

Learning path for patent administrators

Entry into the European phase: formal requirements and examination: EPAC - entry level

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Introduction

This publication, "Entry into the European phase: formal requirements and examination, EPAC - entry level", is part of the "Learning path for patent administrators" series is edited and published by the European Patent Academy. The series is intended for patent administrators who are taking part in training and certifications organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include: general aspects of the patent system; the European patent system and the European patent granting procedure; the International Patent System (PCT) and the PCT procedure; European and international publications; filing a European patent application and filing an international application; the formalities during the European and during the international search; the formalities during the European examination and during the international preliminary examination; the formalities during the appeal procedure after refusal (EPC), during the opposition procedure (EPC); national validation (EPC); entry into national/regional phases and entry into the European phase (PCT).

Each chapter focuses on one topic at entry, intermediate or advanced level, as appropriate. The series will be revised annually to ensure it remains up to date.

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All references to natural persons are to be understood as applying to all genders.

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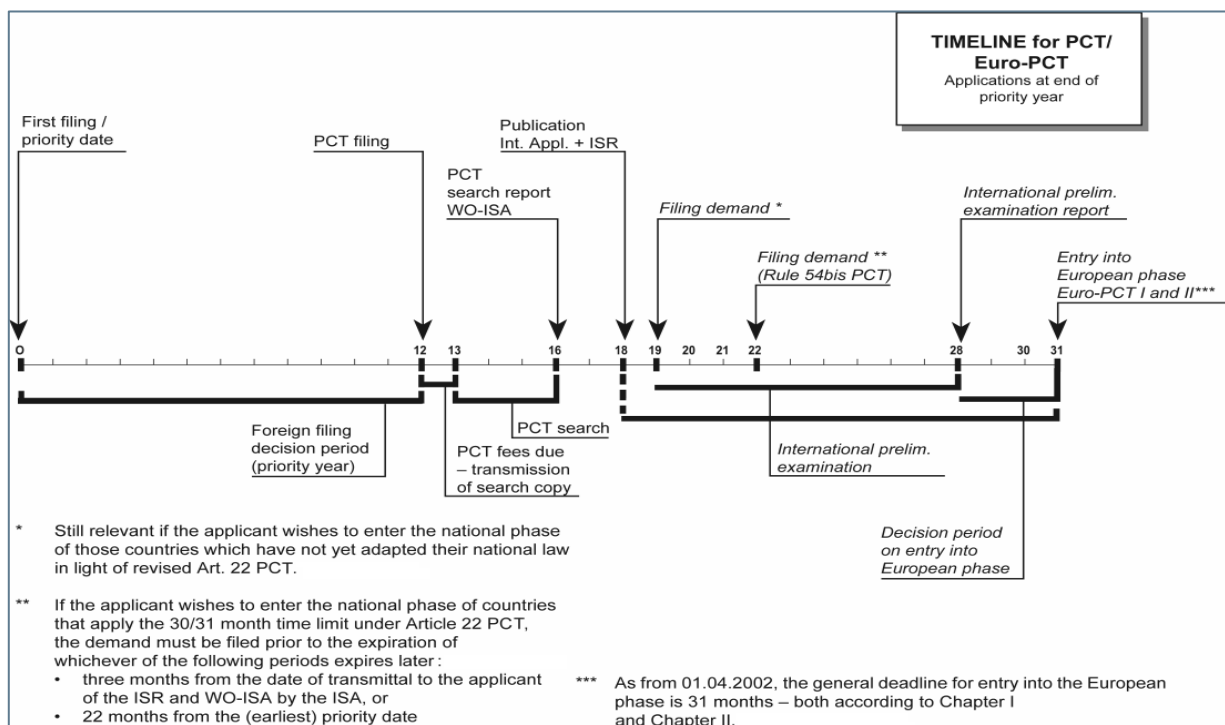
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1. Learning objectives

Participants in this course will learn about

- the timeline for the European phase
- the requirements before the 31-month time limit
- how to accelerate the examination procedure
- the requirements for early processing
- the publication of Euro-PCT applications
- the correction of Euro-PCT publications

2. Timeline for the European phase



3. Requirements before the 31-month time limit

A national or regional office before which an international application (IA) is continued is called the designated Office (DO), or, if international preliminary examination took place, elected Office (EO).

Since all EPC contracting states are PCT contracting states, the EPO can act as DO for any EPC contracting state, provided the IA was filed on or after the date on which the EPC entered into force for the state concerned. An IA entering the regional phase before the EPO is called a Euro-PCT application.

For the EPO as EO, the same requirements apply as for the EPO acting as DO. In addition, however, at least one of the EPC contracting states must have been elected for a European patent in the demand for international preliminary examination. Since the filing of the demand constitutes the election of all PCT contracting states that were designated, this requirement will automatically be met in respect of each state that was an EPC contracting state on the international filing date, unless the applicant has withdrawn such election in the meantime.

The process generally referred to as "entry into the European phase" is not an act in itself, but a bundle of requirements to be fulfilled within 31 months from the international filing date or, where applicable, the earliest priority date claimed for the international application ("31-month time limit").

Which requirements are to be fulfilled within the 31-month time limit depends to a certain extent on the particular case, but they can be summarised in general as follows:

- supplying a translation, if the Euro-PCT application was not published in one of the EPO's official languages
- specifying the application documents on which the European grant procedure is to be based
- paying the filing fee provided for in [Article 78\(2\) EPC](#), including an additional fee for applications with more than 35 pages
- paying the designation fee (and any extension or validation fees) if the period under [Rule 39 EPC](#) has expired earlier and
- paying the search fee if a supplementary European search report is to be drawn up

In order to enter the European phase, the applicant must at least take the following steps within 31 months from the filing date or, if priority has been claimed, from the earliest priority date:

- file the request for examination and pay the examination fee if the period under [Rule 70\(1\) EPC](#) has expired earlier
- pay the renewal fee due in respect of the third year under [Article 86\(1\) EPC](#) (if the fee has fallen due earlier under [Rule 51\(1\) EPC](#)) and
- where applicable (in rare cases) file the certificate of exhibition mentioned in [Article 55\(2\) EPC](#)

Legal references:

[Art. 153\(1\), \(4\), \(7\) EPC](#)

[Rule 159\(1\) EPC](#)

[Art. 2\(xiii\) and \(xiv\) PCT](#)

[GL/EPO E-IX, 2](#)

4. Foreign agents and their role in the national procedure

Applicants who do not have a principal place of business or residence within the territory of one of the contracting states to the EPC must be represented in all proceedings before the EPO ([Art. 133\(2\) EPC](#)). However, before expiry of the period of 31 months under [Art. 22\(3\)](#) and [39\(1\) PCT](#) in conjunction with [Rule 159\(1\) EPC](#), non-resident applicants may take the steps for entry into the European phase themselves by filling in, signing and filing EPO [Form 1200](#) plus a translation of the IA if required.

Agents for the international phase may continue to act on behalf of the applicant only if they are recognised professional European representatives and have also been authorised to represent the applicant during the European phase.

See also [Guide for applicants: Chapter 5 – Euro-PCT procedure before the EPO as a designated \(PCT Chapter I\) or elected \(PCT Chapter II\) Office](#).

Legal references:

[Art. 133\(2\) EPC](#)

[Rule 159\(1\) EPC](#)

5. Acceleration of the examination procedure

Applicants who want to request accelerated prosecution of their Euro-PCT application must submit a separate online request under the PACE programme using EPO [Form 1005](#).

If the [Rule 70\(1\) EPC](#) period for requesting examination has not yet expired when entering the European phase early, prosecution can be accelerated if the request for examination is filed together with the request for early entry. If a supplementary European search report has to be drafted, prosecution can be accelerated by waiving the [Rule 70\(2\) EPC](#) communication in EPO [Form 1200](#).

Even if a PACE request has been filed, the EPO will have to respect the six-month time limit provided for in [Rules 161 and 162 EPC](#) and will therefore not start supplementary European search or examination before expiry of that time limit.

Applicants interested in accelerating the proceedings may therefore consider waiving their right to the [Rule 161/162](#) communication, which they can do by selecting the first check box in Section 12.2 of EPO [Form 1200](#).

To ensure the waiver is effective, they must not pay any claims fees by automatic debit order as they will then not be debited until the last day of the six-month period under [Rule 162\(2\) EPC](#). Instead, they must already pay them on (early) entry into the European phase.

Legal references:

[Rule 10\(4\), 70\(1\), \(2\), 161, 162, \(2\) EPC](#)

[OJ EPO 2013, 156, 15, 2015, A93, 2015, A94](#)

[GL/EPO E-VIII, 4](#)

6. Early processing

A valid request for early processing causes prosecution of the Euro-PCT application to be taken up before expiry of the 31-month time limit. A request for early processing, however, does not lead to accelerated prosecution.

Such a request does not require specific wording, but the applicant must clearly state that they wish the processing of their application before the EPO as designated/elected Office to commence early under [Art. 23\(2\) PCT](#) or [Art. 40\(2\) PCT](#).

Automatic debiting cannot be used for payments to be made for this matter. Applicants must use a different method of payment.

For the request to be effective, the applicant must comply with the requirements of [Rule 159\(1\) EPC](#) as if the 31-month period expired on the date the applicant requests early processing. Please note that these so-called necessary requirements to make a request effective have no basis in the EPC.

The following requirements must be complied with to make a request effective:

- payment of the filing fee, including an additional fee for applications with more than 35 pages
- filing of a translation if required
- filing the specification of the application documents and
- payment of the search fee if a supplementary European search report has to be drawn up

Legal references:

Rule 10, 159 EPC

Art. 153 EPC

Art. 23(1), 40(1) PCT

7. Subsequent requirements

Fulfilment of a further requirement of Rule 159(1) EPC, for which the period has not yet expired when filing the request, does not affect the request becoming effective.

Examples of these requirements are the payment of the designation fee, the payment of a renewal fee or the filing of a request for examination.

Such further requirements must be complied with before expiry of the appropriate period, even if such a period expires before the end of the 31-month period.

Legal references:

Rule 39(1), 51(1), 70(1), 159(1) EPC

8. Publication of Euro-PCT applications

An IA published in one of the three official languages of the EPO (DE, EN or FR) enjoys, subject to the provisions of Article 67(2) and (3) EPC, provisional protection as from the date of the international publication.

After entry of the IA into the European phase, the EPO notifies applicants of the publication of the IA's bibliographic data in the European Patent Bulletin and confirms that the application enjoys provisional protection in the individual EPC contracting states.

If international publication took place in a language other than DE, EN or FR, the EPO will publish the translation of the Euro-PCT application submitted by the applicant upon entry into the European phase. In that case, the provisional protection is only effective as from the date the translation is published.

The translation of the Euro-PCT application is published together with the bibliographic data as an A-document and includes all documents that were part of the international publication.

The mandatory translation of the annexes to the IPRP and any amendments to the application documents filed on or after entry into the European phase are not published.

Pursuant to Article 153(6) EPC, the international search report takes the place of the European search report. Once the supplementary European search report has been drawn up, this will be mentioned in the [European Patent Bulletin](#), Part I.1(4).

The supplementary search report itself is not published but is available via public file inspection.

Legal references:

Art. 67, 153(3), (4), (6) EPC

Art. 11(3), 29(1), (2) PCT
R. 48.2 PCT
GL/EPO E-IX, 2.5.1

9. Correction of Euro-PCT publications

If the applicant proves to the satisfaction of the EPO that

- the international filing date (IFD) is incorrect owing to an error made by the receiving Office (RO) or
- that the RO or the International Bureau (IB) erroneously considered a priority claim not to have been made

and if the error is an error such that, had it been made by the EPO itself, the EPO would rectify it under EPC law or practice, then

- the EPO must rectify the error and treat the IA as if it had been accorded the rectified IFD or as if the priority claim had not been considered not to have been made.

Further, if an RO accords the IFD on the basis of incorporation by reference, the EPO as DO/EO will review this finding in terms of whether the requirements listed in Rule 82ter.1(b)(i)-(iii) PCT have been complied with.

If the EPO does not agree with the finding of the RO, it will notify the applicant that it intends to consider the (later) date on which the missing element or part was furnished as the IFD in the European patent grant procedure. The applicant will be given the opportunity to comment.

Further, in the case of missing parts, the applicant may also request that the missing part concerned be disregarded in the European patent grant procedure. In that case, the missing part will be considered not to have been furnished and the EPO will not treat the IA as if the IFD had been corrected.

Legal references:

Rule 82ter.1(a), (b)(i)-(iii), (c), (d) PCT
GL/EPO E-IX, 2.9.3

10. Beyond the course

You can deepen what you have learned during this course with the following further reading:

- [Guide for applicants \(Chapter 5 – Euro-PCT procedure before the EPO as a designated \(PCT Chapter I\) or elected \(PCT Chapter II\) Office, EPO website](#)
- [PCT Applicant's Guide, National Phase: EP, WIPO website](#)

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