
PCT – Part B

Guidelines for Search

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Chapter I – Introduction

1. Purpose of Part B

Part B is drafted for and applies to searches and written opinions established by the EPO as ISA or SISA in the context of Chapter I of the Patent Cooperation Treaty (PCT).

2. The examiner

The examiner appointed to carry out the search and establish the written opinion normally works alone; at the discretion of the director, a prospective Examining Division can be appointed. *GL/ISPE 15.08-15.09*

2.1 Consultation with other examiners

Section B-I, 2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.2 Search Division consisting of more than one examiner

Section B-I, 2.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *GL/ISPE 15.08*

Chapter II – General

1. International search and written opinion under Chapter I

The procedure through which a PCT application proceeds from the filing of the application to the conclusion of the international phase comprises the international search and written opinion under Chapter I, which is mandatory for applicants, and the international preliminary examination under Chapter II, which is optional.

Art. 15

Art. 33

The objective of the international search is to discover the prior art which is relevant for the purpose of determining whether, and if so to what extent, the claimed invention to which the international application relates is or is not novel and does or does not involve an inventive step. The result of the search is communicated to the applicant in the form of an international search report. In some cases the International Searching Authority is not required to establish a search for some or all of the claimed subject-matter, e.g. because more than one invention is claimed or the application covers excluded subject-matter.

Art. 17

Rule 43

GL/ISPE 15 and 16

In its capacity as an International Searching Authority, the EPO is empowered not only to carry out the international search but also to formulate 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. When appropriate, an opinion will also be given on added subject-matter, unity, insufficient disclosure and clarity or support issues, as well as formal defects.

Rule 43bis

GL/ISPE 17

This opinion is sent to the applicant in the form of a written opinion of the International Searching Authority (WO-ISA) together with the search report. 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. 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 (PCT Chapter I).

Rule 44bis

GL/ISPE 2.18

The written opinion (and any informal comments filed by the applicant) will be made available to the public by the International Bureau at the same time as the international publication.

Art. 21(3)

Rule 48.2

GL/ISPE 2.17

The EPO is an International Searching and Preliminary Examining Authority for the vast majority of PCT contracting states. All applications are treated in the same manner irrespective of their country of origin.

Art. 16, 32

Rule 35, 59

GL/ISPE 1.13-1.14

Although the PCT procedure differs in some procedural and formal aspects from the European procedure, the criteria for search and examination with respect to novelty, inventive step, industrial applicability, unity, non-patentable subject-matter or exclusions, insufficient disclosure and clarity are in principle the same. This means that search and examination under the

PCT is carried out in the same way and applying the same quality standard as for a European application in so far as the same requirements are examined.

There is no difference between an international and a European search, either in respect of the method and thoroughness of the search or in respect of the sources of prior art searched.

2. Objective of the search

Art. 15

Rule 33

GL/ISPE 15.01

The objective of the international search is to discover the prior art which is relevant for the purpose of determining novelty and inventive step. The international search as such, thus, does not differ from a European search.

3. Search documentation

Rule 34

GL/ISPE 15.45-15.51

Section B-II, 3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4. Search report

Art. 18

Rule 43

GL/ISPE 16.01

An international search report is prepared containing the results of the search, in particular by identifying the documents constituting the relevant state of the art (see GL/PCT-EPO B-X, 9).

Rule 43bis.1

The search report is accompanied by a written opinion of the International Searching Authority (see GL/PCT-EPO B-XI).

5. Time limit

Rule 42.1, 43bis.1

GL/ISPE 2.13, 16.05

The time limit for establishing the international search report and the WO-ISA is three months from the receipt of the search copy by the ISA or nine months from the priority date, whichever occurs later. In practice this means that the search and the written opinion should be established no later than 16 months from the priority date.

6. Representation before the EPO as ISA or SISA

Art. 49 ~~PCT~~

Any agent or other person entitled to undertake representation before the receiving Office with which the international application was filed may represent the applicant throughout the international phase, including before the EPO as ISA or SISA (see GL/PCT-EPO A-VIII, 1.1). Depending on which office acted as receiving Office, such agent or other person may or may not be a professional representative or legal practitioner entitled to undertake representation under Art. -134 EPC.

Rule 90.1(b) ~~PCT~~

Rule 90.1(b-bis) ~~PCT~~

Representation before the EPO as ISA or SISA may also be undertaken by any agent (professional representative or legal practitioner) competent to act before the EPO and duly appointed for this purpose (see GL/PCT-EPO A-VIII, 1.7 and 1.8).

Chapter III – Characteristics of the search

1. Scope of the search

1.1 Completeness of the search

The scope of the international search is defined in Art. 15(4), stipulating that the International Searching Authority must endeavour to discover as much of the relevant prior art as its facilities permit and must, in any case, consult the documentation specified in the PCT Regulations (Rule 34). It follows from this definition ("as its facilities permit") that the scope of an international search is equivalent to that of a European search. International and European searches are thus fully identical in scope.

Art. 15(4)

Rule 34

See also ISPE Guidelines 15.18 and 15.20.

1.2 Effectiveness and efficiency of the search

Section B-III, 2.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 15.46-15.47

1.3 Search in analogous fields

Section B-III, 2.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 33.2(b), (c)

GL/ISPE 15.48-15.51

1.4 Search on the internet

Section B-III, 2.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 15.56-15.59

Concerning the dating of internet citations, see GL/PCT-EPO G-IV, 6.4.

2. The subject of the search

2.1 Basis for the search

The international search is carried out on the basis of the search copy of the application as transmitted to the ISA by the RO (see GL/PCT-EPO B-III, 2.3.1).

Art. 15(3)

Rule 33.3(a)

GL/ISPE 15.10

Concerning rectification of obvious mistakes and/or incorporation by reference of missing or correct parts or elements, see GL/PCT-EPO B-III, 2.3 and H-II, 2.2.2.

2.2 Interpretation of claims

Section B-III, 3.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 15.21-15.23

2.2.1 Claims with explicit references to the description or drawings

Although explicit references in the claims to features elucidated in the description or in the drawings are only permissible where "absolutely necessary", if claims contain such references, the examiner should strive to search these technical features as long as they are unambiguously defined by specific parts of the description.

Rule 6.2(a)

GL/ISPE 5.10, 16.30

However, where the reference does not clearly identify which subject-matter of the description and/or drawings is to be considered as included in the claim, the examiner may informally contact the applicant for clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3). In the special case of "omnibus claims" (e.g. a claim reading "The invention substantially as herein described"), no request for informal clarification should be issued, and subsequently the search report will be designated as complete.

The procedure above should be followed regardless of whether or not the reference to the drawings and/or the description is allowable according to Rule 6.2(a).

Where the reference does not appear to be justified, the examiner should raise an objection in the written opinion.

2.3 Obvious mistakes and missing or correct parts/elements

2.3.1 General considerations

Art. 19
Rule 91.1
GL/ISPE 15.10, 15.23

Since there is no right to amend the application until after the international search has been established, the international search must be carried out on the basis of the search copy of the application as transmitted to the EPO as ISA by the RO, except that obvious mistakes or formal matters which are contrary to the PCT and are called to the applicant's attention by the RO may be corrected (see also GL/PCT-EPO H-IV).

2.3.2 Request for rectification of obvious mistakes (Rule 91)

Rule 91

An applicant can request authorisation to rectify obvious mistakes in the international application (see GL/PCT-EPO H-IV, 2). The examiner (if the request relates to the description, claims or drawings) will have to assess whether such a request can be authorised according to the criteria set out in Rule 91 – see GL/ISPE 8.07-8.08. If RO has erroneously authorised such rectification, this may affect the search (see GL/PCT-EPO H-IV, 2.1).

Art. 19
GL/ISPE 15.10

If the changes requested by the applicant before the receipt of the ISR are not rectifications, but rather amendments, the examiner must refuse them, because there is no right to amend the application until after the international search report has been established. This applies even if the applicant refers to them as rectifications and even if they would be allowable amendments not adding subject-matter to the application as originally filed. For example, reformulation of claims, deletion of technical terms, deletion or limitation of claims and the taking of subject-matter from the description into the claims must all be refused at this stage regardless of whether or not they might be allowable, since they are not rectifications, but rather substantive amendments.

2.3.3 Incorporating missing parts or elements, or correct parts or elements, completely contained in the priority document

Rule 20.5

If applicants omit to file part(s) of the application and/or (an) entire element(s) thereof (i.e. all of the description and/or all of the claims), they may still furnish it (them) at a later date without affecting the international filing date, subject to the requirements of Rule 4.18 and Rule 20.6(a) and provided the missing part(s) and/or element(s) were completely contained in the priority document.

Similarly if applicants appear to have erroneously filed part(s) of the application and/or (an) entire element(s) thereof (i.e. all of the description and/or all of the claims), they may still furnish the correct part(s) and/or element(s) at a later date without affecting the international filing date, subject to the requirements of Rules 4.18 and 20.6(a) and provided the correct part(s) and/or element(s) were completely contained in the priority document (see GL/PCT-EPO A-II, 6).

Rule 20.5bis

The activity of the EPO as ISA depends on the decisions taken by the RO with regard to the international application and its filing date; see also GL/PCT-EPO A-II, 6. Therefore, in cases where the international application was corrected by the RO under Rule 20.5bis, the EPO as ISA will carry out the search on the basis of the international application including the correct element(s) and/or part(s) if:

- (a) the RO notifies it of the correct element(s) and/or part(s) before the start of the search; or
- (b) the RO notifies it of the correct element(s) and/or part(s) after the start of the search (including after its completion) and the applicant pays an additional fee equal to the search fee within one month of the date of the invitation to do so issued by the EPO (Rule 40bis.1 and Article 2(1) RFees) (see GL/PCT-EPO B-III, 2.3.4).

The examiner checks whether the RO's assessment of the "completely contained" criterion was correct (see GL/PCT-EPO H-II, 2.2.2). If the RO erroneously considered that the missing part(s) and/or element(s), or correct part(s) and/or element(s), were completely contained in the priority document, the search should be extended to include documents which would be relevant if the application were to be redated (such documents can be cited as "L" in the ISR).

See also GL/PCT-EPO B-XI, 2.1.

2.3.4 Correct elements or parts notified after the start of the search and additional fee

The RO may notify the ISA of correct part(s) and/or element(s) after the ISA has begun to draw up the international search report. In such cases, the EPO as ISA will invite the applicant to pay an additional fee equal to the search fee within one month of the date of the invitation (Form 208) (Rule 40bis.1 and Article 2(1) RFees).

OJ EPO 2020, A36

OJ EPO 2020, A81

If the EPO as ISA is notified of correct element(s) and/or part(s) after the search has started but before its completion and the additional fee is paid, the EPO will also complete the already initiated search and issue a non-official international search report and written opinion based on the international application as initially submitted. However, the non-official international search report and written opinion are issued only for the benefit of the applicant and any designated Offices which have given notice under Rule 20.8(b-bis) of an incompatibility. They therefore do not constitute the international search report under Rule 43 and written opinion under

Rule 43*bis*. The applicant thus has no obligation to respond to the non-official written opinion upon entry into the European phase.

Regarding the treatment in the European phase of correct element(s) or part(s) notified after the ISA has begun to draw up the international search report, please see Section C-III, 1.3 in the Guidelines for Examination in the EPO.

2.4 Anticipation of amendments to claims

Rule 33.3(b)
GL/ISPE 15.25

Section B-III, 3.5 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.5 Broad claims

GL/ISPE 15.26

Section B-III, 3.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.6 Independent and dependent claims

GL/ISPE 15.27

Section B-III, 3.7 in the Guidelines for Examination in the EPO apply *mutatis mutandis*.

2.7 Search on dependent claims

GL/ISPE 15.28

Section B-III, 3.8 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. See also GL/PCT-EPO F-IV, 3.3.

2.8 Combination of elements in a claim

GL/ISPE 15.31

Section B-III, 3.9 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.9 Different categories

GL/ISPE 15.32

Section B-III, 3.10 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.10 Subject-matter excluded from search

Art. 17(2)(a)
Rule 39
GL/ISPE 15.33

The examiner may exclude certain subject-matter from the search. These exclusions may result from the international application including subject-matter which the EPO as ISA is not required to deal with (see GL/PCT-EPO B-VIII, 2). They may also arise because the description, claims or drawings fail to meet a requirement, such as clarity or support of the claims by the description, to such an extent that no meaningful search can be carried out for all or some of the claims (see GL/PCT-EPO B-VIII, 3).

2.11 Nucleotide and amino acid sequences

Rule 5.2, 13*ter*.1
OJ EPO 2011, 372
~~OJ EPO 2013, 542~~
OJ EPO 2021, A96, A97
OJ EPO 2022, A60
GL/ISPE 9.39, 15.12
GL/ISPE 15.14A

If, after an invitation from the EPO as ISA according to Rule 13*ter*.1, the applicant has not submitted the sequence listing in the required format (in XML and complying with WIPO Standard ST.26) and in an accepted language and paid the late furnishing fee within the time limit set, the EPO as ISA will carry out the international search without the sequence listing to the extent that a meaningful search can be carried out (see also GL/PCT-EPO B-VIII, 3.2).

If, in addition to an ST.26-compliant sequence listing, another sequence listing is also filed in another format accepted for the filing of documents, only the sequence listing complying with ST.26 will be taken into account when searching the application.

2.12 Lack of unity

When the claims of the international application do not relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept, the applicant will normally be invited to pay additional search fees. If the applicant does not pay any additional search fees in response to the invitation, the international search will normally be restricted to those parts that relate to the invention, or so linked group of inventions, first mentioned in the claims. If additional fees have been paid within the prescribed time limit, those parts that relate to the inventions covered thereby are also searched. See also GL/PCT-EPO B-VII.

Art. 17(3)(a)
GL/ISPE 15.24

2.13 Technological background

Section B-III, 3.13 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 15.30

Chapter IV – Search procedure and strategy

1. Analysis of the application prior to searching

1.1 Taking into account results of an earlier search and classification

Applicants may request the ISA to take any earlier searches into account, including searches not carried out by the EPO.

*Rules 4.12, 12bis,
Rules 23bis.1, 41.1*

It may happen that the PCT application to be searched by the EPO as ISA is a "doublure" of a previous application. A later filed application is considered as a doublure when (i) the search report for the first application is issued by the EPO, (ii) the earlier application is claimed as priority, (iii) this priority claim is valid, and (iv) the later search report can at least partly be based on a search report of the earlier application.

Where the EPO can base the ISR on an earlier search that it has performed on an application whose priority is validly claimed for the international application, the international search fee paid will be refunded in part or in full depending upon the extent to which the EPO benefits from that earlier search. No refund is made if priority has not been validly claimed (see also GL/PCT-EPO A-III, 9.2).

*Rules 4.12, 12bis,
Rules 16.3, 41.1
OJ EPO 2009, 99
~~OJ EPO 2019,~~
A5 OJ EPO 2023, A5*

A request to take into account an earlier search not made by the EPO has no impact on the work of the examiner, who will do an independent full-scope international search. However, the documents cited in the earlier search report (which will be available in the file) might be useful. No refund is made for an earlier search that was not carried out by the EPO itself.

For international applications filed on or after 1 July 2017, in carrying out the international search, the EPO as ISA may take earlier search results into account where the applicant makes a request to that effect under Rule 4.12 as well as in the cases envisaged under Rule 41.2. This means that the EPO as ISA will also be able to take earlier search and classification results into account where the international application claims the priority of one or more earlier applications in respect of which an earlier search has been carried out by the EPO, or where the RO has transmitted to the EPO as ISA a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or (b), or where such a copy is available to the EPO as ISA in a form and manner acceptable to it.

*Rules 23bis.2 and
41.2*

1.2 PCT Direct applications

Under PCT Direct, an applicant filing an international application claiming priority from an earlier national, European or international application already searched by the EPO (i.e. a "doublure"; see GL/PCT-EPO B-IV, 1.1) is able to react to any objections raised in the search opinion drawn up for the priority application. This simplifies the assessment of the international application and adds to the value of the international search report and written opinion established by the EPO.

OJ EPO 2017, A21

1.2.1 Requests for PCT Direct

Applicants may request to have their international application processed under PCT Direct by filing a letter ("PCT Direct letter") containing informal comments aimed at overcoming objections raised in the search opinion established by the EPO for the priority application. Such informal comments are to be understood as arguments regarding the patentability of the claims of the international application and also possibly as explanations regarding any modifications to the application documents, in particular to the claims, in comparison with the earlier application. PCT Direct letters do not form part of the international application.

Upon receipt of a PCT Direct letter, the international application will be processed under PCT Direct only where the following two requirements are met:

- (a) the informal comments are filed together with the international application with the receiving Office in the form specified in GL/PCT-EPO A-IV, 1.2, and
- (b) the international application claims priority of an earlier application searched by the EPO (European, national or international first filing).

1.2.2 Processing of PCT Direct letters

PCT Direct letters filed with the receiving Office will be transmitted to the EPO as International Searching Authority and to the International Bureau of WIPO together with the search copy and record copy, respectively.

At the EPO as International Searching Authority, the examiner performing the international search will take informal comments filed under PCT Direct into account when preparing the international search report and written opinion, provided that they meet the requirements (a) and (b) listed in GL/PCT-EPO B-IV, 1.2.1 and that they are in the form specified in GL/PCT-EPO A-IV, 1.2.

The written opinion will reflect this by acknowledging the PCT Direct letter and addressing its content insofar as it is relevant to the international search procedure. The examiner, however, may make explicit reference to the earlier search opinion only if it is annexed to the PCT Direct letter.

In accordance with the PCT provisions on file inspection, PCT Direct letters will be available to the public on WIPO's PATENTSCOPE.

1.3 Third-party observations

For general information on third-party observations in the PCT phase, see GL/PCT-EPO E-II.

If the formalities officer forwards third-party observations to the examiner before a final report (ISR, SISR or IPER) is established, the examiner should consider them in the same way as in the European procedure (see GL/EPO E-VI, 3). However, given that under the PCT third-party observations should refer to novelty or inventive step only, their relevance will in most cases depend on the relevance of the prior-art documents in support of them. Any

document(s) provided to the examiner with the observations will either have been received from the IB or obtained by the formalities officer.

Third-party observations will normally not reach the examiner at the international search stage if the ISR is established and received by the IB on time, namely before publication of the application. However, this may happen when the international search is performed after an A2 publication.

If the third-party observations are relevant, the documents will be cited in the ISR and in section V of the WO-ISA. The examiner will take the third-party observations and the applicant's comments, if present, into account when drafting the WO-ISA. GL/ISPE 15.68

If the third-party observations are not relevant or not sufficiently understandable, the documents will not be included in the ISR. The examiner will insert a comment in section V of the WO-ISA indicating that the third-party observations have been taken into account and found not to be relevant or that the third-party observations could not be taken into account, together with the reasons.

1.4 Documents cited in the application

See ISPE Guidelines 15.37.

2. Search strategy

2.1 Subject of the search; restrictions

See ISPE Guidelines 15.41.

2.2 Formulating a search strategy

Section B-IV, 2.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. GL/ISPE 15.47

2.3 Carrying out the search; types of documents

Section B-IV, 2.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. GL/ISPE 15.52

2.4 Reformulation of the subject of the search

Section B-IV, 2.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. GL/ISPE 15.53

2.5 Closest prior art and its effects on the search

Paragraphs 1 to 3 of section B-IV, 2.5 in the Guidelines for Examination in the EPO apply *mutatis mutandis*.

See also ISPE Guidelines 15.60.

2.6 End of search

Section B-IV, 2.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. GL/ISPE 15.61

3. Procedure after searching

3.1 Preparation of the search report

Art. 18
Rule 43.5
GL/ISPE 15.67, 15.69
and 15.72
OJ EPO 2017, A106

Section B-IV, 3.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

An information sheet regarding the search strategy is systematically annexed to all international search reports, including partial search reports. If the application lacks unity of invention, the data contained in this sheet will only concern the invention(s) for which the search fee(s) has (have) been paid. The information sheet will contain certain details about the databases in which the examiner conducted the prior-art search, the classification symbols defining the extent of the search, and the keywords selected by the examiner or any other element relating to the invention to be searched and used to retrieve the relevant prior art. Upon publication of the international search report, the information sheet will be made available to the public via file inspection on WIPO's PATENTSCOPE and in the European Patent Register.

3.2 Amended international search report

It might happen that there was an error in the international search report and the applicant requests correction of that error. In such a case the examiner should consider issuing a corrected ISR (and possibly WO-ISA).

Further reasons for amending the international search report are indicated in ISPE Guidelines 15.74.

Chapter V – Preclassification and IPC classification of international patent applications

1. Definitions

Section B-V, 1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2. Preclassification (for file routing and distribution)

Section B-V, 2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.1 Incorrect preclassification

Section B-V, 2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3. IPC classification of the application

Section B-V, 3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 43.3
GL/ISPE 7.02-7.04
GL/ISPE 15.39

3.1 Amended classification of late-published search reports

See ISPE Guidelines 7.05.

3.2 IPC classification when the scope of the invention is not clear

Section B-V, 3.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 7.06, 7.08

3.3 IPC classification in cases of a lack of unity of invention

Section B-V, 3.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 7.07

3.4 Verification of the IPC classification

Section B-V, 3.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Chapter VI – The state of the art at the search stage

1. General

The general considerations relating to the state of the art with regard to the determination of novelty and inventive step are set out in GL/PCT-EPO G-IV.

2. State of the art – oral disclosure, etc.

According to Rule 33.1(a) and Rule 33.1(b), oral disclosure, use, exhibition, etc. are recognised as prior art only when this is substantiated by a written disclosure, contrary to Art. 54 EPC.

Rule 33.1(a), (b)

See also ISPE Guidelines 11.22 and 15.05.

Where a non-written disclosure occurs and both the non-written disclosure and the written account of it are published before the relevant date as defined in Rule 64.1(b), the examiner will cite the written account in the search report and give the date of the written disclosure on the search report. In this case, the written disclosure constitutes the prior art.

Rule 64.1(b)

If the written disclosure was made available to the public on or after the filing date of the international application concerned, the written disclosure will be cited in the international search report together with the date on which it was available, provided that the non-written disclosure was made available to the public prior to the filing date of the international application. The written opinion and the international preliminary examination report will draw attention to the non-written disclosure in Box No. VI (Certain documents cited).

Rule 64.2, 70.9

Where a non-written disclosure occurs but is not followed by any written account, it is not cited in the international search report, because it is not considered to be state of the art under the PCT. The examiner makes a note of this non-written disclosure and will reconsider its status if the application enters the European phase before the EPO (see GL/EPO B-VI, 2).

3. Priority

Section B-VI, 3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 11.02-11.03

4. Conflicting applications

4.1 Potentially conflicting European and international applications

Generally, where the international search is concluded less than eighteen months after the international filing date of the application, it will not be possible at the time of the search to make a complete search for potentially conflicting European and international applications. This search therefore has to be completed during the mandatory top-up search if a demand under Chapter II PCT has been made (see GL/PCT-EPO C-IV, 5) or alternatively at the examination stage by the Examining Division if the application enters the European phase before the EPO (see GL/EPO C-IV, 7.1).

4.2 National prior rights

Section B-VI, 4.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5. Date of reference for documents cited in the search report; filing and priority date**5.1 Verification of claimed priority date(s)**

Section B-VI, 5.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also ISPE Guidelines 11.02-11.03.

5.2 Intermediate documents

Section B-VI, 5.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.3 Doubts as to the validity of the priority claim; extension of the search

Section B-VI, 5.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also ISPE Guidelines 11.06.

5.4 Documents published after the filing date

Section B-VI, 5.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also ISPE Guidelines 11.11.

5.5 Non-prejudicial disclosures

Potentially non-prejudicial disclosures should be cited in the international search report. Whether the disclosure falls within Art. 55(1)(a) or (b) EPC will be investigated by the Examining Division after the application has validly entered the European phase.

See also ISPE Guidelines 16.76.

5.6 Matters of doubt in the state of the art

Section B-VI, 5.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also ISPE Guidelines 11.23 and 15.64-15.65.

6. Contents of prior-art disclosures**6.1 General remark**

Section B-VI, 6.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 51bis.1(a)(v)
Art. 55 EPC

6.2 Citation of documents corresponding to documents not available or not published in one of the official EPO languages

Section B-VI, 6.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

6.3 Conflict between abstract and source document

Section B-VI, 6.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

6.4 Insufficient prior-art disclosures

Section B-VI, 6.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

6.5 Incorrect compound records in online databases

Section B-VI, 6.5 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

7. Internet disclosures – technical journals

Section B-VI, 7 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also ISPE Guidelines 11.13.

Chapter VII – Unity of invention

1. General remarks

Unity is assessed in the same way in the PCT and European procedures. However, the consequences of a finding of lack of unity at the search and/or examination stages are different under the PCT, as are the actions to be taken by the examiner. In particular, the applicant may be asked to pay additional search and/or examination fees and may do so under protest.

Furthermore, divisional applications are not allowed under the PCT.

2. Lack of unity at the search stage

If the lack of unity finding is raised at the search stage, a search is conducted for the invention first mentioned in the claims and the applicant is invited to pay additional search fees with Form PCT/ISA/206 (hereafter referred to as "Form 206"). The applicant can then decide to:

Art. 17(3)(a)
Rule 13, 40.1
GL/ISPE 10

- (i) not pay any additional fees,
- (ii) pay some or all fees without protest or
- (iii) pay some or all fees under protest.

At the same time as completing Form 206, the examiner completes the provisional opinion accompanying the partial search results (EPO Form 1707) for the searched first invention. Form 206 and EPO Form 1707 are sent together to the applicant. The examiner must give a complete and self-contained reasoning for the lack of unity in EPO Form 1707.

OJ EPO 2017, A20

In the case of a doublure (see GL/PCT-EPO B-IV, 1.1) where the earlier application also lacked unity, the applicant should be invited to pay additional fees even if all inventions were searched in the earlier application. The amount refunded will then be decided for each invention separately.

3. No request for payment of additional search fees

Exceptionally it might be chosen not to request the applicant to pay additional search fees, even if an objection as to lack of unity occurs. This could be the case when the additional search effort for the other invention(s) is minor. In addition, no invitation to pay additional search fees should be issued when the other inventions are either not novel or do not possess an inventive step over the prior art at hand. However, it must be borne in mind that the written opinion under Chapter I must be written for all inventions that were searched, including those for which no additional search fees were requested. If additional search fees are not requested, for consistency reasons the examiner should not ask for additional examination fees should a demand for international preliminary examination under Chapter II be filed (see GL/PCT-EPO C-V, 3.3). Thus, when deciding on whether to ask for additional search fees, the examination effort for the whole procedure must also be taken into account.

If an objection of lack of unity has been raised but it was exceptionally chosen not to request the applicant to pay additional search fees, the ISR is issued for all inventions, indicating that the application lacks unity and listing the different groups of inventions. The WO-ISA is completed for all searched inventions. In Section IV of the WO-ISA, the examiner indicates that the requirement of unity is not fulfilled and that all claims have been searched and examined and provides full reasons on the separate sheet.

4. Cascading non-unity

If additional search fees are paid in response to an invitation to do so and the additional search(es) reveal(s) a further lack of unity "a posteriori", no further invitation to pay further additional search fees is issued.

If the applicant pays (an) additional search fee(s), a search is carried out for the invention(s) for which the search fee(s) has/have been paid.

If the search reveals that one or more of these inventions also lack unity "a posteriori", only the first invention of each of the groups of inventions is searched.

The WO-ISA will be drafted for all the searched inventions. Section III must be modified to cover the inventions actually searched. Under Section IV, full reasons must be given for all the non-unity objections raised. Under Section V an opinion as to novelty, inventive step and industrial applicability must be given for all searched inventions.

Claims not searched during the international phase can be prosecuted during the regional phase before the EPO in accordance with GL/EPO F-V, 7.1, as appropriate.

Example

A lack of unity objection is raised by the EPO acting as ISA, identifying four different inventions A, B, C and D. The first invention A is searched and the applicant is invited to pay further search fees for inventions B, C and D.

The applicant pays two further search fees for inventions B and C. During the additional search, B is found to lack unity "a posteriori" and is divided into the groups of inventions B1, B2 and B3.

In this case only B1 and C are searched, so in Section III of the WO-ISA the claims relating to inventions B2, B3 and D are indicated as not searched. In Section IV, full reasons must be given for why the claims of the application were divided into A, B, C and D and why B was further subdivided into B1, B2 and B3. Under Section V an opinion on patentability must be given for A, B1 and C.

Examination of the application in the European phase will be based on either A, B1 or C (see GL/EPO F-V, 7.1(iii)). For the claims relating to inventions B2, B3 and D, an invitation under Rule 164(2) EPC will be issued in accordance with GL/EPO F-V, 7.1(iv).

5. Documents relevant only to other inventions

The provisions of section B-VII, 1.3 in the Guidelines for Examination in the EPO apply *mutatis mutandis*.

6. Reply from the applicant to the invitation to pay additional search fees

6.1 No payment of additional search fees

If, after an invitation to pay additional search fees, the applicant does not do so, the file will not be returned to the examiner, but the final search report and the WO-ISA, which were already prepared by the examiner at the initial search stage, will be sent out by the formalities officer.

During the European phase, the applicant may still pursue claimed inventions which were not searched in the international phase upon invitation to pay search fees by the examining division. See GL/EPO C-III, 3.2.

6.2 Payment of additional search fees without protest

If, after an invitation to pay additional search fees, the applicant has paid additional search fees without protest, a complete search will be carried out for the inventions for which search fees have been paid and the ISR will be issued for these inventions. The WO-ISA will be drafted for the claims for which search fees have been paid. Section IV is to be filled out, and Section III must be modified to the actual payment of fees.

6.3 Payment of additional search fees under protest

In reply to Form 206, applicants may pay some or all of the additional fees under protest. If they do so, then this triggers the protest procedure for determining whether the request for payment of the additional fees was justified (see also GL/PCT-EPO B-VII, 7).

Rule 40.2(c)

GL/ISPE 10.66-10.69

If the applicant has paid additional search fees under protest and the Review Panel decided that the protest was fully or partly justified, the examiner will follow the decision of the Review Panel and will proceed to establish the ISR and WO-ISA for the inventions for which search fees have been paid. In the ISR the examiner will adapt the number of inventions and their definitions as well as the non-unity reasoning to be consistent with the decision of the review panel. In the WO-ISA, Section IV and the reasoning will be adapted to the decision of the Review Panel and Section III will be modified to the actual payment of fees. Under Section V an opinion as to novelty, inventive step and industrial applicability for all searched inventions will be given.

In the special situation where the protest was fully justified and where, as a consequence, the application is considered unitary, the examiner will follow the decision of the Review Panel and send a final ISR with no indication of non-unity. In Section IV of the WO-ISA the examiner will indicate that the requirement of unity of invention is complied with and that the search report has been established in respect of all parts of the application; no reasons need to be given on the separate sheet. Under Section V, an opinion as to novelty, inventive step and industrial applicability for all claims will be given.

If the applicant has paid additional search fees under protest and the Review Panel decided that the protest was not justified, the examiner will follow the decision of the Review Panel and proceed to establish the ISR and WO-ISA for the inventions for which search fees have been paid. In the ISR and the WO-ISA (Section IV) the examiner will indicate that the requirement of unity is not complied with. Section III will be modified to the actual payment of fees, and under Section V an opinion as to novelty, inventive step and industrial applicability for all searched inventions will be given.

The final ISR and WO-ISA will be sent out together with the decision on protest (Form PCT/ISA/212) in order to ensure that both are consistent.

See also below (GL/PCT-EPO B-VII, 7), for the protest procedure and the work of the Review Panel.

7. Protest procedure

The procedure consists of a review within the ISA first by the formalities officer in charge of the file and then by a Review Panel.

7.1 Admissibility of the protest as checked by the formalities officer

Before initiating the protest procedure the formal admissibility of the protest in the sense of Rule 40.2(c) (Chapter I) must be checked.

Rule 40.2(c) and 40.2(e)

GL/ISPE 10.66-10.67 and 10.69

To be admissible the protest should satisfy the following requirements:

- (a) The applicant must have paid the prescribed protest fee (Rule 40.2(e)), and
- (b) The payment under protest must be accompanied by a reasoned statement, i.e. the reasoned statement should have been filed with the payment or at the latest within the time limit set in Form 206.

The reasoned statement must comply with Rule 40.2(c); i.e. applicants should argue why the international application complies with the requirement of unity of invention or why the amount of the required additional fee is excessive. In the protest applicants should question the number of additional fees that they have been invited to pay, and not the amount of a single additional fee.

The payment of the protest fee and the filing of a purported reasoned statement are assessed by specially trained formalities officers. If the formalities officer finds any deficiencies, the applicant is informed of them by way of Form 212 or Form 224. Any substantive analysis is made by the Review Panel when assessing the justification of the protest (see GL/PCT-EPO B-VII, 7.2). If the applicant merely submits a statement of disagreement without reasoning, the Review Panel will refer to the reasoning contained in the invitation to pay additional search fees (Form 206) when taking its decision.

7.2 The work of the Review Panel

If the applicant pays the additional fees under protest and the protest is found admissible, the case is referred to the director to appoint a three-member Review Panel, which comprises the examiner in charge, an examiner as chairperson of the Review Panel and a further examiner. This Review Panel will, in case of entry into the European phase, constitute the Examining Division. The names of the members of the Review Panel are made public on Form 212.

GL/ISPE 10.68
OJ EPO 2015, A59
OJ EPO 2010, 322

The Review Panel is appointed from the moment that the protest is found admissible. Its purpose is to determine, on the basis of the protest, whether the request for payment of additional fees by the examiner was justified on the basis of the reasoning given (see W 11/93). The review does not allow a re-evaluation to determine possible additional grounds for lack of unity (see W 9/07, Reasons 2.8).

The scope of the review is limited to those inventions for which additional fees have been paid. If the applicant's reasoning is not related to those inventions, the Review Panel will come to the conclusion that the protest is not or is only partially justified, depending on the case.

If the Review Panel determines that the protest is wholly justified, it will inform the applicant with Form 212 (Decision on Protest Chapter I). This also applies if the Review Panel's finding results in the application not lacking unity. It is not necessary to give any reasons unless the Review Panel decides that such reasoning would be beneficial. Furthermore, the Review Panel will order the reimbursement of all the additional fees and the protest fee. The search will be carried out and the written opinion established for the inventions for which the fees are paid (see GL/PCT-EPO B-VII, 6.3).

GL/ISPE 10.70

If the Review Panel considers that the protest is not justified at all, it will communicate this to the applicant using Form 212. Reasoning must be given, indicating why the request for payment of additional fees is upheld and addressing the applicant's relevant arguments. The search will be carried out and the written opinion established for the inventions for which the fees are paid (see GL/PCT-EPO B-VII, 6.3).

If the Review Panel considers that the protest is only partially justified, it will communicate this to the applicant using Form 212. Reasoning must be given, indicating why the request for payment of additional fees is partially upheld and addressing the applicant's relevant arguments. The search will be carried out and the written opinion established for the inventions for which the fees are paid (see GL/PCT-EPO B-VII, 6.3). The Review Panel will order the reimbursement of the corresponding additional fees but not the protest fee.

The formalities officer will send the decision of the Review Panel to the applicant and the IB. The decision on protest (Form 212) will be sent out together with the final ISR and WO-ISA in order to ensure that both are consistent.

After an invitation to pay additional search fees, the applicant may pay all of the additional fees under protest. If the Review Panel confirms the initial finding of lack of unity by finding the protest not justified, and if the application enters the European phase with unamended claims, the Examining Division will, as a rule, confirm the lack of unity and request the applicant to limit the claims to one invention and to file (a) divisional application(s) for the other invention(s). Alternatively, the applicant may amend the claims to render them unitary.

See also GL/EPO C-III, 3.4.

8. Lack of unity and incomplete search

The procedures for dealing with cases which lack unity and where in addition a meaningful search is not possible are dealt with in GL/PCT-EPO B-VIII, 3.6.

Rule 13

Art. 17(2)(a)(ii)

Art. 17(3)(a)

Chapter VIII – Subject-matter to be excluded from the search

1. General remarks

The aim of the EPO as ISA is to issue international search reports which are as complete as possible. Nevertheless, there are situations in which the search report and the written opinion cover only part of the subject-matter claimed, or in which no search report is issued. This may be either because the international application includes subject-matter which the ISA is not required to deal with (see GL/PCT-EPO B-VIII, 2) or else because the description, claims or drawings fail to meet a requirement, such as clarity or support of the claims by the description, to such an extent that no meaningful search can be made of all or some of the claims (see GL/PCT-EPO B-VIII, 3). Applications of the latter kind are often referred to as "complex applications".

GL/ISPE 9.01

The same approach is taken as for European applications.

In principle, a declaration of no search under Art. 17(2)(a)(ii) should remain an exception. Under the PCT, even if the applicant amends the claims to overcome the objection, an additional search is not possible. When a declaration of no search is issued, the search must be performed at the examination stage without requesting an additional fee if the international application enters the European phase before the EPO and if the objection leading to the declaration has been overcome (GL/EPO C-IV, 7.3). Therefore, at least some effort should be made to carry out a meaningful search of at least part of the claimed subject-matter.

Art. 17(2)(a)(ii)
GL/ISPE 9.40

2. Subject-matter which the ISA is not required to search and examine

Art. 17(2)(a)(i) and Art. 34(4)(a)(i) together with Rules 39 and 67.1 are the equivalents of Art. 52(2), (3) and 53(b), (c) EPC concerning the exclusion from patentability of non-technical inventions, programs for computers, methods of doing business, medical methods and the exception to patentability for plant or animal varieties or essentially biological processes for the production of plants and animals, respectively. Since the PCT procedure does not lead to a grant, subject-matter which would be excluded from patentability under the EPC is identified as subject-matter for which the ISA and/or the IPEA is not required to carry out search and international preliminary examination.

Art. 17(2)(a)(i)
Art. 34(4)(a)(i)
Rule 39
Rule 67.1
GL/ISPE 9.02-9.15

The criteria applied for the decision not to perform an international search are the same as for the European procedure. This means that the discretion of an ISA not to search subject-matter set forth in Rule 39.1 is exercised by the EPO as ISA only to the extent that such subject-matter is not searched under the provisions of the EPC.

For subject-matter which the ISA is not required to search under Art. 17(2)(a)(i) and where, as a consequence, an incomplete search report will be issued, the restriction should always be indicated both in the search report and in the WO-ISA.

GL/ISPE 9.40

Where the subject-matter of all claims constitutes a subject excluded from the search, a declaration of non-establishment of the international search report is issued pursuant to Article 17(2)(a) on Form PCT/ISA/203, indicating the reasons. A written opinion is established, even though, in the absence of a search, it cannot address the questions of novelty and inventive step and may not be able to address other questions, such as that of industrial applicability. The written opinion should contain full reasoning as to why the search is not possible.

2.1 Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body

Rule 39.1(iv)

GL/ISPE 9.08-9.10

Claims directed to medical treatment which would fall under the exceptions to patentability under Art. 53(c) EPC should, in principle, also be exempted from international search.

Yet the EPO as ISA applies the same practice as for European applications, and the examiner will explain so in the WO-ISA.

In the table below, several types of claim involving a composition A or substance X in methods of treatment or diagnosis (hereinafter referred to as medical treatment) are listed. Depending on the situation, some of these could be patentable in an EP application (see also [GL/EPO G-VI, 6.1](#) ~~GL/EPO G-VI, 7.1~~).

	Claim wording	Excluded from patentability according to Art. 53(c) EPC
a	compound X for use as a medicament	NO
b	compound X for use in treating disease Y	NO
c	composition A containing X for use in treating disease Y (composition A may be generally defined)	NO
d	medicament containing compound X	NO
e	use of X in a composition A for the treatment of disease Y	YES
f	use of X as a medicament for the treatment of disease Y	YES
g	use of X for the treatment of disease Y	YES
h	use of X for preparing a medicament	NO

	Claim wording	Excluded from patentability according to Art. 53(c) EPC
i	use of X for the manufacture of a medicament for treating disease Y	NO
j	process for the preparation of a medicament for treating disease Y using compound X as an active ingredient	NO
k	method of treatment of disease Y using X	YES

For claims of type (a), (b) or (c), the examiner will search and examine the claims and assess the novelty and inventive step of the indicated uses, as is the case for an EP application. In the WO-ISA, a remark will be added that novelty and inventive step have been assessed according to EPO practice. The reason for adding this remark is that under Art. 54(4) and (5) EPC it is possible to obtain patent protection for any substance or composition comprised in the state of the art, for any use or specific use, respectively, in a (medical) method referred to in Art. 53(c) EPC, provided that such use is not comprised in the state of the art. Claims seeking this kind of protection may be drafted as "Substance X for use as a medicament/for use in therapy" or "Substance X for use in the treatment of disease Y", respectively. See also [GL/EPO G-VI, 6.1](#) ~~GL/EPO G-VI, 7.1~~.

For claims of type (d) or (h), the examiner will search and examine the claims and assess the novelty and inventive step thereof, as is the case for an EP application. In the WO-ISA, a remark will be added that novelty and inventive step have been assessed according to EPO practice.

For claims of type (i) or (j), the examiner will search and examine the claims and assess the novelty and inventive step of the indicated uses. In the WO-ISA, a remark regarding EPO practice with regard to such claims will be added.

For claims of type (e), (f), (g) or (k), in the vast majority of cases, a search report is established on the basis of the alleged effects of the product/composition, because their subject-matter can readily and in a straightforward manner be understood in terms of these effects. For reasons of efficiency an opinion on novelty, inventive step and industrial applicability will be given for (at least) the independent claims, as far as relating to the alleged effects of the compound/composition, as would be done for an EP application. A reservation concerning patentability will be added, indicating that at the EPO claims directed to a method of treatment or the use of a composition in a treatment are exempted from patentability, but that a claim directed to a composition or substance for such use would be admissible.

Rule 33.3(b)

In some cases, no search report can be established for claims of type (e), (f), (g) or (k), because their subject-matter cannot readily and in a straightforward manner be understood in terms of the alleged effects of the

compound/composition. For these claims, no assessment under Art. 33(1), i.e. novelty, inventive step and industrial applicability, will be carried out.

2.2 Subject-matter according to Rules 39.1(i), (iii), (v) and (vi)

Section B-VIII, 2.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

The EPO applies options A9.07[2] and A9.15[2] of the Appendix to Chapter 9 of the ISPE Guidelines.

2.2.1 Computer-implemented business methods

OJ EPO 2018, A24
OJ EPO 2017, A115
OJ EPO 2014, A117
OJ EPO 2007, 592
GL/ISPE 9.07

As a result of an amendment to the Agreement between the EPO and WIPO under the PCT, any national or resident of the United States of America filing an international application on or after 1 January 2015 with the United States Patent and Trademark Office (USPTO) or the IB as receiving Office will be able to select the EPO as ISA irrespective of the technical field in which the application is classified. It should, however, be noted that the Notice from the EPO dated 1 October 2007 concerning business methods remains applicable. Therefore, the EPO as ISA will, in all cases where the subject-matter of the international application involves technical means, consider the application and to the extent possible provide a search report for those parts of it which are more than mere business methods.

Section B-VIII, 2.2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3. No meaningful search possible

The meaning of the word "meaningful" in the context of Art. 17(2)(a)(ii) is essentially a matter for the examiner to decide. The examiner's finding may change in the light of any reply from the applicant to the invitation for informal clarification, if available (see GL/PCT-EPO B-VIII, 3.3 and 3.4). The exercise of the examiner's discretion will depend upon the facts of the case.

GL/ISPE 9.01

The term "meaningful search" in Article 17(2)(a)(ii) should be read to include a search that within reason is complete enough to determine whether the claimed invention complies with the substantive requirements, that is, the novelty, inventive step, and industrial applicability requirements, and/or the sufficiency, support and clarity requirements of Articles 5 and 6. Accordingly, a finding of "no meaningful search" should be limited to exceptional situations in which no search at all is possible for a particular claim, for example where the description, the claims or the drawings are totally unclear. To the extent that the description, the claims or the drawings can be sufficiently understood, even though parts of the application are not in compliance with the prescribed requirements, a search should be performed recognising that the non-compliance may have to be taken into account for determining the extent of the search.

As there is no legal provision providing that an applicant must formulate the application in such a way as to make an economical search possible, "reasons of economy" cannot be used as a reason, or part of a reason, for issuing an incomplete search report.

3.1 Examples of impossibility to perform a meaningful search over the whole of the claimed scope

A number of non-limiting examples will illustrate where a restriction of the search may find application:

- (i) claims lacking support; insufficient disclosure

Art. 5 and 6

One example would be a claim so broadly formulated that at least part of its scope is speculative, i.e. not supported by the disclosure of the application. In this case the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, and a meaningful search can be performed only on the basis of the narrower, disclosed invention, for example only on the basis of that part of the claim which is supported. In extreme cases, this may mean a search directed to only one or more of the specific examples disclosed in the description. The examiner should bear in mind that the requirements under Art. 5 and 6 concerning sufficiency of disclosure and support should be seen from the perspective of the person skilled in the art.

- (ii) claims lacking conciseness

An example would be where there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is sought (for the case of multiple independent claims in the same category see GL/PCT-EPO B-VIII, 4). A complete search (or any search at all) may de facto be impossible.

*Art. 6
Rule 6.1(a)
GL/ISPE 9.25 and
9.30*

It is noted that the EPO allows multiple dependent claims, provided that they do not detract from the clarity of the claims as a whole and that the arrangement of claims does not create obscurity in the definition of the subject-matter to be protected (see also GL/PCT-EPO F-IV, 3.4). In case of unclarity, it may be appropriate for the examiner to first invite the applicant for informal clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3-3.6).

*Rule 6.4(a)
GL/ISPE 9.41*

- (iii) claims lacking clarity

An example would be where the applicant's choice of parameter to define the invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all. In such a case, the parameter chosen by the applicant may lack clarity (see Art. 6; cf. GL/PCT-EPO F-IV, 4.11). It may be that the lack of clarity of the parameter is such as to render a meaningful search of the claims or of a claim or of a part of a claim impossible, because the choice of parameter renders a sensible comparison of the claimed invention with the prior art impossible. If so, the search may possibly be restricted to the worked examples, as far as they can be understood, or to the way in which the desired parameter is obtained.

GL/ISPE 9.22

In all examples listed above, the examiner may where appropriate informally invite the applicant to provide clarification of the claimed subject-matter (see GL/PCT-EPO B-VIII, 3.3).

See ISPE Guidelines 9.01 and 9.19-9.30 for further information.

3.2 Nucleotide and amino acid sequences

If the sequence listing of an international application is not available or does not comply with WIPO Standard ST.26 (see Annex C to the Administrative Instructions, paragraph 4), the EPO as ISA will invite the applicant to furnish a sequence listing complying with the standard or a translation in the form of a new sequence listing in a language acceptable to it, as the case may be, and pay a late furnishing fee, and to perform these steps within a non-extendable time limit of one month from the date of the invitation.

If, within the time limit set, the applicant has not submitted an ST.26-compliant sequence listing and paid the late furnishing fee, the EPO as ISA will carry out the international search without the sequence listing to the extent that a meaningful search can be carried out.

The examiner when performing the search will either:

- (i) issue a declaration under Art. 17(2)(a)(ii) and Rule 13ter.1(d) that no meaningful search on any claimed subject-matter is possible due to the failure of the applicant to comply with Rule 5.2 (no sequence listing) and/or Rule 13ter.1(a) (no computer-readable sequence listing);

or

- (ii) issue an incomplete search report with a declaration under Art. 17(2)(b) and Rule 13ter.1(d) that a meaningful search is not possible in respect of certain claimed subject-matter due to the failure to comply with Rule 5.2 (no sequence listing) and/or Rule 13ter.1(a) (no computer-readable sequence listing).

This also has consequences for the international preliminary examination procedure before the EPO as IPEA (see GL/PCT-EPO C-VIII, 2.1).

3.3 Informal clarification

Where the description, claims or drawings fail to comply with a requirement, such as clarity or support of the claims by the description, to such an extent that no meaningful search can be made, the examiner may informally contact the applicant to clarify specific aspects of the application before the search is carried out. Such informal clarification may help the examiner to focus the search better. It is highly recommended to invite the applicant to provide such informal clarification before issuing an incomplete ISR or a declaration of no search. However, there is no legal obligation on the examiner to use it and no legal consequences in the PCT if the applicant does not respond. An incomplete search report or a declaration of no search may still be issued without prior clarification.

Rule 5.2, 13ter.1
 OJ EPO 2011, 372
~~OJ EPO 2013, 542~~
 OJ EPO 2021, A96
 OJ EPO 2021, A97
 OJ EPO 2022, A60
 GL/ISPE 9.39
 GL/ISPE 15.14A

GL/ISPE 9.34, 9.35
 OJ EPO 2011, 327

Informal clarification may take the form of a telephone consultation or of a written request (Form PCT/ISA/207) ~~sent by fax~~. In both cases the applicant can be given a short time limit (normally two weeks) to respond. ~~In view of the short time limits in the PCT, a telephone consultation, for which minutes must be written, may be more appropriate. If the issues at stake can be clarified during the telephone consultation, no time limit will be given. The examiner will send the minutes of the consultation for information and will prepare the ISR and WO-ISA taking the result of the consultation into account.~~

~~Alternatively, a written request for clarification can be sent by fax. This is in particular appropriate when dealing with non-European representatives due to potential time zone differences and linguistic problems, and/or when the issue to be discussed is not suitable for a telephone consultation.~~

Any reference to the "applicant" in GL/PCT-EPO B-VIII, 3.3.1 and GL/PCT-EPO B-VIII, 3.3.2 includes any duly appointed agent.

3.3.1 Informal clarification by telephone

In view of the short time limits in the PCT, a telephone consultation, for which minutes must be written, may be more appropriate. If the issues at stake can be clarified during the telephone consultation, no time limit will be given. If not, the short time limit referred to in GL/PCT-EPO B-VIII, 3.3 will be set. In the former case, the examiner will send the minutes of the consultation for information and will prepare the ISR and WO-ISA taking the result of the consultation into account. In the latter case, the examiner will send minutes setting the time limit, and wait for this time limit to expire before preparing the ISR and WO-ISA. They will take into consideration any on-time reply received from the applicant.

Where the applicant is registered for ~~with~~ the EPO M~~m~~ailbox service and/or ~~with~~ PCT-Link, the minutes will be sent to the M~~m~~ailbox. Where the applicant is not so registered and the minutes set a time limit for reply, they are sent by regular mail and an ~~informative~~ email is also sent to the applicant to inform them accordingly. If an email address for the applicant is not available, the EPO acting as ISA may contact them by telephone to request one. Only if ~~this~~ one is provided will an ~~informative~~ email be sent. Where the applicant is not registered ~~with~~ for the EPO M~~m~~ailbox service and/or ~~with~~ PCT-Link and the minutes do not set a time limit for reply, the minutes are sent by regular mail and no ~~informative~~ email is sent.

The EPO no longer issues urgent notifications by fax. ~~As such,~~ The minutes of ~~a~~ ~~this~~ telephone consultation will therefore no longer be communicated by ~~this means~~.

OJ EPO 2023, -A15

3.3.2 — Informal clarification by written request

Alternatively, a written request for clarification can be sent. This is in particular appropriate when dealing with non-European representatives due to potential time zone differences and linguistic problems, and/or when the issue to be discussed is not suitable for a telephone consultation.

OJ EPO 2023, -A/15

Where the applicant is registered ~~with~~for the EPO M~~mail~~box service and/or ~~with~~-PCT -Link, the written request will be sent to the M~~mail~~box. Where the applicant is not so registered, ~~then~~the written request is sent by regular mail and an ~~informative~~-email is also sent to the applicant to inform them accordingly. If an email address for the applicant is not available, the EPO acting as ISA may contact them by telephone to request one. Only if ~~this~~one is provided will an ~~informative~~-email be sent.

OJ EPO 2011, 327

The EPO no longer issues urgent notifications by fax. ~~As such, a~~An informal written request for clarification will therefore no longer be communicated by ~~this means~~.

3.4 Reply to the invitation for informal clarification

3.4.1 Failure to reply in time or no reply

If the applicant does not reply within the set time limit to the invitation for informal clarification, the examiner will prepare the search report and WO-ISA to the extent possible without the requested clarification.

If the applicant replies after the time limit has expired, and the search report has not yet been established, the reply should be taken into account; if the search report has already been established the reply will not be taken into account

3.4.2 Reply in time

If the applicant replies to the invitation for informal clarification, the examiner will prepare the search report and WO-ISA taking the reply into account.

3.5 The content of the WO-ISA after an invitation for informal clarification and/or in case of a restriction of the search

Art. 17(2)(b)

Generally, a restriction of the search will not always be indicated in the international search report. Rather the extent of the search as well as the reasons for the restriction will in many cases only be indicated in the WO-ISA, as explained below. The opinion given is normally restricted to what has actually been searched.

If after clarification a complete search can be made, the ISR will be designated as complete. Any outstanding clarity problem will be mentioned in Box VIII of the WO-ISA.

Art. 17(2)(b)

If only some of the claims and/or parts of the claims can be searched and it is not possible, on the basis of the description, to foresee a likely fallback position for the unsearched subject-matter, even taking any reply from the applicant into consideration, a precise indication of what has been searched with the corresponding claims, together with full reasoning why the search was restricted, are entered into both the ISR and the WO-ISA. In addition, in the WO-ISA an opinion as to novelty, inventive step and industrial applicability of the searched subject-matter must be given.

If some claims or parts of claims cannot be searched but it is possible, on the basis of the description, to foresee a searchable fallback position, taking any possible reply from the applicant into consideration, the ISR will be filled out

as for a complete search in respect of those claims. An indication which claims have been searched (in part), together with full reasoning why the search was restricted, and a precise indication of what has been searched are entered into the WO-ISA. In the ISR the cited documents will relate to the searched (or partially searched) claims only. In addition, in the WO-ISA an opinion as to novelty, inventive step and industrial applicability of the searched subject-matter must be given.

If, even taking any reply from the applicant into consideration, it is not possible to perform a search at all, a declaration of no search, together with full reasoning why, is issued instead of the ISR. The WO-ISA must contain full reasoning why the search is not possible.

Art. 17(2)(a)(iii)

A restriction of the search due to exceptions mentioned in Rule 39 (e.g. medical treatment claims) must always be indicated in the search report.

Rule 39

3.6 Combination of an incomplete search and lack of unity

The requirements of unity of invention and the requirements of Art. 17(2)(a)(ii) are separate requirements. However, it is possible that an application both violates the requirements of clarity, disclosure, support or conciseness to such an extent that a meaningful search cannot be carried out, and lacks unity. In that case, the examiner can combine an incomplete search and a finding of non-unity. However, the applicant should not be invited to pay additional fees for subject-matter which will later not be searched under Art. 17(2)(a)(ii). Typically, a non-unity objection could be made first and then an incomplete search applied to the searched invention. In such a case the examiner may send an informal clarification request for the first invention only and include in the invitation to pay additional fees remarks on clarity problems related to further inventions.

Rule 13

Art. 17(2)(a)(ii)

However, if the complexity lies in lack of clarity, the search will be restricted first, and the non-unity objection applied to the clear parts of the claimed subject-matter.

4. Multiple independent claims per category

Multiple independent claims in one category are per se not a reason for an incomplete search

GL/ISPE 5.13-5.14

Generally, an opinion must be given on all searched claims. Only one independent claim in each category needs to be treated in detail; short comments would normally suffice for further independent claims.

Furthermore, if appropriate, an objection as to clarity and conciseness under Article 6 may be made under Box VIII of the WO-ISA. The EPO as ISA may exercise its discretion to ask the applicant to clarify the subject-matter to be searched, applying the same procedure as described under GL/PCT-EPO B-VIII, 3.3 – GL/PCT-EPO B-VIII, 3.4.

Chapter IX – Search documentation

1. General

1.1 Organisation and composition of the documentation available to the Search Divisions

Section B-IX, 1.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

1.2 Systematic access systems

Section B-IX, 1.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2. Patent documents arranged for systematic access

2.1 PCT minimum documentation

Section B-IX, 2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 34.1(b)(i), (ii) and (c)

2.2 Unpublished patent applications

Since the search for conflicting applications that are not published at the time of the initial search is completed either during Chapter II in case a demand is filed or during the European phase, the documents which can be cited in the search report do not include unpublished patent applications (see GL/PCT-EPO B-VI, 4.1).

2.3 Search reports

Section B-IX, 2.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.4 Patent family system

Section B-IX, 2.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3. Non-patent literature arranged for systematic access

3.1 Periodicals, records, reports, books, etc.

Section B-IX, 3.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4. Non-patent literature arranged for library-type access

Section B-IX, 4.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Chapter X – Search report

1. General

The results of the search will be recorded in an international search report. A number of different possible limitations of the scope of the search report exist. These are:

- (i) a declaration issued instead of the search report according to Art. 17(2)(a) (see GL/PCT-EPO B-VIII);
- (ii) an incomplete search report according to Art. 17(2)(b) (see GL/PCT-EPO B-VIII);
- (iii) a partial international search report due to a finding of a lack of unity according to Art. 17(3)(a) and Rule 13; and
- (iv) an incomplete search report due to missing sequence listings (see GL/PCT-EPO B-VIII, 3.2).

The Search Division is responsible for drawing up the international search report (see GL/PCT-EPO B-I, 2 and subsections).

This chapter contains the information which is necessary to enable the examiner to correctly prepare the search report.

A search report must contain no matter, in particular no expressions of opinion, reasoning, arguments or explanations, other than that required by the Form or referred to in GL/PCT-EPO B-X, 9.2.8. However, this does not apply to the written opinion (see GL/PCT-EPO B-XI, 3).

*Rule 43.9
GL/ISPE 16.07*

2. Different types of search reports drawn up by the EPO as ISA

The EPO in its capacity as ISA will draw up the following types of search reports:

- (i) international search reports under the PCT; *Art. 16(1)*
- (ii) international-type search reports. For details, reference is made to GL/EPO B-II, 4.5. *Art. 15(5)
GL/ISPE 2.22, 16.04*

3. Form and language of the search report

3.1 Form

See ISPE Guidelines 16.08 and 16.09.

Rule 43.10

3.2 Language

See ISPE Guidelines 16.11.

Rule 43.4

3.3 Account of the search

Section B-X, 3.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.4 Record of search strategy*OJ EPO 2017, A106*

Since 1 November 2015, all search reports drawn up by the EPO under both the PCT and EP procedures, including partial search reports, have been automatically supplemented with an information sheet entitled "Information on Search Strategy". If the application lacks unity of invention, the data contained in this sheet only concerns the invention(s) for which the search fee(s) has (have) been paid. The information sheet is automatically generated based on the data entered by the examiner when drawing up the search report. It lists the databases in which the examiner conducted the prior-art search, the classification symbols defining the extent of the search, and the keywords selected by the examiner or any other element relating to the invention to be searched and used to retrieve the relevant prior art.

Upon publication of a search report drawn up under the PCT procedure, the information sheet will be made available to the public via file inspection on WIPO's PATENTSCOPE.

4. Identification of the patent application and type of search report

Section B-X, 4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5. Classification of the patent application

Rule 43.3(a)
GL/ISPE 16.52

The EPO as ISA classifies the application according to the IPC and CPC.

6. Areas of technology searched*GL/ISPE 16.53*

Section B-X, 6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

7. Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A)

Rule 44.2
GL/ISPE 16.33

The international application must contain an abstract and a title (see also GL/PCT-EPO F-II, 2 and 3). If the search report is published together with the application (A1 publication), the examiner indicates on supplemental sheet A:

Rule 8.1, Rule 38
GL/ISPE 16.39-16.47

(i) the approval or amendment of the text of the abstract, which should not exceed 150 words;

Rule 37
GL/ISPE 16.35-16.38

(ii) the approval or amendment of the title of the invention (see also GL/PCT-EPO H-III, 7); and

Rule 8.2
GL/ISPE 16.48-16.51

(iii) the figure which is to accompany the abstract. It is possible to indicate multiple figures from various sheets, but the overall size should not exceed what could fit on an A4 sheet.

GL/ISPE 15.40

If the application is to be published before the international search report is prepared (A2 publication, see GL/EPO B-X, 4), the examiner only needs to prepare the classification data. Titles, abstracts and figures are published as submitted by the applicant.

It is to be noted that first filings (i.e. applications not claiming priority from an earlier application) cannot be published as A2.

8. Restriction of the subject of the search

In the following cases, the international search report, the declaration issued instead of the search report under Art. 17(2)(a), or the incomplete or partial search report will indicate whether the subject of the search was restricted and which claims have or have not been searched:

GL/ISPE 16.19

GL/ISPE 16.28-16.32

(i) lack of unity of invention (see GL/PCT-EPO B-VII).

Art. 17(3)(a), Rule 13

(ii) claims in respect of which no meaningful search or only an incomplete search can be carried out (see GL/PCT-EPO B-VIII).

In **case (ii)**, the following situations may occur:

(a) A declaration that a meaningful search has not been possible on the basis of all claims is issued instead of the search report; or

Art. 17(2)(a)

(b) If a meaningful search has not been possible for one or more of the claims in part or in full, the claims concerned are mentioned in the incomplete search report and/or in the written opinion.

Art. 17(2)(b)

In case (a), the reasons for not carrying out the search should be indicated in the declaration.

In case (b), a limitation of the search will not always be indicated in the ISR. Rather, the extent of the search as well as the reasons for the restriction will in many cases only be indicated in the WO-ISA. See GL/PCT-EPO B-VIII, 3.5, for details of whether an indication under Art. 17 should be made in the ISR or only in the WO-ISA.

(iii) missing sequence listings (see GL/PCT-EPO B-VIII, 3.2).

Rule 5.2, 13ter.1

9. Documents noted in the search

9.1 Identification of documents in the search report

9.1.1 Bibliographic elements

Section B-X, 9.1.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 16.78

9.1.2 "Corresponding documents"

Section B-X, 9.1.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 33.1

GL/ISPE 16.64(a)

9.1.3 Languages of the documents cited

Section B-X, 9.1.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 15.69, 15.72

PCT AI 505, 507 GL/ISPE 16.65	9.2 Categories of documents (X, Y, P, A, D, etc.) Section B-X, 9.2 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
GL/ISPE 16.66-16.68	9.2.1 Particularly relevant documents Section B-X, 9.2.1 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
GL/ISPE 16.69	9.2.2 Documents defining the state of the art and not prejudicing novelty or inventive step Section B-X, 9.2.2 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
GL/ISPE 16.70	9.2.3 Documents which refer to a non-written disclosure Section B-X, 9.2.3 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
Rule 33.1(c) GL/ISPE 11.07	9.2.4 Use of "P" documents in the search report Although "P" documents are normally not used for the further examination they should be indicated in the search report since they might become pertinent at a later national stage. The EPO as ISA also cites non-patent literature P-X documents in the search report. If the priority document is not available to the examiner at the time of the search, it will be assumed that the priority is valid for the purpose of establishing the search report and written opinion. For the relevant dates for conducting the search, see GL/PCT-EPO B-VI, 3.
GL/ISPE 16.71	Furthermore, section B-X, 9.2.4 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
GL/ISPE 16.72	9.2.5 Documents relating to the theory or principle underlying the invention Section B-X, 9.2.5 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
GL/ISPE 16.73	9.2.6 Potentially conflicting patent documents Section B-X, 9.2.6 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
	9.2.7 Documents cited in the application See GL/ISPE 16.74.
GL/ISPE 16.75 GL/ISPE 11.10	9.2.8 Documents cited for other reasons Section B-X, 9.2.8 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .
GL/ISPE 16.77	9.3 Relationship between documents and claims Section B-X, 9.3 in the Guidelines for Examination in the EPO applies <i>mutatis mutandis</i> .

9.4 Identification of relevant passages in prior-art documents

Section B-X, 9.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 43.5(e)
GL/ISPE 15.69,
16.64(b)

10. Authentication and dates

Section B-X, 10 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 43.2, 43.8
GL/ISPE 16.83-16.84

11. Copies to be attached to the search report**11.1 General remarks**

One copy of the international search report is sent to the IB and one to the applicant. The latter is accompanied by copies of all documents cited, except those documents appearing in the search report after the "&" symbol which are not designated for copying and communication to the applicant (see GL/EPO B-X, 11.3).

Rule 44.1 and 44.3
GL/ISPE 16.86

11.2 Electronic version of document cited

Section B-X, 11.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

11.3 Patent family members; the "&" sign

Section B-X, 11.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

11.4 Reviews or books

Section B-X, 11.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

11.5 Summaries, extracts or abstracts

Section B-X, 11.5 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

11.6 Citation of video and/or audio media fragments available on the internet

Section B-X, 11.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

12. Transmittal of the search report and written opinion

The EPO forwards one copy of the search report or the declaration under Art. 17(2)(a) and of the written opinion to the IB and one copy to the applicant. The applicant also receives copies of all cited documents see GL/EPO B-X, 12), including automated translations annexed to the written opinion (when appropriate, see GL/EPO B-X, 9.1.3) and those documents appearing after the "&" sign and designated to be copied and sent to the applicant (see GL/EPO B-X, 11.3).

Rule 44
GL/ISPE 16.86

Chapter XI – The written opinion

1. The written opinion

Under Chapter I, at the same time as establishing the search report the search examiner must establish the written opinion of the ISA (WO-ISA) to be sent to the applicant together with the search report. The WO-ISA gives 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. When appropriate, an opinion will also be given on added subject-matter, unity, insufficient disclosure and clarity or support issues, as well as formal defects.

Rule 43bis
GL/ISPE 17

The findings of the written opinion must be consistent with the document categories assigned in the search report and must also be consistent with any other issues raised in the search report, such as lack of unity of invention or limitation of the search.

If there are no defects in the application, the WO-ISA will state the reasons why the application is considered to fulfil the requirements of novelty, inventive step and industrial applicability.

The written opinion (and any informal comments filed by the applicant) will be made available to the public by the IB at the same time as the international publication.

Art. 21(3)
GL/ISPE 2.17

If the application subsequently enters the EP phase, the applicant is obliged to reply to any negative WO-ISA or IPRP/IPER. The WO-ISA is thus comparable to the ESOP in the European procedure.

2. Basis of the written opinion (WO-ISA)

Applicants cannot amend the application before the search report has been communicated to them. Consequently, the WO-ISA will always relate to the application documents as originally filed or a translation thereof, and subject to the possibility of sequence listings being furnished later for the purposes of international search (see Rule 13ter.1). Furthermore, any reply filed by the applicant in response to an invitation for informal clarification (see GL/PCT-EPO B-VIII, 3.4) will also be taken into consideration when drawing up the written opinion.

GL/ISPE 17.13

Replacement pages or sheets, filed in response to an invitation by the receiving Office to correct defects in the international application, are deemed to be part of the international application "as originally filed". These sheets are identified with a stamp "SUBSTITUTE SHEET (RULE 26)" (see GL/PCT-EPO H-IV, 1). Also, replacement pages or sheets for rectification of obvious mistakes under Rule 91 (see GL/PCT-EPO H-IV, 2) are deemed to be part of the international application "as originally filed". These sheets are identified with "RECTIFIED SHEET (RULE 91.1)".

Rule 26
Rule 91.1
GL/ISPE 17.16

See GL/PCT-EPO H-IV, 2, for the procedure to follow if the rectified sheets contain added subject-matter.

2.1 Applications containing missing parts or elements, or correct parts or elements, incorporated by reference

Rule 20.5
GL/ISPE 15.11

If applicants omit to file part(s) of the application and/or (an) entire element(s) thereof (i.e. all of the description and/or all of the claims), they may still furnish it (them) at a later date without affecting the international filing date, subject to the requirements of Rules 4.18 and Rule 20.6(a) and provided the missing part(s) and/or element(s) was (were) completely contained in the priority document.

Rule 20.5bis
OJ EPO 2020, A36
OJ EPO 2020, A81

Similarly, if applicants appear to have erroneously filed part(s) of the application and/or (an) entire element(s) thereof (i.e. all of the description and/or all of the claims), they may still furnish the correct part(s) and/or element(s) at a later date without affecting the international filing date, subject to the requirements of Rules 4.18 and 20.6(a) and provided the correct part(s) and/or element(s) were completely contained in the priority document.


The activity of the EPO as ISA depends on the decisions taken by the RO with regard to the international application and its filing date; see also GL/PCT-EPO A-II, 6. Therefore, in cases where the international application was corrected by the RO under Rule 20.5bis, the EPO as ISA will establish the written opinion on the basis of the international application including the correct element(s) and/or part(s) if:

- (a) the RO notifies it of the correct element(s) and/or part(s) before the start of the search; or
- (b) the RO notifies it of the correct element(s) and/or part(s) after the start of the search (including after its completion) and the applicant pays an additional fee equal to the search fee within one month of the date of the invitation to do so issued by the EPO (Rule 40bis.1 and Article 2(1) RFees) (see GL/PCT-EPO B-III, 2.3.4).

See GL/PCT-EPO B-III, 2.3.3.

The examiner must check (as far as the documents needed are available) whether the RO's assessment of the "completely contained" criterion was correct (see GL/PCT-EPO H-II, 2.2.2). See also GL/PCT-EPO B-III, 2.3.3 and GL/PCT-EPO H-II, 2.2.2.2, for the impact on the search report and WO-ISA.

2.2 Applications filed in Dutch

Rules 12.4, 43.4, 48.3
Agreement
EPO-WIPO,
Annex A 
OJ EPO 2017, A115
OJ EPO 2018, A17
OJ EPO 2018, A24

The EPO acting as ISA accepts international applications drawn up in Dutch if the application was filed with the Netherlands patent office as RO.

Therefore, for such files, a translation is not required for the purpose of the international search by the EPO as ISA. However, under Rule 12.4(a), within 14 months of the priority date, a translation must be filed with the RO in a language of publication accepted by the RO for the purpose of international publication, i.e. English, French or German in the case of the Netherlands patent office as RO. The EPO as ISA will establish the ISR and WO-ISA in

that language if it is already known at the time of carrying out the international search; otherwise they will be in the language of the request form, i.e. English, French or German. See also PCT Applicant's Guide, International Phase, Annex C, NL.

3. Analysis of the application and content of the written opinion

3.1 The search division's dossier

Section B-XI, 3.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.2 Reasoned objections

3.2.1 Opinion on novelty, inventive step and industrial applicability

The opinion given in the WO-ISA is restricted to what has actually been searched; this should also be made clear in the WO-ISA.

A full explanation of the conclusions reached should always be given for all searched claims, regardless of whether this conclusion is positive or negative. Normally only one independent claim in each category is treated in detail; for negative conclusions regarding further independent claims, as well as for dependent claims, comments may be shorter.

3.2.2 Multiple independent claims

Multiple independent claims in one category are per se not a reason for a restriction of the search (see GL/PCT-EPO B-VIII, 4).

GL/ISPE 5.13 and 5.14

If appropriate, an objection as to clarity and conciseness under Article 6 may be made under Box VIII (see GL/PCT-EPO F-IV, 3.2). As an alternative, for cases where multiple independent claims in one category do not affect the clarity of the definition of the invention, a minor objection may be raised under Box VII.

3.2.3 Dependent claims – WO-ISA

Dependent claims should be indicated as complying or not with the requirements of novelty, inventive step and industrial applicability. Short statements of the reasons why the claims do not comply with these requirements should be given on the separate sheet. At the discretion of the examiner, more detailed comments may be made about selected dependent claims. If any claims are found to be novel and inventive, brief reasons for this too should be given on the separate sheet.

3.2.4 Clarity, conciseness, support and formal defects – WO-ISA

Major clarity, conciseness or support issues will be mentioned under Box VIII, unless they result in a meaningful search being impossible, in which case they will be treated under Section III.

Formal defects (e.g. reference signs, two-part form, acknowledgment of prior-art documents, etc.) as well as minor clarity issues will be dealt with under Box VII.

If the application is severely deficient and it is clear that the claims will have to be drastically redrafted anyway, it is not necessary to make objections with respect to minor clarity issues and/or formal issues.

3.3 Making suggestions

GL/ISPE 3.05, 17.71

It is possible to make suggestions in the written opinion as to how certain objections raised may be overcome. However, examiners must not actually, of their own volition, make any final amendments to the application documents, however minor, for the reason that only amendments submitted by the applicant may be taken into consideration for the IPER. In no circumstances should the impression be given that compliance with the suggestions would lead to an allowable application under the EPC or any national law.

If no demand for Chapter II is filed, the WO-ISA will automatically be converted into an IPRP Chapter I. Therefore, the WO-ISA should not contain formulations suggesting to the applicant to actively file submissions.

3.4 Positive or negative WO-ISA

The examiner needs to indicate whether the WO-ISA is to be considered positive or negative for further prosecution. The reason for this is that when entering the European phase the applicant is required to respond to the WO-ISA if it is negative, but not if it is positive (see GL/EPO E-IX, 3.3.2).

As a general rule, a WO-ISA is considered positive if it contains no objections at all or only minor objections which would not hinder a direct grant in the EP phase.

In the special case where the search report cites P and/or E documents but the priority could not be checked and there are no other objections, the WO-ISA is considered positive (since the examiner in the European phase first has to evaluate the validity of the priority and then decide whether a grant is still possible).

On the other hand, if the relevance of the document is independent of the priority being valid, detailed reasons for the novelty objection will be given, as well as an indication to the applicant that such a document would be relevant when entering the European phase before the EPO.

In the case of method of treatment claims which can easily be reformulated into an allowable format (see also GL/PCT-EPO B-VIII, 2.1), the above applies as well; i.e. if this is the only objection, the WO-ISA will be considered positive since such a reformulation can be done by the examiner at the grant stage in the European phase before the EPO.

In the special case of a non-unitary application, where all inventions searched were found to be novel and inventive, but still lacking unity – as the only objection – the WO-ISA is marked as negative.

4. Priority claim and the WO-ISA

GL/ISPE 17.28-17.29

Normally, priority need only be checked if a relevant P or E document is found during the search. However, there may also be cases where the examiner immediately realises that the priority is not valid (e.g. in the case of an alleged doublure (see GL/PCT-EPO B-IV, 1.1) or a continuation-in-part (see GL/PCT-EPO F-VI, 1.4)). Also, in case of restoration of priority rights, the examiner may insert a comment in Box II (see GL/PCT-EPO B-XI, 4.1).

4.1 Restoration of priority

See GL/PCT-EPO F-VI, 3.7.

Rule 26bis.3

If the examiner notices that the filing date exceeds the earliest priority date plus twelve and two months this may be indicated in the WO-ISA.

4.2 Use of "P" documents in the written opinion

If the priority document is not available, the opinion will be established on the assumption that the claimed priority is valid. In this case, no comments need be made regarding "P" documents, but the "P" documents will nevertheless be indicated under Section VI. For potentially conflicting patent documents which might give rise to an objection under Art. 54(3) EPC in the European phase, the statements in GL/PCT-EPO B-XI, 4.3, below regarding "E" documents apply.

GL/ISPE 17.29(b)

If the priority document is available, the examiner will check the validity of the priority and indicate any negative finding under Section II. Should the priority be found not to be valid, detailed comments will be made for these documents with respect to novelty and inventive step of the claimed subject-matter under Section V, since these documents then become prior art under Rule 33.1(a).

GL/ISPE 17.29(c)

Sometimes it is possible for the examiner to determine from the documents on file that the claimed priority is not valid. An example would be when during the search a document is found which shows that the priority document of the searched application is actually not the first application for the claimed invention.

4.3 Use of "E" documents in the written opinion

Although there are no harmonised provisions in the PCT Contracting States that correspond to Art. 54(3) EPC, such documents will be mentioned under Section VI if they are considered prejudicial to the novelty of at least one claim. If the relevance of the document is independent of the priority being valid or if the priority could be checked and was found invalid, reasons for the novelty objection will be provided, together with an indication that such a document would be relevant when entering the European phase before the EPO.

On the other hand, if the document would be relevant under Art. 54(3) EPC only if the priority is not valid, and this could not be checked, then no reasons need to be given.

5. Unity in relation to the written opinion

In the case of lack of unity where more than one invention has been searched, for each invention searched one independent claim in each category must be treated in detail.

See GL/PCT-EPO B-VII for further details.

6. The written opinion in cases of a restriction of the search

The extent of the search as well as the reasons for the restriction will in many cases only be indicated in the WO-ISA. See GL/PCT-EPO B-VIII, 3.5, for details of whether an indication under Art. 17 should be made in the ISR or only in the WO-ISA. The opinion given is then normally restricted to what has actually been searched.

Any argumentation and objections presented in the written opinion must be consistent with the restrictions of the search and the reasons therefor. See also GL/PCT-EPO B-VIII, 2, GL/PCT-EPO B-VIII, 3 and GL/PCT-EPO B-VIII, 3.1.

7. Sequence listings

Where the applicant has not filed an electronic sequence listing conforming to WIPO Standard ST.26 in response to a request from the ISA, or has not paid the late furnishing fee, the WO-ISA will indicate under Section III that the written opinion is limited to the same extent as the search was limited because the applicant failed to comply with Rule 5.2 (no sequence listing) and/or Rule 13~~ter~~.1(a) (no computer-readable sequence listing).

8. Options open to the applicant following receipt of the ISR and WO-ISA

See ISPE Guidelines 2.15.

If the international application subsequently enters the European phase, the applicant is obliged to reply to any negative WO-ISA or IPER.

Rule 5.2

Rule 13~~ter~~.1(a)

OJ EPO 2011, 372

~~OJ EPO 2013, 542~~

OJ EPO 2021, A96

OJ EPO 2021, A97

OJ EPO 2022, A60

GL/ISPE 9.39, 15.12

and 15.14A

Chapter XII – Supplementary international search (SIS)

1. General

The supplementary international search system is optional for both applicants and International Authorities. Its purpose is to enable applicants, during the international phase, to obtain further supplementary searches from other Authorities so that they have a better basis for deciding whether or not to enter the regional phase.

Rule 45bis
OJ EPO 2010, 316
OJ EPO 2017, A115
OJ EPO 2018, A24
GL/ISPE 2.20, 15.76

The EPO as SISA only accepts a limited number of SIS requests per year. Since 2010, the EPO has limited the number of SIS requests it will accept to 700 per year.

2. Time limits

An applicant can request a SIS up to the end of 22 months from the priority date. The request must be filed with the IB.

Rule 45bis.1(a)
GL/ISPE 2.20, 15.78
PCT Newsletter
10/2016, 1

The SISA must start the search promptly after receipt of the necessary documents, though it may delay the start of the search until it has received the ISR from the main ISA, but not later than the end of 22 months from the priority date.

Rule 45bis.5(a)
GL/ISPE 15.82

The supplementary international search report (SISR) must be established within 28 months from the priority date so as to allow the applicant to take it into account when deciding whether or not to enter the regional/national phase.

Rule 45bis.7(a)
GL/ISPE 15.94

The file will therefore be sent to the examiner as soon as all the documents have been received, including the ISR from the main ISA. If, however, the ISR from the main ISA is not received within 22 months of the priority date, the file will be sent to the examiner to enable the start of the search.

3. Basis for the search

The SIS is always made on the claims as originally filed (or a translation thereof), irrespective of whether amendments have been filed under Art. 19 or 34.

Rule 45bis.5(b)
GL/ISPE 15.85

In cases where the international application was corrected by the RO under Rule 20.5bis, the EPO as SISA will carry out the supplementary international search on the basis of the international application including the ~~later submitted~~ pages submitted later and containing the correct element or part. This is the version that will have been ~~as~~ searched by the main ISA.

4. Scope of the search

GL/ISPE 15.93

At the EPO the scope of a SIS is the same as for any other international search carried out by the EPO as ISA and is not limited to documentation in a specific language.

If an ISR from the main ISA is already available when the examiner carries out the SIS, it will be taken into account when establishing the SISR and written opinion.

5. Limitation of the search for reasons other than non-unity

With respect to limitations of the search for reasons other than non-unity (including the issuance of a declaration of no search), the same criteria apply as for any international search carried out by the EPO as ISA (see GL/PCT-EPO B-VIII, 2, 3 and subsections).

GL/ISPE 15.87

Any such limitation of the search will be indicated in the search report and/or the annexed explanations (of equal value to the information contained in a WO-ISA) as set out in GL/PCT-EPO B-X, 8 and B-XI, 6, with the exception that in the case of a declaration of no search (Form PCT/SISA/502) no explanations from the SISA are provided for. For any other limitation of the search, the reasoning will be given only in the explanations annexed to the SISR and an automatic reference thereto will be inserted in the SISR.

Furthermore, the SISA does not have to search claims which were not searched by the main ISA. However, the examiner will not limit the SIS merely on the grounds that the main ISA did so, but will make a case-by-case assessment based on EPO practice to determine whether the limitation made by the main ISA was appropriate under EPO practice.

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

For non-unity: see GL/PCT-EPO B-XII, 10.

6. Filling out the search report

The SISR is filled out in the same way as for any international search, with the exception that publication details do not have to be provided since the main ISA has already provided the publication data and IPC classes.

GL/ISPE 15.96

Examiners will not cite in the SISR a document already cited in the ISR unless they attach a different significance to it, e.g. as a Y document in combination with a newly cited document or where the main ISR has clearly failed to recognise the extent of the document's relevance.

Furthermore, it will be indicated in the SISR whether or not the main ISR was available and taken into account.

7. Explanations under Rule 45bis.7(e)

No separate WO-ISA is established for a SIS. Instead, only a free-text sheet is used, and this will contain the same information as the separate sheet that is part of the WO-ISA in the form of "explanations". Upon entry into the European phase, the applicant is obliged to respond to these explanations, as set out in Rule 161(1) EPC. A positive conclusion must be reasoned in the same way as in a WO-ISA/IPER.

*Rule 45bis.7(e)
GL/ISPE 15.96(iv), (v)*

Formally, the explanations under Rule 45bis.7(e) are part of the SISR (Form PCT/SISA/501) and are contained in an annex called the "Scope Annex".

Although the Scope Annex will concentrate on the documents cited in the SISR, in some circumstances it might be appropriate to raise objections based on documents cited in the ISR.

An example would be that of a document cited in the ISR which could be used as a Y document for inventive step for some dependent claims in the

Scope Annex. In this case it might be necessary to cite the document again in the SISR as a Y document for those claims if this was not already indicated in the main ISR (see also GL/PCT-EPO B-XII, 6), and to provide argumentation in the Scope Annex.

It may also occur that although the EPO as SISA finds further pertinent prior art, objections may also be raised based on X and/or Y documents cited in the ISR. In such a case, the examiner may choose to base objections only on the documents cited in the ISR if considered expedient. Should the objections correspond to those raised in the WO-ISA from the main ISA, a mere reference to the WO-ISA objections will suffice.

There may also be cases where the ISR contains documents pertinent for novelty and/or inventive step and the EPO as SISA cannot find any further relevant documents (only possibly A documents). In such a case the following two possibilities will arise:

- (i) if the examiner agrees with the categories (X, Y) given in the ISR for these documents, it is not necessary to cite the documents again in the SISR. The examiner will then use the documents cited in the ISR to raise objections of lack of novelty and/or inventive step. If the WO-ISA from the main ISA has raised the same objections, and the examiner agrees with the given reasoning, a mere reference to the objections raised in the WO-ISA from the main ISA will suffice.
- (ii) if the examiner does not agree with some or all of the categories (X, Y, A) given in the ISR for any such documents considered pertinent and upon which the examiner wishes to base the objections in the Scope Annex, such documents will be cited again in the SISR.

In both these cases the A documents found by the EPO as SISA will be cited in the SISR.

Generally, an explicit re-evaluation of the objections raised in the WO-ISA will be avoided. The examiner will thus refrain from negatively commenting on any reasoning given in the WO-ISA, bearing in mind that national law differs amongst the PCT contracting states.

8. Validity of priority and E/P documents

At this stage the priority document should be available in the file and it can therefore be checked if E/P documents were found during the search. Should the priority document not be available, for the purposes of the search the priority is assumed to be valid. No indication in the Scope Annex is necessary.

If the priority is not valid, this will be explained in the Scope Annex, and any P documents found to be relevant will be dealt with in detail.

On the other hand, if the priority is valid, any cited P documents do not need to be dealt with in detail.

Any E document which is a potential Art. 54(3) EPC document will be dealt with in the Scope Annex. In this case the applicant's attention should be drawn to the relevance of such a document if the application enters the European phase before the EPO and a reasoned statement as to lack of novelty will be given.

9. Copies of documents cited in the SISR

The applicant will receive a copy of each document cited in the SISR free of charge.

*OJ EPO 2010, 316
GL/ISPE 15.97*

10. Non-unity

10.1 General procedure

In case of non-unity only one invention is searched; there is no possibility to pay additional fees for further inventions. Furthermore, the decision as to which invention should be considered the main invention and thus searched is handled differently for the SIS procedure, as set out in detail in GL/PCT-EPO B-XII, 10.2.

*Rule 45bis.6
GL/ISPE 15.89-15.90*

Where the main ISA has already objected to lack of unity, the applicant can indicate together with the supplementary search request which of the inventions should be searched by the SISA. For further details see GL/PCT-EPO B-XII, 10.3.

Rule 45bis.1(d)

If on the other hand the main ISA has not objected to lack of unity, the EPO as SISA is free to do so, as the SISA is not bound by any finding on unity made by the ISA but merely obliged to take such a finding into account.

Rule 45bis.6(b)

As for any international search where lack of unity is objected to, the applicant has the right to protest against the non-unity finding. In the SIS procedure this protest is called a review (see GL/PCT-EPO B-XII, 10.4).

Rule 45bis.6(c)

10.2 Deciding what is to be considered the main invention

The main invention will normally be the invention first mentioned in the claims. However, the examiner will exercise due discretion in selecting the invention to be searched where the first mentioned invention is one for which no search report would be established, 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 ISA responsible for the main international search. For details, see GL/PCT-EPO B-XII, 10.3.

10.3 The main ISA found that unity of invention is lacking

If the main ISA has already objected to lack of unity and the examiner agrees with the assessment in the main ISR, this can be reported by simply referring to the ISR.

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 before the ISA, the reasoning will be set out in full so that it is easily understood by both the applicant and third parties. No reasons need be given why the lack-of-unity objection raised in the ISR could not be followed.

If the examiner finds that the application does not lack unity, a complete search is made for all the claims. No reasons need be given why the lack-of-unity objection raised in the ISR could not be followed.

Furthermore, if the main ISA has already objected to lack of unity, the applicant can indicate, on the supplementary search request form (in Box IV), which of the inventions searched by the main ISA the SIS should be based upon.

If the examiner agrees with the assessment of unity of invention made by the main ISA and the relevant claims are not excluded for any reason, the SIS will focus on the invention indicated by the applicant.

If examiners cannot follow the objection raised in the ISR, but raise a different non-unity objection, when deciding on the main invention to be searched, they will take the request by the applicant into account as far as possible. The examiner will provide complete reasoning for the lack-of-unity objection in the SISR and will include an explanation of the extent to which the applicant's request could be taken into account in view of the different non-unity objection raised by the EPO.

10.4 Review procedure

Rule 45bis.6(d)
GL/ISPE 15.91

If applicants do not agree with the finding of lack of unity they can request a review of this finding. This procedure is similar to the protest procedure with the difference that additional fees cannot be paid.

If applicants request a review of the non-unity finding they must pay a review fee. If no fee is paid, the request for review is considered not to have been made.

Similar to the protest procedure, a Review Panel is established consisting of the examiner responsible for the file, an examiner as chairperson of the Review Panel and a further examiner. This Review Panel will, in case of entry into the European phase, constitute the Examining Division (see GL/PCT-EPO B-VII, 7.2). The examiner dealing with the file will make a first assessment of the arguments made by the applicant and will then discuss the case with the members of the Review Panel to come to a decision.

The purpose of the Review Panel is to determine whether the lack-of-unity objection was justified on the basis of the reasoning given in the SISR. The review does not include re-evaluation to determine possible additional grounds for lack of unity.

Where the Review Panel determines that the objection was not justified, it will inform the applicant with Form 503; no reasoning needs to be given. Furthermore, it will order the reimbursement of the review fee. A corrected SISR must then be established on all claims.

If the Review Panel considers that the objection is completely or partially justified, it will communicate this to the applicant with Form 503. In these cases, reasoning must be given indicating why the objection is (at least

partially) upheld. This reasoning should also address the applicant's relevant arguments. The review fee will not be reimbursed. In the case of an only partially justified lack-of-unity objection, a corrected search report taking the result of the review into account must be established.

11. Combination of SIS and Chapter II

If the ISA was one of the European International Searching Authorities (SE, ES, AT, FI, TR, NPI (XN) or VPI (XV)) the applicant can file a demand under Chapter II with the EPO and additionally a request for SIS by the EPO.

For such a file the examiner will first establish the SISR with Scope Annex and then continue with Chapter II.

Under Chapter II, a WO-IPEA (Form 408) will be sent to the applicant if there are objections, since the WO-ISA from another office is not recognised as a WO-IPEA (unlike an EPO WO-ISA) and the Scope Annex does not legally qualify as a WO-IPEA (see GL/PCT-EPO C-IV, 2.1).

GL/ISPE 17.04