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ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C.PCT 1155
– 07.2

November 13, 2008

*Proposed modifications to the
PCT International Search and Preliminary Examination Guidelines*

Madam,
Sir,

1. This Circular is addressed to your Office in its capacity as an International Searching Authority under the Patent Cooperation Treaty (PCT) for the purposes of consultation under PCT Rule 89.2(b).
2. This Circular concerns proposed modifications to the PCT International Search and Preliminary Examination Guidelines, consequential on amendments of the Regulations under the PCT introducing the supplementary international search system, adopted by the PCT Assembly at its thirty-sixth session and to enter into force on January 1, 2009 (see document PCT/A/36/13).
3. It is recalled that related proposals for modifications to the Administrative Instructions (including certain Forms) were made in Circular C. PCT 1153, dated September 19, 2008. The draft modifications to the PCT International Search and Preliminary Examination Guidelines set out in the Annex to this Circular include references to the Administrative Instructions as proposed to be modified in Circular C. PCT 1153.

Modifications to the PCT International Search and Preliminary Examination Guidelines

4. The Annex to this Circular sets out proposed modifications to the PCT International Search and Preliminary Examination Guidelines. The modifications are shown using underline and strikeout compared to the present version of the Guidelines as set out in document PCT/ISPE/1, except for certain modifications outlined in the following paragraph. Certain other modifications to the present version of the Guidelines, which have already been agreed upon earlier, relating to corrections or changes to the PCT Regulations and Administrative Instructions since April 1, 2004, are not shown.

5. The exceptions to the marking referred to in paragraph 4 are as follows:

(i) a diagram has been added at the end of Chapter 2, which is not marked using underline;

(ii) proposed new Chapter 15*bis* is shown with changes shown (by way of underlining and strikethrough) compared to the text in Annex III of document PCT/MIA/15/11, where a first draft of modifications relating to supplementary search was presented as new paragraphs 15.71 to 15.86.

6. Attention is particularly drawn to the deletion of the previously proposed item (iii) of the paragraph numbered 15*bis*.13 in the Annex. Upon further consideration, it appears to the International Bureau that the natural reading of Rules 45*bis*.5(g) and 45*bis*.9(a) is such that the limitations referred to in Rule 45*bis*.9 must be matters of competence for search in general, rather than in the extent of a supplementary international search.

7. For example, it would appear to the International Bureau that an Authority could make a limitation under Rule 45*bis*.9(a) such that it will not be competent if the claimed invention relates to certain subject matter. An Authority could not, however, make a limitation such that it will be competent to perform a supplementary international search but that the extent of that search will be limited so that the search will extend to claims which relate to acceptable subject matter but not to those claims relating to specified unacceptable subject matter. Similarly, an Authority could make a limitation such that it would not be competent if the international application contained more than a certain number of claims (say, more than 50 claims), but not a limitation such that it will be competent to perform a supplementary international search for an international application which contains more than 50 claims but that the extent of that search will be limited so that the search will extend to the first 50 claims only.

8. Box No. II of proposed Form PCT/SISA/501, as shown in Circular C. PCT 1153, consequently does not include any space for indicating claims which are found unsearchable as a result of a limitation in accordance with Rule 45*bis*.9

(though it does include all the options for the “normal” types of unsearchable claims, including those due to subject matter under Rule 39).

9. International Authorities are particularly invited to comment on this interpretation of limitations under Rule 45*bis*.9 as well as, if this interpretation is considered to be correct, whether it sees the need to amend the PCT Regulations so as to allow an Authority to make a limitation as to the claims which are searched, as distinct from a limitation as to overall competence to carry out a supplementary international search at all.

Comments on the Proposed Modifications

10. Since one International Searching Authority (Nordic Patent Institute) has already amended its agreement to indicate that it will be offering supplementary international searches as of January 1, 2009, and two others are also expected to do so; and noting that, as of that date, requests for supplementary searches may be made in relation to any international application (including pending applications) for which the 19 months period under Rule 45*bis*.1(a) has not expired by that date, you are invited to provide comments, if any, to the International Bureau by December 15, 2008, preferably by fax to (+41-22) 338 71 50 or by email to: *pct.mia@wipo.int*.

Sincerely yours,



Francis Gurry
Director General

Enclosures: Annex: Proposed modifications to the PCT International Search and Preliminary Examination Guidelines

CIRCULAR C.PCT 1155

ANNEX

PROPOSED MODIFICATIONS TO THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

Chapter 1 Introduction

[...]

Overview of International Application Process

1.09 The procedure through which an international patent application under the Patent Cooperation Treaty proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two main stages, commonly referred to as the “international phase” and the “national phase” (or “regional phase” when an international application comes before a regional body rather than a national one). As indicated in paragraph 1.01, a major change to processing international applications is that the International Searching Authority rather than the International Preliminary Examining Authority establishes a first written opinion (under PCT Rule 43*bis*), thus combining the international search and international preliminary procedures to a much greater extent than before. The following paragraphs 1.10, 1.11 and the flowchart of typical international application processing that has been provided at the end of this chapter provide a brief overview of the international phase, with a complete explanation provided in Parts 2 through 8 of the Guidelines.

The International Phase

Articles 22, 23

1.10 The international phase begins when the international application is filed and, provided that the international application is not withdrawn, includes various formalities checks, an international search, preparation of a written opinion, publication of the application and, optionally, an international preliminary examination. During this phase, no national or regional Office may process or examine the application except at the specific request of the applicant.

1.11 The international phase in turn includes a number of groups of actions which are distinct in nature, though they may in practice overlap slightly in timing:

(a) Filing of the international application with an appropriate receiving Office: this includes a “request” (a petition that the international application be processed according to the Treaty, together with certain data concerning matters such as the applicant, inventor, any agent and formal details about the application, such as the title and any priority claims), a description, one or more claims, one or more drawings (where required) and an abstract;

(b) Certain procedural checks are carried out, an international filing date is accorded and copies of the application are sent to the International Bureau (the record copy) and the International Searching Authority (the search copy);

(c) An international search by the International Searching Authority: this includes a search for earlier disclosures relevant to the novelty and inventive step of the claimed invention and the establishment of an international search report and a written opinion on novelty, inventive step and industrial application, normally at 16 months from the priority date, as detailed later in this document. (See chapter 2 and Parts IV and V);

(d) International Publication of the international application, the international search report, and Article 19 amendments (if any) by the International Bureau at 18 months from the priority date;

(e) Optionally, at the request of the applicant, a supplementary international search by a different Authority to the one which conducted the main international search, to extend the overall scope of the search (for example, to better cover prior art in languages which are not used by the main Authority);

(ef) Optionally, at the request of the applicant by filing a “demand” (Chapter II of the PCT), an international preliminary examination conducted by the International Preliminary Examining Authority, in which the examiner considers further the issues of novelty, inventive step and industrial application, taking into account any comments or amendments under Article 19 or 34 from the applicant, as detailed later in this document; this concludes with the establishment of an international preliminary examination report, which is entitled “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” (see chapter 17);

(fg) Issuance of an “international preliminary report on patentability” (Chapter I of the Patent Cooperation Treaty) by the International Bureau on behalf of the International Searching Authority if the applicant does not file a demand requesting examination of the international application in response to the written opinion as established by the International Searching Authority; the international preliminary report on patentability has the same content as the written opinion established by the International Searching Authority;

(gh) Distribution by the International Bureau of documents to the designated Offices or elected Offices, including copies of the application, any amendments which have been filed, any supplementary international search reports, and an international preliminary report on patentability, comprising either the contents of the written opinion by the International Searching Authority or, where established, the international preliminary examination report.

The National (or Regional) Phase

1.12 After 30 months from the priority date of the application (20 months in certain States due to transitional provisions; States also have the option of specifying a later date applicable for applications before their Office), the application may begin its national (or regional) phase in each designated Office (if international preliminary examination has not been demanded and Chapter I of the PCT applies) or elected

Office (if international preliminary examination has been demanded and Chapter II of the PCT applies). This is the procedure which actually leads to the grant, or refusal, of a patent according to the relevant national law or regional arrangement. While the national and regional Offices may not make further requirements beyond those of the Treaty and Regulations in respect of matters of form and contents, they are not bound by the Treaty to follow the results of any international search or examination which has been performed when the application is examined during the national or regional phase.

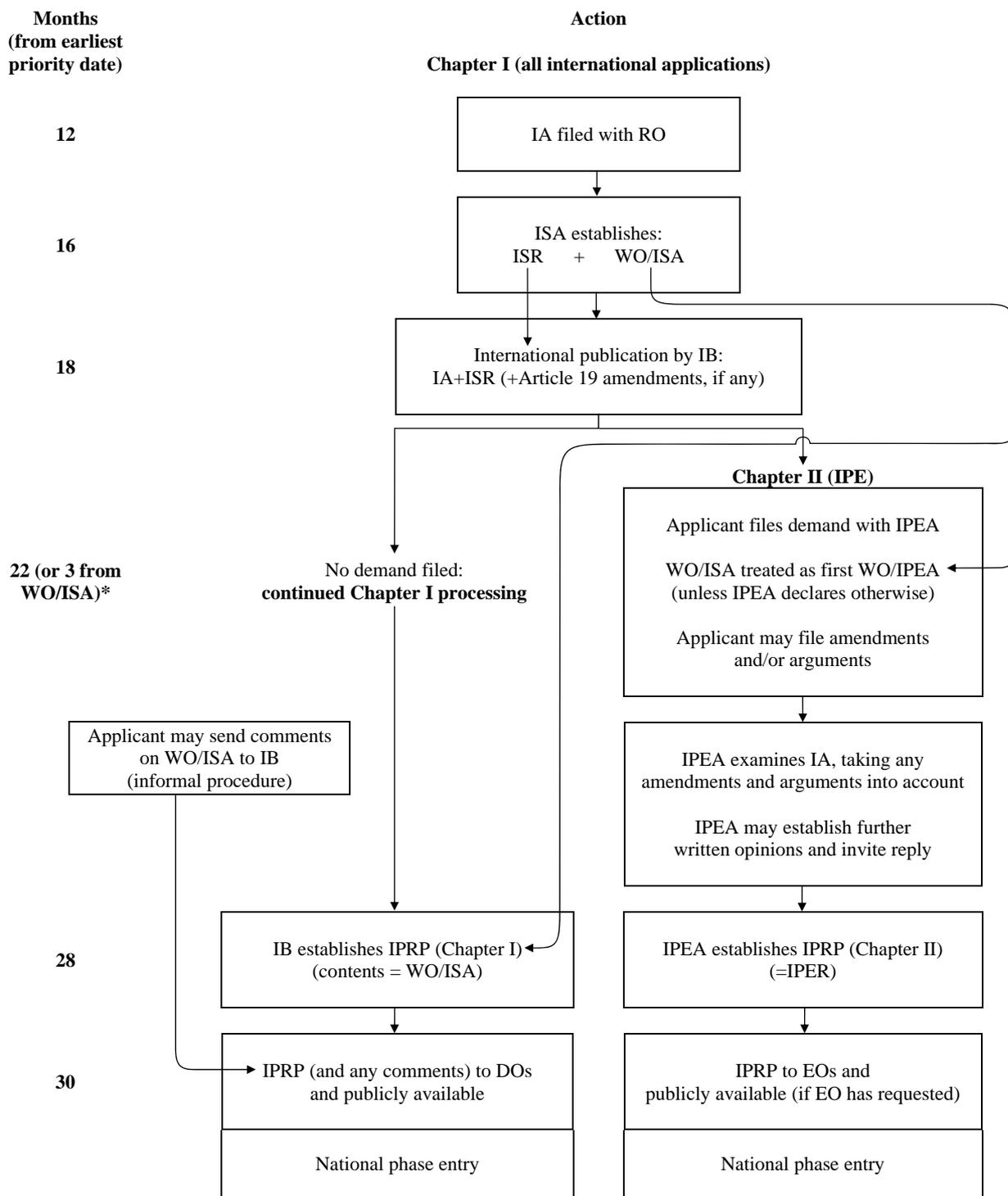
The International Authorities

Articles 16, 32; Rules 35, 59

1.13 The International Searching Authorities and International Preliminary Examining Authorities are national Offices or intergovernmental organizations entrusted with a number of tasks under the Treaty, especially the establishment of international search and preliminary examination reports. One or more Authorities may be competent to search or examine a particular international application. This depends on agreements between the International Authorities and the International Bureau, together with a decision which has been notified to the International Bureau by each receiving Office concerning which Authorities are competent to act in respect of international applications filed with that Office. Where more than one Authority might be competent to perform the search or examination of any particular application, the applicant chooses the desired Authority in the request or demand. [International Searching Authorities may decide whether they wish to offer a supplementary international search service, which will then normally be open to any applicant which does not choose that Authority for the main international search.](#)

1.14 The International Preliminary Examining Authority for any particular application will usually be the same body as the International Searching Authority, but this is not necessarily the case. A different Authority may be specifically chosen by the applicant or else, occasionally, an Authority may be competent to search a particular international application but not to examine it. Consequently it is particularly important that both the international search report and the written opinion by the International Searching Authority are produced to consistent standards, so that they may be used effectively by any other Authority, as well as by applicants and designated Offices.

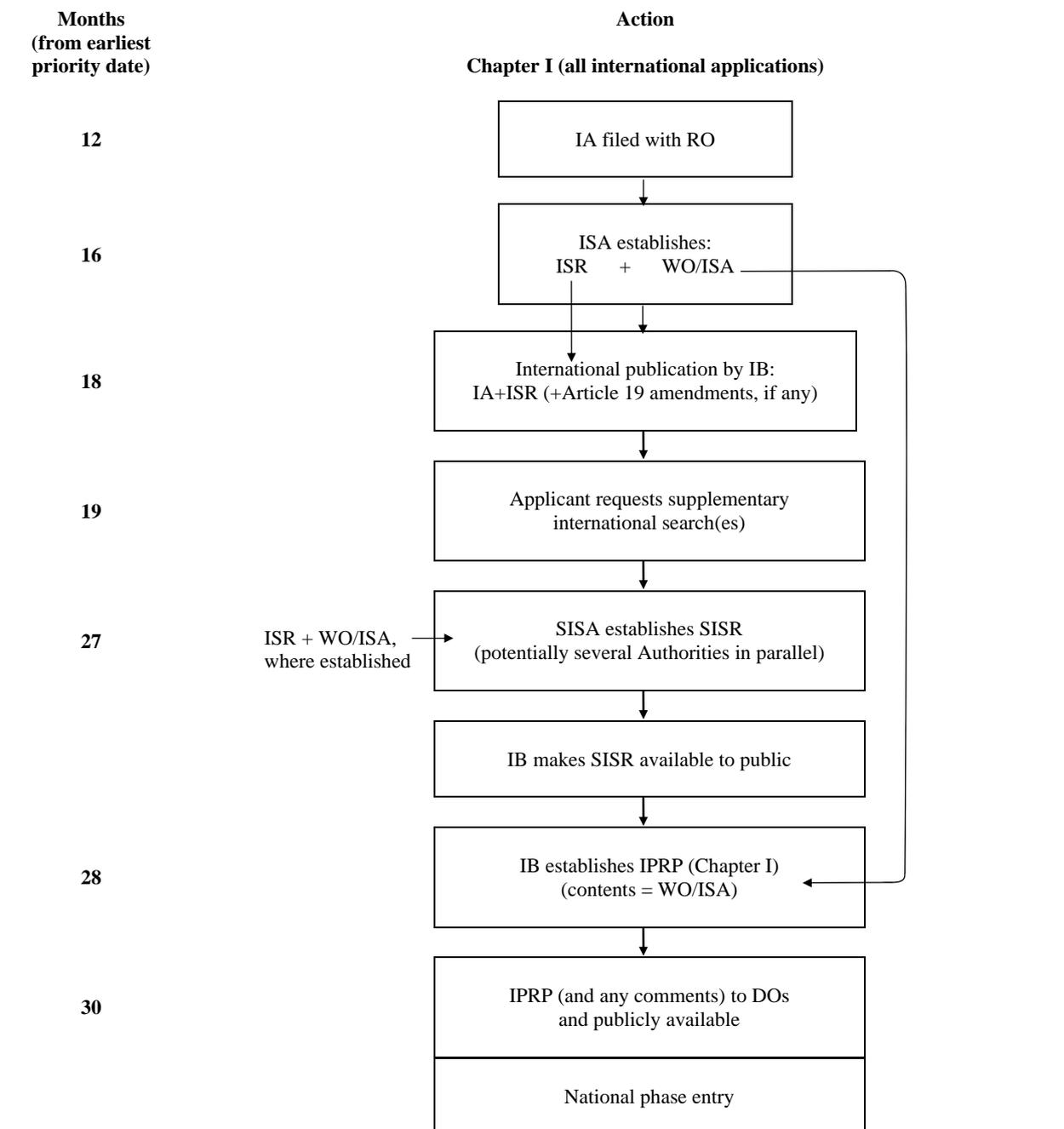
Flowchart of Typical International Application Processing



- | | | | |
|------|---|---------|---|
| RO | receiving Office | IA | international application |
| IB | International Bureau | ISR | international search report |
| ISA | International Searching Authority | WO/ISA | written opinion of the ISA |
| IPEA | International Preliminary Examining Authority | WO/IPEA | written opinion of the IPEA |
| DO | designated Office | IPE | international preliminary examination |
| EO | elected Office | IPRP | international preliminary report on patentability |
| | | IPER | international preliminary examination report |

* In practice, demand must be filed by 19 months for Article 22 transitional reservation countries

**Flowchart of Typical International Application
With Supplementary International Search**



RO	receiving Office	IA	international application
IB	International Bureau	ISR	international search report
ISA	International Searching Authority	WO/ISA	written opinion of the ISA
SISA	Authority specified for supplementary search	IPRP	international preliminary report on patentability
DO	designated Office		

Chapter 2 Overview of the International Search Stage

[...]

Options Open to the Applicant

2.15 In general, the applicant has the following options available following the receipt of the international search report and written opinion of the International Searching Authority:

(a) send (informal) comments on the written opinion of the International Searching Authority to the International Bureau, who will make these available to designated Offices and to the public at the same time that the written opinion becomes available (in the form of an international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty), see paragraph 2.18, below);

Rule 46

(b) submit to the International Bureau amendments of the claims under Article 19(1), optionally including a brief statement explaining the amendments;

Rule 45bis

(c) request one or more supplementary international searches from Authorities which offer that service, other than the one which performed the main international search;

Articles 31, 34(2)(b); Rule 53

(~~e~~) request international preliminary examination, including arguments and/or amendments which will be taken into account by the International Preliminary Examining Authority;

(~~e~~) withdraw the application under Rule 90bis; or

(~~f~~) take no further action in the international phase, instead waiting until it is necessary, or desired, to pursue the application before designated Offices.

Further Processing of the International Search Report and Written Opinion

Confidential Treatment

Article 30; Rules 44ter.1, 94.3

2.16 Prior to the international publication of the international application, all matter pertaining to the application is confidential and may not, without the request or authorization of the applicant, be accessed by any person or authority, except for the transmissions of information specifically required by the Treaty and Regulations for the purposes of processing the application. If no demand is filed:

(a) the written opinion of the International Searching Authority;

(b) any international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) (see paragraph 2.18, below);

(c) any translation thereof; and

(d) any comments on the written opinion of the International Searching Authority submitted by the applicant

all remain confidential until 30 months from the priority date unless authorized by the applicant. If early processing is requested, the designated or elected Office may allow access to any documents which have been communicated to it to the extent provided by its national law, provided that the international application has been published.

Publication of the Search Report

Article 21(3); Rules 48.2, 44ter

2.17 When the international application is published by the International Bureau, the international search report is published with the pamphlet (or, if delayed, is published as a separate pamphlet as soon as possible afterwards) and becomes available to the public. The written opinion, on the other hand, remains confidential for the time being.

Transmission and Making Available of the International Preliminary Report on Patentability When no Demand Is Filed

Rule 44bis

2.18 If no international preliminary examination report is to be established because the applicant did not file a demand for preliminary examination, or the demand has been withdrawn, the International Bureau will prepare a report, entitled “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” having the same contents as the written opinion. Note that even if the applicant filed any amendments under Article 19, the amendments will not be taken into consideration in the international preliminary report on patentability. Also, note that in certain circumstances as set forth in Rule 44bis.3(a) and (d), the International Bureau may translate the written opinion or report into English. Any such report and translation is communicated to designated Offices, who may then allow access to it, after 30 months from the priority date, or earlier if the applicant has requested early national processing of his application under Article 23(2). The report or written opinion, together with any translation may also be made available to the public by the International Bureau or the International Searching Authority after 30 months from the priority date.

Further Responsibilities of the International Searching Authority

Article 20(3), Rule 44.3

2.19 At any time within seven years of the international filing date of the international application, either the applicant or any designated Office is entitled to request copies of the documents cited in the search report to be sent to them by the International Searching Authority, subject, if required by the Authority, to the payment of costs for preparing and mailing the copies (the applicant may be sent copies of the citations automatically with the international search report).

Supplementary International Searches

2.19.1 International Searching Authorities may offer supplementary international searches as an optional additional service for applicants. Such searches are intended as a complement to the main international search, recognizing the fact that no search can be completely exhaustive and is particularly relevant to the situation where the Authority conducting the supplementary international search has particular language specializations which may not be available in the International Searching Authority which conducts the main international search. The applicant can request a supplementary international search from any Authority which offers the service (except the Authority which conducts the main search) at any time before 19 months from the priority date. Many of the details of the service provided are decided by the Authority which is to carry out the supplementary international search. The scope of the service is defined in an annex to the agreement between the International Bureau and the International Authority and details are published in the PCT Applicant's Guide.

International-Type Searches

Article 15(5)

2.20 Under Article 15(5), an International Searching Authority may be entrusted with carrying out “international-type searches” for national applications. These searches are by definition similar to international searches, and the same considerations for establishing the search report will apply. However, only the search itself is carried out; no written opinion is established for such applications unless there is a specific arrangement between the Offices involved for such an opinion to be established at the same time.

Chapter 10 Unity of Invention

[...]

Process at the International Search Stage

[...]

Process at the Supplementary International Search Stage

Rule 45bis.6

10.70.1 Contrary to the case for the main international search, there is no opportunity to pay additional fees for search of further inventions at the supplementary international search stage. Consequently, subject to the possibility of search of additional inventions without payment of fees where little additional search effort is required (as indicated in paragraphs 10.64 and 10.65 with respect to the main international search), the supplementary international search report should be established immediately on the main invention only (see paragraph 10.70.4 for consideration of what is the main invention).

Rule 45bis.6(a) and (b)

10.70.2 The Authority specified for supplementary international search may make its own assessment as to unity of invention, but it should take into account the opinion of the main International Searching Authority included in the international search report as well as any protest by the applicant or decision by the International Searching Authority in relation to such a process which is received prior to the start of the supplementary international search.

10.70.3 If the examiner considers that there is a lack of unity of invention, this should be explained in Box No. III of the supplementary international search report. If the examiner agrees with the assessment in the main international search report, this can be reported by simply referring to the international search report. On the other hand, if the examiner forms a different point of view, or agrees with a revised view on unity of invention in a decision relating to a protest (which will usually not appear in the original international search report, but only be available as a separate later document), the reasoning should be set out in full so that it is easily understood by both the applicant and third parties.

Rules 45bis.1(d), 45bis.6(a) and (f)

10.70.4 The main invention will normally be the invention first mentioned in the claims, but the examiner should use appropriate discretion in selecting the invention to be searched where the first mentioned invention is one for which no search report would be established (due to clarity, subject matter or for any other reason), or else where the applicant has requested that the supplementary search should be limited to one of the inventions other than the first identified by the International Searching Authority responsible for the main international search (for example, because the first invention has been shown by the main international search to be so completely anticipated that it is clear that no patent could be granted for that invention).

Review of Opinion

10.70.5 The normal protest procedure (see paragraphs 10.66 to 10.70) does not apply to requests for supplementary international search. However, the applicant may, within one month of the date of notification of the supplementary international search report, request the Authority to review the examiner's opinion on unity of invention. This request may be subject to a review fee. The results of the review are promptly notified to the applicant using

Form PCT/SISA/503. The same form can be used to indicate that the request for review is considered not to have been made because the review fee has not been paid within 1 month from the date on which the examiner's opinion was notified to the applicant.

10.70.6 If the examiner's opinion is found to be at least partly unjustified, the Authority should issue a corrected supplementary search report, stating the revised view on unity of invention and, where appropriate, including the search results for all claims which should have been included. If the opinion was entirely unjustified, the applicant should also have any review fee refunded.

Process at the International Preliminary Examination Stage

[...]

Chapter 15bis Supplementary International Search

Introduction

~~15.71~~15bis.01 Supplementary international search is an optional service offered by some International Searching Authorities. It is intended as a supplement to the main international search, recognizing the fact that no search can be completely exhaustive and is particularly relevant to the situation where the Authority conducting the supplementary international search has particular language specializations which may not be available in the International Searching Authority which conducts the main international search.

15bis.02~~15.72~~ Many of the details of the service provided are decided by the Authority which is to carry out the supplementary international search. The scope of the service is defined in an annex to the agreement between the International Bureau and the International Authority and details are published in the PCT Applicant's Guide.

Requesting Supplementary International Search

Rules 45bis.1 and 45bis.4

15bis.03~~15.73~~ If the applicant wishes a supplementary international search to be carried out, he must submit a request to the International Bureau within 19 months from the priority date and pay the relevant fees within one month of submitting the request. It is expected that a request for supplementary international search will usually only be made after the applicant has seen and considered the main international search report, but this is not a requirement.

Rule 45bis.4(e)

15bis.04~~15.74~~ If the request is valid and all the fees and necessary additional items (translations and copies of sequence listings in electronic form) are provided, the International Bureau will, once it has received the international search report or after the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

- (i) the supplementary search request;
- (ii) the international application;
- (iii) any sequence listing furnished with the request for supplementary international search;
- (iv) any translation furnished by the applicant which is to be used as the basis of the supplementary international search;

and, at the same time or promptly after their later receipt by the International Bureau:

(v) the international search report ([or the declaration in accordance with Article 17\(2\)\(a\) that no international search report will be established](#)) and the written opinion established under Rule 43bis.1;

(vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a); and

(vii) any protest by the applicant under Rule 40.2(c) and the decision thereon by the review body constituted in the framework of the International Searching Authority.

[15bis.05](#) If any of the documents listed in items (v) to (vii) are not available to the International Bureau at that time, they are transmitted promptly when they are later received.

Receipt of the Request for Supplementary International Search by the Authority

Acknowledgement of Receipt

Section 519

[15bis.06](#) On receipt of the request for supplementary international search, the Authority promptly sends an acknowledgement of receipt of the copy of the international application to the applicant and to the International Bureau using Form PCT/SISA/506.

Requests For Supplementary International Search Considered Not to Be Made

Rules 45bis.3(e) and 45bis.5(g)

[15bis.07](#) If, whether prior to or following acknowledgement of receipt of the request for supplementary international search, the Authority finds that carrying out the search is excluded by a limitation or condition specified in the agreement between the Authority and the International Bureau, the Authority considers the request not to have been submitted, in which case it notifies the applicant and the International Bureau accordingly using Form PCT/SISA/507 and refunds the supplementary search fee to the extent specified by the agreement, using Form PCT/SISA/508 to notify the repayment.

Start of Supplementary International Search

Rule 45bis.5(a)

~~15.75~~[15bis.08](#) The Authority specified for supplementary search normally starts the supplementary international search promptly on receipt of the documents indicated in items (i) to (iv) of paragraph ~~15.74~~[15bis.04](#), above, ~~save that~~ However, the Authority may, at its option, delay the start of the search until it has also received the international search report and written opinion of the International Searching Authority, or until the expiration of 22 months from the priority date, whichever occurs first.

Rule 45bis.4(f)

[15bis.09](#) If the written opinion of the main International Searching Authority is not in either English or a language accepted by the Authority specified for supplementary

search, the Authority may request the International Bureau to provide a translation into English, which is transmitted within two months of the request.

Withdrawal of the Request for Supplementary International Search

Rules 45bis.3(d) and 90bis.3bis; Section 520

15bis.10 The applicant may withdraw the request for supplementary international search at any time before the transmittal to the applicant of the supplementary international search report or the declaration that no such report will be established. In this case, processing of the supplementary international search should stop. There is no general obligation for the Authority to refund the supplementary search fee at this stage (the fee will be refunded by the International Bureau if the withdrawal occurs before any documents are sent to the Authority), but Authorities may offer full or partial refunds according to internal practice. Such policy may be set out in the section of the Agreement with the International Bureau under Article 16(3)(b) dealing with refunds. If the notice of withdrawal is received directly from the applicant, rather than from the International Bureau, the Authority should mark the notice with the date on which it was received and promptly transmit a copy to the International Bureau.

Basis of the Supplementary International Search

Rule 45bis.5(b)

15bis.11~~15.76~~ Although the applicant will often have had an opportunity to file amended claims under Article 19 by the time that the supplementary search is carried out, the supplementary search is performed on the basis of the international application as filed (or a translation thereof) so that it is easier for a truly complementary search to be performed and for the results to be considered together by the applicant or a designated Office.

Rules 13ter, 45bis.5(c)

15bis.12 If the application contains disclosure of one or more nucleotide and/or amino acid sequences but does not contain a sequence listing complying with the relevant standard (see paragraph 4.15), the Authority may invite the applicant (with Form PCT/SISA/504) to furnish, within a fixed time limit, a sequence listing in written form and/or in computer readable form complying with the standard for purposes of completion of the supplementary international search. If the applicant complies with the invitation, the Authority proceeds with the completion of the supplementary international search on the basis of the written and/or computer readable forms of the sequence listing provided. Any sequence listing not contained in the international application as filed will not, subject to Article 34, form part of the international application, but will only be used as a search tool. If the applicant does not comply with the invitation within the time limit or if the response to the invitation does not comply with the standard, the Authority is not required to carry out the supplementary international search to the extent that such non-compliance has the result that a meaningful search cannot be carried out (see paragraph 15bis.13(i)).

*Claims Excluded from Supplementary International Search**Rule 45bis.5(c) to (e)-and-(g)*

15bis.13~~15.77~~ In addition to limitation of the supplementary international search due to a lack of unity of invention (see paragraph 15bis.15, below), ~~T~~the supplementary search may exclude:

Rule 45bis.5(c)

(i) any claims which would not be the subject of international search by the Authority carrying out the supplementary search, whether for reasons of clarity, subject matter or failure to provide, after a warning and opportunity to comply, a sequence listing in an appropriate form (see paragraphs 15.11 and 15.29); and

Rule 45bis.5(d) and (e)

(ii) where the international search report or a declaration under Article 17(2)(a) has been established before the start of the supplementary search, any claims which were not the subject of the international search; ~~and~~

~~— (iii) — any claims which are excluded by a limitation or condition specified in the part of the agreement between the International Bureau and the International Authority stating the scope of its service.~~

Rule 45bis.5(c)

15bis.14~~15.78~~ If ~~such~~ exclusions referred to in paragraph 15bis.13 items (i) or (ii) mean that no supplementary international search report will be established, the Authority so declares and promptly notifies the applicant and the International Bureau using Form PCT/SISA/~~XXX~~502. On the other hand, if some claims are excluded, but a supplementary search report is nevertheless established, the limitations are indicated in Box No. II of the supplementary international search report (Form PCT/SISA/~~XXX~~501).

*Unity of Invention**Rules 45bis.5(b) and 45bis.6*

15bis.15~~15.79~~ Contrary to the case for the main international search, no opportunity is offered to pay additional fees in case it is found that the international application lacks unity of invention. Rather, the supplementary international search report is immediately established on those parts of the international application which relate to the main invention. Normally, this will mean the invention first mentioned in the claims. However, the examiner should also consider the following in determining whether there is unity of invention and, if so, what is considered to be the main invention (see also paragraphs 10.70.1 to 10.70.4):

Rule 45bis.6(b)

(i) though not bound by the views of the International Searching Authority, due account should be taken of any opinion on unity of invention included in the documents indicated in items (vi) and (vii) of paragraph 15bis.04~~15.74~~, above;

Rule 45bis.6(f)

(ii) if the International Searching Authority has found a lack of unity of invention, the applicant may, under Rule 45bis.1(d) have specified a wish that the supplementary search be limited to one of those inventions (for example, because the

first invention is clearly not novel and he does not wish to pursue it further) – if the examiner agrees with the assessment of unity of invention and the relevant claims are not excluded for any reason, the supplementary international search should focus on that invention;

(iii) where the invention first claimed would not be searched for any reason, the first searchable invention should be considered instead;

(iv) if other inventions are easily searched, it may be appropriate to include those inventions within the scope of the supplementary search report (see paragraph 10.64).

Rule 45bis.6(a)(ii)

15bis.16~~15.80~~ The examiner's opinion on unity of invention and the consequent scope of the supplementary international search should be reported on the supplementary international search report in the same way as for the main international search in Box No. III of the supplementary international search report (Form PCT/SISA/501).

Rule 45bis.6(c) and (d)

15bis.17~~15.81~~ The normal protest procedure (see paragraphs 10.66 to 10.70) does not apply to requests for supplementary international search. However, the applicant may, within one month of the date of notification of the supplementary international search report, request the Authority to review the examiner's opinion on unity of invention. This request may be subject to a review fee. The results of the review are promptly notified to the applicant and copied to the International Bureau using Form PCT/SISA/~~XXX~~503. The copy to the International Bureau should be accompanied by a copy of the applicant's request for review in case this needs to be transmitted to designated Offices (see paragraph 15bis.18). If the examiner's opinion is found to be at least partly unjustified, the Authority should issue a corrected supplementary search report, stating the revised view on unity of invention and, where appropriate, including the search results for all claims which should have been included. If the opinion was entirely unjustified, the applicant should also have any review fee refunded. See paragraphs 10.70.5 and 10.70.6.

Rule 45bis.6(e)

15bis.18 If the applicant so requests, the International Bureau will communicate the text of both the request for review and the decision thereon to the designated Offices together with the supplementary international search report.

Extent of Search

Rule 45bis.5(f)

15bis.19~~15.82~~ The minimum extent of a supplementary search is set out in the agreement between the International Bureau and the Authority specified for supplementary search. This will in general be different from the PCT minimum documentation under Rule 34 since it is expected that the main international search should, (subject to the language-related exceptions in paragraph (e) of that Rule,) cover that documentation ~~fully~~effectively. Where the main international search report is not received before the start of the supplementary international search (see

paragraph 15bis.08), the examiner may need to make assumptions about the scope which the main international search will have in order to decide the extent of the search which he should conduct. Any comments on this matter may be recorded on the supplementary international search report (see paragraph 16.51.1).

Establishment of the Supplementary International Search Report

Rule 45bis.7(a)

15bis.20~~15.83~~ The supplementary international search report (Form PCT/SISA/~~XXX~~501) ~~shall~~must be established, or declaration that no such report shall be established (Form PCT/SISA/~~XXX~~502) must be made within 28 months from the priority date and transmitted to the applicant and to the International Bureau using Form PCT/SISA/505.

Rule 45bis.7(b)

15bis.21~~15.84~~ The report or declaration is made in a language of publication: normally either the language of publication of the international application, or else the language of the translation provided for the purpose of the supplementary international search, though there may be cases where the first is not a language ~~offered~~accepted by the Authority and the second is not a language of publication.

Rule 45bis.87(c) to (e)

15bis.22~~15.85~~ The contents of the supplementary international search report are essentially the same as for the main international search report, save for the following:

- (i) an indication should be given on the cover sheet of whether the examiner was able to take into account the main international search report;
- (ii) the examiner does not classify the international application or make any indication of its classification on the supplementary international search report;
- (iii) it is not necessary to include the citation of any document cited in the main international search report, unless it is considered to have additional relevance when cited in conjunction with other documents not cited in the main international search report;
- (iv) explanation may be included with regard to the citations considered to be relevant: this is to allow short comments to be included to indicate what the relevant features of a document are in view of the fact that no additional written opinion is established and citations may frequently be in a language not easily understood by the applicant – the explanation is not intended to be a full explanation of the document's relevance to novelty and inventive step of the sort expected in a written opinion;
- (v) explanation may be included with regard to the scope of the supplementary international search, for example to indicate any assumptions made relating to the appropriate scope of search where the main international search report was not established and transmitted to the Authority specified for supplementary search in time to be considered during the search.

Copies of Documents

Rule 45bis.7(c)

15bis.23~~15.86~~ The Authority must provide copies of cited documents to the applicant or any designated Office, subject to the payment of any relevant fees, on request at any time within 7 years from the international filing date, as would be the case for the International Searching Authority under Article 20(3) and Rule 44.3. [Form PCT/SISA/509](#) may be used for this purpose.

Chapter 16

International Search Report

General

16.01 The results of the international search are recorded in the international search report (Form PCT/ISA/210), which is transmitted with Form PCT/ISA/220 to the applicant and with Form PCT/ISA/219 to the International Bureau, together with the written opinion of the International Searching Authority, which must be established at the same time. The search report is published by the International Bureau and serves as a basis for the written opinion of the International Searching Authority, any international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty), and any examination of the international application by the designated Offices or by the International Preliminary Examining Authority.

16.02 The examiner is responsible for seeing that the international search report is drawn up in such a way that it can subsequently be typed or printed in final form.

Supplementary International Search

16.02.1 The guidelines in this chapter also apply to the preparation of supplementary international search reports (see also Chapter 15bis). For such reports, Form PCT/SISA/501 is used instead of Form PCT/ISA/210. For the covering letters, Form PCT/SISA/505 is used instead of Form PCT/ISA/220. Otherwise, specific details are only included where the required content or procedure differs from that in the case of a normal international search report. The supplementary international search report is not accompanied by a written opinion, but may include certain explanations which might otherwise have been included in a written opinion (see paragraph 16.58(c)).

International-Type Search

16.02.2 The guidelines in this chapter also apply to the preparation of international-type search reports (see paragraph 2.20). For such reports, Form PCT/ISA/201 is used instead of Form PCT/ISA/210. Form PCT/ISA/220 (see paragraphs 16.12 to 16.19) is not used as a covering letter: the nature of any alternative depends on the arrangements between the International Searching Authority and the national Office on whose behalf the international-type search is conducted, as does the matter of whether the international-type search report is accompanied by a written opinion.

Time Limit for Establishing the International Search Report

Articles 17(2), 18(1); Rule 42.1

16.03 The international search must be carried out in time to allow the final establishment of the international search report or of a declaration under Article 17(2) (see paragraph 9.40) before the expiration of three months from the receipt of the search copy by the International Searching Authority, which is notified to the applicant on Form PCT/ISA/202, or nine months from the priority date, whichever time limit

expires later. If, in case of lack of unity of invention or of an invitation to file a sequence listing, the time limit cannot be met, the international search report is established promptly after the receipt of additional search fees or after the expiration of the time limit for payment of such fees, if no such payment is made, or after the receipt of the sequence listing.

Completing the International Search Report

Sections 110, 504, 503, 508; AI Annex B

16.04 The following paragraphs contain information which is necessary to enable the examiner to complete the Form correctly. Further information is contained in the following Sections of the Administrative Instructions:

- (i) for the indication of dates: Section 110;
- (ii) for the classification of the international applications: Section 504 ([does not apply to supplementary international search reports](#));
- (iii) for the identification of the cited documents: Section 503;
- (iv) for the indication of special categories of documents: Sections 505 and 507;
- (v) for the indication of the claims to which cited documents are relevant: Section 508;
- (vi) for the consideration of unity of invention: Annex B to the Administrative Instructions.

Matter Not Required by the Form

Rules 43.9, 45bis.7

16.05 The international search report must contain no matter other than as required by the Form; in particular, it must contain no expressions of opinion, reasoning, arguments or explanations. [However, in the case of supplementary international search reports \(which are not accompanied by written opinions\), the report may contain explanations with regard to the citations and the scope of the search: see paragraph 15bis.22 items \(iv\) and \(v\).](#)

Different Types of International Search Reports

Articles 15(5), 16(1)

16.06 [\[moved to 16.02.1 and 16.02.2 and expanded\]](#) ~~The International Searching Authority may draw up the following types of search reports:~~

- ~~—— (i) international search report;~~
- ~~—— (ii) international type search report (see paragraph 2.20).~~

Form and Language of the International Search Report

International Search Report Form

Section 507(g)

16.07 Following completion of the search, the examiner reconsiders the classification in the light of experience acquired during the search ([this does not apply to supplementary international searches, in which no classification of the international application is made](#)) and prepares the international search report (Form PCT/ISA/210) and the Notification of Transmittal of the ISR (Form PCT/ISA/220). Once an examiner has completed the search, there should be no delay in completing the search report. The printed international search report Form (Form PCT/ISA/210) to be transmitted to the applicant and to the International Bureau contains two main sheets (“first sheet” and “second sheet”) to be used for all searches. These two main sheets are intended for recording the important features of the search such as the fields searched and for citing documents revealed by the search. The printed international search report Form also contains ~~five~~[six](#) optional continuation sheets for use where necessary. There are continuation sheets for each of the “first sheet” and the “second sheet”:

(a) “continuation of first sheet (1),” “continuation of first sheet (2),” and “continuation of first sheet (3);” and

(b) “continuation of second sheet,” ~~and~~ “patent family annex,” [and “extra sheet”](#) respectively.

16.08 The “continuation of first sheet (1)” is used only when the international application includes a nucleotide and/or amino acid sequence and indicates the basis on which the international search was carried out, since the relevant listings or related tables may be filed or furnished at different times and in different forms. The “continuation of first sheet (2) is used where an indication is made on the first sheet that claims were found unsearchable (item 2) and/or that unity of invention is lacking (item 3). The relevant indications are then made on that continuation sheet. The “continuation of first sheet (3)” contains the text of the abstract where an abstract or an amended abstract is established by the International Searching Authority (item 5) and an indication to that effect is made on the first sheet. The “continuation of second sheet” is to be used where the space on the second sheet is insufficient for the citation of documents. The “patent family annex,” or alternatively a blank sheet, may be used for the indication of the members of patent families. The Form also includes an “extra sheet,” which may be used whenever additional space is required to complete information from the other sheets. A sheet may be in paper form or may consist of the electronic equivalent of a paper sheet.

[16.08.1 “Continuation of first sheet \(3\)” does not appear in the Forms for international-type searches \(Form PCT/ISA/201\) and supplementary international searches \(Form PCT/SISA/501\), which do not provide for establishment of an abstract. Form PCT/SISA/501 also contains a further optional sheet for information on the scope of the supplementary international search \(see paragraphs 15bis.13 and 16.51.1\).](#)

Language of Search Report

Rule 43.4

16.09 The international search report is drawn up in the language in which the international application to which it relates is to be published, or, if a translation into another language was transmitted under Rule 23.1(b) (see paragraph 15.13) and the International Searching Authority so wishes, in the language of that translation. Supplementary international search reports are drawn up in a language of publication. Normally, this will be either the language in which the international application is actually to be published, or else the language of the translation provided for the purpose of supplementary international search, but it is possible that the former may not be a working language of the Authority and that the latter may not be a language of publication; in this case, any language of publication may be used.

Sheets Included in the Pamphlet

16.10 It is to be noted that only the “second sheet,” the “continuation of second sheet” (if any), the “continuation of first sheet (2)” (if any), and “the extra sheet” (if any), as well as any separate sheet with information on members of patent families, will be the subject of international publication, as the “first sheet” and the continuations of first sheet (1) and (3) (if any) contain only information which will already appear on the front page of the pamphlet.

International Type Search

Rules 45bis.8(d), 94.1(a)

16.11 *[original content moved to 16.02.2 and expanded slightly]* ~~If an international-type search has been carried out, Form PCT/ISA/201 is used for the report.~~ Any supplementary international search report is not included in the published international application, but the complete document (including the first sheet and any continuation sheets) is made available to the public, together with a translation into English where appropriate. The report is also communicated to all designated and elected Offices whenever the main international search report is requested.

Filling Out the Notification of Transmittal of the International Search Report of the Declaration (Form PCT/ISA/220)

Address for Correspondence

Section 108

16.12 The address for correspondence is taken from the request Form (PCT/RO/101). When an agent represents the applicant, the address for correspondence is listed in Box No. IV of the PCT request Form. For applicants processing their own applications, the address for correspondence may be listed in Box No. II of the request Form. However, where the correspondence on file shows any changes in the applicant or address for correspondence, the later address is used.

Applicant's or Agent's File Reference

Section 109

16.13 The applicant's or agent's file reference is taken from the request Form (PCT/RO/101) or else the most recent file reference from the latest correspondence from the applicant or the agent.

International Application Number

16.14 The international application number is allocated and recorded on the request Form by the receiving Office.

International Filing Date

16.15 The international filing date is assigned by the receiving Office upon receipt of the international application. This date is recorded on the request Form.

Applicant

Section 105

16.16 When there is more than one applicant in respect of the international application, only the first mentioned of these on the request Form is indicated in the international search report. The other applicants, if any, are indicated by the words "et al" (or ET-AL) following the first applicant's name. The first mentioned applicant is indicated in Box No. II of the request Form, a second applicant is listed in Box No. III; further applicants are listed on the continuation sheet if there are more than two applicants.

Example (i): AMERICAN TECHNOLOGIES INC. et al.

Example (ii): SMITH, John Doe

Notes:

(a) As shown above, company names are written in capital letters; for personal names the family name is given first in capital letters and the given names are in mixed case-this helps to identify the family name.

(b) These guidelines will be followed, *mutatis mutandis*, when the international search report is being prepared in a language, such as Japanese, that does not discriminate between uppercase and lowercase characters or when the language of the international search report has a different order of indicating surnames and given names.

Cases Where No, or Limited, Search Report is Established

Rules 39 and 67 |

16.17 No International Searching Authority is required to search or examine an international application to the extent that its subject matter is any of the following:

- (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.

Chapter 9 deals in detail with these exclusions from the search and examination, as well as other situations, such as lack of clarity, where it may not be possible to establish a meaningful international search in respect of some or all claims. See also paragraph 15.11, which deals with the exclusion of claims as a result of non-compliance with the relevant standards for sequence listings. [Supplementary international search reports may also exclude claims which were not the subject of the main international search.](#)

16.18 Paragraph 9.40 indicates the course of action to be taken if it is not possible to establish an international search in respect of any of the claims.

16.19 Where the examiner finds that the claims relate to more than one invention and these inventions are not so linked as to form a single general inventive concept, the international search report may be established only in respect of the first invention and those further inventions in respect of which additional fees are paid. See chapter 10. The additional fees may be paid under protest (see paragraphs 10.66 to 10.70).

Filling Out the International Search Report (Form PCT/ISA/210)

Earliest Priority Date

16.20 The earliest priority date is given in Box No. VI of the request Form (PCT/RO/101).

Total Number of Sheets

16.21 The first sheet of the international search report indicates the total number of sheets in the report. The correct number is entered, not including sheets which have not been filled in (blank sheets). The number of sheets only includes the number of sheets from Form PCT/ISA/210. It does not include the number of sheets from Form PCT/ISA/220 (Notification of transmittal of the international search report and the written opinion of the International Searching Authority, or the declaration) as this is a letter to the applicant/attorney only.

“It Is Also Accompanied by a Copy of Each Prior Art Document Cited in This Report” Box

16.22 If the International Searching Authority is sending out documents, this box is checked.

Basis of the Report

16.23 If the search has been conducted on the basis of a translation of the international application (see paragraph 15.13), this is indicated in item 1a of the first sheet of the international search report.

16.23.1 If rectifications of obvious mistakes have been authorized by or notified to the International Searching Authority in time to be taken into account in the international search report, this is indicated by checking box 1.b of the first sheet of the international search report.

Nucleotide and/or Amino Acid Sequence Listings and Related Tables

16.24 Where the application discloses any nucleotide and/or amino acid, box 1.bc of the first sheet is checked and Box No. I (appearing on “continuation of first sheet (1)”) indicates the form (that is, whether in paper copy or computer readable form) and status (that is, whether filed with the international application or later, for the purposes of search) of the sequence listing, and any related tables, that the search was carried out on. See paragraphs 4.15 and 15.11 for further details.

Reference to Main International Search Report

16.24.1 In the case of supplementary international search reports, item 1.d of the first sheet indicates whether the international search report was received in time for it to be able to take it into account. If the international search report was not taken into account, it may be necessary to include an indication of any assumptions which were made as to the scope of the main international search in the Annex of Form PCT/SISA/501 concerning the scope of the supplementary international search (see paragraph 15bis.19).

Restriction of the Subject of the International Search

16.25 The report indicates whether the search was restricted or not for any of the reasons indicated below. If any such restrictions are applied, the claims in respect of which a search has not been carried out are identified and the reasons for this are indicated. The four categories where such restrictions may arise are:

(i) claims drawn to subject matter not required to be searched by the International Authority (see chapter 9 – in the case of supplementary international searches, see also paragraph 15bis.13);

(ii) claims in respect of which a meaningful search cannot be carried out (see chapter 9);

(iii) multiple dependent claims which do not comply with Rule 6.4(a) (see paragraph 5.16);

(iv) lack of unity of invention (see chapter 10).

16.26 Where claims are not searched for any of the reasons (i) to (iii), box 2 of the first sheet of the international search report is checked. In addition, Box No. II of the international search report (on “continuation of first sheet (2)”) is completed, giving the details.

16.27 It should be noted that claims which rely, in respect of the technical features of the invention, on references to the description or drawings (“omnibus claims;” see paragraph 5.10) are searched and reported upon if they can be given a definite construction. However in the written opinion of the International Searching Authority and for the purposes of international preliminary examination, any breach of Rule 6.2(a) (no reference to the description or drawings except when absolutely necessary) may be reported in Box No. VII of the opinion or report.

16.28 If the national law of the Office acting as International Searching Authority permits multiple dependent claims which do not comply with Rule 6.4(a), such claims are included in the international search and no indication is made under item 3 of Box No. II.

16.29 Where lack of unity has been found (see chapter 10), check box 3 of the first sheet of the international search report (Form PCT/ISA/210) is checked. In addition, Box No. III of the international search report (on “continuation of first sheet (2)”) is completed, irrespective of whether an invitation to pay additional search fees has issued. The search report indicates the separate inventions present in the claims, whether additional search fees were requested and paid, and which claims were searched. It also indicates whether any additional search fees were accompanied by a protest. [In the case of supplementary international search reports, there is no opportunity to pay additional fees and only a single invention is searched – see paragraphs 10.70.1 to 10.70.6 for the applicable process in this case.](#)

Abstract, Title and Figure

Articles 3(2), 4(1)(iv); Rules 8, 44.2

16.30 The international application must contain an abstract and a title. The examiner [conducting the main international search](#) indicates approval or amendment of the text of the abstract, the title of the invention, and the selection of the figure that is to accompany the abstract in items 4 to 6 of the first sheet of the international search report. Box No. IV (on “continuation of first sheet (3)”) is used to record any new or amended abstract.

[16.30.1 This procedure does not apply to supplementary international searches. Consequently paragraphs 16.31 to 16.48 do not apply to supplementary international search reports. For international-type searches, it is a matter for agreement between the International Searching Authority and the national Office on whose behalf the international search is conducted whether the title and abstract are reviewed by the International Authority. Form PCT/ISA/201 does not include specific space for such matters; if required, the appropriate information should be recorded on separate sheets.](#)

– Abstract

Article 14(1)(a)(iv) and (1)(b); Rules 26, 38.1

16.31 Where the international application lacks an abstract, the relevant receiving Office should find this in their routine check and issue the invitation to correct accordingly, allowing at least one month from the mailing date of the invitation for a reply. The receiving Office should notify the International Searching Authority that

the invitation has been sent. The receiving Office may declare the international application withdrawn if no abstract is furnished to the receiving Office within the time limit fixed. However the International Searching Authority proceeds with the international search unless and until it receives notification that the application is considered withdrawn.

Article 3(3); Rule 8.3

16.32 In determining the definitive contents of the abstract, or establishing the text of the abstract anew, where it is missing, the examiner should take into consideration the fact that the abstract is merely for use as technical information and, in particular, must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be drafted so that it constitutes an efficient instrument for the purpose of assisting the scientist, engineer or researcher in searching in the particular technical field and should in particular make it possible to assess whether there is need for consulting the international application itself. WIPO guidelines for the preparation of abstracts are found in WIPO Standard ST.12/A.

Rule 8.1(a), 8.3

16.33 In considering the adequacy of the applicant's abstract and figure, because of practical difficulties experienced by the International Bureau with publication, examiners when assessing or drafting abstracts, should have particular regard to the following:

(a) It is important that the abstract be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). Within this constraint the abstract must provide a summary of the technical information about the disclosure as contained in the description, claims and drawings. It should be drafted so as to serve as an efficient scanning tool for searching purposes in the art.

(b) Phrases should not be used which can be implied, such as, "This disclosure concerns", "The invention defined by this disclosure" and "This invention relates to".

Rule 8.2(b)

(c) Only one figure should normally be selected unless this would lead to inadequate disclosure. The inclusion of more than two figures should not be considered except in extreme circumstances where necessary information cannot be otherwise conveyed. Where none of the figures is considered useful for the understanding of the invention (even where the applicant has suggested a figure), no figure should be selected.

(d) Abstracts may be incomprehensible if the numerals on the selected figure(s) do not correspond with those in the abstract.

(e) An absence of reference numerals on the figures must be accepted as the examiner has no mechanism to initiate their provision.

Rule 8.1(d)

(f) Each main technical feature mentioned in the abstract and illustrated by a drawing should be followed by a reference sign, placed between parentheses.

Rule 38.2(a)

16.34 If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it establishes an abstract itself.

16.35 The review of the abstract should be conducted in a way that does not impact upon the date of actual completion of the search. This review should be completed in parallel with other steps in the process.

16.36 The applicant can only comment on the abstract prepared by the examiner after it has been established in the international search report (see search report Form PCT/ISA/210, first sheet, item 5). This is the only invitation to comment issued to the applicant. It occurs either when no abstract has been filed or when the originally filed abstract does not comply with Rule 8, and the examiner must prepare a compliant abstract. In this event the examiner establishes an appropriate abstract.

Rule 38.2(b)

16.37 The applicant is allowed one month from the date of mailing of the international search report to respond to the examiner's abstract in the report.

16.38 If the applicant does comment, the examiner takes the applicant's comments into consideration. It is not necessary for the examiner to reply to the applicant's comment even if adverse.

Rule 38.2(b); Section 515

16.39 If the International Searching Authority amends the abstract established in the international search report it notifies the International Bureau and the applicant using Form PCT/ISA/205.

– *Title*

Rules 4.3, 26.1, 37.2, 44.2

16.40 According to Rule 4.3, the title must be short and precise (preferable from two to seven words in English or when translated into English). Furthermore, the title should clearly and concisely state the technical designation of the invention. In this regard the following should be taken into account:

(a) personal names or trade names or similar terms of a non-technical nature which do not serve to identify the invention should not be used;

(b) the abbreviation "etc.", being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(c) titles such as "Method", "Apparatus", "Chemical Compounds" alone or similar vague titles do not clearly state the technical designation of the invention."

Article 14(1)(a)(iii) and 14(1)(b); Rules 26 and 37.1

16.41 Where the international application lacks a title, the relevant receiving Office should find this in its routine check and issue the invitation to correct accordingly, allowing at least one month from the mailing date of the invitation for a reply. The receiving Office should notify the International Searching Authority that the invitation has been sent. The receiving Office may declare the international application

withdrawn if no title is furnished to the receiving Office within the time limit fixed. However, the International Searching Authority proceeds with the international search unless and until it receives notification that the application is considered withdrawn.

Rule 37

16.42 The examiner is required to draft a title where:

(i) the applicant has not responded to the invitation from the receiving Office to provide a title within the time allowed, but the International Searching Authority has not received notification that the application is considered withdrawn,

(ii) no title was filed and the receiving Office omitted to invite the applicant to rectify the deficiency, or

(iii) the title is deficient because it does not comply with the requirements of Rule 4.3.

16.43 The examiner is not required to gain the approval of the applicant for the title and the establishment of the title by the examiner is by suitable completion of the international search report Form (see check box 4 of the first sheet of Form PCT/ISA/210).

– *Drawings to Be Published*

16.44 When indicating the Figure No. of the drawings, the applicant's suggestion is found at Box No. IX of the request Form (PCT/RO/101).

16.45 Where none of the figures is considered useful for the understanding of the abstract, this is indicated at the appropriate box (item 6, first sheet of the international search report).

16.46 When no drawings accompany the application none of the boxes are checked.

16.47 It is not recommended to select more than one figure; however, if it is necessary to do so then the wording of the Form should be changed to reflect the change from single case to plural case. For example, "figure" is changed to "figures", "is" to "are" and "No." to "Nos.". (These recommendations will be followed, *mutatis mutandis*, when the international search report is being prepared in a language, such as Japanese, that does not have distinction between singular and plural forms.)

Classification of Subject Matter

Rule 43.6(a)

16.48 The International Searching Authority [conducting the main international search](#) assigns obligatory "invention information" International Patent Classification (IPC) symbols in accordance with the rules as set forth in the Guide to the IPC and in the IPC itself (using the edition of the IPC in force at the time) and records this information in Box A of the second sheet of the international search report. Non-obligatory IPC symbols, as defined in the Guide (such as the optional IPC indexing codes), do not need to be applied. The IPC Guide can be accessed via the WIPO web site at: www.wipo.int. See chapter 7. [No additional classification or reclassification is made during any supplementary international search.](#)

Fields Searched

16.49 The international search report lists the classification identification of the fields searched in Box B of the second sheet of the international search report. If the IPC is not used for this purpose, the classification used is indicated.

Minimum Documentation Searched

16.50 The International Searching Authority consults the minimum documentation specified in Rule 34 and considers other relevant databases or other search resources such as those listed in the Search Guidance IPDL. Where the IPC classification terms were searched, with or without restricting the search by using key words, the examiner should enter the associated IPC symbols on the international search report.

Documentation Searched Other Than Minimum Documentation

Rule 43.6(b)

16.51 Where documentation other than the PCT minimum documentation is searched, the other documentation searched is identified in Box B of the second sheet of the international search report when practicable. This section is used for non-electronic databases searched, for example, paper or microfilm. It is used for example, for:

(a) Capri-enter “CAPRI” and the appropriate IPC code for the classification searched, for example, “CAPRI: IPC F16B 1/02”.

(b) Search of patent specifications not forming part of the minimum documentation according to a classification system peculiar to the country issuing the patent - enter classification searched, for example, “AU Class 53.6”

(c) Search of patent specifications not forming part of the minimum documentation according to the IPC - enter the IPC codes for the classification places searched, for example, “AU: IPC B65G 51/-”.

Rule 45bis.7(e)(ii)

16.51.1 In the case of a supplementary international search report, depending on the scope of service which is defined in the agreement between the International Bureau and the particular International Searching Authority, the examiner may assume that the PCT minimum documentation had been included in the main international search and that the main focus of the search should lie elsewhere, for example on disclosures in particular languages in which the International Authority specified for supplementary search specializes. An extra sheet may be included to make longer comments on the scope of the supplementary international search, including any assumptions which have been made on the scope of the main international search in the event that this was not received by the Authority in time to review it prior to carrying out the supplementary search (see paragraph 15bis.19).

Electronic Database Consulted

Rule 43.6(c)

16.52 Where an electronic database is used in carrying out the international search, the name of the database may be included in the search report. In addition, depending on the policy of an International Searching Authority, examiners may find it useful to

others to indicate the exact search queries used to search the database in the report. If it is impractical to record the exact query or queries, then a summary of the query or queries should be included. See paragraph 16.53.

16.53 Where keywords (search terms) are used, it may be useful to include the keywords on the search report. If the number of keywords used is large, then a representative sample of the keywords could be used (for example, “Keywords: A, B, C, and similar terms”). However, depending on the policy of an International Searching Authority, the examiner may find it useful to record the search history in sufficient detail to allow examiners of national stage applications to fully interpret and rely upon the international search. See paragraph 15.58.

16.54 Structure searches are not conveniently indicated on the search report. If a structure search was carried out this can be indicated by a statement such as “structure search carried out based on the quinoline nucleus in formula (I)”.

16.55 Sequence searches should be dealt with in the same way as structure searches (“search of SEQ ID 1-5”).

Examples:

DWPI & keywords: A, B, C, and similar terms (Note; DWPI includes WPAT, WPI, WPIL)

JAPIO & keywords: A, B, C, and similar terms

MEDLINE & keywords: A, B, C, and similar terms

DWPI IPC A01B 1/- & keywords: A, B, C

CA & WPIDS: IPC C07D 409/- & keywords: A, B, C

CA: Structure searched based on Formula (I)

ESP@CE keywords: A, B, C.

Genbank: Sequence search on nucleic acid sequence SEQ ID NO: 1.

Notes:

(a) Merely putting “keywords searched” without specifying the actual keywords used is not acceptable.

(b) There is no need to indicate the way the database was accessed, for example, there is no need to specify that ESP@CE was accessed via the Internet, or MEDLINE via STN.

(c) Where the search is conducted using a particularly relevant portion of a longer referenced nucleic acid or amino acid sequence, rather than the full length sequence referenced as filed for a particular SEQ ID NO of the sequence listing, the search examiner should indicate the region or regions of the full length reference sequence which encompassed the sequence searched. For example “search of SEQ ID NO: 1 for nucleotides 1150-1250 only.”

Previous Search

16.56 Where the international search report is entirely or partly based on a previous search made for an application relating to a similar subject, the previous application number and the relevant search history consulted for this previous search is, where appropriate, identified as having been consulted for the international application in question, except in those instances where the details of an earlier search cannot be ascertained, or whenever it is impractical to record the full details of the earlier search. In the later case, a summary of the earlier search should be included. Where the previous application has been published, this information is recorded in the international search report; if the previous application has not yet been published, the information may be sent to the applicant informally when the international search report is transmitted. See paragraph 16.53.

Documents Considered to Be Relevant

Rule 43.5

16.57 The completion of Box C of the second sheet of the international search report can be considered as having three components. These are: the citation category; the citation of the document together with identification of relevant passages where appropriate; and the identification of relevant claim numbers. These three components are discussed separately in paragraphs 16.59 to 16.69, 16.72, and 16.71 and 16.73, respectively, below.

16.58 Some general points to note are:

Rule 33.1

(a) Documents selected for citation should be the prior art that is closest to the applicant's invention. The duplication of teachings by way of citation of multiple documents showing the same inventive elements should be kept to a minimum (see paragraphs 15.63 and 15.64).

(b) When citing a document, the examiner should clearly indicate which portions and specific pages of the document are most relevant (see paragraph 15.64).

(c) In the case of supplementary international searches, the examiner need not include in the report the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report. Noting that the supplementary search is intended to supplement the main international search rather than to make a reassessment, inclusion of such citations and reassessment of their relevance should be avoided. Usually, the reason for including such a citation is where it is necessary to cite the document as category "Y" (see paragraph 16.62) to indicate a lack of inventive step when the disclosure of the document is taken together with that of a newly discovered citation, further to any lack of inventive step indicated in the main international search report. Nevertheless, recitation of a document may also be appropriate where the main international search report has clearly failed to recognize the extent of a document's relevance, for example because the first examiner was relying on an abstract or machine translation because he did not understand the original language of the document.

Citation Category

Sections 505, 507

16.59 Documents which are cited are given a category indication by way of an alphabetic character, details of which are given in Administrative Instructions 505 and 507 and below. The categories for citations are also explained under the “Documents considered to be relevant” section of the report. A category should always be indicated for each document cited. Where needed, combinations of different categories are possible.

– *Particularly relevant documents*

Section 505

16.60 Where a document cited in the international search report is particularly relevant, it is indicated by the letters “X” or “Y”.

16.61 Category “X” is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel or where a document is such that when considered in light of common general knowledge, a claimed invention cannot be considered to involve an inventive step.

16.62 Category “Y” is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art.

– *Documents defining the state of the art not prejudicing novelty or inventive step*

Section 507(c)

16.63 Where a document cited in the International search report represents state of the art not prejudicial to the novelty or inventive step of the claimed invention, it is indicated by the letter “A”.

– *Documents which refer to a nonwritten disclosure*

Section 507(a)

16.64 Where a document cited in the International search report refers to a non-written disclosure, the letter “O” is entered. Examples of such disclosures include conference proceedings. The document category “O” is always accompanied by a symbol indicating the relevance of the document according to paragraphs 16.61 to 16.63, for example O,X, O,Y or O,A.

– *Intermediate documents*

Section 507(d)

16.65 Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one (see Article 2(xi)(b)), are denoted by the letter “P”. The letter “P” is also given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category “P” is always accompanied by a symbol indicating the relevance of the document, for example P,X, P,Y or P,A.

– *Documents relating to the theory or principle underlying the invention*

Section 507(e)

16.66 Where any document cited in the search report is a document which may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter “T”.

– *Potentially conflicting patent documents*

Section 507(b)

16.67 Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date) but published later than that date and the content of which would constitute prior art relevant to novelty (Article 33(2)) is indicated by the letter “E” (see section 507(b) and Rule 33.1(c)). Where the patent document and the application searched have the same date, the patent document is also identified by the letter “E”. An exception is made for patent documents based on the priority under consideration.

– *Documents cited in the application*

16.68 When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, such documents may be identified on the search report by the wording “cited in the application”, which appears under the cited document.

– *Documents cited for other reasons*

Section 507(f)

16.69 Where in the search report any document is cited for reasons other than those referred to in the foregoing paragraphs (in particular as evidence), for example:

(a) a document which may throw doubt on a priority claim (Article 4(C)(4) of the Paris Convention), or

(b) a document cited to establish the publication date of another citation

the document is indicated by the letter “L”. Brief reasons for citing the document should be given. Documents of this type need not be indicated as relevant to any particular claims. However, where the evidence which they provide relates only to certain claims (for example the “L” document cited in the search report may invalidate

the priority in respect of certain claims and not others), then the citation of the document should refer to those claims.

– *Non-prejudicial disclosures*

16.70 In certain cases the invention may have been disclosed, before the relevant date for the purposes of the PCT, in such a way that it is not considered to form part of the state of the art in accordance with the national law of one or more designated Offices. The applicant may make a declaration of the existence of such excluded state of the art in the request Form according to Rule 4.17(v). However these exemptions do not necessarily apply in all designated Contracting States and additionally, according to Rule 51bis.1(a)(v), the applicant may still have to file the correct documents in the national/regional phase at the designated Office in question in order to qualify for the exemption. Consequently such documents must be cited on the international search report with the appropriate category indicated above and may also be considered in the written opinion of the International Searching Authority and during international preliminary examination.

Relationship Between Documents and Claims

Section 508

16.71 Each citation should include a reference to the claims to which it relates. If necessary, various relevant parts of the document cited should each be related to the claims in like manner (with the exception of “L” documents, see paragraph 16.69 and “A” documents, see paragraph 16.73). It is also possible for the same document to represent a different category with respect to different claims. For example:

X	WO9001867 A (WIDEGREN LARS (SE))	1
	8 March 1990 (1990-03-08)	
Y	* figure 1 *	2-5
A	* figure 2 *	6-10

The above example means that Figures 1 and 2 of the cited document disclose subject matter which prejudices the novelty or inventive step of claim 1, which prejudices the inventive step of claims 2-5 when combined with another document cited in the search report, and which represents non-prejudicial state of the art for the subject matter of claims 6-10.

Citation of the Documents

Section 503; WIPO Standard ST.14

16.72 Identification of any document should be made according to WIPO Standard ST.14. In the case of patent documents, this means the inclusion of:

(i) the industrial property office that issued the document, by the two-letter code (WIPO Standard ST.3);

(ii) the number of the document as given to it by the industrial property office that issued it (for Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document);

(iii) the kind of document, by the appropriate symbols as indicated on the document under WIPO Standard ST.16 or, if not indicated on that document, as provided in that Standard, if possible;

(iv) the name of the patentee or applicant (in capital letters and, where appropriate, abbreviated);

(v) the date of publication of the cited patent document (using four digits for a year designation according to the Gregorian Calendar) or, in case of a corrected patent document, the date of issuance of the corrected patent document as referred to under INID code (48) of WIPO Standard ST.9 and, if provided on the document, the supplementary correction code as referred to under INID code (15);

(vi) indications of the location of the most relevant cited material within the document, preferably by means of paragraph numbers or page and line numbers; where multiple renderings of the same document are published (e.g., PDF and HTML); it may also be necessary to indicate which version of the document is being referred to (WIPO Standard ST.14 also provides recommendations for best modes of identifying passages in cases where paragraph, page and line numbers are not well defined).

Rule 45bis.7(e)(i)

16.72.1 In the case of supplementary international search reports, an explanation may also be included with regard to why the citation is considered relevant. This is not intended to be as full an explanation as would be made in the written opinion which accompanies the main international search report, but aims to assist the reader in establishing the reason for which a document was cited, noting especially that many citations in supplementary international search reports may be in languages which might not be fully comprehended by the applicant or by designated and elected Offices. If this explanation can be made in a few words, such that it will not make the list of citations difficult to read, it should be included together with the main citation. If a longer explanation appears necessary, a separate sheet may be added for the purpose.

16.73 For “A” citations it is not necessary to indicate the relevant claims unless there is good reason to do so; for example where there is a clear lack of unity *a priori* and the citation is relevant only to a particular claim or group of claims or when the claims meet the criteria of novelty, inventive step, and industrial applicability under Article 33(2) to (4) and the “A” category citations represent the most relevant prior art.

16.74 The box on the second sheet of Form PCT/ISA/210 entitled “Further documents listed are in the continuation of Box C” is checked if more documents are cited than will fit in the space provided in Box C and therefore a continuation sheet is used.

16.75 The search report is published with the specification and distributed worldwide. To enable any reader in any country to consider the citation in the most convenient document/language, the known family members of each citation are normally listed in the patent family annex sheet of the international search report. The box on the second sheet of Form PCT/ISA/210 entitled “See patent family annex” is checked if a family

member listing is included with the report. Where INPADOC is used to check the family member, it should be noted that:

(a) INPADOC does not provide family listings for documents published prior to 1968;

(b) If INPADOC indicates there are no family members for a cited document then indicate this by entering the word “NONE” where the family members would appear. This indicates to the applicant that a search for family members has been carried out and there was a nil result; and

(c) If INPADOC indicates that none of the citations has a family member the “See patent family annex” box should still be checked and the practice indicated in the paragraph (b) above should be followed for all citations.

Finalization of the Report

Article 19; Rules 43.1, 43.2, 46.1

16.76 The identification of the International Searching Authority which established the international search report and the date on which the report was drawn up are indicated at the bottom of the second sheet of the international search report. This date should be that of the drafting of the report by the examiner who carried out the search. In addition to the date of actual completion, that is, the date on which the report was drawn up, of the international search, the international search report also indicates the date on which it was mailed to the applicant, which is important for the computation of the time limit for filing amendments to the claims under Article 19.

Rule 43.8; Section 514

16.77 Where the examiner is an authorized officer his name will appear on the search report. Where the examiner is not an authorized officer the name of the responsible examiner who will be supervising the report should be entered as the authorized officer. Where the examiner is an authorized officer then the date of actual completion will be the date of completion of the search report and he enters it on the search report. Where the examiner is not an authorized officer, the “date of completion” should be entered after the responsible officer has supervised the report and corrections, if any, have been made.

16.78 The report should be mailed within 3 months of receipt of the search copy or within 9 months from the priority date, whichever is later.

Copies of References Cited in the International Search Report

Rule 44.3

16.79 The International Searching Authority should preferably attach copies of all references cited to the copy of the international search report which is sent to the applicant. However, the preparation of such copies may be the subject of a separate request and payment of a separate fee for copies may be required. For the invitation for payment of fees Form PCT/ISA/221 may be used.

Article 20(3); Rule 44.3

16.80 The International Searching Authority or an agency responsible to it must send, upon request, copies of all references cited in the international search report to any

designated Office or the applicant. Such a request may be presented any time during seven years from the international filing date under the conditions laid down in Rule 44.3. Copies of the references cited may be transmitted with Form PCT/ISA/211.

Chapter 19

Examination Procedure Before The International Preliminary Examining Authority

General

19.01 The present chapter sets out the procedure before the International Preliminary Examining Authority with respect to international preliminary examination from the time such examination starts.

Article 33(1), (2), (3) and (4)

19.02 The objective of international preliminary examination of an international application is to formulate a preliminary and non-binding opinion as to:

- (i) whether the claimed invention appears to be “novel” (see chapter 12);
- (ii) whether the claimed invention appears to involve an “inventive step” (is non-obvious) (see chapter 13); and
- (iii) whether the claimed invention appears to be “industrially applicable” (see chapter 14).

Article 33(5); Rule 5.1(a)(iii)

19.03 Although these criteria serve as the basis for international preliminary examination, any Contracting State may apply additional or different criteria for the purposes of deciding whether or not, in that State, the claimed invention will be protected (that is, by a patent, an inventor’s certificate, a utility certificate or a utility model).

19.04 In addition to these basic three criteria, the examiner should be aware of the following two criteria that are implicitly contained in the Treaty and the Regulations:

- (i) the invention must be such that it can be carried out by a person skilled in the art (after proper instruction by the application); this follows from Article 5. See paragraphs 5.43 *et seq*;
- (ii) the invention must relate to a technical field (Rule 5.1(a)(i)), must be concerned with a technical problem (Rule 5.1(a)(iii)) and must have technical features in terms of which the subject matter for which protection is sought can be defined in the claim (Rule 6.3(a)) (see paragraph 5.04). The PCT does not require that a claimed invention be an advance over the prior art. However, advantageous effects, if any, may be relevant to determining “inventive step” (see chapter 13).

Articles 34(2)(c), 35

19.05 The results of the international preliminary examination, in the course of which one or more written opinions may be issued to the applicant by the International Preliminary Examining Authority and other communications with the applicant may occur, are given in an international preliminary examination report established by that Authority.

Start of, and Time Limit for, International Preliminary Examination

Article 31(2), (3) and (4)

19.06 Prior to the start of international preliminary examination of an international application, the applicant must, of course, have filed a demand (Form PCT/IPEA/401) that his international application be made the subject of an international preliminary examination. Chapter 18 gives details of the actions which take place on receipt of the demand before the examiner begins the international preliminary examination itself.

Start of Examination

Rule 69.1

19.07 The International Preliminary Examining Authority starts the international preliminary examination when it is in possession of the demand; if the applicant is required to furnish a translation under Rule 55.2, that translation; and of either the international search report and the written opinion established under Rule 43*bis*.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, provided that the International Preliminary Examining Authority does not start the international preliminary examination before the expiration of the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date unless the applicant expressly requests an earlier start, with the exception of the following situations:

(a) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes, start at the same time as the international search, provided that the examination is not to be postponed according to the statement concerning amendments.

(b) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned. These will be transmitted to the International Preliminary Examining Authority by the International Bureau. If a demand for international preliminary examination has already been submitted, the applicant should preferably, at the time he files the Article 19 amendments with the International Bureau, also file a copy of the amendments with the International Preliminary Examining Authority.

(c) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority does not start the international preliminary examination before:

- (i) it has received a copy of any amendments made under Article 19;
- (ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19; or

(iii) the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date;

whichever occurs first.

(d) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.

Rule 45bis.8(c) and (d)

19.07.1 Any supplementary international search reports which are transmitted to the Authority in sufficient time should be taken into account for the purpose of a written opinion or international preliminary examination report as if they were a part of the main international search report. On the other hand, supplementary international search reports do not need to be taken into account if they are received by the Authority after it has started to draw up an opinion or report.

...

[End of Annex and of Circular]