

EP Grant & Validation Process

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- Presenters:
 - Bryn Williams, UK Principal, European Patent Attorney, Schwegman, Lundberg & Woessner, UK
 - Karen McCartney, IP Paralegal, Schwegman, Lundberg & Woessner, UK

The European Patent Convention Countries

Map showing the geographic coverage of European patents as of 1 November 2019

■ Member states (38)

- Albania
- Austria
- Belgium
- Bulgaria
- Croatia
- Cyprus
- Czech Republic
- Denmark
- Estonia
- Finland
- France
- Germany
- Greece
- Hungary
- Iceland
- Ireland
- Italy
- Latvia
- Liechtenstein
- Lithuania
- Luxembourg
- Malta
- Monaco
- Netherlands
- North Macedonia
- Norway
- Poland
- Portugal
- Romania
- San Marino
- Serbia
- Slovakia
- Slovenia
- Spain
- Sweden
- Switzerland
- Turkey
- United Kingdom

■ Extension states (2)

- Bosnia and Herzegovina
- Montenegro

■ Validation states (4)

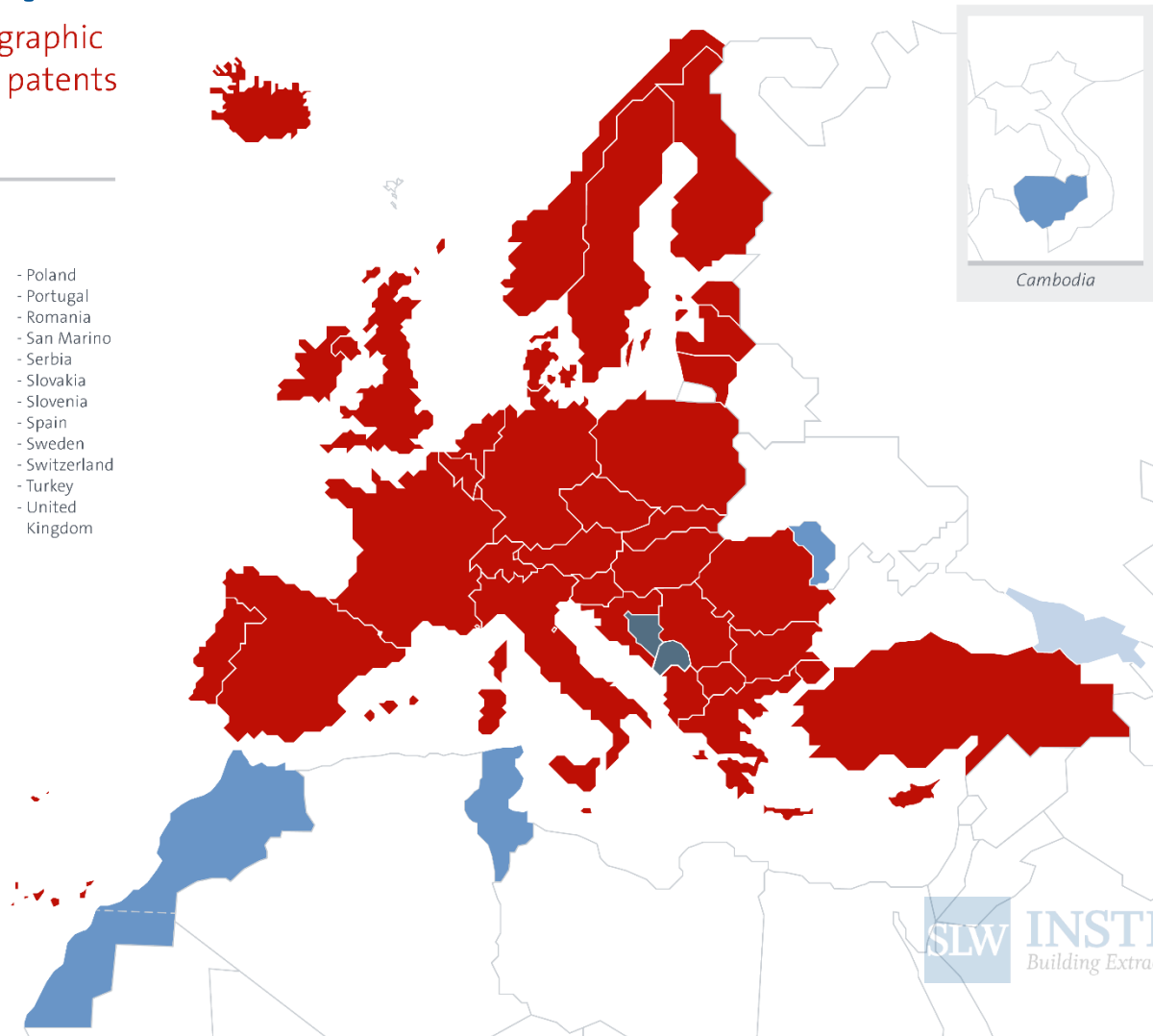
Agreement in force

- Cambodia
- Republic of Moldova
- Morocco
- Tunisia

■ Future validation states (1)

Agreement signed but not in force yet

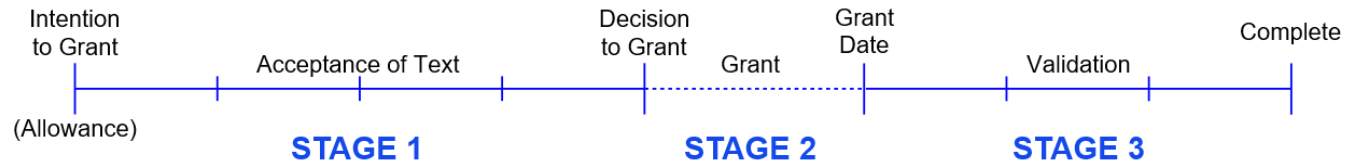
- Georgia





EP Grant & 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)
- This document sets out the text that the EPO has accepted.

Application No. 13 000 230.6 - 1604	Ref. EP1301	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.



Application No. 13 000 230.6 - 1604	Ref. EP1301	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 telexfax on 11-06-2013

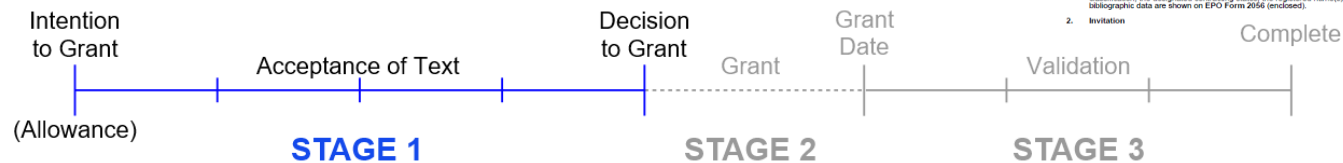
Drawings, Sheets
 1/14-14/14 as originally filed

See also the comments in enclosed EPO Form 2506.

1.2 Bibliographic data

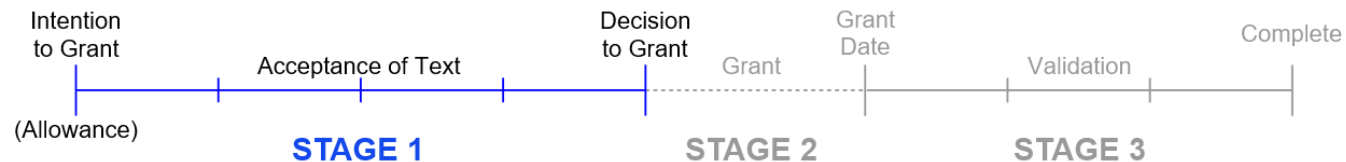
The title of the invention in the three official languages of the European Patent Office, the international patent classification, the designated contracting states, the registered name(s) of the applicant(s) and the other bibliographic data are shown on EPO Form 2556 (enclosed).

2. Invitation



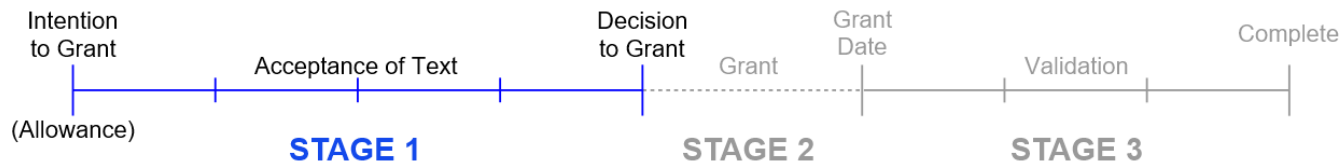
Stage 1 – Intention to Grant – Rule 71(3)

- 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)



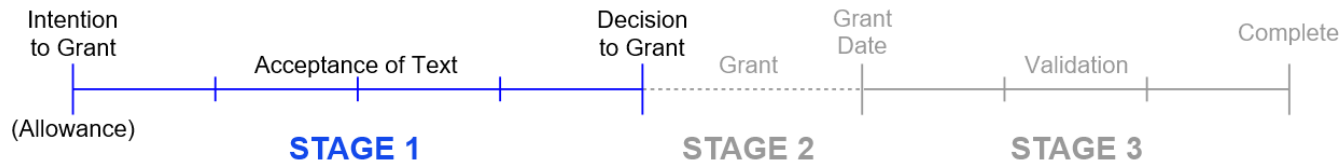
Approving the text – recent procedural change

- The rule 71(3) document is the legal text, it is the document on which any litigation will be conducted; therefore it has to be correct.
- If it is not correct then we **do not** approve the text.
- We file corrections and request a further 71(3).
- This is repeated until the text attached to the 71(3) document is acceptable.



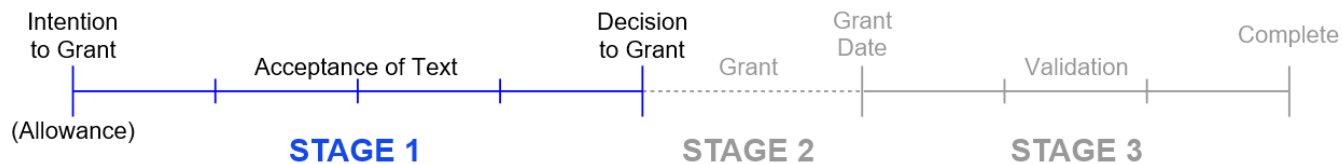
Approving the text – recent procedural change

- Has the Examiner made further amendments? Examiners can make significant changes of their own volition.
- The corrections we make may be such that the Examiner does not issue a further 71(3) but goes back into examination.



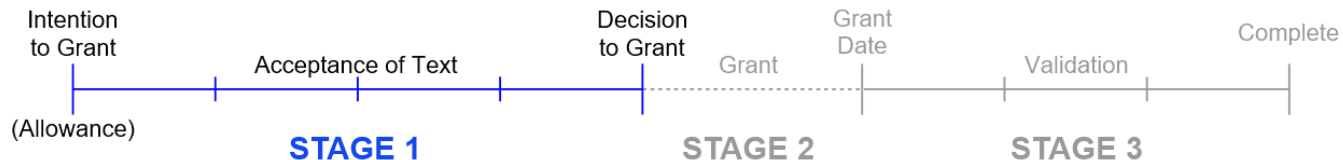
Stage 1 – Checking the Rule 71(3)

- **Verify bibliographic data**
 - Are proprietor details correct?
 - Change of details recorded centrally at EPO prior to grant



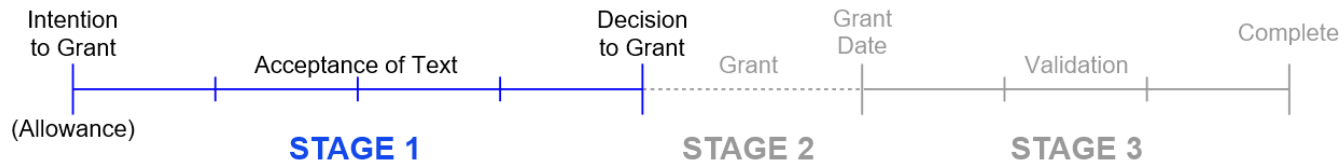
Extending The Timelines

- Reasons for extending:
 - To give more time for filing a divisional applications (discussed later)
 - To allow more time for filing an upcoming assignment, transfer or change of name and/or address
 - Reduce renewal costs (discussed later)
 - Delay costs of grant for the applicant



Extending Stage 1

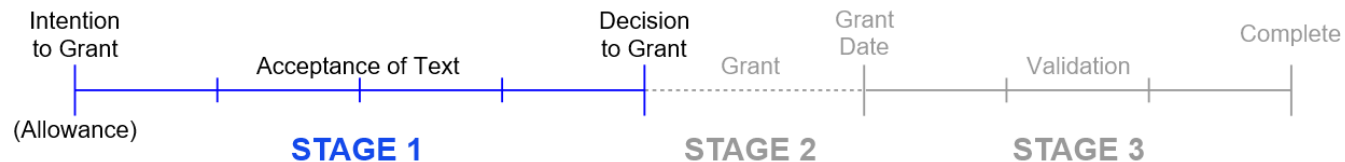
- There is no automatic extension available to the deadline for responding to the Rule 71(3).
- The process can be extended by doing one or both of the following:
 - Allowing the current 71(3) to enter Further Processing
 - Making a minor correction to the current 71(3) and request a further 71(3)



Stage 1 Docketing Requirements



- Time for responding to any Rule 71(3) is four months
- 10 day rule always applies
- Time is not automatically 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).

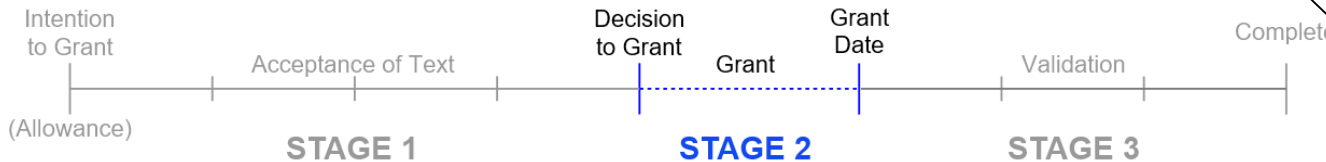
The mention of the grant will be published in European Patent Bulletin 16/33 of **17.08.16**

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.

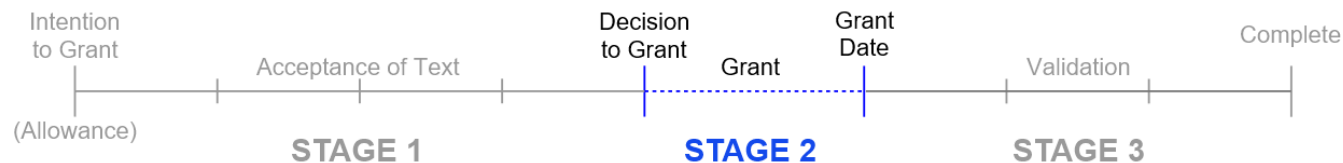
Examining Division : Pantoja Conde A, Demoor K, Lecharteux A



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 extendable – drop dead deadline**
- Sets deadline for completing validations
 - 3 months from the grant date
 - **Not extendable – drop dead deadline**

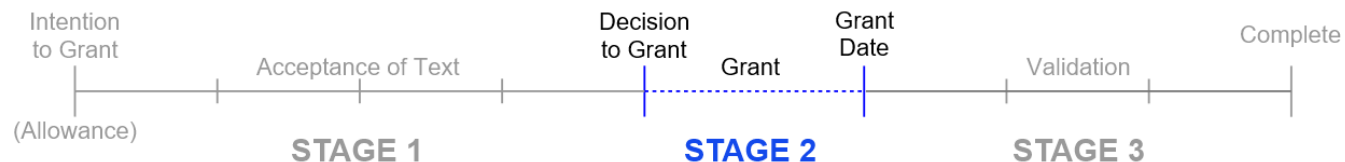


Stage 2 – Renewals/Annuities - Docketing Requirements



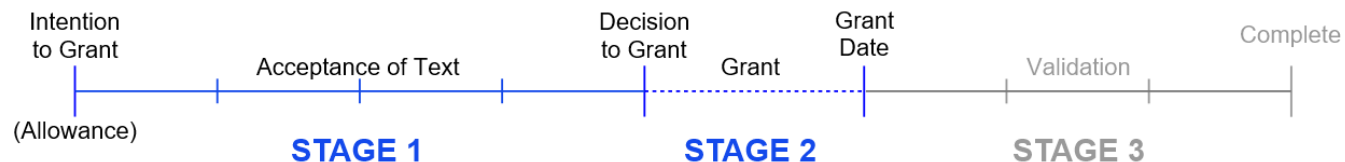
Check when renewal date falls:

- 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)



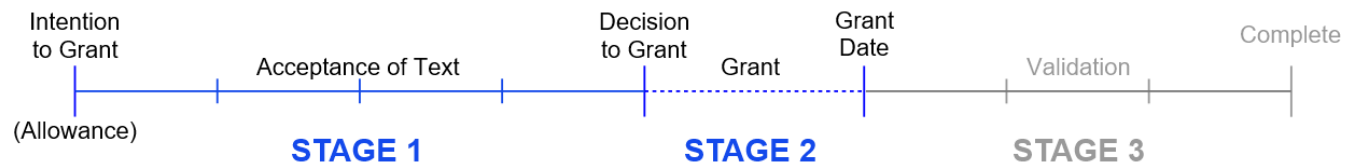
Stage 1/2 – Strategy for renewal payment reductions

- Year 5 renewal due at European Patent Office – **\$1085**
- Year 5 renewal fees due at French, German, UK, Dutch, Italian, Spanish and Irish Patent Offices - **\$1950**
- 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)



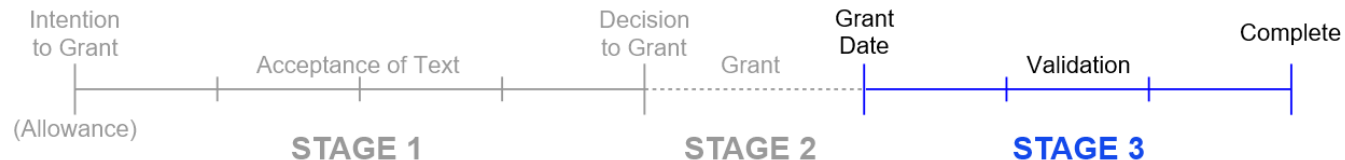
Stage 1/2 – Strategy for renewal payment reductions

- 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



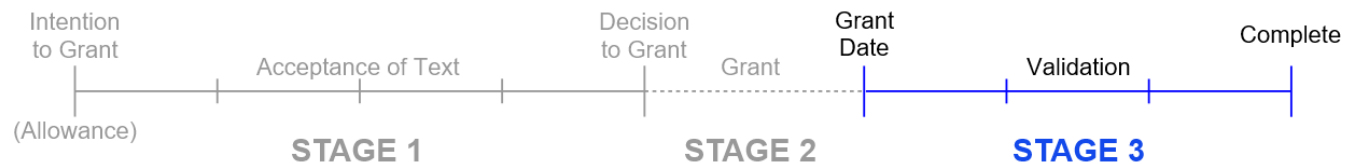
Stage 3 – Validation

- Driven by date of grant – validations must be completed within 3 months – **Not Extendable**
- 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



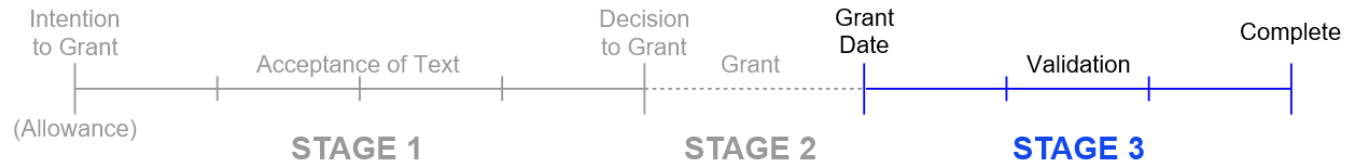
Stage 3 – Validation

- 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, licenses, are correctly received.



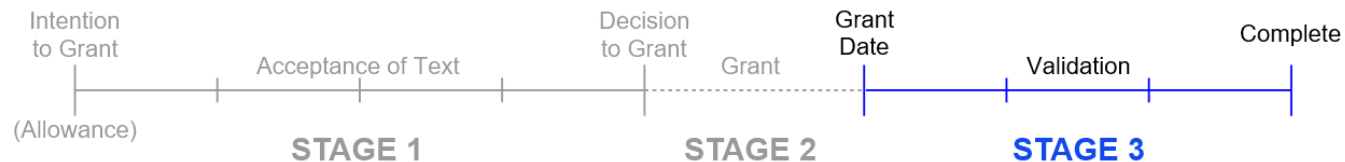
Stage 3 – Renewals/Annuities Considerations

- 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 EPC member states are signatories to the London Agreement who have dispensed with at least some translation requirements.



Stage 3 – Validation Matrix

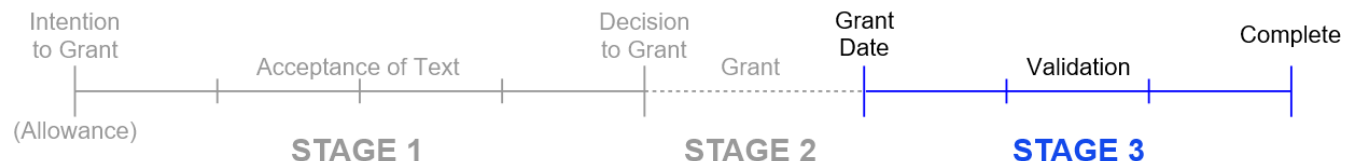
Country	PoA	Translation Req.	Country	PoA	Translation Req.	Country	PoA	Translation Req.
Albania	Yes	Claims Translation	Greece	Yes	Full Translation	Poland	Yes	Full Translation
Austria	Yes	Full Translation	Hungary	Yes	Claims Translation	Portugal	No	Full Translation
Belgium	No	No Translation	Iceland	No	Claims 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 & LI	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 & LI	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

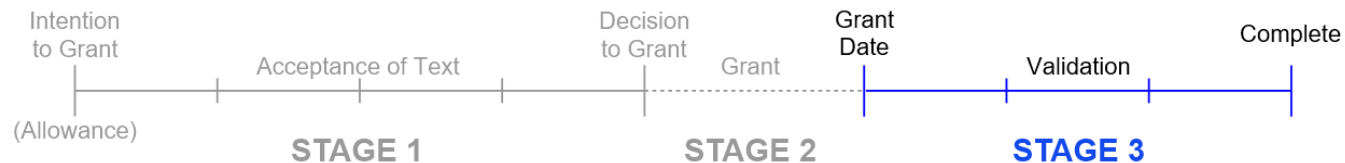
A Power form for Greece must be on file by the validation deadline to complete the national requirements.

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
Estonia	Yes	Full Translation	Malta	Yes	No Translation	Switzerland & LI	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

NB Hungary to become a full translation country in due course

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
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 & LI	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

Translation costs can be split between these territories.

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
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Czech Rep.	Yes	Full Translation	Luxembourg	No	No Translation	Spain	No	Full Translation
Denmark	No	Claims Translation	N Macedonia	Yes	Claims Translation	Sweden	No	Claims Translation
Estonia	Yes	Full Translation	Malta	Yes	No Translation	Switzerland & LI	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

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.

European Union Unitary Patent

- The Unitary Patent is a European Union project to provide a single designation for the European Union Member states.
- It may come into force in 2020 for some European Union countries
- A single combined designation replacing the individual national designations of those member states

Back to Brexit....

- If the Unitary Patent comes in then the UK will probably not be covered by this single validation (because they have left the EU).
- The EPO have said there may be an exception and the UK will be allowed to participate. But the politicians have to agree.
- Everything may become clear during the first half of 2020.

Using SLW UK as your validation provider

- Managed by Attorneys and experienced Paralegals.
- Appointed as Address for Service in four countries avoiding the need to use Associates.
- No document drip feed, documents, such as Powers of Attorney, gathered and sent in batches.
- Our process can be tailored to client requirements.

Thanks for listening.

These materials, and this webinar, are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.