



Patent Disclosure Requirements Consequences of noncompliance European perspective

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Agenda

Patent disclosure requirements and consequences of noncompliance

- 1. Inside the application, upon filing**
- 2. During prosecution**
- 3. Post grant / litigation**



Inside the application, upon filing

The specification should indicate the background art which, as far as is known to the applicant, can be regarded as useful to understand the invention

(EPO: Rule 42(1)(b) EPC; French INPI: Art. R612-12 CPI).

Useful even for the applicant: problem solution approach.

Not binding on patent office (of course).

“Sanction”: EPO typically requires applicant to amend specification to cite further relevant prior art it identified. INPI does not (unless, maybe, none was mentioned – theoretical).



During prosecution (N/A to granted patents, even during opposition)

If a priority is claimed, the EPO expects prior art considered for priority application to be filed together with the EP application (unless automatically shared by priority office). But failure to do so is detected only after examination begins and merely leads to EPO inviting applicant to file such prior art within 2 months.

EPO may (=theory) also request prior art for “related” applications. (Art. 124 and Rules 141 & 70b EPC).

The INPI may, before search, request prior art considered by foreign office for priority application (Art. R612-56-1 CPI).

Failure to comply: application “deemed withdrawn” (EPO) / “rejected” (INPI). But: easy to comply.



Post grant / litigation

Only grounds for revocation: Art. 100&138 EPC and Art. 613-23-1 & 613-25 (in France). Lack of disclosure (even in bad faith): absent.

In general, no duty to disclose prior art. But Art. 42 and 48 UPCA:

- * UPC meant to be fair, equitable and not distort competition,**
- * Representatives must not misrepresent cases or facts knowingly or with good reasons to know.**

Must disclose any prior or pending proceedings relating to the patent (before “any court or authority”) (Rule 13(1)(h) RoP).

Sanctions: costs/damages (Art. 104 EPC, 69 UPCA, 700 FR CPC).



**Bonus slide (if time allows)
Post grant / litigation
(to obtain provisional measures)**

Art. 62 UPCA: UPC may require applicant to provide any reasonable evidence in order to satisfy itself with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent.

Art. 60 UPCA: To be authorized to preserve evidence, must present evidence to support the claim that the patent has been infringed or is about to be infringed.

In practice, may involve arguing why the patent is valid, beyond having been granted (!). Better disclose any art you know that could be relevant, or you can lose the evidence & pay damages. Similar in France.