International Search and Preliminary Examination

WIPO PCT Webinar Series

Session 7

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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 43bis): 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

<table>
<thead>
<tr>
<th>Category*</th>
<th>Citation of document, with indication, where appropriate, of the relevant passages</th>
<th>Relevant to claim No.</th>
</tr>
</thead>
<tbody>
<tr>
<td>X</td>
<td>JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27</td>
<td>7-9, 11</td>
</tr>
<tr>
<td>X</td>
<td>GB 392415 A (JONES) 18 May 1933 (18.05.33)</td>
<td>1-3</td>
</tr>
<tr>
<td>Y</td>
<td>GB 2174500 A (STC) 5 November 1986 (05.11.86)</td>
<td>1-3, 4, 10</td>
</tr>
<tr>
<td>X</td>
<td>Fig. 1, page 3, lines 5-7</td>
<td>4, 10</td>
</tr>
<tr>
<td>Y</td>
<td>Fig. 5, support 36</td>
<td>11-12</td>
</tr>
<tr>
<td>X</td>
<td>GB 2174500 A (STC) 5 November 1986 (05.11.86)</td>
<td>1-3, 4</td>
</tr>
<tr>
<td>Y</td>
<td>US 4322752 A (BIXTY) 30 March 1982 (30.03.82)</td>
<td>4</td>
</tr>
<tr>
<td>A</td>
<td>claim 1</td>
<td>1</td>
</tr>
</tbody>
</table>

**Symbols indicating relevancy of the document cited**

- X: Required
- Y: Useful
- A: Additional

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

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

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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 13ter.1(d)), or
  - the fee for late furnishing of the sequence listing has not been paid within the applicable time limit (Rule 13ter.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 43bis) (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.
**Example: Written Opinion of the ISA**

**WITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY**

<table>
<thead>
<tr>
<th>Box No. V</th>
<th>Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</th>
</tr>
</thead>
<tbody>
<tr>
<td>1. Statement</td>
<td></td>
</tr>
<tr>
<td>Novelty (N)</td>
<td>Claims</td>
</tr>
<tr>
<td></td>
<td>Claims</td>
</tr>
<tr>
<td>Inventive step (IS)</td>
<td>Claims</td>
</tr>
<tr>
<td></td>
<td>Claims</td>
</tr>
<tr>
<td>Industrial applicability (IA)</td>
<td>Claims</td>
</tr>
<tr>
<td></td>
<td>Claims</td>
</tr>
<tr>
<td>2. Citations and explanations:</td>
<td></td>
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<tr>
<td><strong>INDEPENDENT CLAIM 3</strong></td>
<td></td>
</tr>
<tr>
<td>Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of INDEPENDENT CLAIM 3 Document US-A-5 332 238, which is considered to represent the most relevant state of the art,</td>
<td></td>
</tr>
</tbody>
</table>

**Patentability assessment of claims**

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

- 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 66.1bis)

- 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 54bis.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

■ Questions about the ePCT
  ❑ Contact PCT eServices Help Desk:
    Telephone: +41 22 338 95 23
    E-mail: pct.eservices@wipo.int

■ Subscribe to WIPO Newsletters
  www.wipo.int/newsletters

■ PCT Applicant’s Guide
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