

PCT: Options following receipt of International Search Report

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International Search Report

Following the filing of a PCT application, the International Searching Authority (ISA) undertakes an international search of documents published before the priority date of your application. The results of the search are published in an International Search Report (ISR). This is accompanied by a Written Opinion (WO) of the ISA which gives the international examiner's view on the novelty and inventiveness of your application based on the documents identified in the ISR.

A final report (known as the International Report on Patentability (IPRP)) will issue some time after the WO. This report will be viewed by all relevant patent offices of the individual countries you elect to file in (i.e. national phase applications). While not binding on the various patent offices, a positive report can be very influential in the subsequent prosecution of those National Phase applications as many patent offices will use this report as the basis for examination.

When you receive a WO you have a number of options:

- 1. Do not respond to the WO and wait until you file national phase applications to address issues raised in the WO**

If you take this option the objections raised in the WO will remain unchallenged.

The WO will be converted into the IPRP and any objections will need to be addressed at the national phase of prosecution.

We recommend this option if you receive a positive WO or you want to delay costs associated with prosecution of the PCT application until the national phase.

Also, this option may be advisable when the application will be filed in Europe or the United States as examiners in those countries often conduct their own independent examination of a patent and sometimes reach conclusions contrary to those set out in the IPRP.

- 2. File informal comments directed towards the WO**

This option allows you to put your views regarding the WO on record. However, there will be no comment or rebuttal from the PCT International Search Authority. These comments may be considered by each examiner during national phase prosecution.

Informal comments can be filed at any time up to the filing of national phase applications.

We recommend this option if the objections raised in the WO require only some minor clarification, or you want to delay costs associated with prosecution of the PCT application until the national phase.

3. File claim amendments for publication

This option allows you to amend the claims in response to the objections raised in the WO. These amended claims are then published and will be the claims examined at the national phase of prosecution. The examiner who issued the WO will not comment on these amendments.

Claim amendments for publication must be filed within two months of receiving the WO. Note: you cannot present arguments to the examiner under this option. Therefore, these amendments are usually accompanied with informal comments (as above).

We recommend this option when it is advantageous to have claim amendments published, for example to make a possible infringer aware of the scope of protection being sought. In some countries, damages can be back-dated to the date of publication provided the claims are eventually granted in a similar form.

Claim amendments can also be filed at any time during the international phase, but only those filed within two months of receiving the WO will be published.

4. File a demand for further examination

Filing a demand (along with amendments and/or arguments) is a way of addressing one or more objections expressed in a negative WO, in an attempt to obtain a more positive IPRP.

This option allows the PCT application to be further examined so it is possible to respond fully to the objections raised by the examiner before the IPRP issues. As previously discussed, the IPRP is not

binding on the respective national patent offices, but it can be very influential in the subsequent prosecution of any national phase applications.

A demand for further examination must be filed within 22 months after filing the priority document, or within 3 months of the issuance date of the WO (whichever is the later).

We recommend this option when an adverse WO has been received and you believe that amendments/arguments can influence the examiner to issue a more positive IPRP.

The National Phase

Regardless of which prosecution option outlined above you choose, you are required to enter the national phase in all countries in which patent protection is desired.

You have up to 30 or 31 months after the priority date (depending on the country) to do this.