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Patent Protection in Europe from an American Perspective

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Some Significant Differences

- Obtaining Geographic Coverage
- First-to-File v. First-to-Invent
- One-year Grace Period
- Best Mode
- Post-grant Opposition
- Special Matters: Software & Biotech

Obtaining Geographic Coverage

Question: How does one obtain full geographic patent coverage in Europe and the US?

- US – Any patent issued by the USPTO is effective throughout the entire United States.
- Europe – the European Patent Office, an administrative body of the European Patent Organization (EPO), examines patent applications for 32 member states and 4 extension states.

EPO Member States

Austria	Greece	Netherlands
Belgium	Hungary	Poland
Bulgaria	Iceland	Portugal
Cyprus	Ireland	Romania
Czech Republic	Italy	Slovakia
Denmark	Latvia	Slovenia
Estonia	Liechtenstein	Spain
Finland	Lithuania	Sweden
France	Luxembourg	Switzerland
Germany	Malta	Turkey
	Monaco	United Kingdom

Obtaining Geographic Coverage

- Europe
 - EPO **not** co-extensive with European Union
 - EPO extension states:
 - Albania
 - Bosnia and Herzegovina
 - Croatia
 - former Yugoslav Republic of Macedonia
 - Serbia

Obtaining Geographic Coverage

- Europe – grant process
 - If the European Patent Office determines that a patent can be granted, mention of the patent grant is published.
 - The grant represents a bundle of individual national patents.
 - In order for the patent to be enforced in particular member states, Applicant must validate the patent according to each member state's national law.

Obtaining Geographic Coverage

- Europe
 - Validation often requires payment of fees and translations.
 - It may be cheaper to file a direct national application.

First-to-File v. First-to-Invent

Question: Who gets priority of invention when two inventors submit the same invention to the Patent Office?

- US – First to Invent
- Europe – First to File

First-to-File v. First-to-Invent

- Europe – First to File
 - First to file is awarded patent
 - Regardless if person who files second invented first – only filing date matters
 - Motivates inventors to file on their inventions quickly
 - US is considering moving to a first-to-file system

One-Year Grace Period

Question: What happens when you invent something, go to a conference and make a presentation regarding the invention, and then file a patent application?

- US – not a problem as long as you file the application within one year (35 U.S.C. § 102)
- Europe – no grace period

Best Mode

Question: Is it required to disclose the best mode of practicing the invention at the time of application?

- US – Yes
 - 35 U.S.C. § 112 – technical requirement of providing best mode of practicing the invention
 - Fair exchange between the public and the inventor

Best Mode

- Europe – No
 - No best-mode requirement
 - Must offer at least one way of practicing the invention, but need not be the best way (Art. 83, EPC)

Post-Grant Opposition

- US – Re-examination
 - *Ex parte*
 - Patent owner or third party can request.
 - Evidence based only on patents and printed publications.
 - Third party does not participate beyond submission of evidence and in response to an optional pre-examination statement.
 - *Inter partes*
 - Requestor and evidence same as *ex parte*.
 - Third party can participate by responding each time the patentee responds to an action by the US PTO on the merits during examination of the patent.
 - Third party can participate as litigant in BPAI and Fed. Cir. appeals.

Post-Grant Opposition

- Europe – Post-grant opposition
 - Can be filed as late as 9 months after grant of patent.
 - Opposition process – administrative.
 - Opposition filed with all arguments and evidence to EPO.
 - First response is within 4 to 6 months of notice.
 - EPO decides after reviewing correspondence and hearing oral argument.
 - Either party can appeal EPO decision.
 - Successful opposition knocks out patent in all European countries applied toward.
 - Cost-effective strategy for attacking a patent in Europe.
 - Usually takes 2 to 5 years; appeal often takes just as long.

Special Matters: Software

- US – Fully patentable
 - Needs to meet §§ 101-103, 112 requirements just like any other patent application.
 - *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998).
 - No business-method exception to patentability.
 - Don't focus on subject matter but rather utility, novelty, and non-obviousness.
 - Useful, concrete, tangible result required.

Special Matters: Software

- Europe
 - On its face, the answer is “no”
 - Art. 52(2)(c) ECP – “The following in particular shall not be regarded as inventions . . . schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers.”
 - Maybe the answer is “yes”
 - Art. 52(3) ECP – “The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.”

Special Matters: Software

- Europe
 - Case law – software is patentable.
 - *In re Vicom Systems, Inc.*, 1987 O.J.E.P.O. 14, 19 (Tech. Bd. App. 1986) - even if the idea underlying an invention resides on matter excluded under §52(2), the invention may nevertheless be patentable if it is directed at a technical process, as long as no protection is sought for the excluded matter as such.
 - Invention has a “technical effect” improving performance of an apparatus or process; even improving a computer itself.
 - Good practice to stress technical improvement made.
 - Business methods are still not patentable, even in software form.
 - Technical manner for a non-technical method does not endow it with technical character. *In re Pension Benefit Systems Partnership*, 2001 O.J.E.P.O. 441, 450 (Tech. Bd. App. 2000).

Special Matters: Biotech

- US – generally favorable toward biotech patents
 - Must be new, non-obvious, and useful
 - Applicant needs to present substantial utility for patenting genes.
 - No specific exclusions based on ethical considerations
 - Methods of treatment
 - Stem cell lines
 - Cloning

Special Matters: Biotech

- Europe – restrictions on biotech patents
 - *Inventive step v. discovery* sometimes difficult to differentiate when working with biotech
 - Genes and industrial-application requirement can present problems

Special Matters: Biotech

- Europe – restrictions on biotech patents
 - Cloning – European Directive 98/44/EC
 - Inventions whose commercial exploitation is in conflict with morality:
 - Cloning human beings
 - Modifying genetic identity of human beings
 - Uses of human embryos for industrial or commercial purposes
 - Modifying genetic identity of animals that will likely cause suffering without any substantial benefit to man or animal
 - Isolated elements of the human body may constitute patentable inventions

Special Matters: Biotech

- Europe – restrictions on biotech patents
 - Specific Exclusions – Art. 52(4)
 - “Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods [practiced] on the human or animal body shall not be regarded as inventions”

Take-Home Lessons

1. Do not disclose or offer to sell invention until a patent application has been filed.
2. File for patents quickly on key inventions.
3. Consider direct national filing if interested in ≤ 3 EPO member states.

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