

# **"Euro-PCT Guide": PCT procedure at the EPO**

**International phase and entry into the  
European phase**

**Guide for applicants**

12th edition  
Updated to 1 January 2019



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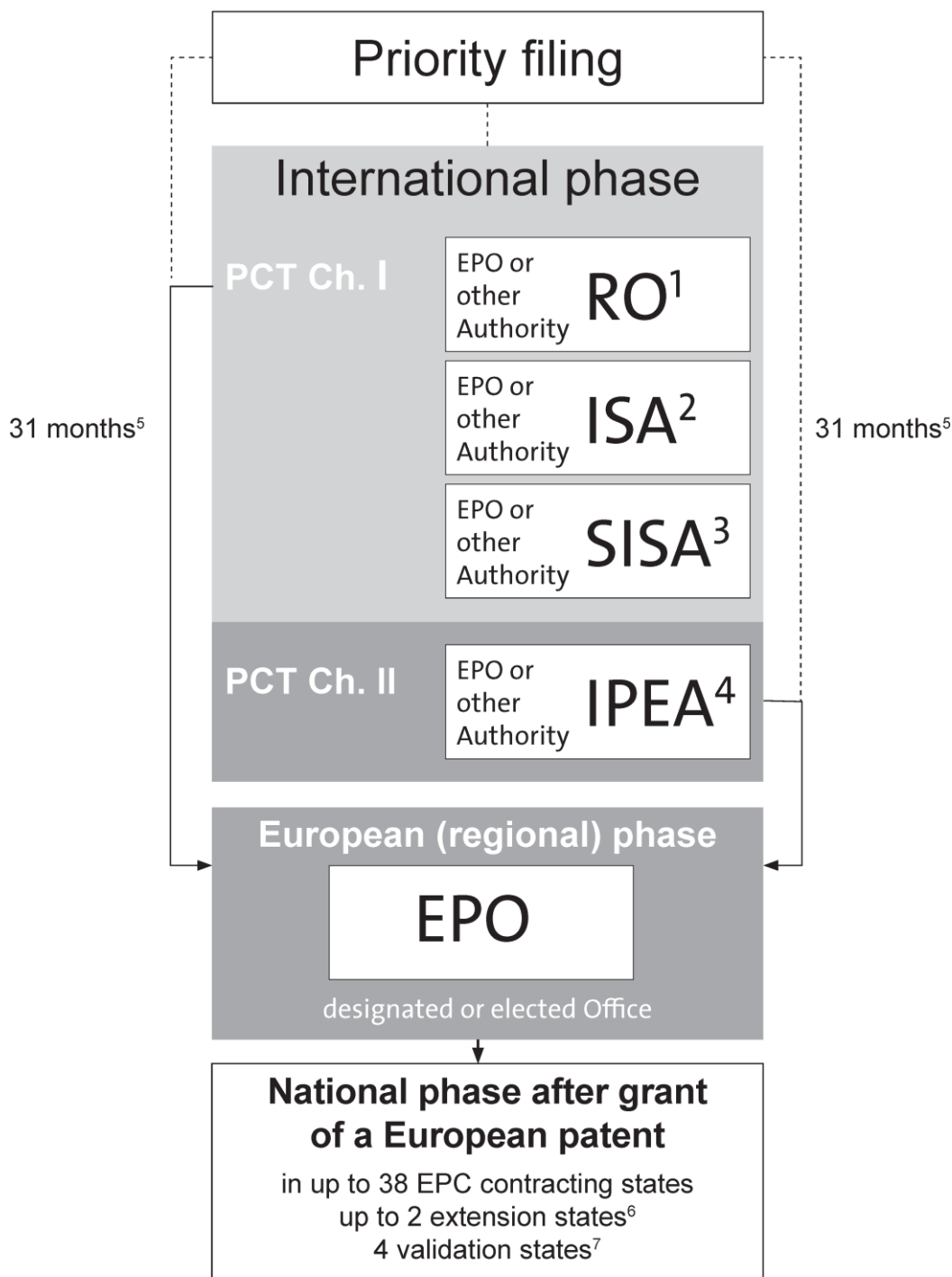
## A. Terms and abbreviations

ADD	Automatic debiting procedure
AI	Administrative Instructions under the PCT
Art.	Article(s) (of the EPC or the PCT)
CET	Central European Time
CMS	EPO new online filing – case management system
CNIPA	National Intellectual Property Administration, PRC
DAS	Digital Access Service
EPC	European Patent Convention
EPO	European Patent Office
GL/EPO	Guidelines for Examination in the European Patent Office (quoted as follows: GL/EPO C-III, 8.4 = Guidelines, Part C, Chapter III, section 8, point 4)
GL/ISPE	PCT International Search and Preliminary Examination Guidelines
GL/PCT-EPO	Guidelines for Search and Examination at the European Patent Office as PCT Authority (quoted as follows: GL/PCT-EPO C-III, 8.4 = Guidelines, Part C, Chapter III, section 8, point 4)
GL/RO	PCT Receiving Office Guidelines
IB	International Bureau of WIPO
IPEA	International Preliminary Examining Authority
IPER	International Preliminary Examination Report
IPRP	International Preliminary Report on Patentability
ISA	International Searching Authority
ISPE Guidelines	PCT International Search and Preliminary Examination Guidelines
ISR	International Search Report
JPO	Japan Patent Office
KIPO	Korean Intellectual Property Office
NPI	Nordic Patent Institute
OEPM	Spanish Patent and Trademark Office
OJ	Official Journal of the European Patent Office (quoted as follows until December 2013: OJ 2001, 459 = Official Journal, year 2001, page 459; and as of January 2014 as: OJ 2015, A51 = Official Journal, year 2015, article 51)
OJ 2007, Spec.Ed.1	Special Edition No. 1 to EPO Official Journal 2007
OFF	Office of first filing
OSF	Office of second filing

PACE	Programme for accelerated prosecution of European patent applications
PCT	Patent Cooperation Treaty
PPH	Patent Prosecution Highway
R.	Rule(s) of the Implementing Regulations (to the EPC or the PCT)
RFees	EPC Rules relating to Fees
RO	Receiving Office
SIS	Supplementary International Search
SISA	Supplementary International Searching Authority
SISR	SIS report
SMEs	Small and medium-sized enterprises
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization
WIPO PCT Guide	"PCT Applicant's Guide" published by the International Bureau of WIPO
WO-ISA	Written Opinion of the International Searching Authority

## B. The international and European phases of a PCT application

### The Euro-PCT-Phases



1 RO = Receiving Office

2 ISA = International Search Authority  
(to be specified by the RO and, where applicable, chosen by the applicant)

3 SISA = Supplementary International Searching Authority

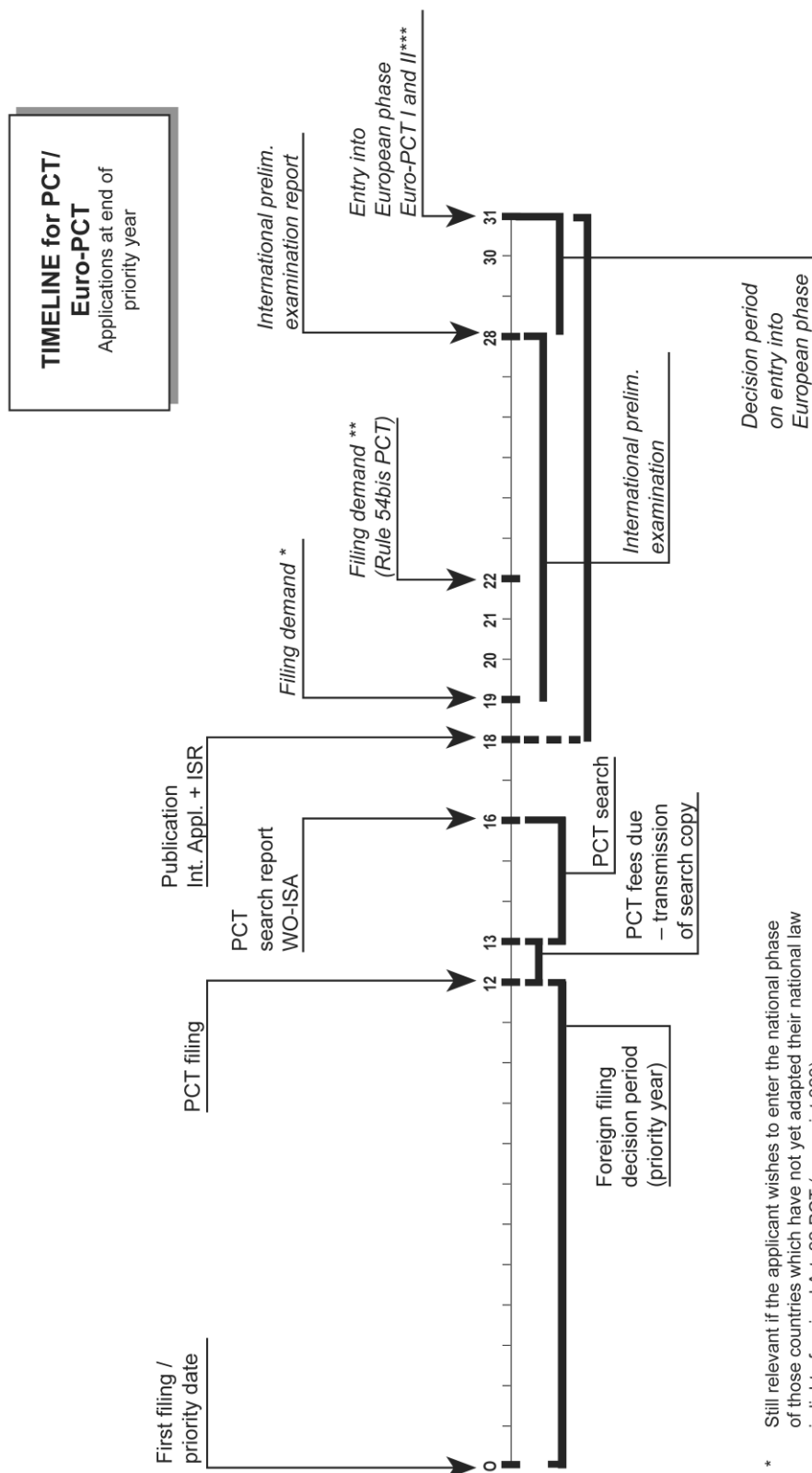
4 IPEA = International Preliminary Examining Authority  
(as for ISA; EPO only when ISA = EPO or XN or XV or AT, ES, FI, SE, TR patent office)

5 As from date of filing or earliest date of priority. The 31 month time limit applies for entry into the European phase (before the EPO as designated Office (Ch. I) and elected Office (Ch. II)).

6 Based on bilateral agreements with the EPO. Currently 2 extension states.

7 Republic of Moldova, Morocco, Tunisia and Cambodia.

## C. Timeline for international applications



\* Still relevant if the applicant wishes to enter the national phase of those countries which have not yet adapted their national law in light of revised Art. 22 PCT (see point 323).

\*\* If the applicant wishes to enter the national phase of countries that apply the 30/31 month time limit under Article 22 PCT, the demand must be filed prior to the expiration of whichever of the following periods expires later (see point 317):

- three months from the date of transmittal to the applicant of the ISR and WO-ISA by the ISA, or
- 22 months from the (earliest) priority date

\*\*\* As from 01.04.2002, the general deadline for entry into the European phase is 31 months – both according to Chapter I and Chapter II (see points 324, 415).

# Chapter 1 – General overview

## 1.1 What is the Euro-PCT Guide?

**1.1.001** This publication is a guide for applicants interested in pursuing the procedure under the PCT. It focuses on the elements specific to the PCT procedure before the EPO.

**1.1.002** This is the twelfth edition of the publication, which is further referred to as the "Euro-PCT Guide".

**1.1.003** The Euro-PCT Guide gives an overview of the procedures under the PCT before the EPO, including entry into the European phase before the EPO as designated/elected Office. The information it provides is not to be considered complete, nor is it intended to replace relevant WIPO publications and EPO decisions and notices concerning specific issues.

**1.1.004** The Euro-PCT Guide is **based on the information available on 1 January 2019**. Any changes to the PCT procedures before the EPO after that date are not reflected in the information provided here. Therefore, in using this Guide, applicants should always verify in particular whether any relevant changes to the procedures have entered into force since 1 January 2019. Information on any changes made after that date can be found in the sources of information mentioned below (see points 1.3.001 ff).

**1.1.005** Although the information in this Guide is not exhaustive, it aims to cover all the important aspects of the procedures when the EPO acts in its capacity as:

- receiving Office (RO),
- International Searching Authority (ISA),
- Supplementary International Searching Authority (SISA),
- International Preliminary Examining Authority (IPEA), and/or
- designated or elected Office.

**1.1.006** Any comments on the Euro-PCT Guide may be addressed to Department 5.2.2.1, PCT Affairs (preferably by email to: *international\_pct\_affairs@epo.org*).

## 1.2 What is the applicable law?

**1.2.001** In all PCT procedures before the EPO, the PCT is applied in accordance with the provisions of Part X of the EPC, "International applications under the Patent Cooperation Treaty - Euro-PCT applications", the Implementing Regulations to the EPC ("EPC Rules") and the relevant further legislation.

*Art. 150(1) EPC*

- 1.2.002** The European Patent Convention of 1973 ("EPC 1973") was comprehensively revised in November 2000 ("EPC 2000"). The revised text of the EPC entered into force on 13 December 2007. Since that date some of the Implementing Regulations to EPC 2000 have been further revised. The most up-to-date version of EPC 2000 is provided on the EPO website.<sup>1</sup> Any reference in this Guide to the articles of the EPC and the rules of the Implementing Regulations relates to EPC 2000.
- 1.2.003** The legal basis for all EPO activities under the PCT is Part X of the EPC (Articles 150-153) as implemented by the provisions of the Implementing Regulations to the EPC, in particular Rules 157-165, and by further legislation such as decisions of the President and the Administrative Council of the EPO.

### **1.3 Euro-PCT Guide and other sources of information**

- 1.3.001** It is explicitly pointed out that the Euro-PCT Guide is intended to be complementary to, but not a substitute for, the **PCT Applicant's Guide** ("WIPO PCT Guide").
- 1.3.002** The WIPO PCT Guide is published in English and French by the **International Bureau of WIPO** ("IB") in electronic form only.<sup>2</sup> A German translation is published in paper form by Carl Heymanns Verlag.
- 1.3.003** Regularly updated general information on the EPO and specific information on the procedures before the EPO as receiving Office, International Authority (ISA, SISA and IPEA) and designated/elected Office under the PCT is provided in the Annexes to the WIPO PCT Guide.<sup>3</sup>
- 1.3.004** Relevant information is also provided on the EPO website<sup>4</sup> and in the **EPO's Official Journal** ("OJ"), which is published in electronic form only.<sup>5</sup> Applicants are strongly advised to consult these publications and to take note of, in particular, any information published after 1 January 2019.
- 1.3.005** Up-to-date news about the PCT is available on the **WIPO website** and also from the **PCT Newsletter** and the **Official Notices (PCT Gazette)**, both published in electronic form by WIPO.<sup>6</sup> Applicants desiring further information about the PCT procedure in the international phase are advised to consult the Administrative Instructions under the PCT ("AI"),<sup>7</sup> the PCT Receiving Office

OJ 2013, 606

<sup>1</sup> [www.epo.org/law-practice/legal-texts/epc.html](http://www.epo.org/law-practice/legal-texts/epc.html)

<sup>2</sup> [www.wipo.int/pct/en/appguide/index.jsp](http://www.wipo.int/pct/en/appguide/index.jsp)

<sup>3</sup> [www.wipo.int/pct/en/appguide/index.jsp](http://www.wipo.int/pct/en/appguide/index.jsp)

<sup>4</sup> [www.epo.org](http://www.epo.org)

<sup>5</sup> [www.epo.org/law-practice/legal-texts/official-journal.html](http://www.epo.org/law-practice/legal-texts/official-journal.html)

<sup>6</sup> PCT Newsletter: [www.wipo.int/pct/en/newslett/](http://www.wipo.int/pct/en/newslett/)  
Official Notices (PCT Gazette): [www.wipo.int/pct/en/official\\_notices/index.html](http://www.wipo.int/pct/en/official_notices/index.html)

<sup>7</sup> AI: [www.wipo.int/pct/en/texts/index.html](http://www.wipo.int/pct/en/texts/index.html)



Guidelines ("GL/RO") and the PCT International Search and Preliminary Examination Guidelines ("ISPE Guidelines", "GL/ISPE"),<sup>8</sup> all available on the WIPO website.

- 1.3.006** Since 1 November 2015, applicants have also been able to consult the **Guidelines for Search and Examination at the European Patent Office as PCT Authority** ("PCT-EPO Guidelines", "GL/PCT-EPO"), available on the EPO website.<sup>9</sup> Furthermore, any reference to "GL/EPO" in this Guide relates to the **Guidelines for Examination in the European Patent Office as revised in 2018**.<sup>10</sup>
- OJ 2015, A73*  
*OJ 2018, A74*

## **1.4 What is the relationship between the PCT and the EPC?**

- 1.4.001** For international applications which are the subject of proceedings before the EPO in any of its functions (see point 1.1.005), the provisions of the PCT and its Regulations ("the PCT Rules") apply, **supplemented** by the provisions of the EPC.
- Art. 150(2) EPC*
- 1.4.002** In case of conflict between the provisions of the EPC and those of the PCT or the PCT Rules, the **PCT prevails**.
- 1.4.003** As from the entry into force of EPC 2000 on 13 December 2007 the EPO has withdrawn all notifications of incompatibility with PCT provisions.<sup>11</sup>
- OJ 2007, 692*
- 1.4.004** In accordance with the principle of the prevalence of the PCT, applicants should refer to the PCT International Search and Preliminary Examination Guidelines ("GL/ISPE", "ISPE Guidelines") for information on search and examination practice and procedure before the EPO as ISA, SISA and IPEA. In addition, they may also refer to the PCT-EPO Guidelines. In these procedures the Guidelines for Examination in the European Patent Office (GL/EPO) apply only to the extent that they can be applied in conformity with the supplementary role of the EPC in the international phase (see point 1.4.001).
- OJ 2015, A73*
- 1.4.005** In a number of cases the ISPE Guidelines leave a choice between alternative options, from which each ISA/IPEA may select the most appropriate. The options are set out in appendices to the chapters of the ISPE Guidelines. The EPO will choose the option most in line with its own practice under the EPC. A list of policy options chosen by the EPO is provided in the Annex to this Guide (see point 3.2.003).

<sup>8</sup> GL/ISPE and GL/RO: [www.wipo.int/pct/en/texts/gdlines.html](http://www.wipo.int/pct/en/texts/gdlines.html)

<sup>9</sup> [www.epo.org/law-practice/legal-texts/html/guidelinespct/e/index.htm](http://www.epo.org/law-practice/legal-texts/html/guidelinespct/e/index.htm)

<sup>10</sup> [www.epo.org/law-practice/legal-texts/guidelines.html](http://www.epo.org/law-practice/legal-texts/guidelines.html)

<sup>11</sup> [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

- 1.4.006** Moreover, in an agreement between the EPO and the International Bureau of WIPO ("Agreement EPO-WIPO") concerning the functioning of the EPO as International Authority (ISA, SISA and IPEA) all particulars of the work of the EPO in that capacity are set out. The latest agreement of October 2017 entered into force on 1 January 2018.
- OJ 2017, A28, A115  
Official Notices (PCT Gazette) – 16 March 2017*

## **1.5 What is the role of the EPO in the international phase?**

- 1.5.001** For international applications under the PCT, the EPO may act as:
- receiving Office ("**RO**") (see points 2.1.001 ff),
  - International Searching Authority ("**ISA**") (see points 3.1.001 ff),
  - Supplementary International Searching Authority ("**SISA**") (see points 3.4.001 ff), and
  - International Preliminary Examining Authority ("**IPEA**") (see points 4.1.001 ff).
- Art. 1-49 PCT  
Art. 150-153 EPC*

## **1.6 What is a Euro-PCT application?**

- 1.6.001** An international application for which the EPO is a designated Office (see point 1.7.004) and which has been accorded an international filing date has - as from that date - the effect of a regular European application (Euro-direct application). Such an international application, being equivalent to a regular European patent application, is referred to as a "Euro-PCT application".
- 1.6.002** Each international application for which the EPO is designated Office is (also) given a **European application number**. This number is notified to the applicant in a communication informing the applicant of the requirements for entry into the European phase (EPO Form 1201), which, as a rule, is issued ten months after international publication of the application.
- 1.6.003** During the international phase of the processing of an international application no designated or elected Office is allowed to process or to examine that application. This means that a Euro-PCT application will not be processed by the EPO acting as designated or elected Office until it enters the European phase (see point 1.7.002). However, this prohibition may be lifted at the explicit request of the applicant (see points 5.1.023 ff).
- Art. 11(3), 45(1) PCT  
Art. 153(2) EPC*
- Art. 23, 40 PCT  
WIPO PCT Guide 3.005, 5.005*

## 1.7 What is the role of the EPO in the European phase?

- 1.7.001** Once an international application has entered the national phase before the EPO, the international application is said to be in the **European phase**. *Art. 22(1), (3), 39(1), (2) PCT  
R. 159(1) EPC  
WIPO PCT Guide 5.005*
- 1.7.002** The time limit for entering the **European** phase is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (see point 5.2.001).
- 1.7.003** An up-to-date overview of the applicable time limit for entry into the national phase in each PCT contracting state - including the EPC contracting states where the national route is preferred - is available on the WIPO website.<sup>12</sup>
- 1.7.004** If an international application enters the European phase (see points 5.2.001 ff), the EPO will act:
- as **designated Office** if the international application was only processed under PCT Chapter I proceedings (international search and publication of the application);
  - as **elected Office** if the international application at the request of the applicant was also processed under PCT Chapter II proceedings (international preliminary examination) (see points 4.1.001 ff and points 5.1.003 ff).

## 1.8 Contracting states to the PCT and the EPC

- 1.8.001** On 1 January 2019 the EPC was in force in a total of 38 states: Albania (AL), Austria (AT), Belgium (BE), Bulgaria (BG), Croatia (HR), Cyprus (CY), Czech Republic (CZ), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Germany (DE), Greece (GR), Hungary (HU), Iceland (IS), Ireland (IE), Italy (IT), Latvia (LV), Liechtenstein (LI), Lithuania (LT), Luxembourg (LU), Malta (MT), Monaco (MC), Netherlands (NL), North Macedonia (MK), Norway (NO), Poland (PL), Portugal (PT), Romania (RO), San Marino (SM), Serbia (RS), Slovakia (SK), Slovenia (SI), Spain (ES), Sweden (SE), Switzerland (CH), Turkey (TR) and United Kingdom (GB). The EPC contracting states are shown in red on the map after point 1.8.004. *OJ 2009, 396  
OJ 2010, 96, 394  
GL/EPO, General Part, 6  
OJ 2018, A44*
- 1.8.002** **All EPC contracting states are also contracting states to the PCT and are bound by its Chapter II.** The EPO can therefore act as designated and elected Office for any EPC contracting state provided the international application was filed on or after the date on which the EPC entered into force for the state concerned. This means that no European patent can be granted for an EPC contracting state on the basis of an international application filed prior to the date of entry into force of the EPC for that state. For *Art. 64(1) PCT  
OJ 2014, A33*

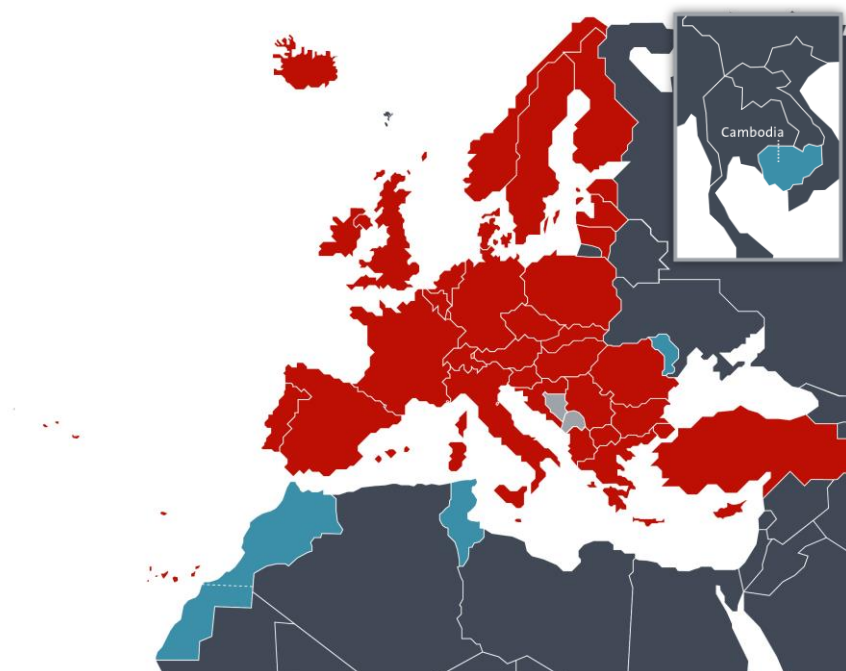
<sup>12</sup> [www.wipo.int/pct/en/texts/time\\_limits.html](http://www.wipo.int/pct/en/texts/time_limits.html)

further information on the (dependent) territories of the EPC contracting states to which the PCT has been extended, see the Notice from the EPO published in OJ 2014, A33.

**1.8.003** For some EPC contracting states, patent protection on the basis of an international application can only be obtained via the European route, i.e. by entering the European phase to obtain a European patent for the state concerned, since these states have closed off the possibility of entering into the national phase before the national Office concerned (see point 2.10.007).

*Art. 45(2) PCT*

**1.8.004** European patents may also take effect in states other than EPC contracting states via a system of extension (in light grey on the map below) or validation (in blue on the map below). For information on extension states, see points 2.11.001 ff. For information on validation states, see points 2.12.001 ff.



## 1.9 Representation in the international phase

**1.9.001** Any attorney, patent agent or other person ("agent") having the right to practise before the national or regional patent office with which the international application was filed is entitled to practise before:

- this national or regional office acting as receiving Office,
- the IB,
- the competent ISA,
- the competent SISA and
- the competent IPEA.

*Art. 27(7), 49 PCT  
R. 90.1 PCT  
Art. 133, 134 EPC  
WIPO PCT Guide  
5.041-5.051,  
10.019-10.023,  
11.001-11.014*

**1.9.002** An agent so appointed before the receiving Office is referred to as "the agent for the international phase". Applicants are strongly advised to appoint an agent already at the time of filing an international application with the receiving Office.

**1.9.003** Two or more applicants may choose to appoint either a **common agent** for the international phase or one of the said applicants who is a national or resident of a PCT contracting state to act as their **common representative**, who in turn may then appoint an agent.

*R. 2.2, 2.2bis,  
90.2(a), 90.3 PCT*

**1.9.004** If no common agent or common representative has been appointed, the applicant first named in the request who is entitled to file an international application is considered to be the common representative (see points 2.9.005 ff). The "deemed common representative" is not entitled to sign notices of withdrawal on behalf of co-applicants. If a deemed common representative has appointed an agent, the latter will be considered to be the agent of record and may validly perform any act which could be performed by the deemed common representative. If an agent has been appointed by a co-applicant of the deemed common representative, the agent will be entitled to act only on behalf of that co-applicant.

*R. 90bis.5, 90.2(b)  
PCT  
PCT Newsletter  
10/2013, 11  
7-8/2014, 11  
6/2017, 8*

**1.9.005** More information on representation specifically before the EPO is provided in points 2.9.001 ff (EPO as RO), points 3.1.020 ff (EPO as ISA), points 4.1.046 ff (EPO as IPEA) and in points 5.3.005 ff (EPO as designated or elected Office).

## **1.10 Computation of time limits in the international phase**

**1.10.001** If a time limit in any procedure in the international phase starts to run upon issue of a communication, the day of the date of that communication is decisive for computing the end of that time limit, not the date of its receipt. In this respect the PCT differs from the EPC, where the date of receipt of a communication is relevant.

*R. 80.6 PCT  
R. 126-129, 131(2)  
EPC*

**1.10.002** However, if an applicant proves to the satisfaction of the EPO as receiving Office, ISA, SISA or IPEA that the despatch of a communication did not take place on the date that the document bears, the actual date of mailing will be taken as the basis for computing the applicable time limit. Furthermore, if a communication was received more than seven days after the date it bears, the applicable time limit will be extended by the number of days by which the communication was received later than seven days after the date it bears.

## **1.11 External complaints**

**1.11.001** External complaints may concern any service or product delivered by the EPO, including all PCT products, and may be submitted by any person, including applicants. They may be submitted using the online form available at [www.epo.org/complaint](http://www.epo.org/complaint).

- 1.11.002** Complaints are forwarded to a dedicated EPO unit responsible for ensuring that any complaint is dealt with fairly and efficiently and that suitable action is taken to address it. A comprehensive reply to the complaint will be provided.
- 1.11.003** The complaint handling procedure does not replace the procedures laid down in the PCT; nor does the unit responsible for handling complaints take decisions on procedural requests. The department competent for the proceedings concerned decides on:
- (a) complaints relating to procedural and/or substantive aspects of specific pending proceedings which are submitted by a party to those proceedings. All parties to the proceedings will be informed accordingly;
  - (b) complaints relating to substantive issues which are submitted by a third party while proceedings are pending before the EPO. Such a submission will be treated as a third-party observation (see point 4.2.015).

## Chapter 2 – The EPO as a PCT receiving Office

### 2.1 Who may file an international application with the EPO?

**2.1.001** An international application may **at the applicant's option** be filed:

*Art. 9, 10 PCT  
R. 19.1, 19.2 PCT  
WIPO PCT Guide  
5.008-5.009*

- with the national office of the PCT contracting state of which the applicant is a resident or national, or with the office acting for that state, or
- with the IB as receiving Office.

**2.1.002** A third option exists for natural and legal persons who are nationals or residents of an **EPC** contracting state, since they may also file international applications with the **EPO** acting as a **receiving Office**. In such cases it is sufficient that at least one applicant is a national or resident of an EPC contracting state, regardless of whether he is for example mentioned in Box II of the PCT Request as applicant for the designation of the US or any other PCT contracting state only and, as the case may be, also as inventor. A person mentioned only as inventor does not qualify as an applicant. Hence, the nationality or residence of a person mentioned only as inventor is irrelevant for the purpose of filing an international application.

*R. 4.5(d), 18, 19.1(b)  
PCT  
Art. 151 EPC  
R. 157 EPC  
OJ 2014, A33*

**2.1.003** If there are **two or more applicants**, it is sufficient for at least one of the applicants to satisfy these requirements. For instance, if a national or resident of an EPC contracting state is mentioned in the PCT request form as inventor and applicant for the purposes of the United States only, the international application may be filed with the EPO as receiving Office regardless of the residence and nationality of the other applicant(s).

*OJ 2014, A33  
Section 203 AI  
WIPO PCT Guide  
5.020-5.022  
PCT Newsletter  
5/2012, 8  
4/2014, 6*

**2.1.004** When the EPO acts as receiving Office, the EPO will process the application in accordance with the relevant provisions of the PCT, including the PCT Receiving Office Guidelines (GL/RO) and the Administrative Instructions under the PCT (AI) (see points 1.3.001 ff).

### 2.2 How must an international application be filed with the EPO as receiving Office?

**2.2.001** International applications must be filed using the PCT request form (PCT/RO/101), preferably in electronic form (e-filing) or alternatively on paper. They may be filed online, direct, by post or by fax. If the application is filed in electronic form, fee reductions apply (see point 2.24.018).

*R. 11, 92.4 PCT  
OJ 2007, Spec.Ed.3,  
A.1, A.2, A.3  
OJ 2015, A91  
OJ 2017, A59  
WIPO PCT Guide  
6.003*

**2.2.002** It is not possible to file an international application by email, telegram, telex or Teletext.



## E-filing

**2.2.003** International applications may be filed in electronic form with the EPO as receiving Office, either online or offline on an electronic data carrier ("physical medium").

*R. 89bis PCT  
OJ 2015, A26, A91  
OJ 2017, A59  
OJ 2018, A45, A46  
GL/EPO A-II, 1.3*

All documents filed electronically must comply with the requirements set out in Part 7 of the Administrative Instructions under the PCT and their Annex F, which sets out the standard for the electronic filing and processing of international applications.

### How can an international application be filed online?

**2.2.004** Applicants can currently choose from various online filing options offered by the EPO and WIPO. The ones offered by the EPO are:

*OJ 2018, A45, A93,  
A94  
AI, Part 7, Annex F*

- Online Filing (OLF), a software application that authenticates users via smart card and can be used to prepare and file international applications and further documents (alternatively applications and further documents prepared in Online Filing can then be filed on electronic data carriers accepted by the EPO; see point 2.2.009);
- the EPO case management system (CMS), a web-based system accessible from most browsers that authenticates users via smart card and can be used to prepare and file international applications and further documents. Data and documents are stored on a secure network hosted by the EPO and it is not necessary to install any software, except for the smart card; and
- Web-Form Filing, a browser-based system which allows applicants to log in with a username and password in order to upload and submit PDFs via a secure internet connection; such PDFs need to comply with Part 7 of the Administrative Instructions under the PCT and their Annex F.

**2.2.005** The EPO's Online Filing software and the required smart card, as well as the CMS and the Web-Form Filing service, are free of charge. More information regarding the EPO Online Services is available on the EPO website.<sup>13</sup>

**2.2.006** The following online filing tools are currently offered by WIPO:

- PCT-SAFE, a software application with user authentication via smart card or digital certificate that can be used to prepare international applications in electronic form and then file them via secure online transmission (alternatively applications prepared using PCT-SAFE can be filed on a physical medium such as a CD-R); and

<sup>13</sup> [www.epo.org/applying/online-services.html](http://www.epo.org/applying/online-services.html)



- ePCT, a browser-based system accessible via a secure connection and offering several means for user authentication (e.g. digital certificate, authenticator application for one-time passwords) that can be used to prepare and file international applications and further documents.

**2.2.007** Information on the PCT-SAFE software and the ePCT service is available on the WIPO website.<sup>14</sup>

**2.2.008** The online filing of an international application with the EPO as receiving Office triggers the electronic acknowledgement of receipt. The acknowledgement indicates the receiving Office, the date and time of receipt, the reference or application number allocated by the EPO, the list of the files transmitted and a message digest, i.e. the message in compressed form.

### **How can an international application be filed electronically on a physical medium ("offline filing")?**

**2.2.009** The physical media accepted by the EPO as receiving Office are CD-R, DVD+R and DVD-R. For more information, please refer to the WIPO PCT Guide.<sup>15</sup>

*OJ 2007, Spec.Ed.3, A.5*

**2.2.010** If an international application is filed on a physical medium, the acknowledgement of receipt is sent by post (see point 2.2.027).

### **What is the purpose of filing in pre-conversion format?**

**2.2.011** If any document making up the international application has been prepared by conversion from a different electronic document format (pre-conversion format), the applicant may submit the document in that format too, preferably together with a statement that the international application in electronic form is a complete and accurate copy of the document in pre-conversion format. Each pre-conversion document must be in a format that fulfils the requirements stipulated in the Decision of the President of 12 July 2007. Pre-conversion documents must be submitted as ZIP files. The purpose of filing in pre-conversion format is that, if an applicant discovers that the relevant part of the international application as filed in electronic form is not a complete and accurate copy of the document submitted in pre-conversion format, they may ask the EPO in its capacity as receiving Office to correct the international application accordingly within 30 months of the priority date.

*OJ 2007, Spec.Ed.3, A.5  
PCT Newsletter  
7/2008, 1  
5/2008, 2  
AI, Part 7, Section  
706*

<sup>14</sup> [www.wipo.int/pct-safe/en/download/download\\_client.html](http://www.wipo.int/pct-safe/en/download/download_client.html),  
<https://pct.wipo.int/>,  
[www.wipo.int/pct-safe/en/index.html](http://www.wipo.int/pct-safe/en/index.html)

<sup>15</sup> [www.wipo.int/pct/guide/en/gdvol1/annexes/annexc/ax\\_c\\_ep.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexc/ax_c_ep.pdf)  
[www.wipo.int/pct/guide/en/gdvol1/annexes/annexd/ax\\_d\\_ep.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexd/ax_d_ep.pdf)

## How can an application be filed with the EPO direct or by post?

- 2.2.012** In principle, the date of filing accorded to an application filed with the EPO direct or by post is the **date of handing over or receipt respectively at an EPO filing office**. Automated mailboxes are installed in Munich ("Zollstrasse") and Berlin next to the EPO building. These automated mailboxes may be used at any time. The automated mailbox at EPO headquarters in Munich (Isar building, Kohlstrasse) has been closed since 1 April 2017. Outside office hours, at all filing offices, documents may be handed to the porter, who will security-scan them on receipt.
- 2.2.013** If the applicant has chosen the EPO as receiving Office the international application should be sent directly to one of the EPO filing offices and not to a national patent office (see point 2.1.002).
- 2.2.014** The EPO has filing offices in Munich, The Hague and Berlin. Please note that the sub-office in Vienna is not a filing office, nor is the Brussels Bureau. The EPO's addresses are available on the EPO website.<sup>16</sup>
- 2.2.015** The national law of an EPC contracting state may prescribe that an international application is to be filed with the EPO as receiving Office **via** its national patent office. Only in that case may the application be filed with the EPO as receiving Office via the national patent office of the EPC contracting state concerned.
- 2.2.016** If, pursuant to national law, the international application must be filed with the EPO as receiving Office via the competent national patent office, this office will only be acting as a "filing office" for the EPO and not as receiving Office. The date of receipt of the application by the national patent office concerned, on behalf of the EPO as receiving Office, will be considered the international filing date, on condition that the application meets the PCT requirements for a filing date to be accorded.
- 2.2.017** In these cases the national patent office concerned must ensure that the application reaches the EPO not later than two weeks before the end of the thirteenth month from filing or, if priority is claimed, from the earliest date of priority.
- 2.2.018** The addresses of the national patent authorities of the EPC contracting states and information on national legislation are provided in the brochure "National law relating to the EPC".<sup>17</sup>
- 2.2.019** The documents constituting an international application must be filed **in only one copy** with the EPO as receiving Office: PCT request form, description, claims, abstract and drawings (Box No. IX PCT request form). The same applies to any *other*

*OJ 2007, Spec.Ed.3,  
A.1, A.2  
OJ 2010, 642*

*Art. 10 PCT  
R. 157(1) EPC*

*OJ 2007, Spec.Ed.3,  
A.1, A.2  
GL/EPO A-II, 1.1*

*Art. 27(8) PCT  
Art. 75(2), 151 EPC  
R. 157(1) EPC  
PCT Newsletter  
6/2014, 11*

*R. 157(3) EPC*

*Art. 3(2), 4-7 PCT  
R. 3.3, 4-8, 11.1 PCT  
R. 157(2) EPC  
WIPO PCT Guide  
5.010, 5.179-5.180*

<sup>16</sup> [www.epo.org/applying/european/filing.html](http://www.epo.org/applying/european/filing.html)

<sup>17</sup> [www.epo.org/law-practice/legal-texts/national-law.html](http://www.epo.org/law-practice/legal-texts/national-law.html)

documents referred to in Rule 3.3(a)(ii) PCT and listed in Box No. IX of the PCT request form.

### What happens in the event of loss or delay in the post?

- 2.2.020** In case of loss or delay, the EPO accepts evidence of mailing a document only if it was mailed via the postal authorities or if one of the following postal service providers was used instead: Chronopost, DHL, Federal Express, flexpress, TNT, SkyNet, UPS or Transworld. As evidence, confirmation of registration by the post office or confirmation of receipt by the postal service provider must be provided at the request of the EPO. *R. 82.1(d), (e) PCT  
OJ 2015, A29*
- 2.2.021** Rule 82 PCT excusing a delay in the post and Rule 82*quater* PCT excusing a delay due to force majeure are not applicable to the priority period, because these provisions may only be applied in respect of time limits fixed in the PCT. It is only under strict conditions that a right of priority may be restored (see points 2.14.001 ff). It is therefore recommended that an application be filed as early as possible. *Art. 48(1) PCT  
OJ 2010, 351  
OJ 2018, A25*

### Can an international application be filed by fax?

- 2.2.022** An international application may, together with further documents other than authorisations and priority documents, be filed by fax with the EPO as receiving Office. The fax numbers are available on the EPO website.<sup>18</sup> *R. 92.4 PCT  
OJ 2007, Spec.Ed.3,  
A.2, A.3  
OJ 2008, 16  
OJ 2010, 642*
- 2.2.023** If an international application is filed by fax, the date on which the facsimile application documents are received in full at the EPO is accorded as the date of receipt of the application. Each of the EPO filing offices is based in the Central European Time zone (CET).
- 2.2.024** If an international application is filed by fax, the original, i.e. **the confirmation copy, is to be filed simultaneously**, and the fax should state that the confirmation copy has been filed separately on paper at the same time (see point 2.2.012). *OJ 2007, Spec.Ed.3,  
A.3  
OJ 2010, 642*
- 2.2.025** Further, on the first sheet of the PCT request form filed as confirmation copy it should be indicated that the international application has previously been filed by fax, in the form of the words "CONFIRMATION COPY" followed by the date of fax transmission.
- 2.2.026** If the confirmation copy is not submitted within 14 days, the applicant will be invited to submit it. If the confirmation copy is not received after expiry of the time limit set in this invitation, the application will be considered withdrawn (see point 5.1.020). *R. 92.4(d), (e), (f),  
(g) PCT*

<sup>18</sup> [www.epo.org/applying/european/filing.html](http://www.epo.org/applying/european/filing.html)

**2.2.027** As a rule, the receiving Office will acknowledge receipt of an international application at an EPO filing office by mail within four working days. The acknowledgement explicitly confirms the receipt of each separate document and item making up the international application (e.g. description, claims, abstract, data carrier, letter, etc.). The receiving Office acknowledges receipt of the international application by automatically issuing Form 1031.

*OJ 2007, Spec.Ed.3, A.3  
OJ 2010, 642  
GL/EPO A-II, 3.1*

**2.2.028** On request, the EPO also acknowledges receipt of an international application **directly by fax or post** upon payment of an administrative fee.<sup>19</sup> To ensure prompt acknowledgement, the request for fax confirmation and evidence of payment of the administrative fee (e.g. a bank order) or a debit order must be enclosed with the documents or filed at the same time. The applicant should not forget to also provide a fax number to which acknowledgement of receipt is to be sent. If no fax number is indicated, the acknowledgement is sent by post to the applicant or, where applicable, his agent.

**2.2.029** If the above-mentioned requirements are fulfilled, the acknowledgement is issued within **one working day** after receipt of the application.

#### **Can an international application be filed by email, telegram, telex or similar means?**

**2.2.030** An international application **cannot** be filed with the EPO by email, telegram, telex or similar means. Applications so filed cannot be accorded a valid date of filing. For filing in electronic form see points 2.2.003 ff.

*OJ 2000, 458  
OJ 2007, Spec.Ed.3, A.3*

**2.2.031** Email, telegram, telex and similar means have **no legal force** in the proceedings under the PCT and cannot be used validly to perform **any** procedural act. Therefore, no time limit for such act can be complied with by such means.

#### **How can further documents be filed?**

**2.2.032** After an international application has been filed other documents may be filed in any proceedings before the EPO online or direct, by post or by fax at the EPO filing offices. However, priority documents issued in paper form which have to be certified by the issuing authority should also be submitted to the EPO in that form to ensure the validity of the certification. For that reason, they may not be filed by fax or via the EPO Web-Form Filing service. On the other hand, priority documents issued in electronic form are accepted only if they are digitally signed by the issuing authority and if that signature is also accepted by the EPO. Applicants filing an international application claiming the priority of an application filed with an office participating in the WIPO Digital Access Service

*R. 17.1 PCT  
OJ 2007, Spec.Ed.3, A.3  
OJ 2016, A78  
OJ 2017, A59  
OJ 2018, A45, A93, A94*

<sup>19</sup> [www.epo.org/applying/fees.html](http://www.epo.org/applying/fees.html)

(DAS) may request the IB to obtain a certified copy of the earlier application via DAS.<sup>20</sup>

- 2.2.033** There is no obligation to file a confirmation copy of subsequent documents, but the receiving Office may require one to be submitted (see point 2.2.024) and will do so in particular if the applicant has submitted substitute sheets under Rule 26 PCT and/or any sheets to be incorporated by reference under Rule 20.6 PCT. In these two cases the applicant is advised to submit a confirmation copy on his own initiative directly after sending the sheets concerned by fax.

## **2.3 Elements of the international application**

- 2.3.001** Any international application **must** contain the following elements: PCT request, description, claim(s) and an abstract. Drawings must only be filed when they are necessary for the understanding of the invention. As regards international applications in the field of biotechnology see also the information in points 2.20.001 ff.

*Art. 3(2), 7  
PCT Newsletter  
4/2017, 9*

- 2.3.002** The international application has to be filed with the EPO as receiving Office **in one copy only**. However, if the application is filed by fax a confirmation copy must be filed (see points 2.2.024 ff).

*R. 11.1 PCT  
R. 157(2) EPC  
OJ 2007, Spec.Ed.3,  
A.3*

## **2.4 How can elements or parts be incorporated in the international application by reference?**

- 2.4.001** If the applicant has omitted to file a **part of** the description, the claims or the drawings of the international application or an **entire element**, i.e. (all of) the description or all of the claims, these parts and elements may be incorporated in the international application under the conditions set out in Rules 4.18 and 20 PCT. If all conditions are met, such incorporation will not affect the international filing date. This procedure may be summarised as follows:

*R. 4.18, 20.5, 20.6,  
20.7 PCT  
WIPO PCT Guide  
6.028*

- 2.4.002** Firstly, such incorporation requires that the omitted part(s) or element(s) be completely contained in an application from which the priority was (validly) claimed **on the international filing date** (see points 2.13.001 ff). The test for "completely contained" requires that the later filed missing part - e.g. a paragraph, a page or a drawing - be identical to the corresponding text/drawing in the priority document.

- 2.4.003** Secondly, the PCT request must contain a statement of incorporation by reference of the priority application(s). A statement to that effect is already provided in Box VI of the PCT request form.

<sup>20</sup> For a list of the participating offices, see [www.wipo.int/das/en/participating\\_offices.html](http://www.wipo.int/das/en/participating_offices.html)

- 2.4.004** If both conditions are met, an applicant who has omitted to file a part or element may include it by confirming its incorporation by reference. This requires that the conditions for confirmation set out in Rules 20.6 and 20.7 PCT are also met.
- 2.4.005** If the description and/or claims as contained in the earlier application do not qualify as "missing parts" on the grounds that the international application already contained a complete description and/or a complete set of claims, the EPO as receiving Office will proceed to a negative finding under paragraph 205D of the PCT Receiving Office Guidelines and will **not** transmit the international application to the International Bureau in accordance with Rule 19.4(a)(iii) PCT (205G(b) GL/RO).
- 2.4.006** The procedure before the EPO as ISA/IPEA in the case of a positive/negative decision by the receiving Office on a request for incorporation by reference is set out below (see points 3.2.016, 4.2.008).
- 2.4.007** An applicant wishing to add omitted parts or elements to an international application which have no basis in a claimed priority application may do so under the conditions set out in Rule 20.5 PCT. However, in that case the filing date of the application as a whole will be the date of filing of the missing parts or elements.

## **2.5 International filing date**

- 2.5.001** The following criteria must be met for the receiving Office to accord an international application an international filing date: *Art. 11 PCT*
- the applicant is entitled to file it with the receiving Office;
  - it is in the prescribed language;
  - it indicates that it is intended as an international application;
  - it designates at least one contracting state;
  - it states the applicant's name;
  - it contains a description; and
  - it contains a claim or claims.
- 2.5.002** No other criteria must be met to obtain an international filing date. However, if the international application is filed without a title or an abstract, the receiving Office will invite the applicant to provide one. If no abstract or title is then submitted, the application is considered withdrawn. *Art. 14 PCT  
R. 8, 26 PCT*
- 2.5.003** Applicants must carefully consider the date on which an international application is to be filed and accordingly choose an appropriate way of filing to assure timely receipt at the EPO (see point 2.2.001).
- 2.5.004** The international filing date of an application filed with the EPO as receiving Office is the date on which the application is received at

the EPO or, in exceptional cases (see points 2.2.015-2.2.018), at a national patent office of an EPC contracting state acting as filing office on behalf of the EPO.

**2.5.005** Each international application has a single filing date. The term "international filing date" should therefore not be interpreted as if there is any further filing date in respect of an international application. The word "international" only refers to the fact that the application concerned was filed as an application under the PCT.

**2.5.006** The (international) filing date is not to be confused with the date of entry into the European phase before the EPO or into any national phase before a designated/elected Office (see graphic "The international and European phases of a PCT application" immediately after the contents). This means that even after entry into the European phase any reference to the filing date of the international application concerned is a reference to the international filing date (see points 5.2.001 ff).

## **2.6 Is it possible to file divisional applications in the international phase?**

**2.6.001** The PCT does not provide for the possibility of filing a divisional application. However, once the international application (i.e. the parent application) has validly entered the European phase, it is possible to file divisional applications with the EPO as designated/elected Office (see point 5.18.001).

*GL/EPO E-IX, 2.4.1*

## **2.7 The PCT request**

**2.7.001** International applications **must** be filed using **the PCT request form** (PCT/RO/101) or a corresponding computer printout. Applicants are advised to read carefully the PCT request form and the explanatory notes before completing the form. For electronic filing, see points 2.2.003 ff.

*Art. 3, 4, 11(1)(iii)  
PCT  
R. 3, 4 PCT  
WIPO PCT Guide  
5.015-5.093*

**2.7.002** Copies of the PCT request form and the explanatory notes are available free of charge from the EPO, the IB and national patent offices. Both documents may also be downloaded from the WIPO website.<sup>21</sup>

<sup>21</sup> [www.wipo.int/pct/en/forms/index.htm](http://www.wipo.int/pct/en/forms/index.htm)



## 2.8 Should the inventor be designated in the request?

**2.8.001** It is recommended that the inventor always be identified (Box No. III, PCT request form), unless there are special reasons for not doing so. The name and address of the inventor must be furnished in the PCT request form if the applicant wants to enter the national phase of a state requiring that the data of the inventor be given in the request upon filing. The consequences of non-compliance are a matter of national law. For up-to-date information on the national law of each of the PCT contracting states, see the WIPO PCT Guide.

*Art. 4(1)(v) PCT  
R. 4.1(a)(iv) PCT  
WIPO PCT Guide  
5.035-5.038  
PCT Newsletter  
8-9/2013, 8*

**2.8.002** In so far as the applicant aims to obtain a European patent, the data concerning the inventor – if not already submitted during the international phase – must be provided upon entry into the European phase (see points 5.2.006 and 5.12.001).

*Art. 22(1) PCT  
R. 159, 163(1) EPC  
GL/EPO E-IX, 2.3.4*

## 2.9 Who may represent an applicant before the EPO as receiving Office?

**2.9.001** Information on the representation of the applicant(s) during the international phase is to be provided in Box No. IV of the PCT request form. Before filling in the box, applicants should carefully read the instructions provided in the Notes to the PCT request form concerning Box No. IV and the information given below (see points 2.9.002-2.9.019).

*Art. 27(7), 49 PCT  
R. 90.1 PCT  
Art. 133, 134 EPC  
OJ 2010, 335  
WIPO PCT Guide  
11.001-11.014*

**2.9.002** The PCT explicitly allows the receiving Office to apply its national law to the extent that it requires an applicant to be represented by an agent having the right to represent applicants before it. Therefore, the EPC provisions concerning professional representation apply in respect of international applications processed by the EPO as receiving Office. According to the EPC, applicants not having their residence or principal place of business in an EPC contracting state need to be represented by a professional representative. Two categories of representatives ("agents" in PCT terminology) have the right to practise before the EPO as receiving Office:

*Art. 27(7) PCT  
Art. 133 EPC  
OJ 2014, A99*

- any professional representative or association of representatives entered in the directory of professional representatives maintained by the EPO
- any legal practitioner qualified to practise in patent matters in one of the EPC contracting states and who has his place of business in that state.

*OJ 2013, 500, 535*

**2.9.003** Only a person belonging to at least one of these categories may be appointed as agent for an international application filed with the EPO as receiving Office (see points 1.9.001 ff). The directory of



professional representatives can be consulted on the EPO website.<sup>22</sup>

- 2.9.004** The agent must always be mentioned by name in Box No. IV of the PCT request form, unless he belongs to an association of professional representatives registered as such with the EPO (see point 2.9.012). The agent may choose his address as he wishes on condition that it is in an EPC contracting state.

The screenshot shows a web form for appointing a representative. At the top, there are two radio buttons: 'Legal entity' (unselected) and 'Natural person' (selected). Below these are input fields for 'Name:' and 'Registration No.'. For 'Natural person', there is a 'First Name:' field. A dropdown menu for 'Country or territory:' is shown. Below this is a large 'Address:' field. To the right of the address field are fields for 'Telephone:', 'Facsimile:', and 'e-mail:'. Below the address field are fields for 'City:', 'Region:', and 'Postal code:'. There are two checkboxes on the right side: 'as advance copies follow' and 'exclusively in electronic form (to be sent)'. At the bottom left, there is a checkbox labeled 'Same address as the first-named agent'. The form has 'OK' and 'Cancel' buttons at the bottom right.

### Two or more applicants – common agent and common representative

- 2.9.005** If there are two or more applicants, a professional representative (see point 2.9.003) may be appointed as "**common agent**" (see point 1.9.003). *R. 90.2 PCT*
- 2.9.006** Moreover, if two or more applicants file the application, they may also appoint one of them as "**common representative**" (see point 1.9.003). If no common agent or common representative is appointed, the applicant first named in the PCT request form who is entitled to file an application with the EPO as receiving Office is considered to be the common representative ("deemed common representative") (see point 1.9.004).

<sup>22</sup> [www.epo.org/applying/online-services/representatives.html](http://www.epo.org/applying/online-services/representatives.html)

- 2.9.007** If no common agent is appointed, any correspondence is sent to the (deemed) common representative or, if the latter has appointed an agent, to the agent of the (deemed) common representative, unless a different address is provided as address for correspondence.

### **How to appoint an agent, common agent or common representative**

- 2.9.008** Appointment of an agent, common agent or common representative for the international phase requires a declaration to that effect. This can be made either in the PCT request (Box No. IV PCT request form) itself or in a separate notice ("power of attorney"). For this purpose the "PCT/Model of power of attorney" may be used, which is available on the WIPO website.<sup>23</sup> If the agent, common agent or common representative is at the same time to be appointed for the procedure in the European phase, please refer to the information in points 2.9.018 ff. *R. 90.4, 90.5 PCT*
- 2.9.009** For the appointment of the agent, the common agent or the common representative to be effective, the PCT request or the power of attorney must be duly signed by (all) the **applicant(s)** for whom the agent, the common agent or the common representative is intended to act (see points 2.9.014 ff and 2.22.001 ff).
- 2.9.010** Appointment of a (common) agent may also be effected by referring in the PCT request or in a separate notice to an existing general power of attorney deposited with the EPO.
- 2.9.011** Please note that a power of attorney may not be filed by fax or using the EPO Web-Form Filing service (see point 2.2.022).

### **Is it possible to appoint an association of professional representatives?**

- 2.9.012** If the applicant wishes to appoint the members of an association of professional representatives as agents, the name of the association and its registration number must be indicated in Box No. IV of the PCT request form. *R. 90 PCT  
R. 152(11) EPC  
OJ 2013, 500, 535*

<sup>23</sup> <http://www.wipo.int/pct/en/forms/pa/index.htm>

## Does the address for correspondence need to be in an EPC contracting state?

- 2.9.013** If no agent has been appointed, any correspondence is sent to the applicant. In that case, applicants may indicate an address for correspondence, which may be located anywhere in the world. This revised EPO practice for the use of an address for correspondence entered into force on 1 November 2014.

*Art. 27(7) PCT  
R. 4.4(d), 53.4 PCT  
Art. 150 EPC  
OJ 2014, A99*

The screenshot shows a web form for entering correspondence details. At the top, there are two radio buttons: 'Legal entity' and 'Natural person', with 'Natural person' selected. Below this, there are input fields for 'Name' (containing 'DOE') and 'First Name' (containing 'John'). To the left of these fields is a small menu with three items: '+ App.', '+ Inv.', and 'Corr.', with 'Corr.' highlighted. Below the name fields, there is a 'Country or territory' section with a dropdown menu showing 'GB' and 'United Kingdom'. To the right is a 'Telephone' field. Below the country, there is an 'Address' field containing '4567 Ipsum Street', followed by a 'City' field containing 'City'. To the right of the address is a 'Facsimile' field. Below the city, there is a 'Postal code' field containing '555987'. To the right of the postal code is an 'e-mail' field. Below the e-mail field, there is a note: 'The competent PCT Authorities e-mail address, if the Authorities notifications issued in respect of'. Below this note are two checkboxes: 'as advance copies follow' and 'exclusively in electronic form (to be sent)'. At the bottom of the form are 'OK' and 'Cancel' buttons.

## Does the EPO require the filing of a power of attorney?

- 2.9.014** The EPO as receiving Office (and also as ISA, SISA and IPEA) has waived the requirement that, for the effective appointment of an agent, common agent or common representative, a signed **separate** power of attorney must be submitted to it if the PCT request is not signed by (all) the applicant(s). The waiver does not apply to a legal practitioner referred to in Article 134(8) EPC if that person is not also a professional representative.
- 2.9.015** The EPO has also waived the requirement that a copy of the **general** power of attorney be attached to the PCT request or to a separate notice if appointment of a (common) agent is made by reference to a general power of attorney.
- 2.9.016** However, as a matter of strategy and caution, (common) agents and common representatives are recommended to obtain explicit authorisation from (all) the applicant(s) by way of direct signature of the PCT request or by duly signed powers of attorney. **The**

*R. 90.4(d) PCT  
Art. 134(8) EPC  
OJ 2010, 335*

*R. 90.5(c) PCT*

*R. 90.4(e), 90.5(d),  
90bis PCT*

**authorisation of each applicant is required in any case in which a withdrawal of any kind is submitted.**

- 2.9.017** The EPO may require the filing of a separate power of attorney or a copy of a general power of attorney in any case of doubt as to the (common) agent's or common representative's entitlement to act.

*OJ 2010, 335*

**Is it possible to appoint an agent for the European phase with the EPO as receiving Office?**

- 2.9.018** A (common) agent appointed in the PCT request as agent for an international application is appointed **only** for the international phase. This means that a professional representative authorised to act before the EPO and who acted for the applicant(s) in the international phase is not automatically considered to be the representative for the European phase. However, if the EPO is receiving Office and the agent is appointed by separate authorisation, the applicant(s) may, at the same time, indicate therein that the agent is also appointed to represent the applicant(s) before the EPO as designated or elected Office in the European phase. For the designation of an agent for the international *and* European phase at the same time, the applicant may use Form EPA/EPO/OEB 1003 available on the EPO's website.<sup>24</sup>

*Art. 27(7), 49 PCT  
R. 90.1 PCT  
Art. 134 EPC  
GL/EPO A-VIII, 1.5  
WIPO PCT Guide  
11.001*

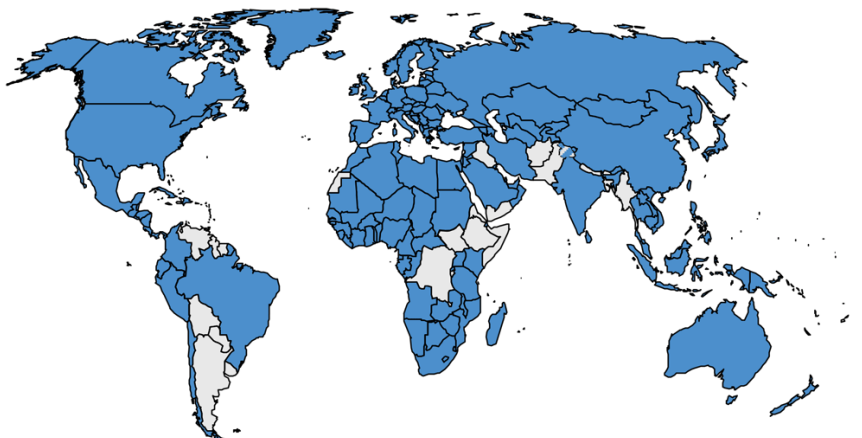
- 2.9.019** If the appointment of an agent is effected by reference to an existing general power of attorney and filing of a copy (see point 2.9.010), the appointment of the agent also for the European phase must be explicitly made in a separate notice.

<sup>24</sup> [http://documents.epo.org/projects/babylon/eponet.nsf/0/F0E8FAC1BF4ED2A7C125737E004E4C9A/\\$File/1003\\_form\\_11\\_11.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/F0E8FAC1BF4ED2A7C125737E004E4C9A/$File/1003_form_11_11.pdf)

## 2.10 For which states may international applications be filed?

- 2.10.001** An international application may seek patent or another form of protection (utility model, for example) for any PCT contracting state.

*Art. 4(1)(ii),  
11(1)(iii)(b) PCT  
R. 4.9(a), (b) PCT  
Art. 153(1) EPC  
WIPO PCT Guide  
5.052*



- 2.10.002** Upon filing of the PCT request, the applicant will obtain automatic and all-inclusive coverage of all designations available under the PCT on the international filing date, in respect of every kind of protection available and in respect of both regional and national patents. The (automatic) designation of "EP" covers all EPC contracting states for which the PCT and the EPC are in force on the filing date of the international application.

- 2.10.003** A decision on the EPC contracting states in which protection by way of a European patent is actually being sought need not be made until the application enters the European phase (see points 5.1.008 ff). It is important to note that, if a state accedes to the EPC after the international filing date, the EPO cannot act as a designated Office for the EPC contracting state concerned and no European patent can be obtained for that state. In this respect, the date of entry into the European phase is irrelevant.

### Non-designation for reasons of national law

- 2.10.004** For reasons of national law, check boxes in Box No. V of the PCT request form provide for exceptions to the otherwise automatic designation of Germany (DE), Japan (JP) and the Republic of Korea (KR). Crossing the check box for these designations is **not** considered as withdrawal of a designation, but as non-designation of the state(s) concerned.

*R. 4.9(b) PCT  
WIPO PCT Guide  
5.053*

- 2.10.005** According to the national law of these states, the filing of an international application which contains the designation of that state and claims the priority of an earlier national application filed

in that state (for Germany: for the same kind of protection) will have the result that the earlier national application ceases to have effect, with the same consequences as the withdrawal of the earlier national application. To avoid this effect, the appropriate box must be crossed (Box No. V PCT request form). More information on so-called "self-designation" can be obtained from the national patent offices concerned.

**Designations**

The filing of this request constitutes under Rule 4.9(a), the designation of all Contracting States of the PCT on the international filing date, for the grant of every kind of protection available under the law applicable, for the grant of both regional and national patents.

However,

☐ DE Germany is not designated for any kind of national protection

☐ JP Japan is not designated for any kind of national protection

☐ KR Republic of Korea is not designated for any kind of national protection

(The check-boxes above may only be used to exclude (irrevocably) the designation of a State at the time of filing or subsequently under Rule 26bis.1, the international application containing an earlier national application filed in the particular State concerned, in order to avoid the effect, under the national law, of this earlier national application. For details see the relevant Annex B1.)

☐

Please follow the internet link below for the current list of PCT Contracting States:

<http://www.wipo.int/treaties/en/documents/pdf/pct.pdf>

**2.10.006** As regards the EPC contracting states, the problem of self-designation exclusively concerns Germany (DE), and only if protection via the grant of a **national patent** in Germany is sought, i.e. if the application actually enters the German national phase. The designation of Germany for the purposes of a **European patent** is not considered a self-designation and is thus not affected. Consequently, there is no reason for withdrawing the automatic designation of EP. If the designation of Germany is not withdrawn upon filing, the international application can still enter the German national phase; however, in that case, the earlier German national application will be deemed withdrawn.

**2.10.007** The national law of a number of EPC contracting states stipulates that, on the basis of a PCT application, **only a European patent** may be obtained for these states. The countries which close off the route to a national patent in this way were, on 1 January 2019, Belgium (BE), Cyprus (CY), France (FR), Greece (GR), Ireland (IE), Italy (IT), Latvia (LV), Lithuania (LT), Monaco (MC), Malta (MT), Netherlands (NL) and Slovenia (SI).

*Art. 45(2) PCT*

## 2.11 Extension

- 2.11.001** With some European states which are not a party to the EPC and thus not "included" in the designation "EP", the EPO has concluded so-called "extension agreements". Pursuant to such agreements and the relevant national law, it is possible for applicants to extend European patent applications and patents to extension states, where the extended patents will confer essentially the same protection as patents granted by the EPO for the current 38 member states of the European Patent Organisation. Valid extension requires firstly that the applicant submits a request for extension and pays the extension fee(s) in due time, i.e. within 31 months from the date of filing (or the earliest priority date) or six months from the date of publication of the international search report, whichever is the later. A further requirement is that, on the international filing date, the extension agreement has to be in force and the extension state must both be a PCT contracting state and be designated for a national patent in the international application. *GL/EPO A-III, 12-12.5*
- 2.11.002** The extension states listed below were already PCT contracting states on the date of entry into force of the extension agreements. Moreover, as from 1 January 2004, all PCT contracting states are automatically designated for a national and, where applicable, a regional patent (see point 2.10.002).
- 2.11.003** On 1 January 2019, extension agreements are in force with:
- Bosnia and Herzegovina (BA) (since 1 December 2004); *OJ 2004, 563, 619*
  - Montenegro (ME) (since 1 March 2010). *OJ 2010, 10*
- 2.11.004** As to the extension of a European patent to the Republic of Montenegro (ME) following its Declaration of Independence on 3 June 2006 and before entry into force of the extension agreement on 1 March 2010, please refer to the information in the Official Journal. *OJ 2007, 406*
- 2.11.005** The extension agreements with Albania (AL), Croatia (HR), Latvia (LV), Lithuania (LT), North Macedonia (MK), Romania (RO), Serbia (RS) and Slovenia (SI) terminated when these states acceded to the EPC. **The extension system continues to apply after the relevant termination date for all applications filed prior to the date on which the extension agreement concerned terminated.** *OJ 2002, 463  
OJ 2003, 1  
OJ 2004, 481  
OJ 2005, 299  
OJ 2007, 637  
OJ 2008, 507  
OJ 2010, 96, 394*
- 2.11.006** A decision on the states for which extension is sought - and, in accordance therewith, timely payment of the extension fee(s) is due - need not be taken until the application has to enter the European phase (see points 5.8.012 ff). *OJ 2009, 603*



## 2.12 Validation

**2.12.001** In addition to the extension agreements, the EPO has concluded validation agreements with a number of states which are not a party to the EPC and thus not included in the designation "EP" (validation states). These validation agreements, unlike extension agreements, are not limited to European states. Pursuant to such agreements and the relevant national law, it is possible for applicants to validate European patent applications and patents in validation states, where the validated patents will confer essentially the same protection as patents granted by the EPO for the current 38 member states of the European Patent Organisation.

**2.12.002** In order to validate European patent applications and patents in a validation state, an applicant has to submit a request for validation and pay the validation fees in due time, i.e. within 31 months from the date of filing (or the earliest priority date) or six months from the date of publication of the international search report, whichever is the later. A further requirement is that, on the international filing date, the validation agreement has to be in force and the validation state must both be a PCT contracting state and be designated for a national patent in the international application. Thus, a decision on the states for which validation is sought – and, in accordance therewith, timely payment of the validation fee(s) is due – need not be taken until the application enters the European phase (see points 2.11.001 ff).

*OJ 2015, A19*

**2.12.003** On 1 January 2019, validation agreements are in force with:

- Morocco (since 1 March 2015);
- Moldova (since 1 November 2015);
- Tunisia (since 1 December 2017);
- Cambodia (since 1 March 2018).

*OJ 2015, A18, A20*

*OJ 2016, A5*

*OJ 2017, A84, A85*

*OJ 2018, A15, A16  
PCT Newsletter  
2/2018, 2*

## 2.13 How can an applicant claim the priority of an earlier application?

**2.13.001** A declaration in an international application claiming the priority of one or more earlier applications filed in or for any state party to the Paris Convention for the Protection of Industrial Property ("Paris Convention") or in or for any Member of the World Trade Organization (WTO) that is not party to the Paris Convention must always indicate the date on which the earlier application was filed, the state or states in which it was filed and the application number(s) under which it was filed. If the earlier application was a regional one, it suffices to give the name of the patent-granting authority under the regional agreement - i.e. "EP" in the case of a European application (Box No. VI PCT request form).

*Art. 8(1) PCT  
R. 2.4, 4.10 PCT  
OJ 2007, 692  
WIPO PCT Guide  
5.007,  
5.057-5.071,  
6.038-6.044*



**2.13.002** Priority from an application filed in or for a WTO Member that is not party to the Paris Convention may only be claimed in the procedure before the EPO as designated Office for an application filed on or after 13 December 2007. *GL/EPO A-III, 6.1*

**2.13.003** If the priority application was not filed by the applicant but transferred to him, the transfer must have taken place before the filing of the application. Proof of entitlement on the international filing date must be submitted (only) if the validity of the priority right claimed becomes relevant in the proceedings before the EPO.

## **2.14 How can an applicant request restoration of the priority right?**

**2.14.001** If an international application is filed after expiry of the priority period, a request for restoration of the right of priority under Rule 26*bis*.3 PCT may be filed with the EPO as receiving Office. A request for restoration of priority may also be filed with the EPO upon entry into the European phase, but its effect will then per se be limited to the grant procedures before the EPO (see points 5.13.018 ff).

*Art. 8 PCT  
R. 2.4, 26bis.2(c),  
26bis.3, 80.5, 82  
PCT  
Art. 122 EPC  
Art. 2(1)13 RFees  
OJ 2007, 692  
WIPO PCT Guide  
5.063-5.069  
PCT Newsletter  
9/2015, 10,  
7-8/2017, 15  
R. 80.5 PCT*


**2.14.002** If the last day of the priority year falls on a non-working day or an official holiday of the EPO, the priority year expires on the next subsequent working day. Rule 82 PCT concerning delay in receipt of an international application due to irregularities in the mail and Rule 82*quater* PCT concerning delays due to force majeure are not applicable to the 12-month time limit for claiming priority, since this time limit is not fixed in the PCT.


**2.14.003** The EPO as receiving Office may only grant a request for restoration of the right of priority if the following requirements are met:


- the international filing date is within two months from the date on which the priority period expired;
- the request for restoration is filed within the time limit of two months from the date on which the priority period expired;
- the fee for restoration of the right of priority is paid within the same time limit, which is not extended if the EPO acts as receiving Office;
- the request for restoration is supplemented by a statement explaining the reasons for failure to file the application within the priority period together with, where available, any evidence; and
- the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken by the applicant.

- 2.14.004** If the EPO as receiving Office intends to refuse a request for restoration of the right of priority, further submissions and/or evidence may be filed with the EPO within the time limit of two months from the date on which the first communication was issued (Form PCT/RO/158). Only then, will a final decision be taken and issued (Form PCT/RO/159).
- 2.14.005** A decision by the receiving Office on a request for restoration of the right of priority is not required for the international search if the application was filed within two months from the date on which the priority period expired, because in that case the priority claim may not be considered void during the international phase (see point 3.2.018). The priority claim continues to serve as the basis for the calculation of all time limits during the international phase, including the time limits for entry into the national phases, i.e. also into the European phase. *R. 26bis.2(c)(iii) PCT  
WIPO PCT Guide  
5.062*
- 2.14.006** If the applicant has not requested restoration of the right of priority in the procedure before the EPO as receiving Office or if the request for restoration has been rejected by the latter, the applicant may file a new request in the national phase, i.e. in the procedures before the EPO (see points 5.13.018 ff) and any other designated Office that has not made a reservation as to the applicability of Rules 49ter.1 and 49ter.2 PCT. *R. 49ter.1 and  
49ter.2 PCT*
- 2.14.007** If the EPO as receiving Office has granted a request for restoration, that decision is valid and will not be reviewed in the procedure before the EPO as designated Office (see points 5.13.021-5.13.022). If no reservation applies, that positive decision will, as a rule, also be accepted by other designated Offices.
- 2.14.008** For information as to the Offices that have made a reservation, please refer to the information in the WIPO PCT Guide (see points 1.3.001 ff).
- 2.15 Does the priority document have to be filed?**
- 2.15.001** Where the applicant claims the priority of an earlier application, a certified copy of that earlier application ("the priority document") must be filed with the receiving Office or the International Bureau within 16 months after the priority date. However, if the earlier application was filed with the receiving Office, the applicant may request that the receiving Office transmit a certified copy of the earlier application to the International Bureau. For that purpose, a check box is provided in Box No. VI of the PCT request form. *R. 17.1(a), (b) PCT*
- 2.15.002** If the EPO as receiving Office is requested to prepare and transmit a certified copy of an earlier application to the International Bureau, a fee is due (see point 2.2.032). However, no fee is due if the IB is requested to retrieve a priority document via DAS and it is available there (see point 2.15.003). The EPO as receiving Office does not include, free of charge, a copy of an earlier application in the file of an international application – even if that earlier application was a European application or an international application filed with the EPO as receiving Office. *R. 17.1(b) PCT  
Art. 3(1) RFees  
OJ 2012, 492  
OJ 2018, A93, A94*

- 2.15.003** Where the earlier application was filed as a national application with a national office that participates in the Digital Access Service (DAS), the IB may be requested to obtain a certified copy of the earlier application from DAS. For that purpose a check box and a text field for the required access code are provided in Box No. VI of the PCT request form. Similarly, where the earlier application was a European patent application filed on or after 1 November 2018, the IB can be asked to obtain a certified copy via DAS since the EPO started to participate in DAS for Euro-direct filings as from that date. From 1 April 2019, it will also be possible to request retrieval of a certified copy via DAS where the international application claims priority from a previous international application filed with the EPO as receiving Office. *OJ 2019, A27*
- 2.15.004** A priority document issued in paper form should also be submitted in that form to the EPO to ensure the validity of its certification. For that reason, it may not be filed by fax or using the EPO Web-Form Filing service. On the other hand, priority documents issued in electronic form are accepted only if they are digitally signed by the issuing authority and if that signature is also accepted by the EPO. At present, the Online Filing software and CMS support the submission of priority documents issued in electronic form (see points 2.2.022 and 2.2.032. Furthermore, during the international phase before the EPO as receiving Office, electronic priority documents can be submitted using ePCT. *R. 17.1(a), (b-bis) PCT  
PCT Newsletter  
12/2010, 7  
OJ 2018, A79  
OJ 2018, A93, A94*
- 2.16 Which is the competent International Searching Authority (ISA) when the EPO acts as receiving Office?**
- 2.16.001** If an international application is filed with the EPO acting as receiving Office, the **EPO is the only competent ISA**. Therefore, this need not be entered in Box No. VII of the PCT request form. *Art. 16 PCT  
R. 4.1(b)(iv), 4.14bis  
PCT  
Art. 152 EPC*
- 2.17 Is it possible to submit informal comments on earlier search results? What is PCT Direct?**
- 2.17.001** On 1 November 2014, the EPO launched the PCT Direct service for international applications filed with the EPO as receiving Office. On 1 July 2015, this service was extended to all the other receiving Offices. Under PCT Direct, an applicant filing an international application with any receiving Office and claiming priority from an earlier application already searched by the EPO may, together with the request form, file a letter containing informal comments aimed at overcoming objections raised in the search opinion established by the EPO for the priority application (see point 3.2.020). The EPO as ISA will take such informal comments into account when establishing the ISR and WO-ISA. *OJ 2014, A89  
OJ 2017, A21*

 Declarations

 Contents

 Fees

### Check List

☐ XML attachments
☒ PDF attachments

☐ Single specification file

copy of general power of attorney  
 translation of international application into...  
 separate indications concerning deposited microorganisms or other biological mat  
 sequence listing submitted for international search only  
 statement confirming that "the information in Annex C/ST.25 text format submitted  
Applicant letter to ISA concerning earlier search ('PCT Direct')  
 IP5 Collaborative Search and Examination Request  
 OTHER

Open

International Application

Accompanying Items

In total: 2 documents 0 files

## 2.18 Can an applicant request that an earlier search be taken into account?

**2.18.001** The applicant may file a request with the receiving Office that the result of an earlier search carried out by the EPO or by any other office be taken into account. A refund of the international search fee is, however, granted only under the conditions set out in point 2.19.001.

*R. 4.12 PCT*

## 2.19 In what circumstances is it possible to obtain a refund of the international search fee?

**2.19.001** If the search for the international application is based entirely or partly on an earlier search report already prepared by the EPO on an application whose priority is validly claimed (Box No. VI of the PCT request form), the applicant may obtain a refund of the international search fee. The EPO acting as ISA decides whether the requirements are met and, where applicable, refunds the applicable amount (see point 3.1.026). Where priority is claimed from an application for which the EPO carried out a search, the continuation section of Box No. VII in the PCT request does not need to be filled in.<sup>25</sup>

*R. 4.12, 12bis.1(d), 16.3, 41 PCT Art. 9(2) RFees Agreement EPO-WIPO Art. 5(2) OJ 2009, 99 OJ 2010, 304 OJ 2017, A95, A115 OJ 2018, A24, A35 GL/EPO A-X, 10.2.3 WIPO PCT Guide 5.073*

**2.19.002** No refund is made for any search other than a search carried out by the EPO on an application from which the right of priority is validly claimed.

## 2.20 Applications containing a reference to biological material

**2.20.001** Under the PCT, the question as to whether a reference to deposited **biological material** must be included in an international application is left to the national law of the designated states. The PCT, however, prescribes the contents of a required reference and sets the time limit for providing such a reference.

*R. 13bis PCT R. 31-34 EPC OJ 2010, 498 Section 209 AI WIPO PCT Guide 11.075-11.087 PCT Newsletter 11/2014, 13*

**2.20.002** Each designated Office decides whether a reference to biological material in accordance with the provisions of the PCT satisfies the requirements of its national law as to the content and time for furnishing the reference. However, a national requirement may be added and become a PCT requirement upon notification to the IB. The EPO has made use of this possibility (see points 2.20.003-2.20.004).

<sup>25</sup> New refund procedures enter into force at the EPO on 1 April 2019; see OJ 2019, A26

- 2.20.003** The EPO has notified the IB that the following additional matter should be indicated by an applicant wishing to enter the European phase:
- R. 13bis.4, 7 PCT  
R. 31(1)(d) EPC*
- To the extent available to the applicant, relevant information on the characteristics of the biological material should be mentioned in the application as filed, and where the biological material has not been deposited by (one of) the applicant(s) but by someone else, the name and address of the latter person (the depositor) must be stated in the international application. Moreover, a document must be submitted to the IB within 16 months from the priority date in which the depositor:
- has authorised the applicant to refer to the biological material, and
  - has given his/her unreserved and irrevocable consent to the deposited material being made available to the public.
- 2.20.004** Such authorisation is, however, not required if the depositor transferred his rights in the deposit to the applicant on the filing date at the latest. In that case, the document containing the transfer must be submitted instead. For further information see Annex L to the WIPO PCT Guide.
- 2.20.005** If any requirement concerning a reference to biological material is not met within 16 months from the priority date of the application, this **cannot** be remedied in the procedure before the EPO as a designated Office, i.e. upon entry into the European phase. As a consequence, the international application may be refused for insufficient disclosure in the course of the examination proceedings before the EPO as designated/elected Office.
- 2.20.006** Details of deposited biological material which are not included in the description should be supplied on a separate form (PCT/RO/134) (Box No. IX, check box No. 7 PCT request form). This form must likewise be used if the applicant wishes samples to be made available only to an expert.
- 2.20.007** The furnishing of samples of biological material by the EPO takes place in conformity with Rule 13*bis* PCT and Rule 33 EPC. As a consequence, if the requirements of Rule 33 EPC are met, requests for the furnishing of samples of biological material are certified by the EPO in its capacity as designated Office vis-à-vis third parties as from international publication in an EPO language, i.e. during the international phase. The EPO has notified the IB that if the applicant wishes the biological material to be made available only by the issue of a sample to an expert nominated by the requester, the applicant must inform the IB accordingly before completion of the technical preparations for publication of the international application, where such publication takes place in one of the EPO's official languages. If the international application was not published in an official language of the EPO, notification of the expert solution may be submitted until completion of the technical preparations for publication of the translation of this application. The fact that this solution has been chosen will be published by
- R. 13bis.6 PCT  
R. 32(1), 33 EPC  
OJ 1992, 470  
OJ 2010, 498  
PCT Newsletter  
7-8/2010, 6  
11/2011, 5*

WIPO on its Patentscope website and/or, if applicable, on the front page of the published translation of the application.

## 2.21 Applications disclosing nucleotide and/or amino acid sequences

- 2.21.001** If the international application discloses one or more **nucleotide and/or amino acid sequences**, it must contain a sequence listing, which is to be drawn up in compliance with the standard prescribed in Annex C of the Administrative Instructions under the PCT and published on the WIPO website. More specifically, the sequence listing must comply with the version of WIPO Standard ST.25 which is applicable on the date on which the sequence listing is submitted.<sup>26</sup>
- R. 5.2, 13ter.1 PCT  
OJ 2011, 372  
OJ 2013, 542  
Section 101, 204,  
207, 208, 707(a) and  
(a-bis)  
Annex C AI  
WIPO PCT Guide  
5.099-5.108,  
11.088  
PCT Newsletter  
7-8/2009, 10  
12/2010, 5  
12/2015, 9*
- 2.21.002** Any sequence listing not contained in the international application as filed will, if not allowable as an amendment under Article 34 PCT (see points 4.2.003 ff), not form part of the international application.
- 2.21.003** Tables related to sequence listings (if there are any) must be included as an integral part of the description in the same format as the remainder of the application. Any pages of tables relating to sequence listings count as regular pages of the description for which full page fees are payable (see point 2.24.006). Where the sequence listing contains free text, that free text must be repeated in the main part of the description in the language thereof and is taken into account for the calculation of the page fee part of the international filing fee (see point 2.24.006).
- R. 5.2(b) PCT*
- 2.21.004** The EPO accepts sequence listings filed on electronic media as specified by the EPO (see point 2.2.009).
- 2.21.005** If an international application is filed in electronic form, a sequence listing forming part of such application and filed in text format in compliance with Annex C is not taken into account for calculating the (page fee part of the) international filing fee (see point 2.24.006). There will be no need to file a second copy for the purposes of international search and, where applicable, international preliminary examination (see points 3.3.011, 4.2.034).
- 2.21.006** If any other option for filing a sequence listing is chosen, e.g. filing on paper or in image format, the sum of the page fee part of the international filing fee is calculated taking into account each page of the sequence listing. Furthermore, if the EPO is selected as ISA, SISA and/or IPEA a sequence listing in electronic form in text format in compliance with Annex C will be required (see points 3.3.011 ff).
- R. 13ter.1 PCT  
OJ 2011, 372  
OJ 2013, 542  
GL/PCT-EPO B-VIII,  
3.2  
GL/EPO E-IX, 2.4.2*

<sup>26</sup> [www.wipo.int/export/sites/www/standards/fr/pdf/03-25-01.pdf](http://www.wipo.int/export/sites/www/standards/fr/pdf/03-25-01.pdf)



## 2.22 Who must sign the request?

- 2.22.001** The PCT request form or, where applicable, the power of attorney **must be signed by the applicant.** *R. 4.1(d), 4.15, 26.2bis(a), 51bis.1(a)(vi) PCT WIPO PCT Guide 5.088-5.091*
- 2.22.002** Where there are two or more applicants, each applicant must sign the request, or each applicant for whom an agent has been appointed must sign a power of attorney (Box No. IX PCT request form). However, if there is more than one applicant, the EPO as receiving Office will not invite the applicant to furnish the missing signature(s) if the PCT request form is signed by **at least one of the applicants**. Any designated Office, however, may require the missing signature of any applicant who has not signed the PCT request for that designated state.
- 2.22.003** The EPO as designated Office does not require a missing signature to be submitted upon entry into the European phase.
- 2.22.004** If not the applicant but his agent has signed the PCT request form, a signed power of attorney or a copy of a general power of attorney need not be submitted since this requirement has been waived by the EPO (see point 2.9.014). However, as a matter of strategy and caution, it is recommended that agents obtain explicit authorisation from all applicants, by way of either direct signature or power of attorney (see points 2.9.016 ff). *R. 90.3, 90.4, 90.5 PCT OJ 2010, 335*

## 2.23 In which language must the international application be filed?

- 2.23.001** The international application, i.e. the request, description, claim(s), drawing(s) and abstract, must be filed with the EPO as receiving Office in English, French or German. An international application filed in another language will be forwarded to the IB to act as receiving Office instead of the EPO. This means that there is no possibility to file an application with the EPO as receiving Office in any other language as is provided under Article 14 EPC for European patent applications not filed via the PCT route (Euro-direct applications). *Art. 3(4)(i), 11(1)(ii) PCT R. 12, 19.4 PCT Art. 14, 150(2) EPC R. 3, 157(2) EPC WIPO PCT Guide 5.013-5.014*
- 2.23.002** If an application is filed with the EPO as receiving Office in one of its official languages, that language will be the language of the proceedings which may not be changed either during the international phase or on entry into the European phase (see points 5.1.014-5.1.015). However, with the exception of amendments and corrections to the application, for which the language of the international application must be used, any other correspondence with the EPO may be in any of the EPO's three official languages. *G 4/08 OJ 2010, 572*



## 2.24 What fees are due when filing an international application?

- 2.24.001** For fee payments to be made during the international phase, please consult the latest information available on both the EPO and the WIPO websites. Furthermore, guidance for the payment of fees, expenses and prices is provided in every issue of the Official Journal.
- 2.24.002** Anyone can validly make fee payments to the EPO: applicants, representatives and any other person.
- 2.24.003** For international applications the following fees are payable direct to the EPO as receiving Office:
- the transmittal fee,
  - the international filing fee, and
  - the international search fee.
- 2.24.004** The transmittal, international filing and search fees are payable within **one month** of receipt of the international application.
- 2.24.005** If the application contains **more than 30 pages**, the international filing fee increases, with a fixed sum to be paid for each page in excess of 30 pages. This extra fee is considered part of the international filing fee and must be paid by the applicant together with the (basic) filing fee. The applicant should compute the extra amount himself and not wait for a communication, because as from expiry of the one-month time limit the missing amount may only be validly paid together with a late payment fee (see point 2.24.020).
- 2.24.006** If the application contains a sequence listing as part of the description, the pages forming that part are not taken into account for calculating the page fee if all requirements are met (see point 2.21.005).

*Art. 3(4)(iv) PCT  
R. 14-16 PCT  
WIPO PCT Guide  
5.184-5.199  
PCT Gazette,  
15 March 2018, 212  
PCT Newsletter  
2/2018, 7, 3/2018, 8,  
4/2018, 7*

*R. 14.1, 15.3,  
16.1(f) PCT  
PCT Newsletter  
5/2015, 10*

### Amounts of fees

- 2.24.007** The amounts of the transmittal and international search fee are set by the EPO and laid down in the EPO's current Schedule of fees and expenses published in the Official Journal.
- 2.24.008** The conditions for a reduction in the international search fee are set out in points 3.1.024 ff.
- 2.24.009** The amount of the international filing fee, including the page fee, is set by WIPO in Swiss francs and is specified in the Schedule of Fees which is annexed to the PCT Regulations (PCT Schedule of Fees) and forms an integral part thereof. If this fee is paid to the EPO as RO, it must be paid in euros. Due to changes in the exchange rate between the euro and the Swiss franc, the

*R. 157(4) EPC  
Art. 2(1).2, 2(1).18  
RFees*

*R. 15.3, 16.1(f),  
14.1(c), 96.1 PCT  
PCT Schedule of  
Fees  
OJ 2018, A101*

equivalent amount is changed from time to time. This is announced by WIPO in its PCT Newsletter and by the EPO in its Official Journal. The amounts payable in respect of the international filing fee, the search fee and the transmittal fee are those applicable on the date of receipt of the international application.

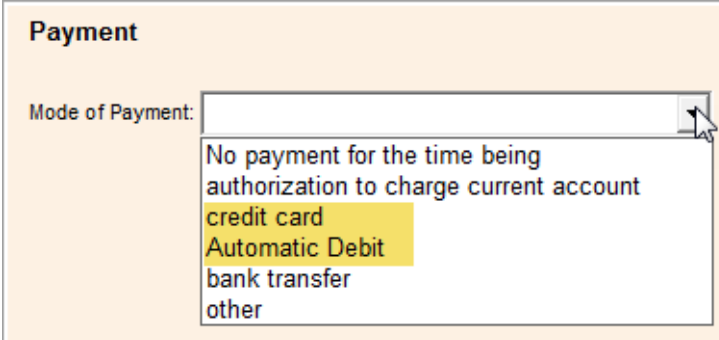
- 2.24.010** The conditions for a reduction in the international filing fee are set out in points 2.24.014 ff.

### Payment methods

- 2.24.011** All fees which are to be paid to the EPO must be paid in euros by payment or transfer to a bank account held by the EPO. For persons having a deposit account with the EPO payment may be made by debit order. As from 1 December 2017, the EPO has moved to "online-only" management of users' deposit accounts. This means that as from that date, all debit orders must be filed in an electronically processable format (XML) using one of the accepted electronic means of filing. A debit order can also be submitted in electronic form via the EPO's Online Fee Payment portal. If a debit order is submitted on paper, via Web-Form Filing or otherwise, it is invalid and will not be carried out.

*OJ 2007, 626  
OJ 2015, A53, A65  
OJ 2015, Suppl.  
Publ. 3  
OJ 2017, Suppl.  
Publ. 5  
OJ 2017, A72, A73*

- 2.24.012** **Automatic debiting** has been available for any fee payments to the EPO as receiving Office, ISA and IPEA since 1 April 2015. Payment of fees by **credit card** became possible on 1 December 2017. Payment by **cheque** was abolished by the EPO in 2008. Every issue of the Official Journal provides guidance for the payment of fees.



The screenshot shows a web form titled "Payment". Below the title is a label "Mode of Payment:" followed by a dropdown menu. The dropdown menu is open, displaying a list of options: "No payment for the time being", "authorization to charge current account", "credit card", "Automatic Debit", "bank transfer", and "other". The "credit card" option is highlighted with a yellow background.

- 2.24.013** The date to be considered as the date on which a payment is made is established in accordance with the EPO's Rules relating to Fees.

*Art. 7(1) RFees*

## When do fee reductions apply?

- 2.24.014** The international filing fee is reduced by 90% if the requirements stipulated in point 5 of the PCT Schedule of Fees are met. If there are several applicants, each of them must satisfy the requirements for the reduction to apply.
- 2.24.015** In respect of applicants entitled to file an international application with the EPO as receiving Office (see point 2.1.002), the reduction applies if the applicant is a natural person who is a national of and resides in one of the following states: Albania (AL), Bulgaria (BG), Croatia (HR), Cyprus (CY), Czech Republic (CZ), Estonia (EE), Greece (GR), Hungary (HU), Latvia (LV), Lithuania (LT), Malta (MT), North Macedonia (MK), Poland (PL), Portugal (PT), Romania (RO), Serbia (RS), Slovakia (SK), Slovenia (SI), Turkey (TR). On 1 January 2019, these EPC/PCT contracting states fell within the criteria of point 5(a) of the PCT Schedule of Fees.
- 2.24.016** If the application is filed by more than one applicant, only one must be a national and resident of one of the EPC/PCT contracting states listed above, but each applicant must fulfil the criteria mentioned under point 5 of the PCT Schedule of Fees.
- 2.24.017** A list of states whose nationals/residents may satisfy the requirements for a reduction is published in the PCT Newsletter.
- 2.24.018** With the EPO acting as receiving Office, there is a reduction in the international filing fee if the application is filed in **electronic form** (see point 2.2.003). The level of the reduction depends on the format in which the application is filed (PDF or XML format).
- 2.24.019** The PCT request form contains a Fee Calculation Sheet which applicants are asked to use for calculating fees. For possible reductions of the international search and preliminary examination fees when the EPO acts as ISA and/or IPEA, see points 3.1.024 and 4.1.059.

*Point 5 PCT  
Schedule of Fees  
WIPO PCT Guide  
5.188  
PCT Newsletter  
6/2015, 13  
PCT Newsletter  
7-8/2015, 5*

*WIPO PCT Guide  
5.189*

## What happens if fees are paid late?

- 2.24.020** If no fees are paid within the prescribed time limits (see point 2.24.004), or if the amounts paid are not sufficient to cover the fees due, the EPO invites the applicant to pay the missing amount together with a late payment fee of 50% of the amount of unpaid fees but at least an amount equal to the transmittal fee.
- 2.24.021** The late filing fee may not exceed the amount of 50% of the international filing fee as specified in the PCT Schedule of Fees, without taking into account any fee due for each page of the international application in excess of 30 pages.
- 2.24.022** If the applicant fails to pay the prescribed fees together with the late payment fee within one month of the date of the invitation, the international application will be considered withdrawn and the receiving Office will so declare.

*Art. 14(3)(a) PCT  
R. 16bis PCT  
OJ 1992, 383  
WIPO PCT Guide  
5.193-5.196  
PCT Newsletter  
5/2015, 10*

## Chapter 3 – The EPO as an International Searching Authority (ISA) and a Supplementary International Searching Authority (SISA)

### 3.1 General

**3.1.001** Since 1 July 2010 the EPO, in its capacity as an International Authority under the PCT, has acted not only as an ISA and an IPEA, but also as a Supplementary International Searching Authority (SISA). This chapter first sets out the procedure before the EPO acting as ISA, and at the end provides information on the procedure before the EPO acting as SISA (see points 3.4.001 ff). Chapter D provides information on the procedure before the EPO acting as IPEA.

**3.1.002** The Agreement EPO-WIPO sets out particulars of the procedures before the EPO as an International Authority. The current agreement entered into force on 1 January 2018. Annexes A and D of the agreement were revised with effect from 1 April 2018.

*OJ 2017, A115  
OJ 2018, A24, A35*

#### **What is the role of the EPO as ISA?**

**3.1.003** For every international application, the EPO as ISA issues either an International Search Report (ISR) and a Written Opinion of the International Searching Authority (WO-ISA) under Chapter I PCT or, in exceptional cases, a Declaration of Non-Establishment of International Search Report and a WO-ISA indicating that the ISA is not required to perform a search or cannot perform a meaningful search (see points 3.2.005 ff).

*Art. 17(2), 18 PCT*

**3.1.004** The ISR contains, among other things, the citations of the prior art documents considered relevant, the classification of the subject-matter of the invention and an indication of the fields searched.

*R. 43 PCT*

**3.1.005** The WO-ISA provides the applicant with a preliminary, non-binding opinion on the issues of novelty, inventive step and industrial applicability. This allows the applicant to assess, already at the search stage, whether to proceed directly to the national/regional phase or to file a demand under Chapter II PCT in order to overcome objections raised in the WO-ISA and possibly receive a positive IPER. However, before taking a decision on filing a demand for international preliminary examination, applicants are advised to consider carefully the information regarding the usefulness of the procedure under Chapter II PCT (see points 4.1.001 ff).

## When is the EPO competent to act as ISA?

- 3.1.006** Although the EPO's competence to act as ISA is, in principle, **universal**, i.e. not restricted to international applications from e.g. EPC contracting states, its competence to act as ISA for an international application is, as set out below, not automatically applicable (see points 3.1.007 ff).

Art. 16 PCT  
R. 35 PCT  
Art. 152 EPC  
Agreement EPO-  
WIPO, Art. 3(1)  
OJ 2017, A115  
OJ 2018, A24, A35  
WIPO PCT Guide  
7.002

### *Specification by the receiving Office*

- 3.1.007** The EPO can act as ISA only on condition that the receiving Office where the application was filed has specified the EPO as ISA.
- 3.1.008** Since most receiving Offices have specified the EPO, only states that had not (yet) specified the EPO as ISA (and IPEA) on 1 January 2019 are mentioned here: United Arab Emirates (AE), Australia (AU), Canada (CA), China (CN), Dominica (DM), Saint Kitts and Nevis (KN), Democratic People's Republic of Korea (KP), Republic of Korea (KR) and Papua New Guinea (PG). Up-to-date information is available on the WIPO website (see point 1.3.005).
- 3.1.009** If the IB is acting as receiving Office, the EPO is competent as ISA/IPEA if the international application could have been filed with a receiving Office which had specified the EPO as ISA/IPEA at the date of filing.

Agreement EPO-  
WIPO, Art. 3(3)  
OJ 2017, A115  
OJ 2018, A24, A35

### *Lifting of the competence limitation*

- 3.1.010** As a result of an amendment to the previous Agreement between the EPO and WIPO under the PCT, any national or resident of the USA filing an international application on or after 1 January 2015 with the USPTO or the IB as receiving Office can select the EPO as ISA or IPEA, irrespective of the technical field of the international application. This amendment is reflected in the current agreement which entered into force on 1 January 2018. It should, however, be noted that the Notice from the EPO dated 1 October 2007 concerning business methods remains applicable.

OJ 2017, A115  
OJ 2018, A24, A35

### *Choice of ISA and consequences*

- 3.1.011** If the receiving Office has specified more than one ISA, the applicant must indicate his choice of ISA in the PCT request (Box No. VII) and in the Fee Calculation Sheet (Box No. 2). Only one ISA may be selected. For example, the EPO may be chosen as ISA for applications filed with the USPTO and for applications in English filed with the JPO as receiving Office.
- 3.1.012** Applicants considering their choice of ISA are advised to bear in mind that the EPO will act as an **IPEA only if the international search was carried out by the EPO itself or by another European ISA**. On 1 January 2019, the EPO, the Austrian, Finnish, Spanish, Swedish and Turkish patent offices as well as the Nordic Patent Institute and the Visegrad Patent Institute were acting as European ISAs (see point 4.1.017).

R. 4.1(b)(iv),  
4.14bis PCT

Agreement EPO-  
WIPO, Art. 3(2),  
Annex A(i)  
OJ 2017, A115  
OJ 2018, A24, A35

- |                |   |                  |
|----------------|---|------------------|
| <b>3.1.013</b> | If the EPO acts as ISA or SISA, no supplementary European search is carried out. Therefore, no search fee will be due on entry into the European phase (see point 5.9.007). | OJ 2009, 594     |
| <b>3.1.014</b> | If the EPO acts as IPEA, there is a reduction of 75% of the examination fee in the European phase (see point 5.10.009).   | Art. 14(2) RFees |

**When is a translation needed for the purpose of international search?**

- |                |  |                                  |
|----------------|--|----------------------------------|
| <b>3.1.015</b> | For the purpose of the international search by the EPO as ISA, the application must be in one of its three official languages, i.e. <b>English, French or German</b> . Where the international application is filed in a different language the applicant must file a translation into one of the three official languages of the EPO with the receiving Office. Such translation must be furnished within one month of the date of receipt of the international application by the receiving Office.  | R. 12.3 PCT                      |
| <b>3.1.016</b> | If the application was not filed in a PCT language of publication, the language of the translation submitted for the purpose of the procedure before the EPO as ISA determines the language in which the international application is published. In any case where the language of the international publication is an official language of the EPO, that language will be the language of the proceedings in the European phase and cannot be changed. Therefore, applicants should carefully consider in which language they submit a translation for the purpose of international search. | R. 48.3 PCT<br>OJ 2010, 572      |
| <b>3.1.017</b> | Upon receipt of payment of the international search fee, the receiving Office will promptly forward a copy of the translation and of the PCT request form ("search copy") to the EPO as ISA.   | Art. 12(1) PCT<br>R. 23.1(b) PCT |

***Language of further correspondence***

- |                |   |                                |
|----------------|---|--------------------------------|
| <b>3.1.018</b> | In any further correspondence with the EPO as ISA, the applicant may use any of the three official languages of the EPO (see point 2.23.002). | R. 92.2(b) PCT<br>OJ 1993, 540 |
|----------------|---|--------------------------------|

***Application filed in Dutch***

- |                |   |   |
|----------------|---|---|
| <b>3.1.019</b> | An exception to the translation requirements for the purpose of international search by the EPO as ISA applies only if the application was filed with the Netherlands Patent Office as receiving Office. The EPO as ISA also accepts applications drawn up in Dutch, even though it is not an official EPO language. Therefore, a translation of an international application filed in Dutch with the Netherlands Patent Office is not required for the purpose of the international search by the EPO as ISA. However, within 14 months from the priority date a translation must be filed with the receiving Office in a language of publication accepted by the receiving Office for the purpose of international publication. The ISR and WO-ISA will be established in the language of the | R. 12.3, 12.4, 43.4,<br>48.3 PCT<br>Agreement EPO-<br>WIPO, Annex A(ii)<br>OJ 2018, A17, A24,<br>A35<br>PCT Newsletter<br>2/2018, 2, 5<br>4/2018, 4 |
|----------------|---|---|



international publication. For the above reasons, filing an application in Dutch should be carefully considered.

### Who may represent the applicant before the EPO as ISA?

- 3.1.020** Applicants may be represented before the EPO as ISA by the agent appointed on filing the international application and having the right to practise before the receiving Office, i.e. the agent for the international phase (see points 1.9.002 ff).
- 3.1.021** An applicant may also appoint an agent to represent him **specifically before the EPO in its capacity as ISA**. Moreover, the agent appointed for the international phase - and thus including for the procedure before the ISA - may appoint a sub-agent to represent the applicant specifically before the EPO as ISA. All communications issued by the ISA are sent to the agent specifically appointed for the procedure before the EPO as ISA.
- 3.1.022** Any agent specifically appointed to act before the EPO as ISA must be entitled to practise before the EPO (see point 2.9.003).
- 3.1.023** The requirement in respect of filing a separate power of attorney or a copy of a general power of attorney has been waived by the EPO as ISA (see point 2.9.014).

*Art. 49 PCT  
R. 83.1bis(b),  
90.1(a), (b), (d) PCT  
WIPO PCT Guide  
11.001-11.014  
PCT Newsletter  
4/2008, 7*

*OJ 2010, 335*

### What are the conditions for a reduction of the search fee?

- 3.1.024** The search fee to be paid if the EPO acts as ISA is reduced by 75% where the applicant or, if there are two or more applicants, **each** applicant is a **natural** person who is a **national and resident of a state not party to the EPC** which on the date of filing of the application is classified as a low-income or lower-middle-income economy by the World Bank. A table listing these states is available on the EPO website.<sup>27</sup>
- 3.1.025** The consequence of the requirement that **each applicant** must be a natural person who is a national and resident of a state **not** party to the EPC is that applicants with the nationality of or residence in an EPC contracting state for that reason alone do not fulfil the requirements for the reduction in the search fee (and the fee for international preliminary examination). It is, however, possible that they fulfil the requirements for the reduction in the international filing fee (see point 2.24.014) and the handling fee (see point 4.1.058).

*OJ 2008, 521  
GL/PCT-EPO A-III,  
8.2  
WIPO PCT Guide  
5.188-5.190  
PCT Newsletter  
7-8/2018, 6*

<sup>27</sup> [www.epo.org/applying/fees/international-fees/information.html](http://www.epo.org/applying/fees/international-fees/information.html)

## When is the search fee refunded?

- 3.1.026** Where the EPO can base the ISR on an earlier search that it has carried out for an application whose **priority is validly claimed** for the international application, the international search fee paid will be refunded in part or in full, depending on the extent to which the EPO benefits from that earlier search (see point 2.19.001). *R. 4.12, 12bis, 16.3, 41.1 PCT  
OJ 2009, 99  
OJ 2017, A95  
WIPO PCT Guide 5.073*
- 3.1.027** No refund is made for an earlier search that was not carried out by the EPO itself and/or if priority has not been validly claimed (see point 2.19.002).

## 3.2 The procedure before the EPO as ISA

### General

- 3.2.001** The objective of the international search is to discover relevant prior art. The PCT defines prior art as consisting of everything which has been made available to the public anywhere in the world by means of a written disclosure. Prior art is relevant if it is of assistance in determining whether the claimed invention is new and involves an inventive step. *Art. 15, 27(5) PCT  
R. 33.1 PCT  
GL/PCT-EPO B-II, 2, B-III, 1*
- 3.2.002** The definition of prior art in Rule 33 PCT is valid exclusively for the international phase of the procedure. This means that, during the European phase, the EPO applies the criteria applicable under the EPC for determining the relevant prior art. However, the scope of an international search is equivalent to that of a European search. This means that there is **no difference between an international and a European search**, either in respect of the method and quality of the search or in respect of the sources of prior art searched.
- 3.2.003** The EPO conducts the international search in accordance with the ISPE Guidelines (see point 1.4.004). In a number of cases, these guidelines leave it to the ISA concerned to choose between two or more (policy) options. A list of the options chosen by the EPO is provided in the PCT-EPO Guidelines and the Annex to this Guide. *GL/PCT-EPO,  
General Part, 3.2*
- 3.2.004** In accordance with the principle of supplementary application of the EPC, the EPO as ISA applies the Guidelines for Examination in the EPO where the PCT-EPO Guidelines and the ISPE Guidelines are silent (see points 1.4.001-1.4.006).

### Establishing the ISR and the WO-ISA

- 3.2.005** For every international application the EPO as ISA issues either an International Search Report (ISR) or, in exceptional cases, a "Declaration of Non-Establishment of International Search Report" (see point 3.3.003), and a Written Opinion of the International Searching Authority (WO-ISA). *Art. 15, 18 PCT  
R. 43, 43bis, 44 PCT  
OJ 2003, 574*



- 3.2.006** The procedure for establishing the ISR and the WO-ISA is similar to that for establishing the European search report and the European Search Opinion (ESOP).
- 3.2.007** The WO-ISA provides the applicant with a preliminary non-binding written opinion on the question whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. A WO-ISA established by the EPO as ISA will be comparable to the written opinion established by the EPO for a Euro-direct application (ESOP) (see point 3.2.002). *R. 43bis.1 PCT*
- 3.2.008** Where appropriate, the WO-ISA will also provide an opinion on issues such as added subject-matter, unity of invention, insufficiency of disclosure, support for the claims in the description, clarity, conciseness and formal defects (e.g. missing reference signs).
- 3.2.009** The WO-ISA may be positive or negative. A WO-ISA is qualified as positive if it contains no objections or only minor objections which would not prevent a direct grant in the European phase. In any other case the WO-ISA is considered negative (see point 3.2.013).
- 3.2.010** The ISR is established within three months from receipt of the search copy at the EPO as ISA or within nine months from the earliest priority date, whichever time limit expires later. *R. 42 PCT  
WIPO PCT Guide  
7.023*
- 3.2.011** The WO-ISA is established at the same time as the ISR. Both documents are sent to the applicant and the IB. The applicant also receives a copy of each document cited in the ISR.
- 3.2.012** As from 1 January 2018, an information sheet ("Information on Search Strategy") is annexed to all search reports drawn up by the EPO under both the PCT and EP procedures. This information sheet contains details about the databases and keywords used by examiners to retrieve the relevant prior art, as well as the classification symbols defining the extent of the search. Information sheets are made available via file inspection on WIPO's PATENTSCOPE and in the European Patent Register upon publication of the search report. *OJ 2017, A106  
OJ 2018, A14*
- 3.2.013** If the EPO acted as ISA (but not as IPEA), the applicant must provide a substantive response to any deficiencies set out in the WO-ISA ("negative WO-ISA") upon entry into the European phase ("mandatory response") (see points 5.4.025 ff). *R. 161 EPC  
GL/EPO E-IX, 3.2*

### **What happens if there are multiple independent claims?**

- 3.2.014** As a rule, the WO-ISA provides an opinion on all searched claims. However, if there are multiple independent claims, only one independent claim in each category is dealt with in detail. In respect of further independent claims, short comments are made. Where appropriate, an objection as to clarity and conciseness under Article 6 PCT may be raised. Further, the ISA may exercise its discretion to ask the applicant to clarify the subject-matter to be searched (see point 3.3.010). *Art. 6 PCT*

### **What happens if the priority document is not available to the ISA?**

- 3.2.015** If, at the time the search is conducted, the priority document(s) is (are) not available to the ISA, the search will be conducted as if the priority claim(s) is (are) valid.

### **Incorporation by reference of missing parts and elements**

- 3.2.016** If the receiving Office has granted a request for incorporation by reference under Rules 4.18 and 20.6 PCT (see points 2.4.001 ff), but the EPO as ISA does not consider the relevant part(s) and/or element(s) completely contained in the priority application, it will indicate this negative finding in the WO-ISA, for instance if the missing text has been inserted into the description of the application in such a way that it does not have exactly the same meaning as in the priority document. *R. 4.18, 20.6 PCT*
- 3.2.017** Furthermore the search will be extended to cover all prior art that will be relevant if, in accordance with the ISA's findings, the international application is re-dated by a designated Office in the national phase. Re-dating of the filing date can be avoided on condition that the applicant withdraws the later filed parts that are not considered completely contained in the priority application (see points 2.4.001 ff).

### **What is the "retention principle" for priority claims?**

- 3.2.018** The EPO as ISA must consider any priority claim to be valid if the international application claiming the priority right is filed within two months after expiry of the priority year ("retention principle"). Therefore, even if no request for restoration of right of priority has been filed, or if such request has been rejected or has not yet been decided upon at the time the international search is carried out, this has no bearing on the procedure before the ISA (see point 2.14.005). *R. 26bis.2(c) PCT*

### **When will the EPO as ISA take earlier search and classification results into account?**

- 3.2.019** For international applications filed on or after 1 July 2017, in carrying out the international search the EPO as ISA may take earlier search results into account where the applicant makes a request to that effect under Rule 4.12 PCT as well as in the cases envisaged under Rule 41.2 PCT. This means that the EPO as ISA will also be able to take earlier search and classification results into account where the international application claims the priority of one or more earlier applications in respect of which an earlier search has been carried out by the EPO, or where the RO has transmitted to it a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or (c) PCT, or where such a copy is available to it in a form and manner acceptable to it. *R. 23bis.2, 41.2 PCT  
PCT Newsletter  
1/2018, 9  
2/2018, 11*

### **What happens if an applicant has made use of the PCT Direct service?**

- 3.2.020** If the applicant has made use of the PCT Direct service by filing, together with the international application, informal comments on the EPO's earlier search results for the priority application (see point 2.17.001), the EPO as ISA will take such informal comments into account when establishing the ISR and WO-ISA. On 1 July 2015, this service was extended to all receiving Offices. As a result, applicants who selected the EPO as ISA will be able to use the service and submit PCT Direct letters irrespective of the receiving Office chosen. The PCT Direct service is useful for applicants interested in a positive WO-ISA in cases where the EPO has raised objections in the search opinion for the priority application. The informal comments should be in the form of a "PCT Direct letter" filed together with the international application and should aim at overcoming the objections raised for the priority application, in particular by explaining any amendments made compared to the priority application and by commenting on the objections raised.
- OJ 2017, A21*

### **When does international publication of the application and the ISR take place?**

- 3.2.021** International publication by the IB takes place promptly after expiry of 18 months from the priority date. If the ISR is available at that time, it will be published together with the application. If not, the ISR is published separately from the international application on receipt by the IB.
- Art. 21 PCT  
R. 48 PCT*
- 3.2.022** A WO-ISA for an international application filed on or after 1 July 2014 will be made available to the public as of the date of publication of the international application.

### **Can the applicant respond to the ISR and WO-ISA?**

- 3.2.023** There is no possibility for any form of dialogue between the applicant and the ISA on the content of the ISR and/or the WO-ISA. However, the applicant has the right to submit to the IB amendments to the claims pursuant to Article 19 PCT, as well as informal written comments on the WO-ISA. Moreover, the applicant may consider filing a demand for international preliminary examination under Chapter II PCT (see points 4.1.006 ff).
- Art. 19 PCT  
R. 46 PCT  
PCT Newsletter  
10/2004, 7  
6/2010, 8*

### **Amendments under Article 19 PCT**

- 3.2.024** Amendments under Article 19 PCT are published by the IB. They are particularly useful if there is a reason to better define the scope of the claims for the purpose of securing provisional protection in the PCT contracting states offering it (see point 5.16.002).
- WIPO PCT Guide  
9.004-9.011*

- 3.2.025** If the applicant wishes to file amendments to the claims, he must submit a complete set of the claims in replacement of all claims originally filed. Further, the basis for the amendments in the application as filed must be indicated in an accompanying letter. *R. 46.4 and 46.5 PCT  
Section 205 AI  
WIPO PCT Guide  
9.004-9.011  
PCT Newsletter  
9/2010, 12  
PCT Newsletter  
6/2010, 8*
- 3.2.026** Amendments under Article 19 PCT are to be filed **exclusively with the IB in the language of the international publication.** *PCT Newsletter  
6/2010, 8*
- 3.2.027** Any amendment to the claims under Article 19 PCT is to be made: *R. 46.1 PCT*
- within two months from the date of transmittal of the search report, or
  - within 16 months from the (earliest) priority date,
- whichever time limit expires later.
- Later filed amendments are accepted if they are received before the technical preparations for international publication have been completed.

### ***Informal comments***

- 3.2.028** If the applicant wishes to file informal comments, he may file them exclusively with the IB. Informal comments must be in the language of the international publication and may be submitted only during the international phase, i.e. within 30 months from the (earliest) priority date, but preferably before expiry of 28 months from the priority date. The IB will not send such comments to the IPEA. *PCT Newsletter  
4/2015, 8*

### ***Demand for international preliminary examination***

- 3.2.029** If a demand for international preliminary examination under Chapter II PCT is filed, any response to the WO-ISA must be submitted to the IPEA in the form of amendments and/or arguments under Article 34 PCT as part of the preliminary examination procedure (see points 4.2.003 ff). *WIPO PCT Guide  
7.030*

### **What is the International Preliminary Report on Patentability Chapter I?**

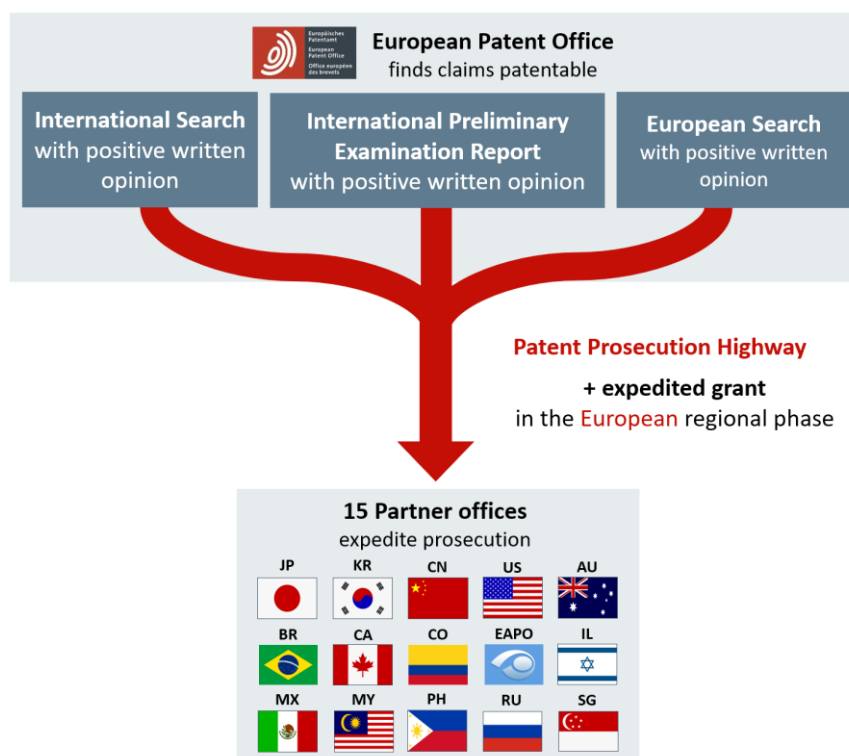
- 3.2.030** If no demand for international preliminary examination is filed, the IB will convert the WO-ISA into the International Preliminary Report on Patentability (IPRP Chapter I). Further, the IPRP Chapter I will be communicated to all designated Offices after expiry of 30 months from the priority date. A copy is promptly sent to the applicant. Any informal comments received will be annexed to the IPRP Chapter I. *R. 44bis PCT  
PCT Newsletter  
9/2018, 13  
11/2018, 10*
- 3.2.031** The IPRP Chapter I, together with any informal comments, will be made available for public inspection at the IB, but not before the international publication of the international application and subject to Article 38 and Rule 94.1(d) to (g) PCT. *R. 94.1(b) PCT  
GL/PCT-EPO C-I, 3  
PCT Gazette,  
12 May 2016, 93*

## Patent Prosecution Highway (PPH) based on a WO-ISA established by the EPO as ISA

**3.2.032** The PPH enables applicants whose claims have been determined to be patentable/allowable to have a corresponding application that has been filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results.

*OJ 2016, A44, A54, A75, A106  
OJ 2017, A5, A46, A47, A67, A77, A96, A107-A110*

**3.2.033** Under the PPH pilot programme at the EPO, a PPH request can also be based on the latest PCT work product, i.e. the WO-ISA or the IPER. Where the EPO is the ISA (and/or IPEA) and the international application contains claims that are determined to be patentable/allowable by the EPO as ISA (and/or IPEA), the applicant may, under the PPH pilot programme, request accelerated examination at the EPO's PPH partner offices. The EPO maintains a comprehensive PPH pilot programme with the other IP5 offices, i.e. CNIPA, JPO, KIPO and USPTO, and has launched bilateral PPH pilot programmes with CIPO (Canada), ILPO (Israel), IMPI (Mexico), IPOS (Singapore), IPA (Australia), SIC (Colombia), ROSPATENT (Russian Federation), MyIPO (Malaysia), IPOPHL (Philippines) and EAPO (Eurasian Patent Office).



**3.2.034** Irrespective of the PPH pilot programme, any applicant may request accelerated examination under the PACE programme in the procedure before the EPO as designated Office, at any time. For more information on the PACE programme, please refer to points 5.1.037 ff.

*OJ 2010, 352  
OJ 2015, A93*

### 3.3 Refusal to perform a (full) international search

#### When may the EPO refuse to conduct a (full) search?

**3.3.001** There are several reasons why the EPO as ISA may refuse or will not be able to perform a (full) international search. Such refusal may relate to the subject-matter of the application (see point 3.3.005), non-compliance with requirements regarding the description, claims or drawings of the application (see point 3.3.008), missing sequence listings (see point 3.3.012) or lack of unity of invention (see points 3.3.013 ff).

**3.3.002** If a claim relates to an invention in respect of which no international search was carried out, the EPO as IPEA will not carry out international preliminary examination in respect of that claim (see point 4.2.027). This also applies if amendments and/or arguments under Article 34 PCT have been filed.

*R. 66.1(e) PCT*

#### No search

**3.3.003** If all claims are found unsearchable, the EPO as ISA will establish a "Declaration of Non-Establishment of International Search Report" instead of an International Search Report and give reasons for the decision in that declaration and in the WO-ISA.

*Art. 17(2)(a) PCT  
PCT Newsletter  
10/2007, 7*

#### Incomplete search

**3.3.004** If only certain claims are found unsearchable, an ISR and a WO-ISA will be established in respect of the other claims. In that case the international search will be incomplete.

*Art. 17(2)(b) PCT*

#### Limitations related to the subject-matter

**3.3.005** The EPO is not required to perform an international search if the application relates to subject-matter which is not regarded as an invention or susceptible of industrial application or which is excluded from patentability **under the provisions of the EPC**. Here, the criteria applied for the decision not to perform an international search are the same as for the European procedure. This means that the discretion of an ISA not to search subject-matter set forth in Rule 39.1 PCT is used by the EPO as ISA only to the extent that such subject-matter is not searched under the provisions of the EPC.

*Art. 17(2)(a)(i) PCT  
R. 39.1 PCT  
Agreement EPO-  
WIPO, Art. 4,  
Annex C  
OJ 2017, A115  
OJ 2018, A24, A35  
GL/PCT-EPO B-VIII,  
1-3  
WIPO PCT Guide  
7.013*

#### Business methods

**3.3.006** The EPO as ISA will not carry out an international search on an application to the extent that its subject-matter relates to no more than a method of doing business, in the absence of any apparent technical character (see point 3.1.010).

*R. 39.1(iii) PCT  
OJ 2007, 592*



- 3.3.007** Nevertheless, if the claimed subject-matter involves technical means, an ISR will be established. However, to the extent that the technical means involved were widely available to everyone at the filing date, no documentary evidence is considered required, because of their notoriety, and no document will be cited in the ISR. Instead, a statement will be inserted that these technical means are considered so commonplace that no citation is considered necessary.

### **Complex applications**

- 3.3.008** Furthermore, the EPO as ISA will in exceptional cases not perform an international search or will perform a search limited to parts of the claimed subject-matter if the application documents fail to comply with the prescribed requirements to such an extent that a meaningful search is impossible for all or part of the claims. Applications of this kind are often referred to as "complex applications".
- 3.3.009** Complex applications will be dealt with in accordance with the PCT-EPO Guidelines and the ISPE Guidelines supplemented, where appropriate, by the EPO's practice as set out in the Guidelines for Examination (GL/EPO) (see points 1.4.001-1.4.006).
- 3.3.010** Before taking a decision under Article 17(2)(a)(ii) PCT, the ISA may invite the applicant informally to provide clarification of the claimed subject-matter in accordance with paragraphs 9.34 and 9.35 of the ISPE Guidelines.
- Art. 17(2)(a)(ii) PCT  
Art. 150(2) EPC*
- OJ 2011, 327*

### **Nucleotide and amino acid sequences**

- 3.3.011** If the sequence listing of an international application is not available in electronic form and/or does not comply with the standard provided in Annex C to the Administrative Instructions (WIPO Standard ST.25), the EPO as ISA will invite the applicant to furnish the sequence listing in electronic format and to pay a late furnishing fee within a non-extendable time limit of one month. Extensive information is provided in the Notice from the EPO of 18 October 2013.
- 3.3.012** If, within the time limit set, the applicant has not submitted the sequence listing in the required electronic form and format and paid the late furnishing fee, the EPO as ISA will carry out the international search without the sequence listing to the extent that a meaningful search can be carried out. This means that in many cases no or only an incomplete search is performed. This also has consequences for the international preliminary examination procedure before the EPO as IPEA (see point 4.2.034).
- R. 5.2, 13ter.1 PCT  
OJ 2007, Spec.Ed.3, C.2  
OJ 2011, 372  
WIPO PCT Guide  
7.005-7.012  
PCT Newsletter  
6/2018, 11*

## **Lack of unity of invention**

- 3.3.013** If the EPO as ISA considers that the international application claims more than one invention, it states the reasons for its finding and invites the applicant to pay an additional fee for every further search, payable direct to the EPO. At the same time the EPO informs the applicant of the result of the partial international search, which is restricted to those parts of the application relating to the invention first mentioned in the claims. As from 1 April 2017, the EPO sends a provisional opinion on the patentability of the invention (or unitary group of inventions) first mentioned in the claims, together with the invitation to pay additional search fees and the partial search results.
- 3.3.014** The amount of the additional fee is reduced for applicants fulfilling the requirements for reduction of the search fee (see point 3.1.024).
- 3.3.015** If the applicant does not pay any additional search fee, the EPO establishes the ISR and WO-ISA on the basis of the result already communicated. The WO-ISA will contain the reasons for any non-unity objection raised.
- 3.3.016** If the applicant pays one or more additional search fee(s) within the time limit set, those parts of the application for which additional search fees have been paid will also be searched. Consequently the ISR and WO-ISA will be established for all inventions for which a search fee has been paid.

*Art. 17(3)(a) PCT  
R. 13, 40 PCT  
R. 158(1) EPC  
OJ 1989, 61  
OJ 2017, A20  
GL/ISPE  
10.01-10.70  
PCT Newsletter  
7/2013, 10*

## ***Cascading non-unity***

- 3.3.017** If in response to an invitation by the EPO as ISA additional search fees are paid and the additional searches reveal a further lack of unity within one of the inventions found initially ("a posteriori"), no further invitation to pay additional fees is issued and the international search is limited to the first invention of each further invention for which an additional fee was paid. If a cascading lack of unity of invention is likely to arise, the invitation to pay additional fees will contain a warning in that respect.

## ***Consequences of non-payment of additional fee(s)***

- 3.3.018** The lack of an ISR and WO-ISA in respect of those parts of the international application for which no additional search fee was paid does not, of itself, have any influence on the validity of the international application. However, the national law of any designated Office may provide that the non-searched parts are considered withdrawn unless a special fee is paid. For further information see the national chapter for the designated Office concerned in the WIPO PCT Guide.

*Art. 17(3)(b) PCT  
WIPO PCT Guide  
7.021*



**3.3.019** If the EPO is ISA, non-payment of an additional search fee has the following important consequences in the further procedures before the EPO:

- the EPO as IPEA will not perform the international preliminary examination in respect of any claims relating to an invention for which no additional search fee was paid and, therefore, for which no ISR was established (see point 4.2.037) *R. 66.1(e) PCT*
- upon entry into the European phase the EPO as designated Office will consider whether the application, which in the meantime may have been amended by the applicant, meets the requirement of unity of invention. If not, the examining division will invite the applicant to pay, within a period of two months, one or more further search fees in respect of any unsearched inventions claimed upon entry into the European phase in order for these to be covered by a further search (see points 5.15.011 ff). *R. 164 EPC  
OJ 2014, A70  
GL/EPO C-III, 2.3*

### **Protest procedure**

**3.3.020** An applicant may pay an additional search fee under "protest". This means that at the time of payment of the additional fee(s) the applicant objects to the finding of lack of unity in a written reasoned statement filed with the EPO as ISA. Such objections may concern the finding of non-unity as such or the number of the required additional fees. The lodging of a protest does not delay the search itself. *R. 40.2(c), (e) PCT  
R. 158(3) EPC  
OJ 2010, 322  
OJ 2015, A59*

**3.3.021** According to the **protest procedure** as set out in Rule 40.2 PCT, the only body examining a protest before the EPO as ISA is a review panel consisting of three members, one of whom chairs the panel and another of whom is the examiner who was responsible for issuing the invitation to pay additional fees.

**3.3.022** Where additional fees are paid under protest and the protest fee is duly paid, the protest will be referred to the review panel for a decision in first and last resort. If the review panel finds that the protest was entirely justified, the additional fees and the protest fee will be refunded. If the review panel finds that the protest was justified only in part, the corresponding additional fees will be refunded, but not the protest fee. The findings of the review panel will be taken into account when establishing the ISR and WO-ISA.

## 3.4 Supplementary International Search (SIS)

### General

- 3.4.001** In its capacity as Authority specified for supplementary search, hereafter referred to as the Supplementary International Searching Authority or SISA, the EPO will carry out a supplementary international search (SIS) at the applicant's request, except for applications where it has already acted as ISA.
- R. 45bis PCT  
Agreement EPO-  
WIPO, Annex B  
OJ 2017, A115  
OJ 2018, A24, A35  
WIPO PCT Guide  
8.001-8.053  
PCT Newsletter  
4/2011, 9  
1/2012, 10  
9/2016, 8*
- 3.4.002** The purpose of the SIS is to provide the applicant with a supplementary international search report (SISR) in addition to the search carried out under Article 15 PCT by the competent ISA ("main search") (see point 3.2.005). In particular, in view of the growing linguistic diversity of the prior art and considering the language knowledge available in the EPO, a SISR established by the EPO can be very useful to applicants.
- 3.4.003** Since the SISR is established within 28 months from the priority date, it may improve the basis for deciding on national phase entry and, in particular where a SISR is drawn up by the EPO, on whether or not to enter the European phase. The SIS reduces the risk of an applicant being faced with relevant prior art only after incurring considerable expenditure for entry into the national/regional phase.
- 3.4.004** In the procedure before the EPO as SISA, no separate written opinion is established. However, the EPO will provide explanations in an annex to the SISR ("Scope Annex") which are equivalent to the information contained in a written opinion established by the EPO as ISA (WO-ISA) (see point 3.2.007).
- 3.4.005** If the EPO has acted as SISA and established a SISR, in principle, **no supplementary European search report will be drawn up in the European phase**. Further, the applicant will be invited in a communication under Rule 161 EPC to correct any deficiencies set out in the Scope Annex to the SISR upon entry into the European phase (see point 5.4.025).
- Art. 153(7) EPC  
R. 161, 164 EPC  
OJ 2009, 594  
OJ 2014, A70*

### What is the scope of the SIS?

- 3.4.006** The scope of the search conducted by the EPO as SISA, i.e. the documentation searched, is the same as for any international search carried out by the EPO as ISA (see point 3.2.002).
- 3.4.007** The SIS is conducted on the international application as originally filed, and neither amendments filed under Article 19 and/or 34 PCT nor informal comments will be taken into account.
- R. 45bis.5(b) PCT*

- 3.4.008** If the ISR is available at the time the SIS is carried out, it will be taken into account. Prior-art documents mentioned in the ISR are re-cited in the SISR only if the EPO qualifies their relevance differently.
- 3.4.009** The EPO conducts a maximum of 700 supplementary searches per year.
- 3.4.010** The **limitations related to subject-matter** set out in Annex C to the Agreement EPO-WIPO apply both where the EPO acts as ISA and where it acts as SISA (see points 3.3.005 ff). The same applies as to any other reason for non-establishment of a (full) search, i.e. complex applications, missing sequence listings and non-unity (see points 3.3.001 ff). As to particulars of the procedure in case of a missing sequence listing and non-unity, please refer to points 3.4.014 and 3.4.018.
- 3.4.011** Furthermore, the EPO acting as SISA may decide not to carry out a search on claims that were not searched by the ISA. However, if the EPO would have searched those claims had it been the ISA, it will search them as SISA.

*R. 45bis.5(c), (d),  
(e) PCT*

#### **What are the requirements for a SIS request?**

- 3.4.012** A SIS request must be filed **with the IB** within 22 months from the priority date. The request is valid only if the supplementary search fee and the supplementary search handling fee are validly paid **to the IB** in Swiss francs.
- 3.4.013** If the application was not filed in English, French or German, and no **translation** into any of these languages has been filed for the purpose of the proceedings before the ISA or for the purpose of international publication, a translation into one of these languages must be filed with the IB together with the SIS request.
- 3.4.014** Where applicable, the applicant must, together with the SIS request, also furnish **to the IB** a copy of the **sequence listing** in an electronic format complying with the standard provided for in Annex C to the Administrative Instructions (see points 3.3.011 ff). The EPO will start the supplementary international search only upon receipt of that copy. If it is **not** received, the EPO will invite the applicant to furnish an electronic copy of the sequence listing complying with that Annex and to pay a late furnishing fee.

*R. 45bis.2 and .3  
PCT  
Official Notices (PCT  
Gazette) –  
8 February 2018  
OJ 2018, A101  
R. 45bis.1(b)(iii) PCT*

*R. 13ter, 45bis.5  
PCT  
Agreement  
EPO-WIPO, Annex B  
OJ 2013, 542  
OJ 2017, A115  
OJ 2018, A24, A35*

#### **Who may represent the applicant before the EPO as SISA?**

- 3.4.015** Applicants may be represented before the EPO as SISA by the agent appointed on filing the international application and having the right to practise before the receiving Office, i.e. the agent for the international phase (see points 1.9.002 ff).
- 3.4.016** An applicant may also appoint an agent to represent him **specifically before the EPO in its capacity as SISA**. Moreover, the agent appointed for the international phase - and thus including for the procedure before the SISA - may appoint a sub-

*Art. 49 PCT  
R. 83.1, 90.1(a), (b),  
(b-bis), (d) PCT*

agent to represent the applicant specifically before the EPO as SISA. All communications issued by the EPO as SISA are sent to the agent specifically appointed for the procedure before the EPO as SISA. An agent specifically appointed to act before the EPO as SISA must be entitled to practise before the EPO (see point 2.9.002).

- 3.4.017** The requirements in respect of filing a separate power of attorney or a copy of a general power of attorney have been waived by the EPO as SISA (see point 2.9.014).

### **Lack of unity of invention**

- 3.4.018** If the EPO as SISA is of the opinion that the international application claims more than one invention, it will state the reasons for its finding and perform a search only for those parts of the application relating to the main invention, i.e. the invention first mentioned in the claims. If, however, the ISA has already raised a non-unity objection and the applicant has, upon filing the SIS request, specified for which invention identified in the ISR the SISR is to be drawn up, the EPO as SISA:

*R. 45bis.1(d),  
45bis.6 PCT  
OJ 2010, 322  
OJ 2015, A59*

- will restrict its search to that invention, if it agrees with the finding of the ISA;
- will take the applicant's wish into account as far as possible, if the non-unity objection made by the ISA is not followed, but a different non-unity objection is found;
- will perform a full search if it considers the requirement of unity of invention to be met.

- 3.4.019** In the case of a non-unity finding by the EPO as SISA, the applicant cannot pay additional search fees to obtain further searches as in the procedure before the ISA (see point 3.3.013). However, within one month of the date of mailing of the SISR, the applicant may request a review of a non-unity finding. He also has to pay the review fee set by the EPO within the same time limit, direct to the EPO. If the review panel considers the lack of unity objection (partly) justified, a revised SISR taking into account the outcome of the review procedure is established.

- 3.4.020** Upon entry into the European phase, the EPO as designated/elected Office will consider whether the application for which it acted as SISA, and which meanwhile may have been amended, meets the requirement of unity of invention and whether protection is sought for an invention covered by the SISR. If not, the examining division will invite the applicant to pay, within a period of two months, one or more further search fees in respect of any unsearched inventions claimed upon entry into the European phase in order for these to be covered by a further search (see points 5.15.011 ff).

*R. 164 EPC  
OJ 2014, A70  
GL/EPO C-III, 2.3*

## Chapter 4 – The EPO as an International Preliminary Examining Authority (IPEA) - PCT Chapter II

### 4.1 General

#### What is the aim of the international preliminary examination?

**4.1.001** In its capacity as IPEA the EPO will carry out an international preliminary examination on condition that the applicant has (validly) filed a "demand" and paid the fees due. The usefulness of this optional procedure depends on the international application concerned and, especially, on the result of the international search (see points 3.2.005 ff). A demand under PCT Chapter II may, in particular, be useful in order to overcome objections raised in the WO-ISA and possibly receive a positive IPER at the end of the PCT Chapter II procedure. However, before taking a decision whether to file a demand with the EPO as IPEA, applicants are strongly recommended to take special note of the information set out in points 4.1.006 ff.

**4.1.002** The purpose of the international preliminary examination under Chapter II of the PCT is not grant or refusal of a patent, but provision of a preliminary and non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable as defined in Article 33 PCT. The statement whether these criteria are satisfied is set out in the International Preliminary Report on Patentability ("IPRP Chapter II") established by the IPEA.

*Art. 35 PCT  
R. 64, 65, 67-70 PCT  
WIPO PCT Guide  
10.001-10.003  
OJ 2003, 574  
OJ 2011, 532  
PCT Newsletter  
9/2018, 13*

**4.1.003** While there is not a fully uniform approach to the criteria for patentability in the national laws of the PCT contracting states, their application during international preliminary examination is such that IPRP Chapter II provides the applicant with a good basis on which to evaluate the chances of obtaining patents in the procedures before the various designated Offices in the national phase.

**4.1.004** The term "IPRP Chapter II" is no more than a different name for the international preliminary examination report (IPER). Both terms refer to the same document, i.e. the report established by the competent IPEA containing the result of the international preliminary examination carried out by it. In the following the term IPER will be used.

*R. 70.15(b) PCT*

**4.1.005** As set out above, the applicant may react to the ISR and WO-ISA established by the ISA by filing amendments under Article 19 PCT and/or "informal comments" with the IB, and/or by filing a demand for international preliminary examination (see points 4.1.020 ff). Should the applicant decide to file a demand for international preliminary examination, the demand form together with

amendments and/or arguments under Article 34 PCT are to be filed directly with the competent IPEA (see points 4.1.023 ff).

### **When is it useful to file a demand for international preliminary examination?**

- 4.1.006** Regardless of whether a demand is filed, applicants will receive a preliminary non-binding written opinion on the patentability of their claimed invention (WO-ISA, IPRP Chapter I) as part of the international search procedure (see points 3.2.005 ff). Therefore, the usefulness of the optional international preliminary examination under Chapter II PCT must be considered carefully for each international application. *PCT Newsletter 4/2010, 8 5/2010, 8*
- 4.1.007** International preliminary examination will, in general, have no added value unless amendments and/or arguments under Article 34 PCT are filed. In the absence of such amendments and/or arguments there will be no reason for the EPO as IPEA to come to a different conclusion to that which it reached in its capacity as ISA, as set out in the WO-ISA.
- 4.1.008** If the ISA has provided the applicant with a declaration under Article 17(2) PCT that no ISR has been established ("declaration of no search"), filing a demand is not recommended, since the EPO as IPEA will not examine claims for which no ISR has been established (see point 4.2.027).
- 4.1.009** It follows that filing a demand for international preliminary examination is, in general, useful only if the WO-ISA was "negative" and the applicant is of the opinion that his amendments and/or arguments filed for the purpose of the PCT Chapter II procedure may lead to a "positive" IPER. In other words, international preliminary examination gives the applicant the opportunity to respond to any negative finding of the ISA during the international phase, as opposed to drafting and filing multiple responses with the national/regional offices where national phase entry is made. In the Chapter II procedure before the EPO the applicant will have the opportunity to interact with the examiner and file further amendments should objections still persist after the reply to the WO-ISA (see point 4.2.017).
- 4.1.010** An advantage of using the EPO as IPEA is that a "top-up" search is performed in order to reveal any further relevant prior-art documents, in particular intermediate prior art, which have been published or have become available to the IPEA after the international search report was established (see points 4.2.009 ff). *R. 66.1ter PCT OJ 2014, A57*

### **Patent Prosecution Highway (PPH) based on an IPER established by the EPO as IPEA**

- 4.1.011** The PPH enables an applicant whose claims have been determined to be patentable/allowable to have a corresponding application that has been filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results. *OJ 2016, A44, A54, A75, A106 OJ 2017, A5, A47, A67, A77, A96, A107-A110*



**4.1.012** Under the PPH pilot programme at the EPO, a PPH request filed with one of the other IP5 offices, i.e. CNIPA, JPO, KIPO and USPTO, or with one of the offices with which the EPO has launched bilateral PPH pilot programmes, i.e. CIPO (Canada), ILPO (Israel), IMPI (Mexico), IPOS (Singapore), IPA (Australia), SIC (Colombia), ROSPATENT (Russia), IPOPHL (Philippines), MyIPO (Malaysia) and EAPO (Eurasian Patent Office), can also be based on an IPER established by the EPO as IPEA (see point 3.2.032).

**4.1.013** Irrespective of the PPH pilot programme any applicant may request accelerated examination under the PACE programme in the procedure before the EPO as **elected Office** at any time. For more information on the PACE programme reference is made to chapter E (see points 5.1.037 ff).

*OJ 2010, 352  
OJ 2015, A93*

### **When is the EPO competent to act as IPEA?**

**4.1.014** Although the EPO's competence as an IPEA is in principle **universal**, i.e. not restricted to international applications from e.g. EPC contracting states, restrictions of various nature do limit its competence (see points 4.1.015 ff). In particular it is stressed that the EPO is competent to act as IPEA only if a "European ISA" (including the EPO itself) carried out the international search (see point 4.1.017).

*Art. 32 PCT  
R. 59.1 PCT  
WIPO PCT Guide  
10.006  
PCT Newsletter  
6/2013, 9*

### **Specification by the receiving Office**

**4.1.015** The EPO acts as an IPEA for any application, **on condition that the receiving Office with which the international application was filed has specified the EPO as IPEA**. The same countries which have not (yet) specified the EPO as ISA have not (yet) specified the EPO as IPEA (see point 3.1.008). Up-to-date information is available in the annexes to the WIPO PCT Guide (see point 1.3.002).

*Art. 32 PCT  
Agreement EPO-  
WIPO, Art. 3(2), (3)  
OJ 2017, A115  
OJ 2018, A24, A35*

**4.1.016** Where the international application was filed with the IB, the EPO is competent as IPEA if the international application could have been filed with a receiving Office which has specified the EPO as IPEA.

### **The EPO or a European ISA acted as ISA**

**4.1.017** The EPO will, however, only act as an IPEA if the international search was also carried out by the EPO or by the Austrian, Finnish, Spanish, Swedish or Turkish patent office or the Nordic Patent Institute or the Visegrad Patent Institute. Applicants considering their choice of ISA (PCT request form Box No. VII) are advised to bear this in mind (see also point 3.1.012).

*Agreement EPO-  
WIPO, Art. 3(2),  
Annex A(i)  
OJ 2017, A115  
OJ 2018, A24, A35*

### ***Is it possible to choose between different IPEAs?***

- 4.1.018** Where several IPEAs are competent in relation to a particular application, the applicant may choose. Here, it should be considered that where the EPO as IPEA has drawn up the IPER the examination fee due in the European phase is reduced by 75% if the subject-matter to be examined is covered by the IPER (see point 5.10.009).

*R. 35.2, 59.1 PCT  
Art. 14(2) RFees  
PCT Newsletter  
5/2018, 1*

### ***Lifting of the competence limitation***

- 4.1.019** As a result of an amendment to the Agreement between the EPO and WIPO under the PCT, any national or resident of the USA filing an international application on or after 1 January 2015 with the USPTO or the IB as receiving Office can select the EPO as IPEA, irrespective of the technical field in which the application is classified. It should, however, be noted that the Notice from the EPO dated 1 October 2007 concerning business methods remains applicable.

*OJ 2007, 592  
OJ 2010, 304  
OJ 2014, A117  
OJ 2017, A115  
OJ 2018, A24, A35*

### **Who may file a demand for international preliminary examination with the EPO?**

- 4.1.020** **Sole** applicants must have their residence in, or be a national of, a PCT contracting state bound by PCT Chapter II. If there are **two or more applicants**, at least one of them must meet this requirement. Secondly, the international application must have been filed with a receiving Office of or acting for a PCT contracting state bound by PCT Chapter II.

*Art. 31(2)(a) PCT  
R. 18.1, 54.1, 54.2  
PCT  
Art. 152 EPC  
WIPO PCT Guide  
10.004, 10.017*

- 4.1.021** At 1 January 2019, all PCT contracting states were bound by Chapter II and, therefore, these requirements do not stand in the way of any applicant wishing to file a demand for a pending international application.

### **How and where is the demand for international preliminary examination to be filed?**

- 4.1.022** The demand for international preliminary examination must be made using the prescribed form (PCT/IPEA/401), downloaded from the WIPO website,<sup>28</sup> copies of which are also available free of charge from all receiving Offices, the IB and the EPO.
- 4.1.023** The demand and any further document relating to the Chapter II procedure (e.g. amendments and/or arguments filed under Article 34 PCT) **must be submitted to the EPO as IPEA and not to the receiving Office or the IB**. The EPO as IPEA will indicate the date of receipt on the demand and promptly notify the applicant of that date.

*Art. 31(3) PCT  
R. 53 PCT  
WIPO PCT Guide  
10.012*

*Art. 31(6) PCT  
R. 59.3, 61 PCT  
WIPO PCT Guide  
10.006*

<sup>28</sup> [www.wipo.int/export/sites/www/pct/en/forms/demand/ed\\_demand.pdf](http://www.wipo.int/export/sites/www/pct/en/forms/demand/ed_demand.pdf)



- 4.1.024** The demand may be filed with the EPO as IPEA direct, by post, by fax or online (see points 2.2.003-2.2.033). As of 1 November 2016, the ePCT service may be used for online filing of the demand under PCT Chapter II directly with the EPO as IPEA, and also for indicating the payment of fees related to the demand.

*OJ 2014, A71  
OJ 2016, A78*

## ACTIONS

Select Action

- Amendments Under Article 19 (text format only)
- Create Power of Attorney
- Declarations under Rule 4.17
- Licensing Availability Request
- Make international application available to DAS
- Observations on close prior art
- Obtain priority document from DAS
- Online Payment
- Prepare and submit indications relating to biological material (R0/134)
- Request for Early Publication
- Rule 92bis change request
- Submit Chapter II Demand**
- Translation for international publication
- Upload Documents
- Withdraw Chapter II Demand
- Withdraw Designation[s]
- Withdraw Election[s]
- Withdraw International Application
- Withdraw Priority Claim[s]

- 4.1.025** If the demand is filed by fax, no written confirmation needs to be filed unless the applicant is invited by the EPO as IPEA to do so (see point 2.2.033).
- 4.1.026** The EPO filing offices are located in the Central European Time (CET) zone.

*R. 92.4(e), (g) PCT  
OJ 2007, Spec.Ed.3,  
A.3 (Art. 3 and 7 of  
the Decision)*

### **When should the demand for international preliminary examination be filed with the EPO?**

- 4.1.027** Pursuant to Rule 54*bis* PCT, the demand may be validly submitted at any time prior to expiry of whichever of the following periods expires later:
- three months from the date of transmittal to the applicant of the ISR and WO-ISA by the ISA, or
  - 22 months from the (earliest) priority date.

*WIPO PCT Guide  
10.010*

- 4.1.028** This time limit guarantees that the applicant has at least three months from the date of mailing of the ISR to decide on the basis of the result of the international search laid down in the ISR and the WO-ISA whether he wants to file a demand with amendments and/or arguments.

**4.1.029** If the demand is submitted after expiry of this time limit, the demand is considered as if it had **not been submitted**. *R. 54bis.1(b) PCT*

**4.1.030** The applicant should be aware that the possibilities to withdraw a demand and obtain a refund of the fee paid are limited (see point 4.1.063). *R. 90bis.4 PCT*

### **When does the international preliminary examination start?**

**4.1.031** The EPO as IPEA will not start examination before expiry of the time limit laid down in Rule 54bis PCT, unless the applicant expressly requests an earlier start under Rule 69.1(a) PCT on Form PCT/IPEA/401.<sup>29</sup> Amendments and/or arguments under Article 34 PCT filed after filing of the demand, but before expiry of this time limit, must always be taken into account for international preliminary examination (see point 4.2.003). *R. 66.1, 66.4bis, 69.1(a) PCT  
WIPO PCT Guide 10.051  
PCT Newsletter 3/2005, 8*

**4.1.032** Where the WO-ISA is considered a first written opinion (see point 4.2.016), a single extension of one month for filing a reply (amendments and/or arguments under Article 34 PCT) is in principle granted if requested before expiry of the normal time limit under Rule 54bis PCT and on condition that the time limit so extended does not expire later than 25 months from the (earliest) priority date (see also point 4.2.025). **The extension does not apply to the time limit for filing the demand, which cannot be extended.** *Art. 34(2)(c) PCT*

### **Delaying of national phase until expiry of 30 months**

**4.1.033** Most contracting states apply Article 22 PCT as amended with effect from 1 April 2002. For these states, the 30/31-month time limit for entry into the national/regional phase applies regardless of whether the applicant has submitted the demand for international preliminary examination within 19 months from the (earliest) priority date.

**4.1.034** The EPO too applies Article 22 PCT as amended with effect from 1 April 2002. Therefore, the time limit for entry into the European phase is always 31 months from the priority date (see points 5.1.010 ff). *R. 159(1) EPC*

<sup>29</sup> Revised Rule 69.1(a) PCT will enter into force as of 1 July 2019. According to this provision, the EPO acting as IPEA will start the international preliminary examination as soon as it is in possession of the following:

- the demand for international preliminary examination;
- payment of the relevant fees;
- either the ISR or the declaration by the ISA under Article 17(2)(a) PCT; and
- the written opinion established under Rule 43bis.1 PCT,

unless the applicant expressly requests postponement until expiry of the applicable time limit under Rule 54bis.1(a) PCT (see PCT Newsletter 10/2018, 1).

- 4.1.035** However, in respect of a small number of designated Offices, old Article 22(1) PCT still applies. The list of the contracting states for which that provision is still applicable is published on the WIPO website (see point 1.3.005). According to the latest information from WIPO available on 9 June 2017, the 20/21-month time limit applies to the following states: Luxembourg (LU) and United Republic of Tanzania (TZ). However, in respect of the **regional** designation of each of these states, the time limit under amended Article 22 PCT applies.<sup>30</sup>
- 4.1.036** Therefore, if an applicant wants to enter the **national** phase for these states, the demand must be received by the competent IPEA within 19 months from the (earliest) priority date to secure the right to entry into the national phase being delayed until expiry of 30/31 months from the priority date.
- 4.1.037** Moreover, for these states, the applicant must respect the 19-month time limit even where the ISR and the WO-ISA are not yet available. In other words, a delay in the international search does not have as a consequence that the 19-month time limit is changed, since this time limit is exclusively calculated on the basis of the (earliest) priority date.
- 4.1.038** For states applying the old Article 22(1) PCT, a demand filed with the EPO after expiry of 19 months from the priority date but prior to:
- three months from the date of transmittal to the applicant of the ISR and the written opinion (WO-ISA) by the ISA, or
  - 22 months from the (earliest) priority date
- is valid, but does not have the effect of postponing commencement of the national phase to 30/31 months for the states in question (see point 4.1.035).

#### **By when will the EPO establish the IPER?**

- 4.1.039** Where the documents required for the preliminary examination were received in due time, the EPO as IPEA will establish the IPER usually within 28 months from the earliest priority date.

*R. 69.2 PCT*

#### **Is a translation of the international application required?**

- 4.1.040** If neither the language in which the international application was filed nor the language in which the application was published is one of the **official languages of the EPO** (English, French or German), the applicant must within the time limit for filing the demand also file a translation in one of these languages with the EPO as IPEA.

*R. 55.2 PCT*  
*OJ 1993, 540*  
*WIPO PCT Guide*  
10.011

<sup>30</sup> [www.wipo.int/pct/en/texts/time\\_limits.html](http://www.wipo.int/pct/en/texts/time_limits.html)

**4.1.041** This situation occurs, for instance, if the international application was filed in Spanish, and the Spanish patent office acted as ISA. However, if the international application was filed in Spanish but the EPO acted as ISA, the applicant need not furnish a translation to the EPO as IPEA because the international preliminary examination will be carried out on the basis of the translation already furnished for the purposes of international search (see point 3.1.015).

**4.1.042** Any amendments to be taken into account for the international preliminary examination must be submitted in the language of proceedings before the EPO as IPEA. If they are initially not submitted in that language, the applicant must file a translation.

*R. 55.3 PCT  
WIPO PCT Guide  
10.055*

### ***Applications filed in Dutch***

**4.1.043** If the EPO is IPEA for an international application originally filed in Dutch with the Netherlands Patent Office as receiving Office, the applicant need not file a translation of the international application since the EPO as IPEA will use the published version of the international application as received from the IB. It should be noted that the demand and amendments under Article 34 PCT must be submitted to the EPO as IPEA in the language of the international publication (see points 3.1.019 and 4.1.042).

*R. 12.4, 55.1,  
55.2(a) PCT  
Agreement EPO-  
WIPO, Annex A(i)  
OJ 2010, 304  
OJ 2014, A117  
OJ 2017, A115  
OJ 2018, A24, A35*

### **In which language should the demand be filed?**

**4.1.044** The demand must be filed in the language in which the international application was filed, except in the following situations:

*R. 48.3, 55.1 PCT*

- If the international application was filed in a language other than the language in which it was published, the demand must be filed in the language of publication (e.g. application filed in Dutch, see point 4.1.043).
- If a translation of the application has to be filed with the EPO as IPEA (see points 4.1.040-4.1.042), the demand must be filed in the language of that translation (e.g. application filed in Spanish, see point 4.1.041).

### ***Language of further correspondence***

**4.1.045** Any other correspondence with the EPO as IPEA may be in any of the EPO's three official languages with the exception of amendments to the application, which are to be filed in the same language as the demand (see point 4.1.042).

*R. 92.2(b) PCT  
R. 3 EPC  
OJ 1993, 540*

### **Who may represent the applicant before the EPO as IPEA?**

**4.1.046** Applicants may be represented before the EPO as IPEA by the agent appointed on filing the international application and having the right to practise before the receiving Office, i.e. the agent for

*Art. 49 PCT  
R. 90.1(c), (d) PCT  
WIPO PCT Guide  
10.019-10.023*

the international phase (see point 1.9.002). The applicant may also appoint an agent to represent him **specifically** before the EPO as IPEA. Moreover, the agent appointed for the international phase may appoint a sub-agent to represent the applicant specifically before the EPO as IPEA.

- 4.1.047** Any agent specifically appointed before the EPO as IPEA must be **entitled to practise before the EPO**. It is strongly recommended that applicants who do not have their residence or place of business in one of the EPC contracting states appoint an agent entitled to practise before the EPO for the proceedings before the EPO as IPEA (see points 2.9.002 ff). *R. 90.1(c) PCT  
Art. 134 EPC*
- 4.1.048** The appointment of an agent specifically before the EPO as IPEA can be done by the applicant or the agent for the international phase either by completing Box No. III of the PCT demand form (PCT/IPEA/401) and signing the demand, or by signing and submitting a separate power of attorney. Appointment may also be effected by reference in the demand or in a separate notice to a correctly deposited general power of attorney, of which a copy must be submitted. In that case, the demand or the separate notice may be signed by the purported agent. *R. 90.4, 90.5 PCT*
- 4.1.049** The EPO as IPEA has waived the requirement that a signed separate power of attorney or a copy of a general power of attorney be submitted to it if the demand is signed by the purported agent for the procedure before the EPO as IPEA and not by the applicant or the agent for the international phase. *R. 90.4(d), 90.5(c) PCT  
OJ 2010, 335*
- 4.1.050** An exception to the waiver applies where the demand is signed by an agent who is not the agent of record, both agents do not belong to the same office and the new agent is not appointed in addition to the agent appointed earlier but appointed under revocation of any earlier appointment (PCT/IPEA/401, Box III, second check box). In that situation a separate power of attorney signed by the applicant or the agent of record, or a copy of a general power of attorney, is to be furnished. A further exception applies in any other case where the EPO is in doubt as to the person entitled to act for the application concerned. For this reason, it is recommended that (common) agents and common representatives obtain explicit authorisation from (all) the applicant(s) by way of direct signature of the PCT demand or by duly signed powers of attorney.

### **Which states may be elected?**

- 4.1.051** The filing of the demand constitutes the election of all PCT contracting states designated in the international application and bound by PCT Chapter II for a national and where possible a regional patent at the same time (see point 4.1.021). If after filing the PCT request the applicant has validly withdrawn a designation, the filing of the demand cannot constitute the election of that state. *Art. 31(4) PCT  
R. 53.7 PCT  
WIPO PCT Guide  
10.005, 10.029*

## Who has to sign the demand?

- 4.1.052** The demand must be signed by the applicant or, if there is more than one applicant, by all applicants. If the signature of one or more applicants is missing, the EPO as IPEA will not invite the applicant(s) to furnish the missing signature(s) provided that at least one of the applicants has signed the demand (see point 4.1.065). *R. 53.2(b), 53.8, 60.1(a-ter), 90.3 PCT WIPO PCT Guide 10.031-10.032*
- 4.1.053** A (common) agent or common representative may sign the demand on behalf of the applicant(s) who appointed him (see points 2.9.009 ff).
- 4.1.054** Where the demand is signed by a (common) agent the EPO as IPEA will not invite the applicant(s) to file a (separate) power of attorney - if not already on file - or a copy of a general power of attorney since the EPO has waived these requirements (see points 2.9.014 ff). *R. 90.4, 90.5 PCT OJ 2010, 335*

## What fees are due for the international preliminary examination?

- 4.1.055** For international preliminary examination, the handling fee and the preliminary examination fee must be paid **direct** to the EPO as IPEA. The preliminary examination fee is set by the EPO. The handling fee is provided for in the Schedule of Fees under the PCT which is published by the IB. *Art. 31(5) PCT R. 57.3, 58 PCT WIPO PCT Guide 10.035 -10.043*
- 4.1.056** Both fees have to be paid within **one month** of the date on which the demand was submitted or within 22 months from the priority date, whichever time limit expires later. The amounts of the handling fee and the preliminary examination fee to be paid shall be the amounts applicable on the date of payment.
- 4.1.057** Applicants are urged to use the **Fee Calculation Sheet** annexed to the demand form (PCT/IPEA/401). For the payment methods currently accepted by the EPO, see point 2.24.011.

## Fee reductions

- 4.1.058** The **handling fee** is reduced by 90% under the same conditions as for the **international filing fee** (see point 2.24.014).
- 4.1.059** The fee for **international preliminary examination** is reduced by 75% under the same conditions as for the reduction of the **international search fee** (see point 3.1.024). *Agreement EPO-WIPO, Annex D-II OJ 2017, A28, A115 OJ 2018, A24, A35 PCT Newsletter 7-8/2016, 5*

## Consequences of non- or late payment of fees

- 4.1.060** Applicants should avoid late or incomplete payment of the handling and international preliminary examination fee (see points 4.1.055 ff), since the EPO cannot commence international preliminary examination before these fees have been paid. Late payment thus reduces the amount of time available for establishment of the IPER. *WIPO PCT Guide 10.047*



**4.1.061** Where the EPO as IPEA finds that the amount paid to it is insufficient to cover the handling fee and the international preliminary examination fee or that no fees were paid by the time they were due, the EPO as IPEA invites the applicant to pay to it the amount required to cover both fees together with the late-payment fee within one month of the date of the invitation. If the applicant complies with the invitation within the specified time limit, payment is deemed to have been made in due time. The late-payment fee is 50% of the amount of the unpaid fees as specified in the invitation. However, it is at least equal to but not more than double the amount of the handling fee.

*R. 58bis PCT  
OJ 1998, 282  
OJ 2018, A37*

**4.1.062** **If the applicant does not comply with the invitation, the demand is deemed not to have been submitted** and no IPER will be established. The absence of a validly filed demand has no consequence for the procedure before the EPO as designated Office, because the time limit to be respected for entry into the European phase is in any case 31 months from the priority date (see point 5.1.010).

#### ***Refund of the fee for international preliminary examination***

**4.1.063** Where the international application or the demand for international preliminary examination is withdrawn **before** examination has commenced and within 30 months from the priority date, the fee for international preliminary examination is refunded in full. It is also refunded in full if the demand is deemed not to have been submitted or the fee was paid by mistake. Any amount paid in excess of the amount due is likewise refunded.

*R. 58.3, 90bis.4 PCT  
Agreement EPO-  
WIPO, Annex D-II  
OJ 2017, A28, A115  
OJ 2018, A24, A35*

#### **Is it possible to correct defects in the demand?**

**4.1.064** If the demand does not comply with the requirements, the EPO as IPEA invites the applicant to correct the defects within one month of the date of the invitation. If the applicant complies with the time limit, the demand is deemed to have been received on the actual filing date, provided that the demand as submitted sufficiently identified the international application. If the applicant does not comply with the invitation in due time, the demand is deemed not to have been submitted.

*R. 60.1 PCT  
WIPO PCT Guide  
10.047-10.050*

**4.1.065** Where there is more than one applicant, a frequent defect concerns failure to provide the required indications and/or the signatures of all the applicants. However, if the required indications are available in respect of one of the applicants entitled to file a demand and the demand is signed by one of them, this is considered sufficient and no invitation will be issued (see point 4.1.052).

*R. 53, 60.1(a-bis),  
60.1(a-ter) PCT*

## 4.2 The international preliminary examination procedure before the EPO as an IPEA

### Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements

- 4.2.001** The applicant must indicate in Box No. IV of the demand form (PCT/IPEA/401) whether the international preliminary examination is to be based on the international application

*R. 53.9, 66.1, 66.5, 70.2(a), (c) PCT  
WIPO PCT Guide  
10.025, 10.061*

– as (originally) filed,

or whether it should take account of

- amendments to the claims under Article 19 PCT, and/or
- amendments to the claims, the description and/or the drawings under Article 34(2)(b) PCT.

The EPO acting as IPEA does not accept claims in the form of auxiliary requests, since this is not provided for under the PCT.

### **Amendments**

- 4.2.002** If amendments under Article 19 PCT are to be taken into account, the applicant must enclose a copy of these with the demand.

- 4.2.003** Amendments and/or arguments filed under Article 34 PCT should preferably be filed together with the demand. However, they also have to be taken into account by the EPO as IPEA if they are filed before expiry of the time limit for filing the demand (see point 4.1.031). Subsequently filed amendments and/or arguments will only be taken into account by the EPO as IPEA if they are received before the point at which preparation of a written opinion or the IPER has actually started. Moreover, if a second written opinion is established (see point 4.2.017), subsequently filed amendments and/or arguments will be taken into account together with the reply to the second written opinion. Amendments and/or arguments not taken into account by the EPO as IPEA may be (re-)filed with the elected Offices upon entry into the national phase.

*R. 66.1(b), 66.4bis  
PCT  
OJ 2011, 532  
WIPO PCT Guide  
10.024, 10.028*

- 4.2.004** If the EPO acted as ISA, the EPO as IPEA will consider the WO-ISA as a first written opinion for the purposes of international preliminary examination and, as a rule, commence the international preliminary examination immediately after expiry of the time limit for filing the demand (see points 4.2.021 ff). Therefore, it is important that amendments and/or arguments under Article 34 PCT are filed in due time.

*R. 66.1bis(b) PCT*

- 4.2.005** Applicants must make sure that none of the amendments go beyond the disclosure in the international application as originally filed. Note that if an amendment contains a negative limitation, e.g. a "disclaimer", the EPO as IPEA in accordance with the discretion provided for in the ISPE Guidelines applies the same approach as

*R. 66.8(a) PCT  
GL/ISPE 20.21*



in respect of a Euro-direct application (see the Annex to this Guide). Further, applicants must indicate in an accompanying letter

- the differences between the application as originally filed and any amendments made,
- the basis for the amendments in the application as filed, and
- the reasons for any such amendments.

**4.2.006** If the basis for any amendment is not indicated as required, the EPO will establish the written opinion and/or IPER as if no amendments had been filed and without first issuing a reminder. *R. 70.2(c-bis) PCT*

**4.2.007** If amendments to the claims are filed a complete set of the claims in replacement of all claims originally filed must be submitted. *R. 66.8(c) PCT*

#### ***Incorporation by reference of missing parts and elements***

**4.2.008** If the receiving Office has granted a request for incorporation by reference under Rules 4.18 and 20.6 PCT but the EPO as IPEA does not consider the relevant part(s) and/or element(s) completely contained in the priority application, it will indicate so in the IPER (see points 2.4.001 ff). *R. 4.18, 20.6 PCT*

#### **Top-up search**

**4.2.009** The EPO as IPEA performs a top-up search in Chapter II in order to reveal any further relevant prior-art documents, in particular intermediate prior art, which have been published or have become available to the IPEA after the international search report was established. *R. 66.1ter PCT  
OJ 2014, A57*

**4.2.010** Any relevant documents found during the top-up search will be indicated in the IPER.

**4.2.011** A top-up search does not normally extend beyond the subject-matter searched by the ISA as set out in Rule 66.1ter PCT. It is performed in respect of all applications undergoing Chapter II examination, apart from in exceptional cases where the examiner considers that performing a top-up search would serve no useful purpose.

**4.2.012** The top-up search is normally performed at the start of Chapter II examination. However, in the case of non-unity where there is more than one invention claimed in the documents for which examination under Chapter II is demanded, the examiner first issues an invitation to pay further examination fees and then performs the top-up search for all inventions for which further examination fees have been paid, provided that any such inventions are not excluded from preliminary examination by the examiner under Rule 66.1(e) PCT.

**4.2.013** The top-up search is based on the application documents available at the start of Chapter II examination. However, in the special case that the application is amended but the basis for the amendments could not be found and/or there is no letter explaining their basis in the description, the top-up search may be limited to the scope of the claims forming the basis of the IPER. *R. 70.2(c), (c-bis) PCT*

**4.2.014** If relevant documents are found during the top-up search which give rise to objections as to patentability, the EPO as IPEA issues a second WO along the lines set out under point 4.2.017.

### **Is it possible to submit third-party observations?**

**4.2.015** Since 1 July 2012 third parties may file observations on a PCT application during the international phase until 28 months from the priority date. Such observations are to be submitted using the online tool provided by WIPO and may be filed anonymously. If third-party observations are received, WIPO will inform the applicant and the applicant is permitted to reply. If the IPER has not yet been established at the time when observations or any reply are received, WIPO will forward the observations and the reply to the EPO acting as IPEA, which will take the observations into account when establishing the second written opinion, if it has not yet been established, and the IPER. Detailed information is contained in a guide entitled "ePCT Third Party Observations", published by WIPO.<sup>31</sup> *AI, Part 8*

### **Procedure before the EPO as IPEA when it also acted as ISA**

#### ***First written opinion***

**4.2.016** A written opinion for the purposes of international preliminary examination is a notification issued by the IPEA which indicates any comments or objections concerning the international application. Pursuant to Rule 66.1bis(a) PCT the WO-ISA is considered to be a (first) written opinion of the IPEA for the purposes of international preliminary examination. The EPO has notified the International Bureau under Rule 66.1bis(b) PCT that this provision is only applied by the EPO as IPEA to the extent that the WO-ISA has been established by the EPO acting as ISA. *Art. 33, 34, 35 PCT  
R. 66.2, 66.3, 66.4  
PCT  
OJ 2003, 574  
WIPO PCT Guide  
10.064-10.066*

#### ***Second written opinion***

**4.2.017** Before issuing a "negative" IPER, the EPO as IPEA will, as a rule, issue a second written opinion, thereby providing the applicant with a further opportunity to submit amendments and/or arguments to overcome any objections raised therein. A request for a second written opinion need not be filed. A second written opinion will be issued on condition that the applicant filed in due time a *OJ 2011, 532*

<sup>31</sup> [www.wipo.int/pct/en/epct/pdf/epct\\_observations.pdf](http://www.wipo.int/pct/en/epct/pdf/epct_observations.pdf)

substantive reply either to the WO-ISA established by the EPO or to the first written opinion established by the EPO as IPEA. The procedure may be different and a second written opinion may not necessarily be issued if a request for consultation by telephone is filed by the applicant (see points 4.2.031 ff). In this context the term "negative" IPER is to be understood as an IPER informing the applicant of a deficiency to which he must respond under Rule 161(1) EPC if he decides to enter the European phase (see points 5.4.025 ff). If the IPER contains no objections or only minor objections which do not hinder a direct grant in the European phase, the IPER is considered positive.

#### **Procedure before the EPO as IPEA when it did not act as ISA**

- 4.2.018** If the EPO acts as IPEA but did not establish the WO-ISA because the international search was conducted by one of the other European ISAs (see point 3.1.012), the WO-ISA established by any such ISA is not considered a (first) written opinion of the EPO as IPEA (see point 4.2.016). In these cases, the EPO in its function as IPEA will issue a first written opinion if it has any objections. The applicant may respond to this written opinion by filing amendments and/or arguments within the time limit set therein. *OJ 2011, 532  
R. 66.1(b) PCT*
- 4.2.019** In this case a second written opinion will be issued on condition that the applicant has filed amendments and/or arguments to overcome any objections raised in the first written opinion and that there remain objections outstanding such that the IPER would be negative if it were to be issued on the basis of the file as it stands.

#### **International preliminary examination before the EPO: four scenarios**

- 4.2.020** For ease of understanding, the procedure before the EPO as IPEA can be summarised in four scenarios:

##### ***First case: The EPO acted as ISA and made no objections***

- 4.2.021** If the WO-ISA established by the EPO as ISA contains **no objections** to the international application ("positive WO-ISA"), the EPO as IPEA will consider the WO-ISA as the first written opinion for the purposes of international preliminary examination (see point 4.2.016). The EPO as IPEA will in this case use its discretion in proceeding to issue the IPER immediately after expiry of the time limit for filing the demand. Therefore, with the exception of the top-up search, the IPER will have no added value over the information provided in the WO-ISA, unless the applicant files amendments and/or arguments for the EPO to take into account as IPEA. *Art. 34(2)(c) PCT*

### ***Second case: The EPO acted as ISA and made objections***

- 4.2.022** If the WO-ISA established by the EPO as ISA contained **objections** to the international application ("negative WO-ISA"), the EPO as IPEA will consider the WO-ISA as the first written opinion for the purposes of international preliminary examination (see point 4.2.016). The WO-ISA will not, however, be reissued as a first written opinion of the EPO as IPEA. A second written opinion will be issued on condition that the applicant has filed amendments and/or arguments in reply to the WO-ISA which must be taken into account for international preliminary examination and that there remain objections outstanding such that the IPER would be negative if it were to be issued on the basis of the file as it stands.

*R. 66.1bis, 66.4, 66.4bis PCT*

### ***Third case: The EPO did not act as ISA and the EPO as IPEA has no objections***

- 4.2.023** If the WO-ISA was issued by an ISA other than the EPO, the WO-ISA is not considered to be the first written opinion of the EPO as IPEA (see point 4.2.016). However, if the EPO as IPEA has no objections to the (amended) application for which preliminary examination has been requested, it may proceed to issue the IPER immediately after expiry of the time limit for filing the demand (see point 4.1.027).

*Art. 34(2)(c) PCT*

### ***Fourth case: The EPO did not act as ISA and the EPO as IPEA has objections***

- 4.2.024** If the WO-ISA was issued by another ISA, the WO-ISA is not considered to be the first written opinion of the EPO as IPEA (see point 4.2.018). If the EPO as IPEA has objections to the application for which preliminary examination has been requested, it will issue a first written opinion. The applicant may respond to this written opinion by filing amendments and/or arguments within the time limit set therein. A second written opinion will be issued on condition that the applicant has filed amendments and/or arguments to overcome any objections raised in the first written opinion and that there remain objections outstanding such that the IPER would be negative if it were to be issued on the basis of the file as it stands.

*R. 66.1bis, 66.2, 66.4, 66.4bis PCT*

### ***What is the time limit for replying to the written opinion?***

- 4.2.025** The time limit for the reply to the first written opinion issued by the EPO as IPEA is usually two months but may be extended to a maximum of three months at the applicant's request. Such a request must be filed before expiry of the two-month time limit set. An extension will only be granted if the extended time limit does not expire later than 25 months from the priority date. An extension of the time limit may also be requested if the WO-ISA is considered to be the first written opinion of the EPO as IPEA (see point 4.2.016). The time limit for the reply to the second written

*R. 66.2(d)(e), 69.2 PCT  
OJ 2011, 532*

opinion or, as the case may be, to the invitation accompanying the minutes of a telephone consultation is normally two months and not shorter than one month unless the applicant has agreed to a shorter time limit.

#### **Will the EPO take any SIS into account?**

- 4.2.026** The EPO as IPEA will take into account any SISR (only) if it is available at the time the international preliminary examination is performed. A further written opinion will be issued before the IPER is established in the exceptional case that the contents of the SISR would change the EPO's opinion as set out in the WO-ISA established by the EPO as ISA. *R. 45bis.8(c) PCT*

#### **Can the EPO refuse to perform preliminary examination?**

- 4.2.027** The EPO as IPEA will not perform an international preliminary examination on any claim for which no international search was performed (see point 3.3.002). In this context it is not relevant whether the applicant files amendments and/or arguments that, allegedly, overcome the reasons for the decision of the ISA not to search the claims concerned. *Art. 17(2)(a) PCT  
R. 66.1(e),  
66.2(a)(vi) PCT*
- 4.2.028** Further, the EPO as IPEA will make use of its discretion not to carry out preliminary examination if the application relates to subject-matter listed in Rule 67 PCT to the extent that such subject-matter is not regarded as an invention or susceptible of industrial application or is excluded from patentability under the provisions of the EPC. *Art. 34(4) PCT  
Agreement EPO-  
WIPO, Art. 4  
OJ 2007, 592  
OJ 2017, A115*
- 4.2.029** Also, if the application fails to comply with the prescribed requirements to such an extent that no meaningful opinion can be formed on novelty, inventive step or industrial applicability, no preliminary opinion on these questions will be established.

#### **Is it possible to request consultation by telephone?**

- 4.2.030** Since the issues to be discussed must be clear, a request for personal communication will not be granted before the applicant has submitted amendments and/or arguments which are to be taken into account by the EPO as IPEA. A request for personal communication may be granted by the EPO acting as IPEA only once and only in the form of consultation by telephone. *Art. 34(2)(a) PCT  
R. 66.6 PCT  
OJ 2011, 532  
WIPO PCT Guide  
10.067*
- 4.2.031** If the applicant files a request for consultation by telephone before a second written opinion is issued, he will be sent the minutes of the telephone consultation together with an invitation to submit further amendments and/or arguments within the time limit set for reply therein. In such a case, no second written opinion will be issued.
- 4.2.032** If the applicant requests a consultation by telephone and/or a second written opinion before a second written opinion is issued, the discretion to decide whether to consult the applicant by

telephone or to establish a second written opinion is left to the EPO as IPEA.

- 4.2.033** If the applicant files a request for consultation by telephone after a second written opinion has been issued but before the date on which the IPER is established, the minutes of the telephone consultation are sent to the applicant but will not be accompanied by an invitation to submit further amendments and/or arguments, and none will be accepted unless agreed upon during the consultation by telephone.

### **Nucleotide and amino acid sequences**

- 4.2.034** If the ISR was not drawn up in full or in part because the sequence listing was not available to the ISA in electronic form in the specified format (see point 3.3.012), this may affect the procedure under Chapter II PCT.

*R. 13ter.2, 66.1(e)  
PCT  
OJ 2011, 372  
OJ 2013, 542  
PCT Newsletter  
6/2018, 11*

- 4.2.035** If no sequence listing in electronic form complying with the requirements is available to the EPO as IPEA, the applicant may be invited to furnish that sequence listing in the required form and format and to pay the late furnishing fee.

- 4.2.036** If no (full) international search was carried out, the EPO as IPEA will not perform the international preliminary examination if a meaningful examination cannot be performed (see point 4.2.027). In such cases an invitation to file a sequence listing under Rule 13ter.2 PCT is not issued by the EPO as IPEA and applicants are advised not to file sequence listings at this late stage.

### **Unity of invention**

- 4.2.037** Where the EPO as IPEA considers that the international application lacks unity of invention, it will invite the applicant either to restrict the claims in order to meet this requirement or, to the extent that the inventions have been searched, to pay additional preliminary examination fees.

*Art. 34(3) PCT  
R. 68.2, 68.3 PCT  
R. 158(2) EPC*

- 4.2.038** If the applicant fulfils the requirements for reduction of the preliminary examination fee, any additional fee is validly paid upon payment of the reduced sum (see point 4.1.059).

- 4.2.039** If the applicant does not pay any additional preliminary examination fee the EPO establishes the IPER on the basis of the result already communicated.

- 4.2.040** If the applicant pays one or more additional preliminary examination fee(s) within the time limit set, those parts of the application for which additional fees have been paid will also be examined. Consequently the IPER will be established for all inventions for which a fee for preliminary examination has been paid.



- 4.2.041** The applicant may pay any additional fee under protest in accordance with Rule 68.3(c) PCT. The protest procedure is the same as before the EPO as ISA (see points 3.3.020 ff). *R. 158(3) EPC  
OJ 2010, 322  
OJ 2015, A59*
- 4.2.042** Where applicable, the EPO as IPEA will base the examination on the results of the protest procedure, if available, before establishment of the IPER.
- 4.2.043** Claims relating to inventions in respect of which no international search report has been established will not be the subject of international preliminary examination by the EPO as IPEA (see point 4.2.027). *R. 66.1(e) PCT*

#### **What must be done after receipt of the IPER?**

- 4.2.044** The IPER is transmitted to the applicant and the IB. The applicant then has no further opportunity to submit comments to the EPO as IPEA. He must now decide on the basis of the results of the international preliminary examination as laid down in the IPER whether he wishes to pursue the international application further by entering the national/regional phase before the elected Offices. *Art. 36, 39 PCT  
R. 71.1 PCT*
- 4.2.045** If the EPO acted as IPEA, the applicant will, where appropriate, be invited to correct any deficiencies set out in the IPER ("negative IPER") upon entry into the European phase (see points 5.4.025 ff). *R. 161 EPC  
GL/EPO E-IX, 3.2*
- 4.2.046** All (further) questions relating to the **European phase** - the procedure before the **EPO as a designated or elected Office** - are dealt with in detail in chapter E.

#### **Confidentiality of the international preliminary examination**

- 4.2.047** The IB and the EPO as IPEA may not allow access to the file of the international preliminary examination to third parties without authorisation by the applicant. *Art. 36(3), 38 PCT  
R. 73.2, 94.1(c),  
94.3 PCT  
Art. 128 EPC  
OJ 1999, 329  
OJ 2003, 382  
OJ 2007, Spec.Ed.3,  
J.2, J.3  
WIPO PCT Guide  
10.003, 10.080,  
10.081*
- 4.2.048** Once the IPER has been established and transmitted to the IB, the latter sends a copy of the IPER to each elected Office. As from that time, the IB also furnishes copies of the IPER on request to any person on behalf of the EPO as IPEA.
- 4.2.049** Furthermore, after completion of the IPER the EPO as **elected Office** allows access to the file of the international preliminary examination in accordance with the provisions of the EPC.



## Chapter 5 – Euro-PCT procedure before the EPO as a designated (PCT Chapter I) or elected (PCT Chapter II) Office

### 5.1 General

**5.1.001** Before the end of the international phase the applicant must decide whether and where he wants to proceed with the international application in the national/regional phase before the designated/elected Offices.

**5.1.002** If the applicant wishes to obtain a European patent he must enter what is known as "the European phase", which means that he must fulfil the requirements (see points 5.2.001 ff) for initiating the processing of his application by the EPO as designated or elected Office in due time (see point 5.1.010).

#### **When is the EPO a designated or elected Office?**

**5.1.003** If an applicant enters the European phase without having requested international preliminary examination under Chapter II, the EPO will act as a "designated Office" (see points 5.1.004 ff). However, if before entering the European phase the application was processed under Chapter II PCT, the EPO will act in the European phase as an "elected Office" (see points 5.1.007 ff).

*Art. 2(xiii) and (xiv)  
PCT  
Art. 153(1) EPC  
GL/EPO E-IX, 2*

#### **When can the EPO act as designated Office?**

**5.1.004** Since all EPC contracting states are PCT contracting states, the EPO can act as a designated Office for any EPC contracting state, provided the international application was filed on or after the date on which the EPC entered into force for the state concerned (see point 1.8.001).

**5.1.005** If this requirement is not met, it may be that an extension or validation agreement between the EPO and a PCT contracting state was in force on the international filing date that provides for the extension or validation of a European patent application or a European patent to or in the state for which patent protection is sought (see points 2.11.001 ff).

**5.1.006** Furthermore, a European patent for any EPC contracting state can be obtained only if neither the application nor the (automatic) designation of the state concerned for a European patent during the international phase has been (deemed) withdrawn.

*R. 90bis.1 and .2  
PCT*

#### **When can the EPO act as elected Office?**

**5.1.007** For the EPO as an elected Office, the same requirements apply as for the EPO acting as a designated Office (see points 5.1.004-5.1.006). In addition, however, at least one of the EPC contracting

states must have been elected for a European patent in the demand for international preliminary examination. Since the filing of the demand constitutes the election of all PCT contracting states that were designated for, where possible, a national and a regional patent, this requirement will automatically be met in respect of each state that was an EPC contracting state at the international filing date, unless the applicant has withdrawn such election in the meantime (see points 1.8.001, 4.1.051).

### **When must the applicant decide on the territorial scope of protection sought for the European patent?**

**5.1.008** Upon entry into the European phase the applicant must pay the designation fee (see point 5.8.001). Payment of this fee confirms the designation of all EPC contracting states that were designated on the international filing date for a European patent (see points 1.8.001, 2.10.001 ff).

*R. 159(1)(d) EPC  
Art. 2(1)3 RFees*

**5.1.009** Within the time limit for payment of the designation fee, the applicant must decide on the extension or validation states for which he seeks extension or validation of the European patent and must pay the due fee (see points 2.11.001 ff, 5.8.009 ff). This fee is to be paid for each extension or validation, and no flat fee applies.

### **When must the European phase be initiated before the EPO as designated or elected Office?**

**5.1.010** If, after considering the ISR and WO-ISA (see points 3.2.023 ff) and, where applicable, the result of the international preliminary examination as laid down in the IPER (see points 4.2.044 ff) and/or a supplementary international search (see points 3.4.001 ff), an applicant decides to pursue his international application further before the EPO as designated/elected Office, he must comply with the requirements for entry into the European phase **within 31 months** from the filing date or, if priority has been claimed, from the earliest priority date.

*Art. 22(1)(3),  
39(1)(a)(b) PCT  
R. 159(1) EPC*

**5.1.011** The time limit for complying with the requirements for entry into the European phase thus extends by one month beyond the standard time limit of 30 months provided for in Articles 22(1) and 39(1)(a) PCT and applies irrespective of whether or not a demand for international preliminary examination was filed (see points 4.1.033-4.1.034).

**5.1.012** If the 31-month time limit expires on a day on which one of the filing offices of the EPO is not open for receipt of documents, the period is extended to the first day thereafter on which all filing offices are open for receipt of documents and on which mail is delivered.

*R. 80.5 PCT  
R. 134 EPC*

**5.1.013** If the applicant does not comply with the requirements for entry into the European phase within the 31-month time limit, the Euro-PCT application is, as a rule, deemed to be withdrawn (see point 5.2.003).

*Art. 24(1)(iii), 39(2)  
PCT  
R. 160 EPC*

## **What is the language of the proceedings in the European phase?**

- 5.1.014** The language of the proceedings is one of the official languages of the EPO (English, French and German). If the international application was published by WIPO (see point 3.2.021) in an official language of the EPO, that language is the language of the proceedings in the European phase. If not, the EPO official language of the translation to be submitted upon entry into the European phase is the language of the proceedings (see points 5.5.001 ff).
- 5.1.015** The EPO does not allow the language of the proceedings to be changed. Reference is made to decision G 4/08 of the Enlarged Board of Appeal.

*Art. 14(1), 14(3),  
153(4) EPC  
R. 159(1)(a) EPC*

*OJ 2010, 572*

## **How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?**

- 5.1.016** For entry into the European phase, applicants are strongly recommended to use the latest version of Form 1200.
- 5.1.017** Form 1200 may be filed electronically using EPO Online Filing (OLF), the EPO case management system (CMS) or the EPO Web-Form Filing service. The (basic part of the) filing fee is reduced if Form 1200 is filed online (see point 5.7.003).<sup>32</sup>
- 5.1.018** The form may also be filed on paper and can be downloaded from the EPO website.<sup>33</sup> Applicants are advised to read the explanatory notes carefully before completing the form.
- 5.1.019** The form must be filed with the EPO direct. It should not be sent either to the IB or to an authority of an EPC contracting state competent to receive European patent applications.
- 5.1.020** If filed in paper form, either by post or by fax, only one copy of the document must be submitted. If the form is filed by fax, a confirmation copy must be filed only on invitation by the EPO.
- 5.1.021** The IB sends to the EPO as designated/elected Office a copy of the international application and the ISR (including the WO-ISA) and, where applicable, also the IPER with annexes. The IB will notify the applicant thereof, and the applicant himself should not file any of these documents with the EPO (see point 5.2.007). However, the applicant may have to file a translation of the international application and further documents as set out below (see points 5.5.001 ff).

*Art. 22, 39 PCT  
R. 49.4 PCT  
OJ 2017, A59  
OJ 2018, A45, A46,  
A80  
Art. 2(1)1 RFees*

*OJ 2017, A11, A12*

*OJ 2007, Spec.  
Ed.3, A.3*

*Art. 20, 36(3) PCT  
R. 47.1(c), 73 PCT  
PCT Newsletter  
11/2013, 9*

<sup>32</sup> [www.epo.org/applying/online-services.html](http://www.epo.org/applying/online-services.html)

<sup>33</sup> [www.epo.org/applying/forms.html](http://www.epo.org/applying/forms.html)

- 5.1.022** Applicants must indicate the European application number, which as a rule is communicated to them approximately ten months after international publication (EPO Form 1201). Applicants who have not yet been notified of this number when performing the required steps for entry into the European phase may instead cite the PCT application number or the PCT publication number.

### **Can the applicant request early processing?**

- 5.1.023** An applicant can request the EPO as designated or elected Office to commence processing the Euro-PCT application at any time before expiry of the 31-month time limit. *Art. 23(2), 40(2) PCT  
R. 159 EPC  
OJ 2013, 156  
OJ 2015, A94  
GL/EPO E-IX, 2.8  
OJ 2017, A74*
- 5.1.024** For this purpose, the applicant must file an **express request for early processing** under Article 23(2) or 40(2) PCT. Section 12.1 of Form 1200 includes a check box for this purpose. However, the request is effective only if the applicant also fulfils the requirements for entry into the European phase **as if the 31-month time limit provided for in Rule 159(1) EPC expired on the date he requests early processing.**
- 5.1.025** This means that, for an application to be processed early, the following requirements must be complied with: payment of the filing fee (see point 5.7.001), including any page fees (see points 5.7.004 ff), filing of the translation (where applicable; see point 5.5.001), specification of the application documents on which the proceedings before the EPO as designated or elected Office are to be based (see point 5.4.001) and payment of the search fee (where applicable; see point 5.9.016). Which further requirements must be complied with depends on the date on which early processing is requested, i.e. on whether the time limits for paying the designation fee (Rule 39(1) EPC) and the renewal fee (Rule 51(1) EPC) and for filing the request for examination and paying the examination fee (Rule 70(1) EPC) have already expired at that date (see points 5.8.001, 5.11.001 ff and 5.10.001 ff). The term "necessary requirements" is used to refer to the requirements that must be complied with for a request for early processing of the application concerned to be effective.
- 5.1.026** Where applicable, the certificate of exhibition must also be filed on entry into the European phase (see point 5.12.004). However, if this requirement is not met, this will not prevent the request for early processing from being effective, but it will affect the prior art that the EPO takes into account in the procedure. *Art. 55(2) EPC  
R. 159(1)(h) EPC  
GL/EPO B-VI, 5.5*
- 5.1.027** Claims fees for any claims in excess of fifteen need only be paid before expiry of the period under Rule 162(2) EPC. Therefore, their payment is not a requirement for a request for early processing to be effective.

**5.1.028** Since 1 November 2017, fees which need to be paid for a request for early processing to be effective may also be paid by **automatic debit order**. However, applicants should bear in mind that automatic debiting can only be performed if the EPO can establish whether or not a page fee needs to be included as part of the filing fee. This is only possible if the EPO has access to the documents referred to in Article 20 PCT, i.e. if:

- the international application has already been published at the time the request for early processing is received,
- the EPO is the receiving Office, or
- the EPO is acting as (S)ISA or IPEA.

If none of the above documents is available to the EPO on the day the request for early processing is filed, applicants should choose another means of payment. Otherwise the fees due will be debited on the date of receipt of the documents referred to in Article 20 PCT from the International Bureau under Rule 47.4 PCT. In this case, the date on which the request for early processing takes effect will be postponed to that date (see point 5.1.029).<sup>34</sup>

**5.1.029** If on the date the request for early processing is filed all necessary requirements (see point 5.1.025) are complied with, the request for early processing is effective as from that date and the application will be processed in the same way as any "regular" Euro-PCT application which has entered the European phase. This means, for instance, that the EPO as designated/elected Office will issue the communication under Rule 161/162 EPC directly after it has established that the request for early processing is effective (see point 5.4.012) and on condition that the international search report has already been established. Furthermore, as from the date the request for early processing is effective, the applicant may file a divisional application (see point 5.18.001).

**5.1.030** If on the date the request for early processing is filed any necessary requirement (see point 5.2.005) is not complied with, the request for early processing will not be effective on the date of receipt of the request but only as from the earliest date thereafter on which all requirements necessary on that date have been complied with (see point 5.1.025). It is only on the latter date that the application enters the European phase. From that moment on it is processed as if the 31-month time limit had already expired, i.e. in the same way as any "regular" Euro-PCT application which has entered the European phase.

**5.1.031** If the requirements for a request for early processing to be effective are not complied with before expiry of the 31-month time limit, the EPO as designated/elected Office cannot start processing the application until that time limit has expired.

<sup>34</sup> See Notice from the EPO dated 27 September 2017 concerning revision of the Arrangements for deposit accounts and their annexes, point II.2, OJ 2017, Supplementary publication 5, 2.

**5.1.032** From the date the applicant's request for early processing is effective, any subsequent withdrawal under Rule 90bis PCT will have no effect in respect of the procedure in the European phase.

*R. 90bis.6(a) PCT*

**5.1.033** Note that if early processing is requested because the applicant wishes not only the processing of the application before the EPO as designated/elected Office but also the examination of the application to start, he must have filed a valid request for examination (including payment of the examination fee) under Article 94 EPC, even if the time limit under Rule 70(1) EPC has not yet expired at the date of effective entry into the European phase, since examination will be taken up only if a request for examination has been validly filed.

**5.1.034** Furthermore, if a request for examination is filed before the EPO has, where applicable, sent the supplementary European search report to the applicant, examination will start only upon receipt of an indication from the applicant that he wishes to proceed further with the application and, if required, a response to the extended European search report. The applicant may waive his right to be asked whether he wishes to proceed further. He can indicate this by ticking the second check box in Section 12.2 of Form 1200.

*R. 70(2), 70a(2) EPC  
OJ 2015, A94*

**Euro-PCT(1200E2K) - Draft - Euro-PCT**

**EP Phase** **Names** **States** **Biological Material** **Documents** **Fee Payment** **Ar**

**Entry into the European Phase**

☒ EPO as designated office  
☐ EPO as elected office

Examination of the application under Article 94 EPC is hereby requested. The examination fee is being (has been)

☐ Request for examination in an admissible non-EPO language

☐ The/Each applicant hereby declares that he is an entity or a natural person under Rule 6(4) EPC.

**Acceleration of procedure**

☐ Early processing of the application pursuant to Article 23(2) / 40(2) PCT is hereby requested ("early entry in")

☒ The applicant waives his right to be asked under Rule 70(2) EPC whether he wishes to proceed further with

☐ The applicant waives his right to the communication under Rules 161(1) or (2) and 162 EPC.

**Past Record**

The language of the international publication is: English

Procedural Language: English

PCT Application Number: PCT/US2018/123456

PCT Publication Number: WO \_\_\_\_\_

EP Application Number: EP \_\_\_\_\_

International Filing Date: 1 March 2018

International Searching Authority (ISA): US United States Patent and Trade

International Preliminary Examining Authority (IPEA): ☐ IPEA other than EPO ☒ IPEA is EPO

4 2 8

**5.1.035** If the EPO acts as **designated** Office and the IB has not yet transmitted to it a copy of the international application, the ISR and the WO-ISA, the applicant may but does **not** have to file with the IB a request to do so. If needed, the EPO will take care of this itself.

*Art. 20 PCT  
R. 44bis.2(b),  
47.4 PCT*



- 5.1.036** The same applies if the EPO acts as **elected** Office and the IB has not yet transmitted to it a copy of the international application, the ISR, the WO-ISA and the IPER with its annexes. *Art. 36(3)(a) PCT  
R. 61.2(d), 73.2(b)  
PCT*

### **Accelerated prosecution of applications - the "PACE" programme**

- 5.1.037** An effective request for early processing causes prosecution of the application by the EPO as designated/elected Office to be taken up before expiry of the 31-month time limit. However, the request for early processing does not lead to accelerated prosecution. Therefore, the applicant may also want to request accelerated prosecution of his application in the European phase. For this purpose, a separate request under the PACE programme is to be submitted online upon entry into the European phase or later (EPO Form 1005). Depending on the time when the request is submitted and the indications made in the form, accelerated prosecution may cover the establishment of the supplementary European search report, where such a report is to be drawn up (see points 5.9.001 ff), or substantive examination. A PACE request may be filed only once for each stage of the procedure. This means that, for a Euro-PCT application for which a supplementary European search is carried out, a request for accelerated **examination** cannot be filed on entry into the European phase but only after the applicant has declared that he wishes to proceed further to examination (Rule 70(2), 70a(2) EPC; see points 5.9.012-5.9.013). *OJ 2015, A93  
GL/EPO E-VIII, 4*

### **Combined PACE request and waiver of Rule 161/162 communication**

- 5.1.038** If a PACE request has been filed, the EPO will also have to respect the six-month time limit provided for in Rules 161 and 162 EPC and will therefore not be able to start supplementary European search or examination before expiry of that time limit (see point 5.4.011). For this reason an applicant interested in acceleration of the procedure may consider waiving his right to the Rule 161/162 communication. This can be done by ticking the first check box in Section 12.2 of EPO Form 1200. The further details are set out below (see point 5.4.017). For the waiver to be effective, any claims fees should not be paid by automatic debit order as they will then be debited (and thus considered paid) on the last day of the six-month period under Rule 162(2) EPC. Instead, they should be paid within the 31-month time limit for entry into the European phase. *OJ 2015, A94*



## 5.2 What are the requirements for entry into the European phase?

### Which steps have to be taken for entry into the European phase?

- 5.2.001** The process generally referred to as "entry into the European phase" is not an act in itself but may be described as a series of "steps" to be taken or, in other words, as a bundle of requirements to be fulfilled within 31 months from the international filing date or, where applicable, the earliest priority date claimed for the international application ("31-month time limit"). Which requirements are to be fulfilled within the 31-month time limit depends to a certain extent on the particular case.
- 5.2.002** Some requirements must be fulfilled in every case, such as payment of the filing fee (point 5.7.001) and specification of the documents on which processing in the European phase is to be based (points 5.4.001 ff). Further, as a rule, the designation fee is due and the request for examination must be filed at expiry of the 31-month time limit for entry into the European phase, unless the ISR was published extremely late (see points 5.8.001, 5.10.004). However, the filing of a translation, for instance, is required only if the international application was not published in an official language of the EPO (points 5.5.001 ff). This means that for each application the applicant must verify which requirements are to be fulfilled within the 31-month time limit.
- 5.2.003** If the applicant does not fulfil all requirements that must be met within the 31-month time limit, in many cases - depending on exactly which requirement was not met - the effect is that the application is deemed to be withdrawn as from the date of expiry of that time limit. A loss of rights may be remedied, but only if the strict requirements under which a remedy applies are fulfilled in due time. If not, the application is irreversibly lost. Each of the requirements will be discussed in detail below (see points 5.2.005 ff).
- 5.2.004** All requirements in respect of which non-timely compliance results in a loss of rights (directly) upon expiry of the 31-month time limit are listed in Rule 159 EPC. In view of that legal effect they are usually referred to as "minimum requirements" for entry into the European phase.

*Art. 24(1)(iii),  
39(2) PCT  
Art. 121,  
122 EPC  
R. 135, 136,  
160, 163(6) EPC*

### What are the minimum requirements?

- 5.2.005** In order to initiate the European phase the applicant must take **at least the following steps within 31 months from** the filing date or, if priority has been claimed, from the earliest priority date:
- supply the **translation** if the Euro-PCT application was not published in one of the EPO's official languages (see points 5.5.001 ff),

*R. 159 EPC*

*Art. 153(4) EPC  
R. 159(1)(a) EPC*

- **specify the application documents** on which the European grant procedure is to be based (see points 5.4.001 ff), *R. 159(1)(b) EPC*
- pay the **filing fee** provided for in Article 78(2) EPC, including an additional page fee for applications with more than 35 pages (see points 5.7.001 ff), *R. 159(1)(c) EPC*
- pay the **designation fee** (and any extension or validation fees) if the period under Rule 39 EPC has expired earlier (see points 5.8.001 ff), *R. 159(1)(d) EPC*
- pay the **search fee** if a supplementary European search report is to be drawn up (see points 5.9.016 ff), *Art. 153(7) EPC*  
*R. 159(1)(e) EPC*
- file the **request for examination** and pay the **examination fee** if the period under Rule 70(1) EPC has expired earlier (see points 5.10.001 ff), *R. 159(1)(f) EPC*
- pay the **renewal fee** for the third year if the period under Rule 51(1) EPC has expired earlier (see points 5.11.001 ff), *R. 159(1)(g) EPC*
- where applicable (in rare cases), file the certificate of exhibition mentioned in Article 55(2) EPC (see points 5.12.004 ff). *R. 159(1)(h) EPC*

### What further requirements need to be considered?

**5.2.006** Besides the "minimum requirements" mentioned in point 5.2.005, the applicant may have to complete one or more of the following steps within the 31-month time limit. These further requirements are not referred to as "minimum requirements" since failure to comply with them does not have the direct effect of a loss of rights (see point 5.2.003).

These further requirements are:

- pay any claims fees due (see points 5.11.004 ff), *R. 162 EPC*
- file the designation of the inventor (see points 5.12.001 ff), *R. 163(1) EPC*
- furnish the file number or the certified copy of the application(s) of which priority is claimed (see points 5.13.004 ff), *R. 163(2) EPC*
- furnish a sequence listing complying with the standard (see point 5.6.006), *R. 163(3) EPC*
- furnish the indications on the applicant mentioned in Rule 163(4) EPC in respect of any applicant (see points 5.12.001 ff), *R. 163(4) EPC*
- appoint a professional representative (see point 5.3.005), *R. 163(5) EPC*
- furnish a copy of the results of any search carried out by or on behalf of the authority with which the priority application was filed (see points 5.4.005 ff). *R. 141(1) EPC*

- 5.2.007** The EPO is sent the copy of the international application required under Article 22(1) or 39(1) PCT by the IB before expiry of the 31-month time limit. Therefore, the applicant should not submit a copy of the application to the EPO. *Art. 20, 22(1), 39(1) PCT*
- 5.2.008** If amendments have been made under Article 19 PCT (see points 3.2.024 ff), the copy transmitted by the IB also includes these amendments and the applicant's statement thereon, if any. *Art. 19(1), 20(2) PCT*

### **Amounts of fees to be paid in the European phase**

- 5.2.009** The amounts of all fees that may be due on entry into the European phase or thereafter are listed in the current version of the Rules relating to Fees (RFees) and the Schedule of fees and expenses of the EPO, which is published as a supplement to the Official Journal and can be found on the EPO website in the section "Fees – Fee payments and refunds".<sup>35</sup> Guidance for the payment of fees and expenses is published in each issue of the Official Journal.
- 5.2.010** All fees to be paid on entry into the European phase are to be paid to the EPO in euro. The bank account opened in the name of the EPO and information on the different options to make a valid payment, for instance via a deposit account held with the EPO, can be found in each issue of the Official Journal and on the EPO website in the section "Fees – Fee payments and refunds".<sup>36</sup> *OJ 2014, A75  
OJ 2017, A100  
OJ 2017, Suppl. Publ. 5  
OJ 2018, Suppl. Publ. 2*
- 5.2.011** Applicants having a deposit account may also make use of the automatic debiting procedure in respect of any fee that must be paid within the 31-month time limit and thereafter. If an automatic debit order is filed in due time, any fee which must be paid within the 31-month time limit will be debited on the last day of that time limit. As from 1 December 2017, the EPO has moved to "online-only" management of users' deposit accounts. This means that debit orders must be filed in an electronically processable format (XML), either using one of the accepted electronic means of filing (e.g. EPO Form 1200E) or via Online Fee Payment in Online services.<sup>37</sup> This also applies to the filing of an automatic debit order. For more information on deposit accounts and the automatic debiting procedure, reference is made to the "Arrangements for deposit accounts (ADA) and their annexes", published in OJ 2017, Supplementary publication 5. *OJ 2017, Suppl. Publ. 5  
PCT Newsletter 12/2017, 14, 6/2018, 10*
- 5.2.012** As of 1 December 2017, fees due to the EPO may be paid by credit card. For conditions and further information, reference is made to the Decision of the President of the EPO dated 22 August 2017 as published in the Official Journal. *OJ 2017, A72, A73*
- 5.2.013** Please note that payment of fees in cash or by cheque is not possible.

<sup>35</sup> [www.epo.org/applying/fees.html](http://www.epo.org/applying/fees.html)

<sup>36</sup> [www.epo.org/applying/fees/payment.html](http://www.epo.org/applying/fees/payment.html)

<sup>37</sup> [www.epo.org/applying/online-services/fee-payment.html#tab1](http://www.epo.org/applying/online-services/fee-payment.html#tab1)

### 5.3 Communication with the applicant – representation – address for correspondence (Form 1200, Sections 1, 2 and 3)

**5.3.001** The EPO will issue any communication only to the applicant or, where applicable, the professional representative. Accordingly, any procedural action will be accepted by the EPO only if it is undertaken by the applicant or, on his behalf, by the (appointed) professional representative. An exception applies in respect of fees, which can be validly paid to the EPO by a third party.

**5.3.002** If an applicant has not appointed a professional representative and is not obliged to do so (see point 5.3.005), he may indicate an address for correspondence to which the EPO will send its communications if all requirements are met. This applies irrespective of whether the applicant is a natural or a legal person.

**5.3.003** The address for correspondence indicated for the proceedings in the European phase must be the applicant's own address and must be located in an EPC contracting state.

*OJ 2014, A99*

**5.3.004** Please note that an address for correspondence which is acceptable for the procedure in the international phase (see point 2.9.013) does not necessarily comply with the requirements applicable in the European phase.

**Requirements specific to applicants with neither residence nor principal place of business in an EPC contracting state - "non-resident applicants"**

- 5.3.005** Applicants having neither their residence nor their principal place of business within the territory of one of the EPC contracting states ("non-resident applicants") must be represented by a professional representative and act through him in all proceedings established by the EPC.<sup>38</sup> In such cases a professional representative must be appointed in due time.
- Art. 27(7) PCT  
Art. 133(2), 134 EPC  
GL/EPO A-III, 2.1  
GL/EPO A-VIII, 1  
GL/EPO E-IX, 2.3.1*
- 5.3.006** Two categories of professional representative have the right to practise before the EPO:
- any professional representative entered in the directory of professional representatives maintained by the EPO, and
  - any legal practitioner who is qualified to practise in patent matters in one of the EPC contracting states and has his place of business in that state.
- 5.3.007** However, up to expiry of the 31-month time limit under Rule 159 EPC, non-resident applicants may either comply with any requirement **themselves** or act through a professional representative entitled to practise before the EPO. This means that a non-resident applicant may himself, within the 31-month time limit, for example sign and file EPO Form 1200, submit amendments, file a translation of the application, file a request for early processing, etc.
- 5.3.008** Non-resident applicants who did **not** themselves take the **required** steps for entry into the European phase **within the 31-month time limit** may subsequently perform these and the other procedural steps (e.g. filing of a request for re-establishment of rights) **only through a professional representative entitled to practise before the EPO**.
- 5.3.009** The only exception to the rule that after expiry of the 31-month time limit non-resident applicants must act in the procedure before the EPO as designated/elected Office through a professional representative is that payments to the EPO can be validly made by anybody.
- GL/EPO A-X, 1*
- 5.3.010** Under no circumstances can an applicant act through his agent appointed for the international phase if the latter is not a professional representative entitled to practise before the EPO (see point 5.3.006). Further, if such representative is the appointed agent for the international phase, he is not automatically appointed for the European phase. A separate appointment is necessary (see point 2.9.018).

<sup>38</sup> [www.epo.org/applying/online-services/representatives.html](http://www.epo.org/applying/online-services/representatives.html)

**5.3.011** The only case in which a new appointment need not be made is if the professional representative was validly appointed in the procedure before the EPO as receiving Office, (S)ISA or IPEA and the appointment expressly extends to representation in the European phase (see point 2.9.018).

**5.3.012** **Non-resident applicants** are therefore **strongly advised** to appoint a professional representative before the EPO **in good time**, i.e. before they initiate proceedings before the EPO as designated/elected Office, and to indicate this appointment in Form 1200, Sections 2 and 3 (see points 5.3.016 ff).

**5.3.013** If no professional representative is appointed for the proceedings in the European phase, any communication issued by the EPO as designated/elected Office will be notified to the applicant, at his address for correspondence, where applicable.

*OJ 2014, A99*

#### **What happens if the requirement to appoint a professional representative is not observed?**

**5.3.014** In case of failure to appoint a professional representative where this is required, the applicant will be invited by the EPO to do so within a time limit of two months. Until the EPO is informed of a (valid) appointment, any procedural step taken by the applicant will be deemed not to have been taken. If within due time the deficiency has not been corrected, the application will be refused.

*R. 163(5), (6) EPC*

**5.3.015** The refusal may be remedied by a request for further processing. The request will be granted if within two months from notification of the refusal a professional representative is appointed and the fee for further processing is paid.

*Art. 121 EPC  
R. 135 EPC  
Art. 2(1)12 RFees*

#### **How does a representative have to be appointed?**

**5.3.016** In the procedure before the EPO as a designated/elected Office, an authorisation or (a reference to) a general authorisation need, as a rule, not be filed by a representative who identifies himself as a professional representative entered on the list maintained by the EPO. This means that for a valid appointment a professional representative merely needs to inform the EPO of his appointment for the application concerned (see also point 2.9.018), e.g. by signing EPO Form 1200.

*Art. 133, 134 EPC  
R. 152 EPC  
OJ 2007, Spec.Ed.3,  
L.1*

**5.3.017** Legal practitioners entitled to practise before the EPO (see point 5.3.006) and employees representing an applicant who are not professional representatives must, as a rule, file a signed authorisation or a reference to a general authorisation. However, no (new) authorisation is to be filed where an authorisation was filed with the EPO as receiving Office, ISA or IPEA and the authorisation expressly empowered the legal practitioner or employee to act before the EPO in the European phase (see point 2.9.018).

*Art. 133(3) and  
134(8) EPC  
OJ 2007, Spec.Ed.3,  
L.1  
GL/EPO A-VIII,  
1.5-1.6*

- 5.3.018** Where an authorisation is to be filed, the use of EPO Form 1003 is recommended for individual authorisations and EPO Form 1004 for general authorisations. If an authorisation is required but not received, the EPO will invite the applicant or representative to file it within a period to be specified in the invitation. *GL/EPO A-VIII, 1.7*

## 5.4 Application documents on which the procedure before the EPO as designated/elected Office is based (Form 1200, Section 6)

**Which version of the Euro-PCT application is taken as the basis for the procedure in the European phase (Form 1200, Sections 6.1 and 6.2)?**

- 5.4.001** When an application enters the European phase, the applicant must specify the application documents, as originally filed or as amended, on which the European grant procedure is to be based. *R. 159(1)(b) EPC*
- 5.4.002** The documents on which the proceedings before the EPO as designated or elected Office are to be based are to be indicated in Section 6 of Form 1200 and, where necessary, further clarification may be provided on an additional sheet. The applicant must make sure that the indications in Section 6 and/or on the additional sheet correspond to any indications given in the table for Section 6 provided for calculation of the additional (page) fee to be paid for applications comprising more than 35 pages (see points 5.7.001 ff).

The screenshot shows the 'Euro-PCT(1200E2K) - Draft - Euro-PCT' application window. The 'Documents' tab is selected, showing a table for calculating the total number of pages. The table includes rows for description, claims, drawings, and an abstract, with a final total of 42 pages. The interface also includes a toolbar with icons for saving, running, and checking, and a status bar at the bottom showing counts for errors, warnings, and information.

Euro-PCT(1200E2K) - Draft - Euro-PCT					
EP Phase	Names	States	Biological Material	Documents	Fee
Documents intended for proceedings before the EPO (R. 159 (1) (b) EPC) and for calculation of the additional fee					
Overview   Description   Claims   Drawings					
Total number of pages - description:				30	
Total number of pages - claims: +				7	
Total number of pages - drawings: +				4	
default one page - abstract: +				1	
Total number of pages:				42	



**Euro-PCT(1200E2K) - Draft - Euro-PCT**

EP Phase | Names | States | Biological Material | **Documents** | Fee Payment

Proceedings | Amendments and Translations | Document Overview | Sequence Listings | Additional Documents

Documents intended for proceedings before the EPO (R. 159 (1) (b) EPC) and for calculating the additional fee

Overview | Description | **Claims** | Drawings

Number of claims on entry into the European phase: 14

Number of claims you intend to pay for (including first 15 claims) : 0

The set of claims on entry into the European phase comprises the following parts:

Part	Pages from...to...	Number of pages
<input type="checkbox"/> International application as published		
<input checked="" type="checkbox"/> Art. 19 PCT amendments	31-37	7
<input type="checkbox"/> Art. 34 PCT amendments		
<input type="checkbox"/> Amendments on entry into the European phase		
Total number of pages - claims:		7

0 4 9

**5.4.003** If the EPO acts as **designated** Office, the documents forming the basis for the proceedings in the European phase are to be indicated in Section 6.1.

**5.4.004** If the EPO acts as **elected** Office, the documents forming the basis for the proceedings in the European phase are to be indicated in Section 6.2. If the applicant has filed test reports (e.g. comparative examples in support of inventive step) with the EPO as IPEA, it is assumed that the EPO may also use them in the European grant proceedings.

### Information on prior art (Form 1200, Section 6.3)

**5.4.005** If the applicant has claimed the right of priority of one or more previous applications, he must on entry into the European phase file the results of any search carried out by or on behalf of the office of first filing (OFF) for each application whose priority is claimed.

Art. 124 EPC  
R. 70b, 141 EPC  
OJ 2010, 410

**5.4.006** The obligation applies irrespective of the form and format in which the search results are drawn up, for instance a search report, a listing of cited prior art or a (relevant) part of an examination report. The applicant must file a complete copy of each relevant document as received from the authority concerned. However, neither a translation of the search results nor a copy of the documents cited therein need be filed at this stage.

- 5.4.007** If the search results for the priority application(s) are not available at the time of entry into the European phase, the applicant must file them as soon as he receives them.
- 5.4.008** No action is required on the part of the applicant where an exemption applies. Firstly, this is the case if the EPO is the authority that performed the search on a claimed priority application and established a search report of one of the following types: a European search report, an ISR, an international-type search report or a search report on a national application drawn up on behalf of a national office (Belgium, Cyprus, France, Greece, Italy, Latvia, Lithuania, Luxembourg, Malta, Monaco, Netherlands, San Marino, Turkey, United Kingdom (with a national filing date of 1 July 2018 or later)). *OJ 2017, A94  
GL/EPO A-III, 6.12*
- 5.4.009** A further exemption from the obligation to file a copy of any search results for a priority application applies if priority is claimed of a first filing made in: *OJ 2011, 62  
OJ 2012, 540  
OJ 2013, 216  
OJ 2015, A2  
OJ 2016, A18, A19*
- Austria
  - Denmark
  - Japan
  - the Republic of Korea
  - Spain
  - the United Kingdom
  - the United States of America.
- 5.4.010** If the search results regarding any claimed priority application have to be filed with the EPO but are not received, the applicant will be invited to file, within a period of two months set in the invitation, the copy of the missing search results and/or a statement that these results are (in whole or in part) not available to him. The invitation will be issued at the time the examining division assumes responsibility for the application. *R. 70b EPC*

### Amending the application – Rule 161/162 communication

- 5.4.011** For the purpose of the procedure before the EPO as designated/elected Office the applicant may always file (**voluntary**) amendments within the 31-month time limit, and if he subsequently changes his mind he may file (further) amendments until expiry of the time limit set in the combined communication under Rules 161 and 162 EPC ("Rule 161/162 communication"). As set out below, if the EPO acted as (Supplementary) International Searching Authority, the applicant may be **required** to file (**mandatory**) amendments to or comments on the application within the time limit set in the Rule 161/162 communication (see point 5.4.026). Whether or not a response is mandatory is clearly stated in the communication, its wording thus *Art. 28, 41 PCT  
R. 52.1(a), 78.1(a)  
PCT  
Art. 123(1) EPC  
R. 137(2), 161(1),  
(2) EPC  
OJ 2010, 634  
OJ 2016, A102  
GL/EPO E-IX, 3.2*

differing depending on the case (EPO Forms 1226AA and 1226BB).

- 5.4.012** The Rule 161/162 communication is issued for each application promptly once the application has entered the European phase and on condition that the ISR is available to the EPO. This means that it is also issued if the applicant has already filed, with Form 1200 or thereafter, amendments and/or comments to form the basis for the procedure in the European phase.
- 5.4.013** The time limit set in the communication under Rules 161 and 162 EPC is six months. This time limit cannot be extended.
- 5.4.014** After expiry of the six-month time limit further possibilities for amending the application are limited. If a supplementary European search is carried out, the applicant always has one further opportunity to submit amendments upon receipt of the report (see point 5.4.021). Amendments made thereafter require the consent of the examining division. By way of exception, in cases where the supplementary European search is dispensed with (EPO was (S)ISA) and, after expiry of the period according to Rule 161(1) EPC, the examining division considers the application documents on file not to have been searched before, and a further search is carried out in the European phase according to Rule 164(2)(a) EPC (see points 5.15.011-5.15.012), the applicant may also submit amendments in response to the communication of the results of that search in accordance with Rule 164(2)(b) EPC and without requiring the consent of the examining division. *R. 70a(2), 137(3), 164(2) EPC*
- 5.4.015** Amendments may under no circumstances go beyond the disclosure in the international application as filed. *Art. 28(2), 41(2) PCT  
Art. 123(2) EPC*
- 5.4.016** Whenever amendments are filed, the applicant must **identify** them and indicate their basis in the application as filed. If he fails to do so, the examining division may issue a communication requesting correction of the omission within a non-extendable time limit of one month. If the deficiency is not remedied in due time, the application will be deemed withdrawn under Article 94(4) EPC. The loss of rights can be remedied with further processing. *Art. 94(4) EPC  
R. 137(4) EPC  
GL/EPO E-IX, 3.4, H-III, 2.1.1*
- May the Rule 161/162 communication be waived?**
- 5.4.017** In order to accelerate the European grant procedure the applicant can, if so desired in addition to a PACE request (see point 5.1.037), waive his right to the Rule 161/162 communication by ticking the first check box in Section 12.2 of Form 1200. *OJ 2015, A94*

- 5.4.018** This waiver will be effective and no Rule 161/162 communication issued only if the applicant has taken all steps required to make its issuance superfluous. In other words, he must ensure that all requirements for the application to proceed to the next phase of the European grant procedure without the communication being issued are fulfilled. This means that within the 31-month time limit he must have:
- paid any claims fees due for the set of claims indicated as the basis for the procedure in the European phase, and
  - filed a substantive response, as the case may be, to the WO-ISA, the IPER or the SISR established by the EPO, if in the absence of such a response the EPO would invite the applicant to do so under Rule 161(1) EPC ("mandatory response").
- 5.4.019** If any requirement for the waiver to be effective is not fulfilled, a Rule 161/162 communication will be issued and processing of the application will not start until the six-month time limit set therein has expired. This applies even if a request under the PACE programme is or has been filed (see point 5.1.037).

*OJ 2015, A94  
GL/EPO E-IX, 3.1,  
3.2, 3.3.1, 3.3.2*

#### **Amendments and the Rule 161/162 communication if a supplementary European search is carried out**

- 5.4.020** If the **EPO did not act as ISA or SISA** for the application it will upon entry into the European phase draw up a supplementary European search report (see point 5.9.001). Up to expiry of the six-month time limit set in the Rule 161/162 communication (EPO Form 1226CC) the applicant may file ("voluntary") amendments. All amendments filed within the time limit set in the communication will be taken into account in drawing up the supplementary European search report and the search opinion (see points 5.9.001, 5.9.003). This means that the supplementary European search will be based on the last set of claims filed up to expiry of this time limit for which any claims fee due has been paid (see point 5.11.005). If the applicant does not wish to wait until the end of the six-month time period under Rules 161(2) and 162 EPC for processing to start, he may request the immediate start of the supplementary search by explicitly waiving his right to use the remainder of the six-month period.
- 5.4.021** After issuance of the supplementary European search report the applicant may, first of all, comment on both the report and the ("positive") search opinion and file ("voluntary") amendments to the description, claims and drawings within the period specified in the communication under Rules 70(2) and 70a(2) EPC for indicating whether he wishes to proceed further with the application.
- 5.4.022** Secondly, if any deficiencies are noted in the search opinion, the applicant will be required under Rule 70a(2) EPC to respond to the objections made. The application will be deemed withdrawn if the applicant does not submit a substantive reply to the communication under Rule 70a(2) EPC ("mandatory response"). The loss of rights can be remedied with further processing.

*R. 161(2) EPC  
GL/EPO E-IX, 3.1*

*R. 137(2) EPC*

*Art. 121 EPC  
R. 70(2), 70a(2),  
70a(3), 135 EPC*

- 5.4.023** It is at the discretion of the examining division to accept any further amendment at a later stage of the proceedings. *R. 137(3) EPC*

**Amendments and the Rule 161/162 communication if no supplementary European search is carried out**

- 5.4.024** If the **EPO has performed a search** for an international application in its capacity **as ISA or SISA**, it will not carry out a supplementary European search upon entry into the European phase (see point 5.9.001), and any amendments filed within the time limit set in the Rule 161/162 communication will serve as the basis for examination. *R. 137(2), 161(1) EPC  
GL/EPO E-IX, 3.2*
- 5.4.025** If the EPO in the international phase made any negative finding and drew up a "negative WO-ISA" or, where the EPO also acted as IPEA, a "negative IPER" or made "objections" in the explanatory notes on the SISR ("negative SISR"), the applicant is required under Rule 161(1) EPC to respond to this finding ("mandatory response"). *OJ 2010, 634*
- 5.4.026** If a response is mandatory, the applicant must respond to the Rule 161/162 communication within the six-month time limit set therein. A response is not mandatory if a substantive response has already been submitted before the Rule 161/162 communication is issued. For the purpose of Rule 161(1) EPC new amendments filed on entry into the European phase and up to the time the Rule 161/162 communication is issued are held to constitute a response on condition that the applicant has indicated - preferably in Box 6 of Form 1200 - that they form the basis for prosecution of the application in the European phase. Whether or not a response is mandatory is clearly indicated in the Rule 161/162 communication (see point 5.4.012).
- 5.4.027** Under the same conditions as for amendments made on entry into the European phase or thereafter, but subject to certain requirements set out in detail in the Guidelines, any amendments made under Article 19 and/or 34 PCT and maintained for the processing of the application in the European phase will constitute a response. *GL/EPO E-IX, 3.3.1*
- 5.4.028** If a "mandatory response" is not filed in due time, the application is deemed withdrawn under Rule 161(1) EPC. Further processing may be requested. *Art. 121 EPC  
R. 135 EPC*
- 5.4.029** Further, if the EPO acted as ISA, SISA or IPEA in the international phase, and regardless of whether the EPO in the international phase made any negative finding (see point 5.4.025), the applicant has the right to submit (further) comments on the WO-ISA, IPER and SISR and to file (further) voluntary amendments as he sees fit within the time limit set in the Rule 161/162 communication. *R. 137(2) EPC*
- 5.4.030** All comments and amendments validly filed by the applicant on a mandatory or voluntary basis within the six-month time limit set in the Rule 161/162 communication will be taken into account in the examination proceedings. This means that examination will be based on the last set of claims filed up to expiry of this time limit for *GL/EPO C-II, 3.2  
GL/EPO E-IX, 4.1- 4.3  
OJ 2015, A94*

which any claims fee due has been paid (see points 5.11.004 ff). If the applicant does not wish to wait until the end of the six-month time period under Rules 161(1) and 162 EPC for processing to start, he may request the immediate start of examination by explicitly waiving his right to use the remainder of the six-month period.

- 5.4.031** It is at the discretion of the examining division to accept any further amendment at a later stage of the examination proceedings. *R. 137(3) EPC*

**Does the filing of amendments have an impact on the number of claims fees payable?**

- 5.4.032** The claims fees are calculated on the basis of the number of claims contained in the application in the version that is, in accordance with the indications in Form 1200, to be taken as the basis for the procedure in the European phase. The amount of the claims fee varies according to a two-tier system. For the 16th and each further claim a claims fee must be paid. However, for any claim over 50 a higher amount is due (see points 5.11.004 ff). *R. 162 EPC  
Art. 2(1)15 RFees  
GL/EPO E-IX, 2.1.3*
- 5.4.033** Where claims fees are to be paid, they must be paid within the 31-month time limit. If the applicant fails to pay (the correct amount of) claims fees in due time, he is invited in the Rule 161/162 communication to pay the missing amount within the non-extendable six-month time limit set therein (see point 5.4.013). If the number of claims increases due to (further) amendments filed in reply to the Rule 161/162 communication, any claims fees due for the additional claims must also be paid within the six-month time limit (see point 5.11.009). If a supplementary European search is carried out, it will relate to the last set of claims received before expiry of the six-month time limit and will be confined to claims for which any claims fees, where applicable, have been paid in due time.
- 5.4.034** Where the number of claims changes as a consequence of a (further) amendment submitted within the six-month time limit set in the Rule 161/162 communication (see point 5.4.013), that number is decisive for calculating the amount of the claims fees to be paid. *OJ 2016, A102, A103*
- 5.4.035** If consequent to the amendments made before expiry of the six-month time limit the number of claims forming the basis for the further procedure is reduced, any claims fees overpaid will be refunded. *R. 162(3) EPC*
- 5.4.036** Claims for which a fee due is not paid are deemed to be abandoned, and the applicant is notified thereof. The loss of rights may be remedied by further processing. Features of a claim deemed abandoned which are not otherwise to be found in the description cannot be reintroduced into the application. *Art. 121 EPC  
R. 135, 162(4) EPC  
J 15/88 (OJ 1990, 445)*



## 5.5 Translation of the application documents and other documents (Form 1200, Section 7)

### When must the applicant file a translation of the Euro-PCT application?

- 5.5.001** If the Euro-PCT application was not published by the IB in an official language of the EPO (English, French, German), the applicant must, within the 31-month time limit, submit to the EPO a translation of the application into any such language (Form 1200, Section 7). *Art. 22(1), 39(1) PCT  
R. 49.2 PCT  
Art. 14(2), 153(4) EPC  
R. 159(1)(a) EPC  
GL/EPO E-IX, 2.1.2*
- 5.5.002** If a translation must be filed, the language of the translation determines the language of the proceedings before the EPO (see point 5.1.014). At any time during the processing of the application in the European phase, errors made in the translation may be corrected. *Art. 14(2), (3) EPC*
- 5.5.003** If the international application has been published by the IB in an official language of the EPO, no translation is required and any translation that is nevertheless filed will be ignored, since the language of the proceedings may not be changed upon entry into the European phase (see point 5.1.015). *G 4/08  
OJ 2010, 572*
- 5.5.004** In written proceedings the applicant may use any official language of the EPO, but any amendments to the application must always be filed in the language of the proceedings (see point 5.1.014). *R. 3 EPC*
- 5.5.005** On the question of whether a translation of the priority document must be submitted, reference is made to points 5.13.012 ff.

### What are the consequences of not filing a translation of the application?

- 5.5.006** If the translation of the Euro-PCT application is not filed within the 31-month time limit, the application is deemed to be withdrawn and the applicant is informed of this in a communication. Moreover, the application will not be considered as comprised in the state of the art under Article 54(3) EPC (see point 5.17.001). *Art. 24(1)(iii),  
39(2) PCT  
Art. 153(5) EPC  
R. 112, 160 EPC*
- 5.5.007** The loss of rights is deemed not to have occurred if, within two months from notification of the above communication, the translation is supplied and further processing is requested by payment of the relevant fee. *Art. 121 EPC  
R. 135(1) EPC  
Art. 2(1)12 RFees*
- 5.5.008** Alternatively, the applicant may request reinstatement of rights under Rule 49.6 PCT if the application is deemed withdrawn because the translation was not filed in due time. However, given that the fee is higher and stricter requirements apply, this remedy has no advantages unless the period for requesting further processing has already expired. *R. 49.6 PCT  
Art. 122 EPC  
R. 136 EPC  
Art. 2(1)13 RFees  
OJ 2007, 692*



- 5.5.009** If the time limit for requesting further processing has been missed (see point 5.5.007), a request for re-establishment of rights in respect of the period under Rule 135(1) EPC may be filed. The request is not deemed to have been filed until the fee for re-establishment relating to the omitted act, i.e. filing the translation under Rule 159(1)(a) EPC, has been paid. Attention is drawn to the further requirements under Article 122 and Rule 136 EPC for the request to be admissible and allowable (see also points 5.13.019 and 5.19.001).
- Art. 122 EPC  
R. 136 EPC  
Art. 2(1)13 RFees  
GL/EPO E-VIII, 3.1.3*

### What must the translation include?

- 5.5.010** The translation must always include:
- the description (as originally filed)
  - the claims (as originally filed)
  - any text in the drawings (as originally filed)
  - the abstract (as published).
- R. 49.2 and 49.5  
PCT*
- 5.5.011** If the EPO acts as **designated** Office the translation must, where applicable, also include:
- **only if** the applicant wishes such amendments to form the basis of further proceedings, any **amendments made to the claims** under Article 19 PCT in the form of a translation of the complete set of claims furnished in replacement of all claims originally filed (see point 3.2.027). The claims as amended under Article 19 PCT must be submitted together with, if submitted to the IB, the translated statement under Article 19(1) PCT explaining the amendments and, in every case, the translated accompanying letter under Rule 46.5(b) PCT, indicating the basis for the amendments in the application as filed, in an official language of the EPO. If a translation of the complete set of claims submitted under Article 19 PCT is not furnished or not accompanied by a translation of, if submitted to the IB, the statement under Article 19(1) PCT and, in every case, the accompanying letter under Rule 46.5(b) PCT, the amendments under Article 19 PCT will be **disregarded** for the further proceedings. If only the statement under Article 19(1) PCT is not available in an official language, only that document will be disregarded.
  - any published request for rectification
  - any sequence listing, unless the text in the sequence listing is available to the EPO in English (see point 5.6.010)
  - any separately furnished references to deposited biological material (Form 1200, Section 8).
- Art. 19 PCT  
R. 46.4 and .5, 49.3,  
49.5(c), (c-bis) PCT  
R. 3, 137(4) EPC*
- R. 91.3(d),  
48.2(a)(vii) PCT  
R. 49.5(a-bis), 5.2(b)  
PCT*
- R. 49.5(h), 13bis.3  
and 13bis.4 PCT*

**5.5.012** In addition, if the EPO acts as **elected** Office, translations of **any annexes** to the international preliminary examination report (IPER) **must always be furnished**, i.e. including any accompanying letter under Rules 66.8(a) or (b) PCT indicating the basis for the amendments in the application as filed. Such translations must be filed regardless of whether protection is sought for the same version of the application documents as was the subject of the IPER. Therefore, a translation of any amendments made under Article 19 PCT (and the accompanying letter under Rule 46.5(b) PCT, if annexed to the IPER) must also always be filed if such amendments are annexed to the IPER.

*Art. 36(2)(b) and (3)(b), 39(2) PCT  
R. 70.16, 74.1(a) PCT  
R. 137(4) EPC*

**5.5.013** If the applicant wishes the amendments to the claims made before the IB under Article 19 PCT to form the basis of the subsequent procedure before the EPO as elected Office, and these amendments are **not** annexed to the IPER (for instance because they were considered reversed by an amendment under Article 34 PCT), then these amendments must also be furnished in translated form, as otherwise they will be disregarded for the further proceedings. Any statement under Article 19(1) PCT and, in every case, the letter under Rule 46.5(b) PCT must also be furnished in an official language of the EPO. If only the statement under Article 19(1) PCT is not available in an official language, only that document will be disregarded (see point 5.5.011).

***What are the consequences of not filing a translation of the annexes to the IPER?***

**5.5.014** If the translation of all annexes to the IPER is not filed in due time, the applicant is invited to furnish the missing translation within two months of notification of a communication. If the applicant fails to reply (in time), the Euro-PCT application is deemed to be withdrawn. The applicant may request further processing (or reinstatement of rights, see points 5.5.007 ff and points 5.13.019 and 5.19.001).

*Art. 121 EPC  
R. 135, 160 EPC  
Art. 2(1)12 RFees*

## **5.6 Biological material & nucleotide and amino acid sequences**

### **Biological material (Form 1200, Section 8)**

**5.6.001** For the sufficient disclosure of an invention which involves the use of or concerns biological material which is not available to the public and which cannot be described in the application in an enabling manner for the skilled person, specific requirements must be met on the international filing date and within sixteen months after the date of filing or the priority date (see point 2.20.001). If any of these requirements was not met within the applicable time limit, no remedy is available before the EPO as designated/elected Office upon entry into the European phase. Extensive information is provided in the Notice from the EPO dated 7 July 2010.

*R. 13bis.3, 13bis.4 PCT  
Art. 83 EPC  
R. 31, 32 EPC  
OJ 2010, 498  
OJ 2017, A55, A60, A61  
OJ 2018, A80  
GL/EPO A-IV, 4.1, 4.3; F-III, 6.5*

**5.6.002** If on filing the international application a reference to the deposit of biological material complying with Rule 31 EPC was made but no proof of the deposit in the form of a copy of the deposit receipt issued by the depositary institution was submitted, the applicant is strongly advised to do so upon entry into the European phase.

**5.6.003** If the Euro-PCT application was not published by the IB in an official language of the EPO, the biological material referred to in the application will be available upon request to any person (only) from the date of publication of the translation by the EPO. If the applicant wishes to make use of the expert solution under Rule 32 EPC, they must file the statement under Rule 32(1) EPC before the technical preparations for publication of the translation by the EPO are completed (see point 2.20.007). The biological material concerned will then be made available only by the issue of a sample to an independent expert nominated by the requester.

*R. 13bis.6 PCT  
R. 32, 33 EPC  
OJ 2017, A55, A60, A61  
GL/EPO A-IV, 4.3*

### **Waiver under Rule 33(2) EPC**

**5.6.004** The issue of a sample of biological material may be requested by any person under the conditions set out in Rule 33(1) EPC. Rule 33(2) EPC requires that the requester has undertaken vis-à-vis the applicant not to make the biological material, or any biological material derived therefrom, available to any third party and to use that material for experimental purposes only, until such time as the European patent application is refused or withdrawn or deemed to be withdrawn, or before the European patent has expired in all the designated states.

*OJ 2010, 498*

**5.6.005** In Form 1200, Section 8, the applicant is given the option of waiving his right to an undertaking by the requester pursuant to Rule 33(2) EPC on condition that the applicant is the depositor of the biological material. A waiver may, however, be filed at any time in the form of a signed statement containing a specification of the biological material concerned.

### **Nucleotide and amino acid sequences (Form 1200, Section 9)**

**5.6.006** Where the Euro-PCT application discloses nucleotide or amino acid sequences, a **sequence listing in electronic (text) form drawn up in compliance with WIPO Standard ST.25** must be available to the EPO as a designated/elected Office on expiry of the 31-month time limit. Extensive information is provided in the Notice from the EPO dated 18 October 2013. The sequence listing must be filed in electronic (TXT) format only; consequently, a sequence listing filed on paper or in PDF format will be disregarded.

*R. 5.2, 13ter.3 PCT  
R. 30, 163(3) EPC  
OJ 2011, 372  
OJ 2013, 542  
OJ 2018, A80  
GL/EPO A-IV, 5;  
E-IX, 2.4.2*

**5.6.007** As a rule the required sequence listing will be available to the EPO if it was contained in the international application under Rule 5.2 PCT or filed under Rule 13ter PCT with the EPO acting as ISA/SISA or IPEA (see points 2.21.001 ff). Further, it will also be accessible to the EPO if it is made available by WIPO on Patentscope and can be downloaded in a usable form.

- 5.6.008** The applicant should in due time verify whether the sequence listing is available to the EPO in the required form and, if it is not, file it before expiry of the 31-month time limit in electronic (TXT) format online or on a data carrier.
- 5.6.009** If a sequence listing must be filed upon entry into the European phase, the applicant must enclose a statement to the effect that the information contained in the sequence listing does not go beyond the content of the original application documents. This statement can be made by crossing the appropriate box in Section 9.2 of Form 1200.
- 5.6.010** A translation of any text matter in a sequence listing which forms part of the description or which was filed subsequently need only be provided if it is not yet available to the EPO in English (see point 5.5.011).

*R. 5.2(b), 12.1(d),  
13ter, 49.5(a-bis)  
PCT  
Art. 14(3) EPC  
R. 3 EPC*

### ***What are the consequences of not filing a sequence listing?***

- 5.6.011** If on expiry of the 31-month time limit a sequence listing in electronic form complying with WIPO Standard ST.25 is not available to the EPO, the applicant will be invited to furnish such a sequence listing and pay the late furnishing fee within a non-extendable period of two months.
- 5.6.012** If the required sequence listing is not filed within the time limit set, the application is refused. The refusal may be remedied by a request for further processing (see points 5.13.019 and 5.19.001).

*R. 30(3), 163(3) EPC  
Art. 2(1)14a RFees*

*Art. 121 EPC  
R. 135 EPC*

## **5.7 Filing fee**

- 5.7.001** Within the 31-month time limit the European filing fee must be paid, this being composed of a basic filing fee and an additional fee which is due for the 36th and each subsequent page of the application. In the case of Euro-PCT applications, the pages forming the basis for the procedure in the European phase are counted as set out below. The additional fee is referred to as the "page fee".
- 5.7.002** The requirement to pay the European filing fee on entry into the European phase implements the right of the EPO as a designated/elected Office to require payment of a "national fee" under Articles 22(1) and 39(1) PCT.
- 5.7.003** The basic filing fee is reduced where Form 1200 is filed online (see point 5.1.017).

*Art. 22(1), 39(1) PCT  
Art. 78(2) EPC  
R. 159(1)(c) EPC  
Art. 2(1)1 RFees  
OJ 2009, 118, 338  
GL/EPO A-III, 13.1  
and E-IX, 2.1.3*

### **Page fee**

- 5.7.004** Applicants are advised to compute the correct page fee with the help of Form 1200, section 6, and in particular the related table, which is part of Form 1200. Precise and correct indications in section 6 and the table are required to ensure that the EPO does

*R. 38(2) EPC  
Art. 2(1)1a RFees  
GL/EPO A-III, 13.2*

not deem the application to be withdrawn due to payment of what appears to be an incorrect amount of the filing fee.

**5.7.005** As a general rule, the page fee is based on the international application as published, regardless of the language of publication. The pages of the description, claims and drawings are counted, plus one page in total for any pages with the bibliographic data and the abstract. Amended claims under Article 19 PCT are also part of the international publication and must be taken into account. They are considered to replace the claims as originally filed unless the applicant explicitly states that the procedure in the European phase is not to be based on them (see first check box in Section 6.1 of Form 1200). Furthermore, any amended pages annexed to the IPER are counted in addition, provided that the IPER is available to the EPO at the 31-month time limit, and unless the applicant has either indicated that the further proceedings are **not** to be based on them or clearly stated that they replace the corresponding pages as originally filed (see point 5.7.009). The latter statement can be made by ticking the first check box in Section 6.2.

**5.7.006** However, the calculation of the page fee cannot be based on pages of the description or of the claims drafted partly in an official language of the EPO and partly in another language. Thus, special rules for calculating the page fee apply if the international application was not published in an official language of the EPO and amendments were filed upon entry into the European phase.

*OJ 2009, 338*

**5.7.007** If amendments to the **claims** are filed for the procedure in the European phase, the entire set of claims must always be submitted, and this set will form the basis for calculating the page fee and will replace any earlier set of claims filed. For international applications not published in an official language of the EPO, the page fee is calculated on the basis of the translation of the set of claims as amended and the description of the international application as published.

**5.7.008** If amendments to the **description** are filed, the pages of the description are counted as follows: the pages of the description as published, plus any pages submitted as amendments to the description, minus the pages which are replaced by the amendments to the description filed upon entry into the European phase. For international applications not published in an official language of the EPO, the page fee is calculated on the basis of the translation of the entire description, even if it is only amended in part. The same applies where the description has been amended under Article 34 PCT and the applicant wishes these amendments to be taken into consideration in the European phase.

**5.7.009** If the application was processed under PCT Chapter II, the amendments filed under Article 34 PCT, which are annexed to the IPER, are to be taken into account in computing the page fee unless the applicant indicates that these pages are not to form the basis for the procedure in the European phase. If the applicant does not clearly state that the amendments under Article 34 PCT

replace the corresponding pages as originally filed, the amendments annexed to the IPER are included in the page count in addition to the number of pages in the international publication (see point 5.7.004).

**5.7.010** Form 1200 and any sequence listing presented as a separate part of the description in accordance with the requirements of WIPO Standard ST.25 are disregarded for the purpose of these calculations.

**5.7.011** Pages with amendments filed after expiry of the 31-month time limit are not taken into account in calculating the page fee. Consequently, even if amendments submitted after expiry of the 31-month time limit reduce the number of pages already paid for, no refund will be made.

### **What happens if the time limit for payment of the filing fee is not observed?**

**5.7.012** If the **filing fee**, i.e. the basic filing fee and/or, where applicable, the page fee, is not paid in full in due time, the application is deemed to be withdrawn. Further, the Euro-PCT application will not be considered as comprised in the state of the art under Article 54(3) EPC (see point 5.17.001). The applicant is informed of the loss of rights in a communication under Rules 112(1) and 160(2) EPC.

*Art. 153(5) EPC  
R. 160, 165 EPC*

**5.7.013** Further processing may be requested within two months from notification of the communication of the loss of rights by payment of the filing fee or the missing part of the filing fee and any page fees, together with the fee for further processing (see also point 5.19.001).

*Art. 121 EPC  
R. 135 EPC  
Art. 2(1)12 RFees*

**5.7.014** If the basic filing fee is not paid (in full) in due time, the fee for further processing amounts to 50% of the basic filing fee. If the page fee is not paid (in full), the fee for further processing amounts to 50% of the page fee for the number of pages for which the page fee has not been paid on time.

**5.7.015** The applicant may also request reinstatement of rights if the application is deemed withdrawn because the filing fee was not paid in due time. Given the fact that the fee is higher and stricter requirements apply, this remedy has no advantages, unless the period for requesting further processing has already expired (see point 5.5.008).

*R. 49.6 PCT  
Art. 122 EPC  
R. 136 EPC  
Art. 2(1)13 RFees*

**5.7.016** If the time limit for requesting further processing has been missed (see point 5.7.013), a request for re-establishment of rights in respect of the period under Rule 135(1) EPC may be filed. The request is not deemed to have been filed until the fee for re-establishment relating to the omitted act has been paid. Since payment of the filing fee and payment of the page fee constitute a unitary procedural act, only one fee for re-establishment has to be paid (see point 5.19.001). Attention is drawn to the further requirements under Article 122 and Rule 136 EPC for the request to be admissible and allowable.

*Art. 122 EPC  
R. 136 EPC  
Art. 2(1)13 RFees  
GL/EPO E-VIII, 3.1.3*



## 5.8 Designations, extensions and validations

- 5.8.001** A (flat) designation fee must be paid within 31 months from the filing date or, if priority has been claimed, the earliest priority date, or within six months from the date of publication of the ISR, whichever time limit expires later. Therefore, unless the publication of the ISR was considerably delayed, the designation fee must be paid within the 31-month time limit.
- 5.8.002** Payment of the designation fee will be effective only in respect of EPC contracting states that were designated for a European patent in the international application on the international filing date (see point 2.10.001).
- 5.8.003** Applicants are reminded that upon filing of the PCT request all PCT contracting states are automatically designated for both a national and, where applicable, a regional patent. Therefore, payment of the (flat) designation fee on entry into the European phase confirms the designation of the EPC contracting states that were **EPC and PCT contracting states at the international filing date** (see point 2.10.002). An exception applies where the applicant has withdrawn the designation for a European patent in respect of one or more EPC contracting states during the international phase.
- 5.8.004** If a state for which patent protection is sought was neither an EPC contracting state nor an extension or validation state at the international filing date (see point 5.8.009), the applicant must enter the national phase in the state concerned to obtain patent protection for that state on the basis of his international application. If, however, before entry into force of the EPC for a state an extension or validation agreement with that state was in force, patent protection in that state may still be obtained on the basis of the extension or validation agreement for any application filed before the related extension agreement was terminated (see point 2.11.005).

*Art. 21 PCT  
R. 48 PCT  
Art. 79(2), 153(6)  
EPC  
R. 39, 159(1)(d) EPC  
Art. 2(1)3 RFees  
OJ 2009, 118  
GL/EPO A-III, 11.2.5;  
E-IX, 2.1.3, 2.3.11*

### What happens if the time limit for payment of the designation fee is not observed?

- 5.8.005** If the designation fee is not paid in due time, the application is deemed withdrawn. The applicant will be informed thereof in a communication under Rules 112(1) and 160(2) EPC.
- 5.8.006** Further processing may be requested within two months after notification of the communication of the loss of rights by payment of the designation fee together with the fee for further processing, which amounts to 50% of the designation fee (see also point 5.19.001).
- 5.8.007** Since the designation fee does not form part of the national (filing) fee (see point 5.7.001), applicants cannot request reinstatement of rights under Rule 49.6 PCT.

*R. 160 EPC  
GL/EPO E-IX, 2.1.3*

*Art. 121 EPC  
R. 135 EPC  
Art. 2(1)3, 2(1)12  
RFees*

*Art. 22(1) PCT  
R. 49.6 PCT*



- 5.8.008** If the time limit for requesting further processing has been missed (see point 5.8.006), a request for re-establishment of rights in respect of the period under Rule 135(1) EPC may be filed. The request is not deemed to have been filed until the fee for re-establishment relating to the omitted act, i.e. payment of the designation fee under Rule 39 EPC, has been paid. Attention is drawn to the further requirements under Article 122 and Rule 136 EPC for the request to be admissible and allowable (see point 5.19.001).
- Art. 122 EPC  
R. 136(1) EPC  
Art. 2(1)13 RFees  
GL/EPO E-VIII, 3.1.3*

### **How can the Euro-PCT application be extended or validated (Form 1200, Section 11)?**

- 5.8.009** Under certain conditions a European patent may be extended to or validated in states which are not EPC contracting states on the international filing date but have concluded an extension or validation agreement with the EPO to that effect.
- OJ 1994, 75; 1996, 82; 1997, 538; 2004, 117, 619; 2007, 406; 2009, 603; 2010, 10  
OJ 2015, A18, A20, A84, A85  
OJ 2016, A5, A67  
OJ 2017, A84, A85  
OJ 2018, A15, A16  
GL/EPO A-III, 12, and E-IX, 2.1.3*
- 5.8.010** Extension or validation of a European patent is possible only if the state concerned was designated in the international application for a national patent and an extension or validation agreement with the EPO was in force at the international filing date (see point 2.11.001).
- 5.8.011** Extension or validation is deemed requested for any international application entering the European phase in respect of any state designated in the application with which an extension or validation agreement was in force **at the international filing date**. However, such request is deemed to be withdrawn in respect of each extension or validation state for which no extension or validation fee is paid in due time. The applicant must, therefore, carefully check for which states extension or validation is possible and pay the required fees in due time (see point 2.12.003).
- GL/EPO A-III, 12.4*
- 5.8.012** Pursuant to the extension and validation agreements, an extension or validation fee must be paid within the same time limit as applies for payment of the designation fee (see point 5.8.001). There is no flat extension or validation fee.
- 5.8.013** In Form 1200, Section 11, the applicant may indicate for which states he intends to pay (an) extension or validation fee(s). In addition to the boxes provided for the states with which an extension agreement was in force on 1 January 2019 – i.e. Bosnia and Herzegovina (BA) and Montenegro (ME) – and those with which a validation agreement was in force on 1 January 2019 – i.e. Cambodia (KH), Morocco (MA), the Republic of Moldova (MD) and Tunisia (TN) – further states may be indicated on condition that an extension or validation agreement with that state was in force **at the filing date** of the international application.
- OJ 2017, A84, A85  
OJ 2018, A15, A16, A80*

- 5.8.014** Upon payment, the applicant must specify the extension or validation states for which payment is actually made, preferably by indicating the correct fee code which is assigned to each individual extension and validation state.<sup>39</sup>

**What happens if the time limit for payment of extension fees is not observed?**

- 5.8.015** If no valid payment is made (see point 5.8.012), any request for extension is deemed withdrawn. *OJ 2009, 603  
GL/EPO A-III, 12.1,  
12.2*
- 5.8.016** Unlike the payment of designation fees, the payment of extension fees is regulated entirely in the relevant extension agreement. Therefore Rule 112 EPC does not apply. This means that no loss-of-rights communication pointing out the failure to observe the time limit for payment is issued. For the same reasons, the applicant cannot request either an (appealable) decision under Rule 112(2) EPC or the re-establishment of rights under Article 122 EPC. However, the applicant may still pay an extension fee after expiry of the (basic) time limit for payment of the designation fee and the extension fees under the following circumstances:
- 5.8.017** Firstly, within a grace period of two months as from expiry of the basic time limit, any extension fee may always be paid with a 50% surcharge.
- 5.8.018** Secondly, where in the absence of payment of the designation fee in due time further processing can be requested in respect of the **designation fee**, the applicant may within two months from notification of the communication of the loss of rights also pay the extension fee(s) with a 50% surcharge.

**What happens if the time limit for payment of validation fees is not observed?**

- 5.8.019** If a validation fee is not paid in due time (see point 5.8.012), the request for validation is deemed withdrawn. Similarly to the payment of the extension fee, the payment of validation fees is regulated entirely in the relevant validation agreement. Therefore Rule 112 EPC and Article 122 EPC do not apply. *OJ 2015, A19, A85  
OJ 2016, A5, A67  
OJ 2017, A84, A85  
OJ 2018, A15, A16*
- 5.8.020** If the validation fee for a state is not paid within the basic period, the applicant can still pay it, together with a 50% surcharge, either within two months of expiry of the basic period ("grace period") or along with the request for further processing concerning the designation fee if this has also not been paid in time and hence within two months of notification of a communication of loss of rights under Rule 112(1) EPC following non-payment of the designation fee.

<sup>39</sup> See OJ 2018, Supplementary publication 2, "Miscellaneous fees" and "Description of fee codes".

- 5.8.021** For the reasons set out in point 5.8.019, re-establishment of rights under Article 122 and Rule 136 EPC is not available in respect of payment of the validation fee.

## **5.9 Supplementary European search**

- 5.9.001** As a rule, a supplementary European search must be performed for each international application entering the European phase and a search fee must be paid. For an exception see points 5.9.007 ff. Like any European search report, the supplementary European search report is accompanied by an opinion under Rule 62 EPC, the European search opinion (ESOP), on whether the application and the invention to which it relates meet the requirements of the EPC. As a further service, the information sheet "Information on Search Strategy" is annexed to all supplementary European search reports as from 1 January 2018 (see point 3.2.012). The supplementary European search report together with the search opinion is known as the "extended (supplementary) European search report" (EESR).

*Art. 153(7) EPC  
R. 62, 159(1)(e) EPC  
GL/EPO B-II, 4.3; E-IX, 3.1  
OJ 2017, A106*

- 5.9.002** No search opinion under Rule 62 EPC will be issued if the applicant:

- has filed the request for examination according to Rule 159(1)(f) EPC **and**
- has waived the right to be asked under Rule 70(2) EPC whether he wishes to proceed further with the application (see points 5.10.002 and 5.10.005)

before the supplementary European search report has been transmitted to him. Instead, a communication will be issued under Rule 71(1) or 71(3) EPC, respectively inviting the applicant to correct and/or amend the application or informing him of the text in which the EPO intends to grant the patent. If, in the latter case, the applicant submits reasoned amendments or corrections to the text intended for grant, the examining division will issue a further communication under Rule 71(3) EPC if it gives its consent to the amendments or corrections provided by the applicant. Upon fulfilment of certain conditions, applicants can waive the right to receive this further communication under Rule 71(3) EPC, which enables them to further expedite the European grant procedure.

*GL/EPO B-XI, 7;  
C-II, 1.(ii); C-VI, 3  
OJ 2015, A52, A94*

- 5.9.003** The supplementary European search is performed on the basis of the last set of (amended) claims available to the EPO on expiry of the time limit set in the Rule 161/162 communication (see points 5.4.020 ff). That set of claims is considered the final set at the time the search is performed (see point 5.4.011). Any claim for which a claim fee due has not been paid will not be searched (see points 5.11.007 ff).

*R. 161 EPC*

- 5.9.004** If third-party observations were filed during the international phase and forwarded by the IB to the EPO as designated or elected Office, they will be considered in the supplementary European search report, provided they are substantiated and meet all formal

*OJ 2017, A86  
GL/EPO E-VI, 3*

requirements. Furthermore, provided they were not filed anonymously and the third party has explicitly so requested, the EPO will expedite the issuing of the first office action in the (European) examination phase.

- 5.9.005** If a supplementary European search is carried out, the European Patent Bulletin will mention the date of despatch of the supplementary European search report. The report is not published, but is available through file inspection.
- 5.9.006** If during the supplementary European search the EPO comes to the conclusion that the application contains more than one independent claim in the same category which does not fall under the exceptions listed under Rule 43(2) EPC, it may issue an invitation to indicate, within a time limit of two months, the basis on which the search is to be carried out (Rule 62a(1) EPC). Similarly, if it is impossible to carry out a meaningful search on the basis of all or some of the subject-matter claimed, the EPO will issue an invitation to file, within a time limit of two months, a statement indicating the subject-matter to be searched. Any declaration of no search, or a partial supplementary European search report issued subsequently due to failure to overcome the deficiency, takes the place of the European search report.

*R. 62a, 63 EPC  
OJ 2009, 533  
GL/EPO B-VIII, 4.1,  
3*

#### **No supplementary European search performed**

- 5.9.007** As a rule a supplementary European search is carried out. Dispensation applies and no search fee is to be paid under Rule 159(1)(e) EPC only if the EPO acted as ISA or SISA for the application in the international phase.
- 5.9.008** If dispensation applies, it also applies where instead of an ISR a declaration of non-establishment under Article 17(2)(a) PCT was issued.
- 5.9.009** If no supplementary European search report is drawn up, the Euro-PCT application will, after formalities examination, be passed on for substantive examination on condition that a request for examination has been validly filed (see points 5.10.001 ff).
- 5.9.010** Any third-party observations filed during the international phase and forwarded by the IB to the EPO as designated or elected Office will be considered in the first office action of the examining division, provided they are substantiated and meet all formal requirements. Provided they were not filed anonymously and the third party has explicitly so requested, the issuing of the first office action will be expedited.

*Art. 153(7) EPC  
OJ 2009, 594  
GL/EPO E-IX, 3.2*

*Art. 17(2)(a) PCT  
Art. 153(6) EPC*

*OJ 2017, A86  
GL/EPO E-VI, 3*

#### **Result of supplementary European search and refund of examination fee**

- 5.9.011** Where the request for examination was filed before transmittal of the supplementary European search report, which is usually the case, the EPO invites the applicant after transmittal of the supplementary European search report to indicate within a six-

*R. 70(2), 70a(2) EPC  
GL/EPO E-IX, 2.5.3,  
B-XI, 8*

month time limit whether he wishes to proceed further with the application, unless the applicant has expressly waived the right to receive such invitation (see point 5.10.005). With the same communication, the applicant is invited to correct any deficiencies noted in the search opinion accompanying the supplementary European search report. Such a reply is mandatory if the search opinion was negative. If the applicant fails to file a reply in such a case, the application is deemed to be withdrawn (see points 5.9.013-5.9.014).

- 5.9.012** If the applicant **wishes to proceed further** to examination, he must notify the EPO accordingly within the six-month time limit indicated in the communication issued by the EPO (see point 5.9.011). Within the same time limit he may or must, as the case may be, comment on the supplementary European search report by filing amendments (see point 5.4.020).
- 5.9.013** If the applicant **does not wish to proceed further** to examination, he may actively withdraw the application, or allow it to lapse by simply not filing a reply within the time limit set in the communication under Rules 70(2) and 70a(2) EPC (see point 5.9.011). The latter will result in the application being deemed withdrawn. *R. 70(3), 70a(3) EPC*
- 5.9.014** Where the application is withdrawn, refused or deemed withdrawn before substantive examination has begun, the examination fee is refunded in full. *Art. 11(a) RFees  
OJ 2016, A48, A49*
- 5.9.015** If the applicant actively withdraws the application after substantive examination has begun but before expiry of the time limit for replying to the first invitation issued by the examining division under Art. 94(3) EPC or, if no such invitation has been issued, before the date of the communication under Rule 71(3) EPC, the examination fee is refunded at a rate of 50%. *Art. 11(b) RFees  
OJ 2013, 153  
OJ 2016, A48, A49  
GL/EPO A-VI, 2.5*

### **Search fee for supplementary European search**

- 5.9.016** If a supplementary European search is to be performed, the European search fee must be paid within the 31-month time limit. *R. 159(1)(e) EPC  
Art. 2(1)2 RFees*

### ***Reduction of the search fee***

- 5.9.017** According to Article 153(7) EPC, the European search fee may be reduced. *Art. 153(7) EPC  
OJ 2016, A2  
OJ 2018, A3, A26  
GL/EPO A-X, 9.3.1*

As of 1 January 2019, the search fee is reduced by a fixed amount of EUR 1 110 where the (S)ISR was drawn up by a European ISA, i.e. the Austrian Patent Office, the Finnish Patent and Registration Office, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the Swedish Patent and Registration Office, the Turkish Patent and Trademark Office or the Visegrad Patent Institute.

However, the reduction applies only to the search fee paid in accordance with Rule 159(1)(e) EPC. Further search fees paid under Rule 164(1) EPC are not reduced and always have to be paid in full (see points 5.15.002 ff).

Since 1 April 2018, there has been no reduction of the European search fee where the (S)ISR was drawn up by a non-European ISA, i.e. the Australian Patent Office (IP Australia), the National Intellectual Property Administration, PRC (CNIPA), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Russian Federal Service for Intellectual Property (ROSPATENT) or the United States Patent and Trademark Office (USPTO).

*OJ 2018, A3, A26  
GL/EPO A-X, 9.3.1*

### ***Refund of the search fee***

- 5.9.018** If the supplementary European search report is based on an earlier search report drawn up by the EPO, or if the application claims the priority of a previous application for which a search was carried out by the EPO, (a part of) the fee paid for the supplementary European search may be refunded. The level of the refund depends on the type of earlier search and the extent to which the EPO benefits from the earlier search report when carrying out the supplementary European search.

*Art. 9(2) RFees  
OJ 2009, 99  
OJ 2017, A94  
GL/EPO A-X, 10.2.1*

### ***What happens if the time limit for payment of the search fee is not observed?***

- 5.9.019** If the search fee is not paid in due time the Euro-PCT application will be deemed to be withdrawn and the applicant will be informed of this in a communication under Rules 112(1) and 160(2) EPC.
- 5.9.020** The loss of rights is deemed not to have ensued if within two months after notification of this communication further processing is requested by payment of the further processing fee, which amounts to 50% of the search fee, together with the missing search fee (see also points 5.13.019 and 5.19.001).
- 5.9.021** Since the search fee does not form part of the national (filing) fee (see point 5.7.001), applicants cannot request reinstatement of rights under Rule 49.6 PCT.
- 5.9.022** If the time limit for requesting further processing has been missed (see point 5.9.020), a request for re-establishment of rights in respect of the period under Rule 135(1) EPC may be filed. The request is not deemed to have been filed until the fee for re-establishment relating to the omitted act, i.e. payment of the search fee under Rule 159(1)(e) EPC, has been paid. Attention is drawn to the further requirements under Article 122 and Rule 136 EPC for the request to be admissible and allowable (see points 5.13.023 and 5.19.004).

*R. 160 EPC*

*Art. 121 EPC  
R. 135 EPC  
Art. 2(1)12 RFees*

*Art. 22(1) PCT  
R. 49.6 PCT*

*Art. 122 EPC  
R. 136(1) EPC  
Art. 2(1)13 RFees  
GL/EPO E-VIII, 3.1.3*



## 5.10 Examination

### How is the request for examination filed (Form 1200, Section 4)?

- 5.10.001** A European patent may only be granted if the substantive examination of the application shows it to meet the requirements of the EPC. Substantive examination of an application will only start upon explicit request. *Art. 94 EPC  
GL/EPO E-IX, 2.1.3, 2.5.2*
- 5.10.002** The applicant must therefore file a written request for examination. If Form 1200, as recommended, is used (see point 5.1.016), this requirement will always be met since the appropriate check box is pre-crossed (Form 1200, Section 4). *R. 70 EPC*
- 5.10.003** The request for examination is only effective if the examination fee has been paid. Therefore, the examination fee must be paid in due time (see points 5.10.004-5.10.007 and 5.10.011).

### When must the request for examination be filed? When must the examination fee be paid?

- 5.10.004** The request for examination must be filed and the examination fee paid within 31 months from the filing date or, if priority has been claimed, from the earliest priority date, or up to six months after the date of publication of the ISR, whichever time limit expires later. Therefore, as a rule and unless the ISR was published after 25 months from the date of filing or the earliest priority date, the request for examination must be filed and the examination fee paid within the 31-month time limit. *R. 70(1), 159(1)(f) EPC  
Art. 2(1)6 RFees  
GL/EPO C-II, 1.2*
- 5.10.005** In most cases the request for examination must be filed and the examination fee must be paid before the supplementary European search report is transmitted to the applicant (see point 5.9.011). After transmission of the report, the EPO will invite the applicant to indicate whether he wishes to proceed further with the application (see point 5.9.011). The applicant can waive his right to be asked whether he wishes to proceed further with the application, e.g. by ticking the second check box in Section 12.2 of Form 1200. *R. 70(2) EPC*
- 5.10.006** On the right to a refund of the examination fee see points 5.9.014 ff.
- 5.10.007** Neither the drawing-up of a supplementary European search report (see points 5.9.001 ff) nor publication of the translation of the Euro-PCT application (see points 5.5.001 ff) affect the time limit for filing the request for examination and payment of the examination fee.

### Are reductions of the examination fee possible?

- 5.10.008** According to Rule 6(4) EPC, the examination fee is reduced by 30% for small and medium-sized enterprises, natural persons, non-profit organisations, universities or public research *Art. 14(4) EPC  
R. 6 EPC  
OJ 2014, A4, A23  
GL/EPO A-X, 9.2.3*



organisations that have their residence or principal place of business in an EPC contracting state having an official language other than English, French or German, and nationals of such states who are resident abroad, provided that they make the declaration under Rule 6(6) EPC and that the request for examination is made in the official language of that EPC contracting state ("admissible non-EPO language"). The declaration under Rule 6(6) EPC can be made by ticking the second check box in Section 4.1 of Form 1200. Applicants having their residence or principal place of business within such a contracting state but not complying with the definition under Rule 6(4) EPC may still file documents in an admissible non-EPO language, but will not qualify for a fee reduction. If there are multiple applicants, all of them must fulfil the requirements of Rule 6 EPC.

### ***Reduction if IPER was issued by the EPO***

**5.10.009** The examination fee is reduced by 75% where the EPO acting as IPEA has already drawn up an international preliminary examination report in respect of the relevant Euro-PCT application, unless in the European phase the applicant is seeking a patent for an invention which is not the subject of that report (see points 4.2.027 and 4.2.037 ff).

*Art. 14(2) RFees  
OJ 2018, A4  
GL/EPO A-X, 9.3.2*

**5.10.010** If the conditions for both reductions (see points 5.10.008-5.10.009) are fulfilled, the examination fee is first reduced by 75%. The 30% reduction is applied to the resulting total and not to the full fee. Therefore, the total reduction in relation to the full fee is 82.5%.

## What happens if the time limit for filing the request for examination and payment of the examination fee is not observed?

- 5.10.011** If the request for examination is not filed or the examination fee is not paid in due time, the application is deemed to be withdrawn. The applicant is informed of this in a communication under Rules 112(1) and 160(2) EPC. If only the examination fee was not paid in due time, the loss of rights is deemed not to have ensued if within two months after notification of this communication further processing is requested by payment of the further processing fee, which amounts to 50% of the examination fee, together with the missing examination fee (see points 5.16.004 and 5.19.001).  
*Art. 121 EPC  
R. 135, 160(2) EPC  
Art. 2(1)12 RFees*
- 5.10.012** If the applicant neither filed the request for examination nor paid the examination fee in due time, further processing must be requested in respect of **both omissions**, i.e. in respect of filing the request for examination and payment of the examination fee. It follows that the applicant must file the request for examination and pay the examination fee itself together with two fees for further processing: the flat fee for further processing in respect of the omitted act (i.e. the request for examination) and 50% of the late-paid examination fee.  
*GL/EPO E-VIII, 2*
- 5.10.013** Since the request for examination including payment of the examination fee does not form part of the national (filing) fee (see point 5.7.001), applicants cannot request reinstatement of rights under Rule 49.6 PCT.  
*Art. 22(1) PCT  
R. 49.6 PCT*
- 5.10.014** If the time limit for requesting further processing has been missed (see point 5.10.011), a request for re-establishment of rights in respect of the period under Rule 135(1) EPC may be filed. The request is not deemed to have been filed until the fee for re-establishment relating to the omitted act has been paid. Since filing the request for examination and payment of the examination fee constitute a unitary procedural act, only one fee for re-establishment has to be paid (see points 5.19.001 and 5.19.003). Attention is drawn to the further requirements under Article 122 and Rule 136 EPC for the request to be admissible and allowable.  
*Art. 122 EPC  
R. 136 EPC  
Art. 2(1)13 RFees  
GL/EPO E-VIII, 3.1.3*

## 5.11 Renewal fee and claims fees

### Renewal fee

- 5.11.001** The renewal fees for a pending Euro-PCT application must be paid to the EPO. These fees are due in respect of the third and each subsequent year, calculated from the date of filing of the Euro-PCT application as accorded by the receiving Office. They may not be paid more than three months before they fall due, except for the third-year renewal fee, which may be paid up to six months before due. As a consequence, it may be paid together with the other fees payable within the 31-month time limit.  
*Art. 11(3) PCT  
Art. 86(1), (2) EPC  
R. 51(1), (2),  
159(1)(g) EPC  
Art. 2(1)4, 2(1)5  
RFees  
GL/EPO A-X, 5.2.4  
OJ 2018, A2*

**5.11.002** If the renewal fee for the third year falls due within the 31-month time limit for entry into the European phase, the due date is deferred and the fee may be paid without surcharge up to expiry of the 31-month time limit. If a renewal fee is not paid on time, it may still be paid within six months of the due date ("grace period"), provided it is paid with a 50% surcharge ("additional fee"). If the third-year renewal fee falls due on expiry of the 31-month time limit but is not paid, this six-month period is computed from the date of expiry of the 31-month time limit.

*R. 159(1)(g),  
51(2) EPC*

**What happens if the time limit for payment of the renewal fee and the additional fee is not observed?**

**5.11.003** If the renewal fee is not paid within the six-month grace period the application is deemed to be withdrawn and the applicant is informed of this in a communication under Rule 112(1) EPC. As a means of redress, the applicant can file a request for re-establishment of rights in respect of the period for paying the renewal fee and the additional fee. The request is not deemed to have been filed until the fee for re-establishment relating to the omitted act, i.e. paying the renewal fee with the additional fee, has been paid. Attention is drawn to the further requirements under Article 122 and Rule 136 EPC for the request to be admissible and allowable (see point 5.15.010).

*Art. 122 EPC  
R. 51(2), 136 EPC  
Art. 2(1)13 RFees  
OJ 2016, A102,  
A103*

**Claims fees**

**5.11.004** If the application documents on which the European grant procedure is to be based contain more than fifteen claims, a claims fee is payable within the 31-month period in respect of the sixteenth and each subsequent claim, and a higher claims fee is payable in respect of the 51st and each subsequent claim.

*R. 162 EPC  
Art. 2(1)15 RFees  
GL/EPO A-III, 9;  
E-IX, 2.1.3 and 2.3.8*

**5.11.005** The claims fees must be calculated on the basis of the number of claims contained in the application in the version that is, in accordance with the indications in Form 1200, to be taken as the basis for processing in the European phase (see point 5.4.032). However, where the number of claims changes as a consequence of a later (further) amendment filed before expiry of the time limit set in the Rule 161/162 communication, the number of claims fees due must be computed on the basis of the claims on file upon expiry of the six-month period set in the Rule 161/162 communication (see point 5.4.034). For further information, please refer to the examples given in OJ 2016, A103, points 3.1 and 3.2.

*OJ 2016, A102,  
A103*

**5.11.006** If the applicant has already paid claims fees within the 31-month period, and the number of claims is reduced as a result of amendments filed within the six-month time limit set in the Rule 161/162 communication, any claims fees paid in excess of those due will be refunded after expiry of that time limit (see point 5.4.035).

*R. 162(3) EPC*

### **What happens if the time limit for payment of the claims fee is not observed?**

- 5.11.007** Where the applicant fails to pay (the correct amount of) the claims fees within the 31-month period, the EPO will invite him by means of the Rule 161/162 communication to pay the missing amount within a non-extendable period of six months (see point 5.4.033). *R. 162(2) EPC  
GL/EPO E-IX, 2.1.3*
- 5.11.008** If additional claims fees become due as a result of amendments filed within the six-month period, the applicant must pay these further claims fees within that same period, since no further invitation under Rule 162 EPC will be issued (see point 5.4.032).
- 5.11.009** Where a claims fee is not paid within the six-month period, the claim concerned is deemed to be abandoned. The applicant is informed of the loss of rights in a communication under Rule 112(1) EPC. Further processing can be requested within two months from notification of the communication by payment of the further processing fee, which amounts to 50% of the claims fee(s) due, together with the missing claims fee(s) (see points 5.19.001 and 5.19.003). Features of a claim deemed to have been abandoned and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims (see point 5.4.036). *Art. 121 EPC  
R. 135, 162(4) EPC  
Art. 2(1)12 RFees  
J 15/88 (OJ 1990, 445)*

## **5.12 Filing of other documents**

### **What happens if data regarding the inventor or an applicant is missing?**

- 5.12.001** If within the 31-month time limit the inventor has not been designated or certain information regarding the inventor or any applicant is missing, the EPO will invite the applicant to file the designation of the inventor or to submit the missing data within two months from the notification of a communication under Rule 163(1) or (4) EPC (see point 2.8.002). *Art. 4(1)(iii), (v),  
22(1), 27(2) PCT  
R. 51bis.1(a)(i) PCT  
Art. 81 EPC  
R. 19, 41(2)(c)  
and 163(1)(4) EPC  
GL/EPO E-IX, 2.3.1,  
2.3.4*

### **What happens if the requirement to file any missing data regarding the inventor or an applicant is not observed?**

- 5.12.002** If within the two-month time limit set in the invitation the missing data have not been filed, the application is refused. *R. 163(6) EPC*
- 5.12.003** The refusal may be remedied by a request for further processing. The request will be granted if within two months from notification of the decision the missing data are filed and the fee for further processing is paid. *Art. 121 EPC  
R. 135 EPC  
Art. 2(1)12 RFees*

## Certificate of exhibition

- 5.12.004** Where relevant, the certificate of exhibition is to be filed within the 31-month time limit. If the document is not filed in due time, the applicant's disclosure at the relevant exhibition will be taken into account for the purposes of establishing whether the invention claimed is new under Article 54 EPC. The relevant exhibitions falling within the terms of the EPC are published every year in the Official Journal.
- Art. 54, 55(2) EPC  
R. 25, 159(1)(h) EPC  
GL/EPO A-IV, 3*
- 5.12.005** If the certificate is not filed in due time, the applicant is informed of this in a communication under Rule 112(1) EPC. The omission may be remedied by a request for further processing. The request will be granted if within two months from notification of the communication the certificate is furnished and the fee for further processing is paid.
- Art. 121 EPC  
R. 135 EPC  
Art. 2(1)12 RFees*
- 5.13 Priority claim**
- 5.13.001** An international application may claim the priority of an earlier application that was filed in any state party to the Paris Convention for the Protection of Industrial Property or for any member of the World Trade Organization (see points 2.13.001 ff). The file number of the earlier application, if known at the time of filing the international application, is to be provided in Box VI of the PCT request form. In the proceedings before the EPO as designated/elected Office, the priority application is referred to as the "previous application", which corresponds to the terminology used in the EPC.
- R. 4.1(a)(ii), 4.10, 17.1, 17.2 PCT  
Art. 87(1)(b), 88(1) EPC  
R. 163(2)(6), 53 EPC  
OJ 2007, 692  
GL/EPO E-IX, 2.3.5*
- 5.13.002** As a rule the applicant is required to provide the file number and to file a certified copy of the previous application with the receiving Office or the IB during the international phase, i.e. within 16 months of the (earliest) priority date (see point 2.15.001), so that both will be available to the EPO on entry into the European phase (see points 2.15.001 and 5.13.009). Alternatively, where the previous application was filed as a national application with a national office that participates in the Digital Access Service (DAS) (or was an EP application filed on or after 1 November 2018), the IB may be requested to obtain a certified copy of the previous application from DAS. For that purpose a check box and a text field for the required access code are provided in Box No. VI of the PCT request form (see points 2.2.032, 2.15.003 and 5.13.006). If the applicant does not provide the file number and a certified copy during the international phase, they are given an opportunity to file them upon entry into the European phase (see points 5.13.004 ff). In this regard, since 1 November 2018 applicants have been able to ask the EPO as designated Office to obtain certain priority documents via DAS (see point 5.13.006).

- 5.13.003** A request for restoration of the right of priority may be (re)filed with the EPO as designated/elected Office (see points 5.13.018 ff). *R. 49ter.2 PCT OJ 2007, 692*
- When is there an obligation to file the priority document with the EPO?**
- 5.13.004** If, during the international phase, the applicant did not submit a certified copy of the previous application (this copy being known as the "priority document") and indicate the file number of the application from which priority is claimed, he must provide the EPO with the priority document and/or file number upon entry into the European phase.
- 5.13.005** A priority document may be filed electronically with the EPO using OLF or the CMS, provided it has been digitally signed by the issuing authority and the EPO can accept and verify the signature. It must be in a format accepted for filing via the aforementioned means, i.e. XML or PDF, in accordance with the Administrative Instructions under the PCT, Part 7 and Annex F. It cannot be filed by fax or using the EPO Web-Form Filing service. By way of example, the EPO accepts electronic priority documents issued and digitally signed by the USPTO and Brazil's National Institute of Industrial Property. *OJ 2007 Spec.Ed.3, A.3 OJ 2018, A45, A78, A79, A93, A94*
- 5.13.006** Since 1 November 2018, for international applications entering the European phase before the EPO as designated Office, the EPO has been able to access priority documents via the Digital Access Service (DAS), provided that the previous application was filed with another participating office. To make use of this service, applicants first ask the office with which the previous application was filed, the office of first filing (OFF), to make the priority document available via DAS, and then ask the EPO to retrieve it there by providing the access code given to the document by the OFF. The access code can be specified using EPO Form 1013. DAS is free of charge for applicants. Currently 19 countries participate in it.<sup>40</sup> *OJ 2018, A27, A78, A79 PCT Newsletter 11/2018, 3*
- 5.13.007** If priority is claimed from an application filed with an office which does not participate in DAS, and where the IB already has a copy of the previous application because it received one from the receiving Office or direct from the applicant, it will forward a copy to the EPO. In such cases, the applicant therefore does not need to provide the EPO with the priority document. When the IB receives priority documents, it uploads them to its PATENTSCOPE database. *R. 17.1, 17.2 PCT GL/EPO E-IX, 2.3.5*
- 5.13.008** Moreover, in the cases listed below, the EPO as designated/elected Office will include a **copy of the priority application** free of charge in the file of a Euro-PCT application even without having received a copy from the IB. The applicant will be informed of this inclusion unless the previous application is a *R. 53(2) EPC OJ 2018, A78 GL/EPO E-IX, 2.3.5*

<sup>40</sup> For a list of the participating offices, see [www.wipo.int/das/en/participating\\_offices.html](http://www.wipo.int/das/en/participating_offices.html).



European application or an international application filed with the EPO as receiving Office. This service is provided on condition that the applicant has informed the EPO of the application number and only if the priority application is:

- a European patent application;
- an international application filed with the EPO as receiving Office;
- a Chinese patent or utility model application;
- a Japanese patent or utility model application;
- a Korean patent or utility model application;
- a United States provisional or non-provisional patent application.

#### **What happens if the requirement to file the priority document or the file number is not observed?**

- |                 |  |   |
|-----------------|--|---|
| <b>5.13.009</b> | Where a certified copy of the previous application or, where no copy must be filed (see points 5.13.007 and 5.13.008), the file number has not yet been submitted on entry into the European phase, the applicant will be invited to furnish that certified copy or number within two months from the date of a notification under Rule 163(2) EPC. This time limit cannot be extended. If the certified copy or the file number is not submitted within that time limit, the priority right is lost.                            | <i>R. 163(2)(6) EPC</i>   |
| <b>5.13.010</b> | The loss of rights may be remedied by requesting further processing. The request will be granted if within two months from notification of the loss of rights the certified copy of the previous application or the file number is filed and the fee for further processing paid (see also point 5.19.001).  | <i>Art. 121 EPC<br/>R. 135 EPC<br/>Art. 2(1)12 RFees</i>                                  |
| <b>5.13.011</b> | If a priority document has not been received from the IB (see point 5.13.007) and is missing on PATENTSCOPE but the applicant has requested the receiving Office to forward the priority document(s) to the IB or requested the IB to obtain the certified copy of the previous application(s) from DAS, no loss of rights will occur. In such case substantive examination may nevertheless begin, but the decision to grant will not be taken until the priority document is furnished. The applicant is informed accordingly. | <i>R. 17.1(b),<br/>17.1(b-bis),<br/>17.2(a) PCT<br/>GL/EPO E-IX, 2.3.5;<br/>F-VI, 2.1</i> |

#### **Is it necessary to file a translation of the priority document?**

- |                 |   |  |
|-----------------|---|--|
| <b>5.13.012</b> | Where the priority document is not in English, French or German, and the validity of the priority claim is relevant for determining whether the invention concerned is patentable, a translation in one of these languages must be submitted at the invitation of the EPO. If a translation is already available to the EPO, it will not issue an invitation. | <i>R. 51bis.1(e) PCT<br/>R. 53(3) EPC<br/>OJ 2007, 692<br/>OJ 2013, 150<br/>GL/EPO A-III, 6.8;<br/>F-VI, 3.4</i> |
|-----------------|---|--|



- 5.13.013** The translation need not necessarily be in the language of the proceedings as long as it is in English, French or German (see point 5.1.014).
- 5.13.014** Where the international application is a complete translation of the previous application, a declaration to that effect is sufficient and no invitation to file a translation will be issued (Form 1200, Section 7.3). This means that if the priority application is, for instance, a national application filed in Spanish, the applicant may declare that his international application filed in, for instance, English is a complete translation of the Spanish priority application. A translation from Spanish into an official language of the EPO is in that case not required. *R. 53(3) EPC  
GL/EPO A-III, 6.8.6*
- 5.13.015** A translation of the priority document may also be requested where the application was filed (in part) on the basis of incorporation by reference. *R. 51bis.1(e)(ii) PCT*

### **What happens if the requirement to file the translation or declaration is not observed?**

- 5.13.016** If the applicant does not provide the translation of the priority document in time, the right of priority is lost and the applicant is informed accordingly. This has the effect that the intermediate document(s) which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability will belong to the prior art under Article 54(2) or Article 54(3) EPC, as applicable. *Art. 54(2)(3) EPC  
R. 53(3) EPC  
OJ 2013, 150  
GL/EPO A-III, 6.10*
- 5.13.017** If the priority right is lost, further processing can be requested and will be granted if within two months from notification of the loss of rights the required translation or declaration is filed and the fee for further processing paid. *Art. 121 EPC  
R. 135 EPC  
Art. 2(1)12 RFees  
GL/EPO A-III, 6.8.3*

### **Restoration of priority under Rule 49ter PCT**

- 5.13.018** If the international application was filed more than 12 months from the filing date of the previous application whose priority is claimed, the applicant may file a request for restoration of priority with the EPO as receiving Office and as designated/elected Office. For information on the procedure before the EPO as receiving Office see point 2.14.001. *R. 26bis.2 PCT  
R. 49ter.1 and .2  
PCT  
Art. 122 EPC  
GL/EPO E-IX, 2.3.5  
OJ 2007, 692  
PCT Newsletter  
9/2015, 10*
- 5.13.019** The EPO in its function both as receiving Office and as designated/ elected Office will grant such a request only if the failure to claim the right of priority within the priority period occurred *in spite of due care required by the circumstances having been taken*. The requirement of due care is applied by the EPO in accordance with its standing practice under Article 122 EPC. The second criterion referred to in the PCT, whether the failure was *unintentional*, does not play a role in the procedures before the EPO. Therefore, a request for restoration of the priority right that was granted by the receiving Office under the "unintentional" criterion does not have any effect before the EPO as designated/elected Office (see point 5.13.022).

- 5.13.020** As set out hereafter (see points 5.13.021 ff), if the applicant has already filed a request for restoration of priority with the receiving Office, a (new) request need not always be filed upon entry into the European phase.
- 5.13.021** If the priority right was restored by the receiving Office under the "due care" criterion, no new request need be filed with the EPO as designated/elected Office, since the EPO will, as a rule, recognise the decision of the receiving Office. If, however, the EPO has reasonable doubt that the requirements for grant were met, it will notify the applicant accordingly. In this communication the reasons for such doubt will be indicated and a time limit will be set within which the applicant may submit comments.
- 5.13.022** If the priority right was restored by the receiving Office under the "unintentional" criterion, a new request needs to be filed with the EPO as designated/elected Office, since the EPO is not bound by the decision of any receiving Office under the "unintentional" criterion (see points 5.13.019 and 5.13.024).
- 5.13.023** The EPO as designated/elected Office will grant a request for restoration of the priority right only if the following requirements are met:
- the filing date of the international application is within two months of the date on which the priority period expired; *R. 26bis.2(c)(iii) PCT*
  - the failure to claim the right of priority within the priority period occurred in spite of due care required by the circumstances having been taken; *R. 49ter.2(a) PCT*  
*Art. 122 EPC*
  - the request for restoration of priority is filed within one month of the date on which the 31-month time limit for entry into the European phase expired or of the effective date of early entry into the European phase; where the international application is deemed to be withdrawn under Rule 160(1) EPC for failure to comply with a requirement under Rule 159(1) EPC, the request may still be filed with an on-time request for further processing in respect of the 31-month time limit under Rule 159(1) EPC or, failing this, with an on-time request for re-establishment of rights in respect of the period for requesting further processing; *R. 49ter.2(b)(i) PCT*
  - the fee for restoration of priority levied by the EPO is duly paid, the time limit for doing so being the same as for the request for restoration of priority; *R. 49ter.2(b)(iii), (d) PCT*  
*R. 136(1) EPC*
  - the request for restoration of priority is accompanied by a statement of reasons for the failure to file the international application within the priority period and preferably by any declaration or other evidence in support of the statement of reasons. *R. 49ter.2(b)(ii) PCT*  
*R. 136(2) EPC*

**5.13.024** If the applicant wants the priority claim to be valid in the procedure before the EPO as designated/elected Office, a request for restoration must always be filed if, in the procedure before the receiving Office:

*R. 49ter.1(d) PCT  
R. 49ter.2(e) PCT  
Art. 113(1) EPC*

- no request for restoration of the priority right was filed;
- the request for restoration of the priority right filed with the receiving Office was rejected;
- a request for restoration of the priority right filed with the receiving Office was granted only under the "unintentional" criterion.

*R. 49ter.1(b) PCT*

## **5.14 Review by the EPO as designated/elected Office and rectification of errors made by the receiving Office or by the IB**

**5.14.001** The EPO as designated or elected Office may review or rectify certain acts of the receiving Office or the IB in the international phase. As regards review of the grant of a request for restoration of the right of priority by the receiving Office, see points 5.13.018 ff.

### **Review by the EPO as designated Office under Article 25 PCT**

**5.14.002** At the request of the applicant, the EPO may review whether a refusal by the receiving Office to accord a filing date, or a declaration on the part of the receiving Office that an international application or the designation of a state is considered withdrawn, or a finding by the IB under Article 12(3) PCT is the result of an error or omission on the part of the authority concerned, in which case the Euro-PCT application can proceed as a European application.

*Art. 25 PCT  
R. 51, 82ter PCT  
R. 159(2) EPC  
GL/EPO E-IX, 2.9*

**5.14.003** To obtain such a review by the EPO as designated Office, applicants must take the following steps:

- The request to the IB under Article 25(1) PCT to send copies of documents in the files promptly to the EPO as designated Office must be made within the two-month time limit under Rule 51.1 PCT.
- The filing fee under Rule 159(1)(c) EPC must be paid and, where required, a translation of the Euro-PCT application furnished within the same two-month time limit (Article 25(2), Rule 51.3 PCT). Applicants are recommended to undertake the remaining steps for entry into the European phase under Rule 159(1) EPC at the same time, possibly together with a request for early processing under Article 23(2) PCT (see points 5.1.023 ff, 5.2.005 ff, 5.5.001 ff).

## **Review by the EPO as designated/elected Office under Article 24 PCT**

- 5.14.004** Pursuant to Article 24(2) PCT the EPO as designated/elected Office may even maintain the application as a European application if this is not required by virtue of the provision in Article 25(2) PCT. The filing of a request under Article 24(2) PCT is governed by the same requirements as a request for review under Article 25(2) PCT, with the exception that the two-month time limit under Rules 51.1 and 51.3 PCT does not apply. The time limit for making a request to be excused under Article 24(2) PCT is subject to national law. Such request may be combined with a request for re-establishment of rights or further processing.
- Art. 24(2), 48(2) PCT  
R. 82bis PCT  
Art. 122, 121 EPC  
OJ 1984, 565  
(Reasons 4)  
J 19/16 (Reasons 6)*
- May errors made by the receiving Office or by the IB be rectified?**
- 5.14.005** If the applicant proves to the satisfaction of the EPO that the international filing date is incorrect owing to an error made by the receiving Office or that the priority claim has been erroneously considered by the receiving Office or the International Bureau not to have been made, and if the error is an error such that, had it been made by the EPO itself, the EPO would rectify it under EPC law or practice, the EPO must rectify the error and treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made.
- R. 82ter.1(a) PCT*
- 5.14.006** Further, if a receiving Office accords the international filing date on the basis of incorporation by reference (see points 2.4.001 ff), the EPO as designated/elected Office will review this finding in terms of whether the requirements listed in Rule 82ter.1(b)(i)-(iii) PCT have been complied with. In particular, the EPO will consider whether the element or part incorporated by reference was indeed missing. For instance, where the international application contained a description and a claim or claims on the international filing date, it is not possible to replace these elements with elements from a priority application. It is also not possible to add elements from a priority application if this would result in the international application having, for instance, two (or more) descriptions or two (or more) sets of claims.
- Art. 11(1)(iii)(d), (e) PCT  
R. 4.18, 20.6,  
82ter.1(b) PCT*
- 5.14.007** If the EPO does not agree with the finding of the receiving Office, it will notify the applicant that it intends to consider the (later) date on which the missing element or part was furnished as the international filing date in the European patent grant procedure. The applicant will be given the opportunity to comment. Further, in the case of missing parts, the applicant may also request that the missing part concerned be disregarded in the European patent grant procedure. In that case, the missing part will be considered not to have been furnished and the EPO will not treat the international application as if the international filing date had been corrected.
- R. 82ter.1(c), (d) PCT*

## 5.15 Lack of unity

**5.15.001** Where the Euro-PCT application does not meet the requirement of unity of invention, the procedure laid down in Rule 164 EPC applies upon entry into the European phase.

**5.15.002** Rule 164 EPC provides the applicant with an opportunity to pay upon invitation, within a two-month period, a further search fee for any invention which has not been searched by the (Supplementary) International Searching Authority in the international phase but which the applicant claims upon expiry of the time limit set in the communication under Rules 161 and 162 EPC. This opportunity is available both where a supplementary European search is to be carried out (the EPO was not the (S)ISA) and where the supplementary European search is dispensed with (the EPO acted as (S)ISA). The further search fees are not subject to the fee reduction under Article 153(7) EPC (see point 5.9.017), which applies only to the search fee payable under Rule 159(1)(e) EPC. Moreover, any further search fees cannot be validly paid until an invitation pursuant to Rule 164 EPC has been issued. The inventions for which a further search fee is paid will be searched by the EPO. The search will not be based on any amendments filed in response to an invitation to pay search fees.

*Art. 82 EPC  
R. 164 EPC  
OJ 2014, A70  
GL/EPO B-VII, 2.3  
GL/EPO C-III, 2.3  
GL/EPO E-IX, 4.2  
G 2/92*

**5.15.003** If the applicant uses automatic debiting, all search fees to be paid under Rule 164 EPC will be automatically debited on the last day of the two-month period set in the invitation. Therefore, if the applicant does not wish to pay any or some of the fees, he must notify the EPO accordingly.

*OJ 2017, Suppl.  
Publ. 5, Annex A.1,  
point 3, Annex A.2,  
Re point 3 AAD, I(b)*

**5.15.004** The further search fees must be paid within the non-extendable two-month time limit set in the invitation. This time limit is excluded from further processing, but re-establishment of rights may be requested.

*Art. 122 EPC  
R. 135(2) EPC  
OJ 2013, 503  
OJ 2014, A70*

**5.15.005** If the applicant disagrees with the finding of lack of unity made by the search division or the examining division, he may request the examining division to review this finding and to refund the search fees paid.

*R. 164(5) EPC*

**5.15.006** An invention that has not been searched by the EPO cannot be prosecuted in examination. Therefore, if the applicant does not take the opportunity to pay search fees under Rule 164 EPC, he will be requested by the examining division to delete any unsearched subject-matter. Any searched or unsearched invention which is not prosecuted in the examination proceedings may be pursued in a divisional application.

*GL/EPO C-III, 3.1.1,  
3.1.2, 3.2  
G 2/92*

### **Supplementary European search to be performed: the EPO did not act as (S)ISA**

**5.15.007** If the application documents which are to serve as the basis for the supplementary European search do not comply with the requirement of unity of invention, the applicant is invited under Rule 164(1)(b) EPC to pay a further search fee for each invention other than the first invention mentioned in the claims. If the

applicant wishes to pay further search fees in response to the invitation under Rule 164(1)(b) EPC, he must do so within the time limit of two months set in the invitation. This period is excluded from further processing under Rule 135(2) EPC.

- |                 |   |   |
|-----------------|---|---|
| <b>5.15.008</b> | Together with the invitation, a partial supplementary European search report together with a provisional opinion on the patentability of the invention (or unitary group of inventions) is drawn up on the invention or group of inventions first mentioned in the claims.  | <i>R. 164(1)(a) EPC<br/>OJ 2017, A20</i>                        |
| <b>5.15.009</b> | The supplementary European search report is then drawn up for the parts of the application relating to inventions for which search fees have been paid. In reply to the accompanying search opinion, the applicant must select, from all inventions searched by the EPO, a single invention to be prosecuted in the European grant procedure. For the other inventions the applicant may file divisional applications.  | <i>R. 164(1)(c) EPC<br/>GL/EPO C-III, 3.1.2, 3.2<br/>G 2/92</i> |
| <b>5.15.010</b> | Although the EPO is in no way bound by the opinion of the ISA on the issue of whether the application meets the requirement of unity, the EPO will in many cases share that opinion, given that the practices of the ISAs are based on the same Guidelines (Chapter 10 of the ISPE Guidelines). Therefore, where the (S)ISA considered the requirement of unity not to be met, the applicant is advised to amend the application in due time (i.e. before expiry of the period under Rule 161(2) EPC) in such a way that the invention on which the applicant wishes the supplementary European search and the examination to be based is that first mentioned in the claims, since if the EPO agrees with the ISA on lack of unity, this invention will then be searched on the basis of the search fee paid according to Rule 159(1)(e) EPC, without the need to pay any additional search fees according to Rule 164(1) EPC, which do not qualify for a fee reduction according to Article 153(7) EPC. |   |

#### **No supplementary search performed: the EPO acted as (S)ISA**

- |                 |  |   |
|-----------------|--|---|
| <b>5.15.011</b> | If the supplementary European search report is dispensed with, the examining division will start substantive examination upon expiry of the time limit set in the communication under Rules 161 and 162 EPC. Where it considers that an invention is claimed which was not searched by the EPO in the international phase, it will invite the applicant to pay a search fee in respect of that invention.  | <i>Art. 19, 34 PCT<br/>R. 161(1), 164(2)<br/>EPC<br/>OJ 2014, A70<br/>GL/EPO C-III, 2.3</i> |
| <b>5.15.012</b> | The examining division will send the applicant the results of any search carried out in respect of an invention for which a search fee has been paid. If the examining division has not found any deficiencies, together with the results it will send the applicant a communication informing him of the text in which it intends to grant the patent and of the related bibliographic data (Rule 71(3) EPC). If the examining division has found deficiencies, together with the results it will send the applicant a communication inviting him to comment on the deficiencies and, where appropriate, to amend the | <i>R. 164(2) EPC<br/>OJ 2014, A70<br/>GL/EPO C-III, 2.3</i>                                 |



application (Article 94(3) EPC and Rule 71(1) and (2) EPC). Where appropriate, the applicant must limit the application to a single searched invention to be prosecuted in the patent grant procedure. For any searched or unsearched subject-matter, divisional applications may be filed.

## 5.16 Publication of the Euro-PCT application by the EPO

**5.16.001** In principle, the international publication of an international application takes the place of the publication of a European patent application.

*Art. 11(3), 29(1)(2)  
PCT  
Art. 67, 153(3)(4)  
EPC  
GL/EPO E-IX, 2.5.1*

**5.16.002** In accordance with this principle, a Euro-PCT application published by the IB in an **official language of the EPO** enjoys, subject to the provisions of Article 67(3) EPC, provisional protection **as from the date of the international publication**. The EPO will, once the application has entered the European phase, notify the applicant of the publication of the bibliographic data of the Euro-PCT application in the European Patent Bulletin and confirm that the application, subject to the provisions of Article 67(2) and (3) EPC, enjoys provisional protection in the individual EPC contracting states.

**5.16.003** If the Euro-PCT application was published by the IB in a **language other than one of the three official languages** of the EPO, the EPO will publish the translation of the Euro-PCT application submitted by the applicant upon entry into the European phase (see point 5.5.001). In that case the provisional protection is, subject to Article 67(2) and (3) EPC, only effective **as from the date of publication of the translation** by the EPO.

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

*R. 48.2 PCT*

- the description as originally filed;
- the claims as originally filed;
- any claims amended under Article 19 PCT including the statement under Article 19 PCT;
- any drawings as originally filed;
- the sequence listing forming part of the description (see point 5.6.010);
- the abstract;
- any appendices to the application;
- any certificate(s) of the deposit of biological material;
- the translation of the ISR.



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

- 5.16.005** Pursuant to Article 153(6) EPC the international search report takes the place of the European search report. Once the supplementary European search report has been drawn up, this will be mentioned in the European Patent Bulletin, Part I.1(4). The supplementary search report itself is not published but is available via public file inspection.

## 5.17 State of the art

- 5.17.001** Upon payment of the filing fee (including any page fee) and, where required, receipt of the translation, an international application is considered as comprised in the state of the art under Article 54(3) EPC (see points 5.5.006 and 5.7.012).
- Art. 54(3), 153(5) EPC  
R. 165 EPC  
GL/EPO G-IV, 5.2*

## 5.18 Divisional applications

- 5.18.001** One or more divisional applications can be filed for any earlier Euro-PCT application that is pending before the EPO as designated or elected Office. A Euro-PCT application is pending before the EPO as designated or elected Office if the applicant has fulfilled all the requirements for entering the European phase and either the 31-month period under Rule 159(1) EPC has expired or a request for early processing under Article 23(2) or 40(2) PCT has become effective at the latest on the day the divisional application is filed.
- Art. 76 EPC  
R. 36 EPC  
OJ 2013, 156, 501  
GL/EPO A-IV, 1.1, 1.1.1, 1.3.3;  
E-IX, 2.4.1  
J 18/09, OJ 2011, 480*

The divisional application must be filed in the language of the proceedings of the earlier (parent) application. Alternatively, if the earlier application was filed in a language other than an EPO official language, the divisional application may be filed in that language. In this case, a translation into the language of the proceedings of the earlier application must be filed within two months of the filing of the divisional application.

## 5.19 Further processing and re-establishment of rights

- 5.19.001** If a Euro-PCT application is refused or deemed to be withdrawn following the non-observance of a time limit in the European phase, the applicant may request further processing or, where further processing is no longer available, re-establishment of rights (see e.g. points 5.5.009, 5.5.014, 5.6.012, 5.7.013, 5.7.016, 5.8.006, 5.8.008, 5.9.020, 5.9.022, 5.10.011, 5.10.014, 5.11.003, 5.11.009 and 5.13.010). Requests for further processing and for re-establishment of rights are made by performing the omitted act and by paying the applicable fee.
- Art. 121, 122 EPC  
R. 135, 136 EPC  
GL/EPO E-VIII, 2, 3  
Art. 2(1)12, first and third indents, RFees*

**5.19.002** Omitting to take the steps necessary to enter the European phase within the 31-month time limit amounts to non-observance of several time limits. Further processing must be requested for each omitted step. The applicant is informed accordingly in a communication of loss of rights (EPO Form 1205N). The requests for further processing must be filed and the deficiencies remedied within two months of notification of the communication.

*Art. 94(1) EPC  
R. 70(1) EPC  
GL/EPO E-VIII, 2  
Art. 2(1)12 RFees  
R. 112, 160 EPC*

**5.19.003** For omitted procedural acts (e.g. late filing of a translation), the further processing fee is a flat rate (fee code 122). For late payments, the further processing fee amounts to 50% of the late-paid fee (fee code 123).

Separate further processing fees must be paid for each omitted act comprising a unitary procedural act.

For example:

- If the applicant pays the filing fee, including any page fee due, after expiry of the 31-month period, two fees for further processing are due, i.e. 50% of the late-paid filing fee and 50% of the late-paid page fee (see point 5.7.013).
- If the applicant submits the request for examination and pays the examination fee after expiry of the 31-month period, two fees for further processing are due, i.e. the (flat rate) fee for the late-filed request and 50% of the late-paid examination fee (see point 5.10.012).
- If the applicant files a sequence listing late and then fails to pay the late furnishing fee on time, two fees for further processing are due, i.e. one for the late-filed sequence listing and 50% of the late-paid late furnishing fee (see point 5.6.012).

**5.19.004** If the time limit for requesting further processing has expired, the applicant may request re-establishment of rights in respect of that time limit. The request is valid only if the corresponding fee is paid. Re-establishment must be requested for each time limit missed. However, for acts considered to be unitary procedural acts (see point 5.19.003) only **one** fee for each unitary act is due.

*Art. 122 EPC  
R. 136 EPC  
GL/EPO E-VIII, 3  
J 26/95*

For example:

- If the applicant, having failed to pay the filing fee including the page fee on time, then fails to request further processing on time, only one fee for re-establishment of rights is due in respect of the filing and page fees.
- If the applicant, having failed to file the request for examination and pay the examination fee on time, then fails to request further processing on time, only one fee for re-establishment of rights is due in respect of the request for examination and the examination fee.

For an overview of the fees due for further processing and re-establishment of rights, see the table in GL/EPO E-VIII, 3.1.3.

Attention is also drawn to the further requirements for the admissibility and the allowability of requests for re-establishment of rights, which are outlined in detail in GL/EPO E-VIII, 3.



## **Annex I. Criteria chosen by the EPO as ISA/IPEA on specific points in the ISPE Guidelines**

In a number of cases the ISPE Guidelines leave ISAs/IPEAs the choice between alternative guidelines upon which each ISA/IPEA may rely as appropriate.

The options are set out in the appendices to the chapters of the ISPE Guidelines mentioned below. The paragraph number (e.g. Point A5.16) refers to the relevant paragraph in the chapter concerned (in this case Chapter 5, point 16).

The EPO as ISA/IPEA has chosen the options listed below.

### **Appendix to Chapter 4**

Point A4.05	References to prior art	Option [1] applies
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### **Appendix to Chapter 5**

Point A5.16	Multiple dependent claims	Option [2] applies
Point A5.20	Interpretation of claims	Option [2] applies
Point A5.21	The EPO applies the first sentence concerning "use" claims	
Point A5.26	Product-by-process claims	Option [1] applies
Point A5.42	Conciseness	Option [2] applies

### **Appendix to Chapter 9**

Point A9.07	Excluded subject matter	Option [2] applies
Point A9.15	Programs for computers	Option [2] applies

### **Appendix to Chapter 12**

Point A12.02	Novelty: effective date	Option [1] applies
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### **Appendix to Chapter 13**

Point A13.08	The EPO applies the problem-solution approach	
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### **Appendix to Chapter 14**

Point A14.01[2]	The EPO applies the criterion of industrial applicability	
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### **Appendix to Chapter 20**

Point A20.21	Disclaimer	Option [2] applies
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