

Rule 141 EPC has been amended, with effect on 1st January 2011.

According to new Rule 141(1), an applicant for a European patent application claiming priority of a previous application has to file a copy of the results of any prior art search carried out by the authority with which the previous application was filed (office of first filing).

Such a copy shall be filed together with the European application, or, in the case of a Euro-PCT application, on entry into the European phase.

Where the applicant has not received from the office of first filing the copy of the search results when filing the European application (or when entering into European phase for a PCT), he has to file such a copy without delay after he has received it.

No sanction is provided in case of non-compliance with these provisions.

Furthermore, according to Rule 141(2), the applicant is exempted from the obligation to file a copy of the prior art search results when such results are available to the EPO, in particular in the following cases:

- The previous search was performed by the EPO (for example when the previous application is a EP application, or a PCT with EPO acting as ISA),
- The EPO has an exchange agreement with the Office of first filing (a list of the corresponding Offices should be published by the end of 2010).

Furthermore, a new Rule 70b has been introduced in the EPC.

According to this rule, if the copy of the prior art search required under Rule 141 has still not been duly filed when the Examining Division of the EPO starts examining the application on the merits, the Examining Division shall invite the applicant to file, within a non-extendable period of two months, such a copy, or, in case these results are still not available to the applicant, a corresponding statement (for example, in case the search results are not yet available to the applicant, or in case the Office of first filing does not carry out a search with respect to the previous application).

If the applicant fails to reply to such an invitation, the application shall be deemed to be withdrawn.

In such a case, the applicant can request further processing of its application, within two months after reception of the communication of withdrawal, by filing the requested documents (search results or non-availability statement) and paying the further processing fee.

When multiple priorities are claimed, the applicant has to file copies of the prior art search drawn up for all previous applications.

The copy of the results of prior art search has to be filed as such, that is to say under the form it was drawn up by the office of first filing: the copy submitted to the EPO must be a copy of the official document issued by the office of first filing (search report, listing of cited prior art, relevant part of an examination report). A listing of the cited prior art drawn up by the applicant himself is not sufficient.

However, neither a translation of the search results, nor copies of the documents cited are required.

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

These new provisions shall enter into force on 1st January 2011, and shall apply to European patent applications and PCT applications filed on or after that date.

The purpose of these new rules is to improve the examination performed by the EPO. However, there is absolutely no obligation for the EPO examiner to use the previous search results submitted by the applicant, such a use being at the total discretion of the EPO examiner.

To comply with these new obligations, we recommend the following strategy:

1. In cases in which the previous search was performed by the EPO, or in which the EPO has an exchange agreement with the Office of first filing, there is nothing to do.
2. In other cases:
 - If the results of the prior art search are available when filing the European application (or when entering into European phase for a PCT): file a copy thereof, in order to avoid issuance of an invitation under Rule 70b,
 - If the results of the prior art search results are not available when filing the European application (or when entering into European phase for a PCT): file nothing, and wait for the invitation under Rule 70b – but do not file a statement of non-availability of the prior art search results at the filing (or European phase entering) date, because this is of no use, and does not avoid the issuance of an invitation under Rule 70b.

For any further advice, please do not hesitate to contact us.

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