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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Eleventh Session
Geneva, February 21 to 25, 2005

INTERIM PROTEST PROCEDURE
AT THE EUROPEAN PATENT OFFICE

Document prepared by the International Bureau

1. The European Patent Office (EPO) proposes to introduce an interim procedure in relation to protests under PCT Rules 40 and 68 where the applicant disagrees with a finding of lack of unity of invention, to be used from the entry into force of the amendments to those Rules on April 1, 2005, until the entry into force of the Act revising the Convention on the Grant of European Patents of November 29, 2000 (EPC 2000).
2. Annex I contains an explanation of the forms which will be required for the interim procedure. Annex II contains a copy of a notice which is to appear in the Official Journal of the EPO 3/2005. Annex III contains a copy of the EPO's modified versions of Forms PCT/ISA/228 and PCT/IPEA/437 which will be used in the interim procedure.
3. *The Meeting is invited to take note of the information contained in the Annexes concerning the interim protest procedure at the European Patent Office.*

[Annex I follows]

ANNEX I

NEW PCT PROTEST PROCEDURE:
NECESSARY FORMS FOR THE EPO INTERIM PROCEDURE

INTRODUCTION

Although Rules 40 and 68 PCT as revised effective April 1, 2005 no longer require a prior review of the justification for an invitation to pay additional fees, the EPO intends to continue to subject all protest cases to an internal review prior to referring the protest, where appropriate, to the Boards of Appeal. The internal review will no longer be part of the formal protest procedure and will be operated as a service from the EPO, free of charge to the applicant. The intention behind this move is to ensure continuity in the run up to entry into force of EPC 2000, expected in or around 2007, when it is anticipated that the Boards of Appeal will cease to play any role in the protest procedure and all protests will be handled in a single stage by a body akin to the current review panel. This interim procedure is being introduced after consultation with the International Bureau. By way of concession, the EPO will not require the applicant to pay the protest fee until one month from the date of the internal review (he may of course pay the protest fee earlier if he so wishes) in order to allow him to take account of the findings of the review prior to deciding whether or not to continue the protest. This necessitates continued use of some of the existing forms (for details see below) with appropriate modifications. The interim protest procedure is described in detail in the accompanying notice, which will be published in OJ EPO 3/2005 and the MIA is invited to comment.

NECESSARY PCT FORMS:

The PCT forms which will be introduced with the new protest procedure on 01.04.2005 are not compatible with the EPO interim procedure. For this reason, the EPO will continue to use the old forms (modified where necessary) with additional information and instructions appended thereto.

The following forms will still be used by the EPO for the protest procedure:

PCT/ISA/206	Invitation to Pay Additional Fees
PCT/IPEA/405	Invitation to Restrict or Pay Additional Fees
PCT/ISA/228	Notification Regarding Review of Justification for Invitation to Pay Additional Search Fees
PCT/IPEA/437	Invitation to Pay Protest Fee

Forms PCT/ISA/206 and PCT/IPEA/405 will be accompanied by an information sheet explaining the EPO interim protest procedure, making reference to the announcement of this procedure in the OJ EPO and indicating that payment of the protest fee may be effected up until one month after notification of the results of the prior review.

Since, under the EPO interim procedure, the applicant can delay payment of the protest fee until after receipt of the results of the review, the forms PCT/ISA/228 and PCT/IPEA/437 currently used to inform the applicant of the outcome of the prior review and to invite payment of the protest fee will be maintained. These forms will however be modified (see Annex III) to reflect the new procedure.

[Annex II follows]

ANNEX II

NOTICE TO APPEAR IN THE OFFICIAL JOURNAL
OF THE EUROPEAN PATENT OFFICE
CONCERNING THE PROTEST PROCEDURE UNDER THE PCT

“This Notice replaces the previous Notice published in OJ EPO 9/1992 547.

“1. Rules 40 and 68 PCT have been amended with effect from 1 April 2005. The effect of the amendments is that the requirement to carry out a review of the justification for the invitation to pay additional fees under Article 17(3)(a) or Article 34(3)(a) PCT prior to requiring payment of a protest fee (Rule 40.2(e) and Rule 68.3(e) PCT) has been deleted.

“2. Under Articles 154(3) and 155(3) EPC the Boards of Appeal at the EPO are responsible for deciding on protests against payment of additional fees for international search or international preliminary examination subject to payment of a protest fee, currently EUR 1 020. These Articles have been deleted from the EPC as revised in 2000 which however has not yet entered into force.

“3. Pending entry into force of the revised version of the EPC, where additional fees for international search or international preliminary examination are paid under protest according to Rules 40.2(c) or 68.3(c) PCT, the EPO will continue to subject any invitation to pay such additional fees to an *internal* review, prior to submission of the protest to the Board of Appeal. This review is in the nature of a service from the EPO and the previous procedure described in Rule 105(3) EPC is no longer applicable. In order to allow the applicant to consider the result of the review the EPO will, by way of concession, not require payment of the protest fee until one month *after* the date of notification of the review to the applicant.

“4. (a) If the result of the review is that the invitation was *not* justified, any additional fees for international search or international preliminary examination paid will be refunded. If the applicant has already paid the protest fee this will also be refunded.

“(b) If the result of the review is that the invitation was *entirely* justified, the applicant will be notified and will also be informed that if he wishes to proceed to examination of the protest by the Board of Appeal he must pay the protest fee within one month if he has not already done so.

“(c) If the result of the review is that the invitation was justified *only in part*, the corresponding additional fees will be refunded. If the applicant has already paid the protest fee, the protest will be referred to the Board of Appeal unless the applicant indicates within one month from notification of the result of the review that he does not wish to continue the protest. If the applicant has not already paid the protest fee, he will be informed that he must do so within one month of the date of the notification of the result of the review if he wishes the protest to be referred to the Board of Appeal.

“5. If the protest fee is duly paid the protest will be referred to the Board of Appeal for decision.

“(a) If the Board of Appeal finds that the protest was *entirely* justified, the additional fees and the protest fee will be refunded.

“(b) If the Board of Appeal finds that the protest was justified only *in part*, the corresponding additional fees will be refunded, but not the protest fee.”

[Annex III follows]

ANNEX III

MODIFIED VERSIONS OF FORMS PCT/ISA/228 AND PCT/IPEA/437

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

INVITATION TO PAY PROTEST FEE

(PCT Rule 40.2(e))

	Date of mailing (day/month/year)
Applicant's or agent's file reference	PAYMENT DUE within ONE MONTH from the above date of mailing
International application No.	International filing date (day/month/year)
Applicant	

1. The applicant is invited, within the time limit indicated above, to pay a protest fee (unless such fee has already been paid) for the examination of the protest, in the amount of:

_____ (amount/currency)

since a prior review of the justification for the invitation to pay additional fees (Form PCT/ISA/206) has resulted in the requirement of payment of additional fees to be upheld:

because the invitation is justified.


the invitation is justified in part.

To the extent the invitation is not justified, _____ additional search fee(s) paid under protest will be refunded in due course.

The reasons for this invitation to pay a protest fee are indicated in the Annex.

2. Failure to pay the protest fee within the time limit indicated above will result in the protest being considered not to have been made.

3. If the applicant has already paid the protest fee but does not wish to continue with the protest in view of the result of the prior review, he is requested to indicate this within the time limit indicated above. In this case the protest fee will be refunded. If no such indication is received within the time limit it is assumed that the applicant wishes to continue with the protest, which will be referred to the Boards of Appeal. The protest fee will only be refunded if the Board finds that the protest was entirely justified

Name and mailing address of the International Searching Authority  European Patent Office, P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk Tel. (+31-70) 340-2040, Tx. 31 651 epo nl, Fax: (+31-70) 340-3016	Authorized officer
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PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

INVITATION TO PAY PROTEST FEE

(PCT Rule 68.3(e))

To:	
	Date of mailing (day/month/year)
Applicant's or agent's file reference	PAYMENT DUE within ONE MONTH from the above date of mailing
International application No.	International filing date (day/month/year)
Applicant	

1. The applicant is invited, within the time limit indicated above, to pay a protest fee (unless such fee has already been paid) for the examination of the protest, in the amount of:

_____ (amount/currency)

since a prior review of the justification for the invitation to pay additional fees (Form PCT/IPEA/405) has resulted in the requirement of payment of additional fees to be upheld:

because the invitation is justified.

the invitation is justified in part.
To the extent the invitation is not justified, _____ additional search fee(s) paid under protest will be refunded in due course.

The reasons for this invitation to pay a protest fee are indicated in the Annex.

2. Failure to pay the protest fee within the time limit indicated above will result in the protest being considered not to have been made.

3. If the applicant has already paid the protest fee but does not wish to continue with the protest in view of the result of the prior review, he is requested to indicate this within the time limit indicated above. In this case the protest fee will be refunded. If no such indication is received within the time limit it is assumed that the applicant wishes to continue with the protest, which will be referred to the Boards of Appeal. The protest fee will only be refunded if the Board finds that the protest was entirely justified.

Name and mailing address of the IPEA/	Authorized officer
Facsimile No.	Telephone No.

Form PCT/IPEA/437 (April 2005)

[End of Annex III and of document]