

NEW RULES ON SEARCH

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On January 1, 2011, new changes to the Implementing Regulations of the European Patent Convention (EPC) entered into force. These changes mean that an applicant claiming priority from an earlier patent application must provide the EPO with a copy of the results of any prior art search conducted on the priority application.

The purpose is to accelerate the examination of patent applications for which search and/or examination work has already been conducted at another intellectual property office. The new rules allow the EPO to exploit work previously done by another office, thereby reducing duplication of search and examination procedures.

The EPO has amended Rule 141 EPC and introduced new Rule 70b EPC. These rules introduce a mandatory requirement that applicants must provide the EPO with a copy of any prior art search results for all priority applications. These new rules will apply to all European patent applications (including Euro-PCT and divisional patent applications) filed on or after January 1, 2011.

A copy of the search results must be filed together with a direct European patent application or upon entry into the European regional phase of a Euro-PCT application. If the search result is not available at the date of filing, the applicant must supply the copy “without delay”, once the prior art search results have been made available to the applicant. What is meant by “without delay” is not clear, and apparently there are no sanctions for failing to fulfil this obligation.

However, if the Examining Division notes at the time of assuming responsibility for an application that a copy of the search results has not yet been included in the EPO file, it will invite the applicant to submit the results within two months. If the applicant does not submit the search results in time, the application is deemed withdrawn. Further processing is available.

Even though the amended Rule 141 EPC requires that applicants provide the EPO with access to search results for all priority applications, intellectual property offices in Japan, the United Kingdom and the United States have agreed to share search results with the EPO automatically. Applicants are therefore not required to supply the EPO with a copy of prior art search results produced by these patent offices. Since the EPO already has access to its own search results, applicants do not have to file a copy of search results produced by the EPO. Furthermore, for divisional European applications, there is no need to file a copy of search results obtained for a priority application if it has already been filed for the parent application.

“IN ORDER TO MEET THE REQUIREMENTS OF PRIOR SEARCH RESULTS, THE EPO HAS STRESSED THAT AN ACTUAL COPY OF THE SEARCH RESULTS ISSUED BY THE PATENT OFFICE OF FIRST FILING MUST BE FILED; A MERE LISTING OF PRIOR ART REVEALED BY THE SEARCH IS NOT ALLOWED.”

In order to meet the requirements of prior search results, the EPO has stressed that an actual copy of the search results issued by the patent office of first filing must be filed; a mere listing of prior art revealed by the search is not allowed. However, the applicants are not required to provide a translation of search results drawn up in a non-official language of the EPO or copies of the prior art documents themselves.

Presently, it is not clear what is meant by the expression “any search” in Rule 141(1) EPC, and this could be interpreted to extend to results of supplementary searches and later citations of new documents in examination reports issued after the search report. However, it must be noted that an applicant is not required to inform the EPO of all prior art known to him, but only prior art identified by the patent office(s) that handled the priority application.

Although the above changes to the EPC place an additional burden on applicants, this burden must not be confused with the Information Disclosure Statement required by the United States Patent Office. In the US, any person involved in the preparation or prosecution of a US patent has an obligation to disclose all prior art relevant to patentability, otherwise an issued patent can be held unenforceable or invalid. In contrast, failure to comply with the changes made to the EPC will not threaten the enforceability of a granted EP patent. Furthermore, it is likely that more national patent offices will share search results automatically with the EPO, thereby decreasing the burden on applicants.

In any case, the effort and initiative demonstrated by the EPO in the search for efficient solutions to improve the framework for IPR protection is welcome. ■

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