

Granting Procedure

Filing date

Art. 80, R 40 EPC

- EPC 2000 only applies to applications after Dec 13, 2007
- EP applications in every language Art 14(2) EPC

Requirements for a filing date

- Notification that EP has been requested
- Information to ascertain the identity of the applicant or to ascertain establishing contact to the applicant
- Description or reference to prior applications
- Claims are no longer essential for the filing date, but for the further procedure (search, publication, research)

Art. 123(2) EPC

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Reference to a prior application:

- Filing date and official reference number of prior application
- Patent office of prior application
- Reference renders description and figures moot and can include a reference to the claims R 57(c) EPC
- Certified copy and if necessary translation of the prior application needs to be filed
 - Deadline: 2 months after filing at the EPO
 - 2 months after request by the EPO
 - Legal consequences R55, 57(a), 58 EPC
 - No further processing, only reinstatement after failure to file in time

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Missing parts in the description or figures:

- EPO requests subsequent filing within a time period of 2 months
- After subsequent filing the filing date will be newly appointed unless a priority is claimed, the missing parts are completely covered by the priority application and request of applicant
- Details in R 56 EPC

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Right of priority

Art. 87, R 52, 53 EPC

- **Entitlement to priority**

Filing in a WTO-member state, which is not a member of the Paris Convention (e.g. Taiwan)

- Reinstatement of **priority deadline is possible!**

- **Priority declaration**

Can be done or corrected within 16 months of the earliest priority date

- **Translation of the priority document**

Only upon request by the EPO, if validity of priority is relevant to the patentability

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Further processing

Art. 121, R 135 EPC

- Standard legal remedy for applicants (good news!)
in case of loss of right by failure to comply with statute or EP
deadlines
- Deadline: 2 months after notification of loss of right
- Payment of fee for further processing and completing the omitted
act
- Fee for further processing:
50% of the fee which was not paid
Otherwise EUR 210
- Further processing applies to all cases in which the deadline for
further processing has not expired on Dec. 13, 2007

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Further processing

Art. 121, R 135 EPC

Excluded from further processing are deadlines for

- Declaration of priority
- Appeal
- Request for examination by EBA
- Further processing and reinstatement
- Deadlines set by the formality and receiving division
- Request to obtain a decision with the right to appeal
- Payment of annuity fees
- Notification of deposition numbers of biological material

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Reinstatement

Art. 122, R 136 EPC

- Reinstatement is now possible for the priority deadline Art. 87 EPC
2 months after expiry of the priority deadline
2 months also for reinstatement of the deadline according to
Art. 112a(4) EPC - EBA
- Excluded from reinstatement are
 - all deadlines for which further processing may be requested
 - deadline for reinstatement itself
- Reinstatement according to EPC2000 applies to all cases, in which the
deadline for reinstatement has not expired on Dec. 13, 2007

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Further amendments

- Definition of “written form” and “signature” R 1, 2(2) EPC
- Divisional application is to be filed in the language of procedure
R 36(2) EPC
- Opposition
Implementation of principles of G10/91 R 81(1) EPC
 - Grounds for opposition filed by the opponent must be checked
 - Further grounds can be checked

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Further amendments

- EPO may request information about state of the art from the applicant, which has been identified in parallel cases (rare)
Art. 124, R 141 EPC
- The right to refuse testimony of the representative
(attorney-client privilege) Art. 134a(1)(d) R 153 EPC

Recent case law – Enlarged Board of Appeal

Ref No.	Title	Date
G 1/08	“Biological process” (not yet published)	9.12.2010
G 1/09	Pending application	27.9.2010
G 4/08	Langue de la procédure	16.2.2010
G 3/08	Patentability of programs for computers	12.5.2010
G 3/08	Suspicion of partiality	16.10.2009
G 2/08	Dosage regime	19.2.2010
G 2/08	Exclusion and objection	15.6.2009
G 1/07	Method for treatment by surgery	15.2.2010
G 2/06	Stem cells (OJ 2009, 306)	25.11.2008

European Patent after Grant

Scope of protection of the European Patent

Art. 69(1) EPC

(1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims

Protocol on the Interpretation of Art. 69(1) EPC

Elements equivalent to the elements in the claims have to be considered.

Also applies to applications pending on Dec. 13, 2007 and for granted patents.

European Patent after Granting

National nullity suits

Art. 138(2), (3) EPC

- Partial nullity possible by restriction procedure
- The patentee is allowed to merely defend the restricted European patent.
- This also applies to patents, which have been granted before Dec 13, 2007

Thank you for your attention !

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