

European (PCT) patent application





A European regional phase application based upon a PCT application must be filed within 31 months of the priority date.

The documents/information/instructions required by us to prepare a European patent application based on a PCT application are as follows:

- The PCT application number, publication number and filing date.
- A copy of any amendments made under Articles 19 or 34 PCT to the application.
- Filing and (where applicable) search fees must be paid within 31 months from the priority date. If there are more than 15 claims in the patent specification, then extra fees will have to be paid for each claim over 15. Amendments to reduce the number of claims, and hence the number of claims fees payable, can be made at the time of European phase entry or in response to an EPC communication issued shortly afterwards. We need to know if the applicant wishes to make any amendments upon European regional phase entry.
- Designation and examination fees must also usually be paid within 31 months
 from the priority date. The designation fee serves to designate the application to
 all countries which were a party to the EPC when the PCT application was filed.
 The applicant can also choose, by paying an extension or validation fee, to extend
 the EPC application to any countries which were EPC extension or validation states
 when the PCT application was filed. We need to know if the applicant is interested
 in any validation or extension states because the fees are payable at the same time
 as the designation fee.
- Where the language of the PCT application was not English, French or German a translation into one of the three languages must be provided. A translation of the specification as originally filed together with a translation of any amendments under Articles 19 or 34 PCT is required within 31 months of the priority date.
- If an international preliminary examination has been carried out, it is helpful for us to have a copy of any written opinion and the international preliminary examination report (with annexes and a copy of any documents cited in the report).

The European Patent Office does not require any forms to be signed by the applicant. It does have the right to request a power of attorney form signed by the applicant, but rarely does.

This information has been prepared by Boult Wade Tennant.

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The prosecution stages of a European patent application derived from the PCT

Approximate Notes time scale (from international At this stage, it is necessary to file a translation of the priority date) specification if not in English, German or French and pay regional phase entry filing, search, designation, examination, excess pages and No later than excess claims fees as appropriate. 31 months from priority date An additional claim fee is levied for each claim in excess of 15. The EPO sets a six month period to file amended amended claims 32 months claims that allows a reduction in the fees payable and, if & response to the EPO acted as International Searching Authority, to file written opinion a response to any objections raised in the written opinion. For PCT applications filed in English, French or German, 34 months **Publication** this is to be publication of bibliographic details only. The actual due date is the last day of the month irst maintenance fees 3 vears containing the second anniversary of the PCT filing date. This report is only issued if the international application Supplementary 3-5vears was not searched by the EPO (otherwise the application search report goes straight to examination). If an SSR is issued, the EPO invites the applicant to confirm File response to SSR 31/2-51/2 vears their wish to proceed and to respond to the SSR's opinion on patentability within six months. 3-6 years Application examined If the Examiner's objections to the patentability of the invention in the examination report are not overcome by the response, which may include amendments to the Examination claims and/or arguments, further examination reports may report issued be issued until the application is accepted, abandoned by the applicant or rejected as being unpatentable. If the examiner has no Four months is set as the period for responding to each (further) objections examination report. File response to Applicant sent copy of text for approval and invited to file The claims must be translated into French and German and fees for grant and printing paid within four months of 3-8 years and pay for grant and receipt of the text the EPO considers allowable for grant. printing -Third parties may file an opposition to the patent up to 4-9 years Patent granted and opened to opposition nine months after the grant date.

Patent brought

into force in contracting states of applicant's choosing

Annual renewal fees

Patent expires

20 years from

international

filing date

004d

This must happen within three months of grant and may necessitate the filing of a translation of the specification

into the local language (e.g. Spanish, Italian etc.), paying

official fees and appointing a local patent agent. The result is the conversion of the European patent into a

The annual maintenance fees to the European Patent Office cease on grant and are replaced by renewal

fees payable in each country into which the patent was brought into force. If the annual renewal fees

are paid every year the patents will last 20 years from

the PCT filing date, otherwise they will expire on

bundle of individual national patents

non-payment of the renewal fee.