

in the SISR as a Y document for those claims if this was not already indicated in the main ISR (see also GL/PCT-EPO B-XII.6), and to provide argumentation in the Scope Annex.

It may also occur that although the EPO as SISA finds further pertinent prior art, objections may also be raised based on X and/or Y documents cited in the ISR. In such a case, the examiner may choose to base objections only on the documents cited in the ISR if considered expedient. Should the objections correspond to those raised in the WO-ISA from the main ISA, a mere reference to the WO-ISA objections will suffice.

There may also be cases where the ISR contains documents pertinent for novelty and/or inventive step and the EPO as SISA cannot find any further relevant documents (only possibly A documents). In such a case the following two possibilities will arise:

- (i) if the examiner agrees with the categories (X, Y) given in the ISR for these documents, it is not necessary to cite the documents again in the SISR. The examiner will then use the documents cited in the ISR to raise objections of lack of novelty and/or inventive step. If the WO-ISA from the main ISA has raised the same objections, and the examiner agrees with the given reasoning, a mere reference to the objections raised in the WO-ISA from the main ISA will suffice.
- (ii) if the examiner does not agree with some or all of the categories (X, Y, A) given in the ISR for any such documents considered pertinent and upon which the examiner wishes to base his objections in the Scope Annex, such documents will be cited again in the SISR.

In both these cases the A documents found by the EPO as SISA will be cited in the SISR.

Generally, an explicit re-evaluation of the objections raised in the WO-ISA will be avoided. The examiner will thus refrain from negatively commenting on any reasoning given in the WO-ISA, bearing in mind that national law differs amongst the PCT contracting states.

## **8. Validity of priority and E/P documents**

At this stage the priority document should be available in the file and it can therefore be checked if E/P documents were found during the search. Should the priority document not be available, for the purposes of the search the priority is assumed to be valid. No indication in the Scope Annex is necessary.

If the priority is not valid, this will be explained in the Scope Annex, and any P documents found to be relevant will be dealt with in detail.

On the other hand, if the priority is valid, any cited P documents do not need to be dealt with in detail.

Any E document which is a potential Art. 54(3) EPC document will be dealt with in the Scope Annex. In this case the applicant's attention should be