



# International Search and Preliminary Examination

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# Poll questions





# International Search and Written Opinion of the ISA

# The International Searching Authority (1)

- Checks unity of invention (Rules 13 and 40)
- Checks title (Rule 37); checks abstract (Rule 38)
- Searches claimed invention (Article 15(3), Rule 33.3)
- Authorizes rectification of obvious mistakes if the mistake is:
  - in any part of the international application other than the request, (Rule 91.1(b)(ii)) or
  - in any paper submitted to that Authority (Rule 91.1(b)(iv))

# The International Searching Authority (2)

- Establishes international search report (ISR) (Rules 42 and 43) or declaration that no international search report will be established (Article 17(2))
- Establishes written opinion of the ISA (Rule 43*bis*): non-binding first opinion on novelty, inventive step (non-obviousness) and industrial applicability of claimed invention

# International Search Report (ISR) (Rules 42 and 43)

## ■ Contains:

- IPC (International Patent Classification) symbols
- indications of the technical areas searched
- indications relating to any finding of lack of unity
- a list of the relevant prior art documents
- indications relating to any finding that a meaningful search could not be carried out in respect of certain (but not all) claims

## ■ Time limit to establish ISR and written opinion of the ISA:

- 3 months from the date of receipt of the search copy by the ISA (usually within approximately 16 months from the priority date if priority is claimed); or
- 9 months from the priority date, whichever time limit expires later

# Example: PCT International Search Report

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11
X	GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1	1-3
Y	page 3, lines 5-7	4, 10
A	Fig. 5, support 36	11-12
X	GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1	1-3
Y		4
A	US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1	1
A	GREEN, J.P. Integrated Circuit and Electronic Compass, IBM Technical Disclosure Bulletin, October 1975, Vol. 17, No. 6, pages 1344 and 1345	1-5

**Symbols indicating relevancy of the document cited**

**Documents relevant to whether or not your invention may be patentable**

**The claim numbers in your application to which the document is relevant**

# Cases where no international search report will be established (1)

- The application relates to a subject matter which the ISA is not required to search, and in the particular case decides not to search (Article 17(2)(a)(i) and Rule 39.1)
- Subject matters listed in PCT Rule 39.1
  - (i) scientific and mathematical theories
  - (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
  - (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
  - (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
  - (v) mere presentations of information,
  - (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.



# Cases where no international search report will be established (2)

- The description, claims or drawings do not comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out in respect of any of the claims (Article 17(2)(a)(ii))
- The application contains the disclosure of a nucleotide and/or amino acid sequence, but:
  - no listing of that sequence is furnished,
  - the listing furnished does not comply with the Standard set out in Annex C of the Administrative Instructions or is not in electronic form (Rule 13*ter*.1(d)), or
  - the fee for late furnishing of the sequence listing has not been paid within the applicable time limit (Rule 13*ter*.1(d))

# Cases where no international search report will be established (3)

## ■ Consequences:

- ❑ the ISA will declare that no international search report has been established and that declaration will be published as part of the published international application (Rule 48.2(a)(v))
- ❑ the application remains valid but the IPEA will not be obliged to carry out the international preliminary examination for lack of an international search report (Rule 66.1(e))

# Written opinion of the ISA (Rule 43*bis*) (1)

- Initial preliminary non-binding opinion on:
  - novelty (not anticipated)
  - inventive step (not obvious)
  - industrial applicability
- A written opinion will be established for all international applications at the same time as the ISR
- The written opinion is sent to applicant and the International Bureau together with the ISR

# Written opinion of the ISA (Rule 43bis) (2)

- The written opinion is made publicly available on PATENTSCOPE in its original language as of the date of publication of the international application
- No formal procedure for applicants to respond to written opinion of the ISA
- Possibility to submit informal comments to the International Bureau
  - They are made publicly available together with the written opinion in their original language
  - They are communicated to the DOs together with the IPRP (Chapter I) if and when it is sent
- Note: The IPRP Chapter I and its translation are established at 30 months from the priority date



# International preliminary report on patentability (IPRP) (Chapter I of the PCT) (Rule 44*bis*)

- If applicant does not file a demand for international preliminary examination:
  - IB establishes the IPRP (Chapter I) on the basis of the written opinion of the ISA
  - IPRP (Chapter I) and its translation
    - are sent to designated Offices
    - are made publicly available on PATENTSCOPE (but not “published” like the international application and ISR) at the expiry of 30 months from the priority date

# Use of the written opinion of the ISA for the purposes of the Chapter II procedure (Rule 66.1 *bis*)

- If applicant files a demand for international preliminary examination:
  - written opinion of the ISA becomes written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain ISAs)
  - informal comments by applicant on written opinion of ISA will not be sent to IPEA (Article 34 amendments/arguments only)
  - if an international preliminary examination report is established, any informal comments submitted to the IB will not be sent to DOs or EOs



# International Preliminary Examination



# International preliminary examination (1)

- Results in the establishment by the IPEA of a non-binding opinion on
  - novelty (not anticipated) (Article 33(2) and Rule 64)
  - inventive step (not obvious) (Article 33(3) and Rule 65)
  - industrial applicability (Article 33(4))
- International preliminary examination provides an opportunity to make amendments and to address patentability issues raised by the ISA

# International Preliminary Examination (2)

- Only claims relating to the invention(s) searched by the ISA will be examined by the IPEA (Rules 66.1(e) and 66.2(a)(vi))

# Start of international preliminary examination (Rule 69.1)

- When the IPEA is in possession of:

- the demand
- the international search report (or the declaration under Article 17(2)(a)) and the written opinion of the ISA
- the preliminary examination and handling fees

it does not wait for the expiration of the applicable time limit under Rule 54*bis*.1(a) unless the applicant expressly requests postponement

- If the demand contains a statement about amendments, when copies of these amendments are available (see Rule 69.1(c), (d) and (e))

- If international preliminary examination is to be carried out on the basis of a translation of the international application, when that translation is available (see Rule 55.2(c))

# Written opinion of IPEA (Rules 66.2 and 66.6)

- The written opinion of the ISA is considered to be the written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain other ISAs)
- Where the written opinion of the ISA is taken as the written opinion of the IPEA, no second written opinion has to be issued
- If a second written opinion is issued, the applicant may respond within the time limit fixed in that second written opinion
- Possibility to request an interview with the examiner at the IPEA (Rule 66.6)

# The international preliminary report on patentability (Chapter II)

- Must be established by the IPEA within:

- 28 months from the priority date

- 6 months from the time provided under Rule 69.1 for the start of the international preliminary examination

- 6 months from date of receipt by IPEA of translation under Rule 55.2,

whichever expires last (Rule 69.2)

# The international preliminary report on patentability (Chapter II) (2)

- No provisions for appeal or further proceedings during the international phase before the International Authorities
- Sent to the applicant and the IB (Rule 71.1)
- IB forwards copies of the report, and any required translation of the report into English (prepared by the IB), to the elected Offices (Article 36(3)(a) and Rule 72.1)
- The annexes are not translated by the IB (Article 36(3)(b))

# Amendment to the PCT Regulations as from 1 July 2020

- Amendment of PCT Rules 71 and 94
  - Requires the IPEA to copy certain documents from its file to the IB, which the IB would make available to the public on behalf of the elected Office
  - Apply to any document received at or established by the IPEA on or after 1 July 2020

# Poll answers





# Questions?



# PCT Resources

- General questions about the PCT

- Contact the PCT Information Service:

- Telephone: +41 22 338 83 38

- E-mail: [pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

- Questions about the ePCT

- Contact PCT eServices Help Desk:

- Telephone: +41 22 338 95 23

- E-mail: [pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)

- Subscribe to WIPO Newsletters

- [www.wipo.int/newsletters](http://www.wipo.int/newsletters)

- PCT Applicant's Guide

- [www.wipo.int/pct/en/guide/index.html](http://www.wipo.int/pct/en/guide/index.html)

# Thank you!



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complete the  
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