

Entry into the European phase

Early Entry

Early Certainty from Search

Acceleration schemes: PCT-PPH, PACE, waivers

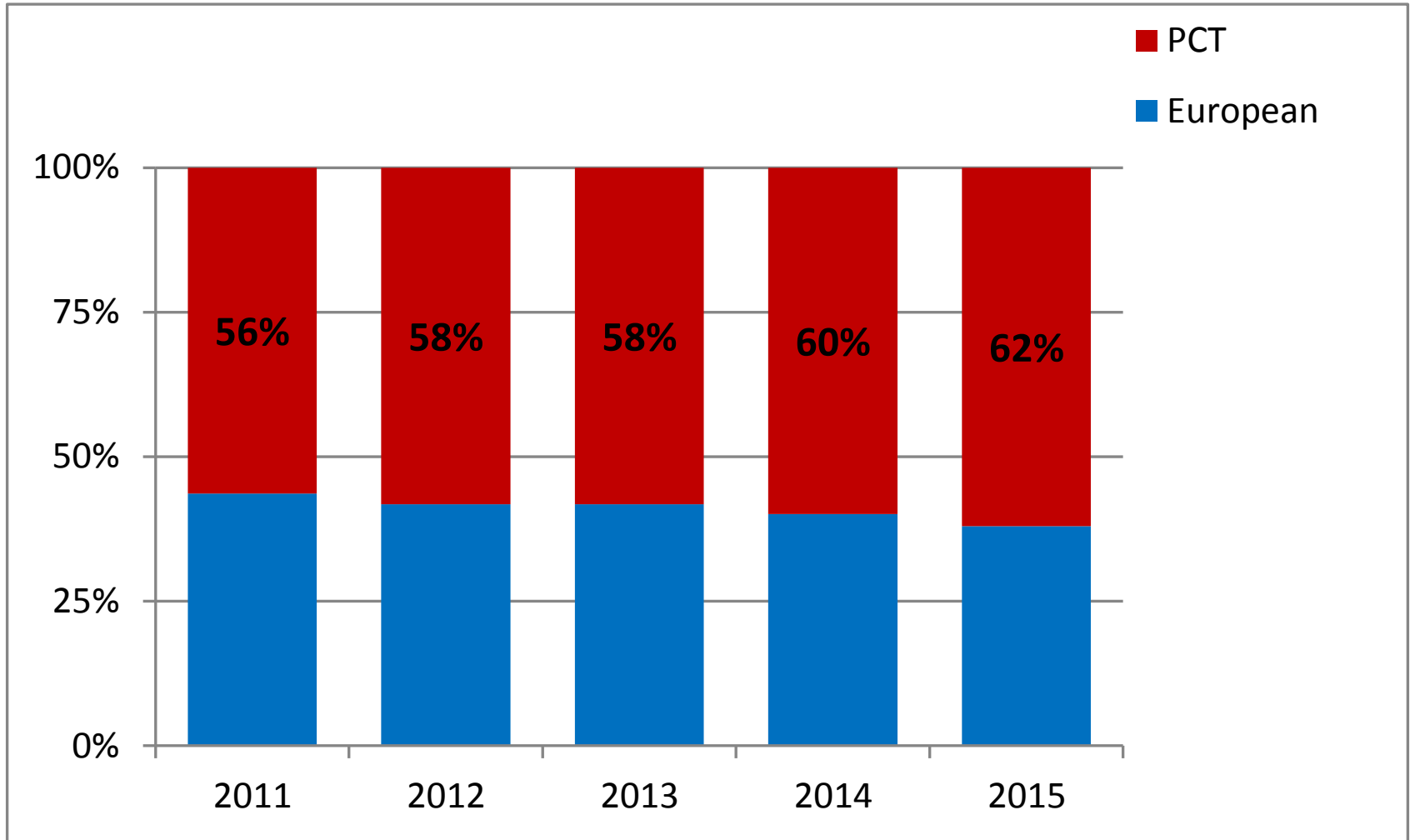
Global dossier



The EPO as designated Office

- In 2015: 98 228 international applications entered the European phase (92 007 in 2014) vs 61 724 Euro-direct applications = 61,4% of total
 - **EPO Form 1200** to be filed directly at the EPO
 - National route closed for the following 12 EPO Member States: as of 01.01.2016, Belgium, Cyprus, France, Greece, Ireland, Italy, Latvia, Lithuania, Malta, Monaco, the Netherlands and Slovenia.
 - Time limit:
 - **31 months** from the filing date or, if a priority is claimed, from the oldest priority
- OR**
- Request for early processing

The EPO as designated Office: Share of grants



Request for early processing (1)

- Processing ban until **expiry of 31 months** from filing/priority
Article 22(3) / 39(1)(b) PCT, Rule 159(1) EPC
- Only the **applicant** can lift this processing ban
Articles 23(1)/40(1) PCT
- Requirements:
 - **Explicit request** for early processing (preferably with explicit reference to Article 23(2) / 40(2) PCT)
 - Compliance with the **requirements of Rule 159 EPC** as if the 31-month period expired on the date early processing is requested

(OJ EPO 2013, 156)

Request for early processing (2)

Requirements specific to Euro-PCT applications:

- always to be fulfilled : **filing fee**, and **specification** of application documents forming the basis of EP phase proceedings
- depending on the case : **translation** if the application was not published in an EPO official language, and European **supplementary search fee** if the EPO was not ISA or SISA

Requirements applicable to any European application:

- **designation fee**
- examination request, and **examination fee**
- (third) **renewal fee**

Consequences of an **effective request**

- The processing ban has been lifted by the applicant:
 - ⇒ The application is processed like any Euro-PCT application having (regularly) entered the European phase

Article 153(2) EPC

- ⇒ Time limits under the EPC for procedural acts (payment of fees, submission of documents) must be complied with

Consequences of a **non-effective request**

EPO issues Form 1231 informing the applicant of deficiencies

The applicant then has a choice between:

- doing **nothing**, i.e. not pursuing the request for early entry
 - The international phase continues
 - The processing ban still applies
 - Article 23(1) / 40(1) PCT
 - Regular entry into the European phase on expiry of the 31-month period
 - Rule 159(1) EPC
- **pursuing the request for early entry** by
 - fulfilling any missing requirement as indicated in Form 1231
 - complying with any further requirement due on the date on which the request is pursued

Waivers in the grant procedure – overview

- Purpose:
 - Accelerate the procedure
 - Increase procedural efficiency both for users and the Office

- Waivers and PACE requests are to be distinguished and have to be filed separately:
 - PACE is a request to speed up the processing
 - A waiver is abandoning the right to a communication

Waiving the right to a communication under Rules 161 and 162 EPC

- A communication under Rules 161 and 162 EPC gives the applicant the opportunity to **comment on the WO-ISA and file amendments**, and informs him of any **claims fees** due
- The applicant may **waive the right** to receive such a communication under Rules 161 and 162 EPC
- This waiver avoids the 6-month period set in the communication under Rules 161 and 162 EPC

Waiving the right to an invitation under **Rule 70(2) EPC** (only EPO ≠ (S)ISA)

- The EPO invites the applicant to indicate after search whether he **wishes to proceed further with the application** under Rule 70(2) EPC
- The applicant can **waive** this right and request examination unconditionally, irrespective of the results of the search
- This waiver avoids the 6-month period set in the communication under Rule 70(2) EPC

PACE in search

European patent applications filed **on or after 1 July 2014**

➔ Extended/partial European search report already issued within six months from the filing date/expiry of the period under Rule 161 EPC (if possible)

⇒ **Since the introduction of ECfS, all searches are being processed according to the PACE timeline!**

OJ EPO 2015, A93 (points 8 & 9)

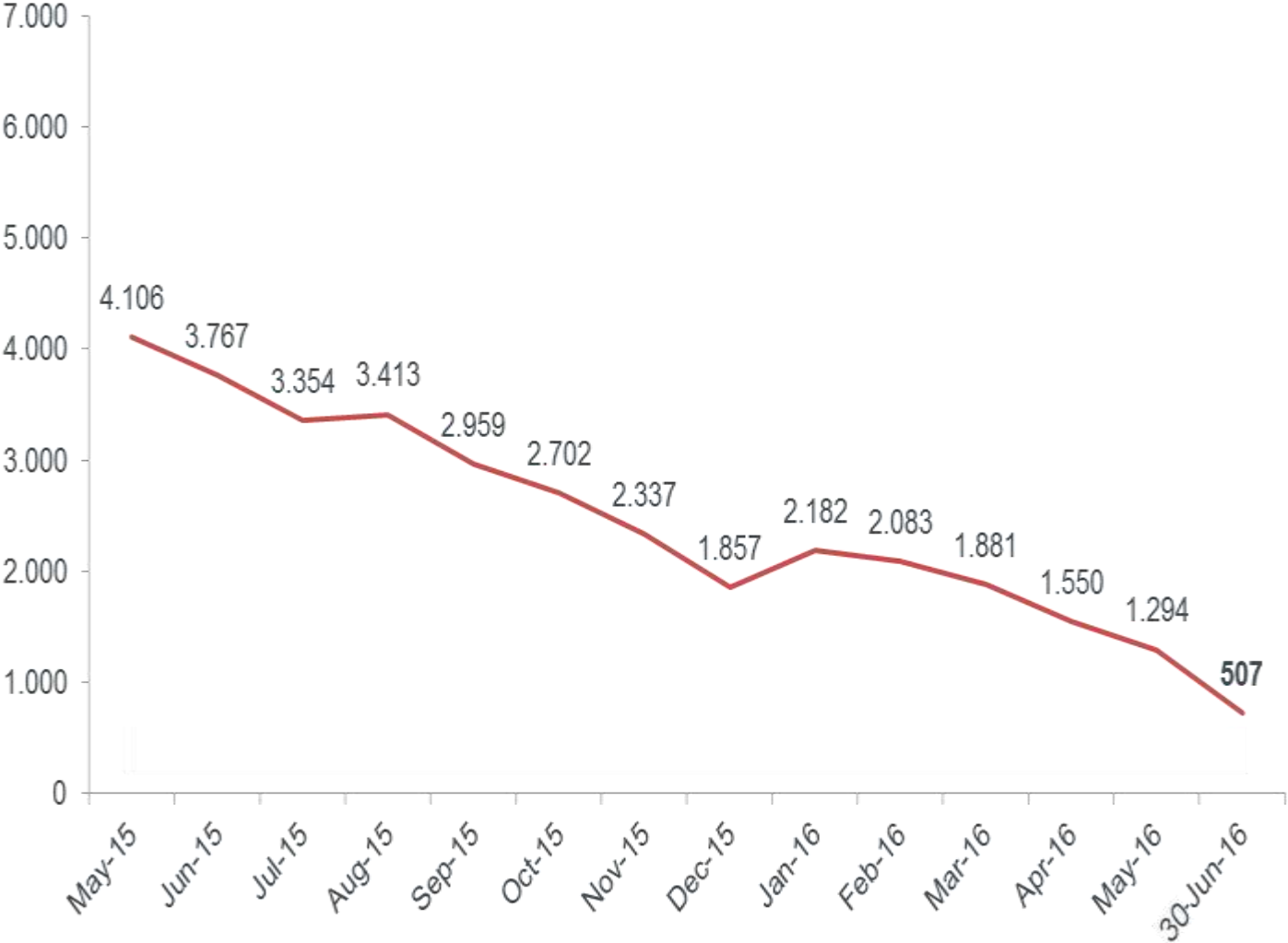
PACE requirements since 1 January 2016

- PACE requires
 - a written request
 - using EPO Form 1005
 - filed online
- A PACE request can only be filed for **one application at a time**
- A PACE request can only be filed **once during each stage** of the procedure
 - A PACE request filed during search will not trigger accelerated examination

Removal from the PACE programme

- An application will be **removed** from the PACE programme if
 - the applicant **requests an extension** of time limits
 - the PACE request is withdrawn
 - the application has been refused or withdrawn or is deemed to be withdrawn
 - ➔ **Not be possible to restore** processing under the PACE programme
(a second request for the application during the same stage of the procedure will not be processed)
 - Accelerated prosecution will be **suspended** in the event of failure to pay renewal fees by the due date
- Rule 51(1) EPC

PACE backlog (RAEX)



PCT-PPH programme

A PPH request can be based on the latest PCT work product (WO-ISA or IPER) established by the ISA or IPEA under the following conditions:

- the PCT work product determines one or more claims to be patentable/ allowable.
- all claims in the application entering the national phase must sufficiently correspond to the patentable/allowable claims which have been examined in the international phase (declaration of claims correspondence)
- at the EPO, use of EPO Form 1009

EPO's PPH activities

- **Expansion** of the EPO PPH network
 - Continuation of the IP5 PPH trial
 - New PPH partner offices
 - in 2015: Canada, Israel, Mexico, Singapore
 - in 2016: Australia (1 July 2016), Colombia (1 October 2016)
 - Bilateral PPH pilot programmes in preparation
 - Russia, Malaysia, the Philippines
- Promotion of the **PCT – PPH**
 - in line with EPO's objective to strengthen the PCT
 - reinforce the use of PCT work products

Status of IP5 PPH pilot programme

as of September 2016

Patent Office	Work product	Launch date	Number of requests
JPO	PCT work products	29 January 2010	1418
	national work products		2751
KIPO	PCT work products	6 January 2014	129
	national work products		109
SIPO	PCT work products	6 January 2014	311
	national work products		91
USPTO	PCT work products	29 January 2010	308
	national work products	28 September 2008	2640
Total IP5 PPH			7767

Status of bilateral PPH pilot programmes

as of July 2016

Patent Office	Work product	Launch date	Number of requests
CIPO (Canada)	PCT work products	6 January 2015	42
	national work products		21
ILPO (Israel)	PCT work products	6 January 2015	25
	national work products		11
IMPI (Mexico)	national work products	6 January 2015	2
IPOS (Singapore)	national work products	6 January 2015	5
Total non-IP5			106

Early Certainty from Search (ECfS)

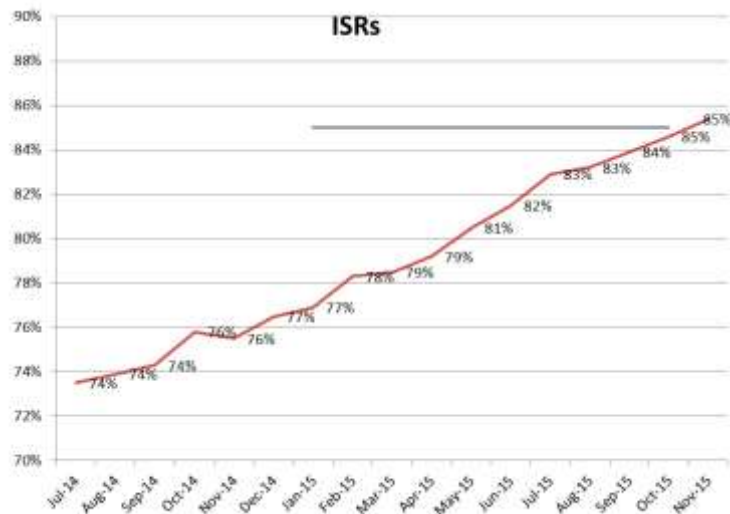
- Issue all **searches with opinion** on time: about 6 months after file reception
- **Expedite grant** following positive search opinion
- **Adherence to fast track** examination
- Fast processing of cases of **substantiated third party observations**
- Priority to **opposition first actions**
- **Finish** already started examination files **before starting new** cases
- Backlog of searches prior to 1/7/2014 being gradually reduced

ECfS – all new searches with opinion are now out after 6 months



- Graph shows priority 1 backlog, 1 file per examiner is the virtual minimum

ECfS timeliness – PCT Chapter I



ISRs issued on time for A1 publication:

- 2015 : 89,8 %
- Q1-Q2 2016 : 94,2 %

ISRs issued on time under Rule 42 PCT:

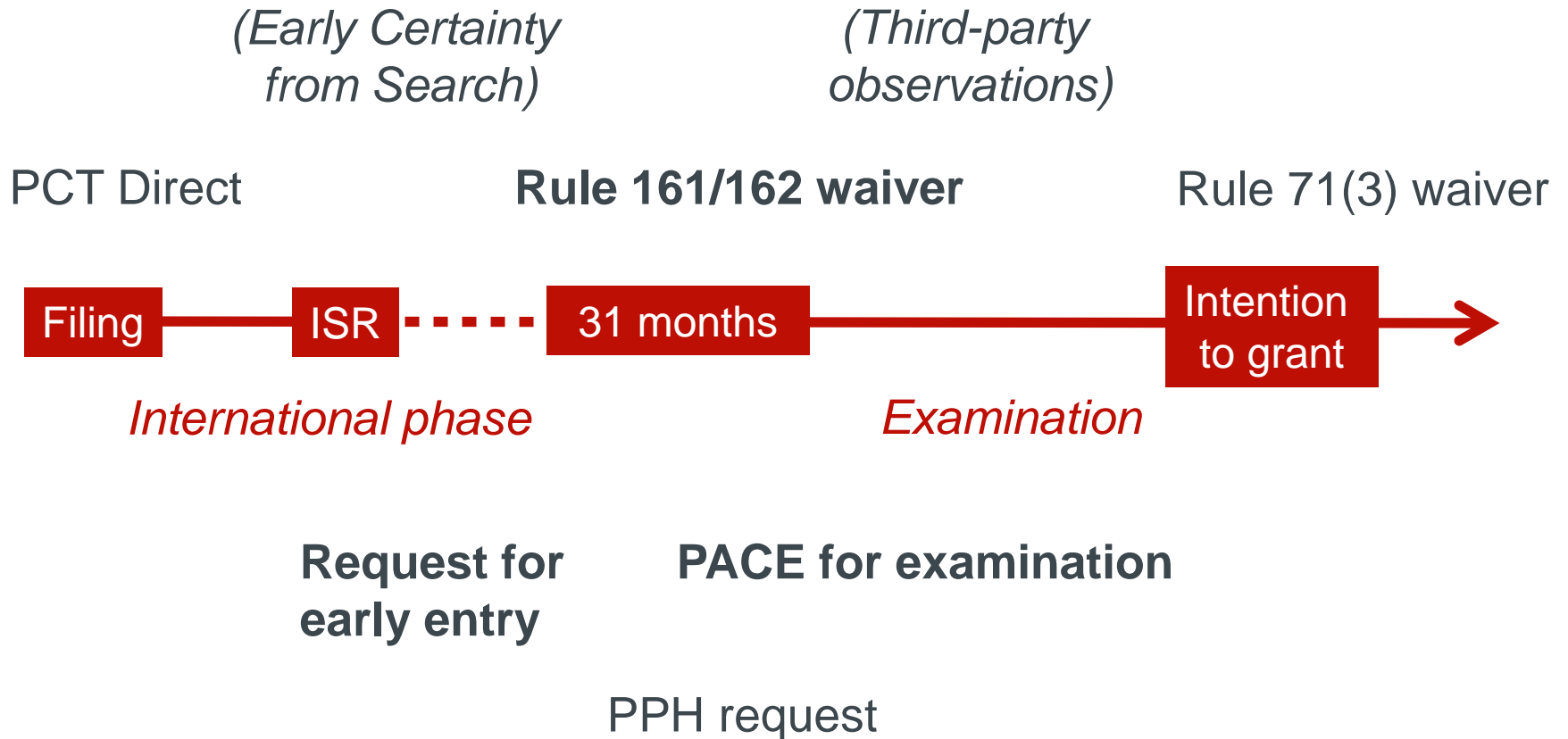
- 2015 : 64,4 %
- Q1-Q2 2016 : 73,1 %

At the EPO we identified around 9% of non-unity cases which may not be easily processed within the 3 m time limit under Rule 42 PCT !

What is next? Early Certainty across all processes

- Early Certainty from ... **Search** **ECfS**
 - Prior art search and written opinion within **6 months**
- Early Certainty from ... **Examination** **ECfE**
 - Grants (up to IGRA) on average within **12 months**
- Early Certainty from ... **Opposition** **ECfO**
 - Standard Opposition within **15 months**

Recap: early processing and other ways of acceleration **(EPO = ISA)**



Recap: early processing and other ways of acceleration **(EPO ≠ ISA)**

Rule 161/162 waiver

Rule 70(2) waiver

(Third-party observations)

(Early Certainty from Search)

Rule 71(3) waiver



International phase

Supplementary search

Examination

Request for early entry

PACE for search

PACE for examination

PPH request

EPO Global Dossier service

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Application No. or Publication No./20110001205.X

Issue No.:

Applicant or Patentee: Who is granted the invention?/Who is the

Title of Invention: For system and the method that reduce the need that the Waterwater moment equipment produced

The First Office Action
(PFI Application Entering the National Phase)

1. Upon the request of substantive examination of the applicant, in accordance with Article 26(1) of the Patent Law, the State Intellectual Property Office proceeds the substantive examination for the above-mentioned application for a patent for invention.

2. In accordance with Article 35.2 of the Patent Law, the State Intellectual Property Office proceeds to examine the above-mentioned application for a patent for invention on its substance on the day 10/11/2011.

3. The applicant requests on the basis of:

3. Upon examination, the applicant submitted to the applicant on _____ shall not be accepted for not in conformity with Rule 26.1 of the Implementing Regulations of the Patent Law.

4. Examination is proceeded on the basis of Chinese document or the Chinese translation of the original filing international application.

5. Examination is proceeded on the basis of the following applicant documents:

6. The following reference documents are cited in this Office Action/the serial number of which will be used to:

No.	Document number or Document title	publication date (or application date of the reference application)
1	US 2002254744A1	2002/06/12
2	US 2001067424A1	2001/06/09

8. Conclusive opinion of the examination:
About the description:

Example from Chinese file wrapper:
First Office Action in the original Chinese language and the translation into English

- IP5 file wrapper portal
- Access to IP5 patent family information
- On-the-fly machine translation from Asian languages to English
- Free of charge
- Via the European Register and Espacenet
- US data since June 2015

The EPO's Global Dossier

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WO2011129660

About this file

Legal status

Federated register

Event history

Citations

Patent family

All documents

Quick help

- [What happens if I click on the "XML" or "ST36" buttons?](#)
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Patent family: WO2011129660

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Type	Publication No.	Date	Type
Patent family member	US8780848 i Global dossier	15.07.2014	B2
	US2013028227	31.01.2013	A1
	Priority number	Date	
	US32430710	15.04.2010	
Type	Publication No.	Date	Type
Patent family member	KR20110115551 i Global dossier	21.10.2011	A
	Priority number	Date	
	US32430710	15.04.2010	
Type	Publication No.	Date	Type
Patent family member	JP2013524719 i Global dossier	17.08.2013	A
	Priority number	Date	
	US32430710	15.04.2010	
	KR2011002721	15.04.2011	
	KR20110035131	15.04.2011	
Type	Publication No.	Date	Type
Patent family member	CN102845117 i Global dossier	26.12.2012	A
	Priority number	Date	
	US32430710	15.04.2010	
	KR2011002721	15.04.2011	
	KR20110035131	15.04.2011	

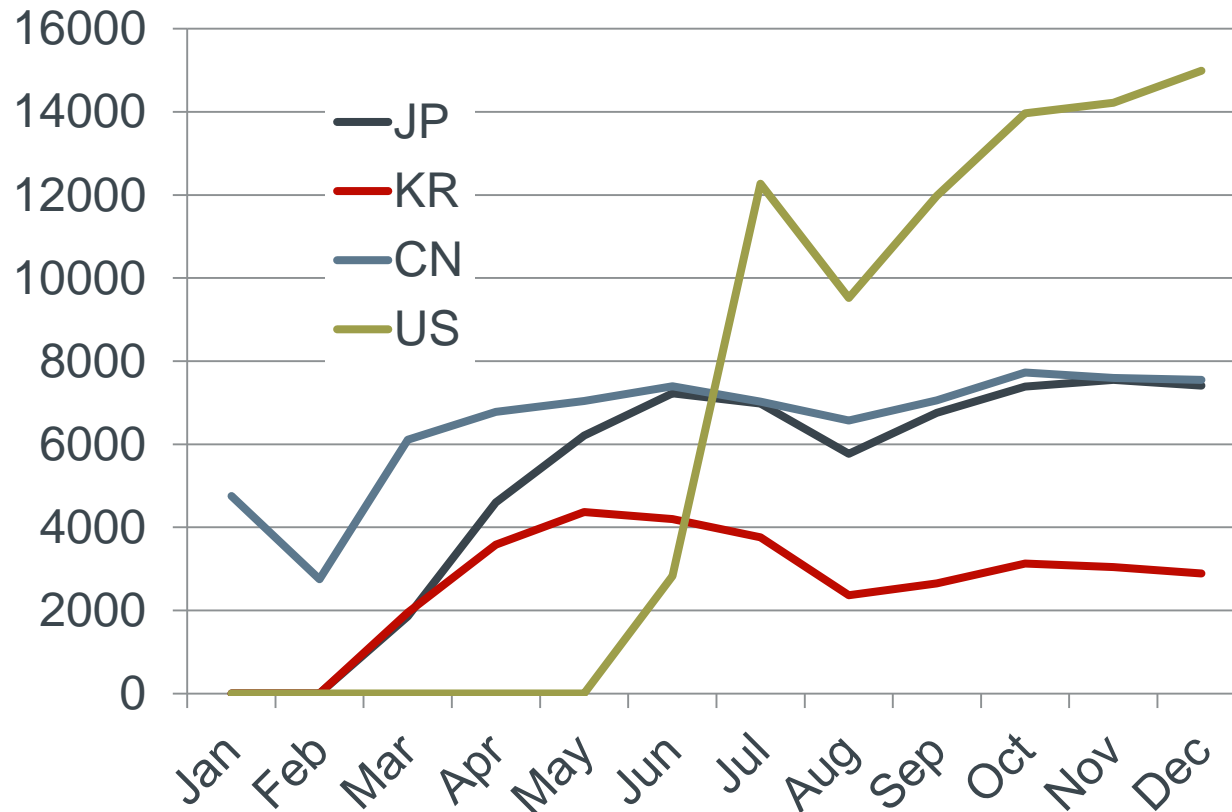
USPTO file wrappers since **06/15**

KIPO and JPO file wrappers since **03/15**

SIPO file wrappers since **06/14**

Usage in 2015/2016

Approx. 40 000 accesses/month



Accesses by unique visitor monthly 2015

+ graph for 2016 usage.

Global Dossier – link to WIPO CASE

- Extension of EPO One Portal Dossier and Global Dossier to WIPO CASE:
 - EPO examiners have access to WIPO CASE (since June 2016)
 - Public access is planned by end of 2016
- Benefit of link to WIPO CASE:
 - **EPO patent examiners** are now able to re-use the search and examination results from offices participating in WIPO CASE. 24 accessing offices and 10 providing offices as of June 2016 (AU, JP, US, CN, KR, IL, CA, BRN, UK, WIPO IB).
 - with the agreement of participating patent offices, external patent **users** will be able to view the file wrappers of an increasing number of patent offices

Information on PCT procedures before EPO

- All PCT related information of the EPO e.g. Decisions of the Council or of the President, Notices of the EPO, Guidelines of the EPO, case law

=> <http://www.epo.org/pct>

- Detailed overview of the PCT procedures before the EPO :
=> "Euro-PCT Guide 2016" (January 2016)

<http://www.epo.org/applying/international/guide-for-applicants.html>



Thank you for your attention!

Questions :

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