

A horizontal banner image with a grid overlay. It contains several panels: a scale of justice, a person's face, a computer keyboard, and a gavel.

JONES DAY
COMMENTARY

INFORMATION DISCLOSURE REQUIREMENTS IN RELATION TO EUROPEAN PATENT APPLICATIONS

According to the European Patent Convention's current Implementing Regulations, an inventor applying for a European patent may be invited by the European Patent Office ("EPO") to submit information on prior art that was taken into consideration in the examination of related national or regional patent applications. If the information is not provided in a timely fashion, the application will be deemed to have been withdrawn. These regulations have now been amended to make it compulsory to file a copy of the results of any search carried out in relation to the application or applications of which the European patent application claims priority. This requirement will enter into effect on January 1, 2011, and will apply to European patent applications and international patent applications filed after that date.

In the case of a direct European patent application, the search results must be filed together with the application. In the case of an international patent

application entering the European regional phase, the search results must be filed on entry in the European phase. If the search results become available later, then they must be supplied without delay.

Although the applicant is required to provide only the results of searches conducted in respect of the priority application, search results in respect of other applications relating to the same invention may still be requested, with the application deemed to have been withdrawn if the request is not complied with in a timely manner.

In practice, the new requirement is not as strict as it may appear at first sight. Although the prior art taken into consideration in the examination of the priority application should be included upon filing or filed upon entry in the regional phase, there will be no immediate adverse consequences if this is not done. Instead, once the European patent

application enters the examination stage, the EPO will send an invitation to supply the information within a period of two months. The European patent application will be deemed to have been withdrawn only if no response to this invitation is filed.

Nonetheless, applicants or their attorneys seeking to maximize the efficiency of their foreign filing procedures would be well advised to assemble the information on prior art when instructing their European patent attorneys to file a new European patent application or to enter the European phase, because this would normally coincide with the filing of corresponding patent applications in other jurisdictions that have information disclosure requirements.

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