PCT-EPO Guidelines – combined comments received via the public user consultation (01.02. – 04.04.2023) and from the members of the SACEPO Working Party on Guidelines

Consultation results following the meeting of the SACEPO Working Party on Guidelines (WPG) held on 4 May 2023

General comment: Well done!

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
	GP			No comment		
1	Part A	II	1.1	This year's Pre-Exam showed that many candidates have the wrong understanding when an applicant files a first application (PCT in the Pre-Exam) directly with the EPO or IB while the national law of the state of residence (France in that case) requires to file with the national office (first) – while the EP or PCT application is valid, but some serious sanctions may apply to the applicant in his home state due to that violation. The EP and PCT "just" give a basis for the national law to allow such sanction, but there is no provision in the EP/PCT to deny the application the status of an EP/PCT application. ■ GL/PCT-EPO 1.1 (and A-II, 2) is also silent about a possible national requirement to file nationally first (there is only a mention at the end of 1.1 that national law may allow to also file	I suggest that to also include a reference to A-II, 3.2 in GL/PCT-EPO A-II, 1.1: "Filing with a competent national authority may be mandatory of national law (e.g., in view of residency or nationality of the applicant or the inventor): see A-II, 3.2. I suggest to amend the first paragraph of GL/PCT-EPO A-II, 1.1 to include the underline sentence: "The national law of an EPC contracting state may stipulate that, for national security reasons, an international application must be filed with the EPO as receiving Office via a competent authority of that state. However, not meeting such national requirement (e.g., by filing directly with the EPO or the IB) does not, as such, have the	The Office agreed to include the proposed reference to A-II, 3.2. The Office stated that a further amendment to the first paragraph is not required. There were no further comments from the SACEPO WPG members.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				nationally) – it is mentioned in A-II, 3.2.	effect that the application is not dealt with as an international application."	
2	Part A	11	6.1	 a. 6.1 Correct element or part not furnished for the purpose of incorporation by reference b. The procedure to be followed varies depending on whether the correction is requested either on/before the date on which the requirements under Art. 11(1) for the accordance of an international filing date are fulfilled (see GL/PCT-EPO A-II, 6.1.1) or after that date (see GL/PCT-EPO A-II, 6.1.2). Since the notification of incompatibility referred to in GL/PCT-EPO A-II, 6 had no impact on the procedure to be followed by the EPO as receiving Office in cases where the applicant did not request incorporation by reference, the processing of these requests has remained unchanged since the withdrawal of the notification of incompatibility. 	The last paragraph is confusing and unnecessary – we suggest to delete it.	The Office agreed to the proposal.
3	Part A	11	6.2	A-II, 6.2 Correct element or part furnished for the purpose of incorporation by reference The section includes: ". The wrong element or part, marked as "ERRONEOUSLY FILED (RULE 20.5 <i>bis</i>)", will remain in the international application".		The Office agreed to add a paragraph providing users with additional information on the consequences of incorporation by reference in the subsequent phases of the grant procedure.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				It is suggested to add what the effect of the indication "ERRONEOUSLY FILED (RULE 20.5bis)" for the international phase and for the EP regional phase. Does this indication have any effect on the possible scope, types or procedure w.r.t. amendments, correction of errors,? In particular, it should be clarified if the erroneously filed parts can serve as: a basis for amendments under PCT Art, 19, a demand for international preliminary examination, for SIS, for the EP phase (limit the application documents to the erroneous parts and delete the corrected parts when entering or in response to R.161/162) (make a reference to the EPC GL on this point).		
4	Part A	III	3	A-III, 3 Method of payment – old references to ADA/AAD For ADA and AAD, the GL/PCT-EPO still refer to Supplementary publication 4, OJ EPO 2019. This has however been superseded per 10 September 2022 by Supplementary publication 3, OJ EPO 2022.		The Office confirmed that it will update the reference.
5	Part A	III	9.2 etc.	A-III, 9.2, 9.2.1.1, 9.2.1.2, 9.2.1.3; B-IV, 1.1 – Refund of search fee by EPO=ISA These still mention OJ 2019, A5, but that has been superseded per		The Office confirmed that it will update the reference.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				1/4/2022 and will be again per 1/4/2023. OJ citations to be updated for:" OJ 2023, A5, superseding OJ 2022, A9 per 1/4/2023 OJ 2022, A9 superseding OJ 2019, A5 per 1/4/2022		
6	Part A	VI	1.6	A-VI, 1.6 Applicant's entitlement to claim priority [Comment also submitted last year – it was not considered in view of pending referrals G 1/22 & G 2/22, but the proposed clarifications are (at least largely) independent of the outcome of those referrals] A-VI, 1.6 added text comprises: The applicant claiming the priority of an earlier application must be the applicant of the latter or the successor in title. and: However, for a successor in title to enjoy a priority right in proceedings before the EPO, the earlier application or the priority right must have been transferred before the filing date of the international application (Box No. VIII (iii) PCT request form) and the transfer must be valid under the applicable national provisions. Any deficiencies cannot be remedied after that, and in particular not in the European phase. This suggests that a transfer of the earlier APPLICATION AS SUCH is	It is proposed to amend the text in GL/PCT-EPO by adding "of the priority right" and by deleting the "earlier application and adding a comment on the application and the priority right being separately transferrable to: The applicant claiming the priority of an earlier application must be the applicant of the latter or the successor in title of the priority right. and However, for a successor in title to enjoy a priority right in proceedings before the EPO, the earlier application or the priority right must have been transferred before the filing date of the international application (Box No. VIII (iii) PCT request form) and the transfer must be valid under the applicable national provisions. Any deficiencies cannot be remedied after that, and in particular not in the European phase. It is to be noted that the earlier application and the priority right are separate rights, such	The Office agreed to adopt some of the proposed suggestions on a provisional basis, in view of pending referrals G 1/22 and G 2/22. The PCT-EPO Guidelines cover the practice of the EPO in its capacity as International Authority under the PCT. They do not cover the regional phase. Consequently, they use the language of the PCT and the Paris Convention as international treaties. These treaties do not concern themselves with national requirements applicable to a transfer of priority rights. In some national jurisdictions, the transfer of a patent application can implicitly encompass the transfer of the respective priority right. However, in the interest of user friendliness, and in view of the strict approach of some jurisdictions, the suggested text "successor in title of the priority right" can be added. The Office agreed to align the sentence with the wording of GL/EPO A-III, 6.1. This reflects the fact that some national laws do allow for an implicit transfer of the priority right with the patent application, while others set the bar higher. The section would read: "However, for a successor in title to enjoy a priority right in proceedings before the EPO, the transfer of the earlier application including the priority right (or of the priority right as such) must have taken place before the filing date of the international application (Box No. VIII (iii) PCT request form) and the transfer

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				sufficient to also transfer the priority right created by its filing. That suggestion is incorrect in view of the EPC case law: it is only correct if the national law concerned would consider the priority right to be transferred together with the application, even if that is not explicit in the transfer agreement. The corresponding section in the GL/EPO does not have this problem. There it reads in GL/EPO A-III, 6.1: As concerns (ii) above, the transfer of the application including the priority right (or of the priority right as such) must have taken place before the filing date of the later European application and must be a transfer valid under the relevant national provisions.	that a transfer of the earlier application may, under the national law and the terms of the transfer agreement concerned, not comprise a transfer of the priority right created by its filing.	must be valid under the relevant national provisions. []". Regarding the suggestion to add a sentence explaining that the transfer of a patent application is distinct from the transfer of the respective priority right, the Office stated that this goes beyond the scope of the PCT-EPO Guidelines, whose aim is not to inform readers on matters of national patent law. For this reason, the suggestion will not be adopted. There were no further comments from the SACEPO WPG members.
7	Part A	VII		A-VII Languages The EPO has made some amendments as agreed on the 23 rd SACEPOWPG, but we propose additional improvements:	It is proposed to add sections on: Languages before EPO as ISA Languages before EPO as SISA Languages before EPO as IPEA while referring to the EPO-WIPO Agreement and its Annexes	The Office agreed to add a clarification that the language of proceedings before the EPO acting as International Authority (ISA, SISA and IPEA) is English, French or German, and to include a reference to Art. 152 EPC and a hyperlink to Art. 3 and Annex A (ii) EPO-WIPO Agreement.
8	Part A	VIII	1.4	A-VIII, 1.4 "Representation" by an employee (new section) [1] The section indicates "This kind of "representation" has to be distinguished from representation by an agent.".	A clarification is requested if the difference is relevant. If the difference is not relevant, it is requested to delete the sentence and to delete the	The Office agreed to align the wording of this section with GL/EPO A-VIII, 1.3.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				However, neither this section nor any other part of A-VIII clarifies that there are different types of representation, nor is it explained what the difference is and what the effects of that are. Further, the section suggests that there is a difference as "The actions of the employee are regarded as actions of the natural or legal person and communications from the EPO"; however, also for a professional representative "The actions of the professional representative are regarded as actions of the natural or legal person and communications from the EPO". Also, the binding effect of such actions is the same for employees as for professional representatives. It is noted that the EPFC uses the same terms for representation in Art. 133(2) and (3) EPC, i.e., for professional representatives and employees (the term "be represented by").	quotes from the phrase "representation".	
9	Part A	VIII	1.4	A-VIII, 1.4 "Representation" by an employee (new section) [2] Representation by an employee is only described w.r.t. the EPO as rO, not w.r.t. the EPO as ISA, SISA or IPEA. However, PCT Art. 49 ("Any attorney, patent agent, or other person, having the right to practice before the national Office with which the international		The Office clarified that an applicant with its place of business in an EPC contracting state may also act through an employee in proceedings before the EPO as ISA, SISA or IPEA. The Office confirmed that it will consider a corresponding clarification in this section. See also comment 8.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				application was filed, shall be entitled to practice before the International Bureau and the competent International Preliminary Examining Authority and competent International Preliminary Examining Authority in respect of that application.") seems to provide that an employee that is allowed to represent an applicant before the EPO as rO can also act before the EPO as ISA, SISA or IPEA. Similarly in view of PCT Rule 90.1(a) indicates that "A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed or, where the international application before the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority." NB: Possibly a difference arises due to the term "right to practice", and an employee does not "have the right to practice" – however, in its common meaning, the employee has a right to practice due to Art. 133(3) EPC?		

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
				Clarification is requested.		
10	Part A	VIII	1.11		A-VIII, 1.11 & 1.13 Power of attorney – waiver It is suggested to add that the PoA is not waived in case of "representation" by an employee. (Especially if an employee is not covered by the term "agent").	The Office agreed to the proposal.
11	Part B				Proposal: New section on representation It is proposed to add a section like C-II, 5 also in the search part: before EPO as ISA before EPO as SISA The section could (similar as as C-II 5 refers to GL/PCT-EPO A-VIII, 1.9), in part refer to the new section GL/PCT-EPO A-VIII, 1.7 and 1.8 Similar comment was discussed at the in 23rd SACEPOWPG and the EPO agreed to take this on board: It is proposed to add a section like C-II, 5 also in the search part.	The Office agreed to the proposal to insert a short section on ISA/SISA-specific representation under Rule 90.1(b) PCT and Rule 90.1(b-bis) PCT.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
					The Office stated that Part A will be further enhanced with all aspects of representation before the EPO and therefore agreed to take this comment on board in that context.	
	Part C			No comments		
	Part E			No comments		
12	Part F	V	1	F-V, 1 The section indicates " that, in the PCT procedure, multiple independent claims in the same category need to be considered under the Art. 6 conciseness requirement."	It is suggested to add a reference to GL/PCT-EPO F-IV, 3.2 and to GL/EPO F-IV, 3.2	The Office agreed to the proposal.
13	Part F	V	1		We suggest to add at the end of the section (See ISPE Guidelines 10.01 to 10.10 (similar to section F-V, 3 and in F-VI, 2.1). ISPE Guidelines include useful guidance for the examiner (see 10.04).	The Office stated that the GL/PCT-EPO provide a detailed EPO-centric implementation of the more general principles in ISPE Guidelines 10.01 to 10.10. Since the EPC and PCT provisions on unity are the same, the Office finds it sufficient that this section already refers to EP practice on unity in GL/EPO F-V, 1 to GL/EPO F-V, 3. The Office agreed to reconsider its position. This was welcomed by the SACEPO WPG members.
14	Part G	IV	8	G-IV, 8 Errors in prior-art documents This section addresses the same topic as GL/EPO G-IV, 9, but it uses different terminology.	It is suggested to use the terminology of as GL/EPO G-IV, 9 ("can directly and unambiguously derive") also in GL/PCT-EPI G0IV, 8 (which now uses "can immediately see"). Alternatively, the complete text of G-IV, 8 could be replaced by "The principles as laid down in	For consistency and simplicity, the Office agreed to replace the text with a reference to GL/EPO.

#	Part	Chap- ter	Section	Comment	Suggestion	Consultation results
					the Guidelines for Examination in the EPO (GL/EPO G-IV, 9) apply mutatis mutandis.", as is also done in, e.g., G-IV, 6.5.	
	Part H			No comments		