

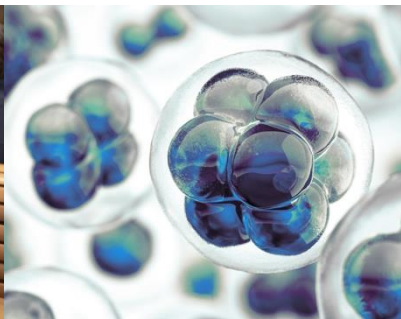


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Patentamt  
European  
Patent Office  
Office européen  
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# PCT Update



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# Content

- Status update on PCT: facts and figures
- Representation at the EPO in the international phase
- **Obvious mistakes (R. 91 PCT)**
- Report on the 2021 PCT Working Group meeting
- Early entry into the European phase – request for early processing (Art. 23(2) / 40(2) PCT)

# Obvious mistakes –requirements

R. 91 PCT

- Obvious mistakes can be rectified if:
  - the mistake is obvious
  - the rectification is obvious.
  
- A mistake is "obvious" **if it is obvious** to the competent authority **that something else was intended** than what appears in the document concerned **AND nothing else could have been intended than the proposed rectification.**

## Obvious mistakes – requirements

- It may be rectified:
  - if the applicant so requests
  - if the competent authority invites the applicant to do so.
- The request shall specify:
  - the mistake to be rectified
  - the proposed rectification and
  - at the option of the applicant, contain a brief explanation
- Time limit: **26 months from the priority date**

## Obvious mistakes – competent authority

**Competent authority:** depends on the document in which the mistake was made: R. 91.1(b) PCT

- **RO** => for mistakes in a **PCT request** or in a correction thereof
- **ISA** => for mistakes in the **description, claims or drawings** or in a correction thereof

## Obvious mistakes – competent authority

- **IPEA** => for mistakes in **the description, claims or drawings** or correction thereof or **amendments under Art. 19 or 34**, if a demand was filed and the date for the start of the international preliminary examination under Rule 69.1 PCT has passed
- **RO, ISA, IPEA or IB** => for mistakes in **any other document** (except abstract or amendment under Article 19).

## Obvious mistakes – basis for the decision

To determine whether a mistake is obvious, the competent authority may take into account only:

- in case of mistake in **the description, claims and drawings** and, where applicable, a correction thereof: **the content of the description, claims and drawings**, and, where applicable, the correction or amendment concerned.

## Obvious mistakes – basis for the decision

- in case of a mistake in **the request** or a correction thereof, or in a **document under 91.1(b)(iv) PCT: the content of the international application**, where applicable of the correction, **and any other document (including the priority document) available at the applicable date.**



# Obvious mistakes – applicable date

Applicable date:

- In case of a mistake in a part of the international application: **the international filing date**
- In case of a mistake in a document other than the international application: **the date on which the document was submitted**

## Obvious mistakes - exceptions

R. 91.1(g) PCT

- A mistake shall not be rectifiable under this Rule if:
  - the mistake lies in the omission of **one or more entire elements** or **one or more entire sheets** => (Rules 20.3 and 20.5)
  - a mistake is in the **abstract** => (Rule 38.3)
  - the mistake is in an **amendment under Art. 19** (unless IPEA is competent)
  - the mistake is in a **priority claim** or in a **notice correcting or adding a priority claim, where the rectification would cause a change in the priority date** => (Rule 26*bis*)

## Obvious mistakes – decision

- The authority shall **promptly decide** whether to authorise the rectification and **promptly notify** the decision taken
  - => in case of refusal indicate the reasons.
- **If the obvious mistake is rectified**, it shall be effective:
  - if the mistake is in the int. application, from the international filing date
  - if the mistake is in a document other than the int. application, from the date on which that document was submitted

## Obvious mistakes – decision

- **In case of refusal**, the IB shall, upon request submitted by the applicant within two months from the date of refusal, publish the **request for rectification**, the **reasons for refusal** by the authority and **any further brief comments submitted by the applicant**.

## Obvious mistakes – designated Office

- The DO may not take the rectification into account if:
  - processing or examination has started prior to the date of notification of the decision
- The DO may disregard such rectification only if it finds that it would not have authorised it under Rule 91 if it had been the competent authority.
  - **but** not before giving the applicant the opportunity to make observations

# Question



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**May I file a rectification under R. 91 PCT in a language other than the language in which the application was filed?**



= Yes

# Answer



R. 12.2(b) PCT

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The correct answer is:  no

- Any rectification under R. 91.1 PCT of an obvious mistake shall be in the language in which the application is filed.
- Where a translation of the international application has been furnished for the purposes of the international search, international publication, international preliminary examination, the rectification is to be both in the language in which the international application is filed and the language of the translation.
- Exception: request.

# Question



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**If the description and/or the claims contain a few sentences or short fragments in a language other than the language of the proceedings, may I request rectification under R. 91?**



= Yes



# Answer



The correct answer is:  **yes**

→ If the mistake only concerns a few sentences or short fragments and requirements under R. 91 PCT are fulfilled.

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# PCT WG report

- Recent meeting: 14-17 June 2021

[https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=62348](https://www.wipo.int/meetings/en/details.jsp?meeting_id=62348)

- Reports/studies submitted to the WG for information/consideration/comment:
  - Report on the 28th meeting of international authorities under the PCT ([PCT/WG/14/2](#))
  - WIPO Fee Transfer Service: status report ([PCT/WG/14/7](#))
  - IP5 PCT collaborative search and examination: status report ([PCT/WG/14/6](#))

# PCT WG report

Specific amendments submitted to the Assembly:

- **Sequence listings:** implementation of standard ST.26 (XML) (PCT/WG/13/8)
  - Amendments to Rules 5, 12, 13*ter*, 19.4 and 49 PCT
  - Adopted by the Assembly in October 2021
  - These amendments will enter into force on 1 July 2022 and will apply to any international application with an international filing date on or after that date.

# PCT WG report

- **Strengthening PCT safeguards in case of general disruption (PCT/WG/14/11)**
  - Amendment to Rule 82*quater*.1 to include epidemics as a cause of force majeure
  - New Rule 82*quater*.3 [general disruption]
  - These amendments will also enter into force on 1 July 2022 and apply to any time limit that expires on or after that date.

# 1 July 20: Fee “netting structure” introduced

- PCT did not clearly arrange the forwarding of fees
  - for example, Search fee is collected by RO on behalf of ISA
  - but sensitive to movements in currency exchange rates
  
- Since 21 Jul 20, explicit legal basis added for transfer via IB of fees
  - Fee collected by “collecting Office” for benefit of “beneficiary Office”
  - Collecting Office promptly notifies receipt of such a fee
  - Upon receipt of notification, beneficiary Office proceeds as if it had received fee on date on which fee was received by collecting Office
  - Collecting Office transfers fees according to agreed procedure
  
- Will make it easier in future for RO’s to allow applicant to choose **ANY ISA**

R. 96.2 PCT  
R. 15, 16, and 57 PCT

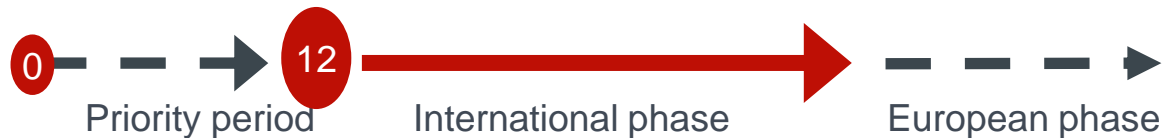
Source: Pete Pollard

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# Regular entry vs. early processing

- **Regular** entry into the European phase: **31 months** from filing/priority (Art. 22(3) / 39(1)(b) PCT, Rule 159(1) EPC)
  - **The PCT prevails:** Regular time limits under the EPC delayed to 31 months!
- **Until expiry of 31 months: processing ban** (Art. 23(1) or 40(1) PCT)
  - the EPO as designated/elected Office may not start processing the application before expiry of the 31-month period



- Only the **applicant** can lift this processing ban by filing an explicit request for early processing (Art. 23(2) or 40(2) PCT)

Art. 22 PCT  
Art. 39 PCT  
Art. 23 PCT  
Art. 40 PCT  
Art. 150(2) EPC  
Art. 153(2) EPC  
Rule 159(1) EPC



# Strategic considerations for late or early entry

- **National effect:** PCT application with filing date is **equivalent** to national filings (Art. 11(3) PCT)
- National / regional entry **must be duly performed, otherwise national effect lost** (Art. 24(1)(iii) / Art. 39(2) PCT)
- National offices do not send formal reminders, but at 28m ...
  - IB sends Form IB/308 indicating 30m is latest to enter
  - EPO sends applicants world-wide EPO 1201 explaining entry steps
- Prefer **“last-minute”** entry because:
  - IB has made relevant files available to dO/eO’s
  - irreversible decisions and national costs delayed as long as possible
- Prefer **“early entry”** because ...
  - quicker grant or earlier provisional protection
  - quicker opinion on patentability in national search or office action
  - avoid national effect due to international action, such as **withdrawal of priority**

Art. 11(3) PCT  
Art. 24(1)(iii) or Art. 39(2) PCT  
Art. 29(1) PCT  
PCT Ag-INT 3.005  
PCT AG-INT 5.003, 6.012,  
PCT AG-INT 9.024  
PCT AG-NAT 2.006

# Reasons for requesting early processing

1. **Voluntary:** Strategic considerations by the applicant
2. **Necessitated by unintentional loss of national effect:**
  - International application is refused or deemed to be withdrawn in the international phase
  - Remedies under the PCT: Articles 24 – 26 PCT; strict time limit under Article 25(2) PCT (2 months from a negative communication from the RO - Rule 51(1) PCT).
  - **Entry into the European phase with a request for early processing necessitated**
  - If the request under Art. 24, 25 or 26 PCT can be allowed, the EPO will process the application like any European patent application (Art. 153(2) EPC).

Art. 24 PCT  
Art. 25 PCT  
Art. 26 PCT  
Rule 82<sup>ter</sup>.1 PCT  
Rule 51 PCT  
GL, E-IX, 2.9

# Request for early processing

## ▪ Requirements:

- Simply filing EPO Form 1200 early during the international phase does **not** constitute a request for early processing!
- **Required: Explicit request** for early processing (with explicit reference to Article 23(2) / 40(2) PCT)
  - EPO Form 1200, section 12.1 or Tab “Requests” in online filing
- Compliance with the **requirements of Rule 159 EPC as if the 31-month period expired on the date early processing is requested**
  - **For any procedural acts and fees, the 31-month period can no longer be claimed!**
- Request can be made during the entire 31-month period

Art. 23(2) PCT  
Art. 40(2) PCT  
Rule 159(1) EPC  
OJ EPO 2013, 156  
J 18/09  
GL E-IX, 2.8

# Rule 159(1) requirements for an effective early entry (1)

## 1. Always to be made together with the request for early processing:

- Payment of the EPO's **filing fee** as the "national fee" under Articles 22/39 PCT (Rule 159(1)(c) EPC), including any **additional fee** for pages over 35 ("page fee")
- **Specification of the application documents** serving as the basis for the European phase (Rule 159(1)(b) EPC)

Rule 159(1) EPC

## Rule 159(1) requirements for an effective early entry (2)

2. To be made together with the request for early processing, depending on the individual case:
  - Payment of the **search fee** if the EPO did not act as (S)ISA (Rule 159(1)(e) EPC)
  - Filing of a **translation** if the international application is not published in EN/FR/DE (Rule 159(1)(a) EPC)

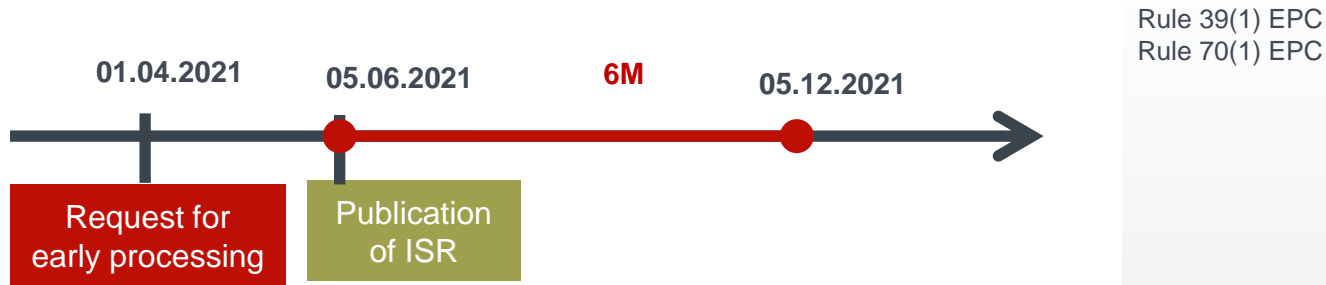
# Rule 159(1) requirements for an effective early entry (3)

## 3. To be made depending on the effective date of early processing:

Art. 153(3)-(5) EPC  
Rule 39(1) EPC  
Rule 70(1) EPC  
Rule 51(1) EPC

- Payment of the **designation fee**: the time limit under Rule 39(1) EPC may not yet have expired (Rule 159(1)(d) EPC)
- **Request for examination & payment of the examination fee**: the time limit under Rule 70(1) EPC may not yet have expired (Rule 159(1)(f) EPC)
  - The time limits for the designation and examination fees expire six months from the date of publication of the ISR
- Payment of the **renewal fee** for the 3rd year: may not yet have been fallen due under Rule 51(1) EPC (Rule 159(1)(g) EPC)
- **Delaying payment of these fees to the 31-month period no longer possible**

# Example 1: Designation fee and request for examination



- Six-month periods pursuant to Rules 39(1) and 70(1) EPC have not yet started when filing the request for early processing
- Paying the designation fee and filing the request for examination (including the payment of the examination fee) **is not required** for the request for early processing to be effective

## Example 2: Designation fee and request for examination



- Six-month periods pursuant to Rules 39(1) and 70(1) EPC have started when filing the request but not yet expired
- Paying the designation fee and filing the request for examination (including the payment of the examination fee) **is not required** for the request for early processing to be effective



## Example 3: Designation fee and request for examination



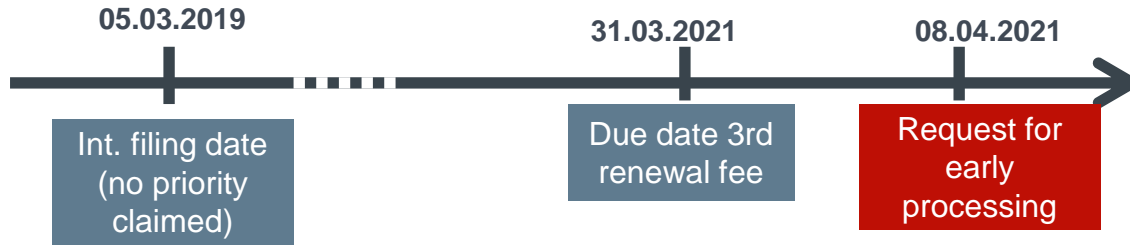
- Six-month periods pursuant to Rules 39(1) and 70(1) EPC have expired when filing the request
- Paying the designation fee and filing the request for examination (including payment of the examination fee) **is required** for the request for early processing to be effective

## Example 4: Renewal fee



- Pursuant to Rule 51(1) EPC, the renewal fee for the 3rd year is due on 31.03.2021
- Payment of the renewal fee **is not required** for the request for early processing to be effective
- However, according to Rule 51(1) EPC, the 3<sup>rd</sup> renewal fee can be paid 6 months in advance

## Example 5: Renewal fee



Rule 51(1) EPC

- Pursuant to Rule 51(1) EPC, the renewal fee for the 3<sup>rd</sup> year is due on 31.03.2021
- Payment of the renewal fee (without additional fee) **is required** for the request for early processing to be effective

# Consequences of an effective request

- **The processing ban has been lifted by the applicant:**

Art. 153(2) EPC

- The application is processed like any Euro-PCT application having (regularly) entered the European phase (Art. 153(2) EPC)
- The international phase is terminated in respect of the EPO as designated/elected Office
- No more recurrence to the 31-month time limit – the delaying effect of the 31-month period is lifted:
  - Time limits under the EPC for procedural acts (payment of fees, submission of documents) apply
  - The applicant requests the immediate processing as a European application = procedural declaration
- **The request for early processing cannot be simply withdrawn**
- The request for early processing **is not** a request for accelerated prosecution (PACE). **PACE must be requested separately**

# Consequences of an effective request, cont.'d

From the date the **request for early processing** is effective,

- the application is pending before the EPO as DO/EO, and the applicant may validly file a **divisional application**
  - any subsequent **withdrawal** of the international application under Rule 90*bis* PCT will have no effect in respect of the procedure in the European phase
  - any **IPER** (Chapter II PCT) may be disregarded if not available in time to be taken into account after processing has started
  - the 1-month time limit for requesting **restoration of right of priority** starts running (Rule 49*ter.2*(b)(i) PCT)
- **Important legal date:** The applicant is informed about the day on which the request has become effective (Form 1232)

Rule 90*bis* PCT  
Rule 49*ter.2* PCT  
OJ EPO 2013, 156  
GL E-IX, 2.8

# Processing the file

- An effective request for early processing does not in all cases mean that the Euro-PCT application can be processed immediately
- In general, the ISR must be available to enable the EPO to start processing the file
- **Reason:**
- **If a supplementary European search is to be carried out**, the search examiner bases their work on the results of the ISR by another International Searching Authority (GL, B-II, 4.3.2);
- **If the European search report is dispensed with (EPO = ISA):**
  - a reply to the WOISA is in many cases mandatory;
  - substantive examination can generally only start once a search report is available (GL, C-III, 4).

Art. 28 PCT  
Art. 41 PCT  
Rule 161 EPC  
Rule 162 EPC

# Processing the file, cont.'d

## The ISR must be available before the first processing step can be taken

- **First processing step** (once ISR available):
  - sending the communication under Rules 161 and 162 EPC
  - Further possibility to amend the application (Art. 28 / Art. 41 PCT)
  - Filing a reply to the WOISA (voluntary or mandatory reply)
  
- **EPA actions possible before receipt of the ISR:**
  - Recording of bibliographic data
  - Establish access to the PCT file (either within the EPO or via ePCT)

Art. 153(6) EPC  
Art. 153(7) EPC  
OJ EPO 2015, A94  
GL B-II, 4.3.2  
GL C-III, 4

# Recommended reading

- Guidelines for Examination in the EPO, [E-IX, 2.8](#) (March 2021)
- Euro-PCT Guide, point [5.1.022](#) ff.
- Notice from the EPO dated 21.02.2013 concerning the request for early processing ([OJ EPO 2013, 156](#))
- Notice from the EPO dated 30 November 2015 concerning ways to expedite the European patent application ([OJ EPO 2015, A94](#)).



# Any questions?



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Now

via chat to "*All Panellists*"

# Question



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EPO Form 1231 informs about any deficiencies in your request for early processing.

What happens if you do not reply to EPO Form 1231?

- You receive a noting of loss of rights
- The international phase continues
- You will receive a reminder

# Answer



- Answer 1
- Answer 2**
- Answer 3

The request for early processing is not valid, and the international phase continues. The processing ban applies, i.e. the processing the Euro-PCT file is deferred to 31 months.

# Question



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You have requested early processing but have not yet paid the designation and examination fees because the 6-month period was still running when you filed the request. You miss paying the two fees at the end of the 6-month period.

What is the consequence?

- You will receive a noting of loss of rights.
- You will be informed that your request for early processing has become invalid.
- You can still pay the fees at the end of the 31-month period.

# Answer



## Answer 1

Answer 2

Answer 3

Since the request for early processing has lifted the delaying effect of the 31-month time limit, the designation and examination fees become due earlier. If they are not paid in time, you will receive a noting of loss of rights (Rule 112(1) EPC). Legal remedy: request for further processing (Art. 121 EPC).

# Further questions



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## Now

via chat to "All Panelists"

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## Later

via e-mail to

[international\\_pct\\_affairs@epo.org](mailto:international_pct_affairs@epo.org) or [patentlaw@epo.org](mailto:patentlaw@epo.org)