

Prior national rights

Pursuant to Art. 93 of the [1973 Convention on the Grant of European Patents](#) (hereinafter: EPC), **the European patent application is published after the expiry of a period of 18 months from the date of filing or, if priority has been claimed, from the date of priority** (or at the request of the applicant, before the expiry of that period). However, it may occur that during this 18-month period another previously filed national application (or even a granted patent itself) is published. In other words, when dealing with the issue of earlier national rights, we are thinking about the situation in which there is a national application (or patent) in one of the EPC contracting states, and this application (or patent) was published on or after the filing/priority date of the European patent application. In this issue of the Legal Report, we intend to address some important issues arising in the context of earlier national rights.

How do earlier national rights affect the assessment of the prior art carried out by the Examining Division of the European Patent Office (hereinafter: the EPO)? Can they be opposed to a European application? How have the law and practice in this area changed since the Unified Patent Court (hereinafter: the UPC) launched its operations in June 2023? Finally: how can "latecomers" who would like to apply for protection in Europe benefit from the existing legal regulation, after the 12-month period within which they could exercise the right of priority has passed?

The regulation in the European Patent Convention: National applications outside of the prior art

Under Art. 54 para. 3 EPC, the state of the art comprises the content of European patent applications as filed, the dates of filing of which are prior to the date of the filing of the European patent application, and which were published on or after that date. *A contrario*, **the state of the art will not comprehend national applications.**

It should be emphasised, however, that this does not mean that earlier national rights are completely irrelevant under the EPC. **They are addressed in Art. 139 EPC that governs prior rights.** In accordance with para. 1, in any designated Contracting State a European patent application and a European patent shall have with regard to a national patent application and a national patent the same prior right effect as a national patent application and a national patent. By analogy, **a national patent application and a national patent in a Contracting State shall have with regard to a European patent designating that Contracting State the same prior right effect as if the European patent were a national patent** (para. 2).

This means that **the previously existing right in state X thus only posed a threat to the validation of the European patent in state X.** If we had an earlier application in Poland and then wanted to validate the European patent in Poland, the earlier right could be opposed to the validated European patent in invalidity proceedings.

The measures available to an applicant where an earlier national right exists

The EPO [Guidelines for Examination G-IV, 6](#) lay down certain measures available to a person filing an application for a European patent if an earlier national right exists.

First, such a person may **withdraw from the application the designation of the Contracting State in which the earlier right exists.** Under Art. 79 EPC, all the Contracting States party to the Convention at the time of filing of the European patent application shall be deemed to be designated in the request for grant of a European patent (para. 1), however, the applicant may withdraw the designation of a given Contracting State at any time up to the grant of the European patent (para. 3). **Such withdrawal of the designation is not free from certain risks.** Namely, if we filed an earlier application in Poland and then withdraw the designation, **we must reckon with the possibility that in the meantime the state of the art has changed.**

Secondly, the applicant may file a claim for the country in which he exercises the earlier right different from those for the other designated countries. Where the EPO has been informed of the existence of earlier national right, the European patent application or European pa-

tent may contain, for that state or states, claims and, where appropriate, a description and drawings which are different from those for the other designated states. (Rule 138 of the EPO [Implementing Regulations](#)).

Thirdly, **the applicant may limit the SET OF claims in such a way that the earlier national right ceases to be relevant to the European application.**

In addition, it is worth mentioning that in the case of opposition proceedings, the applicant may amend the description of the invention, claims and drawings — provided that these amendments were occasioned by one of the grounds for opposition, i.e. lack of patentability, lack of sufficient disclosure of the invention, as well as subject matter going beyond the content of the application (Rule 80 in connection of Art. 100 EPC). Amendment may be made even if such grounds have not been invoked by the party filing an opposition. It should be emphasized that the mere existence of earlier national law is not an admissible basis for opposition. Also, it is possible to file a request to revoke or limit the European patent already granted by an amendment of the claims as laid down in Art. 105a. Such a request is filed by a patent-holder, but it is not possible if opposition proceedings in respect of the European patent are pending. Amendments to the claims in these procedures may lead to a situation in which earlier national rights will cease to be relevant.

As we can read in the EPO Guidelines, ([Guidelines for Examination H-III, 4.4](#)), such amendments represent exceptions to the uniformity of European substantive patent law and for that reason filing of different claims is neither required, nor suggested.

The scope of the search carried out by the EPO

It is worth noting that the use of the possibilities described above depended solely on the applicant's awareness of the existing risk. **The EPO did not, on its own initiative, examine whether there were earlier national applications.**

Until now, it was a common practice that, if additional European applications were not taken into account in the search report, the EPO examiners carried out an additional search for European applications falling within the scope of Article 54 para. 3. Such searches covered documents unavailable at the time of the initial search: they had to cover all European applications published within 18 months of filing. The top-up search also had to consider potentially relevant prior art cited by other patent offices in relation to applications concerning the same patent family.

What has changed with the launch of the UPC

The practice in this respect has changed significantly since the UPC started operating in the EU Member States participating in the enhanced cooperation procedure regarding the unitary

patent. We have covered issues related to the unitary patent, i.a., [here](#) and [here](#). Let us remind you that pursuant to Art. 3 para. 1 of [Regulation \(EU\) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection](#), **a European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States** provided that its unitary effect has been registered in the Register for unitary patent protection.

The solution consisting in the amendment of the set of patent claims in the state where the earlier right existed is no longer sufficient in the reality where the UPC operates. Why is this the case?

First, it will no longer be possible to apply the solution provided for in Rule 138, given that the unitary patent is granted in each of the contracting states with the same set of claims. It will therefore not be possible to amend the claims only with respect of a single state. The provision of Art. 3 para. 1 second sentence of Regulation No. 1257/2012 confirms that a European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect.

Next, it is necessary to invoke Art. 65 para. 2 of [the Agreement on a Unified Patent Court](#). The Court may revoke a patent, either entirely or partly, on the grounds referred to in Art. 139 para. 2 of the EPC. This means that the earlier national right in a given state is no longer opposable exclusively in the case where we seek to validate a patent in that state. It can result in invalidating the patent in all contracting states. **In other words, if we get a unitary patent for a specific invention and there was previously a national right in one of the states participating in the enhanced cooperation on UPC, the earlier right will be included in the scope of the state of the art.**

The new practice of the EPO

In the changed legal situation, knowledge of existing prior national rights therefore becomes even more important. Responding to the applicants' concerns, the EPO carries out systematic top-up searches of earlier national rights in all EPC contracting states and assesses their prima facie relevance for a given application. This is a service that is provided free of charge and does not require a request from the applicant.

Non-binding information on earlier national applications will henceforth form part of the communication issued in accordance with the EPC Implementing Regulations. Rule 71 para. 3 obliges the Examining Division to inform the applicant, before deciding to grant the European patent, of the text in which it intends to grant it and of the related bibliographic data. However, the EPO does not draw any conclusions from the prima facie relevant national rights identified – **it is the applicant's responsibility to familiarise themselves with these rights and assess their significan-**

ce from the point of view of the filed application. It should be remembered that the EPC does not impose on the EPO an obligation to provide this service; it is merely an additional precautionary measure.

If the applicant considers that the earlier national rights do not threaten the novelty of the invention, he or she may proceed with his application. Otherwise, it will be necessary to amend the claims. In this case, the applicant has a choice: he or she can amend the claims only in relation to the country where the earlier right exists and then validate in other countries where he or she seeks protection (and therefore resign from the unitary patent, opting for the more traditional validation path). However, if he or she is interested in obtaining a unitary patent, the amendment of the claims must cover all countries participating in the UPC system. It is worth noting that under Rule 71 para. 6, within the period of 4 months (the period for, i.a., paying the fees for granting a patent and for publication), the applicant can submit a request to make reasoned amendments or corrections to the communicated text or choose to keep to the text he or she previously submitted. If the Examining Division consents, a new communication under Art. 71 para. 3 will be made; otherwise, the examination proceedings shall be resumed. The basis for amendment of the European patent application after the confirmation of the communicated text can be found in Rule 137 which states that further amendment may only be made with the consent of the Examining Division — a permissible reason for such an amendment may be the existence of an earlier national right.

How, however, should an applicant proceed if he or she wishes to obtain a unitary patent, and the earlier national right exists in Poland as a state that is not a party to the UPC Agreement? In this case, the claims should be changed only in relation to Poland, where an application for validation would be filed. However, national law in Poland will not affect the fate of the unitary patent that the applicant is seeking.

Art. 54 EPC regulation as a chance for persons who did not apply for international protection during the priority period

Hypothetically, it may happen that we have filed a national application and the 12-month period for exercising the right of priority and preparing an international application regulated by the [Patent Cooperation Treaty of 1970](#) (hereinafter: the PCT) has elapsed. Only after this period will we realize that we would like to seek protection for our invention also outside that one specific state in which we have filed the application. However, if we do not care about such a broad scope of protection as provided for by the PCT, but are interested primarily in protection in the territory of Europe, it may turn out that despite the expiry of the period, it is not too late after all.

This is where Article 54 EPC comes into play, which states that all earlier national applications that are not continued as European applications do not form part of the state of the art

and are therefore not taken into account in the assessment of novelty. **In other words, we can use the 18-month time window between filing of the European application and its publication, and if a national application (patent) is published during this time, this will not ruin our chances of obtaining European protection.** As mentioned earlier, the national application can only be opposed in the event of validation in that specific state where the earlier right exists.

Summary

The key points made in this Legal Report are as follows:

- The state of the art relevant for the assessment of patentability by the EPO does not include earlier national applications.
- An earlier national application may be opposed in the same state to a later European patent validated in it.
- In such a situation, the applicant could withdraw from the European application the designation of the state in which the earlier right existed or amend the patent claims in relation to that specific state.
- Until recently, the EPO has not examined whether earlier national rights existed.
- Modifying patent claims is no longer a solution in the case of states participating in the UPC system: a unitary patent is granted in relation to these states with the same set of claims, and an earlier right existing in one of them carries the risk of central invalidation of the patent.
- Since Poland remains outside the UPC system, earlier national law in Poland does not affect the unitary patent.
- Since 1 September 2022, the EPO has been conducting searches for earlier national rights, but it is up to the applicant to choose what to do with the knowledge obtained in this way.