

**PCT-EPO Guidelines – Consultation results on the combined comments received via the public user consultation (01.02. – 02.04.2024)
and the members of the SACEPO WP/G**

#	Part	Chapter	Section	Comment	Suggested improvement	Consultation results
1.	All			There are often considerable changes to EPC related provisions per 1 April, just 1 month after new GL enter into force and with still 11 months until the next GL. This results in the GL being outdated and the public being incompletely informed already after 1 month.	It is suggested to: - Shift the new editions to 1 April. - Update the online version (at least the HTML version) when significant changes are made (e.g. as now with Rule 7a(3)) - In the HTML ToC page of each part, provide a list of OJ EPOs which newly entered into force but were not incorporated yet in the active GL edition.	The Office thanked the commenter and explained that the Guidelines revision cycle makes it difficult to include changes which enter into force after the Guidelines come into force – or, if 1 April were the new publication date, on their date of entry into force – especially when the secondary legislation in question is published only shortly beforehand. However, the Office will address this proposal and others in a feasibility study on the Guidelines revision cycle. See also minutes, point 2.
2.	All			Amendments to PCT Rules usually enter into force on 1 July, and are known well before the preceding 1 December ("copy close of GL/PCT-EPO"). As the GL are drafted to reflect the situation on 1 March, this results in the GL/PCT-EPO being outdated already 3 months after they were issued, despite the changes already being known at the time of drafting.	It is suggested to: - Include any legal changes per 1 July and the EPO practice as to how they are implemented in the GL/PCT-EPO (besides the status on 1 March)	See #1 above.
3.	A	II	1.2.1	<ul style="list-style-type: none"> ▪ Online Filing 2.0 ▪ Web-Form Filing ▪ EPO Contingency Upload Service 	I suggest to add a reference including info on these options that are not widely used.	<p>The Office stated that references to the President's decisions/notices are already contained in this section; additional information on the filing tools is also easily available on the EPO website. Therefore it considered no further reference is necessary.</p> <p>There were no further comments from the SACEPO WP/G members.</p>

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4.	A	II	1.2.2 (filing by fax)	The section indicates that, when using fax, a confirmation copy needs to be filed by post . Is it not also allowed to, alternatively: - file the confirmation copy by delivery by hand, or - file the confirmation copy by OLF or Online Filing 2.0 (e.g., where the person that filed it by fax had no possibility to use online filing)?	Please clarify in this section whether the suggested alternatives are allowed or not.	The Office indicated that no clarification is necessary since the use of fax would be discontinued as of 1 July 2024. There were no further comments from the SACEPO WP/G members.
5.	A	II	3	However, the EPO does not verify the number of sheets making up a given document	Why does EPO not confirm the number of pages?	The Office stated that the number of pages cannot be confirmed in the acknowledgment of receipt because the formality check needs to be performed first. SACEPO WP/G members invited the Office to consider that it is very important for users to receive confirmation of the number of pages received by the Office. The Office took note of this comment.
6.	A	II	6.2	Comment 6 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments) A-II, 6.2 – How to calculate additional page fees in the situation of PCT Rule 20.5bis(d)? 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. 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? 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	The Office stated that the general principle set out in paragraph 241 of the PCT RO Guidelines applies to these cases: the amount of the international filing fee depends on the total number of sheets in the international application at the time of filing. The Office will add a reference to the above-mentioned paragraph of the PCT RO Guidelines. There were no further comments from the SACEPO WP/G members.

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					been paid (e.g., payment at original filing date) 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	2	Form PCT/RO/102 Notification concerning payment of prescribed fees	Does EPO issue the form (IB issues the form before and after payment of fees)	<p>The Office confirmed that Form PCT/RO/102 is not issued by the RO/EP; this is stated in GL/PCT-EPO A-III, 4.2.</p> <p>The SACEPO WP/G members insisted on the importance of this form for users, especially as an official means of confirmation of payments.</p> <p>The Office took note of this comment.</p>
8.	A	III	8.2		It is suggested to include that an eligible applicant (microenterprise, natural person, non-profit organisation, university or public research organisation) may, when entering the European phase, obtain a 30% reduction of the paid international search fee where the EPO acted as ISA (RFees2024 7a(3)(c)).	The Office confirmed that the new fee-related measures for small entities will be reflected in the new version of the PCT-EPO Guidelines.
9.	A	VI	1.6	In proceedings before the EPO as designated or elected Office, the transfer of the priority right must be assessed under the EPC, regardless of any national laws. The EPC does not set out any formal requirements for the transfer of the priority right (see G 1/22 and G 2/22). For details on the procedure before the EPO as designated or elected Office, see GL/EPO A-III, 6.1	<p>Is it correct to assess the transfer of priority "regardless of any national laws", when the EPC does not set any "formal requirements" for the transfer (i.e. instrument of transfer)? Compare with EPC/GL A-III 6.1</p> <p>As concerns (ii), it is important to note that the transfer of</p>	<p>The Office indicated that the wording of this section corresponds to that used in GL/EPO A-III, 6.1. However, if appropriate, it may revise the wording slightly.</p> <p>There were no further comments from the SACEPO WP/G members.</p>

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					the priority right is distinct from a possible transfer of the priority application and must be assessed under the EPC, regardless of any national laws.	
10.	A	VII	3.1	The section now indicates "With the exception of amendments and corrections to the application, for which the language of the proceedings must be used, any other correspondence with the EPO can be in any of the EPO official languages." However, when the international application is filed in another language with another rO, e.g. in Spanish with the Spanish office, Rule 12.2(b)(i) requires any rectifications referred to in Rule 91.1(b)(ii) and (iii), for which the EPO as ISA or IPEA is the competent authority (e.g. in the case of a mistake in the description, claims or drawings or in a correction thereof, or in an amendment under Article 19 or 34), to be filed in both the language of the application, so Spanish, and the language of the translation submitted for international search, i.e. the language of proceedings before the EPO (see GL/PCT-EPO A-VII, 2)	It is suggested to add to A-VII, 3.1: "If the international application was filed in a different language than the language of proceedings (see GL/PCT-EPO A-VII, 2), any rectification under Rule 91.1(b)(ii) or (iii) of an obvious mistake in a mistake in the description, claims or drawings or in a correction thereof, or in an amendment under Article 19 or 34, for which the EPO as ISA or IPEA is the competent authority shall be filed in both the language of the application, e.g. Spanish, and the language of the translation submitted for international search, i.e. the language of proceedings before the EPO (Rule 12.2(b)(i) PCT)." It is suggested to add to H-IV, 2.1: "For the language requirements for a request for rectification of an obvious mistake in the description, claims and drawings by the EPO as ISA or IPEA, see GL/PCT-EPO A-VII, 3.1."	The Office stated that this point will be clarified in the text; see also #23 below. There were no further comments from the SACEPO WP/G members.
11.	A	VIII	1.10	It is suggested to add when an agent is required before the EPO as dO/eO	It is suggested to: - include the text of GL/EPO E-IX, 2.3.1 in this section, or -	The Office agreed to add a reference to the relevant section of the EPC Guidelines.

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					<p>alternatively to add a reference thereto, or alternatively to copy the 2nd to 5th paragraph thereof into this section:</p> <p>"Applicants, in particular those not resident in an EPC contracting state, are recommended to appoint a professional representative before the EPO in good time, i.e. before initiating proceedings before the EPO as designated/elected Office (see also GL/EPO E-IX, 2.1.2).</p> <p>However, up to expiry of the 31-month time limit under Rule 159, applicants having neither a residence nor their principal place of business within the territory of one of the contracting states may either comply with any requirement themselves or act through a professional representative entitled to practise before the EPO. This means that applicants having neither a residence nor the principal place of business within the territory of one of the contracting states may themselves , 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.</p>	<p>There were no further comments from the SACEPO WP/G members.</p>

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					Applicants having neither a residence nor their principal place of business within the territory of one of the contracting states who do not themselves take the required steps for entry into the European phase within the 31-month time limit may, after expiry of that time limit, perform these and the other procedural steps (e.g. filing a request for re-establishment of rights) only through a professional representative entitled to practise before the EPO. See also GL/EPO E-IX, 2.3.1."	
12.	A	VIII	2.3	The new text includes: "However, if the application is filed by fax a confirmation copy must be filed by post at the same time." The term "filed" is somewhat ambiguous, as the term is usually used for the event of receipt by the EPO, and not the event of sending it off.	It is suggested to clarify the wording.	See #4 above.
13.	A	VIII	2.3	The new text includes: "However, if the application is filed by fax a confirmation copy must be filed by post at the same time." See comments to A-II, 1.2.2 on possible alternative ways	See comments to A-II, 1.2.2	See #4 above.
14.	A	VIII	3.1	The section starts with "Any paper submitted". The use of the term "paper" may originate from the wording of Rule 92.1(a) PCT, but may be misunderstood	It is suggested to replace "paper" by "document".	The Office agreed to revise the wording of this section accordingly.

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				and/or somewhat unclear; it may e.g. be understood as "paper document", "document on paper" or "(scientific) article". The term "Document" seems an unambiguous alternative, and also appropriate in view of the wording of Rule 89 <i>bis</i> PCT.		
15.	A	VIII	3.1	A demand for international preliminary examination 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.	It implies that EPO will proceed with the PE, even if there is a missing signature. Please confirm	The Office confirmed that the procedure indicated is correct; see Rule 60.1(a- <i>ter</i>) PCT. Asked by SACEPO WP/G members, the Office agreed to clarify this point in the text.
16.	B	I	2	For Direct EP, the other two members of the examining division are being involved early, since 1 November 2023 (information Steve Rowan, DG1-EPPC meeting 28.02.2024). Is this also done for searches by EPO as ISA?	Clarification is requested	The Office stated that this was work in progress; a decision on whether there is a need to update the Guidelines will be taken in due course. There were no further comments from the SACEPO WP/G members.
17.	B	II	6	The section starts with "Any agent or other person entitled to undertake representation before the receiving Office with which the international application was filed may represent .." However, Art. 49 PCT uses the terms "Any attorney, patent agent, or other person, having the right to practice before the national Office with which the international application was filed" and Rule 90.1 PCT uses the terms: "A person having the right to practice before the national Office with	Review is requested.	The Office confirmed that it will review the wording and take into consideration the information on representation which can be found under sections GL/PCT-EPO A-VIII, 1.1-1.13. There were no further comments from the SACEPO WP/G members.

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				which the international application is filed". Is the scope of "undertake representation" and "having the right to practice" the same? In particular, do both include employees under Art. 133 (3) EPC: one could argue that they do not represent their employer but that their employer rather acts through them (see German text) so that they would not be entitled when using the text of B-II, 6, but one could also argue that Art. 133(3) does give an employee the right to practice so that they would be entitled under Art.49/R.90 PCT		
18.	B	VI	2	According to Rule 33.1(a) and Rule 33.1(b), oral disclosure, use, exhibition, etc. are recognised as prior art only when this is substantiated by a written disclosure, contrary to Art. 54 EPC.	The assemblies are expected to adopt a proposed amendment to Rule 33 and Rule 64 PCT in July.	The Office said it plans to update this section once the proposed amendments have entered into force (see also #2 above). There were no further comments from the SACEPO WP/G members.
19.	C	I	2	Is the IPE examination done by a single examiner, or by a group of 3 (that will become the examining division in the European phase)? For a search in a Direct EP, the other two members of the examining division are already being involved as of early in the search stage, since 1 November 2023 (information Steve Rowan, DG1-EPPC meeting 28.02.2024).	Clarification is requested	SACEPO WP/G members said applicants needed to know who was in charge and who was involved in actions taken by the Office. Concern was also expressed that the requirements in comments 19 (on search) and 16 (on preliminary examination) are different. The Office explained that this was work in progress; a decision on whether there is a need to update the Guidelines will be taken in due course. It also confirmed that it is aware of the different requirements applying to international search and international preliminary examination.
20.	C	VI		Comment 18 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)	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 said it would consider whether adding further instructions in the Guidelines on the application of Rule 80.5 PCT and Rule 80.6 PCT was expedient, bearing in mind what is currently

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				<p>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):</p> <table border="1" data-bbox="611 608 1005 1422"> <tr> <td data-bbox="611 608 752 703">Original mailing date</td> <td data-bbox="752 608 864 703">08-07-2018</td> <td data-bbox="864 608 1005 703"></td> </tr> <tr> <td data-bbox="611 703 752 828">Acceptable date of receipt R80.6</td> <td data-bbox="752 703 864 828">15-07-2018</td> <td data-bbox="864 703 1005 828"></td> </tr> <tr> <td data-bbox="611 828 752 1273">Actual date of receipt</td> <td data-bbox="752 828 864 1273">10-08-2018</td> <td data-bbox="864 828 1005 1273">number of days which the document or letter was received later than seven days after the date it bears = 25 days</td> </tr> <tr> <td data-bbox="611 1273 752 1422">Original due date</td> <td data-bbox="752 1273 864 1422">09-08-2018</td> <td data-bbox="864 1273 1005 1422">08-08-2018 but time limit cannot</td> </tr> </table>	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		<p>described in the Euro-PCT Guide (sections 1.10.001-002). It pointed out that situations referred to in the comment were less likely to occur in future, given the availability of the Mailbox service in the international phase via MyEPO Portfolio and PCT Link. It also stated that the comment would best be treated in Part E ("General Procedural Matters"), not Part C ("PCT Chapter II"), since it applied beyond just PCT Chapter II and the EPO acting as IPEA.</p> <p>SACEPO WP/G members requested that an example of the application of Rules 80.5 PCT and Rule 80.6 PCT be inserted.</p>
Original mailing date	08-07-2018																	
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				<table border="1" data-bbox="611 240 1003 1062"> <tr> <td data-bbox="611 240 757 576"></td> <td data-bbox="757 240 869 576"></td> <td data-bbox="869 240 1003 576">expire on a day the EPO is closed, therefore moved to next open day Rule 80.5</td> </tr> <tr> <td data-bbox="611 576 757 911">New due date under Rule 80.6</td> <td data-bbox="757 576 869 911">03-09-2018</td> <td data-bbox="869 576 1003 911">original limit date plus 25 additional days resulting from time difference Rule 80.6</td> </tr> <tr> <td data-bbox="611 911 757 1062">Addition of 7-day period of grace</td> <td data-bbox="757 911 869 1062">10-09-2018</td> <td data-bbox="869 911 1003 1062"></td> </tr> </table> <p data-bbox="577 1094 1099 1375">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). 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>			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	Addition of 7-day period of grace	10-09-2018			
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21.	C	VII	3	What is the appropriate course of action for a third party is he observes that his third party observations have not been considered and that not even "[A] comment is included in Section V of the WO-IPEA and/or in the IPER indicating that the third-party observations have been taken into account and found not to be relevant or that the third-party observations could not be taken into account and why." If he would simple refile them, they may again not be considered.	Clarification is requested	<p>The Office said this was not an issue for the Guidelines, as it concerned alleged non-compliance with the instructions these contain. This could not be reflected in the Guidelines themselves; there are dedicated channels for this in the form of the external complaints handling mechanism described in GL/EP E-VI, 4.</p> <p>SACEPO WP/G members expressed that the question of third-party observations not being taken into account was a recurring issue. They also noted that recurring filings of the same third-party observations occurred as well. Improvement of the treatment of third-party observations was requested.</p> <p>The Office expressed its thanks for the comments and said an analysis of the handling of third-party observations is ongoing; the results will be presented at the SACEPO Quality meeting in June.</p>
22.	G	VI	4	This section may need to be updated in view of G 1/23 (once issued)		<p>The Office said that if the decision is available in time for the current cycle of the Guidelines, its content will be taken into account accordingly.</p> <p>There were no further comments from the SACEPO WP/G members.</p>
23.	H	IV	2.1	See comment to A-VII, 3.1	See proposal under A-VII, 3.1	<p>The Office agreed to the proposal and proposed adding the following text to H-IV, 2.1: "For the language requirements for a request for rectification of an obvious mistake in the description, claims and drawings by the EPO as ISA or IPEA, see GL/PCT-EPO A-VII, 3.1."</p> <p>There were no further comments from the SACEPO WP/G members.</p>