



HSM IP Patent Client Guide

EUROPEAN COMMUNITY

Registration

A patent application can be filed directly at the European Patent Office (EPO) which examines and grants European patents under the *European Patent Convention (EPC)* also known as the *Convention on the Grant of European Patents* of 8 October 1973.

When filing a European patent application all of the contracting states for which the EPC has entered into force on the date of filing are deemed to be designated. The contracting states are currently: Albania, Austria, Belgium, Bulgaria, Cyprus, Croatia, the Czech Republic, Denmark, Estonia, Finland, the former Yugoslav Republic of Macedonia, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, the Netherlands, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey and the United Kingdom.

European patents applications may also be extended to a number of states not party to the EPC. at present these “extension states” are: Bosnia-Herzegovina and Montenegro.

The following information and documentation is required:

1. a request for the grant of the patent
2. a description of the invention
3. one or more claims and any drawings referred to in the description or any claim
4. an abstract
5. a designation of inventor(s)
6. an English, French or German translation of all of the above documents

It usually takes about 3-5 years for the EPO to process an application for registration. Paris Convention priority can be claimed. Once the registration is complete the EPO will issue the proprietor(s) with a Certificate attesting that the European patent has been granted to the person(s) named on the Certificate.

Patent Cooperation Treaty

The EPO also accepts patent applications under the Patent Cooperation Treaty (PCT). A request for entry into the European Regional Phase must be filed at the EPO within 31 months of the priority date, specifying the documents on which processing in Europe is to be based and requesting examination of the application.

Grant Procedure

A granted European patent does not remain as a single patent, but splits into a “bundle” of national patents. In order for this to happen it is necessary to validate the European patent in each of the designated states in which patent protection is desired, usually within three months of the grant of the patent. In some states this validation process requires the payment of a fee, the filing of a Power of Attorney and/or the filing of a translation of the claims or the entire patent specification into an official language of the state in question.

Searches

Whilst there is no requirement to conduct a search in Europe prior to the filing of an application for registration a search is recommended to ascertain that there will be no discrepancies concerning the innovativeness of the patent. The result can usually be provided within 3-4 weeks.

Expiry

A European patent registration is valid for 20 years.

Abandonment

Please inform us as soon as possible if you wish to abandon your patent or allow it to lapse so that we can update our records and advise the EPO and the national Patent Offices in the designated states in which the patent has been validated accordingly. This will avoid us sending out unnecessary Reminder Notices.

Assignment

Please inform us as soon as possible if the patent has been assigned so that we can file an application to record the assignment at the EPO and the national Patent Offices in the designated states in which the patent has been validated accordingly.

To record the assignment of a patent registration at the EPO the only documentation required is a copy of the Deed of Assignment. The documentation required to record the assignment at the national Patent Offices in the designated states in which the patent has been validated varies from state to state.

It usually takes four months or less for the EPO to process an application to record an assignment. Once the recording is complete the EPO will issue a Certificate of Registration of Assignment. The time it takes to record the assignment at the national Patent Offices in the designated states in which the patent has been validated varies from state to state.

Change of Particulars

Please inform us as soon as possible if there is any change to the registration so that we can file an application to record the change at the EPO and the national Patent Offices in the designated states in which the patent has been validated accordingly.

To record a change of name and/or address for a patent registration at the EPO the only documentation required is the document evidencing the change. The documentation required to record the change at the national Patent Offices in the designated states in which the patent has been validated varies from state to state.

It usually takes four months or less for the EPO to process an application to record a Change of Particulars. Once the recording is complete the EPO will issue a Certificate of Recording showing the change. The time it takes to record the change at the national Patent Offices in the designated states in which the patent has been validated varies from state to state.

Unitary Patent

Recent developments in the European Union (EU) mean that it should soon be possible to obtain a Unitary Patent which provides uniform protection across the participating member states (which are, at present, the member states of the EU with the exception of Spain, Poland and Croatia). The Unitary Patent will remove the requirement to complete the validation procedure in the participating member states. Instead, a centralised validation procedure will require more limited formalities including, during a transitional period, a single translation of the patent.

Our Firm

HSM IP Ltd. provides worldwide intellectual property services. Based in the Cayman Islands and independently owned and operated, our experienced team of attorneys and paralegals deliver first class service to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues internationally.

The success and growth of our firm is due to our keen understanding of our clients' needs for a comprehensive "one-stop shop" which encompasses a wide range of services from the initial consultation process to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly and substantially paperless workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements, including multi-currency invoicing and e-billing. We offer a competitive schedule of fixed fees, inclusive of both disbursements and official fees, which means we can provide clients with an accurate estimate of their project costs before embarking on a global filing programme for their portfolio.

As a leader in the field, HSM IP understands the value of long-term business relationships. We have a wealth of knowledge and specialise in the Caribbean, Central and Latin America and other off shore jurisdictions. Our staff regularly contribute to leading IP publications and we also publish a range of country-specific IP Client Guides which are available on our website.

Supported by HSM Chambers, an offshore law firm with experienced attorneys admitted in multiple jurisdictions, we have substantial experience in taking action to address the infringement of trade marks and patents and in the conduct of passing-off actions. We are also able to offer investigative services to identify the source of, and distributors of, infringing goods, working closely with police and customs officials as necessary.

Memberships: INTA, ASIPI, ITMA, MARQUES and IPCA.

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HSM IP Ltd. is a Law Firm recognised under the Legal Practitioners (Incorporated Practice) Regulations, 2006 (as amended).

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