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Office européen des brevets

PCT procedure before the EPO as receiving Office



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Head, Department of PCT Affairs
Madrid, 3 November 2016

PCT procedure before the EPO as receiving Office (RO)

- Conditions for choosing EPO as RO
- Applicability of PCT to EPC Contracting States
- PCT Direct service
- Address for Correspondence (AfC)
- Representation rules for non-European applicants
- New : means of filing and payment, use of smart cards at the EPO
- Case study: incorporation by reference at the EPO as RO

Conditions for the selection of RO/EP (1)

Nationality / Residence of the applicant:

The EPO is receiving office (RO) for international applications for all EPC Contracting States → receives applications from:

- nationals from EPC Contracting States, and
- residents in an EPC Contracting State (natural / legal persons)

ATTENTION: Nationality / residence of a person mentioned only as an inventor is irrelevant for the purposes of filing an international application, but his/her designation is required for the European phase.

Conditions for the selection of RO/EP (2)

Multiple applicants :

- at least one of the applicants has to comply with the nationality / residence criterion

- possibility to select an applicant for certain PCT Contracting States only .... but:

  ATTENTION: when a State is designated for a national **and** regional patent, the applicants have to be the same for both designations - Rule 4(5)(d) PCT

- if a **priority is claimed**, it is enough that the applicant of the earlier application is also (one) applicant in the subsequent PCT application

Conditions the selection of RO/EP (3)

The PCT does not extend to all territories of the EPC Contracting States (ex.: Jersey, Bermuda, Cayman Islands, ...):

- applicants residing on such territories must ensure that they are entitled to file an international application with the EPO as receiving office (criteria: nationality)

- all PCT applicants wanting to benefit from protection in these territories must first verify if this protection can be obtained thanks to a national patent (e.g. validation of UK patent)

See OJ EPO 2014, A.33

Applicability of PCT to territories covered by the EPC (1)

Territories of EPC Contracting States in which the PCT is applicable:

- **Denmark** :
  - Faroe Islands (FO),
  - Greenland (GL)

- **Finland :**
  - Åland Islands (AX)

- **France :**
  - French Polynesia (PF), French Southern Territories (TF), New Caledonia (NC), Saint Barthélemy (BL), Saint-Martin (French part) (MF), Saint-Pierre-et-Miquelon (PM), Wallis et Futuna (WF)

Applicability of PCT to territories covered by the EPC (2)

Territories of EPC Contracting States where the PCT is applicable:

- **Netherlands :**
  - Curaçao (CW), Saint-Martin (Dutch part) (SX), Aruba (AW**)**
- **Norway :**
  - Bouvet Island (BV),
  - Svalbard and Jan Mayen (SJ)
- **United Kingdom :**
  - The Isle of Man (IM)

Applicability of PCT to territories covered by the EPC (3)

Territories of EPC Contracting States where the PCT <u>is NOT</u> applicable

- **UNITED KINGDOM :**
  - British Virgin Islands (BVI), Guernesey (GG), Jersey (JE), Bermuda (BM), Cayman Islands (KY), Falkland Islands (FK), Îles Turks and Caicos Islands (TC), Anguilla (AI), Gibraltar (GI), Montserrat (MS), Pitcairn (PN), Saint Helena, Ascension and Tristan da Cunha (SH), South Georgia and the South Sandwich Islands (GS).

« PCT Direct » Service

- Relevant for applicants filing a PCT application and claiming priority from a 1st filing searched by EPO who are interested in a quick outcome

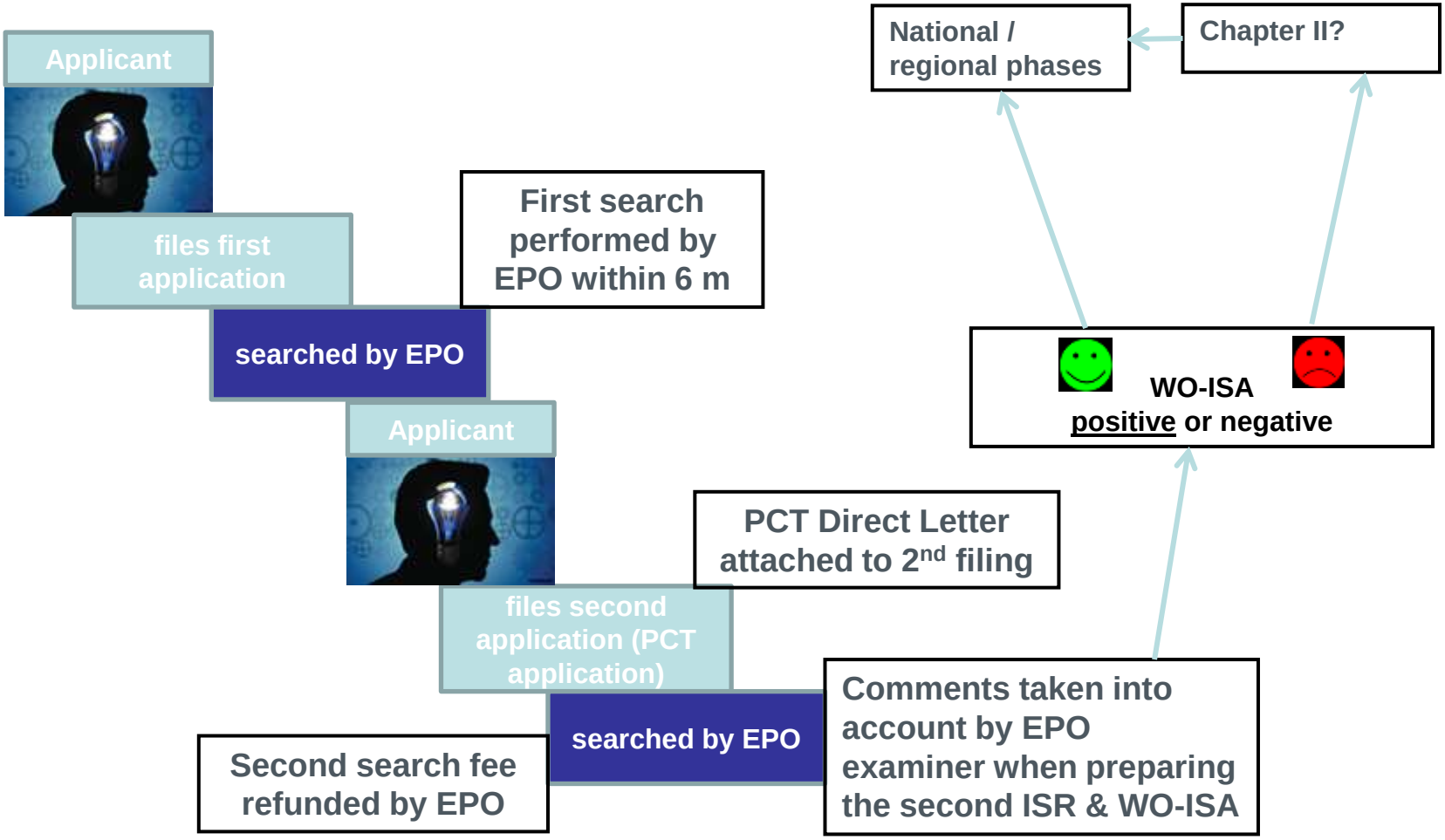
- **How?** File "PCT Direct letter" with PCT application containing informal comments on objections of earlier search opinion **+** possibility of showing "track changes" → **PCT Direct is free of charge**

- Examiner will establish ISR and WO-ISA taking into account informal comments on the earlier search opinion

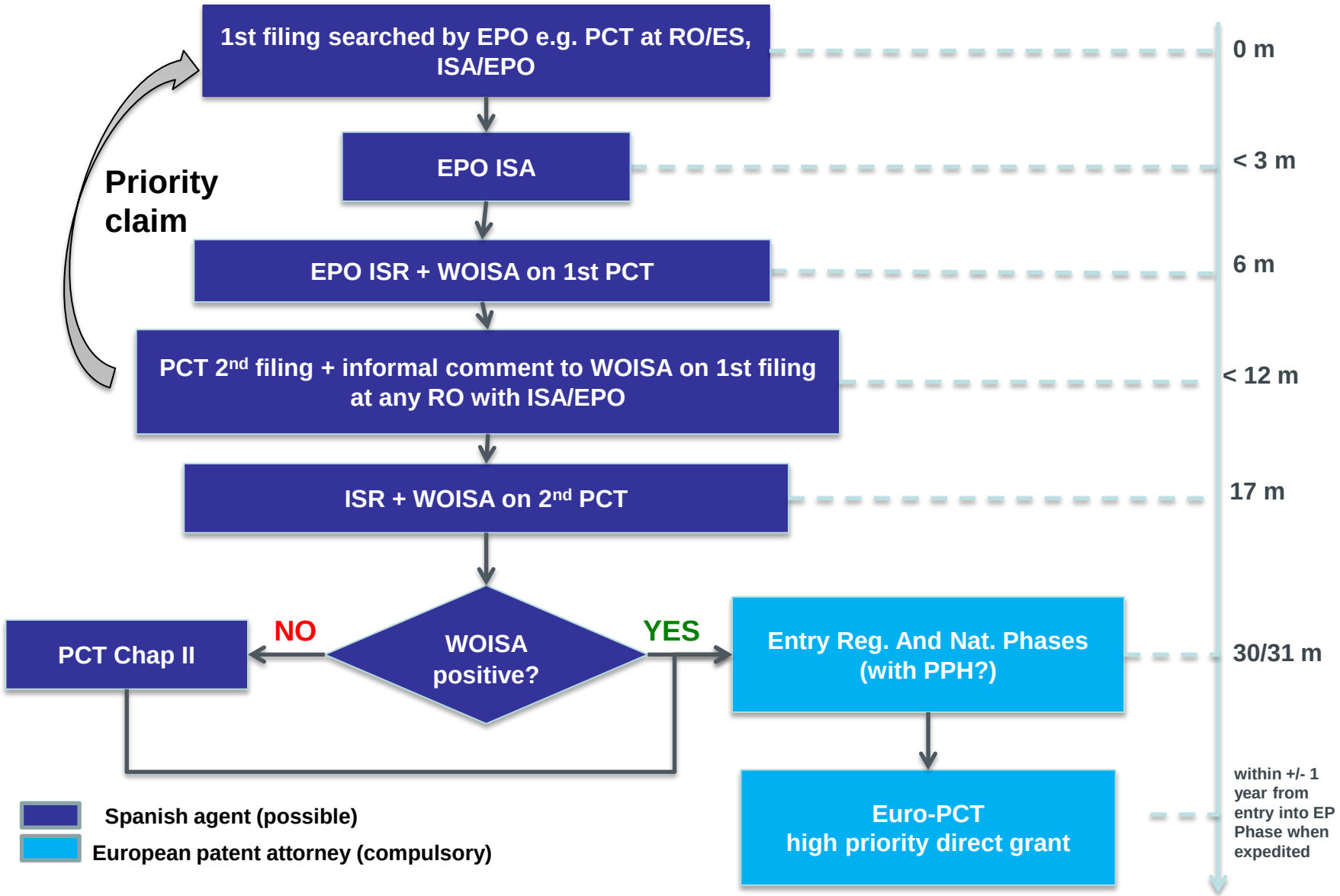
- Increase likelihood of receiving positive WOISA. + 200 letters / month

- Since Nov. 2014 at RO/EP; since July 2015 open to all ROs (see EPO OJ 2015, A51)

PCT Direct : concept



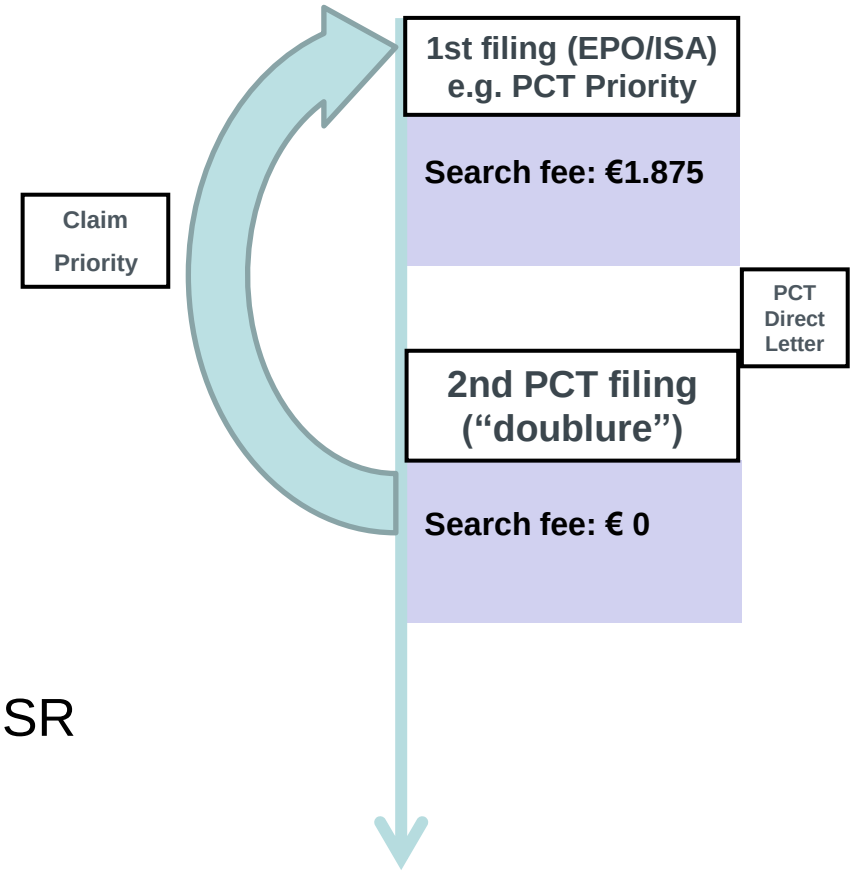
PCT Direct for Spanish applicants (time line)



“PCT Direct” search refunds if ISA=EPO

100 % refund where EPO
can make full use of earlier ISR
(“doublure”)

25 % refund where EPO
can make partial use of earlier ISR



PCT – direct

Why PCT-direct?

- Additional opportunity to discuss with the examiner the objections raised in the EESR of the first filing.

- Examiner “notices” amendments to the claims and description

Address for Correspondence (AfC) (1)

- **Previous EPO practice**
  - Only legal persons acting without a representative could indicate an address of correspondence which did not coincide with the address of their place of business.
  - Recipient indicated for the address for correspondence must be the applicant.

- **Revised practice (since November 2014)**
  - Differentiation between international and European phase of an application → **alignment** of EPO's practice on the practice of **the IB** for the international phase.

Address for Correspondence (AfC): new practice (2)

- In the **international phase**, if no representative has been appointed:
  - all applicants (either natural or legal persons),
  - can indicate as AfC an address situated in **any State in the World** (not only EPC Contracting States),
  - even if that address is the one of a person other than the applicant.

- In the **European phase**:
  - **any applicant,** whether a natural or legal person,
  - can indicate as AfC, an address located **on the territory of an EPC Contracting States**
  - **only** if the address is the applicant's address (for legal persons, the address may include a sub-division within a firm, provided this is not a different legal person).

Address for correspondence (AfC): European phase (3)

- An address for correspondence indicated in the Euro-PCT application for the **international phase** is not valid **for the European phase** if:
  - it is located outside the territories of EPC Contracting States;
  - belongs to another person.

- The applicant will have to indicate a new address for correspondence fulfilling the conditions under the European phase (Form 1200 or separate letter).

- See **OJ EPO 2014, A99**

Representation in case of a non-European applicant

In the case of multiple applicants only,

- if one or more of the applicants is / are not domiciled in an EPC Contracting State...

- but at least one of the applicants is domiciled in an EPC Contracting State,

the latter applicant is considered **as the deemed common representative under Rule 90(2) PCT**

For the (other) non-European applicant(s), there **no** requirement by RO/EP for representation by a European representative

New means of filing

RO-EP accepts paper filings, filings by fax, CMS, PCT-SAFE and ...

- **Since April 2014** : online filing of subsequently filed documents under PCT, possible at the EPO via **eOLF** (**PCT-SDF module**).
- **Since July 2014** : Filing of a Chapter 2 demand for a preliminary international examination via **eOLF** (**PCT-DEMAND module**).
- **Since November 2014** : Filing of international applications with RO/EP directly with **ePCT (WIPO)**.
- **NEW: Since 1st November 2016:** ePCT service extended to all subsequently filed documents for RO/EP, ISA/EP et IPEA/EP.
- Emergency solution (better than fax) : web-form filing on EPO website

Current Fee payment methods at the EPO

- **Bank transfers to EPO's bank account**

Fee payments to EPO bank accounts must be made in EUR and transferred without charge to the EPO

- **Use of a deposit account held with the EPO,** replenished via bank transfer:

➢ 2 possibilities of deposit account payment: debit order for individual fees, and automatic debit order.

➢ **Electronic means of payment** for EPO deposit accounts holders:
  - **Online Filing** (PCT/RO 101, PCT-SFD, PCT-Demand)
  - **Online Fee Payment** (batch payment, deposit account management)
  - **New Online Filing – CMS**, **PCT-SAFE**
  - **ePCT** (PCT/RO/101, SFD)

- **Objective for 2017** (to be confirmed): to stop paper order and accept payments by credit card.

Use of Smart Cards at the EPO

I- Accessing the Online Fee Payment web service

II- Filing and fee payment directly to the EPO systems

- Online Filing
- New Online Filing - CMS

III- Access documents at the EPO

I- Online Fee Payment web service

Access

via Internet browser; EPO deposit account needed

Authentication

with Smartcard

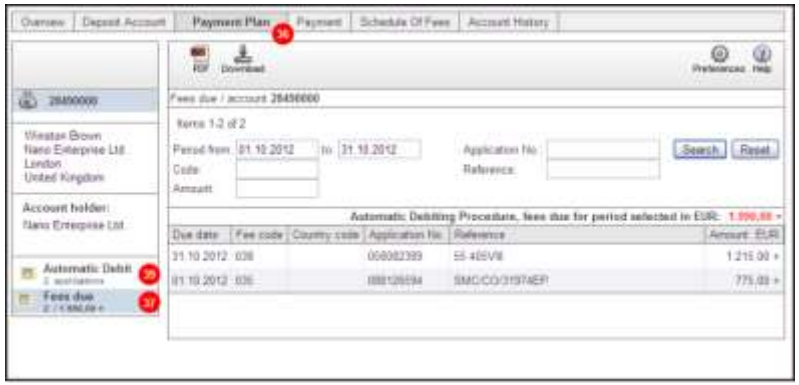
I- Online Fee Payment – features (I)

Pay any EP and PCT fee to the EPO online

Upload and perform batch payments

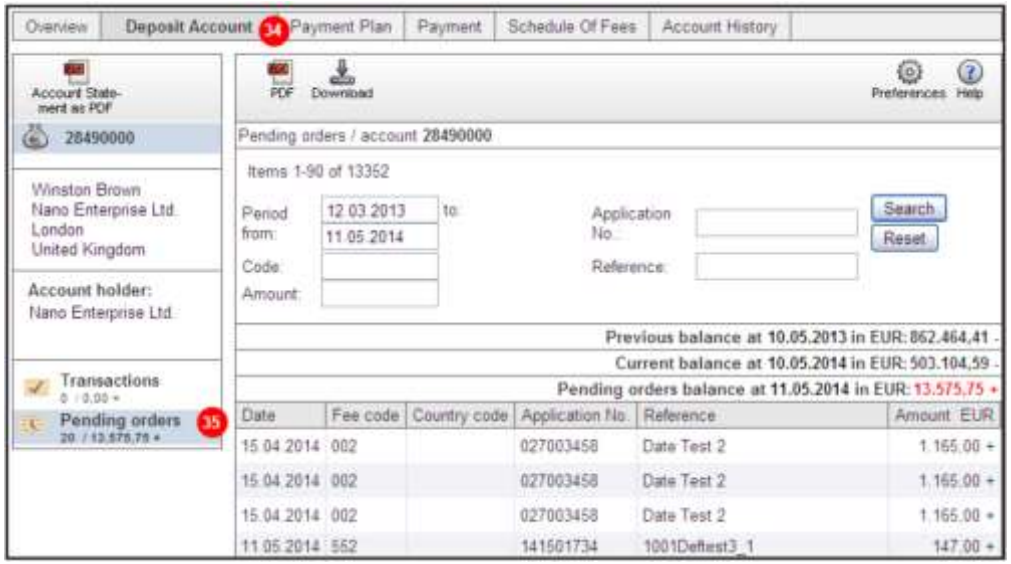
Manage (request and revoke) automatic debit orders

View payment plan for automatic debit orders



I- Online Fee Payment – features (II)

View pending orders from Online Fee Payment and all online filing tools (this includes Online Filing, New Online Filing - CMS and ePCT)



View all transactions within 90 days (older ones available in Account History)

View statements

I- Online Fee Payment

New features from 1 November 2016

- increased visibility of replenishments

(i.e. one day after receipt at EPO)

- optimized pending order balance within search function
- additional features:
  - statement for selected timeframe
  - batch payment: single pdf confirmation files for each application no.

Planned for the near future

- validation tool to identify and block payments for dead files

II- Online Filing

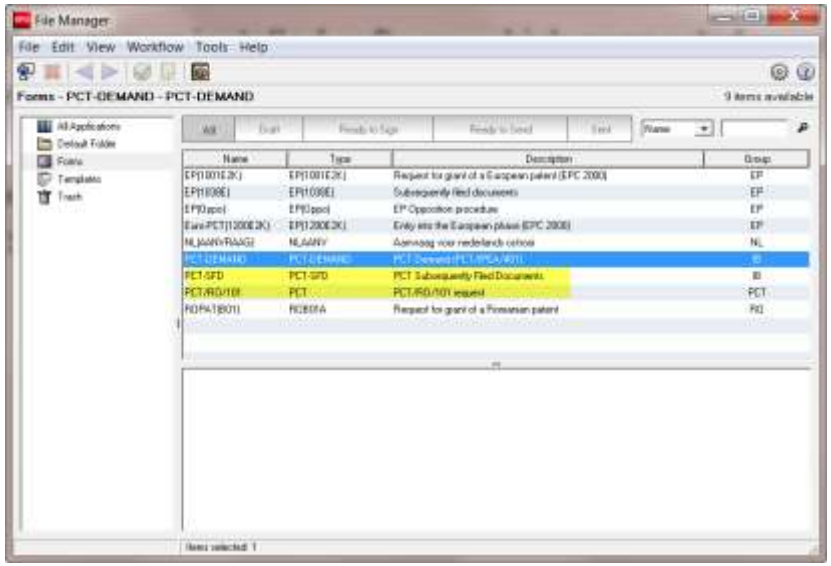
Access

locally or server installed software

for sending it securely connects to the EPO online filing server

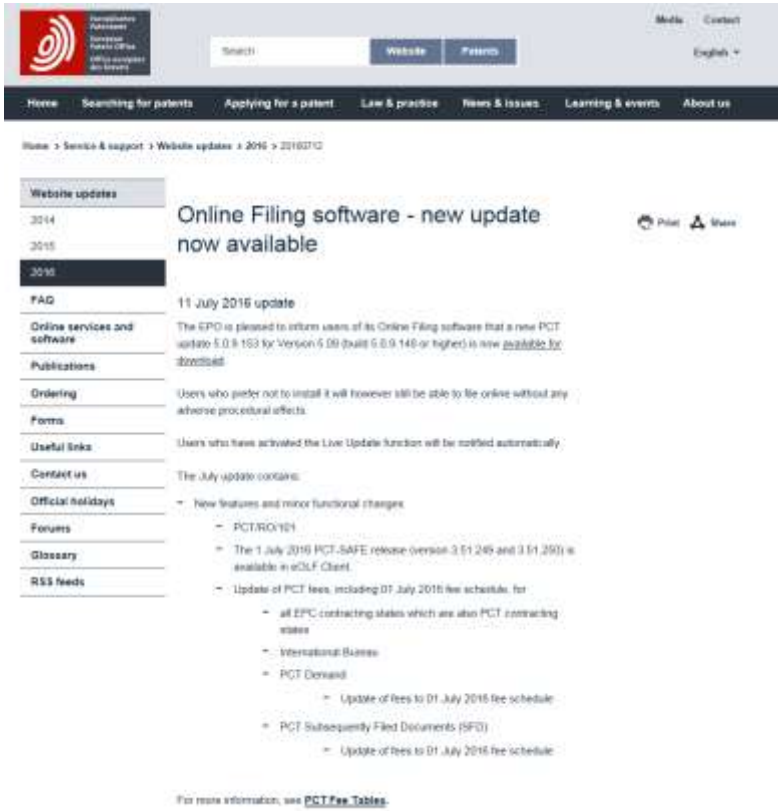
Authentication

with Smartcard



II- Online Filing – software updates

Software and fee updates are available for download and installation from EPO’s website



II- Online Filing – features (I)

Prepare and file documents including fee payment

EP related:

- EP applications (EP1001)
- Entry into European Phase (EP1200)
- Subsequently filed documents and/or fee payment (EP1038)

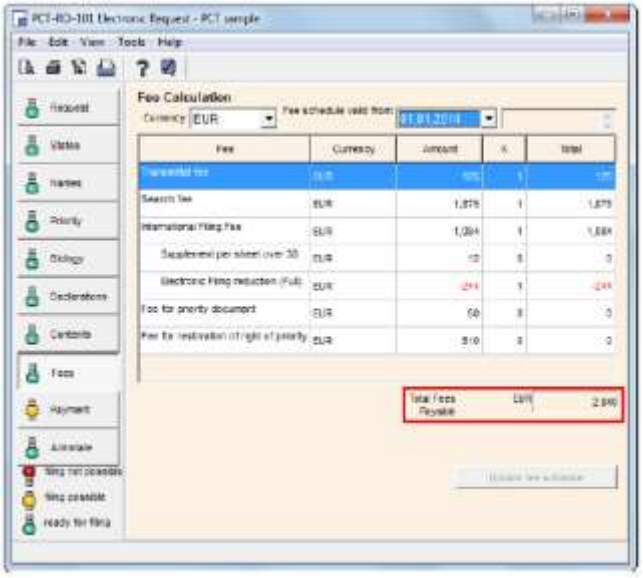
PCT related:

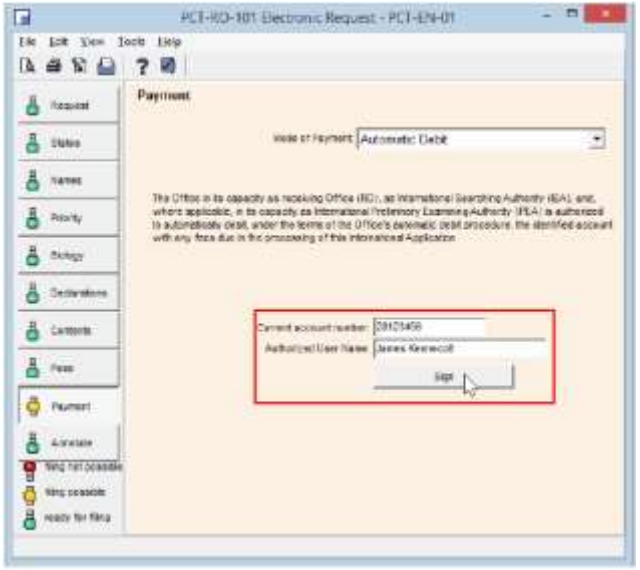
- PCT application (PCT/RO/101)
- Demand Chapter II PCT (PCT-DEMAND)
- Subsequently filed documents and related fee payments (PCT-SFD)
- New from 1 November 2016: all PCT fees may be paid via the PCT-SFD plug-in

II- Online Filing – features (II)

For new EP and new PCT applications an automated fee calculation is available

Request for automatic debiting may be indicated





II- New Online Filing – CMS

Access

via Internet browser; EPO CMS account needed

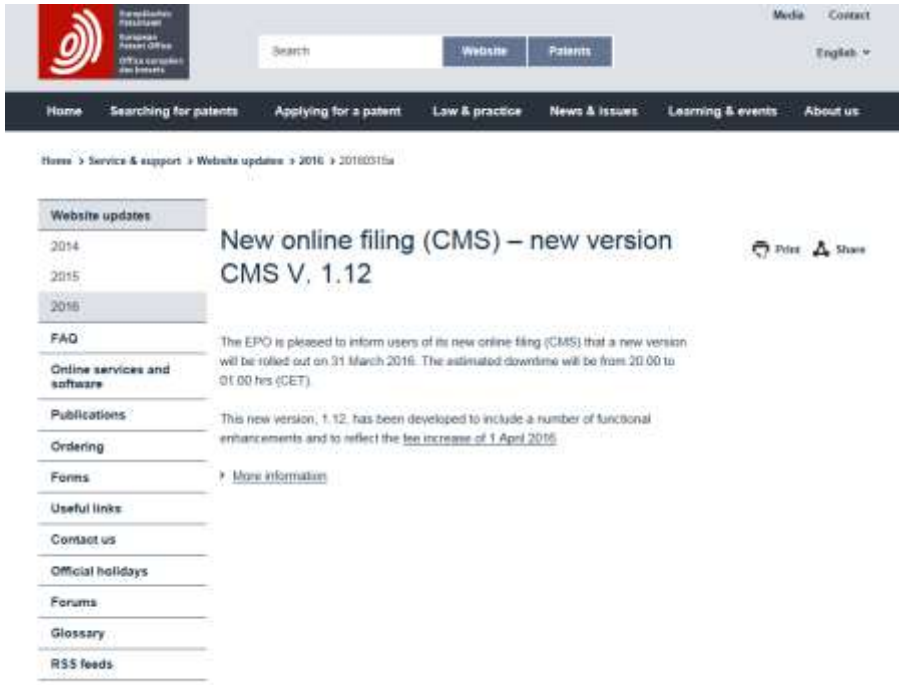
Authentication

with Smartcard

II- New Online Filing – CMS – features (I)

System and fees are updated on EPO side – no action from users needed

Update information available on EPO website



II- New Online Filing – CMS – features (II)

Prepare and file documents including fee payment

EP related:

- EP applications (EP1001)
- Entry into European Phase (EP1200)
- Subsequently filed documents and/or fee payment (EP1038)

PCT related:

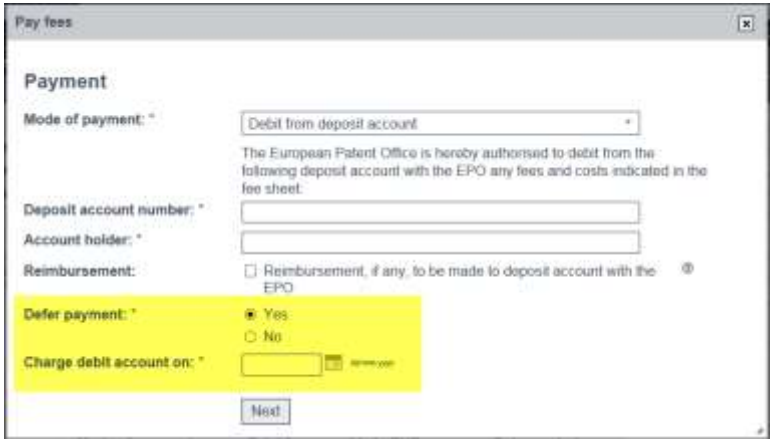
- PCT application (PCT/RO/101)
- Subsequently filed documents and related fee payments (PCT1038)

II- New Online Filing – CMS – features (III)

For new EP and new PCT applications an automated fee calculation is available

Request for automatic debiting may be indicated

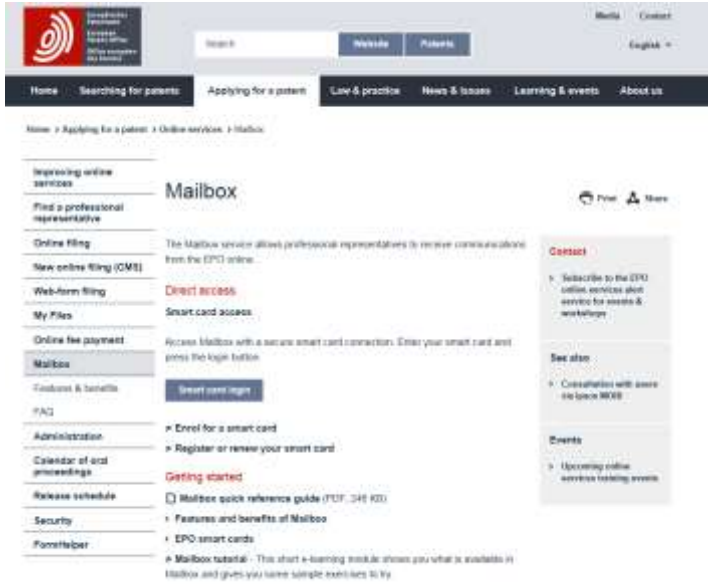
Deferred execution date may be indicated



III- Access documents

Potentially access filed EP documents using CMS or eOLF.

Potentially receive EP Mail electronically via Mailbox



Any more questions regarding the use of smart cards: please contact Richard Garvey at rgarvey@epo.org

Case Study : Incorporation by reference at RO-EP

- PLT and PCT framework
- Missing element *vs* missing part
- Requirements: formal and substantive
- Practical examples: general and specific to EPO acting as RO
- Advice to applicants
- Effect upon entry into the national or regional phase
- Conclusion

Background

- The Patent Law Treaty (PLT, signed 1 June 2000 in Geneva) introduces the concept of incorporation by reference of missing parts and elements in Article 5

- Harmonize the practices in proceedings before Offices acting under the PCT and applying national laws

- Enable the inclusion of accidentally omitted elements or parts that are contained in an earlier application of which priority is validly claimed, without affecting the international filing date

PCT framework

- Since 1 April 2007 in force under the PCT

- To date, 8 Offices acting as receiving Office (RO) have not yet withdrawn their notification of incompatibility with their national law (Rule 20.8(a) PCT): BE, CU, CZ, DE, ID, IT, KR, MX

- To date, 8 Offices acting as designated Office (DO) have not yet withdrawn their notification of incompatibility with their national law (Rule 20.8(b) PCT): CN, CU, CZ, DE, ID, KR, MX, TR

Missing element

Definition for the purposes of incorporation by reference: the whole description or the full set of claims

If the RO finds that an element is missing in the papers purporting to be an international application, it invites the applicant (PCT/RO/103):

- to furnish the required element → the international filing date (IFD) changes into the day the requirements for filing an international application are fulfilled (Article 11(2)(b) and Rule 20.3(b)(i) PCT)

  or

- to confirm that the element is incorporated by reference → if the conditions of incorporation by reference are met, the IFD is maintained (Rule 20.6(b) and 20.3(b)(ii) PCT)

Missing part

Definition: part of the description, part of the claims, part or **all** of the drawings

Where the RO finds a part is missing, it invites the applicant (PCT/RO/107):

- to complete the purported international application by furnishing the missing part → the IFD changes into the date of receipt of the missing part (Rule 20.5(c) PCT)

  or
- to confirm that the part was incorporated by reference → if the conditions for incorporation by reference are met, the IFD is maintained (Rule 20.6(b) and 20.5(d) PCT)

Formal requirements: time limit (Rule 20.7 PCT)

Where an invitation was issued by the RO (Rule 20.3(a) or Rule 20.5(a) PCT): **two months** from the date of the invitation

- the RO informs the applicant if in these two months the priority period expires

Where no invitation was sent to the applicant by the RO: **two months** from the filing date

Formal requirements: confirmation (Rule 20.6 PCT)

Written notice confirming that the element or part in question is incorporated by reference in the international application accompanied by:

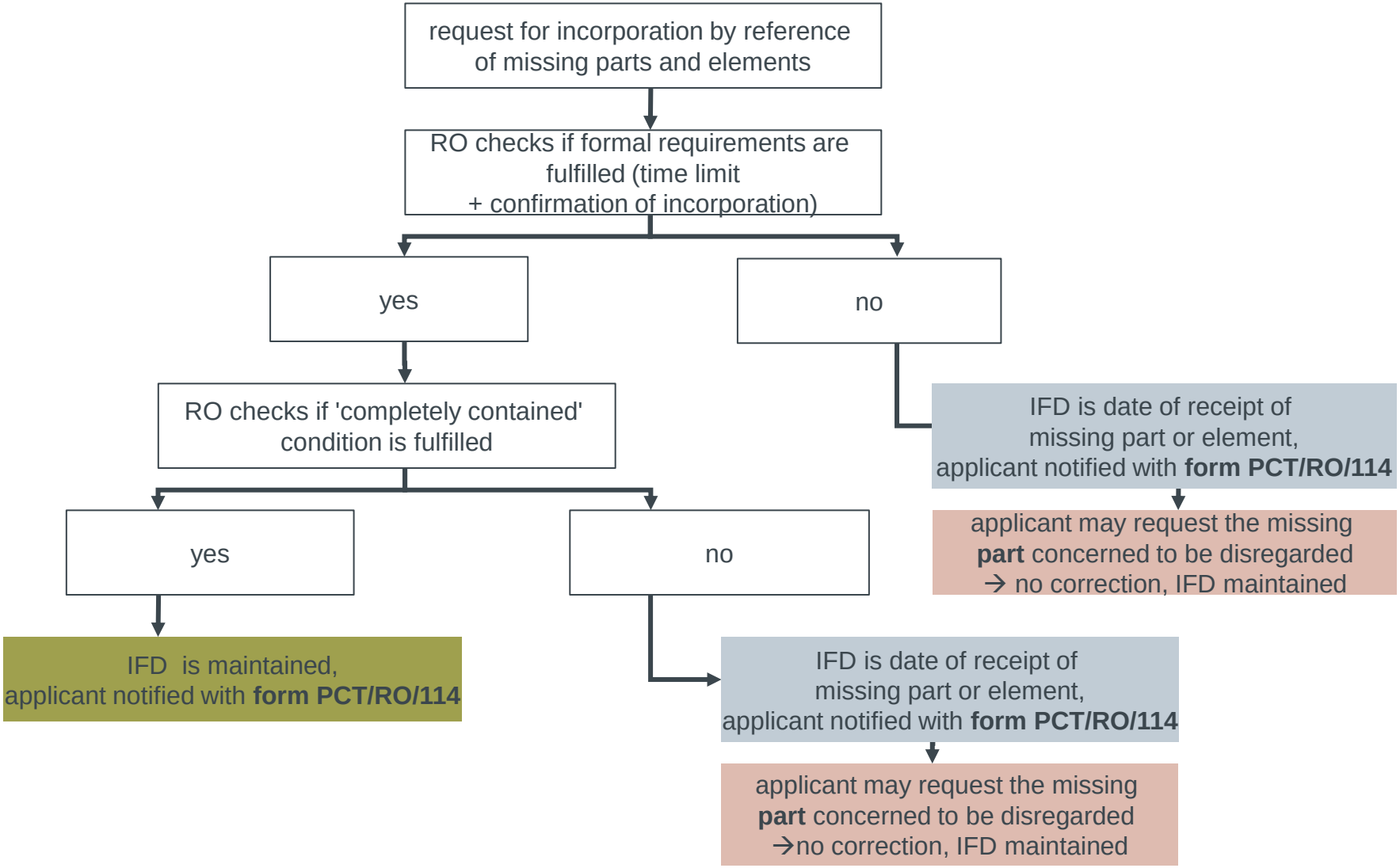
- The sheet(s) embodying the entire element or part as contained in the priority document
- A copy of the priority document, if not already submitted
- A translation if the earlier application is not in the language of the international application
- An indication of where the missing part is in the priority document

Condition: 'completely contained' (Rule 20.6 PCT)

The omitted element or part must be **completely contained** in the earlier application from which the priority was validly claimed → must be identical to the corresponding text/drawing in the priority document

Request contains a statement of incorporation by reference (Rule 4.18 PCT), subject to confirmation under Rule 20.6 PCT → Box No. VI in Form PCT/RO/101

Decision by RO: overview of the procedure



Practical examples (1): general

Example 1: missing element

the full set of claims is missing

RO noticed shortly after the filing date

→ RO is expected to spot the missing element

Decision: RO issues invitation (PCT/RO/103) to the applicant, who has then two months to furnish missing element or request incorporation by reference

Example 2: missing part unnoticed by RO

several pages of the description are missing, number of pages in Check List of the Request is accurate

two months after the filing date

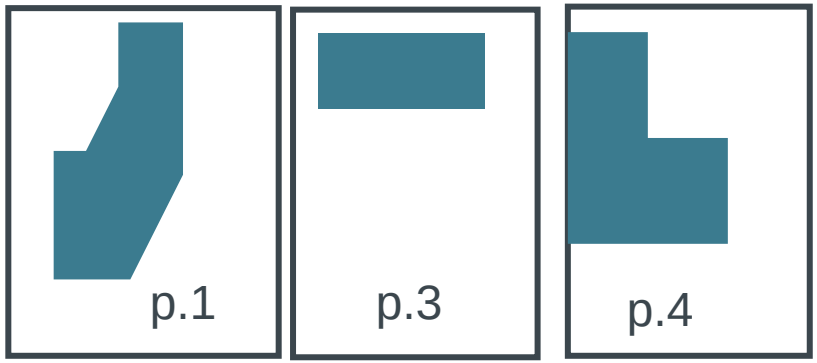
applicant found out about the mistake and informed the RO

→RO is expected to spot the missing part

Decision: RO issues invitation (PCT/RO/107) to the applicant, who has then two months to furnish missing part or request incorporation by reference

Practical examples (2): missing drawings

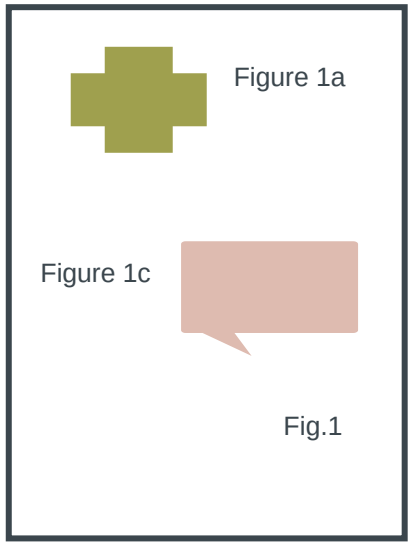
Example 3: missing page of drawings



→ RO is expected to spot the missing page of drawings

Decision: RO issues invitation (PCT/RO/107) to the applicant, who has or request incorporation by reference

Example 4: missing feature in a drawing



→ RO is **not** expected to spot a missing feature in a drawing

Decision: RO does **not** issue invitation (PCT/RO/107) to the applicant

Practical examples (3): others

Example 5: addition of priority claim

Priority not claimed on the filing date

Some pages of the drawings appear to be missing

Completely contained in the priority claimed one week after the filing date

→ Rule 4.18 PCT requires that the priority of the earlier application is claimed on the filing date

Decision: Incorporation by reference **not** allowed

Example 6: obvious mistake in numbering of drawings

Missing drawings completely contained in earlier application whose priority is claimed

Mistake in the numbering of drawings in the earlier application (e.g. Fig.1, Fig. 2, Fig. c, Fig.4, no Fig.3). Description refers to Fig.1, Fig. 2, Fig.3, Fig.4).

→Rectification of clerical mistake allowed (Rule 91 PCT)

Decision: RO issues invitation PCT/RO/107 and PCT/RO/108.

Practical examples (4): others

Example 7: Inclusion of wrong page of drawings

Application contained a wrong sheet of drawings with two figures
Correct sheet also contains two (but different) figures
Description correctly refers to two figures
RO/IB can not be expected to verify whether the figures submitted are the correct ones. The formality check performed will not detect this error

Decision: RO does **not** issue invitation (PCT/RO/107) to the applicant

Example 8: Removal of information not allowed

Together with his confirmation of incorporation by reference, applicant submits a replacement sheet which includes missing parts completely contained in the earlier application
However, the replacement sheet also leaves out several paragraphs which were originally contained in the description
→RO/IB will not accept that certain information originally disclosed is removed through incorporation by reference
Decision: If there still is sufficient time, applicant will be invited to resubmit relevant replacement pages; if the time limit has already expired, request will not be granted

Practical examples (5): others

Example 9: sequence listing as a missing part

References to a sequence listing in the description

No sequence listing filed on the filing date

Sequence listing completely contained in the earlier application whose priority is claimed

→ Sequence listing filed in the application is a part of the description (Rule 5.2 PCT)

Decision: RO issues invitation

PCT/RO/107

Practical examples (6): others

Example 10: missing paragraph in description filed with IB instead of RO/EP

applicant requested incorporation by reference with the IB after publication

RO/EP received the request forwarded by the IB

→Request must be filed with the RO

→RO/EP is not expected to spot a missing paragraph

Decision: RO does **not** issue invitation (PCT/RO/107) to the applicant

Example 11: entire set of new elements was filed

application as filed was complete (description and claims)

new description and claims are entirely unrelated to the elements originally filed

→ whole set of new description and claims does **not** qualify as missing element

Decision: Request **not** granted

Our advice to applicants

- This procedure is time consuming for both users and Offices, and requests are **not** always granted

- Be careful: always **check the content of the acknowledgement of receipt after filing an international application**

- Use online file access tools (such as ePCT) right after submission of your application to verify correct contents of your application

Effect on DO: full review (Rule 82*ter*.1 PCT)

DOs may review decisions of ROs which have allowed incorporation by reference if the DO finds:

- no priority document was furnished
- the statement of incorporation was missing or not submitted
- no written notice confirming incorporation by reference was submitted
- no required translation of the priority document was furnished, or
- the element or part in question was not completely contained in the priority document

Effect on DO: outcome of review (Rule 82ter.1 PCT)

If the DO decides the incorporation by reference did not meet the criteria

- the DO may treat the international application as if the international filing date had been accorded on the basis of the date on which the sheets containing the missing elements or parts were submitted

- the DO has to give the applicant the opportunity to make observations on this outcome and/or to request that, at least the missing parts which had been furnished be disregarded

If the DO notified the IB of incompatibility with their national law, the DO will apply the above as well (Rule 20.8 (c) PCT)

Entry into the regional phase with the EPO

Where the priority document is not in an EPO official language, the applicant must provide (Rule 51bis.1(e)(ii) PCT):

- a translation of the priority document, and
- in cases of missing parts, an indication as to where that part is contained in the translation of the priority document

Conclusion

- EPO and IB / USPTO practices differ only marginally, i.e. when a completely new specification (description & claims) is filed.

- EPO suggested to 2013 PCT WG to align the RO Guidelines to Rule 20 PCT (PCT/WG/6/20), in order to avoid loss of rights when entering into the regional phase; there was no consensus.

- Discussions continued in the PCT WG on this matter since 2013, especially regarding the cases of erroneously filed applications. The target is to explore possibilities that could achieve greater consistency and legal certainty for applicants.