

Limited Competency of Certain International Searching Authorities With Respect to Applications Filed in the USPTO

Applicants are hereby reminded that certain International Searching Authorities have limited their competency for applications filed with the United States receiving Office (RO/US). Selecting a non-competent International Searching Authority (ISA) can result in significant delays in the issuance of the International Search Report and Written Opinion of the International Searching Authority.

Please see below the current ISA limitations and information:

- The use of IP Australia is restricted. IP Australia will not act as an ISA if it has received more than 250 international applications from the USPTO during a fiscal quarter, as indicated in the Official Gazette at [1409 O.G. 302](#) on December 30, 2014. IP Australia will act as an IPEA only if it also acted as the ISA.
- The use of the ILPO is restricted. The ILPO will not act as an ISA for applications with one or more claims relating to a business method as defined by certain International Patent Classification classes nor will the ILPO act as an ISA where it has received more than 75 international applications from the USPTO during a fiscal quarter, as indicated in the Official Gazette at 1408 O.G. 52 on November 4, 2014. For the definition of what the ILPO considers to be precluded subject matter in the field of business methods, see Annex B of the Agreement between the Israel Patent Office and the United States Patent and Trademark Office (http://www.uspto.gov/patents/law/notices/ilpo_isa-ipea.pdf). The ILPO will act as an IPEA only if it also acted as the ISA.
- The use of the JPO is restricted. The JPO will not act as an ISA for applications unless: (1) the applications are submitted in the English language; (2) the claims of the application are directed to the field of green technology as defined by certain International Patent Classification classes; (3) the JPO has not received more than 5,000 international applications from the USPTO during the 3 year period from July 1, 2015 to June 30, 2018, and not more than 300 applications per quarter during the first year, and not more than 475 application per quarter during the second and third years; and (4) the JPO is chosen as a competent authority by the applicants of said applications. The JPO will also act as an International Preliminary Examining Authority if these four requirements are met, and the JPO acted as the ISA. Detailed information can be found in [Official Notices \(PCT Gazette\)](#) 25 June 2015 edition under RO/US.
- The use of the EPO is not restricted. However, the EPO will issue a declaration under PCT Rule 17(2)(a) that no ISR will be established whenever an application relates only to a business method as such. In applications containing claims relating to business methods where the subject matter of the application also contains technical features, the EPO will perform a search for those parts of the application which are more than mere business methods. The announcement appears in the Official Gazette at [1414 O.G. 61](#) on March 10, 2015. The EPO will act as an IPEA only if it also acted as the ISA.