

The European Patent Convention

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Recommended Citation

The European Patent Convention, 3 Md. J. Int'l L. 408 (1978).

Available at: <http://digitalcommons.law.umaryland.edu/mjil/vol3/iss2/10>

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THE EUROPEAN PATENT CONVENTION

The European Patent Convention¹ (EPC) is an attempt to simplify European patent law. The Convention provides a procedure for securing a single, European patent,² which has the effect of a national patent in the signatory nations designated in the application. Through this alternative to national procedures, widespread patent coverage should be easier to obtain. Requirements for a European patent, however, are rigorous and its attraction is primarily the consolidation of the grant procedures.³

The EPC establishes several organs to handle the various aspects of the patent application procedure. The European Patent Office (EPO), located in Munich, is the international equivalent of a national patent office. Its administrative divisions are the General Search Division, the Examining Division, and the Opposition Division. The Receiving Section is at The Hague.

The first procedural step is the filing of an application at either a national patent office or directly with the EPO.⁴ The application may be in any of the three official languages (English, French, or German) and the applicant's choice becomes the language of the proceedings.⁵ The Receiving Section subjects the application to both a preliminary⁶ and a supplementary formal examination to determine whether it is in proper form and all fees are paid.⁷ If all is in order, the application is forwarded to the General Search Division.

1. Convention on the Grant of European Patents, October 5, 1973, 13 INT'L LEGAL MATS. 268 (1974) [hereinafter cited as EPC]. The convention is in force for Belgium, Federal Republic of Germany, France, Luxembourg, Netherlands, Switzerland and United Kingdom. Austria, Denmark, Greece, Ireland, Italy, Lichtenstein, Monaco, Norway, and Sweden have also signed but had not ratified by October 7, 1977, the date the EPC entered into force.

2. *Id.*, art. 58. A European patent is available to any natural or legal person.

3. "Grant procedure" refers to the entire application procedure, from the filing of an application through receipt of the patent.

4. EPC, *supra* note 1, art. 75(1)(a) and (b).

5. *Id.*, art. 14(3).

6. *Id.*, art. 90.

7. *Id.*, art. 91. The supplementary formal examination determines whether an agent has been designated, an abstract is attached, the inventor is named and drawings are included. The application is also checked for possible priority claims based on previously filed national applications.

The General Search Division conducts a search to determine the prior state of the art.⁸ This produces the technical report upon which the grant of a European patent is based and provides the applicant with a preview of how the Examining Division will treat his application. The applicant may then withdraw or seek to amend his application, limit his statement of claims, or proceed without change.⁹ Regardless of the form in which the applicant elects to proceed, he must file a request for examination with the Examining Division.¹⁰

The Examining Division evaluates the application using three criteria:¹¹ 1) An invention must be susceptible to industrial application; 2) it must be novel; 3) it must involve an inventive step. The Examining Division then informs the applicant whether and, if so, on what conditions the patent will be granted. If the terms are acceptable to the applicant, he then has three months to accept the patent.¹² Translation of the patent and related materials into the other two official languages is required at this time.¹³ The patent is then provisionally granted and notice is given by publication of a reference to the grant.

Following publication, the EPC provides a nine month period during which anyone may file an opposition to the grant.¹⁴ The Opposition Division reviews such challenges.¹⁵ If no one files an

8. *Id.*, art. 92.

9. *Id.*, art. 96(1) and Implementing Regulations to the Convention on the Grant of European Patents, 13 INT'L LEGAL MATS. 312, 328-9, (1974), Rule 51(1) [hereinafter cited as Regs.]. See also, K. Hoffman, Introduction Into the European Patent System 6 (July 1977) [hereinafter cited as Hoffman Memorandum] (memorandum prepared for the law firm of Hoffman, Eitle and Partner, Munich, West Germany; on file with the law firm of Sughrue, Rothwell, Zinn, Mion and MacPeak, Washington, D.C.).

10. EPC, *supra* note 1, art. 94(1). Such request must be accompanied by payment of an examination fee and made within six months after publication of the search report. *Id.*, art. 94.

11. *Id.*, art. 52(1). See also, art. 54 (Novelty), art. 56 (Inventive Step), and art. 57 (Industrial Application).

12. *Id.*, art. 97(2)(a).

13. *Id.*, art. 97(5) and Regs. *supra*, note 8, Rule 51(4).

14. *Id.*, art. 99(1).

15. Grounds for challenging the grant are lack of patentability, insufficiency of description, and new material introduced during examination. The opposition procedure involves an examination in which the patentee submits arguments and amendments (where appropriate) and opponents may respond. THE CHARTERED INSTITUTE OF PATENT AGENTS, PATENTS IN EUROPE 8 (February, 1976). See also, EPC, *supra* note 1, arts. 99-102.

opposition, or if the applicant successfully defends the grant, the EPO issues a full-fledged European patent, valid in accordance with national law in those countries designated in the original application.¹⁶

It should be noted that there are two other patent treaties closely related to the EPC — the Patent Cooperation Treaty (PCT)¹⁷ and the Community Patent Convention (CPC).¹⁸ The PCT is aimed at worldwide application.¹⁹ The PCT transforms a single international filing into a number of national filings, each of which is accompanied by a search report prepared by the International Searching Authority.²⁰ National patent offices then act on it. For these purposes the European Patent Office is considered a national patent office.²¹ Therefore, both foreign national patent procedures and the European patent procedure can be initiated by a PCT filing.²²

The CPC creates a truly unitary patent by providing the governing law after grant. Included are rules relating to the patent's validity, rights conferred by the patent, and the law for enforcing those rights. In contrast, the EPC creates the hybrid "European patent," which is granted according to EPC procedure, but its validity and the holder's rights under it are determined by national law. The two treaties are related, however, in that the CPC incorporates the grant procedure of the EPC.²³

16. A Board of Appeal is available for review of adverse decisions. See EPC, *supra* note 1, arts. 106-112.

17. The Patent Cooperation Treaty, June 19, 1970, 9 INT'L LEGAL MATS. 978 [hereinafter cited as PCT]. The PCT entered into force on January 24, 1978.

18. Convention for the European Patent for the Common Market, December 15, 1975, 19 O. J. Eur. Comm. (L17) (1976) [hereinafter cited as CPC]. The CPC has not yet entered into force.

19. The PCT is available, however, only to the residents and nationals of the contracting states. Art. 9(1) (subject to the exceptions in art. 9(2)). See New International Legislations Concerning Patents for Invention [sic], 2 C L Newsletter 6 (October 1977) (unpublished newsletter from the French patent firm Cabinet Lavoix, on file with Sughrue, Rothwell, Mion, Zinn and MacPeak, Washington, D.C.).

20. PCT, *supra* note 17, art. 16.

21. EPC, *supra* note 1, art. 151(1).

22. *Id.*, art. 150(2). The PCT establishes receiving offices to accept the PCT filing, art. 3 and Regulations under the Patent Cooperation Treaty, 9 INT'L LEGAL MATS. 994, 1001, (1970) Rule 19(1)(a). The United States patent office is such a receiving office and it is anticipated that by the end of 1978, European patent applications will be accepted there.

23. CPC, *supra* note 18, art. 2(2), art. 3, art. 4.

As its name implies, the CPC is restricted to members of the European Economic Community (EEC).²⁴ Because the CPC establishes a unitary patent it cannot come into effect until all EEC members have ratified.²⁵ The Community patent will be valid in all EEC countries. For purposes of the CPC, the EEC is like a single nation and the Community patent is like a national patent and can only be issued for the whole. The CPC will not replace national patents or the newly created European patent, but will exist as an alternative to those procedures.

Flexibility appears to be the dominant theme for the future. The patent applicant may use a national, the EPC, or the CPC procedure. Furthermore, access to individual systems may be simplified by a PCT filing. The choice of the proper route will involve an appraisal of the applicant's own needs and the relative cost of each procedure. The EPC procedure (and the CPC by incorporation) will be lengthy and expensive. Various estimates have put the length of time required to secure a European patent at four to five years²⁶ while the approximate cost will probably approach 10,000 DM.²⁷ Balancing this against the time and expense of acquiring individual national applications, estimates indicate that the break-even point will be coverage in three countries.²⁸ This should become clearer as experience with the convention grows.

Another consideration is the relatively strict standards used in granting European patents. Requirements for some national patents amount to little more than registration.²⁹ Therefore, when limited protection is all that is required, the national procedures may be more attractive. But for large multinational corporations and others seeking to protect their technological interests on a broad scale, the European procedure should be preferable. Furthermore, experimentation with the EPC can best be undertaken by large corporations which have the continuing need for widespread patent coverage as well as the resources to carry out the experimentation.³⁰

24. The nine members of the European Economic Community are: Belgium, Denmark, France, Federal Republic of Germany, Ireland, Italy, Luxembourg, Netherlands and United Kingdom.

25. As of October 28, 1977, parliamentary approval for ratification of the Convention had occurred in Belgium, France and the United Kingdom.

26. C L Newsletter, *supra* note 19, at 6.

27. *Id.*

28. *Id.*

29. *Id.* The French National patent procedure is one example.

30. See Hoffman Memorandum, *supra* note 9, at 9.

Attention will focus on the EPO as the first European patent applications are accepted in June, 1978. The success of the European procedure will doubtlessly affect directly the future success of the CPC and related patent measures. The next five years will be a testing period in which to determine how effective these attempted simplifications can be.

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