

## **PRIOR ART EFFECT OF EUROPEAN PATENT APPLICATIONS**

### **Introduction**

1. This Guidance Note explains how changes to UK patent law, made by the Patents Act 2004 and implementing provisions of the revised European Patent Convention (“EPC 2000”), will affect the prior art effect of European Patent Applications.

### **What is the background?**

2. EPC 2000 comes into force on 13 December 2007. The Patents Act 2004 includes provisions to implement changes necessary to ensure that UK patent law is consistent with EPC 2000. However, these provisions are not yet in force and it is proposed that they will come into force on 13 December 2007 to coincide with EPC 2000.

3. Currently the European Patent Convention requires applicants to designate the Contracting States in which protection is sought on filing. However, if a particular Contracting State is not designated when the application is published, the disclosure in that application has a more limited prior art effect on future applications in that state.

### **What legislation is changing?**

4. Under EPC 2000 all Contracting States will automatically be designated on filing and the removal of a designation before publication will not affect the prior art status of a European patent application. UK patent law is changed to ensure consistency of approach to the treatment of European patent applications representing prior art for the purposes of assessing novelty of an invention.

### **What is the purpose of the new legislation?**

5. UK patent law is changed to make it clear that where a country is deemed to be designated under EPC 2000, that country is treated as designated for the purposes of the Patents Act 1977. Section 78 is amended to set out that the removal of a designation prior to publication does not prevent matter contained in an application for a European patent (UK) becoming part of the state of the art by virtue of section 2(3) of the Patents Act 1977. (Section 2(3) says that matter contained in an application for another patent which was published later than the priority date of the application in suit, but which has an earlier priority date, shows the application in suit to lack novelty).

6. The new legislation therefore ensures that every European patent application is treated under the Patents Act 1977 as an application for a European Patent (UK) since every Contracting State is automatically designated on filing and that the application continues to represent prior art under section 2(3) even if the UK designation is removed prior to publication.

### **Who will be affected by the changes?**

7. Anyone applying for a European patent will be affected by the change in the prior art effect of European patents.

8. For anyone applying for a UK patent every published European patent application will represent a potentially-relevant prior art document under section 2(3) of the Patents Act 1977.

### **When will the changes be effective?**

9. The changes will apply to new European patent applications filed on or after 13 December 2007. Granted European patents and pending European patent applications filed prior to 13 December 2007 will be subject to the earlier regime – i.e. removal of the UK designation from a European patent application prior to publication of that application will continue to prevent the matter contained in that application from becoming part of the state of the art under section 2(3) of the Patents Act 1977.

### **A brief summary**

- Every European patent application will automatically designate every Contracting State on filing of the European patent application.
- Removal of the UK designation prior to publication will no longer affect the section 2(3) prior art status of the European patent application in the UK.
- Every European patent application will therefore represent a potential section 2(3) citation when assessing novelty of a later invention.
- The changes only apply to new European patent applications filed after 13 December 2007.

### **Where can I get more information?**

10. Explanatory Notes to the Patents Act 2004 remain available from the OPSI website:

<http://www.opsi.gov.uk/acts/acts2004/20040016.htm> (The Patents Act 2004)

<http://www.opsi.gov.uk/acts/en2004/2004en16.htm> (Explanatory Notes)

11. Furthermore, the UK Intellectual Property Office's comprehensive guide to patent law and practice, the *Manual of Patent Practice*, will be updated to reflect these changes. The *Manual* is available to download from the UK Intellectual Property Office website at:

<http://www.ipo.gov.uk/patent/p-decisionmaking/p-law/p-law-manual/p-law-manual-practice.htm>

### **Status of this Guidance Note**

12. This Guidance Note has been prepared by the Intellectual Property Office. It gives the Office's view of the changes made by the Patents Act 2004 and as such it has no legal force.

UK Intellectual Property Office

Edition 2  
November 2007