

PCT – Part C

Guidelines for Procedural Aspects in Chapter II

Contents

Chapter I – Introduction

I-1

- | | | |
|----|--|-----|
| 1. | General remark | I-1 |
| 2. | Work of an examiner | I-1 |
| 3. | Purpose of international preliminary examination | I-1 |

Chapter II – Formal requirements to be met before the start of the international preliminary examination

II-1

- | | | |
|-----|---|------|
| 1. | Filing of the demand | II-1 |
| 2. | The EPO as competent IPEA | II-1 |
| 3. | Identification of the international application in the demand | II-1 |
| 4. | Applicant's entitlement to file a demand | II-1 |
| 5. | Representation | II-2 |
| 6. | Election of states | II-2 |
| 7. | Signature | II-2 |
| 8. | Basis for international preliminary examination | II-2 |
| 9. | IPEA file | II-3 |
| 10. | Correction of deficiencies | II-3 |
| 11. | Payment and refund of fees | II-3 |
| 12. | Transmission of demand to the International Bureau | II-3 |

Chapter III – Documents forming the basis of the international preliminary examination

III-1

- | | | |
|----|--|-------|
| 1. | Substitute sheets and rectified sheets | III-1 |
| 2. | Sheets filed under Rule 20.6 containing missing parts or elements or correct parts or elements | III-1 |
| 3. | Amended sheets | III-1 |

4.	Added subject-matter	III-2
	Chapter IV – Examination of the WO-ISA and replies	IV-1
1.	General procedure	IV-1
2.	Despatch of a further written opinion (Form 408)	IV-1
2.1	Procedure when the EPO was not the ISA	IV-1
2.2	Procedure when the EPO was the ISA	IV-1
2.3	Supplementary international search (SIS) by another office	IV-2
2.4	Files arriving late	IV-3
2.5	Request for a further written opinion	IV-3
3.	Late-filed reply after a first or further WO-IPEA (408) has been sent	IV-3
4.	Consequences of a restriction of the search	IV-4
4.1	Submissions prompted by a restriction of the search or a declaration that no search is possible	IV-4
4.2	Consequences of a declaration of no search or an incomplete search in subsequent European procedure	IV-5
5.	Top-up searches in PCT Chapter II	IV-5
5.1	Timing, basis and forms	IV-5
5.2	Exemptions from top-up search	IV-5
5.3	Documents newly found in the top-up search, when further objections are present	IV-6
5.4	Intended positive IPER and top-up search	IV-7
	Chapter V – Unity of invention	V-1
1.	Unity of invention under Chapter II	V-1
2.	No payment of additional search fees	V-2
3.	Searched claims did not comply with unity of invention	V-2
3.1	Payment of additional search fees without protest	V-2

3.2	Payment of additional search fees under protest	V-2
3.3	No request for payment of additional search fees	V-2
4.	Applicant's reply to the invitation to pay additional fees (Form 405)	V-3
4.1	No payment of additional examination fees or failure to reply	V-3
4.2	Payment of additional examination fees without protest	V-3
4.3	Payment of additional examination fees under protest	V-3
5.	Protest procedure	V-4
5.1	Admissibility of the protest as checked by the formalities officer	V-4
5.2	The work of the Review Panel	V-4

Chapter VI – Time limits **VI-1**

1.	Start of the international preliminary examination	VI-1
2.	Time limit for international preliminary examination	VI-1
3.	Extension of the time limit	VI-1

Chapter VII – Other procedures in examination **VII-1**

1.	Request for an interview or telephone consultation	VII-1
2.	Confidentiality	VII-2
3.	Examination of observations by third parties	VII-3

Chapter VIII – The IPER **VIII-1**

1.	Opinion given in the IPER (Form 409)	VIII-1
2.	Completing the IPER	VIII-1
2.1	Sequence listings	VIII-2
3.	Positive or negative IPER	VIII-2
4.	Rectification of the IPER	VIII-2

Chapter IX – Special requests		IX-1
1.	Withdrawal of demand under Chapter II	IX-1
2.	Request for examination of a different set of claims	IX-1
3.	Request for examination of certain claims only	IX-2
4.	Complaint against the findings at the search stage	IX-2

Chapter I – Introduction

1. General remark

Chapters C-II to C-IX set out the general procedure for the international preliminary examination under PCT Chapter II, together with guidance on particular matters where necessary. They do not provide detailed instructions on matters of internal administration.

Matters of substantive law, i.e. the requirements which a PCT application must fulfil, are dealt with in Part F, Part G and Part H.

2. Work of an examiner

See ISPE Guidelines 3.05.

3. Purpose of international preliminary examination

While the search and the accompanying written opinion under Chapter I are mandatory for applicants, examination under Chapter II is optional. *GL/ISPE 3.02, 3.04*

The end product of the PCT procedure is the international preliminary report on patentability (IPRP) Chapter I or Chapter II. This report will be the result: *Rules 44bis and 70*

- i. either of further examination under Chapter II (see below) in the form of an international preliminary examination report (IPER) from the International Preliminary Examining Authority *Rule 70*
GL/ISPE 3.02
- ii. or, if no demand under Chapter II is filed, of the International Bureau's conversion of the WO-ISA into an IPRP of the International Searching Authority, which is made public at 30 months from the priority date or shortly thereafter together with any informal comments submitted by the applicant. Such comments will be annexed to the report. Since no demand for preliminary examination under Chapter II has been filed, there is no re-examination of the WO-ISA. *Rule 44bis*
GL/ISPE 2.18

In its capacity as an International Preliminary Examining Authority (i.e. under Chapter II of the PCT), the EPO is empowered to carry out international preliminary examination (IPE), the objective of which is 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. *Article 33(1)*
GL/ISPE 19.02

The international preliminary examination does not lead to either a grant or a refusal of a patent; instead, at the end of the procedure, a report – the IPRP Chapter II or IPER – is established. The procedure under Chapter II allows the applicant to submit amendments and arguments in response to the WO-ISA and, if applicable, to a WO-IPEA, which will be taken into account when establishing the report. *Rule 66.1bis(b)*
GL/ISPE 3.19

Art. 32
Rule 59
GL/ISPE 1.13-1.15

The EPO is a 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.

Chapter II – Formal requirements to be met before the start of the international preliminary examination

1. Filing of the demand

The demand for international preliminary examination must be made using the prescribed form (PCT/IPEA/401).

*Art. 31(3)
Rule 53*

A demand for preliminary examination selecting the EPO as IPEA must be filed with the EPO in Munich, Berlin or The Hague, in writing, by hand, by post, by facsimile or electronically. As of 1 November 2016 the ePCT service may be used for online filing of the demand under PCT Chapter II, and also for indicating the payment of fees related to the demand.

*Art. 31(6)(a)
OJ EPO 2014, A71
OJ EPO 2016, A78
OJ EPO 2018, A25,
A45*

The EPO will indicate the date of receipt on the demand and promptly notify the applicant of that date. If the demand is filed by fax, no written confirmation needs to be filed unless the applicant is invited by the EPO as IPEA to do so.

*Rule 92.4(e), (g)
OJ EPO 2007,
Spec. ed. 3, A.3
(Art. 3 and 7 of the
Decision)*

If the applicant filed the demand incorrectly with the International Bureau (IB), a receiving Office, an International Searching Authority or a non-competent International Preliminary Examining Authority, that Office or Authority or the IB will mark the date of receipt and will transmit the demand to the EPO as IPEA.

Rule 59.3

The time limit for filing the demand for international preliminary examination with the EPO is as defined in Rule 54*bis*.1.

2. The EPO as competent IPEA

The IPEA receiving the demand should ensure that it is competent to act as IPEA.

*Art. 31(6)(a) and 32,
Rule 59.3*

Although the EPO's competence as an IPEA is not restricted to international applications from EPC contracting states, restrictions of various nature limit its competence.

In particular, the EPO is competent to act as IPEA only if the international search was carried out by the EPO or by the Austrian, Finnish, Spanish, Swedish or Turkish patent office, the Nordic Patent Institute (NPI) or the Visegrad Patent Institute (VPI).

*Agreement EPO-
WIPO,
OJ EPO 2017, A115
OJ EPO 2018, A24*

3. Identification of the international application in the demand

The international application must be identified by indicating the international application number, the international filing date, the title of the invention and the name and address of the applicant.

*Rules 53.6 and
60.1(b)*

4. Applicant's entitlement to file a demand

The demand should contain the name and the address (including postal code and name of the country) of the applicant, the state of nationality and the state of residence.

*Art. 31(2),
Rules 18.1 and 54*

Sole applicants must have their residence in, or be a national of, a PCT contracting state bound by PCT Chapter II. If there is more than one applicant, at least one of the applicants has to fulfil these requirements. Secondly, the international application must have been filed with a receiving Office of or acting for a PCT contracting state bound by PCT Chapter II. At present, all PCT contracting states are bound by PCT Chapter II. Therefore, these requirements do not stand in the way of any applicant wishing to file a demand for a pending international application.

5. Representation

*Rule 90
Art. 31(2), Rule 54*

The demand should indicate the agent or common representative who has been appointed by the applicant(s) or a sub-agent who has been appointed by an agent appointed under Rule 90.1(a) ("the agent for the international phase") (see GL/PCT-EPO A-VIII, 1.9).

Any agent or other person having the right to practice before the EPO during the European phase is entitled to practice before the EPO as IPEA in respect of that application. The same applies to any agent or other person entitled to practice before the RO with which the international application was filed (Article 49 PCT) (see GL/PCT-EPO A-VIII, 1.1).

Where an agent is appointed, any correspondence intended for the applicant will be sent to the address indicated for the agent.

If there are two or more applicants and no common agent or common representative is appointed, all correspondence will be sent to the first-named applicant who has the right to file an international application with the receiving Office concerned, as this applicant will be considered to be the common representative ("deemed common representative") (see GL/PCT-EPO A-VIII, 1.3).

For common provisions on representation, see GL/PCT-EPO A-VIII.

6. Election of states

*Art. 37, Rule 53.7
GL/ISPE 22.11*

The filing of the demand constitutes the election of all contracting states which are designated and are bound by Chapter II of the PCT.

7. Signature

*Rules 53.8, 90.3(a),
90.4(a) and (b)*

The demand must be signed either by all the applicants or by the (common) agent or the common representative.

8. Basis for international preliminary examination

*Art. 19 and 34 PCT
Applicant's Guide
Int. Phase, Annex E*

The preliminary examination is based on the international application either as filed or as amended under Article 19 or 34 (see also GL/PCT-EPO C-III).

Rule 66

Applicants must indicate on which basis they wish the IPEA to start the international preliminary examination – the application as originally filed or with amendments (Article 19 or Article 34); any translations; any comments about the WO-ISA (indexed ISOREPLY) or about the ISR; a sequence listing in the language of the IPE where applicable.

Additionally, a fee for preliminary examination and a handling fee are to be paid (see GL/PCT-EPO A-III, 7.1 and 7.2). *Rule 58.1 and 58.3*

9. IPEA file

The EPO as IPEA promptly establishes the file when the conditions under Rule 69.1(a) are fulfilled, using the existing ISA file or creating a new file if the EPO was not the ISA. *PCT AI section 605*

10. Correction of deficiencies

Certain defects might be corrected *ex officio* by the IPEA; for others, the EPO as IPEA invites the applicant to correct the defects within one month of the date of the invitation. If the applicant complies with the time limit, the demand is deemed to have been received on the actual filing date, provided that the demand as submitted sufficiently identified the international application. If the applicant does not comply with the invitation in due time, the demand is deemed not to have been submitted. *Art. 31(3)*
Rules 53, 55 and 60
GL/ISPE 22.37-22.41

11. Payment and refund of fees

Both the preliminary examination fee and the handling fee must be received at the EPO as IPEA one month from the date of receipt of the demand or 22 months from the earliest priority date, whichever expires later. See GL/PCT-EPO A-III, 7.1 and 7.2. *Rules 57 and 58*
GL/ISPE 22.42-22.48

For the conditions for refunding the handling fee and the international preliminary examination fee, see GL/PCT-EPO A-III, 9.6 and 9.7, respectively.

12. Transmission of demand to the International Bureau

The transmission of the demand to the International Bureau should be effected not later than one month after receipt of the demand. *Rules 61.1 and 90bis.4(a)*

Chapter III – Documents forming the basis of the international preliminary examination

1. Substitute sheets and rectified sheets

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 are deemed to be part of the international application "as originally filed". These sheets are identified with "RECTIFIED SHEET (RULE 91.1)" (see GL/PCT-EPO H-IV, 2.2).

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. Sheets filed under Rule 20.6 containing missing parts or elements or correct parts or elements

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 20.6(a) and provided the missing part(s) and/or element(s) were completely contained in the priority document.

Rule 4.18
Rule 20.3
Rule 20.5
Rule 20.5bis
Rule 20.6
OJ EPO 2020, A36
OJ EPO 2020, A81
GL/ISPE 6.01
GL/ISPE 15.11
GL/ISPE 17.16A
GL/ISPE 18.07
GL/ISPE 22.27

Similarly, if applicants appear to have erroneously filed (a) 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.

Such elements and/or parts are then considered to have been part of the application as originally filed, provided that they were notified to the ISA on time or the relevant additional fee was paid; see GL/PCT-EPO B-III, 2.3.3, B-III, 2.3.4, and B-XI, 2.1.

The examiner checks 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 H-II, 2.2.2.2, for the impact on the IPER.

See also GL/EPO C-III, 1.3, and GL/EPO E-IX, 2.9.4, for the effect on the European phase.

3. Amended sheets

Any change, other than the rectification of obvious mistakes in the claims, the description or the drawings is considered an amendment. Unless withdrawn or superseded by later amendments, any change considered an amendment must be taken into consideration for the purpose of the international preliminary examination.

Art. 19
Art. 34(2)(b)
Rule 66.5
GL/ISPE 20.04

See GL/PCT-EPO H-II and H-III for details.

4. Added subject-matter

GL/ISPE 20.09

All amended pages (description, claims, drawings) must be examined to see whether they introduce subject-matter not originally disclosed. The same criteria should be used as under Art. 123(2) EPC for the European procedure (see GL/PCT-EPO H-II and III).

Concerning the applicant's obligation to indicate the basis for the amendments in the application as originally filed, see GL/PCT-EPO H-I, 6.

Art. 19(2)

Art. 34(2)(b)

Rule 70.2(c)

If any newly filed claim, drawing or part of the description contains amendments which are considered to go beyond the disclosure as originally filed, the claim concerned is examined, taking into consideration only those technical features which have a basis in the application as originally filed, disregarding the amendments which are considered as introducing added subject-matter.

If that is not possible, the text of the claims as originally filed or amended under Art. 19(1) is examined and this information is entered on the cover sheet and in Section I of the WO-IPEA (Form 408) and/or of the IPER (Form 409). On the separate sheet, reasons must be given as to why the amendments introduce subject-matter not originally disclosed and why they are disregarded.

Chapter IV – Examination of the WO-ISA and replies

1. General procedure

Under Chapter II, the reply to the WO-ISA, WO-IPEA (Form 408) or telephone minutes with possible amendments will be examined.

The final result of this examination under Chapter II is the issuance of the IPER (see GL/PCT-EPO C-VIII).

The examiner will first consider whether the objections raised in the WO-ISA have been overcome by the submitted arguments and/or amendments. If this is the case, the IPER will be issued directly, provided that the top-up search does not yield any pertinent prior art (see GL/PCT-EPO C-IV, 5.4). If objections have not been overcome or if pertinent prior art is found in the top-up search (see GL/PCT-EPO C-IV, 5.3 and 5.4), a further WO-IPEA or telephone minutes should be issued as set out in GL/PCT-EPO C-IV, 2.2.

If a further WO-IPEA or telephone minutes setting a time limit for reply are issued, the examiner will examine any reply from the applicant and will then as a rule draft the IPER directly even if objections still occur, unless there is an outstanding request for a telephone consultation (see GL/PCT-EPO C-IV, 2.2, and C-VII, 1). An exception could be if it is clear that minor amendments could be suggested during e.g. a short telephone consultation which would result in a positive IPER, so that it would appear procedurally expedient to solve these problems in the Chapter II phase.

OJ EPO 2011, 532

2. Despatch of a further written opinion (Form 408)

2.1 Procedure when the EPO was not the ISA

Where the ISR and WO-ISA were established by another European International Searching Authority (at present SE, ES, AT, FI, TR, NPI (XN) and VPI (XV)), the WO-ISA is not considered as the first written opinion for the procedure under Chapter II PCT and the examiner will examine the file, taking into account the WO-ISA and any reply from the applicant on file. If there are objections as to novelty, inventive step and/or industrial applicability, the examiner will send a WO-IPEA with a time limit for the applicant to reply as laid down in Rule 66.2(d), which is normally two months.

*Rule 66.1bis
GL/ISPE 3.19*

If, despite the applicant's timely and substantive reply (in the form of amendments and/or arguments) to this WO-IPEA, there are still objections outstanding, possibly resulting from the top-up search in Chapter II (see GL/PCT-EPO C-IV, 5), a further written opinion or telephone minutes are issued as set out under GL/PCT-EPO C-IV, 2.2.

2.2 Procedure when the EPO was the ISA

Applicants must be given a further opportunity for interaction in Chapter II before a negative IPER is established, on condition that they have filed in due time a substantive reply to the WO-ISA in the form of amendments and/or arguments.

OJ EPO 2011, 532

Thus if, after reply to the WO-ISA, there are still objections outstanding, before issuing a negative IPER the examiner must send:

- as a rule, a (further) written opinion (Form 408, WO-IPEA), but:
- if a request for a telephone consultation was filed before the (further) written opinion was issued: telephone minutes;
- if a request for either a telephone consultation or a (further) written opinion (see GL/PCT-EPO C-VII, 1) was filed before the (further) written opinion was issued: a written opinion or telephone minutes,

Rule 66.2(d)

in either case generally (see GL/PCT-EPO C-VII, 1) with a time limit to reply which is normally two months, in order to give the applicant a further opportunity to provide arguments and/or amendments in reply to any outstanding objections. Documents newly found during the top-up search (see GL/PCT-EPO C-IV, 5) are attached to the WO-IPEA or to the telephone minutes, as appropriate.

If the applicant has not submitted any response to the negative WO-ISA with the demand, and the top-up search in Chapter II does not reveal any new pertinent prior art, then a negative IPER, repeating the objections raised in the WO-ISA, will be issued directly.

In the exceptional situation of a non-unitary application, where all inventions examined were found novel and inventive, but still lacking unity as the only remaining objection, a negative IPER can be sent directly without a further WO-IPEA (see GL/PCT-EPO C-VIII, 3).

2.3 Supplementary international search (SIS) by another office

When conducting preliminary examination under Chapter II, the examiner must also take into account any documents cited in any supplementary international search report (SISR) by another office which is available in the file.

If the SISR has not been received by the EPO 24 months after the priority date, the file will be sent to the examiner anyway. If, after checking, the examiner concludes that an invitation to pay additional fees in case of lack of unity (see GL/PCT-EPO C-V, 1) or a WO-IPEA (see GL/PCT-EPO C-IV, 2.2) has to be sent, this will happen as soon as possible without awaiting the SISR.

If neither an invitation to pay additional fees in case of lack of unity nor a WO-IPEA needs to be sent out before the IPER is established, the examiner waits until 27 months from the priority date to establish the IPER to allow the SISR to arrive and be taken into account.

Rule 45bis.8(c)

If the IPER has not yet been established, the examiner will take the SISR into account when establishing the IPER.

2.4 Files arriving late

If the demand has been validly received by the EPO very late, the examiner will telephone the applicant and explain the situation. In such cases applicants will then be asked whether they prefer to:

- discuss the application over the phone and receive a short time limit to file amendments (e.g. one to two weeks, set by the telephone minutes); or
- receive a WO-IPEA with a short time limit (e.g. one to two weeks); or
- receive a negative IPER without further interaction; or
- receive a WO-IPEA with a longer time limit, in which case the IPER will be issued late.

In those very exceptional cases where the file is so late that even with a time limit of one to two weeks the IPER would be issued after 28 months, applicants will be asked whether they would like a time limit to file amendments although the IPER will be late or prefer a timely but negative IPER without further interaction.

In the above-mentioned exceptional cases where after a telephone consultation the applicant does not wish to file amendments/observations but agrees that a negative IPER can be established directly, the examiner will send a direct negative IPER.

2.5 Request for a further written opinion

Frequently applicants explicitly request a further written opinion (under Chapter II) if the examiner's opinion is still negative. If the applicant has not yet had a further opportunity to file amendments in Chapter II, this request must be granted (see GL/PCT-EPO C-IV, 2.2).

If the applicant has already had a further opportunity to file amendments, then as a rule the IPER is issued directly (see however also GL/PCT-EPO C-IV, 1).

3. Late-filed reply after a first or further WO-IPEA (408) has been sent

In the PCT procedure, there is no loss of right for applicants if they do not meet the time limits for replying to a written opinion. The only risk the applicant takes with a late reply is that it might not be taken into account for establishing the IPER.

Rule 66.4bis
Rule 80.5
Rule 82
Rule 82quater
GL/ISPE 19.32
GL/ISPE 19.50

In practice, if the applicant's reply is received after the time limit set in the WO-IPEA (Form 408) but before an IPER (Form 409) has been started, the late-filed reply is taken into consideration for drawing up the IPER.

GL/ISPE 19.33

If a reply is received after the IPER has actually been started and the applicant has not met all the objections set out in the last written opinion, the

late reply is not considered and the IPER is drawn up on the basis of the conclusions set out in the last WO-IPEA.

If a reply is received after the IPER has actually been started and all the objections set out in the last WO-IPEA have been met, the late-filed reply is taken into consideration for drawing up the IPER.

If no reply has been received, the IPER is drawn up on the basis of the conclusions set out in the last WO-IPEA.

4. Consequences of a restriction of the search

4.1 Submissions prompted by a restriction of the search or a declaration that no search is possible

Rule 66.1(e)

If the search covered only some claims or part of one or more claims (see GL/PCT-EPO B-VIII), only the subject-matter which has been searched - as indicated in the ISR (GL/PCT-EPO B-X, 8) and/or in the WO-ISA (GL/PCT-EPO B-XI, 6) - can be the object of the international preliminary examination. It should always be made clear which claims have been examined.

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

After a restriction of the search, either because subject-matter is excluded from the search or because a meaningful search is not possible, or after a declaration that no search at all is possible, the applicant's reply may, at subsequent stages of the procedure, challenge the ISA's findings.

However, the IPEA has no responsibility for actions taken by the ISA, and there is no provision in the PCT for an IPEA review of, or for an appeal against, such an ISA decision.

Any written arguments from the applicant relating to the completeness of the search are not to be treated as a communication with the IPEA, unless the applicant's reply contains a complaint against the findings at the search stage when the EPO acted as ISA (see GL/PCT-EPO C-IX, 4).

If the reply to the WO-ISA contains arguments challenging the findings at the search stage related to the restriction of the search, the examiner will mention in the WO-IPEA or IPER (under Section III) that the findings of the ISA cannot be reviewed by the IPEA.

Rule 66.1(e)

If the applicant phones the examiner to discuss the issue orally, the examiner will inform the applicant that this is a matter which is the responsibility of the ISA under Chapter I of the PCT and that the procedure before the ISA is closed.

If the reply contains amended claims introducing unsearched matter, the applicant will be informed in the IPER (under Section III) that an opinion cannot be given for unsearched matter.

As explained in GL/PCT-EPO B-VIII, 1, an additional search may be made after entry into the European phase, in the examination phase, if the reasons

for restricting the search can be overcome (see also GL/EPO C-IV, 7.3). This additional search is at no additional cost to the applicant.

4.2 Consequences of a declaration of no search or an incomplete search in subsequent European procedure

For unsearched subject-matter, no written opinion is established under PCT Chapter I and no examination is carried out under PCT Chapter II. Furthermore, there is no possibility to appeal the decision of the ISA (see GL/PCT-EPO C-IV, 4.1), so that even if the applicant were to succeed in convincing the examiner under Chapter II that the decision not to search certain subject-matter was incorrect, this has no consequences. However, in the European procedure the examining division must review the decision of the search division (examiner) and take a final decision. This implies that in the European phase for the Euro-PCT application the examiner might have to reverse the decision of the ISA and perform a complete search (either because of the arguments filed or because of the claims having been redrafted so that a search can now be performed, see also GL/EPO C-IV, 7.3).

5. Top-up searches in PCT Chapter II

A top-up search is mandatory at the outset of PCT Chapter II, subject to some exceptions (see GL/PCT-EPO C-IV, 5.2). The date – or absence – of this top-up search must be indicated in the IPER.

*Rules 66.1ter and
Rule 70.2(f)
OJ EPO 2014, A57
GL/ISPE 19.15,
19.19-19.20*

5.1 Timing, basis and forms

The top-up search will be conducted before/at the same time as issuing the first WO-IPEA (Form 408)/telephone consultation or, where no written opinion is produced, the IPER (Form 409) (approximately within a month of the start of international preliminary examination). A further top-up search before issuance of the IPER is normally not necessary.

GL/ISPE 19.18

In the case of non-unity where there is more than one invention claimed for which examination under Chapter II is demanded, the examiner will first issue an invitation to pay additional examination fees (Form 405) and then perform the top-up search for all inventions for which additional examination fees have been paid.

*Art. 34(3)(a)
GL/ISPE 19.16*

The IPEA must indicate in the IPER whether or not a top-up search has been done. The date indicated in the form is the date of the latest top-up search. The box which indicates that no top-up search has been done is only ticked if all the claims are exempted from top-up search.

Rule 70.2(f)

5.2 Exemptions from top-up search

As a general rule, a top-up search will be conducted for all the claims forming the basis for the Chapter II examination, as indicated in boxes I and III of the WO/IPER.

GL/ISPE 19.15

A top-up search is not conducted on:

Rule 66.1ter

(a) subject-matter not searched by the ISA;

Rule 66.1(e)

Art. 34(3) (b) non-unity cases – inventions for which additional search fees were paid, but not additional examination fees;

Art. 34(4) (c) subject-matter which, although not excluded from the search, is excluded from preliminary examination;

In addition to what is mentioned in Rule 66.1 *ter* PCT, the top-up search may be refused or limited by the EPO as IPEA:

Art. 34(2)(b) and 19(2) (d) where amendments contain added matter;

GL/ISPE 19.17 (e) where there is no letter explaining the basis for amendments and/or
Rule 46.5(b) and 66.8 indicating what has been amended in the application;

(f) where the EPO as ISA would not cite any documentary evidence as to the relevant state of the art (e.g. in case of "notorious knowledge" in the field of computer-implemented inventions).

Rule 70.2(c) In case (d) above, the examiner will perform the top-up search based on either the previous set of application documents or the amended set, ignoring the added subject-matter. In case (e) above, the same applies to unsupported amendments (see GL/PCT-EPO C-III, 4).

Where a top-up search is made for some claims or part of claims, there is no indication of:

- which claims are not covered by the top-up search (this should be derivable from the indications in Sections I and III of the WO/IPER); or
- why no or only a partial top-up search has been made.

5.3 Documents newly found in the top-up search, when further objections are present

GL/ISPE 3.22 If the top-up search reveals pertinent prior art, according to present practice a WO-IPEA or a telephone consultation is the first action in **Chapter II** (see GL/PCT-EPO C-IV, 2.2). If a positive WO-ISA was drafted or the objections in the negative WO-ISA have been overcome by the applicant's amendments/arguments, see GL/PCT-EPO C-IV, 5.4.

GL/ISPE 19.21 The documents found are indicated as follows:

Rule 64.3 (a) If the newly found documents are published after the filing date (E documents) and are relevant for novelty, they are mentioned in Section VI of the WO-IPEA and IPER (for the level of detail see GL/PCT-EPO B-XI, 4.3).

Rule 64.1 (b) If the newly found documents are published before the priority date and are relevant for novelty and/or inventive step, they are mentioned in Section V of the WO-IPEA and IPER and detailed reasoning is provided.

- (c) If the newly found documents are published in the priority period (P documents) and are relevant for novelty and/or inventive step, and if the priority is (assumed to be) valid, the documents are mentioned in Section VI of the WO-IPEA and IPER; comments are optional (see GL/PCT-EPO B-XI, 4.2). This applies only if there are other objections; otherwise, see GL/PCT-EPO C-IV, 5.4.
- (d) If the newly found documents are published in the priority period (P documents) and are relevant for novelty and/or inventive step, and if the priority is invalid, the documents are mentioned in Section V of the WO-IPEA and IPER and detailed reasoning is provided.

Documents found during the top-up search and mentioned in the WO-IPEA will also be mentioned in the IPER, unless rendered irrelevant by amendments or arguments provided by the applicant during the international preliminary examination. It will be always indicated in Box I of the IPER that additional relevant documents were found during the top-up search.

5.4 Intended positive IPER and top-up search

If a positive WO-ISA was drafted or the objections in the negative WO-ISA have been overcome by the applicant's amendments/arguments, and if the top-up search reveals:

- (a) no relevant documents, a positive IPER is issued directly.
- (b) pertinent prior art published before the priority date, a WO-IPEA or telephone minutes is/are issued (GL/PCT-EPO C-IV, 2.2). Details of how the document is indicated can be found in GL/PCT-EPO C-IV, 5.3(b).
- (c) only P/E documents which are (could become) prior art under Art. 54(3) EPC in later EP proceedings (independently of the validity of the priority), a WO-IPEA with detailed novelty reasoning is sent (GL/PCT-EPO B-XI, 3.4); the document is introduced in Section VI and its possible relevance upon entry into the EP phase is indicated. Details of how the document is indicated can be found in GL/PCT-EPO C-IV, 5.3(a).
- (d) other P/E documents relevant for novelty and if the priority is (assumed to be) valid, a positive IPER is sent directly (GL/PCT-EPO B-XI, 3.4), and the document is mentioned in Section VI of the IPER.

Rule 64.1

Chapter V – Unity of invention

1. Unity of invention under Chapter II

If an invitation to pay additional fees was issued during Chapter I and the applicant paid some or all of the required additional fees, and if, where applicable, the objection as to lack of unity was at least partly upheld during a protest procedure, then under Chapter II the applicant will normally be invited (using Form 405) to pay additional examination fees if all the searched inventions are also to be examined under Chapter II. Inventions for which no search fees were paid cannot be pursued and will thus also not be objected to or commented on. A review of the decision taken under Chapter I is not provided for in the PCT.

Art. 34(3)(a)-(c)
Rule 68.2
GL/ISPE 10.74

A single WO-IPEA/IPER is then drafted by the examiner, dealing with all the inventions for which examination fees have been paid.

In reply to the WO-ISA the applicant may have filed redrafted claims which differ substantially from those for which lack of unity was raised. In such a case it should be carefully considered whether:

- the lack of unity objection still applies to the new set of claims
- the amended claims relate to searched subject-matter
- the reasoning as to lack of unity has to be amended because of the new claims and/or the arguments presented.

Normally, the examiner under Chapter II agrees with the objection made at the search stage. Exceptionally, if this is not the case (e.g. if the search and WO-ISA were made by another office), it is possible to send out an invitation to pay further examination fees (Form 405) even if this was not done at the search stage. However, if a lack of unity objection was raised at the search stage resulting in a partial search and a different conclusion is reached under Chapter II, there is no possibility to ask for an additional search for unsearched subject-matter. In this case, examination in Chapter II is restricted to what has been searched.

Furthermore, it is possible that the original claims did not lack unity but the amended claims do. In such a case, if the amended claims lacking unity relate to unsearched subject-matter, they are not examined, and a WO-IPEA/IPER is established on searched subject-matter only (no Form 405 is to be sent out). It is also possible that the amended claims do not lack unity, but that these amended claims relate to subject-matter lacking unity with the originally searched invention or group of inventions. In such a case, the applicant is informed that the amended claims will not be examined in a WO-IPEA/IPER (no Form 405 is sent out). On the other hand, if e.g. the applicant has generalised the original independent claim so that it is no longer novel and lack of unity a posteriori occurs, then an invitation to pay additional fees is sent before the WO-IPEA/IPER.

Rule 66.1(e)

For information on the exceptional situation of a non-unitary application, where all inventions examined were found novel and inventive, but still lacking unity as the only remaining objection, see GL/PCT-EPO C-VIII, 3.

2. No payment of additional search fees

If, in reply to the objection to lack of unity at the search stage, the applicant has not paid additional search fees, the WO-IPEA/IPER is based on the claims for which the search report and the WO-ISA have been drafted, taking amendments and arguments from the applicant into account. Section IV is not filled out.

3. Searched claims did not comply with unity of invention

3.1 Payment of additional search fees without protest

If, in reply to the objection to lack of unity at the search stage, the applicant has paid additional search fees without protest, and the application still lacks unity, the objection indicated on Form 206 and in the WO-ISA will normally be confirmed, where necessary adapted to the amendments/arguments filed by the applicant.

Art. 34(3)(a)
Rule 68.2

Form 405 is sent out, requesting additional examination fees only for those inventions which have been searched and which are still present in the claims.

3.2 Payment of additional search fees under protest

Rule 68.3(c)
GL/ISPE 10.78

If, in reply to the objection to lack of unity at the search stage, the applicant has paid additional search fees under protest and

- (a) the Review Panel decided that the protest was fully justified, no invitation to pay additional fees (Form 405) is sent. The Review Panel's decision is followed and the WO-IPEA/IPER is established for all searched inventions;
- (b) the Review Panel decided that the protest was partly justified, an invitation to pay additional fees (Form 405) is sent, with the reasoning and the number of inventions adapted to the Review Panel's decision.

The examiner should ensure that the lack of unity objection raised at the search stage is still valid for the newly filed claims.

3.3 No request for payment of additional search fees

Rule 68.1
GL/ISPE 10.76

If, at the search stage, an objection of lack of unity was raised but exceptionally it was chosen not to request the applicant to pay additional search fees, the examination is carried out on the entire application. No invitation to pay additional fees (Form 405) is sent; instead, the WO-IPEA/IPER is established for all searched inventions. Under Section IV, it is indicated that the requirement of unity is not fulfilled.

4. Applicant's reply to the invitation to pay additional fees (Form 405)

4.1 No payment of additional examination fees or failure to reply

If, in reply to the invitation in Form 405, the applicant neither restricts the claims nor pays additional examination fees, or if the applicant does not reply, the WO-IPEA/IPER is established on the basis of the main or first invention mentioned in the invitation to pay additional fees (Form 405) and for which the search fee has been paid. Section IV is filled out and the reasons for lack of unity are given on the separate sheet.

Art. 34(3)(c)
Rule 68.4-68.5
GL/ISPE 10.75

If, in reply to the invitation in Form 405, the applicant restricted the claims, the examiner has to check whether the restricted set of claims is unitary and whether all claims relate to searched subject-matter.

If this is the case, the WO-IPEA/IPER is established on the restricted set of claims, and Section IV is not filled out.

If this is not the case, the WO-IPEA/IPER is established on the main or first invention mentioned in Form 405 and for which the search fee has been paid; Section IV is filled out, and any claims relating to non-searched subject-matter are indicated in Section III.

4.2 Payment of additional examination fees without protest

If, in reply to the invitation in Form 405, the applicant pays additional preliminary examination fees without protest, the WO-IPEA/IPER is established on the basis of those inventions for which examination fees have been paid. Section IV is filled out and the reasons for lack of unity are given on the separate sheet.

If, in reply to the invitation in Form 405, the applicant restricted the claims and paid additional fees, the examiner has to verify that the restricted set of claims does not contain more inventions than those for which additional fees have been paid and that the restricted claims relate to subject-matter that has been searched.

If this is the case, the WO-IPEA/IPER is established on the restricted set of claims, and Section IV is filled out.

If this is not the case, the WO-IPEA/IPER is established on as many inventions mentioned in Form 405 as additional fees have been paid for. Section IV is filled out and any claims relating to unsearched subject-matter are indicated in Section III.

In both cases the reasons for the lack of unity are given on the separate sheet.

4.3 Payment of additional examination fees under protest

In reply to Form 405, 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 C-V, 5).

Rule 68.3(c) and (e)
GL/ISPE 10.78

5. Protest procedure

Rule 68.3(c), (d)

The protest procedure consists of a review within the IPEA first by the formalities officer and then by a Review Panel.

5.1 Admissibility of the protest as checked by the formalities officer

Rule 68.3(c), (e)
GL/ISPE 10.79

Before initiating the protest procedure the formal admissibility of the protest in the sense of Rule 68.3(c) (Chapter II) must be checked.

To be admissible the protest should satisfy the following requirements:

- (a) The applicant must have paid the prescribed protest fee (Rule 68.3(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 405 (Chapter II).

The reasoned statement must comply with Rule 68.3(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 examination 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 420 or Form 424. Any substantive analysis is made by the Review Panel when assessing the justification of the protest.

5.2 The work of the Review Panel

GL/ISPE 10.80

For the composition and purpose of the Review Panel, see GL/PCT-EPO B-VII, 7.2. The names of the members of the Review Panel are made public on Form 420.

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.

GL/ISPE 10.81

If the Review Panel determines that the protest is wholly justified, it will inform the applicant with Form 420 (Decision on Protest Chapter II). This also applies if the Review Panel's finding results in the application not lacking unity. It is not necessary to give any reasoning 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 examination will be carried out on the inventions for which the fees are paid, and the non-unity reasoning and the number of inventions in the IPER (or WO-IPEA) will be adapted to the Review Panel's decision.

If the Review Panel considers that the protest is not justified at all, it will communicate this to the applicant using Form 420. Reasoning must be given, indicating why the request for payment of additional fees is upheld and addressing the applicant's relevant arguments. The examination will be carried out on the inventions for which the fees are paid.

If the Review Panel considers that the protest is only partially justified, it will communicate this to the applicant using Form 420. Reasoning must be given, indicating why the request for payment of the additional fees is partially upheld and addressing the applicant's relevant arguments. The examination will be carried out on the inventions for which the fees are paid, and the non-unity reasoning and the number of inventions in the IPER (or WO-IPEA) will be adapted to the Review Panel's decision. 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 420) will be sent out together with the WO-IPEA or IPER in order to ensure that both are consistent.

GL/ISPE 10.82

Chapter VI – Time limits

1. Start of the international preliminary examination

The EPO as IPEA will start the international preliminary examination when it is in possession of all of the documents and fees required under Rule 69.1(a). It will not wait until the applicable time limit under Rule 54bis.1(a) has expired unless the applicant expressly requests it to do so.

Rule 69.1(a)
Rule 54bis.1(a)
GL/ISPE 19.07

Where the statement concerning amendments filed with the demand indicates that the applicant would like the international preliminary examination to take into account amendments under Article 34 but the applicant failed to submit them with the demand, the IPEA will invite it to do so within a set time limit, pursuant to Rule 60.1(g) (Form PCT/IPEA/431). The IPEA will not start the international preliminary examination until it has received them or before expiry of the time limit set in the invitation pursuant to Rule 60.1(g), whichever occurs first.

Rules 53.9(c),
60.1(g), 66.4bis,
69.1(e)

Similarly, where the applicant would like the international preliminary examination to take into account amendments under Article 19 and any accompanying statements, the IPEA will not start the international preliminary examination before it has received a copy of the amendments.

The EPO as IPEA does not apply Rules 69.1(b) and 69.1(b-bis), i.e. it will not start the international preliminary examination at the same time as the international search.

2. Time limit for international preliminary examination

The time limit for establishing the international preliminary examination report is laid down in Rule 69.2. Where the documents required for the preliminary examination were received in due time, the EPO will establish the IPEA within 28 months from the priority date.

Rule 69.2(i)
GL/ISPE 3.24, 19.10

The applicant has a time limit of 31 months from the priority date to enter the European phase before the EPO.

Rule 159(1) EPC
Art. 22(1), (3)
Art. 39(1)(a), (b)

3. Extension of the time limit

Failure to meet the time limit set in the WO-ISA or the WO-IPEA does not constitute a formal loss of rights; see GL/PCT-EPO C-IV, 3.

Requests for extension of the time limit for replying to the WO-ISA where it is considered as a first opinion of the IPEA are handled by the formalities officers. As a rule, a one-month extension will be granted if requested before expiry of the normal time limit under Rule 54bis and on condition that the time limit so extended does not expire later than 25 months from the (earliest) priority date; further extensions are not allowed. The extension does not apply to the time limit for filing the demand, which cannot be extended.

A request for extension of the time limit to reply to a WO-IPEA (Form 408) will be granted only if there is sufficient time available to grant the extension in view of the time limit laid down in Rule 69.2(i), i.e. if the extended time limit

Rule 66.2(e)

does not expire later than 27 months from the earliest priority date and the request is made prior to expiry of the set time limit.

If the ISR was delayed so that the time limit of 28 months for establishing the IPER cannot be met, the request for extension should be granted.

Chapter VII – Other procedures in examination

1. Request for an interview or telephone consultation

Art. 34(2) gives the applicant the right to communicate orally with the IPEA. Thus, a request for a telephone conversation from the applicant or the agent (including those overseas) will be granted, but only after the subject-matter on which the international preliminary examination is to be based has been clarified, i.e. only after the applicant has filed a written response to the WO-ISA, or, if the international search report has raised an objection of lack of unity, to an invitation to restrict the claims or to pay additional fees (Form 405). In that way, the subject-matter to be discussed in the telephone conversation is clarified upfront. Requests for personal interviews are not granted. However, if a personal interview is requested, the examiner should inform the applicant by phone that it is the EPO's policy not to grant personal interviews, but that the matter can be discussed in the form of a telephone consultation subject to the above condition.

Art. 34(2)

Rule 66.6

GL/ISPE 19.41-19.46

If the applicant has requested a telephone consultation the following applies:

OJ EPO 2011, 532

- (a) as a general rule the applicant has, upon request, the right to one telephone consultation;
- (b) after a telephone consultation the applicant should in general be given a time limit (normally two months) to file amended claims and/or arguments. If, in a telephone consultation, the applicant has expressed the intention not to file further observations/amendments, in other words if the applicant has agreed to receive an IPER without further interaction, minutes of the telephone consultation are sent and these are directly followed up with a negative IPER. No time limit is set in the minutes.
- (c) if, before issuance of the (further) written opinion (Form 408), the applicant has requested a telephone consultation or alternatively a further written opinion, the examiner has the discretion to decide which kind of interaction is most suitable for the application in question;
- (d) in the specific case of a telephone consultation being requested after issuance of the further written opinion but before the date on which the IPER is established, the request must be granted before a negative IPER is issued. However, in this case the applicant does not have the right to file further amendments, unless an agreement has been explicitly reached (see below).

Rule 66.6

Rule 66.6

When a telephone consultation is arranged, the matters for discussion should be clearly stated in advance. If the arrangement is made by telephone, the examiner should record the particulars and briefly indicate in the file (Form 428: minutes of telephone conversation) the matters to be discussed as well as the date and time for the consultation. A copy of the arrangements recorded is sent to the applicant.

GL/ISPE 19.45

If the applicant wishes to discuss amended claims during a telephone consultation, a copy of such claims should be sent in advance to the examiner in order to enable appropriate preparation. The time limit for such submissions will be set by the examiner on the record of the arrangement.

GL/ISPE 19.46

The result of the telephone consultation is recorded by the examiner and added to the file. The recording will depend upon the nature of the matters under discussion and will be forwarded to the applicant.

If the consultation replaces the second written opinion or takes place after a reply to a second written opinion but has ended with an agreement on amendments, Form 428 will include:

- a warning that the amendments cannot be made by the IPEA and
- an invitation for the applicant to file amended sheets normally within one month, but at least one month before the deadline for the IPER (unless as agreed with respect to the late issue of the IPER).

In those cases where the consultation takes place after a reply to a second written opinion and no agreement has been reached, applicants are informed that their arguments will be taken into account when establishing the IPER.

Enquiries as to the processing of files may be filed online using the dedicated form (EPO Form 1012) (see the Notice from the EPO dated 2 August 2016, OJ EPO 2016, A66).

2. Confidentiality

Art. 38
Rule 94.2
GL/ISPE 3.26

Without the applicant's authorisation, the IB and the EPO as IPEA may not allow access to the file of the international preliminary examination by third parties, except by the elected Offices once the IPER has been established.

Art. 36(3)
Rule 71.1(a)
Rule 73.2
Rule 94.1(c), (d), (e)
GL/ISPE 3.25A

Once the IPER has been established and transmitted to the IB, the latter sends a copy of the IPER, together with its translation (as prescribed) and its annexes (in the original language), to each elected Office. As from that time, the IB, on behalf of the EPO as elected Office, also furnishes copies of the IPER as well as of any document transmitted to it under Rule 71.1 by the IPEA to anyone who requests them.

Rule 94.2(b), (c)

Once the IPER has been established, at the request of any elected Office, the EPO as IPEA will provide access to any document contained in its file, except to any information in respect of which it has been notified by the IB that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule 94.1(d) or (e).

Rule 94.1(c)
Rule 94.3
GL/ISPE 3.27

Provided international publication has taken place, once the IPER has been established, third parties may access the file of the international preliminary examination via those elected Offices whose national law allows access by third parties to the file of a national application (see also GL/EPO E-IX, 2.10). Such access may be allowed to the same extent as provided by the national law for access to the file of a national application.

3. Examination of observations by third parties

For details on third-party observations please refer to GL/PCT-EPO E-II.

For relevant third-party observations in Chapter II the following applies:

GL/ISPE 17.69

- (a) If a negative IPER is envisaged and a second written opinion has not been sent, a WO-IPEA (Form 408) is drafted taking into account the third-party observations and the applicant's comments where available, and referring to the new prior-art documents in section V (see also GL/PCT-EPO C-IV, 2.2).
- (b) If the IPER would have been negative even without the third-party observations and a WO-IPEA has already been sent before receipt of these observations, no further written opinion is sent before establishment of the IPER.
- (c) If a WO-IPEA has already been sent before receipt of the third-party observations and the IPER would have been positive without the third-party observations, a new WO-IPEA is issued or the applicant is called, whichever course of action is considered the more expedient, in particular in the light of the deadline for issuing the IPER.

In cases (b) and (c) above, the IPER is established taking into account the third-party observations and the applicant's comments, and referring to the new documents where appropriate in Section V of the IPER.

- (d) If a positive IPER is envisaged since, even though the third-party observations may refer to more relevant documents than the ones on file, they do not prejudice novelty and inventive step, the newly cited relevant documents are dealt with in the reasons in favour of patentability in Section V on the separate sheet as appropriate.

If the documents are relevant but do not add anything to what was already available, it is left to the examiner's discretion whether they need to be quoted in the IPER. For example, in those cases where the documents are a better starting point for the problem-solution approach, examiners may wish to review their argumentation in support of the positive assessment of inventive step.

Third-party observations which are not relevant or not sufficiently understandable (see GL/PCT-EPO E-II for observations not in an EPO official language) do not need to be dealt with substantially in the WO-IPEA and/or in the IPER. A comment is included in Section V of the WO-IPEA and/or in the IPER 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 and why.

Chapter VIII – The IPER

1. Opinion given in the IPER (Form 409)

Art. 35(2) specifies that the report shall not contain any statement on the question of whether the claimed invention is or seems to be patentable or unpatentable according to any national law. Moreover, the purpose of the preliminary examination is merely to give an opinion, but it does not lead to a grant or a refusal of the application. In these circumstances, therefore, the report should not give the impression that any part of the application may or may not be allowable. It will only state whether or not the claims meet certain criteria.

Art. 35(2)
GL/ISPE 19.48

2. Completing the IPER

The IPER is drafted in the same way as the WO-ISA, i.e. a positive or negative opinion will be given for all claims, taking into account the arguments and/or amendments submitted by the applicant.

Therefore, the same criteria apply to the IPER as to the WO-ISA with respect to all examination issues (see also GL/PCT-EPO B-XI).

In particular the IPER will only be established for claims which have been searched (as indicated in the WO-ISA); any amended claims that are directed to subject-matter not searched will not be considered and an indication will be made in Section III of the IPER (non-establishment of opinion), with reasons given on the separate sheet.

Rule 66.1(e)
GL/ISPE 19.25

If no reply has been received to a written opinion or the objections raised in a previous written opinion are still valid, the comments contained in that written opinion can be transferred to the corresponding section in the IPER. However, if the applicant has submitted arguments in favour of the claims, then even if the objections previously raised are still valid, the examiner should, in a neutral way (i.e. without direct reference to the letter of reply in the sense of "see reply/arguments from the applicant"), deal with at least the main arguments from the applicant in order to ensure that the applicant knows that the arguments made have been considered.

If arguments, facts and evidence, such as the results of a comparative test, produced by an applicant in response to a written opinion are of crucial importance in assessing inventive step, the examiner may base the argumentation in the IPER on the applicant's response. This is of importance to other offices which need to know why a particular conclusion has been reached. However, since the IPER should be written in a neutral way and should be self-contained, the examiner should not append to the IPER portions of the applicant's reply or refer directly to the applicant's letter of reply.

2.1 Sequence listings

Rule 5.2
Rule 13ter.2
Rule 66.1(e)
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,
15.13 and 17.37

Where no (complete) international search was carried out because the applicant did not file an electronic sequence listing conforming to WIPO Standard ST.26 in response to a request from the ISA or did not pay the late furnishing fee, the IPER will indicate under Section III that the examination is limited according to Rule 13ter.2 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 13ter.1(a) (no computer-readable sequence listing). The examiner also indicates in Section III of the IPER that the examination is also limited according to Rule 66.1(e) because the search was incomplete.

Where a sequence listing in electronic form and compliant with WIPO Standard ST.26 is not available to the EPO as IPEA, the applicant may be invited to furnish such a sequence listing under Rule 13ter.1(a) and to pay the late furnishing fee under Rule 13ter.1(c) within a non-extendable period of one month from the date of the invitation.

3. Positive or negative IPER

As for the WO-ISA, the examiner needs to indicate whether the IPER is to be considered positive or negative. The same criteria apply as in GL/PCT-EPO B-XI, 3.4.

In the special case of a non-unitary application, where all inventions examined (normally after issuance of an invitation to pay additional fees (Form 405); see GL/PCT-EPO C-V, 1) were found novel and inventive, but still lacking unity – as the only remaining objection – the IPER is marked as negative. Under Section V, a positive statement as to novelty and inventive step is given for all examined inventions, and the objection as to lack of unity is reasoned under Section IV.

In this special case, the negative IPER can be sent directly without any further written opinion, as an exception to the general principle outlined in GL/PCT-EPO C-IV, 2.2, that prior to issuing a negative IPER a WO-IPEA (Form 408) is to be sent. The reason for this exception is that the applicant is entitled to have multiple inventions examined in Chapter II if additional fees have been paid, so that there is no objection to be raised in the WO-IPEA.

In the case of a non-unitary application where no additional search fees were paid and the report on the first invention is positive, the IPER is also marked as negative (because the non-unity objection will prevent a direct grant upon entry into the European phase) and can be sent directly. Under Section V, a positive statement as to novelty and inventive step is given for the first invention only. Section IV is not filled out (see GL/PCT-EPO C-V, 2).

4. Rectification of the IPER

Rule 66.4bis

Since an IPER is a non-binding opinion and not a decision, the PCT provides for neither opposition nor appeal against it. Establishment of the IPER is normally the end of the international phase. Any further observations or amendments the applicant wishes to make should therefore be addressed to the elected Offices and not to the IPEA.

GL/ISPE 19.34

Only when there is an error in the IPER or the IPER has been issued when in fact a second written opinion should have been issued (see GL/PCT-EPO C-IV, 2.2) will the file be transmitted to the examiner to decide whether or not to issue a corrected IPER.

In rare cases, the report may be incorrect, for example because it was based on wrong application documents or citations which are wrongly cited or are not comprised in the state of the art or on new documents cited for the first time in the IPER, or because amendments to the claims were overlooked.

In such cases, if there is at least one week before the actual deadline (normally 28 months from the priority date), a new Form 409 is completed with the correct information, and the corrected IPER is sent to the applicant and to WIPO.

GL/ISPE 19.35

In cases where there is less than one week before that deadline, or where the deadline has expired, applicants are called to ask whether they still wish to receive a corrected IPER. If this is the case, a corrected IPER is issued. If the applicant declines to wait for a corrected IPER because of the deadline, Form 428 (minutes of telephone consultation) is completed, indicating the error in the IPER such that, in the regional phase, the applicant may cite the content of this form as evidence, and Form 428 is transmitted for information.

If, despite the applicant's request for rectification, the IPER does not contain any of the defects mentioned above, the formalities officer informs the applicant with a standard letter that the international preliminary examination phase has come to an end. Any further comments may only be addressed to the elected Offices on entry into the national phase.

Chapter IX – Special requests

1. Withdrawal of demand under **Chapter II**

Applicants are entitled to a refund of the whole amount of the international preliminary examination fee if the demand is withdrawn before 30 months from the priority date and on condition that international preliminary examination has not started. If the examiner has actually started to examine the file, no refund will be made. The starting date of international preliminary examination can in most cases be derived from Form PCT/IPEA/409, which in Box I, point 6, indicates the date of the top-up search (Rule 70.2(f)). GL/PCT-EPO C-IV, 5.1, explains that the top-up search is conducted at the start of international preliminary examination and is usually not repeated before the IPER is issued.

Rule 58.3
Rule 90bis.4
OJ EPO 2017, A115
OJ EPO 2018, A24

The withdrawal of the demand will be effective upon receipt of a notice from the applicant to the IB. However, the applicant may also submit the notice of withdrawal to the EPO as IPEA. In this case, the EPO as IPEA marks the date of receipt on the notice and transmits it promptly to the IB. The notice is considered to have been submitted to the IB on its date of receipt at the EPO as IPEA.

The signature of each applicant is required if the demand under **Chapter II** is withdrawn.

Rule 90bis.5

2. Request for examination of a different set of claims

The filing of different sets of claims for different elected States or of different (main and auxiliary) requests based on different sets of claims is not accepted since examining such claims is both time-consuming and against the intention of the PCT. Auxiliary requests are not provided for under the PCT because Rule 66.1(c) provides that, where Art. 19 amendments are made, the international preliminary examination is based on these amendments, unless they are superseded or reversed by a later amendment under Art. 34, and furthermore because Rule 70.16(a) provides for the annexing of the latest set of application documents to the IPER. The simultaneous examination of several co-pending requests is not compatible with the sequential consideration of single requests provided for in the above-mentioned Rules.

Rule 66.1(c)
Rule 70.16(a)

If it is clear which request is the preferred (e.g. the main request), the WO-IPEA/IPER is established on that request; a remark is added in the WO-IPEA/IPER that the treatment of different requests (or main and auxiliary requests) is not provided for under the PCT.

If it is not clear which request is preferred (different requests with no preferred order), the applicant is asked, preferably by telephone, to furnish one set only or to state which set/request should be used for the examination.

If the applicant does not reply and/or insists on a plurality of sets, the WO-IPEA/IPER is drawn up on the first set, with a remark on the separate sheet under Section I.

3. Request for examination of certain claims only

Applicants sometimes file a request for examination of certain claims only without actually restricting the set of claims, e.g. in order to achieve a positive IPER although the findings for some claims would be negative. An example would be where in reply to the WO-ISA, which contained a negative opinion on claims 1-5 and a positive one on claims 6 and 7, the applicant does not change the claims but asks that the IPER be established for claims 6 and 7 only.

Art. 34(3)(c)
Art. 34(4)(a)(i) and (ii)
Art. 35(2)

A request for examination of certain claims only is not accepted since the IPER is established on the claims on file and can only be restricted by the examiner, e.g. on the grounds of lack of unity with not all fees paid, unsearched claims, clarity or added subject-matter. A restriction at the request of the applicant would be contrary to Art. 35(2), which states that the IPER relates to "each claim". In such a case the applicant is informed that unless a restricted set of claims is filed the IPER will be established for all claims.

4. Complaint against the findings at the search stage

Art. 17(3)(a),
Art. 17(2)(a)(i) and (ii)

If the search was restricted and the applicant complains about the findings at the search stage, the complaint will be dealt with by the Complaint Handling Unit at the EPO.

In order to ensure that a submission is treated as a complaint, applicants are advised to use the online complaint form and explicitly state that their reply is to be considered as a complaint. A letter of reply in which an applicant submits only substantive counterarguments contesting the findings of the ISA is not a complaint (see also GL/PCT-EPO C-IV, 4.1).

While there is no provision for a review based on substantive arguments, the ISA may exceptionally have to issue a corrected ISR in the event of a procedural flaw.