Entry into the European phase
Processing your application before the EPO as designated Office
Presenting today

Reinoud Hesper (NL)
Head of Department, Patent Law: Filing & Euro-PCT
Directorate Patent Law
EPO Munich
Presenting today

Elke von Brevern (DE)
Expert in PCT Affairs Department
EPO Munich

At the EPO since 2008

Formalities Officer (2008-2010), Online Filing
Application Manager (2010-2015) at the EPO

Coordinator of PCT-related projects implementation at the EPO
Entry into the European phase

Agenda

I. Basic aspects and principles
II. Requirements for entry into the European phase
   • “Must” requirements
   • “Should” requirements
International v. National phase

- International phase
  - 30 months from priority/filing

- National phase
  - proceedings before national office as designated/elected Office
  - national phase before the EPO = European phase

Art. 22(1) PCT
What does entry into the European phase mean?

There is no such thing as THE act of entry into the European phase

Entry requires fulfilling certain requirements within 31 months of priority/filing (extra one month)

Otherwise application is deemed withdrawn

Art. 22(1),(3)
Art. 39(1)(a),(b) PCT
Rule 159 EPC

Art. 24(1)(iii) and 39(2) PCT
Rule 160 EPC
Processing prohibition

§ Until expiry of 31 months from the filing/priority date, the EPO as designated/elected Office is prohibited from processing the application

§ Early processing is also possible before 31 months but requires explicit request
Question 1

If early processing is requested, can the applicant fulfil the entry requirements until the expiry of the 31 month period?

- yes  
- no
Question 1

Solution

No. For a request for early processing to be effective, the applicant must comply with the requirements stipulated in Rule 159(1) as if the 31-month time limit expired on the date he requests early processing.

† The correct answer is: “no”
Interaction between PCT and EPC

- Prevalence of the PCT
- Supplementary application of the EPC
- Equal service levels

Art. 27 PCT
Art. 150(2) EPC

Art. 150(2) EPC

Art. 11(3) PCT
Art. 153(2) EPC
EPO Form 1200 for entry into the European phase

- Recommended way of requesting entry

- Contains i.a. precrossed request for examination, possibility to indicate translations

- Fee sheet makes fee calculation easier, especially if page fees are payable

- Notes to Form 1200: instructions on how to use the form, which options to select
Requirements for entry into the European phase

**Must** requirements
- non-compliance ➕ loss of rights

**Should** requirements
- non-compliance ➕ no automatic loss of rights
- e.g. further time limit instead

EPO Guidelines E-IX, 2.1.1
**Must requirements**

Always
- Pay EPO’s filing fee
- Pay the designation fee
- Request examination and pay the examination fee

Always, if applicable
- Pay the additional/page fee if > 35 pages
- Pay the search fee if EPO was not ISA or SISA
- File a translation if IA was not published in EN/FR/DE

Non-compliance ‡ application deemed withdrawn

Rule 159(1)(c) EPC
Rule 159(1)(d) EPC
Rule 159(1)(f) EPC
Rule 38(2) EPC
Art. 2(1).1a RFees
Rule 159(1)(e) EPC
Rule 159(1)(a) EPC
**Must: Filing fee**

- **Art 22 and 39 PCT allow a “national fee”**
  - must pay within the 31 month time limit
  - “filing fee” is imprecise
  - entry
  - filing

- **Two parts**
  - basic fee
  - page/additional fee if > 35 pages

- **Non payment**
  - application deemed withdrawn
  - further processing

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Euro-PCT Guide, point 5.7  
EPO Guidelines E-IX, 2.1.4  
Rule 159(1)(c) EPC  
Art. 78(2) EPC

Rule 38(2) EPC  
Art. 2(1).1a RFees

Rule 160(1) EPC  
Art. 121 EPC
**Must: Designation fee**

- The flat designation fee must be paid within
  - 31 months from the priority/filing date, or,
  - 6 months of publication of the ISR or the declaration under Article 17(2) PCT
  - whichever period expires later

- Non-payment is deemed withdrawn
  - further processing is available

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Euro-PCT Guide, point 5.8
Rule 159(1)(d) EPC
Art. 79(2) EPC
Rule 39 EPC
Art. 153(6) EPC

Rule 160(1) EPC
Art. 121 EPC
**Must:** Request for examination and fee

- The request for examination must be filed within
  - 31 months from the priority date, or,
  - 6 months from publication of the ISR or the declaration under Art. 17(2)(a) PCT
  - whichever expires later

- Request valid only if the examination fee is paid

- If not filed and paid † deemed withdrawn
  - but further processing is possible
  - two further processing fees may be payable

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EPO Guidelines E-IX, 2.1.4  
Euro-PCT Guide, point 5.10  
Rule 159(1)(f) EPC  
Rule 70 EPC  
Art. 153(6) EPC  
Art. 94 EPC  
Rule 160(1) EPC  
Art. 121 EPC  
EPO Guidelines E-VII, 2
Must, if applicable: Search fee

- Search fee payable within 31 months if supplementary European search report has to be drawn up

- Supplementary European search report must be drawn up if EPO did not act as ISA or SISA
  - ISR and its publication take place of the ESR
  - only formal not substantive role of ISR is recognized

- No supplementary European search if EPO acted as ISA or SISA ‡ no search fee payable

- Non-payment ‡ deemed to be withdrawn, but further processing is possible

Guidelines E-IX, 2.1.4
Euro-PCT Guide, point 5.9
Rule 159(1)(e) EPC

Art. 153(7), first sentence, EPC

Art. 153(6) EPC

Art. 153(7), last sentence, EPC
Question 2

Does the payment of a search fee upon entry into the European phase depend on whether the EPO was IPEA?

- yes  "  no
Question 2

Solution

No. A search fee is payable if the EPO was not ISA or SISA. Whether the EPO was IPEA is irrelevant.

The correct answer is: “no”
**Must, if applicable: Translation**

- All application documents for the EP procedure must be in one of the three EPO languages.

- International application not published in official EPO language ‡ translation necessary ‡ language of translation becomes language of proceedings.

- Consequences of no translation:
  - original description and claims ‡ deemed withdrawn
  - other docs ‡ two month time limit then loss of rights

- Redress
  - Further processing is available
  - Re-establishment of rights

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Art. 153(4) EPC  
Art. 14(1) EPC  
Guidelines E-IX, 2.1.3  
Euro-PCT Guide, point 5.5

Arts. 22 and 49 PCT  
Rule 159(1)(a) EPC  
Rule 49.5 PCT  
Article 14(3) EPC

Rule 160(1) EPC  
Guidelines E-IX, 2.1.3
**Should: Specify application documents**

- Indicate the basis of the Eur. phase processing

- Amendments may be filed upon entry into Eur. phase
  - until expiry of 6 month time limit set in Rule 161/162 EPC communication
  - file at expiry of 6 months = basis for search/exam
  - Rule 161/162 EPC communication can be waived

- No amending beyond disclosure of IA as filed

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**Rule 159(1)(b) EPC**

**Arts. 28 and 40 PCT**

**Guidelines E-IX, 2.1.1**

**Rules 161 and 137(2) EPC**

**Euro-PCT Guide, point 5.4.011 et seq.**

**Guidelines E-IX, 4.3.2**

**Art. 123(2) EPC**
**Should: Claims fees**

- Payment within the 31-month time limit

- 6 month “grace period”
  - from Rule 161/162 communication
  - invites to amend application and pay claims fees
  - claims fees recalculated based on amendments

- Expiry of time limit in Rule 161/162 communication
  - excess claims fees paid refunded
  - claim for which no fee paid deemed abandoned
  - further processing available

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- Rule 162 EPC
- Rule 161/162 EPC
- Guidelines E-IX, 2.3.8
- Euro-PCT Guide, point 5.11
- Rule 162(3) EPC
- Rule 162(4) EPC
Question 3

Can the claims be amended upon entry into the European phase with effect for the claims fees to be paid?

- yes  no
It is possible to amend the claims after the date of entry into the European phase as long as the claims fees are paid for the set of claims on file at the expiry of the time limit set in the communication under Rules 161/162 EPC.

The number of claims is checked again at grant to ensure that the correct number of claims fees have been paid.

Yes

Rule 162(2) EPC

Rule 71(4) EPC
**Should: Renewal fees**

- Payable for 3rd year and each further year
  - date of filing of the Euro-PCT

- Due date deferred until end of 31 months if fell due during that period; no surcharge applies

- Payment within six months after the due date (“grace period”) ‡ surcharge required

- non-payment within grace period ‡ deemed to be withdrawn

- Re-establishment is available
Should: Representation

β EPC applies before EPO as DO/EO

β After 31 months applicants having neither their residence nor principal place of business must be represented

β No representation required for entry or payments

β Non compliance ‡ invitation to appoint within 2 mths.
  • if further limit not met ‡ application refused
  • further processing is available

Art. 27(7) PCT
Art. 133(2), 134 EPC
Euro-PCT Guide, point 5.3
Guidelines E-IX, 2.3.1

Art 133(2) EPC
Rule 159(1) EPC

Rule 163(5) EPC
Rule 163(6) EPC
Restoration of priority

- May be possible to save priority even though application was filed outside priority 12 months

- Admissibility: i.a. request for restoration must be filed with DO within one month of entry

- Allowability: EPO practice and case-law on due care

- Restoration can also be requested at RO
  - valid in European phase only if was granted on basis of “due care”

- No redress available
More information

**Euro-PCT Guide, Chapter 5**
https://www.epo.org/applying/international/guide-for-applicants/html/e/ga_c5.html

**EPO Guidelines**
Questions

now via chat to "All Panelists"

later via mail  academy@epo.org
Thank you for your attention!

patentlaw@epo.org

For further information, please see the Euro-PCT Guide 2019

(www.epo.org/applying/international/guide-for-applicants.html)