

European Patent Regime

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Convention on the Grant of European Patents (EU Patent Convention), 1973

- Establishing the European Patent Organisation (Art.4) for protection of inventions in EU by a single procedure (Art.1)
- Called European patents (Art. 2) and have the effect of and be subject to same conditions as a national patent
- Can be requested for one or more states (Art. 3)
- European patent office supervised by Admin council to grant EU patents (Art. 4). A conference of ministers shall meet every 5 years to discuss issues in the EU patent system (Art. 4a)
- EP Organisation has legal personality (Art. 5) and enjoys legal capacity



EPO and patentability

- Headquartered in Munich with branch at The Hague (Art.6). Sub offices (Art. 7)
- Liability (Art. 9)

Chapter 1 – Patentability (Art. 52)

All fields of technology, new, involve an inventive step, and are susceptible of industrial application

Not patentable – discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for mental acts, games, presentation of information.

Exceptions to patentability

Art.53

- Commercial exploitation of which would be contrary to ordre public or morality
- Plant or animal varieties, biological processes for production of plants or animals – microbiological process and product are patentable
- Methods of treatment of human or animal body, surgery, therapy or diagnostic methods – products, substances and composition for use in these methods patentable

Novelty Art. 54

- Does not form part of the state of the art
- Comprise everything made available to the public by written, oral description or use or in any other way
- European patent applications filed prior to the filing date, but published later

Non-prejudicial disclosures Art. 55

- No earlier than 6m prior to filing
- Displayed at an official, or officially recognised, international exhibition falling within convention on international exhibitions, 1928

Art. 56 Inventive step

- Having regard to the state of the art, it is not obvious to a PHOSITA.

Art. 57 Industrial Application

Susceptible of industrial application, if it can be made or used in any kind of industry or agriculture.

Article 58 – who can get patent - Natural or legal person

Art. 59 – multiple applicants

Art. 60 – right to EU patent – first to file/employee-employer relationship

Art. 62 – right to inventor to be mentioned as such

Effect of European Patent

- Term of Patent (Art. 63)– 20 years
- Rights conferred by EU Patent (Art. 64) – same rights as national patent. Infringement shall be dealt with under national law; Art. 66 – equivalence with national filing for priority; Art. 67 – provisionally confer rights under national law after publication; Art. 68 – if revoked or limited, the patents shall be deemed not to have had the effect of national patent.
- Requirement for translation (Art. 65) by contracting state
- Extent of protection (Art. 69) shall be determined by claims, the description and drawings shall be used to interpret the claims

Effects of EU patent/ object of property

- Art. 70 – authentic text shall be the one in which proceedings take place – one of the official languages of the convention.
- Art. 71 – EU patent application may be transferred
- Art. 72 – Assignment shall be in writing, and require signature of parties
- Art. 73 – patent application may be licensed in whole or part for the whole or part of the territories of the contracting states designated
- Art. 74 – In each designated state, law applicable to national patent application shall apply to EU patent application

Filing requirements

- Art. 75 – Filed with EPO, with the Central Industrial Property Office of the state; state may decide subject which cannot be communicated abroad without prior authorisation of state
- Art. 76 – divisional may be filed directly with EPO
- Art. 77 – CIPO shall forward to EPO
- Art. 78 – requirements for EU patent application – request, description, one or more claim, drawings, abstract, filing and search fee
- Art. 79 – designation subject to designation fee; designation can be withdrawn.
- Art. 80 – date of filing when requirements are fulfilled

Filing requirements

- Art. 81 – designation of inventor/origin of the right to patent
- Art. 82 – unity of invention
- Art. 83 – disclosure sufficiently clear and complete for it to be carried out by PHOSITA
- Art. 84 – claims shall define the matter for which protection is sought. Shall be clear and concise supported by the description.
- Art. 85 – abstract shall serve the purpose of technical information only – and not for interpreting the scope of protection sought
- Art. 86 – renewal fees – third year and every year thereafter



Priority

- Art. 87 – PCT
- Art. 88 – declaration of priority – multiple priorities
- Art. 89 – date of priority is date of filing of EU patent

Procedure up to grant

Art. 90 – examination on filing and formal requirements

Art. 92 – search report on the basis of claims, with due regard to description and drawings

Art. 93 – publication at 18m, or earlier at request of applicant

Examination

- Art. 94 – request for examination – invitation to file observations and amend application w/i due time
- Art. 97 – grant or refusal –
- Art. 98 – publish spec soon after grant
- Art. 99 – notice of opposition w/i 9m – with fee
- Art. 100 – grounds for opposition – patentable sub-matter, does not disclose the invention in a sufficiently clear and complete manner for PHOSITA, sub-matter of patent extends beyond appln, or divisional beyond content of earlier appln.

Revocation

- Art. 101 – opposition division shall examine – invite parties to file observations
- If one ground is maintainable, it shall revoke
- Amendment during opposition proceedings
- Art. 103 – publication of new spec after opposition decision
- Art. 104 – costs to be borne by each party – equity
- Art. 105 – intervention of assumed infringer in opposition after expiry of opposition period, if proceedings for infringer instituted against him

Limitation or revocation /appeals

- Art. 105a/b – proprietor may request revocation or limitation
- Art. 105c – publication of amended appln.

Appeals

Art. 106 – appeal from receiving, examining, oppn and legal division

Art. 107 – any party adversely affected may appeal

Art. 108 – appeal w/i 2m of decision; grounds to be filed w/i 4m

Art. 109 – interlocutory revision – if appeal is not filed by third party

Art. 110 – board of appeal shall examine; Art. 111 – if board remits case to the dept., they shall be bound by ratio decidendi of board

Enlarged board

- Art. 112 – point of law of fundamental importance – president of EPO may refer to enlarged board where two different decisions
- Party may appeal for review by enlarged board Art.112a

Common provisions

Art. 113 – right to be heard

Art. 114 – examination of its own motion – not restricted to facts, evidence, arguments provided by the parties – may disregard facts not submitted in due time

Art. 115 – observations by third parties concerning patentability

Proceedings

- Art. 116 – oral proceedings if expedient, may reject – not public at receiving section, examination division and legal division – but public in appeal
- Art. 117 – hearing, request for information, production of doc, hearing witnesses, opinions by experts, inspection, affidavits
- Art. 118 – where applicants are not the same in respect of different designated states, they shall be regarded as joint applicants
- Art. 119 – notifications by EPO
- Art. 120 – time limits

Public information

- Art. 127 – EU patent register is open to public inspection
- Art. 128 – inspection of register
- Art. 129 – periodical publications
- Admin and legal cooperation and exchange of info between CIPO, and EPO, exchange of publications – Art. 130-131



PCT

- Art. 150 application of PCT
- Art. 151 EPO as a receiving office
- Art. 152 – ISA or IPEA
- Art. 153 – EPO as a designated office



Thank you

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