

**Revised EPO Rule 141 and New Rule 70b
(Information on Prior Art -
Copies of Search Results)**

**Revised Rule 141 and New Rule 70b -
Apply to European patent applications
and International patent applications
filed on or after 1 January 2011**

**Revised Rule 141 - Information on prior
art**

(1) An applicant claiming priority within the meaning of Article 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, paragraph 1.

**New Rule 70b - Request for a copy of
search results**

(1) Where the European Patent Office notes, at the time the Examining Division assumes responsibility, that a copy referred to in Rule 141, paragraph 1, has not been filed by the applicant and is not deemed to be duly filed under Rule 141, paragraph 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, paragraph 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fails to reply in due time to the invitation under paragraph 1, the European patent application shall be deemed to be withdrawn.

**Article 124 Information on prior art
(entered in to force with EPC2000 in
December 2007)**

(1) The European Patent Office may, in accordance with the Implementing Regulations, invite 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.

(2) If the applicant fails to reply in due time to an invitation under paragraph 1, the European patent application shall be deemed to be withdrawn.

EPO Rule Changes Effective 1 January 2011 – Prior Art Information

EPO rule changes which apply to European patent applications and International patent applications filed on or after 1 January 2011 introduce a new requirement for applicants to supply the EPO with information concerning Patent Office searches carried out in relation to the application(s) from which priority is claimed.

Article 124 EPC already provides that the EPO can request an EP applicant to give information about prior art cited by other patent offices on applications corresponding to an EP application. In our experience, such requests are rare.

Amended Rule 141 and new Rule 70b introduce new requirements for an EP applicant to file “a copy of the results of any search” carried out by the patent office(s) which handled the application(s) from which priority is claimed.

Rule 141(2) provides for the possibility that in some situations, determined by the President of the EPO, search results need not be filed by the applicant if they are otherwise available to the EPO.

Under a Decision of the President of the EPO dated 9 December 2010, an EP applicant is exempted from having to file search results under Rule 141 if the priority of a first filing made in Japan, the USA or the UK is claimed. **Thus, if an EP application claims priority to an earlier application filed in Japan, the USA or the UK, no action is required by the applicant with regard to the search results issued on that earlier application.** It is possible that further countries will be added to this list of exemptions under Rule 141(2) in the future.

An EP applicant is also exempted from having to file search results if the EPO drew up the search report on the application from which priority is claimed, for example if the EPO drew up a European search report or an International (PCT) search report on the earlier application.

If an application from which priority is claimed is not covered by one of the exceptions above, the applicant will have to provide the search results to the EPO. In some jurisdictions there is no distinct “search” phase. The EPO will regard as “results of any search” any office action issued on the earlier application in which prior art is cited. A copy of the relevant official document (e.g. office action) is required. A translation of the official document is not required, nor are copies of the cited prior art references.

In some cases, no office action will be issued by the “office of first filing” (OFF) with respect to the application from which priority is claimed before an EP application is filed (or before a Euro-PCT application enters the European phase). In this case, the results of the OFF “search” of course cannot be filed when the EP application is filed (or when the Euro-PCT application enters the European phase).

Rule 141(1) recognizes this and indicates that the results of the OFF “search” can be filed at a later time “without delay after such results have been made available”. We assume that “without delay” means as soon as reasonable after the OFF “search” results are available. However, no penalty is imposed if the results of the OFF “search” are not provided “without delay”.

Rule 70(b) then provides that when the EP application (or Euro-PCT application) enters the EPO examination phase the EPO can issue a letter setting a 2-month term for the applicant to file the OFF “search” results – or a statement that the OFF “search” results are still not available. If OFF “search” results are available at the time the EPO examination phase is entered, they can be filed within the relevant 2-month time limit. If OFF “search” results are still not available, it is necessary only to inform the EPO that they are not available.