision is the long delays at the EPO in dealing with opposition cases. For guidance, an opposition at the EPO may take between 18 months and 3 years. An appeal from an opposition is likely to take a further 2 to 3 years.

2) Language and Costs

The centralized prosecution and grant procedure at the EPO is cheaper and more convenient than filing multiple national applications in contracting states.

In particular, whereas multiple translations might be needed before (or shortly after) filing if national applications were filed in several countries, the EPC route requires a filing in only one language (English, French or German). Under EPC2000 it will be possible to file in any language, including Japanese. But a translation into an official language of the EPO must be submitted within 2 months of filing. For PCT applications entering the EPO regional phase, a translation, if needed, must be filed by 31 months from priority.

However, while the EPC route may provide cost savings on translations and official fees when filing a new application, as compared to multiple separate national applications, the cost of the validation procedure after grant of the European patent can be high. This is because of the need for translations and payment of official fees, as discussed above. Thus, the total cost of translations is not necessarily reduced with the EPC system, but it is delayed until such time as the applicant knows the scope of any patent that is to be granted. This means that a more informed decision can be made as to which countries should be selected for validation.

According to statistics published by the EPO, on average a European patent is validated in 7 countries, requiring translation into 5 languages. The London Agreement, discussed below, may reduce the number of translations for a typical European patent, but it depends on the countries concerned.

In the Japanese system, there are substantial initial translation costs for foreign applicants. However, cost at grant is low.

Although this paper concentrates on

the EPC system, it is useful to remember that applications can be filed directly in individual countries in Europe: it is not compulsory to use the EPC system. If only one or a few countries are important to the applicant, then national filings may be a sensible option. However, beware: for PCT applications, there are a number of European countries for which patent protection can be obtained only via the EPC; they are: FR, GR, IE, IT, BE, NL, MC, SI and CY. So, if an applicant has a PCT application and wants protection in those countries, it is necessary to use the EPC route.

2. Proposals in Europe

Three proposals for reducing the cost of obtaining and enforcing patent rights in Europe are discussed below.

1) Community Patent

This proposal is currently dormant and, at the time of writing this paper, there were no plans to discuss it again in the near future. Nevertheless, it is a proposal that could, in theory, be revived at any time by the European Union (EU). But this seems unlikely to happen until there is agreement on the language issues, discussed below.

Briefly, the proposal is that the EU would produce a Regulation that would bring a Community Patent into effect for all the member states of the EU. Thus, the legal basis for the Community Patent would be EU law. This is different from the EPC, which is an independent convention not controlled by the EU. However, currently, all 27 member states of the EU are also contracting states of the EPC so the legal basis for the Community Patent would allow 27 of the 32 contracting states of the EPC to be

covered by the Community Patent.

In this respect, the Community Patent would be like the Community Design Regulation (RCD) and Community Trade Mark Regulation (CTM) in that it would cover the whole of the EU.

The Community Patent proposal also includes provisions for dealing with validity and infringement after grant. A unitary Community Patent would be enforceable in Community Patent Courts, which would be established in each of the EU states. The European Court of Justice (ECJ) would hear appeals and make final binding decisions on matters of law. This is similar to the CTM and RCD systems.

Part of the proposal is for the EU to become a contracting state of the EPC. This would allow the EPO to examine and grant patents that designated the "Community Patent". When granted by the EPO, there would be a validation step for the Community Patent, just as there is for other contracting states.

Unfortunately, no agreement could be reached on the translation requirements for the validation step and so the proposed EU Regulation did not proceed.

Further information can be found at: http://patlaw-reform.european-patent-office.org/community_patent/index.en.php

2) The London Agreement

This agreement relates to the validation step of the EPC system. The current requirement in most EPC countries is for a translation into the official language of that country of the entire specification of the European patent. Of course, if the European patent has been granted in the official language of a country, no translation is required.

The London Agreement is a proposal to reduce the number of translations that

would be needed during the validation stage. Contracting states of the London Agreement would agree to dispense with translations into their national official language and instead rely on one of the EPO's official languages (English, French and German).

The London Agreement is not yet in force. It is expected to come into force in the first half of 2008, but not before 1 February 2008. The London Agreement is not compulsory and less than half of the EPC contracting states will be party to the Agreement when it comes into force.

The London Agreement distinguishes between two types of EPC contracting state: (1) those with a national official language that is also one of the EPO official languages (i.e. English, French or German); and (2) those whose national official language is not English, French or German.

Group (1) includes Ireland, France, Germany, Austria, Belgium, Switzerland, Monaco, Luxembourg and Malta (only some of which will join the Agreement at the start; others may join later).

Group (2) includes all of the other EPC contracting states, including, for example, Italy, Spain, Greece, Sweden and Netherlands.

For group (1) countries, there would be no need to file a translation of the European patent. When a group (1) country joins the London Agreement, it will agree that it is sufficient for the patent to be granted in any one of English, German or French.

However, it will still be necessary to translate the claims of a European patent into all three EPO official languages. There will therefore be no change to the current practice of filing claim transla-

tions at the EPO when the Examiner has indicated allowance of the application.

This means that for group (1) countries there would be no requirement for translations beyond what is already required as part of the EPO grant procedure. For example, when the Agreement comes into force, the UK will no longer require translation of the full text of a granted EP patent published in German or French.

This could result in considerable cost savings. For example, if GB, FR and DE (all of which will be parties to the Agreement when it comes into force) were the only countries required for validation, then there would be no translation costs (other than the obligatory claim translations).

However, the cost savings may not be so significant if other countries were required for validation.

For group (2) countries, each country would nominate one of the three EPO official languages. If the European patent is granted in that language, no translation would be required. Only if the European patent was granted in one of the other two EPO official languages would the description need to be translated into the nominated language.

However, even if the European patent is granted in the nominated language, a group (2) country may still require a translation of the claims into their national official language. It is expected that all group (2) countries will require this.

For example, Sweden is a group (2) country (it appears to be ready to ratify the Agreement) and it has nominated English. If a European patent is granted in German, it would be necessary to prepare a translation of the description into English. It would also be necessary to

prepare a translation of the claims into Swedish. However, if the European patent was granted in English, only a translation of the claims into Swedish would be required.

For both group (1) and group (2) countries, if there is a dispute relating to the patent (e.g. alleged infringement), the patent proprietor must, at their own expense, prepare a full translation of the patent into the national official language of the country and send it to the alleged infringer and to the competent national court.

Based on the latest available information, for a European patent published in English, translation will definitely not be required, when the London Agreement comes into force, for the following countries: UK, France, Germany, Switzerland, Ireland, Luxembourg and Monaco.

For a European patent in English, translation of the claims only into the national official language will be required for the following countries: Sweden, Denmark, Iceland, Netherlands, Latvia and Slovenia. This assumes that Sweden and Denmark will ratify, which they are poised to do. Also, that Latvia and Slovenia will nominate English, which it is expected they will do.

When it comes into force, the London Agreement will affect any European patent whose grant date is after the date on which the Agreement comes into force.

In some cases, it may be desirable to delay the grant of a European application so that the London Agreement will apply to it. If the Examiner has already indicated allowance of the application (communication under Rule 51(4) EPC) then the EPO's further processing procedure could be used to delay filing

claims translations and approving the text.

More detail can be found at: http://patlaw-reform.european-patent-office.org/london_agreement/index.en.php

3) European Patent Litigation Agreement (EPLA)

The EPLA is an agreement to establish a system for conducting centralized litigation of European patents.

Currently, litigation of European patents is very expensive. It requires law suits in each country where infringement is alleged to have occurred. As well as the burden of multiple sets of legal fees, the patentee (and alleged infringer) is also faced with the possibility that national courts will reach different decisions based on the same patent and the same alleged infringing act. At present there is no requirement for one national court to follow the decision made by another national court, although in practice they will look closely at the decisions of other national courts.

The EPLA would establish a European Patent Judiciary, comprising a new European Patent Court system. This would allow all the national patents derived from an EP patent to be litigated in a single proceedings.

The European Patent Court would include a Court of First Instance and a Court of Appeal.

The Court of First Instance would have a Central Division established at the seat of the European Patent Court (as yet undecided). It would also include a number of Regional Divisions, which would be established within each of the countries that are party to the agreement. Thus, for example, the UK would designate a court to act as a Regional Division of the Court of First Instance.

The decision of the European Patent Court would be regarded, in all Contracting States, as a decision of the national court of that state. Thus, a decision of the European Patent Court (e.g. a Regional Division in France) could revoke the EP patent in all contracting states.

Progress on the EPLA seems to have stalled recently. The most recent development was the EU Parliament indicating that member states of the EU may be in breach of EU law if they proceed with the EPLA. In particular, the EU Parliament appear to be concerned that the EPLA designates the International Court of Justice (ICJ) as the final level of appeal for matters relating to disputes between Contracting States of the EPLA concerning the interpretation or application of the EPLA. The EU Parliament has indicated that it should be the European Court of Justice (ECJ) that has the final say on disputes between member states of the EU. This appears to miss the point that the EPLA would not be EU law; it would be an independent agreement, which would be open to non-EU states.

More information can be found at: <http://patlaw-reform.european-patent-office.org/epla/index.en.php>

Part A – Filing a New Application

1) Claiming priority

Under the EPC, it is possible to claim priority from Paris Convention countries, but not from WTO countries that are not also party to the Paris Convention (Art 87 EPC/EPC2000).

This is in contrast to Japanese Patent Law which permits a valid claim to priority from Paris Convention or WTO countries (Section 43bis JPA).

Fortunately, this imbalance will be corrected when EPC2000 comes into force on 13 December 2007. For European applications filed after that date, it will be possible to claim priority from both Paris Convention and WTO countries (Art 87(1)(b) EPC2000).

2) Language

A European application can be filed and prosecuted in any one of English, French and German.

In addition, it is possible to file the new application in an official language of one of the contracting states, but only if the applicant is a resident, has their principal place of business, or is a national of that state living abroad. This must be followed by a translation into English, French or German (Art 14 EPC).

When EPC2000 comes into force, it will be possible to file a new European application in any language, provided a translation into English, French or German is filed within 2 months (Art 14 EPC2000). However, this does not apply to PCT applications, where a translation into English, French and German will continue to be required by 31 months from priority.

In Japan, applications can be filed and prosecuted in Japanese. However, an application can also be filed in English, followed by a translation within 2 months or 14 months from priority (Section 36bis JPA).

3) Fees

For direct-filed (non-PCT) European applications, the EPO require the following fees within 1 month of filing: filing fee, search fee and claim fees.

In addition, the exam fee and designation fee(s) are due within 6 months of

the publication of the search report.

Thus, separate search and exam fees are due. This reflects the two-stage search and examination procedure at the EPO. By dividing the procedure and the official fee in this way, the applicant can receive a copy of the relevant prior art and the Examiner's preliminary opinion before deciding whether or not to proceed to examination.

For PCT cases entering the European regional phase, these fees are due within 31 months from the priority date.

The payment of designation fees reflects the fact that the EPC system provides a route to multiple national patents.

One of the changes that will come into force with EPC2000 is that all new applications will be deemed to designate all available states. However, payment of multiple (up to 7) designation fees will still be required in order to actually designate those states. This change to automatic designation of all states may be an indication that future changes may lead to the replacement of multiple designation fees with a single designation fee to cover all states.

In the Japanese system, only an application fee is payable on filing. An exam fee and claim fees are payable within three years.

4) Claim Fees

The EPO requires payment of claim fees for the 11th and subsequent claims. These are payable within 1 month of filing for direct-filed applications. For PCT cases entering the European phase, the claim fees are due 31 months from the priority date or shortly after in response to the Rule 109/110 EPC (Rule 161/162 EPC2000) communication.

Thus, for direct-filed European applications, a decision as to the number of claims must be made very early in the procedure. Furthermore, the claims cannot be amended between filing and receipt of the European search report, as discussed in more detail below.

In Japan, claim fees are due for all claims. However, these are not due until the deadline for requesting examination. Thus, the applicant may have the benefit of search reports or exam reports from corresponding cases before deciding which claims to pay for.

Part B - Procedure

1) Oral Proceedings (Hearings)

At the EPO, the applicant has a right to an oral hearing, if such a hearing is requested by the applicant. Therefore, it is normal practice for European Patent Attorneys to file a conditional request for an oral hearing such that an oral hearing must be appointed before a decision to refuse the application can be issued.

Oral proceedings provide a further (final) opportunity to submit written arguments and amendments and to present oral arguments to the Examining Division.

2) Search and Examination

As noted above, at the EPO, search and examination are distinct procedural steps. However, one Examiner does both, for consistency and efficiency.

The search report is a useful first warning as to potential problems with the application, for example lack of unity. It also provides the applicant with an opportunity to review prior art found by the Examiner.

In the case of multiple inventions, only the first will be searched. For direct-filed European applications, a partial search report will be issued and the applicant has the opportunity to pay additional search fees for one or more of the other inventions. It will then be possible to select any one of the searched inventions for examination.

For PCT applications entering the European regional phase, under the current system, the procedure is analogous to direct-filed applications. Thus, for applications where the EPO did not do the International search, a European partial search report will be issued, together with an invitation to pay extra search fees for the additional invention(s). However, under EPC2000, there will be no opportunity to pay additional search fees. The EPO will search only the invention appearing first in the claims. If there are other inventions, it will only be possible to pursue them in a divisional application.

This is an important change that will affect many PCT applications entering the European regional phase. Indeed, it will affect all PCT applications that have not yet received the European supplementary search report. This will include many PCT applications that have already entered the European regional phase as well as those entering the European phase from now on.

As a consequence of this change it is very important that the subject matter of greatest interest to the applicant appears first in the claims. In particular, if there are multiple independent claims, then the independent claim of greatest interest should appear first in the claims. Similarly, the order of the dependent claims should reflect the importance of the optional features.

In practice, for PCT cases entering the European regional phase, careful consideration should be given to the order of the claims. If necessary, amendments can be made on entry to the regional phase or shortly after entry in response to the EPO's standard invitation to amend the application. The claims on file at that stage will be the claims that are searched.

3) Extended European Search Report (EESR)

For European applications, including PCT applications designating Europe, filed on or after 1 July 2005, the EPO search report will be an Extended European Search Report (EESR). The EESR includes an opinion on the patent application and the invention.

It is possible (but not compulsory) to file amendments and/or arguments in reply to the EESR. For example, if the applicant wishes to expedite prosecution.

If an amendment is made after receipt of the EESR, the first Official Action (O/A) should take those amendments into account. Similarly, if arguments were submitted in response to the EESR, those arguments should be considered by the Examiner before issuing the first O/A.

If no reply was filed after the EESR, the first O/A will repeat the opinion and, if the opinion was negative, set the usual deadline for response.

In Japan, search and examination are combined. Thus, the first communication received by the applicant in relation to the patentability of their application will be either a Decision to Grant the application or a non-final Notice of reasons for refusal.

In many cases, the applicant's response to the first Notice is their last chance to make amendments freely.

4) Case study 1 – Search and Examination (Lack of Unity and Patentability)

Consider an application filed with three inventions defined in the claims. Each invention is claimed in an independent claim and a set of dependent claims.

In Europe there is no opportunity to amend the claims before receiving the search report. Thus, for direct-filed applications, the first invention appearing in the claims will be searched, even if the applicant is no longer interested in it. This will not change under EPC2000.

If the European application is a direct-filed (non-PCT) application, a “partial” search report is issued with an invitation to pay 2 further search fees within a short deadline (2-6 weeks). If extra search fee(s) are paid, the other invention(s) will be searched. An EESR is issued, with a lack of unity “opinion”.

For PCT applications entering the European regional phase, there is an opportunity to amend the claims, before the EPO carry out their (supplementary) search. Again, this will not change under EPC2000.

Under the current procedure, a partial search report will be issued and a request for additional search fees issued, just as for direct-filed applications. However, under EPC2000, the procedure will change, as discussed above. It will no longer be possible to get additional searches for PCT cases. This means that the application can proceed only with the invention that appears first in the claims. An EESR will be issued for those claims, together with a lack of unity “opinion”.

After the EESR has been issued and assuming that only the first invention was searched and no amendments made, ex-

amination at the EPO could proceed as follows:

First O/A:

- repeats EESR lack of unity objection

Response:

- delete unsearched inventions

Second O/A:

- lack of patentability objections

Response:

- Address objections with argument and/or amendment

Third O/A (a summons to attend an oral hearing):

- Repeats outstanding objections

Response:

- Further arguments and/or amendments; file multiple sets of claims (requests)

Oral hearing:

- Present oral arguments and (possibly) further amendments

Decision:

- Issued at the end of the hearing

In Japan, the application can be amended at will before the issuance of the O/A. This would allow the order of the inventions to be changed, for example to reflect changes in the commercial situation. When examination starts, examination at the JPO could proceed as follows:

The 1st invention is searched and examined.

Non-final Notice:

- Lack of unity and lack of patentability objections

Response:

- Delete all claims except for 1st invention and address patentability objections

Final Notice:

- New objections arising from amendment

Response:

- Restriction/cancellation of claims to address new objections

Decision:

- Issued in writing

5) Amendment - When?

In Europe, Rule 86 EPC (Rule 137 EPC2000) tells us when an amendment can be made:

- (1) No amendment between filing and receipt of search report.
- (2) Optional (voluntary) amendment after receipt of search report.
- (3) Guaranteed opportunity to amend after receipt of first O/A (even if the O/A is an indication that the application is allowable)
- (4) Amendment to address objections raised in any O/A

Provision (1) means that it is very important to draft the claims of a direct-filed European application in an order that reflects the importance the applicant attaches to the inventions or to preferred features within a single invention.

For PCT applications entering the European regional phase, amendments can be made after receipt of the European (supplementary) search report and O/As as per (3) and (4) above. In addition, amendments can be made as follows:

- (1) On entry to the regional phase (provided the ISR has been issued); and
- (2) Shortly after entering the regional phase in reply to the EPO's standard invitation

In Japan, Section 17bis JPA tells us when an amendment can be made. There are three periods during which an amendment can be filed:

- (1) Amendment is possible at any time up to issuance of the first O/A
- (2) After issuance of the first and subsequent O/A (under Section 50 or Section 48-7 JPA), amendment is only possible during the deadline for response to the O/A.
- (3) Within 30 days of filing an appeal

So, perhaps the most significant difference between Europe and Japan is that no amendment is allowed in Europe prior to receiving the search report. This means that, for direct-filed applications, there is no opportunity to change the claims before searching starts. In contrast, in Japan it is possible to amend the claims before they are searched by the JPO. Of course, for PCT cases, amendment is possible in Europe shortly after entering the regional phase and before the EPO carry out their supplementary search.

6) Amendment - Content of Amendment

In Europe, it is Rule 86 EPC (Rule 137 EPC2000) and Art 123(2) EPC/EPC2000 that restrict the content of an amendment:

- (1) Amended claims must not contain added matter
- (2) Amended claims may not relate to unsearched subject matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

- (3) Voluntary amendments in response to the second and subsequent official actions will only be accepted at the Examiner's discretion.

Requirement (2) is sometimes applied incorrectly by EPO Examiners and an objection may be raised against an amendment based on disclosures in the description but not the claims. Such an objection may indicate that the Examiner has searched only the features in the claims. This is not correct searching practice according to the EPO Examination Guidelines and there is no requirement that preferred or optional features relating to the invention must be claimed in order to be searched. Nevertheless, it is good practice for Europe to try to put all the features that are likely to be useful for an amendment into the claims.

Requirement (3) means that in practice it is desirable to file voluntary amendments (e.g. adding new dependent claims) when responding to the first O/A. In particular, if voluntary amendments (other than simple corrections of errors) are requested late in the examination procedure, for example when the Examiner has indicated allowance of the application, there is a serious risk that the amendments will be refused.

In Japan, Section 17bis (3) to (5) JPA set out the restrictions on the content of an amendment:

- (1) Amended claims must not contain added matter
- (2) Amendments in response to a final Notice are substantially restricted

In addition, for applications filed after 1 April 2007:

- (3) Amended claims must have unity with unamended claims that have been examined for patentability

So, like the EPO, it is also a good idea to file voluntary amendments early in the proceedings, before the first O/A or in response to the first O/A.

7) Deadline for Responding to an O/A

At the EPO, the response period for all O/As is, according to Rule 84 EPC (Rule 132 EPC2000), 2-4 months. In practice it is nearly always 4 months, but the Examiner has discretion to shorten it to 2 months (for example if there are only minor objections that do not require substantive changes).

The deadline will be the same regardless of whether the applicant is domestic or foreign.

The deadline is calculated by adding 10 days to the date of the O/A, to allow for delivery time, and then adding the response period, typically 4 months.

Extensions of time are also available for all applicants. In practice, the EPO will always grant a 2 month extension of time for responding to an O/A. No reason or explanation is required, just a written request filed before the expiry of the normal period for response. There is no official fee.

A discretionary further extension of time can sometimes be obtained where the applicant has persuasive reasons for needing more time to respond. For example, if they need more time to conduct experiments or prepare a declaration from an expert. These exceptional extensions of time should not be relied on.

In addition to an extension of time, the EPO also provides a guaranteed 2-3 month additional extension of time via

the Further Processing procedure. This is a mechanism for reviving the application after it has been “deemed withdrawn” by the EPO. In practice, the EPO will send a “loss of rights” communication if a deadline (or extended deadline) has been missed. The loss of rights letter is normally received within about one month of missing the deadline. The loss of rights letter will set a final 2 month deadline for responding to the O/A. No explanation for the delay is needed. However, a large official fee (Euros 210) must be paid. The further processing procedure is widely used.

So, a total of about 9 months is normally available to respond to an O/A at the EPO.

In Japan, domestic applicants have 60 days to respond to an O/A. Foreign applicants have 3 months to respond.

Foreign applicants can also benefit from up to 3 consecutive one month extensions of time. An official fee is required for each extension, but it is small. A reason is needed, but this has already been prescribed by the JPO (translation of documents) and this reason will be accepted without proof.

Domestic applicants cannot normally obtain an extension of time. However, a single one month extension of time is available if comparative experiments need to be performed.

Thus, foreign applicants have up to 6 months to respond to an O/A at the JPO and domestic applicants have only 60 days (with an additional one month if comparative experiments are required).

8) Failure to Respond to an Official Action

In Europe, if the further processing deadline is missed, the application will be

withdrawn for failure to respond to the O/A.

It is not possible to revive the application by filing an appeal. This is because an appeal at the EPO can succeed only if the reason for the decision to refuse the application was incorrect. In the case of a missed O/A deadline, the EPO would be correct in issuing their decision because no response was filed.

However, whilst an appeal would not be useful, there is a mechanism for trying to restore the application and that is *Restitutio in Integrum* (Art 122 EPC/EPC2000). This is a procedure for restoring an application that has been refused for missing a deadline. However, it is not an automatic procedure and it is intended to restore only those applications where the deadline was missed inadvertently.

In fact, an application will only be restored if the applicant was unable to observe the time limit despite all due care having been taken by the applicant as required by the circumstances. So, for example, a change of mind by the applicant is not a basis for restoring the application. However, for example, if there was an unforeseeable error in an otherwise efficient system (e.g. a mistake in an established diary/reminder system), then the application may be restored.

In Japan, it is much simpler to revive an application after a deadline (or extended deadline) has been missed. An appeal can be filed and a response to the O/A filed as part of the appeal. However, any amendments filed with the appeal will be restricted in the same way as for a response to a final Notice.

9) Divisional Applications - Time Limit for Filing

In Europe, a divisional application can be filed at any time up to (but not including) the date on which the EPO Bulletin publishes details of the grant of the patent.

In practice, EPO procedure provides advance warning of a case being granted or refused. Thus, if an application is considered to be allowable, a Rule 51(4) EPC (Rule 71(3) EPC2000) communication will be issued. This is the start of the grant procedure, which includes approving the text for grant proposed by the EPO, filing translations of the claims, etc. Furthermore, later on in the grant procedure the EPO will inform the applicant of the date when publication of the mention of grant is expected. This sets the final deadline for filing a divisional application.

In practice, it is desirable to file a divisional application not later than the response to the Rule 51(4) EPC (Rule 71(3) EPC2000) communication.

In the case where the Examiner intends to refuse the application, a summons to an oral hearing is issued (assuming a precautionary request for oral proceedings has been filed by the applicant, as discussed above). A divisional application can be filed as a precaution, shortly before the oral hearing. Payment of the fees on the divisional (due one month after filing) can be delayed until the outcome on the parent application is known.

Alternatively, if the application is refused (at oral proceedings or in a written decision), an appeal can be filed and then a divisional application filed during appeal proceedings. The outcome of the appeal does not affect the validity of the divisional.

In Japan, a divisional application can be filed at any time that an amendment to the parent case is possible.

However, if the Examiner considers an application to be allowable, there will be no warning of grant. So, if a divisional is of interest to the applicant, a precautionary divisional application can be filed when responding to a Notice, or shortly after filing the request for examination.

Similarly, if the applicant is concerned that the Examiner may refuse the application after a response to a first Notice (in the case where the response does not address all of the previous objections) or after a response to a final Notice (if the amendment is not allowable or does not overcome all of the objections), a precautionary divisional application can be filed when responding to the Notice.

However, for applications filed after 1 April 2007, there will be an additional opportunity to file a divisional application after grant or after refusal. This is good news.

10) Divisional Applications - Content of a Divisional Application

In Europe, the Enlarged Board of Appeal (EBA) have recently decided several questions relating to the content of a divisional application. The relevant decisions are G1/05 and G1/06 (consolidated).

The main questions addressed by the EBA relate to the validity of divisional applications in each of the following situations:

- (i) added matter is present in the divisional application as filed (as compared to the parent application);

- (ii) the subject matter claimed in the divisional application was not claimed in the parent application as filed; and
- (iii) the divisional application is a “second generation” or “grand-child” application - in other words, a divisional of a divisional application.

The EBA’s decisions on questions (i) to (iii) are as follows:

- (i) any such added matter can be removed from the divisional application at the appropriate time, whilst retaining the filing date of the parent application;
- (ii) there is no requirement for the claimed subject matter of a divisional application to be derived from the claims of the parent application; and
- (iii) there is no limit on the number of generations of divisional applications

In Europe, if a divisional application is used to pursue broader protection than the parent application, there is no need to include a disclaimer to exclude the claimed matter of the parent case. Indeed, such a disclaimer would almost certainly be regarded as added matter at the EPO. Nevertheless, double patenting is prohibited, but the EPO have traditionally assessed this quite narrowly, such that overlapping, but not identical, claim scope is allowable.

In Japan, a divisional application must not include added matter and it must not claim the same invention as the parent application. However, if these requirements are not met on filing, there is

an opportunity to amend the divisional application after filing to satisfy these requirements.

It is also possible to file a divisional application at the JPO to pursue broader claims than the parent application. Depending on the facts of the case, it may be necessary to incorporate a disclaimer into the claims of the divisional to avoid an objection under Section 39 JPA with respect to the parent application.

11) Accelerated Examination

At the EPO, accelerated examination can be requested very easily and it will always be allowed. There is no need to provide a reason and it can be used for any application. There is no official fee.

The EPO will try to issue the first O/A within 3 months of the request for accelerated examination. They will also endeavour to issue second and subsequent O/As within 3 months of the applicant’s response.

In Japan, a request for accelerated examination can be filed in respect of (i) international applications, (ii) worked inventions, (iii) SME-related inventions, (iv) academic-related inventions, and (v) applications to which the patent prosecution highway (PPH) procedure is applicable.

It is necessary to provide comments on patentability with respect to prior art documents known to the applicant at the same time as filing the request.

12) Post Grant Amendment (Limitation)

Currently in Europe, post grant amendment is only possible at national patent offices (the exception being amendment of a patent during EPO opposition proceedings). Thus, it can be expensive and time consuming to make an

amendment to a European patent that has been validated in several countries in Europe. In addition, the different procedures in the various countries may lead to different outcomes in terms of allowable amendments.

One of the changes provided by EPC2000 is to introduce a centralized amendment procedure at the EPO. This should represent a much more convenient solution to the problem of amending a granted European patent. However, the procedure will only allow amendments that constitute a limitation of the granted claims. Thus, simple editorial or cosmetic changes will not be allowed.

Under the new procedure, it will not be necessary to provide a reason for the amendment. The amendment will not be examined for novelty and inventive step but it will be examined for added matter and clarity. Third parties cannot be a party to the procedure, although they can file observations if they so wish.

If there is a problem with a proposed amendment (e.g. lack of clarity), the EPO will issue a communication setting a deadline for response. Only one communication will be issued and there will be only one opportunity to respond. However, if the amendment is rejected, it will be possible to file a new request for amendment.

Naturally, any part of the patent that is amended will need to be translated into the appropriate language of the contracting states where the patent is in force.

This should bring this aspect of patent practice closer to the post grant correction appeal system that is available in Japan.

Part C – Substantive Law

1) Novelty - Date and Time of Filing

In Europe, Article 54 EPC/EPC2000 defines prior art as information made available to the public before the date of filing. There is no legal basis for assessing novelty based on the time at which an application was filed.

This means that a disclosure made on the same day as the application was filed is not prior art at the EPO, nor in any of the Contracting States.

In Japan, Section 29(1) JPA states that prior art is any information that is publicly worked, publicly known, published in a distributed publication or made available to the public via electronic telecommunication lines before the time of filing the application. This means that a public disclosure on the same date as the filing of the application can be prior art.

2) Content of Prior Art as Interpreted by the Skilled Person

In Europe, the disclosure of a prior art document is assessed by establishing what information is directly and unambiguously disclosed to the skilled person taking into account their common general knowledge.

This assessment is made on the date of publication of the prior art, using common general knowledge at that date. This means that common general knowledge that came into existence after the publication of the prior art document cannot be taken into account.

Generally, this is not particularly relevant during examination of most applications, but it may be important in rapidly developing technical fields such as biotechnology. It may also be more relevant in oppositions where there may be a

greater emphasis on the interpretation of disclosures and the level of common general knowledge.

In Japan, the assessment of novelty is similarly based on a novelty test wherein the explicit or implicit disclosures in a prior art document can anticipate a later filed application. However, in contrast to Europe, in assessing the disclosures of a prior art document, the common general knowledge is applied on the filing date of the patent application. Thus, common general knowledge that came into existence between the publication of the prior art document and the filing of the patent application can be used to interpret the disclosures in the prior art under novelty.

3) Novelty - Grace Period

In Europe, there is no grace period.

However, as set out in Article 55 EPC/EPC2000, there are exceptions to the state of the art in respect of:

- (i) disclosures made in breach of confidence - the disclosure is disregarded if the application is filed within 6 months of the unauthorized disclosure; and
- (ii) disclosures of an invention made by the inventor or successor in title at a designated exhibition - the disclosure is disregarded if the application is filed within 6 months of the exhibition.

However, in respect of exhibitions under (ii), there are very few designated exhibitions (a few per year) and in practice this provision is very rarely relied on.

In Japan, there is a 6 month grace period as set out in Section 30 JPA. However, in the context of an applicant wishing to obtain global patent rights, such a

grace period cannot be relied upon because the disclosure before filing will create a bar to patentability at the EPO.

There has been discussion amongst the trilateral Patent Offices regarding a possible grace period in Europe, but there have been no concrete proposals and there is currently no legal basis in the EPC, or in EPC2000, for a grace period to be introduced.

4) Novelty - Earlier Unpublished Applications

Both Europe and Japan have provisions that deal with the status as prior art of earlier unpublished patent applications that have not been published at the time of filing a later application.

In Europe, Articles 54(3) and (4) EPC and Rule 23a EPC contain the relevant provisions. They state that earlier filed European patent applications are prior art for novelty only in respect of overlapping designated states (provided the designation fees have been paid in the overlapping states).

EPC2000 will remove the requirement for there to be overlapping states (Art 54(3) EPC2000). This means that any earlier filed EP application that is subsequently published will be prior art for novelty. This change will affect all applications filed after entry into force of EPC2000, i.e. after 13 December 2007. For divisional applications, the filing date is taken as the actual filing date of the divisional, rather than the filing date of the parent. This means that, bizarrely, an earlier filed unpublished European patent application can be prior art for a divisional application but not for the parent application.

While the EPC provisions do not apply to earlier filed national applications, it

is important to remember that an earlier unpublished national application may be prior art under the national law of that contracting state. So, if the applicant is aware of an earlier national right, they will need to consider whether that earlier national right is relevant to patentability in that particular country.

Although the EPO does not examine a European application with respect to such earlier national rights, it will permit an applicant to file an additional set of amended claims for the contracting state or states where there is an earlier national right. A European application can therefore proceed with two or more sets of claims.

At the EPO, the assessment of novelty in respect of certain unpublished European applications is carried out in the same way as for “normal” prior art. So, the threshold for novelty is consistent.

In Japan, earlier national rights are dealt with in Sections 29bis and 39 JPA. Section 29bis JPA is equivalent to Art 54(3) EPC/EPC2000.

Like Art 54(3) EPC/EPC2000, Section 29bis JPA states that earlier unpublished Japanese applications are prior art for novelty only. However, unlike the EPO, the assessment of novelty is broader than the assessment of novelty for “normal” applications. Thus, an objection under Section 29bis JPA will be raised if an earlier national right is “substantially identical” to the later filed application.

5) Novelty - Self Collision

As a result of Art 54(3) EPC/EPC2000 discussed above, it is possible in Europe for an applicant’s own earlier unpublished application to be cited for novelty against a later application. In

particular, there is no exception in Europe for cases where the applicants of the earlier and later filed applications are the same. This is also the case for common inventorship. Thus, self collision is possible in Europe!

In Japan, self collision will not occur if the applicants are the same or if the inventors are the same.

6) Case study 2 – Self Collision

2 Japanese basic applications (JP1, JP2) are filed on consecutive days for closely related subject matter.

JP1 is concerned with a new copolymer X useful for food packaging. One of the examples also includes a disclosure of copolymer X with a coating layer Y, which shows improved performance.

JP2 (filed the day after JP1) is concerned with coating material Y useful for improving the performance of plastic food packaging. It contains several examples of the use of material Y as a coating layer on various plastic substrates.

The applicant for both cases is the same.

2 European applications (EP1 & EP2) are filed on consecutive days on the 12 month anniversaries of the basic applications.

EP1 includes the subject matter of JP1, together with some additional examples. Claim 1 is to “A copolymer X”.

EP2 includes the subject matter of JP2, together with some additional examples. Claim 1 is to “A coating material Y”.

EP1 claims priority from JP1.

EP2 claims priority from JP2.

The applicants are the same. The designated states are the same.

During prosecution at the EPO, EP1 is cited under Art 54(3) EPC/EPC2000 in a lack of novelty objection against claim 1 of EP2. The objection is correct. This is because the example in EP1 disclosing the use of material Y as a coating layer constitutes a disclosure has an earlier effective filing date than claim 1 of EP2. This situation would be the same under EPC/EPC2000.

In response, the applicant has only one option and that is to amend claim 1 to achieve novelty. This could be done by introducing a new feature into claim 1 or by introducing a disclaimer, such that the specific example in EP1 is excluded. However, whilst the disclaimer should be formally allowed by the EPO (following the EBA decision G1/03), it is not entirely clear how such a disclaimer would be interpreted by national courts – for example, it would arguably not be in keeping with the principle that such disclaimers should be allowed in a situation where the contents of an earlier unpublished application could not be known to the applicant at the time of filing.

In hindsight, it would have been better for the applicant if they had filed both JP applications on the same day and also filed the EP applications on the same day (or combined the two inventions in one application, and divided later on, to defer costs). However, even if the filing dates of the JP applications were different, an objection might have been avoided if EP2 claimed priority from JP2 and JP1.

Thus, Japanese applicants who are familiar with Japanese patent law should be aware that a filing strategy that is effective in Japan (and the US) may be

ineffective in Europe because of the wider effect of Art 54(3) EPC. This will remain the case under EPC2000.

7) Double Patenting

In Japan, Section 39 JPA applies to national rights where the claimed invention is the same in both earlier and later filed applications (or applications filed on the same day).

The EPC/EPC2000 does not include a provision corresponding to Section 39 JPA. However, it does state that the right to an invention arrived at independently by two parties will belong to the first one to file an EP application (Art 60(2) EPC/EPC2000). Nevertheless, the only mechanism for enforcing this is to apply Art 54(3) EPC/EPC2000.

Furthermore, as noted above, the EPO Examination Guidelines state that a divisional application cannot be pursued for the same invention as the parent application, thereby providing a bar to double patenting. However, this is generally applied quite narrowly and overlapping, but not identical, scope is usually allowed.

8) Excluded Subject Matter

In Europe, subject matter for which a patent will not be granted is set out in the EPC (Art 52(2), (4) and Art 53 EPC/EPC2000), and in the Implementing Regulations (Rules 23c, d and e EPC (Rules 27 to 29 EPC2000)).

The “excluded matter” is broadly the same as that in Japan. However, in Japan, the “excluded matter” is set out in the Guidelines rather than the statute (although Section 2 JPA provides the legal basis for delegation to the Guidelines).

The only significant difference to mention here is that the exclusion relating

to methods of treatment and diagnostic methods is narrower in Japan than in Europe. Thus, at the EPO, such methods are unpatentable if they relate to the treatment or diagnosis of humans or animals. In Japan, such methods are excluded only if they relate to humans.

Also, in Europe a claim should not be refused as a diagnostic method unless the claimed method includes all of the steps required to reach a diagnosis. This follows the decision of the Enlarged Board of Appeal in G1/04. So, for example, a method of conducting an X-ray or MRI scan of a patient is allowable because it does not include the step of assessing the results to produce a diagnosis.

Furthermore, at both the JPO and EPO it may be possible to get claims granted to methods of operating medical or diagnostic equipment. At the JPO, this type of approach appears to have been developed further so that “pseudo” methods of treatment and diagnosis may be possible, provided the steps of interacting with the human body are not explicitly claimed.

As a mental exercise, it is interesting, at least for a European patent attorney, to consider whether the JPO would allow a claim to:

“A method of operating a syringe (hypodermic needle), the syringe including
 a cannula portion,
 a fluid reservoir containing therapeutic compound X in fluid communication with the cannula portion, and
 a fluid pressure generating means,

wherein the method comprises the step of actuating the fluid pressure generating means so as to urge compound X from the fluid storage reservoir through the cannula.”

There is no mention of injecting a patient. There is no mention of treating a disease. Nevertheless, a doctor would presumably infringe such a claim when injecting compound X into a patient.

At the EPO such a claim would not be allowable. The EPO would consider the absence of an explicit step of injecting a patient to be irrelevant and the substance of the claim would be regarded as more important than the form. However, the EBA are currently considering, in pending case G1/07, whether the step of injecting a diagnostic agent into a patient constitutes an impermissible surgical step. An argument in favour of such a method of injection being allowable is that the exclusion of surgical methods in fact applies only to treatment by surgery and that injection of a diagnostic agent does not and cannot provide treatment.

Part D – Patent Practice

1) Claims - Essential Features

It is a requirement at the EPO that the independent claim(s) defining the broadest scope of protection must include the essential features of the invention (Rule 29(1) EPC (Rule 43(1) EPC2000)).

If the Examiner considers that a feature should be added to the claims in order to properly define the invention, he can raise an objection, normally under Art 84 EPC/EPC2000. It is for this reason that terms such as “essential” or “very important” should be avoided when describing optional or preferred features. Similarly, if a feature is used in all of the

examples, but is not essential to make the invention work, it may be appropriate to state in the description that the feature is a preferred feature in practical embodiments but that it is not needed in order to make the invention work. Furthermore, if an advantage can be associated with an optional or preferred feature it can help to make it clear that it is not essential to the invention.

In Japan, the applicant decides which features are required in order to define the invention. Thus, perhaps there is less concern over how optional or preferred features are described in the specification.

2) Claims - Independent Claims

The EPO will allow only one independent claim in each category (method, apparatus, etc), except in certain exceptional situations. This requirement is set out in Rule 29(2) EPC (Rule 43(2) EPC2000). The exceptional situations in which multiple independent claims in the same category will be allowed are as follows:

- (a) Interrelated products
- (b) Different uses of the same product
- (c) Alternative solutions to the same problem where it is not appropriate to cover the alternatives by a single claim

Examples of (a) include a transmitter and receiver, a plug and socket, or an intermediate and final chemical compound.

An example of (b) is first and second medical uses.

An example of type (c) is different methods of synthesizing the same compound

This requirement is applied strictly by EPO Examiners. In particular, if there are multiple independent claims in the same category and the only difference between the claims is the choice of language to describe the same features, an objection will be raised. In such a case, none of the exceptions (a) to (c) above would apply and so it would be necessary to delete all except one of the independent claims.

For European regional processing of PCT cases containing multiple independent claims, the selection of the applicant's preferred independent claim be made on or shortly after entering the European regional phase, after receiving the (supplementary) search report, or in response to the first O/A.

In some cases it may be desirable to wait until after the supplementary search report before selecting an independent claim because the applicant will then have the advantage of a search of all of the independent claims and this may assist the applicant in deciding which of the independent claims to pursue. However, the EPO's new procedure under EPC 2000 in which only the invention appearing first in the claims is searched may make waiting until after the supplementary search a risky strategy. If multiple independent claims are to be maintained until after the search, an amendment should nevertheless be considered on or shortly after entering the regional phase to place the independent claim of most interest first in the claims, thereby ensuring that the claims are in the desired order for the supplementary search.

Naturally, in cases where no (supplementary) search is to be conducted by the EPO (i.e. the EPO were the International Searching Authority), it may expedite

prosecution to select only one independent claim before examination starts. This may also save money on claim fees when entering the European regional phase.

In Japan, there are no such complications with respect to multiple independent claims. The applicant is free to define their invention using as many independent claims as they like.

3) Claims - Two-Part Claim Form

At the EPO, it is usually necessary to present the independent claims in the two-part form in order to comply with Rule 29(1) EPC (Rule 43(1) EPC2000). However, it is clear from Rule 29(1) EPC (Rule 43(1) EPC2000) that the two-part form is not obligatory and should only be required when it is appropriate.

In theory, the two-part form does not constitute an admission as to which features are in the prior art and which are allegedly new. However, interpretation of granted claims is dealt with by national law and so it is difficult to say with any certainty that the two-part form would not be interpreted in this way in a national court.

Thus, if there is doubt as to whether the two-part form is appropriate, the Examiner should not insist on the two-part form. For example, if it is not clear which features are directly and unambiguously disclosed in a single prior art document, the two-part form should not be applied. Similarly, if the clarity or conciseness of the claim would be adversely affected by rewriting it in the two part form, then the two-part form should not be used.

There is no equivalent requirement in Japanese patent practice.

4) Claims - Product Claims

At the EPO, reciting the intended use of a product in the claim does not normally provide a limitation.

Indeed, the words “for use” are interpreted by the EPO to mean “suitable for use”. Thus, any product that is suitable for the intended use will anticipate the claim. Nevertheless, in some cases the words “for use” (= suitable for use) can exclude products that are clearly not suitable for a particular function.

For example, a claim to “a mold for molten steel having shape X” would not be anticipated by a prior art plastic mold having shape X. This is because a plastic mold is clearly not suitable for use with molten metal.

However, any prior art product that has shape X and is suitable for use with molten metal will anticipate the claim. Thus, a prior art metal tray not intended to be used as a mold but incidentally having shape X, will anticipate the claim.

In such a case, a method or use claim may be the most appropriate way of protecting the invention.

In Japan, the use specified in a product claim is treated as a limiting feature that can distinguish over prior art. Thus, in the example given above, a metal tray having shape X will not anticipate the claim when examined at the JPO. The exception to this is where the field and range of application of the product are very similar to the prior art use.

5) Claims - Medical Product Claims

At the EPO, the general principle that the specified use of a product cannot provide a limitation does not apply to the first use of that product in a method of medical treatment or a diagnostic method.

Thus, Art 54(5) EPC/EPC2000 states that a product for use in a method of medical treatment or a diagnostic method will be novel even if the product per se is known.

So, first medical use claims of the format "Product X for use in a method of medical treatment/diagnostic method" are allowable at the EPO. Indeed, unlike current practice at the JPO, it is possible to get broad claims without limitation to a particular disease or class of diseases.

At the JPO, the "Product for use" claim format is also allowable for medical products, although a composition must be specified rather than the compound per se. Nevertheless, the JPO do not like such claims to refer to methods of treatment. Thus, "A pharmaceutical composition X for treating disease Y" is fine, but "A pharmaceutical composition X for use in a method of treating disease Y" is likely to receive an objection.

In Europe, the current practice with respect to second medical use inventions is that Swiss type claims must be used, in accordance with EBA decision G5/83. Thus, claims of the form "Use of product X in the manufacture of a medicament for the treatment of disease Y" are currently the only way to protect the second and subsequent use of a product already known for use in a method of treatment or diagnosis.

In particular, the new patentable use can arise from any one of a new disease, a new patient group, a new mode of application (topical, oral, etc), and, following the decision in T1020/03, possibly a new dosage regime or drug combination. In T1020/03 the Board of Appeal stated that the new "second medical use" can be based on any step that would confer patentability on a hypothetical method of

treatment claim. It is not yet clear whether this decision will be followed by Examiners or other Boards of Appeal.

Under EPC2000 the "Product for use" format of the first medical use claim will also apply to second and subsequent medical indications. The wording corresponding to the Swiss type claim discussed above would therefore be "Product X for use in treatment of disease Y". This will bring EPO medical use practice much closer to that of the JPO. It is expected that the existing case law relating to Swiss type claims will continue to apply to the new second medical use format.

The new claim format will apply to all pending applications when EPC2000 comes into force on 13 December 2007. In practice, both Swiss type claims and "Product X for use in ..." claims should be included in new applications.

In Japan, second and subsequent medical indications can already be protected using the usual "Pharmaceutical composition for treatment of..." format.

6) Claims - Method Claims

At the EPO, unlike product claims, the indication of the purpose of the method can provide a limitation to a method claim.

Thus, a claim to a method for remelting steel would not be anticipated by a prior art method that comprised the same technical steps but was not in fact a method of remelting steel.

The JPO has a similar approach to the assessment of method claims.

7) Claims - Use Claims (Including Second Non-Medical Use Claims)

The EPO allows use claims, which are generally regarded as interchangeable with method or process claims.

However, a use claim at the EPO can also be used to protect an invention that resides in the use of a known substance in a known way to achieve a new non-medical technical effect or application.

Thus, based on the EPO's normal approach to the assessment of a method or product claim, a claim to the product itself would lack novelty and a method of using the product would also lack novelty because the physical steps involved in using the product would be the same.

However, the EBA decided in G2/88 that a use claim could protect such an invention provided the new technical application was recited in the claim. More specifically, they decided that the new application of the invention could constitute a limitation with respect to the prior art.

In one of the examples considered by the EBA, it was known to use a particular composition to inhibit corrosion of metal components. The invention resided in the use of the same product applied in the same way to the same metal components to provide a lubricant effect.

The EBA stated that a claim of the form "Use of composition X as a lubricant" would be novel with respect to the known use for inhibition of corrosion.

Thus, even though the new technical effect would inevitably have been occurring during the known use of the composition, the EBA decided that the new technical effect had not been made available to the public.

However, the new technical effect will not contribute to patentability if the alleged technical effect underlies the known use.

In Japan, use claims are not normally needed as product claims with a limitation to the use of the product are allowable. However, if the field and range of

application of the use of the product are very similar to the known use then it will not be allowed. Thus, in the example given above, it seems unlikely that the JPO would allow a claim to "A composition for use as a lubricant..." when the composition per se was known and the composition would be applied in the same amounts and to the same components as in the prior art method for inhibiting corrosion.

8) Auxiliary requests

In Europe, it is possible to file, in addition to a "normal" response to an O/A, a "conditional" response to the same O/A. A conditional response will only be considered by the EPO if the "normal" response does not overcome the objections.

Thus, in practice, two or more sets of claims might be filed, each set comprising different amendments. The EPO would examine the first set in the normal way and, if they reject the first set, go on to examine the second set.

This practice is well established at the EPO and the different sets of claims are typically labeled "Main Request" and "Auxiliary Request" so as to make it clear which is to be examined first. If there are more than two requests, the auxiliary requests are labelled "First Auxiliary Request", "Second Auxiliary Request" and so on. The EPO will examine the requests in order. If they find any one of the requests to be allowable, they will not consider the remaining requests.

This approach is commonly used when filing submissions in preparation for oral proceedings (both oral proceedings at the end of the examination procedure and, in particular, oral proceedings

in Opposition or Appeal proceedings).

It is a useful procedure for obtaining the Examiner's/Opposition Division's/Board of Appeal's opinion on a number of different amendments. Of course, there is a limit to how many requests will be considered and if an unreasonable number of requests are filed, not all of them will be considered. As a very general guide, five or fewer requests will normally be examined without complaint but ten or more may give rise to difficulties (particularly in *inter partes* proceedings where the other party may object). Having said that, in some cases, many more than ten auxiliary requests have been considered. So, it very much depends on the facts of each case and the forum (Examining Division, Opposition Division or Board of Appeal).

In any case, careful selection of appropriate auxiliary requests is an important part of EPO practice in preparation for oral proceedings.

However, the use of multiple requests is not always appropriate. In particular, if such multiple requests are filed in the early stages of examination, there

would be a risk that the Examiner would simply select a narrower amendment from the list of requests without conducting a proper examination of the main request.

In Japan, the use of multiple requests is not normal practice. However, in some cases it may be possible to file a response (for example, arguments) and an additional request that the applicant be given a further opportunity to amend the claims if the main response is not successful. In some cases (e.g. appeal proceedings) it may be appropriate to indicate what the alternative amendment would be.

The full text of EPC2000 can be found at:

<http://www.epo.org/patents/law/legislative-initiatives/epc2000/convention.html>

The EPO's Examination Guidelines under EPC 2000 have recently been released and are available at:

<http://www.epo.org/patents/law/legislative-initiatives/epc2000/draft-epc-2000-guidelines.html>