



PCT-Direct and PPH

**& HERRERO
ASOCIADOS**

November 2014 EPO launches PCT service, called "PCT Direct".

Applicant filing an international application claiming priority from an earlier application already searched by the EPO will be able to react to any objections raised in the search opinion drawn up for the priority application.

Streamlines procedure without having to wait for ISR

PCT direct letter (no form) should contain informal comments:

Informal comments are to be understood as arguments regarding the patentability of the claims of the international application and also possibly as explanations regarding any modifications to the application documents, in particular to the claims, in comparison with the earlier application

Upon receipt of a PCT Direct letter, the international application will be processed under PCT Direct if

- (a) the informal comments are filed together with the international application with the EPO or WIPO
- (b) the international application claims priority of an earlier application searched by the EPO (European or national first filing).

PCT Direct letter:

- separate document attached to the international application;
- should be titled "PCT Direct / informal comments"
- clearly identify in the header the application number of the earlier application
- if claims or description differ from those of the earlier application, submit a marked-up copy indicating the differences
- Submit everything as a single document in PDF format (not as ZIP) and indicated by checking Box IX of the PCT request form. For filings in electronic form, the words "PCT Direct / informal comments" should be entered as a remark using the EPO online filing software or the EPO new online filing (CMS)

PCT Direct PCT form RO 101

Sheet No.

Box No. IX CHECK LIST for EFS-Web filings - this sheet is only to be used when filing an international application with RO/US via EFS-Web

This international application contains the following:	Number of sheets	This international application is accompanied by the following item(s) (mark the applicable check-boxes below and indicate in right column the number of each item):	Number of items
(a) request form PCT/RO/101 (including any declarations and supplemental sheets)		1. <input type="checkbox"/> fee calculation sheet	
(b) description (excluding any sequence listing part of the description, see (f), below)		2. <input type="checkbox"/> original separate power of attorney	
(c) claims		3. <input type="checkbox"/> original general power of attorney	
(d) abstract		4. <input type="checkbox"/> copy of general power of attorney; reference number:	
(e) drawings (if any)		5. <input type="checkbox"/> priority document(s) identified in Box No. VI as item(s)	
(f) sequence listing part of the description in the form of an image file (e.g. PDF)		6. <input type="checkbox"/> Translation of international application into (language):	
		7. <input type="checkbox"/> separate indications concerning deposited microorganism or other biological material	
Total number of sheets (including the sequence listing part of the description if filed as an image file)	0	8. <input type="checkbox"/> (only where item (f) is marked in the left column) copy of the sequence listing in electronic form (Annex C/ST.25 text file) not forming part of the international application but furnished only for the purposes of international search under Rule 13ter	
(g) sequence listing part of the description		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 via EFS-Web:	
<input type="checkbox"/> filed in the form of an Annex C/ST.25 text file		10. <input type="checkbox"/> copy of results of earlier search(es) (Rule 12bis.1(a)) ..	
<input type="checkbox"/> WILL BE filed separately on physical data carrier(s), on the same day and in the form of an Annex C/ST.25 text file		11. <input type="checkbox"/> other (specify):	
Indicate type and number of physical data carrier(s)			

Figure of the drawings which should accompany the abstract:

Language of filing of the international application:

Box No. X SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE

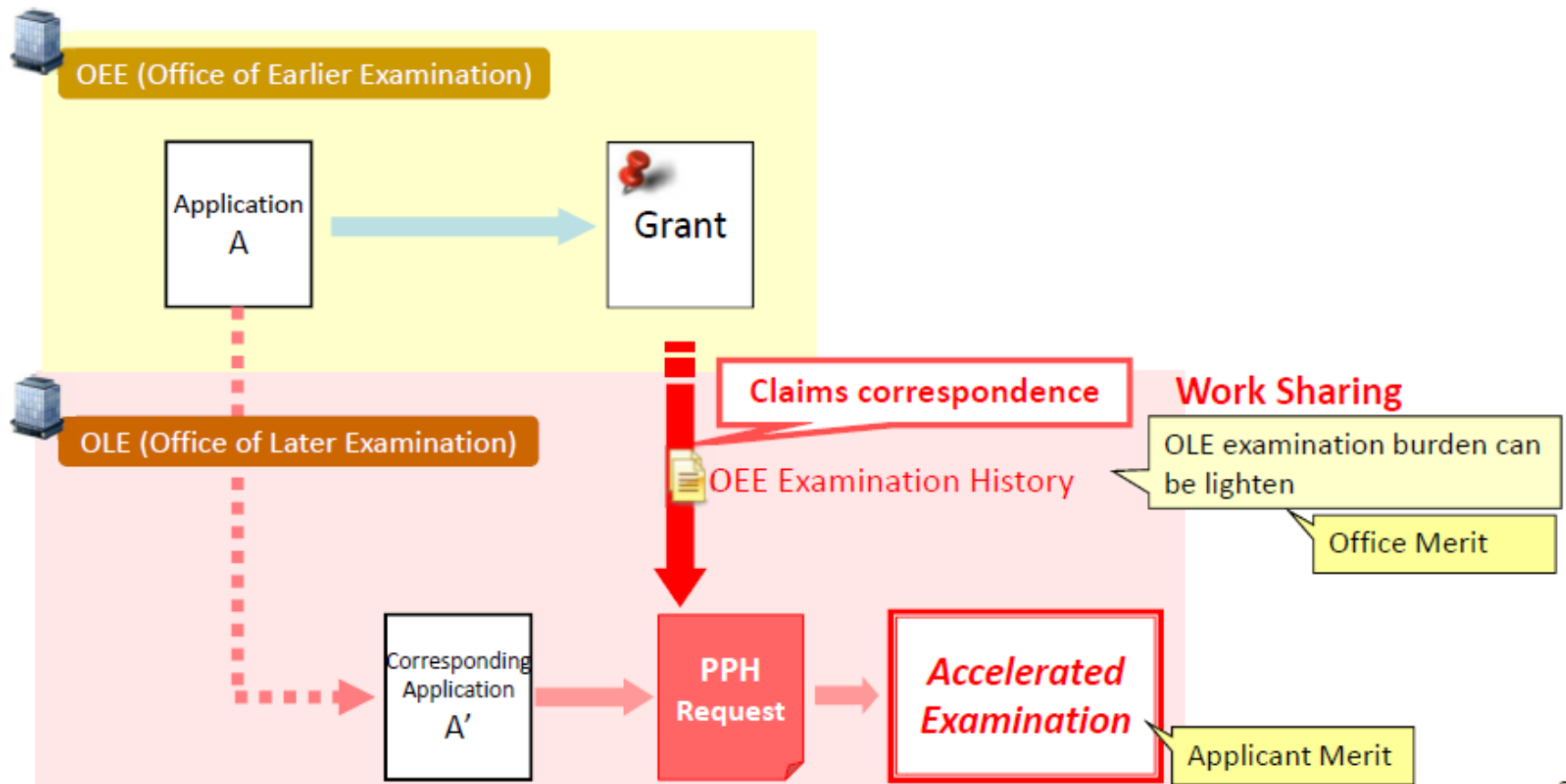
Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the request).

At the EPO as International Searching Authority, the examiner performing the international search will take informal comments filed under PCT Direct into account when preparing the international search report and written opinion

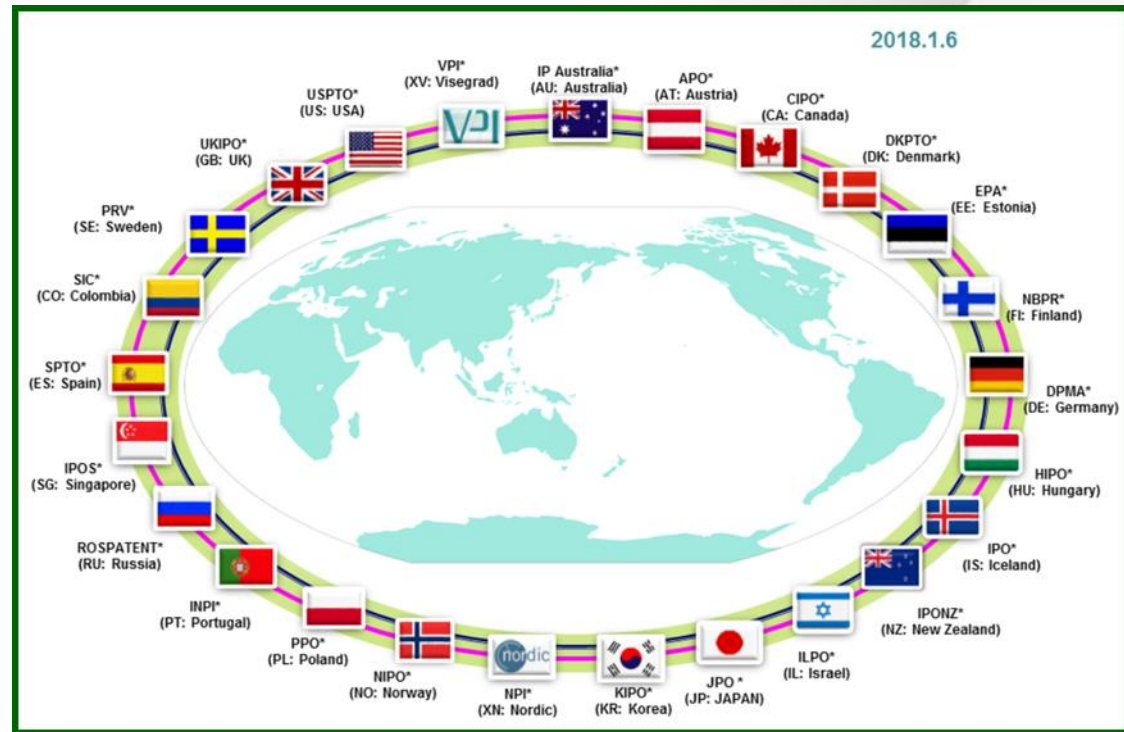
However, the examiner will make no explicit reference to the PCT Direct letter or its content.

Patent Prosecution Highway (**PPH**): set of bilateral and multilateral agreements (Global PPH) among various national patent offices that allow for **accelerating examination** in a given patent office by relying on positive results already obtained in another patent office.

Best used together with CAP (OEPM), PACE (EPO)...



PPH at SPTO (OEPM)



- TR, TW, MX, MA, PE, CN, CO

REQUESTED DOCUMENTATION:

- Copy of all the office actions relevant to patentability
- Both Spanish and English are acceptable as translation language. Machine translations are admissible
- Copy of the claims found to be patentable/allowable by the OEE and translations.
- claims correspondence table must indicate how the claims in the SPTO application correspond to the patentable/allowable claims in the OEE application

- Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the SPTO are of the same or similar scope as the claims in the OEE, or the claims in the SPTO are narrower in scope than the claims in the OEE. In this regard, a claim that is narrower in scope occurs when a OEE claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims).
- A claim in the SPTO which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond. For example, claims to a process of manufacturing a product → product claims that are dependent on the corresponding process claims.

- Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as patentable/allowable in the OEE application.

- Since January 2018: Canada, Israel, Mexico and Singapore
- Australia, Brazil, Colombia, Malaysia, the Philippines, Russia and the Eurasian Patent Office
- And IP5
- The EPO may also terminate the IP5 PPH pilot programme early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the IP5 PPH pilot programme is terminated before 5 January 2020.
- Requested documentation: same as SPTO but in English, French or German
- Substantive examination of the EP application for which participation in the PPH pilot programme is requested has not begun. The examination starting date is visible