

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

The USPTO has noticed a significant number of international applications filed in the United States receiving Office (RO/US) under the Patent Cooperation Treaty (PCT) where the applicant has chosen an International Searching Authority (ISA) which is not competent for the subject matter of the claimed invention. This can result in significant delays in the issuance of the International Search Report and Written Opinion of the International Searching Authority. When such an application is filed it is forwarded by the RO/US to the ISA selected by applicant. After processing the application, the ISA will return the application to the RO/US with an indication that it is drawn to subject matter for which the ISA is not competent to act. The RO/US will then notify applicant of such and invite applicant to select a competent ISA. Once the RO/US receives a new indication from applicant as to a new ISA, the RO/US will forward the application to the newly selected ISA where it will undergo further processing and will eventually receive a search in accordance with Chapter I of the PCT.

Applicants are hereby reminded that certain ISAs have limited their competency for applications filed with the RO/US. Specifically, the European Patent Office (EPO) will not act as an ISA/IPEA for applications with one or more claims to a business method (see [PCT Applicant's Guide, Annexes D\(EP\), E\(EP\)](#) and [PCT Gazette No. 07/2005, page 4432 and No. 38/2006, page 19070](#)). Further, the Australian Patent Office (IP Australia) has declared that it is not competent for applications with one or more claims drawn to subject matter set forth in Annex A of the Arrangement between IP Australia and the United States Patent and Trademark Office (see [1337 OG 263](#)). To avoid significant processing delays, applicants filing international applications naming either the EPO or IP Australia as the ISA should take care to ensure that the application does not contain any claims for which the selected ISA is not competent.