



European Patent Basics

Introduction to European Patent SYSTEM

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EUROPEAN PATENT ATTORNEY

Barry Franks



Background and Experience

Work

Patent examiner at the European Patent Office in The Hague for nearly 10 years.
In-house counsel at GE Healthcare in the UK and Sweden for 8 years.
Private practice 12 years.

Education

B.Sc. in Engineering with French from the University of Bath, UK

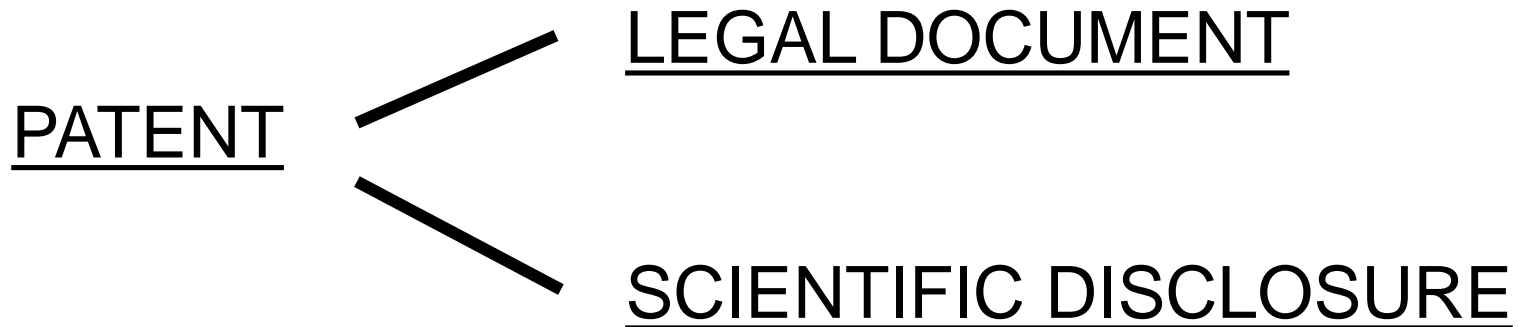
IP specific experience

Drafting, prosecuting patent applications. Oral proceedings before the Swedish Patent Office and the European Patent Office. Oppositions and appeals for European patents. Freedom-to-operate evaluations. IP due-diligence. Patent portfolio management. Setting up and managing invention disclosure systems. Former lecturer at the Swedish Patent Office and at the Swedish IP Academy.

Peer nominated Awards

Managing Intellectual Property Magazine “IP Star” 2014, 2015
Intellectual Asset Management Magazine “Patent 1000” 2013, 2014, 2015

What is a patent?



Legal Document

State grants a monopoly
for a limited period -
in return for:

Scientific Disclosure

Description of invention

Result is that others can learn and improve upon it

Monopoly

- **Your European Patent allows you to prevent others from using your IP without your permission in selected European countries**
- **Advantages:**
 - **unique selling proposition such as: better performance, lower costs.**
 - **better negotiating position: able to cross-licence**
 - **Revenue: license fees, royalties.**

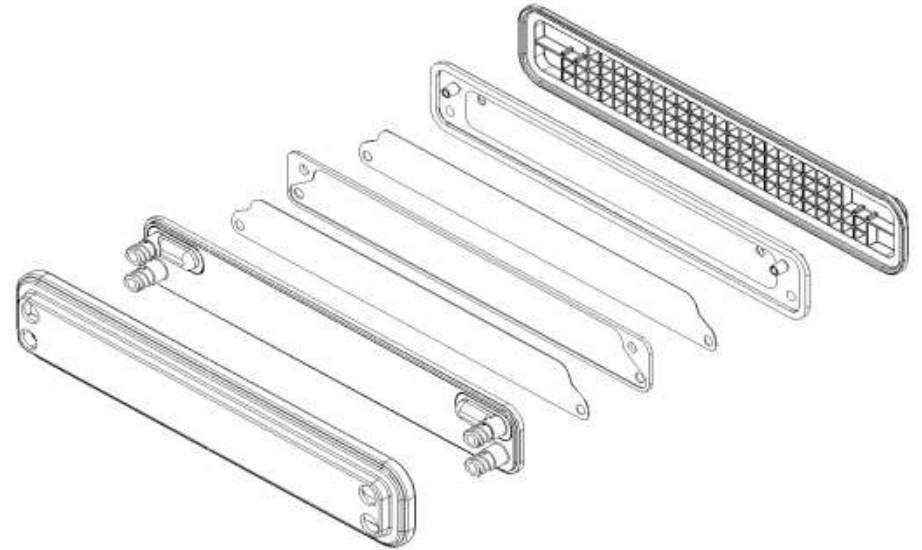


Monopoly – for how long?

- 20 years from the “filing date” of the European patent application or the PCT application that it is based on.



What is patentable?



- **Novel**
- **Inventive step**
- **Capable of industrial application**

What may be patented?

- Products
- Methods/processes for manufacturing a product
- Use of a product for a specific purpose
- Diagnostic methods where the essential technical step is performed outside the body
- Cosmetic method that does not include a doctor
- Grey area
 - Therapeutic/diagnostic methods
 - Business methods (involving technical step)
 - Computer programs (that control technical steps in a machine or system, as implemented in said machine or system)
- Exceptions
 - Pure discoveries without any known commercial use, games, discoveries
 - Inventions whose commercial use would be contrary to "public order" or morality

Novel and inventive

- No publication prior to filing – anywhere!
- e.g. no article, press release, conference presentation/poster/proceedings or blog entry
- Exception: countries with a grace-period e.g. USA
- No sale of products incorporating the invention prior to filing
- No lecture or presentation prior to filing (except under a **non-disclosure agreement (NDA)**)
- Seek professional advice early!
- File before others do!



Contents of a patent application

■ Title

■ Abstract

■ Description

■ Claims

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

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PCT
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(25) Filing Language: English

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0118013.8 31 July 2001 (31.07.2001) GB

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(81) Designated States (national): AE, AG, AL, AM, AT, AU,
AZ, BA, BB, BG, BH, BY, BZ, CA, CH, CN, CO, CR, CU,
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GB, GR, HU, IE, IT, LU, MC, NL, PL, PT, SE, SK, TR);
OAPI patent (BF, BI, CI, CG, CM, GA, GN, GQ,
GW, ML, MR, NE, SN, TD, TG)

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without international search report and to be republished
upon receipt of that report

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(54) Title: MODULAR GEL-STRIP CARRIER ELEMENT

(57) Abstract: A carrier module for holding a gel-strip in heat transferring contact with the surface of a cooling plate or a Peltier plate in an electrophoretic separation process, comprising a carrier member (1, 3b) formed in a plastic material for disposable use; the carrier member having a top plane formed with at least one elongate channel (2) for receiving the gel-strip in longitudinal contact with a bottom portion (5) of the channel, the carrier member being molded to have a shell formed structure wherein said channel is depressed from the top plane of the shell structure so as to be able to rest with its bottom in contact with the cooling plate surface.

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Types of patent applications

- **National**
- **Regional (EP)**
- **International (PCT)**



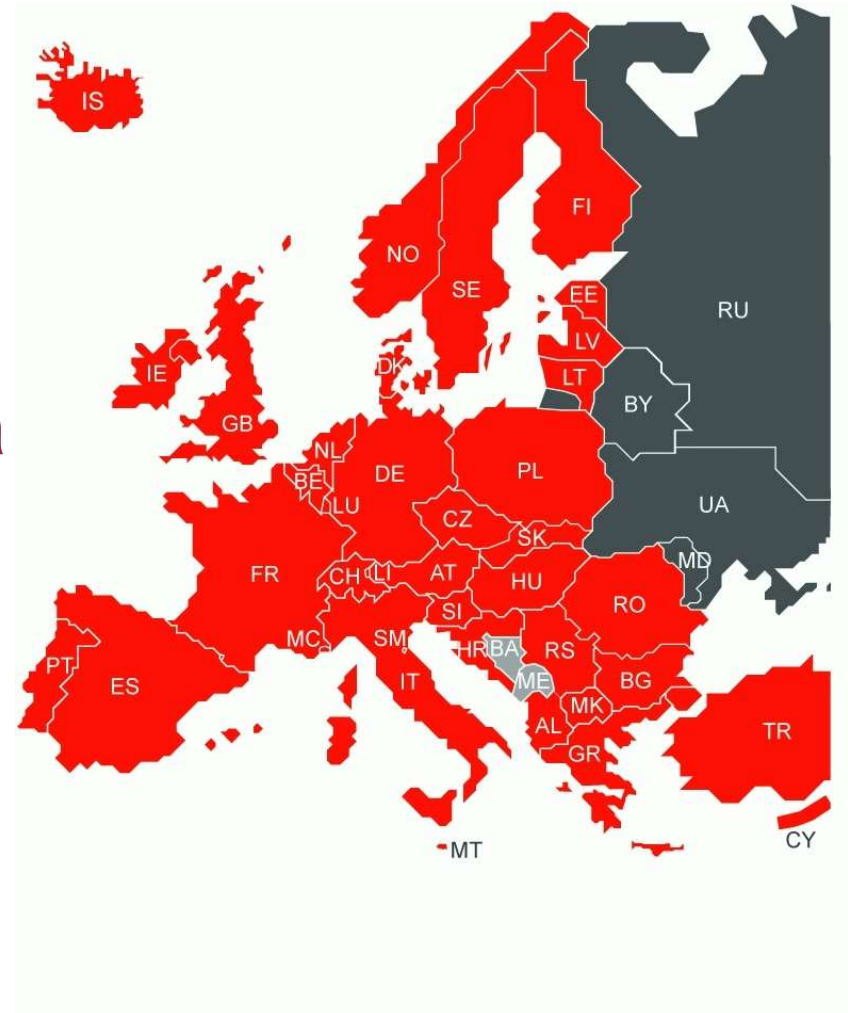
Patents are national rights (for now)

- Must, in principle, be sought in each separate country where protection is desired (but Unified European Patent coming...)
- National attorney required
- Usually must be translated into the national language



Types of patent applications

- **Regional, e.g.**
- **European Patent**
- **Others: Eurasia, Africa**



Types of patent applications

International - PCT contracting states



European patent system)

One patent application

One language (DE, FR or GB)

One European Patent attorney

One set of rules (European Patent Convention)

One set of fees

One opposition procedure

BUT

Not (yet) one granted patent! A granted European patent needs to be validated in all the countries that you want to have protection in and leads to national patents

However – Unitary patent system is coming soon!

European patent system)

Member states (38)

Albania	Luxembourg
Austria	Malta
Belgium	Monaco
Bulgaria	Former Yugoslav Republic of Macedonia
Croatia	Netherlands
Cyprus	Norway
Czech Republic	Poland
Denmark	Portugal
Estonia	Romania
Finland	San Marino
France	Serbia
Germany	Slovakia
Greece	Slovenia
Hungary	Spain
Iceland	Sweden
Ireland	Switzerland
Italy	Turkey
Latvia	United Kingdom
Liechtenstein	
Lithuania	

Extension states (2)

Bosnia-Herzegovina
Montenegro

Validation states (1)

Morocco



Filing costs - patent application

AREA	TYPE OF PATENT APPLICATION	TYPICAL COST (Euro)
National, e.g. UK, SE	Preparation of specification and filing of national patent application	€1200 to €7000 plus VAT
Europe	Preparation of specification and filing of European patent application	€3000 to €9000 plus VAT
International	Preparation of specification and filing of International (PCT) patent application	€4500 to €10000 plus VAT
Europe	Filing of European patent application within 12 months of original national filing date, with priority claim to original national filing date	€2300 to €2800 plus VAT
International	Filing of International (PCT) patent application within 12 months of original national filing date, with priority claim to original national filing date	€4000 to £€4500 plus VAT

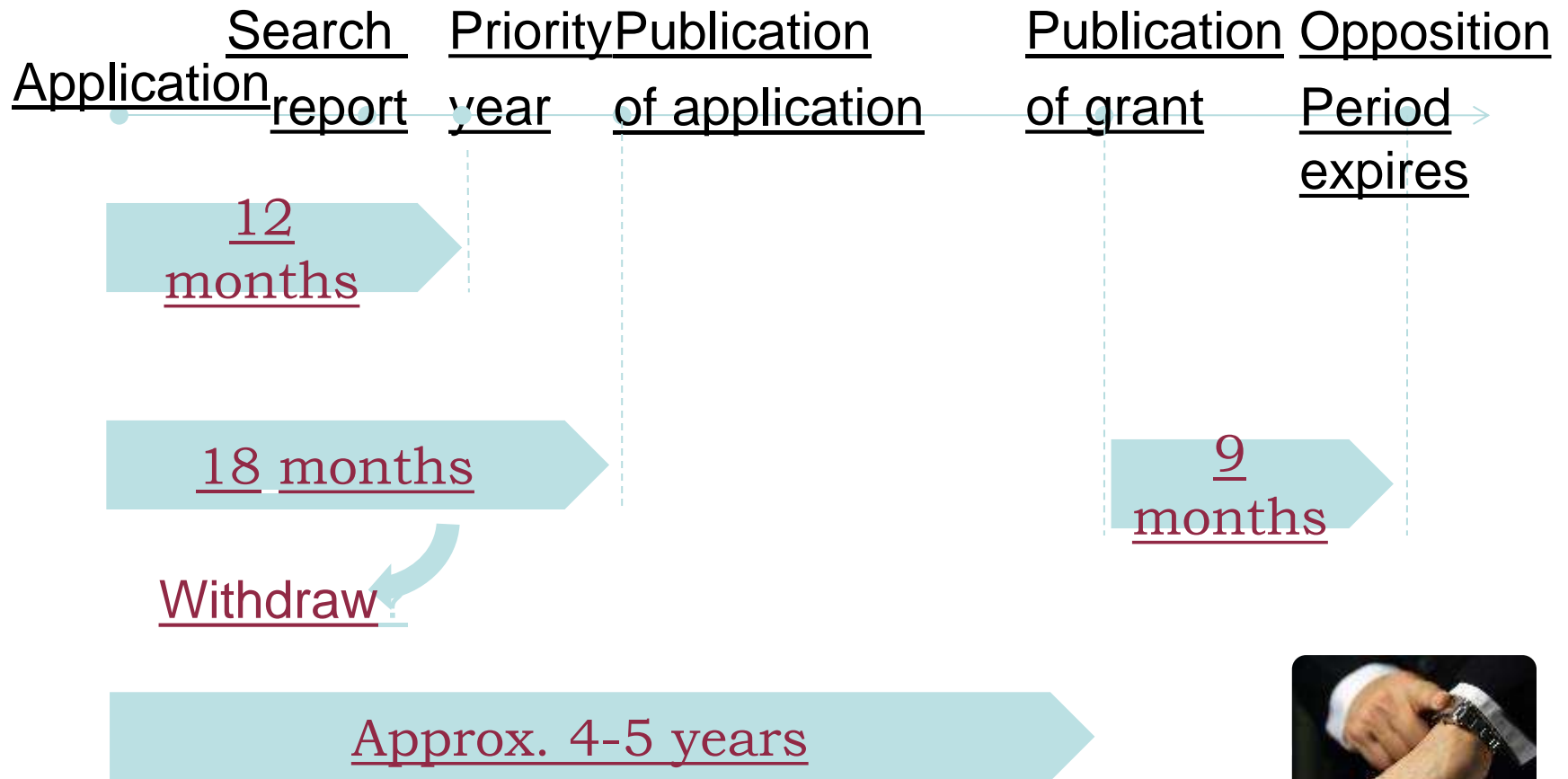


Patenting process

- Drafting
- Filing
- Prosecution – EPO “Examining Division”
- Grant/refusal/abandon
- 5% chance of opposition
- National validation
- USE!!!!
- <http://www.epo.org/applying/european/Guide-for-applicants.html>



Important dates - Europe



Important dated for patents

- - 6 to 1 month invent, search and write application
- 0 month- filing of priority application
- 7 months- office action
- 12 months- PCT filing
- 15 months – PCT search report
- 18 months- Publication
- 30 months- EP and national filings
- 30 + EP and national prosecution
- 30++ Grant – start of 9 month opposition period
- Every year from the start of the third year - maintenance fees



What is “patent prosecution”

- Getting your patent granted!
- Involves responding to office letters
- (called “office actions”)
- Three types:
 - Formal – need to reply € 200 - 500
 - Substantive – need to reply or act € 1000 - 3000
 - Decisions – may need to act € 1000 - 2000



Granted patents

- **Granted European patents lead to a basket of national patent rights**
- **Need to decide which countries to validate and maintain the patent in.**
- **Cost may include translation and maintenance fees.**
- **Details available here:
<http://www.epo.org/law-practice/legal-texts/national-law.html>**



Granted patents

■ Granted patents may be:

- Opposed
- Invalidated/revoked
- Infringed
- Abandoned
- Maintained
- Sold
- Licensed
- Used as security
- Enforced



Questions?

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