



## Claim format harmonisation

### ***The Federation's proposal for international claim format harmonisation, to facilitate cooperation between patent offices and to help users***

The Federation's members are all engaged in international commercial activity and patenting. As patentees and/or as potential infringers of third-party patents, they waste time and money to the extent there are unnecessary differences in law and procedure between major territories. The same differences waste the time of patent office examiners, who are less able to take advantage of each other's work. There are differences whose elimination -

- (a) should be readily negotiable internationally because they do not raise fundamental issues of principle (as differences in grace periods, exceptions and limitations, and industrial applicability do); and
- (b) should offer particular savings because they are of practical relevance to most inventions rather than just to a minority of inventions (as are the more fundamental differences just referred to).

Accordingly, in 2013, the Federation issued a policy paper PP2/13 suggesting that the existing arbitrary and wasteful differences in claim format should be eliminated. The paper noted particularly that applicants, examiners, and competitors of applicants all waste time and money because of the formal differences between claim sets for the same invention before the EPO and the USPTO, as follows:

Difference	EPO	USPTO
N° 1	Two-part ("characterised in that") main claim form is required wherever appropriate (EPC Rule 43).	Two-part form is inadvisable for the applicant.
N° 2	Sub-claims may depend on any one or more preceding claims to the extent this is logically permissible.	Sub-claim dependencies are restricted (35 USC 112).
N° 3	Reference numerals are required wherever appropriate (EPC Rule 43).	Reference numerals are inadvisable for the applicant.
N° 4	"Modification" claims referring to previous claims are allowed.	"Modification" claims referring to previous claims are barred (35 USC 112).

Differences (1) and (3) have the effect that main claims of essentially the same scope will mostly read differently in Europe and the USA. Differences (2) and (4) mean that the logical structures of two precisely equivalent sets of claims would in general differ from each other - and in practice that the claim sets are not precisely equivalent at all.<sup>1</sup>

The Federation's paper has been widely disseminated, and it is hoped that the above issues will be addressed by the IP5 group of offices considering patent law harmonisation.

<sup>1</sup> A set of 10 PCT claims in which each of claims 2 to 10 depends on every preceding claim can be used directly in the European regional phase (provided EPC Rule 43 is taken into account). A precisely equivalent set of claims for the US national phase complying with the restriction on dependencies would number 257, incurring prohibitive claim fees.

Like collaborative search and examination in the international phase of PCT applications (also promoted by the Federation - *Trends and Events*, December 2012, pages 32-33), harmonised claim format would, if implemented, significantly enhance the international patent system.

Mike Jewess, 30 October 2013