LEGAL PROTECTION OF PATENTS

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Legal Framework

a) International Law

Paris Convention for the Protection of Industrial Property.

World intellectual Property Organization (WIPO).

Patent Corporation Treaty (PCT).

Patent Law Treaty (PLT).

The IPC.

Agreement on Trade-Related Aspects of intellectual Property Rights (TRIPS)-Agreement.

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b) European Law

European Patent Convention (EPC):

a) Implementing Regulations to the Convention on the Grant of European Patents.

b) Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent (Protocol on Recognition).

c) Protocol on Privileges and Immunities of the European Patent Organization (Protocol on Privileges and Immunities).

d) Protocol on the Centralization of the European Patent System and on its Introduction (Protocol on Centralization).

Regulation (EU) n° 1257/2012 of the European Parliament and of the Council, of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection

National laws of transposition

See each country.

What is a patent ?

A patent is a right granted by the authorities in exchange for the disclosure of a new and inventive technology to the public.

Patents generally are granted for inventions in all technical fields provided that they are new, not obvious from the state of the art to a person skilled in the art and are susceptible of industrial application.

National Patents, European Patents and European Patents with unitary effect

Patents are generally granted nationally, and, accordingly, are subject to the legal regulations of the respective country. The European patent has its own procedural rules for the granting of a patent, but, in turn, leads to national patent rights.

There is no difference between a European patent valid in a country and a national patent after the examination. In case of a national patent application the examination will be performed by the national patent office, in case of a European patent application the examination will be performed by the EPO.

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The European Patent with unitary effect will be a European patent granted by the EPO under the provisions of the European Patent Convention to which unitary effect for the territory of the 25 participating states (all member states of the European Union except Spain and Italy) is given after grant, at the patentee's request.

Exceptions from patentability

The following subject matters as such usually are not regarded as inventions:

- Discoveries as well as scientific theories and mathematical methods;
- The human body at the various stages of its formation and development;
- The mere discovery of one element of the human body, including the sequence or partial sequence of a gene;
- Aesthetic creations;
- Plans, rules and methods for mental acts, for games or for business activities as well as programs for computers;
- The presentation of information.

Patents shall not be granted on methods for cloning human beings; methods for modifying the germ line genetic identity of human beings; the use of human embryos; production and exploitation of hybrid species evolving from germ cells, totipotent cells or cell nuclei of human beings and animals; methods for modifying the genetic identity of animals which are used to cause these animals suffering without any substantial medical benefit to Man or animal, and also animals produced by such methods.

Methods intended for the surgical or therapeutical treatment of the human or animal body and diagnostic methods carried out at the human or animal body shall also be unpatentable, except for products, in particular, substances or compositions, to be applied in any of these methods which can be subject of patent protection.

Patents further shall not be granted for plant varieties or animal races as well as for substantially biological methods for breeding plants or animals.

The concept of plant variety is defined by Article 5 of Regulation (EC) No 2100/94 on Community plant variety rights, Official Journal No. L 227 of 1 September 1994 p. 1, in the version of Regulation (EC) No 2506/95, Official Journal No. L 258 of 28 October 1995 p. 3. A method for breeding plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection. Inventions which concern plants or animals shall be patentable if the technical feasibility of the invention is technically

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not limited to a particular plant or animal variety. The exclusion of patentability of substantially biological methods for breeding plants or animals, shall not affect the patentability of inventions the subject matter of which is a microbiological or other technical method or a product obtained by means of such a method, wherein a microbiological method means any method using microbiological material, or performed upon or resulting in microbiological material.

The terms of protection

In Europe, patents are granted for a maximum period of 20 years from the filing date of the patent application.

For pharmaceuticals or pesticides, the term of protection can be extended by a Supplementary Protection Certificate. The background of this is that pharmaceuticals and pesticides must go through a long state marketing authorization procedure before they can be marketed, and only then can be placed on the market. Thus the term of the patent already begins before the rights holder can bring his invention on the market. In order to compensate for this, the Supplementary Protection Certificate gives the possibility to gain back up to five years of the lost time of the protection period through a supplementary property right: this gives the simultaneous holder of a patent and a Supplementary Protection Certificate the possibility of a protection period of maximum 15 years from the initial approval (in the EU). For pharmaceuticals for children there is additionally the possibility of a paediatric extension of 6 months.

Rights granted by a patent

The patent grants an exclusion right to the patent holder; thus it allows him to prohibit other persons from using the invention. The patent holder can inter alia prohibit others from manufacturing the object of invention industrially, putting it into circulation, supplying, using or introducing or possessing for these purposes.

If the patent has been granted for a process, its effect shall also cover any products directly produced by this process.

European patent law also confers the patent owner the right to prevent all third parties from supplying or offering to supply a person other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or it has been obvious in the circumstances, that these means are suitable and intended for putting that invention into effect. This prohibition of indirect patent infringement shall not apply when the means are staple commercial products, except when the third parties induces the person supplied to commit prohibited acts.

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Claims in case of infringement

In case of breach, the holder of rights may demand, in particular, the cessation of the infringing use, the removal of infringing goods or tools, reasonable compensation or in the case of negligence, damages, each including financial statements, publication of the judgment and information about the origin and distribution channel.

The cessation, but also the preserving of evidence ("house search under civil law") or the ability to pay ("freezing of assets") can be enforced through a preliminary injunction. An intentional patent infringement may also be a criminal offence and punishable by imprisonment.

Employees inventions

Employees also may be entitled to the grant of a patent for any inventions made by them during their employment.

Depending on the national legislation, it may be necessary to conclude a contract for transfer of rights to the corporation.

Care should be taken to include in all contracts with suppliers, an assignment clause in favour of the client company. In this case, although not inventor, the company would – in the limits provided by European cartel law be rightholder.

Scope of the Patent

Patents have to be interpreted under consideration of the protocol for the interpretation of Article 69 EPC considering not only the patent claims and the wording but also their sense, the description and the drawings of the patent.

According to court practice, not only the literal infringement falls under the scope of a patent but also the equivalent use of a patented invention. Different rules on equivalent infringement have established across Europe. In Germany and Austria for example, equivalent use occurs if a person skilled in the art, at the priority date, equipped with general technical knowledge and, considering the state of the art, takes the exchanged features without inventive effort as a method of functioning the same way as the claimed patent.

The UK instead asks the three so called Catnic questions: a variant does not infringe a claim unless :

a) it would have no material effect on the way the invention works.

b) the lack of material effect would have been obvious to one skilled in the art at the date of publication, and

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c) it would be apparent to the skilled reader that the patentee could not have intended the particular claim language to exclude such a known, minor variant having no material effect.

No surprise that the European case law is not perfectly homogeneous especially when it comes to equivalent infringement.

Exception of Prior Use

Depending on the respective national legislation, a patent eventually does not enter into effect against any person who, already at the time of filing of the application, used the invention or took measures necessary for such use in good faith (prior user). The right of prior use is not yet perfectly harmonized in Europe.

What Is the Difference between a Patent and a Utility Model?

Some countries do not only grant patents but also utility models. Like patents, utility models are means to protect inventions. The requirements for utility models are similar to those for patents:

- novelty (for which, however, in case of utility models the inventor or his legal successor may enjoy a period of grace);
- inventive step and moreover, of course;
- industrial applicability is required in both cases.

One major difference between patents and utility models is the form of the granting procedure. While the process of obtaining a patent will often involve extended examination before the patent is, with respect to utility models, only a formal examination of conformity with the law is carried out.

The term of a utility model is shorter than the term of a patent.

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