PREFACE

This text explores substantive and procedural differences between the practice of European patent law and the practice of U.S. patent law.

It is a guide designed to help U.S. patent attorneys develop European patent prosecution skills, avoid mistakes, and generally succeed at the European Patent Office.

Objectives of this Text

This text has two purposes. The first, very practically, is to provide attorneys, agents, and technical advisors with a useful and practical understanding of the process by which European patent rights are secured. Because of the relatively high costs of procuring and maintaining European patent rights, U.S. companies tend to file for European rights primarily on inventions that are important to their business. The process of deciding whether to file for European patent rights is effectively a rationalization process during which a client determines the critical and interesting innovations of its research and development. In view of this, the prosecution of a European application necessitates careful and studied attention, as it is often used to protect more significant inventions.

Furthermore, mistakes made during the prosecution of a European application can jeopardize the related U.S. patent position. This occurred recently when an important U.S. patent of Abbott Labs was held unenforceable based on conflicting positions taken by the attorney at the United States Patent Office versus the European Patent Office.[1] Conversely, success in Europe can expedite victory in the U.S., as illustrated by CR Bard's successful defense of a European Opposition brought by ACS, Inc. that lead to a $100 million settlement of a pending U.S. litigation.[2]

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[1] *See* Therasense, Inc. v. Becton, Dickinson & Co., 864 F. Supp. 2d 856 (N.D. Cal. 2012).

[2] In 1998, the Guidant Corporation agreed to pay C.R. Bard Inc. $100 million in the second quarter to settle two patent-infringement suits Bard had brought against its Advanced Cardiovascular Systems division. *See Guidant to Pay Bard to Settle Patent Suits*, N.Y. Times (Apr. 7, 1998), http://www.nytimes.com/1998/04/07/business/guidant-to-pay-bard-to-settle-patent-suits.html.

The second purpose is to help attorneys, agents, and technical advisors become more advanced practitioners of patent law by comparing European Patent Office (EPO) and United States Patent and Trademark Office (USPTO) practice, as well as European and United States patent laws. This comparative analysis should provide a greater contextual understanding of all intellectual property (IP) law. To be clear, this Manual is not intended to address all facets of the EPC, its implementing regulations and the EPO Examination Guidelines. In that vein, it is not organized sequentially according to the Articles of the EPC, unlike other treatises, instead this work focuses on selected aspects of EPO law and practice that tend to conflict with or differ from U.S. law and practice, so as to provide a comparative perspective to a U.S. patent attorney.

For this purpose, the text includes references to laws, policies and practices of the European Patent Organisation and will compare them to the laws and policies followed by the USPTO. Hopefully, this comparison will highlight the elements of patent law and practice that are common to both jurisdictions and perhaps bring out those elements of patent law that are core to any legal framework seeking to reward inventive and creative activity.

The European Patent Organisation

Although the USPTO will likely be well known to most U.S. patent practitioners, the European Patent Organisation may be less familiar. Just as the USPTO works to support and implement policies and procedures that it deems beneficial to U.S. industry, the European Patent Organisation undertakes a similar effort to support European industry.

Primarily, the European Patent Organisation organizes and funds the European Patent Office. Additionally, the European Patent Organisation is an influential member of the international patent community and has worked extensively on forging alliances with other patent granting authorities in support of certain initiatives and policies.[3] The European Patent Organisation represents the IP interests of its 38 member states including all 28 member states of the

[3] *See Mission and Vision*, EUR. PAT. OFF., http://www.epo.org/about-us/office/mission.html (last updated Sept. 2, 2008) ("[W]e will continue to contribute to innovation across Europe, and play a leading role in developing an effective global patent system.").

European Union,[4] a collective that includes over 550 million citizens that are part of some the world's largest economies and most innovative companies. As such, the president of the European Patent Office regularly engages with the heads of the other major patent offices, including the United States Patent Office, the Chinese Patent Office, the Korean Patent Office, and the Japanese Patent Office.

To advance the interests of the European nations that are members of the European Patent Organisation, the European Patent Organisation actively participates in major policy discussions at the World Intellectual Property Organization, the European Union, and the World Trade Organization.[5] Understanding the favored polices and processes of the European Patent Organisation, not to mention the incentives and interests of the European Patent Office (EPO) may give U.S. attorneys further insight into the context and motivation for certain policy changes the USPTO proposes. For example, this text reviews certain favored polices of the European Patent Organisation that are currently under consideration for global adoption, including standards for assessing inventive step, two-stage examinations, and the mandatory use of the Patent Cooperation Treaty process as a way to expedite national or regional stage prosecution. All of these may soon be reflected within USPTO initiatives.

Efforts to Compare U.S. and European Patent Laws and Procedures

In *Approaching Comparative Company Law*, [6] Professor David Donald wrote that comparative law is the natural companion to globalization. Intellectual property laws of the United States and Europe, more than many areas of law, are subject to these forces of globalization. Globalization seems to be moving U.S. and European intellectual property laws along a common path. However, national

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[4]The member states of the EPO are: Albania, Austria, Belgium, Bulgaria, Switzerland, Cyprus, Czech Republic, Germany, Denmark, Estonia, Spain, Finland, France, United Kingdom, Greece, Croatia, Hungary, Ireland, Iceland, Italy, Liechtenstein, Lithuania, Luxembourg, Latvia, Monaco, Former Yugoslav Republic of Macedonia, Malta, Netherlands, Norway, Poland, Portugal, Romania, Serbia, Sweden, Slovenia, Slovakia, San Marino, and Turkey.

[5]The Five IP Offices supported the improvement of electronic data exchange amongst themselves, as well as the study of the possible harmonization of formalities and data contents of search and examination results.

[6]David C. Donald, *Approaching Comparative Company Law*, 14 FORDHAM J. CORP. & FIN. L. 83, 84 (2008).

and regional interests and priorities remain. These different priorities impact the application of Intellectual Property law and certainly cause substantive differences over issues such as inventor compensation and legal rights to patent forms of life. But, the administrative law around the application for patent rights seems to be harmonizing around a common set of priorities focused on transparency, public participation, quality and accessibility. Given this, a comparative review of U.S. and European patent laws and granting proceedings is useful for the U.S. patent attorney handling European patent matters.

This text is largely a practical review of European patent law through the lens of comparison between the patent laws of Europe and those of the United States. The comparisons are made to benefit the U.S. patent practitioner who is looking for a deeper understanding of European patent law and its interrelationship, at least in key areas, with U.S. law. Comparisons are made to illustrate the differences and similarities between European and U.S. law, with the intent of providing deeper insights into both European and U.S. patent systems. The comparisons made herein are made with caution, and honest effort was applied to obtain accurate information, compare only the comparable, considering history's impact, and maintain awareness of the distorting tendencies of one's own perspective.

To this end, there are several general differences between the administrative patent systems of the United States and Europe that should be noted, as they extend over all comparisons made in this book and, to some extent, make many comparisons presented herein imperfect. These are:

1. The European Patent Office is an optional path to European patent rights, while the only path to a U.S. patent is through the USPTO. This is a difference well known to U.S. patent attorneys, but it is a difference that is fading. The rise of the European Patent Office has occurred, in no small part, at the expense of the National patent offices in Europe, many of which now do little more than record native language translations of patents granted from the European Patent Office, collect a portion of annuities and keep a registry of assignment rights. Many U.S. attorneys would be quite surprised to see how limited the search and examination capabilities are for many European national patent offices, particularly for certain areas of technology.

2. The European Patent Office Board of Appeals largely drives the development of European Patent Law. The USPTO has no similar vehicle of influence. There is no judicial review of the decisions from the European Patent Office Board of Appeals. In contrast, all decisions of the U.S. Patent Trial and Appeal Board are reviewed by the U.S. Federal Courts.
3. The EPO language regime provides a layer of complexity that is not found in the U.S. system. The European Patent Office operates in three working languages, with all granted patents having claims translated in all three languages.[7] Patents granted by the EPO have effect in member states that do not have these three languages as national languages. Thus, the courts of these states will litigate these English, French and German language patents in a language other than English, French or German. The U.S. Patent regime lacks any such language challenge.
4. There are no decisions of truly precedential effect from the EPO—none from the Board, and none from a court. Although decisions of the Enlarged Board of Appeal of the EPO are highly persuasive, they are not binding other than for the appeal being heard.
5. Lastly, the European Patent Office is, in the end, a political entity created to further political goals of the member European states. The USPTO serves only to further the goals of the United States.

These differences highlight that European patent law itself has a different political, linguistic, cultural and legal basis than U.S. patent law. These differences are manifest in substantive legal principles, such as the European Patent Convention's Acts policies precluding patenting medical treatment and diagnostic methods, as well as in the EPO's strict requirements for support for claim amendments. Those substantive differences can result in costly errors if U.S. attorneys are unfamiliar with them and unfamiliar with the underlying reasons for them.

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[7] Convention on the Grant of European Patents art. 14(1), Oct. 5, 1973, 1065 U.N.T.S. 199 [hereinafter EPC] ("The official languages of the European Patent Office shall be English, French and German.").

Those seasoned in European patent law will appreciate that the following discussion and working examples are not exhaustive. In fact, they are only a beginning, a springboard if you will, to a new and rich understanding of both legal frameworks.

For their invaluable help in the preparation of this edition, we would like to acknowledge the contributions of numerous colleagues at Ropes & Gray and elsewhere, including Dr. Clair Curran, Dr. Natalie Kirchhofer, Margaret Sullivan, Nicholas Dube, and Conor Boyce. The authors would particularly like to express their appreciation for the careful work, quick research and thoughtful criticism of Ekaterina Gianiotis and Daniel Sternberg. We are also grateful to numerous current and former members of the Examining Division, Opposition Division, and Boards of Appeal at the European Patent Office for their helpful discussions and insights regarding European patent law.

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November 2015