

*Intellectual Property
International Series*

Guide to European Patents

by Andrew Rudge

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Dedication

To those whom I love best:
Wendy, Emma and Millie

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About the Author

Andrew Rudge is British and first trained to be a synthetic organic chemist, obtaining a first degree in Natural Sciences and a PhD in the synthesis of polyhydroxylated alkaloids, both from Cambridge University. He worked as a medicinal chemist in the pharmaceutical industry for five years before moving into patents and qualifying as a European Patent Attorney and a Chartered Patent Attorney (UK) in 2004. Since qualification Andrew has been very active in the field of education. He has co-authored 'A Complete Guide to Passing the European Qualifying Exam' (published by Sweet and Maxwell) which aims to provide comprehensive guidance for students both preparing for and taking the European Qualifying Exam in order to qualify as a European patent attorney. He teaches European patent law in London and Strasbourg for CEIPI (part of the University of Strasbourg) and has lectured on patent law at the CEELI institute in Prague.

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Preface

The continent of Europe consists of about 48 countries with a combined population of over 700 million people and a gross domestic product of about \$13 trillion. For any global, innovation-based company, obtaining strong patent protection across this large market is of obvious importance. Europe has always been at the forefront of the developing international patent system and in the twentieth century it addressed the challenge of increasing harmonisation in the context of tremendous diversity of language and legal tradition. The unique solution which was developed, a regional patent-granting body called the European Patent Office (EPO), has proved to be a great success. The EPO, which operates alongside national patent offices, grants a single patent which can be registered in up to 40 European countries (38 Contracting States and two Extension States) and is increasingly the forum of choice for those seeking patent protection in Europe.

The law under which the EPO practices, laid out in the European Patent Convention and associated texts, is strikingly different in many respects from US patent law. Some subject matter, such as a pure business method, is simply not patentable in Europe; other subject matter, such as a method of treatment, requires very specific redrafting in order to be patentable; and the first-to-file system has very important consequences in terms of the way novelty is judged and the extent to which an applicant can amend during prosecution. These important considerations, and others, create traps for the unwary foreign applicant which can severely limit the scope of protection obtainable in Europe.

This book guides the non-European applicant through the important steps of drafting, filing and prosecuting a European application, pointing out where pitfalls may arise and helping the applicant to avoid them. The first section introduces the patent system operated by the EPO and points out some of the most important ways in which it differs from the US patent system. The second section covers the requirements of a European patent application

and the invention which it seeks to protect and shows how an application can best be drafted in order to maximise its chances of success at the EPO. There are many requirements which need to be met from the outset and which will be difficult or impossible to remedy at a later stage. The last section explains in detail the procedure during grant, opposition, limitation and appeal proceedings before the EPO, explaining the procedural options available to the applicant and their consequences.

I have based the advice in this book on my own experience of prosecuting US-origin applications at the EPO, especially those which were never drafted to be road-worthy for their journey through the EPO. Many of these applications never complete the journey and those that do limp over the finishing line are often in a pretty poor state and not well suited for enforcement. The aim of this book is to equip U.S. applicants with the right knowledge and tools to avoid such disasters so that they can obtain European patents of a quality merited by their inventions.

Andrew Rudge
Walmer, January 2013

Glossary of referenced texts

EPC means EPC2000

EPC1973 means the European Patent Convention of 05 October 1973, as amended by the Revision Act of 17 December 1991 and Administrative Council decisions of 21 Dec 1978, 13 Dec 1994, 20 Oct 1995, 05 Dec 1996, 10 Dec 1998 and 27 Oct 2005 (and its Implementing Regulations)

EPC2000 means the European Patent Convention as amended by the Revision Act of 29 November 2000 (and its Implementing Regulations)

Guidelines means Guidelines for Examination in the European Patent Office and may be consulted at <http://www.epo.org/law-practice/legal-texts/guidelines.html>

Gxxxx/yy means Enlarged Board of Appeal decision No.xxxx of year yy the text of which may be found on the EPO Web site at <http://www.epo.org/law-practice/case-law-appeals/search.html>

Jxxxx/yy means Legal Board of Appeal decision No.xxxx of year yy the text of which may be found on the EPO Web site at <http://www.epo.org/law-practice/case-law-appeals/search.html>

NatLaw means National Law relating to the EPC which is collated by the EPO and available at <http://www.epo.org/law-practice/legal-texts/national-law.html>

[yyyy] O.J. xx means Official Journal of the EPO, year yyyy, page xx which may be consulted at <http://www.epo.org/law-practice/legal-texts/official-journal.html>

PCT means the Patent Cooperation Treaty of 19 June 1970, as amended on 28 Sept 1979 and modified on 03 Feb 1984 and 03 Oct 2001 (and its Regulations)

RPBA means Rules of Procedure of the Boards of Appeal which may be consulted at <http://www.epo.org/patents/appeals.html>

RRF means Rules relating to Fees

Txxxx/yy means Technical Board of Appeal decision No.xxxx of year yy the text of which may be found on the EPO Web site at <http://www.epo.org/law-practice/case-law-appeals/search.html>

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