PCT – Part F

The International Application

Contents

Chapter I – Introduction

Apart from the requirements of novelty, inventive step and industrial application, and the exclusion of subject-matter for which the ISA and/or IPEA is not required to carry out search and international preliminary examination, an international application must also satisfy a number of other requirements which are checked by the EPO as ISA and/or IPEA and reported on in the written opinion and/or IPER, as appropriate. These include substantive requirements such as sufficiency of disclosure (Art. 5), clarity of the claims (Art. 6) and unity of invention (Rule 13) as well as formal requirements such as the numbering of the claims (Rule 6.1) and the form of the drawings (Rule 11.10 to 11.13). These requirements are dealt with in the present Part F.

Rule 43bis.1(a)
Rule 66.2(a)

Part F also deals with the requirements relating to the right to priority.

Chapter II – Content of an international application (other than claims)

1. General

The contents of the international application are set out in Article 3(2). The application must contain: *GL/ISPE 4.01*

(i) a request;

(ii) a description (see GL/PCT-EPO F-II, 4);

(iii) one or more claims (see GL/PCT-EPO F-IV);

(iv) one or more drawings (where required; see GL/PCT-EPO F-II, 5); and

(v) an abstract (see GL/PCT-EPO F-II, 2).

This chapter discusses items (ii), (iv) and (v) insofar as they are the concern of the ISA and IPEA. Item (v) is dealt with first.

2. Abstract

2.1 Purpose of the abstract

An international application must contain an abstract. The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought. *Article 3(2), 3(3)*

2.2 Definitive content

The abstract is initially supplied by the applicant subject to the exception provided for under Rule 38.2. The examiner conducting the main international search has the task of determining its definitive content, which will normally be published with the application. In doing this, he should consider the abstract in relation to the application as filed. If the search report is published later than the application, the abstract published with the application will be the one resulting from the procedure referred to in ISPE Guidelines 15.40. *Rules 8, 44.2*

This procedure does not apply to supplementary international searches for which the EPO is SISA, because the main ISA has already provided the publication data (see GL/PCT-EPO B-XII, 2). *GL/ISPE 16.34*

See also ISPE Guidelines 16.41.

2.3 Content of the abstract

See ISPE Guidelines 16.42-16.43. *PCT Newsletter 04/2017, 9*

See also GL/PCT-EPO B-X, 7.

2.4 Figure accompanying the abstract

Section F-II, 2.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also ISPE Guidelines 16.42(c) and 16.48-16.51 and GL/PCT-EPO B-X, 7.

2.5 Checklist

Section F-II, 2.5 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

2.6 Transmittal of the abstract to the applicant

Art. 18(2); Rule 44.2

The content of the abstract is transmitted to the applicant together with the search report (Form PCT/ISA/210, Box IV) (see GL/PCT-EPO B-X, 7(i)).

2.7 Comments on the abstract by the applicant

Rule 38.3

See ISPE Guidelines 16.45-16.47.

3. The title

Rules 4.3, 5.1(a)

The items making up the request do not normally concern the examiner, with the exception of the title. Rule 5.1(a) stipulates that the description "shall first state the title of the invention as appearing in the request".

The title must be short and precise. The examiner reviews the title in the light of the description and claims and any amendments thereto, to make sure that the title, as well as being concise, gives a clear and adequate indication of the subject of the invention. Thus, if amendments are made which change the categories of claims, the examiner should check whether a corresponding amendment, which may not go beyond the disclosure in the international application as filed, is needed in the title (see also GL/PCT-EPO B-X, 7). See also GL/PCT-EPO H-III, 7.

Rules 37, 44.2

For further provisions specifically related to the title, see ISPE Guidelines 16.35 - 16.38.

4. Description (formal requirements)

4.1 General remarks

Art. 5
Rule 5.1
GL/ISPE 4.02, 13.11

Section F-II, 4.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Section 204 PCT AI

The usage of the subheadings outlined in Section 204 of the Administrative Instructions under the PCT is recommended.

4.2 Technical field

Rule 5.1(a)(i)

See ISPE Guidelines 4.04.

4.3 Background art

Rule 5.1(a)(ii)

See ISPE Guidelines 4.05. The EPO applies option GL/ISPE A4.05[1] of the Appendix to Chapter 4 of the ISPE Guidelines.

4.3.1 Format of background art citations

Section F-II, 4.3.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.3.1.1 Examples of quotation for non-patent literature

Section F-II, 4.3.1.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.3.1.2 Examples of quotation for patent literature

Section F-II, 4.3.1.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.4 Irrelevant matter

Section F-II, 4.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also GL/PCT-EPO F-II, 7.4.

4.5 Technical problem and its solution

See ISPE Guidelines 4.06-4.07.

Rules 5.1(a)(iii), 9.1(iii)

4.6 Reference in the description to drawings

See ISPE Guidelines 4.08.

4.7 Reference signs

See ISPE Guidelines 4.09.

4.8 Industrial applicability

The description should indicate explicitly the way in which the invention is capable of exploitation in industry, if this is not obvious from the description or from the nature of the invention (see also GL/PCT-EPO, G-III). The expression "capable of exploitation in industry" means the same as "susceptible of industrial application". In view of the broad meaning given to the latter expression in the Appendix to Chapter 14 of the ISPE Guidelines, A14.01[2].1(1) and A14.01[2].2, it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must therefore be explicitly indicated.

Art. 33(1), (4)
Rule 5.1(a)(vi)
GL/ISPE A14.01[2]

Also, in relation to certain biotechnological inventions, i.e. sequences and partial sequences of genes, the industrial application is not self-evident and must be disclosed in the patent application.

4.9 Manner and order of presentation

See ISPE Guidelines 4.21.

Rule 5.1(b)
Section 204 PCT AI

4.10 Terminology

See ISPE Guidelines 4.22.

Rule 10.2

4.11 Computer programs

See ISPE Guidelines 4.23.

4.12 Physical values, units

Rule 10.1(a), (b), (d), (e)

See ISPE Guidelines 4.24. See also GL/EPO F-II, Annex 2.

4.13 Registered trademarks

Section F-II, 4.14 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5. Drawings

5.1 Form and content of the drawings

Rules 11.10-11.13

See GL/PCT-EPO A-V and ISPE Guidelines 4.28.

5.2 Photographs

The PCT Regulations are silent with regard to photographs. Nevertheless, they are allowed where what is to be shown (for instance, crystalline structures) cannot possibly be presented in a drawing. See GL/PCT-EPO A-V, 1.2, PCT AG I 5.159 and PCT Receiving Office Guidelines, Chapter VI, paragraph 146 (GL/RO 146).

Section F-II, 5.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

6. Nucleotide and amino acid sequence listings

Rule 5.2

See ISPE Guidelines 4.15 and Euro-PCT Guide, points 2.24.001-2.24.007~~2.23.001-2.23.006~~.

For handling of non-compliant nucleotide and/or amino acid sequence listings at the search stage and during the PCT Chapter II procedure, see GL/PCT-EPO B-VIII, 3.2 and GL/PCT-EPO C-VIII, 2.1, respectively.

6.1 Reference to sequences disclosed in a database

Section GL/EPO F-II, 6.1 to 6.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

7. Expressions, etc., not to be used

7.1 Categories

Rule 9.1

There are four categories of expressions which should not be contained in an international application, as specified in Rule 9.1. See ISPE Guidelines 4.29.

7.2 Expressions or drawings contrary to morality or public order

Rule 9.1(i) and (ii)

See ISPE Guidelines 4.29.

With regard to patentability issues with such matter, see GL/PCT-EPO G-II, 4.1.

7.3 Disparaging statements

See ISPE Guidelines 4.30. *Rule 9.1(iii)*

7.4 Irrelevant matter

See ISPE Guidelines 4.31. See also GL/PCT-EPO F-II, 4.4. *Rule 9.1(iv)*

7.5 Omission of matter from publication

See ISPE Guidelines 4.32. *Art. 21(6)*

Annex 1
Checklist for considering the abstract (see GL/PCT-EPO F-II, 2.5)

Annex 1 to Section F-II in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Annex 2
Units recognised in international practice (see GL/PCT-EPO F-II, 4.12)

Annex 2 to Section F-II in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Chapter III – Sufficiency of disclosure

1. Sufficiency of disclosure

A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art, it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it apparent to the skilled person how to put the invention into practice. A single example may suffice, but where the claims cover a broad field, the application should not usually be regarded as satisfying the requirements of Art. 5 unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts and evidence of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example (see also GL/PCT-EPO F-IV, 6.3). In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill. In this context, the "whole area claimed" is to be understood as substantially any embodiment falling within the ambit of a claim, even though a limited amount of trial and error may be permissible, e.g. in an unexplored field or when there are many technical difficulties.

GL/ISPE 5.45-5.51

With regard to Art. 5, an objection of lack of sufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts. See also GL/PCT-EPO F-III, 4.

For the requirements of Art. 5 and of Rule 5.1(a)(iii) and (a)(v) to be fully satisfied, it is necessary that the invention is described not only in terms of its structure but also in terms of its function unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.

Art. 5
Rule 5.1(a)(iii) and (v)

In cases where it is found that an application is sufficiently disclosed according to Art. 5 only in respect of a part of the claimed subject-matter, it may be appropriate for the examiner to first invite the applicant to provide informal clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3-3.6).

2. Sufficiency vs. additional subject-matter

See ISPE Guidelines 4.12.

Art. 5
Art. 34(2)(b)

3. Insufficient disclosure

See ISPE Guidelines 4.13.

Art. 5

If the claims for a perpetual motion machine are directed to its function, and not merely to its structure, an objection arises not only under Art. 5 but also

under Art. 33(4) in that the invention is not "industrially applicable" (see GL/PCT-EPO G-III, 1).

4. Burden of proof as regards the possibility of performing and repeating the invention

If there are serious doubts as regards the possibility of performing the invention and repeating it as described, the burden of proof as regards this possibility, or at least a demonstration that success is credible, rests with the applicant, who can discharge this burden of proof during the PCT Chapter II procedure or after entry into the European phase before the EPO. As regards the possibility of performing and repeating the invention, see also GL/PCT-EPO F-III, 3.

5. Cases of partially insufficient disclosure

5.1 Only variants of the invention are incapable of being performed

Section F-III, 5.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. See also GL/PCT-EPO G-VII, 5.2.

5.2 Absence of well-known details

GL/ISPE 5.50

Section F-III, 5.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. See also GL/PCT-EPO F-III, 1 and F-IV, 4.5 ff.

5.3 Difficulties in performing the invention

Section F-III, 5.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

6. Inventions relating to biological material

6.1 Biological material

Rule 13bis

See ISPE Guidelines 4.16-4.17.

6.2 Public availability of biological material

Section F-III, 6.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

6.3 Deposit of biological material

Rule 13bis.2
OJ EPO 2010, 498
OJ EPO 2017, A60
OJ EPO 2017, A61

See Euro-PCT Guide, points 2.23.001-2.23.007~~2.22.001-2.22.007~~.

6.4 Priority claim

Section F-III, 6.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

7. Proper names, trademarks and trade names

See ISPE Guidelines 4.25.

For the assessment of the clarity of claims referring to a trademark (Art. 6), see GL/PCT-EPO F-IV, 4.8.

8. Reference documents

See ISPE Guidelines 4.26.

Where the reference document relates to the background art, it may be in the application as originally filed or introduced at a later date (see GL/PCT-EPO F-II, 4.3 and GL/PCT-EPO H-II, 2.2.5).

Incorporation of essential matter or essential features at a later date is, however, subject to the restrictions set out in GL/PCT-EPO H-II, 2.2.1. It may be that the examiner has requested the applicant to furnish the document referred to, in order to be able to carry out a meaningful search (see ISPE Guidelines 15.37).

9. "Reach-through" claims

Section F-III, 9 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

10. Sufficiency of disclosure and Rule 20.5(e) or Rule 20.5*bis*(e)

The application may contain sheets stamped "Not to be considered (R. 20.5(e), R. 20.5*bis*(e) or 20.7)". This means that these sheets were not allowed by the receiving Office (for formal or substantive reasons) or that the applicant has withdrawn those parts or elements in order to avoid re-dating of the application. Such sheets thus do not form part of the application documents and should be ignored for search and examination.

In this case, the examiner must carefully evaluate whether the invention is still sufficiently disclosed without relying on the technical information contained in the withdrawn parts or elements. Should the examiner reach the conclusion that the requirements of Art. 5 are not satisfied, a corresponding objection is raised. See also GL/PCT-EPO F-III, 3 to 5.

11. Sufficiency of disclosure and clarity

An ambiguity in the claims may lead to an insufficiency objection. However, ambiguity also relates to the scope of the claims, i.e. Art. 6 (see GL/PCT-EPO F-IV, 4). Normally, therefore, an ambiguity in a claim will lead to an objection under Art. 5 only if the whole scope of the claim is affected, in the sense that it is impossible to carry out at all the invention defined therein. Otherwise an objection under Art. 6 is appropriate. *GL/ISPE 4.12, 5.58*

In particular, where a claim contains an ill-defined ("unclear", "ambiguous") parameter (see also GL/PCT-EPO F-IV, 4.11) and where, as a consequence, the skilled person would not know whether they were working within or outside of the scope of the claim, this, by itself, is not a reason to deny sufficiency of disclosure as required by Art. 5. Nor is such a lack of clear definition necessarily a matter for objection under Art. 6 only. What is decisive for establishing insufficiency within the meaning of Art. 5 is whether the parameter, in the specific case, is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using common general knowledge, to identify (without undue burden) the technical measures necessary to solve the problem underlying the application at issue.

There is a delicate balance between Art. 5 and Art. 6 which has to be assessed on the merits of each individual case.

Chapter IV – Claims (Art. 6 and formal requirements)

1. General

The international application must contain "one or more claims." *Art. 3(2), 6*
GL/ISPE 5.01-5.02

The claims must:

(i) "define the matter for which protection is sought;"

(ii) "be clear and concise;" and

(iii) "be fully supported by the description."

This chapter sets out the appropriate form and content of the claims, together with how they should be interpreted for the purposes of assessing the novelty and inventive step of the inventions which they define and searching for prior art which may be relevant to making that assessment.

For form-filling of the written opinion in case of formal defects or of clarity, conciseness or support issues, see GL/PCT-EPO B-XI, 3.2.4.

2. Form and content of claims

2.1 Technical features

Section F-IV, 2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *Rule 6.3(a)*
GL/ISPE 5.04

It is not necessary that every feature should be expressed in terms of a structural limitation. Functional features are dealt with in GL/PCT-EPO F-IV, 6.5. For the specific case of a functional definition of a pathological condition, see GL/PCT-EPO F-IV, 4.22.

2.2 Two-part form

See ISPE Guidelines 5.05 and ISPE Guidelines 5.22. *Rule 6.3(b)*

2.3 Two-part form unsuitable

See ISPE Guidelines 5.06 and ISPE Guidelines 5.07.

2.3.1 Two-part form "wherever appropriate"

See ISPE Guidelines 5.08.

2.4 Formulae and tables

See ISPE Guidelines 5.09. *Rule 11.10(a)-(c)*

3. Kinds of claim

3.1 Categories

See ISPE Guidelines 5.12.

For activities practised upon living things, see GL/PCT-EPO G-II, 4.2 and GL/PCT-EPO G-II, 5.4, which relate to subject-matter that may be excluded from search or preliminary examination.

3.2 Number of independent claims

GL/ISPE 5.13-5.14

The PCT has no provision equivalent to Rule 43(2) EPC. However, plural independent claims in one category which comply with the requirement of unity of invention (see GL/PCT-EPO F-V, 1) may be objected to under Art. 6 if they result in a lack of clarity and conciseness (see also GL/PCT-EPO B-VIII, 4).

When assessing whether to raise an objection of lack of clarity or conciseness for such claims, the examiner will take examples (i) to (iv) in GL/EPO F-IV, 3.2 into account.

3.3 Independent and dependent claims

Rules 6.4(a), 13.4 GL/ISPE 5.15-5.16 and A5.16[2]

Section F-IV, 3.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.4 Arrangement of claims

GL/ISPE 5.17

Section F-IV, 3.5 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rules 6.4(a), (b) and (c)

The EPO allows multiple dependent claims, provided that they do not detract from the clarity of the claims as a whole and that their arrangement does not create obscurity in the definition of the subject-matter to be protected. The EPO applies option GL/ISPE A5.16[2] of the Appendix to Chapter 5 of the ISPE Guidelines.

In case of unclarity, it may be appropriate for the examiner to first invite the applicant to provide informal clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3-3.6).

See GL/PCT-EPO F-IV, 3.7 for claims referring to a claim in a different category.

3.5 Subject-matter of a dependent claim

Section F-IV, 3.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.6 Alternatives in a claim

GL/ISPE 5.18

Section F-IV, 3.7 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

For the assessment of unity of invention of claims referring to alternatives, see GL/PCT-EPO F-V, 1.

3.7 Independent claims containing a reference to another claim or to features from a claim of another category

Section F-IV, 3.8 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *GL/ISPE 5.19*

3.8 Claims directed to computer-implemented inventions

Section F-IV, 3.9 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.8.1 Cases where all method steps can be fully implemented by generic data processing means

Section F-IV, 3.9.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.8.2 Cases where method steps require specific data processing means and/or require additional technical devices as essential features

Section F-IV, 3.9.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.8.3 Cases where the invention is realised in a distributed computing environment

Section F-IV, 3.9.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4. Clarity and interpretation of claims

4.1 Clarity

See ISPE Guidelines 5.31. *Art. 6*

Where it is found that the claims lack clarity, it may be appropriate for the examiner to first invite the applicant to provide informal clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3-3.6).

4.2 Interpretation

See ISPE Guidelines 5.20. The EPO applies option A5.20[2] of the Appendix to Chapter 5 of the ISPE Guidelines.

4.3 Inconsistencies

See ISPE Guidelines 5.29 and 17.70.

4.4 General statements, "spirit" of invention

See ISPE Guidelines 5.30.

4.5 Essential features

4.5.1 Objections arising from missing essential features

Section F-IV, 4.5.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.5.2 Definition of essential features

Section F-IV, 4.5.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.5.3 Generalisation of essential features

Section F-IV, 4.5.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.5.4 Implicit features

See ISPE Guidelines 5.33.

4.5.5 Examples

Examples illustrating essential features can be found in the Annex to section F-IV in the Guidelines for Examination in the EPO.

4.6 Relative terms

GL/ISPE 5.34

Section F-IV, 4.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.7 Terms like "about", "approximately" and "substantially"

GL/ISPE 5.38

Section F-IV, 4.7 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.8 Trademarks

See ISPE Guidelines 5.39.

See also GL/PCT-EPO F-II, 4.13 with regard to the need to acknowledge trademarks as such in the description. With regard to the effect of references to trademarks on sufficiency of disclosure (Art. 5), see GL/PCT-EPO F-III, 7.

4.9 Optional features

GL/ISPE 5.40

Section F-IV, 4.9 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.10 Result to be achieved

GL/ISPE 5.35

Section F-IV, 4.10 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

It should be noted that the requirements for allowing a definition of subject-matter in terms of a result to be achieved differ from those for allowing a definition of subject-matter in terms of functional features (see GL/PCT-EPO F-IV, 4.22 and 6.5).

Moreover, claims pertaining to a result to be achieved may likewise pose problems in the sense that essential features are missing (see GL/PCT-EPO F-IV, 4.5).

4.11 Parameters

GL/ISPE 5.36

Section F-IV, 4.11 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

For the assessment of novelty of claims containing parameters, see GL/PCT-EPO G-VI, 6.

For further issues relating to clarity, lack of support and sufficiency of disclosure regarding parameters, see GL/PCT-EPO F-III, 11 and GL/PCT-EPO F-IV, 6.4.

4.12 Product-by-process claim

GL/ISPE 5.26

Claims for products defined in terms of a process of manufacture are allowable only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such. The claim may for instance take the form "Product X obtainable by process Y". Irrespective of whether the term "obtainable", "obtained", "directly obtained" or an equivalent wording is used in the product-by-process claim, it is still directed to the product per se and confers absolute protection upon the product.

As regards novelty, when a product is defined by its method of manufacture, the question to be answered is whether the product under consideration is identical to known products. The burden of proof for an allegedly distinguishing "product-by-process" feature lies with the applicant, who has to provide evidence that the modification of the process parameters results in another product, for example by showing that distinct differences exist in the properties of the products. Nevertheless, the examiner needs to furnish reasoned argumentation to support the alleged lack of novelty of a product-by-process claim, especially if this objection is contested by the applicant.

The EPO applies option GL/ISPE A5.26[1] of the Appendix to Chapter 5 of the ISPE Guidelines.

4.12.1 Product claim with process features

Section F-IV, 4.12.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.13 Interpretation of expressions stating a purpose

GL/ISPE 5.21, 5.23

Section F-IV, 4.13 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

For claims directed to a known substance or composition for use in a surgical, therapeutic or diagnostic method, see GL/PCT-EPO G-II, 4.2.

4.14 Definition by reference to use or another entity

GL/ISPE 5.37

Section F-IV, 4.14 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.15 The expression "in"

Section F-IV, 4.15 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.16 Use claims

GL/ISPE A5.21

The EPO applies the first sentence concerning "use" claims of point GL/ISPE A5.21 of the Appendix to Chapter 5 of the ISPE Guidelines.

Thus a claim in the form "the use of substance X as an insecticide" should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use as an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit". However, a claim directed to the use of a process for a particular purpose is equivalent to a claim directed to that very same process.

Care should be taken when a claim relates to a two-step process which combines a use step with a product production step. This may be the case e.g. when a polypeptide and its use in a screening method have been defined as the only contribution to the art. An example of such a claim would then be:

"A method comprising:

(a) contacting polypeptide X with a compound to be screened and

(b) determining whether the compound affects the activity of said polypeptide;

and then formulating any active compound into a pharmaceutical composition."

Many variations of such a claim are conceivable, but in essence they combine (a) a screening step (i.e. using a specified test material to select a compound having a given property) with (b) further production steps (i.e. further transforming the selected compound for instance into the desired composition).

Two different types of process claim exist: (i) the use of an entity to achieve a technical effect and (ii) a process for the production of a product. The above claim and its analogues represent a combination of two different and irreconcilable types of process claim. Step (a) of the claim relates to a process of type (i), step (b) to a process of type (ii). Step (b) builds on the "effect" achieved by step (a), rather than step (a) feeding into step (b) a specific starting material and resulting in a specific product. This results in an unclear claim according to Art. 6.

4.17 References to the description or drawings

Rule 6.2(a)

See ISPE Guidelines 5.10.

4.18 Reference signs

See ISPE Guidelines 5.11. If there is a large number of different embodiments, only the reference signs of the most important embodiments need be incorporated in the independent claim(s). *Rule 6.2(b)*

If text is added to reference signs in parentheses in the claims, lack of clarity can arise (Art. 6). Expressions such as "securing means (screw 13, nail 14)" or "valve assembly (valve seat 23, valve element 27, valve seat 28)" are not reference signs in the sense of Rule 6.2(b) but are special features. It is unclear whether the features added to the reference signs are limiting or not. Accordingly, such bracketed features are generally not permissible. However, additional references to those figures, where particular reference signs are to be found, such as "(13 - Figure 3; 14 - Figure 4)", are unobjectionable.

A lack of clarity can also arise with bracketed expressions that do not include reference signs, e.g. "(concrete) moulded brick". In contrast, bracketed expressions with a generally accepted meaning are allowable, e.g. "(meth)acrylate" which is known as an abbreviation for "acrylate and methacrylate". The use of brackets in chemical or mathematical formulae is also unobjectionable. The use of brackets for providing physical values complying with the requirements of Rule 10.1 is unobjectionable as well.

4.19 Negative limitations (e.g. disclaimers)

A claim's subject-matter is normally defined in terms of positive features indicating that certain technical elements are present. Exceptionally, however, the subject-matter may be restricted using a negative limitation expressly stating that particular features are absent. This may be done e.g. if the absence of a feature can be deduced from the application as filed. *GL/ISPE 5.41*

Negative limitations such as disclaimers may be used only if adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable or would unduly limit the scope of the claim. It has to be clear what is excluded by means of the disclaimer. A claim containing one or more disclaimers must also fully comply with the clarity and conciseness requirements of Art. 6.

For the allowability of disclaimers excluding embodiments that were disclosed in the original application as being part of the invention, see GL/PCT-EPO H-III, 4.2. With respect to the allowability of a disclaimer not disclosed in the application as filed see GL/PCT-EPO H-III, 4.1.

The EPO applies option GL/ISPE A20.21[2] of the Appendix to Chapter 20 of the ISPE Guidelines.

4.20 "Comprising" vs. "consisting"

Section F-IV, 4.21 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *GL/ISPE 5.24(a), (b)*

4.21 Functional definition of a pathological condition

Section F-IV, 4.22 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

See also GL/PCT-EPO G-II, 4.2.

4.22 Broad claims

GL/ISPE 5.42, 15.25

The PCT Regulations do not explicitly mention overly broad claims. However, objections to such claims may arise for various reasons.

Where there are discrepancies between the claims and the description, the claims are not sufficiently supported by the description (Art. 6) and also, in most cases, the invention is not sufficiently disclosed (Art. 5, see GL/PCT-EPO F-IV, 6.1).

Sometimes an objection of lack of novelty arises, for example if the claim is formulated in such broad terms that it also covers known subject-matter from other technical fields. Broad claims may also cover embodiments for which a purported effect has not been achieved. On raising an objection of lack of inventive step in such cases, see GL/PCT-EPO G-VII, 5.2.

4.23 Order of claims

There is no legal requirement that the first claim should be the broadest. However, Art. 6 requires that the claims must be clear not only individually but also as a whole. Therefore, where there are a large number of claims, they should be arranged with the broadest claim first. If the broadest of a large number of claims is a long way down, so that it could easily be overlooked, the applicant should be required either to re-arrange the claims in a more logical way or to direct attention to the broadest claim in the introductory part or in the summary of the description.

Furthermore, if the broadest claim is not the first one, the later broader claim must also be an independent claim. Consequently, where these independent claims are of the same category, an objection may also arise under Rule 6 if they result in a lack of clarity and conciseness (see GL/PCT-EPO F-IV, 3.2).

5. Conciseness, number of claims

Rule 6.1(a)

See ISPE Guidelines 5.42.

The EPO applies option GL/ISPE A5.42[2] of the Appendix to Chapter 5 of the ISPE Guidelines.

Where it is found that the claims lack conciseness under Art. 6, it may be appropriate for the examiner to first invite the applicant to provide informal clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3 to GL/PCT-EPO B-VIII, 3.6).

6. Support in description

6.1 General remarks

Art. 6

See ISPE Guidelines 5.43.

Regarding support for dependent claims by the description, see GL/PCT-EPO F-IV, 6.6.

6.2 Extent of generalisation

See ISPE Guidelines 5.52.

An invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology.

6.3 Objection of lack of support

See ISPE Guidelines 5.44.

Once the examiner has set out a reasoned case that, for example, a broad claim is not supported over the whole of its breadth, the onus of demonstrating that the claim is fully supported lies with the applicant (see GL/PCT-EPO F-III, 4).

The question of support is illustrated by examples (i) to (iii) in GL/EPO F-IV, 6.3. See also ISPE Guidelines 5.53.

Where it is found that the claims lack support in the description under Art. 6, it may be appropriate for the examiner to first invite the applicant to provide informal clarification before the search is carried out (see GL/PCT-EPO B-VIII, 3.3-3.6).

6.4 Lack of support vs. insufficient disclosure

Art. 5, 6

It should be noted that, although an objection of lack of support is an objection under Art. 6, it can often, as in examples (i) to (iii) of GL/EPO F-IV, 6.3, also be considered as an objection of insufficient disclosure of the invention under Art. 5 (see GL/PCT-EPO F-III, 1 to GL/PCT-EPO F-III, 3), the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in respect of a narrow "invention"). Both requirements are designed to reflect the principle that the terms of a claim should be commensurate with, or be justified by, the invention's technical contribution to the art. Therefore, the extent to which an invention is sufficiently disclosed is also highly relevant to the issue of support. The reasons for failure to meet the requirements of Art. 5 may in effect be the same as those that lead to the infringement of Art. 6 as well, namely that the invention, over the whole range claimed, extends to technical subject-matter not made available to the person skilled in the art by the application as filed.

For example, where a technical feature is described and highlighted in the description as being an essential feature of the invention, to comply with Art. 6 this must also be part of the independent claim(s) defining the invention (see GL/PCT-EPO, F-IV, 4.5.1). By the same token, if the (essential) technical feature in question is absent from the claims, and no information is given on how to perform the claimed invention successfully without the use of said feature, the description does not disclose the invention defined in the claim(s) in the manner prescribed by Art. 5.

GL/ISPE 4.12, 5.58

An objection under both Art. 5 and Art. 6 may also be justified. An example would be a claim relating to a known class of chemical compounds defined by measurable parameters, when the description does not disclose a

technical teaching allowing the skilled person to manufacture those compounds complying with the parametric definition, and this is not otherwise feasible by the application of common general knowledge or routine experimentation. Such a claim would be both technically not supported and not sufficiently disclosed, regardless of whether the parametric definition meets the clarity requirement of Art. 6.

6.5 Definition in terms of function

See ISPE Guidelines 5.56.

See also GL/PCT-EPO F-IV, 2.1 and 4.10.

6.6 Support for dependent claims

Section F-IV, 6.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Annex
Examples concerning essential features

The Annex to F-IV of the Guidelines for Examination in the EPO contains examples of how to evaluate whether a claim contains all essential features of the invention. The examiner will apply the same criteria when assessing essential features under the PCT *mutatis mutandis*.

Chapter V – Unity of invention

1. Assessment of and reasoning for unity of invention

Art. 150(2) EPC

Given the harmonisation of the definitions concerning unity of invention in Rules 13.1 and 13.2 PCT compared with Art. 82 EPC and Rule 44(1) EPC respectively, the formal criteria for unity in the EPC and the PCT systems are the same. Hence, search and substantive examination follow the same principles in both the European and PCT procedures as far as the reasoning for unity of invention is concerned.

As a consequence, the parts relating to the assessment of unity of invention and its reasoning of GL/EPO F-V, 1 to F-V, 3 and all subsections apply *mutatis mutandis* to the PCT procedure, with the exception of those passages in GL/EPO F-V, 2.1 and F-V, 3.2.1 relating to Rule 43(2) EPC. This is because Rule 43(2) EPC has no equivalent in the PCT, which also means that, in the PCT procedure, multiple independent claims in the same category need to be considered under the Art. 6 conciseness requirement (see GL/EPO F-IV, 3.2 and GL/PCT-EPO F-IV, 3.2).

Intermediate documents cited under Rule 33.1(c) (see GL/PCT-EPO B-X, 9.2.4) are considered in the same way as documents under Art. 54(3) EPC (see GL/EPO F-V, 3.1) and cannot be used for a non-unity objection.

This is also the case for novelty-destroying documents cited under Rule 33.1(a) as accidental anticipation within the meaning of decisions G 1/03 and G 1/16 of the EPO's Enlarged Board of Appeal (see GL/EPO F-V, 3.1.2).

2. Lack of unity during search

Art. 17(3)(a)
Rule 40, 45bis.6

In many and probably most instances, lack of unity will have been noted at the search stage. In such cases, 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. See GL/PCT-EPO B-VII, 2.

See also ISPE Guidelines 10.60 for the process at the international search stage and ISPE Guidelines 10.83 for the process at the supplementary international search stage.

GL/EPO F-V, 4 applies *mutatis mutandis*, with the exception of those aspects already covered above.

3. Lack of unity during the PCT Chapter II procedure

Art. 34(3)(a)-(c)
Rule 68

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 preliminary 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. See GL/PCT-EPO C-V.

See also ISPE Guidelines 10.71 to ISPE Guidelines 10.73.

Chapter VI – Priority

1. The right to priority

For the establishment of the WO-ISA in relation to the priority claim, see GL/PCT-EPO B-XI, 4 and subsections.

1.1 Filing date as effective date

See ISPE Guidelines 6.01 and ISPE Guidelines 15.11 A,B and C.

Art. 11, 14
Rule 20

1.2 Priority date as effective date

When an international application claims the right of priority of the date of filing of an earlier application, the priority date (i.e. the filing date of the earlier application) will be used to calculate certain time limits.

Art. 2(xi)

The priority claim must refer to an earlier application. The day of filing of the earlier application not being included in the priority period (Art. 8(2) PCT in conjunction with Article 4C(2) of the Paris Convention and Rule 2.4(a) PCT), the priority period starts on the day following the date of filing of the earlier application. Thus, an "earlier" application is to be understood as an application that has been filed at least a day before the application claiming priority.

Art. 8(1)
Rules 2.4, 17.1 and 80

Furthermore, the priority date becomes the effective date for the purposes of international examination, i.e. the written opinion (of either the ISA or the IPEA) and the international preliminary examination report. The relevant date for the purposes of the international search is always the international filing date.

Rules 33.1, 43bis.1, 64.1
GL/ISPE 11.02-11.05

See ISPE Guidelines 6.02.

1.3 Validly claiming priority

See ISPE Guidelines 6.03 and ISPE Guidelines 15.11 as well as GL/PCT-EPO A-VI, 1.6.

Art. 8(1)
Rules 2.4, 4.10
Rule 26bis.2

1.4 Subsequent application considered as first application

See ISPE Guidelines 6.04.

Art. 8(2)(a)

Examples of applications that cannot be recognised as a "first application" are:

(i) US applications which are a "continuation" of a previous application ("con");

(ii) US applications which are a "continuation in part" of a previous application ("cip"), in so far as the subject-matter in question was already disclosed in the original US application;

(iii) national applications claiming priority from a previous national application or national utility model.

In the case of US con or cip applications, the first sentence of the description reads as follows: "This application is a continuation in part (continuation) of Serial Number .... filed .....". The following information is found on the title page under the heading "CONTINUING DATA******": "VERIFIED THIS APPLICATION IS A CIP (or CON) OF ....." A form headed "Declaration for Patent Application" must also be attached to the end of the application (in this case the priority document), listing earlier foreign or US applications under the heading "foreign priority benefits under Title 35, United States Code, 119" or "benefit under Title 35, U.S.C., 120 of any United States application(s)".

1.5 Multiple priorities

Art. 8(1)

See ISPE Guidelines 6.05.

2. Determining priority dates

2.1 Examining the validity of a right to priority

See ISPE Guidelines 6.06.

2.2 The same invention

See ISPE Guidelines 6.07 to ISPE Guidelines 6.09.

A disclaimer which is allowable under Art. 34(2)(b) (see GL/PCT-EPO H-III, 4.1 and GL/PCT-EPO H-III, 4.2) does not change the identity of the invention within the meaning of Art. 8. Therefore, such a disclaimer could be introduced when drafting and filing a successive international application, without affecting the right to priority from the first application not containing the disclaimer.

2.3 Priority claim not valid

See ISPE Guidelines 6.10.

3. Claiming priority

3.1 General remarks

Art. 11
Rule 4.10

See ISPE Guidelines 6.11 and GL/PCT-EPO A-VI, 1.6.

3.2 Declaration of priority

Art. 8(1)
Rule 4.10

See ISPE Guidelines 6.13 to ISPE Guidelines 6.15.

3.3 Certified copy of the previous application (priority document)

Rules 17.1 and 66.7(a)

See Euro-PCT Guide, points 2.17.001-2.17.004~~2.16.001-2.16.004~~.

3.4 Translation of the previous application

Rule 66.7(b)

See ISPE Guidelines 6.17.

3.5 Withdrawal of priority claims

The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date. *Rule 90bis.3*

3.6 Correction or addition of priority claim

See ISPE Guidelines 6.11, ISPE Guidelines 6.16 and ISPE Guidelines 8.10. *Rule 26bis.1*

3.7 Re-establishment of rights in respect of the priority period

The applicant may file a request for restoration of the priority right up to two months after expiry of the priority year from the claimed priority. *Rule 26bis.3 PCT Newsletter 07-08/2017, 15*

In the international phase, restoration can be granted under both the "due care" and "unintentional" criteria. The EPO as receiving Office and as designated Office in the regional phase will decide on the basis of the "due care" criterion (which is the same criterion as used for EP applications with respect to re-establishment of rights under Art. 122 EPC). If the EPO was not the receiving Office, the request may have been decided upon under the "unintentional" criterion.

If the priority right was restored by the receiving Office under the "due care" criterion, no new request need be filed with the EPO as designated/elected Office, since the EPO will, in principle, recognise the decision of the receiving Office. If, however, the EPO has reasonable doubt that the requirements for grant were not met, it will notify the applicant accordingly. In this communication the reasons for such doubt will be indicated and a time limit will be set within which the applicant may submit comments.

If the priority right was restored by the receiving Office under the "unintentional" criterion, a new request needs to be filed with the EPO as designated/elected Office, since the EPO is not bound by the decision of any receiving Office under the "unintentional" criterion.

A priority claim may not be considered invalid on the basis that the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within two months of that date. The examiner may make a remark in the WO-ISA indicating the number of days by which the 12-month priority period has been exceeded. *Rule 26bis.2(c)(iii)*

For filling out the WO-ISA where the filing date exceeds the earliest priority date by over twelve months and a further two months, see GL/PCT-EPO B-XI, 4.1.