

# **Contrasting European and American Drafting Practices; Common Drafting Errors and Tips**

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Barry Franks European and Swedish Patent Attorney at Hynell Patenttjänst AB

# Patent drafting from a European perspective

Differences between US and EP requirements:

- No grace period
- Preamble and charactering portion
- Support in the description
- One independent claim in each category
- Claim fees
- Multiple claim dependencies
- Reference numbers in claims

## Grace period – costs \$\$\$\$\$\$\$\$\$

Most countries in the world do not have a grace period for the inventor's own disclosures of the invention.

This means that if you publish your invention and then file a patent application in the US during the grace period you can get a US patent. However, even if you claim priority from the US patent application, your own publication is still prior art against you in most of the world.

So file your first patent application before revealing your invention to the public!

# Preamble and characterizing portion - saves \$\$

Wherever possible (99% of the time!), claims have to have a preamble (which describes the closest prior art) and a characterizing portion. These are separated by the word "characterized (or similar word).

E.g. your invention is a drinking glass (or other drinking vessel) which helps prevent the consumption of too much alcohol by the feature of having a hole in the side.

Drinking vessels are part of the prior art so "drinking vessel" is part of the preamble.

The inventive feature of the hole in the side is put in the characterizing part:

E.g. Claim 1 states "A drinking vessel **characterized** in that it is adapted to reduce the volume drunk by a user by means of a through-hole in the side wall".

# Support in the description – saves \$\$\$\$

It is a requirement that all the claimed subject matter has support in the description.

The easiest way to ensure sure this is to paste the claims into the description and rewrite them as "aspects" of the invention.

E.g. Claim 1 states " A drinking vessel **characterized** in that it is adapted to reduce the volume drunk by a user by means of a through-hole in the side wall ".

In the description this would be written as:

"One aspect of the invention is a drinking vessel adapted to reduce the volume drunk by a user by means of a through-hole in the side,"

# One independent claim in each category – costs \$\$\$

Categories of claims include:

Physical entities (product, apparatus, device, compound)

Activities (process, use,

Whenever possible the claims should be drafted to have only one independent claim in each category. Otherwise there is a risk that the examiner will say that there is a lack of unity of invention and some claims will not be searched or examined.

Exceptions to this rule are interrelated product e.g. plug and socket, receiver and transmitter, intermediate and final chemical product, gene, gene construct, host, protein, medicament.

# Claim fees – costs \$\$\$\$\$

The first 15 claims are free.

Claims 16 to 50 cost an additional 235 Euros each

Claims 50 and above cost an additional 585 Euros each

Reduce the number of claims. But how?

# Multiple claim dependencies – saves \$\$\$\$\$

US practice due to the US fee calculation method, e.g.:

Claim 1 has feature A

Claim 2 is dependent on claim 1 plus feature B

Claim 3 is dependent on claim 1 plus feature C

Claim 4 is dependent on claim 1 plus features B and C

EP practice: reduce the number of claims by making dependent claims dependent on previous claims, e.g.:

Claim 1 has feature A

Claim 2 is dependent on claim 1 plus feature B

Claim 3 is dependent on claim 1 or claim 2 plus feature C

Same scope of protection with only three claims instead of four



# Reference numbers in claims – saves \$\$

It is "preferable" (but in practice it is obligatory) to put reference number of features shown in the drawings into the claims.

It is explicitly stated in the rules (Rule 43 (7)) that: "These reference signs shall not be construed as limiting the claim."!

If you don't do add reference signs then your European Patent Attorney will have to do it and it will cost a lot more time and money than if you do it yourself!

# Thank you!

- Barry Franks
- Hynell Patenttjänst AB
- [barry.franks@hynell.se](mailto:barry.franks@hynell.se)
- +46 72 402 45 20