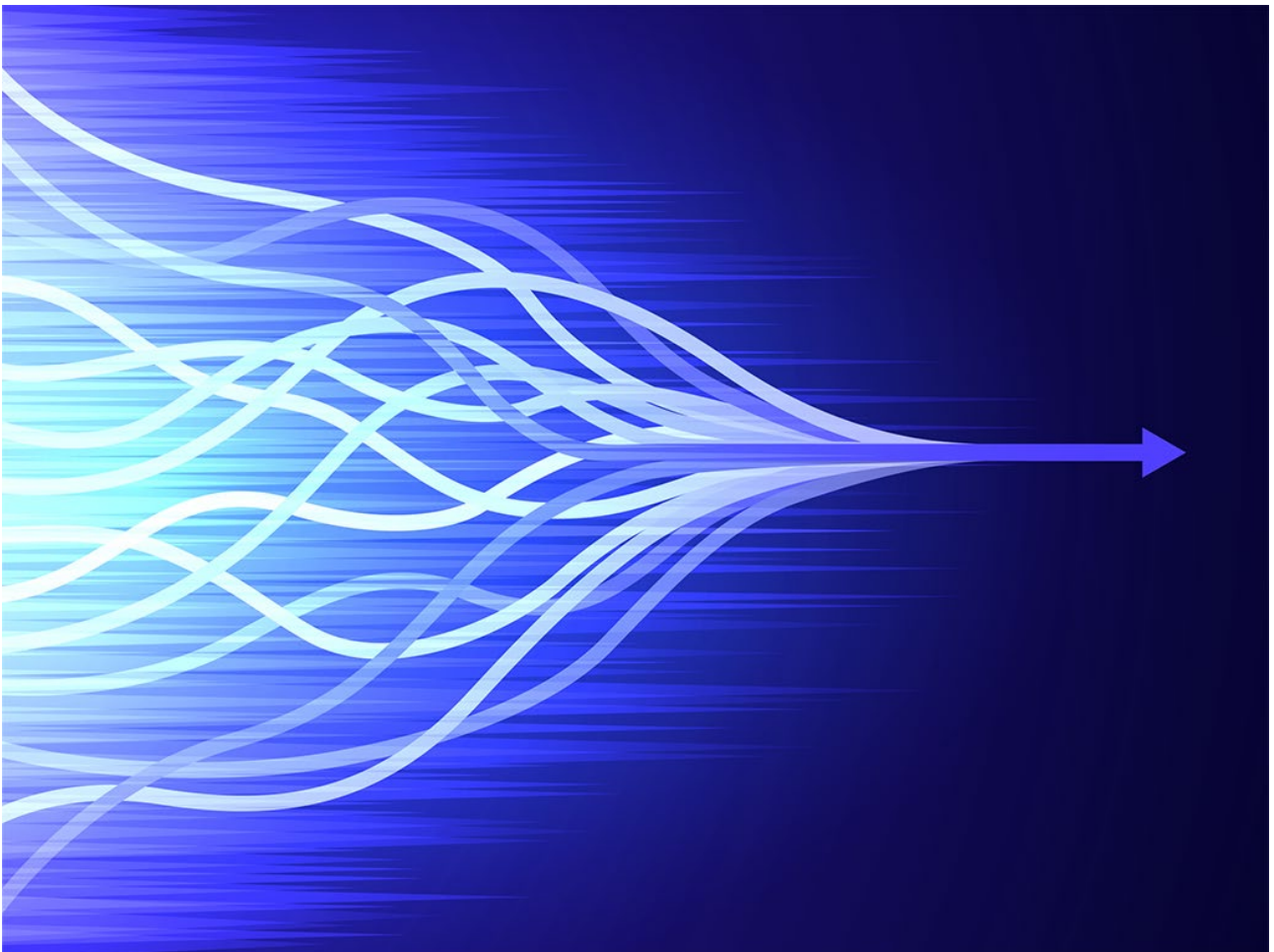


Convergence of practice

Common practice as regards claim drafting and structure

March 2023



Common practice as regards claim drafting and structure

Considering that the claims define the matter for which protection is sought and determine, with the help of the description and the drawings, the extent of the protection conferred by a patent or a patent application;

Considering that the formal requirements governing the drafting of the claims and their structure are therefore crucial;

Considering the advantages for users of an alignment of the formal requirements governing the drafting of claims and their structure;

Noting that any common practice will be implemented on a voluntary basis;

Having regard to the opinion of the Committee on Patent Law;

The Administrative Council at its meeting on 22 March 2023 approved the following common practice as regards as regards claim drafting and structure:

Clarity, conciseness and support for claims in the description

Offices are to provide that the claims are clear and concise and are fully supported by the description, in line with the provisions of the Patent Cooperation Treaty (Article 6 PCT).

Form and content of claims

Offices are to provide that the definition of the matter for which protection is sought is in terms of the technical features of the invention. Offices are to provide that, whenever appropriate, claims contain:

- (i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art,
- (ii) a characterising portion, preceded by the words "characterised in that", "characterised by", "wherein the improvement comprises," or any other words to the same effect, stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.

Offices are to provide that the claims are typed or printed, without prejudice to more liberal requirements for the purpose of obtaining a filing date.

Limit on the number of independent claims per category

Offices are to provide that, without prejudice to the requirement of unity of invention, a patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

- (a) a plurality of interrelated products,
- (b) different uses of a product or apparatus,
- (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

Requirements for dependent claims

Offices are to provide that any claim which includes all the features of one or more other claims ("dependent claim") does so by a reference, if possible at the beginning, to the other claim or claims and then states the additional features claimed.

Offices are to provide that all dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, are grouped together to the extent and in the most practical way possible.

Number of claims

Offices are to provide that the number of the claims is reasonable in consideration of the nature of the invention claimed. Offices are to provide that the applicant is to pay a fee if they exceed a certain number of claims, which is to be determined by the national Offices in accordance with the applicable national law.

Applications containing drawings: reference signs linking the claims to the drawings ("reference signs")

Offices are to provide that where the patent application contains drawings, the technical features mentioned in the claims are preferably followed by the reference signs relating to those features. When used, the reference signs must preferably be placed between parentheses. If including reference signs does not particularly facilitate quicker understanding of a claim, they should not be included. These reference signs are not to be construed as limiting the claim.

Tables

Offices are to provide that any claim may contain tables only if the subject-matter of the claim makes the use of tables desirable.

Values and units

Offices are to provide that values are expressed in units conforming to international standards, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement must also be expressed in units conforming to international standards. Only the technical terms, formulae, signs and symbols generally accepted in the field in question must be used.

Offices are to provide a list or overview of units recognised in international standards and complying with national requirements.

1. Background

With the adoption of the Strategic Plan 2023, discussions were launched on a convergence programme aimed at reducing or overcoming differences in administrative practices by setting common practices in identified areas where a more uniform approach would provide the most beneficial results for both users and patent offices. At its 51st meeting, the Committee on Patent Law gave a favourable opinion on the convergence of practice programme (CA/PL 14/19). A common practice as regards claim drafting and structure was identified as an area for a possible convergence of practice. Pursuant to the working method established by the Committee on Patent Law, a working group, namely Working Group 5 – Claim drafting and structure, was set up to explore possible common practices in this area. The work of the group was planned to be concluded by November 2022.

A call for interest was launched in December 2022, whereupon 21 EPC contracting states and 2 extension states indicated their interest in participating in the discussions of Working Group 5. BusinessEurope and epi both nominated one representative as an observer in the discussions of the Working Group. The composition of the Working Group was as follows: Austria, Bosnia and Herzegovina, Bulgaria, Croatia, Czech Republic, Denmark, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Lithuania, Montenegro, Netherlands, Norway, Poland, Portugal, San Marino, Spain, Sweden, the United Kingdom, epi, BusinessEurope and the European Patent Office (EPO).

In February 2022, the chairperson of the Working Group (a representative of the EPO) issued a detailed questionnaire to identify the administrative practices regarding the different formal requirements concerning the common practice as regards claim drafting and structure in the participating states and to determine any differences and similarities among these practices. The answers from the participants were compiled in a summary document which served as a basis for the discussions within the Working Group.

The Working Group held four virtual meetings (6 April 2022, 18 May 2022, 6 July 2022 and 28 September 2022). Based on the discussions in these meetings and taking into account the results of the questionnaire, the Working Group identified eight areas where a convergence of practice was considered to particularly benefit both users and patent offices.

On 15 November 2022, at its 56th meeting, the Committee on Patent Law was provided with an update on the work of Working Group 5.

In parallel to the discussions in the Working Group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19, point 21), users were consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 10 March 2022 and 18 October 2022. In order to further broaden the scope of the consultation process, on 5 October 2022 the EPO organised the third virtual platform on convergence of practice and informed users and offices of the results achieved within the Working Groups 5 and 6 until then.

At its fourth meeting on 28 September 2022, the Working Group agreed to recommend to the Administrative Council the enclosed common practice as regards the claim drafting and structure for adoption and any subsequent voluntary implementation (see Annex 1). The Working Group also agreed upon explanatory remarks to the eight different areas contained in this recommendation for a common practice which are reflected below.

2. Explanatory remarks

The Working Group took note of the fact that the implementation of any common practice in the eight identified areas may be subject to a revision of the applicable legal framework. In this regard, it is reiterated that the implementation of any given agreed common practice takes place on a voluntary basis (CA/PL 14/19, point 16). In order for the benefits of the convergence of practice to fully materialise, the aim should be to achieve the implementation of the agreed common practice in as many contracting and extension states as possible.

2.1 Clarity, conciseness and support for claims in the description

Almost all Offices confirmed that their jurisdiction prescribes that the claims must define the matter for which protection is sought, and be clear, concise and supported by the description. However, the replies to the questionnaire showed that some Offices do not expressly provide that the claims are clear, concise and supported by the description.

In view of these differences, the Working Group is of the opinion that an alignment of the requirements for clarity, conciseness and support for the claims in the description would be very advantageous as it would ensure consistent practice and case law. It therefore recommends that Offices are to provide that the claims are clear, concise and that they are fully supported by the description, in line with the provisions of the Patent Cooperation Treaty (Article 6 PCT).

2.2 Form and content of claims

A large majority of respondents confirmed that their jurisdiction prescribes that **claims must be drafted in terms of the technical features of the invention**. A few respondents answered that there is no express provision in their legislation to that effect. Consequently, the Working Group recommends that Offices are to provide that the claims define the matter for which protection is sought in terms of the technical features of the invention, in line with Rule 6.3(a) PCT. This means that claims are not to contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose are to be allowed if they assist in defining the invention.

Most of the Offices responded that they prescribe the **two-part form**. Some Offices that responded that they adhere to the two-part form explained further that exceptions or special reasons for not using the two-part form are also foreseen in their jurisdiction. In one Office, the two-part form is not explicitly prescribed but is adopted in practice. One Office stated that it is left to the discretion of the applicant whether to use the two-part or one-part form and one Office replied that no form is prescribed. In view of these discrepancies, the Working Group recommends that Offices adopt the two-part form for claims, wherever appropriate, in line with the provisions of the PCT, which are set out in the next paragraph.

Rule 6.3(b) PCT defines the two-part form which a claim should take "whenever appropriate". The first part should contain a statement indicating the designation of the subject-matter of the invention, that is, the general technical class of apparatus, process, etc. to which the claimed invention relates, followed by a statement of those technical features "which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art". The second part or

"characterising portion" should state the technical features which, in combination with the features stated under the first part (Rule 6.3(b)(i) PCT), it is desired to protect, that is, the features which the invention adds to the prior art (see also the PCT International Search and Preliminary Examination Guidelines, point 5.05).

A few Offices responded that handwritten claims are accepted. The Working Group, while not wishing to recommend specific font sizes or spaces, is of the opinion that Offices are to provide that claims are typed or printed as this facilitates the electronic processing of patent applications. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be drawn or written by hand. This is without prejudice to any more liberal requirements of the Offices as regards the accordancy of a date of filing of a patent application. In other words, applicants may file applications containing claims that are not typed or printed for the purpose of obtaining a filing date. However, at a later stage, Offices may require applicants to file typed or printed claims as a formal requirement.

2.3 Limit on the number of independent claims per category

The responses to this question were mixed, with most national Offices responding that there is no limit imposed in their jurisdiction. The other Offices responded that generally only one independent claim per category is permitted. Most of these Offices also outlined some exceptions to this general requirement. The Working Group is of the opinion that it would be beneficial if all Offices had a general provision aimed at limiting the number of independent claims in a patent application.

The recommendation's aim is to have a simplified discussion with the applicants on inadmissible claim proliferation but without changing the scope of protection obtainable. In examination proceedings, the amount of work required is to a large extent dependent on the number of independent claims in the application. A large number of such claims in the granted patent also makes it difficult for third parties and national judges to determine the scope of protection conferred by the patent. If the number of independent claims in a patent application gives rise to objections under the requirements of clarity and conciseness of the claims (Article 6 PCT), an examiner can insist on a limitation of this number by strictly applying these requirements. However, they must provide detailed reasons demonstrating that the objections are a direct consequence of the presence of excessive independent definitions of the subject-matter for which protection is sought. A considerable increase of procedural efficiency is therefore achieved if the examiner has at their disposal a requirement imposing a clear limitation on the number of independent claims.

The proposed recommendation sets up and defines the principle of "one independent claim per category" (see Rule 43(2) EPC). The only admissible exceptions to this principle are explicitly stated in the recommendation, which is intended to have the same effect as a strict application of Article 6 PCT but which relieves the examiner of the requirement to provide lengthy substantive reasoning. Exceptions can only be admitted in the specific circumstances defined in subparagraphs (a), (b) and (c), provided the requirement of unity of invention is met. An applicant wanting more than one independent claim in the same category must, if an Office objects, convincingly demonstrate that all the additional independent claims come under one of the exceptions explicitly given in the recommended provision. So the onus is on the applicant. It is to be noted that the requirement of one independent claim per category is without prejudice to obtaining a filing date.

Examples of typical situations falling within the scope of the exceptions from the principle of one independent claim per category can be shown in examination guidelines or similar texts. The Guidelines for Examination at the EPO (see F-IV, 3.2) contain examples of the specific circumstances defined in sub-paragraphs (a), (b) and (c) as well as some examples of allowable claim types. Examples of a plurality of interrelated products (sub-paragraph (a) of the recommendation) are: plug and socket; transmitter – receiver; intermediate(s) and final chemical product; gene – gene construct – host – protein – medicament.

Despite the semantic differences observed amongst the Working Group participants, there are two basic kinds of claim: claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or composition (for example a chemical compound or a mixture of compounds) as well as any physical entity (for example an object, article, apparatus, machine, or system of cooperating apparatuses) which is produced by a person's technical skill. The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things.

2.4 Requirements for dependent claims

The answers to the questionnaire showed that the formal requirements for dependent claims are not fully aligned in the Offices participating in the Working Group in particular as regards the placement of the reference to another claim at the beginning of the dependent claim, if possible. A few Offices do not have any express requirements at all. Therefore, the Working Group recommends that Offices are to provide that any claim which includes all the features of one or more other claims ("dependent claim") does so by a reference, if possible, at the beginning, to the other claim or claims and then states the additional features claimed, in line with the provisions of the Patent Cooperation Treaty (see Rule 6.4(a) PCT).

In view of the fact that not all Offices prescribe a certain grouping of dependent claims, the Working Group also recommends that Offices provide that all dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, are grouped together to the extent and in the most practical way possible, in line with the provisions of the Patent Cooperation Treaty (Rule 6.4(c) PCT). The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner is to invite the applicant to submit a suitable amendment if the arrangement of claims is such that it creates obscurity in the definition of the subject-matter to be protected.

2.5 Number of claims

Although all the respondents explained that there was no explicit limit imposed on the **overall number of claims** in an application, some Offices highlighted further that their jurisdiction foresees generally that the number of claims may be limited in some way. The Working Group, considering the provisions of the Patent Cooperation Treaty (Rule 6(1)(a) PCT), recommends that Offices are to expressly provide that the number of claims is reasonable in consideration of the nature of the invention claimed. What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case. The interests of the relevant public must also be borne in

mind. The presentation of the claims must not make it unduly burdensome to determine the matter for which protection is sought.

Most replies from the Offices show that an **additional fee** is prescribed where the applicant exceeds a certain number of claims. The responses were varied as to the number of claims triggering an additional fee. The Working Group is of the opinion that there should be an incentive for applicants not to exceed a certain number of claims. It therefore recommends in particular that Offices are to provide that the applicant is to pay a fee if they exceed a certain number of claims, which is to be determined by the Offices in accordance with the applicable national law. The amount of this fee is also to be determined by the national Offices.

2.6 Application containing drawings: reference signs linking the claims to the drawings ("Reference signs")

The majority of the respondents stated that they do indeed have requirements regarding the use of reference signs in claims. However, a few national Offices responded that they do not have any requirements regarding the use of reference signs in claims.

Therefore, the Working Group recommends that Offices are to expressly provide that if a patent application contains drawings and the technical features of the claims would be rendered more intelligible by relating those features to the corresponding features of the drawings, this is preferably to be done by placing the appropriate reference signs in parentheses after the features in the claims (see Rule 6(2)(b) PCT). These reference signs should not, however, be construed as limiting the scope of a claim, but merely as aids for more easily understanding the defined subject-matter (see also the PCT International Search and Preliminary Examination Guidelines, point 5.11).

2.7 Tables

As a few Offices answered that the claims are not allowed to contain tables, the Working Group recommends that Offices are to provide that the claims may contain tables only if their subject-matter makes the use of tables desirable. In view of the use of the word "desirable", the examiner should not object to the use of tables in claims where this form is convenient (see Rule 11.10(c) PCT, and the PCT International Search and Preliminary Examination Guidelines, point 5.09).

2.8 Values and units

A few Offices responded that they do not require conformity to international standards. The Working Group therefore recommends that Offices are to provide that values are expressed in units conforming to international standards, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement must also be expressed in units conforming to international standards. Only the technical terms, formulae, signs and symbols generally accepted in the field in question must be used.

The results of the questionnaire also showed that not all Offices provide a list of the accepted standards. Hence, the Working Group, considering the usefulness of such a list for the users, recommends that Offices are to provide a list or overview of units recognised in international standards and complying with national requirements (see the Guidelines for Examination at the EPO,

F-II, Annex 2 for an example of such a list). Using internationally accepted measurement units is conducive to a common understanding and makes the examining procedure more efficient and transparent for all parties. In addition, it enables the examiner of each Office to more easily raise deficiencies regarding values in a claim that are not expressed in units conforming to international standards.