

Life of a file

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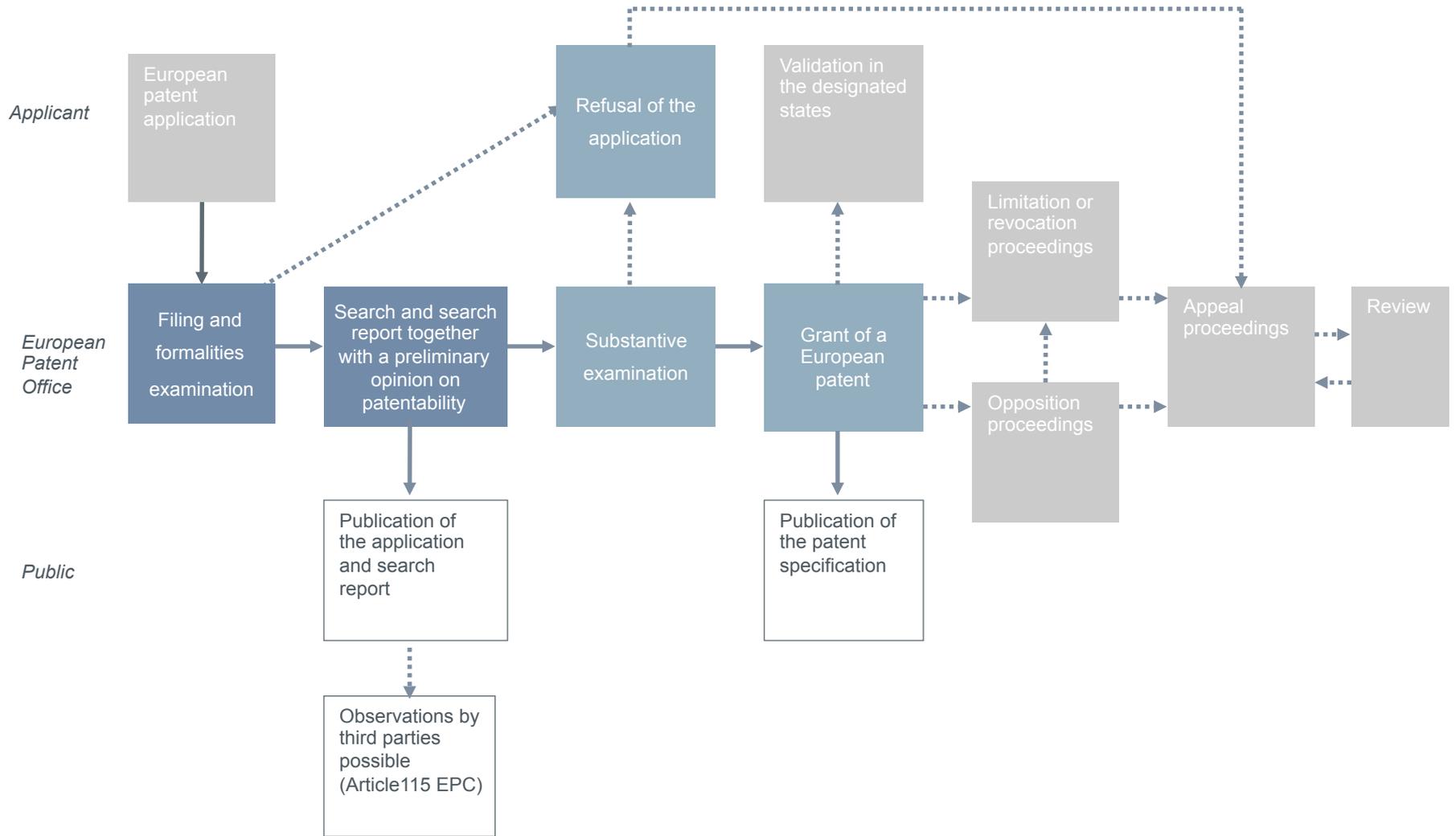
26-30/11/2012



Introduction

- This module describes what happens to applications in the European patent grant procedure.
- From filing through to grant and beyond, the file goes through a number of different stages.
- This presentation looks at these stages in the order in which they occur in the procedure.

The grant procedure at a glance



Overview – grant procedure

The procedure begins when an application for a European patent is filed with the EPO. During this **filing phase**:

- a date of filing is assigned
- formal requirements are checked

Once the application complies with the filing requirements, it enters the **search phase**, where:

- a search for prior art is performed
- a search report and a written opinion are issued

In the **examination phase** all the substantive issues relating to the application are assessed and the contents of the application are shaped into a form in which the patent can be granted ... or the application refused.

Overview – post-grant procedures

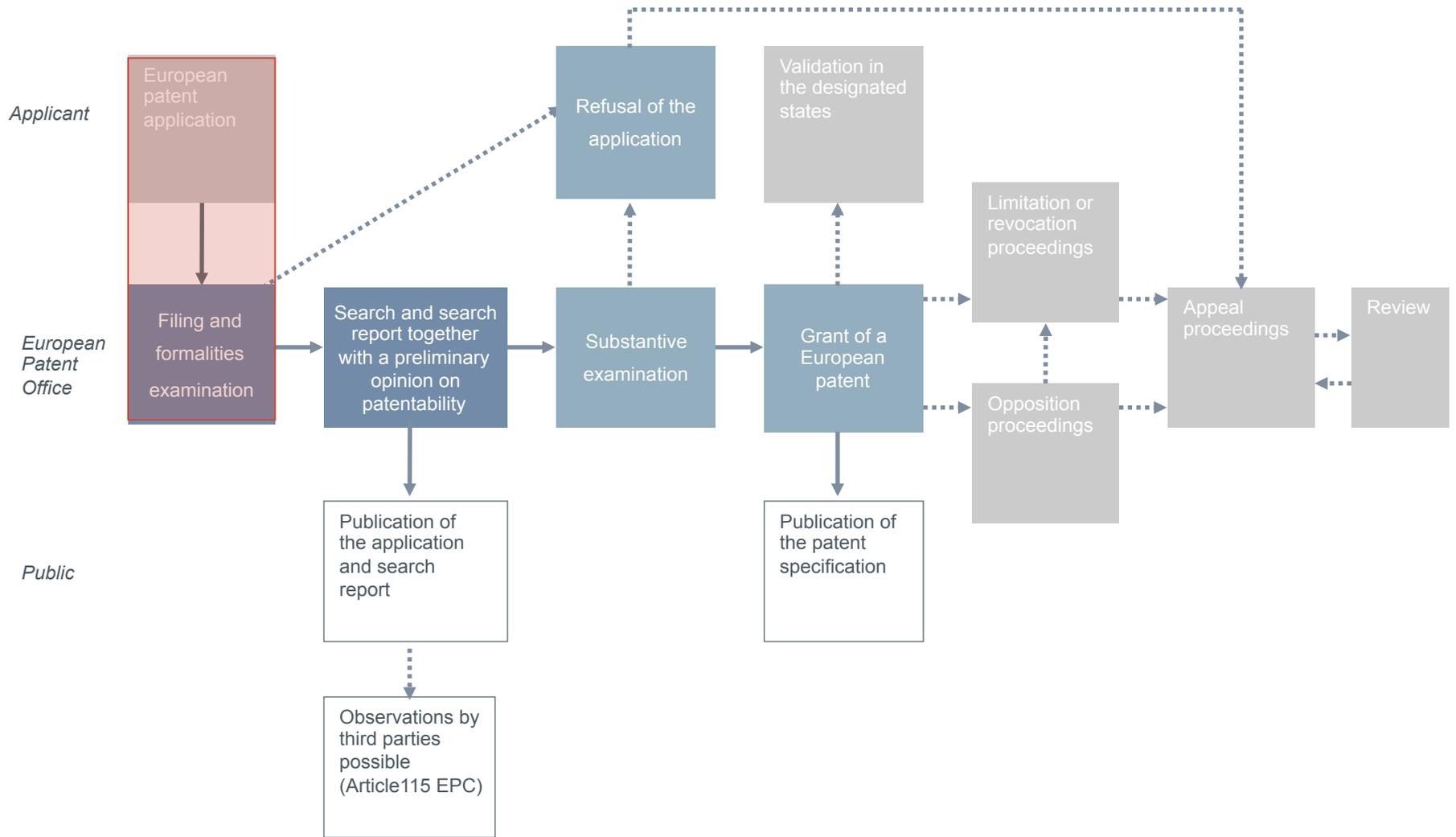
The post-grant procedures are:

- **Opposition** - where third parties may contest a granted patent
- **Revocation** and limitation - where patent proprietors may revoke their own patent or limit its scope
- **Appeal** - every adverse decision is subject to appeal, to guarantee a two-instance procedure

The grant procedure step-by-step

- You have just seen an overview of the grant procedure.
- We will now have a look at the individual stages in the procedure in more detail.

The grant procedure at a glance



Filing a patent application

- The first step is for the applicant to file a request for grant of a European patent.
- The application must be accompanied by the required documentation.
- Applications may be filed online.

Filing a patent application

- Where? EPO (Munich, The Hague, Berlin) ([Art. 75 \(1\)a EPC](#))
National Patent Offices ([Art. 75 \(1\) b](#)) and [77 EPC](#))
PCT ([Art. 150 et seq. EPC](#))
- How? Post ([R. 35 EPC](#))
Fax
EPO online services
- Who? Inventor/applicant ([Art. 60 \(1\) und \(3\) EPC](#))

Online filing



2000

The introduction of the EPO's electronic *epoline* service allows applicants to file **patent applications** via the internet.

Online fee payment and file inspection follow in 2002.

The online filing of **oppositions** and **appeals** is introduced in March 2009.

Date of filing

- The date of filing is crucial because:
 - it determines the state of the art
 - it must be within the priority year if priority is claimed
 - many deadlines depend on this date
- For applicants it is therefore essential to acquire a date of filing.
- The requirements are laid out in [R. 40 EPC](#).
 - indication that a European patent is sought
 - identification of the applicant
 - description or reference to a previously filed application
- For a date of filing to be accorded, the application may be filed in any language. No claims, fees or declaration of priority are necessary at this point ...

... but they will be required later!

Date of filing

- The application as originally filed will define any amendments to come.
- The application as originally filed consists of the documentation present at the date of filing
- This has impact on subsequent phases: search and examination may be restricted to the original scope of protection sought.

Formalities examination

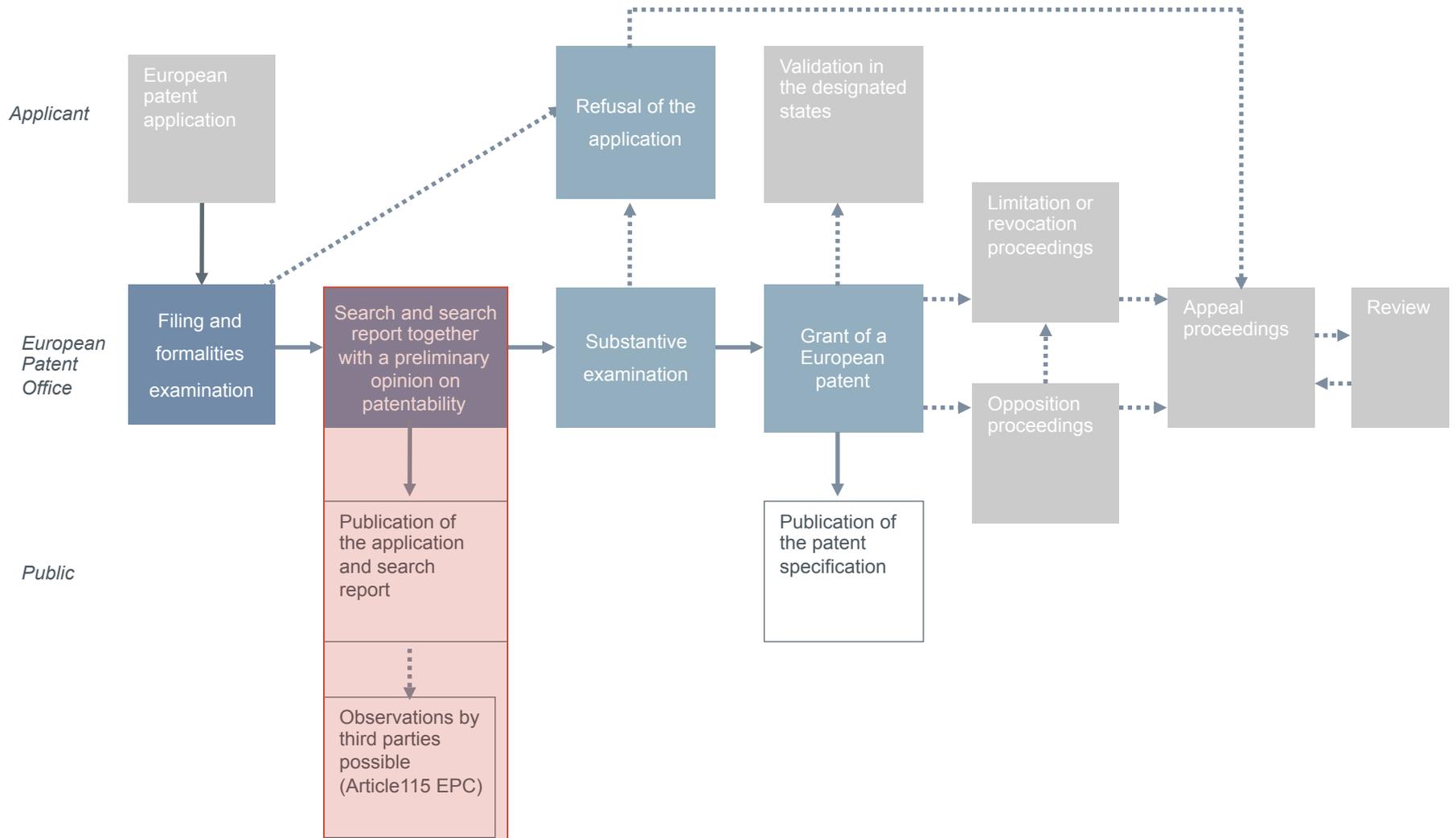
- Once the date of filing is accorded, the file must be complete.
- The following aspects are examined for compliance (R. 57 EPC):
 - Translation of the application (Art. 14)
 - Request for grant of a European (R. 41 EPC)
 - One or more claims (Art. 78)
 - An abstract (Art. 78)
 - Filing fee (additional fee for the 36th and subsequent pages) and the search fee paid (R. 17(2), 36(3), 38 EPC)
 - Designation of the inventor (R. 19(1))
 - Claim to priority (R. 52, 53 EPC)
 - Representation (Art 133(2) EPC)
 - Formal requirements (R. 46, 49 EPC)
 - Nucleotide or amino acid sequences

File constitution

- If all the information is present, a paper copy of the file is printed, containing at least:
 - a description
 - claims
 - drawings (where available)

- Different codes are assigned depending on whether the application
 - is a first filing, i.e. without any priority claim
 - claims priority from a previous application
 - is entering the European phase after the Patent Cooperation Treaty phase

The grant procedure at a glance



Search

Purpose of the search ([Art. 92 EPC](#))

- To discover the state of the art at the relevant date.
- To prepare for substantive examination and to determine whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step.

Search documentation

- Internal and external documents
- Patent and non-patent literature

Search phase

- The outcome of the search phase is:
 - a search report listing the relevant prior art ([Art. 92, R. 61 EPC](#)) an opinion on whether the application and the invention to which it relates meet the requirements of the EPC ([R. 62\(1\) EPC](#))
- The combination of these two documents is known as the extended European search report ([R. 62 EPC](#)).

European search report

The search report includes the citations of relevant documents.

Categories are assigned (X, Y, ...) to indicate the relevance and type of citation.

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	GB 1 203 328 A (TREVOR JOHN FRANKLIN) 26 August 1970 (1970-08-26) example 1 ---	1,2,6-10
X	WO 94 12184 A (SYNTEX INC) 9 June 1994 (1994-06-09) examples 1,2 ---	1,10
X	US 5 688 529 A (HEGDE SAYEE GOJANAN ET AL) 18 November 1997 (1997-11-18) abstract ---	1,7,10
Y	WO 97 38689 A (HAEBERLIN BARBARA ;CIBA GEIGY AG (CH); MAK CHING PONG (CH); MEINZE) 23 October 1997 (1997-10-23) cited in the application example 1 --- -/--	1-10

The opinion provides a written analysis of the patentability of the application, based on the cited documents.

1 The following documents are referred to in this communication:
D1 : US 6 243 026 B1 (JUDGE KEVIN ET AL) 5 June 2001 (2001-06-05)

Clarity

2. The present application refers to a traffic signal priority system, although the wording of claim 1 is such that tries to encompass a generic entry/exit control system. This however is not in line with the description, page 3, lines 3-5, where it is clearly stated that the invention directs to a traffic signal priority system. As such will be the claimed invention understood in the following (Art. 84 EPC). The applicant is reminded that the full scope of the claims must be supported by the

3 Independent claims

3.1 The present application does not meet the criteria of Article 52(2) EPC because the subject-matter of claim 1 is not new in the sense of Article 54(1) and (2) EPC.

Document D1 discloses (the references in parenthesis applying to this document):

A mobile event triggering method, comprising
 detecting an entry of a vehicle into a defined event location (D1, col. 14, line 53)
 evaluating a vehicle status with respect to at least one entry criterion (col. 14, line 53)
 conducting an event entry action when the vehicle status meets said at least one entry criterion (D1, col. 14, line 55; lines 26-28)
 evaluating the vehicle status with respect to at least one mobile event criterion corresponding to at least one mobile event
 activating said at least one mobile event when the vehicle status meets said at least one mobile event criterion corresponding to said at least one mobile event

Publication

- Patent applications are published around 18 months from the date of filing or priority.
 - These documents are known as A publications ([Art. 93 EPC](#)).
- Publication makes the contents of the application available to the public. It also
 - provides provisional protection ([Art. 67 EPC](#));
 - enables third parties to submit observations ([Art. 115 EPC](#));
 - forms part of the state of the art ([Art. 54\(2\)](#)).

Publication of the application

- If it is ready, the European search report may be published together with the application.

- If it is not ready, the application is published without it, and the search report is published separately.
 - They can both be found in the [publication server](#).

- The opinion is not published together with the search report ([R. 62 EPC](#)) ...
 - ... but it is made available to the public as part of the written procedure via [online](#) file inspection.

(19) 
 Europäisches Patentamt
 European Patent Office
 Office européen des brevets



(11) EP 0 797 950 A1

(12) EUROPEAN PATENT APPLICATION

(43) Date of publication: 01.10.1997 Bulletin 1997/40 (51) Int Cl. #: A61B 5/042

(21) Application number: 97400666.0

(22) Date of filing: 25.03.1997

(84) Designated Contracting States: BE DE FR GB IT NL SE	(72) Inventor: Ouchi, Teruhiko Tokyo (JP)
(30) Priority: 25.03.1996 JP 67653/96	(74) Representative: Joly, Jean-Jacques et al Cabinet Beau de Loménie 168, rue de l'Université 75340 Paris Cédex 07 (FR)
(71) Applicant: TERUMO KABUSHIKI KAISHA Tokyo (JP)	

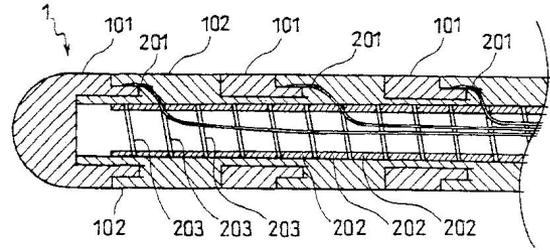
(54) Electrode catheter

(57) The electrode catheter comprises a metal inner tube (202) with distal and proximal ends and an outer tube (102) formed of a synthetic resin so as to cover the outside surface of said inner tube (202). The inner tube (202) has a helical slit (203) formed from the distal end to a predetermined position. One or more insulated wires (201) are laid inside the inner tube (202) from the proximal end to the distal end portion, and one or more electrodes (101) are disposed on the outer tube. The

wires (201) are brought out of the inner tube (202) through the slit (203) and are connected to the electrodes (101).

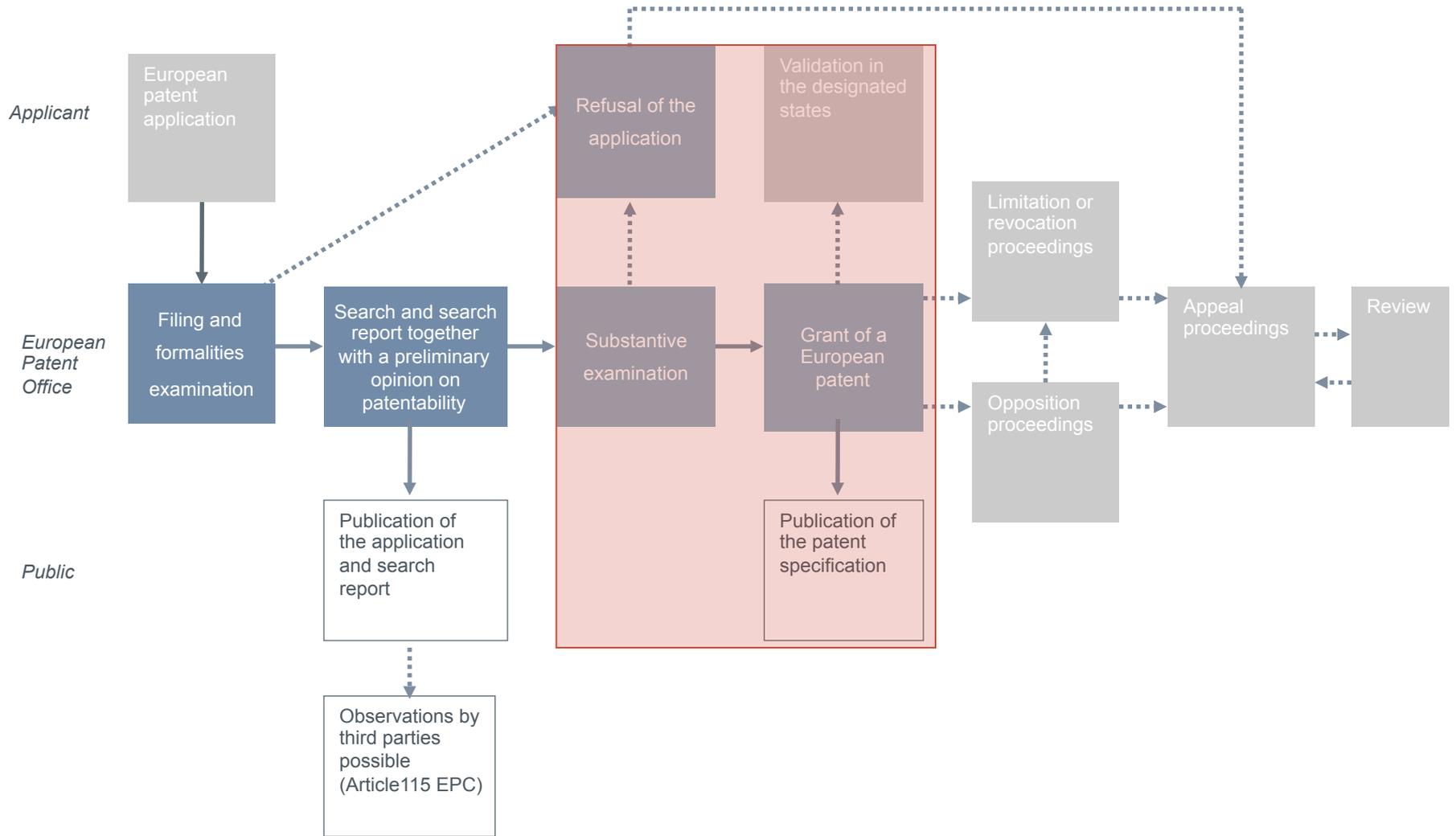
The electrode catheter has a high pushability and torque-transmission capability along with a high flexibility and kink resistance. It can be easily inserted into a desired position of complexly branched thin blood vessels without kink or breakage of the wires caused by collapse of the lumen.

FIG.2



EP 0 797 950 A1

The grant procedure at a glance



Substantive examination

- For an application to be granted, all the requirements of the EPC must be met ([Art. 97 EPC](#)).
- The applicant may request examination up to six months after the mention of publication of the search report ([R. 70 EPC](#)).

The examining division

- The examining division consists of three members ([Art. 18 EPC](#)).
- Each decision is the responsibility of the division as a whole.
- Examination is an ex-parte procedure in which only the applicant is involved.
 - Third parties may only submit observations



Substantive examination

- Substantive examination mainly deals with how the invention is disclosed and defined:
 - Clear definition of the protection sought ([Art. 84 EPC](#)).
 - Sufficient disclosure of the invention ([Art. 83 EPC](#)).
 - Unity of invention ([Art. 82 EPC](#)).

- A patent may be granted for an invention which
 - is new ([Art. 54 EPC](#)),
 - involves an inventive step ([Art. 56 EPC](#)),
 - has industrial applicability ([Art. 57 EPC](#)),
 - ...and is not excluded from patentability ([Art. 52-53 EPC](#)).

Substantive examination

- These requirements are examined using the cited prior art as documentation to back up the arguments.
- All objections raised must be reasoned and supported by evidence.
- Examination cannot therefore take place until after the search phase has been completed.

Final outcome

- **The application meets the requirements of the EPC:**
 - + translation of the claims
 - + payment of grant and publishing fees
 - ➔ **grant**
 - Opposition period begins
 - Administration goes over to the national offices (+ "Validation")

- **The application does not meet the requirements of the EPC:**
 - ➔ **refusal**
 - Adverse decision may be appealed.

Publication of the European patent

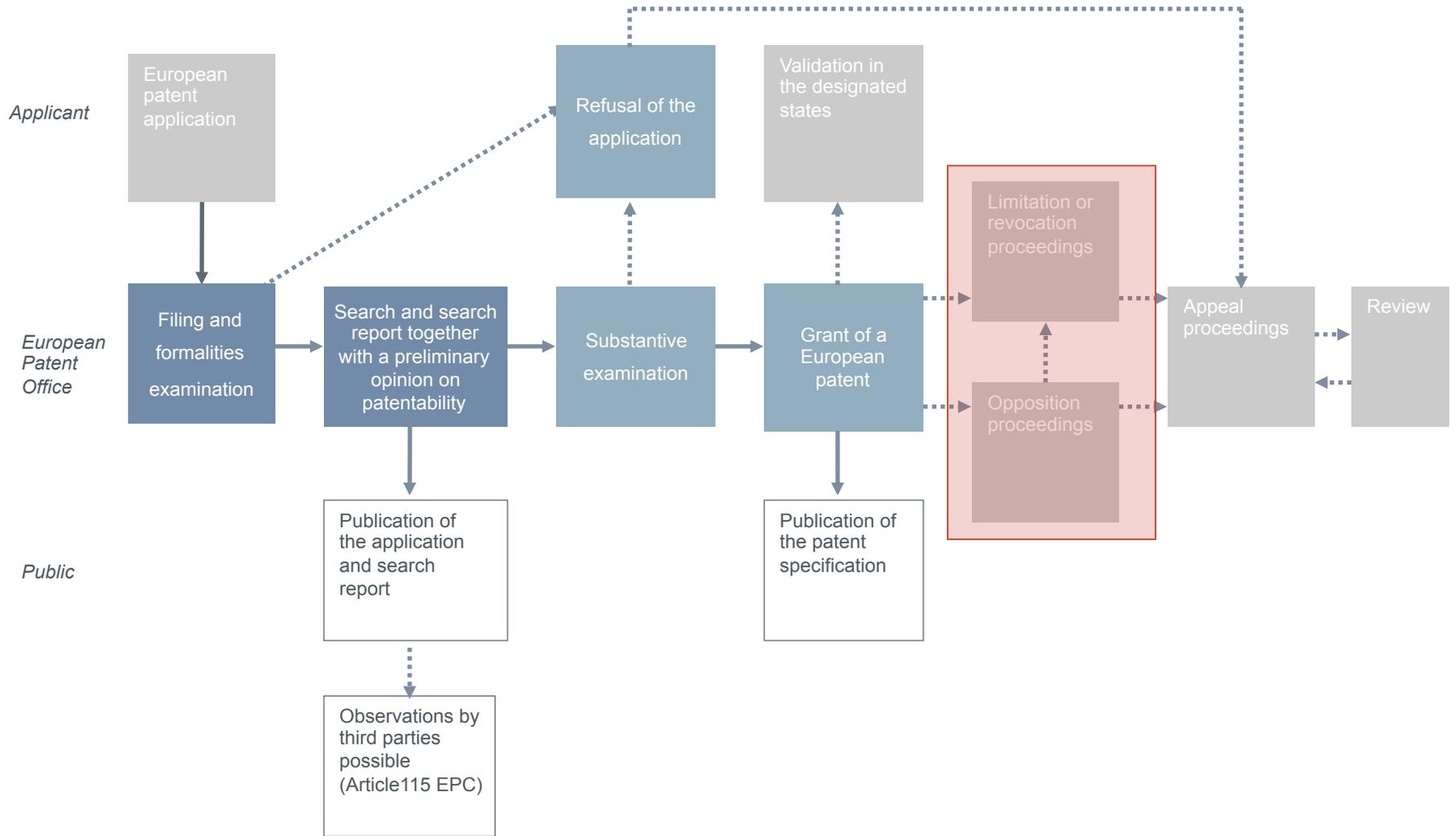
- Granted European patents are published after the examination procedure.
 - These documents are known as B publications ([Art. 98 EPC](#)).

- Publication of the specification informs the public and
 - defines the granted exclusive right ([Art. 64 EPC](#))
 - enables the opposition procedure ([Art. 99 EPC](#))

(19) 		 (11) EP 1 796 454 B1								
	EUROPÄISCHE PATENTSCHRIFT									
(45) Veröffentlichungstag und Bekanntmachung des Hinweises auf die Patenterteilung: 10.09.2008 Patentblatt 2008/37	(51) Int. Cl.: A01D 41/14 (2006.01)	(86) Internationale Anmeldenummer: PCT/EP2006/050344								
(21) Anmeldenummer: 06704260.6	(87) Internationale Veröffentlichungsnummer: WO 2006/079609 (03.08.2006 Gazette 2006/31)									
(22) Anmeldetag: 20.01.2006										
(54) ERNTEGERÄT, INSBESONDERE ERNTEVORSATZ FÜR LANDWIRTSCHAFTLICHE ERNTEMASCHINEN ZUM AUFNEHMEN UND WEITERFÖRDERN VON HALMFRÜCHTEN HARVESTING EQUIPMENT, IN PARTICULAR HARVESTING ATTACHMENT FOR AGRICULTURAL HARVESTING MACHINES USED TO GATHER AND TRANSPORT CEREALS APPAREIL DE RECOLTE, EN PARTICULIER ACCESSOIRE DE RECOLTE POUR DES MACHINES DE RECOLTE AGRICOLES, SERVANT A CUEILLIR ET TRANSPORTER DES CEREALES										
(84) Benannte Vertragsstaaten: AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HU IE IS IT LI LT LU LV MC NL PL PT RO SE SI SK TR										
(30) Priorität: 29.01.2005 DE 102005004211	(74) Vertreter: Holst, Sönke Deere & Company European Office Global Intellectual Property Services John-Deere-Strasse 70 68163 Mannheim (DE)	<ul style="list-style-type: none"> • SCHULZE HOCKENBECK, Leo 48351 Everswinkel (DE) • WEITENBERG, Clemens 46325 Borken (DE) 								
(43) Veröffentlichungstag der Anmeldung: 20.06.2007 Patentblatt 2007/25	(73) Patentinhaber: Maschinenfabrik Kemper GmbH & Co. KG 48973 Stadtlohn (DE)	(56) Entgegenhaltungen: <table style="width: 100%; border: none;"> <tr> <td>EP-A- 1 685 755</td> <td>EP-A- 1 685 756</td> </tr> <tr> <td>DE-A-4102004 022 53</td> <td>DE-A1- 4 030 066</td> </tr> <tr> <td>DE-A1- 19 523 255</td> <td>FR-A- 2 814 324</td> </tr> <tr> <td>US-A- 4 355 690</td> <td>US-A- 5 934 382</td> </tr> </table>	EP-A- 1 685 755	EP-A- 1 685 756	DE-A-4102004 022 53	DE-A1- 4 030 066	DE-A1- 19 523 255	FR-A- 2 814 324	US-A- 4 355 690	US-A- 5 934 382
EP-A- 1 685 755	EP-A- 1 685 756									
DE-A-4102004 022 53	DE-A1- 4 030 066									
DE-A1- 19 523 255	FR-A- 2 814 324									
US-A- 4 355 690	US-A- 5 934 382									
(72) Erfinder: <ul style="list-style-type: none"> • RICKERT, Clemens 48703 Stadtlohn (DE) • HÜNING, Martin 48727 Billerbeck (DE) 										

EP 1 796 454 B1
 Anmerkung: Innerhalb von neun Monaten nach Bekanntmachung des Hinweises auf die Erteilung des europäischen Patents im Europäischen Patentblatt kann jedermann nach Maßgabe der Ausführungsordnung beim Europäischen Patentamt gegen dieses Patent Einspruch einlegen. Der Einspruch gilt erst als eingelegt, wenn die Einspruchsgebühr entrichtet worden ist. (Art. 99(1) Europäisches Patentübereinkommen).
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The grant procedure at a glance



Post-grant procedures

- After a European patent has been granted, three procedures may be initiated:
 - opposition
 - limitation
 - revocation

- These procedures may affect the patent as granted.

Opposition

- Any person may oppose a European patent within nine months of its publication.
- This procedure provides for a centralised possibility to rectify the grant of the patent.
- After the opposition period has expired, European patents may be only challenged in the individual countries in which they are valid.

Opposition

- A European patent may be opposed if according to the opponent:
 - the subject-matter of the claims is not new, inventive or industrially applicable ([Art. 100\(a\) EPC](#))
 - the subject-matter of the claims is excluded from patentability or is not regarded as an invention ([Art. 100\(a\) EPC](#));
 - the invention is not sufficiently disclosed ([Art. 100\(b\) EPC](#)); and/or
 - the granted patent goes beyond the original application as filed ([Art. 100\(c\) EPC](#)).

- New prior art may be submitted.

- Opposition procedures are independent of the examination procedure.

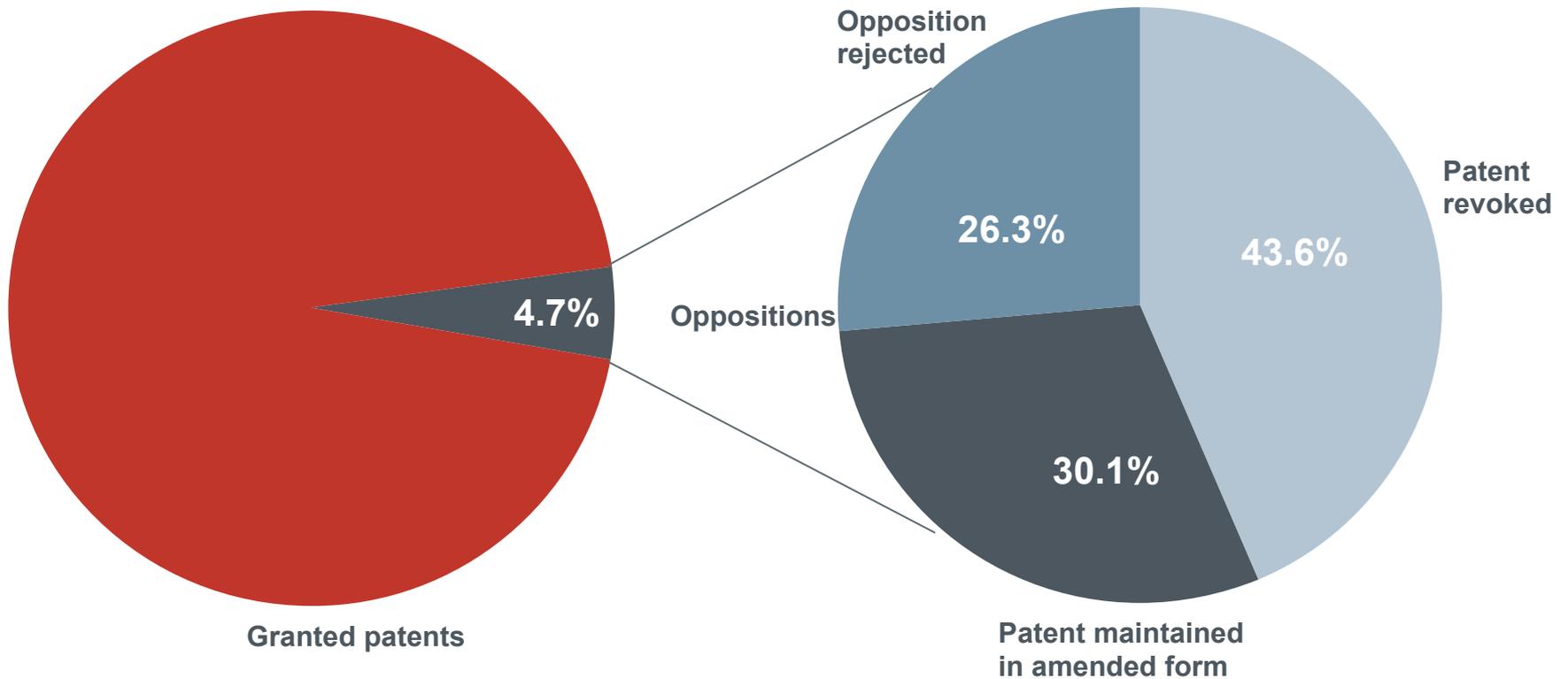
The opposition division

- The opposition division consists of three members ([Art. 19 EPC](#)).
- Each decision is the responsibility of the division as a whole.
- Opposition is an inter-partes procedure:
 - patent proprietor
 - opponent(s)



Oppositions in 2009

Oppositions were filed against 4.7% of all granted European patents. Over one third of all opposed patents were revoked.



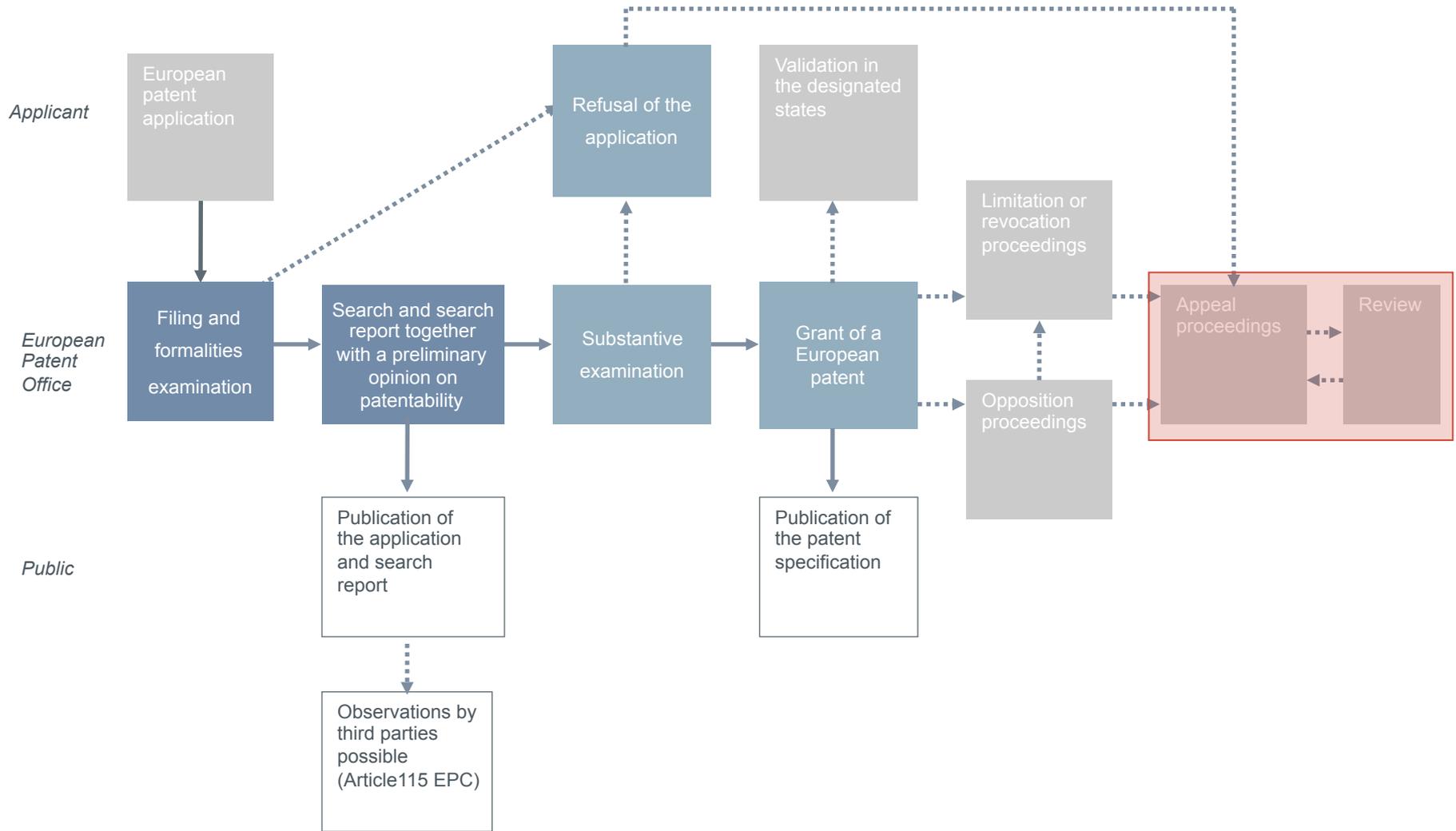
Limitation procedure ([Art. 105 a-c EPC](#))

- At any time after the grant the patent proprietor may request limitation of the patent by filing a new set of claims.
- The decision to limit the European patent takes effect on the date on which it is published in the Bulletin.
- The effect of the decision to limit the patent is that the patent is limited *ab initio* in all contracting states.
- Opposition proceedings have precedence ([R. 93 EPC](#)).

Revocation procedure ([Art. 105 a-c EPC](#))

- The patent proprietor may request revocation of the patent at any time after grant.
- The revocation applies *ab initio* to all contracting states in respect of which the patent was granted.

The grant procedure at a glance



Appeals

- Any adverse decision made by the EPO is subject to a two-instance procedure.
- The department of the first instance - for example, the Receiving Section, the examining division or the opposition division - may refuse an application or a request.
- The party adversely affected may appeal in the second instance.

Appeal procedure

The boards of appeal

- The EPO's **legal boards of appeal** and **technical boards of appeal** give independent final rulings on appeals against decisions taken during grant and opposition proceedings. They can exercise any power within the competence of the department responsible of the decision appealed or remit the case to that department for further prosecution ([Art. 106-111 EPC](#)).

Appeal procedure

The Enlarged Board of Appeal

- The **Enlarged Board of Appeal** issues decisions and opinions on cases referred to it, either to ensure uniform application of the law or to rule on a point of law of fundamental importance ([Art. 112 EPC](#)). These cases are referred
 - either by the boards of appeal
 - or by the President (where two boards have given different decisions)
- It also gives decisions on petitions for review of the decisions of the boards of appeal ([Art. 112a EPC](#)).

Conclusion

The procedure starts with the filing of the documents that form the European application. Once this has occurred:

- a search is carried out
- an examination is conducted
- and a decision is taken.

This decision may later be

- opposed
- limited
- revoked
- appealed