

Earlier Start of International Preliminary Examination

Kluwer Patent Blog
June 26, 2019

Thorsten Bausch (Hoffmann Eitle)

Please refer to this post as: Thorsten Bausch, 'Earlier Start of International Preliminary Examination', Kluwer Patent Blog, June 26, 2019, <http://patentblog.kluweriplaw.com/2019/06/26/earlier-start-of-international-preliminary-examination/>

As of 1 July 2019, Rule 69.1(a) PCT will be amended to provide for the International Preliminary Examining Authority to start the international preliminary examination upon receipt of the demand, instead of waiting until the expiration of the applicable time limit for filing a demand.

This means that applicants will no longer need to expressly request that the international preliminary examination should start before the expiration of the applicable time limit under Rule 54bis.1(a) PCT in Box No. IV, item 4 of the PCT Chapter II Demand Form (version valid until 30 June 2019; version as of 1 July 2019), but rather only in the opposite case, i.e. in cases where to the applicant wishes to postpone the start of international preliminary examination until the expiration of the time limit for filing a demand (3 months from the date of transmittal to the applicant of the ISR or 22 months from the priority date).

In other words, if the demand is filed early, applicants can assume that the EPO acting as IPEA will be able to start with examination of the application immediately upon receipt of the demand. This can be of importance when an applicant is interested in timely receiving a Written Opinion under PCT Chapter II, e.g. in view of parallel pending application(s); or when an applicant would like to have a positive Written Opinion as soon as possible, e.g., in view of licensing negotiations. As such, this amendment will surely be welcomed by applicants.

In the opposite case, i.e. if applicant is planning amendments under Article 34 PCT and wishes that the international preliminary examination be based on these amendments, but they are not yet ready when the expiration of the time limit under Rule 54bis.1(a) PCT is imminent, applicant should ensure that at least the demand is filed within that time limit. Applicant should further indicate in the demand that he/she wishes the international preliminary examination to be conducted on the basis of amendments under PCT Article 34 by checking the corresponding box(es) in Box No. IV, item 11. If you have indicated in the demand that you wish the international preliminary examination to start on the basis of amendments under Article 34 PCT, but no such amendments have, in fact, been submitted, the IPEA will invite you (using Form PCT/IPEA/4311), under Rule 60.1(g) PCT to submit the missing amendments within a time limit fixed in the invitation, and will not start the international preliminary examination before it has received the amendments, or before the expiration of the time limit fixed in the invitation (Rule 69.1(e) PCT). It goes without saying, however, that if this happens, there will be less time available for international preliminary examination.

See WIPO's [Newsletter](#) for more details.

by Boris Tchitchanov and Thorsten Bausch