

TABLE OF CONTENTS

Preface	xi
About the Author	xii
Acknowledgements	xiii
Abbreviations and Acronyms	xiv
Part A General Information	1
Chapter 1 Introduction	3
1.1 Pre-examination	3
1.2 Preparation	3
1.3 This book	4
1.4 How and what to study for the legal questions of the Pre-examination	4
1.4.1 Tables with key topics	4
1.4.2 Questions and answers	4
1.5 Pass rate	5
Chapter 2 Instructions to Candidates for Preparing Their Answers	6
2.1 General provisions	6
2.2 Pre-examination	6
2.3 Grading	7
2.4 Instructions for answering the Pre-examination paper	7
Chapter 3 Training Material	9
3.1 EPC	9
3.2 EPO Brochures	9
3.3 WIPO	10
3.4 PCT - EPO	10
3.5 Reference books	10
3.6 Questions and answers for the Pre-examination	10
Part B Study Programme, Time Schedule and Methodology	11
Chapter 1 Study Programme	13
Chapter 2 Time Schedule	16
Chapter 3 Methodology for answering legal questions at the Pre-Examination	18
3.1 Step 1: Get a picture of the situation	18
3.1.1 Keywords	18
3.1.2 Dates in questions	19
3.1.3 Example question	19
3.2 Step 2: Assess the situation	20
3.3 Step 3: Find the answer	20
3.3.1 Example question	21
3.4 Step 4: Answer True or False	22
3.5 Dealing with negative statements	23
Chapter 4 Time Management during the Pre-Examination	24
Part C Topics to Study for the Pre-examination	25
Chapter 1 General and Institutional Provisions; Languages and Representation	27
1.1 Interpretation of the EPC	27
1.2 Principles of the EPC	28
1.3 Institutional provisions	29

1.3.1	The European Patent Organisation	29
1.3.2	The European Patent Office	30
1.3.3	The Administrative Council	32
1.3.4	Financial provisions of the Organisation	32
1.3.5	Fees	33
1.4	Languages and translations	33
1.4.1	Languages of the EPO	33
1.4.2	Reduction of fees under the language arrangements	34
1.4.3	Language in written proceedings	35
1.4.4	Language in oral proceedings	36
1.5	Representation before the EPO	37
1.5.1	General principles of representation	37
1.5.2	Representation before the EPO	38
1.5.3	Authorisation of representative	39
1.5.4	Institute of professional representatives before the EPO	40
Chapter 2 Patentability: Inventions, Exceptions to Patentability and Medical Uses; State of the Art		41
2.1	Patentable and non-patentable inventions	41
2.2	Exceptions to patentability	41
2.3	Medical uses	43
2.4	Second non-medical use	43
2.5	Industrial application	43
2.6	State of the art	44
2.6.1	Availability of information to the public	44
2.6.2	Means of disclosure	44
2.6.3	Extent of disclosure	45
2.7	Content of a European patent application	45
2.8	European prior rights	46
2.9	Non-prejudicial disclosures	47
Chapter 3 Patentability: Novelty and Inventive Step		49
3.1	Novelty	49
3.2	Inventive step	51
Chapter 4 Unity of Invention, Disclosure and Claims; Right of Priority		55
4.1	Unity of invention	55
4.2	Disclosure	56
4.3	Claims	57
4.4	Right of priority in the EPC	60
4.4.1	Priority right	60
4.4.2	Claiming priority	62
4.4.3	Effect of priority right	65
4.4.4	Re-establishment of right of priority	65
4.5	Right of priority in the Paris Convention	66
4.5.1	National treatment and right of priority	66
4.5.2	Cross-references between provisions relating to priority in the EPC and the Paris Convention	67
4.6	Right of priority in the Patent Cooperation Treaty	68
4.6.1	Claiming priority	68
4.6.2	Priority document	68
4.6.3	Correction or addition of priority claim	69
4.6.4	Restoration of the right of priority	70
Chapter 5 Right to and Effect of the European Patent or Application; Information from the EPO		71
5.1	Right to the European patent	71
5.2	Entitlement proceedings	72

5.2.1	Applications where the applicant is not entitled	72
5.2.2	Applications where the patent proprietor is not entitled	73
5.3	Designation of the inventor	73
5.4	Rights conferred by a European patent and by an application	74
5.4.1	Effect of granted European patent	74
5.4.2	Protection conferred by a European patent application	75
5.5	Interpretation of the European patent	76
5.5.1	Extent of protection	76
5.5.2	Authentic text of a European patent application or European patent	77
5.6	Infringement and sanctions	77
5.7	Transfer and assignment of European patent applications and patents	78
5.8	Licences and other rights	78
5.9	The European patent application as an object of property	79
5.10	European Patent Register	79
5.11	File inspection	80
5.12	Periodical publications	80
5.13	Exchange of information between EPO and national offices	81
Chapter 6 EPC Procedural Law: Filing the Application, Date of Filing and Formalities Examination; European Search		83
6.1	The European patent application, examination on filing and formalities examination	83
6.1.1	The European patent application	83
6.1.2	Filing of a European patent application	85
6.1.3	Filing of a divisional application	86
6.1.4	Date of filing	87
6.1.5	The Receiving Section	88
6.1.6	Examination on filing; accordance of date of filing	88
6.1.7	Missing parts of the description or missing drawings	89
6.1.8	Examination of formal requirements	89
6.1.9	Consequences if the deficiencies are not rectified in due time	90
6.1.10	Applications relating to nucleotide and amino acid sequences	91
6.1.11	Applications relating to biological material	91
6.2	Search, search opinion and European search report	92
6.2.1	Search Divisions	92
6.2.2	European search	92
6.2.3	Unity of invention	93
6.2.4	European search report	93
6.2.5	Extended European search report	93
6.2.6	Approval of the abstract by the Search Division	94
6.2.7	Response to the search opinion	94
Chapter 7 EPC Procedural Law: Publication, Substantive Examination, Grant or Refusal; Amendments and Correction of Errors		95
7.1	Publication of the patent application	95
7.1.1	Types of publication	97
7.2	Designation of States	97
7.2.1	Designation of Contracting States	97
7.2.2	Extension and validation States	98
7.3	Request for examination including examination fee	98
7.4	Invitation to provide information on prior art and results of earlier searches	99
7.5	Substantive examination	100
7.5.1	Examining Divisions	100
7.5.2	The first stage of substantive examination	101
7.5.3	Acceleration of substantive examination (PACE)	102
7.5.4	Examination of replies of the applicant and further stages of examination	102
7.5.5	Auxiliary requests	103

7.5.6	Final stage of the examination	104
7.6	Decision to grant or refuse	106
7.6.1	Grant of the European patent	106
7.6.2	Types of publication	108
7.6.3	Refusal of the European patent application	108
7.7	Amendments and correction of errors	109
7.7.1	Amendments	109
7.7.2	Correction of errors	111
Chapter 8 EPC Procedural Law: Opposition, Intervention, Limitation and Revocation; Appeal Proceedings; Enlarged Board of Appeal		113
8.1	Opposition	113
8.1.1	Persons entitled to oppose	113
8.1.2	Notice of opposition and parties to opposition proceedings	113
8.1.3	Grounds for opposition	115
8.1.4	Opposition Divisions	116
8.1.5	Examination for deficiencies in the notice of opposition	117
8.1.6	Substantive examination of the opposition	118
8.1.7	Decisions in opposition proceedings	120
8.1.8	Publication of a new specification of the European patent	121
8.1.9	Apportionment of costs	122
8.2	Intervention of the assumed infringer	123
8.2.1	Notice of intervention	123
8.2.2	Intervention during appeal proceedings	124
8.3	Limitation or revocation proceedings	125
8.3.1	Request for limitation or revocation	125
8.3.2	Examination of the request for limitation or revocation	125
8.4	Appeal	127
8.4.1	Decisions subject to appeal	127
8.4.2	Persons entitled to appeal and parties to appeal proceedings	127
8.4.3	Notice of appeal and grounds of appeal	128
8.4.4	Interlocutory revision	128
8.4.5	Boards of Appeal	129
8.4.6	Examination of appeals	129
8.4.7	Decisions in appeals	130
8.5	Enlarged Board of Appeal	131
8.5.1	Decision or opinion of the Enlarged Board of Appeal	131
8.5.2	Petition for review by the Enlarged Board of Appeal	132
Chapter 9 EPC Procedural Law: Common Provisions, Periods, Remedies and Fees; Conversion, Revocation and National Rights		135
9.1	Common provisions governing procedure	135
9.1.1	Right to be heard and basis of decisions	135
9.1.2	Examination by the EPO of its own motion	136
9.1.3	EPO may disregard facts or evidence not submitted in time	137
9.1.4	Third-party observations	137
9.1.5	Oral proceedings	139
9.1.6	Taking of evidence by the departments of the EPO	141
9.1.7	Unity of the European patent application or European patent	142
9.1.8	Communications and notification	142
9.1.9	Reference to general principles	143
9.2	Periods	144
9.2.1	Periods indicated in the EPC or specified by the EPO	144
9.2.2	Calculation of periods	144
9.2.3	Extension of periods	145
9.2.4	Late receipt of documents	145
9.2.5	Interruption of proceedings	146
9.2.6	Consequences of non-observance of periods	146

9.3	Further processing and re-establishment of rights	147
9.3.1	Loss of rights	147
9.3.2	Further processing of the European patent application	148
9.3.3	Re-establishment of rights	149
9.4	Fees	150
9.4.1	Fees for applications and patents	150
9.4.2	Due date for fees and payment in due time	150
9.4.3	Reduction of fees	151
9.4.4	Refund of fees	151
9.4.5	Renewal fees	152
9.5	Conversion, revocation and national rights	153
9.5.1	Conversion into a national patent	153
9.5.2	Revocation of European patents before a court of a Contracting State	154
9.5.3	Relations between European and national patents	154
9.5.4	Territorial extent of the European patent application and European patent	155
Chapter 10 PCT: General Provisions; Filing the International Application and Accordance of the International Filing Date; the EPO as Receiving Office		157
10.1	Introduction to the PCT	157
10.1.1	Introduction	157
10.1.2	Definitions	157
10.2	General provisions	158
10.2.1	Types of protection and regional patent treaties	158
10.2.2	Administrative provisions, revision and amendment	158
10.2.3	Agents and common representatives	159
10.2.4	Time limits	161
10.2.5	Delay in meeting certain time limits	161
10.2.6	Review by designated Offices	162
10.2.7	Withdrawals	163
10.2.8	Correction of obvious mistakes in documents	164
10.2.9	Correspondence	164
10.2.10	Recording of changes concerning the applicant, inventor, agent or common representative	165
10.2.11	Keeping of records of files	165
10.2.12	Access to files	165
10.2.13	Schedule of fees	166
10.3	Filing the international application	166
10.3.1	Requirements for filing the international application	166
10.3.2	Description, claims and drawings	167
10.3.3	Languages of the international application	168
10.3.4	Fees due when filing an international application	169
10.3.5	Claiming priority	169
10.3.6	The applicant	170
10.3.7	The receiving Office	170
10.4	International filing date and formalities examination	171
10.4.1	Accordance of the international filing date	171
10.4.2	Filing missing parts and missing elements	172
10.4.3	Formalities examination	173
10.4.4	Transmittal by the receiving Office of the international application to the International Bureau and the international searching authority	174
10.5	The EPO acting as receiving Office	175
10.5.1	Application of the PCT to the EPC	175
10.5.2	The EPO as receiving Office	175
Chapter 11 PCT: International Search, International Publication and International Preliminary Examination; the EPO as ISA and as IPEA		177
11.1	International search	177

11.1.1	Objective of the international search	177
11.1.2	International Searching Authority	177
11.1.3	Subject-matter not required to be searched	178
11.1.4	Unity of invention	178
11.1.5	Written opinion of the ISA	179
11.1.6	International search report	179
11.2	The EPO acting as International Searching Authority	180
11.3	Amendment of the claims after receiving the international search report	181
11.4	Supplementary international search	182
11.5	The EPO as ISA carrying out supplementary international searches	184
11.6	International publication	185
11.6.1	Content of the international publication	185
11.6.2	Languages of publication	186
11.6.3	Preventing publication	186
11.6.4	Postponing publication	187
11.6.5	Provisional protection	187
11.6.6	Confidential nature of the international application	187
11.7	Third-party observations and licensing indications	188
11.8	International preliminary examination	189
11.8.1	Demand for international preliminary examination	189
11.8.2	Fees in relation to international preliminary examination	190
11.8.3	International Preliminary Examining Authority	191
11.8.4	Objective of the international preliminary examination	191
11.8.5	Procedure before the IPEA	192
11.8.6	Unity of invention	193
11.8.7	Subject-matter on which IPEA is not required to carry out examination	193
11.8.8	International preliminary examination report	194
11.9	The EPO acting as International Preliminary Examining Authority	195
Chapter 12	PCT: National/Regional Entry and Euro-PCT Application	197
12.1	National phase	197
12.1.1	Certain national requirements	197
12.1.2	Patent Prosecution Highway	198
12.1.3	Processing prohibition and early entry on express request of the applicant	198
12.1.4	Amendment of the application before designated/elected Offices	199
12.1.5	Communication to designated Offices	200
12.1.6	Entry into the national phase before the designated Offices	200
12.1.7	Entry into the national phase before the elected Offices	201
12.1.8	Reinstatement of rights after failure to duly enter the national phase	202
12.2	Regional entry before the EPO as designated or elected Office and processing of the Euro-PCT application	203
12.2.1	EPO as designated or elected Office	203
12.2.2	The Euro-PCT application as a European prior right	204
12.2.3	Equivalence between the international search report and the European search report	204
12.2.4	Supplementary European search	205
12.2.5	Procedural requirements for entry into the European phase	206
12.2.6	Consequences of non-fulfilment of certain requirements	207
12.2.7	Early processing of the Euro-PCT applications	209
12.2.8	Claims fees	210
12.2.9	Examination of certain formal requirements by the EPO	210
12.2.10	Response to the written opinion of the EPO as ISA or to explanations as given by the EPO as SISA or to the IPER by the EPO as IPEA	213
12.2.11	Amendment of the Euro-PCT application where the EPO did not act as ISA or SISA in the international phase	214
12.2.12	Accelerated processing of the Euro-PCT application	215
12.2.13	Further searches and unity of invention where the EPO did not act as ISA or SISA	216
12.2.14	Unity of invention and further searches where the EPO acted as ISA or SISA	216

12.2.15 Substantive examination of the Euro-PCT application	218
12.2.16 Decision to grant or refuse	218
Part D Tables of Legislation	219
Chapter 1 References to EPC Articles and Rules	221
Chapter 2 References to PCT Articles and Rules	230
Part E Indexes	233
Chapter 1 Indexes	235
Decisions/opinions of the Enlarged Board of Appeal	235
Chapter 2 Keyword Indexes	236
2.1 European Patent Convention	236
2.2 Patent Cooperation Treaty	257
2.3 Paris Convention	266
2.4 Pre-examination	266
Ordering Information	267