



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

40 YEARS 1973-2013
**EUROPEAN
PATENT
CONVENTION**
Innovation matters

Understanding of the International Preliminary Examination Report (IPER) and Written Opinion (WO)

Nicolas Wyplosz

February 2013



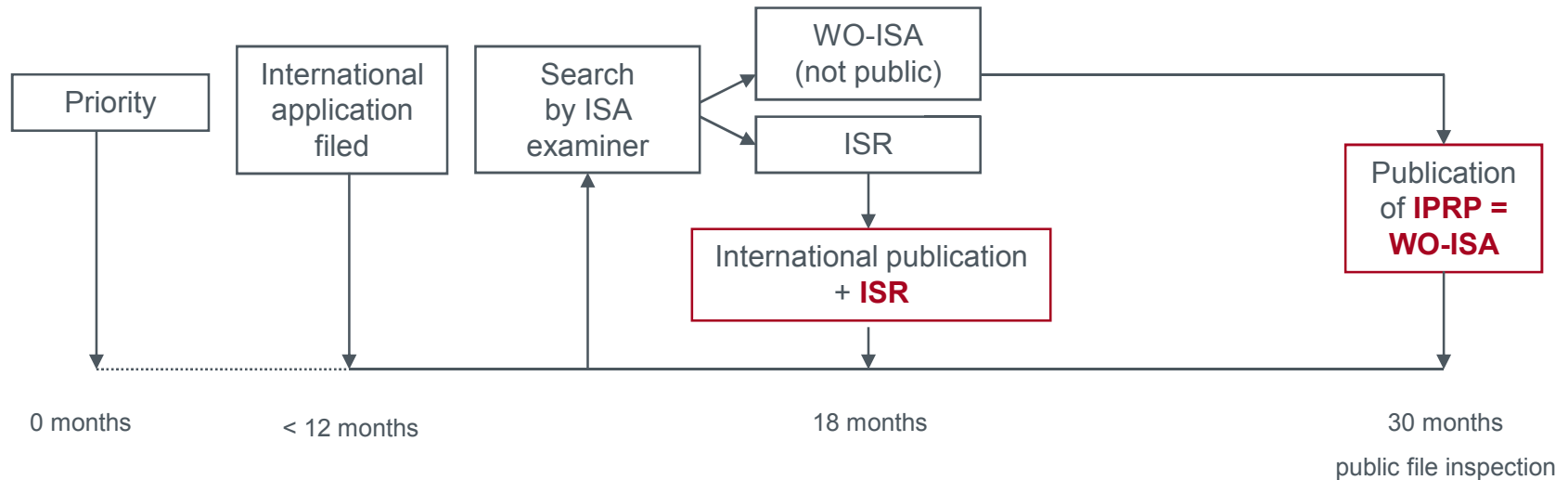
Learning objectives

International Searching Authority (ISA) International Preliminary Examining Authority (IPEA)

- Get an overview of the various ISA/IPEA actions
 - **WO-ISA** and **IPRP Chap I**
 - **IPER (IPRP Chap II)**
- Understand the form of an ISA/IPEA actions
 - **Cover sheet**
 - **Boxes I to VIII**
 - **Separate sheet**
- Understand how to use an IPRP/IPER in the national phase

PCT international phase

Chapter 1 only (ISA): WO-ISA + IPRP



If no international examination is requested (demand for Chapter II), the International Bureau converts, on behalf of the ISA, the WO-ISA to an IPRP

WO-ISA: Written Opinion of the International Searching Authority

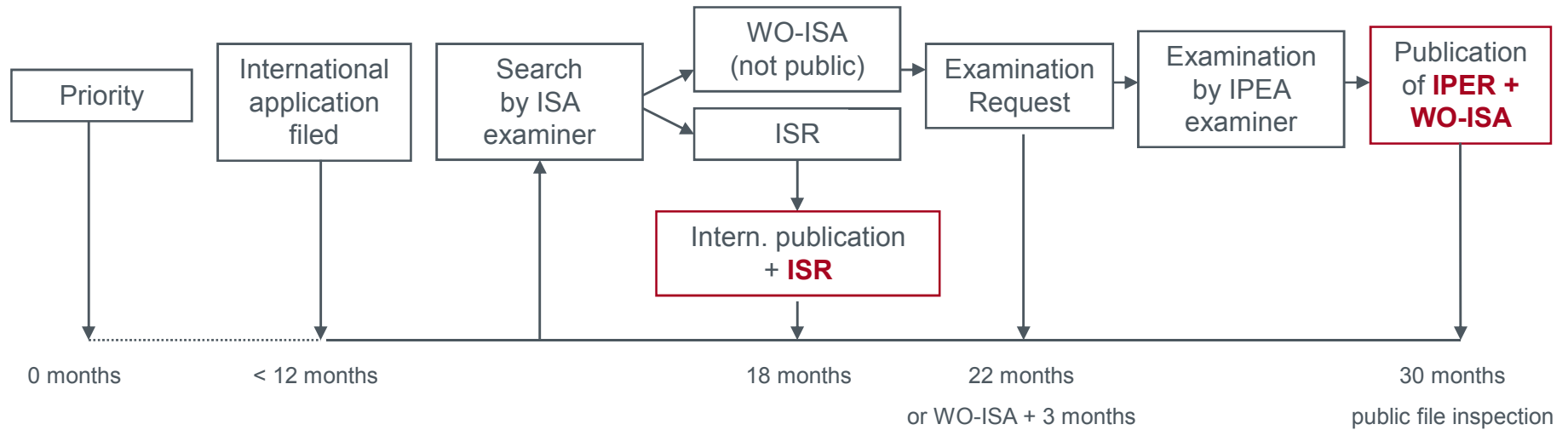
ISR: International Search Report

International publication: publication of the application

IPRP Chapter I: International Preliminary Report on Patentability (content=WO-ISA)

PCT international phase

Chapter 2 (ISA+IPEA): WO-ISA + IPER



WO-ISA: Written Opinion of the International Searching Authority

ISR: International Search Report

International publication: publication of the application

IPER: International Preliminary Examination Report (IPER = IPRP Chapter II)

Confidentiality

International publication at 18 months

- An international application is **confidential** until international **publication**
- Documents **publicly available** after international publication:
 - the international application itself
 - any amendments
 - **ISR (International Search Report)**
 - copies of priority documents

Confidentiality

Entry in the national phase at 30 months

- Documents made available **after the expiration of 30 months** from the priority date:
 - **WO-ISA**
 - informal comments from the applicant
 - **IPRP** (International Preliminary Report on Patentability) or **IPER** (International Preliminary Examination Report)

Overview of the structure of WO-ISA, IPRP, IPER

- Cover sheet
- Box I - Basis of the opinion
- Box II - Priority
- Box III - Non-establishment of opinion
- Box IV - Lack of unity
- Box V - Reasoned statement (novelty and inventive step)
- Box VI - Certain documents cited
- Box VII - Certain defects
- Box VIII - Certain observations (clarity)

Cover sheet

Chapter I only

File information

IPRP issued by IB
on behalf of ISA

Indicate the items
completed and
dispatched
(Box I and V by
default)

Name of the
International Bureau
(IB) authorized officer

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

IPRP Chap I

(PCT Rule 44bis)

Applicant's or agent's file reference 00364.000038.PC	FOR FURTHER ACTION		See item 4 below
International application No. PCT/US2008/081252	International filing date (<i>day/month/year</i>) 27 October 2008 (27.10.2008)	Priority date (<i>day/month/year</i>) 02 November 2007 (02.11.2007)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant COMBE INTERNATIONAL LTD.			

- This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).
- This REPORT consists of a total of 6 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

- This report contains indications relating to the following items:

<input checked="" type="checkbox"/>	Box No. I	Basis of the report
<input type="checkbox"/>	Box No. II	Priority
<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/>	Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/>	Box No. VI	Certain documents cited
<input checked="" type="checkbox"/>	Box No. VII	Certain defects in the international application
<input type="checkbox"/>	Box No. VIII	Certain observations on the international application

- The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

	Date of issuance of this report 26 October 2010 (26.10.2010)
The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer Gijsbertus Beijer
Facsimile No. +41 22 338 82 70	e-mail: pt07.pct@wipo.int

Form PCT/IB/373 (January 2004)

Cover sheet

Chapter I only

Copy of the cover sheet of WO-ISA

ISA=EPO
Examiner's name

PATENT COOPERATION TREATY


From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:		WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)	
see form PCT/ISA/220			
		Date of mailing (day/month/year) see form PCT/ISA/210 (second sheet)	
Applicant's or agent's file reference see form PCT/ISA/220		FOR FURTHER ACTION See paragraph 2 below	
International application No. PCT/US2008/081252	International filing date (day/month/year) 27.10.2008	Priority date (day/month/year) 02.11.2007	
International Patent Classification (IPC) or both national classification and IPC INV. A45D24/22			
Applicant COMBE INTERNATIONAL LTD.			

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

<input checked="" type="checkbox"/> Box No. I	Basis of the opinion
<input type="checkbox"/> Box No. II	Priority
<input type="checkbox"/> Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/> Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/> Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/> Box No. VI	Certain documents cited
<input checked="" type="checkbox"/> Box No. VII	Certain defects in the international application
<input type="checkbox"/> Box No. VIII	Certain observations on the international application

Name and mailing address of the ISA:	Date of completion of this opinion	Authorized Officer
 European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Fax: +49 89 2399 - 4465	see form PCT/ISA/210	Acerbis, Giorgio Telephone No. +49 89 2399-6895

Cover sheet

Chapter II

IPEA issued by IPEA
(IPRP Chap II)

IPEA=EPO
Examiner's name

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 11002003PCT	FOR FURTHER ACTION	See Form PCT/IPEA416
International application No. PCT/IB2010/052422	International filing date (<i>day/month/year</i>) 31.05.2010	Priority date (<i>day/month/year</i>)
International Patent Classification (IPC) or national classification and IPC INV. A45D26/00		
Applicant E.V.F Delacour bv		

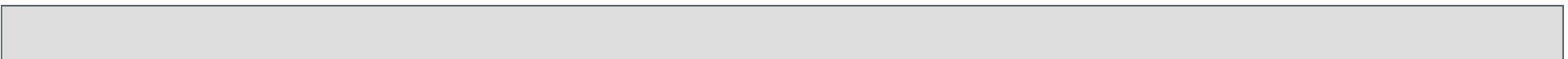
4. This report contains indications relating to the following items:	
<input checked="" type="checkbox"/> Box No. I	Basis of the report
<input type="checkbox"/> Box No. II	Priority
<input type="checkbox"/> Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/> Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/> Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/> Box No. VI	Certain documents cited
<input checked="" type="checkbox"/> Box No. VII	Certain defects in the international application
<input type="checkbox"/> Box No. VIII	Certain observations on the international application
Date of submission of the demand	Date of completion of this report
18.11.2011	29.03.2012
Name and mailing address of the international preliminary examining authority:	Authorized officer
 European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Fax: +49 89 2399 - 4465	Acerbis, Giorgio Telephone No. +49 89 2399-6895



Box I: Basis of the opinion

Information on the Application Documents on which the examiner bases his opinion.

- Indication of language : as filed or a translation
- Rectification of obvious mistakes
- Nucleotide and/or Amino Acid Sequence listings



Box I: Basis of the opinion

Box No. I Basis of the opinion

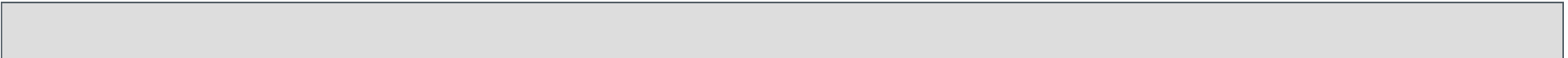
1. With regard to the **language**, this opinion has been established on the basis of:
 - the international application in the language in which it was filed
 - a translation of the international application into , which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1 (b)).
2. This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a))
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of a sequence listing filed or furnished:
 - a. (means)
 - on paper
 - in electronic form
 - b. (time)
 - in the international application as filed
 - together with the international application in electronic form
 - subsequently to this Authority for the purposes of search
4. In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

Box II: Priority

– Priority document not available and assumed to be valid

or

– Claimed priority found invalid



Box II: Priority

Box No. II Priority

1. The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.
2. This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

Box III - Non-establishment of opinion

- Claims for which no opinion is given
- Reasons
 - excluded subject-matter (mathematical theories, plants / animals, business methods)
 - unclear (so unclear than no meaningful opinion can be formed)
 - lack of support
 - problems with nucleotide and/or amino acid sequence listings

Box III - Non-establishment of opinion

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

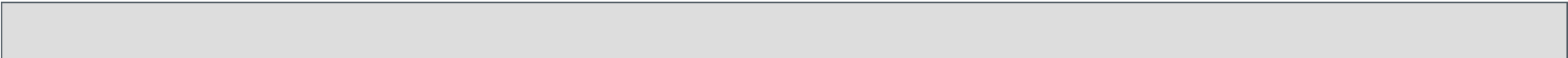
The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of

- the entire international application
- claims Nos. 10

because:

- the said international application, or the said claims Nos. relate to the following subject matter which does not require an international search (*specify*):
- the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 10 are so unclear that no meaningful opinion could be formed (*specify*):

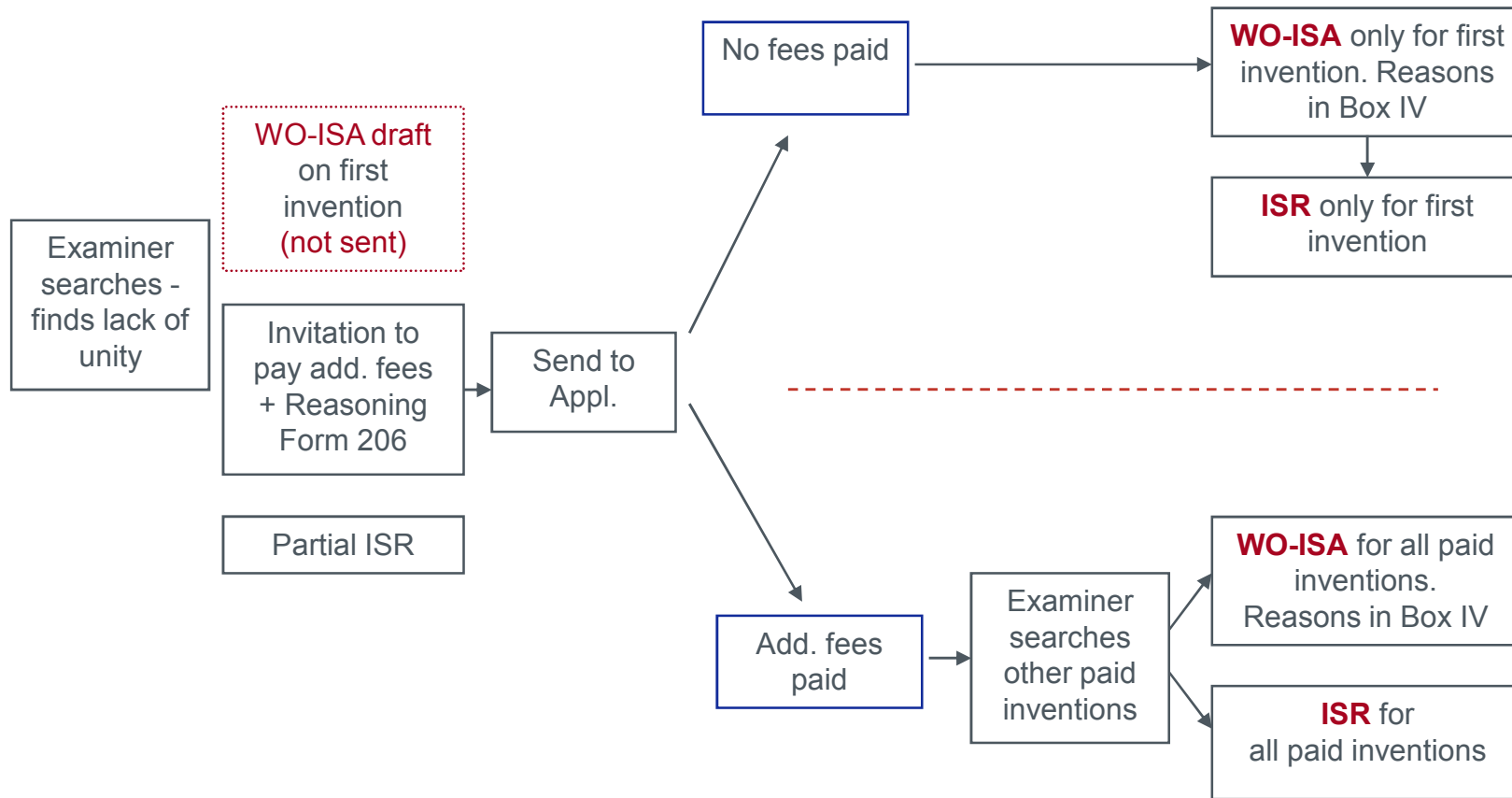
see separate sheet



Box IV - Lack of unity

Invitation to pay additional fees

Are fees paid by the applicant?



Box IV - Lack of unity

- Groups of invention
- Reasoning for lack of unity

If following the invitation the applicant **pays** additional search fees :

- all paid inventions are searched and covered in the WO-ISA

If the applicant **does NOT pay**:

- only the first invention forms basis of the opinion

Box IV - Lack of unity

Box No. IV Lack of unity of invention

1. In response to the invitation (Form PCT/ISA/206) to pay additional fees, the applicant has, within the applicable time limit:
 - paid additional fees
 - paid additional fees under protest and, where applicable, the protest fee
 - paid additional fees under protest but the applicable protest fee was not paid
 - not paid additional fees

2. This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
 - complied with
 - not complied with for the following reasons:
see separate sheet

4. Consequently, this report has been established in respect of the following parts of the international application:
 - all parts.
 - the parts relating to claims Nos. 1-5

Box IV - Lack of unity

Text on separate sheet: reasoning

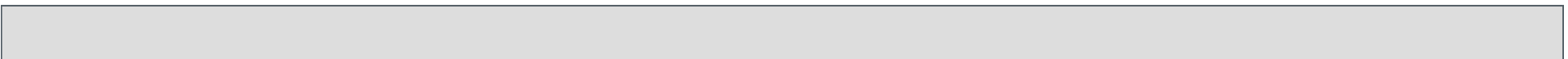
This Authority considers that there are **2 inventions** covered by the claims indicated as follows:

I: **Claims 1-10** are directed to a lamp.

II: **Claims 11-20** are directed to a remote control for a lamp.

The **reasons** for which the inventions are not so linked as to form a single general inventive concept, as required by Rule 13.1 PCT, are as follows:

...



Box V - Reasoned statement

Novelty and inventive step

For each claim a negative or positive conclusion is reached on **novelty, inventive step** and **industrial applicability**

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims 5-10, 12-15
	No:	Claims 1-4, 11
Inventive step (IS)	Yes:	Claims 8
	No:	Claims 1-7, 9-15
Industrial applicability	Yes:	Claims 1-15
	No:	Claims

2. Citations and explanations
see separate sheet

See **separate sheet** for citations and explanations

Box V - Reasoned statement

Separate sheet, citations (prior art)

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; **citations** and explanations supporting such statement

Reference is made to the following documents:

D1 WO 91/19237 A1

D2 US 2011/032695 A1

Box V - Reasoned statement

Separate sheet, novelty

This reasoning indicates the features that the examiner sees as being particularly relevant.

- 1 The subject-matter of independent claim 1 does not meet the requirements of Article 33(2) PCT.

D1 discloses:

An illumination system for lighting a building (fig. 1; house 4) comprising:
an array of LED lights (fig. 2; LED array 100),
an movement detection device (fig. 2, motion detection 200),
a micro-controller (fig. 2; microprocessor 15),
wherein when a signal from said movement detection device is above a threshold level (fig. 3; comparator 20 compares V_{ref} to V_{det}), said micro-controller switches said array of lights to an illumination state (see paragraph [0016]).

Hence the subject-matter of claim 1 is not new.

Box V - Reasoned statement

Separate sheet, novelty

- The examiner normally will only give **one full novelty objection**
- However, if D2 is an "X" document then a short reasoning is given.
For example:

2. The subject-matter of claims 1 is also not new in view of D2.

D2 discloses (see figure 1) an LED array (12) and a movement detector (14) whereby when the signal from the movement detector exceeds a threshold the LEDs are switched on **(see paragraphs [0035]-[0038])**

Box V - Reasoned statement

Separate sheet, inventive step

- 3 The subject-matter of claim 1 does not involve an inventive step, Article 33(3) PCT, in view of D1 and D2.
 - 3.1 **D1 discloses:** feature a, feature b, feature c...
 - 3.2 The subject-matter of claim 1 **differs** from D1 in the **feature d**
 - 3.3 The **problem to be solved** in D1 is to ensure that colour control of a discharge lamp can be achieved.
 - 3.4 D2 teaches that the **feature d** can be used to control the colour of a lamp.
 - 3.5 Therefore, it would be **obvious** for the skilled person to combine the features of D1 with D2 and arrive at the subject-matter of claim 1.
 - 3.6 Hence the subject-matter of claim 1 is not inventive.

Box V - Reasoned statement

Separate sheet, dependent claims

The **dependent claims** are addressed:

4. Dependent claims 2-7, 9 and 11-15 do not appear to contain any additional features which, in combination with the independent claims meet the requirements of the PCT with respect to novelty and/or inventive step (Art 33.2 and 33.3 PCT), the reasons being as follows:
 - 4.1 Claims 2-4 and 11 are known from D1 (see in particular fig. 4)
 - 4.2 Claims 5-7, 9 and 12-15 relate to obvious alternative constructions to the teaching of D1.

MAYBE the examiner writes:

- 4.3 There are no objections concerning claim 8 with respect to novelty and inventive step because the feature xxx is not disclosed in D1 and this solves the problem of yyy. Consequently the subject-matter of claim 8 meets the requirements of Art 33.2 et 33.3 PCT.

Box V - Reasoned statement

Separate sheet, clarity

The claims are unclear such that the assessment of novelty / inventive step is affected (Art 6 PCT).

Note: there are two approaches for clarity:

1) The examiner makes reference to objections raised in **Box VIII**

or

2) The examiner writes the clarity objection and indicates the reasons for affecting novelty / inventive step in **Box V** (interpretation of the claims).

Box VI - Certain documents cited

P documents (intermediate documents) and **E documents** (potentially conflicting patent documents).

If the priority document is not available, the examiner assumes that the claimed priority is valid.

Box No. VI Certain documents cited

1. Certain published documents (Rules 43*bis*.1 and 70.10)
and / or
2. Non-written disclosures (Rules 43*bis*.1 and 70.9)

see form 210

Box VII - Certain defects

Formal defects: this section is often left out by EPO examiners as they prefer to deal with these objections in the regional phase.

Box No. VII Certain defects in the international application

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

see separate sheet

Re Item VII

Certain defects in the international application

1. Independent claims 1 and 10 are not in the **two-part form**, contrary to Rule 6.3(b) PCT. It appears that the two-part form would be appropriate in the present case, with those features known in combination from the prior art D1 being placed in the preamble (Rule 6.3(b)(i) PCT) and the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).
2. The features of claims 1-18 are not provided with **reference signs** placed in parentheses (Rule 6.2(b) PCT).
3. Rule 5.1(a)(ii) PCT requires that the **relevant background art disclosed in D1 and D2** be mentioned in the description and that these documents be identified therein.

Box VIII - Certain observations

Clarity and conciseness (Art 6 PCT)

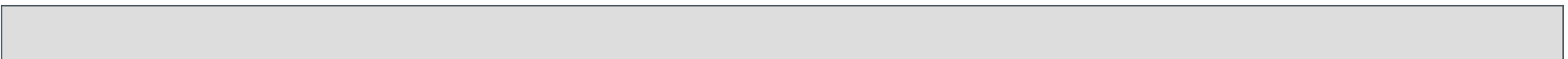
Box No. VIII Certain observations on the international application

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:

see separate sheet

- **Clarity problems**
 - claims, description, drawings
- Claims are **insufficiently supported** by the description

Note: if clarity objections were already raised in **Box V** they are not repeated.



Box VIII - Certain observations (clarity)

Clarity examples, separate sheet

- **Result to be achieved**
 - stating the desired result without explaining how the result is achieved

- **Inconsistencies, ambiguous syntax, relative terms, etc.**

- **Too many independent claims** in one category (conciseness)
 1. Although claims 1, 19 and 22 have been drafted as separate independent apparatus claims, they appear to relate effectively to the same subject-matter and to differ from each other only with regard to the definition of the subject-matter for which protection is sought and/or in respect of the terminology used for the features of that subject-matter. The aforementioned claims therefore lack conciseness and as such do not meet the requirements of Article 6 PCT.

How to use the IPRP/IPER?

- The IPRP/IPER is a **non-binding opinion**
- National or regional offices where a patent is later sought decide on the grant or refusal of the application in their territory.
- When the PCT application enters national / regional phase:
 - Follow the direction of the IPRP/IPER

How to use the IPRP/IPER?

Positive and negative opinions

- A **positive opinion** is given when there are **only minor or no objections**
 - there are no objections which the applicant needs to reply to in the regional phase at EPO
 - **a direct grant is expected in the national phase**
 - minor defects will not give rise to a negative opinion
- A **negative opinion** is given when there are objections
 - objections relating to novelty, inventive step
 - major clarity objections
 - the applicant must reply to the objections raised after entry in the regional phase at EPO (Rule 161 EPC)

How to use the IPRP/IPER?

Positive opinion: Separate Sheet

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following document:

D1 : US7,133,898 A2

1. D1 is regarded as being the prior art closest to the subject-matter of claim 1, and discloses:
AAA, BBB, CCC
 - 1.1 The subject-matter of claim 1 differs from D1 in that of feature DDD and is therefore new (Article 33(2) PCT).
 - 1.2 The problem to be solved by the present invention may be regarded as XXX
 - 1.3 The solution to this problem proposed in claim 1 of the present application is considered as involving an inventive step (Article 33(3) PCT) for the following reasons: YYY

How to use the IPRP/IPER?

Amendments filed on entry in national phase

Letter of applicant

Amended claims
received before
examination in
reply to a
negative
IRPR/IPER

Dear Sirs,

With reference to the Communication pursuant to Rules 161(1) and 162 EPC, dated June 8, 2010, the objections raised in the International Preliminary Report of Patentability have been carefully considered.

Accordingly, a new set of claims 1 - 12 to be substituted for the originally filed claims 1 - 12 is herewith enclosed.

Amendments

New independent claim 1 has been amended and now reads as follows (for the Examiner's convenience, newly introduced features are shown in underlined text and deletions are shown in stroke-through text):

1. A device (1) for cosmetic treatment of hairy body parts, such as eyebrows, comprising
a pair of tweezers (2), having a couple of flexible arms (2', 2'') connected to each other at a ~~an~~ first end,
each flexible arm (2', 2'') having an internal side and an external side, said internal side of each flexible arm (2') being faced to the internal side of the other flexible arm (2'') [see figures],

How to use the IPRP/IPER?

Amendments filed on entry in national phase

Discussion on patentability

Patentability of claim 1 – Novelty.

In item 2.1 of the written opinion of the international searching authority, the subject matter of originally claim 1 was rejected as being not new over document (D1).

It is believed that the above new claim 1 now clearly distinguishes from the disclosure of prior art document (D1), as it will become apparent from the following remarks.

D1 (the references in parentheses apply to this document) shows an applicator of preparations for eyelash, that comprises a tweezers-like holder 6 carrying obliquely-arranged bristles 8, 9, which are fitted in stocks 11, 11a engaged by the ends 7 of the holder and by clamps 12.

Therefore, the subject matter of new claim 1 differs from D1, and from the other cited documents, in that it provides at least one comb/brush member coupled on the external side of the relevant flexible arm close to the free end of said flexible arm.

Hence, it is submitted that the Application meets the requirements of Art 54 EPC.

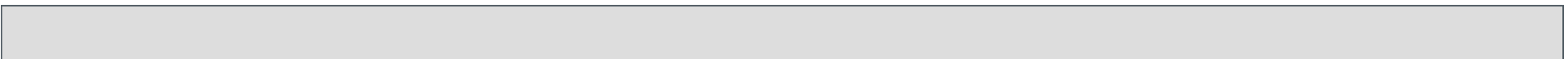
Summary

ISA produces a **WO-ISA** that is converted into an **IPRP Chap I**
IPEA produces an **IPER (IPRP Chap II)**

Opinions comprise a **cover sheet, boxes I to VIII and a separate sheet**

The IPRP/IPER is a **non-binding (positive or negative) opinion**

Amendments are filed by the applicant in the national phase,
possibly with annotated amended claims





Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Thank you very much for your time.

Any Questions?

Nicolas Wyplosz
nwyplosz@epo.org

November 2013

