

LIFE OF A PATENT

CONTENT MAP

The course “Life of a patent” aims at familiarising future *patent professionals* with the collective’s essential activities related to the grant and post-grant procedure.

It reflects EPO procedures from a patent professional’s perspective and situation. This specific angle will help participants to face their future activities in an effective and meaningful way.

The course consists of four chapters:

1. PRE-DRAFTING

The attorney receives input from the applicant or inventor. It is important to develop skills of listening to the explanations in order to *grasp the actual gist of the invention*. The attorney must also be in a position to advise the client about the filing strategy in geographical terms.

Practically, the attorney must be in a position to advise on:

- whether the alleged invention is patentable or not (e.g. not a business method)
- whether the counterpart is entitled to file a patent application and with whom
- which the chances of obtaining a patent are on the basis of previous publications, state of the art known to the applicant, etc
- which filing strategy to choose in terms of national and international scope

To this end, the participant needs general knowledge about:

- patentability: what can form part of a patent and what not (exclusions and exceptions)
- essence of an invention and generalisation in claims
- ownership: who is entitled to the protection conferred
- patentability requirements: brief overview (N/IS)
- how to balance the scope of potential protection: level of detail and existing prior art
- filing and filing routes (national, EP, PCT...) with associated costs and timelines

2. DRAFTING

The attorney needs to reflect on the input and must be able to convert the extracted information into a complete patent application.

This means that the attorney is able to:

- decide on the content to be included
- consider the format of the application (number of claims, extension of the description)
- address the application's specific requirements: clarity issues, non-unity, use of disclaimers

To this end, the participant needs general knowledge about:

- sufficiency of disclosure
- field-specific questions on the formulation of claims: medical use, CII, biotech
- claim drafting (clarity and unity)
- independent and dependent claims
- level of detail of description; embodiments
- drawings
- anatomy of a patent: parts

3. FORMAL ASPECTS OF PROSECUTION

This chapter addresses the attorney's actions before the EPO, i.e. the actual procedure in front of the EPO (or PCT IB) to deal with office actions towards the grant of a patent.

The attorney must be able to proficiently carry out all relevant actions.

To this end, the chapter addresses the following topics:

- filing and representation
- search phase, amendments and publication (and rights conferred)
- office actions: understanding the written opinions, the objections with respect to novelty and inventive step and unity
- drafting a response and incorporating amendments
- grant or refusal and their legal effect
- validation in the different countries
- the opposition procedure: grounds for filing, formal requirements, prosecution and possible outcomes
- filing an appeal and next steps in case the appeal is admissible
- oral proceedings: when to request it and other related requests
- requesting limitation or revocation of the patent

4. SUBSTANTIVE ASPECTS OF PROSECUTION

This chapter covers in detail the substantive aspects of prosecution: patentability requirements, amendments and the issue of priority.

The attorney must know and be generally able to realise the relevant actions and procedures related to these aspects.

To this end, the chapter addresses topics like:

- novelty: implicit features, generic vs specific disclosure, meaning and interpretation of specific expressions
- assessment of inventive step: the problem/solution approach
- admissibility and allowability of amendments
- requirements for valid priority, the meaning of “same invention”