

# EPAC syllabus

The examination papers are drawn up in the three official languages of the EPO (English, French and German).

Candidates may use any books or documents they consider useful for answering the examination papers.

The EPAC certification has been designed to enable paralegals, patent administrators and formalities officers to demonstrate that they have the required knowledge and skills to deal independently and autonomously with the procedures associated with the filing, prosecution, grant and maintenance of European and international patent applications, as well as post-grant procedures.

The examination focuses on procedural aspects under the European Patent Convention, the Patent Cooperation Treaty (PCT) and the Paris Convention as well as national laws and other agreements in so far as they apply to European patents and patent applications, including the London Agreement.

Candidates must answer questions on the various patenting routes and application procedures and the procedural, administrative and formalities-related tasks involved.

Candidate must demonstrate the ability to validly file patent applications with competent authorities on the basis of said regional and international treaties and agreements, as well as to monitor and carry out in a timely manner any procedural matters, including payment of applicable fees.

Candidates must be familiar with how to monitor time limits, the filing of documents and fee payments. In particular, candidates must demonstrate familiarity with the procedures for remedying deficiencies or losses of rights caused by missed deadlines or payments and non-conformities.

Candidates must be capable of determining possible means of redress and be able to deal with all post-grant procedures.

## MODULE 1 – Understanding patents

### A - General aspects of patent law

- Background of the patent system
- What is a patent (IP right, object of property, structure of a patent specification)
- Patentability criteria (new, inventive, industrial application)
- Patenting routes (national, regional, international)
- Priority definition (Paris Convention)
- Ownership and inventorship (transfer of rights or assignments)
- Designation states, extension and validation states
- Duties and responsibilities of patent attorney and patent administrators

### B - The European patent grant system

## B1 The EPO as patenting authority

- The legal system: the EPC
- Where to find relevant information
- The EPO online services
- Representation before the EPO

## B2 The EP patent application procedure

- Timeline of a European patent application
- Outline of the patent grant procedure
- Roles of the formalities officer, search, examining and opposition divisions as well as the Boards of Appeal
- EPC time limits (type, calculation, extension)
- EPC remedies (extension of periods, evidence of payment of fees under Article 7 EPC, late-received documents under Rule 133 EPC, correction of errors under Rule 139/140 EPC, request for a decision, further processing, re-establishment of rights, appeal, petition for review)
- EPC fees (structure, payment methods, type of fees, refunds, fee reductions)

## C - The PCT patent filing system

### C1 WIPO, role of the International Bureau (IB)

- The legal system: the PCT
- Where to find relevant information
- Overview of WIPO online services
- Representation under the PCT, agents and common representatives

### C2 The PCT application procedure

- PCT contracting states
- Outline of the PCT procedure, the role of the different offices (IB, RO, ISA, SISA, IPEA)
- PCT Chapter I and Chapter II
- Structure of the international procedure (timelines)
- PCT time limits (type, calculation, seven-day rule, considered in time, extension)
- PCT fees (general structure, type of fees, amount and currency, authority to which fees must be paid, how to pay, refunds)
- PCT remedies (force majeure, review and excuse procedure)

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Candidates must demonstrate that they have the ability to file and prosecute a European patent application (EP direct and divisional) meeting the requirements of the European Patent Convention.

## **MODULE 2 – EPO procedure from filing to search results**

### **A - Filing a European patent application**

- Patenting route claiming a priority right (declaration of priority, certified copy, translation, adding/correcting priority claims, WIPO DAS)
- Who can file (right to a European patent, representation)
- Where to file (national office, EPO)
- What to file (request, content of the application, filing by reference, sequence listings)
- When to file
- How to file at the EPO (online, by fax, by post, by hand)
- What to pay
- Languages, translations and fee reductions
- Filing via national office

#### **A1 Date of filing**

- Accordance of filing date: minimum requirements
- Legal consequence of a filing date
- Missing parts, change of filing date

#### **A2 Formal requirements for European patent applications**

- Examination of formal requirements (application documents, designation of inventor)
- Correction of defects (invitation to correct defects, time limits, rectification)
- Remedies (extension of time limit, request for a decision, further processing, re-establishment of rights, appeal)
- Requirements for additional documents (SEQL, BIOM)

### **B - Filing a divisional application**

- What is a divisional, legal basis
- Who can file
- When to file
- Where to file (EPO)
- What to file (request, content of the application, filing by reference)
- What to pay
- Designated states, extension states, validation states
- Language

### **C - Search and European search report**

- Timeline for delivering search
- Search fee, refund
- Different types of search reports drawn up by the EPO (standard, incomplete search, lack of unity)
- Content of the extended European search report (EESR)
- Special procedures (conciseness, independent claims, no meaningful search)

- Amending the patent application after issuance of the search report
- Accelerated search
- Response to search opinion

#### **D - Publication of the European patent application**

- Background of publication
- Date of publication and technical preparations
- Form and content of publication, the European Publication Server
- European Patent Register
- Types of publications
- Time limits triggered by publication
- Preventing publication, withdrawal

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Candidates must master all procedural steps involved in the European patent grant process and post-grant procedures.

### **MODULE 3 – EPO procedure from entry into examination to validation**

#### **A - Examination**

- Examination request, maintenance of application
- Fees (examination, designation, extension, validation, renewal fees)
- Filing amendments before substantive examination (basis)
- Prior search results
- Additional search fees
- Refund of fees
- Acceleration of the examination procedure (waiver, PACE request, PPH request )
- Substantive examination (Office actions, response to Office actions, amendments)
- Stay, interruption and resumption of the proceedings
- Third-party observations
- Withdrawals
- Oral proceedings, consultation, witness hearing, practical considerations (sending samples/models)
- Intention to grant
- Approval (fees, translation of claims) and disapproval by the applicant, late amendments
- Decisions (decision to grant, refusal)
- Publication (types)
- Correction after grant (bibliographic data, specification, publication errors)

#### **B - Appeal procedure *ex parte***

- Filing an appeal
- Who may file
- What, where and how to file

- What to pay

## **C - Post grant**

### C1 National validation

- Overview of national systems
- Extension states
- Validation states
- When to validate
- Validation requirements (e.g. London Agreement)
- Annuities

### C2 Opposition procedure

- Filing notice of an opposition
- Who may file
- What, when, where and how to file
- What to pay
- Outcome of the opposition

### C3 - Appeal procedure *inter partes*

- Filing an appeal
- Who may file
- What, where and how to file
- What to pay

### C4- Limitation and revocation procedure

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Candidates must demonstrate that they have the ability to file and prosecute an international application meeting the requirements of the Patent Cooperation Treaty.

## **MODULE 4 – PCT procedure**

### **A - Filing an international application**

- Where to file, the choice of receiving Office (national office, IB, EPO)
- How to file
- PCT request form
- Content of the application
- Official fees
- Languages, translations and fee reductions

#### A1 International filing date

- Accordance of filing date: requirements
- Missing elements, change of filing date

## A2 Formal requirements of an international application

- Examination of formal requirements (applicant, representative, designation of inventor, priority, designation of states, signatures)
- Invitation to correct defects
- Remedies (extension of time limit, Rule 91, Rule 26 PCT)
- Claiming priority (correcting, adding, withdrawing priority claim)
- Correcting defects (correction of errors, restoration of priority right, request for obvious error)
- Possible remedies

## B - International search

- The choice of the International Searching Authority (ISA)
- Search fee, refund
- PCT-Direct letter
- Content and form of international search report (ISR)
- Special procedures (lack of unity, no meaningful search)
- Amendment of the claims before the International Bureau (Article 19 PCT)
- Role of the Supplementary International Searching Authority (SISA)
- Filing a supplementary international search (SIS)

## C - International publication

- When and where published, technical preparations
- Form and content of the publication, PATENTSCOPE
- International publication: languages
- Preventing publication or delaying publication

## D - International preliminary examination

- Where to file, the choice of the International Preliminary Examining Authority (IPEA)
- How to file
- What to file
- Demand request form
- What to pay
- Office actions, reply to office actions, amendments
- International preliminary report (IPER)
- Third-party observations

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Candidates must be able to enter into the national/regional phase meeting the requirements of the European Patent Convention.

## **MODULE 5 – Entry into the national/regional phase after PCT**

### **A - The national/regional phase**

- End of PCT international phase, time limits for national/regional entry
- Early entry
- Outline procedure European regional phase
- Supplementary search (or not)

### **B - Entry into the European phase, formal requirements and examination**

- Requirements for entry into the European phase (request for examination, fees, translations, basis for grant)
- Early processing
- Foreign agents and their role in the national procedure
- Acceleration of the examination procedure (early entry, waiver, PPH, PACE)
- Subsequent requirements (applicant, inventor, representation, amendments, certified copy, search results priority application, sequence listings)
- Correction of defects and remedies