

U.S. Patent and Trademark Office, Commerce

§ 1.484

By a small entity (\$1.27(a)) .....	\$300.00
By other than a small or micro entity .....	\$600.00
(B) For an international preliminary examination fee paid before January 1, 2014 .....	\$600.00
(ii) If the International Searching Authority for the international applica- tion was an authority other than the United States Patent and Trade- mark Office:	
(A) For an international preliminary examination fee paid on or after Janu- ary 1, 2014:	
By a micro entity (\$1.29) .....	\$190.00
By a small entity (\$1.27(a)) .....	\$380.00
By other than a small or micro entity .....	\$760.00
(B) For an international preliminary examination fee paid before January 1, 2014 \$750.00.	
(2) An additional prelimi- nary examination fee when required, per addi- tional invention:	
(i) If the international pre- liminary examination fee set forth in paragraph (a)(1) of this section was paid on or after January 1, 2014:	
By a micro entity (\$1.29) .....	\$150.00
By a small entity (\$1.27(a)) .....	\$300.00
By other than a small or micro entity .....	\$600.00
(ii) If the international pre- liminary examination fee set forth in paragraph (a)(1) of this section was paid before January 1, 2014 .....	\$600.00
(b) The handling fee is due on filing the Demand and shall be prescribed in PCT Rule 57.	

**§ 1.484 Conduct of international pre-  
liminary examination.**

- (a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.
- (b) International preliminary examination will begin in accordance with PCT Rule 69.1.
- (c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.
- (d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.
- (e) The written opinion established by the International Searching Authority under PCT Rule 43*bis*.1 shall be considered to be a written opinion of the United States International Preliminary Examining Authority for the purposes of paragraph (d) of this section.
- (f) The International Preliminary Examining Authority may establish further written opinions under paragraph (d) of this section.
- (g) If no written opinion under paragraph (d) of this section is necessary, or if no further written opinion under paragraph (f) of this section is to be established, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.
- (h) An applicant will be permitted a personal or telephone interview with the examiner, which may be requested after the filing of a Demand, and must be conducted during the period between the establishment of the written opinion and the establishment of the international preliminary examination report. Additional interviews may be conducted where the examiner determines that such additional interviews

[78 FR 17107, Mar. 20, 2013]

## § 1.485

## 37 CFR Ch. I (7–1–14 Edition)

may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant or, if not filed by applicant be made of record in the file by the examiner.

(i) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary report may be established as if the priority had not been claimed.

[52 FR 20049, May 28, 1987, as amended at 58 FR 4346, Jan. 14, 1993; 62 FR 53199, Oct. 10, 1997; 63 FR 29619, June 1, 1998; 66 FR 16006, Mar. 22, 2001; 68 FR 59888, Oct. 20, 2003]

### **§ 1.485 Amendments by applicant during international preliminary examination.**

The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must be made in accordance with PCT Rule 66.8.

[74 FR 31373, July 1, 2009]

### **§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.**

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for reply, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

[52 FR 20049, May 28, 1987, as amended at 58 FR 4346, Jan. 14, 1993; 62 FR 53200, Oct. 10, 1997]

### **§ 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.**

(a) If the applicant disagrees with the holding of lack of unity of invention by