

The EPC

CIPA Informals Foundation Lecture
Tuesday 7 February 2023

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History and
context

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History and context

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Overview

- Framework and context of the EPC
 - History
 - What is the EPC?
- Content of EPC
 - What does it cover and what does it not cover

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History of the EPC

- EPC drawn up in 1973
- Entered into force in 1978
- Revised in 2000
- EPC 2000 entered into force in December 2007

EPC in context

- Not an EU Treaty
- But all EU states are members
- All EFTA states now members
- New EU entrants required to sign up

EPC in context

- EPC separate from but interacts with:
 - Patent Cooperation Treaty
 - Patent Law Treaty (EPC 2000)
 - Paris Convention (not directly applicable)
 - TRIPS
 - Budapest Treaty (microorganism)
 - Extension agreements
 - Validation agreements
 - National laws of EPC contracting states

What is the EPC?

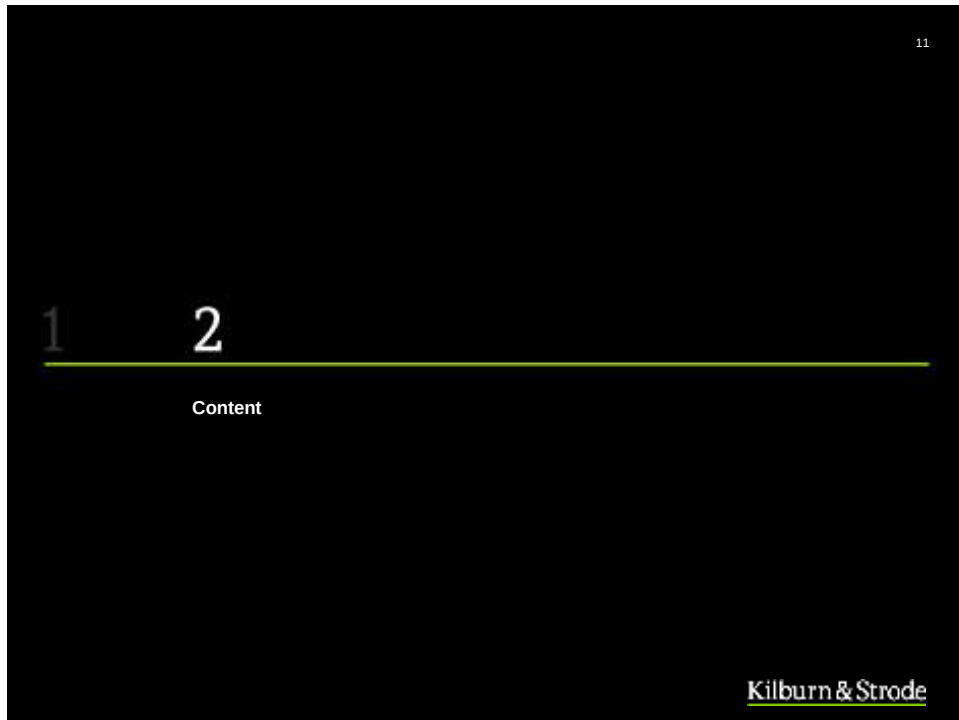
- A system for granting 'European' patents (Article 1 EPC)
 - Filing of patent applications
 - Search/Examination
 - Grant
 - Opposition
 - Appeal

What is the EPC?

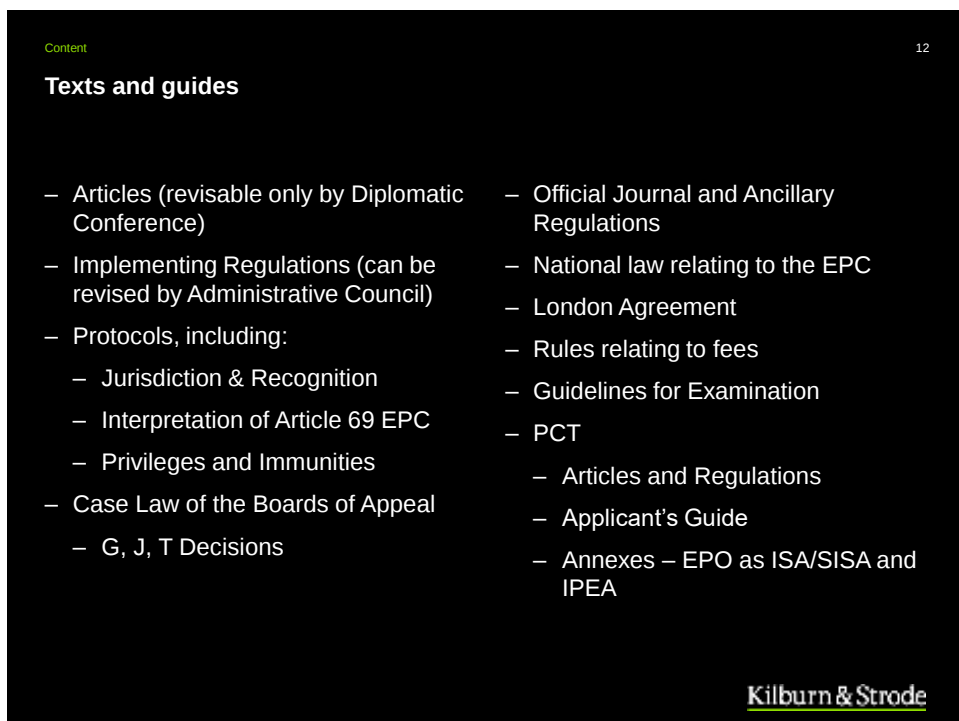
- Does not include:
 - Infringement
 - Ownership of / property in patents (left to national law)
 - But provides for recordal on register of assignments, licences etc. (Articles 71 to 74 EPC)
 - Can now be executed electronically

Pros / Cons of EPC

- | | |
|---|--|
| <ul style="list-style-type: none"> – Pros <ul style="list-style-type: none"> – Single filing for all contracting states – Deferral of translation expenses until grant – Central limitation (post-grant amendment) | <ul style="list-style-type: none"> – Cons <ul style="list-style-type: none"> – Slow to grant (3-4 years from filing to grant is typical) – pre-COVID was improving with EPO's early certainty program, then stalled, now starting to improve – Central opposition – Can be expensive (particularly for small clients) |
|---|--|



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Articles of the EPC

- Art. 1-51: General and institutional provisions (including responsibility of examining division, appeal boards, how they are constituted, financial provisions etc.)
- Art. 52-57: Patentability
- Art. 58-98: Filing, pre-grant, grant procedures
- Art. 99-105: Opposition and Limitation
- Art. 106-112: Appeals
- Art. 113-126: Common procedural provisions (inc. time limits)
- Art. 127-134: Register, representation, file inspection
- Art. 135-141: Impact on national law
- Art. 142-149: Special agreements, including unitary patents
- Art. 150-153: PCT/EPO interface
- Art. 164-178: Final provisions

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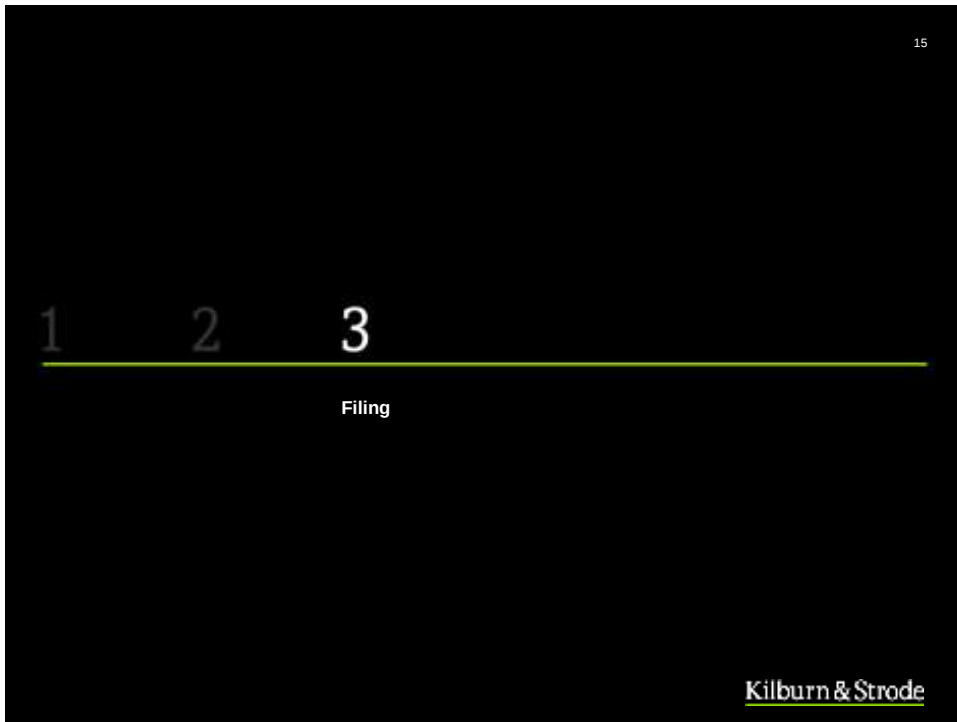
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Patentability

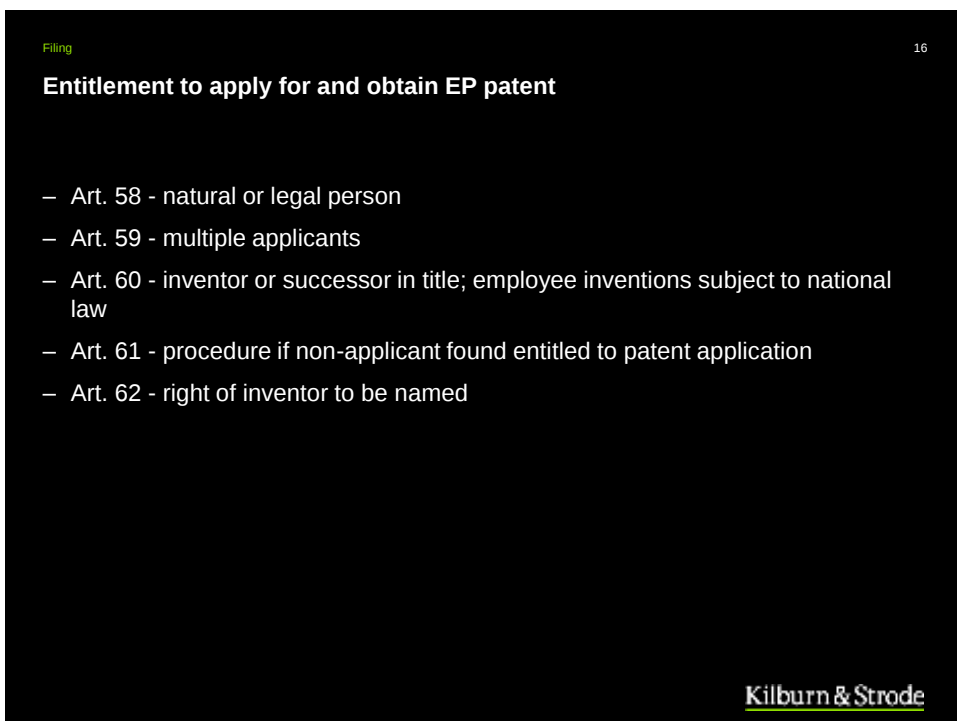
- Art. 52 - patentable inventions, exclusions to patentable inventions
- Art. 53 - exceptions to patentability (ordre public; methods of treatment of human or animal body)
- Art. 54 - novelty
- Art. 55 - non-prejudicial disclosures (evident abuse of confidence, exhibition priority)
- Art. 56 - inventive step
- Art. 57 - industrial application (made or used in any kind of industry)

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Filing - where and how?

Articles 75-81, 90-91

- Where (Art. 75-77):
 - EPO Munich, Hague, Berlin
 - National Patent Office of contracting state
 - Divisional filings only at EPO
- How :
 - E-filing (reduced filing fees) – OLF, OLF 2.0, web-form filing
 - By hand, post/courier, fax (follow with hardcopy)

Filing - requirements

- To obtain a filing date (Art. 80, Rule 40):
 - Indication that EP is sought
 - Identification of applicant
 - Description/reference to previous application. NB no requirement for claims here but can't add matter later
- Other requirements (Art. 78, and 81; Rules 41, 52, and 53)
 - Form 1001, claim(s), abstract, filing and search fees (1 month from filing), designation of inventor (16 months from priority), certified priority document (direct or via DAS code) (16 months from priority)

Filing - languages

- Art. 14
- English, French or German
- Nationals/residents of EPC states having other official language can use language of that state then submit translation into EN, FR or DE
- This is language of proceedings for EPO written communications/amendments to application

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Grant procedure

Pre-grant process

- Formalities exam (Art. 90)
- Priority (Art. 87-89)
- Search/EESR (Art. 92)
- Publication (Art. 93)
- Renewal fees (Art. 86)
- Request exam (Art. 94, Rule 70) and pay designation fees (Art. 79, Rule 36)
- Substantive examination (Art. 94)

Priority

- Articles 87-89
- Claim priority from a first patent/utility model filing that was filed in a Paris Convention or WTO state, with filing date in previous 12 months
 - Make sure applicant is entitled to claim priority
- Declaration on filing of EP application (or within 16 months of priority date claimed)
- Provide certified copy (direct or via DAS) within 16 months of priority date (or when asked, e.g. ex-PCT)

Search - EESR

- Receive search report
- Partial search report:
 - If examiner finds lack of unity in claims
 - If prior art cited that makes claims lack unity
 - Invitation to pay further search fees (can't amend later to unsearched subject matter)
- No search report:
 - If claims considered unclear or un-patentable subject matter
 - Opportunity to address this prior to search (Rule 63)
 - Aux requests, filed claims don't change file copy

Search - EESR

- Search report accompanied by 'non-binding' European search opinion (Rule 62)
- Invitation to address deficiencies within period for requesting exam or confirming exam (Rule 70)
- Response is compulsory under Rule 70a
- Any further amendment at discretion of EPO (Rule 137)

Publication

- 18 months after priority date (Art. 93)
- File history open to public inspection (Art. 128)
- With or without search report:
 - With (A1); without (A2); later S.R. (A3)
- Provisional protection begins now (Art. 67) but only if national law permits and national law requirements have been met (e.g. translation)

Renewal fees

- Article 86
- Payable at EPO in advance in respect of the 3rd year and each subsequent year until year of publication of grant
- Due on last day of month containing the anniversary of filing date
- 3rd year's renewal fee can be paid up to 6 months in advance
- Other can be paid up to 3 months in advance
- Can be paid up to 6 months late with an additional fee
- After grant, renewal fees are no longer payable to the EPO and instead are paid to national patent offices

Examination and Designation fees

- Request examination within 6 months of publication of Search Report (A1 or A3) and pay examination fee (Art. 94, Rule 70)
- Pay a single flat designation fee to designate all states if the EP filing date on or after 1 April 2009 (Art. 79, Rule 36)
- Same deadline for paying fees for extension states
- Communication issued to indicate when examination will start
 - Refund of examination fee available if application withdrawn
 - 100% if before substantive examination starts
 - 50% if before deadline for responding to first 94(3) or date of 71(3)

Examination

- First will address amendments and/or arguments made in EESR response
- 4 months to respond, extendable as of right to 6 months, further extension(s) discretionary (give a very good reason – better use further processing?)
- Amendments not to add matter (Art. 123(2))
- Examining Division consists of 3 members, including 1 primary examiner
- Grant or refusal needs approval of 2 out of 3
- Telephone/Zoom interview, oral proceedings (last opportunity to file written submissions ahead of hearing)

Grant process

- Articles 97-98, Rule 71
- Receive Rule 71(3) communication
 - notice of intention to grant and text for grant (Druckexemplar)
- Within 4 months of notification
 - pay grant and printing fees, file claims translations
 - OR request amendment/correction/keep to latest text
 - Application returns to examination
- Receive decision to grant, publication of granted specification ('B' spec)
- Within 3 months of grant
 - validate patent at national patent offices (National Law relating to EPC, London Agreement)

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Post-grant
procedure

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Opposition

- Within 9 months of date of grant
 - File form 2003, pay fee
 - Written statement of grounds: patentability, added matter, sufficiency
- Patentee responds within 4 months
- Amend and/or argue against opponent
- Oral proceedings before 3 person Opposition Division, decision on day
- Outcomes (Art. 101):
 - maintain patent as granted
 - maintain patent in amended form (file new claims translations, pay new printing fee)
 - revocation of patent (retroactive effect in all states)

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Appeals

- Can appeal from a decision of:
 - Examining division, Opposition division (Technical Board of Appeal)
 - Receiving or Legal section (Legal Board of Appeal)
 - Opportunity to have a bad decision overturned – not for having another go
 - File notice of appeal within 2 months of decision, pay appeal fee. Grounds of appeal within 4 months of decision
- Oral proceedings normal, decision on day
- May refer application back to Examining division, finally refuse application, finally settle opposition
- No further appeal possible unless fundamental procedural defect has taken place - Petition for Review by Enlarged Board (Art. 112a)

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Post-grant amendment

- Art. 105 request for limitation or revocation
 - Central post-grant amendment by proprietor upon payment of fee
 - Must narrow claims (or self-revoke) and not add matter
 - Cannot be used whilst opposition is underway

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Other key
elements

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Time limits

- ‘10 day’ rule (Rule 126)
 - T2056/08 - get it right!
 - Abolished for communications issued from 1 November 2023
- Missed time limit? Further processing (Art. 121)
 - Requested by payment of prescribed fee
 - Complete omitted act
 - A “paid for extension”?
- Re-establishment of rights (Art. 122)
 - Show that time limit was missed despite all due care required by the circumstances having being taken

Divisional applications

- File whilst parent application is pending
- Must not add matter over parent (Art. 76)
- File at EPO in language of proceedings (or language of filing) of parent (Rule 36)
- Pay back renewal fees due on filing (Rule 51(3))
- Pay divisional fee for 2nd and subsequent generation divisionals

Fee Payments

- Rules relating to Fees
 - Amount to be paid for each fee (Rfees.2(1))
 - Particulars required for payment to be valid (Rfees.6(1))
 - When a payment is deemed to be made (Rfees.7)
 - Underpayment (Rfees.8)
 - Fee refunds (Rfees.9 – Rfees.12) and reductions (Rfees.14)
- Annual fee increases in March

PCT and Euro-PCT

- Articles 150-153
- PCT filing that designates or elects EPO is equivalent to EP application (Art. 150(2))
- PCT overrides EPC (Art. 150(2))
- Euro - PCT
 - Enter application at EPO using Form 1200 within 31 months of priority date
 - Pay filing fee and any search fees, plus exam and designation fees, 3rd year renewal fee if already fallen due (Rule 159 EPC) – request early processing?
 - Prosecution continues under EPC
- Rule 161
 - Invitation to file voluntary amendment prior to search/examination
 - Mandatory response to written opinion of EPO as ISA or SISA

Registration & Validation

- Registration in HK
- Validation in states that have a validation agreement with the EPO
 - Currently Morocco, Moldova, Tunisia, and Cambodia
 - Pay fee to EPO
 - 6 months of publication of search report, or
 - Where applicable, deadline for EP regional phase entry

Unitary patent (UP)

- Progress has been stop-start for 40-odd years
- Looks highly likely to start 1 June 2023
- EU agreement, so post-Brexit not UK
 - Currently have 17 UP states
- An alternative to 'classical' validation in individual EPC states
 - Can't have both
- Single object of property, single renewal fee, single court
- Request unitary effect within 1 month of grant
 - Transitionally, can delay grant/ask early for unitary effect
- You'll likely hear lots more about it over the next few months

Thank you

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