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**Contents:**

- **Cross-referenced** PCT Articles and Rules (retrieved April 2012)
- PCT Applicant's Guide International Phase / National Phase (selected chapters) (retrieved April 2012)
- EPO Guide for Applicants Part II, International Route (retrieved October 2012)
- EPO Guidelines for Examination (only paragraphs that directly reference PCT articles or rules) (retrieved October 2012)

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## **A.1 PCT Establishment of a Union**

(1) The States party to this Treaty (hereinafter called "the Contracting States") constitute a Union for cooperation in the filing, searching, and examination, of applications for the protection of inventions, and for rendering special technical services. The Union shall be known as the International Patent Cooperation Union.

(2) No provision of this Treaty shall be interpreted as diminishing the rights under the Paris Convention for the Protection of Industrial Property of any national or resident of any country party to that Convention.

### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 5 The role of the EPO in the international phase

***R.1 PCT Abbreviated Expressions***

1.1 *Meaning of Abbreviated Expressions*

- (a) In these Regulations, the word "Treaty" means the Patent Cooperation Treaty.
- (b) In these Regulations, the words "Chapter" and "Article" refer to the specified Chapter or Article of the Treaty.

## ***R.2 PCT Interpretation of Certain Words***

### **2.1 "Applicant"**

Whenever the word "applicant" is used, it shall be construed as meaning also the agent or other representative of the applicant, except where the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, such as, in particular, where the provision refers to the residence or nationality of the applicant.

### **2.2 "Agent"**

Whenever the word "agent" is used, it shall be construed as meaning an agent appointed under **Rule 90.1**, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used.

### **2.2bis "Common Representative"**

Whenever the expression "common representative" is used, it shall be construed as meaning an applicant appointed as, or considered to be, the common representative under **Rule 90.2**.

### **2.3 "Signature"**

Whenever the word "signature" is used, it shall be understood that, if the national law applied by the receiving Office or the competent International Searching or Preliminary Examining Authority requires the use of a seal instead of a signature, the word, for the purposes of that Office or Authority, shall mean seal.

### **2.4 "Priority Period"**

(a) Whenever the term "priority period" is used in relation to a priority claim, it shall be construed as meaning the period of 12 months from the filing date of the earlier application whose priority is so claimed. The day of filing of the earlier application shall not be included in that period.

(b) **Rule 80.5** shall apply *mutatis mutandis* to the priority period.

#### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 9 Representation in the international phase

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 32 Priority claim

GA B 33 Restoration of priority right

#### **PCT Implementing Rules**

R.80 PCT Computation of Time Limits

R.90 PCT Agents and Common Representatives

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.041 Does the applicant have to be represented by an agent before the receiving Office, the International Bureau and other International Authorities under the PCT?

PCT AG-IP 5.048 Can one of several applicants represent all of them as a common representative?

PCT AG-IP 5.059 What does "priority period" mean?

PCT AG-IP 5.089 May the international application be signed by an agent?

PCT AG-IP 5.091 When must or may a seal be used instead of a signature?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.032 What defects do not influence the international filing date?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.020 May the applicant be represented by an agent before the International Preliminary Examining Authority?

PCT AG-IP 10.022 May the applicants be represented by a common representative?

PCT AG-IP 10.032 When must or may a seal be used instead of a signature?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

## A.1 PCT Establishment of a Union

### R.2 PCT Interpretation of Certain Words

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PCT AG-IP 11.005 What is a “common representative” of the applicants?

PCT AG-IP 11.006 What happens if no common agent or common representative is specifically appointed?

## A.2 PCT Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

- (i) "application" means an application for the protection of an invention; references to an "application" shall be construed as references to applications for patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;
- (ii) references to a "patent" shall be construed as references to patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;
- (iii) "national patent" means a patent granted by a national authority;
- (iv) "regional patent" means a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one State;
- (v) "regional application" means an application for a regional patent;
- (vi) references to a "national application" shall be construed as references to applications for national patents and regional patents, other than applications filed under this Treaty;
- (vii) "international application" means an application filed under this Treaty;
- (viii) references to an "application" shall be construed as references to international applications and national applications;
- (ix) references to a "patent" shall be construed as references to national patents and regional patents;
- (x) references to "national law" shall be construed as references to the national law of a Contracting State or, where a regional application or a regional patent is involved, to the treaty providing for the filing of regional applications or the granting of regional patents;
- (xi) "priority date," for the purposes of computing time limits, means:
  - (a) where the international application contains a priority claim under **Article 8**, the filing date of the application whose priority is so claimed;
  - (b) where the international application contains several priority claims under **Article 8**, the filing date of the earliest application whose priority is so claimed;
  - (c) where the international application does not contain any priority claim under **Article 8**, the international filing date of such application;
- (xii) "national Office" means the government authority of a Contracting State entrusted with the granting of patents; references to a "national Office" shall be construed as referring also to any intergovernmental authority which several States have entrusted with the task of granting



## A.2 PCT Definitions

### R.2 PCT Interpretation of Certain Words

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regional patents, provided that at least one of those States is a Contracting State, and provided that the said States have authorized that authority to assume the obligations and exercise the powers which this Treaty and the Regulations provide for in respect of national Offices;

(xiii) "designated Office" means the national Office of or acting for the State designated by the applicant under **Chapter I** of this Treaty;

(xiv) "elected Office" means the national Office of or acting for the State elected by the applicant under **Chapter II** of this Treaty;

(xv) "receiving Office" means the national Office or the intergovernmental organization with which the international application has been filed;

(xvi) "Union" means the International Patent Cooperation Union;

(xvii) "Assembly" means the Assembly of the Union;

(xviii) "Organization" means the World Intellectual Property Organization;

(xi) "International Bureau" means the International Bureau of the Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);

(xx) "Director General" means the Director General of the Organization and, as long as BIRPI subsists, the Director of BIRPI.

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**  
GA E I 1 When is the EPO a designated or elected Office?

#### **PCT Articles**

A.3 PCT The International Application

A.4 PCT The Request

A.8 PCT Claiming Priority

A.31 PCT Demand for International Preliminary Examination

A.43 PCT Seeking Certain Kinds of Protection

A.44 PCT Seeking Two Kinds of Protection

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.34 PCT Minimum Documentation

R.43 PCT The International Search Report

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.001 What is an international application?

PCT AG-IP 5.002 What may be the subject of an international application?

PCT AG-IP 5.058 What does "priority date" mean?

PCT AG-IP 5.121 Can both intermediate and final products be claimed?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.002 When is an Office a designated Office?

PCT AG-NP 2.004 When is an Office an elected Office?

#### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.001 What is the time limit for entering the national phase before a designated Office?

PCT AG-NP 3.002 What is the time limit for entering the national phase before an elected Office?

#### **Case Law with Headnote**

J 8/81 Form of decision / International application / International search report / Refund of fee for European search report

#### **General Case Law**

J 3/00 Rectification of errors made by a PCT Receiving Office (PCT Rule 82 ter) / Protection of legitimate expectations

## A.3 PCT The International Application

(1) Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.

(2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.

(3) 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.

(4) The international application shall:

(i) be in a prescribed language;

(ii) comply with the prescribed physical requirements;

(iii) comply with the prescribed requirement of unity of invention;

(iv) be subject to the payment of the prescribed fees.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 3 Elements of the international application

GA B 7 Number of copies of documents filed

GA B 20 The PCT request

GA B 41 Language of the international application

GA B 42 Fees

### **PCT Articles**

A.2 PCT Definitions

A.14 PCT Certain Defects in the International Application

A.47 PCT Time Limits

### **PCT Implementing Rules**

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.27 PCT Lack of Payment of Fees

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.001 What is an international application?

PCT AG-IP 5.002 What may be the subject of an international application?

PCT AG-IP 5.010 What are the elements of an international application?

PCT AG-IP 5.013 What language must be used for an international application?

PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?

PCT AG-IP 5.114 What is meant by the requirement of "unity of invention"?

PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?

PCT AG-IP 5.164 How must the abstract be drafted?

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

PCT AG-IP 5.184 What fees are due in respect of an international application?

### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.032 What defects do not influence the international filing date?

### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.025 Can access be gained at the International Bureau to the file of an international application?

## A.3 PCT The International Application

### R.2 PCT Interpretation of Certain Words

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#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.006 How does the national phase start?

#### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.003 Are reminders to enter the national phase sent to the applicant by the designated Offices? What happens if the international search report or the international preliminary examination report is late?

#### **Case Law of the Enlarged Board**

G 4/08 Langue de la Procédure

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [..]

## A.4 PCT The Request

(1) The request shall contain:

(i) a petition to the effect that the international application be processed according to this Treaty;

(ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States"); if for any designated State a regional patent is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate; if, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty; if, under the national law of the designated State, the designation of that State has the effect of an application for a regional patent, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent;

(iii) the name of and other prescribed data concerning the applicant and the agent (if any);

(iv) the title of the invention;

(v) the name of and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application. Otherwise, the said indications may be furnished either in the request or in separate notices addressed to each designated Office whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application.

(2) Every designation shall be subject to the payment of the prescribed fee within the prescribed time limit.

(3) Unless the applicant asks for any of the other kinds of protection referred to in **Article 43**, designation shall mean that the desired protection consists of the grant of a patent by or for the designated State. For the purposes of this paragraph, **Article 2(ii)** shall not apply.

(4) Failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in any designated State whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application. Failure to furnish the said indications in a separate notice shall have no consequence in any designated State whose national law does not require the furnishing of the said indications.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 7 Number of copies of documents filed

GA B 20 The PCT request

GA B 21 Designation of inventor

GA B 29 For which states may international applications be filed?

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XII 1 Missing data regarding the inventor or an applicant

## A.4 PCT The Request

### R.2 PCT Interpretation of Certain Words

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#### **PCT Articles**

##### A.2 PCT Definitions

##### A.14 PCT Certain Defects in the International Application

##### A.31 PCT Demand for International Preliminary Examination

##### A.43 PCT Seeking Certain Kinds of Protection

#### **PCT Implementing Rules**

##### R.27 PCT Lack of Payment of Fees

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.035 When and how must the inventor be identified?

PCT AG-IP 5.043 How is an agent to be appointed?

PCT AG-IP 5.052 What is the designation of States?

PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.002 When is an Office a designated Office?

#### **Case Law with Headnote**

J 3/81 International application / Correction of mistake / Public interest / Reestablishment of rights / Payment of fee

#### **General Case Law**

J 9/91 Euro-PCT applications - form and content - national requirement / Correction of errors/omissions / Priority [...]

J 19/93 -

J 3/94 EPO as an elected office / Election concerning the grant of a national patent not valid for the European grant [...]

J 7/99 Article 91(5) EPC disproportionate legal consequence (no) / Legal incapacity (no) cause of non-compliance

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [...]

### ***R.3 PCT The Request (Form)***

#### **3.1     *Form of Request***

The request shall be made on a printed form or be presented as a computer print-out.

#### **3.2     *Availability of Forms***

Copies of the printed form shall be furnished free of charge to the applicants by the receiving Office, or, if the receiving Office so desires, by the International Bureau.

#### **3.3     *Check List***

(a) The request shall contain a list indicating:

(i) the total number of sheets constituting the international application and the number of the sheets of each element of the international application: request, description (separately indicating the number of sheets of any sequence listing part of the description), claims, drawings, abstract;

(ii) where applicable, that the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a sequence listing in electronic form, a document relating to the payment of fees, or any other document (to be specified in the check list);

(iii) the number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published; in exceptional cases, the applicant may suggest more than one figure.

(b) The list shall be completed by the applicant, failing which the receiving Office shall make the necessary indications, except that the number referred to in **paragraph (a)(iii)** shall not be indicated by the receiving Office.

#### **3.4     *Particulars***

Subject to **Rule 3.3**, particulars of the printed request form and of a request presented as a computer print-out shall be prescribed by the Administrative Instructions.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 7 Number of copies of documents filed

GA B 20 The PCT request

#### **PCT Implementing Rules**

R.8 PCT The Abstract

R.11 PCT Physical Requirements of the International Application

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.49 PCT Copy, Translation and Fee under Article 22

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.084 What is the purpose of the check list?

PCT AG-IP 5.170 When must a figure be suggested to accompany the abstract?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.002 What are the additional procedural steps at the receiving Office for processing a request form print-out prepared using the PCT-SAFE software?

PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.092 What is the effect of an extension?

## A.4 PCT The Request

### R.3 PCT The Request (Form)

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PCT AG-IP 11.095 Can defects in the filing of request form print-outs generated using the PCT-SAFE software be corrected?  
PCT AG-IP 11.100 What happens when the request form print-out is not in the format provided by the PCT-SAFE software but it is filed with a corresponding diskette?

### ***R.4 PCT The Request (Contents)***

#### ***4.1 Mandatory and Optional Contents; Signature***

(a) The request shall contain:

- (i) a petition,
- (ii) the title of the invention,
- (iii) indications concerning the applicant and the agent, if there is an agent,
- (iv) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

- (i) a priority claim,
- (ii) indications relating to an earlier search as provided in **Rules 4.12(i)** and **12bis.1(c)** and **(f)**,
- (iii) a reference to a parent application or parent patent,
- (iv) an indication of the applicant's choice of competent International Searching Authority.

(c) The request may contain:

- (i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application,
- (ii) a request to the receiving Office to prepare and transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office,
- (iii) declarations as provided in **Rule 4.17**,
- (iv) a statement as provided in **Rule 4.18**,
- (v) a request for restoration of the right of priority,
- (vi) a statement as provided in **Rule 4.12(ii)**.

(d) The request shall be signed.

#### ***4.2 The Petition***

The petition shall be to the following effect and shall preferably be worded as follows: "The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty."

#### ***4.3 Title of the Invention***



## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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The title of the invention shall be short (preferably from two to seven words when in English or translated into English) and precise.

#### 4.4 *Names and Addresses*

(a) Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s).

(b) Names of legal entities shall be indicated by their full, official designations.

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. In order to allow rapid communication with the applicant, it is recommended to indicate any teleprinter address, telephone and facsimile machine numbers, or corresponding data for other like means of communication, of the applicant or, where applicable, the agent or the common representative.

(d) For each applicant, inventor, or agent, only one address may be indicated, except that, if no agent has been appointed to represent the applicant, or all of them if more than one, the applicant or, if there is more than one applicant, the common representative, may indicate, in addition to any other address given in the request, an address to which notifications shall be sent.

#### 4.5 *The Applicant*

(a) The request shall indicate:

(i) the name,

(ii) the address, and,

(iii) the nationality and residence

of the applicant or, if there are several applicants, of each of them.

(b) The applicant's nationality shall be indicated by the name of the State of which he is a national.

(c) The applicant's residence shall be indicated by the name of the State of which he is a resident.

(d) The request may, for different designated States, indicate different applicants. In such a case, the request shall indicate the applicant or applicants for each designated State or group of designated States.

(e) Where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered.

#### 4.6 *The Inventor*

(a) Where **Rule 4.1(a)(iv)** or **(c)(i)** applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.

## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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(b) If the applicant is the inventor, the request, in lieu of the indication under **paragraph (a)**, shall contain a statement to that effect.

(c) The request may, for different designated States, indicate different persons as inventors where, in this respect, the requirements of the national laws of the designated States are not the same. In such a case, the request shall contain a separate statement for each designated State or group of States in which a particular person, or the same person, is to be considered the inventor, or in which particular persons, or the same persons, are to be considered the inventors.

#### 4.7 *The Agent*

(a) If an agent is appointed, the request shall so indicate, and shall state the agent's name and address.

(b) Where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

#### 4.8 *Common Representative*

If a common representative is appointed, the request shall so indicate.

#### 4.9 *Designation of States; Kinds of Protection; National and Regional Patents*

(a) The filing of a request shall constitute:

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date;

(ii) an indication that the international application is, in respect of each designated State to which **Article 43** or **44** applies, for the grant of every kind of protection which is available by way of the designation of that State;

(iii) an indication that the international application is, in respect of each designated State to which **Article 45(1)** applies, for the grant of a regional patent and also, unless **Article 45(2)** applies, a national patent.

(b) Notwithstanding **paragraph (a)(i)**, if, on October 5, 2005, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request in which the priority of an earlier national application filed in that State is claimed may contain an indication that the designation of that State is not made, provided that the designated Office notifies the International Bureau by January 5, 2006, that this paragraph shall apply in respect of designations of that State and that the notification is still in force on the international filing date. The information received shall be promptly published by the International Bureau in the Gazette.<sup>1</sup>

#### 4.10 *Priority Claim*

(a) Any declaration referred to in **Article 8(1)** ("priority claim") may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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- (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 party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;
  - (iv) where the earlier application is a regional application, the authority 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.
- (b) In addition to any indication required under **paragraph (a)(iv)** or **(v)**:
- (i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;
  - (ii) where the earlier application is a regional application and at least one of the countries party to the regional patent treaty is neither party to the Paris Convention for the Protection of Industrial Property nor a Member of the World Trade Organization, the priority claim shall indicate at least one country party to that Convention or one Member of that Organization for which that earlier application was filed.
- (c) For the purposes of **paragraphs (a)** and **(b)**, **Article 2(vi)** shall not apply.
- (d) If, on September 29, 1999, **paragraphs (a)** and **(b)** as amended with effect from January 1, 2000, are not compatible with the national law applied by a designated Office, those paragraphs as in force until December 31, 1999, shall continue to apply after that date in respect of that designated Office for as long as the said paragraphs as amended continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by October 31, 1999. The information received shall be promptly published by the International Bureau in the Gazette.

#### 4.11 *Reference to Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

- (i) the applicant intends to make an indication under **Rule 49bis.1(a)** or **(b)** of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (ii) the applicant intends to make an indication under **Rule 49bis.1(d)** of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall indicate the relevant parent application or parent patent or other parent grant.

- (b) The inclusion in the request of an indication under **paragraph (a)** shall have no effect on the operation of **Rule 4.9**.

## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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#### 4.12 *Taking into Account Results of Earlier Search*

If the applicant wishes the International Searching Authority to take into account, in carrying out the international search, the results of an earlier international, international-type or national search carried out by the same or another International Searching Authority or by a national Office (“earlier search”):

- (i) the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out;
- (ii) the request may, where applicable, contain a statement to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language.

#### 4.13 *[Deleted]*

#### 4.14 *[Deleted]*

#### 4.14bis *Choice of International Searching Authority*

If two or more International Searching Authorities are competent for the searching of the international application, the applicant shall indicate his choice of International Searching Authority in the request.

#### 4.15 *Signature*

- (a) Subject to **paragraph (b)**, the request shall be signed by the applicant or, if there is more than one applicant, by all of them.
- (b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.

#### 4.16 *Transliteration or Translation of Certain Words*

- (a) Where any name or address is written in characters other than those of the Latin alphabet, the same shall also be indicated in characters of the Latin alphabet either as a mere transliteration or through translation into English. The applicant shall decide which words will be merely transliterated and which words will be so translated.
- (b) The name of any country written in characters other than those of the Latin alphabet shall also be indicated in English.

#### 4.17 *Declarations Relating to National Requirements Referred to in **Rule 51bis.1(a)(i) to (v)***

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

- (i) a declaration as to the identity of the inventor, as referred to in **Rule 51bis.1(a)(i)**;

## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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- (ii) a declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent, as referred to in **Rule 51bis.1(a)(ii)**;
- (iii) a declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application, as referred to in **Rule 51bis.1(a)(iii)**;
- (iv) a declaration of inventorship, as referred to in **Rule 51bis.1(a)(iv)**, which shall be signed as prescribed by the Administrative Instructions;
- (v) a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, as referred to in **Rule 51bis.1(a)(v)**.

#### 4.18 *Statement of Incorporation by Reference*

Where the international application, on the date on which one or more elements referred to in **Article 11(1)(iii)** were first received by the receiving Office, claims the priority of an earlier application, the request may contain a statement that, where an element of the international application referred to in **Article 11(1)(iii)(d)** or **(e)** or a part of the description, claims or drawings referred to in **Rule 20.5(a)** is not otherwise contained in the international application but is completely contained in the earlier application, that element or part is, subject to confirmation under **Rule 20.6**, incorporated by reference in the international application for the purposes of **Rule 20.6**. Such a statement, if not contained in the request on that date, may be added to the request if, and only if, it was otherwise contained in, or submitted with, the international application on that date.

#### 4.19 *Additional Matter*

- (a) The request shall contain no matter other than that specified in **Rules 4.1** to **4.18**, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.
- (b) If the request contains matter other than that specified in **Rules 4.1** to **4.18** or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

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1 Editor's Note: This information is also published on the WIPO website at:  
**[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.3.6 Title of the invention

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 1 Who may file an international application with the EPO?

GA B 4 Incorporation by reference of missing parts and elements

GA B 7 Number of copies of documents filed

GA B 20 The PCT request

GA B 21 Designation of inventor

GA B 29 For which states may international applications be filed?

GA B 30 Non-designation for reasons of national law

GA B 32 Priority claim

GA B 35 The International Searching Authority (ISA)

GA B 36 Taking an earlier search into account

GA B 37 Refund of the search fee paid for a priority application

GA B 40 Signature

## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 5 Choice of ISA and consequences

GA C I 11 Refund of the search fee

GA C II 5 Incorporation by reference of missing parts and elements

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 3 Incorporation by reference of missing parts and elements

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XIII XIII.

#### **PCT Articles**

A.2 PCT Definitions

A.8 PCT Claiming Priority

A.11 PCT Filing Date and Effects of the International Application

A.43 PCT Seeking Certain Kinds of Protection

A.44 PCT Seeking Two Kinds of Protection

A.45 PCT Regional Patent Treaties

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.12bis PCT Copy of Results of Earlier Search and of Earlier Application; Translation

R.20 PCT International Filing Date

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.26bis PCT Correction or Addition of Priority Claim

R.26ter PCT Correction or Addition of Declarations under Rule 4.17

R.29 PCT International Applications Considered Withdrawn

R.37 PCT Missing or Defective Title

R.41 PCT Taking into Account Results of Earlier Search

R.48 PCT International Publication

R.49 PCT Copy, Translation and Fee under Article 22

R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

R.51bis PCT Certain National Requirements Allowed under Article 27

R.53 PCT The Demand

R.60 PCT Certain Defects in the Demand

R.82ter PCT Rectification of Errors Made by the Receiving Office or by the International Bureau

R.90 PCT Agents and Common Representatives

R.90bis PCT Withdrawals

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.019 What are the requirements with respect to the title of the invention?

PCT AG-IP 5.024 How must the applicant be identified?

PCT AG-IP 5.025 How must names be indicated in the request?

PCT AG-IP 5.027 How must addresses be indicated in the request?

PCT AG-IP 5.028 When is the indication of a telephone number, a facsimile number or an e-mail address recommended?

PCT AG-IP 5.030 May a special address be given for the sending of correspondence?

PCT AG-IP 5.035 When and how must the inventor be identified?

PCT AG-IP 5.038 What must be done if the inventors are not the same for all designated States?

PCT AG-IP 5.043 How is an agent to be appointed?

PCT AG-IP 5.051 When and how may a special address for correspondence be given?

PCT AG-IP 5.052 What is the designation of States?

PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?

PCT AG-IP 5.057 How may the priority of an earlier application be claimed?

PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?

PCT AG-IP 5.064 How should a request for the restoration of the right of priority be filed with the receiving Office?

PCT AG-IP 5.070 When and to whom must the priority document be furnished?

PCT AG-IP 5.072 Must an applicant indicate a choice of International Searching Authority?

PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search? What are the benefits of this for applicants?

PCT AG-IP 5.074 What declarations may be referred to in Box No. VIII and included in Boxes Nos. VIII(i) to (v)?

PCT AG-IP 5.075 What purpose do declarations referred to in Rule 4.17 serve?

PCT AG-IP 5.078 How must the declarations be presented in the request?

PCT AG-IP 5.080 Must the standardized wordings of declarations always be used?

PCT AG-IP 5.088 Who must sign the international application and when?

PCT AG-IP 5.089 May the international application be signed by an agent?

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.005 What are the conditions that must be fulfilled for the international application to be entitled to an international filing date?

PCT AG-IP 6.025 What defects influence the international filing date?

## A.4 PCT The Request

### R.4 PCT The Request (Contents)

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PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?

PCT AG-IP 6.028 How should missing elements or parts be incorporated by reference into the international application?

PCT AG-IP 6.032 What defects do not influence the international filing date?

PCT AG-IP 6.036 May the applicant correct indications of residence and nationality?

PCT AG-IP 6.041 Can the applicant be invited to correct defects in a priority claim?

PCT AG-IP 6.047 How should a correction or addition of a declaration referred to in Rule 4.17 be presented?

PCT AG-IP 6.049 What happens when the applicant fails to correct a declaration referred to in Rule 4.17 ?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.002 Which International Searching Authority is competent?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.017 How can the applicant receive notifications via e-mail?

PCT AG-IP 8.021 How can an agent receive notifications via e-mail?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.015 What constitutes international publication?

PCT AG-IP 9.023 How can copies of the priority document be obtained?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?

PCT AG-IP 10.021 When and how may an agent be appointed for the purposes of the procedure concerning the international preliminary examination?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.028 Can the international application proceed if an applicant/inventor for the United States of America refuses to sign the request or cannot be found or reached?

PCT AG-IP 11.031 Do similar provisions apply to excuse non-signature of other documents connected with the international application?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.002 When is an Office a designated Office?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.003 What must be done to prove inventorship, the right to file the application or the like?

PCT AG-NP 5.005 What can be done in the international phase to simplify the processing of international applications in the national phase?

#### **Case Law of the Enlarged Board**

G 2/02 International applications - priorities from India / Applicability of Article 87(5) EPC / The position under the PCT / [...]

G 3/02 International applications - priorities from India / Applicability of Article 87(5) EPC / The position under the PCT / [...]

#### **Case Law with Headnote**

J 15/80 Priority right / Deposit of industrial design / Industrial design/deposit of / Paris Convention and EPC

J 3/81 International application / Correction of mistake / Public interest / Reestablishment of rights / Payment of fee

J 2/92 Correction of particulars after publication / Errors of transcription - interest of third parties - apparent [...]

#### **General Case Law**

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

J 1/03 All due care required by the circumstances

## A.5 PCT The Description

The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 17 E-filing in pre-conversion format

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.094 How must the description be drafted?

**General Case Law**

W 21/04 Défaut d'unité d'invention à cause de l'omission d'une caractéristique dans les revendications telles qu'elles ont été [..]



## ***R.5 PCT The Description***

### ***5.1 Manner of the Description***

- (a) The description shall first state the title of the invention as appearing in the request and shall:
- (i) specify the technical field to which the invention relates;
  - (ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such art;
  - (iii) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;
  - (iv) briefly describe the figures in the drawings, if any;
  - (v) set forth at least the best mode contemplated by the applicant for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; where the national law of the designated State does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not), failure to describe the best mode contemplated shall have no effect in that State;
  - (vi) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry and the way in which it can be made and used, or, if it can only be used, the way in which it can be used; the term "industry" is to be understood in its broadest sense as in the Paris Convention for the Protection of Industrial Property.
- (b) The manner and order specified in **paragraph (a)** shall be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economic presentation.
- (c) Subject to the provisions of **paragraph (b)**, each of the parts referred to in **paragraph (a)** shall preferably be preceded by an appropriate heading as suggested in the Administrative Instructions.

### ***5.2 Nucleotide and/or Amino Acid Sequence Disclosure***

- (a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing complying with the standard provided for in the Administrative Instructions and presented as a separate part of the description in accordance with that standard.
- (b) Where the sequence listing part of the description contains any free text as defined in the standard provided for in the Administrative Instructions, that free text shall also appear in the main part of the description in the language thereof.

#### **EPO Guidelines - A Formalities Examination**

GL A IV 5.2 Sequence listings of an application filed by reference to a previously filed application

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.4.2 Sequence listings

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 39 Applications disclosing nucleotide and/or amino acid sequences

## A.5 PCT The Description

### R.5 PCT The Description

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#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 7 Nucleotide and amino acid sequences

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E VI 3 Nucleotide and amino acid sequences (Form 1200, Section 9)

#### **PCT Implementing Rules**

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

R.49 PCT Copy, Translation and Fee under Article 22

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.019 What are the requirements with respect to the title of the invention?

PCT AG-IP 5.094 How must the description be drafted?

PCT AG-IP 5.099 What special requirements apply to a nucleotide and/or amino acid sequence listing part of the description?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.005 What special requirements apply during the international search to a nucleotide and/or amino acid sequence listing?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.088 What special requirements apply to nucleotide and/or amino acid sequences disclosed in international applications?

#### **General Case Law**

T 211/06 Internal art and subjective / laboratory practice / - not prior art under Article 54(2) EPC, and not a possible [..]

## A.6 PCT The Claims

The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 17 E-filing in pre-conversion format

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 3 Multiple independent claims

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.112 How must claims be drafted?

**Case Law with Headnote**

W 31/88 Invitation to pay additional fees on the grounds of alleged lack of clarity

**General Case Law**

W 7/89 Invitation à payer fondée sur une objection d'absence d'unité de l'invention a priori et sur une allégation d'un  
[..]

W 21/04 Défaut d'unité d'invention à cause de l'omission d'une caractéristique dans les revendications telles qu'elles  
ont été [..]

## ***R.6 PCT The Claims***

### ***6.1 Number and Numbering of Claims***

- (a) The number of the claims shall be reasonable in consideration of the nature of the invention claimed.
- (b) If there are several claims, they shall be numbered consecutively in Arabic numerals.
- (c) The method of numbering in the case of the amendment of claims shall be governed by the Administrative Instructions.

### ***6.2 References to Other Parts of the International Application***

- (a) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings. In particular, they shall not rely on such references as: "as described in part ... of the description," or "as illustrated in figure ... of the drawings."
- (b) Where the international application contains drawings, the technical features mentioned in the claims shall preferably be followed by the reference signs relating to such features. When used, the reference signs shall preferably be placed between parentheses. If inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made. Reference signs may be removed by a designated Office for the purposes of publication by such Office.

### ***6.3 Manner of Claiming***

- (a) The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.
- (b) Whenever appropriate, claims shall contain:
  - (i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,
  - (ii) a characterizing portion-preceded by the words "characterized in that," "characterized by," "wherein the improvement comprises," or any other words to the same effect-stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.
- (c) Where the national law of the designated State does not require the manner of claiming provided for in **paragraph (b)**, failure to use that manner of claiming shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

### ***6.4 Dependent Claims***

- (a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as "dependent claim") shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such claims in the alternative only. Multiple dependent claims shall not serve as a basis for any other multiple dependent claim. Where the national law of the national Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in a manner different from that

provided for in the preceding two sentences, failure to use that manner of claiming may result in an indication under **Article 17(2)(b)** in the international search report. Failure to use the said manner of claiming shall have no effect in a designated State if the manner of claiming actually used satisfies the national law of that State.

(b) Any dependent claim shall be construed as including all the limitations contained in the claim to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.

(c) All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most practical way possible.

## 6.5 *Utility Models*

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of **Rules 6.1 to 6.4**, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under **Article 22** to adapt his application to the requirements of the said provisions of the national law.

### **PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

A.22 PCT Copy, Translation, and Fee, to Designated Offices

### **PCT Implementing Rules**

R.66 PCT Procedure before the International Preliminary Examining Authority

R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.112 How must claims be drafted?

### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.014 May the International Searching Authority refuse to search international applications which are unclear or have other defects?

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?

## A.7 PCT The Drawings

(1) Subject to the provisions of **paragraph (2)(ii)**, drawings shall be required when they are necessary for the understanding of the invention.

(2) Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings:

(i) the applicant may include such drawings in the international application when filed,

(ii) any designated Office may require that the applicant file such drawings with it within the prescribed time limit.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 3 Elements of the international application

GA B 7 Number of copies of documents filed

### **PCT Articles**

A.27 PCT National Requirements

### **PCT Implementing Rules**

R.7 PCT The Drawings

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.010 What are the elements of an international application?

PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?

## ***R.7 PCT The Drawings***

### ***7.1 Flow Sheets and Diagrams***

Flow sheets and diagrams are considered drawings.

### ***7.2 Time Limit***

The time limit referred to in **Article 7(2)(ii)** shall be reasonable under the circumstances of the case and shall, in no case, be shorter than two months from the date of the written invitation requiring the filing of drawings or additional drawings under the said provision.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 38 Applications containing a reference to biological material

**PCT Articles**

A.7 PCT The Drawings

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?

## ***R.8 PCT The Abstract***

### **8.1     *Contents and Form of the Abstract***

(a) The abstract shall consist of the following:

(i) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;

(ii) where applicable, the chemical formula which, among all the formulae contained in the international application, best characterizes the invention.

(b) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English).

(c) The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

(d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses.

### **8.2     *Figure***

(a) If the applicant fails to make the indication referred to in **Rule 3.3(a)(iii)**, or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to **paragraph (b)**, indicate the figure or figures which should accompany the abstract when the latter is published by the International Bureau. In such case, the abstract shall be accompanied by the figure or figures so indicated by the International Searching Authority. Otherwise, the abstract shall, subject to **paragraph (b)**, be accompanied by the figure or figures suggested by the applicant.

(b) If the International Searching Authority finds that none of the figures of the drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, the abstract, when published by the International Bureau, shall not be accompanied by any figure of the drawings even where the applicant has made a suggestion under **Rule 3.3(a)(iii)**.

### **8.3     *Guiding Principles in Drafting***

The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art, especially by assisting the scientist, engineer or researcher in formulating an opinion on whether there is a need for consulting the international application itself.

#### **EPO Guidelines - B Search**

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

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 7 Number of copies of documents filed

#### **PCT Implementing Rules**

R.3 PCT The Request (Form)

R.38 PCT Missing or Defective Abstract

R.48 PCT International Publication

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**



## A.7 PCT The Drawings

### R.8 PCT The Abstract

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PCT AG-IP 5.084 What is the purpose of the check list?

PCT AG-IP 5.164 How must the abstract be drafted?

PCT AG-IP 5.170 When must a figure be suggested to accompany the abstract?

**PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.032 What defects do not influence the international filing date?

## ***R.9 PCT Expressions, Etc., Not to Be Used***

### **9.1     *Definition***

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging *per se*);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

### **9.2     *Noting of Lack of Compliance***

The receiving Office and the International Searching Authority may note lack of compliance with the prescriptions of **Rule 9.1** and may suggest to the applicant that he voluntarily correct his international application accordingly. If the lack of compliance was noted by the receiving Office, that Office shall inform the competent International Searching Authority and the International Bureau; if the lack of compliance was noted by the International Searching Authority, that Authority shall inform the receiving Office and the International Bureau.

### **9.3     *Reference to Article 21(6)***

"Disparaging statements," referred to in **Article 21(6)**, shall have the meaning as defined in **Rule 9.1(iii)**.

#### **PCT Articles**

A.21 PCT International Publication

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

## ***R.10 PCT Terminology and Signs***

### 10.1 *Terminology and Signs*

(a) Units of weights and measures shall be expressed in terms of the metric system, or also expressed in such terms if first expressed in terms of a different system.

(b) Temperatures shall be expressed in degrees Celsius, or also expressed in degrees Fahrenheit, if first expressed in a different manner.

(c) *[Deleted]*

(d) For indications of heat, energy, light, sound, and magnetism, as well as for mathematical formulae and electrical units, the rules of international practice shall be observed; for chemical formulae, the symbols, atomic weights, and molecular formulae, in general use, shall be employed.

(e) In general, only such technical terms, signs and symbols should be used as are generally accepted in the art.

(f) When the international application or its translation is in Chinese, English or Japanese, the beginning of any decimal fraction shall be marked by a period, whereas, when the international application or its translation is in a language other than Chinese, English or Japanese, it shall be marked by a comma.

### 10.2 *Consistency*

The terminology and the signs shall be consistent throughout the international application.

#### **PCT Implementing Rules**

R.11 PCT Physical Requirements of the International Application

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.157 May symbols be used in drawings?

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

## ***R.11 PCT Physical Requirements of the International Application***

### ***11.1 Number of Copies***

(a) Subject to the provisions of **paragraph (b)**, the international application and each of the documents referred to in the check list (**Rule 3.3(a)(ii)**) shall be filed in one copy.

(b) Any receiving Office may require that the international application and any of the documents referred to in the check list (**Rule 3.3(a)(ii)**), except the receipt for the fees paid or the check for the payment of the fees, be filed in two or three copies. In that case, the receiving Office shall be responsible for verifying the identity of the second and the third copies with the record copy.

### ***11.2 Fitness for Reproduction***

(a) All elements of the international application (i.e., the request, the description, the claims, the drawings, and the abstract) shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset, and microfilming, in any number of copies.

(b) All sheets shall be free from creases and cracks; they shall not be folded.

(c) Only one side of each sheet shall be used.

(d) Subject to **Rule 11.10(d)** and **Rule 11.13(j)**, each sheet shall be used in an upright position (i.e., the short sides at the top and bottom).

### ***11.3 Material to Be Used***

All elements of the international application shall be on paper which shall be flexible, strong, white, smooth, non-shiny, and durable.

### ***11.4 Separate Sheets, Etc.***

(a) Each element (request, description, claims, drawings, abstract) of the international application shall commence on a new sheet.

(b) All sheets of the international application shall be so connected that they can be easily turned when consulted, and easily separated and joined again if they have been separated for reproduction purposes.

### ***11.5 Size of Sheets***

The size of the sheets shall be A4 (29.7 cm x 21 cm). However, any receiving Office may accept international applications on sheets of other sizes provided that the record copy, as transmitted to the International Bureau, and, if the competent International Searching Authority so desires, the search copy, shall be of A4 size.

### ***11.6 Margins***

(a) The minimum margins of the sheets containing the description, the claims, and the abstract, shall be as follows:

– top: 2 cm

## A.7 PCT The Drawings

### R.11 PCT Physical Requirements of the International Application

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- left side: 2.5 cm
- right side: 2 cm
- bottom: 2 cm.

(b) The recommended maximum, for the margins provided for in **paragraph (a)**, is as follows:

- top: 4 cm
- left side: 4 cm
- right side: 3 cm
- bottom: 3 cm.

(c) On sheets containing drawings, the surface usable shall not exceed 26.2 cm x 17.0 cm. The sheets shall not contain frames around the usable or used surface. The minimum margins shall be as follows:

- top: 2.5 cm
- left side: 2.5 cm
- right side: 1.5 cm
- bottom: 1 cm.

(d) The margins referred to in **paragraphs (a) to (c)** apply to A4-size sheets, so that, even if the receiving Office accepts other sizes, the A4-size record copy and, when so required, the A4-size search copy shall leave the aforesaid margins.

(e) Subject to **paragraph (f)** and to **Rule 11.8(b)**, the margins of the international application, when submitted, must be completely blank.

(f) The top margin may contain in the left-hand corner an indication of the applicant's file reference, provided that the reference appears within 1.5 cm from the top of the sheet. The number of characters in the applicant's file reference shall not exceed the maximum fixed by the Administrative Instructions.

#### 11.7 *Numbering of Sheets*

- (a) All the sheets contained in the international application shall be numbered in consecutive Arabic numerals.
- (b) The numbers shall be centered at the top or bottom of the sheet, but shall not be placed in the margin.

#### 11.8 *Numbering of Lines*

- (a) It is strongly recommended to number every fifth line of each sheet of the description, and of each sheet of claims.
- (b) The numbers should appear in the right half of the left margin.

11.9 *Writing of Text Matter*

- (a) The request, the description, the claims and the abstract shall be typed or printed.
- (b) Only graphic symbols and characters, chemical or mathematical formulae, and certain characters in the Chinese or Japanese language may, when necessary, be written by hand or drawn.
- (c) The typing shall be 1½-spaced
- (d) All text matter shall be in characters the capital letters of which are not less than 0.28 cm high, and shall be in a dark, indelible color, satisfying the requirements specified in **Rule 11.2**, provided that any text matter in the request may be in characters the capital letters of which are not less than 0.21 cm high.
- (e) As far as the spacing of the typing and the size of the characters are concerned, **paragraphs (c) and (d)** shall not apply to texts in the Chinese or Japanese language.

11.10 *Drawings, Formulae, and Tables, in Text Matter*

- (a) The request, the description, the claims and the abstract shall not contain drawings.
- (b) The description, the claims and the abstract may contain chemical or mathematical formulae.
- (c) The description and the abstract may contain tables; any claim may contain tables only if the subject matter of the claim makes the use of tables desirable.
- (d) Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

11.11 *Words in Drawings*

- (a) The drawings shall 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.
- (b) Any words used shall be so placed that, if translated, they may be pasted over without interfering with any lines of the drawings.

11.12 *Alterations, Etc.*

Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings, and interlineations. Non-compliance with this Rule may be authorized if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

11.13 *Special Requirements for Drawings*

- (a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colorings.

## A.7 PCT The Drawings

### R.11 PCT Physical Requirements of the International Application

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- (b) Cross-sections shall be indicated by oblique hatching which should not impede the clear reading of the reference signs and leading lines.
- (c) The scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty.
- (d) When, in exceptional cases, the scale is given on a drawing, it shall be represented graphically.
- (e) All numbers, letters and reference lines, appearing on the drawings, shall be simple and clear. Brackets, circles or inverted commas shall not be used in association with numbers and letters.
- (f) All lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments.
- (g) Each element of each figure shall 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.
- (h) The height of the numbers and letters shall not be less than 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.
- (i) The same 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 shall be so arranged that the complete figure can be assembled without concealing any part of any of the figures appearing on the various sheets.
- (j) The different figures shall be arranged on a sheet or sheets without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet.
- (k) The different figures shall be numbered in Arabic numerals consecutively and independently of the numbering of the sheets.
- (l) Reference signs not mentioned in the description shall not appear in the drawings, and vice versa.
- (m) The same features, when denoted by reference signs, shall, throughout the international application, be denoted by the same signs.
- (n) If the drawings contain a large number of reference signs, it is strongly recommended to attach a separate sheet listing all reference signs and the features denoted by them.

#### 11.14 *Later Documents*

**Rules 10, and 11.1 to 11.13**, also apply to any document—for example, replacement sheets, amended claims, translations—submitted after the filing of the international application.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 3 Elements of the international application

GA B 6 Filing options if the EPO is receiving Office

GA B 7 Number of copies of documents filed

#### **PCT Implementing Rules**

R.3 PCT The Request (Form)

R.10 PCT Terminology and Signs

R.21 PCT Preparation of Copies

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.49 PCT Copy, Translation and Fee under Article 22

## A.7 PCT The Drawings

### R.11 PCT Physical Requirements of the International Application

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R.55 PCT Languages (International Preliminary Examination)

R.92 PCT Correspondence

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.012 How must the sheets of an international application be numbered?

PCT AG-IP 5.018 Physical Requirements.

PCT AG-IP 5.105 What are the physical requirements for the description?

PCT AG-IP 5.106 How should the pages and lines be numbered?

PCT AG-IP 5.107 How are chemical or mathematical formulae to be represented?

PCT AG-IP 5.109 How are tables to be represented?

PCT AG-IP 5.124 What are the physical requirements for the claims?

PCT AG-IP 5.125 May claims include tables?

PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?

PCT AG-IP 5.131 How must the drawings be presented?

PCT AG-IP 5.134 Should figures of drawings be arranged in a particular manner?

PCT AG-IP 5.140 How must drawings be numbered?

PCT AG-IP 5.143 How should drawings be executed?

PCT AG-IP 5.147 How are cross-sections to be represented?

PCT AG-IP 5.150 What should be the scale of figures of the drawings?

PCT AG-IP 5.152 How should numbers, letters, reference signs and like indications be presented and applied to drawings?

PCT AG-IP 5.156 May drawings contain text matter?

PCT AG-IP 5.160 May a list of reference signs used in the drawings be included in the description?

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

PCT AG-IP 5.179 In how many copies must an international application be filed?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.002 What are the additional procedural steps at the receiving Office for processing a request form print-out prepared using the PCT-SAFE software?

PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?

PCT AG-IP 6.032 What defects do not influence the international filing date?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.092 What is the effect of an extension?

PCT AG-IP 11.095 Can defects in the filing of request form print-outs generated using the PCT-SAFE software be corrected?

PCT AG-IP 11.100 What happens when the request form print-out is not in the format provided by the PCT-SAFE software but it is filed with a corresponding diskette?



***R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication***

12.1 *Languages Accepted for the Filing of International Applications*

- (a) An international application shall be filed in any language which the receiving Office accepts for that purpose.
- (b) Each receiving Office shall, for the filing of international applications, accept at least one language which is both:
  - (i) a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and
  - (ii) a language of publication.
- (c) Notwithstanding **paragraph (a)**, the request shall be filed in any language of publication which the receiving Office accepts for the purposes of this paragraph.
- (d) Notwithstanding **paragraph (a)**, any text matter contained in the sequence listing part of the description referred to in **Rule 5.2(a)** shall be presented in accordance with the standard provided for in the Administrative Instructions.

12.1bis *Language of Elements and Parts Furnished under Rule 20.3, 20.5 or 20.6*

An element referred to in **Article 11(1)(iii)(d)** or **(e)** furnished by the applicant under **Rule 20.3(b)** or **20.6(a)** and a part of the description, claims or drawings furnished by the applicant under **Rule 20.5(b)** or **20.6(a)** shall be in the language of the international application as filed or, where a translation of the application is required under **Rule 12.3(a)** or **12.4(a)**, in both the language of the application as filed and the language of that translation.

12.1ter *Language of Indications Furnished under Rule 13bis.4*

Any indication in relation to deposited biological material furnished under **Rule 13bis.4** shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under **Rule 12.3(a)** or **12.4(a)**, any such indication shall be furnished in both the language in which the application is filed and the language of that translation.

12.2 *Language of Changes in the International Application*

- (a) Any amendment of the international application shall, subject to **Rules 46.3** and **55.3**, be in the language in which the application is filed.
- (b) Any rectification under **Rule 91.1** of an obvious mistake in the international application shall be in the language in which the application is filed, provided that:
  - (i) where a translation of the international application is required under **Rule 12.3(a)**, **12.4(a)** or **55.2(a)**, rectifications referred to in **Rule 91.1(b)(ii)** and **(iii)** shall be filed in both the language of the application and the language of that translation;

## A.7 PCT The Drawings

### R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

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(ii) where a translation of the request is required under **Rule 26.3ter(c)**, rectifications referred to in **Rule 91.1(b)(i)** need only be filed in the language of that translation.

(c) Any correction under **Rule 26** of a defect in the international application shall be in the language in which the international application is filed. Any correction under **Rule 26** of a defect in a translation of the international application furnished under **Rule 12.3** or **12.4**, any correction under **Rule 55.2(c)** of a defect in a translation furnished under **Rule 55.2(a)**, or any correction of a defect in a translation of the request furnished under **Rule 26.3ter(c)**, shall be in the language of the translation.

#### 12.3 *Translation for the Purposes of International Search*

(a) Where the language in which the international application is filed is not accepted by the International Searching Authority that is to carry out the international search, the applicant shall, within one month from the date of receipt of the international application by the receiving Office, furnish to that Office a translation of the international application into a language which is all of the following:

(i) a language accepted by that Authority, and

(ii) a language of publication, and

(iii) a language accepted by the receiving Office under **Rule 12.1(a)**, unless the international application is filed in a language of publication.

(b) **Paragraph (a)** shall not apply to the request nor to any sequence listing part of the description.

(c) Where, by the time the receiving Office sends to the applicant the notification under **Rule 20.2(c)**, the applicant has not furnished a translation required under **paragraph (a)**, the receiving Office shall, preferably together with that notification, invite the applicant:

(i) to furnish the required translation within the time limit under **paragraph (a)**;

(ii) in the event that the required translation is not furnished within the time limit under **paragraph (a)**, to furnish it and to pay, where applicable, the late furnishing fee referred to in **paragraph (e)**, within one month from the date of the invitation or two months from the date of receipt of the international application by the receiving Office, whichever expires later.

(d) Where the receiving Office has sent to the applicant an invitation under **paragraph (c)** and the applicant has not, within the applicable time limit under **paragraph (c)(ii)**, furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the receiving Office shall so declare. Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 15 months from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation after the expiration of the time limit under **paragraph (a)** may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 25% of the international filing fee referred to in item 1 of the **Schedule of Fees**, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

#### 12.4 *Translation for the Purposes of International Publication*

## A.7 PCT The Drawings

### R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

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(a) Where the language in which the international application is filed is not a language of publication and no translation is required under **Rule 12.3(a)**, the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into any language of publication which the receiving Office accepts for the purposes of this paragraph.

(b) **Paragraph (a)** shall not apply to the request nor to any sequence listing part of the description.

(c) Where the applicant has not, within the time limit referred to in **paragraph (a)**, furnished a translation required under that paragraph, the receiving Office shall invite the applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee required under **paragraph (e)**, within 16 months from the priority date. Any translation received by the receiving Office before that Office sends the invitation under the previous sentence shall be considered to have been received before the expiration of the time limit under **paragraph (a)**.

(d) Where the applicant has not, within the time limit under **paragraph (c)**, furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the receiving Office shall so declare. Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 17 months from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation after the expiration of the time limit under **paragraph (a)** may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 25% of the international filing fee referred to in item 1 of the **Schedule of Fees**, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 41 Language of the international application

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 6 Translation

GA C I 8 Application filed in Dutch

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 16 Applications filed in Dutch

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E VI 3 Nucleotide and amino acid sequences (Form 1200, Section 9)

#### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

#### **PCT Implementing Rules**

R.5 PCT The Description

R.13bis PCT Inventions Relating to Biological Material

R.19 PCT The Competent Receiving Office

R.20 PCT International Filing Date

R.22 PCT Transmittal of the Record Copy and Translation

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.29 PCT International Applications Considered Withdrawn

R.43 PCT The International Search Report

R.45bis PCT Supplementary International Searches

R.46 PCT Amendment of Claims before the International Bureau

R.48 PCT International Publication

R.49 PCT Copy, Translation and Fee under Article 22

R.55 PCT Languages (International Preliminary Examination)

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.013 What language must be used for an international application?

PCT AG-IP 5.179 In how many copies must an international application be filed?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.005 What are the conditions that must be fulfilled for the international application to be entitled to an international filing date?

PCT AG-IP 6.013 When is a translation of the international application required?

## A.7 PCT The Drawings

### R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

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PCT AG-IP 6.014 What are the translation requirements if the international application is filed in a language which is not accepted by the International Searching Authority?

PCT AG-IP 6.019 What are the translation requirements if the request is in a language which is not a language of publication accepted by the receiving Office for the purpose of filing the

PCT AG-IP 6.020 What are the translation requirements if the international application is filed in a language which is accepted by the International Searching Authority, but is not a language of publication?

PCT AG-IP 6.032 What defects do not influence the international filing date?

PCT AG-IP 6.059 How does the search copy reach the International Searching Authority?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.023 Where should the language, for the purposes of supplementary international search, be indicated?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?

PCT AG-IP 11.078 What are the indications which must be given in the reference with regard to the deposit of biological material?

#### **Case Law of the Enlarged Board**

G 4/08 Langue de la Procédure

#### **General Case Law**

J 3/00 Rectification of errors made by a PCT Receiving Office (PCT Rule 82 ter) / Protection of legitimate expectations

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation  
[..]

#### **General Case Law**

T 353/03 Right to be heard - no (claims amended substantially) / Insufficient reasoning of decision / Errors in the translation  
[..]

***R.12bis PCT Copy of Results of Earlier Search and of Earlier Application;  
Translation***

*12bis.1 Copy of Results of Earlier Search and of Earlier Application; Translation*

- (a) Where the applicant has, under **Rule 4.12**, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to **paragraphs (c) to (f)**, submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.
- (b) The International Searching Authority may, subject to paragraphs (c) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:
- (i) a copy of the earlier application concerned;
  - (ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;
  - (iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;
  - (iv) a copy of any document cited in the results of the earlier search.
- (c) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copies referred to in **paragraphs (a) and (b)(i) and (iv)**, indicate the wish that the receiving Office prepare and transmit them to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.
- (d) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy or translation referred to in **paragraphs (a) and (b)** shall be required to be submitted under those paragraphs.
- (e) Where the request contains a statement under **Rule 4.12(ii)** to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in **paragraphs (b)(i) and (ii)** shall be required to be submitted under those paragraphs.
- (f) Where a copy or translation referred to in **paragraphs (a) and (b)** is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library or in the form of the priority document, and the applicant so indicates in the request, no copy or translation shall be required to be submitted under those paragraphs.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 37 Refund of the search fee paid for a priority application

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 11 Refund of the search fee

**PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.12bis PCT Copy of Results of Earlier Search and of Earlier Application; Translation

R.41 PCT Taking into Account Results of Earlier Search

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search?  
What are the benefits of this for applicants?

## ***R.13 PCT Unity of Invention***

### **13.1 Requirement**

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

### **13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled**

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in **Rule 13.1** shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

### **13.3 Determination of Unity of Invention Not Affected by Manner of Claiming**

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

### **13.4 Dependent Claims**

Subject to **Rule 13.1**, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

### **13.5 Utility Models**

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of **Rules 13.1 to 13.4**, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under **Article 22** to adapt his application to the requirements of the said provisions of the national law.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 8 Lack of unity of invention

#### **PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

#### **PCT Implementing Rules**

R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.114 What is meant by the requirement of "unity of invention"?

PCT AG-IP 5.115 How is the requirement of unity of invention satisfied?

PCT AG-IP 5.116 May different categories of claims be combined in an international application?

PCT AG-IP 5.118 What is permitted under the "Markush Practice"?

PCT AG-IP 5.121 Can both intermediate and final products be claimed?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.015 What is the purpose of the requirement of "unity of invention"?

PCT AG-IP 7.016 What happens where the International Searching Authority considers that the international application does not meet the requirement of unity of invention?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.044 What will happen where the main International Searching Authority finds that the international application

## A.7 PCT The Drawings

### R.13 PCT Unity of Invention

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does not comply with the requirement of unity of invention?

#### **Case Law of the Enlarged Board**

G 1/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

G 2/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

#### **Case Law with Headnote**

T 631/97 Non-payment of further search fees

W 7/85 Unity of invention - mixture and component

#### **General Case Law**

W 3/87 Einheitlichkeit abhängiger Ansprüche

W 2/88 Single general inventive concept (no)

#### **Case Law with Headnote**

W 3/88 Unity a posteriori / Invitation to pay additional fees following a posteriori examination of unity of invention (no) / [...]

#### **General Case Law**

W 29/88 Unity of invention - identity of structural scope in claims of different categories

#### **Case Law with Headnote**

W 31/88 Invitation to pay additional fees on the grounds of alleged lack of clarity

W 32/88 Apparatus specifically designed for carrying out a process / Process - apparatus / Apparatus - other applications

#### **General Case Law**

W 35/88 Nichteinheitlichkeit a posteriori - Begründung in der Aufforderung nach R.40 PCT

#### **Case Law with Headnote**

W 44/88 Admissibility of an "a posteriori" objection of lack of unity (yes) / Single general inventive concept (yes)

#### **General Case Law**

W 3/89 Unity of Invention - the possibilities of R. 13.2 are not exhaustive / Intermediate and process for obtaining it are [...]

W 7/89 Invitation à payer fondée sur une objection d'absence d'unité de l'invention a priori et sur une allégation d'un [...]

W 11/89 Uneinheitlichkeit - Hervorhebung von Worten durch Unterstreichung bei Aufzählung - Begründungsmangel - Aufforderung [...]

W 13/89 Unity of invention (yes)

W 16/89 Unity of Invention - Method and devices (yes)

W 17/89 Lack of unity (no)

W 19/89 Non-unity a posteriori (yes) / Reimbursement of the additional search fees (yes) / Inventions conceptually closely [...]

W 27/89 Nichteinheitlichkeit a posteriori in klaren Fällen (bejaht), Begründung der Zahlungsaufforderung

W 30/89 Aufforderung zur Zahlung - nicht begründet / Uneinheitlichkeit a priori - nein / Abhängige Ansprüche - Aggregation von [...]

W 32/89 Unité d'invention de revendications dépendante (non)

#### **Case Law with Headnote**

W 6/90 A priori absence of unity / Single general concept not inventive

#### **General Case Law**

W 18/90 -

W 19/90 Nicht-Einheitlichkeit a posteriori (bejaht)

W 24/90 Uneinheitlichkeit a posteriori (verneint)

W 26/90 Lack of unity a priori between the independent claims / No clear case for lack of unity a posteriori for dependent [...]

W 36/90 Non-unity a posteriori (no)

W 38/90 Unity a priori (no)

W 39/90 No lack of unity a priori between the independent claims

W 48/90 a priori lack of unity of invention (confirmed)

W 59/90 Begründung mangelnder Einheitlichkeit a priori mit mangelnder Klarheit unzulässig / Begründungsmangel / Beurteilung [...]

W 6/91 Determination of the technical problem as precondition for assessment of unity of invention / Failure to determine the [...]

W 8/91 Uneinheitlichkeit a posteriori - nicht begründet

W 14/91 Uneinheitlichkeit a posteriori - nicht begründet

W 16/91 Uneinheitlichkeit a priori (verneint) / Mangelnde Begründung

W 17/91 Lack of unity a posteriori / Insufficient reasons in the invitation

W 21/91 Uneinheitlichkeit a priori (nein) - zusammenhängende Erfindungen

W 22/91 Lack of unity a posteriori (no)

W 23/91 Lack of unity a posteriori / No examination of inventive step in cases that are not clear / Non-unity not established [...]

W 28/91 Non-unity a priori (no) / Second medical indication for compounds of a general formula and first medical indication [...]

W 31/91 Non-unity a posteriori - yes

W 35/91 Non-unity of invention a priori (no) / Structural relationship between compounds / Structural relationship between [...]

W 52/91 Einheitlichkeit a priori (nein)

W 54/91 Lack of unity a priori

W 5/92 Lack of unity a priori (yes)

W 10/92 Frage der Einheitlichkeit a posteriori kein klarer Fall - Rückzahlung der zusätzlichen Recherchegebühr



## A.7 PCT The Drawings

### R.13 PCT Unity of Invention

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W 22/92 Non-unity a priori - partially contested - unity of invention acknowledged to the extent requested in the protest  
W 29/92 Lack of unity (no); inadequate reasons / Unity of invention acknowledged to the extent requested in the protest

#### **Case Law with Headnote**

W 32/92 Uneinheitlichkeit a posteriori (bejaht)

#### **General Case Law**

W 34/92 -

W 38/92 Lack of unity (no); inadequate reasons

W 40/92 Einheitlichkeit a priori (ja)

W 45/92 Lack of unity a posteriori

W 52/92 Lack of unity a priori (no)

W 9/93 Different problems / Different solutions / Common inventive concept (no)

W 1/94 Non-unité a postérieure (non) - activité commune

#### **Case Law with Headnote**

W 3/94 Begründungspflicht nach R. 40.1 PCT im Hinblick auf die Vorschriften in den PCT-Richtlinien nicht erfüllt

#### **General Case Law**

W 8/94 Invitation to pay an additional search fee - not sufficiently motivated and not justified

W 2/95 Einheitlichkeit der Erfindungen von Produkt und Verfahren zu dessen Herstellung beim Fehlen wörtlich gleicher [...]

W 6/95 Common new property (yes) / Significant structural element (yes)

W 1/96 -

#### **Case Law with Headnote**

W 4/96 Lack of unity a posteriori - yes / Absence of a common technical feature defining a contribution of the claimed [...]

W 1/97 -

#### **General Case Law**

W 6/97 Lack of unity of invention a posteriori - not established / Determination of single general inventive concept / [...]

W 6/98 Lack of unity of invention a posteriori - not established / Insufficient reasoning / IPEA

#### **Case Law with Headnote**

W 11/99 Einheitlichkeit zwischen Verfahrens- und Produktansprüchen und zwischen Produktansprüchen untereinander - ja

#### **General Case Law**

W 18/01 Lack of unity a posteriori - Invitation to pay additional fee - sufficiently reasoned (no)

W 9/02 Unity-protest partially justified (Reimbursement of one additional search fee) / Clarity objections to be [...]

W 9/03 Einheitlichkeit a posteriori (nein)

W 17/03 Invitation to pay additional fees sufficiently reasoned (yes) / Investigation of technical relationships with the aid [...]

W 21/04 Défaut d'unité d'invention à cause de l'omission d'une caractéristique dans les revendications telles qu'elles ont été [...]

W 20/06 Competence of the Boards of Appeal for examining the protest (yes) / Protest fee duly paid (yes) / Admissibility of [...]

W 6/07 -

### ***R.13bis PCT Inventions Relating to Biological Material***

#### ***13bis.1 Definition***

For the purposes of this Rule, "reference to deposited biological material" means particulars given in an international application with respect to the deposit of biological material with a depositary institution or to the biological material so deposited.

#### ***13bis.2 References (General)***

Any reference to deposited biological material shall be made in accordance with this Rule and, if so made, shall be considered as satisfying the requirements of the national law of each designated State.

#### ***13bis.3 References: Contents; Failure to Include Reference or Indication***

(a) A reference to deposited biological material shall indicate:

- (i) the name and the address of the depositary institution with which the deposit was made;
  - (ii) the date of deposit of the biological material with that institution;
  - (iii) the accession number given to the deposit by that institution; and
  - (iv) any additional matter of which the International Bureau has been notified pursuant to **Rule 13bis.7(a)(i)**, provided that the requirement to indicate that matter was published in the Gazette in accordance with **Rule 13bis.7(c)** at least two months before the filing of the international application.
- (b) Failure to include a reference to deposited biological material or failure to include, in a reference to deposited biological material, an indication in accordance with **paragraph (a)**, shall have no consequence in any designated State whose national law does not require such reference or such indication in a national application.

#### ***13bis.4 References: Time Limit for Furnishing Indications***

(a) Subject to **paragraphs (b) and (c)**, if any of the indications referred to in **Rule 13bis.3(a)** is not included in a reference to deposited biological material in the international application as filed but is furnished to the International Bureau:

- (i) within 16 months from the priority date, the indication shall be considered by any designated Office to have been furnished in time;
  - (ii) after the expiration of 16 months from the priority date, the indication shall be considered by any designated Office to have been furnished on the last day of that time limit if it reaches the International Bureau before the technical preparations for international publication have been completed.
- (b) If the national law applicable by a designated Office so requires in respect of national applications, that Office may require that any of the indications referred to in **Rule 13bis.3(a)** be furnished earlier than 16 months from the priority date, provided that the International Bureau has been notified of such requirement pursuant to **Rule 13bis.7(a)(ii)** and has published such requirement in the Gazette in accordance with **Rule 13bis.7(c)** at least two months before the filing of the international application.

## A.7 PCT The Drawings

### R.13bis PCT Inventions Relating to Biological Material

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(c) Where the applicant makes a request for early publication under **Article 21(2)(b)**, any designated Office may consider any indication not furnished before the technical preparations for international publication have been completed as not having been furnished in time.

(d) The International Bureau shall notify the applicant of the date on which it received any indication furnished under **paragraph (a)**, and:

(i) if the indication was received before the technical preparations for international publication have been completed, publish the indication furnished under **paragraph (a)**, and an indication of the date of receipt, together with the international application;

(ii) if the indication was received after the technical preparations for international publication have been completed, notify that date and the relevant data from the indication to the designated Offices.

#### *13bis.5 References and Indications for the Purposes of One or More Designated States; Different Deposits for Different Designated States; Deposits with Depositary Institutions Other than Those Notified*

(a) A reference to deposited biological material shall be considered to be made for the purposes of all designated States, unless it is expressly made for the purposes of certain of the designated States only; the same applies to the indications included in the reference.

(b) References to different deposits of the biological material may be made for different designated States.

(c) Any designated Office may disregard a deposit made with a depositary institution other than one notified by it under **Rule 13bis.7(b)**.

#### *13bis.6 Furnishing of Samples*

Pursuant to **Articles 23** and **40**, no furnishing of samples of the deposited biological material to which a reference is made in an international application shall, except with the authorization of the applicant, take place before the expiration of the applicable time limits after which national processing may start under the said Articles. However, where the applicant performs the acts referred to in **Articles 22** or **39** after international publication but before the expiration of the said time limits, the furnishing of samples of the deposited biological material may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples of the deposited biological material may take place under the national law applicable by any designated Office as soon as, under that law, the international publication has the effects of the compulsory national publication of an unexamined national application.

#### *13bis.7 National Requirements: Notification and Publication*

(a) Any national Office may notify the International Bureau of any requirement of the national law:

(i) that any matter specified in the notification, in addition to those referred to in **Rule 13bis.3(a)(i)**, **(ii)** and **(iii)**, is required to be included in a reference to deposited biological material in a national application;

(ii) that one or more of the indications referred to in **Rule 13bis.3(a)** are required to be included in a national application as filed or are required to be furnished at a time specified in the notification which is earlier than 16 months from the priority date.

## A.7 PCT The Drawings

### R.13bis PCT Inventions Relating to Biological Material

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(b) Each national Office shall notify the International Bureau of the depositary institutions with which the national law permits deposits of biological materials to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) The International Bureau shall promptly publish in the Gazette requirements notified to it under **paragraph (a)** and information notified to it under **paragraph (b)**.

#### **EPO Guidelines - F The European Patent Application**

GL F III 6.5 Euro-PCT cases

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 38 Applications containing a reference to biological material

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E V 3 What the translation must include

GA E VI 1 Biological material (Form 1200, Section 8)

#### **PCT Articles**

A.21 PCT International Publication

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.23 PCT Delaying of National Procedure

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.40 PCT Delaying of National Examination and Other Processing

#### **PCT Implementing Rules**

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.48 PCT International Publication

R.49 PCT Copy, Translation and Fee under Article 22

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.084 What is the purpose of the check list?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.075 When must an international application include a reference to biological material and/or to its deposit with a depositary institution?

PCT AG-IP 11.076 What effect does the PCT give to such a reference?

PCT AG-IP 11.077 May the reference be made for the purposes of only some of the designated States?

PCT AG-IP 11.078 What are the indications which must be given in the reference with regard to the deposit of biological material?

PCT AG-IP 11.079 What are the indications concerning biological material itself which must be given in the reference?

PCT AG-IP 11.080 At what time must the reference (with the indications which must be contained therein) be made?

PCT AG-IP 11.081 What is the consequence of failure to furnish an indication on time?

PCT AG-IP 11.083 How does the applicant decide on the depositary institution with which to deposit the biological material?

PCT AG-IP 11.085 Does a reference in an international application to the deposit of biological material involve the possibility of a sample being obtained by the International Searching Authority or the International Preliminary Examining Authority?

PCT AG-IP 11.086 What possibility is there, when a reference is made in an international application to the deposit of biological material, of third persons obtaining a sample?

***R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings*****13ter.1**     *Procedure before the International Searching Authority*

- (a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, unless such listing in electronic form is already available to it in a form and manner acceptable to it, and to pay to it, where applicable, the late furnishing fee referred to in **paragraph (c)**, within a time limit fixed in the invitation.
- (b) Where at least part of the international application is filed on paper and the International Searching Authority finds that the description does not comply with **Rule 5.2(a)**, it may invite the applicant to furnish, for the purposes of the international search, a sequence listing in paper form complying with the standard provided for in the Administrative Instructions, unless such listing in paper form is already available to it in a form and manner acceptable to it, whether or not the furnishing of a sequence listing in electronic form is invited under **paragraph (a)**, and to pay, where applicable, the late furnishing fee referred to in **paragraph (c)**, within a time limit fixed in the invitation.
- (c) The furnishing of a sequence listing in response to an invitation under **paragraph (a)** or **(b)** may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets, provided that a late furnishing fee may be required under either **paragraph (a)** or **(b)** but not both.
- (d) If the applicant does not, within the time limit fixed in the invitation under **paragraph (a)** or **(b)**, furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only be required to search the international application to the extent that a meaningful search can be carried out without the sequence listing.
- (e) Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under **paragraph (a)** or **(b)** or otherwise, shall not form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to **Article 34(2)(b)**.
- (f) Where the International Searching Authority finds that the description does not comply with **Rule 5.2(b)**, it shall invite the applicant to submit the required correction. **Rule 26.4** shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

**13ter.2**     *Procedure before the International Preliminary Examining Authority*

**Rule 13ter.1** shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

**13ter.3**     *Sequence Listing for Designated Office*

No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

## A.7 PCT The Drawings

### R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

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#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 39 Applications disclosing nucleotide and/or amino acid sequences

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 7 Nucleotide and amino acid sequences

GA C IV 3 Requirements for filing a SIS request

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 16 Nucleotide and amino acid sequences

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E V 3 What the translation must include

GA E VI 3 Nucleotide and amino acid sequences (Form 1200, Section 9)

#### **PCT Articles**

A.34 PCT Procedure Before the International Preliminary Examining Authority

#### **PCT Implementing Rules**

R.5 PCT The Description

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.45bis PCT Supplementary International Searches

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.099 What special requirements apply to a nucleotide and/or amino acid sequence listing part of the description?

PCT AG-IP 5.100 How can an international application containing a sequence listing be filed?

PCT AG-IP 5.101 How is the fee for filing sequence listings calculated?

PCT AG-IP 5.102 How should the applicant proceed where the international application is filed on paper and a sequence listing, not forming part of the international application, is to be furnished in electronic form for the purposes of [...]

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.005 What special requirements apply during the international search to a nucleotide and/or amino acid sequence listing?

PCT AG-IP 7.006 Can the International Searching Authority require a sequence listing to be provided in electronic form?

PCT AG-IP 7.010 What is the procedure for furnishing a sequence listing upon invitation?

PCT AG-IP 7.011 Does a sequence listing furnished to the International Searching Authority form part of the international application?

PCT AG-IP 7.012 Will a sequence listing furnished to the International Searching Authority also meet any requirements of the International Preliminary Examining Authority or, in the national phase, of a designated Office?

PCT AG-IP 7.013 May the International Searching Authority refuse to search certain subject matter?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.012 Which documents, other than the supplementary search request must be submitted?

PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.063 What special requirements apply during the international preliminary examination to nucleotide and/or amino acid sequence listings?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.088 What special requirements apply to nucleotide and/or amino acid sequences disclosed in international applications?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.033 What requirements need to be satisfied in relation to the furnishing of a sequence listing?

## ***R.14 PCT The Transmittal Fee***

### **14.1     *The Transmittal Fee***

- (a) Any receiving Office may require that the applicant pay a fee to it, for its own benefit, for receiving the international application, transmitting copies to the International Bureau and the competent International Searching Authority, and performing all the other tasks which it must perform in connection with the international application in its capacity of receiving Office ("transmittal fee").
- (b) The amount of the transmittal fee, if any, shall be fixed by the receiving Office.
- (c) The transmittal fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 42 Fees

GA B 43 Amounts of fees

#### **PCT Implementing Rules**

R.16bis PCT Extension of Time Limits for Payment of Fees

R.19 PCT The Competent Receiving Office

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.27 PCT Lack of Payment of Fees

R.88 PCT Amendment of the Regulations

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.184 What fees are due in respect of an international application?

PCT AG-IP 5.185 To whom are the fees payable?

PCT AG-IP 5.186 What is the currency in which the fees are payable?

PCT AG-IP 5.187 What are the amounts of the fees?

PCT AG-IP 5.191 When are the fees due?

### ***R.15 PCT The International Filing Fee***

#### **15.1**     *The International Filing Fee*

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international filing fee") to be collected by the receiving Office.

#### **15.2**     *Amount*

- (a) The amount of the international filing fee is as set out in the **Schedule of Fees**.
- (b) The international filing fee shall be payable in the currency or one of the currencies prescribed by the receiving Office ("prescribed currency").
- (c) Where the prescribed currency is the Swiss franc, the receiving Office shall promptly transfer the said fee to the International Bureau in Swiss francs.
- (d) Where the prescribed currency is a currency other than the Swiss franc and that currency:
  - (i) is freely convertible into Swiss francs, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the international filing fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Bureau;
  - (ii) is not freely convertible into Swiss francs, the receiving Office shall be responsible for the conversion of the international filing fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the **Schedule of Fees**, to the International Bureau. Alternatively, if the receiving Office so wishes, it may convert the international filing fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.

#### **15.3**     *Time Limit for Payment; Amount Payable*

The international filing fee shall be paid to the receiving Office within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

#### **15.4**     *Refund*

The receiving Office shall refund the international filing fee to the applicant:

- (i) if the determination under **Article 11(1)** is negative,
- (ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn, or
- (iii) if, due to prescriptions concerning national security, the international application is not treated as such.



## A.7 PCT The Drawings

### R.15 PCT The International Filing Fee

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#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 42 Fees

GA B 43 Amounts of fees

#### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

#### **PCT Implementing Rules**

R.16 PCT The Search Fee

R.16bis PCT Extension of Time Limits for Payment of Fees

R.19 PCT The Competent Receiving Office

R.27 PCT Lack of Payment of Fees

R.96 PCT The Schedule of Fees

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.184 What fees are due in respect of an international application?

PCT AG-IP 5.185 To whom are the fees payable?

PCT AG-IP 5.186 What is the currency in which the fees are payable?

PCT AG-IP 5.187 What are the amounts of the fees?

PCT AG-IP 5.191 When are the fees due?

PCT AG-IP 5.192 What happens if the amounts of the fees are changed?

PCT AG-IP 5.197 In what cases are fees refunded?

### ***R.16 PCT The Search Fee***

#### **16.1**     *Right to Ask for a Fee*

(a) Each International Searching Authority may require that the applicant pay a fee ("search fee") for its own benefit for carrying out the international search and for performing all other tasks entrusted to International Searching Authorities by the Treaty and these Regulations.

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency prescribed by that Office ("prescribed currency").

(c) Where the prescribed currency is the currency in which the International Searching Authority has fixed the said fee ("fixed currency"), the receiving Office shall promptly transfer the said fee to that Authority in that currency.

(d) Where the prescribed currency is not the fixed currency and that currency:

(i) is freely convertible into the fixed currency, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the search fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Searching Authority;

(ii) is not freely convertible into the fixed currency, the receiving Office shall be responsible for the conversion of the search fee from the prescribed currency into the fixed currency and shall promptly transfer that fee in the fixed currency, in the amount fixed by the International Searching Authority, to the International Searching Authority.

(e) Where, in respect of the payment of the search fee in a prescribed currency, other than the fixed currency, the amount actually received under **paragraph (d)(i)** of this Rule by the International Searching Authority in the prescribed currency is, when converted by it into the fixed currency, less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) As to the time limit for payment of the search fee and the amount payable, the provisions of **Rule 15.3** relating to the international filing fee shall apply *mutatis mutandis*.

#### **16.2**     *Refund*

The receiving Office shall refund the search fee to the applicant:

(i) if the determination under **Article 11(1)** is negative,

(ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn, or

(iii) if, due to prescriptions concerning national security, the international application is not treated as such.

#### **16.3**     *Partial Refund*

## A.7 PCT The Drawings

### R.16 PCT The Search Fee

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Where the International Searching Authority takes into account, under **Rule 41.1**, the results of an earlier search in carrying out the international search, that Authority shall refund the search fee paid in connection with the international application to the extent and under the conditions provided for in the agreement under **Article 16(3)(b)**.

#### **EPC Rules relating to Fees**

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

#### **EPO Guidelines - A Formalities Examination**

GL A X 10.2.3 Refund of the international search fee

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 37 Refund of the search fee paid for a priority application

GA B 42 Fees

GA B 43 Amounts of fees

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 11 Refund of the search fee

#### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

A.16 PCT The International Searching Authority

#### **PCT Implementing Rules**

R.15 PCT The International Filing Fee

R.16bis PCT Extension of Time Limits for Payment of Fees

R.19 PCT The Competent Receiving Office

R.27 PCT Lack of Payment of Fees

R.41 PCT Taking into Account Results of Earlier Search

R.45bis PCT Supplementary International Searches

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search?

What are the benefits of this for applicants?

PCT AG-IP 5.184 What fees are due in respect of an international application?

PCT AG-IP 5.185 To whom are the fees payable?

PCT AG-IP 5.186 What is the currency in which the fees are payable?

PCT AG-IP 5.187 What are the amounts of the fees?

PCT AG-IP 5.191 When are the fees due?

PCT AG-IP 5.192 What happens if the amounts of the fees are changed?

PCT AG-IP 5.197 In what cases are fees refunded?

#### **Case Law with Headnote**

W 18/06 Erfüllung der Bedingungen für die Anerkennung des Widerspruchs als erhoben - fristgemäße Zahlung der [...]

***R.16bis PCT Extension of Time Limits for Payment of Fees***

**16bis.1**     *Invitation by the Receiving Office*

(a) Where, by the time they are due under **Rules 14.1(c), 15.3 and 16.1(f)**, the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee and the search fee, the receiving Office shall, subject to **paragraph (d)**, invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under **Rule 16bis.2**, within a time limit of one month from the date of the invitation.

(b) *[Deleted]*

(c) Where the receiving Office has sent to the applicant an invitation under **paragraph (a)** and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under **Rule 16bis.2**, the receiving Office shall, subject to **paragraph (e)**:

(i) make the applicable declaration under **Article 14(3)**, and

(ii) proceed as provided in **Rule 29**.

(d) Any payment received by the receiving Office before that Office sends the invitation under **paragraph (a)** shall be considered to have been received before the expiration of the time limit under **Rule 14.1(c), 15.3 or 16.1(f)**, as the case may be.

(e) Any payment received by the receiving Office before that Office makes the applicable declaration under **Article 14(3)** shall be considered to have been received before the expiration of the time limit referred to in **paragraph (a)**.

**16bis.2**     *Late Payment Fee*

(a) The payment of fees in response to an invitation under **Rule 16bis.1(a)** may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under **item (i)** is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% of the international filing fee referred to in **item 1** of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 46 Late payment of fees

**PCT Articles**

A.14 PCT Certain Defects in the International Application

**PCT Implementing Rules**

R.14 PCT The Transmittal Fee

R.15 PCT The International Filing Fee

R.16 PCT The Search Fee

R.27 PCT Lack of Payment of Fees

R.29 PCT International Applications Considered Withdrawn

## A.7 PCT The Drawings

### R.16bis PCT Extension of Time Limits for Payment of Fees

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#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.193 What happens if the fees are not paid or not paid in full?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.037 Can time limits to correct certain defects be extended?

## A.8 PCT Claiming Priority

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2)(a) Subject to the provisions of **subparagraph (b)**, the conditions for, and the effect of, any priority claim declared under **paragraph (1)** shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 32 Priority claim

GA B 33 Restoration of priority right

#### **PCT Articles**

A.2 PCT Definitions

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.17 PCT The Priority Document

R.90bis PCT Withdrawals

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

PCT AG-IP 5.057 How may the priority of an earlier application be claimed?

PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?

#### **Case Law of the Enlarged Board**

G 2/02 International applications - priorities from India / Applicability of Article 87(5) EPC / The position under the PCT / [...]

G 3/02 International applications - priorities from India / Applicability of Article 87(5) EPC / The position under the PCT / [...]

#### **Case Law with Headnote**

J 15/80 Priority right / Deposit of industrial design / Industrial design/deposit of / Paris Convention and EPC

J 2/92 Correction of particulars after publication / Errors of transcription - interest of third parties - apparent [...]

T 15/01 Admissibility of appeal (yes) - party status of universal successor of original patentee (yes) - correction of wrong [...]

#### **General Case Law**

T 1147/02 Added matter (no) / Sufficiency, novelty, inventive step (yes) / Admission of late filed documents (no) / Validity of [...]

T 477/06 Priority valid (no) / Novelty (no)

#### **Case Law with Headnote**

T 382/07 Exhibition priority (no); transfer of priority right (yes); added matter (no) - disclaimer allowable; extension of [...]

## ***R.17 PCT The Priority Document***

### **17.1**     *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under **Article 8**, a copy of that earlier application, certified by the authority with which it was filed ("the priority document"), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to **paragraphs (b) and (b-bis)**, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(b-bis) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, as the case may be, instead of submitting the priority document:

(i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or

(ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to **paragraph (d)**, disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under **paragraph (c)** if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

### **17.2**     *Availability of Copies*

(a) Where the applicant has complied with **Rule 17.1(a), (b) or (b-bis)** the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under **Article 22**. Where the applicant makes an express request to the designated Office under **Article 23(2)** prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

## A.8 PCT Claiming Priority

### R.17 PCT The Priority Document

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(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Where the international application has been published under **Article 21**, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

(i) the international application was withdrawn,

(ii) the relevant priority claim was withdrawn or considered, under **Rule 26bis.2(b)**, not to have been made.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.3.5 Claim to priority

#### **EPO Guidelines - F The European Patent Application**

GL F VI 2.1 Examining the validity of a right to priority

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 34 Furnishing of the priority document

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XIII XIII.

GA E XIII 1 Obligation to furnish the priority document

GA E XIII 2 Non-observance of the requirement to file a copy or the application number

#### **PCT Articles**

A.8 PCT Claiming Priority

A.21 PCT International Publication

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.23 PCT Delaying of National Procedure

#### **PCT Implementing Rules**

R.20 PCT International Filing Date

R.26bis PCT Correction or Addition of Priority Claim

R.48 PCT International Publication

R.66 PCT Procedure before the International Preliminary Examining Authority

R.82ter PCT Rectification of Errors Made by the Receiving Office or by the International Bureau

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.070 When and to whom must the priority document be furnished?

PCT AG-IP 5.070B What steps must be taken so that the International Bureau can obtain the priority document from a digital library, in particular via the DAS?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.028 How should missing elements or parts be incorporated by reference into the international application?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.023 How can copies of the priority document be obtained?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.056 May the International Preliminary Examining Authority ask for the priority document and a translation of it?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.009 When must a copy of the priority document be furnished for the national phase?

PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?

#### **Case Law with Headnote**

J 2/92 Correction of particulars after publication / Errors of transcription - interest of third parties - apparent [..]

#### **General Case Law**

J 11/95 Priority right - Claiming priority - Filing of priority document (no) / Loss of right of priority - Interruption of [..]

T 1147/02 Added matter (no) / Sufficiency, novelty, inventive step (yes) / Admission of late filed documents (no) / Validity of [..]



## A.9 PCT The Applicant

- (1) Any resident or national of a Contracting State may file an international application.
- (2) The Assembly may decide to allow the residents and the nationals of any country party to the Paris Convention for the Protection of Industrial Property which is not party to this Treaty to file international applications.
- (3) The concepts of residence and nationality, and the application of those concepts in cases where there are several applicants or where the applicants are not the same for all the designated States, are defined in the Regulations.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 1 Who may file an international application with the EPO?

#### **PCT Articles**

A.45 PCT Regional Patent Treaties

#### **PCT Implementing Rules**

R.18 PCT The Applicant

R.19 PCT The Competent Receiving Office

R.90 PCT Agents and Common Representatives

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.020 Who may file an international application?

PCT AG-IP 5.031 Why and how must the nationality and residence of the applicant be indicated in the request?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.005 What is a “common representative” of the applicants?

PCT AG-IP 11.025 What should be done if the inventor died before the international application was filed?

## ***R.18 PCT The Applicant***

### ***18.1 Residence and Nationality***

(a) Subject to the provisions of **paragraphs (b) and (c)**, the question whether an applicant is a resident or national of the Contracting State of which he claims to be a resident or national shall depend on the national law of that State and shall be decided by the receiving Office.

(b) In any case,

(i) possession of a real and effective industrial or commercial establishment in a Contracting State shall be considered residence in that State, and

(ii) a legal entity constituted according to the national law of a Contracting State shall be considered a national of that State.

(c) Where the international application is filed with the International Bureau as receiving Office, the International Bureau shall, in the circumstances specified in the Administrative Instructions, request the national Office of, or acting for, the Contracting State concerned to decide the question referred to in **paragraph (a)**. The International Bureau shall inform the applicant of any such request. The applicant shall have an opportunity to submit arguments directly to the national Office. The national Office shall decide the said question promptly.

### ***18.2 [Deleted]***

### ***18.3 Two or More Applicants***

If there are two or more applicants, the right to file an international application shall exist if at least one of them is entitled to file an international application according to **Article 9**.

### ***18.4 Information on Requirements under National Law as to Applicants***

(a) and (b) *[Deleted]*

(c) The International Bureau shall, from time to time, publish information on the various national laws in respect of the question who is qualified (inventor, successor in title of the inventor, owner of the invention, or other) to file a national application and shall accompany such information by a warning that the effect of the international application in any designated State may depend on whether the person designated in the international application as applicant for the purposes of that State is a person who, under the national law of that State, is qualified to file a national application.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 1 Who may file an international application with the EPO?

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 9 Who may file a demand for international preliminary examination with the EPO?

#### **PCT Articles**

A.9 PCT The Applicant

#### **PCT Implementing Rules**

R.54 PCT The Applicant Entitled to Make a Demand

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.008 Where should an international application be filed?

PCT AG-IP 5.020 Who may file an international application?

PCT AG-IP 5.023 How are questions of residence and nationality determined?

PCT AG-IP 5.031 Why and how must the nationality and residence of the applicant be indicated in the request?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

## A.9 PCT The Applicant

### R.18 PCT The Applicant

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PCT AG-IP 10.004 On what conditions may a demand for international preliminary examination be submitted?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.023 What should be done in the case of the death of the applicant during the international phase?

PCT AG-IP 11.025 What should be done if the inventor died before the international application was filed?

## A.10 PCT The Receiving Office

The international application shall be filed with the prescribed receiving Office, which will check and process it as provided in this Treaty and the Regulations.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 1 Who may file an international application with the EPO?

GA B 2 Where to file if the EPO is receiving Office?

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.008 Where should an international application be filed?

**PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?

### ***R.19 PCT The Competent Receiving Office***

#### **19.1**     *Where to File*

- (a) Subject to the provisions of **paragraph (b)**, the international application shall be filed, at the option of the applicant,
- (i) with the national Office of or acting for the Contracting State of which the applicant is a resident,
- (ii) with the national Office of or acting for the Contracting State of which the applicant is a national, or
- (iii) irrespective of the Contracting State of which the applicant is a resident or national, with the International Bureau.
- (b) Any Contracting State may agree with another Contracting State or any intergovernmental organization that the national Office of the latter State or the intergovernmental organization shall, for all or some purposes, act instead of the national Office of the former State as receiving Office for applicants who are residents or nationals of that former State. Notwithstanding such agreement, the national Office of the former State shall be considered the competent receiving Office for the purposes of **Article 15(5)**.
- (c) In connection with any decision made under **Article 9(2)**, the Assembly shall appoint the national Office or the intergovernmental organization which will act as receiving Office for applications of residents or nationals of States specified by the Assembly. Such appointment shall require the previous consent of the said national Office or intergovernmental organization.

#### **19.2**     *Two or More Applicants*

If there are two or more applicants:

- (i) the requirements of **Rule 19.1** shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national;
- (ii) the international application may be filed with the International Bureau under **Rule 19.1(a)(iii)** if at least one of the applicants is a resident or national of a Contracting State.

#### **19.3**     *Publication of Fact of Delegation of Duties of Receiving Office*

- (a) Any agreement referred to in **Rule 19.1(b)** shall be promptly notified to the International Bureau by the Contracting State which delegates the duties of the receiving Office to the national Office of or acting for another Contracting State or an intergovernmental organization.
- (b) The International Bureau shall, promptly upon receipt, publish the notification in the Gazette.

#### **19.4**     *Transmittal to the International Bureau as Receiving Office*

- (a) Where an international application is filed with a national Office which acts as a receiving Office under the Treaty but

## A.10 PCT The Receiving Office

### R.19 PCT The Competent Receiving Office

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- (i) that national Office is not competent under **Rule 19.1** or **19.2** to receive that international application, or
- (ii) that international application is not in a language accepted under **Rule 12.1(a)** by that national Office but is in a language accepted under that Rule by the International Bureau as receiving Office, or
- (iii) that national Office and the International Bureau agree, for any reason other than those specified under **items (i)** and **(ii)**, and with the authorization of the applicant, that the procedure under this Rule should apply,

that international application shall, subject to **paragraph (b)**, be considered to have been received by that Office on behalf of the International Bureau as receiving Office under **Rule 19.1(a)(iii)**.

(b) Where, pursuant to **paragraph (a)**, an international application is received by a national Office on behalf of the International Bureau as receiving Office under **Rule 19.1(a)(iii)**, that national Office shall, unless prescriptions concerning national security prevent the international application from being so transmitted, promptly transmit it to the International Bureau. Such transmittal may be subjected by the national Office to the payment of a fee, for its own benefit, equal to the transmittal fee charged by that Office under **Rule 14**. The international application so transmitted shall be considered to have been received by the International Bureau as receiving Office under **Rule 19.1(a)(iii)** on the date of receipt of the international application by that national Office.

(c) For the purposes of **Rules 14.1(c)**, **15.3** and **16.1(f)**, where the international application was transmitted to the International Bureau under **paragraph (b)**, the date of receipt of the international application shall be considered to be the date on which the international application was actually received by the International Bureau. For the purposes of this paragraph, the last sentence of **paragraph (b)** shall not apply.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 1 Who may file an international application with the EPO?

GA B 41 Language of the international application

#### **PCT Articles**

A.9 PCT The Applicant

A.15 PCT The International Search

#### **PCT Implementing Rules**

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.14 PCT The Transmittal Fee

R.15 PCT The International Filing Fee

R.16 PCT The Search Fee

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.35 PCT The Competent International Searching Authority

R.54 PCT The Applicant Entitled to Make a Demand

R.59 PCT The Competent International Preliminary Examining Authority

R.83 PCT Right to Practice before International Authorities

R.90 PCT Agents and Common Representatives

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.008 Where should an international application be filed?

PCT AG-IP 5.013 What language must be used for an international application?

PCT AG-IP 5.031 Why and how must the nationality and residence of the applicant be indicated in the request?

PCT AG-IP 5.062 What are the consequences if the international application is filed after the expiration of the priority period?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.002 What are the additional procedural steps at the receiving Office for processing a request form print-out prepared using the PCT-SAFE software?

PCT AG-IP 6.025 What defects influence the international filing date?

PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?

PCT AG-IP 6.034 What happens if the application is filed in a language which is not accepted by the receiving Office?

PCT AG-IP 6.035 What happens if the applicant is a resident or national of a Contracting State but files the application with a "non-competent" receiving Office?

## A.10 PCT The Receiving Office

### R.19 PCT The Competent Receiving Office

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#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

PCT AG-IP 11.097 What happens where the receiving Office does not accept request form print-outs generated using the PCT-SAFE software?

#### **General Case Law**

J 3/00 Rectification of errors made by a PCT Receiving Office (PCT Rule 82 ter) / Protection of legitimate expectations

## A.11 PCT Filing Date and Effects of the International Application

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,

(ii) the international application is in the prescribed language,

(iii) the international application contains at least the following elements:

(a) an indication that it is intended as an international application,

(b) the designation of at least one Contracting State,

(c) the name of the applicant, as prescribed,

(d) a part which on the face of it appears to be a description,

(e) a part which on the face of it appears to be a claim or claims.

(2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in **paragraph (1)**, it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.

(3) Subject to **Article 64(4)**, any international application fulfilling the requirements listed in **items (i) to (iii)** of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

(4) Any international application fulfilling the requirements listed in **items (i) to (iii)** of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

### EPO Guidelines - E General Procedural Matters

GL E VIII 2.3.11 Designation fee

### EPO Guidelines - F The European Patent Application

GL F VI 1.1 Filing date as effective date

### EPO Guide for Applicants, part II Int. - A General Overview

GA A 6 Euro-PCT application

### EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office

GA B 5 International filing date

GA B 20 The PCT request

GA B 29 For which states may international applications be filed?



## A.11 PCT Filing Date and Effects of the International Application

### R.19 PCT The Competent Receiving Office

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GA B 41 Language of the international application

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XI 1 Renewal fee

GA E XVI XVI.

#### **PCT Articles**

A.14 PCT Certain Defects in the International Application

A.24 PCT Possible Loss of Effect in Designated States

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.64 PCT \* Reservations

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.15 PCT The International Filing Fee

R.16 PCT The Search Fee

R.20 PCT International Filing Date

R.22 PCT Transmittal of the Record Copy and Translation

R.29 PCT International Applications Considered Withdrawn

R.49 PCT Copy, Translation and Fee under Article 22

R.51 PCT Review by Designated Offices

R.55 PCT Languages (International Preliminary Examination)

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

PCT AG-IP 5.052 What is the designation of States?

PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?

PCT AG-IP 5.094 How must the description be drafted?

PCT AG-IP 5.112 How must claims be drafted?

PCT AG-IP 5.197 In what cases are fees refunded?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?

PCT AG-IP 6.005 What are the conditions that must be fulfilled for the international application to be entitled to an international filing date?

PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?

PCT AG-IP 6.008 What date is accorded as the international filing date?

PCT AG-IP 6.009 Does non-payment, incomplete payment or late payment of fees influence the international filing date?

PCT AG-IP 6.011 How does the applicant know whether his application has been accorded an international filing date or that his application is not treated as an international application or is considered to have been withdrawn?

PCT AG-IP 6.025 What defects influence the international filing date?

PCT AG-IP 6.026 What happens if all sheets of the international application are not received on the same day?

PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?

PCT AG-IP 6.028 How should missing elements or parts be incorporated by reference into the international application?

PCT AG-IP 6.030 What are the consequences if the requirements for the incorporation by reference are not complied with?

PCT AG-IP 6.033 What defects in request form print-outs prepared using the PCT-SAFE software do not affect the international filing date?

PCT AG-IP 6.036 May the applicant correct indications of residence and nationality?

PCT AG-IP 6.037 Can time limits to correct certain defects be extended?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

PCT AG-IP 11.092 What is the effect of an extension?

PCT AG-IP 11.097 What happens where the receiving Office does not accept request form print-outs generated using the PCT-SAFE software?

PCT AG-IP 11.100 What happens when the request form print-out is not in the format provided by the PCT-SAFE software but it is filed with a corresponding diskette?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.001 What is the national phase?

#### **General Case Law**

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

J 3/00 Rectification of errors made by a PCT Receiving Office (PCT Rule 82 ter) / Protection of legitimate

## A.11 PCT Filing Date and Effects of the International Application

### R.19 PCT The Competent Receiving Office

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expectations

J 13/03 Principle of protection of legitimate expectations / Restitutio -Euro - PCT applications - EPO designated Office

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [..]

#### **General Case Law**

T 353/03 Right to be heard - no (claims amended substantially) / Insufficient reasoning of decision / Errors in the translation [..]

## ***R.20 PCT International Filing Date***

### **20.1**     *Determination under Article 11(1)*

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers fulfill the requirements of **Article 11(1)**.

(b) For the purposes of **Article 11(1)(iii)(c)**, it shall be sufficient to indicate the name of the applicant in a way which allows the identity of the applicant to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) For the purposes of **Article 11(1)(ii)**, it shall be sufficient that the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language accepted by the receiving Office under **Rule 12.1(a)**.

(d) If, on October 1, 1997, **paragraph (c)** is not compatible with the national law applied by the receiving Office, **paragraph (c)** shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.<sup>2</sup>

### **20.2**     *Positive Determination under Article 11(1)*

(a) If the receiving Office determines that, at the time of receipt of the papers purporting to be an international application, the requirements of **Article 11(1)** were fulfilled, the receiving Office shall accord as the international filing date the date of receipt of the international application.

(b) The receiving Office shall stamp the request of the international application which it has accorded an international filing date as prescribed by the Administrative Instructions. The copy whose request has been so stamped shall be the record copy of the international application.

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under **Rule 22.1(a)**.

### **20.3**     *Defects under Article 11(1)*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of **Article 11(1)**, the receiving Office finds that any of the requirements of **Article 11(1)** are not, or appear not to be, fulfilled, it shall promptly invite the applicant, at the applicant's option:

(i) to furnish the required correction under **Article 11(2)**; or

(ii) where the requirements concerned are those relating to an element referred to in **Article 11(1)(iii)(d)** or **(e)**, to confirm in accordance with **Rule 20.6(a)** that the element is incorporated by reference under **Rule 4.18**;

and to make observations, if any, within the applicable time limit under **Rule 20.7**. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

(b) Where, following an invitation under **paragraph (a)** or otherwise:

(i) the applicant furnishes to the receiving Office the required correction under **Article 11(2)** after the date of receipt of the purported international application but on a later date falling within the applicable time limit under **Rule 20.7**, the receiving Office shall accord that later date as the international filing date and proceed as provided in **Rule 20.2(b)** and (c);

(ii) an element referred to in **Article 11(1)(iii)(d)** or (e) is, under **Rule 20.6(b)**, considered to have been contained in the international application on the date on which one or more elements referred to in **Article 11(1)(iii)** were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of **Article 11(1)** are fulfilled and proceed as provided in **Rule 20.2(b)** and (c).

(c) If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation under **paragraph (a)** since the requirements of **Article 11(1)** were fulfilled when the papers were received, it shall proceed as provided in **Rule 20.2**.

#### 20.4 *Negative Determination under Article 11(1)*

If the receiving Office does not receive, within the applicable time limit under **Rule 20.7**, a correction or confirmation referred to in **Rule 20.3(a)**, or if a correction or confirmation has been received but the application still does not fulfill the requirements of **Article 11(1)**, the receiving Office shall:

(i) promptly notify the applicant that the application is not and will not be treated as an international application and shall indicate the reasons therefor;

(ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number;

(iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in **Rule 93.1**, and

(iv) send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under **Article 25(1)**, the International Bureau needs such a copy and specially asks for it.

#### 20.5 *Missing Parts*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of **Article 11(1)**, the receiving Office finds that a part of the description, claims or drawings is or appears to be missing, including the case where all of the drawings are or appear to be missing but not including the case where an entire element referred to in **Article 11(1)(iii)(d)** or (e) is or appears to be missing, it shall promptly invite the applicant, at the applicant's option:

(i) to complete the purported international application by furnishing the missing part; or

(ii) to confirm, in accordance with **Rule 20.6(a)**, that the part was incorporated by reference under **Rule 4.18**;

and to make observations, if any, within the applicable time limit under **Rule 20.7**. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

## A.11 PCT Filing Date and Effects of the International Application

### R.20 PCT International Filing Date

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(b) Where, following an invitation under **paragraph (a)** or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of **Article 11(1)** are fulfilled but within the applicable time limit under **Rule 20.7**, a missing part referred to in **paragraph (a)** so as to complete the international application, that part shall be included in the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of **Article 11(1)** are fulfilled and proceed as provided in **Rule 20.2(b)** and (c).

(c) Where, following an invitation under **paragraph (a)** or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of **Article 11(1)** were fulfilled but within the applicable time limit under **Rule 20.7**, a missing part referred to in **paragraph (a)** so as to complete the international application, that part shall be included in the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that part, notify the applicant accordingly and proceed as provided for in the Administrative Instructions.

(d) Where, following an invitation under **paragraph (a)** or otherwise, a part referred to in **paragraph (a)** is, under **Rule 20.6(b)**, considered to have been contained in the purported international application on the date on which one or more elements referred to in **Article 11(1)(iii)** were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of **Article 11(1)** are fulfilled and proceed as provided in **Rule 20.2(b)** and (c).

(e) Where the international filing date has been corrected under **paragraph (c)**, the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under **paragraph (c)**, request that the missing part concerned be disregarded, in which case the missing part shall be considered not to have been furnished and the correction of the international filing date under that paragraph shall be considered not to have been made, and the receiving Office shall proceed as provided for in the Administrative Instructions.

#### 20.6 *Confirmation of Incorporation by Reference of Elements and Parts*

(a) The applicant may submit to the receiving Office, within the applicable time limit under **Rule 20.7**, a written notice confirming that an element or part is incorporated by reference in the international application under **Rule 4.18**, accompanied by:

(i) a sheet or sheets embodying the entire element as contained in the earlier application or embodying the part concerned;

(ii) where the applicant has not already complied with **Rule 17.1(a)**, **(b)** or **(b-bis)** in relation to the priority document, a copy of the earlier application as filed;

(iii) where the earlier application is not in the language in which the international application is filed, a translation of the earlier application into that language or, where a translation of the international application is required under **Rule 12.3(a)** or **12.4(a)**, a translation of the earlier application into both the language in which the international application is filed and the language of that translation; and

(iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application and, where applicable, in any translation referred to in **item (iii)**.

(b) Where the receiving Office finds that the requirements of **Rule 4.18** and **paragraph (a)** have been complied with and that the element or part referred to in **paragraph (a)** is completely contained in the earlier application concerned, that element or part shall be considered to have been contained in the purported international application on the date on which one or more elements referred to in **Article 11(1)(iii)** were first received by the receiving Office.

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### R.20 PCT International Filing Date

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(c) Where the receiving Office finds that a requirement under **Rule 4.18** or **paragraph (a)** has not been complied with or that the element or part referred to in **paragraph (a)** is not completely contained in the earlier application concerned, the receiving Office shall proceed as provided for in **Rule 20.3(b)(i)**, **20.5(b)** or **20.5(c)**, as the case may be.

#### 20.7 *Time Limit*

(a) The applicable time limit referred to in **Rules 20.3(a)** and **(b)**, **20.4**, **20.5(a)**, **(b)** and **(c)**, and **20.6(a)** shall be:

(i) where an invitation under **Rule 20.3(a)** or **20.5(a)**, as applicable, was sent to the applicant, two months from the date of the invitation;

(ii) where no such invitation was sent to the applicant, two months from the date on which one or more elements referred to in **Article 11(1)(iii)** were first received by the receiving Office.

(b) Where a correction under **Article 11(2)** or a notice under **Rule 20.6(a)** confirming the incorporation by reference of an element referred to in **Article 11(1)(iii)(d)** or **(e)** is received by the receiving Office after the expiration of the applicable time limit under **paragraph (a)** but before that Office sends a notification to the applicant under **Rule 20.4(i)**, that correction or notice shall be considered to have been received within that time limit.

#### 20.8 *Incompatibility with National Laws*

(a) If, on October 5, 2005, any of **Rules 20.3(a)(ii)** and **(b)(ii)**, **20.5(a)(ii)** and **(d)**, and **20.6** are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.<sup>2</sup>

(a-bis) Where a missing element or part cannot be incorporated by reference in the international application under **Rules 4.18** and **20.6** because of the operation of **paragraph (a)** of this Rule, the receiving Office shall proceed as provided for in **Rule 20.3(b)(i)**, **20.5(b)** or **20.5(c)**, as the case may be. Where the receiving Office proceeds as provided for in **Rule 20.5(c)**, the applicant may proceed as provided for in **Rule 20.5(e)**.

(b) If, on October 5, 2005, any of **Rules 20.3(a)(ii)** and **(b)(ii)**, **20.5(a)(ii)** and **(d)**, and **20.6** are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in **Article 22** have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.<sup>2</sup>

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under **Rule 20.6(b)**, but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of **paragraph (b)** of this Rule, the designated Office may treat the application as if the international filing date had been accorded under **Rule 20.3(b)(i)** or **20.5(b)**, or corrected under **Rule 20.5(c)**, as the case may be, provided that **Rule 82ter.1(c)** and **(d)** shall apply *mutatis mutandis*.

<sup>2</sup> Editor's Note: This information is also published on the WIPO website at:  
[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html).

**EPO Guidelines - B Search**

GL B III 3.3.1 General considerations

GL B XI 2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT

**EPO Guidelines - E General Procedural Matters**

GL E VIII 2.2 Provisions of Chapter A-II ("Filing of applications and examination on filing")

**EPO Guidelines - G Patentability**

GL G IV 5.1.2 Accorded date of filing still subject to review

**EPO Guidelines - H Amendments and Corrections**

GL H IV 2.3.2 Missing parts of the description or missing drawings filed after the date of filing

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 4 Incorporation by reference of missing parts and elements

GA B 12 Filing further documents

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 5 Incorporation by reference of missing parts and elements

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 3 Incorporation by reference of missing parts and elements

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R.55 PCT Languages (International Preliminary Examination)

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

R.82ter PCT Rectification of Errors Made by the Receiving Office or by the International Bureau

R.89ter PCT Copies in Electronic Form of Documents Filed on Paper

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PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?

PCT AG-IP 6.005 What are the conditions that must be fulfilled for the international application to be entitled to an international filing date?

PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?

PCT AG-IP 6.008 What date is accorded as the international filing date?

PCT AG-IP 6.011 How does the applicant know whether his application has been accorded an international filing date or that his application is not treated as an international application or is considered to have been withdrawn?

PCT AG-IP 6.012 Can an international filing date once accorded be "taken away"?

PCT AG-IP 6.025 What defects influence the international filing date?

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PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?

PCT AG-IP 6.028 How should missing elements or parts be incorporated by reference into the international application?

PCT AG-IP 6.029 What is the time limit for confirming the incorporation by reference of missing elements or parts?

PCT AG-IP 6.030 What are the consequences if the requirements for the incorporation by reference are not complied with?

PCT AG-IP 6.031 What are the effects of the successful incorporation of missing elements or parts on designated or elected Offices?

PCT AG-IP 6.058 How does the International Bureau monitor the receipt of the record copy?

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.012 When and how is the international application published by the International Bureau?

**PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.033 Can obvious mistakes be rectified by the applicant?

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

## A.11 PCT Filing Date and Effects of the International Application

### R.20 PCT International Filing Date

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PCT AG-IP 11.092 What is the effect of an extension?

PCT AG-IP 11.097 What happens where the receiving Office does not accept request form print-outs generated using the PCT-SAFE software?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.012 Will pages which have been accepted as incorporated by reference by the receiving Office be accepted by the designated or elected Office?

#### **General Case Law**

J 3/00 Rectification of errors made by a PCT Receiving Office (PCT Rule 82 ter) / Protection of legitimate expectations



## **A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority**

(1) One copy of the international application shall be kept by the receiving Office ("home copy"), one copy ("record copy") shall be transmitted to the International Bureau, and another copy ("search copy") shall be transmitted to the competent International Searching Authority referred to in **Article 16**, as provided in the Regulations.

(2) The record copy shall be considered the true copy of the international application.

(3) The international application shall be considered withdrawn if the record copy has not been received by the International Bureau within the prescribed time limit.

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 6 Translation

GA C II 2 Establishing the ISR and the WO-ISA

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

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A.16 PCT The International Searching Authority

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A.30 PCT Confidential Nature of the International Application

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R.21 PCT Preparation of Copies

R.22 PCT Transmittal of the Record Copy and Translation

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R.88 PCT Amendment of the Regulations

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### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.179 In how many copies must an international application be filed?

### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?

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### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.099 What happens when the request form print-out generated using the PCT-SAFE software is filed without a corresponding diskette?

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### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [..]

## A.13 PCT Availability of Copy of the International Application to Designated Offices

(1) Any designated Office may ask the International Bureau to transmit to it a copy of the international application prior to the communication provided for in **Article 20**, and the International Bureau shall transmit such copy to the designated Office as soon as possible after the expiration of one year from the priority date.

(2)(a) The applicant may, at any time, transmit a copy of his international application to any designated Office.

(b) The applicant may, at any time, ask the International Bureau to transmit a copy of his international application to any designated Office, and the International Bureau shall transmit such copy to the designated Office as soon as possible.

(c) Any national Office may notify the International Bureau that it does not wish to receive copies as provided for in **subparagraph (b)**, in which case that subparagraph shall not be applicable in respect of that Office.

### PCT Articles

A.20 PCT Communication to Designated Offices

A.30 PCT Confidential Nature of the International Application

### PCT Implementing Rules

R.31 PCT Copies Required under Article 13

### PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

### PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

### Case Law with Headnote

W 18/06 Erfüllung der Bedingungen für die Anerkennung des Widerspruchs als erhoben - fristgemäße Zahlung der [...]

### ***R.21 PCT Preparation of Copies***

#### **21.1     *Responsibility of the Receiving Office***

(a) Where the international application is required to be filed in one copy, the receiving Office shall be responsible for preparing the home copy and the search copy required under **Article 12(1)**.

(b) Where the international application is required to be filed in two copies, the receiving Office shall be responsible for preparing the home copy.

(c) If the international application is filed in less than the number of copies required under **Rule 11.1(b)**, the receiving Office shall be responsible for the prompt preparation of the number of copies required, and shall have the right to fix a fee for performing that task and to collect such fee from the applicant.

#### **21.2     *Certified Copy for the Applicant***

Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.

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A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

#### **PCT Implementing Rules**

R.11 PCT Physical Requirements of the International Application

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PCT AG-IP 5.179 In how many copies must an international application be filed?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.060 Can the applicant obtain certified copies of the international application?

## ***R.22 PCT Transmittal of the Record Copy and Translation***

### **22.1 Procedure**

(a) If the determination under **Article 11(1)** is positive, and unless prescriptions concerning national security prevent the international application from being treated as such, the receiving Office shall transmit the record copy to the International Bureau. Such transmittal shall be effected promptly after receipt of the international application or, if a check to preserve national security must be performed, as soon as the necessary clearance has been obtained. In any case, the receiving Office shall transmit the record copy in time for it to reach the International Bureau by the expiration of the 13th month from the priority date. If the transmittal is effected by mail, the receiving Office shall mail the record copy not later than five days prior to the expiration of the 13th month from the priority date.

(b) If the International Bureau has received a copy of the notification under **Rule 20.2(c)** but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.

(c) If the International Bureau has received a copy of the notification under **Rule 20.2(c)** but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

(d) After the expiration of 14 months from the priority date, the applicant may request the receiving Office to certify a copy of his international application as being identical with the international application as filed and may transmit such certified copy to the International Bureau.

(e) Any certification under **paragraph (d)** shall be free of charge and may be refused only on any of the following grounds:

(i) the copy which the receiving Office has been requested to certify is not identical with the international application as filed;

(ii) prescriptions concerning national security prevent the international application from being treated as such;

(iii) the receiving Office has already transmitted the record copy to the International Bureau and that Bureau has informed the receiving Office that it has received the record copy.

(f) Unless the International Bureau has received the record copy, or until it receives the record copy, the copy certified under **paragraph (e)** and received by the International Bureau shall be considered to be the record copy.

(g) If, by the expiration of the time limit applicable under **Article 22**, the applicant has performed the acts referred to in that Article but the designated Office has not been informed by the International Bureau of the receipt of the record copy, the designated Office shall inform the International Bureau. If the International Bureau is not in possession of the record copy, it shall promptly notify the applicant and the receiving Office unless it has already notified them under **paragraph (c)**.

(h) Where the international application is to be published in the language of a translation furnished under **Rule 12.3** or **12.4**, that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under **paragraph (a)** or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

A.13 PCT Availability of Copy of the International Application to Designated Offices  
R.22 PCT Transmittal of the Record Copy and Translation

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22.2 *[Deleted]*

22.3 *Time Limit under Article 12(3)*

The time limit referred to in **Article 12(3)** shall be three months from the date of the notification sent by the International Bureau to the applicant under **Rule 22.1(c)** or **(g)**.

**PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

A.22 PCT Copy, Translation, and Fee, to Designated Offices

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R.24 PCT Receipt of the Record Copy by the International Bureau

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PCT AG-IP 5.179 In how many copies must an international application be filed?

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PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?

PCT AG-IP 6.010 Can the receiving Office refuse to treat an international application as such for reasons of national security?

PCT AG-IP 6.011 How does the applicant know whether his application has been accorded an international filing date or that his application is not treated as an international application or is considered to have been withdrawn?

PCT AG-IP 6.057 How does the record copy reach the International Bureau?

PCT AG-IP 6.058 How does the International Bureau monitor the receipt of the record copy?

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

## ***R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing***

### **23.1 Procedure**

- (a) Where no translation of the international application is required under **Rule 12.3(a)**, the search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.
- (b) Where a translation of the international application is furnished under **Rule 12.3**, a copy of that translation and of the request, which together shall be considered to be the search copy under **Article 12(1)**, shall be transmitted by the receiving Office to the International Searching Authority, unless no search fee has been paid. In the latter case, a copy of the said translation and of the request shall be transmitted promptly after payment of the search fee.
- (c) Any sequence listing in electronic form which is furnished for the purposes of **Rule 13ter** but submitted to the receiving Office instead of the International Searching Authority shall be promptly transmitted by that Office to that Authority.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 6 Translation

GA C II 2 Establishing the ISR and the WO-ISA

#### **PCT Articles**

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

#### **PCT Implementing Rules**

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R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

R.29 PCT International Applications Considered Withdrawn

R.37 PCT Missing or Defective Title

R.38 PCT Missing or Defective Abstract

R.43 PCT The International Search Report

R.55 PCT Languages (International Preliminary Examination)

R.92 PCT Correspondence

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.179 In how many copies must an international application be filed?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?

PCT AG-IP 6.059 How does the search copy reach the International Searching Authority?

***R.24 PCT Receipt of the Record Copy by the International Bureau***

24.1 *[Deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

(i) the applicant,

(ii) the receiving Office, and

(iii) the International Searching Authority (unless it has informed the International Bureau that it wishes not to be so notified),

of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the designated Offices and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent.

(b) *[Deleted]*

(c) If the record copy is received after the expiration of the time limit fixed in **Rule 22.3**, the International Bureau shall promptly notify the applicant, the receiving Office, and the International Searching Authority, accordingly.

**PCT Implementing Rules**

R.22 PCT Transmittal of the Record Copy and Translation

R.51 PCT Review by Designated Offices

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.002 When and to whom does the International Bureau notify its receipt of the record copy of the international application?

PCT AG-IP 9.003 What should be done by the applicant when he receives the notification of receipt of the record copy?

***R.25 PCT Receipt of the Search Copy by the International Searching Authority***

***25.1 Notification of Receipt of the Search Copy***

The International Searching Authority shall promptly notify the International Bureau, the applicant, and—unless the International Searching Authority is the same as the receiving Office—the receiving Office, of the fact and the date of receipt of the search copy.

**PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.059 How does the search copy reach the International Searching Authority?



## A.14 PCT Certain Defects in the International Application

(1)(a) The receiving Office shall check whether the international application contains any of the following defects, that is to say:

- (i) it is not signed as provided in the Regulations;
- (ii) it does not contain the prescribed indications concerning the applicant;
- (iii) it does not contain a title;
- (iv) it does not contain an abstract;
- (v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements.

(b) If the receiving Office finds any of the said defects, it shall invite the applicant to correct the international application within the prescribed time limit, failing which that application shall be considered withdrawn and the receiving Office shall so declare.

(2) If the international application refers to drawings which, in fact, are not included in that application, the receiving Office shall notify the applicant accordingly and he may furnish them within the prescribed time limit and, if he does, the international filing date shall be the date on which the drawings are received by the receiving Office. Otherwise, any reference to the said drawings shall be considered non-existent.

(3)(a) If the receiving Office finds that, within the prescribed time limits, the fees prescribed under **Article 3(4)(iv)** have not been paid, or no fee prescribed under **Article 4(2)** has been paid in respect of any of the designated States, the international application shall be considered withdrawn and the receiving Office shall so declare

(b) If the receiving Office finds that the fee prescribed under **Article 4(2)** has been paid in respect of one or more (but less than all) designated States within the prescribed time limit, the designation of those States in respect of which it has not been paid within the prescribed time limit shall be considered withdrawn and the receiving Office shall so declare.

(4) If, after having accorded an international filing date to the international application, the receiving Office finds, within the prescribed time limit, that any of the requirements listed in **items (i) to (iii)** of Article 11(1) was not complied with at that date, the said application shall be considered withdrawn and the receiving Office shall so declare.

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PCT AG-IP 11.027 What must be done if the applicant is temporarily unavailable to sign the international application?

PCT AG-IP 11.028 Can the international application proceed if an applicant/inventor for the United States of America refuses to sign the request or cannot be found or reached?

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

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### R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

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#### ***R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application***

##### 26.1 *Invitation under Article 14(1)(b) to Correct*

The receiving Office shall issue the invitation to correct provided for in **Article 14(1)(b)** as soon as possible, preferably within one month from the receipt of the international application. In the invitation, the receiving Office shall invite the applicant to furnish the required correction, and give the applicant the opportunity to make observations, within the time limit under **Rule 26.2**.

##### 26.2 *Time Limit for Correction*

The time limit referred to in **Rule 26.1** shall be two months from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

##### 26.2bis *Checking of Requirements under Article 14(1)(a)(i) and (ii)*

(a) For the purposes of **Article 14(1)(a)(i)**, if there is more than one applicant, it shall be sufficient that the request be signed by one of them.

(b) For the purposes of **Article 14(1)(a)(ii)**, if there is more than one applicant, it shall be sufficient that the indications required under **Rule 4.5(a)(ii)** and **(iii)** be provided in respect of one of them who is entitled according to **Rule 19.1** to file the international application with the receiving Office.

##### 26.3 *Checking of Physical Requirements under Article 14(1)(a)(v)*

(a) Where the international application is filed in a language of publication, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in **Rule 11** only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;

(ii) any translation furnished under **Rule 12.3** for compliance with the physical requirements referred to in **Rule 11** to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in **Rule 11** only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;

(ii) any translation furnished under **Rule 12.3** or **12.4** and the drawings for compliance with the physical requirements referred to in **Rule 11** to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

##### 26.3bis *Invitation under Article 14(1)(b) to Correct Defects under Rule 11*

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The receiving Office shall not be required to issue the invitation under **Article 14(1)(b)** to correct a defect under **Rule 11** where the physical requirements referred to in that Rule are complied with to the extent required under **Rule 26.3**.

#### 26.3ter Invitation to Correct Defects under **Article 3(4)(i)**

(a) Where the abstract or 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 shall, unless

(i) a translation of the international application is required under **Rule 12.3(a)**, or

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. **Rules 26.1, 26.2, 26.3, 26.3bis, 26.5 and 29.1** shall apply *mutatis mutandis*.

(b) If, on October 1, 1997, **paragraph (a)** is not compatible with the national law applied by the receiving Office, **paragraph (a)** shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.<sup>3</sup>

(c) Where the request does not comply with **Rule 12.1(c)**, the receiving Office shall invite the applicant to file a translation so as to comply with that Rule. **Rules 3, 26.1, 26.2, 26.5 and 29.1** shall apply *mutatis mutandis*.

(d) If, on October 1, 1997, **paragraph (c)** is not compatible with the national law applied by the receiving Office, **paragraph (c)** shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.<sup>3</sup>

#### 26.4 Procedure

A correction of the request offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transferred from the letter to the request without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, and in the case of a correction of any element of the international application other than the request, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

#### 26.5 Decision of the Receiving Office

The receiving Office shall decide whether the applicant has submitted the correction within the applicable time limit under **Rule 26.2**, and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in **Rule 11** if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

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### R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

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<sup>3</sup> *Editor's Note:* This information is also published on the WIPO website at:  
**[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

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R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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PCT AG-IP 5.173 What happens if the abstract is missing or defective?

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PCT AG-IP 11.027 What must be done if the applicant is temporarily unavailable to sign the international application?

PCT AG-IP 11.030 What is the consequence if a satisfactory statement explaining a lack of signature of an applicant/inventor for the United States of America cannot be furnished?

PCT AG-IP 11.039 Where and when must a request for rectification be sent?

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

### ***R.26bis PCT Correction or Addition of Priority Claim***

#### ***26bis.1 Correction or Addition of Priority Claim***

(a) The applicant may correct a priority claim or add a priority claim to the request by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in **Rule 4.10**.

(b) Any notice referred to in **paragraph (a)** received by the receiving Office or the International Bureau after the applicant has made a request for early publication under **Article 21(2)(b)** shall be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.

(c) Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

#### ***26bis.2 Defects in Priority Claims***

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim:

(i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under **Rule 26bis.3** has not been submitted;

(ii) that the priority claim does not comply with the requirements of **Rule 4.10**; or

(iii) that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (i), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with **Rule 26bis.3**, unless the receiving Office has notified the International Bureau under **Rule 26bis.3(j)** of the incompatibility of **Rule 26bis.3(a)** to (i) with the national law applied by that Office.

(b) If the applicant does not, before the expiration of the time limit under **Rule 26bis.1(a)**, submit a notice correcting the priority claim, that priority claim shall, subject to **paragraph (c)**, for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit.

(c) A priority claim shall not be considered void only because:

A.14 PCT Certain Defects in the International Application  
R.26bis PCT Correction or Addition of Priority Claim

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- (i) the indication of the number of the earlier application referred to in **Rule 4.10(a)(ii)** is missing;
  - (ii) an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; or
  - (iii) 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 the period of two months from that date.
- (d) Where the receiving Office or the International Bureau has made a declaration under **paragraph (b)** or where the priority claim has not been considered void only because **paragraph (c)** applies, the International Bureau shall publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information shall be included in the communication under **Article 20** where the international application is not published by virtue of **Article 64(3)**.
- (e) Where the applicant wishes to correct or add a priority claim but the time limit under **Rule 26bis.1** has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information.

*26bis.3 Restoration of Right of Priority by Receiving Office*

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant, and subject to **paragraphs (b) to (g)** of this Rule, restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:

- (i) occurred in spite of due care required by the circumstances having been taken; or
- (ii) was unintentional.

Each receiving Office shall apply at least one of those criteria and may apply both of them.

(b) A request under **paragraph (a)** shall:

- (i) be filed with the receiving Office within the time limit applicable under **paragraph (e)**;
- (ii) state the reasons for the failure to file the international application within the priority period; and
- (iii) preferably be accompanied by any declaration or other evidence required under **paragraph (f)**.

(c) Where a priority claim in respect of the earlier application is not contained in the international application, the applicant shall submit, within the time limit applicable under **paragraph (e)**, a notice under **Rule 26bis.1(a)** adding the priority claim.

(d) The submission of a request under **paragraph (a)** may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration, payable within the time limit applicable under **paragraph (e)**. The amount of that fee, if any, shall be fixed by the receiving Office.

The time limit for payment of the fee may be extended, at the option of the receiving Office, for a period of up to two months from the expiration of the time limit applicable under **paragraph (e)**.

(e) The time limit referred to in **paragraphs (b)(i), (c) and (d)** shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under **Article 21(2)(b)**, any request under **paragraph (a)** or any notice referred to in **paragraph (c)** submitted, or any fee referred to in **paragraph (d)** paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

(f) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in **paragraph (b)(iii)** be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau a copy of any such declaration or other evidence filed with the receiving Office, in which case the International Bureau shall include such copy in its files.

(g) The receiving Office shall not refuse, totally or in part, a request under **paragraph (a)** without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under **paragraph (f)**.

(h) The receiving Office shall promptly:

(i) notify the International Bureau of the receipt of a request under **paragraph (a)**;

(ii) make a decision upon the request;

(iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

(i) Each receiving Office shall inform the International Bureau of which of the criteria for restoration it applies and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(j) If, on October 5, 2005, **paragraphs (a) to (i)** are not compatible with the national law applied by the receiving Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.<sup>4</sup>

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<sup>4</sup> *Editor's Note:* This information is also published on the WIPO website at:  
[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html).



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***R.26ter PCT Correction or Addition of Declarations under Rule 4.17***

***26ter.1 Correction or Addition of Declarations***

The applicant may correct or add to the request any declaration referred to in **Rule 4.17** by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

***26ter.2 Processing of Declarations***

(a) Where the receiving Office or the International Bureau finds that any declaration referred to in **Rule 4.17** is not worded as required or, in the case of the declaration of inventorship referred to in **Rule 4.17(iv)**, is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

(b) Where the International Bureau receives any declaration or correction under **Rule 26ter.1** after the expiration of the time limit under Rule 26ter.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

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PCT AG-IP 5.083 Can a declaration referred to in Rule 4.17 be corrected or added during the international phase?

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PCT AG-IP 6.045 Can defects in declarations referred to in Rule 4.17 be corrected? Can declarations be added?

PCT AG-IP 6.046 Which are the defects in declarations made under Rule 4.17 in respect of which the applicant may be invited to submit a correction?

PCT AG-IP 6.050 What happens where the International Bureau receives a correction or addition of a declaration referred to in Rule 4.17 after the applicable time limit?

***R.27 PCT Lack of Payment of Fees***

27.1 *Fees*

(a) For the purposes of **Article 14(3)(a)**, "fees prescribed under **Article 3(4)(iv)**" means: the transmittal fee (**Rule 14**), the international filing fee (**Rule 15.1**), the search fee (**Rule 16**), and, where required, the late payment fee (**Rule 16bis.2**).

(b) For the purposes of **Article 14(3)(a)** and **(b)**, "the fee prescribed under **Article 4(2)**" means the international filing fee (**Rule 15.1**) and, where required, the late payment fee (**Rule 16bis.2**).

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PCT AG-IP 5.193 What happens if the fees are not paid or not paid in full?

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PCT AG-IP 6.009 Does non-payment, incomplete payment or late payment of fees influence the international filing date?

***R.28 PCT Defects Noted by the International Bureau***

28.1 *Note on Certain Defects*

(a) If, in the opinion of the International Bureau, the international application contains any of the defects referred to in **Article 14(1)(a)(i), (ii) or (v)**, the International Bureau shall bring such defects to the attention of the receiving Office.

(b) The receiving Office shall, unless it disagrees with the said opinion, proceed as provided in **Article 14(1)(b)** and **Rule 26**.

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PCT AG-IP 6.051 Is the receiving Office the only authority which may note any of the above defects during the international phase?

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### **29.1**     *Finding by Receiving Office*

If the receiving Office declares, under **Article 14(1)(b)** and **Rule 26.5** (failure to correct certain defects), or under **Article 14(3)(a)** (failure to pay the prescribed fees under **Rule 27.1(a)**), or under **Article 14(4)** (later finding of non-compliance with the requirements listed in **items (i) to (iii)** of **Article 11(1)**), or under **Rule 12.3(d)** or **12.4(d)** (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under **Rule 92.4(g)(i)** (failure to furnish the original of a document), that the international application is considered withdrawn:

- (i) the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;
- (ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;
- (iii) the receiving Office shall not transmit the search copy as provided in **Rule 23**, or, if such copy has already been transmitted, it shall notify the International Searching Authority of the said declaration;
- (iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy;
- (v) no international publication of the international application shall be effected if the notification of the said declaration transmitted by the receiving Office reaches the International Bureau before the technical preparations for international publication have been completed.

### **29.2**     *[Deleted]*

### **29.3**     *Calling Certain Facts to the Attention of the Receiving Office*

If the International Bureau or the International Searching Authority considers that the receiving Office should make a finding under **Article 14(4)**, it shall call the relevant facts to the attention of the receiving Office.

### **29.4**     *Notification of Intent to Make Declaration under Article 14(4)*

- (a) Before the receiving Office issues any declaration under **Article 14(4)**, it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within two months from the date of the notification.
- (b) Where the receiving Office intends to issue a declaration under **Article 14(4)** in respect of an element mentioned in **Article 11(1)(iii)(d)** or **(e)**, the receiving Office shall, in the notification referred to in **paragraph (a)** of this Rule, invite the applicant to confirm in accordance with **Rule 20.6(a)** that the element is incorporated by reference under **Rule 4.18**. For the purposes of **Rule 20.7(a)(i)**, the invitation sent to the applicant under this paragraph shall be considered to be an invitation under **Rule 20.3(a)(ii)**.

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### R.29 PCT International Applications Considered Withdrawn

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(c) **Paragraph (b)** shall not apply where the receiving Office has informed the International Bureau in accordance with **Rule 20.8(a)** of the incompatibility of **Rules 20.3(a)(ii)** and **(b)(ii)** and **20.6** with the national law applied by that Office.

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R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

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PCT AG-IP 6.012 Can an international filing date once accorded be “taken away”?

PCT AG-IP 6.032 What defects do not influence the international filing date?

PCT AG-IP 6.051 Is the receiving Office the only authority which may note any of the above defects during the international phase?

PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.049 How can international publication be prevented?

***R.30 PCT Time Limit under Article 14(4 )***

30.1 *Time Limit*

The time limit referred to in **Article 14(4)** shall be four months from the international filing date.

**PCT Articles**

A.14 PCT Certain Defects in the International Application

**PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.012 Can an international filing date once accorded be “taken away”?

### ***R.31 PCT Copies Required under Article 13***

#### **31.1     *Request for Copies***

(a) Requests under **Article 13(1)** may relate to all, some kinds of, or individual international applications in which the national Office making the request is designated. Requests for all or some kinds of such international applications must be renewed for each year by means of a notification addressed by that Office before November 30 of the preceding year to the International Bureau.

(b) Requests under **Article 13(2)(b)** shall be subject to the payment of a fee covering the cost of preparing and mailing the copy.

#### **31.2     *Preparation of Copies***

The preparation of copies required under **Article 13** shall be the responsibility of the International Bureau.

#### **PCT Articles**

A.13 PCT Availability of Copy of the International Application to Designated Offices

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?



### ***R.32 PCT Extension of Effects of International Application to Certain Successor States***

#### *32.1 Extension of International Application to Successor State*

(a) The effects of any international application whose international filing date falls in the period defined in **paragraph (b)** are extended to a State ("the successor State") whose territory was, before the independence of that State, part of the territory of a Contracting State designated in the international application which subsequently ceased to exist ("the predecessor State"), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

(b) The period referred to in **paragraph (a)** starts on the day following the last day of the existence of the predecessor State and ends two months after the date on which the declaration referred to in **paragraph (a)** was notified by the Director General to the Governments of the States party to the Paris Convention for the Protection of Industrial Property. However, where the date of independence of the successor State is earlier than the date of the day following the last day of the existence of the predecessor State, the successor State may declare that the said period starts on the date of its independence; such a declaration shall be made together with the declaration referred to in **paragraph (a)** and shall specify the date of independence.

(c) Information on any international application whose filing date falls within the applicable period under **paragraph (b)** and whose effect is extended to the successor State shall be published by the International Bureau in the Gazette.

#### *32.2 Effects of Extension to Successor State*

(a) Where the effects of the international application are extended to the successor State in accordance with **Rule 32.1**,

(i) the successor State shall be considered as having been designated in the international application, and

(ii) the applicable time limit under **Article 22** or **39(1)** in relation to that State shall be extended until the expiration of at least six months from the date of the publication of the information under **Rule 32.1(c)**.

(b) The successor State may fix a time limit which expires later than that provided in **paragraph (a)(ii)**. The International Bureau shall publish information on such time limits in the Gazette.

#### **PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.39 PCT Copy, Translation, and Fee, to Elected Offices

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.089 What is a successor State?

PCT AG-IP 11.090 Which are the international applications whose effects are extended to a successor State?

PCT AG-IP 11.091 How will an applicant know that the effects of his international application have been extended to a successor State?

PCT AG-IP 11.092 What is the effect of an extension?

## A.15 PCT The International Search

- (1) Each international application shall be the subject of international search.
- (2) The objective of the international search is to discover relevant prior art.
- (3) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any).
- (4) The International Searching Authority referred to in **Article 16** shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.
- (5)(a) If the national law of the Contracting State so permits, the applicant who files a national application with the national Office of or acting for such State may, subject to the conditions provided for in such law, request that a search similar to an international search ("international-type search") be carried out on such application.
- (b) If the national law of the Contracting State so permits, the national Office of or acting for such State may subject any national application filed with it to an international-type search.
- (c) The international-type search shall be carried out by the International Searching Authority referred to in **Article 16** which would be competent for an international search if the national application were an international application and were filed with the Office referred to in **subparagraphs (a) and (b)**. If the national application is in a language which the International Searching Authority considers it is not equipped to handle, the international-type search shall be carried out on a translation prepared by the applicant in a language prescribed for international applications and which the International Searching Authority has undertaken to accept for international applications. The national application and the translation, when required, shall be presented in the form prescribed for international applications.

### **EPO Guidelines - A Formalities Examination**

GL A III 6.12 Copy of the search results for the priority or priorities

### **EPO Guidelines - B Search**

GL B II 4.5 International-type searches

GL B III 2.1 Completeness of the search

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 1 General

GA C IV 1 General

### **PCT Articles**

A.16 PCT The International Searching Authority

A.65 PCT Gradual Application

### **PCT Implementing Rules**

R.19 PCT The Competent Receiving Office

R.33 PCT Relevant Prior Art for the International Search

R.34 PCT Minimum Documentation

### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.001 What are the main procedural steps before the International Searching Authority?

PCT AG-IP 7.003 What is the purpose of the international search?

PCT AG-IP 7.004 What documents are searched by the International Searching Authority?

### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.001 What is supplementary international search?

## A.16 PCT The International Searching Authority

(1) International search shall be carried out by an International Searching Authority, which may be either a national Office or an intergovernmental organization, such as the International Patent Institute, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications.

(2) If, pending the establishment of a single International Searching Authority, there are several International Searching Authorities, each receiving Office shall, in accordance with the provisions of the applicable agreement referred to in **paragraph (3)(b)**, specify the International Searching Authority or Authorities competent for the searching of international applications filed with such Office.

(3)(a) International Searching Authorities shall be appointed by the Assembly. Any national Office and any intergovernmental organization satisfying the requirements referred to in **subparagraph (c)** may be appointed as International Searching Authority.

(b) Appointment shall be conditional on the consent of the national Office or intergovernmental organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office or organization and the International Bureau. The agreement shall specify the rights and obligations of the parties, in particular, the formal undertaking by the said Office or organization to apply and observe all the common rules of international search.

(c) The Regulations prescribe the minimum requirements, particularly as to manpower and documentation, which any Office or organization must satisfy before it can be appointed and must continue to satisfy while it remains appointed.

(d) Appointment shall be for a fixed period of time and may be extended for further periods.

(e) Before the Assembly makes a decision on the appointment of any national Office or intergovernmental organization, or on the extension of its appointment, or before it allows any such appointment to lapse, the Assembly shall hear the interested Office or organization and seek the advice of the Committee for Technical Cooperation referred to in **Article 56** once that Committee has been established.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 35 The International Searching Authority (ISA)

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 2 Competence of the EPO as ISA

#### **PCT Articles**

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

A.15 PCT The International Search

A.32 PCT The International Preliminary Examining Authority

A.56 PCT Committee for Technical Cooperation

#### **PCT Implementing Rules**

R.16 PCT The Search Fee

R.35 PCT The Competent International Searching Authority

R.36 PCT Minimum Requirements for International Searching Authorities

R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.45bis PCT Supplementary International Searches

## A.16 PCT The International Searching Authority

### R.32 PCT Extension of Effects of International Application to Certain Successor States

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#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search? What are the benefits of this for applicants?

PCT AG-IP 5.197 In what cases are fees refunded?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.002 Which International Searching Authority is competent?

#### **General Case Law**

W 17/03 Invitation to pay additional fees sufficiently reasoned (yes) / Investigation of technical relationships with the aid [...]

## A.17 PCT Procedure Before the International Searching Authority

(1) Procedure before the International Searching Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.

(2)(a) If the International Searching Authority considers

(i) that the international application relates to a subject matter which the International Searching Authority is not required, under the Regulations, to search, and in the particular case decides not to search, or

(ii) that the description, the claims, or the drawings, fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out,

the said Authority shall so declare and shall notify the applicant and the International Bureau that no international search report will be established.

(b) If any of the situations referred to in **subparagraph (a)** is found to exist in connection with certain claims only, the international search report shall so indicate in respect of such claims, whereas, for the other claims, the said report shall be established as provided in **Article 18**.

(3)(a) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. The International Searching Authority shall establish the international search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.

(b) The national law of any designated State may provide that, where the national Office of that State finds the invitation, referred to in **subparagraph (a)**, of the International Searching Authority justified and where the applicant has not paid all additional fees, those parts of the international application which consequently have not been searched shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

### EPC Implementing Rules

R.158 EPC The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

### EPO Guidelines - B Search

GL B II 4.2 Additional European searches

### EPO Guidelines - C Procedural Aspects of Substantive Examination

GL C II 1.2 Euro-PCT applications

GL C III 3.1.1 No additional search fees paid

GL C III 3.3 Refund of additional search fees

### EPO Guidelines - E General Procedural Matters

GL E VIII 2.7 Communication to the EPO as a designated Office

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 2 No search

GA C III 3 Incomplete search

GA C III 4 Limitations related to the subject-matter

GA C III 6 Complex applications

GA C III 8 Lack of unity of invention

GA C III 10 Consequences of non-payment of additional fee(s)

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 2 Usefulness of PCT Chapter II

GA D II 14 Refusal to perform preliminary examination

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E IX 1 No supplementary European search performed

**PCT Articles**

A.18 PCT The International Search Report

A.20 PCT Communication to Designated Offices

A.21 PCT International Publication

A.22 PCT Copy, Translation, and Fee, to Designated Offices

**PCT Implementing Rules**

R.6 PCT The Claims

R.40 PCT Lack of Unity of Invention (International Search)

R.42 PCT Time Limit for International Search

R.43 PCT The International Search Report

R.43bis PCT Written Opinion of the International Searching Authority

R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.45 PCT Translation of the International Search Report

R.45bis PCT Supplementary International Searches

R.47 PCT Communication to Designated Offices

R.48 PCT International Publication

R.54bis PCT Time Limit for Making a Demand

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.88 PCT Amendment of the Regulations

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.112 How must claims be drafted?

PCT AG-IP 5.179 In how many copies must an international application be filed?

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.013 May the International Searching Authority refuse to search certain subject matter?

PCT AG-IP 7.014 May the International Searching Authority refuse to search international applications which are unclear or have other defects?

PCT AG-IP 7.015 What is the purpose of the requirement of “unity of invention”?

PCT AG-IP 7.016 What happens where the International Searching Authority considers that the international application does not meet the requirement of unity of invention?

PCT AG-IP 7.021 What happens if the applicant does not pay the additional fees as invited?

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

**PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.024 When and how may the applicant select certain inventions to be searched?

PCT AG-IP 8.041 What are the consequences if the Authority finds that carrying out the supplementary international search is excluded by a limitation or condition?

PCT AG-IP 8.042 May the Authority refuse to search certain claims?

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?

PCT AG-IP 9.014 When does international publication take place?

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.010 At what stage of the procedure should the demand for international preliminary examination be submitted?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

**Case Law of the Enlarged Board**

G 1/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

G 2/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

**Case Law with Headnote**

J 20/89 EPO acting solely as IPEA / Appellate jurisdiction of Boards of Appeal in internat. phase (no)

T 87/88 Uneinheitlichkeit bei der Recherche beanstandet / Die Mitteilung der Recherchenabteilung keine beschwerdefähige [...]

T 631/97 Non-payment of further search fees

## A.17 PCT Procedure Before the International Searching Authority

### R.32 PCT Extension of Effects of International Application to Certain Successor States

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#### **General Case Law**

T 690/06 Declaration pursuant to Article 17(2)(a) PCT / Additional search / Substantial procedural violation (no) / Remittal [...]

#### **Case Law with Headnote**

W 7/85 Unity of invention - mixture and component

W 4/87 Fees (additional) paid within the prescribed time limit / Late submission of protest / Protest - late submission

W 3/88 Unity a posteriori / Invitation to pay additional fees following a posteriori examination of unity of invention (no) / [...]

#### **General Case Law**

W 29/88 Unity of invention - identity of structural scope in claims of different categories

#### **Case Law with Headnote**

W 31/88 Invitation to pay additional fees on the grounds of alleged lack of clarity

W 32/88 Apparatus specifically designed for carrying out a process / Process - apparatus / Apparatus - other applications

#### **General Case Law**

W 35/88 Nichteinheitlichkeit a posteriori - Begründung in der Aufforderung nach R.40 PCT

#### **Case Law with Headnote**

W 44/88 Admissibility of an "a posteriori" objection of lack of unity (yes) / Single general inventive concept (yes)

#### **General Case Law**

W 3/89 Unity of Invention - the possibilities of R. 13.2 are not exhaustive / Intermediate and process for obtaining it are [...]

W 7/89 Invitation à payer fondée sur une objection d'absence d'unité de l'invention a priori et sur une allégation d'un [...]

W 11/89 Uneinheitlichkeit - Hervorhebung von Worten durch Unterstreichung bei Aufzählung - Begründungsmangel - Aufforderung [...]

W 12/89 No reason in invitation for a posteriori consideration / Unreasoned allegation of lack of novelty / Not a clear case [...]

W 13/89 Unity of invention (yes)

W 14/89 Aufforderung zur Zahlung zusätzlicher Recherchegebühr / Keine nachvollziehbare Begründung ohne Berücksichtigung der [...]

W 17/89 Lack of unity (no)

W 19/89 Non-unity a posteriori (yes) / Reimbursement of the additional search fees (yes) / Inventions conceptually closely [...]

W 21/89 Uneinheitlichkeit a posteriori

W 27/89 Nichteinheitlichkeit a posteriori in klaren Fällen (bejaht), Begründung der Zahlungsaufforderung

W 30/89 Aufforderung zur Zahlung - nicht begründet / Uneinheitlichkeit a priori - nein / Abhängige Ansprüche - Aggregation von [...]

#### **Case Law with Headnote**

W 6/90 A priori absence of unity / Single general concept not inventive

#### **General Case Law**

W 18/90 -

W 24/90 Uneinheitlichkeit a posteriori (verneint)

W 26/90 Lack of unity a priori between the independent claims / No clear case for lack of unity a posteriori for dependent [...]

W 36/90 Non-unity a posteriori (no)

W 38/90 Unity a priori (no)

W 48/90 a priori lack of unity of invention (confirmed)

W 50/90 Lack of unity a priori (yes) - first medical indication vs. process of preparation

W 5/91 Unity of invention (no - subsequent different medical indications) (yes - second medical indication for compounds of a [...])

W 8/91 Uneinheitlichkeit a posteriori - nicht begründet

W 14/91 Uneinheitlichkeit a posteriori - nicht begründet

W 16/91 Uneinheitlichkeit a priori (verneint) / Mangelnde Begründung

W 17/91 Lack of unity a posteriori / Insufficient reasons in the invitation

W 21/91 Uneinheitlichkeit a priori (nein) - zusammenhängende Erfindungen

W 22/91 Lack of unity a posteriori (no)

W 23/91 Lack of unity a posteriori / No examination of inventive step in cases that are not clear / Non-unity not established [...]

W 28/91 Non-unity a priori (no) / Second medical indication for compounds of a general formula and first medical indication [...]

W 31/91 Non-unity a posteriori - yes

W 35/91 Non-unity of invention a priori (no) / Structural relationship between compounds / Structural relationship between [...]

W 50/91 Lack of unity a priori (no) - / Lack of reasons in the invitation

## A.17 PCT Procedure Before the International Searching Authority

### R.32 PCT Extension of Effects of International Application to Certain Successor States

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W 52/91 Einheitlichkeit a priori (nein)

W 5/92 Lack of unity a priori (yes)

W 10/92 Frage der Einheitlichkeit a posteriori kein klarer Fall - Rückzahlung der zusätzlichen Recherchegebühr

W 22/92 Non-unity a priori - partially contested - unity of invention acknowledged to the extent requested in the protest

W 29/92 Lack of unity (no); inadequate reasons / Unity of invention acknowledged to the extent requested in the protest

#### **Case Law with Headnote**

W 32/92 Uneinheitlichkeit a posteriori (bejaht)

#### **General Case Law**

W 33/92 Unity of invention (yes)

W 34/92 -

W 38/92 Lack of unity (no); inadequate reasons

W 40/92 Einheitlichkeit a priori (ja)

W 45/92 Lack of unity a posteriori

W 52/92 Lack of unity a priori (no)

W 3/93 Widerspruch unzulässig

#### **Case Law with Headnote**

W 3/94 Begründungspflicht nach R. 40.1 PCT im Hinblick auf die Vorschriften in den PCT-Richtlinien nicht erfüllt

#### **General Case Law**

W 2/95 Einheitlichkeit der Erfindungen von Produkt und Verfahren zu dessen Herstellung beim Fehlen wörtlich gleicher [...]

W 6/95 Common new property (yes) / Significant structural element (yes)

W 1/96 -

#### **Case Law with Headnote**

W 4/96 Lack of unity a posteriori - yes / Absence of a common technical feature defining a contribution of the claimed [...]

W 1/97 -

#### **General Case Law**

W 6/97 Lack of unity of invention a posteriori - not established / Determination of single general inventive concept / [...]

W 9/02 Unity-protest partially justified (Reimbursement of one additional search fee) / Clarity objections to be [...]

W 9/03 Einheitlichkeit a posteriori (nein)

W 17/03 Invitation to pay additional fees sufficiently reasoned (yes) / Investigation of technical relationships with the aid [...]

W 1/06 Applicant not adversely affected - no need for further reviewing the protest / Protest fee - refund (yes)

#### **Case Law with Headnote**

W 18/06 Erfüllung der Bedingungen für die Anerkennung des Widerspruchs als erhoben - fristgemäße Zahlung der [...]

#### **General Case Law**

W 20/06 Competence of the Boards of Appeal for examining the protest (yes) / Protest fee duly paid (yes) / Admissibility of [...]

W 22/06 Unity of invention (yes)

W 2/07 Admissibility of the protest - (no)

W 6/07 -



## A.18 PCT The International Search Report

- (1) The international search report shall be established within the prescribed time limit and in the prescribed form.
- (2) The international search report shall, as soon as it has been established, be transmitted by the International Searching Authority to the applicant and the International Bureau.
- (3) The international search report or the declaration referred to in **Article 17(2)(a)** shall be translated as provided in the Regulations. The translations shall be prepared by or under the responsibility of the International Bureau.

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 2 Establishing the ISR and the WO-ISA

#### **PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.001 What are the main procedural steps before the International Searching Authority?

PCT AG-IP 7.023 When must the international search report be established?

PCT AG-IP 7.025 How do the applicant and the International Bureau receive the international search report?

#### **Case Law with Headnote**

J 8/83 Examination fee/refund of / Refund of examination fee / Invitation by the EPO

#### **General Case Law**

J 9/83 Euro-PCT-applications - Supplementary European search report - legal nature / Examination fee - refund of (yes) - [...]

### ***R.33 PCT Relevant Prior Art for the International Search***

#### ***33.1 Relevant Prior Art for the International Search***

(a) For the purposes of **Article 15(2)**, relevant 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.

(b) When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

(c) Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of **Article 15(2)** had it been published prior to the international filing date, shall be specially mentioned in the international search report.

#### ***33.2 Fields to Be Covered by the International Search***

(a) The international search shall cover all those technical fields, and shall be carried out on the basis of all those search files, which may contain material pertinent to the invention.

(b) Consequently, not only shall the art in which the invention is classifiable be searched but also analogous arts regardless of where classified.

(c) The question what arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary essential function or use of the invention and not only the specific functions expressly indicated in the international application.

(d) The international search shall embrace all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features, even though, in its specifics, the invention as described in the international application is different.

#### ***33.3 Orientation of the International Search***

(a) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed.

(b) In so far as possible and reasonable, the international search shall cover the entire subject matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended.

#### **EPO Guidelines - B Search**

GL B VI 2 State of the art – oral disclosure, etc.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

## A.18 PCT The International Search Report

### R.33 PCT Relevant Prior Art for the International Search

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GA C II 1 General

#### **PCT Articles**

A.15 PCT The International Search

#### **PCT Implementing Rules**

R.43 PCT The International Search Report

R.45bis PCT Supplementary International Searches

R.88 PCT Amendment of the Regulations

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.003 What is the purpose of the international search?

#### **Case Law of the Enlarged Board**

G 1/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

G 2/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

#### **Case Law with Headnote**

W 3/88 Unity a posteriori / Invitation to pay additional fees following a posteriori examination of unity of invention (no) / [...]

#### **General Case Law**

W 21/89 Uneinheitlichkeit a posteriori

### ***R.34 PCT Minimum Documentation***

#### **34.1 Definition**

- (a) The definitions contained in **Article 2(i)** and **(ii)** shall not apply for the purposes of this Rule.
- (b) The documentation referred to in **Article 15(4)** ("minimum documentation") shall consist of:
- (i) the "national patent documents" as specified in **paragraph (c)**,
  - (ii) the published international (PCT) applications, the published regional applications for patents and inventors' certificates, and the published regional patents and inventors' certificates,
  - (iii) such other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau when agreed upon for the first time and whenever changed.
- (c) Subject to **paragraphs (d)** and **(e)**, the "national patent documents" shall be the following:
- (i) the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the former Soviet Union, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America,
  - (ii) the patents issued by the Federal Republic of Germany, the Republic of Korea and the Russian Federation,
  - (iii) the patent applications, if any, published in and after 1920 in the countries referred to in **items (i)** and **(ii)**,
  - (iv) the inventors' certificates issued by the former Soviet Union,
  - (v) the utility certificates issued by, and the published applications for utility certificates of, France,
  - (vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.
- (d) Where an application is republished once (for example, an *Offenlegungsschrift* as an *Auslegeschrift*) or more than once, no International Searching Authority shall be obliged to keep all versions in its documentation; consequently, each such Authority shall be entitled not to keep more than one version. Furthermore, where an application is granted and is issued in the form of a patent or a utility certificate (France), no International Searching Authority shall be obliged to keep both the application and the patent or utility certificate (France) in its documentation; consequently, each such Authority shall be entitled to keep either the application only or the patent or utility certificate (France) only.
- (e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after

A.18 PCT The International Search Report  
R.34 PCT Minimum Documentation

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the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) For the purposes of this Rule, applications which have only been laid open for public inspection are not considered published applications.

**EPO Guidelines - B Search**

GL B III 2.1 Completeness of the search

GL B IX 1.1 Organisation and composition of the documentation available to the Search Divisions

GL B IX 2.1 PCT minimum documentation

**PCT Articles**

A.2 PCT Definitions

A.15 PCT The International Search

**PCT Implementing Rules**

R.36 PCT Minimum Requirements for International Searching Authorities

R.43 PCT The International Search Report

R.63 PCT Minimum Requirements for International Preliminary Examining Authorities

R.88 PCT Amendment of the Regulations

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.004 What documents are searched by the International Searching Authority?

### ***R.35 PCT The Competent International Searching Authority***

#### **35.1**     *When Only One International Searching Authority Is Competent*

Each receiving Office shall, in accordance with the terms of the applicable agreement referred to in **Article 16(3)(b)**, inform the International Bureau which International Searching Authority is competent for the searching of the international applications filed with it, and the International Bureau shall promptly publish such information.

#### **35.2**     *When Several International Searching Authorities Are Competent*

(a) Any receiving Office may, in accordance with the terms of the applicable agreement referred to in **Article 16(3)(b)**, specify several International Searching Authorities:

(i) by declaring all of them competent for any international application filed with it, and leaving the choice to the applicant, or

(ii) by declaring one or more competent for certain kinds of international applications filed with it, and declaring one or more others competent for other kinds of international applications filed with it, provided that, for those kinds of international applications for which several International Searching Authorities are declared to be competent, the choice shall be left to the applicant.

(b) Any receiving Office availing itself of the faculty provided in **paragraph (a)** shall promptly inform the International Bureau, and the International Bureau shall promptly publish such information.

#### **35.3**     *When the International Bureau Is Receiving Office under **Rule 19.1(a)(iii)***

(a) Where the international application is filed with the International Bureau as receiving Office under **Rule 19.1(a)(iii)**, an International Searching Authority shall be competent for the searching of that international application if it would have been competent had that international application been filed with a receiving Office competent under **Rule 19.1(a)(i)** or **(ii)**, **(b)** or **(c)** or **Rule 19.2(i)**.

(b) Where two or more International Searching Authorities are competent under **paragraph (a)**, the choice shall be left to the applicant.

(c) **Rules 35.1** and **35.2** shall not apply to the International Bureau as receiving Office under **Rule 19.1(a)(iii)**.

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 2 Competence of the EPO as ISA

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 7 Choice of applicant

**PCT Articles**

A.16 PCT The International Searching Authority

**PCT Implementing Rules**

R.19 PCT The Competent Receiving Office

R.59 PCT The Competent International Preliminary Examining Authority

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.002 Which International Searching Authority is competent?

### ***R.36 PCT Minimum Requirements for International Searching Authorities***

#### **36.1**     *Definition of Minimum Requirements*

The minimum requirements referred to in **Article 16(3)(c)** shall be the following:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches;
- (ii) that Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in **Rule 34**, properly arranged for search purposes, on paper, in microform or stored on electronic media;
- (iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in **Rule 34** is written or is translated;
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;
- (v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

#### **EPO Guidelines - B Search**

GL B IX 1.1 Organisation and composition of the documentation available to the Search Divisions

#### **PCT Articles**

A.16 PCT The International Searching Authority

#### **PCT Implementing Rules**

R.34 PCT Minimum Documentation

### ***R.37 PCT Missing or Defective Title***

#### **37.1**     *Lack of Title*

If the international application does not contain a title and the receiving Office has notified the International Searching Authority that it has invited the applicant to correct such defect, the International Searching Authority shall proceed with the international search unless and until it receives notification that the said application is considered withdrawn.

#### **37.2**     *Establishment of Title*

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with **Rule 4.3**, it shall itself establish a title. Such title shall be established in the language in which the international application is to be published or, if a translation into another language was transmitted under **Rule 23.1(b)** and the International Searching Authority so wishes, in the language of that translation.

#### **EPO Guidelines - B Search**

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

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.49 PCT Copy, Translation and Fee under Article 22

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.022 What happens if the International Searching Authority finds that the title of the invention or the abstract is missing or defective?



### ***R.38 PCT Missing or Defective Abstract***

#### **38.1**     *Lack of Abstract*

If the international application does not contain an abstract and the receiving Office has notified the International Searching Authority that it has invited the applicant to correct such defect, the International Searching Authority shall proceed with the international search unless and until it receives notification that the said application is considered withdrawn.

#### **38.2**     *Establishment of Abstract*

If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with **Rule 8**, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published or, if a translation into another language was transmitted under **Rule 23.1(b)** and the International Searching Authority so wishes, in the language of that translation.

#### **38.3**     *Modification of Abstract*

The applicant may, until the expiration of one month from the date of mailing of the international search report, submit to the International Searching Authority:

- (i) proposed modifications of the abstract; or
- (ii) where the abstract has been established by the Authority, proposed modifications of, or comments on, that abstract, or both modifications and comments;

and the Authority shall decide whether to modify the abstract accordingly. Where the Authority modifies the abstract, it shall notify the modification to the International Bureau.

#### **EPO Guidelines - B Search**

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

#### **PCT Implementing Rules**

R.8 PCT The Abstract

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.173 What happens if the abstract is missing or defective?

PCT AG-IP 5.174 Can an abstract be corrected even if the International Searching Authority has already approved it?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.022 What happens if the International Searching Authority finds that the title of the invention or the abstract is missing or defective?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.033 Can obvious mistakes be rectified by the applicant?

***R.39 PCT Subject Matter under Article 17(2)(a)(i)***

39.1 *Definition*

No International Searching Authority shall be required to search an international application if, and to the extent to which, its subject matter is any of the following:

- (i) scientific and mathematical theories,
- (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information,
- (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

**EPO Guidelines - B Search**

GL B VIII 1 General remarks

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 4 Limitations related to the subject-matter

GA C III 5 Business methods

**PCT Implementing Rules**

R.45bis PCT Supplementary International Searches

R.88 PCT Amendment of the Regulations

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.013 May the International Searching Authority refuse to search certain subject matter?

**Case Law of the Enlarged Board**

G 1/07 Applicable provisions - Art. 112(1) EPC 1973 - Art. 53(c) EPC" / Admissibility of the referral - yes / The Vienna [..]

**Case Law with Headnote**

T 1194/97 Presentation of information as such - no / Clarity - yes / Novelty - yes / Inventive step - yes

**General Case Law**

T 613/99 Recherche incomplète effectuée en vertu de la règle 45 CBE ou 39(1) PCT / Décision de rejet au titre de la règle 86(4) [..]

***R.40 PCT Lack of Unity of Invention (International Search)***

**40.1**     *Invitation to Pay Additional Fees; Time Limit*

The invitation to pay additional fees provided for in **Article 17(3)(a)** shall:

- (i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;
- (ii) invite the applicant to pay the additional fees within one month from the date of the invitation, and indicate the amount of those fees to be paid; and
- (iii) invite the applicant to pay, where applicable, the protest fee referred to in **Rule 40.2(e)** within one month from the date of the invitation, and indicate the amount to be paid.

**40.2**     *Additional Fees*

- (a) The amount of the additional fees due for searching under **Article 17(3)(a)** shall be determined by the competent International Searching Authority.
- (b) The additional fees due for searching under **Article 17(3)(a)** shall be payable direct to the International Searching Authority.
- (c) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive. Such protest shall be examined by a review body constituted in the framework of the International Searching Authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under **Article 22**.
- (d) The membership of the review body referred to in **paragraph (c)** may include, but shall not be limited to, the person who made the decision which is the subject of the protest.
- (e) The examination of a protest referred to in **paragraph (c)** may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee. Where the applicant has not, within the time limit under **Rule 40.1(iii)**, paid any required protest fee, the protest shall be considered not to have been made and the International Searching Authority shall so declare. The protest fee shall be refunded to the applicant where the review body referred to in **paragraph (c)** finds that the protest was entirely justified.

**EPC Implementing Rules**

R.158 EPC The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

**EPC Rules relating to Fees**

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

**EPO Guidelines - C Procedural Aspects of Substantive Examination**

GL C III 3.3 Refund of additional search fees

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 8 Lack of unity of invention

GA C III 11 Protest procedure

**PCT Articles**

## A.18 PCT The International Search Report

### R.40 PCT Lack of Unity of Invention (International Search)

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A.17 PCT Procedure Before the International Searching Authority

A.22 PCT Copy, Translation, and Fee, to Designated Offices

#### **PCT Implementing Rules**

R.45bis PCT Supplementary International Searches

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.016 What happens where the International Searching Authority considers that the international application does not meet the requirement of unity of invention?

PCT AG-IP 7.019 May the applicant protest against payment of the additional fees?

#### **Case Law of the Enlarged Board**

G 1/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

G 2/89 Competence of the Enlarged Board of Appeal in protest cases under PCT / Non-unity a posteriori

#### **Case Law with Headnote**

W 7/85 Unity of invention - mixture and component

#### **General Case Law**

W 3/87 Einheitlichkeit abhängiger Ansprüche

#### **Case Law with Headnote**

W 4/87 Fees (additional) paid within the prescribed time limit / Late submission of protest / Protest - late submission

#### **General Case Law**

W 2/88 Single general inventive concept (no)

#### **Case Law with Headnote**

W 3/88 Unity a posteriori / Invitation to pay additional fees following a posteriori examination of unity of invention (no) / [...]

#### **General Case Law**

W 29/88 Unity of invention - identity of structural scope in claims of different categories

#### **Case Law with Headnote**

W 31/88 Invitation to pay additional fees on the grounds of alleged lack of clarity

W 32/88 Apparatus specifically designed for carrying out a process / Process - apparatus / Apparatus - other applications

#### **General Case Law**

W 35/88 Nichteinheitlichkeit a posteriori - Begründung in der Aufforderung nach R.40 PCT

#### **Case Law with Headnote**

W 44/88 Admissibility of an "a posteriori" objection of lack of unity (yes) / Single general inventive concept (yes)

#### **General Case Law**

W 3/89 Unity of Invention - the possibilities of R. 13.2 are not exhaustive / Intermediate and process for obtaining it are [...]

W 7/89 Invitation à payer fondée sur une objection d'absence d'unité de l'invention a priori et sur une allégation d'un [...]

W 11/89 Uneinheitlichkeit - Hervorhebung von Worten durch Unterstreichung bei Aufzählung - Begründungsmangel - Aufforderung [...]

W 12/89 No reason in invitation for a posteriori consideration / Unreasoned allegation of lack of novelty / Not a clear case [...]

W 13/89 Unity of invention (yes)

W 14/89 Aufforderung zur Zahlung zusätzlicher Recherchegebühr / Keine nachvollziehbare Begründung ohne Berücksichtigung der [...]

W 16/89 Unity of Invention - Method and devices (yes)

W 21/89 Uneinheitlichkeit a posteriori

W 27/89 Nichteinheitlichkeit a posteriori in klaren Fällen (bejaht), Begründung der Zahlungsaufforderung

W 30/89 Aufforderung zur Zahlung - nicht begründet / Uneinheitlichkeit a priori - nein / Abhängige Ansprüche -

Aggregation von [...]

W 32/89 Unité d'invention de revendications dépendante (non)

#### **Case Law with Headnote**

W 6/90 A priori absence of unity / Single general concept not inventive

#### **General Case Law**

W 18/90 -

W 19/90 Nicht-Einheitlichkeit a posteriori (bejaht)

W 24/90 Uneinheitlichkeit a posteriori (verneint)

W 26/90 Lack of unity a priori between the independent claims / No clear case for lack of unity a posteriori for dependent [...]

W 36/90 Non-unity a posteriori (no)

W 38/90 Unity a priori (no)

W 48/90 a priori lack of unity of invention (confirmed)

W 50/90 Lack of unity a priori (yes) - first medical indication vs. process of preparation

W 59/90 Begründung mangelnder Einheitlichkeit a priori mit mangelnder Klarheit unzulässig / Begründungsmangel / Beurteilung [...]

W 5/91 Unity of invention (no - subsequent different medical indications) (yes - second medical indication for compounds of a [...])

W 6/91 Determination of the technical problem as precondition for assessment of unity of invention / Failure to determine the [...]

W 8/91 Uneinheitlichkeit a posteriori - nicht begründet

W 14/91 Uneinheitlichkeit a posteriori - nicht begründet

W 16/91 Uneinheitlichkeit a priori (verneint) / Mangelnde Begründung

W 17/91 Lack of unity a posteriori / Insufficient reasons in the invitation

W 21/91 Uneinheitlichkeit a priori (nein) - zusammenhängende Erfindungen

## A.18 PCT The International Search Report

### R.40 PCT Lack of Unity of Invention (International Search)

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W 23/91 Lack of unity a posteriori / No examination of inventive step in cases that are not clear / Non-unity not established [...]

W 28/91 Non-unity a priori (no) / Second medical indication for compounds of a general formula and first medical indication [...]

W 31/91 Non-unity a posteriori - yes

W 35/91 Non-unity of invention a priori (no) / Structural relationship between compounds / Structural relationship between [...]

W 43/91 Invitation to pay additional search fees - without legal effect in the absence of reasons given for alleged lack of [...]

W 50/91 Lack of unity a priori (no) - / Lack of reasons in the invitation

W 52/91 Einheitlichkeit a priori (nein)

W 5/92 Lack of unity a priori (yes)

W 10/92 Frage der Einheitlichkeit a posteriori kein klarer Fall - Rückzahlung der zusätzlichen Recherchegebühr

W 22/92 Non-unity a priori - partially contested - unity of invention acknowledged to the extent requested in the protest

W 29/92 Lack of unity (no); inadequate reasons / Unity of invention acknowledged to the extent requested in the protest

#### **Case Law with Headnote**

W 32/92 Uneinheitlichkeit a posteriori (bejaht)

#### **General Case Law**

W 33/92 Unity of invention (yes)

W 34/92 -

W 38/92 Lack of unity (no); inadequate reasons

W 40/92 Einheitlichkeit a priori (ja)

W 45/92 Lack of unity a posteriori

W 52/92 Lack of unity a priori (no)

W 3/93 Widerspruch unzulässig

W 8/93 Scope of the examination according to Rule 40.2(c) PCT / No reimbursement of the protest fee

W 1/94 Non-unité a postérieure (non) - activité commune

#### **Case Law with Headnote**

W 3/94 Begründungspflicht nach R. 40.1 PCT im Hinblick auf die Vorschriften in den PCT-Richtlinien nicht erfüllt

#### **General Case Law**

W 8/94 Invitation to pay an additional search fee - not sufficiently motivated and not justified

W 2/95 Einheitlichkeit der Erfindungen von Produkt und Verfahren zu dessen Herstellung beim Fehlen wörtlich gleicher [...]

W 6/95 Common new property (yes) / Significant structural element (yes)

W 1/96 -

#### **Case Law with Headnote**

W 4/96 Lack of unity a posteriori - yes / Absence of a common technical feature defining a contribution of the claimed [...]

W 1/97 -

#### **General Case Law**

W 6/97 Lack of unity of invention a posteriori - not established / Determination of single general inventive concept / [...]

W 9/02 Unity-protest partially justified (Reimbursement of one additional search fee) / Clarity objections to be [...]

W 9/03 Einheitlichkeit a posteriori (nein)

W 17/03 Invitation to pay additional fees sufficiently reasoned (yes) / Investigation of technical relationships with the aid [...]

W 21/04 Défaut d'unité d'invention à cause de l'omission d'une caractéristique dans les revendications telles qu'elles ont été [...]

W 1/06 Applicant not adversely affected - no need for further reviewing the protest / Protest fee - refund (yes)

#### **Case Law with Headnote**

W 18/06 Erfüllung der Bedingungen für die Anerkennung des Widerspruchs als erhoben - fristgemäße Zahlung der [...]

#### **General Case Law**

W 20/06 Competence of the Boards of Appeal for examining the protest (yes) / Protest fee duly paid (yes) / Admissibility of [...]

W 22/06 Unity of invention (yes)

W 26/06 -

W 6/07 -

## ***R.41 PCT Taking into Account Results of Earlier Search***

### **41.1     *Taking into Account Results of Earlier Search***

Where the applicant has, under **Rule 4.12**, requested the International Searching Authority to take into account the results of an earlier search and has complied with **Rule 12bis.1** and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

#### **EPO Guidelines - A Formalities Examination**

GL A X 10.2.3 Refund of the international search fee

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 37 Refund of the search fee paid for a priority application

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 11 Refund of the search fee

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.12bis PCT Copy of Results of Earlier Search and of Earlier Application; Translation

R.16 PCT The Search Fee

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search?

What are the benefits of this for applicants?

PCT AG-IP 5.197 In what cases are fees refunded?

#### **General Case Law**

W 22/06 Unity of invention (yes)

### ***R.42 PCT Time Limit for International Search***

#### ***42.1 Time Limit for International Search***

The time limit for establishing the international search report or the declaration referred to in **Article 17(2)(a)** shall be three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 2 Establishing the ISR and the WO-ISA

**PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.023 When must the international search report be established?

### ***R.43 PCT The International Search Report***

#### **43.1**     *Identifications*

The international search report shall identify the International Searching Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant, and the international filing date.

#### **43.2**     *Dates*

The international search report shall be dated and shall indicate the date on which the international search was actually completed. It shall also indicate the filing date of any earlier application whose priority is claimed or, if the priority of more than one earlier application is claimed, the filing date of the earliest among them.

#### **43.3**     *Classification*

(a) The international search report shall contain the classification of the subject matter at least according to the International Patent Classification.

(b) Such classification shall be effected by the International Searching Authority.

#### **43.4**     *Language*

Every international search report and any declaration made under **Article 17(2)(a)** shall be in the language in which the international application to which it relates is to be published, provided that:

(i) if a translation of the international application into another language was transmitted under **Rule 23.1(b)** and the International Searching Authority so wishes, the international search report and any declaration made under **Article 17(2)(a)** may be in the language of that translation;

(ii) if the international application is to be published in the language of a translation furnished under **Rule 12.4** which is not accepted by the International Searching Authority and that Authority so wishes, the international search report and any declaration made under **Article 17(2)(a)** may be in a language which is both a language accepted by that Authority and a language of publication referred to in **Rule 48.3(a)**.

#### **43.5**     *Citations*

(a) The international search report shall contain the citations of the documents considered to be relevant.

(b) The method of identifying any cited document shall be regulated by the Administrative Instructions.

(c) Citations of particular relevance shall be specially indicated.

(d) Citations which are not relevant to all the claims shall be cited in relation to the claim or claims to which they are relevant.

(e) If only certain passages of the cited document are relevant or particularly relevant, they shall be identified, for example, by indicating the page, the column, or the lines, where the passage appears. If



the entire document is relevant but some passages are of particular relevance, such passages shall be identified unless such identification is not practicable.

43.6 *Fields Searched*

(a) The international search report shall list the classification identification of the fields searched. If that identification is effected on the basis of a classification other than the International Patent Classification, the International Searching Authority shall publish the classification used.

(b) If the international search extended to patents, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, utility certificates of addition, or published applications for any of those kinds of protection, of States, periods, or languages, not included in the minimum documentation as defined in **Rule 34**, the international search report shall, when practicable, identify the kinds of documents, the States, the periods, and the languages to which it extended. For the purposes of this paragraph, **Article 2(ii)** shall not apply.

(c) If the international search was based on, or was extended to, any electronic data base, the international search report may indicate the name of the data base and, where considered useful to others and practicable, the search terms used.

43.6bis *Consideration of Rectifications of Obvious Mistakes*

(a) A rectification of an obvious mistake that is authorized under **Rule 91.1** shall, subject to **paragraph (b)**, be taken into account by the International Searching Authority for the purposes of the international search and the international search report shall so indicate.

(b) A rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search if it is authorized by or notified to that Authority, as applicable, after it has begun to draw up the international search report, in which case the report shall, if possible, so indicate, failing which the International Searching Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

43.7 *Remarks Concerning Unity of Invention*

If the applicant paid additional fees for the international search, the international search report shall so indicate. Furthermore, where the international search was made on the main invention only or on less than all the inventions (**Article 17(3)(a)**), the international search report shall indicate what parts of the international application were and what parts were not searched.

43.8 *Authorized Officer*

The international search report shall indicate the name of the officer of the International Searching Authority responsible for that report.

43.9 *Additional Matter*

The international search report shall contain no matter other than that specified in **Rules 33.1(b)** and **(c)**, **43.1** to **43.3**, **43.5** to **43.8**, and **44.2**, and the indication referred to in **Article 17(2)(b)**, provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.

## A.18 PCT The International Search Report

### R.43 PCT The International Search Report

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#### 43.10 *Form*

The physical requirements as to the form of the international search report shall be prescribed by the Administrative Instructions.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 1 The role of the EPO as ISA

GA C I 8 Application filed in Dutch

GA C II 2 Establishing the ISR and the WO-ISA

#### **PCT Articles**

A.2 PCT Definitions

A.17 PCT Procedure Before the International Searching Authority

#### **PCT Implementing Rules**

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.33 PCT Relevant Prior Art for the International Search

R.34 PCT Minimum Documentation

R.43bis PCT Written Opinion of the International Searching Authority

R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.45bis PCT Supplementary International Searches

R.48 PCT International Publication

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.001 What are the main procedural steps before the International Searching Authority?

PCT AG-IP 7.024 What are the contents of the international search report?

### ***R.43bis PCT Written Opinion of the International Searching Authority***

#### ***43bis.1 Written Opinion***

(a) Subject to **Rule 69.1(b-bis)**, the International Searching Authority shall, at the same time as it establishes the international search report or the declaration referred to in **Article 17(2)(a)**, establish a written opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) For the purposes of establishing the written opinion, **Articles 33(2) to (6), 35(2) and (3) and Rules 43.4, 43.6bis, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a)** shall apply *mutatis mutandis*.

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under **Rule 66.1bis(a)** but subject to **Rule 66.1bis(b)**, be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of **Rule 66.2(a)**, in which case the applicant is invited to submit to that Authority, before the expiration of the time limit under **Rule 54bis.1(a)**, a written reply together, where appropriate, with amendments.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 1 General remarks

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R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.44bis PCT International Preliminary Report on Patentability by the International Searching Authority

R.44ter PCT Confidential Nature of Written Opinion, Report, Translation and Observations

R.45bis PCT Supplementary International Searches

R.54bis PCT Time Limit for Making a Demand

R.62 PCT Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

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R.64 PCT Prior Art for International Preliminary Examination

R.65 PCT Inventive Step or Non-Obviousness

R.66 PCT Procedure before the International Preliminary Examining Authority

R.67 PCT Subject Matter under Article 34(4)(a)(i)

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.72 PCT Translation of the International Preliminary Examination Report and of the Written Opinion of the International Searching Authority

R.73 PCT Communication of the International Preliminary Examination Report or the Written Opinion of the International Searching Authority

## A.18 PCT The International Search Report

### R.43bis PCT Written Opinion of the International Searching Authority

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#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.001 What are the main procedural steps before the International Searching Authority?

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.051 When does the international preliminary examination start?

***R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.***

**44.1**     *Copies of Report or Declaration and Written Opinion*

The International Searching Authority shall, on the same day, transmit one copy of the international search report or of the declaration referred to in **Article 17(2)(a)**, and one copy of the written opinion established under **Rule 43bis.1** to the International Bureau and one copy to the applicant.

**44.2**     *Title or Abstract*

The international search report shall either state that the International Searching Authority approves the title and the abstract as submitted by the applicant or be accompanied by the text of the title and/or abstract as established by the International Searching Authority under **Rules 37** and **38**.

**44.3**     *Copies of Cited Documents*

(a) The request referred to in **Article 20(3)** may be presented any time during seven years from the international filing date of the international application to which the international search report relates.

(b) The International Searching Authority may require that the party (applicant or designated Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in **Article 16(3)(b)** between the International Searching Authorities and the International Bureau.

(c) *[Deleted]*

(d) Any International Searching Authority may perform the obligations referred to in **paragraphs (a)** and **(b)** through another agency responsible to it.

**EPO Guidelines - B Search**

GL B II 4.3.2 A supplementary European search report is required

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

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A.17 PCT Procedure Before the International Searching Authority

A.20 PCT Communication to Designated Offices

**PCT Implementing Rules**

R.37 PCT Missing or Defective Title

R.38 PCT Missing or Defective Abstract

R.43 PCT The International Search Report

R.43bis PCT Written Opinion of the International Searching Authority

R.45bis PCT Supplementary International Searches

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.022 What happens if the International Searching Authority finds that the title of the invention or the abstract is missing or defective?

PCT AG-IP 7.025 How do the applicant and the International Bureau receive the international search report?

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

**PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.050 How can the applicant obtain copies of the documents cited in the supplementary international search report?

PCT AG-IP 8.053 Will the supplementary international search report be published?

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

***R.44bis PCT International Preliminary Report on Patentability by the International Searching Authority***

**44bis.1**     *Issuance of Report; Transmittal to the Applicant*

(a) Unless an international preliminary examination report has been or is to be established, the International Bureau shall issue a report on behalf of the International Searching Authority (in this Rule referred to as "the report") as to the matters referred to in **Rule 43bis.1(a)**. The report shall have the same contents as the written opinion established under **Rule 43bis.1**.

(b) The report shall bear the title "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)" together with an indication that it is issued under this Rule by the International Bureau on behalf of the International Searching Authority.

(c) The International Bureau shall promptly transmit one copy of the report issued under **paragraph (a)** to the applicant.

**44bis.2**     *Communication to Designated Offices*

(a) Where a report has been issued under **Rule 44bis.1**, the International Bureau shall communicate it to each designated Office in accordance with **Rule 93bis.1** but not before the expiration of 30 months from the priority date.

(b) Where the applicant makes an express request to a designated Office under **Article 23(2)**, the International Bureau shall communicate a copy of the written opinion established by the International Searching Authority under **Rule 43bis.1** to that Office promptly upon the request of that Office or of the applicant.

**44bis.3**     *Translation for Designated Offices*

(a) Any designated State may, where a report has been issued under **Rule 44bis.1** in a language other than the official language, or one of the official languages, of its national Office, require a translation of the report into English. Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(b) If a translation is required under **paragraph (a)**, it shall be prepared by or under the responsibility of the International Bureau.

(c) The International Bureau shall transmit a copy of the translation to any interested designated Office and to the applicant at the same time as it communicates the report to that Office.

(d) In the case referred to in **Rule 44bis.2(b)**, the written opinion established under **Rule 43bis.1** shall, upon request of the designated Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the designated Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

**44bis.4**     *Observations on the Translation*

## A.18 PCT The International Search Report

### R.44bis PCT International Preliminary Report on Patentability by the International Searching Authority

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The applicant may make written observations as to the correctness of the translation referred to in **Rule 44bis.3(b) or (d)** and shall send a copy of the observations to each of the interested designated Offices and to the International Bureau.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.7 Communication to the EPO as a designated Office

GL E VIII 2.8 Delaying of the procedure before the EPO

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 13 International Preliminary Report on Patentability Chapter I

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 8 Request for early processing

#### **PCT Articles**

A.23 PCT Delaying of National Procedure

#### **PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.44ter PCT Confidential Nature of Written Opinion, Report, Translation and Observations

R.93bis PCT Manner of Communication of Documents

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

***R.44ter PCT Confidential Nature of Written Opinion, Report, Translation and Observations***

*44ter.1 Confidential Nature*

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) to the written opinion established under **Rule 43bis.1**, to any translation thereof prepared under **Rule 44bis.3(d)** or to any written observations on such translation sent by the applicant under **Rule 44bis.4**;

(ii) if a report is issued under **Rule 44bis.1**, to that report, to any translation of it prepared under **Rule 44bis.3(b)** or to any written observations on that translation sent by the applicant under **Rule 44bis.4**.

(b) For the purposes of **paragraph (a)**, the term "access" covers any means by which third parties may acquire cognizance, including individual communication and general publication.

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GA C II 8 Access to the WO-ISA

GA C II 13 International Preliminary Report on Patentability Chapter I

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.44bis PCT International Preliminary Report on Patentability by the International Searching Authority

R.94 PCT 11 Access to Files

**PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.025 Can access be gained at the International Bureau to the file of an international application?

**PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?



***R.45 PCT Translation of the International Search Report***

45.1 *Languages*

International search reports and declarations referred to in **Article 17(2)(a)** shall, when not in English, be translated into English.

**PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

**PCT Implementing Rules**

R.45bis PCT Supplementary International Searches

R.47 PCT Communication to Designated Offices

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.017 In what language is the international application published?

### ***R.45bis PCT Supplementary International Searches***

#### ***45bis.1 Supplementary Search Request***

(a) The applicant may, at any time prior to the expiration of 19 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under **Rule 45bis.9**. Such requests may be made in respect of more than one such Authority.

(b) A request under **paragraph (a)** (“supplementary search request”) shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number;

(ii) the International Searching Authority that is requested to carry out the supplementary international search (“Authority specified for supplementary search”); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under **Rule 12.3** or **12.4** is to form the basis of the supplementary international search.

(c) The supplementary search request shall, where applicable, be accompanied by:

(i) where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under **Rule 12.3** or **12.4** is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority;

(ii) preferably, a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required by the Authority specified for supplementary search.

(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to restrict the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in **Article 17(3)(a)**.

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

(i) if it is received after the expiration of the time limit referred to in **paragraph (a)**; or

(ii) if the Authority specified for supplementary search has not stated, in the applicable agreement under **Article 16(3)(b)**, its preparedness to carry out such searches or is not competent to do so under **Rule 45bis.9(b)**.

#### ***45bis.2 Supplementary Search Handling Fee***

(a) The supplementary search request shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”) as set out in the **Schedule of Fees**.

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### R.45bis PCT Supplementary International Searches

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(b) The supplementary search handling fee shall be paid in the currency in which the fee is set out in the **Schedule of Fees** or in any other currency prescribed by the International Bureau. The amount in such other currency shall be the equivalent, in round figures, as established by the International Bureau, of the amount as set out in the **Schedule of Fees**, and shall be published in the Gazette.

(c) The supplementary search handling fee shall be paid to the International Bureau within one month from the date of receipt of the supplementary search request. The amount payable shall be the amount applicable on the date of payment.

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in **Rule 45bis.4(e)(i) to (iv)** are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under **Rule 45bis.1(e)**.

#### 45bis.3 *Supplementary Search Fee*

(a) Each International Searching Authority carrying out supplementary international searches may require that the applicant pay a fee ("supplementary search fee") for its own benefit for carrying out such a search.

(b) The supplementary search fee shall be collected by the International Bureau. **Rules 16.1(b) to (e)** shall apply *mutatis mutandis*.

(c) As to the time limit for payment of the supplementary search fee and the amount payable, the provisions of **Rule 45bis.2(c)** shall apply *mutatis mutandis*.

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in **Rule 45bis.4(e)(i) to (iv)** are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under **Rule 45bis.1(e) or 45bis.4(d)**.

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under **Article 16(3)(b)**, refund the supplementary search fee if, before it has started the supplementary international search in accordance with **Rule 45bis.5(a)**, the supplementary search request is considered not to have been submitted under **Rule 45bis.5(g)**.

#### 45bis.4 *Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to Authority Specified for Supplementary Search*

(a) Promptly after receipt of a supplementary search request, the International Bureau shall check whether it complies with the requirements of **Rule 45bis.1(b) and (c)(i)** and shall invite the applicant to correct any defects within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under **Rules 45bis.2(c) and 45bis.3(c)**, the International Bureau finds that the supplementary search handling fee and the supplementary search fee have not been paid in full, it shall invite the applicant to pay to it the amount required to cover those fees, together with the late payment fee under **paragraph (c)**, within a time limit of one month from the date of the invitation.

(c) The payment of fees in response to an invitation under **paragraph (b)** shall be subject to the payment to the International Bureau, for its own benefit, of a late payment fee whose amount shall be 50% of the supplementary search handling fee.

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### R.45bis PCT Supplementary International Searches

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(d) If the applicant does not furnish the required correction or does not pay the amount in full of the fees due, including the late payment fee, before the expiration of the time limit applicable under **paragraph (a) or (b)**, respectively, the supplementary search request shall be considered not to have been submitted and the International Bureau shall so declare and shall inform the applicant accordingly.

(e) On finding that the requirements of **Rule 45bis.1(b)** and **(c)(i)**, **45bis.2(c)** and **45bis.3(c)** have been complied with, the International Bureau shall promptly, but not before the date of receipt by it of the international search report or the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

(i) the supplementary search request;

(ii) the international application;

(iii) any sequence listing furnished under **Rule 45bis.1(c)(ii)**; and

(iv) any translation furnished under **Rule 12.3, 12.4 or 45bis.1(c)(i)** which is to be used as the basis of the supplementary international search;

and, at the same time, or promptly after their later receipt by the International Bureau:

(v) the international search report and the written opinion established under **Rule 43bis.1**;

(vi) any invitation by the International Searching Authority to pay additional fees referred to in **Article 17(3)(a)**; and

(vii) any protest by the applicant under **Rule 40.2(c)** and the decision thereon by the review body constituted in the framework of the International Searching Authority.

(f) Upon request of the Authority specified for supplementary search, the written opinion referred to in **paragraph (e)(v)** shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to that Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

#### *45bis.5 Start, Basis and Scope of Supplementary International Search*

(a) The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in **Rule 45bis.4(e)(i) to (iv)**, provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in **Rule 45bis.4(e)(v)** or until the expiration of 22 months from the priority date, whichever occurs first.

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in **Rule 45bis.1(b)(iii) or 45bis.1(c)(i)**, taking due account of the international search report and the written opinion established under **Rule 43bis.1** where they are available to the Authority specified for supplementary search before it starts the search. Where the supplementary search request contains an indication under **Rule 45bis.1(d)**, the supplementary international search may be restricted to the invention specified by the applicant under **Rule 45bis.1(d)** and those parts of the international application which relate to that invention.

## A.18 PCT The International Search Report

### R.45bis PCT Supplementary International Searches

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- (c) For the purposes of the supplementary international search, **Article 17(2)** and **Rules 13ter.1, 33** and **39** shall apply *mutatis mutandis*.
- (d) Where the international search report is available to the Authority specified for supplementary search before it starts the search under **paragraph (a)**, that Authority may exclude from the supplementary search any claims which were not the subject of the international search.
- (e) Where the International Searching Authority has made the declaration referred to in **Article 17(2)(a)** and that declaration is available to the Authority specified for supplementary search before it starts the search under **paragraph (a)**, that Authority may decide not to establish a supplementary international search report, in which case it shall so declare and promptly notify the applicant and the International Bureau accordingly.
- (f) The supplementary international search shall cover at least the documentation indicated for that purpose in the applicable agreement under **Article 16(3)(b)**.
- (g) If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation or condition referred to in **Rule 45bis.9(a)**, other than a limitation under **Article 17(2)** as applicable by virtue of **Rule 45bis.5(c)**, the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.
- (h) The Authority specified for supplementary search may, in accordance with a limitation or condition referred to in **Rule 45bis.9(a)**, decide to restrict the search to certain claims only, in which case the supplementary international search report shall so indicate.

#### 45bis.6 *Unity of Invention*

- (a) If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention, it shall:
- (i) establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims (“main invention”);
  - (ii) notify the applicant of its opinion that the international application does not comply with the requirement of unity of invention and specify the reasons for that opinion; and
  - (iii) inform the applicant of the possibility of requesting, within the time limit referred to in **paragraph (c)**, a review of the opinion.
- (b) In considering whether the international application complies with the requirement of unity of invention, the Authority shall take due account of any documents received by it under **Rule 45bis.4(e)(vi)** and **(vii)** before it starts the supplementary international search.
- (c) The applicant may, within one month from the date of the notification under **paragraph (a)(ii)**, request the Authority to review the opinion referred to in **paragraph (a)**. The request for review may be subjected by the Authority to the payment to it, for its own benefit, of a review fee whose amount shall be fixed by it.
- (d) If the applicant, within the time limit under **paragraph (c)**, requests a review of the opinion by the Authority and pays any required review fee, the opinion shall be reviewed by the Authority. The review shall not be carried out only by the person who made the decision which is the subject of the review. Where the Authority:

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### R.45bis PCT Supplementary International Searches

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- (i) finds that the opinion was entirely justified, it shall notify the applicant accordingly;
- (ii) finds that the opinion was partially unjustified but still considers that the international application does not comply with the requirement of unity of invention, it shall notify the applicant accordingly and, where necessary, proceed as provided for in **paragraph (a)(i)**;
- (iii) finds that the opinion was entirely unjustified, it shall notify the applicant accordingly, establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant.
- (e) On the request of the applicant, the text of both the request for review and the decision thereon shall be communicated to the designated Offices together with the supplementary international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under **Article 22**.
- (f) **Paragraphs (a) to (e)** shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to restrict the supplementary international search in accordance with the second sentence of **Rule 45bis.5(b)** or with **Rule 45bis.5(h)**, provided that any reference in the said paragraphs to the “international application” shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under **Rule 45bis.1(d)** or which relate to the claims and those parts of the international application for which the Authority will carry out a supplementary international search, respectively.

#### 45bis.7 *Supplementary International Search Report*

- (a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report, or make the declaration referred to in **Article 17(2)(a)** as applicable by virtue of **Rule 45bis.5(c)** that no supplementary international search report will be established.
- (b) Every supplementary international search report, any declaration referred to in **Article 17(2)(a)** as applicable by virtue of **Rule 45bis.5(c)** and any declaration under **Rule 45bis.5(e)** shall be in a language of publication.
- (c) For the purposes of establishing the supplementary international search report, **Rules 43.1, 43.2, 43.5, 43.6, 43.6bis, 43.8 and 43.10** shall, subject to **paragraphs (d) and (e)**, apply *mutatis mutandis*. **Rule 43.9** shall apply *mutatis mutandis*, except that the references therein to **Rules 43.3, 43.7 and 44.2** shall be considered non-existent. **Article 20(3)** and **Rule 44.3** shall apply *mutatis mutandis*.
- (d) The supplementary international search report need not contain the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report.
- (e) The supplementary international search report may contain explanations:
  - (i) with regard to the citations of the documents considered to be relevant;
  - (ii) with regard to the scope of the supplementary international search.

#### 45bis.8 *Transmittal and Effect of the Supplementary International Search Report*

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### R.45bis PCT Supplementary International Searches

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(a) The Authority specified for supplementary search shall, on the same day, transmit one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, to the International Bureau and one copy to the applicant.

(b) Subject to **paragraph (c)**, **Article 20(1)** and **Rules 45.1, 47.1(d)** and **70.7(a)** shall apply as if the supplementary international search report were part of the international search report.

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

#### *45bis.9 International Searching Authorities Competent to Carry Out Supplementary International Search*

(a) An International Searching Authority shall be competent to carry out supplementary international searches if its preparedness to do so is stated in the applicable agreement under **Article 16(3)(b)**, subject to any limitations and conditions set out in that agreement.

(b) The International Searching Authority carrying out the international search under **Article 16(1)** in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

(c) The limitations referred to in **paragraph (a)** may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, other than limitations under **Article 17(2)** as applicable by virtue of **Rule 45bis.5(c)**, limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.

#### **EPC Implementing Rules**

R.161 EPC Amendment of the application

#### **EPC Rules relating to Fees**

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

#### **EPO Guidelines - B Search**

GL B II 4.3.2 A supplementary European search report is required

#### **EPO Guidelines - C Procedural Aspects of Substantive Examination**

GL C IV 2 Extent of examination of replies

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C IV 1 General

GA C IV 2 Scope and limitations of SIS

GA C IV 3 Requirements for filing a SIS request

GA C IV 5 Lack of unity of invention

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 13 International preliminary examination and SIS

#### **PCT Articles**

A.16 PCT The International Searching Authority

A.17 PCT Procedure Before the International Searching Authority

A.20 PCT Communication to Designated Offices

A.22 PCT Copy, Translation, and Fee, to Designated Offices

#### **PCT Implementing Rules**

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

R.16 PCT The Search Fee

R.33 PCT Relevant Prior Art for the International Search

R.39 PCT Subject Matter under Article 17(2)(a)(i)

R.40 PCT Lack of Unity of Invention (International Search)

R.43 PCT The International Search Report

R.43bis PCT Written Opinion of the International Searching Authority

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R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.45 PCT Translation of the International Search Report

R.47 PCT Communication to Designated Offices

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.90bis PCT Withdrawals

R.96 PCT The Schedule of Fees

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.114 What is meant by the requirement of "unity of invention"?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.001 What is supplementary international search?

PCT AG-IP 8.003 Which authorities can be requested to carry out a supplementary international search?

PCT AG-IP 8.004 Does each Authority offer the same supplementary international search service?

PCT AG-IP 8.005 When should the request for a supplementary search be filed?

PCT AG-IP 8.006 Is there a form to request supplementary search?

PCT AG-IP 8.008 Where and how should a supplementary search request be filed?

PCT AG-IP 8.011 How should the Authority specified for supplementary search be identified?

PCT AG-IP 8.012 Which documents, other than the supplementary search request must be submitted?

PCT AG-IP 8.013 How should the international application be identified?

PCT AG-IP 8.015 How should the applicant be identified?

PCT AG-IP 8.018 How is an agent appointed for the purposes of the procedure before the Authority specified for supplementary search?

PCT AG-IP 8.023 Where should the language, for the purposes of supplementary international search, be indicated?

PCT AG-IP 8.024 When and how may the applicant select certain inventions to be searched?

PCT AG-IP 8.029 Which fees must be paid by the applicant?

PCT AG-IP 8.030 When must the applicable fees be paid?

PCT AG-IP 8.032 Can fees already paid be refunded in some circumstances?

PCT AG-IP 8.033 What does the International Bureau check upon receipt of the supplementary search request?

PCT AG-IP 8.034 What happens if there are other defects in the supplementary search request?

PCT AG-IP 8.035 What happens if the fees are not paid or not paid in full?

PCT AG-IP 8.037 When will the International Bureau transmit the relevant documents to the Authority specified for supplementary search?

PCT AG-IP 8.038 Which documents are transmitted by the International Bureau to the Authority specified for supplementary search?

PCT AG-IP 8.039 When will the Authority start work on the supplementary international search?

PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?

PCT AG-IP 8.041 What are the consequences if the Authority finds that carrying out the supplementary international search is excluded by a limitation or condition?

PCT AG-IP 8.042 May the Authority refuse to search certain claims?

PCT AG-IP 8.043 What is the scope of the supplementary international search?

PCT AG-IP 8.044 What will happen where the main International Searching Authority finds that the international application does not comply with the requirement of unity of invention?

PCT AG-IP 8.045 What will happen where the Authority specified for supplementary search considers that the international application does not comply with the requirement of unity of invention?

PCT AG-IP 8.046 What will happen when the applicant requests a review of the opinion of the Authority on unity of invention?

PCT AG-IP 8.047 When is the supplementary international search report established?

PCT AG-IP 8.048 What happens when the Authority specified for supplementary search declares that no supplementary international search report will be established?

PCT AG-IP 8.049 What does the supplementary international search report contain?

PCT AG-IP 8.050 How can the applicant obtain copies of the documents cited in the supplementary international search report?

PCT AG-IP 8.051 How is the supplementary international search report transmitted?

PCT AG-IP 8.052 Is a copy of the supplementary international search report sent to the International Preliminary Examining Authority?



## A.19 PCT Amendment of the Claims Before the International Bureau

(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) The amendments shall not go beyond the disclosure in the international application as filed.

(3) If the national law of any designated State permits amendments to go beyond the said disclosure, failure to comply with **paragraph (2)** shall have no consequence in that State.

### **EPO Guidelines - A Formalities Examination**

GL A III 13.2 Additional fee (if application documents comprise more than thirty-five pages)

### **EPO Guidelines - B Search**

GL B III 3.3.2 Specific rules applicable to Euro-PCT applications

GL B XI 2 Basis of the search opinion

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 3.3.1 Earlier filed amendments or comments

### **EPO Guidelines - H Amendments and Corrections**

GL H II 2.1 Before receipt of the search report - Rule 137(1)

GL H III 2.1.1 Rule 137(4) communication and response thereto

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 9 Procedure after receipt of the ISR and WO-ISA

GA C II 10 Amendments under Article 19 PCT

GA C IV 2 Scope and limitations of SIS

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 1 Aim of the international preliminary examination

GA D II 1 Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements

GA D II 2 Amendments

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E II 3 Further requirements

GA E IV 6 Amendments and the Rule 161 EPC/Rule 162 EPC communication if no supplementary European search is carried out

GA E V 3 What the translation must include

GA E VII 1 Page fee

### **PCT Articles**

A.20 PCT Communication to Designated Offices

### **PCT Implementing Rules**

R.46 PCT Amendment of Claims before the International Bureau

R.48 PCT International Publication

R.49 PCT Copy, Translation and Fee under Article 22

R.53 PCT The Demand

R.55 PCT Languages (International Preliminary Examination)

R.62 PCT Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

R.66 PCT Procedure before the International Preliminary Examining Authority

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

## A.19 PCT Amendment of the Claims Before the International Bureau

### R.45bis PCT Supplementary International Searches

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PCT AG-IP 5.127 Can the claims be amended during the international phase?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?

PCT AG-IP 9.007 What is a statement accompanying an amendment?

PCT AG-IP 9.009 May the amended claims include new matter?

PCT AG-IP 9.009\_a What happens where the replacement sheets were not accompanied by a letter?

PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?

PCT AG-IP 9.011 In what circumstances should the claims be amended under Article 19 ?

PCT AG-IP 9.015 What constitutes international publication?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.011 What happens if the international application was filed or published in a language which is not accepted by the International Preliminary Examining Authority?

PCT AG-IP 10.024 Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination?

PCT AG-IP 10.025 What is the purpose of indicating the basis for international preliminary examination?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

PCT AG-IP 10.027 May several check-boxes be marked in Box No. IV?

PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?

PCT AG-IP 10.051 When does the international preliminary examination start?

PCT AG-IP 10.061 What documents form the basis of the international preliminary examination?

PCT AG-IP 10.070 May amendments include new matter in the international application?

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

PCT AG-IP 10.076 How are amendments to the international application referred to in the international preliminary report on patentability ( Chapter II of the PCT )?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.037 Which mistakes cannot be rectified?

PCT AG-IP 11.038 Do rectifications of obvious mistakes need to be authorized by a particular Office?

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

PCT AG-IP 11.046 In what language should amendments be submitted during the international phase?

PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?

PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?

PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.014 Which are the claims that must be translated where the claims have been amended under Article 19 ?

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

#### **Case Law with Headnote**

J 8/83 Examination fee/refund of / Refund of examination fee / Invitation by the EPO

#### **General Case Law**

J 9/83 Euro-PCT-applications - Supplementary European search report - legal nature / Examination fee - refund of (yes) - [...]

#### **Case Law with Headnote**

J 9/84 Claims fees / Claims fees/allocation of / Abandonment of claims / Claims/abandonment

## ***R.46 PCT Amendment of Claims before the International Bureau***

### **46.1**     *Time Limit*

The time limit referred to in **Article 19** shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment made under **Article 19** which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

### **46.2**     *Where to File*

Amendments made under **Article 19** shall be filed directly with the International Bureau.

### **46.3**     *Language of Amendments*

If the international application has been filed in a language other than the language in which it is published, any amendment made under **Article 19** shall be in the language of publication.

### **46.4**     *Statement*

(a) The statement referred to in **Article 19(1)** shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. The statement shall be identified as such by a heading, preferably by using the words "Statement under **Article 19(1)**" or their equivalent in the language of the statement.

(b) The statement shall contain no disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

### **46.5**     *Form of Amendments*

(a) The applicant, when making amendments under **Article 19**, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled.

(iii) shall indicate the basis for the amendments in the application as filed.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 3.4 Rule 137(4) applies

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 9 Procedure after receipt of the ISR and WO-ISA

## A.19 PCT Amendment of the Claims Before the International Bureau

### R.46 PCT Amendment of Claims before the International Bureau

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GA C II 10 Amendments under Article 19 PCT

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E V 3 What the translation must include

#### **PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

#### **PCT Implementing Rules**

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.47 PCT Communication to Designated Offices

R.48 PCT International Publication

R.49 PCT Copy, Translation and Fee under Article 22

R.53 PCT The Demand

R.55 PCT Languages (International Preliminary Examination)

R.62 PCT Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

R.66 PCT Procedure before the International Preliminary Examining Authority

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?

PCT AG-IP 9.006 What should the accompanying letter contain?

PCT AG-IP 9.007 What is a statement accompanying an amendment?

PCT AG-IP 9.009\_a What happens where the replacement sheets were not accompanied by a letter?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.051 When does the international preliminary examination start?

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.046 In what language should amendments be submitted during the international phase?

PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

## A.20 PCT Communication to Designated Offices

(1)(a) The international application, together with the international search report (including any indication referred to in **Article 17(2)(b))** or the declaration referred to in **Article 17(2)(a)**, shall be communicated to each designated Office, as provided in the Regulations, unless the designated Office waives such requirement in its entirety or in part.

(b) The communication shall include the translation (as prescribed) of the said report or declaration.

(2) If the claims have been amended by virtue of **Article 19(1)**, the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in **Article 19(1)**.

(3) At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.

### **EPO Guidelines - B Search**

GL B II 4.3.2 A supplementary European search report is required

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

GL E VIII 2.7 Communication to the EPO as a designated Office

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E I 8 Request for early processing

GA E II 3 Further requirements

### **PCT Articles**

A.13 PCT Availability of Copy of the International Application to Designated Offices

A.17 PCT Procedure Before the International Searching Authority

A.19 PCT Amendment of the Claims Before the International Bureau

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.30 PCT Confidential Nature of the International Application

A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report

A.39 PCT Copy, Translation, and Fee, to Elected Offices

### **PCT Implementing Rules**

R.26bis PCT Correction or Addition of Priority Claim

R.44 PCT Transmittal of the International Search Report, Written Opinion, Etc.

R.45bis PCT Supplementary International Searches

R.47 PCT Communication to Designated Offices

R.61 PCT Notification of the Demand and Elections

R.90bis PCT Withdrawals

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.050 How can the applicant obtain copies of the documents cited in the supplementary international search report?

PCT AG-IP 8.051 How is the supplementary international search report transmitted?

PCT AG-IP 8.053 Will the supplementary international search report be published?

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.001 What must be done by the applicant before the start of the national phase?

## A.20 PCT Communication to Designated Offices

### R.46 PCT Amendment of Claims before the International Bureau

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PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

#### **Case Law with Headnote**

J 9/84 Claims fees / Claims fees/allocation of / Abandonment of claims / Claims/abandonment

## ***R.47 PCT Communication to Designated Offices***

### **47.1 Procedure**

(a) The communication provided for in **Article 20** shall be effected by the International Bureau to each designated Office in accordance with **Rule 93bis.1** but, subject to **Rule 47.4**, not prior to the international publication of the international application.

(a-bis) The International Bureau shall notify each designated Office, in accordance with **Rule 93bis.1**, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document.

(b) Any amendment received by the International Bureau within the time limit under **Rule 46.1** which was not included in the communication provided for in **Article 20** shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

(c)<sup>5</sup> The International Bureau shall, promptly after the expiration of 28 months from the priority date, send a notice to the applicant indicating:

(i) the designated Offices which have requested that the communication provided for in **Article 20** be effected under **Rule 93bis.1** and the date of such communication to those Offices; and

(ii) the designated Offices which have not requested that the communication provided for in **Article 20** be effected under **Rule 93bis.1**.

(c-bis) The notice referred to in **paragraph (c)** shall be accepted by designated Offices:

(i) in the case of a designated Office referred to in **paragraph (c)(i)**, as conclusive evidence that the communication provided for in **Article 20** was effected on the date specified in the notice;

(ii) in the case of a designated Office referred to in **paragraph (c)(ii)**, as conclusive evidence that the Contracting State for which that Office acts as designated Office does not require the furnishing, under **Article 22**, by the applicant of a copy of the international application.

(d) Each designated Office shall, when it so requires, receive the international search reports and the declarations referred to in **Article 17(2)(a)** also in the translation referred to in **Rule 45.1**.

(e)<sup>5</sup> Where any designated Office has not, before the expiration of 28 months from the priority date, requested the International Bureau to effect the communication provided for in **Article 20** in accordance with **Rule 93bis.1**, the Contracting State for which that Office acts as designated Office shall be considered to have notified the International Bureau, under **Rule 49.1(a-bis)**, that it does not require the furnishing, under **Article 22**, by the applicant of a copy of the international application.

### **47.2 Copies**

The copies required for communication shall be prepared by the International Bureau. Further details concerning the copies required for communication may be provided for in the Administrative Instructions.

### **47.3 Languages**

A.20 PCT Communication to Designated Offices  
R.47 PCT Communication to Designated Offices

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(a) The international application communicated under **Article 20** shall be in the language in which it is published.

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed.

47.4 *Express Request under Article 23(2) prior to International Publication*

Where the applicant makes an express request to a designated Office under **Article 23(2)** prior to the international publication of the international application, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect the communication provided for in **Article 20** to that Office.

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<sup>5</sup> *Editor's Note:* Rule 47.1(c) and (e) shall apply to any international application whose international filing date is on or after January 1, 2004 and in respect of a designated Office which has made a notification under paragraph (2) of the decisions of the Assembly set out in Annex IV of document PCT/A/30/7 (to the effect that the modification of the time limit fixed in Article 22(1) was not compatible with the national law applied by that Office on October 3, 2001), and which has not withdrawn that notification under paragraph (3) of those decisions, as though the reference in each of Rule 47.1(c) and (e) to "28 months" was a reference to "19 months," with the consequence that two notifications under Rule 47.1(c) shall, if applicable, be sent in respect of such an application. Information received by the International Bureau concerning any such incompatibility is published in the Gazette and on the WIPO website at: [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html).

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 8 Request for early processing

**PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

A.20 PCT Communication to Designated Offices

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.23 PCT Delaying of National Procedure

**PCT Implementing Rules**

R.45 PCT Translation of the International Search Report

R.45bis PCT Supplementary International Searches

R.46 PCT Amendment of Claims before the International Bureau

R.49 PCT Copy, Translation and Fee under Article 22

R.52 PCT Amendment of the Claims, the Description, and the Drawings, before Designated Offices

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

R.93bis PCT Manner of Communication of Documents

**PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.051 How is the supplementary international search report transmitted?

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.002 When and to whom does the International Bureau notify its receipt of the record copy of the international application?

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

**PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?



## A.21 PCT International Publication

- (1) The International Bureau shall publish international applications.
- (2)(a) Subject to the exceptions provided for in **subparagraph (b)** and in **Article 64(3)**, the international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application.
- (b) The applicant may ask the International Bureau to publish his international application any time before the expiration of the time limit referred to in **subparagraph (a)**. The International Bureau shall proceed accordingly, as provided in the Regulations.
- (3) The international search report or the declaration referred to in **Article 17(2)(a)** shall be published as prescribed in the Regulations.
- (4) The language and form of the international publication and other details are governed by the Regulations.
- (5) There shall be no international publication if the international application is withdrawn or is considered withdrawn before the technical preparations for publication have been completed.
- (6) If the international application contains expressions or drawings which, in the opinion of the International Bureau, are contrary to morality or public order, or if, in its opinion, the international application contains disparaging statements as defined in the Regulations, it may omit such expressions, drawings, and statements, from its publications, indicating the place and number of words or drawings omitted, and furnishing, upon request, individual copies of the passages omitted.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.3.7 Prohibited matter

GL E VIII 2.5.2 Request for examination

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 7 International publication of the application and the ISR

### **PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

A.29 PCT Effects of the International Publication

A.64 PCT \* Reservations

### **PCT Implementing Rules**

R.9 PCT Expressions, Etc., Not to Be Used

R.13bis PCT Inventions Relating to Biological Material

R.17 PCT The Priority Document

R.26bis PCT Correction or Addition of Priority Claim

R.48 PCT International Publication

R.90bis PCT Withdrawals

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.012 When and how is the international application published by the International Bureau?

PCT AG-IP 9.014 When does international publication take place?

PCT AG-IP 9.015 What constitutes international publication?

PCT AG-IP 9.017 In what language is the international application published?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

## A.21 PCT International Publication

### R.47 PCT Communication to Designated Offices

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PCT AG-IP 11.072 To what extent are international applications treated as confidential?

PCT AG-IP 11.106 How are licensing indications made available?

#### **Case Law with Headnote**

J 6/79 Request for examination/time limit / Appeal fee/Reimbursement

J 5/81 Publication of European patent application / European patent application/publication of / Technical [..]

#### **General Case Law**

J 9/91 Euro-PCT applications - form and content - national requirement / Correction of errors/omissions / Priority [..]

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [..]

## ***R.48 PCT International Publication***

### 48.1 *Form and Means*

The form in which and the means by which international applications are published shall be governed by the Administrative Instructions.

### 48.2 *Contents*

(a) The publication of the international application shall contain:

(i) a standardized front page;

(ii) the description;

(iii) the claims;

(iv) the drawings, if any;

(v) subject to **paragraph (g)**, the international search report or the declaration under **Article 17(2)(a)**;

(vi) any statement filed under **Article 19(1)**, unless the International Bureau finds that the statement does not comply with the provisions of **Rule 46.4**;

(vii) where the request for publication under **Rule 91.3(d)** was received by the International Bureau before the completion of the technical preparations for international publication, any request for rectification of an obvious mistake, any reasons and any comments referred to in **Rule 91.3(d)**;

(viii) the indications in relation to deposited biological material furnished under **Rule 13bis** separately from the description, together with an indication of the date on which the International Bureau received such indications;

(ix) any information concerning a priority claim referred to in **Rule 26bis.2(d)**;

(x) any declaration referred to in **Rule 4.17**, and any correction thereof under **Rule 26ter.1**, which was received by the International Bureau before the expiration of the time limit under **Rule 26ter.1**;

(xi) any information concerning a request under **Rule 26bis.3** for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to the criterion for restoration upon which the decision was based.

(b) Subject to **paragraph (c)**, the front page shall include:

(i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions;

(ii) a figure or figures where the international application contains drawings, unless **Rule 8.2(b)** applies;

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first;

(iv) where applicable, an indication that the request contains a declaration referred to in **Rule 4.17** which was received by the International Bureau before the expiration of the time limit under **Rule 26ter.1**;

(v) where the international filing date has been accorded by the receiving Office under **Rule 20.3(b)(ii)** or **20.5(d)** on the basis of the incorporation by reference under **Rules 4.18** and **20.6** of an element or part, an indication to that effect, together with an indication as to whether the applicant, for the purposes of **Rule 20.6(a)(ii)**, relied on compliance with **Rule 17.1(a)**, **(b)** or **(b-bis)** in relation to the priority document or on a separately submitted copy of the earlier application concerned;

(vi) where applicable, an indication that the published international application contains information under **Rule 26bis.2(d)**;

(vii) where applicable, an indication that the published international application contains information concerning a request under **Rule 26bis.3** for restoration of the right of priority and the decision of the receiving Office upon such request;

(viii) where applicable, an indication that the applicant has, under **Rule 26bis.3(f)**, furnished copies of any declaration or other evidence to the International Bureau.

(c) Where a declaration under **Article 17(2)(a)** has issued, the front page shall conspicuously refer to that fact and need include neither a drawing nor an abstract.

(d) The figure or figures referred to in **paragraph (b)(ii)** shall be selected as provided in **Rule 8.2**. Reproduction of such figure or figures on the front page may be in a reduced form.

(e) If there is not enough room on the front page for the totality of the abstract referred to in **paragraph (b)(iii)**, the said abstract shall appear on the back of the front page. The same shall apply to the translation of the abstract when such translation is required to be published under **Rule 48.3(c)**.

(f) If the claims have been amended under **Article 19**, the publication of the international application shall contain the full text of the claims both as filed and as amended. Any statement referred to in **Article 19(1)** shall be included as well, unless the International Bureau finds that the statement does not comply with the provisions of **Rule 46.4**. The date of receipt of the amended claims by the International Bureau shall be indicated.

(g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available, the front page shall contain an indication to the effect that that report was not available and that the international search report (when it becomes available) will be separately published together with a revised front page.

(h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under **Article 19** has not expired, the front page shall refer to that fact and indicate that, should the claims be amended under **Article 19**, then, promptly after receipt by the International Bureau of such amendments within the time limit under **Rule 46.1**, the full text of the claims as amended will be published together with a revised front page. If a statement under **Article 19(1)** has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of **Rule 46.4**.

(i) If the authorization by the receiving Office, the International Searching Authority or the International Bureau of a rectification of an obvious mistake in the international application under **Rule 91.1** is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall

## A.21 PCT International Publication

### R.48 PCT International Publication

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be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under **Rule 91.2**, as the case may be, and the front page shall be republished.

(j) If, at the time of completion of the technical preparations for international publication, a request under **Rule 26bis.3** for restoration of the right of priority is still pending, the published international application shall contain, in place of the decision by the receiving Office upon that request, an indication to the effect that such decision was not available and that the decision, when it becomes available, will be separately published.

(k) If a request for publication under **Rule 91.3(d)** was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in that Rule shall be promptly published after the receipt of such request for publication, and the front page shall be republished.

#### 48.3 *Languages of Publication*

(a) If the international application is filed in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish ("languages of publication"), that application shall be published in the language in which it was filed.

(b) If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under **Rule 12.3** or **12.4**, that application shall be published in the language of that translation.

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under **Rule 48.2(a)(v)**, or the declaration referred to in **Article 17(2)(a)**, the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, if not furnished by the applicant under **Rule 12.3**, shall be prepared under the responsibility of the International Bureau.

#### 48.4 *Earlier Publication on the Applicant's Request*

(a) Where the applicant asks for publication under **Articles 21(2)(b)** and **64(3)(c)(i)** and the international search report, or the declaration referred to in **Article 17(2)(a)**, is not yet available for publication together with the international application, the International Bureau shall collect a special publication fee whose amount shall be fixed in the Administrative Instructions.

(b) Publication under **Articles 21(2)(b)** and **64(3)(c)(i)** shall be effected by the International Bureau promptly after the applicant has asked for it and, where a special fee is due under **paragraph (a)**, after receipt of such fee.

#### 48.5 *Notification of National Publication*

Where the publication of the international application by the International Bureau is governed by **Article 64(3)(c)(ii)**, the national Office concerned shall, promptly after effecting the national publication referred to in the said provision, notify the International Bureau of the fact of such national publication.

#### 48.6 *Announcing of Certain Facts*

(a) If any notification under **Rule 29.1(ii)** reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the

## A.21 PCT International Publication

### R.48 PCT International Publication

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International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.

(b) *[Deleted]*

(c) If the international application, the designation of any designated State or the priority claim is withdrawn under **Rule 90bis** after the technical preparations for international publication have been completed, notice of the withdrawal shall be published in the Gazette.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 6 Translation

GA C I 8 Application filed in Dutch

GA C II 7 International publication of the application and the ISR

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 17 Language of the demand

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E V 3 What the translation must include

#### **PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

A.19 PCT Amendment of the Claims Before the International Bureau

A.21 PCT International Publication

A.64 PCT \* Reservations

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.8 PCT The Abstract

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.13bis PCT Inventions Relating to Biological Material

R.17 PCT The Priority Document

R.20 PCT International Filing Date

R.26bis PCT Correction or Addition of Priority Claim

R.26ter PCT Correction or Addition of Declarations under Rule 4.17

R.29 PCT International Applications Considered Withdrawn

R.43 PCT The International Search Report

R.46 PCT Amendment of Claims before the International Bureau

R.90bis PCT Withdrawals

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.013 What language must be used for an international application?

PCT AG-IP 5.077 How do designated Offices receive the declarations relevant to them?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.020 What are the translation requirements if the international application is filed in a language which is accepted by the International Searching Authority, but is not a language of publication?

PCT AG-IP 6.049 What happens when the applicant fails to correct a declaration referred to in Rule 4.17 ?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.007 What is a statement accompanying an amendment?

PCT AG-IP 9.011 In what circumstances should the claims be amended under Article 19 ?

PCT AG-IP 9.014 When does international publication take place?

PCT AG-IP 9.015 What constitutes international publication?

PCT AG-IP 9.017 In what language is the international application published?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.041 What steps will the competent authority take once a request for rectification of an obvious mistake has been filed?

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

PCT AG-IP 11.075 When must an international application include a reference to biological material and/or to its deposit with a depositary institution?

PCT AG-IP 11.081 What is the consequence of failure to furnish an indication on time?

#### **General Case Law**

J 1/03 All due care required by the circumstances

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [...]

#### **General Case Law**

T 353/03 Right to be heard - no (claims amended substantially) / Insufficient reasoning of decision / Errors in the translation  
[..]

## A.22 PCT Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in **Article 20** has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30\* months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30\* months from the priority date.

(2) Where the International Searching Authority makes a declaration, under **Article 17(2)(a)**, that no international search report will be established, the time limit for performing the acts referred to in **paragraph (1)** of this Article shall be the same as that provided for in **paragraph (1)**.

(3) Any national law may, for performing the acts referred to in **paragraphs (1)** or **(2)**, fix time limits which expire later than the time limit provided for in those paragraphs.

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\* *Editor's Note:* The 30-month time limit, as in force from April 1, 2002, does not apply in respect of any designated Office which has notified the International Bureau of incompatibility with the national law applied by that Office. The 20-month time limit, as in force until March 31, 2002, continues to apply after that date in respect of any such designated Office for as long as Article 22(1), as modified, continues not to be compatible with the applicable national law. Information received by the International Bureau concerning any such incompatibility is published in the Gazette and on the WIPO website at: **[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

### **EPO Guidelines - C Procedural Aspects of Substantive Examination**

GL C II 1.2 Euro-PCT applications

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

GL E VIII 2.4.1 Divisional applications

GL E VIII 2.5.1 Publication of the international application

GL E VIII 2.8 Delaying of the procedure before the EPO

### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 7 The role of the EPO in the European phase

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 21 Designation of inventor

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 13 Delaying of national phase until expiry of 30 months

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 5 When must the European phase be initiated before the EPO as designated or elected Office?

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E II 3 Further requirements

GA E V 1 When must the applicant file a translation of the Euro-PCT application?

GA E VII VII.

GA E XII 1 Missing data regarding the inventor or an applicant

### **PCT Articles**

A.17 PCT Procedure Before the International Searching Authority



## A.22 PCT Copy, Translation, and Fee, to Designated Offices

### R.48 PCT International Publication

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A.20 PCT Communication to Designated Offices

A.23 PCT Delaying of National Procedure

A.24 PCT Possible Loss of Effect in Designated States

A.30 PCT Confidential Nature of the International Application

A.37 PCT Withdrawal of Demand or Election

A.39 PCT Copy, Translation, and Fee, to Elected Offices

#### **PCT Implementing Rules**

R.6 PCT The Claims

R.13 PCT Unity of Invention

R.13bis PCT Inventions Relating to Biological Material

R.17 PCT The Priority Document

R.20 PCT International Filing Date

R.22 PCT Transmittal of the Record Copy and Translation

R.32 PCT Extension of Effects of International Application to Certain Successor States

R.40 PCT Lack of Unity of Invention (International Search)

R.45bis PCT Supplementary International Searches

R.47 PCT Communication to Designated Offices

R.49 PCT Copy, Translation and Fee under Article 22

R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

R.49ter PCT Effect of Restoration of Right of Priority by Receiving Office; Restoration of Right of Priority by Designated Office

R.50 PCT Faculty under Article 22(3)

R.51bis PCT Certain National Requirements Allowed under Article 27

R.52 PCT Amendment of the Claims, the Description, and the Drawings, before Designated Offices

R.74 PCT Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices

R.86 PCT The Gazette

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?

PCT AG-IP 6.057 How does the record copy reach the International Bureau?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?

PCT AG-IP 11.060 Can the applicant withdraw the demand for international preliminary examination or the election of any State?

PCT AG-IP 11.092 What is the effect of an extension?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.006 How does the national phase start?

#### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.001 What is the time limit for entering the national phase before a designated Office?

PCT AG-NP 3.002 What is the time limit for entering the national phase before an elected Office?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.001 What must be done by the applicant before the start of the national phase?

PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?

PCT AG-NP 4.008 In which case must the international application be translated?

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.007 What is the applicable time limit to request restoration of the right of priority with a designated Office?

PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?

A.22 PCT Copy, Translation, and Fee, to Designated Offices  
R.48 PCT International Publication

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**Case Law of the Enlarged Board**

G 4/08 Langue de la Procédure

G 1/09 Pending application - Definition / Divisional application / Appeal period

**Case Law with Headnote**

J 6/79 Request for examination/time limit / Appeal fee/Reimbursement

J 7/82 Non-compliance/cause of / Reestablishment of rights / No opportunity to present comments / Procedural violation [..]

J 9/84 Claims fees / Claims fees/allocation of / Abandonment of claims / Claims/abandonment

**General Case Law**

J 32/86 Erfinderische Tätigkeit (bejaht)

J 42/89 General principles - principle of good faith / General principles - right to be heard / Restitutio - time limit for [..]

J 22/92 Restitutio - Euro-PCT applications - EPO designated office / Restitutio - time limits - period of grace - inapplicable [..]

J 26/92 Re-establishment of rights / Isolated mistake / All due care (yes) / Restitutio - all due care - professional [..]

J 10/94 Demande de brevet européen d'origine PCT / Taxe nationale de base / Taxes de désignation / Délai de paiement / [..]

J 6/00 Withdrawal of the priority claims in the international phase / Unambiguous declaration (no) / Analogous application of [..]

J 13/03 Principle of protection of legitimate expectations / Restitutio -Euro - PCT applications - EPO designated Office

**Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation [..]

## A.23 PCT Delaying of National Procedure

- (1) No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under **Article 22**.
- (2) Notwithstanding the provisions of **paragraph (1)**, any designated Office may, on the express request of the applicant, process or examine the international application at any time.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

GL E VIII 2.3.5 Claim to priority

GL E VIII 2.4.1 Divisional applications

GL E VIII 2.8 Delaying of the procedure before the EPO

### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 5 The role of the EPO in the international phase

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 8 Request for early processing

### **PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.40 PCT Delaying of National Examination and Other Processing

### **PCT Implementing Rules**

R.13bis PCT Inventions Relating to Biological Material

R.17 PCT The Priority Document

R.44bis PCT International Preliminary Report on Patentability by the International Searching Authority

R.47 PCT Communication to Designated Offices

R.90bis PCT Withdrawals

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

PCT AG-IP 5.070 When and to whom must the priority document be furnished?

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.001 What is the national phase?

PCT AG-NP 2.006 How does the national phase start?

### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.004 Can the national phase start before the expiration of the time limit for entering it?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

### **Case Law of the Enlarged Board**

G 4/08 Langue de la Procédure

G 1/09 Pending application - Definition / Divisional application / Appeal period

### **General Case Law**

J 9/83 Euro-PCT-applications - Supplementary European search report - legal nature / Examination fee - refund of (yes) - [...]

J 6/00 Withdrawal of the priority claims in the international phase / Unambiguous declaration (no) / Analogous application of [...]

## A.24 PCT Possible Loss of Effect in Designated States

(1) Subject, in case (ii) below, to the provisions of **Article 25**, the effect of the international application provided for in **Article 11(3)** shall cease in any designated State with the same consequences as the withdrawal of any national application in that State:

(i) if the applicant withdraws his international application or the designation of that State;

(ii) if the international application is considered withdrawn by virtue of **Articles 12(3)**, **14(1)(b)**, **14(3)(a)**, or **14(4)**, or if the designation of that State is considered withdrawn by virtue of **Article 14(3)(b)**;

(iii) if the applicant fails to perform the acts referred to in **Article 22** within the applicable time limit.

(2) Notwithstanding the provisions of **paragraph (1)**, any designated Office may maintain the effect provided for in **Article 11(3)** even where such effect is not required to be maintained by virtue of **Article 25(2)**.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

GL E VIII 2.5.1 Publication of the international application

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 5 When must the European phase be initiated before the EPO as designated or elected Office?

GA E II 1 Overview of the steps to be taken for entry into the European phase

GA E V 2 Consequences of not filing a translation of the application

GA E XIV XIV.

### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

A.14 PCT Certain Defects in the International Application

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.25 PCT Review by Designated Offices

### **PCT Implementing Rules**

R.49 PCT Copy, Translation and Fee under Article 22

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.056 Can failure to meet a time limit in the proceedings before the receiving Office or a delay in furnishing documents to that Office be excused?

PCT AG-IP 6.057 How does the record copy reach the International Bureau?

### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.002 When is an Office a designated Office?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?

### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.021 What may be the result of a review by the designated Office?

PCT AG-NP 6.025 What must be done by the applicant who has exceeded a time limit?

### **General Case Law**

J 32/86 Erfinderische Tätigkeit (bejaht)

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

## A.25 PCT Review by Designated Offices

(1)(a) Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn, or where the International Bureau has made a finding under **Article 12(3)**, the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to any of the designated Offices named by the applicant.

(b) Where the receiving Office has declared that the designation of any given State is considered withdrawn, the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to the national Office of such State.

(c) The request under **subparagraphs (a) or (b)** shall be presented within the prescribed time limit.

(2)(a) Subject to the provisions of **subparagraph (b)**, each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in **paragraph (1)** was justified under the provisions of this Treaty and the Regulations, and, if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred.

(b) Where the record copy has reached the International Bureau after the expiration of the time limit prescribed under **Article 12(3)** on account of any error or omission on the part of the applicant, the provisions of **subparagraph (a)** shall apply only under the circumstances referred to in **Article 48(2)**.

### EPC Implementing Rules

R.159 EPC The European Patent Office as a designated or elected Office – Requirements for entry into the European phase

### EPO Guidelines - E General Procedural Matters

GL E VIII 2.9 Review by the EPO as a designated Office

### EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office

GA E XIV XIV.

### PCT Articles

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

A.24 PCT Possible Loss of Effect in Designated States

A.48 PCT Delay in Meeting Certain Time Limits

### PCT Implementing Rules

R.20 PCT International Filing Date

R.51 PCT Review by Designated Offices

### PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO

PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?

### PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase

PCT AG-NP 6.018 In which case may a request for review be made?

PCT AG-NP 6.019 How may the right to request a review be exercised and when?

PCT AG-NP 6.021 What may be the result of a review by the designated Office?

### General Case Law

J 9/91 Euro-PCT applications - form and content - national requirement / Correction of errors/omissions / Priority [...]

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

## **A.26 PCT Opportunity to Correct Before Designated Offices**

No designated Office shall reject an international application on the grounds of non-compliance with the requirements of this Treaty and the Regulations without first giving the applicant the opportunity to correct the said application to the extent and according to the procedure provided by the national law for the same or comparable situations in respect of national applications.

### **Case Law with Headnote**

J 3/81 International application / Correction of mistake / Public interest / Reestablishment of rights / Payment of fee

### **General Case Law**

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

## A.27 PCT National Requirements

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

(2) The provisions of **paragraph (1)** neither affect the application of the provisions of **Article 7(2)** nor preclude any national law from requiring, once the processing of the international application has started in the designated Office, the furnishing:

(i) when the applicant is a legal entity, of the name of an officer entitled to represent such legal entity,

(ii) of documents not part of the international application but which constitute proof of allegations or statements made in that application, including the confirmation of the international application by the signature of the applicant when that application, as filed, was signed by his representative or agent.

(3) Where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because he is not the inventor, the international application may be rejected by the designated Office.

(4) Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application.

(5) Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

(6) The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.

(7) Any receiving Office or, once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications.

## A.27 PCT National Requirements

### R.48 PCT International Publication

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(8) Nothing in this Treaty and the Regulations is intended to be construed as limiting the freedom of any Contracting State to apply measures deemed necessary for the preservation of its national security or to limit, for the protection of the general economic interests of that State, the right of its own residents or nationals to file international applications.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.3.1 Representation

#### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 9 Representation in the international phase

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 22 Representation in the procedure before the EPO as receiving Office

GA B 26 Address for correspondence

GA B 28 Appointment of an agent for the European phase with the EPO as receiving Office

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 1 General

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E III 1 Requirements specific to applicants with neither residence nor principal place of business in an EPC contracting state - "non-resident applicants" (Form 1200, Sections 2 and 3)

GA E XII 1 Missing data regarding the inventor or an applicant

#### **PCT Articles**

A.7 PCT The Drawings

#### **PCT Implementing Rules**

R.51bis PCT Certain National Requirements Allowed under Article 27

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.020 Who may file an international application?

PCT AG-IP 5.039 How, in the case of several applicants, are the designated States for which they are applicants to be identified?

PCT AG-IP 5.041 Does the applicant have to be represented by an agent before the receiving Office, the International Bureau and other International Authorities under the PCT?

PCT AG-IP 5.043 How is an agent to be appointed?

PCT AG-IP 5.084 What is the purpose of the check list?

PCT AG-IP 5.121 Can both intermediate and final products be claimed?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.010 Can the receiving Office refuse to treat an international application as such for reasons of national security?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.023 What should be done in the case of the death of the applicant during the international phase?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.001 What must be done by the applicant before the start of the national phase?

PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?

PCT AG-NP 5.006 Must the applicant be represented by an agent for the national phase?

PCT AG-NP 5.007 When and how must the agent be appointed?

PCT AG-NP 5.008 Who may act as an agent for the national phase?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.001 What is the effect of the PCT on the substantive conditions of patentability applied in the national phase?

#### **General Case Law**

J 23/88 Interruption of proceedings by legal incapacity of a representative from outside the Contracting States (allowed)

J 9/91 Euro-PCT applications - form and content - national requirement / Correction of errors/omissions / Priority [...]

T 328/04 Sufficiency of disclosure (no)

T 106/06 Lack of unity - (no)

W 21/89 Uneinheitlichkeit a posteriori



## **A.28 PCT Amendment of the Claims, the Description, and the Drawings, Before Designated Offices**

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each designated Office within the prescribed time limit. No designated Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed unless the national law of the designated State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the designated State in all respects not provided for in this Treaty and the Regulations.

(4) Where the designated Office requires a translation of the international application, the amendments shall be in the language of the translation.

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**  
GA E IV 3 Amending the application – Rule 161 EPC/Rule 162 EPC communication

### **PCT Implementing Rules**

R.52 PCT Amendment of the Claims, the Description, and the Drawings, before Designated Offices

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.111 Can the description be amended during the international phase?

PCT AG-IP 5.127 Can the claims be amended during the international phase?

PCT AG-IP 5.162 Can the drawings be amended during the international phase?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

## A.29 PCT Effects of the International Publication

(1) As far as the protection of any rights of the applicant in a designated State is concerned, the effects, in that State, of the international publication of an international application shall, subject to the provisions of **paragraphs (2) to (4)**, be the same as those which the national law of the designated State provides for the compulsory national publication of unexamined national applications as such.

(2) If the language in which the international publication has been effected is different from the language in which publications under the national law are effected in the designated State, the said national law may provide that the effects provided for in **paragraph (1)** shall be applicable only from such time as:

- (i) a translation into the latter language has been published as provided by the national law, or
- (ii) a translation into the latter language has been made available to the public, by laying open for public inspection as provided by the national law, or
- (iii) a translation into the latter language has been transmitted by the applicant to the actual or prospective unauthorized user of the invention claimed in the international application, or
- (iv) both the acts described in **(i)** and **(iii)**, or both the acts described in **(ii)** and **(iii)**, have taken place.

(3) The national law of any designated State may provide that, where the international publication has been effected, on the request of the applicant, before the expiration of 18 months from the priority date, the effects provided for in **paragraph (1)** shall be applicable only from the expiration of 18 months from the priority date.

(4) The national law of any designated State may provide that the effects provided for in **paragraph (1)** shall be applicable only from the date on which a copy of the international application as published under **Article 21** has been received in the national Office of or acting for such State. The said Office shall publish the date of receipt in its gazette as soon as possible.

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**  
GA E XVI XVI.

### **PCT Articles**

A.21 PCT International Publication

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.024 What are the legal effects of international publication?

## A.30 PCT Confidential Nature of the International Application

(1)(a) Subject to the provisions of **subparagraph (b)**, the International Bureau and the International Searching Authorities shall not allow access by any person or authority to the international application before the international publication of that application, unless requested or authorized by the applicant.

(b) The provisions of **subparagraph (a)** shall not apply to any transmittal to the competent International Searching Authority, to transmittals provided for under **Article 13**, and to communications provided for under **Article 20**.

(2)(a) No national Office shall allow access to the international application by third parties, unless requested or authorized by the applicant, before the earliest of the following dates:

(i) date of the international publication of the international application,

(ii) date of the receipt of the communication of the international application under **Article 20**,

(iii) date of the receipt of a copy of the international application under **Article 22**.

(b) The provisions of **subparagraph (a)** shall not prevent any national Office from informing third parties that it has been designated, or from publishing that fact. Such information or publication may, however, contain only the following data: identification of the receiving Office, name of the applicant, international filing date, international application number, and title of the invention.

(c) The provisions of **subparagraph (a)** shall not prevent any designated Office from allowing access to the international application for the purposes of the judicial authorities.

(3) The provisions of **paragraph (2)(a)** shall apply to any receiving Office except as far as transmittals provided for under **Article 12(1)** are concerned.

(4) For the purposes of this Article, the term "access" covers any means by which third parties may acquire cognizance, including individual communication and general publication, provided, however, that no national Office shall generally publish an international application or its translation before the international publication or, if international publication has not taken place by the expiration of 20 months from the priority date, before the expiration of 20 months from the said priority date.

### EPO Guidelines - E General Procedural Matters

GL E VIII 2.10 Inspection of files

#### PCT Articles

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

A.13 PCT Availability of Copy of the International Application to Designated Offices

A.20 PCT Communication to Designated Offices

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.38 PCT Confidential Nature of the International Preliminary Examination

A.30 PCT Confidential Nature of the International Application  
R.48 PCT International Publication

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A.64 PCT \* Reservations

**PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.004 Is the international application treated as confidential by the receiving Office?

**PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

### ***R.49 PCT Copy, Translation and Fee under Article 22***

#### 49.1 *Notification*

(a) Any Contracting State requiring the furnishing of a translation or the payment of a national fee, or both, under **Article 22**, shall notify the International Bureau of:

- (i) the languages from which and the language into which it requires translation,
- (ii) the amount of the national fee.

(a-bis) Any Contracting State not requiring the furnishing, under **Article 22**, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau under **Rule 47** has not taken place by the expiration of the time limit applicable under **Article 22**) shall notify the International Bureau accordingly.

(a-ter) Any Contracting State which, pursuant to **Article 24(2)**, maintains, if it is a designated State, the effect provided for in **Article 11(3)** even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under **Article 22** shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under **paragraphs (a), (a-bis)) or (a-ter)** shall be promptly published by the International Bureau in the Gazette.

(c) If the requirements under **paragraph (a)** change later, such changes shall be notified by the Contracting State to the International Bureau and that Bureau shall promptly publish the notification in the Gazette. If the change means that translation is required into a language which, before the change, was not required, such change shall be effective only with respect to international applications filed later than two months after the publication of the notification in the Gazette. Otherwise, the effective date of any change shall be determined by the Contracting State.

#### 49.2 *Languages*

The language into which translation may be required must be an official language of the designated Office. If there are several of such languages, no translation may be required if the international application is in one of them. If there are several official languages and a translation must be furnished, the applicant may choose any of those languages. Notwithstanding the foregoing provisions of this paragraph, if there are several official languages but the national law prescribes the use of one such language for foreigners, a translation into that language may be required.

#### 49.3 *Statements under Article 19; Indications under Rule 13bis.4*

For the purposes of **Article 22** and the present Rule, any statement made under **Article 19(1)** and any indication furnished under **Rule 13bis.4** shall, subject to **Rule 49.5(c)** and **(h)**, be considered part of the international application.

#### 49.4 *Use of National Form*

No applicant shall be required to use a national form when performing the acts referred to in **Article 22**.

#### 49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of **Article 22**, the translation of the international application shall contain the description (subject to **paragraph (a-bis)**), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to **paragraphs (b)**, **(c-bis)** and **(e)**,

(i) contain the request,

(ii) if the claims have been amended under **Article 19**, contain both the claims as filed and the claims as amended (the claims as amended shall be furnished in the form of a translation of the complete set of claims furnished under **Rule 46.5(a)** in replacement of all the claims originally filed), and

(iii) be accompanied by a copy of the drawings.

**(a-bis)** No designated Office shall require the applicant to furnish to it a translation of any text matter contained in the sequence listing part of the description if such sequence listing part complies with **Rule 12.1(d)** and if the description complies with **Rule 5.2(b)**.

(b) Any designated Office requiring the furnishing of a translation of the request shall furnish copies of the request form in the language of the translation free of charge to the applicants. The form and contents of the request form in the language of the translation shall not be different from those of the request under **Rules 3 and 4**; in particular, the request form in the language of the translation shall not ask for any information that is not in the request as filed. The use of the request form in the language of the translation shall be optional.

(c) Where the applicant did not furnish a translation of any statement made under **Article 19(1)**, the designated Office may disregard such statement.

**(c-bis)** Where the applicant furnishes, to a designated Office which requires under **paragraph (a)(ii)** a translation of both the claims as filed and the claims as amended, only one of the required two translations, the designated Office may disregard the claims of which a translation has not been furnished or invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the designated Office chooses to invite the applicant to furnish the missing translation and the latter is not furnished within the time limit fixed in the invitation, the designated Office may disregard those claims of which a translation has not been furnished or consider the international application withdrawn.

(d) If any drawing contains text matter, the translation of that text matter shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

(e) Any designated Office requiring under **paragraph (a)** the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under **Article 22**, invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(f) The expression "Fig." does not require translation into any language.

(g) Where any copy of the drawings or any drawing executed anew which has been furnished under **paragraph (d)** or **(e)** does not comply with the physical requirements referred to in **Rule 11**, the designated Office may invite the applicant to correct the defect within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(h) Where the applicant did not furnish a translation of the abstract or of any indication furnished under **Rule 13bis.4**, the designated Office shall invite the applicant to furnish such translation, if it

deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(i) Information on any requirement and practice of designated Offices under the second sentence of **paragraph (a)** shall be published by the International Bureau in the Gazette.

(j) No designated Office shall require that the translation of the international application comply with physical requirements other than those prescribed for the international application as filed.

(k) Where a title has been established by the International Searching Authority pursuant to **Rule 37.2**, the translation shall contain the title as established by that Authority.

(l) If, on July 12, 1991, **paragraph (c-bis)** or **paragraph (k)** is not compatible with the national law applied by the designated Office, the paragraph concerned shall not apply to that designated Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.<sup>6</sup>

#### 49.6 *Reinstatement of Rights after Failure to Perform the Acts Referred to in Article 22*<sup>7</sup>

(a) Where the effect of the international application provided for in **Article 11(3)** has ceased because the applicant failed to perform the acts referred to in **Article 22** within the applicable time limit, the designated Office shall, upon request of the applicant, and subject to **paragraphs (b) to (e)** of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

(b) The request under **paragraph (a)** shall be submitted to the designated Office, and the acts referred to in **Article 22** shall be performed, within whichever of the following periods expires first:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under **Article 22**; or

(ii) 12 months from the date of the expiration of the applicable time limit under **Article 22**;

provided that the applicant may submit the request at any later time if so permitted by the national law applicable by the designated Office.

(c) The request under **paragraph (a)** shall state the reasons for the failure to comply with the applicable time limit under **Article 22**.

(d) The national law applicable by the designated Office may require:

(i) that a fee be paid in respect of a request under **paragraph (a)**;

(ii) that a declaration or other evidence in support of the reasons referred to in **paragraph (c)** be filed.

(e) The designated Office shall not refuse a request under **paragraph (a)** without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

## A.30 PCT Confidential Nature of the International Application

### R.49 PCT Copy, Translation and Fee under Article 22

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(f) If, on October 1, 2002, **paragraphs (a) to (e)** are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by January 1, 2003. The information received shall be promptly published by the International Bureau in the Gazette.<sup>6</sup>

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6 *Editor's Note:* This information is also published on the WIPO website at:  
**[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

7 *Editor's Note:* Paragraphs (a) to (e) of Rule 49.6 do not apply to any international application whose international filing date is before January 1, 2003, provided that:

(i) those paragraphs shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 22 expires on or after January 1, 2003;

(ii) to the extent that those paragraphs are applicable by virtue of Rule 76.5, the latter Rule shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 39(1) expires on or after January 1, 2003;

(iii) where a designated Office has informed the International Bureau under paragraph (f) of Rule 49.6 that paragraphs (a) to (e) of that Rule are not compatible with the national law applied by that Office, items (i) and (ii) of this paragraph shall apply in respect of that Office except that each reference in those items to the date January 1, 2003, shall be read as a reference to the date of entry into force of Rule 49.6(a) to (e) in respect of that Office. Information received by the International Bureau concerning any such incompatibility is published in the Gazette and on the WIPO website at:  
**[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

#### **EPC Rules relating to Fees**

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

GL E VIII 2.7 Communication to the EPO as a designated Office

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E V 1 When must the applicant file a translation of the Euro-PCT application?

GA E V 2 Consequences of not filing a translation of the application

GA E V 3 What the translation must include

GA E VI 3 Nucleotide and amino acid sequences (Form 1200, Section 9)

GA E VII 2 Non-observance of the time limit for payment of the filing fee

GA E VIII 1 Non-observance of the time limit for payment of the designation fee

#### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

A.19 PCT Amendment of the Claims Before the International Bureau

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.24 PCT Possible Loss of Effect in Designated States

#### **PCT Implementing Rules**

R.3 PCT The Request (Form)

R.4 PCT The Request (Contents)

R.5 PCT The Description

R.11 PCT Physical Requirements of the International Application

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.13bis PCT Inventions Relating to Biological Material

R.37 PCT Missing or Defective Title



## A.30 PCT Confidential Nature of the International Application

### R.49 PCT Copy, Translation and Fee under Article 22

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R.46 PCT Amendment of Claims before the International Bureau

R.47 PCT Communication to Designated Offices

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.140 How must drawings be numbered?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?

PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?

PCT AG-NP 4.008 In which case must the international application be translated?

PCT AG-NP 4.009 What is the language into which the international application must be translated?

PCT AG-NP 4.010 What must the translation comprise?

PCT AG-NP 4.011 Does the abstract require translation?

PCT AG-NP 4.012 Does the request require translation?

PCT AG-NP 4.013 How does the applicant prepare a translation of the request?

PCT AG-NP 4.014 Which are the claims that must be translated where the claims have been amended under Article 19 ?

PCT AG-NP 4.017 Must any statement explaining amendments made to the claims under Article 19 be translated?

PCT AG-NP 4.018 Must a reference to deposited biological material be translated?

PCT AG-NP 4.021 Does the translation have to contain drawings?

PCT AG-NP 4.022 How must the translation of text matter in drawings be presented?

PCT AG-NP 4.023 What are the physical requirements for the translation?

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

PCT AG-NP 4.032 Is the use of national forms mandatory for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?

#### **Case Law of the Enlarged Board**

G 4/08 Langue de la Procédure

#### **General Case Law**

J 42/89 General principles - principle of good faith / General principles - right to be heard / Restitutio - time limit for [...]

***R.49bis PCT Indications as to Protection Sought for Purposes of National Processing***

*49bis.1 Choice of Certain Kinds of Protection*

(a) If the applicant wishes the international application to be treated, in a designated State in respect of which **Article 43** applies, as an application not for the grant of a patent but for the grant of another kind of protection referred to in that Article, the applicant, when performing the acts referred to in **Article 22**, shall so indicate to the designated Office.

(b) If the applicant wishes the international application to be treated, in a designated State in respect of which **Article 44** applies, as an application for the grant of more than one kind of protection referred to in **Article 43**, the applicant, when performing the acts referred to in **Article 22**, shall so indicate to the designated Office and shall indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily.

(c) In the cases referred to in **paragraphs (a) and (b)**, if the applicant wishes the international application to be treated, in a designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, the applicant, when performing the acts referred to in **Article 22**, shall indicate the relevant parent application, parent patent or other parent grant.

(d) If the applicant wishes the international application to be treated, in a designated State, as an application for a continuation or a continuation-in-part of an earlier application, the applicant, when performing the acts referred to in **Article 22**, shall so indicate to the designated Office and shall indicate the relevant parent application.

(e) Where no express indication under paragraph (a) is made by the applicant when performing the acts referred to in **Article 22** but the national fee referred to in **Article 22** paid by the applicant corresponds to the national fee for a particular kind of protection, the payment of that fee shall be considered to be an indication of the wish of the applicant that the international application is to be treated as an application for that kind of protection and the designated Office shall inform the applicant accordingly.

*49bis.2 Time of Furnishing Indications*

(a) No designated Office shall require the applicant to furnish, before performing the acts referred to in **Article 22**, any indication referred to in **Rule 49bis.1** or, where applicable, any indication as to whether the applicant seeks the grant of a national patent or a regional patent.

(b) The applicant may, if so permitted by the national law applicable by the designated Office concerned, furnish such indication or, if applicable, convert from one kind of protection to another, at any later time.

**PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.43 PCT Seeking Certain Kinds of Protection

A.44 PCT Seeking Two Kinds of Protection

**PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?

**PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

## A.30 PCT Confidential Nature of the International Application

### R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

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PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

***R.49ter PCT Effect of Restoration of Right of Priority by Receiving Office;  
Restoration of Right of Priority by Designated Office***

*49ter.1 Effect of Restoration of Right of Priority by Receiving Office*

(a) Where the receiving Office has restored a right of priority under **Rule 26bis.3** based on a finding by it 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, that restoration shall, subject to **paragraph (c)**, be effective in each designated State.

(b) Where the receiving Office has restored a right of priority under **Rule 26bis.3** based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to **paragraph (c)**, be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion.

(c) A decision by the receiving Office to restore a right of priority under **Rule 26bis.3** shall not be effective in a designated State where the designated Office, a court or any other competent organ of or acting for that designated State finds that a requirement under **Rule 26bis.3(a), (b)(i) or (c)** was not complied with, taking into account the reasons stated in the request submitted to the receiving Office under **Rule 26bis.3(a)** and any declaration or other evidence filed with the receiving Office under **Rule 26bis.3(b)(iii)**.

(d) A designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement referred to in **paragraph (c)** was complied with, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for that doubt and giving the applicant an opportunity to make observations within a reasonable time limit.

(e) No designated State shall be bound by a decision of the receiving Office refusing a request under **Rule 26bis.3** for restoration of the right of priority.

(f) Where the receiving Office has refused a request for the restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under **Rule 49ter.2(a)** within the time limit under that Rule.

(g) If, on October 5, 2005, **paragraphs (a) to (d)** are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.<sup>8</sup>

*49ter.2 Restoration of Right of Priority by Designated Office*

(a) Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with **paragraph (b)**, restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:

(i) occurred in spite of due care required by the circumstances having been taken; or

### A.30 PCT Confidential Nature of the International Application

#### R.49ter PCT Effect of Restoration of Right of Priority by Receiving Office; Restoration of Right of Priority by Designated Office

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(ii) was unintentional.

Each designated Office shall apply at least one of those criteria and may apply both of them.

(b) A request under **paragraph (a)** shall:

(i) be filed with the designated Office within a time limit of one month from the applicable time limit under **Article 22**;

(ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under **paragraph (c)**; and

(iii) be accompanied by any fee for requesting restoration required under **paragraph (d)**.

(c) The designated Office may require that a declaration or other evidence in support of the statement of reasons referred to in **paragraph (b)(ii)** be filed with it within a time limit which shall be reasonable under the circumstances.

(d) The submission of a request under **paragraph (a)** may be subjected by the designated Office to the payment to it, for its own benefit, of a fee for requesting restoration.

(e) The designated Office shall not refuse, totally or in part, a request under **paragraph (a)** without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal may be sent by the designated Office to the applicant together with any invitation to file a declaration or other evidence under **paragraph (c)**.

(f) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under **paragraphs (a) and (b)**, the designated Office may, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under those paragraphs.

(g) Each designated Office shall inform the International Bureau of which of the criteria for restoration it applies, of the requirements, where applicable, of the national law applicable in accordance with **paragraph (f)**, and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(h) If, on October 5, 2005, **paragraphs (a) to (g)** are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.<sup>8</sup>

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<sup>8</sup> *Editor's Note:* This information is also published on the WIPO website at: [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html).

#### EPC Rules relating to Fees

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

## A.30 PCT Confidential Nature of the International Application

### R.49ter PCT Effect of Restoration of Right of Priority by Receiving Office; Restoration of Right of Priority by Designated Office

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#### **EPO Guidelines - E General Procedural Matters**

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#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 33 Restoration of priority right

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XIII XIII.

GA E XIII 5 Restoration of priority under Rule 49ter PCT

#### **PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

#### **PCT Implementing Rules**

R.26bis PCT Correction or Addition of Priority Claim

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.065 What are the criteria for restoration applied by the receiving Office?

PCT AG-IP 5.069 What are the effects of a decision by a receiving Office on designated Offices?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.004 What are the effects of a decision by a receiving Office to restore the right of priority on designated Offices?

PCT AG-NP 6.005 What are the consequences of a decision by a receiving Office to restore the right of priority on a designated Office which has made a notification of incompatibility?

PCT AG-NP 6.006 Can a request to restore the right of priority also be filed directly with a designated Office?

PCT AG-NP 6.007 What is the applicable time limit to request restoration of the right of priority with a designated Office?

PCT AG-NP 6.008 How should a request for the restoration of the right of priority be filed with the designated Office?

PCT AG-NP 6.009 What are the criteria for restoration applied by the designated Office?

PCT AG-NP 6.010 What needs to be included in the statement of reasons for the request to restore the right of priority?

PCT AG-NP 6.011 Will there be an opportunity to convince the designated Office that it should not refuse the request?

***R.50 PCT Faculty under Article 22(3)***

50.1 *Exercise of Faculty*

- (a) Any Contracting State allowing a time limit expiring later than the time limits provided for in **Article 22(1)** or **(2)** shall notify the International Bureau of the time limits so fixed.
- (b) Any notification received by the International Bureau under **paragraph (a)** shall be promptly published by the International Bureau in the Gazette.
- (c) Notifications concerning the shortening of the previously fixed time limit shall be effective in relation to international applications filed after the expiration of three months computed from the date on which the notification was published by the International Bureau.
- (d) Notifications concerning the lengthening of the previously fixed time limit shall become effective upon publication by the International Bureau in the Gazette in respect of international applications pending at the time or filed after the date of such publication, or, if the Contracting State effecting the notification fixes some later date, as from the latter date.

**PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

### ***R.51 PCT Review by Designated Offices***

#### **51.1**     *Time Limit for Presenting the Request to Send Copies*

The time limit referred to in **Article 25(1)(c)** shall be two months computed from the date of the notification sent to the applicant under **Rule 20.4(i)**, **24.2(c)**, or **29.1(ii)**.

#### **51.2**     *Copy of the Notification*

Where the applicant, after having received a negative determination under **Article 11(1)**, requests the International Bureau, under **Article 25(1)**, to send copies of the file of the purported international application to any of the named Offices he has attempted to designate, he shall attach to his request a copy of the notification referred to in **Rule 20.4(i)**.

#### **51.3**     *Time Limit for Paying National Fee and Furnishing Translation*

The time limit referred to in **Article 25(2)(a)** shall expire at the same time as the time limit prescribed in **Rule 51.1**.

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GA E XIV XIV.

#### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

A.25 PCT Review by Designated Offices

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R.20 PCT International Filing Date

R.24 PCT Receipt of the Record Copy by the International Bureau

R.29 PCT International Applications Considered Withdrawn

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?

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PCT AG-NP 6.019 How may the right to request a review be exercised and when?

PCT AG-NP 6.025 What must be done by the applicant who has exceeded a time limit?



***R.51bis PCT Certain National Requirements Allowed under Article 27***

*51bis.1 Certain National Requirements Allowed*

(a) Subject to **Rule 51bis.2**, the national law applicable by the designated Office may, in accordance with **Article 27**, require the applicant to furnish, in particular:

- (i) any document relating to the identity of the inventor,
- (ii) any document relating to the applicant's entitlement to apply for or be granted a patent,
- (iii) any document containing any proof of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed,
- (iv) where the international application designates a State whose national law requires that national applications be filed by the inventor, any document containing an oath or declaration of inventorship,
- (v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time;
- (vi) the confirmation of the international application by the signature of any applicant for the designated State who has not signed the request;
- (vii) any missing indication required under **Rule 4.5(a)(ii)** and **(iii)** in respect of any applicant for the designated State.

(b) The national law applicable by the designated Office may, in accordance with **Article 27(7)**, require that

- (i) the applicant be represented by an agent having the right to represent applicants before that Office and/or have an address in the designated State for the purpose of receiving notifications,
- (ii) the agent, if any, representing the applicant be duly appointed by the applicant.

(c) The national law applicable by the designated Office may, in accordance with **Article 27(1)**, require that the international application, the translation thereof or any document relating thereto be furnished in more than one copy.

(d) The national law applicable by the designated Office may, in accordance with **Article 27(2)(ii)**, require that the translation of the international application furnished by the applicant under **Article 22** be:

- (i) verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful;
- (ii) certified by a public authority or sworn translator, but only where the designated Office may reasonably doubt the accuracy of the translation.

## A.30 PCT Confidential Nature of the International Application

### R.51bis PCT Certain National Requirements Allowed under Article 27

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(e) The national law applicable by the designated Office may, in accordance with **Article 27**, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

(i) where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable; or

(ii) where the international filing date has been accorded by the receiving Office under **Rule 20.3(b)(ii)** or **20.5(d)** on the basis of the incorporation by reference under **Rules 4.18** and **20.6** of an element or part, for the purposes of determining under **Rule 82ter.1(b)** whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

(f) If, on March 17, 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.<sup>9</sup>

#### *51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required*

(a) Where the applicable national law does not require that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (**Rule 51bis.1(a)(i)**), if indications concerning the inventor, in accordance with **Rule 4.6**, are contained in the request or if a declaration as to the identity of the inventor, in accordance with **Rule 4.17(i)**, is contained in the request or is submitted directly to the designated Office;

(ii) relating to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (**Rule 51bis.1(a)(ii)**), if a declaration as to that matter, in accordance with **Rule 4.17(ii)**, is contained in the request or is submitted directly to the designated Office;

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (**Rule 51bis.1(a)(iii)**), if a declaration as to that matter, in accordance with **Rule 4.17(iii)**, is contained in the request or is submitted directly to the designated Office.

(b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (**Rule 51bis.1(a)(i)**) (other than a document containing an oath or declaration of inventorship (**Rule 51bis.1(a)(iv)**)), if indications concerning the inventor, in accordance with **Rule 4.6**, are contained in the request;

(ii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (**Rule 51bis.1(a)(iii)**), if a declaration as to that matter, in accordance with **Rule 4.17(iii)**, is contained in the request or is submitted directly to the designated Office;

(iii) containing an oath or declaration of inventorship (**Rule 51bis.1(a)(iv)**), if a declaration of inventorship, in accordance with **Rule 4.17(iv)**, is contained in the request or is submitted directly to the designated Office.

(c) If, on March 17, 2000, **paragraph (a)** is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.<sup>9</sup>

#### *51bis.3 Opportunity to Comply with National Requirements*

(a) Where any of the requirements referred to in **Rule 51bis.1(a)(i) to (iv)** and **(c) to (e)**, or any other requirement of the national law applicable by the designated Office which that Office may apply in accordance with **Article 27(1)** or **(2)**, is not already fulfilled during the same period within which the requirements under **Article 22** must be complied with, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

(b) Where any requirement of the national law applicable by the designated Office which that Office may apply in accordance with **Article 27(6)** or **(7)** is not already fulfilled during the same period within which the requirements under **Article 22** must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

(c) If, on March 17, 2000, **paragraph (a)** is not compatible with the national law applied by the designated Office in relation to the time limit referred to in that paragraph, the said paragraph shall not apply in respect of that Office in relation to that time limit for as long as the said paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.<sup>9</sup>

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<sup>9</sup> *Editor's Note:* This information is also published on the WIPO website at:  
**[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 40 Signature

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XII 1 Missing data regarding the inventor or an applicant

GA E XIII 3 Filing a translation of the priority document or the declaration

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A.27 PCT National Requirements

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R.20 PCT International Filing Date

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

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#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.074 What declarations may be referred to in Box No. VIII and included in Boxes Nos. VIII(i) to (v)?

PCT AG-IP 5.075 What purpose do declarations referred to in Rule 4.17 serve?

PCT AG-IP 5.076 Do all designated Offices accept declarations made under Rule 4.17 for the purposes of fulfillment of national phase requirements?

## A.30 PCT Confidential Nature of the International Application

### R.51bis PCT Certain National Requirements Allowed under Article 27

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PCT AG-IP 5.080 Must the standardized wordings of declarations always be used?

PCT AG-IP 5.084 What is the purpose of the check list?

PCT AG-IP 5.088 Who must sign the international application and when?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.047 How should a correction or addition of a declaration referred to in Rule 4.17 be presented?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.001 What must be done by the applicant before the start of the national phase?

PCT AG-NP 4.024 In how many copies must the translation be furnished?

PCT AG-NP 4.025 Must the translation be certified?

PCT AG-NP 4.026 Must the translation be verified?

PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?

PCT AG-NP 5.003 What must be done to prove inventorship, the right to file the application or the like?

PCT AG-NP 5.005 What can be done in the international phase to simplify the processing of international applications in the national phase?

PCT AG-NP 5.006 Must the applicant be represented by an agent for the national phase?

PCT AG-NP 5.007 When and how must the agent be appointed?

PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?

***R.52 PCT Amendment of the Claims, the Description, and the Drawings, before Designated Offices***

52.1 *Time Limit*

(a) In any designated State in which processing or examination starts without special request, the applicant shall, if he so wishes, exercise the right under **Article 28** within one month from the fulfillment of the requirements under **Article 22**, provided that, if the communication under **Rule 47.1** has not been effected by the expiration of the time limit applicable under **Article 22**, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any later time if so permitted by the national law of the said State.

(b) In any designated State in which the national law provides that examination starts only on special request, the time limit within or the time at which the applicant may exercise the right under **Article 28** shall be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under **paragraph (a)**.

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GA E IV 3 Amending the application – Rule 161 EPC/Rule 162 EPC communication

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A.28 PCT Amendment of the Claims, the Description, and the Drawings, Before Designated Offices

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PCT AG-IP 5.111 Can the description be amended during the international phase?

**PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

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(1) On the demand of the applicant, his international application shall be the subject of an international preliminary examination as provided in the following provisions and the Regulations.

(2)(a) Any applicant who is a resident or national, as defined in the Regulations, of a Contracting State bound by **Chapter II**, and whose international application has been filed with the receiving Office of or acting for such State, may make a demand for international preliminary examination.

(b) The Assembly may decide to allow persons entitled to file international applications to make a demand for international preliminary examination even if they are residents or nationals of a State not party to this Treaty or not bound by **Chapter II**.

(3) The demand for international preliminary examination shall be made separately from the international application. The demand shall contain the prescribed particulars and shall be in the prescribed language and form.

(4)(a) The demand shall indicate the Contracting State or States in which the applicant intends to use the results of the international preliminary examination ("elected States"). Additional Contracting States may be elected later. Election may relate only to Contracting States already designated under **Article 4**.

(b) Applicants referred to in **paragraph (2)(a)** may elect any Contracting State bound by **Chapter II**. Applicants referred to in **paragraph (2)(b)** may elect only such Contracting States bound by **Chapter II** as have declared that they are prepared to be elected by such applicants.

(5) The demand shall be subject to the payment of the prescribed fees within the prescribed time limit.

(6)(a) The demand shall be submitted to the competent International Preliminary Examining Authority referred to in **Article 32**.

(b) Any later election shall be submitted to the International Bureau.

(7) Each elected Office shall be notified of its election.

### EPC Implementing Rules

R.161 EPC Amendment of the application

### EPO Guidelines - C Procedural Aspects of Substantive Examination

GL C II 3.2 Response to PCT actions prepared by the EPO

### EPO Guide for Applicants, part II Int. - D The EPO as an IPEA

GA D I 9 Who may file a demand for international preliminary examination with the EPO?

GA D I 10 How and where is the demand for international preliminary examination to be filed?

GA D I 20 Which states may be elected?

GA D I 22 Fees

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A.4 PCT The Request

A.32 PCT The International Preliminary Examining Authority

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A.53 PCT Assembly

A.63 PCT Entry into Force of the Treaty

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A.69 PCT Notifications

#### **PCT Implementing Rules**

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R.54 PCT The Applicant Entitled to Make a Demand

R.59 PCT The Competent International Preliminary Examining Authority

R.61 PCT Notification of the Demand and Elections

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PCT AG-IP 5.008 Where should an international application be filed?

PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

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PCT AG-IP 10.002 What are the main effects of the international preliminary examination?

PCT AG-IP 10.004 On what conditions may a demand for international preliminary examination be submitted?

PCT AG-IP 10.005 Which States may be elected?

PCT AG-IP 10.006 Where should the demand for international preliminary examination be submitted?

PCT AG-IP 10.010 At what stage of the procedure should the demand for international preliminary examination be submitted?

PCT AG-IP 10.012 What requirements as to form, contents and language must the demand for international preliminary examination comply with?

PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?

PCT AG-IP 10.024 Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination?

PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?

PCT AG-IP 10.029 Which States may be elected?

PCT AG-IP 10.035 What fees are payable in respect of a demand for international preliminary examination?

PCT AG-IP 10.039 What are the amounts of these fees?

PCT AG-IP 10.044 What happens to the demand for international preliminary examination once it has been received?

PCT AG-IP 10.046 What action can the applicant take if the indications on the demand form do not support the applicant's right to file the demand?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

PCT AG-IP 10.056 May the International Preliminary Examining Authority ask for the priority document and a translation of it?

PCT AG-IP 10.057 What is the purpose of the international preliminary examination?

PCT AG-IP 10.061 What documents form the basis of the international preliminary examination?

PCT AG-IP 10.062 What happens if no international search report has been established in respect of certain claims?

PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?

PCT AG-IP 10.066 What is a "written opinion"?

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PCT AG-IP 10.070 May amendments include new matter in the international application?

PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that "unity of invention" is lacking?

PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?

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PCT AG-IP 10.078 In what language is the international preliminary report on patentability ( Chapter II of the PCT )

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established?

PCT AG-IP 10.079 How do the applicant, the International Bureau and the elected Offices receive the international preliminary report on patentability ( Chapter II of the PCT ) and, where applicable, its translation?

PCT AG-IP 10.080 Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?

PCT AG-IP 10.081 To what extent is the international preliminary examination confidential?

PCT AG-IP 10.082 How can the applicant obtain copies of the documents cited in the international preliminary report on patentability ( Chapter II of the PCT )?

PCT AG-IP 10.083 What is the effect and usefulness of the international preliminary report on patentability ( Chapter II of the PCT ) in the national phase?

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PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?

PCT AG-IP 11.041 What steps will the competent authority take once a request for rectification of an obvious mistake has been filed?

PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?

PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?

PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?

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PCT AG-NP 2.004 When is an Office an elected Office?

PCT AG-NP 2.006 How does the national phase start?

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PCT AG-NP 3.003 Are reminders to enter the national phase sent to the applicant by the designated Offices? What happens if the international search report or the international preliminary examination report is late?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

#### **General Case Law**

J 3/94 EPO as an elected office / Election concerning the grant of a national patent not valid for the European grant [..]

J 4/94 EPO as elected Office / Demand by the elected Office - interpretation



## A.32 PCT The International Preliminary Examining Authority

(1) International preliminary examination shall be carried out by the International Preliminary Examining Authority.

(2) In the case of demands referred to in **Article 31(2)(a)**, the receiving Office, and, in the case of demands referred to in **Article 31(2)(b)**, the Assembly, shall, in accordance with the applicable agreement between the interested International Preliminary Examining Authority or Authorities and the International Bureau, specify the International Preliminary Examining Authority or Authorities competent for the preliminary examination.

(3) The provisions of **Article 16(3)** shall apply, *mutatis mutandis*, in respect of International Preliminary Examining Authorities.

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 4 Competence of the EPO as an IPEA

GA D I 5 Specification by the receiving Office

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A.31 PCT Demand for International Preliminary Examination

### **PCT Implementing Rules**

R.59 PCT The Competent International Preliminary Examining Authority

R.63 PCT Minimum Requirements for International Preliminary Examining Authorities

R.71 PCT Transmittal of the International Preliminary Examination Report

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.001 What is international preliminary examination?

PCT AG-IP 10.006 Where should the demand for international preliminary examination be submitted?

## A.33 PCT The International Preliminary Examination

- (1) 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 (to be non-obvious), and to be industrially applicable.
- (2) For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.
- (3) For the purposes of the international preliminary examination, a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.
- (4) For the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.
- (5) The criteria described above merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purpose of deciding whether, in that State, the claimed invention is patentable or not.
- (6) The international preliminary examination shall take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 2 Establishing the ISR and the WO-ISA

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 1 Aim of the international preliminary examination

GA D II 4 First written opinion

### **PCT Articles**

A.34 PCT Procedure Before the International Preliminary Examining Authority

A.35 PCT The International Preliminary Examination Report

### **PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.64 PCT Prior Art for International Preliminary Examination

R.65 PCT Inventive Step or Non-Obviousness

R.66 PCT Procedure before the International Preliminary Examining Authority

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.001 What is international preliminary examination?

PCT AG-IP 10.057 What is the purpose of the international preliminary examination?

### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.001 What is the effect of the PCT on the substantive conditions of patentability applied in the national phase?

### **General Case Law**

W 21/89 Uneinheitlichkeit a posteriori

W 6/98 Lack of unity of invention a posteriori - not established / Insufficient reasoning / IPEA

### ***R.53 PCT The Demand***

#### **53.1**     *Form*

- (a) The demand shall be made on a printed form or be presented as a computer print-out. The particulars of the printed form and of a demand presented as a computer print-out shall be prescribed by the Administrative Instructions.
- (b) Copies of printed demand forms shall be furnished free of charge by the receiving Office or by the International Preliminary Examining Authority.

#### **53.2**     *Contents*

- (a) The demand shall contain:
- (i) a petition,
  - (ii) indications concerning the applicant and the agent if there is an agent,
  - (iii) indications concerning the international application to which it relates,
  - (iv) where applicable, a statement concerning amendments.
- (b) The demand shall be signed.

#### **53.3**     *The Petition*

The petition shall be to the following effect and shall preferably be worded as follows: "Demand under **Article 31** of the Patent Cooperation Treaty: The undersigned requests that the international application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty."

#### **53.4**     *The Applicant*

As to the indications concerning the applicant, **Rules 4.4** and **4.16** shall apply, and **Rule 4.5** shall apply *mutatis mutandis*.

#### **53.5**     *Agent or Common Representative*

If an agent or common representative is appointed, the demand shall so indicate. **Rules 4.4** and **4.16** shall apply, and **Rule 4.7** shall apply *mutatis mutandis*.

#### **53.6**     *Identification of the International Application*

The international application shall be identified by the name and address of the applicant, the title of the invention, the international filing date (if known to the applicant) and the international application number or, where such number is not known to the applicant, the name of the receiving Office with which the international application was filed.

#### **53.7**     *Election of States*

## A.33 PCT The International Preliminary Examination

### R.53 PCT The Demand

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The filing of a demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty.

#### 53.8 *Signature*

(a) Subject to **paragraph (b)**, the demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.

(b) Where two or more applicants file a demand which elects a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the demand or could not be found or reached after diligent effort, the demand need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the International Preliminary Examining Authority, the lack of signature of the applicant concerned, or

(ii) the applicant concerned did not sign the request but the requirements of **Rule 4.15(b)** were complied with.

#### 53.9 *Statement Concerning Amendments*

(a) If amendments under **Article 19** have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments:

(i) to be taken into account, in which case a copy of the amendments and of the letter required under **Rule 46.5(b)** shall preferably be submitted with the demand; or

(ii) to be considered as reversed by an amendment under **Article 34**.

(b) If no amendments under Article 19 have been made and the time limit for filing such amendments has not expired, the statement may indicate that, should the International Preliminary Examining Authority wish to start the international preliminary examination at the same time as the international search in accordance with **Rule 69.1(b)**, the applicant wishes the start of the international preliminary examination to be postponed in accordance with **Rule 69.1(d)**.

(c) If any amendments under **Article 34** are submitted with the demand, the statement shall so indicate.

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 10 How and where is the demand for international preliminary examination to be filed?

GA D I 15 Translation of the international application

GA D I 20 Which states may be elected?

GA D I 21 Signature

GA D I 26 Defects in the demand and how they can be corrected

GA D II 1 Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements

#### **PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

A.31 PCT Demand for International Preliminary Examination

A.34 PCT Procedure Before the International Preliminary Examining Authority

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.46 PCT Amendment of Claims before the International Bureau

R.60 PCT Certain Defects in the Demand

R.69 PCT Start of and Time Limit for International Preliminary Examination

## A.33 PCT The International Preliminary Examination

### R.53 PCT The Demand

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R.90bis PCT Withdrawals

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.003 What should be done by the applicant when he receives the notification of receipt of the record copy?

PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.001 What is international preliminary examination?

PCT AG-IP 10.005 Which States may be elected?

PCT AG-IP 10.012 What requirements as to form, contents and language must the demand for international preliminary examination comply with?

PCT AG-IP 10.014 What are the requirements with respect to the identification of the international application?

PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?

PCT AG-IP 10.021 When and how may an agent be appointed for the purposes of the procedure concerning the international preliminary examination?

PCT AG-IP 10.025 What is the purpose of indicating the basis for international preliminary examination?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

PCT AG-IP 10.029 Which States may be elected?

PCT AG-IP 10.031 Who must sign the demand?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

PCT AG-IP 10.051 When does the international preliminary examination start?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.031 Do similar provisions apply to excuse non-signature of other documents connected with the international application?

#### **General Case Law**

J 3/94 EPO as an elected office / Election concerning the grant of a national patent not valid for the European grant [...]

J 4/94 EPO as elected Office / Demand by the elected Office - interpretation

### ***R.54 PCT The Applicant Entitled to Make a Demand***

#### **54.1     *Residence and Nationality***

(a) Subject to the provisions of **paragraph (b)**, the residence or nationality of the applicant shall, for the purposes of **Article 31(2)**, be determined according to **Rule 18.1(a)** and **(b)**.

(b) The International Preliminary Examining Authority shall, in the circumstances specified in the Administrative Instructions, request the receiving Office or, where the international application was filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned to decide the question whether the applicant is a resident or national of the Contracting State of which he claims to be a resident or national. The International Preliminary Examining Authority shall inform the applicant of any such request. The applicant shall have an opportunity to submit arguments directly to the Office concerned. The Office concerned shall decide the said question promptly.

#### **54.2     *Right to Make a Demand***

The right to make a demand under **Article 31(2)** shall exist if the applicant making the demand or, if there are two or more applicants, at least one of them is a resident or national of a Contracting State bound by **Chapter II** and the international application has been filed with a receiving Office of or acting for a Contracting State bound by **Chapter II**.

#### **54.3     *International Applications Filed with the International Bureau as Receiving Office***

Where the international application is filed with the International Bureau as receiving Office under **Rule 19.1(a)(iii)**, the International Bureau shall, for the purposes of **Article 31(2)(a)**, be considered to be acting for the Contracting State of which the applicant is a resident or national.

#### **54.4     *Applicant Not Entitled to Make a Demand***

If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under **Rule 54.2**, the demand shall be considered not to have been submitted.

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GA D I 9 Who may file a demand for international preliminary examination with the EPO?

#### **PCT Articles**

A.31 PCT Demand for International Preliminary Examination

#### **PCT Implementing Rules**

R.18 PCT The Applicant

R.19 PCT The Competent Receiving Office

R.57 PCT The Handling Fee

R.60 PCT Certain Defects in the Demand

R.61 PCT Notification of the Demand and Elections

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.008 Where should an international application be filed?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.004 On what conditions may a demand for international preliminary examination be submitted?

PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?

PCT AG-IP 10.043 In what cases are these fees refunded?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

***R.54bis PCT Time Limit for Making a Demand***

*54bis.1 Time Limit for Making a Demand*

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

(i) three months from the date of transmittal to the applicant of the international search report or the declaration referred to in **Article 17(2)(a)**, and of the written opinion established under **Rule 43bis.1**; or

(ii) 22 months from the priority date.

(b) Any demand made after the expiration of the time limit applicable under **paragraph (a)** shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 11 When should the demand for international preliminary examination be filed with the EPO?

GA D I 12 Start of the international preliminary examination

**PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.57 PCT The Handling Fee

R.59 PCT The Competent International Preliminary Examining Authority

R.69 PCT Start of and Time Limit for International Preliminary Examination

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.006 Where should the demand for international preliminary examination be submitted?

PCT AG-IP 10.010 At what stage of the procedure should the demand for international preliminary examination be submitted?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?

PCT AG-IP 10.051 When does the international preliminary examination start?

### ***R.55 PCT Languages (International Preliminary Examination)***

#### **55.1**     *Language of Demand*

The demand shall be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication. However, if a translation of the international application is required under **Rule 55.2**, the demand shall be in the language of that translation.

#### **55.2**     *Translation of International Application*

(a) Where neither the language in which the international application is filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to **paragraph (b)**, furnish with the demand a translation of the international application into a language which is both:

(i) a language accepted by that Authority, and

(ii) a language of publication.

(a-bis) A translation of the international application into a language referred to in **paragraph (a)** shall include any element referred to in **Article 11(1)(iii)(d)** or **(e)** furnished by the applicant under **Rule 20.3(b)** or **20.6(a)** and any part of the description, claims or drawings furnished by the applicant under **Rule 20.5(b)** or **20.6(a)** which is considered to have been contained in the international application under **Rule 20.6(b)**.

(a-ter) The International Preliminary Examining Authority shall check any translation furnished under **paragraph (a)** for compliance with the physical requirements referred to in **Rule 11** to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.

(b) Where a translation of the international application into a language referred to in **paragraph (a)** was transmitted to the International Searching Authority under **Rule 23.1(b)** and the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the applicant need not furnish a translation under **paragraph (a)**. In such a case, unless the applicant furnishes a translation under **paragraph (a)**, the international preliminary examination shall be carried out on the basis of the translation transmitted under **Rule 23.1(b)**.

(c) If a requirement referred to in **paragraphs (a)**, **(a-bis)** and **(a-ter)** is not complied with and **paragraph (b)** does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case may be, within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant complies with the invitation within the time limit under **paragraph (c)**, the said requirement shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted and the International Preliminary Examining Authority shall so declare.

#### **55.3**     *Language and Translation of Amendments and Letters*



### A.33 PCT The International Preliminary Examination

#### R.55 PCT Languages (International Preliminary Examination)

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(a) Subject to **paragraph (b)**, if the international application has been filed in a language other than the language in which it is published, any amendment under **Article 34**, as well as any letter referred to in **Rule 66.8(a)**, **Rule 66.8(b)** and **Rule 46.5(b)** as applicable by virtue of **Rule 66.8(c)**, shall be submitted in the language of publication.

(b) Where a translation of the international application is required under **Rule 55.2**:

(i) any amendment and any letter referred to in paragraph (a); and

(ii) any amendment under **Article 19** which is to be taken into account under **Rule 66.1(c)** or (d) and any letter referred to in **Rule 46.5(b)**;

shall be in the language of that translation. Where such amendments or letters have been or are submitted in another language, a translation shall also be submitted.

(c) If an amendment or letter is not submitted in a language as required under **paragraph (a)** or (b), the International Preliminary Examining Authority shall invite the applicant to submit the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant fails to comply, within the time limit under **paragraph (c)**, with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under **paragraph (c)**, with the invitation to furnish a letter referred to in **paragraph (a)** in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 15 Translation of the international application

GA D I 16 Applications filed in Dutch

GA D I 17 Language of the demand

#### **PCT Articles**

A.11 PCT Filing Date and Effects of the International Application

A.19 PCT Amendment of the Claims Before the International Bureau

A.34 PCT Procedure Before the International Preliminary Examining Authority

#### **PCT Implementing Rules**

R.11 PCT Physical Requirements of the International Application

R.12 PCT Language of the International Application and Translations for the Purposes of International Search and International Publication

R.20 PCT International Filing Date

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.46 PCT Amendment of Claims before the International Bureau

R.55 PCT Languages (International Preliminary Examination)

R.60 PCT Certain Defects in the Demand

R.61 PCT Notification of the Demand and Elections

R.66 PCT Procedure before the International Preliminary Examining Authority

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.92 PCT Correspondence

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.011 What happens if the international application was filed or published in a language which is not accepted by the International Preliminary Examining Authority?

PCT AG-IP 10.012 What requirements as to form, contents and language must the demand for international preliminary examination comply with?

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### R.55 PCT Languages (International Preliminary Examination)

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PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

PCT AG-IP 10.051 When does the international preliminary examination start?

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.046 In what language should amendments be submitted during the international phase?

PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?

#### **Case Law with Headnote**

J 8/07 Langue de la procédure - choix de la langue lors de l'entrée dans la phase régionale d'une demande PCT - utilisation  
[..]

***R.56 PCT [Deleted]***

### ***R.57 PCT The Handling Fee***

#### *57.1 Requirement to Pay*

Each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau ("handling fee") to be collected by the International Preliminary Examining Authority to which the demand is submitted.

#### *57.2 Amount*

- (a) The amount of the handling fee is as set out in the **Schedule of Fees**.
- (b) The handling fee shall be payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority ("prescribed currency").
- (c) Where the prescribed currency is the Swiss franc, the Authority shall promptly transfer the said fee to the International Bureau in Swiss francs.
- (d) Where the prescribed currency is a currency other than the Swiss franc and that currency:
  - (i) is freely convertible into Swiss francs, the Director General shall establish, for each Authority which prescribes such a currency for the payment of the handling fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the Authority to the International Bureau;
  - (ii) is not freely convertible into Swiss francs, the Authority shall be responsible for the conversion of the handling fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the **Schedule of Fees**, to the International Bureau. Alternatively, if the Authority so wishes, it may convert the handling fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.

#### *57.3 Time Limit for Payment; Amount Payable*

- (a) Subject to **paragraphs (b) and (c)**, the handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later.
- (b) Subject to **paragraph (c)**, where the demand was transmitted to the International Preliminary Examining Authority under **Rule 59.3**, the handling fee shall be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later.
- (c) Where, in accordance with **Rule 69.1(b)**, the International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search, that Authority shall invite the applicant to pay the handling fee within one month from the date of the invitation.
- (d) The amount of the handling fee payable shall be the amount applicable on the date of payment.

#### *57.4 Refund*

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

## A.33 PCT The International Preliminary Examination

### R.57 PCT The Handling Fee

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- (i) if the demand is withdrawn before the demand has been sent by that Authority to the International Bureau, or
- (ii) if the demand is considered, under **Rule 54.4** or **54bis.1(b)**, not to have been submitted.

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GA D I 22 Fees

#### **PCT Implementing Rules**

R.54 PCT The Applicant Entitled to Make a Demand

R.54bis PCT Time Limit for Making a Demand

R.58 PCT The Preliminary Examination Fee

R.58bis PCT Extension of Time Limits for Payment of Fees

R.59 PCT The Competent International Preliminary Examining Authority

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.96 PCT The Schedule of Fees

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.035 What fees are payable in respect of a demand for international preliminary examination?

PCT AG-IP 10.037 To whom are these fees payable?

PCT AG-IP 10.038 In what currency are these fees payable?

PCT AG-IP 10.039 What are the amounts of these fees?

PCT AG-IP 10.042 When are these fees due?

PCT AG-IP 10.043 In what cases are these fees refunded?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

#### **Case Law with Headnote**

W 18/06 Erfüllung der Bedingungen für die Anerkennung des Widerspruchs als erhoben - fristgemäße Zahlung der [...]

### ***R.58 PCT The Preliminary Examination Fee***

#### **58.1     *Right to Ask for a Fee***

(a) Each International Preliminary Examining Authority may require that the applicant pay a fee ("preliminary examination fee") for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(b) The amount of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority. As to the time limit for payment of the preliminary examination fee and the amount payable, the provisions of **Rule 57.3** relating to the handling fee shall apply *mutatis mutandis*.

(c) The preliminary examination fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

#### **58.2     *[Deleted]***

#### **58.3     *Refund***

The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.

#### **EPC Rules relating to Fees**

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 22 Fees

GA D I 25 Refund of the fee for international preliminary examination

#### **PCT Implementing Rules**

R.57 PCT The Handling Fee

R.58bis PCT Extension of Time Limits for Payment of Fees

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.035 What fees are payable in respect of a demand for international preliminary examination?

PCT AG-IP 10.037 To whom are these fees payable?

PCT AG-IP 10.038 In what currency are these fees payable?

PCT AG-IP 10.039 What are the amounts of these fees?

PCT AG-IP 10.042 When are these fees due?

PCT AG-IP 10.043 In what cases are these fees refunded?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

***R.58bis PCT Extension of Time Limits for Payment of Fees***

**58bis.1**     *Invitation by the International Preliminary Examining Authority*

(a) Where the International Preliminary Examining Authority finds:

(i) that the amount paid to it is insufficient to cover the handling fee and the preliminary examination fee; or

(ii) by the time they are due under **Rules 57.3** and **58.1(b)**, that no fees were paid to it;

the Authority shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under **Rule 58bis.2**, within a time limit of one month from the date of the invitation.

(b) Where the International Preliminary Examining Authority has sent an invitation under **paragraph (a)** and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under **Rule 58bis.2**, the demand shall, subject to **paragraph (c)**, be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(c) Any payment received by the International Preliminary Examining Authority before that Authority sends the invitation under **paragraph (a)** shall be considered to have been received before the expiration of the time limit under **Rule 57.3** or **58.1(b)**, as the case may be.

(d) Any payment received by the International Preliminary Examining Authority before that Authority proceeds under **paragraph (b)** shall be considered to have been received before the expiration of the time limit under **paragraph (a)**.

**58bis.2**     *Late Payment Fee*

(a) The payment of fees in response to an invitation under **Rule 58bis.1(a)** may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under **item (i)** is less than the handling fee, an amount equal to the handling fee.

(b) The amount of the late payment fee shall not, however, exceed double the amount of the handling fee.

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GA D I 24 Consequences of non- or late payment of fees

**PCT Implementing Rules**

R.57 PCT The Handling Fee

R.58 PCT The Preliminary Examination Fee

R.61 PCT Notification of the Demand and Elections

R.69 PCT Start of and Time Limit for International Preliminary Examination

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

PCT AG-IP 10.051 When does the international preliminary examination start?

***R.59 PCT The Competent International Preliminary Examining Authority***

59.1 *Demands under Article 31(2)(a)*

(a) For demands made under **Article 31(2)(a)**, each receiving Office of or acting for a Contracting State bound by the provisions of **Chapter II** shall, in accordance with the terms of the applicable agreement referred to in **Article 32(2)** and **(3)**, inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of **Rule 35.2** shall apply *mutatis mutandis*.

(b) Where the international application was filed with the International Bureau as receiving Office under **Rule 19.1(a)(iii)**, **Rule 35.3(a)** and **(b)** shall apply *mutatis mutandis*. **Paragraph (a)** of this Rule shall not apply to the International Bureau as receiving Office under **Rule 19.1(a)(iii)**.

59.2 *Demands under Article 31(2)(b)*

As to demands made under **Article 31(2)(b)**, the Assembly, in specifying the International Preliminary Examining Authority competent for international applications filed with a national Office which is an International Preliminary Examining Authority, shall give preference to that Authority; if the national Office is not an International Preliminary Examining Authority, the Assembly shall give preference to the International Preliminary Examining Authority recommended by that Office.

59.3 *Transmittal of the Demand to the Competent International Preliminary Examining Authority*

(a) If the demand is submitted to a receiving Office, an International Searching Authority, or an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Office or Authority shall mark the date of receipt on the demand and, unless it decides to proceed under **paragraph (f)**, transmit the demand promptly to the International Bureau.

(b) If the demand is submitted to the International Bureau, the International Bureau shall mark the date of receipt on the demand.

(c) Where the demand is transmitted to the International Bureau under **paragraph (a)** or submitted to it under **paragraph (b)**, the International Bureau shall promptly:

(i) if there is only one competent International Preliminary Examining Authority, transmit the demand to that Authority and inform the applicant accordingly, or

(ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within the time limit applicable under **Rule 54bis.1(a)** or 15 days from the date of the invitation, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

(d) Where an indication is furnished as required under **paragraph (c)(ii)**, the International Bureau shall promptly transmit the demand to the competent International Preliminary Examining Authority indicated by the applicant. Where no indication is so furnished, the demand shall be considered not to have been submitted and the International Bureau shall so declare.



### A.33 PCT The International Preliminary Examination

#### R.59 PCT The Competent International Preliminary Examining Authority

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(e) Where the demand is transmitted to a competent International Preliminary Examining Authority under **paragraph (c)**, it shall be considered to have been received on behalf of that Authority on the date marked on it under **paragraph (a)** or **(b)**, as applicable, and the demand so transmitted shall be considered to have been received by that Authority on that date.

(f) Where an Office or Authority to which the demand is submitted under **paragraph (a)** decides to transmit that demand directly to the competent International Preliminary Examining Authority, **paragraphs (c) to (e)** shall apply *mutatis mutandis*.

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 4 Competence of the EPO as an IPEA

GA D I 7 Choice of applicant

GA D I 10 How and where is the demand for international preliminary examination to be filed?

#### **PCT Articles**

A.31 PCT Demand for International Preliminary Examination

A.32 PCT The International Preliminary Examining Authority

#### **PCT Implementing Rules**

R.19 PCT The Competent Receiving Office

R.35 PCT The Competent International Searching Authority

R.54bis PCT Time Limit for Making a Demand

R.57 PCT The Handling Fee

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.006 Where should the demand for international preliminary examination be submitted?

PCT AG-IP 10.042 When are these fees due?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

## ***R.60 PCT Certain Defects in the Demand***

### **60.1**     *Defects in the Demand*

(a) Subject to **paragraphs (a-bis)** and **(a-ter)**, if the demand does not comply with the requirements specified in **Rules 53.1, 53.2(a)(i) to (iii), 53.2(b), 53.3 to 53.8 and 55.1**, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a-bis) For the purposes of **Rule 53.4**, if there are two or more applicants, it shall be sufficient that the indications referred to in **Rule 4.5(a)(ii)** and **(iii)** be provided in respect of one of them who has the right according to **Rule 54.2** to make a demand.

(a-ter) For the purposes of **Rule 53.8**, if there are two or more applicants, it shall be sufficient that the demand be signed by one of them.

(b) If the applicant complies with the invitation within the time limit under **paragraph (a)**, the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) If the applicant does not comply with the invitation within the time limit under **paragraph (a)**, the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(d) *[Deleted]*

(e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in **paragraphs (a) to (c)** .

(f) If the demand does not contain a statement concerning amendments, the International Preliminary Examining Authority shall proceed as provided for in **Rules 66.1 and 69.1(a) or (b)**.

(g) Where the statement concerning amendments contains an indication that amendments under **Article 34** are submitted with the demand (**Rule 53.9(c)**) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall invite the applicant to submit the amendments within a time limit fixed in the invitation and shall proceed as provided for in **Rule 69.1(e)**.

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 21 Signature

GA D I 26 Defects in the demand and how they can be corrected

#### **PCT Articles**

A.34 PCT Procedure Before the International Preliminary Examining Authority

#### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.53 PCT The Demand

R.54 PCT The Applicant Entitled to Make a Demand

R.55 PCT Languages (International Preliminary Examination)

R.61 PCT Notification of the Demand and Elections

R.66 PCT Procedure before the International Preliminary Examining Authority

## A.33 PCT The International Preliminary Examination

### R.60 PCT Certain Defects in the Demand

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R.69 PCT Start of and Time Limit for International Preliminary Examination

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

PCT AG-IP 10.031 Who must sign the demand?

PCT AG-IP 10.044 What happens to the demand for international preliminary examination once it has been received?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

## ***R.61 PCT Notification of the Demand and Elections***

### ***61.1 Notification to the International Bureau and the Applicant***

(a) The International Preliminary Examining Authority shall indicate on the demand the date of receipt or, where applicable, the date referred to in **Rule 60.1(b)**. The International Preliminary Examining Authority shall promptly either send the demand to the International Bureau and keep a copy in its files or send a copy to the International Bureau and keep the demand in its files.

(b) The International Preliminary Examining Authority shall promptly notify the applicant of the date of receipt of the demand. Where the demand has been considered under **Rules 54.4, 55.2(d), 58bis.1(b)** or **60.1(c)** as if it had not been submitted, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

### ***61.2 Notification to the Elected Offices***

(a) The notification provided for in **Article 31(7)** shall be effected by the International Bureau.

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) and the date of receipt by the International Preliminary Examining Authority of the demand.

(c) The notification shall be sent to the elected Office together with the communication provided for in **Article 20**. Elections effected after such communication shall be notified promptly after they have been made.

(d) Where the applicant makes an express request to an elected Office under **Article 40(2)** prior to the international publication of the international application, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the communication provided for in **Article 20** to that Office.

### ***61.3 Information for the Applicant***

The International Bureau shall inform the applicant in writing of the notification referred to in **Rule 61.2** and of the elected Offices notified under **Article 31(7)**.

### ***61.4 Publication in the Gazette***

The International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions.

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 10 How and where is the demand for international preliminary examination to be filed?

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 8 Request for early processing

#### **PCT Articles**

A.20 PCT Communication to Designated Offices

A.31 PCT Demand for International Preliminary Examination

A.40 PCT Delaying of National Examination and Other Processing

#### **PCT Implementing Rules**

R.54 PCT The Applicant Entitled to Make a Demand

R.55 PCT Languages (International Preliminary Examination)

R.58bis PCT Extension of Time Limits for Payment of Fees

R.60 PCT Certain Defects in the Demand

## A.33 PCT The International Preliminary Examination

### R.61 PCT Notification of the Demand and Elections

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R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.044 What happens to the demand for international preliminary examination once it has been received?

PCT AG-IP 10.046 What action can the applicant take if the indications on the demand form do not support the applicant's right to file the demand?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

#### **General Case Law**

J 13/03 Principle of protection of legitimate expectations / Restitutio -Euro - PCT applications - EPO designated Office

### A.33 PCT The International Preliminary Examination

#### R.62 PCT Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

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#### ***R.62 PCT Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority***

##### 62.1 *Copy of Written Opinion by International Searching Authority and of Amendments Made before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

- (i) a copy of the written opinion established under **Rule 43bis.1**, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and
- (ii) a copy of any amendment under **Article 19**, any statement referred to in that Article, and the letter required under **Rule 46.5(b)**, unless that Authority has indicated that it has already received such a copy.

##### 62.2 *Amendments Made after the Demand Is Filed*

If, at the time of filing any amendments under **Article 19**, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments, any statement referred to in that Article and the letter required under **Rule 46.5(b)**. In any case, the International Bureau shall promptly transmit a copy of such amendments, statement and letter to that Authority.

#### **PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

#### **PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.46 PCT Amendment of Claims before the International Bureau

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.179 In how many copies must an international application be filed?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.051 When does the international preliminary examination start?

***R.62bis PCT Translation for the International Preliminary Examining Authority of  
the Written Opinion of the International Searching Authority***

*62bis.1 Translation and Observations*

- (a) Upon request of the International Preliminary Examining Authority, the written opinion established under **Rule 43bis.1** shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau.
- (b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.
- (c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau.

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

***R.63 PCT Minimum Requirements for International Preliminary Examining Authorities***

63.1 *Definition of Minimum Requirements*

The minimum requirements referred to in **Article 32(3)** shall be the following:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out examinations;
- (ii) that Office or organization must have at its ready disposal at least the minimum documentation referred to in **Rule 34**, properly arranged for examination purposes;
- (iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in **Rule 34** is written or is translated;
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;
- (v) that Office or organization must hold an appointment as an International Searching Authority.

**PCT Articles**

A.32 PCT The International Preliminary Examining Authority

**PCT Implementing Rules**

R.34 PCT Minimum Documentation



## ***R.64 PCT Prior Art for International Preliminary Examination***

### **64.1**     *Prior Art*

(a) For the purposes of **Article 33(2)** and **(3)**, everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) For the purposes of **paragraph (a)**, the relevant date shall be:

(i) subject to **item (ii)** and **(iii)**, the international filing date of the international application under international preliminary examination;

(ii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid;

(iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

### **64.2**     *Non-Written Disclosures*

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means ("non-written disclosure") before the relevant date as defined in **Rule 64.1(b)** and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of **Article 33(2)** and **(3)**. Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in **Rule 70.9**.

### **64.3**     *Certain Published Documents*

In cases where any application or any patent which would constitute prior art for the purposes of **Article 33(2)** and **(3)** had it been published prior to the relevant date referred to in **Rule 64.1** was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of **Article 33(2)** and **(3)**. Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in **Rule 70.10**.

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GA D I 1 Aim of the international preliminary examination

#### **PCT Articles**

A.33 PCT The International Preliminary Examination

#### **PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.65 PCT Inventive Step or Non-Obviousness

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority  
(International Preliminary Examination Report)

## A.33 PCT The International Preliminary Examination

### R.64 PCT Prior Art for International Preliminary Examination

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R.88 PCT Amendment of the Regulations

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.057 What is the purpose of the international preliminary examination?

### ***R.65 PCT Inventive Step or Non-Obviousness***

#### **65.1     *Approach to Prior Art***

For the purposes of **Article 33(3)**, the international preliminary examination shall take into consideration the relation of any particular claim to the prior art as a whole. It shall take into consideration the claim's relation not only to individual documents or parts thereof taken separately but also its relation to combinations of such documents or parts of documents, where such combinations are obvious to a person skilled in the art

#### **65.2     *Relevant Date***

For the purposes of **Article 33(3)**, the relevant date for the consideration of inventive step (non-obviousness) is the date prescribed in **Rule 64.1**.

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GA D I 1 Aim of the international preliminary examination

#### **PCT Articles**

A.33 PCT The International Preliminary Examination

#### **PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.64 PCT Prior Art for International Preliminary Examination

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.057 What is the purpose of the international preliminary examination?

## A.34 PCT Procedure Before the International Preliminary Examining Authority

(1) Procedure before the International Preliminary Examining Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.

(2)(a) The applicant shall have a right to communicate orally and in writing with the International Preliminary Examining Authority.

(b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.

(c) The applicant shall receive at least one written opinion from the International Preliminary Examining Authority unless such Authority considers that all of the following conditions are fulfilled:

(i) the invention satisfies the criteria set forth in **Article 33(1)**,

(ii) the international application complies with the requirements of this Treaty and the Regulations in so far as checked by that Authority,

(iii) no observations are intended to be made under **Article 35(2)**, last sentence.

(d) The applicant may respond to the written opinion.

(3)(a) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it may invite the applicant, at his option, to restrict the claims so as to comply with the requirement or to pay additional fees.

(b) The national law of any elected State may provide that, where the applicant chooses to restrict the claims under **subparagraph (a)**, those parts of the international application which, as a consequence of the restriction, are not to be the subject of international preliminary examination shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

(c) If the applicant does not comply with the invitation referred to in **subparagraph (a)** within the prescribed time limit, the International Preliminary Examining Authority shall establish an international preliminary examination report on those parts of the international application which relate to what appears to be the main invention and shall indicate the relevant facts in the said report. The national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office.

(4)(a) If the International Preliminary Examining Authority considers

(i) that the international application relates to a subject matter on which the International Preliminary Examining Authority is not required, under the Regulations, to carry out an international preliminary examination, and in the particular case decides not to carry out such examination, or

(ii) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability, of the claimed invention,

the said Authority shall not go into the questions referred to in **Article 33(1)** and shall inform the applicant of this opinion and the reasons therefor.

(b) If any of the situations referred to in **subparagraph (a)** is found to exist in, or in connection with, certain claims only, the provisions of that subparagraph shall apply only to the said claims.

**EPC Implementing Rules**

R.158 EPC The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

**EPC Rules relating to Fees**

A. 14 Rfees EPC Reduction of fees

**EPO Guidelines - A Formalities Examination**

GL A III 13.2 Additional fee (if application documents comprise more than thirty-five pages)

**EPO Guidelines - B Search**

GL B III 3.3.2 Specific rules applicable to Euro-PCT applications

GL B XI 2 Basis of the search opinion

**EPO Guidelines - E General Procedural Matters**

GL E VIII 3.3.1 Earlier filed amendments or comments

GL E VIII 3.3.5 Indications on Form 1200

**EPO Guidelines - H Amendments and Corrections**

GL H II 2.1 Before receipt of the search report - Rule 137(1)

GL H III 2.1.1 Rule 137(4) communication and response thereto

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GA B 39 Applications disclosing nucleotide and/or amino acid sequences

**EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 12 Demand for international preliminary examination

GA C III 1 When may the EPO refuse to conduct a (full) search?

GA C IV 2 Scope and limitations of SIS

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GA D I 1 Aim of the international preliminary examination

GA D I 2 Usefulness of PCT Chapter II

GA D I 10 How and where is the demand for international preliminary examination to be filed?

GA D I 12 Start of the international preliminary examination

GA D I 16 Applications filed in Dutch

GA D II 1 Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements

GA D II 2 Amendments

GA D II 4 First written opinion

GA D II 8 First case: The EPO acted as ISA and made no objections

GA D II 10 Third case: The EPO did not act as ISA and the EPO as IPEA has no objections

GA D II 14 Refusal to perform preliminary examination

GA D II 15 Request for consultation by telephone

GA D II 17 Unity of invention

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E IV 6 Amendments and the Rule 161 EPC/Rule 162 EPC communication if no supplementary European search is carried out

## A.34 PCT Procedure Before the International Preliminary Examining Authority

### R.65 PCT Inventive Step or Non-Obviousness

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GA E V 3 What the translation must include

GA E VII 1 Page fee

#### **PCT Articles**

A.33 PCT The International Preliminary Examination

A.35 PCT The International Preliminary Examination Report

#### **PCT Implementing Rules**

R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

R.53 PCT The Demand

R.55 PCT Languages (International Preliminary Examination)

R.60 PCT Certain Defects in the Demand

R.66 PCT Procedure before the International Preliminary Examining Authority

R.68 PCT Lack of Unity of Invention (International Preliminary Examination)

R.69 PCT Start of and Time Limit for International Preliminary Examination

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.88 PCT Amendment of the Regulations

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.111 Can the description be amended during the international phase?

PCT AG-IP 5.127 Can the claims be amended during the international phase?

PCT AG-IP 5.162 Can the drawings be amended during the international phase?

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?

PCT AG-IP 9.011 In what circumstances should the claims be amended under Article 19 ?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.024 Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination?

PCT AG-IP 10.025 What is the purpose of indicating the basis for international preliminary examination?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

PCT AG-IP 10.027 May several check-boxes be marked in Box No. IV?

PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?

PCT AG-IP 10.051 When does the international preliminary examination start?

PCT AG-IP 10.061 What documents form the basis of the international preliminary examination?

PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?

PCT AG-IP 10.067 How may the applicant react to a written opinion by the International Preliminary Examining Authority?

PCT AG-IP 10.070 May amendments include new matter in the international application?

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking?

PCT AG-IP 10.076 How are amendments to the international application referred to in the international preliminary report on patentability ( Chapter II of the PCT )?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.038 Do rectifications of obvious mistakes need to be authorized by a particular Office?

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

PCT AG-IP 11.046 In what language should amendments be submitted during the international phase?

PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?

PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?

PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

A.34 PCT Procedure Before the International Preliminary Examining Authority  
R.65 PCT Inventive Step or Non-Obviousness

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**PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

**Case Law with Headnote**

J 20/89 EPO acting solely as IPEA / Appellate jurisdiction of Boards of Appeal in internat. phase (no)

W 4/93 IPEA / Umfang der Überprüfung nach Regel 68.3 e) PCT / Beurteilung der Einheitlichkeit a posteriori / Objektive [..]

**General Case Law**

W 6/98 Lack of unity of invention a posteriori - not established / Insufficient reasoning / IPEA

**Case Law with Headnote**

W 11/99 Einheitlichkeit zwischen Verfahrens- und Produktansprüchen und zwischen Produktansprüchen untereinander - ja

**General Case Law**

W 18/01 Lack of unity a posteriori - Invitation to pay additional fee - sufficiently reasoned (no)

W 21/04 Défaute d'unité d'invention à cause de l'omission d'une caractéristique dans les revendications telles qu'elles ont été [..]

### ***R.66 PCT Procedure before the International Preliminary Examining Authority***

#### **66.1**     *Basis of the International Preliminary Examination*

- (a) Subject to **paragraphs (b) to (d)**, the international preliminary examination shall be based on the international application as filed.
- (b) The applicant may submit amendments under **Article 34** at the time of filing the demand or, subject to **Rule 66.4bis**, until the international preliminary examination report is established.
- (c) Any amendments under **Article 19** made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under **Article 34**.
- (d) Any amendments under **Article 19** made after the demand was filed and any amendments under **Article 34** submitted to the International Preliminary Examining Authority shall, subject to **Rule 66.4bis**, be taken into account for the purposes of the international preliminary examination.
- (d-bis) A rectification of an obvious mistake that is authorized under **Rule 91.1** shall, subject to **Rule 66.4bis**, be taken into account by the International Preliminary Examining Authority for the purposes of the international preliminary examination.
- (e) Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

#### **66.1bis**     *Written Opinion of the International Searching Authority*

- (a) Subject to **paragraph (b)**, the written opinion established by the International Searching Authority under **Rule 43bis.1** shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of **Rule 66.2(a)**.
- (b) An International Preliminary Examining Authority may notify the International Bureau that paragraph (a) shall not apply to the procedure before it in respect of written opinions established under **Rule 43bis.1** by the International Searching Authority or Authorities specified in the notification, provided that such a notification shall not apply to cases where the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority. The International Bureau shall promptly publish any such notification in the Gazette.<sup>10</sup>
- (c) Where the written opinion established by the International Searching Authority under **Rule 43bis.1** is not, by virtue of a notification under **paragraph (b)**, considered to be a written opinion of the International Preliminary Examining Authority for the purposes of **Rule 66.2(a)**, the International Preliminary Examining Authority shall notify the applicant accordingly in writing.
- (d) A written opinion established by the International Searching Authority under **Rule 43bis.1** which is not, by virtue of a notification under **paragraph (b)**, considered to be a written opinion of the International Preliminary Examining Authority for the purposes of **Rule 66.2(a)** shall nevertheless be taken into account by the International Preliminary Examining Authority in proceeding under **Rule 66.2(a)**.

#### **66.2**     *Written Opinion of the International Preliminary Examining Authority*



(a) If the International Preliminary Examining Authority

- (i) considers that any of the situations referred to in **Article 34(4)** exists,
- (ii) considers that the international preliminary examination report should be negative in respect of any of the claims because the invention claimed therein does not appear to be novel, does not appear to involve an inventive step (does not appear to be non-obvious), or does not appear to be industrially applicable,
- (iii) notices that there is some defect in the form or contents of the international application under the Treaty or these Regulations,
- (iv) considers that any amendment goes beyond the disclosure in the international application as filed,
- (v) wishes to accompany the international preliminary examination report by observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description,
- (vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, or
- (vii) considers that a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out,

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of **Rule 6.4(a)**, the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply **Article 34(4)(b)**. In such case, it shall notify the applicant accordingly in writing

- (b) The notification shall fully state the reasons for the opinion of the International Preliminary Examining Authority.
- (c) The notification shall invite the applicant to submit a written reply together, where appropriate, with amendments.
- (d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall, subject to **paragraph (e)**, not be more than three months after the said date.
- (e) The time limit for replying to the notification may be extended if the applicant so requests before its expiration.

66.3 *Formal Response to the International Preliminary Examining Authority*

- (a) The applicant may respond to the invitation referred to in **Rule 66.2(c)** of the International Preliminary Examining Authority by making amendments or—if he disagrees with the opinion of that Authority—by submitting arguments, as the case may be, or do both.

(b) Any response shall be submitted directly to the International Preliminary Examining Authority.

66.4 *Additional Opportunity for Submitting Amendments or Arguments*

(a) If the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and **Rules 66.2** and **66.3** shall apply.

(b) On the request of the applicant, the International Preliminary Examining Authority may give him one or more additional opportunities to submit amendments or arguments.

66.4bis *Consideration of Amendments, Arguments and Rectifications of Obvious Mistakes*

Amendments, arguments and rectifications of obvious mistakes need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received by, authorized by or notified to that Authority, as applicable, after it has begun to draw up that opinion or report.

66.5 *Amendment*

Any change, other than the rectification of an obvious mistake, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

66.6 *Informal Communications with the Applicant*

The International Preliminary Examining Authority may, at any time, communicate informally, over the telephone, in writing, or through personal interviews, with the applicant. The said Authority shall, at its discretion, decide whether it wishes to grant more than one personal interview if so requested by the applicant, or whether it wishes to reply to any informal written communication from the applicant.

66.7 *Copy and Translation of Earlier Application Whose Priority Is Claimed*

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of **Rule 17.1**, and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in **Article 33(1)**, invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

66.8 *Form of Amendments*

(a) Subject to **paragraph (b)**, when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on

account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in **paragraph (a)** may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

(c) When amending the claims, **Rule 46.5** shall apply *mutatis mutandis*. The set of claims submitted under **Rule 46.5** as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles **19** or **34**, as the case may be.

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<sup>10</sup> *Editor's Note:* This information is also published on the WIPO website at:  
**[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 3.4 Rule 137(4) applies

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C III 1 When may the EPO refuse to conduct a (full) search?

GA C III 10 Consequences of non-payment of additional fee(s)

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 12 Start of the international preliminary examination

GA D I 15 Translation of the international application

GA D I 16 Applications filed in Dutch

GA D II 1 Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements

GA D II 2 Amendments

GA D II 4 First written opinion

GA D II 9 Second case: The EPO acted as ISA and made objections

GA D II 11 Fourth case: The EPO did not act as ISA and the EPO as IPEA has objections

GA D II 12 Time limit for reply to the written opinion

GA D II 14 Refusal to perform preliminary examination

GA D II 15 Request for consultation by telephone

GA D II 16 Nucleotide and amino acid sequences

GA D II 17 Unity of invention

#### **PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

A.33 PCT The International Preliminary Examination

A.34 PCT Procedure Before the International Preliminary Examining Authority

#### **PCT Implementing Rules**

R.6 PCT The Claims

R.17 PCT The Priority Document

R.43bis PCT Written Opinion of the International Searching Authority

R.46 PCT Amendment of Claims before the International Bureau

R.55 PCT Languages (International Preliminary Examination)

R.60 PCT Certain Defects in the Demand

R.68 PCT Lack of Unity of Invention (International Preliminary Examination)

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

## A.34 PCT Procedure Before the International Preliminary Examining Authority

### R.66 PCT Procedure before the International Preliminary Examining Authority

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PCT AG-IP 9.009 May the amended claims include new matter?

PCT AG-IP 9.011 In what circumstances should the claims be amended under Article 19 ?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.024 Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination?

PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?

PCT AG-IP 10.056 May the International Preliminary Examining Authority ask for the priority document and a translation of it?

PCT AG-IP 10.061 What documents form the basis of the international preliminary examination?

PCT AG-IP 10.062 What happens if no international search report has been established in respect of certain claims?

PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?

PCT AG-IP 10.066 What is a “written opinion”?

PCT AG-IP 10.067 How may the applicant react to a written opinion by the International Preliminary Examining Authority?

PCT AG-IP 10.068 Will amendments and arguments always be taken into account?

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?

PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

***R.67 PCT Subject Matter under Article 34(4)(a)(i)***

67.1 *Definition*

No International Preliminary Examining Authority shall be required to carry out an international preliminary examination on an international application if, and to the extent to which, its subject matter is any of the following:

- (i) scientific and mathematical theories,
- (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information,
- (vi) computer programs to the extent that the International Preliminary Examining Authority is not equipped to carry out an international preliminary examination concerning such programs.

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 1 Aim of the international preliminary examination

GA D II 14 Refusal to perform preliminary examination

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.88 PCT Amendment of the Regulations

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?

**Case Law of the Enlarged Board**

G 1/07 Applicable provisions - Art. 112(1) EPC 1973 - Art. 53(c) EPC" / Admissibility of the referral - yes / The Vienna [..]

***R.68 PCT Lack of Unity of Invention (International Preliminary Examination)***

68.1 *No Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall proceed with the international preliminary examination, subject to **Article 34(4)(b)** and **Rule 66.1(e)**, in respect of the entire international application, but shall indicate, in any written opinion and in the international preliminary examination report, that it considers that the requirement of unity of invention is not fulfilled and it shall specify the reasons therefor.

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation shall:

- (i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement;
- (ii) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;
- (iii) invite the applicant to comply with the invitation within one month from the date of the invitation;
- (iv) indicate the amount of the required additional fees to be paid in case the applicant so chooses; and
- (v) invite the applicant to pay, where applicable, the protest fee referred to in **Rule 68.3(e)** within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

- (a) The amount of the additional fees due for international preliminary examination under **Article 34(3)(a)** shall be determined by the competent International Preliminary Examining Authority.
- (b) The additional fees due for international preliminary examination under **Article 34(3)(a)** shall be payable direct to the International Preliminary Examining Authority.
- (c) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive. Such protest shall be examined by a review body constituted in the framework of the International Preliminary Examining Authority which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.
- (d) The membership of the review body referred to in **paragraph (c)** may include, but shall not be limited to, the person who made the decision which is the subject of the protest.

A.34 PCT Procedure Before the International Preliminary Examining Authority  
R.68 PCT Lack of Unity of Invention (International Preliminary Examination)

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(e) The examination of a protest referred to in **paragraph (c)** may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. Where the applicant has not, within the time limit under **Rule 68.2(v)**, paid any required protest fee, the protest shall be considered not to have been made and the International Preliminary Examining Authority shall so declare. The protest fee shall be refunded to the applicant where the review body referred to in **paragraph (c)** finds that the protest was entirely justified.

68.4 *Procedure in the Case of Insufficient Restriction of the Claims*

If the applicant restricts the claims but not sufficiently to comply with the requirement of unity of invention, the International Preliminary Examining Authority shall proceed as provided in **Article 34(3)(c)**.

68.5 *Main Invention*

In case of doubt which invention is the main invention for the purposes of **Article 34(3)(c)**, the invention first mentioned in the claims shall be considered the main invention.

**EPC Implementing Rules**

R.158 EPC The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

**EPC Rules relating to Fees**

A. 2 Rfees EPC Fees provided for in the Convention and in the Implementing Regulations

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 17 Unity of invention

**PCT Articles**

A.34 PCT Procedure Before the International Preliminary Examining Authority

**PCT Implementing Rules**

R.66 PCT Procedure before the International Preliminary Examining Authority

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking?

**Case Law with Headnote**

W 4/93 IPEA / Umfang der Überprüfung nach Regel 68.3 e) PCT / Beurteilung der Einheitlichkeit a posteriori / Objektive [...]

**General Case Law**

W 6/98 Lack of unity of invention a posteriori - not established / Insufficient reasoning / IPEA

W 18/01 Lack of unity a posteriori - Invitation to pay additional fee - sufficiently reasoned (no)

W 21/04 Défaute d'unité d'invention à cause de l'omission d'une caractéristique dans les revendications telles qu'elles ont été [...]

### ***R.69 PCT Start of and Time Limit for International Preliminary Examination***

#### **69.1**     *Start of International Preliminary Examination*

(a) Subject to **paragraphs (b) to (e)**, the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

- (i) the demand;
- (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under **Rule 58bis.2**; and
- (iii) either the international search report or the declaration by the International Searching Authority under **Article 17(2)(a)** that no international search report will be established, and the written opinion established under **Rule 43bis.1**;

provided that the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under **Rule 54bis.1(a)** unless the applicant expressly requests an earlier start.

(b) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes and subject to **paragraphs (d) and (e)**, start at the same time as the international search.

(b-bis) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in **Article 34(2)(c)(i) to (iii)** are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under **Rule 43bis.1**.

(c) Where the statement concerning amendments contains an indication that amendments under **Article 19** are to be taken into account (**Rule 53.9(a)(i)**), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (**Rule 53.9(b)**), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

- (i) it has received a copy of any amendments made under **Article 19**;
- (ii) it has received a notice from the applicant that he does not wish to make amendments under **Article 19**; or
- (iii) the expiration of the applicable time limit under **Rule 46.1**.

(e) Where the statement concerning amendments contains an indication that amendments under **Article 34** are submitted with the demand (**Rule 53.9(c)**) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international



A.34 PCT Procedure Before the International Preliminary Examining Authority  
R.69 PCT Start of and Time Limit for International Preliminary Examination

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preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in **Rule 60.1(g)** has expired, whichever occurs first.

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

- (i) 28 months from the priority date; or
- (ii) six months from the time provided under **Rule 69.1** for the start of the international preliminary examination; or
- (iii) six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under **Rule 55.2**.

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 12 Start of the international preliminary examination

GA D I 14 Time limit for establishing the IPER

GA D II 12 Time limit for reply to the written opinion

**PCT Articles**

A.17 PCT Procedure Before the International Searching Authority

A.19 PCT Amendment of the Claims Before the International Bureau

A.34 PCT Procedure Before the International Preliminary Examining Authority

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.46 PCT Amendment of Claims before the International Bureau

R.53 PCT The Demand

R.54bis PCT Time Limit for Making a Demand

R.55 PCT Languages (International Preliminary Examination)

R.57 PCT The Handling Fee

R.58bis PCT Extension of Time Limits for Payment of Fees

R.60 PCT Certain Defects in the Demand

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.010 At what stage of the procedure should the demand for international preliminary examination be submitted?

PCT AG-IP 10.026 How should the statement concerning amendments be completed?

PCT AG-IP 10.051 When does the international preliminary examination start?

PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?

**PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.038 Do rectifications of obvious mistakes need to be authorized by a particular Office?

## A.35 PCT The International Preliminary Examination Report

- (1) The international preliminary examination report shall be established within the prescribed time limit and in the prescribed form.
- (2) The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law. It shall state, subject to the provisions of **paragraph (3)**, in relation to each claim, whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined for the purposes of the international preliminary examination in **Article 33(1) to (4)**. The statement shall be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require. The statement shall also be accompanied by such other observations as the Regulations provide for.
- (3)(a) If, at the time of establishing the international preliminary examination report, the International Preliminary Examining Authority considers that any of the situations referred to in **Article 34(4)(a)** exists, that report shall state this opinion and the reasons therefor. It shall not contain any statement as provided in **paragraph (2)**.
- (b) If a situation under **Article 34(4)(b)** is found to exist, the international preliminary examination report shall, in relation to the claims in question, contain the statement as provided in **subparagraph (a)**, whereas, in relation to the other claims, it shall contain the statement as provided in **paragraph (2)**.

### EPO Guide for Applicants, part II Int. - D The EPO as an IPEA

GA D I 1 Aim of the international preliminary examination

GA D II 4 First written opinion

#### PCT Articles

A.33 PCT The International Preliminary Examination

A.34 PCT Procedure Before the International Preliminary Examining Authority

#### PCT Implementing Rules

R.43bis PCT Written Opinion of the International Searching Authority

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

#### PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)

PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?

PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?

PCT AG-IP 10.075 What are the form and contents of the international preliminary report

PCT AG-IP 10.077 May the international preliminary report on patentability ( Chapter II of the PCT ) express a view on the patentability of the invention?

***R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)***

70.1 *Definition*

For the purposes of this Rule, "report" shall mean international preliminary examination report.

70.2 *Basis of the Report*

(a) If the claims have been amended, the report shall issue on the claims as amended.

(b) If, pursuant to **Rule 66.7(a)** or **(b)**, the report is established as if the priority had not been claimed, the report shall so indicate.

(c) If the International Preliminary Examining Authority considers that any amendment goes beyond the disclosure in the international application as filed, the report shall be established as if such amendment had not been made, and the report shall so indicate. It shall also indicate the reasons why it considers that the amendment goes beyond the said disclosure.

(c-bis) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under **Rule 46.5(b)(iii)**, **Rule 46.5(b)(iii)** being applicable by virtue of **Rule 66.8(c)**, or **Rule 66.8(a)**, as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

(d) Where claims relate to inventions in respect of which no international search report has been established and have therefore not been the subject of international preliminary examination, the international preliminary examination report shall so indicate.

(e) If a rectification of an obvious mistake is taken into account under **Rule 66.1**, the report shall so indicate. If a rectification of an obvious mistake is not taken into account pursuant to **Rule 66.4bis**, the report shall, if possible, so indicate, failing which the International Preliminary Examining Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

70.3 *Identifications*

The report shall identify the International Preliminary Examining Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant, and the international filing date.

70.4 *Dates*

The report shall indicate:

(i) the date on which the demand was submitted, and

(ii) the date of the report; that date shall be the date on which the report is completed.

70.5 *Classification*

#### A.35 PCT The International Preliminary Examination Report

##### R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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(a) The report shall repeat the classification given under **Rule 43.3** if the International Preliminary Examining Authority agrees with such classification.

(b) Otherwise, the International Preliminary Examining Authority shall indicate in the report the classification, at least according to the International Patent Classification, which it considers correct.

#### 70.6 *Statement under Article 35(2)*

(a) The statement referred to in **Article 35(2)** shall consist of the words "YES" or "NO," or their equivalent in the language of the report, or some appropriate sign provided for in the Administrative Instructions, and shall be accompanied by the citations, explanations and observations, if any, referred to in the last sentence of **Article 35(2)**.

(b) If any of the three criteria referred to in **Article 35(2)** (that is, novelty, inventive step (non-obviousness), industrial applicability) is not satisfied, the statement shall be negative. If, in such a case, any of the criteria, taken separately, is satisfied, the report shall specify the criterion or criteria so satisfied.

#### 70.7 *Citations under Article 35(2)*

(a) The report shall cite the documents considered to be relevant for supporting the statements made under **Article 35(2)**, whether or not such documents are cited in the international search report. Documents cited in the international search report need only be cited in the report when they are considered by the International Preliminary Examining Authority to be relevant.

(b) The provisions of **Rule 43.5(b)** and (e) shall apply also to the report.

#### 70.8 *Explanations under Article 35(2)*

The Administrative Instructions shall contain guidelines for cases in which the explanations referred to in **Article 35(2)** should or should not be given and the form of such explanations. Such guidelines shall be based on the following principles:

- (i) explanations shall be given whenever the statement in relation to any claim is negative;
- (ii) explanations shall be given whenever the statement is positive unless the reason for citing any document is easy to imagine on the basis of consultation of the cited document;
- (iii) generally, explanations shall be given if the case provided for in the last sentence of **Rule 70.6(b)** obtains.

#### 70.9 *Non-Written Disclosures*

Any non-written disclosure referred to in the report by virtue of **Rule 64.2** shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public.

#### 70.10 *Certain Published Documents*

Any published application or any patent referred to in the report by virtue of **Rule 64.3** shall be mentioned as such and shall be accompanied by an indication of its date of publication, of its filing date, and its claimed priority date (if any). In respect of the priority date of any such document, the

## A.35 PCT The International Preliminary Examination Report

### R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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report may indicate that, in the opinion of the International Preliminary Examining Authority, such date has not been validly claimed.

#### 70.11 *Mention of Amendments*

If, before the International Preliminary Examining Authority, amendments have been made, this fact shall be indicated in the report. Where any amendment has resulted in the cancellation of an entire sheet, this fact shall also be specified in the report.

#### 70.12 *Mention of Certain Defects and Other Matters*

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

- (i) the international application contains any of the defects referred to in **Rule 66.2(a)(iii)**, it shall include this opinion and the reasons therefor in the report;
- (ii) the international application calls for any of the observations referred to in **Rule 66.2(a)(v)**, it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;
- (iii) any of the situations referred to in **Article 34(4)** exists, it shall state this opinion and the reasons therefor in the report;
- (iv) a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, it shall so state in the report.

#### 70.13 *Remarks Concerning Unity of Invention*

If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under **Article 34(3)**, the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (**Article 34(3)(a)**), or on the main invention only (**Article 34(3)(c)**), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in **Rule 68.1**, where the International Preliminary Examining Authority chose not to invite the applicant to restrict the claims or to pay additional fees.

#### 70.14 *Authorized Officer*

The report shall indicate the name of the officer of the International Preliminary Examining Authority responsible for that report.

#### 70.15 *Form; Title*

(a) The physical requirements as to the form of the report shall be prescribed by the Administrative Instructions.

(b) The report shall bear the title "international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)" together with an indication that it is the international preliminary examination report established by the International Preliminary Examining Authority.

#### 70.16 *Annexes to the Report*

## A.35 PCT The International Preliminary Examination Report

### R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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(a) The following replacement sheets and letters shall be annexed to the report:

- (i) each replacement sheet under **Rule 66.8** containing amendments under **Article 34** and each letter under **Rule 66.8(a)**, **Rule 66.8(b)** and **Rule 46.5(b)** as applicable by virtue of **Rule 66.8(c)**;
- (ii) each replacement sheet under **Rule 46.5** containing amendments under **Article 19** and each letter under **Rule 46.5**; and
- (iii) each replacement sheet under **Rule 26.4** as applicable by virtue of **Rule 91.2** containing a rectification of an obvious mistake authorized by that Authority under **Rule 91.1(b)(iii)** and each letter under **Rule 26.4** as applicable by virtue of **Rule 91.2**;

unless any such replacement sheet has been superseded or considered reversed by a later replacement sheet or an amendment resulting in the cancellation of an entire sheet under **Rule 66.8(b)**; and

(iv) where the report contains an indication referred to in **Rule 70.2(e)**, any sheet and letter relating to a rectification of an obvious mistake which is not taken into account pursuant to **Rule 66.4bis**.

(b) Notwithstanding **paragraph (a)**, each superseded or reversed replacement sheet referred to in that paragraph and any letter referred to in that paragraph relating to such superseded or reversed sheet shall also be annexed to the report where:

- (i) the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in **Rule 70.2(c)**;
- (ii) the relevant superseding or reversing amendment was not accompanied by a letter indicating the basis for the amendment in the application as filed and the report is established as if the amendment had not been made and contains an indication referred to in **Rule 70.2(câ ‘bis)**.

In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

## 70.17 *Languages of the Report and the Annexes*

The report and any annex shall be in the language in which the international application to which they relate is published, or, if the international preliminary examination is carried out, pursuant to **Rule 55.2**, on the basis of a translation of the international application, in the language of that translation.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 3.4 Rule 137(4) applies

GL E VIII 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 10 Amendments under Article 19 PCT

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 1 Aim of the international preliminary examination

GA D II 1 Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements

GA D II 2 Amendments

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E V 3 What the translation must include

### **PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

A.34 PCT Procedure Before the International Preliminary Examining Authority

A.35 PCT The International Preliminary Examination Report

### **PCT Implementing Rules**

## A.35 PCT The International Preliminary Examination Report

### R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.43 PCT The International Search Report

R.43bis PCT Written Opinion of the International Searching Authority

R.45bis PCT Supplementary International Searches

R.46 PCT Amendment of Claims before the International Bureau

R.55 PCT Languages (International Preliminary Examination)

R.64 PCT Prior Art for International Preliminary Examination

R.66 PCT Procedure before the International Preliminary Examining Authority

R.68 PCT Lack of Unity of Invention (International Preliminary Examination)

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

R.74 PCT Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.009\_a What happens where the replacement sheets were not accompanied by a letter?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.070 May amendments include new matter in the international application?

PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?

PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking?

PCT AG-IP 10.075 What are the form and contents of the international preliminary report

PCT AG-IP 10.076 How are amendments to the international application referred to in the international preliminary report on patentability ( Chapter II of the PCT )?

PCT AG-IP 10.078 In what language is the international preliminary report on patentability ( Chapter II of the PCT ) established?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.041 What steps will the competent authority take once a request for rectification of an obvious mistake has been filed?

PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?

PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

## **A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report**

(1) The international preliminary examination report, together with the prescribed annexes, shall be transmitted to the applicant and to the International Bureau.

(2)(a) The international preliminary examination report and its annexes shall be translated into the prescribed languages.

(b) Any translation of the said report shall be prepared by or under the responsibility of the International Bureau, whereas any translation of the said annexes shall be prepared by the applicant.

(3)(a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated by the International Bureau to each elected Office.

(b) The prescribed translation of the annexes shall be transmitted within the prescribed time limit by the applicant to the elected Offices.

(4) The provisions of **Article 20(3)** shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 18 What must be done after receipt of the IPER?

GA D II 19 Confidentiality of the international preliminary examination

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E I 8 Request for early processing

GA E V 3 What the translation must include

### **PCT Articles**

A.20 PCT Communication to Designated Offices

A.38 PCT Confidential Nature of the International Preliminary Examination

### **PCT Implementing Rules**

R.71 PCT Transmittal of the International Preliminary Examination Report

R.73 PCT Communication of the International Preliminary Examination Report or the Written Opinion of the International Searching Authority

R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.079 How do the applicant, the International Bureau and the elected Offices receive the international preliminary report on patentability ( Chapter II of the PCT ) and, where applicable, its translation?

PCT AG-IP 10.080 Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?

PCT AG-IP 10.082 How can the applicant obtain copies of the documents cited in the international preliminary report on patentability ( Chapter II of the PCT )?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?



A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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**PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

***R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices***

76.1, 76.2 and 76.3 [Deleted]

76.4 *Time Limit for Translation of Priority Document*

The applicant shall not be required to furnish to any elected Office a translation of the priority document before the expiration of the applicable time limit under **Article 39**.

76.5 *Application of Certain Rules to Procedures before Elected Offices*

**Rules 13ter.3, 20.8(c), 22.1(g), 47.1, 49, 49bis, 49ter and 51bis** shall apply, provided that:

- (i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;
- (ii) any reference in the said Rules to **Article 22** or **Article 24(2)** shall be construed as a reference to **Article 39(1)** or **Article 39(3)**, respectively;
- (iii) the words "international applications filed" in **Rule 49.1(c)** shall be replaced by the words "a demand submitted;"
- (iv) for the purposes of **Article 39(1)**, where an international preliminary examination report has been established, a translation of any amendment under **Article 19** shall only be required if that amendment is annexed to that report;
- (v) the reference in **Rule 47.1(a)** to **Rule 47.4** shall be construed as a reference to **Rule 61.2(d)**.

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E V 2 Consequences of not filing a translation of the application

GA E XIII XIII.

**PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.24 PCT Possible Loss of Effect in Designated States

A.39 PCT Copy, Translation, and Fee, to Elected Offices

**PCT Implementing Rules**

R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

R.20 PCT International Filing Date

R.22 PCT Transmittal of the Record Copy and Translation

R.47 PCT Communication to Designated Offices

R.49 PCT Copy, Translation and Fee under Article 22

R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

R.49ter PCT Effect of Restoration of Right of Priority by Receiving Office; Restoration of Right of Priority by Designated Office

R.51bis PCT Certain National Requirements Allowed under Article 27

R.61 PCT Notification of the Demand and Elections

**PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?

PCT AG-NP 4.008 In which case must the international application be translated?

PCT AG-NP 4.009 What is the language into which the international application must be translated?

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international

## A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report

### R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

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preliminary examination?

PCT AG-NP 4.021 Does the translation have to contain drawings?

PCT AG-NP 4.022 How must the translation of text matter in drawings be presented?

PCT AG-NP 4.023 What are the physical requirements for the translation?

PCT AG-NP 4.024 In how many copies must the translation be furnished?

PCT AG-NP 4.025 Must the translation be certified?

PCT AG-NP 4.026 Must the translation be verified?

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?

PCT AG-NP 4.032 Is the use of national forms mandatory for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?

PCT AG-NP 5.003 What must be done to prove inventorship, the right to file the application or the like?

PCT AG-NP 5.006 Must the applicant be represented by an agent for the national phase?

PCT AG-NP 5.007 When and how must the agent be appointed?

PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?

***R.72 PCT Translation of the International Preliminary Examination Report and of the Written Opinion of the International Searching Authority***

72.1 *Languages*

(a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

72.2 *Copy of Translation for the Applicant*

The International Bureau shall transmit a copy of the translation referred to in **Rule 72.1(a)** of the international preliminary examination report to the applicant at the same time as it communicates such translation to the interested elected Office or Offices.

72.2bis *Translation of the Written Opinion of the International Searching Authority Established under Rule 43bis.1*

In the case referred to in **Rule 73.2(b)(ii)**, the written opinion established by the International Searching Authority under **Rule 43bis.1** shall, upon request of the elected Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the elected Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

72.3 *Observations on the Translation*

The applicant may make written observations as to the correctness of the translation of the international preliminary examination report or of the written opinion established by the International Searching Authority under **Rule 43bis.1** and shall send a copy of the observations to each of the interested elected Offices and to the International Bureau.

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.73 PCT Communication of the International Preliminary Examination Report or the Written Opinion of the International Searching Authority

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.078 In what language is the international preliminary report on patentability ( Chapter II of the PCT ) established?

***R.73 PCT Communication of the International Preliminary Examination Report or the Written Opinion of the International Searching Authority***

73.1 *Preparation of Copies*

The International Bureau shall prepare the copies of the documents to be communicated under **Article 36(3)(a)**.

73.2 *Communication to Elected Offices*

(a) The International Bureau shall effect the communication provided for in **Article 36(3)(a)** to each elected Office in accordance with **Rule 93bis.1** but not before the expiration of 30 months from the priority date.

(b) Where the applicant makes an express request to an elected Office under **Article 40(2)**, the International Bureau shall, upon the request of that Office or of the applicant,

(i) if the international preliminary examination report has already been transmitted to the International Bureau under **Rule 71.1**, promptly effect the communication provided for in **Article 36(3)(a)** to that Office;

(ii) if the international preliminary examination report has not been transmitted to the International Bureau under **Rule 71.1**, promptly communicate a copy of the written opinion established by the International Searching Authority under **Rule 43bis.1** to that Office.

(c) Where the applicant has withdrawn the demand or any or all elections, the communication provided for in **paragraph (a)** shall nevertheless be effected, if the International Bureau has received the international preliminary examination report, to the elected Office or Offices affected by the withdrawal.

**EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 19 Confidentiality of the international preliminary examination

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E I 8 Request for early processing

**PCT Articles**

A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report

A.40 PCT Delaying of National Examination and Other Processing

**PCT Implementing Rules**

R.43bis PCT Written Opinion of the International Searching Authority

R.71 PCT Transmittal of the International Preliminary Examination Report

R.72 PCT Translation of the International Preliminary Examination Report and of the Written Opinion of the International Searching Authority

R.93bis PCT Manner of Communication of Documents

**PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.079 How do the applicant, the International Bureau and the elected Offices receive the international preliminary report on patentability ( Chapter II of the PCT ) and, where applicable, its translation?

PCT AG-IP 10.080 Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?

### ***R.74 PCT Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof***

#### **74.1     *Contents of Translation and Time Limit for Transmittal Thereof***

(a) Where the furnishing of a translation of the international application is required by the elected Office under **Article 39(1)**, the applicant shall, within the time limit applicable under **Article 39(1)**, transmit a translation of any replacement sheet referred to in **Rule 70.16** which is annexed to the international preliminary examination report, unless such sheet is in the language of the required translation of the international application. The same time limit shall apply where the furnishing of a translation of the international application to the elected Office must, because of a declaration made under **Article 64(2)(a)(i)**, be effected within the time limit applicable under **Article 22**.

(b) Where the furnishing under **Article 39(1)** of a translation of the international application is not required by the elected Office, that Office may require the applicant to furnish, within the time limit applicable under that Article, a translation into the language in which the international application was published of any replacement sheet referred to in **Rule 70.16** which is annexed to the international preliminary examination report and is not in that language.

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E V 3 What the translation must include

##### **PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.64 PCT \* Reservations

##### **PCT Implementing Rules**

R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

##### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

##### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.078 In what language is the international preliminary report on patentability ( Chapter II of the PCT ) established?

##### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

***R.75 PCT [Deleted]***

## A.37 PCT Withdrawal of Demand or Election

- (1) The applicant may withdraw any or all elections.
- (2) If the election of all elected States is withdrawn, the demand shall be considered withdrawn.
- (3)(a) Any withdrawal shall be notified to the International Bureau.
- (b) The elected Offices concerned and the International Preliminary Examining Authority concerned shall be notified accordingly by the International Bureau.
- (4)(a) Subject to the provisions of **subparagraph (b)**, withdrawal of the demand or of the election of a Contracting State shall, unless the national law of that State provides otherwise, be considered to be withdrawal of the international application as far as that State is concerned.
- (b) Withdrawal of the demand or of the election shall not be considered to be withdrawal of the international application if such withdrawal is effected prior to the expiration of the applicable time limit under **Article 22**; however, any Contracting State may provide in its national law that the aforesaid shall apply only if its national Office has received, within the said time limit, a copy of the international application, together with a translation (as prescribed), and the national fee.

### PCT Articles

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.38 PCT Confidential Nature of the International Preliminary Examination

### PCT Implementing Rules

R.90bis PCT Withdrawals

### PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase

PCT AG-IP 11.060 Can the applicant withdraw the demand for international preliminary examination or the election of any State?

### PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)

PCT AG-NP 2.004 When is an Office an elected Office?



## A.38 PCT Confidential Nature of the International Preliminary Examination

(1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of **Article 30(4)** to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

(2) Subject to the provisions of **paragraph (1)** and **Articles 36(1)** and **(3)** and **37(3)(b)**, neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or nonissuance of an international preliminary examination report and on the withdrawal or nonwithdrawal of the demand or of any election.

### **EPO Guidelines - A Formalities Examination**

GL A XI 2.1 Extent of file inspection

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 19 Confidentiality of the international preliminary examination

### **PCT Articles**

A.30 PCT Confidential Nature of the International Application

A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report

A.37 PCT Withdrawal of Demand or Election

A.64 PCT \* Reservations

### **PCT Implementing Rules**

R.94 PCT 11 Access to Files

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.025 Can access be gained at the International Bureau to the file of an international application?

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.002 What are the main effects of the international preliminary examination?

PCT AG-IP 10.080 Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?

PCT AG-IP 10.081 To what extent is the international preliminary examination confidential?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?

### **General Case Law**

T 1101/99 Delegation of duties to formalities examiners - rejection of file inspection not covered

T 508/01 PCT file, other than IPER, incorporatable by reference in response to Rule 51(2) EPC communication - (no) /  
[..]

## A.39 PCT Copy, Translation, and Fee, to Elected Offices

(1)(a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of **Article 22** shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under **Article 20** has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date.

(b) Any national law may, for performing the acts referred to in **subparagraph (a)**, fix time limits which expire later than the time limit provided for in that subparagraph.

(2) The effect provided for in **Article 11(3)** shall cease in the elected State with the same consequences as the withdrawal of any national application in that State if the applicant fails to perform the acts referred to in **paragraph (1)(a)** within the time limit applicable under **paragraph (1)(a)** or **(b)**.

(3) Any elected Office may maintain the effect provided for in **Article 11(3)** even where the applicant does not comply with the requirements provided for in **paragraph (1)(a)** or **(b)**.

### EPO Guidelines - C Procedural Aspects of Substantive Examination

GL C II 1.2 Euro-PCT applications

### EPO Guidelines - E General Procedural Matters

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

### EPO Guide for Applicants, part II Int. - A General Overview

GA A 7 The role of the EPO in the European phase

### EPO Guide for Applicants, part II Int. - D The EPO as an IPEA

GA D I 13 Delaying of national phase until expiry of 30 months

GA D II 18 What must be done after receipt of the IPER?

### EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office

GA E I 5 When must the European phase be initiated before the EPO as designated or elected Office?

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E II 1 Overview of the steps to be taken for entry into the European phase

GA E II 3 Further requirements

GA E V 1 When must the applicant file a translation of the Euro-PCT application?

GA E V 2 Consequences of not filing a translation of the application

GA E V 3 What the translation must include

GA E VII VII.

GA E XII 1 Missing data regarding the inventor or an applicant

### PCT Articles

A.11 PCT Filing Date and Effects of the International Application

A.20 PCT Communication to Designated Offices

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.40 PCT Delaying of National Examination and Other Processing

A.64 PCT \* Reservations

### PCT Implementing Rules

R.13bis PCT Inventions Relating to Biological Material

R.32 PCT Extension of Effects of International Application to Certain Successor States

R.74 PCT Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof

R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

R.77 PCT Faculty under Article 39(1)(b)

R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices

R.86 PCT The Gazette

R.90bis PCT Withdrawals

### PCT Appl. Guide - Int. Phase - 5. Filing an International Application

## A.39 PCT Copy, Translation, and Fee, to Elected Offices

### R.75 PCT [Deleted]

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PCT AG-IP 5.003 What are the main effects of an international application?

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.002 What are the main effects of the international preliminary examination?

PCT AG-IP 10.010 At what stage of the procedure should the demand for international preliminary examination be submitted?

PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?

PCT AG-IP 11.048 Can the applicant withdraw the international application?

PCT AG-IP 11.050 Can the applicant withdraw designations?

PCT AG-IP 11.056 Can the applicant withdraw priority claims made in the international application?

PCT AG-IP 11.092 What is the effect of an extension?

#### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.006 How does the national phase start?

#### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.002 What is the time limit for entering the national phase before an elected Office?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?

PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?

PCT AG-NP 4.008 In which case must the international application be translated?

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?

#### **Case Law with Headnote**

J 9/84 Claims fees / Claims fees/allocation of / Abandonment of claims / Claims/abandonment

J 20/89 EPO acting solely as IPEA / Appellate jurisdiction of Boards of Appeal in internat. phase (no)

#### **General Case Law**

J 22/92 Restitutio - Euro-PCT applications - EPO designated office / Restitutio - time limits - period of grace - inapplicable [...]

J 25/92 Payment of examination fee / Lack of specific written request

J 7/93 Restitutio - inapplicable time limits / EPO as designated office - time limits - communications with no legal effect

J 3/94 EPO as an elected office / Election concerning the grant of a national patent not valid for the European grant [...]

J 4/94 EPO as elected Office / Demand by the elected Office - interpretation

J 10/94 Demande de brevet européen d'origine PCT / Taxe nationale de base / Taxes de désignation / Délai de paiement / [...]

J 6/00 Withdrawal of the priority claims in the international phase / Unambiguous declaration (no) / Analogous application of [...]

J 3/01 International application / Correction of designation / Re-establishment of the right to be notified of a Rule 85a(1) [...]

J 25/01 Euro-PCT application / Correction of designation / Non payment of designation fees within the time limit

J 6/02 Correction of designation of a country / Procedural effects

J 13/03 Principle of protection of legitimate expectations / Restitutio -Euro - PCT applications - EPO designated Office

***R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices***

76.1, 76.2 and 76.3 [Deleted]

**76.4 Time Limit for Translation of Priority Document**

The applicant shall not be required to furnish to any elected Office a translation of the priority document before the expiration of the applicable time limit under **Article 39**.

**76.5 Application of Certain Rules to Procedures before Elected Offices**

**Rules 13ter.3, 20.8(c), 22.1(g), 47.1, 49, 49bis, 49ter and 51bis** shall apply, provided that:

(i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) any reference in the said Rules to **Article 22** or **Article 24(2)** shall be construed as a reference to **Article 39(1)** or **Article 39(3)**, respectively;

(iii) the words "international applications filed" in **Rule 49.1(c)** shall be replaced by the words "a demand submitted;"

(iv) for the purposes of **Article 39(1)**, where an international preliminary examination report has been established, a translation of any amendment under **Article 19** shall only be required if that amendment is annexed to that report;

(v) the reference in **Rule 47.1(a)** to **Rule 47.4** shall be construed as a reference to **Rule 61.2(d)**.

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?

GA E V 2 Consequences of not filing a translation of the application

GA E XIII XIII.

**PCT Articles**

A.19 PCT Amendment of the Claims Before the International Bureau

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.24 PCT Possible Loss of Effect in Designated States

A.39 PCT Copy, Translation, and Fee, to Elected Offices

**PCT Implementing Rules**

R.13ter PCT Nucleotide and/or Amino Acid Sequence Listings

R.20 PCT International Filing Date

R.22 PCT Transmittal of the Record Copy and Translation

R.47 PCT Communication to Designated Offices

R.49 PCT Copy, Translation and Fee under Article 22

R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

R.49ter PCT Effect of Restoration of Right of Priority by Receiving Office; Restoration of Right of Priority by Designated Office

R.51bis PCT Certain National Requirements Allowed under Article 27

R.61 PCT Notification of the Demand and Elections

**PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?

PCT AG-NP 4.008 In which case must the international application be translated?

PCT AG-NP 4.009 What is the language into which the international application must be translated?

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

PCT AG-NP 4.021 Does the translation have to contain drawings?

## A.39 PCT Copy, Translation, and Fee, to Elected Offices

### R.76 PCT Translation of Priority Document; Application of Certain Rules to Procedures before Elected Offices

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PCT AG-NP 4.022 How must the translation of text matter in drawings be presented?

PCT AG-NP 4.023 What are the physical requirements for the translation?

PCT AG-NP 4.024 In how many copies must the translation be furnished?

PCT AG-NP 4.025 Must the translation be certified?

PCT AG-NP 4.026 Must the translation be verified?

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?

PCT AG-NP 4.032 Is the use of national forms mandatory for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?

PCT AG-NP 5.003 What must be done to prove inventorship, the right to file the application or the like?

PCT AG-NP 5.006 Must the applicant be represented by an agent for the national phase?

PCT AG-NP 5.007 When and how must the agent be appointed?

PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?

***R.77 PCT Faculty under Article 39(1)(b)***

77.1 *Exercise of Faculty*

(a) Any Contracting State allowing a time limit expiring later than the time limit provided for in **Article 39(1)(a)** shall notify the International Bureau of the time limit so fixed.

(b) Any notification received by the International Bureau under **paragraph (a)** shall be promptly published by the International Bureau in the Gazette.

(c) Notifications concerning the shortening of the previously fixed time limit shall be effective in relation to demands submitted after the expiration of three months computed from the date on which the notification was published by the International Bureau.

(d) Notifications concerning the lengthening of the previously fixed time limit shall become effective upon publication by the International Bureau in the Gazette in respect of demands pending at the time or submitted after the date of such publication, or, if the Contracting State effecting the notification fixes some later date, as from the latter date.

**PCT Articles**

A.39 PCT Copy, Translation, and Fee, to Elected Offices

## A.40 PCT Delaying of National Examination and Other Processing

(1) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of **Article 23** shall not apply to such State and the national Office of or acting for that State shall not proceed, subject to the provisions of **paragraph (2)**, to the examination and other processing of the international application prior to the expiration of the applicable time limit under **Article 39**.

(2) Notwithstanding the provisions of **paragraph (1)**, any elected Office may, on the express request of the applicant, proceed to the examination and other processing of the international application at any time.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation

GL E VIII 2.5.2 Request for examination

### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 5 The role of the EPO in the international phase

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 8 Request for early processing

### **PCT Articles**

A.23 PCT Delaying of National Procedure

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.64 PCT \* Reservations

### **PCT Implementing Rules**

R.13bis PCT Inventions Relating to Biological Material

R.61 PCT Notification of the Demand and Elections

R.73 PCT Communication of the International Preliminary Examination Report or the Written Opinion of the International Searching Authority

R.90bis PCT Withdrawals

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.003 What are the main effects of an international application?

### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.002 What are the main effects of the international preliminary examination?

### **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

PCT AG-NP 2.001 What is the national phase?

PCT AG-NP 2.006 How does the national phase start?

### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.004 Can the national phase start before the expiration of the time limit for entering it?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

### **General Case Law**

J 9/83 Euro-PCT-applications - Supplementary European search report - legal nature / Examination fee - refund of (yes) - [...]

### **Case Law with Headnote**

J 1/89 Reminder concerning payment of renewal fees / Courtesy service of the EPO / Clarity and unambiguity of communications [...]

### **General Case Law**

J 6/00 Withdrawal of the priority claims in the international phase / Unambiguous declaration (no) / Analogous application of [...]

## **A.41 PCT Amendment of the Claims, the Description, and the Drawings, Before Elected Offices**

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each elected Office within the prescribed time limit. No elected Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired, except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed, unless the national law of the elected State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the elected State in all respects not provided for in this Treaty and the Regulations.

(4) Where an elected Office requires a translation of the international application, the amendments shall be in the language of the translation.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E IV 3 Amending the application – Rule 161 EPC/Rule 162 EPC communication

### **PCT Implementing Rules**

R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.111 Can the description be amended during the international phase?

PCT AG-IP 5.127 Can the claims be amended during the international phase?

PCT AG-IP 5.162 Can the drawings be amended during the international phase?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?



***R.78 PCT Amendment of the Claims, the Description, and the Drawings, before Elected Offices***

78.1 *Time Limit*

(a) The applicant shall, if he so wishes, exercise the right under **Article 41** to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfillment of the requirements under **Article 39(1)(a)**, provided that, if the transmittal of the international preliminary examination report under **Article 36(1)** has not taken place by the expiration of the time limit applicable under **Article 39**, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any later time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under **Article 41** shall be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under **paragraph (a)**.

78.2 *[Deleted]*

78.3 *Utility Models*

The provisions of **Rules 6.5** and **13.5** shall apply, *mutatis mutandis*, before elected Offices. If the election was made before the expiration of the 19th month from the priority date, the reference to the time limit applicable under **Article 22** is replaced by a reference to the time limit applicable under **Article 39**.

**EPO Guidelines - E General Procedural Matters**

GL E VIII 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E IV 3 Amending the application – Rule 161 EPC/Rule 162 EPC communication

**PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.36 PCT Transmittal, Translation, and Communication, of the International Preliminary Examination Report

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.41 PCT Amendment of the Claims, the Description, and the Drawings, Before Elected Offices

**PCT Implementing Rules**

R.6 PCT The Claims

R.13 PCT Unity of Invention

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.111 Can the description be amended during the international phase?

**PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.013 May the applicant amend the international application for the national phase?

## **A.42 PCT Results of National Examination in Elected Offices**

No elected Office receiving the international preliminary examination report may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected Office.

### **EPO Guidelines - E General Procedural Matters**

GL E VIII 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

#### **General Case Law**

T 508/01 PCT file, other than IPER, incorporatable by reference in response to Rule 51(2) EPC communication - (no) /  
[..]

## A.43 PCT Seeking Certain Kinds of Protection

In respect of any designated or elected State whose law provides for the grant of inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, or utility certificates of addition, the applicant may indicate, as prescribed in the Regulations, that his international application is for the grant, as far as that State is concerned, of an inventor's certificate, a utility certificate, or a utility model, rather than a patent, or that it is for the grant of a patent or certificate of addition, an inventor's certificate of addition, or a utility certificate of addition, and the ensuing effect shall be governed by the applicant's choice. For the purposes of this Article and any Rule thereunder, **Article 2(ii)** shall not apply.

### **PCT Articles**

A.2 PCT Definitions

A.4 PCT The Request

A.44 PCT Seeking Two Kinds of Protection

### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.052 What is the designation of States?

PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

## A.44 PCT Seeking Two Kinds of Protection

In respect of any designated or elected State whose law permits an application, while being for the grant of a patent or one of the other kinds of protection referred to in **Article 43**, to be also for the grant of another of the said kinds of protection, the applicant may indicate, as prescribed in the Regulations, the two kinds of protection he is seeking, and the ensuing effect shall be governed by the applicant's indications. For the purposes of this Article, **Article 2(ii)** shall not apply.

### **PCT Articles**

A.2 PCT Definitions

A.43 PCT Seeking Certain Kinds of Protection

### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.49bis PCT Indications as to Protection Sought for Purposes of National Processing

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.052 What is the designation of States?

PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

## A.45 PCT Regional Patent Treaties

(1) Any treaty providing for the grant of regional patents ("regional patent treaty"), and giving to all persons who, according to **Article 9**, are entitled to file international applications the right to file applications for such patents, may provide that international applications designating or electing a State party to both the regional patent treaty and the present Treaty may be filed as applications for such patents.

(2) The national law of the said designated or elected State may provide that any designation or election of such State in the international application shall have the effect of an indication of the wish to obtain a regional patent under the regional patent treaty.

### **EPC Articles**

Preamble

### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 6 Euro-PCT application

GA A 8 Contracting states to the PCT and the EPC

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 30 Non-designation for reasons of national law

### **PCT Articles**

A.9 PCT The Applicant

### **PCT Implementing Rules**

R.4 PCT The Request (Contents)

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.052 What is the designation of States?

### **General Case Law**

J 19/93 -

## **A.46 PCT Incorrect Translation of the International Application**

If, because of an incorrect translation of the international application, the scope of any patent granted on that application exceeds the scope of the international application in its original language, the competent authorities of the Contracting State concerned may accordingly and retroactively limit the scope of the patent, and declare it null and void to the extent that its scope has exceeded the scope of the international application in its original language.

### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.002 May the applicant correct errors in the translation of the international application?

## A.47 PCT Time Limits

(1) The details for computing time limits referred to in this Treaty are governed by the Regulations.

(2)(a) All time limits fixed in **Chapters I** and **II** of this Treaty may, outside any revision under **Article 60**, be modified by a decision of the Contracting States.

(b) Such decisions shall be made in the Assembly or through voting by correspondence and must be unanimous.

(c) The details of the procedure are governed by the Regulations.

### **PCT Articles**

A.3 PCT The International Application

A.31 PCT Demand for International Preliminary Examination

A.53 PCT Assembly

A.60 PCT Revision of the Treaty

### **PCT Implementing Rules**

R.81 PCT Modification of Time Limits Fixed in the Treaty

***R.79 PCT Calendar***

79.1 *Expressing Dates*

Applicants, national Offices, receiving Offices, International Searching and Preliminary Examining Authorities, and the International Bureau, shall, for the purposes of the Treaty and the Regulations, express any date in terms of the Christian era and the Gregorian calendar, or, if they use other eras and calendars, they shall also express any date in terms of the Christian era and the Gregorian calendar.



***R.80 PCT Computation of Time Limits*****80.1**     *Periods Expressed in Years*

When a period is expressed as one year or a certain number of years, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

**80.2**     *Periods Expressed in Months*

When a period is expressed as one month or a certain number of months, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

**80.3**     *Periods Expressed in Days*

When a period is expressed as a certain number of days, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire on the day on which the last day of the count has been reached.

**80.4**     *Local Dates*

(a) The date which is taken into consideration as the starting date of the computation of any period shall be the date which prevails in the locality at the time when the relevant event occurred.

(b) The date on which any period expires shall be the date which prevails in the locality in which the required document must be filed or the required fee must be paid.

**80.5**     *Expiration on a Non-Working Day or Official Holiday*

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:

(i) on which such Office or organization is not open to the public for the purposes of the transaction of official business;

(ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;

(iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or

(iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day;

the period shall expire on the next subsequent day on which none of the said four circumstances exists.

#### 80.6 *Date of Documents*

Where a period starts on the day of the date of a document or letter emanating from a national Office or intergovernmental organization, any interested party may prove that the said document or letter was mailed on a day later than the date it bears, in which case the date of actual mailing shall, for the purposes of computing the period, be considered to be the date on which the period starts. Irrespective of the date on which such a document or letter was mailed, if the applicant offers to the national Office or intergovernmental organization evidence which satisfies the national Office or intergovernmental organization that the document or letter was received more than seven days after the date it bears, the national Office or intergovernmental organization shall treat the period starting from the date of the document or letter as expiring later by an additional number of days which is equal to the number of days which the document or letter was received later than seven days after the date it bears.

#### 80.7 *End of Working Day*

(a) A period expiring on a given day shall expire at the moment the national Office or intergovernmental organization with which the document must be filed or to which the fee must be paid closes for business on that day.

(b) Any Office or organization may depart from the provisions of **paragraph (a)** up to midnight on the relevant day.

#### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 10 Computation of time limits in the international phase

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 33 Restoration of priority right

#### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E I 5 When must the European phase be initiated before the EPO as designated or elected Office?

#### **PCT Implementing Rules**

R.2 PCT Interpretation of Certain Words

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.028 When is the indication of a telephone number, a facsimile number or an e-mail address recommended?

PCT AG-IP 5.059 What does "priority period" mean?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.017 How can the applicant receive notifications via e-mail?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.018\_a How can the applicant receive notifications via e-mail?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.062 What are the rules concerning the computation of time limits?

***R.81 PCT Modification of Time Limits Fixed in the Treaty***

81.1 *Proposal*

- (a) Any Contracting State or the Director General may propose a modification under **Article 47(2)**.
- (b) Proposals made by a Contracting State shall be presented to the Director General.

81.2 *Decision by the Assembly*

- (a) When the proposal is made to the Assembly, its text shall be sent by the Director General to all Contracting States at least two months in advance of that session of the Assembly whose agenda includes the proposal.
- (b) During the discussion of the proposal in the Assembly, the proposal may be amended or consequential amendments proposed.
- (c) The proposal shall be considered adopted if none of the Contracting States present at the time of voting votes against the proposal.

81.3 *Voting by Correspondence*

- (a) When voting by correspondence is chosen, the proposal shall be included in a written communication from the Director General to the Contracting States, inviting them to express their vote in writing.
- (b) The invitation shall fix the time limit within which the reply containing the vote expressed in writing must reach the International Bureau. That time limit shall not be less than three months from the date of the invitation.
- (c) Replies must be either positive or negative. Proposals for amendments or mere observations shall not be regarded as votes.
- (d) The proposal shall be considered adopted if none of the Contracting States opposes the amendment and if at least one-half of the Contracting States express either approval or indifference or abstention.

**PCT Articles**

A.47 PCT Time Limits

**PCT Implementing Rules**

R.88 PCT Amendment of the Regulations

## A.48 PCT Delay in Meeting Certain Time Limits

(1) Where any time limit fixed in this Treaty or the Regulations is not met because of interruption in the mail service or unavoidable loss or delay in the mail, the time limit shall be deemed to be met in the cases and subject to the proof and other conditions prescribed in the Regulations.

(2)(a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.

(b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in **subparagraph (a)**, any delay in meeting any time limit.

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 9 Loss or delay in the post

### **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XIV XIV.

### **PCT Articles**

A.25 PCT Review by Designated Offices

### **PCT Implementing Rules**

R.82bis PCT Excuse by the Designated or Elected State of Delays in Meeting Certain Time Limits

### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.056 Can failure to meet a time limit in the proceedings before the receiving Office or a delay in furnishing documents to that Office be excused?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.063 Can a delay or loss in the mail be excused?

### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?

### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.021 What may be the result of a review by the designated Office?

PCT AG-NP 6.022 Can a delay in meeting a time limit be excused?

PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?

PCT AG-NP 6.025 What must be done by the applicant who has exceeded a time limit?

PCT AG-NP 6.027 Must the late arrival of a document caused by irregularities in the mail service be excused?

### **Case Law with Headnote**

J 5/80 Restitutio in integrum / Due care on the part of the professional representative / Due care on the part of the [...]

J 20/89 EPO acting solely as IPEA / Appellate jurisdiction of Boards of Appeal in internat. phase (no)

J 2/92 Correction of particulars after publication / Errors of transcription - interest of third parties - apparent [...]

### **General Case Law**

J 22/92 Restitutio - Euro-PCT applications - EPO designated office / Restitutio - time limits - period of grace - inapplicable [...]

J 11/93 Notifications to applicants / Authorised representative / Appointment of European professional representative

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

J 13/03 Principle of protection of legitimate expectations / Restitutio -Euro - PCT applications - EPO designated Office

### **Case Law with Headnote**

T 227/97 Request for re-establishment of rights - admissible (yes) - loss of rights / Remittal

W 4/87 Fees (additional) paid within the prescribed time limit / Late submission of protest / Protest - late submission

## ***R.82 PCT Irregularities in the Mail Service***

### **82.1     *Delay or Loss in Mail***

(a) Any interested party may offer evidence that he has mailed the document or letter five days prior to the expiration of the time limit. Except in cases where surface mail normally arrives at its destination within two days of mailing, or where no airmail service is available, such evidence may be offered only if the mailing was by airmail. In any case, evidence may be offered only if the mailing was by mail registered by the postal authorities.

(b) If the mailing, in accordance with **paragraph (a)**, of a document or letter is proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, or, if the document or letter is lost in the mail, substitution for it of a new copy shall be permitted, provided that the interested party proves to the satisfaction of the said Office or organization that the document or letter offered in substitution is identical with the document or letter lost.

(c) In the cases provided for in **paragraph (b)**, evidence of mailing within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within one month after the date on which the interested party noticed—or with due diligence should have noticed—the delay or the loss, and in no case later than six months after the expiration of the time limit applicable in the given case.

(d) Any national Office or intergovernmental organization which has notified the International Bureau that it will do so shall, where a delivery service other than the postal authorities is used to mail a document or letter, apply the provisions of **paragraphs (a) to (c)** as if the delivery service was a postal authority. In such a case, the last sentence of **paragraph (a)** shall not apply but evidence may be offered only if details of the mailing were recorded by the delivery service at the time of mailing. The notification may contain an indication that it applies only to mailings using specified delivery services or delivery services which satisfy specified criteria. The International Bureau shall publish the information so notified in the Gazette.

(e) Any national Office or intergovernmental organization may proceed under **paragraph (d)**:

(i) even if, where applicable, the delivery service used was not one of those specified, or did not satisfy the criteria specified, in the relevant notification under **paragraph (d)**, or

(ii) even if that Office or organization has not sent to the International Bureau a notification under **paragraph (d)**.

### **82.2     *Interruption in the Mail Service***

(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.

(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within

## A.48 PCT Delay in Meeting Certain Time Limits

### R.82 PCT Irregularities in the Mail Service

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five days after the mail service was resumed. The provisions of **Rule 82.1(c)** shall apply *mutatis mutandis*.

#### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 9 Loss or delay in the post

GA B 33 Restoration of priority right

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.063 Can a delay or loss in the mail be excused?

PCT AG-IP 11.064 Can a delay or loss be excused where a delivery service is used?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.027 Must the late arrival of a document caused by irregularities in the mail service be excused?

## A.48 PCT Delay in Meeting Certain Time Limits

### R.82bis PCT Excuse by the Designated or Elected State of Delays in Meeting Certain Time Limits

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#### ***R.82bis PCT Excuse by the Designated or Elected State of Delays in Meeting Certain Time Limits***

##### **82bis.1**     *Meaning of "Time Limit" in Article 48(2)*

The reference to "any time limit" in **Article 48(2)** shall be construed as comprising a reference:

- (i) to any time limit fixed in the Treaty or these Regulations;
- (ii) to any time limit fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau or applicable by the receiving Office under its national law;
- (iii) to any time limit fixed by, or in the national law applicable by, the designated or elected Office, for the performance of any act by the applicant before that Office.

##### **82bis.2**     *Reinstatement of Rights and Other Provisions to Which Article 48(2) Applies*

The provisions of the national law which is referred to in **Article 48(2)** concerning the excusing, by the designated or elected State, of any delay in meeting any time limit are those provisions which provide for reinstatement of rights, restoration, *restitutio in integrum* or further processing in spite of non-compliance with a time limit, and any other provision providing for the extension of time limits or for excusing delays in meeting time limits.

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**  
GA E XIV XIV.

#### **PCT Articles**

A.48 PCT Delay in Meeting Certain Time Limits

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.056 Can failure to meet a time limit in the proceedings before the receiving Office or a delay in furnishing documents to that Office be excused?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.022 Can a delay in meeting a time limit be excused?

PCT AG-NP 6.023 In respect of which time limits may delays be excused?

PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?

***R.82ter PCT Rectification of Errors Made by the Receiving Office or by the International Bureau***

**82ter.1** *Errors Concerning the International Filing Date and the Priority Claim*

(a) If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered void by the receiving Office or the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered void.

(b) Where the international filing date has been accorded by the receiving Office under **Rule 20.3(b)(ii)** or **20.5(d)** on the basis of the incorporation by reference under **Rules 4.18** and **20.6** of an element or part but the designated or elected Office finds that:

(i) the applicant has not complied with **Rule 17.1(a)**, **(b)** or **(b-bis)** in relation to the priority document;

(ii) a requirement under **Rule 4.18**, **20.6(a)(i)** or **51bis.1(e)(ii)** has not been complied with; or

(iii) the element or part is not completely contained in the priority document concerned;

the designated or elected Office may, subject to **paragraph (c)**, treat the international application as if the international filing date had been accorded under **Rule 20.3(b)(i)** or **20.5(b)**, or corrected under **Rule 20.5(c)**, as applicable, provided that **Rule 17.1(c)** shall apply *mutatis mutandis*.

(c) The designated or elected Office shall not treat the international application under **paragraph (b)** as if the international filing date had been accorded under **Rule 20.3(b)(i)** or **20.5(b)**, or corrected under **Rule 20.5(c)**, without giving the applicant the opportunity to make observations on the intended treatment, or to make a request under **paragraph (d)**, within a time limit which shall be reasonable under the circumstances.

(d) Where the designated or elected Office, in accordance with **paragraph (c)**, has notified the applicant that it intends to treat the international application as if the international filing date had been corrected under **Rule 20.5(c)**, the applicant may, in a notice submitted to that Office within the time limit referred to in **paragraph (c)**, request that the missing part concerned be disregarded for the purposes of national processing before that Office, in which case that part shall be considered not to have been furnished and that Office shall not treat the international application as if the international filing date had been corrected.

**EPO Guidelines - B Search**

GL B XI 2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT

**EPO Guidelines - C Procedural Aspects of Substantive Examination**

GL C III 1 Missing drawings or parts of the description filed under Rule 56 or claims filed after accordance of a date of filing

**EPO Guidelines - H Amendments and Corrections**

GL H IV 2.3.2 Missing parts of the description or missing drawings filed after the date of filing

**EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

GA E XIV XIV.

**PCT Implementing Rules**

R.4 PCT The Request (Contents)

R.17 PCT The Priority Document

R.20 PCT International Filing Date



## A.48 PCT Delay in Meeting Certain Time Limits

### R.82ter PCT Rectification of Errors Made by the Receiving Office or by the International Bureau

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R.51bis PCT Certain National Requirements Allowed under Article 27

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.012 Can an international filing date once accorded be “taken away”?

PCT AG-IP 6.031 What are the effects of the successful incorporation of missing elements or parts on designated or elected Offices?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.012 Will pages which have been accepted as incorporated by reference by the receiving Office be accepted by the designated or elected Office?

PCT AG-NP 6.028 Which errors made by the receiving Office or the International Bureau may be rectified?

## A.49 PCT Right to Practice Before International Authorities

Any attorney, patent agent, or other person, having the right to practice before the national Office with which the international application was filed, shall be entitled to practice before the International Bureau and the competent International Searching Authority and competent International Preliminary Examining Authority in respect of that application.

### **EPO Guide for Applicants, part II Int. - A General Overview**

GA A 5 The role of the EPO in the international phase

GA A 9 Representation in the international phase

### **EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 22 Representation in the procedure before the EPO as receiving Office

GA B 28 Appointment of an agent for the European phase with the EPO as receiving Office

### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 9 Representation before the EPO as ISA

GA C IV 4 Representation before the EPO as SISA

### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 19 Representation

### **PCT Implementing Rules**

R.83 PCT Right to Practice before International Authorities

### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.041 Does the applicant have to be represented by an agent before the receiving Office, the International Bureau and other International Authorities under the PCT?

PCT AG-IP 5.042 Who may be appointed to act as an agent?

### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.020 May the applicant be represented by an agent before the International Preliminary Examining Authority?

### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.002 Who may be appointed as an agent?

### **General Case Law**

J 23/88 Interruption of proceedings by legal incapacity of a representative from outside the Contracting States (allowed)

J 5/04 Absence de mandataire désigné pour la phase régionale PCT - Signification régulière au premier déposant / [...]

### ***R.83 PCT Right to Practice before International Authorities***

#### **83.1     *Proof of Right***

The International Bureau, the competent International Searching Authority, and the competent International Preliminary Examining Authority, may require the production of proof of the right to practice referred to in **Article 49**.

#### **83.1bis     *Where the International Bureau Is the Receiving Office***

(a) Any person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant or, if there are two or more applicants, any of the applicants is a resident or national shall be entitled to practice in respect of the international application before the International Bureau in its capacity as receiving Office under **Rule 19.1(a)(iii)**.

(b) Any person having the right to practice before the International Bureau in its capacity as receiving Office in respect of an international application shall be entitled to practice in respect of that application before the International Bureau in any other capacity and before the competent International Searching Authority and competent International Preliminary Examining Authority.

#### **83.2     *Information***

(a) The national Office or the intergovernmental organization which the interested person is alleged to have a right to practice before shall, upon request, inform the International Bureau, the competent International Searching Authority, or the competent International Preliminary Examining Authority, whether such person has the right to practice before it.

(b) Such information shall be binding upon the International Bureau, the International Searching Authority, or the International Preliminary Examining Authority, as the case may be.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 9 Representation before the EPO as ISA

GA C IV 4 Representation before the EPO as SISA

#### **PCT Articles**

A.49 PCT Right to Practice Before International Authorities

#### **PCT Implementing Rules**

R.19 PCT The Competent Receiving Office

#### **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.042 Who may be appointed to act as an agent?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.002 Who may be appointed as an agent?

## A.50 PCT Patent Information Services

- (1) The International Bureau may furnish services by providing technical and any other pertinent information available to it on the basis of published documents, primarily patents and published applications (referred to in this Article as "the information services").
- (2) The International Bureau may provide these information services either directly or through one or more International Searching Authorities or other national or international specialized institutions, with which the International Bureau may reach agreement.
- (3) The information services shall be operated in a way particularly facilitating the acquisition by Contracting States which are developing countries of technical knowledge and technology, including available published know-how.
- (4) The information services shall be available to Governments of Contracting States and their nationals and residents. The Assembly may decide to make these services available also to others.
- (5)(a) Any service to Governments of Contracting States shall be furnished at cost, provided that, when the Government is that of a Contracting State which is a developing country, the service shall be furnished below cost if the difference can be covered from profit made on services furnished to others than Governments of Contracting States or from the sources referred to in **Article 51(4)**.
- (b) The cost referred to in **subparagraph (a)** is to be understood as cost over and above costs normally incident to the performance of the services of a national Office or the obligations of an International Searching Authority.
- (6) The details concerning the implementation of the provisions of this Article shall be governed by decisions of the Assembly and, within the limits to be fixed by the Assembly, such working groups as the Assembly may set up for that purpose.
- (7) The Assembly shall, when it considers it necessary, recommend methods of providing financing supplementary to those referred to in **paragraph (5)**.

### PCT Articles

#### A.51 PCT Technical Assistance

## **A.51 PCT Technical Assistance**

(1) The Assembly shall establish a Committee for Technical Assistance (referred to in this Article as "the Committee").

(2)(a) The members of the Committee shall be elected among the Contracting States, with due regard to the representation of developing countries.

(b) The Director General shall, on his own initiative or at the request of the Committee, invite representatives of intergovernmental organizations concerned with technical assistance to developing countries to participate in the work of the Committee.

(3)(a) The task of the Committee shall be to organize and supervise technical assistance for Contracting States which are developing countries in developing their patent systems individually or on a regional basis.

(b) The technical assistance shall comprise, among other things, the training of specialists, the loaning of experts, and the supply of equipment both for demonstration and for operational purposes.

(4) The International Bureau shall seek to enter into agreements, on the one hand, with international financing organizations and intergovernmental organizations, particularly the United Nations, the agencies of the United Nations, and the Specialized Agencies connected with the United Nations concerned with technical assistance, and, on the other hand, with the Governments of the States receiving the technical assistance, for the financing of projects pursuant to this Article.

(5) The details concerning the implementation of the provisions of this Article shall be governed by decisions of the Assembly and, within the limits to be fixed by the Assembly, such working groups as the Assembly may set up for that purpose.

### **PCT Articles**

A.50 PCT Patent Information Services

## **A.52 PCT Relations with Other Provisions of the Treaty**

Nothing in this Chapter shall affect the financial provisions contained in any other Chapter of this Treaty. Such provisions are not applicable to the present Chapter or to its implementation.

## A.53 PCT Assembly

- (1)(a) The Assembly shall, subject to **Article 57(8)**, consist of the Contracting States.
- (b) The Government of each Contracting State shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
- (2)(a) The Assembly shall:
- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Treaty;
  - (ii) perform such tasks as are specifically assigned to it under other provisions of this Treaty;
  - (iii) give directions to the International Bureau concerning the preparation for revision conferences;
  - (iv) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;
  - (v) review and approve the reports and activities of the Executive Committee established under **paragraph (9)**, and give instructions to such Committee;
  - (vi) determine the program and adopt the triennial\* budget of the Union, and approve its final accounts;
  - (vii) adopt the financial regulations of the Union;
  - (viii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;
  - (ix) determine which States other than Contracting States and, subject to the provisions of **paragraph (8)**, which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
  - (x) take any other appropriate action designed to further the objectives of the Union and perform such other functions as are appropriate under this Treaty.
- (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.
- (3) A delegate may represent, and vote in the name of, one State only.
- (4) Each Contracting State shall have one vote.
- (5)(a) One-half of the Contracting States shall constitute a quorum.

(b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence as provided in the Regulations.

(6)(a) Subject to the provisions of **Articles 47(2)(b), 58(2)(b), 58(3) and 61(2)(b)**, the decisions of the Assembly shall require two-thirds of the votes cast.

(b) Abstentions shall not be considered as votes.

(7) In connection with matters of exclusive interest to States bound by **Chapter II**, any reference to Contracting States in **paragraphs (4), (5), and (6)**, shall be considered as applying only to States bound by **Chapter II**.

(8) Any intergovernmental organization appointed as International Searching or Preliminary Examining Authority shall be admitted as observer to the Assembly.

(9) When the number of Contracting States exceeds forty, the Assembly shall establish an Executive Committee. Any reference to the Executive Committee in this Treaty and the Regulations shall be construed as references to such Committee once it has been established.

(10) Until the Executive Committee has been established, the Assembly shall approve, within the limits of the program and triennial<sup>\*</sup> budget, the annual programs and budgets prepared by the Director General.

(11)(a) The Assembly shall meet in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee, or at the request of one-fourth of the Contracting States.

(12) The Assembly shall adopt its own rules of procedure.

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<sup>\*</sup> *Editor's Note:* Since 1980, the program and budget of the Union have been biennial.

#### **PCT Articles**

A.31 PCT Demand for International Preliminary Examination

A.47 PCT Time Limits

A.57 PCT Finances

A.58 PCT Regulations

A.60 PCT Revision of the Treaty

A.61 PCT Amendment of Certain Provisions of the Treaty

#### **PCT Implementing Rules**

R.85 PCT Absence of Quorum in the Assembly



## A.54 PCT Executive Committee

- (1) When the Assembly has established an Executive Committee, that Committee shall be subject to the provisions set forth hereinafter.
- (2)(a) The Executive Committee shall, subject to **Article 57(8)**, consist of States elected by the Assembly from among States members of the Assembly.
- (b) The Government of each State member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
- (3) The number of States members of the Executive Committee shall correspond to one-fourth of the number of States members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.
- (4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution.
- (5)(a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.
- (b) Members of the Executive Committee may be re-elected but only up to a maximum of two-thirds of such members.
- (c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.
- (6)(a) The Executive Committee shall:
- (i) prepare the draft agenda of the Assembly;
  - (ii) submit proposals to the Assembly in respect of the draft program and biennial budget of the Union prepared by the Director General;
  - (iii) *[deleted]*
  - (iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director General and the yearly audit reports on the accounts;
  - (v) take all necessary measures to ensure the execution of the program of the Union by the Director General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly;
  - (vi) perform such other functions as are allocated to it under this Treaty.
- (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(7)(a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization.

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative or at the request of its Chairman or one-fourth of its members.

(8)(a) Each State member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum.

(c) Decisions shall be made by a simple majority of the votes cast.

(d) Abstentions shall not be considered as votes.

(e) A delegate may represent, and vote in the name of, one State only.

(9) Contracting States not members of the Executive Committee shall be admitted to its meetings as observers, as well as any intergovernmental organization appointed as International Searching or Preliminary Examining Authority.

(10) The Executive Committee shall adopt its own rules of procedure.

**PCT Articles**

A.57 PCT Finances

A.60 PCT Revision of the Treaty

A.61 PCT Amendment of Certain Provisions of the Treaty

## **A.55 PCT International Bureau**

- (1) Administrative tasks concerning the Union shall be performed by the International Bureau.
- (2) The International Bureau shall provide the secretariat of the various organs of the Union.
- (3) The Director General shall be the chief executive of the Union and shall represent the Union.
- (4) The International Bureau shall publish a Gazette and other publications provided for by the Regulations or required by the Assembly.
- (5) The Regulations shall specify the services that national Offices shall perform in order to assist the International Bureau and the International Searching and Preliminary Examining Authorities in carrying out their tasks under this Treaty.
- (6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee and any other committee or working group established under this Treaty or the Regulations. The Director General, or a staff member designated by him, shall be *ex officio* secretary of these bodies.
- (7)(a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the revision conferences.
  - (b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for revision conferences.
  - (c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at revision conferences.
- (8) The International Bureau shall carry out any other tasks assigned to it.

### **PCT Articles**

A.60 PCT Revision of the Treaty

A.61 PCT Amendment of Certain Provisions of the Treaty

### **PCT Implementing Rules**

R.86 PCT The Gazette

## A.56 PCT Committee for Technical Cooperation

- (1) The Assembly shall establish a Committee for Technical Cooperation (referred to in this Article as "the Committee").
- (2)(a) The Assembly shall determine the composition of the Committee and appoint its members, with due regard to an equitable representation of developing countries.
- (b) The International Searching and Preliminary Examining Authorities shall be *ex officio* members of the Committee. In the case where such an Authority is the national Office of a Contracting State, that State shall not be additionally represented on the Committee.
- (c) If the number of Contracting States so allows, the total number of members of the Committee shall be more than double the number of *ex officio* members.
- (d) The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested organizations to participate in discussions of interest to them.
- (3) The aim of the Committee shall be to contribute, by advice and recommendations:
- (i) to the constant improvement of the services provided for under this Treaty,
  - (ii) to the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports, and
  - (iii) on the initiative of the Assembly or the Executive Committee, to the solution of the technical problems specifically involved in the establishment of a single International Searching Authority.
- (4) Any Contracting State and any interested international organization may approach the Committee in writing on questions which fall within the competence of the Committee.
- (5) The Committee may address its advice and recommendations to the Director General or, through him, to the Assembly, the Executive Committee, all or some of the International Searching and Preliminary Examining Authorities, and all or some of the receiving Offices.
- (6)(a) In any case, the Director General shall transmit to the Executive Committee the texts of all the advice and recommendations of the Committee. He may comment on such texts.
- (b) The Executive Committee may express its views on any advice, recommendation, or other activity of the Committee, and may invite the Committee to study and report on questions falling within its competence. The Executive Committee may submit to the Assembly, with appropriate comments, the advice, recommendations and report of the Committee.
- (7) Until the Executive Committee has been established, references in **paragraph (6)** to the Executive Committee shall be construed as references to the Assembly.

(8) The details of the procedure of the Committee shall be governed by the decisions of the Assembly.

**PCT Articles**

A.16 PCT The International Searching Authority

A.60 PCT Revision of the Treaty

A.61 PCT Amendment of Certain Provisions of the Treaty

## A.57 PCT Finances

(1)(a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union and its contribution to the budget of expenses common to the Unions administered by the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) Subject to the provisions of **paragraph (5)**, the budget of the Union shall be financed from the following sources:

(i) fees and charges due for services rendered by the International Bureau in relation to the Union;

(ii) sale of, or royalties on, the publications of the International Bureau concerning the Union;

(iii) gifts, bequests, and subventions;

(iv) rents, interests, and other miscellaneous income.

(4) The amounts of fees and charges due to the International Bureau and the prices of its publications shall be so fixed that they should, under normal circumstances, be sufficient to cover all the expenses of the International Bureau connected with the administration of this Treaty.

(5)(a) Should any financial year close with a deficit, the Contracting States shall, subject to the provisions of **subparagraphs (b) and (c)**, pay contributions to cover such deficit.

(b) The amount of the contribution of each Contracting State shall be decided by the Assembly with due regard to the number of international applications which has emanated from each of them in the relevant year.

(c) If other means of provisionally covering any deficit or any part thereof are secured, the Assembly may decide that such deficit be carried forward and that the Contracting States should not be asked to pay contributions.

(d) If the financial situation of the Union so permits, the Assembly may decide that any contributions paid under **subparagraph (a)** be reimbursed to the Contracting States which have paid them.

(e) A Contracting State which has not paid, within two years of the due date as established by the Assembly, its contribution under **subparagraph (b)** may not exercise its right to vote in any of the organs of the Union. However, any organ of the Union may allow such a State to continue to exercise its right to vote in that organ so long as it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(6) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(7)(a) The Union shall have a working capital fund which shall be constituted by a single payment made by each Contracting State. If the fund becomes insufficient, the Assembly shall arrange to increase it. If part of the fund is no longer needed, it shall be reimbursed.

(b) The amount of the initial payment of each Contracting State to the said fund or of its participation in the increase thereof shall be decided by the Assembly on the basis of principles similar to those provided for under **paragraph (5)(b)**.

(c) The terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(d) Any reimbursement shall be proportionate to the amounts paid by each Contracting State, taking into account the dates at which they were paid.

(8)(a) In the headquarters agreement concluded with the State on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such State shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such State and the Organization. As long as it remains under the obligation to grant advances, such State shall have an *ex officio* seat in the Assembly and on the Executive Committee.

(b) The State referred to in **subparagraph (a)** and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(9) The auditing of the accounts shall be effected by one or more of the Contracting States or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

#### **PCT Articles**

A.53 PCT Assembly

A.54 PCT Executive Committee

A.60 PCT Revision of the Treaty

A.61 PCT Amendment of Certain Provisions of the Treaty

## A.58 PCT Regulations

(1) The Regulations annexed to this Treaty provide Rules:

(i) concerning matters in respect of which this Treaty expressly refers to the Regulations or expressly provides that they are or shall be prescribed,

(ii) concerning any administrative requirements, matters, or procedures,

(iii) concerning any details useful in the implementation of the provisions of this Treaty.

(2)(a) The Assembly may amend the Regulations.

(b) Subject to the provisions of **paragraph (3)**, amendments shall require three-fourths of the votes cast.

(3)(a) The Regulations specify the Rules which may be amended

(i) only by unanimous consent, or

(ii) only if none of the Contracting States whose national Office acts as an International Searching or Preliminary Examining Authority dissents, and, where such Authority is an intergovernmental organization, if the Contracting State member of that organization authorized for that purpose by the other member States within the competent body of such organization does not dissent.

(b) Exclusion, for the future, of any such Rules from the applicable requirement shall require the fulfillment of the conditions referred to in **subparagraph (a)(i)** or **(a)(ii)**, respectively.

(c) Inclusion, for the future, of any Rule in one or the other of the requirements referred to in **subparagraph (a)** shall require unanimous consent.

(4) The Regulations provide for the establishment, under the control of the Assembly, of Administrative Instructions by the Director General.

(5) In the case of conflict between the provisions of the Treaty and those of the Regulations, the provisions of the Treaty shall prevail.

### PCT Articles

A.53 PCT Assembly

### PCT Implementing Rules

R.88 PCT Amendment of the Regulations



***R.84 PCT Expenses of Delegations***

84.1 *Expenses Borne by Governments*

The expenses of each Delegation participating in any organ established by or under the Treaty shall be borne by the Government which has appointed it.

***R.85 PCT Absence of Quorum in the Assembly***

85.1 *Voting by Correspondence*

In the case provided for in **Article 53(5)(b)**, the International Bureau shall communicate the decisions of the Assembly (other than those concerning the Assembly's own procedure) to the Contracting States which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of that period, the number of Contracting States having thus expressed their vote or abstention attains the number of Contracting States which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

**PCT Articles**

A.53 PCT Assembly

## ***R.86 PCT The Gazette***

### **86.1**     *Contents*

The Gazette referred to in **Article 55(4)** shall contain:

- (i) for each published international application, the data specified by the Administrative Instructions taken from the front page of the publication of the international application, the drawing (if any) appearing on the said front page, and the abstract;
- (ii) the schedule of all fees payable to the receiving Offices, the International Bureau, and the International Searching and Preliminary Examining Authorities;
- (iii) notices the publication of which is required under the Treaty or these Regulations;
- (iv) information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in **Articles 22** or **39** have been complied with in respect of the international applications designating or electing the Office concerned;
- (v) any other useful information prescribed by the Administrative Instructions, provided access to such information is not prohibited under the Treaty or these Regulations.

### **86.2**     *Languages; Form and Means of Publication; Timing*

- (a) The Gazette shall be published in English and French at the same time. The translations shall be ensured by the International Bureau in English and French.
- (b) The Assembly may order the publication of the Gazette in languages other than those referred to in **paragraph (a)**.
- (c) The form in which and the means by which the Gazette is published shall be governed by the Administrative Instructions.
- (d) The International Bureau shall ensure that, for each published international application, the information referred to in **Rule 86.1(i)** is published in the Gazette on, or as soon as possible after, the date of publication of the international application.

### **86.3**     *Frequency*

The frequency of publication of the Gazette shall be determined by the Director General.

### **86.4**     *Sale*

The subscription and other sale prices of the Gazette shall be determined by the Director General.

### **86.5**     *Title*

The title of the Gazette shall be determined by the Director General.

### **86.6**     *Further Details*

## A.58 PCT Regulations

### R.86 PCT The Gazette

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Further details concerning the Gazette may be provided for in the Administrative Instructions.

#### **PCT Articles**

A.22 PCT Copy, Translation, and Fee, to Designated Offices

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.55 PCT International Bureau

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.015 What constitutes international publication?

PCT AG-IP 9.017 In what language is the international application published?

PCT AG-IP 9.021 How can copies of the published international application be obtained?

PCT AG-IP 9.022 How can the published international application in electronic form be accessed?

***R.87 PCT Communication of Publications***

87.1 *Communication of Publications on Request*

The International Bureau shall communicate, free of charge, every published international application, the Gazette and any other publication of general interest published by the International Bureau in connection with the Treaty or these Regulations, to International Searching Authorities, International Preliminary Examining Authorities and national Offices upon request by the Authority or Office concerned. Further details concerning the form in which and the means by which publications are communicated shall be governed by the Administrative Instructions.

### ***R.88 PCT Amendment of the Regulations***

#### **88.1**     *Requirement of Unanimity*

Amendment of the following provisions of these Regulations shall require that no State having the right to vote in the Assembly vote against the proposed amendment:

- (i) **Rule 14.1** (Transmittal Fee),
- (ii) *[deleted]*
- (iii) **Rule 22.3** (Time Limit Under **Article 12(3)**),
- (iv) **Rule 33** (Relevant Prior Art for International Search),
- (v) **Rule 64** (Prior Art for International Preliminary Examination),
- (vi) **Rule 81** (Modification of Time Limits Fixed in the Treaty),
- (vii) the present paragraph (i.e., **Rule 88.1**).

#### **88.2**     *[Deleted]*

#### **88.3**     *Requirement of Absence of Opposition by Certain States*

Amendment of the following provisions of these Regulations shall require that no State referred to in **Article 58(3)(a)(ii)** and having the right to vote in the Assembly vote against the proposed amendment:

- (i) **Rule 34** (Minimum Documentation),
- (ii) **Rule 39** (Subject Matter Under **Article 17(2)(a)(i)**),
- (iii) **Rule 67** (Subject Matter Under **Article 34(4)(a)(i)**),
- (iv) the present paragraph (i.e., **Rule 88.3**).

#### **88.4**     *Procedure*

Any proposal for amending a provision referred to in **Rules 88.1** or **88.3** shall, if the proposal is to be decided upon in the Assembly, be communicated to all Contracting States at least two months prior to the opening of that session of the Assembly which is called upon to make a decision on the proposal.

#### **PCT Articles**

A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

A.17 PCT Procedure Before the International Searching Authority

A.34 PCT Procedure Before the International Preliminary Examining Authority

A.58 PCT Regulations

#### **PCT Implementing Rules**

R.14 PCT The Transmittal Fee

R.22 PCT Transmittal of the Record Copy and Translation

R.33 PCT Relevant Prior Art for the International Search

R.34 PCT Minimum Documentation

R.39 PCT Subject Matter under Article 17(2)(a)(i)

R.64 PCT Prior Art for International Preliminary Examination

## A.58 PCT Regulations

### R.88 PCT Amendment of the Regulations

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R.67 PCT Subject Matter under Article 34(4)(a)(i)

R.81 PCT Modification of Time Limits Fixed in the Treaty

### ***R.89 PCT Administrative Instructions***

#### **89.1     *Scope***

(a) The Administrative Instructions shall contain provisions:

- (i) concerning matters in respect of which these Regulations expressly refer to such Instructions,
- (ii) concerning any details in respect of the application of these Regulations.

(b) The Administrative Instructions shall not be in conflict with the provisions of the Treaty, these Regulations, or any agreement concluded by the International Bureau with an International Searching Authority, or an International Preliminary Examining Authority.

#### **89.2     *Source***

(a) The Administrative Instructions shall be drawn up and promulgated by the Director General after consultation with the receiving Offices and the International Searching and Preliminary Examining Authorities.

(b) They may be modified by the Director General after consultation with the Offices or Authorities which have a direct interest in the proposed modification.

(c) The Assembly may invite the Director General to modify the Administrative Instructions, and the Director General shall proceed accordingly.

#### **89.3     *Publication and Entry into Force***

(a) The Administrative Instructions and any modification thereof shall be published in the Gazette.

(b) Each publication shall specify the date on which the published provisions come into effect. The dates may be different for different provisions, provided that no provision may be declared effective prior to its publication in the Gazette.



## A.59 PCT Disputes

Subject to **Article 64(5)**, any dispute between two or more Contracting States concerning the interpretation or application of this Treaty or the Regulations, not settled by negotiation, may, by any one of the States concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the States concerned agree on some other method of settlement. The Contracting State bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other Contracting States.

### **PCT Articles**

A.64 PCT \* Reservations

## **A.60 PCT Revision of the Treaty**

- (1) This Treaty may be revised from time to time by a special conference of the Contracting States.
- (2) The convocation of any revision conference shall be decided by the Assembly.
- (3) Any intergovernmental organization appointed as International Searching or Preliminary Examining Authority shall be admitted as observer to any revision conference.
- (4) **Articles 53(5), (9) and (11), 54, 55(4) to (8), 56, and 57**, may be amended either by a revision conference or according to the provisions of **Article 61**.

### **PCT Articles**

- A.47 PCT Time Limits
- A.53 PCT Assembly
- A.54 PCT Executive Committee
- A.55 PCT International Bureau
- A.56 PCT Committee for Technical Cooperation
- A.57 PCT Finances
- A.61 PCT Amendment of Certain Provisions of the Treaty

## A.61 PCT Amendment of Certain Provisions of the Treaty

(1)(a) Proposals for the amendment of **Articles 53(5), (9) and (11), 54, 55(4) to (8), 56, and 57**, may be initiated by any State member of the Assembly, by the Executive Committee, or by the Director General.

(b) Such proposals shall be communicated by the Director General to the Contracting States at least six months in advance of their consideration by the Assembly.

(2)(a) Amendments to the Articles referred to in **paragraph (1)** shall be adopted by the Assembly.

(b) Adoption shall require three-fourths of the votes cast.

(3)(a) Any amendment to the Articles referred to in **paragraph (1)** shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the States members of the Assembly at the time it adopted the amendment.

(b) Any amendment to the said Articles thus accepted shall bind all the States which are members of the Assembly at the time the amendment enters into force, provided that any amendment increasing the financial obligations of the Contracting States shall bind only those States which have notified their acceptance of such amendment.

(c) Any amendment accepted in accordance with the provisions of **subparagraph (a)** shall bind all States which become members of the Assembly after the date on which the amendment entered into force in accordance with the provisions of **subparagraph (a)**.

### **PCT Articles**

A.53 PCT Assembly

A.54 PCT Executive Committee

A.55 PCT International Bureau

A.56 PCT Committee for Technical Cooperation

A.57 PCT Finances

A.60 PCT Revision of the Treaty

## A.62 PCT Becoming Party to the Treaty

(1) Any State member of the International Union for the Protection of Industrial Property may become party to this Treaty by:

(i) signature followed by the deposit of an instrument of ratification, or

(ii) deposit of an instrument of accession.

(2) Instruments of ratification or accession shall be deposited with the Director General.

(3) The provisions of Article 24 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property shall apply to this Treaty.

(4) **Paragraph (3)** shall in no way be understood as implying the recognition or tacit acceptance by a Contracting State of the factual situation concerning a territory to which this Treaty is made applicable by another Contracting State by virtue of the said paragraph.

### PCT Articles

A.69 PCT Notifications

## A.63 PCT Entry into Force of the Treaty

(1)(a) Subject to the provisions of **paragraph (3)**, this Treaty shall enter into force three months after eight States have deposited their instruments of ratification or accession, provided that at least four of those States each fulfill any of the following conditions:

- (i) the number of applications filed in the State has exceeded 40,000 according to the most recent annual statistics published by the International Bureau,
- (ii) the nationals or residents of the State have filed at least 1,000 applications in one foreign country according to the most recent annual statistics published by the International Bureau,
- (iii) the national Office of the State has received at least 10,000 applications from nationals or residents of foreign countries according to the most recent annual statistics published by the International Bureau.

(b) For the purposes of this paragraph, the term "applications" does not include applications for utility models.

(2) Subject to the provisions of **paragraph (3)**, any State which does not become party to this Treaty upon entry into force under **paragraph (1)** shall become bound by this Treaty three months after the date on which such State has deposited its instrument of ratification or accession.

(3) The provisions of **Chapter II** and the corresponding provisions of the Regulations annexed to this Treaty shall become applicable, however, only on the date on which three States each of which fulfill at least one of the three requirements specified in **paragraph (1)** have become party to this Treaty without declaring, as provided in **Article 64(1)**, that they do not intend to be bound by the provisions of **Chapter II**. That date shall not, however, be prior to that of the initial entry into force under **paragraph (1)**.

### PCT Articles

- A.31 PCT Demand for International Preliminary Examination
- A.64 PCT \* Reservations
- A.65 PCT Gradual Application
- A.69 PCT Notifications

## A.64 PCT \* Reservations

(1)(a) Any State may declare that it shall not be bound by the provisions of **Chapter II**.

(b) States making a declaration under **subparagraph (a)** shall not be bound by the provisions of **Chapter II** and the corresponding provisions of the Regulations.

(2)(a) Any State not having made a declaration under **paragraph (1)(a)** may declare that:

(i) it shall not be bound by the provisions of **Article 39(1)** with respect to the furnishing of a copy of the international application and a translation thereof (as prescribed),

(ii) the obligation to delay national processing, as provided for under **Article 40**, shall not prevent publication, by or through its national Office, of the international application or a translation thereof, it being understood, however, that it is not exempted from the limitations provided for in **Articles 30** and **38**.

(b) States making such a declaration shall be bound accordingly.

(3)(a) Any State may declare that, as far as it is concerned, international publication of international applications is not required.

(b) Where, at the expiration of 18 months from the priority date, the international application contains the designation only of such States as have made declarations under **subparagraph (a)**, the international application shall not be published by virtue of **Article 21(2)**.

(c) Where the provisions of **subparagraph (b)** apply, the international application shall nevertheless be published by the International Bureau:

(i) at the request of the applicant, as provided in the Regulations,

(ii) when a national application or a patent based on the international application is published by or on behalf of the national Office of any designated State having made a declaration under **subparagraph (a)**, promptly after such publication but not before the expiration of 18 months from the priority date.

(4)(a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.

(b) Any State making a declaration under **subparagraph (a)** shall to that extent not be bound by the provisions of **Article 11(3)**.

(c) Any State making a declaration under **subparagraph (a)** shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at any time by notification addressed to the Director General.

(5) Each State may declare that it does not consider itself bound by **Article 59**. With regard to any dispute between any Contracting State having made such a declaration and any other Contracting State, the provisions of **Article 59** shall not apply.

(6)(a) Any declaration made under this Article shall be made in writing. It may be made at the time of signing this Treaty, at the time of depositing the instrument of ratification or accession, or, except in the case referred to in **paragraph (5)**, at any later time by notification addressed to the Director General. In the case of the said notification, the declaration shall take effect six months after the day on which the Director General has received the notification, and shall not affect international applications filed prior to the expiration of the said six-month period.

(b) Any declaration made under this Article may be withdrawn at any time by notification addressed to the Director General. Such withdrawal shall take effect three months after the day on which the Director General has received the notification and, in the case of the withdrawal of a declaration made under **paragraph (3)**, shall not affect international applications filed prior to the expiration of the said three-month period.

(7) No reservations to this Treaty other than the reservations under **paragraphs (1) to (5)** are permitted.

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\* *Editor's Note:* Information received by the International Bureau concerning reservations made under Article 64(1) to (5) is published in the Gazette and on the WIPO website at: **[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**.

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A.21 PCT International Publication

A.30 PCT Confidential Nature of the International Application

A.31 PCT Demand for International Preliminary Examination

A.38 PCT Confidential Nature of the International Preliminary Examination

A.39 PCT Copy, Translation, and Fee, to Elected Offices

A.40 PCT Delaying of National Examination and Other Processing

A.59 PCT Disputes

A.63 PCT Entry into Force of the Treaty

A.69 PCT Notifications

#### **PCT Implementing Rules**

R.26bis PCT Correction or Addition of Priority Claim

R.48 PCT International Publication

R.74 PCT Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof

R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

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PCT AG-IP 5.003 What are the main effects of an international application?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.012 When and how is the international application published by the International Bureau?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.002 What are the main effects of the international preliminary examination?

PCT AG-IP 10.005 Which States may be elected?

#### **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

PCT AG-NP 3.002 What is the time limit for entering the national phase before an elected Office?

## A.65 PCT Gradual Application

(1) If the agreement with any International Searching or Preliminary Examining Authority provides, transitionally, for limits on the number or kind of international applications that such Authority undertakes to process, the Assembly shall adopt the measures necessary for the gradual application of this Treaty and the Regulations in respect of given categories of international applications. This provision shall also apply to requests for an international-type search under **Article 15(5)**.

(2) The Assembly shall fix the dates from which, subject to the provision of **paragraph (1)**, international applications may be filed and demands for international preliminary examination may be submitted. Such dates shall not be later than six months after this Treaty has entered into force according to the provisions of **Article 63(1)**, or after **Chapter II** has become applicable under **Article 63(3)**, respectively.

### PCT Articles

A.15 PCT The International Search

A.31 PCT Demand for International Preliminary Examination

A.63 PCT Entry into Force of the Treaty



## **A.66 PCT Denunciation**

(1) Any Contracting State may denounce this Treaty by notification addressed to the Director General.

(2) Denunciation shall take effect six months after receipt of the said notification by the Director General. It shall not affect the effects of the international application in the denouncing State if the international application was filed, and, where the denouncing State has been elected, the election was made, prior to the expiration of the said six-month period.

### **PCT Articles**

A.69 PCT Notifications

## **A.67 PCT Signature and Languages**

- (1)(a) This Treaty shall be signed in a single original in the English and French languages, both texts being equally authentic.
- (b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the German, Japanese, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.
- (2) This Treaty shall remain open for signature at Washington until December 31, 1970.

## **A.68 PCT Depositary Functions**

- (1) The original of this Treaty, when no longer open for signature, shall be deposited with the Director General.
- (2) The Director General shall transmit two copies, certified by him, of this Treaty and the Regulations annexed hereto to the Governments of all States party to the Paris Convention for the Protection of Industrial Property and, on request, to the Government of any other State.
- (3) The Director General shall register this Treaty with the Secretariat of the United Nations.
- (4) The Director General shall transmit two copies, certified by him, of any amendment to this Treaty and the Regulations to the Governments of all Contracting States and, on request, to the Government of any other State.

## A.69 PCT Notifications

The Director General shall notify the Governments of all States party to the Paris Convention for the Protection of Industrial Property of:

- (i) signatures under **Article 62**,
- (ii) deposits of instruments of ratification or accession under **Article 62**,
- (iii) the date of entry into force of this Treaty and the date from which **Chapter II** is applicable in accordance with **Article 63(3)**,
- (iv) any declarations made under **Article 64(1)** to **(5)**,
- (v) withdrawals of any declarations made under **Article 64(6)(b)**,
- (vi) denunciations received under **Article 66**, and
- (vii) any declarations made under **Article 31(4)**.

### PCT Articles

A.31 PCT Demand for International Preliminary Examination

A.62 PCT Becoming Party to the Treaty

A.63 PCT Entry into Force of the Treaty

A.64 PCT \* Reservations

A.66 PCT Denunciation

## A.69 PCT Notifications

### R.89bis PCT Filing, Processing and Communication of International Applications and Other Documents in Electronic Form or by Electronic Means

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#### ***R.89bis PCT Filing, Processing and Communication of International Applications and Other Documents in Electronic Form or by Electronic Means***

##### 89bis.1 *International Applications*

- (a) International applications may, subject to **paragraphs (b) to (e)**, be filed and processed in electronic form or by electronic means, in accordance with the Administrative Instructions, provided that any receiving Office shall permit the filing of international applications on paper.
- (b) These Regulations shall apply *mutatis mutandis* to international applications filed in electronic form or by electronic means, subject to any special provisions of the Administrative Instructions.
- (c) The Administrative Instructions shall set out the provisions and requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form or by electronic means, including but not limited to, provisions and requirements in relation to acknowledgment of receipt, procedures relating to the according of an international filing date, physical requirements and the consequences of non-compliance with those requirements, signature of documents, means of authentication of documents and of the identity of parties communicating with Offices and authorities, and the operation of **Article 12** in relation to the home copy, the record copy and the search copy, and may contain different provisions and requirements in relation to international applications filed in different languages.
- (d) No national Office or intergovernmental organization shall be obliged to receive or process international applications filed in electronic form or by electronic means unless it has notified the International Bureau that it is prepared to do so in compliance with the applicable provisions of the Administrative Instructions. The International Bureau shall publish the information so notified in the Gazette.
- (e) No receiving Office which has given the International Bureau a notification under **paragraph (d)** may refuse to process an international application filed in electronic form or by electronic means which complies with the applicable requirements under the Administrative Instructions.

##### 89bis.2 *Other Documents*

**Rule 89bis.1** shall apply *mutatis mutandis* to other documents and correspondence relating to international applications.

##### 89bis.3 *Communication between Offices*

Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal ("communication") of an international application, notification, communication, correspondence or other document by one national Office or intergovernmental organization to another, such communication may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

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A.12 PCT Transmittal of the International Application to the International Bureau and the International Searching Authority

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PCT AG-IP 5.188 What fee reductions are available?

***R.89ter PCT Copies in Electronic Form of Documents Filed on Paper***

**89ter.1**      *Copies in Electronic Form of Documents Filed on Paper*

Any national Office or intergovernmental organization may provide that, where an international application or other document relating to an international application is filed on paper, a copy thereof in electronic form, in accordance with the Administrative Instructions, may be furnished by the applicant.

**PCT Implementing Rules**

R.20 PCT International Filing Date

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PCT AG-IP 5.015 What is the form of the request?

PCT AG-IP 5.188 What fee reductions are available?

**PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.002 What are the additional procedural steps at the receiving Office for processing a request form print-out prepared using the PCT-SAFE software?

PCT AG-IP 6.033 What defects in request form print-outs prepared using the PCT-SAFE software do not affect the international filing date?

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PCT AG-IP 11.092 What is the effect of an extension?

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## ***R.90 PCT Agents and Common Representatives***

### **90.1**     *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority.

(b) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(b-bis) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Preliminary Examining Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(d) An agent appointed under **paragraph (a)** may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

### **90.2**     *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a "common agent") under **Rule 90.1(a)**, one of the applicants who is entitled to file an international application according to **Article 9** may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under **Rule 90.1(a)** or a common representative under **paragraph (a)**, the applicant first named in the request who is entitled according to **Rule 19.1** to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

### **90.3**     *Effects of Acts by or in Relation to Agents and Common Representatives*

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### R.90 PCT Agents and Common Representatives

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- (a) Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants concerned.
- (b) If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants.
- (c) Subject to **Rule 90bis.5(a)**, second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

#### 90.4 *Manner of Appointment of Agent or Common Representative*

- (a) The appointment of an agent shall be effected by the applicant signing the request, the demand or a separate power of attorney. Where there are two or more applicants, the appointment of a common agent or common representative shall be effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney.
- (b) Subject to **Rule 90.5**, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under **Rule 90.1(b)**, **(b-bis)**, **(c)** or **(d)(ii)**, it shall be submitted to the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.
- (c) If the separate power of attorney is not signed, or if the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with **Rule 4.4**, the power of attorney shall be considered non-existent unless the defect is corrected.
- (d) Subject to **paragraph (e)**, any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches, any International Preliminary Examining Authority and the International Bureau may waive the requirement under **paragraph (b)** that a separate power of attorney be submitted to it, in which case **paragraph (c)** shall not apply.
- (e) Where the agent or the common representative submits any notice of withdrawal referred to in **Rules 90bis.1 to 90bis.4**, the requirement under **paragraph (b)** for a separate power of attorney shall not be waived under **paragraph (d)**.

#### 90.5 *General Power of Attorney*

- (a) Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a "general power of attorney"), provided that:
  - (i) the general power of attorney has been deposited in accordance with **paragraph (b)**, and
  - (ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.
- (b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under **Rule 90.1(b)**, **(b-bis)**, **(c)** or **(d)(ii)**, it shall be deposited with the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.



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### R.90 PCT Agents and Common Representatives

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(c) Any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches and any International Preliminary Examining Authority may waive the requirement under **paragraph (a)(ii)** that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding **paragraph (c)**, where the agent submits any notice of withdrawal referred to in **Rules 90bis.1** to **90bis.4** to the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be, a copy of the general power of attorney shall be submitted to that Office or Authority.

#### 90.6 *Revocation and Renunciation*

(a) Any appointment of an agent or common representative may be revoked by the persons who made the appointment or by their successors in title, in which case any appointment of a sub-agent under **Rule 90.1(d)** by that agent shall also be considered as revoked. Any appointment of a sub-agent under **Rule 90.1(d)** may also be revoked by the applicant concerned.

(b) The appointment of an agent under **Rule 90.1(a)** shall, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent made under that Rule.

(c) The appointment of a common representative shall, unless otherwise indicated, have the effect of revoking any earlier appointment of a common representative.

(d) An agent or a common representative may renounce his appointment by a notification signed by him.

(e) **Rule 90.4(b)** and (c) shall apply, *mutatis mutandis*, to a document containing a revocation or renunciation under this Rule.

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PCT AG-IP 10.031 Who must sign the demand?

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PCT AG-IP 11.001 For what purposes may an agent be appointed?

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J 6/00 Withdrawal of the priority claims in the international phase / Unambiguous declaration (no) / Analogous application of [..]

J 5/04 Absence de mandataire désigné pour la phase régionale PCT - Signification régulière au premier déposant / [..]

### ***R.90bis PCT Withdrawals***

#### *90bis.1 Withdrawal of the International Application*

- (a) The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.
- (b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where **Article 39(1)** applies, to the International Preliminary Examining Authority.
- (c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

#### *90bis.2 Withdrawal of Designations*

- (a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under **Rule 90bis.4**.
- (b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.
- (c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under **Rule 90bis.1**.
- (d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where **Article 39(1)** applies, to the International Preliminary Examining Authority.
- (e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

#### *90bis.3 Withdrawal of Priority Claims*

- (a) 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.
- (b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in **paragraph (a)** in respect of one or more or all of the priority claims.
- (c) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where **Article 39(1)** applies, to the International Preliminary Examining Authority.

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### R.90bis PCT Withdrawals

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(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to **paragraph (e)**, be computed from the priority date resulting from that change.

(e) In the case of the time limit referred to in **Article 21(2)(a)**, the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

#### *90bis.3bis Withdrawal of Supplementary Search Request*

(a) The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant and to the International Bureau, under **Rule 45bis.8(a)**, of the supplementary international search report or the declaration that no such report will be established.

(b) Withdrawal shall be effective on receipt, within the time limit under **paragraph (a)**, of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in **paragraph (a)**, the communication of that report or declaration under **Article 20(1)**, as applicable by virtue of **Rule 45bis.8(b)**, shall nevertheless be effected.

#### *90bis.4 Withdrawal of the Demand, or of Elections*

(a) The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.

(c) If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

#### *90bis.5 Signature*

(a) Any notice of withdrawal referred to in **Rules 90bis.1 to 90bis.4** shall, subject to **paragraph (b)**, be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under **Rule 90.2(b)** shall, subject to **paragraph (b)**, not be entitled to sign such a notice on behalf of the other applicants.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in **Rules 90bis.1 to 90bis.4** need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

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### R.90bis PCT Withdrawals

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(ii) in the case of a notice of withdrawal referred to in **Rule 90bis.1(b)**, **90bis.2(d)**, **90bis.3(c)** or **90bis.3bis(b)**, the applicant concerned did not sign the request but the requirements of **Rule 4.15(b)** were complied with, or

(iii) in the case of a notice of withdrawal referred to in **Rule 90bis.4(b)**, the applicant concerned did not sign the demand but the requirements of **Rule 53.8(b)** were complied with.

#### 90bis.6 *Effect of Withdrawal*

(a) Withdrawal under **Rule 90bis** of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under **Article 23(2)** or **Article 40(2)**.

(b) Where the international application is withdrawn under **Rule 90bis.1**, the international processing of the international application shall be discontinued.

(b-bis) Where a supplementary search request is withdrawn under **Rule 90bis.3bis**, the supplementary international search by the Authority concerned shall be discontinued.

(c) Where the demand or all elections are withdrawn under **Rule 90bis.4**, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

#### 90bis.7 *Faculty under Article 37(4)(b)*

(a) Any Contracting State whose national law provides for what is described in the second part of **Article 37(4)(b)** shall notify the International Bureau in writing.

(b) The notification referred to in **paragraph (a)** shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the date of such publication.

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***R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents***

91.1 *Rectification of Obvious Mistakes*

- (a) An obvious mistake in the international application or another document submitted by the applicant may be rectified in accordance with this Rule if the applicant so requests.
- (b) The rectification of a mistake shall be subject to authorization by the “competent authority”, that is to say:
- (i) in the case of a mistake in the request part of the international application or in a correction thereof—by the receiving Office;
- (ii) in the case of a mistake in the description, claims or drawings or in a correction thereof, unless the International Preliminary Examining Authority is competent under **item (iii)**—by the International Searching Authority;
- (iii) in the case of a mistake in the description, claims or drawings or in a correction thereof, or in an amendment under **Article 19** or **34**, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examination shall start in accordance with **Rule 69.1** has passed—by the International Preliminary Examining Authority;
- (iv) in the case of a mistake in a document not referred to in **items (i) to (iii)** submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, other than a mistake in the abstract or in an amendment under **Article 19**—by that Office, Authority or Bureau, as the case may be.
- (c) The competent authority shall authorize the rectification under this Rule of a mistake if, and only if, it is obvious to the competent authority that, as at the applicable date under **paragraph (f)**, something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.
- (d) In the case of a mistake in the description, claims or drawings or in a correction or amendment thereof, the competent authority shall, for the purposes of **paragraph (c)**, only take into account the contents of the description, claims and drawings and, where applicable, the correction or amendment concerned.
- (e) In the case of a mistake in the request part of the international application or a correction thereof, or in a document referred to in **paragraph (b)(iv)**, the competent authority shall, for the purposes of **paragraph (c)**, only take into account the contents of the international application itself and, where applicable, the correction concerned, or the document referred to in **paragraph (b)(iv)**, together with any other document submitted with the request, correction or document, as the case may be, any priority document in respect of the international application that is available to the authority in accordance with the Administrative Instructions, and any other document contained in the authority’s international application file at the applicable date under **paragraph (f)**.
- (f) The applicable date for the purposes of **paragraphs (c) and (e)** shall be:
- (i) in the case of a mistake in a part of the international application as filed—the international filing date;
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## A.69 PCT Notifications

### R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

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(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application—the date on which the document was submitted.

(g) A mistake shall not be rectifiable under this Rule if:

(i) the mistake lies in the omission of one or more entire elements of the international application referred to in **Article 3(2)** or one or more entire sheets of the international application;

(ii) the mistake is in the abstract;

(iii) the mistake is in an amendment under **Article 19**, unless the International Preliminary Examining Authority is competent to authorize the rectification of such mistake under paragraph (b)(iii); or

(iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under **Rule 26bis.1(a)**, where the rectification of the mistake would cause a change in the priority date;

provided that this paragraph shall not affect the operation of **Rules 20.4, 20.5, 26bis** and **38.3**.

(h) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or another document, it may invite the applicant to request rectification under this Rule.

#### 91.2 *Requests for Rectification*

A request for rectification under **Rule 91.1** shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation. **Rule 26.4** shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

#### 91.3 *Authorization and Effect of Rectifications*

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize a rectification under **Rule 91.1** and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions, including, as required, notifying the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the designated and elected Offices of the authorization or refusal.

(b) Where the rectification of an obvious mistake has been authorized under **Rule 91.1**, the document concerned shall be rectified in accordance with the Administrative Instructions.

(c) Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which that document was submitted.

(d) Where the competent authority refuses to authorize a rectification under **Rule 91.1**, the International Bureau shall, upon request submitted to it by the applicant within two months from the



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### R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

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date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of the request, reasons and comments (if any) shall if possible be included in the communication under **Article 20** where the international application is not published by virtue of **Article 64(3)**.

(e) The rectification of an obvious mistake need not be taken into account by any designated Office in which the processing or examination of the international application has already started prior to the date on which that Office is notified under **Rule 91.3(a)** of the authorization of the rectification by the competent authority.

(f) A designated Office may disregard a rectification that was authorized under **Rule 91.1** only if it finds that it would not have authorized the rectification under **Rule 91.1** if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under **Rule 91.1** without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

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R.70 PCT International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

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PCT AG-IP 5.110 How can obvious mistakes in the description be rectified?

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PCT AG-IP 11.043 What can be done if the authorization of a rectification is refused?

## A.69 PCT Notifications

### R.91 PCT Rectification of Obvious Mistakes in the International Application and Other Documents

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PCT AG-IP 11.044 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?

PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?

#### **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

PCT AG-NP 6.014 May the applicant correct obvious mistakes in the international application for the national phase?

PCT AG-NP 6.015 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?

#### **Case Law of the Enlarged Board**

G 2/95 Ersatz der vollständigen Anmeldungsunterlagen durch andere Unterlagen im Wege einer Berichtigung nach Regel 88 EPÜ [..]

#### **General Case Law**

J 9/91 Euro-PCT applications - form and content - national requirement / Correction of errors/omissions / Priority [..]

#### **Case Law with Headnote**

J 2/92 Correction of particulars after publication / Errors of transcription - interest of third parties - apparent [..]

#### **General Case Law**

J 17/99 Demande internationale, désignation / réputée retirée - correction après publication de la demande (non)

## ***R.92 PCT Correspondence***

### *92.1 Need for Letter and for Signature*

(a) Any paper submitted by the applicant in the course of the international procedure provided for in the Treaty and these Regulations, other than the international application itself, shall, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. The letter shall be signed by the applicant.

(b) If the requirements provided for in **paragraph (a)** are not complied with, the applicant shall be informed as to the non-compliance and invited to remedy the omission within a time limit fixed in the invitation. The time limit so fixed shall be reasonable in the circumstances; even where the time limit so fixed expires later than the time limit applying to the furnishing of the paper (or even if the latter time limit has already expired), it shall not be less than 10 days and not more than one month from the mailing of the invitation. If the omission is remedied within the time limit fixed in the invitation, the omission shall be disregarded; otherwise, the applicant shall be informed that the paper has been disregarded.

(c) Where non-compliance with the requirements provided for in **paragraph (a)** has been overlooked and the paper taken into account in the international procedure, the non-compliance shall be disregarded.

### *92.2 Languages*

(a) Subject to **Rules 55.1** and **55.3** and to **paragraph (b)** of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under **Rule 23.1(b)** or furnished under **Rule 55.2**, the language of such translation shall be used.

(b) Any letter from the applicant to the International Searching Authority or the International Preliminary Examining Authority may be in a language other than that of the international application, provided the said Authority authorizes the use of such language.

(c) *[Deleted]*

(d) Any letter from the applicant to the International Bureau shall be in English or French.

(e) Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English or French.

### *92.3 Mailings by National Offices and Intergovernmental Organizations*

Any document or letter emanating from or transmitted by a national Office or an intergovernmental organization and constituting an event from the date of which any time limit under the Treaty or these Regulations commences to run shall be sent by air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

### *92.4 Use of Telegraph, Teleprinter, Facsimile Machine, Etc.*

- (a) A document making up the international application, and any later document or correspondence relating thereto, may, notwithstanding the provisions of **Rules 11.14** and **92.1(a)**, but subject to **paragraph (h)**, be transmitted, to the extent feasible, by telegraph, teleprinter, facsimile machine or other like means of communication resulting in the filing of a printed or written document.
- (b) A signature appearing on a document transmitted by facsimile machine shall be recognized for the purposes of the Treaty and these Regulations as a proper signature.
- (c) Where the applicant has attempted to transmit a document by any of the means referred to in **paragraph (a)** but part or all of the received document is illegible or part of the document is not received, the document shall be treated as not having been received to the extent that the received document is illegible or that the attempted transmission failed. The national Office or intergovernmental organization shall promptly notify the applicant accordingly.
- (d) Any national Office or intergovernmental organization may require that the original of any document transmitted by any of the means referred to in **paragraph (a)** and an accompanying letter identifying that earlier transmission be furnished within 14 days from the date of the transmission, provided that such requirement has been notified to the International Bureau and the International Bureau has published information thereon in the Gazette. The notification shall specify whether such requirement concerns all or only certain kinds of documents.
- (e) Where the applicant fails to furnish the original of a document as required under **paragraph (d)**, the national Office or intergovernmental organization concerned may, depending on the kind of document transmitted and having regard to **Rules 11** and **26.3**,
- (i) waive the requirement under **paragraph (d)**, or
- (ii) invite the applicant to furnish, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation, the original of the document transmitted,
- provided that, where the document transmitted contains defects, or shows that the original contains defects, in respect of which the national Office or intergovernmental organization may issue an invitation to correct, that Office or organization may issue such an invitation in addition to, or instead of, proceeding under **item (i)** or **(ii)**.
- (f) Where the furnishing of the original of a document is not required under **paragraph (d)** but the national Office or intergovernmental organization considers it necessary to receive the original of the said document, it may issue an invitation as provided for under **paragraph (e)(ii)**.
- (g) If the applicant fails to comply with an invitation under **paragraph (e)(ii)** or **(f)**:
- (i) where the document concerned is the international application, the latter shall be considered withdrawn and the receiving Office shall so declare;
- (ii) where the document concerned is a document subsequent to the international application, the document shall be considered as not having been submitted.
- (h) No national Office or intergovernmental organization shall be obliged to receive any document submitted by a means referred to in **paragraph (a)** unless it has notified the International Bureau that it is prepared to receive such a document by that means and the International Bureau has published information thereon in the Gazette.

## A.69 PCT Notifications

### R.92 PCT Correspondence

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#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C I 7 Language of further correspondence

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D I 10 How and where is the demand for international preliminary examination to be filed?

GA D I 18 Language of further correspondence

#### **PCT Implementing Rules**

R.11 PCT Physical Requirements of the International Application

R.23 PCT Transmittal of the Search Copy, Translation and Sequence Listing

R.26 PCT Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

R.29 PCT International Applications Considered Withdrawn

R.55 PCT Languages (International Preliminary Examination)

#### **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

PCT AG-IP 6.003 How does the international application reach the receiving Office?

PCT AG-IP 6.052 How should a correction be presented?

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.009 In which language should the supplementary search request be filed?

PCT AG-IP 8.010 What is the language of correspondence with the International Bureau in connection with supplementary international search?

PCT AG-IP 8.026 Who must sign the supplementary search request?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.006\_a What happens where the international application is not in the same language as the accompanying letter?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?

PCT AG-IP 11.067 Can documents be filed by telegraph, teleprinter, facsimile machine, etc?

#### **General Case Law**

W 6/91 Determination of the technical problem as precondition for assessment of unity of invention / Failure to determine the [...]

***R.92bis PCT Recording of Changes in Certain Indications in the Request or the Demand***

*92bis.1 Recording of Changes by the International Bureau*

(a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:

- (i) person, name, residence, nationality or address of the applicant,
- (ii) person, name or address of the agent, the common representative or the inventor.

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.028 When is the indication of a telephone number, a facsimile number or an e-mail address recommended?

PCT AG-IP 5.039 How, in the case of several applicants, are the designated States for which they are applicants to be identified?

**PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.017 How can the applicant receive notifications via e-mail?

**PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.018 Who should be indicated if there has been a change in the name or person of the applicant?

PCT AG-IP 10.018\_a How can the applicant receive notifications via e-mail?

**PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?

PCT AG-IP 11.023 What should be done in the case of the death of the applicant during the international phase?

### ***R.93 PCT Keeping of Records and Files***

#### **93.1     *The Receiving Office***

Each receiving Office shall keep the records relating to each international application or purported international application, including the home copy, for at least 10 years from the international filing date or, where no international filing date is accorded, from the date of receipt.

#### **93.2     *The International Bureau***

(a) The International Bureau shall keep the file, including the record copy, of any international application for at least 30 years from the date of receipt of the record copy.

(b) The basic records of the International Bureau shall be kept indefinitely.

#### **93.3     *The International Searching and Preliminary Examining Authorities***

Each International Searching Authority and each International Preliminary Examining Authority shall keep the file of each international application it receives for at least 10 years from the international filing date.

#### **93.4     *Reproductions***

For the purposes of this Rule, records, copies and files may be kept as photographic, electronic or other reproductions, provided that the reproductions are such that the obligations to keep records, copies and files under **Rules 93.1 to 93.3** are met.

#### **PCT Implementing Rules**

R.20 PCT International Filing Date

### ***R.93bis PCT Manner of Communication of Documents***

#### **93bis.1      *Communication on Request; Communication via Digital Library***

(a) Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal ("communication") of an international application, notification, communication, correspondence or other document ("document") by the International Bureau to any designated or elected Office, such communication shall be effected only upon request by the Office concerned and at the time specified by that Office. Such request may be made in relation to individually specified documents or a specified class or classes of documents.

(b) A communication under **paragraph (a)** shall, where so agreed by the International Bureau and the designated or elected Office concerned, be considered to be effected at the time when the International Bureau makes the document available to that Office in electronic form in a digital library, in accordance with the Administrative Instructions, from which that Office is entitled to retrieve that document.

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 13 International Preliminary Report on Patentability Chapter I

#### **PCT Implementing Rules**

R.44bis PCT International Preliminary Report on Patentability by the International Searching Authority

R.47 PCT Communication to Designated Offices

R.73 PCT Communication of the International Preliminary Examination Report or the Written Opinion of the International Searching Authority

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?

PCT AG-IP 9.002 When and to whom does the International Bureau notify its receipt of the record copy of the international application?

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.079 How do the applicant, the International Bureau and the elected Offices receive the international preliminary report on patentability ( Chapter II of the PCT ) and, where applicable, its translation?

#### **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?



### ***R.94 PCT 11 Access to Files***

#### **94.1     *Access to the File Held by the International Bureau***

(a) At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to **Article 38** and **Rule 44ter.1**, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c)<sup>12</sup> The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph (b) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.<sup>13</sup>

#### **94.2     *Access to the File Held by the International Preliminary Examining Authority***

At the request of the applicant or any person authorized by the applicant, or, once the international preliminary examination report has been established, of any elected Office, the International Preliminary Examining Authority shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

#### **94.3     *Access to the File Held by the Elected Office***

If the national law applicable by any elected Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, including any document relating to the international preliminary examination, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the international publication of the international application. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

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<sup>11</sup> *Editor's Note:* Rule 94 as in force from July 1, 1998, applies only in respect of international applications filed on or after that date. Rule 94 as in force until June 30, 1998, continues to apply after that date in respect of international applications filed until that date. The text of Rule 94 as in force until June 30, 1998, is reproduced below:

**"Rule 94  
Furnishing of Copies by the International Bureau and  
the International Preliminary Examining Authority**

#### **94.1     Obligation to Furnish**

At the request of the applicant or any person authorized by the applicant, the International Bureau and the International Preliminary Examining Authority shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in the file of the applicant's international application or purported international application."

## A.69 PCT Notifications

### R.94 PCT 11 Access to Files

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<sup>12</sup> *Editor's Note:* Rule 94.1(c) as in force from January 1, 2004, applies to international applications filed on or after that date. Rule 94.1(c) also applies to the furnishing on or after January 1, 2004, of copies of the international preliminary examination report in respect of any international application, whether the international filing date of the application is before, on or after January 1, 2004.

<sup>13</sup> *Editor's Note:* Information concerning which elected Offices have requested the International Bureau to furnish copies of international preliminary examination reports on their behalf is also published on the WIPO website at: [www.wipo.int/pct/en/texts/pdf/access\\_iper.pdf](http://www.wipo.int/pct/en/texts/pdf/access_iper.pdf).

#### **EPO Guidelines - A Formalities Examination**

GL A XI 2.1 Extent of file inspection

#### **EPO Guidelines - E General Procedural Matters**

GL E VIII 2.10 Inspection of files

#### **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

GA C II 8 Access to the WO-ISA

GA C II 13 International Preliminary Report on Patentability Chapter I

#### **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

GA D II 19 Confidentiality of the international preliminary examination

#### **PCT Articles**

A.38 PCT Confidential Nature of the International Preliminary Examination

#### **PCT Implementing Rules**

R.44ter PCT Confidential Nature of Written Opinion, Report, Translation and Observations

#### **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

PCT AG-IP 8.053 Will the supplementary international search report be published?

#### **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

PCT AG-IP 9.025 Can access be gained at the International Bureau to the file of an international application?

#### **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

PCT AG-IP 10.002 What are the main effects of the international preliminary examination?

PCT AG-IP 10.080 Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?

PCT AG-IP 10.081 To what extent is the international preliminary examination confidential?

#### **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

PCT AG-IP 11.072 To what extent are international applications treated as confidential?

PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?

#### **General Case Law**

T 1101/99 Delegation of duties to formalities examiners - rejection of file inspection not covered

***R.95 PCT Availability of Translations***

95.1 *Furnishing of Copies of Translations*

- (a) At the request of the International Bureau, any designated or elected Office shall provide it with a copy of the translation of the international application furnished by the applicant to that Office.
- (b) The International Bureau may, upon request and subject to reimbursement of the cost, furnish to any person copies of the translations received under **paragraph (a)**.

## ***R.96 PCT The Schedule of Fees***

### 96.1 *Schedule of Fees Annexed to Regulations*

The amounts of the fees referred to in **Rules 15, 45bis.2** and **57** shall be expressed in Swiss currency. They shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

**EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office**

GA B 43 Amounts of fees

**PCT Implementing Rules**

R.15 PCT The International Filing Fee

R.45bis PCT Supplementary International Searches

R.57 PCT The Handling Fee

**PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

PCT AG-IP 5.184 What fees are due in respect of an international application?

## EPO Guide for Applicants, part II Int. - A General Overview

### GA A A.

General overview

**Introduction to the Euro-PCT Guide**

**Applicable law**

**Euro-PCT Guide and other sources of information**

**Relationship PCT - EPC**

**The role of the EPO in the international phase**

**Euro-PCT application**

**The role of the EPO in the European phase**

**Contracting states to the PCT and the EPC**

**Representation in the international phase**

**Computation of time limits in the international phase**

### *GA A 1 Introduction to the Euro-PCT Guide*

#### 1

This part of the EPO Guide for Applicants is aimed at applicants interested in pursuing the procedure under the PCT. It is of a summary nature and focuses on the elements specific to the PCT procedure before the EPO.

#### 2

The present publication is the sixth edition and is further referred to as the "Euro-PCT Guide".

#### 3

The Euro-PCT Guide gives an overview of the procedures under the PCT before the EPO, including entry into the European phase before the EPO as designated/elected Office. The information it provides is not to be considered complete, nor is it intended to replace relevant WIPO publications and EPO decisions and notices concerning specific issues.

#### 4

The Euro-PCT Guide is **updated to 1 April 2012**. Any changes to the PCT procedures before the EPO after that date are not reflected in the information provided here. Therefore, in using this Guide, applicants should always verify in particular whether any relevant changes to the procedures have entered into force since 1 April 2012. Information on any changes made to date can be found in the sources of information mentioned below (see **points 11 ff**).

#### 5

Although the information in this Guide is not exhaustive, it aims to cover all the **points to note** when the EPO acts in its capacity as:

- a receiving Office,
- an International Searching Authority (ISA),
- a Supplementary International Searching Authority (SISA),
- an International Preliminary Examining Authority (IPEA), and/or
- a designated or elected Office.

**Annex II** shows the different phases of the PCT procedure (see also **Annex III**).

#### 6

Any comments on the Euro-PCT Guide may be addressed to Directorate 5.2.2, International Legal Affairs, PCT.

## ***GA A 2 Applicable law***

7

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**

8

The European Patent Convention of 1973 ("EPC 1973") was comprehensively revised in November 2000 ("EPC 2000"). The revised text of the EPC entered into force on 13 December 2007. Since that date some of the Implementing Regulations to EPC 2000 have been further revised. The most up-to-date version of EPC 2000 is provided on the EPO website.[ 1 ] In the following any reference made to the articles of the EPC and the rules of the Implementing Regulations relates to EPC 2000.

9

Part X of the EPC forms the legal basis for all EPO activities under the PCT. It contains only four provisions: **Articles 150-153 EPC**. These provisions are implemented by the provisions of the Implementing Regulations to the EPC, in particular **Rules 157-165 EPC**, and by further legislation such as decisions of the President and the Administrative Council of the EPO.

10

**Articles 150-153 EPC** and **Rules 157-165 EPC** apply both to applications with an international filing date on or after 13 December 2007 and to international applications filed before that date. Only in respect of the non-unity procedure before the EPO as ISA and IPEA does an exception to this principle apply (see **points 270** and **396**).

[ 1 ]

[www.epo.org/law-practice/legal-texts/epc.html](http://www.epo.org/law-practice/legal-texts/epc.html)

## ***GA A 3 Euro-PCT Guide and other sources of information***

11

It is explicitly pointed out that the Euro-PCT Guide is intended to be complementary to, but not a substitute for, the **PCT Applicant's Guide** ("WIPO PCT Guide").

12

The WIPO PCT Guide is published in English and French by the **International Bureau of WIPO** ("IB") in electronic form only[ 2 ]. A German translation is published in paper form by Carl Heymanns Verlag.

13

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 ]. Relevant information is also provided on the EPO website[ 4 ] and in the **EPO's Official Journal** ("Official Journal" and "OJ"), which is published in paper and electronic form[ 5 ]. Applicants are strongly advised to consult these publications and to take note of, in particular, any information published after 1 April 2012.

14

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[ 6 ].

15

Applicants desiring further information about the PCT procedure in the international phase are advised to consult the Administrative Instructions under the PCT ("AI")[ 7 ], the PCT Receiving Office Guidelines ("GL/RO") and the PCT International Search and Preliminary Examination Guidelines ("ISPE Guidelines", "GL/ISPE")[ 8 ], all available on the WIPO website. Any reference to "Guidelines" ("GL/EPO") in this guide, however, relates to the **Guidelines for Examination in the European Patent Office as revised in 2012**[ 9 ].

[ 2 ]

[www.wipo.int/pct/guide/en/index.html](http://www.wipo.int/pct/guide/en/index.html)

[ 3 ]

[www.wipo.int/pct/guide/en/index.html](http://www.wipo.int/pct/guide/en/index.html)

[ 4 ]

[www.epo.org](http://www.epo.org)

[ 5 ]

[www.epo.org/patents/law/legal-texts/journal.html](http://www.epo.org/patents/law/legal-texts/journal.html)

[ 6 ]

PCT Newsletter: [www.wipo.int/pct/en/newslett/index.html](http://www.wipo.int/pct/en/newslett/index.html)

Official Notices (PCT Gazette): [www.wipo.int/pct/en/official\\_notices/index.html](http://www.wipo.int/pct/en/official_notices/index.html)

[ 7 ]

AI: [www.wipo.int/pct/en/texts/index.htm](http://www.wipo.int/pct/en/texts/index.htm)

[ 8 ]

GL/ISPE and GL/RO: [www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)

[ 9 ]

[www.epo.org/law-practice/legal-texts/guidelines.html](http://www.epo.org/law-practice/legal-texts/guidelines.html)

## ***GA A 4 Relationship PCT - EPC***

### **16**

For international applications which are the subject of proceedings before the EPO in any of its functions (see **point 5**), the provisions of the PCT and its Regulations ("the PCT Rules") apply, **supplemented** by the provisions of the EPC.

#### **Art. 150(2) EPC**

GL/EPO General Part, 3.1

### **17**

In case of conflict between the provisions of the EPC and those of the PCT or the PCT Rules, the **PCT prevails**.

### **18**

As from the entry into force of EPC 2000 on 13 December 2007 the EPO has withdrawn all notifications of incompatibility with PCT provisions.[ **10** ]

OJ 2007, 692

### **19**

In accordance with the principle of the prevalence of the PCT, applicants should refer to the PCT International Search and Preliminary Examination Guidelines (GL/ISPE and ISPE Guidelines) for information on search and examination practice and procedure before the EPO as ISA, SISA and IPEA. In these procedures the Guidelines for Examination in the European Patent Office (GL/EPO) apply only to the extent that they can be applied in conformity with the supplementary role of the EPC in the international phase (see **point 16**). Where the ISPE Guidelines give the International Authority a choice between different options, the EPO will follow the option most in line with its practice under the EPC as set out in **Annex IV** (see **point 219**).

### **20**

In a number of cases the ISPE Guidelines leave a choice between alternative guidelines upon which each ISA/IPEA may rely as appropriate. The options are set out in appendices to the chapters of the ISPE Guidelines. A list of policy options chosen by the EPO is provided in **Annex IV**.

### **21**

Moreover, in an agreement between the EPO and the International Bureau of WIPO ("Agreement EPO-WIPO") concerning the functioning of the EPO as International Authority (ISA, SISA and IPEA) all particulars of the work of the EPO in that capacity are set out. The agreement of 2 October 2007, currently in force, was last revised with effect from 1 April 2012.

OJ 2010, 304

OJ 2012, 256

[ 10 ]

[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

## ***GA A 5 The role of the EPO in the international phase***

**22**

For international applications under the PCT, the EPO may act as:

**Art. 1-49 PCT**

**Art. 150-153 EPC**

**GL/EPO E-VIII**

—

receiving Office ("**RO**") (see **points 42 ff**),

—

International Searching Authority ("**ISA**") (see **points 188 ff**),

—

Supplementary International Searching Authority ("**SISA**") (see **points 274 ff**), and

—

International Preliminary Examining Authority ("**IPEA**") (see **points 296 ff**).

**23**

During the international phase of the processing of an international application no designated or elected Office is allowed to process or to examine that application. However, this prohibition may be lifted at the explicit request of the applicant (see **points 427 ff**).

**Art. 23, 40 PCT**

WIPO PCT Guide 3.005, 5.005

### ***GA A 6 Euro-PCT application***

**24**

An international application for which the EPO is a designated Office (see **point 30**) and which has been accorded an international filing date has - as from that date - the effect of a regular European application (Euro-direct application). Such an international application, being equivalent to a regular European patent application, is referred to as a "Euro-PCT application".

**Art. 11(3) PCT, Art. 45(1) PCT**

**Art. 153(2) EPC**

**25**

Each international application for which the EPO is designated Office is (also) given a **European application number**. This number is notified to the applicant in a communication informing the applicant of the requirements for entry into the European phase (EPO Form 1201), which, as a rule, is issued ten months after international publication of the application.

**26**

**Annex II** contains a chart illustrating the various stages of a Euro-PCT application with the most important time limits.

### ***GA A 7 The role of the EPO in the European phase***

**27**

Once an international application has entered the national phase before the EPO, the international application is said to be in the **European phase**.

**Art. 22(1) PCT, Art. 22(3) PCT, Art. 39(1) PCT, Art. 39(2) PCT**

**R. 159(1) EPC**

WIPO PCT Guide 5.005

**28**

The time limit for entering the **European phase** is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (see **point 443**).

**29**

An up-to-date overview of the applicable time limit for entry into the national phase in each PCT contracting state - including the EPC contracting states where the national route is preferred - is available on the WIPO website[ **11** ].

**30**



If an international application enters the European phase (see **points 443 ff**), the EPO will act:

**Art. 153(1) EPC**

—

as **designated Office** if the international application was only processed under **PCT Chapter I** proceedings (international search and publication of the application);

—

as **elected Office** if the international application at the request of the applicant was also processed under **PCT Chapter II** PCT proceedings (international preliminary examination) (see **points 296 ff** and **points 407 ff**).

[ 11 ]

[www.wipo.int/pct/en/texts/time\\_limits.html](http://www.wipo.int/pct/en/texts/time_limits.html)

## ***GA A 8 Contracting states to the PCT and the EPC***

### **31**

The states for which the EPC has entered into force most recently are San Marino (SM) on 1 July 2009, Albania (AL) on 1 May 2010 and Serbia (RS) on 1 October 2010. Hence on 1 April 2012 the EPC was in force in a total of 38 states[ **12** ]: Albania (AL), Austria (AT), Belgium (BE), Bulgaria (BG), Croatia (HR), Cyprus (CY), Czech Republic (CZ), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Germany (DE), Greece (GR), Hungary (HU), Iceland (IS), Ireland (IE), Italy (IT), Latvia (LV), Liechtenstein (LI), Lithuania (LT), Luxembourg (LU), former Yugoslav Republic of Macedonia (MK), Malta (MT), Monaco (MC), Netherlands (NL), Norway (NO), Poland (PL), Portugal (PT), Romania (RO), San Marino (SM), Serbia (RS), Slovakia (SK), Slovenia (SI), Spain (ES), Sweden (SE), Switzerland (CH), Turkey (TR) and United Kingdom (GB).

OJ 2009, 396

OJ 2010, 96

OJ 2010, 394

GL/EPO, General Part, 6

### **32**

**All EPC contracting states are also contracting states to the PCT and are bound by its Chapter II PCT.** The EPO can therefore act as designated and elected Office for any EPC contracting state provided the international application was filed on or after the date on which the EPC entered into force for the state concerned. This means that no European patent can be granted for an EPC contracting state on the basis of an international application filed prior to the date of entry into force of the EPC for that state.

**Art. 64 PCT**

### **33**

For some EPC contracting states, patent protection on the basis of an international application can only be obtained via the European route, i.e. by entering the European phase to obtain a European patent for the state concerned, since these states have closed off the possibility of entering into the national phase before the national Office concerned (see **point 121**).

**Art. 45(2) PCT**

### **34**

For information on "extension states", see **points 122 ff**.

[ 12 ]

[www.epo.org/about-us/epo/member-states.html](http://www.epo.org/about-us/epo/member-states.html)

## ***GA A 9 Representation in the international phase***

### **35**

Any attorney, patent agent or other person ("agent") having the right to practise before the national or regional patent office with which the international application was filed is entitled to practise before:

**Art. 27(7) PCT, Art. 49 PCT**

**R. 90.1 PCT**

**Art. 133, 134 EPC**

WIPO PCT Guide

5.041-5.051,

10.019-10.023,

11.001-11.014

—

this receiving Office,

—

the IB,

—

the competent ISA,

—

the competent SISA and

—

the competent IPEA.

**36**

An agent so appointed before the receiving Office is referred to as "the agent for the international phase". Applicants are strongly advised to appoint an agent already at the time of filing an international application with the receiving Office (see **Annex VIII**).

**37**

Two or more applicants may choose to appoint either a **common agent** for the international phase or one of the said applicants who is a national or resident of a PCT contracting state to act as their **common representative**, who in turn may then appoint an agent.

**R. 2.2 PCT, R. 2.2bis PCT, R. 90.2 PCT, R. 90.3 PCT**

**38**

If no common agent or common representative has been appointed, the applicant first named in the request who is entitled to file an international application with the EPO as receiving Office is considered to be the common representative (see **points 100 ff**). The "deemed common representative" is not entitled to sign notices of withdrawal on behalf of co-applicants. 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.

**R. 90bis.5 PCT**

**39**

More information on representation before the EPO is provided in **points 96 ff** (EPO as RO), **points 209 ff** (EPO as ISA), **points 342 ff** (EPO as IPEA) and in **points 455 ff** (EPO as designated or elected Office).

***GA A 10 Computation of time limits in the international phase***

**40**

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, not the date of its receipt. In this respect the PCT differs from the EPC, where not the date a communication bears, which is as a rule the date of mailing, but the date of its receipt is relevant.

**R. 80.6 PCT**

**R. 131(2) EPC**

**41**

However, if an applicant proves to the satisfaction of the EPO as receiving Office, ISA, SISA or IPEA that the despatch 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.

## ***GA AI Annex I***

Terms and abbreviations

AI

Administrative Instructions under the PCT

Art.

Article(s) (of the EPC or the PCT)

CET

Central European Time

DAS

Digital Access Service

EPC

European Patent Convention

EPO

European Patent Office

GL/EPO

Guidelines for Examination in the European Patent Office (quoted as follows: GL/EPO C-III, 8.4 = Guidelines, Part C, Chapter III, section 8, point 4)

GL/ISPE

PCT International Search and Preliminary Examination Guidelines

GL/RO

PCT Receiving Office Guidelines

IB

International Bureau of WIPO

IPEA

International Preliminary Examining Authority

IPER

International Preliminary Examination Report

IPRP

International Preliminary Report on Patentability

ISA

International Searching Authority

ISPE Guidelines

PCT International Search and Preliminary Examination Guidelines

ISR

International Search Report

JPO

Japan Patent Office

NPI

Nordic Patent Institute

OEPM

Spanish Patent and Trademark Office

OJ

Official Journal of the European Patent Office (quoted as follows: OJ 2001, 459 = Official Journal, year 2001, page 459)

OJ 2007, Spec.Ed.1

Special Edition No. 1 to EPO Official Journal 2007

OFF

Office of first filing

OSF

Office of second filing

PACE

programme for accelerated prosecution of European patent applications

PCT

Patent Cooperation Treaty

PPH  
Patent Prosecution Highway  
PRV  
Swedish Patent and Registration Office  
R.  
Rule(s) of the Implementing Regulations (to the EPC or the PCT)  
RFees  
**EPC Rules relating to Fees**  
RO  
Receiving Office  
SIS  
Supplementary International Search  
SISA  
Supplementary International Searching Authority  
SISR  
SIS report  
USPTO  
United States Patent and Trademark Office  
WIPO  
World Intellectual Property Organization  
WIPO PCT Guide  
"PCT Applicant's Guide" published by the International Bureau of WIPO  
WO-ISA  
Written Opinion of the International Searching Authority

## ***GA AII Annex II***

The international and European phases of a PCT application



**Enlarge image**

## ***GA AIII Annex III***

Timeline for international applications



**Enlarge image**

## ***GA AIV Annex IV***

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	The EPO applies the problem-solution approach	
Appendix to Chapter 14		
Point 14.01[02]	The EPO applies the criterion of industrial applicability	
Appendix to Chapter 20		
Point A20.21	Disclaimer	Option [2] applies

## ***GA AIX Annex IX***

Form PCT/IPEA/401 Demand and Notes  
**Form PCT/IPEA/401 Demand and Note**

## ***GA AN Annexes***

**Annex I Terms and abbreviations**

**Annex II The international and European phases of a PCT application**

**Annex III Timeline for international applications**

**Annex IV Criteria chosen by the EPO as ISA/IPEA on specific points in the ISPE Guidelines**

**Annex V Filing offices of the EPO (OJ 2007, Spec. Ed. 3, A.2.)**

**Annex VI Form PCT/RO/101 Request and Notes**

**Annex VII Form PCT/RO/101 Fee Calculation Sheet and Notes**

**Annex VIII EPO Form 1003 Authorisation**

**Annex IX Form PCT/IPEA/401 Demand and Notes**

**Annex X Form PCT/IPEA/401 Fee Calculation Sheet and Notes**

**Annex XI Form for entry into the European phase (EPO Form 1200) and Notes**

**Annex XII EPO Form 1010 Payment of fees and expenses**

## ***GA AV Annex V***

Filing offices of the EPO (OJ 2007, Spec. Ed. 3, A.2.)

**1.**

**Addresses and opening hours of the filing offices**

(a)

Munich headquarters

European Patent Office

Erhardtstrasse 27

80469 Munich

Germany

European Patent Office

Bayerstrasse 34

(entrance via Zollstrasse 3)

80335 Munich

Germany

Postal address:

European Patent Office

80298 Munich

Germany

Tel.: +49 (0)89 2399-0

Monday to Thursday: 08.00 to 16.45 hrs, and

Friday: 08.00 to 15.30 hrs (both offices)

(b)

The Hague

European Patent Office

Patentlaan 2

2288 EE Rijswijk

Netherlands

Tel.: +31 (0)70 340-2040

Postal address:

European Patent Office

Postfach 5818

2280 HV Rijswijk

Netherlands

Monday to Friday: 08.00 to 18.00 hrs

(c)

Berlin

European Patent Office

Gitschiner Strasse 103

10969 Berlin

Germany

Tel.: +49 (0)30 25901-0

Postal address:

European Patent Office

10958 Berlin

Germany

Monday to Friday: 10.00 to 12.00 hrs

2.

The EPO filing offices in Berlin and Munich are equipped with automated mail-boxes, which may be used at any time.[ 34 ]

3.

**For filing documents by fax only, the following numbers of the filing offices are to be used:**

Munich:

+49 (0)89 2399-4465

The Hague:

+31 (0)70 340-3016

Berlin:

+49 (0)30 25901-840

4.

For information on filing documents online, see the website of the EPO Online Services:

***[www.epoline.org/portal/public](http://www.epoline.org/portal/public)***

[ 34 ]

The automated mail-box facility is not at present available at the filing office in The Hague. Outside office hours, documents may be handed in to the porter.

Form PCT/RO/101 Request and Notes  
**Form PCT/RO/101 Requests and Notes**

***GA AVII Annex VII***

Form PCT/RO/101 Fee Calculation Sheet and Notes  
**Form PCT/RO/101 Fee Calculation Sheet and Notes**

***GA AVIII Annex VIII***

EPO Form 1003 Authorisation  
**EPO Form 1003 Authorisation**

***GA AX Annex X***

Form PCT/IPEA/401 Fee Calculation Sheet and Notes  
**Form PCT/IPEA/401 Fee Calculation Sheet and Notes**

***GA AXI Annex XI***

Form for entry into the European phase (EPO Form 1200) and Notes  
**Form for entry into the European phase (EPO Form 1200) and Notes**

***GA AXII Annex XII***

EPO Form 1010 Payment of fees and expenses  
**EPO Form 1010 Payment of fees and expenses**

## EPO Guide for Applicants, part II Int. - B The EPO as a PCT receiving Office

### GA B B.

The EPO as a PCT receiving Office

**Who may file an international application with the EPO?**

**Where to file if the EPO is receiving Office?**

**Elements of the international application**

**Incorporation by reference of missing parts and elements**

**International filing date**

**Filing options if the EPO is receiving Office**

**Acknowledgement of receipt**

**E-filing**

**Divisional applications**

**The PCT request**

**Designation of inventor**

**Representation in the procedure before the EPO as receiving Office**

**For which states may international applications be filed?**

**Extension**

**Priority claim**

**Restoration of priority right**

**Furnishing of the priority document**

**The International Searching Authority (ISA)**

**Taking an earlier search into account**

**Refund of the search fee paid for a priority application**

**Applications containing a reference to biological material**

**Applications disclosing nucleotide and/or amino acid sequences**

**Signature**

**Language of the international application**

**Fees**

### *GA B 1 Who may file an international application with the EPO?*

#### 42

An international application may **at the applicant's option** be filed:

**Art. 9, 10 PCT**

**R. 19.1, 19.2 PCT**

WIPO PCT Guide 5.008-5.009

—

with the national office of the PCT contracting state of which the applicant is a resident or national, or  
with the office acting for that state, or

—

with the IB as receiving Office.

#### 43

A third option exists for natural and legal persons who are nationals or residents of an **EPC** contracting state, since they may also file international applications with the **EPO** acting as a **receiving Office**. In such cases it is sufficient that at least one applicant is a national or resident of an EPC contracting state, regardless of whether he is for example mentioned in Box II of the PCT Request as applicant for the designation of the US only and, as the case may be, also as inventor. A person mentioned only as inventor does not qualify as an applicant.

**R. 4.5(d) PCT, R. 18 PCT**



**Art. 151 EPC**

**R. 157 EPC**

**GL/EPO E-VIII, 1**

**44**

If there are **two or more applicants**, it is sufficient for at least one of the applicants to satisfy these requirements. For instance, if a national or resident of an EPC contracting state 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).

**45**

When the EPO acts as receiving Office, the EPO will process the application in accordance with the relevant provisions of the PCT, including the PCT Receiving Office Guidelines (GL/RO) and the Administrative Instructions under the PCT (AI) (see **points 11 ff**).

***GA B 2 Where to file if the EPO is receiving Office?***

**46**

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 (see **point 43**).

**Art. 10 PCT**

**R. 157(1) EPC**

**47**

The EPO has filing offices in Munich, The Hague and Berlin. Please note that the sub-office in Vienna is not a filing office. The EPO's addresses are listed in **Annex V**.

OJ 2007, Spec.Ed.3, A.1, A.2

**48**

The national law of an EPC contracting state may prescribe that an international application is to be filed with the EPO as receiving Office **via** its national patent office. Only in that case may the application be filed with the EPO as receiving Office via the national patent office of the EPC contracting state concerned.

**Art. 75(2), 151 EPC**

**R. 157(1) EPC**

**49**

If, pursuant to national law, the international application must be filed with the EPO as receiving Office via the competent national patent office, this office will only be acting as a "filing office" for the EPO and not as receiving Office. The date of receipt of the application by the national patent office concerned, on behalf of the EPO as receiving Office, will be considered the international filing date, on condition that the application meets the PCT requirements for a filing date to be accorded.

**50**

In these cases the national patent office concerned must ensure that the application reaches the EPO not later than two weeks before the end of the thirteenth month from filing or, if priority is claimed, from the earliest date of priority.

**R. 157(3) EPC**

**51**

The addresses of the national patent authorities of the EPC contracting states, and information on the national legislation establishing which international applications for which the applicant has chosen the EPO as receiving Office must be filed via the national patent office, are provided in the brochure "National law relating to the EPC"[ **13** ].

[ **13** ]

[www.epo.org/patents/law/legal-texts/national-law-epc.html](http://www.epo.org/patents/law/legal-texts/national-law-epc.html)

***GA B 3 Elements of the international application***

52

Any international application **must** contain the following elements: PCT request, description, claim(s) and an abstract. Drawings must only be filed when they are necessary for the understanding of the invention. As regards international applications in the field of biotechnology see also the information in **points 146 ff.**

**Art. 3(2) PCT, Art. 7 PCT**

53

The international application has to be filed with the EPO as receiving Office **in one copy only**. However, if the application is filed by fax a confirmation copy must be filed (see **points 71 ff.**).

**R. 11.1 PCT**

**R. 157(2) EPC**

OJ 2007, Spec.Ed.3, A.3

### ***GA B 4 Incorporation by reference of missing parts and elements***

54

If the applicant has omitted to file a **part of** the description, the claims or the drawings of the international application or an **entire element**, i.e. (all of) the description or all of the claims, these parts and elements may be incorporated in the international application under the conditions set out in **Rules 4.18 and 20 PCT**. If all conditions are met, such incorporation will not affect the international filing date. This procedure may be summarised as follows:

**R. 4.18 PCT, R. 20.5 PCT, R. 20.6 PCT, R. 20.7 PCT**

WIPO PCT Guide 6.028

55

Firstly, such incorporation requires that the omitted part(s) or element(s) be completely contained in an application from which the priority was (validly) claimed **on the international filing date** (see **point 128 ff.**). The test for "completely contained" requires that the later filed missing part - e.g. a paragraph, a page or a drawing - be identical to the corresponding text/drawing in the priority document.

56

Secondly, the PCT request must contain a statement of incorporation by reference of the priority application(s). A statement to that effect is already provided in Box VI of the PCT request form.

57

If both conditions are met, an applicant who has omitted to file a part or element may include it by confirming its incorporation by reference. This requires that the conditions for confirmation set out in **Rules 20.6 and 20.7 PCT** are also met.

58

The procedure before the EPO as ISA/IPEA in the case of a positive/negative decision by the receiving Office on a request for incorporation by reference is set out below (see **points 231, 369**).

59

An applicant wishing to add omitted parts or elements to an international application which have no basis in a claimed priority application may do so under the conditions set out in **Rule 20.5 PCT**. However, in that case the filing date of the application as a whole will be the date of filing of the missing parts or elements.

### ***GA B 5 International filing date***

60

Applicants must carefully consider the date on which an international application is to be filed and accordingly choose an appropriate way of filing to assure timely receipt at an EPO filing office (see **point 47**).

**Art. 11 PCT**

61

The international filing date of an application filed with the EPO as receiving Office is the date on which the application is received at one of the EPO's filing offices or, in exceptional cases (see **points 49-51**), at a national patent office of an EPC contracting state acting as filing office on behalf of the EPO.

**62**

Each international application has a single filing date. The term "international filing date" should therefore not be interpreted as if there is 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.

**63**

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 (see **Annex II**). This means that even after entry into the European phase any reference to the filing date of the international application concerned is a reference to the international filing date (see **points 443 ff**).

***GA B 6 Filing options if the EPO is receiving Office***

**64**

International applications must be filed in writing, either on paper or in electronic form (e-filing). They may be filed direct, by post, by fax or online. If the application is filed in electronic form a fee reduction may apply (see **point 182**).

**R. 11.1 PCT**

WIPO PCT Guide

6.003

OJ 2007, Spec.Ed.3, A.1, A.2, A.3

**Number of copies of documents filed**

**Filing direct or by post**

**Loss or delay in the post**

**Fax filing**

**E-mail, telegram, telex and similar means**

**Filing further documents**

***GA B 7 Number of copies of documents filed***

**65**

The documents constituting an international application must be filed **in only one copy** with the EPO as receiving Office: PCT request form, description, claims, abstract and drawings (Box No. IX PCT request form). The same applies to any *other* documents referred to in **Rule 3.3(a)(ii) PCT** and listed on the right-hand side of Box No. IX of the PCT request form.

**Art. 3(2) PCT, Art. 4 PCT-Art. 7 PCT**

**R. 3.3 PCT, R. 4 PCT-R. 8 PCT, R. 11.1(b) PCT**

**R. 157(2) EPC**

WIPO PCT Guide 5.010, 5.179-5.180

***GA B 8 Filing direct or by post***

**66**

In principle, the date of filing accorded to an application filed with the EPO direct or by post is the **date of handing over or receipt respectively at an EPO filing office**. Automated mailboxes are installed in Munich (in "Kohlstrasse" and "Zollstrasse") and Berlin next to the EPO building. These automated mailboxes may be used at any time. In The Hague documents may be handed to the porter in the main building at any time.

WIPO PCT Guide Vol. I/B2

OJ 2007, Spec.Ed.3, A.1, A.2

OJ 2010, 642

### ***GA B 9 Loss or delay in the post***

**67**

In case of loss or delay, the EPO accepts evidence of mailing a document only if it was mailed via the postal authorities or if one of the following delivery services was used instead: Chronopost, DHL, Federal Express, Flexpress, TNT, SkyNet or UPS. As evidence, confirmation of registration by the post office or of receipt by the delivery service must be provided at the request of the EPO.

**R. 82.1(d), (e) PCT**

OJ 2007, Spec.Ed.3, A.1

**68**

Please note that **Rule 82 PCT** excusing a delay in the post is not applicable to the priority period, because this provision may only be applied in respect of time limits fixed in the PCT. However, under strict conditions a right of priority may be restored (see **points 131 ff**). It is, therefore, recommended that an application be filed as early as possible.

**Art. 48(1) PCT**

**R. 82.1 PCT**

OJ 2010, 351

### ***GA B 10 Fax filing***

**69**

An international application may, together with further documents other than authorisations and priority documents, be filed by fax with the EPO as receiving Office. The fax numbers are provided in **Annex V, point 3**.

**R. 92.4 PCT**

OJ 2007, Spec.Ed.3, A.2, A.3

OJ 2008, 16

OJ 2010, 642

**70**

If an international application is filed by fax, the date on which the facsimile application documents are received in full at the EPO is accorded as the date of receipt of the application. Each of the EPO filing offices is based in the Central European Time zone (CET).

**71**

If an international application is filed by fax, the original, i.e. **the confirmation copy, is to be filed simultaneously**, and the fax should state that the confirmation copy has been filed separately on paper at the same time (see **point 66**).

OJ 2007, Spec.Ed.3, A.3

OJ 2010, 642

**72**

Further, on the first sheet of the PCT request form filed as confirmation copy it should be indicated that the international application has previously been filed by fax, in the form of the words "CONFIRMATION COPY" followed by the date of fax transmission.

**73**

If the confirmation copy is not submitted in due time, the applicant will be invited to submit it. If the confirmation copy is not received even after expiry of the time limit set in a second invitation, the application will be considered withdrawn (see **point 423**).

**R. 92.4(d) PCT, R. 92.4(e) PCT, R. 92.4(f) PCT**

### ***GA B 11 E-mail, telegram, telex and similar means***

**74**

An international application **cannot** be filed with the EPO by e-mail, telegram, telex or similar means. Applications so filed cannot be accorded a valid date of filing. For filing in electronic form see **points 82 ff.**

OJ 2000, 458

OJ 2007, Spec.Ed.3, A.3

**75**

E-mail, telegram, telex and similar means have **no legal force** in the proceedings under the PCT and cannot be used validly to perform **any** procedural act. Therefore, no time limit for such act can be complied with by such means.

### ***GA B 12 Filing further documents***

**76**

After an international application has been filed other documents may be filed in any proceedings before the EPO direct, by post or - with the exception of authorisations and priority documents - by fax at the EPO filing offices.

OJ 2007, Spec.Ed.3, A.3

**77**

No confirmation copy of a further document must be filed, but the receiving Office may require a confirmation copy to be submitted (see **point 71**), which it will do in particular if the applicant has submitted substitute sheets under **Rule 26 PCT** and/or any sheets to be incorporated by reference under **Rule 20.6 PCT**. In these two cases the applicant is advised to submit a confirmation copy on his own initiative directly after sending the sheets concerned by fax.

**R. 20.6, 26 PCT**

### ***GA B 13 Acknowledgement of receipt***

**78**

The receipt of an international application at an EPO filing office is, as a rule, acknowledged by post within four working days. The acknowledgement explicitly confirms the receipt of each separate document and item making up the international application (e.g. description, claims, abstract, data carrier, letter, etc.).

OJ 2007, Spec.Ed.3, A.3

OJ 2010, 642

GL/EPO, A-II, 3.1

**79**

As from 1 March 2011 the receipt of an international application is acknowledged by automated Form 1031. This form is, therefore, no longer to be submitted by the applicant himself and can no longer be downloaded from the EPO website.

**80**

On request, the EPO also acknowledges receipt of an international application **directly by fax or post** upon payment of the administrative fee[ **14** ]. To ensure prompt acknowledgement, the request for fax confirmation and evidence of payment of the administrative fee (e.g. a bank order) or a debit order must be enclosed with the documents or filed at the same time. The applicant should not forget to also provide a fax number to which acknowledgement of receipt is to be sent. If no fax number is indicated, the acknowledgement is sent by post to the address of the applicant or, where applicable, his representative.

**81**

If the requirements for this express procedure are fulfilled, the acknowledgement is issued within **one working day** after receipt of the application.

[ 14 ]

[www.epo.org/applying/forms-fees.html](http://www.epo.org/applying/forms-fees.html)

## ***GA B 14 E-filing***

**82**

International applications may be filed in electronic form with the EPO as receiving Office, either online or offline on an electronic data carrier ("physical medium").

### **R. 89bis PCT**

OJ 2009, 182

OJ 2010, 226

GL/EPO A-II, 1.3

### **Online filing**

#### **Filing on a physical medium ("offline filing")**

#### **E-filing in pre-conversion format**

#### **PCT-EASY filing**

## ***GA B 15 Online filing***

**83**

For online filing with the EPO as receiving Office, the EPO's Online Filing software or the PCT-SAFE software, provided by the IB, may be used. The software allows applicants to fill in the PCT request form (Form PCT/RO/101) directly in the electronic document formats that are accepted by the EPO as receiving Office.

Part 7, Annex F AI

**84**

The EPO's Online Filing software and the required smart card are free of charge. More information is available from the EPO Online Services on the EPO website[ **15** ].

**85**

Information on the PCT-SAFE software is available on the WIPO website[ **16** ].

**86**

If an international application is filed online with the EPO as receiving Office, the receipt of documents is **acknowledged electronically** by the EPO during the submission session. The acknowledgement includes the identity of the receiving Office, i.e. the EPO, the date and time of receipt, a reference or application number allocated by the EPO, a list of the files transmitted and a message digest, i.e. the message in compressed form.

[ **15** ]

[www.epo.org/applying/online-services/online-filing.html](http://www.epo.org/applying/online-services/online-filing.html)

[ **16** ]

[www.wipo.int/pct-safe/en](http://www.wipo.int/pct-safe/en)

## ***GA B 16 Filing on a physical medium ("offline filing")***

**87**

The physical media accepted by the EPO as receiving Office are CD-R, DVD+R, DVD-R. Reference is made to the information in the WIPO PCT Guide.[ **17** ]

OJ 2007, Spec.Ed.3, A.5

**88**

If an international application is filed on a physical medium, the acknowledgement of receipt is sent by post (see **point 78**).

[ **17** ]

[www.wipo.int/pct/guide/en/gdvol1/annexes/annexc/ax\\_c\\_ep.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexc/ax_c_ep.pdf)

[www.wipo.int/pct/guide/en/gdvol1/annexes/annexd/ax\\_d\\_ep.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexd/ax_d_ep.pdf)

## ***GA B 17 E-filing in pre-conversion format***

89

If any document making up the international application has been prepared by conversion from a different electronic document format (pre-conversion format), the applicant may be allowed to submit the document in that format together with a statement that the international application in electronic form is a complete and accurate copy of the document in pre-conversion format. Each pre-conversion document must be in a format that fulfils the requirements stipulated in the Decision of the President of 12 July 2007. Furthermore, it is recommended that pre-conversion documents be submitted as ZIP files.

**Art. 5, 6 PCT**

OJ 2007, Spec.Ed.3, A.5

PCT Newsletter 7/2008, 1

### ***GA B 18 PCT-EASY filing***

90

Since 1 April 2007 the EPO as receiving Office has ceased to accept international applications filed in the PCT-EASY format. If an application is filed in the PCT-EASY mode together with a PCT-EASY diskette the latter will be disregarded and the application will be processed as a normal application filed on paper.

OJ 2007, 58

### ***GA B 19 Divisional applications***

91

The PCT does not provide for the possibility of filing a divisional application. A divisional application with an international application as its parent application may not be filed with the EPO as designated/elected Office unless the parent application has validly entered the European phase (see **point 645**).

GL/EPO A-VII, 4.1

### ***GA B 20 The PCT request***

92

International applications **must** be filed using **the PCT request form** (PCT/RO/101) or a corresponding computer printout. Applicants are advised to read carefully the PCT request form and the explanatory notes before completing the form. For electronic filing, see **points 82 ff.**

**Art. 3 PCT, Art. 4 PCT, Art. 11(1)(iii) PCT**

**R. 3, 4 PCT**

WIPO PCT Guide 5.015-5.093

93

The PCT request form with the explanatory notes and the fee calculation sheet can be found in **Annex VI** and **VII**. Copies of these documents together with explanatory notes are available free of charge from the EPO, the IB and national patent offices. Both documents may also be downloaded from WIPO's website[ **18** ].

[ 18 ]

[www.wipo.int/pct/en/forms/index.htm](http://www.wipo.int/pct/en/forms/index.htm)

### ***GA B 21 Designation of inventor***

94

It is recommended that the inventor always be identified (Box No. III, PCT request form), unless there are special reasons for not doing so. The name and address of the inventor must be furnished in the PCT request form 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 (e.g. the US). 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.

**Art. 4(1)(v) PCT**

**R. 4.1(a)(iv) PCT**

WIPO PCT Guide 5.035-5.038

**95**

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 **points 448 and 602**).

**Art. 22(1) PCT**

**R. 159, 163(1) EPC**

GL/EPO E-VIII, 2.3.4

### ***GA B 22 Representation in the procedure before the EPO as receiving Office***

**96**

Information on the representation of the applicant(s) during the international phase is to be provided in Box No. IV of the PCT request form. Before filling out the box, applicants should carefully read the instructions provided in the Notes to the PCT request form concerning Box No. IV and the information given below (see **points 97-114**).

**Art. 27(7), 49 PCT**

**R. 90.1 PCT**

**Art. 133, 134 EPC**

WIPO PCT Guide 11.001-11.014

OJ 1994, 538

**97**

Two categories of representative - agents in PCT terminology - have the right to practise before the EPO as receiving Office:

- any professional representative entered in the directory of professional representatives maintained by the EPO
- any legal practitioner qualified to practise in patent matters in one of the EPC contracting states and who has his place of business in that state.

**98**

Only a person belonging to at least one of these categories may be appointed as agent for an international application filed with the EPO as receiving Office (see **points 42-43**). The directory of professional representatives can be consulted on the EPO website[ **19** ].

**99**

The agent must always be mentioned by name in Box No. IV of the PCT request form, unless he belongs to an association of professional representatives registered as such with the EPO (see **points 106 ff**). The agent may choose his address as he wishes on condition that it is in an EPC contracting state.

[ **19** ]

[www.epo.org/patents/Grant-procedure/representatives](http://www.epo.org/patents/Grant-procedure/representatives)

**Two or more applicants - common agent and common representative**

**How to appoint an agent, common agent or common representative**

**Association of professional representatives**

**Address for correspondence**

**Waiver**

**Appointment of an agent for the European phase with the EPO as receiving Office**



### ***GA B 23 Two or more applicants - common agent and common representative***

#### **100**

If there are two or more applicants a professional representative (see **point 96**) may be appointed as "**common agent**" (see **point 37**).

#### **R. 90.2 PCT**

#### **101**

Moreover, if the application is filed by two or more applicants, they may also appoint one of their number as "**common representative**" (see **point 37**). If no common agent or common representative is appointed, the applicant first named in the PCT request form who is entitled to file an application with the EPO as receiving Office is considered to be the common representative ("deemed common representative") (see **point 37**).

#### **102**

If no common agent is appointed, any correspondence is sent to the address of the (deemed) common representative. If the latter has appointed an agent, it is sent to the address of the agent of the (deemed) common representative. A different address may be provided as address for correspondence only if certain requirements are met (see **point 108**).

### ***GA B 24 How to appoint an agent, common agent or common representative***

#### **103**

Appointment of an agent, common agent or common representative for the international phase requires a declaration to that effect to be made either in the PCT request (Box No. IV PCT request form) itself 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.[ **20** ] If the agent, common agent or common representative is at the same time to be appointed for the procedure in the European phase, applicants are referred to the information in **points 113 ff**.

#### **R. 90.4, 90.5 PCT**

#### **104**

For the appointment of the agent, the common agent or the 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 (see **points 159 ff**).

#### **105**

Appointment of a (common) agent may also be effected by referring in the PCT request or in a separate notice to an existing general power of attorney deposited with the EPO, if a copy of it is attached to the PCT request or the separate notice.

#### **106**

Please note that a power of attorney may not be filed by fax (see **point 69**).

[ **20** ]

[www.epo.org/applying/forms-fees.html](http://www.epo.org/applying/forms-fees.html)

### ***GA B 25 Association of professional representatives***

#### **107**

If the applicant wishes to appoint the members of an association of professional representatives as agents, the name of the association and its registration number must be indicated in Box No. IV of the PCT request form.

#### **R. 90 PCT**

#### **Art. 150(2) EPC**

#### **R. 152(11) EPC**

### ***GA B 26 Address for correspondence***

**108**

If no agent has been appointed, any correspondence is sent to the applicant. In that case applicant firms with operations at different locations may indicate an address for correspondence in an EPC contracting state. Since taking care of the post of another person requires competence to represent that person, the address of a third party may not be indicated, but only an address of the applicant himself.

**Art. 27(7) PCT**

**Art. 150 EPC**

OJ 1980, 397

***GA B 27 Waiver***

**109**

The EPO as receiving Office (and also as 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 be submitted to it if the PCT request is not signed by (all) the applicant(s). The waiver does not apply to a legal practitioner referred to in **Article 134(8) EPC** if that person is not also a professional representative.

**R. 90.4(d) PCT**

**Art. 134 EPC**

OJ 2010, 335

**110**

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.

**R. 90.5(c) PCT**

**111**

However, as a matter of strategy and caution, (common) agents and common representatives are recommended to obtain explicit authorisation from (all) the applicant(s) by way of direct signature of the PCT request or by duly signed powers of attorney. **The authorisation of each applicant is required in any case in which a withdrawal of any kind is submitted.**

**R. 90.4(e) PCT, R. 90.5(d) PCT, R. 90bis PCT**

**112**

The EPO may require the filing of a separate power of attorney or a copy of a general power of attorney in any case of doubt as to the (common) agent's or common representative's entitlement to act.

OJ 2010, 335

***GA B 28 Appointment of an agent for the European phase with the EPO as receiving Office***

**113**

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 receiving Office and the agent is appointed by separate authorisation, the applicant(s) may at the same time indicate therein that the agent is also appointed to represent the applicant(s) before the EPO as designated or elected Office in the European phase. For the designation of an agent for the international *and* European phase at the same time, the applicant may use Form EPA/EPO/OEB 1003 available on the EPO's website[ **21** ].

**Art. 27(7), 49 PCT**

**R 90.1 PCT**

**Art. 134 EPC**

WIPO PCT Guide 11.001

GL/EPO A-VIII, 1.5

**114**

If the appointment of an agent is effected by reference to an existing general power of attorney and filing of a copy (see **point 105**), the appointment of the agent also for the European phase must be explicitly made in a separate notice.

[ 21 ]

[http://documents.epo.org/projects/babylon/eponet.nsf/0/F0E8FAC1BF4ED2A7C125737E004E4C9A/\\$File/1003\\_form\\_11\\_11.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/F0E8FAC1BF4ED2A7C125737E004E4C9A/$File/1003_form_11_11.pdf)

***GA B 29 For which states may international applications be filed?***

**115**

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

**Art. 4(1)(ii) PCT,**

**Art. 11 (1)(iii)(b) PCT**

**R. 4.9(a) PCT, R. 4.9(b) PCT**

**Art. 153(1) EPC**

WIPO PCT Guide 5.052

**116**

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 EP covers all EPC contracting states for which the PCT and the EPC are in force on the filing date of the international application.

**117**

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 (see **points 412 ff**). Therefore, 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.

**Non-designation for reasons of national law**

***GA B 30 Non-designation for reasons of national law***

**118**

For reasons of national law, check-boxes 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). Crossing the check-box for these designations is **not** considered as withdrawal of a designation, but as non-designation of the state(s) concerned.

**R. 4.9(b) PCT**

WIPO PCT Guide 5.053

**119**

According to the national law 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 (for Germany: for the same kind of protection) 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 crossed (Box No. V PCT request form). More information on so-called "self-designation" can be obtained from the national patent offices concerned.

**120**

As regards the EPC contracting states, the problem of self-designation exclusively concerns Germany (DE) and only if the PCT request includes the automatic designation of Germany for a **national patent**. 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.

#### 121

The national law of a number of EPC contracting states stipulates that on the basis of a PCT application **only a European patent** may be obtained for these states. The countries which close off the route to a national patent in this way were, on 1 April 2012, Belgium (BE), Cyprus (CY), France (FR), Greece (GR), Ireland (IE), Italy (IT), Latvia (LV), Monaco (MC), Malta (MT), Netherlands (NL) and Slovenia (SI).

**Art. 45(2) PCT**

### *GA B 31 Extension*

#### 122

With some European states, which are not a party to the EPC and thus not "included" in the designation "EP", the EPO has agreed a so-called "extension agreement". Pursuant to such agreement an applicant may, in the European phase, extend his application to any "extension state" on condition that all requirements are met. Valid extension requires, firstly, that on the international filing date the extension agreement was in force and, secondly, that this extension state was both a PCT contracting state at the filing date and was designated for a **national** patent in the international application.

GL/EPO General Part, 7, **A-III, 12**

#### 123

The extension states listed below were already PCT contracting states on the date of entry into force of the extension agreement. Moreover, as from 1 January 2004, all PCT contracting states are automatically designated for a national and, where applicable, a regional patent (see **point 116**).

#### 124

On 1 April 2012 an extension agreement is in force with:

—

Bosnia and Herzegovina (BA) (since 1 December 2004);  
OJ 2004, 563, 619  
OJ 2007, 406  
OJ 2010, 10

—

Montenegro (ME) (since 1 March 2010).

#### 125

As to the extension of a European patent to the Republic of Montenegro (ME) following its Declaration of Independence on 3 June 2006 and before entry into force of the extension agreement on 1 March 2010, reference is made to the information in the Official Journal.

#### 126

The extension agreements with Albania (AL), Croatia (HR), Latvia (LV), Lithuania (LT), the former Yugoslav Republic of Macedonia (MK), Romania (RO), Serbia (RS) and Slovenia (SI) terminated when these states acceded to the EPC. **The extension system continues to apply after the relevant termination date for all applications filed prior to the date on which the extension agreement concerned terminated.**

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

#### 127

A decision on the states for which extension is sought - and in accordance therewith timely payment of the extension fee(s) is due - need not be taken until the application has to enter the European phase (see **points 551 ff**).  
OJ 2009, 603

### ***GA B 32 Priority claim***

#### **128**

A declaration in an international application claiming the priority of one or more earlier applications filed in or for any state party to the Paris Convention for the Protection of Industrial Property ("Paris Convention") or in or for any Member of the World Trade Organization (WTO) that is not party to the Paris Convention must always indicate the date on which the earlier application was filed, the state or states in which it was filed and the application number(s) under which it was filed. If the earlier application was a regional one, it suffices to give the name of the patent-granting authority under the regional agreement - i.e. "EP" in the case of a European application (Box No. VI PCT request form).

**Art. 8(1) PCT**

**R. 2.4, 4.10 PCT**

WIPO PCT Guide 5.007, 5.057-5.071, 6.038-6.044

OJ 2007, 692

#### **129**

Priority from an application filed in or for a WTO Member that is not party to the Paris Convention may only be claimed in the procedure before the EPO as designated Office for an application filed on or after 13 December 2007.

#### **130**

If the priority application was not filed by the applicant but transferred to him, the transfer must have taken place before the filing of the application. Proof of entitlement at the international filing date must be submitted (only) if the validity of the priority right claimed becomes relevant in the proceedings before the EPO.

GL/EPO A-III, 6.1

### ***GA B 33 Restoration of priority right***

#### **131**

If an international application is filed after expiry of the priority period a request for restoration of priority right under **Rule 26bis.3 PCT** may be filed with the EPO as receiving Office. A request for restoration of priority may also be filed with the EPO upon entry into the European phase, but its effect will then per se be limited to the grant procedures before the EPO (see **points 624 ff**).

**Art. 8 PCT**

**R. 2.4 PCT, R. 26bis.2(c) PCT, R. 26bis.3 PCT, R. 80.5 PCT, R. 82 PCT**

**Art. 122 EPC**

**Art. 2.13 RFees**

WIPO PCT Guide 5.063-5.069

OJ 2007, 692

PCT Newsletter

2007/4, 1-5

#### **132**

If the last day of the priority year falls on a non-working day or an official holiday of the EPO, the priority year expires on the next subsequent working day. **Rule 82 PCT** concerning delay in receipt of an international application due to irregularities in the mail is not applicable to the 12-month time limit for claiming priority, since this time limit is not fixed in the PCT.

#### **133**

The EPO as receiving Office may only grant a request for restoration of priority right if the following requirements are met:

—

the international filing date is within two months from the date on which the priority period expired;

–  
the request for restoration is filed within the time limit of two months from the date on which the priority period expired;

–  
the fee for restoration of the right of priority is paid within the same time limit, which is not extended if the EPO acts as receiving Office;

–  
the request for restoration is supplemented by a statement explaining the reasons for failure to file the application within the priority period together with, where available, any evidence; and

–  
the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken by the applicant.

#### 134

A decision by the receiving Office on a request for restoration of priority is not required for the international search if the application was filed within two months from the date on which the priority period expired, because in that case the priority claim may not be considered void during the international phase (see **point 233**).

#### **R. 26bis.2(c) PCT**

#### 135

If the applicant has not requested restoration of priority in the procedure before the EPO as receiving Office or if the request for restoration has been rejected by the latter, the applicant may file a new request in the national phase, i.e. in the procedures before the EPO (see **points 624 ff**) and any other designated Office that has not made a reservation as to the applicability of **Rules 49ter.1** and **.2 PCT**.

#### 136

If the EPO as receiving Office has granted a request for restoration, that decision is valid and will not be reviewed in the procedure before the EPO as designated Office (see **points 628-629**). If no reservation applies, that positive decision will as a rule also be accepted by other designated Offices.

#### **R. 49ter.1** and **2 PCT**

#### 137

For information as to the Offices that have made a reservation, reference is made to the information in the WIPO PCT Guide (see **points 11 ff**).

### ***GA B 34 Furnishing of the priority document***

#### 138

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 within 16 months after the priority date. However, if the earlier application was filed with the receiving Office, the applicant may request that the receiving Office transmits a certified copy of the earlier application to the International Bureau. For that purpose a check-box is provided in Box No. VI of the PCT request form.

#### **R. 17.1(a), (b) PCT**

#### 139

If the EPO is requested to prepare and transmit a priority document to the International Bureau a fee is due.

#### **R. 17.1(b) PCT**

#### **Art. 3(1) RFees**

#### 140

Please note that the procedure whereby the EPO includes free of charge a copy of the previous application from which priority is claimed in the file of a European patent application does not apply in respect of an international application processed by the EPO as receiving Office (see **point 614**). Moreover, the obligation to furnish the priority document cannot be met by a request to the IB under

the Digital Access Service (DAS) to retrieve that document from an electronic library, because the EPO does not participate in this system.

**R. 17.1(b-bis) PCT** OJ 2009, 236

PCT Newsletter 12/2010, 8

**141**

A priority document may not be filed by fax (see **point 69**).

### ***GA B 35 The International Searching Authority (ISA)***

**142**

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

**Art. 16 PCT**

**R. 4.1(b)(iv) PCT, R. 4.14bis PCT**

**Art. 152 EPC**

### ***GA B 36 Taking an earlier search into account***

**143**

The applicant may file a request with the receiving Office that the result of an earlier search carried out by the EPO or by any other office be taken into account. A refund of the international search fee is, however, granted only under the conditions set out in **point 144**.

**R. 4.12 PCT**

### ***GA B 37 Refund of the search fee paid for a priority application***

**144**

An applicant who is of the opinion that the EPO can base its search entirely or partly on an earlier search report already prepared by the EPO on an application whose priority is validly claimed (Box No. VI of the PCT request form) may obtain a refund of the international search fee paid. The EPO acting as ISA decides whether the requirements are met and, where applicable, refunds the applicable amount (see **point 213**). Where priority is claimed from an application for which the EPO carried out a search, the continuation section of Box No. VII in the PCT request does not need to be filled out.

**R. 4.1 PCT, R. 4.12 PCT, R. 12bis.1(d) PCT, R. 16.3 PCT, R. 41 PCT**

Agreement EPO-WIPO Art. 5(2)

OJ 2010, 304

OJ 2012, 256

WIPO PCT Guide 5.073

OJ 2009, 99

OJ 2010, 341

GL/EPO A-X, **10.2.3**

**145**

No refund is made for any search other than a search carried out by the EPO on an application from which the right of priority is validly claimed.

### ***GA B 38 Applications containing a reference to biological material***

**146**

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.

**R. 13bis PCT**



**R. 31-34 EPC**

WIPO PCT Guide 11.075-11.087

OJ 2010, 506

Section 209 AI

**147**

A reference to biological material in accordance with the provisions of the PCT is to be regarded by each designated Office as satisfying the requirements of its national law as to the content and time 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 (see **points 148-149**).

**148**

The EPO has notified the IB that if the biological material has not been deposited by the applicant 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 within 16 months from the priority date in which the depositor:

**R. 13bis.4, 7 PCT**

**R. 31(1)(d) EPC**

—

has authorised the applicant to refer to the biological material, and

—

has given his/her unreserved and irrevocable consent to the deposited material being made available to the public.

**149**

Such authorisation is, however, not required if the depositor transferred his rights in the deposit to the applicant on the filing date 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 and the information in the Guide for Applicants, Part 1, points 76 ff.

**150**

If any requirement concerning a reference to biological material is not met within 16 months from the priority date of the application, this **cannot** be corrected 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.

**151**

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, check-box No. 8 PCT request form). This form must be used also if the applicant wishes samples to be made available only to an expert.

**152**

The furnishing of samples of biological material by the EPO takes place in conformity with **Rule 33 EPC**. As a consequence, if the requirements of **Rule 33 EPC** are met, samples of biological material are furnished by the EPO in its capacity as designated Office to third parties as from international publication, 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. The fact that this solution has been chosen will be published on the front page of the published translation of the application.

**R. 13bis.6 PCT**

**R. 32(1), 33 EPC**

OJ 1992, 470

OJ 2010, 498

PCT Newsletter

7-8/2010, 6



11/2011, 5

### ***GA B 39 Applications disclosing nucleotide and/or amino acid sequences***

#### **153**

If the international application discloses one or more **nucleotide and/or amino acid sequences**, it must contain a sequence listing, which is to be drawn up in compliance with the standard (WIPO Standard ST.25) prescribed in Annex C of the Administrative Instructions under the PCT and published on the WIPO website. The sequence listing must comply with the version of WIPO Standard ST.25 which is applicable on the date on which the sequence listing is submitted[ 22 ].

#### **R. 5.2, 13ter.1 PCT**

WIPO PCT Guide 5.099-5.108,

7.005-7.012, 11.088

OJ 2011, 372, 376

Section 101, 207, 208, 513, 610, 707(a) and (a-bis)

Annex C AI

PCT Newsletter

12/2010,5

7-8/2009, 10

#### **154**

Any sequence listing not contained in the international application as filed will - if not allowable as an amendment under **Article 34 PCT** (see **point 363**) - not form part of the international application.

#### **155**

Tables related to sequence listings must be included as an integral part of the description in the same format as the remainder of the application. Any pages of tables relating to sequence listings count as regular pages of the description for which full page fees are payable (see **point 169**).

#### **156**

The EPO accepts sequence listings filed on electronic media as specified by the EPO (see **point 87**).

#### **157**

If an international application is filed in electronic form, a sequence listing forming part of such application and filed in text format in compliance with Annex C is not taken into account for calculating the (page fee part of the) international filing fee (see **point 167**) and there will be no need to file a second copy for the purposes of international search and, where applicable, international preliminary examination (see **points 260, 389**).

#### **158**

If any other option for filing a sequence listing is chosen - e.g. filing on paper or in image format - the sum of the page fee part of the international filing fee is calculated taking into account each page of the sequence listing. Further, if the EPO acts as ISA, SISA and/or IPEA a sequence listing in electronic form in text format in compliance with Annex C must be furnished (see **points 260 ff**).

#### **R. 13ter.1 PCT**

OJ 2011, 372, 376

GL/EPO A-IV, 5;

E-VIII, 2.4.2

[ 22 ]

[www.wipo.int/standards/en/pdf/archives/03-25-01arc2009.pdf](http://www.wipo.int/standards/en/pdf/archives/03-25-01arc2009.pdf)

### ***GA B 40 Signature***

#### **159**

The PCT request form or, where applicable, the power of attorney **must be signed by the applicant**.

#### **R. 4.1(d) PCT, R. 4.15 PCT, R. 26.2bis(a) PCT, R. 51bis.1(a)(vi) PCT**

WIPO PCT Guide 5.013-5.014

#### **160**

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 PCT request form, see **point 97**). 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.

**161**

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

**162**

If not the applicant but his agent has signed the PCT request form a signed power of attorney or a copy of a general power of attorney need not be submitted since this requirement has been waived by the EPO (see **point 109**). However, as a matter of strategy and caution agents are recommended to obtain explicit authorisation from all applicants, either by way of direct signature or powers of attorney (see **point 111 ff**).

**R. 90.3 PCT, R. 90.4 PCT, R. 90.5 PCT**

OJ 2010, 335

### ***GA B 41 Language of the international application***

**163**

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. An international application filed in another language will be forwarded to the IB to act as receiving Office instead of the EPO. This means that there is no possibility to file an application with the EPO as receiving Office in any other language as is provided under **Article 14 EPC** for European patent applications not filed via the PCT route (Euro-direct applications).

**Art. 3(4)(i) PCT, Art. 11(1)(ii) PCT**

**R. 12, 19.4 PCT**

**Art. 14, 150(2) EPC**

**R. 3, 157(2) EPC**

WIPO PCT Guide 5.013-5.014

OJ 1993, 540

**164**

If an application is filed with the EPO as receiving Office in one of its official languages, that language will be the language of the proceedings which may not be changed either during the international phase or on entry into the European phase (see **points 418-419**). However, with the exception of amendments and corrections to the application, for which the language of the international application must be used, any other correspondence with the EPO may be in any of the EPO's three official languages.

OJ 1993, 540

**G 4/08**

OJ 2010, 572

### ***GA B 42 Fees***

**165**

For fee payments to be made during the international phase applicants are recommended to consult the latest information available on both the EPO and the WIPO websites. Furthermore, guidance for the payment of fees, expenses and prices is provided in each issue of the Official Journal.

**Art. 3(4)(iv) PCT**

**R. 14-16 PCT**

WIPO PCT Guide 5.185-5.199

**166**

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

**167**

For international applications the following fees are payable direct to the EPO as receiving Office:

- the transmittal fee,
- the international filing fee, and
- the international search fee.

**168**

The transmittal, international filing and search fees are payable within **one month** of receipt of the international application.

**R. 14.1 PCT, R. 15.4 PCT, R. 16.1(f) PCT**

**169**

If the application contains **more than 30 sheets**, the international filing fee is increased, with a fixed sum to be paid for each sheet in excess of 30 sheets. This extra fee is considered part of the international filing fee and must be paid by the applicant together with the (basic) filing fee. The applicant must compute the extra amount himself and not wait for a communication, because as from expiry of the one month time limit the missing amount may only be validly paid together with a late payment fee (see **point 185**).

**170**

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 all requirements are met (see **points 153 ff**).

**Amounts of fees**

**Payment methods**

**Reductions**

**Late payment of fees**

## ***GA B 43 Amounts of fees***

**171**

The amounts of the transmittal and international search fee are fixed by the EPO and given in the EPO's current Schedule of fees and expenses published in the Official Journal.

**R. 157(4) EPC**

**Art. 2.2, 2.18 RFees**

**172**

The conditions for a reduction in the international search fee are set out in **points 213 ff**.

**173**

The amount of the international filing fee, including the page fee, is fixed by WIPO 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. The amounts payable in respect of the international filing fee, the search fee and the transmittal fee are those applicable on the date of receipt of the international application.

**R. 15.3 PCT, R. 16.1(f) PCT,**

**R. 14.1(c) PCT, R. 96.1 PCT**

PCT Schedule of Fees

**174**

The conditions for a reduction in the international filing fee are set out in **points 178 ff**.

## ***GA B 44 Payment methods***

**175**

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. For persons having a deposit account with the EPO payment may be made by debit order. However, the **automatic debiting** facilities are not yet available for any fee payments to the EPO as receiving Office, ISA and IPEA. Furthermore, payment of fees by **credit card** is not possible and payment by **cheque** was abolished by the EPO in 2008. Each issue of the Official Journal provides guidance for the payment of fees.

OJ 2007, 626

OJ 3/2009, Supplement

**176**

The equivalent amount in euros of any fee set in Swiss francs by WIPO is from time to time amended. Actual fee rates are published in the Official Journal, the Official Notices (PCT Gazette) and the PCT Newsletter (see **point 11** ff).

**177**

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**.

**Art. 7(3) RFees**

### ***GA B 45 Reductions***

**178**

The international filing fee is reduced by 90% if the requirements stipulated in point 5 of the PCT Schedule of Fees are met. If there are several applicants, each of them must satisfy the requirements for the reduction to apply.

Point 5 PCT Schedule of Fees

**Art. 8 RFees**

WIPO PCT Guide 5.188

**179**

In respect of applicants entitled to file an international application with the EPO as receiving Office (see **point 42**) the reduction applies if the applicant is a natural person who is a national of and resides in one of the following states: Albania (AL), Bulgaria (BG), Croatia (HR), Czech Republic (CZ), Estonia (EE), Hungary (HU), Latvia (LV), Lithuania (LT), former Yugoslav Republic of Macedonia (MK), Poland (PL), Romania (RO), Serbia (RS), Slovakia (SK), Turkey (TR). On 1 April 2012 these EPC/PCT contracting states fell within the criteria of point 5(a) of the PCT Schedule of Fees.

**180**

If the application is filed by more than one applicant, only one must be a national and resident of one of the EPC/PCT contracting states listed above, but each applicant must fulfil the criteria mentioned under point 5 of the PCT Schedule of Fees.

**181**

A list of states whose nationals/residents may satisfy the requirements for a reduction to apply is published in the PCT Newsletter.

**182**

If the EPO acts as receiving Office a reduction in the international filing fee may be obtained if the application is filed in **electronic form** (see **point 82**). The level of the reduction depends on the format in which the application is filed (PDF or XML format).

WIPO PCT Guide 5.189

**183**

The EPO as receiving Office does not accept international applications filed in PCT-EASY format. If an application is filed in that format the EPO will process it as an application filed on paper and, consequently, no reduction applies (see **point 90**).

**184**

The PCT request form contains a Fee Calculation Sheet which applicants are asked to use for calculating fees (**Annex VII**).

### ***GA B 46 Late payment of fees***

**185**

If no fees are paid within the prescribed time limits (see **point 168**), or if the amounts paid are not sufficient to cover the fees due, the EPO invites the applicant to pay the missing amount together with a late payment fee of 50% of the amount of unpaid fees but at least an amount equal to the transmittal fee.

**Art. 14(3)(a) PCT**

**R. 16bis PCT**

WIPO PCT Guide

5.193-5.196

OJ 1992, 383

**186**

The late filing fee may 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 sheet of the international application in excess of 30 sheets.

**187**

If the applicant fails to pay the prescribed fees together with the late payment fee within one month of the date of the invitation, the international application will be considered withdrawn and the receiving Office will so declare.

## **EPO Guide for Applicants, part II Int. - C The EPO as ISA and SISA**

### **GA C C.**

The EPO as an International Searching Authority (ISA) and a Supplementary International Searching Authority (SISA)

#### **I. General**

#### **II. The procedure before the EPO as ISA**

#### **III. Refusal to perform a (full) international search**

#### **IV. Supplementary International Search (SIS)**

### **GA C II.**

#### **General**

##### **188**

Since 1 July 2010 the EPO, in its capacity as an International Authority under the PCT, acts not only as an ISA and an IPEA but also as a Supplementary International Searching Authority (SISA). This chapter first sets out the procedure before the EPO acting as ISA, and at the end provides information on the procedure before the EPO acting as SISA (see **points 274 ff**). **Chapter D** provides information on the procedure before the EPO acting as IPEA.

##### **189**

The Agreement EPO-WIPO sets out particulars of the procedures before the EPO as an International Authority. The agreement dated 2 October 2007, currently in force, was last revised with effect from 1 July 2010. Annex C, Part I, of the agreement was revised with effect from 1 April 2012.

OJ 2010, 304

OJ 2012, 256

#### **The role of the EPO as ISA**

#### **Competence of the EPO as ISA**

#### **Translation**

#### **Representation before the EPO as ISA**

#### **Reduction of the search fee**

#### **Refund of the search fee**

### **GA C I 1 The role of the EPO as ISA**

##### **190**

The EPO as ISA establishes for each international application an International Search Report (ISR) and a Written Opinion of the International Searching Authority (WO-ISA) under **Chapter I PCT** (see **points 221 ff**).

##### **191**

The ISR contains, among other things, the citations of the prior art documents considered relevant, the classification of the subject-matter of the invention and an indication of the fields searched.

#### **R. 43 PCT**

##### **192**

The WO-ISA provides the applicant with a preliminary, non-binding opinion on the issues of novelty, inventive step and industrial applicability. This allows the applicant to assess, already at the search stage, whether to proceed to the national/regional phase. For this and other reasons, in some cases international preliminary examination may have no added value (see **points 301 ff**). Therefore, before taking a decision on filing a demand for international preliminary examination, applicants are advised

to consider carefully the information regarding the usefulness of the procedure under **Chapter II PCT**.

### ***GA C I 2 Competence of the EPO as ISA***

#### **193**

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, its competence to act as ISA for an international application is, as set out below, not automatically applicable (see **points 194 ff**).

**Art. 16 PCT**

**R. 35 PCT**

**Art. 152 EPC** Agreement EPO-WIPO, Art. 3(1) OJ 2010, 304

WIPO PCT Guide 7.002

**Specification by the receiving Office**

**Limited competence**

**Choice of ISA and consequences**

### ***GA C I 3 Specification by the receiving Office***

#### **194**

The EPO can act as ISA only on condition that the receiving Office where the application was filed has specified the EPO as ISA.

#### **195**

Since most receiving Offices have specified the EPO, only states that had not (yet) specified the EPO as ISA (and IPEA) on 1 April 2012 are mentioned here: United Arab Emirates (AE), Antigua and Barbuda (AG), Australia (AU), Canada (CA), China (CN), Dominica (DM), Comoros (KM), Saint Kitts and Nevis (KN), Democratic People's Republic of Korea (KP), Republic of Korea (KR), Papua New Guinea (PG). Up-to-date information is available on the WIPO website (see **point 14**).

#### **196**

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 had specified the EPO as ISA/IPEA at the date of filing.

Agreement EPO-WIPO, Art. 3(3)

OJ 2010, 304

### ***GA C I 4 Limited competence***

#### **197**

The EPO has limited its competence as ISA under certain conditions. The EPO will not carry out an international search in respect of any international application filed by a national or resident of the United States of America with the United States Patent and Trademark Office (USPTO) as receiving Office where such application contains one or more claims relating to the field of **business methods as defined in Annex A of the Agreement EPO-WIPO**.

OJ 2010, 304

#### **198**

Moreover, if the IB acted as receiving Office in respect of such an application, the EPO is not competent as ISA if the international application could have been filed with the USPTO as receiving Office, unless at least one of the applicants is a national of or has residence in an EPC contracting state (see **point 43**).

#### **199**

In respect of international applications claiming a business method and for which the limitation of competence does not apply, the EPO may also refuse to carry out a (full) international search for the reasons set out below (see **point 255**).

### ***GA C I 5 Choice of ISA and consequences***

#### **200**

If the receiving Office has specified more than one ISA, the applicant must indicate his choice of ISA in the PCT request (Box No. VII) and in the Fee Calculation Sheet (Box No. 2) (see **Annex VII**). 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.

#### **R. 4.1(b)(iv) PCT, R. 4.14bis PCT**

Agreement EPO-WIPO, Art. 3(2), Annex A(ii)

OJ 2010, 304

OJ 2009, 206

#### **201**

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 any other "European ISA"**. On 1 April 2012 the EPO, the Austrian, Finnish, Spanish and Swedish patent offices and the Nordic Patent Institute were acting as European ISAs (see **point 311**).

#### **202**

If the EPO acts as ISA, the supplementary European search report is dispensed with and so no search fee will be due on entry into the European phase (see **point 567**).

OJ 2011, 616

#### **203**

If the EPO acts as IPEA, a reduction of 50% in the fee due for examination in the European phase is granted (see **point 589**).

**Art. 14(2) RFees**

### ***GA C I 6 Translation***

#### **204**

For the purpose of the international search by the EPO as ISA the application must be written 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 with the receiving Office a translation into one of the three official languages of the EPO. Such translation must be furnished within one month of the date of receipt of the international application by the receiving Office.

#### **R. 12.3 PCT**

#### **205**

If the application was not filed with the receiving Office 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 must carefully consider in which language they submit a translation for the purpose of international search.

#### **R. 48.3 PCT**

OJ 2010, 572

**G 4/08** of 16.2.2010

#### **206**

Upon payment of the search fee, the receiving Office will promptly forward a copy of the translation and of the PCT request form ("search copy") to the EPO as ISA.

#### **Art. 12(1) PCT**

#### **R. 23.1(b) PCT**

**Language of further correspondence**

**Application filed in Dutch**

### ***GA C I 7 Language of further correspondence***



**207**

In any further correspondence with the EPO as ISA the applicant may use any of the three official languages of the EPO (see **point 164**).

**R. 92.2(b) PCT**

OJ 1993, 540

***GA C I 8 Application filed in Dutch***

**208**

An exception to the translation requirements for the purpose of international search by the EPO as ISA applies only if the application was filed with the Belgian or Netherlands patent office as receiving Office, since - although not an official language - the EPO as ISA also accepts applications drawn up in Dutch. Therefore, a translation of an international application filed in Dutch with the Belgian or Netherlands patent office is not required for the purpose of the international search by the EPO as ISA. However, within 14 months from the priority date a translation must be filed with the receiving Office in a language of publication accepted by the receiving Office for the purpose of international publication. The ISR and WO-ISA will be established in the language of the international publication. For the above reasons, filing an application in Dutch is to be carefully considered.

**R. 12.3 PCT, R. 12.4 PCT, R. 43.4 PCT, R. 48.3 PCT**

Agreement EPO-WIPO, Annex A(i)

OJ 2010, 304

***GA C I 9 Representation before the EPO as ISA***

**209**

Applicants may be represented before the EPO as ISA by the agent appointed on filing the international application and having the right to practise before the receiving Office, i.e. the agent for the international phase (see **point 36 ff**).

**Art. 49 PCT**

**R. 83.1bis(b) PCT, R. 90.1(a) PCT, R. 90.1(b) PCT, R. 90.1(d) PCT**

WIPO PCT Guide 11.001-11.014

PCT Newsletter

4/2008, 7

**210**

An applicant may also appoint an agent to represent him **specifically before the EPO in its capacity as ISA**. Moreover, the agent appointed for the international phase - and thus including for the procedure before the ISA - may appoint a sub-agent to represent the applicant specifically before the EPO as ISA. All communications issued by the ISA are sent to the agent specifically appointed for the procedure before the EPO as ISA.

**211**

Any agent specifically appointed to act before the EPO as ISA must be entitled to practise before the EPO (see **point 98**).

**212**

The requirements in respect of filing a separate power of attorney or a copy of a general power of attorney have been waived by the EPO as ISA (see **point 109**).

OJ 2010, 335

***GA C I 10 Reduction of the search fee***

**213**

The search fee to be paid if the EPO acts as ISA is reduced by 75% where the applicant or, if there are two or more applicants, **each** applicant is 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. A table containing this classification is available on the EPO website.[ 23 ]

WIPO PCT Guide 5.188-5.189

OJ 2008, 521

GL/EPO A-X, 9.3.3

#### 214

The consequence of the requirement that **each applicant** must be a natural person who is a national and resident of a state **not** party to the EPC is that any applicant with the nationality of or residence in an EPC Contracting State does, already for that reason, not fulfil the requirements for the reduction in the search fee (and the fee for international preliminary examination) but may fulfil the requirements for the reduction in the international filing fee (see **point 178**) and the handling fee (see **point 354**).

[ 23 ]

[www.epo.org/applying/forms-fees/international-fees/information.html](http://www.epo.org/applying/forms-fees/international-fees/information.html)

### *GA C I 11 Refund of the search fee*

#### 215

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 search fee paid will be refunded in part or in full depending upon the extent to which the EPO benefits from that earlier search (see **point 143**).

**R. 4.12 PCT, R. 12bis PCT, R. 16.3 PCT, R. 41.1 PCT**

WIPO PCT Guide 5.073

OJ 2009, 99

OJ 2010, 341

#### 216

No refund is made for an earlier search that was not carried out by the EPO itself and/or if priority has not been validly claimed (see **point 144**).

### *GA C II II.*

The procedure before the EPO as ISA

**General**

**Establishing the ISR and the WO-ISA**

**Multiple independent claims**

**Validity of priority claims**

**Incorporation by reference of missing parts and elements**

**Restoration of priority**

**International publication of the application and the ISR**

**Access to the WO-ISA**

**Procedure after receipt of the ISR and WO-ISA**

**International Preliminary Report on Patentability Chapter I**

**Patent Prosecution Highway (PPH) based on a WO-ISA established by the EPO as ISA**

### *GA C II 1 General*

#### 217

The objective of the international search is to discover relevant prior art. The PCT defines prior art as consisting of everything which has been made available to the public anywhere in the world by means of a written disclosure. Prior art is relevant if it is of assistance in determining whether the claimed invention is new and involves an inventive step.

**Art. 15, 27(5) PCT**

**R. 33.1 PCT**

GL/EPO B-II, 2,  
B-III, 1, E-VIII, 3

218

The definition of prior art in **Rule 33 PCT** is valid exclusively for the international phase of the procedure. This means that during the European phase the EPO applies the criteria applicable under the EPC for determining the relevant prior Art. However, the scope of an international search is equivalent to that of a European search. This means that there is **no difference between an international and a European search**, either in respect of the method and quality of the search or in respect of the sources of prior art searched.

219

The EPO conducts the international search in accordance with the ISPE Guidelines (see **point 19**). In a number of cases these guidelines leave it to the ISA concerned to choose between two or more (policy) options. A list of the options chosen by the EPO is provided in **Annex IV**.

220

In accordance with the principle of supplementary application of the EPC, the EPO as ISA applies the Guidelines for Examination in the EPO where the ISPE Guidelines are silent (see **points 16-21**).

### ***GA C II 2 Establishing the ISR and the WO-ISA***

221

For each application the EPO as ISA issues both an International Search Report (ISR) or, in exceptional cases, a "declaration of non-establishment of the ISR" (see **point 252**) and a Written Opinion of the International Searching Authority (WO-ISA).

**Art. 12 PCT, Art. 18 PCT**

**R. 43 PCT, R. 43bis PCT, R. 44 PCT**

OJ 2003, 574

222

The procedure for establishing the ISR and the WO-ISA is similar to that for establishing the European search report and the European Search Opinion (ESOP).

223

The WO-ISA provides the applicant with a preliminary non-binding written opinion on the question whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. A WO-ISA established by the EPO as ISA will be comparable to the written opinion established by the EPO for a Euro-direct application (ESOP) (see **point 218**).

**Art. 33 PCT**

224

Where appropriate the WO-ISA will also provide an opinion on issues such as added subject-matter, unity of invention, insufficiency of disclosure, support for the claims in the description, clarity, conciseness and formal defects (e.g. missing reference signs).

225

The WO-ISA may be positive or negative. A WO-ISA is qualified as positive if it contains no objections or only minor objections which would not hinder a direct grant in the European phase. In any other case the WO-ISA is considered negative (see **point 228**).

226

The ISR is established and then transmitted to the applicant and the IB within three months from receipt of the search copy of the application at the EPO or within nine months from the earliest priority date, whichever time limit expires later.

**R. 23, 42 PCT**

WIPO PCT Guide 7.023

GL/ISPE 16.03

227

The WO-ISA will be prepared at the same time as the ISR for delivery together with the ISR to the applicant and the IB. The EPO sends the ISR including the WO-ISA to the applicant together with a copy of each document cited in the ISR.

228

If the EPO acted as ISA (but not as IPEA), the applicant must provide a substantive response to any deficiencies set out in the WO-ISA ("negative WO-ISA") upon entry into the European phase ("mandatory response") (see **points 493 ff**).

**R. 161 EPC**

GL/EPO E-VIII, 3.2

### ***GA C II 3 Multiple independent claims***

229

As a rule the WO-ISA provides an opinion on all searched claims. However, if there are multiple independent claims only one independent claim in each category is dealt with in detail. In respect of further independent claims short comments are made. Where appropriate an objection as to clarity and conciseness under **Article 6 PCT** may be raised. Further, the ISA may exercise its discretion to ask the applicant to clarify the subject-matter to be searched (see **point 259**).

**Art. 6 PCT**

### ***GA C II 4 Validity of priority claims***

230

If at the time the search is conducted the priority document(s) is (are) not available to the ISA, the search will be conducted as if the priority claim(s) is (are) valid.

### ***GA C II 5 Incorporation by reference of missing parts and elements***

231

If the receiving Office has granted a request for incorporation by reference under **Rules 4.18** and **20.6 PCT** (see **point 54 ff**) but the EPO as ISA does not consider the relevant part(s) and/or element(s) completely contained in the priority application, it will indicate this negative finding in the WO-ISA, for instance if the missing text has been inserted into the description of the application in such a way that it does not have exactly the same meaning as in the priority document.

**R. 4.18, 20.6 PCT**

232

Furthermore the search will be extended to cover all prior art that will be relevant if, in accordance with the ISA's finding, the international application is re-dated by a designated Office in the national phase. Re-dating of the filing date can be avoided on condition that the applicant withdraws the later filed missing parts or elements that are not considered completely contained in the priority application (see **point 54 ff**).

### ***GA C II 6 Restoration of priority***

233

The EPO as ISA must consider any priority claim to be valid if the international application claiming the priority right is filed within two months after expiry of the priority year ("retention principle"). Therefore, even if no request for restoration of priority has been filed or if such a request has been rejected or has not yet been decided on at the time the international search is carried out, this has no bearing on the procedure before the ISA (see **point 134**).

**R. 26bis.2(c) PCT**

### ***GA C II 7 International publication of the application and the ISR***

234

The international publication of the international application by the IB takes place promptly after expiry of 18 months from the priority date. If the ISR is available at that time it will be published together with the application. If not, the ISR is published separately from the international application on receipt by the IB.

**Art. 21 PCT**

**R. 48 PCT**

**235**

Unlike the ISR, the WO-ISA will not be published.

OJ 2003, 574

### ***GA C II 8 Access to the WO-ISA***

**236**

The IB and the ISA will not, unless authorised by the applicant, allow anyone access to the WO-ISA before the expiry of 30 months from the priority date. After that date the EPO as designated Office will grant access to the WO-ISA. If the application is the subject of international preliminary examination by the EPO as IPEA, the WO-ISA established by the EPO as ISA will be considered a first written opinion for the purposes of the procedure under **Chapter II PCT** and may as such become public as part of the **Chapter II PCT** file even before expiry of the 30-month time limit (see **point 403**).

**R. 44ter PCT, R. 94.2, 94.3 PCT**

WIPO PCT Guide 7.031-7.032

OJ 2007, Spec.Ed.3, J.2, J.3

### ***GA C II 9 Procedure after receipt of the ISR and WO-ISA***

**237**

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 **point 301 ff**).

**Art. 19 PCT**

**R. 46 PCT**

PCT Newsletter 10/2004, 7

3/2005, 8

6/2010, 8

**Amendments under Article 19 PCT**

**Informal comments**

**Demand for international preliminary examination**

### ***GA C II 10 Amendments under Article 19 PCT***

**238**

Amendments under **Article 19 PCT** are published by the IB. They are particularly useful if there is a reason to better define the scope of the claims for the purpose of securing provisional protection in the PCT contracting states offering it (see **point 642**).

WIPO PCT Guide 9.004-9.011

**239**

If the applicant wishes to file amendments to the claims, he must submit a complete set of the claims in replacement of all claims originally filed. Further, the basis for the amendments in the application as filed must be indicated in an accompanying letter.

**Art. 19 PCT**

**R. 46.4 PCT and R. 46.5 PCT, R. 70.2 PCT**

WIPO PCT Guide  
9.004-9.011  
Section 205 AI  
PCT Newsletter  
9/2010, 12

**240**

Amendments under **Article 19 PCT** are to be filed **exclusively with the IB in the language of the international publication**.

PCT Newsletter 6/2010, 8

**241**

Any amendment to the claims under **Article 19 PCT** is to be made:

**R. 46.1 PCT**

—

within two months from the date of transmittal of the search report, or

—

within 16 months from the (earliest) priority date,  
whichever time limit expires later.

Later filed amendments are accepted if they are received before the technical preparations for international publication have been completed.

***GA C II 11 Informal comments***

**242**

If the applicant wishes to file informal comments he may file them exclusively with the IB. Informal comments must be in the language of the international publication and may be submitted only during the international phase, i.e. within 30 months from the (earliest) priority date, but preferably before expiry of 28 months from the priority date. The IB will not send such comments to the IPEA.

WIPO PCT Guide 7.030

***GA C II 12 Demand for international preliminary examination***

**243**

If a demand for international preliminary examination under **Chapter II PCT** is or will be filed, any response to the WO-ISA must be submitted to the IPEA in the form of amendments and/or arguments under **Article 34 PCT** as part of the preliminary examination procedure (see **point 362 ff**).

WIPO PCT Guide 7.030

***GA C II 13 International Preliminary Report on Patentability Chapter I***

**244**

If no demand for international preliminary examination is filed, the WO-ISA will be converted by the IB into an International Preliminary Report on Patentability (IPRP Chapter I). Further, it will be communicated to all designated Offices on expiry of 30 months from the priority date. A copy is promptly sent to the applicant. Any informal comments received will be annexed to the IPRP Chapter I.

**R. 44bis PCT, R. 93bis.1 PCT**

**245**

The IPRP Chapter I, together with any informal comments, will be made available for public inspection at the IB, but not before expiry of 30 months from the priority date. The same applies to the WO-ISA (see **point 236**).

**R. 44ter PCT, R. 94.1(b) PCT**

GL/EPO E-VIII, 2.10

***GA C II 14 Patent Prosecution Highway (PPH) based on a WO-ISA established by the EPO as ISA***

**246**

The PPH enables applicants whose claims have been determined to be patentable/allowable to have a corresponding application that 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[ **24** ].

OJ 2012, 32

OJ 2012, 89

**247**

Under the PCT-PPH pilot programme a PPH request can be based on the latest PCT work product, i.e. the WO-ISA or the IPER. Where the EPO is the ISA (and/or IPEA) and the international application contains claims that are determined to be patentable/allowable by the EPO as ISA (and/or IPEA), the applicant may under the PPH request accelerated examination at the JPO and the USPTO when the application has entered the national phase before these offices.

**248**

The procedures and requirements for filing a request with the JPO and the USPTO for participation in the PCT-PPH pilot programme are available from the JPO and USPTO websites[ **25** ]. The pilot programme runs until 28 January 2014.

**249**

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. For more information on the PACE programme reference is made to **point 441** ff.

OJ 2010, 352

[ **24** ]

For information see [www.trilateral.net/index.html](http://www.trilateral.net/index.html)

[ **25** ]

See [www.jpo.go.jp](http://www.jpo.go.jp) and [www.uspto.gov](http://www.uspto.gov)

***GA C III III.***

Refusal to perform a (full) international search

**When may the EPO refuse to conduct a (full) search?**

**No search**

**Incomplete search**

**Limitations related to the subject-matter**

**Complex applications**

**Nucleotide and amino acid sequences**

**Lack of unity of invention**

**Protest procedure**

***GA C III 1 When may the EPO refuse to conduct a (full) search?***

**250**

There are several reasons why the EPO as ISA may refuse or will not be able to perform a (full) international search. Such refusal may relate to e.g. the subject-matter of the application (see **point 254**), non-compliance with requirements regarding the description, claims or drawings of the application (see **point 257**), missing sequence listings (see **point 260**) or lack of unity of invention (see **point 262** ff).

**251**

With regard to the (further) procedure in the international phase, it is noted that if a claim relates to an invention in respect of which no ISR has been established, the EPO as IPEA will not carry out



international preliminary examination in respect of that claim (see **point 382**). This also applies if amendments and/or arguments under **Article 34 PCT** have been filed.

**R. 66.1(e) PCT**

### ***GA C III 2 No search***

#### **252**

If no search at all is performed, the EPO as ISA will establish a "declaration of non-establishment of the ISR" instead of an ISR and give reasons for the decision in that declaration and in the WO-ISA.

**Art. 17(2)(a) PCT**

PCT Newsletter 10/2007, 7

### ***GA C III 3 Incomplete search***

#### **253**

If any of the reasons listed above for not performing an international search exists with respect to certain claims only, an ISR and a WO-ISA will be established in respect of the other claims. In that case the international search will be incomplete.

**Art. 17(2)(b) PCT**

### ***GA C III 4 Limitations related to the subject-matter***

#### **254**

The EPO is not required to perform an international search and to establish an ISR 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**. Here, 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 PCT** is used by the EPO as ISA only to the extent that such subject-matter is not searched under the provisions of the EPC.

**Art. 17(2)(a)(i) PCT**

**R. 39.1 PCT**

WIPO PCT Guide 7.013

Agreement EPO-WIPO, Art. 4,

Annex B

OJ 2010, 304

GL/EPO **B-VIII**,

**B-VIII, 1-B-VIII, 3**

**Business methods**

### ***GA C III 5 Business methods***

#### **255**

Attention is drawn to the field of business methods (see **point 197**). 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.

**R. 39.1(iii) PCT**

OJ 2007, 592

#### **256**

Furthermore, if the claimed subject-matter involves technical means an ISR will be established. 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 of their notoriety, and no



document will be cited in the ISR. Instead a statement will be inserted that these technical means are considered so commonplace that no citation is considered necessary.

### ***GA C III 6 Complex applications***

#### **257**

Furthermore, the EPO as ISA will in exceptional cases not perform an international search or will perform a search limited to parts of the claimed subject-matter if the application documents fail to comply with the prescribed requirements to such an extent that a meaningful search is impossible for all or part of the claims; these kinds of applications are often referred to as "complex applications".

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

**Art. 150(2) EPC**

OJ 2000, 228

GL/EPO B-VIII, 3.1

#### **258**

Complex applications will be dealt with in accordance with the ISPE Guidelines supplemented, where appropriate, by the EPO's practice as set out in the Guidelines for Examination (GL/EPO) (see **points 16-21**).

#### **259**

Before taking a decision under **Article 17(2)(a)(ii) PCT** the ISA may invite the applicant informally to provide clarification of the claimed subject-matter in accordance with paragraphs 9.34 and 9.35 of the ISPE Guidelines.

OJ 2011, 327

### ***GA C III 7 Nucleotide and amino acid sequences***

#### **260**

If the sequence listing of an international application is not available in electronic form and/or does not comply with the standard provided in Annex C to the Administrative Instructions (WIPO Standard ST.25), the EPO as ISA will invite the applicant to furnish the sequence listing in the required form and format and pay a late furnishing fee within a non-extendable time limit of one month from the date of the invitation. A paper version of the sequence listing does not have to be submitted. Extensive information is provided in a Notice from the EPO of 26 March 2010.

**R. 5.2, 13ter.1 PCT**

WIPO PCT Guide 7.005-7.012

**Art. 3 RFees**

OJ 2005, 225

OJ 2007, Spec.Ed.3,

C.2

OJ 2011, 372

OJ 2011, 376

OJ 2011, 658

OJ 3/2012, Supplement

GL/EPO A-IV, 5; E-VIII, 2.4.2

#### **261**

If, within the time limit set, the applicant has not submitted the sequence listing in the required electronic form and format 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 without such listing. This means that in many cases no or only an incomplete search is performed. This also has consequences for the international preliminary examination procedure before the EPO as IPEA (see **point 382**).

### ***GA C III 8 Lack of unity of invention***

**262**

If the EPO as ISA considers that the international application claims more than one invention, stating the reasons for its finding it invites the applicant to pay for each further invention an additional search fee, which must be paid direct to the EPO. At the same time the EPO informs the applicant of the result of its partial international search, which is restricted to those parts of the application relating to the invention first mentioned in the claims.

**Art. 17(3)(a) PCT**

**R. 13, 40 PCT**

**R. 158(1) EPC**

**Art. 2.2 RFees**

OJ 1989, 61

GL/ISPE 10.01-10.78

**263**

If the applicant fulfils the requirements for reduction of the search fee, any additional search fee is validly paid upon payment of the reduced amount (see **point 213**).

**264**

If the applicant does not pay any additional search fee, the EPO establishes the ISR and WO-ISA on the basis of the result already communicated. The WO-ISA will contain the reasons for any non-unity objection raised.

**265**

If the applicant pays one or more additional search fee(s) within the time limit set, those parts of the application for which additional search fees have been paid will also be searched. Consequently the ISR and WO-ISA will be established for all inventions for which a search fee has been paid.

**Cascading non-unity**

**Consequences of non-payment of additional fee(s)**

***GA C III 9 Cascading non-unity***

**266**

If in response to an invitation by the EPO as ISA additional search fees are paid and the additional search(es) performed reveal(s) a further lack of unity ("a posteriori"), no further invitation to pay additional search fees is issued and the international search is limited to the first invention of each further invention for which an additional fee was paid. If a cascading lack of unity of invention is likely to arise, the invitation to pay additional search fees will contain a warning.

***GA C III 10 Consequences of non-payment of additional fee(s)***

**267**

The lack of an ISR and WO-ISA in respect of those parts of the international application for which no additional search fee was paid does not, of itself, have any influence on the validity of the international application. However, the national law of any designated Office may provide that the non-searched parts are considered withdrawn unless a special fee is paid. For further information see the national chapter for the designated Office concerned in the WIPO PCT Guide.

**Art. 17(3)(b) PCT**

WIPO PCT Guide 7.021

**268**

If the EPO is ISA, non-payment of an additional search fee has the following important consequences in the further procedures before the EPO:

**R. 66.1(e) PCT**

—

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 **point 382**)

—

upon entry into the European phase the EPO as designated Office will consider whether the application, which in the meantime may have been amended by the applicant, meets the requirement of unity of invention. If not, the examining division will invite the applicant to restrict the application to one single invention. Where not all inventions contained in the application were searched by the EPO because of non-payment of an additional search fee, the applicant must restrict the application to one of the inventions covered by the ISR (or the SISR, see **point 293**). Since an unsearched invention may only be pursued in the European phase by filing a divisional application a decision on non-payment of additional search fees in the international phase is to be well considered (see **point 635**).

**R. 164 EPC**

GL/EPO E-VIII, 2.4.1

### ***GA C III 11 Protest procedure***

#### **269**

An applicant may pay an additional search fee under "protest". This means that at the time of payment of the additional fee(s) the applicant objects to the finding of lack of unity in a written reasoned statement filed with the EPO as ISA. Such objections may concern the finding of non-unity as such or the number of the required additional fees. The lodging of a protest does not delay the search itself.

**R. 40.2(c), (e) PCT**

**R. 158(3) EPC**

**Art. 2.21 RFees**

OJ 2010, 320, 322

#### **270**

For applications filed on or after 13 December 2007, the date of entry into force of the EPC 2000, a **one-stage protest procedure** as set out in **Rule 40.2 PCT** applies. According to this procedure the only body examining a protest before the EPO as ISA is a review panel consisting of three members: the head of a directorate, normally the head of the directorate by which the invitation to pay additional fees was issued, an examiner with special expertise in unity of invention and, normally, the examiner who issued the invitation. The boards of appeal are no longer competent to decide on protests in respect of any international application filed on or after 13 December 2007.

#### **271**

For applications pending on 13 December 2007 the **two-stage procedure** in force since 1 April 2005 continues to apply.

#### **272**

Both procedures are set out in detail in the Notice from the EPO dated 24 March 2010. In the following only the one-stage protest procedure is summarised.

OJ 2010, 322

### **One-stage protest procedure**

### ***GA C III 12 One-stage protest procedure***

#### **273**

Where additional fees are paid under protest and the protest fee is duly paid, the protest will be referred to the review panel for a decision in first and last resort. If the review panel finds that the protest was entirely justified, the additional fees and the protest fee will be refunded. If the review panel finds that the protest was justified only in part, the corresponding additional fees will be refunded, but not the protest fee.

### ***GA C IV IV.***

Supplementary International Search (SIS)

**General**

**Scope and limitations of SIS**

**Requirements for filing a SIS request**

**Representation before the EPO as SISA**  
**Lack of unity of invention**

***GA C IV 1 General***

**274**

In its capacity as the International Searching Authority specified for supplementary international search - hereafter referred to as the Supplementary International Searching Authority or SISA - the EPO will carry out a supplementary international search (SIS) at the applicant's request.

**R. 45bis ff PCT**

Agreement EPO-WIPO, Annex E

OJ 2010, 304

WIPO PCT Guide 8.001-8.053

OJ 2010, 316

PCT Newsletter 4/2011, 9

1/2012, 10

**275**

For an overview of the general procedure reference is made to the information in the WIPO PCT Guide. For specific information on the procedure before the EPO acting as SISA reference is made to Annex E to the Agreement EPO-WIPO and the May edition of the Official Journal 2010.

**276**

A SIS request may be filed with the EPO as SISA in respect of international applications for which on 1 July 2010 the time limit of 19 months from the priority date had not yet expired.

**277**

The purpose of SIS is to provide the applicant with a supplementary international search report (SISR) in addition to the search carried out under **Article 15 PCT** by the competent ISA ("main search") (see **point 221**). In particular, in view of the growing linguistic diversity of the prior art and considering the language knowledge available in the EPO, a SISR established by the EPO can be very useful to applicants.

**278**

Since the SISR is established within 28 months from the priority date it may improve the basis for deciding on national phase entry and - in particular where a SISR is drawn up by the EPO - on whether or not to enter into the European phase. SIS reduces the risk of an applicant being faced with relevant prior art only after incurring considerable expenditure for entry into the national/regional phase.

**279**

In the procedure before the EPO as SISA no written opinion is established. However, the EPO will provide explanations in an annex to the SISR ("Scope Annex") which are of equal value to the information contained in a written opinion established by the EPO as ISA (WO-ISA) (see **point 223**).

**280**

If the EPO has acted as SISA and established a SISR **no supplementary European search report will be drawn up in the European phase**. Further, the applicant will be invited in a communication under **Rule 161 EPC** to correct any deficiencies set out in the Scope Annex to the SISR upon entry into the European phase (see **point 497**).

**Art. 153(7) EPC**

**R. 161 EPC**

OJ 2009, 594

***GA C IV 2 Scope and limitations of SIS***

**281**

The scope of the search conducted by the EPO as SISA - i.e. the documentation searched - is the same as for any international search performed by the EPO as ISA (see **point 218**).

**282**

SIS is conducted on the international application as originally filed, and neither amendments filed under **Article 19 PCT** and/or **Article 34 PCT** nor informal comments will be taken into account.

**R. 45bis.5(b) PCT**

**283**

If the ISR is available at the time the SIS is performed, it will be taken into account. Any prior art document mentioned in the ISR is not re-cited in the SIS, unless the EPO qualifies its relevance differently.

**284**

The EPO conducts a maximum of 700 supplementary searches per year.

**285**

The **limitations related to subject-matter** set out in Annex A to the Agreement EPO-WIPO apply both where the EPO acts as ISA and where it acts as SISA (see **point 254 ff**). The same applies as to any other reason for non-establishment of a (full) search, i.e. complex applications, missing sequence listings and non-unity (see **point 256 ff**). As to particulars of the procedure in case of a missing sequence listing and non-unity, reference is made to **points 289** and **293**.

**286**

Further, where the EPO acts as SISA it may decide not to search claims that were not searched by the ISA. However, if the EPO, had it been the ISA for the international application, would have searched the claims concerned, it will not exercise its discretion not to search these claims if it acts as SISA.

**R. 45bis.5(c) PCT, R. 45bis.5(d) PCT, R. 45bis.5(e) PCT**

***GA C IV 3 Requirements for filing a SIS request***

**287**

A SIS request must be filed **with the IB** within 19 months from the priority date. The request is valid only if the supplementary search fee and the supplementary search handling fee are validly paid **to the IB** in Swiss francs.

**R. 45bis.2 PCT and R. 45bis.3 PCT**

OJ 2009, 99

OJ 2010, 341

**288**

If the application was not filed in English, French or German, and no **translation** into any of these languages has been filed for the purpose of the proceedings before the ISA or for the purpose of international publication, a translation into one of these languages must be filed with the IB together with the SIS request.

**R. 45bis.1(b)(iii) PCT**

**289**

Where applicable the applicant must together with the SIS request also furnish **to the IB** a copy of the **sequence listing** in electronic form complying with the standard provided for in Annex C to the Administrative Instructions (see **point 260 ff**). The EPO will start the supplementary international search only upon receipt of the 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 the late furnishing fee.

**R. 13ter PCT, R. 45bis.5 PCT**

Agreement EPO- WIPO, No. 4 Annex E

OJ 2010, 316 under 4

***GA C IV 4 Representation before the EPO as SISA***

**290**

Applicants may be represented before the EPO as SISA by the agent appointed on filing the international application and having the right to practise before the receiving Office, i.e. the agent for the international phase (see **point 36 ff**).

**Art. 49 PCT**

**R. 83.1 PCT, R. 90.1(a) PCT, R. 90.1(b) PCT, R. 90.1(b-bis) PCT, R. 90.1(d) PCT**  
OJ 2010, 335

**291**

An applicant may also appoint an agent to represent him **specifically before the EPO in its capacity as SISA**. Moreover, the agent appointed for the international phase - and thus including for the procedure before the SISA - may appoint a sub-agent to represent the applicant specifically before the EPO as SISA. All communications issued by the EPO as SISA are sent to the agent specifically appointed for the procedure before the EPO as SISA. An agent specifically appointed to act before the EPO as SISA must be entitled to practise before the EPO (see **point 97**).

**292**

The requirements in respect of filing a separate power of attorney or a copy of a general power of attorney have been waived by the EPO as SISA (see **point 109**).

### ***GA C IV 5 Lack of unity of invention***

**293**

If the EPO as SISA is of the opinion that the international application claims more than one invention, stating the reasons for its finding it will perform a search only for those parts of the application relating to the main invention, i.e. the invention first mentioned in the claims. If, however, the ISA has already made a non-unity objection and the applicant has, upon filing the SIS request, specified for which invention identified in the ISR the SISR is to be drawn up, the EPO as SISA:

**R. 45bis.1(d) PCT, R. 45bis.6 PCT**

**Art. 2.22 RFees**

OJ 2010, 320, 322

—

will restrict its search to that invention, if it agrees with the finding of the ISA;

—

will take the applicant's wish into account as far as possible, if the non-unity objection made by the ISA is not followed but a different non-unity objection is found;

—

will perform a full search if it considers the requirement of unity of invention to be met.

**294**

In the case of a non-unity finding by the EPO as SISA, the applicant cannot pay additional search fees to obtain further searches as in the procedure before the ISA (see **point 262**). However, the applicant may request a review of a non-unity finding within one month of the date of the notification of the SISR, on condition that the review fee set by the EPO is paid within the same time limit. The review fee must be paid directly to the EPO. If the review panel considers the lack of unity objection (partly) justified, a revised SISR taking into account the outcome of the review procedure is established.

**295**

Upon entry into the European phase the EPO as designated/elected Office will consider whether the application for which it acted as SISA - and which meanwhile may have been amended - meets the requirement of unity of invention and whether protection is sought for an invention covered by the SISR. If not, the examining division will invite the applicant to limit the application to a single invention covered by the SISR. Any other invention may be pursued in the European phase only by filing a divisional application (see **point 645**).

**R. 164 EPC**

OJ 2009, 582

GL/EPO E-VIII, 2.4.1

## **EPO Guide for Applicants, part II Int. - D The EPO as an IPEA**

### **GA D D.**

The EPO as an International Preliminary Examining Authority (IPEA) - PCT Chapter II PCT

#### **I. General**

#### **II. The international preliminary examination procedure before the EPO as an IPEA**

### **GA D I I.**

General

**Aim of the international preliminary examination**

**Usefulness of PCT Chapter II**

**Patent Prosecution Highway (PPH) based on an IPER established by the EPO as IPEA**

**Competence of the EPO as an IPEA**

**Who may file a demand for international preliminary examination with the EPO?**

**How and where is the demand for international preliminary examination to be filed?**

**When should the demand for international preliminary examination be filed with the EPO?**

**Start of the international preliminary examination**

**Delaying of national phase until expiry of 30 months**

**Time limit for establishing the IPER**

**Translation of the international application**

**Language of the demand**

**Representation**

**Which states may be elected?**

**Signature**

**Fees**

**Defects in the demand and how they can be corrected**

### ***GA D I I Aim of the international preliminary examination***

#### **296**

In its capacity as IPEA the EPO will carry out an international preliminary examination on condition that the applicant has (validly) filed a "demand" and paid the fees due. The usefulness of this optional procedure depends on the international application concerned and, especially, on the result of the international search (see **point 221 ff**). Therefore, before taking a decision whether to file a demand with the EPO as IPEA, applicants are strongly recommended to take special note of the information set out in part II of this chapter (see **point 299 ff**).

#### **297**

The purpose of the international preliminary examination under **Chapter II of the PCT** is not grant or refusal of a patent, but provision of 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 as defined in **Article 33 PCT**. The statement whether these criteria are satisfied is set out in the International Preliminary Report on Patentability ("IPRP Chapter II") established by the IPEA.

**Art. 33 PCT PCT, Art. 35 PCT**

**R. 64 PCT, R. 65 PCT, R. 67-70 PCT**

WIPO PCT Guide 10.001-10.003

OJ 2003, 574

OJ 2011, 532

#### **298**



While there is not a fully uniform approach to the criteria for patentability in the national laws of the PCT contracting states, their application during international preliminary examination is such that IPRP Chapter II provides the applicant with a good basis on which to evaluate the chances of obtaining patents in the procedures before the various designated Offices in the national phase.

299

The term "IPRP Chapter II" is no more than a different name for the international preliminary examination report (IPER). Both terms refer to the same document; the report established by the competent IPEA containing the result of the international preliminary examination carried out by it. In the following the term IPER will be used.

**R. 70.15(b) PCT**

300

As set out above, the applicant may react to the ISR and WO-ISA established by the ISA by filing amendments under **Article 19 PCT** or "informal comments" with the IB, or by filing a demand for international preliminary examination (see **point 316 ff**). Should the applicant decide to file a demand for international preliminary examination, the demand form together with amendments and/or arguments under **Article 34 PCT** are to be filed directly with the competent IPEA (see **point 319 ff**).

***GA D I 2 Usefulness of PCT Chapter II***

301

Regardless of whether a demand is filed, applicants will receive a preliminary non-binding written opinion on the patentability of their claimed invention (WO-ISA, IPRP Chapter I) as part of the international search procedure (see **point 221 ff**). Therefore, the usefulness of international preliminary examination under **Chapter II PCT** must be considered carefully for each international application.

PCT Newsletter 4/2010, 8

5/2010, 8

302

International preliminary examination will, in general, have no added value unless amendments and/or arguments under **Article 34 PCT** are filed for the EPO to take into account as IPEA. In the absence of such amendments and/or arguments there will be no reason for the EPO as IPEA to come to a different conclusion to that which it reached in its capacity as ISA, as set out in the WO-ISA.

303

If the ISA has provided the applicant with a declaration under **Article 17(2) PCT** that no ISR has been established ("declaration of no search"), filing a demand is not recommended, since the EPO as IPEA will not examine claims for which no ISR has been established (see **point 382**).

304

It follows that filing a demand for international preliminary examination is, in general, useful only if the WO-ISA was "negative" and the applicant is of the opinion that his amendments and/or arguments filed for the purpose of the **PCT Chapter II** procedure may lead to a "positive" IPER. In other words, international preliminary examination gives the applicant the opportunity to respond to any negative finding of the ISA during the international phase, as opposed to drafting and filing multiple responses with the national/regional offices where national phase entry is made.

***GA D I 3 Patent Prosecution Highway (PPH) based on an IPER established by the EPO as IPEA***

305

The PPH enables an applicant whose claims have been determined to be patentable/allowable to have a corresponding application that 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 2012, 32

OJ 2012, 89

306



Under the PCT-PPH pilot programme, a PPH request filed with the JPO and the USPTO can also be based on an IPER established by the EPO as IPEA. For more information reference is made to **point 246 ff.**

**307**

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. For more information on the PACE programme reference is made to chapter E (see **points 441 ff.**).

OJ 2010, 352

***GA D I 4 Competence of the EPO as an IPEA***

**308**

Although the EPO's competence as an IPEA is in principle **universal**, i.e. not restricted to international applications from e.g. EPC contracting states, restrictions of various nature do limit its competence (see **points 309 ff.**). In particular it is stressed that the EPO is competent to act as IPEA only if a "European ISA" carried out the international search (see **point 311**).

**Art. 32 PCT**

**R. 59.1 PCT**

WIPO PCT Guide 10.006

**Specification by the receiving Office**

**The EPO or a European ISA acted as ISA**

**Choice of applicant**

**Limited competence**

***GA D I 5 Specification by the receiving Office***

**309**

The EPO acts as an IPEA for any application, **on condition that the receiving Office with which the international application was 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 **point 194**). Up-to-date information is available in the annexes to the WIPO PCT Guide (see **point 12**).

**Art. 32 PCT**

Agreement EPO-WIPO, Art. 3(2), (3)

OJ 2010, 304

**310**

Where the international application was 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.

***GA D I 6 The EPO or a European ISA acted as ISA***

**311**

The EPO will, however, only act as an IPEA if the international search was also carried out by the EPO or by the Austrian, Finnish, Spanish or Swedish patent office or the Nordic Patent Institute. Applicants considering their choice of ISA (PCT request form Box No. VII) are advised to bear this in mind (see also **point 200**).

Agreement EPO-WIPO, Art. 3(2), Annex A(ii)

OJ 2010, 304

***GA D I 7 Choice of applicant***

**312**

Where several IPEAs are competent in relation to a particular application, the applicant may choose. Here, it must be considered that where the EPO as IPEA has drawn up the IPER the examination fee due in the European phase is reduced by 50% if the subject-matter to be examined is covered by the IPER (see **point 589**).

**R. 35.2, 59.1 PCT**

**Art. 14(2) RFees**

### ***GA D I 8 Limited competence***

#### **313**

The EPO has limited its competence as IPEA under certain conditions. The EPO will not carry out international preliminary examination in respect of any international application filed by a national or resident of the United States of America with the USPTO or the IB as the receiving Office, where such application contains one or more claims relating to the field of **business methods** as defined in Annex A of the Agreement EPO-WIPO (see **point 197**).

Agreement EPO-WIPO, Annex A

OJ 2010, 304

#### **314**

Even if the EPO is competent as IPEA for an application claiming a business method, it may be that the EPO will not perform an examination for the reasons set out hereafter (see **point 382 ff**).

OJ 2007, 592

#### **315**

Where the IB was receiving Office, the EPO is not competent as IPEA for international applications relating to business methods (see **point 197**), if the international application could have been filed with the USPTO, unless the application could also have been filed with the EPO as receiving Office.

### ***GA D I 9 Who may file a demand for international preliminary examination with the EPO?***

#### **316**

**Sole** applicants must have their residence in, or be a national of, a PCT contracting state bound by **PCT Chapter II**. If there are **two or more applicants**, at least one of them must meet 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**.

**Art. 31(2)(a) PCT**

**R. 18.1 PCT, R. 54.1 PCT, R. 54.2 PCT**

**Art. 152 EPC**

WIPO PCT Guide 10.004, 10.017

#### **317**

At 1 July 2010, all PCT contracting states were bound by **Chapter II PCT** and, therefore, these requirements do not stand in the way of any applicant wishing to file a demand for a pending international application.

### ***GA D I 10 How and where is the demand for international preliminary examination to be filed?***

#### **318**

The demand for international preliminary examination must be made using the prescribed form (PCT/IPEA/401 - see **Annex IX**), copies of which are available free of charge from all receiving Offices, the IB and the EPO. The form may also be downloaded from the WIPO website[ **26** ].

**Art. 31(3) PCT**

**R. 53 PCT**

WIPO PCT Guide 10.012

GA D I 11 When should the demand for international preliminary examination be filed with the EPO?

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**319**

The demand and any further document relating to the **Chapter II PCT** procedure (e.g. amendments and/or arguments filed under **Article 34 PCT**) **must be submitted to the EPO as IPEA and not to the receiving Office or the IB**. The EPO as IPEA will indicate the date of receipt on the demand and promptly notify the applicant of that date.

**Art. 31(6) PCT, Art. 34(2)(b) PCT**

**R. 59.3, 61 PCT**

WIPO PCT Guide 10.006

**320**

The demand may be filed with the EPO as IPEA direct, by post or by fax (see **points 66-77**). The demand cannot be filed in electronic form yet. As soon as electronic filing of the demand becomes available, a notice will be published in all relevant sources of information (see **point 11 ff**).

**321**

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 (see **point 77**).

**R. 92.4(e), (g) PCT**

OJ 2007, Spec.Ed.3, A.3 (Art. 3 and 7 of the Decision)

**322**

The EPO filing offices are located in the Central European Time (CET) zone (see **Annex V**).

[ 26 ]

[www.wipo.int/export/sites/www/pct/en/forms/demand/ed\\_demand.pdf](http://www.wipo.int/export/sites/www/pct/en/forms/demand/ed_demand.pdf)

### ***GA D I 11 When should the demand for international preliminary examination be filed with the EPO?***

**323**

Pursuant to **Rule 54bis PCT**, the demand may be validly submitted at any time prior to expiry of whichever of the following periods expires later:

**R. 54bis PCT**

WIPO PCT Guide 10.010

–

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.

**324**

This time limit guarantees that the applicant has at least three months from the date of mailing of the ISR to decide on the basis of the result of the international search laid down in the ISR and the WO-ISA whether he wants to file a demand with amendments and/or arguments.

**325**

If the demand is submitted after expiry of this time limit, the demand is considered as if it had **not been submitted**.

**R. 54bis.1(b) PCT**

**326**

The applicant should be aware that the possibilities to withdraw a demand and obtain a refund of the fee paid are limited (see **point 359**).

**R. 90bis.4 PCT**

### ***GA D I 12 Start of the international preliminary examination***

**327**

The EPO as IPEA will not start examination before expiry of the time limit laid down in **Rule 54bis PCT**, unless the applicant requires an earlier start. Amendments and/or arguments under **Article 34**

**PCT** filed after filing of the demand, but before expiry of this time limit, must always be taken into account for international preliminary examination (see **point 363**).

**R. 66.1 PCT, R. 66.4bis PCT, R. 69.1(a) PCT**

WIPO PCT Guide 10.051

PCT Newsletter 03/2005, 8

**328**

Where the WO-ISA is considered a first written opinion (see **point 372**), a single extension of one month for filing a reply (amendments and/or arguments under **Article 34 PCT**) is in principle granted if requested before expiry of the normal time limit under **Rule 54bis PCT** and on condition that the time limit so extended does not expire later than 25 months from the (earliest) priority date (see also **point 380**). **The extension does not apply to the time limit for filing the demand, which cannot be extended.**

**Art. 34(2)(c) PCT**

### ***GA D I 13 Delaying of national phase until expiry of 30 months***

**329**

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 from the (earliest) priority date.

**Art. 22(1), 39(1) PCT**

WIPO PCT Guide 10.010, 10.050

**330**

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 (see **points 414 ff**).

**R. 159(1) EPC**

**331**

However, in respect of a small number of designated Offices, old **Article 22(1) PCT** still applies. The list of the contracting states for which that provision is still applicable is published on the WIPO website (see **point 12**). According to the latest information from WIPO available on 9 February 2012, the 20/21-month time limit applies to the following states: Luxembourg (LU), United Republic of Tanzania (TZ) and Uganda (UG). However, in respect of the **regional** designation of each of these states, the time limit under amended **Article 22 PCT** applies[ **27** ].

PCT Newsletter 2/2005, 6

**332**

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 from 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.

**333**

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 have as a consequence that the 19-month time limit is changed, since this time limit is exclusively calculated on the basis of the (earliest) priority date.

WIPO PCT Guide 10.050

**334**

For states applying the old **Article 22(1) PCT**, 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 for the states in question (see **point 331**).

[ 27 ]

[www.wipo.int/pct/en/texts/time\\_limits.html](http://www.wipo.int/pct/en/texts/time_limits.html)

### ***GA D I 14 Time limit for establishing the IPER***

**335**

Where the documents required for the preliminary examination were received in due time, the EPO as IPEA will establish the IPER usually within 28 months from the earliest priority date.

**R. 69.2 PCT**

### ***GA D I 15 Translation of the international application***

**336**

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** (English, French or German), the applicant must within the time limit for filing the demand also file a translation in one of these languages with the EPO as IPEA.

**R. 55.2 PCT**

WIPO PCT Guide 10.011-10.013

OJ 1993, 540

**337**

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, the applicant need not furnish a translation to the EPO as IPEA. In such cases the international preliminary examination will be carried out on the basis of the translation already furnished for the purposes of international search (see **point 204**).

**338**

Any amendments to be taken into account for the international preliminary examination must be submitted in the language of proceedings of the procedure before the EPO as IPEA. If they are initially not submitted in that language, the applicant must file a translation.

**R. 53.9 PCT, R. 55.3 PCT, R. 66.9 PCT**

WIPO PCT Guide 10.055

**Applications filed in Dutch**

### ***GA D I 16 Applications filed in Dutch***

**339**

If the EPO is IPEA for an international application originally filed in Dutch with the Dutch or Belgian patent office as receiving Office, the applicant need not file a translation of the international application since the EPO as IPEA will use the published version of the international application which it receives from the IB. 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 **points 208 and 338**).

**R. 12.4 PCT, R. 55.1 PCT, R. 55.2(a) PCT, R. 66.9(a) PCT**

Agreement EPO-WIPO, Annex A(i)

OJ 2010, 304

OJ 2009, 206

### ***GA D I 17 Language of the demand***

**340**

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

**R. 48.3, 55.1 PCT**

—

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 (e.g. application in Dutch, see **point 339**).

—

If a translation of the application has to be filed with the EPO as IPEA (see **points 336-338**), the demand must be filed in the language of that translation (e.g. application in Spanish, see **point 337**).

**Language of further correspondence**

### ***GA D I 18 Language of further correspondence***

#### **341**

Any other correspondence with the EPO as IPEA may be in any of the EPO's three official languages with the exception of amendments to the application, which are to be filed in the same language as the demand (see **point 338**).

**R. 92.2(b) PCT**

**Art. 150 EPC**

**R. 3 EPC**

OJ 1993, 540

### ***GA D I 19 Representation***

#### **342**

Applicants may be represented before the EPO as IPEA by the agent appointed on filing the international application and having the right to practise before the receiving Office, i.e. the agent for the international phase (see **point 36**). The applicant may also appoint an agent to represent him **specifically** before the EPO as IPEA. Moreover, the agent appointed for the international phase may appoint a sub-agent to represent the applicant specifically before the EPO as IPEA.

**Art. 49 PCT**

**R. 90.1(c), (d) PCT** WIPO PCT Guide 10.019-10.023

#### **343**

Any agent specifically appointed before the EPO as IPEA must be **entitled to practise before the EPO**. It is strongly recommended that applicants who do not have their residence or place of business in one of the EPC contracting states appoint an agent entitled to practise before the EPO for the proceedings before the EPO as IPEA (see **points 97 ff**).

**R. 90.1(c) PCT**

**Art. 134 EPC**

#### **344**

The appointment of an agent specifically before the EPO as IPEA can be done by the applicant or the agent for the international phase either by completing Box No. III of the PCT 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 demand or in a separate notice to a correctly deposited general power of attorney, of which a copy must be submitted. In that case, the demand or the separate notice may be signed by the purported agent.

**R. 90.4, 90.5 PCT**

#### **345**

The EPO as IPEA has waived the requirement that a signed separate power of attorney or a copy of a general power of attorney be submitted to it if the demand is signed by the purported agent for the procedure before the EPO as IPEA and not by the applicant or the agent for the international phase.

**R. 90.4(d), 90.5(c) PCT**

OJ 2010, 335

**346**

An exception to the waiver applies where the demand is signed by an agent who is not the agent of record, both agents do not belong to the same office and the new agent is not appointed in addition to the agent appointed earlier but appointed under revocation of any earlier appointment (PCT/IPEA/401, Box III second and third check-box). In that situation a separate power of attorney signed by the applicant or the agent of record, or a copy of a general power of attorney is to be furnished.

***GA D I 20 Which states may be elected?***

**347**

The filing of the demand constitutes the election of all PCT contracting states designated in the international application and bound by **PCT Chapter II** for a national and where possible a regional patent at the same time (see **point 317**). 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.

**Art. 31(4) PCT**

**R. 53.7 PCT**

WIPO PCT Guide

10.005, 10.029

***GA D I 21 Signature***

**348**

The demand 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 (see **point 345**).

**R. 53.2(b) PCT, R. 53.8 PCT, R. 60.1(a-ter) PCT, 90.3 PCT**

WIPO PCT Guide 10.031-10.032

**349**

A (common) agent or common representative may sign the demand on behalf of the applicant(s) who appointed him (see **points 104 ff**).

**350**

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 - if not already on file - or a copy of a general power of attorney since the EPO has waived these requirements (see **point 109**).

**R. 90.4, 90.5 PCT**

OJ 2010, 335

***GA D I 22 Fees***

**351**

For international preliminary examination, the handling fee and the preliminary examination fee must be paid **direct** to the EPO as IPEA. The preliminary examination fee is set by the EPO. The handling fee is provided for in the Schedule of Fees under the PCT which is published by the IB.

**Art. 31(5) PCT**

**R. 57.3 PCT, R. 58 PCT**

**Art. 2.19 RFees**

WIPO PCT Guide 10.035 -10.043

OJ 3/2012, Supplement

**352**

Both fees have to be paid within **one month** of the date on which the demand was submitted or within 22 months from the priority date, whichever time limit expires later. The amounts of the handling fee and the preliminary examination fee to be paid shall be the amounts applicable on the date of payment.

**353**



Applicants are urged to use the **Fee Calculation Sheet** annexed to the demand form (PCT/IPEA/401).  
**Fee reductions**  
**Consequences of non- or late payment of fees**  
**Refund of the fee for international preliminary examination**

### ***GA D I 23 Fee reductions***

#### **354**

The **handling fee** is reduced by 90% under the same conditions as for the **international filing fee** (see **point 178**).

PCT Schedule of Fees

WIPO PCT Guide 10.035 -10.041

#### **355**

The fee for **international preliminary examination** is reduced by 75% under the same conditions as for the reduction of the **international search fee** (see **point 213**).

OJ 2008, 521

Agreement EPO-WIPO, Annex **C-II**

OJ 2010, 304

### ***GA D I 24 Consequences of non- or late payment of fees***

#### **356**

Applicants should avoid late or incomplete payment of the handling and international preliminary examination fee (see **points 351 ff**), since 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.

WIPO PCT Guide 10.047

#### **357**

Where the EPO as IPEA 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 by the time they were due, the EPO as IPEA invites the applicant to pay to it the amount required to cover both fees together with the late-payment fee within one month of the date of the invitation. If the applicant complies with the invitation within the specified time limit, payment is deemed to have been made in due time. The late-payment fee is 50% of the amount of the unpaid fees as specified in the invitation. However, it is at least equal to but not more than double the amount of the handling fee.

#### **R. 58bis PCT**

OJ 1998, 282

#### **358**

**If the applicant does not comply with the invitation, the demand is deemed not to have been submitted** and no IPER will be established. The absence of a validly filed demand has no consequence for the procedure before the EPO as designated Office, because the time limit to be respected for entry into the European phase is in any case 31 months from the priority date (see **point 414**).

### ***GA D I 25 Refund of the fee for international preliminary examination***

#### **359**

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, the applicant is refunded 75% of the fee for international preliminary examination. If the demand is deemed not to have been submitted or the fee was paid by mistake, the fee is refunded in full. Any amount paid in excess of the amount due is likewise refunded.



**R. 58.3 PCT**

Agreement EPO-WIPO, Annex C-II  
OJ 2010, 304

***GA D I 26 Defects in the demand and how they can be corrected***

**360**

If the demand does not comply with the requirements, 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.

**R. 60.1 PCT**

WIPO PCT Guide 10.047-10.050

**361**

Where there is more than one applicant, a frequent defect concerns failure to provide the required indications and/or the signatures of all the applicants. However, if 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, this is considered sufficient and no invitation will be issued (see **point 348**).

**R. 53 PCT, R. 60.1(a-bis) PCT, R. 60.1(a-ter) PCT**

***GA D II II.***

The international preliminary examination procedure before the EPO as an IPEA

**Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements**

**First written opinion**

**Second written opinion**

**The EPO was not the ISA**

**International preliminary examination before the EPO: four scenarios**

**Time limit for reply to the written opinion**

**International preliminary examination and SIS**

**Refusal to perform preliminary examination**

**Request for consultation by telephone**

**Nucleotide and amino acid sequences**

**Unity of invention**

**What must be done after receipt of the IPER?**

**Confidentiality of the international preliminary examination**

***GA D II 1 Which documents form the basis of the international preliminary examination? - Amendments - Missing parts and elements***

**362**

The applicant must indicate in Box No. IV of the demand form (PCT/IPEA/401) whether the international preliminary examination is to be based on the international application

**Art. 19 PCT, Art. 34 PCT**

**R. 53.9 PCT, R. 66.1 PCT, R. 66.5 PCT, R. 70.2(a) PCT, R. 70.2(c) PCT**

WIPO PCT Guide 10.025, 10.061

—

as (originally) filed,

or whether it should take account of

—

amendments to the claims under **Article 19 PCT**, and/or

— amendments to the claims, the description and/or the drawings under **Article 34(2)(b) PCT**.

#### **Amendments**

#### **Incorporation by reference of missing parts and elements**

### ***GA D II 2 Amendments***

#### **363**

If amendments under **Article 19 PCT** are to be taken into account, the applicant must enclose a copy of these with the demand.

#### **364**

Amendments and/or arguments filed under **Article 34 PCT** should preferably be filed together with the demand. However, they also have to be taken into account by the EPO as IPEA if they are filed before expiry of the time limit for filing the demand (see **point 323**). 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. Moreover, if a second written opinion is established (see **point 372**), subsequently filed amendments and/or arguments will be taken into account together with the reply to 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.

#### **Art. 34(2)(b) PCT**

#### **R. 66.1(b) PCT, R. 66.4bis PCT**

WIPO PCT Guide 10.024, 10.028

OJ 2011, 532

#### **365**

If the EPO acted as ISA, the EPO as IPEA will consider the WO-ISA as a first written opinion for the purposes of international preliminary examination and, as a rule, commence the international preliminary examination immediately after expiry of the time limit for filing the demand (see **points 323, 377**). Therefore, it is important that amendments and/or arguments under **Article 34 PCT** are filed in due time.

#### **366**

Applicants must make sure that none of the amendments go beyond the disclosure in the international application as originally filed. Note that if an amendment contains a negative limitation, e.g. a "disclaimer", the EPO as IPEA in accordance with the discretion provided for in the ISPE Guidelines applies the same approach as in respect of a Euro-direct application (see **Annex IV**). Further, applicants must indicate in an accompanying letter

#### **R. 66.8(a) PCT**

GL/ISPE A20.21

GL/EPO H

— 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.

#### **367**

If the basis for any amendment is not indicated as required, the EPO will establish the written opinion and/or IPER as if no amendments had been filed and without first issuing a reminder.

#### **R. 70.2(c-bis) PCT**

#### **368**

If amendments to the claims are filed a complete set of the claims in replacement of all claims originally filed must be submitted.

#### **R. 66.8(c) PCT**

### ***GA D II 3 Incorporation by reference of missing parts and elements***

**369**

If the receiving Office has granted a request for incorporation by reference under **Rules 4.18** and **20.6 PCT** but the EPO as IPEA does not consider the relevant part(s) and/or element(s) completely contained in the priority application, it will indicate so in the IPER (see **points 54 ff**).  
**R. 4.18, 20.6 PCT**

### ***GA D II 4 First written opinion***

**370**

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.

**Art. 33 PCT, Art. 34 PCT, Art. 35 PCT**

**R. 66.1bis PCT, R. 66.2 PCT, R. 66.3 PCT, R. 66.4 PCT**

WIPO PCT Guide 10.064-10.066, 10.074

OJ 2003, 574

**371**

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.

### ***GA D II 5 Second written opinion***

**372**

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. A second written opinion will be issued on condition that the applicant filed 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. The procedure may be different and a second written opinion may not necessarily be issued if a request for consultation by telephone is filed by the applicant (see **point 385**). In this context the term “negative” IPER is to be understood as an IPER informing the applicant of a deficiency to which he must respond under **Rule 161(1) EPC** if he decides to enter the European phase (see **points 493 ff**). If the IPER contains no objections or only minor objections which do not hinder a direct grant in the European phase, the IPER is considered positive.

OJ 2011, 532

### ***GA D II 6 The EPO was not the ISA***

**373**

If the EPO acts as IPEA but did not establish the WO-ISA because the international search was conducted by one of the other European ISAs (see **point 200**), the WO-ISA established by any such ISA is not considered a (first) written opinion of the EPO as IPEA (see **point 371**). In these cases, the EPO in its function as IPEA will issue a first written opinion if it has any objections. The applicant may respond to this written opinion by filing amendments and/or arguments within the time limit set therein.

OJ 2011, 532

**374**

In this case a second written opinion will be issued on condition that the applicant has filed amendments and/or arguments to overcome any objections raised in the first written opinion and that

there remain objections outstanding such that the IPER would be negative if it were to be issued on the basis of the file as it stands.

***GA D II 7 International preliminary examination before the EPO: four scenarios***

**375**

For ease of understanding, the procedure before the EPO as IPEA can be summarised in four scenarios:

OJ 2011, 532

**First case: The EPO acted as ISA and made no objections**

**Second case: The EPO acted as ISA and made objections**

**Third case: The EPO did not act as ISA and the EPO as IPEA has no objections**

**Fourth case: The EPO did not act as ISA and the EPO as IPEA has objections**

***GA D II 8 First case: The EPO acted as ISA and made no objections***

**376**

If the WO-ISA established by the EPO as ISA contains **no objections** to the international application ("positive WO-ISA"), the EPO as IPEA will consider the WO-ISA as the first written opinion for the purposes of international preliminary examination (see **point 370**). The EPO as IPEA will in this case use its discretion in proceeding to issue the IPER immediately after expiry of the time limit for filing the demand. Therefore, the IPER will have no added value over the information provided in the WO-ISA, unless the applicant files amendments and/or arguments for the EPO to take into account as IPEA.

**Art. 34(2)(c) PCT**

***GA D II 9 Second case: The EPO acted as ISA and made objections***

**377**

If the WO-ISA established by the EPO as ISA contained **objections** to the international application ("negative WO-ISA"), the EPO as IPEA will consider the WO-ISA as the first written opinion for the purposes of international preliminary examination (see **point 370**). The WO-ISA will not, however, be reissued as a first written opinion of the EPO as IPEA. A second written opinion will be issued on condition that the applicant has filed amendments and/or arguments in reply to the WO-ISA which must be taken into account for international preliminary examination and that there remain objections outstanding such that the IPER would be negative if it were to be issued on the basis of the file as it stands.

**R. 66.1bis PCT, R. 66.4 PCT, R. 66.4bis PCT**

OJ 2003, 574

***GA D II 10 Third case: The EPO did not act as ISA and the EPO as IPEA has no objections***

**378**

If the WO-ISA was issued by an ISA other than the EPO, the WO-ISA is not considered to be the first written opinion of the EPO as IPEA (see **point 370**). However, if the EPO as IPEA has no objections to the (amended) application for which preliminary examination has been requested, it may proceed to issue the IPER immediately after expiry of the time limit for filing the demand (see **point 323, 372**).

**Art. 34(2)(c) PCT**

***GA D II 11 Fourth case: The EPO did not act as ISA and the EPO as IPEA has objections***

**379**

If the WO-ISA was issued by another ISA, the WO-ISA is not considered to be the first written opinion of the EPO as IPEA (see **point 373**). If the EPO as IPEA has objections to the application for which preliminary examination has been requested, it will issue a first written opinion. The applicant may respond to this written opinion by filing amendments and/or arguments within the time limit set therein. A second written opinion will be issued on condition that the applicant has filed amendments and/or arguments to overcome any objections raised in the first written opinion and that there remain objections outstanding such that the IPER would be negative if it were to be issued on the basis of the file as it stands.

**R. 66.1bis PCT, R. 66.2 PCT, R. 66.4 PCT, R. 66.4bis PCT**

***GA D II 12 Time limit for reply to the written opinion***

**380**

The time limit for the reply to the first written opinion issued by the EPO as IPEA is usually two months but may be extended to a maximum of three months at the applicant's request. Such a request must be filed before expiry of the two-month time limit set. An extension will only be granted if the extended time limit does not expire later than 25 months from the priority date. An extension of the time limit may also be requested if the WO-ISA is considered to be the first written opinion of the EPO as IPEA (see **point 370**). The time limit for the reply to the second written opinion or, as the case may be, to the invitation accompanying the minutes of a telephone consultation is normally two months and not shorter than one month (see **point 385**) unless the applicant has agreed to a shorter time limit.

**R. 66.2(d) PCT, R. 66.2(e) PCT, R. 69.2 PCT**  
OJ 2011, 532

***GA D II 13 International preliminary examination and SIS***

**381**

The EPO as IPEA will take into account any SISR (only) if it is available at the time the international preliminary examination is performed. A further written opinion will be issued before the IPER is established in the exceptional case that the contents of the SISR would change the EPO's opinion as set out in the WO-ISA established by the EPO as ISA.

**R. 45bis.8(c) PCT**

***GA D II 14 Refusal to perform preliminary examination***

**382**

The EPO as IPEA will not perform an international preliminary examination on any claim for which no international search was performed (see **point 251**). 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.

**Art. 17(2)(a) PCT**

**R. 66.1(e) PCT, R. 66.2(a)(vi) PCT**

**383**

Further, the EPO as IPEA will make use of 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. Here, reference is made to the information published by the EPO in respect of international applications claiming a business method (see **point 315**).

**Art. 34(4) PCT**

**R. 67 PCT**

Agreement EPO-WIPO, Art. 4  
OJ 2010, 304

OJ 2007, 592

**384**

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.

### ***GA D II 15 Request for consultation by telephone***

**385**

Since the issues to be discussed must be clear, a request for personal communication will not be granted before the applicant has submitted amendments and/or arguments which are to be taken into account by the EPO as IPEA. A request for personal communication may be granted by the EPO acting as IPEA only once and only in the form of consultation by telephone

**Art. 34(2)(a) PCT**

**R. 66.6 PCT**

WIPO PCT Guide 10.067

OJ 2011, 532

**386**

If the applicant files a request for consultation by telephone before a second written opinion is issued, he will be sent the minutes of the telephone consultation together with an invitation to submit further amendments and/or arguments within the time limit set for reply therein. In such a case, no second written opinion will be issued.

**387**

If the applicant requests a consultation by telephone and/or a second written opinion before a second written opinion is issued, the discretion to decide whether to consult the applicant by telephone or to establish a second written opinion is left to the EPO as IPEA.

**388**

If the applicant files a request for consultation by telephone after a second written opinion has been issued but before the date on which the IPER is established, the minutes of the telephone consultation are sent to the applicant but will not be accompanied by an invitation to submit further amendments and/or arguments, and none will be accepted unless agreed upon during the consultation by telephone.

### ***GA D II 16 Nucleotide and amino acid sequences***

**389**

If the ISR was not drawn up in full or in part because the sequence listing was not available to the ISA in electronic form in the specified format (see **point 260**), this may affect the procedure under

**Chapter II PCT.**

**R. 13ter.2 PCT, R. 66.1(e) PCT**

OJ 2011, 372, 376

**390**

If no sequence listing in electronic form complying with the requirements is available to the EPO as IPEA, the applicant may be invited to furnish that sequence listing in the required form and format and to pay the late furnishing fee.

**391**

If no (full) international search was carried out, the EPO as IPEA will not perform the international preliminary examination if a meaningful examination cannot be performed (see **point 382**). In such cases an invitation to file a sequence listing under **Rule 13ter.2 PCT** is not issued by the EPO as IPEA and applicants are advised not to file sequence listings at this late stage.

### ***GA D II 17 Unity of invention***

**392**

Where the EPO as IPEA considers that the international application lacks unity of invention, it will invite the applicant either to restrict the claims in order to meet this requirement or, to the extent that the inventions have been searched, to pay additional preliminary examination fees.

**Art. 34(3) PCT**

**R. 68.2 PCT, R. 68.3(c) PCT R. 158(2) EPC**

OJ 2010, 320, 322

**393**

If the applicant fulfils the requirements for reduction of the preliminary examination fee, any additional fee is validly paid upon payment of the reduced sum (see **point 355**).

**394**

If the applicant does not pay any additional preliminary examination fee the EPO establishes the IPER on the basis of the result already communicated.

**395**

If the applicant pays one or more additional preliminary examination fee(s) within the time limit set, those parts of the application for which additional fees have been paid will also be examined. Consequently the IPER will be established for all inventions for which a fee for preliminary examination has been paid.

**396**

The applicant may pay any additional fee under protest in accordance with **Rule 68.3(c) PCT**. The protest procedure is the same as before the EPO as ISA (see **points 262 ff**).

**R. 158(3) EPC**

**Art. 2.21 RFees,**

OJ 2010, 320, 322

**397**

Where applicable, the EPO as IPEA will base the examination on the results of the protest procedure, if available, before establishment of the IPER.

**398**

Claims relating to inventions in respect of which no international search report has been established will not be the subject of international preliminary examination by the EPO as IPEA (see **point 382**).

**R. 66.1(e) PCT**

### ***GA D II 18 What must be done after receipt of the IPER?***

**399**

The IPER is transmitted to the applicant and the IB. The applicant then has no further opportunity to submit comments to the EPO as IPEA. He must now decide on the basis of the results of the international preliminary examination as laid down in the IPER whether he wishes to pursue the international application further by entering the national/regional phase before the elected Offices.

**Art. 36 PCT. Art. 39 PCT**

**R. 71.1 PCT**

**400**

If the EPO acted as IPEA, the applicant will, where appropriate, be invited to correct any deficiencies set out in the IPER ("negative IPER") upon entry into the European phase (see **points 493 ff**).

**R. 161 EPC**

GL/EPO E-VIII, 3.2

**401**

All (further) questions relating to the **European phase** - the procedure before the **EPO as a designated or elected Office** - are dealt with in detail in chapter E.

### ***GA D II 19 Confidentiality of the international preliminary examination***

**402**

The IB and the EPO as IPEA may not allow access to the file of the international preliminary examination to third parties without authorisation by the applicant.



**Art. 36(3), 38 PCT**

**R. 73.2 PCT, R. 94.1(c) PCT, R. 94.3 PCT**

**Art. 128 EPC**

WIPO PCT Guide

10.003, 10.081

OJ 1999, 329

OJ 2003, 382

OJ 2007, Spec.Ed.3,

J.2, J.3

**GL/EPO E-VIII, 2.10**

**403**

Once the IPER has been established and transmitted to the IB, the latter sends a copy of the IPER to each elected Office. As from that time, the IB also furnishes copies of the IPER on request to any person on behalf of the EPO as IPEA.

**404**

Furthermore, after completion of the IPER the EPO as **elected Office** allows access to the file of the international preliminary examination in accordance with the provisions of the EPC.



## **EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office**

**GA E E.**

Euro-PCT procedure before the EPO as a designated (PCT Chapter I) or elected (PCT Chapter II) Office

**I. General**

**II. What is "entry into the European phase"?**

**III. Representation**

**IV. Application documents on which the procedure before the EPO as designated/elected Office is based (Form 1200, Section 6)**

**V. Translation of the application documents and other documents (Form 1200, Section 7)**

**VI. Biological material & nucleotide and amino acid sequences**

**VII. Filing fee**

**VIII. Designations and extensions**

**IX. Supplementary European search**

**X. Examination**

**XI. Renewal fee and claims fees**

**XII. Filing of other documents**

**XIII. Priority claim**

**XIV. Review by the EPO as designated Office of Euro-PCT applications which fail in the international phase**

**XV. Lack of unity**

**XVI. Publication of the Euro-PCT application by the EPO**

**XVII. State of the art**

**XVIII. Divisional applications**

**GA E I I.**

General

**405**

Before the end of the international phase the applicant must decide whether and where he wants to proceed with the international application in the national/regional phase before the designated/elected Offices.

**406**

If the applicant wishes to obtain a European patent he must enter what is known as "the European phase", which means that he must fulfil the requirements (see **points 443 ff**) for initiating the processing of his application by the EPO as designated or elected Office in due time (see **point 414**).

**When is the EPO a designated or elected Office?**

**When must the applicant decide on the scope of protection sought for the European patent?**

**When must the European phase be initiated before the EPO as designated or elected Office?**

**Language of the proceedings in the European phase**

**How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?**

**Request for early processing**

**Accelerated prosecution of applications - the "PACE" programme**

**GA E I I When is the EPO a designated or elected Office?**

**407**

EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office

#### GA E I 2 When can the EPO act as designated Office?

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If an applicant enters the European phase without having requested international preliminary examination under Chapter II, the EPO will act as a "designated Office" (see **points 408 ff**). However, if before entering the European phase the application was processed under **Chapter II PCT**, the EPO will act in the European phase as an "elected Office" (see **points 411 ff**).

**Art. 2(xiii) PCT** and **Art. 2(xiv) PCT**

**Art. 153(1) EPC**

**GL/EPO E-VIII, 2**

**When can the EPO act as designated Office?**

**When can the EPO act as elected Office?**

#### *GA E I 2 When can the EPO act as designated Office?*

##### **408**

Since all EPC contracting states are PCT contracting states, the EPO can act as a designated Office for any EPC contracting state, provided the international application was filed on or after the date on which the EPC entered into force for the state concerned (see **point 31**).

##### **409**

If this requirement is not met it may be that an extension agreement was in force on the international filing date that provides for the extension of a European patent to the state for which patent protection is sought (see **points 122 ff**).

##### **410**

Furthermore, a European patent for any EPC contracting state can be obtained only if the applicant has withdrawn neither the application nor the (automatic) designation of the state concerned for a European patent during the international phase.

**R. 90bis PCT**

#### *GA E I 3 When can the EPO act as elected Office?*

##### **411**

For the EPO as an elected Office, the same requirements apply as for the EPO acting as a designated Office (see **points 408-410**). In addition, however, at least one of the EPC contracting states must have been elected for a European patent in the demand for international preliminary examination. Since the filing of the demand constitutes the election of all PCT contracting states that were designated for, where possible, a national and a regional patent, this requirement will automatically be met in respect of each state that was an EPC contracting state at the international filing date, unless the applicant has withdrawn such election in the meantime (see **points 31, 347**).

#### *GA E I 4 When must the applicant decide on the scope of protection sought for the European patent?*

##### **412**

Upon entry into the European phase the applicant must pay the designation fee (see **point 544**).

Payment of this fee confirms the designation of all EPC contracting states that were designated on the international filing date for a European patent (see **points 31, 115 ff**).

**R. 159(1)(d) EPC**

**Art. 2.3 RFees**

**OJ 2008, 513**

##### **413**

Within the time limit for payment of the designation fee, the applicant must decide on the extension states for which he seeks extension of the European patent and must pay the extension fees due (see **points 122 ff, points 551 ff**). An extension fee is to be paid for each extension, and no flat extension fee applies.

EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office

GA E I 5 When must the European phase be initiated before the EPO as designated or elected Office?

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***GA E I 5 When must the European phase be initiated before the EPO as designated or elected Office?***

**414**

If, after considering the ISR and WO-ISA (see **points 237 ff**) and, where applicable, the result of the international preliminary examination as laid down in the IPER (see **points 399 ff**) and/or a supplementary international search (see **points 274 ff**), an applicant decides to pursue his international application further before the EPO as designated/elected Office, he must comply with the requirements for entry into the European phase **within 31 months** from the filing date or, if priority has been claimed, from the earliest priority date (see **points 128 ff**).).

**Art. 22(1) PCT, Art. 22(3) PCT, Art. 39(1)(a) PCT, Art. 39(1)(b) PCT**

**R. 159(1) EPC**

**415**

The time limit for complying with the requirements for entry into the European phase thus extends by one month beyond the standard time limit of 30 months provided for in **Articles 22(1) and 39(1)(a) PCT** and applies irrespective of whether or not a demand for international preliminary examination was filed (see **points 329-330**).

**416**

If the 31-month time limit expires on a day on which one of the filing offices of the EPO is not open for receipt of documents, the period is extended to the first day thereafter on which all filing offices are open for receipt of documents and on which mail is delivered.

**R. 80.5 PCT**

**R. 134 EPC**

**417**

If the applicant does not comply with the requirements for entry into the European phase within the 31-month time limit, the Euro-PCT application is, as a rule, deemed to be withdrawn (see **point 445**).

**Art. 24(1)(iii) PCT, Art. 39(2) PCT**

**R. 160 EPC**

***GA E I 6 Language of the proceedings in the European phase***

**418**

The language of the proceedings is one of the official languages of the EPO (English, French and German). If the international application was published by WIPO (see **point 234**) in an official language of the EPO, that language is the language of the proceedings in the European phase. If not, the EPO official language of the translation to be submitted upon entry into the European phase is the language of the proceedings (see **points 505 ff**).

**Art. 14(3), 153(5) EPC**

**R. 159(1)(a) EPC**

**419**

The EPO does not allow the language of the proceedings to be changed. Reference is made to decision **G 4/08** of the Enlarged Board of Appeal.

OJ 2010, 572

***GA E I 7 How and where should the applicant initiate the procedure before the EPO as a designated/elected Office (Form 1200)?***

**420**

For entry into the European phase, applicants are strongly recommended to use the latest version of Form 1200 (**Annex XI**).

**Art. 22, 39 PCT**

**R. 49.4, 76.5 PCT**

**421**

The form may be downloaded from the EPO website[ **28** ]. Applicants are advised to read the explanatory notes carefully before completing the form.

**422**

The form must be filed with **the EPO** direct. It should not be sent either to the IB or to an authority of an EPC contracting state competent to receive European patent applications.

OJ 2007 Spec.Ed.3, A.3

**423**

If filed in paper form, either by post or by fax, only one copy of the document must be submitted. If the form is filed by fax, a confirmation copy must be filed only on invitation by the EPO.

**424**

Form 1200 may also be filed in electronic form, online or on an admissible data carrier using the EPO Online Filing software. The (basic part of the) filing fee is reduced if Form 1200 is filed online (see **point 532**)[ **29** ].

OJ 2007, Spec.Ed.3, A.5

**Art. 2.1 RFees**

OJ 2009, 182

OJ 2010, 226

**425**

Since the IB sends to the EPO as designated/elected Office a copy of the international application and the ISR (including the WO-ISA) and, where applicable, also the IPER with annexes, the applicant should not file these documents (see **point 449**). However, the applicant may have to file a translation of the international application and further documents as set out below (see **points 505 ff**).

**Art. 20 PCT, Art. 36(3) PCT**

**R. 73 PCT**

**426**

Applicants must indicate the European application number, which as a rule is communicated to them approximately ten months after international publication (EPO Form 1201). Applicants who have not yet been notified of this number when performing the required steps for entry into the European phase may instead cite the PCT application number or the PCT publication number.

[ **28** ]

[www.epo.org/patents/Grant-procedure/Filing-an-application/European-applications/forms.html](http://www.epo.org/patents/Grant-procedure/Filing-an-application/European-applications/forms.html)

[ **29** ]

[www.epoline.org/portal/public](http://www.epoline.org/portal/public)

***GA E I 8 Request for early processing***

**427**

An applicant can request the EPO as designated or elected Office to commence processing the Euro-PCT application at any time before expiry of the 31-month time limit.

**Art. 23(2) PCT, Art. 40(2) PCT**

**R. 90bis.6 PCT**

**R. 159 EPC**

**428**

For this purpose, the applicant must file an **express request for early processing**, which is not included in Form 1200. Moreover, he must fulfil the requirements for entry into the European phase as **if the 31-month time limit provided for in Rule 159(1) EPC expired on the date he requests early processing**.

**429**

This means that, for an application to be processed early, the following requirements must be complied with: payment of the filing fee (see **point 530**), filing of the translation (where applicable, see **point 505**), specification of the application documents (see **point 469**), payment of the search fee (where applicable, see **point 575**). Which further requirements must be complied with depends on the

GA E I 8 Request for early processing

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date on which early processing is requested, since the time limits for paying the designation fee (**Rule 39(1) EPC**) and the renewal fee (**Rule 51(1) EPC**) and for filing the request for examination and paying the examination fee (**Rule 70(1) EPC**) may not yet have expired at that date (see **points 544, 593 ff** and 580 ff). The term “necessary requirements” is used to refer to the requirements that must be complied with for a request for early processing for the application concerned to be effective.

**430**

Where applicable, the certificate of exhibition must also be filed on entry into the European phase (see **point 605**). However, if this requirement is not met, this will not prevent the request for early processing from being effective, but it will affect the prior art that the EPO takes into account in the procedure.

GL/EPO B-VI, 5.5

**431**

Claims fees for any claims in excess of fifteen need only be paid upon expiry of the period under **Rule 162(2) EPC**. Therefore, their payment is not a requirement for a request for early processing to be effective.

**432**

Fees which need to be paid for a request for early processing to be effective **must not be paid by automatic debit order**, since in that case the fees are debited - and thus paid - only on the last day of the 31-month time limit.

**433**

If on the date the request for early processing is filed all necessary requirements (see **point 429**) are complied with, the request for early processing is effective as from that date and the application will be processed in the same way as any Euro-PCT application which has entered the European phase. This means, for instance, that the EPO as designated/elected Office will issue the communication under **Rule 161 EPC/Rule 162 EPC** directly after it has established that the request for early processing is effective (see **point 480**). Furthermore, as from the date the request for early processing is effective, the applicant may file a divisional application (see **point 645**).

**434**

If on the date the request for early processing is filed any necessary requirement (see **point 447**) is not complied with, the request for early processing will not be effective on the date of receipt of the request but only as from the earliest date thereafter on which all requirements necessary on that date have been complied with (see **point 429**). It is only on the latter date that the application enters the European phase, and from that moment on is processed in the same way as any Euro-PCT application which has entered the European phase.

**435**

If the requirements for a request for early processing to be effective are not complied with before expiry of the 31-month time limit, the EPO as designated/elected Office cannot start processing the application until that time limit has expired.

**436**

From the date the applicant's request for early processing is effective, any subsequent withdrawal under **Rule 90bis PCT** will have no effect in respect of the procedure in the European phase.

**437**

Note that if early processing is requested because the applicant wishes not only the processing of the application before the EPO as designated/elected Office but also the examination of the application to start, he must have filed a valid request for examination (including payment of the examination fee) under **Article 94 EPC**, even if the time limit under **Rule 70(1) EPC** has not yet expired at the date of effective entry into the European phase, since examination will be taken up only if a request for examination has been validly filed.

**438**

Furthermore, if a request for examination is filed before the EPO has, where applicable, sent the supplementary European search report to the applicant, examination will start only upon receipt of an indication from the applicant that he wishes to proceed further with the application and, if required, a response to the extended European search report. The applicant may waive his right to be asked whether he wishes to proceed further. He can indicate this in box 4.2 of Form 1200.

**R. 70(2), 70a(2) EPC**

**439**

If the EPO acts as **designated** Office and the IB has not yet transmitted to it a copy of the international application, the ISR and the WO-ISA, the applicant may but does **not** have to file with the IB a request to do so. If needed, the EPO will take care of this itself.

**Art. 20 PCT**

**R. 44bis.2(b), 47.4 PCT**

**440**

The same applies if the EPO acts as **elected** Office and the IB has not yet transmitted to it a copy of the international application, the ISR, the WO-ISA and the IPER with its annexes.

**Art. 36(3)(a) PCT**

**R. 61.2(d), 73.2(b) PCT**

***GA E I 9 Accelerated prosecution of applications - the "PACE" programme***

**441**

An effective request for early processing causes prosecution of the application by the EPO as designated/elected Office to be taken up before expiry of the 31-month time limit. In addition to the possibility of requesting early processing, the applicant may want accelerated prosecution of his application in the European phase. For this purpose, a separate request under the PACE programme is to be submitted upon entry into the European phase or later (EPO Form 1005). Depending on the time when the request is submitted and the indications made in the form, accelerated prosecution may cover the formalities examination, the establishment of the supplementary European search report, where such a report is to be drawn up (see **points 562 ff**), and/or substantive examination.

OJ 2010, 352

GL/EPO E-VII, 3

**Combined PACE request and waiver of Rule 161 EPC/Rule 162 EPC communication**

***GA E I 10 Combined PACE request and waiver of Rule 161 EPC/Rule 162 EPC communication***

**442**

If a PACE request has been filed, the EPO will also have to respect the six-month time limit provided for in **Rules 161 and 162 EPC** and will therefore not be able to start supplementary European search or examination before expiry of that time limit (see **point 479**). For this reason an applicant interested in acceleration of the procedure may consider waiving his right to the **Rule 161 EPC/Rule 162 EPC** communication. The procedure to follow is set out below (see **point 485**).

OJ 2011, 354

***GA E II II.***

What is "entry into the European phase"?

**Overview of the steps to be taken for entry into the European phase**

**Minimum requirements**

**Further requirements**

**Amounts of fees to be paid in the European phase**

***GA E II 1 Overview of the steps to be taken for entry into the European phase***

**443**

The process generally referred to as "entry into the European phase" is not an act in itself but may be described as a series of "steps" to be taken or, in other words, as a bundle of requirements to be fulfilled within 31 months from the international filing date or, where applicable, the earliest priority



date claimed for the international application ("31-month time limit"). Which requirements are to be fulfilled within the 31-month time limit depends to a certain extent on the particular case.

**444**

Some requirements must be fulfilled in every case, such as payment of the filing fee (**point 530**) and specification of the documents on which processing in the European phase is to be based (**points 469 ff**). Further, as a rule, the designation fee is due and the request for examination must be filed at expiry of the 31-month time limit for entry into the European phase, unless the ISR was published extremely late (see **points 544, 583**). However, the filing of a translation, for instance, is required only if the international application was not published in an official language of the EPO (**points 505 ff**). This means that for each application the applicant must verify which requirements are to be fulfilled within the 31-month time limit.

**445**

If the applicant does not fulfil all requirements that must be met within the 31-month time limit, in many cases - depending on exactly which requirement was not met - the effect is that the application is deemed to be withdrawn as from the date of expiry of that time limit. A loss of rights may be remedied, but only if the strict requirements under which a remedy applies are fulfilled in due time. If not, the application is irreversibly lost. Each of the requirements will be discussed in detail below (see **points 447 ff**).

**Art. 24(1)(iii) PCT, Art. 39(2) PCT**

**Art. 121, 122 EPC**

**R. 135 EPC, R. 136 EPC, R. 160 EPC, R. 162 EPC, R. 163 EPC**

**446**

All requirements in respect of which non-timely compliance results in a loss of rights (directly) upon expiry of the 31-month time limit are listed in **Rule 159 EPC**. In view of that legal effect they are usually referred to as "minimum requirements" for entry into the European phase.

## ***GA E II 2 Minimum requirements***

**447**

In order to initiate the European phase the applicant must take **at least the following steps within 31 months from** the filing date or, if priority has been claimed, from the earliest priority date:

**R. 159 EPC**

—

supply the **translation** if the Euro-PCT application was not published in one of the EPO's official languages (see **points 505 ff**),

**Art. 153(4) EPC**

**R. 159(1)(a) EPC**

—

**specify the application documents** on which the European grant procedure is to be based (see **points 469 ff**),

**R. 159(1)(b) EPC**

—

pay the **filing fee** provided for in **Article 78(2) EPC**, including an additional page fee for applications longer than 35 pages (see **points 530 ff**),

**R. 159(1)(c) EPC**

—

pay the **designation fee** (and any extension fees) if the period under **Rule 39 EPC** has expired earlier (see **points 544 ff**),

**R. 159(1)(d) EPC**

—

pay the **search fee** if a supplementary European search report is to be drawn up (see **points 575 ff**),

**Art. 153(7) EPC**

**R. 159(1)(e) EPC**

—

GA E II 3 Further requirements

---

file the **request for examination** and pay the **examination fee** if the period under **Rule 70(1) EPC** has expired earlier (see **points 580 ff**),

**R. 159(1)(f) EPC**

–

pay the **renewal fee** for the third year if the period under **Rule 51(1) EPC** has expired earlier (see **points 593 ff**),

**R. 159(1)(g) EPC**

–

where applicable (in rare cases), file the certificate of exhibition mentioned in **Article 55(2) EPC** (see **points 605 ff**).

**R. 159(1)(h) EPC**

***GA E II 3 Further requirements***

**448**

Besides the "minimum requirements" mentioned in **point 447**, the applicant may have to complete one or more of the following steps within the 31-month time limit. These further requirements are not referred to as "minimum requirements" since failure to comply with them does not have the direct effect of a loss of rights (see **point 444**).

These further requirements are:

–

pay any claims fees due (see **points 596 ff**),

**R. 162 EPC**

–

file the designation of the inventor (see **points 602 ff**),

**R. 163(1) EPC**

–

furnish the file number or the copy of the application(s) of which priority is claimed (see **points 611 ff**),

**R. 163(2) EPC**

–

furnish a sequence listing complying with the standard (see **point 523**),

**R. 163(3) EPC**

–

furnish the indications on the applicant mentioned in **Rule 163(4) EPC** in respect of any applicant (see **points 602 ff**),

**R. 163(4) EPC**

–

appoint a professional representative (see **point 455**),

**R. 163(5) EPC**

–

furnish a copy of the results of any search carried out by or on behalf of the authority with which the priority application was filed (see **points 473 ff**).

**R. 141(1) EPC**

**449**

The EPO is sent the copy of the international application required under **Article 22(1) PCT** or **Article 39(1) PCT** by the IB before expiry of the 31-month time limit. Therefore, the applicant should not submit a copy of the application to the EPO.

**Art. 20 PCT, Art. 22(1) PCT, Art. 39(1) PCT**

**450**

If amendments have been made under **Article 19 PCT** (see **points 238 ff**), the copy transmitted by the IB also includes these amendments and the applicant's statement thereon.

**Art. 19(1), (2) PCT**



***GA E II 4 Amounts of fees to be paid in the European phase***

**451**

The amounts of all fees that may be due on entry into the European phase or thereafter are listed in the current version of the **Rules relating to Fees** (RFees) and the Schedule of fees and expenses of the EPO, which is published as a supplement to the Official Journal and can be found on the EPO website[ **30** ]. Guidance for the payment of fees and expenses is published in each issue of the Official Journal.

OJ 3/2012 Suppl.

**452**

All fees to be paid on entry into the European phase are to be paid to the EPO in euro. A list of bank accounts opened in the name of the EPO and information on the different options to make a valid payment, for instance via a deposit account held with the EPO, can be found in each issue of the Official Journal and on the EPO website[ **31** ].

**453**

Applicants having a deposit account may also make use of the automatic debiting procedure in respect of any fee that must be paid within the 31-month time limit and thereafter. If an automatic debit order is filed in due time, any fee which must be paid within the 31-month time limit will be debited on the last day of that time limit. For more information on deposit accounts, reference is made to the supplement to the third issue of the Official Journal 2009.

OJ 3/2009 Suppl.

**454**

Please note that payment of any fees in cash, by cheque or by credit card is not possible.

[ **30** ]

[www.epo.org/applying/forms-fees.html](http://www.epo.org/applying/forms-fees.html)

[ **31** ]

[www.epo.org/patents/Grant-procedure/Filing-an-application/costs-and-fees/fee-payment-methods.html](http://www.epo.org/patents/Grant-procedure/Filing-an-application/costs-and-fees/fee-payment-methods.html)

***GA E III III.***

Representation

**Requirements specific to applicants with neither residence nor principal place of business in an EPC contracting state - "non-resident applicants" (Form 1200, Sections 2 and 3)**

**Non-observance of the requirement to appoint a professional representative**

**How to appoint a representative - authorisation**

***GA E III 1 Requirements specific to applicants with neither residence nor principal place of business in an EPC contracting state - "non-resident applicants" (Form 1200, Sections 2 and 3)***

**455**

Applicants having neither their residence nor their principal place of business within the territory of one of the EPC contracting states must be represented by a professional representative and act through him in all proceedings established by the EPC.[ **32** ] In such cases a professional representative must be appointed in due time.

**Art. 27(7) PCT**

**Art. 133(2), 134 EPC**

**GL/EPO A-III, 2.1**

**456**

Two categories of professional representative have the right to practise before the EPO:

—

EPO Guide for Applicants, part II Int. - E Euro-PCT procedure before the EPO as designated or elected Office

**GA E III 2 Non-observance of the requirement to appoint a professional representative**

any professional representative entered in the directory of professional representatives maintained by the EPO[ 33 ], and

–

any legal practitioner who is qualified to practise in patent matters in one of the EPC contracting states and has his place of business in that state.

**457**

However, up to expiry of the 31-month time limit under **Rule 159 EPC**, non-resident applicants may either comply with any requirement **themselves** or act through a professional representative entitled to practise before the EPO. This means that a non-resident applicant may himself, within the 31-month time limit, for example sign and file EPO Form 1200, submit amendments, file a translation of the application, etc.

**458**

Non-resident applicants who did **not** themselves take the **required** steps for entry into the European phase **within the 31-month time limit** may subsequently perform these and the other procedural steps (e.g. filing of a request for re-establishment of rights) **only through a professional representative entitled to practise before the EPO**.

**459**

The only exception to the rule that after expiry of the 31-month time limit non-resident applicants must act in the procedure before the EPO as designated/elected Office through a professional representative is that payments to the EPO can be validly made by anybody.

**GL/EPO A-X, 1**

**460**

Under no circumstances can an applicant act through his agent appointed for the international phase if the latter is not a professional representative entitled to practise before the EPO (see **point 456**).

Further, if such representative is the appointed agent for the international phase, he is not automatically appointed for the European phase. A separate appointment is necessary (see **point 113**).

**461**

The only case in which a new appointment need not be made is if the professional representative was validly appointed in the procedure before the EPO as receiving Office and the appointment expressly extends to representation in the European phase (see **point 113**).

**462**

**Non-resident applicants** are therefore **strongly advised** to appoint a professional representative before the EPO **in good time**, i.e. before they initiate proceedings before the EPO as designated/elected Office, and to indicate this appointment in Form 1200, Sections 2 and 3 (see **points 466 ff**).

**463**

If no professional representative is appointed for the proceedings in the European phase, any communication issued by the EPO as designated/elected Office will be notified to the address of the applicant.

[ 32 ]

[www.epo.org/patents/Grant-procedure/representatives.html](http://www.epo.org/patents/Grant-procedure/representatives.html)

[ 33 ]

[www.epo.org/applying/online-services/representatives.html](http://www.epo.org/applying/online-services/representatives.html)

***GA E III 2 Non-observance of the requirement to appoint a professional representative***

**464**

In case of failure to appoint a professional representative where this is required, the applicant will be invited by the EPO to do so within a time limit of two months. Until the EPO is informed of a (valid) appointment, any procedural step taken by the applicant will be deemed not to have been taken. If within due time the deficiency has not been corrected, the application will be refused.

**R. 163(5), (6) EPC**

465

The refusal may be remedied by a request for further processing. The request will be granted if within two months from notification of the refusal a professional representative is appointed and the fee for further processing is paid.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

### ***GA E III 3 How to appoint a representative - authorisation***

466

In the procedure before the EPO as a designated/elected Office, an authorisation or (a reference to) a general authorisation need, as a rule, not be filed by a representative who identifies himself as a professional representative entered on the list maintained by the EPO. This means that for a valid appointment a professional representative merely needs to inform the EPO of his appointment for the application concerned (see **point 113**).

**Art. 133 EPC**

**R. 152(1)-(3) EPC**

OJ 2007, Spec.Ed.3, L.1

467

Legal practitioners entitled to practise before the EPO (see **point 456**) and employees representing an applicant who are not professional representatives must, as a rule, file a signed authorisation or a reference to a general authorisation. However, no (new) authorisation is to be filed where the EPO acted as receiving Office and the authorisation expressly empowered the legal practitioner or employee to act before the EPO in the European phase (see **point 113**).

**Art. 133(3) and 134(8) EPC**

GL/EPO A-VIII, 1.5-A-VIII, 1.6

468

Where an authorisation is to be filed, the use of EPO Form 1003 (**Annex VIII**) is recommended for individual authorisations and EPO Form 1004 for general authorisations. If an authorisation is required but not received, the EPO will invite the applicant or representative to file it within a period to be specified in the invitation.

GL/EPO A-VIII, 1.7

### ***GA E IV IV.***

Application documents on which the procedure before the EPO as designated/elected Office is based (Form 1200, Section 6)

**Which version of the Euro-PCT application is taken as the basis for the procedure in the European phase (Form 1200, Sections 6.1 and 6.2)?**

**Information on prior art (Form 1200, Section 6.3)**

**Amending the application – Rule 161 EPC/Rule 162 EPC communication**

**Waiving the Rule 161 EPC/Rule 162 EPC communication**

**Amendments and the Rule 161 EPC/Rule 162 EPC communication if a supplementary European search is carried out**

**Amendments and the Rule 161 EPC/Rule 162 EPC communication if no supplementary European search is carried out**

**Amendments and claims fees**

***GA E IV 1 Which version of the Euro-PCT application is taken as the basis for the procedure in the European phase (Form 1200, Sections 6.1 and 6.2)?***

469

GA E IV 2 Information on prior art (Form 1200, Section 6.3)

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When an application enters the European phase, the applicant must specify the application documents, as originally filed or as amended, on which the European grant procedure is to be based.

**R. 159(1)(b) EPC**

**470**

The documents on which the proceedings before the EPO as designated or elected Office are to be based are to be indicated in Section 6 of Form 1200 and, where necessary, further clarification may be provided on an additional sheet. The applicant must make sure that the indications in Section 6 and/or on the additional sheet correspond to any indications given in the table for Section 6 provided for calculation of the additional (page) fee to be paid for applications comprising more than 35 pages (see **points 530 ff**).

**471**

If the EPO acts as **designated** Office, the documents forming the basis for the proceedings in the European phase are to be indicated in Section 6.1.

**472**

If the EPO acts as **elected** Office, the documents forming the basis for the proceedings in the European phase are to be indicated in Section 6.2. If the applicant has filed test reports with the EPO as IPEA, it is assumed that the EPO may also use them in the European grant proceedings.

**GA E IV 2 Information on prior art (Form 1200, Section 6.3)**

**473**

If the applicant has claimed the right of priority of one or more earlier applications, he must on entry into the European phase file the results of any search carried out by or on behalf of the office of first filing (OFF) for each application whose priority is claimed. This obligation applies to international applications filed as from 1 January 2011.

**Art. 124 EPC**

**R. 70b, 141 EPC**

OJ 2010, 410, 600

OJ 2011, 62, 64

**474**

The obligation applies irrespective of the form and format in which the search results are drawn up, for instance a search report, a listing of cited prior art or a (relevant) part of an examination report. The applicant must file a complete copy of each relevant document as received from the authority concerned. However, neither a translation of the search results nor a copy of the documents cited therein need be filed.

**475**

If the search results for the priority application(s) are not available at the time of entry into the European phase, the applicant must file them as soon as he receives them.

**476**

No action is required on the part of the applicant where an exemption applies. Firstly, this is the case if the EPO is the authority that performed the search on a claimed priority application and established a search report of one of the following types: a European search report, an ISR, an international-type search report or a search report on a national application drawn up on behalf of a national office (Belgium, Cyprus, France, Greece, Italy, Luxembourg, Malta, Netherlands, Turkey).

OJ 2010, 600

**477**

A further exemption from the obligation to file a copy of any search results for a priority application applies if priority is claimed of a first filing made in:

OJ 2011, 62

—

Japan

—

United Kingdom

—

United States of America.

**478**

If the search results regarding any claimed priority application have to be filed with the EPO but are not received, the applicant will be invited to file, within a period of two months set in the invitation, the copy of the missing search results and/or a statement that these results are (in whole or in part) not available to him. The invitation will be issued at the time the examining division assumes responsibility for the application.

### ***GA E IV 3 Amending the application – Rule 161 EPC/Rule 162 EPC communication***

**479**

For the purpose of the procedure before the EPO as designated/elected Office the applicant may always file (**voluntary**) amendments within the 31-month time limit, and if he subsequently changes his mind he may file (further) amendments until expiry of the time limit set in the combined communication under **Rules 161 and 162 EPC (Rule 161 EPC/Rule 162 EPC communication)**. As set out below, the applicant may also be **required** to file (**mandatory**) amendments to and/or comments on the application within the time limit set in the **Rule 161 EPC/Rule 162 EPC communication (see point 494)**. Whether or not a response is mandatory is clearly stated in the communication, its wording thus differing depending on the case (EPO Forms 1226AA, 1226BB and 1226CC).

**Art. 28, 41 PCT**

**R. 52.1(a), 78.1(a) PCT**

**Art. 123(2) EPC**

**R. 137(2) EPC,**

**R. 161(1) EPC, R. 161(2) EPC**

**GL/EPO E-VIII, 3.1-3.3**

OJ 2009, 299

OJ 2010, 350

OJ 2010, 634

**480**

The **Rule 161 EPC/Rule 162 EPC** communication is issued for each application promptly once the application has entered the European phase and on condition that the ISR is available to the EPO. This means that it is also issued if the applicant has already filed, with Form 1200 or thereafter, amendments and/or comments to form the basis for the procedure in the European phase.

**481**

Pursuant to **Rules 161 and 162 EPC** the time limit set in the communication is six months. This time limit cannot be extended.

**482**

After expiry of the six-month time limit further possibilities for amending the application are limited. If a supplementary European search is carried out, the applicant always has one further opportunity to submit amendments upon receipt of the report (see **point 489**). Amendments made thereafter require the consent of the examining division.

**R. 137(3) EPC**

**483**

Amendments may under no circumstances go beyond the disclosure in the international application as filed.

**Art. 28(2), 41(2) PCT Art. 123(2) EPC**

**484**

Whenever amendments are filed, the applicant must **identify** them and indicate their basis in the application as filed. If he fails to do so, the examining division may issue a communication requesting correction of the omission within a non-extendable time limit of one month. If the deficiency is not remedied in due time, the application will be deemed withdrawn under **Article 94(4) EPC**. The loss of rights can be remedied with further processing.

**Art. 94(4) EPC**

**R. 137(4) EPC**

GL/EPO E-VIII, 3.4

### ***GA E IV 4 Waiving the Rule 161 EPC/Rule 162 EPC communication***

**485**

In order to accelerate the European grant procedure the applicant can, if so desired in addition to a PACE request (see **point 441**), waive his right to the **Rule 161 EPC/Rule 162 EPC** communication by crossing the box in Section 6.4 of Form 1200.

OJ 2011, 354

**486**

This waiver will be effective and no **Rule 161 EPC/Rule 162 EPC** communication issued only if the applicant has taken all steps required to make its issuance superfluous. In other words, he must ensure that the application can proceed to the next phase of the European grant procedure without the communication being issued. This means that within the 31-month time limit he must have:

—

paid any claims fees due for the set of claims indicated as the basis for the procedure in the European phase, and

—

filed a substantive response, as the case may be, to the WO-ISA, the IPER or the SISR established by the EPO, if in the absence of such a response the EPO would invite the applicant to do so under **Rule 161(1) EPC** (“mandatory response”).

**487**

If any requirement for the waiver to be effective is not fulfilled, a **Rule 161 EPC/Rule 162 EPC** communication will be issued and processing of the application will not start until the six-month time limit set therein has expired. This applies even if a request under the PACE programme is or has been filed (see **point 441**).

### ***GA E IV 5 Amendments and the Rule 161 EPC/Rule 162 EPC communication if a supplementary European search is carried out***

**488**

If the **EPO did not act as ISA or SISA** for the application it will upon entry into the European phase draw up a supplementary European search report (see **point 562**). Up to expiry of the time limit set in the **Rule 161 EPC/Rule 162 EPC** communication the applicant may file (“voluntary”) amendments and comments. All amendments and comments filed within the time limit set in the communication will be taken into account in drawing up the supplementary European search report and the search opinion (see **points 562, 564**). This means that the supplementary European search will be based on the last set of claims filed up to expiry of this time limit for which any claims fee due is paid (see **point 597**).

**R. 161(2) EPC**

OJ 2010, 406, **point 6**

OJ 2010, 634

GL/EPO E-VIII, 3.1-3.2, 4.3

**489**

After issuance of the supplementary European search report the applicant may, first of all, comment on both the report and the search opinion and file (“voluntary”) amendments to the description, claims and drawings within the period specified in the communication under **Rule 70a(2) EPC** for indicating whether he wishes to proceed further with the application.

**R. 137(2) and 70a(2) EPC**

**490**



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GA E IV 6 Amendments and the Rule 161 EPC/Rule 162 EPC communication if no supplementary European search is carried out

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Secondly, if any deficiencies are noted in the search opinion, the applicant will be required under **Rule 70a(2) EPC** to respond to the objections made. The application will be deemed withdrawn if the applicant does not submit a substantive reply to the communication under **Rule 70a(2) EPC** ("mandatory response"). The loss of rights can be remedied with further processing.

**Art. 121 EPC**

**R. 135 EPC, R. 70a(2) EPC**

**491**

It is at the discretion of the examining division to accept any further amendment at a later stage of the proceedings.

**R. 137(3) EPC**

***GA E IV 6 Amendments and the Rule 161 EPC/Rule 162 EPC communication if no supplementary European search is carried out***

**492**

If the **EPO has performed a search** for an international application in its capacity as **ISA or SISA**, it will not carry out a supplementary European search upon entry into the European phase (see **point 562**), and any amendments filed within the time limit set in the **Rule 161 EPC/Rule 162 EPC** communication will serve as the basis for examination.

**R. 137(2) and 161(1) EPC**

**GL/EPO E-VIII, 3.2**

**493**

If the EPO in the international phase made any negative finding and drew up a "negative WO-ISA" or, where the EPO also acted as IPEA, a "negative IPER" or made "objections" in the explanatory notes on the SISR ("negative SISR"), the applicant is required under **Rule 161(1) EPC** to respond to this finding ("mandatory response").

**494**

If a response is mandatory, the applicant must respond to the **Rule 161 EPC/Rule 162 EPC** communication within the six-month time limit set therein, unless a substantive response has already been submitted. For the purpose of **Rule 161(1) EPC** new amendments filed on entry into the European phase and up to the time the **Rule 161 EPC/Rule 162 EPC** communication is issued are held to constitute a response on condition that the applicant has indicated - preferably in Box 6 of Form 1200 - that they form the basis for prosecution of the application in the European phase.

**495**

Under the same conditions as for amendments made on entry into the European phase or thereafter, but subject to certain requirements set out in detail in the Guidelines, any amendments made under **Article 19 PCT** and/or **Article 34 PCT** and maintained for the processing of the application in the European phase will constitute a response.

**GL/EPO E-VIII, 3.2-3.3**

**496**

If a "mandatory response" is not filed in due time, the application is deemed withdrawn under **Rule 161(1) EPC**. Further processing may be requested.

**Art. 121 EPC**

**R. 135 EPC**

**497**

Further, if the EPO acted as ISA, SISA or IPEA in the international phase, and regardless of whether the EPO in the international phase made any negative finding (see **point 493**), the applicant has the right to submit (further) comments on the WO-ISA, IPER and SISR and to file (further) voluntary amendments as he sees fit within the time limit set in the invitation.

**R. 137(2) EPC**

**498**

All comments and amendments validly filed by the applicant on a mandatory or voluntary basis within the time limit set in the **Rule 161 EPC/Rule 162 EPC** communication will be taken into account in

GA E IV 7 Amendments and claims fees

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the examination proceedings. This means that examination will be based on the last set of claims filed up to expiry of this time limit for which any claims fee required is duly paid (see **points 596 ff**).

OJ 2010, 634

**499**

It is at the discretion of the examining division to accept any further amendment at a later stage of the examination proceedings.

**R. 137(3) EPC**

*GA E IV 7 Amendments and claims fees*

**500**

The claims fees are calculated on the basis of the number of claims contained in the application in the version that is, in accordance with the indications in Form 1200, to be taken as the basis for the procedure in the European phase. The amount of the claims fee varies according to a two-tier system. For the 16th and each further claim a claims fee must be paid. However, for any claim over 50 a higher amount is due (see **points 596 ff**).

**R. 162 EPC**

**Art. 2.15 RFees**

OJ 2009, 118 (3.1)

GL/EPO E-VIII, 2.1.3

**501**

Where claims fees are to be paid, they must be paid within the 31-month time limit. If the applicant fails to pay (the correct amount of) claims fees in due time, he is invited in the **Rule 161 EPC/Rule 162 EPC** communication to pay the missing amount within the non-extendable six-month time limit set therein (see **point 481**). If a supplementary European search is carried out, it will relate to the last set of claims received before expiry of the six-month time limit and will be confined to claims for which any claims fees, where applicable, have been paid in due time.

**502**

Where the number of claims changes as a consequence of a (further) amendment submitted within the six-month time limit set in the **Rule 161 EPC/Rule 162 EPC** communication (see **point 481**), that number is decisive for calculating the amount of the claims fees to be paid.

**503**

If consequent to the amendments made before expiry of the six-month time limit the number of claims forming the basis for the further procedure is reduced, any claims fees overpaid will be refunded.

**R. 162(3) EPC**

**504**

Claims for which a fee due is not paid are deemed to be abandoned, and the applicant is notified thereof. The loss of rights may be remedied by further processing. Features of a claim deemed abandoned which are not otherwise to be found in the description cannot be reintroduced into the application.

**Art. 121 EPC**

**R. 135, 162(4) EPC**

**J 15/88**

OJ 1990, 445

*GA E V V.*

Translation of the application documents and other documents (Form 1200, Section 7)

**When must the applicant file a translation of the Euro-PCT application?**

**What the translation must include**

*GA E V 1 When must the applicant file a translation of the Euro-PCT application?*



**505**

If the Euro-PCT application was not published by the IB in an official language of the EPO (English, French, German), the applicant must, within the 31-month time limit, submit to the EPO a translation of the application into any such language (Form 1200, Section 7).

**Art. 22(1), 39(1) PCT**

**R. 49.2 PCT**

**Art. 14(2), 153(4) EPC**

**R. 159(1)(a) EPC**

**GL/EPO E-VIII, 2.1.2**

**506**

If a translation must be filed, the language of the translation determines the language of the proceedings before the EPO (see **point 418**). At any time during the processing of the application in the European phase, errors made in the translation may be corrected.

**Art. 14(3) EPC**

**507**

If the international application has been published by the IB in an official language of the EPO, no translation is required and any translation that is nevertheless filed will be ignored, since the language of the proceedings may not be changed upon entry into the European phase.

**G 4/08**

OJ 2010, 572

**508**

In written proceedings the applicant may use any official language of the EPO, but any amendments to the application must always be filed in the language of the proceedings (see **point 418**).

**R. 3 EPC**

**509**

On the question of whether a translation of the priority document must be submitted, reference is made to **points 618 ff.**

**Consequences of not filing a translation of the application**

***GA E V 2 Consequences of not filing a translation of the application***

**510**

If the translation of the Euro-PCT application is not filed within the time limit, the application is deemed to be withdrawn and the applicant is informed of this in a communication. Moreover, the application will not be considered as comprised in the state of the art under **Article 54(3) EPC** (see **point 644**).

**Art. 24(1)(iii) PCT, Art. 39(2) PCT**

**R. 76.5 PCT**

**Art. 153(4) EPC**

**R. 112, 160 EPC**

**511**

The loss of rights is deemed not to have occurred if, within two months from notification of the above communication, the translation is supplied and further processing is requested by payment of the relevant fee.

**Art. 121 EPC**

**R. 135(1) EPC**

**Art. 2.12 RFees**

**512**

Alternatively, the applicant may request reinstatement of rights under **Rule 49.6 PCT** if the application is deemed withdrawn because the translation was not filed in due time. However, given that the fee is higher and stricter requirements apply, this remedy has no advantages unless the period for requesting further processing has already expired.

**R. 49.6 PCT**

**Art. 122 EPC**

**R. 136 EPC**

**Art. 2.13 RFees**

***GA E V 3 What the translation must include***

**513**

The translation must always include:

**R. 49.3 PCT and R. 49.5 PCT**

- the description (as originally filed)
- the claims (as originally filed)
- any text in the drawings (as originally filed)
- the abstract (as published).

**514**

If the EPO acts as **designated** Office the translation must, where applicable, also include:

**R. 49.5 PCT**

– **only if** the applicant wishes such amendments to form the basis of further proceedings, any **amendments made to the claims** under **Article 19 PCT** in the form of a translation of the complete set of claims furnished in replacement of all claims originally filed (see **point 241**) together with, if submitted to the IB, the statement under **Article 19(1) PCT** explaining the amendments and, in every case, the accompanying letter under **Rule 46.5(b) PCT**. If a translation of the complete set of claims submitted under **Article 19 PCT** is not furnished or not accompanied by a translation of, if submitted to the IB, the statement under **Article 19(1) PCT** and, in every case, the accompanying letter under **Rule 46.5(b) PCT**, it will be **disregarded** for the further proceedings. If only the statement under **Article 19(1) PCT** is missing, only that document will be disregarded.

**Art. 19 PCT**

**R. 46.4 PCT and R. 46.5 PCT, R. 49.3 PCT, R. 49.5(c) PCT, R. 49.5(c-bis) PCT**

- any published request for rectification

**R. 91.3(d) PCT,**

**R. 48.2(a)(vii) PCT**

- any sequence listing, unless the text in the sequence listing is available to the EPO in English (see **point 527**)

**R. 49.5(a-bis) PCT, R. 13ter PCT**

- any separately furnished references to deposited biological material (Form 1200, Section 8).

**R. 49.5(h) PCT, R. 13bis.3 PCT and R. 13bis.4 PCT**

**515**

In addition, if the EPO acts as **elected** Office, translations of **any annexes** to the international preliminary examination report (IPER) **must always be furnished**, i.e. regardless of whether protection is sought for the same version of the application documents as was the subject of that report. Therefore, a translation of any amendments made under **Article 19 PCT** must also always be filed if such amendments are annexed to the IPER.

**Art. 36(2)(b) PCT and Art. 36(3)(b) PCT, Art. 39(2) PCT**

**R. 70.16 PCT, R. 74.1(a) PCT**

**516**

If the applicant wishes the amendments to the claims made before the IB under **Article 19 PCT** to form the basis of the subsequent procedure before the EPO as elected Office, and these amendments are **not** annexed to the IPER (for instance because they were considered reversed by an amendment

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**GA E V 4 Consequences of not filing a translation of the annexes to the IPER**

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under **Article 34 PCT**), then these amendments and any statement under **Article 19(1) PCT** explaining them and, in every case, the letter under **Rule 46.5(b) PCT** must also be furnished in translated form, as otherwise they will be disregarded for the further proceedings. If only the statement under **Article 19(1) PCT** is missing, only that document will be disregarded (see **point 514**).

**Consequences of not filing a translation of the annexes to the IPER**

***GA E V 4 Consequences of not filing a translation of the annexes to the IPER***

**517**

If the translation of all annexes to the IPER is not filed in due time, the applicant is invited to furnish the missing translation within two months of notification of the communication. If the applicant fails to comply, the Euro-PCT application is deemed to be withdrawn. The applicant may request further processing (or reinstatement of rights, see **points 511 ff**).

**Art. 121 EPC**

**R. 135, 160 EPC**

***GA E VI VI.***

Biological material & nucleotide and amino acid sequences

**Biological material (Form 1200, Section 8)**

**Waiver under Rule 33(2) EPC**

**Nucleotide and amino acid sequences (Form 1200, Section 9)**

**Consequences of not filing a sequence listing**

***GA E VI 1 Biological material (Form 1200, Section 8)***

**518**

For the sufficient disclosure of an invention which involves the use of or concerns biological material which is not available to the public and which cannot be described in the application in an enabling manner for the skilled person, specific requirements must be met on the international filing date (see **point 146**). If any of these requirements was not met within the applicable time limit, no remedy is available before the EPO as designated/elected Office upon entry into the European phase. Extensive information is provided in the Notice from the EPO dated 7 July 2010.

**R. 13bis.3 PCT and R. 13bis.4 PCT**

**R. 31, 32 EPC**

OJ 2010, 506

**519**

If on filing the international application a reference to the deposit of biological material complying with **Rule 31 EPC** was made but no proof of the deposit in the form of a copy of the receipt issued by the depositary institution was submitted, the applicant is strongly advised to do so upon entry into the European phase.

**520**

If the Euro-PCT application was not published by the IB in an official language of the EPO, the biological material referred to in the application will be available upon request to any person (only) from the date of publication of the translation by the EPO. In this case, if the applicant files the statement under **Rule 32(1) EPC** before the technical preparations for publication of the translation by the EPO are completed, the biological material concerned will be made available only by the issue of a sample to an expert nominated by the requester.

***GA E VI 2 Waiver under Rule 33(2) EPC***

**521**

**GA E VI 3 Nucleotide and amino acid sequences (Form 1200, Section 9)**

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The issue of a sample of biological material may be requested by any person under the conditions set out in **Rule 33(1) EPC** and requires that the requester has undertaken vis-à-vis the applicant in accordance with **Rule 33(2) EPC** not to make the biological material concerned available to any third party and to use that material for experimental purposes only.

**R. 33(2) EPC**

OJ 2010, 498

**522**

In Form 1200, Section 8, the applicant is given the option of waiving his right to an undertaking by the requester pursuant to **Rule 33(2) EPC** on condition that the applicant is the depositor of the biological material. A waiver may, however, be filed at any time in the form of a signed statement containing a specification of the biological material concerned.

**GA E VI 3 Nucleotide and amino acid sequences (Form 1200, Section 9)**

**523**

Where the Euro-PCT application discloses nucleotide or amino acid sequences, a **sequence listing in electronic (TXT) form drawn up in compliance with WIPO Standard ST.25** must be available to the EPO as a designated/elected Office on expiry of the 31-month time limit. The sequence listing does not have to be filed on paper. Extensive information is provided in the Notice from the EPO dated 28 April 2011.

**R. 5.2, 13ter.3 PCT**

**R. 30, 163(3) EPC**

OJ 2011, 372 and 376

OJ 2007, Spec.Ed. 3, A.5

GL/EPO A-IV, 5 and E-VIII, 2.4.2

**524**

As a rule the required sequence listing will be available to the EPO if it was contained in the international application under **Rule 5.2 PCT** or filed under **Rule 13ter PCT** with the EPO acting as ISA/SISA or IPEA (see **points 153 ff**). Further, it will also be accessible to the EPO if it is made available by WIPO on Patentscope and can be downloaded in a usable form.

**525**

The applicant should in due time verify whether the sequence listing is available to the EPO in the required form and, if it is not, file it before expiry of the 31-month time limit online or on a data carrier.

**526**

If a sequence listing must be filed upon entry into the European phase, the applicant must enclose a statement to the effect that the sequence listing contains only the sequence information contained in the original application documents. This statement can be made by crossing the appropriate box in Section 9.2 of Form 1200.

**527**

A translation of any text matter in a sequence listing which forms part of the description or which was filed subsequently need only be provided if it is not yet available to the EPO in English (see **point 514**).

**R. 5.2(b) PCT, R. 12.1(d) PCT, R. 13ter PCT, R. 49.5(a-bis) PCT**

**GA E VI 4 Consequences of not filing a sequence listing**

**528**

If on expiry of the 31-month time limit a sequence listing in electronic form complying with WIPO Standard ST.25 is not available to the EPO, the applicant will be invited to furnish such a sequence listing and pay the late furnishing fee within a non-extendable period of two months.

**R. 30(3), 163(3) EPC**

**Art. 2.14a RFees**

**529**

If the required sequence listing is not filed within the time limit set, the application is refused. The refusal may be remedied by a request for further processing.

**Art. 121 EPC**

**R. 135 EPC**

**GA E VII VII.**

Filing fee

**530**

Within the 31-month time limit the European filing fee must be paid, this being composed of a basic filing fee and an additional fee which is due for the 36th and each subsequent page of the application. In the case of Euro-PCT applications, the pages forming the basis for the procedure in the European phase are counted as set out below. The additional fee is referred to as the "page fee".

**Art. 22(1), 39(1) PCT**

**Art. 78(2) EPC**

**R. 159(1)(c) EPC**

**Art. 2.1 RFees**

OJ 2009, 118, 338

GL/EPO A-III, 13.1 and E-VIII, 2.1.3

**531**

The requirement to pay the European filing fee on entry into the European phase implements the right of the EPO as a designated/ elected Office to require payment of a "national fee" under **Articles 22(1) PCT** and **Articles 39(1) PCT**.

**532**

The basic filing fee is reduced where Form 1200 is filed online (see **point 424**).

**Page fee**

**Non-observance of the time limit for payment of the filing fee**

**GA E VII 1 Page fee**

**533**

Applicants are advised to compute the correct page fee with the help of Form 1200, section 6, and in particular the related table, which is part of Form 1200. Precise and correct indications in section 6 and the table are required to ensure that the EPO does not deem the application to be withdrawn due to payment of what appears to be an incorrect amount of the filing fee. In particular, if the international application has not been published in an official language of the EPO, the applicant is advised to consult the information published in OJ 2009, page 338.

**R. 38(2) EPC**

**Art. 2.1a RFees**

GL/EPO A-III, 13.2

**534**

Regardless of the language of publication, the page fee is based on the international application as published. The pages of the description, claims and drawings are counted, plus one page in total for any pages with the bibliographic data and the abstract. Amended claims under **Article 19 PCT** are also considered part of the international publication and must be taken into account unless the applicant has indicated that the procedure in the European phase is not to be based on them.

**535**

If amendments to the **claims** are filed for the procedure in the European phase, the entire set of claims must always be submitted, and this set will form the basis for calculating the page fee and will replace any earlier set of claims filed.

**536**

**GA E VII 2 Non-observance of the time limit for payment of the filing fee**

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If amendments to the **description** are filed, in computing the page fee the pages of the description are counted as follows: the pages of the description as published, plus any pages submitted as amendments to the description, minus the pages which are replaced by the amendments to the description filed upon entry into the European phase.

**537**

If the application was processed under **PCT Chapter II**, the amendments filed under **Article 34 PCT** are to be taken into account in computing the page fee unless the applicant indicates that these pages are not to form the basis for the procedure in the European phase.

**538**

Form 1200 and any sequence listing presented as a separate part of the description in accordance with the requirements of WIPO Standard ST.25 are disregarded for the purpose of these calculations.

**539**

Pages with amendments filed after expiry of the 31-month time limit are not taken into account in calculating the filing fee. Consequently, even if amendments submitted after expiry of the 31-month time limit reduce the number of pages already paid for, no refund will be made.

***GA E VII 2 Non-observance of the time limit for payment of the filing fee***

**540**

If the **filing fee**, i.e. the basic filing fee and/or, where applicable, the page fee, is not paid in full in due time, the application is deemed to be withdrawn. Further, the Euro-PCT application will not be considered as comprised in the state of the art under **Article 54(3) EPC** (see **point 644**). The applicant is informed of the loss of rights in a communication under **Rules 112(1)** and **160(2) EPC**.

**Art. 153(5) EPC**

**R. 160, 165 EPC**

**541**

Further processing may be requested within two months from notification of the communication of the loss of rights by payment of the filing fee or the missing part of the filing fee together with the fee for further processing.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

**542**

If the basic filing fee is not paid (in full) in due time, the fee for further processing amounts to 50% of the basic filing fee. If the page fee is not paid (in full), the fee for further processing in respect of this part of the filing fee amounts to 50% of the page fee for the number of pages for which the page fee has not been paid.

**543**

The applicant may also request re-instatement of rights if the application is deemed withdrawn because the filing fee was not paid in due time. Given the fact that the fee is higher and stricter requirements apply, this remedy has no advantages, unless the period for requesting further processing has already expired (see **point 512**).

**R. 49.6 PCT**

**Art. 122 EPC**

**R. 136 EPC**

**Art. 2.13 RFees**

OJ 2007, 692

***GA E VIII VIII.***

Designations and extensions

**544**

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**GA E VIII 1 Non-observance of the time limit for payment of the designation fee**

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A (flat) designation fee must be paid within 31 months from the filing date or, if priority has been claimed, the earliest priority date, or within six months from the date of publication of the ISR, whichever time limit expires later. Therefore, unless the publication of the ISR was considerably delayed, the designation fee must be paid within the 31-month time limit.

**Art. 79(2) EPC**

**R. 39 EPC, R. 159(1)(d) EPC Art. 2.3 RFees**

OJ 2009, 118

**GL/EPO A-III, 11.3.9; E-VIII, 2.1.3, 2.3.11**

**545**

Payment of the designation fee will be effective only in respect of EPC contracting states that were designated for a European patent in the international application on the international filing date (see **point 115**).

**546**

Applicants are reminded that upon filing of the PCT request all PCT contracting states are automatically designated for both a national and, where applicable, a regional patent. Therefore, payment of the (flat) designation fee on entry into the European phase confirms the designation of the EPC contracting states that were **EPC and PCT contracting states at the international filing date** (see **point 116**). An exception applies where the applicant has withdrawn the designation for a European patent in respect of one or more EPC contracting states during the international phase.

**547**

If a state for which patent protection is sought was neither an EPC contracting state nor an extension state at the international filing date (see **point 551**), the applicant must enter the national phase in the state concerned to obtain patent protection for that state on the basis of his international application. If, however, before entry into force of the EPC for a state an extension agreement with that state was in force, patent protection in that state may still be obtained on the basis of the extension agreement for any application filed before the extension agreement was rescinded (see **point 126**).

**Non-observance of the time limit for payment of the designation fee**

**How to extend the Euro-PCT application (Form 1200, Section 11)**

**Non-observance of the time limit for payment of extension fees**

***GA E VIII 1 Non-observance of the time limit for payment of the designation fee***

**548**

If the designation fee is not paid in due time, the application is deemed withdrawn. The applicant will be informed thereof in a communication under **Rules 112(1) and 160(2) EPC**.

**R. 160 EPC**

**GL/EPO E-VIII, 2.1.3**

**549**

Further processing may be requested within two months after notification of the communication of the loss of rights by payment of the designation fee together with the fee for further processing, which amounts to 50% of the designation fee.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.3, 2.12 RFees**

**550**

Since the designation fee does not form part of the national fee (see **point 530**), the remedy of reinstatement of rights under **Rule 49.6 PCT** is not available.

**R. 49.6 PCT**

***GA E VIII 2 How to extend the Euro-PCT application (Form 1200, Section 11)***

**551**



**GA E VIII 3 Non-observance of the time limit for payment of extension fees**

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Under certain conditions a European patent may be extended to states which are not EPC contracting states on the international filing date but have concluded an extension agreement with the EPO to that effect.

**GL/EPO A-III, 12 and E-VIII, 2.1.3**

OJ 1994, 75; 1996, 82; 1997, 538; 2004, 117, 619; 2007, 406; 2009, 603; 2010, 10

**552**

Extension of a European patent is possible only if the state concerned was designated in the international application for a national patent and an extension agreement with the EPO was in force at the international filing date (see **point 122**).

**553**

Extension is deemed requested for any international application entering the European phase in respect of any state designated in the application with which an extension agreement was in force **at the international filing date**. However, such request is deemed to be withdrawn in respect of each extension state for which no extension fee is paid in due time. The applicant must, therefore, carefully check for which states extension is possible and, if extension is wished, pay the required extension fees in due time.

**554**

Pursuant to the applicable national provisions of the extension states, an extension fee must be paid within the same time limit as applies for payment of the designation fee (see **point 530**).

**555**

Since there is no flat extension fee, an extension fee must be paid for each of the extension states for which extension is wished. The amount of the extension fee can be found in the EPO's Schedule of fees and expenses (under "Miscellaneous fees" in point 4).

**556**

In Form 1200, Section 11, the applicant may indicate for which states he intends to pay (an) extension fee(s). However, the request for extension is deemed to be withdrawn, if the extension fee for an extension state is not paid in due time. In addition to the boxes provided for the states with which an extension agreement was in force on 1 April 2012 - i.e. Bosnia and Herzegovina (BA) and Montenegro (ME) - further states may be indicated on condition that an extension agreement with that state was in force **at the filing date** of the international application.

**557**

Upon payment, the applicant must specify the extension states for which payment is actually made and in particular if the payment does not correspond to the indications provided in Form 1200, Section 11.

***GA E VIII 3 Non-observance of the time limit for payment of extension fees***

**558**

If no valid payment is made, any (deemed) request for extension is deemed withdrawn.

**GL/EPO A-III, 12.2**

OJ 2009, 603

**559**

If an extension fee is not paid in due time - even if the intention to pay the extension fee for one or more states was indicated in Form 1200, Section 11 - **no** communication pointing out the failure to observe the time limit for payment is issued. However, the applicant may still pay an extension fee after expiry of the (basic) time limit for payment of the designation fee and the extension fees under the following circumstances:

**560**

Firstly, within a grace period of two months as from expiry of the basic time limit, any extension fee may always be paid with a 50% surcharge.

**561**

Secondly, where in the absence of payment of the designation fee in due time further processing can be requested in respect of the **designation fee**, the applicant may within two months from notification of the communication of the loss of rights also pay the extension fee(s) with a 50% surcharge.



**GA E IX IX.**

Supplementary European search

**562**

As a rule, a supplementary European search must be performed for each international application entering the European phase and a search fee must be paid. For an exception see **point 567 ff.** Like any European search report, the supplementary European search report is accompanied by an opinion under **Rule 62 EPC**, the European search opinion (ESOP), on whether the application and the invention to which it relates meet the requirements of the EPC. The supplementary European search report together with the search opinion is known as the "extended (supplementary) European search report" (EESR).

**Art. 153(7) EPC**

**R. 62 EPC, R. 159(1)(e) EPC**

OJ 2005, 435-I

GL/EPO B-II, 4.2, 4.3; E-VIII, 3.1

**563**

No search opinion under **Rule 62 EPC** will be issued if the applicant:

—

has filed the request for examination according to **Rules 159(1)(f) EPC** and

—

has waived the right to be asked under **Rule 70(2) EPC** whether he wishes to proceed further with the application (see **points 581 and 584**)

before the supplementary European search report has been transmitted to him. Instead, a communication will be issued under **Rule 71(1)** or **71(3) EPC**, respectively inviting the applicant to correct and/or amend the application or informing him of the text in which the EPO intends to grant the patent.

GL/EPO B-X, 1, B-X, 4;

B-XI, 7; C-VI, 3

**564**

The supplementary European search is performed on the basis of the last set of (amended) claims available to the EPO on expiry of the time limit set in the **Rule 161 EPC/Rule 162 EPC** communication (see **points 488 ff.**). That set of claims is considered the final set at the time the search is performed (see **point 479**). Any claim for which a claim fee due has not been paid will not be searched (see **points 599 ff.**).

**R. 161 EPC**

**565**

If a supplementary European search is carried out, the European Patent Bulletin will mention the date of despatch of the supplementary European search report. The report is not published, but is available through file inspection.

**566**

If during the supplementary European search the EPO comes to the conclusion that no search or only a partial search can be carried out, it will issue, depending on the case, a declaration of no search or a partial supplementary European search report, which takes the place of the European search report.

**R. 63 EPC**

GL/EPO B-VIII, 3.3, and B-X, 8

**No supplementary European search performed**

**Result of supplementary European search and refund of examination fee**

**Search fee for supplementary European search**

**Refund of the search fee**

**GA E IX 1 No supplementary European search performed**

**567**

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**GA E IX 2 Result of supplementary European search and refund of examination fee**

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As a rule a supplementary European search is carried out. Dispensation applies and no search fee is to be paid only if the EPO acted as ISA or SISA for the application in the international phase.

**Art. 153(7) EPC**

OJ 2009, 594

**568**

If dispensation applies, it also applies where instead of an ISR a declaration of non-establishment under **Article 17(2)(a) PCT** was issued.

**Art. 17(2)(a) PCT**

**Art. 153(6) EPC**

**569**

If no supplementary European search report is drawn up, the Euro-PCT application will, after formalities examination, be passed on for substantive examination on condition that a request for examination has been validly filed (see **points 580 ff**).

***GA E IX 2 Result of supplementary European search and refund of examination fee***

**570**

Where the request for examination was filed before transmittal of the supplementary European search report, which is usually the case (see **point 583**), the EPO invites the applicant after transmittal of the supplementary European search report to indicate whether he wishes to proceed further with the application, unless the applicant has expressly waived the right to receive such invitation (see **point 584**).

**R. 70(2), 70a(2) EPC**

OJ 2009, 533

GL/EPO A-VI, 2.3, 2.5; B-XI, 7

**571**

Where the applicant **wishes to proceed further**, he must notify the EPO accordingly within the time limit set. Within the same time limit he may comment on the supplementary European search report by filing amendments. He must also make sure that, if the EPO has issued a negative written opinion, a substantive (mandatory) reply is submitted to ensure that the application is not deemed withdrawn in its absence (see **point 490**).

**572**

If the applicant **does not wish to proceed further**, he may withdraw the application, or refrain from answering within the time limit set in the respective invitation. This will result in the application being deemed withdrawn.

**R. 70(3) EPC**

**573**

Where the application is withdrawn or deemed withdrawn before the examining division has assumed responsibility, the examination fee is refunded in full.

**574**

If prosecution is stopped after the applicant has indicated that he wishes to proceed further and the examining division has assumed responsibility, the applicant may be entitled to a refund of 75% of the examination fee. This also applies if no supplementary European search report is drawn up (see **points 567 ff**).

**Art. 11 RFees**

OJ 2009, 542

***GA E IX 3 Search fee for supplementary European search***

**575**

If a supplementary European search is to be performed, the European search fee must be paid within the 31-month time limit.

**R. 159(1)(e) EPC**

**Art. 2.2 RFees**

OJ 2012, 207

**Reduction of the search fee**

***GA E IX 4 Reduction of the search fee***

**576**

If a supplementary European search report is to be established, the European search fee may be reduced. The reductions in the search fee applicable on 1 April 2012 may be summarised as follows:

**Art. 153(7) EPC**

OJ 2005, 548

OJ 2011, 616

**GL/EPO A-X, 9.3.1**

—

a reduction of EUR 190 for international applications for which the ISR was drawn up exclusively by any of the following ISAs: the Australian Patent Office, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Russian Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation), the United States Patent and Trademark Office (USPTO) or the State Intellectual Property Office of the People's Republic of China (SIPO).

—

a reduction of EUR 990 for international applications for which the ISR was drawn up by a European ISA: the Austrian Patent Office, the National Board of Patents and Registration of Finland, the Spanish Patent and Trademark Office, the Swedish Patent and Registration Office or the Nordic Patent Institute (NPI).

***GA E IX 5 Refund of the search fee***

**577**

If the application claims the priority of an earlier application for which a search was carried out by the EPO, (a part of) the fee paid for the supplementary European search may be refunded. The level of the refund depends on the type of earlier search and the extent to which the EPO benefits from the earlier search report when carrying out the supplementary European search.

OJ 2009, 99

OJ 2010, 338

**Art. 9(2) RFees**

**GL/EPO A-X, 10.2.1**

**Non-observance of the time limit for payment of the search fee**

***GA E IX 6 Non-observance of the time limit for payment of the search fee***

**578**

If the search fee is not paid in due time the Euro-PCT application will be deemed to be withdrawn and the applicant will be informed of this in a communication under **Rules 112(1) and 160(2) EPC**.

**R. 160 EPC**

**579**

The loss of rights is deemed not to have ensued if within two months after notification of this communication further processing is requested by payment of the further processing fee, which amounts to 50% of the search fee, together with the missing search fee.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

***GA E X X.***

Examination

**How to file the request for examination (Form 1200, Section 4)**

**When must the request for examination be filed? When must the examination fee be paid?**

**Reduction of the examination fee**

**Reduction if IPER was issued by the EPO**

**Non-observance of the time limit for filing the request for examination and payment of the examination fee**

***GA E X 1 How to file the request for examination (Form 1200, Section 4)***

**580**

A European patent may only be granted if the substantive examination of the application shows it to meet the requirements of the EPC. Substantive examination of an application will only start upon explicit request.

**Art. 94 EPC**

GL/EPO E-VIII, 2.1.3, 2.5.2

**581**

The applicant must therefore file a written request for examination. If Form 1200, as recommended, is used (see **point 420**), this requirement will always be met since the appropriate check-box is pre-crossed (Form 1200, Section 4).

**R. 70 EPC**

**582**

The request for examination is only effective if the examination fee has been paid. Therefore, the examination fee must be paid in due time (see **points 583-586** and **591**).

***GA E X 2 When must the request for examination be filed? When must the examination fee be paid?***

**583**

The request for examination must be filed and the examination fee paid within 31 months from the filing date or, if priority has been claimed, from the earliest priority date, or up to six months after the date of publication of the ISR, whichever time limit expires later. Therefore, as a rule and unless the ISR was published after 25 months from the date of filing or the earliest priority date, the request for examination must be filed and the examination fee paid within the 31-month time limit.

**R. 70(1) EPC, R. 159(1)(f) EPC**

**Art. 2.6 RFees**

GL/EPO C-II, 1.2

**584**

In most cases the request for examination must be filed and the examination fee must be paid before the supplementary European search report is transmitted to the applicant (see **point 570**). After transmission of the report, the EPO will invite the applicant to indicate whether he wishes to proceed further with the application (see **point 570**). The applicant can waive his right to be asked whether he wishes to proceed further with the application, e.g. by crossing the box in Section 4.2 of Form 1200.

**585**

On the right to a refund of the examination fee see **points 573** ff.

**586**

Neither the drawing-up of a supplementary European search report (see **points 565** ff) nor publication of the translation of the Euro-PCT application (see **points 507** ff) affect the time limit for filing the request for examination and payment of the examination fee.

***GA E X 3 Reduction of the examination fee***

**587**

**GA E X 4 Reduction if IPER was issued by the EPO**

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Applicants who have their residence or principal place of business in an EPC contracting state having a language other than English, French or German as an official language, and nationals of such states who are resident abroad, are entitled to a **20% reduction in the examination fee** on condition that they

**Art. 14(4) EPC**

**R. 6(3) EPC**

**Art. 14(1) RFees**

**GL/EPO A-X, 9.2.3**

—  
file the written request for examination in one of the official languages of this state other than English, French or German, and

—  
within one month of so doing - at the earliest simultaneously with the written request for examination - file a translation in the language of the proceedings (see **point 418**).

**588**

Please note that once the examination fee has been paid and the request for examination in an EPO language has been filed, the applicant is no longer entitled to the reduction in the examination fee if thereafter the request for examination is filed in an admissible non-EPO language.

***GA E X 4 Reduction if IPER was issued by the EPO***

**589**

The examination fee is reduced by 50% where the EPO acting as IPEA has already drawn up an international preliminary examination report in respect of the relevant Euro-PCT application, unless in the European phase the applicant is seeking a patent for an invention which is not the subject of that report (see **points 382 and 392 ff**).

**Art. 14(2) RFees**

**GL/EPO A-X, 9.3.2**

**590**

If the conditions for both reductions (see **points 587-589**) are fulfilled, the examination fee is first reduced by 50%. The 20% reduction is applied to the resulting total and not to the full fee. Therefore, the total reduction in relation to the full fee is 60%.

***GA E X 5 Non-observance of the time limit for filing the request for examination and payment of the examination fee***

**591**

If the request for examination is not filed or the examination fee is not paid in due time, the application is deemed to be withdrawn. The applicant is informed of this in a communication under **Rules 112(1) and 160(2) EPC**. The loss of rights is deemed not to have ensued if within two months after notification of this communication further processing is requested by payment of the further processing fee, which amounts to 50% of the examination fee, together with the missing examination fee.

**Art. 121 EPC**

**R. 135, 160(2) EPC**

**Art. 2.12 RFees**

**592**

If, exceptionally, the applicant neither filed the request for examination nor paid the examination fee in due time, further processing must be requested in respect of **both omissions**, i.e. in respect of filing the request for examination and payment of the examination fee. It follows that the applicant must file the request for examination and pay the examination fee itself together with two fees for further processing: the flat fee for further processing in respect of the request for examination and 50% of the examination fee.

## ***GA E XI XI.***

Renewal fee and claims fees

**Renewal fee**

**Claims fees**

### ***GA E XI 1 Renewal fee***

#### **593**

The renewal fees for a pending Euro-PCT application must be paid to the EPO. These fees are due in respect of the third and each subsequent year, calculated from the date of filing of the Euro-PCT application as accorded by the receiving Office. They may not be paid more than three months before they fall due.

**Art. 11(3) PCT**

**Art. 86(1), (2) EPC**

**R. 51(1) EPC, R. 51(2) EPC, R. 159(1)(g) EPC**

**Art. 2.4, 2.5 RFees**

**GL/EPO A-X, 5.2.4**

**OJ 1993, 229, point II-3**

#### **594**

The renewal fee for the third year can always be validly paid until the due date under **Rule 51(1) EPC**. If, however, the renewal fee for the third year fell due within the 31-month time limit for entry into the European phase, the due date is deferred and the fee may be paid without surcharge up to expiry of the 31-month time limit. In that case the grace period of six months within which the renewal fee can still be validly paid, subject to payment of a 50% additional fee, is computed from the date of expiry of the 31-month time limit.

**Non-observance of the time limit for payment of the renewal fee**

### ***GA E XI 2 Non-observance of the time limit for payment of the renewal fee***

#### **595**

If the renewal fee is not paid within the 6-month grace period the application is deemed to be withdrawn and the applicant is informed of this in a communication under **Rule 112(1) EPC**. The applicant may within one year from expiry of the grace period request re-establishment of rights provided the request is filed within two months from the removal of the cause of non-compliance with the time limit.

**Art. 122 EPC**

**R. 136 EPC**

**Art. 2.13 RFees**

### ***GA E XI 3 Claims fees***

#### **596**

If the application documents on which the European grant procedure is to be based contain more than fifteen claims, a claims fee is payable within the 31-month period in respect of the sixteenth and each subsequent claim, and a higher claims fee is payable in respect of the 51st and each subsequent claim.

**R. 162 EPC**

**OJ 2009, 119 (3.1)**

**Art. 2.15 RFees GL/EPO A-III, 9; E-VIII, 2.1.3 and 2.3.8**

#### **597**

The claims fees must be calculated on the basis of the number of claims contained in the application in the version that is, in accordance with the indications in Form 1200, to be taken as the basis for processing in the European phase (see **point 500**). However, where the number of claims changes as a

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**GA E XI 4 Non-observance of the time limit for payment of the claims fee**

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consequence of a later (further) amendment filed before expiry of the time limit set in the **Rule 161 EPC/Rule 162 EPC** communication, that number is to be used as the basis for calculating the amount of the claims fees to be paid. The **Rule 161 EPC/Rule 162 EPC** communication sets a six-month time limit for payment of any claims fees not yet paid (see **point 501**).

**598**

If the applicant has already paid claims fees within the 31-month period, any claims fees paid in excess of those due taking into account any amendment made thereafter, will be refunded after expiry of the six-month time limit set in the **Rule 161 EPC/Rule 162 EPC** communication (see **point 503**).

**R. 162(3) EPC**

**Non-observance of the time limit for payment of the claims fee**

***GA E XI 4 Non-observance of the time limit for payment of the claims fee***

**599**

Where the applicant fails to pay (the correct amount of) the claims fees within the 31-month period, the EPO will invite him by means of the **Rule 161 EPC/Rule 162 EPC** communication to pay the missing amount within a non-extendable period of six months (see **point 502**).

**R. 162(2) EPC**

**GL/EPO E-VIII, 2.1.3**

**600**

If additional claims fees become due as a result of amendments filed during the six-month period, the applicant must pay these further claims fees during that same period, since no further invitation under **Rule 162 EPC** will be issued (see **point 500**).

**601**

Where a claims fee is not paid within the six-month period, the claim concerned is deemed to be abandoned. Features of a claim deemed to have been abandoned and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and in particular, into the claims.

**R. 162(4) EPC**

***GA E XII XII.***

Filing of other documents

**Missing data regarding the inventor or an applicant**

**Certificate of exhibition**

***GA E XII 1 Missing data regarding the inventor or an applicant***

**602**

If within the 31-month time limit the inventor has not been designated or certain information regarding the inventor or any applicant is missing, the EPO will invite the applicant to file the designation of the inventor or to submit the missing data within two months from the notification of a communication under **Rule 163(1) or (4) EPC**.

**Art. 4(1)(v) PCT, Art. 22(1) PCT, Art. 27(2) PCT, Art. 39(1)(b) PCT**

**R. 51bis.1(a)(i) PCT**

**PCT Newsletter 5/2010, 3**

**Art. 81 EPC**

**R. 19 EPC and R. 163(1) EPC, R. 163(4) EPC**

**GL/EPO E-VIII, 2.3.1, 2.3.4**

**Non-observance of the requirement to file any missing data regarding the inventor or an applicant**



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GA E XII 2 Non-observance of the requirement to file any missing data regarding the inventor or an applicant

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***GA E XII 2 Non-observance of the requirement to file any missing data regarding the inventor or an applicant***

**603**

If within the two-month time limit set in the invitation the missing data have not been filed, the application is refused.

**Art. 90(5) EPC**

**R. 163(6) EPC**

**604**

The refusal may be remedied by a request for further processing. The request will be granted if within two months from notification of the decision the missing data are filed and the fee for further processing is paid.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

***GA E XII 3 Certificate of exhibition***

**605**

Where relevant, the certificate of exhibition is to be filed within the 31-month time limit. If the document is not filed in due time, the applicant's disclosure at the relevant exhibition will be taken into account for the purposes of establishing whether the invention claimed is new under **Article 54 EPC**.

**Art. 54, 55(2) EPC**

**R. 25 EPC, R. 159(1)(h) EPC**

**606**

If the certificate is not filed in due time, the applicant is informed of this in a communication under **Rule 112(1) EPC**. The omission may be remedied by a request for further processing. The request will be granted if within two months from notification of the communication the certificate is furnished and the fee for further processing is paid.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

***GA E XIII XIII.***

Priority claim

**607**

An international application may claim the priority of an earlier application. As a rule the priority document, i.e. a certified copy of the application from which priority is claimed, will be available to the EPO (see **point 138**). However, if this is not the case, the applicant is given an opportunity to file that document upon entry into the European phase (see **points 615 ff**).

**R. 76.4 PCT, R. 17.1(c) PCT**

**Art. 88(1) EPC**

**R. 163(2) EPC, R. 163(6) EPC, R. 52(1) EPC, R. 53 EPC**

**GL/EPO A-III, 6; E-VIII, 2.3.5**

**608**

The EPO also recognises a priority claim from an application filed in or for any member of the World Trade Organization (WTO) that is not party to the Paris Convention for the Protection of Industrial Property (see **points 128 ff**).

**R. 4.10(a) PCT**

**OJ 2007, 692**

**609**



GA E XIII 1 Obligation to furnish the priority document

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A request for restoration of the right of priority may be filed with the EPO as designated/elected Office (see **points 624 ff**).

**R. 49ter.1 PCT and R. 49ter.2 PCT**

OJ 2007, 692

**Obligation to furnish the priority document**

**Filing a translation of the priority document or the declaration**

**Restoration of priority under Rule 49ter PCT**

***GA E XIII 1 Obligation to furnish the priority document***

**610**

Where the priority of an earlier application is claimed for a Euro-PCT application, the IB sends a copy of the priority document to the EPO if the IB received the priority document from the receiving Office or directly from the applicant or was able to retrieve it from a digital library. As a rule the applicant should file a copy with the receiving Office or the IB or request the receiving Office or the IB that the copy be retrieved from a digital library within 16 months from the (earliest) priority date (see **point 138**).

**R. 17.2 PCT**

GL/EPO E-VIII, 2.3.5

**611**

If during the international phase the applicant did not furnish the priority document or, where no such document must be furnished, the number of the application from which priority is claimed, he may provide the priority document or that number upon entry into the European phase.

**612**

A priority document may be filed in electronic form with the EPO only if it is digitally signed by the issuing authority and the signature is accepted by the EPO. A priority document cannot be filed by fax.

OJ 2007 Spec.Ed. 3, A.3; 2009, 182, 187

**613**

The **application number of a priority application** must always be available to the EPO as designated/elected Office. This number is, if known at the time of filing the application, to be provided in Box VI of the PCT request form.

**R. 163(2), 53(2) EPC**

**614**

In the cases listed below, the EPO as designated/elected Office will include a **copy of the priority application** free of charge in the file of a Euro-PCT application even without having received a copy from the IB. The applicant will be informed of this inclusion unless the previous application is a European application or an international application filed with the EPO as receiving Office. This service is provided on condition that the applicant has informed the EPO of the application number and only if the priority application is:

OJ 2009, 236

GL/EPO A-III, 6.7

- a European patent application;
- an international application filed with the EPO as receiving Office;
- a Japanese patent or utility model application;
- a Korean patent or utility model application;
- a United States provisional or non-provisional patent application.

**Non-observance of the requirement to file a copy or the application number**

***GA E XIII 2 Non-observance of the requirement to file a copy or the application number***

**615**

Where the certified copy of the priority document or, where no copy must be filed (see **point 614**), the application number has not yet been submitted on entry into the European phase, the applicant will be invited to furnish that copy or number within two months from the date of a notification under **Rule 163(2) EPC**. This time limit cannot be extended. If the priority document or the application number is not submitted within that time limit, the priority right is lost.

**R. 163(2) EPC, R. 163(6) EPC**

**616**

The loss of rights may be remedied by requesting further processing. The request will be granted if within two months from notification of the loss of rights the (certified) copy of the priority document or the application number is filed and the fee for further processing paid.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

**617**

If a priority document is missing but the applicant has fulfilled the requirement under **Rule 17 PCT** in due time, no loss of rights will occur. In such case substantive examination may nevertheless begin, but the decision to grant will not be taken unless the priority document is furnished.

**R. 17.1 PCT**

**GL/EPO E-VIII, 2.3.5;**

**F-VI, 2.1**

***GA E XIII 3 Filing a translation of the priority document or the declaration***

**618**

Where the priority document is not in English, French or German, and the validity of the priority claim is relevant for determining whether the invention concerned is patentable, a translation in one of these languages must be submitted at the invitation of the EPO. If a translation is already available to the EPO, it will not issue an invitation.

**R. 51bis.1(e) PCT**

**R. 53(3) EPC**

**OJ 2007, 692**

**OJ 1999, 296**

**GL/EPO A-III, 6.8; F-VI, 3.4**

**619**

The translation need not necessarily be in the language of the proceedings as long as it is in English, French or German (see **point 418**).

**620**

Where the Euro-PCT application is a complete translation of the previous application, a declaration to that effect is sufficient and no invitation to file a translation will be issued (Form 1200, Section 7, Box No. 3). This means that if the priority application is, for instance, a national application filed in Spanish, the applicant may declare that his Euro-PCT application filed in, for instance, English is a complete translation of the Spanish priority application. A translation from Spanish into an official language of the EPO is in that case not required.

**621**

A translation of the priority document may also be requested where the application was filed (in part) on the basis of incorporation by reference.

**R. 51bis.1(e)(ii) PCT**

**Non-observance of the requirement to file the translation or declaration**

***GA E XIII 4 Non-observance of the requirement to file the translation or declaration***

**622**

If the required translation or declaration is not filed in due time, the intermediate document(s) which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability will be considered as belonging to the prior art under **Article 54(2) or (3) EPC**, as applicable.

**623**

If the applicant fails to observe the time limit, he may request further processing. The request will be granted if within two months from notification of the loss of rights the required translation or declaration is filed and the fee for further processing paid.

**Art. 121 EPC**

**R. 135 EPC**

**Art. 2.12 RFees**

**GL/EPO A-III, 6.8**

***GA E XIII 5 Restoration of priority under Rule 49ter PCT***

**624**

If the international application was filed more than 12 months from the filing date of the earlier application whose priority is claimed, the applicant may file a request for restoration of priority with the EPO as receiving Office and as designated/elected Office. For information on the procedure before the EPO as receiving Office see **point 131**.

**R. 49ter.1 PCT and R. 49ter.2 PCT**

**Art. 122 EPC**

**OJ 2007, 692**

**625**

The EPO in its function both as receiving Office and as designated/ elected Office will grant such a request only if the failure to claim the right of priority within the priority period occurred *in spite of due care required by the circumstances having been taken*. The requirement of due care is applied by the EPO in accordance with its standing practice under **Article 122 EPC**. The second criterion referred to in the PCT, whether the failure was *unintentional*, does not play a role in the procedures before the EPO (see **point 629**).

**626**

As set out hereafter (see **point 628**), if the applicant has already filed a request for restoration of priority with the receiving Office, a (new) request need not always be filed upon entry into the European phase.

**627**

The EPO will grant a request for restoration of priority right only if the following requirements are met:

- the filing date is within two months from the date on which the priority period expired;
- the failure to claim the right of priority within the priority period occurred *in spite of due care required by the circumstances having been taken*;
- a request for restoration of priority is filed within one month from the date on which the 31-month time limit for entry into the European phase expired;
- the fee for restoration of priority levied by the EPO is duly paid within the same time limit;
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the request for restoration of priority is accompanied by a statement of reasons for the failure and is preferably accompanied by any declaration or other evidence in support of the statement of reasons.

**628**

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.

**629**

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".

**630**

If the applicant wants the priority claim to be valid in the procedure before the EPO as designated/elected Office, a request for restoration must always be filed if, in the procedure before the receiving Office:

- no request for restoration of priority right was filed;
- the request for restoration of priority right filed with the receiving Office was rejected;
- a request for restoration of priority right filed with the receiving Office was granted only under the "unintentional criterion".

## **GA E XIV XIV.**

Review by the EPO as designated Office of Euro-PCT applications which fail in the international phase

**631**

At the request of the applicant, the EPO may review whether a refusal by the receiving Office to accord a filing date, or a declaration on the part of the receiving Office that a Euro-PCT application or the designation of a state is considered withdrawn, or a finding by the IB under **Article 12(3) PCT** is the result of an error or omission on the part of the authority concerned, in which case the Euro-PCT application can proceed as a European application.

**Art. 25 PCT**

**R. 51 PCT, R. 82bis PCT**

**R. 159(2) EPC**

**GL/EPO E-VIII, 2.9**

To obtain such a review by the EPO as designated/elected Office, applicants must take the following steps:

- The request to the IB under **Article 25(1) PCT** to send copies of documents in the files promptly to the EPO as designated Office must be made within the two-month time limit under **Rule 51.1 PCT**.

- The filing fee under **Rule 159(1)(c) EPC** must be paid and, where required, a translation of the Euro-PCT application furnished within the same two-month time limit (**Rule 51.3 PCT**). Applicants are recommended to undertake the remaining steps for entry into the European phase under **Rule 159(1) EPC** at the same time (see **points 447 ff, points 505 ff**).

**632**

Pursuant to **Article 24(2) PCT** the EPO as designated/elected Office may even maintain the application as a European application if this is not required by virtue of the provision in **Article 25(2) PCT**. The filing of a request under **Article 24(2) PCT** is governed by the same requirements as a request for review under **Article 25(2) PCT**. Such request may be combined with a request for re-establishment of rights or further processing.

**Art. 24(2) PCT, Art. 48(2) PCT**

**R. 82bis PCT**

**Art. 122, 121 EPC**

OJ 1984, 565 (Reasons, point 4)

**633**

If the applicant proves to the satisfaction of the EPO that the international filing date is incorrect owing to an error made by the receiving Office or that the priority claim has been erroneously considered by the receiving Office or the International Bureau not to have been made, and if the error is an error such that, had it been made by the EPO itself, the EPO would rectify it under EPC law or practice, the EPO must rectify the error and treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made.

**R. 82ter PCT**

**GA E XV XV.**

Lack of unity

**634**

Where the Euro-PCT application does not meet the requirement of unity of invention, the procedure laid down in **Rule 164 EPC** applies upon entry into the European phase.

**R. 164 EPC**

GL/EPO E-VIII, 2.4.1

**635**

In respect of a **further invention** contained in the Euro-PCT application which was not searched by the EPO in the international phase, a search will be performed only if a divisional application is filed. This means that the opportunity to have multiple inventions searched within the framework of a single Euro-PCT application is limited to the international phase of the application.

**636**

The EPO will not examine a Euro-PCT application if it has not itself performed a search in respect of the invention for which protection is sought. It follows that the examination of a Euro-PCT application in the European phase is conditional on the availability of the results of:

- either an international search carried out by the EPO as ISA/SISA in respect of the invention for which examination is requested;
- or a supplementary European search carried out by the EPO as designated/elected Office in respect of the invention for which examination is requested.

**No supplementary search performed: EPO was ISA**

**Supplementary search performed: EPO was not ISA**

**GA E XV 1 No supplementary search performed: EPO was ISA**

**637**

Upon entry into the European phase the applicant must choose one invention from those searched during the international phase by the EPO as ISA/SISA to form the basis of the examination. If this requirement is not met, the applicant will be invited by the examining division to indicate which invention he wishes to pursue.

**GA E XV 2 Supplementary search performed: EPO was not ISA**

**638**

If after entry into the European phase a supplementary European search is to be performed (EPO was not ISA/SISA), it will be carried out only on the **invention or group of inventions first mentioned in**

**the claims** (as possibly amended upon entry into the European phase), regardless of whether an ISR was drawn up in respect of that invention in the international phase and regardless of any earlier findings as to unity of invention in the international phase.

**639**

Although the EPO is in no way bound by the opinion of the ISA on the question whether the application meets the requirement of unity, the EPO will, given the fact that the practices of the ISAs are based on the same Guidelines (Chapter 10 of the ISPE Guidelines), in many cases share that opinion. Therefore, where the ISA/SISA considered the requirement of unity not to be met, the applicant is advised to amend the application in due time in such a way that the invention on which the applicant wishes the supplementary search and the examination to be based, is that first mentioned in the claims.

**640**

If a supplementary European search report is to be drawn up, the invention that was the subject of the supplementary European search is the only invention that can be examined (see **points 635-636**). If the applicant wishes a different invention to be examined he will have to file a divisional application.

## **GA E XVI XVI.**

Publication of the Euro-PCT application by the EPO

**641**

In principle, the international publication of an international application takes the place of the publication of a European patent application.

**Art. 11(3) PCT, Art. 29(1) PCT, Art. 29(2) PCT**

**Art. 67 EPC, Art. 153(3) EPC, Art. 153(4) EPC**

**GL/EPO E-VIII, 2.5.1**

**642**

In accordance with this principle, a Euro-PCT application published by the IB in an **official language of the EPO** enjoys, subject to the provisions of **Article 67(3) EPC**, provisional protection **as from the date of the international publication**. The EPO will, once the application has entered the European phase, notify the applicant of the publication of the bibliographic data of the Euro-PCT application in the European Patent Bulletin and confirm that the application, subject to the provisions of **Article 67(3) EPC**, enjoys provisional protection in the individual EPC contracting states.

**643**

If the Euro-PCT application was published by the IB in a **language other than one of the three official languages** of the EPO, the EPO will publish the translation of the Euro-PCT application submitted by the applicant upon entry into the European phase (see **point 505**). In that case the provisional protection is, subject to **Article 67(3) EPC**, only effective **as from the date of publication of the translation** by the EPO.

## **GA E XVII XVII.**

State of the art

**644**

Upon payment of the filing fee and, where required, receipt of the translation an international application is considered as comprised in the state of the art under **Article 54(3) EPC** (see **points 510 and 540**).

**Art. 54(3) EPC, Art. 153(3) EPC, Art. 153(4) EPC**

**R. 165 EPC**

**GL/EPO G-IV, 5.2**

## **GA E XVIII XVIII.**

Divisional applications

**645**

If the Euro-PCT application has entered the European phase, one or more European divisional applications may be filed in respect of subject-matter contained in a Euro-PCT application. The divisional application must be filed in the language of the proceedings of the earlier application.

**Art. 76 EPC**

**R. 36(2) EPC**

**GL/EPO A-IV, 1; E-VIII, 2.4.1**

**J 18/09**, OJ 2011, 480

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a European patent  
Guide for applicants  
Part 2  
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"Euro-PCT Guide"  
**6th edition**  
**Updated until 1 April 2012**

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## **PCT Appl. Guide - Int. Phase - 5. Filing an International Application**

### ***PCT AG-IP 5.001 What is an international application?***

**PCT AG-IP 5.001 What is an international application?** An application is “international” when it is filed under and with reference to the PCT. It is the first step towards obtaining a patent in or for a State party to the PCT: “in” such a State when a national patent is desired; “for” such a State when a regional patent (ARIPO, Eurasian, **European** or **OAPI patent**) is desired. [Article 2(vii) 3(1)]

### ***PCT AG-IP 5.002 What may be the subject of an international application?***

**PCT AG-IP 5.002 What may be the subject of an international application?** An international application must be an application for the protection of an invention. The PCT encompasses the filing of applications for patents for inventions, inventors’ certificates, utility certificates, utility models, and various kinds of patents and certificates of addition (see **Article 2(i)**). An international application thus cannot validly be filed for certain other forms of industrial property rights which fall outside the scope of “inventions,” such as, for example, purely ornamental designs. [Article 2(i) and (ii) 3(1)]

### ***PCT AG-IP 5.003 What are the main effects of an international application?***

**PCT AG-IP 5.003 What are the main effects of an international application?** Any international application has two main effects. One of those effects, generally speaking, is the same as that of a national (or regional) application. It occurs on the date accorded as the international filing date (see **paragraph 6.005**). It is produced in or for the “designated States,” that is, the States in which or for which the applicant wishes to obtain a patent by filing an international application. For the prior art effect of international applications in the United States of America, see **National Chapter (US)**. [Article 4(1)(ii) 11(3) 64(4) Rule 4.9]

5.004. Designated States in respect of which international preliminary examination has been demanded by the applicant are called “elected States” in the terminology of the PCT. [Article 31(1) 31(4)(a)]

5.005. Subject to what is said in the following paragraph, the other main effect of an international application is that, normally, no designated Office may process or examine the international application prior to the expiration of 30 months from the priority date (for the definition of “priority date”, see **paragraph 5.057**) and that any fees due to a designated Office and any translation of the international application to be furnished to a designated Office will have to be paid and furnished, respectively, only by the expiration of that 30-month period. In respect of certain designated Offices (currently three), the applicable time limit is the former 20-month time limit, not the new 30-month time limit because, due to the incompatibility, for the time being, of the modified PCT provision (**PCT Article 22(1)**) with the relevant national law, those Offices made a declaration of incompatibility which will remain in effect until it is withdrawn by the respective Offices. Furthermore, certain designated Offices have fixed time limits expiring even later than 30 months, or 20 months, as the case may be (for more detailed information, see **paragraph 4.016** and the **National Chapters** (Summaries)). This effect of the international application is normally referred to as the effect of “delaying” the patent examination and granting procedure before the national (or regional) Offices. [Article 22(1) 23(1)]

5.006. If international preliminary examination has been demanded before the expiration of 19 months from the priority date, the delaying effect in respect of any State whose designated Office has

notified the International Bureau that the 30-month time limit under **Article 22(1)**, as in force from April 1, 2002, is incompatible with the national law applied by that Office, is 10 months longer, so that any fees due to an elected Office and any translation of the international application will have to be paid and furnished, respectively, only by the expiration of 30 months from the priority date. (For more detailed information see the **National Phase** and **National Chapters**. Later time limits apply in some Offices.) [**Article 39(1) 40(1)**]

5.007. An international application which has been accorded an international filing date is the equivalent of a "regular national filing" within the meaning of the **Paris Convention for the Protection of Industrial Property** and, consequently, may be invoked as the basis of a priority claim in a national, regional or other international application filed subsequently within the time limit and subject to the conditions provided for in that Convention. [**Article 8 11(4)**]

### ***PCT AG-IP 5.008 Where should an international application be filed?***

**PCT AG-IP 5.008 Where should an international application be filed?** Annexes B indicate, for each Contracting State, the authorities with which its nationals and residents may, as applicants, file international applications. In the terminology of the PCT, these authorities are called "receiving Offices" (because they receive international applications). They are listed with their full names and addresses, their telephone, facsimile and/or teleprinter numbers and, where available, their e-mail and/or Internet addresses, in **Annexes B**, and the requirements of each receiving Office are listed in **Annex C**. Where there are several applicants who are not all nationals and/or residents of the same Contracting State, any receiving Office of or acting for a Contracting State of which at least one of the applicants is a resident or national is competent to receive an international application filed by those applicants. Alternatively, at the applicant's option, the international application may be filed with the International Bureau as receiving Office, regardless of the Contracting State of which the applicant is a resident or national. If there are two or more applicants, the international application may be filed with the International Bureau as receiving Office if at least one of the applicants is a resident or national of a Contracting State. Residents or nationals of States which are party to the PCT and also to the **ARIPO Harare Protocol**, to the **Eurasian Patent Convention**, to the **European Patent Convention**, or to the **OAPI Agreement** generally also have the option of filing an international application with the **ARIPO Office**, the **Eurasian Patent Office**, the **European Patent Office**, or the **OAPI Office**, respectively. Compliance with any national security prescriptions applicable under national law is the applicant's responsibility. As to measures which may be applied by receiving Offices in connection with such prescriptions, see **paragraph 6.010**. [**Article 10 Rule 19.1(a) 19.2**]

5.009. Applicants may have a choice between several receiving Offices, for example, where there are two or more applicants whose States of nationality and residence include more than one Contracting State, or where a sole applicant has nationality and/or residence in more than one Contracting State. [**Article 31(2)(a) Rule 18.1 54**]

### ***PCT AG-IP 5.010 What are the elements of an international application?***

**PCT AG-IP 5.010 What are the elements of an international application?** Any international application must contain the following elements: request, description, claim or claims, one or more drawings (where drawings are necessary for the understanding of the invention), and abstract. Detailed information on each is given below. [**Article 3(2) 7**]

### ***PCT AG-IP 5.011 What is the order of the elements of the international application?***

**PCT AG-IP 5.011 What is the order of the elements of the international application?** The elements of the international application must be arranged in the following order: request, description,

claim(s), abstract, drawing(s) (if any). For applications containing sequence listings, see **paragraph 11.088**. [Section 207(a)]

***PCT AG-IP 5.012 How must the sheets of an international application be numbered?***

**PCT AG-IP 5.012 How must the sheets of an international application be numbered?** All the sheets constituting the international application must be numbered in consecutive Arabic numerals with three or, where the international application contains a sequence listing, four separate series of numbers: the first applying to the request, the second applying to the part consisting of the description, the claim(s) and the abstract (see **paragraph 5.106**), the third applying to the drawings (see **paragraph 5.140**), and the last applying to the sequence listing part, if any, of the description (see **paragraph 5.099**). [Rule 11.7(a) Section 207(b)]

***PCT AG-IP 5.013 What language must be used for an international application?***

**PCT AG-IP 5.013 What language must be used for an international application?** The language in which an international application must be filed depends on the receiving Office. Some receiving Offices allow the applicant to choose between two or more languages. The language or languages which may be used for filing an international application with a given receiving Office are indicated in **Annex C**. If the international application is filed in a language other than Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish (that is, the languages in which international applications may be published - see **paragraphs 9.017 to 9.020**), or if the language in which the international application is filed is not accepted by the International Searching Authority which is to carry out the international search (see **paragraph 7.002** and **Annex D**), a translation of the international application will need to be furnished for the purposes of international search and/or international publication. A translation may also be required for the purposes of the supplementary international search if neither the language in which the international application is filed or published nor that in which the translation is furnished for the purposes of the main international search is accepted by the Authority which is to carry out the supplementary international search (see **Annex SISA**). Furthermore, a translation may also be required for the purposes of the international preliminary examination if the language in which the international application is filed or published is not accepted by the International Preliminary Examining Authority which is to carry out the international preliminary examination (see **Annex E**). The requirements in relation to languages and the furnishing of translations are explained in greater detail in **paragraphs 6.013 to 6.020, 8.012, 9.017 to 9.019** and **10.011**. Those requirements operate, in most cases, in such a way that only one translation would need to be furnished for the purposes of the international phase of processing. All elements of the international application must normally be in the same language. However, the request must be in a language which is both a language accepted by the receiving Office (see **Annex C**) and a language of publication, and the text matter of the drawings (if any) and the abstract may be in the language in which the international application is to be published (see **paragraphs 6.018** and **6.019**). [Article 3(4)(i) Rule 12.1 48.3(b)]

5.014. For the case where an international application is not filed in a language accepted by the receiving Office with which it is filed, see **paragraph 6.034**. [Rule 19.4(a)(ii)]

[ ]

***PCT AG-IP 5.015 What is the form of the request?***

**PCT AG-IP 5.015 What is the form of the request?** The request must: (a) be made on a printed form (**Form PCT/RO/101**) to be filled in with the required indications; or (b) be presented as a



computer print-out complying with the **Administrative Instructions**; or (c) be presented in the format of the print-out of the computer generated request prepared using the PCT-SAFE software<sup>1</sup>. A filled-in sample and a blank copy of the Form **PCT/RO/101** are available from the Internet website address indicated below. Any prospective applicant may also obtain copies of the printed request Form **PCT/RO/101**, free of charge, from the receiving Office with which he plans to file his international application or from the International Bureau. To facilitate preparation of the request, the International Bureau has prepared downloadable PDF (portable document format) versions on its website. These may be downloaded from **www.wipo.int/pct/en/forms/** and completed using a computer or printed out and filled in using a typewriter. The request, and instructions on how to complete the editable version, is also available from that site. Any prospective applicant may obtain the PCT-SAFE software free of charge from the International Bureau or download it directly from the PCT-SAFE website at: **www.wipo.int/pct-safe/en/**, which also provides guidance on using this software. [**Rule 3.1 3.2 3.4 4 89ter Section 102**]

5.016. The **request** contains a petition for the international application to be processed according to the PCT and must also contain certain indications. It must contain the title of the invention. It must identify the applicant, (normally) the inventor, and the agent (if any). The filing of a request constitutes the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and for the grant of both regional and national patents. The request should also contain, where applicable, a priority claim, an indication of the applicant's choice of competent International Searching Authority and a reference to any relevant earlier international, international-type or other search. The request must be signed. Details for the filling in of the **request form** are given below in respect of each Box of that form. As to the language of the request, see **paragraph 5.013**. [**Article 4(1) 43 44 45 Rule 3 4.1 4.9(a) 4.10 4.11 4.14bis 4.15**]

5.017. It is recommended that the applicant indicate his file reference, if any, not exceeding 12 characters in length, in the box provided for this purpose on the first sheet of the **request form**. The receiving Office, International Bureau, International Searching Authority and International Preliminary Examining Authority will use the file reference in correspondence with the applicant (see also **paragraphs 5.105, 5.129, 10.015 and 11.071** as to the indication of file references on other elements of, or papers relating to, the international application). [**Section 109**]

### ***PCT AG-IP 5.018 Physical Requirements.***

**PCT AG-IP 5.018 Physical Requirements.** Any text matter in the request must be in characters the capital letters of which are not less than 0.21 cm high. [**Rule 11.9(d)**]

[ ]

### ***PCT AG-IP 5.019 What are the requirements with respect to the title of the invention?***

**PCT AG-IP 5.019 What are the requirements with respect to the title of the invention?** The title of the invention must be short (preferably two to seven words, when in English or translated into English) and precise. The same title must be given by the applicant in Box No. I of the request and at the beginning of the description (see **paragraph 5.094**). [**Rule 4.3 5.1(a)**]

[ ]

### ***PCT AG-IP 5.020 Who may file an international application?***

**PCT AG-IP 5.020 Who may file an international application?** Any resident or national of a Contracting State may file an international application. Where there are two or more applicants, at least one of them must be a national or a resident of a Contracting State. The Contracting States are listed in **Annex A**. As to questions of residence and nationality, see **paragraph 5.023**. [**Article 9(1) 9(3) Rule 18.1 18.3**]

5.021. The national law of any designated State may require that, for the purposes of the designation of that State, the applicant(s) must be the inventor(s). There is presently one such State, namely the United States of America. Where the inventor is deceased, see **paragraphs 11.023 to 11.026**. [**Article 27(3) Rule 18.4(c)**]

5.022. In any international application, different applicants may be indicated for the various designated States. This possibility is of great practical importance where the United States of America is designated. As indicated in **paragraph 5.021**, the applicant for the purposes of the designation of the United States of America must be the inventor. No such requirement exists for other States. Note, however, that where more than one type of protection is available for a Contracting State (see **paragraph 5.055 and Annex B**), different applicants may not be indicated for different types of protection, furthermore for the national and regional designation of a State, the same applicant or applicants must be indicated. [**Article 9(3) Rule 18.4(c) Section 203(b)**]

### ***PCT AG-IP 5.023 How are questions of residence and nationality determined?***

**PCT AG-IP 5.023 How are questions of residence and nationality determined?** The question whether an applicant is a resident or national of a Contracting State depends on the national law of that State and is decided by the receiving Office. In any case, however, possession of a real and effective industrial or commercial establishment in a Contracting State is considered residence in that State, and a legal entity constituted according to the national law of a Contracting State is considered a national of that State. Where a question of the applicant's residence or nationality arises in connection with an international application filed with the International Bureau as receiving Office, the International Bureau will request the national Office of, or acting for, the Contracting State concerned to decide the question and will inform the applicant of such request. The applicant has the opportunity to submit arguments relating to the issue of residence or nationality directly to that national Office, which will decide the question promptly. [**Rule 18.1**]

### ***PCT AG-IP 5.024 How must the applicant be identified?***

**PCT AG-IP 5.024 How must the applicant be identified?** The applicant must be identified by the indication of his name and address and by marking next to that indication, the check-box "This person is also inventor" in Box No. II, or "applicant and inventor" in Box No. III, where the applicant is also the inventor or one of the inventors, or the check-box "applicant only" where the applicant is not also the inventor or one of the inventors. Where the applicant is a corporation or other legal entity (that is, not a natural person), the check-box "applicant only" must be marked. Where the applicant is registered with the receiving Office, the number or other indication under which the applicant is so registered may also be indicated in Boxes No. II or III. The applicant's nationality and residence must also be indicated (see **paragraph 5.031**). For the identification of the inventor, see **paragraph 5.035**. For later changes in the person, name and address of the applicant, see **paragraphs 11.018 to 11.022**. [**Rule 4.5**]

### ***PCT AG-IP 5.025 How must names be indicated in the request?***

**PCT AG-IP 5.025 How must names be indicated in the request?** The names of natural persons must be indicated by the family name followed by the given name(s). Academic degrees or titles or other indications which are not part of the person's name must be omitted. The family name should

preferably be written in capital letters (see filled-in sample of the **request form** at the address indicated in **paragraph 5.015**). [**Rule 4.4(a) 4.19(a)**]

5.026. The name of a legal entity must be indicated by its full official designation (preferably in capital letters). [**Rule 4.4(b)**]

***PCT AG-IP 5.027 How must addresses be indicated in the request?***

**PCT AG-IP 5.027 How must addresses be indicated in the request?** Addresses must be indicated in such a way as to satisfy the requirements for prompt postal delivery at the address indicated and must consist of all the relevant administrative units up to and including the house number (if any). The address must also include the country. [**Rule 4.4(c)**]

***PCT AG-IP 5.028 When is the indication of a telephone number, a facsimile number or an e-mail address recommended?***

**PCT AG-IP 5.028 When is the indication of a telephone number, a facsimile number or an e-mail address recommended?** It is recommended that the telephone number, facsimile number and e-mail address of the applicant, named first in the request, be given, if no agent or common representative is indicated in Box No. IV (see **paragraphs 5.041 to 5.051**). Any e-mail address supplied will be used only for the types of communication which might be made by telephone, unless the applicant has authorized either the sending of advance copies of notifications by e-mail followed by paper notifications or the sending of notifications exclusively by e-mail to the indicated e-mail address (see below). [**Rule 4.4(c)**]

5.029. If the applicant has authorized either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail, by marking the corresponding check-box in Box No. II of the **request form**, the receiving Office, the International Searching Authority (also in its capacity as Authority specified for supplementary search), the International Bureau and the International Preliminary Examining Authority may, if they wish to do so, send such notifications in respect of the international application to the applicant, thus avoiding processing or postal delays. Details of which Authorities will send notifications by e-mail are included in **Annex B**. If an e-mail notification is followed by the official notification on paper, only the paper copy of the notification is considered to be the legal copy of the notification and only the date of mailing of the paper copy will commence any time limit within the meaning of **Rule 80**. Where the applicant requests the sending of notifications exclusively by e-mail, the date of mailing indicated on the electronic copy will commence any time limit within the meaning of **Rule 80**. It is the applicant's responsibility to keep any e-mail address details up-to-date and to ensure that incoming e-mails are not blocked, for any reason, on the recipient's side. Changes to the e-mail address indicated in the request should be requested to be recorded, preferably directly at the International Bureau, under **Rule 92bis** (see **paragraphs 11.018 to 11.022**). [ ]

***PCT AG-IP 5.030 May a special address be given for the sending of correspondence?***

**PCT AG-IP 5.030 May a special address be given for the sending of correspondence?** Only one address may be indicated for each applicant in Box No. II or III. However, where no agent, or common representative, is indicated in Box No. IV of the request, a special address for correspondence may be indicated in that Box. Where an applicant is indicated in Box No. IV as common representative, an address for correspondence may be indicated in that Box (see **paragraphs 5.047 and 5.051**) other than the address given for that applicant in Box No. II or III. [**Rule 4.4(d)**]

PCT AG-IP 5.031 Why and how must the nationality and residence of the applicant be indicated in the request?

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***PCT AG-IP 5.031 Why and how must the nationality and residence of the applicant be indicated in the request?***

**PCT AG-IP 5.031 Why and how must the nationality and residence of the applicant be indicated in the request?** This information is needed to determine whether the applicant is entitled to file an international application and also to determine the competence of the receiving Office. It must be provided by an indication of the names of the country of which the applicant is a national and of the country of which he is a resident. Where the country of residence is not indicated specifically but a country is indicated in the address, it will be assumed that the country of residence is the country indicated in the address. For the procedure where an international application is filed with a "non-competent" receiving Office, see **paragraph 6.035**. For the manner of indicating names of countries, see **paragraph 5.033**. [Article 9(1) Rule 18 19]

***PCT AG-IP 5.032 Must the indications in respect of applicants be provided for all applicants?***

**PCT AG-IP 5.032 Must the indications in respect of applicants be provided for all applicants?** If there is more than one applicant, it is advisable that the indications outlined in **paragraphs 5.024 to 5.031** are provided in respect of all applicants. However, if the indication of the address, nationality and residence has been provided in respect of at least one applicant who is entitled to file the international application with the receiving Office, the receiving Office will not invite the applicant to furnish the missing indications in respect of any other applicant. [Rule 26.2bis(b)]

***PCT AG-IP 5.033 How must the names of States be indicated?***

**PCT AG-IP 5.033 How must the names of States be indicated?** The name of any State may be indicated either by the full name of the State or by a short title or two-letter code or any combination thereof. This principle applies for the indication of the names of States in all Boxes of the request where such names must be indicated. **Annex K** contains a comprehensive list of the short names and two-letter codes accepted for use in indicating countries, territories and intergovernmental organizations (and their Offices) in documents relating to international applications under the PCT. The list is as set out in WIPO Standard ST.3, which is published in the *WIPO Handbook on Industrial Property Information and Documentation* and available on the Internet site at [www.wipo.int/standards/en/pdf/03-03-01.pdf](http://www.wipo.int/standards/en/pdf/03-03-01.pdf). [Section 115]

***PCT AG-IP 5.034 Which of several applicants should be named first?***

**PCT AG-IP 5.034 Which of several applicants should be named first?** It is recommended that the applicant who will represent all the applicants and to whom notifications are to be sent be named first, since he will be considered to be the common representative of all the applicants if no common agent or common representative is appointed and if that applicant is entitled to file an international application with the receiving Office (see **paragraph 5.048**). However, if a common agent representing all applicants or a common representative is indicated in Box No. IV of the request, notices will be sent to that common agent or common representative. (See also **paragraphs 11.015 to 11.017**.) [ ]

***PCT AG-IP 5.035 When and how must the inventor be identified?***

**PCT AG-IP 5.035 When and how must the inventor be identified?** Where the person identified in Box No. II as applicant is also the inventor, it is sufficient to mark the check-box "This person is also inventor." No repetition of the name and address of the inventor is required in Box No. III. Where the inventor is identified in Box No. III, the check-box "applicant and inventor" must be marked if the

**PCT AG-IP 5.038 What must be done if the inventors are not the same for all designated States?**

inventor is also applicant; the check-box "inventor only" must be marked if the inventor is not also applicant. For the purposes of the designation of the United States of America, the check-box "applicant and inventor" must always be marked in Box No. III, since that State requires the applicant to be the inventor (see **paragraph 5.021**). Where the inventor is not the same for all designated States, see **paragraph 5.038**. Where the inventor is deceased, see **paragraphs 11.023 to 11.026**. [Article 4(1)(v) 4(4) Rule 4.1(a)(iv) 4.6]

5.036. Where the inventor is not also an applicant, the check-box "inventor only" must be marked and his name and address must be indicated in one of the sub-boxes of Box No. III. The name and address of the inventor may be omitted from the request where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application. **Annexes B** indicate what the requirements are for each Contracting State or intergovernmental organization. However, unless special reasons prevent the indication of the name and address of the inventor, it is recommended that it always be included in the request. Note that all inventors must also be applicants if the designation of the United States of America is to be pursued into the **US national phase**, except in special circumstances because of differing national laws as to inventorship (see **paragraph 5.038**). [Article 4(4) Rule 4.1(c)(i)]

5.037. As regards the indication of the name and address of the inventor, what is said in this respect for the applicant, in **paragraphs 5.025 and 5.027**, also applies. An indication of the country of which the inventor is a national or resident is not required unless the inventor is also applicant. For later changes in the person, name or address of the inventor, see **paragraphs 11.018 and 11.020**. [Rule 4.4]

***PCT AG-IP 5.038 What must be done if the inventors are not the same for all designated States?***

**PCT AG-IP 5.038 What must be done if the inventors are not the same for all designated States?** The PCT permits different inventors to be indicated for different designated States where, in this respect, the requirements of the national laws of the designated States are not the same. For the manner of indicating for which designated States the person named is the inventor, see item 1(iii) of the Supplemental Box of the **request form** (see **filled-in sample of the request form** at the address indicated in **paragraph 5.015**). Where, and this is the usual case, all the inventors are the same for all designated States, no special indication in the Supplemental Box is required. [Rule 4.6(c)]

***PCT AG-IP 5.039 How, in the case of several applicants, are the designated States for which they are applicants to be identified?***

**PCT AG-IP 5.039 How, in the case of several applicants, are the designated States for which they are applicants to be identified?** Details concerning the designation of States in general are given in **paragraphs 5.052 to 5.054** below. At the bottom of Box No. II and of each sub-box of Box No. III, there are four check-boxes (see **filled-in sample of the request form** at the address indicated in **paragraph 5.015**). One (but only one) of those check-boxes must be marked for the applicant identified in Box No. II and for each further applicant, if any. None of these four check-boxes should be marked if the person identified in any of the sub-boxes of Box No. III is "inventor only." The indications to be made in Box No. II and any of the sub-boxes of Box No. III relating to the designated States for which the person is identified as "This person is also inventor," "applicant only," "applicant and inventor" or "inventor only" have to be read in conjunction with the designations made in Box No. V. An explanation of each of the four check-boxes is given below, separately for Box No. II and Box No. III. [ ]

[ ]

" all designated States"

## PCT Appl. Guide - Int. Phase - 5. Filing an International Application

PCT AG-IP 5.039 How, in the case of several applicants, are the designated States for which they are applicants to be identified?

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☐

This check-box must be marked where the person identified in Box No. II is and qualifies as applicant for all designated States. Where that person is a legal entity or an assignee, this check-box should not be marked given that the United States of America is automatically one of the designated States. ☐

" all designated States except the United States of America"

☐

This check-box must normally be marked where the person identified in Box No. II is not "also inventor," since only the inventor can be the applicant for the United States of America (see **paragraphs 5.021 and 5.035**). ☐

" the United States of America only"

☐

This check-box must normally be marked where the person identified in Box No. II is "also inventor" but is not also applicant for the other designated States. Often the inventor is the applicant only for the United States of America and another person (natural person or legal entity) is the applicant for all other designated States. This check-box must not be marked if the person identified in Box No. II is not "also inventor." ☐

" the States indicated in the Supplemental Box"

☐

This check-box must be marked only in special cases not covered by the preceding three check-boxes. Where, for example, each of three applicants is applicant for different States, the indication of the States for which the person identified in Box No. II is applicant must be made in the Supplemental Box of the **request form** (see the explanation given below in relation to the sub-boxes of Box No. III for the other two applicants in such a case). The manner in which the Supplemental Box is to be used is explained in detail in item 1(ii) of the Supplemental Box itself (see **filled-in sample of the request form** at the address indicated in **paragraph 5.015**) ☐

☐

" all designated States"

☐

This check-box must be marked where the person identified in the sub-box as "applicant and inventor" or as "applicant only" is and qualifies as applicant for all designated States. Where that person is a legal entity or an assignee, this check-box should not be marked given that the United States of America is automatically one of the designated States. ☐

" all designated States except the United States of America"

☐

This check-box must normally be marked where the person identified in the sub-box is "applicant only" (which means that the person is not also the inventor), since only the inventor can be the applicant for the United States of America (see **paragraphs 5.021 and 5.035**). ☐

" the United States of America only"

☐

## PCT Appl. Guide - Int. Phase - 5. Filing an International Application

**PCT AG-IP 5.041 Does the applicant have to be represented by an agent before the receiving Office, the International Bureau and other International Authorities under the PCT?**

This check-box must be marked where the person identified in the sub-box is "applicant and inventor" but is not also applicant for the other designated States. Often the inventor is the applicant only for the United States of America and another person (natural person or legal entity) is the applicant for all other designated States. This check-box must not be marked if the person identified in the sub-box is "applicant only" or "inventor only" (that is, where the person identified as "inventor only" is inventor for some countries but not for the United States of America or where the applicant has no intention of pursuing the international application before the designated Office of the United States of America).  
[ ]

" the States indicated in the Supplemental Box"  
[ ]

This check-box must be marked only in special cases not covered by the preceding three check-boxes. Where, for example, each of three applicants is applicant for different States, the indication of the States for which each of the two further applicants identified in a sub-box of Box No. III as "applicant and inventor" or "applicant only" must be made in the Supplemental Box of the **request form** (see the explanation given above in relation to the sub-boxes of Box No. II for the first applicant). The manner in which the Supplemental Box is to be used is explained in detail in item 1(ii) of the Supplemental Box itself (see **filled-in sample of the request form** at the address indicated in **paragraph 5.015**). [ ]

5.040. Where, for the purposes of the designation of the United States of America, an inventor is named but not also indicated as applicant for the purposes of that designation, and unless the inventor is deceased, or if no inventor is indicated, and the designation of the United States of America has not been withdrawn, the receiving Office will notify the applicant that the application may be rejected by the **United States Patent and Trademark Office** as a designated Office because only the inventor is qualified to file a national application in the United States of America (**Article 27(3)**). Any response by an applicant requesting that an inventor be indicated as an applicant for the United States of America will be treated as a request under PCT **Rule 92bis**. Where, however, a legal entity is indicated on the request as an applicant for States including the United States of America and the request also names a person who is an inventor and applicant for the purposes of the United States of America, then the receiving Office will *ex officio* correct the request to indicate the legal entity as an applicant for the purposes of "all designated States except the United States of America." Similarly, any response to the notification referred to above requesting that an inventor be indicated as an applicant for the United States of America will be considered, in the absence of instructions to the contrary, to include a request to change the indication of any legal entity indicated as an applicant for the United States to that of an applicant for "all designated States except the United States of America". [ ]

[ ]

***PCT AG-IP 5.041 Does the applicant have to be represented by an agent before the receiving Office, the International Bureau and other International Authorities under the PCT?***

**PCT AG-IP 5.041 Does the applicant have to be represented by an agent before the receiving Office, the International Bureau and other International Authorities under the PCT?** Annex C indicates, for each receiving Office, whether the applicant has to be represented by an agent. As already stated (see **paragraph 1.004**), 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 a professional patent attorney or patent agent. [**Article 27(7) 49 Rule 2.2 90.1**]

***PCT AG-IP 5.042 Who may be appointed to act as an agent?***

**PCT AG-IP 5.042 Who may be appointed to act as an agent?** Any person who can act as an agent before the Office which acts as receiving Office (see **Annex C**) may be appointed as an agent for any international application filed with that Office. Where the international application is filed with the International Bureau as receiving Office, any person who has the right to practice before the national (or regional) Office of, or acting for, a Contracting State of which the applicant (or, if there are two or more applicants, any of the applicants) is a resident or national may be appointed as agent (see **Annex C**). 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 and the International Preliminary Examining Authority. [**Article 49 Rule 83.1bis Section 106**]

***PCT AG-IP 5.043 How is an agent to be appointed?***

**PCT AG-IP 5.043 How is an agent to be appointed?** Subject to **paragraph 5.044** an agent may be appointed by designation in Box No. IV of the request (see **filled-in sample of the request form** at the address indicated in **paragraph 5.015**) if the international application is signed by the applicant (see also **paragraphs 5.088 and 5.089**). Otherwise the appointment of the agent must be in a separate document (“power of attorney”) signed by the applicant. The indication in Box No. IV of the request or in the power of attorney must contain the name and address of the agent in the manner indicated in **paragraphs 5.025 to 5.028**. It is recommended that the agent’s telephone number, facsimile number and/or e-mail address also be indicated. Where the agent is registered with the receiving Office, the number or other indication under which the agent is so registered may also be indicated. Where there are several applicants, an agent representing all of them may be appointed by designation in the request or by a separate power of attorney or by a combination of both methods, provided that all the applicants have signed either the request or a separate power of attorney. Model powers of attorney are available in editable PDF format on the WIPO website at: [www.wipo.int/pct/en/forms/pa/index.htm](http://www.wipo.int/pct/en/forms/pa/index.htm). The separate power of attorney must be submitted to the receiving Office or to the International Bureau or, if the appointment was made specifically for the purposes of the procedure before the International Searching Authority or International Preliminary Examining Authority, to the Authority concerned (see **paragraph 5.045**). Where a general power of attorney authorizes an agent to represent the applicant before the Office which acts as receiving Office, and where that general power includes the filing of international applications, a copy of the general power of attorney originally submitted to the receiving Office must accompany any international application in relation to which the appointment made in it is to be exercised unless this requirement has been waived by the receiving Office concerned (see **paragraph 5.044**), and reference must be made to that copy in Box No. IX of the request. It is to be noted that general powers of attorney must be deposited with the receiving Office (not with the International Bureau, except where the international application is filed with the International Bureau as receiving Office) or, if the appointment was made specifically for the purposes of the procedure before the International Searching Authority or International Preliminary Examining Authority, with the Authority concerned (see **paragraph 5.045**). [**Article 4(1)(iii) Rule 4.1(a)(iii) 4.7 90.3**]

5.044. Any receiving Office, International Searching Authority, International Preliminary Examining Authority or the International Bureau may waive the requirement that a separate power of attorney be submitted to it. Any receiving Office, International Searching Authority, or International Preliminary Examining Authority may waive the requirement that a copy of a general power of attorney is attached to the request, the demand or a separate notice. The receiving Office or Authority may waive these requirements in general or only for certain cases. In cases where either waiver is applicable, no separate power of attorney or copy of a general power of attorney needs to be furnished by the applicant. Any such waiver and any conditions relating thereto are published in the *Official Notices (PCT Gazette)* (see also **Annexes C, D and E**). Please note that a power of attorney must, in any event, still be furnished for any case of withdrawal, even if the requirement has been waived for other cases. Any waiver made by a receiving Office only applies in respect of that Office but not necessarily in respect of other Authorities involved in the PCT procedure. Regarding signature



PCT AG-IP 5.047 Is the person who signs the request for a corporate applicant regarded as an agent?

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requirements, see **paragraphs 5.088 to 5.091**; for special provisions regarding withdrawals, see **paragraphs 11.048 to 11.061**. [Rule 90.4(d) and (e) 90.5 (c) and (d)]

5.045. Further agents may be appointed at any time to represent the applicant either generally or specifically before the International Searching Authority or the International Preliminary Examining Authority, and an agent appointed for general purposes, unless otherwise indicated in the document appointing him, may appoint sub-agents to represent the applicant. The appointment of a new agent is treated as revocation of any former appointment of agents, unless otherwise indicated in the power of attorney appointing the new agent. [Rule 90.1(d)(ii) 90.6(b)]

5.046. If representation by an agent before the receiving Office is required (see **paragraph 5.041**), it is advisable that the agent be appointed by the time the international application is filed to ensure that the international application will be accepted for processing by the receiving Office. The practice of the receiving Office with regard to enforcing the requirement that an agent be appointed is, generally the same as that observed by it in the case of national (or regional) applications. If the appointment of an agent is not obligatory, an appointment may be made either at the time of filing the international application or later. [Article 27(7) Rule 4.7 90.3]

***PCT AG-IP 5.047 Is the person who signs the request for a corporate applicant regarded as an agent?***

**PCT AG-IP 5.047 Is the person who signs the request for a corporate applicant regarded as an agent?** The answer depends on the nature of the authorization to act for the corporate applicant – that is, on whether the person signs on behalf of the corporate applicant or as an appointed agent. If the name of that person is indicated in Box No. IV and the check-box "agent" is marked, the person will be regarded as an agent and a power of attorney may be required. If the corporate applicant is indicated in that Box and the check-box "common representative" is marked, the person who signs will not be regarded as an agent. The mere fact that a person is indicated as part of the address for correspondence to the corporate applicant as common representative (see **paragraph 5.051**) does not mean that the person will be regarded as an agent. [ ]

***PCT AG-IP 5.048 Can one of several applicants represent all of them as a common representative?***

**PCT AG-IP 5.048 Can one of several applicants represent all of them as a common representative?** If a common agent is not appointed by all the applicants, one of the applicants may be appointed by the other applicants as the common representative of all the applicants (see **paragraph 11.005**). If neither a common agent nor a common representative is appointed, the first-named applicant who has a right to file an international application with the receiving Office concerned is automatically considered to be the "deemed" common representative of all the applicants (see **paragraph 11.006**). [Rule 2.2bis 90.2]

5.049. A more detailed explanation of the provisions relating to agents and common representatives appears in **paragraphs 11.001 to 11.014**. [ ]

5.050. If the agent or common representative has authorized either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail by marking the corresponding check-box in Box No. IV of the **request form**, the receiving Office, the International Searching Authority (also in its capacity as Authority specified for supplementary search), the International Bureau and the International Preliminary Examining Authority may, if they wish to do so, send such notifications in respect of the international application to the agent or common representative at the indicated e-mail address, thus avoiding processing or postal delays. Where an e-mail address has been provided both in respect of the applicant and in respect of an agent or common

representative, the International Bureau will send e-mail communications only to the appointed agent or common representative (see also **paragraph 5.029**). [ ]

***PCT AG-IP 5.051 When and how may a special address for correspondence be given?***

**PCT AG-IP 5.051 When and how may a special address for correspondence be given?**

Correspondence is sent to the appointed agent or common representative, if any. Where no agent or common representative is appointed, any correspondence will be sent to the address, indicated in Box No. II or III, of the applicant (if only one person is named as applicant) or of the applicant who is considered to be the common representative (if there are two or more persons named as applicants) (see **paragraphs 5.048 and 11.006**). However, if the applicant wishes correspondence to be sent to a different address, in such a case, 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). [**Rule 4.4(d) Section 108**]

[ ]

***PCT AG-IP 5.052 What is the designation of States?***

**PCT AG-IP 5.052 What is the designation of States?** The designation of States is the indication of Contracting States in or for which the applicant may seek protection for his invention. For international applications filed after 1 January 2004, the filing of the request automatically constitutes: [**Article 4(1)(ii) 11(1)(iii)(b) Rule 4.9(a)**]

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date; [ ]

(ii) an indication that the international application is, in respect of each designated State to which **Article 43** or **44** applies, for the grant of every kind of protection which is available by way of the designation of that State; and [ ]

(iii) an indication that the international application is, in respect of each designated State to which **Article 45(1)** applies, for the grant of a regional patent and also, unless **Article 45(2)** applies, a national patent. [ ]

This is also valid where the applicant does not use the request **Form PCT/RO/101** issued on 1 January 2004, or thereafter, or where the international filing date is changed to a date either on, or after, 1 January 2004. [ ]

5.053. As an exception to the automatic and all-inclusive designation of Contracting States, Germany, Japan and the Republic of Korea may be excluded from being designated. The reason for this exception is that these States have notified the International Bureau that the national law applied by their designated Offices contains provisions to the effect that the filing of an international application which contains the designation of that State and which claims the priority of an earlier national application having effect in the same State, has the result that the earlier national application ceases to have effect. Check-boxes can therefore be marked when an applicant wants to avoid undesired loss of the national priority application. Further details relating to this issue, and particular conditions which may apply, are explained in **Annex B** in respect of these States. [**Rule 4.9(b)**]

PCT AG-IP 5.054 Is the procedure for extending a European patent to a country having an Extension Agreement with the European Patent Organisation available through the filing of an international application?

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***PCT AG-IP 5.054 Is the procedure for extending a European patent to a country having an Extension Agreement with the European Patent Organisation available through the filing of an international application?***

**PCT AG-IP 5.054 Is the procedure for extending a European patent to a country having an Extension Agreement with the European Patent Organisation available through the filing of an international application?** A European patent granted on an international application may, if the necessary conditions are met, be extended to a State having an Extension Agreement to that effect with the European Patent Organisation. The procedure is available through the filing of an international application as the filing of the request constitutes the designation of all States, including the designation of the **European Patent Office** and the designation for a national patent of all States having concluded an Extension Agreement, and which are also PCT Contracting States.

**Annex B (EP)** contains information as to the States to which European patents may be so extended. Details of the applicable procedure, including the steps to be taken on entering the national phase and fees payable, have been published in the *Official Journal of the European Patent Office* (No. 1-2/1994, pages 75 to 88, and No. 11/1997, pages 538 to 542); see also the **National Chapter Summary (EP)**. [ ]

***PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?***

**PCT AG-IP 5.055 Is it possible to choose a kind of protection other than a patent, and if so how is it done?** As indicated in **paragraph 5.052**, the filing of the request constitutes the indication that the international application is, in respect of each designated State to which **Article 43** or **44** applies, for the grant of every kind of protection which is available by way of the designation of that State. Examples of such kinds of protection are an inventor's certificate, a utility certificate, a utility model, a "petty patent," a patent of addition, a certificate of addition or an inventor's certificate of addition. It is not possible, during the international phase, to indicate the wish to obtain a certain kind of protection for a particular designated Office. Any further choice of the kind of protection sought can only be made at the time of national phase entry before the respective designated Offices. Please note, however, that it is possible to withdraw a certain type of protection in respect of the designation of a State. **Annexes B** indicate, for each Contracting State, the kinds of protection available. [**Article 4(1)(ii) 4(3) 43 44 Rule 4.1(b)(iii) 4.11 49bis.1**]

***PCT AG-IP 5.056 Is it necessary to include any parent information in the international application?***

**PCT AG-IP 5.056 Is it necessary to include any parent information in the international application?** Where, when entering the national phase, a title (patent, certificate, inventor's certificate) of addition is sought, or where the applicant wishes the international application to be treated as an application for a continuation or a continuation-in-part, for the purposes of the international search, that fact must be indicated following the name of the designated State, and the parent application must be identified in the "Supplemental Box" (see item 2 or 3 of that Supplemental Box). [ ]

[ ]

***PCT AG-IP 5.057 How may the priority of an earlier application be claimed?***

**PCT AG-IP 5.057 How may the priority of an earlier application be claimed?** Any international application may contain a declaration claiming the priority of one or more earlier applications filed in or for any country party to the **Paris Convention for the Protection of Industrial Property** or in or for a member of the **World Trade Organization (WTO)** that is not party to that Convention. Note that where priority is claimed of an earlier filing in or for a WTO member which is not party to the Paris Convention, a PCT Contracting State that is not a Member of the WTO is not required to recognize the effects of such a priority claim. An earlier regional (**ARIPO, Eurasian, European, OAPI** or any other similar regional organization providing for the grant of regional patents and where at least one of the countries party to that regional patent treaty is party also to the Paris Convention or the WTO) application or an earlier international application can also serve as a basis for a priority claim. Any priority claim must be made in the request. The priority claim must contain the necessary indications which allow the earlier application to be uniquely identified. If the earlier application was a national application, it must indicate the country in which it was filed, the date on which it was filed and the number under which it was filed. Where the earlier application was a regional application, the priority claim must indicate the Office with which it was filed; only where not all countries party to the regional patent treaty under which the earlier application was filed are also party to the **Paris Convention for the Protection of Industrial Property** (the Paris Convention) or are also members of the WTO must the priority claim indicate at least one country party to the Paris Convention or at least one member of the WTO for which that earlier regional application was filed. Where the earlier application was an international application, the priority claim must indicate the receiving Office with which it was filed. The two-letter code (see **Annex K** and **paragraph 5.033**) may be used for the indication of the country or, where applicable, for the Office of filing. Subject to certain conditions, priority claims may be corrected and added, after the international application has been filed, by a notice submitted to the receiving Office or to the International Bureau (see **paragraphs 6.038 to 6.044**). [Article 8(1) Rule 4.1(b)(i) 4.10]

***PCT AG-IP 5.058 What does “priority date” mean?***

**PCT AG-IP 5.058 What does “priority date” mean?** Where the international application contains a priority claim, “priority date” means the filing date of the application whose priority is claimed. Where the international application does not contain such a claim, “priority date” means the filing date of the international application. Where the international application contains two or more claims, “priority date” means the filing date of the earliest application whose priority is claimed. [Article 2(xi)]

***PCT AG-IP 5.059 What does “priority period” mean?***

**PCT AG-IP 5.059 What does “priority period” mean?** “Priority period” means the period of 12 months from the filing date of the earlier application whose priority is claimed in the international application. The day of filing of the earlier application is not included in this period. Subject to what is said below, in order to validly claim priority, an international application must always be filed within the priority period; otherwise, the right of priority will be lost. Note that, in certain cases (see **Rules 2.4(b)** and **80.5**) the priority period may expire on a later day. Note further that, if the international application is filed after the expiration of the priority period but within a certain time limit, it may be possible, under limited circumstances, to request restoration of the right of priority (see **paragraphs 5.062 to 5.069**; this, however, will not apply to all Contracting States). [Rule 2.4 80.5]

***PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?***

**PCT AG-IP 5.060 What are the principles governing the right of priority for international applications?** The PCT makes no change to the provisions which govern the right of priority and are

contained in **Article 4 of the Paris Convention for the Protection of Industrial Property**; WTO members are required to apply Paris Convention **Article 4** in accordance with **Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights** (TRIPS Agreement). Since an international application has the effect in each designated State of a regular national application, it may claim priority from another application, and be used as the basis for a priority claim in a later application, just like any regular national application. So far as PCT procedures are concerned, the priority claim is particularly important because it establishes a priority date for the purposes of computing time limits under the PCT. The validity of a priority claim is not determined during the international phase (although the matter is taken into consideration for the purposes of establishing international preliminary reports on patentability (**Chapter I or II** of the PCT)). Also, a priority claim would, subject to the possibility of correction (see **paragraphs 6.038 to 6.044**), for the purposes of the procedure under the PCT, be considered not to have been made if the application, the priority of which is claimed, was not filed either in a country party to the Paris Convention or in a member of the WTO, if the international application were filed more than two months after the expiration of the priority period (see **paragraphs 5.062 and 6.038**) or if the priority claim did not include the required details concerning the date on which and the country and/or Office, as the case may be, where the earlier application was filed. [**Article 8(1) and (2)(a) 11(3) 11(4) Rule 4.10**]

***PCT AG-IP 5.061 How must dates be indicated in the priority claim?***

**PCT AG-IP 5.061 How must dates be indicated in the priority claim?** Each date appearing in the international application or in any correspondence must be indicated by the Arabic number of the day, the name of the month and the Arabic number of the year, in that order. In the request, after, below or above that indication, the date should be repeated in parentheses with a two-digit Arabic numeral each for the number of the day and the number of the month, the number of the year must be indicated in four digits, in that order and separated by periods, slants or hyphens, for example: "20 March 2006 (20.03.2006) or 20 March 2006 (20/03/2006) or 20 March 2006 (20-03-2006)." [**Section 110**]

***PCT AG-IP 5.062 What are the consequences if the international application is filed after the expiration of the priority period?***

**PCT AG-IP 5.062 What are the consequences if the international application is filed after the expiration of the priority period?** Where an international application has an international filing date which is later than the date on which the priority period expired (see **paragraph 5.059**) but within a period of two months from that date, the priority claim concerned will not be declared void for the purposes of the international phase of the PCT procedure, irrespective of whether the restoration of the right of priority is requested (see below), or whether such a request is accepted or refused by the receiving Office. Where the priority claim in question is the only or the earliest priority claim in the international application, it will continue to serve as the basis to calculate all time limits during the international phase. Note, however, that the fact that the priority claim is retained in the international application does not mean in any way that the validity of such a priority claim in the national phase is assured. [**Rule 26bis.3**]

In respect of such a priority claim, the applicant may file a request for the restoration of the right of priority with the receiving Office (see the following paragraphs for the procedure relating to the restoration of the right of priority). Several receiving Offices have, however, notified the International Bureau under **Rule 26bis.3(j)** of the incompatibility of the provisions governing such requests to restore the right of priority with the national laws applied by those Offices. As a result, those receiving Offices will not apply those provisions and thus do not accept such requests. A list of Offices which will not accept requests under **Rule 26bis.3(a)** can be found on WIPO's website at [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html#R\\_26bis\\_3\\_j](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html#R_26bis_3_j). To the extent that the applicant is aware, before filing the international application, of the need to file a request for restoration, he should consider filing the international application with a competent receiving Office that does accept such requests. For example, the receiving Office of the International Bureau accepts

PCT AG-IP 5.063 What is the time limit for requests for the restoration of the right of priority?

such requests and is competent for international applications filed by a national or resident of any PCT Contracting State. If the need to file a request to restore only becomes apparent after the international application has already been filed, the applicant may request the receiving Office to transmit the international application to the receiving Office of the International Bureau under **Rule 19.4(a)(iii)**. [ ]

***PCT AG-IP 5.063 What is the time limit for requests for the restoration of the right of priority?***

**PCT AG-IP 5.063 What is the time limit for requests for the restoration of the right of priority?**

The time limit for complying with the requirements to request the restoration of the right of priority is two months from the date on which the priority period expired. If the receiving Office requires the applicant to provide a declaration or evidence in support of the statement of reasons for failure to timely file the international application (see **paragraph 5.064**), it will allow the applicant a reasonable time under the circumstances to furnish such documents. [**Rule 26bis.3(e)**]

***PCT AG-IP 5.064 How should a request for the restoration of the right of priority be filed with the receiving Office?***

**PCT AG-IP 5.064 How should a request for the restoration of the right of priority be filed with the receiving Office?** The **request form**, Box VI, includes an option for the applicant to request restoration of the right of priority and a similar option is included in the PCT-SAFE software. The applicant only needs to add an indication, in the case of multiple priority claims, to clarify in respect of which priority claim restoration is requested. The request to restore the right of priority may also be submitted separately from the request form by way of a letter to the receiving Office. [**Rule 4.1(c)(v) 26bis.1(a) 26bis.3**]

For the request to restore the right of priority to be successful, the following requirements must be met: [ ]

- the international application must contain a priority claim to an earlier application. In addition, this international application must have been filed within two months from the date of the expiration of the priority period. If, the international application does not contain the relevant priority claim at the time of filing, such a claim must be added, in accordance with **Rule 26bis.1(a)** (see **paragraphs 6.038 to 6.040**), within two months from the expiration of the priority period (see **Rules 26bis.3(c) and (e)**); [ ]

- the request to restore should state the reasons for the failure to file the international application within the priority period. This statement of reasons should be submitted as a separate document and accompany the request for restoration in the **request form** or may be filed subsequently within the time limit under **Rule 26bis.3(e)**. The statement of reasons should take into consideration the restoration criterion which the applicant seeks to satisfy, from among those applied to such requests by the Office (see **Annex C** and **paragraph 5.065**); [ ]

- a fee for requesting restoration, if applicable, must be paid (see **Annex C** for whether a particular receiving Office requires a fee for the restoration of the right of priority) before the expiration of the time limit under **Rule 26bis.3(e)**; the time limit for payment of the fee may be extended for a period of up to two months from the expiration of the time limit under **Rule 26bis.3(e)** (**Rule 26bis.3(d)**); [ ]

- if required by the receiving Office, a declaration or other evidence in support of the statement of reasons should preferably be furnished together with the request to restore but may also be furnished upon invitation by the receiving Office (**Rule 26bis.3(f)**) (for the applicable time limit, see **paragraph 5.063**). [ ]

***PCT AG-IP 5.065 What are the criteria for restoration applied by the receiving Office?***

**PCT AG-IP 5.065 What are the criteria for restoration applied by the receiving Office?** There are two possible criteria for restoration: either the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or the failure to file the international application within the priority period was unintentional. All Offices to which these Rules are applicable (see **paragraph 5.062**) must apply at least one of these criteria. If a receiving Office wishes, it may apply both criteria for restoration and leave the choice to the applicant as to which criterion is sought to be applied in a specific case, noting that it would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would in general be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion. Furthermore, a receiving Office will be free to apply, upon request of the applicant, first the “due care” criterion and then, if the receiving Office finds that that criterion is not complied with, the “unintentionality” criterion. [**Rule 26bis.3(a) 49ter.1(a) and (b)**]

***PCT AG-IP 5.066 What needs to be included in the statement of reasons for the request to restore the right of priority?***

**PCT AG-IP 5.066 What needs to be included in the statement of reasons for the request to restore the right of priority?** The statement should indicate the reasons for the failure to file the international application within the priority period. It should contain all the relevant facts and circumstances which would allow the receiving Office to determine 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 or was unintentional. [ ]

***PCT AG-IP 5.067 What kind of declaration or evidence is required in support of a request for restoration of the right of priority?***

**PCT AG-IP 5.067 What kind of declaration or evidence is required in support of a request for restoration of the right of priority?** Under **Rule 26bis.3(f)**, the receiving Offices may require that a declaration or other evidence in support of the statement of reasons be furnished or, if some evidence has already been provided, that additional evidence be furnished. [**Rule 26bis.3(f)**]

***PCT AG-IP 5.068 Will there be an opportunity for dialogue with the receiving Office should that Office intend to refuse the request?***

**PCT AG-IP 5.068 Will there be an opportunity for dialogue with the receiving Office should that Office intend to refuse the request?** If the receiving Office intends to refuse the request for restoration of the priority claim, it is required to notify the applicant of its intention. The applicant then has an opportunity to make observations on the intended refusal within a reasonable time limit, specified in the notification of intended refusal (**Form PCT/RO/158**). Note that this notification may in practice be sent to the applicant together with an invitation to file a declaration or other evidence. [**Rule 26bis.3(g)**]

***PCT AG-IP 5.069 What are the effects of a decision by a receiving Office on designated Offices?***

**PCT AG-IP 5.069 What are the effects of a decision by a receiving Office on designated Offices?** A decision by a receiving Office to restore a right of priority based on the criterion of “due care” will, as a general rule, be effective in all designated Offices, unless the designated Office submitted a notification of incompatibility under **Rule 49ter.1(g)**. A decision by a receiving Office to

restore a right of priority based on the criterion of “unintentionality” will be effective only in those designated States the applicable laws of which provided for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion. A decision by a receiving Office to refuse to restore the right of priority can always be reviewed by a designated Office, unless it has submitted a notification of incompatibility under **Rule 49ter.1(g)**, such that restoration is not possible in that jurisdiction. [**Rule 49ter.1**]

In addition, a review of a positive decision may be made by a designated Office in the limited situation where it reasonably doubts that one of the substantive requirements for restoration was complied with. No review is permitted on purely formal grounds, such as, for example, the ground that the relevant fee in the international phase might not have been paid. [ ]

### ***PCT AG-IP 5.070 When and to whom must the priority document be furnished?***

**PCT AG-IP 5.070 When and to whom must the priority document be furnished?** Before the expiration of 16 months from the priority date (or, where the applicant requests early processing pursuant to **Article 23(2)**, before that request is made), a certified copy of the earlier application (whether it is a national, regional or international application) must be submitted by the applicant either to the International Bureau or to the receiving Office (unless it has already been filed with the receiving Office together with the international application). Any certified copy that reaches the International Bureau after the expiration of 16 months from the priority date, but before the date of international publication of the international application, will be considered to have reached the International Bureau on the last day of that 16-month period. The copy must be certified by the authority with which the earlier application was filed. Where that authority is the same Office as the receiving Office, the applicant may, instead of submitting the certified copy, request the authority, before the expiration of 16 months from the priority date, to prepare and transmit the certified copy to the International Bureau; in that case, the fee usually charged by the Office should be paid when the request for transmittal is made; the easiest solution for the applicant is to make this request at the time of filing the international application, by marking the check-box provided for that purpose in Box No. VI. Furthermore, where the priority document is available to either the International Bureau or to the receiving Office from a digital library in accordance with **Rule 17.1(b-bis)** and **Section 715(a)**, the applicant may, before the expiration of 16 months from the priority date, request the International Bureau to obtain the priority document from such a digital library, or, if only the receiving Office has access to the priority document concerned, to request the receiving Office to obtain the document from such a digital library and to transmit it to the International Bureau (see **paragraph 5.070B**). The International Bureau will not charge a fee for this service. Where the receiving Office is requested to obtain and transmit the priority document from a digital library, any fee that might be charged by the receiving Office should be paid when the request to obtain the priority document is made. The easiest solution for the applicant is to make this request with the International Bureau or the receiving Office at the time of filing the international application, by marking the check-box provided for that purpose in Box No. VI. [**Rule 4.1(c)(ii)** **17.1 17.2(a)** **Section 411**]

### ***PCT AG-IP 5.070A How will I know if my earlier application is available to the PCT System from a digital library?***

**PCT AG-IP 5.070A How will I know if my earlier application is available to the PCT System from a digital library?** At the moment, the only available “digital library” in the PCT system is the WIPO Priority Document Access Service (DAS). This offers access to earlier applications filed at the receiving Office of the International Bureau and a number of national Offices for use as priority documents. However, unlike some of the bilateral priority document sharing systems between national Offices, the earlier application is only available if the applicant has taken specific steps to make the document available, as set out in the paragraphs below. Details of Offices participating in the Priority Document Access Service are available in Annex B and at: [www.wipo.int/patentscope/en/priority\\_documents/offices.html](http://www.wipo.int/patentscope/en/priority_documents/offices.html). [ ]



PCT AG-IP 5.070B What steps must be taken so that the International Bureau can obtain the priority document from a digital library, in particular via the DAS?

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***PCT AG-IP 5.070B What steps must be taken so that the International Bureau can obtain the priority document from a digital library, in particular via the DAS?***

**PCT AG-IP 5.070B** What steps must be taken so that the International Bureau can obtain the priority document from a digital library, in particular via the DAS? Where the applicant would like to request the International Bureau to obtain a priority document via DAS, the following steps must have been taken: [ ]

(i) the applicant must first have authorized the Office with which the earlier application was filed (Office of First Filing) to make the application available in the DAS system. What precise steps must be taken depends, however, on the Office concerned. For further details see **Annex B**;[ ]

(ii) the applicant then needs to go to the DAS portal at:  
**[https://webaccess.wipo.int/priority\\_documents/en/](https://webaccess.wipo.int/priority_documents/en/)** and enter the specific “access code” provided by the Office with which the earlier application was filed. At this stage, the applicant is also obliged to provide an e-mail address for receipt of subsequent electronic notifications from the DAS system;[ ]

(iii) from the DAS portal, the applicant then needs to give permission to the International Bureau to obtain a copy of the earlier application;[ ]

(iv) the applicant requests the International Bureau to obtain a copy of the earlier application, for which priority has been claimed, by marking the check-box, provided for that purpose, in Box No. VI of the PCT request form or by submitting a written request to the International Bureau.[ ]

5.070C. The International Bureau notifies the applicant of the date on which the priority document was received or obtained. Any designated Office may request a copy of the priority document from the International Bureau. Provided the applicant has either furnished a certified copy or requested that the priority document be transmitted or obtained and paid the necessary fee as described above, no designated Office may ask the applicant to furnish a certified copy of the earlier application. Where this is not the case and unless the earlier application of which priority is claimed was filed with the designated Office in its capacity as national Office or if the priority document is available to the designated Office from a digital library, any designated Office may disregard the priority claim. The designated Office must first, however, have given the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances. For the obligation of the applicant to furnish a simple (not certified) copy of the priority document to the designated Offices (including a copy of the priority certificate), see **National Phase, paragraph 5.009** and the relevant **National Chapters**. [ ]

5.071. For information as to the obtaining of copies of the priority document after international publication, see **paragraph 9.023**. [Rule 17.2(b)]

[ ]

***PCT AG-IP 5.072 Must an applicant indicate a choice of International Searching Authority?***

**PCT AG-IP 5.072** Must an applicant indicate a choice of International Searching Authority? Where two or more International Searching Authorities are competent to carry out the international search, the applicant must indicate the Authority chosen in the appropriate space in Box No. VII. For details on which International Searching Authorities are competent, see **Annex C** and **paragraph 7.002**. [Rule 4.1(b)(iv) 4.14bis]

PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search? What are the benefits of this for applicants?

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***PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search? What are the benefits of this for applicants?***

**PCT AG-IP 5.073 Can the International Searching Authority be requested to take into account the results of an earlier search? What are the benefits of this for applicants?** If the applicant wishes the International Searching Authority, in carrying out the international search, to take into account the results of an earlier international, international-type or national search (**Rule 4.12**) and has complied with all the requirements under **Rule 12bis.1**, the Authority must, to the extent possible, take into account the results of the earlier search if it was carried out by the same Office as that which is acting as the International Searching Authority (**Rule 41.1(i)**). However, if the earlier search was carried out by another International Searching Authority or national (or regional) Office, the International Searching Authority may choose whether it takes into account the results of the earlier search (**Rule 41.1(ii)**). To the extent that the International Searching Authority takes such earlier search results into account, the International Searching Authority must reduce the search fee to the extent and under the conditions provided for in the agreement under **Article 16(3)(b)** (**Rule 16.3**). International Searching Authorities are free to decide the extent and conditions for such search fee reductions. For the full texts of the agreements under **Article 16(3)(b)** see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html) (see also **paragraph 5.198**). [**Rule 4.1(b)(ii) 4.12 12bis 16.3 41.1**]

The **request form**, Box No. VII, includes an option for the applicant to request that the results of an earlier search be taken into consideration by the International Searching Authority and a similar option is included in the PCT-SAFE software. The applicant only needs to check the corresponding box in Box No. VII and identify the earlier application (whether national, regional or international) in respect of which the earlier search was carried by including the filing date, the filing number and the country of filing. [ ]

In general, if the applicant has made a request for the results of an earlier search to be taken into account, he should – together with the international application and at the time of filing – provide the receiving Office with a copy of the results of the earlier search. However, the applicant will not need to furnish a copy of the earlier search results in the following cases: [ ]

– where the earlier search was carried out by the same Authority or Office as that which will act as the International Searching Authority; [ ]

– where the earlier search was carried out by the same Office as that which is acting as the receiving Office; in this case, the applicant can request the receiving Office to prepare and transmit the earlier search results directly to the International Searching Authority by marking the check-box provided in Box No. VII of the **request form**; [ ]

– where a copy of the earlier search results is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library and the applicant indicated this fact as provided for in Box No. VII of the **request form**. [ ]

If the applicant wants the results of more than one search to be taken into account, the above-mentioned indications must be specified for each and every earlier search. In addition, where the applicant requests the International Searching Authority to take into account the results of more than two earlier searches, the sheet of the **request form** containing Box No. VII, Use of Results of Earlier Search, Reference to that Search, should be duplicated as many times as necessary to allow the applicant to comply with the requirements and provide the required information for each earlier application. [ ]

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PCT AG-IP 5.074 What declarations may be referred to in Box No. VIII and included in Boxes Nos. VIII(i) to (v)?

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Unless the applicant has done so already, the International Authority may invite the applicant (**Form PCT/ISA/238**) to furnish to it a copy of the earlier application, a translation (where required) of that earlier application into a language accepted by the International Searching Authority, a translation (where required) of the results of the earlier search into a language accepted by the International Searching Authority and/or a copy of any document cited in the results of the earlier search. However, the International Searching Authority may not require the applicant to furnish any or some of those documents in the following cases: [ ]

– where the earlier search was carried out by the same Authority or Office as that which will act as the International Searching Authority; [ ]

– where the earlier search was carried out by the same Office as that which is acting as the receiving Office; in this case, the applicant can request the receiving Office to prepare and transmit a copy of the earlier application and copies of any documents cited in the results of the earlier search directly to the International Searching Authority by marking the check-box(es) provided in Box No. VII of the **request form**; [ ]

– where the applicant marks the check-box provided in Box No. VII of the **request form** stating that the international application is the same or substantially the same as the earlier application in respect of which the earlier search was carried out, except that it is filed in a different language, the International Searching Authority may not require a copy of the earlier application or a translation thereof; [ ]

– where a copy of the earlier application or of any document cited in the results of the earlier search or a translation of the earlier application or a translation of the results of the earlier search are available to the International Searching Authority in a manner acceptable to it, and if the applicant has indicated so by marking the check-box provided in Box No. VII of the **request form**. [ ]

[ ]

### ***PCT AG-IP 5.074 What declarations may be referred to in Box No. VIII and included in Boxes Nos. VIII(i) to (v)?***

**PCT AG-IP 5.074 What declarations may be referred to in Box No. VIII and included in Boxes Nos. VIII(i) to (v)?** The applicant may, for the purposes of the national law applicable in one or more designated States, include one or more of the following declarations under **Rule 4.17**, using the prescribed standardized wording and presenting them in the relevant Box or Boxes Nos. VIII(i) to (v), which are all optional declaration sheets: [ ]

– Box No. VIII(i): declaration as to the identity of the inventor (noting that such declaration need not be made in Box No. VIII(i) if the name and address of the inventor are indicated in the request, that is, usually in Boxes No. II and/or III); [**Rule 4.17(i) 51bis.1(a)(i)**]

– Box No. VIII(ii): declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent; [**Rule 4.17(ii) 51bis.1(a)(ii)**]

– Box No. VIII(iii): declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application; [**Rule 4.17(iii) 51bis.1(a)(iii)**]

– Box No. VIII(iv): declaration of inventorship (only for the purposes of the United States of America), noting that that declaration must be signed; [**Rule 4.17(iv) 51bis.1(a)(iv)**]

– Box No. VIII(v): declaration as to non-prejudicial disclosures or exceptions to lack of novelty. [**Rule 4.17(v) 51bis.1(a)(v)**]

No other declaration(s) may be included in any of Boxes Nos. VIII(i) to (v). If no declaration is made, none of the optional declaration sheets should be included in the request as filed. [ ]

***PCT AG-IP 5.075 What purpose do declarations referred to in Rule 4.17 serve?***

**PCT AG-IP 5.075 What purpose do declarations referred to in Rule 4.17 serve?** The purpose of declarations referred to in **Rule 4.17**, if they are made using the standardized wording (see **paragraphs 5.078 to 5.080**), is to simplify the processing of international applications in the national phase. The matters in respect of which such declarations may be made are matters in respect of which designated Offices are entitled to require documents or evidence during the national phase. Where the declaration in question is one of those referred to in **Rule 4.17(i) to (iv)**, the designated Office for the purposes of which the declaration is made may not require any document or evidence relating to the subject matter of such declaration unless it may reasonably doubt the veracity of that declaration. Where the declaration in question is that referred to in **Rule 4.17(v)**, the designated Office for the purposes of which the declaration is made is free to nevertheless require further documents or evidence, noting that the matter of non prejudicial disclosures and exceptions to lack of novelty is a substantive matter of patentability. It is to be noted that the fact that a declaration is made does not of itself establish the matters declared: those matters remain for determination by the designated Offices in accordance with the applicable national law. [**Rule 4.17 51bis.1 51bis.2(a) and (b)**]

***PCT AG-IP 5.076 Do all designated Offices accept declarations made under Rule 4.17 for the purposes of fulfillment of national phase requirements?***

**PCT AG-IP 5.076 Do all designated Offices accept declarations made under Rule 4.17 for the purposes of fulfillment of national phase requirements?** Most of the designated Offices accept such declarations; however, certain Offices have informed the International Bureau, in accordance with **Rule 51bis.2(c)**, that, even if one or more of the declarations are made as provided in the request, they may still require further documents or evidence in the national phase since the respective national laws applied by them are not compatible with **Rule 51bis.2(a)** or parts thereof. For more information, see **National Phase, paragraphs 5.003 to 5.005**, and the corresponding Summary in the **National Chapter** for the designated Office concerned. [**Rule 51bis.2(a) and (c)**]

***PCT AG-IP 5.077 How do designated Offices receive the declarations relevant to them?***

**PCT AG-IP 5.077 How do designated Offices receive the declarations relevant to them?** All declarations will be part of the published international application (see **paragraph 9.015**) and will therefore not be communicated separately to the designated Offices concerned. [**Rule 48.2(a)(x) 48.2(b)(iv)**]

***PCT AG-IP 5.078 How must the declarations be presented in the request?***

**PCT AG-IP 5.078 How must the declarations be presented in the request?** Each declaration should be made in the appropriate sub-box (i) to (v) of Box No. VIII; a "continuation sheet for declaration" (Continuation of Box No. VIII (i) to (v)) should be used in case any single declaration does not fit in the corresponding sub-box. The declarations must be worded using the standardized wording provided for in **Sections 211 to 215**. Except in respect of the declaration of inventorship for the purposes of the designation of the United States of America (see **paragraph 5.079** for details), the applicant must choose those items and elements of the standardized wording that apply and place them

in the appropriate order, taking into account the facts of the case, the chronology of events, etc. Detailed guidance on making these declarations is contained in the Notes to the **request form**. Refer to the relevant Summaries in the **National Chapters** for information as to which declaration(s) may be made in respect of which designated States. [Rule 4.17 Section 211 212 213 214 215]

5.079. The text of the declaration of inventorship for the purposes of the designation of the United States of America only is pre-printed in Box No. VIII(iv) of the **request form** since that text must be used as shown in **Section 214**, no parts may be omitted or presented in an order different from that used in the form. In addition, all of the inventors must be named in that declaration, even if they do not sign the same (copy of the) declaration, and bibliographic data (such as, but not limited to, address of residence and citizenship) must be included for each inventor; the declaration must be signed and dated directly by the inventor(s). See also **paragraph 5.091**. [Rule 4.17(iv) Section 214(a) and (b)]

***PCT AG-IP 5.080 Must the standardized wordings of declarations always be used?***

**PCT AG-IP 5.080 Must the standardized wordings of declarations always be used?** The standardized wordings should always be used, otherwise, the designated Offices are entitled, even though they are not obliged, to require the applicant to furnish a new declaration or further evidence in the national phase. It should be noted, however, that even if a declaration has not been made using the standardized wording, the International Bureau will nevertheless publish it. It will then be up to each designated Office concerned to determine whether it can accept the declaration or not; in other words, the applicant will not have any guarantee that such Office will accept it. If the circumstances of a particular case are such that the standardized wording is not applicable for making a particular declaration, the applicant should not attempt to make that declaration under **Rule 4.17** but should, instead, comply with the requirements concerned in the national phase of the application. [Rule 51bis.2]

***PCT AG-IP 5.081 What is the purpose of the check-boxes in Box No. VIII?***

**PCT AG-IP 5.081 What is the purpose of the check-boxes in Box No. VIII?** The check-boxes in Box No. VIII should be completed by the applicant to allow the receiving Office to verify that the declaration(s) referred to correspond to those made in Boxes No. VIII (i) to (v), as the case may be. [ ]

***PCT AG-IP 5.082 What if the applicant chooses not to make any declaration at the time of filing the international application or if the declarations are not yet available at the time of filing?***

**PCT AG-IP 5.082 What if the applicant chooses not to make any declaration at the time of filing the international application or if the declarations are not yet available at the time of filing?** In both cases, the request should not include the optional sheets for declarations and nothing should be marked in the list contained in Box No. VIII. [ ]

***PCT AG-IP 5.083 Can a declaration referred to in Rule 4.17 be corrected or added during the international phase?***

**PCT AG-IP 5.083 Can a declaration referred to in Rule 4.17 be corrected or added during the international phase?** A declaration may be corrected, or a new (missing) declaration added, by a notice submitted to the International Bureau. For further details, see **paragraphs 6.045 to 6.050**. [Rule 26ter.1]

[ ]

***PCT AG-IP 5.084 What is the purpose of the check list?***

**PCT AG-IP 5.084 What is the purpose of the check list?** Box No. IX should be completed by the applicant to allow the receiving Office to verify the completeness of the documents constituting and/or accompanying the international application and, in particular, to check whether the international application as filed actually contains the number of sheets in paper form indicated in items (a) to (f). [Rule 3.3 Section 313]

5.085. The actual number of sheets constituting each element of the international application as well as their total should be indicated (for the numbering of sheets, see **paragraph 5.012**). As for the sheets of the request, they are at least four in number (the "first sheet," the "second sheet", the "third sheet" and the "last sheet"). There may be more sheets if one or more optional sheets are used (the "continuation sheet" for Box No. III, the "supplemental sheet", the "declaration sheet" or the "continuation sheet for declaration"). [ ]

5.086. For details on the completion of Box No. IX and on the kinds of items which may need to be filed with the international application, see the Notes to the **request form**. See also the **National Chapters** for details concerning certain matters in relation to designated Offices. [Article 27(2) Rule 13bis 51bis.1 Section 209]

5.087. The applicant must further indicate in Box No. IX the number of that figure of the drawings (if any) which is suggested to accompany the abstract for publication (see **paragraph 5.170**) and preferably also the language of filing of the international application. [Rule 3.3(a)(iii) 8.2 Section 201]

[ ]

***PCT AG-IP 5.088 Who must sign the international application and when?***

**PCT AG-IP 5.088 Who must sign the international application and when?** The international application must be signed in Box No. X of the request by the applicant, or, where there are two or more applicants, by all of them. However, if there is more than one applicant, the receiving Office will not invite the applicant to furnish missing signatures when the request is signed by at least one of the applicants. Note, however, that in this case, any designated Office may in accordance with the applicable national law require the confirmation of the international application by the signature of any applicant for the designated State who has not signed the request. Subject to certain conditions indicated in **paragraph 5.089**, the request may be signed by the agent instead of the applicant(s). [Article 14(1)(a)(i) Rule 4.1(d) 4.15 26.2bis(a) 51bis.1(a)(vi) 90.3]

***PCT AG-IP 5.089 May the international application be signed by an agent?***

**PCT AG-IP 5.089 May the international application be signed by an agent?** The international application may be signed by an agent, but in that case the agent must be appointed as such by the applicant in a separate power of attorney signed by the applicant himself. The power of attorney has to be submitted to the receiving Office unless the receiving Office has waived the requirement to furnish a separate power of attorney (see **paragraphs 5.041 to 5.051**, and **11.001 to 11.014**). If there are two or more applicants, the request may be signed by an agent on behalf of all or only some of them; in that case the agent must be appointed as such in one or more powers of attorney signed by the applicants on whose behalf the agent signs the application. Where a power of attorney appointing an agent who signs an international application is missing and the receiving Office requires that a power of attorney be furnished, the signature is treated as missing until the power of attorney is submitted. For the case where an inventor who is an applicant for the purposes of the designation of

the United States of America refuses to sign the request or cannot be found or reached, see **paragraphs 11.028 to 11.032**. For the case of a general power of attorney, see **paragraphs 5.043 and 11.009**. [Rule 2.1 4.1(d) 4.15 90.3 90.4 90.5]

***PCT AG-IP 5.090 How must the international application be signed?***

**PCT AG-IP 5.090 How must the international application be signed?** The signature should be executed indelibly in a dark color, preferably in black ink, so that it will appear clearly in a photocopy. The name of each person signing the international application should be indicated (preferably typewritten) next to the signature. Where the person signs on behalf of a legal entity, the capacity in which that person signs should also be indicated. [ ]

***PCT AG-IP 5.091 When must or may a seal be used instead of a signature?***

**PCT AG-IP 5.091 When must or may a seal be used instead of a signature?** In international applications filed with the **State Intellectual Property Office of the People's Republic of China** as receiving Office, a seal may be used instead of a signature. In the case of international applications filed in English with the **Japan Patent Office** as receiving Office and in respect of which the **European Patent Office** has been chosen by the applicant as International Searching Authority, a signature must be furnished instead of a seal. In international applications filed with the **Korean Intellectual Property Office** as receiving Office, a seal may be used instead of a signature. [Rule 2.3]

[ ]

***PCT AG-IP 5.092 What are the Notes to the request form?***

**PCT AG-IP 5.092 What are the Notes to the request form?** The Notes to the **request form** are intended to facilitate the completion of that form. They indicate, in relation to each Box of that form, what indications are required and how they are to be made. The Notes are not required to be submitted with the request, however, and should not be numbered as part of the request. [ ]

[ ]

***PCT AG-IP 5.093 What is the fee calculation sheet?***

**PCT AG-IP 5.093 What is the fee calculation sheet?** The fee calculation sheet is intended to help the applicant to calculate the total amount of fees payable to the receiving Office. The sheet is usually annexed to the **request form** which the applicant obtains from the receiving Office. It is not part of the form and is not counted as a sheet of the request, however, and its use is not mandatory. Nevertheless, it is strongly recommended that the applicant complete the fee calculation sheet and submit it to the receiving Office. This will help the receiving Office to verify the calculations and identify any errors. Where two or more International Searching Authorities are competent for searching the international application (see **paragraph 7.002**), the Authority which was chosen by the applicant and indicated in Box No. VII of the **request form** (see **paragraph 5.072**) should also be indicated in the fee calculation sheet, together with the amount of the applicable search fee (see **paragraph 5.187**). See the Notes to the fee calculation sheet for details about completion of the sheet. For information about the payment of fees generally, see **paragraphs 5.184 to 5.199**. [ ]

[ ]

***PCT AG-IP 5.094 How must the description be drafted?***

**PCT AG-IP 5.094 How must the description be drafted?** The description must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. It must start with the title of the invention as appearing in Box No. I of the request. **Rule 5** contains detailed requirements as to the "manner and order" of the description, which, generally, should be in six parts. Those parts should have the following headings: "Technical Field," "Background Art," "Disclosure of Invention," "Brief Description of Drawings," "Best Mode for Carrying Out the Invention" or, where appropriate (see **paragraph 5.096**), "Mode(s) for Carrying Out the Invention," "Industrial Applicability," and, where applicable, "Sequence Listing" and "Sequence Listing Free Text." [**Article 5 11(1)(iii)(d) Rule 5 Section 204**]

5.095. The details required for the disclosure of the invention so that it can be carried out by a person skilled in the art depend on the practice of the national Offices. It is therefore recommended that due account be taken of national practice (for instance in Japan and the United States of America) when the description is drafted. The need to amend the description during the national phase (see **paragraph 5.111** below) may thus be avoided. [ ]

5.096. What is said in **paragraph 5.095** applies likewise to the need to indicate the "best mode for carrying out the invention." If at least one of the designated Offices requires the indication of the "best mode" (for instance, the **United States Patent and Trademark Office**), that best mode must be indicated in the description. [**Rule 5.1(a)(v)**]

5.097. A description drafted with due regard to what is said in **paragraphs 5.094 to 5.096** will be accepted by all the designated Offices. It might require more care than the drafting of a national patent application, but certainly much less effort than the drafting of multiple applications, which is necessary where the PCT route is not used for filing in several countries. [ ]

5.098. The requirement of unity of invention is discussed, in connection with the claims, in **paragraphs 5.114 to 5.123**. [ ]

***PCT AG-IP 5.099 What special requirements apply to a nucleotide and/or amino acid sequence listing part of the description?***

**PCT AG-IP 5.099 What special requirements apply to a nucleotide and/or amino acid sequence listing part of the description?** Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description must contain a listing of the sequence which complies with the standard provided for in **Annex C of the Administrative Instructions** (Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in International Patent Applications Under the PCT) and which is presented as a separate part of the description in accordance with that standard. Where the international application contains the disclosure of a sequence listing, the "sequence listing part" of the description should be headed "Sequence Listing." Where applicable, the main part of the description should, under the heading "Sequence Listing Free Text," repeat the free text contained in the sequence listing. For further information relating to nucleotide and/or amino acid sequence listings, including those filed for the purposes of international search see below and **paragraphs 7.005 to 7.012**. [**Rule 5.2 13ter.1 Section 204 208 513**]

***PCT AG-IP 5.100 How can an international application containing a sequence listing be filed?***

**PCT AG-IP 5.100 How can an international application containing a sequence listing be filed?** An international application containing a sequence listing, forming part of the international application, can be filed on paper or in electronic form. Where the international application is filed in



electronic form, the sequence listing part of the description must also be filed in that form. The application has to be in an electronic document format and/or by a means of transmittal accepted by the receiving Office for the purposes of filing international applications in electronic form (**Annex F**). The sequence listing shall preferably be in text format prepared in accordance with **paragraph 40, Annex C of the Administrative Instructions**. This means the actual sequence listing file output generated by the “PatentIn” software (a “.txt” or “.app” file—depending on the version of the software used (see **paragraph 5.104**)) without converting it into PDF or any other format. Where the international application is filed on paper, the sequence listing part of the description must also be filed on paper in accordance with **Annex C of the Administrative Instructions**. Where the international application is filed on paper and the International Searching Authority requires a copy of the sequence listing in electronic form, such a copy together with the required statement should accompany the international application, but only for the purposes of international search under **Rule 13ter** (see **paragraph 5.102**). [**Section 208 702 Annex F of the Administrative Instructions**]

***PCT AG-IP 5.101 How is the fee for filing sequence listings calculated?***

**PCT AG-IP 5.101 How is the fee for filing sequence listings calculated?** For international applications filed on paper, page fees for the sequence listing are calculated in exactly the same way as the page fees in the main part of the description. For international applications filed in electronic format, this calculation depends on whether the sequence listing is provided in the text format referred to in **paragraphs 5.099 and 5.100**, above. If so, no page fees at all are payable in respect of the sequence listing. If, however, the sequence listing is provided in any other format (such as PDF), or if the sequence is included in the main part of the description instead of as a separate sequence listing file, full page fees are payable. In all cases, tables relating to sequence listings should be an integral part of the description and sheets containing such tables are counted as pages of the description, irrespective of the format in which they are submitted. [**Rule 13ter.1 Schedule of Fees Section 707 Annex C of the Administrative Instructions**]

***PCT AG-IP 5.102 How should the applicant proceed where the international application is filed on paper and a sequence listing, not forming part of the international application, is to be furnished in electronic form for the purposes of [..]***

**PCT AG-IP 5.102 How should the applicant proceed where the international application is filed on paper and a sequence listing, not forming part of the international application, is to be furnished in electronic form for the purposes of international search only?** If the applicant is aware that the International Searching Authority requires a listing of the sequence in electronic form (see **Annex D**), it is advisable to submit such a listing in the prescribed format (see **Annex C of the Administrative Instructions**) on an electronic carrier, accompanied by a statement confirming that “the information recorded in electronic form submitted under **Rule 13ter** is identical to the sequence listing as contained in the international application as filed on paper,” to the receiving Office, together with the international application, rather than to wait for an invitation from the Authority. The receiving Office will then include the electronic carrier, which does not form part of the international application, with the copy of the international application transmitted by the receiving Office to the Authority. [**Rule 13ter Annex C of the Administrative Instructions**]

***PCT AG-IP 5.103 Do all receiving Offices accept the filing of sequence listings in electronic format?***

**PCT AG-IP 5.103 Do all receiving Offices accept the filing of sequence listings in electronic format?** Receiving Offices which are prepared to accept the filing of international applications in electronic format are indicated in **Annex C**. Since the international application and the sequence listing part of the description must either both be in electronic format, or both be on paper, only

PCT AG-IP 5.104 Does the International Bureau recommend any software for the preparation of sequence listings in electronic format?

Offices that accept international applications in electronic form will accept sequence listings filed in this format (see **paragraph 5.100**). [ ]

***PCT AG-IP 5.104 Does the International Bureau recommend any software for the preparation of sequence listings in electronic format?***

**PCT AG-IP 5.104 Does the International Bureau recommend any software for the preparation of sequence listings in electronic format?** The electronic form of sequence listings should preferably be created by dedicated software such as “PatentIn” (available free of charge from the European Patent Office website at: [www.epo.org/patents/Grant-procedure/Filing-an-application/European-applications/Filing-options/PatentIn-filing-software.html](http://www.epo.org/patents/Grant-procedure/Filing-an-application/European-applications/Filing-options/PatentIn-filing-software.html), or from the United States Patent and Trademark Office (USPTO) website at: [www.uspto.gov/web/offices/pac/patin/patentin.htm](http://www.uspto.gov/web/offices/pac/patin/patentin.htm)). [ ]

***PCT AG-IP 5.105 What are the physical requirements for the description?***

**PCT AG-IP 5.105 What are the physical requirements for the description?** Rule 11 lists the physical requirements which have to be met by an international application. The paper must be of A4 size, white and durable. The minimum margins must be 2 cm on the top, the bottom and the right side of the sheet, and 2.5 cm on the left side of the sheet. The margins should not exceed 3 cm on the bottom and the right side of the sheet and 4 cm on the top and the left side of the sheet. The margins must be completely blank, except that a file reference not exceeding 12 characters in length may be placed by the applicant in the left-hand corner of the top margin within 1.5 cm from the top of the sheet. Any text matter in the description must be in characters the capital letters of which are not less than 0.28 cm. [**Rule 11 Section 109**]

***PCT AG-IP 5.106 How should the pages and lines be numbered?***

**PCT AG-IP 5.106 How should the pages and lines be numbered?** The page number must be centered at the top or bottom of the sheet, but not in the 2 cm margin (that is, a page number, if at the top of the sheet, must be below the 2 cm margin, and if at the bottom of the sheet, above the 2 cm margin). It is strongly recommended that every fifth line of each sheet be numbered in the right half of the left margin. The description must be typewritten or printed. The typing must be 1½ spaced and in dark indelible color so as to permit direct reproduction. The capital letters of the characters must be a minimum of 0.28 cm high. [**Rule 11.7 11.8 11.9 Section 207**]

***PCT AG-IP 5.107 How are chemical or mathematical formulae to be represented?***

**PCT AG-IP 5.107 How are chemical or mathematical formulae to be represented?** 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. It is recommended in such cases that each formula be designated by a reference sign and the description should contain references to such formulae whenever necessary. Chemical or mathematical formulae may also be grouped together and be placed after the claims as drawings. In such a case, the chemical or mathematical formulae must be drawn to comply with the requirements for drawings and the sheets must be numbered as drawing sheets (see **paragraph 5.157**). [**Rule 11.9(b) 11.10(b)**]

5.108. 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 high. All mathematical symbols used in a formula which appear in a 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. [Rule 11.9(b) 11.9(d) 11.13(h)]

### ***PCT AG-IP 5.109 How are tables to be represented?***

**PCT AG-IP 5.109 How are tables to be represented?** For the sake of convenience, tables may be grouped together in 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) or by a capital letter, or by a title indicating its contents, 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. [Rule 11.10(c) and(d)]

### ***PCT AG-IP 5.110 How can obvious mistakes in the description be rectified?***

**PCT AG-IP 5.110 How can obvious mistakes in the description be rectified?** The procedure for rectification of obvious mistakes is explained in paragraphs 11.033 to 11.044. The omission of an entire sheet of the description cannot be rectified without affecting the international filing date (see paragraphs 6.025 and 6.026). Changes other than the rectification of obvious mistakes are considered amendments (see paragraph 5.111). [Rule 91]

### ***PCT AG-IP 5.111 Can the description be amended during the international phase?***

**PCT AG-IP 5.111 Can the description be amended during the international phase?** The description can be amended during the international phase only if the applicant files a demand for international preliminary examination (see paragraph 10.001). The description can also be amended during the national phase before each designated or elected Office (see National Phase). Different provisions apply to amendment of the claims in the international phase – see paragraph 5.127. [Article 28 34(2)(b) 41(1) Rule 52 78]

[ ]

### ***PCT AG-IP 5.112 How must claims be drafted?***

**PCT AG-IP 5.112 How must claims be drafted?** The claim or claims must “define the matter for which protection is sought.” Claims must be clear and concise. They must be fully supported by the description. Rule 6 contains detailed requirements as to the number and numbering of claims, the extent to which any claim may refer to other parts of the international application, the manner of claiming, and dependent claims. As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought (“the characterizing portion”). [Article 6 11(1)(iii)(e) Rule 6.1 6.2 6.3 6.4]

5.113. In principle, under the PCT, any dependent claim which refers to more than one other claim (“multiple dependent claim”) must refer to such claims in the alternative only, and multiple dependent claims cannot serve as a basis for any other multiple dependent claim. However, the national laws of most Contracting States permit a manner of claiming which is different from that provided for in the

preceding sentence, and the use of that different manner of claiming is in principle also permitted under the PCT. For the purposes of those designated States where that different manner of claiming is not permitted, the applicant must decide which drafting style to adopt. If that different manner of claiming is used, amendments may need to be made to the claims during the national phase in those States which do not permit it. Moreover, the national Offices of such States, when they act as International Searching Authorities, may indicate under **Article 17(2)(b)** that a meaningful search could not be carried out if that different manner of claiming is used (see **paragraph 7.014**). [**Rule 6.4(a)**]

***PCT AG-IP 5.114 What is meant by the requirement of "unity of invention"?***

**PCT AG-IP 5.114 What is meant by the requirement of "unity of invention"?** An international application should be drafted so that the claims relate to only one invention or to a group of inventions so linked as to form a single general inventive concept. This principle is laid down in **Article 3(4)(iii)** and **Rule 13**. Observance of this requirement is checked by neither the receiving Office nor the International Bureau, but it is checked by, and is important to the procedure before, the International Searching Authority (see **paragraphs 7.015 to 7.021**), the Authority specified for supplementary search (see **paragraph 8.044**) and the International Preliminary Examining Authority (see **paragraph 10.072**), and may be relevant in the national phase before the designated and elected Offices. Since separate searches and examinations are required for distinctly different inventions, additional fees are required if the international search or international preliminary examination is to cover two or more inventions (or groups of inventions linked as just described). (For how the issue of unity of invention affects the supplementary international search, see **paragraph 8.043**.) [**Article 3(4)(iii)** **Rule 13 45bis.6(a)**]

***PCT AG-IP 5.115 How is the requirement of unity of invention satisfied?***

**PCT AG-IP 5.115 How is the requirement of unity of invention satisfied?** Unity of invention is present only when there is a "technical relationship" among the claimed inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The determination whether a group of inventions is so linked as to form a single inventive concept is made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. An initial determination of unity of invention based on the assumption that the claims avoid the prior art will be made before the prior art search but may be reconsidered on the basis of the results of the search.

**Annex B of the Administrative Instructions** contains detailed criteria governing the determination whether an international application complies with the requirement of unity of invention under **Rule 13**. The following paragraphs set out a summary of some of the more important criteria discussed in that Annex. Illustrations of three particular situations are explained in detail below: [**Rule 13.2 13.3 Section 206**]

(i) combinations of different categories of claims (for example – product, process, use, and apparatus or means), [ ]

(ii) so-called "Markush practice" and [ ]

(iii) the case of intermediate and final products. [ ]

***PCT AG-IP 5.116 May different categories of claims be combined in an international application?***

**PCT AG-IP 5.116 May different categories of claims be combined in an international application?** The method for determining unity of invention contained in **Rule 13** is construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: [ ]

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or [ ]

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or [ ]

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process, [ ]

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. [ ]

5.117. An apparatus or means is considered to be "specifically designed for carrying out" a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. [ ]

### ***PCT AG-IP 5.118 What is permitted under the “Markush Practice”?***

**PCT AG-IP 5.118 What is permitted under the “Markush Practice”?** **Rule 13.2** also governs the "Markush practice" wherein a single claim defines alternatives of an invention – a common drafting practice for inventions in the chemical field. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in **Rule 13.2**, is considered to be met when the alternatives are of a similar nature. [ ]

5.119. When the Markush grouping is for alternatives of chemical compounds, they are regarded as being of a similar nature where the following criteria are fulfilled: [ ]

(i) all alternatives have a common property or activity, and [ ]

(ii) (a) a common structure is present – that is, a significant structural element is shared by all of the alternatives, or [ ]

(b) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains. [ ]

5.120. When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention will be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity will be raised. [ ]

### ***PCT AG-IP 5.121 Can both intermediate and final products be claimed?***

**PCT AG-IP 5.121 Can both intermediate and final products be claimed?** The situation involving intermediate and final products is also governed by **Rule 13.2**. The term "intermediate" is intended to

mean intermediate or starting products. Such products have the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity. Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled: [ ]

(i) the intermediate and final products have the same essential structural element, in that: [ ]

(a) the basic chemical structures of the intermediate and the final products are the same, or [ ]

(b) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and [ ]

(ii) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element. [ ]

5.122. Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known – for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there must be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product. [ ]

5.123. An international application which complies with the unity of invention requirements laid down in **Rule 13** must be accepted by all the designated and elected Offices, since **Article 27(1)** does not allow any national law (as defined in **Article 2(x)**) to require compliance with requirements relating to the contents of the international application different from or additional to those provided for in the PCT. [**Article 2(x) 27(1) Rule 13**]

### ***PCT AG-IP 5.124 What are the physical requirements for the claims?***

**PCT AG-IP 5.124 What are the physical requirements for the claims?** The physical requirements are the same as those for the description as outlined in **paragraph 5.105**. Note that the claims must commence on a new sheet. [**Rule 11 11.4(a)**]

### ***PCT AG-IP 5.125 May claims include tables?***

**PCT AG-IP 5.125 May claims include tables?** The claims may include tables if this is desirable in view of the subject matter involved. In this case, 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 (see **paragraph 5.109**). [**Rule 11.10(c)**]

### ***PCT AG-IP 5.126 How can obvious mistakes in the claims be rectified?***

**PCT AG-IP 5.126 How can obvious mistakes in the claims be rectified?** The procedure for rectification of obvious mistakes is explained in **paragraphs 11.033 to 11.044**. The omission of an entire sheet of the claims cannot be rectified without affecting the international filing date (see **paragraphs 6.025 and 6.026**). It is recommended that a request for the rectification of obvious mistakes in the claims be made only if the mistake is liable to affect the international search; otherwise, the rectification should be made by amending the claims (see **paragraph 5.127**). [**Rule 91**]

### ***PCT AG-IP 5.127 Can the claims be amended during the international phase?***

PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?

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**PCT AG-IP 5.127 Can the claims be amended during the international phase?** Yes, the claims may be amended under **Article 19** on receipt of the international search report (see **paragraphs 9.004 to 9.011**); they may also be amended during international preliminary examination if the applicant has filed a demand (see **paragraphs 10.024 and 10.067**) and during the national phase. [**Article 19 28 34(2)(b) 41(1)**]

[ ]

***PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?***

**PCT AG-IP 5.128 When is the inclusion of drawings required in the international application?**

The international application must contain drawings when they are necessary for the understanding of the invention. Moreover where, without drawings being actually necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings, the applicant may include such drawings and any designated Office may require the applicant to file such drawings during the national phase. [**Article 3(2) 7 Rule 7.1**]

5.129. Perspectives, exploded views, sections and cross-sections, and details on a different scale are all considered to be drawings. Drawings also cover 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**]

5.130. Where chemical or mathematical formulae and tables are included in the description, claims or abstract, they are not considered to be drawings and are thus not subject to the same requirements as drawings (see **paragraphs 5.131 to 5.133**). However, such graphic forms may be submitted as drawings, in which case they are subject to the same requirements as drawings. [**Rule 11.10**]

***PCT AG-IP 5.131 How must the drawings be presented?***

**PCT AG-IP 5.131 How must the drawings be presented?** Drawings must be presented on one or more separate sheets. They may not be included in the description, the claims or the abstract. They may not contain text matter, except a single word or words when absolutely indispensable.

**Rules 11.10 to 11.13** contain detailed requirements as to further physical requirements of drawings. Any drawing meeting those requirements must be accepted in the national phase by the designated Offices. Drawings newly executed according to national standards may not be required during the national phase if the drawings filed with the international application comply with **Rule 11**. A file reference may be indicated on each sheet of the drawings as for the description (see **paragraph 5.105**). [**Rule 11.10 11.11 11.13**]

5.132. The 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)**]

5.133. 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. Each sheet must be reasonably free from erasures and must be free from alterations, overwriting and interlineations. Only one side of each sheet may be used. The usable surface of sheets must not exceed 26.2 cm x 17.0 cm. The sheets must not contain frames around the usable surface. The minimum margins which must be observed are: top and left side: 2.5 cm; right side: 1.5 cm; bottom: 1.0 cm. [**Rule 11.2(a) 11.2(b) and (c) 11.3 11.5 11.6(c) 11.12**]

***PCT AG-IP 5.134 Should figures of drawings be arranged in a particular manner?***

**PCT AG-IP 5.134 Should figures of drawings be arranged in a particular manner?** 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. However, figures should not be separated by lines. [Rule 11.10(d) 11.13(j)]

5.135. As far as possible, all figures of the drawings should be set out upright on the sheets. Where the drawings cannot be presented satisfactorily in an upright position, they may be placed sideways, with the tops of the drawings on the left-hand 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. Similar considerations apply to tables and chemical and mathematical formulae (see **paragraphs 5.107 and 5.109**). [Rule 11.10(d) 11.13(j)]

5.136. The drawings should contain as many figures as may be necessary to adequately show the claimed invention. The views may be plan, elevation, section, or perspective views; detail views of portions or elements, on a larger scale if necessary, may be used. Exploded views, with the separated parts of the same figure embraced by a bracket, to show the relationship or order of assembly of various parts, are permissible. One figure should not be placed upon or within the outline of another figure. [ ]

5.137. Where an invention concerns improvements to details of existing devices and machines, a general figure may be desirable to indicate where on the device or machine the improvement is situated, in order to ensure that the drawings are readily understood. If, for example, the invention relates to the fixing of an elastic diaphragm in a diaphragm pump, a figure – generally the first – may represent the entire pump, as improved by the invention, the details of which will then be given in the other figures. On the other hand, it would be unnecessary to represent the entire machine comprising this diaphragm, for example the automobile in which the diaphragm pump circulates the fuel. [ ]

5.138. It is sufficient to choose the views which are the most representative and contain the minimum of hidden parts, so that the object is completely and unambiguously defined by means of the smallest possible number of views. To this end, it is sometimes sufficient to replace the various views of an object by a single perspective view. The simplest view compatible with the desired result should be chosen. [ ]

5.139. 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. 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. [Rule 11.13(i)]

***PCT AG-IP 5.140 How must drawings be numbered?***

**PCT AG-IP 5.140 How must drawings be numbered?** All sheets of drawings must be numbered in the center of either the top or the bottom of each sheet but not in the margin (as for the sheets of the description – see **paragraph 5.106**) in numbers larger than those used as reference signs in order to avoid confusion with the latter. For drawings, a separate series of numbers is to be used (see **paragraph 5.012**). The number of each sheet of the drawings 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, "2/5" would be used for the second sheet of drawings where there are five sheets in all and "1/1" would be used in the case of a single sheet. [Rule 11.7 Section 207(b)]

5.141. Different figures on the sheets of drawings must be numbered in Arabic numerals consecutively and 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 the expression "Fig.," whatever the language of the international application. Where a single figure is sufficient to illustrate the claimed invention, it should not be numbered and the abbreviation "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 as regards 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) 49.5(f)]

5.142. The different 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. [ ]

### ***PCT AG-IP 5.143 How should drawings be executed?***

**PCT AG-IP 5.143 How should drawings be executed?** The drawings must be executed in durable, black, uniformly thick and well-defined lines and strokes. 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 those which by their nature do not permit the use of such instruments, for example, irregular diagrams, ornamental structures and curved reference lines (see paragraph 5.145). [Rule 11.13]

### ***PCT AG-IP 5.144 May lines of different thicknesses be used in the same drawing?***

**PCT AG-IP 5.144 May lines of different thicknesses be used in the same drawing?** Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning. One could, for instance, use: [ ]

- a continuous thick line for edging and outlining views and cross-sections; [ ]
- a continuous thin line for reference lines (see paragraph 5.145 for further details), hatching, outlining parts of adjoining elements, fictitious lines of intersection of surfaces connected by curved or rounded edges; [ ]
- a continuous thin line drawn freehand for delimiting views, part sections or interrupted views; [ ]
- a thin broken line made up of short dashes for hidden edges and contours; [ ]
- a dot-dash thin line for axes and planes of symmetry, extreme positions of movable elements, in front of a cross-section; [ ]
- a thin line terminating in two thick lines for outlines of cross-sections. [ ]

### ***PCT AG-IP 5.145 How should reference***

**PCT AG-IP 5.145 How should reference lines be shown?** 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 quite 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 (see **paragraph 5.143**). [ ]

5.146. Arrows may be used at the end of the reference lines provided that their meaning is clear. They may indicate a number of points: [ ]

(i) a freestanding arrow indicates the entire section towards which it points; [ ]

(ii) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow; [ ]

(iii) arrows may also be used in appropriate cases to show the direction of movement. [ ]

### ***PCT AG-IP 5.147 How are cross-sections to be represented?***

**PCT AG-IP 5.147 How are cross-sections to be represented?** In making and representing cross-sections, certain conditions must be observed with regard to the indication and identification of the figures concerned and how they are to be represented, as more fully explained in **paragraphs 5.148 and 5.149**. [Rule 11.13(b)]

5.148. Where a figure is a cross-section on 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 on 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. A cross-section represents that part of an object which is situated on a cutting surface. In industrial drawings, the cross-section is that part of the object which is behind the cutting surface from the point of view of the person looking at it. Cutting surfaces are generally plane surfaces and if they are not, they must be defined precisely. Cross-sections must always follow the cutting surface, whatever it may be. [ ]

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 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 45°. 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. [ ]

### ***PCT AG-IP 5.150 What should be the scale of figures of the drawings?***

**PCT AG-IP 5.150 What should be the scale of figures of the drawings?** The scale of the figure should be such that all the essential details can be clearly distinguished in a linear reduction in size to

**PCT AG-IP 5.152 How should numbers, letters, reference signs and like indications be presented and applied to drawings?**

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two-thirds. In exceptional cases, where required, the scale of the drawing may be graphically represented. Indications such as "actual size" or "scale ½" on the drawings or in the description, are not permitted, since these lose their meaning with reproduction in different format. [Rule 11.13(c)]

5.151. Each element of each figure must be in 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. As a preferred alternative to a difference in proportion within one figure for the purpose of achieving the necessary clarity, a supplementary figure should be added giving a larger scale illustration of the element of the initial figure. In such cases, it is recommended that the enlarged element shown in the second figure be surrounded by a finely drawn or "dot-dash" circle in the first figure pinpointing its location without obscuring the figure. [Rule 11.13(g)]

***PCT AG-IP 5.152 How should numbers, letters, reference signs and like indications be presented and applied to drawings?***

**PCT AG-IP 5.152 How should numbers, letters, reference signs and like indications be presented and applied to drawings?** Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, and of the sheets of the drawings, 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. Such numbers, letters and reference signs should not be so placed in the closed and complex parts of the drawings as to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. As a general rule, numbers, letters and reference signs should be placed as closely as possible to the part in question. [Rule 11.13(e)]

5.153. A minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible. The Latin alphabet should normally be used for letters. The Greek alphabet is to be accepted, however, where it is customarily used, for example, to indicate angles, wavelengths, etc. [Rule 11.13(h)]

5.154. Reference signs are to be used in a manner which is consistent as between the description, claims and drawings. In particular, reference signs not mentioned in the description must not appear in the drawings, and vice versa. Features of a drawing should not be designated by a reference sign in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to delete reference signs on the drawing which have been deleted in the description. Where for any reason a figure is deleted, all reference signs relating solely to that figure appearing in the description and claims should also be deleted. [Rule 11.13(i)]

5.155. The same features, when denoted by reference signs, must, throughout the international application, be denoted by the same signs. However, where several variants or embodiments of a claimed invention are described, each with reference to a particular figure, and where each variant contains features whose function is the same or basically the same, the features may, if this is indicated in the description, be identified by reference numbers made up of the number of the figure to which it relates followed by the number of the feature, which is the same for all variants, so that a single number is formed. For example, the common feature "15" would be indicated by "115" in Fig. 1, while the corresponding feature would be indicated by "215" in Fig. 2, thereby allowing the individual feature and the figure on which it is to be considered to be indicated at the same time. Complex cases involving many pages of drawings may be made easier to read if, when the individual variants or embodiments are described with reference to particular groups of figures, the common

reference sign is prefixed by the number of the particular variant or embodiment to which it relates; however, this should, if used, be explained in the description. [Rule 11.13(m)]

***PCT AG-IP 5.156 May drawings contain text matter?***

**PCT AG-IP 5.156 May drawings contain text matter?** 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 catch words 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. [Rule 11.11]

***PCT AG-IP 5.157 May symbols be used in drawings?***

**PCT AG-IP 5.157 May symbols be used in drawings?** Known devices may be illustrated by symbols which have a universally recognized 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, that is, simple, and providing 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. [Rule 10.1(d) and (e)]

***PCT AG-IP 5.158 Is the use of shading permitted?***

**PCT AG-IP 5.158 Is the use of shading permitted?** The use of shading in figures is allowed provided this assists in their understanding and is not so extensive as to impede legibility. Shading may, for instance, be used to indicate the shape of spherical, cylindrical, conical elements, etc. 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, as few in number as possible and they must contrast with the rest of the drawings. [ ]

***PCT AG-IP 5.159 May a photograph be presented instead of a drawing?***

**PCT AG-IP 5.159 May a photograph be presented instead of a drawing?** The PCT makes no provision for photographs. Nevertheless, they are allowed where it is impossible to present in a drawing what is to be shown (for instance, crystalline structures). Where, exceptionally, photographs are submitted, they must be black and white, must be on sheets of A4 size, and must respect the minimum margins (see **paragraph 5.133**) and admit of direct reproduction. Color photographs are not accepted, nor are color drawings. Photographs are retained by the International Bureau as part of the record copy. [ ]

***PCT AG-IP 5.160 May a list of reference signs used in the drawings be included in the description?***

**PCT AG-IP 5.160 May a list of reference signs used in the drawings be included in the description?** In the case of international applications dealing with complex subjects and incorporating a large number of drawings, a separate sheet listing all reference signs may be included at the end of the description as a part thereof. This list may take whatever form is appropriate and contain all the reference signs together with the designation of the features which they denote. This method could have the advantage of allowing an easier reference to the meaning of the various reference signs employed and understanding of the drawings. [Rule 11.13(n)]

***PCT AG-IP 5.161 How can obvious mistakes in the drawings be rectified?***

**PCT AG-IP 5.161 How can obvious mistakes in the drawings be rectified?** The procedure for rectification of obvious mistakes is explained in **paragraphs 11.033 to 11.044**. The omission of an entire sheet of drawings cannot be rectified without affecting the international filing date (see **paragraphs 6.025(i)(b) and 6.026**). Changes other than the rectification of obvious mistakes are considered amendments (see **paragraph 5.162**). [Rule 91]

***PCT AG-IP 5.162 Can the drawings be amended during the international phase?***

**PCT AG-IP 5.162 Can the drawings be amended during the international phase?** The drawings can be amended during the international phase only if the applicant files a demand for international preliminary examination (see **paragraph 10.001**). The drawings can also be amended during the national phase. [Article 28 34(2)(b) 41(1)]

5.163. As regards the figure or, exceptionally, figures to accompany the abstract, see **paragraph 5.171**. [ ]

[ ]

***PCT AG-IP 5.164 How must the abstract be drafted?***

**PCT AG-IP 5.164 How must the abstract be drafted?** The abstract must consist of a summary of the disclosure as contained in the description, the claims and any drawings. Where applicable, it must also contain the most characteristic chemical formula. The abstract must be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). As a rule of thumb, it can be said that the volume of the text of the abstract, including one of the figures from the drawings (if any), should not exceed what can be accommodated on an A4 sheet of typewritten matter, 1½ spaced. The other physical requirements must correspond to those for the description, outlined in **paragraph 5.105**. The abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art. These and other requirements concerning the abstract are spelled out in detail in **Rule 8**. [Article 3(3) 14(1)(a)(iv) Rule 8]

5.165. The abstract should be primarily related to what is new in the art to which the invention pertains. Phrases should not be used which are implicit (for instance, "the invention relates to ..."). [ ]

5.166. If the invention is in the nature of a modification to an apparatus, process, product or composition, the abstract should be directed to the technical disclosure of the modification. If the invention is of a basic nature, the entire technical disclosure may be new in the art and the abstract should be directed to the entire disclosure. If an international application relating to a product, particularly a compound or composition, also contains significant disclosure of its method of preparation or use, this matter should also be abstracted. If the disclosure involves alternatives, the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative. [ ]

5.167. Where applicable, and provided the international application contains the information, the abstract should include at least the following: (1) if the invention is a machine, apparatus, or system, its organization and operation; (2) if the invention is an article, its method of making; (3) if the invention is a chemical compound, its identity and preparation; (4) if the invention is a mixture, its ingredients; (5) if the invention is a process, the steps. Extensive mechanical and design details of apparatus should not be given. [ ]

5.168. With regard particularly to chemical inventions for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, for example, "the compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a class should be by a typical example. For processes, the type of reaction, reagents and process conditions should be stated, generally illustrated by a single example. Wherever applicable, the chemical formula should be given which, among all the formulae contained in the international application, best characterizes the invention. [Rule 8.1(a)(ii)]

5.169. The abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application. [Rule 8.1(c)]

***PCT AG-IP 5.170 When must a figure be suggested to accompany the abstract?***

**PCT AG-IP 5.170 When must a figure be suggested to accompany the abstract?** Where the international application contains drawings, the applicant must indicate, in the check list of the request, the number of the figure in the drawings which the applicant suggests should be published with the abstract. [Rule 3.3(a)(iii) 8.2]

5.171. The figure illustrating the abstract must be the figure which best characterizes the claimed invention and must be chosen from the drawings accompanying the international application. Only one figure should be indicated. The abstract may exceptionally be illustrated by more than one figure. If none of the figures is found useful for the understanding of the abstract, no figure need be indicated in the check list. The figure or figures that will accompany the abstract at the time the international application is published may not be included in the abstract. [ ]

5.172. The abstract must be presented on a separate sheet which must appear after the claims and be numbered accordingly (see paragraph 5.012). [Section 207]

***PCT AG-IP 5.173 What happens if the abstract is missing or defective?***

**PCT AG-IP 5.173 What happens if the abstract is missing or defective?** Where the receiving Office finds that the abstract is missing, it invites the applicant to furnish it within a time limit of two months from the date of the invitation to correct. The international application is considered withdrawn if no abstract is furnished to the receiving Office within the time limit fixed. Where the receiving Office has not invited the applicant to furnish an abstract, the International Searching Authority establishes one. The same applies where the abstract does not comply with the requirements outlined in the preceding paragraphs (see also paragraph 7.022). Where the abstract is established by the International Searching Authority, the applicant may submit comments on it within one month from the date of mailing of the international search report. [Article 14(1)(a)(iv) and (b) Rule 26.2 38.2 38.3]

***PCT AG-IP 5.174 Can an abstract be corrected even if the International Searching Authority has already approved it?***

**PCT AG-IP 5.174 Can an abstract be corrected even if the International Searching Authority has already approved it?** The applicant is entitled, until the expiration of one month from the date of mailing of the international search report, to submit to the International Searching Authority proposed modifications of the abstract. It will be up to the Authority to decide whether to modify the abstract accordingly. [Rule 38.3]

[ ]

PCT AG-IP 5.175 What other formal requirements does the international application have to meet?

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***PCT AG-IP 5.175 What other formal requirements does the international application have to meet?***

**PCT AG-IP 5.175 What other formal requirements does the international application have to meet?** The international application may not contain matter contrary to morality or public order, disparaging statements or obviously irrelevant or unnecessary matter. The details are set out in **Rule 9**. [Article 21(6) Rule 9]

5.176. There are certain requirements as to the technical terminology and signs to be used (metric system, etc.). They are specified in **Rule 10**. The use of such prescribed technical terminology will be accepted by all designated Offices. [Rule 10]

5.177. The international application must comply with certain physical requirements, such as requirements concerning fitness for reproduction, the paper to be used, the manner of writing (generally typewritten or printed), etc. The details are spelled out in **Rule 11**. They are, in general, very similar to the requirements applied by the major Patent Offices for national applications (and by the **Eurasian Patent Office** and the **European Patent Office** for Eurasian and European patent applications, respectively). [Article 3(4)(ii) 14(1)(a)(v) Rule 11]

5.178. Where any name or address is written in characters other than those of the Latin alphabet (for example, Chinese, Cyrillic or Japanese), it must be transliterated or translated into English. For details, see **Rule 4.16**. [Rule 4.16]

***PCT AG-IP 5.179 In how many copies must an international application be filed?***

**PCT AG-IP 5.179 In how many copies must an international application be filed?** An international application, and, where applicable, a translation of the international application, must be filed in one, two or three copies, depending on the requirements of the receiving Office. **Annex C** contains the relevant information. See also **Rule 21**. [Rule 11.1(a) and (b) 21]

5.180. It is to be noted that there must eventually be three copies of every international application: one is kept by the receiving Office (the "home copy"), one is transmitted by the receiving Office to, and is kept by, the International Bureau (the "record copy"), and one is transmitted by the receiving Office to, and kept by, the International Searching Authority (the "search copy"). If less than the required number of copies is filed by the applicant (see **paragraph 5.179**), the receiving Office is responsible for preparing the additional copies and may charge a fee to the applicant. [Article 12 Rule 21.1 22.1(a) 23.1(a) Section 305]

5.181. Where the international application was filed in a language which is accepted by the receiving Office but not by the International Searching Authority which is to carry out the international search, the applicant has to furnish a translation of the international application (see **paragraphs 6.013 to 6.013** for details). In that case, the receiving Office forwards a copy of the international application in the language of filing (the "record copy") to the International Bureau, a copy (the "search copy" to the International Searching Authority and retains one copy (the "home copy"). When the receiving Office receives the translation of the international application, it forwards one copy to the International Bureau (the "record copy – translation (**Rule 12.3**)"), keeps one copy for its files (the "home copy – translation (**Rule 12.3**)") and forwards the third copy, together with a copy of the request (the "search copy – translation (**Rule 12.3**)") to the International Searching Authority. If the translation is filed by the applicant in fewer than the required number of copies (see **paragraph 5.179**), the receiving Office is responsible for preparing the additional copies and may charge a fee to the applicant. [Rule 12 12.3 21.1 22.1(a) 23.1(a) Section 305bis]

5.182. Where the international application was filed in a language which is accepted by the receiving Office and by the International Searching Authority which is to carry out the international search but which is not also in a language of publication, the applicant has to furnish a translation of the international application (see **paragraphs 6.013 to 6.023** for details). In that case, the receiving Office forwards a copy of the international application in the language of filing (the “record copy”) to the International Bureau, a copy (the “search copy”) to the International Searching Authority and retains one copy (the “home copy”). When the receiving Office receives the translation of the international application, it forwards one copy to the International Bureau (the “record copy – translation (**Rule 12.4**)”) and keeps one copy for its files (the “home copy – translation (**Rule 12.4**)”). No copy of the translation of the international application will therefore be forwarded to the International Searching Authority by the receiving Office. If the translation is filed by the applicant in fewer than the required number of copies (see **paragraph 5.179**), the receiving Office is responsible for preparing the additional copy and may charge a fee to the applicant. [**Rule 12.4 21.1 22.1(a) Section 305bis**]

5.183. Where the International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the International Searching Authority, the International Bureau will, promptly upon receipt of the international search report or, if the demand was received after the international search report, promptly upon receipt of the demand, send a copy of the international application and the international search report together with a copy of the written opinion of the International Searching Authority to the International Preliminary Examining Authority. Where neither the language in which the international application was filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant must furnish with the demand a translation of the international application into a language which is both a language accepted by that Authority and a language of publication. No such translation is required where the International Searching Authority and the International Preliminary Examining Authority are part of the same national Office or intergovernmental organization. In cases where, instead of the international search report, a declaration under **Article 17(2)(a)** was issued, references in the preceding sentences to the international search report shall be considered references to the said declaration. [**Rule 62.1(i) Section 420**]

[ ]

### ***PCT AG-IP 5.184 What fees are due in respect of an international application?***

**PCT AG-IP 5.184 What fees are due in respect of an international application?** There are three kinds of fee which must be paid in connection with every international application. [**Article 3(4)(iv)**]

(i) The “transmittal fee” is fixed by, and accrues to, the receiving Office for the performance of its tasks in connection with the receipt and checking of the international application, and for the transmittal of copies of it to the International Bureau and the International Searching Authority. [**Rule 14**]

(ii) The “search fee” is fixed by, and accrues to the benefit of, the International Searching Authority for the carrying out of the international search and the establishment of the international search report and the written opinion of the International Searching Authority. [**Rule 16.1**]

(iii) The “international filing fee” is fixed in the **Schedule of Fees** annexed to the PCT Regulations and accrues to the International Bureau for the performance of various tasks, including the publication of the international application and, where applicable, the issuance on behalf of the International Searching Authority of the international preliminary report on patentability (**Chapter I of the PCT**) and the communication of various notifications to the applicant, the receiving Office, the International



Searching Authority, the International Preliminary Examining Authority, and the designated and elected Offices. [Rule 15.1 96]

***PCT AG-IP 5.185 To whom are the fees payable?***

**PCT AG-IP 5.185 To whom are the fees payable?** All three kinds of fee referred to in **paragraph 5.184** are payable to the receiving Office with which the international application is filed. The receiving Office then transmits the search fee to the International Searching Authority and the international filing fee to the International Bureau. [Rule 14.1(a) 15.1 16.1(b)]

***PCT AG-IP 5.186 What is the currency in which the fees are payable?***

**PCT AG-IP 5.186 What is the currency in which the fees are payable?** Generally, the fees referred to in **paragraph 5.184** are payable in the currency of the country in which the receiving Office is located. Complete information on this question is contained in **Annex C** and, for the search fee, in **Annex D**. [Rule 14.1(b) 15.2 16.1(b)]

***PCT AG-IP 5.187 What are the amounts of the fees?***

**PCT AG-IP 5.187 What are the amounts of the fees?** **Annex C** and, for the search fee, **Annex D** indicate the amounts of the fees referred to in **paragraph 5.184**. Where the applicant has the choice between two or more International Searching Authorities (see **paragraph 7.002**), the amount of the search fee depends on which International Searching Authority is chosen and indicated in Box No. VII of the **request form** (see **paragraphs 5.072** and **5.093**) and in the fee calculation sheet (see **paragraph 5.093**). For details on how to calculate the fee for sequence listings, see **paragraph 5.101**. [Rule 14.1(b) 15.2 16.1(a)]

***PCT AG-IP 5.188 What fee reductions are available?***

**PCT AG-IP 5.188 What fee reductions are available?** An applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below 3,000 US dollars (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997), or who is a national of and resides in one of the following States: Antigua and Barbuda, Bahrain, Barbados, the Libyan Arab Jamahiriya, Oman, the Seychelles, Singapore, Trinidad and Tobago and the United Arab Emirates, is entitled, in accordance with the **Schedule of Fees, item 4**, to a reduction of 90% of the international filing fee. In addition, an applicant who qualifies for the 90% reduction in the international filing fee will not have to pay the transmittal fee in respect of an international application filed with the International Bureau as receiving Office. The same applies (i.e. the 90% reduction in the international filing fee and no transmittal fee to be paid if filing is made with the International Bureau as receiving Office) for an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations. If there are several applicants, each must satisfy one or the other of the above-mentioned criteria. The reduction of those fees will be automatically available to any applicant so entitled on the basis of the indications of name, nationality and residence given in the request. The fee reduction will be available even if one or more of the applicants are not from PCT Contracting States, provided that each of them satisfies the above-mentioned criteria and that at least one of them is a national or resident of a PCT Contracting State and thus is entitled to file an international application. Information about PCT Contracting States whose nationals and residents are entitled to a reduction of 90% of the international filing fee, is contained in **Annex C** and, in particular **Annex C (IB)**. As far as other States are concerned, inquiries should be addressed to the International Bureau. It is to be noted that, if both the reduction for electronic filing of an international application and the 90% reduction of the international

filing fee are applicable, the 90% reduction is calculated after the reduction for electronic filing of an international application. [ ]

5.189. An applicant who files an international application is entitled to a reduction in the international filing fee provided that: [**Rule 89bis 89ter Sections 102(i) 102bis 702 707**]

(i) – the request is presented as a computer print-out prepared using the PCT-SAFE software (“request in PCT-EASY format”); – the request in PCT-EASY format is filed together with a computer diskette, prepared using the PCT-SAFE software, containing a copy in electronic form of the data contained in the request and of the abstract (“PCT-EASY physical medium”); and – the international application is filed with a receiving Office which is prepared to accept the filing of international applications containing the request in PCT-EASY format together with the PCT-EASY physical medium; or [ ]

(ii) the international application is filed in electronic form with a receiving Office which is prepared to accept the filing of international applications in electronic form and in compliance with **Part 7, Annex F** or the basic common standard. [ ]

The reduction is 100 Swiss francs or the equivalent in the currency in which the international filing fee is paid to the receiving Office in case (i) above. In case (ii) above, the reduction is 100 Swiss francs or the equivalent where the request and the text of the description, claims and abstract are not in character coded format, 200 Swiss francs or the equivalent where the request is in character coded format and the text of the description, claims and abstract is not in character coded format and is 300 Swiss francs or the equivalent where the request and the text of the description, claims and abstract are in character coded format. See **paragraphs 6.002, 6.007, 6.033 and 11.094 to 11.101** for further details about the use of the PCT-SAFE software or any other electronic filing software that has been specified by the receiving Office in accordance with **Annex F of the Administrative Instructions** or that complies with the basic common standard. [ ]

5.190. The international search fee payable to the **Austrian Office**, the **European Patent Office (EPO)** and the **Spanish Patent and Trademark Office**, as well as the preliminary examination fee payable to the **Austrian Office** and the **EPO**, are reduced by 75% under certain conditions (see **Annexes D** and, where applicable, **E**). [ ]

### ***PCT AG-IP 5.191 When are the fees due?***

**PCT AG-IP 5.191 When are the fees due?** All fees referred to in **paragraph 5.184** may be paid at the same time, and, if they are paid upon filing of the international application by the receiving Office, no problems can arise. However, all fees can be paid as much as one month from the date of receipt of the international application by the receiving Office. The dates on which payments are deemed to have been received are determined by the receiving Office. The latter applies the same rules as are applied in the case of payments for national applications. [**Rule 14 15.3 16.1(f)**]

### ***PCT AG-IP 5.192 What happens if the amounts of the fees are changed?***

**PCT AG-IP 5.192 What happens if the amounts of the fees are changed?** Where the amount of the international filing fee or of the search fee, in the currency in which the fee is payable, changes, the new amount must be paid as from the date of its entry into force. However, where the amount of any such fee changes between the date on which the international application was received and the date of payment, the amount payable is the amount applicable on the date of receipt of the international application. This system allows the applicant to pay all the fees for the international application, within the one-month period, on the basis of the amounts applicable on the date on which the application was filed with the receiving Office. [**Rule 15.3 16.1(f)**]

***PCT AG-IP 5.193 What happens if the fees are not paid or not paid in full?***

**PCT AG-IP 5.193 What happens if the fees are not paid or not paid in full?** Where, within the time they are due, the applicant has not paid any or all of the fees, the receiving Office invites the applicant to pay the missing amount, together with a late payment fee, within a time limit of one month from the date of the invitation. If the applicant pays the amount (including the late payment fee) specified in the invitation, the deficiency in payment has no consequences for the international application. The amount of the late payment fee is 50% of the missing amount or, if that 50% is less than the transmittal fee, an amount equal to the transmittal fee; but the amount of the late payment fee may not exceed the amount of 50% of the international filing fee referred to in **item 1 of the Schedule of Fees**, not taking into account any fee for each sheet of the international application in excess of 30 sheets (see **Annex C**). [**Rule 16bis.1 16bis.2**]

5.194. Where, within the time by which they are due, the applicant has not paid any or all of the fees, any payment relating to the missing amount must be considered to have been received within the time by which those fees are due, if the payment is received by the receiving Office before that Office sends the invitation, referred to in the preceding paragraph, to pay the missing amount. [ ]

5.195. If the transmittal fee, the international filing fee and the search fee are not paid in the prescribed currency and within the prescribed time limits, including the time limit set in the invitation from the receiving Office to pay the missing amount together with the late payment fee (see **paragraph 5.193**), the international application is considered withdrawn, and the receiving Office promptly informs the applicant accordingly. However, any payment must be considered to have been received before the expiration of the applicable time limit if it is received by the receiving Office before that Office makes the applicable declaration, under **Article 14(3)**, that the international application is considered withdrawn. [**Article 14(3) Rule 16bis.1(c) 27.1 29.1 Section 321**]

5.196. If the amounts paid do not cover the transmittal fee (if applicable), the international filing fee and the search fee (if applicable), the moneys paid will be allocated as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions by the receiving Office, which promptly notifies the applicant accordingly. [ ]

***PCT AG-IP 5.197 In what cases are fees refunded?***

**PCT AG-IP 5.197 In what cases are fees refunded?** There is no rule under the PCT concerning the possibility of asking for a refund of the transmittal fee. The search fee and the international filing fee are refunded where, due to prescriptions concerning national security, the international application is not treated as such, or where the receiving Office refuses to accord an international filing date to the international application under **Article 11(1)**. Such refusal occurs, generally speaking, where the international application is defective in certain respects (see **paragraph 6.005**). The receiving Office will also refund the international filing fee or the search fee to the applicant if the international application is withdrawn or considered withdrawn before the transmittal of the record copy to the International Bureau or the transmittal of the search copy to the International Searching Authority, as the case may be. [**Rule 15.4 16.2**]

5.198. Most International Searching Authorities will refund part or all of the search fee if the international application is withdrawn or considered withdrawn after transmittal of the search copy but before the start of the international search (see **Annex D**). Where the International Searching Authority must, under **Rule 41.1(i)**, or may, under **Rule 41.1(ii)**, take into account the results of the earlier search when carrying out the international search (see also **paragraph 5.073**), in accordance with **Rule 16.3**, the International Searching Authority must refund the search fee to the extent and under the conditions provided for in the agreement under **Article 16(3)(b)**. International Searching Authorities are free to decide the extent and conditions for such search fee reductions. [**Rule 16.3 41.1**]

5.199. For refunds or reductions of fees in the national phase, see **National Phase, paragraph 4.007** and **National Chapters** (Summaries). [ ]

## **PCT Appl. Guide - Int. Phase - 6. Processing of the IA by the rO**

### ***PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?***

**PCT AG-IP 6.001 What are the main procedural steps at the receiving Office?** The main procedural steps that any international application goes through at the receiving Office are the following: [ ]

- (i) the international application and the related fees are received by the receiving Office; [**Article 10**]
- (ii) the international application is checked by the receiving Office to determine whether it meets the requirements prescribed by the PCT as to the language, form and contents of international applications (the checks performed by the receiving Office are of a formal nature and do not go into the substance of the invention); [**Article 11(1) 14(1)(a)**]
- (iii) where the checks made by the receiving Office show that the international application does not meet certain requirements as to fees, language, form and contents, that Office invites the applicant to furnish the necessary corrections; [**Article 11(2)(a) 14(1)(b) Rule 20.1 20.3 26.1**]
- (iv) where – possibly after correction (see **paragraphs 6.024 to 6.053**) – the checks made by the receiving Office show that the international application meets the requirements prescribed for that purpose by the PCT, an international filing date is accorded to the international application by the receiving Office; [**Article 11(1) 11(2)(b) Rule 20.2**]
- (v) copies of the international application, its translation, where applicable, and other related documents are transmitted by the receiving Office to the International Searching Authority and to the International Bureau so that they may carry out the procedural steps for which they are responsible in the further processing of the international application. [**Article 12 Rule 22 23**]

### ***PCT AG-IP 6.002 What are the additional procedural steps at the receiving Office for processing a request form print-out prepared using the PCT-SAFE software?***

**PCT AG-IP 6.002 What are the additional procedural steps at the receiving Office for processing a request form print-out prepared using the PCT-SAFE software?** For those receiving Offices which have indicated that they are prepared to accept such requests, in addition to those procedural steps listed in **paragraph 6.001**, the receiving Office will review each request form print-out prepared using the PCT-SAFE software to ensure that: [**Rule 3.1 11 19 89ter**]

- (i) the request is presented as a computer print-out prepared using the PCT-SAFE software; [ ]
- (ii) the request is filed together with a computer diskette prepared using the PCT-SAFE software; and [ ]
- (iii) the computer diskette contains a copy in electronic form of the data contained in the request and the abstract. [ ]

See **paragraphs 5.189, 6.007, 6.033 and 11.094 to 11.101** for further details about the processing of requests prepared using the PCT-SAFE software. [ ]

***PCT AG-IP 6.003 How does the international application reach the receiving Office?***

**PCT AG-IP 6.003 How does the international application reach the receiving Office?** The international application may be deposited with or mailed to the receiving Office. It may also be filed by other means of rapid communication, notably by facsimile machine, provided that the receiving Office places such facilities at the disposal of applicants and that the original is furnished within 14 days, if so required by the receiving Office (see **Annexes B**). The requirements in relation to filing the international application and any subsequent documents by facsimile machine are explained in more detail in **paragraphs 11.067 to 11.070**. [**Rule 92.4**]

***PCT AG-IP 6.004 Is the international application treated as confidential by the receiving Office?***

**PCT AG-IP 6.004 Is the international application treated as confidential by the receiving Office?** Yes, it is. Third parties are not permitted to have access to the international application, unless requested or authorized by the applicant, before the date of international publication. Designated Offices are, however, permitted to publish the fact that they have been designated, together with a limited amount of bibliographic data. For further details as to confidentiality, see **Article 30** and **paragraphs 11.072 to 11.074**. [**Article 30**]

[ ]

***PCT AG-IP 6.005 What are the conditions that must be fulfilled for the international application to be entitled to an international filing date?***

**PCT AG-IP 6.005 What are the conditions that must be fulfilled for the international application to be entitled to an international filing date?** The receiving Office must accord an "international filing date" to the international application if it finds that the following conditions are fulfilled: [**Article 11(1) Rule 20.1 20.2**]

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office (see **paragraphs 5.008, 5.020 and 5.023**); [ ]

(ii) the international application is in the prescribed language (see **paragraph 6.006**); [ ]

(iii) the international application contains at least the following elements: [ ]

(a) an indication that it is intended as an international application, [ ]

(b) a request which constitutes the designation of a Contracting State bound by the PCT on the international filing date (under **Rule 4.9(a)** – see **paragraph 5.052**), [ ]

(c) the name of the applicant (for this purpose it is sufficient if the name of the applicant is indicated in a way which allows his identity to be established, even if the name is misspelled, or the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete), [ ]

(d) a part which on the face of it appears to be a description, [ ]

(e) a part which on the face of it appears to be a claim or claims. [ ]

**PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?**

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6.006. For the purposes of according an international filing date, the requirement that the international application be in a prescribed language is met, in most receiving Offices, if the description and claims (but not necessarily the other elements of the international application) are in a language accepted by the receiving Office under **Rule 12.1(a) and (c)** (see **Rule 20.1(c) and paragraph 5.013**). If any of the other elements of the international application are not in a language accepted by the receiving Office, they may be corrected later without affecting the international filing date (see **paragraphs 6.032 and 6.034**). A translation will need to be furnished by the applicant in respect of any international application which is filed in a language which is not a language accepted by the International Searching Authority which is to carry out the international search and/or a language of publication; see **paragraphs 6.013 to 6.020**). In certain Offices, however, **Rule 20.1(c)** is incompatible with the applicable national law. For as long as that incompatibility continues, that Rule will not apply for those Offices; all elements of an international application filed with those Offices as receiving Office must therefore comply with the language requirements of **Rule 12.1** before an international filing date can be accorded (see **Annex C** for details). [**Article 11(1)(ii) and (iii) Rule 12.1 20.1(c) and (d)**]

***PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?***

**PCT AG-IP 6.007 What is the effect of failing to file a paper copy of the international application when the request is prepared as a print-out using the PCT-SAFE software?** A PCT-EASY physical medium filed alone

– without any corresponding application papers – does not meet the requirements for according an international filing date. The paper form of the international application remains the legally determinative version. Thus, the paper form of the international application which accompanies a request prepared using PCT-SAFE must contain the required elements in order to receive an international filing date. See **paragraph 6.033** for further details about receiving an international filing date for requests prepared using the PCT-SAFE software. [**Article 11(1) Rule 3.1 11.3 20**]

***PCT AG-IP 6.008 What date is accorded as the international filing date?***

**PCT AG-IP 6.008 What date is accorded as the international filing date?** The reply to this question depends on whether the requirements for according an international filing date (see **paragraph 6.005**) were fulfilled on the date on which the international application was received by the receiving Office, or, pursuant to **Rule 20.6**, considered to have been received (see **paragraph 6.026 to 6.031**), or – following correction of defects in relation to those requirements – on a later date. The international filing date will, in the former case, be the date on which the international application was received by the receiving Office and, in the latter case, the date on which the correction was received by the receiving Office. Naturally, any correction has to comply with some conditions; in particular it has to be filed within a certain time limit. More is said about this in **paragraph 6.025**. Where all the sheets pertaining to the same international application are not received on the same day by the receiving Office, see **paragraph 6.026**. [**Article 11(1) 11(2)(b) Rule 20.1 20.2**]

***PCT AG-IP 6.009 Does non-payment, incomplete payment or late payment of fees influence the international filing date?***

**PCT AG-IP 6.009 Does non-payment, incomplete payment or late payment of fees influence the international filing date?** No, it does not, however, those defects will eventually lead the receiving Office to declare that the international application is considered withdrawn (see **paragraphs 5.195 and 5.196**). Although an international application which has not been accorded an international filing date and an international application which is considered withdrawn are both excluded from further processing in the international phase, an international application which fulfills the requirements

PCT AG-IP 6.010 Can the receiving Office refuse to treat an international application as such for reasons of national security?

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necessary for it to be accorded an international filing date may be invoked as a priority application under the **Paris Convention for the Protection of Industrial Property** (if the conditions laid down by that Convention are fulfilled) even where the international application is considered withdrawn under the PCT (for non-payment of fees or other reasons). [Article 11(3) 11(4) 14(3) Rule 27]

***PCT AG-IP 6.010 Can the receiving Office refuse to treat an international application as such for reasons of national security?***

**PCT AG-IP 6.010 Can the receiving Office refuse to treat an international application as such for reasons of national security?** Each Contracting State is free to apply measures deemed necessary for the preservation of its national security. For example, each receiving Office has the right not to treat an international application as such and not to transmit the record copy to the International Bureau and the search copy to the International Searching Authority. Compliance with national security prescriptions where the international application is filed with the International Bureau as receiving Office will not be checked by the International Bureau; such compliance is the applicant's responsibility. Where an international filing date has been accorded but national security considerations prevent transmittal of the record copy, the receiving Office must so declare to the International Bureau before the expiration of 13, or at the latest 17, months from the priority date. [Article 27(8) Rule 22.1 Section 330]

***PCT AG-IP 6.011 How does the applicant know whether his application has been accorded an international filing date or that his application is not treated as an international application or is considered to have been withdrawn?***

**PCT AG-IP 6.011 How does the applicant know whether his application has been accorded an international filing date or that his application is not treated as an international application or is considered to have been withdrawn?** Where the receiving Office accords an international filing date to the international application, it promptly notifies the applicant of that date and of the international application number; where it decides that the international application is not to be treated as an international application (because of a negative determination for lack of compliance with **Article 11**, or because national security considerations prevent it from being treated as such) or is to be considered withdrawn, it promptly notifies the applicant accordingly. [Rule 20.2 20.5(c) 20.4(i) 22.1 29.1(ii)]

***PCT AG-IP 6.012 Can an international filing date once accorded be “taken away”?***

**PCT AG-IP 6.012 Can an international filing date once accorded be “taken away”?** If, after having accorded an international filing date, the receiving Office finds that it should not have accorded it, the international application is considered withdrawn and the receiving Office so declares and promptly notifies the applicant. However, such a finding may validly occur only during the four months following the international filing date and must be preceded by a notification to the applicant of the intention to make the declaration which should, where applicable, also include an invitation to confirm the incorporation of missing elements in accordance with **Rule 20.6(a)**. The applicant has the right to submit arguments within two months from the notification or, where applicable, confirm the incorporation by reference of missing elements. For the rectification of errors made by the receiving Office in according the international filing date, see **Rule 82ter.1** and the **National Phase, paragraph 6.028**. [Article 14(4) Rule 29.1 29.4 30.1 82ter.1 Section 312]

[ ]

***PCT AG-IP 6.013 When is a translation of the international application required?***



PCT AG-IP 6.014 What are the translation requirements if the international application is filed in a language which is not accepted by the International Searching Authority?

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**PCT AG-IP 6.013 When is a translation of the international application required?** Every receiving Office must accept, for the purpose of filing international applications, at least one language which is both a language of publication and a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office. In addition, any receiving Office may accept one or more other languages for the purpose of filing international applications. A translation of the international application is required when the language in which the international application is filed is a language which is not a language of publication and/or a language accepted by the International Searching Authority which is to carry out the international search. [Rule 12.1]

***PCT AG-IP 6.014 What are the translation requirements if the international application is filed in a language which is not accepted by the International Searching Authority?***

**PCT AG-IP 6.014 What are the translation requirements if the international application is filed in a language which is not accepted by the International Searching Authority?** Where the language in which the international application is filed is not accepted by the International Searching Authority that is to carry out the international search, the applicant must furnish, to the receiving Office, a translation of the international application into a language which is both a language accepted by that Authority and a language of publication. Moreover, unless the international application was filed in a language of publication (see **paragraph 9.017**), the language into which the international application is translated must also be a language in which international applications may be filed with the receiving Office concerned. No translation is required of any sequence listing part of the description which complies with the standard provided for in **Annex C of the Administrative Instructions**. (Concerning translation of the request, see **paragraph 6.019**.) [Rule 12.3]

6.015. The translation of the international application must be furnished to the receiving Office within one month from the date on which the international application was received by that Office. Where, by the time the receiving Office notifies the applicant of the international application number and international filing date, the applicant has not furnished the required translation, the receiving Office will, preferably together with that notification, invite the applicant to furnish the required translation either within the time limit of one month from the date on which the international application was received by the receiving Office, or, in the event that the required translation is not furnished within that time limit, to furnish it and to pay, where applicable, the late furnishing fee (see **paragraph 6.017**), within one month from the date of the invitation or two months from the date of receipt of the international application by the receiving Office, whichever expires later. [ ]

6.016. Where the receiving Office has sent to the applicant an invitation to furnish the translation and, where applicable, pay the late furnishing fee, and the applicant has not done so within the applicable time limit, the international application will be considered withdrawn and the receiving Office will so declare. However, any translation and any payment which are received by the receiving Office before that Office makes the declaration that the international application is considered withdrawn, and before the expiration of 15 months from the priority date, will be considered to have been received before the expiration of the applicable time limit. [ ]

6.017. The late furnishing fee which any receiving Office may collect for translations which are furnished after the expiration of the time limit of one month from the date on which the international application is received by the receiving Office, is equal to 25% of the international filing fee referred to in **item 1 of the Schedule of Fees**, not taking into account any fee for each sheet of the international application in excess of 30 sheets. [ **Rule 12.3(e)**]

PCT AG-IP 6.018 What are the translation requirements if the abstract or text matter in the drawings of the international application are in a language which is different from the language of the description and claims?

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***PCT AG-IP 6.018 What are the translation requirements if the abstract or text matter in the drawings of the international application are in a language which is different from the language of the description and claims?***

**PCT AG-IP 6.018 What are the translation requirements if the abstract or text matter in the drawings of the international application are in a language which is different from the language of the description and claims?** If the abstract or text matter in the drawings of the international application is in a language which is different from the language of the description and claims, then the receiving Office will invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. However, no such invitation will be issued if the abstract or text matter in the drawings is in the language in which the international application is to be published, or if a translation of the international application is required because the language in which the international application was filed is not accepted by the International Searching Authority which is to perform the international search. [Rule 26.3ter(c)]

***PCT AG-IP 6.019 What are the translation requirements if the request is in a language which is not a language of publication accepted by the receiving Office for the purpose of filing the***

**PCT AG-IP 6.019 What are the translation requirements if the request is in a language which is not a language of publication accepted by the receiving Office for the purpose of filing the request?** Whatever the language in which the description and claims are filed, the request must always be filed in a language of publication accepted by the receiving Office for the purposes of filing the request. If the request is in a language which does not fulfill this requirement, the receiving Office invites the applicant to file a translation that complies with it. [Rule 12.1(c) 26.3ter(c)]

***PCT AG-IP 6.020 What are the translation requirements if the international application is filed in a language which is accepted by the International Searching Authority, but is not a language of publication?***

**PCT AG-IP 6.020 What are the translation requirements if the international application is filed in a language which is accepted by the International Searching Authority, but is not a language of publication?** If the international application is filed in a language which is not a language of publication but is a language accepted by the International Searching Authority which is to carry out the international search, the applicant must furnish to the receiving Office a translation of the international application into a language of publication which the receiving Office accepts for that purpose. No translation is required of any sequence listing part of the description which complies with the standard provided for in **Annex C of the Administrative Instructions**. (Concerning the translation of the request, see **paragraph 6.019**.) [Rule 12.4 48.3]

6.021. The translation of the international application must be furnished to the receiving Office within 14 months from the priority date. Where the applicant has not furnished the required translation within the applicable time limit, the receiving Office will invite the applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee (see **paragraph 6.023**), within 16 months from the priority date. [ ]

6.022. Where the receiving Office has sent to the applicant an invitation to furnish the translation and, where applicable, pay the late furnishing fee, and the applicant has not done so within the applicable time limit, the international application will be considered withdrawn and the receiving Office will so declare. However, any translation and any payment which are received by the receiving Office before that Office makes the declaration that the international application is considered

PCT AG-IP 6.024 What defects in the international application may be corrected and within what time limits?

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withdrawn, and before the expiration of 17 months from the priority date, will be considered to have been received before the expiration of the applicable time limit. [ ]

6.023. The late furnishing fee which any receiving Office may collect for translations which are furnished after the expiration of the time limit of 14 months from the priority date, is equal to 25% of the international filing fee referred to in **item 1 of the Schedule of Fees**, not taking into account any fee for each sheet of the international application in excess of 30 sheets. [ ]

[ ]

***PCT AG-IP 6.024 What defects in the international application may be corrected and within what time limits?***

**PCT AG-IP 6.024 What defects in the international application may be corrected and within what time limits?** The following paragraphs attempt to give general answers to those questions in the characteristic cases of possible defects. [ ]

***PCT AG-IP 6.025 What defects influence the international filing date?***

**PCT AG-IP 6.025 What defects influence the international filing date?** [ ]

(i) Where the receiving Office finds that the international application does not comply with the requirements for according an international filing date – in other words: [ ]

(a) that the applicant obviously lacks, for reasons of residence and nationality, the right to file an international application with the receiving Office (but see also **paragraphs 6.035 and 6.036**); [**Article 11(1)(i)**]

(b) that the international application does not contain an indication that it is intended as an international application; [**Article 11(1)(iii)(a)**]

(c) that the international application does not contain a request which constitutes the designation of all Contracting States bound by the PCT on the international filing date (under **Rule 4.9(a)** – see **paragraph 5.052**); [**Article 11(1)(iii)(b)**]

(d) that the international application does not contain the name of the applicant or does not contain at least the minimum indications concerning the name of the applicant which are indicated in **paragraph 6.005(iii)(c)**; [**Article 11(1)(iii)(c)**]

(e) that the international application does not contain a part which, on the face of it, appears to be a description and a part which, on the face of it, appears to be a claim or claims; [**Article 11(1)(iii)(d) and (e)**]

the receiving Office invites the applicant to correct the defect. The time limit for filing the correction is two months from the date of the invitation to correct. If the correction is made within the time limit, the date of receipt of the correction becomes the international filing date; otherwise, the application is not treated as an international application (but see also **paragraphs 6.035 and 6.036** in relation to the applicant's residence and nationality, and **paragraphs 6.013 to 6.020** for applications filed in a language which is accepted by the receiving Office but which is not both a language accepted by the International Searching Authority which is to carry out international searching, and a language of publication). Where the defect concerns item (i)(e) above, the receiving Office will invite the

PCT AG-IP 6.026 What happens if all sheets of the international application are not received on the same day?

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applicant to confirm in accordance with **Rule 20.6** that the missing element concerned was incorporated by reference under **Rule 4.18** (see **paragraphs 6.027 to 6.031**), in which case it may be possible to retain the earlier date as the international filing date. Where the required elements of the international application are not in a language accepted by the receiving Office, that Office will transmit the international application to the International Bureau as receiving Office under **Rule 19.4** (noting that the International Bureau as receiving Office is prepared to accept international applications filed in any language; see **paragraph 6.034** and **Annex C**). [**Article 11(1)(ii) Rule 19.4 20.3 20.6 20.7**]

(ii) Where the receiving Office finds that parts of the description, claims, all drawings or parts thereof are, or appear to be, missing, it notifies the applicant accordingly and invites the applicant to correct the defect or else, where appropriate, to confirm in accordance with **Rule 20.6** that the missing part was incorporated by reference under **Rule 4.18** (see **paragraph 6.027 to 6.031** for details). The time limit for furnishing such missing parts is two months from the date of the invitation. If there is no such invitation and if the applicant notices and wishes to correct the defect on his own initiative, this is also permitted within a time limit of two months from the date on which papers were first received by the receiving Office. If the missing parts are furnished within that time limit, the date of their receipt becomes the international filing date, unless the applicant is able to confirm in accordance with **Rule 20.6** that the missing part concerned was incorporated by reference under **Rule 4.18** (see **paragraphs 6.027 to 6.031**), in which case it may be possible to retain the earlier date as the international filing date. Where missing drawings referred to in the international application are not furnished within the time limit, any references to drawings in the international application are considered non-existent and the international filing date remains as originally accorded. Note, however, that, where the international filing date is corrected to a later date, any priority claim will be considered void, for the purposes of the procedure under the PCT, if the accorded international filing date falls outside the two month period after the expiration of the priority period of the priority claim concerned (see **paragraphs 5.060** and **6.038**). Where the international filing date has been corrected, the applicant may, in a notice submitted to the receiving Office within one month from the date of mailing of the notification of later submitted parts (**Form PCT/RO/126**), request that the missing part be disregarded in order to preserve the date on which papers were first received as the international filing date and, where applicable, to retain the priority claim (**Rule 20.5(e)**). [**Article 14(2) Rule 20.5(e) 20.7**]

***PCT AG-IP 6.026 What happens if all sheets of the international application are not received on the same day?***

**PCT AG-IP 6.026 What happens if all sheets of the international application are not received on the same day?** The receipt of further sheets after an invitation to correct has been sent under **Article 11(2)(a)** or **14(2)** (see **paragraph 6.025**) generally results in the date of receipt of those further sheets being accorded as the international filing date, provided that they are received within the applicable time limit under **Rule 20.7**, and unless the applicant is able to include these later submitted sheets by way of incorporation by reference (see **paragraphs 6.027 to 6.031**). If no invitation to correct has been sent but all the sheets relating to the same purported international application (apart from the abstract) are not received on the same day by the receiving Office, and the applicant has not confirmed the incorporation by reference of those later submitted sheets, the Office corrects the request by marking on it the date on which the papers completing the international application were received, and that later date is accorded as the international filing date, provided that the later sheets were received within two months from the date on which sheets were first received. Each sheet is marked with the date on which it was actually received. The absence or late receipt of the abstract does not, of itself, result in correction of the date marked on the request or in the according of a later international filing date. [**Rule 20.3(b) 20.5(b), (c) and (d) 20.7**]

PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?

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***PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?***

**PCT AG-IP 6.027 Can missing pages be added to an international application without affecting the international filing date?** This is possible under certain circumstances, but the resulting international filing date will not be recognized in some Contracting States (see **paragraph 6.031**). Under **Rule 4.18**, where an element of the international application referred to in **Article 11(1)(iii)(d)** or **(e)** or a part of the description, claims or drawings referred to in **Rule 20.5(a)** is not otherwise contained in the international application but is completely contained in the earlier application of which priority is claimed on the date on which one or more elements referred to in **Article 11(1)(iii)** were first received by the receiving Office, it is possible to incorporate by reference these missing elements or parts into the international application. Such incorporation by reference will have the effect that the elements or parts which have been incorporated by reference will be considered to have been received on the date on which one or more elements referred to in **Article 11(1)(iii)** were first received. As a result, the international filing date would remain the date when one or more elements referred to in **Article 11(1)(iii)** were first received (provided that all other **Article 11** requirements for the according of a filing date are met). These procedures do not apply if the receiving Office has notified the International Bureau under **Rule 20.8(a)** that any of **Rules 20.3(a)(ii)** and **(b)(ii)**, **20.5(a)(ii)** and **(d)**, and **20.6** are not compatible with its national law. Such a receiving Office will therefore neither invite nor accept a confirmation of the incorporation by reference. Instead, the receiving Office would apply the above described correction procedure (**paragraph 6.025**). A list of Offices which have notified the International Bureau under **Rule 20.8(a)** and which will therefore not accept the incorporation by reference of missing elements or parts can be found on WIPO's website at [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html#R\\_20\\_8\\_a](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html#R_20_8_a). If the need to incorporate certain missing elements or parts becomes apparent after the international application has been filed, the applicant may request the receiving Office to transmit the international application to the receiving Office of the International Bureau under **Rule 19.4(a)(iii)**, which does accept the incorporation by reference of missing elements or parts. [**Rule 19.4(a)(iii)** 20.3 20.5 20.8]

***PCT AG-IP 6.028 How should missing elements or parts be incorporated by reference into the international application?***

**PCT AG-IP 6.028 How should missing elements or parts be incorporated by reference into the international application?** A statement of incorporation by reference referred to in **Rule 4.18** must have been included in the international application on the date when one or more elements referred to in **Article 11(1)(iii)** are first received by the receiving Office. Such a statement is automatically included in the request if the latest version of **Form PCT/RO/101** or the latest version of the PCT-SAFE software is used. If such a statement was not contained in the request at the time of filing, it can only be added to the request if it was otherwise contained in, or submitted with, the international application on the date of filing. Furthermore, one or several priority claims to earlier applications which completely contain the missing element or part must have been made in the international application at the time of filing. Adding such priority claims under **Rule 26bis.1(a)** would not be sufficient. If these requirements have been met, the applicant should confirm the incorporation by reference by way of a written notice to the receiving Office within the time limit indicated below. Such notice should be accompanied by: [**Rule 4.18** 20.6]

- a sheet or sheets embodying the entire element or part as contained in the earlier application; [ ]
- where the applicant has not already complied with the requirements of **Rule 17.1(a)**, **(b)** or **b-bis**, a copy of the earlier application as filed; [ ]
- where **Rule 20.6(a)(iii)** applies, a translation or translations of the earlier application; and [ ]

PCT AG-IP 6.029 What is the time limit for confirming the incorporation by reference of missing elements or parts?

– in the case of a missing part, an indication as to where the missing part is contained in the earlier application and, where applicable, in any translation of the earlier application. [ ]

***PCT AG-IP 6.029 What is the time limit for confirming the incorporation by reference of missing elements or parts?***

**PCT AG-IP 6.029 What is the time limit for confirming the incorporation by reference of missing elements or parts?** Where no invitation by the receiving Office has been sent to submit missing elements or parts (**Form PCT/RO/103 or PCT/RO/107**), the time limit to confirm is two months from the date on which papers were first received by the receiving Office. Where such an invitation has been issued, the time limit to confirm is two months from the date of mailing of this invitation. If this time limit expires after the expiration of 12 months from the filing date of the earliest application, the priority of which is claimed, the receiving Office will draw this circumstance to the attention of the applicant (as a warning that, if the missing elements or parts are not confirmed to have been incorporated by reference and the international filing date is thus corrected to a date after the expiration of the priority period, the correction of the international filing date may result in the loss of the right of priority; the same applies, even if the missing elements or parts are confirmed to have been incorporated by reference, with regard to those States which do not apply the provisions concerning incorporation by reference (see **paragraph 6.031**)). For missing elements, any notice confirming the incorporation by reference of that missing element under **Rule 20.6(a)** received by the receiving Office after the expiration of this two-month time limit but before the Office has sent a notification under **Rule 20.4(i)** to the applicant, is considered to have been received within the time limit (**Rule 20.7(b)**). [**Rule 20.7**]

***PCT AG-IP 6.030 What are the consequences if the requirements for the incorporation by reference are not complied with?***

**PCT AG-IP 6.030 What are the consequences if the requirements for the incorporation by reference are not complied with?** If not all of the requirements for the incorporation by reference are fulfilled (for example, if a missing element or part is not entirely contained in the earlier application), the international application will be assigned a later international filing date (the date of receipt of the missing element or part, to the extent that all other requirements of **Article 11(1)** are complied with on that date) (see **paragraphs 6.025 and 6.026**). In the case of missing parts, the applicant may, however, request that the missing part be disregarded, in accordance with **Rule 20.5(e)**. [**Rule 20.3(b)(i) 20.4 20.5(c) 20.5(e)**]

***PCT AG-IP 6.031 What are the effects of the successful incorporation of missing elements or parts on designated or elected Offices?***

**PCT AG-IP 6.031 What are the effects of the successful incorporation of missing elements or parts on designated or elected Offices?** In most Contracting States, the elements or parts will be treated as if they had actually been contained in the international application as originally filed. Designated and elected Offices may, to a limited extent, review decisions by receiving Offices which have allowed incorporation by reference (**Rule 82ter.1(b)**). If the designated or elected Office finds that: the applicant did not comply with its obligation to furnish a priority document; the statement of incorporation was missing or not submitted with the request; no written notice confirming incorporation by reference was submitted; no required translation was furnished; or the element or part in question was not completely contained in the priority document; then the designated or elected Office may treat the international application as if the international filing date had been accorded on the basis of the date on which the sheets containing the missing elements or parts were submitted, but only after giving the applicant the opportunity to make observations on this outcome and/or to request that, at least, the missing parts which had been furnished be disregarded, in accordance with **Rule 82ter.1(d)**. [**Rule 20.8(c) 82ter.1**]

However, those designated Offices which have submitted notifications of incompatibility under **Rule 20.8(b)**, may treat the international application as if the international filing date had been accorded on the basis of the date on which the sheets containing the missing elements or parts were submitted, but also only after having given the applicant the opportunity to make observations on this outcome and/or to request that, at least, the missing parts which had been furnished be disregarded, pursuant to **Rule 20.8(c)**. [ ]

***PCT AG-IP 6.032 What defects do not influence the international filing date?***

**PCT AG-IP 6.032 What defects do not influence the international filing date?** Where the receiving Office finds that [ ]

(i) the international application is not signed (or, in the cases referred to in **paragraph 5.091**, does not bear a seal; see also **paragraphs 11.027 to 11.032** for cases where an applicant refuses to sign or cannot be found or reached); [**Article 14(1)(a)(i) Rule 2.3 4.1(d) 4.15**]

(ii) the international application does not contain the name of the applicant presented in the prescribed way (other than those referred to in **paragraph 6.005(iii)(c)**, for which case see **paragraph 6.025(i)(d)**), or the prescribed indications in respect of at least one of the applicants – these indications are specified in **Rules 4.4 and 4.5**; they include, in particular, the applicant's address, residence and nationality; [**Article 14(1)(a)(ii) Rule 4.4 4.5**]

(iii) the international application does not contain a title (that is, a title for the claimed invention); [**Article 14(1)(a)(iii) Rule 4.3**]

(iv) the international application does not contain an abstract; [**Article 14(1)(a)(iv) Rule 8**]

(v) the international application and, where applicable, the translation of the international application, does not comply, to the extent provided for in the Regulations, with the prescribed physical requirements (the physical requirements are specified in detail in **Rule 11**; compliance with them must be checked only to the extent that such compliance is necessary for the purpose of reasonably uniform international publication, and no international application will be considered withdrawn for lack of such compliance if it complies to the extent necessary for the purpose of reasonably uniform international publication); [**Article 14(1)(a)(v) Rule 11 26.3**]

(vi) any element of the international application, other than the description and claims, is not in an admitted language (see **paragraphs 5.013, 6.005(ii) and 6.006**); [**Article 3(4)(i) Rule 12.1 26.3ter(a)**]

the receiving Office invites the applicant to correct the defect (however, regarding international applications which are filed in a language which is accepted by the receiving Office but require translation, see **paragraphs 6.013 to 6.020**). The time limit for filing the correction is two months from the date of the invitation. If the correction is made within the time limit (including any extension – see **paragraph 6.037**), the international filing date remains the date on which the international application was received by the receiving Office; otherwise, the international application is considered withdrawn. In certain Offices, however, the provisions of **Rule 26.3ter(a)** for correction of elements not in an accepted language are incompatible with the applicable national law. For as long as that incompatibility continues, that Rule will not apply for those Offices; all elements of an international application filed with those Offices as receiving Office must therefore comply with the language requirements of **Rule 12.1** before an international filing date can be accorded (see also **paragraph 6.006** and see **Annex C** for details). [**Article 14(1)(b) Rule 26.1 26.2 26.2bis(b) 26.3ter(b) 26.5 29.1**]

PCT AG-IP 6.033 What defects in request form print-outs prepared using the PCT-SAFE software do not affect the international filing date?

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***PCT AG-IP 6.033 What defects in request form print-outs prepared using the PCT-SAFE software do not affect the international filing date?***

**PCT AG-IP 6.033 What defects in request form print-outs prepared using the PCT-SAFE software do not affect the international filing date?** The following defects in requests prepared using the PCT-SAFE software do not affect the international filing date: [Article 11(1) Rule 89ter Section 102(i) 102bis]

- (i) the request in PCT-SAFE format is filed without the PCT-EASY physical medium; [ ]
- (ii) the PCT-EASY physical medium does not contain an abstract; or [ ]
- (iii) the PCT-EASY physical medium, accompanying a paper copy of the request, is defective or incomplete. [ ]

These defects may render the applicant ineligible to receive the fee reduction under **Schedule of Fees, item 4(a)**. However, if the applicant furnishes, before the receiving Office transmits the record copy to the International Bureau, a PCT-EASY physical medium which is not defective and which contains the required indications, the applicant is eligible to receive the fee reduction although he did not provide the diskette at the time of filing the application. See **paragraph 5.189** for further information on the fee reduction associated with PCT-SAFE; see **paragraph 6.002** for further details on the processing of request form print-outs prepared using the PCT-SAFE software. [ ]

***PCT AG-IP 6.034 What happens if the application is filed in a language which is not accepted by the receiving Office?***

**PCT AG-IP 6.034 What happens if the application is filed in a language which is not accepted by the receiving Office?** If the international application is filed in a language which is not a language accepted by the national (or regional) Office with which it is filed, but is in a language accepted by the International Bureau as receiving Office, that international application will be considered to have been received by that Office on behalf of the International Bureau as receiving Office. In fact, the International Bureau as receiving Office accepts international applications filed in any language (see **Annex C**). In such a case, the international application will be date-stamped by the national (or regional) Office concerned and promptly transmitted to the International Bureau (unless this is prevented by national security prescriptions). That transmittal may be subjected to the payment of a fee equal to the transmittal fee (see **paragraph 5.184(i)** and **Annex C**), but other fees paid will be refunded by the national (or regional) Office to the applicant and the applicable fees will then have to be paid to the International Bureau as receiving Office (see **Annex C**). The international application so transmitted will be considered to have been received by the International Bureau as receiving Office on the date on which it was received by the national (or regional) Office, except that, for the purposes of calculating the time limits for paying the fees due on filing the international application to the competent receiving Office, the date of receipt of the international application is considered to be the date on which the international application was actually received by the International Bureau as receiving Office. [Rule 19.4(a)(ii), (b) and (c)]

***PCT AG-IP 6.035 What happens if the applicant is a resident or national of a Contracting State but files the application with a “non-competent” receiving Office?***

**PCT AG-IP 6.035 What happens if the applicant is a resident or national of a Contracting State but files the application with a “non-competent” receiving Office?** If the international application is erroneously filed with a national (or regional) Office which acts as a receiving Office under the Treaty by an applicant who is a resident or national of a Contracting State, but that Office is not



competent under **Rule 19.1** or **19.2** (having regard to the applicant's residence and nationality) to receive the international application, the international application will be considered to have been received by the Office with which it was filed on behalf of the International Bureau as receiving Office (see **paragraphs 5.008** and **5.009**). In such a case, the international application will be date-stamped by the national (or regional) Office concerned and promptly transmitted to the International Bureau (unless this is prevented by national security prescriptions). That transmittal may be subjected by the national Office to the payment of a fee equal to the transmittal fee (see **paragraph 5.184(i)** and **Annex C**), but other fees paid will be refunded by the national Office to the applicant and the applicable fees will then have to be paid to the International Bureau as receiving Office (see **Annex C (IB)**). The international application so transmitted will be considered to have been received by the International Bureau as receiving Office on the date on which it was received by the national (or regional) Office, except that, for the purposes of calculating the time limits for paying the fees due on filing the international application, the date of receipt of the international application is considered to be the date on which the international application was actually received by the International Bureau as receiving Office. [**Rule 19.4(a)(i), (b) and (c)**]

***PCT AG-IP 6.036 May the applicant correct indications of residence and nationality?***

**PCT AG-IP 6.036 May the applicant correct indications of residence and nationality?** If the indications of the applicant's residence and nationality as stated in the request do not support the applicant's right to file an international application (see **paragraphs 5.020, 5.023** and **6.005(i)**), that is, if the applicant appears not to be (or, where there are two or more applicants, none of the applicants appears to be) a resident or national of a Contracting State, there is *prima facie* a defect under **Article 11(1)(i)** and the receiving Office issues an invitation accordingly to correct that defect (see **paragraph 6.025(i)(a)**). In such a case, it may be that the applicant is able to show that he had, on the date on which the international application was actually received by the receiving Office, the right to file an international application with that receiving Office. In those circumstances, the applicant should submit evidence to the receiving Office accordingly, together with a proposed correction of the indications concerning his residence and/or nationality. If the receiving Office is satisfied, on the basis of that evidence, of the applicant's right to file the international application, the invitation to correct the defect under **Article 11(1)(i)** will be considered to be an invitation to correct a defect under **Article 14(1)(a)(ii)** and **Rule 4.5** in the prescribed indications concerning the applicant's residence and/or nationality, and the indications may be corrected accordingly. If such a correction is made, no defect will be considered to exist under **Article 11(1)(i)**, and the defect will thus not prevent the accordance of the actual date of receipt of the international application as the international filing date. Note, however, that the **United States Patent and Trademark Office** as receiving Office has stated that it will not apply the procedure outlined above. [**Article 11(1)(i) 14(1)(a)(ii) Rule 4.5 Section 329**]

***PCT AG-IP 6.037 Can time limits to correct certain defects be extended?***

**PCT AG-IP 6.037 Can time limits to correct certain defects be extended?** The time limit of two months for the correction of defects under **Article 14(1)** (see **paragraph 6.032**) may be extended by the receiving Office. The receiving Office may extend the time limit *ex officio* or at the request of the applicant at any time – even after the time limit fixed in the invitation has expired – before a decision is taken on whether the applicant has submitted the correction within the time limit and whether or not the international application so corrected is to be considered withdrawn. On the other hand, the time limits fixed by the receiving Office for the correction of defects under **Article 11** or **Article 14(2)** (see **paragraph 6.025**) and for the payment of missing or underpaid fees under **Rule 16bis** (see **paragraphs 5.193** and **5.195**) may not be extended. [**Rule 26.2**]

***PCT AG-IP 6.038 Can defects in priority claims be corrected?***

**PCT AG-IP 6.038 Can defects in priority claims be corrected?** Any defective priority claim may be corrected and any missing priority claim added by a notice which may be submitted to the receiving Office or the International Bureau. The time limit for correcting or adding a priority claim is 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16 month period expires first, provided that a notice correcting or adding a priority claim may in any event be submitted until the expiration of four months from the international filing date. If a correction of a priority claim is received before the receiving Office or the International Bureau, as the case may be, declares the priority claim void (see **paragraph 6.043**) and not later than one month after the expiration of the applicable time limit, it is considered to have been received before the expiration of that time limit. To correct a priority claim, any indication relating to that priority claim may be changed, added or deleted. [**Rule 26bis.1(a) 26bis.2(b)**]

6.039. Where the applicant has made a request for early publication of the international application, any notice to correct or add a priority claim received by the receiving Office or the International Bureau after that request was made will be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed. [ ]

6.040. Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired will be computed from the priority date as so changed. [**Rule 26bis.1(c)**]

***PCT AG-IP 6.041 Can the applicant be invited to correct defects in a priority claim?***

**PCT AG-IP 6.041 Can the applicant be invited to correct defects in a priority claim?** Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim that; [**Rule 26bis.2**]

(i) the international application has an international filing date which is later than the date on which the priority period expired and that no request for restoration of the right of priority has been submitted; [ ]

(ii) the priority claim does not comply with the requirements of **Rule 4.10** (see **paragraph 5.057**); or [ ]

(iii) any indication in a priority claim is not the same as the corresponding indication appearing in the priority document; [ ]

the receiving Office or the International Bureau, as the case may be, will invite the applicant to correct the priority claim. [ ]

6.042. Where the defect consists of the fact that the filing date of the international application is outside the priority period but is within two months from the date on which the priority period expired, the receiving Office also informs the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with **Rule 26bis.3** (see **paragraphs 5.062 to 5.069**), except where the receiving Office has notified the International Bureau under **Rule 26bis.3(j)** of the incompatibility of **Rule 26bis.3(a) to (i)** with the national law applied by that Office. [**Rule 26bis.2(a) 26bis.3**]

6.043. If the applicant fails to respond to an invitation from the receiving Office or the International Bureau to correct a priority claim before the expiration of the time limit for doing so, that priority claim will, for the purposes of the procedure under the Treaty, be considered void and the receiving Office or the International Bureau, as the case may be, will so declare and inform the applicant accordingly. However, a priority claim will not be considered void only because the indication of the

**PCT AG-IP 6.045 Can defects in declarations referred to in Rule 4.17 be corrected? Can declarations be added?**

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number of the earlier application is missing, an indication in the priority claim is not the same as the corresponding indication appearing in the priority document, or 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. [**Rule 26bis.2(c)**]

6.044. Where the receiving Office or the International Bureau has made a declaration that a priority claim will be considered void, for the purposes of the procedure under the PCT, or where the priority claim has only not been considered void because **Rule 26bis.2(c)** applies (see last sentence of **paragraph 6.043**), the International Bureau will publish, together with the international application, information concerning the priority claim, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Where the applicant wishes to correct or add a priority claim but the time limit to do so under **Rule 26bis.1** has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee (see **Section 113(c) of the Administrative Instructions**), request the International Bureau to publish information concerning the matter. [**Rule 26bis.2(d) 26bis.2(e)** ]

***PCT AG-IP 6.045 Can defects in declarations referred to in Rule 4.17 be corrected? Can declarations be added?***

**PCT AG-IP 6.045 Can defects in declarations referred to in Rule 4.17 be corrected? Can declarations be added?** Any defective declaration may be corrected and any new (missing) declaration may be added by a notice submitted to the International Bureau by the applicant, either in response to an invitation to correct (see **paragraph 6.046**) or on his own initiative. The time limit for correcting or adding a declaration is 16 months from the priority date. Any correction or addition which is received by the International Bureau after that time limit is considered to have been received on the last day of the time limit if it reaches the International Bureau before the technical preparations for international publication have been completed. [**Rule 26ter.1**]

***PCT AG-IP 6.046 Which are the defects in declarations made under Rule 4.17 in respect of which the applicant may be invited to submit a correction?***

**PCT AG-IP 6.046 Which are the defects in declarations made under Rule 4.17 in respect of which the applicant may be invited to submit a correction?** Where the receiving Office or the International Bureau finds that any declaration contained in the request appears to be defective or incomplete, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within the time limit referred to in **paragraph 6.045**. The kinds of defects which may give rise to an invitation are, for example, the fact that a declaration does not contain the standardized wording as prescribed, or that the blank spaces have not been filled in with names, dates, etc., furthermore, in respect of the declaration of inventorship for the purposes of the designation of the United States of America, that it is not signed as prescribed. [**Rule 26ter.2(a)**]

***PCT AG-IP 6.047 How should a correction or addition of a declaration referred to in Rule 4.17 be presented?***

**PCT AG-IP 6.047 How should a correction or addition of a declaration referred to in Rule 4.17 be presented?** Any correction or addition of a declaration must be made by way of a notice consisting of the corrected or added declaration itself accompanied by a letter explaining the correction or addition. Such notice should be submitted directly to the International Bureau in all cases, even if that notice is in response to an invitation issued by the receiving Office. Any notice nevertheless submitted to the receiving Office will be date stamped by that Office and transmitted to the International Bureau. [**Section 216 317**]

PCT AG-IP 6.049 What happens when the applicant fails to correct a declaration referred to in Rule 4.17 ?

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6.048. In the case of a corrected declaration, the applicant must submit a replacement sheet, using the relevant Box (amongst Boxes Nos. VIII (i) to (v)). In the case of an added declaration, the applicant may either use the relevant sub-box mentioned above or a blank sheet of paper. Any corrected or added declaration of inventorship for the purposes of the designation of the United States of America should be signed and dated by the inventor and should be entitled "Supplemental declaration of inventorship (**Rules 4.17(iv)** and **51bis.1(a)(iv)**". [**Section 214(c)**]

***PCT AG-IP 6.049 What happens when the applicant fails to correct a declaration referred to in Rule 4.17 ?***

**PCT AG-IP 6.049 What happens when the applicant fails to correct a declaration referred to in Rule 4.17 ?** The International Bureau will publish declarations, either as originally filed, or as corrected, whether or not they comply with **Rule 4.17**. Furthermore, an indication about the fact that declarations were made will be included in the front page of the published international application. [**Rule 48.2(b)(iv)**]

***PCT AG-IP 6.050 What happens where the International Bureau receives a correction or addition of a declaration referred to in Rule 4.17 after the applicable time limit?***

**PCT AG-IP 6.050 What happens where the International Bureau receives a correction or addition of a declaration referred to in Rule 4.17 after the applicable time limit?** Where the International Bureau receives a correction or addition of a declaration after the applicable time limit (see **paragraph 6.045**), it will notify the applicant accordingly. It does not publish that declaration, or communicate that declaration to the designated Office(s), but informs the applicant that any such declaration should be submitted directly by him to the designated Office(s) concerned. In the case of a declaration of inventorship signed by at least one of the inventors, the International Bureau will return the declaration to the applicant. [**Rule 26ter.1 Section 419(c)**]

***PCT AG-IP 6.051 Is the receiving Office the only authority which may note any of the above defects during the international phase?***

**PCT AG-IP 6.051 Is the receiving Office the only authority which may note any of the above defects during the international phase?** If, in the opinion of the International Bureau or the International Searching Authority, the international application is not signed as provided in the **Regulations** by at least one of the applicants, or does not contain the name of the applicant presented in the prescribed way, or the prescribed indications in respect of at least one of the applicants, or does not comply to the extent provided in the Regulations with the prescribed physical requirements, the International Bureau or the International Searching Authority, as the case may be, brings such defects to the attention of the receiving Office. Unless that Office believes that there is no defect, it must then invite the applicant to correct it, within a time limit of two months from the date of the invitation (see **paragraph 6.032**). [**Rule 28 29.3**]

***PCT AG-IP 6.052 How should a correction be presented?***

**PCT AG-IP 6.052 How should a correction be presented?** The correction must generally be filed in the form of one or more replacement sheets incorporating the correction and accompanied by a letter. The letter accompanying a replacement sheet must explain the differences between the replacement sheet and the one it replaces. Correction by letter without replacement sheets is possible only for corrections of the request where the correction is of such a nature that it can be transferred from the letter to the request or other part of the record copy without any adverse effect on the clarity

and the direct reproducibility of the sheet onto which the correction is to be transferred. As to the signature and other requirements of such letters, see **Rule 92.1** [**Rule 26.4 92.1**]

***PCT AG-IP 6.053 Does a correction entail the payment of a fee?***

**PCT AG-IP 6.053 Does a correction entail the payment of a fee?** Both the request for and the making of any correction are free of charge. There is also no fee for the extension of a time limit for correction (see **paragraph 6.037**). [ ]

***PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?***

**PCT AG-IP 6.054 Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office?** The PCT does not expressly provide for any appeal or petition during the international phase. However, practice has shown that receiving Offices reconsider their decisions on petition, and that some national courts or appeal boards have accepted appeals against decisions taken by national (or regional) Offices in their capacity as receiving Offices. However, the latter possibility, even where the applicant is successful in obtaining a revision of the decision of the receiving Office in his favor, may remain without effect in the States designated in the international application, particularly when the applicant has not performed the acts required under **Article 22(1)**, **39(1)(a)** or **25** within the applicable time limit. [ ]

6.055. The PCT provides for the review by designated Offices of any decision of the receiving Office refusing to accord an international filing date or declaring that the international application is considered withdrawn. (For details of the procedure, including the time limit for requesting such review, see **National Phase, paragraphs 6.018 to 6.021.**) [**Article 25 Rule 29.1 51**]

***PCT AG-IP 6.056 Can failure to meet a time limit in the proceedings before the receiving Office or a delay in furnishing documents to that Office be excused?***

**PCT AG-IP 6.056 Can failure to meet a time limit in the proceedings before the receiving Office or a delay in furnishing documents to that Office be excused?** The PCT provides that any Contracting State must, as far as that State is concerned, excuse, for reasons allowed by the national law, any delay in meeting any time limit. Moreover, any Contracting State may, as far as it is concerned, excuse for other reasons any delay in meeting any time limit. Finally, any designated Office may maintain the effect of an international application (see **paragraphs 5.003 to 5.007**), even where the decision of the receiving Office to the effect that the international application, or the designation of the State concerned, is considered withdrawn is found to be correct. (For details, see **National Phase, paragraph 6.021.**) [**Article 24(2) 48(2) Rule 82bis**]

[ ]

***PCT AG-IP 6.057 How does the record copy reach the International Bureau?***

**PCT AG-IP 6.057 How does the record copy reach the International Bureau? What are the consequences if it does not reach the International Bureau within the prescribed time limit?** The record copy (see **paragraph 5.180**), which incidentally is, for the purposes of the procedure under the PCT, considered the true copy of the international application, must reach the International Bureau in time because, if the record copy has not been received by that Bureau within the prescribed time limit, the international application is considered withdrawn. However, no international application is considered withdrawn in such a case without the applicant having been informed beforehand (see **paragraph 6.058**). Failure to transmit the record copy does not relieve the applicant of the obligation

PCT AG-IP 6.058 How does the International Bureau monitor the receipt of the record copy?

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to enter the national phase before the designated Offices within the applicable time limit (see **National Phase, paragraphs 6.022 to 6.027**). [Article 12(2) 12(3) 22(1) 24(1)(ii) and (iii) Rule 22.1 22.3]

***PCT AG-IP 6.058 How does the International Bureau monitor the receipt of the record copy?***

**PCT AG-IP 6.058 How does the International Bureau monitor the receipt of the record copy?**

The International Bureau, once informed by the receiving Office of the international application number and of the international filing date, monitors the receipt of the record copy. If the International Bureau has not received the record copy within 13 months from the priority date, it urges the receiving Office to send it. If, one month later, the record copy has still not been received, the International Bureau notifies the applicant of the fact. The applicant can then ask the receiving Office either to transmit the record copy or to issue – and this must be done free of charge – a certified copy of the international application which he can himself transmit to the International Bureau. Only after the expiration of three months from the above-mentioned notification from the International Bureau to the applicant may the International Bureau make the finding that no record copy has been received within the prescribed time limit. Thus the applicant will always have been warned and offered the possibility of taking care of the transmittal of the record copy himself before any loss of rights can occur. The certification of a copy of the international application must be made free of charge in such a case, and may be refused only in certain cases (for instance where national security considerations prevent the international application from being treated as such; for details, see **Rule 22.1(e)**). [Rule 20.2(c) 22.1(e)]

***PCT AG-IP 6.059 How does the search copy reach the International Searching Authority?***

**PCT AG-IP 6.059 How does the search copy reach the International Searching Authority?** The search copy (see **paragraph 5.180**) is transmitted by the receiving Office to the International Searching Authority. The search copy is only transmitted if the international search fee has been fully paid to the receiving Office (see **paragraphs 5.184(ii), 5.193, 5.195 and 5.198**), and, where the international application was filed in a language not accepted by the International Searching Authority, only after the required translation has been furnished (see **paragraph 5.181**). Therefore, it is in the applicant's interests to pay the search fee promptly, and, where applicable, furnish the translation promptly, in order to avoid any delay in establishment of the international search report. The International Searching Authority notifies the International Bureau, the applicant and the receiving Office of the fact and date of receipt of the search copy. [Article 12(1) Rule 12.1(c) 23.1 25.1]

***PCT AG-IP 6.060 Can the applicant obtain certified copies of the international application?***

**PCT AG-IP 6.060 Can the applicant obtain certified copies of the international application?** On payment of a fee, the receiving Office must furnish to the applicant, at his request, certified copies of the international application as filed and of any corrections to it. The certified copy of the international application is the priority document where the applicant claims the priority of that international application. For copies of priority documents referred to in the international application, see **paragraph 5.070**. [Rule 21.2]

## **PCT Appl. Guide - Int. Phase - 7. Int Search Procedure by ISA**

### ***PCT AG-IP 7.001 What are the main procedural steps before the International Searching Authority?***

**PCT AG-IP 7.001 What are the main procedural steps before the International Searching Authority?** The main procedural steps that any international application goes through before the International Searching Authority are the following: [Article 15 18 Rule 43 43bis.1]

- (i) conducting the international search, [ ]
- (ii) preparing the international search report, and [ ]
- (iii) establishing a written opinion. [ ]

### ***PCT AG-IP 7.002 Which International Searching Authority is competent?***

**PCT AG-IP 7.002 Which International Searching Authority is competent?** Each receiving Office (except the International Bureau as receiving Office – see **paragraph 5.008**) specifies one or more International Searching Authorities as competent to carry out international searches on international applications filed with it. For some receiving Offices, different International Searching Authorities are competent depending on the language in which the international application is filed or, where the international application is filed in a language accepted by the receiving Office but not by the International Searching Authority, translated. Where several International Searching Authorities are specified as competent by the receiving Office, the applicant may choose between them (subject to any such language restriction). **Annex C** indicates the International Searching Authority or Authorities specified as competent by each receiving Office, and the languages in which international applications filed with that Office are accepted for international search by those Authorities. Where the international application is filed with the International Bureau as receiving Office, the competent International Searching Authority (or Authorities) is that (or are those) which would have been competent if the international application had been filed with a competent national (or regional) Office as receiving Office. All of the languages accepted for search by each International Searching Authority are set out in **Annex D**. Where two or more International Searching Authorities are competent to carry out the international search, the applicant must indicate the Authority of his choice in the **request form** (see **paragraph 5.072**) and should also indicate it in the fee calculation sheet (see **paragraphs 5.093** and **5.187**). Finally, within the framework of the respective agreements relating to the functioning of certain Offices as International Searching Authorities, these Authorities may provide for limitations of their competence in respect of certain international applications. The consolidated texts of these Agreements are available on the WIPO website at the following address: [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html). For more detailed information, see **Annex D**. [Article 16 Rule 4.14bis 35]

### ***PCT AG-IP 7.003 What is the purpose of the international search?***

**PCT AG-IP 7.003 What is the purpose of the international search?** The purpose of the international search is to discover relevant prior art. “Prior art” consists of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations); it is “relevant” in respect of the international application if it can help determine whether or not the claimed invention is new, whether or not it involves an inventive

**PCT AG-IP 7.004 What documents are searched by the International Searching Authority?**

step (in other words, whether it is or is not obvious), and whether the making available to the public occurred prior to the international filing date (for further details, see **Rule 33**). The international search is made on the basis of the claims, with due regard to the description and the drawings (if any) contained in the international application. The results of the international search are set out in the international search report (see **paragraphs 7.023 to 7.026**). [**Article 15(4) Rule 33**]

***PCT AG-IP 7.004 What documents are searched by the International Searching Authority?***

**PCT AG-IP 7.004 What documents are searched by the International Searching Authority?** The International Searching Authority must endeavor to discover as much of the relevant prior art as its facilities permit, and it must in any case consult the so-called “minimum documentation.” Roughly stated, the latter comprises the published patent documents issued after 1919 by France, by Germany from 1920 to 1945 and by the Federal Republic of Germany since 1945, by Japan (for International Searching Authorities other than the **Japan Patent Office**, only those documents for which English abstracts are generally available), by the former Soviet Union and now by the Russian Federation (for International Searching Authorities other than the **Federal Service on Intellectual Property, Patents and Trademarks (Russian Federation)** only those documents for which English abstracts are generally available), by Switzerland (except documents in Italian), by the United Kingdom, by the United States of America, by the African Intellectual Property Organization (**OAPI**), by the African Regional Intellectual Property Organization (**ARIPO**), by the **Eurasian Patent Office** and by the **European Patent Office**; published international (PCT) applications; and, from various dates, about 135 technical periodicals. It is emphasized, however, that, where the International Searching Authority has more than the “minimum documentation” at its disposal, it is obliged also to consult that additional documentation to the extent permitted by its facilities. [**Article 15(4) Rule 34.1**]

[ ]

***PCT AG-IP 7.005 What special requirements apply during the international search to a nucleotide and/or amino acid sequence listing?***

**PCT AG-IP 7.005 What special requirements apply during the international search to a nucleotide and/or amino acid sequence listing?** Where the International Searching Authority finds that an international application contains disclosure of one or more nucleotide and/or amino acid sequences and that the listing of such sequences complying with the standard provided for in **Annex C of the Administrative Instructions** (see **paragraph 5.099**) has not already been furnished (either as part of the international application or separately for the purposes of international search – see **paragraphs 5.100 and 5.102**), that Authority may invite the applicant to furnish a listing complying with this standard. The listing required by the International Searching Authority is for the purpose of carrying out the international search; the application of the requirements of national law in relation to disclosure of inventions involving a sequence listing is a matter for the national phase of processing. [**Rule 5.2 13ter.1 Section 208 513(a)**]

***PCT AG-IP 7.006 Can the International Searching Authority require a sequence listing to be provided in electronic form?***

**PCT AG-IP 7.006 Can the International Searching Authority require a sequence listing to be provided in electronic form?** If the International Searching Authority finds that the applicant has not already furnished a sequence listing in electronic form complying with the standard provided for in **Annex C of the Administrative Instructions**, it may invite the applicant to furnish a listing to it in such a form. [**Rule 13ter.1(a) 13ter.1(b) Section 208**]



***PCT AG-IP 7.007 What electronic formats for sequence listings are acceptable?***

**PCT AG-IP 7.007 What electronic formats for sequence listings are acceptable? Paragraph 40, Annex C of the Administrative Instructions** requires that the entire printable copy of the sequence listing in electronic form must be contained within one electronic file on an electronic carrier that is acceptable to the competent International Searching Authority. The file must be encoded as a text file using IBM Code Page 437, IBM Code Page 932 (both of which are *de facto* standards for personal computers), or a compatible code page to represent the sequence listing with no other codes included (IBM is a registered trademark of International Business Machines Corporation, United States of America). A compatible code page, as would be required for, for example, Japanese, Chinese, Cyrillic, Arabic, Greek or Hebrew characters, is one that assigns the Roman alphabet and numerals to the same hexadecimal positions as do the specified code pages. [Section 208 Annex C of the Administrative Instructions]

***PCT AG-IP 7.008 Does the International Bureau recommend any software for the preparation of sequence listings in electronic format?***

**PCT AG-IP 7.008 Does the International Bureau recommend any software for the preparation of sequence listings in electronic format?** The electronic form of a sequence listing should preferably be created by dedicated software such as “PatentIn” (see **paragraph 5.104**). [ ]

7.009. The diskette or any other electronic carrier that is acceptable to the competent International Searching Authority must have a label permanently affixed thereto on which has been typed, or hand-printed in block capitals, the name of the applicant, the title of the invention, a reference number, the date on which the data were recorded, the computer operating system and the name of the competent Authority. If the diskette or any other electronic carrier that is acceptable to the competent Authority is submitted after the date of filing of an application, the labels must also include the filing date of the application and the application number. [Annex F, Appendix IV, 2.(f) of the Administrative Instructions]

***PCT AG-IP 7.010 What is the procedure for furnishing a sequence listing upon invitation?***

**PCT AG-IP 7.010 What is the procedure for furnishing a sequence listing upon invitation?** An invitation from the International Searching Authority to furnish a sequence listing complying with the standard provided for in **Annex C to the Administrative Instructions** (see **paragraphs 7.005 to 7.008**), will specify a time limit for response to the invitation. The furnishing of a sequence listing in response to the invitation may be subjected by the International Searching Authority to the payment of a late furnishing fee. The amount of the late furnishing fee shall be determined by the International Searching Authority but shall not exceed 25% of the international filing fee referred to in **item 1 of the Schedule of Fees** (excluding any fee paid for each sheet of the international application in excess of 30). Any sequence listing furnished by the applicant must be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed. If the applicant does not comply within that time limit, the search undertaken by the International Searching Authority may be restricted (see **paragraph 7.013**). [Rule 13ter.1(a) 13ter.1(b) 13ter.1(c) 13ter.1(d)]

***PCT AG-IP 7.011 Does a sequence listing furnished to the International Searching Authority form part of the international application?***

**PCT AG-IP 7.011 Does a sequence listing furnished to the International Searching Authority form part of the international application?** Any sequence listing, furnished separately to the International Searching Authority, is used only for the purposes of the international search and does

PCT AG-IP 7.012 Will a sequence listing furnished to the International Searching Authority also meet any requirements of the International Preliminary Examining Authority or, in the national phase, of a designated Office?

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not form part of the international application. Nevertheless, once the international application has been published, any such sequence listing will be made available for public inspection by the International Bureau on PATENTSCOPE

([www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf)). [Rule 13ter.1(e)]

***PCT AG-IP 7.012 Will a sequence listing furnished to the International Searching Authority also meet any requirements of the International Preliminary Examining Authority or, in the national phase, of a designated Office?***

**PCT AG-IP 7.012 Will a sequence listing furnished to the International Searching Authority also meet any requirements of the International Preliminary Examining Authority or, in the national phase, of a designated Office?** The same requirements in relation to sequence listings for the purposes of international search apply during international preliminary examination (see **paragraph 10.063**). The International Preliminary Examining Authority may, for example, invite the applicant to furnish to it a sequence listing in electronic form complying with the standard provided for in **Annex C of the Administrative Instructions** for the purposes of international preliminary examination. Concerning designated Offices, no designated Office may require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the **Annex C of the Administrative Instructions**. If a designated Office finds that a sequence listing does not comply with the standard provided for in the Administrative Instructions and/or are not in a electronic form provided for in the Administrative Instructions, it may invite the applicant to furnish a listing complying with those requirements (see **National Chapters**). [Rule 13ter.2]

[ ]

***PCT AG-IP 7.013 May the International Searching Authority refuse to search certain subject matter?***

**PCT AG-IP 7.013 May the International Searching Authority refuse to search certain subject matter?** The International Searching Authority is not required to perform an international search on claims which relate to any of the following subject matter: (i) scientific and mathematical theories, (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes, (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games, (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods, (v) mere presentation of information, and (vi) computer programs to the extent that the Authority is not equipped to search prior art concerning such programs. However, certain International Searching Authorities do, in practice, search these fields to varying extents – for example, several International Searching Authorities search subject matter which is normally searched under the national (or regional) procedure (for details, see **Annex D**). In addition, the International Searching Authority is not required to search the international application, to the extent that a meaningful search cannot be carried out, in certain cases where a nucleotide and/or amino acid sequence listing is not furnished in accordance with the prescribed standard or in an electronic form (see **paragraphs 7.005 to 7.012**). If the International Searching Authority is not required to search any of the claims, it may declare that it will not establish an international search report. It should, nevertheless, be noted that the lack of an international search report in such a case does not, in itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues. In respect of the possibility for the International Searching Authority to limit its competence, see **paragraph 7.002**. [Article 17(2)(a)(i) and (b) Rule 13ter.1(d) 39.1]

PCT AG-IP 7.014 May the International Searching Authority refuse to search international applications which are unclear or have other defects?

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***PCT AG-IP 7.014 May the International Searching Authority refuse to search international applications which are unclear or have other defects?***

**PCT AG-IP 7.014 May the International Searching Authority refuse to search international applications which are unclear or have other defects?** If the International Searching Authority considers that the description, the claims or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out, it may declare that it will not establish a search report (such a declaration may also be made in respect of some of the claims only). This may in particular occur where the description or the claims are unclear. The lack of an international search report does not, of itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues. Where only some of the claims are found to be “unsearchable,” the International Searching Authority will not search them but will search the rest of the international application. The same may apply in the case of multiple dependent claims which do not comply with the manner of drafting provided for in the second and third sentences of **Rule 6.4(a)** (see **paragraph 5.113**). [**Article 17(2)(a)(ii)** and **(b) Rule 6.4(a)**]

[ ]

***PCT AG-IP 7.015 What is the purpose of the requirement of “unity of invention”?***

**PCT AG-IP 7.015 What is the purpose of the requirement of “unity of invention”?** The search fee (see **paragraph 5.184(ii)** and **Annex D**) is intended to compensate the International Searching Authority for carrying out an international search on the international application, but only where the international application meets the requirement of “unity of invention.” That means that the international application must relate to only one invention or must relate to a group of inventions which are so linked as to form a single general inventive concept. The requirement of unity of invention is explained in detail in **paragraphs 5.114 to 5.123**. [**Article 17(3)(a) Rule 13**]

***PCT AG-IP 7.016 What happens where the International Searching Authority considers that the international application does not meet the requirement of unity of invention?***

**PCT AG-IP 7.016 What happens where the International Searching Authority considers that the international application does not meet the requirement of unity of invention?** If the International Searching Authority finds that the international application does not meet the requirement of unity of invention, it invites the applicant to pay additional fees, specifying the reasons for its finding and indicating the number of additional fees to be paid. The invitation will also invite the applicant to pay, where applicable, and will indicate the amount of, the protest fee as referred to in **Rule 40.2(e)**. Such additional fees are payable directly to the International Searching Authority within one month from the date of the invitation. **Annex D** indicates the amount of the additional search fee per additional invention charged by each International Searching Authority. [**Article 17(3)(a) Rule 13 40.1 40.2(a)** and **(b) 40.2(e)**]

7.017. When the International Searching Authority invites the applicant to pay additional fees, it may annex to the invitation the results of a partial international search limited to the invention first mentioned in the claims (the relevant claims are identified in the invitation). The results of such a partial search will be included in the international search report when it is established, together with the results of the search of any further invention for which the applicant pays additional fees within the time limit fixed in the invitation. [ ]

7.018. The International Searching Authority establishes the international search report in any case on those parts of the international application which relate to the “main invention,” that is, the invention – or group of inventions so linked as to form a single general inventive concept – first mentioned in the claims. Moreover, the International Searching Authority establishes the international search report also on those parts of the international application which relate to any invention – or any group of inventions so linked as to form a single general inventive concept – in respect of which the applicant has paid the additional fee within the time limit fixed in the invitation. [Article 17(3)(a) Rule 13]

***PCT AG-IP 7.019 May the applicant protest against payment of the additional fees?***

**PCT AG-IP 7.019 May the applicant protest against payment of the additional fees?** Yes, any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the number of the required additional fees is excessive. Any such protest is examined by a review body constituted in the framework of the International Searching Authority, and a decision is taken on it. To the extent that the applicant’s protest is found to be justified, the additional fee is totally or partly reimbursed. At the request of the applicant, the texts of both the protest and the decision on it are notified to the designated Offices together with the international search report. [Rule 40.2(c) and (d)]

7.020. Where the applicant pays additional fees under protest, the International Searching Authority may also require the applicant to pay a fee for the examination of the protest (“protest fee”). Details of the protest fee, if any, charged by the International Searching Authorities appear in **Annex D**. Where the applicant has not, within one month from the date of the invitation to pay additional fees, paid any required protest fee, the protest shall be considered not to have been made and the International Searching Authority shall so declare. [Rule 40.1 40.2(e)]

***PCT AG-IP 7.021 What happens if the applicant does not pay the additional fees as invited?***

**PCT AG-IP 7.021 What happens if the applicant does not pay the additional fees as invited?** Where, within the prescribed time limit, the applicant does not pay all the additional fees indicated by the International Searching Authority, but pays only some of them, or does not pay any additional fee at all, certain parts of the international application are not searched by that Authority. The lack of an international search report in respect of those parts of the international application does not, of itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues in respect of all claims. Nevertheless, the national law of any designated State may provide that such unsearched parts of the international application will be considered withdrawn as far as that State is concerned unless a special fee is paid by the applicant to its national Office. There are only a few Offices which apply such provisions. Details of special fees are given in the respective **National Chapters**. [Article 17(3)(b)]

[ ]

***PCT AG-IP 7.022 What happens if the International Searching Authority finds that the title of the invention or the abstract is missing or defective?***

**PCT AG-IP 7.022 What happens if the International Searching Authority finds that the title of the invention or the abstract is missing or defective?** In such cases, and in certain circumstances, it is the International Searching Authority which eventually establishes an appropriate title or abstract. For details, see **Rules 37, 38 and 44.2**, and **paragraph 5.173**. [Rule 37 38 44.2]

[ ]

***PCT AG-IP 7.023 When must the international search report be established?***

**PCT AG-IP 7.023 When must the international search report be established?** The international search report must be established within three months from the receipt of the search copy by the International Searching Authority (see **paragraph 6.059**) or nine months from the priority date, whichever time limit expires later. [**Article 18(1) Rule 42**]

***PCT AG-IP 7.024 What are the contents of the international search report?***

**PCT AG-IP 7.024 What are the contents of the international search report?** The international search report contains, among other things, the citation of the documents considered relevant, the classification of the subject matter of the invention (according to the International Patent Classification) and an indication of the fields searched (those fields being identified by a reference to their classification) as well as any electronic data base searched (including, where practicable, the search terms used). Citations of particular relevance must be indicated specially. Citations which are not relevant to all the claims must be indicated in relation to the claim or claims to which they are relevant. If only certain passages of the document cited are relevant or particularly relevant, they must be identified, for example by an indication of the page on which, or the column or lines in which, the passage appears. It is important to note that an international search report must not contain any expression of opinion, reasoning, argument or explanation of any kind whatsoever. For full details, see **Rule 43**. [**Rule 43**]

***PCT AG-IP 7.025 How do the applicant and the International Bureau receive the international search report?***

**PCT AG-IP 7.025 How do the applicant and the International Bureau receive the international search report?** The International Searching Authority transmits on the same day one copy of the international search report (or, where none is established, a declaration to that effect – see **paragraphs 7.013 and 7.014**) and the written opinion established by it to the applicant and to the International Bureau. The latter publishes the international search report with the published international application (see **paragraph 9.015**) and sends a copy to the designated Offices. [**Article 18(2) Rule 44.1**]

***PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?***

**PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?** The applicant can obtain copies of the documents cited in the international search report by requesting them from the International Searching Authority. Certain International Searching Authorities, however, transmit such copies automatically without extra charge to the applicant, together with the international search report. **Annex D** indicates those International Searching Authorities and indicates for the other Authorities the fees charged for furnishing copies on request. [**Article 20(3) Rule 44.3**]

[ ]

7.027. In respect of every international application filed on or after 1 January 2004, the International Searching Authority will establish, at the same time that it establishes the international search report or the declaration referred to in **Article 17(2)(a)**, a preliminary and nonbinding written opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be

PCT AG-IP 7.026 How can the applicant obtain copies of the documents cited in the international search report?

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industrially applicable, very similar in scope to the written opinion established by the International Preliminary Examining Authority during international preliminary examination. [**Rule 43bis.1(a)**]

7.028. The relevant date for determining prior art for the purposes of establishing the written opinion is the international filing date or, where priority of an earlier application is claimed, the priority date – this date is different from that used in establishing the international search report but is consistent with the date used in international preliminary examination. The written opinion of the International Searching Authority is established in the language in which the international search report is established, and is communicated to the applicant and to the International Bureau together with the international search report or the declaration referred to in **Article 17(2)(a)**. [**Rule 44.1**]

7.029. The International Searching Authority must, as a rule, establish the international search report and the written opinion within three months from the receipt of the search copy sent to it by the receiving Office or within nine months from the priority date, whichever expires later. [ ]

7.030. Even though no special provisions are included in the **Regulations** providing for the applicant to comment on the written opinion of the International Searching Authority, in accordance with the decision of the PCT Assembly, applicants may submit comments on an informal basis to the International Bureau. The purpose of such informal comments is to give the applicant an opportunity to rebut the written opinion of the International Searching Authority in the event that international preliminary examination is not requested. Any formal response to the written opinion of the International Searching Authority must be submitted directly to the International Preliminary Examining Authority under **Article 34** as part of the procedure under **Chapter II**. [ ]

7.031. If no international preliminary examination report has been or will be established, the written opinion of the International Searching Authority will form the basis for the issuance by the International Bureau, on behalf of the International Searching Authority, of the international preliminary report on patentability (IPRP) (**Chapter I**) which will be communicated to all designated Offices, together with any informal comments submitted by the applicant. The international preliminary report on patentability (Chapter I) is made available for public inspection after the expiration of 30 months from the priority date. [**Rule 44bis 44ter** ]

7.032. If a demand for international preliminary examination is filed in respect of an international application, the written opinion which has been established by the International Searching Authority will, in general, be used by the International Preliminary Examining Authority as its own first written opinion, unless the International Preliminary Examining Authority notifies the International Bureau to the contrary. [**Rule 43bis.1(c) 66.1bis** ]

## **PCT Appl. Guide - Int. Phase - 8. Supplementary International Search**

### ***PCT AG-IP 8.001 What is supplementary international search?***

**PCT AG-IP 8.001 What is supplementary international search?** Supplementary international search permits the applicant to request, in addition to the international search carried out under **Article 15(1)** (the “main international search”, as explained in **Chapter 7**), one or more supplementary international searches each to be carried out by an International Authority (the “Authority specified for supplementary search”) other than the International Searching Authority that carries out the main international search. [**Rule 45bis**]

### ***PCT AG-IP 8.002 What are the benefits of supplementary international search for the applicant?***

**PCT AG-IP 8.002 What are the benefits of supplementary international search for the applicant?** Requesting supplementary international search reduces the risk of new prior art being cited in the national phase. The increasing diversity of prior art in different languages and different technical fields means that the Authority carrying out the main international search is not always capable of discovering all of the relevant prior art. Requesting one or more supplementary international searches, during this early phase of the patent prosecution, expands both the linguistic and technical scope of the search. In addition, it may also be possible to have the supplementary search carried out in a State where they are likely to enter the national phase later on. [ ]

### ***PCT AG-IP 8.003 Which authorities can be requested to carry out a supplementary international search?***

**PCT AG-IP 8.003 Which authorities can be requested to carry out a supplementary international search?** Only an International Searching Authority that has stated its preparedness to carry out supplementary international searches (see **Annex SISA**) and which is not the International Searching Authority that carried out the main international search, can be requested to carry out a supplementary international search. [**Rule 45bis.1(e)** **45bis.9(b)**]

### ***PCT AG-IP 8.004 Does each Authority offer the same supplementary international search service?***

**PCT AG-IP 8.004 Does each Authority offer the same supplementary international search service?** The Authorities prepared to offer supplementary international searches may specify any limitations and conditions on this service in their agreement with the International Bureau (see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)). These limitations may include limitations as to the subject matter for which supplementary searches will be carried out, beyond those limitations that can be evoked in respect of the main international search (see **paragraphs 7.013** and **7.014**), and limitations as to the total number of supplementary international searches which will be carried out in a given period (see **Annex SISA**). [**Rule 45bis.9(a)** and (c)]

### ***PCT AG-IP 8.005 When should the request for a supplementary search be filed?***

**PCT AG-IP 8.005 When should the request for a supplementary search be filed?** In many cases, requests for supplementary search will be filed once the applicant has received the main international search report. In any event, the applicant must file a request for a supplementary international search prior to the expiration of 19 months from the priority date. If the request is received after the

expiration of this time limit, it will be considered not to have been submitted and there are no provisions to extend this time limit. [Rule 45bis.1(a) 45bis.1(e)(i)]

[ ]

***PCT AG-IP 8.006 Is there a form to request supplementary search?***

**PCT AG-IP 8.006 Is there a form to request supplementary search?** To facilitate preparation of the supplementary search request, the International Bureau has made available Form **PCT/IB/375** “Supplementary Search Request” in PDF editable format on WIPO’s website (instructions on how to complete and save the editable form are also available at: [www.wipo.int/pct/en/forms/instructions.htm](http://www.wipo.int/pct/en/forms/instructions.htm)). This form should be completed in accordance with indications in the Notes attached to the form. While use of this form is optional, it is highly recommended. [Rule 45bis.1(b) Section 102(f) and (g)]

8.007. If the applicant wishes more than one supplementary international search to be carried out, a separate request, preferably using Form **PCT/IB/375**, should be submitted for each supplementary international search requested. [Rule 45bis.1(a)]

***PCT AG-IP 8.008 Where and how should a supplementary search request be filed?***

**PCT AG-IP 8.008 Where and how should a supplementary search request be filed?** A supplementary search request must be filed with the International Bureau and not with the Authority specified for supplementary search. The International Bureau will transmit the request to the Authority specified for supplementary search once it has verified that all formal requirements have been complied with. [Rule 45bis.1(b) 45bis.4(e)]

***PCT AG-IP 8.009 In which language should the supplementary search request be filed?***

**PCT AG-IP 8.009 In which language should the supplementary search request be filed?** The supplementary search request should be filed in either English or French. [Rule 92.2(d) Section 104]

***PCT AG-IP 8.010 What is the language of correspondence with the International Bureau in connection with supplementary international search?***

**PCT AG-IP 8.010 What is the language of correspondence with the International Bureau in connection with supplementary international search?** Any correspondence between the applicant and the International Bureau should be in English or French, at the choice of the applicant, provided that it should be in the same language as the international application – if the latter was filed in English or French. [Rule 92.2(d) Section 104]

***PCT AG-IP 8.011 How should the Authority specified for supplementary search be identified?***

**PCT AG-IP 8.011 How should the Authority specified for supplementary search be identified?** The Authority specified for supplementary search should be identified, by an indication of the name or two-letter code of the Authority at the top of the first sheet of the supplementary search request form. [Rule 45bis.1(b)(ii)]



PCT AG-IP 8.012 Which documents, other than the supplementary search request must be submitted?

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***PCT AG-IP 8.012 Which documents, other than the supplementary search request must be submitted?***

**PCT AG-IP 8.012 Which documents, other than the supplementary search request must be submitted?** Where neither the language in which the international application was filed, nor the language in which a translation (if any) has been furnished for the purposes of main international search or international publication, is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority must be submitted together with the request. Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the applicant, if so required, should preferably furnish a copy of the sequence listing in electronic form (complying with the standard provided for in **Annex C** of the Administrative Instructions) to the International Bureau together with the supplementary search request. [Rule 13ter.1 45bis.1(c)]

[ ]

***PCT AG-IP 8.013 How should the international application be identified?***

**PCT AG-IP 8.013 How should the international application be identified?** The applicant should clearly identify the international application by its international application number, international filing date (for the date format, see **paragraph 5.061**) and title, as provided for in Box No. I. If a new title has been established by the International Searching Authority, that title should be indicated. [Rule 45bis.1(b)(i) Section 109 110]

8.014. Where the international application claims the priority of several earlier applications, the filing date of the earliest application, whose priority is claimed, should be indicated as the priority date. A file reference not exceeding 12 characters may also be indicated, if desired by the applicant. [ ]

[ ]

***PCT AG-IP 8.015 How should the applicant be identified?***

**PCT AG-IP 8.015 How should the applicant be identified?** The applicant should be identified by the indication of his name and address in Box No. II. The requirements for the indication of the name and address of the applicant are the same as those for the request form (PCT/RO/101) (see **paragraphs 5.025 to 5.034**). [Rule 45bis.1(b)(i)]

8.016. Where there are two or more applicants, only one needs to be indicated for the purposes of requesting supplementary search. It is recommended that the applicant who will represent all the applicants, and to whom notifications are to be sent, be indicated. If an agent or a common representative is indicated in Box No. III of the request, notices will be sent to that agent or common representative (see also **paragraphs 11.015 to 11.017**). [ ]

***PCT AG-IP 8.017 How can the applicant receive notifications via e-mail?***

**PCT AG-IP 8.017 How can the applicant receive notifications via e-mail?** If the applicant has authorized either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail, by marking the corresponding check-box in Box No. II of the supplementary search request form, the International Bureau and the Authority specified for supplementary search may, if they wish to do so, send such notifications to the applicant, thus avoiding processing or postal delays. Where the agent or common representative has also provided e-mail authorization, the International Bureau and the Authority specified for supplementary search will

**PCT AG-IP 8.018** How is an agent appointed for the purposes of the procedure before the Authority specified for supplementary search?

send e-mail communications only to the appointed agent or common representative (see **paragraph 8.018**). Note that not all Authorities will send such notifications by e-mail (see **Annex B**). If an e-mail notification is followed by the official notification on paper, only the paper copy of the notification is considered to be the legal copy of the notification and only the date of mailing of the paper copy will commence any time limit within the meaning of **Rule 80**. Where the applicant requests the sending of notifications exclusively by e-mail, the date of mailing indicated on the electronic copy will commence any time limit within the meaning of **Rule 80**. It is the applicant's responsibility to keep any e-mail address details up-to-date and to ensure that incoming e-mails are not blocked, for any reason, on the recipient's side. Changes to the e-mail address indicated should be requested to be recorded, preferably directly at the International Bureau, under **Rule 92bis**. [**Rule 4.4(c)**]

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***PCT AG-IP 8.018*** *How is an agent appointed for the purposes of the procedure before the Authority specified for supplementary search?*

**PCT AG-IP 8.018** How is an agent appointed for the purposes of the procedure before the Authority specified for supplementary search? The appointment of an agent to represent the applicant for the purposes of all procedures during the international phase, including the procedure before the Authority specified for supplementary search, may be made in Box No. IV of the request form (**PCT/RO/101**) or in a separate power of attorney submitted to the receiving Office (see also **paragraphs 5.041 to 5.046** and **11.001 to 11.014**). [**Rule 45bis.1(b)(i) 90.1 90.2 90.4 90.5**]

8.019. Where, however, an agent is to be appointed specifically for the purposes of the procedure before the Authority specified for supplementary search, this should be indicated in Box No. III of the supplementary search request form and the form signed by the applicant. [ ]

8.020. The appointment of an agent may also be made in a separate power of attorney signed by the applicant. The indications in Box III or in a separate power of attorney must include the name and address of the agent (see **paragraphs 5.025 to 5.029**). It is recommended that the agent's telephone number, facsimile number and/or e-mail address also be indicated. It is also recommended that where an agent is registered with the Office, that is acting as the Authority specified for supplementary search, the number or other indication under which the agent is so registered should be included.

**Model powers of attorney** are available in editable PDF format on the WIPO website. Any separate power of attorney must be submitted to the Authority specified for supplementary search if the appointment was made specifically for the purposes of the procedure before that Authority. Where a general power of attorney authorizes an agent to represent the applicant before the Office, which acts as the Authority specified for supplementary search, and the appointment was made specifically for the purposes of the procedure before that Authority, the general power of attorney must be deposited with the said Authority. The Authority specified for supplementary search may waive the requirement that a separate power of attorney or a copy of the general power of attorney be submitted to it (see **Annex SISA**). [ ]

***PCT AG-IP 8.021*** *How can an agent receive notifications via e-mail?*

**PCT AG-IP 8.021** How can an agent receive notifications via e-mail? If the check-box in Box No. III is marked indicating that either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail is authorized, the International Bureau and the Authority specified for supplementary search may, if they wish to do so, send such notifications to the agent or common representative at the indicated e-mail address, thus avoiding processing or postal delays (see **paragraph 8.017**). [**Rule 4.4(c)**]

***PCT AG-IP 8.022*** *What is the address for correspondence?*

PCT AG-IP 8.023 Where should the language, for the purposes of supplementary international search, be indicated?

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**PCT AG-IP 8.022 What is the address for correspondence?** Where an agent is appointed specifically for the purposes of the procedure before the Authority specified for supplementary search, all notifications issued by that Authority will be addressed only to that agent. Otherwise, correspondence will be sent to the agent appointed previously or to the common representative, as the case may be. However, where no agent or common representative is appointed and the applicant wishes correspondence to be sent to a different address other than that indicated in Box No. II, he may indicate that address in Box No. III. In such cases, the last check-box of Box No. III must be marked. However, the last check-box must not be marked if either of the check-boxes “agent” or “common representative” in Box No. III has been marked. [Section 108]

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***PCT AG-IP 8.023 Where should the language, for the purposes of supplementary international search, be indicated?***

**PCT AG-IP 8.023 Where should the language, for the purposes of supplementary international search, be indicated?** The applicant should indicate the language, for the purposes of supplementary international search, in Box IV and whether that language is that of the international application as originally filed, or of any translation furnished to the receiving Office under **Rule 12.3** or **12.4**. Where neither the language in which the international application was filed, nor the language in which a translation (if any) has been furnished under **Rule 12.3** or **12.4**, is accepted by the Authority specified for supplementary search, a translation of the international application, into a language, which is accepted by that Authority, must be furnished together with the request. In such cases, the last check-box concerning language should be marked. Where more than one of the above applies, the applicant may indicate, which language version is to form the basis of the supplementary international search, by marking the corresponding check-box. [Rule 45bis.1(b)(iii)]

***PCT AG-IP 8.024 When and how may the applicant select certain inventions to be searched?***

**PCT AG-IP 8.024 When and how may the applicant select certain inventions to be searched?** Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the applicant may choose, among the several inventions, which invention he wishes to be searched by the Authority specified for supplementary search. If he wishes to limit the supplementary international search to an invention, other than the main invention referred to in **Article 17(3)(a)**, he may indicate this wish by marking the last check-box in Box No. IV of the supplementary search request form, and state the corresponding numbers of the claims relating to this invention in the space provided. Where the international search report is available to the Authority specified for supplementary search before it starts the supplementary international search, it may, however, exclude from the search any claims which were not the subject of the main international search. [Rule 45bis.1(d) 45bis.5(d)]

[ ]

***PCT AG-IP 8.025 What is the purpose of the check list?***

**PCT AG-IP 8.025 What is the purpose of the check list?** Box No. V should be completed by the applicant to allow the International Bureau to verify the completeness of the documents accompanying the supplementary search request and, in particular, to check whether a translation of the international application and a sequence listing, where indicated in the respective check-boxes, are actually received. [ ]

[ ]

***PCT AG-IP 8.026 Who must sign the supplementary search request?***

**PCT AG-IP 8.026 Who must sign the supplementary search request?** The supplementary search request must be signed by one of the applicants or by the appointed agent. It should be noted, however, that additional signatures may be required for withdrawal of the supplementary search request (see **paragraphs 11.048 to 11.061**). [Rule 90.3(a) 92.1]

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***PCT AG-IP 8.027 What are the Notes to the supplementary search request form?***

**PCT AG-IP 8.027 What are the Notes to the supplementary search request form?** The Notes to the supplementary search request form are intended to facilitate the completion of that form. They indicate, in relation to each Box of that form, what indications are required and how they are to be made. The Notes are not required to be submitted with the supplementary search request. [ ]

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***PCT AG-IP 8.028 What is the fee calculation sheet?***

**PCT AG-IP 8.028 What is the fee calculation sheet?** The fee calculation sheet is intended to help the applicant calculate the total amount of fees payable to the International Bureau. The sheet is usually annexed to the supplementary search request form (see **8.006**). It is strongly recommended that the applicant complete the fee calculation sheet and submit it to the International Bureau. This will help the International Bureau to verify the fee calculations and identify any errors. The Notes to the fee calculation sheet provide details about completion of the sheet. For more information about the payment of fees generally, see **paragraphs 5.184 to 5.199**. [ ]

[ ]

***PCT AG-IP 8.029 Which fees must be paid by the applicant?***

**PCT AG-IP 8.029 Which fees must be paid by the applicant?** Two fees must be paid for supplementary international search: (i) the supplementary search fee for the benefit of the Authority specified for supplementary search; and (ii) the supplementary search handling fee for the benefit of the International Bureau. The supplementary search fee charged by each Authority varies and is fixed by the Authority in its agreement with the International Bureau (see **[www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)** and **Annex SISA**). The supplementary search handling fee is fixed by the PCT Assembly and listed in the **Schedule of Fees** annexed to the PCT Regulations (See **Annex B(IB)**). Applicants from certain States may be entitled to a 90% reduction of this fee (see the Notes to the fee calculation sheet (**PCT/RO/101**) for more information). [Rule 45bis.2(a) 45bis.3(a)]

***PCT AG-IP 8.030 When must the applicable fees be paid?***

**PCT AG-IP 8.030 When must the applicable fees be paid?** Both the supplementary search fee and the supplementary search handling fee must be paid to the International Bureau within one month from the date of receipt of the supplementary search request. If they are not paid in full within that time limit, a late payment fee will become due (see Form **PCT/IB/377**). If the fees remain unpaid, the

PCT AG-IP 8.031 In which currencies may fees for supplementary international search be paid?

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International Bureau will consider the request not to have been submitted. [Rule 45bis.2(b) and (c) 45bis.3(b) and (c) 45bis.4(c) and (d)]

***PCT AG-IP 8.031 In which currencies may fees for supplementary international search be paid?***

**PCT AG-IP 8.031 In which currencies may fees for supplementary international search be paid?** Payment of fees will only be accepted in Swiss francs. The amount payable is the amount applicable on the date of payment. [ ]

***PCT AG-IP 8.032 Can fees already paid be refunded in some circumstances?***

**PCT AG-IP 8.032 Can fees already paid be refunded in some circumstances?** If, before the International Bureau has transmitted the relevant documents to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted, the International Bureau will refund both the supplementary search fee and the supplementary search handling fee to the applicant. If, before the Authority specified for supplementary search has started the search, the supplementary search request is considered not to have been submitted, that Authority will refund the supplementary search fee to the applicant in accordance with its agreement with the International Bureau (see **paragraph 8.029**). [Rule 45bis.2(d) 45bis.3(d) and (e)]

[ ]

***PCT AG-IP 8.033 What does the International Bureau check upon receipt of the supplementary search request?***

**PCT AG-IP 8.033 What does the International Bureau check upon receipt of the supplementary search request?** Following receipt of the supplementary search request, the International Bureau will check whether the request was received within the prescribed time limit, that is, before the expiration of 19 months from the priority date. It will verify whether the Authority specified is competent to carry out the search, that is, an International Authority which is prepared to offer supplementary international searches and which is not the International Searching Authority that carried out the main international search. If these requirements have not been complied with, it will declare the supplementary search request not to have been submitted, and will notify the applicant accordingly using Form **PCT/IB/379** (see also **paragraphs 8.003 to 8.005**). [Rule 45bis.1(e)]

***PCT AG-IP 8.034 What happens if there are other defects in the supplementary search request?***

**PCT AG-IP 8.034 What happens if there are other defects in the supplementary search request?** The International Bureau will then check whether the supplementary search request has clearly indicated the name and address of at least one applicant and of the agent (if any), the title of the invention, the international filing date and the international application number. It will also verify whether a translation of the international application is needed to carry out the supplementary international search, and where necessary, whether that translation has been furnished. If any of these requirements have not been complied with, it will invite the applicant to correct these defects within one month from the date of the invitation using Form **PCT/IB/378** (see also **paragraphs 8.013 to 8.016, 8.018 to 8.020, and 8.023**). [Rule 45bis.4(a)]

***PCT AG-IP 8.035 What happens if the fees are not paid or not paid in full?***

**PCT AG-IP 8.037** When will the International Bureau transmit the relevant documents to the Authority specified for supplementary search?

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**PCT AG-IP 8.035** What happens if the fees are not paid or not paid in full? The International Bureau will also check whether the supplementary search fee and the supplementary search handling fee have been paid in full. If not, and the one-month time limit has not expired, it will invite the applicant to pay the amount required to cover those fees using Form **PCT/IB/376**. If the one-month time limit has already expired, the International Bureau will issue Form **PCT/IB/377** inviting the applicant to pay the amount required, together with a late payment fee equal to 50% of the supplementary search handling fee, within one month from the date of the invitation (see also **paragraphs 8.029 and 8.030**). [**Rule 45bis.4(b) and (c)**]

8.036. If the applicant fails to correct these defects, or does not pay the fees in full, before the expiration of the respective time limit, the supplementary search request will be considered not to have been submitted, and the International Bureau will make a declaration to this effect and notify the applicant accordingly using Form **PCT/IB/379**. [**Rule 45bis.4(d)**]

***PCT AG-IP 8.037*** When will the International Bureau transmit the relevant documents to the Authority specified for supplementary search?

**PCT AG-IP 8.037** When will the International Bureau transmit the relevant documents to the Authority specified for supplementary search? Once the International Bureau finds that all of the preceding requirements (see **paragraphs 8.033 to 8.035**) have been complied with, it will transmit the relevant documents (see **paragraph 8.038**) to the Authority specified for supplementary search, promptly after it receives the international search report, or after the expiration of 17 months from the priority date, whichever occurs first. If some documents are still not available to it at the above time, it will promptly transmit them once they are available. [**Rule 45bis.4(e)**]

***PCT AG-IP 8.038*** Which documents are transmitted by the International Bureau to the Authority specified for supplementary search?

**PCT AG-IP 8.038** Which documents are transmitted by the International Bureau to the Authority specified for supplementary search? The International Bureau will transmit to the Authority specified for supplementary search a copy of each of the following, where applicable: (i) the supplementary search request, (ii) the international application, (iii) any electronic copy of the sequence listing furnished therewith, (iv) any translation furnished which is to be used as the basis for the supplementary international search, (v) the international search report and the written opinion (including an English translation), (vi) any invitation by the International Searching Authority to pay additional fees concerning unity of invention, and (vii) any protest by the applicant against the opinion of the International Searching Authority concerning unity of invention, and the decision thereon by the same Authority. [**Rule 45bis.4(e) and (f)**]

[ ]

***PCT AG-IP 8.039*** When will the Authority start work on the supplementary international search?

**PCT AG-IP 8.039** When will the Authority start work on the supplementary international search? On receipt of the relevant documents from the International Bureau, the Authority specified for supplementary search should promptly begin its work (see **paragraph 8.037**). However, if on receipt of the relevant documents, the international search report and written opinion are not yet available, the Authority may postpone the start of the search until it receives these documents. Work on the supplementary international search must, however, commence before the expiration of 22 months from the priority date, regardless of the lateness of the international search report and written

PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?

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opinion. The absence of those documents will be noted on the international search report. [Rule 45bis.5(a)]

***PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?***

**PCT AG-IP 8.040 Which documents may the applicant submit directly to the Authority specified for supplementary search?** The applicant should furnish all the required documents to the International Bureau with the supplementary search request (see **paragraph 8.012**), and the International Bureau will transmit these, together with all other relevant documents, to the Authority specified for supplementary search (see **paragraph 8.038**). Any amendments filed under **Article 19** or **34** will not be taken into account. If, however, the applicant did not submit, a copy in electronic form of the sequence listing to the International Bureau, together with the request for supplementary search (see **paragraph 8.012**), he will be invited by the Authority specified for supplementary search to submit such a copy to the said Authority. Failure to comply with this requirement may result in that Authority only carrying out the supplementary international search to the extent that a meaningful search can be carried out without the sequence listing (see also **paragraphs 7.005 to 7.012** for more relevant information). [Rule 13ter.1 45bis.4(e) 45bis.5(c)]

***PCT AG-IP 8.041 What are the consequences if the Authority finds that carrying out the supplementary international search is excluded by a limitation or condition?***

**PCT AG-IP 8.041 What are the consequences if the Authority finds that carrying out the supplementary international search is excluded by a limitation or condition?** If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation or condition set out in its Agreement with the International Bureau (see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)), other than a limitation under **Article 17(2)**, it will declare that the supplementary search request be considered not to have been submitted, and promptly notify the applicant and the International Bureau accordingly. If, however, the Authority finds that carrying out the search is not entirely excluded, it may restrict the search to certain claims only and will indicate this fact in the supplementary international search report. [Rule 45bis.5(g) and (h) 45bis.9]

***PCT AG-IP 8.042 May the Authority refuse to search certain claims?***

**PCT AG-IP 8.042 May the Authority refuse to search certain claims?** In certain circumstances the Authority is not obliged to conduct a supplementary search on some or all of the claims in the international application. These include subject matter that the Authority would not search in a main international search and claims which have not been searched by the main searching Authority. If the Authority specified for supplementary search finds that it is not obliged to search any of the claims, it will declare that no supplementary international search report will be established (see **paragraph 8.048**) and promptly notify the applicant and the International Bureau accordingly. [Article 17(2)(a) Rule 45bis.5]

***PCT AG-IP 8.043 What is the scope of the supplementary international search?***

**PCT AG-IP 8.043 What is the scope of the supplementary international search?** The supplementary international search shall cover at least the documentation indicated for that purpose in the Agreement between the International Authority acting as the Authority specified for supplementary search and the International Bureau (see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)). For some Authorities this may comprise

PCT AG-IP 8.044 What will happen where the main International Searching Authority finds that the international application does not comply with the requirement of unity of invention?

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all PCT documentation plus other patent and technical documents held by that Authority, while others will focus specifically on documentation in certain languages (see **Annex SISA**). [Rule 45bis.5(f)]

***PCT AG-IP 8.044 What will happen where the main International Searching Authority finds that the international application does not comply with the requirement of unity of invention?***

**PCT AG-IP 8.044 What will happen where the main International Searching Authority finds that the international application does not comply with the requirement of unity of invention?** If the main International Searching Authority finds that the international application does not comply with the requirement of unity of invention and the applicant did not pay any additional search fees, the Authority specified for supplementary search is not obliged to carry out any supplementary search on claims which have not been searched by the main International Searching Authority. The requirements for unity of invention are set out in detail in **paragraphs 5.114 to 5.123**. The Authority specified for supplementary search is not, however, obliged to agree with the main International Searching Authority and may make its own finding on unity of invention. [Rule 13 45bis.5(e)]

***PCT AG-IP 8.045 What will happen where the Authority specified for supplementary search considers that the international application does not comply with the requirement of unity of invention?***

**PCT AG-IP 8.045 What will happen where the Authority specified for supplementary search considers that the international application does not comply with the requirement of unity of invention?** If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention (the requirements for unity of invention are set out in detail in **paragraphs 5.114 to 5.123**) it will not invite the applicant to pay additional fees, as the International Searching Authority does in the main international search. Instead, it will establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims (“main invention”), and notify the applicant of its opinion that the international application does not comply with the requirement of unity of invention and specify the reasons for that opinion. The applicant may, within one month from the date of the notification, request the Authority to review its opinion, subject to the payment of any review fee (see **Annex SISA**). The review fee will be refunded in full, where the opinion is found to be unjustified (see **paragraph 8.046**) and a revised supplementary international search report will be issued, where appropriate. [Rule 45bis.6(a) and (c)]

***PCT AG-IP 8.046 What will happen when the applicant requests a review of the opinion of the Authority on unity of invention?***

**PCT AG-IP 8.046 What will happen when the applicant requests a review of the opinion of the Authority on unity of invention?** If the applicant requests a review of the opinion of the Authority specified for supplementary search that the international application does not comply with the requirement of unity of invention and pays any required review fee, the Authority will review its opinion on unity of invention. The review may not be carried out only by the person who made the decision which is the subject of the review. The result of the review will be notified to the applicant. If the opinion is found to be entirely unjustified, the Authority will establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant. If the opinion is found to be partially unjustified, and the Authority still considers that the international application does not comply with the requirement of unity of invention, it will establish a corrected supplementary international search report where necessary. Independent of the review, the applicant may always request that the text of both the request for review and the decision thereon be



communicated to the designated Offices together with the supplementary international search report. [Rule 45bis.6(d) and (e)]

***PCT AG-IP 8.047 When is the supplementary international search report established?***

**PCT AG-IP 8.047 When is the supplementary international search report established?** The supplementary international search report must be established within 28 months from the priority date using Form PCT/SISA/501. [Rule 45bis.7(a)]

***PCT AG-IP 8.048 What happens when the Authority specified for supplementary search declares that no supplementary international search report will be established?***

**PCT AG-IP 8.048 What happens when the Authority specified for supplementary search declares that no supplementary international search report will be established?** A declaration that no supplementary international search report will be established must be made within 28 months from the priority date using Form PCT/SISA/502 (see paragraphs 8.003 and 8.004). [Rule 45bis.7(a)]

***PCT AG-IP 8.049 What does the supplementary international search report contain?***

**PCT AG-IP 8.049 What does the supplementary international search report contain?** The supplementary international search report is generally similar in contents and appearance to the main international search report (see paragraph 7.024). It does not, however, contain comments on the title of the invention or the abstract, nor does it contain the classification of the subject matter. Further, it does not repeat relevant prior art documents which have already been cited in the international search report, unless this is necessary because of new relevance when read in conjunction with other documents discovered during the supplementary international search. On occasion, the supplementary international search report may contain more detailed explanations concerning citations of documents than those in the main international search report. This is due to the fact that, unlike the main international search, no written opinion is established with the supplementary international search report, and these additional details are helpful for a full understanding of the prior art. Furthermore, it may contain additional comments on the scope of the supplementary search which has been conducted. This is of particular relevance when the supplementary search has been carried out without the benefit of the main international search report. [Rule 45bis.7(d) and (e)]

***PCT AG-IP 8.050 How can the applicant obtain copies of the documents cited in the supplementary international search report?***

**PCT AG-IP 8.050 How can the applicant obtain copies of the documents cited in the supplementary international search report?** Many Authorities which have stated their preparedness to carry out supplementary international search transmit such copies automatically, without extra charge to the applicant, together with the supplementary international search report. Annex SISA indicates whether an Authority charges a fee for furnishing copies of these documents. [Article 20(3) Rule 44.3 45bis.7]

***PCT AG-IP 8.051 How is the supplementary international search report transmitted?***

PCT AG-IP 8.052 Is a copy of the supplementary international search report sent to the International Preliminary Examining Authority?

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**PCT AG-IP 8.051 How is the supplementary international search report transmitted?** The Authority specified for supplementary search will, on the same day, transmit one copy of the supplementary international search report (or, the declaration that no supplementary international search report will be established) to the International Bureau and one copy to the applicant. The International Bureau will include the supplementary international search report in its communication to each designated Office, as if it were part of the international search report, unless the designated Office has waived this requirement. [Article 20(1) Rule 45bis.8 47.1(d)]

***PCT AG-IP 8.052 Is a copy of the supplementary international search report sent to the International Preliminary Examining Authority?***

**PCT AG-IP 8.052 Is a copy of the supplementary international search report sent to the International Preliminary Examining Authority?** Where the applicant files a demand for international preliminary examination, and the International Preliminary Examining Authority is not the same Authority as that specified for supplementary search, the International Bureau will, promptly on receipt of the supplementary international search report, transmit a copy of said report to the International Preliminary Examining Authority. The report, together with the international search report, will all be taken into account by that Authority during the process of international preliminary examination. Note, however, if that Authority has already begun to draw up the international preliminary examination report, it need not take into account the supplementary international search report for the purposes of that report. [Rule 45bis.8(b) and (c) Section 420(b)]

***PCT AG-IP 8.053 Will the supplementary international search report be published?***

**PCT AG-IP 8.053 Will the supplementary international search report be published?** The supplementary international search report is not published per se nor as part of the international publication. Nevertheless, once the international application has been published, and the supplementary international search report has been received, it is made available for public inspection by the International Bureau on PATENTSCOPE ([www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf)). [Article 20(3) Rule 44.3 94.1(b)]

## **PCT Appl. Guide - Int. Phase - 9. Int. Publication, Amendments, Processing by IB**

### ***PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?***

**PCT AG-IP 9.001 What are the main procedural steps at the International Bureau?** The main procedural steps that any international application goes through at the International Bureau are the following: [ ]

(i) the International Bureau monitors the receipt of the record copy of the international application and notifies the fact, and the date of receipt, to the applicant and the authorities concerned; for details, see **paragraph 9.002**; [**Rule 22.1 24.2**]

(ii) the applicant may amend the claims of the international application under **Article 19** by means of a communication addressed to the International Bureau; for details, see **paragraphs 9.004 to 9.011**; [**Article 19 Rule 46**]

(iii) the international application is published by the International Bureau (such publication usually takes place just after the expiration of 18 months from the priority date); for details, see **paragraphs 9.012 to 9.024**; [**Article 21 Rule 48**]

(iv) copies of the international application, the international search report and the written opinion of the International Searching Authority (in the form of the international preliminary report on patentability (**Chapter I of the PCT**)) (see (v) and (vi) below) pertaining to it are transmitted by the International Bureau to the designated Offices; for details, see **paragraphs 9.028 and 9.029**; [**Article 20 Rule 43bis 44 47**]

(v) where a preliminary examination report (international preliminary report on patentability (**Chapter II of the PCT**)) has not been established, the International Bureau issues an international preliminary report on patentability (**Chapter I of the PCT**) (see **paragraph 7.031**); [**Rule 44bis**]

(vi) copies of that report are transmitted by the International Bureau to the applicant, and to the designated Offices in accordance with **Rule 93bis**, but not before the expiration of 30 months from the priority date; the International Bureau may also if so requested by any designated State, transmit a copy of a translation into English of the international preliminary report on patentability (**Chapter I of the PCT**) to any interested designated Office and to the applicant at the same time as it communicates the report to that Office; [**Rule 44bis.2 44bis.3**]

(vii) where a demand for international preliminary examination has been filed, the International Bureau notifies the elected Offices, transmits the international preliminary report on patentability (**Chapter II of the PCT**) to them and makes a translation of that report into English (if required by any elected Office); for further details, see **paragraphs 10.006, 10.045, 10.078 and 10.079**. [**Article 36 Rule 70 71 72 73 74**]

### ***PCT AG-IP 9.002 When and to whom does the International Bureau notify its receipt of the record copy of the international application?***

**PCT AG-IP 9.002 When and to whom does the International Bureau notify its receipt of the record copy of the international application? When are designated Offices notified?** How the International Bureau receives the record copy and how it monitors that receipt is explained in **paragraphs 6.057 and 6.058**. The record copy of the international application should normally reach the International Bureau before the expiration of 13 months from the priority date. After receiving the

PCT AG-IP 9.003 What should be done by the applicant when he receives the notification of receipt of the record copy?

record copy, the International Bureau notifies the applicant, the receiving Office and the International Searching Authority (unless it has informed the International Bureau that it wishes not to be so notified) of the fact and of the date of receipt of the record copy. All those notifications are effected promptly after the International Bureau's receipt of the record copy. [Rule 24.2 47.1(a-bis) 93bis.1]

***PCT AG-IP 9.003 What should be done by the applicant when he receives the notification of receipt of the record copy?***

**PCT AG-IP 9.003 What should be done by the applicant when he receives the notification of receipt of the record copy?** The notification sent to the applicant (**Form PCT/IB/301**) contains the list of the designated Offices. This notification will allow the applicant to check whether the fact that certain designations (DE, JP and/or KR) were specifically excluded in the request, and/or any subsequent withdrawal of designations have been properly reflected. The applicant may wish to withdraw the designation of any designated State at this point, or at any time prior to the expiration of 30 months from the priority date. [Rule 24.2(a) 53.7 90bis.2]

[ ]

***PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?***

**PCT AG-IP 9.004 When and how may the claims of the international application be amended in the international phase?** The applicant is entitled, under **Article 19**, to one opportunity to amend the claims of the international application in the international phase. (Further opportunities to amend the claims, and also the description and the drawings, are available during the international phase under **Article 34** if, and only if, the applicant files a demand for international preliminary examination – see **paragraphs 9.011, 10.024 to 10.028, and 10.067 to 10.071**). Any amendment to the claims under **Article 19** must be filed with the International Bureau – not with the receiving Office nor the International Searching Authority. The amendments must be in the language in which the international application is published (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish – see **paragraphs 9.017 to 9.019**). The opportunity to make amendments under **Article 19** is available after the applicant has received the international search report and the written opinion of the International Search Authority, and remains available until the end of 16 months from the priority date or two months after the transmittal (that is, the date of mailing) of that report and opinion, whichever expires later. Amendments received by the International Bureau after the time limit are still accepted if they have been received before the technical preparations for international publication have been completed. Amendments to the claims under **Article 19** are not allowed where the International Searching Authority has declared, under **Article 17(2)**, that no international search report would be established (see **paragraph 7.014**). Upon entry into the national phase, if the claims have been amended under **Article 19**, a translation of both the claims as filed and as amended (in the form of a translation of the complete set of claims furnished under **Rule 46.5(a)** in replacement of all the claims originally filed and any statement may have to be furnished to the designated/elected Offices, (see **National Chapters (Summary)**). (As to amendments in the national phase, see **paragraphs 5.111, 5.127 and 5.162, the National Phase and National Chapters**.) The submission of **Article 19** amendments should comprise: [**Article 19(1) Rule 46 49.5(a)(ii), 49.5(c), 49.5(c-bis)**]

(i) a complete set of claims in replacement of the claims originally filed (see **paragraph 9.005**) [ ]

(ii) a letter which must indicate the differences between the claims as filed and those as amended plus the basis for the amendments (see **paragraphs 9.005 to 9.006A**) [ ]

(iii) an optional statement under **Article 19** (see **paragraphs 9.007 to 9.008**) [ ]

9.005. When filing amendments to the claims under **Article 19**, the applicant is required to file a sheet or sheets containing a complete set of claims in replacement of the claims originally filed. The replacement sheet or sheets must be accompanied by a letter drawing attention to the differences between the claims as filed and the claims as amended. It must also indicate the basis for the amendment to the claims with specific references to particular parts of the application (description, claims, drawings) as originally filed (see **paragraph 9.006**). Where an amendment results in the cancellation of an entire sheet of the international application as originally filed, the amendment (that is, the cancellation) is evidenced only by the letter addressed to the International Bureau. Amendments may consist in the cancellation of one or more entire claims, in the addition of one or more new claims, or in the amendment of the text of one or more of the claims as filed. All the claims appearing on a replacement sheet must be numbered in Arabic numerals (corresponding to the order of the claims). Where a claim is cancelled, no renumbering of the other claims is required. However, where the applicant does renumber claims, they must be renumbered consecutively. [**Rule 6.1 46.5 Section 205**]

### ***PCT AG-IP 9.006 What should the accompanying letter contain?***

**PCT AG-IP 9.006 What should the accompanying letter contain?** The letter, which must accompany the replacement sheets containing amendments to the claims, must indicate firstly the differences between the claims as filed and those as amended and secondly the basis for the amendments in the application as filed. This should be done by stating, in connection with each claim appearing in the international application, whether: [**Rule 46.5 Section 205**]

(i) the claim is unchanged, [ ]

(ii) the claim is cancelled; [ ]

(iii) the claim is new; [ ]

(iv) the claim replaces one or more claims as filed; [ ]

(v) the claim is the result of the division of a claim as filed, etc. [ ]

The replacement sheets containing the amended claims should not, however, contain marked-up text; they should contain clean text only. This should be followed by an indication of the basis for the amendments in the application as filed. The basis for the amendments has to be indicated so that the examiner may, by consulting those precise references in the application, assess whether the amendments contain subject-matter which extends beyond the disclosure of the application as filed. Therefore, non-specific indications such as “see the description as filed” or “see the claims as filed” are generally not considered sufficient for an indication of the basis for the amendment. Example: [ ]

“Claim 1 amended; claims 2 to 7 unchanged; claims 8 and 9 amended; claims 10 to 14 cancelled; claims 15 to 17 unchanged; new claim 18 added. [ ]

(i) Basis for the amendment: Claim 1 has been amended at lines 4 and 11 to 14 and now indicates that the filter comprises a periodic backwashing means serially coupled to a first and second chamber. The basis for this amendment can be found in original claims 2 and 4 as filed. [ ]

(ii) Basis for the amendment: Concerning amended claims 8 and 9, the indication of ‘quick-fire piston’ is in paragraph Nos. 2 and 19 in the description as filed. [ ]

PCT AG-IP 9.006\_a What happens where the international application is not in the same language as the accompanying letter?

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(iii) Basis for the amendment: Claim 18 is new, the indication is in drawing No. III of the original application.” [ ]

***PCT AG-IP 9.006\_a What happens where the international application is not in the same language as the accompanying letter?***

**PCT AG-IP 9.006\_a What happens where the international application is not in the same language as the accompanying letter?** The accompanying letter should be furnished in English or French. References may, however, be made to the international application in the language of the international application where to do so will facilitate the work of the examiner in finding the reference, for example: [Rule 92.2(d)]

(i) Basis for the amendment: Concerning amended claim 2, the indication of “請求項1に基づくパーキングアシストシステム” is in paragraph Nos. 23, 46 and 85 in the description as filed. [ ]

***PCT AG-IP 9.007 What is a statement accompanying an amendment?***

**PCT AG-IP 9.007 What is a statement accompanying an amendment?** Any amendment may be accompanied by a brief statement by the applicant explaining the amendment and indicating any impact it might have on the description and the drawings. Such a statement is published together with the international application itself (see **paragraphs 9.012 to 9.024**). Statements not referring to a specific amendment are not permitted. The statement must not exceed 500 words if in English or when translated into English. It may not contain disparaging comments on the international search report or on the relevance of any of the citations contained in that report. References to certain citations in the report may be made only in connection with an amendment made to a specific claim. The statement must be in the language in which the international application is published (see **paragraphs 9.017 and 9.018**). [Article 19(1) Rule 46.4 48.2(a)(vi)]

9.008. A statement explaining the amendment is not to be confused with and must be clearly distinguished from the letter indicating the differences between the claims as filed and those as amended and the basis for the amendment (see **paragraph 9.006**). It is also distinct from the statement concerning amendments which must be included in a demand for international preliminary examination (see **paragraphs 10.024 to 10.027**). It must therefore be identified as such by a heading “Statement under **Article 19(1)**.” Where the statement does not comply with the requirements, it is neither published by the International Bureau nor communicated to the designated Offices. [Rule 46.4(a) 48.2(a)(vi)]

***PCT AG-IP 9.009 May the amended claims include new matter?***

**PCT AG-IP 9.009 May the amended claims include new matter?** The PCT provides that amendments are not to go beyond the disclosure in the international application as filed. This requirement is not directly enforceable during **Chapter I of the international phase**, but failure to comply with it may have adverse consequences for the applicant during the international preliminary examination and in the national phase (see **paragraphs 10.070 and 11.047** below). [Article 19(2) and (3) Rule 66.2(a)(iv)]

***PCT AG-IP 9.009\_a What happens where the replacement sheets were not accompanied by a letter?***

**PCT AG-IP 9.009\_a What happens where the replacement sheets were not accompanied by a letter?** The PCT requires that replacement sheets filed with **Article 19** amendments must be

**PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?**

accompanied by a letter indicating the basis for the amendment to the claims (see **paragraph 9.006**). Substantive compliance with this requirement is not checked during the international phase unless the applicant requests international preliminary examination but failure to comply with it may have adverse consequences for the applicant during international preliminary examination and in the national phase (see also **paragraph 11.047A** below). [**Rule 46.5(b) 70.2(c-bis)**]

***PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?***

**PCT AG-IP 9.010 Should a copy of amendments under Article 19 be filed with the International Preliminary Examining Authority?** If the applicant submits a demand for international preliminary examination, he should file a copy of the amendments to the claims under **Article 19**, the letter which accompanied the amended claims and the statement under **Article 19(1)** (if any) with the International Preliminary Examining Authority with the demand (if the amendment has already been filed) or at the same time as he files the amendment with the International Bureau (if the amendment is filed after the demand). Where the International Preliminary Examining Authority requires a translation of the international application under **Rule 55.2**, the applicant should also furnish a translation of any amendments made under **Article 19** and any letter that accompanied the amendments if he wishes those amendments to be taken into account for international preliminary examination. The International Bureau transmits a copy of any amendment, accompanying letter and any statement under **Article 19** received prior to the filing of the demand to the International Preliminary Examining Authority unless that Authority indicates that it has already received a copy. If an amendment, the accompanying letter and any statement under **Article 19** are received after the demand has been filed, the International Bureau transmits a copy to the International Preliminary Examining Authority in any event, but timely filing of a copy of these documents by the applicant direct with that Authority ensures that the international preliminary examination will proceed without undue delay or uncertainty. See **paragraphs 10.024 to 10.028** in connection with the demand form. [**Rule 53.9(a)(i) 55.3 62.1 62.2**]

***PCT AG-IP 9.011 In what circumstances should the claims be amended under Article 19 ?***

**PCT AG-IP 9.011 In what circumstances should the claims be amended under Article 19 ?** Since any amendments of the claims under **Article 19** are published with the international application (see **paragraph 9.015**), such amendment may be useful to the applicant if there is a reason to better define the scope of the claims for the purposes of provisional protection in those designated States whose national law provides for such protection (see **paragraph 9.024**). It is to be noted that, where international preliminary examination takes place, the applicant has the right under **Article 34(2)(b)** to file amendments to the claims (as well as to the description and the drawings) with the International Preliminary Examining Authority, regardless of whether or not he has filed amendments to the claims under **Article 19** with the International Bureau (see **paragraphs 10.024, 10.028, 10.067 to 10.071, and 11.045 to 11.047**). There is therefore normally no need to amend the claims under **Article 19** where a demand for international preliminary examination is filed, unless there is a particular reason related to provisional protection or otherwise for amending the claims before international publication. [**Article 34(2)(b) Rule 48.2(f) 66.1(b)**]

[ ]

***PCT AG-IP 9.012 When and how is the international application published by the International Bureau?***

PCT AG-IP 9.013 When are the technical preparations for international publication completed?

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**PCT AG-IP 9.012 When and how is the international application published by the International Bureau?** International applications are published by the International Bureau except in any of the following cases: [ ]

(i) if the international application is not accorded an international filing date by the receiving Office (see **paragraphs 6.005 to 6.012**); [**Rule 20.4**]

(ii) if the international application is considered withdrawn before the technical preparations for publication have been completed; [**Article 21(5)**]

(iii) if the international application is withdrawn by the applicant (see **paragraphs 11.048 and 11.049**) before the technical preparations for publication have been completed; [**Article 21(5)**]

(iv) if the only designated State remaining at the time of the completion of the technical preparations for publication, is the United States of America (since the United States of America made a declaration under **Article 64(3)(a)**), unless any of the exceptions specified in **Article 64(3)(c)** applies. [**Article 64(3)**]

***PCT AG-IP 9.013 When are the technical preparations for international publication completed?***

**PCT AG-IP 9.013 When are the technical preparations for international publication completed?** The technical preparations for publication are completed by the 15th day prior to the date of publication. [ ]

***PCT AG-IP 9.014 When does international publication take place?***

**PCT AG-IP 9.014 When does international publication take place?** International publication takes place promptly after the expiration of 18 months from the priority date. However, when the applicant asks the International Bureau to publish his international application earlier, the International Bureau does so. If the applicant asks for early publication and the international search report, or the declaration referred to in **Article 17(2)(a)**, is not available for publication with the international application, a special fee, the amount of which is indicated in **Annex B (IB)**, is payable to the International Bureau. [**Article 21(2) Rule 48.2(h) 48.4 Section 113**]

***PCT AG-IP 9.015 What constitutes international publication?***

**PCT AG-IP 9.015 What constitutes international publication?** Since 1 April 2006, publication of international applications filed under the PCT takes place wholly in electronic form. The published international application will include any declaration filed under **Rule 4.17** and, if available at the time of publication, the international search report or declaration by the International Searching Authority to the effect that no international search report will be established, and also any amendment, including any statement, under **Article 19**. Where the time limit for amending the claims has not expired at the time of the completion of the technical preparations for publication, the international application is published with an annotation accordingly, and any amendment received within the time limit is published later. Similarly, if the international search report or declaration by the International Searching Authority is not available, the international application is published with an annotation accordingly and the report or declaration is published separately after it has been received by the International Bureau. Each published international application is assigned an international publication number consisting of the code WO followed by an indication of the year and a serial number (for example, WO 2004/123456). For further details governing international publication, see **Article 21** and **Rule 48**. [**Article 21(3) Rule 48.1 48.2(a), (g) and (h) Section 404 406(b)**]



9.016. On the same date the international application is published, the bibliographic data, the title of the invention, the abstract and a characteristic drawing (if any) of each published international application are made available on the WIPO website at:  
**www.wipo.int/patentscope/search/en/structuredSearch.jsf**. [Rule 86.1(i) Section 407(b)]

***PCT AG-IP 9.017 In what language is the international application published?***

**PCT AG-IP 9.017 In what language is the international application published?** If the international application is filed in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish, it is published in the language in which it was filed. Where the language of publication is Arabic, Chinese, French, German, Japanese, Korean, Portuguese, Russian or Spanish, the International Bureau prepares English translations of the title of the invention, the abstract and the international search report (or the declaration referred to in **paragraph 7.014**) and includes the translations in the published international application. The International Bureau also prepares, where applicable, French translations of the title and the abstract. The title and abstract are published on the WIPO website at: **www.wipo.int/patentscope/search/en/structuredSearch.jsf** (see **paragraph 9.020**). [Article 21(4) Rule 45.1 48.3]

9.018. If the international application is filed in a language which is a language other than Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish and is a language accepted by the International Searching Authority for international search, the applicant must furnish a translation of the international application into a language of publication accepted by the receiving Office for that purpose. The international application will be published in that language of translation only (see **paragraphs 6.020 to 6.023**). [Rule 48.3(b)]

9.019. If the international application is filed in a language which is neither a language of publication (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish) nor a language accepted by the International Searching Authority for international search, it is published in the language of the translation furnished by the applicant (see **paragraphs 6.013 to 6.020**). [ ]

9.020. The bibliographic data, titles and abstracts, and any figure which appears on the front page of each published international application are published in English and in French on the WIPO website at: **www.wipo.int/patentscope/search/en/structuredSearch.jsf**. [Rule 86.2(a)]

***PCT AG-IP 9.021 How can copies of the published international application be obtained?***

**PCT AG-IP 9.021 How can copies of the published international application be obtained?** In addition to downloading the published international application from the WIPO website anyone may obtain a copy of the published international application by ordering it from the International Bureau, preferably referring to its international publication number (if available). [Rule 86.1(i) 86.4]

***PCT AG-IP 9.022 How can the published international application in electronic form be accessed?***

**PCT AG-IP 9.022 How can the published international application in electronic form be accessed?** The published international application in electronic form is available via WIPO website at **www.wipo.int/patentscope/search/en/structuredSearch.jsf**. [Rule 86.1(i) 86.4]

***PCT AG-IP 9.023 How can copies of the priority document be obtained?***

**PCT AG-IP 9.023 How can copies of the priority document be obtained?** Third parties who wish to receive a copy of the priority document may apply to the Office with which the earlier application

was filed, to certain designated Offices or to the International Bureau. The International Bureau makes copies of priority documents, after international publication of the international application available on the WIPO website at: [www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf), or on paper upon request and subject to reimbursement of the cost. However, the International Bureau does not furnish such copies if, prior to the international publication, the international application was withdrawn, or the relevant priority claim was withdrawn or was considered not to have been made, or the relevant declaration of the priority claim was cancelled. [Rule 4.10(b) 17.2(c)]

***PCT AG-IP 9.024 What are the legal effects of international publication?***

**PCT AG-IP 9.024 What are the legal effects of international publication?** Article 29 has the effect of ensuring, with certain qualifications, that provisional protection is available after the international publication of an international application in the same way as it is after national publication of unexamined national applications. The qualifications are such as to enable Contracting States to make such protection conditional on the furnishing of translations (in some circumstances), on the expiration of 18 months from the priority date, and/or on receipt by the designated Office of a copy of the international application as published under the PCT. For further details, see Article 29. Annexes B indicate what the position is in each Contracting State. [Article 29]

***PCT AG-IP 9.025 Can access be gained at the International Bureau to the file of an international application?***

**PCT AG-IP 9.025 Can access be gained at the International Bureau to the file of an international application?** For international applications filed before 1 July 1998, the applicant or any person authorized by the applicant may, subject to reimbursement of the cost of the service, obtain copies from the International Bureau of any document contained in its file. For international applications filed on or after 1 July 1998, the International Bureau makes certain documents in its file available on WIPO's website together with the published international application. In addition, it will, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, upon reimbursement of the cost of the service, copies of any document contained in its file (see paragraphs 11.072 to 11.074 for details concerning the confidentiality of international applications). [Rule 94]

9.026. In addition to the general Article 38 exception referred to above, for international applications filed on or after 1 January 2004, the International Bureau will not, unless requested or authorized by the applicant, provide access by any person or authority to: [Rule 44~~ter~~]

- (i) the written opinion of the International Searching Authority; [ ]
- (ii) any informal comments submitted by the applicant on the written opinion of the International Searching Authority; [ ]
- (iii) the international preliminary report on patentability (**Chapter I of the PCT**); or [ ]
- (iv) any translations of those documents or written observations by the applicant on those translations; [ ]

before the expiration of 30 months from the priority date. [ ]

9.027. Concerning access to the international preliminary report on patentability, the International Bureau will, as of 1 January 2004 and if so requested by an elected Office, make copies of that report available on the WIPO website at: [www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf) to

PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?

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third parties on behalf of that Office. A number of elected Offices have made this request to the International Bureau, see [www.wipo.int/pct/en/texts/access\\_iper.html](http://www.wipo.int/pct/en/texts/access_iper.html). [Rule 94.1(c)]

[ ]

***PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?***

**PCT AG-IP 9.028 How and when do the designated Offices receive copies of the international application?** Subject to what is said in this paragraph and in **paragraph 9.029**, the International Bureau communicates a copy of the international application in the language in which the international application is published, to each designated Office upon their request and at the time specified by that Office, pursuant to **Rule 93bis**, but not prior to the international publication. Where the language in which the international application is published is different from the language in which it was filed, the International Bureau will furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed. In practice, the communication is effected by sending a copy of the published international application (for details concerning the contents of published international applications, see **paragraph 9.015**). The International Bureau also sends, promptly after the expiration of 19 months from the priority date in respect of designated Offices which do not apply the 30-month time limit, and again promptly after the expiration of 28 months from the priority date in respect of designated Offices which do apply the 30-month time limit, a notice (**Form PCT/IB/308** (First Notice) (*19 months*) and **Form PCT/IB/308** (Second and Supplementary Notice) (*28 months*)) to the applicant informing him of the Offices to which the communication has been effected and of the date of such communication. The notices must be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notices. On receiving the notices, the applicant knows that he does not have to send a copy of the international application to any of the designated Offices indicated on them as having been sent the communication. [**Article 20(1)(a) 22(1) Rule 47.1(a) 47.2 47.3 93bis**]

9.029. A copy of the international application (albeit without the international search report) is communicated by the International Bureau, prior to the communication referred to in the preceding paragraphs, to any designated Office which so requests; this transmittal may not be done before the expiration of one year from the priority date. It should be noted that, to date, no national or regional Office has asked for a copy of all the international applications designating it to be the subject of such an early communication. If he wishes, the applicant may at any time transmit, or ask the International Bureau to transmit, a copy of his international application to any designated Office. Such special transmittal by the International Bureau requires the payment of a fee, the amount of which is indicated in **Annex B (IB)**. Further details are to be found in **Article 13** and **Rule 31**. It is to be noted that transmittal in this way does not, unless expressly requested by the applicant, entitle the designated Office to start its processing of the international application. If, however, the applicant makes an express request to a designated or elected Office (under **Article 23(2)** or **40(2)**, respectively) for early commencement of national processing, the International Bureau then promptly effects the communication to the Office concerned upon request by the applicant or the designated or elected Office. [**Article 13 23(2) 40(2) Rule 31 47.4 61.2(d)**]

## **PCT Appl. Guide - Int. Phase - 10. Int. Prelim. Examin. (Chapter II)**

### ***PCT AG-IP 10.001 What is international preliminary examination?***

**PCT AG-IP 10.001 What is international preliminary examination?** International preliminary examination of an international application may be requested under **Chapter II of the PCT** to obtain “a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable” (**Article 33(1)**). It is carried out by an “International Preliminary Examining Authority” at the request – called “demand” – of the applicant, for use before the “elected” Offices, that is, the designated Offices which are elected by the applicant for that purpose, (note that the filing of a demand constitutes the election of all Contracting States which are designated and bound by **Chapter II of the Treaty**). Not every applicant who has the right to file an international application has the right to demand international preliminary examination; the following paragraphs explain who may make a demand. [**Article 31(1) 31(4)(a) 32(1) 33(1) Rule 53.7**]

### ***PCT AG-IP 10.002 What are the main effects of the international preliminary examination?***

**PCT AG-IP 10.002 What are the main effects of the international preliminary examination?** Since the criteria on which the international preliminary examination is based (see **paragraph 10.001**) correspond to internationally accepted criteria for patentability, the international preliminary report on patentability (**Chapter II of the PCT**) gives the applicant the opportunity to evaluate the chances of obtaining patents in elected Offices before incurring the expense and trouble of entering the national phase. Moreover, the fact that the carrying out of such an examination has been demanded has the result that the national phase in each elected State is normally delayed until the expiration of 30 months from the priority date (longer times apply in some elected Offices), provided that the demand is submitted before the expiration of 19 months from the priority date (Note, however, that the 30-month time limit applies in any case, to a large number of designated Offices even if they have not been elected within the 19-month time limit; see **paragraph 5.005** for details). For further details, see **paragraph 10.010**, and also the **National Chapters**, (Summaries). [**Article 39(1) 40(1) 64(2)(a)(i) and (ii)**]

10.003. With the exception of the fact that a demand has been filed and the names of those designated States for which a notice of withdrawal has been submitted to the International Bureau or to the International Preliminary Examining Authority are available on the WIPO website at: [www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf), the international preliminary examination procedure remains confidential between the applicant, the International Preliminary Examining Authority and the International Bureau. In respect of international applications filed before 1 July 1998, a copy of the international preliminary examination report, when it has been established, is sent by the International Bureau to each elected Office as well as the applicant, but is not available from the International Preliminary Examining Authority or the International Bureau to any other persons or Offices. In respect of international applications filed on or after 1 July 1998, copies of all documents contained in the file of the International Preliminary Examining Authority may be obtained by third parties via those elected Offices whose national law provides for access to the files of national applications (see also **paragraphs 10.080 and 10.081, and 11.072 to 11.074**). Concerning the availability of the international preliminary examination report from the International Bureau, see **paragraph 9.027. [Article 38 Rule 94]**

[ ]

PCT AG-IP 10.004 On what conditions may a demand for international preliminary examination be submitted?

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***PCT AG-IP 10.004 On what conditions may a demand for international preliminary examination be submitted?***

**PCT AG-IP 10.004 On what conditions may a demand for international preliminary examination be submitted?** There are two conditions which have to be fulfilled for a demand to be submitted. First, the applicant – or, if there are two or more applicants, at least one of them – must be a resident or a national of a Contracting State bound by **Chapter II of the PCT**. Second, the international application must have been filed with the receiving Office of, or acting for, a Contracting State bound by **Chapter II**. **Annexes A and B** indicate whether or not each Contracting State is bound by **Chapter II**. Potential applicants who have residence and/or nationality in more than one Contracting State, and thus generally have a choice of receiving Office, should therefore file the international application with a receiving Office of or acting for a Contracting State bound by **Chapter II** if they wish to take advantage later of the international preliminary examination procedure. However, it should be noted that the right to make a demand may be lost if, following a change in the applicants named in the international application, there is no longer, at the time the demand is made, at least one applicant who is a resident or national of a Contracting State bound by **Chapter II**. The concepts of residence and nationality are defined in **Rule 18.1** (see **paragraph 5.023**). If the applicant does not have the right to make a demand, the demand is considered not to have been submitted. [**Article 31(2)(a) Rule 18.1 54**]

***PCT AG-IP 10.005 Which States may be elected?***

**PCT AG-IP 10.005 Which States may be elected?** In relation to demands for international preliminary examination filed on, or after, 1 January 2004, all Contracting States which are designated in the international application and are bound by **Chapter II of the PCT** are elected. The printed demand form (available on the WIPO website at:

**[www.wipo.int/pct/en/forms/demand/ed\\_demand.pdf](http://www.wipo.int/pct/en/forms/demand/ed_demand.pdf)**) contains a pre-printed statement that the filing of the demand constitutes the election of all Contracting States which are designated and are bound by **Chapter II of the Treaty** (see **paragraph 10.029**). Please note that States whose designation has been withdrawn cannot subsequently be elected. If the applicant does not wish to elect a particular State, the election of that State may be withdrawn after a demand has been filed. It should be also noted that withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election. [**Article 31(4) 64(1) Rule 53.7 90bis.4**]

***PCT AG-IP 10.006 Where should the demand for international preliminary examination be submitted?***

**PCT AG-IP 10.006 Where should the demand for international preliminary examination be submitted?** The demand must be made separately from the international application, and be submitted directly to an International Preliminary Examining Authority which is competent to carry out international preliminary examination on the international application concerned. Each receiving Office (except the International Bureau as receiving Office – see **paragraph 5.008**) specifies one or more International Preliminary Examining Authorities as competent to carry out international preliminary examination on international applications filed with it. In addition, different International Preliminary Examining Authorities may be competent in relation to an international application depending on the language in which the international application was filed and on which International Searching Authority carried out the international search. Where several International Preliminary Examining Authorities are competent in relation to a particular international application, having regard to which receiving Office the international application was filed with and the language of the international application, the applicant may choose between them. Where the international application is filed with the International Bureau as receiving Office, the competent International Preliminary Examining Authority (or Authorities) is that (or are those) which would have been competent if the international application had been filed with a competent national (or regional) Office as receiving

**PCT AG-IP 10.010** At what stage of the procedure should the demand for international preliminary examination be submitted?

Office. The International Preliminary Examining Authority or Authorities competent for international applications filed with each national (or regional) Office acting as receiving Office, and the languages accepted for international preliminary examination by each International Preliminary Examining Authority, may be ascertained by consulting **Annexes C and E**. Finally, within the framework of the respective agreements relating to the functioning of certain Offices as International Preliminary Examining Authorities, these Authorities may provide for limitations of their competence in respect of certain international applications. The consolidated texts of these Agreements are available on the WIPO website at the following address: [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html). For more detailed information, see **Annex E**. [**Article 31(3) 31(6)(a) 32(2) Rule 59**]

10.007. If a demand is submitted to a receiving Office, an International Searching Authority, an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, or the International Bureau, that Office or that Authority or the International Bureau, as the case may be, will mark on it the date of receipt, which will be considered to be the date on which the demand was received on behalf of the competent International Preliminary Examining Authority. [**Rule 59.3(a), (b) and (e)**]

10.008. When a demand is filed with a receiving Office, an International Searching Authority, or an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Office or Authority may send the demand either directly to the competent International Preliminary Examining Authority, or to the International Bureau which will in turn forward the demand to the competent International Preliminary Examining Authority. [**Rule 59.3(c) and (f)**]

10.009. If two or more International Preliminary Examining Authorities are competent, the applicant will be invited, by the Office or Authority to which the demand was submitted, or by the International Bureau, as the case may be, to indicate, within the time limit applicable under **Rule 54bis.1(a)**, or within 15 days from the date of the invitation whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted. Where the applicant furnishes that indication, the demand will promptly be transmitted to the competent International Preliminary Examining Authority. Where no indication is so furnished, the demand will be considered not to have been submitted, and the Office or Authority to which the demand was submitted, or the International Bureau, as the case may, will declare that the demand is considered not to have been submitted. [**Rule 59.3(c) and (d)**]

***PCT AG-IP 10.010*** *At what stage of the procedure should the demand for international preliminary examination be submitted?*

**PCT AG-IP 10.010** At what stage of the procedure should the demand for international preliminary examination be submitted? A demand may be submitted at any time prior to the expiration of the following time limits, whichever expires later: [**Article 39(1) Rule 54bis.1(a) 69.1(a)(iii) 69.2**]

- (i) three months from the date of transmittal to the applicant of the international search report and the written opinion of the International Searching Authority, or of the declaration, referred to in **Article 17(2)(a)** that no international search report will be established; or [ ]
- (ii) 22 months from the priority date. [ ]

In addition, in respect of some Offices (see **paragraph 5.005**), in order to secure the full effect of the demand – including the delaying of the national phase until 30 months from the priority date – it must be submitted before the expiration of 19 months from the priority date. Since international preliminary examination will normally not start before the international search report and the written

**PCT AG-IP 10.011** What happens if the international application was filed or published in a language which is not accepted by the International Preliminary Examining Authority?

opinion of the International Searching Authority are available (see **paragraphs 10.051 to 10.055**) and provided that the International Preliminary Examining Authority will not start the preliminary examination before the expiration of the applicable time limit unless the applicant expressly requests an earlier start, the applicant will normally wish to take that report and opinion into account before deciding whether to proceed further on his quest for patent protection. Note, however, that the 19-month time limit will expire regardless of whether the establishment of the international search report and the written opinion of the International Searching Authority are delayed. On the other hand, the length of time available for the international preliminary examination depends on the earliest possible submission of the demand after the international search report and the written opinion of the International Searching Authority are available, since the international preliminary report on patentability (**Chapter II of the PCT**) must in most cases be established before the expiration of 28 months from the priority date, or six months from the time provided for the start of the international preliminary examination, or six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished by the applicant, if applicable, whichever period expires last (see **paragraph 10.074**). The more time available for the international preliminary examination, the better will be the result and quality which can be expected. Therefore, a demand should be filed as soon as possible after the applicant's evaluation of the international search report and the written opinion of the International Searching Authority has shown that it is worthwhile to pursue the international application further. [ ]

[ ]

***PCT AG-IP 10.011*** *What happens if the international application was filed or published in a language which is not accepted by the International Preliminary Examining Authority?*

**PCT AG-IP 10.011** What happens if the international application was filed or published in a language which is not accepted by the International Preliminary Examining Authority? Where neither the language in which the international application was filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant must furnish with the demand a translation of the international application into a language which is both a language accepted by that Authority, and a language of publication. No such translation is required where the International Searching Authority and the International Preliminary Examining Authority are part of the same national Office or intergovernmental organization, in which case the international preliminary examination will be carried out on the basis of the translation furnished for the purposes of the international search (see **paragraphs 6.014 to 6.017**). Details about the languages accepted for international preliminary examination by the various International Preliminary Examining Authorities appear in **Annex E**. See **paragraph 9.010** in connection with the need to file a translation of amendments under **Article 19**. [**Rule 55.2**]

[ ]

***PCT AG-IP 10.012*** *What requirements as to form, contents and language must the demand for international preliminary examination comply with?*

**PCT AG-IP 10.012** What requirements as to form, contents and language must the demand for international preliminary examination comply with? The demand must either be made on a printed form to be filled in with the required indications or be presented as a computer print-out complying with the Administrative Instructions. To facilitate preparation of the demand, the International Bureau has prepared downloadable PDF (portable document format) versions on its

PCT AG-IP 10.014 What are the requirements with respect to the identification of the international application?

website at [www.wipo.int/pct/en/forms/](http://www.wipo.int/pct/en/forms/). The editable PDF version of the form (**PCT/IPEA/401**) may be completed using a computer or printed out and filled in using a typewriter. The demand, and instructions on how to complete the editable version, is available in English, French, German, Russian and Spanish. Sample filled-in forms are also available from the above website address. Copies of forms may also be obtained, free of charge, from the receiving Office or the International Preliminary Examining Authority. [**Article 31(3) Rule 53 Section 102(b) and (i)**]

10.013. The completed demand must identify the applicant and the international application to which it relates. The demand contains a petition that the international application be the subject of international preliminary examination. The filing of the demand constitutes the automatic election of all Contracting States which are designated and which are bound by **Chapter II of the PCT** – see **paragraph 10.029** and the **sample filled-in demand form**, at the addresses indicated in **paragraph 10.012**). It must, where applicable, contain a statement concerning amendments, on the basis of which the international preliminary examination will start (see **paragraphs 10.025 and 10.026**) and an indication of the language in which international preliminary examination will be carried out. The demand must be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication. However, where a translation of the international application is required because the International Preliminary Examining Authority accepts neither the language in which the international application is filed nor the language in which the international application is published (see **paragraphs 5.013 and 10.011**), the demand must be in the language of that translation. The demand must be signed (see **paragraphs 10.031, 10.032, and 11.027 to 11.032**). Details for the filling in of the demand form are given below in respect of each Box of that form. Where more than one International Preliminary Examining Authority is competent in relation to the international application (see **paragraph 10.006**), the Authority chosen by the applicant, and with which the demand is filed, should be identified, preferably by an indication of the name or two-letter code of the Authority (see **Annex K**), at the top of the first sheet of the demand form in the space provided for that purpose. [**Rule 53 55.1**]

[ ]

***PCT AG-IP 10.014 What are the requirements with respect to the identification of the international application?***

**PCT AG-IP 10.014 What are the requirements with respect to the identification of the international application?** The international application must be identified by its international application number, filing date and title. If the international application number is not known to the applicant at the time of filing of the demand, the name of the receiving Office with which the international application was filed must be indicated. The title of the invention must be the same as that which appears in the published international application (that is, the same as that indicated in the request, unless it was modified by the International Searching Authority – see **paragraph 7.022**). [**Rule 53.6**]

10.015. It is recommended that the applicant indicate his file reference, if any, not exceeding 12 characters in length, in the box provided for this purpose on the first sheet of the demand form (see **paragraphs 5.017 and 5.105** in relation to the request and the description). [ ]

10.016. Indication of the priority date on the demand is not mandatory, but is recommended since it will assist the International Preliminary Examining Authority to ascertain promptly whether or not the demand was filed before the expiration of 19 months from the priority date. [ ]



[ ]

***PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?***

**PCT AG-IP 10.017 Who may file a demand for international preliminary examination? What indications are required?** If there is a sole applicant, he must be a resident or national of a Contracting State bound by **Chapter II of the PCT**. If there are two or more applicants, it is sufficient that one of them be a resident or national of a Contracting State bound by Chapter II, regardless of the elected State(s) for which each applicant is indicated. The detailed requirements for the various indications required in connection with each applicant (full names and addresses, telephone, facsimile and/or e-mail address, nationality and residence) are the same as those required under **Rule 4** in connection with the request (see **paragraphs 5.023 to 5.034**). Where the applicant is registered with the International Preliminary Examining Authority, the number or other indication under which the applicant is so registered may also be indicated in Box No. II. Note that any inventor who is not also an applicant is not indicated in the demand. Where a question of the applicant's residence or nationality arises, the International Preliminary Examining Authority will request the receiving Office or, where the international application was filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned to decide the question and will inform the applicant of such request. The applicant has the opportunity to submit arguments relating to the issue of residence or nationality directly to the Office concerned, which will decide the question promptly. [**Article 31(2) Rule 4 53.4 53.5 54.1 54.2 60.1(a-bis)**]

***PCT AG-IP 10.018 Who should be indicated if there has been a change in the name or person of the applicant?***

**PCT AG-IP 10.018 Who should be indicated if there has been a change in the name or person of the applicant?** If the recording of a change in the name or person has been requested under **Rule 92bis.1** before the demand was filed (see **paragraphs 11.018 to 11.022**), it is the applicant(s) on record at the time when the demand is filed who must be indicated in the demand. [**Rule 92bis.1**]

***PCT AG-IP 10.018\_a How can the applicant receive notifications via e-mail?***

**PCT AG-IP 10.018\_a How can the applicant receive notifications via e-mail?** If the applicant has authorized either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail, by marking the corresponding check-box in Box No. II of the demand form, the International Bureau and the International Preliminary Examining Authority may, if they wish to do so, send such notifications to the applicant, thus avoiding processing or postal delays. Where the agent or common representative has also provided e-mail authorization, the International Bureau and the International Preliminary Examining Authority will send e-mail communications only to the appointed agent or common representative (see **paragraph 10.022**). Note that not all Authorities will send such notifications by e-mail (see **Annex B**). If an e-mail notification is followed by the official notification on paper, only the paper copy of the notification is considered to be the legal copy of the notification and only the date of mailing of the paper copy will commence any time limit within the meaning of **Rule 80**. Where the applicant requests the sending of notifications exclusively by e-mail, the date of mailing indicated on the electronic copy will commence any time limit within the meaning of **Rule 80**. It is the applicant's responsibility to keep any e-mail address details up-to-date and to ensure that incoming e-mails are not blocked, for any reason, on the recipient's side. Changes to the e-mail address indicated should be requested to be recorded, preferably directly at the International Bureau, under **Rule 92bis**. [ ]

[ ]

***PCT AG-IP 10.019 Does the applicant have to be represented by an agent before the International Preliminary Examining Authority?***

**PCT AG-IP 10.019 Does the applicant have to be represented by an agent before the International Preliminary Examining Authority?** No, the applicant is not obliged to be represented by an agent, but he may be, and in most cases it is highly advisable for him to be represented (see paragraph 1.004). [ ]

***PCT AG-IP 10.020 May the applicant be represented by an agent before the International Preliminary Examining Authority?***

**PCT AG-IP 10.020 May the applicant be represented by an agent before the International Preliminary Examining Authority?** Yes, he may. He may be represented by the agent who represented him for the filing of the international application (if any) or by another agent having the right to practice before the receiving Office with which the international application was filed (see Annex C). He may also be represented by an agent appointed specifically for the purposes of the international preliminary examination procedure and chosen from among those persons who have the right, according to the rules applicable in the national or regional Office acting as International Preliminary Examining Authority, to practice before that Office (see **National Chapters**, (Summaries)). See **paragraphs 11.001 to 11.014** for more information about representation. [**Article 49 Rule 2.2 90.1(a)** and (c)]

***PCT AG-IP 10.021 When and how may an agent be appointed for the purposes of the procedure concerning the international preliminary examination?***

**PCT AG-IP 10.021 When and how may an agent be appointed for the purposes of the procedure concerning the international preliminary examination?** If an agent has already been appointed for the filing of the international application, that agent may also represent the applicant for the purposes of the international preliminary examination procedure and may sign the demand on behalf of the applicant. Alternatively, a different agent or an additional agent may be designated in the demand for international preliminary examination or in a separate power of attorney. The detailed requirements for the various indications required in connection with each agent (full names and addresses, telephone, facsimile, e-mail address(es) and/or teleprinter numbers) are the same as those required under **Rule 4** in connection with the request (see **paragraph 5.043**). Where the agent is registered with the International Preliminary Examining Authority, the number or other indication under which the agent is so registered may also be indicated in Box No. III. Further information about the manner of appointing agents, including sub-agents, appears in **paragraphs 11.001 to 11.014**. [**Rule 53.2(a)(ii) 53.5 90**]

***PCT AG-IP 10.021\_a How can an agent (or common representative) receive notifications via e-mail?***

**PCT AG-IP 10.021\_a How can an agent (or common representative) receive notifications via e-mail?** If the check-box in Box No. III is marked indicating that either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail is authorized, the International Bureau and the International Preliminary Examining Authority may, if they wish to do so, send such notifications to the agent or common representative at the indicated e-mail address, thus avoiding processing or postal delays (see **paragraph 10.018**) [ ]

***PCT AG-IP 10.022 May the applicants be represented by a common representative?***

**PCT AG-IP 10.022 May the applicants be represented by a common representative?** The provisions relating to common representatives which apply at earlier stages (see **paragraph 5.048**) continue to be applicable during the international preliminary examination procedure. That is, if no common agent is appointed, one of the applicants may be appointed by the other applicants as the common representative of all the applicants, and if neither a common agent nor a common representative is appointed, the applicant named first in the request who is entitled to file an international application with the receiving Office concerned will be considered to be the common representative ("deemed common representative") (see **paragraph 11.006**). A separate power of attorney must be filed with the International Preliminary Examining Authority, the International Bureau or the receiving Office, if the person appointed at the time the demand is filed signs the demand on behalf of the applicant. However, the receiving Office, the International Bureau or the International Preliminary Examining Authority may waive the requirement that a separate power of attorney be filed. For further details see **Annexes B (IB), C and E. [Rule 2.2bis 90.2 90.4]**

***PCT AG-IP 10.023 What other provisions apply to agents and common representatives during the international preliminary examination procedure?***

**PCT AG-IP 10.023 What other provisions apply to agents and common representatives during the international preliminary examination procedure?** The same general provisions apply to agents and common representatives during the international preliminary examination as apply during other stages of the international phase (for example, in relation to their legal position and revocation and renunciation of appointments – see **paragraphs 11.001 to 11.014**). [ ]

[ ]

***PCT AG-IP 10.024 Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination?***

**PCT AG-IP 10.024 Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination?** The applicant has the right, under **Article 34(2)(b)**, to amend the claims, the description and the drawings before the start of the international preliminary examination and also during the examination, if time permits, until the preparation of the international preliminary report on patentability (**Chapter II of the PCT**). (As far as the claims are concerned, this is in fact the second opportunity to amend them before the international preliminary examination starts; the first opportunity is offered by the possibility of submitting amendments under **Article 19** to the International Bureau as described in **paragraphs 9.004 to 9.009, and 9.011**.) For further details concerning amendments under **Article 34(2)(b)**, see **paragraphs 10.028, 10.067 to 10.071, 11.045 to 11.047. [Article 34(2)(b) Rule 66.1(b) and (d)]**

***PCT AG-IP 10.025 What is the purpose of indicating the basis for international preliminary examination?***

**PCT AG-IP 10.025 What is the purpose of indicating the basis for international preliminary examination? Do the statement concerning amendments and the indication of the language for the purposes of the international preliminary examination have to be filled in? [Rule 53.2(a)(iv) 53.9]**

(i) The statement concerning amendments should be completed, since it enables the International Preliminary Examining Authority to identify those documents which will serve as the basis for the

start of the international preliminary examination with a view to starting it as soon as possible. However, failure to complete the statement or to complete it correctly is not fatal to the application. In particular, if no amendments have been filed under **Article 19** or **Article 34** and if the applicant does not wish to file such amendments at the time when he files the demand, the result will simply be that the international preliminary examination will start on the basis of the international application as originally filed. The applicant will not be precluded from making amendments at a later stage of the international preliminary examination, provided that they reach the International Preliminary Examining Authority in sufficient time to be taken into account. On the other hand, if there have been amendments but they are not indicated, or if the applicant wishes later to file amendments but does not so indicate, the start of the international preliminary examination may be delayed or the applicant may find that there is insufficient time at a later stage to have his intended amendments taken into account. [ ]

(ii) Completing the indication of the language for the purposes of the international preliminary examination and its associated check-boxes helps the International Preliminary Examining Authority determine quickly, with a view to starting international preliminary examination as soon as possible, whether the demand and the international application are in a language accepted by that Authority, or whether a translation of the international application is required. Completing the indication also helps the International Preliminary Examining Authority decide whether any amendments filed with the demand (see paragraph (i) above) are in the appropriate language. [ ]

***PCT AG-IP 10.026 How should the statement concerning amendments be completed?***

**PCT AG-IP 10.026 How should the statement concerning amendments be completed?** If amendments to the claims have been made under **Article 19** (see **paragraphs 9.004 to 9.009**) prior to the filing of the demand, the statement must indicate whether, for the purposes of the international preliminary examination, the applicant wishes the amendments to be taken into account (in which case a copy of the amendments should be filed with the demand) or to be considered as reversed by an amendment under **Article 34**. If no amendments under **Article 19** have been made but the time limit for filing such amendments (see **paragraph 9.004**) has not expired at the time when the demand is filed, the statement may, if the applicant so chooses, indicate that the applicant wishes the start of the international preliminary examination to be postponed (see **paragraph 10.054**). If any amendments under **Article 34** are submitted with the demand, the statement must so indicate. A more detailed explanation is given below for each of the check-boxes in Box No. IV. [ ]

“1. The applicant wishes the international preliminary examination to start on the basis of:  
[ ]  
the international application as originally filed”  
[ ]

This check-box should be marked either where the applicant has not made any amendments under **Article 19** and does not intend at the time of filing the demand to file any amendments, or where the applicant has already made amendments under **Article 19** but is no longer interested in pursuing them.  
[ ]

“the description  
[ ]  
[ ]  
the claims  
[ ]  
[ ]

☐

the drawings

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These check-boxes should be marked only where the applicant wishes amendments to be taken into account for the start of the international preliminary examination. Where the applicant wishes amendments which have previously been made under **Article 19** to be taken into account, a copy of the amendments, and any statement accompanying such amendments, should be attached to the demand. If a check-box is marked but the demand is not accompanied by the documents referred to, the start of international preliminary examination will be delayed until the International Preliminary Examining Authority receives them. Amendments under **Article 34** should be submitted with, and attached to, the demand. The applicant should also indicate, by marking the appropriate check-box(es), which parts of the international application are so amended. [**Rule 60.1(g) 69.1(e)**]

"2. The applicant wishes any amendments to the claims made under **Article 19** to be considered as reversed."

[**Rule 53.9(a)(ii)**]

This check-box should be marked only where the applicant, after having previously made amendments under **Article 19**, no longer wishes them to be considered for international preliminary examination. Marking this check-box will have the effect that those amendments will be considered as reversed by an amendment under **Article 34**. [ ]

"3. Where the IPEA wishes to start the international preliminary examination at the same time as the international search in accordance with **Rule 69.1(b)**, the applicant requests the IPEA to postpone the start of the international preliminary examination until the expiration of the applicable time limit under **Rule 69.1(d)**."

[**Rule 53.9(b) 69.1(d)**]

This check-box should be marked only where, at the time when the demand is filed, the time limit for filing amendments under **Article 19** has not expired (see **paragraph 9.004**) and the applicant intends to file such amendments after filing the demand. In practice, this situation is only likely to arise if the demand is filed before the international search report is available. If this check-box is marked but the applicant later decides not to file amendments under **Article 19**, he should send a notice to the International Preliminary Examining Authority that he does not wish to file such amendments and the international preliminary examination will then start. It should be noted that the examination will start in any event after the expiration of the applicable time limit under **Rule 54bis.1(a)** even where no amendments have been received by the International Preliminary Examining Authority. [ ]

"4. The applicant expressly wishes the international preliminary examination to start earlier than at the expiration of the applicable time limit under **Rule 54bis.1(a)**."

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This check-box should be marked if the applicant wishes that the international preliminary examination start earlier than at the expiration of the applicable time limit under **Rule 54bis.1(a)**. Where the International Searching Authority and the International Preliminary Examining Authority are not the same Authority, the examination will not commence until the International Preliminary Examining Authority is in possession of the international search report, or a notice of the declaration under **Article 17(2)(a)** and the written opinion of the International Searching Authority. [ ]

***PCT AG-IP 10.027 May several check-boxes be marked in Box No. IV?***

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PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?

**PCT AG-IP 10.027 May several check-boxes be marked in Box No. IV?** Yes – for example, under item (1), two or three check-boxes may be marked if the applicant has already filed amendments to the claims under **Article 19** and wishes those amendments to be taken into account along with further amendments under **Article 34** to the description and/or drawings (and possibly further amendments to the already amended claims). [ ]

***PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?***

**PCT AG-IP 10.028 May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?** Yes, the applicant is not precluded from later making amendments, or further amendments, during the course of the international preliminary examination (see **paragraphs 10.067 to 10.071**), whatever appears in the statement concerning amendments, and in this sense the statement is not binding on the applicant or on the conduct of the international preliminary examination. For example, the applicant may choose to file amendments under **Article 34** at a later stage which supersede amendments previously made under **Article 19**, even though the statement indicates that those previous amendments should be taken into account. However, the information contained in the statement is used by the International Preliminary Examining Authority to determine when, and on what basis, the international preliminary examination is to start (see **paragraphs 10.051 to 10.055**). Moreover, amendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of the international preliminary report on patentability (**Chapter II of the PCT**) if they are received after the Authority has begun to draw up that report (see **paragraph 10.068**). Since the time available for international preliminary examination is limited, it is in the applicant's interests to be as definite as possible, at the time of filing the demand, as to what should form the basis of the international preliminary examination. If the applicant intends to file amendments under **Article 34** but is not in a position to submit them with the demand, that intention should preferably be mentioned in a letter filed with the demand. It is to be noted that since, under **Rule 66.1bis**, the written opinion of the International Searching Authority will in the majority of cases be considered to be the written opinion of the International Preliminary Examining Authority, if amendments under **Article 34** are not filed together with the demand, the International Preliminary Examining Authority might, shortly after the expiration of the time limit under **Rule 54bis.1(a)**, start to draw up the international preliminary report on patentability (**Chapter II of the PCT**). [**Rule 66.1(b) 66.4bis**]

[ ]

***PCT AG-IP 10.029 Which States may be elected?***

**PCT AG-IP 10.029 Which States may be elected?** The making of a demand on, or after, 1 January 2004 has the effect of electing all States which have been designated and which are bound by **Chapter II of the PCT**. [**Rule 53.7**]

[ ]

***PCT AG-IP 10.030 What is the purpose of the Check List?***

**PCT AG-IP 10.030 What is the purpose of the Check List?** The Check List in Box No. VI should be completed by the applicant to allow the International Preliminary Examining Authority to verify the completeness of the documents filed with the demand. Of particular importance in the Check List are the indications relating to amendments referred to in the statement concerning amendments. The indications given in the Check List should correspond with the indications given in Box No. IV. [ ]

[ ]

***PCT AG-IP 10.031 Who must sign the demand?***

**PCT AG-IP 10.031 Who must sign the demand?** The demand must be signed by the applicant or, if there is more than one applicant, by all the applicants making the demand – that is, the applicants for the States which are elected. However, an agent or common representative may sign the demand on behalf of the applicant or applicants who appointed him. The demand may be signed on behalf of all the applicants by an appointed common agent or common representative, or by the applicant who is considered to be the common representative (“deemed common representative”) if no common agent or common representative has been appointed (see **paragraph 11.006**). However, if the signature(s) of one or more applicants is missing, the International Preliminary Examining Authority will not invite the applicants to furnish the missing signature(s) provided that at least one of the applicants has signed the demand. Should a notice of withdrawal be filed at any time during the international phase, that notice will have to be signed by the applicant or, if there are two or more applicants by all of them (**Rule 90bis.5(a)**), or by any agent or common representative whose appointment has been effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney (**Rule 90bis.4(a)**). For the case where an applicant/inventor for the United States of America is unwilling to sign or cannot be found or reached, see **paragraphs 11.027 to 11.032**. [**Rule 53.4 53.8 60.1(a-ter) 90.3**]

***PCT AG-IP 10.032 When must or may a seal be used instead of a signature?***

**PCT AG-IP 10.032 When must or may a seal be used instead of a signature?** In the demand or other papers filed with the State Intellectual Property Office of the People’s Republic of China as International Preliminary Examining Authority, a seal may be used instead of a signature. In the case of a demand or other papers filed in English with the **European Patent Office** as International Preliminary Examining Authority in respect of international applications filed with the **Japan Patent Office** as receiving Office, a signature must be furnished instead of a seal. In the demand or other papers filed with the **Korean Intellectual Property Office** as International Preliminary Examining Authority, a seal may be used instead of a signature (see **paragraph 5.091** in respect of the request). [**Rule 2.3**]

[ ]

***PCT AG-IP 10.033 What are the Notes to the demand form?***

**PCT AG-IP 10.033 What are the Notes to the demand form?** The Notes to the demand form (see the WIPO website at: [www.wipo.int/pct/en/forms/demand/ed\\_demand.pdf](http://www.wipo.int/pct/en/forms/demand/ed_demand.pdf)) are intended to facilitate the completion of that form. They indicate, in relation to each Box of the form, what indications are required and how they are to be made. The Notes are not required to be filed with the demand. [ ]

[ ]

***PCT AG-IP 10.034 What is the fee calculation sheet?***

**PCT AG-IP 10.034 What is the fee calculation sheet?** The fee calculation sheet is intended to help the applicant calculate the total amount of fees payable to the International Preliminary Examining Authority. The sheet is usually annexed to the printed demand form which the applicant obtains from

**PCT AG-IP 10.035 What fees are payable in respect of a demand for international preliminary examination?**

the receiving Office or the International Preliminary Examining Authority. It is not part of the form, however, and its use is not mandatory. Nevertheless, it is strongly recommended that the applicant complete the fee calculation sheet and submit it to the International Preliminary Examining Authority. This will help the International Preliminary Examining Authority verify the calculations and identify any errors. See the Notes to the fee calculation sheet at the WIPO Internet address in **paragraph 10.033** for details about completion of the sheet. For further information about the payment of fees, see **paragraphs 10.035 to 10.043**. [ ]

[ ]

***PCT AG-IP 10.035 What fees are payable in respect of a demand for international preliminary examination?***

**PCT AG-IP 10.035 What fees are payable in respect of a demand for international preliminary examination?** There are two kinds of fees which have to be paid in connection with the demand: [Article 31(5)]

(i) the “preliminary examination fee,” which is fixed by and accrues to the International Preliminary Examining Authority, mainly for carrying out the international preliminary examination and for establishing the international preliminary report on patentability (**Chapter II of the PCT**); [Rule 58.1(a) and (c)]

(ii) the “handling fee,” which is fixed in the **Schedule of Fees** to the PCT Regulations and accrues to the International Bureau for carrying out various tasks, including, where required, the translation of the international preliminary report on patentability (**Chapter II of the PCT**) into English (see **paragraph 10.039**). [Rule 57.1]

***PCT AG-IP 10.036 Is any fee payable for effecting an election?***

**PCT AG-IP 10.036 Is any fee payable for effecting an election?** There is no “election fee”. The only fees payable for filing a demand are those specified in **paragraph 10.035**. [ ]

***PCT AG-IP 10.037 To whom are these fees payable?***

**PCT AG-IP 10.037 To whom are these fees payable?** The preliminary examination fee and the handling fee are payable to the International Preliminary Examining Authority, which forwards the handling fee to the International Bureau. [Rule 57.1 58.1(c)]

***PCT AG-IP 10.038 In what currency are these fees payable?***

**PCT AG-IP 10.038 In what currency are these fees payable?** Generally, the preliminary examination fee and the handling fee are payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority. Complete information on this question is contained in **Annex E**. [Rule 57.2(b) 58.1(c)]

***PCT AG-IP 10.039 What are the amounts of these fees?***

**PCT AG-IP 10.039 What are the amounts of these fees?** **Annex E** indicates the amounts of the preliminary examination fee and the handling fee payable to each International Preliminary Examining Authority. [Rule 57.2(a) 57.3 58.1(b)]



10.040. A reduction of the preliminary examination fee charged by the **European Patent Office** may be available to applicants from certain States – see **Annex E(EP)** for further details. [ ]

10.041. An applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below 3,000 US dollars (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997), or who is a national of and resides in one of the following States: Antigua and Barbuda, Bahrain, Barbados, the Libyan Arab Jamahiriya, Oman, the Seychelles, Singapore, Trinidad and Tobago and the United Arab Emirates; or an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations, is entitled, in accordance with the **Schedule of Fees, item 4**, to a reduction of 90% of the handling fee. Information about PCT Contracting States whose nationals and residents are entitled to a reduction of 90% of the handling fee is contained in **Annex E**. If there are several applicants, each must satisfy one or the other of the above-mentioned criteria. The reduction of the fee will be automatically available to any applicant so entitled on the basis of the indications of name, nationality and residence given in the international application and in Box No. II of the demand. The fee reduction will be available even if one or more of the applicants are not from PCT Contracting States, provided that each of them satisfies the above-mentioned criteria and that at least one of them is a national or resident of a PCT Contracting State bound by **Chapter II** and thus is entitled to file a demand. The PCT Contracting States whose nationals and residents are eligible for the fee reduction, as outlined above, are listed in **Annex C (IB)**. [ ]

#### ***PCT AG-IP 10.042 When are these fees due?***

**PCT AG-IP 10.042 When are these fees due?** The preliminary examination fee and the handling fee must be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later, provided that, where the demand was transmitted to the competent International Preliminary Examining Authority under **Rule 59.3**, the handling fee must be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later. As to the consequences of non-payment or late payment of these fees, see **paragraph 10.047**. [**Rule 57.3 58.1(b)**]

#### ***PCT AG-IP 10.043 In what cases are these fees refunded?***

**PCT AG-IP 10.043 In what cases are these fees refunded?** The International Preliminary Examining Authority will refund the handling fee if the demand is withdrawn before being sent to the International Bureau or if the demand is considered not to have been submitted because none of the applicants had the right to file a demand (see **paragraph 10.004**). Each International Preliminary Examining Authority decides at its discretion whether it will refund the preliminary examination fee, or any part thereof, in other circumstances. Details are indicated in **Annex E**. [**Rule 54.4 57.4 58.3**]

[ ]

#### ***PCT AG-IP 10.044 What happens to the demand for international preliminary examination once it has been received?***

**PCT AG-IP 10.044 What happens to the demand for international preliminary examination once it has been received?** The International Preliminary Examining Authority promptly notifies the applicant of the date of receipt of the demand, and then examines the demand to ascertain whether it meets all the requirements. If it does not, the International Preliminary Examining Authority invites the applicant to comply. For full details on the correction of defects in the demand, see **Rule 60.1** and **paragraphs 10.047 to 10.049**, and **paragraph 10.050**. [**Rule 60.1(a) 61.1**]

PCT AG-IP 10.046 What action can the applicant take if the indications on the demand form do not support the applicant's right to file the demand?

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10.045. The International Preliminary Examining Authority sends the demand or a copy thereof to the International Bureau. The International Bureau then notifies Offices of their election and informs the applicant that it has done so. For full details, see **Rules 61.2** and **61.3**. In addition, the International Bureau, promptly after the filing of the demand but not before the international publication, publishes information on the WIPO website at:

**www.wipo.int/patentscope/search/en/structuredSearch.jsf** on the demand and the elected States concerned, as provided in the **Administrative Instructions**. [**Article 31(7) Rule 61.1(a) 61.2 61.3 61.4 Section 431**]

***PCT AG-IP 10.046 What action can the applicant take if the indications on the demand form do not support the applicant's right to file the demand?***

**PCT AG-IP 10.046 What action can the applicant take if the indications on the demand form do not support the applicant's right to file the demand?** If the indications of the applicant's residence and nationality given in Box No. II of the demand form do not support the applicant's right to file a demand with the International Preliminary Examining Authority concerned (see **paragraph 10.004**), the International Preliminary Examining Authority notifies the applicant that the demand is considered not to have been submitted. It may happen, however, that those indications were incorrectly stated or that the applicant in fact had a residence and/or nationality supporting the applicant's right to file the demand. In such a case, evidence should immediately be submitted indicating that, in fact, the applicant had, on the date on which the demand was received by the International Preliminary Examining Authority, the right to file the demand with that Authority. If that evidence is to the satisfaction of the Authority, it will then regard the requirements of **Article 31(2)(a)** as having been fulfilled on the date of actual receipt of the demand, and the indications in the demand can be corrected. [**Article 31(2)(a) Rule 61.1(b) Section 614**]

***PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?***

**PCT AG-IP 10.047 Can defects in the demand for international preliminary examination, non-compliance with certain language requirements, and non-payment of certain fees be corrected, and if so how?** What are the consequences? If the International Preliminary Examining Authority finds that: [ ]

(i) the demand does not meet the requirements as to form, contents and languages (see **paragraph 10.012**), [**Article 31(3) Rule 53 55.1**]

(ii) the handling fee was not paid within one month from the date on which the demand was submitted or, where the demand was transmitted to the competent International Preliminary Examining Authority under **Rule 59.3**, within one month from the date of receipt by that Authority, or was not paid in the prescribed currency (see **paragraphs 10.035** and **10.038**), or [**Rule 57.3**]

(iii) the preliminary examination fee was not paid within one month from the date on which the demand was submitted or, where the demand was transmitted to the competent International Preliminary Examining Authority under **Rule 59.3**, within one month from the date of receipt by that Authority, or was not paid in the prescribed currency (fixed by the International Preliminary Examining Authority – see **paragraphs 10.035** and **10.038**), it invites the applicant to correct the defect(s) and comply with the requirements and/or to pay the required fee(s). In the case of defects as to form or language, the invitation specifies a time limit of at least one month from the date of the invitation, which time limit may be extended by the International Preliminary Examining Authority at any time before a decision is taken. In the case of defects as to fee payment, the invitation specifies a time limit of one month from the date of the invitation; a late payment fee may also be required; no

extension of this time limit is available. However, any payment must be considered to have been received before the expiration of the applicable time limit if it is received by the International Preliminary Examining Authority before the expiration of the time limit for paying the fee(s) or, where an invitation to pay missing fees has been sent, before that Authority makes the declaration that the demand is considered not to have been made. [Rule 58.1(b) 58bis 60.1(b)]

10.048. There is no adverse consequence for the applicant, other than possibly delaying the start of the international preliminary examination (see **paragraph 10.050**), if he complies with the invitation within the time limit so specified (including any extensions, where applicable), except where the defect was that the demand did not permit the international application to be identified. In the latter case, the demand is considered to have been received on the date on which the required correction to it is received, and the International Preliminary Examining Authority informs the applicant of that date. [Rule 60.1(b) 61.1(b)]

10.049. If, after the expiration of the time limit specified (including any extensions), a signature (of at least one applicant), or other required indication (in respect of one applicant who has the right according to **Rule 54.2** to make a demand) is still lacking the demand is considered not to have been submitted and the International Preliminary Examining Authority will so declare. [Rule 60.1(c) 61.1(b)]

10.050. Where the demand is considered to have been received, as described in **paragraph 10.048**, on a date later than that on which it was actually submitted, the effect of postponing the commencement of the national phase (see **paragraph 10.002** above) is lost if that later date is after the expiration of 19 months from the priority date. This is, however, only relevant in respect of any State whose designated Office has notified the International Bureau that the 30-month time limit under **Article 22(1)**, as in force from April 1, 2002, is incompatible with the national law applied by that Office. The effect of postponing the commencement of the national phase is also lost where the demand is considered not to have been submitted (see **paragraph 10.049**). [Article 39(1)(a)]

[ ]

### ***PCT AG-IP 10.051 When does the international preliminary examination start?***

**PCT AG-IP 10.051 When does the international preliminary examination start?** Subject to the exceptions mentioned in **paragraphs 10.052 to 10.055**, the International Preliminary Examining Authority starts the international preliminary examination when it is in possession of the demand, the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under **Rule 58bis.2**, and of either the international search report and the written opinion established under **Rule 43bis.1** or a declaration by the International Searching Authority that no international search report will be established and the written opinion established under **Rule 43bis.1**. Even if the International Preliminary Examining Authority is in possession of all of the above, however, it may not start the international preliminary examination before the expiration of the applicable time limit under **Rule 54bis.1(a)** unless the applicant expressly requests an earlier start. [Rule 69.1(a)]

10.052. If the competent International Preliminary Examining Authority is part of the same (national or regional) Office as the competent International Searching Authority, the international preliminary examination may, if the Office wishes and except where the applicant has requested that the international preliminary examination be postponed (see **paragraph 10.054**), start at the same time as the international search (often called a "telescoped" procedure since the international search and international preliminary examination partly overlap). [Rule 69.1(b)]

PCT AG-IP 10.056 May the International Preliminary Examining Authority ask for the priority document and a translation of it?

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10.053. Where the statement concerning amendments made in the demand contains an indication that amendments under **Article 19** are to be taken into account, the International Preliminary Examining Authority will not start the international preliminary examination before it has received a copy of the amendments concerned and the accompanying letter. Therefore, a copy of those amendments and accompanying letter should be attached to the demand by the applicant in order to allow as much time as possible for the international preliminary examination (see **paragraphs 9.010, 10.025 and 10.026**). The International Bureau will, in any event, send a copy of those amendments and accompanying letter to the International Preliminary Examining Authority unless that Authority has indicated that it has already received them (see **paragraph 9.010**), but waiting for those copies to be sent may delay the start of the international preliminary examination. [**Rule 53.9(a)(i) 62 69.1(c)**]

10.054. Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (see **paragraph 10.026**), the International Preliminary Examining Authority will not start the international preliminary examination before whichever of the following occurs first: [**Rule 53.9(b) 69.1(d)**]

(i) it has received a copy of any amendments under **Article 19**; [ ]

(ii) it has received a notice from the applicant that he does not wish to make amendments under **Article 19**; or [ ]

(iii) the expiration of the applicable time limit under **Rule 46.1**. [ ]

Therefore, where the applicant gives such an indication in the demand, he should ensure that the International Preliminary Examining Authority is informed promptly of any amendments or of any decision on his part not to file amendments, in order to gain the maximum time possible for the international preliminary examination procedure. [ ]

10.055. Where the statement concerning amendments contains an indication that amendments under **Article 34** are submitted with the demand (see **paragraph 10.026**), but no such amendments are, in fact, submitted with the demand, the International Preliminary Examining Authority will not start the international preliminary examination before it has received the amendments or before it has invited the applicant to file them and the time limit fixed in that invitation has expired, whichever occurs first. Where the international application was not filed in the language of publication, any amendments under **Article 34** and any accompanying letter (as well as any letter accompanying **Article 19** amendments) must be in the language of publication. Where the international preliminary examination is carried out on the basis of a translation of the international application (see **paragraph 10.011**), any such amendments, and any amendments under **Article 19** which are to be taken into account, and any letter that accompanied such amendments must be in the language of that translation. Where such amendments have been or are filed in another language, a translation of the amendments into the language in which the international preliminary examination is carried out must also be furnished (see also **paragraph 11.046**). If the amendments or accompanying letter are not in the required language, the International Preliminary Examining Authority will invite the applicant to furnish them within a reasonable time limit. If the applicant fails to furnish the amendments and/or the accompanying letter within the time limit set in the invitation, the International Preliminary Examining Authority will not take the amendments into consideration for the purposes of the international preliminary examination. [**Rule 53.9(c) 55.2 55.3(a), (b) (c) and (d) 69.1(e)**]

***PCT AG-IP 10.056 May the International Preliminary Examining Authority ask for the priority document and a translation of it?***

**PCT AG-IP 10.056 May the International Preliminary Examining Authority ask for the priority document and a translation of it?** If the International Preliminary Examining Authority needs a

copy of an application the priority of which is claimed in the international application (“the priority document”) and the International Bureau already has the priority document in its possession (see **paragraph 5.070**), the International Bureau furnishes a copy of it to the Authority on request. Should the applicant have failed to provide the priority document under **Rule 17.1**, the international preliminary report on patentability (**Chapter II of the PCT**) may be established as if the priority had not been claimed, but no elected Office may later disregard the priority claim under those circumstances before giving the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances. Where the priority document is in a language other than the language or one of the languages indicated for the International Preliminary Examining Authority in **Annex E**, and that Authority is of the opinion that the validity of the priority claim is relevant for the formulation of the opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable, the Authority may invite the applicant to furnish to it a translation in that language. The applicant must comply with that invitation within two months from its date; otherwise, the international preliminary report on patentability (**Chapter II of the PCT**) may be established as if the priority had not been claimed. [**Rule 66.7**]

***PCT AG-IP 10.057 What is the purpose of the international preliminary examination?***

**PCT AG-IP 10.057 What is the purpose of the international preliminary examination?** As already stated in **paragraph 10.001**, the purpose of the international preliminary examination is to formulate an opinion – which is “preliminary” (since a final opinion will be formulated only in the national phase by the national or regional Patent Office or by a competent national or regional court) and “non-binding” (on anyone, including elected Offices) – on whether the claimed invention appears (i) to be novel, (ii) to involve an inventive step (to be non-obvious), and (iii) to be industrially applicable. While there is not a fully uniform approach to these criteria in national laws, their application under the PCT during the international preliminary examination procedure is such that the international preliminary report on patentability (**Chapter II of the PCT**) gives a good idea of the likely results in the national phase. [**Article 33(1)**]

10.058. For the purposes of the international preliminary examination, a claimed invention is considered novel if it is not anticipated by the prior art. **Rule 64** defines “prior art” for the purposes of the examination. [**Article 33(2) Rule 64**]

10.059. For the purposes of the international preliminary examination, a claimed invention is considered to involve an inventive step if, having regard to the prior art as defined in the Regulations (see **paragraph 10.058**), it is not, at the prescribed relevant date, obvious to a person skilled in the art. For further details, see **Rule 65**. [**Article 33(3) Rule 65**]

10.060. For the purposes of the international preliminary examination, a claimed invention is considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. [**Article 33(4)**]

***PCT AG-IP 10.061 What documents form the basis of the international preliminary examination?***

**PCT AG-IP 10.061 What documents form the basis of the international preliminary examination?** The international preliminary examination is based on the claims, the description and the drawings comprised in the international application. Amendments to the claims under **Article 19** made before the demand was filed are taken into account unless they are superseded by a subsequent amendment under **Article 34** (see **paragraph 10.028**) or considered as reversed by an amendment under **Article 34** (see **paragraph 10.026**). Amendments made after the demand is filed, whether

PCT AG-IP 10.062 What happens if no international search report has been established in respect of certain claims?

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under **Article 19** or under **Article 34**, are also taken into account for the purposes of the international preliminary examination, except that they need not be taken into account for the purposes of a written opinion of the International Preliminary Examining Authority or the international preliminary report on patentability (**Chapter II of the PCT**) if they are received after the International Preliminary Examining Authority has begun to draw up that opinion or report. As to the allowability of amendments in general, see **paragraph 11.047**. [**Rule 66.1 66.4bis**]

***PCT AG-IP 10.062 What happens if no international search report has been established in respect of certain claims?***

**PCT AG-IP 10.062 What happens if no international search report has been established in respect of certain claims?** Claims relating to inventions in respect of which no international search report has been established (see **paragraphs 7.013 to 7.021**) need not be the subject of international preliminary examination and any written opinion of the International Preliminary Examining Authority, as well as the international preliminary report on patentability (**Chapter II of the PCT**), will so indicate. [**Rule 66.2(a)(vi)**]

***PCT AG-IP 10.063 What special requirements apply during the international preliminary examination to nucleotide and/or amino acid sequence listings?***

**PCT AG-IP 10.063 What special requirements apply during the international preliminary examination to nucleotide and/or amino acid sequence listings?** Where the International Preliminary Examining Authority finds that an international application contains disclosure of a nucleotide and/or amino acid sequence and that listings of the sequences complying with the standard provided for in **Annex C of the Administrative Instructions** (see **paragraph 5.099**) have not already been furnished (as part of the international application or for the purposes of international preliminary examination, as the case may be), that Authority may invite the applicant to furnish sequence listings complying with this standard. If the International Preliminary Examining Authority finds that the applicant has not already furnished (as part of the international application or for the purposes of international preliminary examination, as the case may be), sequence listings in electronic form complying with the standard provided for in **Annex C of the Administrative Instructions**, it may invite the applicant to furnish sequence listings to it in such a form. The listings required by the International Preliminary Examining Authority are for the purposes of carrying out the international preliminary examination. National law requirements, in relation to disclosure of inventions involving sequence listings, are a matter for the national phase of processing. [**Rule 13ter.2**]

***PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?***

**PCT AG-IP 10.064 What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?** The International Preliminary Examining Authority notifies the applicant in a "written opinion" if it considers that [**Rule 66.2**]

(i) the international application relates to subject matter on which it is not required to carry out an international preliminary examination, and decides not to carry out such an examination (this situation being the same as the one described in **paragraph 7.013** in relation to the international search), [**Article 34(4)(a)(i) 35(3)(a) Rule 66.2(a)(i) 67**]

(ii) the description, the claims or the drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness) or industrial applicability of the claimed invention (this situation being the same as

the one described in **paragraph 7.014** in relation to the international search), [**Article 34(4)(a)(ii)**  
**Rule 66.2(a)(i)**]

(iii) the international preliminary report on patentability (**Chapter II of the PCT**) should be “negative” (see **paragraph 10.075**) in respect of any of the claims because the invention claimed therein does not appear to be novel, does not appear to involve an inventive step (be non-obvious), or does not appear to be industrially applicable, [**Rule 66.2(a)(ii)**]

(iv) any amendment goes beyond the disclosure in the international application as filed (see **paragraphs 10.070** and **11.047**), [**Rule 66.2(a)(iv)**]

(v) the international preliminary report on patentability (**Chapter II of the PCT**) should be accompanied by (unfavorable) observations on the clarity of the claims, the description and the drawings, or on the question of the claims being fully supported by the description, [**Rule 66.2(a)(v)**]

(vi) a claim relates to an invention in respect of which no international search report has been established (see **paragraphs 7.013 to 7.021**) and the International Preliminary Examining Authority has decided not to carry out the international preliminary examination in respect of that claim, [**Rule 66.2(a)(vi)**]

(vii) a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out (similarly to **paragraph 5.099** in relation to the international search), [**Rule 66.2(a)(vii)**]

(viii) the national law applied by the national Office which acts as the International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of **Rule 6.4(a)** (this situation being the same as the one described in **paragraphs 5.113** and **7.014** in relation to the international search). [**Rule 66.2(a)**]

10.065. The Authority also proceeds as indicated in **paragraph 10.064** where it notices some defect in the form or contents of the international application. Where observance of the unity of invention requirement (see **paragraphs 5.114 to 5.123**) is in question, see **paragraph 10.072**. [**Rule 66.2(a)(iii)**]

### ***PCT AG-IP 10.066 What is a “written opinion”?***

**PCT AG-IP 10.066 What is a “written opinion”?** A “written opinion” is a notification, issued by the International Preliminary Examining Authority to the applicant, which indicates any comments by the Authority on the matters mentioned in **paragraph 10.064**. The written opinion must fully state the reasons for it, must invite the applicant to submit a written reply and must fix a time limit for the reply (usually two months, but extendible at the applicant’s request – for more details, see **Rule 66.2(d)**). There may be no written opinion if the Authority has no such comments to make (in which case the Authority will proceed directly to the issuance of the international preliminary report on patentability (**Chapter II of the PCT**)). The Authority may issue one or more additional written opinions if time permits, particularly if the applicant makes a prompt and serious attempt to address the Authority’s comments by argument or amendment. [**Rule 66.2 66.4(a)**]

### ***PCT AG-IP 10.067 How may the applicant react to a written opinion by the International Preliminary Examining Authority?***

**PCT AG-IP 10.067 How may the applicant react to a written opinion by the International Preliminary Examining Authority? May the applicant amend the international application at**

**this stage?** The applicant may ask for further clarifications from the International Preliminary Examining Authority and may himself give clarifications to it, since the PCT expressly provides that the applicant has a right to communicate orally, by telephone or personally, or in writing with the Authority (**Article 34(2)(a)**; see also **Rule 66.6**). More specifically, where the applicant receives a written opinion from the Authority on any of the matters referred to in **paragraphs 10.064 and 10.065**, he may respond to that written opinion (see **Article 34(2)(d)**). The response may consist of amendments and/or arguments. Any change – other than the rectification of obvious mistakes (see **paragraphs 11.033 to 11.044**) – in the claims, the description or the drawings (including cancellation of claims, omission of passages in the description or omission of certain drawings) is considered an amendment. For the form of amendments, see **paragraph 10.071**. If the International Preliminary Examining Authority issues one or more additional written opinions, the applicant's reaction possibilities are the same as in the case of the first written opinion. The applicant may request the International Preliminary Examining Authority to give him one or more additional opportunities to submit amendments or arguments if sufficient time remains. [**Article 34(2)(a) and (d) Rule 66.2(b), (c) and (d) 66.3 66.4 66.5 66.6 66.8**]

***PCT AG-IP 10.068 Will amendments and arguments always be taken into account?***

**PCT AG-IP 10.068 Will amendments and arguments always be taken into account?**

Amendments and arguments submitted will be taken into account if they are received in sufficient time. In view of the limited time available for international preliminary examination, however, it is in the applicant's interest to reply as soon as possible to any written opinion. Amendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary report on patentability (**Chapter II of the PCT**) if they are received after the Authority has begun to draw up that opinion or report. [**Rule 66.4bis**]

10.069. It should be noted that the International Preliminary Examining Authority cannot force the applicant to make any change in the international application. In other words the applicant may disregard any opinion of the said Authority, either wholly or in part. Such an attitude may lead to an unfavorable or less favorable international preliminary report on patentability (**Chapter II of the PCT**), but the applicant may prefer such a report (in the hope that he will overcome, in the national phase, any difficulties that it may cause him) to a change which he does not believe in. [ ]

***PCT AG-IP 10.070 May amendments include new matter in the international application?***

**PCT AG-IP 10.070 May amendments include new matter in the international application?** As for amendments under **Article 19** (see **paragraph 9.009**), amendments under **Article 34(2)(b)** may not go beyond the disclosure in the international application as filed. If the International Preliminary Examining Authority considers that any amendments do not comply with this requirement, it will comment accordingly in any written opinion and in the international preliminary report on patentability (**Chapter II of the PCT**), and the report will be established as if such amendment had not been made (see also **paragraph 11.047**). [**Article 34(2)(b) Rule 70.2(c)**]

***PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?***

**PCT AG-IP 10.071 What must be done to effect amendments to the international application before the International Preliminary Examining Authority?** The applicant must submit a replacement sheet for every sheet which, on account of an amendment, differs from the sheet previously filed. The amendment must be submitted with an accompanying letter which explains the difference between the replaced sheet and the replacement sheet and which preferably explains the reasons for the amendment. In addition, the letter must indicate the basis for the amendment in the



**PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking?**

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application. The basis for the amendment must always refer to the application (description, claims, drawings) as originally filed, even if multiple amendments were made during the international phase. When filing amendments to the claims, a complete set of claims in replacement of the claims as originally filed (or previously amended under **Article 19**) shall be submitted. For an example of how the basis for the amendment should be indicated, see **paragraph 9.006**. For the consequences of not furnishing an accompanying letter with the replacement sheets, see **paragraph 11.047A**. Where the amendment consists in the deletion of passages or in minor alterations or additions, the alterations or additions may be made on a copy of the relevant sheet of the international application, provided that the clarity and direct reproducibility of that sheet are not adversely affected. No replacement sheet is required where the amendment results in the cancellation of an entire sheet; such an amendment may be communicated in a letter which preferably explains the reasons for the amendment. For amendments to the claims, see also **paragraphs 9.005 and 9.006** in relation to the international search, which apply *mutatis mutandis*. Where the international application was not filed in the language of publication, any amendments under **Article 34** and any accompanying letter (as well as any letter accompanying **Article 19** amendments) must be in the language of publication. Where the international preliminary examination is carried out on the basis of a translation of the international application (see **paragraphs 10.011, 10.054 and 10.055**), any amendments under **Article 34** and any amendments under **Article 19**, which are to be taken into account, and any accompanying letter must be in the language of that translation. Where such amendments have been or are filed in another language, a translation of the amendments into the language in which the international preliminary examination is carried out must also be furnished (see **paragraphs 5.013, 10.011 and 11.046**). No fee is payable in respect of filing any amendments under **Article 34(2)(b)**. If the amendments or accompanying letter are not in the required language, the International Preliminary Examining Authority will invite the applicant to furnish them within a reasonable time limit. If the applicant fails to furnish the amendments and/or the accompanying letter within the time limit set in the invitation, the International Preliminary Examining Authority shall not take such amendments into account for the purposes of the international preliminary examination. [**Rule 11.14 46.5 55.3 66.8 70.2(c-bis)**]

***PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking?***

**PCT AG-IP 10.072 What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking?** If the International Preliminary Examining Authority considers that the international application does not comply with the unity of invention requirement (see **paragraphs 5.114 to 5.123** for the notion of “unity of invention”), it may choose between two courses of action: it may carry out the international preliminary examination on the entire international application and express its views on the lack of unity of invention in the international preliminary report on patentability (**Chapter II of the PCT**), or it may invite the applicant, at his option, either to restrict the claims so that they meet the requirement (in which case the Authority must specify at least one possibility of restriction) or to pay additional fees (since the preliminary examination fee is calculated to cover cases where unity of invention exists). If the applicant chooses to restrict the claims as required, the examination is carried out on the claims as restricted. If the applicant chooses to pay the additional fees, the international preliminary examination is carried out on the claims for the main invention and those claims in respect of which additional fees were paid, and the report will indicate that such additional fees have been paid. The additional fees may be paid under protest, in which case procedures similar to those explained in relation to the international search apply (see **paragraphs 7.019 and 7.020**). If the applicant neither restricts the claims nor pays additional fees, the examination is carried out on the main invention as identified by the International Preliminary Examining Authority or the applicant, or in cases of doubt as defined in **Rule 68.5** (namely, the invention first mentioned in the claims is considered to be the main invention). [**Rule 68 70.13**]

10.073. A finding of lack of unity of invention may continue to be important during the national phase. Any elected Office which agrees with the finding of lack of unity may, during the national

PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?

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procedure, require the applicant to restrict the claims or to divide the application into a number of divisional applications, or to pay special fees in order to maintain those parts of the international application which do not relate to the main invention (for further details, see **Article 34(3)**). [**Article 34(3)**]

[ ]

***PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?***

**PCT AG-IP 10.074 When must the international preliminary report on patentability ( Chapter II of the PCT ) be established?** The time limit for establishment of the international preliminary report on patentability (**Chapter II of the PCT**) is whichever of the following which expires last: 28 months from the priority date; six months from the time provided under **Rule 69.1** for the start of the international preliminary examination; or six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under **Rule 55.2** (see **paragraphs 10.051 to 10.055**). Thus, under normal circumstances, the applicant receives the report, at the latest, two months before national processing at the elected Offices may start. This ensures that he has time to consider whether, and in which elected Offices, he wants to enter the national phase and to prepare the necessary action (for details, see **National Phase**). [**Article 35(1) Rule 69.2**]

***PCT AG-IP 10.075 What are the form and contents of the international preliminary report***

**PCT AG-IP 10.075 What are the form and contents of the international preliminary report on patentability (Chapter II of the PCT)?** The international preliminary report on patentability (**Chapter II of the PCT**) contains, among other things, a statement (in the form of a simple “yes” or “no”), in relation to each claim which has been examined, on whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability. The statement is, where appropriate, accompanied by the citation of relevant documents together with concise explanations pointing out the criteria to which the cited documents are applicable and giving reasons for the International Preliminary Examining Authority’s conclusions. Other matters which may be included in the report are listed in **paragraphs 10.064 and 10.065**. Where applicable, the report also includes remarks relating to the question of unity of invention (see **paragraph 10.072**). For more details, see **Article 35(1) and (2), Rule 70 and Section 604**. [**Article 35(1) and (2) Rule 70 Section 604**]

***PCT AG-IP 10.076 How are amendments to the international application referred to in the international preliminary report on patentability ( Chapter II of the PCT )?***

**PCT AG-IP 10.076 How are amendments to the international application referred to in the international preliminary report on patentability ( Chapter II of the PCT )?** The international preliminary report on patentability (**Chapter II of the PCT**) identifies the basis on which it is established – that is, whether, and if so, which, amendments have been taken into account. If amendments were made either under **Article 19** and/or **Article 34**, but the applicant failed to submit the required accompanying letter to the International Bureau or the International Preliminary Examining Authority, the report may be established as if the amendments concerned had not been made and the report shall so indicate. The following are attached as “annexes” to the international preliminary report on patentability (**Chapter II of the PCT**): replacement sheets containing amendments under **Article 19** and/or **Article 34**, which have been taken into account, and any accompanying letters, and replacement sheets containing rectifications of obvious mistakes, and

**PCT AG-IP 10.077** May the international preliminary report on patentability ( Chapter II of the PCT ) express a view on the patentability of the invention?

accompanying letter authorized under **Rule 91**. Where a rectification of an obvious mistake is not taken into consideration because it has reached the International Preliminary Examining Authority only after it has begun to draw-up the report and, as a result, was not taken into account, the report shall so indicate and the sheets relating to the rectification will be annexed to the report. Amendments under **Article 19** which have been considered as reversed by an amendment under **Article 34** (see **paragraph 10.026**) or which have been superseded by later replacement sheets, or amendments resulting in the cancellation of entire sheets, are not annexed to the report neither are the letters which accompany such replacement sheets. However, if the International Preliminary Examining Authority considers that the superseding or reversing amendment goes beyond the original disclosure, each superseded or reversed replacement sheet and any letter relating to such sheets are nevertheless annexed to the report. Similarly, if the applicant failed to submit, together with the superseding or reversing amendments, the required accompanying letter, indicating the basis of the amendment in the application as filed, and where, as a result, the report is established as if the superseding or reversing amendments had not been made, each such superseded or reversed replacement sheet and any letter relating to such sheets are nevertheless annexed to the report. [**Rule 70.2(c-bis)** and (e) **70.16**]

***PCT AG-IP 10.077*** *May the international preliminary report on patentability ( Chapter II of the PCT ) express a view on the patentability of the invention?*

**PCT AG-IP 10.077** May the international preliminary report on patentability ( Chapter II of the PCT ) express a view on the patentability of the invention? No, it may not. **Article 35(2)** expressly states that “the international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law.” It should be noted that, in this context, “national law” includes regional patent treaties (the **ARIPO Harare Protocol**, the **Eurasian Patent Convention**, the **European Patent Convention** and the **OAPI Agreement**). [**Article 35(2)**]

***PCT AG-IP 10.078*** *In what language is the international preliminary report on patentability ( Chapter II of the PCT ) established?*

**PCT AG-IP 10.078** In what language is the international preliminary report on patentability ( Chapter II of the PCT ) established? Are translations prepared? The international preliminary report on patentability (**Chapter II of the PCT**) and any annexes are established in the language in which the international application is published – see **paragraphs 9.017 to 9.020** – except where the international preliminary examination is carried out on the basis of a translation (see **paragraphs 5.013, 10.011 and 10.013**), in which case the international preliminary report on patentability (**Chapter II of the PCT**) and annexes are established in the language of that translation. Each elected State may require that the report, if it is not in (one of) the official language(s) of its national Office, be translated into English. If this is the case, the translation of the body of the report is prepared by the International Bureau, which transmits copies to the applicant and to each interested elected Office. If any elected Office requires a translation of annexes to the report, the preparation and furnishing of that translation is the responsibility of the applicant. [**Rule 70.17 72 74**]

***PCT AG-IP 10.079*** *How do the applicant, the International Bureau and the elected Offices receive the international preliminary report on patentability ( Chapter II of the PCT ) and, where applicable, its translation?*

**PCT AG-IP 10.079** How do the applicant, the International Bureau and the elected Offices receive the international preliminary report on patentability ( Chapter II of the PCT ) and, where applicable, its translation? The International Preliminary Examining Authority transmits, on the same day, copies of the international preliminary report on patentability (**Chapter II of the PCT**) (and any annexes – see **paragraph 10.076**) to the applicant and the International Bureau. The latter

**PCT AG-IP 10.080** Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?

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transmits copies of the report (including any annexes) to the elected Offices, as well as a translation into English of the body of the report where that is required by any elected Office in accordance with **Rule 93bis**; a translation of any annexes, if required, must be prepared and sent to the elected Offices concerned by the applicant himself (see **paragraph 10.078** and the **National Phase**). If, in the opinion of the applicant, there are errors in the translation of the international preliminary report on patentability (**Chapter II of the PCT**), he may send written observations on such errors to any interested elected Office and must send a copy of such observations to the International Bureau. As far as comments on the content of the international preliminary report on patentability (**Chapter II of the PCT**) itself are concerned, they should be addressed to the elected Offices during the national phase. [**Article 36(1) 36(3)(a) Rule 71.1 73.2 93bis**]

***PCT AG-IP 10.080*** *Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices?*

**PCT AG-IP 10.080** Is the international preliminary report on patentability ( Chapter II of the PCT ) accessible to persons other than the applicant and the elected Offices? The report is not

published by the International Bureau. According to **Article 36(3)(a)**, the International Bureau communicates the report to elected Offices. As of 1 January 2004, however, if so requested by an elected Office (details of such requests are published in the *Official Notices (PCT Gazette)*), the International Bureau will make available on the WIPO website at:

**[www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf)** the international preliminary report on patentability (**Chapter II of the PCT**), although, not before the expiration of 30 months from the priority date. The International Preliminary Examining Authority may not, unless requested or authorized by the applicant, give copies to anyone other than the applicant and the International Bureau. Once the international preliminary report on patentability (**Chapter II of the PCT**) becomes part of the file in the elected Office, however, the national law applicable by that Office applies as to access to that report and the international preliminary examination file by persons other than the applicant, as indicated in **paragraph 11.072**. [**Article 36(3)(a) 38(1) Rule 73.2(a) 94.1 94.2 94.3**]

***PCT AG-IP 10.081*** *To what extent is the international preliminary examination confidential?*

**PCT AG-IP 10.081** To what extent is the international preliminary examination confidential?

Neither the International Bureau nor the International Preliminary Examining Authority may, unless requested or authorized to do so by the applicant, give information on the issuance or non-issuance of an international preliminary report on patentability (**Chapter II of the PCT**) or on the withdrawal or non-withdrawal of the demand or of any election. Information from the international preliminary examination file may, however, be available through some elected Offices. For further explanation of the extent to which the international application is treated as confidential and of the possibilities for third parties to obtain information concerning the international preliminary examination, see **paragraphs 11.072 to 11.074**. [**Article 38 Rule 94**]

***PCT AG-IP 10.082*** *How can the applicant obtain copies of the documents cited in the international preliminary report on patentability ( Chapter II of the PCT )?*

**PCT AG-IP 10.082** How can the applicant obtain copies of the documents cited in the international preliminary report on patentability ( Chapter II of the PCT )? The applicant may obtain copies of those documents cited in the international preliminary report on patentability (**Chapter II of the PCT**) which were not cited in the international search report by requesting them from the International Preliminary Examining Authority. **Annex E** indicates the fees charged by such Authorities for furnishing copies on request. [**Article 36(4) Rule 71.2**]

PCT AG-IP 10.083 What is the effect and usefulness of the international preliminary report on patentability ( Chapter II of the PCT ) in the national phase?

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***PCT AG-IP 10.083 What is the effect and usefulness of the international preliminary report on patentability ( Chapter II of the PCT ) in the national phase?***

**PCT AG-IP 10.083 What is the effect and usefulness of the international preliminary report on patentability ( Chapter II of the PCT ) in the national phase?** Since the international preliminary report on patentability (**Chapter II of the PCT**) contains an opinion on the compliance of the international application with internationally accepted criteria of novelty, inventive step (non-obviousness) and industrial applicability, it provides the applicant with a strong basis on which to evaluate the chances of obtaining patents in the various Offices in the **national phase**. While the international preliminary report on patentability (**Chapter II of the PCT**) is not binding on elected Offices, it carries considerable weight with them, and a favorable report will assist the prosecution of the application before the elected Offices. An elected Office which is the same national or regional Office as that which carried out the international preliminary examination as International Preliminary Examining Authority under the PCT will generally proceed rapidly to the grant of a patent in the national phase if the international preliminary report on patentability (**Chapter II of the PCT**) is favorable to the international application. [ ]

## **PCT Appl. Guide - Int. Phase - 11. Miscellaneous Questions International Phase**

### ***PCT AG-IP 11.001 For what purposes may an agent be appointed?***

**PCT AG-IP 11.001 For what purposes may an agent be appointed?** The applicant may appoint an agent or agents to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority - that is, for the purposes of the international phase generally. The applicant may also appoint an agent or agents to represent him specifically before the International Searching Authority, any Authority specified for supplementary search or before the International Preliminary Examining Authority. Agents appointed for the purposes of the international application during the international phase will not be automatically regarded as agents by national Offices during the national phase; other agents may thus have to be appointed for the purposes of the national phase before each of the various designated Offices (see **National Chapters**, (Summaries)). [Rule 90.1]

### ***PCT AG-IP 11.002 Who may be appointed as an agent?***

**PCT AG-IP 11.002 Who may be appointed as an agent?** A person may be appointed as agent for the international phase generally if he has the right to practice before the Office with which the international application is filed. Where the international application is filed with the International Bureau as receiving Office (see **paragraph 5.008**), any person who has the right to practice before the national (or regional) Office of, or acting for, a Contracting State of which the applicant (or, if there are two or more applicants, any of the applicants) is a resident or national (see **Annex C**) may be appointed as agent. A person may be appointed as agent to represent the applicant specifically before the International Searching Authority, before any Authority specified for supplementary search, or before the International Preliminary Examining Authority if he has the right to practice before the Office or intergovernmental organization which acts as that Authority. The right to practice before an Office or organization is governed by the national law applied by the Office or organization concerned. [Article 49 Rule 83.1bis 90.1]

### ***PCT AG-IP 11.003 Are all applicants required to have the same agent?***

**PCT AG-IP 11.003 Are all applicants required to have the same agent?** Each applicant is free to appoint his own agent. Ordinarily, however, it will be convenient for all of two or more applicants to appoint the same person to represent all of them as their "common agent" (or to appoint a number of common agents – for example, the partners in the firm of patent attorneys or patent agents which acts for the applicant). [ ]

### ***PCT AG-IP 11.004 Can an agent appoint a sub-agent?***

**PCT AG-IP 11.004 Can an agent appoint a sub-agent?** Any agent who has been appointed to represent the applicant for the international phase in general may appoint a sub-agent to represent the applicant, unless there is an indication otherwise in the document by which the original agent was appointed. Sub-agents may be appointed to represent the applicant either generally or before a specific International Searching Authority, Authority specified for supplementary search or International Preliminary Examining Authority. A sub-agent's appointment is subject to the same qualifications as to the right to practice as are set out in **paragraph 11.002**. [Rule 90.1(d)]

### ***PCT AG-IP 11.005 What is a "common representative" of the applicants?***

PCT AG-IP 11.006 What happens if no common agent or common representative is specifically appointed?

**PCT AG-IP 11.005 What is a “common representative” of the applicants?** Where there are two or more applicants and they have not appointed a common agent representing all of them for the purposes of the international phase in general, one of the applicants may be appointed by the other applicants as their common representative. A person may only be appointed as common representative if he is a national or resident of a Contracting State and thus is entitled himself to file an international application. [Article 9 Rule 2.2bis 90.2(a)]

***PCT AG-IP 11.006 What happens if no common agent or common representative is specifically appointed?***

**PCT AG-IP 11.006 What happens if no common agent or common representative is specifically appointed?** If there are two or more applicants and they do not appoint a common agent or a common representative, the first-named applicant who has the right to file an international application with the receiving Office concerned (see paragraphs 5.020 to 5.023) will automatically be considered to be the common representative of all the applicants ("deemed common representative"). Such "deemed common representative" may do most of the things which an appointed agent or an appointed common representative may do on behalf of all the applicants, including signing the demand and many other documents for the purposes of the PCT. However, the "deemed common representative" may not validly sign, on behalf of the other applicants, the request itself or a notice effecting withdrawal of the international application, a designation, a priority claim, the demand or an election. If the "deemed common representative" has himself appointed an agent, that agent is able to perform any act which could be performed by the "deemed common representative" himself on behalf of the other applicants, including the signing of certain documents with effect for all the applicants (but, similarly, not the request or a notice of withdrawal). [Rule 2.2bis 90.2(b) 90bis.5]

***PCT AG-IP 11.007 How is an agent or common representative appointed?***

**PCT AG-IP 11.007 How is an agent or common representative appointed?** The appointment of an agent or common representative may be effected in the request and or the demand (see paragraphs 5.041 to 5.049, and 10.019 to 10.023) in a separate power of attorney (see paragraph 11.008) or in a general power of attorney (see paragraph 11.009). Where there are two or more applicants, a common agent or common representative, representing all of them, may be appointed by a combination of those methods, provided that each applicant signs either the request, the demand or a power of attorney. [Rule 90.4(a)]

***PCT AG-IP 11.008 What are the requirements with respect to a separate power of attorney?***

**PCT AG-IP 11.008 What are the requirements with respect to a separate power of attorney?**

Where the appointment of an agent or common representative is effected by a separate power of attorney, that power of attorney must be submitted to either the receiving Office or the International Bureau. However, any receiving Office, International Searching Authority, Authority specified for supplementary search, International Preliminary Examining Authority and/or the International Bureau may waive the requirement that a separate power of attorney be submitted to it (details of such waivers are published in the *Official Notices (PCT Gazette)*) in the *PCT Newsletter* and on the WIPO website at: [www.wipo.int/pct/en/texts/waivers.html](http://www.wipo.int/pct/en/texts/waivers.html). It should be noted, however, that a waiver made by an Office, an Authority or the International Bureau does not apply where the agent or the common representative submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4. A suitable model form for a separate power of attorney is available on the WIPO website at: [www.wipo.int/pct/en/forms/pa/index.htm](http://www.wipo.int/pct/en/forms/pa/index.htm). [Rule 90.4]

PCT AG-IP 11.009 Can an agent be appointed by a general power of attorney to represent the applicant in relation to any international application filed by that applicant?

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***PCT AG-IP 11.009 Can an agent be appointed by a general power of attorney to represent the applicant in relation to any international application filed by that applicant?***

**PCT AG-IP 11.009 Can an agent be appointed by a general power of attorney to represent the applicant in relation to any international application filed by that applicant?** Yes, such a general appointment can be made. The original general power of attorney must be filed with the receiving Office if the appointment was for the purposes of the international phase generally, or with the International Searching Authority, the Authority specified for supplementary search, or the International Preliminary Examining Authority if the appointment was specifically to represent the applicant before that Authority. The appointment will then be effective in relation to any particular application filed by that applicant provided that the general power of attorney is referred to in the request, the demand or a separate notice. However, any receiving Office, International Searching Authority, Authority specified for supplementary search, and/or International Preliminary Examining Authority may waive the requirement that a copy of the general power of attorney be attached to the request, the supplementary search request, the demand or any separate notice (details of such waivers are published in the *Official Notices (PCT Gazette)*). For an Office or Authority that has not made a waiver of the requirement, a copy of the general power of attorney must be attached to the request, supplementary search request, demand or separate notice. That copy of the signed original need not, itself, be separately signed. A suitable model form for a general power of attorney is available on the WIPO website at: [www.wipo.int/pct/en/forms/pa/index.htm](http://www.wipo.int/pct/en/forms/pa/index.htm). It should be noted that a waiver made by an Office or an Authority does not apply where the agent or the common representative submits any notice of withdrawal referred to in **Rules 90bis.1 to 90bis.4**. [Rule 90.5]

***PCT AG-IP 11.010 What is the legal position of an agent or common representative?***

**PCT AG-IP 11.010 What is the legal position of an agent or common representative?** Any act by or in relation to an agent or common representative has the effect of an act by or in relation to the applicant or applicants whom the agent represents for the purposes of the procedure before the receiving Office, International Bureau, International Searching Authority, Authority specified for supplementary search, and/or International Preliminary Examining Authority, depending on whether the appointment was for general purposes or for the purposes of the procedure before a particular authority (see **paragraph 11.001**). In particular, an agent or common representative is able to sign documents in connection with the international application on behalf of the applicants. However, an applicant who is the "deemed common representative" (see **paragraph 11.006**) may not sign notices of withdrawal on behalf of the other applicants (see **paragraphs 11.048, 11.050, 11.056 and 11.060**). If there are two or more agents representing the same applicant or applicants, an act by or in relation to any of those agents has the effect of an act by or in relation to that applicant or those applicants. [Rule 90.3]

***PCT AG-IP 11.011 Can the appointment of an agent or a common representative be revoked?***

**PCT AG-IP 11.011 Can the appointment of an agent or a common representative be revoked?** Yes, it can. The document containing the revocation must be signed by the persons who made the appointment or by their successors in title. The appointment of a sub-agent may also be revoked by the applicant concerned. If the appointment of an agent is revoked, any appointment of a sub-agent by that agent is also considered revoked. [Rule 90.6(a)]

11.012. The appointment of an agent for the international phase in general automatically has the effect, unless otherwise indicated, of revoking any earlier such appointment of an agent. The



PCT AG-IP 11.014 How can an agent or common representative renounce his appointment?

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appointment of a common representative similarly has the effect, unless otherwise indicated, of revoking any earlier appointment of a common representative. [Rule 90.6(b) and (c)]

11.013. The rules for signing and submission of a power of attorney apply *mutatis mutandis* to a revocation of an appointment (see paragraphs 11.007 and 11.008). [ ]

***PCT AG-IP 11.014 How can an agent or common representative renounce his appointment?***

**PCT AG-IP 11.014 How can an agent or common representative renounce his appointment?**

Renunciation of an appointment may be made by means of a notification signed by the agent or common representative. The rules for signing and submission of a power of attorney apply *mutatis mutandis* to a renunciation (see paragraphs 11.007 and 11.008). The applicant is informed of the renunciation by the International Bureau. [Rule 90.6(d) and (e) Section 425]

[ ]

***PCT AG-IP 11.015 To whom will correspondence be addressed by the various authorities under the PCT?***

**PCT AG-IP 11.015 To whom will correspondence be addressed by the various authorities under the PCT?** Where there is a sole applicant in relation to an international application, correspondence will be sent to the applicant at his indicated address; or, if he has appointed one or more agents, to that agent or the first-mentioned of those agents; or, if he has not appointed an agent but has indicated a special address for notifications (see paragraphs 5.030 and 5.051), at that address. [Section 108(b)]

11.016. Where there are two or more applicants who have appointed one or more common agents, correspondence will be addressed to that agent or the first-mentioned of those agents. Where no common agent has been appointed, correspondence will be addressed to the common representative (either the appointed common representative or the applicant who is the "deemed common representative" – see paragraphs 11.005 and 11.006) at his indicated address; or, if the common representative has appointed one or more agents, to that agent or the first-mentioned of those agents; or, if the common representative has not appointed an agent but has indicated a special address for notifications, at that address. [Section 108(c)]

11.017. Where one or more agents have been appointed specifically to represent the applicant(s) before the International Searching Authority, the Authority specified for supplementary search, or the International Preliminary Examining Authority, correspondence will be addressed by the Authority concerned to that agent or the first-mentioned of those agents. [Section 108(d)]

[ ]

***PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?***

**PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?** Where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common

PCT AG-IP 11.018 What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?

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representative, the applicant or the receiving Office should ask the International Bureau to record the change. If so requested, the International Bureau records the change and notifies all Offices and PCT Authorities interested in the change accordingly. Any such recording is free of charge. If the request for a change in the person of the applicant is made by the applicant himself or by his agent, it is not necessary to produce for the International Bureau any assignment or other document by means of which the change in the person of the applicant was effected. Assignments and other documents relating to the right to file the international application may, however, be required by the designated Offices once national processing has started; the **National Chapters** give details on this matter. [**Rule 92bis Section 422**]

11.019. It is not necessary, in order for a change in the person of the applicant to be recorded, that the new applicant be a resident or national of a PCT Contracting State; the PCT does not contain any restriction as to whom an international application may be assigned. The applicant's right to file the international application is determined on the basis of the applicant(s) indicated in the request at the time when the international application is filed (see **paragraph 5.020**). However, the residence and nationality of the new applicant must be borne in mind in considering whether that applicant has the right to file a demand for international preliminary examination (see **paragraphs 10.017 and 10.018**).  
[ ]

11.020. The request for recording of the change must be made in writing and may be sent either to the receiving Office or to the International Bureau. The International Bureau records the change if the request for recording is received by it before the expiration of 30 months (regardless of the precise time limit applicable, Office by Office, such as 31 months or later) from the priority date, regardless of whether a demand for **Chapter II** has been filed before the expiration of 19 months from the priority date, and regardless of whether any of the Offices designated has notified the International Bureau that the modification of PCT **Article 22(1)** is incompatible with its applicable national law. The International Bureau will also notify all designated Offices of any such changes. The legal effect of the recorded change will vary from Office to Office. In any case, as is generally the case, Offices are entitled to require additional evidence or documents in the national phase regarding any change requested during the international phase (for information on the Offices which require additional documents in the national phase, including a new request for change specifically for the national phase before a particular Office, see the relevant Summary in the **National Chapters**). If the request is made shortly before the expiration of the time limit indicated above, it is recommended that it be sent directly to the International Bureau so as to be actually received by the latter on time. [**Article 22(1) 39(1)(a) Section 422(a)(iii)**]

11.021. Where the request for a change in the person of the applicant is made by a person not yet named in the request (hereinafter referred to as "the new applicant") without the written consent of the applicant, a copy of an assignment or other documentary evidence supporting the change in person must be filed with the request for the change. Where the request for a change in the person of the applicant is made by an agent of the new applicant, a power of attorney signed by the new applicant must be furnished at the same time unless the Office or Authority with which the request is filed has waived the requirement that a separate power of attorney, or a copy of a general power of attorney, has to be submitted (see **paragraphs 11.008 and 11.009**). [**Rule 90.3**]

11.022. Where the request for a change in the person of the applicant is made by the agent of record, a power of attorney appointing the agent, signed by the new applicant, should be furnished at the same time, if the agent is to represent the new applicant unless the Office or Authority with which the request is filed has waived the requirement that a separate power of attorney, or a copy of a general power of attorney, has to be submitted (see **paragraphs 11.008 and 11.009**). [**Rule 90.3 92bis.1(a)**]

[ ]

PCT AG-IP 11.023 What should be done in the case of the death of the applicant during the international phase?

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***PCT AG-IP 11.023 What should be done in the case of the death of the applicant during the international phase?***

**PCT AG-IP 11.023 What should be done in the case of the death of the applicant during the international phase?** The answer to this question depends on the national law applicable in such a case. The successor to the rights of the applicant (whether his heir, a legal representative, the estate represented by a legal representative, etc.) should be indicated as the new applicant, and a request for such a change to be recorded accordingly should be made under **Rule 92bis.1** (see the procedure outlined in **paragraphs 11.018 to 11.022**). The reason for the requested change must be indicated. Documentary evidence proving the right to the application is not required during the international phase (although it may be required by any designated Office for the purposes of the national phase of processing) except in the case referred to in **paragraph 11.025**. [**Article 27(2) Rule 92bis.1(a)**]

11.024. If the deceased applicant was the inventor and if the United States of America, which requires that the applicant be the inventor, is designated, the legal representative or the heir of the deceased applicant/inventor must be named as the new applicant for the United States of America. A request should be made for the recording of a change in the person of the applicant in such a case, as follows (for instance): "SMITH, Alfred, legal representative of JONES, Bernard (deceased)" or "SMITH, Alfred, heir of JONES, Bernard (deceased)," and the residence, nationality and address of the legal representative or heir should be indicated rather than those of the deceased applicant/inventor. [**Article 27(3) Rule 18.4(c) 92bis.1(a)**]

***PCT AG-IP 11.025 What should be done if the inventor died before the international application was filed?***

**PCT AG-IP 11.025 What should be done if the inventor died before the international application was filed?** In such a case, the request must indicate the name of the deceased inventor with an indication that he is deceased, for instance: "JONES, Bernard (deceased)." For the case of a designation for which the inventor must be the applicant, see **paragraph 11.024**. In the latter case, since the right of the applicant to file the international application (see **paragraph 5.020**) depends on the nationality or residence of the heir or the legal representative, his nationality and residence must be indicated. [**Article 9 Rule 18.1**]

***PCT AG-IP 11.026 What should be done in the case of the death of the inventor during the international phase?***

**PCT AG-IP 11.026 What should be done in the case of the death of the inventor during the international phase?** In such a case, no action is required, except if the United States of America is designated (in which case, what is said in **paragraph 11.024** applies). [ ]

[ ]

***PCT AG-IP 11.027 What must be done if the applicant is temporarily unavailable to sign the international application?***

**PCT AG-IP 11.027 What must be done if the applicant is temporarily unavailable to sign the international application?** Where an applicant is temporarily unavailable, the international application can be filed without his signature. The lack of an applicant's signature or of a power of attorney signed by him, where either of these might be required, are correctable defects under **Article 14(1)(a)(i) and (b)**, and can be remedied by filing a copy of the request (or, where the request has been signed by an agent, of a power of attorney (where this might be necessary)), duly signed by

PCT AG-IP 11.028 Can the international application proceed if an applicant/inventor for the United States of America refuses to sign the request or cannot be found or reached?  
the applicant within the time limit fixed by the receiving Office for the correction of these potential defects (see **paragraph 6.032**). [**Article 14(1)(a)(i) 14(1)(b) Rule 26.2 26.2bis Section 316**]

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***PCT AG-IP 11.028 Can the international application proceed if an applicant/inventor for the United States of America refuses to sign the request or cannot be found or reached?***

**PCT AG-IP 11.028 Can the international application proceed if an applicant/inventor for the United States of America refuses to sign the request or cannot be found or reached?** The PCT provides a special procedure, where two or more applicants file an international application designating the United States of America, which enables the international application to proceed if an applicant/inventor for the United States of America refuses to sign or cannot be found or reached after diligent effort. Its operation is limited to signature of the request by applicants for the purposes of the designation of a State whose national law requires that national applications be filed by the inventor (the United States of America is the only Contracting State to have such a requirement in its national law – see **paragraphs 5.021 and 5.035**). [**Rule 4.15(b)**]

11.029. It is provided by **Rule 4.15(b)** that, where an applicant/inventor for the designation of the United States of America refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant/inventor if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned. If such a statement is furnished to the satisfaction of the receiving Office, the international application complies with the requirements of **Article 14(1)(a)(i)** for the purposes of all designated States (including the United States of America) without adverse consequences in the international phase. However, additional proof may be required by the **United States Patent and Trademark Office** after entry into the national phase if the required oath or declaration by the inventor (see **National Phase**) is not signed by all the applicant/inventors. [**Rule 4.15(b)**]

***PCT AG-IP 11.030 What is the consequence if a satisfactory statement explaining a lack of signature of an applicant/inventor for the United States of America cannot be furnished?***

**PCT AG-IP 11.030 What is the consequence if a satisfactory statement explaining a lack of signature of an applicant/inventor for the United States of America cannot be furnished?** As long as the international application has been signed by at least one of the applicants, there is no further consequence. [**Rule 26.2bis(a)**]

***PCT AG-IP 11.031 Do similar provisions apply to excuse non-signature of other documents connected with the international application?***

**PCT AG-IP 11.031 Do similar provisions apply to excuse non-signature of other documents connected with the international application?** Provisions similar to **Rule 4.15(b)** apply to excuse a lack of signature by an applicant/inventor for the United States of America of certain other documents connected with the international application, provided that a similar statement is furnished explaining the lack of signature to the Office or Authority concerned. These documents are the demand and a notice of withdrawal of the international application, a designation, a priority claim, the demand or an election. Note, however, that the signatures of all the applicants are not required for all of those documents – for example, the demand may be signed by the common representative (including an applicant who is the “deemed common representative” – see **paragraph 11.006**). [**Rule 53.8(b) 90bis.5**]

11.032. The following documents will also be accepted without the signature of an applicant/inventor for the United States of America in the circumstances specified: [ ]

(i) the demand need not, under **Rule 53.8(b)**, be signed by the applicant/inventor concerned if he did not sign the request but that lack of signature was explained in a statement, to the satisfaction of the receiving Office, under **Rule 4.15(b)** (see **paragraph 11.029**); [**Rule 53.8(b)(ii)**]

(ii) a notice of withdrawal of the international application, a designation or a priority claim need not be signed by the applicant/inventor concerned if he did not sign the request but that lack of signature was explained in a statement, to the satisfaction of the receiving Office, under **Rule 4.15(b)**; [**Rule 90bis.5(b)(ii)**]

(iii) a notice of withdrawal of the demand or of an election need not be signed by the applicant/inventor concerned if he did not sign the demand, but that lack of signature was explained in a statement, to the satisfaction of the International Preliminary Examining Authority or the International Bureau under **Rule 53.8(b)**. [**Rule 90bis.5(b)(iii)**]

[ ]

### ***PCT AG-IP 11.033 Can obvious mistakes be rectified by the applicant?***

**PCT AG-IP 11.033 Can obvious mistakes be rectified by the applicant?** Obvious mistakes in the international application or other documents submitted by the applicant may generally be rectified if the rectification is requested within the applicable time limit. Any such rectification is effected free of charge. **Rule 91** considers certain mistakes to be not “rectifiable” (see **paragraph 11.037**) and requires applicants to rely on other means of correction (see **Rules 20.4, 20.5, 26bis** and **38.3**). [**Rule 91.1(a)** and (g)]

### ***PCT AG-IP 11.034 What types of mistakes can be rectified?***

**PCT AG-IP 11.034 What types of mistakes can be rectified?** Only obvious mistakes can be rectified. A mistake is considered obvious if it is obvious to the competent authority that, at the relevant date (see **paragraph 11.036**), something else was intended than what appears in the document concerned, and that nothing else could have been intended other than the proposed rectification. In other words, both the mistake and the rectification of that mistake have to be obvious to the competent authority. [**Rule 91.1(c)**]

### ***PCT AG-IP 11.035 Is there any limitation on the kind of documents which an authority could consider when determining whether a mistake is obvious?***

**PCT AG-IP 11.035 Is there any limitation on the kind of documents which an authority could consider when determining whether a mistake is obvious?** If the mistake is contained in the description, the claims or the drawings, or in a correction or any amendment thereof, the competent authority is limited, for the purposes of determining whether both the mistake and the proposed rectification are obvious (see **paragraph 11.034**), to only take into account the contents of the description, the claims and the drawings and, where applicable, of the correction or amendment concerned. If the mistake is contained in the request or a correction thereof or in any other document mentioned in

**Rule 91.1(b)(iv)**, the competent authority should, for the purposes of determining whether both the mistake and the proposed rectification are obvious, take into account not only the content of the international application itself and, where applicable, the correction concerned and any other document referred to in **Rule 91.1(b)(iv)**, but also any other document submitted by the applicant

**PCT AG-IP 11.036** What is the relevant date applied by the competent authority for the determination of whether a mistake and its rectification are obvious?

together with the request, correction or document, as the case may be, including any priority document that is available to that competent authority. Furthermore, the authority should also take into account any other document contained in the authority's international application file at the relevant date (see **paragraph 11.036**). [**Rule 91.1(d)** and (e)]

***PCT AG-IP 11.036*** *What is the relevant date applied by the competent authority for the determination of whether a mistake and its rectification are obvious?*

**PCT AG-IP 11.036** What is the relevant date applied by the competent authority for the determination of whether a mistake and its rectification are obvious? Where the mistake appears in the international application as filed, the relevant date is the international filing date; where the mistake appears in any document other than the international application as filed, including any mistake in a correction or an amendment of the international application, the relevant date is the date on which the document (correction and/or amendment) concerned was submitted. [**Rule 91.1(f)**]

***PCT AG-IP 11.037*** *Which mistakes cannot be rectified?*

**PCT AG-IP 11.037** Which mistakes cannot be rectified? The following mistakes cannot be rectified under **Rule 91**: [**Rule 91.1(g)**]

– omissions of entire elements or sheets of the international application, even if clearly resulting from inattention at the stage of filing of the international application, for example, when copying or assembling sheets; [ ]

– mistakes in the abstract; [ ]

– mistakes in an amendment under **Article 19**, unless the International Preliminary Examining Authority is the competent authority to authorize the rectification of such mistakes under **Rule 91.1(b)(iii)**; [ ]

– mistakes in a priority claim or in a notice correcting or adding a priority claim if the rectification of the mistake would cause a change in the priority date (see **paragraph 6.038** concerning whether such mistakes can instead be corrected under **Rule 26bis.1(a)**); [ ]

***PCT AG-IP 11.038*** *Do rectifications of obvious mistakes need to be authorized by a particular Office?*

**PCT AG-IP 11.038** Do rectifications of obvious mistakes need to be authorized by a particular Office? Yes, rectifications must be authorized by the competent PCT authority, that is: [**Rule 91.1(b)**]

(i) if the mistake is in the request or in any correction thereof – by the receiving Office; [ ]

(ii) if the mistake is in the description, the claims or the drawings or in any correction thereof – by the International Searching Authority, or by the International Preliminary Examining Authority where a demand for international preliminary examination has been made and has not been withdrawn and the date on which the international preliminary examination should start pursuant to **Rule 69.1** has passed; [ ]

(iii) if the mistake is in the description, the claims or the drawings or any correction thereof, or in any amendment under **Article 19** or **34**, and if a demand for international preliminary examination has been made and has not been withdrawn and if the date on which the international preliminary

examination should start pursuant to **Rule 69.1** has passed – by the International Preliminary Examining Authority; [ ]

(iv) if the mistake is in any document other than those referred to in item (i) to (iii) above submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, other than a mistake in the abstract or in an amendment under **Article 19** – by that Office, Authority or Bureau, as the case may be. [ ]

***PCT AG-IP 11.039 Where and when must a request for rectification be sent?***

**PCT AG-IP 11.039 Where and when must a request for rectification be sent?** The request for rectification must be addressed to the authority competent to authorize the rectification (see **paragraph 11.038**). It must be filed within 26 months from the priority date. The request must specify the mistake to be rectified and the proposed rectification; it can also contain a brief explanation if the applicant so wishes. The procedure provided for in **Rule 26.4** (see **paragraph 6.052**) applies as to the manner in which the proposed rectification should be indicated. [ **Rule 91.2**]

***PCT AG-IP 11.040 Can a competent authority invite the applicant to correct an obvious mistake?***

**PCT AG-IP 11.040 Can a competent authority invite the applicant to correct an obvious mistake?** Where the receiving Office, the International Searching Authority, the International Preliminary Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or in any other document, it may invite the applicant to file a request for rectification under **Rule 91**. [**Rule 91.1(h)**]

***PCT AG-IP 11.041 What steps will the competent authority take once a request for rectification of an obvious mistake has been filed?***

**PCT AG-IP 11.041 What steps will the competent authority take once a request for rectification of an obvious mistake has been filed?** Once the applicant has filed a request for rectification of an obvious mistake, the competent authority promptly decides whether to authorize or to refuse the requested rectification and promptly notifies its decision to the applicant and the International Bureau. In case of a refusal, the competent authority should also inform the applicant and the International Bureau of the reasons for the refusal. Where the competent authority has authorized the rectification of an obvious mistake under **Rule 91**, the document concerned shall be rectified in accordance with **Sections 325, 413bis, 511 and 607** of the Administrative Instructions. Where the rectification has been authorized by the receiving Office, the International Searching Authority or the International Bureau, the International Bureau publishes the rectified sheets as part of the international application if the authorization is received or given by the International Bureau before completion of technical preparations for international publication. Where such authorization is received or given only after technical preparations have been completed, the International Bureau will republish the international application in accordance with **Rule 48.2(i)**. Where the rectification is authorized by the International Preliminary Examining Authority, the rectified sheets and the request for rectification of an obvious mistake submitted by the applicant are annexed to the IPRP (**Chapter II of the PCT**). [**Rule 48.2(i) 70.16(a)(iii) 91.3(a) and (b)**]

***PCT AG-IP 11.042 When does the rectification of an obvious mistake become effective?***

**PCT AG-IP 11.042 When does the rectification of an obvious mistake become effective?** If the mistake appears in the international application as filed, the rectification becomes effective as from the international filing date; if the mistake appears in any document other than the international

application as filed, including any mistake in a correction or any amendment to the international application, the rectification becomes effective as from the date on which that document was submitted. [Rule 91.3(c)]

***PCT AG-IP 11.043 What can be done if the authorization of a rectification is refused?***

**PCT AG-IP 11.043 What can be done if the authorization of a rectification is refused?** If the authorization of a rectification is refused, the applicant may request the International Bureau, within two months from the date of the refusal, in writing, to publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, together with the international application. This request is subject to the payment at the same time of a special fee, the amount of which is indicated in **Annex B (IB)**. Once the request for rectification and the reasons for refusal have been published, the applicant may pursue it further before the designated Offices under their national law and practice for the rectification of obvious mistakes. Refused requests for rectification are not annexed to the IPRP except in certain circumstances as set out in **paragraph 10.076**. [Rule 91.3(d) Section 113(b)]

***PCT AG-IP 11.044 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?***

**PCT AG-IP 11.044 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?** Generally, designated and elected Offices must process the international application in the national phase “as rectified”, unless that designated or elected Office has already started the processing or examination of the international application before the date on which that Office is notified under **Rule 91.3(a)** by the International Bureau of the authorization of the rectification concerned. Otherwise, a designated or elected Office may only disregard a rectification that was authorized under **Rule 91.1** if it finds that it would not have authorized the rectification of the obvious mistake if it had been the competent authority. In the latter case, the designated Office may, however, only disregard any rectification that was authorized during the international phase, if it has given the applicant an opportunity to make observations, within a reasonable time limit, on the Office’s intention to disregard the rectification. [Rule 91.3(e) and (f)]

[ ]

***PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?***

**PCT AG-IP 11.045 How, and at what stages, may the claims, description and drawings in an international application be amended?** As described elsewhere in this text, during the international phase the applicant has one opportunity to amend the claims under **Article 19** after receiving the international search report (see **paragraphs 9.004 to 9.011**). Amendments may also be made under **Article 34(2)(b)** to the description, claims and drawings before and during the international preliminary examination procedure (see **paragraphs 10.024 to 10.028**, and **10.067 to 10.071**). Such amendments are in addition to the possibilities for correction of defects under **Article 11** and **Rule 20** (see **paragraphs 6.024 to 6.026**) and **Article 14** and **Rule 26** (see **paragraph 6.032**), and to the possibility for rectification of obvious mistakes under **Rule 91.1** (see **paragraphs 11.033 to 11.044**). Applicants are also guaranteed the opportunity to amend the international application for the purposes of the national phase by virtue of **Articles 28** and **41** (see **National Chapters**). [Article 19 34(2)(b)]

***PCT AG-IP 11.046 In what language should amendments be submitted during the international phase?***



PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?

**PCT AG-IP 11.046 In what language should amendments be submitted during the international phase?** Concerning the language in which amendments of the claims under **Article 19** must be submitted, see **paragraphs 9.004 and 9.017 to 9.019**; concerning the language in which amendments of the description, claims and/or drawings under **Article 34** must be submitted, see **paragraph 10.071**. [Rule 46.3 55.3]

***PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?***

**PCT AG-IP 11.047 May amendments to the claims, description or drawings during the international phase introduce new matter into the international application?** **Article 19(2)** and **Article 34(2)(b)** both provide that amendments are not to go beyond the disclosure in the international application as filed. Compliance will not be checked during the international phase unless the applicant requests international preliminary examination. If the International Preliminary Examining Authority considers that any amendments go beyond the original disclosure, it will comment accordingly in any written opinion of the International Preliminary Examining Authority and in the international preliminary report on patentability (**Chapter II of the PCT**), and the report will be established as if such amendment had not been made (see **paragraphs 10.064(iv)** and **10.070**). Compliance with the requirement may be important during the national phase, when it may be checked by the designated Offices, and non-compliance may result at that stage in adverse consequences such as disallowance of the amendments or the according of a later filing date for any new matter claimed as a result of the amendments concerned. On the other hand, if the national law applicable in a designated Office permits amendments to go beyond the disclosure in the application as filed, non-compliance with the requirement has no consequence in the State concerned. Although customary in most national laws and contained in the **European Patent Convention**, the requirement is not one which – by virtue of the PCT – would bind any of the Contracting States. It is contained in the PCT because most laws provide for it, and it therefore seems to be a useful warning to all applicants planning to make amendments in the international phase. [**Article 19(2)** and **(3) 34(2)(b)** **Rule 66.2(a)(iv)** **70.2(c)**]

***PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?***

**PCT AG-IP 11.047\_a What happens where the claims, description or drawings have been amended, but the replacement sheets were not accompanied by a letter?** The PCT requires that replacement sheets submitted with **Article 19** or **Article 34** amendments must be accompanied by a letter indicating the basis for the amendment in the application as filed (see **paragraph 9.005**, **9.006** and **10.071**). Substantive compliance with this requirement is not checked during the international phase unless the applicant requests international preliminary examination. If the International Preliminary Examining Authority finds that the replacement sheets were either not accompanied by such a letter or that the letter failed to indicate the basis for the amendment, the International Preliminary Examining Authority may establish the international preliminary report on patentability (**Chapter II of the PCT**) as if such amendment had not been made. Compliance with this requirement may also be important during the national phase, when it may be checked by the designated Offices, and failure to comply may result in disallowance of the amendments. [**Article 19(1)** **34(2)(b)** **Rule 46.5(b)(iii)** **66.8** **70.2(c-bis)**]

[ ]

***PCT AG-IP 11.048 Can the applicant withdraw the international application?***

**PCT AG-IP 11.048 Can the applicant withdraw the international application?** The applicant may withdraw the international application by a notice addressed to the International Bureau or to the receiving Office or, where **Article 39(1)** applies, to the International Preliminary Examining Authority, and received before the expiration of 30 months (see **paragraph 5.005**) from the priority date. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the “deemed common representative” (see **paragraph 11.006**) may not sign such a notice on behalf of the other applicants. Where an Office or Authority has waived the requirement that a separate power of attorney, or a copy of a general power of attorney, has to be furnished, the waiver does not apply in respect of any notice of withdrawal. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see **paragraphs 11.027 to 11.032**. [**Rule 90.4(e) 90.5(d) 90bis.1 90bis.5**]

***PCT AG-IP 11.049 How can international publication be prevented?***

**PCT AG-IP 11.049 How can international publication be prevented?** The applicant may prevent international publication by withdrawing the international application, provided that the applicant submits a notice of withdrawal and that the notice of withdrawal reaches the International Bureau before the completion of technical preparations for that publication (see **paragraph 9.013**). The notice of withdrawal may state that the withdrawal is to be effective only on the condition that international publication can still be prevented. In such a case the withdrawal is not effective if this condition cannot be met – that is, if the technical preparations for international publication have already been completed. The same effect may possibly be achieved if, for example through non-payment of the applicable fees, the international application is considered withdrawn and the receiving Office so declares (**Form PCT/RO/117**). Issuance of this declaration by the receiving Office alone, however, will not prevent international publication unless the declaration is also received by the International Bureau before completion of technical preparations for international publication (**Rule 29.1(v)**). [**Rule 90bis.1(c)**]

International publication may be postponed by withdrawing the priority claim as outlined in **paragraphs 11.050 and 11.057**. [ ]

***PCT AG-IP 11.050 Can the applicant withdraw designations?***

**PCT AG-IP 11.050 Can the applicant withdraw designations?** The applicant may withdraw the designation of any State, and in respect of any kind of protection available, or only in respect of some of the kinds of protection available, by a notice addressed to the International Bureau or to the receiving Office or, where **Article 39(1)** applies, to the International Preliminary Examining Authority, and received before the expiration of 30 months (see **paragraph 5.005**) from the priority date. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the “deemed common representative” (see **paragraph 11.006**) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see **paragraphs 11.027 to 11.032**. [**Rule 90bis.2 90bis.5**]

11.051. Withdrawal of the designation of a State which has been elected for the purposes of international preliminary examination automatically results in withdrawal of the corresponding election. [**Rule 90bis.2(a)**]

11.052. Where a State has been designated for the purposes of obtaining both a national patent and a regional patent (see **paragraphs 4.022 to 4.026**, and **5.052 to 5.053**), withdrawal of the designation of that State is taken to mean withdrawal only of the designation for the purpose of obtaining a national

**PCT AG-IP 11.056 Can the applicant withdraw priority claims made in the international application?**

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patent, unless otherwise indicated. In practice, the applicant should always make it clear which of the designations is intended to be withdrawn. [Rule 90bis.2(b)]

11.053. If all designations are withdrawn, the international application itself will be treated as withdrawn. [Rule 90bis.2(c)]

11.054. A designation will not be published if the notice of its withdrawal reaches the International Bureau before the technical preparations for international publication have been completed (see paragraph 9.013). [Rule 90bis.2(e)]

11.055. Where the international application indicates different applicants for different designated States, the withdrawal of a designation may result in the applicant for the designation which is withdrawn being no longer an applicant for any designated State. In such a case, replacement sheets for the request indicating only the remaining applicants, namely those for the States the designations of which have not been withdrawn, should be furnished together with the notice of withdrawal. For example, where the designation of the United States of America has been withdrawn, the corrected request must show that the person who was named as applicant for that State only (and that person must be the inventor) is no longer "applicant and inventor" but "inventor only." Should the applicant fail to submit a replacement sheet, the request is corrected by the receiving Office or by the International Bureau. Whichever authority makes the correction notifies the other and the applicant accordingly. [ ]

***PCT AG-IP 11.056 Can the applicant withdraw priority claims made in the international application?***

**PCT AG-IP 11.056 Can the applicant withdraw priority claims made in the international application?** The applicant may withdraw a priority claim made in the international application by a notice addressed to the International Bureau or to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority, and received before the expiration of 30 months (see paragraph 5.005) from the priority date. Any or all of the priority claims may be so withdrawn. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the "deemed common representative" (see paragraph 11.006) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see paragraphs 11.027 to 11.032. [Rule 90bis.3 90bis.5]

11.057. Where the withdrawal of a priority claim causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not yet expired – for example, the time limit before which processing in the national phase cannot start – is computed from the priority date resulting from the change. (It is not possible to extend the time limit concerned if it has already expired when the priority claim is withdrawn.) However, if the notice of withdrawal reaches the International Bureau after the completion of the technical preparations for international publication, the International Bureau may proceed with the international publication on the basis of the time limit for international publication as computed from the original priority date. [Rule 90bis.3(d) and (e)]

***PCT AG-IP 11.058 Can the applicant withdraw a supplementary search request?***

**PCT AG-IP 11.058 Can the applicant withdraw a supplementary search request?** The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant of the supplementary international search report or the declaration that no such report will be established. However, withdrawal of the request will only result in a refund of any fees paid if the

**PCT AG-IP 11.060 Can the applicant withdraw the demand for international preliminary examination or the election of any State?**

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International Bureau has not yet transmitted any document to the Authority specified for supplementary search. A notice of withdrawal may be addressed either to the International Bureau or to the Authority specified for supplementary search, and the withdrawal will be effective on receipt of the notice by that Authority or the International Bureau. However, if the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration, the report or declaration will still be communicated to each designated Office as required. Where there are two or more supplementary search requests that have been submitted in respect of the same international application, the notice must specify which, of any such requests, is intended to be withdrawn. [**Rule 90bis.3bis**]

11.059. The notice of withdrawal of the supplementary search request must be signed by the applicant or, if there are two or more applicants, by all of them, or by the agent or common representative whose appointment has been effected by each applicant signing, at his choice, the request, the supplementary search request, the demand, or a power of attorney. [ ]

***PCT AG-IP 11.060 Can the applicant withdraw the demand for international preliminary examination or the election of any State?***

**PCT AG-IP 11.060 Can the applicant withdraw the demand for international preliminary examination or the election of any State?** The applicant may withdraw the demand or the election of any State at any time prior to the expiration of 30 months from the priority date by a notice addressed to the International Bureau. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the “deemed common representative” (see **paragraph 11.006**) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see **paragraphs 11.027 to 11.032**. [**Article 37 Rule 90bis.4 90bis.5**]

11.061. In respect of designated Offices which do not apply the 30-month time limit, the applicant should exercise care in withdrawing the demand or elections after the expiration of the time limit under **Article 22** for entry into the national phase, since such withdrawal is treated in each of the elected States concerned as a withdrawal of the international application for that State unless the national phase has already started in that State. If withdrawal of the demand or elections is effected before the expiration of that time limit, however, the international application will not be considered withdrawn, but the applicant will, of course, have to take the usual steps before the expiration of that time limit to enter the national phase (see **paragraph 5.005** and National Phase, **paragraph 3.001**). For further details, see **Article 37(4)**. [**Article 37(4)**]

[ ]

***PCT AG-IP 11.062 What are the rules concerning the computation of time limits?***

**PCT AG-IP 11.062 What are the rules concerning the computation of time limits?** There are detailed provisions in **Rule 80** concerning the computation of time limits (whether expressed in years, months or days), including the case where a time limit expires on a non-working day. The days which are non-working days for the International Bureau are published periodically in the *Official Notices (PCT Gazette)* and in the *PCT Newsletter*. The **PCT Time Limit Calculator** is designed to assist applicants in computing PCT time limits and is available on the WIPO website at:

**[www.wipo.int/pct/en/calculator/pct-calculator.html](http://www.wipo.int/pct/en/calculator/pct-calculator.html)**. International applications or other documents may be filed up to midnight Geneva time and receive the date of the day it was received (irrespective of whether it is filed by fax, online, etc.). Please note that the last page must have been received

before midnight Geneva time (Central European time); see **Rule 80.4**. Where a period starts on the date of a notification, that period may be extended if the notification was actually mailed on a later date or was received more than seven days after the date it bears; see **Rule 80.6** for details. For computation of time limits based on the priority date in cases where the priority claim is withdrawn, see **paragraph 11.057**. [**Rule 80**]

[ ]

***PCT AG-IP 11.063 Can a delay or loss in the mail be excused?***

**PCT AG-IP 11.063 Can a delay or loss in the mail be excused?** **Rule 82** contains detailed provisions governing the situation where a letter arrives late or gets lost due to irregularities in the mail service, for example, because the mail service was interrupted due to a strike. The provisions operate to excuse failure to meet a time limit for filing a document for up to six months after the expiration of the time limit concerned, provided that the document was mailed at least five days before the expiration of the time limit. In order to take advantage of these provisions, the mailing must have been by registered airmail or, where surface mail would normally arrive at the destination concerned within two days of mailing, by registered surface mail. Evidence is required to satisfy the Office or organization concerned, and a substitute document must be filed promptly – see **Rule 82.1(b)** and **(c)** for details. [**Article 48(1)** **Rule 82.1**]

***PCT AG-IP 11.064 Can a delay or loss be excused where a delivery service is used?***

**PCT AG-IP 11.064 Can a delay or loss be excused where a delivery service is used?** Some national Offices and intergovernmental organizations also apply these provisions where a delivery service other than the postal authorities is used to mail documents or letters – see **Rule 82.1(d)** and **(e)** for details, and **Annexes B** for information about which Offices and organizations recognize use of delivery services for this purpose, and in what circumstances **Rule 82.1** will apply to such use. [**Rule 82.1(d)** and **(e)**]

11.065. Special provisions also apply to mail interruptions caused by war, revolution, civil disorder, strike, natural calamity or other like reasons – see **Rule 82.2** for details. [**Rule 82.2**]

[ ]

***PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?***

**PCT AG-IP 11.066 What are the rules concerning the filing of letters, documents and papers?** There are detailed provisions in **Rule 92** concerning letters, documents or papers submitted by the applicant in the course of the international procedure: letters must be signed; any other paper submitted must be accompanied by a letter; letters and documents from the applicant to the receiving Office, the International Searching Authority, the Authority specified for supplementary search, and the International Preliminary Examining Authority must generally be in the language of the international application or, where a translation of the international application has been transmitted or furnished for the purposes of the international search, supplementary international search, international publication or international preliminary examination (see **paragraphs 5.013, 6.020, 8.012, 9.018** and **10.011**), in the language of that translation. However, any letter addressed to the International Bureau must be in English or French. As to the language of any amendments to the claims under **Article 19** (and their accompanying statement), see **paragraphs 9.004** and **9.007**. As to the language of the

PCT AG-IP 11.067 Can documents be filed by telegraph, teleprinter, facsimile machine, etc?

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demand and of any amendments under **Article 34**, see **paragraphs 10.013 and 10.071**. [**Rule 12.1 55.2 92 Section 104**]

***PCT AG-IP 11.067 Can documents be filed by telegraph, teleprinter, facsimile machine, etc?***

**PCT AG-IP 11.067 Can documents be filed by telegraph, teleprinter, facsimile machine, etc?**

**Rule 92.4** governs the use of telegraph, teleprinter, facsimile machine and other like means of communication resulting in the filing of a printed or written document. These means of communication may only be used where the national Office or intergovernmental organization concerned is prepared to receive correspondence by these means. Some Offices and organizations require, for certain or all kinds of documents, that a communication by such admitted means of communication must, in any event, be confirmed by the applicant within 14 days; otherwise the communication may be considered not to have been made. However, failure to comply with such a requirement may be waived in some cases. Even where there is no standing requirement for originals to be furnished, an Office or organization may require the originals in any particular case. Further details on these requirements are set out in **Rule 92.4**, and information as to the practice and requirements applied in particular Offices and organizations is given in **Annexes B**. [**Rule 92.4**]

11.068. Applicants should, before sending a document by a means of telecommunication, check in **Annexes B** to ascertain what the requirements of the addressee are. Where the papers to be submitted are documents making up the international application or replacement sheets containing amendments or corrections to the international application, the original should in any event be mailed as a matter of course on the same or the following day. [ ]

11.069. Where an original is sent to an Office or organization of a document previously transmitted to that Office or organization by a means of telecommunication, the original must be accompanied by a letter identifying the date and means of the earlier transmission. [**Rule 92.4(d)**]

11.070. If part or all of a document received by such means of transmission is illegible, or if part of the document is not received, the document is treated as not having been received to the extent that it is illegible or that the attempted transmission failed, and the Office or organization promptly notifies the applicant accordingly. [ ]

***PCT AG-IP 11.071 May a file reference be used in correspondence?***

**PCT AG-IP 11.071 May a file reference be used in correspondence?** The applicant or his agent may mark a file reference in the box provided for that purpose on the first sheet of the request form (see **paragraph 5.017**), on each page of the other elements of the international application (see **paragraphs 5.105, 5.124 and 5.129**), on the first sheet of the supplementary search request form (see **paragraph 8.013**), on the first sheet of the demand form (see **paragraph 10.015**), and in any other correspondence relating to the international application. The file reference may be composed either of letters of the Latin alphabet or Arabic numerals, or both. It may not exceed 12 characters. The receiving Office, the International Bureau, the International Searching Authority, the Authority specified for supplementary search and the International Preliminary Examining Authority will use the file reference in correspondence with the applicant. [**Section 109**]

[ ]

***PCT AG-IP 11.072 To what extent are international applications treated as confidential?***

PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?

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**PCT AG-IP 11.072 To what extent are international applications treated as confidential?** An international application is confidential in relation to third parties until the international publication date, with only limited and specified exceptions (see **Article 30**). The International Bureau will at any time, at the request of the applicant or any person authorized by the applicant, furnish copies of any document contained in its file, subject to reimbursement of the cost of the service. An order for access made by a court with competent jurisdiction would be taken by the International Bureau as substituting for the applicant's authorization. [**Article 30 38 Rule 94.1(a)**]

11.073. After international publication, the international application itself is publicly available, as are any published amendments under **Article 19** (see **Rule 48.2(f)**), the international search report (see **Article 21(3)** and **Rule 48.2(a)(v)**) (these elements are included in the published international application) and copies of priority documents (noting the exceptions mentioned in **paragraph 9.023**; see **Rule 17.2**). Additionally, in respect of international applications filed on or after 1 July 1998, the International Bureau will, after international publication, furnish copies of any document contained in its file at the request of any person and upon reimbursement of the cost of the service, but subject to the restrictions imposed by **Article 38** in respect of documents relating to the international preliminary examination. However, copies of the written opinion of the International Searching Authority, informal comments on the written opinion of the International Searching Authority, the international preliminary report on patentability (**Chapter I of the PCT**) and any translation thereof are only made available after the expiration of 30 months from the priority date. [**Rule 17.2 44ter 48 94.1(b)**]

**PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?**

**PCT AG-IP 11.074 To what extent is the international preliminary examination confidential?**

Where the applicant requests international preliminary examination, **Article 38** expressly provides that the International Bureau and the International Preliminary Examining Authority may not allow unauthorized access to the file of the international preliminary examination. Access by third parties to papers relating to the international preliminary examination held in the files of the International Bureau and the International Preliminary Examining Authority thus will be permitted only if that is requested or authorized by the applicant. Once the international preliminary report on patentability (**Chapter II of the PCT**) has been established, the report is communicated to elected Offices. Third parties may be able, if the national law applicable by an elected Office so provides or permits, to gain access to the report as part of the application file of the elected Office. Furthermore, the International Bureau will, if so requested by an elected Office (details of such requests are published in the *Official Notices (PCT Gazette)*), furnish copies of the international preliminary report on patentability (**Chapter II of the PCT**) on behalf of an elected Office that has made such a request. After the international preliminary report on patentability (**Chapter II of the PCT**) has been established, elected Offices may gain access to the file of the International Preliminary Examining Authority. In addition, in respect of international applications filed on or after 1 July 1998, an elected Office may, in turn, allow access by any person to documents on its file which relate to the international preliminary examination. Such access may be allowed only to the same extent as provided by the national law for access to the file of a national application, and may not be given before the international publication of the international application. The furnishing of copies of documents may be subject to reimbursement of the cost of the service. [**Article 36(3)(a) 38 Rule 94.1 94.2 94.3**]

[ ]

**PCT AG-IP 11.075 When must an international application include a reference to biological material and/or to its deposit with a depositary institution?**

**PCT AG-IP 11.075 When must an international application include a reference to biological material and/or to its deposit with a depositary institution?** The PCT does not require the inclusion of such a reference in an international application; it merely prescribes the contents of any "reference to deposited biological material" (defined as "particulars given ... with respect to the deposit of biological material ... or to the biological material so deposited") which is included in an international application, and when such a reference must be furnished. It follows that the applicant will see a need to make such a reference only when it is required for the purpose of disclosing the invention claimed in the international application in a manner sufficient for the invention to be carried out by a person skilled in the art – that is, when the law of at least one of the designated States provides for the making, for this purpose, of a reference to deposited biological material if the invention involves the use of biological material that is not available to the public. **Annex L** lists those national (or regional) Offices of, or acting for, the Contracting States whose national law provides for the making of a reference to deposited biological material for the purposes of patent procedure; those national (or regional) Offices whose laws do not provide for such references are indicated in **Annexes B** (in some cases together with information given by those Offices on the possibility of referring in the international application to deposits of biological material even though the applicable national law does not provide specially for it). Where any indications are furnished separately from the description and are received by the International Bureau before the completion of technical preparations for international publication, the date of receipt by the International Bureau and the indication will be included in the published international application. [**Rule 13bis.1 48.2(a)(viii)**]

***PCT AG-IP 11.076 What effect does the PCT give to such a reference?***

**PCT AG-IP 11.076 What effect does the PCT give to such a reference?** A reference to deposited biological material made in accordance with the requirements of the PCT must be regarded by each of the designated Offices as satisfying the requirements of the national law applicable in that Office with regard to the contents of such references and the time for furnishing them. [**Rule 13bis.2**]

***PCT AG-IP 11.077 May the reference be made for the purposes of only some of the designated States?***

**PCT AG-IP 11.077 May the reference be made for the purposes of only some of the designated States?** A reference may be made for the purposes of all designated States or for one or only some of the designated States. A reference is considered to be made for the purpose of all designated States unless it is expressly made for certain designated States only. References to different deposits may be made for the purposes of different designated States. [**Rule 13bis.5**]

***PCT AG-IP 11.078 What are the indications which must be given in the reference with regard to the deposit of biological material?***

**PCT AG-IP 11.078 What are the indications which must be given in the reference with regard to the deposit of biological material?** There are two kinds of indication which may have to be given, namely: [**Rule 13bis.3 12.1ter**]

- (i) indications specified in the **PCT Regulations** themselves; and [ ]
- (ii) additional indications which have been notified by the national (or regional) Office of (or acting for) a State designated in the international application and which have been published in the **Official Notices (PCT Gazette)**; these additional indications may relate not only to the deposit of the biological material but also to the biological material itself (see **paragraph 11.079**). [ ]

The indications in the first category are: [ ]



PCT AG-IP 11.079 What are the indications concerning biological material itself which must be given in the reference?

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(i) the name and address of the depositary institution with which the deposit was made; [ ]

(ii) the date of the deposit with that institution; and [ ]

(iii) the accession number given to the deposit by that institution. [ ]

**Annex L** sets out, for each national (or regional) Office, the additional indications (if any) in the second category which are required to be given. These indications must be furnished both in the language in which the international application is filed and, where a translation of the international application is required under **Rule 12.3(a)** or **12.4(a)**, in the language of that translation. [ ]

***PCT AG-IP 11.079 What are the indications concerning biological material itself which must be given in the reference?***

**PCT AG-IP 11.079 What are the indications concerning biological material itself which must be given in the reference?** The national laws of some of the national (or regional) Offices require that, besides indications concerning the deposit of biological material, an indication be given concerning the biological material itself, such as, for example, a short description of its characteristics, at least to the extent that this information is available to the applicant. These requirements must be met in the case of international applications for which any such Office is a designated Office, provided that the requirements have been notified to the International Bureau and published in the *Official Notices (PCT Gazette)*. **Annex L** indicates, for each of the national (or regional) Offices, the requirements (if any) of this kind which have been so notified and published. [**Rule 13bis.3(a)(iv)** **13bis.7(a)**]

***PCT AG-IP 11.080 At what time must the reference (with the indications which must be contained therein) be made?***

**PCT AG-IP 11.080 At what time must the reference (with the indications which must be contained therein) be made?** If any indication is not included in a reference to deposited biological material contained in the international application as filed, it may be furnished to the International Bureau within 16 months from the priority date unless the International Bureau has been notified (and, at least two months prior to the filing of the international application, has published in the *Official Notices (PCT Gazette)*) that the national law applicable by a designated Office requires in relation to national applications that the indication be furnished earlier. If any of the indications are furnished to the International Bureau after the expiration of 16 months from the priority date but before the technical preparations for international publication have been completed, those indications will be considered by any designated Office to have been furnished on the last day of the 16-month time limit. If the applicant makes a request for early publication (see **paragraph 9.014**), all indications should be furnished by the time the request is made, since any designated Office may regard any indication not furnished when the request is made as not having been furnished in time. **Annex L** specifies, for each national (or regional) Office whose national law requires a reference to deposited biological material to be furnished earlier than 16 months after the priority date, the applicable time limit(s) for furnishing such indications. [**Rule 13bis.4** **13bis.7(a)(ii)**]

***PCT AG-IP 11.081 What is the consequence of failure to furnish an indication on time?***

**PCT AG-IP 11.081 What is the consequence of failure to furnish an indication on time?** No check is made in the international phase to determine whether a reference has been furnished within the prescribed time limit. However, where the indications were received after the technical preparations for international publication have been completed, the International Bureau notifies the designated Offices of the date(s) on which indications not included in the international application as

filed were furnished to it. Failure to include a reference to deposited biological material (or any indication required in such a reference) in the international application as filed, or failure to furnish it (or the indication) within the prescribed time limit, has no consequence if the national law does not require the reference (or indication) to be furnished in a national application. Where there is a consequence, it is the same as that which applies under the national law. [Rule 13bis.3(b) 13bis.4 48.2(a)(viii)]

***PCT AG-IP 11.082 Where should the reference be made?***

**PCT AG-IP 11.082 Where should the reference be made?** To the extent that indications relating to the deposit of biological material are not given in the description, they may be furnished on a separate sheet, for which purpose **Form PCT/RO/134** (see WIPO website at: [www.wipo.int/pct/en/forms/](http://www.wipo.int/pct/en/forms/)) should preferably be used. That separate sheet may be filed after the international application is filed. If the sheet is submitted when the international application is filed, a reference to it should be made in the check list contained on the last sheet of the request form (see website address above ). Certain designated Offices require that the indications relating to the deposit of biological material must be included in the description at the time of filing (see **Annex L**) so the sheet, if submitted when the international application is filed, may need to be included as one of the sheets of the description; otherwise the indications given in it will not be taken into account by those Offices in the national phase. If the sheet is furnished to the International Bureau later (see **paragraph 11.080**), it must be enclosed with a letter. **Form PCT/RO/134** may also be prepared using the PCT-SAFE software (see **paragraph 5.015**). [Section 209]

***PCT AG-IP 11.083 How does the applicant decide on the depositary institution with which to deposit the biological material?***

**PCT AG-IP 11.083 How does the applicant decide on the depositary institution with which to deposit the biological material?** Each national (or regional) Office whose national law provides for deposits of biological material for the purposes of patent procedure notifies the International Bureau of the depositary institutions with which the national law permits such deposits to be made. Information on the institutions notified by each of those Offices is published by the International Bureau in the *Official Notices (PCT Gazette)*. **Annex L** indicates the institutions with which deposits may be made. [Rule 13bis.7(b)]

11.084. A reference to a deposit cannot be disregarded by a designated Office for reasons pertaining to the institution with which the biological material was deposited if the deposit referred to is one made with a depositary institution notified by that Office. Thus, by consulting the *Official Notices (PCT Gazette)* (or **Annex L**), the applicant can be sure that he has deposited the biological material with an institution which will be accepted by the designated Office. [Rule 13bis.5(c)]

***PCT AG-IP 11.085 Does a reference in an international application to the deposit of biological material involve the possibility of a sample being obtained by the International Searching Authority or the International Preliminary Examining Authority?***

**PCT AG-IP 11.085 Does a reference in an international application to the deposit of biological material involve the possibility of a sample being obtained by the International Searching Authority or the International Preliminary Examining Authority?** International Searching Authorities and International Preliminary Examining Authorities may not require the furnishing of a sample of deposited biological material for the purposes of international search or international preliminary examination, respectively. [Rule 13bis.6]

PCT AG-IP 11.086 What possibility is there, when a reference is made in an international application to the deposit of biological material, of third persons obtaining a sample?

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***PCT AG-IP 11.086 What possibility is there, when a reference is made in an international application to the deposit of biological material, of third persons obtaining a sample?***

**PCT AG-IP 11.086 What possibility is there, when a reference is made in an international application to the deposit of biological material, of third persons obtaining a sample?** The furnishing of samples is governed by the national laws applicable in the designated Offices.

**Rule 13bis.6**, however, provides for the delaying of any furnishing of samples under the national law applicable in each of the designated (or elected) Offices until the start of the national phase, subject to the ending of this "delaying effect" brought about by the occurrence of either of the following two events: [**Rule 13bis.6**]

(i) the applicant has, after international publication of the international application, taken the steps necessary to enter the national phase before the designated Office (see **National Phase, paragraph 4.001**); [ ]

(ii) international publication of the international application has been effected, and that publication has the same effects, under the national law applicable in the designated Office, as the compulsory national publication of an unexamined national application (in other words, the international application has qualified for the grant of "provisional protection"); for the Contracting States whose national laws provide for "provisional protection," and the conditions which have to be met for an international application to qualify for that protection, see **Annexes B**. [ ]

11.087. With respect to certain designated Offices (for instance, the **European Patent Office**), the applicant may take advantage of the procedure whereby, until the occurrence of a certain event, the biological material may be made available only by the issue of a sample to an expert nominated by the requester. For details, see **Annex L**. [ ]

[ ]

***PCT AG-IP 11.088 What special requirements apply to nucleotide and/or amino acid sequences disclosed in international applications?***

**PCT AG-IP 11.088 What special requirements apply to nucleotide and/or amino acid sequences disclosed in international applications?** See paragraphs 5.099 to 5.104, 7.005 to 7.012, and 10.063. See National Phase, paragraph 6.033 and National Chapters in relation to the national phase. [**Rule 5.2 13ter Section 208 Annex C of the Administrative Instructions**]

[ ]

***PCT AG-IP 11.089 What is a successor State?***

**PCT AG-IP 11.089 What is a successor State?** A successor State is a State whose territory was, before its independence, part of the territory of a **PCT Contracting State** that subsequently ceased to exist (the predecessor State), and which (successor State) has deposited with the Director General of WIPO a declaration indicating that the PCT continues to be applicable in that State ("declaration of continuation"). As from the date of the deposit of such a declaration, the successor State may be designated in international applications. Moreover, the effects of international applications filed during a certain period are extended to the successor State. [**Rule 32.1(a)**]

PCT AG-IP 11.090 Which are the international applications whose effects are extended to a successor State?

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***PCT AG-IP 11.090 Which are the international applications whose effects are extended to a successor State?***

**PCT AG-IP 11.090 Which are the international applications whose effects are extended to a successor State?** Rule 32 provides that the effects of any international application filed during a certain period are extended to a successor State, irrespective of which States have been designated in the international application. This period, for those successor States whose date of independence is later than the date of the day following the last day of the existence of the predecessor State, begins on the day following the last day of the existence of the predecessor State and ends two months after the date on which the Director General notifies the Governments of the States party to the **Paris Convention for the Protection of Industrial Property** of the successor State's declaration of continuation. For those States whose date of independence is earlier than the date of the day following the last day of the existence of the predecessor State, the successor State may, in conjunction with its declaration of continuation, declare that the period referred to above starts on the date of its independence. [Rule 32.1(b)]

***PCT AG-IP 11.091 How will an applicant know that the effects of his international application have been extended to a successor State?***

**PCT AG-IP 11.091 How will an applicant know that the effects of his international application have been extended to a successor State?** Information on any international application whose filing date falls within the applicable period (see **paragraph 11.090**) and whose effect is extended to the successor State shall be published by the International Bureau in the *Official Notices (PCT Gazette)*. [Rule 32.1(c)]

***PCT AG-IP 11.092 What is the effect of an extension?***

**PCT AG-IP 11.092 What is the effect of an extension?** A successor State is considered as having been designated in the international application on the international filing date. The applicable time limits under **Article 22** or **39(1)** in relation to that State shall be extended until the expiration of at least six months from the date of the publication of the information under **Rule 32.1(c)** (see **paragraph 11.091**). A successor State may fix time limits which expire later than the time limits given in the previous sentence of this paragraph and, if it does so, the International Bureau will publish this information in the *Official Notices (PCT Gazette)*. [Rule 32.2]

11.093. The procedure for extension of the effects of international applications to certain successor States (as explained above) should not be confused with the extension of European patents to States which are bound by the PCT and which have Extension Agreements with the **European Patent Organisation** (see **paragraph 5.054** and **Annex B (EP)**). [ ]

[ ]

11.094. Together with a paper copy of an international application, an applicant may prepare and file a request form print-out using the PCT-SAFE software (see **paragraph 5.015**). An applicant who files a request form print-out prepared using the PCT-SAFE software and also files a copy of the abstract and the data contained on the request in electronic form may be eligible to receive a fee reduction (see **paragraph 5.189** for details about the fee reduction for use of the PCT-SAFE software. However, a diskette containing that data filed alone – without any corresponding application papers – does not meet the requirements for according an international filing date. For information on what defects in request form print-outs prepared using the PCT-SAFE software do not affect the international filing date, see **paragraph 6.033**. For information on how to correct defects in the filing of request form print-outs generated using the PCT-SAFE software, see **paragraphs 11.095 to 11.101**,

**PCT AG-IP 11.095 Can defects in the filing of request form print-outs generated using the PCT-SAFE software be corrected?**

below. For further information on the PCT-SAFE software, to download the software, report bugs, resolve other problems and suggest improvements, please visit the PCT-SAFE website at [www.wipo.int/pct-safe/en/](http://www.wipo.int/pct-safe/en/). [Article 11(1) Rule 3.1 11.3 20 89ter Section 102(i)]

***PCT AG-IP 11.095 Can defects in the filing of request form print-outs generated using the PCT-SAFE software be corrected?***

**PCT AG-IP 11.095 Can defects in the filing of request form print-outs generated using the PCT-SAFE software be corrected?** Although request form print-outs generated from the PCT-SAFE software are filed together with a computer diskette containing the request and abstract, it is the paper copy of the request and abstract which is the legally determinative version. Thus, the general procedures for correction of defects in the paper applications should be followed (see **paragraphs 6.024 to 6.056**). See **paragraph 6.002** for details on the procedural steps at the receiving Office for request form print-outs prepared using the PCT-SAFE software. [Rule 3.1 11.3 89ter Section 102(i)]

***PCT AG-IP 11.096 How should defects in the request form print-out generated using the PCT-SAFE software be corrected?***

**PCT AG-IP 11.096 How should defects in the request form print-out generated using the PCT-SAFE software be corrected?** To correct a defect in such a request form print-out, the applicant should submit a replacement print-out of the entire request prepared using the PCT-SAFE software. A correction which is stated in a letter and is not accompanied by a replacement print-out of the entire request prepared using the PCT-SAFE software is acceptable only if it is of such a nature that it can be transferred from the letter to the record copy without affecting the clarity and direct reproducibility of the sheet onto which the correction is to be transferred. A replacement diskette should not be furnished when correcting defects in the request or abstract. [ ]

***PCT AG-IP 11.097 What happens where the receiving Office does not accept request form print-outs generated using the PCT-SAFE software?***

**PCT AG-IP 11.097 What happens where the receiving Office does not accept request form print-outs generated using the PCT-SAFE software?** If the receiving Office does not accept the filing of request form print-outs generated using the PCT-SAFE software but the request is filed in that format, the international application does not comply with the requirements of **Article 14** and the receiving Office will invite the applicant to file a request which does comply with **Article 14**. The international application in such cases is treated like any other international application containing a request which does not comply with the physical requirements under **Article 14**. It should be noted that the use of the request form print-out generated using the PCT-SAFE software does not, of itself, have any adverse effect in connection with the according of an international filing date. [Article 11(1) 14(1) Rule 20 89ter]

11.098. Instead of inviting the applicant to file an application in paper form, any receiving Office which does not accept the filing of request form print-outs generated using the PCT-SAFE software may decide to seek the authorization of the applicant to transmit the international application to the International Bureau as receiving Office under **Rule 19.4(a)(iii)** (see **paragraph 6.035**). [Rule 19.4(a)(iii)]

***PCT AG-IP 11.099 What happens when the request form print-out generated using the PCT-SAFE software is filed without a corresponding diskette?***

**PCT AG-IP 11.099 What happens when the request form print-out generated using the PCT-SAFE software is filed without a corresponding diskette?** The use of the PCT-SAFE software for

**PCT AG-IP 11.100** What happens when the request form print-out is not in the format provided by the PCT-SAFE software but it is filed with a corresponding diskette?

generating the request form print-out is not permitted if the corresponding diskette is not filed together with the request. Thus, if the applicant fails to provide a corresponding diskette when filing the request form print-out generated using the PCT-SAFE software, the applicant will be invited to furnish a request in paper form which complies with the requirements of **Article 14**. Only if the applicant furnishes the diskette immediately after filing the request – that is, before the receiving Office transmits the record copy to the International Bureau – is the use of the PCT-SAFE software permissible and the fee reduction related to the use of the PCT-SAFE software applicable. If the missing diskette is not filed before transmission of the record copy of the international application to the International Bureau, the applicant is not entitled to the fee reduction. [**Article 12 14 Rule 89ter Section 102(i)**]

***PCT AG-IP 11.100*** What happens when the request form print-out is not in the format provided by the PCT-SAFE software but it is filed with a corresponding diskette?

**PCT AG-IP 11.100** What happens when the request form print-out is not in the format provided by the PCT-SAFE software but it is filed with a corresponding diskette? If the international application contains a request form print-out which is not in the format generated by the PCT-SAFE software, but is in another format such as **Form PCT/RO/101**, and a corresponding diskette is furnished together with the application papers, the applicant will be notified that the conditions for applying the fee reduction related to the use of the PCT-SAFE software are not satisfied and that the fee reduction is not applicable since the request form print-out is not in the format provided by the PCT-SAFE software. However, if the applicant responds by furnishing the request form print-out in the format provided by the PCT-SAFE software before the receiving Office transmits the record copy to the International Bureau, the applicant is entitled to the appropriate fee reduction resulting from filing the application using the PCT-SAFE software. A diskette filed alone, without any application papers, does not meet the requirements for according a filing date. [**Article 11 12 Rule 3.1 11.3 89ter Section 102(i)**]

***PCT AG-IP 11.101*** What happens when the diskette is incomplete or defective?

**PCT AG-IP 11.101** What happens when the diskette is incomplete or defective? A diskette must contain the appropriate data, including the text of the abstract, and be readable if the appropriate fee reduction related to the use the PCT-SAFE software is to apply. If the receiving Office finds that a diskette contains incomplete data or is unreadable, the receiving Office will proceed as though the request form print-out in the format provided by the PCT-SAFE software had been filed without a diskette. [**Section 102(i)**]

[ ]

***PCT AG-IP 11.102*** How can applicants indicate their interest in licensing the invention(s) contained in their international application?

**PCT AG-IP 11.102** How can applicants indicate their interest in licensing the invention(s) contained in their international application? Applicants can file a request to that effect either (and preferably) by completing Form PCT/IB/382 “Request for indication of availability for licensing purposes” available at: [www.wipo.int/pct/en/forms/ib/editable/ed\\_ib382.pdf](http://www.wipo.int/pct/en/forms/ib/editable/ed_ib382.pdf) or by way of a letter addressed to the International Bureau. Details of the licensing terms may also be included in the form or letter. All such requests should be sent directly to the International Bureau which does not charge a fee for this service. [ ]

PCT AG-IP 11.103 When should a request for indication of availability for licensing purposes be filed?

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***PCT AG-IP 11.103 When should a request for indication of availability for licensing purposes be filed?***

**PCT AG-IP 11.103 When should a request for indication of availability for licensing purposes be filed?** Requests for indication of availability for licensing purposes can be submitted at any time until the expiration of 30 months from the priority date. [ ]

***PCT AG-IP 11.104 Is it possible to file multiple licensing requests or modify those already filed?***

**PCT AG-IP 11.104 Is it possible to file multiple licensing requests or modify those already filed?** Where applicants file multiple requests or want to modify those already filed, they must ensure their latest request is always a self-contained document, comprising complete information about any requests or modifications. [ ]

***PCT AG-IP 11.105 In which language can the request for indication of availability for licensing purposes be filed?***

**PCT AG-IP 11.105 In which language can the request for indication of availability for licensing purposes be filed?** Form PCT/IB/382 will shortly be available in all ten publication languages (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish) and the International Bureau is ready to accept the request for indication of availability for licensing purposes by way of a letter in any of those languages. [ ]

***PCT AG-IP 11.106 How are licensing indications made available?***

**PCT AG-IP 11.106 How are licensing indications made available?** The processing of the licensing request by the International Bureau generates a statement in the bibliographic data indicating the applicant's interest in concluding licensing agreements. In addition, this is linked to the filed request for indication of availability for licensing purposes (either Form PCT/IB/382 or the letter containing the licensing indications) which is available, under a dedicated tab, in PATENTSCOPE. Applicants are reminded that if they want to publish licensing indications in relation to their international application at a very early stage, they should also consider filing a request for early international publication as provided under **Article 21(2)(b)**. [ ]

***PCT AG-IP 11.107 Can the licensing indications be removed?***

**PCT AG-IP 11.107 Can the licensing indications be removed?** Applicants can request that the International Bureau remove the licensing indications from the “*PCT Bibliographic Data*” tab in PATENTSCOPE at any time during the international or national phase. In addition, the processing of the request for removal of the licensing availability indications removes the dedicated “*Licensing*” tab in PATENTSCOPE. Once removed, the licensing request and the related correspondence remain part of the file history under the related “*Documents*” tab in PATENTSCOPE. [ ]

***PCT AG-IP 11.108 How can you search for international applications for which licensing indications are available?***

**PCT AG-IP 11.108 How can you search for international applications for which licensing indications are available?** In addition to being published with the international application to which it relates, the licensing indications are also a search criterion within PATENTSCOPE Search Service [www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf) allowing third parties to identify those

PCT AG-IP 11.108 How can you search for international applications for which licensing indications are available?

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applicants who have expressed their interest in licensing the invention(s) contained in their international application. The search criterion can also be used in combination/multi-field searches and RSS feeds. [ ]



## **PCT Appl. Guide - Nat. Phase - 2. Entry into national phase (general)**

### ***PCT AG-NP 2.001 What is the national phase?***

**PCT AG-NP 2.001 What is the national phase?** The national phase is the second of the two main phases of the PCT procedure. It follows the international phase and consists in the processing of the international application before each Office of or acting for a **Contracting State** that has been designated in the international application (see **International Phase**). In each designated State the international application has the effect of a national (or regional) application as from the international filing date, and the decision to grant protection for the invention is the task of the Office of or acting for that State (the “designated Office”). The national phase of processing the international application by the designated Office is generally delayed until the termination of the international phase on the expiration of the time limits indicated in **paragraphs 3.001 and 3.002**. [Article 11(3) 23 40]

### ***PCT AG-NP 2.002 When is an Office a designated Office?***

**PCT AG-NP 2.002 When is an Office a designated Office?** The national Office of a **Contracting State** is a “designated Office” if the State is “designated” in the international application for national protection. The filing of a request constitutes the designation of all **Contracting States** that are bound by the **Treaty** on the international filing date. However, some States may be excluded from this all-inclusive designation where they have notified the International Bureau that **Rule 4.9(b)** applies to them (see **International Phase, paragraph 5.053**). Where a **PCT Contracting State** is party to the **ARIPO Harare Protocol**, the **Eurasian Patent Convention** or the **European Patent Convention** and is designated for a **regional** (ARIPO, Eurasian or European) patent, the **regional Office** concerned (the **ARIPO Office**, the **Eurasian Patent Office** or the **European Patent Office**) is the designated Office. Where a State party to the **ARIPO Harare Protocol**, the **Eurasian Patent Convention** or the **European Patent Convention** is designated twice, namely both for national protection and for a **regional patent**, there are two designated Offices for that State – the national Office of the State itself and the regional Office concerned. However, certain **States** party to the **ARIPO Harare Protocol** or the **European Patent Convention** have “closed the national route” whereby patent protection can be obtained in those countries via an international application *only* by way of a designation for a regional (ARIPO or European) patent. If any of the States that have “closed the national route” are designated, the designated Office concerned is always the **ARIPO Office** or the **European Patent Office**, respectively (see **International Phase, paragraphs 4.022 to 4.026**). The **European Patent Office** is also, in effect, the designated Office where patent protection is desired for a designated State through the extension of a European patent to that State, a possibility which is only available for countries which have a corresponding agreement with the **European Patent Organisation** (see **Annex B (EP)** and the **National Chapter** (Summary) relating to the **European Patent Office**). Where States party to the **OAPI Agreement** are designated, the **OAPI Office**, by virtue of the provisions of that Agreement, is always the designated Office (see **International Phase, paragraphs 4.022 to 4.026**). The competent designated Office(s) for each **Contracting State** is (are) set out in **Annexes B**. [Article 2(xiii) 4]

2.003. Where the applicant, before the expiration of the time limit for entering the national phase, voluntarily withdraws a designation, the Office of or acting for the State whose designation is withdrawn ceases to be a designated Office. [Article 24(1)(i) and (ii) **Rule 90bis.2**]

### ***PCT AG-NP 2.004 When is an Office an elected Office?***

**PCT AG-NP 2.004 When is an Office an elected Office?** Where a demand for international preliminary examination is filed, the term “elected Office” is used – instead of the term “designated

Office” – to denote the Office of or acting for a State in which the applicant intends to use the results of the international preliminary examination. Since only designated States can be elected, all elected Offices are necessarily also designated Offices. [**Article 2(xiv) 31**]

2.005. Where the demand is withdrawn prior to the date on which examination or processing may start in the national phase, or where the applicant fails to pay the preliminary examination fee or the handling fee and, consequently, the demand is considered as if it had not been submitted, the Office of or acting for the State which has been elected in the demand ceases to be an elected Office. [**Article 37 Rule 90bis.4**]

***PCT AG-NP 2.006 How does the national phase start?***

**PCT AG-NP 2.006 How does the national phase start?**The national phase starts only if the applicant performs certain acts, either before the expiration of a certain time limit or together with an express request that it start earlier. The applicant should not expect any notification inviting him to perform those acts. He has sole responsibility for performing them in due time. The consequences of failure to do so are fatal to the application in a number of designated States (see **paragraphs 4.003 and 4.004**). It should be noted that the acts must be performed in due time even if, for some reason, the international search report and the written opinion of the International Searching Authority or the international preliminary report on patentability (**Chapter I or II of the PCT**) are not yet available. Details of the acts to be performed and the applicable time limits are given in the following paragraphs. [**Article 22(1) 23 39(1)(a) 40**]

## **PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase**

### ***PCT AG-NP 3.001 What is the time limit for entering the national phase before a designated Office?***

**PCT AG-NP 3.001 What is the time limit for entering the national phase before a designated Office?** Subject to what is said below, no designated Office may normally process or examine the international application prior to the expiration of 30 months from the priority date and any fees due to a designated Office and any translation of the international application to be furnished to a designated Office will have to be paid and furnished, respectively, only by the expiration of that 30-month period ("priority date" means, where the international application contains a priority claim, the filing date of the application whose priority is claimed, and, where it does not contain such a claim, the filing date of the international application. Where the international application contains two or more claims, "priority date" means the filing date of the earliest application whose priority is claimed). In respect of certain designated Offices, the applicable time limit is 20 months, not 30 months because of the incompatibility, for the time being, of the modified PCT provision (PCT **Article 22(1)**) with the relevant national law; those Offices made a declaration of incompatibility which will remain in effect until it is withdrawn by the respective Offices. Furthermore, certain designated Offices have fixed time limits expiring even later than 30 months, or 20 months, as the case may be. For regular updates on these applicable time limits, refer to the relevant **National Chapters**; a cumulative table is also available from WIPO's website at [www.wipo.int/pct/en/texts/time\\_limits.html](http://www.wipo.int/pct/en/texts/time_limits.html). [**Article 2(xi) 22**]

### ***PCT AG-NP 3.002 What is the time limit for entering the national phase before an elected Office?***

**PCT AG-NP 3.002 What is the time limit for entering the national phase before an elected Office?** If the applicant files a demand for international preliminary examination prior to the expiration of 22 months (or 19 months in respect of certain Offices that have made a declaration of incompatibility with the modified PCT provision (PCT **Article 22(1)**) from the priority date, the time limit before the expiration of which the applicant must enter the national phase by performing the prescribed acts indicated below is governed for the elected Offices by **Article 39(1)**. The time limit is normally 30 months from the priority date, the same time limit for entering the national phase as that which applies in the case of a designated Office which has not been elected (see **paragraph 3.001**). The national law applied by each elected Office may fix a time limit which expires later than 30 months from the priority date. The **National Chapter** (Summary) relating to each elected Office in respect of which an extended time limit applies indicates the length of that time limit as does the table referred to in **paragraph 3.001**. [**Article 2(xi) 39(1) 64(2)**]

### ***PCT AG-NP 3.003 Are reminders to enter the national phase sent to the applicant by the designated Offices? What happens if the international search report or the international preliminary examination report is late?***

**PCT AG-NP 3.003 Are reminders to enter the national phase sent to the applicant by the designated Offices? What happens if the international search report or the international preliminary examination report is late?** Designated Offices usually do not issue any reminder to applicants that the time limit for entering the national phase is about to expire (or has just expired). It is therefore the applicant's responsibility to monitor the applicable time limit(s) in order for the application not to lose its effect before the designated Offices. The applicant is responsible for timely performance of the acts required for entry into the national phase even if the international search report and the written opinion of the International Searching Authority or the international preliminary report

PCT Appl. Guide - Nat. Phase - 3. Time limit for entering national phase

PCT AG-NP 3.004 Can the national phase start before the expiration of the time limit for entering it?

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on patentability (**Chapter I or II of the PCT**) have not been established by the time the applicant has to make a decision about how to proceed (see **International Phase, paragraphs 7.023, 7.027, 7.031 and 10.074**). [ ]

[ ]

***PCT AG-NP 3.004 Can the national phase start before the expiration of the time limit for entering it?***

**PCT AG-NP 3.004 Can the national phase start before the expiration of the time limit for entering it?** The PCT provides, in **Articles 23 and 40**, that national processing may not start before the expiration of the time limits indicated in **paragraphs 3.001 and 3.002** unless the applicant makes an express request to the Office concerned that it start the processing and the examination of the international application earlier. Such a request is not effective, however, unless the applicant has performed the prescribed acts indicated in the following paragraphs. The attention of applicants is drawn to the information in **paragraph 4.028**. [Article 23 40]

## **PCT Appl. Guide - Nat. Phase - 4. Acts to be performed for entry nat. phase**

### ***PCT AG-NP 4.001 What must be done by the applicant before the start of the national phase?***

**PCT AG-NP 4.001 What must be done by the applicant before the start of the national phase?**The following acts must be performed (if applicable): [Article 22(1)]

- (i) payment of the national fee (see **paragraphs 4.005 to 4.007**); [ ]
- (ii) furnishing of a translation, if prescribed (see **paragraphs 4.008 to 4.026**); [ ]
- (iii) in exceptional cases (if a copy of the international application has not been communicated to the designated Office under **Article 20**), furnishing of a copy of the international application, except where not required by that Office (see **paragraphs 4.027 and 4.028**); [ ]
- (iv) in exceptional cases (if the name and address of the inventor were not given in the request when the international application was filed, but the designated Office allows them to be given at a time later than that of the filing of a national application), furnishing of the indication of the name and address of the inventor (see **paragraphs 4.030 and 4.031**). [ ]

4.002. There may be acts in addition to those described in **paragraph 4.001** which must be performed for the international application to proceed in the national phase, but none of those acts, which are described further below and in the **National Chapter** relating to each designated Office, has to be performed within the time limit for entering the national phase. [Article 27(1), (2), (6) and (7) **Rule 51bis**]

### ***PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?***

**PCT AG-NP 4.003 What are the consequences of failure to perform the acts required for entry into the national phase?**The consequences where, on expiration of the applicable time limit for entering the national phase, the required acts have not (all) been performed, are that the international application loses the effect of a national application and the procedure comes to an end in respect of each Office before which they have not (all) been performed. Non-performance of the required acts in respect of one Office does not alter the effect of the international application before the other Offices. The automatic loss of the effect relieves the applicant, where he decides not to pursue the international application in the national phase, of the need to expressly withdraw the international application or the designation or election of a certain State. [Article 24(1)(iii) **39(2)**]

4.004. Where the applicant fails to perform the required acts in time, he may ask the designated Office to maintain the effect of the international application and to excuse the delay (see **paragraphs 6.022 to 6.027**). [Article 48(2) **Rule 49.6 82bis**]

[ ]

### ***PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?***

**PCT AG-NP 4.005 What fees must be paid for entry into the national phase and when?** The fees to be paid for entry into the national phase are indicated in each **National Chapter** (Summary and fees annex). They must be paid in the currencies and within the time limits that are also indicated there. If annual or renewal fees have become due by the time the national phase could start, they must be paid before the expiration of the time limit applicable for entering the national phase. The National Chapters set out this information. [Article 22(1) 39(1)(a) Rule 49.1(a)(ii) 76.5]

***PCT AG-NP 4.006 How can payment of national fees be effected?***

**PCT AG-NP 4.006 How can payment of national fees be effected?** The fees annex to each National Chapter contains this information. [ ]

***PCT AG-NP 4.007 Does the applicant have the right to claim the exemption, reduction or refund of national fees?***

**PCT AG-NP 4.007 Does the applicant have the right to claim the exemption, reduction or refund of national fees?** The exemption, reduction or refund of national fees is granted by various designated Offices. Each **National Chapter** (Summary) contains information on whether fee exemptions, reductions or refunds can be claimed and, if so, under what circumstances and in what amounts. [ ]

[ ]

***PCT AG-NP 4.008 In which case must the international application be translated?***

**PCT AG-NP 4.008 In which case must the international application be translated?** A translation of the international application must be furnished if the language in which it was filed or published is not a language accepted by the designated Office. [Article 22(1) 39(1)(a) Rule 49.1(a)(i) 76.5]

***PCT AG-NP 4.009 What is the language into which the international application must be translated?***

**PCT AG-NP 4.009 What is the language into which the international application must be translated?** The language or languages prescribed by the designated Offices are given in the **National Chapter** (Summary) relating to each Office. Where several languages are given, the applicant may choose the language which suits him best. It should be noted that the language in which the translation of the international application is furnished is usually also the language for the whole procedure before the designated Office. [Rule 49.1(a)(i) 76.5]

***PCT AG-NP 4.010 What must the translation comprise?***

**PCT AG-NP 4.010 What must the translation comprise?** The translation must comprise a translation of the description (including the title of the invention), of the claims (see **paragraph 4.014**) and of any text matter in the drawings (see **paragraph 4.022**), as originally filed and/or as amended (see **paragraphs 4.014 to 4.017, 4.019 and 4.020**) – each **National Chapter** (Summary) lists what the translation must comprise for the designated Office concerned. For the translation of the abstract and of the request, see the following paragraphs. [Rule 49.5(a)]

***PCT AG-NP 4.011 Does the abstract require translation?***

**PCT AG-NP 4.011 Does the abstract require translation?** Normally the abstract must also be translated, but some Offices do not require a translation for the national phase. The **National Chapter** (Summary) relating to each Office which requires that the abstract be translated contains an indication to that effect. [Rule 49.5(a)]

***PCT AG-NP 4.012 Does the request require translation?***

**PCT AG-NP 4.012 Does the request require translation?** The designated Offices have the right to require a translation of the request but most of them do not require it. The **National Chapter** (Summary) relating to each Office which requires that the request be translated contains an indication to that effect. [Rule 49.5(a)(i)]

***PCT AG-NP 4.013 How does the applicant prepare a translation of the request?***

**PCT AG-NP 4.013 How does the applicant prepare a translation of the request?** The usual way of translating the request is to transfer the data contained in the request of the international application as filed to a request form in the language of the translation. Every designated Office that requires a translation of the request is obliged to furnish to the applicant – free of charge – a copy of the request form in the language of the translation. It should be noted that the use of the request form in the language of the translation is optional, so that applicants who do not have such a form may present the translation in a different format. [Rule 49.5(b)]

***PCT AG-NP 4.014 Which are the claims that must be translated where the claims have been amended under Article 19 ?***

**PCT AG-NP 4.014 Which are the claims that must be translated where the claims have been amended under Article 19 ?** The designated Offices have the right to require a translation of the claims both as originally filed and as amended under **Article 19**. Each **National Chapter** (Summary) contains information on the applicable requirements. As to translations of the claims as amended under **Article 19** in a case where the international application has been the subject of international preliminary examination, see **paragraph 4.019**. [Rule 49.5(a)(ii)]

4.015. Where a designated Office requires a translation of both the claims as filed and of the claims as amended under **Article 19**, but the applicant furnishes only one of the required two translations, the designated Office either disregards the claims of which a translation has not been furnished or invites the applicant to furnish the missing translation within a time limit which must be reasonable in the circumstances. If such an invitation is issued but the missing translation has still not been furnished within that time limit, the designated Office may either disregard the claims whose translation is missing or consider the international application withdrawn. [Rule 49.5(c-bis)]

4.016. The procedures outlined in **paragraph 4.015** do not apply in all designated Offices. The various **National Chapters** (Summary) indicate, for each designated Office which requires a translation of both the claims as filed and of the claims as amended under **Article 19**, whether an invitation is issued where both translations are not filed and what the consequences are if the missing claims are not furnished in response to such an invitation. [Rule 49.5(l)]

***PCT AG-NP 4.017 Must any statement explaining amendments made to the claims under Article 19 be translated?***

**PCT AG-NP 4.017 Must any statement explaining amendments made to the claims under Article 19 be translated?** This statement must be translated only where required by the designated Office (see the **National Chapter** (Summary)). Failure to furnish a translation of the explanatory statement has

no effect on the international application itself; it can only result in the statement being disregarded by the designated Office. [Rule 49.5(c)]

***PCT AG-NP 4.018 Must a reference to deposited biological material be translated?***

**PCT AG-NP 4.018 Must a reference to deposited biological material be translated?** Where such a reference is contained in the description, its translation is part of the translation of the description. Where the reference is not contained in the description but has been furnished on the optional sheet (see **International Phase, paragraph 11.075**) or in a later communication, a translation must be furnished together with the translation of the international application. Where the applicant fails to furnish the translation of the reference, the designated Office may invite him to do so if it deems necessary. [Rule 49.5(h)]

***PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?***

**PCT AG-NP 4.019 What must be translated where the international application has been the subject of international preliminary examination?** Amendments to the description, claims or drawings under **Article 34** that have been filed with the International Preliminary Examining Authority and have been taken into account for the establishment of the international preliminary report on patentability (**Chapter II of the PCT**) will be annexed to that report. Any amendments under **Article 19** as well as replacement sheets containing rectifications of obvious mistakes authorized under **Rule 91.1(b)(iii)**, will similarly be annexed to the report if they have been taken into account (that is, they will in general not be annexed to the report if they have been superseded by later amendments or considered as reversed by an amendment under **Article 34**. However, exceptionally where the International Preliminary Examining Authority considers that a superseding or reversing amendment goes beyond the disclosure in the international application as filed, the replacement sheet superseded or reversed by the most recent superseding or reversing amendment will nevertheless be annexed to the report, and the report will contain an indication of this as referred to in **Rule 70.2(c)**). A translation of the amendments annexed to the report must be furnished together with the translation of the international application within the applicable time limit under **Article 39(1)**. [Article 36(2)(b) Rule 70.16 74.1 76.5]

4.020. If there have been any amendments under **Article 19** which are not annexed to the international preliminary report on patentability (**Chapter II of the PCT**), a translation of those amendments need not be furnished to most elected Offices. A few elected Offices do, however, require translations of amendments under **Article 19** even if they are not annexed to the international preliminary report on patentability (**Chapter II of the PCT**) – see the various **National Chapters** (Summary) for details. [Rule 70.16 76.5(iv)]

***PCT AG-NP 4.021 Does the translation have to contain drawings?***

**PCT AG-NP 4.021 Does the translation have to contain drawings?** No applicant is required to furnish original drawings to the designated Offices together with the translation of the international application. Offices may require only the furnishing of a copy of the original drawing(s), and few actually do so. The **National Chapter** (Summary) relating to each designated Office indicates this information. If the copy of the drawings is not furnished within the time limit for entering the national phase, the international application does not lose its effect, but the designated Office invites the applicant to furnish the missing copy. [Rule 49.5(a)(iii) 49.5(e) 76.5]

***PCT AG-NP 4.022 How must the translation of text matter in drawings be presented?***



**PCT AG-NP 4.022 How must the translation of text matter in drawings be presented?** Where a drawing, a table or the like contains text matter, that text matter must be translated. There are two methods that may be used for the physical presentation of the translated text matter. One is to furnish new sheets of drawings, tables, etc., containing the translated text matter. The other is to paste the translation over the original text matter and to furnish a copy of that sheet. The latter method, however, requires the copy to be of good quality and fit for reproduction by the designated Office. If it is not, the designated Office may invite the applicant to correct the defect. The expression "Fig." which is frequently used in drawings does not require translation into any language. If the translation of the text matter of the drawings is not furnished within the time limit for entering the national phase, the international application may lose the effect of a national application. [Rule 49.5(d) and (f) 76.5]

***PCT AG-NP 4.023 What are the physical requirements for the translation?***

**PCT AG-NP 4.023 What are the physical requirements for the translation?** The translation of the international application and any copy of drawings must comply with the physical requirements prescribed by the designated Office. However, no such Office has the right to require compliance with requirements as to the form of the translation of the international application that are different from or additional to those laid down in the **PCT** and the **Regulations** for the filing of international applications. Therefore, if the papers furnished to the designated Office comply with the physical requirements for international applications, they must be accepted by that Office. For details of those physical requirements, see **International Phase, paragraphs 5.177, 6.032, 6.051 and 11.097**. [Rule 49.5(j) 76.5]

***PCT AG-NP 4.024 In how many copies must the translation be furnished?***

**PCT AG-NP 4.024 In how many copies must the translation be furnished?** One copy of the translation is in principle sufficient for entering the national phase. There are some designated Offices, however, that require two or more copies. Where this is the case, it is mentioned in the **National Chapter** (Summary). If one or more copies are missing, those Offices will give the applicant an opportunity to furnish them once the national phase has started. [Rule 51bis.1(c) 76.5]

***PCT AG-NP 4.025 Must the translation be certified?***

**PCT AG-NP 4.025 Must the translation be certified?** The translation of the international application furnished for entry into the national phase does not need to be certified by a public authority or a sworn translator. However, if later the designated Office reasonably doubts the accuracy of the translation, it may require the applicant to furnish a certification of the translation. [Rule 51bis.1(d)(ii) 76.5]

***PCT AG-NP 4.026 Must the translation be verified?***

**PCT AG-NP 4.026 Must the translation be verified?** Verification of a translation means that the translation must be accompanied by a statement signed by the applicant or by the translator, to the effect that, to the best of his knowledge, the translation is complete and faithful. There are only a few designated Offices that require verification. For each such Office, the **National Chapter** (Summary) contains an indication to that effect and gives further details (including **forms**). [Rule 51bis.1(d)(i) 76.5]

[ ]

***PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?***

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PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?

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**PCT AG-NP 4.027 Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?** Under normal circumstances, none of the designated Offices requires a copy of the international application to be submitted by the applicant. There are only a few that do require a copy where the communication by the International Bureau of a copy of the international application under **Article 20** has not, or could not yet have, taken place (for details, see the **National Chapters** (Summary)). That communication is effected by the International Bureau in accordance with **Rule 93bis.1** but not prior to the international publication of the international application. The applicant is notified accordingly by means of **Form PCT/IB/308** (First notice informing the applicant of the communication of the international application (to designated Offices which do not apply the 30 month time limit under **Article 22(1)**), and **Form PCT/IB/308** (Second and supplementary notice informing the applicant of the communication of the international application (to designated Offices which apply the 30 month time limit under **Article 22(1)**)). When the applicant receives these Forms, he does not have to furnish a copy of the international application to any of the designated Offices, since the notices are accepted by all of them as conclusive evidence that the communication has duly taken place on the date specified in the notice. [**Article 22(1) 39(1)(a) Rule 47.1(a) 49.1(a-bis) and (a-ter) 76.5 93bis.1**]

4.028. On the other hand, where the applicant makes an express request for early processing of the international application (see **paragraphs 2.006 and 3.004**) before the communication of the international application has taken place, he must either furnish a copy of the international application, and of any amendment filed under **Article 19** with the International Bureau, at the same time as he makes the express request for early processing to the designated Office or request the International Bureau to transmit a copy of his international application to the designated Office in accordance with **Article 13(2)(b)**. The other acts prescribed for entering the national phase must naturally also be complied with. [**Article 13(2)(b) 22(1) 23(2) 39(1)(a) 40(2) Rule 47.4**]

[ ]

4.029. The filing of a request constitutes an indication that the international application is, in respect of each designated Office to which **Article 43** or **44** applies, for the grant of every kind of protection which is available by way of the designation of that State. As a result, if the applicant wishes the international application to be treated in a designated Office as an application not for the grant of a patent but for the grant of another kind of protection available for the designated Office, or for the grant of more than one kind of protection, the applicant is required to indicate his choice of protection to the designated Office when performing the acts to enter the national phase. Similarly and within the same time limits, the applicant is required to make such indications also in cases where he wishes the international application to be treated in a designated Office as an application for a patent of addition, a certificate of addition, inventor's certificate of addition, a utility certificate of addition or as a continuation or a continuation-in-part. Although some designated Offices may require the applicant to furnish any such indications at the time the acts referred to in **Article 22** or **Article 39** are performed, many designated Offices would allow the applicant to furnish such indications or, where applicable, convert from one kind of protection to another, at a later time as provided by national law. [**Rule 49bis.1 76.5**]

[ ]

***PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?***

**PCT AG-NP 4.030 In which case must the name and address of the inventor be indicated for entry into the national phase?** If the name or address of the inventor or inventors has not been

PCT AG-NP 4.032 Is the use of national forms mandatory for entry into the national phase?

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indicated in the request at the time of filing, that information must be furnished to the designated Offices at the time of entry into the national phase. If such indications are required, most of the designated Offices will invite the applicant to furnish them if he fails to do so on entering the national phase, but some of them will not. Details are given in the **National Chapters** (Summary). [**Article 22(1)**]

4.031. The indication of the name and address of the inventor is to be distinguished from other declarations of or concerning the inventor or the invention, etc. The latter are considered "special requirements" (see **paragraphs 5.001 to 5.005**) which may be complied with after entry into the national phase. [**Article 27(2)(ii) Rule 51bis.1(a) 76.5**]

[ ]

***PCT AG-NP 4.032 Is the use of national forms mandatory for entry into the national phase?***

**PCT AG-NP 4.032 Is the use of national forms mandatory for entry into the national phase?**No applicant may be required to use a national form to perform the acts prescribed for entry into the national phase. Several Offices do, however, keep such forms at the disposal of applicants, and their use is recommended. The **National Chapters** contain information about existing forms, and the annexes to the Chapters reproduce samples of them. [**Rule 49.4 76.5**]

## **PCT Appl. Guide - Nat. Phase - 5. Special requirements for national phase**

### ***PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?***

**PCT AG-NP 5.001 What is the meaning of "special requirements" and when do they have to be complied with?** No designated Office is allowed to require, before the expiration of the applicable time limit for entering the national phase, the performance of acts other than those referred to in **Article 22(1)**, namely the payment of the national fee, the furnishing of a translation (if prescribed) and, in exceptional cases, the furnishing of a copy of the international application, and the indication of the name and address of the inventor (see **paragraph 4.001**). All other requirements of the national law, to the extent that they are admitted under **Article 27**, are referred to in this publication as "special requirements." They may still be complied with after entry into the national phase. **Rule 51bis** indicates the most common of those requirements and provides that the applicant must be given an opportunity to comply with any such special requirement after the start of the national phase. This opportunity is usually given either by sending an invitation to comply with a certain special requirement within a time limit indicated in the invitation or by providing in the national law for a certain time limit within which the applicant must, without invitation, comply with the requirement. [**Article 27(1), (2), (6) and (7) Rule 51bis 76.5**]

5.002. For each designated Office, the **National Chapter** (Summary) lists the special requirements, if any, which must be complied with in connection with entry into the national phase, and indicates whether the Office concerned will invite the applicant to comply or, if there is no invitation, what the time limit is within which he must comply should he not have done so already. It is highly recommended that any special requirement indicated in the **National Chapter** (Summary) be complied with at the time of performing the acts for entry into the national phase, because this is more economical and avoids the risk of forgetting to comply with the requirement later. The most common of the special requirements are explained in general terms in the following paragraphs. Details are given in each **National Chapter** (Summary). [ ]

[ ]

### ***PCT AG-NP 5.003 What must be done to prove inventorship, the right to file the application or the like?***

**PCT AG-NP 5.003 What must be done to prove inventorship, the right to file the application or the like?** Depending on national law and practice, some designated Offices require the applicant to furnish: [**Rule 51bis.1(a) 51bis.2 51bis.3 76.5**]

(i) any document relating to the identity of the inventor; [ ]

(ii) any document relating to the applicant's entitlement to apply for or be granted a patent; [ ]

(iii) any document containing proof of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed; [ ]

(iv) any document containing an oath or declaration of inventorship; [ ]

PCT AG-NP 5.004 When must requirements relating to matters such as inventorship, right to file, etc. be complied with?

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(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time. [ ]

However, in general, a document referred to above will not be required if the applicant has furnished a declaration under **Rule 4.17** (see **paragraph 5.005**). What may be required by a particular designated Office is indicated in the **National Chapters** (Summary). The annexes to the National Chapters contain forms that must or may be used for this purpose. Documents (other than declarations under **Rule 4.17**) required by designated Offices, must always be sent by the applicant to the designated Office concerned and should not be sent to the International Bureau, which, if it does receive them, keeps them in its files but does not transmit them to the designated Offices. [ ]

***PCT AG-NP 5.004 When must requirements relating to matters such as inventorship, right to file, etc. be complied with?***

**PCT AG-NP 5.004 When must requirements relating to matters such as inventorship, right to file, etc. be complied with?** In general, such requirements must be complied with within a time limit of at least two months from the date of an invitation that the designated Office must send to the applicant, in case the requirement concerned was not already complied with within the time limit for entering the national phase (see **paragraphs 3.001** and **3.002**). Certain designated Offices have, however, informed the International Bureau that the time limit of two months was not compatible with the applicable national law (see the relevant **National Chapters** (Summary)). [ ]

***PCT AG-NP 5.005 What can be done in the international phase to simplify the processing of international applications in the national phase?***

**PCT AG-NP 5.005 What can be done in the international phase to simplify the processing of international applications in the national phase?** The applicant may include in Box No. VIII of the request form one or more of the following declarations under **Rule 4.17**: [**Rule 4.17 51bis.2**]

– Box No. VIII(i): declaration as to the identity of the inventor (noting that such declaration need not be made in Box No. VIII(i) if the name and address of the inventor are indicated in the request, that is, usually in Boxes No. II and/or III); [**Rule 4.17(i) 51bis.1(a)(i)**]

– Box No. VIII(ii): declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent; [**Rule 4.17(ii) 51bis.1(a)(ii)**]

– Box No. VIII(iii): declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application; [**Rule 4.17(iii) 51bis.1(a)(iii)**]

– Box No. VIII(iv): declaration of inventorship (only for the purposes of the United States of America), noting that that declaration must be signed; [**Rule 4.17(iv) 51bis.1(a)(iv)**]

– Box No. VIII(v): declaration as to non-prejudicial disclosures or exceptions to lack of novelty. [**Rule 4.17(v) 51bis.1(a)(v)**]

Where the request contains a declaration complying with **Rule 4.17(i) to (iv)**, a designated Office may not (except if it has informed the International Bureau to the contrary) require any document or evidence relating to the subject matter of that declaration (see **paragraph 5.003**) unless it reasonably doubts the veracity of the declaration concerned. In the case of a declaration as to non-prejudicial disclosures or exceptions to lack of novelty made under **Rule 4.17(v)**, the designated Offices

concerned are always entitled to require further documents of evidence. For further details, see **International Phase, paragraphs 5.074 to 5.080**. [ ]

[ ]

***PCT AG-NP 5.006 Must the applicant be represented by an agent for the national phase?***

**PCT AG-NP 5.006 Must the applicant be represented by an agent for the national phase?** Most designated Offices require non-resident applicants to be represented by an agent; others require non-resident applicants to have an address for service in the country. The **National Chapters** (Summary) indicate whether an agent must be appointed or whether an address for service is required. [Article 27(7) Rule 51bis.1(b) 76.5]

***PCT AG-NP 5.007 When and how must the agent be appointed?***

**PCT AG-NP 5.007 When and how must the agent be appointed?** It is highly recommended that an agent be appointed for the performance of the acts for entry into the national phase. An address for service, where required, should also be indicated at the time of performing those acts. As for any obligation to be represented by an agent or to have an address for service, it applies only once the national phase has started. The appointment of an agent must be made in a power of attorney signed by the applicant(s). Model powers of attorney are contained in the annexes to the **National Chapters** and on the website at [www.wipo.int/pct/en/forms/pa/index.htm](http://www.wipo.int/pct/en/forms/pa/index.htm). [Article 27(7) Rule 51bis.1(b) 76.5]

***PCT AG-NP 5.008 Who may act as an agent for the national phase?***

**PCT AG-NP 5.008 Who may act as an agent for the national phase?** The reply to this question is given for each designated Office in the **National Chapter** (Summary). Lists with names and addresses of agents may be obtained from the designated Offices, but not from the International Bureau. [Article 27(7)]

[ ]

***PCT AG-NP 5.009 When must a copy of the priority document be furnished for the national phase?***

**PCT AG-NP 5.009 When must a copy of the priority document be furnished for the national phase?** The priority document must be submitted during the international phase to the receiving Office or to the International Bureau, and the International Bureau makes it available to designated Offices (for details, see **International Phase, paragraph 5.070**). Where the priority document has been submitted within the time limit during the international phase to the receiving Office or to the International Bureau, no designated Office may require an original priority document (that is, an original certified copy of the earlier application) from the applicant. What may be required, however, is a copy of the priority document, that is, a simple photocopy of the original priority document (consisting of a copy of both the earlier application and the certificate of its filing date), together with a translation of the priority document (see **paragraph 5.010**). [Rule 17.2(a)]

***PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?***

PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?

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**PCT AG-NP 5.010 When must a translation of the priority document be furnished for the national phase?** In general, a designated Office may require the applicant to furnish a translation of the priority document only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. However, some designated Offices (which have informed the International Bureau to that effect) require a translation of the priority document in all cases once national processing has started. Where such a requirement exists, it is indicated in the **National Chapter** (either in the Summary, if the translation must be furnished relatively shortly after entry into the national phase, or elsewhere, if it must be furnished at a later stage during the national phase) together with an indication of the time limit for furnishing the translation. [**Rule 17.2(a) 51bis.1(e) 51bis.1(f) 76.4**]

## **PCT Appl. Guide - Nat. Phase - 6. Miscellaneous Questions National Phase**

### ***PCT AG-NP 6.001 What is the effect of the PCT on the substantive conditions of patentability applied in the national phase?***

**PCT AG-NP 6.001 What is the effect of the PCT on the substantive conditions of patentability applied in the national phase?** The PCT leaves each Contracting State free to determine substantive conditions of patentability. This is particularly true for what constitutes "prior art." However, since the requirements of prior art as defined in the **PCT** and its **Regulations** for the purposes of the international phase are generally as strict as, or stricter than, those defined in any national law, the chances of unpleasant surprises by way of previously uncited prior art references being raised during the national phase are substantially reduced. On the other hand, the PCT does not prevent any national law from requiring the applicant to furnish, in the national phase, evidence in respect of any substantive condition of patentability in that law. [**Article 27(5)** and **(6) 33(5)**]

[ ]

### ***PCT AG-NP 6.002 May the applicant correct errors in the translation of the international application?***

**PCT AG-NP 6.002 May the applicant correct errors in the translation of the international application?** Where the translation of the international application contains an error, that error may be rectified, during the national phase, before all designated Offices. [ ]

6.003. The scope of the translation of the international application may not, however, exceed the scope of the international application in its original language. Where, for example, as a result of incorrect translation, the scope of the international application in the language of the translation is narrower than in its original language, that scope may be broadened but must not exceed the original scope. Where the scope of the translation is broader than that of the international application in its original language, the designated Office or any other competent authority of the designated State may limit accordingly the scope of the international application or of a patent resulting from it. [**Article 46**]

[ ]

### ***PCT AG-NP 6.004 What are the effects of a decision by a receiving Office to restore the right of priority on designated Offices?***

**PCT AG-NP 6.004 What are the effects of a decision by a receiving Office to restore the right of priority on designated Offices?** A decision by a receiving Office to restore a right of priority based on the criterion of "due care" will, as a general rule, be effective in all designated Offices, unless the designated Office submitted a notification of incompatibility under **Rule 49ter.1(g)** (see **paragraph 6.005**). A decision by a receiving Office to restore a right of priority based on the criterion of "unintentionality" will be effective only in those designated States the applicable laws of which provided for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion. A decision by a receiving Office to refuse to restore the right of priority can always be reviewed by a designated Office (see **paragraph 6.006**), unless it has submitted a notification of incompatibility under **Rule 49ter.1(g)**, such that restoration is not possible in that jurisdiction. In addition, a review of a positive decision may



**PCT AG-NP 6.005** What are the consequences of a decision by a receiving Office to restore the right of priority on a designated Office which has made a notification of incompatibility?

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be made by a designated Office in the limited situation where it reasonably doubts that one of the substantive requirements for restoration was complied with. No review is permitted on purely formal grounds, such as, for example, the ground that the relevant fee in the international phase might not have been paid. [Rule 49ter.1]

***PCT AG-NP 6.005*** *What are the consequences of a decision by a receiving Office to restore the right of priority on a designated Office which has made a notification of incompatibility?*

**PCT AG-NP 6.005** What are the consequences of a decision by a receiving Office to restore the right of priority on a designated Office which has made a notification of incompatibility?

Several designated Offices have notified the International Bureau under **Rule 49ter.1(g)** of the incompatibility of **Rule 49ter.1(a) to (d)** with the national law applied by that Office. As a result, these designated Offices will not be obliged to give effect to the decision by a receiving Office to restore the right of priority for the purposes of the procedure before that designated Office as outlined above. A list of Offices which have notified the International Bureau of incompatibility of their national law with **Rule 49ter.1** can be found on WIPO's website at [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html#R\\_49ter\\_1\\_g](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html#R_49ter_1_g). [Rule 49ter.1(g)]

***PCT AG-NP 6.006*** *Can a request to restore the right of priority also be filed directly with a designated Office?*

**PCT AG-NP 6.006** Can a request to restore the right of priority also be filed directly with a designated Office? A request to restore the right of priority can also be filed directly with a designated Office once the applicant has entered the national phase before that Office. An applicant may wish to rely on this opportunity if he could not file a request to restore the right of priority with the receiving Office because of the operation of **Rule 26bis.3(j)**, or obtain the restoration of the priority right on the desired criterion because of the criterion for restoration applied by the receiving Office, or because the receiving Office has refused the request to restore filed with it (see **Rule 49ter.1(e)**). Several designated Offices have, however, notified the International Bureau under **Rule 49ter.2(h)** of the incompatibility of **Rule 49ter.2(a) to (g)** with the national law applied by that Office. As a result, these designated Offices will not accept a request to restore the right of priority filed with it. A list of Offices which have notified the International Bureau of the incompatibility of their national law with **Rule 49ter.2** can be found on WIPO's website at [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html#R\\_49ter\\_2\\_h](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html#R_49ter_2_h). [Rule 49ter.2]

***PCT AG-NP 6.007*** *What is the applicable time limit to request restoration of the right of priority with a designated Office?*

**PCT AG-NP 6.007** What is the applicable time limit to request restoration of the right of priority with a designated Office? The time limit for complying with the requirements for requesting the restoration of the right of priority is at least one month from the applicable time limit under **Article 22** for entering the national phase, though designated Offices are free to apply longer time limits where permitted under their national law (**Rule 49ter.2(f)**). If the designated Office requires the applicant to provide a declaration or evidence in support of the statement of reasons for failure to timely file the international application, it allows the applicant a reasonable time under the circumstances to furnish such documents. [Rule 49ter.2(b)(i) 49ter.2(f)]

***PCT AG-NP 6.008*** *How should a request for the restoration of the right of priority be filed with the designated Office?*

**PCT AG-NP 6.008 How should a request for the restoration of the right of priority be filed with the designated Office?** The request to restore the right of priority must be submitted by way of a letter to the designated Office. For the request to restore the right of priority to be successful, the following requirements must be met: [**Rule 49ter.2(b)** and (f)]

– the international application must contain a priority claim to an earlier application and the international application must have been filed within two months from the expiration of the priority period. If the international application did not contain the relevant priority claim at the time of filing, such a claim must have been added, pursuant to **Rule 26bis.1(a)** (see **International Phase, paragraphs 6.038 to 6.040**), before the expiration of the time limit under **Rule 26bis.3(e)** (**Rule 26bis.3(c)**); [ ]

– the request to restore should state the reasons for the failure to file the international application within the priority period (see **paragraph 6.010**). The statement of reasons should be drafted in light of the restoration criterion which the applicant seeks to satisfy, from among those applied by the Office (see **paragraph 6.009**); [ ]

– the request must be accompanied by any fee for requesting restoration required by the designated Office (see **National Chapter**, Annex I for whether a particular designated Office requires such a fee); [ ]

– if required by the designated Office and subject to an invitation by the Office, a declaration or other evidence in support of the statement of reasons must be furnished (**Rule 49ter.2(c)**) (for the applicable time limit, see **paragraph 6.007**). [ ]

***PCT AG-NP 6.009 What are the criteria for restoration applied by the designated Office?***

**PCT AG-NP 6.009 What are the criteria for restoration applied by the designated Office?** There are generally two criteria for restoration: either the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or the failure to file the international application within the priority period was unintentional. All designated Offices to which these Rules are applicable (see **paragraph 6.006**) must apply at least one of these criteria, or else one more favorable from the point of view of the applicant. If a designated Office wishes, it may apply both criteria for restoration. [**Rule 49ter.2(a)** and (f)]

***PCT AG-NP 6.010 What needs to be included in the statement of reasons for the request to restore the right of priority?***

**PCT AG-NP 6.010 What needs to be included in the statement of reasons for the request to restore the right of priority?** The statement should indicate the reasons for the failure to file the international application within the priority period. It should contain all the relevant facts and circumstances which would allow the designated Office to determine 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 or was unintentional. [**Rule 49ter.2(b)(ii)**]

***PCT AG-NP 6.011 Will there be an opportunity to convince the designated Office that it should not refuse the request?***

**PCT AG-NP 6.011 Will there be an opportunity to convince the designated Office that it should not refuse the request?** If the designated Office intends to refuse the request for the restoration of the priority claim, it is required to notify the applicant of its intention. The applicant must be given an opportunity to make observations on the intended refusal within a reasonable time limit, specified in

**PCT AG-NP 6.012 Will pages which have been accepted as incorporated by reference by the receiving Office be accepted by the designated or elected Office?**

the notification of intended refusal. Note that this notification may in practice be sent to the applicant together with an invitation to file a declaration or other evidence. [Rule 49ter.2(e)]

[ ]

***PCT AG-NP 6.012 Will pages which have been accepted as incorporated by reference by the receiving Office be accepted by the designated or elected Office?***

**PCT AG-NP 6.012 Will pages which have been accepted as incorporated by reference by the receiving Office be accepted by the designated or elected Office?** Designated and elected Offices may, to a limited extent, review decisions by receiving Offices which have allowed incorporation by reference (**Rule 82ter.1(b)**). If the designated or elected Office finds that the applicant did not comply with its obligation to furnish or arrange for the furnishing of a priority document; the statement of incorporation was missing or not submitted with the request; no written notice confirming incorporation by reference was submitted; no required translation furnished; or the element or part in question was not completely contained in the priority document, the designated or elected Office may treat the international application as if the international filing date had been accorded on the basis of the date on which the sheets containing the missing elements or parts were submitted, but only after having given the applicant the opportunity to make observations on this outcome and/or to request that, at least, the missing parts which had been furnished be disregarded, in accordance with **Rule 82ter.1(d)**. Similarly, those designated Offices which have submitted notifications of incompatibility under **Rule 20.8(b)** (see **International Phase, paragraph 6.027**) may also treat the international application as if the international filing date had been accorded without the benefit of the incorporation by reference but also only after having given the applicant the opportunity to make observations on this outcome and/or to request that, at least the missing parts which had been furnished be disregarded, pursuant to **Rule 20.8(c)**. [**Rule 82ter.1**]

[ ]

***PCT AG-NP 6.013 May the applicant amend the international application for the national phase?***

**PCT AG-NP 6.013 May the applicant amend the international application for the national phase?** The PCT guarantees that the applicant may amend the claims, the description and the drawings before any designated Office. Although he already has had the opportunity to amend the claims in the international phase, he may wish to make further amendments, which may be different for the purposes of the various designated Offices, in the national phase, or he may wish to amend also the description or the drawings (which is not possible during the international phase unless the applicant has made a demand for international preliminary examination). All designated and elected Offices are obliged to permit such amendments for at least one month from the time when the applicant performs the steps necessary to enter the national phase. That minimum time limit may be later in certain exceptional circumstances specified in **Rules 52.1** and **78**. In any event, most designated and elected Offices permit amendments at any time during the national examination procedure (if applicable). The **National Chapters** give additional indications in this respect. [**Article 19 28 34(2)(b) 41 Rule 46 52.1 66.1 78**]

***PCT AG-NP 6.014 May the applicant correct obvious mistakes in the international application for the national phase?***

PCT AG-NP 6.015 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?

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**PCT AG-NP 6.014 May the applicant correct obvious mistakes in the international application for the national phase?** Normally, any obvious mistake in the description, claims and drawings may be corrected before the designated Office. The correction can be presented as an amendment (see **paragraph 6.013**), provided that the scope of the international application as originally filed is not thereby broadened. [**Rule 91.3(f)**]

***PCT AG-NP 6.015 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?***

**PCT AG-NP 6.015 What are the effects of the authorization of an obvious mistake on the designated and elected Offices?** Generally, designated and elected Offices must process the international application in the national phase “as rectified”, unless that designated or elected Office has already started the processing or examination of the international application before the date on which that Office is notified under **Rule 91.3(a)** by the International Bureau of the authorization of the rectification concerned. Otherwise, a designated or elected Office may disregard a rectification that was authorized under **Rule 91.1** if it finds that it would not have authorized the rectification if it had been the competent authority (see **Rule 91.3(f)**). The designated Office may, however, only disregard any rectification that was authorized during the international phase, if it has given the applicant an opportunity to make observations, within a reasonable time limit, on the Office’s intention to disregard the rectification. [**Rule 91.3(e) and (f)**]

6.016. Where the authorization of rectification has been refused during the international phase and the applicant has made a request for publication under **Rule 91.3(d)** (see **International Phase, paragraph 11.043**), he should repeat the request for rectification before each designated Office in a language admitted by that Office. [ ]

6.017. The conditions for allowing the rectification of an obvious mistake depend on the national law and practice applied by the designated Offices. Applicants are advised to inquire at the Offices concerned regarding the conditions applicable. [ ]

[ ]

***PCT AG-NP 6.018 In which case may a request for review be made?***

**PCT AG-NP 6.018 In which case may a request for review be made?** A review by the designated Office of the following decisions may be requested: [**Article 25**]

(i) the receiving Office has refused to accord an international filing date to the international application because of certain defects in that application; [ ]

(ii) the receiving Office has declared that the international application is considered withdrawn because of certain defects in that application or because of non-payment of the prescribed fees; [ ]

(iii) the International Bureau has made a finding that the international application is considered withdrawn because it has not received the record copy within the prescribed time limit. [ ]

Thus, those decisions that may have been made during the international phase and affect the international application as such are subject to review by each designated Office. Review by the designated Office consists of an examination to ascertain whether the receiving Office’s refusal or declaration or the International Bureau’s finding was the result of an error or omission on the part of the authority concerned. [**Article 25(2)(a)**]

***PCT AG-NP 6.019 How may the right to request a review be exercised and when?***

**PCT AG-NP 6.019 How may the right to request a review be exercised and when?** In any of the three cases referred to in **paragraph 6.018**, the applicant must, if he wants the decision to be reviewed, [ ]

(i) request the International Bureau, under **Article 25**, to send to each designated Office specified by him a copy of any relevant document in the file; this request must be in English or French; [**Article 25(1)(b)**]

(ii) request each of those designated Offices, separately, to review the decision affecting his international application, giving the facts and evidence indicating an error or omission on the part of the receiving Office or of the International Bureau, as the case may be; in addition, and at the same time (see **paragraph 6.020**), the applicant must pay to the said designated Office the national fee for entry into the national phase, and furnish a translation of the international application where required; for details about fees and required translations, see the **National Chapters** (Summary); the request to the designated Office must be in a language accepted by that Office; where the review requested concerns the refusal to accord an international filing date, the applicant must attach to his request a copy of the notice informing him of the refusal. [**Article 25(2)(a) Rule 51.2**]

6.020. Both the request to the International Bureau and the request to any designated Office together with any required translation and fee must reach the authority concerned within two months from the date of the notification informing the applicant of the unfavorable decision. [**Rule 51.1 51.3**]

***PCT AG-NP 6.021 What may be the result of a review by the designated Office?***

**PCT AG-NP 6.021 What may be the result of a review by the designated Office?** If the applicant has complied with the requirements outlined in the preceding paragraphs, the designated Office will make a finding on whether the decision was justified and, if it finds that it was the result of an error or omission, it must treat the international application as if that error or omission had not occurred, and maintain the effect of the international application as a regular national application as of the international filing date. If it finds that the decision was not the result of an error or omission, it may nevertheless maintain the effect of the international application under **Article 24(2)**. The latter may be the case where the decision was the result of failure to meet a prescribed time limit (such as for the furnishing of corrections or the payment of fees); in such a case, the applicant is advised to request the designated Office not only to review the decision but also to excuse the delay. Details on the excusing of delays in meeting time limits are given in the following paragraphs. [**Article 24(2) 25(2)(a) 48(2)**]

[ ]

***PCT AG-NP 6.022 Can a delay in meeting a time limit be excused?***

**PCT AG-NP 6.022 Can a delay in meeting a time limit be excused?** A delay in meeting a time limit which has resulted in the international application being considered withdrawn, during either the international phase or the national phase, may be excused under certain circumstances. The excusing of a delay is understood as any decision which has the effect of the international application being treated as if the time limit had not been exceeded. The excusing of a delay cannot be requested during the international phase, however. It may be granted only in the national phase (for delays in both the international phase and the national phase) by each designated Office individually, and only as far as that Office is concerned. The conditions laid down by the national law of each designated Office are paramount in determining whether a delay must be or may be excused. All national provisions related to the excusing of delays must be applied to international applications in the same way and under the

same conditions as they are to national applications. Examples of such provisions are those that allow for the reinstatement of rights, restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, and so on. [Article 48(2) Rule 82bis]

***PCT AG-NP 6.023 In respect of which time limits may delays be excused?***

**PCT AG-NP 6.023 In respect of which time limits may delays be excused?** The time limits concerned are all those fixed in the PCT (Treaty and Regulations) and also any time limit fixed by a PCT authority and any time limit either fixed by, or in the national law applicable by, the designated Office for the performance of any act by the applicant before that Office, including the time limit for entering the national phase. [Rule 82bis.1]

***PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?***

**PCT AG-NP 6.024 What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39.1 within the applicable time limit?** Contracting States are required under Rule 49.6 to provide for the possibility to reinstate the rights of the applicant with respect to an international application where the applicant failed to comply with the requirements of Article 22 or 39.1. Details of this possibility are given in Rule 49.6. Some Contracting States have notified the International Bureau, under Rule 49.6(f), of the incompatibility of this Rule with their national laws. A table of such notifications is available on WIPO's website at: [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html#R\\_49\\_6\\_f](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html#R_49_6_f). Once a State has taken the necessary actions to amend its national law, notification of this will be published in the *Official Notices (PCT Gazette)* and the table will be updated. Moreover, even if a Contracting State has made a notification under Rule 49.6(f), the applicant is advised to check with the Office concerned whether a system to reinstate rights with respect to an application exists or not. Some States have made notifications only because their national laws already contain provisions for the reinstatement of rights but these provisions are not in line with the contents of Rule 49.6. Some States therefore have no procedure in place to reinstate rights with respect to an application whereas others do have such systems, either more or less favorable to the applicant than Rule 49.6. [Article 48(2) Rule 49.6 82bis.2]

***PCT AG-NP 6.025 What must be done by the applicant who has exceeded a time limit?***

**PCT AG-NP 6.025 What must be done by the applicant who has exceeded a time limit?** The applicant must perform all acts required for entry into the national phase (see paragraphs 4.001 to 4.031). He must at the same time request the designated Office to excuse the delay and to maintain the effect of the international application before it. The procedure depends on the national requirements applicable, including any time limit for filing a request to excuse the delay. Those requirements are indicated in the **National Chapter**. Applicants can usually be sure of meeting any such time limit when the request to excuse is made and the acts for entering the national phase are performed either within two months from the date of the notification of the unfavorable decision or within two months from the date on which the time limit (such as the time limit for entering the national phase) expired. [Article 48(2) Rule 51.1 51.3]

6.026. The request for a delay to be excused should be made in addition to, and together with, any request for the review of a decision made by the receiving Office declaring the international application withdrawn for failure to comply with any requirement within a certain time limit (see paragraphs 6.018 to 6.021). Should the designated Office confirm the decision made by the

**PCT AG-NP 6.027** Must the late arrival of a document caused by irregularities in the mail service be excused?

receiving Office, it may nevertheless maintain the effect of the international application because, under its national law, the delay may be excused in accordance with provisions for the reinstatement of rights, the revival of an abandoned application, the continuation of proceedings or the like. It should be noted that, as outlined in the preceding paragraphs, the applicant must, before each Office concerned, fulfill all the conditions in the applicable national law, including the making of the request for a delay to be excused within any time limit prescribed by the national law. [Article 24(2) 48(2)]

***PCT AG-NP 6.027*** *Must the late arrival of a document caused by irregularities in the mail service be excused?*

**PCT AG-NP 6.027** **Must the late arrival of a document caused by irregularities in the mail service be excused?** If a time limit fixed in the **Treaty** or the **Regulations** is exceeded because of the delayed arrival of a document or letter, it must be excused if it was caused by a delay in the mail or by an interruption of the mail service, provided that sufficient evidence is produced and the mailing was by mail registered with the postal authorities or with any delivery service notified by the designated Office to the International Bureau. Similarly, and under the same conditions, a new copy of a document or letter may be substituted for a document or letter lost in the mail, provided that the replacement document or letter is proved to be identical with the one lost. For details, see **Rule 82**. [Article 48(1) Rule 82]

[ ]

***PCT AG-NP 6.028*** *Which errors made by the receiving Office or the International Bureau may be rectified?*

**PCT AG-NP 6.028** **Which errors made by the receiving Office or the International Bureau may be rectified?** If the receiving Office has made an error in according the international filing date or if the priority claim in the request has been erroneously considered by the receiving Office or the International Bureau not to have been made, the designated Office must rectify the error if it is one that it would have rectified in accordance with its national law or national practice had it made the error itself. [Rule 82<sup>ter</sup>]

***PCT AG-NP 6.029*** *What must be done to request rectification of such an error and when?*

**PCT AG-NP 6.029** **What must be done to request rectification of such an error and when?** The applicant must request the designated Office to rectify the error and must prove, to the satisfaction of that Office, that the international filing date accorded by the receiving Office is incorrect owing to an error made by the receiving Office, or that a priority claim has erroneously been considered not to have been made by the receiving Office or the International Bureau. The request should be made on entering the national phase. [ ]

[ ]

***PCT AG-NP 6.030*** *What has to be done by the applicant once the national phase has started?*

**PCT AG-NP 6.030** **What has to be done by the applicant once the national phase has started?** The usual national procedure applies to international applications during the national phase. What is said in the following text and in the **National Chapter** (Summary) concerns only the acts that

must be performed for entry into the national phase and those acts that should be performed on entering the national phase but may still be performed once it has started. What has to be done thereafter—at least the main procedural steps—is outlined for each designated Office in the relevant **National Chapter** (Summary). Applicants who are not familiar with the patent procedure before a certain designated Office should seek professional advice even where they are not obliged to be represented before that Office by an agent. [ ]

[ ]

***PCT AG-NP 6.031 How should the international application be identified?***

**PCT AG-NP 6.031 How should the international application be identified?** All documents sent and all payments of fees to a designated Office (and any letter accompanying such documents or payments) should indicate – if already known – the national serial number given to the international application by the designated Office. Where the national number is not yet known (or not given), the international application number should be indicated, preferably together with the international filing date, the name of the applicant and the title of the invention. [ ]

[ ]

***PCT AG-NP 6.032 What are the requirements regarding deposits of biological material?***

**PCT AG-NP 6.032 What are the requirements regarding deposits of biological material?** Annex L contains details of designated Offices' requirements regarding deposits of biological material. [ ]

[ ]

***PCT AG-NP 6.033 What requirements need to be satisfied in relation to the furnishing of a sequence listing?***

**PCT AG-NP 6.033 What requirements need to be satisfied in relation to the furnishing of a sequence listing?** No designated Office may require that the applicant furnish nucleotide and/or amino acid sequences and the listing of those sequences ("sequence listings") in a format other than that complying with the standard provided for in **Annex C of the Administrative Instructions** (Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in International Patent Applications under the PCT). Where the international application contains one or more sequence listings which do not comply with the standard provided for in **Annex C of the Administrative Instructions**, any designated Office may require that an **Annex C** compliant sequence listing be furnished. Designated Offices may also require that an electronic version of a sequence listing be furnished, even if such a listing has been filed as part of the description of an electronically filed international application in an **Annex C** compliant format, or has been submitted for the purposes of international search under **Rule 13ter** during the international phase. This is because the electronic format in which it was filed during the international phase will not necessarily be in a format acceptable to that designated Office. [**Rule 13ter.1(a) 13ter.1(b) 13ter.3 Annex C of the Administrative Instructions**]



## EPO Guidelines - A Formalities Examination

### *GL A III 6.12 Copy of the search results for the priority or priorities*

An applicant claiming priority within the meaning of **Art. 87** must file a copy of the results of any search carried out by the authority with which the priority application was filed together with the European patent application, in the case of a Euro-PCT application on entry into the European phase, or without delay after such results have been made available to him. This requirement also applies to priority claims which are subsequently withdrawn or lapse and to priority claims introduced or corrected after the filing date (see **A-III, 6.5.1** and **A-III, 6.5.2**). The obligation under **Rule 141(1)** exists as long as the application is pending before the EPO. This requirement applies to all European and Euro-PCT applications filed on or after 1 January 2011 (OJ EPO 2009, 585). In the case of divisional applications, the relevant date is that on which the divisional application was received by the EPO (see **A-IV, 1.2.1**), not the filing date of the parent application. Where the copy is not provided to the EPO before the Examining Division assumes responsibility, the procedure is as set out in **C-II, 5**, and **C-III, 5**. [**Rule 141(1)**; ]

Where multiple priorities are claimed, the copy of the search results referred to above must be provided for all applications claimed as priority. If the search results are not drawn up in an official language of the EPO, no translation is required. The copy of the search results submitted must be a copy of the official document issued by the office where the priority was filed. A simple listing of the prior art drawn up by the applicant will not suffice. Copies of the cited documents do not have to be provided (see the Notice from the EPO dated 28 July 2010, OJ EPO 2010, 410).

The copy referred to in **Rule 141(1)** is deemed to be duly filed if it is available to the EPO and is to be included in the file of the European patent application under the conditions determined by the President. According to the Decision of the President dated 5 October 2010, OJ EPO 2010, 600, for the time being these exceptions are not based on an agreement with the national patent offices, but are limited to cases where a search report of the following type was drawn up by the EPO on an application whose priority is claimed: [**Rule 141(2)**; ]

(i)European search report (**Art. 92**)

(ii)international search report (**Art. 15(1) PCT**)

(iii)international-type search report (**Art. 15(5) PCT**)

(iv)search report prepared on behalf of a national office on a national application (Belgium, Cyprus, France, Greece, Italy, Luxembourg, Malta, Netherlands, Turkey).

Furthermore, according to the Decision of the President dated 9 December 2010, OJ EPO 2011, 62, the EPO includes in the file of a European patent application a copy of the search results referred to in **Rule 141(1)**, thus exempting the applicant from filing said copy, where the priority of a first filing made in one of the following states is claimed:

– Japan

– United Kingdom

– United States of America.

Furthermore, for divisional applications, where the results of the search on the claimed priority have already been provided in respect of the parent application, the applicant need not provide them again in respect of the divisional application (see the Notice from the EPO dated 28 July 2010, OJ EPO 2010, 410).

### *GL A III 13.2 Additional fee (if application documents comprise more than thirty-five pages)*

This section relates only to applications filed and international applications entering the European phase on or after 1 April 2009 (see also the Notice from the EPO dated 26 January 2009, OJ EPO 2009, 118, and the supplement thereto, OJ EPO 2009, 338). [**Rule 38(2); Rule 38(3); Art. 2(1), No. 1a RFees; ]**

An additional fee is payable as part of the filing fee for European patent applications which are filed on or after 1 April 2009 and comprise more than thirty-five pages. The amount of the fee is calculated according to the number of pages over thirty-five. The language reduction under **Rule 6(3)** applies. The additional fee is payable within one month of the filing date of the application or of the date of filing a European divisional application or a European application according to **Art. 61(1)(b)**. If the application is filed without claims or by reference to a previously filed application, the additional fee is payable within one month of filing the first set of claims or one month of filing the certified copy of the application referred to in **Rule 40(3)**, whichever expires later. The additional fee is calculated on the basis of the pages of the description, claims, any drawings and one page for the abstract, in the language of filing. The pages of the request for grant (Form 1001) and those forming part of a sequence listing within the meaning of **Rule 30(1)** are not counted, provided the sequence listing contained in the description complies with WIPO Standard ST.25. If the application is filed by reference to a previously filed application, the pages of the certified copy, excluding those for the certification and for bibliographic data, are taken as the basis for the calculation. If the application is filed without claims, the additional fee takes account of the pages of the first set of claims filed.

For international (Euro-PCT) applications entering the European phase on or after 1 April 2009, the additional fee is payable as part of the filing fee within the 31-month period of **Rule 159(1)**. It is calculated on the basis of the international application as published, any amendments under **Article 19 PCT** and one page for the abstract. If there is more than one page of bibliographic data, the further pages are not counted. The pages of the latest set of any amended documents (**Article 34 PCT**, amendments filed upon entry) on which European phase processing is to be based (**Rule 159(1)(b)**) will also be taken into account where available to the EPO by the date of payment of the additional fee within the thirty-one months. If the applicant intends pages of the international publication or of amendments to be replaced by pages of the latest set of amendments, and therefore to be excluded from the calculation, he must also, at the latest by the date of payment, identify these replacement pages and clearly indicate the pages which they are to replace. This information should preferably be given in the relevant section of the form for entry into the European phase (Form 1200). Otherwise any new pages filed at this stage will be taken to be additional pages. Form 1200 is disregarded in the calculation of the additional fee.

Example:

International application, published in English, containing 100 pages:

abstract

1

description

50

claims

20

drawings

20

claims, **Art. 19 PCT**

9

On entry into European phase, within the 31-month period, 10 pages of amended claims are filed to replace previous pages of claims, as indicated by the applicant in Form 1200.

## EPO Guidelines - A Formalities Examination

### GL A IV 5.2 Sequence listings of an application filed by reference to a previously filed application

-> number of pages on which calculation is based: 100 - 20 (original claims) - 9 (**Art. 19 PCT**) + 10 (EP entry) - 35 (fee-exempt)

-> number of pages to be paid for: 46

Pages of amendments filed after the date of payment of the additional fee, in particular during the **Rule 161(1)** or **Rule 161(2)** period (see **E-VIII, 3**), are not taken into account. Consequently, if amendments are filed at this stage which reduce the number of pages already paid for, no refund will be made.

If the additional fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to **Rule 112(1)**; the applicant can request further processing according to **Art. 121** and **Rule 135**. The amount of the fee for further processing is computed according to the number of pages on file at expiry of the relevant period for which the additional fee, calculated as set out above, has not been paid. The amount of the fee for further processing in respect of the additional fee does not take into account the basic filing fee according to **Art. 2(1), No. 1, RFees**, where this was paid on time. [**Art. 2(1), No. 12 RFees**; ]

### *GL A IV 5.2 Sequence listings of an application filed by reference to a previously filed application*

Where the application is filed by reference to a previously filed application (see **A-II, 4.1.3.1**), and that previously filed application contained sequence listings on its date of filing, then those sequence listings form part of the application as originally filed. This is subject to the exception that, where the sequences only appear in the claims and not in the description or drawings of the previously filed application, and the applicant did not include the claims of the previously filed application in the reference, then those sequences are not included in the European application as originally filed, even if the applicant subsequently filed a sequence listing complying with WIPO Standard ST.25 later on in the prosecution of that previously filed application (later filed sequence listings are not part of the description according to **Rule 30(2)**).

Where the previously filed application is not available to the EPO, it will not be possible to carry out the check according to **Rule 57(j)** on the compliance of the listing with **Rule 30(1)** until the applicant files the certified copy and any translation required, which must be done within two months of the date of filing (**Rule 40(3)**). After the certified copy and translation, where applicable, are received, if it transpires that the listing contained therein does not comply with **Rule 30(1)** in conjunction with the rules laid down by the President of the EPO, the European Patent Office will send a communication according to **Rule 30(3)** inviting the applicant to correct any deficiencies (including the lack of the electronic listing and/or, where applicable, the lack of a statement of identity of the electronic listing with the written listing) and pay the late furnishing fee (see **A-IV, 5**).

If the previous application referred to is a European application or an International application filed with the EPO as receiving Office, and this application satisfied the requirements of **Rule 30** or **Rule 5(2) PCT** in combination with WIPO Standard ST.25 **on its date of filing** then all the requirements of **Rule 30(1)** are satisfied automatically on the date of filing of the European application filed by reference to this application.

In all other cases, however, the applicant will have to ensure that all the requirements of **Rule 30(1)**, in conjunction with the rules laid down by the President of the EPO, are met. This means that if the previously filed application referred to is not one of the above types of application, even where it contains a written sequence listing conforming to WIPO Standard ST.25, the applicant will still have to provide an electronic form of the sequence listing complying with WIPO Standard ST.25 and, where applicable, a statement that the information in electronic form is identical to the written sequence listing, in order to satisfy the requirements of **Rule 30(1)** in conjunction with the rules laid down by the President of the EPO. This includes the case where the previously filed application was a European application or International application filed with the EPO as receiving Office, but where one or more of the elements required to satisfy the requirements of **Rule 30(1)** or **Rule 5(2) PCT** in

conjunction with WIPO Standard ST.25 were not present on the date of filing. If this is not the case, the procedure in **A-IV, 5** will be followed (a communication under **Rule 30(3)** will be sent).

### ***GL A X 10.2.3 Refund of the international search fee***

The international search fee will be refunded in the cases specified in **Rules 16.2 PCT, Rule 16.3 PCT** and **Rule 41 PCT** and in Annex C of the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (WIPO) under the PCT (see OJ EPO 2010, 304). Following amendment of the provisions set out in Annex C, Part II(3) of the above mentioned agreement, any refund of the international search fee paid for an international application filed on or after 1 January 2004 will be granted to the extent set out in the Notice from the President of the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, N.3 for international applications for which the international search is completed before 1 April 2009, in the Decision of the President of the EPO dated 22 December 2008, OJ EPO 2009, 114 for international applications for which the international search is completed on or after 1 April 2009 but before 1 July 2010, and in the Decision of the President of the EPO dated 24 March 2010, OJ EPO 2010, 341, for international applications for which the international search report is completed on or after 1 July 2010. Details on the criteria for the refund of international search fees are given in the Notice from the EPO dated 9 January 2009, OJ EPO 2009, 99.[**Rule 16.2 PCT; Rule 16.3 PCT; Rule 41 PCT;** ]

### ***GL A XI 2.1 Extent of file inspection***

Inspection of the files of European patent applications and of European patents is granted in respect of the original documents or of copies thereof or, if the files are stored on other media, in respect of these media. All parts of the file compiled when conducting the examination, opposition and appeal procedure with the parties are open for inspection. It also includes any invitations under **Rule 63(1)** or **Rule 62a(1)** and the search opinion if applicable.[**Rule 145(1); Rule 147(2);** ]

Observations by third parties (**Art. 115**) are an integral part of the files and as such are open to inspection in accordance with **Art. 128**. If a third party asks that his observations or a part thereof be treated confidentially, that request cannot be granted and the third party will be notified accordingly.

The parts of the file excluded from inspection are:[**Art. 128(4);** ]

(i)the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal; [**Rule 144(a);** ]

(ii)draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties; [**Rule 144(b);** ]

(iii)the designation of the inventor if he has waived his right to be mentioned as inventor under **Rule 20(1);[Rule 144(c);** ]

(iv)any other document excluded from inspection by the President of the EPO on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent. These documents include documents relating to file inspection and requests for accelerated search and accelerated examination under the "PACE" programme (if submitted using Form 1005 or in a separate document) (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3);[**Rule 144(d);** ]

(v)subject to **Rules 94.2 PCT** and **Rule 94.3 PCT**, the files of the international preliminary examination for a Euro-PCT application in respect of which the EPO is the international preliminary examining authority and for which an international preliminary examination report has not yet been established (see OJ EPO 2003, 382; see also **E-VIII, 2.10**).[**Art. 38(1) PCT; Rule 94 PCT;** ]

The parts of the file excluded from inspection are kept separate in the files from those open to inspection.

## EPO Guidelines - B Search

### *GL B II 4.2 Additional European searches*

At the examination stage of a European patent application an additional search may be necessary. The reasons for such an additional search may be, for example:

(i) amendment of claims so that they embrace matter not covered by the original search (see, however, **C-III, 3.1.1** and **H-II, 7.1**, for claims not searched because of lack of unity and **H-II, 6.2**, for amendments introducing subject-matter from the description resulting in claims defining subject-matter which is not linked by a single general inventive concept to the subject-matter originally searched);

(ii) removal by amendment or rebuttal, during substantive examination, of the deficiencies which resulted in the issuance of an incomplete search or a declaration taking the place of a search report under **Rule 63**, or a declaration under **Art. 17(2)(a) PCT** or **Art. 17(2)(b) PCT** (see **B-VIII** and **C-IV, 7.2**); [**Rule 63**; **Art. 17(2) PCT**; ]

(iii) reversal, by the Examining Division, of an opinion of the Search Division with respect to novelty or lack of inventive step (see **B-III, 1.1**) or on other issues (see **B-III, 1.2**), in particular lack of unity of invention (see **B-VII**), exclusions from the search (see **B-III, 3.11** and **B-VIII**) or **Rule 62a**; and [**Rule 64**; **Rule 62a**; ]

(iv) limitations or imperfections in the initial search.

The Examining Division makes use of documents found in such an additional search, where they are considered relevant to the examination of the application. Where a new document is used in the examination procedure, a copy must be communicated to the applicant (**Art. 113(1)**).

In a similar way, an additional search may become necessary during examination of oppositions against a European patent (see **D-VI, 5**).

#### *GL B II 4.3.2 A supplementary European search report is required*

According to decisions taken by the Administrative Council, a supplementary European search report including a search opinion pursuant to **Rule 62** is drawn up (and the search fees reduced in cases **(i)** to **(iii)**) in respect of an international application for which:

(i) the patent office of the USA, Japan, China, Australia, Russia or Korea was the International Searching Authority (OJ EPO 2005, 548; OJ EPO 2010, 133 and 141);

(ii) the Swedish, Austrian or Spanish Patent Office was the International Searching Authority and where the international application was filed on or after 1 July 2005 and also where the International Searching Authority was the patent office of Finland and the international application was filed on or after 1 April 2005 or where the Nordic Patent Institute was the International Searching Authority (see OJ EPO 2005, 422).

(iii) a supplementary international search report was drawn up by one of the European International Searching Authorities referred to in **(ii)** (OJ EPO 2009, 595; OJ EPO 2010, 316).

(iv) an international search report was drawn up by an International Searching Authority other than one of those mentioned in points **(i)** to **(iii)** and other than the EPO.

For the applications mentioned under **(i)** to **(iv)**, the supplementary European search is carried out in all the search documentation of the EPO. It is left to the Search Division's judgment whether a limitation as to the search documents is chosen. No precise limits can at present be set to these supplementary European searches since the documentation and search practice of these International Searching Authorities have not been fully harmonised in respect of the EPO.

As a general rule, the EPO should avoid any superfluous work and duplication of work and should rely on the efficiency and quality of the international searches to the largest extent possible. The EPO as designated Office requests the International Searching Authority or the Supplementary International Searching Authority to supply, together with the international search report, copies of the documents cited therein (**Art. 20(3) PCT**, see also **Rule 44.3(a) PCT** or **Rule 45bis.7(c) PCT**). When documents are cited that are not in one of the official languages of the EPO and the Search Division needs a translation into one of these languages, it should provide this itself (e.g. a patent family member in an official language of the EPO or, alternatively, an abstract of the document in an official language of the EPO, see **B-VI, 6.2**), unless it is able to obtain it from any other source, e.g. the applicant or the International Searching Authority.

The Search Division should consider the opinions on patentability expressed by the ISA, SISA and/or IPEA, whether contained (implicitly) in the search report or (explicitly) in the written opinion accompanying the search report. The Search Division is nevertheless free to deviate from any or all of these opinions when performing a supplementary European search and when preparing the search opinion.

### ***GL B II 4.5 International-type searches***

Under the PCT, the EPO, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (**Art. 15(5) PCT**). These searches are by definition similar to international searches, and the same considerations apply, except where unity of invention is lacking; in case of a lack of unity in a national application subject to an international-type search, no reasoned statement on the lack of unity is included in the search report. Furthermore, no invitation to pay additional fees is issued, but applicants may have the possibility to pay these fees directly to the national offices. In cases where a written opinion is established, it is drafted in accordance with EPO practice under **PCT Chapter I**, including a reasoned statement in respect of any potential lack-of-unity objection.

### ***GL B III 2.1 Completeness of the search***

The European search is essentially a thorough, high-quality, all-embracing search. Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any information retrieval system and its implementation. The search should be carried out in such a manner as to reduce to a minimum the possibility of failing to discover complete anticipations for any claims, or other highly relevant prior art. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower recall ratio can be accepted (see in this context, however, **B-III, 2.3**). For limitations of the subject-matter searched by the EPO, see **B-VIII**.

The scope of the international search is defined in **Art. 15(4) PCT** 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 PCT**). It follows from this definition ("as its facilities permit") that the scope of an international search shall be equivalent to a European search. International and European searches shall thus be fully compatible. In accordance therewith, if the EPO carried out the international search or the supplementary international search, no supplementary European search report need be drawn up and the international search report made by the EPO takes unconditionally the place of the European search report (**Art. 153(6) EPC**, see OJ EPO 2009, 595, and OJ EPO 2010, 316; see also **B-II, 4.3**).

### ***GL B III 3.3.1 General considerations***

Where a European application does not derive from an earlier international application, the applicant may not amend the claims before receiving the European search report (**Rule 137(1)**). Consequently,

in these cases, the search is directed to the claims as originally filed, in the European application, or to the set of claims filed according to **Rule 57(c)** or **Rule 58**. [**Rule 56**; **Rule 137(1)**; ]

If the application documents used for the search contain missing parts of description and/or missing drawings filed under **Rule 56(3)** and the examiner expects the application to be re-dated by the Examining Division at a later stage of the procedure (see **C-III, 1**), he should extend the scope of the search, such as also to cover prior art which will be relevant for assessing the novelty and inventive step of the subject-matter claimed on the basis of a possible new date of filing of the application (see also **B-XI, 2.1**). The same applies to Euro-PCT applications when the application contains missing parts of the description, drawings or claims and/or missing elements filed under **Rule 20.6 PCT**.

Missing parts of the description and/or missing drawings filed under **Rule 56** are always considered to be part of the application documents "as originally filed".

### ***GL B III 3.3.2 Specific rules applicable to Euro-PCT applications***

Where a European application derives from an earlier international application, the applicant may have amended the international application in the international phase, either after receipt of the international search report (**Art. 19(1) PCT**) or during international preliminary examination (**Art. 34(2)(b) PCT**). The applicant may then specify that he wishes to enter the European phase with these or otherwise amended application documents (including claims) according to **Rule 159(1)(b)**. Furthermore, the applicant is given the opportunity by the EPO to amend the application documents (including the claims) within a set time limit (**Rule 161(2)**, see **E-VIII, 3**). The application as amended serves as the basis for any supplementary European search which has to be performed pursuant to **Art. 153(7)** (see **B-II, 4.3** and **B-XI, 2**). [**Rule 159(1)(b)**; **Rule 161**; ]

Where the claims of an international application on entry into the European (regional) phase are amended in such a way as to contravene **Art. 123(2)**, the procedure explained in **B-VIII, 6**, applies.

### ***GL B VI 2 State of the art – oral disclosure, etc.***

According to **Rule 33.1(a) PCT** and **Rule 33.1(b) PCT**, oral disclosure, use, exhibition, etc. are recognised as prior art only when this is substantiated by a written disclosure. In contrast, according to **Art. 54 EPC**, a public oral description, use, etc. is considered as prior art. However, the examiner, in carrying out a European search, should cite an oral description, etc. as prior art only if he has available a written confirmation or is otherwise convinced that the facts can be proved. Such references to oral disclosure, prior public use, disclosure by sale, etc. are more usually brought up by opponents in opposition proceedings (see **G-IV, 7.1** to **G-IV, 7.4**).

### ***GL B VIII 1 General remarks***

In relation to searches carried out for European patent applications, the subject-matter listed in **Rule 39.1 PCT** may be considered under the EPC either not to be susceptible of industrial application (**Art. 57**) or, to the extent to which the European patent application relates to that subject-matter as such, to be excluded from patentability under **Art. 52(2)** and **Art. 52(3)**, or to constitute an exception to patentability under **Art. 53(b)** and **Art. 53(c)**. The claims are not searched in as far as they relate to such subject-matter (for the procedure for limiting the search according to **Rule 63** see **B-VIII, 3.1** to **B-VIII, 3.4**). For the specific case of compositions for use in methods of treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, see **B-VIII, 2.1**, below. [**Art. 52(2)**; **Art. 52(3)**; **Art. 53**; **Art. 57**; **Rule 63**; ]

While a decision on these matters rests with the Examining Division, opinions on these matters are formed by the Search Division for the purpose of drafting the search opinion (if applicable, see **B-XI, 7**) and also in considering possible limitations of the search and therefore whether or not to apply the procedure provided for under **Rule 63(1)** (see **B-VIII, 3.1** to **B-VIII, 3.4**). The Search Division has

thus to consider the requirements for patentability other than novelty and inventive step, as set out in **G-II** and **G-III**.**[Art. 52; ]**

The above-mentioned situations may also occur for only some of the claims or for part of a claim. In these cases, this will be indicated in the invitation according to **Rule 63(1)** and in any subsequent incomplete search report or the declaration taking the place of the search report under **Rule 63(2)**.**[Rule 63; ]**

### ***GL B IX 1.1 Organisation and composition of the documentation available to the Search Divisions***

The basic part of the search documentation consists of a collection of patent documents systematically accessible in a manner suitable for searching. Additionally, periodicals and other publications of technical literature are put at the disposal of the examiners. This non-patent literature is accessible through in-house or external databases, some of which are arranged in the library in a manner suitable for consultation; parts thereof, such as particularly relevant articles, are selected and made available for direct access by incorporating these, or copies thereof, into the systematic documentation. The systematically accessible part of the search documentation includes the minimum documentation required for an International Searching Authority under **Rules 34 PCT** and **Rule 36.1(ii) PCT** and extends somewhat beyond these minimum requirements.

#### ***GL B IX 2.1 PCT minimum documentation***

The systematically accessible search documentation includes the national patent documents belonging to the PCT minimum documentation as specified in **Rule 34.1(b)(i) PCT** and **Rule 34.1(c) PCT**.

Also included are published international (PCT) and regional (e.g. European) patent applications, patents, and inventors' certificates (**Rule 34.1(b)(ii) PCT**).

A complete list of the contents of the PCT minimum documentation is available on the WIPO website.

### ***GL B X 7 Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A)***

Supplemental sheet A is prepared by the examiner before publication of the application, regardless of whether this is with the search report (A1 publication) or without it (A2 publication). The information contained in supplemental sheet A is needed for the publication of the application.

On supplemental sheet A, the examiner indicates:

(i)approval or amendment of the text of the abstract, the content of which is communicated to the applicant according to **Rule 66** (see **A-III, 10**). Examination of the abstract does not go beyond ensuring that it relates to the application concerned and that there is no conflict with the title of the invention or with the classification of the application. Since the abstract should relate to the application as filed, the examiner should consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search.**[Rule 47(1); Rule 66; ]**

If the search report is published separately (A3 publication), information about the abstract is not given in the communication. The information sent to the applicant includes the title of the invention and the figure, if any, of the drawings to be published with the abstract.

In exceptional cases, the examiner may change the abstract after the search has been carried out. However, if this is done after the application has been published A2, supplemental sheet A is not reissued;

(ii)approval or amendment of the title of the invention (see **A-III, 7**);**[Rule 41(2)(b); ]**



(iii) approval, modification or abolition of the selection of the figure which is to accompany the abstract (see **F-II, 2.3(vi)** and **F-II, 2.4**); and [**Rule 47(4)**]; ]

(iv) the translation of the title of the European application into the two other official languages. [**Art. 14(7)(a)**]; ]

The European Patent Bulletin is published in all three official languages of the EPO according to **Art. 14(7)(a)** and contains the entries made in the Register of European Patents, which, according to **Rule 143(1)(c)**, must contain the title of the invention. Consequently, the title is required in all three official languages of the EPC.

The above applies equally to applications published with the search report (A1 publication) and those published without it (A2 publication). In the case of an A2 publication, supplemental sheet A further contains the official classification of the application (see **B-X, 5**). In case of an A1 publication, the official classification appears only on the search report (**Rule 61(6)**).

Supplemental sheet A also indicates the nature of the publication to which it relates (A1 or A2).

In the case of a supplementary European search report in respect of an international application, supplemental sheet A should be marked A4. The examiner does not determine the title, abstract or figure to be published with the abstract, since these have already been determined by the International Searching Authority according to **Rules 37.2 PCT**, **Rules 38.2(a) PCT** and **Rules 8.2 PCT**, respectively.

### ***GL B XI 2 Basis of the search opinion***

Where the application is a European application not derived from an International application, the applicant cannot amend his application before the search report has been communicated to him. Consequently, in these cases, the search opinion will always relate to the application documents as originally filed. Furthermore, any reply filed by the applicant in response to an invitation according to **Rule 63(1)** (see **B-VIII, 3.4**) will also be taken into consideration when drawing up the search opinion. [**Art. 123(1)**; **Rule 137(1)**]; ]

However, where the application under consideration derives from an International application and is subject to a supplementary European search according to **Art. 153(7)** (see **B-II, 4.3**), the applicant will have had the opportunity to amend his application both in the International phase and also upon entry into the European phase. The search opinion will then be based on the application documents constituting the latest filed request from the applicant (this may involve the cancellation of amendments previously filed and consequent reversion in part or in full to an earlier set of application documents). The supplementary European search report is also based on these application documents (see **B-II, 4.3**, and **B-III, 3.3.2**). [**Rule 161(2)**; **Rule 159(1)(b)**; **Art. 19 PCT**; **Art. 34(2)(b) PCT**]; ]

Where the search opinion and supplementary European search report are based on such amendments but **Rule 137(4)** has not been satisfied (see **H-III, 2.1**), a communication according to **Rule 137(4)** (see **B-VIII, 6** and **H-III, 2.1.1**) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the Examining Division (see **C-II, 1**). However, once the Examining Division has assumed responsibility for the application, it may send such a communication, provided that the amendments in question have not been withdrawn or superseded (see **H-III, 2.1.1**) and only where the application is of one of the types mentioned in **H-III, 2.1.4**.

#### **2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT**

#### **2.2 Applications containing claims filed after the accorded date of filing**

### ***GL B XI 2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT***

GL B XI 2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT

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If the Receiving Section decided not to re-date the application under **Rule 56(2)** or **Rule 56(5)**, but the search examiner is of the opinion that the subsequently filed missing parts are not "completely contained" in the priority document and/or the requirements of **Rule 56(3)** are not fulfilled, he should carry out the search also taking into account prior art which might become relevant for assessing novelty and inventive step of the subject-matter claimed if the application were re-dated pursuant to **Rule 56(2)** or **Rule 56(5)**. The search opinion must include a warning that the application seems not to fulfil the requirements laid down in **Rule 56** for maintaining the accorded date of filing, a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the Examining Division. If appropriate, the search opinion may also include comments about the effect of re-dating on the priority claim and/or the status of the prior art documents cited in the search report.

The procedure for a Euro-PCT application is similar to that set out above. If when carrying out a supplementary European search the examiner finds that the subsequently filed missing parts are not "completely contained" in the priority document, despite the fact that the Receiving Office did not re-date the application under **Rule 20.5(d) PCT**, the search opinion must include a warning that the application seems not to comply with the requirements of **Rule 20.6 PCT (Rule 82ter.1(c) PCT)**, a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the Examining Division.

However, if the application has been re-dated by the Receiving Section or receiving Office, but the search examiner has reasons to believe that the application meets the requirements of **Rule 56(3)** (or **Rule 20.6 PCT**), he must indicate in the search opinion that decisions given by the Receiving Section (or the receiving Office) may be reconsidered at a later stage by the Examining Division, except where the latter is bound by a decision of the Board of Appeal.

## EPO Guidelines - C Procedural Aspects of Substantive Examination

### *GL C II 1.2 Euro-PCT applications*

If the application has proceeded via the PCT (Euro-PCT application), the six-month period under **Rule 70(1)** begins with the publication of the PCT search report or the declaration under **Art. 17(2)(a) PCT**. However, as is laid down in **Art. 150(2)**, the time limit for requesting examination in a Euro-PCT case does not expire before the time prescribed in **Art. 22 PCT** and **Art. 39 PCT** (i.e. not before the time limit of **Rule 159(1)(f)**). The time limit will not be affected by whether a supplementary European search pursuant to **Art. 153(7)** needs to be made or whether the international application pursuant to **Art. 153(4)** is again published by the EPO. [**Art. 153(4)**; **Art. 153(6)**; **Art. 153(7)**; **Art. 150(2)**; **Rule 159(1)(f)**; ]

If the request for examination of a Euro-PCT application has not been filed within the time limit, the application is deemed withdrawn under **Rule 160(1)**. In such a case, however, the applicant has the possibility of filing a request for further processing pursuant to **Art. 121**. [**Art. 121**; **Rule 136(3)**; **Rule 160(1)**; ]

Where the Euro-PCT application is subject to the preparation of a supplementary European search report (see **B-II, 4.3**), once this search report to the applicant has been dispatched to him, the applicant is sent a communication according to **Rule 70(2)**, inviting him to confirm the request for examination within six months of the notification of that communication (see **E-VIII, 2.5.3**).

### *GL C II 3.2 Response to PCT actions prepared by the EPO*

For Euro-PCT applications where the EPO acted as the International Searching Authority (ISA) and, where a demand under **Art. 31 PCT** was filed, also as the International Preliminary Examining Authority, or as the authority specified for supplementary international search, the applicant will already have responded to a negative WO-ISA, IPER or supplementary international search report prepared by the EPO (unless the communication under **Rule 161** was issued before 1 April 2010 - see **E-VIII, 3.3.3**). [**Rule 161(1)**; ]

This response may comprise amendments and/or observations filed in response to the communication under **Rule 161(1)** (or possibly filed earlier - see **E-VIII, 3.3.1**). Any amendments filed at this stage are made by the applicant of his own volition in accordance with **Rule 137(2)** (for more details see **C-III, 2.2**). This response will be taken into account by the Examining Division when drafting the first communication according to **Art. 94(3)**. For more details, see **E-VIII, 4.1**, **E-VIII, 4.2** and **E-VIII, 4.3**.

### *GL C III 1 Missing drawings or parts of the description filed under Rule 56 or claims filed after accordance of a date of filing*

Where the applicant has supplied missing drawings or parts of the description after accordance of a filing date (see **A-II, 5**) under **Rule 56**, and the Receiving Section has determined that the missing drawings or parts of the description are "completely contained" in the claimed priority application, the application is not re-dated to the date on which the missing drawings or parts of the description were supplied. The Examining Division may review the findings of the Receiving Section on the applicability of **Rule 56(3)**, unless those findings have become final after a decision of a Board of Appeal. Should the Examining Division come to the conclusion that the missing elements are not "completely contained" in the priority document, contrary to the original finding of the Receiving Section, it must communicate this to the applicant and, once it has been established that the right to be heard under **Art. 113(1)** has been observed, notify him of the new date of filing (see **A-II, 5**). The

Examining Division must also inform the applicant that the missing drawings or parts of the description can still be withdrawn within two months from the date of notification of the new date of filing. If the applicant opts for withdrawal, the re-dating of the application will be deemed not to have been made (see also **B-XI, 2.1**). For Euro-PCT applications a review is possible under **Rule 82ter PCT**. [**Rule 56**; ]

If the applicant does not agree with the finding of the Examining Division, he may (within the above time limit) request an appealable decision on the matter. In this case, the examiner will issue a reasoned decision, informing the applicant of the new date of filing, of the reasons for the re-dating and (where appropriate) of the detrimental effect of the re-dating on the claimed priority right. This decision will allow a separate appeal according to **Art. 106(2)**. [**Rule 111**; ]

Once the period for filing an appeal has expired without an appeal being filed, the examiner will resume examination on the basis of the new date of filing.

If the applicant files an appeal in due time, competence for the file passes to the Board of Appeal for reviewing the decision on the accordance of a filing date. While the case is pending before the Board of Appeal, the Examining Division will not continue substantive examination. Once the Board of Appeal has issued a decision, the file will be returned to the examiner, who will be bound on this point by the decision of the Board (**Art. 111(2)**). He will then resume examination.

If the claims were not present at the date of filing the application, the Examining Division must check whether the subsequently filed claims satisfy the requirements of **Art. 123(2)**. If the basis for these subsequently filed claims in the application as filed has not been indicated by the applicant (see **H-III, 2.1**) and the application is one of those mentioned in **H-III, 2.1.4**, the Examining Division may send a communication according to **Rule 137(4)** requesting the applicant to provide this information (see **H-III, 2.1.1**). [**Art. 123(2)**; ]

### ***GL C III 3.1.1 No additional search fees paid***

If the applicant has not availed himself of the opportunity to have the search results on the other inventions included in the search report because he has paid no additional search fees in response to the invitation under **Rule 64(1)** (see **B-VII, 1.2**), he will be taken to have elected that the application should proceed on the basis of the invention which has been searched (see **G 2/92**). [**Rule 64**; ]

The same applies where the applicant has paid no additional international search fees to the EPO acting as ISA in response to the communication under **Art. 17(3)(a) PCT** (leading to the preparation of an international search report by the EPO relating only to the invention first mentioned in the claims, see also **E-VIII, 4.2**). The same also applies where the EPO prepares a supplementary European search report (see **B-II, 4.3** and **B-VII, 2.3**) limited to the invention first mentioned in the claims because of a lack of unity, and where the EPO prepares a supplementary international search report on one invention, also as a result of a finding of a lack of unity. [**Rule 164(1)**; **Rule 164(2)**; ]

It must be taken into account that the final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the Examining Division (see **T 631/97**). When considering the issue of unity, the Examining Division will consider both the reasons given in the search opinion and the applicant's response thereto (see **B-XI, 8** for details of when a response to the search opinion is required); for Euro-PCT cases where no supplementary European search report is prepared, the Examining Division will consider the reasons given in the WO-ISA, IPER or supplementary international search report prepared by the EPO and the applicant's response thereto as required by **Rule 161(1)** (see **E-VIII, 3.2**). In the absence of any convincing response from the applicant to the issue of unity as raised earlier, the Examining Division will normally initially uphold the position taken earlier (see **B-XI, 1.2**) and will then require deletion of all the inventions other than that which has been searched. If the Examining Division is convinced, e.g. by arguments from the applicant, that the opinion on unity at the search stage was incorrect, then an additional search is performed for that part of the subject-matter which is judged to be unitary with an invention which was searched (see **B-II, 4.2(iii)** and **C-IV, 7.2**) and the examination is carried out on

those claims which comply with the requirement of unity of invention. The applicant may file a divisional application for any excised subject-matter (see **C-III, 3.2**).

### ***GL C III 3.3 Refund of additional search fees***

If the applicant has paid further search fees in response to an invitation of the Search Division under **Rule 64(1)** and has requested a refund of these, the Examining Division is required to review the validity of the finding of lack of unity (see also **F-V, 10** to **F-V, 13**). [**Rule 64(2)**; ]

Requests for refunds should be handled promptly. If the examiner concludes that a request for refund should not be granted, an interlocutory decision to that effect should be issued at the earliest opportunity, subject to the requirements of **Art. 113(1)**, and the issuing of the decision should not normally be left until the final decision on the application. Of course, if the stage in the procedure at which the examiner is in a position to issue the decision on the refund coincides with the issuing of either a **Rule 71(3)** communication or a decision refusing the application, then in the former case the interlocutory decision can be issued with the **Rule 71(3)** communication, and in the latter case the decision on the refund can be included in the decision refusing the application. An interlocutory decision issued on this matter will allow separate appeal under **Art. 106(2)**.

Moreover, it is essential to bear in mind that the review under **Rule 64(2)** is restricted to a reconsideration of the validity of that original finding under the circumstances existing at the time the **Rule 64(1)** invitation was sent, taking into account only the prior art which was available at that time. For more details on the assessment of unity of invention see **F-V**.

The issue of refunds of additional **international** search fees paid to the EPO acting as ISA in response to an invitation under **Art. 17(3)(a) PCT**, however, does not arise in the European phase, because these fees were paid in the international phase, which is closed by this stage of the procedure. The applicant may contest the payment of additional international search fees to the EPO acting as ISA by paying these under protest according to **Rule 40.2(c) PCT**. However, this must be done in the **international** phase (see also the Decision of the President of the EPO dated 24 March 2010, OJ EPO 2010, 320 and the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 322).

### ***GL C IV 2 Extent of examination of replies***

After the first examination stage, provided that the:

- search opinion,
- WO-ISA (when prepared by the EPO),
- explanation accompanying the supplementary international search report under **Rule 45bis.7(e) PCT** (when prepared by the EPO, see the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 316, point 6),
- IPER (when prepared by the EPO), or
- first communication (see **B-XI, 1.1** and **B-XI, 8**)

was comprehensive and clear (see **B-XI, 3**, and **C-III, 4** and **C-III, 4.1**), the examiner will not normally need to completely reread the application but rather should concentrate on the amendments themselves, the related passages, and the deficiencies previously noted.

## EPO Guidelines - E General Procedural Matters

### *GL E VIII 1 General remarks*

The EPO may be a "designated Office" or an "elected Office" for an international application filed under the Patent Cooperation Treaty (PCT) designating "EP" (Euro-PCT application). Such application is thereby deemed to be a European application (Euro-PCT application) for the purposes of the EPC. However, in the case of Euro-PCT applications, the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, e.g. in the case of certain time limits, the provisions of the PCT prevail. According to **Art. 153(1)(a)**, the EPO is a designated Office for Contracting States to the EPC in respect of which the PCT has entered into force, which are designated in the international application and for which the applicant wishes to obtain a European patent. If the applicant has elected a designated State, the EPO is an elected Office (**Art. 153(1)(b)**, for details see **E-VIII, 2.1.1**). [**Art. 153(1)(a)**; **Art. 153(1)(b)**; **Art. 153(2)**; **Art. 150(2)**; ]

In addition to being a designated Office, the EPO may act as a receiving Office under the PCT within the terms set out in **Art. 151**. Furthermore, it may also act as an International Searching Authority (ISA), as an International Preliminary Examining Authority (IPEA) under the terms of **Art. 152** and/or as a Supplementary International Searching Authority (SISA) under the PCT. There are thus the following possibilities for a European application filed under the provisions of the PCT: [**Art. 151**; **Art. 152**; **Rule 157**; **Rule 158**; ]

(i) the filing of the application and the international search take place at an office or offices other than the EPO (e.g. the Japan Patent Office). The EPO is a designated Office;

(ii) the application is filed at another office (e.g. the United Kingdom Patent Office) but the EPO performs the international search. The EPO acts as International Searching Authority and is a designated Office;

(iii) the application is filed at the EPO, which also performs the international search. The EPO acts as receiving Office, International Searching Authority and designated Office;

(iv) in addition to the cases mentioned under (i) - (iii), the applicant files a demand for international preliminary examination. The EPO is the "elected Office";

(v) the EPO is the International Preliminary Examining Authority. It may carry out this function without being the receiving Office, a designated Office or an elected Office. The EPO can, however, only act as an IPEA if the international search was carried out by the EPO, the Austrian, Spanish, Swedish or Finnish Patent Office or the Nordic Patent Institute;

(vi) if the international search has been carried out by an office other than the EPO, the applicant may still request the EPO to perform a supplementary international search (SIS) in its capacity as SISA.

In case (i), the European application will be accompanied by an international search report drawn up by another office. In cases (ii) and (iii), the international search report and the "written opinion of the International Searching Authority" (WO-ISA) (**Rule 43bis PCT**) will be prepared by the Search Division of the EPO. In case (iv), the international search report and the international preliminary examination report may be drawn up by the EPO or by another International Searching Authority and International Preliminary Examining Authority.

For further details, in particular as to deadlines and procedural steps before the EPO as RO, ISA, IPEA or SISA, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT".

### *GL E VIII 2.1.2 Initial processing and formal examination; copy of the international application; translation*

**GL E VIII 2.2 Provisions of Chapter A-II ("Filing of applications and examination on filing")**

The initial processing and formal examination of international applications in the international phase are carried out by PCT authorities under the PCT. Unless there is a specific request from the applicant, the EPO acting as a designated or elected Office may not process or examine an international application prior to the expiry of 31 months from the date of filing of the application or, if priority has been claimed, from the earliest priority date (31-month time limit), (see **E-VIII, 2.8** and **E-VIII, 2.5.2**). Since the EPO has not exercised the waiver referred to in **Art. 20(1)(a) PCT**, a copy of the international application will be furnished by the International Bureau. The EPO does not require the applicant to furnish a copy of the international application under **Art. 22 PCT** or **Art. 39 PCT**, even if the International Bureau has not yet communicated a copy under **Art. 20 PCT** at the time the application enters the European phase (see PCT Gazette 14/1986, 2367). [**Art. 23 PCT; Art. 40 PCT; Rule 49.1(a-bis) PCT; Art. 24(1)(iii) PCT; Rule 159(1); Rule 160; Art. 121; Art. 2, No. 12, RFees;** ]

Where the language of the international application is not an official language of the EPO, the applicant is required, in accordance with **Art. 22 PCT** or **Art. 39 PCT** and **Rule 159(1)(a)**, to furnish a translation within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit). The application is deemed to be withdrawn if the translation is not furnished within that period (**Rule 160(1)**). If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates this to the applicant (**Rule 160(3)**).

**Rule 112(2)** applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation and a valid request for further processing (including the payment of the requisite fee) are filed (**Art. 121** and **Rule 135(1)**).

Where an international application was filed and published in the international phase in an official language of the EPO, it is not possible to change the language of the proceedings on entry into the European phase by filing a translation of that application into either of the other two official languages of the EPO (see **G 4/08**). In such cases, the language of the proceedings within the meaning of **Art. 14(3)** remains the language in which the application was published by WIPO's International Bureau and cannot be changed.

***GL E VIII 2.2 Provisions of Chapter A-II ("Filing of applications and examination on filing")***

The provisions of **A-II, 1** ("Where and how applications may be filed") do not apply to international applications, except where explicit reference is made to international applications, including Euro-PCT applications.

The PCT requirements corresponding to those of **A-II, 2** ("Persons entitled to file an application") are more restrictive, as in general the applicant must be a resident or national of a PCT Contracting State and therefore no supplementary examination should be necessary.

The provisions of **A-II, 3** ("Procedure on filing") do not apply.

The provisions for late filing of missing parts completely contained in the priority document (**Rule 56**) exist also under the PCT (**Rule 20.5 PCT** to **Rule 20.8 PCT**).

The date of filing (see **A-II, 4** ("Examination on filing")) of a Euro-PCT application is that accorded under the PCT by the PCT authority which acted as the receiving Office. The formalities examination upon entry into the European phase encompasses all checks required to verify that the requirements of **Rules 159** and **Rule 163** have been met.

If the application is not deemed to be withdrawn, a copy of the application is referred to the Search Division for drawing up any supplementary European search report, if necessary (see **E-VIII, 3.1**).

***GL E VIII 2.3.1 Representation***

The provisions of **A-III, 2** ("Representation") apply to international applications whether furnished in an official language or in translation. An agent having a right to practise before the PCT International Authorities is not necessarily authorised to act before the EPO (see **Art. 27(7) PCT**). For the representation of applicants before the EPO as designated or elected Office see the latest version of the Guide for Applicants "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT".

If there is more than one applicant and the following information was not provided for one or more of those applicants in the International phase and is still missing at the expiry of the 31-month time limit under **Rule 159(1)**: [**Rule 163(4)**; **Rule 163(6)**; ]

(i) address

(ii) nationality

(iii) State of residence or principal place of business

the EPO will invite the applicant to furnish these indications within two months. Failure to do so will lead to refusal of the application. The same applies if the requirements for representation are not met at the end of the 31-month time limit, with the same consequence for failure to correct the deficiency in time. If the applicant fails to reply in time to the above-mentioned invitation, he may request further processing.

### ***GL E VIII 2.3.5 Claim to priority***

The claim to priority (see **A-III, 6** ("Claim to priority")) for an international application refers to the date, or dates, claimed under the PCT. Normally, the copy of the previous application, referred to in **A-III, 6.7**, i.e. the priority document, is furnished to the EPO as designated Office by the International Bureau and not by the applicant. In accordance with **Rule 17.2 PCT**, the International Bureau will be requested by the EPO to furnish it with a copy as standard practice promptly, but not earlier than international publication, or, where the applicant has requested early examination (in accordance with **Art. 23(2) PCT**), not earlier than the date of the request. Where the applicant has complied with **Rule 17.1(a) PCT** and **Rule 17.1(b) PCT**, the EPO may not ask the applicant himself to furnish a copy. [**Rule 17.1 PCT**; **Rule 17.2 PCT**; ]

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the 31-month time limit, the EPO invites the applicant to furnish the number or the copy within a specified period. However, **Rule 53(2)** and the Decision of the President of the EPO dated 17 March 2009, OJ EPO 2009, 236, providing an exception to the requirement that a copy of the previous application be furnished (see **A-III, 6.7**), also apply to international applications entering the European phase. Furthermore, as just mentioned, where the applicant has complied with **Rule 17.1(a) PCT** or **Rule 17.1(b) PCT** the EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document (**Rule 17.2(a) PCT**, second sentence). [**Rule 163(2)**; ]

If the priority document is not on file, substantive examination may nevertheless be started, provided that neither intermediate documents (published in the priority period) nor **Art. 54(3)** documents exist which cause the patentability of the subject-matter claimed to depend on the validity of the priority right. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing. In such cases, however, the application may be refused without the priority document being on file, provided that the relevant prior art is neither an intermediate document nor an **Art. 54(3)** document, the relevance of which depends on the validity of the priority right. For more details on treatment of such cases in examination see **F-VI, 3.4**.

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed on request from the EPO in accordance with **Rule 53(3)** (see **A-III, 6.8** and **A-III, 6.10**). [**Art. 88(1)**; **Rule 53(3)**; ]



The provisions for restoration of priority right (see **A-III, 6.6**) exist also under the PCT (**Rules 26bis.3 PCT** and **Rule 49ter PCT**). Under the PCT, restoration of right of priority can be made either in the international phase before the receiving Office (**Rule 26bis.3 PCT**) or upon entry into the European phase before the EPO (**Rule 49ter.2(b)(i) PCT**).

It should be noted that the EPO as both receiving Office and designated/elected Office applies the "due care" criterion in accordance with its practice under **Art. 122 (Rules 26bis.3(a)(i) PCT and Rule 49ter.2(a)(i) PCT)**. As a consequence, any request for restoration of priority rights granted by a receiving Office under the "unintentional" criterion is not valid in the procedure before the EPO as designated/elected Office (**Rule 49ter.1(b) PCT**).

### ***GL E VIII 2.3.6 Title of the invention***

In relation to **A-III, 7** ("Title of the invention"), the title need only meet the less demanding requirements of **Rule 4.3 PCT** rather than those set out in **A-III, 7.1** and **A-III, 7.2**.

### ***GL E VIII 2.3.7 Prohibited matter***

As prohibited statements or matter may not necessarily be omitted under **Art. 21(6) PCT**, the application must be examined to ensure that the provisions of **A-III, 8** ("Prohibited matter") are complied with. Where the EPO is informed by the International Bureau that statements or matter were omitted from the published PCT application, the Receiving Section should ensure that the corresponding material is excluded from the translation as furnished by the applicant.

### ***GL E VIII 2.3.11 Designation fee***

The time limit for paying the designation fee is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit), if the time limit specified in **Rule 39(1)** has expired earlier (**Rule 159(1)(d)**) (see **A-III, 11.2.5**, for further details). If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of all Contracting States of the EPC is withdrawn, the Euro-PCT application, insofar as it is deemed to be a European application pursuant to **Art. 153(2)** and **Art. 11(3) PCT**, is deemed to be withdrawn.

For information on the requirements for extension of a Euro-PCT application to States for which an Extension Agreement with the EPO has become effective, see **A-III, 12**.

### ***GL E VIII 2.4.1 Divisional applications***

In relation to **A-IV, 1** ("European divisional applications") there is no provision in the PCT for filing divisional applications. One or more European divisional applications may be filed in respect of subject-matter contained in a pending Euro-PCT application, but not before the latter application has entered the European phase (see **A-IV, 1.1.1**), i.e. not before the time limit under **Rule 159(1)** (in conjunction with **Art. 22(1) PCT** and **Art. 22(3) PCT**) has expired (see **G 1/09**, Reasons 3.2.5), and on condition that any requirement of **Art. 22(1) PCT** which must be fulfilled within that time limit for the application concerned is met (see **J 18/09**). Furthermore, divisional applications may be filed as from the date the applicant has requested early processing in accordance with **Art. 23(2) PCT** (see **J 18/09**, Reasons 9). For the sake of completeness it is noted that the requirements of **Rule 36** for filing divisionals must be complied with (see **A-IV, 1**). The divisional application must be filed in the language specified in **Rule 36(2)** (see **A-IV, 1.3.3**). In order to avoid that the Euro-PCT application is deemed withdrawn at the time a divisional application is filed, the respective requirements of **Rule 159(1) EPC** must be fulfilled within the relevant time limits (see also the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT").

### ***GL E VIII 2.4.2 Sequence listings***

**Rules 5.2 PCT** and **Rule 13ter PCT** apply to the filing of sequence listings (see **A-IV, 5** ("Applications relating to nucleotide and amino acid sequences")). The EPO as International Searching Authority (see **E-VIII, 3**) makes use of the opportunity under **Rule 13ter.1 PCT** to invite the applicant where appropriate to furnish it with the prescribed sequence listing in electronic form according to WIPO Standard ST.25, paragraph 39 ff (see Art. 4 of the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372 with the accompanying Notice from the EPO dated 28 April 2011, OJ EPO 2011, 376 (point II)). The furnishing of sequence listings in response to an invitation under **Rule 13ter.1 PCT** is subject to a late furnishing fee (see **Rule 13ter.1(c) PCT**). If the required sequence listing is received after the applicable time limit but before the start of the international search, it will be considered by the EPO in its capacity as ISA as if it had been received within that time limit.

For Euro-PCT applications entering the regional phase before the EPO, the applicant will be invited to furnish a sequence listing in accordance with WIPO Standard ST.25 and pay a late furnishing fee within a period of two months, if such a sequence listing is not available to the EPO at the expiry of the 31-month time limit (see **Rule 163(3)** and **Rule 30(3)**). The filing of a sequence listing is not required on paper (see Art. 5 of the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372 and the accompanying Notice from the EPO dated 28 April 2011, OJ EPO 2011, 376).[**Rule 163(3);** ]

### ***GL E VIII 2.5.1 Publication of the international application***

The international publication of a Euro-PCT application in an official language of the European Patent Office takes the place of publication of the European patent application and will be mentioned in the European Patent Bulletin. If the international publication of the Euro-PCT application is in another language, a translation into one of the official languages must be filed with the EPO within 31 months of the priority date (**Art. 22(1) PCT** and **Rule 159(1)(a)**). The EPO will publish the translation. [**Art. 153(3); Art. 153(4); Rule 159;** ]

If the translation is not supplied, the application is to be deemed withdrawn (**Art. 24(1) PCT**, **Rule 160(1)**). Furthermore, in this case, the application which has been published under the PCT is not considered as comprised in the state of the art in accordance with **Art. 54(3)** (see **G-IV, 5.2**). However, if the EPO finds that the application is deemed to be withdrawn because the translation was not filed in due time, it must first communicate this to the applicant (**Rule 160(3)**). **Rule 112(2)** applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation is supplied, a request for further processing under **Art. 121** and **Rule 135(1)** is filed, and the fee for further processing is paid.[**Rule 160(1);** ]

### ***GL E VIII 2.5.2 Request for examination***

The time limit under **Rule 70(1)** for filing the request for examination referred to in **A-VI, 2** runs from the date of publication under **Art. 21 PCT** of the international search report. However, this time limit will not expire before the time prescribed by **Rule 159(1)(f)** (31-month time limit). See also **E-VIII, 2.1.3**. [**Art. 153(6); Art. 150(2); Rule 159(1)(f);** ]

European substantive examination must normally not begin before expiry of the 31st month from the earliest priority date (**Art. 40(1) PCT**). The only circumstance in which examination may begin earlier is if the applicant has expressly so requested and if any required supplementary search report is available (**Art. 40(2) PCT**).

### ***GL E VIII 2.7 Communication to the EPO as a designated Office***

A copy of the application together with the international search report or a declaration in accordance with **Art. 17(2)(a) PCT** is communicated by the International Bureau to the EPO as a designated Office in accordance with **Art. 20(1)(a) PCT**. Furthermore, the EPO does not require the applicant to furnish a copy of the international application (**Rule 49.1(a-bis) PCT**). The EPO as a designated Office will then examine the application for compliance with the requirements of the EPC (see in particular **E-VIII, 2.3**).[**Art. 20(1)(a) PCT**; **Rule 44bis.2 PCT**; ]

The International Bureau shall communicate the International Preliminary Report on Patentability (**Chapter I of the PCT**) and any informal comments received from the applicant to the EPO as designated Office at 30 months from the priority date.

### ***GL E VIII 2.8 Delaying of the procedure before the EPO***

When acting as a designated Office, the EPO must not process or examine an international application before expiry of the period applicable under **Art. 22 PCT** (**Art. 23(1) PCT**). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (**Art. 23(2) PCT**). The applicant may request the International Bureau to communicate a copy of the Written Opinion established by the International Searching Authority to the EPO as designated Office once a request under **Art. 23(2) PCT** is made.[**Art. 23 PCT**; **Rule 44bis.2 PCT**; ]

### ***GL E VIII 2.9 Review by the EPO as a designated Office***

The EPO may decide, in accordance with **Art. 25 PCT**, to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application. The Examining Division is competent to take decisions in relation to these applications, and the Receiving Section transfers copies of any documents received from the International Bureau under the circumstances of **Art. 25(1)(a) PCT** to the Examining Division. Where it is decided that the application can proceed as a European application, the search and examination is carried out as for other applications although the application may be accorded the date it was originally filed with the PCT receiving Office and may claim the priority date, if any, of the international application.[**Rule 159(2)**; ]

### ***GL E VIII 2.10 Inspection of files***

In its capacity as a designated Office, the EPO also allows access to its files pertaining to the international phase of applications, provided that international publication has taken place. The above applies *mutatis mutandis* to the communication of information from the files.[**Art. 30(2) PCT**; ]

In its capacity as elected Office the EPO allows access to its files (including the entire **PCT Chapter II** file) relating to the international phase of applications filed on or after 1 July 1998, provided international publication has taken place and, as far as the **PCT Chapter II** file is concerned, the IPER has been completed. The above applies *mutatis mutandis* to the communication of information from the files.[**Rule 94.3 PCT**; ]

### ***GL E VIII 3.3.1 Earlier filed amendments or comments***

In certain cases, even though the EPO was the ISA or the SISA, the applicant is not required to respond to the communication under **Rule 161(1)**. These exceptions are explained below:

(i) If the applicant has filed new amendments and/or comments upon entry into the regional phase before the EPO, he will still be sent a communication according to **Rule 161(1)**, but in this case he will not be required to respond to it (note, however, that if the requirements of **Rule 137(4)** were not fulfilled for amendments already filed, it is advisable to make the required indications in reply to the **Rule 161(1)** communication in order to avoid a further communication according to **Rule 137(4)**).

(ii) If the applicant filed amendments according to **Art. 19 PCT** and/or **Art. 34 PCT** in the international phase and these amendments are maintained on entry into the European phase, and if the EPO prepared the WO-ISA or SISR but no IPER (either because the applicant did not demand **Chapter II** or because the IPEA was an office other than the EPO), then these amendments are considered to constitute a response to the WO-ISA or SISR; the applicant will still be sent a communication according to **Rule 161(1)** in such cases, but he will not be required to respond to it (note, however, that if the requirements of **Rule 137(4)** were not fulfilled for amendments already filed, it is advisable to make the required indications in reply to the **Rule 161(1)** communication in order to avoid a further communication according to **Rule 137(4)**).

With regard to the above cases (i) and (ii), however, see also **E-VIII, 3.3.5**. Furthermore, if amendments have been filed under **Art. 19 PCT** or **Art. 34 PCT** and have been taken into consideration in the drawing up of an IPER by the EPO acting as IPEA, these are not considered to constitute a response to the IPER as required by **Rule 161(1)**; in these cases, the applicant is required to respond to the IPER within the six-month period according to **Rule 161(1)**.

In cases (i) and (ii) above, no communication under **Rule 161(1)** or **Rule 162** is issued if the applicant has explicitly waived his right to these and has already paid any claims fees due (see the Notice from the EPO dated 4 May 2010, OJ EPO 2010, 352 and the Notice from the EPO dated 4 April 2011, OJ EPO 2011, 354).

### ***GL E VIII 3.3.5 Indications on Form 1200***

In all cases mentioned in **E-VIII, 3.3.1**, it is important that the applicant clearly indicates on Form 1200 which documents are to form the basis for further prosecution of the application (see **E-VIII, 6.1**). Failure to make the appropriate indications on Form 1200 and/or provide copies and/or translations of the amended application documents as indicated below will result in the applicant being required to respond to the invitation according to **Rule 161(1)**.[]

In particular:

- In case (i) mentioned in **E-VIII, 3.3.1**, comments and/or amendments (the latter according to **Rule 159(1)(b)**) which are filed on entry into the European phase will be considered to constitute a response to the WO-ISA, the SISR or the IPER only if the applicant indicates on Form 1200 that such amendments and/or comments are to form the basis for further prosecution of the application and have been filed no later than the date of filing of Form 1200.
- In case (ii) mentioned in **E-VIII, 3.3.1**, amendments filed in the international phase will be considered to be a response to the WO-ISA, the SISR or the IPER only if the applicant indicates on Form 1200 that these amendments are maintained on entry into the European phase and also provides a translation thereof in the language of the proceedings, where necessary. Furthermore, a copy of the amendments under **Art. 34 PCT** (not made before the EPO as IPEA) would also be required no later than the date of filing of Form 1200.

### ***GL E VIII 3.4 Rule 137(4) applies***

If the application is of one of the types mentioned in **H-III, 2.1.4**, and if amendments which are to form the basis for further examination were filed either during the **Rule 161(1)** time limit or earlier, the requirements of **Rule 137(4)** must be complied with (the amendments must be identified and the basis for them in the application as filed indicated). If the applicant has not yet complied with these requirements on expiry of the time limit according to **Rule 161(1)**, the Examining Division may request him to provide this information within a period of one month, by issuing a communication according to **Rule 137(4)**. Failure to respond to this communication in time will lead to the application being deemed to be withdrawn (see **H-III, 2.1** and **H-III, 2.1.1**). The Examining Division may send a **Rule 137(4)** communication before sending a communication according to **Art. 94(3)** and **Rule 71(1)**, **Rule 71(2)** or **Rule 71(3)**. It should also be noted that a matching requirement applies to amendments

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made in the international phase (**Rules 46.5 PCT, Rule 66.8 PCT and Rule 70.2 PCT**).[**Rule 137(4);**  
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### ***GL E VIII 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER***

The substantive examination is conducted in the same way as with European applications. Where the EPO was the International Preliminary Examining Authority, the international preliminary examination will normally have been carried out by the examiner responsible for examining the related Euro-PCT application.

The application to be examined will be accompanied by an international preliminary examination report drawn up in one of the official languages of the EPO. New documents in the original language may be attached in annex to the report (**Art. 36(3)(a) PCT and Rule 70.16 PCT**). The application will also be accompanied by a translation of the annexes, transmitted by the applicant, in the same language into which the international preliminary examination report was translated (**Art. 36(3)(b) PCT**).[**Art. 14(1);** ]

The examination must be conducted in accordance with **Art. 41 PCT** and **Art. 42 PCT**, which stipulate that:[**Art. 41 PCT; Art. 42 PCT;** ]

(i)the applicant must be given the opportunity to amend the claims, the description and the drawings within a time limit prescribed pursuant to **Rule 78.1(b) PCT or Rule 78.2 PCT** (see also **Rules 159(1)(b) and Rule 161**); and[**Rule 159(1)(b); Rule 161;** ]

(ii)the EPO cannot require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same application in any other elected Office.

#### **4.3.1 Comparative test results**

#### **4.3.2 Basis for substantive examination**

#### **4.3.3 Consideration of the contents of the IPER**

## EPO Guidelines - F The European Patent Application

### *GL F III 6.5 Euro-PCT cases*

International applications relating to the aforementioned unavailable biological material and designating or electing the EPO must comply with **Rule 13bis PCT** in conjunction with **Rule 31**. That means that for sufficient disclosure of the material the deposit with a recognised depository institution must be made not later than the international filing date, relevant information must be given in the application and the necessary indications must be furnished as required during the international phase (see also Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498).

### *GL F VI 1.1 Filing date as effective date*

According to **Art. 80**, a European application is accorded as its date of filing the date on which it satisfies the requirements of **Rule 40**, or, if filed under the PCT, the date on which it satisfies **Art. 11 PCT**. This date remains unchanged except in the special circumstances of late-filed drawings or parts of the description provided for in **Rule 56 EPC** and **Art. 14(2) PCT**. [**Rule 40**; ]

The date of filing may be the only effective date of the application. It will be of importance for fixing the expiry of certain time limits (e.g. the date by which the designation of the inventor must be filed under **Rule 60**), for determining the state of the art relevant to the novelty or obviousness of the subject-matter of the application, and for determining, in accordance with **Art. 60(2)**, which of two or more European applications from separate persons for the same invention is to proceed to grant.

### *GL F VI 2.1 Examining the validity of a right to priority*

As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if prior art has to be taken into account which has been made available to the public within the meaning of **Art. 54(2)** on or after the priority date claimed and before the date of filing (e.g. an intermediate document, see **G-IV, 3**) or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of **Art. 54(3)**, such other application claiming a priority date within that period. In such cases, (i.e. cases where the art in question would be relevant if of earlier date) the examiner must investigate whether the priority date(s) claimed may be accorded to the appropriate parts of the application he is examining and should inform the applicant of the outcome and whether, in consequence, the particular prior art under consideration, e.g. the intermediate document, or the other European application forms part of the state of the art within the meaning of **Art. 54**. Also, in the case of possible conflict with another European application under **Art. 54(3)**, it may be necessary in addition to allocate effective dates to the appropriate parts of that other application and to communicate this to the applicant analogously (see also **G-IV, 3**). When the examiner needs to consider the question of priority date, he should bear in mind all the matters which are mentioned in **F-VI, 1.3** to **F-VI 1.5** above.

If in case of a Euro-PCT application, where the EPO is acting as a designated or elected Office, the priority document is not on file, substantive examination may nevertheless be started. In such a case, without the priority document being on file, the application may even, where appropriate, be refused because the claimed subject-matter lacks novelty or inventive step, provided that the relevant state of the art is neither an intermediate document nor an **Art. 54(3)** application. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

If intermediate documents or **Art. 54(3)** applications exist and the patentability of the subject-matter claimed depends on the validity of the priority right, substantive examination cannot be finalised as long as the priority document is missing. Where the applicant has complied with **Rule 17.1(a) PCT**,

**Rule 17.1(b) PCT** or **Rule 17.1(b-bis) PCT**, he may not be requested to file the priority document. The proceedings have to be stayed and the applicant is informed that, since the patentability of the subject-matter claimed depends on the validity of the priority right, substantive examination cannot be finalised as long as the priority document is not on file.

## EPO Guidelines - G Patentability

### *GL G IV 5.1.2 Accorded date of filing still subject to review*

The prior art considered by the examiner might comprise documents (European or international patent applications) for which the accorded date of filing may still be under review before the EPO. This might be the case, for instance, when:

- (i) a European patent application contains parts of the description and/or drawings filed under **Rule 56**, or
- (ii) an international patent application contains elements or parts of the description, drawings or claims filed under **Rule 20.5** or **Rule 20.6 PCT**.

The examiner should check whether a final decision on the accorded date of filing has already been taken before considering the documents as being state of the art under **Art. 54(3)**. If the date of filing has not yet been established, the examiner should temporarily deal with the documents (if relevant for assessing the patentability of the claimed subject-matter) as if their accorded date of filing were correct, revisiting the issue at a later point in time.



## EPO Guidelines - H Amendments and Corrections

### *GL H II 2.1 Before receipt of the search report - Rule 137(1)*

In the case of a European patent application filed directly at the EPO (not via the PCT), it is not possible for the applicant to amend the application before receiving the European search report (**Rule 137(1)**). [**Rule 137(1)**; ]

In the case of a Euro-PCT application requiring a supplementary European search according to **Art. 153(7)**, the applicant may amend the claims, description and/or drawings before the application is subject to the supplementary search either by maintaining amendments filed in the international phase under **Art. 19 PCT** and/or **Art. 34(2)(b) PCT** or by filing amendments on and/or after entry into the European phase under **Rule 159(1)(b)** and/or **Rule 161(2)** respectively (see also **E-VIII, 3** and **B-III, 3.3.2**).

For replies to an invitation under **Rule 62a** or **Rule 63**, see **H-II, 5**.

### *GL H III 2.1.1 Rule 137(4) communication and response thereto*

If the Examining Division notes a failure to meet either requirement of **Rule 137(4)**, it may issue a communication requesting the correction of this deficiency within a period of one month. The amendments in respect of which such a communication may be sent include, *inter alia*: [**Rule 137(4)**; ]

- (i) claims filed after the date of filing under **Rule 58** (see **A-III, 15**)
- (ii) amendments filed before entry into the European phase from the PCT under **Art. 19 PCT** and/or **Art. 34 PCT** (see **E-VIII, 3**)
- (iii) amendments filed on entry into the European phase from the PCT under **Rule 159(1)(b)** (see **E-VIII, 3**)
- (iv) amendments filed after entry into the European phase from the PCT under **Rule 161(1)** or **Rule 161(2)** (see **E-VIII, 3**)
- (v) amendments filed in response to the search opinion (see **B-XI, 8**)
- (vi) amendments filed during the examination procedure (see, however, **H-III, 2.1.3**), including those filed after the communication according to **Rule 71(3)**.

Such a communication can only be sent in respect of amendments which are part of a current request. It cannot relate to amendments which have since been withdrawn or superseded.

If the applicant fails to comply with this requirement within the above-mentioned period of one month, the application is deemed to be withdrawn due to the applicant's failure to reply to this communication from the Examining Division. The applicant may request further processing for failure to observe this time limit (see **E-VII, 2.1**). [**Art. 94(4)**; ]

If the amendments are filed in response to a communication according to **Rule 71(3)** and the requirements of **Rule 137(4)** are not satisfied in respect of them, the Examining Division may send a **Rule 137(4)** communication. Thereafter, if the applicant replies in time, the Examining Division will then decide whether to admit the amendments (see **H-II, 2.5.5**).

Where auxiliary requests are filed, a **Rule 137(4)** communication may also be sent in respect of one or more of the main and/or auxiliary requests. Alternatively, where **Rule 137(4)** is not complied with in respect of a specific request (main or auxiliary), this request may, for reasons of procedural economy and taking into account the applicant's right to be heard in accordance with **Art. 113(1)**, be deemed inadmissible according to **Rule 137(3)**.

***GL H IV 2.3.2 Missing parts of the description or missing drawings filed after the date of filing***

The procedure under **Rule 56** allows the applicant to file missing drawings or parts of the description subsequently, and to rely on the priority document in order to avoid re-dating of the application to the date of filing of the missing parts. Under **Rule 56(3)**, re-dating is only avoided where the missing parts were "completely contained" in the priority document (see **C-III, 1** and **A-II, 5**). The provisions of **Rule 56(3)** apply only to the filing stage of the application, without further implications: in particular, it is not permissible at later stages of the procedure to rely on the priority documents to correct or amend the application as filed (in keeping with **G 3/89** and **G 11/91**). For Euro-PCT applications a similar provision exists under **Rule 20.6 PCT**, whereby a review by the EPO as elected or designated Office is possible under **Rule 82ter PCT**. [**Rule 56**; ]

Missing parts of the description and/or missing drawings allowed under **Rule 56(3)** are always considered to be part of the application documents "as originally filed".