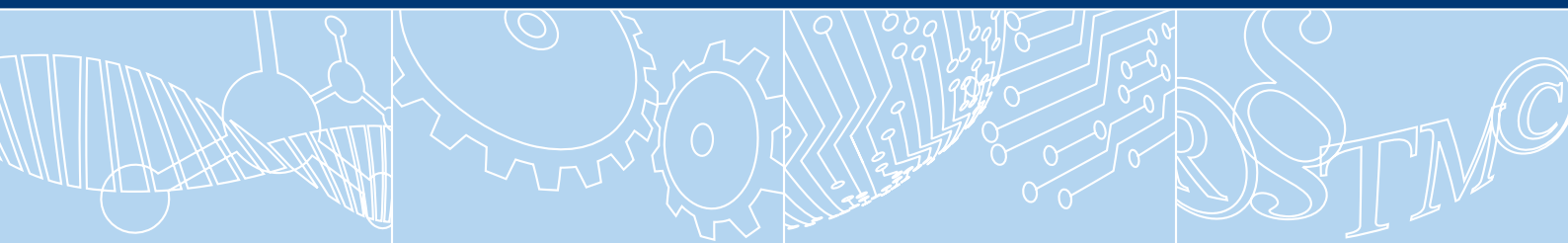


EPO FEES ON CLAIMS: HOW TO RESPOND TO THE FEE INCREASE OF 1 APRIL 2008

NEWSLETTER 04/2008



With its Newsletter 02/2008, Hoffmann · Eitle already provided general information on the fee increases scheduled by the EPO. With the present newsletter, we wish to offer our advice regarding strategies for handling the upcoming dramatic increase in claims fees. From 1 April 2008, a claims fee of EUR 200 is payable for every claim starting with claim 16. Although the focus of this letter is on this imminent change of law, the following comments and recommendations are believed to be equally applicable to the second rise of claims fees on 1 April 2009 to a fee of EUR 500 for claim 51 and every subsequent claim.

by Klemens Stratmann and Peter Wiedemann

WHAT CAN APPLICANTS DO UNTIL 31 MARCH 2008 TO SAVE COSTS WITHOUT AMENDING THE CLAIMS?

Currently, the most effective measure to save claims fees for applications having many more than 15 claims is certainly to file the case at the EPO before 1 April 2008. This applies in particular to pending PCT applications where the deadline of 31 months from the priority for entering the regional phase at the EPO expires on or after 1 April 2008 and the application has progressed so far that entry prior to 1 April 2008 represents an option. In principle, in order to save claim fees, it is also possible to file by 31 March 2008 EP applications claiming foreign priority early within the priority year provided by the Paris Convention. However, this comes at the cost of an earlier expiration date of the EP patent which will expire 20 years from the then earlier application date.

Therefore, if you want to avoid paying claims fees at the new and higher rates **please send us your order letter as soon as possible**. Hoffmann · Eitle is prepared to handle such applications with high priority **to make sure that the application is filed prior to 1 April 2008**.

HOW WILL HOFFMANN · EITLE HANDLE YOUR FILING INSTRUCTIONS AS OF 1 APRIL 2008?

To allow all incoming orders for new applications to be handled efficiently and transparently Hoffmann · Eitle intends to distinguish applications with more than 15 claims according to their number of claims. Statistical analysis of the thousands of cases that we have filed at the EPO in recent years reveals that a very large proportion of these cases enter with 20 claims, or fewer. The quantum of fees payable on claims 16 to 20 will still be relatively modest, in proportion to hours of attorney time, which possibly need to be invested to redraft the claims with the aim of reducing their number. In this connection it also

needs to be considered that a European claims set with 20 claims would presently also attract EUR 450 in claims fees (10 x 45 EUR). It therefore seems to us that maximum efficiency can be achieved by setting up a default position in which **Hoffmann · Eitle will pay claims fees on any application given to us for filing at the EPO, that has 20 claims, or less**.

For those applications we receive that present a set of claims running to **21 claims or more**, our default position will be to hold back from paying the EPO any claim fees at all. Instead, we will make it part of the duties of the Hoffmann · Eitle attorney, who is conducting the pre-filing review of the case, to check whether there are obvious measures, such as the insertion of multiple dependencies, to reduce the number of claims and to settle with the client or the instructing associate what shall be the specific claims set for filing at the EPO. Hoffmann · Eitle will then pay the EPO its quantum of fees on that agreed claims set.

In **Paris Convention cases**, the attorney at Hoffmann · Eitle would therefore likely be engaging in urgent correspondence with the client or instructing associate, before the end of the Paris year, to clarify whether attorney revision of the set of claims is indicated and, in any event, how many claims are to be filed at the EPO. In **PCT cases**, for EPO regional phase entry, the Hoffmann · Eitle attorney has somewhat more time to settle the matter with the client or instructing associate. That attorney can take advantage of the Rule 161/162 EPC period of one month, that commences after EPO regional phase entry with issue by the EPO of its "Rule 161/162 Communication" to Hoffmann · Eitle. In such cases, it would be reasonable to expect the Hoffmann · Eitle attorney to be working with the instructing associate or client, right up until the end of the Rule 161/162 period, in drafting and settling claims for EPO prosecution, and arriving at the corresponding reduced quantum of EPO claims fees.

WHAT HAPPENS IF DUE CLAIM FEES ARE NOT PAID?

It follows from Rule 45(3) EPC that the claim concerned shall be deemed to be abandoned if a claims fee is not paid in due time. Referring to J15/88 the EPO Guidelines for Examination¹ illustrate this legal consequence as **material loss of disclosure**. Accordingly, features of a claim deemed to be abandoned and which are not otherwise found in the description or drawings cannot be subsequently reintroduced into the application and, in particular, into the claims.

Before a decision is made not to pay due claims fees for a specific claim it should be therefore checked whether or not the embodiment described in this claim is disclosed somewhere else in the application. Consequently, the usual practice of many applicants to include into their application a list of embodiments which are described in the same words as the claims will gain additional relevance as of 1 April 2008 since it minimizes the risk of permanently giving up disclosure if claims fees are not paid for any of the original claims.

WHAT CAN APPLICANTS DO TO REDUCE THE NUMBER OF CLAIMS OF PENDING APPLICATIONS?

Oftentimes the claims of applications with a large number of claims show a single dependency structure since they have been drafted to meet PCT Rule 6.4 and US law. If the invention is claimed in more than one independent claim, e.g. in method and device claims, or in claims for the starting material and the end product, it may be often sufficient to have only one sequence of dependent claims to which the second independent claim refers. **Multiple dependencies** will also be effective in saving claims if specific combinations of features are to be defined in the claims with as few dependent claims as possible. The reformulation of **alternatives** defined in several

dependent claims in one single dependent claim is another effective and allowable technique for reducing the number of claims. Furthermore, applicants should consider that the EPO does not fundamentally object to the use of **optional features** following expressions like “preferably”, “for example”, “such as” or “in particular” in the claims as long as these do not introduce ambiguity². Optional features in claims are normally not examined by the EPO but may help to accommodate as many embodiments as possible in 15 claims. The presence of such optional features may thus also increase applicant’s flexibility in conducting amendments.

WHAT SHOULD APPLICANTS CONSIDER WHEN DRAFTING FUTURE APPLICATIONS?

The above explained techniques can be equally used to reduce the number of claims right from the beginning when a new application is drafted.

Whatever measure is taken to reduce the number of claims applicants should have in mind that the EPO has a very narrow understanding of disclosure. The use of lists of alternatives and multiple dependencies runs the risk that a specific combination of features which may theoretically result from the combination of list members and claim dependencies may no longer be regarded as disclosed in view of the “two list principle” applied by the EPO³.

We therefore recommend an early involvement of a European patent attorney to give advice regarding a proper drafting of claims.

¹ Part A, III.9 and VII.1.3

² Guidelines for Examination, Part C, III.4.9

³ cf. Headnote of T7/86 Xanthines/Draco: “A class of chemical compounds defined only by a general structural formula having at least two variable groups does not specifically disclose each of the individual compounds which would result from the combination of all variants within such groups”

SUMMARY

Applicants and European Patent Attorneys face a new challenge in view of the dramatic increase in Claims fees which will take effect on 1 April 2008 and 1 April 2009. In some technical areas where the invention can be practiced at various levels and utilized in many different products and methods, for instance in biotechnology, it will be difficult for Applicants to draft an application with only 15 claims which contains the required claim categories for enforcing a granted patent, gives the sufficient flexibility in conducting amendments and includes the necessary fall-back positions for prosecuting the application.

Given that situation, a few hours of the time of a European patent attorney, formulating before the end of the Paris Convention year a set of claims in "EPO form" could be a useful investment that would facilitate pursuit of patent protection, not just in Europe but also in any other important jurisdictions. Equally, an applicant who contemplates filing a PCT application for use in a number of jurisdictions, including the EPO and the USPTO, might achieve substantial cost savings if it were to give a European patent attorney the opportunity to prepare a set of "EPO form" claims in time for including in the PCT filing documents. We stand ready to assist you with such work. ■

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