

# Strategies for saving cost at the European Patent Office



19<sup>th</sup> June 2010.

J G Marshall  
Serjeants

# The End

Thank you for your patience



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# Per page costs and per claim costs

€13 per page over 35

€210 per claim over 15 but less than 50

€525 per claim over 50



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# Drafting strategy should be:

Shorter specifications

Fewer claims

(subclaims should be patentable if the parent claim had been found to be invalid)



# Lercanidipine patent

- Best-selling drug for controlling blood pressure
- Italian Patentee
- Patent drafted in UK
- 16 pages
- 22/23 years old and still in force through SPCs
- Validity never challenged



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# Same drug company

- Now uses US firm to do initial drafting
- New drug patents average 200 pages plus per patent application



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# The PCT influence

All overseas patent applications are 200+  
pages long



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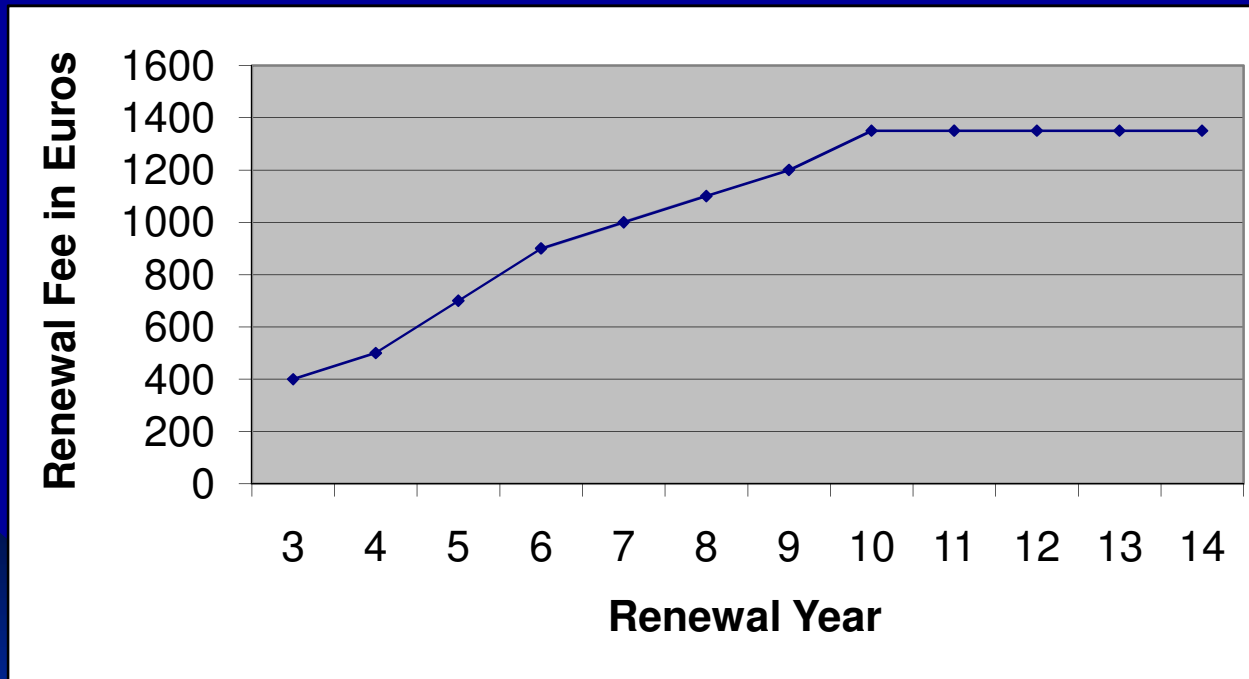
# The solution

- Write the original US provisional specification in the USA using US attorneys
- Write the PCT specification in the UK using UK attorneys
- Instruct the UK attorneys to draft their own specification suitable for the EPO





# The cost of EPO renewal fees



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# Compare the cost of national renewal fees after grant

Record grant in few countries: EPO does not compare well

use PACE to speed up the grant

Record grant in many countries: EPO compares very well indeed

do not use PACE

But monitor the client's needs regularly



# An aside (relevant as yet to the UK only):

Use the Korean Patent Office as ISA

Rapid search report

Often favourable

Can be relied upon to guarantee rapid processing of a corresponding UK national phase application



# Multiple inventions

2 sets of rules in the EPO

- PCT application with EPO as ISA
- Non-PCT application or PCT but EPO is not ISA



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# PCT application with EPO as ISA

If there are two inventions the EPO will refuse to carry out a second search

Only option is to file one or more divisionals



# Non-PCT application or PCT but EPO is not ISA

If there are two inventions then EPO will search the first and demand a second search fee for the second and subsequent inventions

Armed with the second and subsequent search reports, you may consider whether or not to file divisionals



# Conclusion

Select very carefully whether or not to choose the EPO as ISA if there is a possibility of multiple inventions/multiple search fees



# Non-PCT application or PCT but EPO is not ISA

Do you know if the EPO will demand second and subsequent search fees?

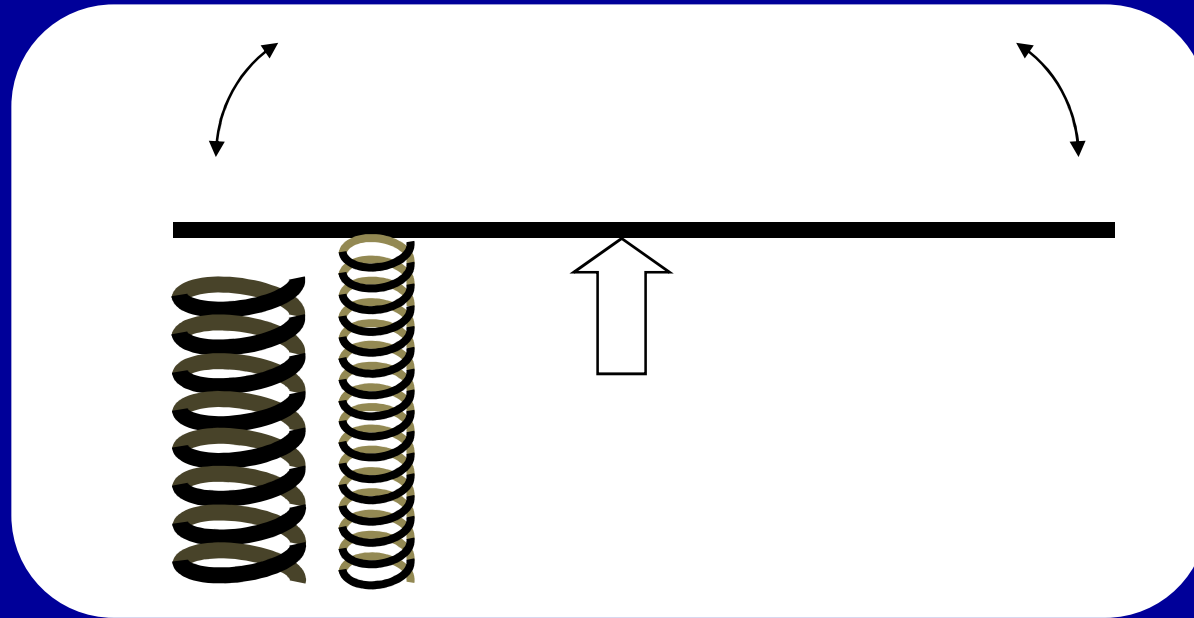
Consider this case history.



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## Trundlehumper platform

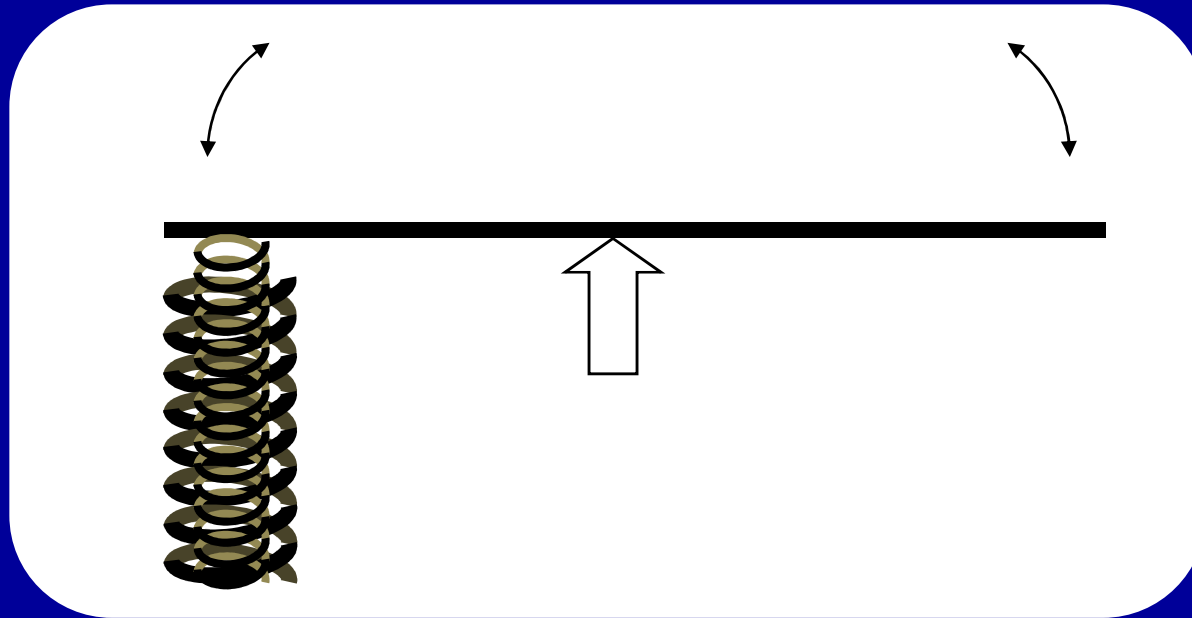
Claim 1:

2 springs on the same side of the pivot point, the first spring being lighter than the second. Rotation of the platform in a first direction is resisted by compression of the first spring followed by compression of the second spring.



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## Trundlehumper platform

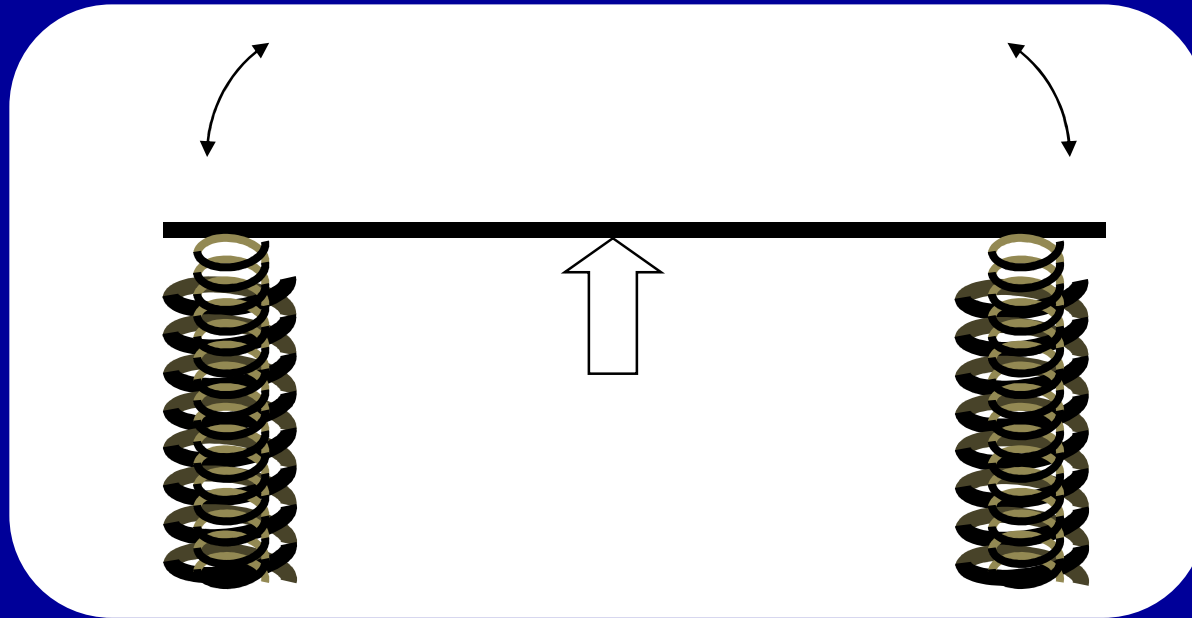
Claim 2:

A trundlehumper platform according to claim 1 in which the two springs are coaxially aligned.



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## Trundlehumper platform

Claim 3:

A trundlehumper platform according to claim 1 or claim 2 in which a second pair of springs is provided, similar to the first but opposing rotation of the platform in a second direction opposite to the first.



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# How many search fees?

- EPO demanded that two extra search fees be paid within a period of one month
- I argued but failed to persuade the examiner who said that he would not examine claims 2 and 3 if they were not searched
- I paid the extra search fees under protest
- Only new prior art showed one spring on each side of pivot point



- I amended claim 1 to specify that the first and second springs were axially aligned
- All three claims were allowed
- I requested a refund of the search fees paid under protest
- Request refused
- Applicant decided not to appeal that refusal



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# Strategy?

- Refuse to pay additional search fees for dependent claims
- Do not expect a refund on any additional search fees paid under protest
- Insist that examination be carried out on the independent claims as searched and on all dependent claims



# Second case history

- Claim 1: Electroluminescence material for a LED
- Claim 2: First method for making the material of claim 1
- Claim 3: Second method for making the material of claim 1
- Claim 4: LED comprising the material of claim 1



- Examiner did not search but demanded three additional search fees, for the inventions of claims 2, 3 and 4
- I amended claims 2 and 3 to an 'either or' form and have argued the issue
- The result is still awaited





# Oral Proceedings

EPO Examiners now tend to give either a refusal or a summons to Oral Proceedings after even one response to an examination report

The issue is whether or not they think that the application is near to allowance



# Oral Proceedings

- Oral Proceedings (OP) are massively expensive to a client
- Better a summons to an OP than a refusal
- Always request an OP at the end of any response involving argument with the Examiner



# But if summoned to OP:

- Respond as early as possible
- Include amended claims
- Include one or more auxiliary requests
- Request a phone conversation with the examiner



# Summary of strategy options:

1. Shorter specifications
2. Fewer claims
3. Constantly monitor rate of progress
4. Make careful use of PACE
5. Choose the ISA carefully
6. Be prepared to argue with Examiners who demand extra search fees
7. Make better use of Auxiliary Requests



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