Consultation results concerning comments on the PCT-EPO Guidelines 2018
16th meeting of the SACEPO Working Party on Guidelines, held on 21 November 2018

General	Comments/ suggestion	Consultation results
2.1	Each Part of the Guidelines is divided into Chapters, each sub-divided into numbered sections which are further sub-divided into paragraphs. Cross-references to other paragraphs are in the format GL/PCT-EPO, followed by the relevant letter of that Part, then the Chapter number (a Roman numeral) and then the section and paragraph numbers (thus, e.g. GL/PCT-EPO C-V, 4.2, would be used to refer to paragraph 4.2 of Chapter V of Part C of the PCT-EPO Guidelines). The marked up is inconsistent with terminology in new version the EPC guidelines – see EPC, General part, 2.2, 4th paragraph? paragraph > sub-section	Agreed. The PCT-EPO Guidelines will be aligned to the EPC Guidelines.
General comment	From last year: We notice that the Euro-PCT Guide has been given an official status (emphasis added): They will exist in parallel to the Euro-PCT Guide "PCT procedure at the EPO, [International phase and entry into the European phase], Guide for applicants"), which has the status of a Notice from the EPO. In the past the Euro-PCT has not legal status as was acknowledged on the EPO website. In fact, the text on the	The Office repeated its comment from last year: *1. The status of the Euro-PCT Guide is that of a Notice from the EPO; it mostly consolidates Decisions and Notices published in the OJ EPO. This was already confirmed for clarification purposes in the November 2015 edition of the PCT-EPO Guidelines.* *2. The place where a document is available on EPO's website has no influence on the legal nature of such document.*

	EPO website http://www.epo.org/applying/international/guide-for-applicants.html The references in the Guidelines to the Guide of Applicants and vice versa confuses a) as to which of the two documents prevails and b) as to the binding nature of their provision. In the case of the EPC Guidelines, it is noted that the "Guidelines do not constitute legal provisions" However, they are cited in Office Actions and Communications and they are adopted in accordance with Art. 10(2)(a) of the European Patent Convention. Contrary to the Guidelines, the "Guide for applicants" aims to provide companies, inventors and their representatives with an outline of the procedure involved in applying for a European patent and they are not quoted by EPO (at least to my knowledge) in Office Actions and Communications. It is worthwhile to note that the present version of the EPC Guidelines quote the "Guide for applicants" only in relation to PCT applications (Part E Chapter VIII – Applications under the Patent Cooperation Treaty (PCT)), whereas they do not make any reference to the Guide for Applicants in all other Parts or Chapters. SUGGESTIONS: We therefore suggest deleting the references to the Guide for applicants and incorporate in the Guidelines the provisions reflecting the practice of the EPO as International Authority.	*3. In the particular context of the PCT, the hierarchy of norms is the following:* *(1) Under Article 150 EPC, the EPO acting as receiving Office and International Authority is first bound by the PCT legal framework which consists of the Treaty, its Regulations, and this inclusive of the secondary law which consists of the Administrative Instructions, the Guidelines for receiving Offices and the International Searching and Preliminary Examination (ISPE) Guidelines. PCT practice is by and large reflected in the Applicant's Guide published by WIPO.* *(2) According to Article 150 EPC, the EPC supplements the PCT legal framework when necessary. By "supplements" it is understood that it may not be contradictory as otherwise the PCT legal framework prevails. This is clearly stated in paragraph (2) of the Article.* *(3) Thus, the EPC but also its Regulations, inclusive of its secondary law such as Decisions, Notices and Guidelines are relevant sources of information supplementing the PCT legal framework. Any documents published by the EPO, even text on its PCT website, contain useful official information which could be referred to according the needs.* *4. The PCT-EPO Guidelines are a new document which will take some years to be built at a similar level of details than the EPO GLs. The content of the new PCT-EPO Guidelines is not as comprehensive as the EPO Guidelines, but will be expanded with each revision (see Notice dated 21 July 2015 (OJ EPO 2015, A73)). This process will take time.*

	Supplementary comment: We are happy with the progress of removing references to the Guide for Applicant. This shows that all references to this guide could be omitted. However, many references to EURO-PCT Guide have been retained. Why?	Therefore, for the time being, cross references to the Euro-PCT Guide should be maintained, where necessary (this was also the position of the Office last year). The same conclusion should be reached for the suggestion to replace the text of the Euro-PCT Guide with references to the PCT-EPO Guidelines. Moreover, the Euro-PCT Guide is a document prepared for the users which consolidates information from different sources; reference to these sources is made in the margin and does not replace the text itself. The Office announced that, in the next edition of the PCT-EPO Guidelines, it intends to expand Part A by the inclusion of two new chapters dedicated respectively to “drawings” and “languages”.

Part	Chapter	Section	Comments/ suggestion	Consultation results
GP		2.5	PCT-AG I: Please clarify if the reference refers to the Applicant’s Guide issued by EPO. Not consistent with list of abbreviations	The Office explained the difference between the PCT Applicant’s Guide (issued by the International Bureau of WIPO) and the Euro-PCT Guide (issued by the EPO) and clarified the following: The list of abbreviations (GP/2.5) says: PCT AG I PCT Applicant's Guide – Introduction to the International Phase Therefore the reference refers to the PCT

				Applicant's Guide issued by the International Bureau of WIPO and not to the Euro-PCT Guide.

Part	Chapter	Section	Comments/ suggestion	EPO position
A	II	-	Chapter A-II has been renumbered to Chapter A-III Fees. Chapter A-II only has a title "Filing of applications and examination on filing" and is empty. Note in the content "chapter II" has not been amended.	The Office clarified that the content in the HTML- and PDF versions is correct. The title in Chapter II is meant to be a placeholder. It may be suppressed if it is misleading.
A	III	1 and 2	Will hyperlinks be provided?	The Office clarified that hyperlinks should remain general (like in A-III,1 – referring to www.epo.org) since links to specific sections may change during website-rearrangements. The Office indicated that a hyperlink to www.epo.org will be added in A-III, 2.
A	III	4.1	A-III 4.1 in relation to the transmittal fee: Add a reference to Rule 157(4) EPC which specifies the payment of the transmittal fee.	Agreed.
A	III	4.1	False statement about fee reductions - not in force yet. See OJ EPO 2018 A28. "once the technical means for DOCX filing are available and the decision of the President of the EPO under amended Article 2(3) RFees has entered into	Not agreed. The statement was correct, however, the new fee scheme is not applied yet – as outlined in OJ EPO 2018, A28.

			force."	
A	III	4.2, 4.3	After "receipt" add "of the" International application"	Not agreed. This is a linguistic issue. Furthermore, there is an unambiguous reference to "international application" in preceding sentence
A	III	4.2	Why does EPO not use PCT/RO/102?	The Office explained that acknowledgement of the receipt of (over-/under-) payments is not part of the EPO's practice, neither under the EPC nor under the PCT. This is in line with the ROGL, paragraph 258, where it is stated that it is within the discretion of the RO to send Form PCT/RO/102. Rather, whether a payment has been fully made or if there is an over-/underpayment is implicit in the subsequent actions that the EPO undertakes. It is not intended to change related workflows at the present stage, given the heavy automation impact of any such change. Furthermore, the majority of applicants pay online, using the Online Fee Payment service. Part of this service is the confirmation that a payment was successfully transmitted.
A	III	8.2	2nd paragraph. Hyperlink requested to "*Applying for a patent → Forms and fees → International (PCT) fees → Decisions and notices relating to PCT fees → Reduction in international search and preliminary examination fees"*	Agreed to add a link to www.epo.org.
A	IV	2	**A-IV 2**: Withdrawals: here it could be added that withdrawals are free of charge with reference to	Agreed. The information should be consistent.

			PCT AG-IP 11.048, 11.050, 11.056 and 11.060.	
A	IV	2.3	Reference to GL/PCT-EPO A-III, 2.2 appears to be superfluous. Reference to GL/PCT-EPO A-III, 2.6 should be corrected to GL/PCT-EPO A-**IV**, 2.6	Agreed to delete the reference to A-III, 2.2. The reference is correct in the HTML- and PDF versions.
A	V	1.1	The reference to “informal comments” is unclear – I think it should require that the work is handled with the same attention as a typical office action response so that there is no difference in standard – I see that this originally came from B III 1.2.1, but wanted to include that comment.	The Office gave the following explanation: The origin of the wording ‘informal comments’ is in EPO OJ 2017, A21 and the Notices introducing the PCT Direct service that preceded it. This wording was selected because the PCT Direct is an additional service offered by the EPO but not foreseen as a standard part of the procedure in the PCT Regulations. However, this does not prejudice the level of care with which the informal submissions by the applicant are handled. According to paragraph 4.2 of EPO OJ 2017, A21, at the EPO as ISA, the examiner performing the international search will take informal comments filed under PCT Direct into account when preparing the international search report and written opinion. The written opinion will reflect this by acknowledging the PCT Direct letter and addressing its content insofar as it is relevant to the international search procedure.

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B	III	2.3.3	In discussing incorporating missing parts or a missing element, it refers to an assessment of the RO. The relevant procedure when EPO is RO should be addressed in Part A. *When will the EPO address this?*	The Office stated that it strives to provide clear and complete PCT-EPO Guidelines, and considerable efforts are therefore made towards this direction, with the aim to gradually expand and improve the Guidelines. For the time being, attention is drawn to A-I.3 which explains that information on the formal requirements for PCT international applications is not restricted to this Part A, but can be also found in other chapters of the PCT-EPO Guidelines. In addition, several passages of the PCT-EPO Guidelines also refer to the Euro-PCT Guide which provides the users with another source of helpful guidance.

B	XI	2.2	*(PCT) B-XI, 2.2 Applications filed in Dutch* *The EPO acting as ISA accepts international applications drawn up in Dutch if the application was filed with the ~~Belgian or~~ Netherlands patent office as RO.* *Therefore, for such files, a translation is not required for the purpose of the international search by the EPO as ISA. However, within 14 months of the priority date, a translation must be filed with the RO in a language of publication accepted by the RO for the purpose of international publication. The ISR and WO-ISA will be established in the language of the international publication.* The ISR and WO-ISA have to be established within three months from the receipt of the search copy by the ISA, or nine months from the priority date, whichever time limit expires later. Thus, the ISA/EP may not have the time to wait 14 months to determine the language of publication and hence <u>the language in which the ISR and WO-ISA have to be established</u>, particularly for an international application without priority claim. The applicant has the choice of providing a translation in English, French or German (PCT Applicant's Guide – International Phase – Annex C - NL - footnote 1) – PCT Rule 12.4a) It should be clarified that the ISR and WO-ISA will be established in English if the language of publication is not yet known.	The Office explained that the EPO acting as ISA receives very few files in Dutch per year, and most of them are second filings. Therefore, the fact that the language of publication is only known at the latest at 14 months from the priority date is not problematic from the perspective of the timing for establishing the WO-ISA and for publishing the A1. In the unlikely event that an application filed in Dutch was a first filing, the WO-ISA would be established in the language of the request form.

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C	General		In this Part, the references to the *Euro-PCT Guide* have been maintained. What is the reason for this?	See the Office's reply to the "General Comment", above.
C	VII	1	*From last year. The amendment introduced by the Office is not as clear as it should be.* 1st paragraph. Why does the applicant have respond to the invitation to pay additional fees in order for the examiner to respond to a telephone call. What happens if the applicant wishes to discuss the searched invention? EPO agreed to clarify, but the sentence added is no clarification. You should be able to discuss the searched invention even if no additional search fees have been paid.	The Office agreed to reword the paragraph for clarification. The following was furthermore explained: The intended meaning of this paragraph is not that a request for a telephone conversation cannot be granted without additional examination fee having been paid. Such a request should be granted only after a written response has been filed by the applicant, either a response to the WO-ISA, or, if lack of unity has been raised in the international search report, a response to the invitation to restrict the claims or pay additional fees (Form PCT/IPEA/405). A response to the latter invitation of Form 405 does not require the applicant to pay the additional fees. The underlying motivation is that the subject-matter to be discussed during the phone conversation (i.e., the claims that should in fine be the subject of the international preliminary examination) should be clarified upfront, before such a request could be granted.

Part	Chapter	Section	Comments/ suggestion	Consultation results
E			NO COMMENTS	----

Part	Chapter	Section	Comments/ suggestion	Consultation results
F	II	2.2	Third paragraph See also ISPE Guidelines 16.36. please check - This reference relates to the title not to the abstract–maybe rather 16.39?	The Office explained that the revision cycles of the PCT-EPO Guidelines and of the ISPE Guidelines do not coincide. The PCT-EPO Guidelines were revised before the publication of the current version of the ISPE Guidelines (in force since 1 July 2018). Paragraph 16.36 is indeed no longer the correct reference due to the changes which were made to the ISPE Guidelines. This also applies to other references to the ISPE Guidelines. The Office will replace “16.36” by “16.41”. The Office will strive to update, whenever relevant and possible, changed references to the ISPE Guidelines during the summer, after the Guidelines have been edited and translated.
F	II	2.3	See ISPE Guidelines 16.37. please check -This reference relates to the title not to the abstract – maybe 16.40?	Agreed - see above. The Office will replace “16.37” by “16.42-16.43”.
F	II	2.7	See ISPE Guidelines 16.40-16.43. please check–maybe 16.45-16.47?	Agreed.
F	II	3	Third paragraph see ISPE Guidelines 16.44-16.47. please check–this refers to abstract maybe 16.35 and further?	Agreed. The Office will replace 16.44-16.47 by 16.35-16.38.
F	II	5.2	**F-II 5.2** Here the reference to the PCT Applicant's Guide in the margin has been changed from 'PCT AG **I** 5.159' to 'PCT AG 5.159'. Without the IP=International Phase it is not clear whether the reference is to the IP or NP=National Phase of the PCT Applicant's Guide.	The Office explained that the “I” is a (roman) number, not a letter. The Office clarified that actually “PCT AG IP 5.159” has been replaced by “PCT AG **I** 5.159” (i.e. the letter P has been deleted) and the used abbreviation (PCT AG I) has been added in the list

			Abbreviations should be on the list in the general part – should be consistent with the normally used for PCT	of abbreviations contained in General, 2.5.
F	III	5.2	F-IV, 4.5. please check maybe , this reference relates to the essential features – should they be well-known?	The Office agreed to add an "et seq.". It was furthermore explained that the claims must define clearly all the essential features of the invention (GL/PCT-EPO F-IV, 4.5.1 referring to GL/EPO F-IV, 4.5.1). An independent claim should clearly specify all of the essential features needed to define the invention except insofar as such features are implied by the generic terms used (GL/PCT-EPO F-IV, 4.5.4 referring to GL/ISPE 5.33). The reference GL/PCT-EPO F-IV, 4.5 is considered correct.
F	III	6.3	See Euro-PCT Guide, points 150-156. please check maybe points 152-158?	Agreed.
F	IV	3.4	3rd paragraph Reference to "GL/PCT-EPO B-VIII, 3.33.6" should be "GL/PCT-EPO B-VIII, 3.3-3.6"	Agreed.
F	IV	3.8.2	**3.8.2 Cases where method steps ~~involve~~ require specific data processing means and/or require additional technical devices as essential features [this wording is used by GL/EPO]** *** "Sections F-IV, 3.9.2 **and F-IV, 3.9.2** , in the Guidelines for Examination in the EPO applies mutatis mutandis."	Agreed. *** Agreed. The Office intends to insert a subsection F-IV, 3.8.3 in the PCT-EPO Guidelines referring to

			Further in GL/EPO there is further subsection F-IV 3.9.3 Cases where the invention is realised in a distributed computing environment – maybe this guidelines also should refer to this point?	GL/EPO F-IV, 3.9.3.
F	IV	4.7	Suggested amendments: **4.7 Terms like "about" ~~and~~, "approximately" <u>or</u> <u>"substantially"</u> [according to GL/EPO]** *** Section F-IV, 4.7, and subsections in the Guidelines for Examination in the EPO applies mutatis mutandis.	Agreed. *** Not agreed. The Office explained that, where a section does not contain any information directly under its heading but the information is contained in its subsections, a reference to the section without further indications implies a reference to all subsections of that section. Thus, the proposed insertion seems superfluous.
F	IV	4.13	Suggested amendment: **4.13 <u>Interpretation of expressions like</u> "Apparatus for ...", "Method for ..."** **[according to GL/EPO]**	Agreed.
F	IV	Annex	"Chapter IV" should be "**F**-IV"	Agreed.
F	V	8.1	Section F-V, 8.1-please check maybe F-V,4.3 in the Guidelines for Examination in the EPO applies mutatis mutandis.	This has already been fixed in the published version of the PCT-EPO Guidelines 2018.

F	V	8.2	Section F-V, 8.2-please check maybe F-V, 4.4, in the Guidelines for Examination in the EPO applies mutatis mutandis.	This has already been fixed in the published version of the PCT-EPO Guidelines 2018.
F	VI	3.3	See Euro-PCT Guide, point 141 Euro-PCT Guide, point 144. please check maybe 143-146	Agreed.

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G	II	3.5	**3.5 Schemes, rules and methods of doing business, performing purely mental acts or playing games** GL/EPO indicates only mental acts-not purely mental acts. Why this difference?	Agreed to remove the term “purely”.
G	IV	6.2.2	**This point in GL/EPO G-IV 7.2.2 was slightly elaborated, maybe it would be worth to include or refer to this part in GL/EPO?**	Agreed.
G	IV	6.4	**2nd paragraph** As regards establishing the publication date and the standard and burden of proof, in particular with technical journals or "print equivalent" publications, the principles as laid down in the Guidelines for Examination in the EPO (G-IV, 7.5.1 and subsections [please check G-IV, 7.5.1 does not	Agreed to correct the reference.

			have subsections… there are G-VI, 7.5.1-7.5.6]) apply *mutatis mutandis*.	
G	IV	8 (i)	I would suggest that the second “immediately” is unnecessary and leaves a lacuna.	The Office explained that the wording of this section was aligned with the wording used in GL/EPO G-IV, 9. Thus, the second “immediately” will be deleted in the PCT-EPO Guidelines if it is deleted in the EP Guidelines.
G	VI	7.1	**7.1 Second or further medical use of known pharmaceutical products** **[there is a slight difference in GL/EPO…. First and further medical use…]**	The Office clarified that the text of the PCT-EPO Guidelines is not identical with the one of the EPC Guidelines: it contains an introduction which is specific to international applications plus a cross-reference to the relevant section of the EPC Guidelines.
G	VII	5	**“Probleme-solution” without “and” there between -**	The Office agreed that the same term should be used in both the PCT-EPO Guidelines and the EPC Guidelines
G	VII	5.4.1	**5.4.1 Formulation of the objective technical problem for claims comprising technical and non-technical features** **[according to GL/EPO G-VII, 5.4.1]**	Agreed.

Part	Chapter	Section	Comments/ suggestion	Consultation results
H	I	3	In the reference to 3rd paragraph "Rule" is missing before "69". It should be: *Rule 54bis, **Rule** 69.1(a)* *PCT AG I 10.010*	Agreed.
H	I	6	In the reference to 1st paragraph Comma is missing: *Rule 46.5, Rule 66.8(a), Rule 70.2(c-bis)*	Not agreed. The Office explained that, when the references are indicated in the margin one under the other, there are no commas between the references.
H	II	2.2.2	1st paragraph "were" in last line should be "was (were)" Same correction in paragraphs 3 and 4 and elsewhere "parts" is changed to "part(s)" or "elements" to element(s)"	Agreed.
H	II	2.2.2.2	2nd paragraph "IPER" should be "IPRP". Should be corrected elsewhere	The Office clarified that the term "IPER" is correct. The end product of the PCT procedure is the IPRP Chapter I or Chapter II. The term "IPRP Chapter II" is no more than a different name for the IPER. Using the term "IPRP" without further indications instead of "IPER" would not be correct. See also consultation results regarding the comments to the EPC Guidelines, H-II, 2.2.
H	II	2.2.5	Reference to H-IV, 2.2.7. should be H-IV, 2.2.**6**.	This has already been fixed in the published version of the PCT-EPO Guidelines 2018.
H	II	2.2.6	Reference to H-IV, 2.2.8. should be H-IV, 2.2.**7**.	This has already been fixed in the published version of the PCT-EPO Guidelines 2018.
H	II	2.2.7	Reference to H-IV, 2.2.9. should be H-IV, 2.2.**8**.	This has already been fixed in the published

				version of the PCT-EPO Guidelines 2018.
H	III	3.4	Suggest to change headline to: “Further cases of broadening of claims” [in line with GL/EPO H-V, 3.4]	Agreed.
H	III	3.5	Cross reference to Applicant’s Guide point 361 is superfluous. The reference to ISPE and GL/EPC should be sufficient.	The Office understood this comment as referring to the Euro-PCT Guide, point 364 because the section does not contain any reference to the PCT Applicant's Guide. The Office indicated that it considers this reference to be relevant but that it will double check this matter.