

### Consultation results of the 26th SACEPO WP/G meeting on 10 October 2023 – PCT-EPO Guidelines

| # |   | Comment  | Suggestion  | Consultation results   |
|---|---|--|---|--|
| 1 | General comment for the whole PCT-EPO Guidelines: | <p>Although we acknowledge that renumbering is in particular cases essential, it may be very inconvenient for users, esp. EQE candidates, tutors and editors of reference material and Q&amp;A books, who all extensively refer to the Guidelines sections.</p> <p>Examples of un-necessary renumbering:<br/>A-II, 1.2.2<br/>A-II, 1.2.3</p> | It is requested to keep the numbering as consistent as possible between the various editions of GL/EPI and GL/PCT-EPO, as well as the Euro-PCT Guide. | <p>The Office confirmed that the issue raised by users has been duly noted and that it is also the Office's intention to limit renumbering of sections to what is strictly necessary. The renumbering of the sections cited as examples was necessary as one important aim of this year's revision was "digital first", as agreed with users at the SACEPO WP/G meeting on 4 May 2023.</p> <p>There were no further comments from SACEPO WP/G members.</p> |

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| 2 | General part |         |         | <p><b>General part</b><br/>Part A on accordance of a date of filing and the formalities examination is not reflected in the title of the Guidelines.</p>        | It would be better to amend the title of the GL/PCT-EPO to read <b>"Guidelines for Examination at the EPO as PCT Authority"</b>   | <p>The Office noted that this was a recurrent comment and maintained its position that the title should not be changed since it reflects the EPO's core activities in the international phase.</p> <p>There were no further comments from SACEPO WP/G members.</p> |
| # | Part A       | Chapter | Section | Comment   | Suggestion  | Consultation results   |
| 3 | A            | I       | 1-3     | <p>3. Other Parts relating to formalities</p> <p>It should be noted that information on the formal requirements for international (PCT) applications is not</p> | The description in section 3 "Other chapters of the PCT-EPO Guidelines may be also be necessary for the work carried out by formalities officers." renders the scope of part A unclear. | The Office agreed to the proposal.   |

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|   |      |         |         | restricted to this Part A. Other chapters of the PCT-EPO Guidelines may also be necessary for the work carried out by formalities officers.  | Suggestion: replace "may be also" by "are" and add that the formal requirements refer to filing of IA as well as before EPO as International Authority.   |   |
| 4 | A    | II      | 1.3     | In the international phase, priority documents and authorisations may not be filed with the EPO as receiving Office by fax or using the EPO Web-Form Filing service. Priority documents may not be filed by fax, using the EPO web-form filing service or using the EPO Contingency Upload Service.  | <b>(editorial)</b> Change paragraph between "Filing service." and "Priority documents"  | The Office agreed to the proposed change.   |
| 5 | A    | II      | 3.2     | In such cases, the national authority will act as the "filing office" for the EPO acting as receiving Office. The date of receipt of the application by the national authority will be considered to be the international filing date, provided that the application meets the PCT requirements for a filing date to be accorded (see GL/PCT-EPO A-II, 4.1). | The sentence does not clarify , which office accords the filing date (Filing Office or Receiving Office) GL/RO Chapter IV, paragraph 43. Please add that this is the RO.  | The Office agreed to clarify this point.  |
| 6 | A    | II      | 6.2     | <b>A-II, 6.2</b> – How to calculate additional page fees in the situation of PCT Rule 20.5bis(d)?<br>No information is given w.r.t. page fees when Rule 20.5bis is used  | Please specify how page fees are determined when Rule 20.5bis(b), (c) or (d) is used.<br>Is the page fee for Rule 20.5bis(b) and (c) only determined by the number of correct pages and are the erroneously filed pages fully ignored?<br>Is the page fee for Rule 20.5bis(d) only determined by the total number of erroneously filed and correct pages together, i.e., are the erroneously filed pages also counted? What if the correct pages are filed after the filing fee has been paid (e.g., payment at original filing date) | The Office stated that this was a new comment. It will therefore be addressed during the next revision of the Guidelines. |

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|   |      |         |         |  | but still within the payment period? What if the correct pages are filed the 1m period to pay the filing fee has expired?  |  |
| 7 | A    | III     | 8.2     | <p>The list of these states can be found on the EPO website (epo.org, under Applying for a patent → Fees → International (PCT) fees → Decisions and notices relating to PCT fees → Reduction in international search and preliminary examination fees).</p> <p>This is not easy to find.</p> <p>Further, OJ EPO 2022, A72 has been superseded by "Notice from the European Patent Office dated 10 July 2023" concerning the reduction of the fees for the international search and the international preliminary examination carried out on international applications in favour of nationals of certain states... (probably in OJ of July 2023)</p> | Add link<br>Update with new Notice to "Notice from the European Patent Office dated 10 July 2023"  | <p>The EPO agreed to the proposal.</p> <p>Regarding the outdated reference to the OJ notice, the Office confirmed that it will be replaced. The version of the Guidelines shared with SACEPO WP/G members was finalised in June 2023 and therefore did not cover the information contained in the July OJ.</p>   |
| 8 | A    | III     | 9.2.1.2 | Partial refund   | Add the level of refund  | The Office agreed to the proposal.   |
| 9 | A    | VI      | 1.6     | Any deficiencies cannot be remedied after that, and in particular not in the European phase.   | <p>Delete ", and "in particular not". Why discussing practice of other authorities?</p> <p>Better to amend to "Any deficiencies cannot be remedied after that in the European phase.</p> | <p>It was agreed that "after that" will be replaced with "after the filing date of the international application" and that a statement will be added to clarify that the sentence does not refer to the practice of other offices on entry into the national/regional phase.</p> <p><i>Subsequent development:</i><br/>As the decision on G 1/22 and G 2/22 has now been taken, the Office will reconsider this comment on that basis.</p> |

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| 10 | A      | VI      | 1.6     | The proposed clarification is appreciated.<br>A reference to G 1/22 should be added irrespectively when the decision may arrive.<br>If G 1/22 has will be decided before Dec 2023, it is suggested to also include a short reference to, and a headline of, that decision in this section, as it will clarify a specific situation where different applicants are involved. | Add reference to G 1/22!  | The Office stated that a reference to a pending decision should not be added.<br><br>There were no further comments from SACEPO WP/G members.<br><br><i>Subsequent development:<br/>As the decision on G 1/22 and G 2/22 has now been taken, the Office will reconsider this comment on that basis.</i> |
| 11 | A      | VII     | 2.1     | The proposed clarification is appreciated.<br>However, it refers to GL/PCT-EPO A-VII, 3.2 but that simply refers to GL/PCT-EPO B-XI, 2.2  | Change reference to GL/PCT-EPO B-XI, 2.2  | The Office agreed to the proposal.  |
| 12 | A      | VII     | 2.2     | The proposed clarification is appreciated.  |   | The Office expressed thanks for the positive comment.   |
| 13 | A      | VII     | 2.3     | The proposed clarification is appreciated.  |   | The Office expressed thanks for the positive comment.   |
| 14 | A      | VIII    | 1.4     | The sentence "This kind of "representation" has to be distinguished from representation by an agent. " was deleted, rather than -as requested in an earlier round of commenting- clarified. However, as the sentence was included before, there must be some kind of relevance to this difference.  | It is requested to maintain the sentence "This kind of "representation" has to be distinguished from representation by an agent. and to indicate what the relevance and effect of this difference is. | The Office stated that it had been agreed with members at the SACEPO WP/G meeting on 4 May 2023 that the wording of this section should be aligned with EPC GL A-VIII, 1.3.<br><br>There were no further comments from SACEPO WP/G members.   |
| #  | Part B | Chapter | Section | Comment   | Suggestion  | Consultation results  |
| 15 | B      | II      | 6       | New section following the results of SACEPO 25, point 11  | Please add a sentence as in C-II, 5: "The same applies to any agent or other person   | The Office agreed to clarify this point.  |

| #  | Part   | Chapter | Section | Comment  | Suggestion  | Consultation results   |
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|    |        |         |         | This is appreciated. However it does not clarify the situation when the agent is authorized to practice before the RO and the EPO is not the RO.   | entitled to practice before the RO with which the international application was filed (Article 49 PCT) (see GL/PCT-EPO A-VIII, 1.1)." |  |
| 16 | B      | VIII    | 2.2.1   | B-VIII, 2.2.1 – Here reference is made to "Agreement between the EPO and WIPO under the PCT". The official name of the agreement is "Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization" or abbreviated "Agreement between the European Patent Organisation and the IB of WIPO".<br>Using the abbreviation "EPO" in B-VIII, 2.2.1 is wrong, because this means "European Patent Office" – according to the definition in General Part, 2.5. | Please include somewhere on the EPO home page the consolidated version of the agreement.  | The Office stated that it cannot agree to the proposal. The abbreviation is used throughout the PCT/EPO Guidelines as well as in the Euro-PCT Guide.<br><br>There were no further comments from SACEPO WP/G members. |
| #  | Part C | Chapter | Section | Comment  | Suggestion  | Consultation results   |
| 17 | C      | II      | 1 and 2 | <b>C-II, 1 and 2</b> – in the margin reference is made to "Agreement EPO-WIPO".  | This should be "Agreement between the European Patent Organisation and the IB of WIPO".   | See comment #16.   |
| 18 | C      | VI      |         | It has come to our knowledge that the EPO as ISA or IPEA has developed a practice (likely initiated because many foreign PCT applicants using EPO as ISA or IPEA receive communications) with 1-month period when that period is expiring. It is indeed written nowhere. Applicants who then contact the EPO receive a new calculation: (this is a dummy example)  | Please describe the practice of EPO as IA, when the applicant receives a communication setting a deadline late, in the PCT-EPO GL.    | The Office stated that this was a new comment. It will therefore be considered during the next revision cycle.   |

| # | Part | Chapter | Section | Comment                          | Suggestion | Consultation results   |
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|   |      |         |         | Original mailing date            | 08-07-2018 |  |
|   |      |         |         | Acceptable date of receipt R80.6 | 15-07-2018 |  |
|   |      |         |         | Actual date of receipt           | 10-08-2018 | number of days which the document or letter was received later than seven days after the date it bears = 25 days |
|   |      |         |         | Original due date                | 09-08-2018 | 08-08-2018 but time limit cannot expire on a day the EPO is closed, therefore moved to next open day Rule 80.5   |
|   |      |         |         | New due date under Rule 80.6     | 03-09-2018 | original limit date plus 25 additional days resulting from time difference Rule 80.6                             |

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|                                   |            |         |         | <table border="1"> <tr> <td>Addition of 7-day period of grace</td> <td>10-09-2018</td> <td></td> </tr> </table> <p>It is noted that the 7 days of that grace period match the 7 days of Rule 80.6 PCT, so that the recomputed deadline ends up being 1 month after the actual date of receipt (1 month -7 days +7 days.<br/>Since this is an aggregate time limit, Rule 80.5 is applied at every step, and the result is taken as the <i>dies a quo</i> for the next step.</p>  | Addition of 7-day period of grace  | 10-09-2018  |  |  |  |
| Addition of 7-day period of grace | 10-09-2018 |         |         |   |  |   |  |  |  |
| #                                 | Part F     | Chapter | Section | Comment   | Suggestion   | Consultation results  |  |  |  |
| 19                                | F          | V       | 1       | <p>The Office did not add the reference to ISPE Guidelines 10.01 to 10.04 in particularly to 10.04. The argument is that "<i>The GL/PCT-EPO provide (by reference to GL/EPO F-V, 1 to F-V, 3) a detailed implementation of the more general principles given in ISPE-GL, 10.01 to 1.10.</i>"</p> <p>In our view, the important statement in 10.04 is "<b>If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case is considered on its merits, the benefit of any doubt being given to the applicant.</b>"</p> | <p>The statement in bold in the left column is not reflected in the EPC GL.</p> <p>Further: In our opinion it should be the reverse (GL/EPO referring to GL/PCT-EPO including the statement in 10.05 of ISPE) if the PCT criteria apply to Euro-PCT?</p> | <p>The Office stated that such a reference was not necessary as comparable guidance already exists in GL/EPO F-V, 2 and 2.2, which are referred to in GL/PCT F-V, 1.</p> <p>SACEPO WP/G members insisted on the importance of inserting such a reference and invited the Office to reconsider its position in this respect.</p> <p>The Office took note of the request.</p> |  |  |  |

| #  | Part   | Chapter | Section | Comment   | Suggestion | Consultation results                                  |
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| #  | Part G | Chapter | Section | Comment   | Suggestion | Consultation results                                  |
| 20 | G      | IV      | 8       | It is appreciated that the amendment is done to take note of our earlier comments |            | The Office expressed thanks for the positive comment. |