

Patent Cooperation Treaty (PCT) Working Group

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PCT DIRECT AT THE EUROPEAN PATENT OFFICE: STATUS REPORT

Document submitted by the European Patent Office

1. As reported in a document presented by the European Patent Office (EPO) at the Working Group in 2015 (document PCT/WG/8/17), on November 1, 2014, the EPO in its capacity as receiving Office (RO) and International Searching Authority (ISA) launched a new PCT service, called "PCT Direct" (see Notice from the EPO dated August 18, 2014, published in OJ EPO 2014, A89).
2. As of July 1, 2015, the possibility to use the PCT Direct service was extended to all receiving Offices. As a result, applicants who selected the EPO as ISA are in the position to submit PCT Direct letters with their applications irrespective of the receiving Office (see Notice from the EPO dated June 22, 2015 published in OJ EPO 2015, A51). The Israel Patent Office is offering a similar service since April 1, 2015, and any other ISA may also decide at any time to offer a similar service. The PCT electronic filing tools have been adapted accordingly, including ePCT, and the PCT Receiving Office Guidelines have been modified to ensure a smooth prosecution of the PCT Direct letters from the part of the receiving Offices (new paragraph 116E).
3. Under PCT Direct, an applicant filing an international application claiming priority from an earlier application already searched by the EPO may react to any objections raised in the search opinion drawn up for the priority application. This new service simplifies the assessment of the international application and adds to the value of the international search report and written opinion established by the EPO. PCT Direct effectively links first filings at the EPO with subsequent international applications with the EPO as ISA. The PCT Direct letter enables examiners and applicants to optimally benefit from the work done for the first filing. When preparing the International Search Report (ISR) and written opinion (WO-ISA), the examiner takes these submissions into account, so that the outcome of the PCT Chapter I procedure at

EPO is actually comparable to the second office action, which would be more often positive, as experience over the last years has shown.

4. In order to use this service, an applicant should prepare a separate document entitled "PCT Direct / informal comments" clearly identifying in the header the application number of the earlier application. The PCT Direct letter and any marked-up copy of the claims and/or the description should be submitted as a single document (in PDF format – if filed electronically) and indicated in the PCT/RO/101 Form by checking Box IX. In particular, the words "PCT Direct / informal comments" should be specified under point 11, "Other", for filings on paper and as a remark for filings in electronic form using the EPO online filing software or the EPO new online filing (CMS). For filings in electronic form using WIPO's ePCT portal, the PCT Direct letter and any marked-up copy of the claims and/or description are to be uploaded as "Other documents" by selecting the box "Applicant letter to ISA concerning earlier search ("PCT Direct")".

5. Upon receipt of a PCT Direct letter, the international application will be processed under PCT Direct only where the following two requirements are met:

- (a) the informal comments are filed together with the international application; and
- (b) the international application claims priority of an earlier application searched by the EPO (i.e. European *premiers dépôts* or certain national first filings).

6. From the introduction of this service on November 1, 2014 up until March 31, 2016, the EPO received in total 3,048 PCT applications with PCT Direct letters attached. On average, this represents 180 files per month over the whole period (17 months), and 200 files per month in the last full year (March 2015 to March 2016). User groups have praised the launch of this new service as it brings more efficiency both for them and for the EPO as ISA.

7. The Working Group is invited to take note of the contents of the present document.

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