



FILING PATENTS IN EUROPE

A Practical Guide

miltons ip

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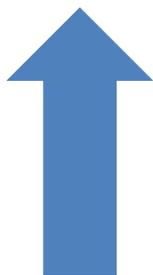
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SUMMARY



Approximately 150,000 patents per year are filed in Europe, and one half of them (75,000 per year) are filed by non-Europeans. With the coming unitary patent system expected to dramatically reduce the cost of national validations, we expect this number to increase rapidly.

Further, with the coming unified European patent court for litigation, we expect patent holders to be even more interested in securing protection in Europe.

1-800

Call toll free during regular business hours (eastern time) to speak direct to the Registered UK/EPO patent attorney handling your files.

\$ or €

We accept payment in US dollars and Euros, and we accept PayPal, VISA, MasterCard as well as checks and wire transfers.

\$700!

Our fee for filing. Great service, fair prices. Call, or go online to generate a firm price quotation.

UK & EPO

The choice is yours: we assist with EPO (European) and UK patents.

This guide provides clear answers to all of the key issues that non-European patent applicants and their attorneys will want to know prior to filing their application in Europe.

On our website, www.european-patent.biz you can generate a precise quote for filing a patent application into Europe (or the United Kingdom), access our detailed schedule of fees, and find detailed information on European patent law and practice.

Of course, we would be pleased to answer any questions. Contact us by phone or email at any time.

We look forward to serving you.

APPROXIMATE COSTS

THE COST TO FILE A PATENT APPLICATION IN EUROPE (EPO)

€1420

All European patent applications are subject to a patent office filing fee and search fee, total €1420, on filing the application.

€2220

Examination and designation fees will be €2220. For PCT applications, these fees are due on filing. For non-PCT applications, they must be paid not later than 6 months after the publication of the European search report.

+ +

Supplementary fees are due if the application is longer than 35 pages or contains more than 15 claims. There are no discounts for small entities on EPO fees.

\$700

Our standard fee for filing a European patent is \$700. Please contact us for volume discounts.

GENERATE A QUOTATION ONLINE AT WWW.EUROPEAN-PATENT.BIZ

We know that clients want price certainty. Our motto is ‘**no mysteries, no surprises**’, and this applies to our fees. On our website, www.european-patent.biz, you will find a price quotation calculator. By providing information about the specific application, you can use this calculator to generate a price for filing a specific application in Europe.

A copy of the quotation will be immediately emailed to you for your records.

Alternatively, if you contact us directly by email or phone with details of the potential application, we can generate and email you a firm price quotation for a specific application – usually within one business day.

THE NATURE OF A EUROPEAN PATENT

The European Patent Convention (EPC) provides a centralized procedure for the filing, examination and grant of patents for the 38 EPC member states (including all 28 member states of the European Union).

The applicant can pursue patent protection in all 38 EPC countries through a single application, in English (or French or German), filed with the European Patent Organisation (EPO).

Currently the situation is that after grant, a European patent matures into a 'basket' of national patents, each giving the same rights as a regular national patent in that country. In order for these national rights to have effect, the applicant/proprietor must validate the European patent in each country where he wishes the patent to have effect. Validation requirements are a matter of national law and differ from country to country, but commonly involve the appointment of a local representative as address for service and may require the filing of a translation of the patent, or just the claims, into the national language of that country. Depending on the countries selected, translation costs have historically contributed to high overall costs for validation in a large number of countries.

In recent years, validation costs for several countries have been reduced under an agreement whereby some countries, notably France, Germany and the UK, dropped the translation requirement and several others relaxed their rules to require translation of the claims only.

THE NEW UNITARY EUROPEAN PATENT

The European Parliament has reached agreement on the creation of a unitary European patent right which will confer protection throughout the participating countries of the European Union (EU) and on the establishment of a Unified Patents Court on which such unitary patents can be litigated centrally. The grant of the new unitary European patent will be the responsibility of the EPO. The new system will run in parallel with the existing European patent system: applicants will be able to choose between obtaining a unitary right and a basket of national rights or a combination of the two such as a unitary patent for the 25 EU member states which participate in the unitary patent scheme together with a classical European patent taking effect in one or more European Patent Convention states which do not participate in the scheme, such as Spain, Switzerland,

the United Kingdom etc. While having a central forum for enforcing the unitary European patent will simplify litigation and reduce litigation costs, it also potentially makes your patent vulnerable to central attack and invalidation.

Details of the new procedure are currently being worked out and have yet to be finalised. In particular, we have yet to learn how the fees for the unitary patent will be structured: this alone will likely have a significant effect on uptake of the new patent.

We expect however that the new rules to be finalized ‘soon’, and when they are this will make securing European patents easier and cheaper.

PROSECUTION, GRANT AND VALIDATION FEES

After filing comes prosecution – examination, and amendments as required prior to allowance. Further costs will be incurred at allowance, and after allowance, validation in the desired countries after grant unless you elect not to validate under the forthcoming unitary patent system.

Examples of other common fees are given below:

	Our Fee	Government Fee (Euro)
Reporting Office Actions	\$75+	-
Responding to an Office Action	\$275+	-
Requesting examination	\$300	€2220
Accelerated Examination	\$250	-
Annual maintenance fees (years 3, 4 etc.)	\$150	€470, €585 etc.
Allowance	\$550 + claim translations	€925
National validation after grant	\$350 per country + local associate’s fees	varies by country

Professional services such as advice on specific objections raised in Office Actions and drafting responsive amendments and arguments for filing with the EPO are charged

according to the time required. We will advise upcoming costs before expending chargeable time and provide a fixed price quote whenever possible.

FILING REQUIREMENTS

The requirements to initiate a PCT Regional Phase filing before the European Patent Office (EPO) are:

1. PCT Number;
2. Priority Date;
3. Filing fee.

If the applicant provides item 1, we can normally retrieve a copy of the specification directly from WIPO. However, if the PCT application was published in a language other than English, French or German, we will also require a translation of the specification into English, French or German.

Ultimately, your European patent attorney will also need:

1. **If priority is claimed, a copy of each priority application, certified by the authority with which it was filed.**
2. Instructions to pay the renewal fees, the first of which becomes due two years from the filing date of the European application.

DEADLINES FOR FILING PATENTS IN EUROPE

Absolute Novelty

Europe is an **absolute novelty** jurisdiction. Unlike in the United States, there is no grace period for disclosures made by the inventor prior to the filing of the first patent application that discloses the invention. Thus the European patent – or the patent it claims priority from – must have been filed before the invention was disclosed by the inventor to the public anywhere in the world.

Paris/Priority

Normal Paris Convention deadlines for priority apply.

PCT @ 31

The Deadline for entering the regional phase in Europe is 31 months from the earliest priority date, or from the International Filing Date if the PCT application does not claim priority.

REQUIREMENT TO APPOINT A REPRESENTATIVE

Non-European applicants for European patents must be represented by a registered European patent attorney, who is the sole person authorized to correspond with the EPO about the pending application.

POWERS OF ATTORNEY

There is no requirement for a power of attorney.

ASSIGNMENTS

If WIPO's records at the time of entry into Europe properly reflect the correct ownership, then no additional documentation of assignments will need to be filed. If this not the case or if the ownership of the patent changes after regional entry, then it is necessary to register an assignment. The EPO fee to register an assignment is €100.

An assignment of a European patent application must be signed by the assignor. The assignment does not need to be notarized.

It is **not** necessary to provide the original assignment for registration purposes in the EPO. A copy – for instance, a PDF – is sufficient.

EXAMINATION

The EPO conducts a prior art search for all European patent applications, including PCT regional phase applications.

Patent examination in Europe commences following the filing of a request for examination and payment of the examination fee by the applicant.

For both PCT and Convention applications, the examination request can be filed at any time from when the application is first filed with the EPO until 6 months after the publication of the European search report.

For a PCT regional phase, the examination fee must be paid on filing but examination does not commence until the applicant confirms his desire to proceed which must be done within 6 months of the publication of the supplementary European search report.

DEFERRAL OF EXAMINATION

No deferral of examination is possible in the EPO.

ACCELERATED EXAMINATION

It is relatively straightforward and inexpensive to request accelerated examination of a patent application in Europe.

No formal petition is required, nor is the applicant required to substantiate the request.

No additional fee must be paid.

THE PATENT PROSECUTION HIGHWAY (RARELY) – PACE (BETTER CHOICE)

The patent prosecution highway (PPH) is the name given to a series of bi-lateral agreements between national patent offices to mutually recognize successful prosecution in their respective offices. The EPO has a PPH agreement with the USPTO and is a party to a PCT-PPH agreement with the other “IP5” patent offices: the United States, Japan, Korea and China.

PPH is designed to accelerate examination at a second patent office where the same application has already been found allowable by a first patent office. However, since it is

rare for a corresponding application to have been allowed in another country before examination has commenced at the EPO (a requirement for requesting PPH) **PPH is not often of use at the EPO.**

Another reason for the limited uptake of PPH at the EPO is that the applicant is free in any case to amend the claims in conformity with an allowed corresponding application, and request accelerated examination under PACE, without invoking PPH.

For most applicants, PACE is the means to accelerate examination at the EPO, not the PPH.

If a corresponding application has been allowed (e.g. by the USPTO) please let us know: we will advise on the best strategy for the prosecution of your European application.

CLAIMS – COMMON VOLUNATRY AMENDMENTS AT FILING

There are significant differences between European patent practice and the practice in other jurisdictions including in particular the United States.

For many applicants the most significant difference relates to claims structure and acceptable claim drafting. For example, the EPO charges an additional filing fee for claims in excess of 15: €235 for the 16th to 50th claim, €585 for the 51st and each subsequent claim. However, multiple-dependent claims are permitted and count as a single claim only for claims fee purposes. Hence it is often possible to re-draft a US-style claim set to reduce the total number of claims without sacrificing subject-matter.

Some subject-matter which is patentable in other jurisdictions, such as methods of medical treatment, is excluded from patentability in Europe. However, therapeutic inventions may often be protected in Europe by utilising specific claim formats which do not fall within the statutory exclusion. Careful recasting of an application can often turn seemingly unpatentable subject matter into patentable claims.

We assist our clients by providing recommendations for potential re-drafting and re-structuring of the claims by way of voluntary amendment upon filing. Having claims that are drafted and structured consistent with European practice will reduce the filing fees dramatically, and will ensure much smoother prosecution.

MAINTENANCE FEES FOR EUROPEAN PATENTS

Maintenance fees (renewal fees) are payable in each year, both before and after grant.

The first payment is due 24 months from the international filing date. Prior to grant, the fees are payable to the EPO. After grant, renewal fees are payable to the respective national patent offices on the anniversary of the filing date.

Annual Renewal Fees (EPO fees)	
Year	EPO fee (€)
3	470
4	585
5	820
6	1,050
7	1,165
8	1,280
9	1,395
10 through 20	1,575

These fees are the government fees only and do not include the service fees – of our firm, or anyone else – who pays the maintenance fee on behalf of the applicant.

For example, our current services fees are \$150 per maintenance fee if paid in advance, \$200 if payment is received after we have paid the fee on behalf of the applicant. Please consult our schedule of fees for more information, or ask for a quote in advance. **Please contact us to discuss volume discounts.**

WHO CAN PAY THE MAINTENANCE FEES

Prior to grant, EPO renewal fees may be paid by anyone – either the agent of record, the applicant, or a third party. After grant, renewal fees are payable to the national patent offices which set their own rules as to who may pay fees. We can pay national renewal fees on your behalf through our network of local associates.

No mysteries, no surprises.

We make European patents straightforward.

ABOUT US

Miltons IP is a specialty intellectual property firm, with particular expertise in ‘making foreign filings straightforward’.

We serve serving clients with patent matters in Europe, the United Kingdom and Canada, as well as trademark and design matters in Canada. Our clients range from small startups to some of the world’s largest multinationals. The firm is headquartered in Ottawa, Canada.

We bring North American practicality to UK and European patents, with a registered UK/European patent attorney resident in Canada who is able to serve clients during normal business hours. We demystify European patents and make them as straightforward as possible for you and your clients. We even bill and accept payment in US \$. Learn more at European-patent.biz, and miltonsip.com