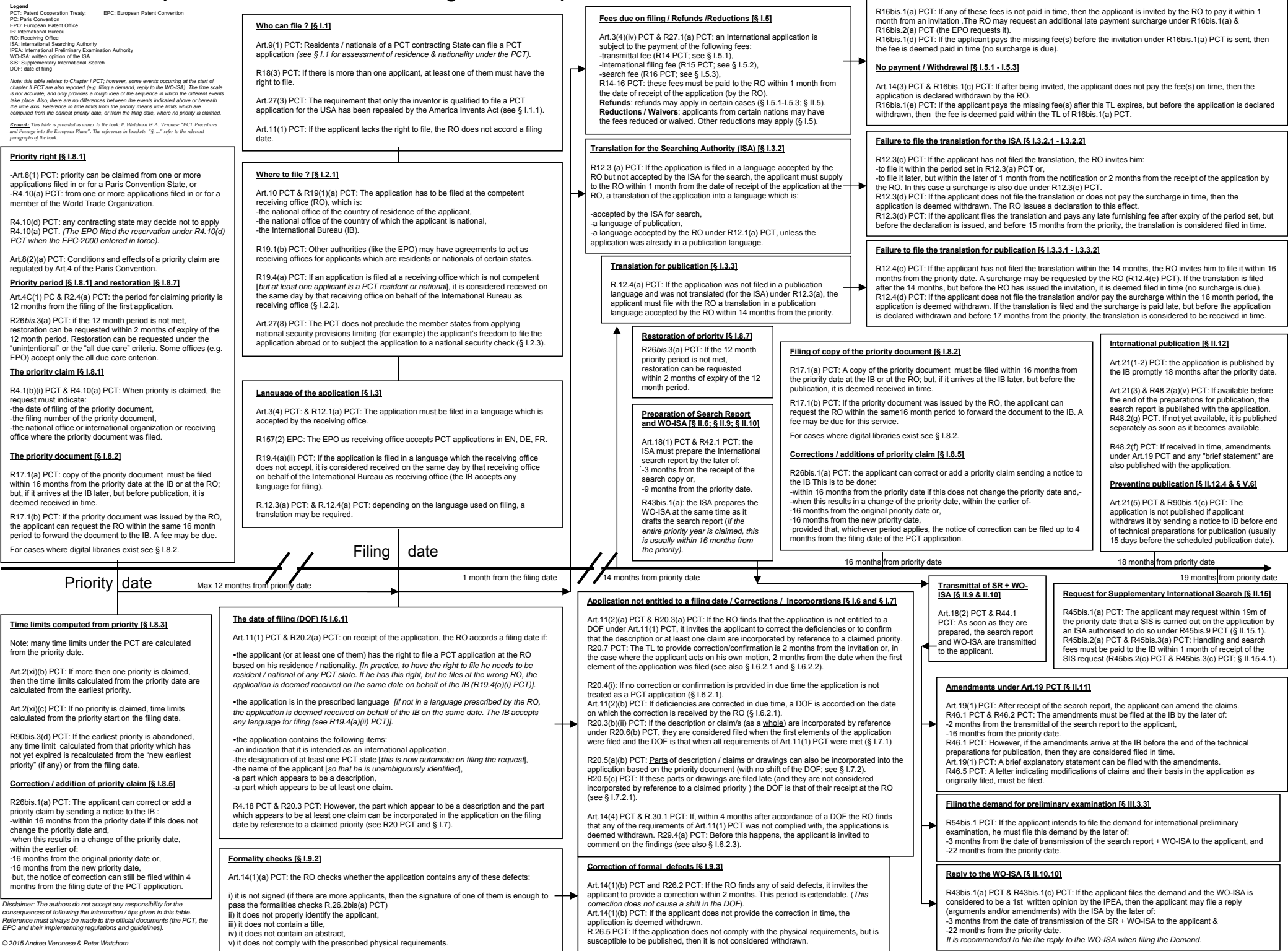


Table 1: Relevant provisions and time limits relating to PCT Chapter I



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).

Table 3: Relevant provisions relating to the International and the Supplementary International Searches.

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 step.

R.332-3 PCT and § II.1 explain that the following are also mentioned in the search report:

- a) oral disclosures which occurred before the International filing date and which are confirmed by a written disclosure which occurred after the International filing date, and
- b) patent applications published after the International filing date of the examination being searched, but having an earlier filing date.

Art.16(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 (§ 1.2)

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

R35.1 PCT & R35.2 PCT: the RO may specify that more than one ISA is competent. In this case the subject 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 (§ 1.2.1).

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 broaden the choice of the possible ISA(s) competent to search that application (§ 1.2.1).

The EPO as ISA (§ 1.2.2)

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, Japan).

The search fee (§ 1.5.3 & § 1.5.4)

Art.3(a)(iv) & R.16:1 (a) PCT: the ISA may charge a fee to perform the international search.
R.16:1(a) 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 filing of the application.
(See § 1.5.3 for late payment of search fees & for sanctions for late payment / failure to pay).
R. fees 2(1) 2 PC: the EPO (acting as ISA) charges a search fee when acting as ISA.

Refunds of the search fee (§ 11.5.1; § 11.5.2)

The search fee is refunded:

- R.16:20(2) PCT: if the application is not recorded a filed date.
- R.16:20(3) PCT: if the application is withdrawn or deemed withdrawn before transmittal of the search copy to the ISA. Bu, QJ 2010, 304; the EPO is more generous, and refunds the search fee if the application is withdrawn/deemed withdrawn before the search is begun.
- R.16:20(3) PCT: if the application is not treated as a PCT application due to considerations of national security.
- R.16:3 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 refund depends on the degree of overlap of the claimed subject matter.
- Ref 1 PCT, R4 12(2) PCT: the refund must be requested in the request form [the EPO does not require this – Euro-PCT Guide 145].
- R12b.1 (a) PCT: copy / translation of the earlier search results and of the earlier application may also have to be provided in this refund to apply.

R.16:1 (a) 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 [QJ 2010, 304]).

Reductions of the search fee § 1.5.3

QJ 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

R23.1(a) PCT & (R22.1 PCT): the search copy is transmitted by the RO to the ISA promptly after receipt of the application to the RO, where:

- a filing date is accorded under Art.11(1) PCT, and
- there are no national security checks to be carried out, (and if there are any they have been already made), and
- 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 is not required to be searched 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 theories,
- 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)(i) 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 application does not contain:

- sequence listings which comply with the standards of the Administrative Instructions, and
- sequence listings in electronic form complying with the Administrative Instructions,

the ISA can require the applicant to file such sequence listings within a time limit set in the invitation.

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.

Non-uniquely in search (§ 8.1.8)

Art.3(4)(ii) PCT: the international application must comply with the requirements of unity.

R13 PCT: defines the criteria to establish whether unity is complied with (§ 8.1.8.2.1).

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 § 8.1.2.1 for the procedure and see also § 8.1.2.3 for the content of the invitation to pay additional fees).

R40.2(b) PCT: the additional search fees is/are to be paid to the ISA (§ 8.1.8.2.1).

R40.1(ii) PCT: the time limit to pay is 1 month from the date of the invitation (§ 8.1.8.2).

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 (§ 8.1.8.2.1).

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.

Protest procedure (§ 11.8.3)

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

- the application is unitary, or,
- that the additional fees are excessive.

R40.1(i) 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(1)21 EPC: the EPO charges a protest fee under R40.2(e) PCT.

R.40.1(ii) PCT: the time limit for the payment of the protest fee is one month from the date of invitation by the ISA to pay additional search fees.

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.

OJ 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 phase).

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 (then any additional fees in excess is refunded),
- c) the application is not-unitary and the number of fees requested was not excessive (then no refund is granted).

R40.2(e): if the review body finds that the protest was entirely justified, then also the protest fee is refunded (together with all additional fees paid).

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 priority date, or from the filing date, where no priority is claimed

Publication of the search report [§ II.12.1]

Art.21(1-2) PCT: the International Bureau publishes the PCT application promptly 18 months after the priority date.

Late publication of the search report (§ II.12.1)

R48.2(g) PCT: if the search report is not yet ready at the time of publication it is published separately as soon as it becomes available. *(This is called an "A3" publication).*

of the application (usually 15 days before the scheduled publication date), it is published with the application (§ 11.12.1) (in this case the publication is identified as an "A1" publication).

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 (§ 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 (§ 11.9)

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

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.).

Incomplete search or no search (§ 11.7)

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 search it, or
- 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 (§ 11.7.1).

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 (§ II.7.2).

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:

(ii) compliance with the "requirements of the PCT" in as far as these are checked by the ISA (the WO-ISA may, for example, contain observations on formal defects of the application or observations on the clarity, support and disclosure of the invention; see § II.10.9).

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

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).

R45b.9(a) PCT: an ISA may act as ISA-SIS if this is allowed for in an agreement between the ISA and the IB.

R45b.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).

R45b.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 R45b.9 PCT, the applicant may choose any ISA to perform a SIS.

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,
- 6 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 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.

R44b1. (a) PCT: where no international preliminary examination report has been or is to be issued (i.e. if 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.

R44b1. (b) PCT: The report is called "*International preliminary report on patentability (Chapter I of the Patent co-operation Treaty)*".

R44b1.3(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. R44b1.3(b) PCT & R44b1.4 PCT: The IB is responsible for providing this translation but the applicant is given the opportunity to make observations on its correctness (S II.10.14).

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) PCT.

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 [§ II.10.11.2]

R44ter.1(a) PCT: except with the authorisation of the applicant, the IB and the ISA may not allow access by any person of 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.***

Applications 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 priority:

- the WO-ISA,
- the report based on the WO-ISA
- the translation of WO-ISA
- the translation of report based on WO-ISA.

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]

R45b5.1(g) PCT: the SIS search is carried out on the application as filed (or a translation thereof).
PCT-A1, 8.040: amendments made under Art.19 PCT are not taken into account (§ II.15.5).

R45b5.5(c) PCT and Art.17(2) PCT: limitations of the SIS may apply if the application concerns subject matter that the ISA 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 (§§ II.15.8).

R45b5.6(a) PCT: if the ISA 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).

R45b5.7(a) PCT: the SIS must be prepared within 28 months from the priority date (§ II.15.7).
R45b5.7(c) PCT: provisions on form and 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 not need to be recited).

R45b5.8(a) PCT & PCT-A1, 8.051: the ISA 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 IEPA.
the IEPA takes the SIS into account if it receives it in time before drafting any WO or IP, (§ II.15.11.
PCT-A1, 8.053: the SIS is not published but is rendered available by the IB under "PatentSCOPE".

Legend:

PCT: Patent Cooperation Treaty
EPO: European Patent Office
OJ: EPO Official Journal
RO: Receiving Office
IB: International Bureau
ISA: International Searching Authority
IPEA: International Preliminary Examination Authority
WO-ISA: Preliminary opinion from the ISA
SIS: Supplementary International Search
SISA: ISA performing the SIS
TL: time limit
DOF: date of filing
PCT-AG: PCT applicant's guide

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).

Note: the search can be suspended by the ISA if the application relates to nucleotide / amino acid sequences, and no sequences in electronic form have been filed [see § II.13.1].

Time limit to prepare the Search Report (§ II.6)

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:

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

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Events taking place during the search procedure

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

Table 4: Procedure before the International Preliminary Examination Authority (IPEA)

Legend:

PCT: Patent Cooperation Treaty
EPC: European Patent Convention
EPO: European Patent Office
PCT-AQ: PCT applicant's guide
S&E-GL: PCT Search and Examination Guidelines
IB: International Bureau
RO: Receiving Office
ISA: International Searching Authority
IPEA: International Preliminary Examination Authority
WO: written opinion (of the IPEA)
WO-ISA: written opinion of the ISA
IPER: International Preliminary Examination Report
TL: time limit

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 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/filing date mean time limits which are computed from the earliest priority date, or from the filing date, where no priority is claimed.

Report based on the WO-ISA (§ II.10.13)

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 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 I of the Patent Co-operation Treaty)". For translations of this report see § II.10.14.

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.

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 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.

When can the IPEA start examination (§ II.10.2)

R69.1(a) PCT & R54bis.1(a) PCT: the IPEA cannot start the preliminary examination before 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.

This unless the applicant requests an earlier start. This is also subject to the exceptions of R69.1(b-e) For more information on these exceptions see § III.10.2.

Start of examination at search stage (§ III.10.2)

R69.1(b-e) PCT: this regulation allows an ISA which also acts as IPEA, to start the examination early (at the search stage) if some conditions are met. In particular:
- the demand must already have been filed,
- no postponement of the examination has been requested,
- any amendment mentioned in the demand must be available.

For more information on this topic see § III.10.2.

WO-ISA considered as first WO of the IPEA (§ III.10.1.1)

R66.1bis(a) PCT: the WO-ISA is considered as the 1st written opinion (WO) of the ISA.

This means that in this case the IPEA may issue the IPEA without the need to issue its own WO. The IPEA has however the discretion to issue another WO (OJ 2011, 532 – the EPO usually issues a second WO).

Where the WO-ISA is considered the 1st written opinion by the IPEA, the applicant may file at the IPEA a reply to the WO-ISA in order to have arguments and / or amendments considered in the IPEA. The reply must be filed within the TL for filing the Demand of R54bis PCT (R43bis.1(c) PCT) in order to be considered by the IPEA; i.e. it has to be filed in due time before the IPEA is established (§ II.10.10).

Issue of a written opinion (WO) (§ III.10.3.2)

Art.34(2)(c) & R66.1bis(b) PCT: any IPEA may notify the IB that it will not accept the WO-ISA of a different ISA as a WO. In such cases the IPEA is obliged by Art.34(2)(c) PCT to issue its own WO before the IPEA is established. (For the content of the WO see § III.10.3.4)

Further written opinions (§ III.10.5)

R66.4(a) PCT: if the IPEA wishes so, it may issue a further WO, but this is at the discretion of the IPEA. (For the content of the WO see § III.10.3.4).

OJ 2011, 532 – However, the EPO usually issues a second WO where it was the ISA.

yes

does the IPEA issue a further written opinion?

No

28 months from priority / filing date

Establishment of the IPEA (§ III.10.7)

Art.35(1) PCT: the International Preliminary Examination Report is established in the prescribed form and is produced within the prescribed time limit.

Form & content of the IPEA (§ III.7.1 - III.7.3)

Art.35(1-2) PCT: the IPEA must be in the prescribed form. In particular the report must contain a statement indicating whether the claims comply with the criteria of novelty / inventive step and industrial applicability (§ III.7.1).
Art.35(2) & R70.6(a) PCT: explanations on the findings must be given and the relevant prior art cited (§ III.7.2).
Art.35(2) PCT, R70.12 & R66(2)(iii) PCT: other support of the application (e.g. relating to clarity and/or support of the claims) may also be mentioned in the IPEA (§ III.10.7.3).

Basis of IPEA (§ III.9)

R66.1(a-d) PCT: depending on whether amendments have been filed, the IPEA is based on the application as originally filed, or on amended documents filed under Art.19 PCT, or filed under Art.34 PCT (also as a reply to the WO-ISA). Amended documents on which the IPEA is based are annexed to the IPEA (see § II.9.1 - § II.9.3).

Documents considered (§ III.10.7.2 & II.15.1.1)

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 in time before drafting the IPEA).

Limited / partial IPEA (§ III.10.7.4-5, § III.13.2)

Art.35(3) PCT, Art.34(4) PCT, R66.1(e) PCT, R70.2(d) PCT, R70.12(ii) PCT: if the IPEA finds that the application:
- relates to subject matter which is not obliged to examine, or
- contains deficiencies such that no meaningful opinion can be formed, or
- relates to inventions which have not been searched, (for example as result of a non-unity objection raised in search or because the ISA considered that no meaningful search was possible), then no opinion will be issued for the part of the application concerned.

Time limit for preparation of the IPEA (§ III.10.7.1.1)

R69.2 PCT: the IPEA must be prepared by the IPEA by the later of the following dates:
- 28 months from the priority / filing date,
- 6 months from the date on which examination can start under R.69.1 PCT,
- 6 months after receipt of the translation under R55.2 PCT

Note: the 28 month TL normally applies.

IPER forwarded to applicant, IB & elected offices / Translation (§ III.10.7.14 & § III.7.12)

Art.36(1) PCT: the IPER is transmitted with its annexes to the applicant and to the IB.
Art.36(3)(a) the IPER & translation (if required) & annexes (in original language) are communicated by the IB to the elected offices (See § III.10.7.14).

R72.1(a) if the report is not in a language of a certain elected state, that state may require an English translation from the IB. (See § III.10.7.12).

Confidentiality of the file of the IPEA (§ III.14)

Art.38(1) PCT: neither the IB, nor the IPEA may allow access to the file of the IPEA, except with the consent of the applicant to:
- any person and
- any authority (except for the elected offices once the IPEA has been established).

Access via elected offices

R94.3 PCT: if the national law of any elected office (this includes treaties such as the EPC) allows access by third parties to the file of a national application, then that office may also allow access to the documents relating to the PCT application. This includes also the file of the IPEA.

Euro-PCT Guide 404: the EPO as elected office allows access to the IPEA file of published applications if the IPEA is completed. But, for applications filed before 01.02.2003 the applicant must also have completed ≥ 1 act for entry into the EP regional phase (OJ 2003, 382 and OJ 1999, 329).

Search report + WO-ISA prepared and transmitted to the applicant (§ II.5 & II.10)

Art.18(2) PCT & R44.1 PCT: as soon as they are prepared, the search report and the WO-ISA are transmitted to the applicant. This triggers one of the two time limits to file the demand for preliminary examination.

The TL for the ISA to prepare the search report is the later of:
- 3 months from the date of transmission of search report + WO-ISA, &
- 9 months from the priority date.

Usually the ISA prepares the search report within 16 months from the priority date.

When to file the demand for preliminary examination (§ III.3.3)

R54bis.1 PCT: the demand for preliminary examination must be filed within the later of:
- 3 months from the date of transmission of Search Report + WO-ISA, &
- 22 months from the filing / priority date.

Normally the 22 month TL applies. The other TL applies only if the search report is transmitted very late.

R54bis.1(b) PCT: any demand made after the prescribed date is considered not to have been made. The IPEA makes a declaration to this effect.

16 months from priority / filing date

19 months from priority / filing date

22 months from priority / filing date

is the demand filed?

No

Yes

is the IPEA the same office as the ISA?

No

Yes

Who can file the demand for Preliminary Examination (§ III.1)

Art.31(2)(a)PCT: the demand for preliminary examination can be filed by any applicant who is:
- 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.

Note: since all PCT states are currently bound to chapter II PCT, any applicant who is a national resident of a PCT state can file a demand for preliminary examination.

R54.2 PCT: if there are two or more applicants, at least one of them must be resident / national of a PCT state bound by chapter II PCT.

R54.4 PCT: if no applicant has the right to file it, the demand is deemed not received.

Where to file the demand / Which IPEA is competent (§ II.2, III.3.1)

Art.31(6)(a) PCT: the demand must be filed at the competent IPEA (§ II.3.1).

Art.32(2) PCT: the RO specifies which IPEA/s is/are competent for International Applications filed at that RO (§ II.2).
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 would have been competent, had the application been filed at the receiving office of:
- the state of residence of the applicant,
- the state of nationality of the applicant,
- other offices (resulting from agreements allowing filing at other offices, e.g. EPO).

R59.1(a-b) & R.35.2(a) PCT: where more than one IPEA is competent the applicant may have a choice among different IPEA's (§ 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 applied by EPO as IPEA see § III.2.3), and/or on the language of the application (e.g. JPTO).

This means that the applicant must check which IPEA/s is/are competent and whether he has a choice. This depends on the RO where the application was filed. See § III.2.1-2.4: for the cases where the EPO is the competent IPEA.

Form & content of the demand: (See § III.3.5 for details)

Language of the demand (§ III.3.4)

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).

Language of the application for preliminary examination (§ II.6)

To be examined, the different parts of the International application must be in a language accepted by the IPEA. If the application 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 a 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. Amendments to the application have to be filed in the same language as that of the application itself. 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.

Reply to the WO-ISA (§ II.10.10)

R43bis.1(c) PCT: if the applicant files the demand and the WO-ISA is considered the 1st written opinion by 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 1st WO-ISA was transmitted to the applicant, and
- 22 months from the priority date.

Note: The applicant has to reply in time, if he wants to be sure that his reply will be considered by the IPEA before the IPEA is established.

Filing amendments under Art.34 (§ III.9 & III.9.3)

Art.34(2)(b) PCT: the applicant may file amendments to the description, claims, drawings of the application before the establishment of the IPEA, (i.e. during the entire examination procedure). The amendments may not extend beyond the content of the application as originally filed.

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.

R66.1(b) PCT: amendments under Art.34 PCT can be filed together with the demand or later, until the IPEA is established.

R66.4bis PCT: amendments or arguments filed after the IPEA has started to draw up a written opinion or the IPER, may be disregarded by the IPEA for the preparation of that written opinion or the IPER.

Prescribed fees (§ III.7)

Art.31(5) PCT: the demand is subject to the payment of the prescribed fees within the prescribed time limit.

Handling fee (§ III.7.1)

R57.1 PCT: the demand is subject to the payment of the handling fee. This must be paid at the IPEA where the demand is submitted (See § III.7.1.2 for refunds of this fee).

Preliminary examination fee (§ III.7.2)

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).

Time Limit for payment (§ III.7.1.1 & III.7.2)

R57.3(a) PCT & R58.1(b) PCT: handling fee & preliminary examination fees must be paid by the later of:
- 1 month from the date of filing of the demand,
- 22 months from the priority / filing date.

Late payment (§ III.7.3)

R58bis.1(a): if the handling & the examination fees are not paid in time, the IPEA invites the applicant to pay 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 this case no surcharge is due).

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

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.

Substantive issues in preliminary examination (§ III.8.1)

Art.33(1) PCT: the objective of the preliminary examination is to give a preliminary non-binding opinion on whether the claimed invention:

- is novel,
- involves an inventive step,
- is industrially applicable.

Art.33(2) PCT: the invention is novel if it is not anticipated by the state of the art, as defined in the regulations.
Art.33(3) PCT: the invention involves an inventive step if it is not obvious to a person skilled in the art at the relevant date.

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.

Relevant date for assessing the prior art (§ III.8.2)

R64.1(b) & R65.2 PCT: the relevant date used to determine the prior art to assess novelty and inventive step is:

- the international filing date, or
- the priority date, if the application validly claims priority.

The prior art (§ III.8.2)

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, 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 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 in time before drafting the IPEA - § III.10.7.2 & II.15.11).

Non-unity in Preliminary examination (§ III.12.1-4)

Art.34(3)(a) PCT: if the IPEA considers that the application lacks unity as set in the regulations, then it may invite the applicant to do the following within the prescribed TL:

- restrict the claims to make them unitary, or
- pay additional examination fees.

R68.1 PCT: the IPEA has the discretion not to issue the above invitation. However, also in this case it 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 requirements of unity; give the reasons of the findings & indicate the TL to reply (§ III.12.2.3).

R68.3(a) PCT: the IPEA sets the amount of the additional fee to be paid. R158(2) EPC: the EPO chooses one whole preliminary examination fee for each additional invention.

R68.3(b) PCT: the additional fee is to be paid to the IPEA.

Art.34(3)(a) PCT & R68.2 PCT: the applicant must respond to the invitation under Art.34(3)(a) PCT within 1 month from the invitation (§ III.12.2.2).

S&E-GL 10.77: if the applicant pays additional examination fees, the IPEA examines the inventions in respect of which additional fees were paid. If the claimed matter is restricted and rendered unitary, the applicant may request that the unitary invention be examined.

Art.34(3)(c) PCT & R68.5 PCT: if no additional fee is paid, the IPEA is established on the "main invention" only. In cases of doubt the main invention is that first mentioned in the claims (§ III.12.2.1).

R68.3(c) PCT: the applicant may pay the additional examination fees under protest, with a "reasoned statement" that the application is fully unitary or that the additional fees are excessive.

R68.3(e) PCT: the TL for filing the protest is the same as for the payment of the additional fees.

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 (Reiss 2.1) 21 EPC).

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

Application not examined (§ III.10.7.4 & III.13.1 & III.13.2)

Limitation due to certain subject matter (§ III.7.4 & § III.13.1)

Art.34(4)(a)(i) PCT, Art.35(3)(a-b) PCT & R70.12(ii) PCT: if the IPEA finds that the application (all, or some claims only) relates to subject matter which it is not obliged to examine, then the application (or the claims concerned), is not subject to examination. The IPEA states this fact.

Art.34(4)(a)(i) PCT & R67.1 PCT: subject matter which the IPEA is not required to examine relates to scientific/mathematical theories, plant varieties, methods of treatment/diagnosis, computer programs, etc. (§ III.10.7.4 & R67 PCT).

Limitation due to serious deficiencies (§ III.13.2 & III.10.7.4)

Art.34(4)(a)(ii) PCT, Art.35(3)(a-b) PCT & R70.12(iii) PCT: if the IPEA finds that the application (all, or some claims only) contains deficiencies such that no meaningful opinion can be formed, then the application (or the claims concerned), is not subject to examination. The IPEA states this fact.

Unsearched subject matter is not examined (§ III.10.7.4)

R66.1(e) PCT & R70.2(d) PCT: the IPEA is not obliged to examine inventions which have not been searched. If this is the case, then no opinion will be issued for the part of the application concerned. The IPEA states this.

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 IPEA.

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

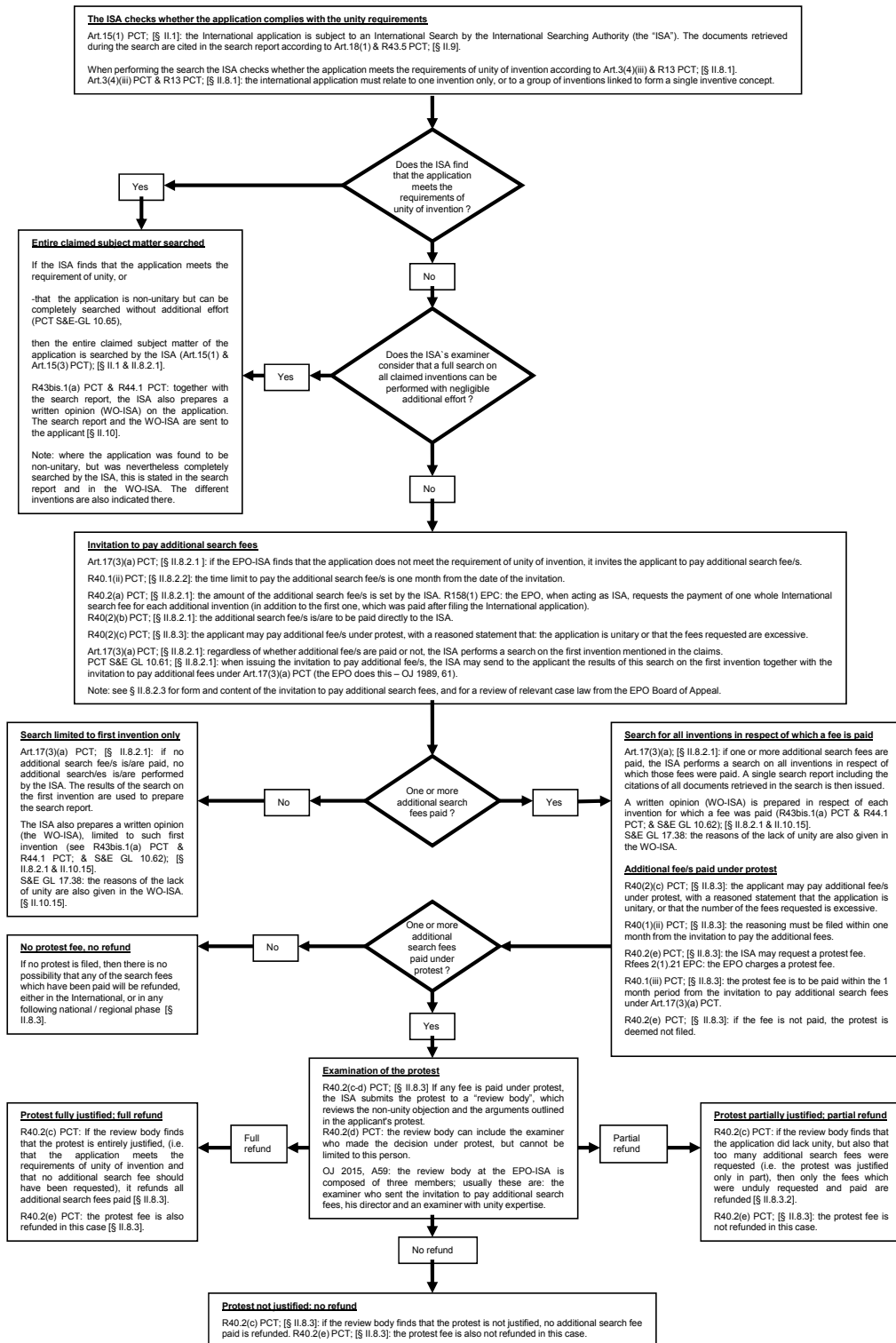
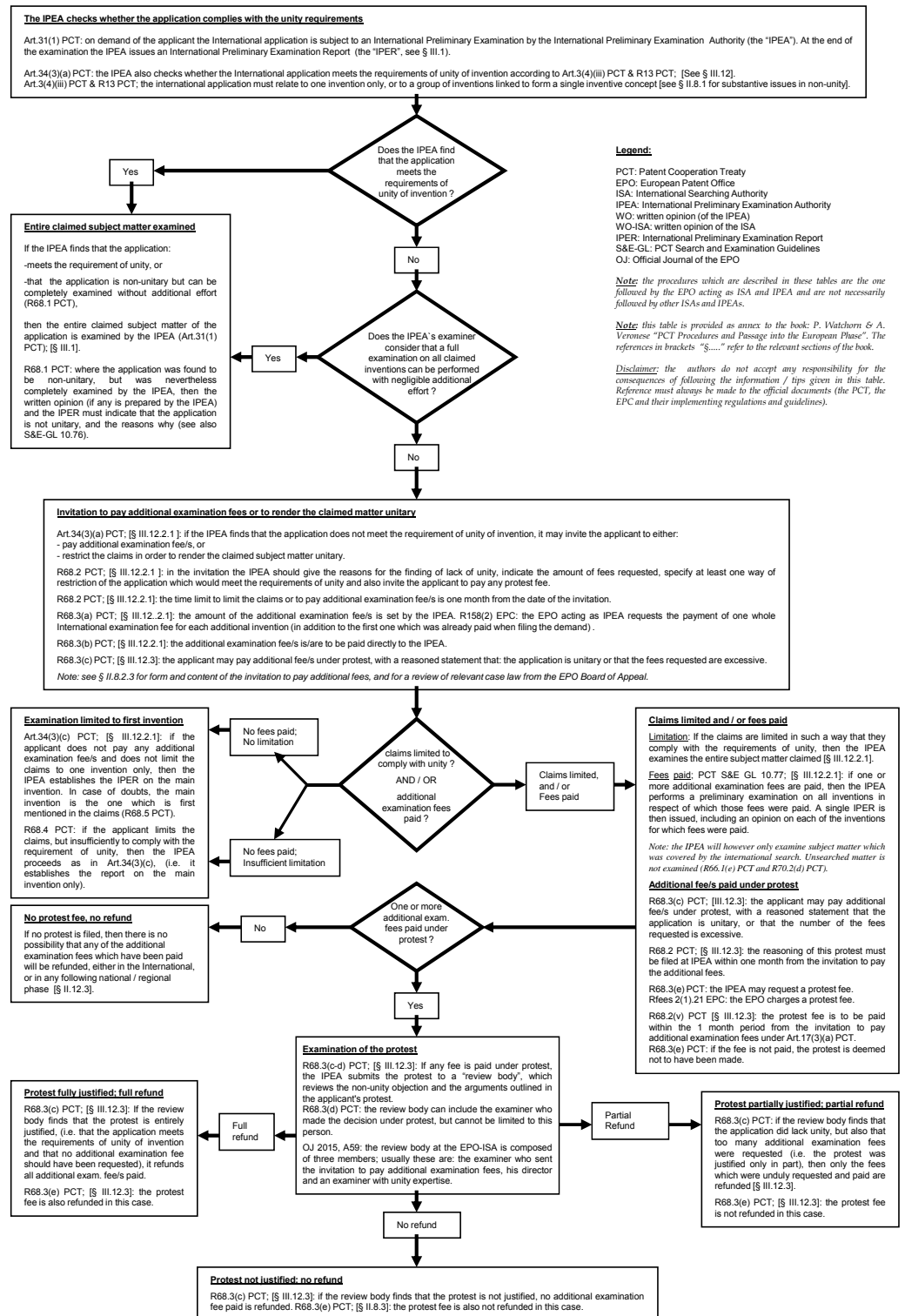


Table 5b: Procedure before the EPO acting as IPEA in case of non-unity



Legend:

PCT: Patent Cooperation Treaty
EPO: European Patent Office
ISA: International Searching Authority
IPEA: International Preliminary Examination Authority
WO: written opinion (of the IPEA)
WO-ISA: written opinion of the ISA
IPER: International Preliminary Examination Report
S&E-GL: PCT Search and Examination Guidelines
OJ: Official Journal of the EPO

Note: the procedures which are described in these tables are the one followed by the EPO acting as ISA and IPEA and are not necessarily followed by other ISAs and IPEAs.

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 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).

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

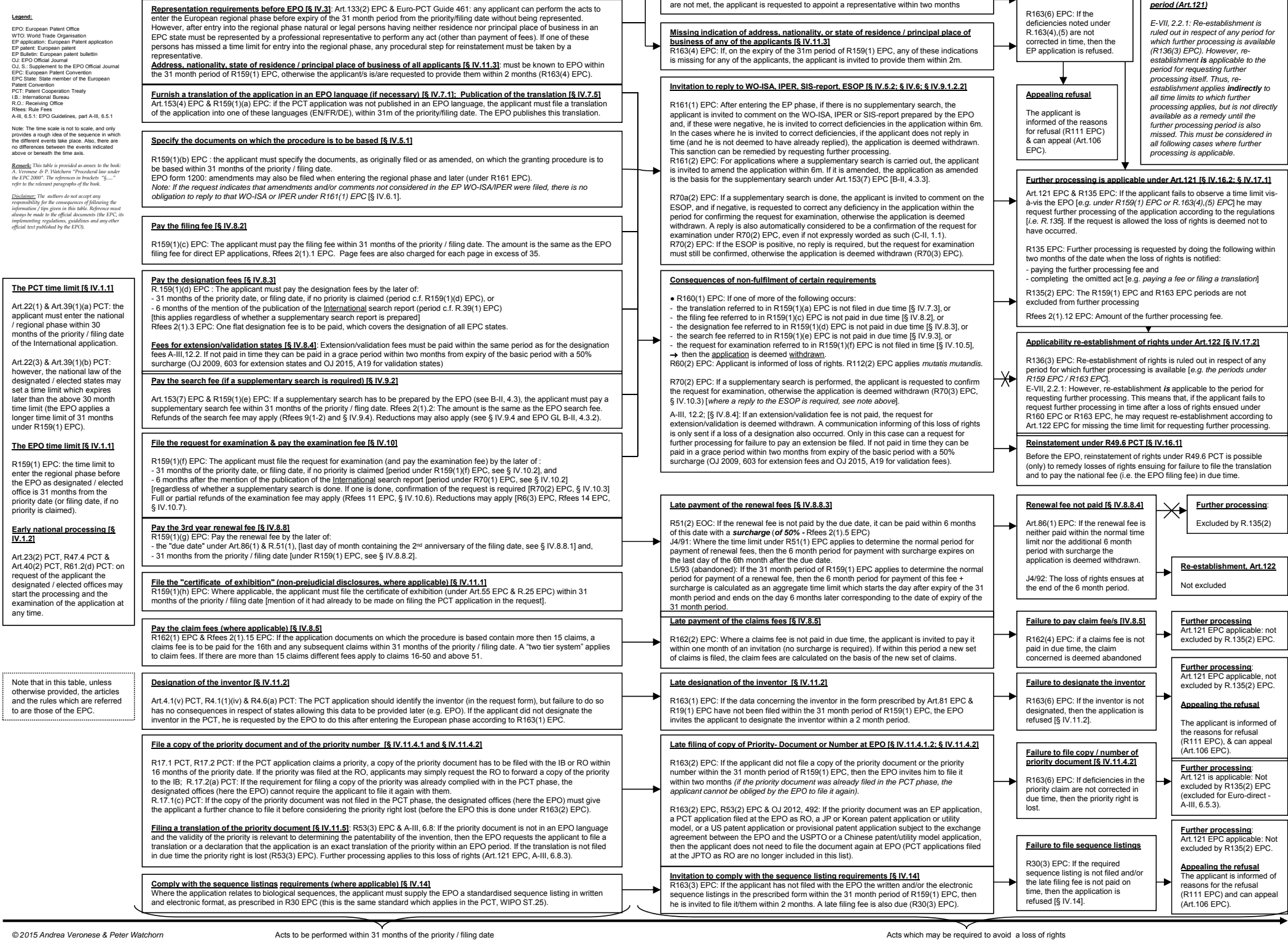


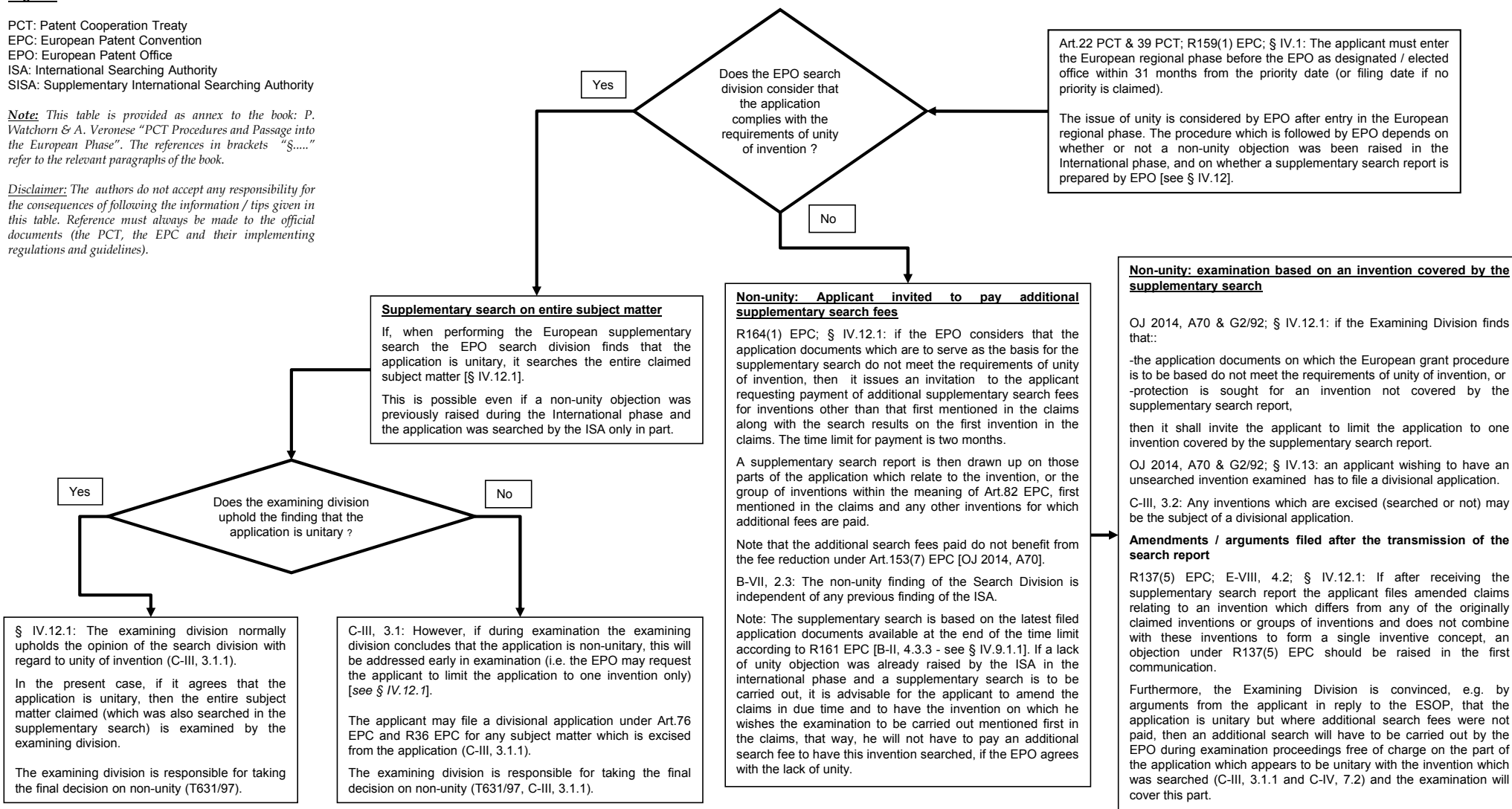
Table 7a: Lack of unity passing into the regional phase before EPO – supplementary search performed – IV.12.1

Legend:

PCT: Patent Cooperation Treaty
EPC: European Patent Convention
EPO: European Patent Office
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 “§.....” refer to the relevant paragraphs of the book.

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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 subject-matter 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:

PCT: Patent Cooperation Treaty
EPC: European Patent Convention
EPO: European Patent Office
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 "§....." 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).

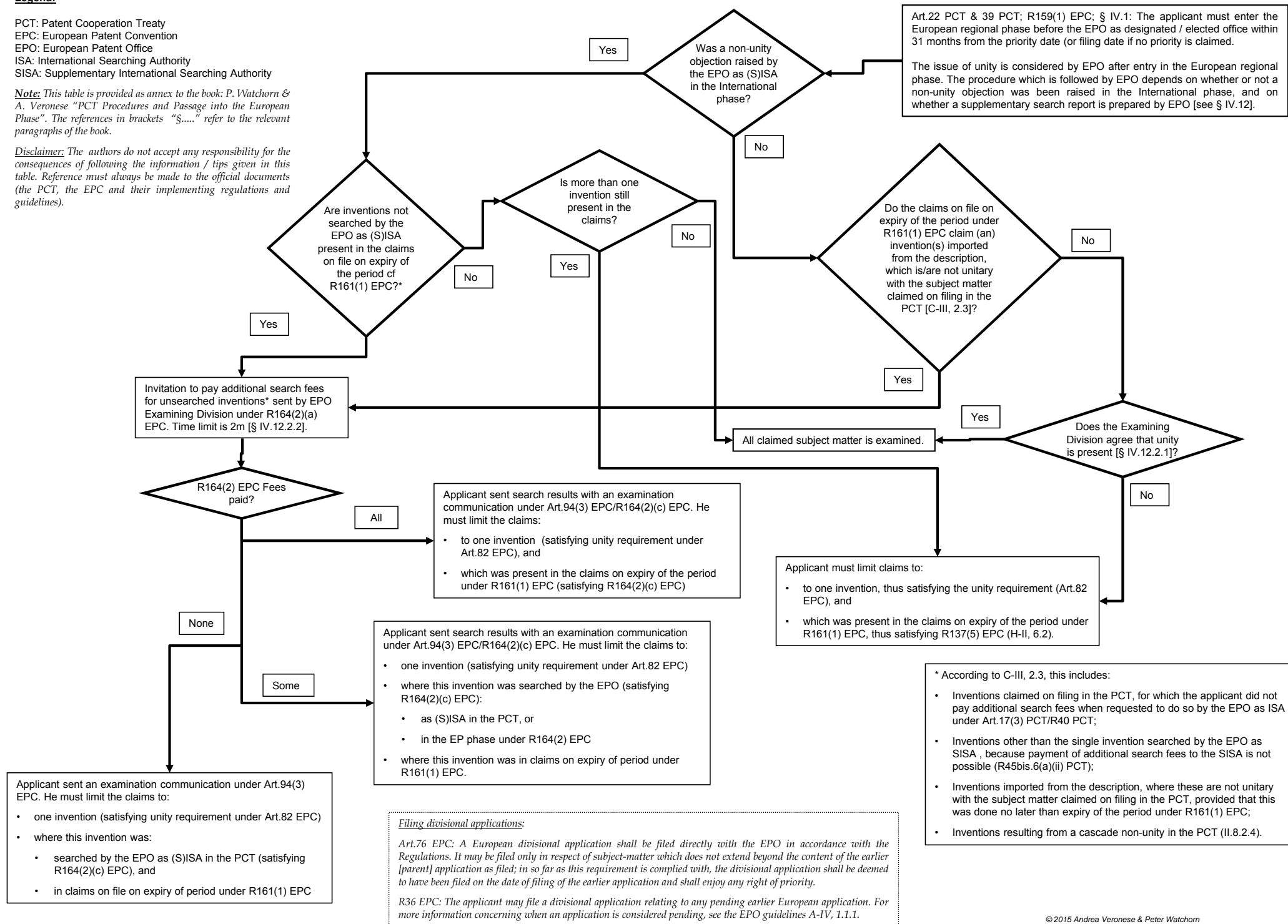


Table 8: Calculation of time limits under the PCT:

Preliminary remarks

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 filing date, or the notification of a document requesting the applicant to perform a procedural act within a certain period.

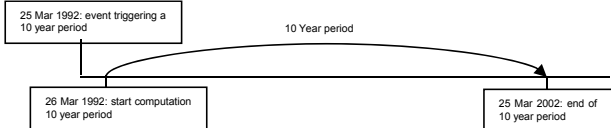
Under the PCT, the time limits which are triggered by the delivery of a document from a national office or an International organization, start to run the day after the date borne by that document or letter, unless the person concerned proves that the document / letter was posted at later date, or that it was delivered more than seven days later than the date which it bears. In these last cases extensions of the time limits are applicable under R80.6 PCT.

In this regard the PCT differs from the EPC, which deems all communications posted by EPO as delivered 10 days after the date of posting, unless the document is received later than these 10 days, in which case the real date of delivery is the one which counts.

Time limits calculated in years (R.80.1 PCT); [§ V.1.1]

Start: the day after the relevant event occurred.

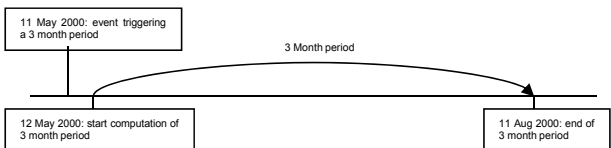
Expire: on the relevant subsequent year, on the same day as the relevant event, provided that if the date of the following year does not exist (i.e. 29 February), then the time limit expires the last day of the month (i.e. 28 February).



Time limits calculated in months (R.80.2 PCT); [§ V.1.1]

Start: the day after the relevant event occurred.

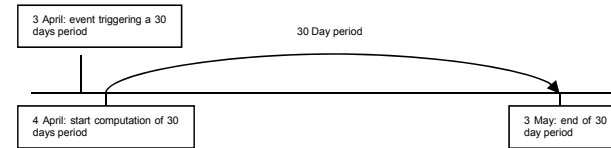
Expire: on the relevant subsequent month, on the same day as the relevant event, provided that if that month has no day with that number (e.g. 31 April), then the time limit expires the last day of the month (i.e. 30 April).



Time limits calculated in days (R.80.3PCT); [§ V.1.1]

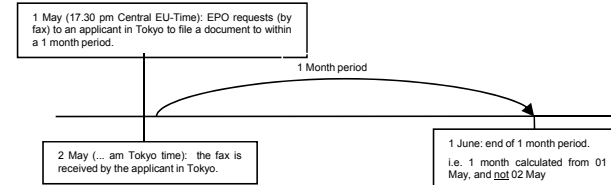
Start: the day after the relevant event occurred.

Expire: on the day on which the last day of the count has been reached.



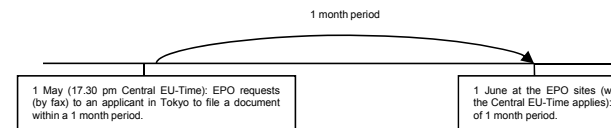
Local dates for starting time limits (R.80.4(a) PCT); [§ V.1.1]

R.80.4(a): the date for computing the Start of the time limit is the date in the place where the relevant date occurred.



Local dates for expiry time limits (R.80.4(b) PCT); [§ V.1.1]

R.80.4(b) PCT: the date for computing the Expire of the time limit is the date where the document must be filed or the fee must be paid.

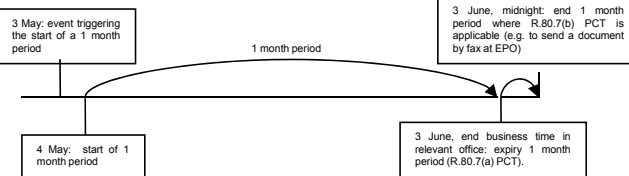


Note: these are not real examples, because notifications triggering a TL may not be sent by fax (R.92.3 PCT, see § IV.1.3.2)

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 filing of documents by fax up to midnight of the relevant day.



Fax filed at EPO at midnight at EPO (OJ S. 3/07, A.3); [§ V.1.2]

If an International application is filed at EPO by fax at midnight, and
-the fax transmission starts before midnight and, and continues after midnight, and
-the document received before midnight satisfies the requirement for obtaining a filing date,

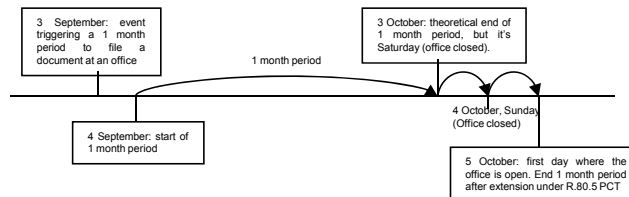
-then the applicant may request the EPO to accord a filing date to the part of the document received before midnight, provided that he renounces to the part received later.

Extension of time limits (R.80.5PCT); [§ V.1.3.1]

R.80.5 PCT: Where a time limit for paying a fee or filing a document expires on :

- 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,
- 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.

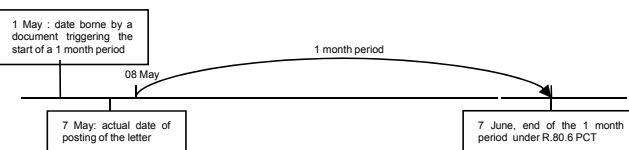


Notifications & time limits: late posting / late delivery of documents at the applicant (R80.6 PCT) [§ V.1.3.2]

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

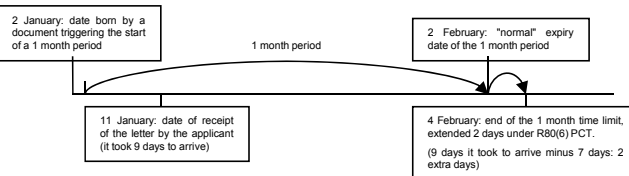
Late posting

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 organization,
-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.



Late arrival

R80.6 PCT: If the applicant can show that a letter or a document arrived more than seven days after the date it bears (regardless when it was posted), then the date of expiry of any time limit starting from the date of that letter or document is shifted forwards by the same number of days the letter took to arrive minus seven.



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 than 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:

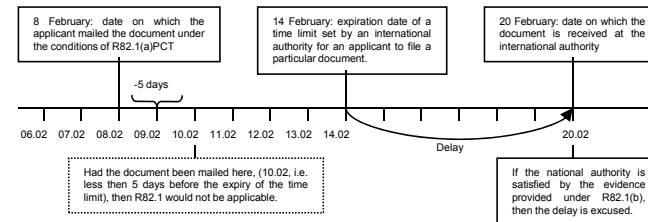
- evidence of the date of mailing,
- the substitute document (in case of loss),
- proof that the substitute document or letter is identical to the original (in case of loss).

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 than 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 than postal authorities. When an office has informed that it accepts the application of R82.1(a) PCT to such delivery services, then it is obliged to do so.



Note: the same example is applicable also to the cases where the document is lost and is not received at all by the International authority

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/ISA/PEA 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 question].

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:

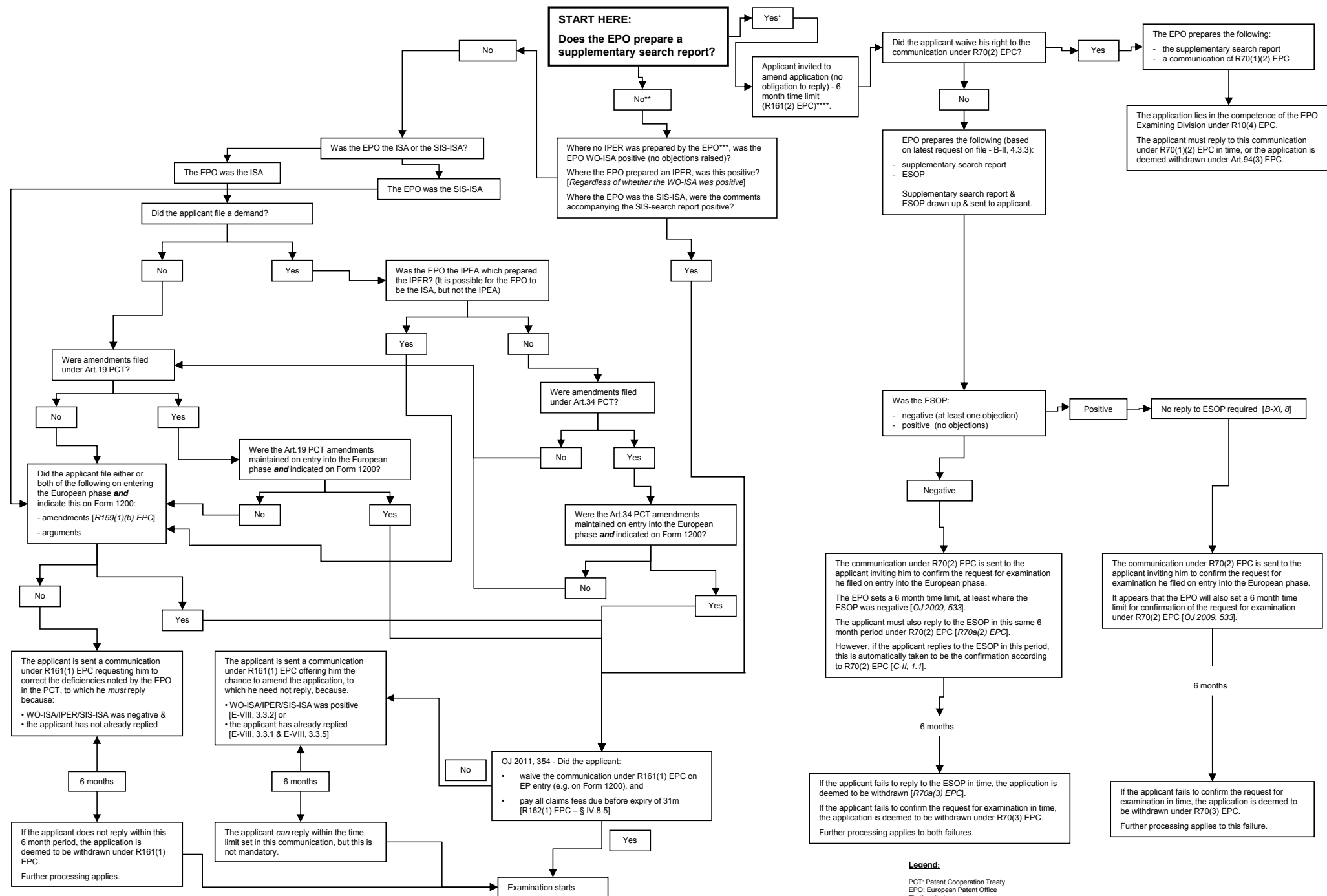
PCT: Patent Cooperation Treaty
EPO: European Patent Office
TL: time limit

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 "§...." 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).

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]



* This includes the case where the EPO prepared the IPER, but the ISA was not the EPO, but rather the office of an EPO state viz: Sweden, Spain, Austria, Finland, the Nordic Patent Institute [the EPO will act as IPEA for such applications - OJ 2010, 304, but will still prepare a supplementary search report for them in the European phase – B-II, 4.3.2].

** This applies where the EPO performed the international search as ISA (B-II, 4.3.1), or where it performed the SIS-search as SIS-ISA [B-II, 4.3.1 & OJ 2009, 594].

*** This includes the case, where the EPO was the ISA (and so prepared a WO-ISA) and there is preliminary examination, but the EPO was not the IPEA.

**** OJ 2011, 354 - The applicant can waive this communication under R161(2) EPC, if he requests this on EP entry (e.g. on Form 1200) and pays any claims fees due before the expiry of the 31m period (R162(1) EPC). If this has been done, this step is simply missed out.

Legend:

PCT: Patent Cooperation Treaty
 EPO: European Patent Office
 TL: time limit

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 "§....." 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).