

Chapter IX – Special requests

1. Withdrawal of demand under Chapter II

Applicants are entitled to a refund of the whole amount of the international preliminary examination fee if the demand is withdrawn before 30 months from the priority date and on condition that international preliminary examination has not started. If the examiner has actually started to examine the file, no refund will be made. The starting date of international preliminary examination can in most cases be derived from Form PCT/IPEA/409, which in Box I, point 6, indicates the date of the top-up search (Rule 70.2(f)). GL/PCT-EPO C-IV 5.1, explains that the top-up search is conducted at the start of international preliminary examination and is usually not repeated before the IPER is issued.

Rule 58.3

Rule 90bis.4

OJ EPO 2017, A115

OJ EPO 2018, A24

The withdrawal of the demand will be effective upon receipt of a notice from the applicant to the IB. However, the applicant may also submit the notice of withdrawal to the EPO as IPEA. In this case, the EPO as IPEA marks the date of receipt on the notice and transmits it promptly to the IB. The notice is considered to have been submitted to the IB on its date of receipt at the EPO as IPEA.

The signature of each applicant is required if the demand under Chapter II is withdrawn.

Rule 90bis.5

2. Request for examination of a different set of claims

The filing of different sets of claims for different elected States or of different (main and auxiliary) requests based on different sets of claims is not accepted since examining such claims is both time-consuming and against the intention of the PCT. Auxiliary requests are not provided for under the PCT because Rule 66.1(c) provides that, where Art. 19 amendments are made, the international preliminary examination is based on these amendments, unless they are superseded or reversed by a later amendment under Art. 34, and furthermore because Rule 70.16(a) provides for the annexing of the latest set of application documents to the IPER. The simultaneous examination of several co-pending requests is not compatible with the sequential consideration of single requests provided for in the above-mentioned Rules.

Rule 66.1(c)

Rule 70.16(a)

If it is clear which request is the preferred (e.g. the main request), the WO-IPEA/IPER is established on that request; a remark is added in the WO-IPEA/IPER that the treatment of different requests (or main and auxiliary requests) is not provided for under the PCT.

If it is not clear which request is preferred (different requests with no preferred order), the applicant is asked, preferably by telephone, to furnish one set only or to state which set/request should be used for the examination.

If the applicant does not reply and/or insists on a plurality of sets, the WO-IPEA/IPER is drawn up on the first set, with a remark on the separate sheet under Section I.