



POST-GRANT DEVELOPMENTS IN EUROPE

BY DR CHARLES HARDING AND DR STEPHANIE WROE, D YOUNG & CO LLP

The European Patent Office (EPO) has introduced new procedures to reduce the duration of straightforward opposition cases from between 19 and 27 months, to just 15 months. To achieve this, the EPO has reduced the internal handling time from 11 months to five months, and shortened deadlines for the parties. At the same time, the EPO has given parties more time to react to the summons to oral proceedings and to prepare for oral proceedings.

Key changes include the following:

Restrictions on extensions

Patentees are still to be given four months to reply to an opposition, but now extensions will only be granted in exceptional circumstances.

Reductions in the procedures once the patentee's reply is received

Opposition divisions will now prepare the next action once a patentee's reply is received. It is likely that the next action will be the summons to oral proceedings together with a preliminary, non-binding opinion.

at AusBiotech's International BioFest

Opponents may still file a response to the patentee's reply but there is no longer a deadline. Since the opposition division can prepare the next action as soon as the patentee's reply is received, we would advise that opponents file any further observations as soon as possible.

At least six months advanced notice of oral proceedings
Parties will be given a deadline of two months (rather than one month) before oral proceedings to file any further written submissions.

The EPO is moving towards disregarding facts or evidence not submitted by parties in due time, unless they are of prima facie relevance. We strongly recommend that parties present all documents, requests and data at the earliest opportunity.

EPO tightens up appeal proceedings

The EPO boards of appeal have also taken steps to increase the efficiency and reduce the length of appeal proceedings. The EPO wants a comprehensive submission from each party at the outset.

It is not uncommon to find the EPO boards of appeal restrictive in the admissibility of new documents, requests and data submitted during the appeal. Often, anything that is not of prima facie relevance will be disregarded as late-filed. A board of appeal may not allow a patentee to file an amended claim set if the board considers that it could have been filed during the opposition procedure. Therefore, we recommend that patentees ensure that auxiliary request claim sets are placed on file during the opposition.

The effect of Brexit on the unitary patent (UP) and the Unified Patent Court (UPC)

With the United Kingdom having voted to leave the European Union (EU), the UPC and UP project is inevitably delayed, and may even be in doubt. The United Kingdom was an integral participant, and its ratification of the UPC Agreement was necessary for the commencement of the UPC provisional application period and full commencement.

There are three possible outcomes, which are as follows:

1. The United Kingdom does not ratify the UPC Agreement while it remains in the EU, and then leaves the EU.

This seems to be a likely scenario. In this case, the remaining UP/UPC participating member states will have to revise the UPC Agreement and Protocol. This outcome means delay, probably until sometime after the United Kingdom leaves the EU. It may also mean the end of the project if it is felt to be unattractive without the United Kingdom.



Stephanie Wroe



Charles Harding

2. The United Kingdom ratifies the UPC Agreement, then leaves the EU and the UP/UPC project.
Politically, this seems unlikely because it requires the United Kingdom to ratify essentially an EU treaty when it has voted to leave the EU. It will also create problems with UPs post actual Brexit (their scope would suddenly reduce) and any UPC judgements/orders that affect the United Kingdom.
3. The United Kingdom negotiates continued participation in the UP/UPC project, despite leaving the EU.

It is unclear whether this is legally possible. In addition, because the UPC Agreement provides for supremacy of EU law, this also looks politically tricky. It would also create new complications since it ought to open the door to other non-EU (but European Economic Area or European Free Trade Association) states such as Norway, Switzerland and Iceland, which have not been allowed to participate so far. This outcome also seems unlikely.

It is worth emphasising that Brexit does not change United Kingdom national rights—or right of representation of United Kingdom-based European patent attorneys—under the European Patent Convention (EPC).

Brexit will also not affect the EPC because it is a treaty separate from the EU. The United Kingdom will continue to be a member of the European patent system, and United Kingdom-based European attorneys will continue to act in the usual way before the EPO. Patent protection in the United Kingdom will continue to be available via the EPO by validating granted European patents in the United Kingdom after grant.

The EPC still represents good value for money for obtaining patent protection in European countries with up to 42 countries represented. 🌍

Charles Harding will be speaking at the 17th International Biotechnology Symposium (IBS 2016).

