



# **Recent Trends in European Patenting**

## **Relevance for Indian Applicants**

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# What changes are coming at the EPO ?

## → Raising the bar

- **Fee structure:** Increased Fees
- **Divisional Applications:** stricter rules
- **Faster Prosecution:** earlier response required
- **Raising the bar:** Inventive Step

## Increased Claim Fees

- Until March 31, 2008:  
10 claims free, EUR 45 for each additional claim
- Beginning April 1, 2008:  
15 claims free, EUR 200 for each additional claim
- Beginning **April 1, 2009**  
15 claims free, **EUR 200 for each additional claim up to the 50th claim**, EUR 500 for each claim beginning with the 51st claim
- Increases applicable to all EP applications filed or entering the regional phase from a PCT beginning April 1, 2008/2009

## Dramatic Increase in Cost for larger number of Claims

- Amount of Claim Fees
  - ◆ Total of 40 claims:
    - ★ Until March 31, 2008: EUR 1,350
    - ★ As of April 1, 2008: EUR 5,000
  
  - ◆ Total of **60 claims**:
    - ★ Until March 31, 2008: EUR 2,250
    - ★ As of April 1, 2008: EUR 9,000
    - ★ As of April 1, 2009: **EUR 12,000**
  
- Prohibitive cost of larger number of claims **requires careful claim drafting** to obtain maximum protection with a minimum number of claims.

## How to minimize costs

- Careful condensing of claim sets that comprise a high number of claims by using
  - multiple dependencies
  - alternatives in one claim → “or”
  - use “lower” claim categories (medical use) that are dependent on a subset of „higher“ claim categories (product, formulation)
- → you need a good patent attorney in Europe, who can minimize the costs in official fees for you

## Divisional Applications

- New Rules 36 (1) and (2) EPC enter into force on April 1st, 2010
- 24 month deadline from the date of the first examining communication for the earliest application, or
- 24 month deadline from the first unity objection
- Transitional Provision: Deadline **October 1st, 2010**

## Faster Prosecution

- Earlier response required: New Rule 70a EPC as from **April 1st, 2010**
- You need to file a response to the Extended European Search Report

Comments on Patentability given in the European Search opinion need to be answered

## Raising the bar – Inventive Step

- Art. 56 EPC

*“An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is **not obvious to a person skilled in the art**”.*

- EPO: The problem-solution approach

- It has already become more difficult to take the hurdle of inventive step

→ good communication with patent attorney in Europe is absolutely necessary !!

## Alternatives to EP patent applications

- National entry into **Germany** from a PCT application

i.e. not regional EP phase, but national phases of particular interest, e.g. Germany

- The national **utility model** ("small patent")

e.g. the German utility model

→ fast, easy, not expensive,  
as powerful as a patent

## Alternatives to EP patent applications

- National entry in **Germany** from a PCT application  
30-months deadline,  
translation into German required,  
language of proceedings will be German
- The national **utility model**  
(„small patent“, 10 years duration, no methods),  
can be branched off a pending PCT application,  
granted straight away, no substantial examination,  
→ immediately enforcable,  
  
→ in addition to / or as an alternative to a patent  
  
→ fast, easy, not expensive, as powerful as a patent

## **CONCLUSION: what changes at the EPO ?**

→ **Raising the bar**

- **Fee structure:** Increased Fees
- **Divisional Applications:** stricter rules
- **Faster Prosecution:** earlier response required
- **Raising the bar:** Inventive Step

→ **Talk to Patent Attorney in Europe !!**

**Good communication absolutely required**

**IP is a true service business**

**Thank you for your attention!**

