PCT at the EPO (advanced)
PCT Practice – A practical update on EPO services in the framework of the PCT
Presenting today

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At the EPO since 2011

Degrees in Law and Business Law at the University of Innsbruck (Austria) and University of Salamanca (Spain)

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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

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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 (%)

- EPO: 32.1%
- JPO: 8.7%
- KIPO: 6.9%
- CNIPA: 21%
- USPTO: 10.8%
- Others: 20.5%

- RO/EP: 46.6%
- RO/IB: 25.9%
- RO/JP: 15.7%
- RO/US: 1.1%
- Other Eur.: 0.6%
- Others: 1.1%
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

IPERs established in 2019

Origin of Demands received

- EPO: 57.2%
- JPO: 17.7%
- KIPO: 11%
- Others: 0.9%
- RO/EP: 8.9%
- RO/IB: 4.3%
- RO/JP: 12.3%
- RO/US: 1.2%
- Eur. ROs: 2.7%
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. 26bis.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 prososal 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 applicabality 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. 26bis.3 PCT
- Statement of reasons
- Exceptional circumstances
Question 1

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
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


Further information from WIPO:

➢ https://www.wipo.int/pct/en/covid_19/covid_update.html
PCT Direct (I)

- 1\textsuperscript{st} filing application \textbf{searched by EPO}
  - EPO issues search report and written opinion – 6m

- PCT application with \textbf{EPO as International Searching Authority} claiming priority from the 1\textsuperscript{st} filing application

- \textbf{Amendments} in response to the search report and opinion established by the EPO for the 1\textsuperscript{st} filing

- \textbf{Letter accompanying your 2\textsuperscript{nd} 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?
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

1st filing (EP, PCT, Nat) searched by EPO

Search report + opinion by EPO

May be withdrawn before publication

2nd PCT filing at any RO, ISA/EPO...
...with attached PCT Direct letter

New ISR + WO-ISA by EPO...
...taking contents of letter into account

Negative WO-ISA

Positive WO-ISA

PCT Chapter II

Entry Regional / National Phase (PPH)

Expedited grant at EPO
PCT Direct (V)

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