



Patent Analysis

Part 2: EPC – European Patent Convention


Disclaimer
This presentation is intended for general discussion purposes only and should not be taken as a legal advice.

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EPC – European Patent Convention

- **Article 52(1) EPC**



Patentable Inventions

European patents shall be granted for **any inventions, in all fields of technology**, provided that they

- are new
- involve an inventive step and
- are susceptible of industrial application


→ A.52(2)(3)

→ A.54

→ A.56

→ A.57

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- **Article 52(2/3) EPC**

- What is not an invention?

The following, in particular,
shall not be **regarded as** inventions:

- a) discoveries, scientific theories, mathematical methods;
- b) aesthetic creations;
- c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- d) presentations of information;

...only to the extent to which a European patent application relates
to such subject matter or activities as such.

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- **Inventions**

An **invention shall be considered to be new** if it does
not form part of the state of the art.

A.54(1)

An **invention shall be considered to be involving an
inventive step** if (...) it is not obvious (...)

A.56

An **invention shall be considered as susceptible of
industrial application** if it can be made or used (...)

A.57

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- Inventions

The European patent application shall relate to one invention only or to a group of inventions forming a single general inventive concept.

A.82

The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

A.83

The European patent application or European patent **may not** be amended in such a way that it contains subject-matter which extends beyond the content of the application **as filed**.

A.123

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inTT

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- Examination at European Patent Office (EPO)

Claimed Subject-Matter

↓

Invention?

↓ No

Objection:
lack of technical character

Yes

Check:

- novelty
- inventive step
- sufficiency of disclosure
- further requirements...

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- **Inventions**

An **invention shall be considered to be new** if it does not form part of the state of the art.

A.54(1)

The concept of "novelty" in Article 54(1) EPC is only defined for "inventions". It does not apply to the exceptions enumerated in Article 52(2) EPC.

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- **Inventions**

An **invention shall be considered to be involving an inventive step** if (...) it is not obvious (...)

A.56

Would the skilled person aware of the prior art at the date of filing have been prompted to arrive to the claimed invention in an obvious manner ?

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- Inventions

An **invention** shall be considered as susceptible of industrial application if it can be made or used (...)

A.57

Almost always the case, only exception: **perpetuum mobile**

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- Inventions

The European patent application shall disclose the invention in a manner sufficiently **clear and complete** for it to be carried out by a person skilled in the art.

A.83

Claiming by result: **usually not possible!**

Wishful thinking: not allowed

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- **Inventions**

The European patent application or European patent **may not** be amended in such a way that it contains subject-matter which **extends beyond the content** of the application as **filed**.

A. 123(2)

Article 123 EPC is a cornerstone of the EPC to ensure the fairness in the fundamental contract for the public.

The underlying idea of Art. 123(2) is that an applicant shall not be allowed to improve his position after the specific date of assertion of right (ie. the filing date), which would give him an unwarranted advantage and damage the legal security of third parties.

What is forbidden ?

Filing information which is not directly and unambiguously (effortless) derivable from the original application documents.

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- **Inventions – what is necessary?**
- Patent can only be granted if **ALL requirements** of the EPC are met.
 - claims need to involve an inventive step; Article 56 EPC
 - sufficiency of disclosure; Article 83 EPC
 - no subject-matter may be added; Article 123(2) EPC

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• Inventions – what is not an invention?

So what's the difference?

CD: 700 MB Opera: 2 CDs
DVD: 4.7 GB Opera: 1 DVD

What's the effect thereof?

Less to ship

 The claimed subject-matter is **NOT INVENTIVE**.
Only one of the obvious possibilities offered to the skilled person.

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• Inventions – some numbers

Rank	Country	% of World Market	PCT Nat. Phase Cost (US\$)	Translation Cost (%)
1	USA	45.83	3,287	0
2	EPO (+ Extension States)	25.05	13,623	0
3	Japan	12.35	17,382	66
4	Canada	1.87	2,440	0
5	Mexico	1.76	7,351	57