

## **Information on Prior Art in the European Patent Procedure**

### **a) Amended Rule 141 EPC**

According to amended Rule 141 EPC an applicant claiming the priority of an earlier application has to file a copy of any search results for the priority application.

The Applicant has to submit the earlier search results

- (a) together with the direct European patent application, or
- (b) upon entry into the European regional phase, i.e. a Euro-PCT application.

This obligation applies to European patent applications, European divisional applications and international patent applications with designation of Europe filed on or after January 1, 2011.

In case of multiple priorities, copies of previous search results of all priority applications must be submitted. Rule 141 (1) EPC applies to all types of search results (like search report, listings of prior art, relevant parts of examination reports). The submitted copy of the search result has to be a copy of the official document as it has been issued by the respective patent office. A listing of the prior art by the applicant is not sufficient. A translation of search results is not required. Copies of referenced documents do not have to be provided. It is not necessary for divisional applications to submit a copy of search results for a priority application, if this has already been done for the parent application.

The EPO together with the Japanese, US-American and British Patent Office have agreed to make search results available in digital format to each other. Therefore applicants are exempted from the obligation to file a copy of search results claiming the priority of an application filed with one of these national patent offices. Also search results the EPO has issued itself need not to be submitted.

New Rule 141(3) EPC provides that the EPO may 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 largely corresponds to previous Rule 141 EPC. Request pursuant to Rule 141(3) EPC will only be issued in individual cases.

If the search results are not present when filing the patent application or in the case of a Euro-PCT application entering the European phase, the applicant has to submit these search results immediately upon receipt.

### **b) New Rule 72 b) EPC**

The new Rule 70b EPC completes the amendments of Rule 141 EPC. If search results have not been provided, the Examining Division will issue a communication according to new Rule 70b EPC setting a non-extendable two month period for reply in which the applicant must file either:

- (a) a copy of the search results, or
- (b) a statement of non-availability of search results (only if they are not available to the applicant). Failure to comply will result in the application being deemed withdrawn.

Where a divisional application enjoys a right of priority, the EPO will 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 does not need to reply to the Rule 70b EPC communication received with respect to the divisional application.

### **Disclaimer**

This information letter contains general information about the amendments of Implementing Regulations to the EPC which could be of interest to our clients and foreign firms and their clients. This is not a legal advice. Additionally, the actual implementation of the amendments by the EPO has not been fully clarified as yet. Therefore, we cannot provide and take over any warranty and liability for the provided information and for the consequences following any action made due to the information provided in these letters. Please do not hesitate to contact us for further information and also a legal advice or expert opinion which might be charged according to our regular schedule of fees.