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**RYUKA IP LAW FIRM**

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## How to Acquire Intellectual Property in Europe ?

- There is an ongoing discussion whether a single European patent application is preferable over several independent national patents.
- Most applicants favorize a single port to all European countries in terms of costs and administrative overhead.
- Independent patent systems and legal systems in different European countries can have strategic advantages.
- The discussion is once again revived by the most recent Rule changes of the EPC.

## Motivation for Rule Changes

- According to EPO: quality of patent applications dropped which increased work load for EPO but should be handled by clients.
- Streamlining examination procedure: time limits for divisional applications; pre- and post-search procedure.
- Inventive Step: Not increasing the legal requirements, but harmonizing and improving consistency
- Re-focusing examination
- Balancing interest

## Summary New Rules as of April 1, 2010

| Amended rule               | Details   |
|----------------------------|---|
| Rules 62a (new) and 63     | The examiner can invite the applicant to clarify the claims before the search is performed.                                   |
| Rule 137 (new paragraph 5) | Amendments introducing subject-matter excluded from search under Rules 62a and 63 EPC are not permitted.                      |
| Rules 70a (new) and 161    | The applicant must respond to the search opinion issued by the EPO search examiner prior to entry into the examination phase. |
| Rule 137, paragraphs 2 & 3 | Only one opportunity for the applicant to file "own volition" amendments.   |
| Rule 137, paragraph 4      | The applicant must identify any amendments and indicate their basis in the original filing.                                   |
| Rule 36                    | Sets time limits for divisional applications.   |
| Rules 57a, 69 and 135      | References to some of above new rules added.  |
| Rule 64                    | Time limit for payment of additional search fee in cases of non-unity.  |

## Summary Rules 141, 70b as of 1. January 2011

| Amended rule | Details   |
|--------------|---|
| Rules 141    | The applicant must provide search results of priority applications and related patent applications                                    |
| Rule 70b     | Two months time limit for Rule 141, legal consequences of failure to comply with Rule 141 and date of coming into force for Rule 141. |

## Rules 141, 70b – Background

- Utilisation Pilot Project (UPP) showed that work on a first filing from a National Patent Office (NPO) can be further used and can be beneficial to EPO.
- Intention is to support and streamline granting procedure.
- Reducing workload for EPO examiners.
- Use of results of NPO is on discretion of examiner
- Applicable to European patent applications (also divisionals and international filings) filed on or after January 1, 2011.

## Rule 141

### Information on prior art

- (1) An applicant claiming priority within the meaning of Article 87 shall file a copy of the results of any search carried out by the authority with which the previous application was filed together with the European patent application, in the case of a Euro-PCT application on entry into the European phase, or without delay after such results have been made available to him.
- (2) The copy referred to in paragraph 1 shall be deemed to be duly filed if it is available to the European Patent Office and to be included in the file of the European patent application under the conditions determined by the President of the European Patent Office.
- (3) Without prejudice to paragraphs 1 and 2, the European Patent Office may invite the applicant to provide, within a period of two months, information on prior art within the meaning of Article 124, paragraph 1."

## Rule 70b

Request for a copy of search results

- (1) Where the European Patent Office notes, at the time the Examining Division assumes responsibility, that a copy referred to in Rule 141, paragraph 1, has not been filed by the applicant and is not deemed to be duly filed under Rule 141, paragraph 2, it shall invite the applicant to file, within a period of two months, the copy or a statement that the results of the search referred to in Rule 141, paragraph 1, are not available to him.
- (2) If the applicant fails to reply in due time to the invitation under paragraph 1, the European patent application shall be deemed to be withdrawn."

*The provisions shall enter into force on 1 January 2011. Rule 141 and new Rule 70b shall apply to European patent applications and international applications filed on or after that date.*



## Rule 141 – Details 1

- Obligation to file search results is triggered by priority claim.
- Applicant has to file search results of the office of first filing (OFF).
- If an application claims multiple priorities, then the search results have to be filed for each one of the earlier applications.
- A copy of the official document issued by OFF must be sent to EPO.
- The search results are to be filed without delay after the search results are available to the applicant
- The obligation to file search results exists as long as a patent application is pending.
- For priority claims to PCT applications, the search results of the International Search Authority (ISA) has to be filed.
- For divisional applications, a copy of search results has not to be filed again (if it already has been filed properly)

## Rule 141 – Details 2

- A translation of the search results is not necessary, if not in an official language of the EPO
- Referenced documents do not have to be included
- No search results necessary if they are available to EPO as defined by President (refer to decisions of the President).
- Rule **141 (3)** relates to a possible invitation to provide search results.
- The EPO can invite to file search results of national or regional patent applications relating to the same invention as the European patent application.
- This encompasses search results of filings of which **no** priority is claimed.
- There is a non extendable time period of two months after receipt of invitation.
- Rule 141 is only applicable during examination phase.

## Rule 70b – Details

- If EPO notices that search results have not been filed: EPO can invite applicant to either file search results or to file a statement that the search results are not available.
- Application deemed withdrawn if no response in time.
- The invitation is automatically filed for divisionals.
- The invitation can be ignored if search results were already provided
  
- Non extendable time limit of two months.
- Further processing is available.

## Decision of President of 5 October 2010 – Rule 141

- The European Patent Office automatically includes a copy of the search results referred to in Rule 141(1) EPC in the file of a European patent application where a search report of the following type was drawn up **by the European Patent Office**
- on an application whose priority is claimed:
  - – **European search report** (Article 92 EPC)
  - – **international search report** (Article 15(1) PCT)
  - – **international-type search** (Article 15(5) PCT)
  - – **search report made on behalf of a national office on a national application** (Belgium, Cyprus, France, Greece, Italy, Luxembourg, Malta, Netherlands, Turkey).

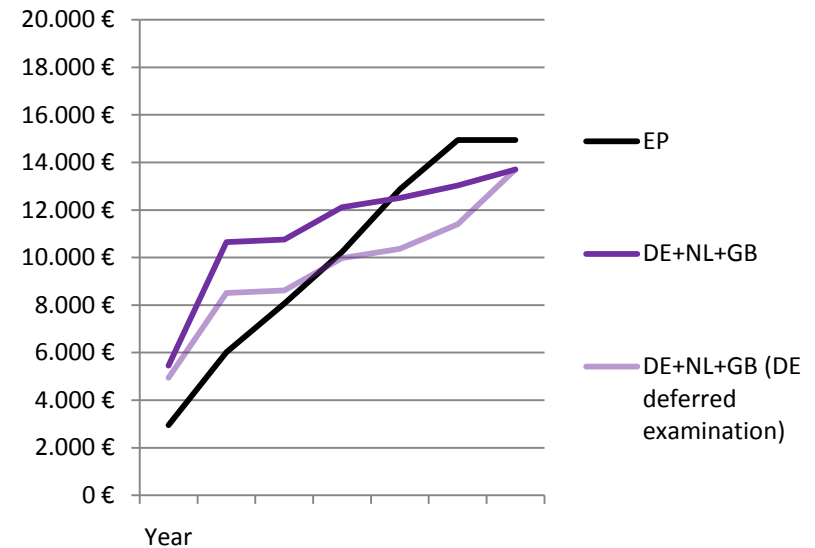
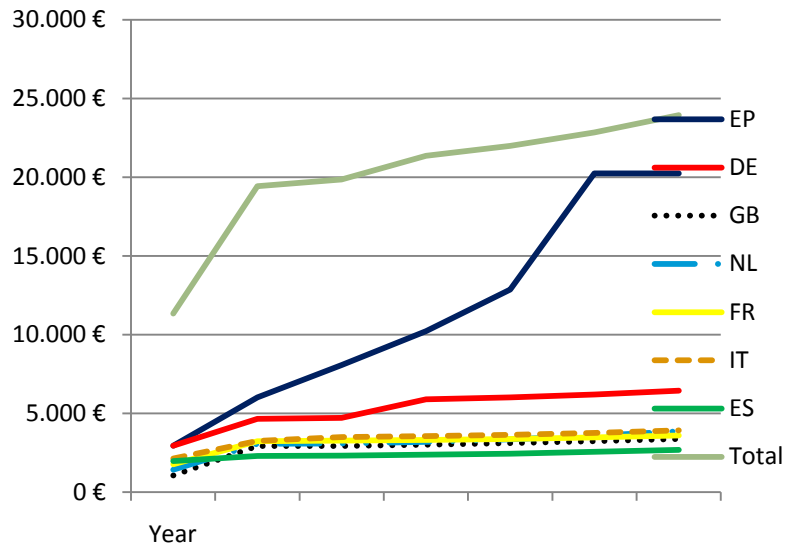
## Decision of President of 10 December 2010 – Rule 141

- The European Patent Office automatically includes in the file of a European patent application a copy of the search results referred to in Rule 141(1) EPC, if the priority of a first filing made in one of the following states is claimed:
- Japan
- United Kingdom
- United States of America

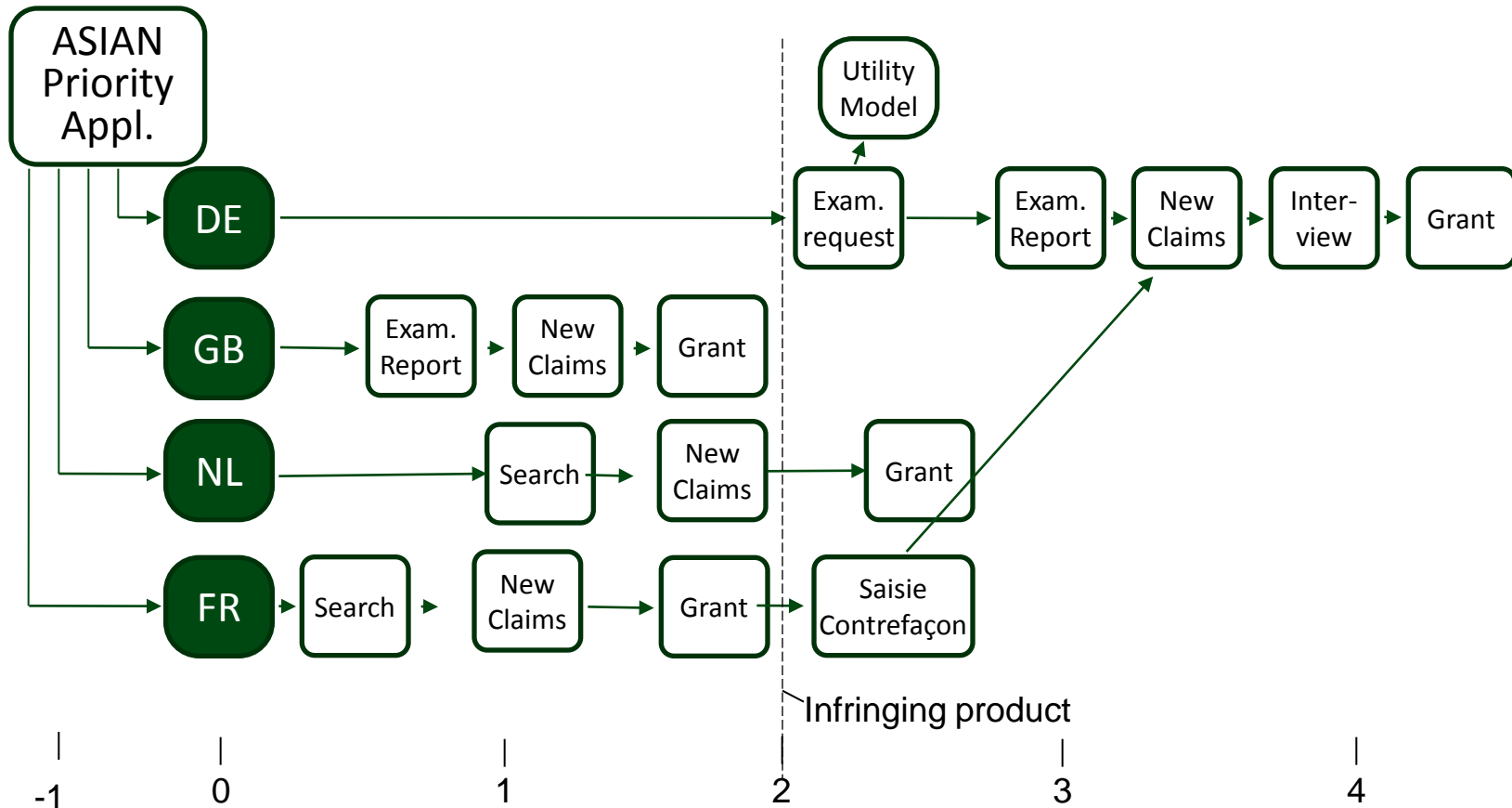
*This decision enters into force on 1 January 2011 and shall apply to European patent applications and international applications filed on or after that date.*

## Example - Patents: Costs

The cost of the national patent filing package is comparable to a European patent application and, depending on the choice of countries, may be less expensive.



## Example - Patents: Tailored Patent Prosecution Scenario



## **AIPEX – EUROPE CONNECTED**

AIPEX is a recently founded alliance of respected national European IP law firms

AOMB, Netherlands

Wynne-Jones, Lainé & James LLP, UK

Prinz & Partner, Germany

AOMB, Poland



We are a legal entity of about 50 attorneys.

By working together as a team, we offer a coordinated and optimized approach to IP in Europe.

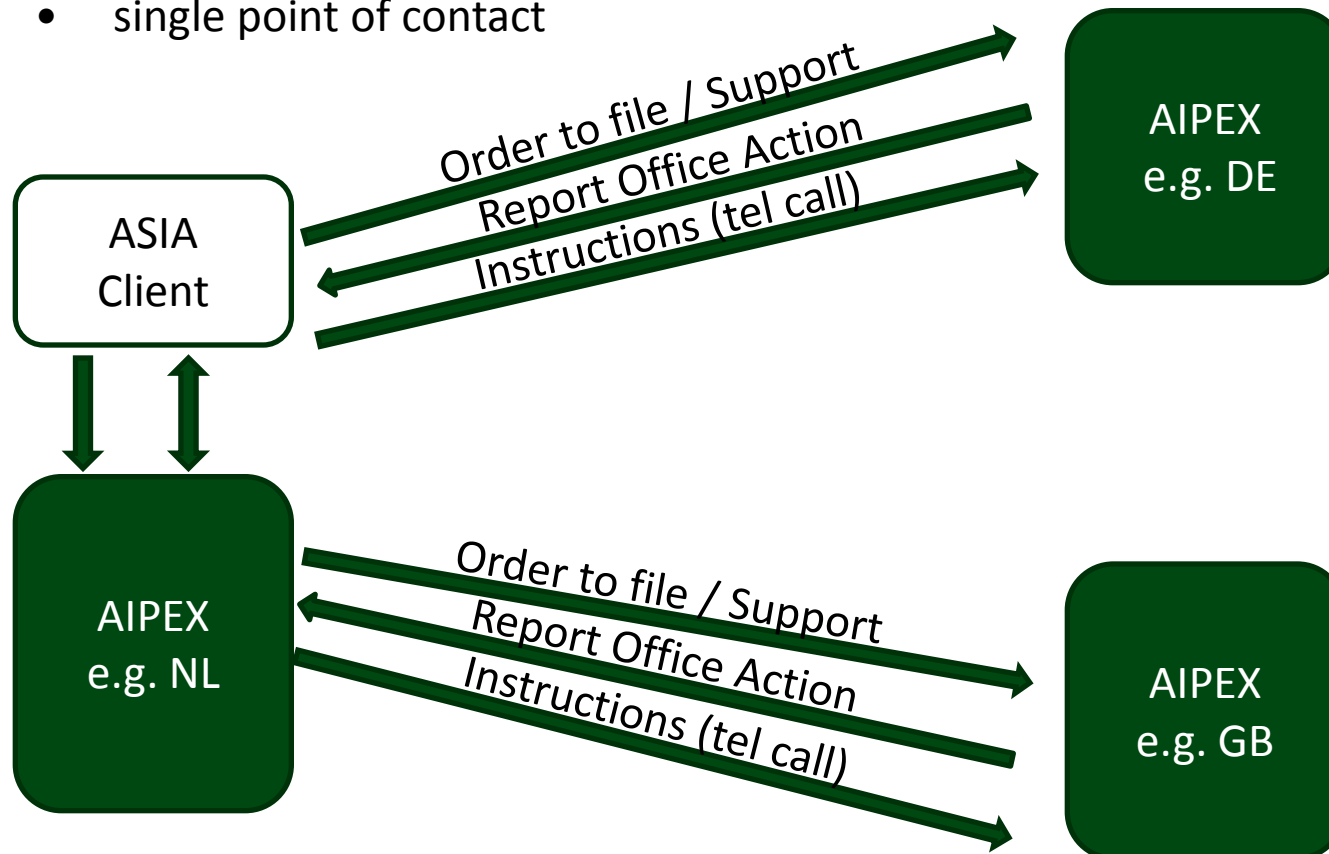
We provide:

- A coordinated approach
- The option of a single point of contact for IP in Europe
- Cost-effectiveness
- Responsiveness
- A guarantee of quality

## Coordinated Approach

Client selects preferred contact option. Can be:

- local contact within AIPEX for different European countries
- single point of contact



## Tailored Solutions

AIPEX offers European regional IP (European patents, Community Trademarks (CTMs), Registered Community Designs (RCDs)).

AIPEX also offers direct national filings as an alternative.

With our coordinated approach, AIPEX can advise on the best strategy for you.

## Example - Patents

- AIPEX provides a package of national patent filings.
- The national patent filing package is flexible, and your patent protection can be tailored to best meet your needs.
- Timings can be coordinated and controlled to your advantage.
- Examination can go simultaneously or successively.
- Can accelerate proceedings before fast acting national patent offices (e.g. NL and GB) for swift enforcement of national patent rights.
- Can decelerate proceedings to postpone costs and to tailor claims subsequent to patent grant in other countries. This makes it difficult for competitors to avoid your patent rights in Europe.
- Different claims can be obtained in different countries to optimize your patent protection and to hinder competitors in finding workaround solutions.

## Barrier of different patents sequentially granted



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