



Euro-PCT patent application route

A European patent application can be obtained by entering the European regional phase from an International PCT (Patent Cooperation Treaty) application, commonly referred to as the “Euro-PCT route”.

A European patent obtained through this route provides the applicant with the same protection and rights as a European patent obtained through a direct filing at the European Patent Office (EPO). With the Euro-PCT route, the first phase of the procedure (the International phase) is subject to the PCT, while the second phase (the regional phase) is before the EPO and is governed by the European Patent Convention (EPC).

How to enter the European regional phase

- It is necessary to complete the following acts for the European regional phase to begin:
- Payment of a number of fees. The amount payable can vary depending on certain factors, e.g., the amount may be reduced depending on which International Searching Authority (ISA) searched the application during the international phase.
- File a request for examination;
- Supply a translation of the Euro-PCT application if that application is not published in English, French or German;
- Specify the application documents on which the European grant procedure is to be based, i.e., the PCT application as filed and/or any amended application documents;
- Pay the renewal fee for the third year (only necessary if entering the European regional phase 24 months or more after the date of filing the PCT application); and
- File a certificate of exhibition (only necessary if the invention was disclosed at an officially recognised international exhibition).

On entry into the European regional phase, the applicant has the opportunity to file voluntary amendments to the application. For example, in certain circumstances, you may wish to file amendments in order to reduce the number of pages in the application and therefore reduce/eliminate excess page fees. Any amendments made must not go beyond the subject-matter disclosed in the PCT application as filed.

What is the deadline for entering the European regional phase?

The deadline for entering the European regional phase is 31 months from the earliest priority date of the PCT application, or from the filing date of the PCT application if no priority is claimed. If you wish to accelerate prosecution, then it is possible to enter the European regional phase before this deadline by requesting early processing of the application at the EPO.

If the 31 month deadline is missed, the EPO will set an additional 2 month (“further processing”) period for completing the minimum requirements mentioned above. Additional fees must be paid and these can be significant so, from a cost standpoint, it is recommended that the original 31 month deadline is met.

After entering the European regional phase

Shortly after entering the European regional phase, the EPO will issue a communication under Rule 161/162 EPC which sets a 6 month deadline (unless, as explained below, the applicant chooses to waive their right to this communication). The route the application takes at this stage depends on whether or not the EPO acted as the International Searching Authority (ISA) during the International phase of the application.

In either case, if the application includes more than 15 claims, excess claims fees must be paid by the 6 month deadline. These fees can be avoided by reducing the number of claims to 15 or fewer by this deadline.

Procedure if the EPO was the ISA

If the EPO acted as the ISA, then the EPO will have already drawn up an International Search Report (ISR) and written opinion during the PCT international phase.

If objections were raised in the written opinion, then the applicant must submit amendments and/or comments addressing those objections within the 6 month period set by the communication under Rule 161/162 EPC. The applicant can also make voluntary amendments and comments during this time.

Procedure if the EPO was not the ISA

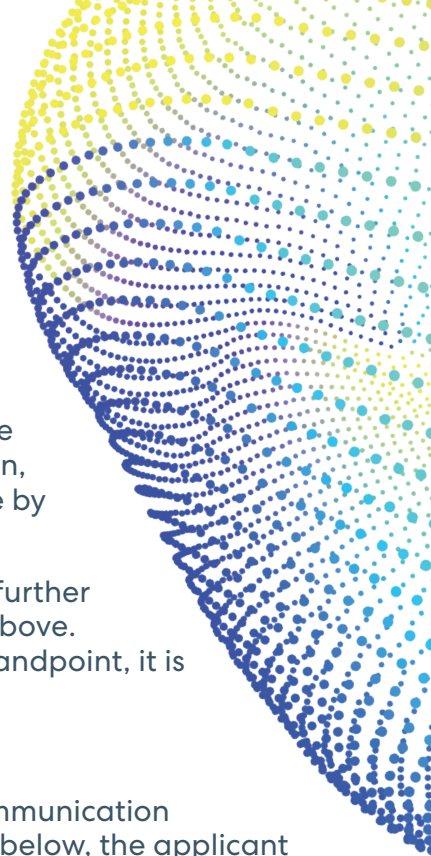
If the EPO did not act as ISA, then the EPO will have not yet performed a search on the application. In this instance, a response during the 6 month time period set by the communication under Rule 161/162 EPC is not mandatory, but the applicant may file voluntary amendments and comments.

At the end of the 6 month time period, the EPO will draw up a supplementary search report and written opinion, which together form the extended European Search Report (EESR), and any amendments and comments filed by the applicant are taken into account.

Shortly after the issuance of the EESR, the EPO will issue a communication under Rules 70(2) and 70a(2) EPC, which sets a further deadline (usually of 6 months). Prior to this deadline, the applicant must submit amendments and/or comments addressing any objections raised in the EESR and confirm that the application is to proceed further. The applicant can also submit any voluntary amendments before the deadline, if desired.

Assessment of Unity

Regardless of whether the EPO was the ISA or not, the EPO will assess unity at the end of the 6 month time period set by the R161/162 communication. The EPO will identify that the claims on file are not unified if all claims do not relate to the same invention.



If a lack of unity is identified, and the EPO was the ISA, then the applicant will be given 2 months to pay any additional search fee(s) for any unsearched invention(s).

If a lack of unity is identified, and the EPO was not the ISA, then the supplementary search report drawn up by the EPO will be a partial supplementary search report directed to the first invention mentioned in the claims. It is possible to pay further search fees to have a supplementary search report drawn up for the other invention(s).

Waiving the right to the communication under R161/162 EPC

If the applicant is interested in accelerating European prosecution of the application, then the applicant may choose to waive their right to the communication under Rule 161/162 EPC. Waiving this right allows the application to proceed without waiting for the 6 month time period that is set by a Rule 161/162 EPC communication, and can potentially reduce the time for the application to proceed to grant. Waiving this right is commonly used in addition to a request for the application to be processed under the programme for accelerated prosecution of European patent applications (PACE).

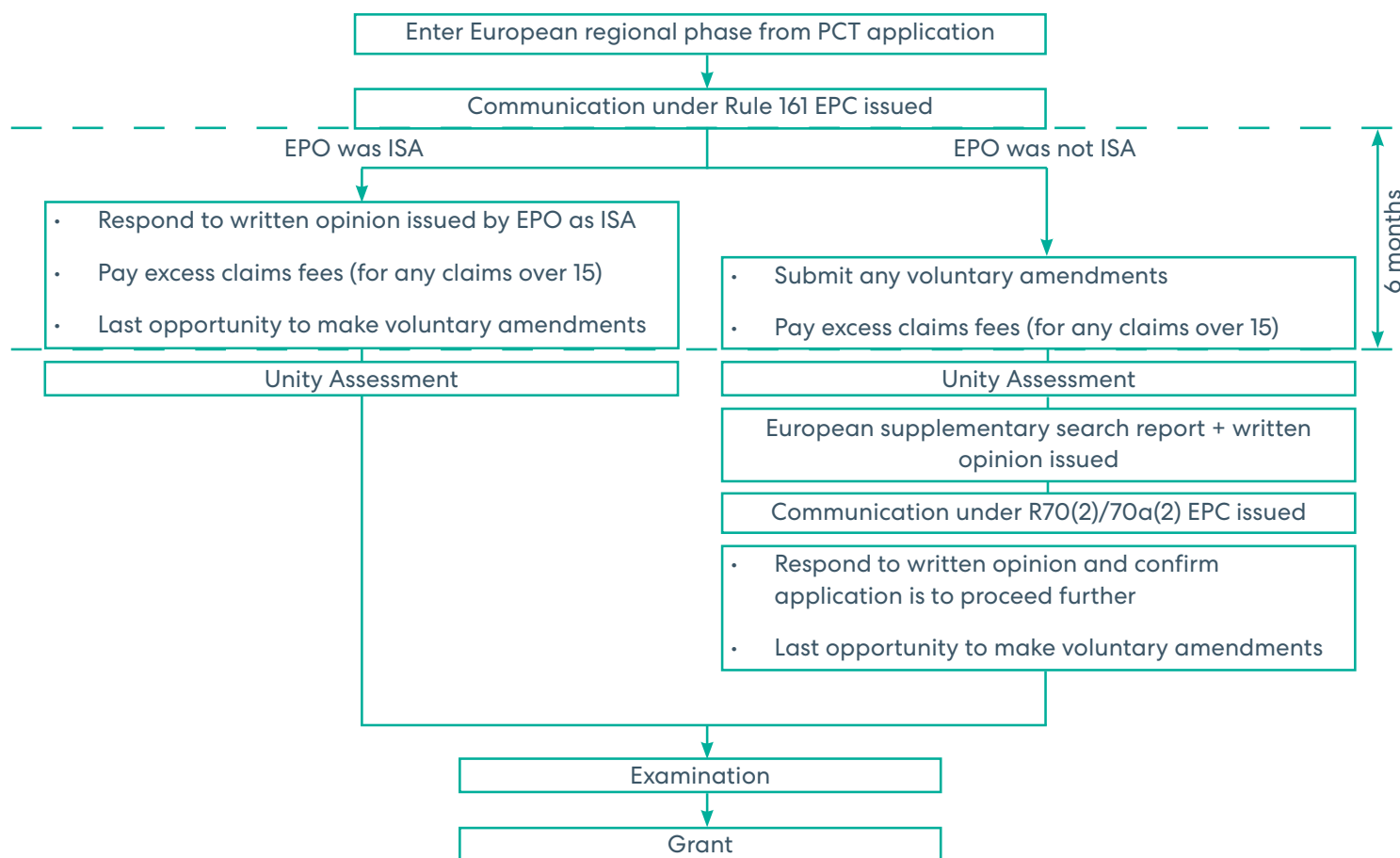
However, the waiver will only be effective if the applicant ensures all requirements for the application to proceed to the next phase of the European grant procedure are fulfilled. This includes, on entering the European regional phase, paying any necessary excess claims fees.

Examination by the EPO

The application then proceeds to substantive examination at the EPO.

Our article on [European patent prosecution](#) provides further information on the EPO procedure from examination through to grant.

The flow chart below provides a general illustration of the Euro-PCT patent application route.



This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact hlk@hlk-ip.com or your usual HLK advisor.