

EPO: Main Features and News of the European Patent System

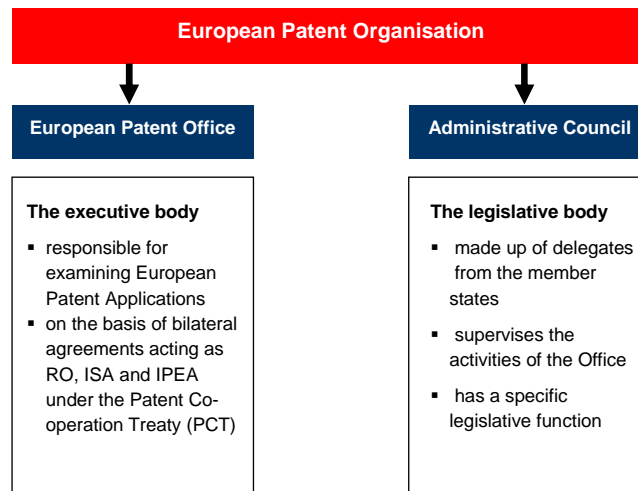
Your idea
our experience

27.04.2010

Overview:

- The European Patent Organization
 - The European Patent Office
 - The Administrative Council
- The European Patent System
 - Patentability
 - Filing/grant procedure
 - Euro-PCT
- Special issues concerning filing of European Applications by non-member states
- Important amendments of Implementing Regulations in EPC

Structure of the European Patent Organisation

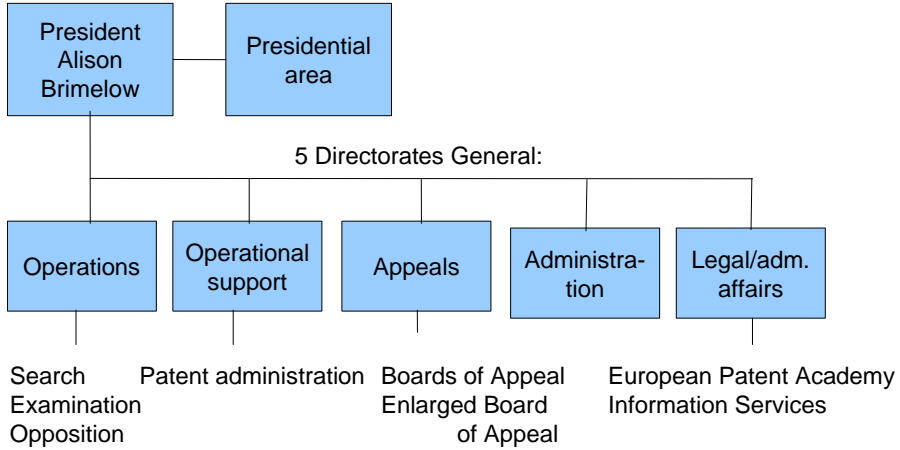


European Patent Office

- Filing Offices:
 - Munich
 - The Hague
 - Berlin
- Branch Office:
 - Vienna
- www.epo.org



EPO Organization



30.04.2010

36 Contracting States

- AT Austria
- BE Belgium
- BU Bulgaria
- CH Switzerland
- CY Cyprus
- CZ Czech Republic
- DE Germany
- DK Denmark
- EE Estonia
- ES Spain
- FI Finland
- FR France
- GB United Kingdom
- GR Greece
- HR Croatia
- HU Hungary
- IE Ireland
- IS Iceland
- IT Italy
- LI Liechtenstein
- LT Lithuania
- LU Luxembourg
- LV Latvia
- MC Monaco
- MK FYR Macedonia
- MT Malta
- NL Netherlands
- NO Norway
- PL Poland
- PT Portugal
- RO Romania
- SE Sweden
- SI Slovenia
- SK Slovakia
- SM San Marino
- TR Turkey



30.04.2010

Extension States

- AL Albania
(will become Contracting State 1 May 2010)
- RS Serbia
- BA Bosnia Herzegovina
- ME Montenegro (from 1 March 2010)

States having special agreements with the EPO.
European Patents may be extended to these states.

Routes to a European Patent

- European route (via EPO):
 - centralised application procedure
 - legal basis: European Patent Convention (EPC2000)
 - protection obtained in up to 38 countries with one single filing
 - at grant: bundle of national patents
- International route (PCT).
 - protection in 142 Contracting States (updated: 28 September 2009)
 - no grant or refusal
 - max 30 or 31 months after date of filing / priority: entry into national or regional phase

Advantages of the European Patent:

- Unitary protection standards in the contracting states
 - Only application, one language
 - Free selection of countries among the member states
 - Only one foreign agent needed
- Cost effective
 - Costs less than approx. three separate national patents
- Strong
 - Thorough search -> 60 million documents / ~3500 Examiners
 - Substantive examination = “safe” legal protection

Patentability

Art. 52(1) EPC2000:

- European patents shall be granted for any inventions, in all fields of technology, provided that they
 - are new
 - involve an inventive step
 - are susceptible of industrial application

What is *not* considered an invention?

Art. 52(2),(3) EPC2000

- 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
- Presentations of information

Lack technical character

and are excluded from patentability "as such"

Patenting of Computer Programs

- Since approximately 2000, claims directed to computer programs have been allowed by the EPO, if the invention has had technical character
- Pending questions before the Enlarged Board of Appeal G3/08 may change



Pending Questions G3/08

- Can a computer program only be excluded if it is claimed as a computer program?
- Does the use of a computer add technical character, or is a further technical effect necessary?
- Must a claimed feature cause a technical effect on a physical entity in the real world? What type of entity?
- Is the activity of programming a technical activity?
- Do all features resulting from programming contribute to technical character?
- Or is a further technical effect of the feature needed?

30.04.2010

Current Practice

Claim may be drafted as:

- A computer program product comprising computer-readable code which, when run in a computer will cause the computer to perform the following steps:
 - receive measurement parameters related to (...)
 - control the opening of a valve in dependence of the measurement parameters

30.04.2010

Technical Effect/Technical Character

- No clear definition of "technical"
- Must go beyond the normal interaction between human and computer
- Claim must have at least one technical feature (may have mixture of technical and non-technical features)
- Only technical features can contribute to inventive step

30.04.2010

Technical Character of Claim

- Example of technical features:

- Controlling an X-ray apparatus
- Controlling a car engine
- Enhancing internal operation



- Example of non-technical features

- Creating an abstract of a text
- Displaying text in a particular style
- Rules for playing a game



30.04.2010

What is not patentable?

- Art. 53 EPC2000
 - Inventions against morality
 - Plant or animal varieties;
 - Essentially biological processes for the production of plants or animals
 - "Medical methods"
 - Methods performed on the human or animal body by way of surgery or therapy, and diagnostic methods practised on the human or animal body

Plant and Animal Varieties

- Varieties within a species are not patentable
 - Plant grouping within a single botanical taxon
 - Animal race
- Plant cells as such are patentable
- Animals having a special property are patentable if the property is not linked to a particular race



Medical Methods



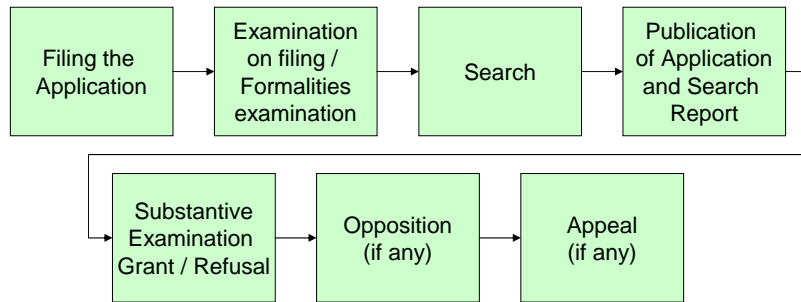
Art. 53 (c)

- Patents not granted for medical methods on humans or animals
 - Methods for treatment by surgery or therapy
 - Diagnostic methods
- Products and apparatuses for medical purposes are not excluded!

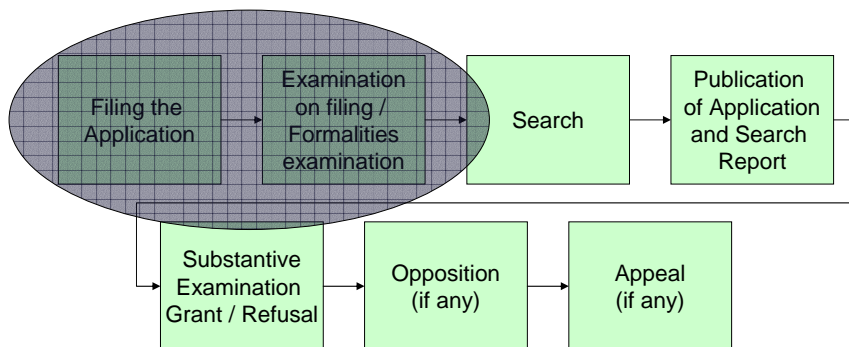
Scope of exclusion

- Methods for treatment by surgery or therapy:
All methods involving at least one step of surgery or therapy are excluded
Confirmed by G1/07
- Diagnostic methods (G/04) :
Only methods involving all necessary steps are excluded:
 - Making the diagnosis
 - Preceding steps (gathering of data)
 - Specific interactions with the body in the preceding steps

The European Patent Grant System



The European Patent Grant System

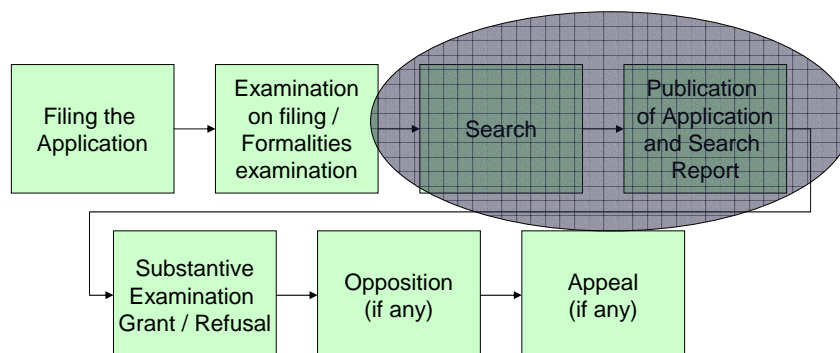


Formalities Examination:

Formal requirements on application

- Request for grant
- Information identifying the applicant
- Description of invention or a valid reference
- One or more claims
- Drawings
- Abstract
- Filing Fee
- Search Fee

The European Patent Grant System



Extended European Search Report

Sent to applicant and published with the application

- European Search Report
 - List of documents with classification
- European Search Opinion
 - Reasoned statement

- Applicant may
 - File observations
 - Correct deficiencies
 - Submit amendments

Publication of the Application

- 18 months after the priority or filing date (Art. 93(1)(a))
 - A1: publication including Search Report
 - A2: publication not including Search Report
 - A3: publication of Search Report following A2 publication
- Publication of an application informs the public and
 - Provides provisional protection (Art. 67 EPC)
 - Enables third parties to submit observations (Art. 115 EPC)

Published European Application



Europäisches Patentamt
European Patent Office
Office européen des brevets



(11) EP 0 797 950 A1

(12) EUROPEAN PATENT APPLICATION

(43) Date of publication: 01.10.1997 Bulletin 1997/40 (51) Int Cl.⁶: A61B 5/042

(21) Application number: 97400666.0

(22) Date of filing: 25.03.1997

(84) Designated Contracting States:
BE DE FR GB IT NL SE

(72) Inventor: Ouchi, Teruhiko
Tokyo (JP)

(30) Priority: 25.03.1996 JP 67653/96

(74) Representative: Joly, Jean-Jacques et al
Cabinet Beau de Loménie
158, rue de l'Université
75340 Paris Cédex 07 (FR)

(71) Applicant: TERUMO KABUSHIKI KAISHA
Tokyo (JP)

Published European Application

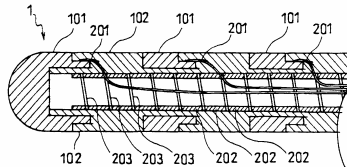
(54) Electrode catheter

(57) The electrode catheter comprises a metal inner tube (102) with distal and proximal ends and an outer tube (101) formed of a synthetic resin so as to cover the outside surface of said inner tube (102). The inner tube (102) has a helical slit (203) formed from the distal end to a predetermined position. One or more insulated wires (201) are laid inside the inner tube (102) from the proximal end to the distal end portion, and one or more electrodes (101) are disposed on the outer tube. The

wires (201) are brought out of the inner tube (102) through the slit (203) and are connected to the electrodes (101).

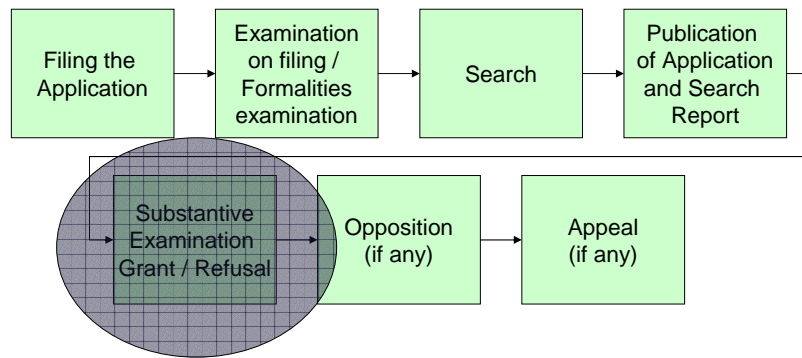
The electrode catheter has a high pushability and torque-transmission capability along with a high flexibility and kink resistance. It can be easily inserted into a desired position of complexly branched thin blood vessels without kink or breakage of the wires caused by collapse of the lumen.

FIG.2



EP 0 797 950 A1

The European Patent Grant System



Substantive Examination

Art. 94 EPC

Purpose of substantive examination:

To ensure that the application and the invention meet the requirements of the EPC

Starts with a request for examination including examination fee

Time limit: 6 months from publication of Search Report

Substantive Examination

- Written communications
 - Reply with deadline for applicant
 - If EPO does not receive a reply within the specified time limit the application is deemed to be withdrawn
- Telephone consultation
- Interviews
- Oral proceedings
- Right to be heard (Art. 113)– **important**



Substantive Examination

Further requirements to patentability:

- Clarity of claims (Art. 84 EPC)
- Unity (Art. 82 EPC)
- Sufficiency of disclosure (Art. 83 EPC)
- Amendments (Art. 123(2) EPC)

Unity

- The European patent application shall relate to one invention only *or* to a group of inventions so linked as to form a *single general inventive concept* (Art. 82 EPC2000)
- Independent claims must relate to the same invention
 - Solve the same technical problem
 - Using the same or corresponding technical features

30.04.2010

Single general inventive concept

Corresponding technical features:

- Product and method of manufacturing product
- Lock and key that work together



Same technical features:

- Spring coils for wheel suspension
 - In cars
 - In bicycles

30.04.2010

Sufficiency of disclosure

Art. 83

- The invention must be disclosed in a manner sufficiently clear and complete to be carried out by a person skilled in the art

Art. 84

- The claims shall be clear and concise and supported by the description

Grant

Rule 71(3) EPC

When the application is in order for grant

- EPO notifies intention to grant
- Applicant responds with
 - Approval of text
 - Translation of claims to the two other EPO-languages
 - Payment of grant and publishing fees
- EPO sends decision to grant
 - Date of publication of the mention of the grant
 - Grant is mentioned in European Patent Bulletin



Validation

- To take effect in a member state, the EP patent must be validated in that state.
- Contracting state may require translation of the granted European patent for valid patent in that state (Art. 65 EPC)
- Fee for publication (validation)
- London Agreement reduces need for translation

London Agreement

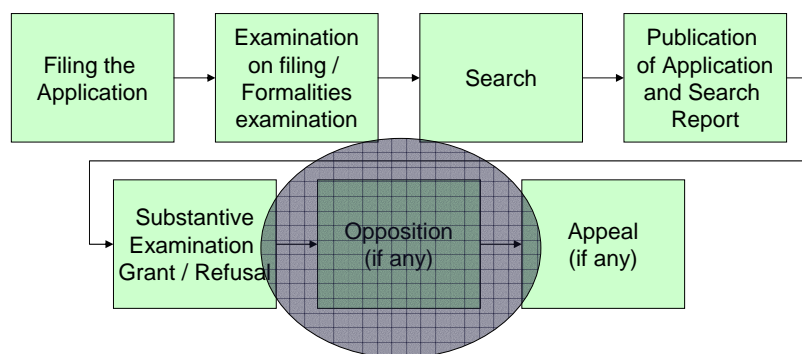
- State having official EP language as official language: no translation of EP patent
- State not having official EP language as official language:
 - may require translation of claims
 - may require description in one particular EP language
- State may require translation in case of dispute (paid by patentee)
- www.epo.org -> law -> legal texts -> London Agreement

London Agreement Member States

Croatia	Luxembourg
Denmark	Monaco
France	Netherlands
Germany	Slovenia
Iceland	Sweden
Latvia	Switzerland
Liechtenstein	United Kingdom
Lithuania	

30.04.2010

The European Patent Grant System



Post-Grant Proceedings

- Opposition
 - By third party
 - Patent may be revoked or maintained as granted or amended
- Limitation
 - Requested by applicant
 - Limit scope of claims
for example because of new prior art
- Revocation
 - Requested by applicant
 - Patent is revoked ab initio

30.04.2010

Opposition

- May be filed by any person
Not by patentee!
- Time limit: 9 months after grant

- Possible outcome of opposition procedures
 - Patent is revoked
 - Patent is maintained in amended form
 - Patent is maintained as granted

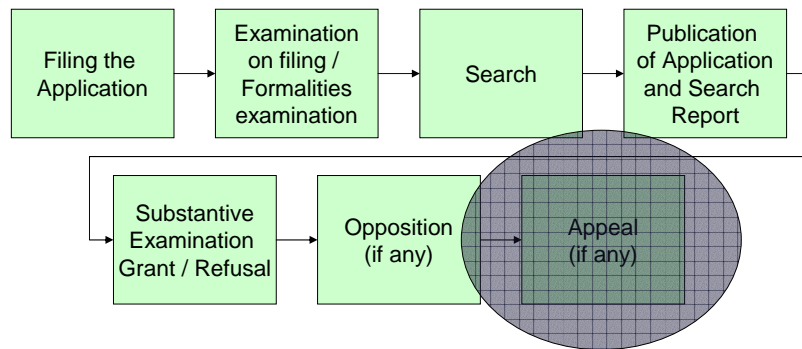
Grounds for Opposition

- Lack of novelty
- Lack of inventive step
- Invention is not patentable
 - Non-technical
 - Medical methods
 - Animal or plant variety
- Invention is not sufficiently disclosed
- Subject-matter added after filing

Opposition Procedure

- Patentee and opponent(s) are parties to proceedings
- Include all grounds, facts, evidence when filing
- Patentee responds to opposition
- Written procedure
- Oral proceedings if requested by party
- Decision at the end of oral proceedings

The European Patent Grant System



Appeal

- Against a decision of the first instance
 - Possible after refusal or opposition
- “adversely affected” party
- Time limits
 - Notice of Appeal: 2 months after decision
 - Grounds for appeal: 4 months after decision
- Appeal fees

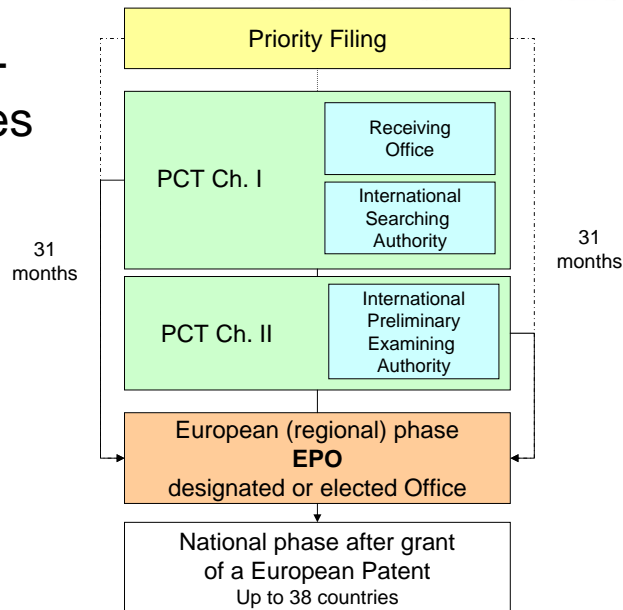
Appeal

- Technical Board of Appeal
 - Legal Board of Appeal
- ⇒ Give independent final rulings (Art. 106-111 EPC)
- Enlarged Board of Appeal
- ⇒ Gives decisions and opinions in order to ensure uniform application of the law, or if an important point of law arises (Art. 112 EPC)
-

Euro-PCT

- Euro-PCT application entering the regional phase before the EPO

The Euro-PCT phases



Source: How to get a European patent – Euro-PCT

Entry into Regional Phase

- 31 months from (earliest) priority date
- Requirements:
 - Translation into EPO language
 - Filing fee
 - Search fee
 - Designation fee (if period expired)
 - Request for examination (if period expired)
 - Renewal fee (if period expired)

Time Limits for Fees

Examination and Designation:

- Time limit 6 months from publication of PCT search report
- Usually expired when entering the regional phase

Renewal fee

- At start of 3rd year from filing (not priority)

Amendments to Claims

- EPO invites applicant to amend claims within 1 month of communication
- Multiple dependent claims allowed
- Claims fees
 - Claims 16 – 50: 210 Euro per claim
 - Claims exceeding 50: 525 Euro per claim!
- Claims sets having more than 15 claims should be rewritten

Multiple Dependent Claims

In Europe:

- Multiple dependencies are advisable because they
 - Make it easier to show basis for claim amendments when features of different claims are combined.
 - Reduce the number of claims and thus save money.
- Claims fees are based on the amended claims set
- Refund is possible if claims are amended

30.04.2010

Amendments to Application

New Rule 161 as of 1 April 2010:

- Applicant may comment on WO-ISA or IPRP
 - EPO invites applicant to correct deficiencies noted in the WO-ISA or IPRP within one month
 - If no response: application is deemed to be withdrawn
- ⇒ For Euro-PCT where EPO *acted as ISA*
- For Euro-PCT where EPO *did not act as ISA*, the applicants may amend the application once within a period of one month from an issued communication.

30.04.2010

Euro-PCT Procedure

- EPO issues supplementary search report with a search opinion
- If claims are amended, search report is based on amended claims
- Search fee is reduced if ISA was
 - USA
 - China
 - Japan
 - Australia
 - Russia
 - Korea

Examination phase

- EPO invites applicant to indicate whether he wants to proceed with the application
- Time limit: 6 months from publication of supplementary search report
- Procedure continues as for regular EPC application
- If no response to invitation: application deemed withdrawn
- Examination fee may be refunded if examination does not start

Important amendments of the Implementing Regulations in EPC

New time limits for filing divisional applications:

- 24 months from first communication from examining division in earliest application
- 24 months from communication objecting to unity in earlier application

- Earliest application: first application in chain of divisionals
- Earlier application: application that is to be divided

Divisional Applications

Transitional provisions:

- If 24 month time limit has expired:
Divisional applications may be filed until 1
October 2010

If 24 month time limit still running:

- Divisional applications may be filed at least until 1
October 2010
- Earlier application must be pending
 - Not granted
 - Not refused or withdrawn

New Rules for Search

From 1 April 2010

- If claims non-unitary
 - Applicant is invited to indicate claims
 - If no indication: first claim in each category searched
- If claims so unclear that no meaningful search can be carried out
 - Applicant is invited to clarify claims
 - No search report or partial search report

Partial Search

- If only some claims searched
 - Because of lack of unity
 - Because of lack of clarity
- In examination: applicant invited to restrict claims set to claims that have been searched

Response to Search Report

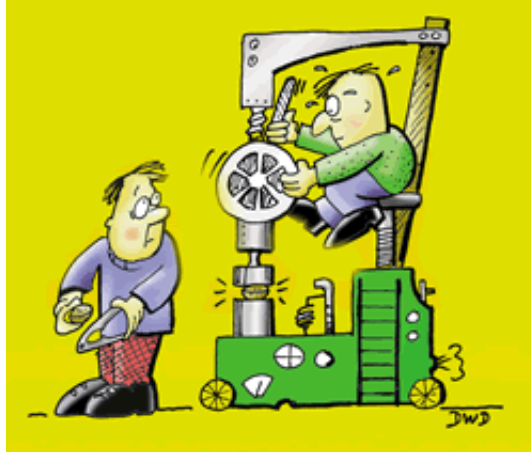
As of 1 April 2010

- Applicant is invited to correct deficiencies stated in
 - Extended European Search Report
 - Supplementary Search Report (for Euro-PCT)
- Time limit: same as for request for examination
- If applicant does not respond, the application is deemed to be withdrawn

Sources of Information

- www.epo.org
 - Law
 - Forms
 - News and changes
 - Links to other Patent Offices
- www.epoline.org
 - Procedural information
 - Status information
 - Link to espacenet
- www.espacenet.com
 - Application and patent documents
 - Family and status information

Seven deadly sins of the inventor



1. The invention is more complex than the problem
merits.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>

Seven deadly sins of the inventor



2. The invention is not kept secret until the date of
filing.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>

Seven deadly sins of the inventor



3. The invention isn't new.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>

Seven deadly sins of the inventor



4. The inventor hasn't fully considered the problem.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>

Seven deadly sins of the inventor



5. No-one wants it.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>

Seven deadly sins of the inventor



6. An invention is safer if it's kept secret.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>

Seven deadly sins of the inventor



7. The inventor has an unrealistic idea of the value of his invention.

Source: <http://www.epo.org/topics/patent-system/seven-sins.html>