



EPO-CNIPA pilot on PCT services for Chinese applicants

28.01.2021

Online seminar

Organized by the European Patent Office (EPO) & the China National Intellectual Property Administration (CNIPA)

This document contains the answers to all the questions that were asked in the chat during the online seminar, including those which could not be addressed due to time constraints.

Questions	Answers
CONDITIONS FOR PARTICIPATION	
<p>Can the application be accepted into the pilot if it is filed by a Chinese applicant and a foreign co-applicant?</p>	<p>In order to file your international application at the CNIPA as receiving Office (RO/CN), it suffices that <u>at least one</u> of the applicants is a national or a resident of P.R. China. If this requirement is fulfilled, your application will be considered a pilot application where you select the EPO as ISA, provided the other requirements for participation are fulfilled (English as language of filing; payment of the international search fee to the EPO; acceptance within the limit of 2,500 applications in the first 12 months of the pilot).</p> <p>For applications filed at the International Bureau as receiving Office (RO/IB), the competent ISAs are the same as those which would have been competent if the application had been filed with a competent national/regional patent Office (see PCT Rule 35.3). Given the fact that the EPO has universal competence as an ISA, most applicants were already able – outside the framework of the pilot – to select the EPO when filing at RO/IB. Therefore, applications from RO/IB will be counted in the pilot only if:</p> <ul style="list-style-type: none"> • All applicants are nationals of P.R. China with a residence in P.R. China or in one of the 7 countries where the EPO may not be designated as ISA (including Australia, Canada and the Republic of Korea); and/or • All applicants are nationals of one of the 7 countries where the EPO may not be designated as ISA and have a place of residence in P.R. China.
<p>Can a European company file a patent application with the CNIPA as receiving Office and select the EPO as ISA? What if the inventor is a Chinese national but works for a foreign company?</p>	<p>Yes, a European company can participate in the pilot when filing the application with CNIPA as receiving Office if it has its place of business in P.R. China or if a national or resident of P.R. China is listed as co-applicant.</p> <p>The status of inventor is irrelevant to determine the competence of a receiving Office.</p>
<p>Can an Indian applicant file a patent application with the CNIPA as receiving Office (RO/CN)?</p>	<p>The CNIPA is competent as receiving Office provided the applicant or <u>at least one</u> of the applicants is a national or resident of P.R. China.</p> <p>Hence, an applicant of Indian nationality residing in P.R. China can select the CNIPA as receiving Office (RO/CN). Similarly, a Chinese national residing in India may also select RO/CN and benefit from the pilot. That being said, your attention is drawn to the fact that the EPO may be selected as ISA when filing at the Indian patent Office as receiving Office.</p>
<p>If a PCT application has been filed with CNIPA as receiving Office in Chinese and the CNIPA has been selected as ISA, is it possible and advisable to switch to change and select the EPO as ISA ?</p>	<p>No. Once you have filed your application and selected CNIPA as your ISA, it is no longer possible to change. Furthermore, in order to select the EPO as ISA under the pilot, your international application must be filed in English. Applications filed in Chinese will not be accepted in the pilot.</p> <p>However, if you have selected CNIPA as your ISA, you may submit a request for supplementary international search (SIS) choosing the EPO as Supplementary International Searching Authority (SISA). A SIS request must be filed with the International Bureau within 22 months from the priority date. If your application was filed in Chinese, a translation of your application into English, French or German must be filed with your request. The EPO establishes the Supplementary International Search Report (SISR) within 28 months from the priority date.</p>

<p>How can I file the documents to participate in the pilot?</p>	<p>All application documents (request, description, claims, drawings if any, and abstract) must be filed with the receiving Office (CNIPA or the International Bureau). If the CNIPA is the receiving Office, the documents should be filed via the CNIPA CE-PCT system. For applications filed with the international Bureau, the applications can be filed using WIPO's ePCT filing tool.</p> <p>Subsequently filed documents (SFDs) to be filed at the EPO as ISA (e.g. rectification of obvious mistakes in the description, claims or drawings according to Rule 91 PCT) or PCT Chapter II demands with the EPO as IPEA can be filed by post or fax, or via the EPO's online filing tools (Web-form filing, Online Filing (OLF) or New Online Filing (CMS)).</p> <p>Alternatively, pilot applicants are encouraged to use the ePCT service of WIPO to file SFDs or their PCT Chapter II demand. The ePCT service can also be used for indicating the payment of fees related to the demand (see EPO OJ 2016, A78).</p>
<p>THE EPO AS ISA</p>	
<p>When can applicants expect to receive form PCT/ISA/202 (notification of receipt of search copy by the ISA)? Can it be seen in CE-PCT?</p>	<p>If the applicant has a European representative, the document can be retrieved electronically via the EPO Mailbox service. Otherwise, the EPO will send by default the international search report (ISR) including the cited documents and the written opinion (WO/ISA) by post. Applicants however can get an electronic copy of the ISR (without the cited documents) and WO/ISA via WIPO's ePCT service, WIPO's online portal for filing and managing PCT applications. It is therefore strongly recommended that Chinese applicants open an ePCT account with WIPO. More information on ePCT can be found on WIPO's website.</p> <p>It is not possible for applicants to receive the notifications relating to the international search performed by the EPO via the CNIPA CE-PCT system.</p>
<p>How long does it take to receive the ISR and WO/ISA from the EPO after filing?</p>	<p>For international applications claiming priority, the EPO acting as ISA usually issues the ISR and a written opinion within three months from its receipt of the search copy.</p> <p>However, if you choose the CNIPA as your receiving Office, the international search cannot start until you have paid the search fee directly to the EPO as the payment of the international search fee is a requirement for the transmission of the international application (search copy) to the EPO acting as ISA.</p>
<p>When establishing the ISR, does the EPO consider special European requirements such as, for instance, clarity under Article 84 EPC or the a posteriori non-unity of invention, in the Search Opinion?</p>	<p>Yes. The EPO applies the same standard for its international and its European search. The entry into the European phase is thereby facilitated. Reference is made to the PCT International Search and Preliminary Examination Guidelines (PCT ISPE Guidelines) applied by the EPO, supplemented by the EPO-PCT Guidelines.</p>
<p>Does the EPO use email as a means of notification?</p>	<p>The EPO does not use emails as an official means of communication.</p> <p>Applicants are invited to apply for a Smartcard and register for the Mailbox service if they are eligible (e.g. European representatives, but not international agents). Otherwise, the EPO will send the international search report (including the cited documents) and written</p>

	<p>opinion by default by post. Applicants however can get an electronic copy of the file of their international application using WIPO's ePCT service. It is therefore strongly recommended that Chinese applicants open an ePCT account with WIPO.</p>
<p>When filing my application with the CNIPA as receiving Office, can I pay the international search fee to the EPO via my European patent attorney or a third party?</p>	<p>Yes. Payments to the EPO can be validly made by anybody throughout the proceedings before the EPO. The international search fee can therefore be paid by your European representative or a third party. If they are using the EPO credit card payment tool, they simply need to indicate the application number.</p> <p>They can also choose to pay via their EPO deposit account if they have one, by using the EPO Online Filing tool (OLF) or New Online Filing (CMS).</p>
THE INTERNATIONAL SEARCH FEE	
<p>How can I pay the international search fee?</p>	<p>If the receiving Office is CNIPA, the search fee is payable directly to the EPO via the EPO credit card payment tool or via deposit account using the EPO Online Filing tool (OLF) or New Online Filing (CMS). We draw your attention to the fact that it is neither possible to use the EPO Online Fee Payment tool (OFP) to pay the international search fee nor to pay by bank transfer.</p> <p>If the receiving Office is the International Bureau (RO/IB), you can pay the international search fee directly with RO/IB.</p>
<p>For an application with a priority that has been searched by the EPO, is there any discount of search fee from the EPO?</p>	<p>If the search for the international application is based entirely or partly on an earlier search report already prepared by the EPO on an application whose priority is validly claimed (Box No. VI of the PCT request form), the applicant may obtain a refund of the international search fee. The EPO acting as ISA decides whether the requirements are met and, where applicable, refunds the applicable amount.</p>
THE INTERNATIONAL PRELIMINARY EXAMINATION (OPTIONAL)	
<p>Do I have to appoint a European representative if I file a Chapter II Demand for international preliminary examination?</p>	<p>No, you do not have to. In the international phase, applicants may be represented before the EPO as IPEA by the agent appointed on filing the international application and having the right to practise before the receiving Office.</p> <p>However, being represented in the international phase by a European representative is strongly recommended, especially to draft amendments under Art. 34 PCT in the framework of Chapter II demand for international preliminary examination. You can therefore appoint an agent to act specifically before the EPO as IPEA. Moreover, the agent appointed for the international phase (e.g. Chinese agent) may appoint a sub-agent to represent the applicant before the EPO as IPEA. Any agent specifically appointed before the EPO as IPEA must be entitled to practise before the EPO.</p> <p>Furthermore, your attention is drawn to the fact that applicants having neither their residence nor their principal place of business within the territory of one of the EPC contracting states ("non-resident applicants") will have to appoint a professional representative entitled to practise before the EPO when entering the European phase. Non-resident applicants are therefore strongly advised to appoint a professional representative before the EPO in good time, i.e. before they initiate proceedings before the EPO as designated/elected Office.</p>

<p>Is it possible to select the CNIPA as ISA and then select the EPO as IPEA?</p>	<p>No. The EPO will act as IPEA only if it has carried out the international search, acting as ISA. Similarly, the CNIPA will not act as IPEA if the EPO has acted as ISA.</p>
<p>THE EUROPEAN PHASE: THE EPO AS DESIGNATED OFFICE</p>	
<p>For early entry into the EP phase, is it possible to start the early entry before the international search report is established? In other words, what is the earliest time possible for entry into the EP phase?</p>	<p>You can file a request for early processing under Article 23(2) PCT as soon as the receiving Office has accorded an international date of filing. As a consequence, the application is considered pending before the EPO as designated Office as from the date the request for early processing is filed, provided all requirements for early processing are also fulfilled on that date (see Guidelines for Examination in the EPO, E-IX, 2.8). However, in order to start the processing of the application before the EPO as designated or elected Office, the ISR must have been established. Rule 161(1) EPC requires, as the case may be, a mandatory reply to the written opinion of the ISA, and, since examination always follows the search stage, the examining division will only take up examination when the EPO has established the ISR and the time limit under Rule 161(1) EPC has expired. As explained during the meeting, to expedite the procedure, the communication under Rules 161 and 162 EPC can be waived provided the reply to this communication is anticipated upon entry into the European phase (OJ EPO 2015, A94).</p>
<p>If I do not waive EPC 161/162 Communication, can I submit voluntary amendments in response to 161/162 EPC Communication? And is the voluntary amendment allowed to be beyond the scope of the claims of the international application?</p>	<p>Yes, you can file voluntary amendments in reply to the communication under Rules 161 and 162 EPC. Where the written opinion of the International Searching Authority (“WOISA”) identified deficiencies, a reply to the communication under Rules 161 and 162 EPC is even mandatory. As a general rule, the principle of Article 123(2) EPC applies to all EP- and Euro-PCT applications, i.e. any amendments may not go beyond the content of the application as originally filed. In the case of PCT-applications, “as originally filed” corresponds to the international date of filing. Please note that the act of entering the European phase does not constitute a filing date – it is a step that follows the international phase of a PCT application that has already been accorded an (international) filing date (Art. 11(1) PCT).</p>
<p>After PACE is requested, is it certain that the Office communications will be issued within 3 months?</p>	<p>The examining division prioritises applications with a PACE request and tries to issue the official communication within 3 months from the applicant’s last reply. Whether the 3 months indication can always be met depends on certain factors, e.g. the workload of the examining division in charge of your file. In certain technical fields there may be constraints due to the numbers of incoming PACE requests. However, such cases should be very rare. For detailed information, please see the corresponding notice from the EPO, OJ EPO 2015, A93.</p>
<p>When should I file a PACE request?</p>	<p>It is most effective to file the PACE request (EPO Form 1005) at the same time as your request to enter the European phase (EPO Form 1200).</p>
<p>Can the PACE also speed up the 71(3) EPC communication?</p>	<p>The PACE request for accelerated examination shortens the periods between your reply to an official communication and the next official communication. Thus, the communication under Rule 71(3) EPC, “intention to grant a European patent”, will also be issued earlier in terms of time, provided your invention meets all requirements for patentability under the EPC.</p>
<p>Is a PACE request necessary given the relatively fast prosecution of the file at the EPO in the European phase?</p>	<p>The PACE request may add to applicants’ strategy for a very fast grant. In fact, the prosecution of Euro-PCT applications has been successfully streamlined in recent years.</p>

NATIONAL PHASE: CHINA	
When entering into the national phase before CNIPA, does the Chinese examiner rely on the EPO's international search report (ISR)? Or is an supplementary Chinese Search mandatory? Will any fee be refunded?	When entering into the national phase before CNIPA under the pilot, the examination standards are the same as those for regular PCT applications entering national phase. If the ISR is established by the EPO, the applicant only need to pay 80% of the substantive examination fee when entering the Chinese national phase. Furthermore, for PCT applications filed with the CNIPA as receiving Office, applicants will be exempted from paying the filing fee and the additional filing fee when entering the Chinese national phase.
ADDITIONAL INFORMATION	
<p>Thank you for your participation to the online seminar. If you need additional information on the EPO-CNIPA pilot on PCT services for Chinese applicants, do not hesitate to consult:</p> <ul style="list-style-type: none">• the dedicated Frequently Asked Questions published on the EPO website in English, French and German• the Guidance for applicants published in Chinese on CNIPA's website. <p>If you have further questions concerning the pilot, you can contact the EPO at support@epo.org and/or CNIPA at PCT_affairs@cnipa.gov.cn, mentioning the EPO-CNIPA pilot in the title of your query.</p>	