

To Demand or not to Demand

(Interacting in the examination of your PCT Application)

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Filing a Demand is a way of addressing objections raised in an International Search Report and Written Opinion (ISRWO), in an effort to obtain a more positive International Preliminary Report on Patentability (IPRP). Being entirely optional means you need to make an active decision for or against – but when does the advantage of filing a Demand exceed the costs immediately associated?

Filing an International (PCT) patent application has several advantages including delay in national/regional filing time and the potential to streamline the prosecution of a patent application in PCT member countries of interest.

By default, all PCT applications are subject to search and examination, and an International Preliminary Report on Patentability (IPRP) is issued for all PCT applications.

The IPRP is a preliminary and non-binding opinion of the patentability of your invention, setting out in detail the reasons and the basis for its negative or positive finding.

A positive finding of patentability in the IPRP is desirable for several reasons:

- A positive IPRP eases prosecution in regions/countries that base their examination on the IPRP, especially the EPO; leading to faster grant of a patent and fewer costs associated.
- A positive IPRP enables you to enter the Patent Prosecution Highway (PPH) for participating countries, including the USA and Japan; again leading to faster grant of a patent and fewer costs associated.
- A positive IPRP eases commercialization by providing an official opinion of a patent authority which is a convincing argument for potential collaborators of the patentable nature of your invention.

Examination of PCT applications may proceed **without** interaction between the applicant and the International Search Authority (ISA), or **with** the interaction between the applicant and the International Preliminary Examining Authority (IPEA), that is, if a Demand is filed.

When to file a Demand

DO – file a Demand together with arguments and amendments addressing objections raised in the ISRWO if you want to try to obtain a more positive IPRP.

DO NOT – file a Demand if you are content with the ISRWO being reissued as an IPRP, and are happy to address any objections raised during the regional/national stage.

The usefulness of this optional procedure depends on the international application concerned and, especially, on the result of the international search (International search report and written opinion; ISRWO): Filing a Demand is, in general, useful only if the ISRWO was negative and the applicant is of the opinion that amendments and/or arguments filed may lead to a positive IPRP.

If you wish to file a Demand, it must be done by 22 months from the first priority date (or filing date, if no priority is claimed), or 3 months from the date of the ISRWO, whichever expires later. Arguments and/or amendments are usually filed together with the Demand (but no later than the same deadline).

If no Demand is filed, the ISRWO is reissued without any changes as the IPRP. Therefore, if the ISRWO is positive, i.e. at least the most relevant claims are found to be novel and inventive, there is no need to file a Demand.

If a Demand is filed, the IPEA reconsiders the ISRWO in view of the amendments made and arguments as presented, before proceeding to prepare the IPRP.

Filing a Demand thus permits central prosecution of the PCT application before a single patent office, and can be used to reduce the number of objections that will need to be addressed later during the regional/national stage. Central prosecution may well prove to be cost efficient by avoiding multiple responses to regional/national offices subsequently. Generally speaking, if the IPEA is correctly applying the prior art then you may as well address this by claim amendment centrally. If you do not agree with the IPEA, then you may address this by argumentation centrally, and avoid making too limiting claim amendments in response to suspect inventive step objections (this ensures that prosecution in countries with a different view toward e.g. non-obviousness will proceed on the broadest claims possible in that country).

Costs associated with filing a Demand

The total cost of preparing and filing a Demand depends on the nature and complexity of the objections raised in the ISRWO and the patent office that you wish to act as IPEA (the PCT authority). The official fees alone are above 2000 €, however a reduction of fees in the subsequent EP regional phase will apply.

If the ISRWO contains negative findings then filing a Demand and presenting your arguments and amendments to the IPEA may well prove to be cost efficient by avoiding multiple responses to regional/national offices subsequently.

The EPO in their capacity as IPEA has in recent years intensified their focus on the Demand process, by requiring Examiners intending to issue a negative IPRP after the applicant has filed a Demand, to provide either a telephone interview or a second written opinion. This gives the applicant a further opportunity to provide his response and thus of obtaining a positive IPRP. As the EPO essentially resumes examination where international examination stopped,

having the EPO regional phase as a main consideration advocates for filing a Demand with the EPO.

In conclusion deciding whether or not to file a Demand is ultimately a decision unique to your specific application and needs, and it depends on factors such as the commercial stage of the product, the interest of licensees, the scope of your planned national/regional filings, your budget and the scope of the prior art cited. We therefore recommend that you discuss with your patent attorney whether or not to file a Demand in order that we may proceed towards a targeted strategy for your application.

Patent Prosecution Highway (PPH) and IPRP

The PPH enables an applicant whose claims have been determined to be patentable to have a corresponding application that has been filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results.

Under the PCT-PPH pilot program, a PPH request filed with the JPO and the USPTO can also be based on an IPRP established by the EPO as IPEA.

If you wish to know more about possibilities for entering into PPHs please contact one of our patent attorneys to learn more about Global-PPH, IP5 PPH or the PCT-PPH.



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