ENTRY INTO THE EUROPEAN PHASE

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ENTRY INTO THE EUROPEAN PHASE

CONTENT

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- Competence of the Receiving Section
- Entry into the European phase
  - Legal basis, time limits, steps to take
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GENERAL INTRODUCTION
Prevalence of the PCT
(Article 27 PCT; Article 150(2) EPC)

Supplementary application of the EPC
(Article 150(2) EPC)

Equal service levels
(Article 11(3) PCT; Article 153(2) EPC)
INTERNATIONAL PHASE (1/2)

0 (months)
Filing of a first application at a national office

12
Filing of a single "international application" at a single "receiving Office" designating all PCT states

International phase
International processing including centralised search, prelim. examination and publication

30/31
National grants by "designated Offices" in/for PCT states

Priority period

Added value: Limiting costs, improving and facilitating …

EUROPEAN PHASE
… subsequent processing in …
## INTERNATIONAL PHASE (2/2)

### Euro-Direct route
Applicant files a direct European application (first filing)

### Euro-direct route claiming priority
Applicant files a direct European application (second filing) claiming priority from a national, regional or PCT application

### International route with an ISA ≠ EPO (PCT)
Applicant files a PCT application choosing an ISA ≠ EPO → Application enters European phase

### International route with the EPO as ISA/IPEA (PCT)
Applicant files a PCT application choosing the EPO as ISA → Application enters European phase
PATENT GRANT PROCEDURE (EP)

Applicant

European patent application

Search and search report together with preliminary opinion on patentability

Publication of application and search report

Observations by third parties possible (Article 115 EPC)

European Patent Office

Filing and formalities examination

Refusal of application

Validation in designated states/UP Register

Grant of European patent

Publication of patent specification

Appeal proceedings

Limitation or revocation proceedings

Opposition proceedings

Review

Public

Observations by third parties possible (Article 115 EPC)
COMPETENCE OF THE RECEIVING SECTION

- **Article 16 EPC**: The Receiving Section is responsible for the examination on filing and the examination as to formal requirements of European patent applications
  - Extends to Euro-PCT applications (PCT route)
- **Rule 10 EPC**: Responsibility ends when the examining division becomes responsible, i.e.
  - upon payment of the examination fee ([Rule 70(1) EPC](https://epo.org)) or
  - if the examination fee was paid early, upon filing the declaration under [Rule 70(2) EPC](https://epo.org) or
  - if the declaration under Rule 70(2) EPC is validly waived, following the transmittal of the European search report ([OJ EPO 2015, A94](https://epo.org)).
- **Euro-PCT applications**: If ISA = EP, the ED is immediately competent after entry.
ENTRY INTO THE EUROPEAN PHASE (EURO-PCT APPLICATIONS)
ENTRY INTO THE EUROPEAN PHASE – LEGAL BASIS

- Article 22 PCT, Article 39 PCT
- Article 23 PCT, Article 40 PCT
- Article 28 PCT, Article 41 PCT
- Article 150 EPC
- Article 153 EPC
- Rule 159 EPC
- Rule 161 EPC
- Rule 162 EPC

 Guidelines for Examination in the EPO, E-IX
ENTRY INTO THE EUROPEAN PHASE – TIME LIMIT

- Time limit for entering the EP phase: 31 months from date of filing/earliest priority date
- The EPO as designated or elected Office may not process the application before expiry of the 31-month period (processing ban) (Articles 23(1) and 40(1) PCT)
- Early processing possible if explicitly requested (Articles 23(2) and 40(2) PCT)
ENTRY INTO THE EUROPEAN PHASE – STEPS TO TAKE (1/3)

- Requirements for entry into the EP phase within 31 months (Rule 159(1) EPC):
  - Furnish translation if international publication is not in official EPO language (EN/DE/FR)
  - Pay the filing fee and any additional fee for pages in excess of 35
  - Specify the application documents on which the European grant procedure is to be based
  - Pay the search fee if a supplementary European search is carried out
    - the search fee is reduced if the ISR was established by a European ISA other than the EPO (OJ EPO 2023, A2, Article 2, GL A-X, 9.3.1)
  - Where applicable, file the certificate of exhibition (extremely rare)
ENTRY INTO THE EUROPEAN PHASE – STEPS TO TAKE (2/3)

- Requirements for entry into EP phase that fall due earlier but are postponed until after expiry of the 31-month period (Rule 159(1) together with Rules 39, 70 and 51 EPC):
  - Pay the designation fee unless the period under Rule 39 EPC has not yet expired (only if ISR late)
  - File the request for examination and pay the examination fee unless the period under Rule 70 EPC has not yet expired (only if ISR late)
  - Pay the third renewal fee if the time limit under Rule 51(1) EPC expired during the international phase (if priority period not fully used or no priority claimed)
  - In Online Filing 2.0 or Online Filing, EPO Form 1200 leads you through all necessary steps
ENTRY INTO THE EUROPEAN PHASE – STEPS TO TAKE (3/3)

Possible further requirements:

- Pay any claims fees for claims exceeding 15 (Rule 162 EPC)

If not yet available to the EPO:

- File the designation of inventor (Rule 163(1) EPC)
- File the priority number or the priority document (Rule 163(2) EPC)
- File a standard-compliant sequence listing (Rule 163(3) EPC)
- Furnish any missing applicant details (Rule 163(4) EPC)

Representation

- Appoint a European representative if this is mandatory (Article 133(2) and Rule 163(5) EPC)
AMENDING THE EURO-PCT APPLICATION

- The application may be amended on entry and/or in reply to the communication under Rules 161 and 162 EPC (EPO Form 1226) issued shortly after effective entry.

Communication under Rules 161 and 162 EPC:

- Amendments should address any objections raised in the search opinion drawn up by the ISA.
  - Reply mandatory if opinion was negative and EPO = ISA.
  - Reply voluntary if opinion was positive or EPO ≠ ISA.
- Period for reply: six months.
  - Any claims fees for claims in excess of 15 are due within same six-month period.
- Further details: GL E-IX, 3.
LOSS OF RIGHTS (1/2)

- If not all the requirements under Rule 159 EPC are met within 31 months:
  - Loss of rights, application is deemed withdrawn (Rule 160 EPC, Article 24(1) PCT)

- Further processing may be requested
  - Rule 135 and Article 121 EPC

- Where further processing is not or no longer available, re-establishment of rights (Rule 136 and Article 122 EPC)

- Time limit for requesting further processing missed → request for re-establishment of rights in respect of the period under Rule 135(1) EPC

- Request not deemed to have been filed until fee for re-establishment relating to the omitted act, i.e. filing the translation under Rule 159(1)(a) EPC and paying the fee for further processing, paid
LOSS OF RIGHTS (2/2)

- Further processing must be requested for each omitted step.
- The applicant is informed accordingly in a communication of loss of rights (EPO Form 1205).
- The requests for further processing must be filed and the deficiencies remedied within two months of notification of the communication.
- For omitted procedural acts (e.g. late filing of a translation), the further processing fee is a flat rate.
- For late payments, the further processing fee amounts to 50% of the late-paid fee.
- Example: if the applicant submits the request for examination and pays the examination fee after expiry of the 31-month period, the fee for further processing comprises the (flat) fee for the late-filed request and 50% of the late-paid examination fee.
EARLY PROCESSING
REQUEST FOR EARLY ENTRY (1/3)

- Applicant may, if explicitly requested, enter the European phase before expiry of the period of 31 months (Articles 23(2) and 40(2) PCT)

- Check box available on EPO Form 1200 for requesting early processing

- All requirements of Rule 159(1) EPC must be fulfilled for valid entry

- Receiving Section checks all necessary documents are on file and, if not, requests them from WIPO

- Once EP phase validly entered, any changes recorded in the international phase are not effective before the EPO as designated/elected Office
CONSEQUENCES OF AN EFFECTIVE REQUEST (2/3)

- The processing ban is lifted by the applicant.
- The application is processed like any Euro-PCT application having entered the European phase in the regular manner.
- Article 153(2) EPC.
- Time limits under the EPC for procedural acts (payment of fees, submission of documents) must be complied with.
CONSEQUENCES OF NON-EFFECTIVE REQUEST (3/3)

The EPO issues Form 1231 informing the applicant of deficiencies. The applicant may:

- **decide not to react**, i.e. abandon the request for early entry
  - the international phase continues
  - the processing ban continues to apply (Article 23(1)/40(1) PCT)
  - entry into the European phase occurs on expiry of the 31-month period (Rule 159(1) EPC)

- **pursue the request for early entry** by
  - fulfilling any missing requirement as indicated in Form 1231
  - complying with any further requirement due on the date on which the request is pursued
OTHER MEANS OF ACCELERATION (1/2)

1. Waiver

- Waiving the communication under Rule 161/162 EPC (> save six months)
- Waiver can be selected in EPO Form 1200

**Requirements:**

- File a response to the written opinion of the ISA, including any amendments, **on entry**
- Pay any claims fees for claims exceeding 15 **on entry**

**If the waiver is accidentally omitted:**

- Early response to the communication under Rule 161/162 with **explicit statement** renouncing use of the remainder of the six-month period

Further details: [OJ EPO 2015, A94](https://epo.org)
OTHER MEANS OF ACCELERATION (2/2)

2. PACE request – accelerate examination

The examining division strives to issue the next official communication within three months of receipt of the latest applicant action

Requirements:
- The PACE request must be filed online using EPO Form 1005
- The proceedings may not be delayed, otherwise the application is removed from the PACE programme
- Applicants may not ask for time extensions
- Applicants must reply to a communication from the EPO in time (avoid risk of loss of rights)
- Applicants must pay the renewal fees within the basic time limit and may not use the six-month grace period
- The request can only be made once during the examination stage

Further details: GL E-VIII, 4.2, OJ EPO 2015, A93
THANK YOU FOR YOUR ATTENTION