



PCT Direct - How to improve your IPRP without filing a Demand

Written by Nadine Eckert-Boulet, HØIBERG

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This is very exciting: you filed a priority founding patent application at the European Patent Office (EPO). You are looking forward to receiving a Search Report and a Written Opinion from EPO in the priority year. Finally, the Opinion arrives. But it is quite a disappointment: the Examiner has multiple objections! When studying the communication, you realise that the objections can be easily overcome by amending the application.

You have two options at this stage:

- 1) The hopeful route: Update the application when entering the international phase by amending the application and the claims – and hope that the International Search Authority will understand the invention correctly. If not, a Request for Preliminary Examination will have to be filed – at a high fee to the authority.
- 2) The PCT Direct route: Update the application when entering the international phase by amending the application and the claims – and take advantage of the PCT Direct procedure and file a letter with the application explaining the amendments to the International Search Authority – with no fee to the authority.

Previously, only the hopeful route was available. The risk when pursuing option 1) is that the Examiner may not notice the changes you have made to the application: often the Written Opinion issued by the International Search Authority (ISA) repeats the objections of the Opinion from the priority year – despite amendments having been made. If you are in need of a positive International Preliminary Report on Patentability (IPRP), you will have to file a Request for Preliminary Examination (also known as a Demand) within 22 months from the priority date – subject to a (substantial) official fee.

Option 2) has been available since 1 November 2014. The PCT Direct procedure is available when filing a PCT application that has been searched by the EPO during the priority year and the EPO is selected as ISA. PCT Direct is requested by filing a letter containing informal comments addressing the objections raised in the search opinion drawn up for the priority application. In other words, you can argue for patentability of your claims simultaneously with the filing of the international application. The letter may also contain explanations as to the modifications performed in the international application.

PCT Direct may help you convince the ISA already at an early stage that your invention is patentable. It is important to note that there is no fee associated with

the PCT-direct procedure – it will cost only your attorney’s time, which is essentially the same as for preparing a Demand – but without the substantial fee to the authority.

PCT-direct gives an opportunity to present arguments in much the same way as in a Demand, but at a lesser cost – and the result can be a positive Written Opinion accompanying the International Search Report.

Of course, success is not guaranteed; it will depend very much on the amendments and/or arguments filed. If the Written Opinion issued with the international Search is negative, you still have the option of filing a Demand.

If you wish to use the PCT Direct system or have questions hereto please feel free to contact your patent attorney at HØIBERG.



Nadine Eckert-Boulet

Patent Attorney

Contact information:

T: +45 3332 0337

neb@hoiberg.com

[Read more about Nadine here.](#)

When can you request PCT Direct?

Two criteria need to be met:

- the international application has to claim priority of an earlier application searched by the EPO.
- the informal comments (the letter) are to be filed together with the international application.

How to request processing under PCT Direct?

- Prepare a marked-up copy of the updated application, highlighting the amendments made to the priority application.
- Draft a letter (“PCT Direct letter”) with informal comments
- File the PCT Direct letter and any marked-up copy of the claims and/or description.
- File the other documents (clean copy of the application and drawings) as usual.