



Europäisches
Patentamt
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Patent Office
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des brevets

The European Patent Office as International Searching Authority

PCT Chapter I



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Presenting today



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Lawyer in PCT Affairs Department
EPO Munich

At the EPO since 2006

Law Degree and Master in International Law and IP in ESADE
(Spain) and Molecular Biology Degree in Open University (UK)

Lawyer (M&A and IP) at Uría Menéndez (Spain) (2004-2006)

Member of the EQE committee since 2016

Presenting today



Elke von Brevern (DE)

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

Coordinator of PCT-related projects implementation at the EPO

The EPO as International Searching Authority



Agenda

- § The EPO leading ISA in 2018
- § High quality searches and written opinions
- § Competence of the EPO to act as ISA
- § Overview of new services
- § Collaborative Search and Examination pilot
- § Applicant friendly fee policy

The EPO as International Searching Authority

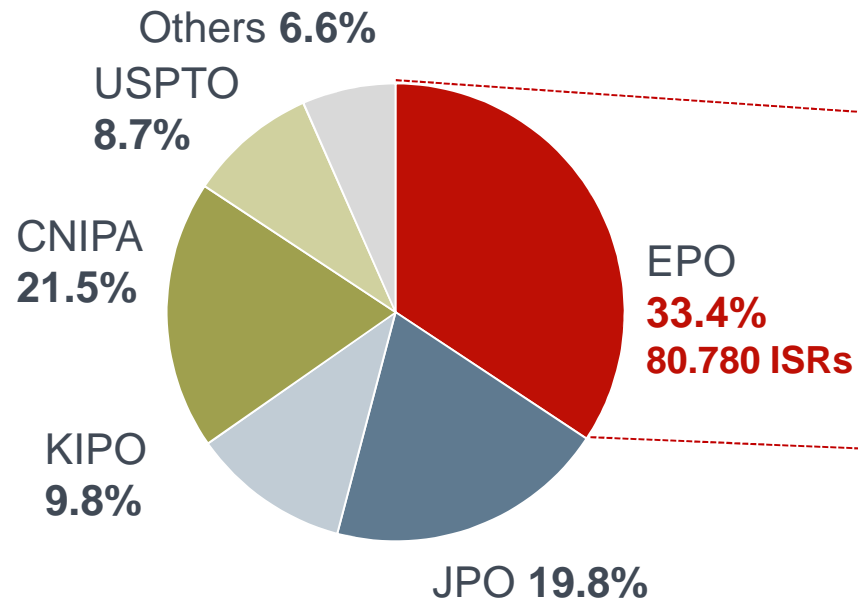


Agenda

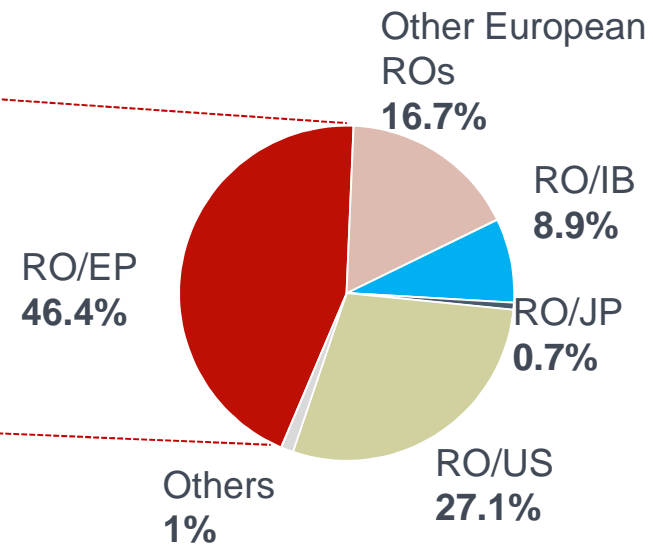
- § **The EPO leading ISA in 2018**
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The EPO leading ISA in 2018

International Search Reports established in 2018



Origin of Search Copies by ROs received by ISA/EP in 2018



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High quality searches and written opinions



Why selecting the EPO as ISA?

§ One standard for all searches at the EPO

- Scope, databases and examiners

§ Written Opinion

- Thorough non-binding opinion on patentability
- Equivalent to the European search opinion
- Sound basis for informed decision prior to national phase entry

§ Improved timeliness

- 96,5% (2018) = A1 publications

§ Relevance during PCT Chapter II

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Competence of the EPO to act as ISA



ISA specified by RO and selected by applicant

- § RO needs to have specified the EPO as ISA
- § **Most ROs have specified the EPO as ISA:** Only 8 exceptions: AU, CA, DM, KN, PG, CN, KR and AE
- § Applicant selects ISA in Box No. VII PCT/RO/101

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Overview of new services delivered by EPO as ISA



PCT-Direct service (1/2)

- § Since 2014, applicants selecting the EPO as ISA are entitled to submit PCT-Direct letters **together with PCT/RO/101**
- § The international application **must claim priority** from an **earlier application already searched by the EPO**
- § **Opportunity to react to objections** raised in earlier search opinion
- § Available via **public file inspection**

OJ EPO 2014, A89
OJ EPO 2017, A21

Overview of new services delivered by EPO as ISA



PCT-Direct service (2/2)

- § EPO examiner will establish ISR and WO-ISA **taking into account informal comments** on the earlier search opinion
- § Since 2017, PCT Direct letter acknowledged in the written opinion
- § However, explicit reference to the earlier search opinion only if it is annexed to the PCT Direct letter

Overview of new services delivered by EPO as ISA



Information sheet on Search Strategy (1/2)

- § Since 2015, Information sheet on Search Strategy **annexed to all search reports established by EPO**
- § Contains relevant data on **classification, databases** and **keywords** used by EPO examiners when performing the search
- § Available via **public file inspection**

OJ EPO 2017, A106

Overview of new services delivered by EPO as ISA



Information sheet on Search Strategy (2/2)

§ **Benefits** of providing information about the search strategy:

- Increase user confidence in the quality of the search report
- Facilitates internal quality reviews
- Can be generally understood (no need for specialist knowledge)

§ Outcome of user feedback

Overview of new services delivered by EPO as ISA



Provisional opinion on partial search results

- § Instances of lack of unity of invention
- § Since 2017, the EPO provides a **provisional opinion** on the patentability of the invention first mentioned in the claims together with the invitation to pay additional search fees and the partial search results
- § The provisional opinion is **for information only**
- § Available via **public file inspection**

Rule 40 PCT

OJ EPO 2017, A20

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Collaborative Search and Examination pilot



Concept and purpose

- § Developed and tested by the **IP5 Offices**
- § PCT search and written opinion by the main ISA **in collaboration** with 'peer' ISAs which furnish contributions and feedback
- § **Increased legal certainty** early on in the procedure

OJ EPO 2018, A47 and A97

Collaborative Search and Examination pilot



Current phase of the pilot (Phase 3)

- § Pilot in **operational phase** to:
 - gauge users' interest for a CS&E product
 - asses expected benefits for both users and Offices
 - decision as to the future of this concept

- § **Applicant driven**: upon request by the applicant

- § **Same number** of applications **per competent ISA**: 100 each over 2 years

- § Started only for applications in **English**, now open to **French** and **German**

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Applicant friendly fee policy



PCT search fee

- § PCT search fee **reduced by 5%** (EUR 100):
currently EUR 1 775

- § **No European supplementary search if the EPO acted as ISA**
(no European supplementary search fees due)

- § Partial or total **PCT search fee refund mechanisms** if the
earlier search of the priority validly claimed was established
by the EPO

Further questions



Questions

now

via chat to "All Panelists"

later

via mail è academy@epo.org

**Question & answer
session**