

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

- Prior art is any evidence that your invention is already known
- 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 PSITA. The "person skilled in the art" is presumed to be a skilled practitioner in the relevant field of technology who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date
- An invention is held to involve an inventive step if it is not obvious to the skilled person in the light of the state of the art

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

Inventive Step v. non-obviousness

- The Examining Divisions, the Opposition Divisions, and the Boards of Appeal of the EPO almost always apply the "problem-solution approach" in order to assess and decide whether an invention involves an inventive step. The approach consists in:
 - identifying the closest prior art, the most relevant prior art, or at least a realistic starting point;
 - determining the objective technical problem, that is, determining, in the view of the closest prior art, the technical problem which the claimed invention addresses and successfully solves; and
 - examining whether or not the claimed solution to the objective technical problem is obvious for the skilled person in view of the state of the art in general.
- In *Graham v. John Deere Co.* factors
 - the scope and content of the prior art;
 - the level of ordinary skill in the art;
 - the differences between the claimed invention and the prior art.
- "secondary considerations" which could, when appropriate, serve as evidence of non-obviousness.
 - commercial success resulting from the device's inventive aspect;
 - long felt but unsolved needs; and
 - persistent failures of others – demonstrate that the claimed invention solves a specific problem and that previous unsuccessful attempts made to solve the same problem by skilled persons having informed knowledge and with prior art tools necessary to solve it.

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 PSITA
- 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 PSITA, 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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