

Differences Between US and EPO Practice, Part II

European law, procedures and culture are very different

- Knowledge of the differences in the law and procedure is essential -
 - To avoid significant loss of rights
 - To avoid falling foul of the procedures
 - To minimize misunderstanding



Today's Goals

- Context - What you need to know beyond day-to-day practice
- Jargon – why call it that?
- Easy life – smoother client engagement
 - formalities requirements
 - EPO post-grant practice
 - EPO approach to priority claiming.
- More context - future matters

The Landscape in Europe

- The European Patent Office is a transnational body. The member states extend beyond the EU e.g. Switzerland, Norway and the UK
- EPO provides for granting, opposition, and post grant amendment
- The EPO has no jurisdiction over disputes (infringement or revocation actions*)
- National Patent Offices grant national patents and hear revocation actions for national and EPO granted patents
- National courts handle all disputes - enforcement and invalidity

Designations

- DESIGNATED STATES
 - Unitary designation of all states on filing (single Designation Fee)
 - Request for Grant completed by payment of Examination Fee
 - Fees can be paid at any time up to 6 months after publication
- EXTENSION STATES
 - Must be designated on filing
 - Fees can be paid at any time up to 6 months after publication

Formalities

- AUTHORISATION

- Not required unless requested or Oral Proceedings to be attended
- Can be authorised to sub-authorise!

- PRIVILEGE

- EPA communications are privileged

- POSTAL SERVICES

- Deemed notification

- FURTHER PROCESSING/RESTITUTION

Formalities

- TRANSFERS (ASSIGNMENT, etc.)
 - No assignment document from the inventor required to be filed – Declaration of Inventor form simply has to state name and address of inventor and date of assignment
 - Recording subsequent assignment requires handwritten signature from persons authorised on behalf of each of assignor and assignee respectively – DIFFERENT FROM USA
 - Best practice to transfer all rights in an application –
 - rights in the invention,
 - rights in the application, and
 - the right to claim priority, - specific right in EP law
 - As well as the right to the patent when granted and any divisionals or continuations in any country. (For completeness, it is useful to include the right to enforce any patents and to claim for past damages).

Formalities

- PRIORITY

 - See below – note EPO not part of WIPO DAS but has bilateral with USPTO

- LANGUAGE

 - Note fee reductions for Applicants resident in European countries with official language that is not a prosecution language (EN/DE/FR) – ES or IT say

- PRESENTATION

 - Form of claims
 - Form of description

- THIRD PARTY OBSERVATIONS

Oral Proceedings (Examining Division)

- Nearest thing to “Final OA” stage in US prosecution
- Summons (with Annex)
- OP (i.e. hearing) can be in person or via Video conference
 - Three Examiners
 - Formal, **not** public
- Response with “Written Submissions”
 - Typically >1 “Request” [a Main Request and one or more Auxiliary Requests] – basically a set of claims as in prosecution
 - If time more submissions until the deadline (~OP-1M)
 - Can still make “late” submissions, but these can be dismissed
- If no progress, OP goes ahead or Applicant withdraws request
- All admitted Requests considered in order during hearing
- Appealable “Decision”: Refused or Allowed

Grant

- Allowable text (first allowable Request at OP or latest amended version from last response)
- For the patent to be granted the Grant Fee must be paid and translations on the claims into French and German (assuming prosecution in English) must be filed in response to Rule 71(3) communication.
- Within 3 months after the Notice of Grant the patent must be validated in each designated state in which a valid patent is required
 - Appoint address for service in each country
 - File translations (if necessary) – London Agreement has reduced the countries requiring full translations
 - Pay fees if necessary

Opposition

- An opposition can be filed against a European patent within 9 months of the grant of the patent.
- Closest thing to Post-Grant Review in Europe
- Grounds of opposition are:
 - Claimed subject matter is not new, inventive, or patentable
 - Insufficiency
 - Subject matter extends beyond the content of the application as filed – added subject matter
- Includes a public Oral Proceedings process similar to ED
- *Inter partes* - Opponent and Proprietor

Opposition

- Written submissions by both parties (sometimes numerous!)
- Although all prior art relied on should be filed with the opposition, late filed prior art will be considered if the Opposition Division consider it relevant
- Interlocutory opinion (allows a degree of case management)
- Oral Proceedings, leading to a Decision
 - Limitation on “motions to amend” on the day based on OD discretion, often more than one if progress is being made [compare with PGR in the US]

Appeal

- A Notice of Appeal can be filed against any decision of the European Patent Office
- The Notice of Appeal must be filed and the fee paid within 2 months of notification of the decision being appealed
- The Grounds of the Appeal must be filed within 4 months of notification of the decision being appealed
- New prior art may be admitted into an Appeal if the Board of Appeal consider it relevant
- Appeal proceedings can become a re-examination process

Appeal

- No court to appeal to from a decision of a Technical Board of Appeal.
- Enlarged Board of Appeal only hears points of law referred to it when the decisions of the Technical Boards of appeal diverge (only a Technical Board of Appeal or the President of the EPO can refer a point of law).

Post Grant Amendment

- Opposition can result in “partial revocation” (i.e. limitations to granted scope)
- Limitation or revocation of a European Patent can also be requested by a patent proprietor at the EPO
 - no restriction on the period between the grant of the patent and the filing of the request.
 - only examined for compliance with Art 84 and Art 123 – clarity and broadening of disclosure or protection.
 - no non-unity objections should be raised if the claims cannot be combined clearly.

Priority

- Must be claimed and can be corrected within 16 month of the earliest claimed priority date.
- Priority can only be claimed from the first application anywhere in the world for the invention – BEWARE CONTINUATIONS AND CIPs
- The right to priority for claims is based on the whole disclosure in the priority application not merely the claims
- The priority application must be *sufficient* for the claim to priority to be valid (“directly and unambiguously derivable”)
- Full specifications must be filed as priority applications

Priority Problems – example

- US provisional application discloses “*apparatus having a screw for fixing together two panels*”.
- The applicant sells the apparatus with a screw fixing.
- A European application is filed claiming priority from the US provisional application and includes claim 1 “*Apparatus having screw means for fixing together two panels*” and claim 2 “*wherein the screw means comprises a screw*”. The description includes examples with screws, clamps, and clips
- Claim 1 is not entitled to priority and has the filing date of the European application and is invalid because of the prior sale of the apparatus with a screw.
- Claim 2 is entitled to priority and is valid. Claims to clamps and clips are not entitled to priority and will need to be inventive over the use of a screw to be valid.

Enforcement

- Disputes are handled by national courts with authority only in their jurisdiction
- Specialist patent courts e.g. the Patents Court in the UK
- No jury trials
- No discovery in Germany. Limited discovery in the UK
- No experts in Germany – may have a court appointed expert
- Divergence of the application of the law
- Bifurcation in Germany.
- Court hears infringement and validity together in UK

Other Matters

- Double patenting
- Languages/S.I. units
- PCT route (for some countries, EP may be only way to a national patent)
- UK protection
 - Isle of Man (UK system applies automatically)
 - Hong Kong (re-registration of standard patent application)*
 - Registration upon request - Guernsey, Cayman Islands,
 - 5yr from grant - Turks and Caicos Islands,
 - 3yr from grant - Jersey, Anguilla, Bermuda, British Virgin Islands, Falkland Islands, Gibraltar, Montserrat, Belize, Fiji, Grenada, Guyana, Kiribati, Solomon Islands, Tuvalu)
- PPH

Brexit

- EPC is NOT the EU
- Currently in Transition period (until 31-DEC-20)
 - UK Gov currently does not expect this to be extended
- EP(UK) {and GB national} stay as they are
- Check any provisions which refer to the EU (and not the UK) in licences
- 2423 EPAs in UK (total of 12658 EPAs listed^{19-Feb-20})
 - “remain fully entitled to represent their clients in proceedings before the EPO, including oral proceedings, without the need for a work permit in either of the states in which proceedings established by the EPC may be conducted, i.e. Germany or the Netherlands”

Unitary Patent

- Still pending
- A “true” European patent with a system of Central and Local courts to handle disputes
- UK participation in doubt, but not ruled out
- not expected before the end of the Brexit transition period

Thanks for listening.

Any questions?

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