

must always be made to the official documents (the PCT, the EPC and their implementing regulations and guidelines).

Table 2: Relevant provisions and time limits relating to PCT Chapter I

DOF: date of filing

PCT: Patent Cooperation Treaty, PCC: Europea PC: Pats Convention EPO. European Patent Office IB: International Bureau RO. Receiving Office ISA International Searching Authority IPEA: International Searching Authority IPEA: International Searching Authority IPEA: International Preliminary Examination Authority WO-ISA's written option of the ISA. SIS: Supplementary International Search IPEC: 64446 officers IPEC: 64446 officers

Note: this subth relates to Chapter I PCT, however, some events occurring at the start of chapter II PCT and ton expressed (e.g., dirty a demand, region than Wo-GSA). The time scale is not accurate, and only provides a roughl idea of the sequence in which the different eventse place. Also, there are no differences between the events indicated above no breasth the time axis. Reference to time limits from the priority means time limits which are computed from the sentiest priority design. or from the filing date, where no proving is claimed.

Remark: This table is provided as annex to the book: P. Watchorn & A. Veronese "PCT Procedure: nto the European Phase". The references in brackets "§...." refer to the relevant namaranhs of the book

Priority right [§ I.8.1]

-Art.8(1) PCT: priority can be claimed from one or more applications filed in or for a Paris Convention State, or -R4.10(a) PCT: from one or more applications filed in or for a member of the World Trade Organization.

R4.10(d) PCT: any contracting state may decide not to apply R4.10(a) PCT. (The EPO lifted the reservation under R4.10(d) PCT when the EPC-2000 entered in force).

Art.8(2)(a) PCT: Conditions and effects of a priority claim are regulated by Art.4 of the Paris Convention.

Art.4C(1) PC & R2.4(a) PCT: the period for claiming priority is 12 months from the filing of the first application.

R26bis.3(a) PCT: if the 12 month period is not met. restoration can be requested within 2 months of expiry of the 12 month period. Restoration can be requested under the "unintentional" or the "all due care" criteria. Some offices (e.g. EPO) accept only the all due care criterion.

The priority claim [§ I.8.1]

R4.1(b)(i) PCT & R4.10(a) PCT: When priority is claimed, the request must indicate:

- -the date of filing of the priority document.
- -the filing number of the priority document,
- -the national office or international organization or receiving office where the priority document was filed.

The priority document [§ I.8.2]

R17.1(a) PCT: copy of the priority document, must be filed. within 16 months from the priority date at the IB or at the RO; but, if it arrives at the IB later, but before publication, it is deemed received in time

R17.1(b) PCT: if the priority document was issued by the RO, the applicant can request the RO within the same 16 month period to forward the document to the IB. A fee may be due.

For cases where digital libraries exist see § I.8.2.

Who can file ? [§ I.1]

Art.9(1) PCT: Residents / nationals of a PCT contracting State can file a PCT application (see § I.1 for assessment of residence & nationality under the PCT).

R18(3) PCT: If there is more than one applicant, at least one of them must have the

Art 27(3) PCT: The requirement that only the inventor is qualified to file a PCT application for the USA has been repealed by the America Invents Act (see § I.1.1).

Art.11(1) PCT: If the applicant lacks the right to file, the RO does not accord a filing

Where to file ? [§ I.2.1]

Art.10 PCT & R19(1)(a) PCT: The application has to be filed at the competent receiving office (RO), which is:

- -the national office of the country of residence of the applicant.
- -the national office of the country of which the applicant is national,
- -the International Bureau (IB).

R19.1(b) PCT: Other authorities (like the EPO) may have agreements to act as receiving offices for applicants which are residents or nationals of certain states

R19.4(a) PCT: If an application is filed at a receiving office which is not competent [but at least one applicant is a PCT resident or national], it is considered received on the same day by that receiving office on behalf of the International Bureau as receiving office (§ 1.2.2).

Art.27(8) PCT: The PCT does not preclude the member states from applying national security provisions limiting (for example) the applicant's freedom to file the application abroad or to subject the application to a national security check (§ 1.2.3).

Language of the application [§ I.3]

any language for filing (see R19.4(a)(ii) PCT)].

-an indication that it is intended as an international application,

date by reference to a claimed priority (see R20 PCT and § I.7).

v) it does not comply with the prescribed physical requirements.

-the name of the applicant [so that he is unambiguously identified],

•the application contains the following items:

-a part which appears to be a description,

pass the formalities checks R.26.2bis(a) PCT)

ii) it does not properly identify the applicant.

Formality checks [§ I.9.2]

iii) it does not contain a title

iv) it does not contain an abstract.

-a part which appears to be at least one claim.

Art.3(4) PCT: & R12.1(a) PCT: The application must be filed in a language which is

R157(2) EPC: The EPO as receiving office accepts PCT applications in EN, DE, FR.

R19.4(a)(ii) PCT: If the application is filed in a language which the receiving office does not accept, it is considered received on the same day by that receiving office on behalf of the International Bureau as receiving office (the IB accepts any

R.12.3(a) PCT: & R.12.4(a) PCT: depending on the language used on filing, a translation may be required.

Filing date

Art.11(1) PCT & R20.2(a) PCT: on receipt of the application, the RO accords a filing date if:

•the applicant (or at least one of them) has the right to file a PCT application at the RO

based on his residence / nationality. [In practice, to have the right to file he needs to be

resident / national of any PCT state. If he has this right, but he files at the wrong RO, the

application is deemed received on the same date on hehalf of the IR (R19 4(a)(i) PCT)]

•the application is in the prescribed language [if not in a language prescribed by the RO,

the application is deemed received on behalf of the IB on the same date. The IB accepts

-the designation of at least one PCT state [this is now automatic on filing the request],

R4.18 PCT & R20.3 PCT; However, the part which appear to be a description and the part

which appears to be at least one claim can be incorporated in the application on the filing

Art.14(1)(a) PCT: the RO checks whether the application contains any of these defects:

i) it is not signed (if there are more applicants, then the signature of one of them is enough to

1 month from the filing date

The date of filing (DOF) [§ I.6.1] Time limits computed from priority [§ I.8.3]

Max 12 months from priorit

Note: many time limits under the PCT are calculated from the priority date.

Priority date

Art.2(xi)(b) PCT: If more then one priority is claimed. then the time limits calculated from the priority date are calculated from the earliest priority

Art.2(xi)(c) PCT: If no priority is claimed, time limits calculated from the priority start on the filing date.

R90bis.3(d) PCT: If the earliest priority is abandoned. any time limit calculated from that priority which has not yet expired is recalculated from the "new earliest priority" (if any) or from the filing date.

Correction / addition of priority claim [§ I.8.5]

R26bis.1(a) PCT: The applicant can correct or add a priority claim by sending a notice to the IB: -within 16 months from the priority date if this does not change the priority date and,

- -when this results in a change of the priority date within the earlier of:
- ·16 months from the original priority date or. ·16 months from the new priority date.
- but, the notice of correction can still be filed within 4 months from the filing date of the PCT application.

Disclaimer: The authors do not accept any responsibility for the consequences of following the information / tips given in this table Reference must always be made to the official documents (the PCT, the EPC and their implementing regulations and guidelines).

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Fees due on filing / Refunds /Reductions [§ 1.5]

Art.3(4)(iv) PCT & R27.1(a) PCT; an International application is subject to the payment of the following fees: -transmittal fee (R14 PCT; see § I.5.1). -international filing fee (R15 PCT; see § I.5.2),

-search fee (R16 PCT; see § I.5.3),

R14-16 PCT: these fees must be paid to the RO within 1 month from the date of receipt of the application (by the RO).

Refunds: refunds may apply in certain cases (§ 1.5.1-1.5.3; § II.5). Reductions / Waivers: applicants from certain nations may have the fees reduced or waived. Other reductions may apply (§ 1.5).

Translation for the Searching Authority (ISA) [§ I.3.2]

R12.3 (a) PCT: If the application is filed in a language accepted by the RO but not accepted by the ISA for the search, the applicant must supply to the RO within 1 month from the date of receipt of the application at the-RO, a translation of the application into a language which is:

accepted by the ISA for search,

-a language of publication, -a language accepted by the RO under R12.1(a) PCT, unless the application was already in a publication language

Restoration of priority [§ I.8.7]

R26bis.3(a) PCT: If the 12 month

within 2 months of expiry of the 12

Preparation of Search Report

and WO-ISA [§ II.6; § II.9; § II.10]

Art.18(1) PCT & R42.1 PCT: the

ISA must prepare the International

-3 months from the receipt of the

-9 months from the priority date

WO-ISA at the same time as it

drafts the search report (if the

R43bis.1(a): the ISA prepares the

entire priority year is claimed this

is usually within 16 months from

search report by the later of:

priority period is not met.

month period.

search copy or.

the priority).

14 months from priority date

restoration can be requested

Translation for publication (& L3 3)

R.12.4(a) PCT: If the application was not filed in a publication language and was not translated (for the ISA) under R12.3(a), the applicant must file with the RO a translation in a publication language accepted by the RO within 14 months from the priority.

Filing of copy of the priority document [§ I.8.2]

R17 1(a) PCT: A copy of the priority document, must be filed within 16 months from the priority date at the IB or at the RO; but, if it arrives at the IB later, but before the

Late payment [§ I.5.1 - I.5.3]

R16bis.2(a) PCT (the EPO requests it).

No payment / Withdrawal [§ I.5.1 - I.5.3]

application is declared withdrawn by the RO.

the fee is deemed paid in time (no surcharge is due).

R17.1(b) PCT: If the priority document was issued by the RO, the applicant can request the RO within the same16 month period to forward the document to the IB. A fee may be due for this service.

For cases where digital libraries exist see & L8.2

Corrections / additions of priority claim [§ I.8.5]

R26bis.1(a) PCT: the applicant can correct or add a priority claim sending a notice to the IB This is to be done:

-within 16 months from the priority date if this does not change the priority date and,--when this results in a change of the priority date, within the earlier of-

- 16 months from the original priority date or.
- 16 months from the new priority date,

16 months from priority date

provided that, whichever period applies, the notice of correction can be filed up to 4 months from the filing date of the PCT application.

International publication (§ II.12)

Art.21(1-2) PCT: the application is published by the IB promptly 18 months after the priority date.

Art.21(3) & R48.2(a)(v) PCT: If available before the end of the preparations for publication, the search report is published with the application. R48.2(g) PCT. If not yet available, it is published separately as soon as it becomes available.

R48.2(f) PCT: If received in time, amendments under Art.19 PCT and any "brief statement" are also nublished with the application

Preventing publication [§ II.12.4 & § V.6]

Art.21(5) PCT & R90bis.1(c) PCT: The application is not published if applicant withdraws it by sending a notice to IR before end of technical preparations for publication (usually 15 days before the scheduled publication date).

18 months from priority date

19 months from priority date

Application not entitled to a filing date / Corrections / Incorporations [§ I.6 and § I.7]

Art 11(2)(a) PCT & R20.3(a) PCT: If the RO finds that the application is not entitled to a DOF under Art.11(1) PCT, it invites the applicant to correct the deficiencies or to confirm that the description or at least one claim are incorporated by reference to a claimed priority R20.7 PCT: The TL to provide correction/confirmation is 2 months from the invitation or in the case where the applicant acts on his own motion, 2 months from the date when the first element of the application was filed (see also § I.6.2.1 and § I.6.2.2).

R20.4(i): If no correction or confirmation is provided in due time the application is not treated as a PCT application (§ I.6.2.1).

Art.11(2)(b) PCT: If deficiencies are corrected in due time, a DOF is accorded on the date on which the correction is received by the RO (§ I.6.2.1).

R20.3(b)(ii) PCT: If the description or claim/s (as a whole) are incorporated by reference under R20.6(b) PCT, they are considered filed when the first elements of the application were filed and the DOF is that when all requirements of Art.11(1) PCT were met (§ I.7.1)

R20 5(a)(b) PCT: Parts of description / claims or drawings can also be incorporated into the application based on the priority document (with no shift of the DOF; see § 1.7.2). R20.5(c) PCT: If these parts or drawings are filed late (and they are not considered incorporated by reference to a claimed priority) the DOF is that of their receipt at the RO

Art.14(4) PCT & R.30.1 PCT: If, within 4 months after accordance of a DOF the RO finds that any of the requirements of Art.11(1) PCT was not complied with, the applications is deemed withdrawn. R29.4(a) PCT: Before this happens, the applicant is invited to comment on the findings (see also § I.6.2.3).

Correction of formal defects [§ I.9.3]

Art.14(1)(b) PCT and R26.2 PCT: If the RO finds any of said defects, it invites the applicant to provide a correction within 2 months. This period is extendable. (This correction does not cause a shift in the DOF).

Art.14(1)(b) PCT: If the applicant does not provide the correction in time, the application is deemed withdrawn.

R.26.5 PCT: If the application does not comply with the physical requirements, but is susceptible to be published, then it is not considered withdrawn

Request for Supplementary International Search [§ II.15]

R45bis 1(a) PCT: The applicant may request within 19m of the priority date that a SIS is carried out on the application by an ISA authorised to do so under R45bis.9 PCT (§ II.15.1). R45bis.2(a) PCT & R45bis.3(a) PCT: Handling and search fees must be paid to the IB within 1 month of receipt of the SIS request (R45bis.2(c) PCT & R45bis.3(c) PCT; § II.15.4.1).

Amendments under Art.19 PCT [§ II.11]

Transmittal of SR + WO-ISA [§ II.9 & II.10]

Art.18(2) PCT & R44.1

to the applicant.

PCT: As soon as they are

prepared, the search report

and WO-ISA are transmitted

Art.19(1) PCT: After receipt of the search report, the applicant can amend the claims. R46.1 PCT & R46.2 PCT: The amendments must be filed at the IB by the later of: -2 months from the transmittal of the search report to the applicant

-16 months from the priority date.

R46.1 PCT: However, if the amendments arrive at the IB before the end of the technical

preparations for publication, then they are considered filed in time. Art.19(1) PCT: A brief explanatory statement can be filed with the amendments.

R46.5 PCT: A letter indicating modifications of claims and their basis in the application as originally filed, must be filed.

Filing the demand for preliminary examination [§ III.3.3]

R54bis.1 PCT: If the applicant intends to file the demand for international preliminary examination, he must file this demand by the later of:

-3 months from the date of transmission of the search report + WO-ISA to the applicant, and -22 months from the priority date.

Reply to the WO-ISA [§ II.10.10]

R43bis.1(a) PCT & R43bis.1(c) PCT: If the applicant files the demand and the WO-ISA is considered to be a 1st written opinion by the IPEA, then the applicant may file a reply (arguments and/or amendments) with the ISA by the later of:

- -3 months from the date of transmission of the SR + WO-ISA to the applicant &
- -22 months from the priority date.
- It is recommended to file the reply to the WO-ISA when filing the Demand.

Failure to file the translation for the ISA [§ I.3.2.1 - I.3.2.2] R12.3(c) PCT: If the applicant has not filed the translation, the RO invites him:

-to file it within the period set in R12.3(a) PCT or, -to file it later, but within the later of 1 month from the notification or 2 months from the receipt of the application by the RO. In this case a surcharge is also due under R12.3(e) PCT.

R16bis.1(a) PCT: If any of these fees is not paid in time, then the applicant is invited by the RO to pay it within 1

R16bis, 1(d) PCT: If the applicant pays the missing fee(s) before the invitation under R16bis, 1(a) PCT is sent, then

Art.14(3) PCT & R16bis.1(c) PCT: If after being invited, the applicant does not pay the fee(s) on time, then the

R16bis.1(e) PCT; If the applicant pays the missing fee(s) after this TL expires, but before the application is declared

month from an invitation .The RO may request an additional late payment surcharge under R16bis.1(a) &

- R12.3(d) PCT: If the applicant does not file the translation or does not pay the surcharge in time, then the application is deemed withdrawn. The RO Issues a declaration to this effect. R12.3(d) PCT: If the applicant files the translation and pays any late furnishing fee after expiry of the period set, but
- before the declaration is issued, and before 15 months from the priority, the translation is considered filed in time.

Failure to file the translation for publication [§ I.3.3.1 - I.3.3.2]

withdrawn, then the fee is deemed paid within the TL of R16bis.1(a) PCT.

R12.4(c) PCT: If the applicant has not filed the translation within the 14 months, the RO invites him to file it within 16 months from the priority date. A surcharge may be requested by the RO (R12.4(e) PCT). If the translation is filed after the 14 months, but before the RO has issued the invitation, it is deemed filed in time (no surcharge is due). R12.4(d) PCT: If the applicant does not file the translation and/or pay the surcharge within the 16 month period, the application is deemed withdrawn. If the translation is filed and the surcharge is paid late, but before the application is declared withdrawn and before 17 months from the priority, the translation is considered to be received in time.

International search and state of the art [§ II.1]

Art 15/1) PCT: each international application is subject to an international search

Art.15(2) PCT: the search is carried out to find the relevant prior art.

Art.15(3) PCT: the search is performed on the basis of the claims, with due regard to the description and the drawings

Art 15(4) PCT: the search is made by the ISA, which endeavours to discover as much prior art as possible, consulting the documentation specified in the regulations

R33.1 PCT: for the purpose of the search (Art.15(2) PCT), the prior art comprises any written disclosure (including drawings & illustrations):

-which occurred anywhere in the world before the filing date and which is relevant to determine whether the invention is new and involves inventive sten

R.33.2-3 PCT and §.II.1 explain that the following are also mentioned in the search report: a) oral disclosures which occurred before the International filling date and which are confirmed by a written disclosure which occurred after the International filling date, and b) patent applications published after the International filing date of the examination being

Art.18(1) PCT: [once the search is completed], the search report is established according to the prescribed regulations (see also § II.9).

Which ISA is competent [§ II.2]

searched, but having an earlier filing date.

Art.16(2) PCT: each RO decides which ISA(s) is/are competent to search applications filed at

R35.1 PCT & R35.2 PCT: the RO may specify that more than one ISA is competent. In this case the choice of the ISA can be left to the applicant or can be determined by (e.g.) the technical field of the application or the language of filing (§ II.2.1)

R35(3) PCT: if the application is filed at the IB, then the ISA is that which would have been competent had the application been filed at the RO which is competent based on the residence / nationality of the applicant. When there are more applicants, this rule may broader the choice of the possible ISA(s) competent to search that application (§ II.2.1).

The EPO as ISA [§ II.2.2]

Art.152 EPC: the EPO acts as ISA for residents / nationals of EPC States. Art.152 EPC: the EPO may also act as ISA for other applicants (nationals or residents in non-EPC states), subject to an agreement between the EPO and the IB (e.g. applicants from USA

The search fee [\$ 1.5.3 & \$ II.4]

Art.3(4)(iv) & R.16.1(a) PCT: the ISA may charge a fee to perform the international search. R.16.1(b) PCT: the search fee is to be paid to the RO.

R.16.1(f) PCT: the search fee is to be paid within 1 month from the filling of the application (See § 1.5.3 for late payment of search fees & for sanctions for late payment / failure to pay). RFees 2(1).2 EPC: the EPO (acting as ISA) charges a search fee when acting as ISA.

Refunds of the search fee [§ II.5.1; § II.5.2]

-R16.2(i) PCT: if the application is not accorded a filling date.
-R16.2(ii) PCT: if the application is withdrawn or deemed withdrawn before transmittal of the search copy to the ISA. But, OJ 2010, 304: the EPO is more generous, and refunds the search fee if the application is withdrawn/deemed withdrawn before the search is begun.
-R16(2)(iii) PCT: if the application is not treated as a PCT application due to consider

R16.3 PCT: if, when performing the International search, the ISA takes into account the results of a previous search carried out on an application claimed as priority. The amount of this refund depends on the degree of overlap of the claimed subject matter R41.1 PCT, R4.12(i) PCT: this refund must be requested in the request form [the EPO does not require this – Euro-PCT Guide 145].

R12bis.1(a) PCT: copy / translation of the earlier search results and of the earlier application may also have to be provided for this refund to apply.

R41.1 PCT: the ISA is not obliged to take into account search reports drawn up by other ISAs. (e.g. the EPO only takes into account earlier searches performed by itself OJ 2010, 304).

Reductions of the search fee [§ I.5.3]

OJ 2008, 521: the EPO charges a reduced search fee for applicants of certain low income states listed by the World Bank

Transmittal of the search copy to the ISA

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given in this table. Reference must always be made to

the official documents (the PCT, the EPC and their

R23.1(a) PCT & (R22.1 PCT): the search copy is transmitted by the RO to the ISA promptly after receipt of the application by the RO, where:
-a filing date is accorded under Art.11(1) PCT, an

-there are no national security checks to be carried out, (and if there are any they have been

-the filing fee and the search fees have been paid, and -no translation under R12.3(a) PCT is required.

R23.1(b) PCT: if a translation was filed under R12.3 PCT to the ISA for the search, it is this translation which is sent as search copy to the ISA (but only if the search fee is paid).

Application not searched due to presence of certain matter [§ II.7.1]

Art 17/2\(a\(i\)) PCT: if the ISA considers that the application relates to subject matter which it is not required to search according to the regulations, then it does not prepare the search report. A declaration informing the applicant and the IB is issued

Art.17(2)(b) PCT: if the subject matter in question appears in certain claims only, only the claims affected are excluded from the search

R39 1 PCT subject matter which the ISA is not required to search is: -scientific / mathematical theorie

-plant / animal varieties, essential biological processes to produce plants / animals other than microbiological processes

-schemes, rules, methods of doing business or performing mental acts, playing games, -methods of treatment of the human / animal body: diagnostic methods.

presentations of information -computer programs.

Application not searched due to serious deficiencies [\$ II.7.2]

Art 17(2)(a)(ii) PCT: if the ISA considers that the description / claims / drawings fail to comply with the PCT requirements to an extent that no meaningful search can be carried out, then it does not prepare a search report. A declaration informing the applicant and the IB is issued.

Art.17(2)(b) PCT: if the subject matter in question appears in certain claims only, only the claims affected are excluded from the search.

Application not searched due to defects concerning sequence listings (§ II.7.2; II.13.1)

R13ter.1(a) PCT & R13ter.1(b) PCT: if the application discloses biological sequence listings, but the

- sequence listings which comply with the standards of the Administrative Instructions, and

- sequence listings in electronic form complying with the Administrative Instructions, then the ISA can require the applicant to file such sequence listing/s within a time limit set in the

R13ter.1(c) PCT: the ISA may request a late furnishing fee

R13ter, 1(d) PCT: if the applicant does not comply with the invitation in due time the ISA is not required to carry out the search to the extent that the non-compliance prevents the ISA from carrying out a meaningful search.

Art.3(4)(iii) PCT: the international application must comply with the requirements of unity. R13 PCT: defines the criteria to establish whether unity is complied with (§ II.8.2.1).

Art.17(3)(a) PCT: if the ISA considers that the application is non-unitary under R13 PCT, it invites the applicant to pay one or more additional search fees within the prescribed time limit (see § II.8.2.1 for the procedure and see § II.8.2.3 for the content of the invitation to pay additional fees). R40.2(b) PCT: the additional search fee/s is/are to be paid to the ISA (§ II.8.2.1).
R40.1(ii) PCT: the time limit to pay is 1 month from the date of the invitation (§ II.8.2).

Art.17(3)(a) PCT: the ISA establishes a search report on the first invention mentioned in the claims and on any other invention for which an additional fee has been paid (§ II.8.2.1).

Note: the EPO acting as ISA sends to the applicant the results of the partial search for the first "main invention" mentioned in the claims together with the invitation to pay additional search fees for the other inventions. Once the TL to pay additional search fees has expired, a search is performed on any invention for which additional searching fees have been paid. A final search report covering all the searched inventions is then issued

R40.2(c) PCT: the applicant may pay the additional search fee under protest, with a reasoned statement that:

-that the additional fees are excessive.

R40.1(ii) PCT: the time limit to pay additional search fee/s and for filing the protest is one month from the date of invitation by the ISA to pay additional search fees.

R40.2(e) PCT: the ISA may ask for a fee for the examination of the protest Rfees 2(1).21 EPC: the EPO charges a protest fee under R40.2(e) PCT.

R.40.1(iii) PCT: the time limit for the payment of the protest fee is one month from the date of invitation

R40.2(c) PCT: the protest is examined by a review body within the ISA. R40.2(d) PCT: the review body can include the examiner who made the decision under protest, but cannot be limited to this person. Q.I.2015, A59: the review body at the EPO-ISA is composed of three examiners: one will chair the panel, and one of the others will be the examiner who sent the original invitation to pay additional fees (these will usually be the future members of the examining division after the case enters the European

R40.2(c) PCT: the review body examines the case and refunds any additional search fee which was paid to the extent that the protest was justified. This means that the review body may decide that:
a) the application is unitary (then any additional fee paid is refunded),

b) the application is non-unitary but the number of additional fees requested by the ISA was excessive

c) the application is not-unitary and the number of fees requested was not excessive (then no refund is

R40.2(e): if the review body finds that the protest was entirely justified, then also the protest fee is

Art 18(1) PCT & R42 1 PCT: the time limit (for the ISA) to prepare the search report (or the declaration replacing it under Art.17(2)(a)) is the later of:

Note: this table is provided as annex to the book: P. Watchorn & A. Veronese "PCT Procedures and Passage into the European Phase". The references in brackets "\$...." refer to the relevant paragraphs of the book. Note also that the time scale is not accurate, and only provides a rough idea of the sequence of the relevant events. Reference to time limits from the priority means time limits which are computed from the earliest priori date, or from the filing date, where no priority is claimed

Publication of the search report [§ II.12.1] Late publication of the search report) [§ II.12.1]

Art.21(1-2) PCT: the International Bureau publishes the R48.2(g) PCT: if the search report is not yet ready at the time of PCT application promptly 18 months after the priority date publication it is published separately as soon as it becomes available This is called an "A3" publication).

Art.21(3) PCT & R48.2(a)(v) PCT: if the search report is available before the end of the preparations for publication of the application (usually 15 days before the scheduled publication date), it is published with the application (§ II.12.1) (in this case the publication is identified as an "A1"

R48(2)(f) PCT: if received in time, amendments under Art.19 PCT and any "brief statement" are also published with the application

Note that the WO-ISA is not published with the application According to R44ter.1(a) PCT the IB and the ISA, where filed before 01.07.2014, the ISA may not allow access to the WO-ISA before 30 months after the priority date (8) II.10.11.2), where the application is filed after 01.07.2014, the WO-ISA is available after publication (§ II.10.11.1).

Transmittal of search report + WO-ISA to applicant [§ II.9 & II.10]

Art.18(2) & R44.1 PCT: as soon as they are prepared, the search report and the WO-ISA are transmitted to the applicant

The search report [§ II.9]

Art.18(1) PCT: the search report is to be prepared in the form prescribed by the

R43 PCT: this rule indicates all the items which the search report must contain (e.g. citations of the relevant prior art documents retrieved in the search, classification of the application, title, abstract, language of the report, etc.).

Art 17(2)(a) PCT: if the ISA considers that the application -relates to subject matter which is not required to search, and decides not to

that the application fails to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out.

then the applicant is notified of this and no search report is established (\$ II 7 1)

Art.17(2)(b) PCT: if any of the situations mentioned in Art17(2)(a) PCT exists in connection with some claims only, the search report indicates this in respect of such claims, whereas for the other claims, the search report is established (§

Partial search following non-unity objection [§ II.8]

Art.17(3)(a) PCT: if the ISA found that the application lacks unity, it prepares a search report only in respect of the first invention mentioned in the claims (main invention) and in respect of any other invention for which additional search fees were paid (§ II.8).

The Written Opinion of the ISA (WO-ISA) [§ II.10]

R43bis.1(a) PCT; the ISA prepares a written opinion (WO-ISA) on the International application at the same time as it drafts the International search report. This opinion is on:

(i) novelty, inventive step, industrial application of the invention (§ II.10.3). (ii) compliance with the "requirements of the PCT" in as far as these are checked defects of the application or observations on the clarity, support and disclosure

R43bis.1(b) PCT indicates, referring to other regulations, that the criteria which the ISA has to apply when establishing the WO-ISA are the same as those which the IPEA applies during preliminary examination

In particular cases no WO-ISA is prepared (see § II.10.2).

Assumption of validity of priority [§ II.10.7]

hetween the ISA and the IR

Often when the WO-ISA is established, the 16 month TL for filing the copy of the priority document has not yet expired. If this copy is not yet available to the ISA the WO-ISA is established on the assumption that the priority is valid (see §.II. 10.7 and S&E GL 11.05). Similar arrangements apply where the ISA requires a translation of the priority (S&E GL 17.29(b)).

Optional Request for Supplementary International Search (SIS) [§ II.15]

R45bis.1(a)(b) PCT: the applicant may request the IB within 19 months of the priority

date that a SIS is carried out on the application by an ISA (or by more than one ISA) authorised to do so under R45bis.9 PCT (§ II.15.1).

R45bis.9(a) PCT; an ISA may act as ISA-SIS if this is allowed for in an agreement

R45bis.9(b) PCT: however, an ISA may not act as SISA if it has carried out the main International Search under Art.16(1) PCT (i.e. it must be a different ISA).

R45bis.9(c) PCT: limitation of competence may apply based on the subject matter to be searched and/or the number of SIS-searches to be performed by that ISA.

Subject to the restrictions under R45bis.9 PCT, the applicant may choose any ISA to

R45bis.2(a), R45bis.3(a), R45bis.2(c) & R45bis.3(c) PCT: a handling and a search fee must be paid to the IB within 1 month from receipt of the SIS request (§ II.15.4.1).

Amendments under Art.19 PCT [§ II.11]

Art.19(1) PCT: after receipt of the search report, the applicant can amend the claims R46.1 PCT & R46.2 PCT: the amendments must be filed at the IB within the later of: -2 months from the transmittal of the search report to the applicant.

16 months from the priority date. R46.1 PCT: however, if the amendments arrive at the IB before the end of the technical preparations for

publication, then they are considered filed in time R46.5 PCT a letter indicating the modifications of the claims and their basis in the application as originally

Leaend:

PCT: Patent Cooperation Treaty EPO: European Patent Office

ISA: International Searching Authority IPEA: International Preliminary Examination Authority

WO-ISA: written opinion from the ISA SIS: Supplementary International Search SISA: ISA performing the SIS

PCT-AG: PCT applicant's quide

O.I: EPO Official Journal

IB: International Bureau

TI: time limit

DOF: date of filing

filed, must be filed together with the amendments.

Art.19(1) PCT: a brief explanatory statement can also be filed with the amendments.

Filing the demand for preliminary examination [§ III.3.3]

R54bis.1(a) PCT: if the applicant intends to file a demand for preliminary examination, the demand must be filed within the later of:

-3 months from the date of transmission of the Search Report & WO-ISA to the applicant and -22 months from the priority date.

Reply to the WO-ISA [§ II.10.10]

R43bis.1(c) PCT: if the applicant files the demand and the WO-ISA is considered as first written opinion by the IPEA, then the applicant may file a reply (arguments or amendments).

R43bis.1(c) PCT & R54bis.1(a) PCT: the reply to the ISA must be filed within the later of:

-3 months from the date of transmission of the SR & WO-ISA to the applicant and -22 months from the priority date.

Report based on the WO-ISA [§ II.10.13]

R44bis.1(a) PCT: where no International preliminary examination report has been or is to be issued (i.e. when no demand for preliminary examination is filed), then the IB prepares a report on behalf of the ISA. This report has the same content as the WO-ISA

R44bis.1(b) PCT: The report is called "International preliminary report on patentability (Chapter I of the Patent

R44bis.3(a) PCT: If it is prepared in a language which is not an official language of a designated office, this office may request a translation into English. R44bis.3(b) PCT & R44bis.4 PCT: the IB is responsible for preparing this translation but the applicant is given the opportunity to make observations on its correctness (§

R44bis.2(a) PCT: this report is communicated by the IB to the designated offices, but not before 30 months from the priority date. But, if the applicant requests early passage in regional / national phase, the IB communicates this report to the designated offices upon request of these offices or of the applicant R44bis.2(b)

Note: if the demand for preliminary examination is filed, R.44bis.1(a) does not apply, and the IPEA prepares a "real" preliminary examination report

Translations of the WO-ISA [§ II.10.12]

R44bis.3(d) PCT & R72.2bis PCT: the designated / elected offices may request a translation of the WO-ISA into English where the applicant has requested early entry in the regional / national phase (since the "report based on the WO-ISA", and possibly its translation, are not yet ready in these cases).

The translation is prepared under the responsibility of the IB

R44bis.4 PCT & R72.3 PCT: the applicant may file comments on this translation.

Confidentiality of the WO-ISA and other documents [§ II.10.11]

Applications filed after 01.07.2014 [\$ II.10.11.1]
Euro-PCT Guide 236 – The WO-ISA is made available by the EPO as ISA from international publication.

Applications filed before 01.07.2014 [S || 1.10.11.21] R44ter.1(a) PCT: except with the authorisation of the applicant, the IB and the ISA may not allow access by any person or authority before 30 months after the priority date to: -the WO-ISA, any translation of the WO-ISA, and any observations from the applicant on that translation, -the report based on the WO-ISA, the translation of the report based on the WO-ISA and any observations

from the applicant on that translation

Note: an earlier access to these documents can be possible where the applicant requests early passage in the regional / national phase. R44ter PCT was deleted with effect for applications filed from 01.07.2014.

ions filed before 01.07.2014 -Availability after 30 months [§ II.10.11.2]

PCT S&E Guidelines 2.18: The IB, the ISA and the designated offices (which receive a copy of the documents from the IB under R44bis.2(a)), can make the following documents available to the public after 30 months from

-the WO-ISA the report based on the WO-ISA

-the translation of WO-ISA

the translation of report based on WOJSA

The EPO as designated office renders the WO-ISA available to the public 30 months after the priority date.

Preparation of the Supplementary International Search Report [§ II.15.7]

R45bis.5(b) PCT; the SIS search is carried out on the application as filed (or a translation thereof). PCT AG I, 8.040: amendments made under Art.19 PCT are not taken into account (§ II.15.5).

R45bis.5(c) PCT & Art.17(2) PCT: limitations of the SIS may apply if the application concerns subject matter that the SISA is not obliged to search or if the application is so deficient that a meaningful search cannot be performed. A declaration is issued in these cases (see § II.15.8).

R45bis.6(a) PCT: if the SISA finds that the application is not unitary, it searches only the first invention mentioned in the claims and informs the applicant giving the reasons. No additional fees are requested and no additional searches are performed on the other inventions (§ II.15.9).

R45bis.7(a) PCT: the SIS must be prepared within 28 months from the priority date (§ II.15.7) R45bis 7(c) PCT: provisions on form & content of the main search report apply to the SIS (\$ II 15.7) (e.g. document cited, classification; but, documents cited in the main search do no need to be recited)

R 45bis 8(a) PCT & PCT-AG I 8 051: the SISA transmits the SIS to the IB. The IB includes the SIS in the main International search report and transmits it to the designated offices and to the IPEA; the IPEA takes the SIS into account if it receives it in time before drafting any WO or IPER; § II.15.11. PCT-AG-I, 8.053: the SIS is not published but is rendered available by the IB under "Patentscope".

Time limit to prepare the Search Report [§ II.6]

-3 months from the receipt of the search copy and, -9 months from the priority date.

> Events taking place after the search report is issued (But, the SIS-request can be filed, and the SIS be issued even before this)

Events taking place during the search procedure

Once the ISA has received the search copy from the

Note: the search can be suspended by the ISA if the

sequences, and no sequences in electronic form have been filed [see § II.13.1].

RO it may start the international search

application relates to nucleotide / amino acid

Table 4: Procedure before the International Preliminary Examination Authority (IPEA) Establishment of the IPER (§ III.10.7) IPER forwarded to applicant, IB Art.35(1) PCT: the International Preliminary Examination [§ III.10.7.14 & § III.7.12] Report is established in the prescribed form and is Report based on the WO-ISA [§ II.10.13] Art 36(1) PCT: the IPER is produced within the prescribed time limit. PCT: Patent Cooperation Treaty R44bis.1(a) PCT & R44bis.1(b) PCT : where no International preliminary examination report has been or is to be issued, then the IB prepares a Form & content of IPER (§ III.7.1 - III.7.3) EPC: European Patent Convention applicant and to the IB. EPO: Furonean Patent Office If no demand is filed, there will be no report on behalf of the ISA. This report has the same content as the WO-ISA and is called "International preliminary report on patentability (Chapter) of the Patent Co-operation Treaty?. For translations of this report see § II. 10.14. Art 36(3)(a): the IPER & Art.35(1-2) PCT: the IPER must be in the prescribed form. PCT-AG: PCT applicant's guide translation (if required) & annexes In particular the report must contain a statement indicating S&E-GL: PCT Search and Examination Guidelines examination by any IPEA (in original language) are communicated by the IB to the whether the claims comply with the criteria of novelty / IB: International Bureau Note: if the demand for preliminary examination is filed, R,44bis,1(a) does not apply and the IPEA prepares a "real" preliminary examination report. inventive step and industrial applicability (§ III.7.1). RO: Receiving Office elected offices (See § III.10.7.14). Art 35(2) & R70.6(a) PCT; explanations on the finding ISA: International Searching Authority R44bis 2(a) PCT: this report is communicated by the IB to the designated offices, but not before 30 months from the priority date. However, if the R72.1(a) if the report is not in a IPEA: International Preliminary Examination Authority WO: written opinion (of the IPEA) or of the applicant language of a certain elected state, that state may require an English translation from the IB. Art 35(2) PCT_R70 12 & R66(2)(iii) PCT: other defects of WO-ISA: written opinion of the ISA the application (e.g. relating to clarity and/or support of the claims) may also be mentioned in the IPER (§ III.10.7.3). IPER: International Preliminary Examination Report (See § III, 10.7, 12). When can the IPEA start examination (§ III.10.2) Basis of IPER (§ III.9) Note: this table is provided as annex to the book: P. Watchorn & A. Veronese "PCT Procedures No R69 1(a) PCT & R54his 1(a) PCT: the IPEA cannot Art 34/2\(c) & R66 1his/h\ PCT: any IPEA may notify Confidentiality of the file of the IPER (§ III.14) and Passage into the European Phase". The references in brackets "§....." refer to the relevant R66.1(a-d) PCT: depending on whether amendments have been filed, the IPER is based on the application as Paragraphs of the book. Note that the time scale is not accurate, and only provides a rough idea of the sequence of the start the preliminary examination before the later of: the IB that it will not accept the WO-ISA of a different -3 months from the transmittal of the search report + ISA as a WO. In such cases the IPEA is obliged by originally filed, or on amended documents filed under Art.19 PCT, or filed under Art.34 PCT (also as a reply to relevant events. Reference to time limits from the priority /filing date mean time limits which are computed from the earliest priority date, or from the filing date, where no priority is claimed. WO-ISA to the applicant and Art.34(2)(c) PCT to issue its own WO, before the IPFR Art.38(1) PCT: neither the IB. nor is established. (For the content of the WO see § the IPEA may allow access to the file of the IPEA, except with the -22 months from the priority date the WO-ISA). Amended documents on which the IPER is does the IPEA based are annexed to the IPER (see § III.9.1 - § III.9.3). This unless the applicant requests an earlier start. Yes consent of the applicant to: Early filing of demand (for certain states only) (§ III.3.3) Documents considered (§ III.10.7.2 & II.15.11) This is also subject to the exceptions of R69 1(b-e). ISA of a differen -any person and For more information on these exceptions see § ISA as 1st WC -any authority (except for the The IPEA takes into account documents cited in the Further written opinion/s (§ III.10.5) For the few states which have not yet adapted their national law elected offices once the IPER has search report and in the SIS (if the SIS-search report is to the new TL of Art.22 PCT, the applicant has to file the heen established) drafted and is received it in time before drafting the IPER). demand within 19 months from the priority / filing date if he wants to extend the international phase up to 30 months form Start of examination at search stage (§ III.10.2) R66.4(a) PCT: if the Limited / partial IPER (§ III.10.7.4-5, § III.13.1-2) Access via elected offices IPEA wishes so, it R69 1/h-e) PCT: this regulation allows an ISA which WO-ISA considered as first WO of the IPEA (§ III.10.3.1) Reply to written opinion (§ III.10.4) the priority / filing date in respect of these states. Art 35(3) PCT Art 34(4) PCT R66 1(e) PCT R70 2(d) may issue a further also acts as IPEA, to start the examination early (at R94.3 PCT: if the national law of PCT, R70.12(iii) PCT: if the IPEA finds that the application WO but this is at the the search stage) if some conditions are met. In any elected office (this includes R66 1his(a) PCT: the WOJSA is Art 34(2)(d) PCT & -relates to subject matter which it is not obliged to treaties such as the EPC) allows Search report + WO-ISA prepared and transmitted to the applicant (§ II.9 & II.10) IPFA (For the When to file the demand for preliminary content of the WO -contains deficiencies such that no meaningful opinion can -no postponement of the examination has been opinion (WO) of the ISA applicant may reply of a national application, then that see § III, 10.3.4). to the WO filing be formed, or -relates to inventions which have not been searched, (for office may also allow access to the documents relating to the PCT -any amendment mentioned in the demand must be R54bis.1 PCT: the demand for preliminary This means that in this case the Art 18(2) PCT & R44 1 PCT: as soon as they amendments / OJ 2011, 532 IPEA may issue the IPER without the need to issue its own WO. arguments within the TL set in the WO example as result of a non-unity objection raised in search or because the ISA considered that no meaningful search examination must filed within the later of application. This includes also the are prepared, the search report and the WO-ISA are transmitted to the applicant. This However, the EPO -3 months from the date of transmission of No nenally issues a For more information on this topic see § III, 10.2. Search Report + WO-ISA, & The IPEA has however the under R66.2(d) was possible). triggers one of the two time limits to file the second WO where it Euro-PCT Guide 404: the EPO as -22 months from the filing / priority date. discretion to issue another WO (OJ 2011, 532 - the EPO usually then no opinion will be issued for the part of the application demand for preliminary examination. was the ISA. R66.4bis PCT: late elected office allows access to the The TL for the ISA to prepare the search Normally the 22 month TL applies. The issues a second WO). filed replies can be IPEA file of published applications other TL applies only if the search report Time limit for preparation of the IPER (§ III.10.7.11) ignored for drafting if the IPER is completed. report is the later of: -3 months from receipt of search copy, Where the WO-ISA is considered R69.2 PCT: the IPER must be prepared by the IPEA by Nο But, for applications filed before is transmitted very late. the report. -9 months from the priority date the 1st written opinion by the IPEA, the applicant may file at the yes the later of the following dates 01 02 2003 the applicant must R54bis.1(b) PCT: any demand made after -28 months from the priority / filling date Usually the ISA prepares the search report the prescribed date is considered not to IPFA a reply to the WO-ISA in -6 months from the date on which examination can start entry into the EP regional phase within 16 months from the priority date order to have arguments and / or under R 69 1 PCT have been made. The IPEA makes a (OJ 2003, 382 and OJ 1999, 329). -6 months after receipt of the translation under R55.2 PCT amendments considered in the IPER. The reply must be filed Note: the 28 month TL normally applies. is the does the IPEA cf R54bis PCT (R43bis, 1(c) PCT) demand Yes same office as t in order to be considered by the issue a further 16 months from 19 months from 22 months from filed? IPEA; i.e. it has to be filed in due ritten opinio 28 months from priority/ filing date priority /filing date priority/ filing date time before the IPER is priority/ filing date established (§ II.10.10). Who can file the demand for Preliminary Examination (§ III.1) Reply to the WO-ISA (§ II.10.10) Substantive issues in preliminary examination (§ III.8.1) Art.31(2)(a)PCT: the demand for preliminary examination can be filed by any applicant who is: R43bis 1(c) PCT: if the applicant files the demand and the WO-ISA is considered the 1st, written opinion by Art.33(1) PCT: the objective of the preliminary examination is to give a preliminary non-binding opinion on whether the claimed invention: the IPEA, then the applicant may file a reply (arguments and/or amendments) to the IPEA by the later of: -3 months from the date when the SR + WO-ISA were transmitted to the applicant, and -resident / national of a PCT State bound by chapter II PCT, and -whose application was filed at a RO of or acting for such state. involves an inventive step. is industrially applicable Note: since all PCT states are currently bound to chapter II PCT, any applicant who is a national resident of a PCT Note: The applicant has to reply in time, if he wants to be sure that his reply will be considered by the IPEA Art 33/2) PCT: the invention is novel if it is not anticipated by the state of the art, as defined in the regulations before the IPER is established. Art.33(3) PCT: the invention involves an inventive step if it is not obvious to the skilled person at the relevant date. R54.2 PCT: if there are two or more applicants, at least one of them must be resident / national of a PCT state bound Art.33(4) PCT: an invention is considered industrially applicable when it can be used in any kind of industry (industry in its broadest sense). Art.34(5) PCT: the PCT contracting states can apply different criteria in deciding whether the invention is patentable or not. R54.4 PCT: if no applicant has the right to file it, the demand is deemed not received Relevant date for assessing the prior art (§ III.8.2) Filing amendments under Art.34 (§ III.9 & III.9.3) R64.1(b) & R65.2 PCT: the relevant date used to determine the prior art to assess novelty and inventive step is: Art 34(2)(b) PCT: the applicant may file amendments to the description, claims, drawings, of the application Where to file the demand / Which IPEA is competent (§ III.2, III.3.1) before the establishment of the IPER. (i.e. during the entire examination procedure). The amendments may the priority date, if the application validly claims priority. not extend beyond the content of the application as originally filed. Art.31(6)(a) PCT: the demand must be filed at the competent IPEA (§ II.3.1). R66.8 PCT & R46.5 PCT: a letter indicating the modifications of the claims and their basis in the application as originally filed, must be filed with the amendments. Art.32(2) PCT: the RO specifies which IPEA/s is/are competent for International Applications filed at that RO (§ II.2). Art.33(2) & R64.1(a) PCT: the prior art for the preliminary examination is everything made available to the public anywhere in the world by means of a written disclosure. R66.1(b) PCT; amendments under Art.34 PCT can be filed together with the demand or later, until the IPER R59.1(b) PCT, R35.3(a) PCT & R19 PCT: if the application was filed at the IB as RO, the competent IPEA is that which including drawings and illustrations, before the relevant date. Note: for the purpose of Prelim-Examin, only written disclosures count as prior art. Non-written disclosures (e.g. oral disclosures and prior uses) are not considered unless would have been competent, had the application been filed at the receiving office of: -the state of residence of the applicant. R66.4bis PCT: amendments or arguments filed after the IPEA has started to draw up a written opinion or confirmed by a written disclosure. See § III.8.2 for non-written disclosures and for patent documents published after the relevant date but having an earlier filing date. Note: the IPEA takes into account documents cited in the search report and in the SIS (if the SIS-search report is drafted and is received it in time before drafting the IPER - § -the state of nationality of the applicant, the IPER, may be disregarded by the IPEA for the preparation of that written opinion or the IPEF -other offices (resulting from agreements allowing filing at other offices, e.g. EPO). III 10.72 & II.15.11). R59.1(a-b) & R.35.2(a) PCT: where more than one IPEA is competent the applicant may have a choice among different IPEAs (§ II.2). However there may be restrictions limiting the choice of the applicant. These limitations may depend on the residency / nationality of the applicant and/or on the technical field of the application (for limitations Prescribed fees (§ III.7) Non-unity in Preliminary examination (§ III.12.1-4) Application not examined (§ III.10.7.4 & III.13.1 & III.13.2) Art.31(5) PCT; the demand is subject to the payment of the prescribed fees within the prescribed time limit Art.34(3)(a) PCT; if the IPEA considers that the application lacks unity as set in the regulations, then it Limitation due to certain subject matter (§ III.7.4 & § III.13.1) applied by EPO as IPEA see § III.2.3), and/or on the language of the application (e.g. JPTO) may invite the applicant to do the following within the prescribed TL: -restrict the claims to make them unitary, or This means that the applicant must check which IPEA/s is /are competent and whether he has a choice. This depends Art.34(4)(a)(i) PCT, Art.35(3)(a-b) PCT & R70.12(iii) PCT: if the on the RO where the application was filed. See § III.2.1-2.4: for the cases where the EPO is the competent IPEA. -nav additional examination fees IPEA finds that the application (all, or some claims only) relates R57.1 PCT: the demand is subject to the payment of the handling fee. This must be paid at the IPEA where to subject matter which it is not obliged to examine, then the R68.1 PCT: the IPEA has the discretion not to issue the above invitation. However, also in this case it the demand is submitted (See § III.7.1.2 for refunds of this fee). application (or the claims concerned), is not subject to Form & content of the demand: (See § III.3.5 for details) must state that the application lacks unity, and indicate why. R68.2 PCT: in the invitation the IPEA should: specify at least one restriction which would satisfy the evamination. The IPER states this fact Art 34(4)(a)(i) PCT & R67 1 PCT: subject matter which the IPEA Language of the demand (§ III.3.4) requirements of unity; give the reasons of the findings & indicate the TL to reply (§ III.12.2.3) R58.1(a-c) PCT: the IPEA may require a preliminary examination fee (the EPO does). The amount is set by the IPEA and must be paid directly to the IPEA (See § III.7.2 for refunds of this fee). R68.3(a) PCT: the IPEA sets the amount of the additional fee to be paid. R158(2) EPC: the EPO charges one whole preliminary examination fee for each additional invention. is not required to examine relates to scientific /mathematica theories, plant varieties, methods of treatment /diagnosis, R55.1 PCT & R55.2 PCT: Demand must be in the language in which the IPEA carries out the preliminary examination (see § III.3.4). R68.3(b) PCT: the additional fee is to be paid to the IPEA. computer programs, etc. (§ III.10.7.4 & R67 PCT). Time Limit for payment (§ III.7.1.1 & III.7.2) Limitation due to serious deficiencies (§ III.13.2 & III.10.7.4) Art.34(3)(a) PCT & R68.2 PCT: the applicant must respond to the invitation under Art.34(3)(a) PCT Language of the application for preliminary examination (§ III.6) Art 34/4)(a)(ii) PCT Art 35/3)(a,b) PCT & R70 12(iii) PCT: if the R57 3(a) PCT & R58 1(b) PCT; handling fee & preliminary examination fees must be paid by the later of: within 1 month from the invitation (§ III.12.2.2). To be examined, the different parts of the International application must be in a language accepted by the IPEA. If the application IPEA finds that the application (all of it, or some claims only) was filed or was published in one of these languages, it will be examined in this language, otherwise a translation has to be filed. However, no translation is required where R55.2(b) PCT is applicable, i.e. where a translation was previously supplied for search under R12.3 PCT and the ISA and the IPEA are the same office. -22 months from the priority / filing date. S&E-GL 10.77; if the applicant pays additional examination fees, the IPEA examines the inventions in contains deficiencies such that no meaningful opinion can be respect of which additional fees were paid. If the claimed matter is restricted and rendered unitary, the IPEA examines that unified matter (provided it was searched - R66.1(e) PCT). formed, then the application (or the claims concerned), is not subject to examination. The IPER states this fact. Amendments to the application have to be filed in the same language as that of the application itself. Art 34(3)(c) PCT & R68 5 PCT: if no additional fee is paid, the IPER is established on the "main Unsearched subject matter is not examined (§ III.10.7.4) If a translation is required and the applicant has not filed it, he is invited to do so. Note: the legal basis of the above provisions (R.55.2 PCT and R.55.3 PCT) is discussed in detail in § III.6.1 and sub-sections. R58bis.1(a): if the handling & the examination fees are not paid in time, the IPEA invites the applicant to pay R66.1(e) PCT & R70.2(d) PCT: the IPEA is not obliged to them within 1 month from the invitation. A surcharge may be requested (the EPO requests it) R58bis.1(c): if a fee is paid late, but before the IPEA issues the invitation it is considered paid in due time (in R68.3(c) PCT: the applicant may pay the additional examination fees under protest, with a "reasoned examine inventions which have not been searched. If this is the case, then no opinion will be issued for the part of the statement" that the application is fully unitary or that the additional fees are excessive. R68.2 PCT: the TL for filing the protest is the same as for the payment of the additional fees. © 2015 Andrea Veronese & Peter Watchorn application concerned. The IPER states this

R58bis.1(b) PCT: if a fee and/or any surcharge is not paid in time, the demand is deemed not received. The

R.58bis.1(d)PCT: if a fee and/or any surcharge, is paid late, but before the IPEA issues the declaration

under R58bis.1(b) PCT, it is considered paid in time.

Disclaimer: the authors do not accept any responsibility for the

EPC and their implementing regulations and guidelines).

consequences of following the information / tips given in this table

Reference must always be made to the official documents (the PCT, the

R68.3(e) PCT: the IPEA may request that a protest fee is paid within 1 month of the invitation to pay additional search fees (the EPO does this (Rfees 2(1).21 EPC).

of any fee paid in excess. (For review body at EPO see OJ 2015, A59 & § III.12.3).

R68.3(e)PCT: if the protest is entirely justified, the protest fee is also reimbursed (§ III.12.3).

R68.3(c-d) PCT: a review body examines the protest and, if it finds it justified, it orders reimbursement

Missing biological sequence listings (§ III.13.2 & III.10.7.4)

R70 12(iv) PCT: if nucleotide and/or amino-acid sequences are

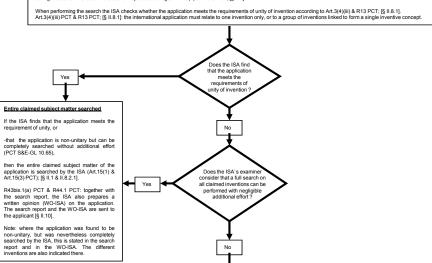
missing in such a form that a meaningful opinion cannot be

formed, then this is noted in the IPER

Table 5a: Procedure before the EPO acting as ISA in case of non-unity

The ISA checks whether the application complies with the unity requirements

Art.15(1) PCT; [§ II.1]: the International application is subject to an International Search by the International Searching Authority (the "ISA"). The documents retrieved during the search are cited in the search report according to Art.18(1) & R43.5 PCT; [§ II.9]



Invitation to pay additional search fees

Art.17(3)(a) PCT; [§ II.8.2.1]: if the EPO-ISA finds that the application does not meet the requirement of unity of invention, it invites the applicant to pay additional search fee/s.

R40.1(ii) PCT; [§ II.8.2.2]: the time limit to pay the additional search fee/s is one month from the date of the invitation

R40.2(a) PCT; [§ II.8.2.1]: the amount of the additional search fee/s is set by the ISA. R158(1) EPC: the EPO, when acting as ISA, requests the payment of one whole International search fee for each additional invention (in addition to the first one, which was paid after filing the International application) R40(2)(b) PCT; [§ II.8.2.1]: the additional search fee/s is/are to be paid directly to the ISA.

R40(2)(c) PCT; [§ II.8.3]; the applicant may pay additional fee/s under protest, with a reasoned statement that; the application is unitary or that the fees requested are excessive

Art.17(3)(a) PCT; [§ II.8.2.1]: regardless of whether additional fee's are paid or not, the ISA performs a search on the first invention mentioned in the claims. PCT S&E GL 10.81; [§ II.8.2.1]: when issuing the invitation to pay additional fee's, the ISA may send to the applicant the results of this search on the first invention together with the

additional search

ne or mo

naid under

Yes

Examination of the protest

tion to pay additional fees under Art.17(3)(a) PCT (the EPO does this - OJ 1989, 61).

Search for all inventions in respect of which a fee is paid

Art.17(3)(a): [§ II.8.2.1]: if one or more additional search fees are

paid, the ISA performs a search on all inventions in respect or which those fees were paid. A single search report including the

citations of all documents retrieved in the search is then issued

A written opinion (WO-ISA) is prepared in respect of each

invention for which a fee was paid (R43bis.1(a) PCT & R44.

S&E GL 17.38: the reasons of the lack of unity are also given in

R40(2)(c) PCT; [§ II.8.3]: the applicant may pay additional fee/s under protest, with a reasoned statement that the application is

unitary, or that the number of the fees requested is excessive

R40.2(e) PCT; [§ II.8.3]: the ISA may request a protest fee.

month from the invitation to pay the additional fees

Rfees 2(1).21 EPC: the EPO charges a protest fee

R40(1)(ii) PCT; [§ II.8.3]: the reasoning must be filed within one

R40.1(iii) PCT; [§ II.8.3]: the protest fee is to be paid within the 1

month period from the invitation to pay additional search fees

R40.2(e) PCT; [§ II.8.3]: if the fee is not paid, the protest is

refunded (§ II.8.3.2).

Protest partially justified; partial refund

R40.2(c) PCT: if the review body finds that

the application did lack unity, but also that

too many additional search fees were

requested (i.e. the protest was justified

only in part), then only the fees which

were unduly requested and paid are

R40.2(e) PCT; [§ II.8.3]: the protest fee is

PCT; & S&E GL 10.62); [§ II.8.2.1 & II.10.15].

Additional fee/s paid under protest

under Art.17(3)(a) PCT.

the WO-ISA

Note: see \$ II 8.2.3 for form and content of the invitation to pay additional search fees, and for a review of relevant case law from the EPO Board of Appeal

Search limited to first invention only

Art.17(3)(a) PCT: [§ II.8.2.1]: if no additional search/es is/are performed by the ISA. The results of the search on the search report.

The ISA also prepares a written opinion (the WO-ISA), limited to such first invention (see R43bis.1(a) PCT & R44.1 PCT; & S&E GL 10.62); [§ II.8.2.1 & II.10.151.

S&E GL 17.38: the reasons of the lack of unity are also given in the WO-ISA. [8 || 10 15]

No protest fee, no refund

If no protest is filed, then there is no which have been paid will be refunded. either in the International, or in any following national / regional phase [§ II.8.3].

Protest fully justified; full refund

R40.2(c) PCT: If the review body finds that the protest is entirely justified, (i.e. that the application meets the requirements of unity of invention and that no additional search fee should have been requested), it refunds all additional search fees paid (§ II.8.3).

R40.2(e) PCT: the protest fee is also

R40.2(c-d) PCT; [§ II.8.3] If any fee is paid under protest, reviews the non-unity objection and the arguments outlined n the applicant's protest. R40.2(d) PCT: the review body can include the examiner Partial who made the decision under protest, but cannot be OJ 2015. A59: the review body at the EPO-ISA is composed of three members; usually these are: the examiner who sent the invitation to pay additional search fees, his director and an examiner with unity expertise.

No refund

Protest not justified; no refund

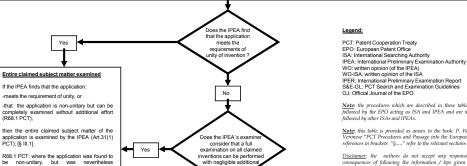
R40.2(c) PCT; [§ II.8.3]: if the review body finds that the protest is not justified, no additional search fee paid is refunded. R40.2(e) PCT; [§ II.8.3]: the protest fee is also not refunded in this case.

Table 5b: Procedure before the EPO acting as IPEA in case of non-unity

The IPEA checks whether the application complies with the unity requirements

Art.31(1) PCT: on demand of the applicant the International application is subject to an International Preliminary Examination by the International Preliminary Examination Authority (the "IPEA"). At the end of the examination the IPEA issues an International Preliminary Examination Report (the "IPER", see § III.1).

Art.34(3)(a) PCT: the IPEA also checks whether the International application meets the requirements of unity of invention according to Art.3(4)(iii) PCT & R13 PCT: [See § III.12]. Art.3(4)(iii) PCT & R13 PCT; the international application must relate to one invention only, or to a group of inventions linked to form a single inventive concept [see § II.8.1 for substantive issues in non-unity].



Note: the procedures which are described in these tables are the one flowed by the EPO acting as ISA and IPEA and are not necessarily

Note: this table is provided as annex to the book: P. Watchorn & A. eronese "PCT Procedures and Passage into the Euronean Phase". The references in brackets "§....." refer to the relevant sections of the book.

Disclaimer: the authors do not accept any responsibility for the consequences of following the information / tips given in this table. Reference must always be made to the official documents (the PCT, the EPC and their implementing regulations and guidelines).

Invitation to pay additional examination fees or to render the claimed matter unitary

Art 34(3)(a) PCT: (\$ III 12.2.1): if the IPFA finds that the application does not meet the requirement of unity of invention, it may invite the applicant to either

restrict the claims in order to render the claimed subject matter unitary.

justified. (i.e. that the application meets

the requirements of unity of invention

and that no additional examination fee

should have been requested), it refunds

R68.3(e) PCT; [§ III.12.3]: the protest

all additional evam fee/s naid

fee is also refunded in this case

completely examined by the IPEA then the

written opinion (if any is prepared by the IPEA) and the IPER must indicate that the application is not unitary, and the reasons why (see also S&E-GL 10.76).

R68.2 PCT; [§ III.12.2.1]: in the invitation the IPEA should give the reasons for the finding of lack of unity, indicate the amount of fees requested, specify at least one way of restriction of the application which would meet the requirements of unity and also invite the applicant to pay any protest fee.

effort?

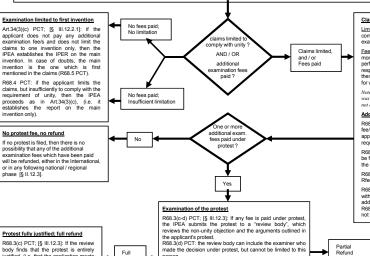
R68.2 PCT: [§ III.12.2.1]: the time limit to limit the claims or to pay additional examination fee/s is one month from the date of the invitation.

R68.3(a) PCT; [§ III.12..2.1]: the amount of the additional examination fee/s is set by the IPEA. R158(2) EPC: the EPO acting as IPEA requests the payment of one whole ation fee for each additional invention (in addition to the first one which was already paid when filing the demand)

R68.3(b) PCT; [§ III.12.2.1]: the additional examination fee/s is/are to be paid directly to the IPEA

R68.3(c) PCT; [§ III.12.3]: the applicant may pay additional fee/s under protest, with a reasoned statement that: the application is unitary or that the fees requested are excessive

Note: see \$ II.8.2.3 for form and content of the invitation to pay additional fees, and for a review of relevant case law from the EPO Board of Appeal



Claims limited and / or fees paid

Limitation: If the claims are limited in such a way that they comply with the requirements of unity, then the IPEA examines the entire subject matter claimed [§ III.12.2.1].

Fees paid; PCT S&E GL 10.77; [§ III.12.2.1]: if one or more additional examination fees are paid, then the IPEA performs a preliminary examination on all inventions in respect of which those fees were paid. A single IPER is then issued, including an opinion on each of the inventions for which fees were paid.

Note: the IPEA will however only examine subject matter which was covered by the international search. Unsearched matter is not examined (R66.1(e) PCT and R70.2(d) PCT).

Additional fee/s paid under protest

R68.3(c) PCT; [III.12.3]: the applicant may pay additional fee/s under protest with a reasoned statement that the application is unitary, or that the number of the fees requested is excessive

R68.2 PCT; [§ III.12.3]: the reasoning of this protest must be filed at IPEA within one month from the invitation to pay the additional fees

R68.3(e) PCT: the IPEA may request a protest fee Rfees 2(1),21 EPC: the EPO charges a protest fee

R68.2(v) PCT [§ III.12.3]: the protest fee is to be paid within the 1 month period from the invitation to pay additional examination fees under Art.17(3)(a) PCT.
R68.3(e) PCT: if the fee is not paid, the protest is deemed

Protest partially justified; partial refund R68.3(c) PCT: if the review body finds that

the application did lack unity, but also that too many additional examination fees justified only in part), then only the fees which were unduly requested and paid are refunded [§ III.12.3].

R68.3(e) PCT; [§ III.12.3]: the protest fee

Protest not justified: no refund

refund

R68.3(c) PCT; [§ III.12.3]: if the review body finds that the protest is not justified, no additional examination fee paid is refunded. R68.3(e) PCT; [§ II.8.3]: the protest fee is also not refunded in this case.

No refund

O.I. 2015. A59: the review body at the EPO-ISA is compose

of three members; usually these are: the examiner who sent

the invitation to pay additional examination fees, his director and an examiner with unity expertise.

Table 6: Acts and time limits to enter the regional phase before the EPO

FPO: European Patent Office EPO European Patent Office
WTO, World Trade Organisation
EP application: European Patent application
EP patent: European patent
EP Bulletin: European patent bulletin
OJ, SEPO Official Journal
OJ, SE Supplement to the EPO Official Journal
EPO: European Patent Convention
EPO: European Patent Convention
EPO: European Patent Convention
EPO: State: State member of the European
Patent Convention

PCT: Patent Cooperation Treaty I.B.: International Bureau

R.O.: Receiving Office

A-III, 6.5.1: EPO Guidelines, part A-III, 6.5.1

Note: The time scale is not to scale, and only provides a rough idea of the sequence in which the different events take place. Also, there are no differences between the events indicated above or beneath the time axis.

Remark: This table is provided as annex to the book: A. Veronese & P. Watchorn "Procedural law unde the EPC 2000". The references in brackets "§....." refer to the relevant paragraphs of the book.

Securing: The uninors were unit unity responsibility for the consequences of following the information / tips given in this table. Reference must shows be made to the official documents (the EPC, its implementing regulations, guidelines and any other official text published by the EPO).

The PCT time limit [§ IV.1.1]

Art.22(1) & Art.39(1)(a) PCT: the applicant must enter the national / regional phase within 30 months of the priority / filing date of the International application.

Art.22(3) & Art.39(1)(b) PCT: however, the national law of the designated / elected states may set a time limit which expires later than the above 30 month time limit (the EPO applies a longer time limit of 31 months under R159(1) EPC).

The EPO time limit [§ IV.1.1]

R159(1) FPC: the time limit to enter the regional phase before the EPO as designated / elected office is 31 months from the priority date (or filing date, if no priority is claimed).

Early national processing [§

Art.23(2) PCT, R47.4 PCT & Art.40(2) PCT, R61.2(d) PCT: on request of the applicant the designated / elected offices may start the processing and the examination of the application at any time.

Note that in this table unless otherwise provided, the articles and the rules which are referred to are those of the EPC

Representation requirements before EPO [§ IV.3]: Art.133(2) EPC & Euro-PCT Guide 461: any applicant can perform the acts to enter the European regional phase before expiry of the 31 month period from the priority/filling date without being represented. However, after entry into the regional phase natural or legal persons having neither residence nor principal place of business in an EPC state must be represented by a professional representative to perform any act (other than payment of fees). If one of these persons has missed a time limit for entry into the regional phase, any procedural step for reinstatement must be taken by a

Address, nationality, state of residence / principal place of business of all applicants [§ IV.11.3]: must be known to EPO within the 31 month period of R159(1) EPC, otherwise the applicant/s is/are requested to provide them within 2 months (R163(4) EPC).

Furnish a translation of the application in an EPO language (if necessary) [§ IV.7.1]; Publication of the translation [§ IV.7.5] Art 153(4) FPC & R159(1)(a) FPC; if the PCT application was not published in an EPO language, the applicant must file a translation of the application into one of these languages (EN/FR/DE), within 31m of the priority/filing date. The EPO publishes this translation.

Specify the documents on which the procedure is to be based [§ IV.5.1]

R159(1)(b) EPC: the applicant must specify the documents, as originally filed or as amended, on which the granting procedure is to be based within 31 months of the priority / filing date.

EPO form 1200: amendments may also be filed when entering the regional phase and later (under R161 EPC). Note: If the request indicates that amendments and/or comments not considered in the EP WO-ISA/IPER were filed, there is no obligation to reply to that WO-ISA or IPER under R161(1) EPC [§ IV.6.1].

Pay the filing fee [§ IV.8.2]

R159(1)(c) EPC: The applicant must pay the filing fee within 31 months of the priority / filing date. The amount is the same as the EPO filing fee for direct EP applications. Rfees 2(1).1 EPC. Page fees are also charged for each page in excess of 35.

Pay the designation fees [§ IV.8.3]

- R.159(1)(d) EPC: The applicant must pay the designation fees by the later of:
- 31 months of the priority date, or filing date, if no priority is claimed (period c.f. R159(1)(d) EPC), or
- 6 months of the mention of the publication of the International search report (period c.f. R.39(1) EPC)

[this applies regardless of whether a supplementary search report is prepared] Rfees 2(1).3 EPC: One flat designation fee is to be paid, which covers the designation of all EPC states.

Fees for extension/validation states [§ IV.8.4]: Extension/validation fees must be paid within the same period as for the designation

fees A-III,12.2. If not paid in time they can be paid in a grace period within two months from expiry of the basic period with a 50% surcharge (OJ 2009, 603 for extension states and OJ 2015, A19 for validation states)

Pay the search fee (if a supplementary search is required) [§ IV.9.2]

Art.153(7) EPC & R159(1)(e) EPC: If a supplementary search has to be prepared by the EPO (see B-IL 4.3), the applicant must pay a supplementary search fee within 31 months of the priority / fling date. Rfees 2(1).2: The amount is the same as the EPO search fee. Refunds of the search fee may apply (Rfees 9(1-2) and § IV.9.4). Reductions may also apply (see § IV.9.4 and EPO GL B-II, 4.3.2).

File the request for examination & pay the examination fee [§ IV.10]

R159(1)(f) EPC: The applicant must file the request for examination (and pay the examination fee) by the later of :

- 31 months of the priority date, or filing date, if no priority is claimed [period under R159(1)(f) EPC, see § IV.10.2], and

- 6 months after the mention of the publication of the International search report [period under R70(1) EPC, see § IV.10.2] [regardless of whether a supplementary search is done. If one is done, confirmation of the request is required [R70(2) EPC, § IV.10.3] Full or partial refunds of the examination fee may apply (Rfees 11 EPC, § IV.10.6). Reductions may apply [R6(3) EPC, Rfees 14 EPC,

Pay the 3rd year renewal fee [§ IV.8.8]

§ IV.10.7).

- R159(1)(g) EPC: Pay the renewal fee by the later of:
- the "due date" under Art.86(1) & R.51(1), [last day of month containing the 2nd anniversary of the filing date, see § IV.8.8.1] and, 31 months from the priority / filing date funder R159(1) EPC, see § IV.8.8.21.

File the "certificate of exhibition" (non-prejudicial disclosures, where applicable) [§ IV.11.1]

R159(1)(h) EPC: Where applicable, the applicant must file the certificate of exhibition (under Art 55 EPC & R 25 EPC) within 31 months of the priority / filing date [mention of it had already to be made on filing the PCT application in the request]

Pay the claim fees (where applicable) [§ IV.8.5]

R162(1) EPC & Rfees 2(1).15 EPC: If the application documents on which the procedure is based contain more then 15 claims, a claims fee is to be paid for the 16th and any subsequent claims within 31 months of the priority / filing date. A "two tier system" applies to claim fees. If there are more than 15 claims different fees apply to claims 16-50 and above 51.

Designation of the inventor [§ IV.11.2]

Art.4.1(v) PCT, R4.1(1)(iv) & R4.6(a) PCT: The PCT application should identify the inventor (in the request form), but failure to do so has no consequences in respect of states allowing this data to be provided later (e.g. EPO). If the applicant did not designate the inventor in the PCT, he is requested by the EPO to do this after entering the European phase according to R163(1) EPC.

File a copy of the priority document and of the priority number [§ IV.11.4.1 and § IV.11.4.2]

R17.1 PCT, R17.2 PCT: If the PCT application claims a priority, a copy of the priority document has to be filed with the IB or RO within 16 months of the priority date. If the priority was filed at the RO, applicants may simply request the RO to forward a copy of the priority to the IB; R.17.2(a) PCT: If the requirement for filing a copy of the priority was already complied with in the PCT phase, the designated offices (here the EPO) cannot require the applicant to file it again with them.

R.17.1(c) PCT: If the copy of the priority document was not filed in the PCT phase, the designated offices (here the EPO) must give the applicant a further chance to file it before considering the priority right lost (before the EPO this is done under R163(2) EPC).

Filing a translation of the priority document [§ IV.11.5]: R53(3) EPC & A-III, 6.8: If the priority document is not in an EPO language and the validity of the priority is relevant to determining the patentability of the invention, then the EPO requests the applicant to file a translation or a declaration that the application is an exact translation of the priority within an EPO period. If the translation is not filed in due time the priority right is lost (R53(3) EPC). Further processing applies to this loss of rights (Art.121 EPC, A-III, 6.8.3).

Comply with the sequence listings requirements (where applicable) [§ IV.14]

Where the application relates to biological sequences, the applicant must supply the EPO a standardised sequence listing in written and electronic format, as prescribed in R30 EPC (this is the same standard which applies in the PCT, WIPO ST.25).

Failure to appoint a representative [§ IV.3)]: R163(5) EPC: If, at the expiry of the 31m period of R159(1) EPC the requirements with respect to representation [Art.133(2) EPC] are not met, the applicant is requested to appoint a representative within two months

Missing indication of address, nationality, or state of residence / principal place of business of any of the applicants [§ IV.11.3] R163(4) EPC: If, on the expiry of the 31m period of R159(1) EPC, any of these indications

is missing for any of the applicants, the applicant is invited to provide them within 2m.

Invitation to reply to WO-ISA, IPER, SIS-report, ESOP [§ IV.5.2; § IV.6; § IV.9.1.2.2]

R161(1) EPC: After entering the EP phase, if there is no supplementary search, the applicant is invited to comment on the WO-ISA, IPER or SIS-report prepared by the EPO and, if these were negative, he is invited to correct deficiencies in the application within 6m In the cases where he is invited to correct deficiencies, if the applicant does not reply in time (and he is not deemed to have already replied), the application is deemed withdrawn This sanction can be remedied by requesting further processing. R161(2) EPC: For applications where a supplementary search is carried out, the applicant

is invited to amend the application within 6m. If it is amended, the application as amended is the basis for the supplementary search under Art.153(7) EPC [B-II, 4.3.3].

R70a(2) EPC: If a supplementary search is done, the applicant is invited to comment on the ESOP, and if negative, is requested to correct any deficiency in the application within the period for confirming the request for examination, otherwise the application is deemed withdrawn. A reply is also automatically considered to be a confirmation of the request for examination under R70(2) EPC, even if not expressly worded as such (C-II, 1.1). R70(2) EPC: If the ESOP is positive, no reply is required, but the request for examination must still be confirmed, otherwise the application is deemed withdrawn (R70(3) EPC).

Consequences of non-fulfilment of certain requirements

- . R160(1) EPC: If one of more of the following occurs:
- the translation referred to in R159(1)(a) EPC is not filed in due time [§ IV.7.3], or the filing fee referred to in R159(1)(c) EPC is not paid in due time [§ IV.8.2], or
- the designation fee referred to in R159(1)(d) EPC is not paid in due time [§ IV.8.3], or
- the search fee referred to in R159(1)(e) EPC is not paid in due time [§ IV.9.3], or
- the request for examination referred to in R159(1)(f) EPC is not filed in time [§ IV.10.5],
- → then the application is deemed withdrawn.

R60(2) EPC: Applicant is informed of loss of rights. R112(2) EPC applies mutatis mutandis

R70(2) EPC: If a supplementary search is performed, the applicant is requested to confirm the request for examination, otherwise the application is deemed withdrawn (R70(3) EPC, § IV.10.3) [where a reply to the ESOP is required, see note above].

A-III, 12.2; [§ IV.8.4]: If an extension/validation fee is not paid, the request for extension/validation is deemed withdrawn. A communication informing of this loss of rights is only sent if a loss of a designation also occurred. Only in this case can a request for further processing for failure to pay an extension be filed. If not paid in time they can be paid in a grace period within two months from expiry of the basic period with a 50% surcharge (O.I.2009, 603 for extension fees and O.I.2015, A19 for validation fees)

Late payment of the renewal fees [§ IV.8.8.3]

R51(2) EOC: If the renewal fee is not paid by the due date, it can be paid within 6 months of this date with a surcharge (of 50% - Rfees 2(1).5 EPC)

J4/91: Where the time limit under R51(1) EPC applies to determine the normal period for payment of renewal fees, then the 6 month period for payment with surcharge expires on he last day of the 6th month after the due date.

L5/93 (abandoned): If the 31 month period of R159(1) EPC applies to determine the normal period for payment of a renewal fee, then the 6 month period for payment of this fee + surcharge is calculated as an aggregate time limit which starts the day after expiry of the 31 month period and ends on the day 6 months later corresponding to the date of expiry of the 31 month period.

Late payment of the claims fees [§ IV.8.5]

R162(2) EPC: Where a claims fee is not paid in due time, the applicant is invited to pay it within one month of an invitation (no surcharge is required). If within this period a new set of claims is filed, the claim fees are calculated on the basis of the new set of claims.

Late designation of the inventor [§ IV.11.2]

R163(1) EPC: If the data concerning the inventor in the form prescribed by Art.81 EPC & R19(1) EPC have not been filed within the 31 month period of R159(1) EPC, the EPO invites the applicant to designate the inventor within a 2 month period

Late filing of copy of Priority- Document or Number at EPO [§ IV.11.4.1.2; § IV.11.4.2]

R163(2) EPC: If the applicant did not file a copy of the priority document or the priority number within the 31 month period of R159(1) EPC, then the EPO invites him to file it within two months (if the priority document was already filed in the PCT phase, the applicant cannot be obliged by the EPO to file it again.

R163(2) EPC, R53(2) EPC & O.I 2012, 492; If the priority document was an EP application a PCT application filed at the EPO as RO, a JP or Korean patent application or utility model, or a US patent application or provisional patent application subject to the exchange agreement between the EPO and the USPTO or a Chinese patent/utility model application, then the applicant does not need to file the document again at EPO (PCT applications filed at the JPTO as RO are no longer included in this list).

Invitation to comply with the sequence listing requirements [§ IV.14]

R163(3) EPC: If the applicant has not filed with the EPO the written and/or the electronic sequence listings in the prescribed form within the 31 month period of R159(1) EPC, then he is invited to file it/them within 2 months. A late filing fee is also due (R30(3) EPC).

Failure to provide correction in due time

R163(6) EPC: If the deficiencies noted under R.163(4).(5) are not corrected in time, then the EP application is refused.

Appealing refusal

The applicant is informed of the reasons for refusal (R111 FPC) & can appeal (Art.106 EPC).

NOTE: Re-establishment (Art.122) applied to further processing period (Art.121)

E-VII, 2.2.1: Re-establishment is ruled out in respect of any period for which further processing is available (R136(3) EPC). However, reestablishment is applicable to the period for requesting further processing itself. Thus, reestablishment applies indirectly to all time limits to which further processing applies, but is not directly available as a remedy until the further processing period is also missed. This must be considered in all following cases where further processing is applicable.

Further processing is applicable under Art.121 [§ IV.16.2; § IV.17.1]

Art.121 EPC & R135 EPC: If the applicant fails to observe a time limit visà-vis the EPO [e.g. under R159(1) EPC or R.163(4),(5) EPC] he may request further processing of the application according to the regulations [i.e. R.135]. If the request is allowed the loss of rights is deemed not to

R135 EPC: Further processing is requested by doing the following within two months of the date when the loss of rights is notified:

- naving the further processing fee and

completing the omitted act [e.g. paying a fee or filing a translation]

R135(2) EPC: The R159(1) EPC and R163 EPC periods are not excluded from further processing

Rfees 2(1).12 EPC: Amount of the further processing fee.

Applicability re-establishment of rights under Art.122 [§ IV.17.2]

R136(3) EPC: Re-establishment of rights is ruled out in respect of any period for which further processing is available [e.g. the periods under R159 EPC / R163 EPCI.

E-VII, 2.2.1: However, re-establishment is applicable to the period for requesting further processing. This means that, if the applicant fails to request further processing in time after a loss of rights ensued under R160 EPC or R163 EPC, he may request re-establishment according to Art.122 EPC for missing the time limit for requesting further processing.

Reinstatement under R49.6 PCT [§ IV.16.1]

Before the EPO, reinstatement of rights under R49.6 PCT is possible (only) to remedy losses of rights ensuing for failure to file the translation and to pay the national fee (i.e. the EPO filing fee) in due time.

Renewal fee not paid [§ IV.8.8.4]

Art 86(1) EPC: If the renewal fee is neither paid within the normal time limit nor the additional 6 month period with surcharge the application is deemed withdrawn

J4/92: The loss of rights ensues at the end of the 6 month period.

Re-establishment, Art.122

Further processing:

Excluded by R.135(2)

Not excluded

Failure to pay claim fee/s [IV.8.5]

R162(4) EPC: if a claims fee is not paid in due time, the claim concerned is deemed abandoned

Failure to designate the inventor

R163(6) EPC: If the inventor is not designated, then the application is refused [§ IV.11.2].

Failure to file copy / number of

R163(6) FPC: If deficiencies in the priority claim are not corrected in due time, then the priority right is

Failure to file sequence listings

R30(3) EPC: If the required sequence listing is not filed and/or the late filing fee is not paid on time, then the application is refused [§ IV.14].

Acts which may be required to avoid a loss of rights

Appealing the refusal The applicant is informed of the reasons for refusal

Further processing

Further processing: Art 121 EPC applicable not

Art 121 FPC applicable: not

excluded by R.135(2) EPC.

excluded by R.135(2) FPC.

(R111 EPC), & can appeal (Art.106 EPC) Further processing:

Art.121 is applicable: Not excluded by R135(2) FPC

(excluded for Euro-direct -

Further processing: Art.121 EPC applicable: Not excluded by R135(2) EPC.

Appealing the refusal The applicant is informed of reasons for the refusal (R111 EPC) and can appeal

(Art.106 EPC)

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Table 7a: Lack of unity passing into the regional phase before EPO – supplementary search performed – IV.12.1

Legend:

PCT: Patent Cooperation Treaty

EPC: European Patent Convention

EPO: European Patent Office

Yes

ISA: International Searching Authority

SISA: Supplementary International Searching Authority

Note: This table is provided as annex to the book: P. Watchorn & A. Veronese "PCT Procedures and Passage into the European Phase". The references in brackets "S" refer to the relevant paragraphs of the book.

Disclaimer: The authors do not accept any responsibility for the consequences of following the information / tips given in this table. Reference must always be made to the official documents (the PCT, the EPC and their implementing regulations and guidelines).

Art.22 PCT & 39 PCT; R159(1) EPC; § IV.1: The applicant must enter the European regional phase before the EPO as designated / elected Does the EPO search office within 31 months from the priority date (or filing date if no Yes division consider that priority is claimed). the application The issue of unity is considered by EPO after entry in the European complies with the requirements of unity regional phase. The procedure which is followed by EPO depends on whether or not a non-unity objection was been raised in the of invention? International phase, and on whether a supplementary search report is prepared by EPO [see § IV.12]. No Non-unity: Applicant invited to pay additional Supplementary search on entire subject matter supplementary search fees If, when performing the European supplementary R164(1) EPC: § IV.12.1: if the EPO considers that the search the EPO search division finds that the application documents which are to serve as the basis for the application is unitary, it searches the entire claimed supplementary search do not meet the requirements of unity subject matter [§ IV.12.1]. of invention, then it issues an invitation to the applicant This is possible even if a non-unity objection was

requesting payment of additional supplementary search fees for inventions other than that first mentioned in the claims previously raised during the International phase and along with the search results on the first invention in the the application was searched by the ISA only in part. claims. The time limit for payment is two months.

> A supplementary search report is then drawn up on those parts of the application which relate to the invention, or the group of inventions within the meaning of Art.82 EPC, first mentioned in the claims and any other inventions for which additional fees are paid.

> Note that the additional search fees paid do not benefit from the fee reduction under Art.153(7) EPC [OJ 2014, A70].

> B-VII, 2.3: The non-unity finding of the Search Division is independent of any previous finding of the ISA.

> Note: The supplementary search is based on the latest filed application documents available at the end of the time limit according to R161 EPC [B-II. 4.3.3 - see § IV.9.1.1]. If a lack of unity objection was already raised by the ISA in the international phase and a supplementary search is to be carried out, it is advisable for the applicant to amend the claims in due time and to have the invention on which he wishes the examination to be carried out mentioned first in the claims, that way, he will not have to pay an additional search fee to have this invention searched, if the EPO agrees with the lack of unity.

Non-unity: examination based on an invention covered by the supplementary search

OJ 2014, A70 & G2/92; § IV.12.1: if the Examining Division finds

-the application documents on which the European grant procedure is to be based do not meet the requirements of unity of invention, or -protection is sought for an invention not covered by the supplementary search report.

then it shall invite the applicant to limit the application to one invention covered by the supplementary search report.

OJ 2014, A70 & G2/92; § IV.13: an applicant wishing to have an unsearched invention examined has to file a divisional application.

C-III, 3.2: Any inventions which are excised (searched or not) may be the subject of a divisional application

Amendments / arguments filed after the transmission of the search report

R137(5) EPC; E-VIII, 4.2; § IV.12.1: If after receiving the supplementary search report the applicant files amended claims relating to an invention which differs from any of the originally claimed inventions or groups of inventions and does not combine with these inventions to form a single inventive concept, an objection under R137(5) EPC should be raised in the first communication.

Furthermore, the Examining Division is convinced, e.g. by arguments from the applicant in reply to the ESOP, that the application is unitary but where additional search fees were not paid, then an additional search will have to be carried out by the EPO during examination proceedings free of charge on the part of the application which appears to be unitary with the invention which was searched (C-III, 3.1.1 and C-IV, 7.2) and the examination will cover this part.

upholds the opinion of the search division with regard to unity of invention (C-III, 3.1.1). In the present case, if it agrees that the

§ IV.12.1: The examining division normally

Does the examining division

uphold the finding that the

application is unitary?

application is unitary, then the entire subject matter claimed (which was also searched in the supplementary search) is examined by the examining division.

The examining division is responsible for taking the final decision on non-unity (T631/97).

C-III, 3.1: However, if during examination the examining division concludes that the application is non-unitary, this will be addressed early in examination (i.e. the EPO may request the applicant to limit the application to one invention only) [see § IV.12.1].

No

The applicant may file a divisional application under Art.76 EPC and R36 EPC for any subject matter which is excised from the application (C-III, 3.1.1).

The examining division is responsible for taking the final decision on non-unity (T631/97, C-III, 3.1.1).

Note # 1: when does the EPO carry out a supplementary search

Under Art.153(7) EPC, the EPO performs a supplementary search report on all international applications which enter the European regional phase, if the international search or supplementary International search was not performed by the EPO (acting as ISA or SISA). Furthermore, no supplementary search is performed on applications filed before 01.07.2005 where the Swedish, the Spanish or the Austrian patent office performed the international search (acting as ISAs). For more information see also § IV.9.

Note # 2: cases where R63 and / or R62 apply, which also lack unity

For the exceptional cases where R63 and/or R62 apply (as in force from April 1, 2010), which also lack unity, see the EPO Guidelines B-VIII, 3.4 and B-VIII, 4.5.

Assessing unity of invention under the PCT and under the EPC

The legal provisions relating to the assessment of unity of invention which are laid down in the PCT (Art.3(4)(iii) PCT and R13 PCT) are identical to those laid down in the EPC (Art.82 EPC and R44 EPC); according to both the PCT and the EPC, an application must relate to one invention only, or to a group of inventions linked to form a single inventive concept [see § II.8.1 & IV.12].

Although the legal provisions concerning the assessment of unity under the PCT and the EPC are the same, and theoretically there should be no divergences in the non-unity findings by the international and the regional authorities, it sometimes happens that an application which was found non-unitary in the international phase is found to be unitary in the EPO regional phase and vice-versa.

Filing divisional applications:

Art.76 EPC: A European divisional application shall be filed directly with the EPO in accordance with the Regulations. It may be filed only in respect of subjectmatter which does not extend beyond the content of the earlier [parent] application as filed: in so far as this requirement is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority.

R36 EPC: The applicant may file a divisional application relating to any pending earlier European application. For more information concerning when an application is considered pending, see the EPO guidelines A-IV, 1.1.1.

Table 7b: Lack of unity passing into the regional phase before EPO – No supplementary search performed [IV.12.2]

Legend:

Art.22 PCT & 39 PCT; R159(1) EPC; § IV.1: The applicant must enter the PCT: Patent Cooperation Treaty European regional phase before the EPO as designated / elected office within **EPC: European Patent Convention** 31 months from the priority date (or filing date if no priority is claimed. EPO: European Patent Office Was a non-unity Yes ISA: International Searching Authority objection raised by The issue of unity is considered by EPO after entry in the European regional SISA: Supplementary International Searching Authority the EPO as (S)ISA phase. The procedure which is followed by EPO depends on whether or not a in the International non-unity objection was been raised in the International phase, and on Note: This table is provided as annex to the book: P. Watchorn & phase? A. Veronese "PCT Procedures and Passage into the European whether a supplementary search report is prepared by EPO [see § IV.12]. Phase". The references in brackets "§" refer to the relevant paragraphs of the book. No Disclaimer: The authors do not accept any responsibility for the consequences of following the information / tips given in this table. Reference must always be made to the official documents Is more than one (the PCT, the EPC and their implementing regulations and invention still guidelines). present in the Do the claims on file on Are inventions not claims? expiry of the period under searched by the R161(1) EPC claim (an) EPO as (S)ISA No No invention(s) imported present in the claims from the description, on file on expiry of Yes which is/are not unitary the period cf No with the subject matter R161(1) EPC?* claimed on filing in the PCT [C-III, 2.3]? Yes Yes Invitation to pay additional search fees for unsearched inventions* sent by EPO Examining Division under R164(2)(a) Yes EPC. Time limit is 2m [§ IV.12.2.2]. Does the Examining Division agree that unity All claimed subject matter is examined. s present [§ IV.12.2.1] R164(2) EPC Fees Applicant sent search results with an examination No paid? communication under Art.94(3) EPC/R164(2)(c) EPC. He All must limit the claims: to one invention (satisfying unity requirement under Art.82 EPC), and Applicant must limit claims to: which was present in the claims on expiry of the period under R161(1) EPC (satisfying R164(2)(c) EPC) to one invention, thus satisfying the unity requirement (Art.82 which was present in the claims on expiry of the period under None Applicant sent search results with an examination communication R161(1) EPC, thus satisfying R137(5) EPC (H-II, 6.2). under Art.94(3) EPC/R164(2)(c) EPC. He must limit the claims to: one invention (satisfying unity requirement under Art.82 EPC) * According to C-III, 2.3, this includes: Some where this invention was searched by the EPO (satisfying Inventions claimed on filing in the PCT, for which the applicant did not R164(2)(c) EPC): pay additional search fees when requested to do so by the EPO as ISA as (S)ISA in the PCT, or under Art.17(3) PCT/R40 PCT; in the EP phase under R164(2) EPC Inventions other than the single invention searched by the EPO as SISA, because payment of additional search fees to the SISA is not where this invention was in claims on expiry of period under possible (R45bis.6(a)(ii) PCT); R161(1) EPC. Applicant sent an examination communication under Art.94(3) Inventions imported from the description, where these are not unitary EPC. He must limit the claims to: with the subject matter claimed on filing in the PCT, provided that this was done no later than expiry of the period under R161(1) EPC; one invention (satisfying unity requirement under Art.82 EPC) Filing divisional applications: Inventions resulting from a cascade non-unity in the PCT (II.8.2.4). where this invention was: Art.76 EPC: A European divisional application shall be filed directly with the EPO in accordance with the Regulations. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier · searched by the EPO as (S)ISA in the PCT (satisfying [parent] application as filed; in so far as this requirement is complied with, the divisional application shall be deemed R164(2)(c) EPC), and to have been filed on the date of filing of the earlier application and shall enjoy any right of priority. · in claims on file on expiry of period under R161(1) EPC

R36 EPC: The applicant may file a divisional application relating to any pending earlier European application. For more information concerning when an application is considered pending, see the EPO guidelines A-IV, 1.1.1.

Table 8: Calculation of time limits under the PCT:

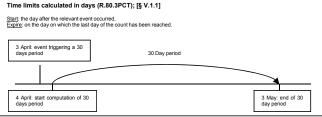
The calculation of a time limit requires the definition of the relevant date triggering the start of the time limit and the computation of the applicable period. The triggering event can be the priority date or the filling date, or the notification of a document requesting the applicant to perform a procedural act within a certain period.

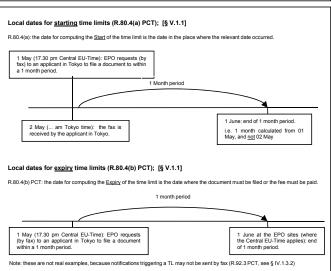
Under the PCT, the time limits which are triggered by the delivery of a document from a national office or an International organization, start to run the day after the date borne by that document or letter, unless the person concerned proves that the document / letter was posted at later date, or that it was delivered more then seven days later then the date which it bears. In these

In this regard the PCT differs from the EPC, which deems all communications posted by EPO as delivered 10 days after the date of

Time limits calculated in years (R.80.1 PCT); [§ V.1.1] Start: the day after the relevant event occurred, <u>Expire</u>: on the relevant subsequent year, on the same day as the relevant event, provided that if the date of the following year does not exist (i.e. 29 February), then the time limit expires the last day of the month (i.e. 28 February). 25 Mar 1992: event triggering a 10 Year period 10 year period 26 Mar 1992: start computation 25 Mar 2002: end of 10 year period 10 year period

Time limits calculated in months (R.80.2 PCT); [§ V.1.1] Start: the day after the relevant event occurred, Expire: on the relevant subsequent month, on the same day as the relevant event, provided that if that month has no day with that number (e.g. 31 April), then the time limit expires the last day of the month (i.e. 30 April). 11 May 2000: event triggering 3 Month period 12 May 2000: start computation of 11 Aug 2000: end of



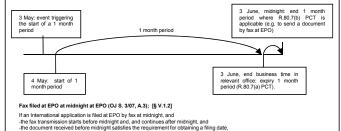


End of working day (R.80.7(a-b) PCT); [§ V.1.2]

R.80.7(a) PCT: a time limit which expires on a particular date expires at the time when the office where the document must be filed, or the fee must be paid is closed for business

R.80.7(b) PCT: any office may extend the time limit under R80.7(a) PCT to expire up to midnight on the relevant day.

OJ S. 3/07, A.3: EPO accepts the filling of documents by fax up to midnight of the relevant day



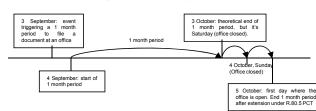
midnight, provided that he renounces to the part received later Extension of time limits (R.80.5PCT); [§ V.1.3.1]

- 8.80.5 PCT: Where a time limit for paying a fee or filing a document expires or
- -a day when that authority is not open to the public for official business, or -a day when ordinary mail is not delivered in the locality where the authority is situated

-then the annlicant may request the EPO to accord a filing date to the part of the document received before

- where the authority is situated in one or more locality on a day where at least one locality is closed and where the law of that office allows the time limit to expire on a subsequent day,
 -where the authority is the office of a PCT state, one day which is an official holiday in a part of that state and where the national
- law allows the time limit to expire on a subsequent day

-then the time limit expires on the next day where none of these situations applies.



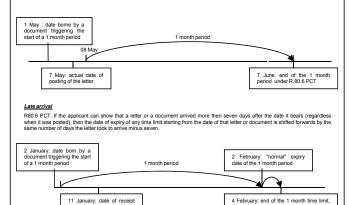
Notifications & time limits: late posting / late delivery of documents at the applicant (R80.6 PCT) [§ V.1.3.2]

Art.47(1) PCT: The details for computing time limits in PCT are governed by the regulations (e.g. R80.6 PCT)

R80.6 PCT: if a time limit starts to run on the day indicated on a document or letter emanating from a national office or International

-and an interested party can prove that it was posted later than the date which it bears -then the actual date of mailing applies for computing such time limit.

(it took 9 days to arrive)



Postal delays: late arrival of documents from the applicant (Art.48(1) & R82.1 PCT); [§ V.1.3.3.1]

Art.48(1) PCT: where a time limit is failed due to postal delays / loss in the mail, the time limit is deemed met, subject to the conditions set out in the regulations (here R82.1(a-b) PCT)

Late arrival & "Five days rule"

R.82.1(a) PCT: any interested party may prove that he has mailed the letter or document five days or more before the expiry of the time limit. This only applies when the letter or document was sent by:

-airmail, and was registered with the postal authorities, or

-other mail registered with the postal authorities but only if: surface mail normally arrives in more then 2 days, or no air mail is available. R82.1(b): PCT: If a party proves to the satisfaction of the national office or international organisation which is the addressee, that the conditions under R82.1(a) where met, then the delay is excused

Lost in the mail & "Five day rule"

R.82.1(b) PCT: if a party proves to the satisfaction of the national office or international organisation to which the letter or document was addressed that

-the letter or document was posted at least five days before the expiry of the time limit, according to the conditions under R82.1(a), and -the party can prove that the item was lost in the mail, and

-the party can prove that a replacement is identical to the lost item

- then the replacement can be allowed (and the time limit be deemed met).

Evidence required:

R82.1(c): PCT: the following evidence must be filed:

-evidence of the date of mailing

-the substitute document (in case of loss),
-proof that the substitute document or letter is identical to the original (in case of loss).

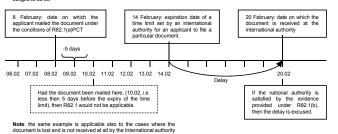
R82.1(c) PCT: the above evidence must be supplied within the following period:

one month after the party has noticed, or should have noticed the delay or loss of the letter or document, but,

-not later then 6 months after the expired time limit.

Delivery services

R82.1(d) PCT: any national office or international organization can apply the provisions of R82.1 PCT to delivery services other then postal authorities. When an office has informed that it accepts the application of R82.1(a) PCT to such delivery services, then it is



Force majeure (Art.48(1) PCT & R82quater.1 PCT); [§ V.1.3.3.2]

Art.48(1) PCT: where a time limit is failed due to postal delays / loss in the mail, the time limit is deemed met, subject to the conditions set out in the regulations. (Here R82quater.1 PCT).

R82quater.1(a) PCT: Any interested party may offer evidence that a time limit before the RO/IB/ISA/SISA/IPEA and set in the regulations was missed because of war / strike / revolution / civil disorder / natural calamity / other like reason in the locality where the interested party resides / has his place of business / is staying and that the relevant action was taken as soon as reasonably possible (after the events in

R82quater.1(b) PCT: Such evidence must be addressed to the office in question not later than 6m after expiry of the time limit in question. If the office in question is convinced, the delay in meeting the time limit is excused.

R82quater.1(c) PCT: The excuse of a delay need not be taken into account by any designated/elected office where the decision to excuse the delay is taken after the applicant has performed the acts referred to in Art.22 PCT/Art./39 PCT before that designated/elected office [for national/regional phase entry].

Legend:

PCT: Patent Cooperation Treat

FPO: Furonean Patent Office

(9 days it took to arrive minus 7 days: 2

Note: this table relates to the computation of time limits under the PCT. Once an application has entered the regional phase before the EPO, the provisions of the EPC are applicable. Although similarities exist between the computation of time limits under the PCT and the EPC, notable differences exist. For example, time limits triggered by notifications are computed differently (see § V.1.3.2). Note also that the time scale in the examples provided in this table is not accurate and only provides a rough idea of the sequence in which the different events take place

Remark: this table is provided as annex to the book: P. Watchorn & A. Veronese "PCT Procedures and Passage into the European

Phase". The references in brackets "\(\xi_{\text{.....}}\)" refer to the relevant paragraphs of the book.

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Table 9: Mandatory reply to the ESOP [§ IV.9.1.2.2] and to the WO-ISA, IPER or comments accompanying the SIS-search report [§ IV.6.1]

