

**CA/PL 14/00**

Orig.: English

Munich, 20.03.2000

SUBJECT: Revision of the EPC: Articles 92, 93 and 98 EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

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#### SUMMARY

This document contains proposals for streamlining and clarifying the above EPC provisions.

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## **I. INTRODUCTION - AMENDMENT OF ARTICLES 92, 93 AND 98 EPC**

1. Article 92(1) EPC is to be redrafted without any change in substance. The purpose of the article is to indicate that the EPO is to draw up search reports on pending European patent applications for which the search fee has been paid. The present wording, however, is too restrictive and does not cover cases in which an application is no longer pending for reasons other than being deemed withdrawn under Article 90(3) EPC. Referring simply to "the European patent application" implies that a search is only performed on an application which has a filing date (otherwise it is not a European patent application, see Article 90(2) EPC) and is pending when the search is performed. Further details can be specified in the Implementing Regulations.
2. It is proposed that Article 92(2) EPC be deleted in its entirety. It is self-evident that the Office is obliged to send the search report to the applicant. If a legal provision is considered necessary, this would typically be a matter for the Implementing Regulations (cf. Rule 58(1) EPC, for example). The obligation to transmit copies of documents cited in the search report should also be dealt with at that legislative level.
3. The internationally accepted standard of publication after eighteen months, with the possible exceptions thereto, is retained in Article 93(1) EPC. The text has been redrafted to shorten it and clarify its meaning.
4. Article 93(2) EPC is to be deleted, its substance being moved to the Implementing Regulations.
5. Article 98 EPC is to be redrafted without any change in substance. The wording is to be brought into line with Article 93 EPC, indication of the contents of the specification being moved to the Implementing Regulations.

## II. PROPOSED AMENDMENTS TO ARTICLES 92, 93 AND 98 EPC

### Present wording

#### Article 92

The drawing up of the European search report

(1) If a European patent application has been accorded a date of filing and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Search Division shall draw up the European search report on the basis of the claims, with due regard to the description and any drawings, in the form prescribed in the Implementing Regulations.

(2) Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.

#### Article 93

Publication of a European patent application

(1) A European patent application shall be published as soon as possible after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, as from the date of priority. Nevertheless, at the request of the applicant the application may be published before the expiry of the period referred to above.

### Proposed wording

#### Article 92

The drawing up of the European search report

**[...] The European Patent Office shall, in accordance with the Implementing Regulations, draw up a European search report in respect of the European patent application [...].**

(2) **Delete** - Move substance to the *Implementing Regulations*

#### Article 93

Publication of **the** European patent application

**The European Patent Office shall publish the** European patent application as soon as possible

**(a)** after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, from the date of priority **or**

**(b)** at the request of the applicant [...] before the expiry of **that period**.

It shall be published simultaneously with the publication of the specification of the European patent when the grant of the patent has become effective before the expiry of the period referred to above.

(2) The publication shall contain the description, the claims and any drawings as filed and, in an annex, the European search report and the abstract, in so far as the latter are available before the termination of the technical preparations for publication. If the European search report and the abstract have not been published at the same time as the application, they shall be published separately.

#### **Article 98**

Publication of a specification of the European patent

At the same time as it publishes the mention of the grant of the European patent, the European Patent Office shall publish a specification of the European patent containing the description, the claims and any drawings.

**The European patent application** shall be published **at the same time as** the specification of the European patent when the **decision to grant** the patent **becomes** effective before the expiry of **that period**.

(2) **Delete** - *Move substance to the Implementing Regulations*

#### **Article 98**

Publication of **the** specification of the European patent

[...] The European Patent Office shall publish **the** specification of the European patent **when** the mention of the grant of the European patent **is published in the European Patent Bulletin**.