

## Best Practices for Drafting and Prosecuting Standard-Essential Patents

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Standard-essential patents (SEPs) are highly valued in any patent portfolio. To build a robust SEP portfolio, it is critical to follow practices that survive the Examiner's scrutiny while maintaining sufficient breadth for essentiality to current or future industry standards. It is also important to generate quality SEPs that can survive invalidity attacks in both litigation and administrative challenges.

### Introduction

SEPs are valuable because they protect technology essential to implementing a specific industry standard and can potentially be licensed to a large number of companies producing products in that market. SEPs are obtained through the patent application process, which involves examination at the patent office for meeting necessary requirements such as novelty, non-obviousness, and subject matter eligibility. It is common for SEP applications to undergo an amendment process when the patent examiner finds the original claims filed in the application do not meet certain patentability requirements.

Companies filing SEP applications may face unique challenges during examination. While it may be desirable to narrowly amend claims to achieve allowance, this may cause the claims to lose their essentiality to an industry standard. In this article, we will explore the intricacies of SEP patent prosecution and provide tips and strategies to build a valuable and robust SEP portfolio.

### Preparing a Strong SEP Application with Sufficient Details and Variations

A clear, robust, and comprehensive application is the first step for procuring a standard essential patent. It is essential to provide a clear and detailed description of the invention including its unique features and technical benefits. In some cases, the Examiner may reject the claims as not novel or obvious based on documents such as a prior industry standard. Thus, including a description of how the invention is different from the prior generation or version of a relevant industry standard can help to persuade the Examiner how the claims are allowable over the prior standard.

This description of how the invention is different from the prior standard can also be useful to explain the subject matter eligibility of the invention, should the Examiner find the claims are directed to an abstract idea and not patent eligible. This principle is illustrated by the 2020 Federal Circuit case *Uniloc v. LG Electronics*, where claims were deemed "directed to a specific asserted improvement to the functionality of the communication system itself" based on the description of the patent, and thus patent eligible.

It is also important to include in the application embodiments covering variations that could be adopted by industry standards. At the time an application is filed, it may be difficult to predict the specific implementation that would be adopted in specific industry standards. Therefore, working with the inventors to include variations of embodiments in the specification enhances the likelihood of obtaining a SEP patent.

As the Federal Circuit explained in the 1991 case *Vas-Cath v. Mahurkar*, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”

Industry standards often use terminologies that have specific meanings to that standard. Using terminologies consistent with the industry standard and explaining the terminologies clearly in the specification also make it easier to show essentiality to the standard and enhance the resulting SEP’s value for enforcement, minimizing the risk of interpreting the invention differently from the relevant industry standard.

A good example is the 2024 Federal Circuit case *3G Licensing v. Honeywell*, where a claim term was construed consistent with how the term is used in technical standard documents. There the Court concluded the term “E-AGCH” requires an absolute grant, consistent with the statement in the 3GPP standard document that E-AGCH is a physical channel carrying the uplink E-DCH absolute grant.

## Drafting Claims with Appropriate Scope and Solid Support

While it is often desired to pursue claims with a broader scope, drafting claims with an appropriate scope that avoids prior industry standards provides a more robust application. Capturing in the claims features distinct from a prior standard provides a better chance to overcome the scrutiny of patent examiners and to survive invalidity challenges based on the prior standard if the SEP is to be enforced.

During prosecution, it is always important to closely monitor the development of a relevant standard and ensure that any necessary claim amendments still fall within the purview of the standard. Seeking legal expertise is paramount in procuring a strong, enforceable SEP. Patent attorneys experienced in SEP prosecution can often find amendments that do not affect the standard essentiality of claims while effectively overcoming the Examiner’s rejections and moving prosecution forward.

An issue frequently encountered during prosecution and enforcement of SEPs is a lack of sufficient support from the specification for the amendments made during prosecution.

A recent example is *Telit Cinterion Deutschland v. 3G Licensing*, where in 2025 the Federal Circuit vacated a decision upholding amended claims, because the underlying decision failed to properly assess whether the claim amendments introduced new limitations not originally described in the patent. This analysis requires careful review of the specification, prior art cited by the Examiner, and the industry standard to come up with claim amendments that meet the patent office’s requirements regarding written description, novelty, and non-obviousness and also maintain essentiality to the industry standard.

It would also be valuable to include claims that are highly likely to be implemented by products practicing the relevant standard, even if the claims themselves are not necessarily essential to the standard. Industry standards typically do not prescribe how products should be implemented in order to comply with the standard.

Claims focused on product implementation – if not standard-essential – would not be subject to the fair, reasonable and non-discriminatory (FRAND) obligations, and thus can add value to a patent portfolio during enforcement or licensing negotiations.

## Maintaining Pendency of SEP Applications on a Jurisdictional Basis

For important SEP applications, a strategy of maintaining pendency of applications with a worldwide protection plan could further the goal of increasing the number and quality of SEPs in the portfolio.

A “continuation” SEP application allows the applicant to refine claim scope and is often assigned to the same Examiner who is familiar with the subject matter of the parent SEP application. As the industry standard continues to develop, a continuation SEP application provides an opportunity to amend claims to fall into the scope of the standard by maintaining the pendency of the application.

A continuation application also allows the applicant to broaden the scope of the claims by maintaining the allowable subject matter of the parent SEP application and omitting other unnecessary limitations.

Achieving a global patent strategy for SEP applications is also paramount, because of the global nature of many industry standards. Consistency among prosecution of SEP applications before different jurisdictions produces patents more robust to invalidity challenges and less prone to disputes on claim meanings during enforcement. Statements made before patent offices of other countries may inform claim scope of a U.S. patent, as the Federal Circuit found in the 2023 case *K-free System v. Nespresso USA*.

To reduce prosecution costs, SEP patent holders should consider the importance of SEPs in different jurisdictions and develop patent strategies accordingly. For example, if products practicing the relevant industry standard are manufactured – by the SEP owner or a competitor – predominantly in a certain jurisdiction, it may be particularly important to obtain SEPs in that jurisdiction.

On the other hand, if products practicing the relevant industry standard are not manufactured or sold in a certain jurisdiction, SEP patent holders may elect to forgo SEP patents in that jurisdiction to save costs.

## Conclusion

A strong SEP portfolio can be a great asset to its owner. Taking the time and effort to carefully draft and prosecute SEP applications can yield quality SEPs. Continuation applications and worldwide protection also provide opportunities to expand SEP portfolios in a cost-efficient manner.

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