

## Entry from PCT into European Regional Phase

If you have filed an International (PCT) patent application and you wish to obtain grant of a European patent, by the deadline of 31 months from the earliest filing date (typically from the earliest priority date) you will need to start this process by taking appropriate steps at the European Patent Office (EPO) to enter the European Regional Phase (file a Euro-PCT application). This briefing note provides an introduction to that process.

### General information and requirements

Filing a European patent application at the EPO in the form of a Euro-PCT application is a popular option, as one application can be filed which designates all member states of the European Patent Convention (EPC). All EU Member States are currently members of the EPC together with some additional countries such as Switzerland, Norway and Turkey. All EPC states can be designated by the payment of a single fee of €585. A full list of states can be found here. If of interest, the non-contracting states of Bosnia and Herzegovina and Montenegro can also be designated for a fee of approximately €102 per state and Morocco and Moldova for €240 and €200 respectively.

As mentioned above, the deadline for European Regional Phase Entry (Euro-PCT filing) is 31 months from the earliest filing date/priority date (in contrast to many other jurisdictions, where a 30 month deadline applies). Although in order to file a Euro-PCT application you do not need to instruct a firm of European Patent Attorneys, such as ourselves, to take the necessary procedural steps for

you, this is recommended, as the expertise of a European Patent Attorney in the initial procedural steps and the downstream process of presenting arguments to the EPO in order to obtain a granted patent is usually invaluable. Applicants without a residence or principal place of business in an EPC Contracting State must in any event appoint a professional representative once the filing has been carried out.

The text of your application must be in one of the official EPO languages, i.e. English, French or German. Thus, a translation will need to be prepared if the text is in a different language to this. The translation can be late filed if necessary, although an additional fee will be incurred.

### Costs

The basic cost of a Euro-PCT filing is €4,000 to €5,500 (this includes the Official Fees and our fees for processing and filing the application). However, it is important also to note that the EPO now levies a fee on filing of €15 per page for each page of the patent application over 35 (previously this fee was payable on grant) and also that excess claims fees of €235 per claim are charged for each

claim in excess of 15 claims (€585 for each claim in excess of 50).

These additional fees, but in particular the excess claims fees, can significantly increase the cost of a Euro-PCT filing. It is thus advisable to try and reduce the number of claims filed at the EPO. There are a number of ways by which the claim number can be reduced within the boundaries of EPO practice and we often advise applicants on claim amendments in order to try to minimise the excess claims fees payable. As the excess claims fees are so expensive, the professional charges we make for the time involved in reducing the claim number are more than outweighed by the saving that is made in the Official Fees payable.

## Claims

With regard to the claims, as well as the high excess claims fees payable, there are a number of formal and procedural rules which it is worth taking into account when filing a Euro-PCT (or shortly thereafter). For example, once the Euro-PCT has been filed, the EPO will carry out a search of the claims, assuming that they have not already carried out such a search during the International PCT phase. The EPO are generally very strict in allowing only one invention (or a group of related inventions) to be protected in the claims of a European patent application. An important point to note is that the EPO will initially only search the invention first mentioned in the claims. For this reason, it is recommended that the most important subject-matter is first in the claim set when the EPO carry out the search.

Given the number of issues to be considered with the claims, we generally recommend that on Euro-PCT filing (or shortly thereafter) we carry out a review of the claims for their compliance with European practice and advise clients accordingly. In addition, a number of EPO rule changes which came into force in April 2010 mean that an early review of the claims is even more important.

With the number of issues to consider, it is often not possible to fully assess all of these before the Euro-PCT is filed. Fortunately, however, shortly after filing, the Applicant is given a further six month period to amend the claims before the claims are searched or examined. This stage in the proceedings thus allows us additional valuable time to discuss appropriate claim amendments with the Applicant. Importantly, as there is no need to pay the fees for excess claims by the 31 month deadline, the appropriate claims fees can be paid on the reduced claim set which is filed within this six month period.

## What to do if the deadline is missed

If the 31 month deadline for filing a Euro-PCT application is missed then there are options for filing the application late, particularly if the deadline is only missed by two or three months (but sometimes longer). You should contact us for specific advice in this regard if this situation is relevant.



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