

Annex 1 to the Nordic Patent Institute QA Manual Level 1

The Nordic Patent Institute decisions on PCT/GL/ISPE alternatives for search and examination.

The Nordic Patent Institute will in its capacity as international Authority (ISA/IPEA) perform search and examination in accordance with the PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES and within the framework of the European Patent Convention. The Nordic Patent Institute aims to deliver high quality products in compliance with the requirements of the Patent Cooperation Treaty and regulations thereto.

However, the PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES (PCT/GL/ISPE) contains some paragraph's, which allows for the international Authority to choose among alternatives.

The decision on which of the alternatives that should form the basis of search and examination practice within the Nordic Patent Institute is based on the existing laws and practice within the NPO's and the overall decision to comply with EPO practice to the extent possible. Alternatives decided are already incorporated in the practice and guidelines for search and examination both on the national levels as well as for the Nordic Patent Institute.

An overview of the Nordic Patent Institute decisions on PCT/GL/ISPE alternatives for search and examination is outlined in the following.

Alternative issues	Reference to PCT/GL/ISPE paragraph	Decision forming the basis for search and examination
Excluded matter – general.	9.04	The Authority will use the approach “technical character” i.e. –must relate to a technical field <i>and</i> - must be concerned with a technical problem.
Computer programs.	9.15	The Authority will follow the alternative [2] given in appendix to chapter 9 in the Guidelines: A9.15[2]: The basic considerations here are exactly the same as for the other exclusions listed in Rule 67, that is, <i>whether the program claimed has technical character</i> .
Schemes, Rules or Methods of Doing Business.	9.07	The Authority will follow the alternative given in the appendix 9.07[2]: If items essentially are of an abstract or intellectual character they are excluded.
Sequence listings.	9.39	The Authority will require sequence listing in electronic form complying with Standard in AI Annex C to be submitted where considered necessary for performing a meaningful search or preliminary examination.
Lack of unity - only relating to	10.59	The Authority will follow the practice in the

protein and its encoding DNA.		last paragraph of Example 39, and thus act as "some Authorities".
Partial international search and invitation to pay additional fee.	10.61	The Authority will follow the practice of the EPO. This means that in case of finding of lack of unity, there will always be produced a <i>preliminary search report</i> based on the first invention mentioned in the claims. The preliminary search report will be sent to the applicant inviting him to pay additional search fees and stating the reasons for lack of unity.
Practice regarding sufficiency of disclosure of an item of prior art.	12.02 and appendix to chapter 12	The Authority will follow the alternative given in the appendix A12.02[1]: A document of prior art must provide a sufficient disclosure, enabling a person skilled in the art to carry out the invention, on its "effective date". The "effective date" is the publication date in the case of a previously published document.
The "problem-solution" method of assessing inventive step.	13.08 and appendix to chapter 13	The Authority will use the "problem-solution" approach in assessing inventive step, as given in the appendix A13.08.1-9.
A single document may call into question the inventive step.	13.13 and appendix to chapter 13	The Authority will follow the practice outlined in the examples (i) to (iv) of A13.13, where a single document of prior art may lead to a finding of lack of inventive step. The document would then be categorized as "X".
Industrial applicability.	14.01 and appendix to chapter 14	The Authority will follow the alternative given in the appendix in A14.01[2].1-8, where all of the following requirements must be met; otherwise industrial applicability of the claimed subject matter is lacking: (1) The application must indicate the way in which the invention is capable of exploitation in industry. (2) The application must disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. (3) Implementation of the invention in accordance with the claim must result in an embodiment capable of being used for the indicated special purpose.
Whether to invite the applicant to introduce references to the prior art into the application.	Appendix in the PCT guidelines A4.05	The Authority will follow [2], i.e. the Authority will not invite the applicant to insert anything which is obtainable from textbooks or otherwise well known. The Authority will neither invite the applicant to provide a detailed description of the cited prior documents.

Dependent claim(s) that refers to more than one other claim.	5.16	The Authority will follow the alternative given in the appendix A5.16[2]: A dependent claim which refers to more than one other claim may refer to them either alternatively or cumulatively.
Whether the description can provide special definitions of terms that are used in the claims.	5.20	The Authority will follow the alternative given in the appendix A5.20[2]: We require the claim to be amended, so far as possible, whereby the meaning is clear from the wording of the claim alone.
Use-claims.	5.21	The Authority will accept use-claims. The use-claims should be interpreted equivalent to the process claim not to be interpreted as the apparatus or the product.
Product-by-process claims.	5.26	The Authority will follow the alternative given in the appendix A5.26[1]: A product-by-process claim should be construed as a claim to the product per se that possesses the characteristics derived from the manufacturing process stated in the claim.
Conciseness.	5.42	The Authority will follow the alternative given in the appendix A5.42[2]: What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case.