

Practice Note

UK Patent Applications



DISCLOSURE OF SEARCH RESULTS

With effect from 1 July 2004 the UK Patent Office will require applicants for UK patents to disclose the results of official searches carried out by other patent offices on corresponding applications. The disclosure requirement is time-limited, and the period in which disclosure is required expires with the time limit for responding to the first examination report. If the first examination report is an acceptance notice, requiring no response, the disclosure period ends two months after the date of issue of the acceptance notice.

At the time of writing this note, on cases where no combined search and examination request has been made the first examination report is typically not issued until around 3½ years from the earliest priority date, so the disclosure period for such cases is quite long.

The Patent Office prefers that, when a request for substantive examination is filed, a disclosure is made of any search results available at that time. Further disclosures should then be made if new search results become available within the disclosure period. It is not necessary to disclose search reports that cite no documents, or search reports that have issued on corresponding PCT or EPC applications, unless those search reports have not yet been published by WIPO or the EPO. Also, search results that were disclosed on a UK parent application do not need to be disclosed again on any UK divisional application.

The disclosure requirement is satisfied either by filing a copy of the search report or by e-mailing the Patent Office details of the cited documents. It is not necessary to furnish copies of the cited documents themselves. From now on, the official covering letter accompanying the UK search report will contain a request for disclosure of search results. The Patent Office does not intend to make a disclosure request on any application for which the UK search report had already issued prior to 1 July 2004, and any disclosure of search results on such an application is at the applicant's discretion.

EXAMINATION OPINIONS AND ABBREVIATED EXAMINATION REPORTS

With effect from 1 April 2004 the UK Patent Office has introduced the possibility of issuing an **examination opinion** and/or an **abbreviated examination report** on selected applications where the Examiner believes that early amendment will lead to a more efficient examination process.

An examination opinion may be issued when the search report is issued, i.e. before a request for substantive examination has been filed. The opinion will draw the applicant's attention to major issues which, in the Examiner's opinion, will require substantial amendment of the application at the substantive examination stage. Such major issues are likely to include novelty/inventive step (particularly where the scope of the broadest independent claim is so large that numerous anticipating documents are found in the search), plurality of invention, complex claim structures, and non-statutory subject-matter.

The examination opinion is intended to encourage the applicant to file an amendment, addressing the issues raised in the report, at or prior to the time of filing the examination request. It is not a statutory examination report (Sec. 18 report) and any response filed to an examination opinion will not count as a response to a Sec. 18 report. Accordingly, the applicant's ability to file voluntary amendments up to the expiry of the term for responding to the first examination report is not affected.

An abbreviated examination report is a statutory examination report. It will only be issued as a first examination report but will have a shortened response term, of only two months, compared to the usual six months. The issues raised in such an abbreviated examination report are likely to be similar to those outlined above in connection with the examination opinion. Because it is a statutory report, expiry of the two-month term is the applicant's last opportunity to file voluntary amendments.

Where an examination opinion is issued with the search report, and the applicant does not make an early amendment addressing the issues raised in the opinion, it is likely that the Examiner will issue an abbreviated examination report with similar content to the examination opinion.

On selected UK national-phase applications based on PCT applications it is also expected that the first examination report will be an abbreviated examination report in which the UK Examiner relies on the search (and, where available, examination) results available from the international phase.

As a transitional measure, the Patent Office is currently reviewing applications for which examination requests have already been filed but which are still awaiting issuance of the first examination report to identify which of these applications would benefit from issuance of an abbreviated examination report. As an exception to the normal rule, the term allowed for responding to the abbreviated examination report on such applications will be six months.