

# THE DOCKETING EXCELLENCE WEBINAR SERIES



Black Hills IP

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# EP VALIDATION PROCESS

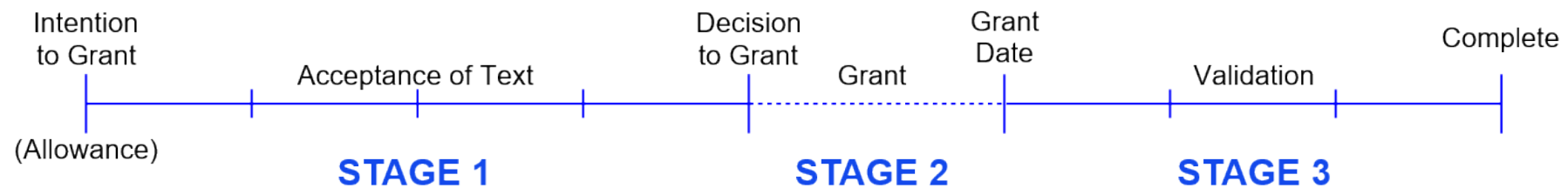


# EP VALIDATION PROCESS

- Presenters:
  - Ann McCrackin, President, Black Hills IP, LLC
  - Bryn Williams, European Patent Attorney, Creation IP
  - Karen McCartney, IP Paralegal, Creation IP

# EP Validation Process – A Three Stage Process

- Stage 1 – Acceptance of Text
  - from receipt of Intention to Grant to Decision to Grant
- Stage 2 – Grant
  - from Decision to Grant to Grant Date
- Stage 3 – Validation
  - from Grant Date to Validation completion



# Stage 1 – Intention to Grant – Rule 71(3)

- Driven by issuance of Communication Under Rule 71(3)

Application No. 13 000 230.6 - 1604	Ref. EP13/01	Date 01.07.2015
Applicant [APPLICANT NAME]		

Communication under Rule 71(3) EPC

1. Intention to grant

You are informed that the examining division intends to grant a European patent on the basis of the above application, with the text and drawings and the related bibliographic data as indicated below.

A copy of the relevant documents is enclosed.



Permittive Officer  
Name: [OFFICIAL]  
Tel: +31 70 340 - 814578  
of 081  
+31 (0)70 340 48 00

Application No. 13 000 230.6 - 1604	Ref. EP13/01	Date 01.07.2015
Applicant [APPLICANT NAME]		

Communication under Rule 71(3) EPC

1. Intention to grant

You are informed that the examining division intends to grant a European patent on the basis of the above application, with the text and drawings and the related bibliographic data as indicated below.

A copy of the relevant documents is enclosed.

1.1 Description, Pages  
1-95 as originally filed

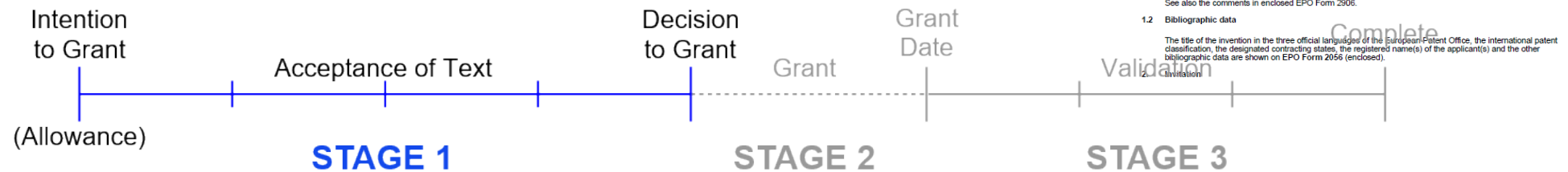
Claims, Numbers  
1-30 filed with telefax on 11-06-2013

Drawings, Sheets  
1/14-14/14 as originally filed

See also the comments in enclosed EPO Form 2906.

1.2 Bibliographic data

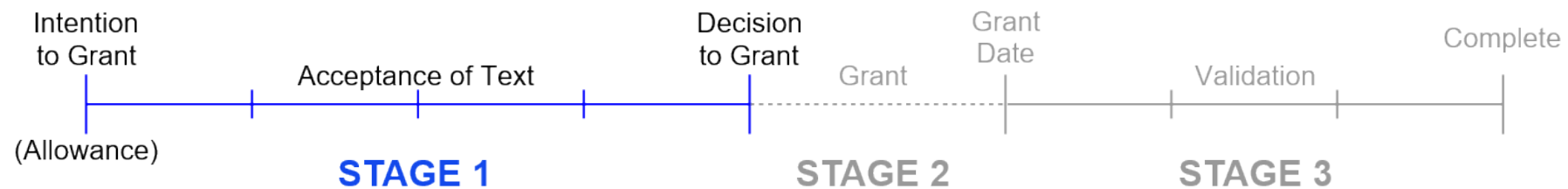
The title of the invention in the three official languages of the European Patent Office, the international patent classification, the designated contracting states, the registered name(s) of the applicant(s) and the other bibliographic data are shown on EPO Form 2056 (enclosed).



# Stage 1 – Intention to Grant – Rule 71(3)

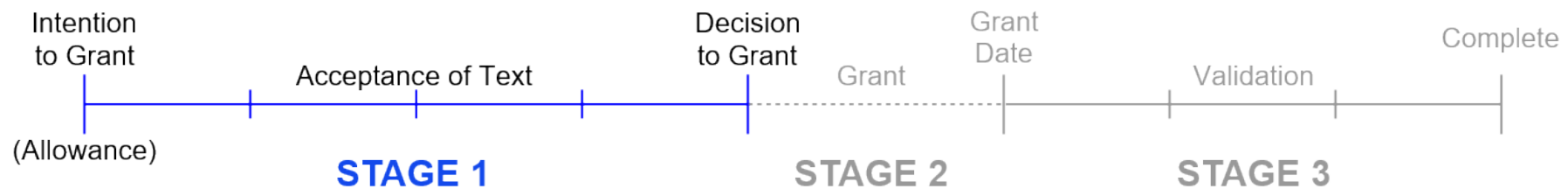
## ■ Requirements:

- Approve the text
- Verify the bibliographic data
- File translations of the claims into French and German
- Pay the Grant and Publishing Fees
- Pay additional Claims and Printing Fees (if necessary)



# Stage 1 – Intention to Grant – Rule 71(3)

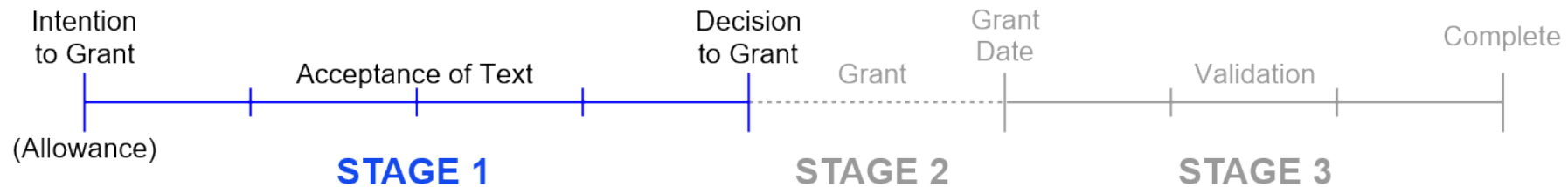
- **Approve the text**
  - Is the allowed text correct?
  - Has the Examiner made further amendments?
- **Verify bibliographic data**
  - Are proprietor details correct?
  - Change of details recorded centrally at EPO prior to grant



# Stage 1 – Acceptance of Text – Docketing Requirements



- Time for responding is four months
- 10 day rule applies
- Time is not extendable
- Further processing is available at an additional cost
  - provides approximately 2 months for complying with the communication.





# Stage 2 - Grant

## ■ Driven by issuance of Decision to Grant Article 97(1)

### Decision to grant a European patent pursuant to Article 97(1) EPC

Following examination of European patent application No. 1xxxxxxx a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 71(3) EPC (EPO Form 2004C) or in the information (EPO Form 2004W, cf. Notice from the EPO dated 8 June 2015, OJ EPO 2015, A52) dated 07.01.16 is hereby granted in respect of the designated Contracting States.

This decision will take effect on the date on which the European Patent Bulletin mentions the grant (Art. 97(3) EPC).

The mention of the grant will be published in European Patent Bulletin 16/33 of 17.08.16.



European Patent Office  
80228 MUNICH  
GERMANY

Questions about this communication ?  
Contact Customer Services at [www.epo.org/contact](http://www.epo.org/contact)



Date  
21.07.16

Reference	Application No./Patent No. 1xxxxxxx
Applicant/Proprietor	

### Decision to grant a European patent pursuant to Article 97(1) EPC

Following examination of European patent application No. 1xxxxxxx a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 71(3) EPC (EPO Form 2004C) or in the information (EPO Form 2004W, cf. Notice from the EPO dated 8 June 2015, OJ EPO 2015, A52) dated 07.01.16 is hereby granted in respect of the designated Contracting States.

Patent No. :  
Date of filing :  
Priority claimed :

Designated Contracting States and Proprietor(s) : AL AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HR HU IE IS IT LI LT LU LV MC MK MT NL NO PL PT RO RS SE SI SK SM TR

This decision will take effect on the date on which the European Patent Bulletin mentions the grant (Art. 97(3) EPC).

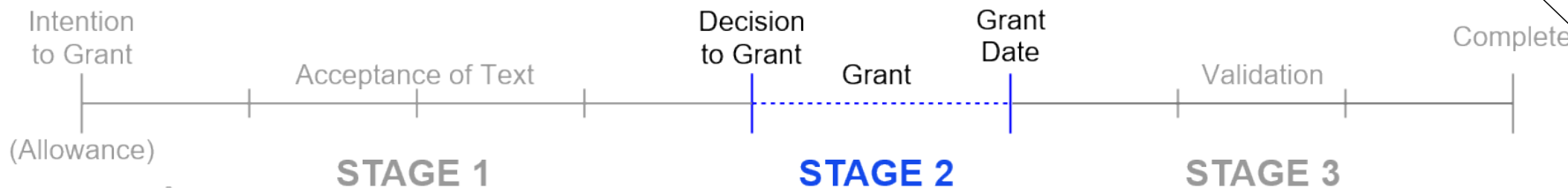
The mention of the grant will be published in European Patent Bulletin 16/33 of 17.08.16.

Examining Division

Pantoja Conde A

Demoor K

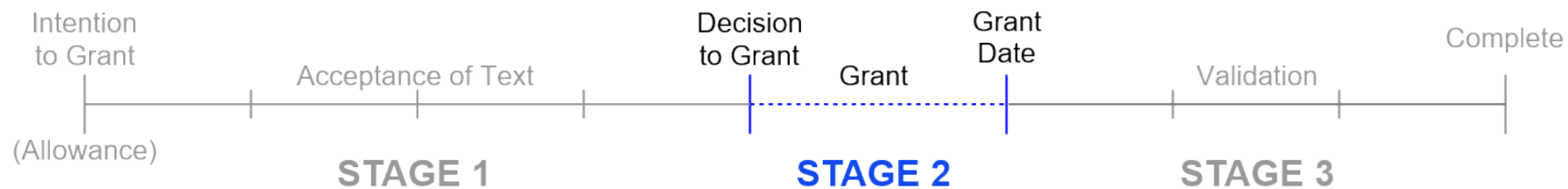
Lechanteux A



# Stage 2 – Grant – Docketing Requirements



- Grant Date - referred to on front page of Decision to Grant
- Sets deadline for filing divisional applications
  - The day **prior** to the grant date
  - **Not extendible – drop dead deadline**
- Sets deadline for completing validations
  - 3 months from the grant date
  - **Not extendible – drop dead deadline**

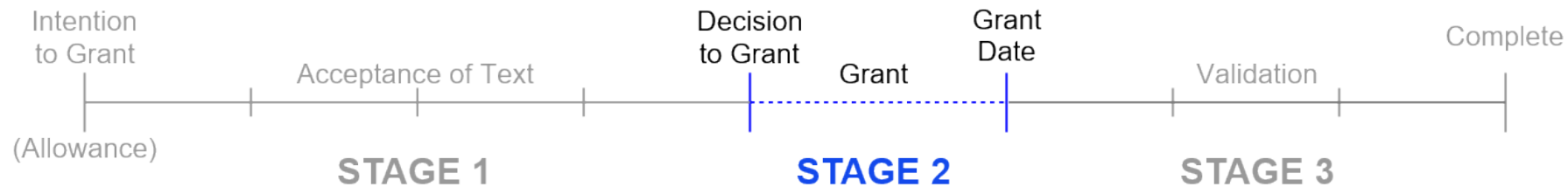


# Stage 2 – Renewals/Annuities – Docketing Requirements



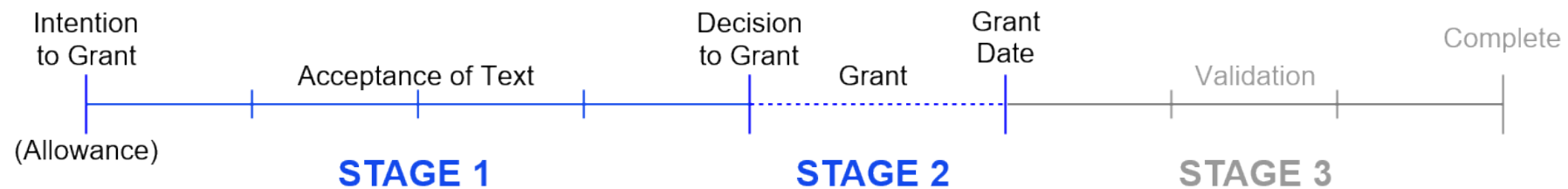
Check when renewal date falls:

- If before grant date renewal due at EPO (one fee)
- If **after** grant date renewals due nationally (multiple fees depending on the EP national selection countries)



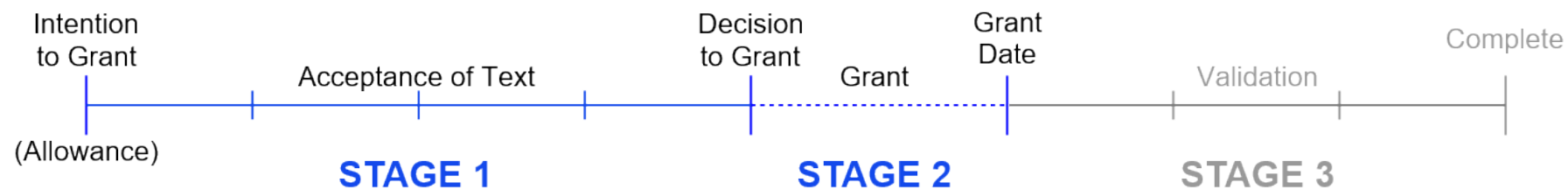
# Stage 1/2 – Strategy for renewal payment reductions

- Year 5 renewal due at European Patent Office – **\$1127**
- Year 5 renewal fees due at French, German, UK, Dutch, Italian, Spanish and Irish Patent Offices - **\$1895**
- A One-off saving can be made if it were possible to bring the fifth year renewal date into Stage 2 (Grant) rather than Stage 3 (Validation)



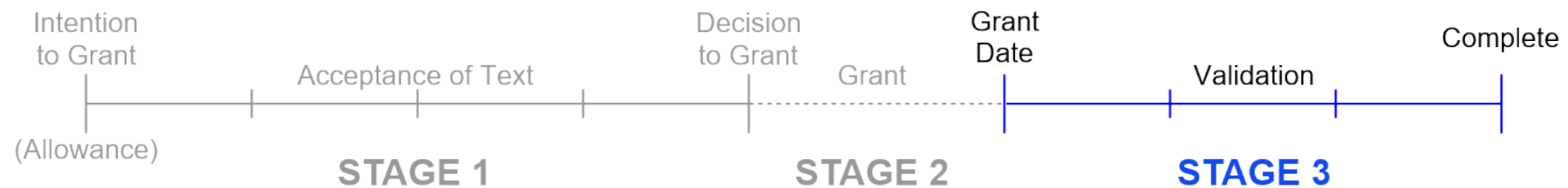
# Stage 1/2 – Strategy for renewal payment reductions

- Action has to be taken during Stage 1 to actively delay date of grant.
- How can this be done?
  - File response to Intention to Grant/allowance as close to deadline as possible
  - Allow case to go into further processing



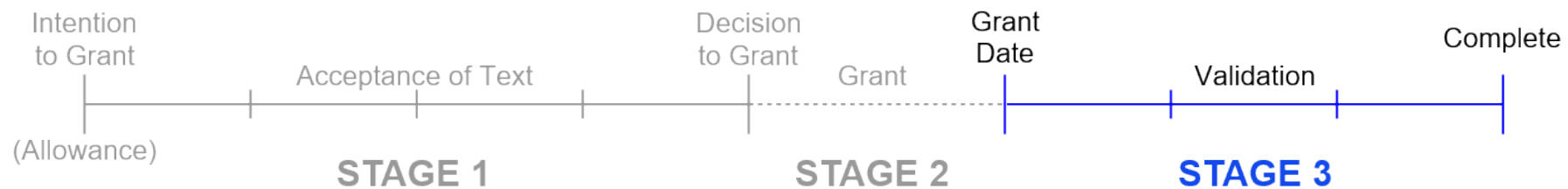
# Stage 3 – Validation

- Driven by date of grant – validations must be completed within 3 months – **Not Extendible**
- Key requirements –
  - Comply with national laws to allow European Patent to have effect in national states
  - Translation and Power of Attorney requirements vary from country to country



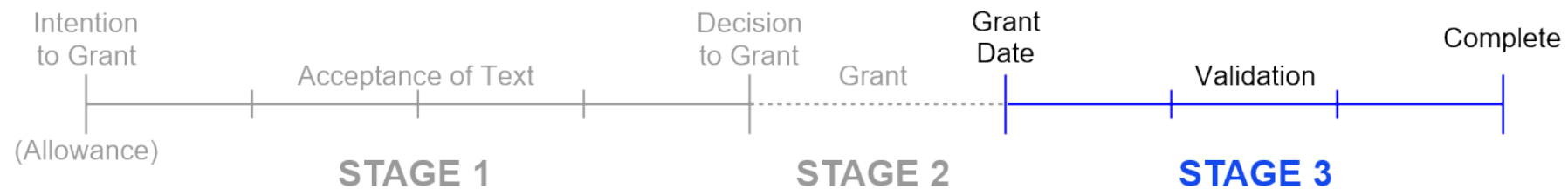
# Stage 3 – Validation

- Validation requirements include:
  - Payment of national fees
  - Filing of national forms
  - Filing of translations
  - Appointing an address for service (local counsel in a country)
    - An address for service is not compulsory but is recommended to ensure communications concerning renewal fees from national offices and from third parties concerning, for example, licences, are correctly received.



# Stage 3 – Renewals/Annuities Considerations

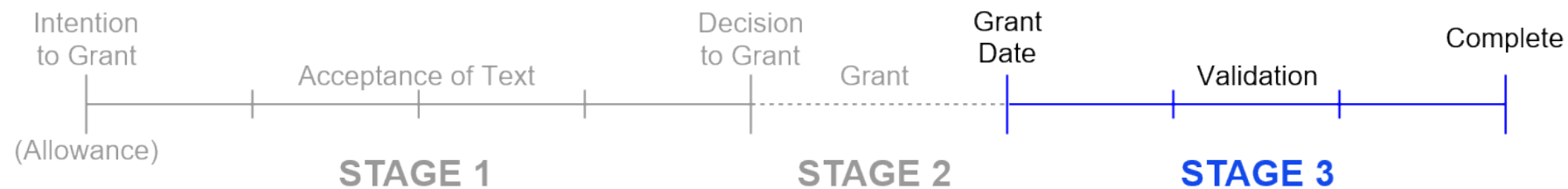
- If the renewal date falls due within validation term renewal deadline reverts to validation deadline
- As a rule of thumb, for countries which require translations to be filed, renewal fees cannot be paid until validation is complete.





# Stage 3 – London Agreement

- The London Agreement is a patent law agreement concluded in London on 17 October 2000 and aimed at reducing the translation costs of European patents granted under the European Patent Convention (EPC).
- Currently 21 of the 39 EPC member states are signatories to the London Agreement who have dispensed with at least some translation requirements.



# Stage 3 – Validation Matrix

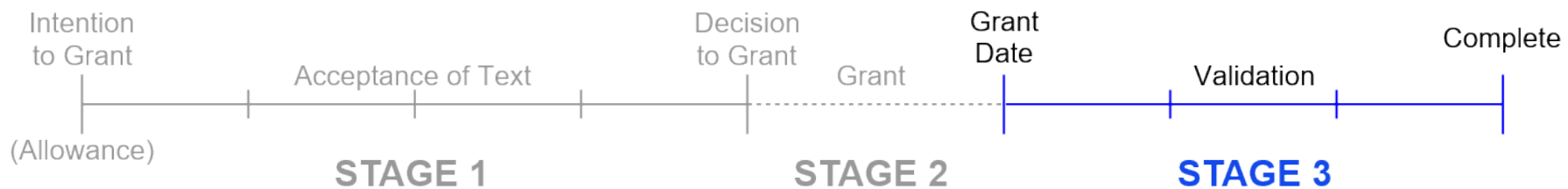
Country	PoA	Translation Req.	Country	PoA	Translation Req.	Country	PoA	Translation Req.
Albania	Yes	Claims Translation	Greece	Yes	Full Translation	Poland	Yes	Full Translation
Austria	Yes	Full Translation	Hungary	Yes	Claims Translation	Portugal	No	Full Translation
Belgium	No	No Translation	Iceland	No	Claims Translation	Romania	Yes	Full Translation
Bosnia/Herz.	Yes	Claims Translation	Ireland	Yes	No Translation	San Marino	Yes	Full Translation
Bulgaria	Yes	Full Translation	Italy	Yes	Full Translation	Serbia	Yes	Full Translation
Croatia	Yes	Claims Translation	Latvia	No	Claims Translation	Slovakia	Yes	Full Translation
Cyprus	Yes	Full Translation	Lithuania	Yes	Claims Translation	Slovenia	Yes	Claims Translation
Czech Rep.	Yes	Full Translation	Luxembourg	No	No Translation	Spain	No	Full Translation
Denmark	No	Claims Translation	Macedonia	Yes	Claims Translation	Sweden	No	Claims Translation
Estonia	Yes	Full Translation	Malta	Yes	No Translation	Switzerland	Yes	No Translation
Finland	No	Claims Translation	Monaco	Yes	No Translation	The Netherlands	No	Claims Translation
France	No	No Translation	Montenegro	Yes	Claims Translation	Turkey	No	Full Translation
Germany	No	No Translation	Norway	Yes	Claims Translation	United Kingdom	No	No Translation

# Stage 3 - Validation - Docketing Requirements



Check requirements – don't run out of time:

- Power forms:
  - Originals may be required by Associate
  - **Greece – Power form must be on file by the validation deadline. Email in advance is acceptable.**



# Stage 3 – Validation Matrix – Powers Required

Country	PoA	Translation Req.	Country	PoA	Translation Req.	Country	PoA	Translation Req.
Albania	Yes	Claims Translation	Greece	Yes	Full Translation	Poland	Yes	Full Translation
Austria	Yes	Full Translation	Hungary	Yes	Claims Translation	Portugal	No	Full Translation
Belgium	No	No Translation	Iceland	No	Claims Translation	Romania	Yes	Full Translation
Bosnia/Herz.	Yes	Claims Translation	Ireland	Yes	No Translation	San Marino	Yes	Full Translation
Bulgaria	Yes	Full Translation	Italy	Yes	Full Translation	Serbia	Yes	Full Translation
Croatia	Yes	Claims Translation	Latvia	No	Claims Translation	Slovakia	Yes	Full Translation
Cyprus	Yes	Full Translation	Lithuania	Yes	Claims Translation	Slovenia	Yes	Claims Translation
Czech Rep.	Yes	Full Translation	Luxembourg	No	No Translation	Spain	No	Full Translation
Denmark	No	Claims Translation	Macedonia	Yes	Claims Translation	Sweden	No	Claims Translation
Estonia	Yes	Full Translation	Malta	Yes	No Translation	Switzerland	Yes	No Translation
Finland	No	Claims Translation	Monaco	Yes	No Translation	The Netherlands	No	Claims Translation
France	No	No Translation	Montenegro	Yes	Claims Translation	Turkey	No	Full Translation
Germany	No	No Translation	Norway	Yes	Claims Translation	United Kingdom	No	No Translation

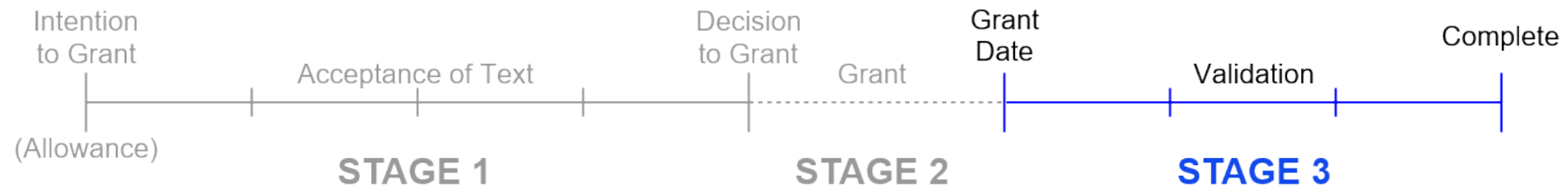
**A Power form for Greece must be on file by the validation deadline to complete the national requirements.**

# Stage 3 - Validation - Docketing Requirements



Check requirements – don't run out of time:

- Translations:
  - Full translations may be required – **Italy, Spain**



# Stage 3 – Validation Matrix – Full Translations

Country	PoA	Translation Req.	Country	PoA	Translation Req.	Country	PoA	Translation Req.
Albania	Yes	Claims Translation	Greece	Yes	Full Translation	Poland	Yes	Full Translation
Austria	Yes	Full Translation	Hungary	Yes	Claims Translation	Portugal	No	Full Translation
Belgium	No	No Translation	Iceland	No	Claims Translation	Romania	Yes	Full Translation
Bosnia/Herz.	Yes	Claims Translation	Ireland	Yes	No Translation	San Marino	Yes	Full Translation
Bulgaria	Yes	Full Translation	Italy	Yes	Full Translation	Serbia	Yes	Full Translation
Croatia	Yes	Claims Translation	Latvia	No	Claims Translation	Slovakia	Yes	Full Translation
Cyprus	Yes	Full Translation	Lithuania	Yes	Claims Translation	Slovenia	Yes	Claims Translation
Czech Rep.	Yes	Full Translation	Luxembourg	No	No Translation	Spain	No	Full Translation
Denmark	No	Claims Translation	Macedonia	Yes	Claims Translation	Sweden	No	Claims Translation
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Finland	No	Claims Translation	Monaco	Yes	No Translation	The Netherlands	No	Claims Translation
France	No	No Translation	Montenegro	Yes	Claims Translation	Turkey	No	Full Translation
Germany	No	No Translation	Norway	Yes	Claims Translation	United Kingdom	No	No Translation

# Stage 3 – Validation Matrix – Duplicate Translations

Country	PoA	Translation Req.	Country	PoA	Translation Req.	Country	PoA	Translation Req.
Albania	Yes	Claims Translation	Greece	Yes	Full Translation	Poland	Yes	Full Translation
Austria	Yes	Full Translation	Hungary	Yes	Claims Translation	Portugal	No	Full Translation
Belgium	No	No Translation	Iceland	No	Claims Translation	Romania	Yes	Full Translation
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Bulgaria	Yes	Full Translation	Italy	Yes	Full Translation	Serbia	Yes	Full Translation
Croatia	Yes	Claims Translation	Latvia	No	Claims Translation	Slovakia	Yes	Full Translation
Cyprus	Yes	Full Translation	Lithuania	Yes	Claims Translation	Slovenia	Yes	Claims Translation
Czech Rep.	Yes	Full Translation	Luxembourg	No	No Translation	Spain	No	Full Translation
Denmark	No	Claims Translation	Macedonia	Yes	Claims Translation	Sweden	No	Claims Translation
Estonia	Yes	Full Translation	Malta	Yes	No Translation	Switzerland	Yes	No Translation
Finland	No	Claims Translation	Monaco	Yes	No Translation	The Netherlands	No	Claims Translation
France	No	No Translation	Montenegro	Yes	Claims Translation	Turkey	No	Full Translation
Germany	No	No Translation	Norway	Yes	Claims Translation	United Kingdom	No	No Translation

# Stage 3 – Validation Matrix – Relative Costs

Country	PoA	Translation Req.	Country	PoA	Translation Req.	Country	PoA	Translation Req.
Albania	Yes	Claims Translation	Greece	Yes	Full Translation	Poland	Yes	Full Translation
Austria	Yes	Full Translation	Hungary	Yes	Claims Translation	Portugal	No	Full Translation
Belgium	No	No Translation	Iceland	No	Claims Translation	Romania	Yes	Full Translation
Bosnia/Herz.	Yes	Claims Translation	Ireland	Yes	No Translation	San Marino	Yes	Full Translation
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France	No	No Translation	Montenegro	Yes	Claims Translation	Turkey	No	Full Translation
Germany	No	No Translation	Norway	Yes	Claims Translation	United Kingdom	No	No Translation

For a typical specification, the green coloured countries are the lowest cost with the red countries being the most expensive. This is indicative and depends on the relative lengths of the claims to the description.



# Questions

- Questions on Today's Program
  - Please submitted your questions using the Q&A button on the control bar on your screen.
- If you have questions regarding Black Hills IP's services or processes, please contact:  
Jim Brophy  
Ph. 612-867-4018  
[jbrophy@blackhillsip.com](mailto:jbrophy@blackhillsip.com)

# The Docketing Excellence Webinar Series

Please join us for our next presentation:

Handling Opposition Proceeding Docketing in the EP

April 19, 2017 at 1:00 PM Central