

Tips For US IP Attorneys: 5 Occasions Your European Attorney Can Add Value

Background

If you are a US IP attorney who regularly helps your clients to protect their IP in Europe, then this quick guide could help you to get the most out of your European attorney relationship.

5 Occasions Your European Attorney Can Add Value

1) Drafting

If your application is destined for Europe, it is vital that the correct EPO-style language is in place in the application as filed.

This can avoid falling foul of the EPO's very strict added subject matter requirements when amending/adding claims during prosecution. There are several ways in which amendments that are perfectly allowable in the US can face tricky objections at the EPO which may not be solvable during prosecution without sub-optimal claim limitations. Your European attorney can help you avoid these traps, saving time and money during prosecution and giving the application the best chance of reaching grant in Europe with a broad claim scope.



If your application relates to a Computer Implemented Invention, then your European attorney can also advise on language and features that should be included to demonstrate patentability within the EPO framework for examining these types of inventions. See our article on AI Drafting Tips for more information on the type of information that should be included: [AI Drafting Tips](#).



2) When Considering PCT Entry To The European Regional Phase

Especially if your application relates to a Computer Implemented Invention or another area which can be judged as unpatentable/non-technical, your European attorney can advise on the chance of success of the application at the EPO before government fees are paid which represent the bulk of the costs at the filing stage. This can help applicants in these technology areas focus their resources on the applications that stand the best chance of success in Europe.

3) When Choosing Other PCT National Phase Entries

There are many countries that can be covered by a European application. Some are obvious (Germany, France, UK, etc.), but some are quite surprising (for example, Cambodia!). Double check your regional/national phase countries with a European attorney to avoid unnecessary prosecution!

4) When Choosing Amendments At The EPO

Amending the language of a claim at the EPO needs to be done carefully to ensure EPO-style basis is found in the application as filed. It may not be possible to choose the same language that has been successful at the USPTO, due to EPO examiners' very different approach. Working with your European attorney to draft EPO-friendly claim amendments can reduce added subject matter objections and often avoid them all together.

5) Selecting Validations And/Or The New Unitary Patent

The Unitary Patent system is expected to come into force in April 2023. With a new set of options, your European attorney can help you decide which route to take. See our Knowledge Hub on our website for more information: [Unitary Patent Update](#). Or get in touch!

Contact Us

If you would like further information on how we could help in the above areas, please contact **Louise Carr** for an initial discussion.



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