

PCT procedure before the EPO as International Authority



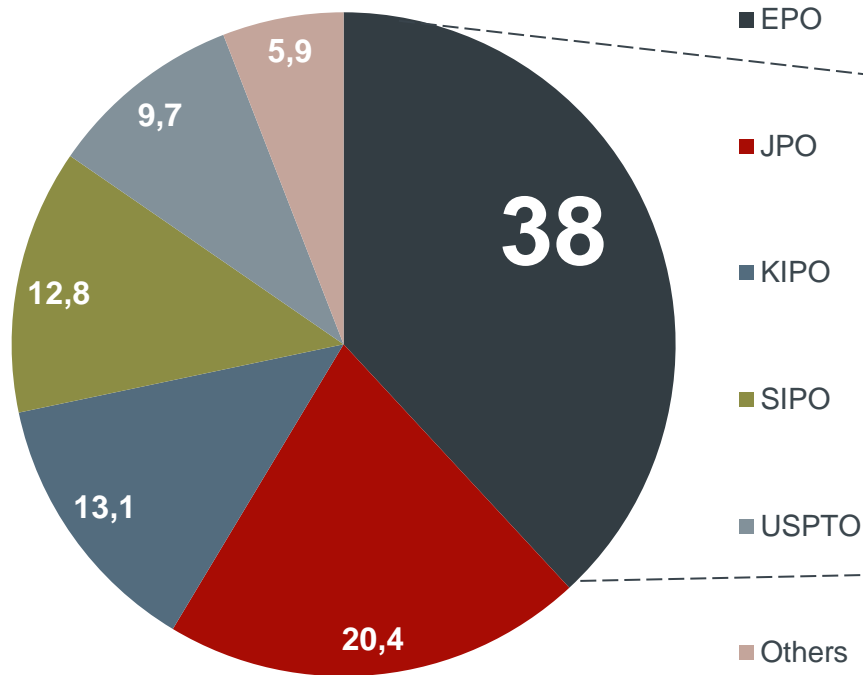
PCT procedure before the EPO as ISA and IPEA

- Informal clarification before search (PCT-CLAR)
- Supplementary International Search (SIS)
- Collaborative Search & Examination Pilot (CS&E)
- Pilot programme on “Search Strategies”
- Chapter II: Second written opinion and top-up search
- Focus: Non-unity procedure under the PCT

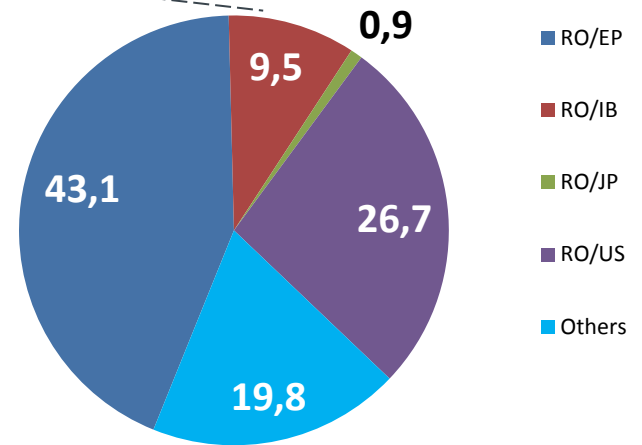
EPO as ISA in 2015

EPO ranks **1st in the world as ISA**, over 81 100 international search reports were established in 2015, which amounts to **38%** worldwide

International Search Reports established in 2015 (%)



Origin of Search Copies received by ISA/EP in 2015 (%)



Latest developments at the EPO as ISA

- PCT Direct service fully operational (around 220 files / month)
- International search fee charged by EPO=ISA frozen at EUR 1 875 since 2012 and at least up until 2018
- Dispense of European supplementary search fee (EUR 1 300)
- Early Certainty for Search programme in full speed with a general improvement on the timeliness of PCT search reports:
 - 94,2% of A1 publications (Q1-Q2 2016) vs 80,6% in 2012
 - 73,1% of ISRs established under Rule 42 PCT (3 m from receipt of search copy or 9 m from priority) in Q1-Q2 2016 vs 54% in 2012

Informal Clarification before search

- EPO may request clarification before issuing a partial ISR/WOISA
- Contact is usually by phone or fax (Form PCT/ISA/207); 2 weeks to reply
- Reply is not mandatory, but the risk is to have an incomplete search. The applicant can reply by:
 - indicating matter to search and/or
 - arguing that his claims are searchable/comply with requirements
 - however, amendments are not possible
- EPO examines reply and may:
 - search a fall-back position chosen by applicant
 - be convinced by applicant's arguments – full search
 - not be convinced – partial/no search
- No consequences in EP phase (R. 62a/63 EPC do not apply)
- OJ EPO 2011, 327; ISPE GL 9.34 and 9.35

Supplementary International Search (SIS) at the EPO

- Given the language knowledge (English, German, French), the SISR established by the EPO helps to overcome problems posed by the linguistic diversity of the prior art that may be found in the national phase
- Same quality of search, fee and advantages as for EPO's international search e.g. dispensation of supplementary European search in EP phase
- Because the SIS by EPO is of the same scope and high quality as the international search in EP phase, SISR established by EPO is respected by national offices upon entry into the national phase
- Explanations provided by EPO in an annex to the SISR are equivalent to the information contained in a written opinion established by EPO as ISA

SIS at the EPO (2)

- Applicants may be represented before the EPO as SISA by the agent appointed for the international phase. Thus, Spanish applicants can continue to be represented by the Spanish agent appointed on file.
- EPO as SISA also searches inventions which have not been searched by the ISA. The applicant must indicate which invention is to be searched.
- Requirements for filing a SIS request :
 - A request must be filed (and the fees paid) with the IB within 19 months from the priority date (**as of 1 July 2017, it will be 22 months**).
- Establishment of the SISR :
 - SISR is established within 28 months within priority date. Therefore, it may improve the basis for deciding on national or European phase entry.

SIS at the EPO (3)

- **Limited costs** : SIS fee (EUR 1 875) and the handling fee for the benefit of the IB (CHF 200) BUT after entry in the European phase,, no fee for
 - Eur. Suppl. search fee (EUR 1 300);
 - claims fee if there are more than 15 claims.
- **Costs for a “useless” application are much higher:** (third) renewal fee (EUR 470), filing fee (EUR 120), Suppl. search fee (EUR 1 300), designation fee (EUR 585), claims fee as of the 16th claim and up until the 50th (EUR 235)
- In 2015, the EPO established 62,5% of all SIS reports.
- **More information** : Euro-PCT 2016 Guide, 272 s.

PCT Collaborative Search & Examination (CS&E)

- Concept: one PCT search performed by the main ISA in collaboration with “peer” ISAs which provide contributions and feedback; IP5 project.
- **Aim:** high quality search, increased legal certainty early on in the procedure
- Pilot phases 1 and 2 (2010-12) were Office driven, and with only 3 participating Offices (EPO, KIPO, USPTO) working on English files
- Pilot phases 1 and 2 covered only a handful of files, and there was no automatic monitoring of the files entering the various national phases
- Pilot phases 1 and 2 could not be used as a conclusive basis to implement the proposed product in the PCT framework, and a 3rd phase was needed

CS&E Pilot phase 3

- Pilot phase 3 will be applicant-driven and all IP5 Offices will participate
- **Aim:** check efficiency gains for Offices and potential uptake by applicants
- Pilot phase 3 is divided in two phases:
 - preparatory phase launched by IP5 Heads on 2 June, and
 - operational phase to be launched (tentatively) by mid 2017.
- Period of operational phase: 3 years to monitor entry into national phases
- 100 files per main ISA will be processed with English and non-English files (including Asian languages: Chinese, Korean and Japanese)
- Secure electronic platform for exchange of information and monitoring of KPIs

CS&E Pilot Group

- CS&E Cooperation Framework endorsed by IP5 Heads: sets the timeline of the CS&E Pilot and the mandate of the CS&E Pilot Group

- CS&E Pilot Group (IP5 + WIPO representatives) is in charge of :
 - during the preparatory phase, organizing the launch of the operational phase on a solid basis (i.a. collaborative scheme and methodology, operational and quality requirements, financial assessment, IT tool etc.)
 - during the operational phase, monitoring the pilot, reporting to IP5 & PCT relevant bodies and informing the user community
 - by the end of the pilot, making a recommendation regarding the implementation of the new product in the PCT framework on the basis of the experience gained and the outcome of the KPIs

- CS&E Pilot Group met for the first time on 17.10.2016 (Munich) and agreed on a Roadmap. Next meeting of the Group will be in February.

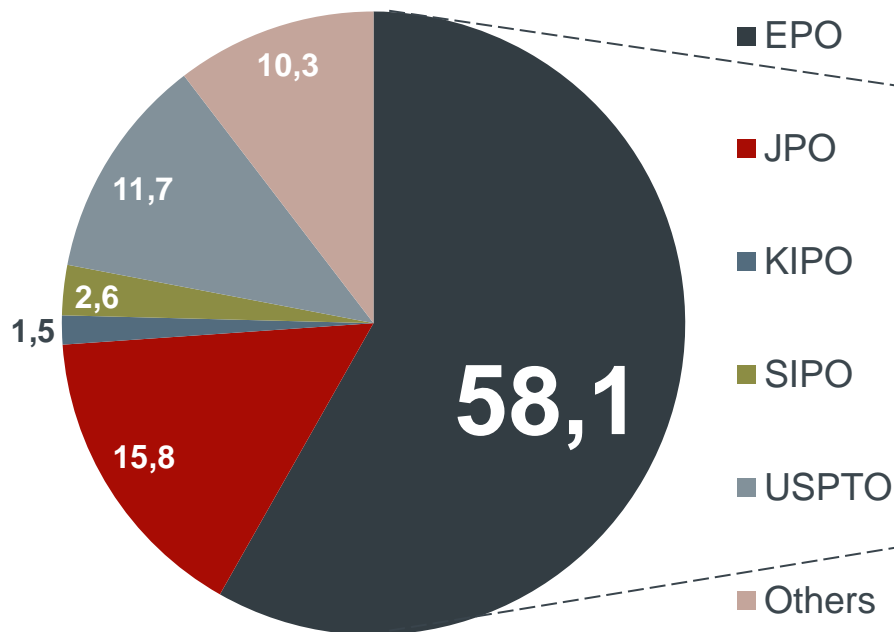
EPO Pilot: Search Strategies

- **Information Sheet on Search Strategy** annexed to all search reports established by EPO under both PCT and EPC
- Contains relevant data on **classification**, **databases** and **key words** used by EPO examiners when performing the search
- Available via file inspection in PATENTSCOPE (for PCT) and European Patent Register (for EP)
- Service available since 1 Nov. 2015 and running until end 2016 (to be extended in 2017)
- See [OJ EPO 2015, A86](#)

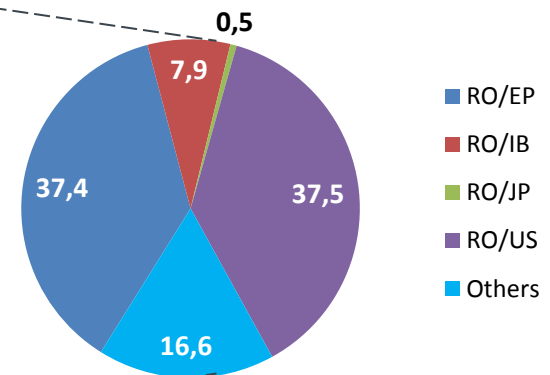
EPO as IPEA in 2015

EPO ranks **1st in the world as IPEA** with over 9 100 international preliminary examination reports having been established in 2015, which amounts to **58.2%** worldwide (reaching even 63,4% in Q1-Q2 2016!)

International Preliminary Examination reports
Established in 2015 (%)



Origins of Demands received by
IPEA/EP in 2015 Q1-3 (%)



Overview of the Chapter 2 procedure



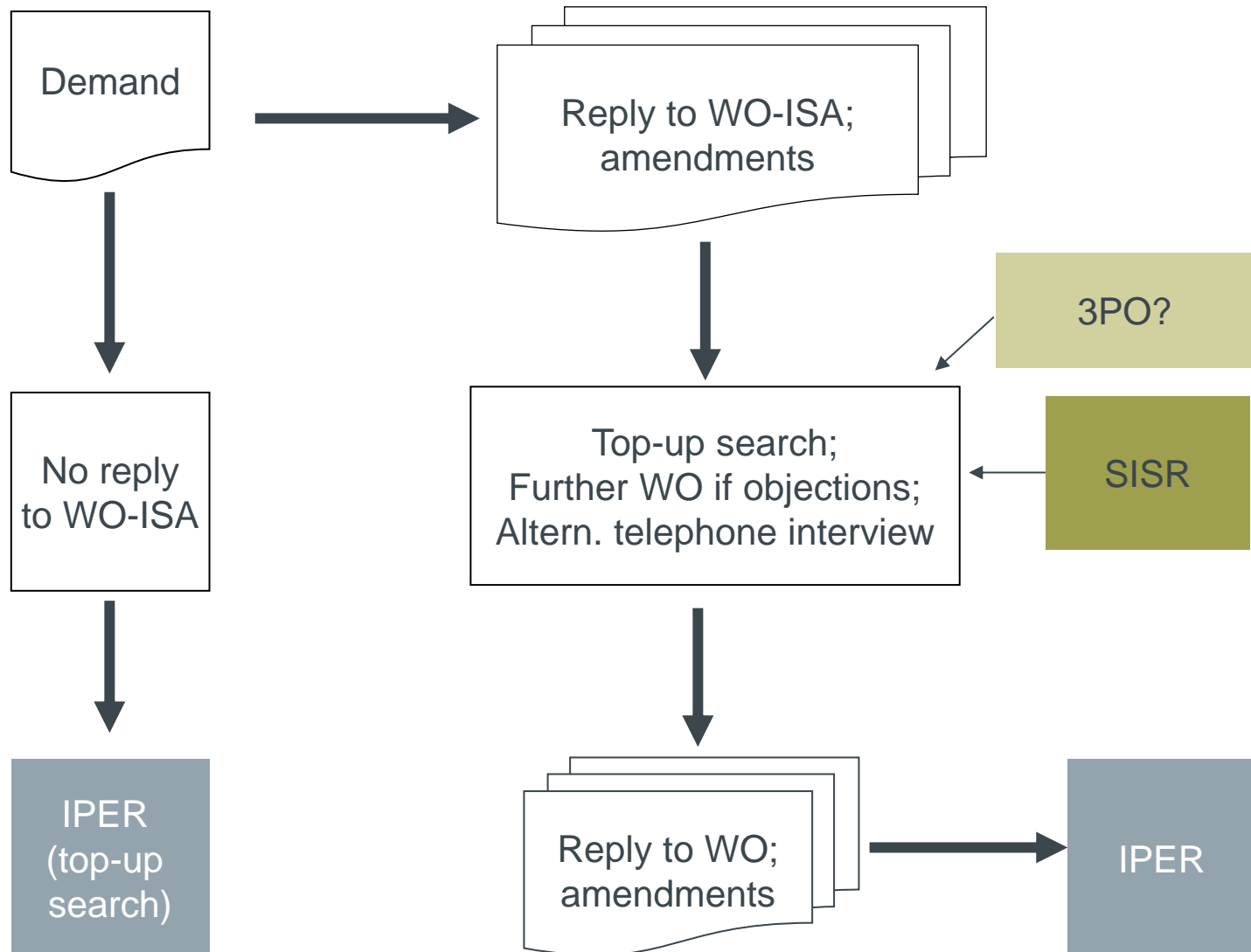
Online filing in Chapter II

- Since 1 April 2014 it is possible to file documents relating to the international application under Rule 89bis.2 PCT online via the PCT-SFD plug-in in the EPO online filing software
 - OJ EPO 2014, A50

- Since 30 June 2014 the demand under PCT Chapter II may be filed online via the PCT-DEMAND plug-in in the EPO online filing software
 - OJ EPO 2014, A71

- Since 1 November 2016 the demand under PCT Chapter II may be filed online via the ePCT
 - OJ EPO 2016, A78

Overview of Chapter II procedure at EPO



Second WO in Chapter II PCT (1)

- New policy since October 2011 in order to enable more interaction within Chapter II
 - Get ready for grant in the European phase
- If the EPO acted as ISA
 - The WO-ISA is considered the first WO under Chapter II PCT (Rule 66.1 *bis*(a) PCT)
- **A second WO is issued** under Rule 66.4 PCT if
 - the applicant filed amendments (or arguments) for the Chapter II procedure, **and**
 - there are objections outstanding so that the IPER would be negative were it to be issued
- Published in OJ EPO 10/2011, 532

Second WO in Chapter II PCT (2)

Exception:

- No second WO issued if a telephone consultation was requested before second WO is established
- Minutes of telephone consultation with time limit for reply takes the place of the second WO

Background:

- Article 34(2)(a) and Rule 66.6 PCT provide for the right to one telephone consultation

Second WO in Chapter II PCT (3)

- The applicant may reply to the second WO or, where applicable, the minutes of the telephone consultation
- Within the time limit set of (as a rule) two months
- By filing comments and/or amendments

Top-up search in Chapter II (EPO practice) (1)

- New Rule 66.1ter PCT entered into force on 1 July 2014
- Top-up search in Chapter II will be done in the same manner as for European applications (Art. 54(3) EPC)
- Will include potentially conflicting prior art under Art. 54(3) EPC, ie also WO publications which have not yet entered the European Phase
- Concentrates on intermediate prior art but also e.g. documents cited in national proceedings for the same application if such documents became available to the EPO as IPEA

Top-up search in Chapter II (2)

EPO practice – timing of top-up search:

- Top-up search in Chapter II will normally be done at the start of Chapter II in order to allow further interaction with applicant should relevant documents be found
- In cases of non-unity an invitation to pay additional fees will be sent first and then the top-up search conducted only for inventions for which fees were paid

Top-up search in Chapter II (3)

EPO practice – scope with respect to the claims:

Will as a general rule be made for all claims forming the basis for the procedure under Chapter II

Examples:

- Unsearched subject-matter claimed
 - The top-up search will not extend beyond the subject-matter searched by the ISA

- Amendments going beyond the original disclosure
 - Top-up search limited to the scope of the claims forming the basis of the Report

Top-up search in Chapter II (4)

Exception:

No top-up search if considered to "serve no useful purpose"

Examples:

- "notorious knowledge" in the field of computer implemented inventions
- excluded subject-matter

Top-up search in Chapter II (5)

EPO practice – interaction with applicant:

- If relevant documents under Rule 64.1 are found giving rise to objections under novelty and inventive step
 - A second WO is issued (or telephone consultation) along the lines set out before
- If only intermediate prior art or potentially conflicting applications are found and there are no other objections
 - Second WO only if Art. 54(3) EPC objection in EP phase

Otherwise an IPER is issued mentioning the documents found under Box VI for information to the applicant

Advantages of Chapter II

- Get the application in order for grant in the national/regional phase
- If the EPO acted as IPEA
 - 50% reduction in the examination fee
(Art. 14(2) Rules Relating to Fees)

With a positive IPER

- A quick grant before the EPO
 - If desired in combination with a PACE (accelerated examination) request
- Strong basis for PPH (e.g. USPTO and JPO):
 - Enables accelerated examination
- Other offices as well relies to a large extent on a positive IPER from the EPO

Positive IPER: Euro-PCT phase (1)

To ensure consistency the EPO has taken the following measures:

- Same examiner in charge in the subsequent EP procedure as in PCT
- In case of a positive IPER the future examining division will be consulted already at the Chapter II stage
- Positive results
 - Very high grant rate for positive IPER, and quickly

Positive IPER: Euro-PCT phase (2)

Mandatory reply in case of positive assessment of patentability:

- In case no other objections in the IPER (e.g. non-unity, formal, clarity, etc.)
 - It is not necessary to provide a reply to the IPER upon entry into the EP phase
 - The file will be treated with priority in the EP phase
- In case of outstanding objections
 - A substantive reply with amendments to overcome the raised objections, possibly in combination with a PACE request, is expected for a quick grant

Focus : Non-unity procedure under the PCT

- International search
- Supplementary International search
- International Preliminary Examination
- European phase where EPO was ISA/SISA

Legal basis for unity of invention - I

- **EPO Guidelines F-V, 1**

"With regard to substantive criteria, unity of invention is examined in search and substantive examination in both European and PCT procedures according to the same principles."

- **Rule 13.1 PCT**

*"The **international application** shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("**requirement of unity of invention**")."*

- **Art. 82 EPC**

*"The **European patent application** shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept."*

Legal basis for unity of invention - II

- The EPO does not require the invitation to be reasoned; a reasoned non-unity opinion will be provided later-on in the opinion attached to the final search report (**B-XI,5**) → no ha lugar protesta en búsqueda
- Under PCT an invitation to pay additional search fees must be reasoned (**Rule 40.1(i) PCT**) → ha lugar protesta

Non-unity in international search

Invitation to pay additional search fees



#1



#2

Invitation (Art. 17.3a PCT Rule 40.1 PCT) Form PCT/ISA/206

- Search results (inv. 1)
- Fee request (inv. 2)
- Unity reasoning
- Time limit: one month

Applicant



Invitation to pay additional search fees

Art. 17(3)(a) PCT / Rule 40.1 PCT

Unity reasoning – R. 40.1(i) PCT

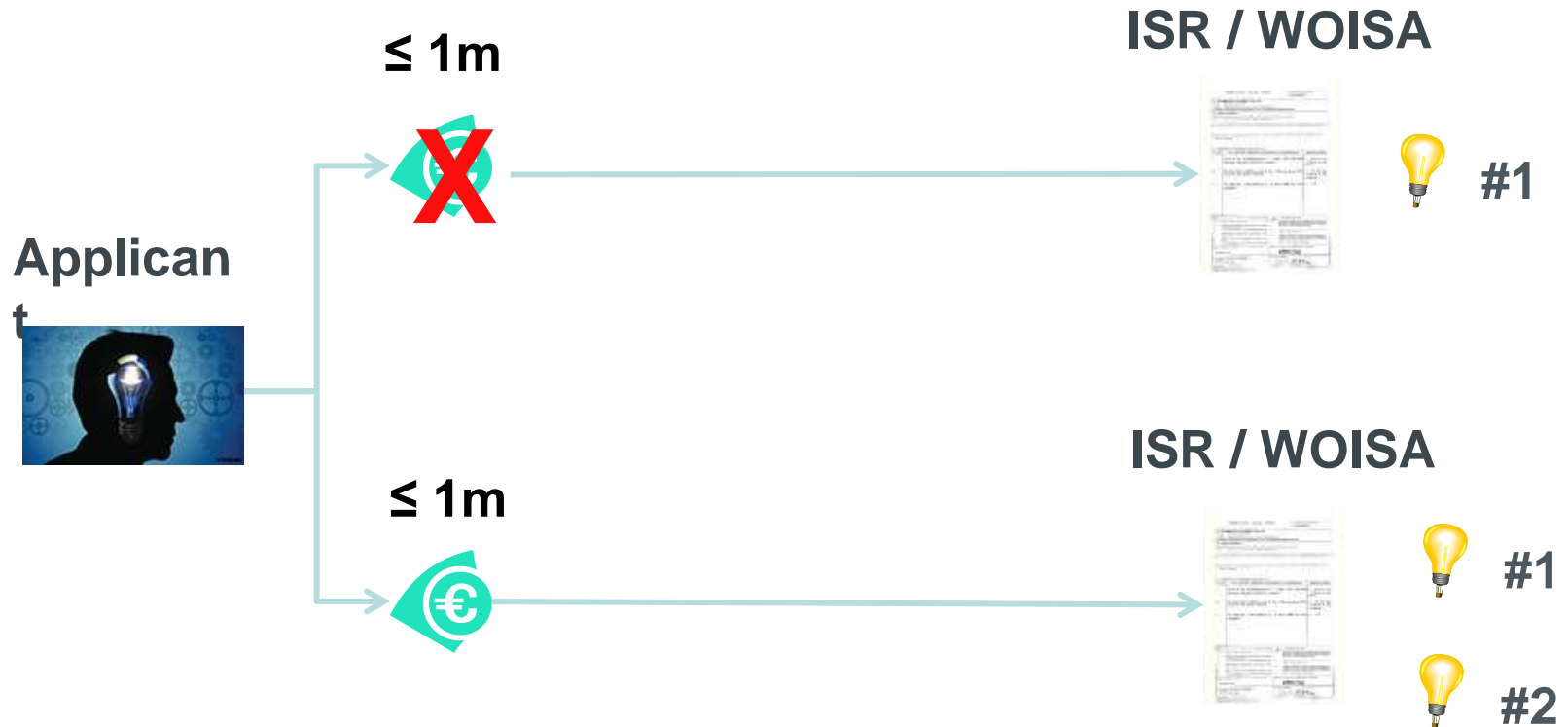
- Problem solution approach – W11/89, W10/92, W8/94
- Closest prior art – W18/92
- Common/corresponding feature – R. 13.2 PCT
- Division of inventions

Amount due per extra invention – EUR 1 875

Search results on 1st invention: Form PCT/ISA/206

If no additional fee is paid, the annex will be considered as the final search –
OJ EPO 1989, 61

Payment of additional search fees



Payment of additional search fees

- Additional fees paid directly to ISA – R. 40.2(b) PCT
- Within 1 month of invitation – R. 40.1(iii) PCT
- Indicate **which** inventions are paid for
- 1x full search fee for each extra invention: EUR 1 875 – R. 158(1) EPC
- Extra search fees can be refunded:
 - By filing a protest
Protest fee: EUR 875 – R. 40.2(c) PCT (may be required by ISA)
 - Where the EPO searched the priority – R. 16.3 PCT (partial refund)

The non-unity protest – Rule 40.2(c) PCT

Formal requirements

- Filed on time ($\leq 1m$) + protest fee (EUR 875) paid on time ($\leq 1m$)
 - R. 40.2(c) PCT

- In an EPO language – OJ 1993, 540, R. 92.2(b) PCT

- Reasoning required – R. 40.2(c) PCT, W8/89
 - Simple allegation – **insufficient**
 - No/insufficient reasoning – merit not examined
 - No further reasons after expiry of time limit

 - Example: payment of additional fee under protest

The non-unity protest – Rule 40.2(c) PCT

Procedure

- Further submissions possible – W15/00
- Amendments are not possible – W3/91, W3/94, W6/94
- **Review body:** 3 examiners, one of whom shall chair the panel and another of whom shall be the examiner who was responsible for issuing the invitation to pay additional fees – OJ EPO 2015, A59

Decision

- Full refund of all contested additional search fees (& protest fee)
- Refund of some contested additional fees
- No refund of any additional search fees

- Patentscope WO2012062920

The non-unity protest – Rule 40.2(c) PCT

Was it indicated/implied if non-unity was *a priori* or *a posteriori*?

In *a posteriori* cases:

Was the problem reformulated, where necessary?

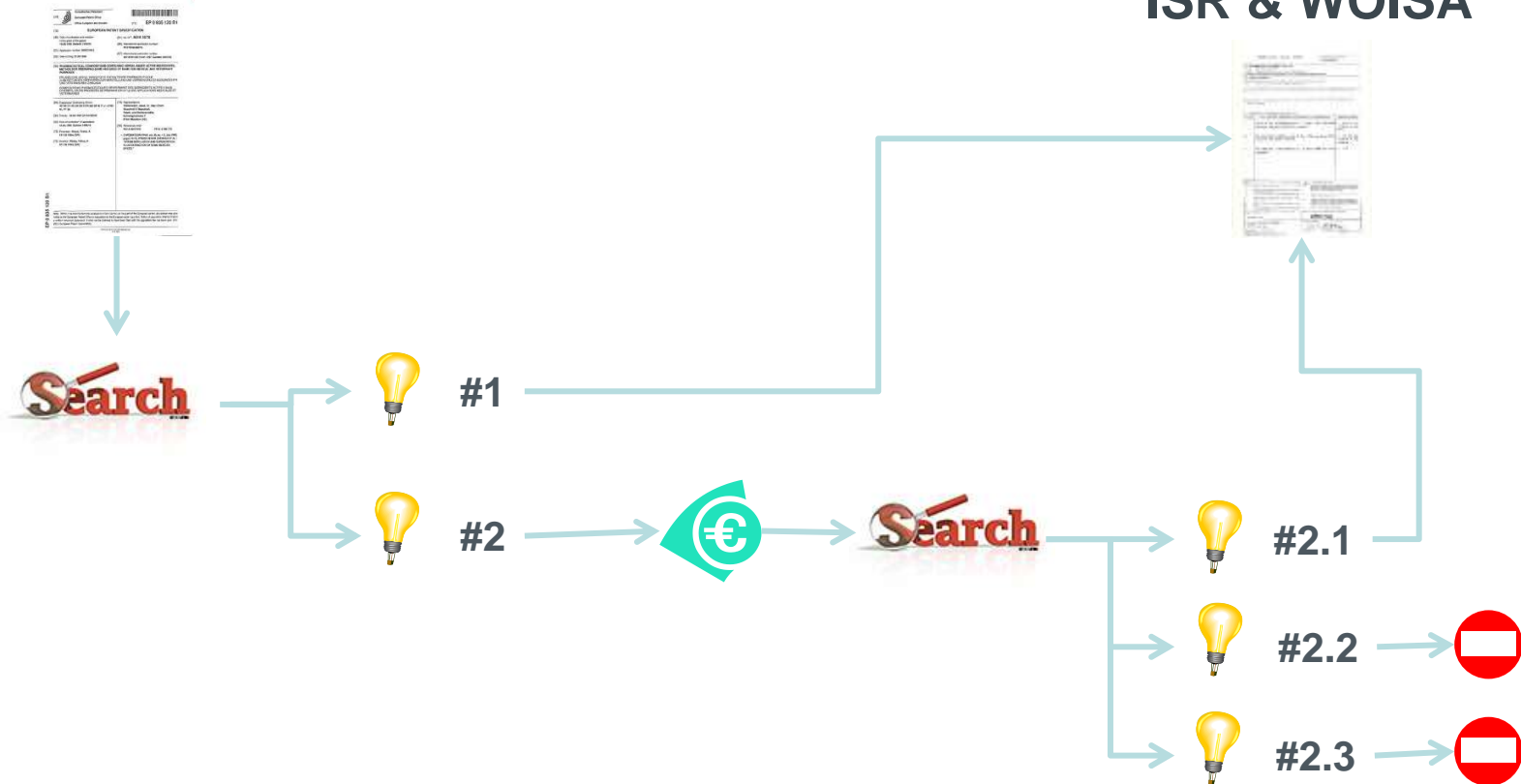
Was the prior art relevant to unity identified?

Was the common/corresponding technical feature:

- identified?
- shown to be known as a solution to problem in prior art?

The *a posteriori* cascade problem

ISR & WOISA



The *a posteriori* cascade problem

- Additional search fee(s) paid for invention(s) other than first
- Cascade a posteriori lack of unity found in one of these inventions
- EPO has two options, to search either:
 - all sub-inventions (2.1, 2.2, 2.3)
 - only the first sub-invention (2.1) – Art. 17(3)(a) PCT
- The EPO cannot send a second invitation – Euro-PCT Guide 2016, 267
- Cascade non-unity identified in ISR/WO-ISA

Non-unity in Supplementary International Search

Normal case – first invention searched



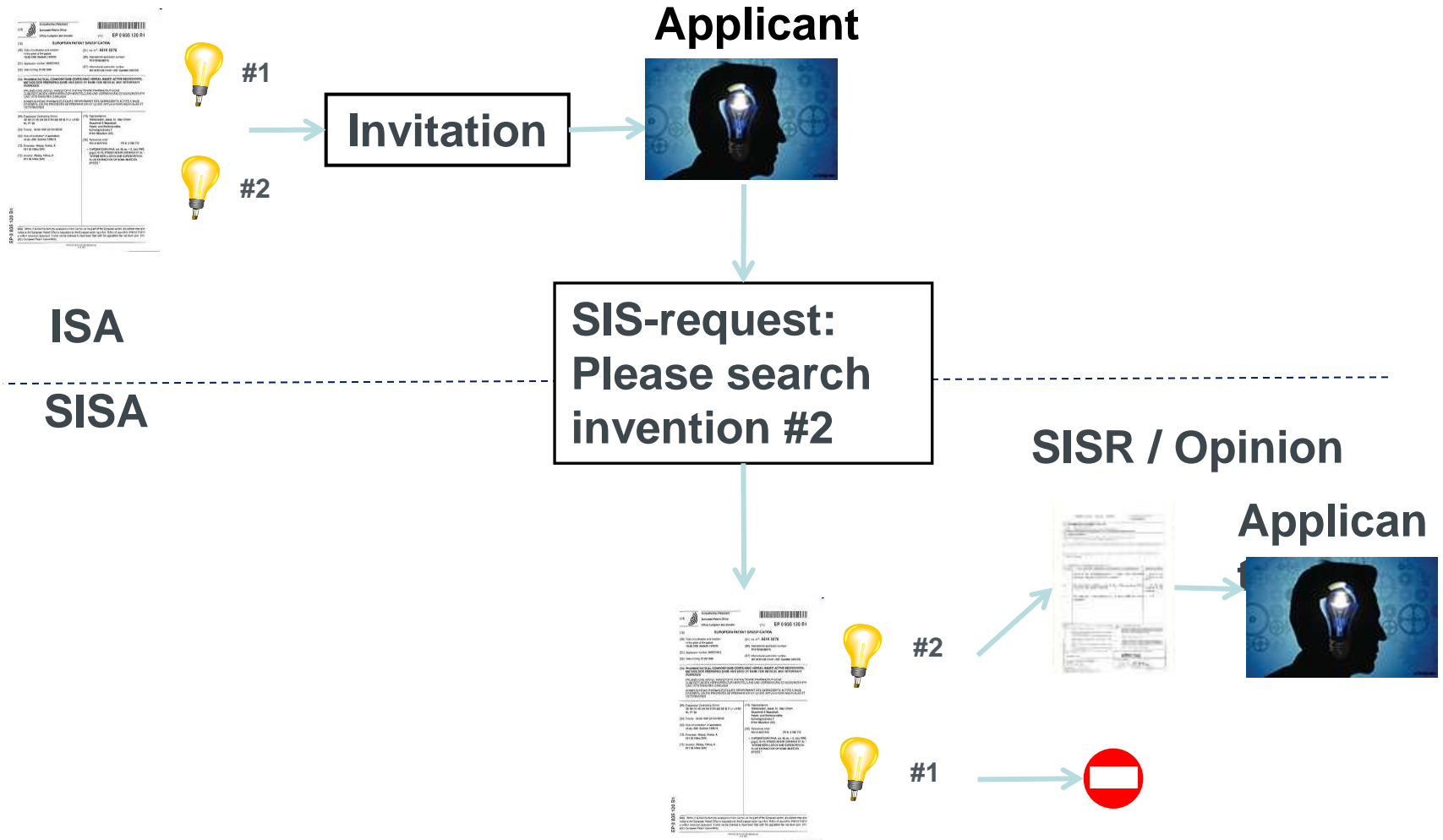
- No invitation to pay additional SIS-fees is sent
- One invention searched/opinion given
- This is usually the first invention in the claims – R. 45bis.6(a) PCT
- Exceptionally another invention is searched instead

Special case – request under Rule 45bis.1(d) PCT

ISA found lack of unity:

- Applicant can request SISA to search an invention other than first
- This is done on the SIS-request
- If EPO as SISA disagrees with ISA (finds unity) – searches all claims
- If EPO as SISA also finds non-unity:
 - same division as ISA: searches invention requested
 - different division to ISA: searches most appropriate invention

Special case – request under Rule 45bis.1(d) PCT



Non-unity in international preliminary examination

Invitation to pay additional examination fees

Art. 34(3)(a) PCT/Rule 68.2 PCT

Where more than one searched invention remains in claims:

IPEA/EP invites the applicant to either:

- pay additional examination fees for searched inventions, or
- restrict the claims to comply with unity

Form PCT/IPEA/405

Invitation contains unity reasoning:

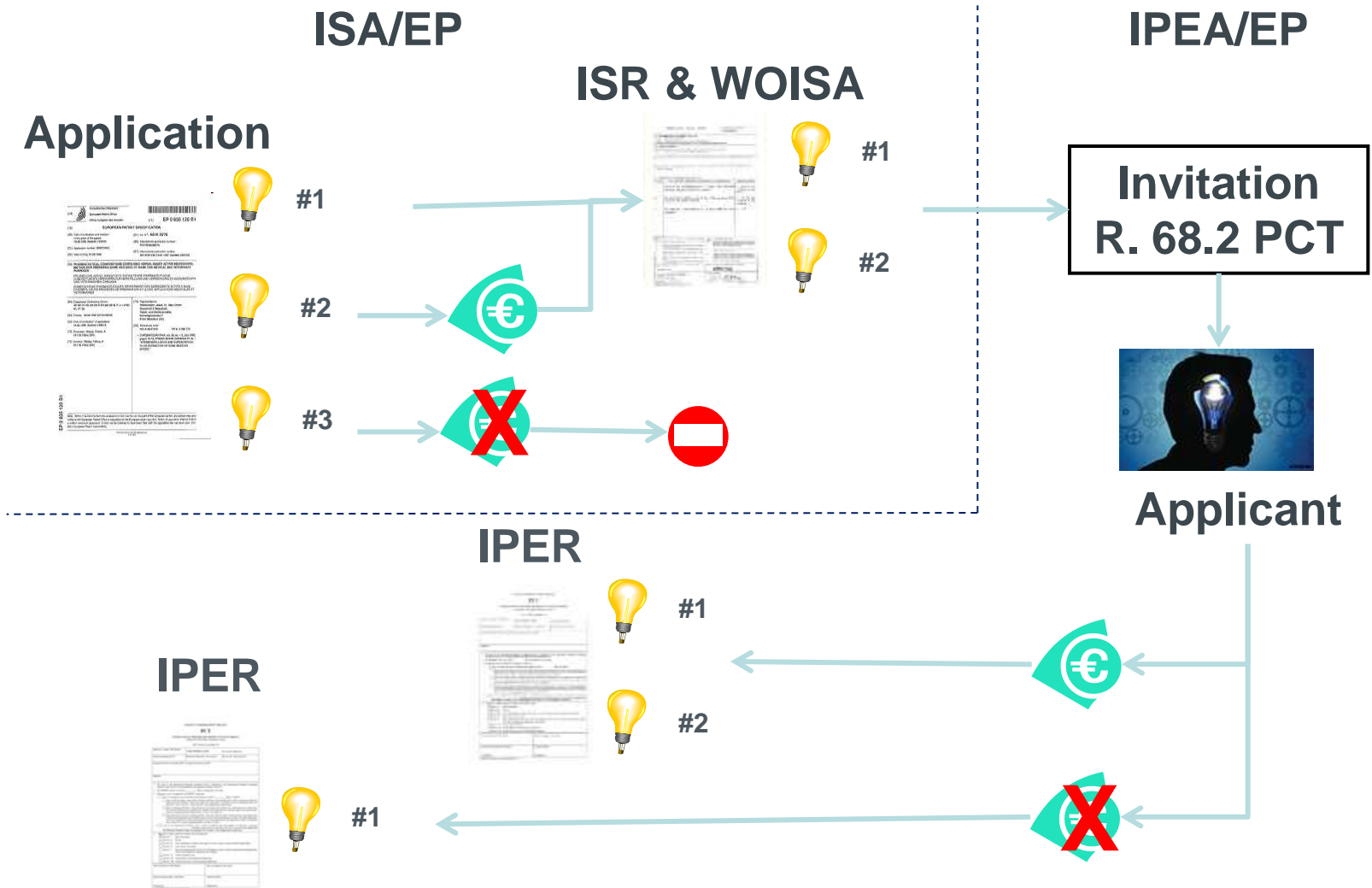
- same requirements as ISA invitation
- ISA reasons may need adapting due to amendments

Invitation indicates amount due per extra invention (EUR 1 930)

Payment of additional examination fees

- Additional fees paid directly to IPEA within 1 month of invitation – R. 68.2(iii) PCT
- Indicate which inventions are paid for
- 1x full examination fee for each extra invention – R. 158(2) EPC)
- WO/IPER cover all searched inventions paid for – Art. 34(3)(c) PCT
- Fees not payable for unsearched inventions – Euro-PCT Guide 2016, 399
- Extra fees may be refunded by filing a protest – EUR 875 – R. 68.3(c) PCT

Non-unity passing from ISA/EP to IPEA/EP



Non-payment/limitation of claims

- Examination based on "main invention" – Art. 34(3)(c) PCT
- "**Main invention**" – usually first in claims
- "**Main invention**" may change where:
 - amendments filed before invitation
 - claims limited in reply to invitation
- Limit to one **searched** invention = "main invention"
- Limit to unsearched invention – cannot be examined – R. 66.1(e) PCT
 - *e) Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.*

Non-unity in the European phase

EP was (S)ISA

Procedure from 01.11.2014 (EPO was (S)ISA)

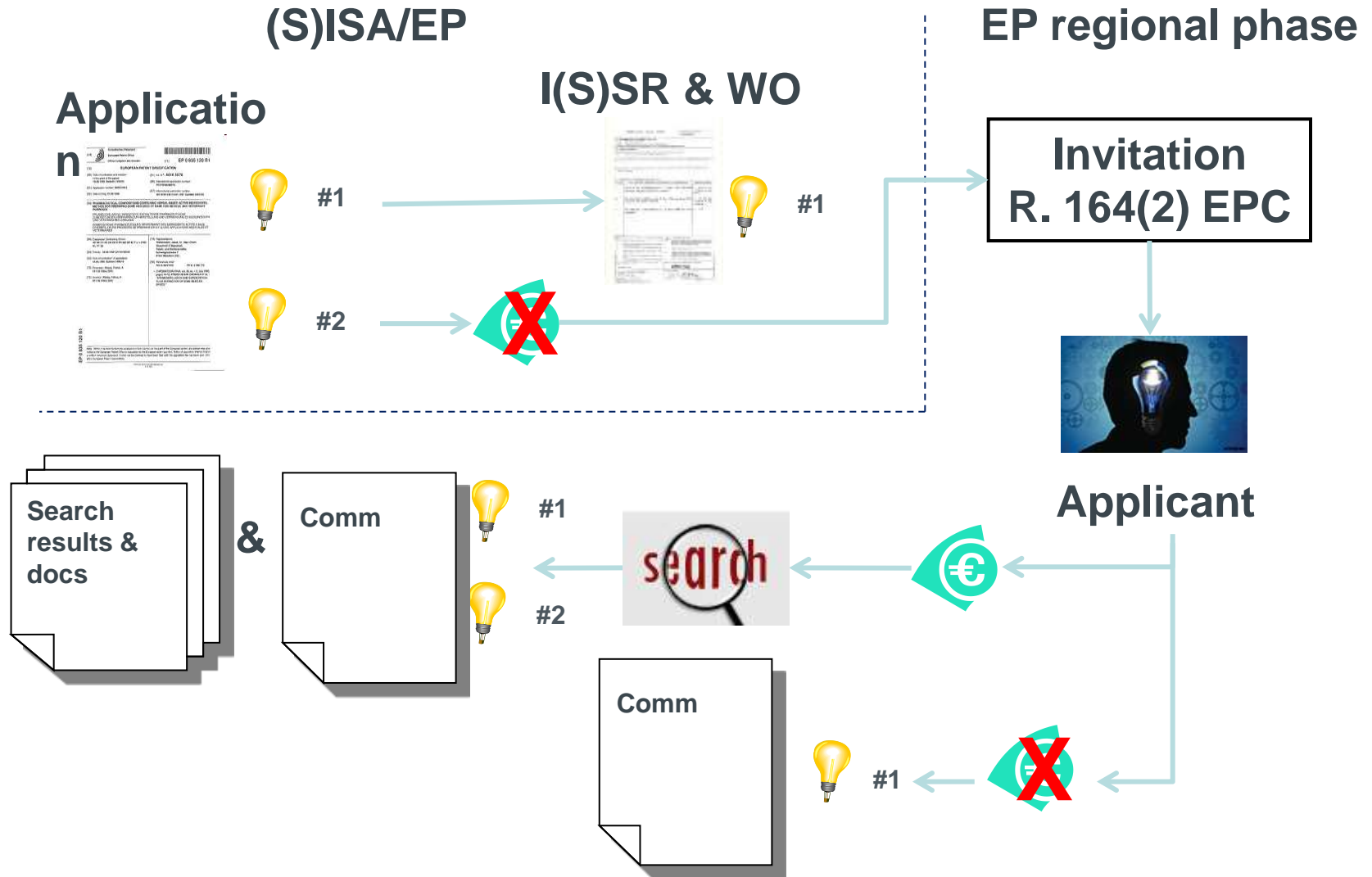
– Invitation to pay additional search fees

Inventions not searched by EPO persist in claims in EP phase:

- Invitation to pay search fee for unsearched inventions – EUR 1 300
– R.164(2) EPC

- Based on claims on file on expiry of a 6 month period – R. 161(1) EPC
 - if all unsearched inventions deleted before this: **no invitation**
 - If all claimed inventions already searched in PCT: **no invitation**

Invitation to pay additional search fees



Additional Searches I (EPO was (S)ISA)

After the six-month period for response to the R.161(1) communication, Examining Division starts examination

- If Examining Division considers that the application claims one or more unsearched inventions → invitation under R.164(2) EPC is sent (further search fee in EP lower than in PCT – Rfees 2(1)2).
 - If no search fee is paid → only invention searched is prosecuted
 - If a search fee is paid for a certain invention → Ex. Div. does the corresponding search (“*search incident during substantive examination*”)
- **Before 01.11.2014:** Not possible to do additional searches for unsearched inventions.

Additional Searches II (EPO was (S)ISA)

- Invitation under R.164(2) EPC is also sent for
 - Unsearched inventions from a cascade (C-III, 2.3)
 - Invention imported from description (F-VI, 13.1 (iv))
 - Only if invention imported before expiry of R. 161(1) EPC period
 - R. 137(5) EPC applies from expiry of R. 161(1) EPC period
- **Special cases**
 - Auxiliary requests – invitation based on main request (CIII, 2.3)
 - Claims suffering a **severe lack of clarity** – Art. 84 EPC
 - EPO sends a normal communication raising clarity (Art. 94(3))
 - Clarified claims filed, revealing an unsearched invention
 - No invitation under R. 164(2) EPC is sent → Divisional

Additional fees paid under Rule 164(2) EPC (1) (EPO was (S)ISA)

- Time limit < 2 months from invitation – R. 164(2)(a)EPC
- EPO then searches inventions paid for
- Search results issued as an annex – R. 164(2)(b) EPC
 - to normal examination communication – R. 71(1)(2) EPC **or**
 - to invitation to approve text for grant – R. 71(3) EPC
- Cited documents accompany above communication

Additional fees paid under Rule 164(2) EPC (2)

Normal examination communication contains/provides:

- all objections to all inventions searched in PCT/EP – C-III, 2.3
- unity objection (where applicable) – C-III, 2.3
- request to delete all unsearched inventions – R. 164(2)(c) EPC
- an exceptional exemption to R. 137(3) EPC – H-II, 2.3

Any invention searched by EPO in PCT **or** EP phase can be pursued

Additional fees paid under Rule 164(2) EPC (EPO was (S)ISA) – Example by Derk Visser

- ISA is EPO – inventions A and B in PCT are non-unitary
- Non further search fee paid → ISA searched only invention A first mentioned in the claims
- Entry EP Phase – inventions B, A and C for prosecution (C taken from the description)
- No amendments under R 161 (1).
- Examining Division invites, according to R164(2), applicant to pay search fee for inventions B and C.
- Applicant pays further search fee for invention C
- Art. 94(3) EPC communication includes search results for invention C, the findings of the examining division for inventions A and C, and a request to limit the invention to a single invention.
- Applicant selects invention C for prosecution and deletes inventions A and B.
- Inventions A and B can only be pursued in divisionals.

Non Unity in the European Phase

EP was not (S)ISA

New procedure from 01.11.2014 (EP was not (S)ISA) – Invitation to pay additional fees – Rule 164(1) EPC

If claims lack unity, procedure is analogous to EP direct:

- partial search report on 1st invention sent – R. 164(1)(a) EPC
 - invitation to pay additional fees also sent – R. 164(1)(b) EPC
 - No ESOP – B-XI, 5
-
- Claims are those on file on expiry of period under R. 161(2) EPC
 - EPO position on unity independent of ISA finding – B-VII, 2.3
 - If no further search fees are paid → only first searched invention for prosecution (+ ESOP)
 - If further fees are paid → Supplementary search report for each invention paid + ESOP
 - **Before 01.11.2014:** SSR limited to 1st claimed invention

Additional fees paid – Rule 164(1) EPC (EP was not (S)ISA)

Time limit: <2 months from invitation

No fee reductions are given for additional search fees

Supplementary search report issued on all inventions paid for

Supplementary search report accompanied by ESOP, containing:

- all relevant objections to invention 1st mentioned in claims
- all relevant objections to all other inventions searched by EPO
- a unity objection

Applicant must then reply to ESOP (Rule 70a EPC)

Examination can be based on any invention searched by EPO (G 2/92)

Additional fees paid – Rule 164(1) EPC

EP was not (S)ISA – Example by Derk Visser

- ISA not EPO – inventions A and B in PCT are non-unitary
- Non further search fee paid → ISA searched only invention A first mentioned in the claims
- Entry EP Phase – inventions B, A and C for prosecution (C taken from the description)
- No amendments under R 161 (2).
- Partial Supplementary Search Report relates to invention B, raises non-unity objection to inventions B, A and C.
- Applicant pays further search fee for invention C
- Supplementary Search Report will cover: inventions B and C.
- Applicant selects invention C for prosecution and deletes inventions A and B.
- Inventions A and B can only be pursued in divisionals.