

Table of Content

Table of Content	II
Used Abbreviations.....	VI
Prologue	VII
1. Introduction - Identification of issues	8
2. The European Patent Convention.....	13
2.1 Nature and purpose of the EPC	13
2.2 Contracting and Extension States	15
2.3 The London Agreement - Translation costs	18
3. Patentability according to the EPC.....	23
3.1 A two stage approach.....	25
3.2 What is technical?	27
3.3 Computer related inventions and software products	29
3.4 Excuse - The EU-Directive for Computer-Implemented Inventions.....	34
3.5 Business methods	36
3.6 Methods of medical treatment or diagnosis performed on the human or animal body.....	38
3.7 Art. 54 EPC - Novelty	44
4. Drafting the documents for a European Patent application	46
4.1 Basic requirements to be satisfied when drafting application documents	47
4.2 The mandatory content of an EP application	48
4.3 Art. 80 EPC – Date of Filing	49
4.4 Claims	50
4.4.1 Keep claims as broad as possible from the very beginning	51
4.4.2 Different categories of claim	53
4.4.3 Different independent claims within the same category	55
4.4.4 Consequences of R. 43 EPC	56
4.4.5 Functional features rather than structural features.....	57
4.4.6 Other aspects	57
4.5 Description	59
4.5.1 Description of the prior art.....	59
4.5.2 Technical problem	59
4.5.3 Description of the embodiment(s)	61
4.6 Drawings	61
4.7 Formalities.....	62
4.8 Claiming priority.....	62
4.8.1 History and problem	64
4.8.2 Conclusion.....	65
4.8.3 Consequences	66
5. Overview of the procedure up to grant of a European Patent.....	68
6. Ways to the European Patent	72
6.1 Direct filing with the EPO.....	73
6.2 Euro-PCT applications	74
6.2.1 PCT applications entering the regional European phase	79
6.2.2 Art. 157(7) EPC – Non-Unity and entering the EP regional phase from PCT	79
6.3 Divisional Applications.....	80

Table of Content

6.4	Suggestions regarding Prosecution of European Patent Applications	80
6.4.1	Avoiding of excessive Claim Fees.....	80
6.4.2	Multiple Independent Claims	81
6.4.3	Examination Phase	82
6.4.4	Entering European Regional PCT Phase before EPO (Euro-PCT).....	83
6.4.5	Amendments to the Claims in general	83
7.	European Search Report.....	84
7.1	Number of independent claims and European Search Report.....	87
7.2	Examination of European patent applications	88
7.3	Art. 124 EPC – Information on Prior Art	89
8.	Amendments to an EP application after filing	90
8.1	Inadmissible Broadening	91
8.2	Limiting extensions.....	93
8.3	Tests applied by the EPO.....	94
8.3.1	Novelty Test	94
8.3.2	Significance Test	94
8.4	Claim Construction	95
8.5	Unsearched Subject-Matter.....	96
8.6	Examples for permissible and impermissible amendments	96
8.7	Amendments after an official communication under R. 71(3) EPC	101
9.	Special aspects of chemical inventions.....	105
9.1	Drafting European Patent Applications for chemical inventions	105
9.1.1	Exceptions from the Two-part form of claims	105
9.1.2	Exceptions from the principle of one independent claim per category	106
9.1.3	"Comprising" vs. "consisting".....	106
9.1.4	Clarity requirements	107
9.1.5	Product by process claims	108
9.1.6	Sufficiency of disclosure.....	109
9.1.7	Unity of invention.....	110
9.2	Prosecution of European Patent Applications for chemical inventions	112
9.2.1	Novelty	112
9.2.2	Inventive step	117
9.2.3	Amendments of the application documents	120
10.	Accelerating and decelerating the EP examination proceedings.....	125
10.1	Acceleration in conjunction with the PACE-system	126
10.1.1	EP applications.....	126
10.1.2	Euro-PCT application	127
10.2	Other measures.....	128
10.3	Decelerating	129
10.3.1	Patent examination proceedings.....	129
10.3.2	Communication pursuant to R. 71(3) EPC	131
10.3.3	Filing a Divisional Application.....	132
11.	Opposition proceedings under the EPC.....	135
11.1	Basics.....	135
11.2	Opponent.....	135
11.3	Opposition Division.....	135
11.4	Grounds for opposition	136
11.5	Overview of the opposition proceedings under the EPC.....	137
11.6	Art. 115 EPC – Third Party Observations.....	143
11.6.1	Formal requirements	144

Table of Content

11.6.2	Treatment of observations.....	144
12.	Appeal proceedings under the EPC.....	146
12.1	Basics.....	146
12.2	Persons entitled to appeal and to be parties to appeal proceedings.....	148
12.3	Withdrawal of the appeal.....	148
12.4	Interlocutory revision.....	149
12.5	Overview of the appeal proceedings under the EPC.....	149
12.6	Possible decisions in respect of appeals.....	153
12.7	Organisational Autonomy of the EPO's Boards of Appeal.....	153
12.7.1	Current legal position.....	153
12.7.2	Creating a third organ of the European Patent Organisation.....	154
12.7.3	Co-operation Appeal Court - Office, seat of the Appeal Court.....	154
13.	Art. 112a EPC – Petition for review by the Enlarged Board of Appeal.....	155
14.	Art. 105a EPC – Request for limitation or revocation.....	157
15.	Differences between European and US patent practice.....	160
15.1	From “First to invent” to “first to file”.....	160
15.2	The “grace period”.....	160
15.3	The “Best mode requirement”.....	161
15.4	New definition of “prior art”.....	161
15.5	“Rights conferred by a granted patent”.....	161
15.6	Opposition after grant.....	162
15.7	Inventive step – non-obviousness.....	162
15.8	Two-part claims.....	163
15.9	Business Methods and Computer-Implemented Inventions.....	164
16.	Enforcement of Patent Rights in Germany.....	166
16.1	Legal basis.....	166
16.2	Types of patent infringement.....	167
(c)	Equivalent infringement.....	170
16.3	Rights of the patent proprietor.....	170
16.3.1	Claim to cease infringement.....	170
16.3.2	Compensation claim.....	170
16.4	Infringement proceedings.....	173
16.4.1	Pre-procedural actions.....	173
16.4.2	Procedural aspects of German infringement proceedings.....	174
16.4.3	Court proceedings.....	175
16.4.4	Decision and appeal.....	176
16.4.5	Interlocutory injunction.....	177
16.4.6	Patent Nullity Proceedings.....	178
17.	The New European Unified Patent System.....	183
17.1	Historical Background.....	183
17.2	The European Patent with Unitary Effect.....	183
17.3	The Unified Patent Court.....	184
	Appendix A: Request for grant (Form 1001).....	186
	Appendix B: Designation of inventor (Form 1002).....	194
	Appendix C: Notice of Opposition to a European Patent (Form 2300).....	196
	Appendix D: PACE request to the European Patent Office (Form 1005).....	200
	Appendix E: Request for limitation or revocation of an EP (Form 2380).....	201

Table of Content

[Appendix F: Rules of Procedure of the Boards of Appeal of the European Patent.....204](#)
[Appendix G: Rules of Procedure of the Enlarged Board of Appeal of
the European Patent Office.....210](#)