Cabinet Beau de Loménie

PATENTS

The European patent

INTRDODUCTION

The Convention on the grant of European patents, hereinafter named the European Patent Convention or EPC, was signed in Munich on October 5, 1973.

This Convention entered into force on October 7, 1977 for 7 States and is now effective in 28 States.

The main purpose of the Convention is to give applicants the opportunity to obtain protection in several European countries by filing a single application covering the Contracting States designated in the application and by taking advantage of only one examination procedure.

The European countries which may be designated as Contracting States in a European patent application are now as follows:

Austria, Belgium, Bulgaria, Switzerland/Liechtenstein, Cyprus, Czech Republic, Germany, Denmark, Estonia, Spain, Finland, France, United Kingdom, Greece, Hungary, Ireland, Italy, Luxembourg, Monaco, The Netherlands, Poland, Portugal, Romania, Sweden, Slovenia, Slovakia and Turkey

Furthermore, the extension of the European patent to ALBANIA, CROATIA, LITHUANIA, LATVIA and MACEDONIA may also be requested upon payment of an appropriate extension fee for each of these five countries.

The term of a European patent is twenty years as from the filing date. Renewal fees should be paid to the European Patent Office in respect of European patent applications. The first renewal fee is due in respect of the third year, calculated from the filing date, and renewal fees should be paid for each subsequent year up to the year in which mention of the grant of the European patent is published.

Thereafter, renewal fees must be paid for each designated Contracting State and Extension State, in which the European patent has effect.

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I – PATENTABILITY REQUIREMENTS

Inventions which are not excluded as such from patentability, which are susceptible of industrial application, which are new and which involve an inventive step are patentable according to the European Patent Convention.

a) Non-Patentable Inventions
Article 52(2) of the EPC lists various types of non-patentable subject matters, including methods of doing business models and computer programs. Non-patentability of business models has been confirmed by various Appeal Boards Decisions if they are claimed as such. Regarding computer programs, patentability is currently admitted if they have a technical effect beyond the mere interaction between software and computer hardware. However, scope of protection of computer programs may be altered in the future since a draft European Directive on the patentability of computer-implemented inventions is being discussed.

Also, pursuant to Article 53 b), granting of European Patents is refused for “plant varieties or animal breeds as well as for essentially biological processes for obtaining plants or animals, this provision not being applicable to microbiological processes or to the products obtained with these processes”.

b) Industrial application

An invention which can be made or used in any kind of industry, including agriculture, is considered as susceptible of industrial application.

It should be noted that, according to Article 52(4) of the EPC, methods for treating humans or animals through surgery or therapy and diagnostic methods are not considered as inventions susceptible of industrial application. However, products for use in any of these methods are not excluded from patentability by this provision.

Nevertheless, it is important to mention that, following the well-known decision of the Enlarged Board of Appeal: EISAI decision [second medical use, EISAI /Dec 5, 1984-Official Journal EPO 3 (1985)], it is possible to obtain European patent protection, not for a therapeutic method of use, but for the use of a known substance for the manufacture of a drug useful for the treatment of a specific disease, provided that this treatment is new and non obvious.

According to established case law, cosmetic treatments are not included under Article 52(4) and would therefore normally be deemed patentable. However, it is sometimes difficult to distinguish between therapeutical treatment and cosmetic treatment.

c) Novelty

According to Article 54 of the EPC, an invention is considered to be novel if it does not form part of the stat of the art.

The state of the art comprises everything made available to the public anywhere in the world by means of a written or oral description, by use or by any other means, prior to the filing of the European patent application or the priority date, if a priority date is claimed.

Furthermore, the contents of prior European patent applications as filed, having a filing date prior to the filing date of the European patent application in question (or its priority date, if any) and which were published on or after the filing date (or priority date) of said application, are also deemed to be part of the state of the art.

However, this is true only insofar as the Contracting States designated in the European patent application are the same as those designated in the prior European patent application.

It may be pointed out that novelty is interpreted restrictively by European Examiners and generally, in the field of chemistry, a specific compound is not considered as anticipated by a compound family.

d) Inventive step

According to Article 56 of the EPC, an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

The state of the art with respect to the inventive step does not include the contents of prior European patent applications filed before but published on or after the filing date (or priority date) of the application considered.

Following some decisions of the Boards of Appeal, evaluation of the inventive step is

generally made according to the "problem-solution" approach as follows:

- What is the closest prior art?
- What is the problem to be solved?
- Has the problem actually been solved?
- Is the solution obvious or not with respect to the prior art?

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II – FILING OF THE EUROPEAN PATENT APPLICATION

a) Where to file?

The filing of the European application may be made either at the European Patent Office in Munich, at its branch at The Hague, or at the national patent offices of the Contracting States, if the laws thereof allow for such filing, for example, in France, United-Kingdom, Italy…

It should be noted that European patent applications filed at a national patent office, in any one of the official languages of the EPO, will have the same effect as if they were filed in the EPO on the same date.

b) The language

European patent applications must be filed in one of the official languages of the EPO, which are English, French or German.

However, applicants having their residence or principal place of business in a Contracting State having as official language a language other than one of the three official languages of the EPO, or nationals of that State residing abroad, may file a European patent application in the official language of their State. In such case, a translation into an official language of the EPO should be filed within a prescribed time limit.

c) The application documents

The European patent application should contain the following:

- a request for the grant of a European patent;
- a disclosure of the invention and, optionally, drawings;
- one or more claims;
- an abstract;
- payment of the appropriate fees.

d) The priority
The priority of a previous application may be claimed. For this purpose, a declaration of priority, a copy of the priority document and a translation thereof into one of the official languages of the EPO should be filed.

Upon filing a European patent application under priority, the date and State of the previous

application should be indicated.

The reference number of this previous application and an official copy thereof must be submitted within sixteen months from the priority date.

However, following the decision of the President of the European Patent Office of December 22, 1998, which entered into force on January 1, 1999, submission of an official copy of the previous application is no longer necessary if the previous application is:

- a European patent application;
- a Japanese patent or utility model application,
- a PCT application filed at the EPO or at the Japanese Patent Office as Receiving Offices.

As from July 1, 2002, the time limit for providing a translation of the priority document is set individually for each application by a communication in this respect from the EPO, **but at the latest within the term under Rule 51(4) EPC**. In Practice, the EPO Examiner will request the translation(s) of the priority document(s) if this is necessary for assessing patentability of the EP application on the account of interfering applications.

The filing of such a translation is **not necessary** when the **European patent application is a literal translation of one single previous priority application**, but in that case a declaration stating that the European patent application is a complete translation of the previous application, **should be submitted**.

e) Designation of the Contracting States

The Contracting States in which the applicant wishes to obtain protection should be designated in the request for the grant of a European patent. A designation fee should be paid for each Contracting State within six months from publication of the European search report.

As from July 1, 1999, designation fees have been deemed paid for all Contracting States upon payment of **seven times the amount of the designation fee**.

The designation of a Contracting State may be withdrawn at any time up until the grant of a European patent, but it is not possible to designate further Contracting States after the deadline for payment of the designation fees.

Designation of Extension States is also possible. Although not being EPC Contracting States, Extension States allow granted European Patents to take effect in their territory, subject to translation requirements. An extension fee is to be paid for each desired Extension State. A list of the current Contracting States and Extension States is given in annex 1.

f) The disclosure of the invention and the claims

According to Article 83 of the EPC, the European patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

On the other hand, Article 84 of the EPC states that “the claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description”.

In this respect it should be noted that the European Patent Convention provides particular rules relating to biological material in order to satisfy the sufficiency requirements (Rule 28 EPC).

When an invention relates to a process or to the product thereof and involves a biological material which is not available to the public or which cannot be described in the application in such a way that anyone skilled in the art can reproduce the invention, the sufficiency requirements are satisfied only if a culture of the biological material has been deposited with a recognized depositary institution.

It is important to note that the deposit should be carried out before filing of the application and that the biological material should be made available as from publication of the European patent application.

However, the applicant has the opportunity to inform the European Patent Office that, up to the date of publication of the mention of grant of the European patent or until such time as the patent application is rejected, withdrawn or deemed to be withdrawn, the biological material can only be made available through the issue of a sample to an Expert nominated by the person making the request.

The option involving the Expert undeniably limits abuses, yet it is often challenged on the grounds that the Expert does not represent the public.

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III – FORMAL EXAMINATION

When the European patent application does not satisfy the requirements of Article 80 of the EPC in which is listed the information needed to assign a date of filing, the Receiving Section indicates to the applicant the deficiencies and informs him that the applicant will not be dealt with as a European patent application unless the deficiencies are remedied within one month.

Also, the Receiving Section invites the applicant to carry out rectification of deficiencies contained in the application documents and to identify the inventors if the designation of inventors has not been filed.

If the applicant does not remedy the deficiencies, the application is deemed to be withdrawn, or is refused or certain features are deemed to be withdrawn, depending on the nature of the deficiency.

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IV – DRAWING UP OF THE SEARCH REPORT

After formal examination, the Search Division of the EPO draws up the European search report, in which are cited those prior art references which are likely to affect the patentability of the claimed invention.

If the Search Division considers that the application fails to satisfy the unity of invention requirements, it draws up a partial search report relating to the invention or the group of inventions linked so as to form a single general inventive concept, which is mentioned first in the claims. Simultaneously it invites the applicant to pay, within a prescribed time limit, a further search fee for each other invention contained in the application, if the search report is to cover these other inventions.

The further search fees may be refunded during the examination procedure upon request by the applicant and if the position of the Search Division is found to be unjustified by the Examining Division.

If the further search fees are not paid, the claims covering the further inventions are deemed to be abandoned. However, filing of divisional applications covering the latter will be possible until payment of the grant and printing fees for the patent application.

After receipt of the European search report, the applicant has the opportunity to file comments on the references cited therein and/or to amend the claims and the specification.

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V– PUBLICATION OF THE APPLICATION AND OF THE SEARCH REPORT – REQUEST FOR EXAMINATION

European patent applications are automatically published as soon as possible after a term of 18 months as from the filing date or from the priority date, if a priority was claimed.

When the European search report is available before the end of the technical preparations for publication of the application, it is published at the same time as the application. Otherwise it is published later.

The substantive examination must be requested within a time limit of six months following publication of the European search report. If a request for examination has not been filed within the prescribed time limit, it is still possible to do so within a further time limit (one month from receipt of the respective notification), provided that an extra fee is paid within this further time limit.

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VI – SUBSTANTIVE EXAMINATION

a) Substantive Examination

At this stage, the examination is substantive, i.e. the Examiner considers whether or not the

application meets the conditions for patentability as set forth in the EPC (sufficiency of disclosure, novelty, inventive step…) and invites the applicant, as often as necessary, to file his remarks and amend the claims and/or specification. Generally, the applicant receives one or two official actions to which he has to reply within a prescribed time limit. Any amendment effected in the application should be supported by the application as filed. No new matter may be added.

If the applicant fails to reply to an official action within the given time limit, the application is deemed to be withdrawn, unless further proceedings are requested and the corresponding fee paid with a prescribed time limit.

b) Divisional application

If an application fails to satisfy unity of invention requirements (Article 82), the application should be limited to subject-matter relating to one invention or group of inventions satisfying unity requirements, and divisional applications may be filed for other inventions.

In this respect, a group of inventions so linked as to form a single general inventive concept satisfies the unity requirements of the EPC.

Divisional applications are deemed to have been filed on the date of filing of the original application. It is not possible to designate in a divisional application Contracting States which were not designated in the original application.

After filing, divisional applications are treated in the same manner as the other applications.

Divisional applications may also be filed at any time on the applicant's initiative up to the grant of the patent. Divisional applications cannot be filed after grant and therefore not during opposition proceedings.
c) Grant of the European Patent

When the application is considered to be in order, the examiner informs the applicant of the text according to which he intends to grant the patent and requests the applicant's approval, pursuant to Rule 51(4) and invites the applicant to pay the granting and printing fees and to file a translation of the claims into the two other official languages.
Finally, the decision to grant the European Patent is issued.

This decision takes effect only on the date on which the European Patent Bulletin mentions publication of the grant.

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VII – NATIONAL VALIDATIONS

From publication of the grant, the applicant obtains protection in all of the Contracting States designated in the patent, but this protection will be void if a translation of the patent in the national language is not filed within a prescribed term at the national patent offices of the Contracting States. (It may be noted here that Contracting States may not require a translation

into one of their national languages to be filed in order for the patent to be valid, since Article 65 EPC allows them to waive this requirement.)

In all of the Contracting States, the term for filing the translation is **three months** from publication of the mention of the grant, **except in Ireland** where the term is six months from said publication and in **Luxembourg or Monaco** where **no translation** is required.

Recently, several Contracting States have ratified the so-called "London Protocol", by which translations of the patent specification would no longer be required. It is not known yet when this Protocol will come into force, nor in which Contracting States. This would lead to a substantive reduction in translation costs for European Patents.

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VIII – OPPOSITION PROCEDURE

Within **nine months from publication of the mention of the grant**, any third party may give notice to the European Patent Office of opposition to the granted European patent.

The notice of opposition should include a written reasoned statement and an opposition fee is to be paid.

An opposition may only be filed on the grounds that:

- the subject-matter of the patent is not patentable within the terms of Articles 52 to 57 of the EPC;
- the invention is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- the subject-matter of the patent extends beyond the content of the application as filed or beyond the content of the earlier application, if the European patent deriving from a divisional application.

Each opponent is party to the opposition proceedings, as well as the owner of the European patent. It should be noted that any third party, against which an infringement action has been brought, may intervene in the opposition, even after expiration of the opposition period, provided he gives notice on intervention within three months from the date on which the infringement proceedings were initiated.

During the opposition procedure, the Opposition Division invites the parties, as often as necessary, to file comments on the communications from another party or issued by itself.

Three possible outcomes exist in an opposition procedure:

- If the opposition is admissible and the Opposition Division considers the grounds for opposition are well founded, it revokes the European patent.
- On the contrary, if the Opposition Division is of the opinion that the opposition grounds do not prejudice maintenance of the patent as granted, it rejects the opposition.
- The Opposition Division may decide to maintain the European patent as amended by the

owner during the opposition procedure. In this case, a new printing fee is paid and translation of the European patent under amended form should be filed at each of the national patent offices, where required.

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IX – APPEAL PROCEDURE

Decisions of the Receiving Section, Examining Divisions, Opposition Divisions and Legal Division may be challenged through an Appeal procedure before the Boards of Appeal.

Any party adversely affected by a decision may appeal. The appeal should be filed within a prescribed time limit after the decision has been issued.

As in the opposition procedure, the Boards of Appeal invites the parties to file comments on the communications, issued by itself or by other parties.

In the appeal procedure, two possible outcomes exist:

- The appeal is dismissed;
- The decision on appeal is set aside and the patent application or patent is further prosecuted

If an important point of law arises, the Board of Appeal may, either on its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal.

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X – EUROPEAN PHASE OF A PCT APPLICATION

The European route is compulsory for some Contracting States designated in a PCT application: BELGIUM, CYPRUS, FRANCE, GREECE, IRELAND, ITALY, MONACO, and THE NETHERLANDS.

The European phase of a PCT application should be entered up until the end of **thirty-one months** from the priority date, whether or not the International Preliminary Examination was requested within the time limit of 19 months from the priority date.

The documents required for entry into the European phase of a PCT application are:

- the request for a PCT application;
- a translation into an official language of the EPO (if the language of the PCT application is not one of the official EPO languages) of:

*the PCT specification with the claims as filed;
*the claims as possibly amended during the proceedings before the International Bureau and any statement explaining these amendments (Art. 19(1) PCT);
*any text appearing in the drawings;

*the abstract of the disclosure;
*the annexes to the International Preliminary Examination Report (Art. 36(3b) PCT) (comments and claims);
*any indication relating to micro-organisms (Rule 49.3 and 76.5 PCT);
*any request for rectification (Rule 91.1-f PCT)

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CONCLUSION

Applicants have, under the European Patent Convention, the possibility to obtain protection in several Contracting States with only one examination procedure, the filing of the European patent application being carried out directly at the EPO or at national patent offices or resulting from entry into the European phase of a PCT application.

A European patent has the same effect in each designated State for which it is validly maintained and is subject to the same conditions as a national patent granted by that State.

Through the European route, translation costs into the language of each designated State for which protection is requested, are postponed up until the grant of the European patent, whereas through national routes, the translation must be carried out upon filing.

It is furthermore possible that in the near future, translation will not be required at all, at least fore some Contracting States, in order to bring the European patent into effect in those States.

Upon granting, the applicant may withdraw one or some designation(s) of Contracting States for which he is no longer interested in seeking patent protection.

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ANNEX

EPC Contracting States

AT	Austria	HU	Hungary
BE	Belgium	IE	Ireland
BG	Bulgaria	IT	Italy
CH	Switzerland	LI	Liechtenstein
CY	Cyprus	LU	Luxembourg
CZ	Czech Republic	MC	Monaco
DE	Germany	NL	Netherlands
DK	Denmark	PL	Poland
EE	Estonia	PT	Portugal
ES	Spain	RO	Romania
FI	Finland	SE	Sweden
FR	France	SI	Slovenia
GB	United Kingdom	SK	Slovakia
GR	Hellenic Republic (Greece)	TR	Turkey

Extension States

AL Albania
HR Croatia
LT Lithuania
LV Latvia
MK Former Yugoslav Republic of Macedonia