International Preliminary Examination

6. An important effect of the election of a State is that the start of the national or regional phase before the national or regional Office of or acting for that State (the "elected Office") is postponed by a further ten months from 20 to 30 months from the priority date, provided that the election has been made before the expiration of 19 months from the priority date (Articles 39 and 40; c.f. Articles 22 and 23). In some Offices the time limit expires even later. If an election is made after the expiration of 19 months from the priority date, it does not have the effect of postponing the national phase (Article 40(1)).

7. The demand must be submitted to a competent IPEA and not to the receiving Office with which the international application was filed (Article 31(6)(a)), although in a particular case both functions may be exercised by the same Office.

8. The demand must be made on a printed or computer generated form (Form PCT/IPEA/401) and must contain certain indications, all of which are clearly identified on the form (see also Rule 53). A master copy of the demand form is contained in Annex Y of Volume I of the PCT Applicant's Guide.

9. **Fees**. When filing the demand, two kinds of fees are due: the preliminary examination fee (Rule 58) which accrues to the IPEA, and the handling fee (Rule 57) which accrues to the International Bureau. Both fees are payable to the IPEA in a currency prescribed by it.

10. Details concerning the completion of the demand form and the payment of fees are contained in the Notes to the Demand and in the Fee Calculation Sheet and the Notes relating thereto which are attached to the demand.

11. **IPEA procedures.** Once the demand has been received by the IPEA, the latter checks whether it complies with the formal requirements and whether the fees have been paid. Where necessary, the applicant is invited to comply with the requirements or to pay any missing fee amount. The IPEA sends the original of the demand to the International Bureau (Rule 61.1(a)), which in turn notifies each elected Office of its election and informs the applicant accordingly (Rules 61.1(b) and 61.2).

12. When filing the demand, or before international preliminary examination starts, the applicant has an opportunity to amend the international application (claims, description and drawings) (Article 34(2)(b) and Rule 66.1). The international preliminary examination will initially be directed to the description, claims and drawings as contained in the international application at the time when the examination starts, including any amendments made previously and referred to in the statement under Rule 53.9. It is important to note that amendments may not go beyond the disclosure in the international application as filed (Article 34(2)(b)).

13. International preliminary examination does not usually start until after an international search report has been drawn up. It may start earlier, at the request of the applicant where search and examination are done by the same Office and that Office applies the "telescope procedure" (Rule 69.1(b)). In practice, not much use is made of the latter possibility because applicants prefer to wait for the international search report before deciding whether or not to

22. It is important to note that any elected Office is free, in the national phase, when determining the patentability of an invention claimed in an international application, to apply the criteria of its national law in respect of prior art and any other conditions of patentability not constituting requirements as to the form or contents of applications (Article 27(5)). The latter are fixed in the PCT and no national law may require compliance with requirements relating to the form or contents that are different from or additional to those provided for in the Treaty and the Regulations (Article 27(1)).

23. **Exclusions from scope of examination**. Certain kinds of subject matters are not required to be the subject of international preliminary examination (Article 34(4)(a)(i)). These are set out in Rule 67. An IPEA may decline to undertake the examination because no meaningful opinion can be formed due to manifest lack of clarity or lack of support for the claims in the description (Article 34(4)(a)(ii)).

24. **Response by applicant**. In situations where a criterion under Article 33 is not complied with or a defect as mentioned above exists, the IPEA starts a dialogue with the applicant. It issues a written opinion to which the applicant is invited to respond (Rule 66.2(a) to (c)). The applicant may then present amendments or arguments (Rule 66.3). There may be one or more additional written opinions, with an invitation to the applicant to respond, before the international preliminary examination report is drawn up (Rule 66.4).

25. Informal communications between the IPEA and the applicant are expressly provided for (Rule 66.6). Consistent with the non-binding, preliminary, nature of the international preliminary examination, there is no provision for formal review of an examiner's opinion, except regarding findings of lack of unity of invention (Article 34(3) and Rule 68.3).

26. International preliminary examination can thus be compared to a regular patent examination in an examining patent office with one exception; namely, in that the time limits set by the examiner for the response are usually much shorter than under the normal examination procedure (Rule 66.2(d)). A prompt reaction is required from the applicant during preliminary examination in order for the international preliminary examination to be completed within the limited time available (Rule 69.2).

27. **The international preliminary examination report**. International preliminary examination ends with the drawing up of the international preliminary examination report. That report must be drawn up before the expiration of 28 months from the priority date or nine months from the start of the examination if the demand is filed after the expiration of 19 months from the priority date (Rule 69.2). The general content of the report is set out in Article 35(2) and (3) and Rule 70.

28. The international preliminary examination report is a non-binding opinion which essentially contains a statement, in relation to each claim, on whether the claim appears to satisfy the criteria of novelty, inventive step and industrial applicability as defined in the PCT. The statement is accompanied by the citation of the documents believed to support that conclusion. Further explanations are given where the circumstances of the case so require. No statement may be made on the question whether the invention would be patentable under the national law of any elected State. If the report is based on the

international search report may cast doubt on the novelty of the invention or on whether it involves an inventive step. The international preliminary examination report affords the applicant useful advice about whether or not it is worthwhile proceeding with the application in the national phase before elected Offices.

34. International preliminary examination should also be considered if, as a result of the international search, the international application needs to be amended in order to avoid the references cited in the international search report. During the international preliminary examination procedure, the applicant has the opportunity to amend the description, claims and drawings of the international application. The critical advice and assistance of the examiner of the IPEA helps the applicant to put the international application in good order, which will be useful during the patent granting procedures in the national phase before the elected Offices. The national patent examination procedure will usually be speeded up and carried out more smoothly and with a greater chance of success.

35. **At what time should a demand for international preliminary examination be filed?** A demand can be filed at any time during the international phase. The Treaty does not set a time limit for filing a demand. For practical purposes, however, there are two events during the international phase that are decisive in making a decision as to when a demand should best be filed.

36. The international preliminary examination does not start, in general, until the international search report is in the possession of the IPEA. Applicants are therefore well advised to wait to receive the search report before filing a demand, since it may reveal prior art that completely destroys novelty or inventive step, so that it would be better to abandon the application without further expense.

37. After receipt of the international search report, however, if a demand is to be filed, it should be filed as soon as possible prior to 19 months from the priority date, because the length of time available for international preliminary examination depends on the time at which the demand is filed. The international preliminary examination report must, in general, be drawn up before the expiration of 28 months from the priority date. The effect of this time limit for the drawing up of the report is that the earlier a demand is filed the earlier international preliminary examination can start, and thus the more time will be available for carrying out the examination.

38. In order to secure the full effect of a demand, namely the postponing of the national phase from 20 to 30 months from the priority date, the demand must be submitted before the expiration of 19 months from the priority date. The international preliminary examination will also be carried out if a demand is submitted later, but then it will not have the effect of postponing the national phase in all elected Offices. Therefore, in order to benefit fully from the advantages of international preliminary examination, the demand should not normally be filed later than 19 months from the priority date

.

39. **Who has to file and sign the demand?** The demand has to be filed by all applicants

IPEA together with the demand, or alternatively they wait to receive the first written opinion of the examiner and draft any amendment in the light of that opinion. If it is clear from the references cited in the international search report that the international application requires amendments, it is recommended to file such amendments with the demand.

46. During the international preliminary examination, and depending on the circumstances, the applicant has at least one but sometimes several opportunities to file amendments. The number of opportunities for filing amendments which will be available depends very much on the time available for international preliminary examination. As the international preliminary examination report must in general be drawn up not later than 28 months from the priority date, the examiner will commence preparation of the report not later than 27 months from the priority date. Any amendments filed by the applicant after that time risk being received after completion of the report, by which time they can no longer be taken into account.

47. Should the applicant wish to make further amendments (which can no longer be filed during the international phase), they can still be filed with elected Offices on entering the national phase. No elected Office may grant a patent or refuse the grant of a patent before the expiration of the time limit for amending the application for the purposes of the grant procedure in the national phase (Article 41 and Rule 78). Each national chapter of Volume II of the PCT Applicant's Guide gives details as to when and how amendments may be filed during the national phase.

48. **How are amendments made in practice?** A replacement sheet must be established for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed (Rule 66.8). A letter explaining the difference between the replaced sheet and the replacement sheet must be filed with the amendment (Rule 66.8). Where the amendment results in the cancellation of an entire sheet this may be communicated in a letter. Any amendment or letter must be in the language in which the international application is published (Rule 66.9).

49. **Can the demand for international preliminary examination, the election of any State or the international application be withdrawn?** The applicant may, at any time prior to the expiration of 30 months from the priority date, withdraw the demand or the election of any State by a notice addressed to the International Bureau (Article 37(1) and (2), and Rule 90bis.4). If the withdrawal is effected prior to the expiration of 20 months from the priority date, the national phase will proceed in accordance with Articles 22 and 23, whereas, if it is effected after that time limit, it has the effect, in the elected State concerned, of a withdrawal of the international application (Article 37(4)(a)). The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date; this will in practice have the same effect as a withdrawal of the demand for the elected States.

50. **Is the file of international preliminary examination confidential?** Neither the International Bureau nor the IPEA may, unless requested or authorized to do so by the applicant, give information on the issuance of an international preliminary examination report or on the withdrawal or non-withdrawal

The Purpose of the International Preliminary Examination

- is to provide a non-binding opinion on:
  - Novelty (Article 33(2) and Rule 64);
  - Inventive Step (Article 33(3) and Rule 65); and,
  - Industrial Applicability (Article 33(4)).



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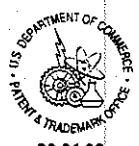
Novelty (Article 33(2))

"...a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the regulations."



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When Does the International Preliminary Examination Start?



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In General

- The International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of both the demand and of either
  - the search report or
  - a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established.



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What Is Examined During Chapter II Proceedings?

- The Claim(s) in the application when
  - those claims are directed to an invention which was searched in the Chapter I proceedings.
  - Note that claims added by amendment filed under Article 19 or under Article 34 are examined if they are directed to an invention searched in Chapter I.

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Excluded Subject Matter *

- No International Preliminary Examining Authority is required to examine the following subject matter:
  - scientific and mathematical theories,
  - 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,
  - schemes, rules or methods of doing business, performing purely mental acts or playing games,

* See Article 17 and Rule 67

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Prior Art For the International Preliminary Examination



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Prior Art In Chapter II

- "...everything made available to the public anywhere in the world by means of written disclosure...shall be considered prior art provided that the making available to the public occurred prior to the relevant date." (Rule 64)



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Certain Published Documents

- A patent or published patent application
  - having a publication date *on or after* the relevant date,
  - which has a filing date or priority date which is earlier than the relevant date,
  - which would constitute relevant piror art if it had been published before the relevant date.
- This type of document is NOT prior art for the purposes of international preliminary examination but is specifically mentioned in the IPER.



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Lack Of Unity Of Invention In Chapter II



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Unity of Invention Procedures

- The IPEA will invite the applicant to pay the additional examination fees.
- If there is a USPTO deposit account indicated in the application papers, IPEA/US may make the invitation by telephone.



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Unity of Invention Procedures (continued)

- The applicant may pay the additional examination fees under protest.
- The applicant does not have to pay any of the additional examination fees.



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The Written Opinion (continued)

- Similar to an "office action" or an "examiner's action."
- Sent only to the applicant.
- The applicant will be given a time limit for response to the written opinion.
  - Normally two months.
  - May not be less than one month.



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The Written Opinion Form PCT/IPEA/408



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Response To The Written Opinion

- Response may consist of arguments and/or amendments.
- Submitted directly and only to IPEA.
- One oral interview with the examiner as a matter of right, additional interviews at the discretion of the IPEA (Article 34(2)(a) and Rule 66.6)
- To ensure consideration, amendments and/or arguments must be submitted within the time limit set for response.

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Response To The Written Opinion (continued)

- Recommendations:
  - Respond promptly and completely to a written opinion; this will reduce work in the national phase before the various elected Offices.
  - Where no response to the written opinion will be made, inform the examiner by writing or telephone; it clarifies the situation for the examiner when preparing the international preliminary examination report.

We do not do this.

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Reasons for Delays in International Preliminary Examination

- On the part of applicant:
  - late payment of fee
  - late correction of defects in the demand
  - incomplete statement in the demand concerning amendments
  - failure to attach amendments referred to in the statement
  - late response to invitation to pay additional examination fees in case of finding of lack of unity of invention.
  - late response to written opinion.
  - failure to file replacement sheets containing amendments



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The International Preliminary Examination Report Form PCT/IPEA/409



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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

I. Basis of the report

1. This report has been drawn on the basis of:

☐ the international application as originally filed.

☐ the description, pages _____ , as originally filed,
pages _____ , filed with the demand,
pages _____ , filed with the letter of _____ ,
pages _____ , filed with the letter of _____ ,

☐ the claims, pages _____ , as originally filed,
pages _____ , as amended under Article 19,
pages _____ , filed with the demand,
pages _____ , filed with the letter of _____ ,
pages _____ , filed with the letter of _____ ,

☐ the drawings, sheets/fig _____ , as originally filed,
sheets/fig _____ , filed with the demand,
sheets/fig _____ , filed with the letter of _____ ,
sheets/fig _____ , filed with the letter of _____ ,

2. The amendments have resulted in the cancellation of: pages: _____
sheets of drawings/figures No.: _____ .

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box.

4. Additional observations, if necessary:

II. Priority

1. ☐ This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:

☐ copy of the earlier application whose priority has been claimed.

☐ translation of the earlier application whose priority has been claimed.

2. ☐ This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid.

Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees, for the following reasons:

3. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☐ all parts.
- ☐ the parts relating to claims Nos. _____ .

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

VI. Certain documents cited

1. Certain published documents

Application No. Patent No.	Publication date *(day/month/year)*	Filing date *(day/month/year)*	Priority date (valid claim) *(day/month/year)*

2. Non-written disclosures

Kind of non-written disclosure	Date of non-written disclosure *(day/month/year)*	Date of written disclosure referring to non-written disclosure *(day/month/year)*

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

Supplemental Box
(To be used when the space in any of Boxes I to VIII is not sufficient)

Continuation of Box [No.]:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. STATEMENT

Novelty (N)	Claims	_____	YES
	Claims	_____	NO
Inventive Step (IS)	Claims	_____	YES
	Claims	_____	NO
Industrial Applicability (IA)	Claims	_____	YES
	Claims	_____	NO

2. CITATIONS AND EXPLANATIONS

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

☐ the entire international application,

☐ claims Nos. _____

because:

☐ the said international application, or the said claims Nos. _____
relate to the following subject matter which does not require an international preliminary examination (specify):

☐ the description, claims or drawings (indicate particular elements below) or said claims Nos. _____
are so unclear that no meaningful opinion could be formed (specify):

☐ the claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for said claims Nos. _____ .

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference	FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*
International Patent Classification (IPC) or national classification and IPC		
Applicant		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of _____ sheets.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings amended during international preliminary examination and/or containing rectifications made before this Authority.

These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☐ Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/ Facsimile No.	Authorized officer Telephone No.

The International Preliminary Examination Report

- Must be established by the IPEA within 28 months from the priority date.
- May contain "annexes" which are sheets containing amendments which have been used as a basis for the report.
- Letters or copies of amendments superseded by later amendments are not annexed to the report.



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The International Preliminary Examination Report (continued)

- No provision for amendment, appeal, or further proceedings before the International Authorities once IPER has been established.
- Sent to the applicant and IB.
- IB forwards copies of the report, and any required translation of the report into English, to the elected Offices.
- The annexes are not translated by the IB.



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PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

PCT

WRITTEN OPINION

(PCT Rule 66)

	Date of mailing *(day/month/year)*
Applicant's or agent's file reference	**REPLY DUE** within months/days from the above date of mailing

International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*

International Patent Classification (IPC) or both national classification and IPC

Applicant

1. This written opinion is the _____ (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

   - I ☒ Basis of the opinion
   - II ☐ Priority
   - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
   - IV ☐ Lack of unity of invention
   - V ☐ Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
   - VI ☐ Certain documents cited
   - VII ☐ Certain defects in the international application
   - VIII ☐ Certain observations on the international application

3. The applicant is hereby **invited to reply** to this opinion.

   When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension.

   How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

   Also For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4*bis*. For an informal communication with the examiner, see Rule 66.6.

   If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: _____ .

Name and mailing address of the IPEA/	Authorized officer
Facsimile No.	Telephone No.

Consequences Of Failure To Pay Additional Examination Fee(s)

- The "main invention" and other inventions covered by any additional examination fees will be examined.
- The inventions not paid for will not be examined but will remain in the international application.

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The Written Opinion (Rule 66.2)

- Must be issued:
  - If there are any claims which do not satisfy the criteria of novelty, inventive step, or industrial applicability;
  - if there are any defects in the form or content of the application;
  - if there are any observations on the adequacy and/or enablement of the description, claims or drawings;
  - if there are any observations of the clarity of the claims; or,
  - if there are any amendments which go beyond the disclosure as originally filed.

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Lack of Unity of Invention (Rule 68)

- During the international preliminary examination a separate consideration of unity of invention is made from the consideration made for the international search.
- Note that claims directed to inventions not searched will not be examined and thus will not be part of any lack of unity of invention requirement made during international preliminary examination.



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Unity of Invention Criteria

- The unity of invention criteria for the international preliminary examination are the same as for the international search and are set forth in:
  - Rule 13 and
  - Annex B to the Administrative instructions.



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The Relevant Date

- The relevant date is
  - the international filing date, or
  - the priority date if there is a valid priority claim to a prior patent application. (Rule 64)

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Non-Written Disclosures

- A written document
  - which refers to a previous oral disclosure, use, exhibition or other means whereby the contents of the written document were made available to the public,
  - having a publication date ***on or after*** the relevant date, and
  - wherein the making available to the public occurred ***before*** the relevant date.
- Non-written disclosures are NOT prior art for the purposes of international preliminary examination but will be specifically mentioned in the IPER.

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Excluded Subject Matter (continued)

- No International Preliminary Examining Authority is required to examine the following subject matter:
  - methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
  - mere presentations of information, and
  - computer programs to the extent that the International Preliminary Examining Authority is not equipped to carry out an international preliminary examination concerning such programs.



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Excluded Subject Matter In IPEA/US

- The United States Patent and Trademark Office has declared that it will search and examine all subject matter searched and examined in US national applications. (MPEP 1849)



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When There Was An Amendment Under Article 19

- When the statement in the demand concerning amendments indicates that Article 19 amendments are to be taken into account
  - the examination shall not start until the IPEA has received a copy of the Article 19 amendments.



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When The Start Of Examination Is To Be Postponed

- When the statement in the demand concerning amendments indicates that the start of the international preliminary examination is to be postponed, the IPEA shall not start the examination before
  - it has received a copy of any amendments made under Article 19;
  - it has received notice from the applicant that no Article 19 amendments were or will be made; or
  - the expiration of 20 months from the priority date,
- whichever occurs first.



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Inventive Step (Article 33(3))

"...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."



30.01.96

Industrial Applicability (Article 33(4))

"...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."



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of the demand or of any election, except for communications or access provided to elected Offices (Article 38). Notice of the fact that a demand for international preliminary examination has been filed before the expiration of 19 months from the priority date will be published in the PCT Gazette by indicating the designated States bound by Chapter II which have not been elected (Rule 61.4).

51. **What is the usefulness of an international preliminary examination report in the national phase?** After international preliminary examination, the application will usually be in a much better form and more easily accepted by examiners in the national phase. The international preliminary examination report is only a non-binding opinion expressed on the basis of the PCT definitions of novelty, inventive step and industrial applicability. National differences are very much the exception, however, and experience has shown that the patent grant procedure can usually be carried out much faster and more simply than for a national application not filed through the PCT. If an elected Office was also the IPEA, it will usually grant a patent more promptly on the basis of a favorable international preliminary examination report. For example, when the EPO acts as IPEA, it will not normally deviate from a favorable report during the European regional phase. The Guidelines for Examination of the EPO (Part E, Chapter IX, 6.4.2) state that "if the international preliminary examination report has been drawn up by the European Patent Office, that report is to be regarded as an opinion for purposes of examination. Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further documents have been cited, as might happen in a supplementary European search report, or if evidence is produced of unexpected effects) or where the substantive patentability requirements under the PCT and EPC are different." The United States Patent and Trademark Office has a similar procedure. A national stage application in the United States of America may be entitled to a drastically reduced National stage filing fee ($94.00 as opposed to $680.00) if the application contains , or is amended to contain, at the time of entry into the national stage in the United States of America, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(2)-(4) as to novelty, inventive step and industrial applicability. Such an application may only be amended to the extent necessary to eliminate objections to form or to cancel rejected claims, and will be taken up for examination in an accelerated manner.(37 CFR 1.492(a)(4) and 1.496(b)

52. The applicant has the opportunity to submit additional amendments or arguments to the elected Office during the course of examination in the national or regional phase, with a view to the eventual allowance of claims which were the subject of adverse comment in the international preliminary examination report.

Conclusion

53. The value and usefulness to applicants and practitioners of the international preliminary examination procedure is such that most applicants file a demand for international preliminary examination if they proceed beyond the international search stage.

named in the international application as applicants for the designated States that are elected in the demand. If there are different applicants for different designated States and all States are elected, then all applicants must be named in the demand. If, however, the only States elected are those for which only some, but not all, applicants indicated in the international application are named as applicants, then only those applicants are to be indicated in the demand.

40. The demand must be signed by all the applicants named in the demand. If the applicants are represented by an agent, the demand may be signed by the agent. In such a case, however, all the applicants named in the demand must have signed a power of attorney If there is no agent, the demand may be signed by the common representative as defined in Rule 90.2.

41. If the applicants have not until this stage been represented by an agent during the international phase, or if they want to be represented before the IPEA by a new or an additional agent, such an appointment may be made in the demand if the demand is signed by all the applicants. If the demand is signed by the new or additional agent named in the demand, a separate power of attorney signed by all the applicants, their original agent or the common representative as defined in Rule 90.2 is required.

42. **Can an election be made after filing the demand?** Any designated State bound by Chapter II at the time of its election can be elected if the applicant files a later election after the demand has been filed (Article 31(4)(a)) and may be filed until the international preliminary examination report is drawn up. However, the postponement by ten months of the national phase applies only if the later election is made prior to the expiration of 19 months from the priority date. If a State which was designated in the international application could not be elected because it was not, at the time of filing the demand, bound by Chapter II, that State may be elected subsequently if it becomes bound by Chapter II in the meantime (and before the expiration of the 19-month time limit), so that the benefits of Chapter II can also be extended to that State.

43. Later elections must be filed with the International Bureau of WIPO in Geneva. There is no mandatory form and it suffices for the applicant to inform the International Bureau of any later elections in a letter which follows the wording of Rule 56.4. However, Annex Z of Volume I of the PCT Applicant's Guide contains a form (Form PCT/IB/328) which can be used for that purpose.

44. **Can the international application be amended before the IPEA?** The applicant can amend the claims, the description and the drawings before the international preliminary examination starts. The amendment must be filed with the IPEA. It may not go beyond the disclosure in the international application as filed. So far as the claims are concerned, this provides the second opportunity for amending them before the international preliminary examination starts (the first being by way of amendments submitted to the International Bureau under Article 19).

45. In practice, most applicants filing a demand for international preliminary examination do not make use of the possibility of amending the claims under Article 19. Either they amend the international application for the purposes of international preliminary examination before

international application in an amended form, a copy of all sheets containing amendments will be annexed to the report.

29. The IPEA transmits the report to the applicant and to the International Bureau (Rule 71). The report is always written in the language in which the international application concerned is published (Rule 70.17). The International Bureau must then, if necessary, translate the report into English to meet the language requirements of some elected Offices (Article 36(2) and Rule 73) (see also Rule 72). The translation by the International Bureau concerns only the report itself and not any annexes to it. There is no publication of the report and it is not accessible to persons other than the applicant and the elected Offices (Article 38). The transmittal of the international preliminary examination report completes the international procedure under Chapter II.

30. Upon receipt of the report (at the latest, about the 28th month from the priority date (Rule 69.2)), the applicant has until the expiration of 30 months from the priority date (Articles 39 and 40) in which to evaluate it and to decide whether or not to proceed further by entering the national or regional phase before the elected Offices. If a translation of the international application must be furnished to the elected Office upon entry into the national phase, it must usually include a translation of the international application as originally filed, and of the amendments appearing in the annexes to the international preliminary examination report (Rule 74). The translation requirements of the annexes vary somewhat among the elected Offices. The national chapter relating to each elected Office in Volume II of the PCT Applicant's Guide indicates the applicable requirements.

31. **Further details about international preliminary examination**. The preceding paragraphs outline the important features of international preliminary examination. The detailed provisions governing the procedures for international preliminary examination are found in Articles 31 to 42 and Rules 53 to 78. The other indispensable tool for understanding international preliminary examination is the PCT Applicant's Guide. Practitioners may also wish, on occasion, to refer to Part 6 (Sections 601 to 614) of the Administrative Instructions under the PCT, to the PCT Preliminary Examination Guidelines, and to the relevant Agreement between WIPO and the office or organization concerned in relation to its functioning as an IPEA (see PCT Gazette No. 26/1987).

Some practical questions relating to international preliminary examination

32. **Under what circumstances should a demand be filed?** Filing a demand for international preliminary examination should always be considered if the applicant wishes to gain time in order to better assess the usefulness and necessity of patent protection in various countries for the invention claimed in the international application. If a demand for international preliminary examination is filed prior to the expiration of 19 months from the priority date, the beginning of the national phase is delayed by ten months. This time enables the applicant to learn more about the technical and economic value of the invention.

33. Moreover, filing a demand should always be considered if the applicant is not sure about his chances of obtaining patent protection. References cited in the

proceed further with the international application and to demand international preliminary examination. The cost of the examination need not be incurred before it is clear, from the results of the international search report, that the invention claimed in the international application is not clearly lacking novelty and inventiveness.

14. **Which claims will be examined?** A further condition for the start of the international preliminary examination is that it must be clear which claims the applicant wants to have examined, noting that there are various possibilities for amendment under the Treaty (Articles 19(1) and 34(2)(b)). Therefore, the demand form provides for a statement by the applicant that identifies the claims on the basis of which the international preliminary examination is to be carried out; namely, the claims as originally filed, or as amended under Article 19, or as filed with the demand (Rule 53.9). If no such statement is contained in the demand, the international preliminary examination will start when the IPEA is in possession of both the demand and either the international search report or the declaration under Article 17(2)(a).

15. If an applicant, after having filed a demand for international preliminary examination, files amendments to the claims under Article 19 with the International Bureau, he must send a copy of the amendments to the IPEA at the same time (Rule 62.2(a)).

16. **Criteria for international preliminary examination.** In the international preliminary examination, the IPEA provides an opinion as to whether the claims as filed or as amended comply with the three criteria mentioned above - namely, novelty, inventive step (non-obviousness), and industrial applicability - in the sense in which they are defined by the Treaty (Article 33).

17. A claimed invention is novel if it is not anticipated by the prior art (Article 33(2)). The Regulations define what, for the purposes of the international preliminary examination, constitutes "prior art" (Rule 64).

18. A claimed invention is regarded as involving an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art (Article 33(3)).

19. A claimed invention is regarded as 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)).

20. International preliminary examination is not limited to examining the compliance of an international application with these three basic criteria (novelty, inventive step and industrial applicability). The international preliminary examination should also reveal any other defect, such as an amendment that goes beyond the scope of the original disclosure, insufficient disclosure, lack of unity of invention, etc. (see Rule 66.2(a)(i) and (iii) to (v)).

21. In practice, novelty and inventive step are assessed in relation to the documents cited in the international search report and in accordance with the PCT Preliminary Examination Guidelines. The examiner will occasionally, but not normally, cite documents in addition to those mentioned in the international search report.

General outline of international preliminary examination

1. Chapter II of the PCT provides applicants with the possibility of seeking an international preliminary examination of their international applications. International preliminary examination is an optional feature of the international phase. It gives the applicant the benefit, before entering the national phase, of obtaining an international preliminary examination report containing an assessment by an International Preliminary Examining Authority (IPEA) of 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)).

2. While the international preliminary examination report is not binding for the purposes of national or regional examination, it is increasingly seen by national and regional Offices as highly persuasive, and in some Offices results in a reduced examination fee in the national or regional phase. Moreover, all designated States which are bound by Chapter II, if they are indicated ("elected") in the applicant's "demand" for international preliminary examination prior to 19 months from the priority date, must postpone commencement of the national phase for a further ten months unless applicant requests earlier commencement.

3. The international preliminary examination procedure thus gives the applicant the time and opportunity, before deciding whether to proceed with the national or regional phase and to incur the considerable expenses involved in translations, national fees, and representation by local agents, to assess both the commercial prospects of the invention and the likelihood of success of the application in the national or regional phase. When the international application goes ahead in the national or regional phase, its processing should be simplified by virtue of the results of the international preliminary examination.

4. **Who can make a demand; States bound by Chapter II.** A demand for international preliminary examination can only be submitted if one of the applicants is a national or a resident of one of the Contracting States bound by Chapter II and the international application was filed with the receiving Office of, or acting for a Contracting State bound by Chapter II (Article 31(2)(a), Rule 54). There are two Contracting States which are not presently bound by Chapter II - namely, Greece, and Spain. It is important to note that, where these two Contracting States are designated for a European patent together with at least one other Contracting State of the European Patent Convention, the time limit under Article 39(1) of 31 months from the priority date for entering the regional phase in the EPO applies also with respect to those two States if the other State has been elected before the expiration of 19 months from the priority date.

5. **The demand**. In the demand for international preliminary examination, the applicant must indicate for which of the Contracting States designated in the international application he desires the examination procedure to be carried out. Those States are referred to as "elected States" (Article 31(4)(a)).