

US Bar - EPO Liaison Council
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3. PCT Strategy

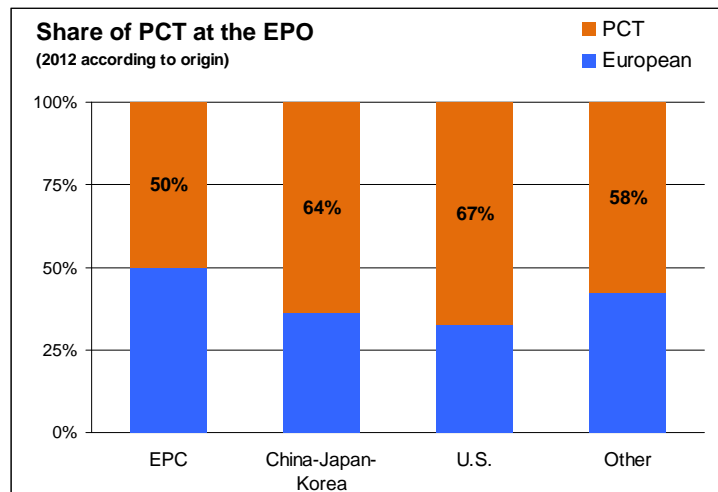
The EPO Strengthens the PCT
- Tangible Results 2013 -

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Euro-PCT applications



PCT applications in the European phase as proportion of PCT applications in the European phase plus Euro-direct applications. Overall share: 58%.

Enhancing the Chapter II procedure

- Recent measures to: 1) enhance the quality of the decision to enter yes/no the European phase 2) enable fast grant in European phase
- As from 1.7.2014: a top-up search in the Chapter II procedure is performed
 - No extra charge, for free!
 - More quality of the IPER and thus legal certainty for further procedure
 - Same scope as the top-up search performed in the European phase
- Reminder => Since 1.10.2011: more interaction with the applicants: second written opinion is issued during preliminary examination if
 - The applicant filed amendments for the Chapter II procedure AND
 - There are objections outstanding so that the IPER would be negative if issued based on the file as it stands

Amended Rule 164 EPC

- As from **1.11.2014** Rule 164 will enable applicants to:
 - Obtain a **search of any invention** claimed in the application documents for the European phase
 - Upon payment of a further search fee for each further invention to be searched
 - Same procedure as for a EP-direct applications (Rule 64 EPC)
 - Select for the further processing of the application **any invention searched by the EPO** either as:
 - Designated Office under Rule 164 in the European phase OR
 - As (S)ISA in the international phase

User benefits of amended Rule 164 EPC

- If the EPO was not the (S)ISA: applicants no longer bound to the (single) invention searched by the EPO as **designated Office upon entry into the European phase**
 - No costs for a divisional application to obtain (just) a search
- If the EPO was the (S)ISA: applicants no longer bound to the invention(s) searched by the EPO as **(S)ISA in the international phase**
 - Postponing of further searches from the international to the European phase avoids further investment at an (too) early stage

Acceleration - early processing at the EPO

- Prohibition under Articles 23(1) and 40(1) PCT = designated/elected Offices cannot process an international application during international phase processing => "Processing ban"
 - ONLY the applicant may lift the processing ban
- How to lift the processing ban in respect of the EPO to accelerate the start of the processing?
 - Request the start of the processing by the EPO by an **express request** for early processing (no special form)
 - Comply with all further requirements => **now clearly explained in a Notice of the EPO dated 21.2.2013**
 - OJ EPO 2013, 156