

Chapter II – Inventions

1. General remarks

The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable.

Art. 33(1)
Rule 43bis.1(a)

The PCT does not define what is meant by "invention", but Rules 39 and 67 contain a list of subject-matter for which the ISA or IPEA is not required to carry out an international search or an international preliminary examination, respectively (see also GL/PCT-EPO B-VIII.2). The Agreement between the EPO and WIPO in relation to the functioning of the EPO as an International Authority under the PCT indicates the subject-matter which the EPO is not required to search or examine, and according to its Art. 4 and Annex C the discretion not to search or examine is exercised by the EPO as ISA and IPEA only to the extent that such subject-matter is not searched under the provisions of the EPC, specifically Art. 52(2), Art. 52(3), Art. 53(b) and Art. 53(c) EPC.

Art. 34(4)(a)(i)
GL/ISPE 9.02-9.15
OJ EPO 2017, A115
OJ EPO 2018, A24

2. Examination practice

In carrying out the international preliminary examination, there are two general points the examiner must bear in mind. Firstly, any exclusion from patentability applies only to the extent to which the application relates to the excluded subject-matter as such. Secondly, the subject-matter of the claim should be considered as a whole, in order to decide whether the claimed subject-matter has a technical character.

3. List of exclusions

See ISPE Guidelines 9.02 to ISPE Guidelines 9.15.

3.1 Discoveries

Rules 39.1 and 67.1 do not explicitly exclude an international search or international preliminary examination on discoveries from being carried out by the ISA or IPEA, respectively. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(a) and Art. 52(3) EPC. Section G-II, 3.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rules 39.1, 67.1
OJ EPO 2017, A115
OJ EPO 2018, A24

3.2 Scientific theories

See ISPE Guidelines 9.05. However, under the Agreement between the EPO and WIPO these fall within the EPO's discretion to exclude matter which would be excluded under Art. 52(2)(a) and Art. 52(3) EPC. Section G-II, 3.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

Rule 39.1(i),
Rule 67.1(i)
OJ EPO 2017, A115
OJ EPO 2018, A24