

## The EPO as designated or elected Office in the CNIPA-EPO pilot

### What steps do I have to take on entry into the European phase?

Entry into the European phase consists of a series of steps that need to be taken within 31 months from the priority date or, if no priority is claimed, within 31 months from the international filing date ([Rule 159\(1\) EPC](#)). Which ones need to be taken depends to a certain extent on the "history" of the international application, e.g. what language it was published in and which office acted as International Searching Authority. The steps that applicants participating in the CNIPA-EPO pilot will need to take to enter the European phase are:

- specify the application documents on which the procedure before the EPO as designated or elected Office is to be based ([Rule 159\(1\)\(b\) EPC](#)),
- pay the filing fee and, if applicable, any additional fees for pages over 35 ([Rule 159\(1\)\(c\) EPC](#)),
- pay the designation fee (within six months from publication of the international search report (ISR) or, if that six-month period has expired earlier, within the 31-month period) ([Rule 159\(1\)\(d\) EPC](#)),
- file the request for examination and pay the examination fee (within six months from publication of the ISR or, if the six-month period has expired earlier, within the 31-month period) ([Rule 159\(1\)\(f\) EPC](#)),
- pay the third renewal fee, if applicable ([Rule 159\(1\)\(g\) EPC](#)). The third renewal fee may be paid up to six months before it falls due ([Rule 51\(1\) EPC](#)).

You are advised to use EPO Form 1200 to file your request for entry into the European phase. It is available in the EPO's online filing tools ([Online Filing](#) or new online filing ([CMS](#))) or as a paper form. In both cases, you will be guided through all the requirements to be fulfilled.

### What advantages can I expect as a pilot participant in the European phase?

As a pilot participant, you will have the following three advantages:

**Firstly**, since only international applications filed in English can be processed under the CNIPA-EPO pilot and English is anyway one of the EPO's official languages, **you will not need to file a translation of your international application on entry into the European phase.**

**Secondly**, where the EPO has already drawn up the international search report, the supplementary European search report ([Article 153\(7\) EPC](#)) is dispensed with in the European phase and so **you will not need to pay a European search fee on entry into this phase.**

**Thirdly**, if you chose to file a demand for international preliminary examination under PCT Chapter II, with the EPO acting as IPEA, the examination fee payable on entry into the European phase **will be reduced by 75%.**

**Where can I find out more about the procedure before the EPO as designated or elected Office?**

Details of the steps to take to enter the European phase, including those relating to representation, and of the subsequent procedure before the EPO as designated or elected Office can be found in [Chapter 5 of the Guide for applicants: PCT procedure before the EPO \(Euro-PCT Guide\)](#).

## **Options available to applicants participating in the CNIPA-EPO pilot for expediting the proceedings before the EPO as designated or elected Office**

### **How can I expedite the grant proceedings for my Euro-PCT application?**

By choosing **the EPO as ISA** you already **automatically shorten the proceedings before the EPO as designated or elected Office by up to 12 months**. This is because the supplementary European search report, which can take six months to establish, is dispensed with, and so you also do not need to file a reply to the EPO's accompanying search opinion (ESOP) ([Rules 70\(2\) and 70a\(2\) EPC](#)), which saves you another six months.

Additionally, three further options are available which you can use to make the prosecution of your application in the European phase even faster:

- Filing a request for early processing under Article 23(2) or 40(2) PCT.
- Waiving the right to a communication under Rules 161(1) and 162(2) EPC, **saving you the period of six months** subsequently available for filing any amendments or comments.
- Filing a **request for accelerated examination** under the "PACE" programme.

All these options are free of charge and can be selected in combination.

### **What is the effect of filing a request for early processing and how do I do it?**

The EPO as designated/elected Office will normally not process an international application before expiry of the 31-month time limit from the date of filing or, if priority has been claimed, from the priority date (Articles 22(3) or 39(1)(b) PCT, Rule 159(1) EPC). However, you can ask it to start the processing of your application earlier by filing an explicit request for early processing (Article 23(2) or 40(2) PCT). **A request for early processing can be filed at any time before expiry of the 31-period limit** under [Rule 159\(1\) EPC](#). You can file it directly in EPO Form 1200 ("Entry into the European phase") by simply selecting the checkbox provided in the EPO's online filing tools (Online Filing or new online filing (CMS)) or in the [paper form](#) (section 12.1).

The request for early processing is effective only if you comply with the requirements of Rule 159(1) EPC as if the 31-month time limit expired on the date you filed it. For further details on requesting early processing, see the Guidelines for Examination in the EPO, [Part E-IX, 2.8](#).

It is also recommended that you wait to receive the international search report (ISR) before filing the request.

If you selected the EPO as ISA, the ISR will be established about four to six months after the date of filing. If you file a request for early processing straight after receiving the ISR, you can shorten the international phase by up to 15 months. The EPO has direct access to the search results in its own files. This saves the administrative work involved in obtaining the documents via the International Bureau.

### **What is the communication under Rules 161 and 162 EPC for and how can I waive my right to it?**

As soon as your international application has validly entered the European phase, the EPO will issue a communication under Rules 161(1) and 162(2) EPC. In this communication, it will invite you to amend your Euro-PCT application as required to correct any deficiencies in the international application identified in the written opinion of the ISA ("WO-ISA") or, if no such deficiencies were identified in the WO-ISA, provide you with a further opportunity to file any voluntary amendments (Rule 161(1) EPC). It will also invite you to pay any claims fees for claims over 15 which have not yet been paid (Rule 162(2) EPC). You will then have six months to reply to the communication. The EPO will only continue processing your application once this time limit has expired.

**However, if you want to expedite the proceedings, you can waive your right to this communication.** You can do this directly in EPO Form 1200 ("Entry into the European phase") by simply selecting the checkbox provided in the EPO's online filing tools (Online Filing or new online filing (CMS)) or in [the paper form](#) (section 12.2, first checkbox).

A waiver of the right to a communication under Rules 161(1) and 162(2) EPC will be effective only if you have also fulfilled all the requirements of Rules 161 and 162 EPC on entry into the European phase (i.e. you have paid any claims fees due and, where required, submitted a response to the WOISA under Rule 161(1) EPC).

### What can I do if I omitted to file a waiver or did not fulfil the further requirements for the waiver?

If you omitted to file a waiver or **if you did not fulfil the further requirements for the waiver**, the communication under Rules 161(1) and 162(2) EPC will be issued. However, you can still shorten the subsequent six-month period by filing an early response to the communication and explicitly stating that you do not wish to use the remainder of the period.

Further information on the communication under Rules 161 and 162 EPC and the waiver option can be found in the Guidelines for Examination in the EPO, [Part E-IX, 3.2](#), and in the [notice from the EPO dated 30 November 2015 concerning ways to expedite the European grant procedure](#).

To ensure the proceedings continue to move quickly, you should not wait until the grant stage to file any voluntary amendments but should file them as soon as possible too, e.g. already on entry into the European phase.

### What are the advantages of a PACE request and how can it be filed?

Where a request to participate in the programme for accelerated prosecution of European patent applications ("PACE") is on file, the examining division will aim to issue its next official communication within three months from receipt of the applicant's latest action.

The request can be filed only once during the examination stage and is free of charge. If you want fast processing of your Euro-PCT application right from the outset, you should already file the PACE request on entry into the European phase.

You must file your PACE request online using [EPO Form 1005](#), which contains a preformulated request for accelerated examination. It is not included in the public part of the file so the public will not be informed of your wish to accelerate examination.

## What must I do in order to remain in the PACE programme?

In order for your application to remain in the PACE programme, you must take care not to delay the proceedings. In particular:

- You must not ask for any time extensions.
- You must file a reply to any communication from the EPO within the basic time limit.
- You must not risk any loss of rights or a refusal.
- You must pay the renewal fees within the basic time limit ([Rule 51\(1\) EPC](#)) and must not make use of the six-month period available for paying them with a surcharge ([Rule 51\(2\) EPC](#)).

## Does a PACE request make any difference to the period under Rules 161(1) and 162(2) EPC?

A PACE request does not shorten the six-month period for replying to a communication under Rules 161(1) and 162(2) EPC. Unless you have waived your right to the communication altogether, this period can only be shortened by filing an early reply in which you explicitly state that you will not use the remainder of the period to file further amendments.

## Does a PACE request have the same effect as a request for early processing?

No. A PACE request does not result in early processing of the file under Article 23(2) or 40(2) PCT. Nor does an effective request for early processing mean that the application is automatically part of the PACE programme. Instead, each request must be filed separately.

Further information on the PACE programme can be found in the Guidelines for Examination in the EPO, [E-VIII, 4](#) and [4.2](#), and in the related [notice from the EPO dated 30 November 2015](#).

## How to accelerate prosecution of your Euro-PCT application: a summary for pilot participants

To ensure that the prosecution of your Euro-PCT application before the EPO as designated or elected Office will be accelerated, it is recommended that you:

- Use EPO Form 1200 for entry into the European phase. You can submit it online using the EPO's Online Filing or new online filing (CMS) tool or on paper (download free of charge from [epo.org/applying/forms/forms](http://epo.org/applying/forms/forms)).
- Enter the European phase and file a request for early processing by selecting the checkbox provided in EPO Form 1200 as soon as you have received the international search report.
- Pay the designation fee and the examination fee on your early entry into the European phase. This saves you from having to monitor time limits and ensures that the examining division is competent to deal with your application from the day your request for early processing becomes effective.

- Waive your right to a communication under Rules 161(1) and 162(2) EPC by selecting the checkbox provided in EPO Form 1200. Ensure that you have also filed any required reply to the WOISA and paid any claims fees for claims over 15.
- File any voluntary amendments at this stage already.
- Make sure that any amendments comply with the patentability requirements under the EPC.
- File a PACE request on EPO Form 1005 via Online Filing or new online filing (CMS) at the same time as your request for entry into the European phase (EPO Form 1200).