

# PCT Direct

## How to improve your IPRP without filing a Demand

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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; maybe the Examiner misunderstood the invention and needs some further explanation, or maybe you have since obtained new data.

### 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 or realise that the application has been amended. 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. This gives you the possibility to file a letter with the application presenting arguments or explaining 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 (when you choose the EPO as International Search Authority (ISA), almost always the Examiner who issued the EESR) may not notice the changes you have made to the application: often the Written Opinion (ISRWO) issued by the International Search Authority (ISA) simply 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), your only option is then 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, or else address the objections in national phase.

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.

The PCT Direct route has now been available for almost a decade – and we like it! In our experience, the ISRWO is almost always more positive than the EESR drawn on the priority application. And this can mean a lot when you are looking for industrial partners! 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.

## Need to know more?

If you wish to know more about the PCT Direct system, feel free to contact our expert Nadine Bravo.



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