

PCT DIRECT a great tool in patent prosecution strategy

By Montserrat Jané & Bernabé Zea

Why was it necessary to set up a system like PCT Direct?

Many applicants file an international application (PCT) in the priority year to, among other reasons, delay the costs associated with extending protection. This prosecution strategy allows for changes to the PCT application to incorporate new subject matter, to better support the scope of protection of the priority application by including, for example, more experimental support, clarify terms of the claims, or add features to the claims that were in the description in the priority application. It also allows for the reorientation of protection based on the latest research results.

There are also several advantages to submitting a European patent application as a priority document. The most important one is to have the search report and written opinion (EESR) approximately 6 months after the first application. This report helps to adjust the PCT patent application to avoid, as far as possible, having the same objections to patentability as the priority application.

However, it was common for the international search report and written opinion (ISR/WO) issued by the European Patent Office (EPO) for a PCT application to repeat the objections contained in the EESR of the priority application, despite the addition of more experimental data in the PCT application or even the amendment of the claims with respect to the ones of the priority application. Sometimes the initial claims were valid, and the objections were simply due to a misinterpretation of the prior art documents or of the invention itself.

This practice, which was often incorrect on the part of examiners, not only frustrated applicants, but also forced them to defend the patent application at the international phase by assuming the costs of an international preliminary examination report (IPER), a typical situation when technology transfer was intended; or to postpone this defense until the national/regional phases, which meant lengthening the granting procedure.

What is the PCT Direct service and what are its requirements?

The PCT Direct service allows applicants to provide comments in favor of the patentability of the claims of the PCT application, whether they have remained unchanged or have been amended from the claims of the priority application. These comments are generally a reply to the objections in the EESR of the priority application.

The use of the PCT Direct service is voluntary. However, in order to access it, two requirements must be met. On the one hand, the PCT application must designate the EPO as the International Searching Authority for the PCT (ISA) and, on the other hand, the PCT application must claim the priority of an earlier European or PCT application that has been searched by the EPO.

Although the comments in the PCT Direct are informal, the examiner must take them into account when examining the PCT application for the preparation of the international search report and the corresponding written opinion.

Unlike the previous situation, now with the PCT direct if the examiner has not considered the arguments and/or modifications in the ISR/WO, with a simple request to the EPO, the examiner is obliged to issue a new opinion taking into account the PCT direct letter.

Further on, it is mentioned that other offices have also implemented this tool.

What did it mean for the users?

The launch of the PCT Direct service ensured that the PCT application itself became yet another opportunity to move towards obtaining a positive opinion on the patentability of the claims at an early stage of the patenting procedure, avoiding leaving it to the discretion of EPO examiners to carry out an in-depth study of the information in the PCT application in order to issue their written opinion.

Although this service does not have associated fees, it adds small costs at the time of filing the patent application, due to the technical work of preparing the brief of arguments. In any case, these costs are much lower than, for example, the request for the international preliminary examination. Nevertheless, it should not be forgotten that a positive opinion in the international phase does not always ensure a fast prosecution in the national/regional phases as the examiners may raise new objections.

The fact that the examiners consider the arguments for issuing the ISR/WO of a PCT application is particularly useful in cases where the objections in the written opinion of the priority application were simply due to a misinterpretation of the prior art documents or of the invention itself, given that the PCT procedure does not provide for the applicant to contact the examiner before the ISR/WO is issued. The PCT Direct is therefore the way to explain to the examiner any mistakes made in the analysis of the priority document.

What precautions should be taken?

The EPO indicates that in order for the examiner to make explicit reference in the ISR/WO to any aspect of the search and written opinion of the priority application, the applicant must attach that search and written opinion to the PCT Direct letter since the PCT Direct letter must be self-explanatory. This means that the arguments, together with any tracked changes copy of the claims and/or description, as well as the search and written opinion of the priority document, if attached, have to be submitted as one document.

However, since the PCT Direct letter is published in WIPO's PATENTSCOPE database, it is not considered advisable to attach the previous search and written opinion, especially in cases where it might alert third parties to possible weaknesses in the patent. The owner of the patent application can always prevent the EESR from being made available to the public by withdrawing the priority application before publication.

Does it replace other actions in the international phase?

Regardless of whether the PCT Direct service is used, the applicant continues to retain the right to amend the claims again in response to the ISR/WO under Article 19 of the PCT, to request an international preliminary examination under Article 34 of the PCT, or to submit informal comments to be sent to the designated national/regional offices. The latter differ from the PCT Direct in that they are submitted after the search report and are not sent to the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA) but are simply stored in the international application file to be sent to the designated national/regional offices.

In short, the PCT Direct does not replace any of the existing actions in the international phase but is an additional tool that helps the owner to obtain a favorable opinion from the examiner on the patentability of the invention. If the PCT Direct is not successful, the owner can use the other available tools at his convenience.

Are there other offices that are implementing it?

The EPO has been offering the PCT Direct service since 1 November 2014. Previously, specifically from 1 April 2014, the Israel Patent Office (ILPO) had already started this service for cases where ILPO was the ISA.

Recently other national offices in European countries have started to offer this service when acting as PCT search administration, and whenever the PCT application claims priority of an earlier application already searched and examined by the same office, whether this earlier application is a national application or a PCT.

According to the information available in the PCT Applicant's Guide, the Finnish Patent and Registration Office (PRH) currently allows the use of PCT Direct from 1 November 2019 for international applications in which it acts as an International Searching Authority for the PCT, provided priority is claimed for an earlier application for which the PRH has carried out a search and written opinion. More recently, the Spanish Patent and Trademark Office (SPTO) has been offering this service, specifically from 25 May 2020, for those international applications which designate the SPTO as an International Searching Authority for the PCT and claim the priority of an earlier national or international application whose search and written opinion has been carried out by the SPTO.

The problems indicated above are not exclusive to the EPO, so the implementation of the PCT Direct service represents a step forward in improving the quality of services provided by other patent offices. The offer of the PCT Direct service by these offices may influence applicants to select them not only as receiving offices but also as search authorities, since using the same office as ISA as the one used in the first application not only represents a saving in search fees, which can be returned by the office partially or totally, but now also allows access to the PCT Direct service with the advantages that this entails.

In short, the availability of the PCT Direct in the prosecution of the international application makes certain patent offices more attractive than others when filing the priority application. Thus, for example, at present there is a great difference between filing a provisional application in the USA, without a search or subsequent option of PCT Direct in the filing of the

international application, as opposed to a priority application in the EPO, which offers a first EESR after approximately 6 months, and, in the event that this opinion is negative, offers the option of using PCT Direct in the subsequent PCT application before the EPO.

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