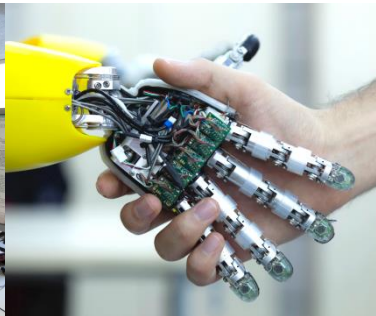




Europäisches  
Patentamt  
European  
Patent Office  
Office européen  
des brevets

# PCT at the EPO

## Filing with the EPO as receiving Office



Camille Bogliolo, Head of Department, PCT Affairs, EPO

Elke von Brevern, Expert, PCT Affairs, EPO

10 April 2019

## Presenting today



**Camille Bogliolo (FR)**

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Head of Department, PCT Affairs  
EPO Munich

At the EPO since 2006

Graduate of Sciences-Po (Paris), Master of Arts (University of Kent, Canterbury) and Master of Laws (Universiteit Maastricht)

Lawyer in International and European Affairs at INPI France (Paris) and in PCT Affairs at WIPO (Geneva)

## Presenting today



**Elke von Brevern (DE)**

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Expert in PCT Affairs Department  
EPO Munich

At the EPO since 2008

Paralegal at various Patent Attorney firms (Germany) (2000-2008)

Formalities Officer (2008-2010), Online Filing Application Manager (2010-2015) at the EPO

In the context of the PCT Affairs Department coordination of PCT-related projects implementation at the EPO

# Filing with the EPO as receiving Office



## Agenda

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- § Reasons for entering the PCT route
- § Main features of the EPO as receiving Office
- § Conditions for selecting the EPO as receiving Office
- § Overview of new services
- § Safety nets
- § An example: restoration of right of priority

# Filing with the EPO as receiving Office



## Agenda

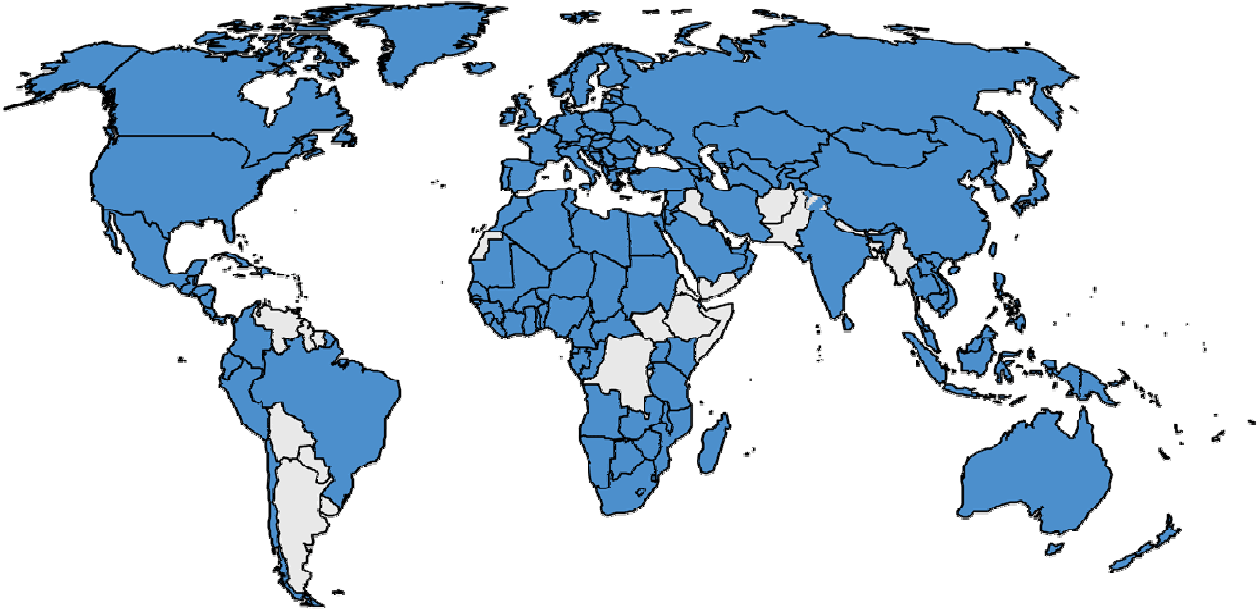
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- § **Reasons for entering the PCT route**
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- § Example of safety net: restoration of right of priority

# Reasons for entering the PCT route



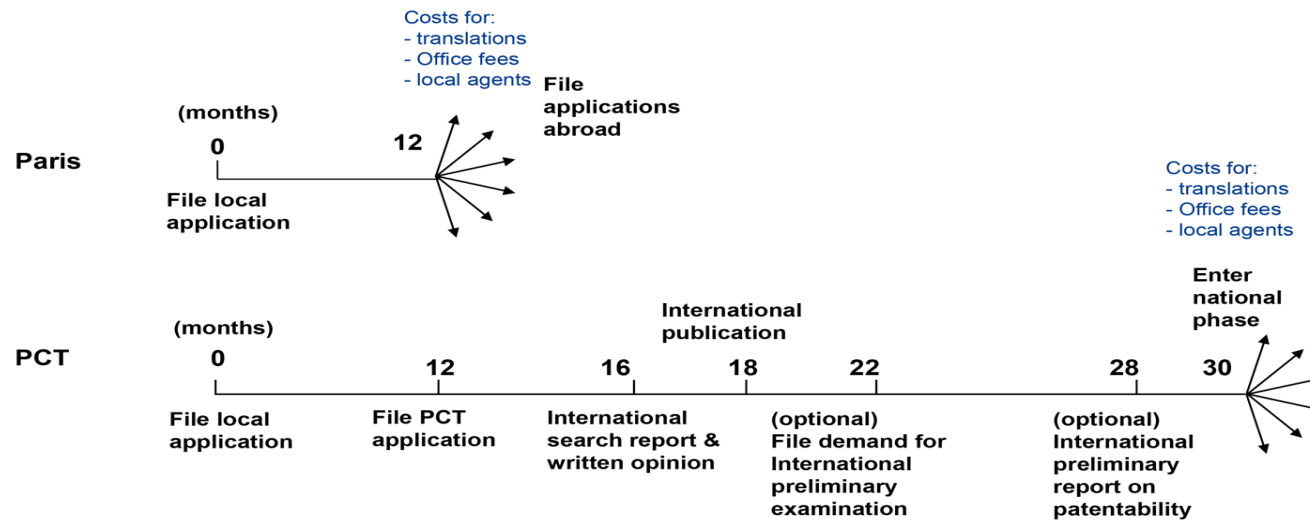
Wide coverage: 152 PCT Contracting States



# Reasons for entering the PCT route



## Overview of Paris and PCT route



## Reasons for entering the PCT route



### Why PCT?

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- § Time gain and cost savings
- § Strong basis for strategic decisions prior to entry into regional or national phase
- § Administrative efficiency
- § Automatic all-designation system



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## Main features of the EPO as receiving Office



### Main Features

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- § The EPO is the 4th receiving Office worldwide with approximately **36 700** applications **in 2018** (15% of the total)
- § **'One-stop-shop'** (EPO=RO+ISA+DO): cost-efficient and timely handling of applications throughout granting process
- § **Three languages** accepted for filing:  
English, French or German
- § **Electronic filing** using EPO tools (Online Filing, CMS) or WIPO's ePCT tool

**Rule 12.1 PCT**  
**Rule 157(2) EPC**

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## Conditions for selecting the EPO as receiving Office



### Nationality or residence

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§ The EPO is receiving office for all EPC Contracting States à receives applications from:

- **nationals** from EPC Contracting States, or
- **residents** in an EPC Contracting State

§ Delegation of receiving Office functions of Belgium and Monaco

**Rule 19.1**  
**Rule 157(2) EPC**

**OJ EPO 2018, A17 and A105**

## Question 1



### Question

May an international application be filed with the EPO as receiving Office if only the inventor is a national or resident of an EPC Contracting State?



yes  no

## Question 1 – solution



### Solution

May an international application be filed with the EPO as receiving Office if only the inventor is a national or resident of an EPC Contracting State?



à The correct answer is: **ý no**

## Question 2



### Question

If there are several applicants, may the application be filed with the EPO acting as receiving Office if only one of the applicants is a national or resident of an EPC Contracting State?



yes  no

## Question 2 – solution



### Solution

If there are several applicants, may the application be filed with the EPO acting as receiving Office if only one of the applicants is a national or resident of an EPC Contracting State?



Rule 19.2 PCT

à The correct answer is: **yes**



# Filing with the EPO as receiving Office



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- § Safety nets
- § Example of safety net: restoration of right of priority

## Overview of new services



### User-friendliness

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§ Payment by **credit card** (01.12.2017)

§ **Fee refund procedures** (01.04.2019)

} via  
Online Fee Payment  
Portal

§ **Dossier Access System** available for international applications (01.04.2019)

OJ EPO 2017, A73

OJ EPO 2019, A26

OJ EPO 2019, A27

# Filing with the EPO as receiving Office



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- § **Safety nets**
- § An example: restoration of right of priority

## Safety nets



### Examples of remedies *ex officio*

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- § **Sequence listing** filed on the same date as the international application
  
- § Duty to transmit to the IB if certain requirements are not met:
  - **Nationality or residence** (competence)
  - **Prescribed language**

**PCT/GL/RO 222**

**Rule 19.4 PCT**

## Question 3



### Question

If the international application is transmitted to the IB pursuant to Rule 19.4 PCT, will the international filing date be affected by the transmittal?



yes  no

## Question 3 – solution



### Solution

If the international application is transmitted to the IB pursuant to Rule 19.4 PCT, will the international filing date be affected by the transmittal?



- à The correct answer is: **ý no**
- à This is a safeguard for applicants: The international application is considered to have been received by RO/EP on behalf of the IB

**Rule 19.4(b) PCT**

## Safety nets



### Examples of remedies upon request

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- § Restoration of right of priority
- § Incorporation by reference of missing parts
- § Rectification of obvious mistakes

**Rule 26bis.3 PCT**

**Rule 4.18 and 20.6 PCT**

**Rule 91 PCT**

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- § **Example of safety net: restoration of right of priority**



# Restoration of right of priority



## Background and purpose

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- § Concept introduced in **Patent Law Treaty**
- § Introduced in the **PCT** on 1.04.2007
- § Few notifications of incompatibility with national law (13 receiving Offices including BR, DE, IN, KR, IT and 14 designated Offices including BR, DE, IN, KR, CN)
- § Restoration in the international phase / European phase
- § **Retention principle**

**Article 13 PLT**

**Rule 26bis.3 PCT**

**Rule 26bis.3(j) PCT**

# Restoration of right of priority



## Admissibility

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§ International filing date within 2 months from the date on which the priority period expired

§ Within this 2-month period:

- Filing **request** for restoration
- Paying **fee** for restoration (RO/EP: 640 EUR); time limit for payment may be extended by 2 months (exceptionally)
- Furnishing **statement of reasons**; may be supported by declarations or other evidence

Rule 26bis.3(a) PCT

Rule 26bis.3(b) and (d) PCT

## Question 4



### Question

If a priority claim is not contained in the request of the international application, may the applicant subsequently add the priority claim after requesting restoration of the right of priority?



yes  no

## Question 4 – solution



### Solution

If a priority claim is not contained in the request of the international application, may the applicant subsequently add the priority claim after requesting restoration of the right of priority?



- à The correct answer is: **yes**
- à Provided the notice adding the priority claim is submitted within 2-months from the expiry of the priority period

**Rule 26bis.3(c) PCT**  
**Rule 26bis.1(a) PCT**

## Restoration of right of priority



### Merits (1/2)

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- § Failure to file within the priority period occurred **in spite of due care** required by the circumstances having been taken
  
- § Non-compliance with the time limit must result either from:
  - an **exceptional circumstance**, or
  - an **isolated mistake** within a normally satisfactory system for monitoring time limits

Rule 26bis.3(a)(i) PCT  
PCT/RO/GL, 166ff

J 2/86

## Restoration of right of priority



### Merits (2/2)

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- § Primary responsibility lies with the **applicant**:
  - proper instructions to the agent
  
- § **Agent** has to show due care by virtue of the delegation:
  - expertise entails higher standard
  
- § ‘Due care’ of the agent in dealing with an **assistant**: isolated mistake by an assistant entrusted with a routine task, if:
  - suitable person selected for the task
  - properly instructed
  - reasonably supervised

J 5/80

## Question 5



### Question

May a culpable mistake by an experienced, sufficiently instructed and properly supervised assistant be excused?



yes  no

## Question 5 – solution



### Solution

May a culpable mistake by an experienced, sufficiently instructed and properly supervised assistant be excused?



à The correct answer is: **no** yes

à Higher standard of due care for agent



## Looking for more infos?



### Recommended sources of information

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§ WIPO's PCT Applicant's Guide:

<https://www.wipo.int/pct/en/guide/index.html>

§ EPO's Euro-PCT Guide, Part B :

<https://www.epo.org/applying/international/guide-for-applicants.html>

§ EPO's website / PCT pages :

<https://www.epo.org/applying/international.html>

§ WIPO's PCT Newsletter:

<https://www.wipo.int/pct/en/newslett/>

## Further questions



### Questions

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**now**

via chat to "All Panelists"

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**later**

via mail è [academy@epo.org](mailto:academy@epo.org)

**Question & answer  
session**