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PCT procedure before the EPO as receiving Office and as International Authority



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EPO as receiving Office

Overview

- EPO as receiving Office
 - Conditions for selection RO/EP
 - PCT Direct service
 - Address for correspondence
 - Representation in case of non-European applicant
 - Fee payment methods

Conditions for 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 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 for selection of RO/EP (3)

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

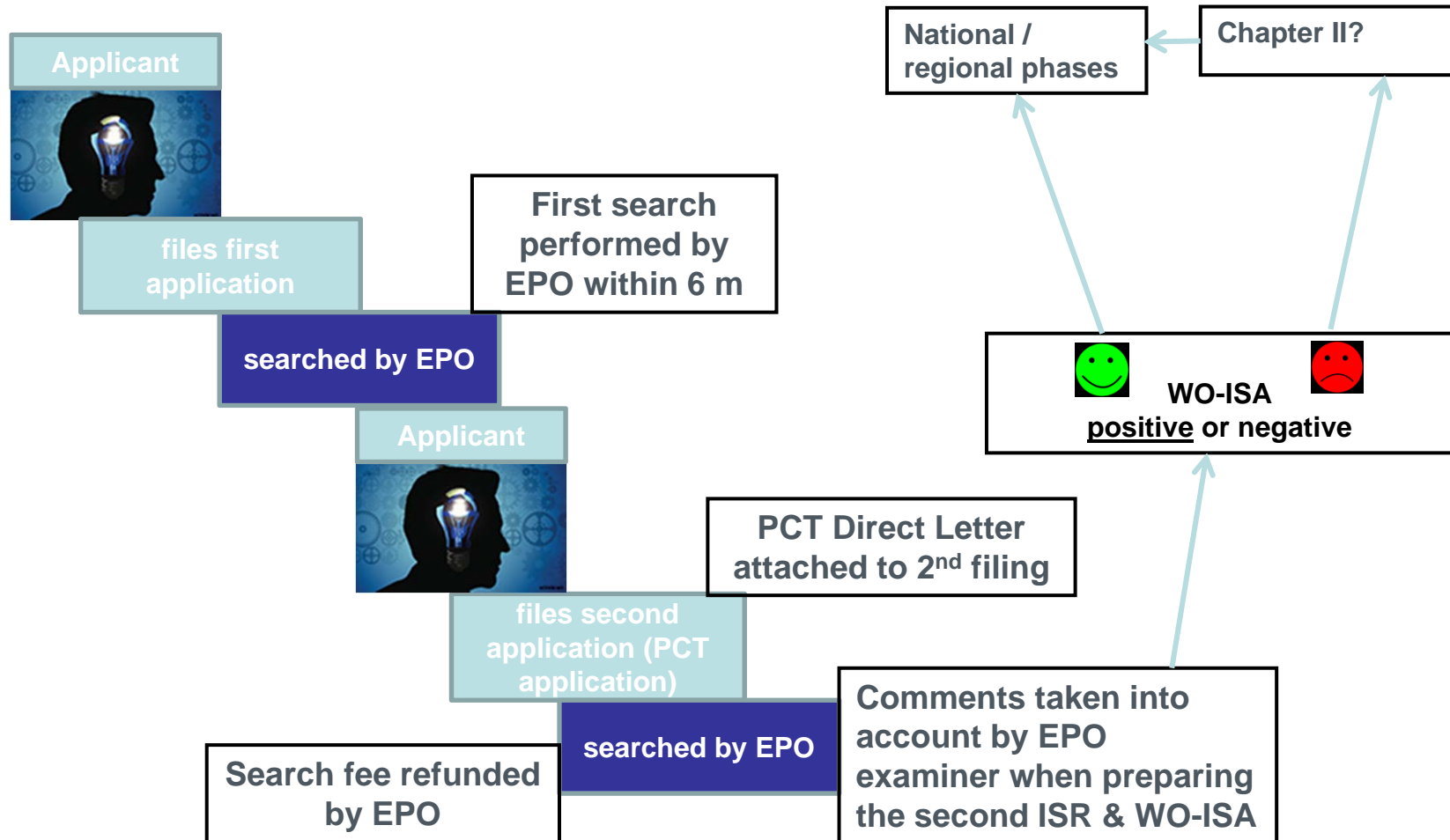
- applicants residing on such territories must ensure that they are entitled to file an international application with the EPO as receiving office (criteria: nationality)
- all PCT applicants wanting to benefit from protection in these territories must first verify if this protection can be obtained thanks to a national patent (e.g. validation of UK patent)

See OJ EPO 2014, A.33

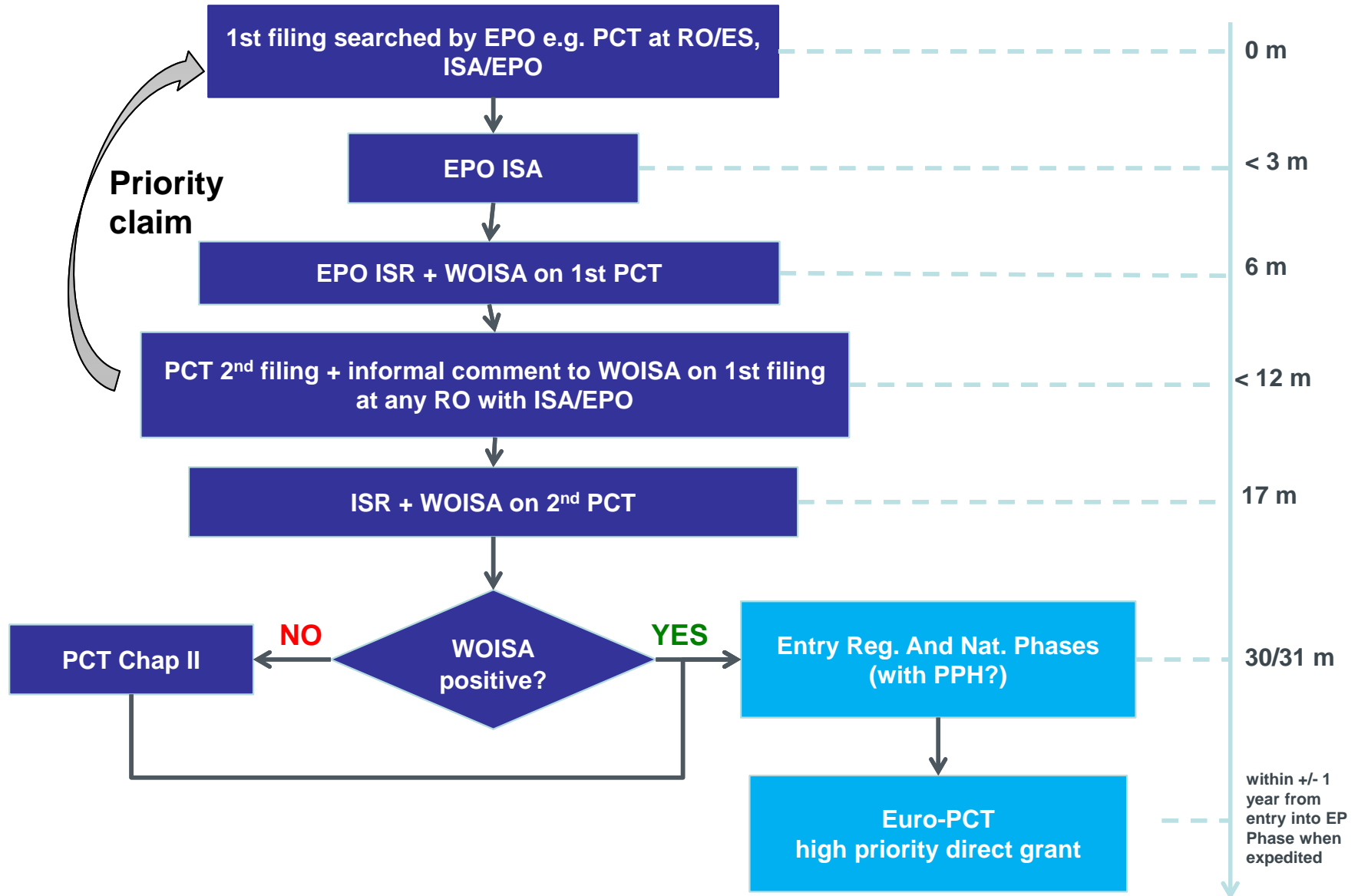
PCT Direct service (1)

- **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**); since April 2017 reference may be made to PCT letter (see **EPO OJ 2017, A21**)

PCT Direct service (2)



PCT Direct service (3)



Address for Correspondence (AfC) RO/EP (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) RO/EP: current practice (2)

- In the **international phase**, if no agent 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) RO/EP: 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

Fee payment methods at the EPO (1)

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

Fee payments to EPO bank account 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:

- Debit order for individual fees, and
- Automatic debit order.

- **Credit cards:** as from 01.12.2017

Secure, easy and flexible web-based service for paying fees

Fee payment methods at the EPO (2)

Credit card, in addition to deposit account and bank transfer

Registration with an email address and password, no smart card authentication needed

Conditions of use/functionalities

- MasterCard and VISA cards accepted
- Payment in EUR
- Payment for multiple applications possible in one go, however, no possibility to upload a batch payment file
- Payment history functionality available
- No refunds to credit cards, at least initially

Decisive date of payment: date on which the credit card transaction is approved by the acquirer and indicated in the transaction confirmation

EPO as International Authority

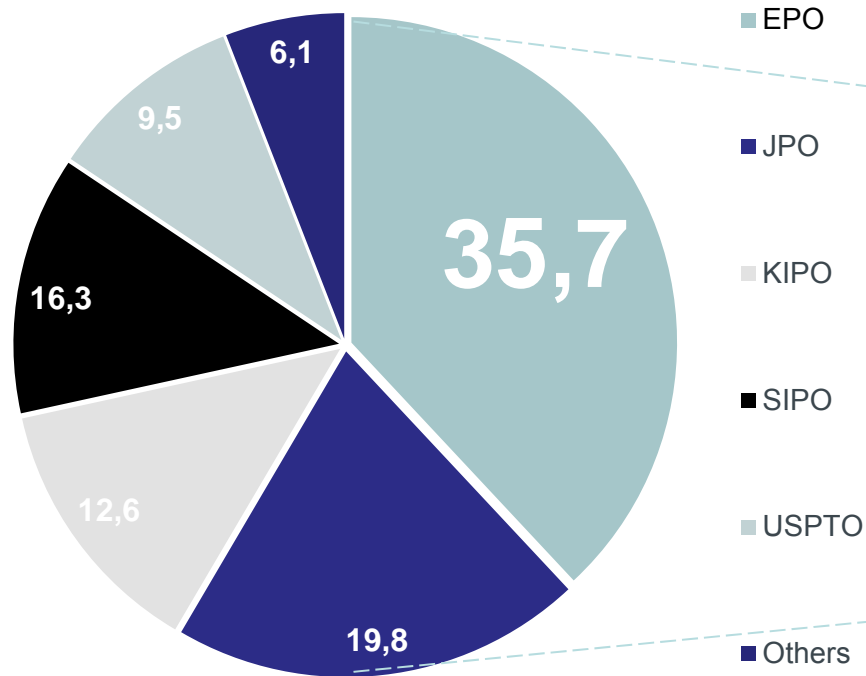
Overview

- EPO as International Authority
 - EPO as ISA
 - Pilot on search strategies
 - Provisional opinion in cases of non-unity (POPS)
 - Collaborative search and examination
 - Short advice on sequence listings
 - EPO as SISA
 - EPO as IPEA
 - Second written opinion in PCT Chapter II
 - Top-up search in PCT Chapter II
 - Positive IPER: Euro-PCT phase

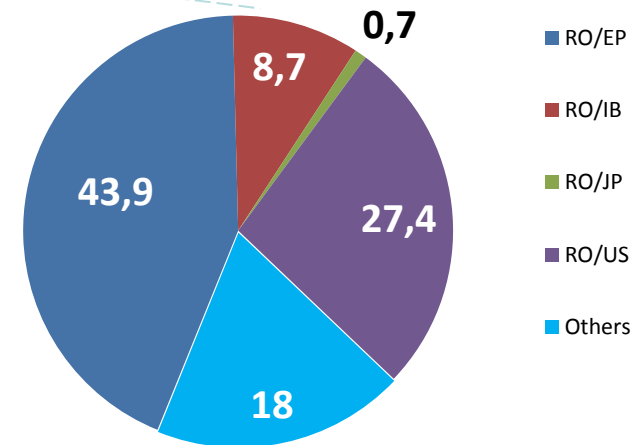
EPO as ISA in 2016

The EPO ranks **1st in the world as ISA**, approx. 80.000 ISRs established in 2016 (**35,7% of total**)

ISRs established in 2016 (%)



Origin of Search Copies received by ISA/EP in 2016 (%)



EPO as ISA: our work

Competence

- When RO has specified the EPO as ISA
- Some exceptions: CN, KR, AU, CA

One standard for all searches at the EPO

- Search reports either in EN, FR or DE
- Highest quality including Asian prior art

Written Opinion

- Thorough non-binding opinion on patentability
- Equivalent to the European search opinion (ESOP)

EPO as ISA: latest developments

- **International search fee** charged by EPO=ISA frozen at EUR 1.875 since 2012 and at least up until 2018
- **Improved timeliness:** 95% ISRs in time for A1 publication
- **New services** offered:
 - **PCT Direct** service fully operational and available at all ROs
 - Pilot on “**search strategies**”
 - Provisional Opinion accompanying the Partial Search results in cases of non-unity (**POPS**)

EPO as ISA: pilot on “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 **keywords** 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 31 Dec. 2017.

For further information see: OJ EPO 2015, A86 and OJ EPO 2017, A3

EPO as ISA: Provisional opinion in cases of non-unity (POPS)

Additional service for EPC and PCT applications since 1 April 2017 in case of finding of lack of unity at the search stage

Change of practice: EPO provides a **provisional opinion** on the patentability of the invention first mentioned in the claims together with the invitation to pay additional search fees and the partial search results

The provisional opinion is **for information only** and no reply is required

The provisional opinion accompanying the partial search results is made available to the public via online file inspection

For further information see: OJ EPO 2017, A20

PCT Collaborative Search & Examination (CS&E)

Concept: PCT search and written opinion by the main ISA in collaboration with “peer” ISAs which provide contributions and feedback

Aim: high quality of ISR and WO-ISA, increased legal certainty early on in the procedure

Pilot phases 1 and 2: concept operationally tested by EPO, KIPO and USPTO

Pilot phase 3: CS&E concept will be further developed and tested amongst the IP5 Offices in view of:

- **gauging users’ interest** for a CS&E product
- **confirming expected benefits** for both users and participating Offices
- **setting the basis** for a decision as to the **future of this concept**

CS&E: main features (1)

Collaboration organised according to a clear scheme:

- **provisional** ISR and WO established by the competent ISA
- **supplemented by** or **corrected** according to contributions of “peer” ISAs
- **final** ISR and WO established by the competent ISA

Applicant driven: applications will be **selected by applicants** (limited number of applications per applicant and a broad pool of applicants)

Same number of applications **per competent ISA** (around 100) and **all** collaborating ISAs will contribute to **all** collaborative work products (a total of around 500 files - a sufficient volume for benchmarking)

Language: applications filed in **English and in other languages** (German, French, Asian languages)

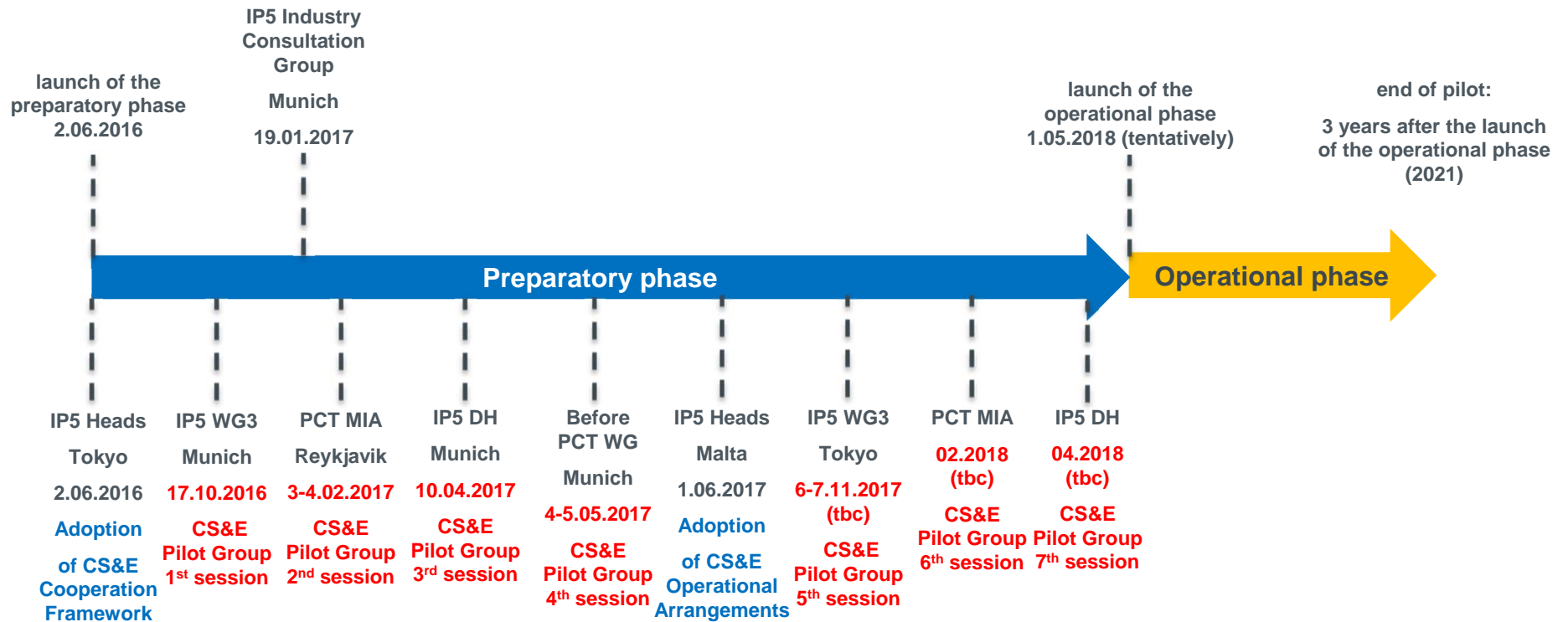
CS&E: main features (2)

A collaboration tool: an IT infrastructure allowing exchanges under the CS&E scheme in a **secure** environment and automated data collection

Fees: during the pilot: standard fee for a PCT Chapter I search at the competent ISA and information about prospective amount of a CS&E fee for a potential regular CS&E product (aggregated amount of the search fees of the collaborating ISAs + an administrative fee)

Participation? Applicants interested to participate in the pilot will need to insert a CS&E Participation Form available on WIPO's website to the submission containing the international application(s) which they wish to be processed in a collaborative manner. A Notice containing more detailed information will be published on EPO's website by year end.

CS&E Pilot - Timeline



SEQL: part of the description or for search purposes?

Important: clear indication in Form RO/101 (Box IX) if SEQL filed on the date of filing

(d) abstract	:		8. <input type="checkbox"/> (only where item (f) is marked in the left column)	
(e) drawings (if any)	:		copy in electronic form (Annex C/ST.25 text file) on	
(f) sequence listing			physical data carrier(s) of the sequence listing, not forming	
part of the			part of the international application, which is furnished only	
description (if any)	:		for the purposes of international search under Rule 13ter	
			(type and number of physical data carriers)	
			
Total number of sheets	:	0	9. <input type="checkbox"/> (only where item (f) (in the left column) and item 8 (above)	
			are marked) a statement confirming that "the information	
			recorded in electronic form submitted under Rule 13ter is	
			identical to the sequence listing as contained in the	
			international application" as filed on paper	

Check whether the SEQL as part of the description are published as such on PATENTSCOPE

If SEQL filed in response to an invitation of the ISA under Rule 13ter PCT (for search purposes only): late furnishing fee to be paid

EPO as SISA (1)

At the option of the applicant: second international search (by another Office)

Irrespective of ISA chosen

At the EPO: same quality of search, fee and advantages as for PCT search
e.g. **dispensation of supplementary European search in EP phase**

Increases legal certainty **before** incurring the costs of entering the national/regional phases

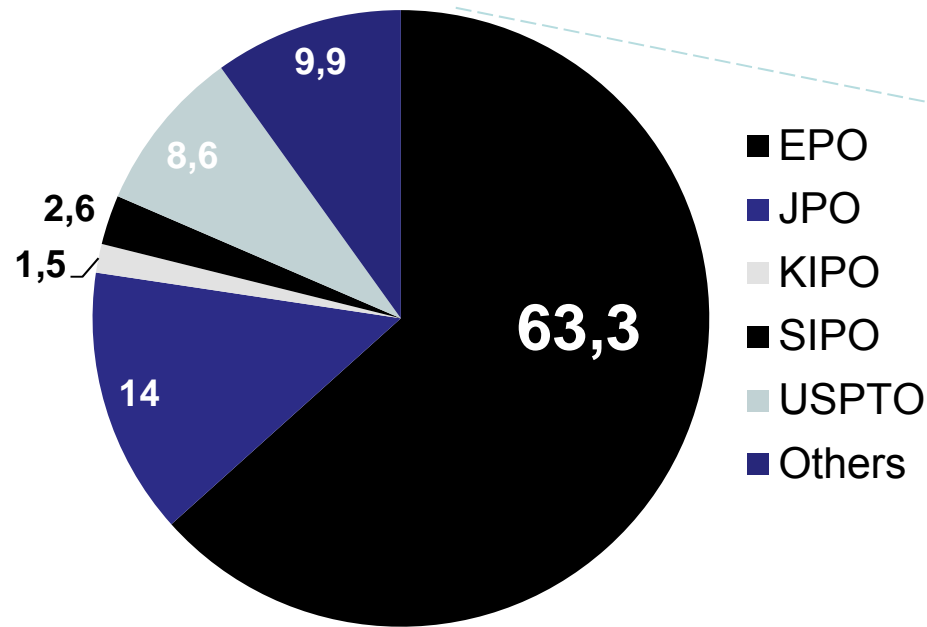
EPO as SISA (2)

- Applicants may be represented before the EPO as SISA by the agent appointed for the international phase.
- EPO as SISA may also search 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 **22 months** from the priority date (NEW as of 1 July 2017: before it was 19 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.

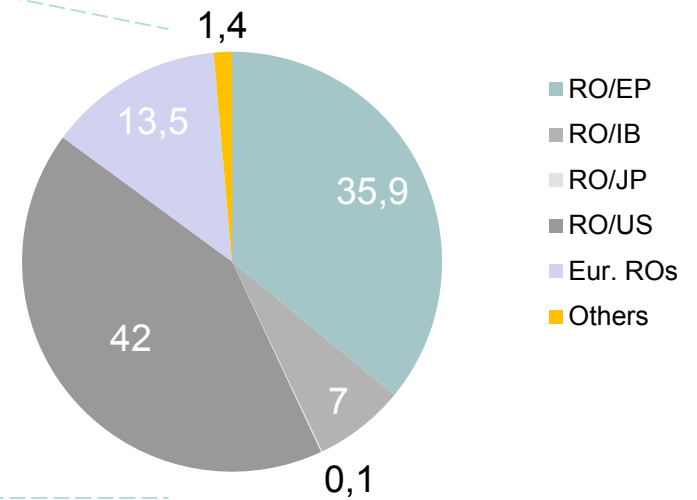
EPO as IPEA in 2016

EPO ranks 1st in the world as IPEA with over 9.100 IPERs established in 2016 (63,3% of total)

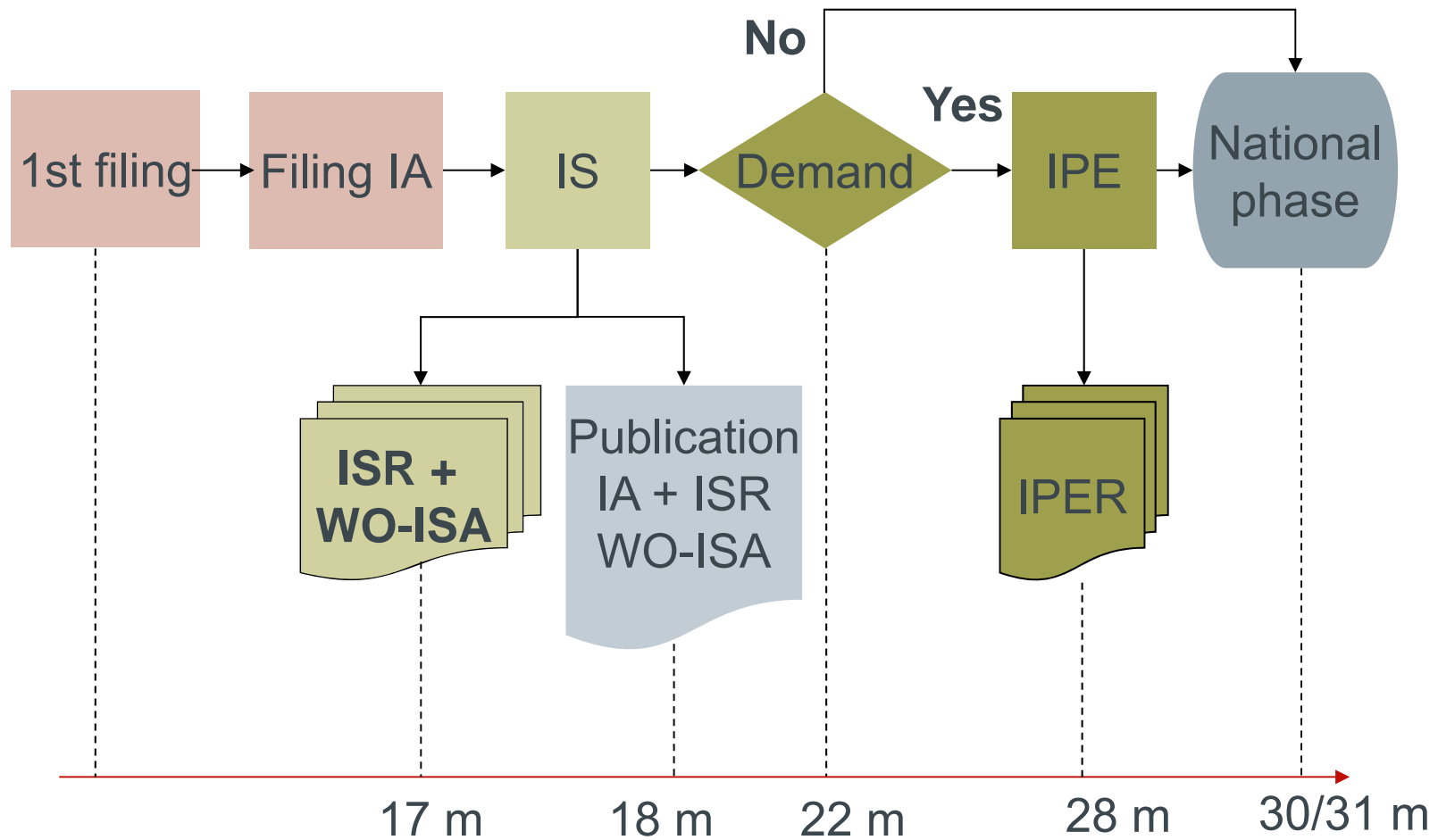
IPERs established in 2016 (%)



Origins of Demands received by IPEA/EP in 2016 (%)



EPO as IPEA: overview of the procedure



Online filing in Chapter II

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

- OJ EPO 2014, A50

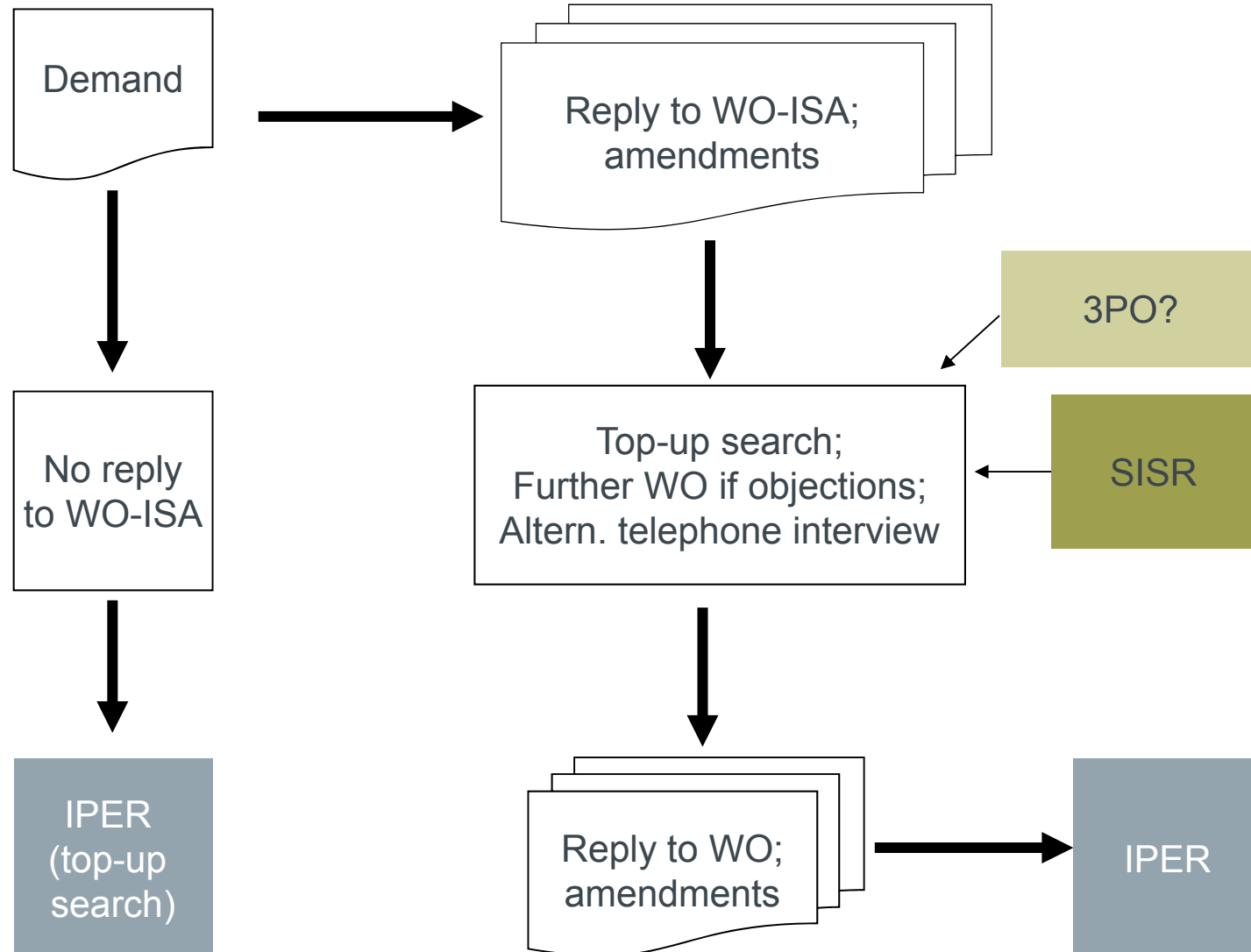
Since 30 June 2014 the demand under PCT Chapter II may be filed online **via the PCT-DEMAND plug-in** in the EPO online filing software

- OJ EPO 2014, A71

NEW Since 1 November 2016 the demand under PCT Chapter II may be filed online **via the ePCT**

- OJ EPO 2016, A78

PCT as IPEA: overview of Chapter II procedure



Second WO in Chapter II PCT (1)

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
-
- For further information see: 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

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

Published in OJ EPO 2014, A57

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

- Reduction in the examination fee (Art. 14(2) RFees)

With a positive IPER

A quick grant before the EPO

- If desired in combination with PACE (accelerated examination)

Strong basis for PPH (e.g. USPTO and JPO):

- Enables accelerated examination

Many DOs rely 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



Thank you for your attention!

Questions :

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