

A change of pace

Important Changes and Reforms for European Patents



The European Patent Convention 2000 (EPC 2000) signed in 29 November 2000 is a revision of the European Patent Convention and the implementing regulations that came into force on 13 December 2007. Most of the changes affect the practice and procedure of the European Patent Office (EPO), while some of the changes are of a more substantive nature impacting the patentability of inventions.

Changes to State of the Art

To be patentable under the EPC, an invention must be “novel” or new in terms of the state of the art. For a later filed European patent application, the state of the art impacting novelty included any earlier filed European patent application that was later published (“a conflicting patent application”) to the extent that the two patent applications designated the same contracting states. This was so even though the conflicting patent application was not publicly available when the later patent application was lodged. This prevented double patenting of an invention in the same contracting state of the EPC. A conflicting patent application does not form part of the state of the art for assessing the inventive

step of the invention claimed in the later application.

Under the EPC 2000 changes, the requirement for identical designations is abolished for new European patent applications. The state of the art includes earlier filed applications that are published regardless of the designations.

Purpose Limited Product Protection for Second Medical Use

Product protection is available under the EPC 2000 changes for second and further medical uses. An example of this claim format is: “compound ABC for treating disease XYZ”. This is a claim format that is available in addition apparently to the well-established Swiss-style claim format for second use: “use of compound ABC in the manufacture of a medicament for treating disease XYZ”.

New Practice for According Filing Date

Several EPC 2000 reforms have made it simpler for a new European patent application to be accorded a filing date. The patent application must indicate that a European patent is sought, identify the applicant or provide information permitting the applicant to be contacted, and provide a written description of an invention or a reference to a previously filed European patent application. Significantly, the description of the invention or reference can be in any language now.

Furthermore, at filing, a European patent application no longer must have at least one claim and designate at least one contracting state to be accorded a filing date, as was previously the case. However, a prudent patent applicant would file a European patent application with a complete set of claims to ensure the fullest possible protection can be obtained and avoid other problems.

Filing Missing Parts

If a European patent application is filed but is incomplete, the EPO informs the applicant of the missing parts. Under the new changes, missing parts of the description and drawings

can be submitted. The missing materials must be submitted within one month of a communication from the EPO about the missing parts. However, the EPO may re-date the patent application to the date of receipt of the missing parts, unless the missing materials are completely contained in any priority document from which the European patent application claimed the benefit of an earlier filing date. If the EPO re-dates the European patent application, the applicant can withdraw the missing parts that were filed within one month of the EPO communication about the re-dating and thereby retain the earlier filing date.

Priority Claiming

The ability to claim the benefit of the filing date of an earlier filing date is now extended to patent applications filed in or for any member of the World Trade Organization (WTO), as well as any state party to the Paris Convention for the Protection of Industrial Property. Under the EPC 2000 changes, if the 12-month deadline for claiming priority is missed, an applicant can still make a priority claim if the European patent application is filed no later than 14 months after the earliest priority date and a request for reinstatement of rights is made. Also, the priority declaration can now be corrected within 16 months of the earliest filing date. Further, a translation of the earlier filed application is no longer required unless requested by the EPO.

Further Processing

In certain circumstances previously, missing a deadline resulting in a total loss of rights could be remedied under the “further processing” mechanism of the EPC. Further processing is now extended to deadlines set by the EPC and those set by the EPO where only a partial loss of rights is involved. However, not all missed deadlines can be remedied using further processing if those deadlines are excluded by the EPC.

Supplementary Searches

An applicant of an International (PCT) patent application designating the EPO and

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containing claims directed to more than one invention is advised to have all claims searched by the International Searching Authority. For any national phase entry of the International patent application filed at the EPO, the EPO conducts a supplementary search of one set of claims searched in the International patent application where the claims lack unity of invention. Previously, an applicant could request the EPO to search claims in a European patent application that were not searched by the International Searching Authority, but this is no longer possible.

By having all claims searched in the International patent application, the applicant can ensure to have the broadest scope to choose the first set of claims in the European patent application that will be searched by the EPO in the supplementary search. Other claims directed to one or more other inventions can be the subject of a divisional patent application.

Requests for Limitation or Revocation

The EPC 2000 changes introduce a procedure at the EPO for centrally limiting or revoking a European patent at any time during the term of the European patent.

A number of other revisions have been introduced by the EPC 2000 reforms, but are not discussed here since they are likely to be less frequently encountered by most applicants of European patent applications.



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One of Spruson & Ferguson's clients, and the winner of the University of Sydney's 2006 Spruson & Ferguson Intellectual Property Strategy Prize, BioPower Systems Pty Limited, has recently been awarded a \$5 million grant under the Australian Government's AusIndustry Renewable Energy Development Initiative (REDI). The REDI grant will be matched by BioPower to fund a \$10.3 million, two-year project involving the deployment and ocean-testing of the company's wave and tidal current energy converters. The company has also received cornerstone funding from CVC REEF Limited, the Federal Government's Renewable Energy Equity Fund.

BioPower System's ocean power conversion technologies are based on the concept of biomimicry, using

biological species as inspiration in engineering design. The bioWAVE wave power system and bioSTREAM tidal power system are visibly reminiscent of sea plants and swimming species. The inventor of these ocean power technologies, BioPower's Chief Executive Officer, Dr. Tim Finnigan, said: "Some of the traits that we observe in large sea plants and fish provide us with clues on how to design machines that will function well in the ocean environment, convert energy efficiently, and survive in the worst storms."

BioPower plans to build and install full-scale, 20-metre prototypes of both its wave and tidal-stream systems, each capable of generating enough power to supply up to 500 homes. BioPower has identified two preferred sites in Tasmania. BioPower has conducted preliminary site investigations at King Island as a location for testing of the bioWAVE, and at Flinders Island as a location for testing the bioSTREAM. At both locations, the company proposes 250kW installations supplying power into Hydro Tasmania's distribution system on the islands. Both islands rely on diesel-fired generators and wind for power supply, so the project could further reduce greenhouse gas emissions through the addition of carbon-free renewable energy.

Spruson & Ferguson extends its congratulations to Tim Finnigan and the team at BioPower Systems on its successes to date and wishes the company well in its upcoming full-scale ocean testing.

Further information on BioPower is available at www.biopowersystems.com.

