

Grant Proceedings before the European Patent Office



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Grant proceedings before the European Patent Office

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IP Brochure

The European Patent Convention (EPC) is a regional patent treaty. It enables the applicant to obtain a patent for a plurality of countries on the basis of a single application in a single procedure before the European Patent Office (EPO).

Table of contents

Title	Page
1. The European Patent Convention	4
2. Patentable subject-matter	4
3. Filing a European Patent Application	6
4. Formal Requirements of the -Application	7
5. Representation	9
6. Examination of the application	9
7. Fees	13
8. Post grant proceedings	13

1. The European Patent Convention

At present, the European Patent Convention (EPC) comprises 38 contracting states. With the request for grant of a European patent the applicant designates all contracting states. In each contracting state, the European patent gives its proprietor the same rights and is subject to the same conditions as a national patent. Since the EPC is not a treaty of the European Union (EU), the contracting states of the EPC also include countries such as Switzerland or Turkey, that are no members of the European Union, in addition to all EU member states. In addition, European patents may also be effective in some countries which have not acceded to the EPC (extension states). The legal basis for such extension is given by bilateral extension agreements between the European Patent Organisation and the extension states (at present 2). Furthermore, there are agreements on the validation of European patents with four states that are no contracting states of the EPC. The European Patent Convention comprises the European Patent Convention itself, its provisions are called Articles and its Implementing Regulations, their provisions are called Rules. A European patent may be applied for on the basis of a direct European application or on the basis of an international patent application (Euro-PCT route, see BARDEHLE PAGENBERG IP Brochure "International Patent Applications under the PCT"). The European patent system has not superseded the national patent systems. However, a number of contracting states have stipulated that a patent on the basis of a PCT-application can only be obtained by a European patent application (closing of the national route). The European patent application can be a first application or claim the right of priority of an earlier application. National applications in parties of the Paris Convention for the Protection of Industrial Property or in a member state of the World Trade Organization as well as earlier international (PCT) or European applications can be considered as earlier applications.

2. Patentable subject-matter

The requirements for patentability of the EPC are in conformity with international standards as laid down in the Patent Cooperation Treaty (PCT) and the Agreement on Trade-Related Aspects of Industrial Property Rights (TRIPS). **2.1 Inventions** European patents are granted for any inventions, in all fields of technology, provided they

- are new,
- involve an inventive step and

- are susceptible of industrial application.

An invention is considered to be new if it does not form part of the state of the art. For the assessment of novelty, older European applications that are not previously published, but have a filing or priority date that is before the filing or priority date of the application to be examined, are also relevant. Inventive step is examined on the basis of the problem-solution approach (see BARDEHLE PAGENBERG IP Brochure “The Assessment of Inventive Step under the EPC”). Older European applications that are not previously published, are not taken into consideration as prior art during the assessment of an inventive step. The following items are not regarded as inventions if claimed as such:

- discoveries, scientific theories and mathematical methods;
- aesthetic creations;
- schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers (see BARDEHLE PAGENBERG IP Brochure “The Patentability of Software under the EPC”);

- presentations of information.

2.2 Exclusions from patentability European patents are not granted in respect of

- inventions the commercial exploitation of which is contrary to “ordre public” or morality;
- plant or animal varieties or essentially biological processes for the production of plants or animals; this exclusion does not apply to microbiological processes or the products thereof;
- methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision does not apply to products, in particular substances or compositions, for use in any of these methods.

3. Filing a European Patent Application

3.1. Who can file? An application may be filed by the inventor or his successor in title, e.g. an assignee. The inventor is to be designated and if the application is filed by a successor in title, such as the employer of the inventor, he has to indicate how he has obtained the right to the patent. The correctness of these indications is not examined by the EPO. The applicant may be a natural or a legal person or any body equivalent to a legal person under its national law, irrespective of its nationality or residence. This means in practice that any body which is entitled to file an application in its country of residence can also file a European patent application. An application may be filed by a plurality of applicants. There may be different applicants for different contracting states. For example, it may be requested that the patent is granted to applicant A for state X, to applicant B for state Y and to applicants A and B in common for the other designated states.

3.2 Where to file? An application may be filed at the EPO in Munich, The Hague or Berlin. The application may also be filed at the patent office of a contracting state, if the law of that state so permits or prescribes. For reasons of national security, many contracting states prescribe that European patent applications from their territory have to be filed at the national office or make direct filing with the EPO subject to prior national authorisation. However, divisional applications have to be directly filed with the EPO.

3.3 Languages The application shall be filed in one of the official languages of the EPO, i.e. English, French or German. The application may also be filed in any other language. In that case a translation in English, French or German has to be filed within two months. At any time during the proceedings before the EPO, the translation may be brought into conformity with the text of the application as filed. The language in which the application is filed or translated is the language of the proceedings before the EPO.

3.4 How to file The application has to be in written and machine-readable form. It may be filed by post, by fax, online using prescribed software, or in person. Using other forms of telecommunication is not allowed; in particular e-mail cannot be used. Currently, more than 75 % of the applications are filed online. The EPO also provides a reduced filing fee for this. Paper documents have to be filed in one copy which is scanned by the EPO. When the application is filed online or by fax, the filing of a confirmation copy is not necessary unless required by the EPO. As a rule, such an invitation is only issued if the original copy is of inferior quality. Instead of filing application documents, the applicant can file a reference to a previously filed application. In that case, for obtaining a date of filing, the applicant must indicate the following details on the

filing date:

- the filing date of the previous application,
- its file number,
- the office where it was filed,

• an indication that this reference replaces the description and any drawings. The applicant can also refer to the claims of the previous application and it is strongly advised to make use of this possibility. In case of the reference to a previously filed application, the applicant must supply a certified copy of the previously filed application as well as a translation into one of the official languages of the EPO within two months of the filing date.

3.5 Divisional applications A divisional application may be filed relating to any pending application (“parent application”), including a divisional application itself. Previous time limits for filing a divisional application do not apply anymore. According to the EPC, a parent application is considered as pending until:

- the day before the mention of grant of a European patent in the European Patent Gazette, or
- in case of a rejection:
- until the expiry of the time limit for filing an appeal, if no appeal is filed, and
- until the final termination of the appeal proceedings, if an appeal is filed.

The divisional application „inherits“ the priority and application date of the parent application. Thus, publications or acts of use which have taken place since this date do not constitute prior art. However, consequently, the renewal fees are also to be paid with a retroactive effect from the application date of the parent application.

4. Formal Requirements of the -Application

4.1 The request for grant The request has to be filed on the prescribed form. The form covers in particular the following items:

- the required information on the applicant(s) and his/their representative(s),
- the signature of the applicant or his representative,

- the request for substantive examination and grant of the patent,
- the designation of the inventor(s),
- the title of the inventions,
- where appropriate, the declaration that the application is a divisional application and the number of the earlier application,
- any priority declaration,
- the designation of all contracting states,
- the indication of all extension states,
- any reference to deposited biological material and to an annexed sequence listing,
- the receipt for documents form as prepared by the applicant containing a checklist of enclosed documents.

4.2 The specification The documents making up the application are

- description, where appropriate with an added sequence listing,
- claims,
- any drawings, and
- abstract.

In accordance with the provisions of the Patent Law Treaty, among these documents only the description is necessary for obtaining a filing date. However, considering the EPO's strict approach in applying the prohibition of adding new subject-matter (see 6.3), it is strongly advised to file also the claims, and any sequence listing and drawings which might be relevant for the disclosure of the invention with the original documents. The formal requirements for drafting the application documents are in line with the provisions of the PCT. Paper documents must be on strong, pliable, white A4 paper (portrait format).

5. Representation

Applicants having their residence or principal place of business in a contracting state may act on their own behalf in proceedings before the EPO. Applicants from other states have to appoint a representative having his place of business or employment within the contracting states and act through him in such proceedings. The representative has to be a European patent attorney who is on a list maintained by the EPO, or a legal practitioner entitled to act before the EPO. If a representative is appointed all notifications sent by the EPO are sent to him.

6. Examination of the application

Procedures before the EPO are conducted in the language of the proceedings (see 3.3). However, in written proceedings parties may use any official language of the EPO. In addition, parties from a contracting state having a language other than English, French or German as an official language may file documents in such other language, provided a translation is filed within one month. In oral proceedings, any party may use an official language of the EPO different from the language of proceedings, provided it gives notice to the EPO one month before. In that case, the EPO provides at its own expense interpretation into the language of the proceedings, if necessary.

6.1 Procedure up to publicationThe first stage of the procedure

comprises:
6.1.1 Examination on filingHere it is examined whether the requirements for according a filing date are met. In accordance with the Patent Law Treaty, a filing date requires:

- an indication that a European patent is sought,
- information identifying the applicant,

• a description or a reference to a previously filed application (see 3.4).

6.1.2 Formalities examinationThis includes an examination whether the request form comprises the prescribed indications

- the requirements with regard to representation are met,
- the documents making up the application meet the formal requirements to the extent necessary for the purpose of a proper publication,

- a translation of the application, fulfilling the formal requirements has been filed, if the original application was not filed in an official language of the EPO,
- the designation of the inventor meets the requirements,
- any declaration of priority meets the formal requirements.

6.1.3 The extended European search report (EESR) The EESR comprises the European search report and a preliminary opinion on patentability (search opinion). The search report is drawn up on the basis of the claims, with due regard to the description and any drawings. It mentions the documents retrieved by the search examiner which may be taken into consideration in assessing the requirements of novelty and inventive step. The documents are usually older patents or publications (often referred to as “patent literature”), or scientific articles, excerpts from specialist books or the like (“non patent literature”). In fields of technology where the products have short life cycles, as for example video games, internet disclosures also play an important role. As a rule, the search opinion should cover all objections to the application, thereby indicating the deficient part of the application, the requirement which is not met and the reason for the objection where this is not immediately apparent. No search is conducted for a claim which is deemed to be abandoned for non-payment of any claims fees which had become due. If the search division considers that the application does not meet the requirements of unity of invention, it draws up a partial search report for the unitary invention first mentioned in the claims. With the transmittal of the partial search report, it informs the applicant accordingly and invites him to pay further search fees for each invention other than the one first mentioned in the claims, if the search is to cover these inventions as well. If the application contains more than one independent claim in the same category, the applicant is invited to indicate an independent claim per category on the basis of which he wishes the search to be carried out. If the applicant fails to provide such an indication, the search is carried out on the first claim in each category, unless the applicant can convince the examiner, that a plurality of independent claims is appropriate under the circumstances. If the search division considers that the application does not comply with the requirements to such an extent that it is impossible to carry out a meaningful search, it issues a reasoned declaration to this effect which replaces the search report (declaration of no search). If it considers that it is impossible to carry out a meaningful search for some of the claims, a partial search report is established.

A limitation of the search has the serious consequence for the later substantive examination that the non-searched matter has to be deleted from the specification and can no longer be claimed. Thus, in particular in case of divisional applications it has to be ensured –and proven to the Search Division, if applicable – that the subject matter of the claims to be examined is supported by the originally filed version of the parent application.The search report is an important indication for the applicant as to the chances for obtaining eventually a patent and for his decision whether or not to request substantive examination. The EPO currently has the aim of completing the EESR for all applications, including divisional applications, within six months after they were filed (referred to as “Early Certainty from Search” program).

6.2 Publication of the applicationThe European patent application is published in electronic form in the language of the proceedings 18 months after the date of filing or priority. From that day on the public has access to the electronic file and the applicant enjoys provisional protection.The publication contains the description, the claims and any drawings, all as filed, plus the abstract. If the European search report is available in time, it is annexed; if not, it is published separately (A3 publication). The European patent application is not published if it has been finally refused or withdrawn or deemed withdrawn up to the end of 5 weeks before the end of 18 months after the date of filing or priority.

6.3 Substantive examinationThe EPO informs the applicant of the day of publication of the search report. Within 6 months from that date the request for examination has to be filed, otherwise the application is deemed to be withdrawn. Within the same time limit, the applicant is required to respond to the search opinion unless the opinion does not raise any objections. This is the only possibility of the applicant to make amendments of his own volition without restriction. In the course of substantive examination, the admission of amendments is subject to the discretion of the examining division.With the valid request for examination, responsibility passes from the receiving section to the examining division. The examining division consists of three examiners. However, the first examiner is entrusted to act on behalf of the division up to the point of a final decision. Oral proceedings have to take place before the full examining division.The examining division examines in the light of the EESR and the applicant’s reply to the search opinion whether the claims meet the requirement of clarity and the application meets the formal and substantive requirements of the EPC, in particular whether the claimed subject-matter is new and involves an inventive step.If the examiner responsible has objections, he sends a first examination report inviting the applicant

to file his observations and, if appropriate, to submit amendments to the specification. The applicant is obliged to reply within a period of at least four months. If he fails to do so in due time, the application is deemed to be withdrawn. After this reply, if there are still objections, the examiner may issue a further communication, contact the applicant by telephone, invite the applicant to an interview or summon to oral proceedings. Examiners are instructed that a final position (grant or refusal) should be reached in as few actions as possible. Refusal after the reply to the first examination report is not excluded, provided the applicant's right to be heard is not violated. The applicant is not allowed to improve his position by adding subject-matter to the original application. An amendment to the specification is regarded as introducing new subject-matter if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from the application as originally filed. This requirement is very strictly applied. For this reason, it is of particular importance for the European grant procedure that all necessary information with regard to the function of the invention is already incorporated into the application in the original version. If the examining division comes to the conclusion that a European patent cannot be granted, it will refuse the application. The decision is issued by the examining division as a whole, and the grounds of refusal must be stated. Refusals may be based only on grounds on which the applicant has had an opportunity to comment. The decision is always given on the application as a whole and not in respect of individual claims. Thus, deficiencies in respect of a single claim or in respect of the description may result in the refusal of the application. Refusal of the application is subject to appeal to the boards of appeal of the EPO. Decisions of the boards of appeal are final and not subject to any further review by national or international instances.

6.4 The grant stage If any deficiencies have been remedied and the examining division is of the opinion that the application is ready for grant, it informs the applicant of the text in which it intends to grant the European patent and invites him to pay the fee for grant and publishing and any claims fees for claims in excess of 15 which have not yet been paid, as well as to file a translation of the claims into the two official languages of the EPO other than the language of the proceedings. Minor amendments, in particular the correction of obvious mistakes like typing errors, are still possible. If the above fees are paid and the translations of the claims are filed in due time, the decision to grant is issued and some weeks later the mention of the grant is published. From the latter date, the

European patent takes effect in the designated contracting states. The EPO has the aim of issuing the mention of the grant of the patent within twelve months of the date of filing of the request for examination (referred to as “Early Certainty from Examination” program).

7. Fees

Fees have to be paid at different stages of the proceedings. At the beginning of the proceedings, i.e. when filing the application or when entering the European phase of a Euro-PCT application: Filing fee and search fee. Claims fees for each claim in excess of 15 claims. Increased claims fees for each claim in excess of 50 claims. Within 6 months from the publication of the search report: Examination fee and designation fee for all contracting states. Before grant: Fee for grant including the fee for printing the European patent specification. Starting from the beginning of the third year from the filing date until publication of the mention of the grant: Annual fees. **To give a rough idea, at present this sums up to EPO fees of somewhat more than EUR 5.000 for a patent granted in the 3rd year of the application without any additional fees.**

8. Post grant proceedings

In the designated contracting states, the European patent has the effect of and is subject to the same conditions as a national patent. This means for example that renewal fees have to be paid as for a national patent. **8.1 Validation** However, in many contracting states, for the patent to retain its protective effect and be enforceable against infringers, it must be validated. That means that the proprietor has to file a translation either of the full specification or of the claims into an official language of that state with the national patent office under the respective national law. **8.2 Opposition Proceedings** After the European patent has been granted, it may be opposed by third parties, if they believe that it should not have been granted. This could be on the grounds, for example, that the invention lacks novelty or does not involve an inventive step. No special need for legal protection is necessary to file an opposition. The opposition by a “straw man”, meaning of a person acting on behalf of

a third party, is also admissible. Notice of opposition can only be filed within nine months of the grant being mentioned in the European Patent Bulletin. Oppositions are dealt with by opposition divisions, which are normally made up of three examiners (for details in this regard see BARDEHLE PAGENBERG brochure "The European Opposition Proceedings").

8.3 Nullity proceedings The European patent is also subject to national revocation proceedings. However, the grounds for revocation to be applied in these proceedings are only those of the EPC (for Germany. See BARDEHLE PAGENBERG IP Brochure "Patent Invalidation").

8.4 Limitation Proceedings At any time after the grant of the patent, the patent proprietor may request at the EPO the limitation of his patent. The decision to limit the European patent takes effect on the date on which it is published in the European Patent Bulletin and applies ab initio to all contracting states in respect of which the patent was granted. Limitation may be useful if the proprietor becomes aware of further state of the art and expects that the patent may be more easily defended in a limited version. Opposition proceedings take precedence over limitation proceedings. The proprietor may also request revocation of his patent if he is not willing to defend it any longer.

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