

Learning path for patent administrators

General aspects of the patent system: EPAC - entry level

Version: October 2022



Introduction

This publication, "General aspects of the patent system, EPAC - entry level", is part of the "Learning path for patent administrators" series is edited and published by the European Patent Academy. The series is intended for patent administrators who are taking part in training and certifications organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include: general aspects of the patent system; the European patent system and the European patent granting procedure; the International Patent System (PCT) and the PCT procedure; European and international publications; filing a European patent application and filing an international application; the formalities during the European and during the international search; the formalities during the European examination and during the international preliminary examination; the formalities during the appeal procedure after refusal (EPC), during the opposition procedure (EPC); national validation (EPC); entry into national/regional phases and entry into the European phase (PCT).

Each chapter focuses on one topic at entry, intermediate or advanced level, as appropriate. The series will be revised annually to ensure it remains up to date.

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All references to natural persons are to be understood as applying to all genders.

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1. Learning objectives

Participants in this course will learn:

- the definition of a patent and the structure of its specification
- the requirements for patentability
- the geographical scope of a patent
- the different patenting routes
- the priority concept
- the definition of ownership and inventorship as well as transfer of rights

2. Background to the patent system

The patent system is designed to facilitate and encourage disclosure of innovations. A patent has two important functions: legal protection of an invention and contribution to economic growth by giving public access to new technologies.

A patent is an exclusive intellectual property right granted for an invention as it prevents others from making or selling a product or implementing a process without the patent owner's consent. A patent can protect an invention for up to 20 years and has territorial effect. The patenting system includes national, regional and international patenting systems. The role of IP (intellectual property) is to establish and protect ownership of ideas and the way they are represented and applied.

Examples

Within IP there are patents (providing protection for IP rights), the Paris Convention (providing protection for intellectual work), the Patent Cooperation Treaty (providing international protection for inventions) and the European Patent Convention (special agreement within the meaning of the Paris Convention).

Legal references:

Art. 87-89 EPC

Rule 157-165 EPC

3. What is a patent?

A patent is a legal title granting its holder the right – in a particular country and for a certain period of time – to prevent third parties from exploiting an invention for commercial purposes without authorisation. The standard protection term of a patent is generally 20 years from the date of filing. Provided that the annual renewal fees are duly paid, patents will remain in force for the maximum protection term.

Some important aspects of a patent as such are the invention itself (the core of a patent), the wording defining the invention (as a legal document), the technical terms used (these can be crucial for a patent) and the level of detail that defines the invention (there should be a sufficient level of detail).

Examples

- In each contracting state for which a patent is granted, a European patent gives its proprietor the same rights as would be conferred by a national patent granted in that state. If its subject-matter is a process, protection is extended to products directly obtained by that process. Any infringement of a European patent is dealt with by national law.
- The problem solved by the invention must thus be a technical problem rather than, for example, a purely financial, commercial or mathematical one. This requirement must be met in order for the invention not to be excluded from patentability. An invention can, for example, be a product, a process or an apparatus.

Legal references:

Art. 63, 64 EPC

4. Structure of a patent specification

The description must specify the technical field to which the invention relates, indicate the background art by citing source documents (patent specifications, books, periodicals), disclose the invention as claimed (the disclosure must indicate the technical problem that the invention solves and describe the solution), describe what is illustrated in any drawings (providing figure numbers and reference signs) and indicate how the invention is susceptible of industrial application.

The claims must define the subject-matter for which protection is sought in terms of the technical features of the invention. They must be clear and concise and supported by the description. An independent claim must state all the essential features of the invention. Any dependent claim must include all the features of the claim to which they relate. They must contain a reference to this other claim, which may also be dependent, and then state the additional features for which protection is sought.

The patent (or patent application) may also contain drawings. These form a useful addition to the description as they illustrate the features of the invention. Any flow sheets and diagrams are considered to be drawings.

There is also an abstract, which is purely for technical information for the public.

Legal references:

Art. 57, 83, 84, 85 EPC

Rule 42(1)(a)-(f), 43, 47, 49 EPC

GL F-II, 4; F-III; F-IV

5. The three patentability criteria

According to the majority of existing patent laws, the patentability requirements for an invention are novelty, inventive step and industrial applicability.

Any technical invention that is not already available to the public and that is not obvious to a person skilled in the art (an average expert in the technical field of the invention, but with no inventive ability) can be patented.

Legal references:

Art. 52(2), 57 EPC

6. The geographical scope of a patent

A patent is an IP right with a validity limited to the territory covered by the granting authority and can be valid for one country (national patent system) or for a region (regional patent system).

An applicant may file a patent application with a national or regional granting authority. The granting authority will process the application based on the applicable national or regional patent law and a patent may be granted on this legal basis. Applicants may also use the international patent system (PCT) to file an application.

Patents confer the right to prevent third parties from making, using or selling the invention without their owners' consent in the countries where the patent has been granted. There are different routes to patent protection and the best route for an application will depend on the invention and the markets the company operates in.

When filing a European patent application, all the contracting states for which the EPC has already entered into force on the date of filing are deemed to be designated. The EPC contracting states are:

- 39 EPC 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, Montenegro, North Macedonia, Malta, Netherlands, Norway, Poland, Portugal, Romania, Serbia, Sweden, Slovenia, Slovakia, San Marino, Turkey.

At a later stage of the procedure (for European patent applications, within six months of the date on which the European Patent Bulletin mentions the publication of the European search report), a specific extension or validation fee must be paid by the applicant to keep the possibility to validate a potentially granted patent in the extension or validation states (GL A-III.12.2):

- One extension state: Bosnia-Herzegovina
- Four validation states: Morocco, Republic of Moldova, Tunisia and Cambodia.

Examples

As an example, the European Patent Office accepts applications under the European Patent Convention (EPC) and the Patent Cooperation Treaty (PCT). If an inventor/applicant is seeking protection in a plurality of European countries, it may be best to apply at the EPO. If an inventor/applicant is seeking protection for only one country, it may be best to apply for a national patent in that particular country.

Legal references:

Art. 59, 64, 65, 79 EPC

Rule 39, 159(1) EPC

GL A-III.12.2

7. National, regional (EP) and international routes

The national route is when the applicant files an application at the relevant national office. If a patent is granted, it is valid only in the state where the application was filed.

The regional or European route is when the applicant files an application in German, English or French at the EPO (as a second application after the national route has concluded). If a patent is granted, it can be valid for up to 44 states (39 EPC member states, 1 extension state and 4 validation states).

The international route is when the applicant files an application under the PCT procedure at the International Bureau (WIPO), the EPO or any allowable national office. For a grant, applicants can choose to enter the national/regional phase in various states (regional or European route) at the end of the international route. If a patent is granted, it can be valid for up to 155 states.

Examples

Filing an application with a national patent office has the advantages that entry into the procedure is usually less expensive and applicants can deal with the office in a language they are more likely to be familiar with. Should they decide that they also need protection in other countries at a later stage, the first national application can serve as the basis for the priority right under which applicants can file an application for the same invention in another country within 12 months from this first filing, while keeping the original filing date.

Legal references:

Art. 75, 76 EPC

Rule 35 EPC

Art. 2-4, 11(3), 64(4) PCT

Rule 4.9 PCT

8. Priority concept and Paris Convention

A priority right is triggered by the first filing of an application for the protection of an invention and allows the filing of a subsequent application for the same invention during 12 months from the date of filing of the first application. This date will be known as the priority date.

The effect of the priority right is that the priority date is considered as the "effective date of filing" of a subsequent application when assessing novelty and right for a subsequent application.

Examples

If an applicant files a patent application, utility model or utility certificate in a state party to the Paris Convention or in any member of the World Trade Organisation (WTO), the applicant may then claim priority when filing a patent application in respect of the same invention.

Legal references:

Art. 54(2), (3), 60, 87, 88(1), (2), 89 EPC

Rule 52, 53 EPC

GL A-III, 6; GL F-VI

9. Ownership and inventorship

The applicant of a patent application is any natural or legal person, or anybody equivalent to a legal person, irrespective of nationality and place of residence and/or business. For the purposes of proceedings before the patenting authority, the applicant will be deemed to be entitled to exercise the right to the patent.

An application may be filed in the name of one or several persons named as joint applicants. The application may also be filed by two or more applicants, which can designate different contracting states of a regional office.

Each application must have designated inventor(s). If the applicant is not the sole inventor, a designation of inventor has to be filed. This designation of inventor must state both the family and given names, the country and place of residence of the inventor and bear the signature of the applicant or their representative.

Examples

For a given application, a first applicant designates a first group of contracting states and a second applicant designates a different group of contracting states while both applicants jointly designate a third group of contracting states. In such a case the applicants will be regarded as joint applicants for the purposes of the proceedings.

Legal references:

[Art. 58, 59, 60\(3\), 118, 133, 134 EPC](#)

[Rule 151\(1\) EPC](#)

[GL A-II, 2](#)

10. Transfer of rights and assignments

A patent application or a patent may be transferred in whole or in part, by the proprietor for one or more of the countries where the patent application/patent is valid.

Legal references:

[Art. 71, 72 EPC](#)

[Rule 14, 22, 85, 142 EPC](#)

[Guidelines E-XIV, 3](#)

11. Duties and responsibilities of a representative/applicant and of a patent paralegal

The three main processes for filings are submission, intake and formal checks. We talk about submission when the applicant or their representative prepares the application and sends it to the chosen filing authority. The intake would be when the filing authority receives and registers the application and the data is converted and uploaded into the appropriate system(s). By formal checks we are referring to any formal compliance with the established legal requirements by the applicant or their representative.

Submitting the mandatory information is the first step in the filing process and it is when the applicant or their representative compiles the necessary information for the request to grant a patent. All requests for grant of a patent need to be signed by the applicant or their representative. As a final step, the signed request and all attached documents are sent.

Legal references:

Art. 90(1) EPC

Rule 10(1) EPC

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