

Client Advisory | *October 2010*

## New Information Disclosure Requirements to be Introduced by the European Patent Office

The EPO has announced yet further rule changes which apply to all European patent applications, including divisional applications, and Euro-PCT applications filed on or after 1 January 2011. These changes require applicants to submit the results of any searches carried out on an application from which an EP application claims priority. They also allow an EPO Examiner to request that the applicant provides information on prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates. On applications filed on or after 1 January 2011, we recommend that any prior art cited in connection with priority applications is disclosed to the EPO.



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### Providing information on prior art

Under amended Rule 141<sup>1</sup> EPC, an applicant claiming priority from a previous application must file a copy of the results of any search carried out by or on behalf of the authority with which the previous application(s) was filed. Copies of the cited documents themselves do not have to be filed. The obligation continues as long as the European patent application is pending before the EPO.

For European divisional applications, the copy of the search results does not have to be filed again if it has already been filed on the parent application.

Under Rule 141(3) EPC, the European Patent Office may invite the applicant to provide, within a period of two months, information on the prior art. This rule 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 rule change therefore encompasses search results with respect to filings whose priority is not being claimed. An invitation under Rule 141(3) EPC will only be issued during the examining phase and only in individual cases.

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- <sup>1</sup> (1) An applicant claiming priority within the meaning of Art. 87 shall file a copy of the results 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 on entry into the European phase, or without delay after such results have been made available to him.
- (2) The copy referred to in paragraph 1 shall be deemed to be duly filed if it is available to the European Patent Office and to be included in the file of the European patent application under the conditions determined by the President of the European Patent Office.
- (3) Without prejudice to paragraphs 1 and 2, 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).

## Requesting for a copy of the search results

New Rule 70b EPC<sup>2</sup> complements amended Rule 141 EPC. Where the applicant fails to provide information on the prior art, the European patent application will be deemed to be withdrawn. Further processing can be requested.

## Impact

In practice, these rule changes are likely to have a limited impact on applicants since search reports are not typically issued on priority applications unless a search by the patent office has been explicitly requested. The obligation under Rule 141(3) EPC may have broader applicability since it concerns prior art cited in national

or regional patent proceedings. However, this obligation is at the discretion of the EPO Examiner and does not establish any ongoing duty.

We will await with interest to see how the EPO implements these rule changes. In particular, it will be interesting to see if these rule changes pave the way for more stringent information disclosure requirements at the EPO.

- <sup>2</sup> (1) Where the European Patent Office notes, at the time the Examining Division assumes responsibility, that a copy referred to in Rule 141 (1) has not been filed by the applicant and is not deemed to be duly filed under Rule 141 (2), it shall invite the applicant to file, within a period of two months, the copy or a statement that the results of the search referred to in Rule 141 (1), are not available to him.
- (2) If the applicant fails to reply in due time to the invitation under paragraph 1, the European patent application shall be deemed to be withdrawn.

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