

INFORMATION SHEET

Filing and prosecuting a european patent application

Persons who wish to seek patent protection in several European countries may file a single European patent application rather than a number of identical national patent applications. In this manner, the applicant will achieve the advantage of having its application subjected to only one examination and grant procedure instead of many parallel procedures in those countries.

Presently, the following countries may be designated in a European patent application: Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Macedonia, Malta, Monaco, The Netherlands, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey and the United Kingdom. Furthermore, a European patent may be extended to Bosnia and Herzegovina, and Montenegro.

It is assumed for the purposes of the following discussion that a patent specification has been previously prepared.

To begin the process of obtaining a European patent, a copy of the patent specification is filed in the Receiving Section of the European Patent Office (the "EPO") along with suitable filing forms.

After all filing formalities have been satisfied, the European Patent Office will perform a search for prior references that are relevant to the patentability of the invention claimed in the application and prepare a Search Report and search opinion.

The next two steps are taken for all EPO applications except those derived from international applications filed under the Patent Co-operation Treaty (the "PCT").

Firstly, 18 months from the EPO filing date (or, where the EPO application claims priority from a previously filed application, 18 months from the filing date of the previous application) the European patent application will be published. The application may be published along with the Search Report that was drawn up by the EPO or the Search Report may be published separately later, once it is completed. After the application is published, third parties may submit written observations with respect to the patentability of the invention.

Secondly, a request for examination must be filed and an examination fee must be paid within six months from the date on which the publication of the Search Report is mentioned in the European Patent Bulletin.

For a European application derived from a PCT application, because PCT applications are published, the EPO does not separately publish a European application stemming from a PCT application. However, the EPO will still publish its Search Report. The request for examination and the examination fee are normally due on submission of a European application derived from a PCT application.

For all European applications, if the search opinion received with the Search Report was not favourable, a response must be made to the opinion within six months of publication of the Search Report. If all objections are overcome and the European Patent Examiner is satisfied that the application should be allowed, before the actual grant of patent rights, the applicant will be invited to approve the text of the patent which the Examining Division intends to grant. As well, grant and printing fees must be paid and translations of the claims into both French and German must be filed.

Once the patent is granted, to obtain protection in the designated European countries, certain

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national requirements must be met. This may include a requirement to translate the specification into a language stipulated by a designated country.

Within nine months of the grant of the European patent, anyone who believes the patent should not have been granted may oppose the grant stating the reasons for their position.

Annual renewal fees must be paid to maintain a European patent application. Such fees are payable from the second year from the date of filing the application and annually thereafter during the pendency of the application. After a European patent is granted on an application, the annual renewal fees become payable directly to the countries in which the European patent has been validated.