



Selecting an International Searching Authority

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Disclaimer

This is not legal advice. Reading these slides or attending this seminar does not make you my client and does not make me your lawyer. This is an educational program. If you want legal advice, consult competent counsel who can learn your detailed situation and can give you advice about your situation.

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A word about your presenter

Yes I am often a consultant for WIPO, teaching this and many other PCT programs, live and recorded ...

in person and via webinar ...

I am also an opinionated private practitioner

Please join me in recognizing that I wear two hats from time to time during the webinar

When you hear me expressing opinions, then I am not speaking on behalf of WIPO, and instead I am merely speaking as a private practitioner

There are 25 ISAs

AT AU BR CA CL CN EA EG EP ES FI
IL IN JP KR PH RU SA SE SG TR
UA US XN XV

How you know which ISAs you have to choose from?

The list of ISAs that you have to choose from is determined by your choice of RO

Your range of choices of RO is in turn defined by your applicant list

This might prompt adding an Applicant of Convenience to your applicant list

Each RO “specifies” one or more ISAs

By far the majority of ROs have specified only a single ISA

This means there are many PCT filers who do not routinely consider any choice of ISA

Example: maybe you are accustomed to only being able to pick ISA/EP

Example: applicant is from AL, AT, BA, BW, CH, CY, DE, EE, FR, GB, GR, HR, IE, IT, LU, ME, MK, MT, MW, NL, PT, SC, SI, TN

This would normally mean the only choice for ISA is ISA/EP

Suppose your claims are very close to being pure business methods or are very close to being pure software implementations

ISA/EP might not be your best choice for an ISA

Maybe add an Applicant of Convenience for one designation (my favorite is Malawi) who is from the US

Now you can also pick ISA/AU, ISA/IL, ISA/JP, ISA/KR, ISA/SG, ISA/RU, ISA/US

Some applicants in this situation pick ISA/KR

The highest number of ISAs that any RO has specified is ten

RO/SA has specified CA, CN, EG, EP, JP, KR, RU, SA, SG and US

Special case: RO/IB

How do you know which ISAs you have to choose from if you are in RO/IB?

Figure out all the ROs that you could have used based on your applicant list

List all of the ISAs that you could have chosen given all of those ROs

That is your list of available ISAs

ePCT will help you with this

ePCT will work out for you which ISAs you have to choose from

This can be very helpful particularly when you are in RO/IB

It is good to learn how to use all functions of ePCT

Some filers are in a rut

They assume that some particular ISA is always the right choice

“we’ve always done it that way”

It is likely that one client may have factors making one ISA a best choice, while a different client may have factors making some other ISA a best choice

It is very unlikely that “one size fits all”

Selecting an International Searching Authority

Many factors may influence the client's selection of ISA

- Quality
- Cost
- Timeliness
- Suitability for later use for PPH purposes
- Possible benefits and interactions with particular national- or regional-phase filing paths
- Paper or electronic communication
- Availability of cited references

Picking an International Searching Authority

- You are getting ready to file a PCT application
- You (actually, the client) must pick an International Searching Authority (ISA)
- If your habit is always to pick the same ISA, because “we’ve always done it that way,” then this is an opportunity to provide better service to your client

PPH Benefit

- AU, IL, JP, KR, RU, SG, and US are all part of the Global PPH. Positive results from any of those ISAs may form the basis for PPH status in:
 - AT, AU, CA, DE, DK, EE, ES, FI, GB, HU, IL, IS, JP, KR, NO, PT, RU, SE, SG, US
- EP, JP, KR, and US are part of the IP5 PPH. Positive results from any of those ISAs may form the basis for PPH status in:
 - CN, EP, JP, KR, US
- So if you know now in which Offices you might enter national/regional phase, and if you might want PPH benefit in those Offices, this may influence your choice of ISA

EPO and PPH

- Note that EPO has the PACE program, which offers the opportunity to accelerate search or examination without having to qualify for PPH
- This explains why it almost never happens that an applicant in EPO uses PPH
- Note that in recent years, nearly all EPO cases receive a first Office Action within PACE time anyway, even if the case is not in PACE
- This also explains why EPO applicants usually do not worry about PPH
- But EPO results (including ISA/EP results) are frequently employed to make use of PPH in other Offices

Search Fees

- US non-small entity: \$2400
- EP: \$2237
- SG: \$1816
- AU: \$1555
- IL: \$1333
- JP: \$1059
- US small entity: \$960
- KR: \$842
- PH: \$600
- US micro entity: \$480

Additional Search Fees in the Event of Lack of Unity of Invention

- Where there is lack of unity, the ISA will only search one invention
- Typically it will turn directly to the first invention
- To have the additional inventions searched, applicant has to pay an additional search fee for each invention
- The fee is paid in the ISA's local currency
- Consider the comparative cost of search if there is a likelihood of lack of unity

Effect on Later National/Regional Stage

- If you pick ISA/EP and later enter the EP regional phase, you don't have to pay a search fee to the DO/EO/EP
 - EPO "drinks its own Champagne"
- If you pick ISA/US and get a favorable WO, or pick IPEA/US and get a favorable IPRP (Chapter II), and you later enter the US national phase, you get out-of-order examination and reduced (zero) search and examination fees (37 CFR § 1.496)
- If you pick IPEA/AU, you get a reduced examination fee in EO/AU

Language Competency

- An ISA/AU or ISA/US searcher might read only English
- ISA/EP searchers read at least English, German, and French, and some also read additional languages
- ISA/IL searchers read Hebrew and English and most also read Russian
- ISA/JP searchers read Japanese and English
- ISA/KR searchers read at least Korean and English and most also read Japanese
- ISA/PH searchers read at least English and some also read additional languages
- ISA/SG searchers read English and Chinese and some also read additional languages

Excluded Subject Matter and Subject Matter Not Required to be Searched

- An International Authority may exclude certain subject matter from its agreement with WIPO to act as an ISA and IPEA
 - If all the claims are directed to such subject matter, ISA will issue an Article 17(2)(a) declaration of non-establishment of the ISR
 - Subject matter not required to be searched includes (Rule 39.1)
 - Scientific and mathematical theories
 - Plant or animal varieties or essentially biological processes for the production of plants or animals (except microbiological)
 - Schemes, rules or methods of doing business
 - Methods for the treatment or diagnosis of the human or animal body
 - Mere presentations of information
 - Computer programs

Subject Matter Not Searched

■ For example:

■ AU

- Methods of treatment
- Plant and animal varieties

■ KR

- Methods of treatment of the human body by therapy

ISA Competency Considerations

■ ISA/AU

- Not competent to act as ISA for international applications filed by US applicants in RO/US or RO/IB if more than 250 IAs have been received in the relevant fiscal quarter

■ ISA/EP

- will not search claims directed to mere business methods

■ ISA/IL

- Numerical limitation of no more than 100 IAs per fiscal quarter for US-based filers

EP: Limitation on Number of Independent Claims in a Category

- Where there are two or more independent claims in the same category of invention (i.e., product or method) that are in unity of invention:
 - ISA/EP may issue an informal communication telling the applicant that the description, claims or drawings fail to comply with the PCT requirements to such an extent that a meaningful search cannot be carried out because the plurality of independent product claims lack conciseness as required by PCT Article 6
 - The applicant may need to choose which independent claim should be searched
 - Unlike a unity of invention requirement, the applicant cannot pay for the search of the other independent claims in that category
 - It is best to ensure that most important independent claim is listed first

Outsourcing

- ISA/US searches are outsourced
 - Continued user concern that USPTO examiners in US national phase may not give full faith and credit to outsourced ISA/US searches and written opinions
 - USPTO focus on ensuring the quality of work from ISA/US contractors

Provision of Cited References

- Upon payment or free of charge
 - ISA/AU: upon payment of AUD 50 (about \$36) per document
 - ISA/EP: provides copies of cited references
 - ISA/IL: upon payment of ILS 44 (about \$14) per document
 - ISA/JP: upon payment of JPY 1400 (about \$12) per document
 - ISA/KR: provides an ephemeral link to a web page containing electronic copies of cited references
 - ISA/PH: upon payment of \$20 per document (but free if ISA is provided electronically)
 - ISA/SG: upon payment of SGD 30 (about \$ 22) per document
 - ISA/US: provides copies of cited non-US patent documents and non-patent literature

EPO – mailbox system

- ISA/EP has a mailbox system
- You should use it
- If you fail to use the EPO mailbox system, then you will have to wait weeks for documents to show up by postal mail
- This leads to risk of delays
- Yes you can get extra time for delays but it is a lot of trouble
- News flash! Starting June 1, 2026, EPO will send all ISA/EP communications to ePCT if the applicant checks the "electronic" box in the PCT Request
- See <https://blog.oppedahl.com/good-news-for-those-who-use-isa-ep-and-ipea-ep/>

The ISA might cite references in its own tongue

- Some practitioners report receiving lots of Chinese-language references from ISA/CN
- Those practitioners tell me they don't like having to pay to get the references translated into English
- "Doctor, it hurts when I move my arm like this!" "So, don't move your arm like that!"

Later choice of International Preliminary Examining Authority

Your choice of ISA affects your later choice of an IPEA

- AU/EP/IL/JP/SG will be available as IPEA to the US filer in a particular PCT application only if that IPEA was also the ISA
 - Bear this in mind when selecting an ISA

Communicating with ISAs through ePCT

This works for ISA/AU, ISA/EP, ISA/KR, ISA/RU, ISA/SG

Of course your PCT application is already in your ePCT workbench (right?)

You click on “upload documents” and pick “to ISA”

You will get credit for what time it is at the ISA

You do not need to figure out how to e-file directly at the ISA

Very handy for sequence listings and responses to invitation to pay additional fees

Thank you!