
Newsletter 2/2010

Information on Prior Art in the European Patent Procedure

by Dr. Sebastian Gritschneider and Dr. Monica Heinemann

1. Introduction

In order to benefit from the work carried out during the priority year on a first filing at a national patent office (NPO) or regional patent office (RPO), the Administrative Council of the EPO has decided that any European patent application claiming priority of a previous national or international application, shall comprise a copy of the results of any search carried out on behalf of the authority with which the previous application was filed.

Accordingly amended Rule 141 EPC and new Rule 70b EPC will apply to all European patent application and Euro-PCT applications filed on or after January 1, 2011 (In case of Euro-PCT applications the international filing date of the PCT application is relevant).

2. Time and form

Amended Rule 141 EPC applies to all European patent applications claiming priority of a previous application within the meaning of Art. 87 EPC. The applicant shall file a copy of any search carried out by the authority with which the previous

application was filed together with the European patent application. In the case of a Euro-PCT application, a copy of the prior search result is to be filed upon entry into the European phase.

Where the prior search results are not available when filing the European patent application or, in the case of a Euro-PCT application, when entering the European phase, the applicant has to file the search results with the EPO without delay after they are made available to him. Ideally, in terms of efficiency, the search result shall be available to the EPO examiner when he/she is drafting the extended European search report.

The obligation under Rule 141(1) EPC exists as long as the European patent application is pending before the EPO.

For Euro-direct and international applications for which the EPO is a designated or elected Office (Euro-PCT applications), the patent office with which the previous application was filed will normally be a national or a regional Office. Hence, as a rule, the search results to be filed are those drawn up by an NPO/RPO in re-

spect of a national patent application or of any other application for industrial property rights that gives rise to a right of priority (utility model, utility certificate, see Article 87 EPC). It currently is assumed that in case of a provisional US application as previous application, no search results are to be filed as no search is carried out.

Where multiple priorities are claimed, the applicant has to file copies of the prior search results drawn up in respect of all previous applications concerned.

The copy of the search results submitted must be a copy of the official document issued by the respective patent office. An informal list of the cited prior art drawn up by the applicant himself is not sufficient for the purpose of Rule 141 EPC.

Where the search results are drawn up in a language that is not an official language of the EPO, a translation of those search results is not necessary. It is further not necessary to file any copies of the documents cited in the prior search results.

3. Search report available to the EPO

Amended Rule 141(2) EPC provides that a copy of the search results under Rule 141(1) EPC shall be deemed to be duly filed if it is *available* to the EPO and to be included in the file of the European patent application under the conditions determined by the President of the European Patent Office.

This provision allows the President of the EPO to determine the cases in which the prior search results are considered *available* to the EPO and are automatically included in the file of the European patent application. In these cases applicants are exempted from the obligation to file a copy of the search results.

With Decision of the president of the EPO dated October 5, 2010, at present this exemption applies only to the following types of search reports drawn up by the European Patent Office on an application whose priority is claimed:

- European search report (Art. 92 EPC)
- international search report (Art. 15(1) PCT)
- international-type search (Art. 15(5) PCT)
- search report made on behalf of a national office on a national application (Belgium, Cyprus, France, Greece, Italy, Luxembourg, Malta, Netherlands, Turkey).

The EPO together with interested NPOs intends to set up the necessary electronic environment for accessing further national/regional search results. Applicants claiming the priority of an application filed with a NPO/RPO for which such an electronic system is in place will be exempted from the obligation to file a copy of the search results under Rule 141(1) EPC. In this context, it is currently also being explored to what extent existing document exchange systems can be used.

The EPO will publish a decision of the President of the EPO under Rule 141(2) EPC as soon as the necessary electronic environment is available. At present it is not foreseeable at what time such environment may be available.

4. Information on related applications

New Rule 141(3) EPC which largely corresponds to present Rule 141 EPC provides that the European Patent Office may invite the applicant to provide, within a period of two months, information on prior art within the meaning of Article 124(1) EPC.

Rule 141(3) EPC allows the EPO to request any information on prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates. This in particular encompasses search results with respect to filings whose priority is not being claimed in the European patent application. It also enables the EPO to request the copy of prior national/regional search results referred to in Rule 141(1) EPC in situations where the search result is not available to the applicant when requested under new Rule 70b EPC (see below for the explanations on Rule 70b EPC).

It is pointed out in the subject EPO communication that an invitation under Rule 141(3) EPC will be issued only during the examining phase and only in individual cases.

5. New Rule 70b EPC

New Rule 70b(1) EPC complements amended Rule 141 EPC and provides for consequences in cases where the applicant fails to provide the information required under Rule 141 EPC.

Where the EPO notes, at the time the examining division assumes responsibility, that a copy of the relevant search results as required under Rule 141(1) EPC has not been filed by the applicant and is not deemed to be duly filed under Rule 141(2) EPC, the EPO invites the applicant to file, within a non-extendable period of two months,

- a copy of the search results required under Rule 141(1) EPC, or
- a statement of non-availability of these search results (e.g. where the search results are not yet available to the applicant or where the PO does not carry out a search with respect to the previous application claimed as priority).

Where the applicant fails to reply in due time to the invitation under Rule 70b(1) EPC, the European patent application will be deemed to be withdrawn (Rule 70b(2) EPC). In such cases, further processing can be requested.

Where a divisional application enjoys a

right of priority, the EPO will, where applicable (i.e. where no copy of the relevant search results has been filed for the divisional application), automatically issue an invitation under Rule 70b(1) EPC. However, where all relevant search results have already been filed with respect to the parent application, the applicant need not reply to the Rule 70b EPC communication received with respect to the divisional application.

Where, with respect to the parent application, an applicant has filed a statement of non-availability as a reply to the Rule 70b(1) EPC invitation, the copy of the relevant search results or a new statement of non-availability of these search results must be filed with respect to the divisional application.

Summary

For European patent applications claiming priority of a earlier national or regional application, the search results drawn up by the authority with which the previous application was filed, are to be transmitted to the EPO.

Such prior search results shall - but need not - be filed together with the European patent application documents.

If at the time the examining division assumes responsibility no copy of the relevant search results was filed, the EPO invites the applicant to do so within a non-extendable period of two months. Upon failure to reply to such invitation, the application is deemed to be withdrawn.