

4 KEY TAKEAWAYS

Traps for the Wary: Patent Prosecution Pitfalls Around the World

Patent prosecution can be full of surprises, sometimes unpleasant. Kilpatrick's [Steve Borgman](#) recently presented "**Traps for the Wary: Patent Prosecution Pitfalls Around the World**" at the [30th Annual University of Texas Advanced Patent Law Institute](#). The presentation discussed the requirements that may surprise U.S. patent practitioners handling applications filed in other countries like Canada, Mexico, and Europe, as well as ways to avoid unpleasant surprises.

Steve's key takeaways from the presentation include:

1

U.S.-based applicants file lots of ex-U.S. applications. In Europe, U.S. applicants account for almost a quarter of all filings in the EPO, and in Canada and Mexico, U.S. applicants account for a little less than half of all filings. Europe, Canada, China, Japan, and Korea account for the majority of ex-U.S. filings by U.S. applicants.

2

Planning ahead for ex-U.S. prosecution can be vital. For example, preparing the claims and specification with the EPO's strict "golden rule" in mind can provide more options for claim amendments in response to rejections from a European Examiner. Europe tends to take a fairly strict view of the claim amendments that will be allowed, as compared to the U.S.

3

Keep up with changes in the law. Both Canada and Mexico have recently adopted new laws and procedures that can affect your patent filing strategies. In Canada, the new rules on excess claims fees and the prohibition against double-patenting may drive the applicant to include a variety of different independent claims that one might not expect to see in a U.S. application. In Mexico, you might be required to file your divisional applications at the time of a response to a restriction requirement, and the IMPI no longer allows "cascading" divisional applications.

4

Find good counsel in the countries of interest for your filings and listen to them. Good local counsel can help keep you apprised of recent developments and strategies to address them. They can also provide advice on drafting your applications for later prosecution in their country.