

## **Patent Cooperation Treaty (PCT) Working Group**

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### **ISSUANCE OF A PROVISIONAL OPINION ACCOMPANYING THE PARTIAL SEARCH RESULTS**

*Document prepared by the European Patent Office*

#### **SUMMARY**

1. This document describes a new service at the European Patent Office, introduced from April 1, 2017. In the case of lack of unity of invention, at the same time as establishing the international search report on the invention first mentioned in the claims, the EPO will provide a provisional opinion on the patentability of this invention.

#### **NEW SERVICE AT THE EUROPEAN PATENT OFFICE**

2. On April 1, 2017, the European Patent Office (EPO), in its capacity as International Searching Authority, launched a new service aimed at further enhancing the quality of its search products and the transparency of its procedures (Notice from the European Patent Office dated 3 March 2017 concerning issuing a provisional opinion accompanying the partial search results, OJ EPO 2017, A20). As from the indicated date, in the case of lack of unity of invention, the EPO will not only provide applicants with a partial international search report on the first invention mentioned in the claims, but also will provide a provisional opinion on the patentability of that invention. The provisional assessment of patentability for the first invention constitutes a useful basis for applicants who are requested at that stage of the procedure to take strategic decisions on the future of the patent application, such as whether or not to pay additional search fees.

3. The provision of this new service is in line with the EPO's continuous efforts to contribute to the strengthening of the PCT system, which for instance, led to the launch in 2015 of the pilot program aimed at furnishing additional information on the search strategy followed by

examiners (extended until the end of 2017 - OJ EPO 2017, A3). Another significant step in that sense was the introduction of the PCT Direct service, whereby an applicant filing an international application and claiming priority from an earlier application already searched by the EPO may react to any objections raised in the search opinion for the priority application (see document PCT/WG/9/21). This service was also further improved by allowing examiners, from April 1, 2017, to expressly refer to the PCT Direct letter in the written opinion, where relevant (OJ EPO 2017, A21).

#### **CONTENT AND FORM**

4. Before April 1, 2017, if there was a finding of lack of unity at the search stage, applicants would receive the written opinion on patentability (WO-ISA) only together with the "final" international search report (Rule 43*bis*.1). Since this date, the EPO sends a provisional opinion on the patentability of the invention (or group of inventions) first mentioned in the claims together with the invitation to pay further/additional fees and the partial search results (Form PCT/ISA/206) in a new EPO form (EPO Form 1707). EPO Form 1707 is made available to the public via online file inspection.

5. It has, however, to be noted that the provisional opinion is provided for information only; no comments addressing the points raised in the provisional opinion should be filed by the applicant, and, if nevertheless filed, such comments are not taken into account by the examiner when completing the written opinion. Any amendments under Article 19, informal written comments, amendments and/or arguments under Article 34, and replies under EPC Rule 161 should therefore continue to be submitted after the "final" international search report and WO-ISA.

6. This additional service not only covers search products issued by the EPO in the international phase but also applies to the searches carried out in the regional phase for both Euro-direct and Euro-PCT applications.

*7. The Working Group is invited to take note of the contents of the present document.*

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