

CHAPTER 11 PCT: INTERNATIONAL SEARCH, INTERNATIONAL PUBLICATION AND INTERNATIONAL PRELIMINARY EXAMINATION; EPO AS ISA, AS SISA AND AS IPEA

11.1 International search

11.1.1 Objective of the international search

PCT Article 15 and Rules 33-34, 41

Topics	PCT	AG-IP	Other
Each IA is subject to international search	Art. 15(1)	7.001	
Objective of the international search is to discover relevant prior art	Art. 15(2), Rule 33.1		
- "relevant" if helpful to determine novelty and inventive step	Rule 33.1(a)	7.003	
- Written disclosures	Rule 33.1(a)-(b)	7.003	
- Published patent applications with earlier priority date	Rule 33.1(c)	7.003	
International search is made on the basis of the claims, with due regard to the description and the drawings (if any)	Art. 15(3), Rule 33.3		
Purpose of the search and the documents searched by the ISA	Art. 15(3), Rule 34	7.003, 7.004	
'International-type search'	Art. 15(5)		
- EPO as ISA	Art. 15(5)		GL/EPO B-II 4.5; OJ 2023 A5
Taking into account results of earlier search and classification	Rule 4.12, 41	5.073, 5.198	GL/PCT-EPO B-IV 1.1; EPG/EPO 2.21, 3.2.025
- Transmittal of documents	Rule 23 <i>bis</i>	5.073	

11.1.2 International Searching Authority

PCT Article 16 and Rules 35-38

Topics	PCT	AG-IP	Other
International search is carried out by the ISA	Art. 16(1)	7.002	
- Competent ISA(s)	Art. 16(2), Rule 4.14 <i>bis</i> , 35.2, 35.3	7.002	
ISA appointed by Assembly	Art. 16(3), 53		ISA-WIPO Agreement
- Minimum requirements for ISA	Art. 16(3)(c), Rule 36		
ISA establishes the title of the IA if it is missing or defective	Rule 37, 4.3, 44.2	7.022	GL/PCT-EPO H-III 7
ISA establishes the abstract of the IA if missing or defective	Rule 38, 8, 44.2	7.022	
- The applicant can propose to modify the abstract	Rule 38.3	5.174	

11.1.3 Subject-matter not required to be searched

PCT Article 17(2) and Rule 39

Topics	PCT	AG-IP	Other
ISA may refuse to search certain subject-matter	Art. 17(2)(a)(i), Rule 39	7.013	GL/EPO B-VIII 2
No meaningful search possible	Art. 17(2)(a)(ii)	7.014	
- Declaration that no ISR is established	Art. 17(2)(a)(ii)	7.014	
- Where only some of the claims are found to be 'unsearchable', ISA will search rest of IA and establish a partial ISR		7.014	
- Filing of amended claims is not allowed if ISA declares under Art. 17(2) that no ISR is established	Art. 19(1)	9.004	
- However, where a partial ISR has been established but the ISR also contains Art. 17(2)(b) declaration, amendments are allowed in relation to the claims that were searched		9.004	

11.1.4 Unity of invention before the ISA

PCT Article 3(4)(iii), 17(3) and Rule 40

Topics	PCT	AG-IP	Other
IA does not comply with the requirement of unity of invention	Art. 3(4)(iii), 17(3)(a), Rule 13	7.015	See also GL/PCT-EPO F-V for assessment of unity by EPO as PCT Authority
- Invitation to pay additional fees	Art. 17(3)(a), Rule 40	7.016-020	
- ISR established for the invention first mentioned in the claims and for those parts for which additional fees have been paid	Art. 17(3)(a)	7.018	
- Consequence of non-payment	Art. 17(3)(b)	7.021	
Applicant may protest against the payment of additional fees	Rule 40.2(c), (d)	7.019	
- Protest fee	Rule 40.1(iii), 40.2(e)	7.016, 7.020	
- Protest examined by review body in the framework of ISA	Rule 40.2(c)	7.019, 7.020	Rule 158(3) EPC; RFees Art. 2(1).21; GL/PCT-EPO B-VII 7.2 'three-member Review Panel'
- Protest fee refunded if protest was entirely justified	Rule 40.2(e)	7.016, 7.020	
Unity before IPEA			See § 11.8.6

11.1.5 Written opinion of the ISA

PCT Rule 43bis

Topics	PCT	AG-IP	Other
Written opinion of the ISA (WO-ISA) is a preliminary and non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable	Rule 43bis.1(a)	7.027	Very similar in scope to the written opinion established by the IPEA during IPE
- WO-ISA is established at the same time as the ISR	Rule 42	7.029	
Relevant date for determining prior art for written opinion	Rule 43bis.1(b) → Rule 64.1, Rule 65.2	7.028	Different from date for ISR
Invention is considered novel if it is not anticipated by the prior art	Rule 43bis.1(b) → Art. 33(2), Rule 64		
- Non-written disclosures	Rule 43bis.1(b) → Rule 64.2		
Invention is considered to involve an inventive step if it is not obvious to a person skilled in the art	Rule 43bis.1(b) → Art. 33(3), Rule 65		
Industrial applicability	Rule 43bis.1(b) → Art. 33(4)		
Applicant may submit “informal comments” on the WO-ISA	(No provision)	7.030	
- Informal comments should be sent to IB (not to ISA)	(No provision)	7.030	

11.1.6 International search report

PCT Article 18 and Rules 42, 43, 44, 45

Topics	PCT	AG-IP	Other
International search report (ISR)	Art. 18, Rule 43	7.023-026	
- Time limit for establishing the ISR	Rule 42.1	7.023, 7.029	
Contents of the ISR:	Rule 43	7.024	
- Classification of the invention; citation of the relevant documents; fields searched; remarks relating to unity of invention	Rule 43.3, 43.5-43.7	7.024	
Transmittal of the ISR and the WO-ISA to the IB and the applicant	Rule 44	7.025	
- Copies of the ISR (or the declaration) and the WO-ISA; title or abstract; copies of cited documents	Rule 44.1-44.3	7.025	
- IB will communicate the ISR to the designated Offices	Art. 20, Rule 47.1		
Translation of the ISR	Rule 45		

PCT Article 18 and Rule 44bis

Topics	PCT	AG-IP	Other
If no demand for international preliminary examination is filed, the WO-ISA forms the basis for the issuance by the IB of the IPRP Chapter I	Rule 44bis.1 → Rule 43bis.1	7.031-032	
- The report has the same contents as the written opinion established under Rule 43bis.1.	Rule 44bis.1(a)	7.031	
- Copy of the IPRP Chapter I is sent to the applicant and to all designated Offices	Rule 44bis.2	7.031	

11.2 The EPO acting as International Searching Authority

Article 152 EPC; PCT Articles 16-17

Topics	EPC	GL/PCT-EPO	Other
EPO as ISA	Art. 152	B-II	PCT Art. 16, 17; GL/EPO E-IX 1; EPG/EPO 3.1.006
- Representation before the EPO as ISA		A-VIII 1.7	PCT Art. 49; PCT Rule 90.1; EPG/EPO 3.1.020
Agreement between the European Patent Organisation and the IB of WIPO			OJ 2017 A115, OJ 2018 A24, OJ 2020 A35, OJ 2023 A37
- Languages of application, or translation, accepted for search		B-XI 2.2	EPG/EPO 3.1.015
- IA filed in Dutch at NL Patent Office as receiving Office		B-XI 2.2	EPG/EPO 3.1.019
- Translation for the purpose of international publication		B-XI 2.2	GL/PCT-EPO B-XI 2.2; EPG/EPO 3.1.015
Incorporation by reference of missing parts or elements		B-III 2.3.3	PCT Rule 20.5, 20.6; EPG/EPO 3.2.017
Incorporation by reference of correct elements and parts		B-III 2.3.3	PCT Rule 20.5bis, 20.6; EPG/EPO 3.2.018
Correct elements or parts notified after the start of the search		B-III 2.3.4	EPG/EPO 3.2.022
- Invitation to pay additional fee (one month)		B-III 2.3.4	PCT Rule 40bis; RFees Art. 2(1).2; GL/PCT-EPO B-III 2.3.4; EPG/EPO 3.2.022
PCT Direct applications		A-IV 1; B-IV 1.2	EPG/EPO 3.2.026
- Request for PCT Direct		B-IV 1.2	
- Applicant may submit informal comments on earlier search results		B-IV 1.2	EPG/EPO 2.20

Article 152 and Rule 158 EPC; PCT Article 17(3)

Topics	EPC	GL/PCT-EPO	Other
Search fee (for carrying out the international search)	(No provision)	A-III 4.3, 8.2	RFees Art. 2(1).2 → PCT Rule 16.1
- Fee reduction for national/resident in State (not party to EPC) with low income: 75%		A-III 8.2	EPG/EPO 3.1.024
- Fee reduction for national/resident of State in which a validation agreement with the EPO is in force: 75%		A-III 8.2	PCT Rule 18; EPG/EPO 3.1.025; also see § 7.2.2
Unity of invention		B-VII, F-V	PCT Art. 17(3)(a), Rule 40
- ISR established for the invention first mentioned in the claims		B-VII 2.3	EPG/EPO 3.2.013
- Same principles are followed in European and PCT procedures as far as assessment and reasoning for unity of invention is concerned		F-V 1	PCT Rule 13.1, 13.2; Art. 82, Rule 44(1) EPC; GL/EPO F-V
- Partial ISR is accompanied by a provisional opinion on the patentability of the invention		B-VII 2.3	EPG/EPO 3.3.013
- Invitation to pay additional (international) search fee for each further invention	Rule 158(1)	A-III 5.1; B-VII 2	RFees Art. 2(1).2
- Protest fee	Rule 158(3)	A-III 5.2; B-VII 6.3	RFees Art. 2(1).21
- Protest procedure conducted by three-member Review Panel	Rule 158(3)	B-VII 7	EPG/EPO 3.3.021
Subject-matter excluded from the international search		B-VIII	PCT Art. 17(2)(a)
- No meaningful search possible		B-VIII 3	EPG/EPO 3.3
ISR		B-X	
- WO-ISA		B-XI	EPG/EPO 3.2.005
- Search strategy		B-IV 3.1, B-X 3.4	EPG/EPO 3.2.012
- Copies of prior art attached to search report		B-X 11	EPG/EPO 3.2.011

11.3 Amendment of the claims after receiving the international search report

PCT Article 19 and Rule 46

Topics	PCT	AG-IP	Other
After receiving the ISR, the applicant is entitled to one opportunity to amend the claims	Art. 19(1)	9.004	
- Time limit: two months from the date of transmittal of the ISR or 16 months from the priority date	Rule 46.1	9.004	
- But considered in time if they reach the IB before the technical preparations are completed	Rule 46.1	9.004	
- Amendments must be filed at the IB	Rule 46.2		
When filing amendments to the claims under Art. 19, the applicant is required to submit:		9.004	
- Replacement sheet(s) containing a complete set of claims replacing the claims as filed	Rule 46.5	9.005	
- An 'accompanying letter' indicating the differences between the claims as filed and as amended plus the basis for the amendments in the IA as filed	Rule 46.5	9.006	
The amendment may be accompanied by a 'brief statement' explaining the amendment and indicating any impact it might have on the description and the drawings	Art. 19(1), Rule 46.4	9.007	
Amendments to the claims under Art. 19 are not allowed where the ISA has declared under Art. 17(2) that no ISR would be established		9.004, 7.014	
- However, where a partial ISR has been established but the ISR also contains a declaration under Art. 17(2)(b), amendments under Art. 19 are allowed in relation to the claims that were searched		9.004	
Amendments may not go beyond the disclosure in the IA as filed	Art. 19(2)	9.009	

11.4 Supplementary international search

PCT Rule 45bis.1

Topics	PCT	AG-IP	Other
In addition to the 'main international search', a supplementary international search may be carried by a SISA other than the ISA that carried out the main international search	Rule 45bis	8.001	EPG/EPO 3.4.002
- Only certain ISA's have indicated their preparedness to act as SISA	Rule 45bis.1(e), Rule 45bis.9	8.003	
Request for supplementary international search should be filed at the IB	Rule 45bis.1(a), (b)	8.006-008	EPG/EPO 3.4.012
- Time limit to file the request: 22 months from the priority date	Rule 45bis.1(a)	8.008	
- Correction of deficiencies in request; sanction if required correction is not filed	Rule 45bis.4(a), (d)	8.034, 8.036	
Withdrawal of the supplementary search request	Rule 90bis.3bis	11.058-059	See § 10.2.7

PCT Rule 45bis.2-4

Topics	PCT	AG-IP	Other
Supplementary search handling fee	Rule 45bis.2(a)	8.029	SoF 2
Supplementary search fee	Rule 45bis.3(a)	8.029	Fee is fixed by SISA
Fees must be paid to the IB	Rule 45bis.2(c), Rule 45bis.3(b)	8.029	
- Currency and amount of the fees	Rule 45bis.2(b), Rule 45bis.3(b)	8.031	
- Reduction of fees		8.029A	
- Refund of fees	Rule 45bis.2(d), Rule 45bis.3(d), (e)	8.032	
Time limit to pay the fees	Rule 45bis.2(b), (c), Rule 45bis.3(b), (c)	8.030	
If not complied in due time, the IB sends invitation to pay together with the late payment fee	Rule 45bis.4(c), (d)	8.030	

PCT Rule 45bis.5

Topics	PCT	AG-IP	Other
Start of supplementary international search	Rule 45bis.5(a)	8.024	
Basis of the supplementary international search	Rule 45bis.5(b)	8.039-042	
Scope of the supplementary international search	Rule 45bis.5(f)	8.043	

PCT Rule 45bis.6

Topics	PCT	AG-IP	Other
If the SISA finds that the IA does not comply with the requirement of unity of invention it will not invite the applicant to pay additional fees	Rule 45bis.6(a)	8.045	
- A SISR will be established for the invention first mentioned in the claims	Rule 45bis.6(a)	8.045	
- The applicant may request the SISA to review its opinion; period 1 month; payment of review fee	Rule 45bis.6(c), (d), (e)	8.045-046	RFees Art. 2(1).22

PCT Rule 45bis.7

Topics	PCT	AG-IP	Other
The SISR must be established within 28 months from the priority date	Rule 45bis.7(a)	8.047	
- Declaration that no SISR will be established	Rule 45bis.7(a), Art. 17(2)(a)	8.048	
Content of the SISR	Rule 45bis.7(d)	8.049	
- No written opinion is established		8.049	
- However, the report may contain 'explanations' with regard to the cited documents and the scope of the supplementary international search	Rule 45bis.7(e)	8.049	See § 11.5

PCT Rule 45bis.8

Topics	PCT	AG-IP	Other
The SISR (or the declaration that no SISR was established) is transmitted to the IB and to the applicant	Rule 45bis.8	8.051	
- IB will communicate the SISR to the designated Offices	Rule 45bis.8(b), 47.1(d)	8.051	
- If the applicant files a demand for international preliminary examination, the IB will transmit a copy of the SISR to the IPEA (unless the IPEA=SISA)	Rule 45bis.8(b), (c)	8.052	
The SISR is not published per se, but is available for public inspection		8.053	

11.5 The EPO as ISA carrying out supplementary international searches

Article 152 EPC; PCT Rule 45*bis*

Topics	EPC	GL/PCT-EPO	Other
EPO can act as SISA		B-XII	PCT Rule 45 <i>bis</i> .9; GL/EPO C-III 2.2; EPG/EPO 3.4
- Representation before the EPO as SISA		A-VIII 1.8	PCT Art. 49; PCT Rule 90.1; EPG/EPO 3.4.016-018
- Agreement between the European Patent Organisation and the IB of WIPO		B-XII 1; E-IX 1	OJ 2017 A115, OJ 2018 A24, OJ 2020 A35, OJ 2023 A37
Supplementary search handling fee	(No provision)		PCT Rule 45 <i>bis</i> .2 (pay to IB)
Search fee for the supplementary international search	(No provision)		RFees Art. 2(1).2 → PCT Rule 45 <i>bis</i> .3(a) EPG/EPO 3.4.012 (pay to IB)
- Fee reduction for natural persons who are a national/resident in State (not party to EPC) with: ...			EPG/EPO 3.4.013 → 3.1.024- 0263
- low income: 75%		A-III 8.3	EPG/EPO 3.4.013
- a validation agreement with the EPO: 75%		A-III 8.3	PCT Rule 18; also see § 7.2.2
The supplementary international search is conducted on the IA as originally filed taking account of the ISR and written opinion		B-XII 3	PCT Rule 45 <i>bis</i> .5(b); EPG/EPO 3.4.006
- Amendments filed under PCT Art. 19 and/or 34 are <i>not</i> taken into account		B-XII 3	PCT Art. 19, 34; EPG/EPO 3.4.007
If the EPO as SISA is of the opinion that the IA claims more than one invention, it will perform a search only for the invention first mentioned in the claims		B-XII 10, F-V	PCT Rule 45 <i>bis</i> .1(d), 45 <i>bis</i> .6(a); GL/EPO C-III 3.1; EPG/EPO 3.4.019
- If main ISA raised non-unity and applicant specifies another invention for SIS, EPO as SISA will take that into account			EPG/EPO 3.4.019
In procedure before EPO as SISA <i>no</i> written opinion is established			
- EPO will provide 'explanations' which are equivalent to WO-ISA established by the EPO as ISA		B-XII 7	PCT Rule 45 <i>bis</i> .7(e); GL/EPO C-IV 2; EPG/EPO 3.4.004
No supplementary European search report will be drawn up after EP entry if the EPO acted as SISA and established a SISR	Art. 153(7)		EPG/EPO 3.4.005; see § 12.2.14