

### The Basics

Historically, to obtain a patent in a country you had to apply to the patent office in that country. If patent protection across Europe was wanted, separate applications were needed for each country. Since 1978, however, it has been possible to file a European patent application to obtain a European patent which may take effect in a number of countries.

#### WHAT IS A EUROPEAN PATENT?

A European patent can be an easier and cheaper alternative to obtaining individual national patents in the countries which are members of the European Patent Convention (EPC). A list of these member countries is attached. Please note that the members of the EPC are not all members of the European Union (EU), although all current members of the EU are members of the EPC.

A European patent gives its owner the same rights as a national patent in each country for which it is granted.

You can choose to apply for protection in any or all of the member countries of the EPC. Generally, if you want patent protection in three or more of the member countries, a European patent is cheaper to obtain than individual national patents.

The basic criteria for patentability under the EPC are similar to those for a UK patent.

European patent applications can be filed at the European Patent Office (EPO) in English. The application procedure leading to grant of the European patent is carried out centrally by the EPO, and correspondence to and from the EPO can be in English. Thus, the filing costs, and the costs of the subsequent application procedure, should be significantly lower than the equivalent costs of filing individual national patent applications, which in most cases must each be carried out in the national language.

Assuming that the EPO decides that your application is allowable, the European patent will usually be granted about three to four years after you make the application. Once granted, subject to certain formal requirements being met, the patent becomes legally effective in the chosen countries.

Following grant, there is a nine month period during which the patent can be opposed at the EPO by any other person.

#### Who can apply for a European patent?

A company or an individual can apply for a European patent. They will have to confirm that they own the invention to be granted a patent.

An application for a European patent can be made directly by you, or you can authorise a European Patent Attorney to make the application on your behalf. European Patent Attorneys are professionally qualified people who are experienced in dealing with the EPO and the application procedure.

If you do not have either a residence or a principal place of business in one of the member countries of the EPC, you must be represented by a European Patent Attorney throughout the application procedure, except for the initial filing of the application.

#### When should I apply for a European patent?

Usually, when a European patent application is made, it will claim priority from an earlier patent application for the same invention, for example an earlier UK patent application.

In order to claim priority, the European patent application must be filed no later than 12 months after the earlier application with certain limited exceptions. The claim to priority must be made within 16 months of the filing of the earlier application.

Claiming priority means that for some purposes your European patent application is back-dated to the date of the earlier patent application. In particular, the patentability of your invention is judged against the public knowledge at the date on which the earlier application was filed, insofar as the earlier application contains sufficient information about the invention. This date is known as the priority date of the European patent application. For example, you may wish to file initially a relatively cheap UK patent application at an early stage in the development of your invention, in order to establish a priority date. Following this first filing, you have a year to develop your invention further, and to work out whether it is commercially viable, before you have to decide whether to invest in a European patent.

It is possible to file an application for a European patent without claiming any priority. It is also possible to make a European

patent application via an international application under the Patent Cooperation Treaty (PCT). We can provide you with further information about these options if you wish. In the remainder of this information sheet it is assumed that you are filing a European patent application claiming priority from an earlier patent application filed 12 months previously.

### How do I apply for a European patent?

To obtain a European patent an application is made to the EPO, though filing is usually via the UK Patent Office.

An application for a European patent must contain:

- the name and address of the applicant(s);
- a request for a European patent;
- a description of the invention - preferably with drawings;
- one or more claims to the invention, defining the scope of protection that you are seeking;
- an abstract giving a brief summary of the invention;
- a request for a search.

A fee must also be paid to the EPO at the time of filing the application. On receipt, the application is given a filing date and a number, and the EPO sends you a receipt.

### What happens next?

Soon after 18 months from the priority date, i.e. six months from filing the European patent application, the application will be published.

A search report will be issued listing documents which may be relevant to the patentability of the invention to which your application relates. This will either be published with the application if issued in time or published later.

The search report will be accompanied by a search opinion in which the EPO give a preliminary view on the patentability of the claims. You will need to respond to the search opinion within 6 months of the publication of the search report, by commenting on the points raised or by correcting the deficiencies noted.

Within the same six months the countries in which you wish to proceed must be confirmed by paying a fee. After this, it is not possible to confirm more countries, but one or more can be abandoned if you wish.

Also within six months, a fee must be paid with a request for examination. During the detailed examination that follows, the EPO may write to you (or your authorised European Patent Attorney if you have one) giving reasons why the invention is not new or inventive, or objecting to formal aspects of the application. A time limit for reply is set, giving you the opportunity to try to persuade the EPO that the invention is worthy of a patent and the application is allowable. The description of the invention or the claims may be amended before agreement is reached; this can take time and involve further communication with the EPO.

When the EPO agrees that your invention is patentable, your patent will be granted.

You will be required at this stage to pay further fees and to provide a translation of the claims into French and German. Also, in order for the patent to take effect in some countries the full text must be translated into an official language of that country, and the translation filed at the respective national patent office. This may be very expensive, perhaps costing many thousands of pounds, depending on the countries involved.

Within nine months of grant, the patent may be opposed at the EPO by any other person. Should the patent be opposed, it is possible to defend your patent by entering into opposition proceedings.

Renewal fees need to be paid while the application is pending to keep it alive. The first renewal fee is due two years after filing the European Patent application, and subsequent renewal fees are due annually.

Once the European patent has been granted, it effectively splits into a group of separate national patent rights.

Annual renewal fees will need to be paid in each chosen country to keep the respective national patent rights in force. You can choose to let your patent rights lapse in one or more of the chosen countries, without affecting the patent rights remaining in other countries.

### How do I enforce my patent?

Once your patent has been granted it is enforceable in each of the countries designated, assuming relevant translations have been made and renewal fees paid. Anyone using your invention without your consent in those countries will be infringing the patent.

Action can be taken by instructing attorneys in the relevant countries to act on your behalf. A separate action is necessary in each country in which you wish to enforce your patent rights.

You cannot sue for infringement until the European patent application has been granted. However, once your application has been granted, it may be possible to claim damages back to the date on which your application was published.

### What can we do for you?

A European Patent Attorney can handle all aspects of obtaining a European Patent, including writing the application.

Employing a European Patent Attorney may increase your costs in the short term, but it is likely to give you a more secure European Patent.

European Patent Attorneys are bound by professional rules of conduct which prevent us from telling anyone about your invention without your consent.

We can advise you on other aspects of intellectual property such as Trade Marks, Copyright, Designs, licensing and litigation, in Britain, Europe and around the world.

## The members of the EPC as at 1st May 2010

|                            |                          |
|----------------------------|--------------------------|
| ALBANIA                    | LITHUANIA                |
| AUSTRIA                    | LUXEMBOURG               |
| BELGIUM                    | MACEDONIA                |
| BULGARIA                   | MALTA                    |
| CROATIA                    | MONACO                   |
| CYPRUS                     | NETHERLANDS              |
| CZECH REPUBLIC             | NORWAY                   |
| DENMARK                    | POLAND                   |
| ESTONIA                    | PORTUGAL                 |
| FINLAND                    | ROMANIA                  |
| FRANCE                     | SAN MARINO               |
| GERMANY                    | SLOVAKIA                 |
| GREECE                     | SLOVENIA                 |
| HUNGARY                    | SPAIN                    |
| ICELAND                    | SWEDEN                   |
| IRELAND                    | SWITZERLAND <sup>1</sup> |
| ITALY                      | TURKEY                   |
| LATVIA                     | UNITED KINGDOM           |
| LIECHTENSTEIN <sup>1</sup> |                          |

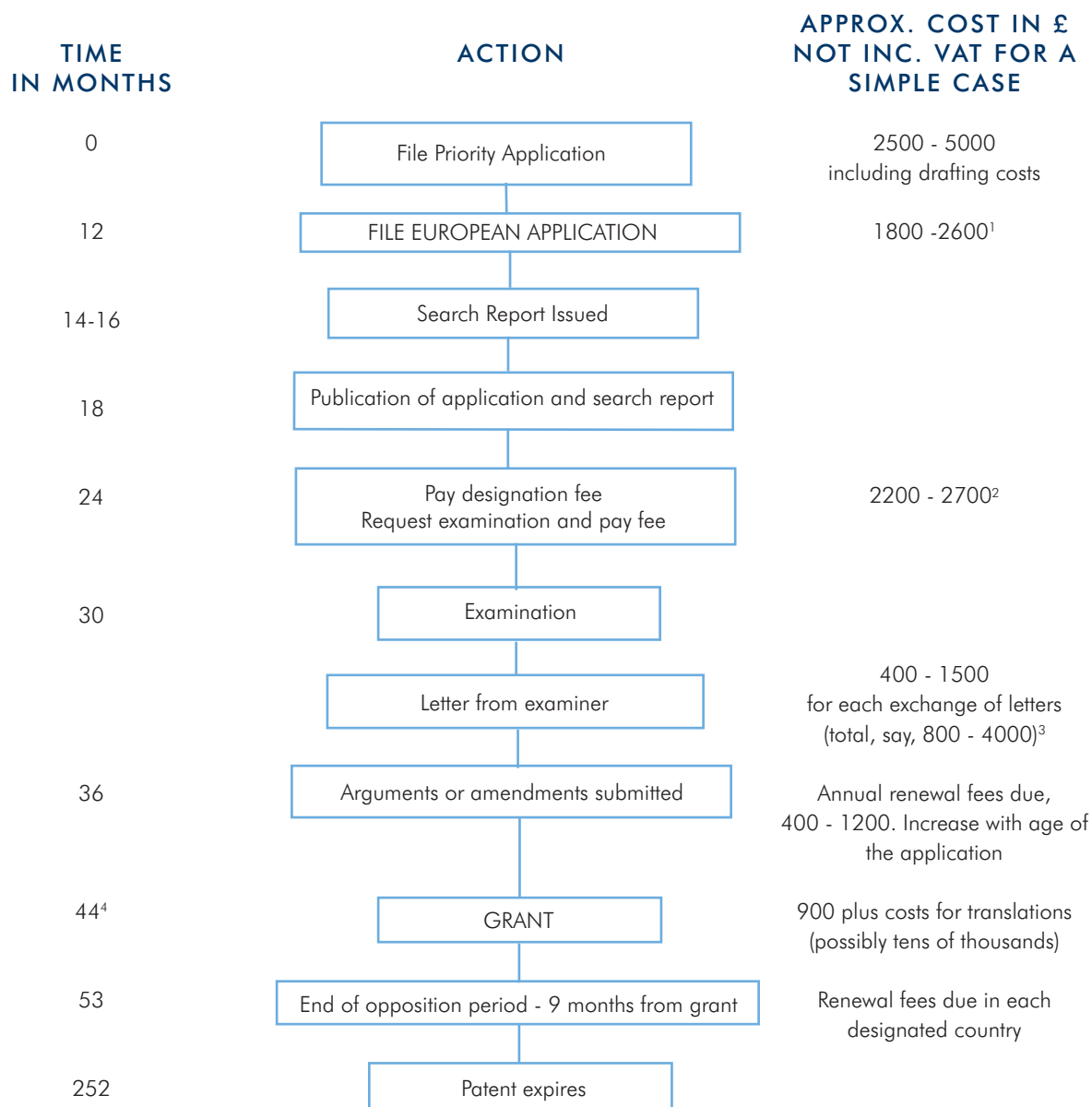
Any or all of the above countries can be designated in a European Patent application.

A European Patent can also be “extended”<sup>2</sup> to the following countries:

BOSNIA & HERZEGOVINA  
MONTENEGRO  
SERBIA

<sup>1</sup> Liechtenstein and Switzerland together count as a single designation

<sup>2</sup> These “extension” countries cannot be designated as such in a European Patent application, but the national law in each country provides for “extension” into that country of the rights conferred by a granted European patent. We can provide further information about this if you are interested in any of these countries.



<sup>1</sup> This is based on filing a European application with no excess claims (i.e. 15 claims or fewer), assuming all documents are filed with the application.

<sup>2</sup> Assuming no 'extension' states are selected. Each extension state will increase cost by about £140.

<sup>3</sup> These costs are typical for cases including relatively simple technology and straightforward legal issues. Costs for cases in more complex fields, such as biotechnology, software or electronic hardware are likely to be higher due to more complicated subject matter and a more difficult legal environment.

<sup>4</sup> May take longer depending on how smoothly the application goes through examination and on the date of publication of the search report.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at [www.mewburn.com](http://www.mewburn.com). Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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