

If the reply contains amended claims introducing unsearched matter, the applicant will be informed in the IPER (under Section III) that an opinion cannot be given for unsearched matter.

As explained in GL/PCT-EPO B-VIII, 1, an additional search may be made after entry into the European phase, in the examination phase, if the reasons for restricting the search can be overcome (see also GL/EPO C-IV, 7.2). This additional search is at no additional cost to the applicant.

4.2 Consequences of a declaration of no search or an incomplete search in subsequent European procedure

For unsearched subject-matter, no written opinion is established under PCT Chapter I and no examination is carried out under PCT Chapter II. Furthermore, there is no possibility for the applicant to appeal the decision of the ISA (see GL/PCT-EPO C-IV, 4.1), so that even if he were to succeed in convincing the examiner under Chapter II that the decision not to search certain subject-matter was incorrect, this has no consequences. However, in the European procedure the examining division must review the decision of the search division (examiner) and take a final decision. This implies that in the European phase for the Euro-PCT application the examiner might have to reverse the decision of the ISA and perform a complete search (either because of the arguments filed or because of the claims having been redrafted so that a search can now be performed, see also GL/EPO C-IV, 7.2).

5. Top-up searches in PCT Chapter II

A top-up search is mandatory at the outset of PCT Chapter II, subject to some exceptions (see GL/PCT-EPO C-IV, 5.2). The date – or absence – of this top-up search must be indicated in the IPER.

Rules 66.1ter and
Rule 70.2(f)
OJ EPO 2014, A57
GL/ISPE 19.15,
19.19-19.20

5.1 Timing, basis and forms

The top-up search will be conducted before/at the same time as issuing the first WO-IPEA (Form 408)/telephone consultation or, where no written opinion is produced, the IPER (Form 409) (approximately within a month of the start of international preliminary examination). A further top-up search before issuance of the IPER is normally not necessary.

GL/ISPE 19.18

In the case of non-unity where there is more than one invention claimed for which examination under Chapter II is demanded, the examiner will first issue an invitation to pay additional examination fees (Form 405) and then perform the top-up search for all inventions for which additional examination fees have been paid.

Art. 34(3)(a)
GL/ISPE 19.16

The IPEA must indicate in the IPER whether or not a top-up search has been done. The date indicated in the form is the date of the latest top-up search. The box which indicates that no top-up search has been done is only ticked if all the claims are exempted from top-up search.

Rule 70.2(f)