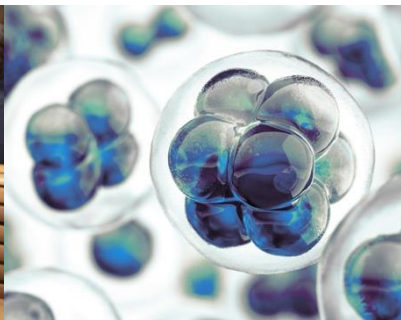




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PCT at the EPO (advanced)

PCT Practice – A practical update on EPO services in the framework of the PCT



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October 20, 2020

Presenting today



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At the EPO since 2011

Degrees in Law and Business Law at the University of
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Author of the commentary to Art. 152 EPC (The EPO as ISA
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the EPC

Presenting today



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At the EPO since 2002

Engineering Degree at the ENAC (French National School of
Civil Aviation) and EQE 2007

Member of the CII Guidelines drafting group

Course 3: PCT Practice



Agenda

- Facts and figures
- COVID-19 – available remedies
- PCT Direct service

Course 3: PCT practice

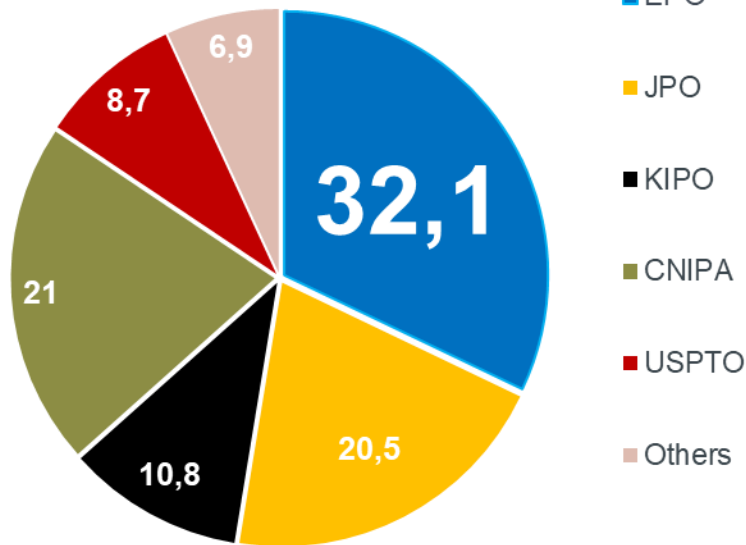


Facts & figures

- **The EPO as ISA in 2019**
- The EPO as IPEA in 2019

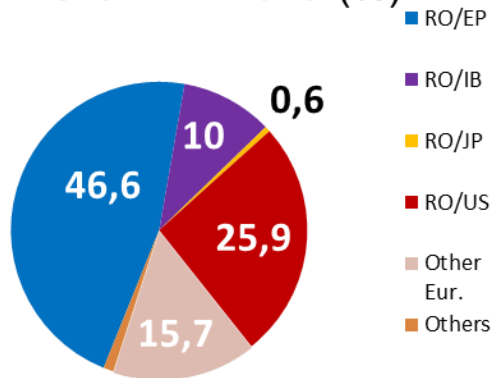
Facts and figures

The EPO as ISA in 2019



ISRs established in 2019

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



Course 3: PCT Practice



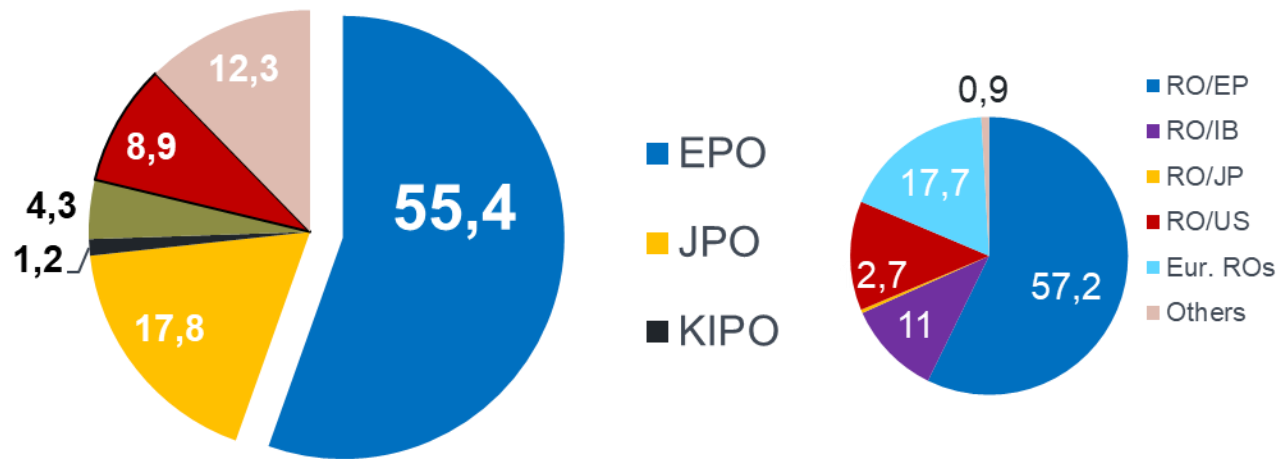
Facts & figures

- The EPO as ISA in 2019
- **The EPO as IPEA in 2019**

Facts and figures

The EPO as IPEA in 2019

Origin of Demands received



IPERs established in 2019

Course 3: PCT Practice



COVID-19: available remedies

- Disruptions caused by the COVID-19 outbreak
- Safety nets at the EPO
- Restoration of the priority right
- Additional information

COVID-19: available remedies



Disruptions caused by the COVID-19 outbreak

- 11 March 2020: WHO declares COVID-19 outbreak as a health emergency with global impact and as a pandemic
- Many countries declared **a state of emergency**
- → consequences/restrictions in the movement of people, having considerable effects on various services and public life as such

COVID-19: available remedies



Safety nets at the EPO

- Notice from the EPO published in May 2020 on the available safeguards under the EPC and the PCT in case of delays in meeting time limits
- Rule 134(2) EPC: Periods expiring on or after 15 March 2020 **extended** until 2 June 2020 for all parties and their representatives
- Extension valid for Euro-direct and Euro-PCT applications, as well as for international applications under the PCT (Art. 150 (2) EPC, supplementary application of the EPC)

COVID-19: available remedies



Safety nets at the EPO

- Extension are granted to all actions to be performed within a certain period before the EPO as laid down in the PCT



Exception: Priority period



Restoration of priority right under R. 26*bis*.3 PCT

- Extensions also applicable to payment of fees during the intl. phase (cf Notice from the EPO dated 30 March 2020, OJ EPO 2020, A38).

COVID-19: available remedies



Situation post 2 June 2020

- Safeguards continue to apply in case of disruptions in the state where the applicant/party is residing (R. 134 (5) EPC and [R. 82quater.1 PCT](#)).

✓ Request

✓ Declaration

✓ Link disruption – delay

✓ Evidence

COVID-19: available remedies



EPO proposal for new PCT rule (I)



Automatic effect (without declaration)

Extension of periods to be declared by a PCT Authority and information – incl. period - published



Legal certainty

Proper legal basis in the PCT; no need to apply national/regional law for extension of periods



Convergence of practices

In case of a general disruption: same practice under national/regional law as under PCT



Flexibility

Discretion for each PCT Authority to apply, declare, extend etc. in case of a general disruption

COVID-19: available remedies



EPO proposal for new PCT rule (II)



Transparency

Due to publication by the respective PCT Authority/International Bureau of WIPO, applicants, 3rd parties and designated Offices are informed



Evidence

The publication of applicability of new rule could serve as evidence for applicants to substantiate requests under R. 82quater.1 PCT

COVID-19: available remedies



Restoration of the right of priority

- Time limit not fixed in the PCT regulations
- Request under R. 26*bis*.3 PCT
- Statement of reasons
- Exceptional circumstances

Question 1



Question

The 31 months time limit to enter the European phase expired on 15 May 2020. May an applicant enter the European phase on 2 June 2020 without losing rights and without paying further fees?



yes no

Question 1 – solution



Solution

The 31 months time limit to enter the European phase expired on 15 May 2020. May an applicant enter the European phase on 2 June 2020 without losing rights and without paying further fees?



→ The correct answer is: yes

Question 2



Question

An applicant filed a DE national patent application on 20 May 2019. She/he wants to file a subsequent PCT application with the EPO as receiving Office claiming the priority from the DE application. Can she/he file the international application on 2 June 2020 without losing the priority right?



yes no

Question 2 – solution



Solution

An applicant filed a DE national patent application on 20 May 2019. He wants to file a subsequent PCT application with the EPO as receiving Office claiming the priority from the DE application. Can he file the international application on 2 June 2020 without losing the priority right?



→ The correct answer is: no

COVID-19: available remedies



Additional information

Up-to-date information from the EPO regarding COVID-19


➤ <https://www.epo.org/news-events/covid-19.html>

Further information from WIPO:

➤ https://www.wipo.int/pct/en/covid_19/covid_update.html

➤ https://www.wipo.int/pct/en/news/2020/news_0009.html

PCT Direct (I)

- 1st filing application **searched by EPO**
 - EPO issues search report and written opinion – 6m
- PCT application with **EPO as International Searching Authority** claiming priority from the 1st filing application
- **Amendments** in response to the search report and opinion established by the EPO for the 1st filing
 - PCT Direct**  **Letter accompanying your 2nd filing**
- **EPO** establishes a new search report and written opinion based on **your** reply letter and addressing the points raised

PCT Direct (II)

Contents of the PCT Direct letter

- **A reply to the search opinion for the 1st filing**
e.g. remarks or **rebuttals** regarding specific objections
- **An explanation of amendments and their significance**
May include **marked-up copies** for improved clarity
- **An indication of subject-matter of particular interest**
Is there something **you** want the examiner to focus on?

PCT Direct (III)

Key advantages of PCT Direct

- **Solid basis for proper and early decision-making**

Provides early clarity on patentable subject-matter before publication

Focusing on the matters **you** highlight in your letter

- **Significantly more likely to lead to positive opinion in PCT**

Expedited grant in Europe and access to **Patent Prosecution Highway**

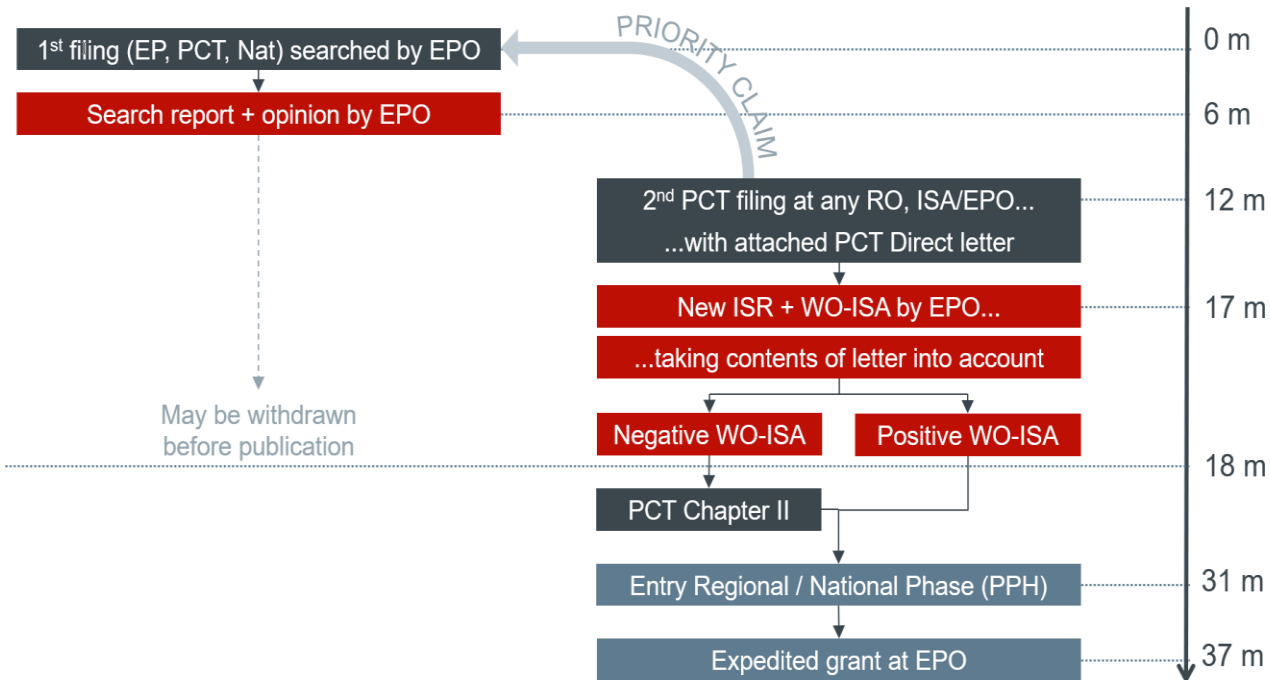
- **Simple and cost-efficient procedure**

Possibility of partial or full **refund** of 2nd search fee

May avoid need to file **demand** under PCT Chapter II

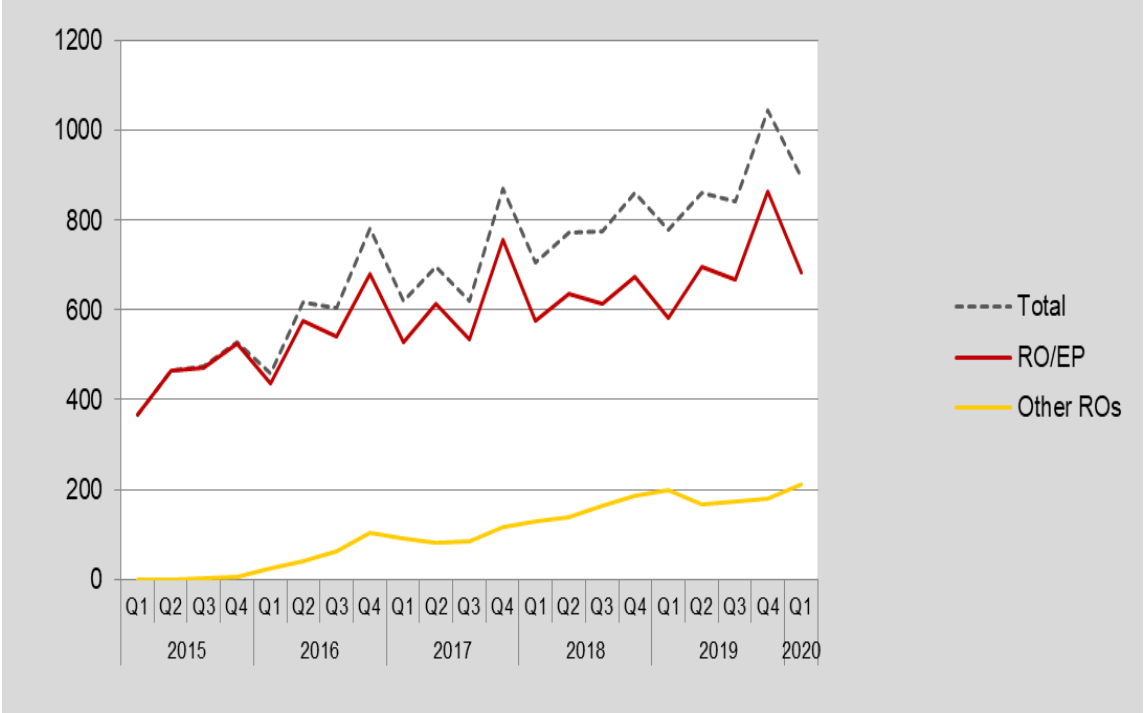
PCT Direct (IV)

PCT Direct timeline



PCT Direct (V)

3.500 PCT Direct requests in 2019, up from 2.800 in 2017



Question 3



Question

The EPO found very pertinent prior art against my first filing, an EP direct application. I then filed a PCT application claiming priority from this application, where I added subject-matter to further distinguish some of the claims from the prior art cited. Can I still use PCT direct ?



yes no

Question 3 – solution



Solution

The EPO found very pertinent prior art against my first filing, an EP direct application. I then filed a PCT application claiming priority from this application, where I added subject-matter to further distinguish some of the claims from the prior art cited. Can I still use PCT direct ?



→ The correct answer is: yes

Question 4



Question

I filed a PCT application under the PCT Direct service that now enters the European phase. Can I amend the description of this Euro-PCT application by incorporating certain comments that I made in the PCT direct letter, noting that the PCT direct letter was duly filed together with the original PCT application ?



yes no

Question 4 – solution



Solution

I filed a PCT application under the PCT Direct service that now enters the European phase. Can I amend the description of this Euro-PCT application by incorporating certain comments that I made in the PCT direct letter, noting that the PCT direct letter was duly filed together with the original PCT application ?



→ The correct answer is: no

Further questions



Questions

now

via chat to "All Panelists"

later

via mail → academy@epo.org

Question & answer
session