

New practice of EPO acting as IPEA

During the PCT-procedure the applicant has the possibility to demand International Preliminary Examination under Art. 31 PCT ("Demand for Chapter II"). This possibility is often used by applicants when a negative International Search Report is received while an International Preliminary Examination Report (IPER) with a positive opinion is desired. Together with the filing of the demand, arguments and possibly claim amendments have to be filed relating to the objections raised in the search report.

A positive IPER may result in a relatively easy and fast grant, especially in the case when the European Patent Office (EPO) acts as IPEA and the applicant seeks a European patent. If all objections can be overcome during the Demand phase, the European Examiner can issue an intention to grant as first communication after conversion of the PCT-application into a European patent application.

Also, for some applicants, a positive IPER may be helpful for other purposes, such as for convincing financiers.

As filing a demand is rather expensive (official fee is 1910€), applicants expect a real opportunity to “debate” the objections raised in the Search Report with the Examiner. In practice, this was not always the case. In some cases, a negative IPER was issued in response to the demand in which the arguments of the applicant were refused. When an IPER is issued, no further debate with the PCT-examiner is possible. This practice left applicants unsatisfied and in doubt whether to continue the application in national or regional procedures.

New practice: second written opinion

Now the EPO announced a new practice. The EPO states:

The new practice (...) provides for a further opportunity for dialogue with the EPO as IPEA, thereby giving applicants more scope to enter the national phase before the elected Offices with a positive IPER. In doing so, the new practice adds to the value of the international preliminary examination procedure before the EPO as IPEA.

Part of the new practice is that before issuing a negative IPER, the EPO in its role as IPEA will, as a rule, issue one additional written opinion (hereafter: “second written opinion”). A negative

IPER is an IPER which contains objections which would hinder a direct grant in the European phase. In the second written opinion normally a time limit for a reply will be given to the applicant of two months, but not shorter than one month.

So, in case the EPO acted as International Search Authority (ISA), the written opinion of the ISA will be considered the first written opinion and a second written opinion will be issued if the applicant filed amendments *and/or* arguments and there are still objections outstanding such that the IPER would be negative.

In cases where the EPO didn't act as International Search Authority (ISA), the EPO as IPEA will issue a first written opinion. If the applicant filed amendments *and/or* arguments and there are still objections outstanding such that the IPER would be negative, a second written opinion will be issued.

Consultation by telephone

Of course, the opportunity for consultation by telephone is still available.

The applicant may request such a consultation by telephone to discuss issues of the application with the PCT examiner. During the previous practice, such a consultation was only available after a second written opinion was issued, which was not always the case. In the new practice, before the second written opinion is issued, the applicant may also request a consultation by telephone or request a consultation by telephone and a second written opinion.

In case a request for consultation is made before the issue of the second written opinion is issued, the applicant is sent the minutes of the telephone consultation together with an invitation to submit further amendments *and/or* arguments within

the time limit set for reply therein. No second written opinion will be issued, since this procedure allows a dialogue with the applicant comparable to the usual procedure as if a second written opinion would have been issued.

When a request for consultation *and/or* a request for a second written opinion (pursuant “Chapter II”) is made before the issue of the second written opinion is issued, the EPO may proceed in the most appropriate way. The examiner will decide either to consult the applicant by telephone as described above or to establish a second written opinion.

If the request for consultation by telephone is made after the second written opinion has been issued, but before the date on which the IPER is established, the minutes of the telephone consultation are sent to the applicant but will not be accompanied by an invitation to submit further amendments *and/or* arguments and none will be accepted by the IPEA, unless agreed upon during the consultation by telephone.

Conclusion

Filing a request for International Preliminary Examination has become more attractive for applicants, as the EPO now guarantees more room for discussing the case with the PCT-Examiner.



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