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EU Rule Changes from January 2011

New EPC rules from 1 January 2011 require search results from Patent Office of first filing (i.e. priority application(s)) to be submitted at time of filing or EP Regional entry.

In order to make further efficiencies in search and examination, the EPC will be introducing an amendment to rule 141 and a new rule 70b, both effective from 1 January 2011. This follows from collaboration between major patent offices in the Utilisation Pilot Project.

Although the applicant will be under an obligation to provide the search results at the time of filing a European application or EP regional phase entry from a PCT application, there is no sanction for failure to do this. Later, during examination, if it is noted that such search results have not been filed, the EPO will invite the applicant to do so within two months. Failure to respond will result in deemed withdrawal of the application, but, as usual, the application can still be revived under further processing provisions for a short period after.

Best practice will be to comply with the EPC requirement at the time of filing/EP regional phase entry wherever possible.

Note that the EPO require an actual copy of the search results in the form in which they are provided by the office of first filing. Also, the search results for **each** priority application are required. However, copies of the documents cited in the search results are not required and it is not necessary to provide a translation of the search results document if it is in a language other than English, French or German.

In respect of divisional applications, a copy of the priority case search results does not have to be filed again.

Applicants will be exempted from this requirement to file search results to the extent that these results can already be accessed by EPO directly by electronic means from other national patent offices. The EPO will publish information both prior to and after entry into force of these new rules concerning the extent to which this exemption will be applicable.

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