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Last-minute
PCT refresher
for EQE 2024

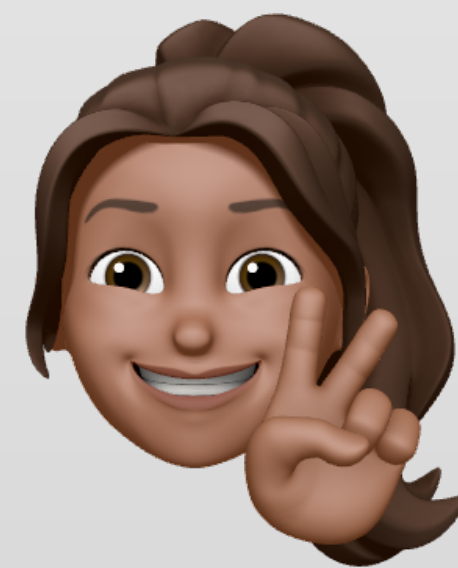
12 February 2024

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Hi, I'm

Zsofia Pintz

EQE tutor and European Patent Attorney



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PCT - the boring stuff

- Effective from 1978
- Not a patent, but an international application, i.e. a 'waiting room'
- No case law - only Articles & Rules
- Consists of an 'International' and a 'national' (or 'regional') phase
- 157 member states (most recent states that joined: Mauritius, Cabo Verde, Iraq and Jamaica)
→ automatically designated at filing under R.4.9(a)(i) PCT
- Not members: e.g. Argentina, Taiwan (most frequent examples in the EQE)
 - Few more non-member examples: Andorra, Afghanistan, Bahamas, Bangladesh, Bolivia, Fiji, Macao, Maldives, Nepal, Pakistan

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International Bureau (IB) of WIPO

Responsible for administrative tasks, such as:

- transmitting information between Offices and between applicant and Offices,
- acting as receiving Office,
- publishing the international applications,
- recording bibliographic changes,
- providing access to its files,
- receiving fees.

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Most important PCT Articles

- Art. 8 - Priority
- Art. 11 - Filing date
- Art. 14 - Defects of IA
- Art. 19 - Amendment of claims before publication
- Art. 21 - International publication
- Art. 22 - Copy, translation, fee to Designated Office
- Art. 29 - Effects of International publication
- Art. 39 - Copy, translation, fee to Elected Office
- Art. 34 - Procedure before IPEA
- Art. 49 - Right to practice

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Most important PCT Rules

- R. 2.4, R. 4.10 - Priority
- R. 12 - Language & translations
- R. 14, R. 15, R. 16 - Fees upon filing
- R. 17 - Priority document
- R. 19 - Competent rO
- R. 20 - Filing date, defects, missing parts, incorporation by reference
- R. 26bis - Correction or addition of priority claim
- R. 40 - Further search (lack of unity)
- R. 45bis - Supplementary international search
- R. 46 - Art. 19 amendments
- R. 48 - International publication, publication languages, early publication
- R. 54bis - Time limit for demand
- R. 57, R. 58 - Fees of the demand
- R. 80 - Computation of time limits, date of receipt
- R. 90 - Agents, common representatives
- R. 90bis - Withdrawals (of IA, of priority, of demand)
- R. 91 - Rectification of obvious mistakes
- R.92bis - Recording of changes

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Time limit calculation

Date of notification in both PCT and EPC (since 1 Nov 2023) is the date on the communication.

Late receipt does not change the date of notification.

However, the end of a period computed from a date of notification may be postponed if you rely on postal mail.

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Time limit calculation - example

Date of communication (setting a 1-month time limit): **1 March 2024**

Communication received: **13 March** → 12 days after the date of communication, so **5 days more than 7 days**

Time limit:

Option 1

If you don't do anything: 1 March 2024 + 1 m (R.80.2 PCT) → 1 Apr 2024 Mon, Easter, so R.80.5 PCT applies → 2 April 2024 Tue

Option 2

If you initiate dispute and prove (including providing satisfactory evidence) that you only received the communication on 13 March:

1 March 2024 + 1 m (R.80.2 PCT) → 1 Apr 2024 + **5 days (R.80.6 EPC)** → 6 Apr 2024 Saturday, so **R.80.5 PCT** applies → 8 April 2024 Monday is the last day to respond

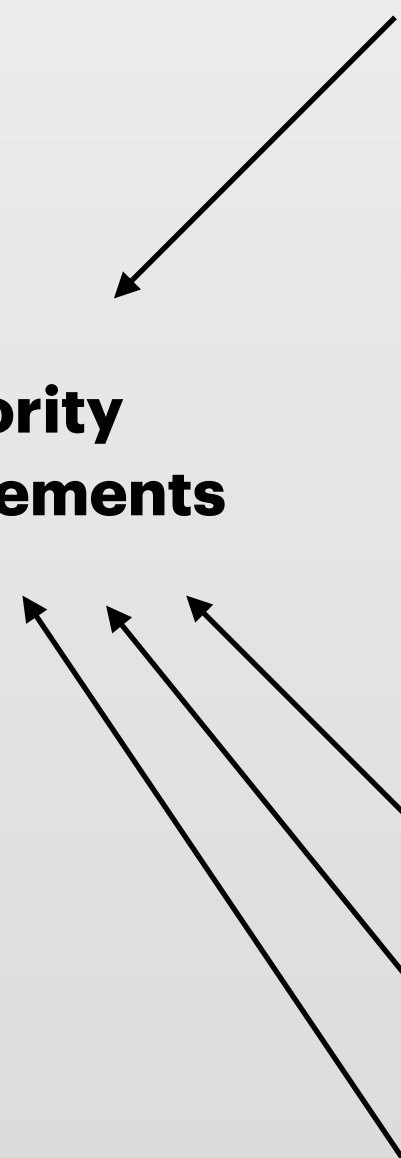
What to use first, R.80.5 or R.80.6 PCT? Answer: **R.80.6 PCT**

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Priority related legal basis

Topic	EPC	PCT	Paris Convention (PC)
12-month period	Art.87(1) EPC	Art.8(2)(a) PCT and Art.4C(1) PC	Art.4C(1) PC
Calculation of the 12 months, the day of filing not included	R.131(2) EPC (R.131(4) EPC for adding months)	A. 8(2)(a) PCT and Art.4C(2) PC	Art.4C(2) PC
Expiration on a non-working day or official holiday	R.134(1) EPC	A. 8(2)(a) PCT and A.4C(3) PC	Art.4C(3) PC
First application and first application exception	Art.87(4) EPC	Art.8(2)(a) PCT and Art.4C(4) PC	Art.4C(4) PC
Same invention	Art.87(1) EPC	Art.8(2)(a) PCT and Art.4C(4) PC	Art.4C(4) PC
Same applicant	Art.87(1) EPC	Art.8(2)(a) PCT and Art.4A(1) PC	Art.4A(1) PC

4 main priority related requirements



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Instead of FP...

R.12.3 PCT - Translation for the Purposes of International Search:

First chance to file translation: (a) Where the language in which the IA is filed is not accepted by the ISA that is to carry out the international search, the applicant shall, **within one month from the date of receipt** of the IA by the rO...

Second chance to file translation: (c)(ii) in the event that the required translation is not furnished within the time limit under paragraph (a), to furnish it and to pay, where applicable, **the late furnishing fee** referred to in paragraph (e), within **one month from the date of the invitation** or **two months from the date of receipt of the IA by the rO**, whichever expires later.

Third (and final) chance to file translation: (d) Where ... the applicant has not, within the applicable time limit under paragraph (c)(ii), furnished the required translation and paid any required late furnishing fee, the IA shall be considered withdrawn and the rO shall so declare. **Any translation and any payment received by the rO before that Office makes the declaration under the previous sentence and before the expiration of 15 months from the priority date shall be considered to have been received before the expiration of that time limit.**

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Instead of FP...

Payment of transmittal fee (R.14.1 PCT), international filing fee (R.15 PCT) and search fee (R.16.1 PCT)

First chance to pay these fees: **1 month from date of receipt** (transmittal fee (R.14.1(c) PCT), international filing fee (R.15.3 PCT) and search fee (R.16.1(f) and R.15.3 PCT)

Second chance to pay these fees: Any payment received by the rO **before that Office sends the invitation under R.16bis.1(a)** shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.3 or 16.1(f). - R.16bis.1(d) PCT - Extension of Time Limits for Payment of Fees

Third chance to pay these fees: **1 month from the date of the invitation with a late payment fee** under Rule 16bis.2 PCT (if applicable) - R.16bis.1(a) PCT

Fourth (and final) chance to pay these fees: Any payment received by the rO **before that Office makes the applicable declaration under Art.14(3)** shall be considered to have been received before the expiration of the time limit referred to in R.16bis.1(a). - R.16bis.1(e) PCT

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Instead of FP...

R.17.1 PCT - Obligation to Submit Copy of Earlier National or International Application

First time limit to submit the copy: Not later than **16 months after the priority date** - R.17.1 PCT

Second chance to submit the copy: "... provided that any copy of the said earlier application which is received by the IB after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it **before the date of international publication** of the IA" - R.17.1 PCT

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Instead of FP...

R.20.7 PCT - Time limit for filing missing parts, confirming incorporation by reference, etc.

First chance:

Option 1: where an invitation under Rule 20.3(a), 20.5(a) or 20.5bis(a) was sent to the applicant, **two months from the date of the invitation** - R.20.7(a)(i) PCT

Option 2: where no such invitation was sent to the applicant, **two months from the date on which one or more elements referred to in Article 11(1)(iii) were first received** by the receiving Office - R.20.7(a)(ii) PCT

Second (and last) chance: "Where neither a correction under Article 11(2) nor a notice under Rule 20.6(a) ... is received by the rO ...any such correction or notice received by that Office after the expiration of that time limit but **before it sends a notification to the applicant under Rule 20.4(i)*** shall be considered to have been received" - R.20.7(b) PCT

* Rule 20.4(i) PCT = Negative Determination, notifying the applicant that the application is not and will not be treated as an IA

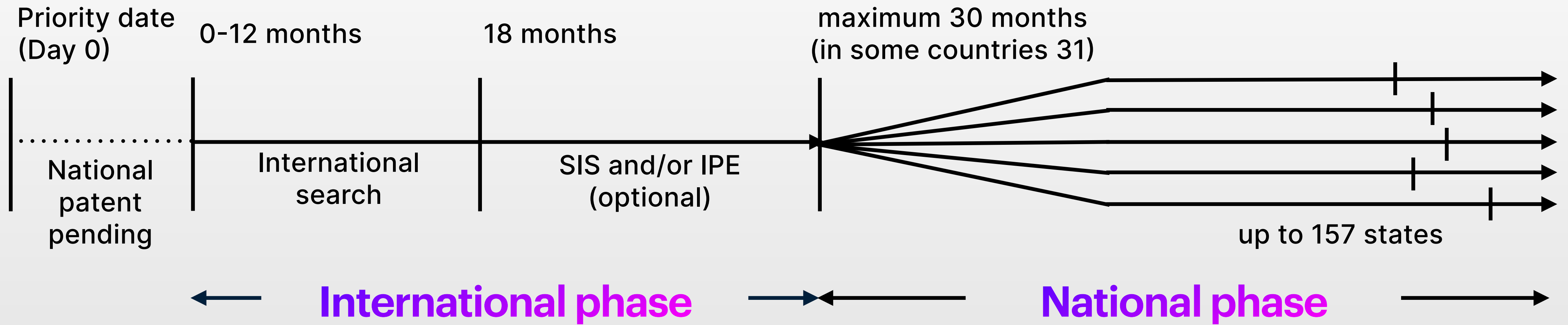
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PCT timeline

1. Filing the international application
2. International search
3. International publication
4. Supplementary international search - optional
5. International preliminary examination - optional
6. Entry into national phase

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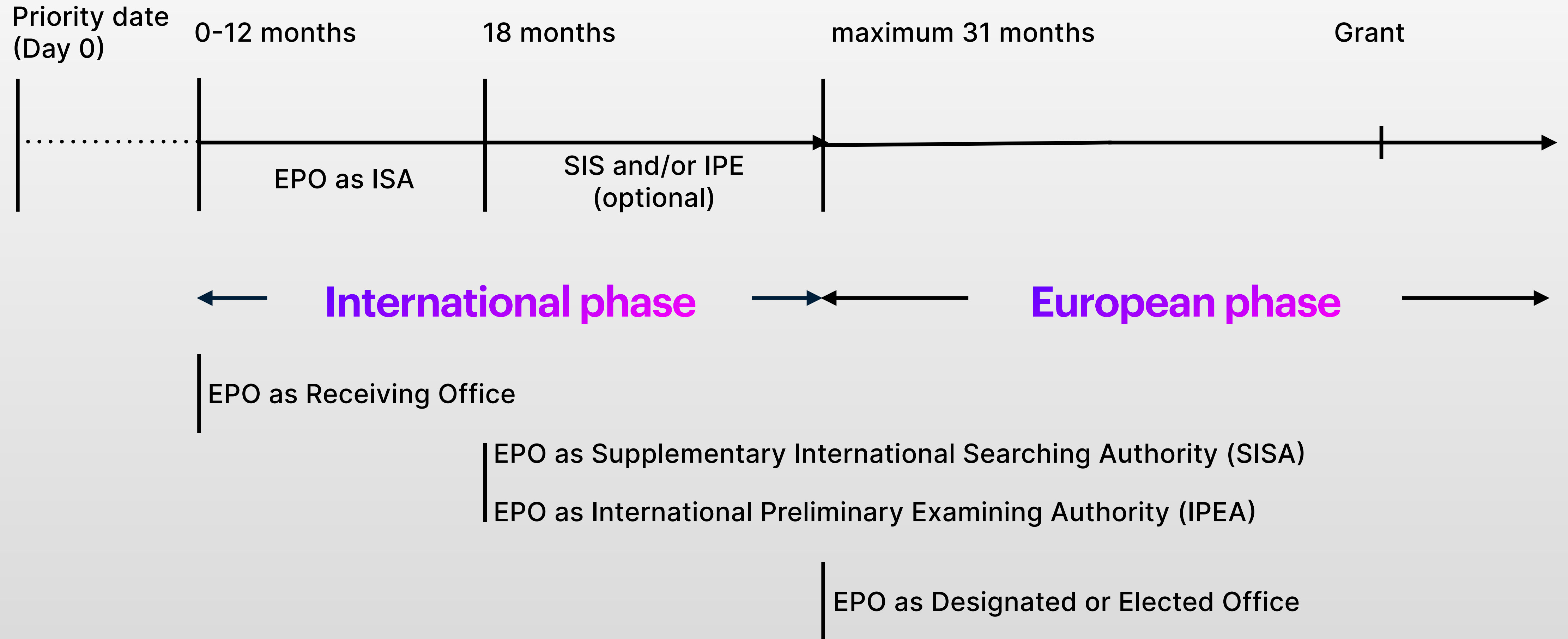
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Role of the EPO

1. Filing the international application - EPO as Receiving Office
2. International search - EPO as ISA
3. International publication
4. Supplementary international search (optional) - EPO as SISA
5. International preliminary examination (optional) - EPO as IPEA
6. Entry into national phase - EPO as Designated or Elected Office

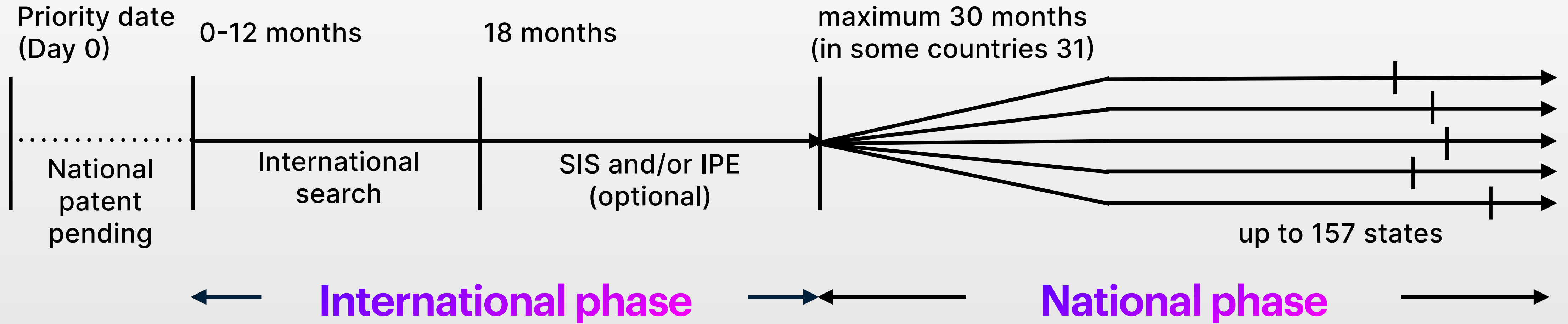
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Filing the international application

International publication

Entry into national phase

Grant

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Filing

- Who can file? (*not anyone, like in EPC*)
- Where can you file? (RO=Receiving Office)
- Language of filing (*depends on rO*)
- What is needed to get a filing date? (*claims are required too*)
- Fees: international filing fee, transmittal fee, search fee
- Representation (agent/common representative)
- Time limits for translation (for ISA and/or for publication)
- Missing parts/missing elements ('incorporation')
- Claiming priority (Paris convention)
- Missing the priority year ('restoration of right of priority')
- Remedies

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Filing - D1 questions

- 2010 D1 - Q3 (restoration of right of priority)
- 2011 D1 - Q3 (no claims - incorporation)
- 2013 D1 - Q5 a) (agent)
- 2014 D1 - Q4 (EPO as rO, signature, withdrawal)
- 2015 D1 - Q3 (priority, joint applicants, rO)
- 2016 D1 - Q2 (priority, translation)
- 2017 D1 - Q5 (restoration of right of priority)
- 2018 D1 - Q1 (missing claims - incorporation, provisional protection)
- 2019 D1 - Q3 a) (no claims - incorporation)
- 2021 D1 - Q5 (languages, translation, rO)
- 2023 D1 - Q2 (typo in priority claim, correcting priority claim)
- 2023 D1 - Q5 a) (missing abstract)

2017 D1 - Q5

French applicant G intended to file international application PCT-G claiming priority of French patent application FR-NAT1 filed on 16 February 2016 and French patent application FR-NAT2 filed on 12 February 2016. Despite all due care taken by the applicant, PCT-G was filed on 14 February 2017 with the EPO as receiving Office. PCT-G did not claim priority of FR-NAT2.

- a) How can the priority claim based on FR-NAT2 be added to PCT-G?
- b) What is the effect of the addition of the priority claim based on FR-NAT2 on the time limit for entry into the European phase?
- c) What can the applicant do before the EPO as receiving Office to avoid that the priority right of FR-NAT2 claimed for PCT-G is considered invalid in the procedure for the grant of a European patent before the EPO as designated Office?

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2017 D1 - Q5

French applicant G **intended** to file international application PCT-G claiming priority of French patent application FR-NAT1 filed on 16 February 2016 and French patent application FR-NAT2 filed on **12 February 2016**. Despite **all due care taken** by the applicant, PCT-G was filed on **14 February 2017** with the EPO as receiving Office. PCT- G did not claim priority of FR-NAT2.

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2018 D1 - Q1

On 20 February 2018, the last day of the priority period, applicant A filed international application PCT-A with the EPO as receiving Office. The request was filed using form PCT/RO/101. PCT-A was filed in French and duly claims priority of FR-A filed by applicant A in French. FR-A contains a description, drawings and one claim, the claim spanning two pages. PCT-A was intended to be identical to FR-A.

Today, 27 February 2018, the applicant noticed that the second page of the claim of PCT-A is missing from the documents submitted to the EPO.

The applicant would like to obtain provisional protection in the EPC Contracting States for the subject-matter claimed in FR-A as soon as possible.

Advise the applicant.

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2018 D1 - Q1

On 20 February 2018, the **last day of the priority period**, applicant A filed international application PCT-A with the EPO as receiving Office. The request was filed using **form PCT/RO/101**. PCT-A was filed in French and **duly claims priority** of FR-A filed by applicant A in French. FR-A contains a description, drawings and one claim, the claim spanning two pages. PCT-A was **intended to be identical** to FR-A.

Today, 27 February 2018, the applicant noticed that the **second page of the claim of PCT-A is missing** from the documents submitted to the EPO.

The applicant would like to obtain provisional protection in the EPC Contracting States for the subject-matter claimed in FR-A as soon as possible.

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R.20 PCT

- Follow **R.20.3** PCT if:
a full element is missing (full description/all claims) → this means there is no filing date!
- Follow **R.20.5** PCT if:
only part of the description/claims/drawings or all drawings are missing
- Follow **R.20.5bis** PCT (entered into force on 1 July 2020) if:
a part or an element was erroneously filed ("entire element referred to in Article 11(1)(iii) (d) or (e) has or appears to have been erroneously filed, or that a part of the description, claims or drawings has or appears to have been erroneously filed including the case where all drawings have or appear to have been erroneously filed")

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Options for applicant (R.20 PCT)

1. File missing parts/correction (within the time limit of R.20.7). This can be done after invitation or of own motion.

→ filing date becomes that later date of correction

→ if this is done under R.20.5(c) or R.20.5bis(c), applicant can request that the missing parts/corrected parts/corrected elements are disregarded so that the date is not changed - R.20.5(e) PCT

2. Confirm incorporation by reference (within the time limit of R.20.7) if priority was already claimed when filing and R.4.18 statement was filed (this is always fulfilled if PCT/RO/101 request is used at filing). This can be done after invitation or of own motion. → filing date becomes the date when the first documents were filed/filing date accorded is unchanged

3. Not doing anything or missing time limit of R.20.7 → different consequences: application not treated as an IA / missing parts will not be part of IA / IA not corrected

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Incorporation under R.20.6 PCT

Only possible, if:

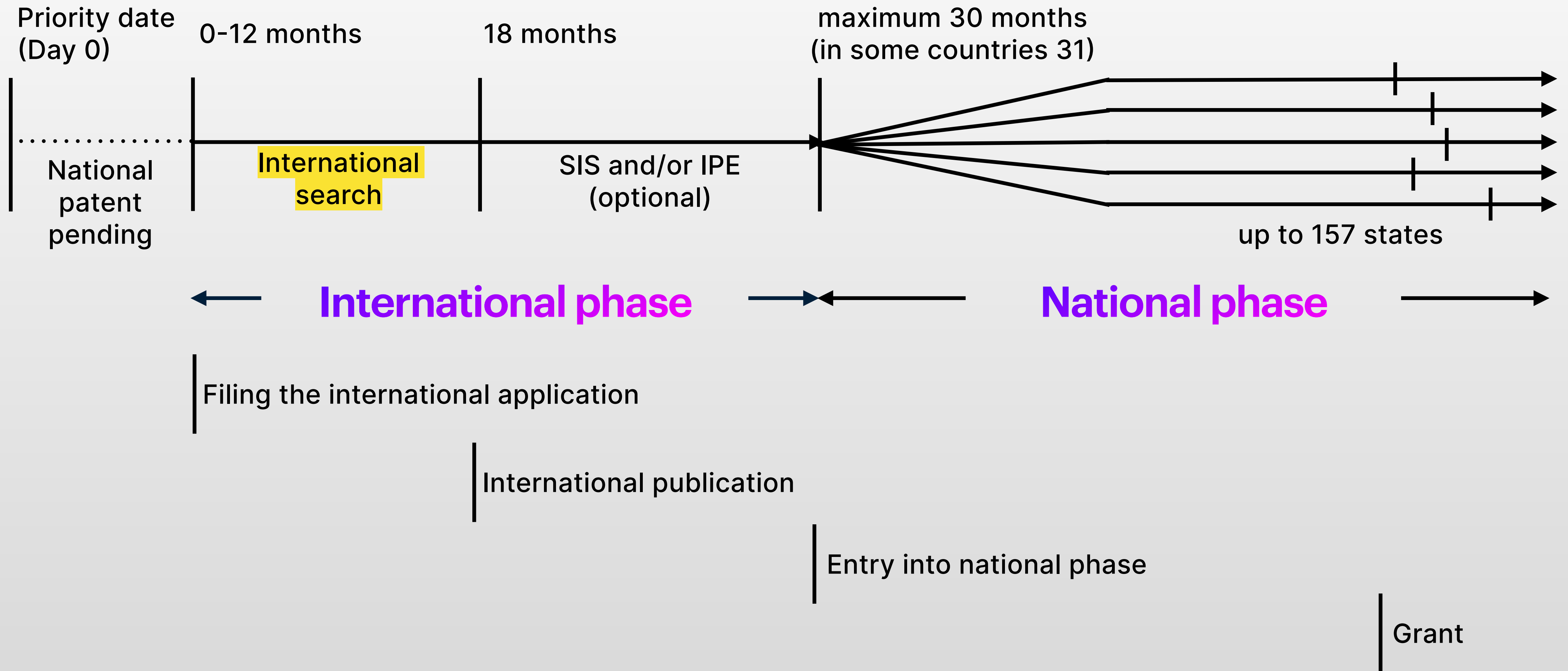
- Statement of incorporation was made at filing - R.4.18 PCT → this is satisfied if form PCT/RO/101 was used (the statement is pre-printed in that form)
- Priority was already claimed at filing* - R.4.18 PCT
- Priority application completely contains the element or part - Rule 20.6(b) PCT
- Time limit of R.20.7(a) PCT can be met

In case of successful incorporation by reference for erroneously filed elements and parts (R.20.5bis), the erroneously filed element or part concerned shall remain in the application! - R.20.5bis(d) PCT

** This requirement is now also present in EPC, see new R.56(3) EPC as in force since 1 November 2022.*

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International search

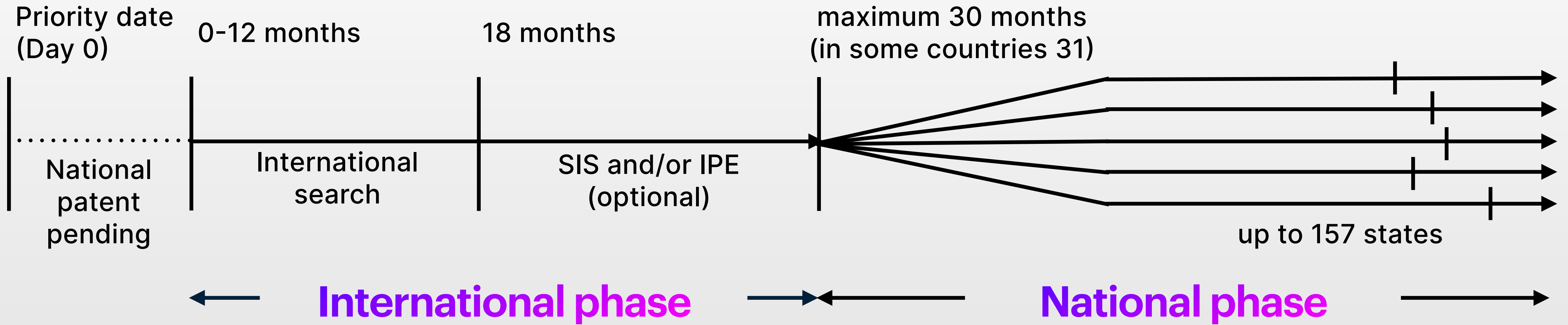
- Competent ISA (based on rO/nationality/residency)
- Prior art (only written disclosures are relevant Art.15(2) & Rule 33.1 PCT)
- Lack of unity, invitation to pay additional fee(s) for further search(es)
- Optional Art. 19 PCT amendments

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International search - D1 questions

- 2019 D1 - Q5 (lack of unity, additional search)

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Filing the international application

International publication

Entry into national phase

Grant

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International publication

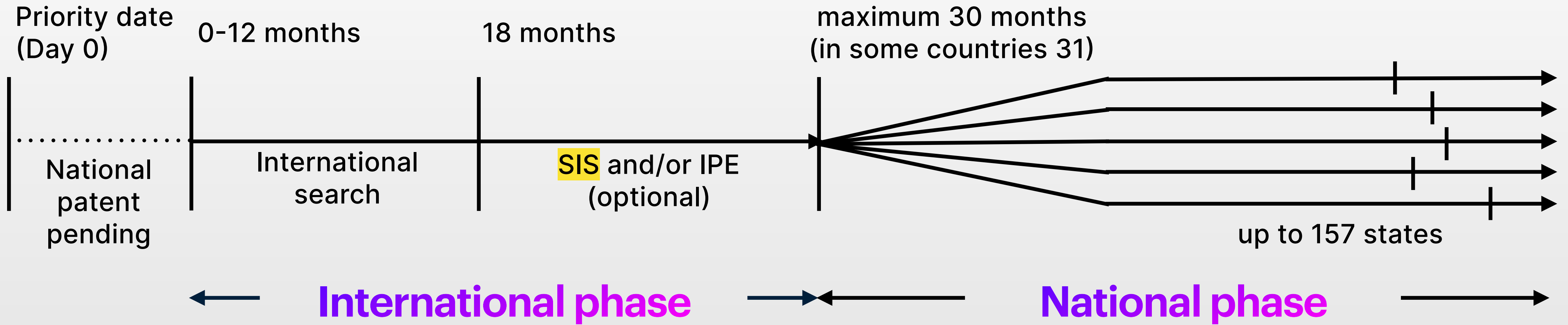
- Languages of publication: Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian, Spanish
- Requesting early publication (if no ISR yet, a publication fee applies)
- Preventing publication ('technical preparations' being completed 15 days before the actual date)
- Postponing publication (withdrawing priority claim)
- Third party observations (only novelty and/or inventive step)
- Provisional protection (e.g. obtain provisional protection in EPC countries)

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International publication - D1 questions

- 2012 D1 - Q5 (international publication, languages)
- 2018 D1 - Q1 (missing claims - incorporation, provisional protection)
- 2019 D1 - Q2 a) (third-party observations)

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Supplementary international search

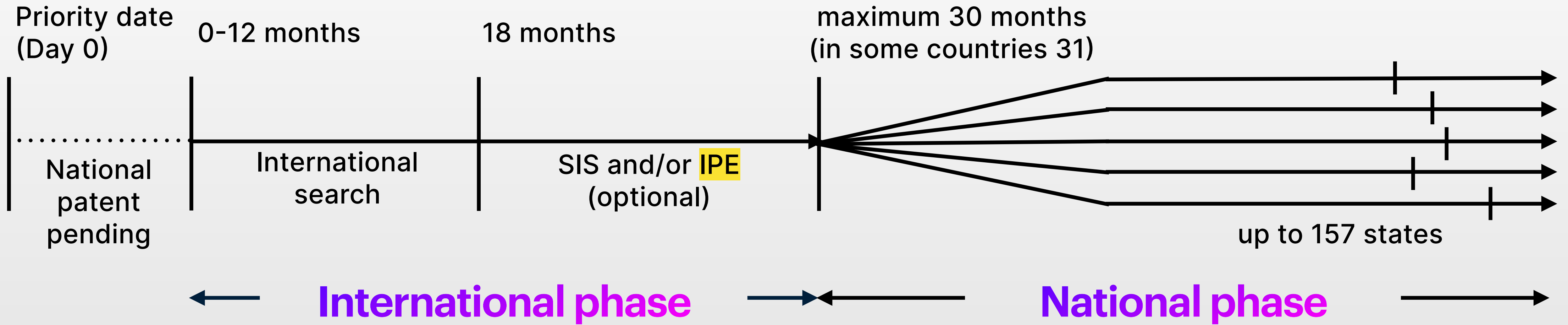
- Optional (and quite rare, about 60 yearly)
- Time limit: within 22 months from the priority date
- Fees: Supplementary search fee and handling fee (to IB!)
- Established: 28 months from the priority date

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Supplementary international search - D1 questions

- 2012 D1 - Q3
- 2022 D1 - Q3

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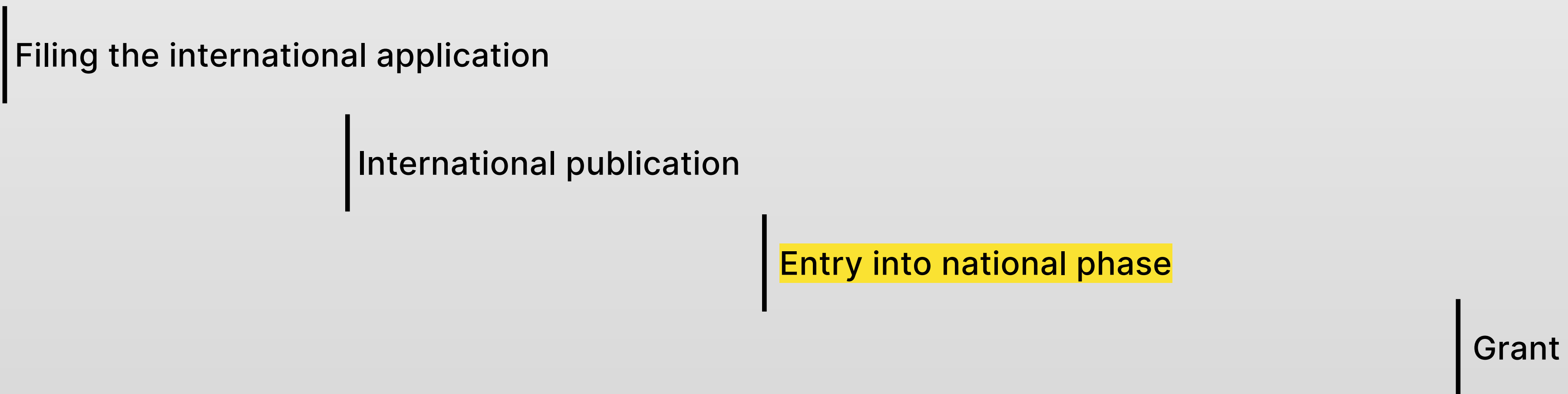
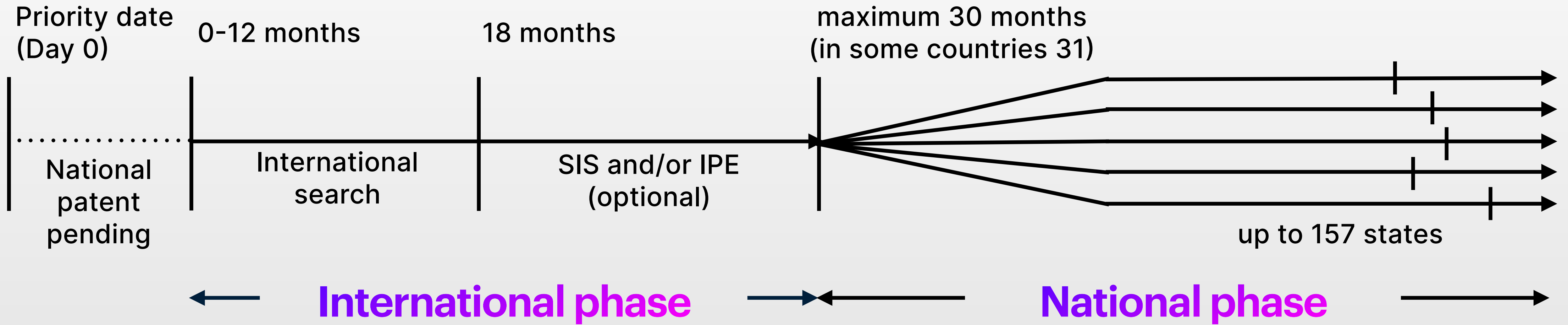
International preliminary examination

- Optional (about 10 000 yearly)
- Filing a 'demand' = requesting international preliminary examination ('Chapter 2', 'Elected office')
- Time limit: within 22 months from the priority date or 3 months from transmittal of ISR, whichever expires later
- Fees: Preliminary examination fee and handling fee (to IPEA!)
- Description, drawings and claims can be all amended (Art.34 PCT)
- Establishing 'IPER'

International preliminary examination - D1 questions

- 2013 D1 - Q5 b) (agent)
- 2023 D1 - Q2 b) (time limit for filing demand)

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Entry into national phase

- Designated Office (if no demand filed for preliminary examination)
- Elected Office (if demand filed for preliminary examination)
- Time limit for entry: 30 months (e.g. USA, BR, CN, JP)
or 31 months (e.g. EPO, IN, EA, AU)
- Grant in the national phase by the national Office has the same effect as a patent granted on a direct national application

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Entry into EP phase

- Requirements based on Rule 159 EPC (filing fee, translation, examination fee, designation fee, search fee, etc.)
- Renewal fees
- Early processing (must comply with all R. 159(1) requirements on that date!)
- Late entry with further processing
- Accelerated processing
- Representation
- R.161/162 EPC
- Supplementary European Search
- "Minimum entry" under Art.153(5) EPC to create Art.54(3) prior art
- Restoration of right of priority before the EPO, using all due care (if only 'unintentional' criteria was used in international phase)

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Entry into EP phase - D1 questions

- 2010 D1 - Q5 (EP entry, lack of unity)
- 2013 D1 - Q5 c) (agent)
- 2016 D1 - Q3 (entry, EP entry, early processing, acceleration)
- 2016 D1 - Q4 (Supplementary European Search, lack of unity)
- 2016 D1 - Q5 (minimum EP entry, Art.54(3) prior art)
- 2017 D1 - Q1 (EP entry, lack of unity)
- 2021 D1 - Q2 (restoration of right of priority)
- 2023 D1 - Q5 b) (excuse procedure before EPO as dO)

How to study PCT for the EQE?

STEP 1

Have your materials ready:

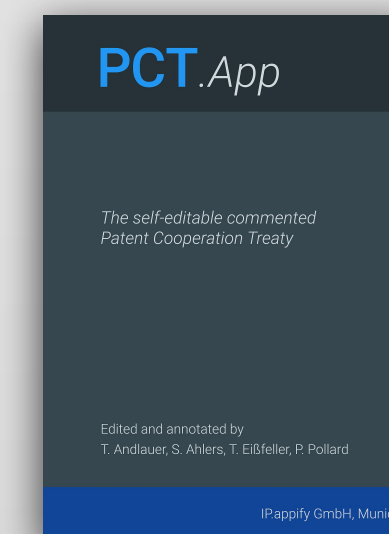
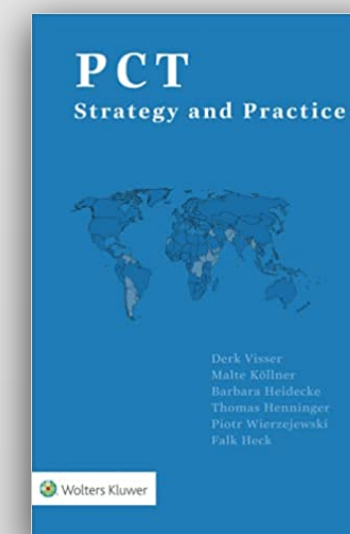
1. PCT applicant's guide
2. PCT reference book (you shouldn't change it at this point)

PCT reference books:

- The Cross-Referenced Patent Cooperation Treaty by Cees Mulder
- PCT: Strategy and Practice by Derk Visser
- PCT.app by Till Andlauer and Pete Pollard

3. Print the tables, documents you want to use

Link: fillun.com/eqe-blog/what-to-print



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How to study PCT for the EQE?

Freely downloadable PCT guides and tables on my blog (all of them updated for EQE 2024):

- Overview of ISAs for each rO
- All PCT time limits with legal basis
- Steps of Euro-PCT entry
- EPC vs PCT differences with legal basis
- Useful lists for PCT (ISA, IPEA, SISA, languages of publications, IP5 offices)
- Priority related legal basis (EPC, PCT and PC in a single table) (NEW)

Link: fillun.com/eqe-blog/downloads

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How to study PCT for the EQE?

STEP 2

Answer EQE legal questions by using your materials (annotating & highlighting your materials while answering the questions)

EQE legal questions:

- previous pre-exams (free)
- EPO pre-exam course
- previous D1 questions (free)
- EPO coffee-break questions (free)
- EPO daily D1 course (free)
- DeltaPatents legal questions (L) book
- DeltaPatents Main exam D questions (D) book

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How to answer the questions?

1. Read the question (once or twice) carefully
2. Recognise the issue (look for the hints in the question)
3. Immediately decide which book/material you are going to use
e.g. PCT applicant's guide for general PCT questions and Euro-PCT guide for EPO related questions and Zsofia's table for the time limits and EP entry
4. Look up the issue in that material (shouldn't take more than 5 seconds to open the book at that Article/Rule)

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Mock Paper D1

Wednesday, 21 February 2024

Part 1 (9:30-11:05 CET): 26 marks, 2 questions

Part 2 (11:35-13:20 CET): 29 marks, 3 questions

Online (Zoom).

<https://www.fillun.com/eqe-blog/mock-paper-d1-2024>

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Thank you!

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Good luck!