Guidelines for Search and Examination at the European Patent Office as PCT Authority

April 2025~~March 2024~~

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General Part

Contents

1. Preliminary remarks

The present Guidelines are dedicated to the specific procedures before the EPO in its capacity as PCT Authority. Their full name is "Guidelines for Search and Examination at the European Patent Office as PCT Authority", or "PCT-EPO Guidelines" for short. ~~, and throughout these Guidelines they are also referred to as "GL/PCT-EPO".~~

These Guidelines can be used and referred to by examiners and formalities officers, as well as applicants and patent attorneys, in addition to ~~the Euro-PCT Guide ("PCT procedure at the EPO, [International phase and entry into the European phase], Guide for applicants"),~~ the PCT-RO (Receiving Office) Guidelines and the PCT ISPE (International Search and Preliminary Examination) Guidelines. They are complementary to, but not a substitute for, the ISPE and RO Guidelines, as well as the PCT Applicant's Guide ("WIPO PCT Guide"), all published by WIPO. ~~They will exist in parallel with the Euro-PCT Guide which, as before, has the status of a Notice from the EPO.~~

The PCT-EPO Guidelines are published as a standalone document in electronic format only, and will be revised on a yearly basis at the same time as the Guidelines for Examination in the European Patent Office ("~~EP~~ EPC Guidelines"). The electronic publication includes not only the online version in HTML format, but also a printable file.

~~The aim is to gradually expand the PCT-EPO Guidelines with each revision cycle. The major change in this ninth edition is the further development of Part A, which now includes new sections on the form and signature of documents.~~

The current tenth edition incorporates information from the former Euro-PCT Guide, making the PCT-EPO Guidelines a more comprehensive resource on the international phase at the EPO.

Any indication from readers drawing attention to errors as well as suggestions for improvement is highly appreciated and can ~~may~~ be sent by email to Department 5.3.1.1, Patent Filing Process and PCT Affairs, at ~~international_pct_affairs@epo.org~~ Guidelines@epo.org.

1.1 Relationship between the PCT and the EPC

In all PCT procedures before the EPO, the PCT is applied in accordance with the provisions of Part X of the EPC, "International applications under the Patent Cooperation Treaty – Euro-PCT applications", the Implementing Regulations to the EPC ("EPC Rules") and the relevant further legislation. *Art. 150(1) EPC*

The legal basis for all EPO activities under the PCT is Part X of the EPC (Articles 150-153) as implemented by the provisions of the Implementing Regulations to the EPC, in particular Rules 157-165, and by further legislation such as decisions of the President and the Administrative Council of the European Patent Organisation.

Art. 150(2) EPC

For international applications which are the subject of proceedings before the EPO in any of its functions, the provisions of the PCT and its Regulations ("PCT Rules") apply, supplemented by the provisions of the EPC. In case of conflict between the provisions of the EPC and those of the PCT or the PCT Rules, the PCT or the PCT Rules prevail.

The PCT allows offices to notify the IB of an incompatibility of certain provisions with their national law, in which case those provisions do not apply before them. A list of notifications of incompatibility filed by the EPO is published on the WIPO website[1].

2. Explanatory notes

2.1 Overview

The PCT-EPO Guidelines follow the structure of the ~~EP~~ EPC Guidelines (Parts A, B, C, E, F, G and H, without D because there is no opposition, limitation or revocation under the PCT), and as far as possible the organisation within each part is similar to that of the ~~EP~~ EPC Guidelines, adapted to the particularities of the PCT system. The sequence of chapters within Part A, however, differs from that of the ~~EP~~ EPC Guidelines. This is due to the particular way in which the content is being gradually extended and the structure may be reconsidered prior to completion of Part A.

Thus, these Guidelines comprise the following seven parts:

Part A: Guidelines for Formalities Examination~~;~~

Part B: Guidelines for Search~~;~~

Part C: Guidelines for Procedural Aspects in Chapter II~~;~~

Part E: Guidelines on General Procedural Matters~~;~~

Part F: The International Application

Part G: Patentability

Part H: Amendments and Corrections

Part A deals with the procedures for formalities examination at the EPO in its capacity as RO, (S)ISA and IPEA. Part B deals with search matters. Part C relates to procedures to be followed in Chapter II.

Part E deals with procedural matters relevant to several or all of the stages in procedure at the EPO as PCT Authority. Part F deals with the requirements which the application must fulfil other than patentability, in particular unity of invention (Rule 13), sufficiency of disclosure (Art. 5), clarity (Art. 6) and the right to priority (Art. 8). Part G deals with excluded subject-matter (Art. 17(2)(a)(i) and Rule 39; Art. 34(4)(a)(i) and Rule 67), novelty (Art. 33(2)), inventive step (Art. 33(3)) and industrial application

[1] *wipo.int/pct/en/texts/reservations/res_incomp.html*

(Art. 33(4)). Part H deals with the requirements relating to amendments and corrections. It relates in particular to the right to amend, the allowability of amendments and the correction of defects and errors.

Each part of the Guidelines is divided into chapters, each subdivided into numbered sections which may be further divided into subsections. Cross-references to other sections and subsections are indicated ~~in the format GL/PCT-EPO, followed~~ by the relevant letter of that part, then the chapter number (a Roman numeral) and then the section or subsection number (so ~~thus, e.g. GL/PCT-EPO~~ C-V, 4.2 would be used to refer to subsection 4.2 of chapter V of Part C of the PCT-EPO Guidelines). When referring to the Guidelines for Examination in the EPO, the same format is used, preceded by~~, but with "GL/EPO"~~ "EPC Guidelines"~~ instead of "GL/PCT-EPO"~~.

Marginal references to articles and rules without further identification relate to the Articles or Rules of the Patent Cooperation Treaty which provide authority for what is stated. It is believed that such references avoid the need for extensive quotation from the PCT itself. References to Articles or Rules of the European Patent Convention are followed by "EPC".

Marginal references to the RO and ISPE Guidelines relate to the corresponding sections in those Guidelines and are an indication that the present Guidelines apply within the framework of the RO and ISPE Guidelines, in conformity with the supplementary role of the EPC in the international phase. *Art. 150(2) EPC*

Where the practice for EP and PCT applications is the same (e.g. for the assessment of novelty), cross-references are made to the ~~EP~~ EPC Guidelines. Where the practices are only partially overlapping, the information is contained in full in the PCT-EPO Guidelines, in order to avoid possible confusion. Chapter 3, Annex I, provides an EPC-PCT concordance table.

Any references to persons made in the PCT-EPO Guidelines are to be understood as being gender-neutral.

2.2 Applicability of the PCT-EPO Guidelines

These Guidelines are intended to cover normal occurrences. They should therefore be considered only as general instructions. The application of these Guidelines to individual international patent applications is the responsibility of the formalities and examining staff and they may have to go beyond these instructions in exceptional cases. Nevertheless, as a general rule, parties can expect the EPO in its capacity as RO, (S)ISA or IPEA to act in accordance with these Guidelines until such time as they – or the relevant legal provisions – are amended. Notices concerning such amendments are published in the Official Journal of the EPO and on the EPO website. It should also be noted that these Guidelines do not constitute legal provisions.

2.3 Relationship between the PCT-EPO Guidelines and the ISPE Guidelines

The PCT-EPO Guidelines are intended to be complementary to, but not a substitute for, the PCT ISPE[2] and RO Guidelines, as well as the PCT Applicant's Guide ("WIPO PCT Guide") ~~and the Euro-PCT Guide[3] ("PCT procedure at the EPO, [International phase and entry into the European phase], Guide for applicants")~~.

The ISPE Guidelines published by WIPO set out in detail the procedures and criteria to be followed by all International Searching and Preliminary Examining Authorities. Since practice varies amongst different authorities these Guidelines provide some degrees of freedom as to which procedure/criteria can be used. Such different criteria are listed in the ISPE Guidelines in appendices to the respective chapters or defined within a specific paragraph. Generally, the EPO will use the same criteria when searching and examining an international application as would have been used in the European procedure. This means that where the ISPE Guidelines are either silent or give no guidance on a particular topic, then the equivalent provisions of the ~~EP~~ EPC Guidelines are applied *mutatis mutandis* to PCT search and preliminary examination. A list of policy options is provided in section 3.2 below, Annex II.

2.4 Further sources of information

Regularly updated general information on the EPO and specific information on the procedures before the EPO as receiving Office, International Authority (ISA, SISA and IPEA) and designated/elected Office under the PCT is provided in the Annexes to the WIPO PCT Guide[3].

OJ EPO 2017, A115

Moreover, an agreement between the European Patent Organisation and the International Bureau of WIPO ("Agreement EPO-WIPO") concerning the functioning of the EPO as International Authority (ISA, SISA and IPEA) sets out all particulars of the EPO's work in that capacity. The latest agreement, dated October 2017, entered into force on 1 January 2018 and has been amended several times since then. A consolidated version of the text as amended can be found on the WIPO website[4].

Relevant information is also provided on the EPO website[5] and in the EPO's Official Journal ("OJ"), which is published in electronic form only[6].

Up-to-date news about the PCT is available on the WIPO website and also from the PCT Newsletter and the Official Notices (PCT Gazette), both published in electronic form by WIPO[7].

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2 GL/ISPE and GL/RO: *wipo.int/pct/en/texts/gdlines.html*

~~3 epo.org/en/legal/guide-europct~~

3 *wipo.int/pct/en/appguide/index.jsp*

4 *wipo.int/export/sites/www/pct/en/docs/agreements/ag-ep.pdf*

5 *epo.org*

6 *epo.org/en/legal/official-journal/*

7 PCT Newsletter: *wipo.int/pct/en/newslett/*

Official Notices (PCT Gazette): *wipo.int/pct/en/official_notices/index.html*

Applicants desiring further information about the PCT procedure in the international phase are advised to consult the Administrative Instructions under the PCT ("PCT/AI") ~~("AI")~~[8], the PCT Receiving Office Guidelines ("GL/RO") and the PCT International Search and Preliminary Examination Guidelines ("ISPE Guidelines", "GL/ISPE"), all available on the WIPO website.

2.5 Abbreviations

In these Guidelines, the following abbreviations are used:

AAD	Arrangements for the automatic debiting procedure
ADA	Arrangements for deposit accounts
ARIPO	African Regional Intellectual Property Organization
Art.	Article
EPC	European Patent Convention
EPO	European Patent Office
ESOP	European search opinion
~~GL/EPO~~EPC Guidelines	Guidelines for Examination in the EPO
GL/ISPE	PCT International Search and Preliminary Examination Guidelines
~~GL/PCT-EPO~~PCT-EPO Guidelines	Guidelines for Search and Examination at the EPO as PCT Authority
GL/RO	PCT Receiving Office Guidelines
IB	International Bureau
IPE	International preliminary examination
IPEA	International Preliminary Examining Authority
IPER	International preliminary examination report
IPRP	International preliminary report on patentability
ISA	International Searching Authority
ISR	International search report

[8] ~~AI:~~ PCT/AI: *wipo.int/pct/en/texts/index.html*

OJ EPO	Official Journal of the European Patent Office
PCT	Patent Cooperation Treaty
PCT AG I	PCT Applicant's Guide – Introduction to the International Phase
PCT-CLAR	Request for clarification before search
PCT/AI	Administrative Instructions under the PCT
PPH	Patent Prosecution Highway
RFees	Rules relating to Fees
RO	Receiving Office
SIS	Supplementary international search
SISA	Supplementary International Searching Authority
SISR	Supplementary international search report
WIPO	World Intellectual Property Organization
WO-ISA	Written opinion of the International Searching Authority

2.6 Forms used by the RO, ISA, SISA and IPEA

The following forms are used by the EPO as RO:

PCT/RO/103	Invitation to correct the purported international application
PCT/RO/104	Notification that the purported international application is not and will not be treated as an international application
PCT/RO/105	Notification of the international application number and of the international filing date
PCT/RO/106	Invitation to correct defects in the international application
PCT/RO/107	Invitation relating to certain parts of the international application that are, or appear to be, missing
PCT/RO/108	Invitation to request rectification
PCT/RO/109	Notification of decision concerning request for rectification

PCT/RO/110	Invitation to correct priority claim and/or notification of possibility to request restoration of the right of priority
PCT/RO/111	Notification relating to priority claim
PCT/RO/114	Notification on decision of confirmation of incorporation by reference of element or part
PCT/RO/117	Notification that international application considered to be withdrawn
PCT/RO/119	Notification of refund of fees
PCT/RO/126	Notification concerning later submitted parts of an international application
PCT/RO/129	Notification concerning request to restore the international filing date
PCT/RO/130	Invitation to request omission of information from international publication
PCT/RO/131	Notification of defects with regard to correspondence submitted by the applicant
PCT/RO/132	Communication in cases for which no other form is applicable
PCT/RO/133	Invitation to pay prescribed fees together with late payment fee
PCT/RO/135	Notification of date of receipt of priority document or of priority application number
PCT/RO/136	Notification of withdrawal
PCT/RO/138	Communication regarding extension of time limit
~~PCT/RO/141~~	~~Invitation to furnish original of document transmitted by telegraph, teleprinter, facsimile machine, etc.~~
PCT/RO/151	Notification of transmittal of purported international application to the International Bureau as receiving Office and invitation to pay fee
PCT/RO/152	Invitation to authorize transmittal of purported international application to the International Bureau as Receiving Office and to pay fee
PCT/RO/158	Notification of intended refusal of request to restore right of priority and/or invitation to furnish declaration or other evidence

PCT/RO/159	Notification of decision on request to restore right of priority

The following forms are used by the EPO as ISA:

PCT/ISA/202	Notification of receipt of search copy
PCT/ISA/203	Declaration of non-establishment of international search report
PCT/ISA/205	Notification of modification of abstract approved by International Searching Authority
PCT/ISA/206	Invitation to pay additional fees and, where applicable, protest fee
PCT/ISA/207	Informal clarification: note/invitation
PCT/ISA/208	Invitation to pay additional fees in case of later submitted sheets
PCT/ISA/210	International search report
PCT/ISA/212	Notification of decision on protest or declaration that protest considered not to have been made
PCT/ISA/213	Notification of refund of search fee
PCT/ISA/216	Invitation to request rectification
PCT/ISA/217	Notification of decision concerning request for rectification
PCT/ISA/220	Notification of transmittal of the international search report and the written opinion of the International Searching Authority, or the declaration
PCT/ISA/224	Communication in cases for which no other form is applicable
PCT/ISA/225	Invitation to furnish nucleotide and/or amino acid sequence listing and to pay, where applicable, late furnishing fee
PCT/ISA/237	Written opinion of the International Searching Authority

The following forms are used by the EPO as SISA:

PCT/SISA/501	Supplementary international search report
PCT/SISA/502	Declaration of non-establishment of supplementary international search report

PCT/SISA/503 Notification of decision on review of opinion; or declaration that request for review of opinion considered not to have been made

PCT/SISA/504 Invitation to furnish nucleotide and/or amino acid sequence listing and to pay, where applicable, late furnishing fee

PCT/SISA/506 Notification of receipt of copy of international application for the purposes of supplementary international search

PCT/SISA/524 Communication in cases for which no other form is applicable

The following forms are used by the EPO as IPEA:

PCT/IPEA/402 Notification of receipt of demand by competent International Preliminary Examining Authority

PCT/IPEA/403 Notification concerning payment of the preliminary examination and handling fees

PCT/IPEA/404 Invitation to correct defects in the demand

PCT/IPEA/405 Invitation to restrict or pay additional fees, and, where applicable, protest fee

PCT/IPEA/407 Notification that demand considered not to have been submitted

PCT/IPEA/408 Written opinion of the International Preliminary Examining Authority

PCT/IPEA/409 International preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)

PCT/IPEA/411 Invitation to request rectification

PCT/IPEA/412 Notification of decision concerning request for rectification

PCT/IPEA/415 Notification concerning documents transmitted

PCT/IPEA/420 Notification of decision on protest or declaration that protest considered not to have been made

PCT/IPEA/423 Invitation to correct defects in correspondence submitted by the applicant

PCT/IPEA/424 Communication in cases for which no other form is applicable

PCT/IPEA/425 Notification of cancellation of certain elections

PCT/IPEA/427	Communication regarding extension of time limit
PCT/IPEA/428	Note on informal communication with the applicant
PCT/IPEA/429	Notification concerning informal communication with the applicant
PCT/IPEA/431	Invitation to submit amendments
PCT/IPEA/432	Communication regarding amendments not taken into account
PCT/IPEA/436	Notification of transmittal of demand to the International Bureau or to the competent International Preliminary Examining Authority
PCT/IPEA/440	Invitation to pay prescribed fees together with late payment fee
PCT/IPEA/441	Invitation to furnish nucleotide and/or amino acid sequence listing and to pay, where applicable, late furnishing fee
PCT/IPEA/442	Invitation to indicate competent International Preliminary Examining Authority
PCT/IPEA/443	Invitation to furnish translation for the purposes of international preliminary examination
PCT/IPEA/444	Notification by non-competent International Preliminary Examining Authority that demand considered not to have been submitted

The forms can be found via the following link: *wipo.int/pct/en/forms/*

2.7 Publications

Since 1 January 2009, the following kind codes have been used for publication of a PCT application:

Code	Publication details
A1	International application published with ISR
A2	International application published without ISR or international application published with declaration under Article 17(2)(a)
A3	Later publication of ISR with revised front page
A4	Later publication of amended claims and/or statement (Article 19) with revised front page

A8 International application republished with corrections to front page bibliographic data

A9 International application or ISR republished with corrections, alterations or supplements (see also WIPO Standard ST.50)

3. Annexes

3.1 Annex I: EPC-PCT concordance table

EPC provisions	PCT provisions	Comments
Art. 52(2) EPC	Rule 39.1 PCT, Rule 67.1 PCT	
Art. 52(3) EPC	Rule 39.1 PCT, Rule 67.1 PCT	
Art. 53(a) EPC	Rule 9.1(i) PCT, Rule 9.1(ii) PCT	
Art. 53(b) EPC	Rule 39.1(ii) PCT, Rule 67.1(ii) PCT	
Art. 53(c) EPC	Rule 39.1 PCT, Rule 67.1 PCT	
Art. 54(1) EPC	Art. 33(2) PCT	
Art. 54(2) EPC	Rule 64.2 PCT (prior use), Rule 33.1(a), (b) and (c) PCT	prior use, except that there is no provision for purely oral disclosure
Art. 54(3) EPC	Rule 64.3 PCT, Rule 70.10 PCT	intermediate/conflicting documents
Art. 55 EPC	Art. 27(5) PCT, Art. 27(6) PCT, Rule 4.17(v) PCT, Rule 51*bis*.1(a)(v) PCT	
Art. 56 EPC	Art. 33(3) PCT	
Art. 57 EPC	Art. 33(4) PCT	
Art. 67(1) EPC	Art. 29(1) PCT	
Art. 67(2) EPC	Art. 29(1) PCT	
Art. 67(3) EPC	Art. 29(2) PCT	
Art. 69 EPC	Art. 29(1) PCT, Art. 29(2) PCT	

EPC provisions	PCT provisions	Comments
Art. 76 EPC	No equivalent	
Art. 82 EPC	Rule 13.1 PCT	
Art. 83 EPC	Art. 5 PCT	
Art. 84 EPC	Art. 6 PCT	
Art. 87 EPC	Art. 8 PCT	
Art. 88 EPC	Art. 8 PCT	
Art. 89 EPC	Rule 64.1(b) PCT	
Art. 122(1) EPC	Rule 26*bis*.3 PCT, Rule 49*ter*.2 PCT	
Art. 123(2) EPC	Art. 19(2) PCT, Art. 34(2)(b) PCT	
Art. 128(1) EPC	Art. 30 PCT	unpublished applications not available for inspection
Art. 128(4) EPC	Rule 94 PCT	designated and elected Offices may allow access to files of international applications (EPO as elected Office allows access to preliminary examination files after completion of the IPER, OJ EPO 2003, 382)
No equivalent	Art. 28(1) PCT, Art. 41(1) PCT	
Rule 30 EPC	Rule 13*bis* PCT	
Rule 31 EPC	Rule 13*bis* PCT	
Rule 32 EPC	Rule 13*bis* PCT	
Rule 33 EPC	Rule 13*bis* PCT	
Rule 34 EPC	Rule 13*bis* PCT	

EPC provisions	PCT provisions	Comments
Rule 40 EPC	Art. 11(1) PCT	Under the EPC, the presence of one or more claims is not a requirement for the accordance of the date of filing
Rule 42(1) EPC	Rule 5.1(a) PCT	
Rule 42(2) EPC	Rule 5.1(b) PCT	
Rule 43(1) EPC	Rule 6.3(a) PCT	
Rule 43(1)(a) EPC	Rule 6.3(b)(i) PCT	
Rule 43(1)(b) EPC	Rule 6.3(b)(ii) PCT	
Rule 43(4) EPC	Rule 6.4(a) (part), (b) and (c) PCT	
Rule 43(5) EPC	Rule 6.1(a) PCT, Rule 6.1(b) PCT	
Rule 43(6) EPC	Rule 6.2(a) PCT	
Rule 43(7) EPC	Rule 6.2(b) PCT	
Rule 44(1) EPC	Rule 13.2 PCT	
Rule 44(2) EPC	Rule 13.3 PCT	
Rule 48 EPC	Rule 9.1(i)-(iv) PCT	
Rule 49(2) EPC	Rule 10.1(a), (b), (d) and (e) PCT Rule 10.2 PCT Rule 11.6(c) PCT, Rule 11.10 PCT Rule 11.11 PCT, Rule 11.13 PCT Rule 11.13(l) and (m) PCT	See decision of the President of the EPO of 25.11.2022 on the presentation of application and other documents (OJ EPO 2022, A113).
Rule 55 EPC	Rule 20.3 PCT; Rule 20.4 PCT	The provision under the EPC does not apply to claims. An invitation under Rule 58 EPC is issued in that case.
Rule 56 EPC	Rule 20.5 PCT	The provision under the EPC does not apply to missing claims.

EPC provisions	PCT provisions	Comments
Rule 56a EPC	Rule 20.5*bis* PCT	
Rule 134(5) EPC	Rule 82*quater* PCT	
Rule 136 EPC	Rule 26*bis*.3 PCT, Rule 49*ter*.2 PCT	
Rule 137(2) EPC	Art. 19(1) PCT, Art. 34(2)(b) PCT, Rule 66.4 PCT	
Rule 137(3) EPC	Art. 34(2)(b) PCT, Rule 66.3(a) PCT, Rule 66.4 PCT, Rule 66.4*bis* PCT	
No equivalent	Art. 7(2)(ii) PCT, Rule 7 PCT	
No equivalent	Rule 65.1 PCT	derives from practice

3.2 Annex II: Criteria chosen by the EPO as ISA/IPEA on specific points in the ISPE Guidelines

In a number of cases the ISPE Guidelines leave ISAs/IPEAs the choice between alternative guidelines upon which each ISA/IPEA may rely as appropriate.

The options are set out in the appendices to the chapters of the ISPE Guidelines mentioned below. The paragraph number (e.g. Point A5.16) refers to the relevant paragraph in the chapter concerned (in this case Chapter 5, point 16).

The EPO as ISA/IPEA has chosen the options listed below.

Appendix to Chapter 4

Point A4.05	References to prior art	Option [1] applies

Appendix to Chapter 5

Point A5.16	Multiple dependent claims	Option [2] applies
Point A5.20	Interpretation of claims	Option [2] applies
Point A5.21	The EPO applies the first sentence concerning "use" claims	
Point A5.26	Product-by-process claims	Option [1] applies

Point A5.42	Conciseness	Option [2] applies

Appendix to Chapter 9

Point A9.07	Excluded subject matter	Option [2] applies
Point A9.15	Programs for computers	Option [2] applies

Appendix to Chapter 12

Point A12.02	Novelty: effective date	Option [1] applies

Appendix to Chapter 13

Point A13.08.1	The EPO applies the problem-solution approach

Appendix to Chapter 14

Point A14.01[2]	The EPO applies the criterion of industrial applicability

Appendix to Chapter 20

Point A20.21	Disclaimer	Option [2] applies

PCT – Part A

Guidelines for Formalities Examination

Contents

Chapter I – Introduction

1. Overview

This current edition of Part A of the PCT-EPO Guidelines deals with filing requirements (Chapter A-II), fees (Chapter A-III), certain special provisions (Chapter A-IV), drawings (Chapter A-V), certain formal requirements (Chapter A-VI), languages (Chapter A-VII) and common provisions (Chapter A-VIII). Other chapters relating to formalities will gradually be added in successive editions.

2. Purpose of Part A

Formalities officers should note that this Part A is intended to provide them with knowledge and background to help them carry out their functions in a uniform and expeditious manner. It provides guidance in addition to other relevant PCT legal sources, such as the PCT Administrative Instructions, the PCT Receiving Office Guidelines, the PCT International Search and Preliminary Examination Guidelines and the Euro-PCT Guide. In case of conflict, the PCT Administrative Instructions, the PCT Receiving Office Guidelines and the PCT International Search and Preliminary Examination Guidelines prevail.

3. Other parts ~~Parts~~ relating to formalities

It should be noted that information on the procedures for formalities examination at the EPO in its capacity as RO, (S)ISA and IPEA is not restricted to this Part A. Other chapters of the PCT-EPO Guidelines are necessary for the work carried out by formalities officers.

Chapter II – Filing of international applications and examination on filing

1. Where and how international applications may be filed

1.1 Filing with the EPO as receiving Office

Natural and legal persons who are nationals or residents of a PCT contracting state may file an international application with any of the following as receiving Office, provided that this option is available to them:

Art. 2(xv)
Art. 9, 10
Rule 18, 19
~~GL/PCT-EPO~~ A-II, 3.2

– the national office of that state

– the office acting for that state

– the International Bureau (IB)

Natural and legal persons who are nationals or residents of an EPC contracting state may file an international application with the EPO as receiving Office instead.

Art. 151 EPC
Rule 157(1) EPC
OJ EPO 2014, A33

If there are two or more applicants, it is sufficient for at least one of them to satisfy these requirements. For instance, if a national or resident of a contracting state to the PCT and the EPC is mentioned in the PCT request form as inventor and applicant for the purposes of the United States only, the international application may be filed with the EPO as receiving Office regardless of the residence and nationality of the other applicant(s).

OJ EPO 2014, A33
PCT/AI 203
WIPO PCT Guide 5.020-5.023
PCT Newsletter 5/2012, 8
4/2014, 6

The national patent offices of Belgium, Monaco, Montenegro and San Marino have ceased to act as receiving Offices under the PCT and delegated this task to the EPO, which will thus act as receiving Office on their behalf for all international applications filed by applicants who are nationals or residents of, or have their principal place of business in, one of these states.

Rule 19.1(b)
OJ EPO 2018, A17
OJ EPO 2018, A105
OJ EPO 2019, A96
OJ EPO 2022, A82

For more information on when the EPO is competent to act as receiving Office (~~,~~ see ~~GL/PCT-EPO~~ A-II, 2).

1.2 Methods of filing with the EPO as receiving Office

International applications must be filed using the PCT request form (PCT/RO/101)~~ and submitted either electronically or on paper~~.

They can be filed online in electronic form, or by delivery by hand or by post in paper form. If the application is filed online, fee reductions apply (see A-III, 8.1.1).

Rule 11, 92.4 PCT
OJ EPO 2017, A11
OJ EPO 2018, A18, A27
OJ EPO 2023, A48

OJ EPO 2024, A41, A42
WIPO PCT Guide 6.003

The EPO no longer accepts international applications filed by fax (a change with effect from 1 July 2024). Nor does it accept international applications filed by email, telegram, telex or teletext.

1.2.1 Filing of applications electronically

Rule 89bis
OJ EPO 2024, A88
OJ EPO 2023, A48, OJ EPO 2023, A97

An international application may be filed electronically with the EPO as receiving Office, either online or offline on electronic data carrier ("physical medium").

OJ EPO 2021, A21, A43
OJ EPO 2018, A25

All documents filed electronically must comply with the requirements set out in Part 7 of the Administrative Instructions under the PCT and Annex F thereof, which sets out the standard for the electronic filing and processing of international applications.

The EPO offers the following free-of-charge electronic filing tools:

OJ EPO 2023, A96

– Online Filing (OLF)~~, a software application~~. Filings using the OLF software may be made online or on electronic data carriers accepted by the EPO. At present, the data carriers accepted are CD-Rs conforming to ISO 9660, DVD-Rs and DVD+Rs.

OJ EPO 2024, A32

– Online Filing 2.0

~~– Web-Form Filing~~

– EPO Contingency Upload Service

OJ EPO 2014, A107

In addition, applicants may use ePCT, an electronic filing tool offered by WIPO.

OJ EPO 2020, A59

The EPO no longer accepts international applications filed with it as receiving Office using the PCT-SAFE filing software. This has been the case since 1 July 2020.

~~*OJ EPO 2023, A48*~~

~~Filings using the OLF software may be made online or on electronic data carriers accepted by the EPO. At present, the data carriers accepted are CD-Rs conforming to ISO 9660, DVD-Rs and DVD+Rs.~~

All the means of electronic filing, except for ~~the Web-Form Filing service and~~ the EPO Contingency Upload Service, allow applicants to fill in the PCT request form (PCT/RO/101) directly in the electronic document formats that are accepted by the EPO as receiving Office.

PCT/AI 706
~~*OJ EPO 2023, A48*~~
OJ EPO 2024, A88

If the documents making up the international application have been prepared by conversion from a different electronic document format (pre-conversion format), the applicant may submit the documents in that format too, preferably together with a statement that the international application in electronic form is a complete and accurate copy of the documents in pre-conversion format. Each pre-conversion document must be in a format that fulfils the requirements stipulated in ~~OJ EPO 2023, A48~~ OJ EPO 2024, A88. It is recommended that pre-conversion documents be

submitted as ZIP files. The purpose of filing in pre-conversion format is that if an applicant discovers that the relevant part of the international application as filed in electronic form is not a complete and accurate copy of the document submitted in pre-conversion format, they may ask the EPO in its capacity as receiving Office to correct the international application accordingly within 30 months of the priority date.

~~**1.2.2 Filing of applications by fax**~~

~~An international application may no longer be filed by fax with one of the EPO's filing offices in Munich, The Hague or Berlin. All EPO filing offices are based in the Central European Time (CET) zone.~~ ~~*Rule 92.4*~~ ~~*Rule 29.1*~~ ~~*OJ EPO 2019, A18*~~ ~~*AI 331*~~

~~If an international application is filed by fax, the date on which the application documents are received in full is accorded as the date of filing, provided that the requirements under Art. 11 are fulfilled (see GL/PCT-EPO A-II, 4.1).~~

~~If an international application is filed by fax, the original, i.e. the confirmation copy, must be filed, preferably simultaneously, and the fax should state that the confirmation copy has been filed separately on paper at the same time. The confirmation copy should be a single copy of each document making up the application and each accompanying document. The first page of the PCT request form (PCT/RO/101) sent as a confirmation copy should be marked "CONFIRMATION COPY", followed by the date of the fax transmission. It is recommended that the confirmation copy be accompanied by EPO Form 1032, which is available on the EPO website.~~

~~If the confirmation copy has not been received within 14 days of receipt of the application, the EPO as receiving Office will despatch an invitation to submit it within a month (Form PCT/RO/141). If the confirmation copy is not provided within this time limit, the international application will be considered withdrawn (Form PCT/RO/117).~~

~~If an international application filed by fax is illegible or incomplete, or the fax transmission has failed, the application will be treated as not having been received and the sender must be notified as soon as possible using Form PCT/RO/140.~~

1.2.2 ~~1.2.3~~ Filing of applications by delivery by hand or by post

An international application may be filed by delivery by hand or by post with one of the EPO's filing offices in Munich, The Hague or Berlin. Neither the sub-office in Vienna nor the Brussels Bureau is a filing office. The EPO's addresses and opening hours can be found on its website. All EPO filing offices are based in the Central European Time (CET) zone, i.e. UTC +1, and Central European Summer Time (CEST) i.e. UTC +2. CEST starts on the last Sunday in March and ends on the last Sunday in October. ~~For further details, see GL/EPO A-II, 1.2.~~ *OJ EPO 2018, A18* *OJ EPO 2018, A27* *OJ EPO 2017, A11* *OJ EPO 2006, 439*

The EPO filing offices in Munich's PschorrHöfe building and Berlin (see the decision of the President of the EPO dated 3 January 2017, OJ EPO 2017, A11) are equipped with automated mailboxes, which may be used at any

time. There is no automated mailbox facility in Munich's Isar building or The Hague; outside office hours, documents may be handed to a porter.

Art. 3(2) PCT
Art. 4-7 PCT
Rule 3.3 PCT
Rule 4-8 PCT
Rule 11.1 PCT
Rule 157(2) EPC
WIPO PCT Guide 5.010, 5.179
OJ EPO 2006, 439

The documents making up the international application must be filed in one copy only: PCT request form, description, claims, abstract and drawings (Box No. IX of the PCT request form). The same applies to any other documents referred to in Rule 3.3(a)(ii) PCT and listed in Box No. IX of the PCT request form.

The ~~date of filing~~ international filing date accorded to an application delivered by hand or by post is the date of handing over or receipt respectively at an EPO filing office, provided that the requirements under Art. 11 are fulfilled (see ~~GL/PCT-EPO~~ A-II, 4.1).

Art. 48(1)
Rule 26bis.3, 82.1, 82quater
OJ EPO 2015, A29

If a filing sent by post is lost or delayed, the EPO accepts evidence of posting only if the document was sent via a postal authority or one of the following generally recognised postal service providers: Chronopost, DHL, Federal Express, flexpress, TNT, SkyNet, UPS or Transworld. As evidence, confirmation of registration by the post office or confirmation of receipt by the postal service provider must be provided at the EPO's request. Rules 82 and 82*quater* do not apply to the priority period, but they do apply to the time limit for submission of a request for restoration of the right of priority under Rule 26*bis*.3 (see ~~GL/PCT-EPO~~ A-VI, 1.5).

1.2.3 ~~1.2.4~~ Filing of applications by other means

OJ EPO 2024, A41, A42
OJ EPO 2000, 458
~~OJ EPO 2019, A18~~

International applications may not be filed with the EPO by fax, by email or similar means of communication. Any application filed by such means will be considered not to have been received and the applicant will be informed accordingly using Form PCT/RO/142 or other suitable means.

They thus have no legal effect in the proceedings under the PCT and cannot be used validly to perform any procedural act. No time limit in connection with a procedural act can be complied with by such means.

1.3 Filing of documents subsequent to the application

Rule 17 PCT
OJ EPO 2016, A78
OJ EPO 2019, A27
OJ EPO 2023, A48
~~OJ EPO 2019, A18~~
OJ EPO 2024, A41, A42

Documents subsequent to the international application may be filed with the EPO as receiving Office electronically or on paper (~~;~~ see ~~GL/PCT-EPO~~ A-II, 1.2).

~~In the international phase, authorisations may not be filed with the EPO as receiving Office by fax or using the EPO Web-Form Filing service.~~

Priority documents issued in paper form which have to be certified by the issuing authority should also be submitted to the EPO in that form to ensure the validity of the certification. On the other hand, priority documents issued in electronic form ~~may not be filed by fax, using the EPO Web-Form Filing service or using the EPO Contingency Upload Service. Priority documents~~ may only be filed electronically using OLF or Online Filing 2.0, and provided they have been digitally signed by the issuing authority and the signature is

accepted by the EPO; they may not be filed using the EPO Contingency Upload Service (see EPC Guidelines A-III, 6.7.1). Electronic priority ~~Priority~~ documents may also be filed with the IB using ePCT.

~~If a document subsequent to the international application is filed by fax, there is no need to submit a confirmation copy unless the receiving Office invites the applicant to submit one (Form PCT/RO/141). It might do so particularly for substitute sheets under Rule 26 and sheets to be incorporated by reference under Rule 20.6. For such sheets, applicants are therefore advised to submit a confirmation copy on their own initiative directly after sending them by fax. If a confirmation copy is not submitted within the time limit prescribed in the invitation issued by the receiving Office, the document will be treated as not having been received (Form PCT/RO/149).~~

~~Rule 92.4(g)(ii)~~
~~OJ EPO 2019, A18~~

1.4 Debit orders for deposit accounts held with the EPO

An international application may be accompanied by a debit order for the fees due on filing. For the electronic means of filing accepted for debit orders ~~,~~ see ~~GL/PCT-EPO~~ A-III, 3.

1.5 Application numbering system

At the EPO, the number range starting at 000001 (PCT/EPyyyy/000001) is used for paper filings ~~(including faxes)~~. ~~The number range starting at 025000 (PCT/EPyyyy/025000) is used for filings made via Web-Form Filing.~~ The number range starting at 050000 (PCT/EPyyyy/050000) is assigned to electronic filings made using Online Filing 2.0, OLF or ePCT.

AI 307

2. Competence of the EPO to act as receiving Office

The EPO is competent to act as the receiving Office for an international application provided that:

– The applicant is a **national or resident** of an EPC contracting state which is also a PCT contracting state (currently the case for all EPC contracting states). If there are two or more applicants, at least one must be a resident or national of an EPC contracting state. A person mentioned only as an inventor does not qualify as an applicant. Hence, the nationality or residence of a person mentioned only as an inventor is irrelevant for determining whether the EPO is competent to act as receiving Office.

Rule 19.1-19.2
Rule 157(1) EPC
OJ EPO 2014, A33

– The international application is filed in one of the **EPO's official languages** (English, French or German).

Rule 12.1(a)
Art. 14 EPC
Rule 157(2) EPC

Where the applicant is not a national or resident of an EPC contracting state or the application is in a language other than English, French or German, the EPO is not the competent receiving Office and the EPO will transmit the purported international application to the IB. The applicant will be informed accordingly (Form PCT/RO/151). For the purpose of the international filing date, the application will nevertheless be considered to have been received by the IB as receiving Office on the date that the EPO received it. In such cases, the EPO does not charge the transmittal fee for

Rule 19.4(b)
Rule 19.4(c)
OJ EPO 1993, 764
GL/RO 274

the transmittal of the documents to the IB. Any fees paid to the EPO will be refunded.

Art. 16
Rule 4.1(b)(iv), 4.14bis
Art. 152 EPC
Agreement EPO-WIPO, Art. 3(1)
OJ EPO 2017, A115
PCT/AI Annex C

If an international application is filed with the EPO acting as receiving Office, the EPO is the only competent ISA, so the ISA does not need to be entered in Box No. VII of the PCT request form.

3. Procedure on filing

3.1 Acknowledgement of receipt

OJ EPO 2023, A48

For international applications filed online using OLF or~~,~~ Online Filing 2.0~~ or Web-Form Filing~~, receipt is acknowledged electronically following successful submission. The acknowledgement contains the identity of the receiving Office, the date and time of receipt, a reference or application number, a list of the files transmitted and, for online filings using OLF or Online Filing 2.0, a message digest, i.e. the message in compressed form.

OJ EPO 2019, A19
OJ EPO 2023, A48

The EPO as receiving Office will acknowledge receipt of a purported international application filed on paper ~~, by fax~~ or ~~using~~ on an electronic data carrier. To do this, it uses ~~using~~ EPO Form 1031, which will be sent by post, as a rule within four working days. In it, the EPO will explicitly confirm the receipt of each document making up the international application and each accompanying item. However, the EPO does not verify the number of sheets making up a given document. ~~EPO Form 1031 is also sent for international applications filed using Web-Form Filing, in addition to the electronic acknowledgement of receipt generated for such applications.~~

The EPO acknowledges receipt of documents filed using the EPO Contingency Upload Service electronically in the service. An acknowledgement indicating in particular the application number, where applicable, is also sent in accordance with the provisions governing the filing of documents on paper.

Upon receipt of paper documents purporting to be an international application, the EPO as receiving Office proceeds according to GL/RO, Chapter IV, paragraph 35.

~~For general information on the receipt of documents at the EPO and for information on acknowledgement of receipt by fax, see GL/EPO A-II, 3.1, which applies *mutatis mutandis* to international applications.~~

3.2 Filing via a competent national authority

Art. 10 PCT
Rule 157(1) EPC

If the applicant has chosen the EPO as receiving Office, the international application should be sent directly to one of the EPO filing offices and not to a national patent office.

The national law of an EPC contracting state may stipulate that, for national security reasons, an international application must be filed with the EPO as receiving Office via a competent authority of that state.

Art. 75(2), 151 EPC
Rule 157(1), (3) EPC
Rule 19.1(b)
GL/RO Chapter III
GL/RO 43

In such cases, the national authority will act as the "filing office" for the EPO acting as receiving Office. The date of receipt of the application by the national authority will be accorded as the international filing date by the EPO as receiving Office, provided that the application meets the PCT requirements for a filing date to be accorded (see ~~GL/PCT-EPO~~ A-II, 4.1).

The national authority must ensure that the application reaches the EPO not later than two weeks before the end of the 13th month from filing or, if priority is claimed, from the earliest date of priority. For further details, see GL/RO Chapter III.

The addresses of the national patent authorities of the EPC contracting states and information on national legislation are provided in the publication "National law relating to the EPC", available on the EPO website (*epo.org*).

4. Examination on filing

4.1 Minimum requirements for according an international filing date

Art. 11
GL/RO 39-44

The international filing date of an international application is the date on which it is received at one of the EPO's filing offices, or at a national authority in an EPC contracting state (see ~~GL/PCT-EPO~~ A-II, 3.2), provided that the following minimum requirements are fulfilled at the time of receipt:

– The applicant is a resident or national of an EPC contracting state.

– The application (description and claim(s)) is in English, French or German.

– The application contains at least the following elements:

  – an indication that it is intended as an international application (this indication is in the header of the request form, PCT/RO/101)

  – a request which constitutes the designation of a state bound by the PCT on the international filing date (filing the request form, PCT/RO/101, automatically designates all PCT contracting states)

  – the name of the applicant

  – a part which on the face of it appears to be a description

  – a part which on the face of it appears to be a claim or claims.

If these requirements have been fulfilled, the purported international application will be accorded its actual date of receipt as the international filing date; the applicant will be notified accordingly (Form PCT/RO/105).

Each international application has a single filing date. The term "international filing date" should therefore not be interpreted to mean any further filing date in respect of an international application. The word "international" only refers to the fact that the application concerned was filed as an application under the PCT.

The (international) filing date is not to be confused with the date of entry into the European phase before the EPO or into any national phase before a designated/elected Office. This means that even after entry into the European phase any reference to the filing date of the application concerned is a reference to the international filing date.

4.1.1 Transmittal of the international application to the ISA and IB

Art. 12
Rules 21, 93.1
PCT/AI 305

One copy of the international application is kept by the receiving Office ("home copy"), one copy ("record copy") is transmitted to the IB, and another copy ("search copy") is transmitted to the competent ISA.

Art. 12
Rules 22, 23, 24, 25, 93.2
PCT/AI 705bis

The record copy is the copy of the international application transmitted to the IB by the receiving Office for publication purposes. It is transmitted promptly after an international filing date has been accorded; the EPO as receiving Office transmits it electronically. This record copy is kept in the IB's records and considered the true copy of the international application. It consists of the application documents and accompanying items filed on the international filing date. It must be transmitted even if the international application is considered withdrawn by the receiving Office or has been withdrawn by the applicant. In this case, the notice effecting withdrawal must also be transmitted.

Art. 12
Rule 93.3

The search copy is the copy of the international application that is transmitted to the competent ISA by the receiving Office for the purposes of performing the international search once the search fee has been paid. It is kept in the competent ISA's records.

4.2 Defects

Art. 11(2)
Rule 20
GL/RO 45-48A

If the EPO as receiving Office finds that, at the time of receipt, the international application does not comply with one or more of the requirements under Art. 11 for according an international filing date, it will invite the applicant to file the required correction(s) within two months of the date of the invitation (Form PCT/RO/103). If the applicant complies, the international filing date will be the date of receipt of the correction(s); otherwise, the application will not be treated as an international application (Form PCT/RO/104). For further details on the procedure followed by the EPO as receiving Office in the event of defects under Art. 11(1), see GL/RO 45-48 and 50.

Rule 4.18, 20.5

If the defect is the omission of an element (description or claims), the applicant may decide either to furnish the missing element as a correction under Art. 11(2) and Rule 20.3(a)(i) as described above or to confirm its incorporation by reference. The second option is described in ~~GL/PCT-EPO~~ A-II, 5.

If the time limit for the correction of the purported international application expires after the 12-month priority period, the applicant's attention is drawn to this circumstance in Form PCT/RO/103.

5. Incorporation by reference of missing elements or parts

If the applicant has omitted to file with the international application a part of the description or of the claims, part or all of the drawings or an entire element, i.e. the entire description or all the claims, the omission may be incorporated in the international application by reference. *Rule 4.18, 20.3, 20.5, 20.6, 20.7*

Firstly, the omission must be completely contained in an application from which priority was claimed on the international filing date. For an omission to be "completely contained", it must be identical to the corresponding text/drawing in the priority document.

Secondly, the PCT request must have contained a statement of incorporation by reference to the priority application. A statement to that effect is already provided for in Box VI of the PCT request form (PCT/RO/101).

Thirdly, the conditions for confirmation in Rules 20.6 and 20.7 must be met.

If all the conditions are met, the omission is considered to be incorporated by reference and the international filing date is unaffected.

If the description and/or claims as contained in the priority application do not qualify as missing parts on the grounds that the international application already contained a complete description and/or a complete set of claims, the EPO as receiving Office will proceed to a negative finding under GL/RO paragraph 205D and will not transmit the international application to the IB in accordance with Rule 19.4(a)(iii).

An applicant wishing to add to an international application omitted parts which have no basis in a priority application may do so under Rule 20.5. However, the filing date of the application as a whole will then be the date on which the missing parts are filed.

6. Correction of erroneously filed elements or parts

If the international application contains an erroneously filed element (description or claims) or an erroneously filed part of the description, claims or drawings (including the case where all the drawings have been erroneously filed), the applicant may correct the international application by furnishing the correct element or part under Rule 20.5*bis*. *Rule 20.5bis*

According to that rule, which entered into force on 1 July 2020, the applicant may request to either *OJ EPO 2022, A71* *OJ EPO 2020, A81*

(a) correct the international application under Rule 20.5*bis*(b) or (c) (see ~~GL/PCT-EPO~~ A-II, 6.1); or

(b) where the correct element or part is contained in a priority application, incorporate it in the international application by reference under Rule 20.5*bis*(d).

Until 31 October 2022, this latter option was not available at the EPO, since this procedure was incompatible with the legal framework under the EPC. The EPO as receiving Office had therefore notified the IB of this incompatibility under Rule 20.8(a-*bis*). However, following the withdrawal of this notification of incompatibility with Rule 20.5*bis*(a)(ii) and (d), the EPO as receiving Office may now also process requests for incorporation by reference of the correct element or part for international applications filed on or after 1 November 2022 (see ~~See GL/PCT-EPO~~ A-II, 6.2).

For details on the procedure before the EPO as International Searching Authority (~~,~~see ~~GL/PCT-EPO~~ B-III, 2.3.3). For the procedure before the EPO as designated or elected Office (~~,~~see ~~GL/EPO~~ EPC Guidelines C-III, 1.3).

6.1 Correct element or part not furnished for the purpose of incorporation by reference

Rule 20.5bis(b) and (c)

The procedure to be followed varies depending on whether the correction is requested either on/before the date on which the requirements under Art. 11(1) for the accordance of an international filing date are fulfilled (see ~~GL/PCT-EPO~~ A-II, 6.1.1) or after that date (see ~~GL/PCT-EPO~~ A-II, 6.1.2).

6.1.1 International filing date has not yet been accorded

Rule 20.5bis(b)
AI 310
GL/RO 203A

If the international filing date has not yet been accorded, the wrong element or part will be replaced with the correct one and the international filing date will be the date on which the requirements under Art. 11(1) are fulfilled, taking into account the correct element or part only. The EPO as receiving Office follows the procedure outlined in AI, section 310.

6.1.2 International filing date has already been accorded

Rule 20.5bis(c)
AI 310 and 310bis
GL/RO 203A and B

If the requirements under Art. 11(1) have already been fulfilled and the international filing date has been accorded, the wrong element or part will be replaced with the correct one and the international filing date will be changed to the date on which the correct element or part was received, unless the applicant requests that the correct element or part be disregarded under Rule 20.5*bis*(e). The EPO as receiving Office follows the procedure outlined in AI, sections 310 and 310*bis*.

6.2 Correct element or part furnished for the purpose of incorporation by reference

Rule 20.5bis(a)(ii) and (d)
OJ EPO 2022, A71
AI 309
GL/RO 241

For international applications filed on or after 1 November 2022, the EPO as receiving Office will process requests for incorporation by reference under Rule 20.5*bis*(d) of the correct element or part. If the requirements of Rules 20.6(b) and 4.18 are fulfilled, the correct element or part will be considered to have been contained in the purported international application on the date on which one or more elements referred to in Art. 11(1)(iii) were first received by the receiving Office, without a change to the international filing date. The wrong element or part, marked as "ERRONEOUSLY FILED (RULE 20.5*bis*)", will remain in the international application. The EPO as receiving Office follows the procedure outlined in

AI, section 309. This will have no impact on the calculation of the international filing fee since the fee amount depends on the total number of sheets of the international application at the time of filing.

For the procedure before the EPO as ISA (see ~~GL/PCT-EPO~~ B-III, 2.3.3) and for the procedure before the EPO as SISA (see ~~GL/PCT-EPO~~ B-XII, 3). For the procedure before the EPO as IPEA (see ~~GL/PCT-EPO~~ H-II, 2.2.2) and the notice from the EPO dated 14 June 2020, OJ EPO 2020, A81. For the procedure before the EPO as designated Office/elected Office (see ~~GL/EPO~~ EPC Guidelines C-III, 1.3).

Rule 19.4(a)(iii)
Rule 20.5bis(a)(ii) and (d)
Rule 20.8(a-bis)
AI 309(g)
GL/RO 195

For international applications filed until 31 October 2022, if the applicant requests within the time limit under Rule 20.7 that a correct element or part be incorporated by reference, the EPO as receiving Office will transmit the international application to the IB as receiving Office, provided the applicant authorises it to do so. No fee will be charged under Rule 19.4(b) for such transmittal. Unless the applicant has already submitted authorisation to transmit the international application, the EPO as receiving Office will invite the applicant to do so using Form PCT/RO/152.

If the applicant does not authorise the transmittal, the request will be treated as a request for correction under Rule 20.5*bis*(b) or (c). The EPO as receiving Office will therefore follow the procedure outlined in ~~GL/PCT-EPO~~ A-II, 6.1.

Chapter III – Fees

1. General

Guidance for the payment of fees, expenses and prices is published in each issue of the EPO's Official Journal. Updated information relating to fees and methods of payment, including the EPO bank account for payments in euro, can also be found on the EPO website (*epo.org*) under: *Applying for a patent → Fees → International (PCT) fees*. Applicants are also recommended to consult the latest information available on the WIPO website.

2. Amounts of fees

The latest information about amounts can be found on both the EPO website (*epo.org*, under *Applying for a patent → Fees → International (PCT) fees → Fees for international applications*) and the WIPO website (*wipo.int*, under *IP Services → PCT – The International Patent System → PCT Fee Tables*).

In addition, the amounts of the fees to be paid to the EPO can be found in the EPO's Schedule of fees and expenses published in the Official Journal and accessible via the EPO website (*epo.org*, under *Law & practice → Legal texts → Official Journal*).

The amount of fees to be paid for the benefit of the IB is fixed in Swiss francs and is specified in the Schedule of Fees which is annexed to the PCT Regulations (PCT Schedule of Fees) and forms an integral part thereof. If these fees are paid to the EPO, they must be paid in euros. Due to changes in the exchange rate between the euro and the Swiss franc, the equivalent amount is changed from time to time. Current fee rates are published in the PCT Newsletter, in WIPO's Official Notices (PCT Gazette) and in the EPO's Official Journal.

Rule 96.1
PCT Schedule of Fees

3. Methods of payment

Fee payments to the EPO may be validly made by anyone: applicants, agents and any other person.

Rules 14.1(c), 15.3, 16.1(f), 57.2, 96.1
OJ EPO 2022, A81
OJ EPO 2015, A53

All fees which are to be paid to the EPO must be paid in euros:

– by payment or transfer to a bank account held by the EPO; or

– by credit card; or

OJ EPO 2017, A72
OJ EPO 2022, A18
OJ EPO 2022, A81

Supplementary publication 2, OJ EPO 2024 ~~*Supplementary publication 3, OJ EPO 2022*~~ *OJ EPO 2022, A81* ~~*Supplementary publication 3, OJ EPO 2023, 10*~~ *OJ EPO 2023, A58*

– by debiting a deposit account held with the EPO on the basis of a debit order filed in an electronically processable format (XML) using one of the accepted electronic means of filing, i.e. the EPO Online Filing software, Online Filing 2.0 or ePCT. Alternatively, a debit order can be submitted in electronic format via Central Fee Payment. Details of payment by deposit account may be found in the Arrangements for deposit accounts (ADA) and their annexes, which can also be found on the EPO website (*epo.org*).

Rule 82quater.2

In the event of a general unavailability of the permitted electronic means of communication, the EPO will make use of the extension of time limits for the payment of fees, as for the performance of any other procedural acts, and will inform the IB accordingly. The EPO Contingency Upload Service may be used exceptionally to file debit orders on condition that the payment period expires on the day of the debit order's submission, the deposit account contains sufficient funds for the debit to be carried out, and evidence is provided (e.g. in the form of screenshots) that the payee is affected by such unavailability, outage or system malfunction, irrespective of its cause. If any of these conditions is not met, the debit order filed via the EPO Contingency Upload Service is invalid and thus will not be carried out.

OJ EPO 2007, 626

Payment of fees by cheque delivered or sent directly to the EPO was abolished with effect from 1 April 2008.

Art. 7(1) RFees

The date to be considered as the date on which a payment is made is established in accordance with the EPO's Rules relating to Fees.

4. Fees to be paid to the EPO as receiving Office

4.1 Transmittal fee

Rule 14
Art. 2(1) RFees
Rule 157(4) EPC
OJ EPO 2018, A4
OJ EPO 2019, A3
OJ EPO 2019, A6

The transmittal fee is paid for the benefit of the EPO as receiving Office (RO/EP) and its amount is fixed by the EPO. It is to be paid within one month from the date of receipt of the international application. The amount payable is the amount applicable on that date of receipt. As of a date to be set by the President of the EPO, if the international application is filed online in character-coded format, no transmittal fee will have to be paid. That date will be published in advance in the EPO's Official Journal.

4.2 International filing fee

Rule 15
OJ EPO 2018, A101

The international filing fee is collected by the RO/EP for the benefit of the IB and its amount is fixed by the IB. It is to be paid within one month from the date of receipt of the international application. The amount payable is the amount applicable on that date of receipt.

The international filing fee is made up of

– a fixed amount (the "basic" filing fee part); and

– an additional amount (the "page fee" part) for each sheet above 30 (including the abstract, even if missing at the time of filing the international application). *GL/RO 241*

Applicants must compute the additional amount themselves and not wait for a communication from the EPO, because as from expiry of the one-month time limit any missing amount may only be validly paid together with a late payment fee (see ~~GL/PCT-EPO~~ A-III, 4.5). For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.1).

The RO/EP will not confirm to the applicants that all fees have been duly paid, nor inform them in advance that an overpayment will be refunded (e.g. using Form PCT/RO/102).

However, if the RO/EP notes before the expiry of the time limit for payment of the relevant fee that the amount paid is not sufficient, it will either proceed to debit any missing amount from the applicant's deposit account where the applicant has authorised it to do so, or it may informally (e.g. by phone) invite the applicant to pay the shortfall before expiry of the time limit. If full payment of the amounts due has not been received upon expiry of the time limit, the RO/EP will proceed as described under ~~GL/PCT-EPO~~ A-III, 4.5.

In the event of overpayment, the RO/EP will inform the applicant by means of Form PCT/RO/132 that the refund due has been processed. No communication giving advance notice of the refund is sent.

If the application contains a sequence listing as part of the description, the pages forming that part are not taken into account for calculating the page fee if the following requirements are met:

(i) the application is filed in electronic form,

(ii) the sequence listing forming part of the application is filed in XML format in compliance with WIPO Standard ST.26 (see *Annex C* to the Administrative Instructions under the PCT, paragraph 4).

If any other option for filing a sequence listing is chosen – filing on paper, in image format or in another electronic format which is not XML – the additional amount of the international filing fee is calculated taking into account each page of the sequence listing. If necessary, this additional amount is calculated after conversion by the RO/EP of the file into the format of the main part of the description. The RO/EP then invites the applicant to confirm whether the content of that converted file is intended to form part of the description and to pay any corresponding page fee (Form PCT/RO/132) within a time limit of one month from the date of the invitation. The content of the converted file is not considered part of the international application if the applicant so indicates or fails, within that time limit, to pay the applicable fees. *OJ EPO 2022, A60*

4.3 International search fee

Rule 16
Art. 2(1) RFees
OJ EPO 2018, A4

The international search fee is collected by the RO/EP for the benefit of the EPO as International Searching Authority (ISA/EP) and its amount is fixed by the EPO. It is to be paid within one month from the date of receipt of the international application. The amount payable is the amount applicable on that date of receipt. For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.2).

If the international search fee is not fully paid within the prescribed time limit, the RO/EP proceeds as described under ~~GL/PCT-EPO~~ A-III, 4.5.

4.4 Fee for ~~establishment and transmittal to the IB of~~ a certified copy of the priority document

4.4.1 Fee for establishment and transmittal of a certified copy of the priority document to the IB

Rule 17.1(b) and (b-bis)
Art. 3(1) Rfees
~~OJ EPO 2023, A3~~
OJ EPO 2019, A27
OJ EPO 2024, A5
AI 715 and 716
PCT AG I 5.070
PCT Newsletter 4/2019

The fee for establishment and transmittal to the IB of a certified copy of the priority document is paid for the benefit of the RO/EP and applies only if the RO/EP is requested by the applicant to prepare and transmit such a copy (e.g. by checking the corresponding box in Box VI of the PCT request form, PCT/RO/101) and if the earlier priority application was filed before the EPO (EP applications or earlier PCT applications filed at the EPO). Its amount is fixed by the EPO. It is not due if the applicant requests the IB to obtain a certified copy of the priority application from a digital library and indicates the Digital Access Service (DAS) access code on the PCT request form (PCT/RO/101, Box VI).

OJ EPO 2020, A57

The procedure whereby the EPO includes, free of charge, a copy of the earlier application from which priority is claimed in the file of a European patent application (cf. ~~GL/EPO~~ EPC Guidelines A-III, 6.7) does not apply in respect of an international application processed by the RO/EP.

4.4.2 Fee for a certified copy of the priority document for the applicant

Rule 21.2
OJ EPO 2024, A5

The fee for a certified copy of the international application for the applicant is payable to the RO/EP and is fixed by the EPO (see A-VI, 1.8). No fee is payable if the request has been filed using MyEPO Portfolio.

4.5 Late payment fee

Rule 16bis.2
OJ EPO 1992, 383

If the transmittal fee, the international filing fee and the search fee are not paid within the prescribed time limits, or if the amounts paid are not sufficient to cover the fees due, the RO/EP invites the applicant to pay the missing amount together with a late payment fee for its own benefit (Form PCT/RO/133). Such payment has to be made within one month from the date of the invitation.

The late payment fee is equal to 50% of the amount of the unpaid fee or, if the resulting amount is less than the transmittal fee, to an amount equal to the transmittal fee. The late payment fee may however not exceed the amount of 50% of the international filing fee as specified in the PCT Schedule of Fees (without taking into account any fee due for each page of the international application in excess of 30 pages).

If the applicant complies with the invitation (Form PCT/RO/133) within the indicated time limit, payment is deemed to have been made in due time.

If the applicant pays the fees after the time limit for payment expires but before the invitation is issued by the RO/EP (Form PCT/RO133), the payment is considered to have been received in time.

Failure to pay the missing amount with the late payment fee within the one-month time limit set in the invitation (Form PCT/RO/133) will result in the international application being considered withdrawn. The RO/EP will so declare (Form PCT/RO/117). *Art. 14(3)(a)*

Nevertheless, if the applicant pays the fees after the time limit set in the invitation expires (Form PCT/RO/133) but before the RO/EP has despatched the notification of withdrawal of the international application (Form PCT/RO/117), the payment is considered to have been received in time and the application will not be considered withdrawn. *Rule 16bis.1(e)*

4.6 Fee for requesting restoration of priority right

The fee for requesting restoration of priority right is paid for the benefit of the RO/EP and its amount is fixed by the EPO. It is to be paid within the same time limit as for filing the request for restoration, which is two months from expiry of the priority period. The amount payable is the amount applicable on the date of receipt of the request for restoration. *Rule 26bis.3(d), (e)*

5. Fees to be paid to the ISA/EP

5.1 Additional search fee

The additional search fee paid in response to an invitation to pay additional fees after a finding of lack of unity (Form PCT/ISA/206, see ~~GL/PCT-EPO~~ B-VII, 6.2) is collected directly by the EPO as International Searching Authority (ISA/EP) and its amount is fixed by the EPO. This fee is to be paid within one month from the date of the invitation. The amount payable is the amount applicable on the date of receipt of the international application. For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.2.1). *Rule 40*

The applicant must also pay the ISA/EP an additional search fee (equal to the search fee) where the receiving Office notifies it of a correct element or part under Rule 20.5*bis* PCT after the start of the search and the applicant wants the search to be based on that correct element or part. This additional fee must be paid within one month from the date of the invitation to do so. No additional search fee is to be paid to the ISA/EP under Rule 40*bis*.1 PCT in the case of missing parts (Rule 20.5 PCT). *Rule 40bis.1*
Art. 2(1) item 2 RFees ~~Rfees~~
OJ EPO 2020, A81

5.2 Protest fee

The protest fee is paid for the benefit of the ISA/EP and its amount is fixed by the EPO. It is to be paid within one month from the date of the invitation to pay additional fees after the finding of lack of unity (Form PCT/ISA/206, see ~~GL/PCT-EPO~~ B-VII, 6.3). The amount payable is the amount applicable on the date of payment. *Rule 40.2(e)*

5.3 Fee for the late furnishing of sequence listings

Rule 13ter.1(c)
~~*OJ EPO 2023, A3*~~
OJ EPO 2024, A5
OJ EPO 2021, A96 and A97

The late furnishing fee is paid for the benefit of the ISA/EP and its amount is fixed by the EPO. It is payable within one month from the date of the invitation to furnish the nucleotide and/or amino acid sequence listing (Form PCT/ISA/225, see ~~GL/PCT-EPO~~ B-VIII, 3.2). The amount payable is the amount applicable on the date of payment.

6. Fees to be paid if a SIS request is submitted

Rule 45bis

To obtain a supplementary international search, the supplementary search handling fee and the supplementary search fee have to be paid to the IB in Swiss francs.

6.1 Supplementary search handling fee

Rule 45bis.2

The supplementary search handling fee is collected by the IB for its own benefit and its amount is fixed by the IB. The supplementary search handling fee is to be paid within one month from the date of receipt of the supplementary search request (Form PCT/IB/375). The amount payable is the amount applicable on the date of payment. For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.3).

6.2 Supplementary search fee

Rule 45bis.3
Art. 2(1) RFees
OJ EPO 2018, A4

The supplementary search fee is collected by the IB for the benefit of the EPO as Supplementary International Searching Authority (SISA/EP) and its amount is fixed by the EPO. It is to be paid within one month from the date of receipt of the supplementary search request (Form PCT/IB/375). The amount payable is the amount applicable on the date of payment.

6.3 Review fee

Rule 45bis.6(c)

The review fee is collected by the SISA/EP for its own benefit and its amount is fixed by the EPO. It is to be paid within one month from the date of the notification of lack of unity of invention (see ~~GL/PCT-EPO~~ B-XII, 10.4).

7. Fees to be paid to the IPEA/EP

7.1 Handling fee

Art. 31(5)
Rule 57
GL/ISPE 22.44
OJ EPO 2018, A101

The handling fee is collected by the EPO as International Preliminary Examining Authority (IPEA/EP) for the benefit of the IB and its amount is fixed by the IB. It is to be paid within one month from the date on which the demand (Form PCT/IPEA/401) was submitted or within 22 months from the priority date, whichever time limit expires later. The amount payable is the amount applicable on the date of payment. For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.3).

If the handling fee is not fully paid within the prescribed time limit, the IPEA/EP proceeds as described under ~~GL/PCT-EPO~~ A-III, 7.5.

7.2 Preliminary examination fee

The preliminary examination fee is collected by the IPEA/EP for its own benefit and its amount is fixed by the EPO. It is to be paid within one month from the date on which the demand (Form PCT/IPEA/401) was submitted or within 22 months from the priority date, whichever time limit expires later. The amount payable is the amount applicable on the date of payment. For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.4).

Art. 31(5)
Rule 58
Art. 2(1) RFees
OJ EPO 2018, A4
GL/ISPE 22.44

If the preliminary examination fee is not fully paid within the prescribed time limit, the IPEA/EP proceeds as described under ~~GL/PCT-EPO~~ A-III, 7.5.

7.2.1 Additional preliminary examination fee

The additional preliminary examination fee paid in response to an invitation to pay additional examination fees after a finding of lack of unity (Form PCT/IPEA/405, see ~~GL/PCT-EPO~~ C-V, 4.2) is collected by the IPEA/EP and its amount is fixed by the EPO. It is to be paid within one month from the date of the invitation. The amount payable is the amount applicable on the date of payment. For any reductions that may apply (~~,~~ see ~~GL/PCT-EPO~~ A-III, 8.4.1).

Rule 68.3

7.3 Protest fee

The protest fee is paid for the benefit of the IPEA/EP and its amount is fixed by the EPO. It is payable within one month from the date of the invitation to pay additional examination fees after a finding of lack of unity (Form PCT/IPEA/405, see ~~GL/PCT-EPO~~ C-V, 4.3). The amount payable is the amount applicable on the date of payment.

Rule 68.3(e)

7.4 Fee for the late furnishing of sequence listings

The late furnishing fee is paid for the benefit of the IPEA/EP and its amount is fixed by the EPO. It is payable within one month from the date of the invitation to furnish the nucleotide and/or amino acid sequence listing (Form PCT/IPEA/441, see ~~GL/PCT-EPO~~ C-VIII, 2.1). The amount payable is the amount applicable on the date of payment.

Rule 13ter.2
~~*OJ EPO 2023, A3*~~
OJ EPO 2024, A5
OJ EPO 2021, A96 and *OJ EPO 2021, A97*

7.5 Late payment fee

Where the IPEA/EP finds that the amount paid to it is insufficient to cover the handling fee and the international preliminary examination fee or that no fees were paid within the time limit for payment, the IPEA/EP invites the applicant to pay to it the amount required to cover those fees together with a late payment fee, within one month from the date of the invitation (Form PCT/IPEA/440).

Rule 58bis.1(a), 58bis.2
OJ EPO 1998, 282

The late payment fee is 50% of the amount of the unpaid fees as specified in the invitation or, if the resulting amount is less than the handling fee, an amount equal to the handling fee. The amount of the late payment fee may not, however, exceed double the amount of the handling fee.

If the applicant complies with the invitation within the specified time limit, payment is deemed to have been made in time (Form PCT/IPEA/440).

Rule 58bis.1(c)

If the applicant pays the fees after the time limit for payment expires but before the IPEA/EP has despatched the invitation (Form PCT/IPEA/440) to the applicant, the payment is considered to have been received in time.

Rule 58bis.1(b)

Failure to pay the missing amount and the late payment fee within the time limit set in the invitation (Form PCT/IPEA/440) will result in the demand being considered as if it had not been submitted, and the EPO will so declare (Form PCT/IPEA/407). The absence of a validly filed demand has no impact on the procedure before the EPO as designated Office because the time limit for entry into the European phase is always 31 months from the priority date.

Rule 58bis.1(d)

If the applicant pays the fees after the time limit set in the invitation expires (Form PCT/IPEA/440) but before the IPEA/EP has despatched the notification that the demand is considered not to have been submitted (Form PCT/IPEA/407), the payment is considered to have been received in time and the demand will not be considered as if it had not been submitted.

8. Reduction of fees

8.1 Reduction of the international filing fee

If one or more of the reductions mentioned below apply, the reduced amount should be indicated on the Fee Calculation Sheet which forms part of the PCT request form (PCT/RO/101).

8.1.1 Reduction for applications filed in electronic form

Point 4 PCT Schedule of Fees
OJ EPO 2018, A101

The amount of reduction of the international filing fee is set by the IB and is applicable on the date of receipt of the international application.

For international applications submitted in electronic form, three different levels of reduction apply, depending on the format in which the application is filed, namely:

8.1.1.1 ~~Web-form filing (WFF) reduction~~ Reduction for filing in PDF

This reduction applies if both the request form (PCT/RO/101) and the specification (description, claims and abstract) are filed in PDF.

8.1.1.2 ~~PDF reduction~~ Reduction for filing the request in XML

This reduction applies if the request form (PCT/RO/101) is filed in character-coded format (XML), while the specification (description, claims and abstract) is filed in PDF.

8.1.1.3 ~~XML reduction~~ Reduction for filing request and specification in XML

This reduction applies if both the request form (PCT/RO/101) and the specification (description, claims and abstract) are filed in character-coded format (XML).

8.1.2 Reductions for applicants from certain states

AG 5.188
~~Point 5 PCT Schedule of Fees~~

The international filing fee is reduced by 90% if the requirements stipulated in point 5 of the PCT Schedule of Fees are met.

For filings at the RO/EP, the reduction applies only if the applicant is a natural person who is a national of and resides in an EPC contracting state complying with the criteria under point 5(a) PCT Schedule of Fees (an updated list can be found on ~~in~~ the WIPO website ~~Euro-PCT Guide, point 2.25.010~~).

Point 5 PCT Schedule of Fees

If the application is filed with the RO/EP by more than one applicant, only one of them needs to be a national and resident of one of the EPC contracting states in question, but each applicant must fulfil the criteria mentioned under point 5 of the PCT Schedule of Fees.

The 90% reduction is calculated after deduction of the electronic filing reduction, if applicable (see ~~GL/PCT-EPO~~ A-III, 8.1.1).

8.2 Reduction of the (supplementary) international search fee

The fee for the (supplementary) international search on an international application is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is

OJ EPO 2020, A4
~~OJ EPO 2023, A67~~
OJ EPO 2024, A69
OJ EPO 2024, A8
Rule 18
PCT AG I 5.190

– a natural person who is a national and resident of a state not party to the EPC which on the date of filing of the application is classified as a low-income or lower-middle-income economy by the World Bank;

or

– a natural or legal person who is a national and resident of a state in which a validation agreement with the EPO is in force.

The list of these states can be found on the EPO website under "Reduction in international search and preliminary examination fees".

For information on the reduction of the previously paid international search fee for micro-entities under Rule 7a(3) EPC after entry into the European phase (see EPC Guidelines A-X 9.2 and EPC Guidelines A-X, 9.4).

8.2.1 Reduction of the additional search fee

If the applicant fulfils the requirements for reduction of the international search fee, any additional search fee is validly paid upon payment of the reduced amount.

8.3 Reduction of the (supplementary search) handling fee

The handling fee is reduced by 90% under the same conditions as for the international filing fee (see ~~GL/PCT-EPO~~ A-III, 8.1.2). This principle also applies to the supplementary search handling fee due under Rule 45*bis*.2.

8.4 Reduction of the preliminary examination fee

The fee for international preliminary examination is reduced by 75% under the same conditions as for the reduction of the international search fee (~~GL/PCT-EPO~~ see A-III, 8.2).

OJ EPO 2020, A4

8.4.1 Reduction of the additional preliminary examination fee

If the applicant fulfils the requirements for reduction of the preliminary examination fee, any additional preliminary examination fee is validly paid upon payment of the reduced amount.

9. Refund of fees

OJ EPO 2022, A18
~~*OJ EPO 2019, A82*~~
OJ EPO 2024, A23

Refunds are made to a deposit account held with the EPO or to a bank account. Since 1 April 2019 the EPO has no longer made refunds by cheque, and the EPO does not make refunds to credit cards. In general, the EPO will refund fees to any deposit account that the party to the proceedings before it indicates in its refund instructions. Parties are therefore also able to indicate a deposit account held by a third party. In the event of a discrepancy between the name of the deposit account holder and the account number indicated, the account number will prevail. ~~Under the fee-refund procedures applicable since 1 October 2019, up-to-date~~ Up-to-date refund instructions must be filed in an electronically processable format (XML).

If the EPO cannot make a refund to a deposit account held with it~~,~~ and the party to the proceedings is a user of MyEPO Portfolio, the refund can be claimed directly in Central Fee Payment without a refund code. If the party is not a user of MyEPO Portfolio, a refund code will be necessary to claim the refund in Central Fee Payment (a second communication containing the refund code will be issued by the EPO in this case). ~~the refund will be made to a bank account. In this case, the party will be invited to claim the refund via the EPO website.~~ When claiming a refund, the party can select whether the refund is to be made to a bank account or to a deposit account held with the EPO. For accounts within the Single Euro Payments Area (SEPA), the only details required will be the IBAN and the name of the account holder. For non-SEPA bank transfers, parties may need to provide more information depending on the country to which the refund is to be transferred. The EPO will pay the transfer fees.

If parties would like all their refunds to be made to a deposit account held with the EPO, they will have to submit separate refund instructions to that effect for all applications concerned. Refund instructions filed for an international application before the EPO as RO or as an International Authority under the PCT will apply only to refunds due in the international phase. Detailed guidance on how and when to file refund instructions is provided in OJ EPO 2024, A23 ~~OJ EPO 2019, A82~~.

Art. 13(2), (3) RFees
OJ EPO 2023, A27

Fees paid by mistake or without cause (e.g. because the EPO is not the competent RO or IPEA) will be refunded. Any amount paid in excess of the amount due is likewise refunded.

Rights for the refunding of fees paid in excess extinguish after four years from the end of the calendar year in which the right originally arose, unless a written reasoned claim is filed.

In addition, the following refunds may apply:

9.1 Refund of the international filing fee

The international filing fee is refunded where

Rule 15.4

– no ~~date of filing~~ international filing date can be accorded; or

– the application is withdrawn or considered withdrawn before its transmittal to the IB.

9.2 Refund of the (additional) international search fee

The international search fee is refunded where

Rule 16.2 and 16.3
Rule 41
~~*OJ EPO 2023, A5*~~
OJ EPO 2024, A7
OJ EPO 2009, 99
PCT AG I 5.073
Agreement EPO-WIPO, Annex D-II,
OJ EPO 2017, A115
~~*OJ EPO 2020, A68*~~
OJ EPO 2024, A29

– no ~~date of filing~~ international filing date can be accorded; or

– the international application is withdrawn or considered withdrawn before its transmittal to the ISA; or

– the international application is withdrawn or considered withdrawn before the start of the international search; or

– the EPO can base the ISR partly or entirely on an earlier search that it has performed on an application whose priority is validly claimed for the international application. The (additional) search fee paid will be refunded in part or in full depending upon the extent to which the EPO benefits from the earlier search~~. See~~ (see also ~~GL/PCT-EPO~~ B-IV, 1.1).

The EPO acting as ISA decides whether the requirements are met and, where applicable, refunds the applicable amount. No refund is made for any search other than a search carried out by the EPO on an earlier application from which the right of priority is validly claimed.

The cases referred to below are intended to illustrate the most common situations:

9.2.1 Examples of refunds

9.2.1.1 Full refund

The "full refund" level applies where the EPO can make full use of the earlier search report for drawing up the international search report.

OJ EPO 2009, 99, 2.1
~~*OJ EPO 2023, A5*~~
OJ EPO 2024, A7

This occurs, in particular, where the claims of the earlier and the later application are identical or where the claims of the later application are limited with respect to those of the earlier application, this limitation being due to

(a) the deletion of alternative features from an independent claim or

(b) the introduction of one or more limiting features into one or more of the independent claims of the later application where the limiting

feature(s) was/were all contained in a dependent claim referring back to said independent claim(s) in the earlier application.

The international search fee is refunded as follows:

– 100% for searches with a written opinion;

– 70% for searches without a written opinion.

9.2.1.2 Partial refund

OJ EPO 2009, 99, 2.2 *~~OJ EPO 2023, A5~~* *OJ EPO 2024, A7*

The "partial refund" level applies where the EPO can make partial use of the earlier search report for drawing up the international search report.

This occurs, in particular, where

(a) the claims of the later application are broader than those of the earlier application and this broadening represents a further generalisation of the same invention as that searched in the earlier application, or

(b) the claims of the later application are limited with respect to those of the earlier application, due to a limiting feature not disclosed in the earlier application but relating to the same invention as that searched in the earlier application.

The international search fee is refunded as follows:

– 25% in the case of an earlier search with written opinion;

– 17.5% in the case of an earlier search without a written opinion.

9.2.1.3 No refund

OJ EPO 2009, 99, 2.3 *~~OJ EPO 2023, A5~~* *OJ EPO 2024, A7*

No refund is due

(a) where the subject-matter claimed in the later application represents an invention different from that searched in the earlier application, or

(b) the legal requirements for a refund are not fulfilled, for example where the priority of the earlier application is not validly claimed.

9.3 Refund of additional search fees and, where applicable, the protest fee

Rule 40.2(c) and (e)

If the Review Panel finds that a protest was entirely justified, the additional search fees and the protest fee will be refunded.

If it finds that the protest was justified only in part, the corresponding additional search fees will be refunded, but not the protest fee (see ~~GL/PCT-EPO~~ B-VII, 7.2).

9.4 Refund of the supplementary search fee

The EPO as SISA will refund the supplementary search fee where, *Rule 45bis.3(e) Agreement EPO-WIPO, Annex D-II, OJ EPO 2017, A115 ~~OJ EPO 2020, A68~~ OJ EPO 2024, A29*

– before it has started the supplementary search, the supplementary search request is considered not to have been submitted; or

– before it has started the supplementary search, the international application or the supplementary search request is withdrawn.

9.5 Refund of the review fee

If the Review Panel finds that the lack of unity objection was not justified, the review fee is refunded to the applicant (see ~~GL/PCT-EPO~~ B-XII, 10.4). *Rule 45bis.6(d)(iii)*

9.6 Refund of the handling fee

Where the demand for international preliminary examination is withdrawn before it has been sent by the IPEA/EP to the IB, or where the demand is considered not to have been submitted, 100% of the handling fee is refunded. *Rule 57.4*

9.7 Refund of the preliminary examination fee

Where the international application or the demand for international preliminary examination is withdrawn before examination has commenced and within 30 months from the priority date, or where the demand is considered not to have been submitted, 100% of the fee for international preliminary examination is refunded. *Rule 58.3 and 90bis.4(a) Agreement EPO-WIPO, Annex D-II, OJ EPO 2017, A115 ~~OJ EPO 2020, A68~~ OJ EPO 2024, A29*

9.8 Refund of additional examination fees and, where applicable, the protest fee

If the Review Panel finds that a protest was entirely justified, the additional examination fees and the protest fee will be refunded. *Rule 68.3(c) and (e)*

If it finds that the protest was justified only in part, the corresponding additional examination fees will be refunded, but not the protest fee (see ~~GL/PCT-EPO~~ C-V, 5.2).

Chapter IV – Special provisions

1. PCT Direct service (see also ~~GL/PCT-EPO~~ B-IV, 1.2)

1.1 General remarks

When filing an international application claiming priority from an earlier national, European or international application already searched by the EPO (i.e. a "doublure"; see ~~GL/PCT-EPO~~ B-IV, 1.1), the applicant may submit to any receiving Office informal comments aimed at reacting to the objections raised in the search opinion established by the EPO for the priority application. At the EPO, this service is called "PCT Direct". *OJ EPO 2017, A21*

Such informal comments are to be understood as arguments regarding the patentability of the claims of the international application and also possibly as explanations regarding any modifications to the application documents, in particular to the claims, in comparison with the priority application. If the requirements under ~~GL/PCT-EPO~~ A-IV, 1.2, are met, the informal comments will be taken into account by the EPO as ISA when it establishes the international search report and written opinion for the international application.

For the processing of applications under the PCT Direct service by the EPO as ISA (~~,~~ see ~~GL/PCT-EPO~~ B-IV, 1.2).

1.2 Form of submissions

Applicants may request to have their international application processed under the PCT Direct service by filing a letter ("PCT Direct letter") containing informal comments aimed at overcoming objections raised in the search opinion established by the EPO for the priority application. The earlier application from which priority is claimed must have been searched by the EPO (international, European or national first filing, but not an international-type search).

The PCT Direct letter is to be presented as a separate document attached to the international application; it should be entitled "PCT Direct/informal comments" and clearly identify in the header the application number of the earlier application. The PCT Direct letter does not form part of the international application.

If the claims and/or the description of the international application differ from the earlier application, preferably a marked-up copy indicating the differences should be submitted. A copy of the earlier search opinion could also be annexed to the PCT Direct letter. It should be borne in mind that the letter, together with the annexed documents, will be made available to the public in accordance with the provisions on file inspection.

The PCT Direct letter, any marked-up copy of the claims and/or description, as well as the earlier search opinion, if annexed, are to be submitted as a single document in PDF (not as a ZIP file) and indicated in Box IX of the PCT request form (Form PCT/RO/101). In particular, the words "PCT Direct/informal comments" should be specified under point 11, "other", for filings on paper. When filing in electronic form using the EPO Online Filing

software, the PCT Direct letter needs to be attached as an accompanying item "Applicant letter to ISA concerning earlier search ("PCT Direct")". For filings in electronic form using Online Filing 2.0 or WIPO's ePCT portal, the PCT Direct letter and any marked-up copy of the claims and/or description are to be uploaded under the section "International Search" – "Use of earlier search and classification results" – "Availability of document(s) to the ISA" – "Other document(s) attached" – "Add other Document" by selecting Document Type "Applicant letter to ISA concerning earlier search ("PCT Direct")". Irrespective of the online filing software used, the correct document is automatically reflected in the generated XML and PDF, which show in section IX-10 the PCT Direct letter as an attachment under "Other".

Informal comments filed under PCT Direct must be self-contained. Third parties must be able to fully understand these comments as they stand. If explicit references are made to the search opinion for the first filing, that search opinion should be annexed to the international application. The reason for this requirement is that the search report, the search opinion or any other submissions that are part of the file of the earlier application may not be publicly available.

1.3 Processing by the EPO as RO

The PCT Direct letter and its annexes are transmitted to the EPO as ISA and to the IB, together with, respectively, the search copy and the record copy.

The PCT Direct letter and its annexes are made available to the public via file inspection in the European Patent Register and on WIPO's PATENTSCOPE.

For details on the procedure in the event of missing indications or missing informal comments, see GL/RO 116F and 116G.

For information on the procedure if informal comments are submitted after the filing of the international application, see GL/RO 116H.

1.4 Processing by the EPO as ISA

For the procedure followed by the EPO as ISA when assessing a PCT Direct request (~~,~~ see ~~GL/PCT-EPO~~ B-IV, 1.2.2).

2. Withdrawals

2.1 General remarks

Rule 90bis.1 to 90bis.4
PCT AG I 11.048, 11.050, 11.056 and 11.060

Applicants may withdraw their international application, one or more designations, priority claims, their request for supplementary international search, their demand or any or all elections by filing a notice of withdrawal within the prescribed time limits. Any such withdrawal is free of charge.

Rule 90bis.5
OJ EPO 2004, 305

A notice of withdrawal must be signed by the applicant or, if there are two or more applicants, by all of them. It may instead be signed, on behalf of the applicant(s), by the duly appointed agent or common representative, but not by the "deemed" common representative under Rule 90.2(b). If the

agent or the common representative has not yet been duly appointed, a power of attorney signed by all the applicants has to be submitted together with the notice of withdrawal; the requirement to submit a power of attorney to the EPO is not waived in such cases. If such a power of attorney is not filed together with the notice of withdrawal, the EPO will request the applicant(s) to submit one and the withdrawal will take effect on the date of its receipt. If no power of attorney is received before the expiration of the time limit for filing a withdrawal, the request for withdrawal will not be processed.

Moreover, the EPO will only process unqualified and unambiguous notices of withdrawal. If in doubt, the EPO will seek clarification of the applicant's or applicants' intention before any action is undertaken. *J 11/80*

2.2 Withdrawal of the international application

Applicants may address a notice of withdrawal of their international application to the IB, the RO or, where a demand has been filed, to the IPEA, and may do so at any time prior to the expiration of 30 months from the priority date. *Rule 90bis.1*

The EPO as RO or IPEA will mark the notice of withdrawal of the international application with the date on which it was received and promptly transmit it to the IB. *PCT AI sections 326 and 609*

For information on the refund of the international filing fee in the event of withdrawal of the international application, see ~~GL/PCT-EPO~~ A-III, 9.1; for information on the refund of the international search fee, see ~~GL/PCT-EPO~~ A-III, 9.2.

2.2.1 Conditional withdrawal

Applicants may request the withdrawal of their international application on condition that the international publication can be prevented ("conditional withdrawal"). In such a case, the withdrawal does not become effective if the condition cannot be met, that is, if the IB has already completed the technical preparations for the international publication. It is recommended that conditional withdrawals be submitted direct to the IB, especially if the date of completion of the technical preparations is imminent. *GL/RO 318*

2.3 Withdrawal of designations

An applicant may address a notice of withdrawal of any designations to the IB, the RO or, where a demand has been filed, the IPEA, and may do so at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of all designated states is treated as withdrawal of the international application (see ~~GL/PCT-EPO~~ A-IV, 2.2). Withdrawal of a designated state which has been elected entails withdrawal of the corresponding election (see ~~GL/PCT-EPO~~ A-IV, 2.6). If the withdrawal of a designation reaches the IB prior to completion of the technical preparations for publication, the designation in question is not published. *Rule 90bis.2*

2.4 Withdrawal of priority claims

Rule 90bis.3

An applicant may address a notice of withdrawal of one or more priority claims to the IB, the RO or, where a demand has been filed, to the IPEA, and may do so at any time prior to the expiration of 30 months from the priority date.

Rule 90bis.3
GL/RO 321

Where the priority date of the international application has changed following withdrawal of a priority claim, any time limit which is computed from the original priority date, and which has not already expired, is recomputed from the priority date resulting from that change. Time limits computed from the original priority date which have already expired are not reinstated (Rule 90*bis*.3(d)). Nevertheless, the IB may proceed with the international publication based on the original priority date if the notice of withdrawal of a priority claim reaches the IB after completion of the technical preparations for publication (Rule 90*bis*.3(e)).

PCT AI section 326

The EPO acting as RO or as IPEA will mark the notice of withdrawal with the date on which it was received and promptly transmit it to the IB.

2.5 Withdrawal of the supplementary search request

Rule 90bis.3bis
PCT AI section 520

Applicants may withdraw their request for supplementary international search by addressing a notice of withdrawal to either the IB or the authority specified for the supplementary search, and may do so at any time before transmittal by the SISA of the supplementary international search report or of the declaration that no such report will be established. The EPO as SISA will mark the notice of withdrawal with the date on which it was received and promptly transmit it to the IB. For information on the refund of the supplementary international search fee by the EPO as SISA (~~,~~ see ~~GL/PCT-EPO~~ A-III, 9.4).

2.6 Withdrawal of the demand or of elections

Rule 90bis.4

Applicants may withdraw their demand or any or all elections by addressing a notice of withdrawal to the IB, and may do so at any time prior to the expiration of 30 months from the priority date. The withdrawal takes effect on the date of receipt of the notice by the IB, the IPEA being notified of that date. If the applicant nevertheless submits the notice of withdrawal to the IPEA, the IPEA will mark the date of receipt on the notice and transmit it promptly to the IB. The notice is considered to have been submitted to the IB on the date marked by the IPEA.

Rule 90bis.6(c)

Where the demand or all elections are withdrawn, the IPEA is notified of the withdrawal by the IB and the processing of the international application by the IPEA is discontinued.

GL/ISPE 22.20

The demand or the copy thereof must be transmitted to the IB even where it has been withdrawn by the applicant. For information on the refund of the handling fee, see ~~GL/PCT-EPO~~ A-III, 9.6; for information on the refund of the preliminary examination fee in the event of withdrawal of the demand, see ~~GL/PCT-EPO~~ A-III, 9.7.

3. Applications disclosing nucleotide and/or amino acid sequences

If the international application discloses one or more nucleotide and/or amino acid sequences, it must contain a sequence listing drawn up in compliance with WIPO Standard ST.26 (the XML-based standard applicable for international applications filed on or after 1 July 2022). For international applications filed before 1 July 2022, the applicable standard before the EPO is WIPO Standard ST.25. Details of the practice which applies for applications filed on or after 1 July 2022 are provided in the decision of the President of the EPO dated 9 December 2021 on the filing of sequence listings and the explanatory notice from the EPO (see OJ EPO 2021, A96 and A97), as well as in the notice from the EPO dated 27 May 2022 concerning the filing of sequence listings in the international (PCT) procedure before the EPO as receiving Office (OJ EPO 2022, A60). Under WIPO Standard ST.26, a standard-compliant sequence listing must be filed for all sequence information meeting the length thresholds defined in WIPO Standard ST.26, paragraphs 7 and 8. The following paragraphs describe the practice applicable for international applications filed on or after 1 July 2022.

Rules 5.2, 13ter.1
OJ EPO 2024, A54, A55
OJ EPO 2022, A60
OJ EPO 2021, A96, A97
PCT/AI Sect. 101, 207, 208, 707(a) and (a-bis) and Annex C
WIPO PCT Guide 5.099-5.104, 11.088
PCT Newsletter 10/2021, 2, 02/2022, 11, 05/2022, 1

Any sequence listing not contained in the international application as filed will, if not allowable as an amendment under Article 34 PCT, not form part of the international application.

If an international application is filed in electronic form, a sequence listing forming part of such application and filed in XML format in compliance with WIPO Standard ST.26 is not taken into account for calculating the (page fee part of the) international filing fee (see A-III, 4.2). There will be no need to file a second copy for the purposes of international search and, where applicable, international preliminary examination.

PCT/AI Sect. 707 (a-bis)

If any other option for filing a sequence listing is chosen, the sum of the page fee part of the international filing fee is calculated, taking into account each page of the sequence listing (see A-III, 4.2). Furthermore, if the EPO is selected as ISA, SISA and/or IPEA, a sequence listing in electronic form in text format in compliance with Annex C to the PCT Administrative Instructions will be required (see B-VIII, 3.2 and EPC Guidelines E-IX, 2.4.2).

Rule 13ter.1
OJ EPO 2021, A96, A97

WIPO has developed a tool called "WIPO Sequence" to assist applicants in preparing sequence listings compliant with WIPO Standard ST.26. Applicants are strongly advised to ensure they have downloaded the latest version of the software and also to sign up on the WIPO website for the WIPO Sequence newsletter in order to receive important announcements and information on software updates and related issues.

Where the EPO as receiving Office finds that a separate electronic file disclosing sequences appears to be in a format other than WIPO Standard ST.26 XML format, it will not consider that file to be part of the international application. Instead, it will convert the file into the format of the main part of the description and invite the applicant to confirm whether the content of that converted file is intended to form part of the description and to pay any corresponding page fee (Form PCT/RO/132) within one month of the date

OJ EPO 2022, A60
PCT/AI Annex C, para. 26

of the invitation. Any payment received by the EPO as receiving Office within this time limit will be considered as confirmation that the content of the converted file is to be part of the international application.

OJ EPO 2022, A60

The content of the converted file will not be considered part of the international application if so confirmed by the applicant or if the applicant does not pay the applicable fees within one month of the date of the invitation. It will then not be part of the priority document prepared by the EPO as receiving Office pursuant to Rule 17.1(b) PCT.

Chapter V – Drawings

This chapter summarises the requirements for drawings in international applications.

An international application must contain drawings where they are necessary to understand the invention. Where they are not, but the nature of the invention admits of illustration by drawings, they are optional.

Art. 3(2), 7
PCT AG I 5.128

1. Graphic forms of presentation considered to be drawings

1.1 Technical drawings

Perspectives, exploded views, sections and cross-sections and details on a different scale are all considered to be drawings. So too are flow sheets and diagrams, such as functional diagrams and graphic representations of a given phenomenon which express the relationship between two or more parameters.

Rule 7.1
PCT AG I 5.129

Where tables or chemical or mathematical formulae are included in the description, claims or abstract, they are not considered to be drawings and are thus not subject to the requirements for drawings. However, such graphic forms may be submitted as drawings, in which case they are.

Rule 11.10
PCT AG I 5.130-5.133

Where such graphic forms of presentation are not submitted as drawings (~~,~~ see ~~GL/PCT-EPO~~ A-V, 11).

1.2 Photographs or coloured drawings

The PCT makes no express provision for photographs or coloured drawings and, furthermore, according to Rule 11.13, drawings must be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes without colourings. Photographs and coloured drawings may, however, exceptionally be submitted where it is impossible to present in a black-and-white drawing what is to be shown. If colours are necessary to discern details, note that these details may be lost when the image is made available in black and white in the publication and via file inspection.

PCT AG I 5.159
GL/RO 146

For further details see ~~GL/EPO~~ EPC Guidelines A-IX, 1.2.

2. Presentation of drawings

2.1 Grouping of drawings

Drawings must be presented on one or more separate sheets. All the figures constituting the drawings must be grouped together on a sheet or sheets without waste of space, but clearly separated from each other. Figures should not be separated by lines. The request, the description, the claims and the abstract must not contain drawings.

Rule 11.10(a), 11.13(j)
PCT AG I 5.131-5.134

2.2 Reproducibility of drawings

Drawings must be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset and microfilming, in any number of copies.

Rule 11.2(a)
PCT AG I 5.132

2.3 Figure accompanying the abstract

Rule 3.3(a)(iii)
PCT AG I 5.163, 5.170 and 5.171
GL/RO 151

Where the international application contains drawings, the applicant must indicate, in the check list on the request form (Form PCT/RO/101), the number of the figure in the drawings which they suggest be published with the abstract.

The figure published with the abstract must be the one which best characterises the claimed invention and must be chosen from the drawings accompanying the international application. Generally, only one figure should be indicated. The abstract may exceptionally be illustrated by more than one figure where necessary information cannot be otherwise conveyed. A figure containing significant amounts of text should be avoided.

3. Requirements regarding the paper used

Rule 11.2(b), 11.2(c), 11.3, 11.5 and 11.12
PCT AG I 5.133

If the international application is filed on paper, drawings must be on sheets of A4 paper (29.7 cm x 21 cm), which must be flexible, strong, white, smooth, non-shiny and durable. The sheets must be free from creases and cracks; they must not be folded. Only one side of each sheet may be used.

Under Rule 11.12, each sheet must be reasonably free from erasures and must be free from alterations, overwriting and interlineations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

4. Presentation of the sheets of drawings

4.1 Usable surface area of sheets

Rule 11.6(c)
PCT AG I 5.133

On sheets containing drawings, the surface usable must not exceed 26.2 cm x 17.0 cm. The sheets must not contain frames around the usable or used surface. The minimum margins are as follows: top: 2.5 cm; left side: 2.5 cm; right side: 1.5 cm; bottom: 1 cm.

4.2 Numbering of sheets of drawings

Rule 11.7
AI 207(b)
PCT AG I 5.012, 5.140 and 5.141

All the sheets of the international application must be numbered in consecutive Arabic numerals. All sheets of drawings must be numbered in the centre of either the top or the bottom of the sheet but not in the margin, in numbers larger than those used as reference signs.

Sheets of drawings must be numbered as a separate series commencing with the first; the number of each sheet must consist of two Arabic numerals separated by an oblique stroke, the first being the sheet number and the second being the total number of sheets of drawings (for example: 1/3, 2/3, 3/3).

5. General layout of drawings

If various figures are presented on the same sheet of drawings, they must be laid out according to the requirements for page-setting and numbering, and figures divided into several parts must comply with the requirements described in the subsections below.

5.1 Page-setting

The figures must be arranged on a sheet or sheets without wasting space, preferably in an upright position and clearly separated from one another. Where a figure cannot be presented satisfactorily in an upright position, it may be placed sideways with the top of the figure at the left side of the sheet. Thus, a figure which is broader than it is high may be set out so that the bottom of the figure lies parallel to and along the right-hand side of the sheet. In this case, if other figures are drawn on the same sheet, they should be set out in the same way, so that all the figures on a single sheet lie in the same position.

Rule 11.13(j)
PCT AG I 5.135

5.2 Numbering of figures

The figures on the sheets of drawings must be numbered in Arabic numerals, consecutively, independently of the numbering of the sheets and, if possible, in the order in which they appear. The numbers of the figures should be preceded by "Fig.", irrespective of the language of the international application. Where a single figure is sufficient to illustrate the claimed invention, it should not be numbered and "Fig." should not appear. Numbers and letters identifying the figures must be simple and clear and may not be used in association with brackets, circles or inverted commas, except in the case of partial figures intended to form one complete figure, irrespective of whether they appear on one or several sheets. In this case the complete figure may be identified by the same number followed by a capital letter (for example: Fig. 7B).

Rule 11.13(k) and 49.5(f)
AI 207(b)
PCT AG I 5.141 and 5.142

The figures should preferably be set out, as far as possible, on each sheet in ascending numerical order from left to right and from top to bottom. If one of two figures illustrates on a larger scale a detail from the other, each figure should be numbered separately and, if possible, consecutively.

5.3 Whole figure

One sheet of drawings may contain several figures. Where figures on two or more sheets form in effect a single complete figure, the figures on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the figures appearing on the various sheets.

Rule 11.13(i)
PCT AG I 5.139

Partial figures drawn on separate sheets must always be capable of being linked edge to edge, that is to say, no partial figure may contain parts of another partial figure. A very long figure may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous. It is therefore recommended that a smaller scale figure be included showing the whole formed by the partial figures and indicating the positions of the parts shown.

6. Prohibited matter

As set out in Rule 9.1(i) and (ii), the international application must not contain drawings contrary to morality or public order. If it does, the applicant may be invited to voluntarily correct it (Rule 9.2).

GL/RO 333
PCT AG I 5.175

7. Execution of drawings

7.1 Drawings of lines and strokes

Rule 11.13(a) and 11.13(f)
PCT AG I 5.143 and 5.144

The drawings must be executed in durable, black, uniformly thick and well-defined lines and strokes. See ~~CL/PCT-EPO~~ A-V, 1.2, in respect of colour drawings, where these are exceptionally submitted. In all cases, the thickness of the lines and strokes must take into account the scale, nature, execution and perfect legibility of the drawing and of the reproductions. All lines in the drawings must, ordinarily, be drawn with the aid of a drafting instrument, except for those which by their nature do not permit the use of such instruments, for example irregular diagrams, ornamental structures and curved reference lines.

7.2 Shading

PCT AG I 5.158

The use of shading in figures is allowed provided this assists in understanding them and is not so extensive as to impede legibility. Shading may, for instance, be used to indicate the shape of spherical, cylindrical or conical elements. Flat parts may also be lightly shaded. Such shading is allowed in the case of parts shown in perspective but not for cross-sections. Only spaced lines may be used for shading, not fully blacked out areas. These lines must be thin and as few in number as possible and contrast with the rest of the drawings.

7.3 Cross-sections

7.3.1 Sectional figures

PCT AG I 5.148

Where a figure is a cross-section of another figure, the latter should indicate the position of the section and may indicate the viewing direction by arrows at each end. In addition, in order to allow each sectional figure to be quickly identified, especially where several cross-sections are made of the same figure, each end of the cross-section line should be marked on the diagram with the same single Arabic or Roman numeral which identifies the figure in which the section is illustrated.

7.3.2 Hatching

Rule 11.13(b)
PCT AG I 5.149

A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced parallel oblique strokes, the space between the strokes being chosen on the basis of the total area to be hatched. Hatching should not impede the clear reading of the reference signs and reference lines. Consequently, if it is not possible to place reference signs outside the hatched area, the hatching may be broken off wherever reference signs are inserted. Certain types of hatching may be given a specific meaning. The hatching should be at a substantial angle to the surrounding axes or principal lines, preferably 45º. The various parts of a cross-section of the same item should be hatched in the same manner. The hatching of juxtaposed different elements should be angled in a different way. In the case of large areas, hatching can be confined to an edging drawn around the inside of the outline of the area to be hatched.

7.4 Scale of drawings

The scale of the drawings and the distinctness of their graphical execution must be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. In exceptional cases, where required, the scale of the drawing may be graphically represented.

Rule 11.13(c)
PCT AG I 5.150

7.5 Numbers, letters and reference signs

Numbers, letters, reference signs and any other data given on the sheets of drawings, such as the numbering of figures and of the sheets, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs indicating minutes, seconds or degrees are permitted. Numbers, letters and reference signs should be laid out in the same direction as the diagram so as to avoid having to rotate the sheet. They should not be placed in the closed and complex parts of the drawings so as to interfere with a thorough comprehension of the drawings, and therefore should rarely cross or mingle with the lines. As a general rule, numbers, letters and reference signs should be placed as close as possible to the part in question.

Rule 11.13(e)
PCT AG I 5.152

7.5.1 Leading lines

Reference lines (also referred to as leading lines), that is, lines between the reference signs (for example, reference numerals) and the details referred to, may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference sign and extend to the feature indicated. Reference lines for certain reference signs may be omitted. Reference signs of this type, which are not connected to anything, will then indicate the surface or cross-section on which they are placed. In such cases the reference sign may be underlined to make it clear that the line has not been left out by mistake. Reference lines must be executed in the same way as other lines in the drawing.

PCT AG I 5.145

7.5.2 Arrows

Arrows may be used at the end of the reference lines provided that their meaning is clear.

PCT AG I 5.146

– A free-standing arrow indicates the entire section towards which it points.

– An arrow touching a line indicates the surface shown by the line looking along the direction of the arrow.

– Arrows may also be used in appropriate cases to show the direction of movement.

7.5.3 Height of the numbers and letters in the drawings

The height of the numbers and letters must not be less than 0.32 cm. For the lettering of drawings, the Latin or, where customary, the Greek alphabet must be used.

Rule 11.13(h)
PCT AG I 5.153

7.5.4 Consistent use of reference signs in the description, claims and drawings

Rule 11.13(l), (n)
PCT AG I 5.154

Reference signs must be used in a manner which is consistent in the description, claims and drawings. In particular, reference signs not mentioned in the description must not appear in the drawings, and vice versa.

Rule 11.13(m)
PCT AG I 5.155

A feature denoted by a reference sign must be denoted by the same sign throughout the international application.

In the case of international applications dealing with complex subjects and incorporating a large number of drawings, a separate sheet listing all the reference signs should be included at the end of the description as a part of it.

7.5.5 Consistent use of reference signs in the drawings

Rule 11.13(m)
PCT AG I 5.155

A feature denoted by a reference sign must be denoted by the same sign throughout the international application.

7.6 Variations in proportions

Rule 11.13(g)

Each element of each figure must be in proper proportion to each of the other elements in the figure, except where the use of a different proportion is indispensable for the clarity of the figure.

8. Text matter in drawings

Rule 11.11
Rule 11.9
PCT AG I 5.156

The drawings must not contain text matter, except a single word or words when absolutely indispensable, such as "water", "steam", "open", "closed", "section on AB" and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords indispensable for understanding. Any words used must be so placed that, if translated, they may be pasted over without interfering with any lines of the drawings.

Any text matter which is indispensable must comply with the requirements for the writing of text matter.

For indications of the type "section on AB", see ~~GL/PCT-EPO~~ A-V, 7.3.1.

Art. 3(4)(i)
GL/RO 55, 57, 62 and 63

Where any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office will invite the applicant to furnish a translation of the text matter of the drawings into the language in which the international application is to be published (Rule 26.3*ter*). The receiving Office decides whether the correction was submitted within the two-month time limit under Rule 26.2 and, if so, whether the international application so corrected is or is not to be considered withdrawn. However, no international application may be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with them to the extent necessary for the purpose of reasonably uniform international publication (Rule 26.5).

9. Conventional symbols

Rule 10.1(d) and (e)
PCT AG I 5.157

Known devices may be illustrated by symbols which have a universally recognised conventional meaning and are generally accepted in the art

provided no further detail is essential for understanding the subject-matter of the claimed invention. Other signs and symbols may be used provided that they are not likely to be confused with existing conventional symbols, that they are readily identifiable (i.e. simple) and that they are clearly explained in the text of the description. Different types of hatching may also have different conventional meanings as regards the nature of a material seen in cross-section.

10. Amendments to drawings

The drawings can be amended during the international phase only if the applicant files a demand for international preliminary examination (see ~~See GL/PCT-EPO~~ H-I, 3). *Art. 34(2)(b)* *PCT AG I 5.162*

For the rectification of obvious mistakes, see ~~GL/PCT-EPO~~ B-III, 2.3.2, and H-I, 2. For the addition of an entire sheet of drawings omitted on the ~~date of~~ filing date, see ~~GL/PCT-EPO~~ A-II, 5. *Rule 91* *PCT AG I 5.161*

If the drawings submitted on the ~~date of~~ filing date do not comply with the requirements in Rule 11 to the extent necessary for the purpose of reasonably uniform international publication, the EPO as receiving Office will invite the applicant to submit a correction within two months of the invitation (Form PCT/RO/106). If the EPO as receiving Office finds that the defects have not been corrected or have not been corrected on time, it will declare the international application withdrawn (Form PCT/RO/117). An international application may not be considered withdrawn for lack of compliance with the physical requirements in Rule 11 if it complies with them to the extent necessary for the purpose of reasonably uniform international publication. *Rule 26* *GL/RO 153-159*

11. Graphic forms of presentation not considered to be drawings

Where tables or chemical or mathematical formulae are included in the description, claims or abstract, they are not considered to be drawings and are thus not subject to the requirements for drawings. *PCT AG I 5.130*

11.1 Chemical and mathematical formulae

The description, the claims and the abstract may contain chemical or mathematical formulae. Such formulae may be written by hand or drawn if necessary but it is recommended that appropriate drafting aids or materials, such as stencils or transfers, be used. For practical reasons formulae may be grouped together on one or more sheets in the description and paginated with it. In such cases, it is recommended that each formula be designated by a reference sign and that the description contain references to the formulae whenever necessary. *Rule 11.9(b), 11.10(b)* *PCT AG I 5.107*

Chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Numerals, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the element of the international application in which they appear. Chemical or mathematical formulae appearing in the text of the international application must have symbols, the capital letters of which are at least 0.28 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm *Rule 11.9(d)* *PCT AG I 5.108*

high. All mathematical symbols used in a formula which appear in the description or on sheets of drawings should be explained in the description, unless their significance is clear from the context. In any case, the mathematical symbols used may be collated in a list.

11.2 Tables

11.2.1 Tables in the description

Rule 11.10(c), 11.10(d)
PCT AG I 5.109

The description may contain tables. For the sake of convenience, tables may be grouped together on one or more sheets of the description and paginated with it. If two or more tables are necessary, each should be identified by a Roman numeral (independently of the pagination of the description or drawings or of the figure numbering), by a capital letter, by a title indicating its content or by some other means. Each line and column in a table should begin with an entry explaining what it represents and, if necessary, the units used. As far as possible, all tables should be set out upright on the sheets. Where the tables cannot be presented satisfactorily in an upright position, they may be placed sideways, with the top of the tables on the left-hand side of the sheet.

11.2.2 Tables in the claims

Rule 11.10(c)
PCT AG I 5.125

The claims may include tables if this is desirable in view of the subject-matter involved. In such cases, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in the description.

Chapter VI – Examination of formal requirements

1. Claim to priority

This section is intended to summarise all formal requirements relating to priority claims in international applications. In the present edition, it focuses on formal requirements under Rule 4.10, defects in priority claims and corrections upon invitation as well as restoration of the priority right. It also provides additional information on the applicant's entitlement to claim priority under Article 87 EPC in the European phase before the EPO. Further relevant aspects will gradually be added in successive editions. For further information see ~~GL/PCT-EPO~~ F-VI.

1.1 Formal requirements under Rule 4.10

Art. 2(i)
Art. 8(1)
Rule 4.10
PCT AG I 5.057 ff.
GL/RO 166 ff.
GL/ISPE 6.03

In an international application, the applicant may claim the priority of one or more earlier applications. The claim needs to be made in the PCT request form (PCT/RO/101) and fulfil the following requirements:

(a) The earlier application must have been filed in or for a country which is party to the Paris Convention for the Protection of Industrial Property ("Paris Convention") or in or for any member of the World Trade Organization that is not party to the Paris Convention.

(b) The priority claim must indicate:

(i) the date on which the earlier application was filed;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country in which it was filed;

(iv) where the earlier application is a regional application, the authority with which the earlier application was filed and that is entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

(c) Where the earlier application is a regional application or an international application, the applicant may, if desired, also indicate one or more countries party to the Paris Convention for which that earlier application was filed, even if this is not required by Rule 4.10(b)(ii). An indication of at least one country party to the Paris Convention or one member of the World Trade Organization for which the earlier application was filed is mandatory where the earlier application is a regional application filed with ARIPO.

Art. 2(i)
Art. 8(1)
Rule 4.10
GL/ISPE 6.03

The words "in or for" any country or member mean that the earlier application the priority of which is claimed may be an earlier national, regional or international application. The earlier application may be for a patent or for the registration of a utility model or for an inventor's certificate.

1.2 Priority period

Art. 8(2)(a)
Rule 2.4
Rule 26bis.1(a)
Rule 26bis.2
Rule 26bis.2(c)(iii)
Art. 4C Paris Convention
Rule 80.5
Rule 82
Rule 82quater
GL/RO 171

The date on which the earlier application was filed must fall within the priority period of 12 months preceding the international filing date. However, if the international filing date lies after, but within two months of, that period's expiry, a priority claim will not be considered void for the purposes of the international phase of the PCT procedure, irrespective of whether restoration of the right of priority is requested (see ~~GL/PCT-EPO~~ A-VI, 1.5).

The priority period starts on the day following the date of filing of the earlier application. The RO/EP will thus not accept a priority claim relating to an application having the same date of filing as the international application and will inform the applicant that the claim will be disregarded unless the priority date can be corrected (PCT/RO/110; see ~~GL/PCT-EPO~~ A-VI, 1.4.1).

If the last day of the priority period falls on a day on which the EPO is not open for the receipt of documents or on which no mail is delivered due to an official holiday or other circumstance described in Rule 80.5, it expires on the next subsequent day on which none of these circumstances exists. However, the priority period may not be extended under Rule 82 or Rule 82*quater* in the event of irregularities in the mail service.

1.3 Inconsistency in the priority claim

Rule 26bis.2(c)(ii)
GL/RO 171

Any indication in the priority claim must be consistent with the corresponding indication appearing in the priority document. However, if an indication in the priority claim is inconsistent with the corresponding indication in the priority document, the claim is not considered void for the purposes of the international phase of the PCT procedure. Instead, in such cases the RO draws applicants' attention to the inconsistency and invites them to correct the priority claim accordingly (PCT/RO/110; see ~~GL/PCT-EPO~~ A-VI, 1.4.1).

1.4 Defects in the priority claim

Rule 4.10
Rule 26bis.1(a)
Rule 26bis.2
GL/RO 167 ff.
PCT AG I 6.038-6.042

Where the RO finds that

– a priority claim does not comply with the requirements of Rule 4.10 (see ~~GL/PCT-EPO~~ A-VI, 1.1), or that

– the filing date indicated for the earlier application does not fall within the period of 12 months preceding the international filing date (see ~~GL/PCT-EPO~~ A-VI, 1.2, and ~~GL/PCT-EPO~~ A-VI, 1.4.2), or that

– any indication in a priority claim is inconsistent with the corresponding indication appearing in the priority document (see ~~GL/PCT-EPO~~ A-VI, 1.3, and ~~GL/PCT-EPO~~ A-VI, 1.4.2),

the RO, using Form PCT/RO/110,

(i) invites the applicant to correct the priority claim (PCT/RO/110, Annex A), and/or

(ii) if the filing date of the international application lies within two months of expiry of the priority period, draws the applicant's attention to the possibility of requesting restoration of the right of priority (PCT/RO/110, Annex B).

1.4.1 Correction of the priority claim upon invitation

The RO will invite the applicant to correct defects in a priority claim (indicated in Annex A of Form PCT/RO/110) within a time limit of 16 months from the priority date or, where the correction would cause a change in the priority date, 16 months from the priority date as so changed, whichever expires first, provided that a notice of correction may, in any event, be submitted until the expiry of four months from the international filing date.

Rule 26bis.1(a)
Rule 26bis.2(a)
AI 314(a)
GL/RO 169
GL/RO 170

Upon receipt of a response to the invitation to correct defects in a priority claim, the RO checks whether the indications furnished by the applicant have been received within the applicable time limit and whether they comply with the formal requirements of Rule 4.10 (see ~~GL/PCT-EPO~~ A-VI, 1.1). If so, the RO follows the procedure laid down in GL/RO 170.

The RO notifies the applicant accordingly, using Form PCT/RO/111, and sends to the IB and the ISA, respectively, a copy of that notification as well as a copy of the corresponding sheet of the PCT request containing the corrections.

If the notice correcting the priority claim is received before the RO declares the priority claim void (see ~~GL/PCT-EPO~~ A-VI, 1.4.2) and not later than one month after the expiry of the time limit, the response is considered to have been received before the expiry of the applicable time limit.

Rule 26bis.2(b), last sentence

1.4.2 Failure to correct

If, in response to the invitation to correct a priority claim, the applicant does not submit a notice correcting the priority claim before expiry of the applicable time limit (see ~~GL/PCT-EPO~~ A-VI, 1.4.1), that priority claim is, for the purposes of the PCT procedure, considered void and the RO so declares using Form PCT/RO/111. In addition to marking the PCT request in accordance with GL/RO 172, the RO also sends to the IB and the ISA, respectively, a copy of that declaration and a copy of the corresponding sheet of the request containing the marking.

Rule 26bis.1(a)
Rule 26bis.2(b)
AI 302
GL/RO 169
GL/RO 171
GL/RO 172
PCT AG I 6.043

1.5 Restoration of the right of priority

Rule 26bis.3
GL/RO 166C
GL/RO 166D
GL/RO 166E
GL/RO 166G
PCT AG I 5.064-5.069
Art. 2(1) item 13
RFees

Where the international application has an international filing date which is later than, but within two months of, the date on which the priority period expired, the applicant may request restoration of the right of priority with the RO. This request may be made directly on the request form (Box No. VI) or separately (either upon receipt of the information from the RO using Form PCT/RO/110, Annex B (see ~~GL/PCT-EPO~~ A-VI, 1.4(ii)) or on the applicant's own initiative).

A request for restoration of the right of priority is admissible if:

(a) the international filing date of the application is within the two-month period following the expiry of the priority period; where a priority claim in respect of the earlier application is not contained in the international application, the priority claim must be added (Rule 26*bis*.1(a)) within the same time limit;

(b) the request is submitted within the two-month period following the expiry of the priority period and is supplemented by a statement of reasons;

(c) the fee for requesting restoration of the right of priority (see also ~~GL/PCT-EPO~~ A-III, 4.6) is paid within two months of the date on which the priority period expired; this time limit may not be extended before the EPO as RO.

Where the applicant makes a request for early publication under Art. 21(2)(b), the request for restoration and the statement of reasons or evidence (Rule 26*bis*.3(b)(iii)), or any notice under Rule 26*bis*.1(a) adding the priority claim, must be filed, and the pertinent fee be paid (Rule 26*bis*.3(d); ~~GL/PCT-EPO~~ A-III, 4.6), before the technical preparations for international publication have been completed (Rule 26*bis*.3(e)).

Rule 26bis.3(a)(i)
OJ EPO 2007, 692
GL/RO 166F,
~~GL/RO~~ 166J -166M

The EPO as RO grants a request for restoration of the right of priority only if the due care required by the circumstances has been taken ("due care" requirement). To satisfy this requirement, the applicant must show to the RO's satisfaction that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken. The standard of having exercised "due care" can only be met if the applicant has taken all measures which a reasonably prudent applicant would have taken. The statement of reasons accompanying the request should describe in detail the facts and circumstances that have led to the late filing as well as any remedial or alternative steps taken to attempt on-time filing of the international application. Due care is considered to have been taken if non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system.

The practice of the EPO as RO defines exceptional circumstances as ones that are unrelated to ordinary working procedures and arise either unexpectedly, as for example a sudden serious illness, or owing to some kind of upheaval, such as an internal reorganisation entailing a move.

Whether exceptional circumstances occurred depends on the facts of the case, and the standard to be met for this is very strict. In particular, events of force majeure may be regarded as exceptional circumstances. An event of force majeure means an external, unforeseeable and/or unavoidable circumstance beyond the control of the applicant or agent. Disasters, such as hurricanes, volcanic eruptions, earthquakes, international conflicts and war, may be considered such events. Due care is generally regarded as having been taken if it is demonstrated that the consequences of the event could not have been predicted and/or avoided.

The assessment of whether the failure to file the international application within the priority period resulted from an isolated mistake within a normally satisfactory monitoring system depends, among other things, on the size of the company of the applicant or agent. The same standard of care as is required of the patent department of a large firm cannot be expected of an individual or a small applicant. In addition, a different standard of due care is required depending on whether the mistake can be ascribed to an applicant, an agent in charge or an assistant.

The EPO as RO considers the facts and circumstances of each particular case, applying the principles summarised in GL/RO 166J-166M. The case law established by the EPO boards of appeal (developed with respect to the re-establishment of rights under Art. 122 EPC) is also taken into consideration when assessing whether due care has been exercised in the respective case~~. See~~ (see also ~~GL/EPO~~ EPC Guidelines, E-VIII, 3.2).

If the RO intends to refuse the request for restoration of the right of priority, as it finds that the statement of reasons is insufficient to determine whether the applicant has satisfied the due care criteria or that the due care criteria appear not to have been met, it invites the applicant to submit further evidence and/or observations on the intended refusal within a two-month time limit (Form PCT/RO/158). The RO explains in detail, in the Annex to Form PCT/RO/158, why it intends to refuse the request. After expiry of the two-month time limit, and taking into account the information available to it at this stage, the RO issues a decision to either restore the right of priority or refuse the request for restoration of the right of priority (Form PCT/RO/159).

Rule 26bis.3(f), (g)
GL/RO 166R,
GL/RO 166S

The RO transmits a copy of all related documents received from the applicant to the IB (including a copy of the restoration request, the statement of reasons and any declaration or other evidence), except if it decides, either upon a reasoned request by the applicant or on its own motion, that (parts of) certain documents are not to be transmitted. In the latter case, the RO notifies the IB accordingly. If the RO receives a reasoned request from the applicant not to transmit (a part of) a document to the IB, but nevertheless decides to transmit that (part of a) document to the IB, it also notifies the applicant of this decision (relevant box in Form PCT/RO/159).

Rule 26bis.3(h-bis)
AI 315
GL/RO 166N
GL/RO 166S
GL/RO 166T

The RO takes the decision not to transmit documents to the IB if it finds that a document or part thereof meets the requirements of Rule 26*bis*.3(h-*bis*), namely that:

(i) a document or part thereof does not obviously serve the purpose of informing the public about the international application;

(ii) publication or public access to any such document or part thereof would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that document or part thereof.

A document or part thereof does not "obviously serve the purpose of informing the public about the international application" if it is clearly irrelevant for the disclosure or assessment of the international application as such. Making a document or a part thereof available to the public would "clearly prejudice the personal or economic interests of a person" if it would be harmful to that person's specific and concrete personal or economic interests. A merely abstract prejudice to hypothetical personal or economic interests is generally not sufficient.

Rule 49ter.1
PCT AG I 5.069

A decision by the EPO as RO to restore the right of priority will be effective before the EPO as designated Office and, as a general rule, in all designated Offices, unless the respective designated Office has submitted a notification of incompatibility under Rule 49*ter*.1(g).

Rule 26bis.2(c)(iii)
WIPO PCT Guide 5.062

A decision by the RO on a request for restoration of the right of priority is not required for the international search if the application was filed within two months of the date on which the priority period expired because in that case the priority claim may not be considered void during the international phase. Where the priority claim in question is the only or the earliest one in the international application, it continues to serve as the basis for the calculation of all time limits during the international phase, including the time limits for entry into the national phases, i.e. also into the European phase.

Rule 49ter.1
Rule 49ter.2

If no request for restoration of the right of priority has been filed by the applicant in the procedure before the EPO as RO or if the request for restoration has been rejected by the EPO as RO, the applicant may file a (new) request in the national phase, i.e. in the procedures before the EPO as designated Office and any other designated Office that has not made a reservation as to the applicability of Rule 49*ter*.1 and Rule 49*ter*.2. For the procedure before the EPO as designated Office (~~,~~ see ~~GL/EPO~~ EPC Guidelines E-VIII, 3).

1.6 Applicant's entitlement to claim priority

The applicant claiming the priority of an earlier application must be the applicant of the latter or the successor in title of the priority right. The question of whether the applicant is actually entitled to claim the priority of an earlier application is not examined during the international phase.

Art. 8(2)(a)
Art. 4A(1) Paris Convention
PCT AG National Phase – National Chapter – EP.29

~~In proceedings before the EPO as designated or elected Office, the transfer of the priority right must be assessed under the EPC, regardless of any national laws. The EPC does not set out any formal requirements for the transfer of the priority right (see G 1/22 and G 2/22).~~ For details on the procedure before the EPO as designated or elected Office (~~,~~ see ~~GL/EPO~~ EPC Guidelines A-III, 6.1).

1.7 Provision of the priority document

Where the applicant claims the priority of an earlier application, a certified copy of that earlier application ("the priority document") must be filed with the receiving Office or the International Bureau (IB) within 16 months of the priority date. However, if the earlier application was filed with the receiving Office, the applicant may request that the receiving Office transmit a certified copy of the earlier application to the IB. A checkbox is provided for that purpose in Box No. VI of the PCT request form.

Rule 17.1(a) and (b)
WIPO PCT Guide 5.070
PCT Newsletter 03/2022, 8

If the EPO as receiving Office is requested to prepare and transmit a certified copy of an earlier application to the IB, a fee is due (see A-III, 4.4). However, no fee is due if the IB is requested to retrieve a priority document via the Digital Access Service (DAS) and it is available there. If no request via DAS is present, the EPO as receiving Office does not include, free of charge, a copy of an earlier application in the file of an international application – even if that earlier application was a European application or an international application filed with the EPO as receiving Office.

Rule 17.1(b) and (b-bis)
Art. 3(1) RFees
OJ EPO 2019, A27
OJ EPO 2021, A43
OJ EPO 2023, A48

Where the earlier application was filed as a national application with a national office that participates in the DAS, the IB may be requested to obtain a certified copy of the earlier application from DAS. For that purpose, a checkbox and a text field for the required access code are provided in Box No. VI of the PCT request form. Similarly, where the earlier application was a European patent application filed on or after 1 November 2018, the IB can be asked to obtain a certified copy via DAS (that was the date on which the EPO started to participate in DAS for Euro-direct filings). Since 1 April 2019, it has also been possible to request retrieval of a certified copy via DAS where the international application claims priority from a previous international application filed with the EPO as receiving Office.

During the international phase before the EPO as receiving Office, electronic priority documents can be submitted, together with the PCT/RO/101, to the EPO or subsequently to the IB using ePCT. For further information on how to file the priority document see A-II, 1.3.

1.8 Certified copies of international applications

Where the applicant needs a certified copy of an international application which was filed with the EPO as receiving Office, a request may be filed

Rule 21.2
OJ EPO 2024, A5

with the EPO together with, where applicable, the payment of the relevant fee (see GL, A-III, 4.4.2). The certified copy will be issued on paper.

2. Designation of states

Art. 4(1)(ii)
Art. 11(1)(iii)(b)
Rule 4.9(a) and (b) PCT
Art. 153(1) EPC
WIPO PCT Guide 5.052-5.053

In filing an international application, applicants may seek patent protection or another form of protection (utility model, for example) for any PCT contracting state.

Upon filing of the PCT request, the applicant will obtain automatic and all-inclusive coverage of all designations available under the PCT on the international filing date, in respect of every kind of protection available and in respect of both regional and national patents. The (automatic) designation of "EP" covers all EPC contracting states for which the PCT and the EPC are in force on the filing date of the international application.

A decision on the EPC contracting states in which protection by way of a European patent is actually being sought need not be made until the application enters the European phase. It is important to note that if a state accedes to the EPC after the international filing date, the EPO cannot act as a designated Office for the EPC contracting state concerned and no European patent can be obtained for that state. In this respect, the date of entry into the European phase is irrelevant.

2.1 Non-designation for reasons of national law

Rule 4.9(b) PCT
WIPO PCT Guide 5.053
PCT Applicant's Guide, Annex B

For reasons of national law, checkboxes in Box No. V of the PCT request form provide for exceptions to the otherwise automatic designation of Germany (DE), Japan (JP) and the Republic of Korea (KR). Selecting the checkbox for these designations is not considered to be withdrawal of a designation, but rather to be non-designation of the state(s) concerned.

According to national law in each of these states, the filing of an international application which contains the designation of that state and claims the priority of an earlier national application filed in that state will have the result that the earlier national application ceases to have effect, with the same consequences as the withdrawal of the earlier national application. To avoid this effect, the appropriate box must be selected (Box No. V of the PCT request form). More information on "self-designation" can be obtained from the national patent offices concerned.

Art. 45(2) PCT
OJ EPO 2022, A82

As regards the EPC contracting states, the problem of self-designation exclusively concerns Germany (DE), and only if protection via the grant of a national patent in Germany is sought, i.e. if the application actually enters the German national phase. The designation of Germany for the purposes of a European patent is not considered a self-designation and is thus not affected. Consequently, there is no reason for withdrawing the automatic designation of EP. If a non-designation of Germany is not indicated upon filing, the international application can still enter the German national phase; however, if this is effected, the earlier German national application will be deemed withdrawn.

The national law of a number of EPC contracting states stipulates that only a European patent may be obtained for these states on the basis of an

international application. The countries which close off the route to a national patent in this way are Belgium (BE), Cyprus (CY), France (FR), Greece (GR), Ireland (IE), Latvia (LV), Lithuania (LT), Monaco (MC), Montenegro (ME), Malta (MT), Netherlands (NL), San Marino (SM) and Slovenia (SI).

3. Extension and validation states

3.1 Extension states

Between 1993 and 2009, the European Patent Organisation concluded what are known as "extension agreements" with a number of European states which had not yet acceded to the EPC at the time and were thus not "included" in the designation "EP", as well as with one which has not acceded to the EPC so far (Bosnia and Herzegovina). Under such an extension agreement and the relevant national law, it is possible for applicants to extend European patent applications and patents to the extension state concerned, where the extended patents will confer essentially the same protection as patents granted by the EPO for the member states of the European Patent Organisation. Valid extension requires firstly that the applicant submit a request for extension and pay the extension fee(s) in due time, i.e. within the period for performing the acts required for entry of an international application into the European phase or within six months of the date of publication of the international search report, whichever period expires later. A further requirement is that, on the international filing date, the extension agreement has to be in force and the extension state must both be a PCT contracting state and be designated for a national patent in the international application.

All extension states (whether former or current) were already PCT contracting states on the date of entry into force of their respective extension agreement. Moreover, since 1 January 2004, all PCT contracting states have been automatically designated for a national and, where applicable, a regional patent.

Extension may be requested for the following European state:

– Bosnia and Herzegovina (BA) (since 1 December 2004). *OJ EPO 2004, 619*

The extension agreements with Albania (AL), Croatia (HR), Latvia (LV), Lithuania (LT), Montenegro (ME), North Macedonia (MK), Romania (RO), Serbia (RS) and Slovenia (SI) terminated when these states acceded to the EPC. The extension system nevertheless continues to apply for all applications filed prior to the date on which each state's particular extension agreement terminated.

OJ EPO 2002, 463
OJ EPO 2003, 1
OJ EPO 2004, 481
OJ EPO 2005, 299
OJ EPO 2007, 406, 637
OJ EPO 2008, 507
OJ EPO 2010, 96, 394
OJ EPO 2022, A78

In view of the time limit for paying extension fees, it is not necessary to decide whether to seek extension – or pay the extension fee due accordingly – prior to the application's entry into the European phase. *OJ EPO 2009, 603*

3.2 Validation states

In addition to the extension agreements, the European Patent Organisation has concluded validation agreements with a number of states which are not a party to the EPC and thus not included in the designation "EP" (validation states). These validation agreements, unlike extension agreements, are not limited to European states. Pursuant to such agreements and the relevant national law, it is possible for applicants to validate European patent applications and patents in validation states, where the validated patents will confer essentially the same protection as patents granted by the EPO for the member states of the European Patent Organisation.

OJ EPO 2015, A19

In order to validate a European patent application or patent in a validation state, an applicant has to submit a request for validation and pay the validation fee in due time, i.e. either within the period for performing the acts required for entry of an international application into the European phase or within six months of the date of publication of the international search report, whichever period expires later. A further requirement is that, on the international filing date, the validation agreement has to be in force and the validation state must both be a PCT contracting state and be designated for a national patent in the international application. In view of the time limit for paying validation fees, there is no need to take a decision on the states for which validation is sought – or pay the validation fees due accordingly – prior to the application's entry into the European phase.

Validation may be requested for the following states

Morocco (MA)	since 1 March 2015	OJ EPO 2015, A18, A20 OJ EPO 2016, A5
Republic of Moldova (MD)	since 1 November 2015	OJ EPO 2015, A84, A85 OJ EPO 2016, A67
Tunisia (TN)	since 1 December 2017	OJ EPO 2017, A84, A85
Cambodia (KH)	since 1 March 2018	OJ EPO 2018, A15, A16
Georgia (GE)	since 15 January 2024	OJ EPO 2023, A105
The Lao People’s Democratic Republic (LA)	since 01 April 2025	

4. Designation of inventor

The inventor should always be identified unless there are special reasons for not doing so. The name and address of the inventor must be furnished in the PCT request form (Box No. III) if the applicant wants to enter the national phase of a state requiring that the data of the inventor be given in the request upon filing. The consequences of non-compliance are a matter of national law. For up-to-date information on the national law of each of the PCT contracting states, see the WIPO PCT Guide, Annex B.

Art. 4(1)(v)
Rule 4.1(a)(iv)
WIPO PCT Guide 5.035-5.038
PCT Newsletter 8-9/2013, 8
PCT Newsletter 10/2020, 14

In so far as the applicant aims to obtain a European patent, the data concerning the inventor – if not already submitted during the international phase – must be provided upon entry into the European phase (see EPC Guidelines E-IX, 2.3.4).

Art. 22(1)
Rule 159, 163(1) EPC

Chapter VII – Languages

1. Admissible languages on filing

1.1 General

The international application, i.e. the request, description, claim(s), drawing(s) and abstract, must be filed with the EPO as receiving Office in English, French or German.

Art. 3(4)(i)
Rule 12.1
Rule 157(2) EPC

An international application filed in another language will be transmitted to the IB to act as receiving Office instead of the EPO. This means that it is not possible to file an international application with the EPO as receiving Office in a language other than the three indicated in Art. 14 EPC for European patent applications not filed via the PCT route (Euro-direct applications).

Rule 19.4(a)(ii)

1.2 International application filed in multiple languages

1.2.1 Abstract and text matter of the drawings

If the abstract and/or any text matter of the drawings is not filed in the same language as the description and claims, the applicant will be invited to correct the defect by the EPO as receiving Office (Form PCT/RO/106) within two months of the date of the invitation. If the applicant replies to the invitation within the prescribed time limit by submitting the translation in the language indicated in the invitation, the international filing date will remain unaffected.

Rule 26.3ter(a), GL/RO 62-64

1.2.2 Request

The request (including any declaration contained in the request under Rule 4.17) may be filed with the EPO as receiving Office in any official language of the EPO (e.g. the request filed in German and the rest of the application in English).

Rule 12.1(c)
GL/RO 59

If the request is not filed in an official language of the EPO, the applicant will be invited to correct the defect (Form PCT/RO/106) within two months of the date of the invitation.

Rule 26.3ter(c)
GL/RO 60

If the applicant replies to the invitation within the prescribed time limit by submitting the translation in one of the official languages of the EPO, the international filing date will remain unaffected.

1.2.3 Description and claims

1.2.3.1 Sentences or short fragments of the description and/or claims in a language other than the language of the proceedings

If the description and/or claims contain sentences or short fragments in a language other than the language of the proceedings, the applicant will be invited by the EPO as receiving Office (PCT/RO/108) to submit a request for rectification under Rule 91 to the EPO as International Searching Authority together with the translation of the relevant parts in the language of the application.

Rule 91

If the requirements under Rule 91 are fulfilled, the rectification will be authorised and will be considered effective from the international filing date. Otherwise, the respective sentences or fragments of the description and/or claims may not be further considered for the purpose of international search and/or preliminary examination.

This scenario only applies where a few words or sentences are in a language other than the language of the proceedings.

1.2.3.2 Technical or non-technical terms used in the description and/or the claims in a language other than the language of the proceedings

Art. 6
Art. 84 EPC
T 61/03

If the description and/or claims contain(s) technical or non-technical terms in a language other than the language of the proceedings, the EPO will assess whether the use of these terms is common or standard in the relevant technical field. In such a case, no translation will be required.

Rule 91

Otherwise, the applicant will be invited by the EPO as receiving Office to submit a request for rectification under Rule 91 (see ~~GL/PCT-EPO~~ A-VII, 1.2.3.1).

1.2.4 Sequence listing

Rule 12.1(d)
PCT/AI Section 332 (a-bis)
PCT Newsletter 07-08/2022, 7

For applications filed on or after 1 July 2022 which contain a sequence listing, the EPO as receiving Office not only accepts sequence listings with language-dependent free text in English or in the same language as used in the international application (French or German) but also permits language-dependent free text to be filed in both English and any other language within a single sequence listing.

2. Language of the proceedings

Rule 12.3
Rule 55.2
OJ EPO 2010, 572

If an international application is filed with the receiving Office in one of the EPO official languages, that language will be the language of the proceedings before the EPO and may not be changed either during the international phase or on entry into the European phase (G 4/08).

If the international application is not filed with the receiving Office in one of the EPO official languages, the language of the proceedings before the EPO as International Authority will be the language of the translation furnished for the purposes of the search or, as the case may be, for the international preliminary examination. The following sections provide more detail on the requirement to file a translation.

2.1 Language for the purpose of the international search

Rule 12.3
Art. 152 EPC
Agreement EPO-WIPO, Art. 3 and Annex A

For the purpose of the international search by the EPO as International Searching Authority, the international application must be in one of its three official languages, i.e. English, French or German. Where the international application is filed in a different language, the applicant must file a translation with the receiving Office into one of the EPO three official languages. This translation must be furnished within one month of the date of receipt of the international application by the receiving Office.

If the application was not filed in a PCT language of publication, the language of the translation submitted for the purpose of the procedure before the EPO as ISA determines the language in which the international application is published. In any case where the language of the international publication is an official language of the EPO, that language will be the language of the proceedings in the European phase and cannot be changed. Therefore, applicants should choose with care the language in which they submit a translation for the purpose of international search.

Rule 48.3
OJ EPO 2010, 572

For international applications filed in Dutch see ~~GL/PCT-EPO~~ B-XI, 2.2.

2.2 Language for the purpose of the supplementary international search

For the purpose of the supplementary international search by the EPO as Supplementary International Searching Authority, the international application must be in one of its three official languages, i.e. English, French or German. Where the international application is filed in a different language, and no translation into any of these languages has been filed for the purpose of the proceedings before the International Searching Authority or for the purpose of international publication, a translation into one of these languages must be filed with the IB together with the request for supplementary international search.

Rule 45bis.1(b)(iii)
Agreement EPO-WIPO, Art. 3 and Annex B

2.3 Language for the purpose of the international preliminary examination

2.3.1 Language of the international application

For the purpose of the international preliminary examination by the EPO as International Preliminary Examining Authority, the international application must be in one of its three official languages, i.e. English, French or German. If neither the language in which the international application was filed nor the language in which the application was published is one of the official languages of the EPO, the applicant must file a translation into one of these languages with the EPO as International Preliminary Examining Authority within the time limit for filing the demand.

Rule 55.2
Art. 152 EPC
Agreement EPO-WIPO, Art. 3 and Annex A

This situation occurs, for instance, if the international application was filed in Spanish, and the Spanish Patent Office acted as ISA. However, if the international application was filed in Spanish but the EPO acted as ISA, a translation will have already been furnished to the EPO as ISA for the purposes of the international search, and the applicant need not furnish a further translation to the EPO as IPEA.

2.3.2 Language of the amendments

Any amendments filed during international preliminary examination must be submitted in the language of proceedings before the EPO as IPEA. If they are initially not submitted in that language, the applicant must file a translation (see VII, 3.1).

Rule 55.3 PCT
WIPO PCT Guide 10.055

2.3.3 Language of the demand

Rule 48.3, 55.1 PCT

The demand must be filed in the language in which the international application was filed, except in the following situations:

– If the international application was filed in a language other than the language in which it was published, the demand must be filed in the language of publication.

– If a translation of the application has to be filed with the EPO as IPEA, the demand must be filed in the language of that translation.

3. Derogations from the language of the proceedings in written proceedings

3.1 Written submissions

Rule 12.2(b)(i)
Rule 92.2(b)
AI 104(a)
OJ EPO 1993, 540

~~With the exception of amendments and~~ Any amendment and correction ~~corrections~~ to the international application must be filed in~~, for which~~ the language of the proceedings ~~must be used,~~. However, if the EPO did not act as RO and the international application was filed in a language other than the language of the proceedings, any rectification under Rule 91.1(b)(ii) and (iii) must be filed in both the language in which the application was filed and the language in which it was translated for the purpose of the procedure before the EPO (language of the proceedings).

~~any~~ Any other correspondence with the EPO as RO, (S)ISA and IPEA can be in any of the EPO official languages.

The EPO ~~as receiving Office~~ will, however, reply in the language of the proceedings.

3.2 International applications filed in Dutch

The EPO acting as ISA and IPEA accept international applications drawn up in Dutch if the application has been filed with the Netherlands Patent Office as RO.

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

Therefore, for such files, a translation is not required for the purpose of the international search by the EPO as ISA. However, under Rule 12.4(a), within 14 months of the priority date, a translation must be filed with the RO in a language of publication accepted by the RO for the purpose of international publication, i.e. English, French or German in the case of the Netherlands Patent Office as RO. The EPO as ISA will establish the ISR and WO-ISA in that language if it is already known at the time of carrying out the international search; otherwise they will be in the language of the request form, i.e. English, French or German. See also PCT Applicant's Guide, International Phase, Annex C, NL.

Rules 12.4, 55.1, 55.2(a)
Agreement EPO-WIPO, Annex A(i)
OJ EPO 2017, A115
OJ EPO 2018, A24

If the EPO acts as IPEA, the applicant need not file a translation of the international application since the EPO will use the published version of the international application as received from the IB, which will be in English, French or German. It should be noted that the demand and amendments under Article 34 PCT must be submitted to the EPO as IPEA in the language of the international publication.

~~See GL/PCT-EPO B-XI, 2.2.~~

3.3 Priority documents

See GL/ISPE 6.17.

3.4 Third-party observations

See ~~GL/PCT-EPO~~ E-II.

4. Correction of the translation

See GL/RO 70.

5. Authentic text of the international application

The "record copy", the copy transmitted to the IB, is considered, for the purposes of the procedure under the PCT, to be a true copy of the international application. *Art. 12(2)*

Where a document in pre-conversion format has been submitted by the applicant together with the international application, that document may be used as a fallback in the event of conversion errors (see ~~GL/PCT-EPO~~ A-II, 1.2.1). *AI 706*

Chapter VIII – Common provisions

1. Representation

1.1 General principles

The PCT explicitly allows the receiving Office to apply its national law to the extent that it requires applicants to be represented by an agent having the right to represent them before it. On this basis, the EPC provisions concerning professional representation apply in respect of international applications processed by the EPO as receiving Office.

Art. 27(7)
Art. 133(1), (2) EPC

An agent is required by the EPO acting as receiving Office if the applicant has neither a residence nor their principal place of business in an EPC contracting state. Such applicants must act through an agent in all proceedings before the EPO acting as receiving Office except for filing the application and paying fees.

In view of the importance of careful preparation of the international application and of its proper processing, it is in any case highly advisable for applicants to use the services of an agent.

An appointed agent who has the right to represent the applicant before the receiving Office is automatically also entitled to act before the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority ("agent for the international phase").

Art. 49
Rule 90.1
PCT AG I 5.041-5.051, 10.019-10.023, 11.001-11.014

Information on the representation of the applicant in the international phase is to be indicated in Box No. IV of the PCT request form, in a separate power of attorney or via a separate notice referring to an existing general power of attorney, taking into account the instructions provided in the Notes to the PCT request form concerning Box No. IV and in GL/RO 117-121 as well as the information provided below.

GL/RO 117-121

1.2 Representation by an agent

Two categories of agent ("professional representative" in EPC terminology) have the right to practise before the EPO as receiving Office:

Art. 27(7)
Art. 134(1), (8) EPC
OJ EPO 2013, 500, 535
PCT AG I 11.001-11.004

– professional representatives or associations of representatives entered in the directory of professional representatives maintained by the EPO;

– legal practitioners qualified to act as a professional representative in patent matters in an EPC contracting state and having their place of business in that state.

Only a person belonging to at least one of these two categories may be appointed as an agent for an international application filed with the EPO as receiving Office.

If the agent is appointed using Box No. IV of the PCT request form, they must be indicated there by name unless they belong to an association of

professional representatives registered as such with the EPO. They can indicate any address they wish as long as it is in an EPC contracting state.

Rule 4.7 and 90 Rule 152(11) EPC OJ EPO 2013, 500, 535

If an association of ~~professional~~ representatives is appointed as agent using Box No. IV of the PCT request form, the name of the association must be indicated there. The number under which the association is so registered with the EPO may also be indicated.

If an association of ~~professional~~ representatives is appointed, each member of the association may perform procedural acts on behalf of the applicant, and correspondence from the EPO is addressed to the association rather than one particular member.

Rule 90.1(d)(ii) Rule 90.6(b) PCT AG I 11.004, 11.012

Further agents may be appointed at any time to represent the applicant either in the international phase in general or specifically before the EPO acting as International Searching Authority, Supplementary International Searching Authority or International Preliminary Examining Authority. The appointment of a new agent for the international phase in general is treated as revocation of any earlier appointment of an agent, unless otherwise indicated in the power of attorney appointing the new agent. Furthermore, an agent appointed for the international phase in general, unless otherwise indicated in the document appointing them, may appoint sub-agents to represent the applicant.

1.3 Representation by a common agent, common representative or "deemed common representative"

Rule 90.2 PCT AG I 11.003, 11.005-11.006

If there are two or more applicants, each of them may choose to appoint their own agent, or they may choose to appoint a common agent for the international phase or one of the applicants who is entitled to file the international application to act as their common representative. The latter may in turn appoint an agent.

Art. 27(7) Art. 133(2) and 150(2) EPC

If the appointed common representative has neither a residence nor their principal place of business in an EPC contracting state, the EPO as receiving Office will require the appointment of an agent.

If a common agent or common representative is appointed using Box No. IV of the PCT request form, their name and address must be indicated there.

Rule 19.1, 90.2 Art. 27(7) Art. 133(2) and 150(2) EPC

If no common agent or common representative is appointed, the applicant first named in the request who is entitled to file the international application with the EPO as receiving Office is considered to be the common representative. If such "deemed common representative" has neither a residence nor their principal place of business in an EPC contracting state, the EPO as receiving Office will require the appointment of an agent.

If no common agent is appointed, any correspondence is sent to the (deemed) common representative or, if the latter has appointed an agent, to their agent, unless a different address is provided as the address for correspondence.

A deemed common representative is not entitled to sign notices of withdrawal on behalf of co-applicants without submitting evidence of their consent to such withdrawal. If a deemed common representative has appointed an agent, the latter may validly perform any act which could be performed by the deemed common representative. If a co-applicant of the deemed common representative has appointed an agent, such agent will not be considered the "agent of record" and will be entitled to act only on behalf of that co-applicant.

1.4 Representation by an employee

Natural or legal persons having their residence or principal place of business in an EPC contracting state do not need to be represented by an agent in proceedings before the EPO acting as receiving Office, (S)ISA or IPEA. They may, however, act in these proceedings through an employee, who need not be an agent (see ~~GL/PCT-EPO~~ A-VIII, 1.2) but who must be authorised (see ~~GL/PCT-EPO~~ A-VIII, 1.11, 1.12, 1.13).

Art. 27(7)
Art. 133(3) EPC

1.5 Manner of appointment of an agent, common agent or common representative

Appointment of an agent, common agent or common representative for the international phase requires a declaration to this effect. This can be made either in the PCT request form (Box No. IV) or in a separate notice ("power of attorney"). For this purpose the "PCT/Model of power of attorney" may be used, which is available on the WIPO website.

Rule 90.4, 90.5
PCT AG I 11.007-11.009

For the appointment of an agent, a common agent or a common representative to be effective, the PCT request or the power of attorney must be duly signed by (all) the applicant(s) for whom the agent, the common agent or the common representative is intended to act. However, a power of attorney must only be submitted to the EPO if the EPO's waiver of the requirement to submit a separate power of attorney does not apply in the circumstances. For further information on separate powers of attorney and the EPO's waiver of the requirement to submit them (~~,—~~see ~~GL/PCT-EPO~~ A-VIII, 1.11 and 1.13).

Appointment of an agent or a common agent may also be effected by referring in the PCT request form (Box No. IX) or in a separate notice to an existing general power of attorney deposited with the EPO. A copy of the general power of attorney must only be furnished if the EPO's waiver concerning a copy of a general power of attorney does not apply in the circumstances. For further information on general powers of attorney and the EPO's waiver of the requirement to submit a copy of them (~~,—~~see ~~GL/PCT-EPO~~ A-VIII, 1.12-1.13).

~~A power of attorney may not be filed by fax or using the EPO Web Form Filing service.~~

1.6 Address for correspondence

Where no agent or common representative is appointed, any correspondence is sent to the address, indicated in Box No. II or III of the PCT request form, of the applicant (if there is only one applicant) or of the deemed common representative (if there are two or more applicants).

Art. 27(7)
Rule 4.4(d)
Art. 150 EPC
OJ EPO 2014, A99

However, if the applicant wishes correspondence to be sent to a different address, that address must be indicated in Box No. IV instead of the indication of an agent or common representative. In this case, and only in this case, the last check box of Box No. IV must be marked (that is, the last check box must not be marked if either of the check boxes "agent" or "common representative" in Box No. IV has been marked). For proceedings in the international phase before the EPO as receiving Office, International Searching Authority, Supplementary International Searching Authority or International Preliminary Examining Authority, the address for correspondence given may be that of any person in any country.

1.7 Representation before the EPO as International Searching Authority

Art. 49
Rule 90.1(a), (b), (d)
PCT AG I 11.001-11.014

Applicants may be represented before the EPO as International Searching Authority (ISA) by the agent appointed on filing the international application and/or having the right to practise before the receiving Office, who is usually the agent for the international phase.

The agent appointed for the international phase – and thus including for proceedings before the ISA – may appoint a sub-agent to represent the applicant specifically before the EPO as ISA, provided that any person so appointed as sub-agent has the right to practise before the EPO acting as ISA. All communications issued by the ISA are then sent to the agent specifically appointed for proceedings before the EPO as ISA.

Applicants may also appoint an agent to represent them specifically before the EPO in its capacity as ISA. Any agent specifically appointed to act before the EPO as ISA must be entitled to practise before the EPO.

The applicant or agent for the international phase can appoint an agent specifically before the EPO as ISA by signing and submitting a separate power of attorney. Appointment may also be effected by reference in a separate notice to a duly deposited general power of attorney. In this case, the separate notice may be signed by the purported agent. The separate power of attorney or a copy of a general power of attorney must only be submitted to the EPO acting as ISA if the EPO's waiver of the requirement to submit it does not apply in the circumstances. For further information, see ~~GL/PCT-EPO~~ A-VIII, 1.11-1.13.

1.8 Representation before the EPO as Supplementary International Searching Authority

Art. 49
Rule 90.1(a), (b), (b-bis), (d)
PCT AG I 11.001-11.014

Applicants may be represented before the EPO as Supplementary International Searching Authority (SISA) by the agent appointed on filing the international application and/or having the right to practise before the receiving Office, who is usually the agent for the international phase.

The agent appointed for the international phase – and thus including for proceedings before the SISA – may appoint a sub-agent to represent the applicant specifically before the EPO as SISA, provided that any person so appointed as sub-agent has the right to practise before the EPO acting as SISA. All communications issued by the EPO as SISA are then sent to the agent specifically appointed for proceedings before the EPO as SISA.

Applicants may also appoint an agent to represent them specifically before the EPO in its capacity as SISA. Any agent specifically appointed to act before the EPO as SISA must be entitled to practise before the EPO.

The applicant or agent for the international phase can appoint an agent specifically before the EPO as SISA by signing and submitting a separate power of attorney. Appointment may also be effected by reference in a separate notice to a duly deposited general power of attorney. In this case, the separate notice may be signed by the purported agent. The separate power of attorney or a copy of a general power of attorney must only be submitted to the EPO acting as SISA if the EPO's waiver of the requirement to submit it does not apply in the circumstances. For further information, see ~~GL/PCT-EPO~~ A-VIII, 1.11-1.13.

1.9 Representation before the EPO as International Preliminary Examining Authority

Applicants may be represented before the EPO as International Preliminary Examining Authority (IPEA) by the agent appointed on filing the international application and/or having the right to practise before the receiving Office, who is usually the agent for the international phase.

Art. 49
Rule 90.1(a), (c), (d)
PCT AG I 10.019-10.023

The agent appointed for the international phase may appoint a sub-agent to represent the applicant specifically before the EPO as IPEA, provided that any person so appointed as sub-agent has the right to practise before the EPO acting as IPEA.

Applicants may also appoint an agent to represent them specifically before the EPO as IPEA. Any agent specifically appointed before the EPO as IPEA must be entitled to practise before the EPO.

The applicant or agent for the international phase can appoint an agent specifically before the EPO as IPEA either by completing Box No. III of the demand form (PCT/IPEA/401) and signing the demand, or by signing and submitting a separate power of attorney. Appointment may also be effected by reference in the PCT demand or in a separate notice to a duly deposited general power of attorney. In this case, the PCT demand or the separate notice may be signed by the purported agent. The separate power of attorney or a copy of a general power of attorney must only be submitted to the EPO acting as IPEA if the EPO's waiver of the requirement to submit it does not apply in the circumstances. For further information, see ~~GL/PCT-EPO~~ A-VIII, 1.11-1.13.

1.10 Representation before the EPO as designated or elected Office

A (common) agent appointed in the PCT request as agent for an international application is appointed only for the international phase. This means that a professional representative authorised to act before the EPO and who acted for the applicant(s) in the international phase is not automatically considered to be the representative for the European phase. However, if the EPO is the receiving Office and the agent is appointed by a separate authorisation, the applicant(s) may, at the same time, indicate in that authorisation that the agent is also appointed to represent the applicant(s) before the EPO as designated or elected Office in the

Art. 27(7), 49
Rule 90.1
Art. 134 EPC
PCT AG I 11.001

European phase. To designate an agent for the international and European phases at the same time, the applicant may use Form EPA/EPO/OEB 1003, which is available on the EPO website.

If an agent is appointed by reference to an existing general power of attorney, the appointment of the agent for the European phase too must be explicitly stated in the separate notice.

For details on representation before the EPO as designated or elected Office, see EPC Guidelines, A-VIII, 1 and E-IX, 2.3.1.

1.11 Power of attorney

Rule 90.4(b)

Generally, a separate power of attorney must be submitted to either the receiving Office or the International Bureau or, where it appoints an agent to represent an applicant specifically before the ISA, SISA or IPEA, to that Authority.

Rule 90.4(c)

It must be duly signed and the name and address of the appointed person must comply with Rule 4.4.

OJ EPO 2010, 335

However, the EPO in its capacity as receiving Office, ISA, SISA and IPEA has waived the requirement under Rule 90.4(b) that a separate power of attorney be submitted to appoint a (common) agent or a common representative (see ~~GL/PCT-EPO~~ A-VIII, 1.13). Thus, in cases where this waiver is applicable, the requirements of signature and proper indication of name and address under Rule 90.4(c) do not apply.

1.12 General power of attorney

Rule 90.5

A "general power of attorney" is a separate power of attorney appointing an agent to represent an applicant in relation to any international application which they may file. Generally, for such appointment to be effective:

– reference must be made in the PCT request, the PCT demand or a separate notice to the general power of attorney;

– the general power of attorney must ~~be~~ have been deposited with the receiving Office or, in the case of appointment specifically before the ISA, SISA or IPEA, with that Authority;

– a copy of the general power of attorney must be attached to the PCT request, the PCT demand or the separate notice, as the case may be.

OJ EPO 2010, 335

However, the EPO in its capacity as receiving Office, ISA, SISA and IPEA has waived the requirement under Rule 90.5(a)(ii) that a copy of a general power of attorney be attached to the PCT request, the PCT demand or a separate notice (see ~~GL/PCT-EPO~~ A-VIII, 1.13).

1.13 Waivers – exceptions to applicability

The waivers by the EPO with regard to the requirements under Rule 90.4(b) and Rule 90.5(a)(ii) do not apply to ~~legal practitioners referred to in Art. 134(8) EPC or to~~ employees referred to in Art. 133(3) EPC if they are not also professional representatives or legal practitioners.

Rule 90.4(e), 90.5(d)
OJ EPO 2010, 335
OJ EPO 2024, A75, A77

The waiver by the EPO with regard to the requirement under Rule 90.4(b) that a separate power of attorney be submitted to appoint a (common) agent or a common representative does not apply if the (common) agent or the common representative submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4.

The waiver by the EPO with regard to the requirement under Rule 90.5(a)(ii) that a copy of the general power of attorney be attached to the PCT request, the PCT demand or the separate notice does not apply if the (common) agent submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4.

Furthermore, the EPO acting as receiving Office, ISA, SISA or IPEA may require the filing of a separate power of attorney or a copy of a general power of attorney if necessary in the circumstances of a particular case, for example if:

– a procedural act is performed by a purported agent who is not the agent of record, unless the purported agent belongs to the same office as the agent of record, or both the purported agent and the agent of record are employees of the applicant or, if there is more than one applicant, of the common representative;

– there is doubt as to whether the agent or common representative is entitled to act.

2. Form of documents

2.1 Documents making up the international application

The physical requirements of the documents making up the international application, i.e. request, description, claims, drawings and abstract, are set out in Rule 11. Compliance with these requirements, which is checked by the receiving Office, is only required to the extent necessary for the purpose of reasonably uniform international publication.

Art. 14(1)(a)(v)
Rule 26.3bis

See GL/RO 132-146.

2.2 Later documents

The requirements of Rules 10 and 11.1 to 11.13 also apply to any other document (e.g. replacement sheets, amended claims, translations) submitted after the filing of the international application.

Rule 11.14
GL/RO 132

2.3 Number of copies

Rule 11.1
Rule 3.3(a)(ii)
Rule 92.4(d) and (g)(ii)
~~*OJ EPO 2019, A18*~~

The documents constituting an international application must be filed with the EPO as receiving Office in one copy only. The same applies to any of the documents referred to in the check list of the PCT request form (Box No. IX).

~~However, if the application is filed by fax a confirmation copy must be filed by post at the same time. See GL/PCT-EPO A-II, 1.2.2. As to subsequent documents filed by fax, there is no obligation to file a confirmation copy unless the receiving Office invites the applicant to submit one. See GL/PCT-EPO A-II, 1.3.~~

2.4 Filing of subsequent documents

See ~~GL/PCT-EPO~~ A-II, 1.3.

3. Signature of documents

3.1 Documents filed after filing the international application

Rule 90bis.5
Rule 92.1(a)
GL/RO 20
GL/ISPE 22.56

Any ~~paper~~ document submitted by the applicant in the course of the international procedure, other than the international application itself, must, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. All letters must be signed by the applicant or by a duly appointed agent or common representative. A deemed common representative is entitled to sign on behalf of the co-applicants with the only exception of notices of withdrawal.

Rule 53.2(b)
Rule 53.8
Rule 60.1(a-ter)
Rule 90bis.5
GL/ISPE 22.28-22.32
OJ EPO 2010, 335

A demand for international preliminary examination shall ~~must~~ be signed by the applicant or, if there is more than one applicant, by all applicants. If the signature of one or more applicants is missing, the EPO as IPEA will not invite the applicant(s) to furnish the missing signature(s) provided that at least one of the applicants has signed the demand. The signature by one of the applicants is thus considered sufficient. It is also possible for (common) agents or common representatives to sign a demand on behalf of the applicant(s) who appointed them. Where the demand is signed by a (common) agent the EPO as IPEA will not invite the applicant(s) to file a (separate) power of attorney or a copy of a general power of attorney since the EPO has waived these requirements. A deemed common representative is entitled to sign on behalf of the co-applicants with the only exception of notice of withdrawal.

3.2 Signature of the PCT request and a power of attorney

Rule 4.1(d), 4.15, 26.2bis(a), 51bis.1(a)(vi)
GL/RO 122-128
WIPO PCT Guide 5.088-5.091
PCT Newsletter, 1/2020, 5

The PCT request form or, where applicable, the power of attorney must be signed by the applicant (Box No. X of the request form).

Where there are two or more applicants, each applicant must sign the request, or each applicant for whom an agent has been appointed must sign a power of attorney (Box No. IX of the PCT request form). However, if there is more than one applicant, the EPO as receiving Office will not invite the applicant to furnish the missing signature(s) if the PCT request form is signed by at least one of the applicants. Any designated Office, however, may require the missing signature of any applicant who has not signed the PCT request for that designated state.

The EPO as designated Office does not require a missing signature to be submitted upon entry into the European phase.

~~For the requirements concerning the signature of the PCT request and a power of attorney see GL/RO 122-128.~~

The EPO as RO, ISA, SISA and IPEA has waived the requirement that, for the effective appointment of an agent, common agent or common representative, a signed separate power of attorney must be submitted to it if the PCT request is not signed by (all) the applicant(s). The EPO has also waived the requirement that a copy of the general power of attorney be attached to the PCT request or to a separate notice if appointment of a (common) agent is made by reference to a general power of attorney. For further details on powers of attorney, general powers of attorney and the waivers see ~~GL/PCT-EPO~~ A-VIII, 1.11-1.13.

3.3 Form of signature

See ~~GL/EPO~~ EPC Guidelines A-VIII, 3.3.

3.4 Joint applicants

For the PCT request and a power of attorney see ~~GL/PCT-EPO~~ A-VIII, 3.2.

For the demand for international preliminary examination see ~~GL/PCT-EPO~~ A-VIII, 3.1.

PCT – Part B

Guidelines for Search

Contents

Chapter I – Introduction

1. Purpose of Part B

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

2. The examiner

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

GL/ISPE 15.08-15.09

2.1 Consultation with other examiners

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

2.2 Search Division consisting of more than one examiner

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

GL/ISPE 15.08

Chapter II – General

1. International search and written opinion under Chapter I

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

Art. 15
Art. 33

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

Art. 17
Rule 43
GL/ISPE 15 and 16

In its capacity as an International Searching Authority, the EPO is empowered not only to carry out the international search but also to formulate a preliminary and non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable When appropriate, an opinion will also be given on added subject-matter, unity, insufficient disclosure and clarity or support issues, as well as formal defects.

Rule 43bis
GL/ISPE 17

This opinion is sent to the applicant in the form of a written opinion of the International Searching Authority (WO-ISA) together with the search report. If no international preliminary examination report is to be established because the applicant did not file a demand for preliminary examination, or the demand has been withdrawn, the International Bureau will prepare a report, entitled "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)" having the same contents as the written opinion. Even if the applicant filed any amendments under Article 19, the amendments will not be taken into consideration in the international preliminary report on patentability (PCT Chapter I).

Rule 44bis
GL/ISPE 2.18

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

Art. 21(3)
Rule 48.2
GL/ISPE 2.17

Although the PCT procedure differs in some procedural and formal aspects from the European procedure, the criteria for search and examination with respect to novelty, inventive step, industrial applicability, unity, non-patentable subject-matter or exclusions, insufficient disclosure and clarity are in principle the same. This means that search and examination under the PCT is carried out in the same way and applying the same quality standard as for a European application in so far as the same requirements are examined.

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

1.1 Competence of the EPO as ISA

Art. 16, 32
Rule 35, 59
GL/ISPE 1.13-1.14

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

Art. 16
Rule 35
Art. 152 EPC
Agreement EPO-WIPO, Art. 3(1)
OJ EPO 2017, A115
OJ EPO 2018, A24
WIPO PCT Guide 7.002

Although the EPO's competence to act as ISA is, in principle, universal, i.e. not restricted to international applications from e.g. EPC contracting states, it can act as ISA only on condition that the receiving Office where the application was filed has specified the EPO as ISA.

Most receiving Offices have specified the EPO as competent ISA. On 1 January 2024, the only states that had not specified the EPO as ISA (and IPEA) were: United Arab Emirates (AE), Australia (AU), Canada (CA), Democratic People's Republic of Korea (KP), Republic of Korea (KR) and Papua New Guinea (PG). Up-to-date information is available on the WIPO website.

Agreement EPO-WIPO, Art. 3(3)
OJ EPO 2017, A115
OJ EPO 2018, A24
OJ EPO 2020, A35
OJ EPO 2023, A37

If the IB is acting as receiving Office, the EPO is competent as ISA/IPEA if the international application could have been filed with a receiving Office which specified the EPO as ISA/IPEA at the filing date.

Rule 4.1(b)(iv), 4.14bis

If the receiving Office has specified more than one ISA, the applicant must indicate the chosen ISA in the PCT request (Box No. VII) and in the Fee Calculation Sheet (Box No. 2). Only one ISA may be selected. For example, the EPO may be chosen as ISA for applications filed with the USPTO and for applications in English filed with the JPO as receiving Office.

Agreement EPO-WIPO, Art. 3(2), Annex A(i)
OJ EPO 2017, A115
OJ EPO 2018, A24
OJ EPO 2020, A35
OJ EPO 2023, A37

Applicants considering their choice of ISA are advised to bear in mind that the EPO will act as an IPEA only if the international search was carried out by the EPO itself or by another European ISA. On 1 January 2024, the EPO, the Austrian, Finnish, Spanish, Swedish and Turkish patent offices as well as the Nordic Patent Institute and the Visegrad Patent Institute were acting as European ISAs.

OJ EPO 2009, 594

If the EPO acts as main ISA or SISA, no supplementary European search is carried out after entry in the European Phase (see EPC Guidelines E-IX, 3.2). Therefore, no search fee will be due on entry into the European phase.

If an international application is filed with the EPO acting as receiving Office, the EPO is the only competent ISA for the international search. Therefore, this need not be entered in Box No. VII of the PCT request form. Note that the EPO cannot be selected as ISA for supplementary international search (SIS) when the EPO was the main ISA.

Art. 16 PCT
Rule 4.1(b)(iv), 4.14bis
Art. 152 EPC
Agreement EPO-WIPO, Art. 3(1)
OJ EPO 2017, A115
OJ EPO 2020, A35

2. Objective of the search

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

Art. 15
Rule 33
GL/ISPE 15.01

3. Search documentation

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

Rule 34
GL/ISPE 15.45-15.51

4. Search report

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

Art. 18
Rule 43
GL/ISPE 16.01

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

Rule 43bis.1

5. Time limit

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

Rule 42.1, 43bis.1
GL/ISPE 2.13, 16.05

6. Representation before the EPO as ISA or SISA

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

Art. 49

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

Rule 90.1(b)
Rule 90.1(b-bis)

Chapter III – Characteristics of the search

1. Scope of the search

1.1 Completeness of the search

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

Art. 15(4)
Rule 34

See also ISPE Guidelines 15.18 and 15.20.

1.2 Effectiveness and efficiency of the search

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

GL/ISPE 15.46-15.47

1.3 Search in analogous fields

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

Rule 33.2(b), (c)
GL/ISPE 15.48-15.51

1.4 Search on the internet

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

GL/ISPE 15.56-15.59

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

2. The subject of the search

2.1 Basis for the search

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

Art. 15(3)
Rule 33.3(a)
GL/ISPE 15.10

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

2.2 Interpretation of claims

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

GL/ISPE 15.21-15.23

2.2.1 Claims with explicit references to the description or drawings

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

Rule 6.2(a)
GL/ISPE 5.10, 16.30

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

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

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

2.3 Obvious mistakes and missing or correct parts/elements

2.3.1 General considerations

Art. 19
Rule 91.1
GL/ISPE 15.10, 15.23

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

2.3.2 Request for rectification of obvious mistakes (Rule 91)

Rule 91

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

Art. 19
GL/ISPE 15.10

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

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

Rule 20.5

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

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

Similarly if applicants appear to have erroneously filed part(s) of the application and/or (an) entire element(s) thereof (i.e. all of the description and/or all of the claims), they may still furnish the correct part(s) and/or element(s) at a later date without affecting the international filing date, subject to the requirements of Rules 4.18 and 20.6(a) and provided the correct part(s) and/or element(s) were completely contained in the priority document (see ~~GL/PCT-EPO~~ A-II, 6). *Rule 20.5bis*

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

(a) the RO notifies it of the correct element(s) and/or part(s) before the start of the search; or

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

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

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

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

The RO may notify the ISA of correct part(s) and/or element(s) after the ISA has begun to draw up the international search report. In such cases, the EPO as ISA will invite the applicant to pay an additional fee equal to the search fee within one month of the date of the invitation (Form 208) (Rule 40*bis*.1 and Article 2(1) RFees). *OJ EPO 2020, A36* *OJ EPO 2020, A81*

If the EPO as ISA is notified of correct element(s) and/or part(s) after the search has started but before its completion and the additional fee is paid, the EPO will also complete the already initiated search and issue a non-official international search report and written opinion based on the international application as initially submitted. However, the non-official international search report and written opinion are issued only for the benefit of the applicant and any designated Offices which have given notice

under Rule 20.8(b-*bis*) of an incompatibility. They therefore do not constitute the international search report under Rule 43 and written opinion under Rule 43*bis*. The applicant thus has no obligation to respond to the non-official written opinion upon entry into the European phase.

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

2.4 Anticipation of amendments to claims

Rule 33.3(b)
GL/ISPE 15.25

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

2.5 Broad claims

GL/ISPE 15.26

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

2.6 Independent and dependent claims

GL/ISPE 15.27

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

2.7 Search on dependent claims

GL/ISPE 15.28

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

2.8 Combination of elements in a claim

GL/ISPE 15.31

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

2.9 Different categories

GL/ISPE 15.32

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

2.10 Subject-matter excluded from search

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

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

2.11 Nucleotide and amino acid sequences

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

Rule 5.2, *13ter.1*
OJ EPO 2011, 372
OJ EPO 2021, A96, *A97*
OJ EPO 2022, A60
OJ EPO 2024, A54, *A55*
GL/ISPE 9.39, *15.12*
GL/ISPE 15.14A

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

2.12 Lack of unity

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

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

2.13 Technological background

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

GL/ISPE 15.30

Chapter IV – Search procedure and strategy

1. Analysis of the application prior to searching

1.1 Taking into account results of an earlier search and classification

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

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

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

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

Rules 4.12, 12bis, Rules 16.3, 41.1 OJ EPO 2009, 99 ~~OJ EPO 2023, A5~~ OJ EPO 2024, A7

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

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

Rules 23bis.2 and 41.2

1.2 PCT Direct applications

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

OJ EPO 2017, A21

1.2.1 Requests for PCT Direct

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

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

(a) the informal comments are filed together with the international application with the receiving Office in the form specified in ~~GL/PCT-EPO~~ A-IV, 1.2, and

(b) the international application claims priority of an earlier application searched by the EPO (European, national or international first filing).

1.2.2 Processing of PCT Direct letters

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

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

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

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

1.3 Third-party observations

PCT AI Part 8

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

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

documents in support of them. Any document(s) provided to the examiner with the observations will either have been received from the IB or obtained by the formalities officer.

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

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

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

1.4 Documents cited in the application

See ISPE Guidelines 15.37.

2. Search strategy

2.1 Subject of the search; restrictions

See ISPE Guidelines 15.41.

2.2 Formulating a search strategy

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

2.3 Carrying out the search; types of documents

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

2.4 Reformulation of the subject of the search

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

2.5 Closest prior art and its effects on the search

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

See also ISPE Guidelines 15.60.

2.6 End of search

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

3. Procedure after searching

3.1 Preparation of the search report

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

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

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

3.2 Amended international search report

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

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

Chapter V – Preclassification and IPC classification of international patent applications

1. Definitions

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

2. Preclassification (for file routing and distribution)

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

2.1 Incorrect preclassification

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

3. IPC classification of the application

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

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

3.1 Amended classification of late-published search reports

See ISPE Guidelines 7.05.

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

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

GL/ISPE 7.06, 7.08

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

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

GL/ISPE 7.07

3.4 Verification of the IPC classification

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

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

1. General

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

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

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

See also ISPE Guidelines 11.22 and 15.05.

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

If the written disclosure was made available to the public on or after the filing date of the international application concerned, the written disclosure will be cited in the international search report together with the date on which it was available, provided that the non-written disclosure was made available to the public prior to the filing date of the international application. The written opinion and the international preliminary examination report will draw attention to the non-written disclosure in Box No. VI (Certain documents cited). *Rule 64.2, 70.9*

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

3. Priority

Section B-VI, 3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *GL/ISPE 11.02-11.03*

4. Conflicting applications

4.1 Potentially conflicting European and international applications

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

the European phase before the EPO (see ~~GL/EPO~~ EPC Guidelines C-IV, 7.1).

4.2 National prior rights

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

5. Date of reference for documents cited in the search report; filing and priority date

5.1 Verification of claimed priority date(s)

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

See also ISPE Guidelines 11.02-11.03.

5.2 Intermediate documents

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

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

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

See also ISPE Guidelines 11.06.

5.4 Documents published after the filing date

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

See also ISPE Guidelines 11.11.

5.5 Non-prejudicial disclosures

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

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

See also ISPE Guidelines 16.76.

5.6 Matters of doubt in the state of the art

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

See also ISPE Guidelines 11.23 and 15.64-15.65.

6. Contents of prior-art disclosures

6.1 General remark

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

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

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

6.3 Conflict between abstract and source document

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

6.4 Insufficient prior-art disclosures

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

6.5 Incorrect compound records in online databases

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

7. Internet disclosures – technical journals

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

See also ISPE Guidelines 11.13.

Chapter VII – Unity of invention

1. General remarks

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

The PCT does not provide for the possibility of filing a divisional application. However, once the international application has validly entered the European phase, it is possible to file divisional applications with the EPO as long as the application is pending (see EPC Guidelines E-IX, 2.4.1).

~~Furthermore, divisional applications are not allowed under the PCT.~~

2. Lack of unity at the search stage

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

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

(i) not pay any additional fees,

(ii) pay some or all fees without protest or

(iii) pay some or all fees under protest.

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

OJ EPO 2017, A20

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

3. No request for payment of additional search fees

Exceptionally it might be chosen not to request the applicant to pay additional search fees, even if an objection as to lack of unity occurs. This could be the case when the additional search effort for the other invention(s) is minor. In addition, no invitation to pay additional search fees should be issued when the other inventions are either not novel or do not possess an inventive step over the prior art at hand. However, it must be borne in mind that the written opinion under Chapter I must be written for all inventions that were searched, including those for which no additional search fees were requested. If additional search fees are not requested, for consistency reasons the examiner should not ask for additional

examination fees should a demand for international preliminary examination under Chapter II be filed (see ~~GL/PCT-EPO~~ C-V, 3.3). Thus, when deciding on whether to ask for additional search fees, the examination effort for the whole procedure must also be taken into account.

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

4. Cascading non-unity

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

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

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

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

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

Example

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

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

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

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

5. Documents relevant only to other inventions

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

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

6.1 No payment of additional search fees

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

If a demand for international preliminary examination selecting the EPO as IPEA has been filed, the EPO as IPEA will not perform the international preliminary examination in respect of any claims relating to an invention for which no additional search fee was paid and, therefore, for which no ISR was established (see C-V, 2).

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

6.2 Payment of additional search fees without protest

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

6.3 Payment of additional search fees under protest

Rule 40.2(c)
GL/ISPE 10.66-10.69

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

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

an opinion as to novelty, inventive step and industrial applicability for all searched inventions will be given.

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

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

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

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

7. Protest procedure

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

7.1 Admissibility of the protest as checked by the formalities officer

Rule 40.2(c) and 40.2(e)

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

GL/ISPE 10.66-10.67 and 10.69

To be admissible the protest should satisfy the following requirements:

(a) The applicant must have paid the prescribed protest fee (Rule 40.2(e)), and

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

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

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

7.2 The work of the Review Panel

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

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

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

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

GL/ISPE 10.70

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

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

If the Review Panel considers that the protest is only partially justified, it will communicate this to the applicant using Form 212. Reasoning must be given, indicating why the request for payment of additional fees is partially upheld and addressing the applicant's relevant arguments. The search will

be carried out and the written opinion established for the inventions for which the fees are paid (see ~~GL/PCT-EPO~~ B-VII, 6.3). The Review Panel will order the reimbursement of the corresponding additional fees but not the protest fee.

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

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

See also ~~GL/EPO~~ EPC Guidelines C-III, 3.4.

8. Lack of unity and incomplete search

Rule 13
Art. 17(2)(a)(ii)
Art. 17(3)(a)

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

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

1. General remarks

The aim of the EPO as ISA is to issue international search reports which are as complete as possible. Nevertheless, there are situations in which the search report and the written opinion cover only part of the subject-matter claimed, or in which no search report is issued. This may be either because the international application includes subject-matter which the ISA is not required to deal with (see ~~GL/PCT-EPO~~ B-VIII, 2), or because of missing sequence listings (see B-VIII, 3.2), or because of lack of non-unity of invention (see B-VII, 2), or else because the description, claims or drawings fail to meet a requirement, such as clarity or support of the claims by the description, to such an extent that no meaningful search can be made of all or some of the claims (see ~~GL/PCT-EPO~~ B-VIII, 3). Applications of the latter kind are often referred to as "complex applications". *GL/ISPE 9.01*

~~The same approach is taken as for European applications.~~

In particular, "complex applications" are dealt with in accordance with the present Guidelines and the ISPE Guidelines supplemented, where appropriate, by the EPO's practice as set out in the EPC Guidelines.

In principle, a declaration of no search under Art. 17(2)(a)(ii) should remain an exception. Under the PCT, even if the applicant amends the claims to overcome the objection, an additional search is not possible. When a declaration of no search is issued, the search must be performed at the examination stage without requesting an additional fee if the international application enters the European phase before the EPO and if the objection leading to the declaration has been overcome (see ~~GL/EPO~~ EPC Guidelines C-IV, 7.3). Therefore, at least some effort should be made to carry out a meaningful search of at least part of the claimed subject-matter. *Art. 17(2)(a)(ii)* *GL/ISPE 9.40*

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

Art. 17(2)(a)(i) and Art. 34(4)(a)(i) together with Rules 39 and 67.1 are the equivalents of Art. 52(2), (3) and 53(b), (c) EPC concerning the exclusion from patentability of non-technical inventions, programs for computers, methods of doing business, medical methods and the exception to patentability for plant or animal varieties or essentially biological processes for the production of plants and animals, respectively. Since the PCT procedure does not lead to a grant, subject-matter which would be excluded from patentability under the EPC is identified as subject-matter for which the ISA and/or the IPEA is not required to carry out search and international preliminary examination. In other words, the EPO is not required to perform an international search if the application relates to subject-matter which is not regarded as an invention or susceptible of industrial application or which is excluded from patentability under the provisions of the EPC (see B-VIII, 1 and B-VIII, 3). *Art. 17(2)(a)(i)* *Art. 34(4)(a)(i)* *Rule 39* *Rule 67.1* *GL/ISPE 9.02-9.15* *Agreement EPO-WIPO, Art. 4, Annex C* *OJ EPO 2017, A115* *OJ EPO 2018, A24* *OJ EPO 2020, A35* *OJ EPO 2023, A37*

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

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

GL/ISPE 9.40

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

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

Rule 39.1(iv)
GL/ISPE 9.08-9.10

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

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

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

	Claim wording	Excluded from patentability according to Art. 53(c) EPC
a	compound X for use as a medicament	NO
b	compound X for use in treating disease Y	NO
c	composition A containing X for use in treating disease Y (composition A may be generally defined)	NO
d	medicament containing compound X	NO

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

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

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

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

For claims of type (e), (f), (g) or (k), in the vast majority of cases, a search report is established on the basis of the alleged effects of the product/composition, because their subject-matter can readily and in a straightforward manner be understood in terms of these effects. For reasons of efficiency an opinion on novelty, inventive step and industrial applicability will be given for (at least) the independent claims, as far as

Rule 33.3(b)

relating to the alleged effects of the compound/composition, as would be done for an EP application. A reservation concerning patentability will be added, indicating that at the EPO claims directed to a method of treatment or the use of a composition in a treatment are exempted from patentability, but that a claim directed to a composition or substance for such use would be admissible.

In some cases, no search report can be established for claims of type (e), (f), (g) or (k), because their subject-matter cannot readily and in a straightforward manner be understood in terms of the alleged effects of the compound/composition. For these claims, no assessment under Art. 33(1), i.e. novelty, inventive step and industrial applicability, will be carried out.

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

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

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

Rule 39.1(iii)
OJ EPO 2007, 592

In particular, the EPO as ISA will not carry out an international search on an application to the extent that its subject-matter relates to no more than a method of doing business, in the absence of any apparent technical character.

Nevertheless, if the claimed subject-matter involves technical means, the EPO as ISA will consider the application and to the extent possible provide a search report for those parts of it which are more than mere business methods. However, to the extent that the technical means involved were widely available to everyone at the filing date, no documentary evidence is considered required because they are common knowledge, and no document will be cited in the ISR. Instead, a statement will be added that these technical means are considered so commonplace that no citation is considered necessary.

2.2.1 Computer -implemented business methods

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

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

Section B-VIII, 2.2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis* (see also B-VIII, 2.2).

3. No meaningful search possible

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

GL/ISPE 9.01
Art. 17(2)(a)
PCT Newsletter 10/2007, 7
Art. 17(2)(b)

The term "meaningful search" in Article 17(2)(a)(ii) should be read to include a search that within reason is complete enough to determine whether the claimed invention complies with the substantive requirements, that is, the novelty, inventive step, and industrial applicability requirements, and/or the sufficiency, support and clarity requirements of Articles 5 and 6. Accordingly, a finding of "no meaningful search" should be limited to exceptional situations in which no search at all is possible for a particular claim, for example where the description, the claims or the drawings are totally unclear. If all claims are found unsearchable, the EPO as ISA will establish a "Declaration of Non-Establishment of International Search Report" instead of an International Search Report and give reasons for the decision in that declaration and in the WO-ISA. To the extent that the description, the claims or the drawings can be sufficiently understood, even though parts of the application are not in compliance with the prescribed requirements, a search should be performed recognising that the non-compliance may have to be taken into account for determining the extent of the search. If only certain claims are found unsearchable, an ISR and a WO-ISA will be established in respect of the other claims. In that case the international search will be incomplete.

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

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

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

(i) claims lacking support; insufficient disclosure

Art. 5 and 6

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

(ii) claims lacking conciseness

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

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

Rule 6.4(a)
GL/ISPE 9.41

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

(iii) claims lacking clarity

GL/ISPE 9.22

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

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

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

3.2 Nucleotide and amino acid sequences

Rule 5.2, 13ter.1
OJ EPO 2011, 372
OJ EPO 2021, A96
OJ EPO 2021, A97
OJ EPO 2022, A60
OJ EPO 2024, A54, A55
GL/ISPE 9.39
GL/ISPE 15.14A

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

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

The examiner when performing the search will either:

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

or

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

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

3.3 Informal clarification

GL/ISPE 9.34, 9.35
OJ EPO 2011, 327

Where the description, claims or drawings fail to comply with a requirement, such as clarity or support of the claims by the description, to such an extent that no meaningful search can be made, the examiner, before taking a decision under Article 17(2)(a)(ii) PCT, ~~the examiner~~ may informally contact the applicant in accordance with paragraphs GL/ISPE 9.34 and GL/ISPE 9.35 to clarify specific aspects of the application before the search is carried out. Such informal clarification may help the examiner to focus the search better. It is highly recommended to invite the applicant to provide such informal clarification before issuing an incomplete ISR or a declaration of no search. However, there is no legal obligation on the examiner to use it and no legal consequences in the PCT if the applicant does not respond. An incomplete search report or a declaration of no search may still be issued without prior clarification.

Informal clarification may take the form of a telephone consultation or of a written request (Form PCT/ISA/207). In both cases the applicant can be given a short time limit (normally two weeks) to respond.

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

3.3.1 Informal clarification by telephone

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

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

OJ EPO 2023, A15 The EPO no longer issues urgent notifications by fax. The minutes of a telephone consultation will therefore no longer be communicated by this means.

3.3.2 Informal clarification by written request

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

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

OJ EPO 2023, A15 The EPO no longer issues urgent notifications by fax. An informal written request for clarification will therefore no longer be communicated by this means.

3.4 Reply to the invitation for informal clarification

3.4.1 Failure to reply in time or no reply

OJ EPO 2011, 327 If the applicant does not reply within the set time limit to the invitation for informal clarification, the examiner will prepare the search report and WO-ISA to the extent possible without the requested clarification.

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

3.4.2 Reply in time

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

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

Art. 17(2)(b) Generally, a restriction of the search will not always be indicated in the international search report. Rather the extent of the search as well as the

reasons for the restriction will in many cases only be indicated in the WO-ISA, as explained below. The opinion given is normally restricted to what has actually been searched.

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

If only some of the claims and/or parts of the claims can be searched and it is not possible, on the basis of the description, to foresee a likely fallback position for the unsearched subject-matter, even taking any reply from the applicant into consideration, a precise indication of what has been searched with the corresponding claims, together with full reasoning why the search was restricted, are entered into both the ISR and the WO-ISA. In addition, in the WO-ISA an opinion as to novelty, inventive step and industrial applicability of the searched subject-matter must be given. *Art. 17(2)(b)*

If some claims or parts of claims cannot be searched but it is possible, on the basis of the description, to foresee a searchable fallback position, taking any possible reply from the applicant into consideration, the ISR will be filled out as for a complete search in respect of those claims. An indication which claims have been searched (in part), together with full reasoning why the search was restricted, and a precise indication of what has been searched are entered into the WO-ISA. In the ISR the cited documents will relate to the searched (or partially searched) claims only. In addition, in the WO-ISA an opinion as to novelty, inventive step and industrial applicability of the searched subject-matter must be given.

If, even taking any reply from the applicant into consideration, it is not possible to perform a search at all, a declaration of no search, together with full reasoning why, is issued instead of the ISR. The WO-ISA must contain full reasoning why the search is not possible. *Art. 17(2)(a)(ii)*

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

3.6 Combination of an incomplete search and lack of unity

The requirements of unity of invention and the requirements of Art. 17(2)(a)(ii) are separate requirements. However, it is possible that an application both violates the requirements of clarity, disclosure, support or conciseness to such an extent that a meaningful search cannot be carried out, and lacks unity. In that case, the examiner can combine an incomplete search and a finding of non-unity. However, the applicant should not be invited to pay additional fees for subject-matter which will later not be searched under Art. 17(2)(a)(ii). Typically, a non-unity objection could be made first and then an incomplete search applied to the searched invention. In such a case the examiner may send an informal clarification request for the first invention only and include in the invitation to pay additional fees remarks on clarity problems related to further inventions. *Rule 13* *Art. 17(2)(a)(ii)*

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

4. Multiple independent claims per category

GL/ISPE 5.13-5.14

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

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

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

Chapter IX – Search documentation

1. General

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

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

1.2 Systematic access systems

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

2. Patent documents arranged for systematic access

2.1 PCT minimum documentation

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

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

2.2 Unpublished patent applications

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

2.3 Search reports

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

2.4 Patent family system

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

3. Non-patent literature arranged for systematic access

3.1 Periodicals, records, reports, books, etc.

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

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

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

Chapter X – Search report

1. General

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

(i) a declaration issued instead of the search report according to Art. 17(2)(a) (see ~~GL/PCT-EPO~~ B-VIII);

(ii) an incomplete search report according to Art. 17(2)(b) (see ~~GL/PCT-EPO~~ B-VIII);

(iii) a partial international search report due to a finding of a lack of unity according to Art. 17(3)(a) and Rule 13; and

(iv) an incomplete search report due to missing sequence listings (see ~~GL/PCT-EPO~~ B-VIII, 3.2).

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

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

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

Rule 43.9
GL/ISPE 16.07

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

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

(i) international search reports under the PCT; *Art. 16(1)*

(ii) international-type search reports. For details, reference is made to ~~GL/EPO~~ EPC Guidelines B-II, 4.5. *Art. 15(5)*, *GL/ISPE 2.22*, *16.04*

3. Form and language of the search report

3.1 Form

See ISPE Guidelines 16.08 and 16.09. *Rule 43.10*

3.2 Language

See ISPE Guidelines 16.11. *Rule 43.4*

3.3 Account of the search

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

3.4 Record of search strategy

OJ EPO 2017, A106

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

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

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

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

5. Classification of the patent application

Rule 43.3(a)
GL/ISPE 16.52

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

6. Areas of technology searched

GL/ISPE 16.53

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

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

Rule 44.2
GL/ISPE 16.33

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

Rule 8.1, *Rule 38*
GL/ISPE 16.39-16.47

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

Rule 37
GL/ISPE 16.35-16.38

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

Rule 8.2
GL/ISPE 16.48-16.51

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

GL/ISPE 15.40

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

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

8. Restriction of the subject of the search

In the following cases, the international search report, the declaration issued instead of the search report under Art. 17(2)(a), or the incomplete or partial search report will indicate whether the subject of the search was restricted and which claims have or have not been searched: *GL/ISPE 16.19 GL/ISPE 16.28-16.32*

(i) lack of unity of invention (see ~~GL/PCT-EPO~~ B-VII). *Art. 17(3)(a) Rule 13*

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

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

(a) A declaration that a meaningful search has not been possible on the basis of all claims is issued instead of the search report; or *Art. 17(2)(a)*

(b) If a meaningful search has not been possible for one or more of the claims in part or in full, the claims concerned are mentioned in the incomplete search report and/or in the written opinion. *Art. 17(2)(b)*

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

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

(iii) missing sequence listings (see ~~GL/PCT-EPO~~ B-VIII, 3.2). *Rule 5.2, 13ter.1*

9. Documents noted in the search

9.1 Identification of documents in the search report

9.1.1 Bibliographic elements

Section B-X, 9.1.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *GL/ISPE 16.78*

9.1.2 "Corresponding documents"

Section B-X, 9.1.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *Rule 33.1 GL/ISPE 16.64(a)*

9.1.3 Languages of the documents cited

Section B-X, 9.1.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*. *GL/ISPE 15.69, 15.72*

9.2 Categories of documents (X, Y, P, A, D, etc.)

PCT AI 505, 507
GL/ISPE 16.65

Section B-X, 9.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.1 Particularly relevant documents

GL/ISPE 16.66-16.68

Section B-X, 9.2.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.2 Documents defining the state of the art and not prejudicing novelty or inventive step

GL/ISPE 16.69

Section B-X, 9.2.2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.3 Documents which refer to a non-written disclosure

GL/ISPE 16.70

Section B-X, 9.2.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.4 Use of "P" documents in the search report

Rule 33.1(c)
GL/ISPE 11.07

Although "P" documents are normally not used for the further examination they should be indicated in the search report since they might become pertinent at a later national stage. The EPO as ISA also cites non-patent literature P-X documents in the search report. If the priority document is not available to the examiner at the time of the search, it will be assumed that the priority is valid for the purpose of establishing the search report and written opinion. For the relevant dates for conducting the search, see ~~GL/PCT-EPO~~ B-VI, 3.

GL/ISPE 16.71

Furthermore, section B-X, 9.2.4 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.5 Documents relating to the theory or principle underlying the invention

GL/ISPE 16.72

Section B-X, 9.2.5 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.6 Potentially conflicting patent documents

GL/ISPE 16.73

Section B-X, 9.2.6 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.2.7 Documents cited in the application

See GL/ISPE 16.74.

9.2.8 Documents cited for other reasons

GL/ISPE 16.75
GL/ISPE 11.10

Section B-X, 9.2.8 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.3 Relationship between documents and claims

GL/ISPE 16.77

Section B-X, 9.3 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

9.4 Identification of relevant passages in prior-art documents

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

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

10. Authentication and dates

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

Rule 43.2, 43.8
GL/ISPE 16.83-16.84

11. Copies to be attached to the search report

11.1 General remarks

One copy of the international search report is sent to the IB and one to the applicant. Copies of all the cited documents are made available to the applicant as described below ~~The latter is accompanied by copies of all documents cited~~, except those documents appearing in the search report after the "&" sign ~~symbol~~ which are not designated for copying and communication to the applicant (see ~~GL/EPO~~ EPC Guidelines B-X, 11.3). MyEPO Portfolio users receive all cited documents electronically in their Mailbox. Applicants that have not opted for electronic notification via Mailbox only receive paper copies of non-patent literature and translations of cited patent literature by post, with digital copies of cited patent literature documents available in Espacenet (*espacenet.com*).

Rule 44.1 and 44.3
GL/ISPE 16.86
OJ EPO 2024, A68

11.2 Electronic version of document cited

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

11.3 Patent family members; the "&" sign

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

11.4 Reviews or books

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

11.5 Summaries, extracts or abstracts

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

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

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

12. Transmittal of the search report and written opinion

The EPO forwards one copy of the search report or the declaration under Art. 17(2)(a) and of the written opinion to the IB and one copy to the applicant. Copies of all the cited documents are made available to the applicant ~~The applicant also receives copies of all cited documents~~ (see ~~GL/EPO~~ EPC Guidelines B-X, 12 and B-X, 11.1), including ~~automated~~ machine translations annexed to the written opinion (when appropriate,

Rule 44
GL/ISPE 16.86
OJ EPO 2024, A68

see ~~GL/EPO~~ EPC Guidelines B-X, 9.1.3) and those documents appearing after the "&" sign and designated to be copied and sent to the applicant (see ~~GL/EPO~~ EPC Guidelines B-X, 11.3).

Chapter XI – The written opinion

1. The written opinion

Under Chapter I, at the same time as establishing the search report the search examiner must establish the written opinion of the ISA (WO-ISA) to be sent to the applicant together with the search report. The WO-ISA gives a preliminary and non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. When appropriate, an opinion will also be given on added subject-matter, unity, insufficient disclosure and clarity or support issues, as well as formal defects.

Rule 43bis
GL/ISPE 17

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

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

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

Art. 21(3)
GL/ISPE 2.17

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

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

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

GL/ISPE 17.13

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

Rule 26
Rule 91.1
GL/ISPE 17.16

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

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

Rule 20.5
GL/ISPE 15.11

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

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

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

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

(a) the RO notifies it of the correct element(s) and/or part(s) before the start of the search; or

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

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

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

2.2 Applications filed in Dutch

See A-VII, 3.2.

~~*Rules 12.4, 43.4, 48.3*~~
~~*Agreement EPO-WIPO, Annex A(i)*~~
~~*OJ EPO 2017, A115*~~
~~*OJ EPO 2018, A17*~~
~~*OJ EPO 2018, A24*~~

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

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

~~Netherlands patent office as RO. The EPO as ISA will establish the ISR and WO-ISA in that language if it is already known at the time of carrying out the international search; otherwise they will be in the language of the request form, i.e. English, French or German. See also PCT Applicant's Guide, International Phase, Annex C, NL.~~

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

3.1 The search division's dossier

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

3.2 Reasoned objections

3.2.1 Opinion on novelty, inventive step and industrial applicability

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

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

3.2.2 Multiple independent claims

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

GL/ISPE 5.13 and 5.14

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

3.2.3 Dependent claims – WO-ISA

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

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

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

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

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

3.3 Making suggestions

GL/ISPE 3.05, 17.71

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

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

3.4 Positive or negative WO-ISA

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

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

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

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

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

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

4. Priority claim and the WO-ISA

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

GL/ISPE 17.28-17.29

4.1 Restoration of priority

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

Rule 26bis.3

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

4.2 Use of "P" documents in the written opinion

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

GL/ISPE 17.29(b)

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

GL/ISPE 17.29(c)

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

4.3 Use of "E" documents in the written opinion

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

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

5. Unity in relation to the written opinion

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

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

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

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

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

7. Sequence listings

Rule 5.2
Rule 13ter.1(a)
OJ EPO 2011, 372
OJ EPO 2021, A96
OJ EPO 2021, A97
OJ EPO 2022, A60
OJ EPO 2024, A54, A55
GL/ISPE 9.39, 15.12 and 15.14A

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

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

Art. 19
Rule 46
PCT Newsletter 10/2004, 7
6/2010, 8

There is no possibility for any form of dialogue between the applicant and the ISA on the content of the ISR and/or the WO-ISA. However, the applicant has the right to submit to the IB amendments to the claims pursuant to Article 19 PCT, as well as informal written comments on the WO-ISA. Moreover, the applicant may consider filing a demand for international preliminary examination under Chapter II PCT. See ISPE Guidelines 2.15.

If the international application subsequently enters the European phase, the applicant is required to respond to the WO-ISA or SISR prepared by the EPO or, where applicable, to the IPER prepared by the EPO as IPEA (see EPC Guidelines E-IX, 3.2 and EPC Guidelines E-IX, 3.3). ~~obliged to reply to any negative WO-ISA or IPER.~~

Chapter XII – Supplementary international search (SIS)

1. General

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

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

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

2. Time limits

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

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

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

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

Where applicable, the applicant must, together with the SIS request, also furnish to the IB a copy of the sequence listing in an electronic format complying with the standard provided for in Annex C to the Administrative Instructions. The EPO will start the supplementary international search only upon receipt of that copy. If it is not received, the EPO will invite the applicant to furnish an electronic copy of the sequence listing complying with that annex and to pay a late furnishing fee.

Rules 13ter, 45bis.5
Agreement EPO-WIPO, Annex B
OJ 2013, 542
OJ 2017, A115
OJ 2018, A24
OJ 2020, A35
OJ 2023, A37

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

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

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

3. Basis for the search

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

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

In cases where the international application was corrected by the RO under Rule 20.5*bis*, the EPO as SISA will carry out the supplementary

international search on the basis of the international application including the pages submitted later and containing the correct element or part. This is the version that will have been searched by the main ISA.

4. Scope of the search

GL/ISPE 15.93

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

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

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

GL/ISPE 15.87

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

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

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

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

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

6. Filling out the search report

GL/ISPE 15.96

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

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

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

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

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

No separate WO-ISA is established for a SIS. Instead, only a free-text sheet is used, and this will contain the same information as the separate

sheet that is part of the WO-ISA in the form of "explanations". Upon entry into the European phase, the applicant is obliged to respond to these explanations, as set out in Rule 161(1) EPC. A positive conclusion must be reasoned in the same way as in a WO-ISA/IPER.

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

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

An example would be that of a document cited in the ISR which could be used as a Y document for inventive step for some dependent claims in the Scope Annex. In this case it might be necessary to cite the document again in the SISR as a Y document for those claims if this was not already indicated in the main ISR (see also ~~GL/PCT-EPO~~ B-XII, 6), and to provide argumentation in the Scope Annex.

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

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

(i) if the examiner agrees with the categories (X, Y) given in the ISR for these documents, it is not necessary to cite the documents again in the SISR. The examiner will then use the documents cited in the ISR to raise objections of lack of novelty and/or inventive step. If the WO-ISA from the main ISA has raised the same objections, and the examiner agrees with the given reasoning, a mere reference to the objections raised in the WO-ISA from the main ISA will suffice.

(ii) if the examiner does not agree with some or all of the categories (X, Y, A) given in the ISR for any such documents considered pertinent and upon which the examiner wishes to base the objections in the Scope Annex, such documents will be cited again in the SISR.

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

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

8. Validity of priority and E/P documents

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

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

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

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

9. Copies of documents cited in the SISR

OJ EPO 2010, 316
GL/ISPE 15.97
OJ EPO 2024, A68

Copies of all the cited documents are made available to the applicant. MyEPO Portfolio users receive all cited documents electronically in their Mailbox. Applicants who/that have not opted for electronic notification via Mailbox only receive paper copies of non-patent literature and translations of cited patent literature by post, with digital copies of cited patent literature documents available in Espacenet (*espacenet.com*).

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

10. Non-unity

10.1 General procedure

Rule 45bis.6
GL/ISPE 15.89-15.90

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

Rule 45bis.1(d)

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

Rule 45bis.6(b)

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

Rule 45bis.6(c)

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

10.2 Deciding what is to be considered the main invention

The main invention will normally be the invention first mentioned in the claims. However, the examiner will exercise due discretion in selecting the invention to be searched where the first mentioned invention is one for which no search report would be established, or else where the applicant has requested that the supplementary search should be limited to one of the inventions other than the first identified by the ISA responsible for the main international search. For details, see ~~GL/PCT-EPO~~ B-XII, 10.3.

10.3 The main ISA found that unity of invention is lacking

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

If the examiner forms a different point of view, or agrees with a revised view on unity of invention in a decision relating to a protest before the ISA, the reasoning will be set out in full so that it is easily understood by both the applicant and third parties. No reasons need be given why the lack-of-unity objection raised in the ISR could not be followed.

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

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

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

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

10.4 Review procedure

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

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

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

Similar to the protest procedure, a Review Panel is established consisting of the examiner responsible for the file, an examiner as chairperson of the

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

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

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

If the Review Panel considers that the objection is completely or partially justified, it will communicate this to the applicant with Form 503. In these cases, reasoning must be given indicating why the objection is (at least partially) upheld. This reasoning should also address the applicant's relevant arguments. The review fee will not be reimbursed. In the case of an only partially justified lack-of-unity objection, a corrected search report taking the result of the review into account must be established.

11. Combination of SIS and Chapter II

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

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

GL/ISPE 17.04

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

PCT – Part C

Guidelines for Procedural Aspects in Chapter II

Contents

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~~ Art. 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 and any further document relating to the Chapter II procedure (e.g. amendments and/or arguments filed under Article 34 PCT) 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. The EPO filing offices are in the Central European Time (CET) zone i.e. UTC +1, and Central European Summer Time (CEST) zone i.e. UTC +2. CEST starts on the last Sunday in March and ends on the last Sunday in October. For emergency situations, including the rare cases of unavailability of the standard EPO filing tools, the EPO Contingency Upload Service is available for filing the demand with the EPO as IPEA. *Art. 31(6)(a)* ~~*OJ EPO 2014, A71*~~ ~~*OJ EPO 2016, A78*~~ *OJ EPO 2018, A25, A45* *OJ EPO 2024, A41, A42* *Rule 92.4(e), (g)* *OJ EPO 2007, Spec. ed. 3, A.3 (Art. 3 and 7 of the Decision)*

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.~~

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 (see C-II, 1.1 and 1.1.1).

1.1 Time limit for filing the demand

Pursuant to Rule 54*bis* PCT, the demand may be validly submitted at any time prior to the expiry of the following time limits, whichever expires later: *Rule 54bis.1(a)*

– three months from the date of transmittal to the applicant of the ISR and WO-ISA by the ISA or

– 22 months from the (earliest) priority date.

This time limit guarantees that applicants have at least three months from the date of mailing of the ISR to decide on the basis of the results of the international search laid down in the ISR and the WO-ISA whether they want to file a demand with amendments and/or arguments.

Rule 54bis.1(b)

If the demand is submitted after expiry of this time limit, the demand is considered to have not been submitted.

Possibilities to withdraw a demand and obtain a refund of the fees paid are limited (see A-III, 9.6 and 9.7, respectively).

1.1.1 Time limit for filing a demand to delay national phase entry

Most contracting states apply Article 22 PCT as amended with effect from 1 April 2002. For these states, the 30/31-month time limit for entry into the national/regional phase applies regardless of whether the applicant has submitted the demand for international preliminary examination within 19 months of the (earliest) priority date.

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

The EPO too applies Article 22 PCT as amended with effect from 1 April 2002. Therefore, the time limit for entry into the European phase is always 31 months from the priority date, irrespective of whether a demand has been filed or not.

PCT Newsletter 2/2005, 6

However, in respect of a small number of designated Offices, the former wording of Article 22(1) PCT still applies. The list of contracting states for which it is still applicable is published on the WIPO website. According to the latest information from WIPO (status on 1 January 2024), the 20/21-month time limit applies to the following states: Luxembourg (LU) and United Republic of Tanzania (TZ). However, in respect of the regional designation of each of these states, the time limit under amended Article 22 PCT applies.

Therefore, if an applicant wants to enter the national phase for these states, the demand must be received by the competent IPEA within 19 months of the (earliest) priority date to secure the right to entry into the national phase being delayed until expiry of 30/31 months from the priority date.

Moreover, for these states, the applicant must respect the 19-month time limit even where the ISR and the WO-ISA are not yet available. In other words, a delay in the international search does not bring about a change in the 19-month time limit, since this time limit is exclusively calculated on the basis of the (earliest) priority date.

For states applying Article 22(1) PCT in its former wording, a demand filed with the EPO after expiry of 19 months from the priority date but prior to

– three months from the date of transmittal to the applicant of the ISR and the written opinion (WO-ISA) by the ISA or

– 22 months from the (earliest) priority date

is valid, but does not have the effect of postponing commencement of the national phase to 30/31 months from the priority date for the states in question.

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).~~

The EPO may only act as an IPEA if the receiving Office with which the international application has been filed has specified the EPO as IPEA. The same countries which have not (yet) specified the EPO as ISA have not (yet) specified the EPO as IPEA (see B-II, 1.1). Up-to-date information is available in the annexes to the WIPO PCT Guide (see General Part I, 2.3 and 2.4, respectively).

Agreement EPO-WIPO, Art. 3(2), (3)
OJ EPO 2017, A115
OJ EPO 2018, A24
OJ EPO 2020, A35
OJ EPO 2022, A37
OJ EPO 2023, A37

Where the international application has been filed with the IB, the EPO is competent as IPEA if the international application could have been filed with a receiving Office which has specified the EPO as IPEA.

In addition, as a further requirement, the EPO is competent to act as IPEA only if the international search has been 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).

Nationals or residents of the USA filing an international application with the USPTO or the IB as receiving Office on or after 1 January 2015 can select the EPO as IPEA, irrespective of the technical field in which the application is classified. However, the EPO is not required to carry out an international preliminary examination on an application if its subject-matter is a method of doing business (OJ EPO 2007, 592).

Art. 34(4)(a)(i)
Rule 67.1
OJ EPO 2017, A115
OJ EPO 2018, A24
OJ EPO 2020, A35
OJ EPO 2022, A37
OJ EPO 2023, A37

If the EPO acts as IPEA, there is a reduction of 75% of the examination fee in the European phase.

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

Art. 31(2)
Rule 54
Rule 90

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). They may also appoint an agent to represent them specifically before the EPO as IPEA under Rule 90.1(c). Moreover, the agent appointed for the international phase may under Rule 90.1(d) appoint a sub-agent to represent the applicant specifically before the EPO as IPEA.

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. 31(4)
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 for a national and, where possible a regional, patent at the same time. If, after filing the PCT request, the applicant has validly withdrawn a designation, the filing of the demand cannot constitute the election of that state.

7. Signature

Rules 53.2(b), 53.8, 60.1(a-ter), 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. If the signature of one or more applicants is missing, the EPO as IPEA will not invite the applicant(s) to furnish the missing signature(s) provided that at least one of the applicants has signed the demand.

Rules 90.4, 90.5
OJ EPO 2010, 335

Where the demand is signed by a (common) agent, the EPO as IPEA will not invite the applicant(s) to file a (separate) power of attorney or a copy of a general power of attorney since the EPO has waived these requirements (see A-VIII, 1.13).

8. Basis for international preliminary examination

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).

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

Applicants must indicate in Box No. IV of the demand form (PCT/IPEA/401) 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.

Rule 66

If amendments under Article 19 are to be taken into account, the applicant must enclose a copy of these with the demand (see C-VI, 1).

Amendments and/or arguments filed under Article 34 PCT should preferably be filed together with the demand. Furthermore, as the EPO will start the preliminary examination as soon as it is in possession of all the elements listed in Rule 69.1(a) PCT (see C-VI, 1), applicants who want to make amendments but are not ready to file them at the same time as the demand should always indicate this by selecting the appropriate checkbox or checkboxes in Box No. IV, item 1, of the PCT demand form (PCT/IPEA/401). Otherwise, the EPO will start the international preliminary examination on the basis of the application as filed. Subsequently filed amendments and/or arguments will only be taken into account by the EPO as IPEA if they are received before the point at which preparation of a written opinion or the IPER has actually started (see C-IV, 3). Moreover, if a second written opinion is established, subsequently filed amendments and/or arguments will be taken into account together with the second written opinion. Amendments and/or arguments not taken into account by the EPO as IPEA may be (re)filed with the elected Offices upon entry into the national phase.

Rule 66.1(b), (c), (d)
Rule 66.4bis

The EPO acting as IPEA does not accept claims in the form of auxiliary requests, since this is not provided for under the PCT (see C-IX, 2).

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

Rule 60.1

Where there is more than one applicant, failure to provide the required indications and/or the signatures of all the applicants will not result in an invitation being issued, as long as the required indications are available in respect of one of the applicants entitled to file a demand and the demand is signed by one of them (see C-II, 7).

11. Payment and refund of fees

Rules 57 and 58
GL/ISPE 22.42-22.48

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 ~~. See GL/PCT-EPO~~ A-III, 7.1 and 7.2).

WIPO PCT Guide 10.047

The EPO cannot commence international preliminary examination before these fees have been paid. Late payment thus reduces the amount of time available for establishment of the IPER (see A-III, 7.5).

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

Rules 61.1 and 90bis.4(a)

The transmission of the demand to the International Bureau should be effected not later than one month after receipt of the demand.

13. Language requirements

See A-VII.

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

1. Substitute sheets and rectified sheets

Rule 26
Rule 91.1
GL/ISPE 17.16

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).

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

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

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.

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~~ EPC Guidelines C-III, 1.3, and ~~GL/EPO~~ EPC Guidelines E-IX, 2.9.4, for the effect on the European phase.

3. Amended sheets

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

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.

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

A second written opinion will be issued on condition that the applicant files in due time a substantive reply either to the WO-ISA established by the EPO or to the first written opinion established by the EPO as IPEA. Thus, before issuing a "negative" IPER, the EPO as IPEA will, as a rule, issue a second written opinion, thereby providing the applicant with a further opportunity to submit amendments and/or arguments to overcome any objections raised therein. A request for a second written opinion need not be filed.

OJ EPO 2011, 532

1.1 Subject-matter which the IPEA is not required to examine

The EPO as IPEA will not perform an international preliminary examination on any claim for which no international search was performed. In this context it is not relevant whether the applicant files amendments and/or arguments that, allegedly, overcome the reasons for the decision of the ISA not to search the claims concerned (see C-IV, 4).

Art. 17(2)(a)
Rules 66.1(e), 66.2(a)(vi)

Furthermore, the EPO as IPEA will use its discretion not to carry out preliminary examination if the application relates to subject-matter listed in Rule 67 PCT to the extent that such subject-matter is not regarded as an invention or susceptible of industrial application or is excluded from patentability under the provisions of the EPC (see B-VIII, 2).

Art. 34(4)
Agreement EPO-WIPO, Art. 4
OJ EPO 2017, A115
OJ EPO 2007, 592

Also, if the application fails to comply with the prescribed requirements to such an extent that no meaningful opinion can be formed on novelty, inventive step or industrial applicability, no preliminary opinion on these questions will be established.

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

2.1 Procedure when the EPO was not the ISA

Rules 66.1bis, 66.2, 66.4, 66.4bis
OJ EPO 2011, 532
GL/ISPE 3.19

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 (considered to be the first written opinion) with a time limit for the applicant to reply as laid down in Rule 66.2(d) (~~, which is~~ normally two months).

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.

Art. 34(2)(c)

If the EPO as IPEA has no objections to the (amended) application for which preliminary examination has been requested, it may issue the IPER immediately if it is in possession of the elements listed in Rule 69.1(a) PCT.

2.2 Procedure when the EPO was the ISA

Art. 33, 34, 35
Rules 66.1bis, 66.2-66.4
OJ EPO 2011, 532

A written opinion for the purposes of international preliminary examination is a notification issued by the IPEA which indicates any comments or objections concerning the international application. Pursuant to Rule 66.*1bis*(a) PCT, the WO-ISA is considered to be a (first) written opinion of the IPEA for the purposes of international preliminary examination. The EPO has notified the International Bureau under Rule 66.*1bis*(b) PCT that this provision is only applied by the EPO as IPEA to the extent that the WO-ISA has been established by the EPO acting as ISA.

OJ EPO 2011, 532

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.

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,

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. *Rule 66.2(d)*

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.

If the IPER has not yet been established, the examiner will take the SISR into account when establishing the IPER. *Rule 45bis.8(c)*

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 (but also see ~~however also GL/PCT-EPO~~ C-IV, 1).

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

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

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.

GL/ISPE 19.33

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.

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

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 (see ~~GL/PCT-EPO~~ B-X, 8) and/or in the WO-ISA (see ~~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. *Rule 66.1(e)*

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

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.

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. *Rule 66.1(e)*

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~~ EPC Guidelines 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~~ EPC Guidelines C-IV, 7.3).

5. Top-up searches in PCT Chapter II

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

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 top-up search is performed by the EPO as IPEA in order to reveal any further relevant prior-art documents, in particular intermediate prior art that has become public since the international search was performed and that could become relevant under Article 54(3) EPC if the application enters the regional phase before the EPO. The date – or absence – of this top-up search must be indicated in the IPER.

5.1 Timing, basis and forms

GL/ISPE 19.18

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.

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

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.

Rule 70.2(f)

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.

5.2 Exemptions from top-up search

GL/ISPE 19.15

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.

Rule 66.1ter

A top-up search is not conducted on:

Rule 66.1(e)

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

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:

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

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

(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).

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). *Rule 70.2(c)*

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

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 3.22*

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

(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 64.3*

(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. *Rule 64.1*

(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.

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Copies of all the cited documents are made available to the applicant. MyEPO Portfolio users receive all cited documents electronically in their Mailbox. Applicants who have not opted for electronic notification via Mailbox receive only paper copies of non-patent literature and translations of cited patent literature by post, with digital copies of cited patent literature documents available in Espacenet (*espacenet.com*).

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.

Rule 64.1

(b) pertinent prior art published before the priority date, a WO-IPEA or telephone minutes is/are issued (see ~~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.

Chapter V – Unity of invention

1. Unity of invention under Chapter II

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

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.

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.

Rule 66.1(e)

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.

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

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

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.

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

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

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).

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 54*bis*.1(a) has expired unless the applicant expressly requests it to do so.

Rule 66.1, Rule 66.4bis, Rule 69.1(a), Rule 54bis.1(a) GL/ISPE 19.07

Where the statement concerning amendments filed with the demand (Box No. IV, item 1, of the PCT demand form PCT/IPEA/401) 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 the applicant ~~it~~ to ~~do so~~ submit the amendments 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 IPER 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 (see C-IV, 2.2) 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 54*bis* 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.

Rule 66.2(e)

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 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. Thus, if the applicant files a request for consultation by telephone before a second written opinion is issued, the EPO as IPEA will comply with it;

Rule 66.6

(b) after a telephone consultation the applicant will be sent the minutes and should in general be given a time limit (normally two months) to file amended claims and/or arguments. In such a case, no second written opinion will be issued. 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~~ an ~~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~~ and/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

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

GL/ISPE 19.45

discussed as well as the date and time for the consultation. A copy of the arrangements recorded is sent to the applicant.

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~~ EPC Guidelines 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

Rules 5.2, 13ter.2, 66.1(e)
OJ EPO 2011, 372
OJ EPO 2013, 542
OJ EPO 2021, A96
OJ EPO 2021, A97
OJ EPO 2022, A60
OJ EPO 2024, A54, A55
GL/ISPE 9.39, 15.12, 15.13, ~~and~~ 17.37

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 13*ter*.1(a) and to pay the late furnishing fee under Rule 13*ter*.1(c) within a non-extendable period of one month from the date of the invitation.

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 13*ter*.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 13*ter*.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. In such cases no invitation to file a sequence listing is issued by the EPO as IPEA and applicants are advised not to file sequence listings at this late stage.

~~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 13*ter*.1(a) and to pay the late furnishing fee under Rule 13*ter*.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

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. *Rule 66.4bis*

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. *GL/ISPE 19.34*

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.

PCT – Part E

Guidelines on General Procedural Matters

Contents

Chapter I – Introduction

Part E contains guidelines for those procedural steps in respect of international applications which may occur at a number of stages in the procedure.

Chapter II – Observations by third parties

Third parties may, anonymously if so desired, file observations under the PCT which, unlike observations under the EPC, should exclusively refer to prior art relevant to the novelty and/or inventive step of the invention claimed in the international application.

AI 801-805 GL/ISPE 15.68, 16.57 and 17.69

The observations are to be submitted electronically to the IB using the online tool provided by WIPO between the date of international publication and 28 months from the priority date of the international application. They may be filed in any language of publication; the cited prior art may be in any language. For more details, see the guide entitled "ePCT Third Party Observations" published by WIPO.

Rule 48.3

The applicant is notified by the International Bureau (IB) of any such observations and may file comments within 30 months from the priority date.

The IB will promptly communicate any third-party observation and any comment by the applicant to the ISA, the SISA and the IPEA, unless the (supplementary) international search report or the international preliminary examination report (IPER) has already been received by the IB.

Promptly after the expiration of 30 months from the priority date, the third-party observation(s) and the applicant's comment(s) will be sent to all designated Offices and elected Offices. The EPO as designated/elected Office will consider a third-party observation filed during the international phase after entry into the European phase as to its contents once that observation becomes available to it. However, provided the examining division has assumed responsibility, the EPO will ~~only~~ make every effort to issue the next office action within three months of expiry of the period under Rule 161 EPC, but only on condition that the third party has clearly expressed its wish that such action be taken, and that the observation was substantiated and not filed anonymously. A third party wishing to achieve the above-mentioned result in the European phase should, therefore, make this clear in the observation or else file the observation with the EPO as designated/elected Office (see also ~~GL/EPO~~ EPC Guidelines E-VI, 3, last paragraph).

Any third-party observations/comments thereto will be made available for public inspection.

If the third-party observations and/or prior art are not in an official EPO language, the formalities officer at the EPO will invite the third party to submit a translation of the observations and/or the prior art in line with the European procedure (see ~~GL/EPO~~ EPC Guidelines E-VI, 3), but setting a shorter time limit within the boundaries of the required strict PCT deadlines. No invitation is issued if these deadlines cannot be respected or if the third-party observations were filed anonymously.

Art. 14(1) EPC

If the third-party observations and/or prior art are not in an official EPO language and a translation is not or cannot be filed, the examiner should

nevertheless take them into account to the extent that this is feasible, in particular when they seem to be *prima facie* relevant (e.g. from the drawings of the prior-art documents). The examiner may add a remark in the WO-ISA that a translation will be required to allow a detailed assessment of the document(s).

Even when third-party observations have been filed, the deadlines indicated for issuing the different office actions under the PCT should be respected in order to ensure timely issuance of the ISR, SISR or IPER.

For third-party observations received during Chapter I, see ~~GL/PCT-EPO~~ B-IV, 1.3. For third-party observations received during Chapter II, see ~~GL/PCT-EPO~~ C-VII, 3.

Chapter III – Patent Prosecution Highway (PPH)

1. General

The Patent Prosecution Highway (PPH) enables an applicant whose claims have been determined to be patentable/allowable to have a corresponding application which has been filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results.

~~OJ EPO 2022, A58 and OJ EPO 2022, A59~~

Currently, the EPO's PPH partner offices are:

OJ EPO 2016, A44

JPO (Japan)	OJ EPO 2022, A115
KIPO (South Korea)	OJ EPO 2022, A115
CNIPA (China)	OJ EPO 2022, A115
USPTO (USA)	OJ EPO 2022, A115
ILPO (Israel)	OJ EPO 2020, A125
CIPO (Canada)	OJ EPO 2020, A137
IMPI (Mexico)	OJ EPO 2020, A21
IPOS (Singapore)	OJ EPO 2020, A138
IPA (Australia)	OJ EPO 2022, A58
SIC (Colombia)	OJ EPO 2022, A88
MyIPO (Malaysia)	OJ EPO 2020, A82
IPOPHL (Philippines)	OJ EPO 2020, A83
INPI (Brazil)	OJ EPO 2024, A99
INDECOPI (Peru)	OJ EPO 2022, A116
SAIP (Saudi Arabia)	OJ EPO 2022, A59
INAPI (Chile)	OJ EPO 2024, A56
IPONZ (New Zealand)	OJ EPO 2024, A98

The PPH programmes with Rospatent (Russian Federation) and EAPO (Eurasia) have been suspended.

OJ EPO 2022, A44 and A45

Under the PPH (pilot) programme a PPH request can be based on:

(i) the latest PCT work product (WO-ISA or IPRP/IPER) established by one of the PPH partner offices as ISA or IPEA (PPH based on PCT work products) (except under the PPH (pilot) programme with INPI (Brazil)); or

(ii) any national work product (office action indicating patentable/allowable claims) established during the processing of a national application or of a PCT application that has entered the national phase before one of the PPH partner offices (PPH based on national work products).

2. PPH based on a WO-ISA established by the EPO as ISA

~~OJ EPO 2022, A58, A59, A88, A115, A116~~
~~OJ EPO 2020, A21, A82, A83, A125, A137, A138,~~
~~OJ EPO 2016, A44,~~
OJ EPO 2015, A93

Where the EPO is the ISA and the international application contains claims that are determined to be patentable/allowable by the EPO as ISA, the applicant may under the PPH (pilot) programme request accelerated examination at the EPO's PPH partner offices when the application has entered the national phase before these offices. The procedures and requirements for filing a request with the EPO's PPH partner offices are available from their respective websites.

Irrespective of the PPH (pilot) programme, any applicant may request accelerated examination under the PACE programme in the procedure before the EPO as designated Office at any time~~. See~~ (see ~~GL/EPO~~ EPC Guidelines E-VIII, 4.2).

3. PPH based on an IPER established by the EPO as IPEA

OJ EPO 2015, A93

Under the PPH (pilot) programme, a PPH request can also be based on an IPER established by the EPO as IPEA. The procedures and requirements for filing a request with the EPO's PPH partner offices are available from their respective websites.

Irrespective of the PPH (pilot) programme, any applicant may request accelerated examination under the PACE programme in the procedure before the EPO as elected Office at any time~~. See~~ (see ~~GL/EPO~~ EPC Guidelines E-VIII, 4.2).

Chapter IV – Time limits in the international phase

1. Computation of time limits in the international phase

If a time limit in any procedure in the international phase starts to run upon issue of a communication, the day of the date of that communication is decisive for computing the end of that time limit.

Rule 80.6
Rule 126 - 129, 131(2) EPC
PCT Newsletter 4/2021, 10

If an applicant proves to the satisfaction of the EPO as receiving Office, ISA, SISA or IPEA that the dispatch of a communication did not take place on the date that the document bears, the actual date of mailing will be taken as the basis for computing the applicable time limit. Furthermore, if a communication was received more than seven days after the date it bears, the applicable time limit will be extended by the number of days by which the communication was received later than seven days after the date it bears.

2. Excuse of delays in meeting time limits and extension of time limits in the international phase

In the case of a delay in meeting time limits in the international phase due to force majeure, the applicant or any interested party has to provide the EPO with evidence that a time limit fixed in the PCT Rules was not met due to war, revolution, civil disorder, strike, natural calamity, epidemic, a general unavailability of electronic communications services or other like reason in the locality where the interested party resides, has their place of business or is staying, and that the relevant action was taken as soon as reasonably possible. Any such evidence must be provided to the EPO no later than six months after the expiry of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the EPO, the delay in meeting the time limit will be excused.

Rule 82quater.1
PCT/AI, Section 111
WIPO PCT Guide 11.065, 11.065A

In the case of a delay in meeting time limits in the international phase due to the unavailability at the EPO of any of the permitted electronic means of communication or means of online payment, applicants may submit a request for excuse of the delay indicating that the time limit was not met due to the unavailability of one of the permitted electronic means of communication or means of online payment on a specific date. They are not required to submit evidence to the EPO. Reference to the notification from the EPO of unavailability of electronic means of communication as published by the International Bureau will be sufficient for the EPO to process the applicant's request. The applicants must, however, perform the relevant action on the next working day on which all permitted means of electronic filing or means of online payment are available. Applicants are informed without delay of the EPO's decision via Form PCT/RO/132.

Rule 82quater.2
PCT/AI, Section 111
WIPO PCT Guide 11.065B, 11.065C
Official Notices (PCT Gazette) – 26 November 2020, 254-255
PCT Newsletter 12/2020, 1
OJ EPO 2020, A120

The EPO may also establish a period of extension of time limits within which a party has to perform an action before the EPO when a state in which it is located is experiencing a general disruption caused by an event listed in Rule 82*quater*.1(a) PCT which affects its operations.

Rule 82quater.3

Rule 26bis.3
OJ EPO 2020, A120

The possibilities of excusing a delay due to force majeure or the unavailability of any of the permitted electronic means of communication or means of online payment and extending time limits provided for in Rules 82*quater*.1, 82*quater*.2 and 82*quater*.3 PCT only apply to time limits fixed in the PCT Rules. Therefore, they apply neither to the priority period pursuant to Article 8(2)(a) PCT in conjunction with Article 4C Paris Convention, nor to the time limit for entering the European phase in accordance with Articles 22 and 39 PCT. A right of priority may be restored only under strict conditions (see Rule 26*bis*.3 PCT and EPC Guidelines E-IX, 2.3.5.3). It is therefore recommended that any subsequent application be filed as early as possible.

Chapter V – External complaints

External complaints may concern any service or product delivered by the EPO, including all PCT products, and may be submitted by any person, including applicants (see EPC Guidelines E-VI, 4).

Chapter VI – Notification

In the international phase, the EPO notifies communications on paper or in electronic form.

Notification in electronic form may be effected to an activated EPO Mailbox, which can be accessed through MyEPO Portfolio. For further details, see EPC Guidelines E-II, 2.3. International agents and applicants who do not have their residence or principal place of business in an EPC contracting state but are entitled to act as representatives before the EPO in PCT international phase proceedings can set up a PCT Link to receive electronic notification via Mailbox of communications from the EPO in the international phase where it acts as ISA, SISA or IPEA.

OJ EPO 2024, A20, A21

Any interested applicant or agent can open an ePCT account and link their international applications to it. ePCT offers immediate online access to any document issued by the offices involved in the PCT procedure. Users can activate an automatic email notification service for newly added documents, although notifications issued via ePCT are at present a courtesy service and do not replace paper notifications. ePCT can also be used to submit documents to participating receiving Offices (including the EPO), participating Authorities (including the EPO as ISA and IPEA) and the IB (see A-II, 1.2.1).

OJ EPO 2014, A107

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. *Art. 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~~ EPC Guidelines 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~~ A-III, 4.2, A-IV, 3 and H-II, 2.2.3 ~~Euro-PCT Guide, points 2.24.001-2.24.007~~.

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~~ EPC Guidelines 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

GL/ISPE 5.45-5.51

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.

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.

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

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.

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

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

See ISPE Guidelines 4.12.

3. Insufficient disclosure

Art. 5

See ISPE Guidelines 4.13.

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 and availability of biological material

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

Rule 13bis
~~*Rule 13bis.2*~~
Rule 31-34 EPC
OJ EPO 2010, 498
~~*OJ EPO 2017, A60*~~
~~*OJ EPO 2017, A61*~~
PCT/AI Section 209
WIPO PCT Guide 11.075-11.087
PCT Newsletter 11/2014, 13

Under the PCT, the question as to whether a reference to deposited biological material must be included in an international application is left to the national law of the designated states. The PCT, however, prescribes the contents of a required reference and sets the time limit for providing such a reference.

Each designated Office decides whether a reference to biological material in accordance with the provisions of the PCT satisfies the requirements of its national law as to the content and the time limit for furnishing the reference. However, a national requirement may be added and become a PCT requirement upon notification to the IB. The EPO has made use of this possibility.

The EPO has notified the IB that the following additional matter should be indicated by an applicant wishing to enter the European phase:

Rule 13bis.4, 13bis.7
Rule 31(1)(d) EPC

To the extent available to the applicant, relevant information on the characteristics of the biological material should be mentioned in the application as filed, and where the biological material has not been deposited by (one of) the applicant(s) but by someone else, the name and address of the latter person (the depositor) must be stated in the international application. Moreover, a document must be submitted to the IB within 16 months from the priority date in which the depositor:

– has authorised the applicant to refer to the biological material and

– has given unreserved and irrevocable consent to the deposited material being made available to the public.

Such authorisation is, however, not required if the depositor's rights to the deposited material are transferred to the applicant by the filing date of the international application at the latest. In that case, the document containing the transfer must be submitted instead. For further information see Annex L to the WIPO PCT Guide.

If any requirement concerning a reference to biological material is not met within 16 months of the priority date of the application, this **cannot** be remedied in the procedure before the EPO as a designated Office, i.e. upon entry into the European phase. As a consequence, the international application may be refused for insufficient disclosure in the course of the examination proceedings before the EPO as designated/elected Office.

Details of deposited biological material which are not included in the description should be supplied on a separate form (PCT/RO/134) (Box No. IX, checkbox No. 7 in the PCT request form). This form must likewise be used if the applicant wishes samples to be made available only to an expert nominated by the requester.

The furnishing of samples of biological material by the EPO takes place in conformity with Rule 13bis PCT and Rule 33 EPC. As a consequence, if the requirements of Rule 33 EPC are met, requests for the furnishing of samples of biological material are certified by the EPO in its capacity as designated Office vis-à-vis third parties as from international publication in an EPO language, i.e. during the international phase. The EPO has notified the IB that if the applicant wishes the biological material to be made available only by the issue of a sample to an expert nominated by the requester, the applicant must inform the IB accordingly before completion of the technical preparations for publication of the international application, where such publication takes place in one of the EPO's official languages. If the international application was not published in an official language of the EPO, notification of the expert solution may be submitted until completion of the technical preparations for publication of the translation of this application by the EPO as designated/elected Office. The fact that this solution has been chosen will be published by WIPO on its

Rule 13bis.6
Rule 32(1), 33 EPC
OJ EPO 2010, 498
OJ EPO 2017, A60, A61
PCT Newsletter 7-8/2010, 6
11/2011, 5

PATENTSCOPE website and/or, if applicable, on the front page of the published translation of the application.

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)

Rule 20.5(e), 20.5bis(e)

The application may contain sheets stamped "Not to be considered (Rule 20.5(e), 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

GL/ISPE 4.12, 5.58

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.

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~~ EPC Guidelines 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, 4.20 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, 4.21 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~~ EPC Guidelines 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~~ EPC Guidelines 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~~ EPC Guidelines 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~~ EPC Guidelines 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~~ EPC Guidelines 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~~ EPC Guidelines 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 ~~EPO's~~ Enlarged Board of Appeal (see ~~GL/EPO~~ EPC Guidelines 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~~ EPC Guidelines 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 date 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 date 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 A-II, 1.3, A-III, 4.4 and A-VI, 1.7.

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

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.

PCT – Part G

Substantive requirements of the application

Contents

Chapter I – Patentability

1. General disclaimer

Under Art. 150(2) EPC, an international application filed under the PCT may be the subject of proceedings before the EPO. In such proceedings, the provisions of the PCT and its Regulations are applied, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT and its Regulations prevail.

The EPO, acting as ISA or IPEA, has established practice on how the examiner assesses novelty and inventive step. For most subject-matter this practice is identical to that used in proceedings for European patent applications. However, for some subject-matter the ISPE Guidelines deviate from the practice in European proceedings, and for other subject-matter they recognise that different offices adopt different approaches. As a result of Art. 150(2) EPC, the EPO as ISA/IPEA will, for the assessment of novelty and inventive step, generally apply the provisions of the PCT and, where these are not sufficient, will base its assessment on its established practice. In the latter case, these Guidelines then state that "the principles as laid down in the corresponding section in the Guidelines for Examination in the EPO apply *mutatis mutandis*."

It should be borne in mind that when an international application validly enters the regional phase before the EPO, it is considered as a European patent application. Consequently, the EPO will apply its criteria for examination as laid down in the Guidelines for Examination in the EPO for any subject-matter.

2. General remarks

The aim of the PCT is to allow the applicant to obtain a preliminary and non-binding opinion on the patentability of the claimed subject-matter before entering the regional phase. The PCT procedure cannot serve the purpose of granting a patent as is the case for example under the EPC.

Art. 33(1)
Rule 43bis.1(a)

Chapter II – Inventions

1. General remarks

The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable.

Art. 33(1)
Rule 43bis.1(a)

The PCT does not define what is meant by "invention", but Rules 39 and 67 contain a list of subject-matter for which the ISA or IPEA is not required to carry out an international search or an international preliminary examination, respectively (see also ~~GL/PCT-EPO~~ B-VIII, 2). The Agreement between the EPO and WIPO in relation to the functioning of the EPO as an International Authority under the PCT indicates the subject-matter which the EPO is not required to search or examine, and according to its Art. 4 and Annex C the discretion not to search or examine is exercised by the EPO as ISA and IPEA only to the extent that such subject-matter is not searched under the provisions of the EPC, specifically Art. 52(2), 52(3), 53(b) and 53(c) EPC.

Art. 34(4)(a)(i)
GL/ISPE 9.02-9.15
OJ EPO 2017, A115
OJ EPO 2018, A24

2. Examination practice

Section G-II, 2 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3. List of exclusions

See ISPE Guidelines 9.02 to ISPE Guidelines 9.15.

3.1 Discoveries

Rules 39.1 and 67.1 do not explicitly exclude an international search or international preliminary examination on discoveries from being carried out by the ISA or IPEA, respectively. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(a) and Art. 52(3) EPC. Section G-II, 3.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rules 39.1, 67.1
OJ EPO 2017, A115
OJ EPO 2018, A24

3.2 Scientific theories

See ISPE Guidelines 9.05. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(a) and Art. 52(3) EPC. Section G-II, 3.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 39.1(i),
Rule 67.1(i)
OJ EPO 2017, A115
OJ EPO 2018, A24

3.3 Mathematical theories

See ISPE Guidelines 9.05. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(a) and Art. 52(3) EPC. Section G-II, 3.3, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 39.1(i),
Rule 67.1(i)
OJ EPO 2017, A115
OJ EPO 2018, A24

3.4 Aesthetic creations

OJ EPO 2017, A115
OJ EPO 2018, A24

Rules 39.1 and 67.1 do not explicitly exclude an international search or international preliminary examination on aesthetic creations from being carried out by the ISA or IPEA, respectively. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(b) and Art. 52(3) EPC. Section G-II, 3.4, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.5 Schemes, rules and methods of doing business, performing purely mental acts or playing games

Rule 39.1(iii),
Rule 67.1(iii)
OJ EPO 2017, A115
OJ EPO 2018, A24

See ISPE Guidelines 9.07, ISPE Guidelines A9.07 and ISPE Guidelines A9.07[2]. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(c) and Art. 52(3) EPC. Section G-II, 3.5, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

3.6 Programs for computers

Rule 39.1(vi),
Rule 67.1(vi)
OJ EPO 2017, A115
OJ EPO 2018, A24

See ISPE Guidelines 9.15, ISPE Guidelines A9.15 and ISPE Guidelines A9.15[2]. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(c) and 52(3) EPC. Section G-II, 3.6, in the Guidelines for Examination in the EPO applies *mutatis mutandis* (see ~~cf. GL/PCT-EPO~~ PCT-EPO Guidelines B-VIII, 2.2).

3.7 Presentations of information

Rule 39.1(v),
Rule 67.1(v)
OJ EPO 2017, A115
OJ EPO 2018, A24

See ISPE Guidelines 9.11 to ISPE Guidelines 9.14. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(d) and Art. 52(3) EPC. Section G-II, 3.7, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4. Exceptions to patentability

4.1 Matter contrary to public order or morality

Art. 21(6)
Rule 9
PCT AG I 5.175
OJ EPO 2017, A115
OJ EPO 2018, A24

Unlike the EPC, the PCT does not explicitly rule out the patentability of subject-matter for reasons of public order or morality. However, according to Rule 9, the application must not contain any expressions contrary to public order or morality, and under the Agreement between the EPO and WIPO the EPO may exclude matter which would be excluded under Art. 53(a) EPC. Generally, no search or preliminary examination is carried out on such matter by the EPO as ISA/IPEA. Section G-II, 4.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.2 Surgery, therapy and diagnostic methods

Rule 39.1(iv),
Rule 67.1(iv)
OJ EPO 2017, A115
OJ EPO 2018, A24

See ISPE Guidelines 9.08-9.10. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 53(c) EPC. Generally, no search or preliminary examination is carried out on such matter by the EPO as ISA/IPEA. Section G-II, 4.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5. Exclusions and exceptions for biotechnological inventions

5.1 General remarks and definitions

"Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

Rule 39.1(ii),
Rule 67.1(ii)
OJ EPO 2017, A115
OJ EPO 2018, A24

5.2 Biotechnological inventions

See ISPE Guidelines 9.06. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 53(b) EPC. Generally, no search or preliminary examination is carried out on such matter by the EPO as ISA/IPEA. Section G-II, 5.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

OJ EPO 2017, A115
OJ EPO 2018, A24

5.3 Exceptions

The PCT, unlike the EPC, does not explicitly exclude carrying out an international search or an international preliminary examination on specific subject-matter related to biotechnological inventions. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 53 EPC. Generally, no search or preliminary examination is carried out on such matter by the EPO as ISA/IPEA. Section G-II, 5.3, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

OJ EPO 2017, A115
OJ EPO 2018, A24

5.4 Plant and animal varieties, essentially biological processes for the production of plants or animals

See ISPE Guidelines 9.06. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 53(b) EPC. Generally, no search or preliminary examination is carried out on such matter by the EPO as ISA/IPEA. Section G-II, 5.4 and subsections, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 39.1(ii),
Rule 67.1(ii)
OJ EPO 2017, A115
OJ EPO 2018, A24

5.5 Microbiological processes

See ISPE Guidelines 9.06. ~~GL/EPO~~ EPC Guidelines G-II, 5.5, applies *mutatis mutandis*.

Rule 39.1(ii),
Rule 67.1(ii)
OJ EPO 2017, A115
OJ EPO 2018, A24

Chapter III – Industrial application

1. General remarks

See ISPE Guidelines 14.01 to ISPE Guidelines 14.03. *Art. 33(4)*

2. Methodology

See ISPE Guidelines 14.04 to ISPE Guidelines 14.06.

3. Industrial applicability

See ISPE Guidelines A14.01[2].1.

Chapter IV – Prior art

1. General remarks and definition

An invention is to be "considered novel if it is not anticipated by the prior art". The "prior art shall consist of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date". The scope of this definition should be noted. There are no restrictions whatsoever as to the geographical location where or the language in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information.

Art. 33(2), (3)
Rules 33.1(a), (b)
Rule 64.1

See also ISPE Guidelines 11.01 and ISPE Guidelines 11.12.

The principles to be applied in determining whether other kinds of prior art, e.g. relating to use (which could be introduced e.g. by a third party, see ~~GL/PCT-EPO~~ E-II, ISPE Guidelines 16.57 and PCT/AI section 801), have been made available to the public are governed by Rules 33.1(b) and 64.2. See G-IV, 6, for non-written disclosures that can be considered to be "print equivalent" or that are otherwise captured in a way which allows them to be seen or copied by others.

For the examination of the novelty of claimed subject-matter, see ~~GL/PCT-EPO~~ G-VI.

Art. 33(2)

A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. For instance, German utility models ("Gebrauchsmuster") are already publicly available as of their date of entry in the Register of utility models ("Eintragungstag"), which precedes the date of announcement in the Patent Bulletin ("Bekanntmachung im Patentblatt").

2. Enabling disclosures

The principles as laid down in section G-IV, 2, in the Guidelines for Examination in the EPO apply *mutatis mutandis*.

3. Date of filing or priority date as effective date

It should be noted that for the purpose of international preliminary examination all prior art is taken into account which was publicly available before the international filing date or, where a priority has been validly claimed, before the date of priority. It should be remembered that different claims, or different alternatives claimed in one claim, may have different effective dates, i.e. the date of filing or (one of) the claimed priority date(s). The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives), and prior art in relation to one claim or one part of a claim may include matter, e.g. an

Rule 64.1(a), (b)
GL/ISPE 11.24-11.26

intermediate document (see ~~GL/PCT-EPO~~ B-X, 9.2.4), which cannot be cited against another claim or another alternative in the same claim because it has an earlier effective date.

Rule 20.5

If the applicant subsequently furnishes missing parts of the description, parts of the claims or all or parts of the drawings under Rule 20.5, the international filing date is the date on which the purported international application is completed by the furnishing of the missing parts, unless the missing parts are completely contained in the priority document and the requirements given in Rule 20.6 are satisfied, in which case the original filing date is maintained. The date of the application as a whole is thus either the date on which the missing parts are received or the original filing date (see ~~GL/PCT-EPO~~ C-III, 2, and ~~GL/PCT-EPO~~ H-II, 2.2.2).

Rule 20.5bis

If the applicant subsequently furnishes (a) correct element(s) (an element being the description or the claims) or correct parts of the description, parts of the claims or all or parts of the drawings under Rule 20.5*bis*, the international filing date is the date on which the purported international application is corrected by the furnishing of the correct elements or parts, unless the correct elements or parts are completely contained in the priority document and the requirements given in Rule 20.6 are satisfied, in which case the original filing date is maintained. The date of the application as a whole is thus either the date on which the correct elements or parts are received or the original filing date (see ~~GL/PCT-EPO~~ C-III, 2, and ~~GL/PCT-EPO~~ H-II, 2.2.2).

4. Documents in a non-official language of the (S)ISA or IPEA

Where applicants

(i) dispute the relevance of a document in a non-official language cited in the search report (for procedure at the search stage (~~,~~ see ~~GL/PCT-EPO~~ B-X, 9.1.2 and 9.1.3), and

(ii) give specific reasons,

examiners should consider whether, in the light of these reasons and of the other prior art available to them, they are justified in pursuing the matter. If so, they should obtain a translation of the document (or merely the relevant part of it if that can be easily identified). If they remain of the view that the document is relevant, they should send a copy of the translation to the applicant with the next communication in the PCT Chapter II phase.

4.1 Machine translations

In order to overcome the language barrier constituted by a document in an unfamiliar non-official language, it might be appropriate for the examiner to rely on a machine translation of the document, which should be sent to the applicant. If only part of the translated document is relevant, the particular passage relied upon should be identified. A translation has to serve the purpose of rendering the meaning of the text in a familiar language. Therefore mere grammatical or syntactical errors which have no impact on the possibility of understanding the content do not hinder its qualification as a translation.

A general statement that machine translations as such cannot be trusted is not sufficient to contest the value of the translation. If the applicant objects to the use of a specific machine translation, the applicant bears the burden of adducing evidence (in the form of, for instance, an improved translation of the whole or salient parts of the document) showing the extent to which the quality of the machine translation is defective and should therefore not be relied upon.

When the applicant provides substantiated reasoning for questioning the objections raised based on the translated text, the examiner will have to take these reasons into account, similarly to when the publication date is questioned.

5. Conflict with other applications

5.1 Prior art pursuant to Rules 33.1(c) and 64.3

GL/ISPE 11.07-11.09
Rule 33.1(c),
Rule 64.3,
Rule 70.10

Under the PCT, the prior art does not comprise the content of other applications filed or validly claiming a priority date earlier than – but published on or after – the date of filing or valid date of priority of the application being examined. However, attention must be drawn to such applications in the international search report and, where applicable, the preliminary examination report, as they may become relevant under Article 54(3) EPC (see also ~~GL/PCT-EPO~~ B-XI, 4.3). ~~By the~~ The "content" of an application ~~is~~ means ~~meant~~ the whole disclosure, i.e. the description, drawings and claims, including:

(i) any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments);

(ii) any matter for which an allowable reference (see ~~GL/EPO~~ EPC Guidelines F-III, 8, penultimate paragraph) to other documents is made; and

(iii) prior art insofar as explicitly described.

However, the "content" does not include any priority document (the purpose of such document being merely to determine to what extent the priority date is valid for the disclosure of the international application).

5.2 Co-pending applications

The PCT does not deal explicitly with the case of co-pending international applications of the same applicant of the same effective date, see ISPE Guidelines 11.10.

6. Prior art made available to the public anywhere in the world by non-written disclosure

Rule 33.1(b),
Rule 64.2
GL/ISPE 11.22

A non-written disclosure is not considered part of the prior art for the purposes of Art. 33(2) and (3) if the date of that non-written disclosure is indicated in a written disclosure which has been made available to the public on or after the relevant date of the application (i.e. on or after the international filing date or, if a priority has been validly claimed, the earliest priority date).

However, the EPO as PCT authority takes into account disclosures that can be considered "print equivalent" (see G-IV, 6.4) or that are otherwise captured in a way which allows them to be seen or copied by others and to ascertain the date on which they were made available to the public, such as, for example, multimedia disclosures (videos) available on the internet.

6.1 Types of non-written disclosure, in particular use, and instances of prior art made available in any other way

Rule 33.1(b), Rule 64.2

Making available to the public may occur by means of an oral disclosure, use, exhibition or other non-written means. Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

Prior art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the prior art concerned.

It should be borne in mind that for the purposes of the international search and the international preliminary examination a non-written disclosure is to be considered part of the prior art for the purposes of Art. 33(2) and (3) only if its content is confirmed by a written disclosure that was made available to the public earlier than the relevant date as defined by Rule 64.1(b).

6.2 Matters to be determined as regards use

Rule 33.1(b), Rule 64.2

When the ISA or the IPEA has gained knowledge of an object or process that has been used in such a way that it is comprised in the prior art (e.g. by a third party, see ~~GL/PCT-EPO~~ E-II, ISPE Guidelines 16.57 and PCT/AI section 801), the following details have to be determined:

(i) whether there is a written disclosure that was made available to the public earlier than the relevant date as defined by Rule 64.1(b) which confirms the use of the object or the process;

(ii) the date on which an alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use);

(iii) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the application; and

(iv) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public.

6.2.1 General principles

Subject-matter should be regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge. This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features are nevertheless to be considered as having been made available to the public. This is irrespective of whether or not particular reasons can be identified for analysing the composition or internal structure of the object. These specific features only relate to the intrinsic features. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g. reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product *per se* as they are dependent on deliberate choices being made. Typical examples are the first or further application as a pharmaceutical product of a known substance or composition and the use of a known compound for a particular purpose, based on a new technical effect. Thus, such characteristics cannot be considered as already having been made available to the public.

If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public.

6.2.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken, or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith and trust are factors which may occur in contractual or commercial relationships (see EPC Guidelines G-IV, 7.2.2).

6.2.3 Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does not refer to the premises of a third party to whom the object in question was unconditionally

sold or the place where the public could see the object in question or ascertain features of it.

6.2.4 Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards) were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

6.2.5 Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

6.3 Prior art made available by means of oral description

Rule 33.1(b), Rule 64.2, Rule 70.9 GL/ISPE 11.22

If the prior art was made available to the public by an oral description before the relevant date (i.e. the date of filing of the application or, if applicable, the date of the earliest validly claimed priority) but a document which reproduces the oral description was only published on or after that relevant date, the ISR and the IPER draw attention to this non-written disclosure in the manner provided for in Rule 70.9 (Rules 33.1(b) and 64.2).

6.4 Internet disclosures

GL/ISPE 11.13-11.20

As a matter of principle, disclosures on the internet form part of the prior art. Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was publicly posted. Internet websites often contain highly relevant technical information. Certain information may even be available only on the internet from such websites. This includes, for example, online manuals and tutorials for software products (such as video games) or other products with a short life cycle.

As regards establishing the publication date and the standard and burden of proof, in particular with technical journals or "print equivalent" publications, the principles as laid down in the Guidelines for Examination in the EPO (G-IV, 7.5.1-7.5.6) apply *mutatis mutandis*.

6.5 Standards and standard preparatory documents

The principles as laid down in the Guidelines for Examination in the EPO (G-IV, 7.6) apply *mutatis mutandis*.

7. Cross-references between prior-art documents

If a document (the "primary" document) refers explicitly to another document (the "secondary" document) as providing more detailed information on certain features, the teaching of the latter is to be regarded as incorporated into the primary document if the document was available to the public on the publication date of the primary document. The relevant date for novelty purposes, however, is always the date of the primary document.

8. Errors in prior-art documents

The principles as laid down in the Guidelines for Examination in the EPO ~~(~~G-IV, 9~~)~~ apply *mutatis mutandis*.

Chapter V – Non-prejudicial disclosures

1. General

GL/ISPE 16.76
PCT/AI Section 215
Rule 4.17(v)

The PCT acknowledges that in certain cases the invention may have been disclosed before the relevant date for the purposes of the PCT in such a way that it is not considered to form part of the prior art in accordance with the national law of one or more designated Offices (Rule 51*bis*.1(a)(v)).

Therefore, it should be borne in mind that, upon validly entering the regional phase before the EPO, the standards for non-prejudicial disclosures as laid down in Article 55(1) EPC will be applied.

Consequently, the principles as laid down in Chapter G-V of the Guidelines for Examination in the EPO apply *mutatis mutandis*.

Chapter VI – Novelty

1. Prior art pursuant to Art. 33(2)

Art. 33(2)
Rule 43bis.1(a)(i), Rule 64.1, Rule 64.2
GL/ISPE 12.01, 12.02

Under the PCT, an invention is considered to be novel if it is not anticipated by the prior art. Everything which is made available to the public anywhere in the world by means of a written disclosure is considered prior art provided that such making available occurred prior to the relevant date. In cases where the making available to the public occurred by non-written means, it constitutes prior art only if a written disclosure that occurred before the relevant date confirms the non-written disclosure. The relevant date is the international filing date or, where at least one priority has been validly claimed, the date of the earliest priority. It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested, see also ISPE Guidelines 12.06.

For the specific case of selection inventions see ISPE Guidelines 12.10.

Furthermore, any matter explicitly disclaimed (with the exception of disclaimers which exclude unworkable embodiments) and prior art acknowledged in a document, insofar as explicitly described therein, are to be regarded as incorporated in the document.

GL/ISPE 12.06

It is further permissible to use a dictionary or similar document of reference in order to interpret a special term used in a document.

2. Implicit features or well-known equivalents

GL/ISPE 12.04

A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of inventive step.

3. Relevant date of a prior document

Rule 64.1, Rule 64.2, Rule 33.1(b)

In determining novelty, a prior document should be read as it would have been read by a person skilled in the art on the relevant date of the document. For the purpose of assessing novelty the "relevant" date for written disclosures is the date as defined by Rule 64.1(b), i.e. either the international filing date of the application under consideration or, if a priority has been validly claimed, the application date of that earlier application (if the filing date of the application is within the two-month period after the expiry of the priority period of the earlier application, the relevant date is also the application date of that earlier application); for non-written disclosures see Rules 33.1(b) and 64.2.

4. Enabling disclosure of a prior document

Rule 33, *Rule 64*
GL/ISPE 12.02

Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the prior art pursuant to Rules 33 and 64, if the information given therein to the skilled person is sufficient to enable them, at the relevant date of the document, to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of them.

Similarly, it should be noted that a chemical compound, the name or formula of which is mentioned in a prior-art document, is not thereby considered as known, unless the information in the document, together, where appropriate, with knowledge generally available on the relevant date of the document, enables it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

The EPO applies option A12.02[1] of the Appendix to Chapter 12 of the ISPE Guidelines.

5. Generic disclosure and specific examples

GL/ISPE 12.08, *12.09*

In considering novelty, it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

6. Implicit disclosure and parameters

GL/ISPE 12.04

In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching. Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters. It may happen that in the relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. The burden of proof for an alleged distinguishing feature lies with the applicant. No benefit of doubt can be accorded if the applicant does not provide evidence in support of the allegations. If, on the other hand, the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims (Art. 5).

7. Examination of novelty

GL/ISPE 12.05

In determining novelty of the subject-matter of claims, the examiner should remember that, particularly for claims directed to a physical entity, non-distinctive characteristics of a particular intended use should be disregarded. For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g. the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated, but implied by the particular use, should be taken into account.

A known compound is not rendered novel merely because it is available with a different degree of purity if the purity can be achieved by conventional means.

7.1 Second or further medical use of known pharmaceutical products

How the novelty of second or further medical use claims is assessed depends on the IPEA. The examiner at the EPO as IPEA examines the novelty of the subject-matter in view of the entry into the regional phase before the EPO and therefore will apply the principles as laid down in ~~GL/EPO~~ EPC Guidelines G-VI, 6.1 and subsections. See ~~GL/PCT-EPO~~ B-VIII, 2.1, for the treatment of medical use claims by the EPO as ISA.

7.2 Second non-medical use

A claim to the use of a known compound for a particular purpose (second non-medical use) which is based on a technical effect will be interpreted by the EPO examiner as including that technical effect as a functional technical feature. The novelty of the use of the known compound for the known production of a known product cannot be deduced from a new property of the produced product. In such a case, the use of a compound for the production of a product will be interpreted as a process for production of the product with the compound. Therefore, it can be regarded as novel only if the process of production as such is novel.

8. Selection inventions

GL/ISPE 12.10

Selection inventions deal with the selection of individual elements, subsets, or subranges, which have not been explicitly mentioned, within a larger known set or range. The examiner of the EPO as IPEA will assess the novelty of the subject-matter according to the principles laid down in ~~GL/EPO~~ EPC Guidelines G-VI, 7 and subsection.

9. Novelty of "reach-through" claims

"Reach-through" claims are defined as claims attempting to obtain protection for a chemical product (and also uses thereof, compositions thereof, etc.) by defining that product functionally in terms of its action (e.g. agonist, antagonist) on a biological target such as an enzyme or receptor. In many such cases, the applicant functionally defines chemical compounds in this way by reference to a newly identified biological target. However, compounds which bind to and exercise this action on that biological target are not necessarily novel compounds simply because the

biological target which they act on is new. Indeed in many cases, applicants themselves provide test results in the application whereby known compounds are shown to exert this action on the new biological target, thus demonstrating that compounds falling within the functional definition of the "reach-through" claim are known in the prior art and so establishing that a reach-through claim relating to compounds defined in this way lacks novelty.

Chapter VII – Inventive step

1. General

An invention is considered to involve an inventive step if, having regard to the prior the art, it is not obvious to a person skilled in the art. Novelty and inventive step are different criteria. The question of whether there is inventive step only arises if the invention is novel.

Art. 33(3)
GL/ISPE 13.01

2. Prior art; date of filing, date of priority

The "prior art" for the purposes of considering inventive step is as defined in Art. 33(3).

GL/ISPE 13.02

In determining what is to be considered prior art, the principles laid down in ~~GL/PCT-EPO~~ G-IV apply.

3. Person skilled in the art

The "person skilled in the art" should be presumed to be a skilled practitioner in the relevant field of technology, who possesses average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date. They should also be presumed to have had access to everything in the "prior art", in particular the documents cited in the search report, and to have had at their disposal the means and capacity for routine work and experimentation which are normal for the field of technology in question. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The skilled person is involved in constant development in their technical field.

GL/ISPE 13.11

3.1 Common general knowledge of the skilled person

Section G-VII, 3.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4. Obviousness

Thus the question to consider, in relation to any claim defining the invention, is whether before the filing or priority date valid for that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty, it is fair to construe any published document in the light of knowledge up to and including the day before the relevant date according to Rule 65.2 for the claimed invention and to have regard to all the knowledge generally available to the person skilled in the art up to and including that day.

Rule 65.1
GL/ISPE 13.03,
GL/ISPE 13.09,
GL/ISPE 13.10

5. Problem-solution approach

In order to render the assessment of inventive step more objective, the EPO applies the so-called **"problem-solution approach"**, which should be applied consistently.

GL/ISPE 13.08,
GL/ISPE A13.08.1-
GL/ISPE A13.08.9

In the problem-solution approach, there are three main stages:

(i) determining the "closest prior art",

(ii) establishing the "objective technical problem" to be solved, and

(iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

The EPO applies option A13.08.1 of the Appendix to Chapter 13 of the ISPE Guidelines.

5.1 Determination of the closest prior art

GL/ISPE 13.10, GL/ISPE A13.08.2

Generally, the principles laid down in section G-VII, 5.1, in the Guidelines for Examination in the EPO apply *mutatis mutandis*. The closest prior art is that which in one single reference discloses the combination of features which constitutes the most promising starting point for a development leading to the invention. In selecting the closest prior art, the first consideration is that it should be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention.

5.2 Formulation of the objective technical problem

GL/ISPE A13.08.3-GL/ISPE A13.08.7

In the second stage, the examiner establishes in an objective way the **technical problem** to be solved. The method to do so is to study the application (or the patent), the closest prior art and the difference (also called "the **distinguishing feature(s)**" of the claimed invention) in terms of features (either structural or functional) between the claimed invention and the closest prior art, identify the technical effect resulting from the distinguishing features, and then formulate the technical problem.

The objective technical problem derived in this way may not be what the applicant presented as "the problem" in the application. The latter may require reformulation, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed. In particular, the prior art cited in the search report may put the invention in an entirely different perspective from that apparent from reading the application only. Reformulation might lead to the objective technical problem being less ambitious than originally envisaged by the application.

Section G-VII, 5.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.3 Could-would approach

GL/ISPE A13.08.8, GL/ISPE A13.08.9

In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that **would** (not simply could, but would)

have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves.

5.4 Claims comprising technical and non-technical features

Section G-VII, 5.4, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.4.1 Formulation of the objective technical problem for claims comprising technical and non-technical features

Section G-VII, 5.4.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.4.2 Examples of applying the steps listed in EPC Guidelines G-VII, 5.4

Illustrative examples can be found in section G-VII, 5.4.2, and subsections G-VII, 5.4.2.1 to G-VII, 5.4.2.5, in the Guidelines for Examination in the EPO.

6. Combining pieces of prior art

Rule 65.1
GL/ISPE 13.12,
GL/ISPE 13.13

In the context of the problem-solution approach, it is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art (e.g. a public prior use or unwritten general technical knowledge) with the closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be an indication of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features.

Section G-VII, 6, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

7. Combination vs. juxtaposition or aggregation

GL/ISPE 13.05,
GL/ISPE 13.14(c),
(d)

The invention claimed must normally be considered as a whole. When a claim consists of a "combination of features", it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. However, where the claim is merely an "aggregation or juxtaposition of features" and not a true combination, it is enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step.

8. *Ex post facto* analysis

GL/ISPE 13.15

It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated, it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. Examiners should be wary of *ex post facto* analysis of this kind. When combining documents cited in the search report, they should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged

invention. In all cases they should attempt to visualise the overall state of the art confronting the skilled person before the applicant's contribution, and should seek to make a "real-life" assessment of this and other relevant factors. They should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant, without the benefit of hindsight.

9. Origin of an invention

While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that an invention may, for example, be based on the following:

(i) the devising of a solution to a known problem;

(ii) the arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).

Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

10. Secondary indicators

10.1 Predictable disadvantage; non-functional modification; arbitrary choice

Section G-VII, 10.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

10.2 Unexpected technical effect; bonus effect

Section G-VII, 10.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

10.3 Long felt need; commercial success

See ISPE Guidelines 13.16-13.18.

11. Arguments and evidence submitted by the applicant

Section G-VII, 11, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

12. Selection inventions

Generally, the principles laid down in section G-VII, 12, in the Guidelines for Examination in the EPO apply *mutatis mutandis*. The subject-matter of selection inventions differs from the closest prior art in that it represents selected sub-sets or sub-ranges. If this selection is connected to a particular technical effect, and if no hints exist leading the skilled person to the selection, then an inventive step is accepted (this technical effect occurring within the selected range may also be the same effect as attained with the broader known range, but to an unexpected degree). The criterion of "seriously contemplating" mentioned in connection with the test for novelty of overlapping ranges should not be confused with the assessment of inventive step. For inventive step, it has to be considered whether the

skilled person would have made the selection or would have chosen the overlapping range in the hope of solving the underlying technical problem or in expectation of some improvement or advantage. If the answer is negative, then the claimed matter involves an inventive step.

The unexpected technical effect must apply to the entire range as claimed. If it occurs in only part of the claimed range, the claimed subject-matter does not solve the specific problem to which the effect relates, but only the more general problem of obtaining, for example, "a further product X" or "a further process Y".

13. Dependent claims; claims in different categories

See ISPE Guidelines 13.19.

14. Examples

See ISPE Guidelines 13.14.

PCT – Part H

Amendments and Corrections

Contents

Chapter I – The right to amend

Chapter H-I deals with the right to amend, while Chapters H-II and H-III deal with the allowability of amendments. Chapter H-IV is dedicated to the rectification of obvious mistakes.

1. Introduction

Notwithstanding the possibility to amend the claims before the IB under Art. 19, an international application may be amended during the PCT Chapter II procedure. There are a number of important aspects to consider.

Firstly, the amendments filed must be such that they can be taken into consideration by the EPO in its capacity as IPEA. The conditions governing timing and formal aspects are explained in ~~GL/PCT-EPO~~ H-I, 2 to ~~GL/PCT-EPO~~ H-I, 6.

Any change in the claims, the description or the drawings, other than a rectification of obvious mistakes under Rule 91, a correction under Rule 26 or the furnishing of missing parts under Rule 20.5 or correct elements or parts under Rule 20.5*bis*, 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

Secondly, amendments must be allowable, which means that they must not:

(i) add to the application subject-matter which was not disclosed in the application as originally filed

Art. 19(2)
Art. 34(2)(b)

(ii) introduce other deficiencies (such as lack of clarity in the claims).

GL/ISPE 20.09

2. Amendments before receipt of the search report

There is no right to amend the application until after the international search report has been established. Obvious mistakes, on the other hand, may be corrected (see ~~GL/PCT-EPO~~ H-IV).

3. Amendments prior to the start of international preliminary examination

When filing the demand, the applicant should indicate on Form PCT/IPEA/401 which documents should form the basis for international preliminary examination. These may be:

Art. 19
Art. 34(2)(b)
Rule 53.9
Rule 66.1
GL/ISPE 20.01-20.02

– the international application as originally filed, or

– amendments to the claims under Art. 19 and/or

– amendments to the claims, the description and/or sequence listings filed as a part thereof and/or the drawings under Art. 34(2)(b).

Rule 53.9(a)

The applicant may have filed amended claims under Art. 19 with the International Bureau after receipt of the search report and before the demand was filed. When filing the demand, the applicant may revert to the originally filed claims, reversing the amendments made according to Art. 19. If this is the case, preliminary examination proceeds on the basis of the originally filed set of claims.

Rule 54bis, Rule 53.9(c), Rule 60.1(g), Rule 69.1(a) PCT AG I 10.010

Amendments and/or arguments filed under Art. 34 should preferably be filed together with the demand. Where the applicant indicates in the statement concerning amendments filed with the demand that it is doing so, but fails to actually submit the amendments with the demand, the EPO as IPEA will invite the applicant to submit them within a set time limit (Form PCT/IPEA/431). Where the applicant has expressly requested postponement of the start of international preliminary examination until expiry of the time limit under Rule 54*bis*.1(a), the EPO as IPEA will take into account any amendments and/or arguments under Art. 34 which are filed before then (see also ~~GL/PCT-EPO~~ C-VI, 1).

The examiner should carefully check that the examination is based on the correct set of documents.

4. Further opportunity to submit amendments

Art. 34(2)(b) Rule 66.4

Together with the reply to the WO-ISA, the WO-IPEA or the minutes of a telephone consultation, the applicant has, subject to certain exceptions (see ~~GL/PCT-EPO,~~ C-VII, 1(d)), the opportunity to submit (further) amendments under Art. 34 to the claims, description and/or drawings.

Rule 66.4bis GL/ISPE 20.05

Subsequently filed amendments and/or arguments will be taken into account by the EPO as IPEA only if they are received before the point at which preparation of a written opinion or the IPER has actually started.

For further details, see ~~GL/PCT-EPO~~ C-IV, 1 and ~~GL/PCT-EPO~~ C-IV, 2 and subsections, and ~~GL/PCT-EPO~~ C-VII, 1.

5. Amended sheets

Rule 66.8 GL/ISPE 20.06

Amendments to the claims, the description and the drawings must be made by filing replacement sheets when, on account of the amendments, the replacement sheet differs from the sheets previously filed.

~~If amendments are made to the claims, a complete set of new claims should be filed.~~

Rule 46.5 Rule 66.8(c)

If amendments to the claims are filed, a complete set of the claims in replacement of all claims originally filed must be submitted.

Rule 92.4 GL/ISPE 20.08 OJ EPO 2024, A41 PCT Gazette 10.05.2024, 88

The applicant may submit amendments ~~by~~ using the EPO's filing tools or on paper. The EPO no longer accepts submissions by fax (a change with effect from 1 July 2024) and any transmission of a document by fax to the EPO shall be deemed not to have been received. ~~and there is no need for a confirmation letter, unless the faxed document is illegible.~~ Printed or typed amendments are preferred; handwritten amendments are, in general, not

acceptable. Nevertheless, if the handwritten amendments are legible they may – at the discretion of the EPO – be admitted.

If amendments are made to a sequence listing contained in an application filed in electronic form, a sequence listing in electronic form comprising the entire listing with the relevant amendment must be filed. *PCT AI Annex C, 3ter*

6. Indication of amendments and their basis

The applicant is obliged to indicate the basis in the application as originally filed for any amendments filed~~.~~, i.e. the applicants may indicate in an accompanying letter *Rule 46.5* *Rule 66.8(a)* *Rule 70.2(c-bis)*

– the differences between the application as originally filed and any amendments made,

– the basis for the amendments in the application as filed, and

– the reasons for any such amendments.

If the basis for any amendment is not indicated as required and is not apparent, the EPO will establish the written opinion and/or IPER as if no amendments had been filed and without first issuing a reminder. ~~If no such basis is indicated, the IPER may be established as if the amendments had not been made.~~ If an IPER is issued, this ~~This~~ is indicated ~~in the IPER~~ under Section I.

If a further WO-IPEA (Form 408) is sent (with respect for the principles set out in ~~GL/PCT-EPO~~ C-IV, 2.2), there should be a similar indication in the WO-IPEA as to which amendments could not be taken into account. Further, the applicant may also be reminded in this WO-IPEA to specify the basis for the amendments which may be filed in reply to the WO-IPEA. However, a WO-IPEA whose only content would be a request to indicate the basis for such amendments will not be sent; instead, the IPER is established directly.

Chapter II – Allowability of amendments

1. Introduction

Once the EPO as IPEA has concluded that the amendments can be taken into consideration (see ~~GL/PCT-EPO~~ H-I), all amended pages (description, claims, drawings) must be examined to see whether they introduce subject-matter not originally disclosed. The examiner should apply the criteria used under Art. 123(2) EPC for the European procedure *mutatis mutandis*, as indicated below. It is important to note that an amendment which is taken into consideration by the EPO as IPEA is not automatically allowable.

GL/ISPE 20.09

With regard to establishing the WO-IPEA or IPER if any newly filed claim, drawing or part of the description contains amendments which are considered to go beyond the disclosure as originally filed, see ~~GL/PCT-EPO~~ C-III, 4.

2. Allowability of amendments

2.1 Basic principle

The examiner should apply the guidelines of section H-IV, 2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

GL/ISPE 20.12

2.2 Content of the application as "originally" filed – general rules

The examiner should apply the guidelines of section H-IV, 2.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.1 Features described in a document cross-referenced in the description

The examiner should apply the guidelines of section H-IV, 2.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

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

If the applicant files (a) missing or correct part(s) (i.e. part(s) of the description, part(s) of the claims and/or part(s) or all of the drawings) and/or (a) missing or correct element(s) (i.e. all of the description and/or all of the claims), the filing date of the application as a whole will be the date on which the part(s) and/or the element(s) was (were) subsequently furnished, unless the RO accepted the incorporation by reference of the missing or correct part(s) and/or element(s).

Rule 20.3
Rule 20.5
Rule 20.5bis
Rule 20.7
OJ EPO 2020, A81

An applicant therefore has the possibility to furnish parts of the application and/or entire elements which were erroneously omitted without affecting the international filing date by requesting their incorporation by reference to the priority document (see ~~GL/PCT-EPO~~ A-II, 5).

Rule 4.18
Rule 20.6

Similarly, an applicant therefore also has the possibility to request the correction of erroneously filed parts of the application and/or entire elements without affecting the international filing date by requesting their incorporation by reference to the priority document. This latter possibility is, however, not available before all ROs. In particular, the EPO acting as RO

Rule 19.4(a)(iii)
Rule 20.5bis(a)(ii)
Rule 20.8(a-bis)
PCT Gazette 30.01.2020, 11-12

had notified the IB of the incompatibility of Rule 20.5*bis*(a)(ii) and Rule 20.5*bis*(d) with the legal framework under the EPC; see ~~GL/PCT-EPO~~ A-II, 6. However, following the withdrawal of this notification of incompatibility with effect from 1 November 2022, the EPO as RO may now also process requests for incorporation by reference of the correct element or part for international applications filed on or after 1 November 2022. See ~~GL/PCT-EPO~~ A-II, 6.2.

The activity of the EPO as ISA and IPEA depends on the decisions taken by the RO with regard to the international application and its filing date (see ~~GL/PCT-EPO~~ B-III, 2.3.3 and ~~GL/PCT-EPO~~ B-III, 2.3.4, and ~~GL/PCT-EPO~~ B-XI, 2.1).

Rule 4.18
Rule 20.3
Rule 20.5
Rule 20.5bis
Rule 20.7

A request for incorporation by reference can only be filed before the RO within two months of the date of receipt of the purported international application (or at the invitation of the RO) provided that the priority claim was present at that initial date of receipt and only if the applicant can show that the missing or correct part(s) and/or element(s) was (were) completely contained in the priority document. Missing or correct parts and/or elements which have been accepted under this criterion are considered to be part of the application documents "as originally filed" (see ~~GL/PCT-EPO~~ B-III, 2.3.4 and ~~GL/PCT-EPO~~ B-XI, 2.1).

Rule 20.5(e)
Rule 20.5bis(e)

If the RO finds that the "completely contained" criterion is not met, the filing date of the application will be the date on which the part(s) and/or the element(s) was (were) subsequently furnished (unless, in the case of missing parts or of correct elements and/or parts, the applicant withdraws the subsequently furnished elements and/or parts). Where the EPO is (S)ISA or IPEA, the examiner must check (as far as the documents needed are available) whether the RO's assessment of the "completely contained" criterion was correct.

See also ~~GL/PCT-EPO~~ A-II, 5.

2.2.2.1 Test for "completely contained"

Rule 20.5(a)(ii)
Rule 20.5(d)
Rule 20.5bis(a)(ii)
Rule 20.5bis(d)
OJ EPO 2020, A81

The test for "completely contained" is stricter than the test for added subject-matter since it is a test whether the subsequently filed missing or correct part(s) and/or element(s) was (were) identical to the corresponding extract in the priority document, or a translation thereof.

GL/RO 205D
GL/ISPE 15.11

Although the RO is responsible for the decision on whether the missing or correct part(s) and/or element(s) was (were) completely contained in the priority document, the examiner must check (as far as the documents needed are available) that the decision taken was correct.

If the EPO is the RO, the examiner is only required to check for additional technical content. This entails ensuring that the missing text has been inserted into the application in such a position that it has exactly the same meaning as it had in the priority document.

If the EPO is not the RO, the identity of drawings and the word-for-word identity of (parts of) the description/claim(s) must also be checked by the examiner (unless the documents needed are not available at this stage).

2.2.2.2 Review by the examiner

Rule 20.5(a)(ii)
Rule 20.5(d)
Rule 20.5bis(a)(ii)
Rule 20.5bis(d)
OJ EPO 2020, A81
GL/ISPE 15.11

If the missing or correct part(s) and/or element(s) was (were) indeed completely contained in the priority document, the examiner will treat the file as having the filing date accorded by the RO. The examiner will proceed in the same way where unable to check whether the missing or correct part(s) and/or element(s) was (were) indeed completely contained in the priority document because, at the time of the search or the preliminary examination, the priority document(s) or any other document needed (i.e. the subsequently filed sheet(s) embodying the missing or correct part(s)/element(s) or the translation of the priority document) is (are) not available to the ISA or IPEA. If the documents needed for the check are not available, this will be indicated in the WO-ISA/IPER, in Section I of the separate sheet.

If the missing or correct part(s) and/or element(s) was (were) not completely contained in the priority document, the decision on the filing date made by the RO is still valid for the international phase. However, the examiner will indicate in the WO-ISA/IPER in Section I of the separate sheet that there are doubts as to whether the missing or correct part(s) and/or element(s) was (were) actually completely contained in the priority document. The search report and the WO-ISA or the IPER, as applicable, will also include documents which would be relevant if the application were to be redated (see ~~GL/PCT-EPO~~ B-III, 2.3.3).

Rules 4.18, 20.5(d), 20.5bis(d), 20.6
OJ EPO 2020, A81
OJ EPO 2022, A71

If the receiving Office has granted a request for incorporation by reference of a missing element or part, or of a correct element or part, under Rules 4.18, 20.5(d), 20.6 and/or 20.5*bis*(d) but the EPO as IPEA does not consider that element or part to be completely contained in the priority application, it will indicate this in the IPER.

A review of the decision by the RO can only take place in the regional phase (Rule 82*ter*.1(b)).

Rule 82ter.1(d)

After entry into the regional phase before the EPO (Euro-PCT phase) the applicant can withdraw the subsequently filed missing or correct parts and/or correct elements in order to avoid the redating of the application. In this case, it should be noted that amendments which are acceptable under the less strict criterion of Art. 123(2) EPC can always be filed during the Euro-PCT phase.

2.2.3 Sequence listings filed after the filing date ~~of filing~~

Rule 13ter.1(c)

Any sequence listing not contained in the international application as filed will – if not allowable as an amendment under Article 34 – not form part of the international application.

See ~~GL/PCT-EPO~~ B-VIII, 3.2, for the effect on the search and ~~GL/PCT-EPO~~ B-XI, 7, for the effect on the WO-ISA. For the effect on examination in Chapter II, see ~~GL/PCT-EPO~~ C-VIII, 2.1.

2.2.4 Priority documents

It is not permissible to add to an international application matter present only in the priority document for that application, unless this is done under the provisions of Rule 20.6 (see ~~GL/PCT-EPO~~ H-II, 2.2.2). For correction of errors, see ~~GL/PCT-EPO~~ H-IV.

2.2.5 Citation of prior art in the description after the filing date

GL/ISPE 20.10

The examiner should apply the guidelines of section H-IV, 2.2.7, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.6 Clarification of inconsistencies

GL/ISPE 20.10

The examiner should apply the guidelines of section H-IV, 2.2.8, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.7 Trade marks

The examiner should apply the guidelines of section H-IV, 2.2.9, in the Guidelines for Examination in the EPO *mutatis mutandis*.

~~**3. Compliance of amendments with other PCT requirements**~~

~~*GL/ISPE 20.09*~~

~~The examiner should apply the guidelines of section H-IV, 5.2, in the Guidelines for Examination in the EPO mutatis mutandis.~~

Chapter III – Allowability of amendments – examples

1. Introduction

This chapter ~~Chapter~~ provides additional guidance and examples relating to a number of typical situations where compliance with Art. 19(2) and/or Art. 34(2)(b) is an issue. However, it must be borne in mind that the allowability of a specific amendment is ultimately to be decided on a case-by-case basis.

2. Amendments in the description

2.1 Clarification of a technical effect

The examiner should apply the guidelines of section H-V, 2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*. *GL/ISPE 20.15*

2.2 Introduction of further examples and new effects

The examiner should apply the guidelines of section H-V, 2.2, in the Guidelines for Examination in the EPO *mutatis mutandis*. *GL/ISPE 20.16-GL/ISPE 20.17*

2.3 Revision of stated technical problem

The examiner should apply the guidelines of section H-V, 2.4, in the Guidelines for Examination in the EPO *mutatis mutandis*. *GL/ISPE 20.18*

2.4 Reference document

The examiner should apply the guidelines of section H-V, 2.5, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.5 Alteration, excision or addition of text in the description

The examiner should apply the guidelines of section H-V, 2.6, in the Guidelines for Examination in the EPO *mutatis mutandis*. *GL/ISPE 20.19*

3. Amendments in claims

3.1 Replacement or removal of a feature from a claim

The examiner should apply the guidelines of section H-V, 3.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.2 Inclusion of additional features

The examiner should apply the guidelines of section H-V, 3.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.2.1 Intermediate generalisations

The examiner should apply the guidelines of section H-V, 3.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.3 Deletion of part of the claimed subject-matter

The examiner should apply the guidelines of section H-V, 3.3, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.4 Further cases of broadening of claims

The examiner should apply the guidelines of section H-V, 3.4, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.5 Disclaimer disclosed in the application as originally filed

GL/ISPE 20.21

The examiner should apply the guidelines of section H-V, 4.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

4. Disclaimers not disclosed in the application as originally filed

4.1 The subject-matter to be excluded is not disclosed in the application as originally filed (so-called undisclosed disclaimers)

The examiner should apply the guidelines of section H-V, 4.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

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

4.2 The subject-matter to be excluded is disclosed in the application as originally filed

The examiner should apply the guidelines of section H-V, 4.2.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

5. Amendments to drawings

It is normally not possible under Art. 34(2)(b) to add completely new drawings to an application, since in most cases a new drawing cannot be unambiguously derivable from the mere text of the description. For the same reasons amendments to drawings should be carefully checked for compliance with Art. 34(2)(b).

For drawings based on the priority document, see ~~GL/PCT-EPO~~ H-II, 2.2.2 and subsections.

6. Amendments derived from drawings

The examiner should apply the guidelines of section H-V, 6, in the Guidelines for Examination in the EPO *mutatis mutandis*.

7. Amendments to the title

Rule 5.1, 37
GL/ISPE 16.35-16.38

The sole purpose of the title is to inform the public about the technical information disclosed in the application. The examiner does not need the applicant's approval to compose or amend the title.

Under Rule 5.1, the title is considered to be a part of the description. Under Rule 37.2, in the absence of a title, or when the title does not comply with Rule 4.3 (i.e. it is too long or not precise enough), the search examiner can compose a title or amend the existing one. On the basis of these two rules taken in conjunction, the EPO as ISA may accept amendments of the title proposed by the applicant, provided that any such amendments do not go beyond the disclosure in the international application as filed.

Art. 34

Moreover, the title can be amended before the EPO as IPEA under Art. 34, like any other part of the description.

Chapter IV – Correction of defects and errors

1. Substitute sheets (Rule 26)

If the RO finds defects under Art. 14(1)(a), it invites the applicant to correct them by submitting replacement sheets which will be ~~stamped~~ marked "SUBSTITUTE SHEET (RULE 26)", and these will retain the original filing date if submitted within the set time limit.

Art. 14
Rule 26
PCT AI Section 325

Where the EPO is (S)ISA or IPEA, the examiner must check whether the substitute sheets contain amendments/corrections that go beyond the strict limits of Rule 26 PCT and breach the prohibition on adding subject-matter, and inform the applicant in case substitute sheets under Rule 26 PCT go beyond the disclosure on the filing date.

2. Request for rectification of obvious mistakes in the application documents (Rule 91)

2.1 Introduction

An applicant can request authorisation to rectify obvious mistakes in the international application. Rectification is authorised on condition that:

Rule 91.1(a)
Rule 91.1(c)
GL/ISPE 8.01

(i) the mistake is obvious to the skilled person, i.e. that something else was intended than what appears in the document concerned, and

(ii) the rectification is obvious to the skilled person, i.e. that nothing else could have been intended than the proposed correction.

The applicant may submit a request for rectification of an obvious mistake in the description, claims and drawings (not the abstract) of the international application (including amended documents) to the ISA or the IPEA, which is the competent body to authorise or refuse such rectification. If the obvious mistake is related to the request form (PCT/RO/101), it is the RO which authorises or refuses the rectification.

Rule 91.1(b)(ii)
Rule 91.1(b)(iii)

The language requirements for a request for rectification of an obvious mistake in the description, claims and drawings by the EPO as ISA or IPEA are set out in A-VII, 3.1.

2.2 Authorisation or refusal of the request for rectification of obvious mistakes in the application documents

In order to determine whether the request for rectification of obvious mistakes can be authorised, the examiner should check that the time limit for requesting rectification has not expired. The request for rectification can only be considered if it is filed with the competent authority within 26 months from the priority date.

Rule 91.2

If the request is too late, it is refused on that ground.

If the request is in time, the examiner must check whether the requested rectifications satisfy the above criteria (i) and (ii) (see ~~GL/PCT-EPO~~ H-IV, 2.1).

– If one or both of the criteria (i) and (ii) are not satisfied, the examiner will not authorise the request and will indicate the reasons.

– If the request is authorised, no reasons need to be given. The fact that a rectification of an obvious mistake has been taken into account will be indicated in the WO-ISA, WO-IPEA (Form 408) or IPER (Form 409) under Section I.

– If the request is authorised only in part, the examiner indicates which rectifications are not allowable, together with the reasons, and which rectifications are allowable. The fact that a rectification of an obvious mistake has been taken into account (in part) will also be indicated in the WO-ISA, WO-IPEA (Form 408) or IPER (Form 409) under Section I.

Rule 91.1
GL/ISPE 17.16
PCT AI Section 607

Authorised 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)".

Rule 91.3(d)

If authorisation of a request for rectification is refused, the applicant may request the IB in writing, within two months of the refusal, to publish the refused request together with the reasons for refusal, subject to payment of a special fee.

2.3 Allowability of rectifications

The examiner will apply the same criteria in assessing the substantive allowability of proposed rectifications according to Rule 91.1 as for European applications according to Rule 139 EPC (see ~~GL/EPO~~ EPC Guidelines H-VI, 2.2.1).

2.4 Examples

The examiner should apply the guidelines of section H-VI, 2.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

List of sections amended in 2025 revision

MAJOR AMENDMENTS

GENERAL PART	General Part, 1.1	New section on relationship between the PCT and EPC
PART A	A-II, 4.1.1	New section on transmittal of the international application to the ISA and IB
	A-III, 3	Addition of information about EPO Contingency Upload Service as an exceptional means of filing debit orders
	A-III, 4.4.1	New section on fee for establishment and transmittal of a certified copy of priority documents to the IB
	A-IV, 3	New section on applications disclosing nucleotide and/or amino acid sequences
	A-VI, 1.7 A-VI, 1.8 A-VI, 2 A-VI, 3 A-VI, 4	New sections on provision of priority document, certified copies of international applications, designation of states and designation of inventors
	A-VI, 2.1 A-VI, 3.1 A-VI, 3.2	New sub-sections on extension states, validation states and non-designation for reasons of national law
	A-VII, 1.2.4	New sub-section on sequence listings
	A-VII, 2.3.1 A-VII, 2.3.2 A-VII, 2.3.3	New sub-section on language of international applications, amendments and demands
	A-VIII, 1.13	Update regarding new practice in relation to signing and filing authorisations
PART B	B-II, 1.1	New sub-section on competences of the EPO as ISA
	B-X, 11.1 B-X, 12 B-XII, 9	Update regarding new practice in relation to access to patent literature documents in search and examination proceedings
PART C	C-II, 1.1 C-II, 1.1.1	New sub-sections on the time limit for filing the demand and for delaying national phase entry
	C-II, 13	New section on language requirements

	C-IV, 1.1	New sub-section on subject-matter which the IPEA is not required to examine
	C-IV, 5.3	Update regarding new practice in relation to access to patent literature documents in search and examination proceedings
PART E	E-III, 1	Addition of Chile and New Zealand to list of the EPO's PPH partner offices
	E-IV	New chapter on time limits in the international phase
	E-V	New chapter on external complaints
	E-VI	New chapter on notification of communications

MINOR AMENDMENTS

GENERAL PART	General Part, 1 General Part, 2.5	Introduction of more consistent abbreviations
	General Part, 2.1	Addition of reference to the footnote
	General Part, 2.3	Deletion of outdated information
	General Part, 2.4	Clarification on "Agreement EPO-WIPO"
	General Part, 2.6	Addition of reference to missing forms
	General Part, 3.1	Addition of reference to EPC and PCT rules and articles
PART A	A-II, 1.1	Update regarding filing with the EPO as receiving Office in the case of two or more applicants
	A-II, 1.2 A-VIII, 2.3	Update regarding change in relation to international applications sent by fax (no longer accepted by the EPO)
	A-II, 1.2.1	Update regarding requirements for documents filed electronically
	A-II, 1.2.2 A-VIII, 2.2	Deletion of section to reflect the abolition of fax as a means of filing
	A-II, 1.2.2	Update regarding sub-offices and non-availability of automatic mailboxes
	A-II, 1.2.3	Addition of information about legal effect of filing of applications by means other than the means referred to in A-II, 1.2.1 and A-II, 1.2.2
	A-II, 1.3	Clarification on priority documents issued in paper form

	A-II, 1.5 A-II, 3.1	Deletion of redundant information referring to fax filings and web-form filing
	A-II, 3.2	Update regarding selection of the EPO as receiving office
	A-II, 4.1	Update regarding “international filing date”
	A-II, 6.2	Clarification on calculation of the international filing fee
	A-III, 4.4.2	New section on fee for a certified copy of priority document
	A-III, 7.5	Clarification on procedure in the case of absence of a validly filed demand
	A-III, 8.1.2	Addition of reference to the WIPO website
	A-III, 8.2	Addition of term “supplementary” in the title and the text
	A-III, 9	Update regarding further digitalisation of the fee refund procedure
	A-III, 9.2.1.1	Update regarding refund of the international search fee
	A-VI, 1.5	Update regarding decision by the RO on a request for restoration of the right of priority
	A-VI, 1.6	Deletion of redundant information relating to transfer of the priority right
	A-VII, 2.1	Clarification on language of translation when applications are not filed in a PCT language
	A-VII, 3.1	Clarification on practice concerning the language of proceedings when the EPO did not act as RO
	A-VII, 3.2	Restructured section – content moved from B-XI, 2.2
	A-VIII, 1.10	Addition of reference to EPC Guidelines
	A-VIII, 3.1	Clarification on applicant’s signature
	A-VIII, 3.2	Clarification on signing of power of attorney by the applicant
PART B	B-II, 6	Clarification on possible representation of applicants by a person having the right to practise before the receiving office
	B-III, 2.10 B-VIII, 3.2 B-XI, 7	Addition of reference to OJ EPO 2024 A54, A55 regarding applicable version of Standard ST.26

	B-VII, 1	Clarification on practice regarding possibility of filing a divisional application
	B-VII, 6.1	Update regarding practice in relation to international preliminary examination
	B-VIII, 1	Update regarding missing sequence listings and lack of unity of invention
	B-VIII, 2	Clarification on cases where the EPO is not required to perform an international search
	B-VIII, 2.2	Clarification on the EPO's practice as ISA with regard to methods of doing business
	B-VIII, 2.2.1	Deletion of redundant information
	B-VIII, 3	Clarification on practice regarding unsearchable claims
	B-VIII, 3.3	Update in view of Article 17(2)(a)(ii) PCT
	B-XI, 2.2	Restructured section – content moved to A-VII, 3.2
	B-XI, 8	Clarification on practice regarding form of dialogue between applicants and ISA
	B-XII, 2	Clarification on practice concerning the provision of the relevant documents in an electronic format complying with Annex C to the Administrative Instructions
PART C	C-II, 1	Deletion of passage to reflect the abolition of fax as a means of filing
	C-II, 2	Clarification on the EPO as IPEA
	C-II, 5	Update regarding representation before the EPO as IPEA
	C-II, 6	Update regarding information on valid withdrawal of designation
	C-II, 7	Update regarding practice in relation to missing signatures
	C-II, 8	Clarification on amendments filed before preliminary examination
	C-II, 10	Clarification on practice in relation to signature of all applicants
	C-II, 11	Addition of information regarding the international preliminary examination in the absence of fee payments

	C-IV, 1	Update regarding “second written opinion”
	C-IV, 2.1	Update regarding “first written opinion”
	C-IV, 2.2	Update regarding written opinions during international preliminary examination
	C-IV, 5	Update regarding the purpose of top-up searches
	C-VI, 1	Addition of reference to Box No. IV of the PCT demand form PCT/IPEA/401
	C-VII, 1	Update regarding requests for consultation by telephone
	C-VIII, 2.1	Restructured section
PART E	E-II	Clarification on accelerated proceedings in the case of third-party observations
PART F	F-II, 6 F-VI, 3.3	Deletion of reference to Euro-PCT Guide
	F-III, 6.3	Update regarding the availability of biological material (title and content)
PART G	G-IV, 1 G-IV, 6	Adaptation to long-standing practice regarding non-written disclosure (PCT Assembly Doc. A/56/2, Annex V, p.3)
PART H	H-I, 5	Update regarding replacement of claims when amendments are filed
	H-I, 6	Addition of a list of possible indicated amendments
	H-II, 2.2.2.2	Clarification on granted request for incorporation by reference of missing element or part
	H-II, 3	Deletion of section to align with deletion of EPC Guidelines content referenced
	H-IV, 1	Clarification on practice concerning procedure for EPO as ISA if substitute sheets under Rule 26 PCT go beyond the disclosure on the filing date
	H-IV, 2.1	Update regarding language requirements for error corrections (A-VII, 3.1)

EDITORIAL CHANGES

PART A	A-II, 1.4; A-II, 4.2; A-II,6; A-II, 6.1; A-III, 4.2; A-III, 4.3; A-III, 4.4.1; A-III, 5.1; A-III, 5.2; A-III, 5.3; A-III, 6.3; A-III, 7.1; A-III, 7.2; A-III, 7.2.1; A-III, 7.3; A-III, 7.4; A-III, 8.1.1.1; A-III, 8.1.1.2; A-III, 8.1.1.3; A-III, 9.1; A-III, 9.2; A-III, 9.2.1.2; A-III, 9.2.1.3; A-III, 9.3; A-III, 9.4; A-III, 9.5; A-III, 9.7; A-III, 9.8; A-IV, 1.1; A-IV, 1.4; A-IV, 2.2; A-IV, 2.3; A-IV, 2.5; A-V, 1.1; A-V, 1.2; A-V, 7.1; A-V, 8; A-V, 10; A-VI, 1; A-VI 1.2; A-VI, 1.3; A-VI, 1.4; A-VI, 1.4.1; A-VI, 1.4.2; A-VII, 1.2.3.2; A-VII, 3.4; A-VII, 5; A-VIII, 1.2; A-VIII, 1.4; A-VIII, 1.5; A-VIII, 1.7; A-VIII, 1.8; A-VIII, 1.11; A-VIII, 1.12; A-VIII, 1.13; A-VIII, 2.4; A-VIII, 3.3; A-VIII, 3.4
PART B	B-II, 4; B-III, 1.3; B-III, 1.4; B-III, 2.1; B-III, 2.2.1; B-III, 2.3.1; B-III, 2.3.2; B-III, 2.3.3; B-III, 2.7; B-III, 2.10; B-III, 2.11; B-III, 2.12; B-IV, 1.1; B-IV, 1.2; B-IV, 1.2.1; B-IV, 1.2.2; B-IV, 1.3; B-VI, 1; B-VI, 2; B-VI, 4.1; B-VII, 2; B-VII, 4; B-VII, 6.3; B-VII, 7.1; B-VII, 7.2; B-VII, 8; B-VIII, 2.1; B-VIII, 3.1; B-VIII, 3.2; B-VIII, 3.3.1; B-VIII, 4; B-IX, 2.2; B-X, 1; B-X, 2; B-X, 7; B-X, 8; B-X, 9.2.4; B-XI, 2; B-XI, 2.1; B-XI,3.2.2; B-XI, 3.4; B-XI, 4; B-XI, 4.1; B-XI, 4.2; B-XI, 5; B-XI, 6; B-XI, 7; B-XII, 5; B-XII, 7; B-XII, 10.1; B-XII, 10.2; B-XII, 10.4; B-XII, 11
PART C	C-III, 1; C-III, 2; C-III, 3; C-IV, 2.3; C-IV, 2.5; C-IV, 4.1; C-IV, 4.2; C-IV, 5.2; C-IV, 5.4; C-V, 1; C-V, 4.3; C-V, 5.2; C-VI, 3; C-VI, 2; C-VI, 3; C-VIII, 2; C-VIII, 3; C-VIII, 4; C-IX, 1; C-IX, 4
PART E	E-III, 2; E-III, 3
PART F	F-II, 4.4; F-II, 4.13; F-II, 5.2; F-II, 6; F-II, 7.2; F-II, 7.4; F-III, 1; F-III, 3; F-III, 4; F-III, 5.1; F-III, 5.2; F-III, 7; F-III, 8; F-III, 10; F-III, 11; F-IV, 1; F-IV, 2.1; F-IV, 3.1; F-IV, 3.2; F-IV, 3.4; F-IV, 3.6; F-IV, 3.8.2; F-IV, 4.8; F-IV, 4.10; F-IV, 4.11; F-IV, 4.13; F-IV, 4.19; F-IV, 4.21; F-IV, 4.22; F-IV, 4.23; F-IV, 5; F-IV, 6.1; F-IV, 6.3; F-IV, 6.4; F-IV, 6.5; F-V, 1; F-V, 2; F-V, 3; F-VI, 1; F-VI, 1.2; F-VI, 1.3; F-VI, 2.2; F-VI, 3.1; F-VI, 3.7
PART G	G-II, 1; G-II, 3.1; G-II, 3.2; G-II, 3.3; G-II, 3.4; G-II, 3.5; G-II, 3.6; G-II, 3.7; G-II, 4.1; G-II, 4.2; G-II, 5.2; G-II, 5.3; G-II, 5.4; G-II, 5.5; G-IV, 2; G-IV, 3; G-IV, 4; G-IV, 5.1; G-IV, 6.2; G-IV, 6.2.2; G-IV, 6.4; G-IV, 6.5; G-IV, 8; G-VI, 7.1; G-VI, 8; G-VII, 2; G-VII, 3.1; G-VII, 5.1; G-VII, 5.2; G-VII, 5.4; G-VII, 5.4.1; G-VII, 5.4.2; G-VII, 6; G-VII, 10.1; G-VII, 10.2; G-VII, 11
PART H	H-I, 1; H-I, 2; H-I, 3; H-I, 4; H-II, 1; H-II, 2.2.2; H-II, 2.2.3; H-II, 2.2.4; H-III, 5; H-IV, 2.2; H-IV, 2.3