EPO-CNIPA pilot on ISA files

Online seminar
EPO-CNIPA pilot on ISA Files

The Heads of Office of the EPO and the CNIPA agreed to enhance their bilateral cooperation in the framework of the PCT.

On 1 December 2020, the EPO and CNIPA launched a 2-year pilot that enables nationals and residents of the People's Republic of China to select the EPO as their ISA for applications filed in English under the PCT.
EPO-CNIPA on ISA Files

Agenda

1. Welcoming remarks
2. What are the conditions to participate in the pilot?
3. Why could it be interesting for applicants to participate in the pilot?
4. What are the procedural specificities of the pilot?
5. User support and information provided by the EPO and the CNIPA
Conditions for participating in the pilot

- Pilot duration: **2 years** as of 1 December 2020
- First 12-month: max. **2 500** pilot applications
- Second 12-month: max **3 000** pilot applications
- Acceptance on a **first-come first-serve** basis
- Competent receiving Offices: CNIPA (RO/CN) or International Bureau of WIPO (RO/IB)
- Language of filing: **English**
- International search fee: **€1 775** (payable directly with the EPO if RO=CN).
CNIPA-EPO Pilot Roadmap

12.11.2019
13th Conference of the CNIPA-EPO Heads of Office
Joint Communiqué
(agreement to launch a pilot)

01.12.2020
Launch of the 2-year pilot

20.10.2020
Joint Communiqué
announcing launch of the pilot on 1 December 2020

Operational phase
max. 2 500 applications in the first 12 months
max. 3 000 applications in the second 12 months
First-come first-serve basis

Monitoring

30.11.2022
End of pilot
EPO-CNIPA on ISA Files

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Why could it be interesting for applicants to participate in the pilot?

a) Strategic choice: interest in patent protection in Europe and above

b) Getting fast track: the key to accelerate the procedure at the EPO
Why could the pilot be of interest to you?

- Nationals or residents of P.R China seeking patent protection in Europe

- Increased legal certainty: Sound basis for taking an informed decision as to whether or not entering the European phase

- Save money: dispense of the European search fee + 75% reduction of the examination fee in the European phase if the EPO acted as IPEA

- Save time: choosing the EPO as ISA accelerates by 12 months the processing of your application in the European phase

-1 350 EUR (Eur. Suppl. Search fee) and -1 425 EUR (Exam. Fee)
The EPO-CNIPA Pilot for applicants seeking protection in Europe

Map showing the geographic coverage of European patents as of 1 November 2019

- Member states (38)
  - Albania
  - Austria
  - Belgium
  - Bulgaria
  - Croatia
  - Cyprus
  - Czech Republic
  - Denmark
  - Estonia
  - Finland
  - France
  - Germany
  - Greece
  - Hungary
  - Ireland
  - Italy
  - Latvia
  - Liechtenstein
  - Lithuania
  - Luxembourg
  - Malta
  - Monaco
  - Netherlands
  - North Macedonia
  - Norway
  - Poland
  - Portugal
  - Romania
  - San Marino
  - Serbia
  - Slovakia
  - Slovenia
  - Spain
  - Sweden
  - Switzerland
  - Turkey
  - United Kingdom

- Extension states (2)
  - Bosnia and Herzegovina
  - Montenegro

- Validation states (4)
  - Agreement in force
    - Cambodia
    - Republic of Moldova
    - Monaco
    - Tunisia
  - Future validation states (1)
    - Agreement signed but not in force yet
      - Georgia
Some figures: the EPO as ISA in 2019

EPO is Nr 1 ISA in 2019:
80,700 search reports

EPO as Nr 1 IPEA in 2019:
6,000 exam. reports
(55% of the total)

EPO’s services as IPEA include top-up search and full dialogue with examiner

ISR established in 2019

Origin of Search Copies received by ISA/EP in 2019 (%)

- EPO: 32.1%
- JPO: 8.7%
- KIPO: 6.9%
- CNIPA: 21%
- USPTO: 10.8%
- Others: 20.5%
- RO/EP: 46.6%
- RO/IB: 0.6%
- RO/JP: 15.7%
- RO/US: 25.9%
- Other Eur.: 1.1%
- Others: 46.6%
EPO as International Searching Authority (ISA)

- Universal competence of the EPO as ISA
- One standard for all searches at the EPO
  High quality including Asian prior art and use of standards
- **Timeliness**: 97% (2019)
  = A1 publications
- **Flowers in the Garden**
  - Non-binding opinion on patentability equivalent to the European search opinion;
  - preliminary opinion in case of non-unity;
  - information sheet on search strategy

EPO as ISA has universal competence and is competent ISA for applicants from 144 countries.

Quality assurance in the entire patent process:
ISO 9001 certified quality management system
EPO as designated Office (DO)

- In 2019 around **105 000 applications** entered the European phase at the EPO (around 60% of all applications filed at the EPO).

- Only way to protect an invention via the PCT in 12 EPC contracting states + 1 extension state which have closed their national route as PCT receiving Offices (FR, NL, BE, LT, MC, IE, GR, MT, CY, LV, SI + ME)

- **Recognition of EPO's own earlier work products:**
  - Dispense of search (no supplementary search fee) when EPO = ISA
  - 75% Examination Fee reduction when EPO = IPEA
You may export your invention ... 
... all over the world using PCT-PPH
EPO-CNIPA on ISA Files

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Why could it be interesting for applicants to participate in the pilot?

a) Strategic choice: interest in patent protection in Europe and above

b) Getting fast track: the key to accelerate the procedure at the EPO
Accelerating Euro-PCT applications – Overview

Steps to take

I. In the international phase
   A. Form RO101: Choosing the EPO as ISA

II. On entry into the European phase
   B. F1200: You choose early entry into the European phase
   C. F1200: You choose to waive the period of 6 months for further amending the application on entry into the European phase
   D. F1005: You choose to accelerate examination by requesting PACE

Save
12 months!

expedite processing by up to
15 months!

expedite processing by
6 months!

receive communications within
3 months!
I. A. Choosing the EPO as ISA on filing the PCT application

Save **12 months** on entry by choosing the **EPO as ISA** in Form RO101

After entry into the EP-phase the file is immediately within the competence of the examining division

**Reason:** the supplementary European search is dispensed with

- **Save 6 months** time for establishing the European search report
- **Save the 6 months** time limit for replying to the extended European search report
II. Accelerating the Patent Grant Process of Euro-PCT applications

Steps to take on entry into the European phase

Instruct your European representative to do the following:

− Request early processing in EPO Form 1200

− File the Rules 161 and 162 waiver in EPO Form 1200
  − File a substantiated reply to the WOISA (written opinion to the ISR) to remedy the identified deficiencies and any further voluntary amendments
  − Pay any claims fees for claims over 15

− File a PACE request separately to EPO Form 1200.
II. B. Early processing ("early entry")

- Save up to 15 months: request early processing and shorten the international phase!

- The EPO can start processing your Euro-PCT application right after receipt of the ISR, about 4-6 months after the international date of filing!

**Reason**: all application documents, including the ISR, are already in the EPO's file

**Your contribution:**
- Give **clear instructions** to your European representative!
- **Ensure** that all requirements for early processing are met!
- Be well prepared, e.g. in terms of any amendments you wish to make

Art. 23(2)/40(2) PCT

Guidelines for Examination in the EPO: E-IX, 2.8

OJ EPO 2015, A94
EPO form 1200 – requesting early processing

12. Beschleunigung des Verfahrens
12.1 Vorzeitige Bearbeitung

Acceleration of procedure
Early processing

Early processing of the application pursuant to Article 23(2) / 40(2) PCT is hereby requested ("early entry into the European phase").

Please take note of the further requirements for the request to be effective and the legal consequences (see "Notes on EPO Form 1200").

Traitement anticipé

Par la présente, le traitement anticipé de la demande selon les articles 23(2)/40(2) PCT est demandé ("entrée anticipée dans la phase européenne").

Veuillez noter les conditions requises à remplir pour qu'une requête en traitement anticipé soit valable, ainsi que les conséquences juridiques (voir la « Notice concernant le formulaire OEB 1200 »).
II. C. Waiving the communication under Rules 161 and 162 EPC

- **Save 6 months:** waive the Rules 161 and 162 communication and comply with the requirements under these Rules already on entry of the European phase

- **Validly waiving the communication under Rules 161(1) and 162 EPC:**
  - File a response to the written opinion by the ISA ("WOISA"), including any amendments
  - Pay any claims fees for claims over 15

- **If the waiver is accidentally omitted:** File an early response to the Rules 161/162 communication and state explicitly that you renounce to use the remainder of the 6-month period!
Requesting waiver to the communication under R. 161(1) or (2) EPC

12.2

**Verzichtserklärungen**

- Der Anmelder verzichtet auf die Mitteilung nach Regel 161 (1) oder (2) und 162 EPÜ.

**Waivers**

The applicant waives his right to the communication under Rules 161(1) or (2) and 162 EPC.

**Renonciations**

Le demandeur renonce au droit de recevoir la notification émise en vertu des règles 161(1) ou (2) et 162 CBE.

Le demandeur renonce à être invité, conformément à la règle 70(2) CBE, à déclarer s'il souhaite maintenir sa demande.
II. D. PACE request – accelerating examination

The examining division strives to issue the next official communication **within 3 months** from receipt of your latest action

**Requirements:**

- You must file the PACE request **online on EPO Form 1005**
- You must not delay the proceedings, otherwise the application is removed from the PACE programme
  - Do not ask for time extensions
  - Reply to a communication from the EPO in time
  - Pay the renewal fees in the basic time limit, do not use the 6-month grace period!

- The request can only be made **once** during the examination stage.
Save **30** months or even more!

**Summary**

- **Date of filing**
- **Early entry**
- **31M**
- **European phase**
  - **Amend application (R.161/162 EPC)**
  - **Suppl. Search**
  - **Proceed w/ exam? (R.70(2))**
  - **grant**
  - **Request PACE acceleration**
  - **exam start**
  - **1st Communication**
  - **Approx. 20 months**

**Priority Filing**
- **12M**
  - **4-6M**
    - **ISR by EPO with written opinion (WOISA)**

**31 months or earlier in case of early entry**
Intermediate Q&A session

Questions & answers

Feel free to write your questions in the chat box to All Panellists.
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What are the procedural specificities of the pilot?

a) CNIPA as RO: some information about the processing of the application selecting ISA=EP
b) Special procedure for the payment of the international search fee when selecting RO/CN (temporary)
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What are the procedural specificities of the pilot?

a) CNIPA as RO: some information about the processing of the application selecting ISA=EP
b) Special procedure for the payment of the international search fee when selecting RO/CN (temporary)
Payment of the international search fee

- International search fee due to ISA/EP: **1 775 €**.

- Exception to Rule 16.1(b) PCT for a temporary period: CNIPA acting as receiving Office is not yet collecting the search fee due to ISA/EP.

- For a transitional period, applicants will thus need to **pay the international search fee directly with the EPO in €** via credit card or their EPO deposit account if they have one.

- Payments of the international search fee are **neither** possible via bank transfer **nor** via the EPO Online Fee Payment service.
Payment of fees by credit card

Sign in to pay fees and claim refunds

Already have an account? Sign in below.

E-mail address

Password

Sign in  Forgot your password?

Using the service for the first time? Please register now.

Easy payment process: register with email and password → pay fees → provide application number → select international search fee from pre-defined fee group → checkout via secured payment process

Easy way to pay the fees at the EPO
No need for an EPO Smartcard → registration with email and password
Immediate confirmation on payment
Get an EPO Smart Card

Some EPO Online Services are exclusively accessible via Smartcard:

- Mailbox/MyFiles
- Administration
- Online Filing (OLF)
- New Online Filing (CMS)

Smart cards

The European Patent Organisation provides authorised users of its Online Services with smart cards for use with digital signatures.

Smart cards are highly secure devices that encrypt signatures. To add your digital signature, all you have to do is insert your smart card into the reader and type your PIN when prompted (you will need to have installed the smart card software first before you can do this).

Online Services smart cards are created by a certification agency. They contain:

- the user's private key
- the user's public key
- a certificate confirming that this public key has been allocated to the user

All users must have their own smart card. If there are several people within one company with the right to sign and/or submit patent applications, they must each have their own card.

Download

- Certificate Policy (PDF, 185 KB)
- Certification Practice Statement (PDF, 230 KB)
- Terms and conditions for EPO smart cards and smart card readers (PDF, 61 KB)
- Setting up cryptovision in Mozilla Firefox (PDF, 395 KB)

Inserting your smart card
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Where to find more information on the CNIPA-EPO Pilot?

FAQ in English

Guidance for applicants in Chinese
Where to find more information on the CNIPA-EPO Pilot?

- Frequently Asked Questions (FAQ) on the EPO website
- Guidance for applicants on the CNIPA website
- Contact the EPO at support@epo.org and/or CNIPA at PCT_affairs@cnipa.gov.cn, by mentioning CNIPA-ISA Pilot in the title of your query.
General information on the EPO as SISA

- Optional for applicants: second search with an Office other than the ISA, potentially in another language (e.g. RO=CN; EPO = SISA)

- At the EPO: same quality of search, fee and advantages as for EPO's international search e.g. dispensation of supplementary European search in EP phase

- Irrespective of ISA chosen

- Gives more legal certainty before incurring the costs of entering the national/regional phases
General information

The EPO Homepage for all information and tools for:

searching
filing
paying
get news and updates
General information

Applying for a patent
https://www.epo.org/applying.html

EPO forms and fees
http://www.epo.org/applying/forms-fees.html

Legal texts:

Guide for applicants
General information
Questions

Feel free to write your questions in the chat box to All Panelists.