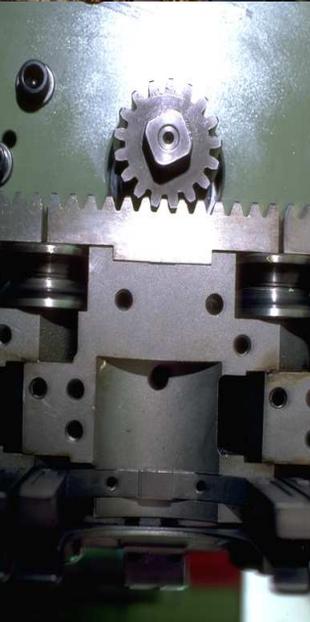
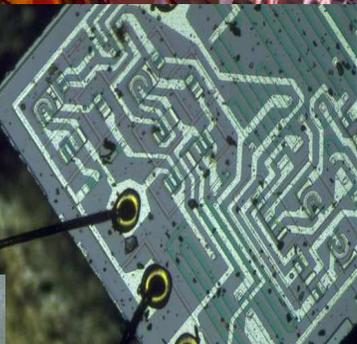


**WHAT TO DO WITH A
WRITTEN OPINION
OF THE
INTERNATIONAL
SEARCH AUTHORITY
(WO/ISA)**

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Prosecution under the Patent Cooperation Treaty (“PCT”) became a little more complicated in 2004. Previously, the search report in Chapter I was a mere list of references, with a simple letter designation of relevance for references cited by the Search Authority. The new rules in the PCT provide for higher Chapter I fees and the issuance of a more complete Written Opinion of the International Search Authority (WO/ISA). This Written Opinion becomes the Preliminary Opinion in the application if not challenged. While not binding on the various patent offices, this opinion can be very influential in the subsequent prosecution of any national stage applications of the subject patent family.

Options for action upon receipt of the WO/ISA are as follows:

- 1. Do nothing. Wait until National or Regional Stage to address the WO/ISA.**
- 2. File informal comments on the WO/ISA.**
- 3. File Article 19 Amendments.**
- 4. File a Demand and carry out full prosecution under Chapter II.**

This paper provides a brief explanation of the options available, deadlines to watch for, and a collection of rules and comments that provide some “How-To” basics in carrying out each of the options.

1. Do nothing. Wait until National or Regional Stage to address the WO/ISA.

If this path is followed, the WO/ISA will stand unchallenged. Any applicable arguments can be presented for the first time at the national and/or regional stage of prosecution.

This strategy is generally recommended when the WO/ISA is favorable, or when it is simply desired to delay costs associated with prosecution until National or Regional Stage.

[Special Note regarding early national stage entry if no demand is filed:

Regardless of which prosecution strategy is chosen, it will be necessary to enter the national or regional stage in all countries in which patent protection is desired by the non-extendable 30 month deadline. There is a special exception if you want protection in Switzerland, Finland, Luxembourg, Sweden, United Republic of Tanzania, Uganda or Zambia, but do not want to file regional applications in the European Patent Office or in the African Regional Industrial Property Organization. In this special case, a shorter national stage filing deadline of 20 months applies if no demand is filed by the 19th month. Note that all of these countries can be filed in the regional phase at 30-31 months, with eventual entry into national phase.]

2. File Informal Comments on the WO/ISA.

If this path is followed, the Applicant has a chance to put his/her views regarding the WO/ISA on the record, but there will be no comment or rebuttal from any office of the PCT.

Informal Comments can be filed at any time during the pendency of the PCT application.

This strategy is generally recommended when the WO/ISA merely requires some simple clarification, or when it is simply desired to delay costs associated with prosecution until National or Regional Stage.

Some mechanics and authorities regarding the filing of Informal Comments are discussed in Appendix A, attached.

3. File Article 19 Amendments.

If this path is followed, the claims are adapted in response to the WO/ISA, and the claims as amended are published to establish provisional rights corresponding to the scope of the claims.

Article 19 amendments must be filed **within two months** of the mailing date of the WO/ISA.

Note that there is no good place to present arguments in Article 19 amendments. Therefore, if you file amendments under Article 19, you should also file Informal Comments in the application.

The amendments will be published in the PCT, and the Applicant's Comments will be passed on to the national stage and regional stage patent offices, without comment from the Examiner that issued the WO/ISA. This strategy is generally recommended when it is apparent that some amendment will be required, and it is desired to have the claims

Some mechanics and authorities regarding the filing of Article 19 Amendments are discussed in Appendix B, attached.

4. File a Demand and carry out full prosecution under Chapter II.

If this path is followed, a full discussion of the issues can be had with the Examiner prior to issuance of an IPER. Although the IPER is not binding on the patent offices, it can be very influential in the subsequent prosecution of any national stage applications of this patent family.

A Demand must be filed 22 months after filing of the priority document, or within three months after the mailing of the WO/ISA. It may be desirable to begin the prosecution by filing comments and/or an amendment under Article 19 as above. The prosecution can be continued by filing arguments and/or amendments under Article 34.

This strategy is recommended when a negative WO/ISA has been received and it is believed that the Examiner can be persuaded to issue a favorable IPER. The current official fee for filing the Demand (when the EPO is the Search and Examination Authority) is approximately \$2000, but about half of this Demand fee is credited when the application is eventually filed in the EPO.

Some mechanics and authorities regarding the filing of Demands and Article 34 Amendments are discussed in Appendix C, attached.

This paper is intended to provide you with helpful suggestions in protecting your organization from avoidable liability concerns in intellectual property matters. Each matter is different, and the advice of competent counsel in each situation should be obtained.

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Appendix A Informal Comments

Informal Comments are filed in the International Bureau (IB), a copy should be sent to the International Examining Authority (IEA) if a Demand is to be filed. The IB will send a copy of these comments to all designated Offices unless an International Preliminary Examination Report (IPER) will be established. (No rule describes this procedure. See PCT form PCT/ISA/220 and PCT Newsletter No 12/2003 for official explanation). This document should be clearly marked as “Informal Comments” for proper handling.

Appendix B

Article 19 Amendments

Article 19 amendments are filed in the IB, copying the IEA if a demand is to be filed.

Article 19 amendments comprise the amendment and an optional additional Statement that is published.

The text of relevant portions of the Treaty, Rules and comments in the Applicant's Guide follow:

Article 19

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 IB within the prescribed time limit. The applicant may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact those 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.

§ 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 shall be required to submit a replacement sheet for every sheet of the claims which, on account of an amendment or amendments under [Article 19](#), differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the

differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

(Applicants Guide)

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 307), 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 317). 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 IPEA, regardless of whether or not he has filed amendments to the claims under Article 19 with the IB (see paragraphs 345, 349, 393 to 397, 449 to 451). 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.

§ 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 and any statement referred to in that Article. In any case, the International Bureau shall promptly transmit a copy of such amendments and statement to that Authority.

Appendix C Demand and Article 34 prosecution

1. Filing deadline

Rule 54bis:

“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 and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a); or
- (ii) 22 months from the priority date.”

While the deadline for demands has changed, there may be an advantage to filing them early. See the FAQs section of the WIPO website. . .

Since a demand does not have to be filed before the expiration of 19 months from the priority date in order to get the benefit of 30 months from the priority date to enter the national phase (in a State in which the modified Chapter I time limit applies), if I want to file a demand so that I can ensure that I obtain an international preliminary examination report (IPER) in sufficient time to be able to use it in my national phase filing decisions, when should I file it?

In order to increase the likelihood that the IPEA will be able to establish the IPER within a time frame that will enable you to make national phase entry decisions based on it, it is our recommendation that you continue to file your demand as early as possible, taking into account PCT Rule 69 in relation to when international preliminary examination will start and the time limits for establishing the report.

2. When you file a demand, you need to file a Statement Concerning Amendments:

§ 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 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 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.

3. Prosecution advice.

To make sure you get a complete prosecution, you should add the following to all written communications:

“If in the opinion of the Examiner a favorable IPER cannot be issued on the basis of the above claims and arguments, Applicants expressly request issuance of an additional written opinion under Rule 66.4 and/or institution of a telephone interview under Rule 66.6. It is submitted that such additional communication, if needed, will facilitate the issuance of a favorable IPER, and provide efficiencies in subsequent regional and national phase examination.”