I. INTRODUCTION

The purpose of this presentation is to introduce some practical aspects of the European grant and Opposition procedure.

Legal or procedural aspects are considered in view of:

- efficiency and costs savings for the Applicant,

- but also in view of strategical industrial aspects since filing of a patent application in the name of an Applicant is essentially on the consideration of the Applicant’s competitors.

Comparisons with the US patent system will appear throughout this presentation.

We will also show the role of the European Patent Attorney and will give some practical indications on what should be done or what should be avoided in the course of the procedure or upon preparing an Application for filing at the EPO.

As you may know, a patent application comprises:

- a description of an invention, including its structural features, method steps, technical functions and advantages, how the invention works, its applications, examples...

- one or more definitions (claims) of what the applicant wants to protect, or of what he “claims” as being his invention.
During both the grant and opposition procedures the Applicant or his Attorney tries to render the application (description and claims) compatible with the formal and substantive prescriptions of the European Patent Convention.

II. OVERVIEW OF THE EPO GRANT PROCEDURE

The Examination by the EPO essentially comprises two stages.

In a first stage, a prior art search is conducted and a Search Report is drafted by the EPO, sent to the Applicant and published.

In a second stage, an Examining Division conducts a Substantive Examination, usually on the basis of the documents cited in the Search Report, and finally issues a Decision to grant a Patent or reject the Application.

II.1. The Search Report

In the course of the European Examination, there is no Information Disclosure Statement (“IDS”) like in the US Patent system.

In other words, the Applicant is not obliged to cite any pertinent prior art document which he knows.

The procedure is based on prior art found by the EPO, normally during the Search, and sometimes on additional prior art cited by third parties.

Although the Search stage normally should not raise any difficulty, some problems may occur.

II.1.a. For example the presence of:

- many claims of the same category,
- very broad claims, or claims which were intentionally drafted very broadly,

will usually result in a Search Report which is very wide and not very well focussed on the invention.

In addition fees have to be paid, depending on the number of claims in excess of ten. This, and the possible use of multiple dependant claims, are significant differences over the US patent system.

For these reasons we recommend not to include too many independent claims upon filing, but rather to keep fall back positions or other aspects in the description.

II.1.b. Another difficulty arises when the EPO decides that claims are too vague or too numerous or cover subject-matter which cannot be covered by a “normal” search or
subject matter excluded from patentability.

In such cases the EPO will invoke specific procedural rules allowing the Examiner not to carry out any search.

This last situation is quite of a problem since, as already explained above, the rest of the procedure is based on this initial stage and that a patent cannot be granted if no Search Report is drafted. It leads to a loss of time in the overall grant procedure.

It occurred for example quite often recently, in the case of applications in the fields of “business methods”.

To the difference of the US patent office which was quite generous in the recent years with such applications, the EPO decided not to carry out any search on claims defining methods for doing business without any technical effect, and on commonplace implementations of such methods.

But the same problem may arise in other fields, for example when the Application intends to cover therapeutical or surgical methods which are not patentable in Europe.

II.1.c. In order to avoid the above problems, it is advisable to reconsider the Application and to amend the claims before filing in order to cover subject-matter not excluded from the Search.

This is usually the task of the European Patent Attorney, of course upon Applicant’s request.

One possible strategy, for example, is to file a set of claims in which at least some of the claims (cl. 1 – 10) involve a technical character or a technical effect, whereas the others (cl. 11 – 30) define a method excluded from patentability.

In such a situation the EPO will probably issue a Search Report only for these claims 1 - 10, which will then be subject to a “normal” procedure, based on the Search report.

It is then possible to maintain the other claims 11 – 30 within the frame of a divisional application which will be separately examined.

Amending the claims before filing is highly advisable or necessary:

- when the Applicant is interested in having a patent granted rapidly for strategical reasons (agreement with a third party, possible litigation,...).

- in fields where competition is fast and where having at least one patent granted can be of a strategic concern.
II.2. Substantive Examination

Like at the other Patent Offices (Japan, US), it essentially consists in one or more communications issued by the EPO on both formal and substantive criterions of the European Patent Convention which are not satisfied by the Application.

How to respond to such communications?

II.2. a. Amendments: how far may the Applicant amend the claims?

Amendments to both description and claims are of course always possible. But this is a very delicate matter where the EP Attorney has to be deeply involved.

One difficulty arises when the Applicant merely instructs the Attorney to file a set of claims identical to those granted in the US as a response to an EPO Communication.

One can understand, of course, that the Applicant wishes to obtain a protection in Europe, which is close to that already granted in the United States.

But this usually raises further problems since:

- such a set of claims is usually not adapted to EPO practice,
- and the EPO is usually very strict with the question of added subject-matter, and more severe and less flexible in this respect than the US Patent Office,
- a Patent granted with added subject- matter may, in some cases, be revoked in Opposition without any possibility for the Patentee to overcome the objection at this later stage.

Such a set of claims should thus be considered more as an indication to the EP Attorney of the protection the Applicant wants to obtain.

But the EP Attorney will have some additional work in order to justify the amendments. Or he might also suggest some amendments to the US type set of claims in order to have a better chance to have these claims granted in Europe.

In other words the mere filing of a set of claims already filed at another Patent Office or granted by another Patent Office elsewhere in the world usually does not mean a cost savings.

II.2.b. Typical example of objections: lack of clarity and lack of novelty or inventive step

The EP Attorney is of course used to dealing with such objections in Europe.
i - Applicant’s instructions and comments are usually very helpful regarding the cited prior art on which lack of novelty or lack of inventive step objections are raised.

ii - lack of clarity objections should rather be addressed by the EP Attorney.

Such a lack of clarity objection is raised when the set of claims is not adapted to European Standards.

One problem arises when the first communication usually raises only lack of clarity objection: it results in a loss of time for the Applicant, because substantive matters will be dealt with only at a later stage,

Example: set of claims containing several independant claims for a same product or method.

Is is however allowed to file a reasonable number of independent claims. Attorney should argue on the basis of inter-related products, or alternative solutions to a same problem.

This may help the Applicant in obtaining an adequate protection for the invention (very helpful in case of litigation).

Actually, the EPC now explicitly allows the application to contain more than one independant claims in certain specific cases, but the EPO is not so generous in this respect in comparison to the US Patent Office.

II.2. c. Clients instructions to Attorney

The Attorney might have some questions in return to instructions or already when transmitting any objection raised. When the EP Attorney sends questions, the Applicant should send him complete instructions and answer to all of his questions.

If the Attorney makes a suggestion and the Applicant disagrees with it, it can be also very helpful for the Attorney’s work to know why (agreement, other prior art...), in particular in view of the further steps of the proceedings.

II.2.d. The priority right

It is current practice for the Applicant, before filing abroad, at the end of the priority year, to amend the application with respect to the priority application.

The substantive Examination at the EPO usually does not concern the validity of a priority right.

However, the recent case law from the Enlarged board of Appeal is very severe
regarding the determination of priority rights (G2/98)Å@*(1).

The Examination procedure now gives the Applicant the possibility to file a priority document or its translation at a very late stage of the procedure. By doing so, the EP Attorney no longer has the possibility of checking whether a certain claim has the right to a certain priority date.

Should the Applicant know that the question of priority might be an important matter at any latter stage, for example because:

- the European Application contains matter not initially contained in the initial priority application
- and because of prior art published during the priority year,

then the Applicant should indicate this to the Attorney upon filing.

II. 2. e. Time schedule

The whole procedure at the EPO may be quite long. Patents may be granted several (4 to 5) years after filing, regardless of a possible subsequent opposition procedure by third parties.

The applicant who has an interest in obtaining a patent rapidly may file at any stage a request for accelerated examination, which is actually very efficient and without additionnal costs. In such a case the Applicant has to react very rapidly to any Official Communication. Such a request may now be excluded from file inspection, so that it is not accessible to the applicant’s competitors.

III. OPPOSITION PROCEDURE

III.1. General principles

The EPO offers the possibility of an Opposition Procedure after Grant.

Through this procedure an Opponent, usually a competitor, tries to attack the Patent in all contracting states it covers.

The Opponent has a limited delay, nine months after grant of the patent, for filing an opposition.

The Opponent usually tries to bring some new evidence for challenging the patentability of the protected invention.

III.2. Relation with infringement action

It is advisable for the Applicant or the Patentee to wait for expiration of the nine months
period after grant before commencing any court action against a competitor or even merely invoking a possible infringement of its European patent.

Otherwise the competitor files an Opposition.

It is also one reason why an Applicant who wants to enforce his rights as soon as possible has an interest in requesting an accelerated Examination.

In addition, in most of the European countries, a judge will stay any infringement action based on a European Patent when an opposition is filed against said Patent.

III.3. Difficulties for the Patentee

The defence of a Patentee is a very delicate matter, for at least two reasons.

a. One general principle which applies to opposition procedures is that the possibility for the Patentee to amend the claims is much more limited than during the course of the Examination procedure.

b. In addition, because of the length of both grant and opposition (+ possible Appeal) procedures, a final decision at the end of an Opposition Procedure is usually issued several years after the filing of the Application.

This means that:

- a product covered by the Patent is usually already on the market at that time,

- or the Patentee has possibly already contracted a licence Agreement with a third party,

and in both cases the position of the Patentee is difficult.

It is thus advisable, when drafting a licence agreement on an Application for which a patent is not yet granted to include some clause in view of a possible opposition.

c. Other problems have been mentionned above in relation with Infringement Action.

d. In view of these difficulties, it is in some cases advisable to prefer national routes to have protection in Europe, in particular in countries where there is no Opposition Procedure (France).

III.4. Time schedule

There is a possibility to request an accelerated processing of an opposition when an infringement action is pending before a National Court of a Contracting State.

This applies as well to a possible subsequent Appeal filed against the Decision of the Opposition Division.
III.5. Costs

Just like for a Court Action, they cannot be foreseen, because they are not based on official fees (except the Opposition fee paid by the Opponent).

Costs largely depend on the evidences brought by the Opponent.

The hearing of witnesses may for example involve significant amounts, as well as Oral Proceedings which are usually of a decisive nature.

IV. THE APPLICATION

In view of the above and based on our experience, we would give the following advices for the drafting of a European patent application.

IV.1. Disclosing the Prior Art

Disclosures of the invention in the problem-solution form, with extensive discussion of the prior art, are often necessary and helpful.

IV.1.a. EPO Examiners usually must decide whether a combination of elements would have been obvious to “one of ordinary skill in the art”, and whether the prior art references teach or suggest the claimed combination.

A problem-solution analysis with regards to the cited prior art is often necessary or helpful in convincing an Examiner that the claims are allowable.

IV.1.b. Frequently, the EPO Examiner will consider another technical problem than the one cited in the application.

The problem-solution approach cited by the Applicant will however form a good basis for a discussion with the Examiner.

IV.1. c. Usually there is no risk that an Examiner considers a broad and incomplete description of a prior art, without reference to a published document, as a prior art definitely admitted by the Applicant. In other words, the Examiner usually raises objections based on the documents themselves.

However, at a latter stage, and in particular in opposition proceedings, or even in the course of a litigation, an opponent or an alleged infringer can always argue on the basis of broad and incomplete citations and the Patentee will have to respond to such argumentation.

This will result in complications and loss of time for the Patentee at this latter stage.
IV.1. d. To summarize, we recommend to cite prior art based on published documents and to discuss the technical problems, which are posed by these documents.

IV.2. Objects or summary of the Invention

Many patent applications include numerous “Objects of the invention”. In some cases, the objects are usually simply a repetition of the patent claims.

We would rather advise the applicant to use that part for explaining some technical effect or advantages in relation with the invention.

This part could also helpfully be used by giving different definitions of the invention, for example:

- broad, intermediate and narrow in scope;
- or: structural and functional definitions,

even if the claims initially only concern one of these definitions.

This part of the specification can then be used for finding a good and clear basis for fallback positions.

IV.3. Claims

Special attention should of course be given to the claims.

Sometimes, patent applications are filed with claims which might be appropriate for prosecution and optimum patent protection in the United States but which are not adapted to European practice.

IV.3. a. Claims in multiple dependent forms are allowed in Europe and Examiners are used to them. There is no fee for using claims in multiple dependent forms (difference with US).

Multiple dependent claims of multiple dependant claims are also permitted (difference with US system).

The use of multiple dependent claims is also recommended for the case a fall-back-position should be necessary at a later stage.

It is sometimes difficult to clearly identify a basis in the description and to find a justification for a combination of features, whereas multiple dependencies would overcome the difficulty very easily.

IV.3.b. Do not submit too many claims. The fees for claims are relatively high in Europe (€ 40 for the 11th and each subsequent claim).
Many claims will also result in a Search which is very wide and which is not very well focussed on the invention (see § II above).

It is thus advisable to reconsider the set of claims before filing in Europe in order to save the payment of such fees.

As already noted above, we recommend the inclusion in the “Summary of the invention” of several definitions which can later be used as fall-back-positions, which saves fees upon filing.

V. CONCLUSION

The European Grant and Opposition procedures offer significant advantages to an Applicant.

However, they have their own specificities, in particular with regards to other Patent systems.

For this reason, the representation work made by a European Patent Attorney is decisive at all stages of the procedure.

In some cases, and in particular when protection is sought in less than 4 or 5 countries, it might however be advisable to still file applications through national routes, in particular in countries where no opposition procedure is available to competitors.

However, in the future, this strategic concern will probably be largely compensated by the advantages of the European Patent System, when the London Protocol*(2) enters into force, and probably also the Community Patent.

References available on www.cabinetbeaudelomenie.fr

*(1) Current Case Law of the Enlarged Board of Appeal : G2/98
*(2) France has signed the “London Protocol”

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