

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

### 11.1 International search

#### 11.1.1 Objective of the international search

PCT Article 15 and Rules 33-34

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		
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)		GL/EPO B-II 4.5
Taking into account results of earlier search and classification	Rule 4.12, 23 <i>bis</i> , 41	5.073, 5.198	GL/PCT-EPO B-IV 1.1; EPG/EPO 3.2.019

#### 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	Art. 16(2), Rule 4.14 <i>bis</i> , 35.2, 35.3	7.002	
ISA appointed by Assembly	Art. 16(3), 53		
- 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 a declaration under Art. 17(2)(b) that certain claims were found unsearchable, amendments under Art. 19 are allowed in relation to the claims that were searched		9.004	

**11.1.4 Unity of invention**

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	
- 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, 40.2(e)	7.016, 7.020	
- Protest examined by review body 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	

### 11.1.5 Written opinion of the ISA

PCT Rule 43*bis*

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 43 <i>bis</i> .1(a)	7.027	
- Relevant date for determining prior art	Rule 44.1	7.028	
- WO-ISA is established at the same time as the ISR	Rule 42	7.029	
Applicant may sent comments on the WO-ISA to the IB	(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, 43.6, 43.7	7.024	
Transmittal of 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	
Translation of the ISR	Rule 45		

PCT Article 18 and Rule 44*bis*

Topics	PCT	AG-IP	Other
If no demand for international preliminary examination is filed, the written opinion forms the basis for the issuance by the IB of the IPRP Chapter I	Rule 44 <i>bis</i> .1	7.031-032	
- Copy of the report is sent to the applicant and to all designated Offices	Rule 44 <i>bis</i> .2	7.031	

## 11.2 The EPO acting as International Searching Authority

Article 152 and Rule 158 EPC

Topics	EPC	GL/PCT-EPO	Other
EPO as ISA	Art. 152	B-II	GL/EPO E-IX 1
- Representation before the EPO as ISA			PCT Art. 49; PCT Rule 90.1; EPG/EPO 3.1.020
Agreement between the European Patent Organisation and the IB of WIPO		E-IX 1	OJ 2017 A115, OJ 2018 A24, OJ 2020 xxx
- IA filed in Dutch at the Netherlands Patent Office		B-XI 2.2	EPG/EPO 3.1.019
PCT Direct applications		A-IV 1; B-IV 1.2	EPG/EPO 3.2.020
- Request for PCT Direct		B-IV 1.2.1	
- Processing of PCT Direct letters		B-IV 1.2.2	
Search fee (for carrying out the international search)	(No provision)	A-III 4.3, A-III 8.2	RFees Art. 2(1) 2 → PCT Rule 16.1
Unity of invention		B-VII	PCT Art. 17(3)(a), Rule 40
- ISR established for the invention first mentioned in the claims		B-VII 2.3	
- Partial ISR is accompanied by a provisional opinion on patentability		B-VII 2.3	EPG/EPO 3.3.013
- Invitation to pay additional (international) search fee for each further invention to be searched	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		B-VII 7	
Subject-matter excluded from the international search		B-VIII	
- No meaningful search possible		B-VIII 3	
ISR		B-X	
- WO-ISA		B-XI	
- Search strategy		B-IV 3.1, B-X 3.4	

### 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: 2 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		
The submission under Art. 19(1) should comprise:		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) that certain claims were found unsearchable, 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	