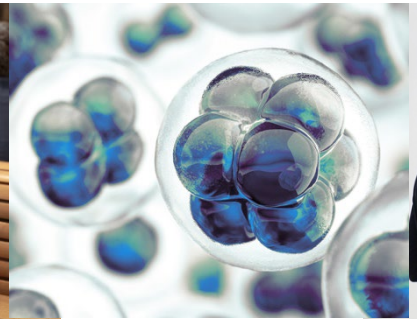
Europäisches Patentamt
European Patent Office
Office européen des brevets

FICPI Virtual 19th Open Forum 2020

Plenary 2- Arguing subject matter eligibility at the PTAB and at the EPO

An introduction to the European patent system



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November 5, 2020

Today ... an area with some 700m inhabitants

38 European member states

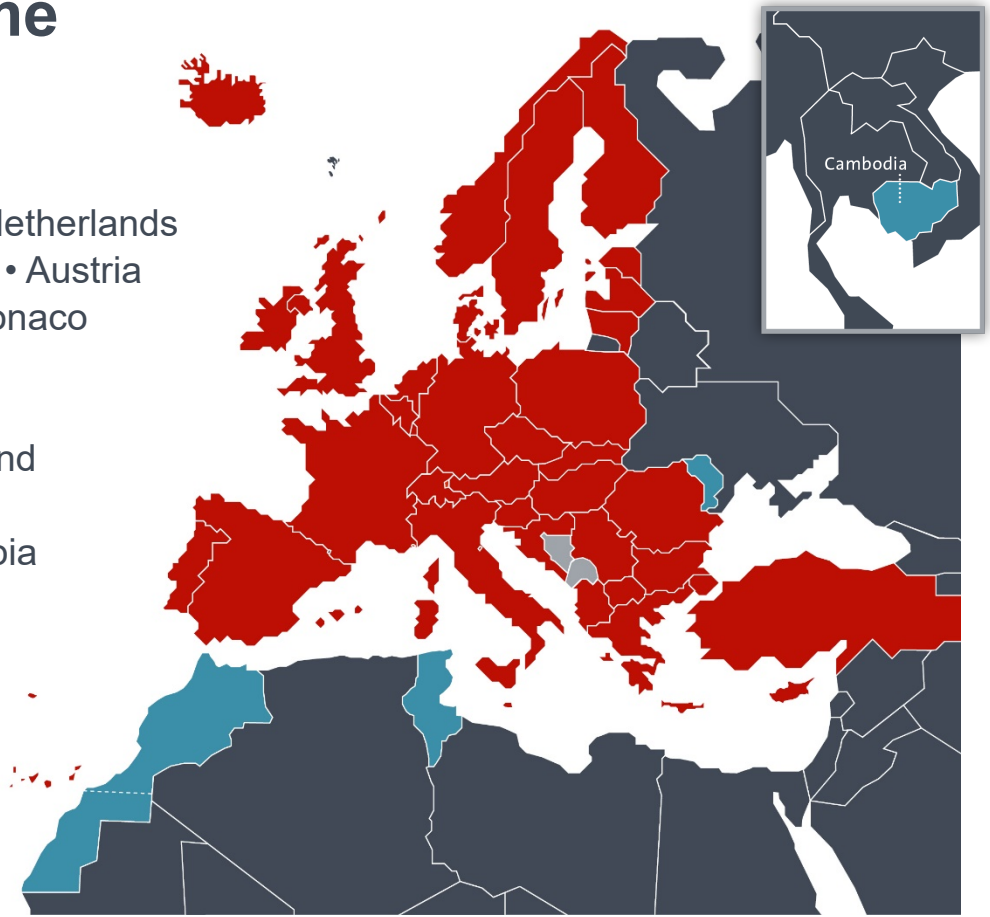
Belgium • Germany • France • Luxembourg • Netherlands
Switzerland • United Kingdom • Sweden • Italy • Austria
Liechtenstein • Greece • Spain • Denmark • Monaco
Portugal • Ireland • Finland • Cyprus • Turkey
Bulgaria • Czech Rep. • Estonia • Slovakia
Slovenia • Hungary • Romania • Poland • Iceland
Lithuania • Latvia • Malta • Croatia • Norway
North Macedonia • San Marino • Albania • Serbia

Two European extension states

Bosnia and Herzegovina • Montenegro

Four validation states

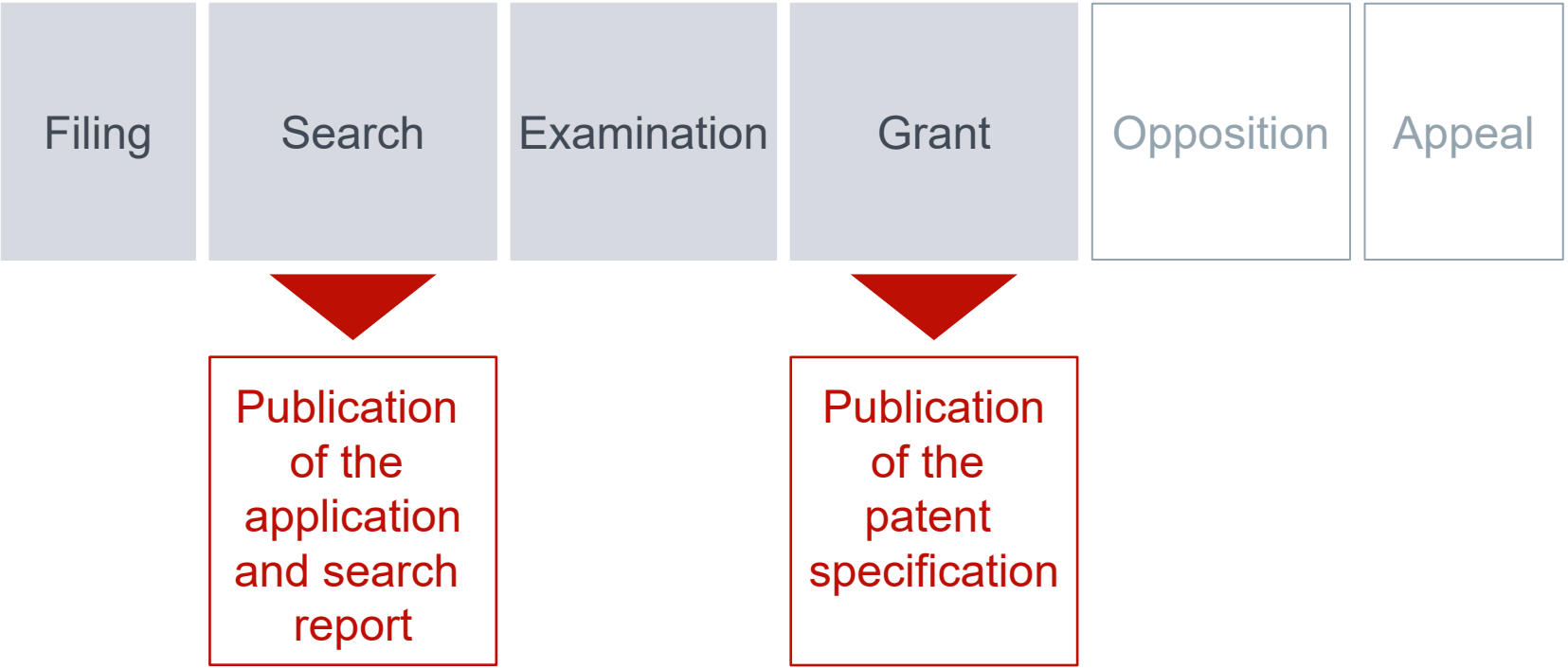
Republic of Moldova • Morocco • Tunisia
Cambodia



Three possible routes to file a patent

Route	National	European	International
Via	National offices	European Patent Office or national offices	International Bureau or European Patent Office or national offices
Valid in	One country	Up to 38 countries + two extension states + four validation states	Up to 152 countries
In brief	Applications are filed with the relevant national office and are valid for that state only	One single application in DE/EN/FR for all EPC contracting states. Same legal effects as national patents	An international patent procedure, not an international patent. After the international phase, applicants can choose to enter the national/regional phase in various states

Basic steps in the European grant procedure



Publication

- Patent applications are published on Espacenet, 18 months after the date of filing (or earliest priority date)
- The search report is also published
- Third parties can submit observations at any time prior to grant

Over 110 million patent documents are accessible to the public on epo.org/espacenet

Opposition

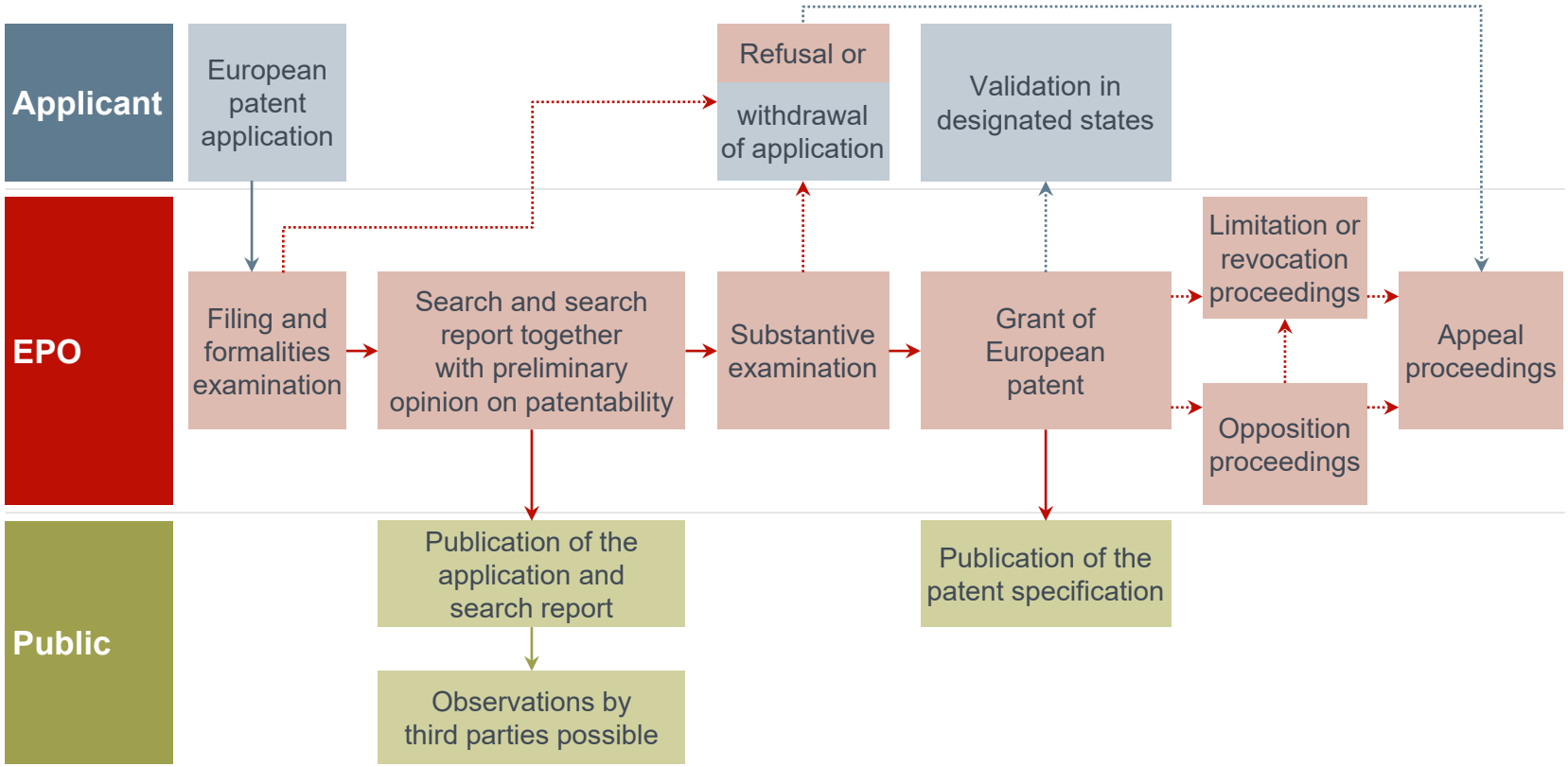
- Any person may oppose a European patent within nine months of its publication
- In 73% of opposition decisions, the patent is upheld either as granted or in amended form
- In 27% of opposition decisions, the patent is revoked
- Main grounds for opposition: novelty, inventive step, sufficiency of disclosure, added-subject-matter
- Clarity is not a ground for opposition

  (except if unclarity is caused by an amendment to the granted claims)

Appeal

- Appeals against decisions taken during grant and opposition proceedings are decided on by the EPO's independent Boards of Appeal
- They can be filed within two months after the date of notification of the decision
- The grounds for appeal must be provided within four months of that date

The European grant procedure in more detail



Patentability

Patents are granted for inventions in all fields of technology

To be patentable, inventions must

- be new
- involve an inventive step
- be industrially applicable

They must relate to a product, process, apparatus or use.

Excluded from patentability under the EPC[1]

- Discoveries
- Scientific theories
- Mathematical methods
- Computer programs
- Aesthetic creations
- Business methods
- Methods for playing games
- Methods for performing mental acts
- Presentations of information

if claimed "as such"

[1] See Article 52 EPC and the case law of the Boards of Appeal.

Exceptions to patentability as defined by the EPC[1]

- Plant or animal varieties or essentially biological processes for the production of plants or animals (e.g. marker-assisted breeding)

- Inventions whose commercial exploitation would be contrary to "ordre public" or morality (e.g. processes for the cloning of human beings)

- Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body

[1] See Article 53 and Rule 28 EPC.

Patentability of methods of treatment (Art. 53(c), Art. 54(5))

- Method of treating disease Y with substance X: NO
- Use of substance X for treating disease Y: NO

- Substance X for use in medicine (first medical use)
- Substance X for use in the treatment of disease Y (second medical use)
- Substance X for use in the treatment of disease Z (further medical use)

Claims can also be rendered novel by:

- new patient subgroup
- new dosage regimen
- new route of administration

Patentability of genes, proteins or cells

- **Rule 29(2) EPC**

An element isolated from the human body or produced by means of a technical process (such as e.g., a gene or a cell) is patentable, even if the structure of that element is identical to that of a natural element.

N.B. The **function** of a claimed gene sequence must be **credible** and **non obvious**

- medicament (e.g. insulin, growth hormone)
- association with cancer (e.g. diagnosis)
- receptor for specific protein or virus (drug target)

And now let’s see how these patentability requirements are applied in a mock opposition case in front of the European patent office…

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