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# Legal Regime of the European Patents

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**Summary:** Authors describe the peculiarities of the modern regional patent systems, especially deal with the European regional patent system. The article focuses on the essence of the European patent, its special features as substantial step towards the integration of the worldwide unified patent system. The procedure for granting the European patent, requirements placed on the patentee and the extent of the exclusive rights are described in the article.

**Keywords:** EU, EU law, industrial property, invention, regional patent systems, the European Patent Organization, the European Patent Convention (EPC), the European Patent Office (EPO), European patent.

## 1. Introduction

The industrial property objects are protected by multilateral system of international legal protection of industrial property<sup>1</sup>. The system of international legal protection of industrial property includes international legal acts and activities of international organizations<sup>2</sup>. International legal protection of industrial property became necessary when foreign participants refused to take part in the international exhibition of inventions in Vienna in 1883 in order to prevent stealing of their ideas by other countries. In the same year the Paris Convention for the Protection of Industrial Property was adopted by 11 countries: Belgium, Brazil, France, Guatemala, Italy, the Netherlands, Portugal, El Salvador, Serbia, Spain and Switzerland (Guatemala, El Salvador and Serbia denounced and reapplied the convention via accession). It was the first main

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<sup>1</sup> Підпригора О. А., Святоцький О. Д. Право інтелектуальної власності: Академічний курс: Підручник для студ. вузів. — К: Ін Юре, 2004. — 672 с.

<sup>2</sup> Право інтелектуальної власності: Акад. курс: Підруч. для студ. вищих навч. закладів / О. П. Орлюк, Г. О. Андрощук, О. Б. Бутнік-Сіверський та ін.; За ред. О. П. Орлюк, О. Д. Святоцького. — К: Видавничий Дім «Ін Юре», 2007. — С. 325–329.

international treaty establishing a Union for the protection of industrial property. According to Articles 2 and 3 of the Convention, juristic and natural persons who are either national or domiciled in a state party to the Convention shall, as regards the protection of industrial property, enjoy in all the other countries of the Union, the advantages that their respective laws grant to nationals<sup>3</sup>. The Convention is currently still in force and nowadays 140 countries have become its members and members of the International Union for the Protection of Industrial Property the purpose of which is legal protection of juristic and natural persons of the states parties to the Convention in foreign countries. Another important international treaty adopted in the sphere of industrial property protection is the Patent Cooperation Treaty (PCT) done at Washington on June 19, 1970<sup>4</sup>. The Treaty defines a simplified patent application procedure for 146 countries worldwide. It enables inventors to file a single international application designating many countries, instead of having to apply separately for national or regional patents.

So, in the international phase an international search and international preliminary examination are performed. In the national or regional phase, the patent granting procedure is carried out by the relevant national or regional patent offices, for example the European Patent Office (EPO).

The key organizational structure in the sphere of intellectual property is the World Intellectual Property Organization (WIPO). WIPO is the global forum for intellectual property services, policy, information and cooperation; it is self-funding agency of the United Nations, with 188 member states. Its mission is to lead the development of a balanced and effective international intellectual property system that enables innovation and creativity for the benefit of all<sup>5</sup>. The system of international legal bodies includes organizations that protect the rights of industrial property, such as: the European Patent Organization<sup>6</sup>, the Eurasian Patent Organization (EAPO)<sup>7</sup>, the African Intellectual Property Organization (AIPO)<sup>8</sup> and the African Regional Intellectual Property Organization (ARIPO)<sup>9</sup>.

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<sup>3</sup> Paris Convention for the Protection of Industrial Property of March 20, 1883. Available at: [http://www.wipo.int/treaties/en/text.jsp?file\\_id=288514](http://www.wipo.int/treaties/en/text.jsp?file_id=288514).

<sup>4</sup> Patent Cooperation Treaty of June 19, 1970. Available at: <http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct.pdf>.

<sup>5</sup> World Intellectual Property Organization. Official web-site of WIPO is available at: <http://www.wipo.int/about-wipo/en/>.

<sup>6</sup> European Patent Organization. Available at: <https://www.epo.org/about-us/organisation.html>.

<sup>7</sup> The Eurasian Patent Organization. Available at: <http://www.eapo.org/en/>.

<sup>8</sup> African Intellectual Property Organization. Available at: <http://www.oapi.int/index.php/fr>.

<sup>9</sup> Organisation Africaine de la Propriété Intellectuelle. Available at: <http://www.aripo.org/>.

## 2. Regional Patent Systems

The European Patent Organization is an intergovernmental organization that was set up on October 7, 1977 on the basis of the European Patent Convention (EPC) signed in Munich in October 5, 1973<sup>10</sup>. Since 1973 the European Patent Organisation has grown to include 38 member states and two extension states (European patents can also be extended at the applicant's request to Bosnia-Herzegovina and Montenegro), covering an area with nearly 600 million inhabitants. It has two bodies, the EPO and the Administrative Council, which supervises the EPO's activities. The EPC's purpose is to facilitate the procedure of submitting patent applications: instead of submitting several patent applications in different languages to patent offices of different countries it is possible to submit one application in one language to EPO in order to obtain patents in European countries.

On September 9, 1994 in Moscow CIS countries (except of the governments of Uzbekistan and Turkmenistan) signed the Eurasian Patent Convention<sup>11</sup>. The Convention came into force on August 12, 1995 and its main purpose was to create an international regional system of legal protection of inventions on the basis of a common Eurasian patent with validity in all states parties to the Convention. The Convention's entry into force has created a unitary patent system throughout the territory of its states parties that provides for: a simple and inexpensive procedure for obtaining patents with validity in all states parties to the Convention (one Eurasian application in one language – one examination – a common Eurasian patent); strong Eurasian patents since all Eurasian applications have to undergo substantive examination; harmonised protection of the patentee's rights within a unitary patent area on the basis of the Convention and other related regulations. Ukraine has signed the Convention but did not ratify it, so the Eurasian patent's validity does not extend to its territory. However, juristic and natural persons of states not parties to the Convention may also apply and receive the Eurasian patent directly submitting to the Eurasian Office. The Eurasian patent system is organizationally shaped in the Eurasian Patent Organization and the Eurasian Office with headquarters in Moscow. The main task of the Organization and the Office is to secure legal protection of inventions in member states with a view to: upholding rights and legitimate interests of patentees, i.e. those who took part in the creation and

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<sup>10</sup> European Patent Convention of October 5, 1973. Available at: [http://documents.epo.org/projects/babylon/eponet.nsf/0/00E0CD7FD461C0D5C1257C060050C376/\\$File/EPC\\_15th\\_edition\\_2013.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/00E0CD7FD461C0D5C1257C060050C376/$File/EPC_15th_edition_2013.pdf).

<sup>11</sup> Eurasian Patent Convention of September 9, 1994. Available at: [http://www.eapo.org/en/documents/norm/convention\\_txt.html](http://www.eapo.org/en/documents/norm/convention_txt.html)

commercial use of inventions, as well as new products and processes embodying them; preserving and multiplying the intellectual, scientific, technological, innovation and industrial potential of its members in the face of strong competition in the global IP market; developing mutually beneficial cooperation with partners from other countries of the world in science, technology, trade, economy, patenting and licensing; as well as facilitating the flow of foreign innovative technologies and investment to the economies of the countries in the region; promoting rapid economic growth in its members on the basis of national and global intellectual resources. As part of this brief, the Eurasian Office has also made its information resources available to the third parties for free access to Eurasian and world patent documentation.

Patent Office of the member states of the African Intellectual Property Organization (AIPO) is located in Yaounde (Cameroon) and carries into practice legally significant functions in respect of applications and law-enforcement documents to certain industrial property object in the countries-members of AIPO, such as: Benin, Burkina Faso, Gabon, Guinea, Cameroon, Congo, Ivory Coast, Mauritania, Mali, Niger, Senegal, Togo, South Africa and Chad.

Patent Office of the countries-members of the African Regional Intellectual Property Organization (ARIPO) is located in Harare (Zimbabwe) and carries into practice legally significant functions in respect of applications and law-enforcement documents to certain industrial property object in the countries-members of ARIPO, such as: Botswana, Ghana, Zambia, Zimbabwe, Kenya, Lesotho, Malawi, Swaziland, Sudan and Uganda.

### **3. The European Patent as a Type of Regional Patents**

#### **3.1 The Essence of the European Patent**

Original ideas and creative work are assets which may be of commercial value in the same way as material goods. Establishing and protecting the ownership of ideas and their representation or application is the function of intellectual property rights such as patents, utility models, copyright, trademarks or designs and models. Patents are concerned with technical and functional aspects of inventions.

The word “patent” originates from the Latin “patere”, which means “to lay open”, i.e. to make available for public inspection. More directly, it is a shortened version of the term “letters patent”, which was a royal decree granting exclusive rights to a person, predating the modern patent system. Similar grants included land patents, which were land grants by early state governments in the

USA, and printing patents, a precursor of modern copyright. In modern use, the term “patent” is a set of exclusive rights granted by a sovereign state to an inventor or assignee for a limited period of time in exchange for detailed public disclosure of an invention. An invention is a solution to a specific technological problem and is a product or a process<sup>12</sup>. The term “patent” usually refers to the right granted to anyone who invents any new, useful, and non-obvious process, machine, article of manufacture, or composition of matter. Patents confer the right to prevent third parties from exploiting an invention for commercial purposes without authorisation. An invention can be, for example, a product, a process or an apparatus. To be patentable, it must be new, industrially applicable and involve an inventive step. The purpose of patents is not to establish long-term monopolies. They are granted for a limited period, which can only be extended in the case of medicines and pesticides which have to undergo lengthy clinical trials for safety reasons. The wide-ranging economic significance of patents derives from the fact that patentees can prevent third parties from commercially exploiting their inventions for up to 20 years from the date of filing of the application. This enables them to recoup their development costs and gives them time to reap the rewards of their investment. The applicant’s obligation to publish a full technical description of the invention contributes greatly to the dissemination of new technical knowledge. Over 80 % of the world’s technical knowledge can now be found in patent documents<sup>13</sup>.

The procedure for granting patents, requirements placed on the patentee, and the extent of the exclusive rights vary widely between countries according to national laws and international agreements. Typically, however, a granted patent application must include one or more claims that define the invention. A patent may include many claims, each of which defines a specific property right. These claims must meet relevant patentability requirements, such as novelty, usefulness, and non-obviousness<sup>14</sup>.

The patent’s special feature is its territorially limited validity: it is valid exclusively in the territory of the state the patent office of which issued this document. However, there are exceptions – so-called regional patents as one of the ways to patent somebody’s decision in foreign countries. The essence

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<sup>12</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. Chapter 2: Fields of Intellectual Property Protection. Available at: <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch2.pdf>.

<sup>13</sup> European patents and the grant procedure. Available at: [http://documents.epo.org/projects/babylon/eponet.nsf/0/e6ce616afbb87afac125773b004b93b5/\\$FILE/EPO\\_EuroPatente13\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/e6ce616afbb87afac125773b004b93b5/$FILE/EPO_EuroPatente13_en.pdf)

<sup>14</sup> Patents: Frequently Asked Questions. Available at the official web-site of WIPO: [http://www.wipo.int/patents/en/faq\\_patents.html#protection](http://www.wipo.int/patents/en/faq_patents.html#protection).

of regional patent system is that certain countries of the region (for example, Europe, CIS, Asia or Africa) sign a treaty determining a possibility to receive a single patent with validity in all countries of the region. Regional patent is a patent granted by the regional patent offices, in particular: the European patent (with validity in the majority European countries), Eurasian patent (with validity in CIS), AIPO's patents and ARIPO's patents (with validity in the majority countries of Africa).

### **3.2 The Grant Procedure**

Under the law of the EPC, patents are only granted for inventions that are new, that involve an inventive step and that are industrially applicable. An invention meets these requirements if it was not known to the public in any form prior to the date of filing or to the priority date, was not obvious to a skilled person and can be manufactured or used industrially. Discoveries, mathematical methods, computer programs and business methods as such are not regarded as inventions. Surgical and therapeutic procedures along with diagnostic methods practised on the human or animal body are excluded from patentability. New plant or animal varieties are completely excluded from patentability. EPC does not recognise inventions whose commercial exploitation would be contrary to "ordre public" or ethical principles, such as means of cloning human life or the use of human embryos for commercial and industrial purposes. The cost of a European patent depends very much on the number of designated states and the planned term of the patent<sup>15</sup>.

All the states parties to the EPC offer the possibility, as a first step, of applying for a national patent. Filing an application with a national patent office has the advantage that entry to the procedure is relatively cheap and that applicants can deal with a patent authority in their own language. If they decide that they also need protection in other countries, they have twelve months from the date of first filing to file applications for the same invention elsewhere. They can claim the priority of the date of first filing for such subsequent applications. A European patent application can claim the priority of a national application or, as is less commonly the case, may itself be a first filing. A European application can also be derived from an international application filed under the PCT.

European patent applications can be filed at the EPO in Munich, The Hague or Berlin or at the central industrial property office of any contracting state.

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<sup>15</sup> European Patent Convention of October 5, 1973. Available at: [http://documents.epo.org/projects/babylon/eponet.nsf/0/00E0CD7FD461C0D5C1257C060050C376/\\$File/EPC\\_15th\\_edition\\_2013.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/00E0CD7FD461C0D5C1257C060050C376/$File/EPC_15th_edition_2013.pdf).

They may be filed online, by post or by fax or delivered in person. European patents are granted by the EPO in a centralised and thus cost-effective and time-saving procedure conducted in English or French or German, its three official languages. They have the same legal effects as national patents in each country for which they are granted. Therefore if it was filed in any other language, a translation in English, French or German needs to be filed within two months. Every European patent undergoes substantive examination and can be obtained for countries which otherwise have “registration-only” systems, thus providing strong protection. The term, scope of protection, binding text and grounds for revocation of European patents are the same for all contracting states to the EPC.

European patent applications consist of four or five parts: 1) a request for grant; 2) a description of the invention; 3) one or more claims; 4) any drawings referred to in the description or the claims; and 5) an abstract. After filing, the subject-matter of a European patent application cannot be extended beyond the content of the application as filed.

The description of the invention must describe the invention clearly and completely enough for a person skilled in the art to be able to carry it out. The description forms the basis for the claims. The claims must define the subject-matter for which patent protection is sought in terms of its technical features. They must be clear and concise and be supported by the description. The application may also contain drawings. These form a useful addition to the description when they illustrate the features of the invention. The abstract is purely for technical information and is not used to assess the patentability of the invention.

The first step in the European patent grant procedure is the examination on filing. This involves checking whether all the necessary information and documentation has been provided so that the application can be accorded a filing date. The following are required: an indication that a European patent is sought, particulars identifying the applicant and a description or a reference to a previously filed application. If no claims are filed, they need to be filed within two months. This is followed by a “formalities” examination relating to certain formal aspects of the application, including the form and content of the patent application, the translation, the designation of the inventor, the appointment of a professional representative and the payment of fees due. In parallel with the formalities examination, a European search report is drawn up, listing all the documents available to the Office that are considered relevant for assessing novelty and inventive step. The search report is based on the patent claims but also takes into account the description and any drawings. Immediately after it has been drawn up, the search report is sent to the applicant, together with

a copy of any cited documents and an initial opinion on whether the claimed invention and the application meet the requirements of the EPC.

The application is published – normally together with the search report – 18 months after the date of filing or the priority date. Applicants then have six months from the date of mention of publication of the search report to respond to the extended European search report and to decide whether or not to pursue their application by requesting substantive examination. Alternatively, an applicant who has requested examination already will be invited to confirm whether the application should proceed, unless he has waived this invitation. From the date of publication, a European patent application confers provisional protection of the invention in the states designated in the application as published. However, it may be necessary under national law to file a translation of the claims with the patent office in question, and to have this translation published.

After the request for examination has been made, the EPO examines, in the light of the search report and taking into account the applicant's reply to it, whether the European patent application and the invention to which it relates meet the requirements of the EPC, and in particular whether the invention is patentable. The grant will, however, not be issued before translations of the claims into the other two official languages have been filed and certain fees paid. An examining division consists of three examiners, one of whom deals with the application up to the point at which a decision is made to grant a patent or to refuse the application. This examiner maintains contact with the applicant or representative and issues the necessary communications on behalf of the division. The final decision on the application is taken by the examining division as a whole. This ensures maximum objectivity for the applicant<sup>16</sup>.

The granted European patent is a “bundle” of individual national patents. In many contracting states, for the patent to retain its protective effect and be enforceable against infringers, it must be validated. That means that where necessary, the patent owner has to file a translation of the specification or at least of the claims into an official language of that state with the national patent office. Fees may also be payable by a certain date. These matters are governed by national law.

After the European patent has been granted, it may be opposed by third parties – who will usually be the applicant's competitors – if they believe that it should not have been granted (for example, because the invention lacks novelty or does not involve an inventive step). Notice of opposition must be filed

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<sup>16</sup> Richard Howson, Points and prizes, or how to Play Your Cards Right at the European Patent Office, *Journal of Intellectual Property Law & Practice*, 2007 2(3):170–173.



within nine months of grant being mentioned in the “European Patent Bulletin”. The examination of oppositions is handled by the EPO’s opposition divisions, which are usually also made up of three examiners. After publication of an application, third parties may present observations on the patentability of the invention to which the application or patent relates, as long as proceedings are pending before the EPO.

The patent proprietor may request limitation or revocation of the patent at any time after it has been granted.

The EPO’s decisions concerning issues such as the refusal of an application or opposition matters are open to appeal. Decisions on appeals are taken by the EPO’s independent boards of appeal<sup>17</sup>.

At the post-grant stage, competence is transferred to the contracting states designated in the European patent. Some of these countries require a translation of the patent specification, or at least of the claims, if the patent has not been granted in one of their official languages. Since translation costs can be considerable, applicants should use market analyses to pinpoint the countries for which they really need protection. The overall cost of obtaining a European patent will generally include fees for the services of a patent attorney. Further details of these costs can be obtained from any patent attorney authorised to act as a professional representative before the EPO<sup>18</sup>.

The detailed scheme and timeline of the European patent application are described as below<sup>19</sup>.

## 4. Conclusions

The exclusive right granted to a patentee in most countries is the right to prevent others, or at least to try to prevent others, from commercially making, using, selling, importing or distributing a patented invention without permission.

The European patent is an essential step towards the integration of the worldwide unified patent system. With one unique European patent application, drafted in only one official language (English, French or German) and

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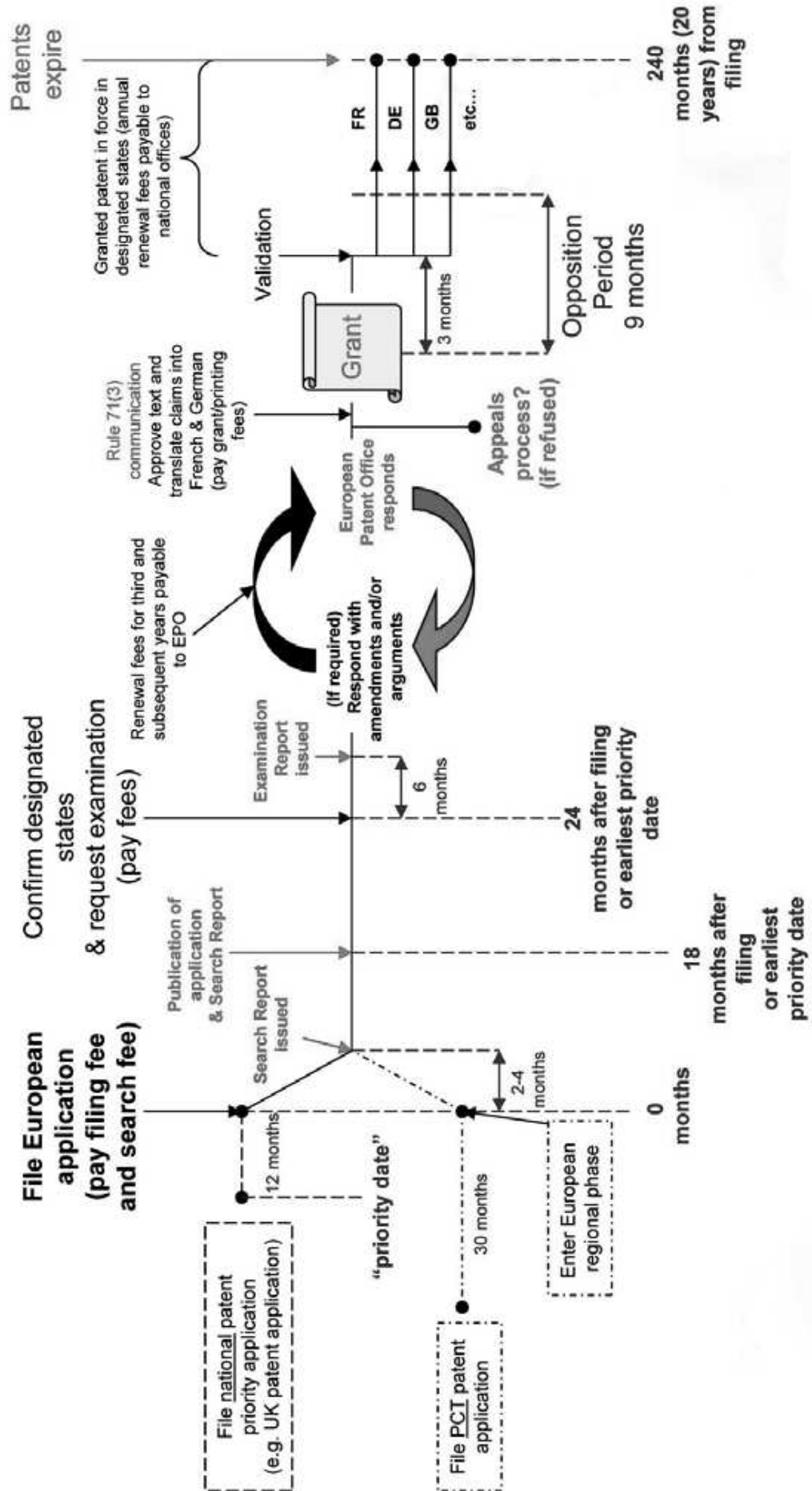
<sup>17</sup> The Patenting Process. Available at the official web-site of the European Patent Organization: <http://www.epo.org/learning-events/materials/inventors-handbook/protection/patents.html>

<sup>18</sup> European patents and the grant procedure. Available at: [http://documents.epo.org/projects/babylon/eponet.nsf/0/e6ce616afbb87afac125773b004b93b5/\\$FILE/EPO\\_EuroPatente13\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/e6ce616afbb87afac125773b004b93b5/$FILE/EPO_EuroPatente13_en.pdf)

<sup>19</sup> Timeline of a European patent application. Available at: <http://www.hgf.com/media/25513/Tipmeline-of-a-European-patent-application.pdf>.

# European Patents

## Application Procedure



filed in one filing office, the steps of the grant procedure (publication and examination of the application) can be unified. Once granted by the EPO, the European patent becomes a bundle of national patents in accordance with the designations chosen by the applicant at the filing date.

The aim is to make the protection of inventions in the member countries cheaper and more reliable by creating a single procedure for the grant of patents. Filing and prosecuting an application at a regional granting office is advantageous as it allows patents in a number of countries to be obtained without having to prosecute applications in all of those countries. Moreover, it has the advantage that it involves only one administration, specifically the EPO which manages the procedure and grants European patents, with the resulting unification of administrative proceedings and requirements. So, the advantages of this regulation for juristic and natural persons wishing to register a unitary European patent are: 1) one application is enough to guarantee the protection of its patent in the 25 participating member states; 2) the application for the 25 participating member states can be filed in one of the three official languages; 3) there is no need to translate the application into each national language; 4) the cost will be drastically reduced by avoiding the translation costs and by establishing a unique annual tax. The disadvantage is that within nine months from granting the European patent third parties can file opposition at the EPO. If the opposition results in the patent being refused or restricted in scope, this is effective in all of the member countries chosen.