Filing PCT applications

EPO User Day – The Hague
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1. The Patent Cooperation Treaty (PCT)

- The PCT is the main tool for applicants seeking patent protection for their inventions in multiple countries

- More than 253 000 PCT applications filed worldwide in 2018

- The EPO is the 4th receiving Office worldwide with approximately 36 700 applications in 2018 (15% of the total)
The PCT now has 152 Contracting States

- Latest additions: Kuwait KW (9 September 2016), Djibouti DJ (23 September 2016) and Cambodia KH (8 December 2016) and Jordan JO (9 June 2017)
2. EPO as receiving Office

- "One stop shop" (RO=ISA=EPO): cost-efficient and accurate upfront handling of PCT applications; quicker processing up to the examiners
- Three accepted filing languages: English, French or German
- Electronic filings using EPO filing tools (Online filing, CMS) or ePCT
- "Safety nets" available at RO/EP: restoration of the priority right, incorporation by reference
Legal requirements to file at RO/EP

- **Competence**
  - One applicant must be national of and/or reside in an EPC State
  - Only filings in English, German or French
  - If RO/EP is not competent: international application (IA) is sent to International Bureau acting as receiving Office (RO/IB) (Rule 19.4 PCT) (date of filing maintained, all fees refunded)

- **Determination of the International date of filing**
  - mandatory elements: applicant, request, description, claim(s)
  - abstract
  - drawings, sequence listing, biological material if needed
The request – Form PCT/RO/101 (1/3)

- **Title**: same as on the first page of the description

- **Applicant's details**: name, address, nationality, residence, designation

- **Inventor's details**: name, address

- **Representation**: professional representative, common representative, address for correspondence
The request – Form PCT/RO/101 (2/3)

- **Designations**: all contracting states

- **Priority claim**: filing date of earlier application, number, country (request for a certified copy only if the EPO was the filing office; restore the right of priority)

- **Declarations**: optional (for the purposes of the national law applicable in one or more designated States)
The request – Form PCT/RO/101 (3/3)

- **Check list** (Box IX of Form PCT/RO/101) allows to identify:
  - documents filed as part of the international application:
    - for international publication by WIPO (document for the entry in national/regional phase for grant)
  - accompanying items:
    - not to be published, only providing additional information (e.g. for search purpose, payment instructions ...)
    - **Pre-conversion archive**

- **Signature**: authorised person to sign the request
Payment of fees (1/3)

- **Payment instructions** can be given
  - when filing the RO101 (Online filing, CMS or ePCT)
  - subsequently by using Online filing PCT-SFD or CMS form 1038*
  - by using Online Fee Payment system (OFP)
  - with credit card fee payment offered at the EPO website

- **Debiting a deposit account** held with the EPO
  - since 1 November 2017 debit order must always be sent in an electronically processable format

* payment instructions to be given within the fee payment functionality in the electronic form, **not** by attaching a form 1010
Payment of fees (2/3)

- PCT-DECA

Since **01.04.2015**, holders of a **deposit account** with the EPO may have their account **automatically debited** on the basis of an **automatic debit order** for a specific application, in the **international phase**.

From the date of receipt of the request for automatic debit order, the correct amounts of the fees are automatically debited **on the last day of the time limit for payment**.
Payment of fees (3/3)

New: payments by credit card as of 1.12.2017

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

Conditions of use / functionalities

- MasterCard and VISA cards accepted
- Payment in EUR
- Payment for multiple applications possible
- Payment history functionality available
- No refunds to credit cards, at least initially
New refund procedures at the EPO

Since 1 April 2019 new fee refund procedures

- possibility to indicate in online forms (PCT/RO/101, PCT-SFDs and PCT-DEMAND) refund instructions to any deposit account held with the EPO

- no refund instructions indicated → the EPO will invite to claim refunds to a bank account via Online Fee Payment Portal

- Fees will no longer be refunded by cheque.

See OJ EPO 2019, A26
Legal requirements for correcting an IA (1/2)

- In case of missing element/part: possibility to complete the IA
  - same day
    International date of filing can be maintained,
  - later filing
    the date of receipt of the documents will be the new date of filing

- Possibility to complete the IA under strict conditions for incorporation by reference (Rule 20 PCT) without affecting the international filing date
  - missing part(s) or the missing element were completely contained in the priority document.
Legal requirements for correcting an IA (2/2)

- **Defect(s) of certain elements** found by RO/EP under Rule 26 PCT
  - invitation to correct is sent by RO/EP
  - 2 month time limit to file corrections

- **Rectification of obvious mistakes** under Rule 91 PCT
  - within 26 months from priority date
  - request for rectification is to be sent to the “competent Authority”
  - RO/EP, ISA/EP or IPEA/EP may invite the applicant to request rectification under R. 91 PCT

- **Priority period** already expired on the date of filing: a request for restoration can be filed and relevant fee paid (Rule 26bis .3 PCT)
Subsequently filed documents (1/2)

- **Means of filing** documents subsequently at EPO
  (select relevant capacity: RO, ISA, SISA or IPEA)

  - Online filing: PCT-SFD
  - CMS: EPO form 1038 can be created from an already CMS filed PCT application
  - WFF
  - ePCT: upload documents
Subsequently filed documents (2/2)

- Exceptions
  - priority documents issued on paper (the original document is still needed)
  - sequence listing if the IA is filed on paper (to avoid mix mode, not accepted at EPO)
3. EPO as International Searching Authority (ISA) (1/3)

- **Competence**
  - RO needs to specify the EPO as ISA (currently: 143 Offices, only a few exceptions: United Arab Emirates, Australia, Canada, China, Dominica, Saint Kitts and Nevis, Democratic People's Republic of Korea, Republic of Korea, Papua New Guinea)

- **One standard for all searches at the EPO**
  - Highest quality including Asian prior art and use of standards
EPO as International Searching Authority (ISA) (2/3)

- **Written Opinion**
  - Non-binding opinion on patentability equivalent to the European search opinion

- **Improved timeliness**
  - 97% (2017) = A1 publications

- **Information Sheet on Search Strategy**
  - Established by EPO under both PCT and EPC annexed to search reports
EPO as International Searching Authority (ISA) (3/3)

- Search fee (fully or partially) reimbursed
  - When the earlier search was already performed by the EPO

- Provisional Opinion or Preliminary Search results in cases of non-unity
  - Additional service for EPC and PCT applications since 1 April 2017 in case of finding of lack of unity at the search stage
PCT Direct (1/5)

PCT-Direct – entry in to force 01.11.2014*

- When filing a PCT application, claiming priority from a 1st EP filing or 1st national filing searched by the EPO, the applicant has the possibility to draft International application documents based on reply to the 1st search opinion established by the EPO by rebutting objections and/or explaining the meaning of amendments

- documents supporting the PCT-Direct request must be filed together with the RO101

*EPO OJ 2014, A89 14
PCT Direct (2/5)

- Opportunity to comment on objections raised in earlier search opinion → increases likelihood of receiving positive WO-ISA

- Can expedite the European phase with a quicker grant → possible save on renewal fees

- Relevant for applicants filing a PCT application and claiming priority from a 1st filing searched by the EPO
"PCT Direct" is a cost-effective procedure providing a solid basis for proper and early decision making.

First filing by EPO (EP, PCT, national)
- search report and written opinion issued within 6 months

Second filing if the EPO as ISA (PCT)
- with 'PCT Direct letter', explaining any changes made and addressing any objections raised in written opinion for first filling
- search report with written opinion more likely to be positive!

This service is free of charge and open to all ROs which have selected the EPO as ISA.
PCT Direct (4/5)

Classical PCT – *international* phase
- filing of international application claiming EPO searched priority
- ISR based on documents as filed
- ISR most likely to be negative

PCT-Direct – *international* phase
- filing of international application based on search result of EPO searched priority
- ISR taking into consideration changes based on priority search results
- ISR most likely to be positive
PCT Direct (5/5)

**classical PCT – regional phase**
- entry into the regional phase with *negative* international search
- obligation to file amendments/comments before examination (R161 EPC)
- Grant of a patent after 4-6 years (average)

**PCT-Direct – regional phase**
- entry into the regional phase (most likely) with positive international search
- possibility to waive R161 and any further R71(3)* EPC communication
  *as per 01.07.2015
- Grant of a patent possible after 3 years**
  **best case scenario
PCT Collaborative Search & Examination (CS&E) (1)

**Framework:** IP5 Cooperation Framework 2016; Operational Arrangements 2018

**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
PCT Collaborative Search & Examination (CS&E) (2)

- **Duration**: 5 Years
  - Pilot phases 1 and 2: preparatory phase (2016-2018)
    concept operationally tested by EPO, KIPO and USPTO
  - Pilot phase 3: operational phase (2018-2021)

- **Monitoring**: CS&E Pilot Group runs the IP5 project under EPO lead

- **Status**: Operational phase launched on 1 July 2018
PCT Collaborative Search & Examination (CS&E) (3)

- Pilot phase 3: CS&E concept is 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
  - Fees: during the pilot: standard fee for a PCT Chapter I search at the competent ISA
CS&E - process model

**PCT ISA**
- checks CS&E criteria fulfilled, formalities examination, confirms acceptance

**Product CS&E International Search and Written Opinion**

**Evaluation**
- CS&E metrics will be monitored over the lifetime of the 500 applications

**Collaborative Search & Examination (CS&E)**
- Applicant driven
- 100 files per ISA over 2 years

**ISA Examiner (Step 1)**
- Carries out search, prepares provisional opinion and provisional search report

**ISA Examiner (Step 2)**
- Produces final International Search Report and Written Opinion

**“Peer” examiners 4 other IP5 Offices**
- Contribution based on ISA provisional opinion and search report

**Expected Benefits**
- Earlier information from all IP5 offices
- All offices contribute to product quality
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 int. application(s) which they wish to be processed in a collaborative manner.

See EPO OJ 2018, A95
4. EPO as International Preliminary Examining Authority (IPEA)

- **Optional procedure** providing several opportunities to amend the application and bring it in order in consultation with the examiner.

- **International preliminary examination report**
  - 'Top-up' search performed prior to examination
  - Third-party observations sent by WIPO
  - Consultation by telephone and second written opinion

- **Advantages**
  - 50% reduction of European examination fee (75% as from 1 April 2018) if the EPO acted as IPEA
  - Multiplying effect: one set of amends valid for all national phase entries
Legal requirements for filing the PCT Demand with IPEA/EP

- Competence of IPEA/EP
  Art. 31(6)(a) PCT:
  - Filing a Demand with the competent IPEA

- When is the EPO competent IPEA
  - EPO or any European ISA (at present: AT, ES, FI, SE, TR, XN and XV) acted as (S)ISA
Formal requirements of the PCT Demand (1/2)

- Demand (PCT/IPEA/401) needs to be filed
  - 3 months from date of transmittal of International Search Report
  - 22 months from priority date - whichever expires later (Rule 54bis.1(a) PCT)

- including:
  - payment of fees
  - ISR and the WO-ISA are available
  - indication of the basis on which the IPE is wished on:
    - e.g. possible amendments under Art. 19 PCT and/or Art. 34 PCT with the letter explaining the amendments
  - any statement or arguments
Formal requirements of the PCT Demand (2/2)

- **Means of filing:**
  - Online filing: PCT-DEMAND
  - CMS: EPO form 1038
  - ePCT: action - Demand

- **If filed after time limit**
  - Demand is considered as not submitted (Rule 54bis.1(b) PCT)
  - Notification (Form PCT/IPEA/407) to applicant and IB
PCT Rule Changes as from 1 July 2019

Amendment to PCT Rule 69.1(a)

- Allows the IPEA to start immediately the international preliminary examination when it is in possession of the demand, relevant fees, ISR and written opinion, as opposed to having to wait until expiration of the time limit under Rule 54bis.1(a) (unless the applicant requests postponement)

- Effective as from 1 July 2019 for applications in respect of which a demand for international preliminary examination is made on or after that date
Effect on European phase processing

If the IPEA/EP has prepared an International Preliminary Examination Report (IPER),

- this has an effect on the examination fee for the European phase: 75% reduction (Art. 14(2) RRF)

- there is a need/an opportunity to respond to the IPER on entry into the European phase (R. 161(1) EPC) (only if the EPO has also prepared the international search report)
5. An EPO applicant friendly fee policy

No inflation-based biennial fee adjustment for 2018-2020

<table>
<thead>
<tr>
<th>Service</th>
<th>Current Fee</th>
<th>New Fee</th>
<th>Reduction</th>
</tr>
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<tbody>
<tr>
<td>PCT search</td>
<td>1,875 €</td>
<td>1,775 €</td>
<td>-5% / 100 €</td>
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<tr>
<td>PCT preliminary examination</td>
<td>1,930 €</td>
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<tr>
<td>Examination European phase</td>
<td>1,960.25 €</td>
<td>1,830 €</td>
<td>-50% / -456.25 €</td>
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</tbody>
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PCT fee reduction measures as of 01.04.2018
Thank you for your attention! Any questions?
Thank you for your attention!

For more information, you are invited to consult the "Euro-PCT guide" provided by the EPO at:
www.epo.org

For any questions or queries, please contact:
international_pct_affairs@epo.org