

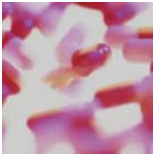
MARKS & CLERK

Intellectual Property

Patents

European and International
a short guide





European Patents

What is the European patent system?

The European patent system is a procedure by which a single patent application may be filed at the European Patent Office (EPO) under the European Patent Convention (EPC) to obtain patents in a number of European countries, e.g. UK, France and Germany. This procedure results in a number of individual national patents, each of which is enforceable before the appropriate national court (rather than a single European patent enforceable centrally in all countries).

When should a European patent be filed?

Generally (but not always) a European patent application is filed within a year of filing a British patent application directed to the invention. A British application is normally filed first as this is a less costly procedure and enables an assessment of the patentability and commercial viability of the invention to be made before a European application is filed. The European application must be filed within a year of the British application in order to be able to claim priority from the British application. If no such priority is claimed, the application must be filed before the invention is publicly disclosed.

What are the advantages of filing a European application?

The main reason for filing a European application is to obtain patent protection in a number of countries by means of a single application procedure, without it being necessary to file a separate national patent application in each country. This is achieved by designating countries in the European application.

How should I select the appropriate route to obtain European protection?

The three possible routines by which patent protection may be obtained in a number of European countries are

- 1) individual national patent applications
- 2) a European patent application
- 3) an International patent application designating a European patent (and other countries to be covered)

Which of these options should be followed in any particular case will depend upon individual circumstances and specialist professional advice should always be sought before a decision is made. An International application enables a large number of countries around the world to be covered for an initial assessment period before patent applications have to be filed in each country, and is therefore particularly suitable for more speculative applications or where it is desirable to delay the costs of individual national patent applications. A European application may be preferred over individual national applications in order to keep down the initial filing and prosecution costs.

The filing of individual national applications may be preferred over a European application to guard against the possibility of patent protection in all countries being lost in the event of the European application being unsuccessful.

What are the steps involved in prosecuting a European application?

The initial stages of a European patent application are similar to those of a British patent application. After the application has been filed, the EPO carried out a search through previously published documents to determine whether or not the invention is new and inventive. The application as filed is published approximately 18 months after the filing date or the priority date (which ever is earlier).

Provided that a request for examination is filed within six months of the date on which the search results are published, the application is then subject to an in-depth examination and, if any official objections are raised, these may be

dealt with by argument or amendment.

If the examination process is successfully negotiated, translations of the claims into the three official languages of the EPO i.e. English, French and German must be filed and a grant fee paid. The patent will then be granted by the EPO.

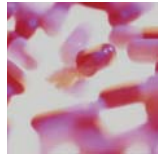
However the most important procedural difference between the European patent system and the British patent system is that anyone may file an opposition to grant of a patent on a European application within a nine month opposition period, and such an opposition, if successful, might lead to cancellation or amendment of the patent.

What steps must be taken to validate the granted European patent in the designated countries?

Most countries will require the full text of the granted European patent to be translated into their national language and a local patent attorney to be appointed as national representative, as well as possibly requiring payment of a national fee. Thereafter it will be necessary to pay annual renewal fees to the appropriate national patent office to maintain each patent in force.

Is there any way in which a single patent covering all these European countries can be obtained?

Not yet. However discussion are well advanced in relation to a so-called Community Patent System by which a single patent can be obtained which will be renewable and enforceable centrally. This system has been delayed by failure to agree issues such as whether and what translations of the granted European patent are to be required and in which courts the Community patents are to be enforced.



International Patent Applications

What is the International patent system?

The international patent system was established under Patent Cooperation Treaty (PCT) and is a procedure by which a single patent application may be filed to obtain initial patent protection in a large number of signatory countries, the most important of which are the European Patent Convention (EPC) countries, Japan and the USA.

However, it is important to appreciate that there is no such thing as an International patent, and that an International application must eventually be followed by the filing of national/regional applications covering the designated countries.

When should an International patent application be filed?

Generally an International patent application is filed within a year of filing a British patent application directed to the invention (instead of filing separate European and foreign applications at this stage). As with a European application, the International application must be filed within a year of the British application in order to be able to claim priority from the British application. If no such priority is claimed, the International application must be filed before the invention is publicly disclosed.

What are the advantages of filing such an application?

The main reason for filing an international application is to start the process of obtaining patent protection in a large number of countries by means of a single application procedure, without it being necessary to initially file a separate national patent application in each country. Thus an International application enables a large number of countries to be covered for an initial assessment period before individual national patent applications have to be filed, and is therefore particularly suitable for more speculative inventions where wide territorial protection is required for minimum initial cost.

How long does an International application remain in force?

An international application remains in force for only a limited period of time, after which it is necessary to continue protection by filing national applications (and/or a European application) covering the countries of interest. This period is 30/31 months from the filing date or the priority date (which ever is earlier), or alternatively only 20/21 months from this date for some countries when an International examination is not requested.

What are the steps involved in prosecuting an International application?

The initial stages of an International application are similar to those of a British or European application. After the application has been filed, the International Searching Authority carries out a search through previously published documents to determine whether or not the invention is new and inventive. The application as filed is published approximately 18 months after the filing date or the priority date (which ever is earlier).

Within 19 months from the filing date or priority date (which ever is earlier) an international Preliminary Examination can be requested. This is a non-binding examination carried out by an examiner at the EPO that gives an opinion on the allowability of the International application. During this procedure the applicant can submit arguments and amendments to convince the examiner to issue a favourable examination report.

The law regarding the national/regional phase deadline is currently in a state of flux. For some designated countries the next stage is the national/regional phase by 30/31 months after the filing date or priority date (which ever is earlier). However, for some countries the national phase deadline is 20/21 months after the filing date or priority date (which ever is earlier) if a request for an International Preliminary Examination has not been requested. If the International Preliminary

Examination has been requested, the deadline is extended for these countries to 30/31 months after the filing date or priority date (which ever is earlier).

The national phase requires the applicant to complete formalities required by each country in which they require to continue with patent protection. The regional phase refers to the formalities required for the International application to continue as a European application before the European Patent Office. At the national/regional phase the applicant can elect to abandon patent protection in some countries by not completing the required formalities for those countries.

Are the national applications resulting from such an International application equivalent to national applications filed in those countries in the first instance?

Yes, if the formalities required by the countries are completed. Where appropriate the application must be translated into the national language and each application proceeds in a substantially similar manner to any national application filed directly at the relevant national patent office. Although the results of the International search and examination are taken account of during national processing, each national patent office will itself examine the application and may raise new official objections. Each national patent is then renewable and enforceable in precisely the same manner as any other patent granted in the country.

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* Managing Intellectual Property magazine surveys over 3000 intellectual property professionals worldwide.

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Intellectual Property

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UK OFFICES

LONDON

57-60 Lincoln's Inn Fields
London
WC2A 3LS
Tel: +44 (0)20 7400 3000
Fax: +44 (0)20 7404 4910
Email: admin@marks-clerk.com

BIRMINGHAM

Alpha Tower
Suffolk Street
Queensway
Birmingham
B1 1TT
Tel: +44 (0)121 643 5881
Fax: +44 (0)121 606 4766
Email: birmingham@marks-clerk.com

BRISTOL

Aztec Centre
Aztec West
Almondsbury
Bristol
BS32 4TD
Tel: +44 (0)1454 203402
Fax: +44 (0)1242 579383
Email: bristol@marks-clerk.com

CAMBRIDGE

Wellington House
East Road
Cambridge
CB1 1BH
Tel: +44 (0)1223 451038
Fax: +44 (0)1223 451120
Email: cambridge@marks-clerk.com

CHELTENHAM

27 Imperial Square
Cheltenham
GL50 1RQ
Tel: +44 (0)1242 524520
Fax: +44 (0)1242 579383
Email: cheltenham@marks-clerk.com

COVENTRY

5 The Quadrant
Coventry
CV1 2EL
Tel: +44 (0)24 7622 2756 or 7145
Fax: +44 (0)24 7625 6197
Email: coventry@marks-clerk.com

LEEDS

43 Park Place
Leeds
LS1 2RY
Tel: +44 (0)113 389 5600
Fax: +44 (0)113 389 5601
Email: leeds@marks-clerk.com

LEICESTER

144 New Walk
Leicester
LE1 7JA
Tel: +44 (0)116 233 8181
Fax: +44 (0)116 233 0192
Email: leicester@marks-clerk.com

MANCHESTER

Sussex House
83-85 Mosley Street
Manchester
M2 3LG
Tel: +44 (0)161 236 2275
Fax: +44 (0)161 236 5846
Email: manchester@marks-clerk.com

NOTTINGHAM

Sutton Place
49 Stoney Street
Nottingham
NG1 1LX
Tel: +44 (0)115 924 2969
Fax: +44 (0)115 924 2968
Email: nottingham@marks-clerk.com

OXFORD

4220 Nash Court
Oxford Business Park South
Oxford
OX4 2RU
Tel: +44 (0)1865 397900
Fax: +44 (0)1865 397919
Email: oxford@marks-clerk.com

INTERNATIONAL OFFICES

ALICANTE

Edificio Carbonell
Explanada de España 1
Alicante 03002
España
Tel: +34 96 514 2727
Fax: +34 96 521 3048
Email: alicante@marks-clerk.com

HONG KONG

20/F Chinachem Hollywood Centre
1-13 Hollywood Road
Central
Hong Kong
Tel: +852 2526 6345
Fax: +852 2810 0791
Email: general@marksclerk.com

LUXEMBOURG

6 Rue Glesener
SP 1775
Luxembourg
L1017
Tel: +352 40 02 70
Fax: +352 40 04 96
Email: luxembourg@marks-clerk.com

MUNICH

8000 München 2,
Alzheimer Eck 2,
Deutschland

OTTAWA

280 Slater Street
Suite 1800
Ottawa
Ontario
Canada K1P 1C2
Tel: +613 236 9561
Fax: +613 230 8821
Email: ottawa@marks-clerk.com

TORONTO

350 Burnhamthorpe Road West
Suite 402
Mississauga
Ontario
Canada L5B 3J1
Tel: +1 905 272 2252
Fax: +1 905 272 2557
Email: toronto@marks-clerk.com

Website: www.marks-clerk.com