

EPO Claim Fees - To Claim or not to Claim?

The introduction of substantial Claim fees by the EPO on the 1 April 2008 has placed a significant financial burden on Applicants and presented Patent Attorneys around the world with a major problem when prosecuting European patent applications.

For every European or EURO-PCT application filed at the EPO on or after 1 April 2008, the 16th claim, and each subsequent claim, attracts a fee of €200 (approx US\$300) per claim.

As an example, even for a modest patent application comprising 35 claims, extra fees of €4,000 (approximately US\$6,000) have to be paid to the EPO. Under the old fee regime only €1,125 (approx US\$1,700) claim fees would have been due.

What should Applicants/Attorneys be doing for European applications?

Our Recommendations:

1. Review each application: The claim structure of each application should be carefully reviewed to conform with European practice, preferably by an experienced European Patent Attorney, before entry into the European phase from a PCT application or filing directly at the EPO.

2. Reduce the number of claims: It is sometimes possible to reduce the number of claims without limiting their scope. A simple example of effective claim reduction is where a US originating application comprises twenty method claims and twenty corresponding system claims. By taking advantage of multiple claim dependency practice, allowed in Europe, it is possible to replace the twenty system claims with a single independent system claim adapted to perform all the method steps of the twenty method claims. Thus,

the net effect is that €3,800 (19 claim fees) in fees are saved, without limiting the scope of the claims under European practice.

3. Recite cancelled claims in the specification: Where it is not possible to simply reduce the claims without affecting their scope, it is advisable to ‘cherry’ pick the most important claims that best encapsulate the invention and cancel the remainder of the claims. For cancelled claims, care should be taken to ensure that the exact subject matter is included in the description for either possible re-introduction during the examination phase or to form the basis of any future divisional applications.

4. Claim fees are not due on filing: Where time is a factor for considering claim reduction, an important point to note is that claim fees do not have to be paid on filing. For EURO-PCT filings claim fees are due one month from the issuance of the Rule 161/162 EPC communication, that typically issues two to four weeks after entering the European regional phase. In response to this EPC Communication, the options are to pay the extra claims fees due, or amend the claims to reduce/remove the extra claims fees. Thus, there is usually a six to eight week window in which to decide a claim strategy for EURO-PCT filings. For European direct filings, a period of one month is allowed in which to validly pay the claim fees under Rule 45 EPC.

5. Consider possibility of filing a divisional application: If there are clearly two separate inventive concepts included in the claims, then an advisable course of action is to select the most important embodiment and include the second embodiment in the description. This approach avoids any possible unity of invention objections that may be encountered during European prosecution and also can substantially save on claim fees. A good indicator to determine whether unity of invention could be a problem is to review the International Search and Non-Binding Opinion on Patentability, especially if the EPO was the designated International Search Authority. A decision can be made on filing a divisional application any time up until the mention of grant of the parent application to obtain protection for the second embodiment.



Summary

It is clear that the recent EPO changes in the Claim fees means that Applicants will have to decide much earlier than before what claims they would like prosecuted/granted, otherwise substantial official fees will have to be paid.

[PURDYLUCEY](#) provides a specialized patent service for entering PCT applications into the European phase and direct European filings. This includes an expert review of the claims by an experienced European Patent Attorney and, where possible, providing practical recommendations to reduce the claim fees, without compromising the scope of protection sought in the patent application.

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