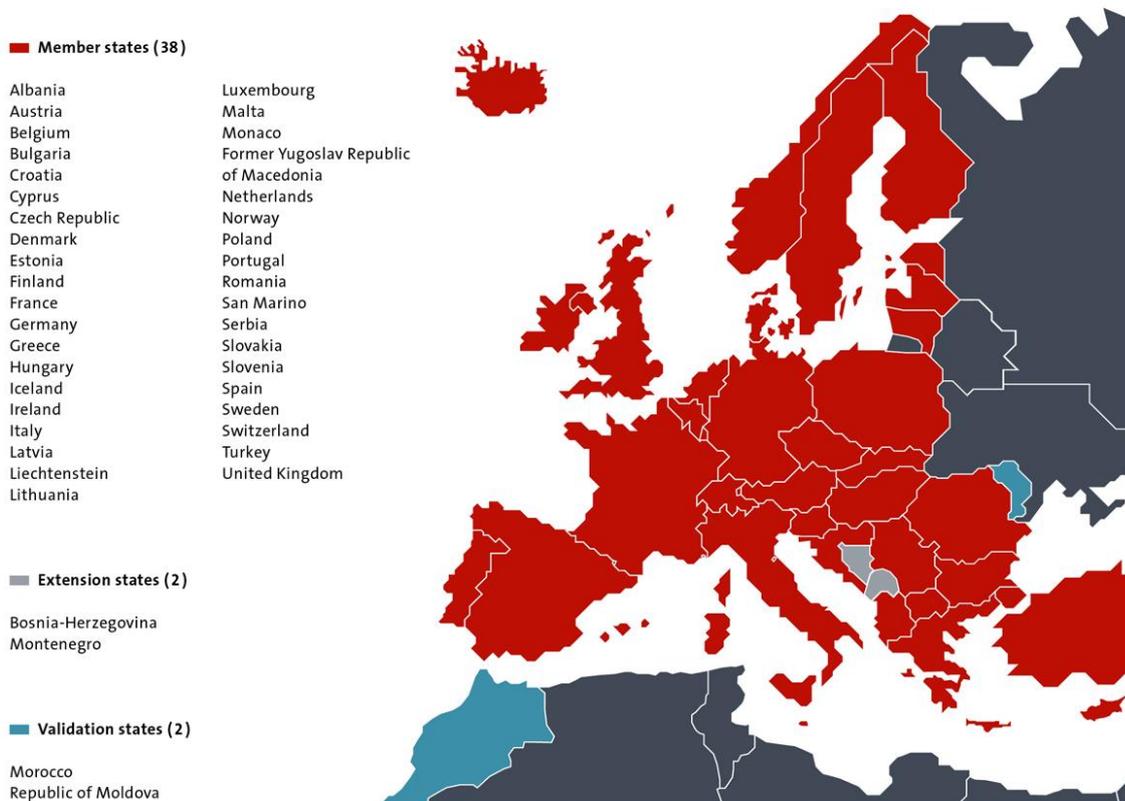


## European Patents

European patents are granted according to the European Patent Convention. The European Patent Convention is administered by the European Patent Organisation, part of which is the European Patent Office which has offices in The Hague, Berlin, Munich, Vienna and Brussels. The European Patent Organisation is an intergovernmental body, and is not part of the European Union, although all European Union states are also contracting states to the European Patent Convention. The European patent therefore covers all European Union member states plus some other additional states.

European patents include member states, in which a European patent is effective in during prosecution and immediately upon grant, Extension states which are states where there is an agreement with the European Patent Organisation that their national patent laws will approximate those of the European Patent Convention, and validation states which are states which will accept granted European patents into their national system without any further substantive examination on basic patentability.



## What can be protected?

The basic criteria for obtaining valid granted protection in a European patent are that the invention:

- has novelty
- involves an inventive step; and
- has industrial applicability

Subject to these criteria, European patents protect any invention which has a technical character or has technical effect.

The novelty requirement means that the claimed invention must not have been made publicly available prior to the earliest priority date of the European patent application. The invention must be novel over the prevailing state-of-the-art at the earliest date of filing the application.

The inventive step requirement means that the invention must not be obvious to a person skilled in the relevant art in which the invention lies, having regard to the state-of-the-art.

In practice most inventions have industrial applicability and it is rare for a European patent application to be rejected on the basis of lack of industrial applicability.

In general, European patents can be obtained in virtually any field of technology, subject to the above criteria.

## Duration

The maximum duration of a European patent is 20 years from the filing date. However, if the European patent claims priority from an earlier patent application, this maximum duration can extend to 21 years from the earliest priority date.

For some types of pharmaceutical / medicinal invention, in some countries such as the UK, protection can be extended for a maximum of a further 5 ½ years, by applying for a supplementary protection certificate. This applies only to a small minority of European patents.

Official maintenance fees need to be paid centrally for a European patent for the third and subsequent years during the application phase, and every year after grant in the individual national states where the European patent continues after grant.

## Scope of rights

The scope of rights are determined by the wording of the patent document itself, in particular the patent claims.

Broadly speaking, a granted European patent gives the patent holder the right to prevent in the case of a product: manufacture, disposing of, offering to dispose of, using, importing a product, keeping a product for disposal or otherwise, or in the case of a process, disposing of, offering to dispose of, using any product of the process, keeping any such product of the process whether for disposal or otherwise, in each of the territories where the European patent is in force.

## Application procedure

European patent applications are filed at the European patent office. A full patent specification with formal drawings needs to be filed at the outset. If you already have the basic document from an earlier procedure, for example a US or UK national filing, that may be suitable with some amendment of the claims. Otherwise, a patent specification needs to be drafted, which will involve discussing technical details of the invention with the inventor in order to prepare the document ready for filing.

After filing, the European patent office performs a search of the invention and issues a search report citing prior art documents. It is usual for a European patent application to cite several relevant prior art documents. Often, the European patent office will also issue a search opinion, giving a preliminary opinion on the patentability of the claims as filed.

After search, the applicant has the opportunity to amend the claims in view of the prior art cited in the search report, if this is necessary.

Eighteen months from the earliest filing date or soon thereafter, the patent specification is published. At this stage, the contents of the specification are publicly available and can be viewed online.

Examination can be requested on filing, at the same time as requesting the search. Otherwise, within a maximum of two years from the filing date, substantive examination must be requested, and the examination fee paid.

The examining division of the European patent office normally issue an examination report which in most cases contains some observations on patentability which will require amendment of the claims and application. The applicant has a period of four months in which to respond to the examination report.

More than one examination report may issue, and at any time up until grant it is open for the examination division to find further prior art or make further observations.

Once the examining division is satisfied that the claimed invention is novel and contains an inventive step, the European patent office issues a communication setting out the text in which the European patent office intends to grant the patent. This must be responded to, and at the same time translations of the claims into the two other official languages of the European patent office must be filed (French and German if the application is filed in English). The application then proceeds through to grant within a few months thereafter.

According to EPO published figures, the average timescale from receiving an application to grant is around 44 months. However this period depends upon the field of technology and the workload of the examining division in those particular fields.

## After grant

Continuation of the European patent in a designated member state after grant is known as “validation” in that state.

Once granted, the European patent is immediately effective in each contracting State. However in order to continue with the rights, in some states further formalities must be attended to.

The current procedure at the end of the European patent is still fragmented on a state-by-state basis. However under the London Agreement on the application of article 65 EPC, a core set of states including CH Switzerland, DE Germany, FR France, GB United Kingdom, IE Republic of Ireland, LU Luxembourg, MC Monaco and MT Malta will accept the European patent without any significant further formalities. For some other states, for the rights to continue requires filing a set of claims translated into the national language of that state.

For yet other states, for example ES Spain and IT Italy, these states require a full translation of the whole document into the national language of that state.

Once the new Unitary Patent comes into force, most of the European Union will be included as a single designated territory, and the European patent will be able to be continued (validated) for most of the European Union in a single administrative procedure at the end of the European patent procedure.

## Enforcement of European patents

At the moment, generally speaking, a granted European patent gives the patent holder the same rights as would be granted to a national patent holder in the state designated in the European patent. Although obtaining the European patent is a centralised procedure, at the time of writing, no centralised procedure for enforcement of these rights in all designated states occurs. Enforcement is before the individual national courts and patent offices on a country by country basis.

Once the new Unitary Patent comes into effect, the system will be supplemented by a single enforcement procedure throughout the whole European Union before the Unified Patent Court.

## Third party opposition procedure

European patents are open to third-party oppositions after grant. Oppositions must be filed within nine months of the date of grant. The centralised opposition procedure before the European patent office allows third parties the opportunity to oppose the whole patent for all designated territories.

Third-party oppositions occur in around 5% of all European patents, and around 1 to 2% of European patents are successfully opposed.

Oppositions are typically filed on the grounds that the invention lacks novelty and/or inventive step, having regard to items of prior art which the European patent office have missed or which have not been raised during the application phase.

The outcomes of an opposition procedure can include:

- the opposition is rejected fully and the patent is maintained in amended form
- the opposition is partially successful, and the patent remains granted but in amended form; or
- the patent is shown to be totally invalid and is revoked in its entirety.

Since the basic European patent office search and examination procedure is quite rigorous and of a high standard, this means that most granted European patents have a high presumption of validity, and revoking the patent during opposition proceedings is difficult. Nevertheless, a small percentage of granted European patents are fully revoked as a

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result of opposition proceedings, in which case they are deemed to be invalid from the outset.

## Further advice

For further information, or to file a European patent application, please contact one of our European patent attorneys.

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