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CITATION OF PRIOR ART

IP5 REPORT

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I. INTRODUCTION

In June 2013 the IP5 Offices were presented with the so-called Industry IP5 Harmonisation Topics List including an extensive set of target areas where a prospective alignment of practices was regarded desirable. Following an evaluation of the listed items and on the basis of a proposal jointly submitted by KIPO and the JPO, the IP5 Offices agreed at the ad hoc meeting of the Patent Harmonisation Experts Panel (PHEP) in April 2014 to prioritise work on the topics; unity of invention, written description/sufficiency of disclosure and citation of prior art (point 5 - 10, RoD, ad hoc PHEP meeting, 15 April 2014).

The PHEP work plan was endorsed by the IP5 Heads of Office at their meeting in June 2014. Additionally, KIPO and the USPTO were designated as lead offices for the topic, citation of prior art. (point 13, RoD, IP5 Heads of Office meeting, 6 June 2014).

During the PHEP meeting in October 2014, KIPO and the USPTO as lead Offices covering citation of prior art proposed to focus on two prioritized sub-topics chosen by analysing IP5 comparison table and inputs from IP5 Industry. The IP5 offices agreed to focus on the two topics : 1. What legal or procedural changes would be required to allow for an IT based solution to submission of prior art previously cited by another office, and 2. What legal or procedural changes would be required to adopt a common form for the citation of prior art? IP5 offices also agreed on the roadmap to identify barriers before IP5 Deputy Heads and Heads meeting in 2015 and to explore solutions before 4th PHEP meeting in October 2015. (point 16 – 19, RoD, PHEP meeting, 17 October 2014).

Following the October 2014 PHEP meeting, KIPO and the USPTO requested that the IP5 offices submit the process by which applicants currently fulfil any duties related to the citation of prior art and an analysis of the potential legal and procedural barriers to implementing the two specific topics. The responses of the IP5 offices were collected and compiled by the two lead Offices.

II. THE PROCESS RELATED TO THE CITATION OF PRIOR ART

1. EPO

According to Article 83 EPC the application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Sufficiency of disclosure must be assessed on the basis of the application as a whole, including the description, claims and drawings. The provisions related to the content of the description are set out in Rule 42 EPC. The purpose of the provisions Article 83 and Rule 42 EPC is to ensure that (i) the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and (ii) to enable the reader to understand the contribution to the art which the invention as claimed has made.

According to Rule 42(1)(b) EPC the description should indicate any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art. Identification of documents reflecting such art, especially patent specifications, should preferably be included.

This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims. Acknowledgment of prior art relevant to the dependent claims only is generally not required.

In principle, when filing an application the applicant should cite in the description the closest prior art known to him. It may happen that the prior art cited by the applicant is not the closest existing for the claimed invention. The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, is required, where necessary, to put the invention into proper perspective. Under the EPC system it is considered that the subsequent inclusion of such a summary in the description does not contravene Art. 123(2) EPC, which prohibits the amendment of the application in a way that it contains subject-matter which extends beyond the content of the application as filed.

In addition, relevant prior art documents not cited in the original application may be subsequently acknowledged in the description even if these were known to the applicant at the time of filing. This is not subject to the payment of any fees.

In short, applicants may fulfil the requirement for citation of prior art by providing information on the background art in the description. For later identified relevant documents, the applicant may be invited by the examining (or opposition) division to subsequently amend the references to the prior art during the examination (or opposition). If the applicant does not follow this invitation, or if the applicant responds to the invitation in an insufficient manner, the application will be refused (Art. 97(2)) or the patent revoked (Art. 101(2) EPC).

As to the format of background art citations, the Guidelines for Examination in the EPO (F-II, 4.3.1) suggest the consistent use of the WIPO Standards format:

(i) for non-patent literature, WIPO Standard ST.14 (Recommendation for the Inclusion of References Cited in Patent Documents); (ii) for patent literature (applications, granted patents and utility models): for the two-letter country code, WIPO Standard ST.3 (Recommended Standard on Two-Letter Codes for the Representation of States, Other Entities and Intergovernmental Organizations); for symbols indicating the type of document, WIPO Standard ST.16 (Recommended Standard Code for the Identification of Different Kinds of Patent Documents).

WIPO Standards ST.14, ST.3 and ST.16 can be found on the WIPO website.

However, in case of deviation from these standards there is no need to correct the codes used, as long as straightforward retrieval of the citation(s) is possible.

2. JPO

(1) Obligation to state background art

The source of the information concerning the invention known to the public through publication such as the name of the publication and others (hereinafter referred to as “information on prior art documents”) must be described in the description when the

applicant has knowledge of any invention(s) related to the said invention, that has been known to the public through publication at the time of filing of the patent application (Patent Act Article 36(4)(ii)).

The information on prior art documents is required to grasp what technical significance the invention for which a patent is sought has and what technical contribution is brought about in light of the state of the art at the time of filing of the application, and to judge the novelty and inventive step etc. of the invention for which a patent is sought. Therefore, it contributes to not only timely examination but also stabilization of the right as the accurate evaluation on the relation between the invention for which a patent is sought and the prior art can be made if the information on prior art documents is stated in the description (Examination Guidelines Part 1, Chapter 3, 2. (1)).

(2) Obligation for examiners in other office to submit cited document

Regarding the procedures for the JPO, applicants are under no obligation to state the information on prior art documents cited by examiners of other offices.

(3) Exception

When there is a large number of inventions described in publications relating to the invention for which a patent is sought, it is desirable to describe appropriate number of inventions with higher relevancy among them, because it may hinder the understanding of the invention for which a patent is sought and go against the purpose of the requirement of citation of prior art in the JPO if all of them are described. In addition, the invention described in a publication not relating to the invention for which a patent is sought should not be described (Examination Guidelines Part 1, Chapter 3, 3.2 (2)).

(4) Effect of failure to fulfil the obligation

In the requirement of citation of prior art in the JPO, it is prescribed to carry out the notice under Article 48septies when the examiner acknowledges that it does not comply with the requirement of citation of prior art. Also, the fact that it does not comply with the

requirement in spite of the notice concerned is judged to be the reason for refusal (Article 49(v)) but not to be the ground for invalidation (Article 123(1)). The reason is that this requirement is established mainly for the purpose of realization of timely examination and even when it is in violation of this requirement, there shall be no substantial deficiency in the invention and it shall not damage the interest of a third person remarkably when it is patented.

The provision under the Patent Act Article 48septies prescribes that the notice on violation of the requirement concerned can be made when the examiner acknowledges that it does not comply with the requirement of citation of prior art.. Therefore, the notice under Article 48septies is not made uniformly but is made when the examiner recognized it to be necessary.

If the fact that it does not comply with the requirement of citation of prior art resulted in directly the reason for refusal, the reason for refusal would be notified uniformly on the whole cases of application, which do not comply with the requirement concerned. In this case, the reason for refusal on the violation of the requirement would be notified surely even to applications without any reasons for rejection on other requirements, which may be contrary to the aim of the requirement whose main purpose of realization of timely examination. In addition, if the applicants are individuals or medium and small-sized enterprises, it is possible that they aren't informed of the information on prior art documents relating to the invention for which a patent is sought at the time of filing. In such a case, if the reason for refusal surely had to be notified when it was recognized to be the violation of this requirement, it would not contribute to the timely examination and also it would give excessive burden to these applicants.

Based on the facts described above, it is more appropriate to operate the provision under Article 48septies so as to attain the timely examination as a whole than to operate it uniformly on all applications from the viewpoint of urging applicants to cooperate for timely examination through disclosure of information on prior art documents (Examination Guidelines Part 1, Chapter 3, 2. (2)).

(5) How to overcome an OA

An applicant can add information on prior art documents by amendments or insist that he/she does not know the relating invention described in a publication by submitting a written opinion to the notice under Article 48septies or the notice of reasons for refusal. When the amendment to add the information on prior art documents is carried out, it is desirable to submit a written opinion that describes contents of the invention described in a publication, and identical features and differences of the invention for which a patent is sought and the invention described in a publication (Examination Guidelines Part 1, Chapter 3, 5.1 (2), 5.2 (2)).

3. KIPO

(1) Obligation to state background art

Applicants should state background art in the description of invention under Article 42(3)(ii) of the Patent Act. Background art is a prior art which is helpful to understand the technical purpose of invention and useful to do search and examination.

Background art should be related to the claimed invention. The background art which is not related to the claimed invention or is too simple is deemed not to meet the requirement.

Applicants should state details of background art in the [Background art] section of the description. It is also recommended to provide information on prior art literature disclosing background art. The information on prior art literature is recommended to contain the country of publication, the name of gazette, publication number, publication date for patent literature and the name of author, title of publication (title of thesis), publisher, date of publication, etc. for non-patent literature.

Even if only the information on prior art literature is disclosed, not the detailed explanation on the background art, where the prior art literature describes proper

background art of the invention, the requirement for stating background art is considered to be fulfilled.

Where multiple prior art literature exist, it is recommended to provide the literature which is closest to the invention.

If background art of claimed invention is stated, it is deemed to satisfy the requirement for background art unless it is so simple that it cannot be useful to understand the claimed invention and to do prior art search and examination.

In short, applicants may fulfil all requirements for citation of prior art by stating appropriate details of background art or information on prior art literature in the description when filing application.

(2) Obligation to submit cited document by examiners in other offices

Apart from background art, it is not mandatory to separately submit examination result (documents cited by examiner) of foreign offices.

(3) Exception

If it is impossible to know background art of new invention which is totally different from existing art, it is allowed to state prior art in similar field, or to specify that appropriate background art can't be found.

(4) How to overcome an OA

If an application receives an office action with a reason for refusal since background art is not stated, the applicant may overcome it by adding information on prior art literature disclosing appropriate background art in the [Background art] section or its subsection, [Prior art document]. Adding information on prior art literature such as publication number is not deemed as addition of new matter.

However, it should be noted that if the applicant adds explanation on background art or contents of prior art literature, the said amendment may be considered as addition of

new matter if the explanation on background art is not obvious from the originally attached written description, claims or drawing(s).

(5) Effect of failure to fulfil the obligation

In KIPO, to state background art is the only obligation related to citation of prior art and if it is not fulfilled, the application may be rejected. This provision is not grounds for invalidation.

4. SIPO

(1) Obligation to state background art

Applicants should state background art in written description under Rule17-1(2) of the Implementing Regulations of the Patent Law. In this part of the description, applicants shall indicate the background art which can be regarded as useful for the understanding, searching, and examination of the invention, and when possible, cite the documents reflecting such art, especially the prior art documents which contain the technical features stated in the preamble portion of the independent claim of the invention, that is, the closest prior art documents.

The documents cited in the description may be either patent documents or non-patent literature, such as periodicals, magazines, manuals, books etc. Where a patent document is cited, at least the country of origin and the publication number, and preferably the publication date, of the patent document shall be clearly indicated. Where a non-patent document is cited, the title and the detailed source of the document shall be clearly indicated.

Moreover, in this part, the problems and defects existing in the background art shall also be objectively described; however, this requirement is limited only to the problem and defect to be solved by the technical solution of the invention or utility model. Where

appropriate, the reason why such problem exists and the difficulties encountered in solving the problem may also be explained.

Citation of documents shall further comply with the following requirements:

- (i) the documents cited shall be publications, either in paper form, or in electronic form;
- (ii) for non-patent documents and foreign patent documents, the publication date shall be earlier than the filing date of the application; for Chinese patent documents, the publication date shall be no later than the publication date of the application; and
- (iii) where the cited document is a foreign patent or non-patent document, the source and relevant information of the cited document shall be indicated in the original language as used for its publication. If necessary, Chinese translation thereof shall be provided, and put in parentheses.

(Section 2 of the Guidelines, chapter 2, 2.2.3)

(2) Obligation to submit cited documents of foreign offices

It is not mandatory to separately submit cited documents of foreign offices.

Under Article 36(2) of the Patent Law, if an application has been filed for an invention patent in a foreign country, the patent administration department under the State Council may require the applicant to submit, within a specified time limit, materials concerning any search made for the purpose of examining the application in that country, or materials concerning the results of any examination made in the country. In the event of the applicant's failure to comply at the expiration of the specified time limit without legitimate reasons, the application shall be deemed to be withdrawn.

Under Rule 49 of the Implementing Regulations of the Patent Law, where the applicant for a patent for invention cannot furnish, for justified reasons, the documents concerning any search or results of any examination specified in Article 36 of the Patent Law, he or it shall make a statement to the patent administration department under the State Council and submit them when the said documents are available.

It should be noted that in the current examination process of SIPO, there are very few occasions that the examiners ask the applicants to submit the cited documents of foreign offices.

(3) How to amend the background art

The part of “Background Art” in the written description is amended to make it consistent with the claimed subject matter of the invention. Where the independent claim is drafted according to the provisions of Rule 21, the relevant contents of the prior art described in the preamble portion of the claim shall be contained in the part of “Background Art” of the description, and the documents reflecting the background art shall be cited. If, through search, the examiner finds any reference documents which are even more related to the claimed subject matter of the invention than the prior art cited in the initial description by the applicant, the applicant shall be allowed to amend such part of the description by adding the contents of these documents and citing the documents. At the same time, the contents describing the unrelated prior art shall be deleted. It shall be noted that such amendment, in fact, has introduced the contents which are not contained in the initial claims and description. However, since the amendment relates just to the background art other than the invention per se, and the contents added are prior art already known to the public before the date of filing, it is allowable.

(Section 2 of the Guidelines, chapter 8, 5.2.2.2)

(4) Effect of failure to fulfil the obligation

According to the Article 26 of the Patent Law, the description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to carry it out. Under the Chapter 2.1.2 of the Part II of the Guidelines, a complete description shall include the contents which are indispensable for the understanding of the invention or utility model, such as the description of the relevant technical field and the state of the background art. So if the “background art” is indispensable for the understanding of the invention, the failure to fulfil the obligation would be the reason to reject the application for that the description will be incomplete under this case, also it will constitute the ground for invalidation. If the

“background art” is not indispensable for the understanding of the invention, there would be no consequence for the failure to fulfil the obligation.

According to the Article 36(2) of the Patent Law, if the examiner requires the applicant to submit, within a specified time limit, materials concerning any search made for the purpose of examining the application in that country, or materials concerning the results of any examination made in the country, in the event of the applicant's failure to comply at the expiration of the specified time limit without legitimate reasons, the application shall be deemed to be withdrawn.

5. USPTO

Under Rule 56 (37 Code of Federal Regulations (CFR) §1.56) individuals associated with the filing and prosecution of a patent application have a general “duty of candor and good faith” when dealing with the Office. Included in this general responsibility is a specific requirement to disclose to the Office all information known to that individual to be material to the patentability of an invention claimed in the application. Information is material to patentability when it is not cumulative to information already of record or being made of record in the application and it establishes either by itself or in combination with other information, a prima facie case of unpatentability of a claim; or it refutes, or is inconsistent with, a position the applicant takes in opposing an argument of unpatentability relied on by the office, or asserting an argument of patentability. A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. The duty to disclose all information known to patentability is deemed to be satisfied if all

information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by 1.97 (b)-(d) and 1.98.

U.S. patent law imposes a duty upon patent applicants to disclose all known prior art references that would be material to the patent examiner in determining patentability. Applicants fulfil that duty by disclosing the references in an Information Disclosure Statement (IDS).

(1) When can an IDS be submitted?

As set forth in 37 CFR 1.97, in order for an applicant to have an IDS considered by the Office during the pendency of the application, the IDS must be filed within one of the following time periods:

- (i) Within three months of the filing date of a national application other than a continued prosecution application under §1.53(d);
- (ii) Within three months of the date of entry of the national stage as set forth in §1.491 in an international application;
- (iii) Before the mailing of a first Office action on the merits; or
- (iv) Before the mailing of a first Office action after the filing of an RCE under §1.114.

An IDS will be considered by the Office if filed after one of the above periods, provided that the IDS is filed before the mailing date of any of a final action under §1.113, a notice of allowance under §1.311, or an action that otherwise closes prosecution in the application, provided the IDS is accompanied by a 1.97(e) statement; or the fee set forth in §1.17(p). An IDS filed after this time period will be considered by the office, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by a 1.97(e) statement and the fee set forth in §1.17(p).

A statement under 1.97(e) states either: (1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or (2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign

patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in §1.56(c) more than three months prior to the filing of the information disclosure statement.

(2) What must an IDS contain?

A properly submitted IDS will contain:

A list of all patents, publication, applications, or other information submitted for consideration by the Office. Each page must include the application number of the application in which the IDS is being submitted; a column that provides a space, next to each document considered, for the examiner's initials; and a heading that clearly indicates that the list is an IDS.

A legible copy of: each foreign patent; each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office; for each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and all other information or that portion which caused it to be listed.

A concise explanation of the relevance, as it is presently understood by the individual designated most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein. A copy of the translation if a written English-language translation of a non-English- language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in §1.56(c).

III. POTENTIAL BARRIERS AND POSSIBLE SOLUTIONS

1. EPO

(1) Common citation form

A first step towards the alignment of the practices of the IP5 Offices could be achieved, if each of the IP5 Offices could gather and exchange prior art citations available for their respective published applications.

As to the legal requirements applicable to the exchange of citation data please see points 11 and 12 above.

(2) IT based solution

The EPO would, in principle, welcome the development of an IT based solution supporting the exchange of and mutual access to the lists of prior art citations filed with the IP5 Offices.

An exchange of such information after publication of the European patent application would not require any changes to the framework currently applicable under the EPC.

The reciprocal exchange of citations pertaining to unpublished applications would only be possible by virtue of working agreements to be concluded between the European Patent Office and the Patent Offices of non-EPO Member States on the basis of Article 130 (2) EPC.

2. JPO

(1) Common citation form

The JPO requires information on prior art documents should be described in the description. If IP5 offices decide to make a common submission form as a separate form from the description, it is necessary to revise the Patent Act in Japan. Furthermore, it will

be required to develop JPO's IT system for adopting common submission forms. The JPO seems to be sceptics about its adoption from a cost-effective perspective as far as the procedures for the JPO are concerned.

(2) IT based solution

The Japan Patent Acts stipulates that "The source of the information concerning the invention known to the public through publication such as the name of the publication and others must be described in the description when the applicant has knowledge of any invention(s) related to the said invention, that has been known to the public through publication at the time of filing of the patent application (Patent Act Article 36(4)(ii)). It does not impose on applicants any obligations for examiners in other offices to submit cited documents. There are, therefore, no needs of IT based solution pertaining to the citation of prior art as far as the procedures for the JPO are concerned.

On the other hand, when it comes to countries or organizations setting some rules to submit documents cited by other offices, waiver for the citation of prior art should be substantialized on condition that the citation can be shared on IT tools such as the OPD, CCD, and so on.

3. KIPO

(1) Common citation form

KIPO requires statement of background art in the description and doesn't have any separation form regarding citation of prior art. If IP5 offices decide to make a common as a separate form from the description, it is necessary to revise the Patent Act. Generally, it takes over one year.

(2) IT based solution

KIPO does not require to necessarily submit prior art cited by other offices. Therefore, it has little impact for applicants to be exempted from obligation to submit cited document by other offices which is available on OPD, CCD, etc.

4. SIPO

(1) Common citation form

SIPO requires statement of background art in written description and it is not mandatory to cite the prior art documents in the background art. So if it is decided to use a common submission form for the citation of prior art, the law and the rules should be revised. Usually it will take a few years.

Under the above rules and practices within SIPO, firstly we think it is necessary for the applicants to meet the requirement of the sufficiency of disclosure by incorporating the background art into the written description. Secondly, the background art could help the examiner better understand the invention, so it could improve the quality and efficiency of the examination. And lastly the burden of the applicants to meet this requirement is modest. Thus, the current requirements within SIPO regarding the citation of prior art is a balanced approach for the applicants to achieve, it seems there is no need to require the applicants to adopt a common form for the citation of prior art.

(2) IT based solution

It is not mandatory for the applicants to submit cited documents of foreign offices in SIPO, so if the applicants are required to submit the prior art previously cited by another office, the law, rules and procedures should be revised.

SIPO suggests that IP5 offices should consider more carefully the potential problems that may arise for the IT based solution to the submission of prior art previously cited by another office.

5. USPTO

Please note: We consider the following preliminary answers and reserve the right to alter our response once specific proposals are established.

(1) Common citation form

As described above, the USPTO requires applicants to submit information material to patentability to the Office through the use of an IDS. Provided that the same information is contained on the common form, slight modifications would need to be made to the CFR and MPEP to capture the change of terminology. Outreach to stakeholders would also be necessary to alert them to the slight change of practice.

However, if the common form requires information other than or instead of what is currently required on the IDS, more substantial changes to the CFR and MPEP would be required. In addition, such changes may require negotiations with the labor union, examiner training, and stakeholder outreach.

(2) IT based solution

The Code of Federal Regulations (CFR) places the burden of the duty of disclosure on the applicant. Accordingly, if an IT based solution modifies the requirements currently stated in the CFR and Manual of Patent Examining Procedure (MPEP), rule changes and revisions, respectively, would be required

IV. SUMMARY

1. Requirements regarding citation of prior art

The EPO, JPO, KIPO and SIPO require patent applicants to incorporate background art into application. Failure to meet the requirement is a reason for refusal in the JPO and KIPO, while it can under certain circumstances lead to both refusal and invalidation/revocation in the EPO and SIPO. Applicants can overcome the reason for refusal through appropriate amendment of the references to the prior art.

In SIPO , if an application has been filed for an invention patent in a foreign country, the examiner may require the applicant to submit, within a specified time limit, materials concerning any search made for the purpose of examining the application in that country, or materials concerning the results of any examination made in the country. In the event of the applicant's failure to comply at the expiration of the specified time limit without legitimate reasons, the application shall be deemed to be withdrawn.

The USPTO imposes a duty upon patent applicants to disclose all known prior art references that would be material to the patent examiner in determining patentability. Applicants fulfil this duty by disclosing the references in an Information Disclosure Statement (IDS), a separate document.

2. Potential barriers and solutions for the common citation form

The JPO, KIPO and SIPO need to revise the Patent Acts to adopt a common form if it is separated from application form.

In the USPTO, so long as the information required in the form was similar to that of the current IDS form, slight modifications to the CFR (Code of Federal Regulations) and MPEP (Manual of Patent Examining Procedure) would be necessary.

3. Potential barriers and solutions for IT based solution

The JPO, KIPO and SIPO do not impose a duty upon applicants to submit prior art cited by other offices during the course of their examination, and as such, do not recognize the need for an IT based solution to the submission of this type of prior art.

The EPO would, in principle, welcome the development of an IT based solution supporting the exchange of and mutual access to the lists of prior art citations filed with the IP5 Offices. While the exchange of information after publication of the European application would not require any changes to the framework currently applicable, the reciprocal exchange of citations pertaining to unpublished applications would only be possible by virtue of working agreements to be conducted between the EPO and the Patent Offices of non-EPO Member States according to the conditions laid down in the EPC.

Since the USPTO currently requires prior art cited by another Office to be submitted to the USPTO via an IDS form, any alteration to this practice would require revision to the CFR and MPEP.

Annex

Supplementary information regarding the application of Rule 141 EPC

1. The present annex addresses points raised by KIPO relevant to the Rule 141 EPC and in particular the applicants' obligation to furnish work results delivered on the priority application on filing of the subsequent EP application. From the EPO perspective the application of Rule 141 EPC is not relevant to the scope of the report regarding citation of prior art.
2. The Rule 141 EPC emerged from the so-called Strategy debate that explored avenues how to enhance synergies within the European patent system. The main outcome of the Strategy debate was the establishment of the European Patent Network which included Utilisation as one of its main elements. The utilisation concept was tested with the Utilisation Pilot Project (UPP), the objective of which was to assess whether the work carried out during the priority year on a first filing at a National Patent Office (OFF) of an EPC Contracting State can be further utilised by the applicant and the EPO in a subsequent filing. Following the positive pilot results the EPO Administrative Council decided to implement a permanent utilisation scheme that would allow the EPO to make systematic use of Art 124 EPC and amended R 141/70b EPC¹.
3. Rule 141(1) provides that an applicant claiming priority 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.

¹ Please see Notice from the European Patent Office dated 28 July 2010 concerning amended Rule 141 EPC and new Rule 70b EPC – utilisation scheme, [OJ EPO 2010, 410](#).

4. If, at the time the application enters the examination stage, a copy of the search results has not been filed by the applicant and is not deemed to be duly filed under R 141(2) the EPO invites the applicant to file, within a non-extendable period of two months, the copy of the relevant search results or a statement of non-availability of these search results. Where the applicant fails to reply in due time, i.e. either provide the search results or furnish the statement of non-availability, the European patent application will be deemed to be withdrawn (Rule 70 b(2) EPC).

5. Rule 141(2) allows the President of the EPO to determine cases in which the OFF search results are considered available to the EPO and are automatically included in the file of the EP application. In these cases applicants are exempted from the obligation to file a copy of the search results². This exemption applies currently to applicants that are claiming the priority of either an application for which the EPO drew up a certain type of search report, or a first filing made in Austria, Denmark, Japan, the Republic of Korea, the United Kingdom, or the United States of America.

² Please see Notice from the European Patent Office dated 10 December 2014 concerning exemption under Rule 141(2) EPC from filing a copy of the search results – utilisation scheme, [OJ EPO 2015, A3](#).