

The life cycle of a European patent application

*Directorate Practice and Procedure_Formalities
Munich and The Hague*

date of review:
20 January 2010



- Part 1:
Requirements for filing of a European patent application
- Part 2:
Overview of the examination procedure
- Part 3:
Means of redress throughout the life of the patent application

Part 1:

Requirements for filing a European patent application

1. Filing of a European Patent Application
2. Date of Filing
3. Formal requirements
4. Inventor
5. Late filing of parts of description and/or drawings
6. Claims
7. Language
8. Priority
9. Fees
10. Accelerated search
11. Search report/Publication of application

Filing a European patent application

- **Where** EPO (Munich, The Hague, Berlin)
(Art. 75 (1) a) EPC)
National offices (Art. 75 (1) b) and 77 EPC)
- **How** Post
Fax
Online
- **Who** Any natural or legal person (Art. 58 EPC)

Date of filing

Requirements for the accordancy of a date of filing (R. 40 EPC):

- Indication that a European patent is sought
- Information identifying the applicant
- A description or reference to a previously filed application

A reference to a previously filed application shall state the

- Filing date
- Number of that application
- Office with which it was filed

Such reference shall indicate that it replaces the description and any drawings

Formal requirements

If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with [Article 90 \(3\) EPC](#), whether:

- EPO Form 1001 completed (including indication about priority)
- Application documents filed:
 - Description
 - Claims
 - Abstract
 - (Drawings)
 - in one of the three official EPO language
- Fees paid
- Inventor data filed
- Representative data filed
- Information about sequence listings given



Designation of inventor

- 16 months from date of filing/priority to file designation of inventor
- Period deemed to have been observed if designation of inventor filed before completion of technical preparations for publication

If not filed

- Application will be published without inventor data
- Decision to refuse will be sent after publication
- Non-submission of designation of inventor cannot be used to prevent publication

Late filing of parts of description and/or drawings

- Late filing of missing pages is applicable to description **AND** drawings
- In case of re-dating applicant has option to maintain original date of filing by withdrawing late-filed pages



Date of filing will shift back to original one
(only on explicit request of applicant!)

Late filing of parts of description and/or drawings - ctd.

If missing pages are completely contained in priority document, the date of filing does not shift if the following conditions are met:

- Explicit request that the late-filed parts be based on the claimed priority
- Certified copy of priority document is filed
- If priority document not in DE/EN/FR, translation is filed
- Indication where missing pages can be found

Claims can be filed

- Directly on filing
- By reference to previously filed application
- After date of filing

EPO Form 1001
(page 4)

29 Patentansprüche / Claims / Revendications

Zahl der Patentansprüche /
Number of claims /
Nombre de revendications

CLMS

29.1

wie beigefügt / as attached /
telles que jointes en annexe

29.2

wie in der früher eingereichten Anmeldung (siehe Feld 28.2) /
as in the previously filed application (see Section 28.2) /
comme telles que figurant dans la demande déposée antérieure-
ment (voir rubrique 28.2)

29.3

Die Patentansprüche werden nachgereicht /
The claims will be filed later /
Les revendications seront produites ultérieurement

Language

- Applications may be filed **in any language** (Art. 14 (2) EPC)
- Translation is required for applications in non-EPO languages
- Translation to be filed within two months of date of filing
 - if not filed, EPO issues invitation to file within two months
 - if still not filed, application deemed to be withdrawn
(re-establishment of rights only possible)

Priority

- Priority declaration can be made **up to 16 months from oldest priority date** (R. 52 (2) EPC) unless a request for early publication (Art. 93 (1) b) EPC) has been made (R. 52 (4) EPC).
- Priority declaration can be corrected under Rule 52 (3) EPC within 16 months
- Priority claim possible from any Paris Convention State **and WTO member**, e.g. Taiwan
- If priority year was missed:
 - Re-establishment of rights (Art. 122 EPC) into priority period possible, to be requested within two months after expiry of 12-month period

Fees

For applications filed (divisional applications received on) on/after 01.04.2009:

- **Filing fee + additional fee** for applications comprising more than 35 pages:
 - **Filing fee** : Online = EUR 100 (Paper = EUR 180)
 - **Additional fee** for 35th and each subsequent page:
EUR 12

Basis for calculation = application documents

 - As available on date of filing
 - In the **language of filing**
- **Search fee:** EUR 1050

Additional fee (part of filing fee)

Detailed basis for calculation:

- **EP applications:**

- Description
- Claims
- Drawings
- Abstract

- **EuroPCT applications:**

- Description
- Claims
- Drawings
- Abstract

} latest version

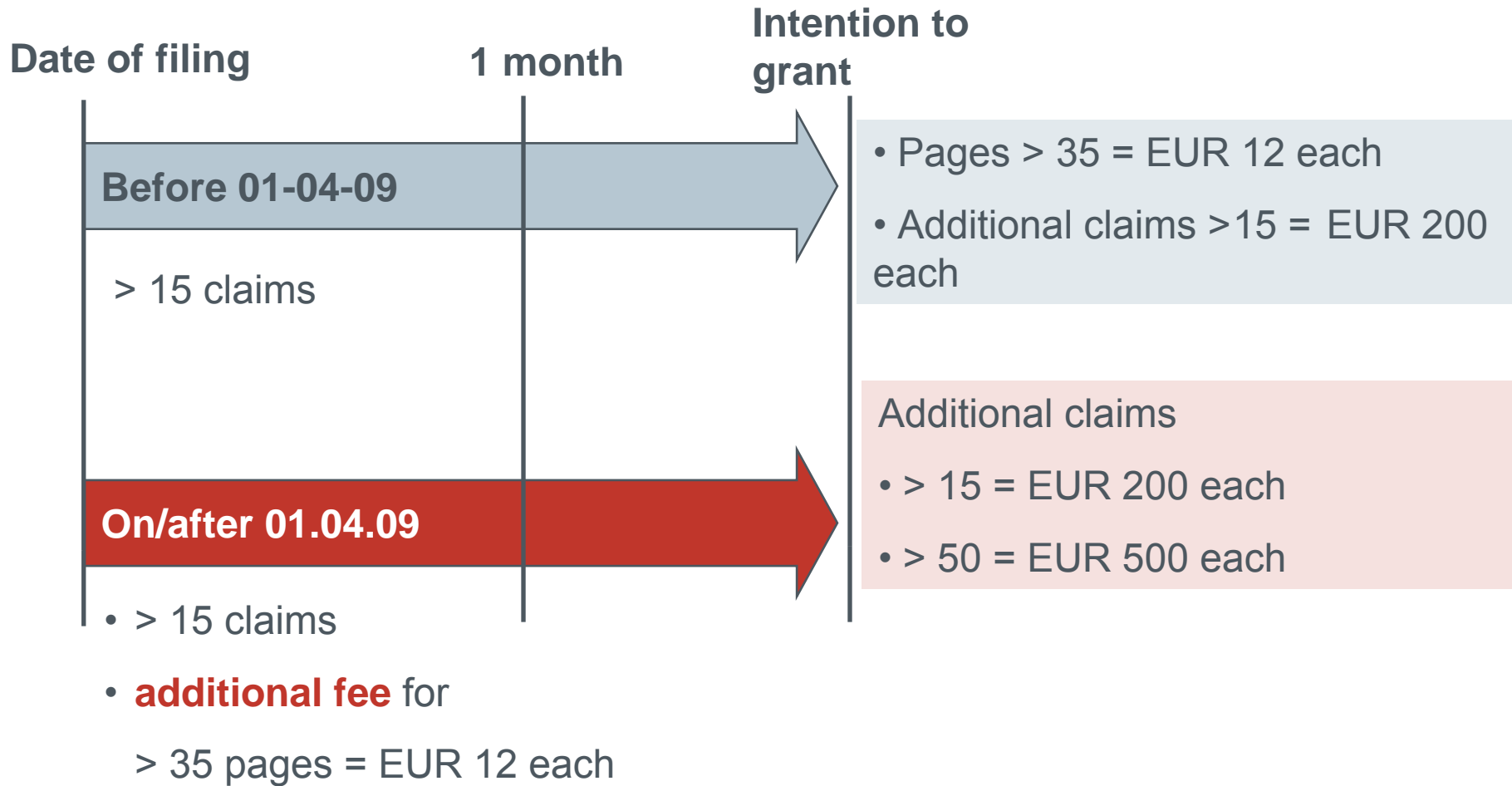
- ▶ Where translation is needed: documents published by the International Bureau as basis for calculation unless amendments have been filed

Fees - ctd.

For applications filed (divisional applications received on) on/after 01.04.2009:

- **Claims fee:**
 - Claims 16-50: EUR 200 each
 - Claims 51 and over: EUR 500 each
- **Designation fee:** EUR 500
- **Examination fee:** EUR 1405

Fees - changes in the examination phase



Request for accelerated search

For applications claiming priority (second filings):

- Once a request for accelerated search is filed, the Office makes every effort to issue the search report as soon as possible

For both first and second filings:

- Accelerated prosecution only possible if application documents on filing are in order for search

No accelerated prosecution is possible if

- the application is filed by reference
- parts of the description or drawings are missing
- the claims are filed after the date of filing

Search report

The Search (Art. 92 EPC)

- To identify the state of the art
- Prepares for substantive examination and is relevant for the purpose of determining whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step

Cited Documents

- Patent literature
- Non-patent literature

The Search report (R. 61 EPC)

- **Indicates results** of the search
- Accompanied by a written opinion whether the application and the invention to which it relates meet the requirements of the EPC (R. 62 EPC)

Part 1: Requirements for filing

European Search Report



European Patent Office

EUROPEAN SEARCH REPORT

Application Number

EP

DOCUMENTS CONSIDERED TO BE RELEVANT			
Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (IPC)
A	JP 07 124453 A (MITSUBISHI KAKOKI KK) 16 May 1995 (1995-05-16) * abstract *	1	INV. B01D71/02 B01D69/10 B01D53/22 C01B3/50
A	JP 05 317662 A (SUMITOMO METAL IND; MITSUBISHI KAKOKI KK) 3 December 1993 (1993-12-03) * abstract *	1	
A	JP 01 131004 A (SANYO ELECTRIC CO) 23 May 1989 (1989-05-23) * abstract *	1	
P,A	JP 2003 135942 A (DAIDO STEEL CO LTD) 13 May 2003 (2003-05-13) * abstract *	1	
The supplementary search report has been based on the last set of claims valid and available at the start of the search.			TECHNICAL FIELDS SEARCHED (IPC)
			B01D C01B H01M
Place of search		Date of completion of the search	Examiner
Munich			
CATEGORY OF CITED DOCUMENTS X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document			

EPO FORM 1503 (02.02) (IP/KOM)

Publication of application

(19)	 Europäisches Patentamt European Patent Office Office européen des brevets	
		(11) EP 1 852 976 A1
(12) EUROPEAN PATENT APPLICATION		
(43)	Date of publication: 07.11.2007 Bulletin 2007/45	(51) Int. Cl.: H03K 18/177 (2006.01) H03K 18/0186 (2006.01)
(21)	Application number: 07018191.4	
(22)	Date of filing: 28.08.2002	
(64)	Designated Contracting States: DE GB	<ul style="list-style-type: none"> • Huang, Joseph San Jose California 95131-3104 (US) • Nguyen, Khal San Jose California 95123 (US) • Pan, Phillip Fremont California 94608 (US)
(30)	Priority: 29.08.2001 US 315904 P 28.08.2002 US 228542	
(62)	Document number(s) of the earlier application(s) in accordance with Art. 75 EPC: 02266977.7 / 1 284 088	
(71)	Applicant: Altera Corporation San Jose, CA 95134 (US)	
(72)	Inventors: • Wang, Bonnie I. Cupertino California 96014 (US) • Sung, Chiakang Milpitas California 96035 (US)	(74) Representative: Appelt, Christian W. FORRESTER & BOEHMERT Anwaltssozietät Pettenerkofersrasse 20-22 80338 München (DE)
		<u>Remarks:</u> This application was filed on 17 - 08 - 2007 as a divisional application to the application mentioned under INID code 62.

(54) Programmable high-speed I/O interface

(57) Methods and apparatus for providing either high-speed, or lower-speed, flexible inputs and outputs. An input and output structure having a high-speed input, a high-speed output, a low or moderate speed input, and an low or moderate speed output is provided. One of the input and output circuits are selected and the others are deselected. The high-speed input and output circuits are comparatively simple, in one example having only a clear signal for a control line input, and are able to interface to

lower speed circuitry inside the core of an integrated circuit. The low or moderate speed input and output circuits are more flexible, for example, having preset, enable, and clear as control line inputs, and are able to support JTAG boundary testing. These parallel high and lower speed circuits are user selectable such that the input output structure is optimized between speed and functionality depending on the requirements of the application.

EP 1 852 976 A1

Publication

- 18 months after date of filing or priority date with or without Search Report (A1 or A2/A3 publication)
- File inspection (online): <http://www.epoline.org/portal/public>
- A- and B-Publications (Art. 93, 98, 103 EPC) available via Publication-Server: <https://data.epo.org/publication-server/>
- Provisional protection (Art. 67 EPC)
- Observations by third parties (Art. 115 EPC)

Part 2: Overview of the examination procedure

1. Examination request
2. The Examining Division and substantive examination
3. Request for accelerated examination
4. Communication from the Examining Division
5. Time limits
6. Payment of fees
7. Renewal fees
8. Grant of a patent



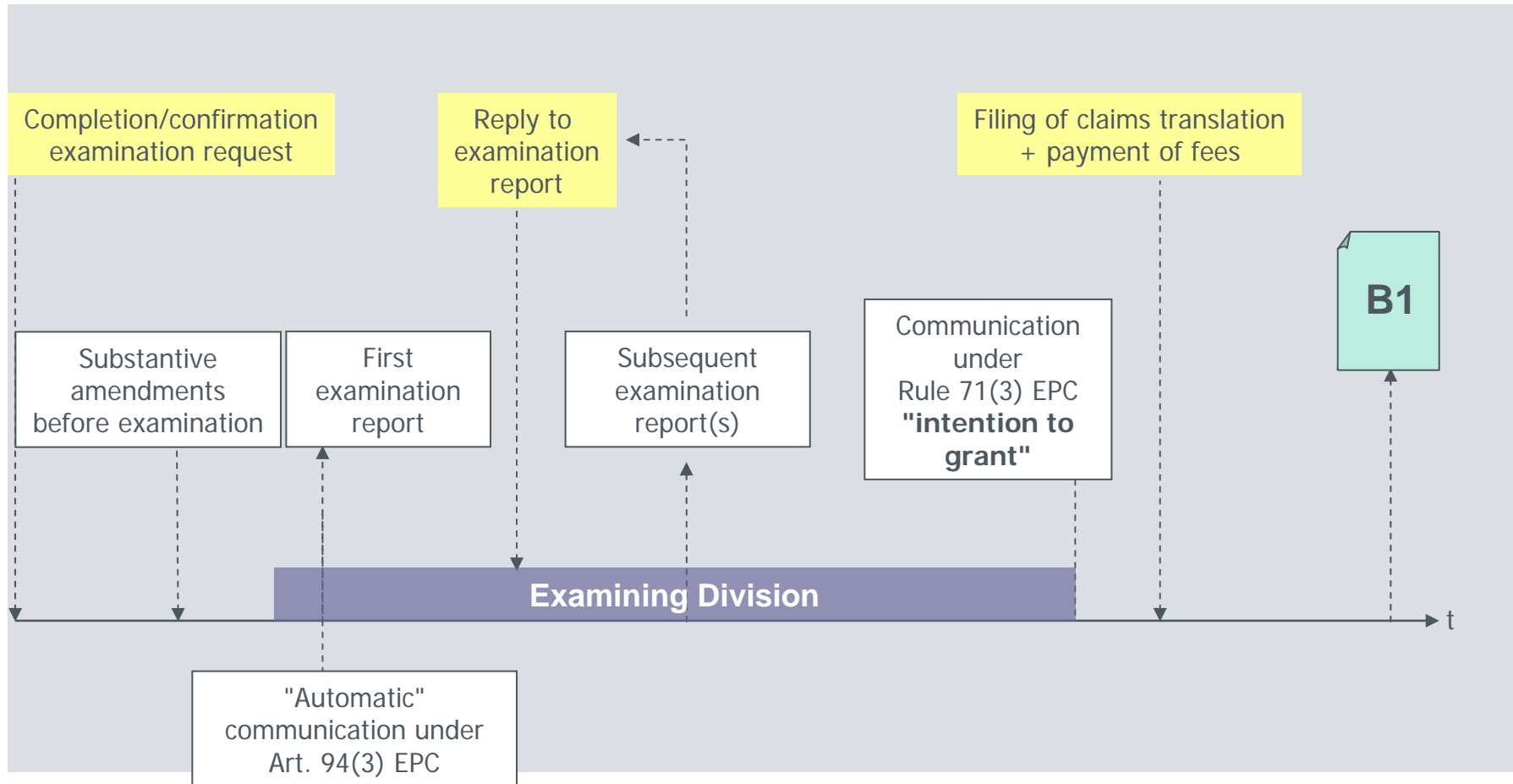
Examination request

Within six months from mention of publication of the European Search Report, the applicant should file/pay:

- Confirmation of the request for examination/payment of examination fee (Art. 94 EPC)
- For applications filed (divisional applications received) on/after 01.04.09, one designation fee for all contracting states (EUR 500)
- For applications filed (divisional applications received) before 01.04.09, designation fees (up to 7) (Art. 79 (2) EPC)
- Extension fees (no flat rate)



Overview of examination procedure





The Examining Division (Art. 18 EPC) and the substantive examination

- Examination is an **ex parte** procedure
- The whole of the Examining Division is responsible for every decision.
- Examining Division decides on grant or refusal, based on EPC criteria for patentability:
 - Novelty (Art. 54 EPC)
 - Inventive step (Art. 56 EPC)
 - Industrial application (Art. 57 EPC)



Request for accelerated examination

- Request can be filed at any time
- EPO tries to issue the first/next examination action within three months
- Free of charge
- Preferably by using EPO Form 1005
- Non-public
- Enquiry as to the next office action not deemed to be acceleration request

Communication from the Examining Division

Dialogue between applicant and examiner

- The standard avenue of communication between applicant and Examining Division
- In most cases first examination report is (semi-)automatic
- In future, mandatory reply to search opinion

Communication from the Examining Division - ctd.

A communication from the Examining Division might include:

- An invitation to provide prior art
(from national/regional patent procedures) (Art. 124 EPC)
 - List with relevant prior art suffices (no documents)
 - No reply/late reply: application deemed to be withdrawn
- An invitation to file translation of priority document
(if not DE/EN/FR) (R. 53 (3) EPC)
 - Only if needed by examiner for assessing patentability
 - No reply/late reply: application deemed to be withdrawn



Communication from the Examining Division - ctd.

Procedure:

- If application does not fulfil requirements of the EPC
→ communication/invitation to remedy deficiencies
- No reply
→ application deemed to be withdrawn
- Reply but deficiencies remain
→ application will be refused (Art. 97 EPC)
- Oral proceedings will be held if requested (Art. 116 EPC)



Time limits

General rules regarding time limits:

- Last day of an EPO time limit must be an open day at EPO.
- A day is not considered as open day at EPO if the Office is closed in either Munich, The Hague or Berlin.
- If last day of a time limit is not an open day, time limit is extended to next open day at EPO.

Calculation of EPO time limits

Either

Starting from notification of EPO communication + time limit involved

- e.g. communication pursuant to Article 94 (3) EPC

Or

Starting from date fixed in EPC

- e.g. six months from due date of renewal fee for payment of additional fee

→ Last day of a time limit must always be an open day at EPO

Extension of EPO time limits

1. Time limits set by the EPO can be extended up to six months
2. Request for extension of time limit must be received at the EPO
 - in writing
 - within original time limit
 - signed by an authorised person
3. Extensions beyond six months are only granted in exceptional circumstances (Notice of Vice-President Directorate-General 2 of the EPO, dated 28.02.1989, OJ 1989, 180)

Part 2: Examination procedure

Method of payment

Bank transfer

EPO deposit account
(insufficient funds: administrative
fee due in order to maintain
original payment date
(EPO Form 9004)

Automatic debit order
(responsibility for paying fees in
due time passes to EPO)

Online Fee Payment

Payment date

➔ Date when amount entered in
EPO account

➔ Date of receipt of debit order
by EPO

➔ Last day of period for payment
(exceptions apply)

➔ Date receipt debit order
by EPO

Who may validly pay fees to the EPO?

Anybody!
(payment of fees is not a procedural step)

Renewal fees

- No renewal fees are due for the first two years of a European patent application
 - Renewal fees for European patent applications in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application, starting with the renewal fee for the third year
- e.g. European patent application filed 17.01.07
Renewal fee for third year due 31.01.09

Renewal fees - ctd.

- If not paid by the due date, payment still possible within six months from due date with 50 % additional fee (as from 01.04.2008)
- Period for validly paying renewal fees before due date reduced to **three months**

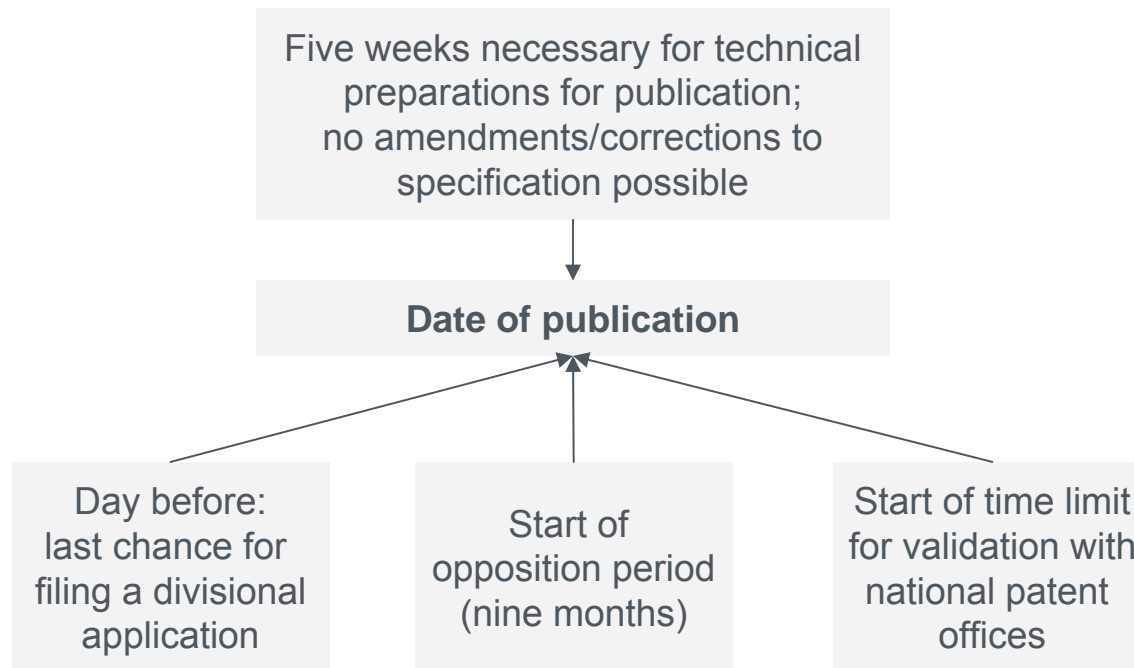
Grant of the European patent

- The application meets the requirements of the EPC:
 - Translation of the claims
 - Payment of grant and printing fees
(grant and publishing fees - applications filed
[divisional applications received] on/after 01.04.09)
 - Payment of fee for additional claim(s)
→ within a non-extendable period of four months
- Applicant might request amendments or corrections of the text intended to grant

Grant of the European patent (Art. 97 EPC) - ctd.

After all requirements are fulfilled:

- Preparations start for the publication of the mention of grant in the European Patent Bulletin and for the publication of the patent specification



Decision to grant - EPO Form 2006



European Patent Office
80298 MUNICH
GERMANY
Tel. +49 (0)89 2399 - 0
Fax +49 (0)89 2399 - 4465



Duckett, Anthony Joseph
Mathys & Squire LLP
120 Holborn
London
EC1N 2SQ
GRANDE BRETAGNE

**For any questions about
this communication:**
Tel.:+31 (0)70 340 45 00

Date
05.11.09

Reference P26129EP-PCT	Application No./Patent No. 02741704.7 - 2117 / 1392683
Applicant/Proprietor Cytovia, Inc.	

Decision to grant a European patent pursuant to Article 97(1) EPC

Following examination of European patent application No. 02741704.7 a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 71(3) EPC dated 24.06.09 is hereby granted in respect of the designated Contracting States.

Patent No. : 1392683
Date of filing : 16.05.02
Priority claimed : 16.05.01/USP 290997

Designated Contracting States
and Proprietor(s) : AT BE CH CY DE DK ES FI FR GB GR IE IT LI LU MC NL PT SE TR
Cytovia, Inc.
6650 Nancy Ridge Drive
San Diego, CA 92121/US

This decision will take effect on the date on which the European Patent Bulletin mentions the grant (Art. 97(3) EPC).

The mention of the grant will be published in European Patent Bulletin 09/49 of 02.12.09.

Examining Division

Ladenburger C

Kyriakakou G

Richter H



Part 3:

Overview of the means of redress throughout the life of the patent application

1. Means of redress
2. Further processing

Means of redress

Request for a decision pursuant to Rule 112(2) EPC

Further processing (Art. 121, Rule 135 EPC)

Re-establishment of rights (Art. 122, Rule 136 EPC)

Appeal under Articles 106 - 108 EPC

All EPO communications indicate the
possible means of redress

Further Processing

- Further processing is the **MAIN** legal remedy for applicants
- It is generally available for partial AND total loss of rights
- **However**, specific time limits are excluded by
Article 121 (4) EPC and Rule 135 (2) EPC

Three different fee situations:

- Non-/Late performance of acts under Rule 71 (3) EPC
= EUR 210 (Fee code 121)
- Non-/Late performance of acts or submissions of documents
= EUR 210 (Fee code 122)
- Non-/Late payment of a fee = 50% of late fee (Fee code 123)

Further Processing - ctd.

- Time limit for filing the further processing request:
 - **two months from notification of loss of rights communication**
 - can also be filed before receipt of loss of rights communication (Legal Advice 13/82)
- Completion of the omitted act
- No reasons necessary
- Payment of the fee for further processing = request
(R.135 (1) EPC)

Major change EPC 1973 <-> EPC 2000:

Amount of **further processing fee** varies according to case / omitted act



End of Presentation