



ENTRY INTO THE EUROPEAN PHASE

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PRESENTER



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- Monika joined the EPO in 2001 as a formalities officer. Since 2015 she supports Directorate Patent Law and Processes as a legal expert with a focus on EP filing and Euro-PCT. Before her time at the EPO, she worked as an assistant in a large patent attorney's office in Munich.



PRESENTER



Christof Mathoi

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GENERAL INTRODUCTION

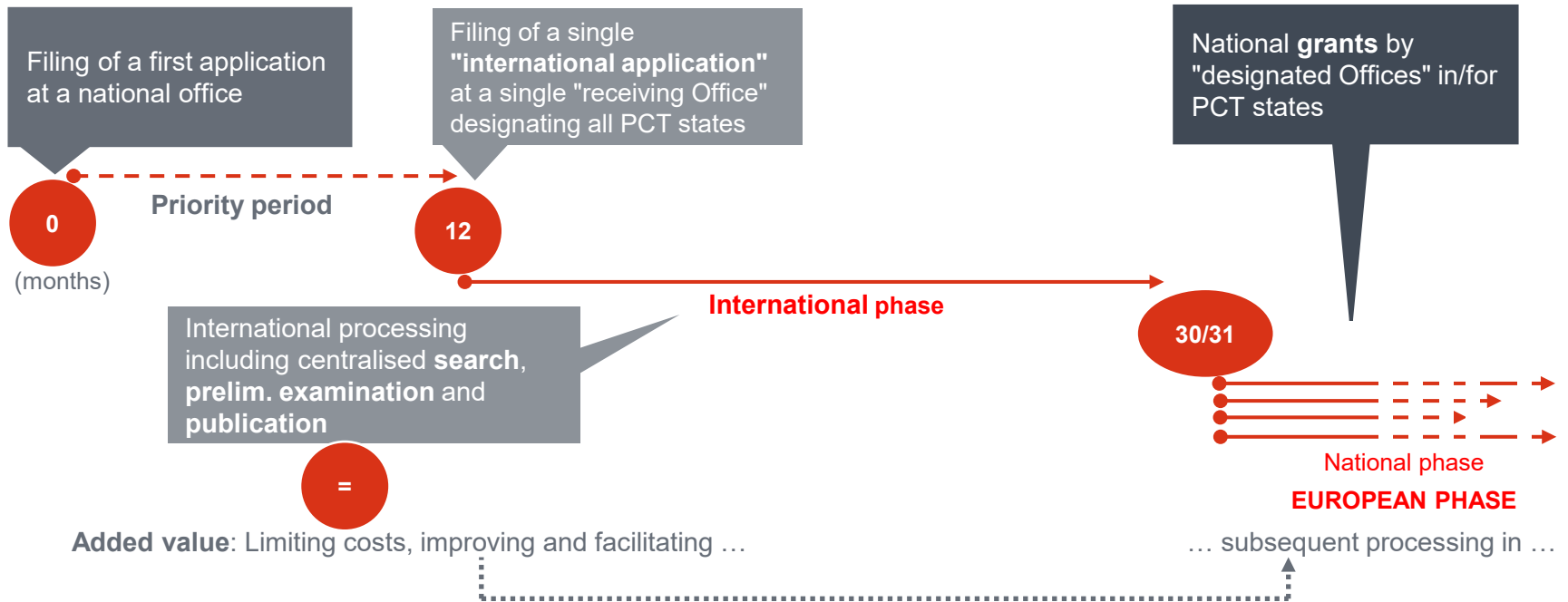


Prevalence of the PCT
(Article 27 PCT; Article 150(2) EPC)

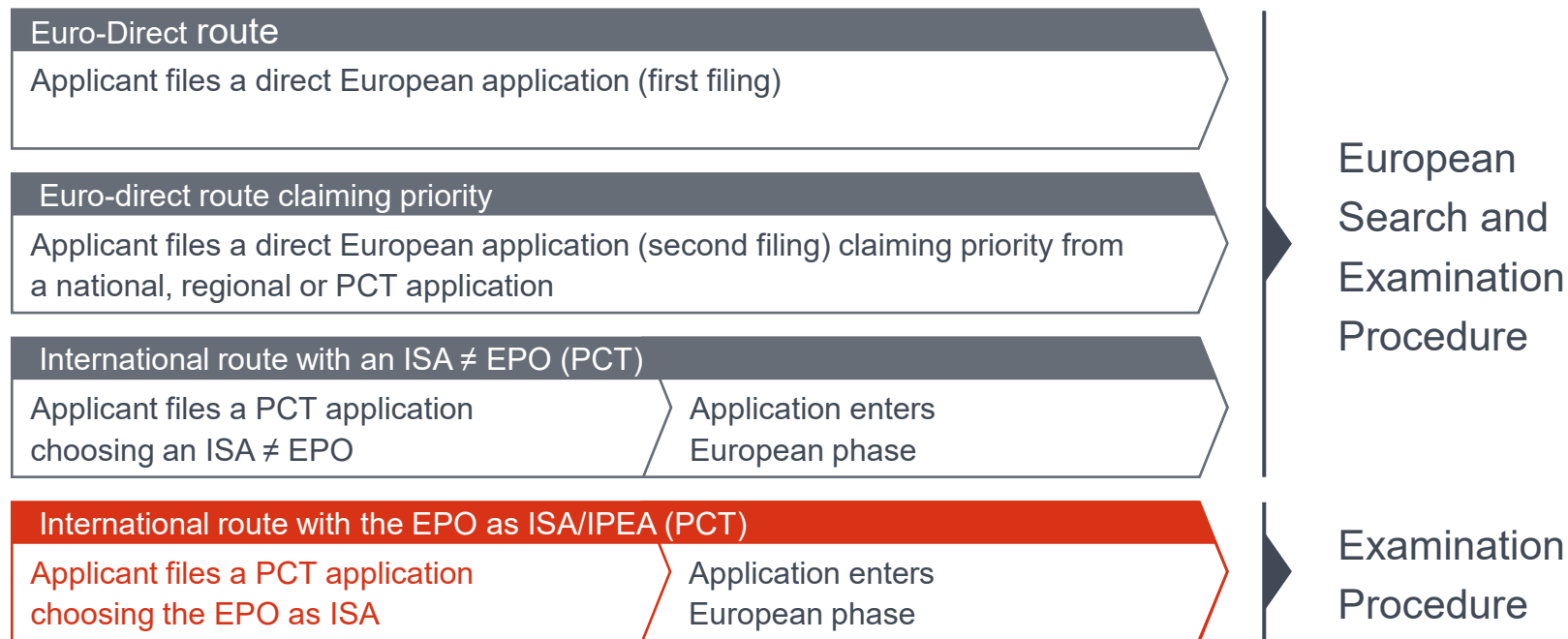
Supplementary application of the EPC
(Article 150(2) EPC)

Equal service levels
(Article 11(3) PCT; Article 153(2) EPC)

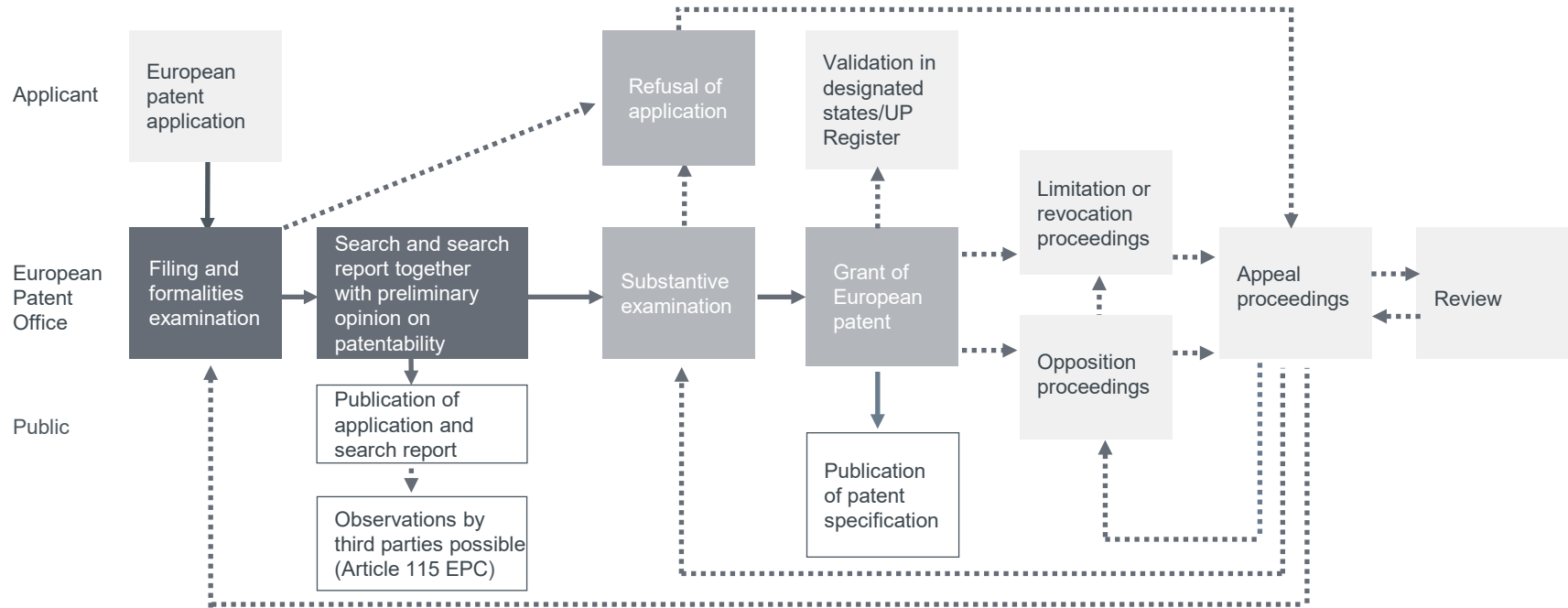
INTERNATIONAL PHASE (1/2)



INTERNATIONAL PHASE (2/2)



PATENT GRANT PROCEDURE (EP)



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](#)) or
 - ▶ if the examination fee was paid early, upon filing the declaration under [Rule 70\(2\) EPC](#) or
 - ▶ if the declaration under Rule 70(2) EPC is validly waived, following the transmittal of the European search report ([OJ EPO 2015, A94](#)).
- **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: [GLE-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](#)

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