

PREFACE

This Supplement is current through September 3, 2016 with some significant updates through November 30, 2016.

This guide designed to help U.S. patent attorneys, agents, and technical advisors develop European patent prosecution skills, avoid mistakes, and generally succeed at the European Patent Office (EPO) has been updated for 2016 with four new chapters, as well as with important recent developments and an appendix chart comparing U.S. patent law with the Unified Patent Court rules.

The 2016 Supplement adds the following four new chapters and appendix:

- **Chapter 14: National Validation**, the process by which an applicant receiving a granted European Patent registers that patent right with the at least some of the national patent offices of the contracting states, extension states and validation states, to secure in those states a national patent that can be enforced by the respective national courts.
- **Chapter 15: Text for Grant**, addressing whether one translation of the granted patent has greater legal significance than the other translations; whether the arguments and communications between the applicant and the EPO are part of the record used when determining the scope of the protection conferred by the patent; and related questions for U.S. practitioners when considering the effect of rulings of the Boards of Appeal and decisions from the Opposition Division.
- **Chapter 16: Selecting and Maintaining Countries for Validation**, which informs readers about when and where to validate the granted European patent as a national patent in a contracting state of the EPC or of an extension state, which is a state that has extended protection of the European patent right in that respective state.

- **Chapter 17: The Unitary Patent and the Unified Patent Court**, discussing a group of agreements that streamline the process for validating and enforcing European patents, which are expected to take effect during the latter part of 2017.
- **Appendix B: Summary Chart of U.S. Patent Statute and Rules Compared With Corresponding Rules of Procedure of the Unified Patent Court.**

The **2016 Supplement** also addresses changes made by the European Board of Appeals to core principles of law under the EPC and changes made to procedures to Appeal and Opposition practice; reviews and updates the comparison between U.S. and European law on patentable subject matter, including the Federal Circuit's *Enfish* decision addressing patentable subject matter in the U.S. and decisions on patentable subject matter in Europe, including changes and clarifications coming from the U.K. Courts and the EPO; considers and compares developments in European law, including decisions from the U.K. courts like *HTC v. Apple* as well as decisions from the European Boards of Appeal such as T 1214/09, *Sharp*; and looks at proposed changes that may come into place under the Unified Patent Court and Unitary Patent regime, if adopted by the European States.

As noted in the main volume, those seasoned in European patent law will appreciate that the following discussion and working examples are not exhaustive but provide a springboard to a new and rich understanding of both legal frameworks.

For their invaluable help, we would like to acknowledge the contributions of numerous colleagues at Ropes & Gray and elsewhere. The authors would particularly like to express their appreciation for the careful work, quick research and thoughtful criticism of Ekaterina Gianiotis and Julian Moore. We are also grateful to numerous current and former members of the Examining Division, Opposition Division, and Boards of Appeal at the European Patent Office for their helpful discussions and insights regarding European patent law.

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