

European (PCT) patent application



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

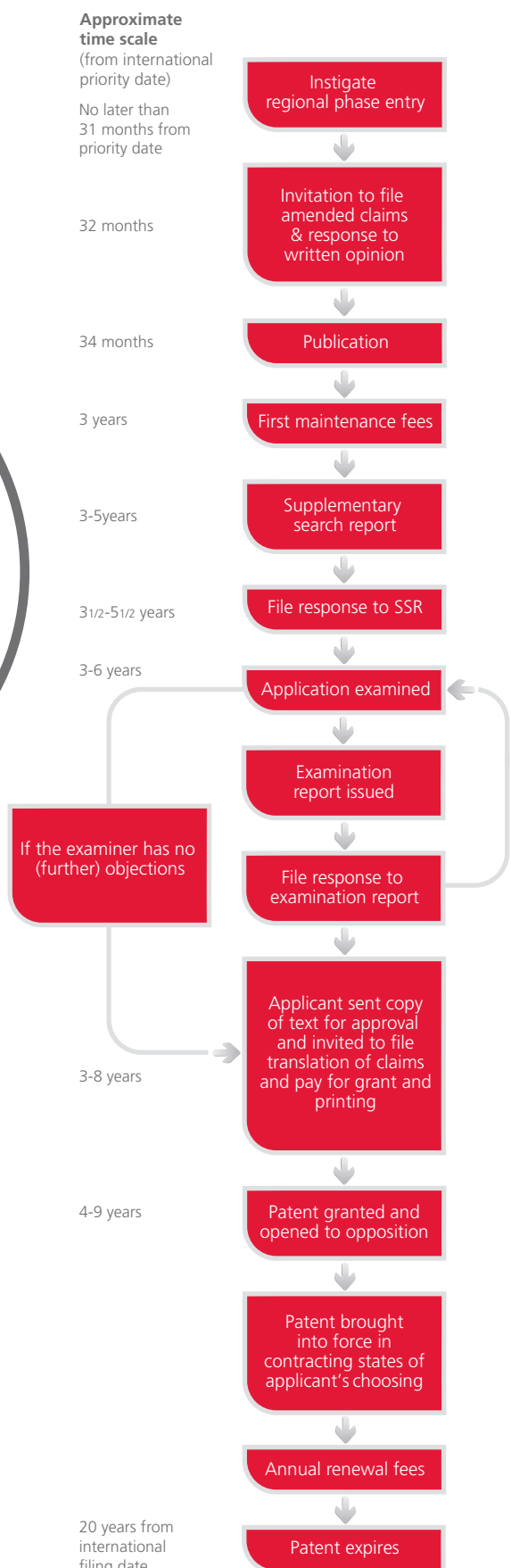
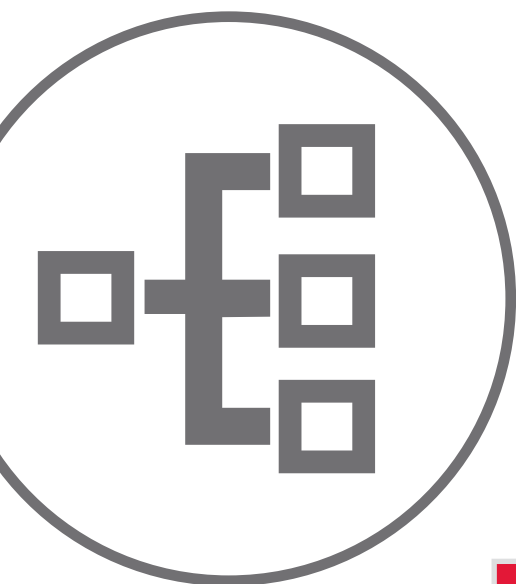
The documents/information/instructions required by us to prepare a European patent application based on a PCT application are as follows:

- 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.



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



Notes

At this stage, it is necessary to file a translation of the specification if not in English, German or French and pay filing, search, designation, examination, excess pages and excess claims fees as appropriate.

An additional claim fee is levied for each claim in excess of 15. The EPO sets a six month period to file amended claims that allows a reduction in the fees payable and, if the EPO acted as International Searching Authority, to file a response to any objections raised in the written opinion.

For PCT applications filed in English, French or German, this is to be publication of bibliographic details only.

The actual due date is the last day of the month containing the second anniversary of the PCT filing date.

This report is only issued if the international application was not searched by the EPO (otherwise the application goes straight to examination).

If an SSR is issued, the EPO invites the applicant to confirm their wish to proceed and to respond to the SSR's opinion on patentability within six months.

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 claims and/or arguments, further examination reports may be issued until the application is accepted, abandoned by the applicant or rejected as being unpatentable. Four months is set as the period for responding to each examination report.

The claims must be translated into French and German and fees for grant and printing paid within four months of receipt of the text the EPO considers allowable for grant.

Third parties may file an opposition to the patent up to nine months after the grant date.

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 bundle of individual national patents.

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 non-payment of the renewal fee.

Approximate time scale
(from international priority date)

No later than 31 months from priority date

32 months

34 months

3 years

3-5 years

3 1/2 - 5 1/2 years

3-6 years

3-8 years

4-9 years

20 years from international filing date

If the examiner has no (further) objections

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This publication does not necessarily deal with every issue or cover all aspects of
the topics with which it deals. It is not intended to provide legal or any other advice.

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