

Grant Procedure

When the European Patent Office (EPO) agrees that an application may be granted, a number of steps must be taken for the European patent to come into force. The purpose of this sheet is to explain these steps and give an idea of the likely time scales and costs. A flow chart is included which provides a summary of the procedure for an application in English.

The grant procedure has two basic requirements:

- a) the EPO must grant the patent, and
- b) the patent must be “validated” in whichever of the designated countries are now required by the applicant.

A more detailed explanation of the steps involved is given below.

Communication under Rule 71(3) (previously Rule 51(4))

This is a letter from the EPO which indicates that the application is acceptable in principle. A copy of the specification is attached to the communication, usually including amendments proposed by the Examiner. A deadline is set for the following acts:

- approving the specification or requesting amendment of it;
- paying the official grant and printing fees;
- filing a translation of the claims into French and German.

It is necessary to file translations of the claims before the deadline even if you intend to request amendment of the specification. In practice, it can be useful to negotiate amendments with the Examiner over the telephone in order to avoid making amendments that will be refused.

Because of the need to prepare translations of the claims, it is important for us to receive instructions in plenty of time before the deadline.

If the European application claims priority from an application which is not in English, French or German, then a translation of the priority application will also need to be filed by the same deadline.

This deadline is inextensible.

When we report the communication under Rule 71(3), we will also give you a detailed estimate of the likely cost of proceeding in each of the designated countries. At this stage, you may choose the countries wanted, but a final decision can be left until patent grant. You may choose not to proceed with some countries in order to reduce expense or because a patent is not wanted in them.

Decision to Grant

After the response to the communication under Rule 71(3) is filed, the EPO will issue another communication, the “Decision to Grant”. This letter informs us that the EPO will now issue the “Certificate of Grant” and publish details of the grant of the patent in the European Bulletin. The Decision to Grant advises us of the date on which this publication will happen: this is the effective date of grant.

Issue of the grant certificate and opposition period

When the certificate of grant of the patent has been issued, it will be sent on to you. There is also an opposition period of nine months from the date of grant in which third parties may file an opposition to your patent. If this were to happen we would inform you immediately.

Validation of the patent in selected designated countries

Within three months of the date of the grant, all necessary action must be taken in selected designated countries in order to give effect to your patent.

Translations

Almost all EPC countries require full translations of the specifications to be filed at their Patent Office in one of their national languages. Countries that require a full translation of an English specification are:

Austria	Italy
Belgium	Netherlands
Bulgaria	Poland
Cyprus	Portugal
Czech Republic	Romania
Denmark	Slovakia
Estonia	Spain
Finland	Sweden
France	Switzerland
Germany	Turkey
Greece	
Hungary	

A French translation can also be filed in Belgium and Switzerland; a German translation can also be filed in Austria and Switzerland; an Italian translation can also be filed in Switzerland; and a Greek translation can also be filed in Cyprus.

Countries that do not require a translation of a specification in English are:

Iceland*	Slovenia*
Ireland	United Kingdom
Lithuania	
Luxembourg	
Monaco	

*Iceland, Lithuania and Slovenia require only the claims to be translated.

Please note: the requirements for translations and the associated costs will change when the London Agreement enters into force, the date of which is not yet known. Please see our information sheet on the London Agreement.

Ownership

Many countries also require a power of attorney signed by the applicant.

Countries that require a power of attorney are:

Austria	Italy
Belgium	Lithuania
Bulgaria	Poland
Cyprus	Portugal
Czech Republic	Romania
Estonia	Slovakia
Finland	Slovenia
Greece*	Spain
Hungary	Sweden
Iceland	Turkey
Ireland	

*Greece requires a notarised power of attorney for the first validation of a European patent in Greece by a proprietor. If you choose not to use our usual colleagues in Switzerland and The Netherlands, then these two countries will also require a power of attorney.

Countries that do not require a power of attorney are:

Denmark	Monaco
France	United Kingdom
Germany	
Luxembourg	

Publications

The European patent is published at grant.

Austria, Bulgaria, Denmark, Finland, Germany, Lithuania, Slovenia, Spain and Sweden will also publish the completed grant text in their national language.

At the time of going to press, no details are available for Latvia.

Renewals

When validation is complete, the patent will be in force in each of your selected countries. It must then be renewed every year, and we can of course deal with this for you if you wish. We pay renewal fees directly to many patent offices, to minimise cost.

Extension countries

A European patent application can result in patents in some East European states which are not members of the EPC, but are known as the "extension" countries. At grant of the patent, at least a translation of the claims must be filed locally.

Costs/estimates

The costs for the grant procedure can vary greatly and can also be high.

The expense is not only in translation but also because certain countries require the payment of official fees on validating the patent, while other countries require the payment of fees for the publication of the specification in their national language.

Translation costs also vary greatly depending on the number of words and pages in the patent specification and how many translations into different languages are needed.

For some countries, only attorney charges are incurred as no fees are payable and no translations required.

The cost at the first stage (dealing with the communication under Rule 71(3), translating claims, official fees) depends on the amount of work involved and the number of words in the claims. A minimum cost at present rates (with four pages of claims) is typically £1300 (€1750, US\$2550).

To give an example of costs at the second stage of validation in each country, with a 5000 word specification, the cost at present for countries where translation is required ranges from £1000 to 2100 per country (€1350 to 2800, US\$2000 to 4200). For countries where no translation is required, or a translation made for another country can be used, the cost is much lower.

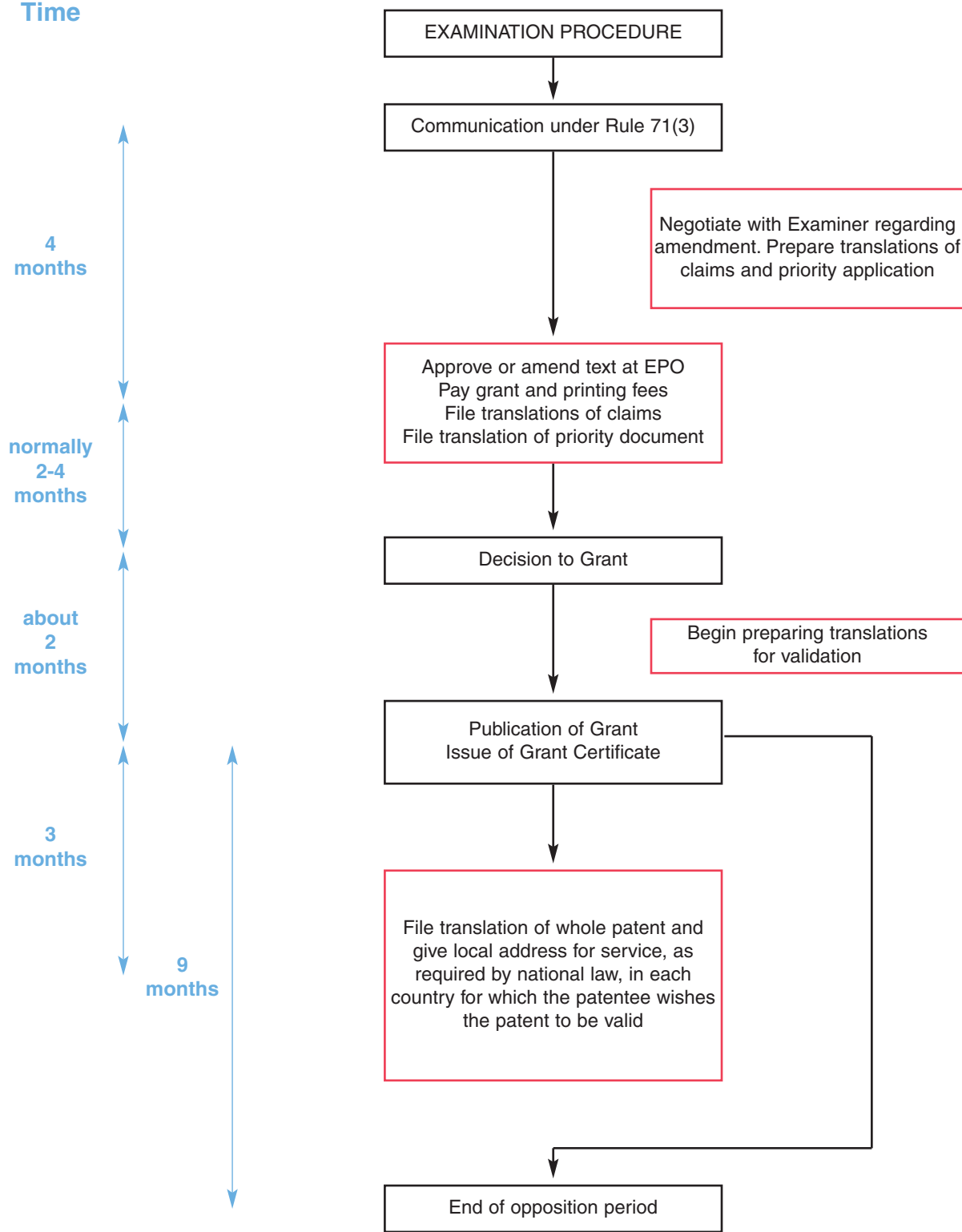
Our estimate of the likely cost will be sent to you with our report of the communication under Rule 71(3).

To produce the estimate, we work out the likely costs of translation, filing, official fees and publication fees in the various countries based on previous charges from foreign attorneys and on the number of words and pages in the approved text.

We use a number of different translators, chosen for their expertise in accurately translating the often highly technical language of patent specifications. Because of the relatively difficult nature of this translation work, clients sometimes find that regular commercial translators can offer cheaper translation rates. However, we do not recommend that translators unfamiliar with patents are used, since an inaccurate translation can have a serious effect on the patent protection. In several countries the translation must be certified by a local patent attorney.

European patent applications: grant procedure

Time



This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

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