

Claim Drafting Strategy for Filing in the US and Europe
by Dana Tangren

Although obtaining a patent in Europe is similar to the process of obtaining a patent in the US, there are some important distinctions that should be considered when drafting a patent application that will be filed in both locations. One notable distinction is the required support for claim language. In the US, a claim can be supported by the specification, drawings or claims as filed. See [MPEP 608.04](#). Furthermore, “an applicant is not limited to the nomenclature used in the application as filed” and is free to make amendments to the specification and claims as long as the new matter is not added. See MPEP 608.01. In addition, as long as a first substantive office action has not been issued, an applicant is generally free to file amendments that broaden claims or that claim subcomponents of a system. Even after an office action has been issued, it is common for examiners to allow broadening amendments. Thus, in general, an applicant will typically have broad leeway in the US for making claim amendments and identifying supporting disclosure for such amendments.

In contrast, Europe has very strict rules as to what claim amendments can be made during prosecution. Notably, once an application has been filed, it can be very difficult to broaden a claim. For example, if an independent claim is filed that recites elements A, B, C, and D, the claim cannot later be amended to remove element D, even prior to examination, unless the specification clearly states that the invention only requires elements A, B, and C. Once examination has begun, broadening amendments are almost never permitted. Furthermore, when adding limitations to a claim, a European examiner will typically require that the added language be literally supported by the language within specification or claims. Thus, even if a feature is clearly depicted in the drawings or would be inherent to one of ordinary skill in the art, language relating to such a feature can typically not be added to a claim unless the language finds literal support in the specification or claims as filed. Thus, in general, amending claims in Europe is very restrictive, when compared to US practice, and is typically limited to that which is expressly recited in the specification or claims.

One strategy to address the restrictive practice in Europe is to incorporate a broad range of claims directly into the specification of an application at the time of drafting, such as in a

Claim Drafting Strategy for Filing in the US and Europe
by Dana Tangren

summary of the invention. In the US, there are extra claim fees for total claims over 20 and in Europe there are extra claim fees for total claims over 15, as such it is not economical to have a broad number of claims within an application. However, there is no fee for having claim language within the specification that can be easily converted into a claim. For example, the specification can be drafted with a large number of discrete paragraphs where each separate paragraph corresponds to language of a separate claim. For example, the specification may state that:

In a first aspect, the invention includes A, B, and C.

In a second aspect, the invention includes A, B, and D.

In a third aspect, the invention includes A, B, and E.

In each of the above aspects, the invention further includes F.

In each of the above aspects, the invention further includes G. Etc.

By using the above approach, the specification can be drafted to incrementally include language in a claim type format that covers all desirable combinations of the claimed invention without having to pay for extra claim fees. This approach provides the highest probability that the specification will include the “literal” language needed for incorporation into a claim for distinguishing over prior art during examination or enable broadening or changing of claim scope prior to examination.