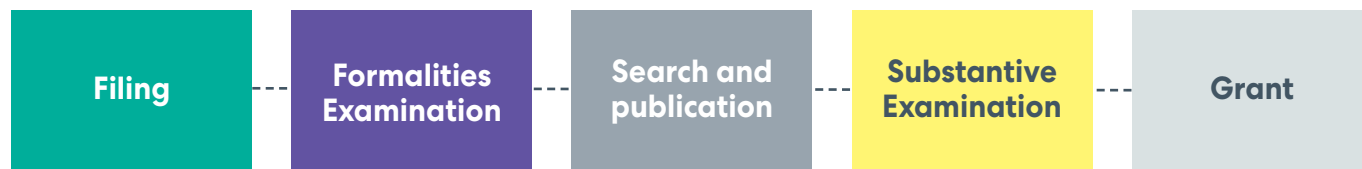




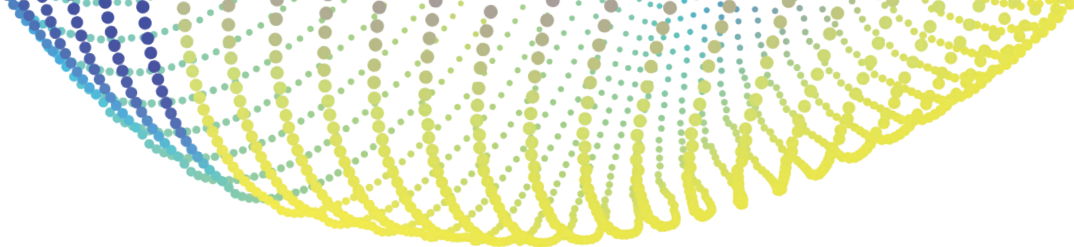
European Patent Prosecution



The path to obtaining a European patent can be viewed as a multi-stage process. Firstly, at the filing stage, the applicant must provide the European Patent Office (EPO) with sufficient information to be awarded a filing date for the application. This filing date acts as a stake in the ground because the application will be assessed for novelty and inventive step based on what was in public domain before this date. As such, it is possible to publicly disclose the invention from this date onwards without compromising its patentability.

The second stage is a formalities examination, during which the filed documents will be examined against a series of formal requirements. If these requirements are met, the application will move to the third stage, where the EPO performs a search for prior art deemed relevant to the patentability of the invention, and the application is published on the EPO website.

During the final (and usually the most extensive) stage, the application will undergo substantive examination. This is essentially a conversation that takes place, mostly in writing, between the applicant and an EPO Examiner. The applicant (or more commonly, their European patent attorney) must persuade the Examiner that the application meets the European patentability requirements. To achieve this, the applicant will need to overcome the Examiner's objections by setting out a convincing argument or amending the application. Once the Examiner's objections are overcome, the application proceeds to grant.



Filing

A filing date for a European patent application can be obtained by filing a description of the invention and the applicant's contact details at the EPO.

It is not necessary to include claims at this stage, but it is worth noting that the European approach to assessing added matter can make it difficult to include claims of the desired scope after filing. With this in mind, it is generally recommended to include claims when filing the application.

The description can be filed in any language, although a translation will be required later if the application is not filed in French, German or English. There are various ways of filing applications at the EPO, including online, by fax or by post. Filing by e-mail is not permitted.

Any person can file a European patent application. However, it is advisable to consult a European patent attorney before filing to give the application the best chances of success. After a filing date has been established, applicants that have neither a residence nor a principal place of business in a member state of the European Patent Convention must be represented by a European patent attorney for all further proceedings.

Formalities Examination

Once a filing date has been established, the EPO checks whether various formal requirements have been provided, such as: a signature, an English, French or German translation (if the application was filed in another language), an abstract, and at least one claim. If one of these requirements has not been provided then, for most requirements, the EPO issues a communication inviting the applicant to remedy the deficiency within 2 months. If the deficiency is not remedied by this deadline, the application is deemed withdrawn.

Fees for the application must be paid within 1 month of the filing date. Higher fees are due if the application has more than 35 pages or more than 15 claims.

Search and publication

Once the formal requirements are satisfied, the search division issues a European search report indicating any prior art documents which are deemed to be relevant to the application. The search report typically issues within 6 months of filing the claims, and is accompanied by a search opinion, which indicates any parts of the European Patent Convention that the application does not comply with. For example, the search opinion may indicate if any of the claims are deemed to be unclear, lack novelty or lack an inventive step.

The application will also publish approximately 18 months from the filing date of the application (or the priority date, if appropriate). If the search report is ready by this time, then the search report is published with the application. Otherwise, the search report will be published separately.

The publication of the search report sets a 6 month deadline for paying further fees and responding to any objections raised in the search opinion.

The response to the search opinion provides the first opportunity for the applicant to amend the application. Before this point, amendment of the application is not possible. Thus, amended claims and/or description pages may be filed in response to the search opinion, although care must be taken to ensure that the amendments do not add matter.

Substantive Examination

The application then proceeds to substantive examination, in which an Examiner considers the applicant's response to the search opinion. If there are any outstanding objections to the application, the Examiner issues an examination report outlining their objections. The examination report specifies the period for response, which is usually between 2 and 4 months. The deadline for responding can usually be extended once by 2 months, up to a total of no more than 6 months.

Once the applicant has responded to the examination report, the Examiner may issue further examination reports maintaining the objections or raising new ones. As amendments to the claims are often needed to overcome the Examiner's objections, it should be noted that any amendments made after the response to the first examination report are at the Examiner's discretion. As such, the Examiner may choose not to admit any amendments filed after this point. In practice, amendments are usually admitted provided they are not divergent (e.g. they build upon any previously filed amendments) and they address the objections raised during examination.

The Examiner may continue issuing further examination reports until the application is either accepted for grant or refused. In practice, applicants often include a request for oral proceedings in at least the first response to the EPO (e.g. in response to the search opinion). This ensures that, if the examining division intends to refuse the application, the applicant is first invited to a hearing, providing a further opportunity to submit arguments and/or amendments.

Grant

Once all of the objections raised in substantive examination have been overcome, the Examiner will issue a communication indicating their intention to grant the application. The communication is accompanied by the Druckexemplar, which is the version of the application that the EPO intends to grant. It will often include amendments suggested by the Examiner to address any minor deficiencies that were not rectified during examination. It is important to check the Druckexemplar thoroughly, as it is taken to be the authentic text of the patent after grant.

If the applicant wishes to make amendments to the text of the Druckexemplar, they must respond with the proposed amendments within 4 months. If the Examining Division has no objections, they will issue a second intent to grant communication. However, the Examining Division can reopen examination of the application if necessary.

Once the applicant is satisfied with the Druckexemplar, further fees are due within 4 months in order to progress the application to grant. It is also necessary to file translations of the claims into the other two official languages of the EPO by this deadline.

The EPO then issues a notice informing the applicant of the date on which grant of the application will be published in the EPO's Official Journal. This date of publication of grant is the date from which patent protection starts.

Depending on where patent protection is sought, it may be necessary to file translations with national patent offices and/or pay further fees for the patent to take effect in some European countries, in a process referred to as validation.

We have also provided timelines for [European prosecution without a priority claim](#) and [European prosecution with a priority claim](#).

This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact hik@hik-ip.com or your usual HLK advisor.