

The mere exclusion of protection by an added feature in G1/93 is a different legal situation from ‘identity of invention’ for a priority claim in G2/98 (G1/03 r.2.1.2). Since the added feature does not change the identity of the invention within the meaning of Art.87(1), it does not affect the right to priority from a first application without this feature (T175/03). However, see the note to Art.123(2) at the end of the section on undisclosed disclaimers.

National courts may take a view on adding an undisclosed feature different from G1/93 and revoke a patent with an added feature on the ground of Art.138(1)(c). German courts interpret Art.123 differently from the EPO and do not consider the deletion of an undisclosed feature from a granted claim as an extension of protection (OJ 1998, 617).

Art. 124 Information on prior art

1 General

The provision allows the EPO to request the applicant to provide information on prior art relevant for a patent application. The EPO increasingly uses this provision (situation 2010) to improve the quality of the examination and to make the grant procedure faster and more efficient.

The EPO may invite the applicant to provide information about prior art cited during proceedings of parallel patent applications and patents and punish failure with deemed withdrawal. The EPC does not oblige an applicant to disclose all relevant prior art known to it, in contrast with for example US patent law which may penalize non-disclosure of relevant prior art with unpatentability.

A limited use of Art.124 would have been expected in view of the fact that the EPO does already have relevant material for the examination from the European search, the work sharing between patent offices, and the worldwide public data retrieval systems which have made it easy to obtain information about national and regional patent applications. Moreover, the EPO can request information on prior art from other patent offices under Art.130(1).

Art. 124(1) The European Patent Office may, in accordance with the Implementing Regulations, invite the applicant to provide information on prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates.

See for the implementation:

R.70b Invitation to file search results

R.141 Procedure for requesting information on prior art

1 Information on corresponding applications

Each applicant claiming priority must provide the results of any search carried out by the office of first filing on the priority application (R.141(1)). If not provided voluntarily on filing or regional entry, the EPO will request them under R.70b.

The EPO may also invite an applicant to provide information on prior art taken into account in corresponding national and regional patent proceedings (R.141(3)). He must also provide the information for corresponding utility models and utility certificates filed in EPC contracting states, i.e. not for those filed in non-contracting states (Art.140 referring to Art.124).