

Best Patent Filing, Prosecution and Enforcement Practices in Europe

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Patent Enforcement (Litigation) Scenario in Europe under present European Patent Convention (EPC) and national (like German („DE“)) Patent Systems

- No Unitary Patent („UP“) nor Unified Patent Court („UPC“) existing yet, but possibly becoming realized 2023/2024
- Only nationally obtained patents in EU and/or U.K. patent offices, like German Patent and Trademark Office (GPTO), and national parts of EPC bundle patent, like in DE, enforceable at national courts
- More than 80% of all patent litigation cases in Europe (first filings) take place in Germany
 - Reason: Market size (nearly 40% of EU GDP)
- Only in 5% of all patent litigations in DE - after termination thereof or parallel thereto - patent litigation procedures take place in other, parallel EU countries and/or UK
- Accordingly, outcome of DE litigation in around 95% triggers EU-wide settlement of multi-country patent disputes in Europe

Which Patents to use in Patent Litigation in Germany?

- In principle, national DE patents and DE parts of EPC patents are similarly suitable
 - Invalidity arguments in both types of litigation only dealt with in parallel, bifurcated invalidation procedure at German Federal Patent Court (GFPC), with appeal to German Federal Court of Justice (GFCJ)
- Distinctly higher rate of partial or full invalidation of patents in dispute at GFPC in case of EP-parts than in case of national German patents
 - Consequence: German national patents considered as „stronger“ than EPC patents
- Recommendation: If possible, for DE-litigation national DE-patents should be used by patentee instead of DE parts of EPC patents

Cost Comparison (based on 50% Discount Scheme applicable in DE/EP sometimes in Case of large Filing Numbers (only on „Basic Fees“) - I

- Cost of filing at EPO (with request for examination): official fee 3.785,00 EUR, honorarium 994,50 EUR, in total 4.779,50 EUR
 - If based on PCT application with EPO as ISA: official fee „only“ 2.635,00 EUR, honorarium „only“ 719,00 EUR, in total „only“ 3.354,00 EUR
- Further cost of about 5.000,00 EUR honorarium and 1.500,00 EUR official fees until patent grant
 - Additional validation cost per designated country after EPC patent grant, from 100,00 EUR till 800,00 EUR, depending on country-wise requirements
- Approximate total cost, till patent grant (without validation): 11.279,50 EUR

Cost Comparison (based on 50% Discount Scheme applicable in DE/EP sometimes in Case of large Filing Numbers (only on „Basic Fees“) - II

- Filing at GPTO (with only machine translation (certified) into German and without request for examination): official fee 60,00 EUR, honorarium 1.337,50 EUR, in total 1.397,50 EUR
 - Examination request only necessary 7 years after filing, then additional official fee of 350,00 EUR and honorarium of 94,50 EUR
 - Further cost of about 5.000,00 EUR honorarium and 500,00 EUR official fee till patent
- Total cost till patent grant: 7.342,00 EUR

Best recommended Practices for Patent Filing/Prosecution in Europe

- „Triage“ before filing at EPO/GPTO as follows:
 - Very important applications – category A
 - Important applications – category B
 - Not so important applications – category C
- A: Filing at EPO plus in parallel in DE without examination request and using English application text, followed by machine translation – examination request can be deferred until 7 years after effective filing date
 - Cost: At filing official fee 3845,00 EUR, honorarium 2.332,00 EUR, in total 6.177,00 EUR
- B: Filing at EPO only (with request for examination, in PCT-case at filing, in non-PCT-cases within six months after publication of search report)
 - Cost: At filing official fee 3.785,00 EUR, honorarium 994,50, in total 4.779,50 EUR (if out of PCT: 3.354,00 EUR in total)
- C: Filing in DE only (in English language, with machine translation lateron, with examination request)
 - Cost: At filing official fee 410,00 EUR, honorarium 1.432,00 EUR, in total 1.842,00 EUR
- Conclusion: Cost of C cases when filing at GPTO (C-cases) only about 50% of total cost of filing at EPO