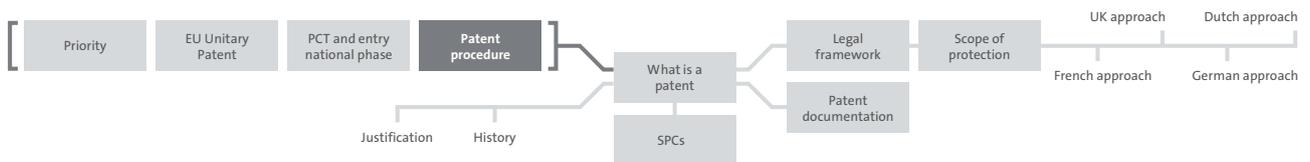


Patent procedure

Essentials: Procedure



The European Patent Office and the Administrative Council

The European Patent Organisation is an intergovernmental organisation set up in 1977 on the basis of the European Patent Convention (EPC).

It has two organs: the European Patent Office (EPO), which is the executive arm of the European Patent Organisation and the Administrative Council, which supervises the activities of the European Patent Office (Article 4 EPC).

The EPO's core activity is the examination of patent applications and the grant of European patents.

The EPO is also responsible for:

- Examining oppositions filed against granted European patents.
- Providing patent information and training services.

The European Patent Organisation currently has **38 member states (Contracting states)**. There are a further **two extension states and four validation states** recognising European patents upon request.

38 member states

Albania; Austria; Belgium; Bulgaria; Switzerland; Cyprus; Czech Republic; Germany; Denmark; Estonia; Spain; Finland; France; United Kingdom; Greece; Croatia; Hungary; Ireland; Iceland; Italy; Liechtenstein; Lithuania; Luxembourg; Latvia; Monaco; Former Yugoslav Republic of Macedonia; Malta; Netherlands; Norway; Poland; Portugal; Romania; Serbia; Sweden; Slovenia; Slovakia; San Marino; Turkey.

Two extension states

Bosnia and Herzegovina; Montenegro

The EPO's official languages

The EPO has three official languages: English, French and German.

Applications may be filed with the EPO in any language. However, according to **Article 14(2) EPC**, applications made in any language other than the EPO's official languages (i.e. English, French or German) must be translated into one of the official languages.

Article 14(2)(3)(6) EPC

Languages of the European Patent Office, European patent applications and other documents

→ see below

This must be done within two months of the initial filing. If the required translation is not filed in due time, the application will be deemed to have been withdrawn.

Article 14(2)(3)(6) EPC

Languages of the European Patent Office, European patent applications and other documents

(2) A European patent application shall be filed in one of the official languages or, if filed in any other language, translated into one of the official languages in accordance with the Implementing Regulations. Throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the application as filed. If a required translation is not filed in due time, the application shall be deemed to be withdrawn.

(3) The official language of the European Patent Office in which the European patent application is filed or into which it is translated shall be used as the language of the proceedings in all proceedings before the European Patent Office, unless the Implementing Regulations provide otherwise.

(6) Specifications of European patents shall be published in the language of the proceedings and shall include a translation of the claims in the other two official languages of the European Patent Office.

Composition of the EPO

The procedures under the EPC are carried out by the following units of the European Patent Office:

- Receiving Section
- Search divisions
- Examining divisions
- Opposition divisions
- Legal Division
- Boards of Appeal
- Enlarged Board of Appeal

The Receiving Section is responsible for the preliminary examination of applications for patents, i.e. for ensuring that applications are complete and that the relevant fees have been paid (Article 16 EPC).

The search divisions are responsible for drawing up search reports, i.e. creating a list of the documents which shall be considered when deciding whether the invention to which a patent application relates is patentable (Article 17 EPC).

Examining divisions are responsible for the substantive examination of patent applications, i.e. determining whether the claimed invention is patentable or not (Article 18 EPC).

Opposition divisions are responsible for the examination of any oppositions against European patents.

The Legal Division is responsible for maintaining the Register of European Patents and the list of professional representatives (Article 20 EPC).

Boards of Appeal

The technical Boards of Appeal hear appeals against decisions of the Receiving Section and the examining and opposition divisions, whereas the Legal Board of Appeal hears appeals against decisions of the Legal Division.

The Boards of Appeal are independent of the Office in their decisions and are bound only by the EPC itself. The EPC safeguards the independence and impartiality of their members who shall not be bound by any instructions other than the provisions of the EPC (Art. 23(3) EPC). The members of the Boards of Appeal are appointed by the Administrative Council of the European Patent Organisation for a term of five years.

Decisions of the boards are made available via the European Patent Register and the EPO's Official Journal. A database of decisions is also available online.

Enlarged Board of Appeal

The Enlarged Board of Appeal ensures the uniform application of the law. If an important point of law arises, a question can be referred to the Enlarged Board of Appeal, either by a Board of Appeal or by the President of the Office.

The Enlarged Board of Appeal

The Enlarged Board of Appeal deals with cases referred to it either by one of the technical boards of appeal, by the Legal Board of Appeal or by the President of the European Patent Office. Cases are referred to the Enlarged Board for a decision on an important point of law or in order to secure uniform application of the law (Article 112 EPC).

The Enlarged Board also examines petitions for review of decisions of the Boards of Appeal under Article 112(a) EPC.

The choice of application route

There are a number of different routes to patent protection. The optimal route for any given invention will depend on the markets in which protection is desired.

The EPO accepts applications under the European Patent Convention (EPC) and the Patent Cooperation Treaty (PCT). Alternatively, applicants may choose to apply direct to the national offices of the states in which they desire protection. This latter route may prove to be financially worthwhile where the number of states in which protection is desired is small.

Filing an application under the European Patent Convention

Any natural or legal person may file a patent application (Article 58 EPC).

Applications may be filed by single or multiple applicants, and by different applicants either jointly or with each designating different contracting states (Article 59 EPC). Nevertheless, the right to be granted a European patent belongs primarily to the inventor or their successor in title. Where the inventor is an employee, the national law of the state in which the inventor is mainly employed will be used to determine ownership of the patent (Article 60 EPC).

In any case, the inventor has the right to be named as such before the European Patent Office (Article 62 EPC).

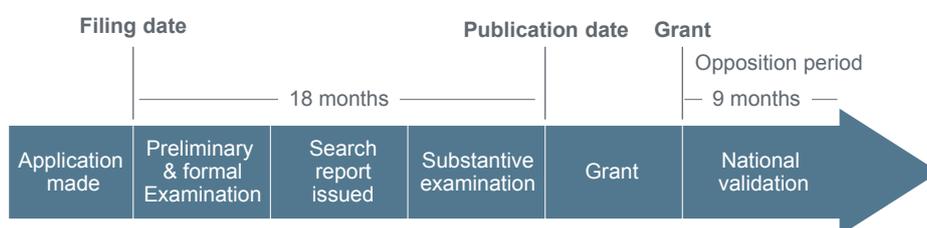
Designation

Applicants for a European patent “designate” the contracting states in which protection is desired.

When a European patent application is filed, all the contracting states are deemed to be designated by default.

However, these designations must subsequently be confirmed by payment of the appropriate fee. Accordingly, before this fee is paid, applicants may withdraw applications in states where protection is not required.

Application process



Significant dates and periods

There are a number of critically important dates or periods of time that have special significance in the European patent system. They include the priority date, the filing date, the date of publication, the date of grant and the opposition period.

The date of filing and date of priority

The date of filing is the date on which the application as received by the **Receiving Section** satisfies **certain requirements**.

It is the date from which the term of the patent is calculated (Article 63 EPC).

In certain cases applicants may claim an earlier priority date (up to 12 months earlier) of a **“Convention” application** for the same invention (Article 87 EPC), provided that they are also the applicants of the earlier application (or their successor in title).

In order to sustain a claim for priority, the application must be supported by matter disclosed in the earlier application. In practice, this means that the specific combination of features present in the claim must be at least implicitly disclosed in the previous application.

The filing date will represent the date at which the invention’s patentability (novelty, inventive step, etc.) is assessed.

Matter made available to the public before the application’s priority or filing date will be considered part of the prior art.

Receiving Section

The EPO has filing offices in Munich, The Hague and Berlin.

Certain requirements

Rule 40(1) EPC

The date of filing of a European patent application shall be the date on which the documents filed by the applicant contain:

- (a) an indication that a European patent is sought;
- (b) information identifying the applicant or allowing the applicant to be contacted; and
- (c) a description or reference to a previously filed application.

“Convention” application

An application in a Paris Convention state or a WTO member state.

Decision of the Enlarged Board of Appeal G 2/98

The patenting process under the EPC for European patents

Preliminary examination

When an application is received by the Receiving Section, the documents making up that application are first marked with the date of receipt and a receipt is issued to the applicant.

The EPO then examines the application to determine whether it meets the minimum requirements for according a filing date, i.e. that it contains:

- (i) an indication that a European patent is sought;
- (ii) information identifying the applicant or allowing the applicant to be contacted; and
- (iii) a description or reference to a single previous application.

Applicants do not actually have to provide any claims in order to obtain a date of filing. If an application is filed without claims, but satisfies all the requirements for obtaining a date of filing, the applicant will be requested to provide at least one claim later.

Formal examination

Once the application has been accorded a filing date, the Receiving Section then examines it to ensure that it meets a number of formal requirements. These requirements are set out in Article 90(3) EPC and relate to the following:

- (i) representation
- (ii) physical requirements of the application
- (iii) abstract
- (iv) request for grant
- (v) claim to priority
- (vi) designation of the inventor
- (vii) translations, where required
- (viii) the presence of at least one claim
- (ix) filing and search fees

The Receiving Section also checks the claims and description in order to ensure that the title of the invention is in general accord with **Rule 42 EPC**. It checks that any other relevant fees have been paid and that deposits of biological material have been made, or sequence listings provided for nucleotide and/or amino acid sequences, where appropriate.

Rule 42 EPC
Content of the description
→ see below

Rule 42 EPC

Content of the description

- (1) The description shall:
 - (a) specify the technical field to which the invention relates;
 - (b) indicate the background art which, as far as is known to the applicant, can be regarded as useful to understand the invention, draw up the European search report and examine the European patent application, and, preferably, cite the documents reflecting such art;
 - (c) disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;
 - (d) briefly describe the figures in the drawings, if any;
 - (e) describe in detail at least one way of carrying out the invention claimed, using examples where appropriate and referring to the drawings, if any;
 - (f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable.
- (2) The description shall be presented in the manner and order specified in paragraph 1, unless, owing to the nature of the invention, a different presentation would afford a better understanding or be more concise.

Search and publication

Search

The aim of the search is to discover the prior art which is relevant to determining whether (and if so to what extent) the claimed invention for which protection is sought is new and involves an inventive step.

Searches are made on the basis of the claims, with due regard to the description and drawings (if any) (**Article 92 EPC**).

A search report is prepared containing the results of the search, in particular identifying the documents constituting the relevant prior art.

A non-binding opinion on patentability is also issued.

Article 92 EPC

Drawing up of the European search report

The European Patent Office shall, in accordance with the Implementing Regulations, draw up and publish a European search report in respect of the European patent application on the basis of the claims, with due regard to the description and any drawings.

Publication

Applications are published as soon as possible after the expiry of a period of 18 months from the date of filing or, where priority is claimed, from the earliest priority date. They may, however, be published before this if requested by the applicant and provided that the relevant fees have been paid (**Article 93(1) EPC**).

If the application is withdrawn before this date, its contents do not become part of the state of the art.

The publication must contain the description, the claims and any drawings as filed, including any late-filed missing parts of the description or missing drawings (Rule 56 EPC). It must also specify, where possible, the names of the person or persons designated as the inventor(s).

Article 93(1) EPC

Publication of the European patent application

(1) The European Patent Office shall publish the European patent application as soon as possible

(a) after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, from the date of priority, or

(b) at the request of the applicant, before the expiry of that period.

Following publication

Provisional protection in all states designated is obtained upon publication. Applicants may therefore claim reasonable compensation from third parties who infringe their patent applications after this point, provided that the application eventually proceeds to grant. However, the patent does not convey any rights to enforce the patentee's monopoly until the date of grant. In effect, it means that in an action for infringement, claims for compensation can be backdated to the publication date.

In order to take the application further once it has been published, various fees must be paid. These include an examination fee and a designation fee (as well as an extension fee (if applicable)).

After publication of the application, third parties may present observations on the patentability of the invention to which it or the patent relates, as long as proceedings are pending before the EPO. These observations may be filed online and are free of charge.

Substantive examination

Following a **request for examination** and payment of the appropriate fee, the application is transferred to the examining division, where it is subjected to substantive examination. If no request for examination is made within six months of publication, the application is deemed to be withdrawn.

Substantive examination considers the patentability of the application, i.e. whether the invention is new, involves an inventive step, is capable of industrial application and does not fall within excluded subject-matter and some other requirements, such as whether the invention as disclosed in the application can be reproduced, the clarity of the claims, or whether any amendments go beyond the disclosure of the application as originally filed.

If the examination reveals that the application or the invention to which it relates does not meet the requirements of the EPC, the examining division will raise the appropriate objections. The applicant may provide counter-arguments and/or amendments to try and overcome these objections. If all objections are overcome, a patent will be granted. Otherwise the application will be refused.

Request for examination

The request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report.

Article 123(1) EPC Amendments

(1) The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. In any event, the applicant shall be given at least one opportunity to amend the application of his own volition.

Pre-grant amendment

Applicants may amend their applications before the patent is granted with relative ease (although for European patents filed directly at the EPO (not via the PCT) they may only be amended once the European search report has been received – see Rule 137(1) EPC).

Under Article 123(1) EPC applicants must be given at least one opportunity to amend the application of their own volition. Applications may also be amended in response to the search opinion (**Rule 137(2) EPC**) or to objections raised during examination (see Rule 71(1) EPC and Article 94(3) EPC).

Applicants may correct **obvious errors** at any time (Rule 139 EPC).

In all cases, the amendments made must satisfy the following conditions:

- (i) They must not add subject-matter to the content of the application as filed (Article 123(2) EPC).
- (ii) They must not themselves cause the application as amended to be objectionable under the EPC, e.g. they must not introduce a lack of clarity into the claims (Article 84 EPC).

Rule 137(2) EPC Amendment of the European patent application

(2) Together with any comments, corrections or amendments made in response to communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1, the applicant may amend the description, claims and drawings of his own volition.

Obvious errors

Obvious errors include linguistic errors and errors of transcription as well as other mistakes in documents filed with the EPO. Where the mistake is in the description, claims or drawings, both the error and the correction must be such that it is immediately evident (at least once attention is directed to the matter) that both (a) an error has occurred; and (b) what the correction should be. Both requirements are viewed through the eyes of the person skilled in the art.

- (iii) They must comply with Rule 137(5) EPC in that the amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

Grant

If the examining division has decided that a patent can be granted, it must inform the applicant of the text (i.e. specification (including claims)) on the basis of which it intends to grant it.

The text is communicated to the applicant along with an invitation to pay a fee for grant and publishing and a request that they file a translation of the claims into the two official languages of the EPO other than the language of the proceedings. An additional fee is also payable for each claim over and above 15 that is contained in the application.

The decision to grant

Once the requirements are satisfied, the decision to grant the patent will be issued. The decision to grant contains the date of the mention of the grant of the European patent and is sent to the applicant when the technical preparations for printing the patent specification have been completed. As soon as possible after the mention of the grant is published in the Bulletin, the EPO publishes the patent specification containing the description, claims (in the three official languages) and any drawings.

Grant and validation

The grant does not take effect until the date on which it is mentioned in the European Patent Bulletin.

The granted European patent is a “bundle” of individual national patents. In many contracting states, for the patent to retain its protective effect and be enforceable against infringers, it must undergo a further process of validation once it has been granted by the EPO. This means that, where necessary, the patent owner has to file with the national patent office concerned a translation of the specification, or at least of the claims, into an official language of the state concerned. Fees may also be payable by a certain date. These matters are governed by national law.

Opposition

After the European patent has been granted, it may be opposed by third parties – usually, but not necessarily, the applicant’s competitors – if they believe that it should not have been granted (for example, because the invention lacks novelty or does not involve an inventive step).

Oppositions are objections raised by third parties to the grant of a European patent. They must be filed within nine months of the mention of the grant of the patent in the European Patent Bulletin.

The examination of oppositions is handled by the opposition division.

If the opposition is successful, the patent is invalidated at source. If the opposition period has passed and the European patent has entered the national phase, anyone wishing to invalidate the patent will have to bring separate revocation actions in all the states in which the patent has effect (Article 19 EPC).

Renewal

The maximum life of a patent is 20 years from the date of filing. However, for it to remain effective, regular renewal fees must be paid. European patent applications are subject to renewal fees in respect of the third and each subsequent year, calculated from the date of filing (see **Article 86(1) EPC**).

Renewal fees in respect of the coming year are due on the last day of the month in which the anniversary of the date of filing falls. Fees increase year on year until year 10, after which they remain at the same level.

After mention of the grant, renewal is governed by national law.

Payment may still be validly made up to six months after the due date for a renewal fee, provided that an additional fee equal to 50% of the renewal fee is paid within the same period.

Article 86(1) EPC

Renewal fees for the European patent application

(1) Renewal fees for the European patent application shall be paid to the European Patent Office in accordance with the Implementing Regulations. These fees shall be due in respect of the third year and each subsequent year, calculated from the date of filing of the application. If a renewal fee is not paid in due time, the application shall be deemed to be withdrawn.