

Learning path for patent administrators

The PCT procedure: EPAC - Entry level

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Introduction

This publication, "The PCT procedure, 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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1. Learning objectives

Participants in this course will learn about:

- the roles of the different authorities under the PCT
- PCT related fees
- time limits to observe
- legal remedies in the case of a deadline being missed
- the mandatory and optional steps in the PCT procedure

2. Abbreviations

DO	designated Office
EO	elected Office
EPO	European Patent Office
IA	international application
IB	International Bureau of WIPO
IFD	international filing date
IPEA	International Preliminary Examining Authority
IPER	international preliminary examination report
IPRP1	international preliminary report on patentability, converted WO/ISA
IPRP2	international preliminary report on patentability, converted IPER
ISA	International Searching Authority
ISR	international search report
PCT	Patent Cooperation Treaty
RO	receiving Office
SEQL	sequence listing
SISA	Authority specified for supplementary international search
SISR	supplementary international search report
WIPO	World Intellectual Property Organization
WO/ISA	written opinion of the International Searching Authority

Legal references:

Art. 52(2), 54(3), 82 EPC

Rule 43, 128 EPC

F-II, 4.2, G-IV, 5.3

3. The role of the RO

The main task of the RO is to receive and process international applications and related correspondence.

The RO checks that the IA is complete, complies with the applicable standards and that the fees have been duly paid.

ROs are also responsible for:

- receiving and processing translations

- requests for restoration of the right of priority
- incorporation by reference
- processing and issuing substitute sheets under Rule 26 PCT
- receiving and processing withdrawals of IAs and designations
- receiving and processing changes to priority claims

Legal references:

Art. 10 PCT

Rule 19, 20, 26 PCT

4. The role of the ISA

The ISA carries out the mandatory international search and:

- discovers relevant prior art
- gives an opinion on the patentability of the IA in terms of novelty, inventive step and industrial applicability
- points out defects in the IA that influence its patentability, e.g. claims lacking clarity or containing subject-matter not required to be searched by the ISA

The ISA's findings are summarised in the ISR and WO/ISA or, if no meaningful search can be carried out, in the declaration of non-establishment of ISR.

The ISA also issues decisions on requests for rectification of obvious mistakes under Rule 91 PCT.

Legal references:

Art. 15, 16, 17 PCT

Rule 39, 43, 43bis, 91 PCT

5. The role of the IPEA

The IPEA carries out the international preliminary examination (IPE).

In principle, the ISA standards also apply to the IPE, but it should be carried out on the basis of an amended IA (description, claims, drawings and SEQL).

The IPE is optional. Its aim is to provide the applicant with the possibility to get a deeper insight into the patentability of the IA.

Ideally, the IA is patentable at the end of the international phase.

Legal references:

Art. 32, 33, 34 PCT

Rule 66 PCT

6. The role of the SISA

The SISA carries out the supplementary international search.

Basically, the supplementary international search is an international search performed in addition to the one carried out by the ISA. It is also carried out on the basis of the original IA. There can be more than one SISA for one IA.

The supplementary international search is optional. Its aim is to provide the applicant with the possibility to get a deeper insight into the patentability of the IA.

Ideally, the IA is patentable at the end of the international phase.

Legal references:

Rule 45bis PCT

7. PCT fees

Fee	EUR	Beneficiary
Filing fee	1 235.00	IB
Page fee per sheet in excess of 30	14.00	IB
Transmittal fee	140.00	RO
Restoration fee	685.00	RO
Certified copy	110.00	RO
International/supplementary search fee	1 775.00	ISA/SISA
Protest fee/review fee	935.00	ISA/IPEA/SISA
Late furnishing fee (SEQL)	245.00	ISA
International preliminary examination fee	1 830.00	IPEA
Handling fee	186.00	IB

(Status: July 2022)

Legal references:

Rule 14, 15, 16, 26bis.3, 40.2, 45bis, 57, 58 PCT

8. Possible fee reductions

Reduction	EUR
Filing fee reduction for filing in XML format	279.00
Filing fee reduction for filing in PDF format	186.00
Filing fee reduction for filing via Webform filing	93.00

(Status: July 2022)

There are further reductions for applicants from lower-middle-income economies

- 90% filing fee reduction, subject to certain conditions
- 75% search and examination fee reduction, subject to certain conditions

9. PCT time limits

Periods expressed in months end on the day with the same number. For example, 15 January and a two-month period means 15 March.

If there is no such day, the period ends on the last day of the month. For example, 31 August and a one-month period means 30 September.

Periods expressed in days are simply counted, starting on the day after the relevant event.

A period cannot end on a day on which the office concerned is closed for business and will therefore end on the next open day.

The business day of an office usually ends at 23:59:59 hrs, local time.

Legal references:

Rule 80 PCT

10. PCT remedies

Communications from PCT authorities should be received within seven calendar days. If not, the applicant has the right to an extension of the time limit of one day for every additional day.

Whether evidence has to be filed depends on the authority in question. For the EPO, a simple statement is sufficient.

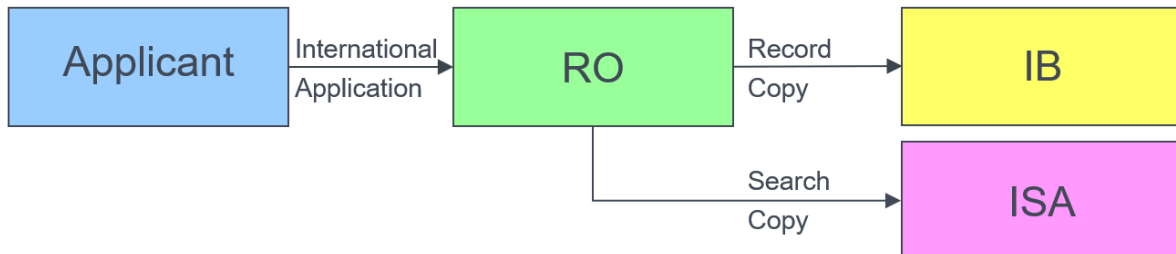
Missed time limits may be excused for reasons of war, revolution, civil disorder, strike, natural calamity, general unavailability of electronic communication means or similar reasons in the applicant's locality.

Offices affected by unavailability of electronic communication means must publish the relevant times and inform the IB.

Legal references:
Rule 80, 82 quater PCT

11. International filing and transmittal of copies

Time: 0 to 12 months from priority

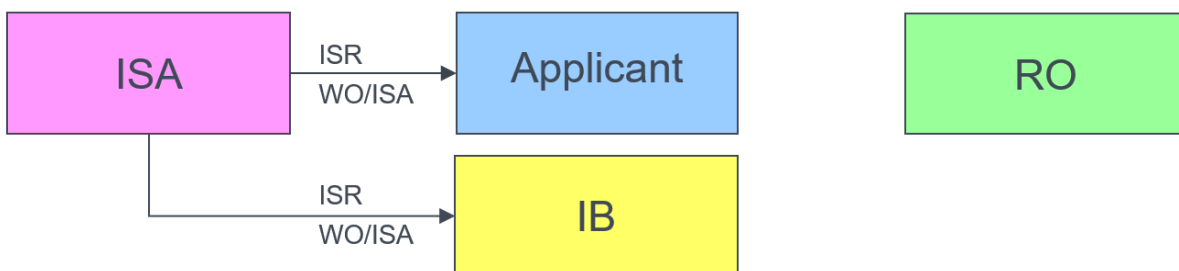


1. The applicant files an IA with an RO of their choice (if priority is claimed, within 12 months of priority).
2. The RO carries out a formal check and a fee check on the IA.
3. If the IA passes the formal check, the RO transmits the record copy to the IB.
4. If the IA passes the fee check, the RO transmits:
 - the international filing fee and page fee to the IB
 - the international search fee and search copy to the ISA

Legal references:
Rule 22, 23 PCT

12. International search

Time: 13 to 16 months from priority



The ISA:

- carries out the international search
- issues the ISR and WO/ISA
- transmits the ISR and WO/ISA to the applicant and the IB

The IB checks the ISR for international publication.

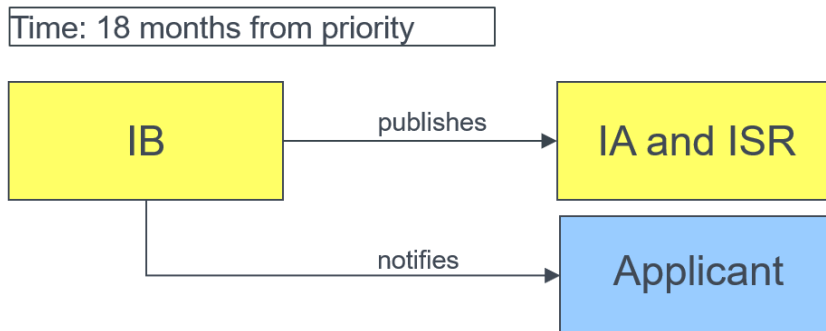
The RO is involved only peripherally, e.g. in the event of outstanding minor formal defects.

Legal references:

Art. 16, 17 PCT

Rule 35, 42, 43, 43bis, 44 PCT

13. International publication



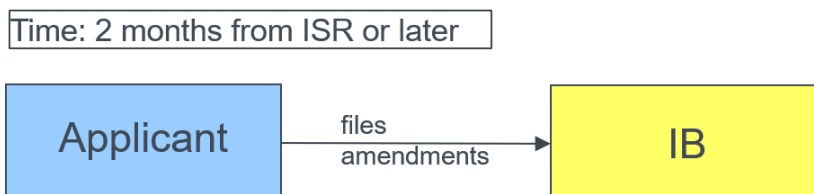
The IB publishes the IA and the ISR (if available) on PATENTSCOPE.

The IB notifies the applicant of the publication.

Legal references:

Rule 48 PCT

14. Amending claims under Art. 19 PCT



The applicant may file amended claims with the IB. The time limit for this is:

- 2 months from the date of transmittal of the ISR or
- before completion of the technical preparations for international publication, whichever expires later

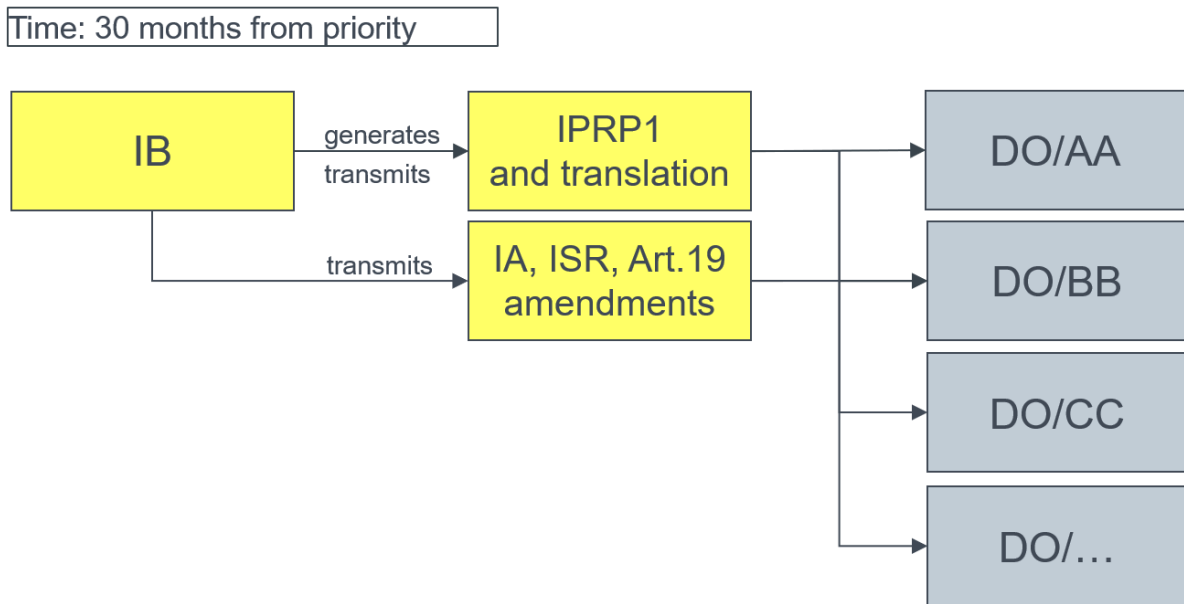
Amendments must be accompanied by a statement explaining the amendments.

Legal references:

Art. 19 PCT

Rule 46 PCT

15. Transmittal of IA and IPRP1 to DOs



The IB generates the IPRP1 and transmits it to the designated Offices together with:

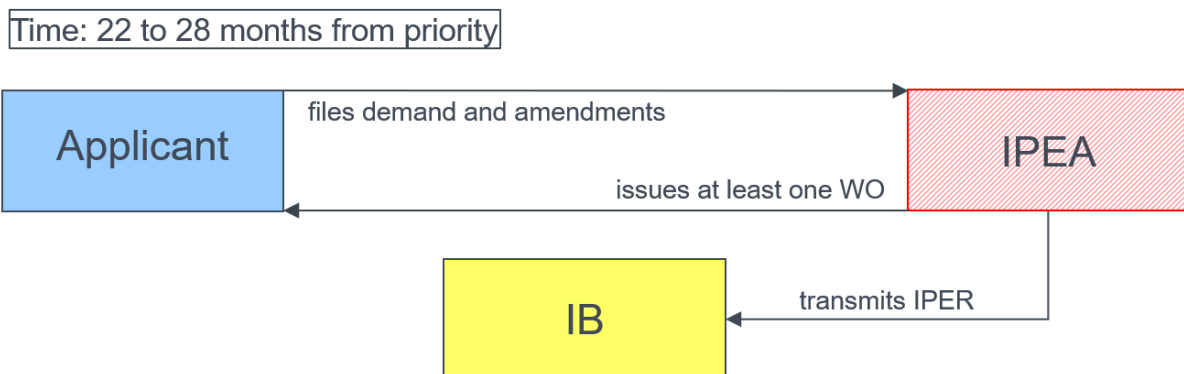
- the IA and the ISR
- a possible translation of the IPRP1
- possible amendments under Art. 19 PCT

This is the end of the international phase and national/regional processing starts.

Legal references:

Art. 20 PCT

16. International preliminary examination



The applicant has the option to file a demand for IPE.

The applicant may amend the description, claims, drawings and SEQL.

The IPEA:

- carries out a formal check and a fee check
- transmits the handling fee to the IB
- carries out the international preliminary examination

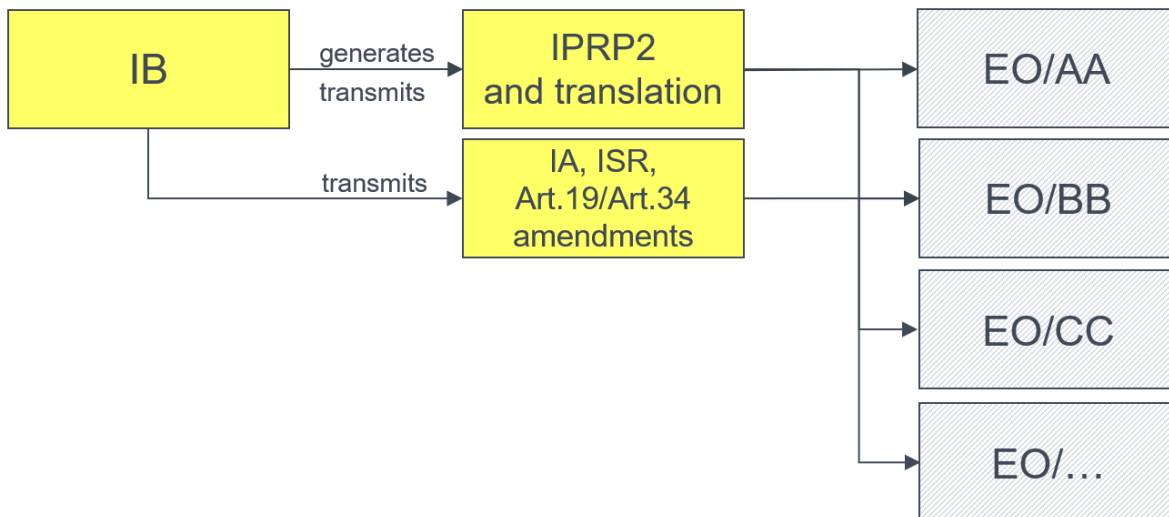
- issues one or two written opinions and transmits them to the applicant and the IB

Legal references:

Art. 33, 34 PCT

17. Transmittal of IA and IPRP2 to EOs

Time: 30 months from priority



The IB generates the IPRP2 and transmits it to the elected Offices together with:

- the IA and the ISR
- if necessary, a translation of the IPRP2 into EN
- amendments under Art. 19 and/or 34 PCT

This is the end of the international phase and national/regional processing starts.

Legal references:

Art. 36 PCT

18. Supplementary international search: request

Time: 17 to 22 months from priority



The applicant has the option to file one or more SIS requests:

- with the IB, before expiry of 22 months from priority
- subject to a handling fee and a supplementary search fee

The IB carries out a formal check and a fee check.

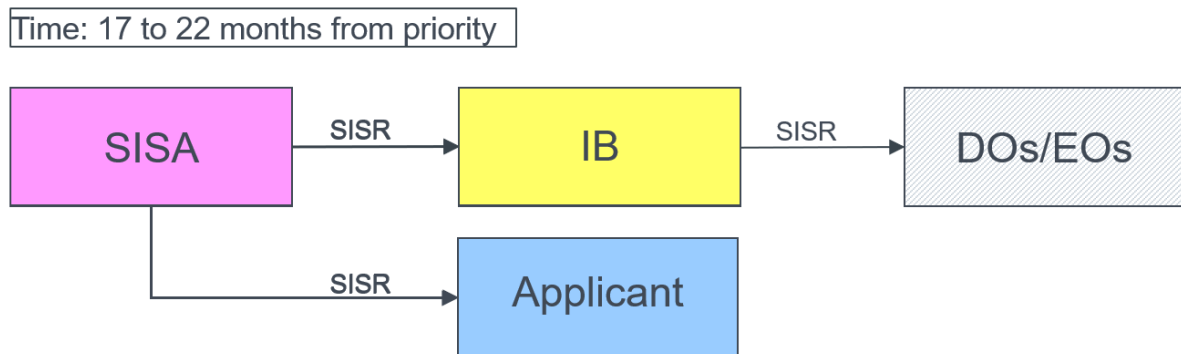
After receipt of the ISR or the expiry of 17 months from priority, whichever happens first, the IB transmits to the SISA:

- the search fee, SIS request, IA, ISR, WO/ISA, any invitation to pay additional fees
- if necessary, translations of the IA and the WO/ISA

Legal references:

Rule 45bis PCT

19. Supplementary international search: SISR



The SISA carries out the supplementary international search and transmits the SISR to the applicant and the IB.

In the event of lack of unity of invention, the SISA will not issue an invitation to pay additional fees, but the applicant has the right to request a review, which might result in a reviewed SISR.

The IB transmits the SISR to the DOs/EOs at the end of the international phase.

Legal references:

Rule 45bis PCT

20. Beyond the course

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

- [PCT Applicant's Guide, Chapter 3: international phase](#)

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