

New (Limited) Duty of Candor in the EPO (Amended European Rule 141)

In December 2009, the European Patent Office (“EPO”) announced in the Official Journal the amendment of Rule 141 and the insertion of new Rule 70b.¹ These changes to the European Patent Convention (“EPC”) modify the requirements for supplying search results on priority applications, introducing a limited duty of candor to the EPO. While Article 124 of the EPC currently allows the EPO to invite an applicant to provide information on prior art cited on related applications,² the new Rules add more teeth to the provision by requiring, rather than merely inviting, search information on related applications. This article examines the language of, and describes what is required under, the new Rules, which will apply to direct European patent applications and national phase PCT applications filed on or after January 1, 2011,³ and proposes some practical considerations for EPO applicants and practitioners in preparing for these changes.

Amended Rule 141 -Information on Prior Art

The most substantial change is Amended Rule 141(1), which requires an applicant to provide a copy of the results of any search that was carried out on a priority application when filing a European application or when entering the regional phase in Europe.⁴ Upon reading the Rule, it is not clear as to exactly what is meant by “a copy of the results of any search carried out by the authority with which the previous application was filed....” If the priority document is a U.S. utility application, would submitting a copy of the Notice of References Cited (PTO-892) from an Office action be sufficient, or would the Applicant also be required to provide a copy of the Office action issued by the U.S. Patent Office? The EPO has not yet provided clarification of this language in Rule 141(1).

In cases where multiple priorities are claimed, search results must be disclosed for each priority application. If the results are unavailable upon filing, they must be filed “without delay after such results have been made available.”⁵ Under Rule 141(1), the EPO requires a copy of the search results in whichever form they originally issued, such as a search report, a listing of cited prior art, or the relevant part of the examination report. According to the language of the Rule as compared to Rule 141(3) (discussed below), it appears that a simple listing of the cited prior art is not acceptable. However, a translation of the search results is not required, and copies of the cited prior art are also not required.

Rule 141(2) eases the burden on what the applicant is required to provide, establishing that search results already “available to the European Patent Office” need not be disclosed.⁶ As such, Rule 141(2) allows the Rule 141(1) requirement to be fulfilled where search results are already available to the EPO. The EPO recently issued a decision stating that the applicant shall be exempted from filing a copy of the search results under Rule 141(1) if the search was carried out by the EPO or national patent offices of Belgium, Cyprus, France, Greece, Italy, Luxembourg, Malta, Netherlands, or Turkey.⁷

Rule 141(3) empowers the examiner to request the applicant to provide “... information on prior art taken

into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates.”⁸ The language of Rule 141(3) merely requires “information on prior art,” which is different than Rule 141(1), and thus it appears that a simple listing of prior art will be acceptable to satisfy a Rule 141(3) request. The examiner retains discretion to issue a Rule 141(3) request,⁹ but once the request has been issued, the prior art information must be submitted within two months.⁹ Failure to submit a response will result in the application being deemed withdrawn.¹⁰ In contrast to Rule 141(1), the examiner can issue multiple requests at later times during prosecution of the application under Rule 141(3).

Rule 70b -Failure to Provide Search Results Under Rule 141

New Rule 70b establishes the enforcement procedure for instances where search results have not been provided under Rule 141(1) and are not deemed to be available to the EPO under Rule 141(2). Upon recognition of the applicant’s non-compliance with Rule 141, Rule 70b(1) empowers the Examining Division to issue an invitation to provide the required search results.¹¹ The invitation sets a two-month reply period in which the applicant must file either a copy of the required search results under Rule 141(1) or a statement that the search results are not available to the applicant.¹² It should be noted that the wording of Rule 70b does not appear to allow for extensions of time in which to file a copy of the search results. Consequently, and until otherwise instructed by the EPO, applicants and their attorneys must assume that the two month deadline is non-extendable. Rule 70b only addresses Rules 141(1) and 141(2) and applies “at the time the Examining Division assumes responsibility,”¹³ indicating that Rule 70b seeks to prohibit initiation of examination without available search reports.¹³ Failure to comply with a Rule 70b request will result in the application being deemed withdrawn.¹⁴

Practical Considerations

While the Amended EPO Rules may remind some of the Information Disclosure Statement (IDS) practice in the United States Patent and Trademark Office (“USPTO”), the language of the Rules indicate that the burden is not as significant as the U.S. disclosure practice, because, for example, the duty is not ongoing and copies of the cited art do not have to be supplied to the EPO. Nonetheless, it is clear that Rule 141(1) can be read as creating a duty of candor for priority applications. However, unless the search reports are not yet available, the duty to provide the search reports to the EPO applies only at the time of filing. Further, in practice, Rule 141(1) may have only a limited effect on many applicants since search reports do not issue on many priority applications, such as U.S. Provisional applications. Rule 141(3) also does not appear to establish an ongoing duty of candor to the EPO, and thus, once a reply has been submitted to the EPO, the obligation under Rule 141(3) is fulfilled. However, it is important to remember that the EPO can issue a request under Rule 141(3) at any time during prosecution of the application.

Additionally, the Amended EPO Rules do not require the submission of search results for related, non-priority documents. Thus, if a U.S. utility application is filed on the same day as a PCT application (on or after January 1, 2011), and an Office action issues in the U.S. case before the PCT application enters

the European regional phase, the duty of candor owed to the EPO is not implicated and the U.S. search results do not have to be reported to the EPO. However, out of an abundance of caution, it may be prudent to send the results to the European attorney responsible for the case.

However, if the priority document is a non-provisional U.S. patent application, and the PCT/direct European filing is made before the issuance of the results of the first search, *i.e.*, the first Office action from the USPTO, the U.S. attorney should docket a reminder to promptly submit the search results to his/her European counterpart.

Regardless of the limited scope of Rule 141, when filing either a direct European application or a PCT application on or after January 1, 2011, an applicant should provide to her/his European counsel a copy of all search results for all priority applications. In addition, as patent attorneys acquire new EPO cases, they should carefully note whether there are any priority claims in the application. If at least one priority application exists, they should immediately acquire a copy of any search results issued on the priority applications and forward the results to the European counsel.

Bradley W. Crawford has extensive experience in patent application preparation and prosecution, with an emphasis in synthetic organic chemistry as well as medicinal chemistry. Before joining MBHB, Mr. Crawford drafted patent applications at Abbott Laboratories, where he also worked as a medicinal chemist. He is listed as a co-inventor on three U.S. patents.

crawford@mbhb.com

James V. DeGiulio, Ph.D. prepares and prosecutes patent applications, conducts legal research, and provides technological advice in support of validity, infringement and patentability analyses, patent application preparation and prosecution, and litigation matters in the life sciences fields.

degiulio@mbhb.com

Authors' Note

While the authors address EPO practice, the authors are not European Patent Attorneys. For a more complete analysis, we recommend contacting a licensed European Patent Attorney. We wish to thank Gill Smaggasale from W. P. Thompson & Co. law firm, for her help in reviewing this article.

Endnotes

1. Decision of the Administrative Council of 28 October 2009 amending the Implementing Regulations to the European Patent Convention (CA/D 18/09), OJ EPO 12/2009, 585-6.
2. Rule 125 EPC.
3. *See supra* Note 1, Article 2(2).
4. Rule 141(1).
5. *Id.*
6. Rule 141(2).
7. Decision of the President of the European Patent Office dated 5 October 2010 on the filing of copies of search results under Rule 141(1) EPC -utilisation scheme, *available at* <http://www.epo.org/patents/law/legal-texts/journal/president/archive/20101020.html>.
8. Rule 141(3).
9. *Id.*
10. *Id.*



11. Rule 70b(1).
12. *Id.*
13. *Id.*
14. Rule 70b(2).