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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

# PATENT COOPERATION TREATY

## INTERIM COMMITTEE FOR TECHNICAL COOPERATION

**Sixth Session**

**Geneva, November 3 to 8, 1976**

DRAFT GUIDELINES
FOR INTERNATIONAL PRELIMINARY EXAMINATION
TO BE CARRIED OUT UNDER THE PATENT COOPERATION TREATY (PCT)

Report prepared by the International Bureau

Introduction

1. The PCT Interim Committee for Technical Cooperation (hereinafter referred to as the "Interim Committee"), at its fifth session held in Geneva from October 29 to November 3, 1975, requested the International Bureau to prepare a draft of "Guidelines for International Preliminary Examination under the PCT" (hereinafter referred to as "PCT Guidelines"), for discussion at the next session of the Interim Committee (see document PCT/TCO/V/20, paragraph 71(vi)).

2. Since international preliminary examination under the PCT will be carried out by several International Preliminary Examining Authorities "the maximum degree of uniformity in their---working methods and the maximum degree of uniformly high quality in their reports" (Article 56(3)(ii) of the PCT) is needed in order to ensure a successful implementation of such a system of international preliminary examination. The PCT itself and the Regulations thereunder contain a number of provisions aimed at achieving that uniformity of international preliminary examining results and the Administrative Instructions will add some more. Moreover, the provision referred to above entrusts the Committee for Technical Cooperation to be established under Article 56 of the PCT with, among other things, the task of contributing to the securing of the said uniformity.

Guidelines for Substantive Examination in the European Patent Office

3. The Interim Committee's attention is drawn to a document recently issued in the framework of the Interim Committee of the European Patent Organisation (EPO), the "Draft Guidelines for Substantive Examination in the EPO to be carried out under the European Patent Convention" of May 26, 1975 (hereinafter referred to as "EPO Guidelines"). This document, which has been prepared by Working Party III of the EPO Interim Committee, was submitted by the International Bureau to prospective PCT Authorities for comments (see circular letter No. 2409, January 26, 1976, Annex A, Appendix I).

4. The EPO Guidelines contain a very detailed description of the practice to be followed for substantive examination relating to European patent applications. Since the European Patent Convention makes provision for the future European Patent Office to act as an International Preliminary Examining Authority under the PCT, an effort has been made in preparing the EPO Guidelines to ensure that the requirements of the PCT and the future EPO procedure with respect to examination are identical or at least compatible. For these reasons, the EPO Guidelines have been used as a basis for the draft PCT Guidelines to the widest extent possible.

5. Invitations to comment on the EPO Guidelines were sent to prospective PCT Authorities, particularly the German Patent Office, the Japanese Patent Office, the State Committee for Inventions and Discoveries of the USSR Council of Ministers, the Swedish Patent Office, the Patent Office of the United Kingdom and the United States Patent and Trademark Office.

Replies Received by the International Bureau

6. The replies received from the State Committee for Inventions and Discoveries of the USSR Council of Ministers, the Patent Office of the United Kingdom and the United States Patent and Trademark Office (hereinafter referred to as the "Authorities"), indicated the desirable differences between the draft EPO Guidelines and what, eventually, should become the PCT Guidelines.

7. The German Patent Office, the Japanese Patent Office and the Swedish Patent Office did not make detailed observations.

Contents of Present Document

Annex A (Compilation of Responses by Authorities in Respect of EPO Guidelines)

8. Annex A to the present document contains a compilation of responses by the three Authorities grouped together according to the chapters or paragraphs of the EPO Guidelines to which they refer. For each paragraph or group of paragraphs dealing with common subject matter, the response from the United States Patent and Trademark Office is reproduced first and is followed by the responses of the State Committee for Inventions and Discoveries of the USSR Council of Ministers and the Patent Office of the United Kingdom. This sequence of responses has been adopted for the sake of clarity in view of the fact that the response by the United States Patent and Trademark Office, consisting of a marked up copy of the EPO Guidelines, could be better utilized as a common basis for presenting the comments of the two other Authorities and avoiding, wherever possible, the repetition of the text of the EPO Guidelines. In addition, the Authorities responding have been identified in the compilation of their responses by the ICIREPAT two-letter country code of the country concerned.

9. In order to further assist the Interim Committee in recognizing those parts of the text of the compilation in which the Authorities expressed different opinions, the text of the compilation is signalled by an arrow accompanied by a number. This number identifies the item set forth in a Comparative Analysis (see Annex B, paragraph 11 below).

Appendices to Annex A

10. Attached to Annex A are the following Appendices:

(i) Appendix I - WIPO circular letter No. 2409 of January 26, 1976;

(ii) Appendices II, III and IV - replies received from those Authorities mentioned in paragraph 6 above (for the two Authorities which submitted comments in the form of marked up versions of the EPO Guidelines, only cover letters have been reproduced as appendices, whereas the comments submitted by the State Committee for Inventions and Discoveries of the USSR Council of Ministers have been reproduced as originally submitted; however, the portions of these comments which were considered relevant to the given chapters and paragraphs of the EPO Guidelines have been also inserted in Annex A);

(iii) Appendices V, VI, and VII - replies received from those Offices mentioned in paragraph 7 above.

Annex B (Comparative Analysis)

11. To facilitate the preparation of future PCT Guidelines, the International Bureau has prepared a Comparative Analysis of the different responses to analyze any important differences of opinion of the Authorities concerned provided they are not only of minor importance or of a mere drafting nature. The Comparative Analysis in Annex B has been organized item by item corresponding to the particular chapter and paragraph, or groups of paragraphs, dealing with common subject matter in the EPO Guidelines. The number identifying each item of the Comparative Analysis appears in the Compilation of responses set forth in Annex A (see paragraph 8 above).

12. The Interim Committee is invited to consider the responses of the Authorities. The Interim Committee is further requested to give its advice in respect of the need for further action to be taken with the view to the establishment of PCT Guidelines.

[Annexes follow]

# COMPILATION OF RESPONSES BY PCT AUTHORITIES IN RESPECT OF EPO GUIDELINES

COVER PAGE

for Technical Cooperation

INTERIM COMMITTEE

~~of the European Patent Organisation~~

~~Secretariat~~

~~Brussels, 26 May 1975~~

~~CI/44/75~~

US:

Preliminary

DRAFT

GUIDELINES FOR ~~SUBSTANTIVE~~ EXAMINATION

~~IN THE EUROPEAN PATENT OFFICE~~

SU: No comments

GB: No comments

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US

SU: No comments

GB: No comments

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US:

SU: No comments

GB: No comments

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SU: No comments

GB: No comments

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US:

SU: No comments

GB: No comments

1 → EXPLANATORY NOTE

by the Interim Committee for Technical Cooperation based upon the document developed

PRELIMINARY
GUIDELINES FOR ~~THE~~ EXAMINATION IN THE ~~EUROPEAN PATENT OFFICE~~ International Preliminary Examining Authority

*Explanatory Note*

*These draft Guidelines have been prepared by Working Party III of the Interim Committee of the European Patent Organisation. When they have been revised ~~in the light of the comments received from the signatory States of the European Patent Convention not represented on Working Party III, and from interested organisations~~ they will be submitted to the Interim Committee with a recommendation that they be published in advance of the opening of ~~the European Patent Office~~. It is anticipated that the Guidelines will eventually be adopted by the ~~President of the European Patent Office~~ (probably after further revision) as internal administrative instructions and guidance for the public ~~in accordance with Article 10, paragraph 2(a), of the European Patent Convention~~.*

for use under the Patent Cooperation Treaty

for Technical Cooperation

any International Preliminary Examining Authority

Assembly

international

*The present document deals with the substantive examination of ~~European~~ applications under ~~the European Patent Convention and its Implementing Regulations~~, as it will be carried out by the examiners ~~in the Munich headquarters of the European Patent Office~~. A further Chapter ~~will~~ be added later dealing with examination in national patent offices ~~under Section IV, paragraph 1, of the Protocol on Centralisation~~. Guidelines are also being prepared on formalities examination, ~~on opposition work~~ and on the ~~search~~. Ultimately it is expected that all the material will be combined into a single book in loose-leaf form and this will probably involve some re-arrangement of the present document. In particular, it may be expedient to ~~bring together into~~ a separate ~~Section~~ matters of general interest such as time limits and oral proceedings. Chapter I on languages has, in fact, been drafted with this in mind.*

US: Chapter II of the Patent Cooperation Treaty and its Administrative Instructions

in the International Preliminary Examining Authority

paper may

international search by the International Searching Authorities

include in

by the Receiving Office

*It will be noted that the text (apart from the Introduction) has been divided into Chapters, each sub-divided into numbered Sections which are further sub-divided into paragraphs. Cross-references to other paragraphs are in a standard form quoting in each case the Chapter, Section and paragraph number (thus e.g. III, 6.9 means paragraph 6.9 in Section 6 of Chapter III). Marginal references indicate the Article or Rule which provides authority for what is stated. It is believed that such references avoid the need for extensive quotation from the ~~European~~ Patent Convention itself, but where the ~~Convention or the Implementing Regulations~~ have been directly quoted this has been indicated by the use of quotation marks and italics.*

Patent Cooperation Treaty

Treaty or the Administrative Instructions

SU: No comments

GB: The two first paragraphs should be replaced by an explanatory note relevant to the PCT.

INTRODUCTION

General Remarks



US:

International Preliminary Examining Authorities

International Preliminary Examining Authorities

International Preliminary Examining Authorities

International Preliminary Examining Authorities

Patent Cooperation Treaty

INTRODUCTION

General remarks

The reputation of the authorities will not only depend on the combined efforts of

1 The establishment of the ~~European Patent Office~~ represents a major step forward in the history of patents. ~~The eyes of the patent world will be on this new Organisation. Its reputation will depend on~~ all employees of ~~all nationalities working harmoniously together and giving of their best,~~ but ~~it will depend~~ above all, on the quality of the technical staff. It is on the search and examination ~~before grant~~, more than anything else, that the ~~European Patent Office~~ will be judged and especially on how examiners ~~in the new Office~~ deal with such difficult questions as inventive step.

2 The Guidelines give instructions as to the practice to be followed in the various aspects of the substantive examination of ~~European~~ applications. They are addressed to the examiners in the ~~European Patent Office~~ but it is hoped that they will also be of assistance to applicants and patent practitioners. The Guidelines are intended to cover typical occurrences. They should therefore be considered only as general directives and examiners may depart from the instructions in exceptional cases. Nevertheless, applicants can expect the ~~Office~~ to act, as a general rule, in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not have the binding authority of a legal text. For the ultimate authority on examination practice, it is necessary to refer firstly to the ~~European Patent Convention~~ itself, ~~including the Implementing Regulations~~ (together with the agreed Conference Minutes on interpretation), ~~and secondly to the interpretation put upon the Convention by the Boards of Appeal and the Enlarged Board of Appeal~~.

~~3 As well as ordinary European applications the European Patent Office~~ may need to deal with international applications filed under the Patent Cooperation Treaty (PCT). The Guidelines explain (particularly in Chapter VI, 10) the modifications in procedure involved in dealing with such international applications, except for the operation of Chapter II of the PCT (International Preliminary Examination) since this is unlikely to be effective for some time; instructions on the impact of this aspect of the PCT will be added later. It is important to note that Article 150 of the Convention states that in case of conflict between the PCT and the ~~Convention, the provisions of the PCT prevail~~.

( Comments from SU and GB on the following page)

.../...

INTRODUCTION (contd.)

General Remarks (contd.)

In.1 EPO 1. Entry into force of the Patent Cooperation Treaty (PCT) represents a major step forward in the history of patents. The eyes of the patent world will be on international applications and the procedure of their examination. The effectiveness and reputation of the PCT will depend on how full and thorough international search has been and how profoundly the decision of International Preliminary Examination is reasoned.

2. The Guidelines concern International Preliminary Examination and its procedures carried out by the examiners in an International Preliminary Examining Authority.

In.2 EPO 3. The Guidelines give instructions as to the practice to be followed in the various aspects of International Preliminary Examination of international applications. They will also be of assistance to applicants and patent practitioners.

SU:

In.2 EPO 4. The Guidelines contain general recommendations for International Preliminary Examination, resulting from Chapter II of the PCT and Regulations under the PCT. This first variant of the Guidelines prepared before the entry into force of the Patent Cooperation Treaty will hardly cover all the problems and cases that may be encountered by the examiner in his practical work. Nevertheless, applicants can expect every International Preliminary Examining Authority to act as a general rule in accordance with the Guidelines until such time as they are revised, and examiners will depart from the instructions only in exceptional cases.

In.3 EPO 5. The Guidelines mostly deal with international applications. However, they may be used mutatis mutandis by National Offices in dealing with national applications if the national law provides so; also, they may be used in revising national laws with the purpose of unification of current practices in patent offices of various countries.

GB: Paragraphs 1 and 2 are not relevant to the PCT as drafted. Redraft with PCT in mind. Delete paragraph 3.

INTRODUCTION (contd.)

The correct approach to examination

4 ~~Examiners will be working with colleagues who not only speak a~~ different language but also come from a different ~~patent~~ background. Many will come from national ~~examining~~ patent offices and be justifiably proud of certain features of their national system. Others will come ~~from countries which do not have a patent examining system.~~ It is important ~~therefore~~ to remember that all examiners in the ~~European Patent Office~~ are working under a common new system as laid down in the ~~European~~ Patent ~~Convention.~~ They should all apply the same standard and in many instances this will mean abandoning previous habits and ways of thought.

various International Preliminary Examining authorites

Cooperation Treaty

5 The attitude of the examiner is very important. He should always try to be constructive and helpful. While it would of course be quite wrong for an examiner to overlook any major deficiency in an application, he should have a sense of proportion and not pursue unimportant objections. He should bear in mind that, subject to the requirements of the Convention, the drafting of the description and claims of ~~a European~~ application is the responsibility of the applicant or his authorised representative.

US: an international

Furthermore, the

an International Preliminary Examining Authority

Treaty

6 ~~There is a further matter which should not be forgotten. The~~ reputation of ~~the European Patent Office~~ will depend not only on the quality of the examination and the helpfulness of the examiners, but also on the speed with which it deals with the work. The ~~Convention~~ imposes various time limits on the applicant. ~~Generally speaking there are no corresponding~~ time limits imposed on the ~~Office, but the European patent system~~ will be judged a success only if examiners and other employees also operate with reasonable expedition.

and in general, there are also

International Preliminary Examining Authority.

The Patent Cooperation Treaty

international

7 Finally, it should hardly need stating that all ~~European~~ applications, regardless of their country of origin and the language in which they are written, should receive equal treatment. An international patent system can ~~be credible only if all trace of~~ national bias ~~is absent~~.

only be credible absent any

(Comments from SU and GB on the following page)

.../...

INTRODUCTION (contd.)

The correct approach to examination (contd.)

SU:

In.5 EPO Art. 35(2) Art. 27(5) Art. 33(5) PCT

6. The attitude of the examiner to International Preliminary Examination is very important. He should be constructive, sticking to the principles, but at the same time he should have a sense of proportion and not pursue unimportant objections. He should bear in mind that International Preliminary Examination does not deal with the questions of patentability of inventions in relation to any national law, taken alone, and the drafting of the description and claims of an international application is the responsibility of the applicant or his authorised representative.

In.6 EPO

7. There is a further matter which should not be forgotten. The PCT imposes various time limits on applicant and examiner. These time limits provide for successful functioning of the examination of international applications. What is meant is that examiners and other employees of an International Preliminary Examining Authority work with a corresponding speed.

In.7 EPO

8. It should hardly need stating that all international applications regardless of their countries of origin should receive equal treatment on the part of the International Prèliminary Examining Authority. An international patent system can be credible only if all trace of national bias is absent.

GB:

~~4 Examiners will be working with colleagues who not only speak a~~ different language but also come from a different ~~patent~~ background. Many will come from national ~~examining~~ patent offices and be justifiably proud of ~~certain features~~ of their national system. Others will come ~~from countries which do not have a patent examining system~~. It is important therefore to remember that all ~~examiners in the European Patent~~ IPEAs will be ~~Office are~~ working under a common new system as laid down in the ~~European~~ PCT and they ~~Patent Convention. They~~ should all apply the same standard. ~~and in many instances this will mean abandoning previous habits and ways of thought~~.

5 The attitude of the examiner is very important. He should always try to be constructive and helpful. While it would of course be quite wrong for an examiner to overlook any major deficiency in an application, he should have a sense of proportion. ~~and not pursue unimportant objections.~~ He should bear in mind that, subject to the requirements of the Convention, the drafting of the description and claims of an ~~European~~ International application is the responsibility of the applicant or his authorised representative.

~~6 There is a further matter which should not be forgotten. The~~ reputation of the European Patent Office will depend not only on the quality of the examination and the helpfulness of the examiners, but also on the speed with which it deals with the work. The Convention imposes various time limits on the applicant. Generally speaking there are no corresponding time limits imposed on the Office, but the European patent system will be judged a success only if examiners and other employees ~~also operate with reasonable expedition~~.

7 Finally, it should hardly need stating that all ~~European~~ International applications, regardless of their country of origin and the language in which they are written, should receive equal treatment. An international patent system can be credible only if all trace of national bias is absent.

CHAPTER I

LANGUAGES

1 The languages of the proceedings

paragraph 1.1

US:

CHAPTER I

LANGUAGES

1 *The languages of the proceedings*

1.1 ~~European patent applications may be filed in one of the official~~ languages of the Office, viz. English, French or German. However, a person having his residence or principal place of business in a Contracting State which has a language other than English, French or German as an official language, or a national of such a State who is resident abroad, may file his application initially in an official language of that State. This means, for example, that a Belgian company may file in Flemish, and that a Swedish national may file in the Swedish language. In such a case, a translation in English, French or German must be filed within three months after the initial filing, but if the application claims priority, the translation must be supplied not later than 13 months after the earliest priority date. (This could mean within one month of the initial filing of the application). If the translation is not filed in time, the application is deemed withdrawn. Such translation may be subsequently brought into conformity with the original text of the ~~application (but see I, 6.2)~~.

~~Art 14(1)~~
Rule 55.2(a)
~~Art 14(2)~~
~~Rule 6(1)~~
~~Art 90(3)~~

~~... If the competent International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the competent International Searching Authority, and if the international application is in a language other than the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Preliminary Examining Authority competent for the international preliminary examination, the latter may require that the applicant submit a translation of that application.~~

SU:

Rules 55,12 PCT

68. The International Preliminary Examining Authority considers international application only in one of the languages specified by the agreement with the International Bureau. If an international application is in any other language the International Preliminary Examining Authority may require the applicant to submit the translation of the application in accordance with PCT Rule 55.2.

GB:

This Chapter will need to be redrafted in terms of PCT Art. 3(4) and Rules 12 and 55.

CHAPTER I

LANGUAGES

1 *The languages of the proceedings*

1.1 European patent applications must be filed in one of the official languages ~~of the Office, viz. English, French or German. However, a~~ person having his residence or principal place of business in a Contracting State which has a language other than English, French or German as an official language, or a national of such a State who is resident abroad, may file his application initially in an official language of that State. This means, for example, that a Belgian company may file in Flemish, and that a Swedish national may file in the Swedish language. In such a case, a translation in English, French or German must be filed within three months after the initial filing, but if the application claims priority, the translation must be supplied not later than 13 months after the earliest priority date. (This could mean within one month of the initial filing of the application). If the translation is not filed in time, the application is deemed withdrawn. Such translation may be subsequently brought into conformity with the original text of the ~~application (but see I, 6.2)~~.

Art 14(1)
Art 14(2)
Rule 6(1)
Art 90(3)

CHAPTER I (contd.)

1 The languages of the proceedings (contd.)

paragraph 1.2

US:

~~Art 14(3)~~

International Preliminary Examining Authority

For example, International Preliminary Examining Authority

1.2 The language ~~(chosen from English, French or German)~~ in which the application is filed, ~~or~~ into which it is subsequently translated, is used as "*the language of the proceedings*". This language is to be used in all proceedings before the ~~Office~~ except where ~~the Implementing Regulations~~ provided otherwise as explained below. ~~Therefore~~, if the language chosen was ~~say~~, English, then the English language must normally be used ~~for example~~ for all correspondence relating to the application (whether to or from the ~~Office~~) and for interviews. ~~(As regards documents which are not filed in the correct language, see I, 4 below).~~

if one of the languages specified in the agreement between the International Bureau and the International Preliminary Examining Authority, or, if not that language, the language

SU: No comments

GB:

Art 14(3)

See Rule 55.1 and 55.2

1.2 The language (chosen from English, French or German) in which the application is filed, or into which it is subsequently translated, is used as "*the language of the proceedings*". This language is to be used in all proceedings before the Office except where the Implementing Regulations provide otherwise as explained below. Therefore, if the language chosen was, say, English, then the English language must normally be used, for example, for all correspondence relating to the application, whether to or from the Office, and for interviews. (As regards documents which are not filed in the correct language, see I, 4 below).

CHAPTER I (contd.)

1 The language of the proceedings (contd.)

2 → paragraph 1.3

US:

Under some circumstances

1.3 The applicant may request the ~~Office~~ to allow a change in the language of the proceedings to one of the other languages ~~of the Office~~. If such a change is allowed, the application remains in ~~and will be published in~~ the initial language and any amendments must be filed in that language, but communication with the applicant will normally be in the new language.

International Preliminary Examining Authority ~~3~~ acceptable to the International Preliminary Examining Authority.

thereto

A request to change the language of the proceedings may arise, for instance, if an application made by an Englishman and filed in English, is later assigned to a Frenchman; or if a Swedish applicant who filed in German, decides ~~later on~~ to change his patent agent and appoints someone who is more familiar with one of the other ~~two official~~ languages. The ~~Office~~ should allow such a change if satisfied with the reasons for the request. ~~This applies also where the proprietor of a European patent requests a change in the language, but if, as is most likely, such a request is made during opposition proceedings, the Office must first consult the opponent and any third party to these proceedings before agreeing to such a change~~.

subsequently

of the Authority

International Preliminary Examining Authority

SU: No comments

GB:

Rule 3

No corresponding provision in PCT but see Rule 55.2

~~1.3 The applicant may request the Office to allow a change in the~~ language of the proceedings to one of the other languages of the Office. If such a change is allowed, the application remains in and will be published in the initial language and any amendments must be filed in that language, but communication with the applicant will normally be in ~~the new language~~.

~~A request to change the language of the proceedings may arise, for~~ instance, if an application made by an Englishman and filed in English, is later assigned to a Frenchman; or if a Swedish applicant who filed in German decides later on to change his patent agent and appoint someone who is more familiar with one of the other two official languages. The Office should allow such a change if satisfied with the reasons for the request. This applies also where the proprietor of a European patent requests a change in the language, but if, as is most likely, such a request is made during opposition proceedings, the Office must first consult the opponent and any third party to these proceedings before ~~agreeing to such a change~~.

CHAPTER I (contd.)

1 The language of the proceedings (contd.)

paragraph 1.4

US: ~~Rule 4 1.4 Any divisional application must be filed in the initial language of~~ the proceedings of the application from which it is divided. However, where advantage is taken of Article 14, paragraph 2, the divisional application may be filed initially in an official language of the applicant's State (see I, 1.1), but must then be translated into the ~~initial language of the proceedings for the earlier application~~.

SU: No comments

GB: Delete paragraph 1.4

---

2 Derogation from the language of the proceedings in written proceedings

paragraphs 2.1 and 2.2

US: ~~2 Derogation from the language of the proceedings in written proceedings~~

Rule 1(1) 2.1 An opponent or a third party who intervenes in opposition proceedings under Article 105 may file documents in any of the official languages of the Office. If the language of the proceedings is English and there is a German opponent, the latter may find it convenient to file the notice of opposition in the German language. If an opponent is a person referred to in Article 14, paragraph 2, he may file his documents in his own language (e.g. Italian). However, he is required to supply a translation into one of the languages of the Office; but this need not be the language of the proceedings. Normally, the period allowed is one month, but if the document is a notice of opposition or appeal, this is extended to the end of the opposition or appeal period, if necessary.

Rule 6(2)

Rule 1(2) 2.2 Documents which are to be used as evidence may be filed in any language. This applies during any proceedings before the Office and applies especially to publications (for instance, an extract from a Russian periodical cited by an opponent to show lack of novelty or lack of inventive step). However, the department dealing with the case may require a translation in one of the languages of the Office, not necessarily the language of the proceedings. If the document is filed by the applicant in pre-grant proceedings the Examining Division should require a translation unless the examiners are fully competent in the language concerned. In most cases, however, such documents will be filed in opposition proceedings and a translation should be required. The department concerned may require this translation to be filed within a time limit. This is to be fixed on a case-to-case basis. The period allowed must not be less than one month, and should depend on the particular language concerned and on the length of the document to be translated.

SU: No comments

GB: Delete paragraph 2.1, paragraph 2.2 is really directed to opposition proceedings and not relevant to PCT.

CHAPTER I (contd.)

3 → 3 Derogations from the language of the proceedings in oral proceedings

CHAPTER I

Deviations — interviews

3 ~~Derogations~~ from the language of the proceedings in ~~oral proceedings~~

an interview

3.1 A party to ~~oral proceedings~~ may use any of the official languages of the ~~Office~~, whether or not this is the language of the proceedings. However, when a party intends to use an official language which is not the language of the proceedings he must either make provision himself for interpreting into the language of the proceedings (no notice then being necessary) or give the ~~Office~~ at least two weeks' notice before the date fixed for the ~~oral proceedings~~. In the latter (and probably more usual) case, it is the responsibility of the ~~Office~~ to provide for interpretation at its own expense.

interview

as long as he provides

3.2 A party may also use an official language of one of the Contracting States, ~~other than English, French or German on condition that he makes provision~~ for interpretation into the language of the proceedings. However, if all the parties and the ~~Office~~ agree, any language may be employed without interpretation or prior notice.

Deviations

3.3 ~~Derogations~~ are permitted ~~from the provisions of Rule 2, paragraph 1, and those are~~ at the discretion of the ~~Office~~. Clearly such permission must depend on the circumstances of the individual case. It can, for example, be envisaged that a party might be unable to give two weeks' notice through no fault of his own, or, although he has made arrangements for an interpreter, the latter was unable (e.g. through illness) to attend. ~~If, in such circumstances, the Office is unable to provide for interpretation, it should, if the oral proceedings occur at the examination stage, postpone them. However, in opposition proceedings, the oral proceedings should continue if the parties agree and the Office officials~~ involved in the proceedings can cope with the language. ~~In other cases,~~ the Office should postpone the oral proceedings and any costs incurred by the innocent party as a result of the postponement should be a matter for ~~apportionment under Article 104~~.

US:

~~3.4 When the evidence is being taken, a party, witness or expert who is~~ unable to express himself adequately in English, French or German or in any other official language of the Contracting States, is permitted to use another language. The Office is responsible for interpretation into the language of the proceedings, assuming that this is necessary, if the evidence is taken at the request of the Office itself. But, if the taking of evidence follows a request by a party to the proceedings, the use of a language other than English, French or German should be allowed only if that party provides for interpretation into the language of the proceedings or, at the discretion of Office, into any one of English, French and German. This discretion should only be exercised in opposition ~~proceedings if the other parties agree.~~

CHAPTER I (contd.)

3 → 3 Derogations from the language of the proceedings in oral proceedings (contd.)

the languages specified in the agreement concluded between the International Bureau and the Authority

of the International Preliminary Examining Authority

CHAPTER I

interviews.

~~Rule 2(2)~~ International Preliminary Examining Authority

3.5 Officials may use any one of ~~English, French or German~~ in the course of all ~~oral proceedings~~. However, they should not depart from the language of the proceedings without good reason, and unless the parties involved are competent in the language used and express no objection, the ~~Office~~ should provide for interpretation into the language of the proceedings at its own expense.

JS (contd.):

interview

~~Rule 2(6)~~ an official language of the International Preliminary Examining Authority

interview is an official language of the Authority

Authority

3.6 Statements made in ~~English, French or German~~ are entered in the minutes of the ~~proceedings~~ in the language employed. Statements made in any other language are entered in the minutes in the official language into which they are translated. Amendments to the text of the description or claims of the application or patent made during ~~oral proceedings~~ are entered in the minutes in the "language of the proceedings". If the ~~proceedings are~~ conducted in a language other than ~~English, French or German~~ and no interpretation is effected, then statements should be entered in the minutes in the language employed and the ~~Office~~ should subsequently provide in the minutes a translation into the language of the proceedings.

interviews

SU: No comments

GB: Delete paragraphs 3.1 to 3.6. All these paragraphs are directed to oral proceedings. The only "oral" proceedings in PCT are those referred to in Rule 66.6 which are discretionary and not relevant to languages.

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4 Documents filed in the wrong language

4 → paragraph 4.1

comprising an international

~~Art 78(1)~~

~~Art 80~~

US: acceptable to the International Preliminary Examining Authority

4.1 ~~As explained in I, 1.1,~~ All ~~the~~ documents ~~making up a European~~ application (i.e. those listed in II, 1.1) must be filed in one of the languages ~~referred to in Article 14, paragraphs 1 and 2. In particular, if the description and claims are not filed in one of these languages, date of filing cannot be accorded (Article 80, sub-paragraph (d))~~.

SU: Rules 55,12 PCT

68. The International Preliminary Examining Authority considers international application only in one of the languages specified by the agreement with the International Bureau. If an international application is in any other language the International Preliminary Examining Authority may require the applicant to submit the translation of the application in accordance with PCT Rule 55.2.

GB: Delete paragraph 4.1, which is not relevant to International Preliminary Examining Authorities. If the documents are filed in the wrong language, this should be noted by the receiving Office, the International Bureau or the International Searching Authority.

CHAPTER I (contd.)

4 Documents filed in the wrong language (contd.)

5 → paragraph 4.2

US: Rule 68.2 ~~Art 14(5)~~

4.2 If any documents other than those ~~making up~~ comprising the application (e.g. a letter from the applicant in reply to an invitation under ~~Article 14, paragraph 2, a written observation under Article 115, or a notice of opposition or appeal~~) is not filed in one of the prescribed languages it will be deemed not to have been received. This also applies where a translation of ~~such~~ a document required by the ~~Convention (e.g. under Article 14, paragraph 4)~~ Treaty is not filed ~~in due time~~ timely.

SU: No comments

GB: Delete paragraph 4.2. Nothing corresponding in the PCT

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5 Translation of the priority document

US: previous application is not in the language or in one of the languages of the International Preliminary Examining Authority, the applicant ~~Rule 38(4) Art 91(3)~~ an invitation for such translation, (Rule 66.7(b)&(c)) ~~Art 70(1)~~

5 *Translation of the priority document*

5.1. Where the ~~applicant~~ application claims the priority of a previous application ~~he must file a copy of that application~~. If the language of the ~~latter~~ is not English, French or German, he must file a translation into one of these languages, at his choice, within 2~~0~~ months after the date of ~~priority~~ timely. If this is not done ~~in due time~~, the priority document will be deemed not to have been received and the ~~right to priority~~ the International Preliminary Examination report shall be established as if the priority had not been claimed.

and a copy of the previous application is needed, it must be requested from the International Bureau.

SU: No comments

GB: Rule 66.7 ~~Art 88(1)~~ one of the languages of the IPEA Rule 38(4) Art 91(3)

5.1. Where the applicant claims the priority of a previous application, he must file a copy of that application. If the language of the latter is not ~~English, French or German~~, he must file a translation into one of these languages, at his choice, within 2~~0~~ months after the date of the request by the IB ~~priority~~. If this is not done in due time, the priority document will be deemed not to have been received and the right to priority will be lost.

CHAPTER I (contd.)

6 Authentic Text

6 → paragraph 6.1

US: 6.1 The text of an application or patent in the initial language of the proceedings is the authentic text. ~~It follows therefore that the translation of the claims of the patent specification required by Article 14, paragraph 7, is for information only.~~

SU: No comments

GB: Delete paragraph 6.1, not relevant

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7 → paragraph 6.2

US: 19 6.2 Where the facility provided for by Article ~~14, paragraph 2,~~ has been used and the question arises as to whether a particular amendment proposed by the applicant or proprietor extends the content of the application or patent beyond the content of the application as filed ~~and thus offends against Article 123, paragraph 2,~~ the ~~Office~~ should normally assume, in the absence of proof to the contrary, that the original translation into ~~English, French or German~~ is in conformity with the text in the original language, ~~say Dutch.~~ However, it is the original text which constitutes the basis for determining such a question. Similarly, it is the original text which determines the content of the application as filed ~~for the purposes of Article 54, paragraph 3 (see IV, 6.1).~~ An erroneous translation ~~from Dutch or one of the other languages covered by Article 14, paragraph 2,~~ may be brought into conformity with the original language at any time during proceedings before the ~~Office, i.e. during pre-grant proceedings and also during opposition proceedings. But during opposition proceedings any amendment~~ to bring the translation into conformity must not be allowed if it offends against Article 123, paragraph 3, that is, if it is an amendment ~~of the claims of the patent which extends the protection conferred.~~

Rule 7 Authority

Art 70(2) a language of the International Preliminary Examining Authority of filing

Art 14(2) International Preliminary Examining Authority

SU: No comments

GB: 6.2 Where ~~the facility provided for by Article 14, paragraph 2, has been used~~ Rule 55.2 applies and the question arises as to whether a particular amendment proposed by the applicant or proprietor extends the content of the application or patent beyond the content of the application as filed and thus offends against ~~Article 123, paragraph 2~~, the ~~Office~~ IPEA should normally assume, in the absence of proof to the contrary, that the original translation into ~~English, French or German~~ is in conformity with the text in the original language, say Dutch. However, it is the original text which constitutes the basis for determining such a question. ~~Similarly, it is the original text which determines the~~ content of the application as filed for the purposes of Article 54, paragraph 3 (see IV, 6.1). An erroneous translation from Dutch or one of the other languages covered by Article 14, paragraph 2, may be brought into conformity with the original language at any time during proceedings before the Office, i.e. during pre-grant proceedings and also during opposition proceedings. But during opposition proceedings any amendment to bring the translation into conformity must not be allowed if it offends against Article 123, paragraph 3, that is, if it is an amendment ~~of the claims of the patent which extends the protection conferred.~~

Rule 66.2(iv) Rule 7

Art 70(2) one of the languages of the IPEA

Doubtful if this is relevant to IPEA procedure → Art 14(2)

CHAPTER I (contd.)

8 → 7 Certificate of translation

US:

~~Rule 5~~

International Preliminary Examining Authority

7.1 The ~~Office~~ has the power to require a certificate that any translation supplied corresponds to the original text. The exercise of this requirement should be determined on a case-to-case basis and ought to be used only when the official concerned has serious doubts as to the accuracy of the translation. ~~Certificates are not in principle required in respect of the translations of the claims into the other two official languages required under Rule 51, paragraph 4 (see VI, 15.2).~~

~~Rule 51(4)~~

SU: No comments

GB:

Rule 5

Redraft in terms of Rule 55.2(c)

7.1 The Office has the power to require a certificate that any translation supplied corresponds to the original text. ~~The exercise of~~ this requirement should be determined on a case-to-case ~~basis~~ and ought to be used only when the official concerned ~~has~~ serious doubts as to the accuracy of the translation. ~~Certificates~~ are not in principle required in respect of ~~the~~ translations of the claims into the other two official ~~languages required under Rule 51, paragraph 4 (see VI, 15.2).~~

Rule 51(4)

CHAPTER II

CONTENT OF EUROPEAN APPLICATION (other than CLAIMS)

1 General

US:

INTERNATIONAL

CONTENT OF ~~EUROPEAN~~ APPLICATION
(other than CLAIMS)

Art ~~78~~ 3 1 General

international 1.1 The requirements of the ~~European patent~~ application are set out in Article ~~78~~. 3 The application must contain:

~~"~~(a) a request ~~for the grant of a European patent~~;

(b) a description of the invention;

(c) one or more claims;

(where required) (d) ~~any~~ drawings ~~referred to in the description or the claims;~~

(e) an abstract~~"~~;

(f) a demand under Article 31 for preliminary examination.

This Chapter deals with all these requirements, in so far as they are the concern of the examiner, with the exception of item (c) which is the subject of Chapter III. Item (e) is dealt with first.

SU: No comments

GB:

Art ~~78~~ 3 1 General

1.1 The requirements of the International ~~European patent~~ application are set out in Article 78. The application must contain:

"(a) a request ~~for the grant of a European patent~~;

(b) a description ~~of the invention~~;

(c) one or more claims;

(d) ~~any~~ one or more drawings (when required) ~~referred to in the description or the claims;~~

(e) an abstract".

This Chapter deals with all these requirements, in so far as they are the concern of the IPEA ~~Examiner~~, with the exception of item (c) which is the subject of Chapter III. Item (e) is dealt with first.

CHAPTER II (contd.)

2 Abstract

US:

international ~~Art 78(1)(e)~~ Art 3(2) 8 delineates the 8 Rule ~~33~~ ~~Rule 47~~ International Searching Authority to establish ~~Art 85~~ International Preliminary Examining Authority normally upon publication,

2.1 The application must contain an abstract. The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and any drawings.

2.2 Rule 33 ~~sets out the detailed~~ requirements for the abstract and it is for the ~~Search Division to settle~~ its final form. ~~The abstract relates only to the application as published, and hence it is not necessary to bring it into conformity with the content of the published patent even if this should differ in substance from that of the application.~~ The examiner will not ~~therefore~~ be concerned with seeking any amendment of the abstract. He should, however, note that the abstract has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter. ~~Although~~ The abstract, ~~after it has been published,~~ constitutes part of the state of the art as from its publication date, ~~it is not to be regarded as part of a European application when dealing with conflicts between copending European applications (see IV, 6.1).~~

SU: No comments

GB:

Art 78(1)(e) 2.1 **The application must contain an abstract.** The purpose of the **abstract is to give brief technical information about the disclosure as** contained in the description, claims and any drawings.

Rule 33 See Rule 47 Rule 8 Art 85 2.2 ~~**Rule 33 sets out the detailed requirements for the abstract and it is for the Search Division to settle its final form.**~~ The abstract relates only to the application as published, and hence it is not necessary to bring it into conformity with the content of the published patent even if this should differ in substance from that of the application. The examiner will not therefore be concerned with seeking any amendment of the abstract. He should, however, note that the abstract has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter. ~~**Although**~~ The abstract, after it has been published, constitutes part of the state of the art as from its publication date, ~~**it is not to be regarded as part of a European application when dealing with conflicts between copending European applications (see IV, 6.1).**~~

CHAPTER II (contd.)

3 The Request

paragraph 3.1

US:

Rule 4

3 *The Request ~~for grant (the title)~~* the Request

3.1 The items making up ~~this request~~ are dealt with in ~~the Guidelines relating to formal requirements~~. They do not normally concern the examiner ~~with the exception of the title~~.

SU: No comments

GB:

3 ***The request ~~for grant~~ (the title)***

**3.1 The items making up this request are dealt with in the Guidelines relating to formal requirements. They do not normally concern the examiner with the exception of the title.**

paragraphs 3.2 and 3.3

US:

Rule 4.3 ~~26(2)(b)~~ by the International Searching Authority, the International Preliminary Examining Authority

3.2 The title should *clearly and concisely state the technical designation of the invention* and should *exclude all fancy names*. While any obvious failures to meet these requirements are likely to be noted ~~during the formalities examination, the~~ examiner should review the title in the light of his reading of the description and claims and any amendments thereto, to make sure that the title, as well as being concise, gives a clear and adequate indication of the subject of the invention.

~~Rule 26(2)(b)~~ International Preliminary Examining Authority

3.3 Also, if the application *contains claims in different categorites (product, process, apparatus, use), this must be evident from the title*. Thus, if any amendments are made which change the categories of claims, the examiner should check whether a corresponding amendment is needed in the title (see also II, 4.2).

SU: No comments

GB:

Rule 26(2)(b) Not appropriate. See PCT Rule 4.3 and redraft in those terms.

3.2 **The title should "~~*clearly and concisely state the technical designation of the invention*~~" and should "*exclude all fancy names*". While any obvious failures to meet these requirements are likely to be noted during the formalities examination, the examiner should review the title in the light of his reading of the description and claims and any amendments thereto, to make sure that the title, as well as being concise, gives a clear and adequate indication of the subject of the invention.**

Rule 26(2)(b) 3.3 Also, if the application "*contains claims in different categorites (product, process, apparatus, use), this must be evident from the title*". Thus, if any amendments are made which change the categories of claims, the examiner should check whether a corresponding amendment is needed in ~~the title (see also II, 4.2)~~.

CHAPTER II (contd.)

4 Description

paragraphs 4.1 and 4.2

US:

Art 5 ~~83~~ the invention

4.1. The application must "*disclose the invention in a manner sufficiently clear and complete for ~~it~~ to be carried out by a person skilled in the art*". The meaning of "*person skilled in the art*" is discussed in Chapter IV, 9.6. This requirement of disclosure should be met by the description with the aid of drawings, if any. The provisions relating to the content of the description are set out in Rule 5 ~~27~~. The purpose of these provisions is:

(i) to ensure that the application contains all the technical information required to enable a skilled person to put the the invention into practice; and

(ii) to enable the reader to understand the contribution to the art which the inventor has made.

Rule 5 ~~27(1)(a)~~

4.2 The description should start with the same title that ~~as~~ appears in the Request ~~for grant~~. Thus if the title is deficient (see II, 3) it should be amended in both the request ~~for grant~~ and the description. The description should contain subheadings corresponding to those contained in Section 205. Although such subheadings are not rigidly mandatory in number or wording, their use is highly recommended in order to provide uniformity in publication and to speed information retrieval. The recommended subheadings are discussed in the following paragraphs.

SU: No comments

GB:

Art ~~83~~ 5

4.1. The application must "*disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art*". The meaning of "*person skilled in the art*" is discussed in Chapter IV, 9.6. This requirement of disclosure should be met by the description with the aid of drawings, if any. The provisions relating to the content of the description are set out in Rule ~~27~~. The purpose of these provisions is: 5.1

(i) to ensure that the application contains all the technical information required to enable a skilled person to put the the invention into practice; and

(ii) to enable the reader to understand the contribution to the art which the inventor has made.

5.1(a)
Rule ~~27(1)(a)~~

4.2 The description should start with the same title as appears in the request for grant. Thus if the title is deficient (see II, 3) it should be amended in both the request for grant and the description.

CHAPTER II (contd.)

4 Description (contd.)

paragraph 4.3

US: 5.1(a)(i) Rule ~~27(1)(i)~~ Technical Field.

4.3 The invention should be placed in its setting by specifying the technical field to which it relates.

SU: No comments

GB: No comments

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paragraphs 4.4 and 4.5

US: 5.1(a)(ii) Rule ~~27(1)(c)~~ Background Art.

4.4 The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see III, 2.2). The insertion into the statement of prior art of references to some of the documents cited in the search report should be required if these are necessary to put the invention ~~into~~ proper perspective. For instance, while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner should require a reference to these documents and a brief summary of the relevant contents.

international

and

4.5 Since the reader is presumed to have the general background technical knowledge appropriate to the art, the examiner should not require the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well known. Likewise the examiner should not require a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed description is necessary for a full understanding of the invention of the application. Lists of several reference documents relating to the same feature or aspect of the prior art are not required; only the most appropriate need be referred to. On the other hand the examiner should not insist upon the excision of any such unnecessary matter, except when it is very extensive.

~~Rule 34(1)(c)~~

SU: No comments

(Comments of GB on the following page)

CHAPTER II (contd.)

4 Description (contd.)

paragraphs 4.4 and 4.5 (contd.)

GB:

Rule 27(1)(e)

The terminology of these sections should be amended to agree with Rule 5. Also refers to "require", "insist" etc. should be removed as IPEA has no power to apply sanctions for non-compliance.

4.4 The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see III, 2.2). The insertion into the statement of prior art of references to some of the documents cited in the search report should be ~~required~~ invited if these are necessary to put the invention into proper perspective. For instance while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner should require a reference to these documents and a brief summary of the relevant contents.

4.5 Since the reader is presumed to have the general background technical knowledge appropriate to the art, the examiner should not require the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well known. Likewise the examiner should not require a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed description is necessary for a full understanding of the invention of the application. Lists of several reference documents relating to the same feature or aspect of the prior art are not required; only the most appropriate need be referred to. On the other hand the examiner should not insist upon the excision of any such unnecessary matter, except when it is very extensive.

Rule 34(1)(c)

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paragraph 4.6

US:

5.1(a)(iii) Disclosure of Invention.

Rule ~~27(1)(d)~~

4.6 The invention as claimed should be disclosed in such a way that the technical problem, or problems, to be met can be appreciated and the manner in which the invention provides a solution can be understood. To meet this requirement, only such details should be included as are necessary for elucidating the invention. It is not necessary, moreover, that the invention be presented explicitly in problem and solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this should not be done in such a way as to disparage any particular prior product or process. Furthermore, neither the prior art nor the applicant's invention should be referred to in a manner likely to mislead. This might be done, e.g. by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case.

~~Rule 34(1)(b)~~

SU: No comments

GB: No comments

CHAPTER II (contd.)

4 Description (contd.)

**paragraphs 4.7 and 4.8**

US:

5.1(a)(iv) Brief Description of Drawings.

Rule ~~27(1)(e)~~ 4.7 If drawings are included they should first be briefly described, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow 'X' of Figure 2; Figure 4 is a cross-section taken through AA of Figure 1." When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number, i.e. the reference should not be in the form: "3 is connected to 5 via 4" but, "resistor 3 is connected to capacitor 5 via switch 4".

~~Rule 32(2)(i)~~ 4.8 The description and drawings ~~should~~ shall be consistent with one another, especially in the matter of reference numbers and other signs (see also Rule 11.13(l)&(n) II, 5.1).

SU: No comments

GB: No comments

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**paragraphs 4.9 to 4.11**

US:

Best Mode for Carrying Out the Invention.

~~Rule 27(1)(f)~~ 4.9 A detailed description of at least ~~one way~~ of carrying out the invention must be given. Since the application is addressed to the person skilled in the art it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it obvious to the skilled person how to put the invention successfully into practice. In many cases a single example or single embodiment wil suffice, but where the claims cover a broad field the description should not usually be regarded as satisfying the requirements of Article ~~83~~ unless it gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims.

Rule 5.1(a)(v) the best mode

5

4.10 It is the responsibility of the applicant to ensure that he supplies, when he first files his application, a sufficient description, i.e. one that meets the requirements of Article ~~83~~ in respect of the invention as claimed in all of the claims. If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Article ~~123, paragraph 2~~, which requires that the subject-matter content of the application must not be extended (see VI, 5.4 to 5.9). ~~Therefore, in such circumstances, either the application must be refused (the most~~ usual case) or, if the deficiency arises ~~only in respect of part of the subject-matter claimed, the~~ claims should be restricted to that part of ~~the invention for which a sufficient description has been filed.~~

5

Art ~~83~~

~~Art 123(2)~~

19(2)

CHAPTER II (contd.)

4 Description (contd.)

paragraphs 4.9 to 4.11 (contd.)

US (contd):

4.11 Two instances where there is a fundamental insufficiency in the application, and thus a failure to satisfy the requirements of Article ~~83~~, deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are ~~unrepeatable~~ not reproducible or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a breeding process in the field of microbiology. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures - as can arise, e.g. in the manufacture of small magnetic cores or electronic components; in this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection necessarily arises under Article 83. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws - this applies e.g. to a perpetual motion machine. If the claims for such a machine are directed to its function, and not merely to its structure, an objection arises not only under Article 83 but also ~~under Article 57, paragraph 1~~ Article 33(4) that the invention is not "*susceptible of industrial application*" (see IV, 4.1).

SU: No comments

GB:

Rule 27(1)(f)

4.9 A detailed description of the best mode ~~at least one way~~ of carrying out the invention must be given. Since the application is addressed to the person skilled in the art it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it obvious to the skilled person how to put the invention successfully into practice. In many cases a single example or single embodiment will suffice, but where the claims cover a broad field the description should not usually be regarded as satisfying the requirements of Article 83 unless it gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims.

Bring more into line with PCT Rule 5.1(a)(v)

4.10 It is the responsibility of the applicant to ensure that he supplies, when he first files his application, a sufficient description, ~~i.e. one that meets the requirements of Article 83 in respect of the invention as claimed in all of the claims~~. If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Article 34(2)(b) ~~123, paragraph 2~~, which requires that the subject-matter content of the application must not be extended (see VI, 5.4 to 5.9). ~~Therefore, in such circumstances, either the application must be refused (the most~~ usual case) or, if the deficiency arises ~~only~~ in respect of part of the subject-matter ~~claimed, the~~ claims should be restricted to that part of ~~the invention for which a sufficient description has been filed~~.

Art 83

Art 123(2)

Not appropriate to PCT.

CHAPTER II (contd.)

4 Description (contd.)

paragraphs 4.9 to 4.11 (contd.)

GB (contd):

4.11 Two instances where there is a fundamental insufficiency in the application, and thus a failure to satisfy the requirements of Article 83, deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are unrepeatable or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a breeding process in the field of microbiology. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures - as can arise, e.g. in the manufacture of small magnetic cores or electronic components; in this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection necessarily arises under Article ~~83~~ 5. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws - this applies e.g. to a perpetual motion machine. ~~If the claims for such a machine are directed to its function, and not merely to its~~ structure, an objection arises not only under ~~Article~~ 83 but also under Article 52, ~~paragraph 1, that~~ the invention is not "*susceptible of ~~industrial application~~*" ~~(see IV, 4.1).~~

paragraphs 4.12 and 4.13

US:

5.1(a)(vi) Rule ~~27(1)(c)~~ ~~Art 52(1)~~ ~~Art 57~~

Industrial Applicability.

4.12 The description should indicate explicitly the way in which the invention is "*capable of exploitation in industry*", if this is not obvious from the description or from the nature of the invention. The expression "*capable of exploitation in industry*" means the same as "*susceptible of industrial application*", ~~and indeed identical expressions are used in the French and German texts of the Convention. In view of the broad meaning given to the latter expression by Article 57 (see IV, 4.1),~~ it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must be made so.

5.1(b) Rule ~~27(2)~~ 5.1(b) and Section 205 5.1(a) 5.1(a)(iii)

4.13 The manner and order of presentation of the various parts of the description should be that specified in Rule ~~27, paragraph 1~~, i.e. as set out above, "*unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation*". Since the responsibility for clearly and completely describing the invention lies with the applicant, the examiner should exercise his discretion as to whether to object to the presentation. Some departure from the requirements of Rule ~~27, paragraph 1~~ is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of Rule ~~27, paragraph 1(a)~~, may be waived where the invention is based on a fortuitous discovery, the practial application of which is recognised as being useful, or where the invention breaks entirely new ground. Also, certain technically simple inventions may be fully comprehensible with the minimum of description and but slight reference to prior art.

CHAPTER II (contd.)

4 Description (contd.)

paragraphs 4.12 and 4.13 (contd.)

SU : No comments

GB :

Rule 27(1)(g)
Art 52(1)
Art 57
Redraft with reference to Rule 5.1(a)(vi)

**4.12 The description should indicate explicitly the way in which the invention is "*capable of exploitation in industry*", if this is not obvious from the description or from the nature of the invention. The expression "*capable of exploitation in industry*" means the same as "*susceptible of industrial application*", and indeed identical expressions are used in the French and German texts of the Convention. In view of the broad meaning given to the latter expression by Article 57 (see IV, 4.1), it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must be made so.**

5.1(b)
Rule ~~27(3)~~
5.1(a)
5.1(a)
5.1(a)(iii)

**4.13 The manner and order of presentation of the description should be** that specified in Rule ~~27, paragraph 1~~, i.e. as set out above, "*unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation*". Since the responsibility for clearly and completely describing the invention lies with the applicant, the examiner should exercise his discretion as to whether to object to the presentation. Some departure from the requirements of Rule ~~27, paragraph 1~~, is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of Rule ~~27, paragraph 1(d)~~, may be waived where the invention is based on a fortuitous discovery, the practial application of which is recognised as being useful, or where the invention breaks entirely new ground. Also, certain technically simple inventions may be fully comprehensible with the minimum of description and but slight reference to prior art.

paragraphs 4.14 and 4.15

US :

~~Rule 35(13)~~

4.14 Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little known or especially formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.

CHAPTER II (contd.)

4 Description (contd.)

paragraphs 4.14 and 4.15 (contd.)

US (contd):

10.1(e)
Rule ~~35(12)~~

4.15 When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published Standard (e.g. a Standard of sieve sizes), and such Standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the specification. The metric system of units of weights and measures must be used or, if another system is used, the units must also be expressed in the metric system. Similarly, temperature must be expressed at least in degrees Celsius or, in cryogenics, in degrees Kelvin. Other physical values (i.e. other than those having units directly derivable from length, mass, time and temperature) must be expressed in the units recognised in international practice; e.g. for electric units the MKSA system should be used. Chemical and mathematical symbols, atomic weights and molecular formulae should be those in general use and technical terms, signs and symbols should be those "*generally accepted in the field in question*". In particular, if there are any agreed International Standards in the art in question, these should be adopted wherever practicable.

art

SU: No comments

GB:

There should be a reference to Rule 5.1(c) and Admin. Instructions Section 205 somewhere.

4.14 Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little known or especially formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.

Rule 35(13)

4.15 When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published Standard (e.g. a Standard of sieve sizes), and such Standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the specification. The metric system of units of weights and measures must be used or, if another system is used, the units must also be expressed in the metric system. Similarly, temperature must be expressed at least in degrees Celsius or, in cryogenics, in degrees Kelvin. Other physical values (i.e. other than those having units directly derivable from length, mass, time and temperature) must be expressed in the units recognised in international practice; e.g. for electric units the MKSA system should be used. Chemical and mathematical symbols, atomic weights and molecular formulae should be those in general use and technical terms, signs and symbols should be those "*generally accepted in the field in question*". In particular, if there are any agreed International Standards in the art in question, these should be adopted wherever practicable.

Rule 35(12)

Rule 10

CHAPTER II (contd.)

4 Description (contd.)

paragraphs 4.16 and 4.17

US :

4.16 The use of proper names or similar words to refer to materials or articles is undesirable since such words are an indication of origin and may relate to a range of different products. If such a word is used, then in order to satisfy the requirements of Article ~~83~~, the product must normally be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the skilled person. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden" cable, "Bellville" washer, "Panhard" rod) they may be allowed without further identification of the product to which they relate.

4.17 If the examiner has reason to suspect that a word used in the description is a registered trade mark, at least in certain States, he should ask the applicant either to acknowledge the word as such or to state that, so far as he is aware, the word is not a registered trade mark. If, on the other hand, an applicant states that a word is a registered trade mark in ~~a~~ certain ~~or~~ States and the examiner happens to know that this statement is incorrect, he should ask the applicant to amend accordingly.

SU : No comments

GB : No comments

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10 → paragraph 4.18

US :

4.18 References to previously published material including patent applications and specifications of granted patents, textbooks and periodicals, are allowable and often desirable (see II, 4.4 above). A reference to an unpublished document, including an unpublished ~~European or other~~ patent application, should not be regarded as adding anything to the content of the disclosure ~~unless publication of the document referred to occurs on or before the date of publication under Article 93 of the application containing the reference.~~ In the case of any document published on or before ~~that~~ date, there can be no objection ~~under Article 123, paragraph 2,~~ to the reference being supplemented or replaced by an indication of the subject-matter contained in the document. In the case of any document published later, or not published at all (including ~~European~~ applications ~~withdrawn before publication~~), the examiner should require the reference to be deleted as being irrelevant.

filed after the priority date

the priority

filed after the priority date

SU : No comments

GB :

4.18 **References to previously published material including patent applications and specifications of granted patents, textbooks and periodicals, are allowable and often desirable (see II, 4.4 above). A reference to an unpublished document, including an unpublished European or other patent application, should not be regarded as adding anything to the content of the disclosure unless publication of the document referred to occurs on or before the date of publication ~~under Article 93~~ of the application containing the reference. ~~In the case of any document~~ published on or before that date, there can be no objection under Article 123, paragraph 2, to the reference being supplemented or replaced by an indication of the subject-matter contained in the document. In the case of any document published later, or not published at all (including European applications withdrawn before publication), the examiner should ~~require the reference to be deleted as being irrelevant~~.**

international

not appropriate

CHAPTER II (contd.)

5 Drawings

US: Rule 7 ~~32~~ 11.10-11.13 ~~Rule 32 (2)(j)~~

5.1 The requirements relating to the form and content of drawings are set down in Rule ~~32~~ 7. Most of these are formal (see Guidelines for formalities examination) but the examiner may sometimes need to consider the requirements of Rule ~~32, paragraph 2(f), (h), (i) and (j)~~ 7. Of these, the only question likely to cause difficulty is whether the textual matter included on the drawings is absolutely indispensable. In the case of circuit diagrams, block schematics and flow sheets, identifying catchwords for functional integers of complex systems (e.g. "magnetic core store", "speed integrator") may be regarded as indispensable from a practical point of view if they are necessary to enable a diagram to be interpreted rapidly and clearly.

SU: No comments

GB: Rule 32 Refer to Rule 11.11 and 11.13 Rule 32 (2)(j)

5.1 **The requirements relating to the form and content of drawings are set down in Rule 32. Most of these are formal (~~see Guidelines for formalities examination~~) but the examiner may sometimes need to consider the requirements of Rule 32, paragraph 2(f), (h), (i) and (j). Of these, the only question likely to cause difficulty is whether the textual matter included on the drawings is absolutely indispensable. In the case of circuit diagrams, block schematics and flow sheets, identifying catchwords for functional integers of complex systems (e.g. "magnetic core store", "speed integrator") may be regarded as indispensable from a practical point of view if they are necessary to enable a diagram to be interpreted rapidly and clearly.**

11 → 6 Inventions relating to micro-organisms

US: ~~Rule 28~~ ~~Rule 28(1)(a)~~ 5

6.1 Applications relating to micro-organisms are subject to ~~the~~ special provisions ~~set out in Rule 28~~. If an invention concerns a micro-biological process or the product thereof and involves the use of a micro-organism which is not available to the public, the disclosure is not considered to have satisfied the requirements of Article ~~83~~ unless the ~~requirements of Rule 28, paragraphs 1 and 2, first sentence, have been met~~ micro-organism has been deposited in a culture collection not later than the date of filing of the application.

6.2 The examiner must form an opinion as to whether or not the micro-organism is available to the public. There are several possibilities. The applicant may have given sufficient information as to the identifying characteristics of the micro-organism and as to the prior availability in a recognised culture collection to satisfy the examiner. Alternatively the micro-organism may be known to be readily available to those skilled in the art, e.g. a micro-organism such as baker's yeast or *Bacillus natto* which is commercially available; or it may be a standard preserved strain, or other micro-organism which the examiner knows to have been preserved in a recognised depository and to be available to the public. In any of these cases no further action is called for. If however the applicant has given no information, or insufficient information, on public availability, and the micro-organism is a particular strain not falling within the known categories already mentioned, then the examiner must assume that the micro-organism is not available to the public.

CHAPTER II (contd.)

11 → 6 Inventions relating to micro-organisms (contd.)

US (contd):

6.3 If the micro-organism is not available to the public the examiner must check

~~Rule 28(1)(2)~~ (i) whether the application as filed gives relevant information on the characteristics of the micro-organism, and

(ii) whether the identity of the culture collection, the date of deposit in that collection and the file number of the deposit have been supplied not later than two months after filing.

Rule 86.5 ~~Rule 28(8)~~ Gazette of International Patent Applications: In addition, the culture collection which is identified must be one which the ~~Official Journal of the European Patent Office~~ has indicated will be recognised. If any of these requirements are not satisfied the application should be refused ~~under Article 97, paragraph 1, for failure to comply with the Convention~~.

SU: No comments

GB: Not applicable, delete paragraphs 6.1 to 6.3

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7 Prohibited matter

US:

~~Rule 34~~ 9.1 7.1 There are four ~~three~~ categories of specifically prohibited matter, these being defined in ~~paragraphs (a) to (c) of Rule~~ 34, ~~paragraph 1~~ (see also IV, 3). ~~It should be noted that the omission, from the publication of the application, of the first category only is mandatory.~~ ~~Rule 34(1)(a)~~ Examples of the first and second categories the kind of matter coming within ~~this category~~ are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter.

third ~~Rule 34(1)(b)~~ 7.2 It is necessary to discriminate in the ~~second~~ category, between libellous or similarly disparaging statements, which are not allowed, and fair comment, e.g. in relation to obvious or generally recognised disadvantages, or disadvantages stated to have been found by the applicant, which, if relevant, is permitted.

Rule 9.3(iv) fourth ~~Rule 34(1)(c)~~ 7.3 The ~~third~~ category is irrelevant matter. It should be noted however that such matter is specifically prohibited under the Rule only if it is *"obviously irrelevant or unnecessary"*, for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art.

Rule 9.1 Office 7.4 Generally the Receiving ~~Section~~ will deal with matter falling under ~~category 1(a), and may have dealt with matter obviously falling within category 1(b), but~~ if any such matter has not been so recognised ~~and has therefore not been omitted from the publication of the application~~, it should be required to be removed during preliminary examination of the application together with any other prohibited matter. The applicant should be informed of the category under which the prohibited matter is ~~required~~ to be removed.

(comments from SU and GB on the following page)

CHAPTER II (contd.)

7 Prohibited matter (contd.)

SU: No comments

GB:

Article 21(6)
Rule ~~34~~ 9

7.1 There are four ~~three~~ categories of specifically prohibited matter, these being defined in paragraphs (a) to (c) of Rule 9.1 ~~34, paragraph 1~~ (see also IV, 3). It should be noted that the omission, from the publication of the application, of the first and second ~~category~~ only is mandatory. Examples of the kind of matter coming within this category are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter.

Rule ~~34(1)(a)~~ 9.1(i) and (ii)

9.1(iii)
Rule ~~34(1)(b)~~

7.2 It is necessary to discriminate in the second category, between libellous or similarly disparaging statements, which are not allowed, and fair comment, e.g. in relation to obvious or generally recognised disadvantages, or disadvantages stated to have been found by the applicant, which, if relevant, is permitted.

9.1(iv)
Rule ~~34(1)(c)~~

7.3 The third category is irrelevant matter. It should be noted however that such matter is specifically prohibited under the Rule only if it is *"obviously irrelevant or unnecessary"*, for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art.

Redraft in terms of Rule 9.2

7.4 Generally the Receiving Office or ISA ~~Section~~ will deal with matter falling under category 1(a), and may have dealt with matter obviously falling within category 1(b), but if any such matter has not been so recognised and has therefore not been omitted from the publication of the application, it should be required to be removed during examination of the application together with any other prohibited matter. The applicant should be informed of the category under which matter is required to be removed.

CHAPTER III

THE CLAIMS

1 General

paragraphs 1.1 and 1.2

US:

1 General

Art 3(2) ~~78(1)(c)~~ 6 1.1 The application must contain "one or more claims".

Art ~~84~~ 6 1.2 These must:

(i) "define the matter for which protection is sought";

(ii) "be clear and concise";

(iii) "be fully supported by the description".

SU: No comments

GB:

1 General

Art 3(2) ~~78(1)(c)~~ 1.1 The application must contain "one or more claims".

Art ~~84~~ 6 1.2 These must:

(i) "define the matter for which protection is sought";

(ii) "be clear and concise";

(iii) "be fully supported by the description".

12

paragraph 1.3

US:

~~Art 69(1)~~ 1.3 Since the terms of the claims determine the extent of the protection conferred by a ~~European~~ patent or application, clarity of claim is of the utmost importance. The claims do not, however, stand in isolation and are not to be interpreted in a strictly literal sense. ~~For a full understanding of how claims should be interpreted it is necessary to refer to the Protocol on the Interpretation of Article 69~~ (see also III, 4).

SU: 13. For successful international examination the clarity of the claims is of the utmost importance in view of their function in defining the scope of the protection sought by the applicant. The requirements to the claims of an international application are provided for in Rule 6 of the Regulations to the PCT. They are closely connected with the requirements of unity of invention (see PCT Rule 13).

GB:

Not applicable

~~Art 69(1) 1.3 Since the terms of the claims determine the extent of the protection~~ conferred by a European patent or application, clarity of ~~claim~~ is of the utmost importance. The claims do not, ~~however,~~ stand in isolation and are not to be interpreted ~~in a strictly~~ literal sense. For a full understanding of ~~how~~ claims should be interpreted it is necessary to ~~refer to the Protocol on the Interpretation of Article 69 (see also III, 4).~~

CHAPTER III (contd.)

2 Form and context of claims

paragraphs 2.1 and 2.2

US :

6.3 Rule ~~29(1)~~

2.1 The claims must be drafted in terms of the "*technical features of the invention*". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose may be allowable if they assist in defining the invention. Claims to the use of the invention in the sense of the technical application thereof are allowable.

6.3(b) Rule ~~29(1)~~ ~~Rule 29(1)(a)~~ 6.3 Rule ~~29~~, paragraph ~~1(a) and~~ (b), defines the two-part form which a claim should adopt "~~wherever~~ *appropriate*". The first part should contain a "statement indicating ~~"the designation of the subject-matter of the invention" i.e. the general technical class of apparatus, process, etc.,~~ to which the invention relates, followed by a statement of *those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art*". It is clear from this wording that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder. The second part or "*characterising portion*" should state the "*technical features which, in combination with the features stated in ~~sub-paragraph 1(a)~~* (the first part), *it is desired to protect*" i.e. the features which the invention adds to the prior art. If the search report reveals that any feature in the second part of the claim was, in fact, already known in combination with all the features in the first part of the claim, the examiner should require that feature to be transferred to the first part.

whenever

under (i)

SU : No comments

GB :

6.3 Rule ~~29(1)~~

2.1 The claims must be drafted in terms of the "*technical features of the invention*". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose may be allowable if they assist in defining the invention. Claims to the use of the invention in the sense of the technical application thereof are allowable.

6.3(b) Rule ~~29(1)~~ ~~Rule 29(1)(a)~~ 6.3 Rule ~~29, paragraph 1(a) and~~ (b), defines the two-part form which a claim should adopt "*whenever appropriate*". The first part should contain a statement indicating "*the designation of the subject-matter of the invention*" i.e. the general technical class of apparatus, process, etc., to which the invention relates, followed by a statement of "*those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art*". It is clear from this wording that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder. The second part or "*characterising portion*" should state the "*technical features which, in combination with the features stated in sub-paragraph (a)* (the first part), *it is desired to protect*" i.e. the features which the invention adds to the prior art. If the search report reveals that any feature in the second part of the claim was, in fact, already known in combination with all the features in the first part of the claim, the examiner should require that feature to be transferred to the first part.

Refer also to Rule 6.3(c) and Admin. Instructions, Section 206 →

CHAPTER III (contd.)

13 → 2 Form and context of claims (contd.)

paragraph 2.3

US:

2.3 The applicant should be required to follow the above two-part formulation where, for example, it is clear that his invention resides in a distinct improvement in an old combination of parts or steps. However, as is indicated by Rule 6 ~~29~~, this form need be used only in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture of the invention or the prior art. Examples of the kind of invention which may require a different presentation are:

(i) the combination of known integers of equal status, the inventive step lying solely in the combination;

(ii) the modification of, as distinct from addition to, a known chemical process e.g. by the substitution of one substance for another; and

(iii) a complex system of functionally inter-related parts, the inventive step concerning changes in several of these parts or in their inter-relationships.

In examples (i) and (ii) the Rule ~~29~~ form of claim may be artificial and inappropriate, ~~whilst~~ in example (iii) it might lead to an inordinately lengthy and involved claim. Another example in which the Rule ~~29~~ form of claim may sometimes be inappropriate is where the invention is a new chemical compound or group of compounds which constitutes a new departure and does not fall within a known class. It is likely also that other cases will arise in which the applicant is able to adduce convincing reasons for formulating the claim in a different form.

6.3(b) whereas 6.3(b)

SU: No comments

GB: Delete paragraph 2.3, not applicable in view of Rule 6.3

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3 Kinds of claim

Categories

paragraph 3.1

US:

3 *Kinds of claim*

Categories

3.1 The ~~Convention~~ Treaty refers to different "*categories*" of claim ("*product, process, apparatus or use*"). However, the main purpose of this classification is to provide a convenient way of indicating in Rule 13 specific combinations permitted ~~under Article 82~~ (see III, 7.2). In fact, there are only two basic kinds of claim, viz, claims to a physical entity (product, apparatus) and claims to an activity (process, use). It should be noted that claims which are worded differently may, in reality, fall within the same category and have effectively the same scope. For example, a claim referring to a "system" and a claim referring to

CHAPTER III (contd.)

3 Kinds of claim (contd.)

Categories (contd.)

paragraph 3.1 (contd.)

US (contd): ~~Art 64(2)~~ "apparatus" may both be in the "apparatus" category. ~~It should be noted that having regard to the provision in Article 64, paragraph 2, that, if the subject-matter of a European patent is a process, the protection conferred shall extend to products directly obtained by the process, claims in different categories, i.e. a process and a product claim may also have similar scope. However,~~ An examiner ~~should not adopt an over academic or rigid approach to the presence of a number of claims which are differently worded in this way. He~~ should bear in mind that the presence of such different claims may assist an applicant in obtaining full protection for his invention in all the designated countries, ~~since regard to the fact that~~ infringement of a ~~European~~ patent is dealt with by national law.

SU: Rule 13.3 PCT — 14. The Regulations to the PCT define various categories of claims (i.e. product, process, apparatus or use). It should be noted that claims of one and the same category may contain different terms. For example the category "apparatus" may include claims defining a system, structure, mechanism or their parts, etc. The category "process" covers processes, subsequence of technological operations, etc. The term "product" is not to be interpreted as limited to a substance or composition. It should be construed liberally as including any physical entity which can be manufactured, e.g. "woven garment". Often one and the same invention can be regarded simultaneously as "apparatus" and "product", or as "apparatus" and "use", etc.

GB: Redraft paragraph 3.1 in terms of Rule 13.2 where the categories are stated differently from EPC Rule 30

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paragraph 3.2

US: Rule ~~29(2)~~ 13.3 — 3.2 Subject to the conditions for unity of invention being satisfied (see III, 7), Rule ~~29, paragraph 2,~~ states that an application may contain two or more independent claims in the same category *where it is not appropriate, having regard to the subject-matter of the application, to cover this subject-matter by a single claim*. This means that, while generic the examiner should not allow an unnecessary proliferation of independent claims, he may allow two or more independent claims in the same category in appropriate cases provided that there is a unifying inventive concept and that the claims as a whole satisfy the requirement of Article 6 that they should be "concise" (see III, 5.1). In applying this principle the examiner should have regard to the remarks made in III, 3.1 concerning claims of apparently similar scope. However, there are other circumstances where it may not be appropriate to cover the subject-matter of an invention by a single independent claim in a particular category; ~~for example,~~ (1) where the invention relates to an improvement in two separate but inter-related articles which may be sold separately, such as an electric plug and socket or transmitter and receiver; ~~As another example, for~~ (2) where is an invention concerned with electrical bridge-rectifier circuits it might be necessary to include separate independent claims to a single-phase and poly-phase arrangements incorporating such circuits since the number of circuits needed per phase is different in the two arrangements; ~~A further instance is~~ and (3) where a known substance is disclosed for a number of distinct medical uses (see IV, 4.2).

(comments from SU and GB on the following page)

CHAPTER III (contd.)

3 Kinds of claim (contd.)

Categories (contd.)

paragraph 3.2 (contd.)

SU:

Rule 13.3 PCT

15. Providing for the requirements of unity of invention, PCT Rule 13 permits that an international application may include two or more independent claims of the same category which cannot readily be covered by a single generic claim. It is permitted to include in the same international application claims of different categories provided that they are limited according to PCT Rule 13.2, and in addition to an independent claim of one category it is permitted to include in an international application a limited number of claims of different category. Further, it is permitted to include a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention (see PCT Rule 13.4).

16. Thus, according to the PCT claims may be divided into independent and dependent claims, and independent claims in their turn are subdivided into main claims and claims in addition to an independent claim.

GB:

Rule 29(2)

Redraft in terms of Rule 13.3

3.2 Subject to the conditions for unity of invention being satisfied (see III, 7), Rule 29, paragraph 2, states that an application may contain two or more independent claims in the same category "*where it is not appropriate, having regard to the subject-matter of the application, to cover this subject-matter by a single claim*". This means that, while the examiner should not allow an unnecessary proliferation of independent claims, he may allow two or more independent claims in the same category in appropriate cases provided that there is a unifying inventive concept and that the claims as a whole satisfy the requirement of Article 84 that they should be concise (see III, 5.1). In applying this principle the examiner should have regard to the remarks made in III, 3.1 concerning claims of apparently similar scope. However, there are other circumstances where it may not be appropriate to cover the subject-matter of an invention by a single independent claim in a particular category, for example, where the invention relates to an improvement in two separate but inter-related articles which may be sold separately, such as an electric plug and socket or transmitter and receiver. As another example, for an invention concerned with electrical bridge-rectifier circuits it might be necessary to include separate independent claims to a single-phase and poly-phase arrangements incorporating such circuits since the number of circuits needed per phase is different in the two arrangements. A further instance is where a known substance is disclosed for a number of distinct medical uses (see IV, 4.2).

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Independent and dependent claims

paragraph 3.3

US:

13.4 Rule [illegible]

specific forms

specific form

specific forms

Independent and dependent claims

3.3 All applications will contain one or more "*independent*" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "[illegible]" of that invention. It is evident that any claim relating to a [illegible] must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "[illegible]" should be construed broadly as meaning any more specific disclosure of the invention than that set out in the main claim or claims.

(comments from SU and GB on the following page)

CHAPTER III (contd.)

3 Kinds of claim (contd.)

Independent and dependent claims (contd.)

paragraph 3.3 (contd.)

SU: No comments

GB: Rule 13.4 ~~Rule 29(3)~~ Redraft in terms of Rule 13.4 →

3.3 **All applications will contain one or more "*independent*" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "*particular embodiments*" of that invention. It is evident that any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "*particular embodiment*" should be construed broadly as meaning any more specific disclosure of the invention than that set out in the main claim or claims.**

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paragraph 3.4

US: Rule 6.4(a) ~~Rule 29(4)~~

3.4 *Any claim which includes all the features of any other claim* is termed a "*dependent claim*". Such a claim must *contain, if possible at the beginning, a reference to the other claim*, all of whose features it includes. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

SU: 17. It is important for the purposes of the international preliminary examination that any dependent claim should be construed as including all the limitations contained in the claim to which it refers. Any dependent claim which refers to more than one other claim, refers to them only alternatively. Multiple dependent claims should not form a basis for other multiple dependent claims. A multiple dependent claim includes all the limitations contained in the particular claim in relation to which it is considered.

GB: Rule 6.4(a) and (b) ~~Rule 29(4)~~ Redraft in terms of Rule 6.4(a) and (b) and metric requirement of "multiple dependent claims" - Rule 6.4(a) →

3.4 **"*Any claim which includes all the features of any other claim*" is termed a "*dependent claim*". Such a claim must "*contain, if possible at the beginning, a reference to the other claim*", all of whose features it includes. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.**

CHAPTER III (contd.)

3 Kinds of claim (contd.)

Independent and dependent claims (contd.)

paragraph 3.5

US: Rule ~~29(4)~~ 6.4(c) shall practical

3.5 All dependent claims, however referred back, "~~must~~ be grouped together to the extent and in the most ~~appropriate~~ way possible". The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should object if the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected.

SU: No comments

GB: Rule ~~29(4)~~ 6.4(2)

3.5 All dependent claims, however referred back, "*must be grouped together to the extent and in the most appropriate way possible*". The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should object if the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected.

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paragraph 3.6

US: 3.6 A claim, whether independent or dependent, can refer to alternatives provided those alternatives are of a similar nature and can fairly be substituted one for another and provided also that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe (see also III, 7.5).

( Add an additional section on the matter of multiple dependent claims being expressed in alternative form only and not being able to serve as a basis for any other multiple dependent claim.)

SU: 17. It is important for the purposes of the international preliminary examination that any dependent claim should be construed as including all the limitations contained in the claim to which it refers. Any dependent claim which refers to more than one other claim, refers to them only alternatively. Multiple dependent claims should not form a basis for other multiple dependent claims. A multiple dependent claim includes all the limitations contained in the particular claim in relation to which it is considered.

GB: No comments

CHAPTER III (contd.)

4 Clarity and interpretation of claims

paragraph 4.1

US: Art 6 ~~84~~ ~~Art 69(1)~~

4.1 The requirement that the claims shall be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the scope of the protection afforded by the patent when granted.

SU: No comments

GB: No comments

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paragraph 4.2

US:

4.2 Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. However it should also be read with an attempt to make technical sense out of it. Such a reading may involve a departure from the strict literal meaning of the wording of the claims ~~(see Protocol on the Interpretation of Article 69)~~.

SU:

III, 4.2 EPO 18. The examiner should be quite sure of the clarity and unambiguity of the claims. Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise.

GB:

4.2 Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. However it should also be read with an attempt to make technical sense out of it. ~~Such a reading may involve a departure from the strict literal meaning of the wording of the claims (see Protocol on the Interpretation of Article 69)~~.

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14 → paragraph 4.3

US:

4.3 Where there is any serious inconsistency between claims and description, amendments to remove this should be required. For example, the description may state, or ~~may~~ imply, that a certain technical feature not mentioned in the claims is essential to the performance of the invention. In such a case, the examiner should require the claims to be amended to include this feature, unless the applicant can show convincingly that it would be clear to a person skilled in the art that the description was incorrect in suggesting that the feature in question was essential, in which case amendment of the description should be required instead. Another form of inconsistency is that in which the description and drawings include one or more embodiments of the invention which appear to fall outside the subject-matter covered by the claims (e.g. the claims all specify an electric circuit employing electronic tubes and one of the embodiments employs semi-conductors as an alternative). Here again either amendment of the claims or of the description and drawings is required, to remove the inconsistency and thus avoid any possible uncertainty which could arise later as to the meaning of the claims. However, the examiner should not pursue objections of this kind unnecessarily. Inconsistencies which do not cause doubt as to the meaning of the claims may be overlooked.

(comments from SU and GB on the following page)

CHAPTER III (contd.)

4 Clarity and interpretation of claims (contd.)

paragraph 4.3 (contd.)

SU :

III, 4.3 EPO

19. Where there is any serious inconsistency between claims and description, amendments to remove this should be required. For example, the description may state, or may imply, that a certain technical feature not mentioned in the claims is essential to the performance of the invention. In such a case, the examiner should require the claims to be amended to include this feature in the claims or exclude it from the description. Therefore, the examiner is eager to reach clarity in the interpretation of the claims and remove inconsistency between claims and description, in order to avoid wrong and incomplete results of the international preliminary examination.

GB :

IPEA cannot 'require' anything

4.3 Where there is any serious inconsistency between claims and description, amendments to remove this should be required. For example, the description may state, or may imply, that a certain technical feature not mentioned in the claims is essential to the performance of the invention. In such a case, the examiner should require the claims to be amended to include this feature, unless the applicant can show convincingly that it would be clear to a person skilled in the art that the description was incorrect in suggesting that the feature in question was essential, in which case amendment of the description should be required instead. Another form of inconsistency is that in which the description and drawings include one or more embodiments of the invention which appear to fall outside the subject-matter covered by the claims (e.g. the claims all specify an electric circuit employing electronic tubes and one of the embodiments employs semi-conductors as an alternative). Here again either amendment of the claims or of the description and drawings is required, to remove theinconsistency and thus avoid any possible uncertainty which could arise later as to the meaning of the claims. However, ~~the examiner should not pursue objections of this kind unnecessarily.~~ Inconsistencies which do not cause doubt as to the meaning of the claims may be overlooked.

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paragraph 4.4

US :

4.4 An independent claim should specify clearly all of the essential features needed to define the invention except in so far as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of wheels. If a claim is to a process for producing the product of the invention, then the process as claimed should be one which necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim. In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in certain respects, it is sufficient if the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for apparatus.

SU : No comments

GB : No comments

CHAPTER III (contd.)

4 Clarity and interpretation of claims (contd.)

paragraph 4.5

US: 4.5 A claim should not include vague or equivocal forms of wording which leave the reader in doubt as to the exact scope of a feature. Examples of this are relative terms such as "thin", "wide", "strong". If such terms appear in a claim it is usually necessary to have them either defined or excised. No objection arises, however, if the relative term has a precise meaning in the art, e.g. "high-frequency amplifier" and this is the meaning intended. The use of trade marks and similar expressions in claims should not be allowed unless their use is unavoidable; they may be allowed exceptionally if they are generally recognised as having a precise meaning (see also II, 4.16).

SU: No comments

GB: request that they be 4.5 A claim should not include vague or equivocal forms of wording which leave the reader in doubt as to the exact scope of a feature. Examples of this are relative terms such as "thin", "wide", "strong". If such terms appear in a claim it is usually necessary to ~~have them~~ either defined or excised. No objection arises, however, if the relative term has a precise meaning in the art, e.g. "high-frequency amplifier" and this is the meaning intended. The use of trade marks and similar expressions in claims should not be allowed unless their use is unavoidable; they may be allowed exceptionally if they are generally recognised as having a precise meaning (see also II, 4.16).

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paragraph 4.6

US: 4.6 Expressions, like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. The examiner should regard expressions of this kind as having no limiting effect on the scope of a claim; that is to say, the feature following any such expression should be regarded as entirely optional.

SU: III, 4.6 EPO 20. A claim should not include vague or equivocal forms of wording which leave the reader in doubt as to the exact scope of a feature. Examples of this are relative terms such as "wide", "strong", etc. It is necessary to have such terms either defined or excised.

GB: No comments

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paragraph 4.7

US: 4.7 Claims which attempt to define the invention, or a feature thereof, by a result to be achieved should not be allowed unless the invention cannot be clearly defined in a more direct way and the result is one which can be directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error.

(comments from SU and GB on the following page)

CHAPTER III (contd.)

4 Clarity and interpretation of claims (contd.)

paragraph 4.7 (contd.)

SU: III, 4.7 EPO — 21. Claims which attempt to define the invention, or a feature thereof, by a result to be achieved should not be allowed. Claims should disclose a means to achieve this or that result or objective of the invention. The examiner however should not pursue the claims when they include technical features relating to the results and objectives of the invention if it helps to define the subject matter.

GB: No comments

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paragraphs 4.8 to 4.10

US:

4.8 If a claim commences with such words as: "Apparatus for carrying out the process etc ..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possessed all of the features specified in the claim, but which would be unsuitable for the stated purpose, or which would require modification to enable it to be so used, should not normally be considered as coming within the scope of the claim. Similar considerations apply to a claim for a product for a particular use. For example if a claim refers to "A hook for a crane" this implies e.g. particular dimensions and strength in the hook. Therefore a fish-hook could never come within the claim, but a hook having the necessary dimensions and strength and possessing all the other features specified in the claim would deprive the claim of novelty whether it was stated to be for use in a crane or not. Similarly, a claim to a substance or composition for a particular use should be construed as relating to the substance or composition *per se* provided that it is not in a form which would render it unsuitable for the stated use. An exception to this general principle of interpretation is where the claim is to a known substance or composition for use in a surgical, therapeutical or diagnostic method (see IV, 4.2).

4.9 For the purposes of examination, a "*use*" claim of a form such as "the use of substance X as an insecticide" should be regarded as equivalent to a "*process*" claim of the form "a process of killing insects using substance X".

6.2(a) Rule ~~29(6)~~

4.10 The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "*except where absolutely necessary*". In particular they must not normally rely on such references as: "as described in part ... of the description", or "as illustrated in Figure 2 of the drawings". The emphatic wording of the excepting clause should be noted. The onus is upon the applicant to show that it is "*absolutely necessary*" to rely on reference to the description or drawings in appropriate cases. An example of an allowable exception would be that in which the invention involved some peculiar shape, illustrated in the drawings, but which could not be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products whose features can be defined only by means of graphs or diagrams.

SU: No comments

GB: No comments

CHAPTER III (contd.)

4 Clarity and interpretation of claims (contd.)

paragraph 4.11

US:

6.2(b)
Rule ~~29(7)~~

4.11 ~~However, the use of references in the claims to features of the drawings is not prohibited. On the contrary,~~ If there are drawings, and the technical features of the claims would be rendered more intelligible by relating these features to the corresponding features of the drawings (e.g. where a complete machine has been illustrated), ~~then~~ this should preferably be done by placing the appropriate reference signs in parentheses after the features in the claims. This should be done in both parts of claims having the preferred form specified in Rule ~~29,~~ ~~paragraph 1.~~ 6.3 These reference signs are not, however, to be construed as limiting the scope of a claim, but merely as aids to an easier understanding of the defined subject-matter.

SU:

Rule 6.2 PCT III, 4.11 EPO

22. Claims should not rely on general references to the description or drawing. Such phrases as "as described in part....of the description", or "as illustrated in figure....of the drawings" are not allowed. However, it is preferable that the technical features of the claims were accompanied by the corresponding reference signs of the drawings. These reference signs should be placed in parantheses. But where they preclude the claims from understanding or make the claims very long, they should not be allowed.

GB: No comments

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5 Conciseness, number of claims

US:

6
Art ~~84~~
~~Rule 29(4)~~

5.1. The requirement that the claims shall be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be reasonable when considered in relation to the nature of the invention claimed, and undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the ~~i~~independent form. Regarding independent claims in the same category see III, 3.2. ~~If there are more than ten claims, either at the time of filing or subsequently, a claim fee is required.~~

SU:

III, 5.1 EPO

23. The requirement that the claims should be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be reasonable when considered in relation to the nature of the invention claimed. Undue repetition of wording, etc. between one claim and another, should be avoided.

GB:

Art 84
Rule 29(5)

5.1. The requirement that the claims shall be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be reasonable when considered in relation to the nature of the invention claimed, and undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the independent form. Regarding independent claims in the same category see III, 3.2. ~~If there are more than ten claims, either at the time of filing or subsequently, a claim fee is required~~.

CHAPTER III (contd.)

6 Support in description

paragraph 6.1

US: Art 6 84

6.1 The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description.

SU: No comments

GB: Art 84

6 *Support in description*

6.1 The claims must fully be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by ~~the extent of~~ the description.

---

paragraph 6.2

US: An appropriate

6.2 Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. ~~A fair statement of~~ claim is one which is not so broad that the claims cover more than has been invented; nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention.

SU: No comments

GB: No comments

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paragraph 6.3

US: fully 6

6.3 When claims are speculative, in that their scope extends beyond the description to embrace possibilities not yet explored by the applicant, the effects of which cannot readily be predetermined or assessed, the examiner should object that such claims are not supported by the description as required by Article 84. For example, a broad claim for "a process for influencing substances by high-frequency electrical energy" may not be adequately supported by the disclosure of a single example of such an influence (e.g. removing dust from a gas) nor of influences on a single substance. Likewise a broad claim for a process for treating "plant seedlings" by subjecting them to a controlled cold shock of such duration and intensity that specified results would follow, may not be supported by a description disclosing the process applied to one kind of plant only. Such a claim might be permissible if it were made clear in the description that the conditions set forth in relation to that plant applied to other plants generally; but otherwise the claim would not be regarded as adequately supported unless the description gave a sufficient range of examples, relating to different kinds of plants, to enable a horticulturist to deduce how the process should be applied to virtually any plant.

(comments from SU and GB on the following page)

CHAPTER III (contd.)

6 Support in description (contd.)

paragraph 6.3 (contd.)

SU:

III, 6.3 EPO

24. When claims are speculative, in that their scope extends beyond the description to embrace possibilities not yet explored by the applicant, the effects of which cannot readily be predetermined or assessed, the examiner should object that such claims are not supported by the description, and this may lead to issuing the notification in accordance with Article 34(4)(a)(ii).

GB:

6.3 When claims are speculative, in that their scope extends beyond the description to embrace possibilities not yet explored by the applicant, the effects of which cannot readily be predetermined or assessed, the examiner should object that such claims are not fully supported by the description as required by Article 84. For example, a broad claim for "a process for influencing substances by high-frequency electrical energy" may not be adequately supported by the disclosure of a single example of such an influence (e.g. removing dust from a gas) nor of influences on a single substance. Likewise a broad claim for a process for treating "plant seedlings" by subjecting them to a controlled cold shock of such duration and intensity that specified results would follow, may not be supported by a description disclosing the process applied to one kind of plant only. Such a claim might be permissible if it were made clear in the description that the conditions set forth in relation to that plant applied to other plants generally; but otherwise the claim would not be regarded as adequately supported unless the description gave a sufficient range of examples, relating to different kinds of plants, to enable a horticulturist to deduce how the process should be applied to virtually any plant.

15 →

paragraph 6.4

US:

6.4 A claim in generic form, i.e. relating to a whole class e.g. of materials or machines, may be acceptable even if of broad scope, if there is fair support in the description, and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where there is doubt about this, i.e. where the information given appears insufficient to enable the skilled man to extend the teaching of the description to parts of the field claimed, but not explicitly described, by using routine methods of experimentation or analysis, the examiner should require the applicant to establish by evidence that the invention can in fact be readily applied, on the basis of the information given, over the whole field claimed or, failing this, to restrict the claim to accord with the description. An example of this might be a claim to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. If all of the examples described related to thermoplastic resins, and the method was such as to appear inappropriate to thermosetting resins, then restriction of the claims to thermoplastic resins might be necessary.

SU: No comments

(comments from GB on the following page)

CHAPTER III (contd.)

6 Support in description (contd.)

15 → paragraph 6.4 (contd.)

GB:

Not for IPEA to do.

6.4 A claim in generic form, i.e. relating to a whole class e.g. of materials or machines, may be acceptable even if of broad scope, if there is fair support in the description, and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where there is doubt about this, i.e. where the information given appears insufficient to enable the skilled man to extend the teaching of the description to parts of the field claimed, but not explicitly described, by using routine methods of experimentation or analysis, the examiner should require the applicant to establish by evidence that the invention can in fact be readily applied, on the basis of the information given, over the whole field claimed or, failing this, to restrict the claim to accord with the description. An example of this might be a claim to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. If all of the examples described related to thermoplastic resins, and the method was such as to appear inappropriate to thermosetting resins, then restriction of the claims to thermoplastic resins might be necessary.

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paragraph 6.5

US:

6.5 A claim may broadly define a feature in terms of its function, even where only one example of the feature has been given in the description, if the skilled reader would appreciate that other means could be used for the same function. For example, "terminal position detecting means" in a claim might be supported by a single example comprising a limit switch, it being obvious to the skilled person that e.g. a photo-electric cell or a strain guage could be used instead. In general, however, if the entire description is such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all means, of performing the function, then objection arises. Furthermore, it may not be sufficient if the description merely states in vague terms that other means may be adopted, if it is not reasonably clear what they might be or how they might be used.

SU: No comments

GB: No comments

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7 Unity of Invention

Independent claims

paragraph 7.1

US:

~~Art 82~~ International Rule 13.1

7.1 The ~~European~~ application must "*relate to one invention only or to a group of inventions so linked as to form a single general inventive concept*". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category (as in the examples given in III, 3.2), but the more usual case is a plurality of independent claims in different categories as permitted by Rule ~~30~~.

13.2

13.2 Rule ~~30~~

(comments from SU and GB on the following page)

CHAPTER III (contd.)

7 Unity of Invention (contd.)

Independent claims (contd.)

paragraph 7.1 (contd.)

SU: No comments

GB:

Art 82 7.1 The ~~European~~ International application must "*relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept*". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category (as in the examples given in III, 3.2), but the more usual case is a plurality of independent claims in different categories as permitted by Rule ~~30~~ 13.2.

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paragraphs 7.2 and 7.3

US:

7.2 A plurality of independent claims in different categories may constitute a group of inventions linked to form a single general inventive concept, the link being e.g. that between a product and the process which produces it; or between a process and an apparatus for carrying out the process. Rule ~~30~~ sets out ~~three~~ different specific combinations of claims in different categories and each of these combinations is permissible in any one application. ~~The wording of that Rule, however, indicates that there are only particular examples of permissible combinations and the reference to other combinations may be misleading.~~ While a single set of independent claims as above is always permissible, Rule ~~30~~ does not oblige an examiner to accept a plurality of such sets which could arise by combining the provisions of Rules ~~30 and 29, paragraph 2~~ (thus resulting in a set under Rule ~~30~~ based on each of a number of independent claims in the same category under Rule ~~29, paragraph 2~~ - see III, 3.2). The proliferation of claims arising out of a combined effect of this kind is likely to be objectionable both under ~~Article 82~~ (lack of unity) and under Article ~~84~~ (lack of conciseness) and should be allowed only exceptionally. For example, where in accordance with Rule ~~29, paragraph 2~~ independent claims are allowable for two related articles ~~such as a transmitter and receiver~~, it does not follow that, under Rule ~~30, sub-paragraph (a)~~, an applicant may be allowed to include also, in the one application, four additional independent claims: two for a process for the manufacture of the ~~transmitter and the receiver~~ respectively, and two for use of the ~~transmitter and receiver respectively~~.

7.3 It is essential that a common inventive concept links the claims in the various categories and in this connection the wording of Rule ~~30~~ should be carefully noted. The link between product and process in Rule ~~30, sub-paragraphs (a) and (c)~~ is that the latter must be "*specially adapted for the manufacture of*" the former (see III, 4.4). Similarly, in ~~Rule 30, sub-paragraphs (b) and (c)~~, the apparatus or means claimed must be "*specifically designed for*" carrying out the process.

SU: No comments

GB: Redraft paragraphs 7.2 and 7.3 in terms of Rule 13.2 which contains only two combinations (although the effect is the same as EPC Rule 30)

CHAPTER III (contd.)

7 Unity of Invention (contd.)

Independent claims (contd.)

paragraph 7.4

US: Rule 13.2 ~~30(a)(e)~~ 7.4 The term "*product*" is not to be interpreted as limited to a substance or composition (e.g. a chemical compound or a mixture of such compounds). It should be construed liberally as including any physical entity (article or apparatus) which can be manufactured, e.g. "a steering mechanism incorporating an automatic feedback circuit ..."; or "a woven garment comprising ..." or "an insecticide consisting of X, Y, Z".

SU: No comments

GB: No comments

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16 → paragraph 7.5

US: 7.5 Alternative forms of an invention may be claimed ~~either~~ in a plurality of independent claims, as indicated in III, 7.1, ~~or in a single claim (but see III, 7.6). In the latter case the presence of the~~ two alternatives as independent forms may not be immediately apparent. In either case, however, ~~the same criteria should be applied in deciding whether or not there is unity of invention.~~

SU: III, 7.5 EPO 25. Alternative forms of an invention may be claimed either in a plurality of dependent claims, or in a single claim. In the latter case the presence of the two alternatives may not be immediately apparent. In either case, however, the presence of the alternatives should not be objected where there is unity of invention according to the PCT Rules.

GB: No comments

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17 → paragraph 7.6

US: for invalidating a patent 7.6 Lack of unity is not a ground of revocation in later proceedings and therefore, although the objection should certainly be made and amendment insisted upon in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the search report. If the common matter of the independent claims is well-known, and the remaining subject-matter of each claim differs from that of the others without there being any unifying novel concept common to all, then clearly there is lack of unity. If, on the other hand, there is a common concept or principle which is novel and inventive then objection of lack

CHAPTER III (contd.)

7 Unity of Invention (contd.)

Independent claims (contd.)

paragraph 7.6 (contd.)

US (contd): In general, the findings of the International Searching Authority should be followed if the claims have not been substantially amended.

of unity does not arise. For determining what is allowable between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant. For the particular case of claims for a known substance for a number of distinct medical uses, see IV, 4.2.

SU: No comments

GB: Delete paragraph 7.6, not relevant to IPEA

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Dependent claims

paragraph 7.7

US: Rule 13

Dependent claims

7.7 No objection ~~on account of~~ due to lack of unity is justified by the fact that a dependent claim in itself or in connection with the claim to which it refers, contains an independent invention. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a "turbine rotor blade as claimed in claim 1" and produced from alloy Z. Then no objection under ~~Article 6~~ arises either because alloy Z was new and its composition was not obvious and thus the alloy itself already contains the essential features of an independent patentable invention, or because, although alloy Z was not new, its application in respect of turbine rotor blades was not obvious, and thus represents an independent invention in conjunction with turbine rotor blades.

SU: No comments

GB: No comments

CHAPTER III (contd.)

7 Unity of Invention (contd.)

Unity in relation to the search

paragraphs 7.8 to 7.11

(18) →

US :

Unity in relation to the search

7.8 In many and probably most instances lack of unity will have been noted and reported upon by the ~~Search Division~~ who will have drawn up an international search report based on those parts of the application relating to the invention, or unified linked group of inventions, first mentioned in the claims. The ~~Search Division~~ may neither refuse the application for lack of unity, nor require limitation of the claims; but must inform the applicant that, if search reports are to be drawn up in respect of those inventions present other than the first mentioned, then appropriate fees must be paid within a stipulated period. ~~The Examining Division may allow a refund of fees if it subsequently finds that the objection was not justified (see III, 7.10).~~ If the International Searching Authority charged extra fees, the International Preliminary Examining Authority will probably need to charge extra fees to cover costs. (A special paragraph should be written on this subject.)

7.9 If the applicant has not availed himself of the opportunity to have search reports on the other inventions he will be taken to have elected that the application should proceed on the basis that it relates to the invention which has been searched. The examiner, if he agrees with the ~~Search Division~~ that the application contains more than one invention, should then require deletion of all ~~of them~~ other than the invention which has been searched (see III, 7.11).

7.10 If, however, the applicant has taken the opportunity to have other inventions searched then he may elect that the application shall proceed on the basis of any one of these, the others being deleted if the examiner agrees with the ~~Search Division's~~ objection of lack of unity.

7.11 Whether or not the question of unity of invention has been raised by the ~~Search Division~~ it must always be considered by the examiner. In ~~doing so~~ he should take into account the search report, ~~or reports~~. If unity is found to be lacking, the applicant should be required to limit his claims in such a way as to avoid the objection. Excision or amendment of parts of the description may also be necessary (see II, 7.3). ~~One or more divisional applications, covering matter removed to meet this objection, may be filed (see VI, 9).~~

SU :

III, 7.8 EPO

26. Prior to drawing up the international preliminary examination report the examiner should ascertain whether the requirements to the claims of the invention have been met and invites the applicant to submit necessary amendments and/or corrections (if any).

27. The International Preliminary Examining Authority ascertains whether the requirements of unity of invention (PCT Rule 13) have been met. In many and probably most instances lack of unity will have been noted by the International Searching Authority while establishing an international search report.

28. Where there is lack of unity the International Preliminary Examining Authority acts in accordance with PCT Rule 68.

(comments from GB on the following page)

CHAPTER III (contd.)

7 Unity of Invention (contd.)

Unity in relation to the search (contd.)

paragraphs 7.8 to 7.11 (contd.)

GB: Paragraphs 7.8 to 7.11 should either be deleted or related to ISAs and PCT procedure

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paragraph 7.12

US: ~~Rule 46(2).~~ ~~7.12 If the examiner considers that there is unity of invention, and a~~ plurality of search reports has been made under ~~Rule 40~~, paragraph 1, the applicant should be ~~informed~~ that the objection of lack of unity is ~~withdrawn and that he may apply for a refund of excess fees.~~

SU: No comments

GB: Paragraph 7.12 should be either deleted or related to ISAs and PCT procedure

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CHAPTER IV

Title

1 General

19 → 2 Inventions

paragraph 2.1 (first two subparagraphs)

US:

PRELIMINARY EXAMINATION

~~PATENTABILITY~~

which must be considered during the international preliminary examination

1 General

1.1 There are four basic requirements ~~for patentability~~:

Art 33(1) ~~52(1)~~

1. There must be an "*invention*".

2. The invention must be "*susceptible of industrial application*".

3. The invention must be "*new*".

4. The invention must involve an "*inventive step*".

These requirements will be dealt with in turn.

2 *Inventions*

~~Art 52(2)~~ Treaty

2.1 The ~~Convention~~ does not define what is meant by "*invention*", but ~~Article 52, paragraph 2, contains a non-exhaustive list of things which shall not be regarded as inventions~~.

Rule 67 specifies what subject matter which need not be examined.

~~Several of the exclusions in this list comprise abstractions as well as~~ materialisations thereof (e.g. an aesthetic creation as an abstract entity or as a picture, sculpture etc., a computer program as an abstract entity or ~~defined in~~ terms of a process for operating a computer or as a ~~record, e.g. on magnetic tape). An "abstraction" is never patentable. Materialisations (= products or processes) may be patentable but only when the "invention" has technical (i.e. practical) features.~~ The examples given below will help to ~~make this clear~~ (see also IV, 2.2). ~~The items on the list in Article 52, paragraph 2, will be dealt with in turn.~~

define what subject matter constitutes an invention

SU:

69. The International Preliminary Examining Authority carries out the international preliminary examination within the time limits provided for in PCT Rule 69.

70. No International Preliminary Examining Authority will carry out the international preliminary examination if the international application claims the objects listed in PCT Rule 67.

(comments from GB on the following page)

CHAPTER IV (contd.)

Title

2 Inventions (contd.)

19 → paragraph 2.1 (first two subparagraphs) (contd.)

GB:

CHAPTER IV

PATENTABILITY

This Chapter should be rearranged so as to follow the PCT approach of Article 33 and 34, and Rule 64, 65, 66 and 67. Reference should be made early in the Chapter to Article 33(5).

~~1 General~~

~~1.1 There are four basic requirements for patentability:~~

Art 52(1)

The PCT does not specify these requirements, but merely lists what are not to be examined - Rule 67. →

1. There must be an "*invention*".
2. The invention must be "*susceptible of industrial application*".
3. The invention must be "*new*".
4. The invention must involve an "*inventive step*".

~~These requirements will be dealt with in turn.~~

2 *Inventions*

Art 52(2)

2.1 The Convention does not define what is meant by "*invention*", but Article 52, paragraph 2, contains a non-exhaustive list of things which shall not be regarded as inventions.

Redraft in terms of Rule 67. →

Several of the exclusions in this list comprise abstractions as well as materialisations thereof (e.g. an aesthetic creation as an abstract entity or as a picture, sculpture etc.; a computer program as an abstract entity or defined in terms of a process for operating a computer or as a record, e.g. on magnetic tape). An "*abstraction*" is never patentable. Materialisations as products or processes may be patentable but only when the "*invention*" has technical (i.e. practical) features. The examples given below will help to make this clear (see also IV, 2.2). The items on the list in Article 52, paragraph 2, will be dealt with in turn.

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paragraph 2.1 (contd.)

20 → Discoveries

US:

Discoveries

person ascertains — If a ~~man finds out~~ a new property of a known material or article, that is not an invention — mere discovery and ~~unpatentable~~. If, however, a ~~man~~ puts that property to practical use he has made an invention ~~which may be patentable~~. For example, the discovery that a particular material is able to withstand mechanical shock would not be ~~patentable~~, but a railway sleeper made from that material could well be ~~patentable~~. A substance when found in nature is also a mere discovery ~~and therefore unpatentable~~. Plant or animal varieties, except products of microbiological processes, ~~are~~ excluded in any event by ~~Article 53, subparagraph (b)~~ (see IV, 3.4 and 3.5).

an invention may be excluded from International Preliminary Examination — Rule 67.1(ii)

CHAPTER IV (contd.)

2 Inventions

paragraph 2.1 (contd.)

(20) →

Discoveries (contd.)

SU: No comments

GB: Delete paragraph under "Discoveries", not mentioned in Rule 67

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paragraph 2.1 (contd.)

Scientific theories

US:

Rule 67.1(i)

an invention

an invention

Scientific theories

These are a more generalised form of discoveries, and the same principle applies. For example, the physical theory of semiconductivity would not be ~~patentable.~~ However, new semiconductor devices and processes for manufacturing these may be ~~patentable.~~

SU: No comments

GB:

Rule 67.1(i)

**Scientific theories**

**These are a more generalised form of discoveries, and the same principle applies. For example, the physical theory of semiconductivity would not be patentable. However, new semiconductor devices and processes for manufacturing these may be patentable.**

---

paragraph 2.1 (contd.)

Mathematical methods

US:

Rule 67.1(i)

inventions

an invention

an invention

Mathematical methods

These are a particular example of the principle that purely abstract or intellectual methods are not ~~patentable.~~ For example, a shortcut method of division would not be ~~patentable~~ but a calculating machine designed to operate accordingly may well be ~~patentable.~~

SU: No comments

GB:

Rule 67.1(i)

**Mathematical** theories ~~methods~~

**These are a particular example of the principle that purely abstract or intellectual methods are not patentable. For example, a shortcut method of division would not be patentable but a calculating machine designed to operate accordingly may well be patentable.**

CHAPTER IV (contd.)

2 Inventions (contd.)

paragraph 2.1 (contd.)

(21) →

Aesthetic creation

US:

an invention
an invention
an invention
an invention
an invention

Aesthetic creation
An aesthetic creation is by definition an article (e.g. a painting or sculpture) whose purpose is other than practical or functional. If, however, the article happens also to have functional or technical features, it might be ~~patentable~~, a tyre tread being an example of this. Likewise, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not ~~patentable~~ the means of obtaining it may be. For example, a fabric may be provided with an attractive appearance by means of a layered structure not previously used for this purpose, in which case a fabric incorporating such structure might be ~~patentable~~. Also a process of producing an aesthetic creation may comprise a technical innovation and thus be ~~patentable~~. For example, a diamond may have a particularly beautiful shape (not of itself ~~patentable~~) produced by a new technical process. In this case, the process is ~~patentable~~ and so is the product, i.e. the diamond having the particular shape when produced by the process.

SU: No comments

GB:

PCT does not mention these →

Aesthetic creation
An aesthetic creation is by definition an article (e.g. a painting or sculpture) whose purpose is other than practical or functional. If, however, the article happens also to have functional or technical features, it might be patentable, a tyre tread being an example of this. Likewise, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not patentable, the means of obtaining it may be. For example, a fabric may be provided with an attractive appearance by means of a layered structure not previously used for this purpose, in which case a fabric incorporating such structure might be patentable. Also a process of producing an aesthetic creation may comprise a technical innovation and thus be patentable. For example, a diamond may have a particularly beautiful shape (not of itself patentable) produced by a new technical process. In this case, the process is patentable and so is the product, i.e. the diamond having the particular shape when produced by the process.

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paragraph 2.1 (contd.)

Schemes, rules and methods for performing mental acts, playing games or doing business

US:

an invention
an invention

Schemes, rules and methods for performing mental acts, playing games or doing business
These are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving crossword puzzles, a game (as an abstract entity defined by its rules) or a scheme for organising a commercial operation would not be ~~patentable~~. However, novel apparatus for playing a game or carrying out a scheme might be ~~patentable~~.

(comments from SU and GB on the following page)

CHAPTER IV (contd.)

2 Inventions (contd.)

paragraph 2.1 (contd.)

Schemes, rules and methods for performing mental acts, playing games or doing business (contd.)

SU : No comments

GB :

See Rule 67.1(iii)

**Schemes, rules and methods for performing mental acts, playing games or doing business**

**These are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving crossword puzzles, a game (as an abstract entity defined by its rules) or a scheme for organising a commercial operation would not be patentable. However, novel apparatus for playing a game or carrying out a scheme might be patentable.**

---

22 → paragraph 2.1 (contd.)

Programs for computers

US :

an invention

Programs for computers

A computer program may take various forms, e.g. an algorithm, a flow-chart or a series of coded instructions which can be recorded on a tape or other machine-readable record-medium, and can be regarded as a particular case of either a mathematical method (see above) or a presentation of information (see below). If the contribution to the known art resides solely in a computer program then the subject-matter is not ~~patentable~~ in whatever manner it may be presented in the claims. For example, a claim to a computer characterised by having the particular program stored in its memory or to a process for operating a computer under control of the program would be as objectionable as a claim to the program *per se* or the program when recorded on magnetic tape.

SU : No comments

GB

IPEA may be required to examine computer programs. Rule 67.1(vi)

Programs for computers

A computer program may take various forms, e.g. an algorithm, a flow-chart or a series of coded instructions which can be recorded on a tape or other machine-readable record-medium, and can be regarded as a particular case of either a mathematical method (see above) or a presentation of information (see below). If the contribution to the known art resides solely in a computer program then the subject-matter is not patentable in whatever manner it may be presented in the claims. For example, a claim to a computer characterised by having the particular program stored in its memory or to a process for operating a computer under control of the program would be as objectionable as a claim to the program *per se* or the program when recorded on magnetic tape.

CHAPTER IV (contd.)

2 Inventions (contd.)

paragraph 2.1 (contd.)

Presentations of information

US:

an invention

Presentations of information

Any presentation of information characterised solely by the content of the information is not ~~patentable~~. This applies whether the claim is directed to the presentation of information *per se* (e.g. written instructions on how to operate a machine or use a chemical substance) or to an information carrier (e.g. a book, traffic sign or gramophone record). If, on the other hand, the manner of presentation of information has new technical features there could be ~~patentable~~ subject-matter (see also IV, 2.2).

inventive

SU: No comments

GB:

Rule 67.1(v)

Mere Presentations of information

Any presentation of information characterised solely by the content of the information is not patentable. This applies whether the claim is directed to the presentation of information *per se* (e.g. written instructions on how to operate a machine or use a chemical substance) or to an information carrier (e.g. a book, traffic sign or gramophone record). If, on the other hand, the manner of presentation of information has new technical features there could be patentable subject-matter (see also IV, 2.2).

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23 → paragraph 2.2

US:

2.2 In considering whether an invention is present there are two general points the examiner must bear in mind. Firstly, he should disregard the form or kind of claim and concentrate on the content in order to identify the novel contribution which the alleged "*invention*" claimed makes to the known art. ~~If this contribution does not constitute an invention, there is not patentable subject-matter.~~ This point is illustrated by the examples given in IV, 2.1 of different ways of claiming a computer program. As another example, if a manufactured article, ~~which is itself of a kind which is patentable,~~ happens to be known, then a claim directed to that article and distinguished from the known art solely by choosing a different colour for the article would not be for an invention unless the colour chosen provided a different technical (and not merely aesthetic) feature. ~~On the other hand,~~ any exclusion from ~~patentability~~ applies only to the extent that the application relates to the excluded subject-matter ~~or activities as such~~. Thus, the exclusion might not apply if the invention also provides new technical features. This is illustrated, for instance, by the examples given in IV, 2.1 under "*aesthetic creations*". As a further example, a gramophone record distinguished solely by the music recorded thereon would not be ~~patentable~~; if, however, the form of the groove were modified so that the record, when used with an appropriate pick-up mechanism, functioned in a new way (as in the first stereo record), there could be ~~patentable subject-matter~~.

Secondly inventive subject matter

an invention

an invention

(comments from SU and GB on the following page)

CHAPTER IV (contd.)

2 Inventions (contd.)

23 → paragraph 2.2 (contd.)

SU : No comments

GB :

Different approach in PCT. See Article 34(4)(a)(i) and Rules 66.2(a)(i) and 67.

2.2 In considering whether an invention is present there are two general points the examiner must bear in mind. Firstly, he should disregard the form or kind of claim and concentrate on the content in order to identify the novel contribution which the alleged *"invention"* claimed makes to the known art. If this contribution does not constitute an invention, there is not patentable subject-matter. This point is illustrated by the examples given in IV, 2.1 of different ways of claiming a computer program. As another example, if a manufactured article, which is itself of a kind which is patentable, happens to be known, then a claim directed to that article and distinguished from the known art solely by choosing a different colour for the article would not be for an invention unless the colour chosen provided a different technical (and not merely aesthetic) feature. On the other hand, any exclusion from patentability applies only to the extent that the application relates to the excluded subject-matter or activities as such. Thus the exclusion might not apply if the invention also provides new technical features. This is illustrated, for instance, by the examples given in IV, 2.1 under *"aesthetic creations"*. As a further example, a gramophone record distinguished solely by the music recorded thereon would not be patentable; if, however, the form of the groove were modified so that the record, when used with an appropriate pick-up mechanism, functioned in a new way (as in the first stereo record), there could be patentable subject-matter.

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3 Exceptions to patentability

24 → paragraphs 3.1 to 3.3

US :

Subject matter exceptions

3 ~~Exceptions to patentability~~

Rule 9

~~Art 53(a)~~ order may be international applications

3.1 Any invention, the publication or exploitation of which would be ~~contrary to "ordre public"~~ contrary to public order or morality ~~is prohibited~~ excluded from ~~patentability~~. The purpose of this is to exclude ~~from protection~~ inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour (see also II, 7.1); one obvious example of subject-matter which should be excluded under this provision is a letter-bomb. This provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general would regard the invention as so abhorrent that the grant of patent rights would be inconceivable. ~~If it is clear that this is the case, objection should be raised under Article 53, sub-paragraph (a); otherwise not.~~

~~Art 53(a)~~ Rule 9.1(ii) order

3.2 Explcitation is not to be deemed to be contrary to ~~"ordre public"~~ public or morality merely because it is prohibited by law or regulation in any ~~or all of the~~ Contracting States. ~~One reason for this is that a product could still be manufactured under a European patent for export to States in which its use is not prohibited.~~

CHAPTER IV (contd.)

3 Exceptions to patentability (contd.)

paragraphs 3.1 to 3.3 (contd.)

24

US (contd):

deletion of portions of the application

3.3 In some cases ~~refusal of a patent~~ may not be necessary. This may result when the invention has both an offensive and a non-offensive use: e.g. a process for breaking open locked safes, the use by a burglar being offensive but the use by a locksmith in the case of emergency inoffensive. In such a case no objection arises under ~~Article 53, sub-paragraph (a),~~ but if the application contains an explicit reference to a use which is contrary to "~~ordre~~ *public*" or morality, deletion of this reference should be required under the terms of Rule ~~34, paragraph 1(a)~~.

Rule 9, order 9

SU: No comments

GB: Delete paragraphs 3.1 to 3.3, not applicable to PCT

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paragraphs 3.4 and 3.5

US:

Rule 67.1(ii)

~~Art 53(b)~~

Another category which need not be examined is and

3.4 ~~Also excluded from patentability are~~ "*plant or animal varieties or essentially biological processes for the production of plants or animals*". ~~One reason for this exclusion is that, at least for plant varieties, other means of obtaining legal protection are available in most countries.~~ The question whether a process is "*essentially biological*" is one of degree depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be excluded. ~~To take some~~ For example, a method of selectively breeding, *e.g.*, horses involving merely selecting for breeding those animals having certain characteristics would be essentially biological ~~and therefore unpatentable~~. ~~On the other hand,~~ However, a method of pruning a tree would not be essentially biological since although a biological process is involved, the essence of the invention is technical; the same could apply to a method of treating a plant characterised by the application of a growth-stimulating substance or radiation.

In International Preliminary Examination conducted

3.5 The exclusion referred to in the preceding paragraph does not apply to micro-biological processes or the products thereof. ~~Thus patents~~ may be ~~obtained~~ not only for processes involving micro-organisms, but also for micro-organisms themselves (as well as inanimate products) when produced by a micro-biological process. ~~Patents~~ may not however be ~~obtained~~ for micro-organisms *per se*.

An International Preliminary Examination conducted

4

SU: No comments

GB: No comments

CHAPTER IV (contd.)

4 Industrial application

paragraph 4.1

US:

Art 33(4) 57

4.1 "*An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture*". "*Industry*" should be understood in its broad sense as including any physical activity which is useful in practical affairs; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog, or a process for converting energy from one form to another. ~~Thus, Article 57 excludes from patentability very few "inventions" which are not already excluded by the list in Article 52, paragraph 2 (see IV, 3.1).~~ One further class of "*invention*" which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine.

33(4) Objection could arise under Article 57 only in so far as the claim specifies the intended function or purpose of the invention, ~~but if, say, a~~ However if, a perpetual motion machine is claimed merely as an article having a particular specified construction then objection should be made under Article 5 ~~83~~ (see II, 4.11).

SU:

Art. 33(4) PCT — 44. A claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.

IV, 4.1 EPO — 45. An invention should not be considered as susceptible of industrial application if a person skilled in the art readily comes to the conclusion that the invention is clearly contrary to well-established physical laws and will not lead to the expected results.

46. Low economic results or poor competitive abilities cannot serve the basis for objections because the invention is not industrially appliable, if the invention can be realized in principle.

Art. 5 PCT — 47. In considering the question whether the invention is industrially applicable, the examiner should bear in mind that the description should disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

GB: Redraft paragraph 4.1 in terms of Article 33(4)

CHAPTER IV (contd.)

4 Industrial application

paragraph 4.2

US:

~~Art 52(4)~~ Rule 67.1(iv) need International Preliminary Examination International Preliminary Examination conducted

4.2 "*Methods for treatment of the human or animal body by surgery or therapy* and "*diagnostic methods*" *practised on the human or animal body* ~~shall~~ *not be regarded as inventions which are susceptible of industrial application*". ~~Patents~~ may, however, be ~~obtained~~ for surgical, therapeutical or diagnostic instruments or apparatus for use in such methods. ~~Patents~~ may also be ~~obtained~~ for new products for use in these methods of treatment or diagnosis, particularly substances or compositions. ~~However in the case of a known substance or composition, this may only be patented for the first such use. If a known substance, not previously used in surgery, therapy or diagnosis is found to be useful in curing, say, a certain human disease, a patent for the substance limited to that use may be obtained; but the same substance could not subsequently be patented for use in curing a different disease, whether human or animal, or in surgery or diagnosis.~~ A claim to a known substance or composition for use in a surgical, therapeutical or diagnostic method should be in a form such as: "Substance or composition X for use in curing disease Y...". Such a claim shall be construed as restricted to the substance or composition when presented or packaged for the specified use (see III, 4.8).

If an applicant discloses at the same time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, he may normally be allowed in the one application independent claims each directed to the substance or composition for one of the various uses; i.e. objection should not, as a general rule, be raised that there is lack of unity of invention.

SU: No comments

GB:

Art 52(4) Redraft in terms of Rule 67.1(iv) →

Art 54(5) This case is not referred to in PCT but it could be retained since otherwise IPEA might report adversely upon an application which under some systems is allowable. →

4.2 "*Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application*". Patents may, however, be obtained for surgical, therapeutical or diagnostic instruments or apparatus for use in such methods. Patents may also be obtained for new products for use in these methods of treatment or diagnosis, particularly substances or compositions. However in the case of a known substance or composition, this may only be patented for the first such use. If a known substance, not previously used in surgery, therapy or diagnosis is found to be useful in curing, say, a certain human disease, a patent for the substance limited to that use may be obtained; but the same substance could not subsequently be patented for use in curing a different disease, whether human or animal, or in surgery or diagnosis. A claim to a known substance or composition for use in a surgical, therapeutical or diagnostic method should be in a form such as: "Substance or composition X for use in curing disease Y...". Such a claim shall be construed as restricted to the substance or composition when presented or packaged for the specified use (see III, 4.8).

If an applicant discloses at the same time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, he may normally be allowed in the one application independent claims each directed to the substance or composition for one of the various uses; i.e. objection should not, as a general rule, be raised that there is lack of unity of invention.

CHAPTER IV (contd.)

4 Industrial application (contd.)

paragraph 4.3

US:

4.3 ~~It should be noted that Article 52, paragraph 4, excludes only treatment by surgery or therapy. It follows that other~~ methods of treatment of live human beings or animals, e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool, are ~~patentable~~ inventions provided that (as would probably be the case) such methods are of a technical, and not essentially biological, character (see IV, 3.4). ~~Furthermore~~ A treatment or diagnostic method, to be excluded from the field of invention, must be actually carried out on the living animal or human body; so that e.g. the treatment of blood for storage in a blood bank, or diagnostic testing of blood samples, the blood being contained in apparatus quite separate from the body, would not be excluded ~~from patentability by virtue of Article 52, paragraph 4.~~

SU: No comments

GB:

4.3 It should be noted that Rule 67.1(iv) ~~Article 52, paragraph 4~~, excludes only treatment by surgery or therapy. It follows that other methods of treatment of live human beings or animals, e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool, are patentable provided that (as would probably be the case) such methods are of a technical, and not essentially biological, character (see IV, 3.4). Furthermore a treatment or diagnostic method, to be excluded, must be actually carried out on the living animal or human body; so that e.g. the treatment of blood for storage in a blood bank, or diagnostic testing of blood samples, the blood being contained in apparatus quite separate from the body, would not be excluded from patentability by virtue of ~~Article 52, paragraph 4~~ Rule 67.1(iv).

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paragraph 4.4

US:

4.4 Methods of testing generally should normally be regarded as inventions susceptible of industrial application ~~and therefore patentable~~ provided that the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application.

SU: No comments

GB: No comments

CHAPTER IV (contd.)

5 Novelty; state of the art

paragraph 5.1

US:

33(2)
Art ~~54(1)~~
~~Art 54(2)~~
Rule 64.1
priority
international

5.1 An invention is ~~"~~considered to be new if it does not form part of the state of the art~~"~~. The ~~"~~state of the art~~"~~ is defined as ~~"~~everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of ~~filing of~~ the ~~European patent~~ application~~"~~. The width of this definition should be noted. There are no limitations as to where, when or in what manner the information in question is made available, although there are certain specific exclusions (see IV, 8). However, since the ~~"~~state of the art~~"~~ available to the examiner will mainly consist of the documents listed in the search report, this Section deals with the question of public availability only in relation to written description (either alone or in combination with an earlier oral description or use). ~~The principles to be applied in determining whether other kinds of prior art (which could be introduced into the proceedings e.g. by a third party under Article 115) have been made available to the public are set out in the Guidelines for Opposition.~~

SU:

Art. 33(2) PCT

29. A claimed invention should be considered novel if it is not anticipated by the prior art.

GB:

Art 54(1)
Art 54(2)
Redraft in terms of Article 33(2) and Rule 64.1(a). 'Prior art' differently defined in PCT.
'prior art'

5.1 An invention is "*considered to be new if it does not form part of the state of the art*". The "*state of the art*" is defined as "*everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application*". The width of this definition should be noted. There are no limitations as to where, when or in what manner the information in question is made available, although there are certain specific exclusions (see IV, 8). However, since the "*state of the art*" available to the examiner will mainly consist of the documents listed in the search report, this Section deals with the question of public availability only in relation to written description (either alone or in combination with an earlier oral description or use). The principles to be applied in determining whether other kinds of prior art (which could be introduced into the proceedings e.g. by a third party under Article 115) have been made available to the public are set out in the Guidelines for Opposition.

CHAPTER IV (contd.)

5 Novelty; state of the art (contd.)

paragraph 5.2

US:

5.2 A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. As a general rule, no document will be cited in the search report unless the fact of its public availability has been clearly established or is highly probable. Also, if there is any ambiguity as to the precise date of publication of a document, the ~~Search Division~~ International Searching Authority will normally have established a publication date e.g. the date of receipt in a library to which the public have access. If the applicant contests the public availability or assumed date of publication of the document, ~~the~~ the examiner should consider whether to investigate the matter further or ask the ~~Search Division~~ International Searching Authority to do. If the applicant ~~shows~~ presents sound reasons for doubting ~~whether~~ that the document forms part of the ~~"~~*state of the art*~~"~~ in relation to his application, and any further investigation does not produce evidence sufficient to remove that doubt, the examiner should not pursue the matter further. The only other problem likely to arise for the examiner is where:

(a) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and

(b) only the oral description or lecture was publicly available before the ~~"date of filing"~~ priority date of the ~~European~~ international application, the document itself being published on or after this date.

In such cases, the examiner should start with the assumption that the document gives a true account of the earlier lecture, display or other event and should therefore regard the earlier event as forming part of the ~~"~~*state of the art*~~"~~. If, however, the applicant gives sound reasons for contesting the truth of the account given in the document then, again, the examiner should not pursue the matter further.

SU:

Rule 64 PCT

30. For the purposes of the international preliminary examination, everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) should be considered prior art provided that such making available occurred prior to the relevant date. The relevant date is considered to be the international filing date or where the international application validly claims the priority of an earlier application, the filing date of such earlier application. The non-written disclosure should not be considered part of the prior art. Any application or any patent published after the relevant date but having an earlier priority date should not be considered part of the prior art. Nevertheless, the international preliminary examination report should call attention to such materials, if such materials are closely related to the international application under consideration.

(comments from GB on the following page)

CHAPTER IV (contd.)

5 Novelty; state of the art (contd.)

paragraph 5.2 (contd.)

GB :

**5.2 A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. As a general rule, no document will be cited in the search report unless the fact of its public availability has been clearly established or is highly probable. Also, if there is any ambiguity as to the precise date of publication of a document, the Search Division will normally have established a publication date e.g. the date of receipt in a library to which the public have access. If the applicant contests the public availability or assumed date of publication of the document the the examiner should consider whether to investigate the matter further or ask the Search Division so to do. If the applicant shows sound reasons for doubting whether the document forms part of the "*state of the art*" in relation to his application and any further investigation does not produce evidence sufficient to remove that doubt the examiner should not pursue the matter further. The only other problem likely to arise for the examiner is where:**

'relevant date' Rule 64.1(b) →

**(a) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and**

**(b) only the oral description or lecture was publicly available before the "*date of filing*" of the European application, the document itself being published on or after this date.**

**In such cases, the examiner should start with the assumption that the document gives a true account of the earlier lecture, display or other event and should therefore regard the earlier event as forming part of the "*state of the art*". If, however, the applicant gives sound reasons for contesting the truth of the account given in the document then again the examiner should not pursue the matter further.**

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paragraph 5.3

US :

2(xi)
the ~~Art. 89~~ priority date
claimed date of filing of an earlier application for the same subject matter

5.3 It should be noted that ~~"date of filing" in Article 54, paragraph 2,~~ is to be interpreted as meaning the ~~date of priority in appropriate cases~~ (see Chapter V). It should be remembered also that different claims, or different alternatives claimed in one claim, may have different effective dates. The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives) and the state of the art in relation to one claim or one part of a claim may include matter which cannot be cited against another claim or part of a claim because the latter has an earlier effective date. Of course, if all the matter in the state of the art was made available to the public before the date of the earliest priority document, the examiner need not (and should not) concern himself with the allocation of priority dates.

SU : No comments

(comments from GB on the following page)

CHAPTER IV (contd.)

5 Novelty; state of the art (contd.)

paragraph 5.3 (contd.)

GB :

Art 89

5.3 It should be noted that "*date of filing*" in Article 54, paragraph 2, is to be interpreted as meaning the date of priority in appropriate cases (see Chapter V). It should be remembered also that different claims, or different alternatives claimed in one claim, may have different effective dates. The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives) and the state of the art in relation to one claim or one part of a claim may include matter which cannot be cited against another claim or part of a claim because the latter has an earlier effective date. Of course if all the matter in the state of the art was made available to the public before the date of the earliest priority document, the examiner need not (and should not) concern himself with the allocation of priority dates.

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6 Conflict with other European applications

paragraphs 6.1 to 6.3

~~6 Conflict with other European applications~~

US :

~~Art 54(3)(4)~~ ~~6.1 The state of the art also comprises the content of other European~~ applications filed earlier than, but published under Article 93 on or after, the date of filing of the application being examined, to the extent that the earlier and later applications designate the same State or States. (Such earlier applications are part of the state of the art

Art 56

only when considering novelty and not when considering inventive step).

Art 89

Again, the "*date of filing*" is to be interpreted as meaning the date of priority in appropriate cases, (see Chapter V). By the content of a

Art 85

European application is meant the whole disclosure, i.e. the description, drawings and claims. It does not include any priority document nor, in view of Article 85, the abstract. However, the "*content*" does include any matter explicitly disclaimed or prior art explicitly described. It is important to note that it is the content of the earlier application as filed which is to be considered when applying Article 54, paragraph 3.

Art 85

In the case where an application is filed in a non-official language as permitted by Article 14, paragraph 2, (see I, 1.1), it may happen that matter is erroneously omitted from the translation in the language of the proceedings and not published under Article 93 in that language. Even in this case, it is the content of the original text which is relevant for the purposes of Article 54, paragraph 3.

6.2 The above principles also apply to PCT applications designating the Office, but with an important modification. A PCT application which has been published by the International Bureau under Article 21 of the PCT, is always effective as prior art as from its PCT publication date; even

Art 158(1)(2)

when it is published in Japanese or Russian. However, Article 158 of the Convention makes clear that a PCT application published in Japanese or Russian is not included in the state of the art as from its priority date for the purposes of Article 54, paragraph 3, unless the PCT applicant has paid the required fee and has supplied a translation of the PCT application in English, French or German.

CHAPTER IV (contd.)

6 Conflict with other European applications (contd.)

paragraphs 6.1 to 6.3 (contd.)

US: (contd)

Rule 67

6.3 Where an application designates some States which are, and some which are not, designated in an earlier conflicting application, there are two special possibilities of amendment open to the applicant. Firstly, he may simply withdraw the designations common to his own and the earlier application. Secondly, he may file claims for such common States which are different from the claims for the other designated States. Where different claims are filed, the examiner should consider whether the retention of the same description and drawings therefore creates confusion. In such a case, Rule 67 permits the examiner to require the filing of a different description and drawings; the applicant ~~himself has the right to require such amendment~~.

SU: No comments

GB: Delete paragraphs 6.1 to 6.3 and replace by a short section dealing with the specific exclusion of Rule 64.3

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25 → paragraph 6.4

US:

~~6.4 The Convention does not deal explicitly with the case of copending~~ European applications of the same date. However, it is an accepted principle in most patent systems that two patents shall not be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more European applications from the same applicant designating the same State or States and the claims of those applications have the same priority date and relate to the same invention (even though they may not necessarily claim that invention in identical terms), the applicant should be told that he must choose which one of those applications he wishes to proceed to grant. Should two such applications of the same priority date be received from two different applicants each must be ~~allowed to proceed as though the other did not exist~~.

SU: No comments

GB:

may be required in the national phase to

6.4 The Treaty ~~Convention~~ does not deal explicitly with the case of copending ~~European~~ applications of the same date. However, it is an accepted principle in most patent systems that two patents shall not be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more ~~European~~ applications from the same applicant designating the same State or States and the claims of those applications have the same priority date and relate to the same invention (even though they may not necessarily claim that invention in identical terms), the applicant should be told that he ~~must~~ choose which one of those applications he wishes to proceed to grant. Should two such applications of the same priority date be received from two different applicants each must be allowed to proceed as though the other did not exist.

CHAPTER IV (contd.)

7 Test for Novelty

paragraph 7.1

US:

7.1 An invention should be regarded as part of the state of the art, and therefore not new, if a single document or other item of prior art which has been made available to the public teaches the person skilled in the art to do something which falls within the terms of any claim defining that invention, the teaching being derivable directly and unambiguously from the document or other prior art item when considered in the light of common general knowledge. For example, if a prior document discloses a generic chemical formula, this would not deprive of novelty a claim to specific compounds falling within that formula (although it might render such a claim obvious). If, on the other hand, a prior document discloses that a certain part is made of rubber, this would deprive of novelty any statement that the part was made of elastic material; it does not matter whether elastic properties are mentioned in the prior document because the elastic properties of rubber are commonly known. It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art ~~together~~ (see IV, 9.7). For the meaning of "*person skilled in the art*" see IV, 9.6.

SU:

37. Formally, the criterion of novelty differs from that of inventive step in that lack of novelty in the claims is confirmed by way of reference only to a single document, and lack of inventive step is confirmed by way of reference to a number of documents.

31. In establishing an international preliminary examination report each claim which is supposed to be examined is considered as to novelty.

IV, 7.1 EPO

32. A claim should be regarded as part of the state of the art and therefore not new, if a single document or other item of prior art teaches the person skilled in the art that the combination of the technical features of this claim is derivable directly and unambiguously from prior art. Hence, in considering novelty it is not permissible to combine separate documents of prior art together. Similarly, it is not permissible to combine separate items of different documents together.

GB:

PCT terminology is different

7.1 An invention should be regarded as part of the state of the art, and therefore not new, if a single document or other item of prior art which has been made available to the public teaches the person skilled in the art to do something which falls within the terms of any claim defining that invention, the teaching being derivable directly and unambiguously from the document or other prior art item when considered in the light of common general knowledge. For example, if a prior document discloses a generic chemical formula, this would not deprive of novelty a claim to specific compounds falling within that formula (although it might render such a claim obvious). If, on the other hand, a prior document discloses that a certain part is made of rubber, this would deprive of novelty any statement that the part was made of elastic material; it does not matter whether elastic properties are mentioned in the prior document because the elastic properties of rubber are commonly known. It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together (see IV, 9.7). For the meaning of "*person skilled in the art*" see IV, 9.6.

CHAPTER IV (contd.)

7 Test for Novelty (contd.)

paragraph 7.2

US:

7.2 In the case of a published document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching.

SU:

IV, 7.2 EPO — 33. Lack of novelty may be apparent from what is explicitly stated in the document itself. The same consideration applies in the case where, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result of falling within the terms of the claims of an international application.

GB: No comments

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paragraph 7.3

US:

7.3 In considering novelty, a prior document should be construed only in the light of knowledge available at the time the document was published and excluding any knowledge subsequently discovered.

SU:

IV, 7.3 EPO — 34. In considering novelty, a prior document should be construed only in the light of knowledge available at the time the document was published and excluding any knowledge subsequently discovered.

GB: No comments

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26 → 8 Non prejudical disclosures

US:

~~8 Non-prejudical disclosures~~

~~Art 55(1)~~ ~~8.1 There are two specified instances (and these are the only two) in~~ which a prior disclosure of the invention shall not be taken into consideration as part of the state of the art, viz. where the disclosure was *"due to, or in consequence of"*:

(a) *"an evident abuse in relation to the applicant or his legal predecessor"* - e.g. the invention was derived from the applicant and disclosed against his wish; or

(b) the display of the invention by the applicant or his legal predecessor at an officially recognised exhibition as defined in Article 55, paragraph 1(b).

8.2 An essential condition, in both instances (a) and (b), is that the disclosure in point must have taken place not earlier than six months preceding the date of filing the application.

CHAPTER IV (contd.)

26 → 8 Non prejudical disclosures (contd.)

US : (contd)

8.3 Regarding instance (a), the disclosure might be made in a published document or in any other way. As a particular instance, the disclosure might be made in a European application of earlier priority date. Thus, for example, a person B who has been told of A's invention in confidence, might himself apply for a patent for this invention. If so, the disclosure resulting from the publication of B's application will not prejudice A's rights provided that A has already made an application, or applies within six months of such publication.

8.4 In instance (b), application must be made within six months of the start of the exhibition if the display is not to prejudice the application. Furthermore the applicant must state, at the time of filing the application, that the invention has been so displayed, and must also file a supporting ~~certificate within four months, giving the particulars required by Rule 23.~~

Art 55(2)
Rule 23

SU: No comments

GB: Delete this section, not relevant to PCT. Should be replaced by a paragraph dealing with "non-oral disclosures" under Rule 64.2

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9 Inventive step

paragraph 9.1

US :

33(3)
Art 56
claimed prior art as defined in the Regulations

9.1 "An invention shall be considered ~~as involving~~ to involve an inventive step if, having regard to the ~~state of the art~~, it is not obvious to a person skilled in the art". Novelty and inventive step are different criteria. Novelty exists if there is any difference between the invention and the known art. The question - Is there inventive step? - only arises if there is novelty.

, at the prescribed relevant date

SU:

Art. 33(3) PCT — 35. A claimed invention should be considered to involve an inventive step if having regard to the prior art it is obvious to a person skilled in the art.

IV, 9.1 EPO — 38. If a claim lacks novelty therefore it does not involve inventive step. In such a case both novelty and inventive step are objected by way of one and the same reference. Thus, the question--Is there inventive step?--only arises if there is novelty, i.e. when there is a difference between each claim and any document belonging to prior art.

GB:

Art 56
Redraft in terms of Rule 65.

9.1 "An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art". Novelty and inventive step are different criteria. Novelty exists if there is any difference between the invention and the known art. The question - Is there inventive step? - only arises if there is novelty.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.2

prior 33(3)

9.2 The "~~state of the art~~" for the purposes of considering inventive step is as ~~defined~~ in Article ~~54, paragraph 2~~ (see IV, 5); it does not include later published ~~European~~ applications ~~referred to in Article 54, paragraph 3~~. As mentioned in IV, 5.3, "~~date of filing~~" in ~~Article 54, paragraph 2~~ means ~~date of priority~~ where appropriate (see Chapter V).

priority date

US: the claimed date of the prior filed application on the same subject matter

SU: No comments

GB: 9.2 The "*state of the art*" for the purposes of considering inventive step is as defined in Article 54, paragraph 2 (see IV, 5); it does not include later published European applications referred to in Article 54, paragraph 3. As mentioned in IV, 5.3, "*date of filing*" in Article 54, paragraph 2, means date of priority where appropriate (see Chapter V).

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paragraphs 9.3 and 9.4

considered to

9.3 Thus the question to consider, in relation to any claim defining the invention, is whether at the priority date of that claim, having regard to the art known at that time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is ~~bad for~~ lack ~~of~~ inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ingenuity beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see IV, 7.3), it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art at the priority date of the claim.

US:

9.4 While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that there are various ways in which the skilled person may arrive at an invention. An invention may, for example, be based on the following:

(i) The formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated).
Example: the problem of indicating to the driver of a motor vehicle at night the line of the road ahead by using the light from the vehicle itself. As soon as the problem is stated in this form the technical solution, viz. the provision of pieces of reflecting glass (or "cats' eyes") suitably positioned and angled along the road surface, appears simple and obvious.

(ii) The devising of a solution to a known problem.
Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraphs 9.3 and 9.4 (contd.)

US (contd):

(iii) The arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).
Example: the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious.

Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

SU: No comments

GB: No comments

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paragraph 9.5

US:

9.5 In identifying the contribution any particular invention makes to the art in order to determine whether there is an inventive step, account should be taken first of what the applicant himself acknowledges in his description and claims to be known; any such acknowledgement of known art should be regarded by the examiner as being correct unless the applicant states he has made a mistake (see VI, 8.5). However, the further prior art contained in the search report may put the invention in an entirely different perspective from that apparent from reading the applicant's specification by itself (and indeed this cited prior art may cause the applicant voluntarily to amend his claims to redefine his invention before his application comes up for examination). In order to reach a final conclusion as to whether any claim includes an inventive step it is necessary to determine the difference between the subject-matter of that claim and the whole of the known art and, in considering this matter, the examiner should not proceed solely from the point of view suggested by the form of claim (prior art plus characterising portion - see III, 2).

SU:

IV, 9.5 EPO

40. In the claims the applicant himself may indicate what seems to be known. But the examiner should not proceed solely from the point of view suggested by the applicant in considering whether there is lack of inventive step or there is not. The examiner determines the difference between any claim and the whole of the known art. During the examination the examiner may put known technical features in an entirely difference perspective from that apparent from reading the applicant's specification by itself.

GB: No comments

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.6

US: prior

9.6 The person skilled in the art should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything in the ~~"state of the art"~~ prior art, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine experimentation. There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person. This may apply e.g. in certain advanced technologies such as computers or telephone systems and in highly specialised processes such as the commercial production of integrated circuits or of complex chemical substances.

SU: No comments

GB: No comments

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27 → paragraph 9.7

US:

9.7 In considering whether there is inventive step (as distinct from novelty (see IV, 7)), it is permissible to combine ~~together~~ the disclosures of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would be obvious to the person skilled in the art. In determining whether it would be obvious to combine two or more distinct documents, the examiner should have regard to the following:

(i) Whether the nature and content of the documents is such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the invention, would combine them;

(ii) Whether the documents come from similar, neighbouring or remote technical fields;

(iii) The number of documents which need to be combined.

The combining of two or more parts of the same document would be obvious if it would be natural for the skilled person to associate these parts with one another. It would normally be obvious to combine with other prior documents a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other. In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.

(comments from SU and GB on the following page)

CHAPTER IV (contd.)

9 Inventive step (contd.)

27 → paragraph 9.7 (contd.)

SU:

IV, 9.7 EPO

39. In considering whether the combination of documents is obvious, the examiner should have regard to the following:

(i) whether the nature and content of the documents is such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the invention, would combine them;

(ii) whether the documents come from similar, neighbouring or remote technical fields;

(iii) the number of documents which need to be combined.

The combination of documents or of two or more parts of the same document would be obvious if it would be natural for the skilled person to associate these documents or their parts with one another. For example, it would normally be obvious to combine with other prior documents a well-known textbook or standard dictionary. It would also be obvious to combine two documents, one of which contains a clear and unmistakable reference to the other, or to combine patent documents relating to classifications bound by references within classification indexes.

Rule 65.1 PCT

36. In considering inventive step, the relation of any particular claim to the prior art as a whole is taken into consideration. Thus, not only separate documents or their parts are considered but also combinations of such documents or combinations or their parts, where such combinations are obvious to the person skilled in the art, i.e. where the possiblity of combining such documents or their parts is obvious from technical point of view to the person skilled in the art.

GB:

9.7 In considering whether there is inventive step (as distinct from novelty (see IV, 7)), it is permissible to combine together the disclosures of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would be obvious to the person skilled in the art. In determining whether it would be obvious to combine two or more distinct documents, the examiner should have regard to the following:

(i) Whether the nature and content of the documents is such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the invention, would combine them;

(ii) Whether the documents come from similar, neighbouring or remote technical fields;

(iii) The number of documents which need to be combined.

The combining of two or more parts of the same document would be obvious if it would be natural for the skilled person to associate these parts with one another. It would normally be obvious to combine with other prior documents a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other. ~~In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.~~

Not applicable under Rule 65.1 →

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8

9.8 The following list gives examples for guidance of circumstances where an invention should be regarded as obvious or where it involves an inventive step (the list is not exhaustive):

(A1) Inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) The teaching of a prior document is incomplete and at least one of the possible ways of filling the gap which would naturally or readily occur to the skilled person results in the invention.
Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical).
Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.

US:

(iii) The invention consists merely in a new use of a well-known material employing the known properties of that material.
Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use.
Example: An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding.

(v) The invention consists merely in the use of a known technique in a closely analagous situation.
Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck. The use of this technique to control the electric propulsion motor of the truck being already known.

(A2) Inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore to be recognised:

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8 (contd.)

(i) A known working method or means when used for a different purpose involves a new, surprising effect.
Example: It is known that high frequency power can be used in inductive butt welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect; an inventive step would exist in this case, however, if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal being on the face of it necessary in order to avoid arcing between the welding contact and the strip). The unexpected additional effect is that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric.

(ii) A new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques.
Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

US: (contd)

(B1) Obvious and consequently non-inventive combination of features:

The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.
Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

(B2) Not obvious and consequently inventive combination of features:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself.
Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquiliser (sedative). It was found that through the addition of the tranquiliser, which intrinsically appeared to have no pain-killing effect, the analgesic effect of the pain-killer was intensified in a way which could not have been predicted from the known properties of the active substances.

(C1) Obvious and consequently non-inventive selection among a number of known possibilities:

(i) The invention consists merely in choosing from a number of equally likely alternatives.
Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8 (contd.)

US: (contd)

(ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures.
Example: The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

(iii) The invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.
Example: The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straightline graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) The invention consists merely in selecting a small number of chemical compounds from a broad field.
Example: The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or small group of radicals from among those referred to, as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document since the question would then be one of lack of novelty rather than obviousness). The resulting compounds
(a) are not described as having, nor shown to possess, any advantageous properties not possessed by the prior art examples; or
(b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection.

(C2) Not obvious and consequently inventive selection among a number of known possibilities:

(i) The invention involves special selection in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product.
Example: In a process where substance A and substance B are transformed at high temperature into substance C, it was known that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130°C. It is now found that in the temperature range from 63 to 65°C, which previously had not been explored, the yield of substance C was considerably higher than expected.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8 (contd.)

(ii) The invention consists in selecting a small number of chemical compounds from a broad field, such compounds having unexpected advantages.
Example: In the example of a substituted chemical compound given at (iv) under (C1) above, the invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior disclosure. In this case however not only does the selection embrace a relatively small area of the possible field, and result in compounds described and shown to possess advantageous properties, but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the described advantageous properties.

US : (contd)

(D) Overcoming a technical prejudice:

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.
Example: Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

SU :

Rule 65.1 PCT

36. In considering inventive step, the relation of any particular claim to the prior art as a whole is taken into consideration. Thus, not only separate documents or their parts are considered but also combinations of such documents or combinations or their parts, where such combinations are obvious to the person skilled in the art, i.e. where the possiblity of combining such documents or their parts is obvious from technical point of view to the person skilled in the art.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8 (contd.)

IV, 9.8 EPO

41. The following list gives examples for guidance of circumstances where an invention should be regarded as obvious or where it involves an inventive step:

A. Inventions involving the application of known measures in an obvious (non-obvious) way:

(i) The teaching of a prior document is incomplete and at least one of the possible ways of "filling the gap" would naturally or readily occur to the skilled person.

Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical).

Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor. However, if the use of a hydraulic motor involves a new, surprising effect, e.g. as a result of a specific technological cooperation with the pump, then the invention can be said to involve inventive step.

(iii) The invention consists merely in a new use of a well-known material employing the known properties of that material.

Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water; this property being known to be an essential one for detergents. But if the use of such a washing composition was previously considered for some reasons impossible, and the inventor removed the undesirable effect, then the invention can be said to involve inventive step.

SU: (contd)

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use.

Example: An electric cable comprises a polythene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding. But if such technique involves a surprising effect, e.g. rapid improvement of electrical durability of cables for high-frequency power, then the invention can be said to involve inventive step.

(v) The invention consists merely in the use of a known technique in a closely analogous situation.

Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanism of an industrial truck, such as a fork-lift truck, the use of this technique being already known to control the movement of a carriage.

B. Obvious and non-obvious combination of features: the invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working interrelationship.

Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

But if the features so associate with each other that a new technical result is achieved then inventive step can be said to be involved, even if each feature, taken alone, is fully known.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8 (contd.)

SU: (contd)

Example: Invention consisting of combined method of teeth treatment including simultaneous use of mechanical and ultrasonic treatments can be said to involve inventive step if a quick and painless result is achieved provided that such a result cannot be achieved by these treatments taken separately.

C. Obvious (non-obvious) selection among a number of known possibilities:

(i) The invention consists merely in choosing from a number of equally likely alternatives.

Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat and a mere choice of one of them doesn't involve inventive step.

(ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures.

Example: The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. In such a case, there is no inventive step, especially if it is obvious that the prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner. But where the choice of rates results in a surprising effect in the working process or lead to new properties of the product, then it is possible to say that inventive step is involved.

(iii) The invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.

Example: The invention is characterized by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straightline graph, obtained from the known art.

(iv) The invention consists merely in selecting a small number of chemical compounds from a broad field.

Example: The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or small group of radicals from amongst those referred to as the subsistent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document since the question would then be one of lack of novelty rather than obviousness). If the resulting compounds are not described as having any advantageous properties not possessed by the prior art examples or are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection, then the invention doesn't involve inventive step. But where there is no indication that it is the choice of this radical that leads to the effect, the invention seems to have inventive step.

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.8 (contd.)

SU: (contd)

D. Overcoming a technical prejudice:

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention.

Example: Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A processing involving the same steps and a certain substance so that no precautions should be taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

GB: No comments

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paragraph 9.9

US:

9.9 It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of *ex post facto* analysis of this kind. In all cases, he should seek to make a practical "real-life" assessment. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising, and this can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step. The same applies where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need. Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

(comments from SU and GB on the following page)

CHAPTER IV (contd.)

9 Inventive step (contd.)

paragraph 9.9 (contd.)

SU:

IV, 9.9 EPO

42. It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at by a series of apparently easy steps. However, a series of such steps might have been far from being obvious before a new idea was formulated. That is why the examiner in considering prior art should give fair weight to relevant arguments or evidence submitted by the applicant. Very often an invention is shown to be of considerable technical value and provides a technical advantage which is new and surprising, but this is not obvious or clear from the claims. So the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step. In complicated cases the examiner should not give much weight to merely qualitative considerations, but he should rather pay attention to the necessity to find a few relevant references to support his objection as to lack of inventive step.

IV, 9.9 EPO

43. Commercial or industrial success alone is not to be regarded as indicative of inventive step. But evidence of commercial success is of relevance provided it derives from a new combination of technical features of the invention and not from selling techniques or advertising or from removal of known deficiencies by known means.

GB:

9.9 It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of *ex post facto* analysis of this kind. In all cases, he should seek to make a practical "real-life" assessment. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising, and this can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in 'raising' ~~pursuing~~ an objection that such a claim lacks inventive step. The same applies where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need. Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

CHAPTER V

PRIORITY

1 The right to priority

paragraphs 1.1 to 1.3

US:

1.1 ~~A European~~ application is accorded as its date of filing the date on which it satisfies the requirements of ~~Article 80, or, if filed under the PCT, the date on which it satisfies PCT~~ Article 11. This date remains unchanged except in the special circumstances of late-filed drawings provided for in ~~Article 91, paragraph 5 and PCT~~ Article ~~14, paragraph 2~~. The date of filing may be the only effective date of the application. It will be of importance for fixing the ~~expiry~~ of certain time limits ~~(e.g. the date by which the designation of the Contracting State must be filed under Article 91, paragraph 5)~~, for determining the state of the art relevant to the novelty or obviousness of the subject-matter of the application, ~~and for determining, in accordance with Article 60, paragraph 2, which of two or more European applications from independent persons for the same invention is to proceed to grant~~.

An international and sheets 14(4) and Rule 20.2. expiration (e.g. the date after which no Article 14(4) finding can be made) and

1.2 However, in many cases, ~~a European~~ application will claim the right of priority of the date of filing of an earlier application. In such cases, it is the priority date (i.e. the date of filing of the earlier application) which becomes the effective date for the purposes mentioned in the preceding paragraph.

an international Art 2(xi) ~~89~~

~~Art 87(1)~~

1.3 For a valid claim to priority, several conditions must be satisfied: the earlier application whose priority is claimed must have been made by the ~~European~~ applicant or his predecessor in title; it must have been filed not more than 12 months before the filing date of the ~~European~~ application; and it must have been made in or for a Member State of the Paris Convention ~~or in a State which has concluded an equivalent bilateral or multilateral agreement with the Office~~.

international

~~Art 87(5)~~

/ A comprehensive list of all the States concerned will ultimately be appended to these Guidelines 7. The words "*in or for*" any Paris Union State mean that priority may be claimed of an earlier national ~~application~~, ~~European application~~ or ~~PCT~~ application. The earlier application may be for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate. So long as the contents of the application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the ~~outcome~~ of the application may later be; for example, it may subsequently be abandoned or refused.

, regional, international

~~Art 87(2)~~
~~Art 87(3)~~

final disposition

SU: No comments

(comments from GB on the following page)

CHAPTER V (contd.)

1 The right to priority (contd.)

paragraphs 1.1 to 1.3 (contd.)

GB:

1.1 An ~~European~~ International application is accorded as its date of filing ~~the date on which it satisfies the requirements of Article 80, or, if filed under the PCT~~, the date on which it satisfies PCT Article 11. This date remains unchanged except in the special circumstances of late-filed drawings provided for in ~~Article 91, paragraph 6 and PCT~~ Article 14, paragraph 2. The date of filing may be the only effective date of the application. It will be of importance for fixing the expiry of certain time limits ~~(e.g. the date by which the designation of the inventor must be filed under Article 91, paragraph 5)~~, and for determining the ~~state of the~~ prior art relevant to the novelty or obviousness of the subject-matter of the application, ~~and for determining, in accordance with Article 60, paragraph 2, which of two or more European applications from independent persons for the same invention is to proceed to grant~~.

Art 89

1.2 However, in many cases, an International application will claim the right of priority of the date of filing of an earlier application. In such cases, it is the priority date (i.e. the date of filing of the earlier application) which becomes the effective date for the purposes mentioned in the preceding paragraph.

Art 87(1)

1.3 For a valid claim to priority, several conditions must be satisfied: the earlier application whose priority is claimed must have been made by the ~~European~~ applicant or his predecessor in title; it must have been filed not more than 12 months before the filing date of the European application; and it must have been made in or for a Member State of the Paris Convention ~~or in a State which has concluded an equivalent bilateral or multilateral agreement with the Office~~.

Art 87(5)

[A comprehensive list of all the States concerned will ultimately be appended to these Guidelines]. The words "*in or for*" any Paris Union State mean that priority may be claimed of an earlier national application, European application or PCT application. The earlier application may be for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate. So long as the contents of the application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the outcome of the application may later be; for example, it may subsequently be abandoned or refused.

Art 87(2)
Art 87(3)

28 → paragraphs 1.4 and 1.5

US:

priority

~~Art 87(4)~~

1.4 Normally, the application ~~the priority of whose date of filing is claimed~~ must be the first application that has been filed for the invention. However, a subsequent application for the same subject-matter and filed in or for the same State shall be considered as the first application for priority purposes if, when this subsequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The International Preliminary Examining Authority ~~Office~~ will not consider this question unless there is evidence of the existence of an earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that an earlier application for the same subject-matter exists, the applicant should be required to establish by evidence from an appropriate authority (normally a national patent office) that there were no rights outstanding in the earlier application.

CHAPTER V (contd.)

1 The right to priority (contd.)

28 → paragraphs 1.4 and 1.5 (contd.)

US: (contd)

Art 8(1)

An international ~~Art 88(2)~~ 1.5 *"Multiple priorities may be claimed"* - ~~i.e. a European~~ application may claim rights of priority based on more than one earlier application. The earlier application may have been filed in or for the same or different States, but in all cases the earliest application must have been filed not more than 12 months before the date of filing of the ~~European~~ application. An element of ~~a European~~ application will be accorded the priority date of the earliest priority application which includes it. If, for instance, the ~~European~~ application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the ~~European~~ application; embodiment A will have the French priority date and embodiment B the German priority date. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the different priority dates. If, on the other hand, ~~a European~~ application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the ~~European~~ application itself. In other words, it is not normally permitted to mosaic priority documents. An exception might arise where one priority document contains a reference to the other.

~~Art 88(2)~~

international

~~Art 88(2)~~

an international

international

international

an international

international

SU: No comments

GB:

Art 87(4) 1.4 Normally, the application, the priority of whose date of filing is claimed, must be the first application that has been filed for the invention. However, a subsequent application for the same subject-matter and filed in or for the same State shall be considered as the first application for priority purposes if, when this subsequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority.

Is this necessary for IPEAs? → The Office will not consider this question unless there is evidence of the existence of an earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that an earlier application for the same subject-matter exists, the applicant should be required to establish by evidence from an appropriate authority (normally a national patent office) that there were no rights outstanding in the earlier application.

CHAPTER V (contd.)

1 The right to priority (contd.)

28 → paragraphs 1.4 and 1.5 (contd.)

GB: (contd)

Art 88(2)

Art 88(3)

Not necessary for IPEAs. →

~~1.5 "Multiple priorities may be claimed" - i.e. a European application~~ may claim rights of priority based on more than one earlier application. The earlier application may have been filed in or for the same or different States, but in all cases the earliest application must have been filed not more than 12 months before the date of filing of the European application. An element of a European application will be accorded the priority date of the earliest priority application which includes it. If, for instance, the European application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the European application; embodiment A will have the French priority date and embodiment B the German priority date. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the different priority dates. If, on the other hand, a European application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the European application itself. In other words, it is not normally permitted to mosaic priority documents. An exception might arise where one priority document contains ~~a reference to the other~~.

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2 Determining priority dates

US:

need only be considered in detail by the examiner

2.1 As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right ~~claimed is important~~ if the subject-matter of the invention has been published ~~within the meaning of Article 54, paragraph 2~~ on or after the priority date claimed and before the date of filing (see IV, 5.3), ~~and forms part of the content of another European application within the~~ meaning of Article 54, paragraph 3, such other application claiming a priority date within that period and designating one or more of the same States (see IV, 6). In such cases, the examiner must satisfy himself that the priority date(s) claimed may be accorded to the appropriate parts of the application he is examining. Also, in the case of possible conflict with another European applicatic. under Article 54, paragraph 3, it may be necessary in addition to allocate priority dates to the ~~appropriate parts of that other application.~~

2.2 When the examiner needs to consider the question of priority date, he should bear in mind all the matters which are mentioned in 1.3 to 1.5 above. He should also remember that, to establish a priority date, it is not necessary that all of the elements of the invention for which priority is claimed should be found among the claims in the previous application. It is sufficient that the documents of the previous application taken as a whole ~~specifically disclose~~ such elements. The description and any claims or drawings of the previous application should, therefore, be considered as a whole in deciding this question, except that account should not be taken of subject-matter found solely in that part of the description referring to prior art, or in an explicit disclaimer.

CHAPTER V (contd.)

2 Determining priority dates (contd.)

paragraphs 2.1 to 2.5 (contd.)

2.3 The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely implied or referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. Exact correspondence is not required, however. It is enough that, on a reasonable assessment, there is in substance a disclosure of all the important elements of the claim.

US: (contd)

2.4 On the other hand, an element claimed broadly and generally in the ~~European~~ international application should be considered to be ~~specifically disclosed~~, if there is a particular disclosure of that element in the priority document and the generalization is obvious from that particular disclosure. For example, a claim to apparatus including "*releasable fastening means*" would normally be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, even when the earlier disclosure does not refer to the fastening element in broad terms.

2.5 If the tests set out in 2.2 to 2.4 are not satisfied in relation to a particular earlier application, then the effective date of the claim ~~(or part of the claim or description)~~ will either be the priority date of the earliest application which does provide the required disclosure or, in the absence of such, will be the date of filing of the ~~European~~ international application itself (or the new date of filing if the application has been re-dated under ~~Article 91, paragraph (1)~~ Rule 4(2) or Rule 20.2).

SU: No comments

GB: Delete this section, not necessary for IPEAs

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3 Claiming priority

US:

3.1 An applicant who wishes to claim priority must ~~file a declaration of priority~~ state this on the request form giving particulars of the previous filing, as specified in Rule ~~38, paragraph 1, together with~~ 17.1 and file a certified copy of the previous application and if necessary a translation of it into one of the official languages of the ~~Office~~ International Preliminary Examining Authority with the International Bureau or directly with the International Preliminary Examining Authority.

3.2 The date and State of any filing from which priority is claimed must be stated at the time of filing the ~~European~~ international application and the ~~file~~ number of the priority application must be indicated within 16 months of the priority date. The certified copy of the priority document must be filed also within 16 months of the priority date, and where a translation is required this must be filed within 2 months of ~~the priority date~~ invitation by the International Preliminary Examining Authority. In the case of ~~a European~~ an international application ~~which is filed under the PCT~~, Rule 17.1 ~~of the PCT~~ requires the applicant to file the certified copy of the earlier application with the International Bureau. ~~In such cases the provisions of the PCT prevail and Article 88, paragraph 1 and Rule 38, paragraph 3, do not apply, and~~ The examiner must request the International Bureau to supply a copy under the terms of

CHAPTER V (contd.)

3 Claiming priority

US (contd):

an official language of the International Preliminary Examining Authority

~~PCT~~ Rule 17.2. If the earlier application whose priority is claimed is not in ~~English, French or German~~, the ~~PCT~~ applicant must still provide a translation of it in one of these languages, as is permitted by ~~PCT~~ Rule 17.2 ~~and required by Article 28, paragraph 1 and Rule 38, paragraph 4~~. In the exceptional case where there has been an early request for examination and examination is thus due to commence before the ~~expiry~~ of the time limits mentioned, if the copy of the priority document or the translation (where required) has not been received, the applicant should be informed that examination will be delayed until the required document is received.

expiration

3.3 Further details concerning the claiming of priority are given in the Guidelines for Formalities Examination since the procedure involved will normally be handled by the Receiving ~~Section~~.

Office or the International Bureau

SU: No comments

GB: Redraft in terms of Article 8 and Rules 4.10 and 17

CHAPTER VI

EXAMINATION PROCEDURE

1 The start of the examination

(29) → paragraph 1.1

US:

CHAPTER VI

INTERNATIONAL PRELIMINARY EXAMINATION PROCEDURE

This Chapter sets out the general procedure for examination, together with guidance on particular matters where necessary. It does not provide detailed instructions on matters of internal administration.

Art 39(1)

Demand for Preliminary Examination

expiration of 25 months after the priority

~~Art 157(1)~~

~~Art 150(2)~~

1 *The start of the examination* an international

1.1 In order that examination of ~~a European~~ application can begin, the applicant is required to file a ~~request for examination~~ and he may do this at any time before the ~~expiry of six months after the~~ date on which ~~the European Patent Bulletin mentions the publication of the search~~ report. If the application has proceeded via the PCT (see VI, 10), this six months period runs from the date of publication of the PCT search report under PCT Article 21, or a declaration made under PCT Article 17, paragraph 2(a). However, as is made clear in Article 150, paragraph 2, the time limit for requesting examination in a PCT case does not expire ~~before the time prescribed in Article 22 of the PCT.~~

SU:

Art. 31 PCT

61. The international preliminary examination is carried out on the demand of the applicant which is made separately from the international application. The demand should contain the prescribed particulars and should be in the prescribed language and form.

GB:

(This Chapter is not generally applicable to PCT)

CHAPTER VI

*EXAMINATION PROCEDURE*

This Chapter sets out the general procedure for examination, together with guidance on particular matters where necessary. It does not provide detailed instructions on matters of internal administration.

1 *The start of the examination*

Art 94 'demand'

Redraft in terms of Article 31 →

Art 157(1)
Art 150(2)

1.1 In order that examination of a European application can begin, the applicant is required to file a request for examination and he may do this at any time before the expiry of six months after the date on which the European Patent Bulletin mentions the publication of the search report. If the application has proceeded via the PCT (see VI, 10), this six months period runs from the date of publication of the PCT search report under PCT Article 21, or a declaration made under PCT Article 17, paragraph 2(a). However, as is made clear in Article 150, paragraph 2, the time limit for requesting examination in a PCT case does not expire before the time prescribed in Article 22 of the PCT.

CHAPTER VI (contd.)

1 The start of the examination (contd.)

29 → paragraphs 1.2 to 1.4

(This section should be amended to contain Rule 62 procedure.)

US:

~~1.2 The Receiving Section remains responsible until the examination request has been filed, or if it was filed before transmission of the search report, until the applicant has replied, within the period set, to the invitation made under Article 96, paragraph 1, to the effect that he intends to continue with the application. When the Receiving Section ceases to be responsible, the dossier relating to the application is passed to Munich.~~ (Art. 10(1))

1.3 In Munich, the ~~dossier~~ application file will be ~~allotted~~ assigned to an Examining Division responsible for the examination of applications in the technical field in which the particular application has been classified by the ~~Search Division or PCT~~ International Searching Authority which carried out the search. If the classification is found to be incorrect, ~~however,~~ the application may be transferred to another Examining Division. The settlement of disputes regarding the correct classification will be the responsibility of a Classification Section ~~acting on behalf of the President under Rule 9, paragraph 1.~~ (Rule 9(1)) Applications may be transferred to other Examining Divisions ~~also~~ for other reasons, e.g. to balance the work load, ~~the allotment of applications to the various Examining Divisions being subject to overall administrative control by the Directorate into which the Divisions are grouped.~~

the International Preliminary Examining Authority

1.4 An Examining Division will normally consist of three technical examiners. However, within ~~the~~ Examining Division ~~one member is responsible for the application,~~ one member will, as a general rule, be entrusted to carry out all the work up to the ~~point of a decision to grant a patent or refuse the application.~~ This means that this examiner is entrusted to act on behalf of the Examining Division in all communications with the applicant up to that point, but he may confer informally with the other members of the Division at any time if a special point of doubt or difficulty arises (see VI, 7.1). Where reference is made in these Guidelines to the "examiner", this normally means the examiner entrusted with ~~the~~ work ~~in this way~~, and it should be understood that ~~this examiner~~ he is always acting in the name of the Examining Division.

an issuance of the International Preliminary Examination Report (Art. 18(2))

this he

SU: No comments

GB: Delete paragraphs 1.2 to 1.4

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2 Examination procedure in general

paragraph 2.1

US:

2.1 The purpose of the ~~examination~~ Preliminary examination procedure in general is to ~~ensure that the application and the invention to which it relates, meet~~ render an opinion as to whether the international application meets the requirements set out in ~~the relevant Articles of the Convention and the Implementing Regulations.~~ (Art. 94) The prime task of the Examining Division is to deal with the substantive requirements; the criteria by which an examiner shall judge whether they

Article 31 of the Treaty

CHAPTER VI (contd.)

2 Examination procedure in general

paragraph 2.1 (contd.)

US (contd): Office (see the Receiving Office Guidelines). normally accept Office.

have been met, are dealt with in detail, in so far as appears necessary, in the other Chapters of these Guidelines. As for the formal requirements ~~(see the Guidelines for Formalities Examination)~~, these are initially the responsibility of the Receiving ~~Section at The Hague~~. As soon as the application has passed to ~~Munich~~ the Examining Division will have ultimate responsibility, ~~but formal matters will normally be dealt with by the Formalities Section in Munich~~. The examiner should ~~not spend time checking~~ the work done by the Receiving ~~Section or this Formalities Section, but if he believes a formalities report is incorrect or incomplete he should refer the application to the Formalities Section for further consideration~~.

SU: Art. 33 PCT

9. The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable.

GB: Art 94

Redraft referring to ROs, IB and ISAs →

2.1 The purpose of the examination is to ensure that the application and the invention to which it relates, meet the requirements set out in the relevant Articles of the ~~Convention~~ Treaty and the ~~Implementing~~ Regulations. The prime task of the ~~Examining Division~~ Examiner is to deal with the substantive requirements; the criteria by which an examiner shall judge whether they have been met, are dealt with in detail, in so far as appears necessary, in the other Chapters of these Guidelines. As for the formal requirements (see the Guidelines for Formalities Examination), these are initially the responsibility of the Receiving Section at The Hague. As soon as the application has passed to Munich the Examining Division will have ultimate responsibility, but formal matters will normally be dealt with by the Formalities Section in Munich. The examiner should not spend time checking the work done by the Receiving Section or this Formalities Section, but if he believes a formalities report is incorrect or incomplete he should refer the application to the Formalities Section for further consideration.

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paragraph 2.2

US: international the demand; ~~Rule 54(1)~~ correspondence concerning informalities Office;

2.2 The examination is to be carried out in accordance with Article 34 ~~96, paragraphs 2 and 3, Article 97, Rule 51, paragraphs 2 to 6 and Rule 53~~. The examiner's first step is to study the description, drawings (if any) and the claims of the application. In carrying out his task, the examiner will have in the dossier the documents making up the ~~European~~ application and a complete history of the proceedings up to the start of the examination. In particular, this dossier will include: the request; ~~the~~ description, drawings (if any) and the claims as originally filed; any amendments proposed to date; the search report with the applicant's comments (if any); ~~and~~ copies of any cited documents; the ~~formalities report~~ from the Receiving ~~Section~~ and the priority documents together with any translations (see V, 3).

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

2 Examination procedure in general (contd.)

paragraph 2.2 (contd.)

SU:

64. Before the international preliminary examination begins, the international application should contain the following:

- request
- description
- claims
- drawings refered to in the description
- abstract
- international search report
- annexed to the international search report: the copies of the priority documents cited, replacement sheets with amendments and corrections to the application, if any.
- demand for the international preliminary examination
- information on payment of fees.

Rule 66 PCT

71. The international preliminary examination should initially be directed to the claims, the description and the drawings, as contained in the international application at the time the international preliminary examination starts. The International Preliminary Examining Authority may notify the applicant accordingly in writing as to the defects of his application as provided by PCT Rule 66.2. The notification should invite the applicant to submit a written reply with amendments and/or corrections within the prescribed time limits, where appropriate. The International Preliminary Examining Authority may issue one or more additional written opinions and may give the applicant one or more additional opportunities to submit amendments or corrections within the prescribed time limit. The International Preliminary Examining Authority may unofficially communicate with the applicant (by means of telephone, letter or interview). The said Authority decides whether to have an interview with the applicant on the request of the latter, or to reply to his unofficial letter.

GB:

and Rule 70

2.2 The examination is to be carried out in accordance with Article ~~96,~~ 33(1) ~~paragraphs 2 and 3, Article 97, Rule 51, paragraphs 2 to 6 and Rule 52~~. The examiner's first step is to study the description, drawings (if any) and the claims of the application. In carrying out his task, the examiner will have in the dossier the documents making up the ~~European~~ International application and a complete history of the proceedings up to the start of the examination. In particular, this dossier will include the request for grant; description, drawings (if any) and the claims as originally filed; any amendments proposed to date; the search report with the applicant's comments (if any), and copies of any cited documents; the formalities report from the Receiving ~~Section~~ Office and the priority documents together with any translations (see V, 3).

Rule 51(1)

CHAPTER VI (contd.)

2 Examination procedure in general (contd.)

paragraph 2.3

US: ~~2.3 When the examiner has studied and understood the claims (including any amended claims), he should make a search for any additional conflicting European applications falling within the area defined by Article 54, paragraph 3 (see VI, 2.4).~~

SU: No comments

GB: Delete paragraph 2.3

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paragraph 2.4

US: 2.4 Taking into account the documents (if any) cited in the search report ~~and any further documents found as the result of the search referred to in VI, 2.3 above~~ and ~~taking account~~ also of any amendments that may have been proposed, or comments made, by the applicant, the examiner should identify any requirements of the ~~Convention and Implementing Regulations~~ which, in his opinion, the application does not satisfy. He will then write to the applicant giving reasons for any objections ~~he raises~~ and inviting the applicant within a specified period to file his observations or submit amendments. The filed application documents are not ~~sent back~~ to the applicant; the procedure for making amendments is explained in VI, 5.1 and 5.2. When the applicant has ~~replied~~, the examiner will then reexamine the application.

international
Treaty
66
Rule ~~51 (3)~~
raised
34
Art ~~96(2)~~
~~Rule 51(2)~~
returned
responded

SU: Rule 66 PCT — 71. The international preliminary examination should initially be directed to the claims, the description and the drawings, as contained in the international application at the time the international preliminary examination starts. The International Preliminary Examining Authority may notify the applicant accordingly in writing as to the defects of his application as provided by PCT Rule 66.2. The notification should invite the applicant to submit a written reply with amendments and/or corrections within the prescribed time limits, where appropriate. The International Preliminary Examining Authority may issue one or more additional written opinions and may give the applicant one or more additional opportunities to submit amendments or corrections within the prescribed time limit. The International Preliminary Examining Authority may unofficially communicate with the applicant (by means of telephone, letter or interview). The said Authority decides whether to have an interview with the applicant on the request of the latter, or to reply to his unofficial letter.

GB: 2.4 Taking into account the documents (if any) cited in the search report ~~and any further documents found as the result of the search referred to in VI, 2.3 above~~, and taking account also of any amendments that may have been proposed, or comments made, by the applicant, the examiner should identify any requirements of the Treaty ~~Convention~~ and ~~Implementing~~ Regulations which, in his opinion, the application does not satisfy. He will then write to the applicant giving reasons for any objections he raises and inviting the applicant within a specified period to file his observations or submit amendments. ~~The filed application documents are not sent back to the applicant; the procedure for making amendments is explained in VI, 5.1 and 5.2.~~ When the applicant has replied, the examiner will then reexamine the application.

Rule 51 (3)
Refer to Article 34(2)(d) → Art 96(2)
Rule 51(2)

CHAPTER VI (contd.)

2 Examination procedure in general (contd.)

(30) → paragraph 2.5

US:

2.5 The examiner should be guided at the re-examination stage by the over-riding principle that a final position ~~(grant or refusal)~~ should be reached in as few actions as possible, and he should control the procedure with this always in mind. The ~~Convention~~ provides that the process of communicating with the applicant described in VI, 2.4 shall be repeated ~~"as often as necessary"~~. Nevertheless, if it is clear that the applicant is not making any real effort to deal with the examiner's objections, either by amendments or by counter-arguments, then even at the first re-examination stage the examiner should bring the application before the other members of the Examining Division, who may decide to ~~refuse the application~~. In any event, at some stage, the examiner will make a short written ~~recommendation to the Division either that the application should be refused or that a patent should be granted thereon. If the Division intends to refuse the application a written reasoned decision is necessary, and this will normally be prepared by the examiner entrusted with the examination of the application~~. In preparing the ~~decision~~, the examiner must take care to abide by the general principles set out in Article ~~113~~, ~~i.e. the decision must be based on grounds or evidence on which the applicant has had the opportunity to comment. If the applicant appeals against the decision, and the Examining Division~~ considers in the light of the applicant's statement, that the appeal is admissible and well-founded, it should rectify its decision accordingly. Otherwise, the appeal will be considered by a Board of Appeal. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the Examining Division for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. ~~The Examining Division is bound by the decision of the Board of Appeal.~~

Treaty ~~Art 96(2)~~ if the Authority so wishes.

~~Art 97~~ issue the International Preliminary Examination report

~~Rule 68(2)~~ statement under Article 35(2)

~~Art 113(1)~~ International Preliminary Examination report 34 and 35

~~Art 109~~

~~Art 111(1)~~

Art 111(2)

SU:

Rule 66 PCT

71. The international preliminary examination should initially be directed to the claims, the description and the drawings, as contained in the international application at the time the international preliminary examination starts. The International Preliminary Examining Authority may notify the applicant accordingly in writing as to the defects of his application as provided by PCT Rule 66.2. The notification should invite the applicant to submit a written reply with amendments and/or corrections within the prescribed time limits, where appropriate. The International Preliminary Examining Authority may issue one or more additional written opinions and may give the applicant one or more additional opportunities to submit amendments or corrections within the prescribed time limit. The International Preliminary Examining Authority may unofficially communicate with the applicant (by means of telephone, letter or interview). The said Authority decides whether to have an interview with the applicant on the request of the latter, or to reply to his unofficial letter.

GB: Delete paragraph 2.5

CHAPTER VI (contd.)

2 Examination procedure in general (contd.)

paragraphs 2.6 to 2.9

US:

~~Rule 51(4)~~ ~~2.6 If the Examining Division considers that a European patent should~~ be granted, it will first inform the applicant of the text in which it intends to make the grant (in order that the Examining Division may inform the applicant of minor corrections required and that the applicant can make a final check on this text) and request payment of the appropriate fees within three months and a translation of the claims into the two official languages of the Office other than that of the proceedings. If any designated Contracting States require a translation pursuant to Rule 51(5) Article 65, paragraph 1, such States should be indicated.

Art 97(3)(5) 2.7 The applicant confirms his approval of the text by payment of the appropriate fees and provision of the required translation within three months. If he fails to do so in due time the application will be deemed to be withdrawn.

Rule 51(4) 2.8 If, on the other hand, the applicant communicates within three months his disapproval of the text submitted, then the communication from the Examining Division is deemed not to have been made and the examination is resumed.

2.9 The stages of this procedure are considered in more detail in the following Sections.

SU: No comments

GB: Delete paragraphs 2.6 to 2.9

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3 The first stage of examination

paragraph 3.1

US:

~~Rule 86(2)~~ international ~~Rule 51(1)~~ international International International Searching Authority under Article 17(2)(a)(ii) 13

noted

3.1 Following the receipt of the search report and prior to the examiner's first communication with the applicant, the latter may file comments on the search report and amendments to the description, claims or drawings. These amendments may be submitted to avoid possible objections of lack of novelty or lack of inventive step in view of the citations listed in the search report; or to meet any objections ~~raised~~ by the ~~Search Division under Rule 45~~ (i.e. that at least some claims do not permit of a meaningful search) or Rule 86 (i.e. that there is lack of unity of invention); or ~~have may be envisaged~~ for some other reason, e.g. to remedy some obscurity which the applicant himself has noted in the original documents.

objections may be raised

SU: No comments

(comments from GB on the following page)

CHAPTER VI (contd.)

3 The first stage of examination (contd.)

paragraph 3.1 (contd.)

GB:

Rule 86(2) Rule 51(1)

3.1 Following the receipt of the search report and prior to the examiner's first communication with the applicant, the latter may file comments on the search report and amendments to the description, claims or drawings. These amendments may be submitted to avoid possible objections of lack of novelty or lack of inventive step in view of the citations listed in the search report; or to meet any objections notified by the ~~Search Division~~ ISA under ~~Rule 45~~ Article 17(2)(a) (i.e. that at least some claims do not permit of a meaningful search) or ~~Rule 46~~ Article 17(3)(a) (i.e. that there is lack of unity of invention); or they may be suggested for some other reason, e.g. to remedy some obscurity which the applicant himself has noted in the original documents.

31. → paragraph 3.2

US:

~~Rule 86(2)~~ 3.2 Such amendments are made by the applicant ~~of~~ *of his own volition*. This means that the applicant is not restricted to amendment necessary to remedy a defect in his application. It does not, however, mean that the applicant is free to amend in any way he chooses. Any amendment must satisfy the following conditions:

~~Art 123(2)~~ (a) It must not add subject-matter to the content of the application as filed (see VI, 5.4 to 5.9).

(b) It must not itself cause the application as amended to be objectionable under the ~~Convention~~ Treaty, e.g. the amendment must not introduce obscurity.

(c) It must not result in claims for an invention or inventions not forming unity with the invention or inventions originally claimed and in respect of which search fees have been paid (see III, 7.9 and 7.10).

If the amendments do not meet these conditions, the applicant should be told that the amended application cannot be allowed. ~~In the case of (c), the applicant should be told also that he may file a divisional application in respect of any invention claimed for which a search fee has not been paid.~~ Apart from the amendments referred to above, ~~which are allowed under Rule 86, paragraph 2,~~ the applicant may correct obvious errors at any time (see VI, 5.10).

SU: No comments

(comments from GB on the following page)

CHAPTER VI (contd.)

3 The first stage of examination (contd.)

(31) → paragraph 3.2 (contd.)

GB:

Rule 86(2)

**3.2 Such amendments are made by the applicant "*of his own volition*". This means that the applicant is not restricted to amendment necessary to remedy a defect in his application. It does not, however, mean that the applicant is free to amend in any way he chooses. Any amendment must satisfy the following conditions:**

Art 28 ~~123(2)~~

(a) It must not add subject-matter to the content of the application as filed (see VI, 5.4 to 5.9).

Redraft in terms of Article 19 and Rule 46, and Article 34(2)(b) →

(b) It must not itself cause the application as amended to be objectionable under the ~~Convention~~ Treaty, e.g. the amendment must not introduce obscurity.

(c) It must not result in claims for an invention or inventions not forming unity with the invention or inventions originally claimed and in respect of which search fees have been paid (see III, 7.9 and 7.10).

~~If the amendments do not meet these conditions, the applicant should be~~ told that the amended application cannot be allowed. In ~~the~~ case of (c), the applicant should be told also that he may ~~file~~ a divisional application in respect of any invention claimed ~~for~~ which a search fee has not been paid. Apart from the ~~amendments~~ referred to above, which are allowed under Rule ~~86~~, paragraph 2, the applicant may correct obvious errors at ~~any time (see VI, 5.10)~~.

---

paragraphs 3.3 and 3.4

US:

34(2)(c)

**3.3 The examiner's first letter under Article ~~96, paragraph 2~~ should, as a general rule, cover all objections to the application (but see VI, 3.6). These objections may relate to formal matters (e.g. failure to comply with one or more of the requirements specified in Rules ~~26 to 29, 31, 32, 35 and 36, such objections being normally derived from a report prepared by a formalities officer~~), to substantive matters (e.g. the ~~subject-matter of the application is not patentable~~), or to both.**

5-7 and 9-11

criteria of Article 33(1)

Treaty

**3.4 For each ground of objection the letter should indicate the part of the application which is deficient and the requirement of the ~~Convention~~ which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the main claim or claims, and if consequently there is lack of unity between dependent claims, the applicant should be warned of this situation (see VI, 5.3(i)). Substantive matters should normally be set out first. The letter should be drafted in such a manner as to facilitate re-examination of the amended application and, in particular, to avoid the need for extensive re-reading (see VI, 4.2).**

SU: No comments

GB: Redraft paragraphs 3.3 and 3.4 in terms of Article 34 and Rule 66.2

CHAPTER VI (contd.)

3 The first stage of examination (contd.)

(32) → paragraph 3.5

US:

66.2(c)
Rule ~~51(2)~~
~~Art 96(2)~~
~~Art 96(3)~~

3.5 The letter should end with an invitation to the applicant to file his observations, to correct any formal deficiencies and otherwise to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply. Failure to reply in due time will cause the application to be deemed withdrawn (see VI, 11.6).

SU: No comments

GB:

Redraft in terms of Article 34 and Rule 66.2

3.5 **The letter should end with an invitation to the applicant to file his observations, to correct any formal deficiencies and otherwise to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply.** ~~**Failure to reply in due time will cause the application to be deemed withdrawn (see VI, 11.6)**~~**.**

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(33) → paragraph 3.6

US:

3.6 It is emphasised that the first sentence of VI, 3.3 only sets out the general rule. There may be cases in which the application is generally deficient. In these cases the examiner should not carry out a detailed examination, but should send a letter to the applicant informing him of this fact, mentioning the major deficiencies and ~~saying~~ stating that further examination is deferred until these have been removed by amendment; the letter should specify a period within which the deficiencies must be removed. There may be other cases in which, although a meaningful examination is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments which are not allowable for one of the reasons stated in VI, 3.2. In such cases it may be more appropriate to deal with this objection before making a detailed examination; if, e.g. the claims need re-casting, it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted as a consequence. However, if there are other major objections these should be dealt with. Generally the examiner should at the first examination stage seek to make the maximum impact with the broad aim of bringing matters to a conclusion (grant or refusal, as the case may be), without any undue delay.

SU: No comments

(comments from GB on the following page)

CHAPTER VI (contd.)

3 The first stage of examination (contd.)

(33) → paragraph 3.6 (contd.)

GB:

Redraft referring to Article 35(3) and 34(4)(a) →

3.6 It is emphasised that the first sentence of VI, 3.3 only sets out the general rule. There may be cases in which the application is generally deficient. In these cases the examiner should not carry out a detailed examination, but should send a letter to the applicant informing him of this fact, mentioning the major deficiencies and saying that further examination is deferred until these have been removed by amendment; the letter should specify a period for reply ~~within which the deficiencies must be removed. There may be other cases in which, although a meaningful~~ examination is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments which are not allowable for one of the reasons stated in VI, 3.2. In such cases it may be more appropriate to deal with this objection before making a detailed examination; if, e.g. the claims need re-casting, it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted as a consequence. However, if there are other major objections these should be dealt with. Generally the examiner should at the first examination stage seek to make the maximum impact with the broad aim of bringing matters to a conclusion (grant or refusal, as the ~~case may be), without any undue delay.~~

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paragraphs 3.7 and 3.8

US:

~~Rule 27(1)(d)~~ violating Article 34(2)(b)

3.7 When making the full examination, the examiner should concentrate on trying to understand what contribution the invention as defined in the claims makes to the known art. This should normally be sufficiently clear from the application as filed. If it is not, the applicant should be required to elucidate the matter (see II, 4.6); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus ~~offending against Article 123, paragraph 2~~ (see VI, 5.4 to 5.9).

Treaty

3.8 Although the examiner must bear in mind all the requirements of the ~~Convention and Implementing Regulations~~, the requirements which are most likely to require attention in the majority of cases are sufficiency of disclosure (see II, 4); clarity, especially of the independent claims (see III, 4); novelty (see IV, 5); and inventive step (see IV, 9).

SU: No comments

GB:

Rule 27(1)(d)

3.7 When making the full examination, the examiner should concentrate on trying to understand what contribution the invention as defined in the claims makes to the known art. This should normally be sufficiently clear from the application as filed. If it is not, the applicant should be required to elucidate the matter (see II, 4.6); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus offending against Article ~~123,~~ 34(2)(b) ~~paragraph 2 (see VI, 5.4 to 5.9)~~.

3.8 Although the examiner must bear in mind all the requirements of the Treaty ~~Convention~~ and Implementing Regulations, the requirements to which special attention are ~~are most likely to require~~ he should direct his in the majority of cases, ~~are~~ sufficiency of disclosure (see II, 4); clarity, especially of the independent claims (see III, 4); novelty (see IV, 5); and inventive step (see IV, 9).

CHAPTER VI (contd.)

3 The first stage of examination (contd.)

paragraphs 3.9 to 3.11

US:

3.9 The examiner should not require or suggest amendments merely because he thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims should be clear. Also, while any serious inconsistencies between the claims and the description as filed should be objected to (see III, 4.3), if the claims appear to require substantial amendment the examiner should not require the applicant to amend the description as well, merely in order to bring it into conformity with the amended claims, since such consequential amendments are better left until the final form of at least the main claims has been settled.

3.10 It must be emphasised that it is not part of the duty of an examiner to require the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the ~~Convention~~ Treaty. However, it may sometimes be useful if the examiner suggests, at least in general terms, an acceptable form of amendment, but if he does so he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered.

3.11 Between receipt of the search report and receipt of the first communication from the examiner, the applicant may submit amendments at any time. These amendments may occasionally arrive after despatch of such communication. In such a case the examiner will have to repeat part of his examination to take them into account and, consequently, may have to issue a supplementary or amended ~~report~~ international opinion.

SU: No comments

GB:

3.9 The examiner should not ~~require or~~ suggest amendments merely because he thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims should be clear. Also, while any serious inconsistencies between the claims and the description as filed should be ~~objected to~~ pointed out (see III, 4.3), if the claims appear to require substantial amendment the examiner should not ~~require~~ request the applicant to amend the description as well, merely in order to bring it into conformity with the amended claims, since such consequential amendments are better left until the final form of at least the main claims has been settled.

3.10 It must be emphasised that it is not part of the duty of an examiner to ~~require~~ request that the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the ~~Convention~~ Treaty. However, it may sometimes be useful if the examiner suggests at least in general terms an acceptable form of amendment, but if he does so he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered.

3.11 Between receipt of the search report and receipt of the first communication from the examiner, the applicant may submit amendments at any time. These amendments may occasionally arrive after despatch of such communication. In such a case the examiner will have to repeat part of his examination to take them into account and, consequently, may have to issue a supplementary or amended ~~report.~~ written opinion.

Rule 86(2)

CHAPTER VI (contd.)

4 Further stages of examination

General procedure

paragraphs 4.1 and 4.2

US:

General procedure

4.1 Following the examiner's first ~~letter~~ opinion and the applicant's reply, the examiner must re-examine the application taking into account observations or amendments made by the applicant.

4.2 The examiner should apply the same standard of examination in relation to matters of substance at all stages in the processing of an application. However, after the first examination stage, he will not normally need to completely re-read the amended application if he has drafted his first letter in a comprehensive way (see VI, 3.4), but should concentrate on the amendments themselves and any related passages, and on the deficiencies noted in the letter.

SU: No comments

GB:

4.1 **Following the examiner's first** ~~**letter**~~ **written opinion and the applicant's reply,** will normally **the examiner** ~~**must**~~ **re-examine the application taking into account observations or amendments made by the applicant.**

4.2 **The examiner should apply the same standard of examination in relation to matters of substance at all stages in the processing of an application. However, after the first examination stage, he will not normally need to completely re-read the amended application if he has drafted his first letter in a comprehensive way (see VI, 3.4), but should concentrate on the amendments themselves and any related passages, and on the deficiencies noted in the letter.**

Redraft referring to Rule 66.4 →

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paragraphs 4.3 to 4.5

US:

4.3 If this re-examination shows that the applicant has not made any real effort to deal with the objections, the examiner should bring the application to the attention of the other members of the Division with a ~~written~~ recommendation as to the action to be taken (see VI, 7.3). In the majority of cases, however, the re-examination will show that a *bona fide* attempt has been made to meet the examiner's objections. In these cases, if there are still objections that require to be met, the examiner must consider whether they could best be resolved by a further written action, a telephone discussion or an interview. It should be noted that such discussions or interviews do not constitute oral proceedings (see VI, 13).

CHAPTER VI (contd.)

4 Further stages of examination (contd.)

paragraphs 4.3 to 4.5 (contd.)

US: (contd)

4.4 If the matters are such that the applicant is likely to require time to consider them, it will probably be preferable to deal with them by means of a written action. If, however, there seems to be confusion about points in dispute, e.g. if the applicant seems to have misunderstood the examiner's argument, or if the applicant's own argument is not clear, then it may expedite matters if the examiner proposes an interview. On the other hand, if the matters to be resolved are minor, or can quickly and easily be explained and dealt with, then they might be settled more expeditiously by telephone discussion. Discussion with the applicant by interview or telephone is more fully considered in VI,6.

4.5 Similar considerations apply to later stages of re-examination except that, having regard to the principle stated in VI, 2.5, the greater the number of actions which have already taken place, the greater is the likelihood that the most appropriate action is to refer the application to the other members of the Examining Division for a final decision.

SU: No comments

GB: Delete paragraphs 4.3 to 4.5, not really applicable to IPEAs

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Examination of amendments

(34) → paragraphs 4.6 and 4.7

US:

66.3
Rule ~~86(3)~~

4.6 After receipt of the first communication from the examiner, the applicant may ~~of~~ *of his own volition, amend once the description, claims and drawings* provided that the amendment is filed at the same time as his reply. Thus for any amendment filed with the reply to the first letter, the conditions set out in VI, 3.2 apply.

~~Rule 86(3)~~ ~~4.7 However, after replying to the first communication the applicant~~ may amend only if the examiner consents to the amendments proposed. The

Rule 51(2)

examiner should allow any amendments necessary to correct any deficiencies which he has reported in a communication to the applicant. He should also give his consent to restriction of the scope of the claims or to amendments which improve the clarity of the description or claims in a manner clearly desirable, and without changing the subject-matter content ~~connected at any time. Any subsequent request to withdraw an amendment~~ is itself a request for further amendment; thus, if this subsequent request occurs after reply to the first communication from the examiner, it will be allowed only if the examiner consents. It should be noted that consent to an amendment does not necessarily imply that the application as amended is free from any objection under the Convention. Further considerations relating to amendments are dealt with in the ~~following section.~~

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

4 Further stages of examination (contd.)

Examination of amendments (contd.)

(34) → paragraphs 4.6 and 4.7 (contd.)

SU: No comments

GB:

Rule 86(3)

Redraft in terms of Rule 66.2(c) →

4.6 **After receipt of the first communication from the examiner, the** applicant may "*of his own volition, amend once the description, claims and drawings*" provided that the amendment is filed at the same time as his reply. Thus for any amendment filed with the reply to the first letter, the conditions set out in VI, 3.2 apply.

Rule 86(3)

Rule 51(2)

4.7 ~~However, after replying to the first communication the applicant may amend only if the examiner consents to the amendments proposed~~. The examiner should allow any amendments necessary to correct any deficiencies which he has reported in a communication to the applicant. He should also give his consent to restriction of the scope of the claims or to amendments which improve the clarity of the description or claims in a manner clearly desirable, and without changing the subject-matter content or scope of these. Also, as stated in VI, 3.2, obvious errors may be corrected at any time. ~~Any subsequent request to withdraw an amendment~~ is itself a request for further amendment; thus, if this subsequent request occurs after reply to the first communication from the examiner, it will be allowed only if the examiner consents. It should be noted that consent to an amendment does not necessarily imply that the application as amended is free from any objection under the Convention. Further considerations relating to amendments are dealt with in the ~~following Section~~.

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5 Amendments - General considerations

Making the amendments

paragraphs 5.1 and 5.2

US:

Making the amendments

Rule 26.4

5.1 The applicant will generally amend the description and claims by filing replacement pages ~~in triplicate~~, but where on any page the amendment required is slight and the total number of such amendments is not excessive, or where whole pages or paragraphs are to be cancelled, the applicant may list such amendments in a letter and request the Office to effect them.

5.2 A similar procedure should apply to amendments of drawings, i.e. where the amendment is very slight, e.g. altering a reference numeral, or is merely the cancellation of one or more entire figures, then the applicant may request the Office to effect it. If, however, the amendment is not straightforward or cannot readily be effected on the existing drawings in a clear and unambiguous manner, it will be necessary for the applicant to file replacement sheets of the drawings affected.

~~(The above paragraphs 5.1 and 5.2 may require reconsideration in the light of decisions taken as to the form of the publication of the European patent under Article 98.)~~

CHAPTER VI (contd.)

5 Amendments - General considerations (contd.)

Making the amendments (contd.)

paragraphs 5.1 and 5.2 (contd.)

SU: No comments

GB: Redraft paragraphs 5.1 and 5.2 in terms of Rule 66.8

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Allowability of amendments

US:

Treaty — 5.3 An amended application must of course satisfy all the requirements of the ~~Convention~~ including, in particular, inventive step and the other matters listed in VI, 3.8 (see also VI, 3.2). Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage:

Rule 13 and — (i) Unity of invention: Do the amended claims still satisfy the requirements of ~~Article 17~~ international? If the search report seems to reveal lack of novelty or inventive step in the concept common to all the claims, ~~but~~ the amended claims do not necessitate further search, the examiner should not object to lack of unity of invention (see III, 7.6). If, however, the claims lack a common inventive concept and a further search is necessary, objection should be raised.

For example, is a — (ii) Agreement of description and claims: If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? ~~I.e. e.g.~~ every embodiment of the invention described still within the scope of one or more claims? (see III, 4.3). Conversely, are all of the amended claims supported by the description? (see III, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment?

violates 34(2)(b) — It is important also to ensure that no amendment adds to the content of the application as filed and thus ~~offends against~~ violates Article ~~123, paragraph 2~~ 34(2)(b) as explained in the following paragraphs.

SU: No comments

GB:

5.3 An amended application must of course satisfy all the requirements of the ~~Convention~~ Treaty including, in particular, inventive step and the other matters listed in VI, 3.8 (see also VI, 3.2). Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage:

CHAPTER VI (contd.)

5 Amendments - General considerations (contd.)

Allowability of amendments (contd.)

GB:

Redraft in terms of Rule 68 →

(i) Unity of invention: Do the amended claims still satisfy the requirements of Article 82? If the search report seems to reveal lack of novelty or inventive step in the concept common to all the claims, but the amended claims do not necessitate further search, the examiner should not object to lack of unity of invention (see III, 7.6). If, however, the claims lack a common inventive concept and a further search is necessary, objection should be raised.

(ii) Agreement of description and claims: If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? Is e.g. every embodiment of the invention described still within the scope of one or more claims? (see III, 4.3). Conversely are all of the amended claims supported by the description? (see III, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment?

It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against Article ~~123, paragraph 2,~~ 34(2)(b) as explained in the following paragraphs.

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Additional subject-matter

paragraph 5.4

US:

amendment entered

~~Art 123(2)~~

5.4 There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant; indeed this may be required by the examiner. Nor will the straightforward clarification of an obscurity, or the resolution of an inconsistency, be objected to. When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the ~~application as so amended~~ cannot be ~~allowed~~.

SU: No comments

GB:

Art 123(2)

5.4 There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant~~, indeed this may be required by the examiner.~~ Nor will the straightforward clarification of an obscurity, or the resolution of an inconsistency, be objected to. When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the application as so amended cannot be allowed.

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paragraph 5.5

US:

not be entered

5.5 An amendment should be regarded as extending the content of the application, and, therefore, ~~unallowable~~, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which differs from that previously presented by the application.

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

5 Amendments - General considerations (contd.)

Additional subject-matter (contd.)

paragraph 5.5 (contd.)

SU: No comments

GB: No comments

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paragraph 5.6

US: 5.6 The fresh subject-matter may be introduced by explicitly mentioning matter which was either not previously mentioned at all, or only implied. For example, if ~~an application related~~ to a rubber composition comprising several ingredients, ~~and~~ the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be objected to as ~~offending against~~ Article ~~123, paragraph 2~~ violating 34(2)(b). Likewise, in an application which described and claimed apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs (see, however, VI, 5.7).

in an application relating

SU: No comments

GB: 5.6 **The fresh subject-matter may be introduced by explicitly mentioning matter which was either not previously mentioned at all, or only implied. For example, if an application related to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be objected to as offending against Article ~~123, paragraph 2~~ 34(2)(b) Likewise, in an application which described and claimed apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs (see, however, VI, 5.7).**

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paragraphs 5.7 to 5.9

US: 5.7 If, however, the applicant can show convincingly that the subject-matter in question would, in the context of the invention, be so well-known to the person skilled in the art that its introduction could be regarded as an obvious clarification, and, therefore, as not extending the content of the application, it may be permitted. For example, in the matter of the rubber composition referred to in VI, 5.6, if the applicant were able to show that the further ingredient which he sought to introduce was, ~~in fact,~~ a well-known additive normally used in rubber compositions of that kind as an aid to mixing and that its omission would generally be questioned, then ~~its mention would be allowable~~ on the grounds that it merely clarified the description and introduced nothing not already known to the skilled person; however, if the introduction of this additive brought about some special effects not originally disclosed, an amendment mentioning this should not be ~~allowed~~. Similarly, in the above-mentioned case of the resilient supports, if the applicant were able to demonstrate that the drawings, as interpreted by the skilled person, showed helical springs, or that the skilled person would naturally use helical springs for the mounting in question, the specific ~~mention of helical springs would be allowable.~~

reference to such an additive could be entered

entered

reference to helical springs could be entered.

CHAPTER VI (contd.)

5 Amendments - General considerations (contd.)

Additionsl subject-matter (contd.)

paragraphs 5.7 to 5.9 (contd.)

US: (contd)

5.8 Amendment by the introduction of further examples, e.g. in the chemical field, should always be looked at very carefully, since *prima facie* any further example to illustrate an invention is likely to extend the content of the application.

5.9 As indicated in VI, 5.5, alteration or excision of the text, as well as the addition of further text, may introduce ~~fresh~~ subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene, or to omit this layer altogether would not normally be ~~allowable~~. In each case the panel disclosed by the amended example would be quite different from that originally disclosed and hence the amendment would introduce ~~fresh~~ subject-matter and therefore ~~be unallowable~~.

new

entered

new

not be entered

: No comments

: No comments

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35 → Correction of errors

US:

91
Rule ~~88~~

5.10 Linguistic errors, errors of transcription and other mistakes in any document filed with the Office may be corrected at any time. However, where the mistake is in the description, claims or drawings, the correction must be "*obvious*" in the sense that it is immediately evident from the document which it is sought to correct:

(a) that an error has occurred; and

(b) what the correction should be.

91
Rule ~~86(3)~~

If a correction is not of this character, it cannot be ~~allowed~~ under Rule ~~88~~, but it could nevertheless be ~~allowed~~ under ~~Rule 86, paragraph 3,~~ Article 34 with the consent of the examiner (see VI, 4.7).

91

entered

SU: No comments

GB:

Rule 88

5.10 Linguistic errors, errors of transcription and other mistakes in any document filed with the Office may be corrected at any time. However, where the mistake is in the description, claims or drawings, the correction must be "*obvious*" in the sense that it is immediately evident from the document which it is sought to correct:

(a) that an error has occurred; and

(b) what the correction should be.

~~If a correction is not of this character, it cannot be allowed under Rule~~

Rule 86(3)

88, but it could nevertheless be ~~allowed~~ under Rule 86, paragraph 3, with ~~the consent of the examiner (see VI, 4.7)~~.

CHAPTER VI (contd.)

5 Amendments - General considerations (contd.)

Plural forms of amendment

US:

~~Plural forms of amendment~~

Rule 87

5.11 A situation may arise in which, as a result of amendment, the application has two distinct sets of claims. This possibility is provided for when the "*state of the art*" includes the content of a European application coming within the terms of Article 54, paragraph 3, and some of the Contracting States designated in the application under examination are not designated in that other European application (see IV, 6.3).

5.12 In examining the two sets of claims referred to above, it will generally be found expedient to deal with each one quite separately, especially where the difference between them is substantial. The letter to the applicant will thus be divided into two parts, and the aim will be to have each set of claims, together with the description and drawings, brought into a state where it is in order to proceed to grant.

5.13 As indicated in IV, 6.3, if the examiner considers that the description and drawings are so inconsistent with either set of claims as to create confusion, he should require the applicant to amend the description and drawings to remedy this.

If the applicant voluntarily proposes such amendment the examiner should allow it only if he considers it necessary.

5.14 Hence this type of application will, after amendment, either consist of two distinct sets of claims each supported by the same description and drawings, or two sets of claims each supported by different description and drawings. In either case, each set of claims and its supporting description and drawings may proceed to grant for the appropriate designated States (or may be refused), independently of the other, as though they were separate applications.

Rule 16(2)

5.15 A similar situation may arise where a final decision on entitlement to the grant of a European patent applies to only some of the States designated in the application (see VI, 5.11).

SU: No comments

GB: Delete paragraphs 5.11 to 5.15, not applicable to IPEAs

6 Discussion with the applicant

paragraph 6.1

US:

6.1 The circumstances in which it may be appropriate for the examiner to communicate with the applicant by telephone or propose an interview rather than send a further written action are considered in VI, 4.4. Communication will, in most instances, be with the applicant's authorised agent rather than the applicant himself. If the applicant or his agent requests an interview the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion.

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

6 Discussion with the applicant (contd.)

paragraph 6.1 (contd.)

SU: Rule 66 PCT — 71. The international preliminary examination should initially be directed to the claims, the description and the drawings, as contained in the international application at the time the international preliminary examination starts. The International Preliminary Examining Authority may notify the applicant accordingly in writing as to the defects of his application as provided by PCT Rule 66.2. The notification should invite the applicant to submit a written reply with amendments and/or corrections within the prescribed time limits, where appropriate. The International Preliminary Examining Authority may issue one or more additional written opinions and may give the applicant one or more additional opportunities to submit amendments or corrections within the prescribed time limit. The International Preliminary Examining Authority may unofficially communicate with the applicant (by means of telephone, letter or interview). The said Authority decides whether to have an interview with the applicant on the request of the latter, or to reply to his unofficial letter.

GB: 6.1 ~~The circumstances in which it may be appropriate for the examiner to communicate with the applicant by telephone or propose an interview rather than send a further written action are considered in VI, 4.4.~~ Communication will, in most instances, be with the applicant's authorised agent rather than the applicant himself. If the applicant or his agent requests an interview the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion.

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paragraph 6.2

US: 6.2 When an interview is arranged, whether by telephone or in writing, and whether by examiner or applicant, the matters for discussion should be stated. If the arrangement is made by telephone, the examiner should record the particulars and briefly indicate, on the file, the matters to be discussed.

SU: No comments

GB: No comments

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(36) → paragraph 6.3

US: 6.3 The interview will normally be conducted solely by the examiner who is responsible for ~~dealing with~~ the application. It is not a formal procedure ~~(for formal oral proceedings before the Examining Division, see VI, 1.7)~~, and the recording of the interview depends upon the nature of the matters under discussion. Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the application in order by clearing up a number of minor points it will usually be sufficient if the examiner makes a note on the file of the matters discussed and the conclusions reached, or amendments agreed upon. If, however, the interview is concerned with resolving weightier matters, such as questions of novelty, inventive step, or whether the amendment introduces ~~fresh~~ now subject-matter then a fuller note of the matters discussed should be made in the file. It should always be made clear to the applicant or agent that any agreement reached must ultimately be subject to the views of the other members of the Division.

CHAPTER VI (contd.)

6 Discussion with the applicant (contd.)

(36) → paragraph 6.3 (contd.)

SU: No comments

GB:

6.3 The interview will normally be conducted solely by the examiner dealing with the application. It is not a formal procedure ~~(for formal oral proceedings before the Examining Division, see VI, 13),~~ and the recording of the interview depends upon the nature of the matters under discussion. Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or ~~putting the application in order by~~ clearing up a number of minor points it will usually be sufficient if the examiner makes a note on the file of the matters discussed and the conclusions reached, or amendments agreed. If, however, the interview is concerned with resolving weightier matters, such as questions of novelty, inventive step, or whether the amendment introduces fresh subject-matter then a fuller note of the matters discussed should be made in the file. ~~It should always be made clear to the applicant or agent that any agreement reached must ultimately be subject to the views of the other members of the Division~~.

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paragraphs 6.4 to 6.6

US:

6.4 If a ~~fresh~~ objection of substance is raised at an interview and no amendment to meet it is agreed ~~at the~~ time, the objection must be confirmed by a letter giving the applicant a ~~fresh~~ period within which he may reply, if he so wishes. Otherwise, time limits may not be altered as a result of an interview.

new: upon at that time

new

6.5 When the telephone is used to settle outstanding matters, the normal procedure should be for the examiner to telephone the authorised agent stating the number of the application he wishes to discuss and requesting the agent to telephone back at a specified time. A note must be made on the file, giving particulars and identifying the matters discussed and any agreements reached. Any matters on which agreement was not reached should also be noted and the arguments adduced by the agent should be summarised.

6.6 The records of interviews or telephone conversations should always indicate whether the next action is due ~~to come~~ from the applicant or the examiner, if there is any possibility of doubt about this.

SU: No comments

GB: No comments

CHAPTER VI (contd.)

7 Work within the Examining Division

(36) → paragraph 7.1

US: that it is ready for the issuance of the International Preliminary Examination Report

7.1 As stated in VI, 1.4, the examiner may seek the advice of other members of his Division, if necessary, at any stage in the examination. However, a point will be reached when it becomes appropriate for the examiner to refer the case formally to the other members of the Examining Division. This will arise if he considers it is in order ~~to proceed to grant, or, in the other event, if there seems no possibility of~~ amendment which would overcome his objections, or if the applicant has made no *bona fide* ~~attempt to meet these objections and it therefore appears that the application must be refused. Between these extremes~~ there are other circumstances in which reference to the Examining Division is appropriate, e.g. oral proceedings may be suggested by the examiner or requested by the applicant because an impasse has been reached. In considering whether to refer the application to the Division, the examiner should be guided by the principle stated in VI, 2.5.

SU: No comments

GB: Delete paragraph 7.1, not applicable to PCT

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paragraphs 7.2 and 7.3

US: ~~7.2 If the examiner considers that the application satisfies the~~ requirements of the Convention and is thus in order to proceed to grant he should make a brief written report. In some cases it may be sufficient merely to state that the objections have all been met by amendment and that, in the examiner's opinion, the application is in order. Where, however, there are any borderline questions which the examiner has resolved in favour of the applicant, he should draw attention specifically to these.

7.3 When referring to the Division an application which is not in order for grant of a patent, the examiner should make a written report which sets out the points at issue, summarises the case history to the extent necessary to enable the other members to obtain a quick grasp of the essential facts, and recommends the action to be taken, e.g. refusal, or grant conditional upon certain further amendments. As the other members will require to study the case themselves, there is no need for a detailed exposition. It will be useful however to draw attention to any unusual features or to points not readily apparent from the documents ~~themselves.~~

SU: No comments

GB: Delete paragraphs 7.2 and 7.3, not applicable to PCT

CHAPTER VI (contd.)

7 Work within the Examining Division (contd.)

(36) → paragraphs 7.4 and 7.5

US:

7.4 When an application is referred to the other members of the Division, they will first consider the case individually and each will indicate his opinion on the course of action to be taken. If there is complete agreement with the recommendation of the original examiner, no meeting of the Division will be necessary. When further action is necessary ~~need~~ the original examiner will be entrusted with the work. If, however, there is not complete agreement immediately with the original examiner, or at least one member of the Division wishes to discuss the case, a meeting of the Division will be arranged. At such a meeting, the Division should try to reach a unanimous opinion by discussion, but where this seems unlikely, the difference of opinion must be resolved by voting. When the Division is enlarged to four members (see VI, 7.9), the Chairman has a casting vote, should this be necessary.

7.5 The other members of the Division should bear in mind that their function ~~generally~~ is not to make a complete re-examination of the application. If, following a discussion, the conclusions of the examiner entrusted with the examination are generally considered to be reasonable, the other members should accept them.

SU: No comments

GB: Delete paragraphs 7.4 and 7.5, not applicable to PCT

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(37) → paragraph 7.6

US:

~~prepare the Int.~~ ~~national Pre-~~ ~~liminary Examin-~~ ~~ation report. If~~ ~~no amendments are~~ ~~made, he should~~ ~~prepare a negat-~~ ~~ive report. If~~ ~~unsatisfactory~~ ~~amendments are~~ ~~made, the exami-~~ ~~ner should eval-~~ ~~uate whether ad-~~ ~~ditional amend-~~ ~~ments to bring~~ ~~the case to meet~~ ~~Article 33 requ-~~ ~~irements can be~~ ~~made within the~~ ~~time limits for~~ ~~issuance of the~~ ~~report under Ru-~~ ~~le 69. He may~~ ~~wish to consult~~ ~~the other membe-~~ ~~rs of the Divi-~~ ~~sion in this in-~~ ~~stance~~

Article 33, must be

7.6 If, in the opinion of the Examining Division, the possibility exists of amending the application to bring it into a form which meets the requirements of ~~the Convention~~, then the original examiner should ~~communicate with the basis of~~ communicate to the applicant that the Examining Division is of the opinion that ~~the application should be refused on account of~~ satisfactory amendments ~~must be~~ submitted within a stated period. If, within the time limit, satisfactory amendments are made, the examiner will then ~~report back to the Examining Division recommending that the application should proceed to grant. If not, he should report back recommending refusal.~~

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

7 Work within the Examining Division (contd.)

37 → paragraph 7.6 (contd.)

Art. 35(2) PCT — 10. The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law.

Art. 33(5) PCT — 11. The criteria of novelty, inventive step, and industrial applicability merely serve the purposes of internation al preliminary examination. Any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not.

Rule 70 PCT — 12. The international preliminary examination report shall contain such information as to identify an international application. It should also mention any amendments and/or corrections made before the report was issued. It should indicate the priority date and the present priority documents. The report should contain remarks concerning unity of invention and the payment of fees where there is lack of unity of invention. It should indicate the claims that were not the subject of international preliminary examination as to their novelty, inventive step, and industrial applicability. The report should indicate the classification according to the International Patent Classification and/or national classifications; it should contain considerations concerning each claim which is believed to be examined in the light of the three above menttioned criteria. The statement of the examiner in respect of the claims may be accompanied by the citations and explanations, if any. The report should also include information on any non-written disclosures and documents, published later but having an earlier priority or filing date of the application. It should also mention the defects of the application and observe the clarity of the claims, description and drawings, and decide whether the claims are in conformity with the description (see the form of the International Preliminary Examination report).

SU:

Art. 35 PCT — 48. The International preliminary examination report should state in relation to each claim which is considered to be examined, whether it satisfies the criteria of novelty, inventive step and industrial applicability.

Rule 70.6 PCT — 49. The statement should consist of the words "YES" or "NO", or their equivalents.

50. The statement is made on each of the criteria taken separately and on all the three criteria taken as a whole.

Rule 70.6 PCT — 51. The statement should be negative if any of the three criteria is not satisfied.

52. If a claim doesn't satisfy the criterion of industrial applicability when the statement on this criterion should be negative and the whole statement on this claim should be "NO". In such a case, novelty and inventive step may not be considered, especially if it is difficult as for example in the case of a perpetual motion machine.

53. It should be remembered that these criteria are interrelated. For example, lack of novelty leads to lack of inventive step.

Art. 35(2) PCT — 54. The international preliminary examination report should be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require.

Rule 70.8 PCT — 55. Citations are necessary when the statement is negative. They should be accompanied by explanations unless the reason for citing any document is easy to imagine on the basis of consultation of the cited document. It is preferable that the explanations give the relevant part of the cited document.

CHAPTER VI (contd.)

7 Work within the Examining Division (contd.)

(37) → paragraph 7.6 (contd.)

SU: (contd)

56. Explanations (and probably citations) are necessary when the statement concerning industrial applicability is negative.

57. Explanations and citations may be given whenever the statement is positive, for example, to support the examiner's decision or when attention should be drawn to a certain document, which could require to ascertain the applicant's claims.

GB: Delete paragraph 7.6, not applicable to PCT

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paragraphs 7.7 to 7.9

US:

~~7.7 If, on the other hand,~~ additional amendments are unlikely to perfect the case the Division is satisfied that ~~the applicant has had sufficient opportunity to amend and that all the requirements are still not met,~~ it should issue ~~a decision to refuse the application.~~ This decision will normally be drafted by the original examiner.

~~Rule 69(2)~~ the International Preliminary Examination report.

~~Art 113(1) The grounds of refusal must be stated and full reasons must be given;~~ refusal may be based only on grounds on which the applicant has had an opportunity to put forward comments. In addition, the applicant's attention must be directed to the provisions for appeal laid down in Articles 106 to 108. If oral proceedings take place (see VI, 13), the decision may be given orally but must subsequently be notified in writing, the time for appeal then running from the date of such notification.

Rule 68(2)
Rule 68(1)

~~7.8~~ Any decision is issued by the Examining Division as a whole and not by an individual examiner. All members, therefore, sign the decision ~~irrespective of whether or not it was a unanimous one.~~

If, however, additional amendments may perfect the case, and if time limits permit, the examiner may issue one or more additional opinions.

~~Art 18(2) 7.9 Where the nature of the decision requires, the Examining~~ Division may decide to add to its number a legally qualified member. This necessity would normally arise only where the decision depends on the resolution of some difficult point of law (e.g. where prior use is involved and there is legal difficulty as to whether the prior use was carried out in public). This provision does not, of course, preclude the examiner from informal consultation with a legally-qualified examiner at ~~any time, either on his own behalf or on behalf of the Division.~~

~~If the Administrative Council should later decide to introduce Examining Divisions consisting of one technical examiner in accordance with Article 33, paragraph 3, then guidelines on this will be required.~~

SU: No comments

GB: Delete paragraphs 7.7 to 7.9, not applicable to PCT

CHAPTER VI (contd.)

8 Searching and the search report

The search report

(38) → paragraphs 8.1 and 8.2

US: Article 17(2)(a)(ii) — Rule 43 — Rule 44 — Rule 46 — Rule 45

8.1 The international search report prepared by the international Searching Authority and ~~Search Division~~ will ~~normally~~ be in the form prescribed by Rule 43 ~~Rule 44~~. ~~In some cases, additional search reports relating to further inventions may be on file in accordance with the provisions of Rule 46 (European search report where the invention lacks unity).~~ In the exceptional cases provided for in ~~Rule 45~~ only a partial search report ~~on a declaration that search is not possible~~ will be ~~available~~.

prepared — is a

8.2 Assuming that a search has been made and documents cited, there ~~are~~ ~~two special~~ problems which may arise occasionally in respect of ~~such documents. The first is~~ the date of publication of the material in the document; this is dealt with in IV, 5.2. ~~The other problem concerns documents in a non-official language (i.e. a language other than English, French or German).~~

SU: No comments

GB: Delete paragraphs 8.1 and 8.2, not applicable to PCT

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(39) → paragraph 8.3

US: International Searching Authority — a known International Preliminary Examining Authority — of the International Preliminary Examining Authority if supplied by the International Searching Authority, may — may

8.3 The ~~search~~ examiner will cite a document in an unfamiliar ~~a non-official~~ language only if he knows or has strong evidence leading him to suspect (e.g. from drawings, from an abstract, ~~or~~ a corresponding patent in ~~an official~~ language, or from a translation produced by ~~himself or~~ some other person familiar with the language of the document) that the document is relevant. The examiner, in his first action, may cite the document on the basis of similar evidence; an abstract or corresponding document in an official language, ~~if supplied by the search examining unit~~, also be cited. If, however, the applicant disputes the relevance of the document and gives specific reasons, the examiner should consider whether, in the light of these reasons and of the other prior art available to him, he is justified in pursuing the matter. If so, he should obtain a translation of the document (or merely the relevant part of it if that can be easily identified). If he remains of the view that the document is relevant, he ~~should~~ send a copy of the translation to the applicant with the next official communication.

SU:

62. The international preliminary examination is preceded by international search carried out by the International Searching Authority. International preliminary examination uses the results of international search and considers amendments and corrections in the international applications made by the applicant after international search.

Art. 33(6) PCT

63. The international preliminary examination should take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

GB: Delete paragraph 8.3, not applicable to PCT

CHAPTER VI (contd.)

8 Searching and the search report (contd.)

Search for conflicting applications

paragraph 8.4

US:

~~Search for conflicting European applications~~

8.4 As stated in VI, 2.3, the examiner will need to make a "topping-up" search for conflicting European applications falling within the area defined by Article 54, paragraph 3. This is because as a general rule the search files in the Search Division will not be complete in respect of such material at the time the main search is made. Since priority dates claimed (if any) may not be accorded to all or part of the application but may be accorded to the appropriate part of a conflicting application (see V, 2.1), this search should be extended so as to cover all published European applications filed up to one year after the filing of the application under consideration. If the examiner is unable to complete this "topping-up" search at the first examination stage he should ensure that such search is completed before the application is reported to be in order for the grant of a patent. In the rare case in which (e.g. due to an early request for examination) the application is found to be in order before this search can be completed, the grant of a patent should not be substantially delayed for this reason unless the examiner has knowledge of an unpublished application which will have to ~~be cited when it is published.~~

SU: No comments

GB: Delete paragraph 8.4, not applicable to PCT

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Other additional searches during examination

paragraphs 8.5 to 8.9

(40)

US:

Other additional searches during examination

8.5 A systematic further search will sometimes be required ~~either at the stage of amendment or subsequently.~~ after the first amendment This may arise either because the first search was an incomplete one, ~~as provided for by Rule 45,~~ or because the ~~Search Division~~ International Searching Authority has not searched a particular part of the application because of objection of lack of unity of invention, and the examiner disagrees with the objection; or because the claims have been so amended that their scope is no longer covered by the original search. ~~It might also arise exceptionally if the applicant wishes from an acknowledgment of prior art (see IV, 5.5), or if the examiner believes~~ that material relevant to obviousness might be found in technical fields ~~not taken into account during the search.~~

8.6 The ~~Search Division~~ International Searching Authority will have in the search files a copy of the published application and of the search report. If therefore the examiner believes that, for whatever reason, a further search may be required, it will often be appropriate for him to consult the ~~search~~ International Searching Authority examiner informally ~~by telephone if, after prior consultation with the search examiner where appropriate, it appears necessary for a relevant~~ further search to be done, the examiner should write a brief report to the Search Division stating the reason for the further search and indicating any points which will help the search examiner to assess the search need without having to study the description again; he should also send such documents (e.g. amended claims) as are relevant to the further search. ~~It will not normally be necessary to return the whole dossier.~~

CHAPTER VI (contd.)

8 Searching and the search report (contd.)

Other additional searches during examination (contd.)

(40) → paragraphs 8.5 to 8.9 (contd.)

US: (contd)

8.7 If, e.g. because of a badly drafted set of claims, the previous search was incomplete to an extent such that the search now to be made is the first effective one, then the examiner should indicate which claim, or claims, in his opinion, define the scope of the invention for which search is now required, and whether a particular interpretation is to be placed upon any wording in these claims. If it seems probable that the scope of the search resulting from the selected claims will, even at that stage, be very broad, the examiner should, if possible, indicate how in his opinion it might be narrowed without impairing unduly the effectiveness of the resultant search. He should also indicate any elements of the selected claims which he considers to be either of little substance or of special importance.

8.8 If a complete search has been made but a further search in the same technical field is required due to amendment of the claims, it will usually be sufficient if the examiner indicates the claim, or claims, defining the invention as in VI, 8.7, and the ways in which these claims are different in scope from the original search.

by the International Searching Authority which

8.9 Although in principle all search work ~~(other than for Article 54, paragraph 3, material)~~ should be done ~~by the Search Division in this~~ respect, the examiner is not barred from looking for relevant document~~s whose existence~~ he knows ~~of~~ or has reason to suspect, if he can retrieve that document in a short time from material available to him ~~in Munich~~ exist

SU: No comments

GB: Delete paragraphs 8.5 to 8.9, not applicable to PCT

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paragraph 8.10

US:

~~Art 157(1) 8.10 When the application has been filed under the PCT, the search~~ report will be the international search report made under the PCT but Art 157(2)(a) this will be accompanied by a ~~supplementary~~ European search report unless the Administrative Council decides that a supplementary report is to be Art 157(3)(a) ~~dispensed~~ with. Both of these reports will have to be considered by the ~~examiner when deciding whether any further search is required.~~

SU: No comments

GB: Delete paragraph 8.10, not applicable to PCT

CHAPTER VI (contd.)

9 Special applications

~~9 Special applications~~

Divisional applications

Art 76(1) 9.1 Subsequent to the filing of a European application, a divisional application may be filed. Such an application can only be filed in respect of subject-matter which does not extend beyond the content of the earlier application as filed (see VI, 5.4 *et seq*). The divisional application is accorded the same filing date as the earlier application, and has the benefit of any right of priority of the earlier application in respect of the subject-matter contained in the divisional application. ~~A European application may give rise to more than one divisional application.~~

~~9.2 The most common reason for filing a divisional application is to~~ meet an objection under Article 82 of lack of unity of invention. If the Search Division notifies lack of unity, divisional applications may be filed before the earlier application comes before the examiner. If the Art 82 examiner objects that the application does not meet the requirements of Rule 25(1)(b) Article 82, the applicant is allowed a period of between two and six months (see VI, 11.2 and 11.3) in which to limit his application, and a further two months after limitation is effected in which to file a divisional application(s) for the matter excised from the earlier application. This means for instance that, if the applicant files amendments limiting his earlier application at the end of the third month of the period allowed in the communication from the examiner, then he has only up to the end of the fifth month in which to file a divisional application(s), even though the period allowed by the examiner for limiting the earlier application may not at that time have terminated.

US:

9.3 If no objection to lack of unity of invention is raised, it is still possible that the applicant may wish to file a divisional appli- Rule 25(1)(a) cation in respect of some particular subject-matter in the earlier application. He has a right to do so, but after receipt of the first official communication under Article 96, paragraph 2, the divisional application must be filed within the period prescribed for reply to that communication, or after that period only if the examiner considers such filing to be justified. Such justification might arise if, for example, the earlier application discloses both a process and an apparatus and the claims, as amended by the applicant, relate only to the process; in such a case a divisional application relating to the apparatus would be justified.

9.4 The examination of a divisional application should be carried out exactly as for any other application. Comparison of the divisional application with the earlier application is necessary, however, to ensure that, as far as possible each application describes only the matter coming within the ambit of its claims. The same comparison should be made between divisional applications where there is more than one. Rule 25(2) When it is necessary for one application to describe matter claimed by another application (e.g. the description of one of the inventions may not be understandable without a description of the other invention), it must include a cross-reference to that other application. The cross-reference should make it clear that the matter in question is claimed in ~~the other application.~~

CHAPTER VI (contd.)

9 Special applications (contd.)

~~9.5 Although the claims in a divisional application must be in respect~~ of subject-matter contained in the earlier application, they need not be limited in their scope to that of those claims in the earlier application which were directed to the same subject-matter.

9.6 The earlier and divisional applications may not claim the same invention (see IV, 6.4). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words, if the difference between the claims of the two applications cannot conceivably be of inventive significance. In certain cases, however, the one application may claim its own subject-matter in combination with that of the other application. For example, the earlier application may describe and claim a new switch mechanism including a new type of switch contact; while the divisional application describes and claims the switch contact *per se*. This is allowable provided both applications contain appropriate crossreferences which clearly set out the position.

Applications resulting from a decision under Article 61

9.7 In certain circumstances, before a patent has been granted on a particular application, it may be adjudged as a result of a final decision of a national court that a person other than the applicant is entitled to the grant of a patent thereon. In this event this third party may either:

US : (contd)

Art 61(1)(a) "(a) *prosecute the application as his own application in place of the applicant,*

Art 61(1)(b) (b) *file a new European patent application in respect of the same invention, or*

Art 61(1)(c) (c) *request that the application be refused.*"

9.8 If the third party adopts the first of these alternatives he becomes the applicant in place of the former applicant and the prosecution of the application is continued from the position at which it was ~~interrupted~~.

~~Art 61(1)(2) 9.9 If however the third party files a new application under Article~~ 61, paragraph 1(b), the provisions of Article 76, paragraph 1, apply to this new application *mutatis mutandis*. This means that the new application is treated as though it were a divisional application i.e. it takes the date of filing and the benefit of any priority right of the original application. The examiner must therefore ensure that the subject-matter content of the new application does not extend beyond the
Rule 15(1) content of the original application as filed. The original application is deemed to be withdrawn on the date of filing of the new application for the designated States concerned.

Rule 16(1) 9.10 "*If, by the final decision, it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application*" then the foregoing considerations apply only to "*such part*". In such a case, option (a) mentioned in VI, 9.7 is not open to the third party and, regarding option (b), the new application must be confined to that part of the original subject-matter to which he has become entitled; similarly the original application must, for the designated States concerned, be confined to the subject-matter to which the original applicant remains entitled. The new

CHAPTER VI (contd.)

9 Special applications (contd.)

US: (contd)

application and the amended original application will stand in a relationship to each other similar to that appertaining between two divisional applications, and they will each stand in a relationship to the original application similar to that in which divisional applications stand in relation to the application from which they are divided. The guidance set out in VI, 9.4, 9.5 and 9.6 is therefore applicable to this situation.

Rule 16(2) 9.11 Where the final decision on entitlement applies to some only of the designated States, the original application may contain different claims, description and drawings for those States compared with the others (see VI, 5.15).

9.12 If the sole result of the application of Article 61, paragraph 1, is to divide the right to the grant between the original applicant and the third party so that each may apply for the entire subject-matter for different designated States, each application should be examined in the normal way without regard to the other, with the proviso that the subject-matter of each application must not extend beyond that of the original application.

SU: No comments

GB: Delete this section, not applicable to PCT

10 PCT applications

~~10 PCT applications~~

US:

Art 153 Art 150(3) 10.1 The Office may be a "*designated Office*" for an international application made under the Patent Cooperation Treaty (PCT) and that application is thereby deemed to be a European application for the purposes of the Convention. However, in such cases the provisions of the PCT apply in addition to those of the Convention, and where there is conflict between them, e.g. in the case of certain time limits (see VI, 11.11), the provisions of the PCT prevail.

Art 151 Art 154 10.2 In addition to being a designated Office, the Office may act as a Receiving Office and also as an International Searching Authority under the PCT within the terms set out in Articles 151 and 154 of the Convention respectively. There are thus three routes which a European application made under the provisions of the PCT may take, viz:

(i) the filing of the application and the international search take place at an office or offices, other than the European Patent Office (e.g. the United States Patent Office);

(ii) the application is filed at another office (e.g. the UK Patent Office) but the European Patent Office performs the international search;

(iii) the application is filed at the European Patent Office which also performs the international search.

In the first instance the European application will be accompanied by an international search report drawn up by another office. In the other two instances the international search report will have been prepared by the Search Division of the European Patent Office.

CHAPTER VI (contd.)

10 PCT applications (contd.)

10.3 In all instances a copy of the application and the international search report are sent to the International Bureau, for subsequent publication and communication to each of the designated Offices (one of which will be the European Patent Office) who then deal with it in accordance with their respective patent laws (e.g. this Office will examine the application for compliance with the requirements of the Convention).

10.4 Publication of the application by the International Bureau takes the place of publication by the Office; with the proviso that, if the
Art 158(1) Art 158(2) language of the application is not one of the official languages of the Office, then the Office must be supplied by the applicant with a translation in one of those languages, which it must publish. If the translated application, together with the appropriate fee, is not supplied, the application is to be deemed withdrawn. Also, in this case, the application which has been published under the PCT is not considered
Art 158(1) as comprised in the state of the art in accordance with Article 54, paragraph 3 (see IV, 6).

US: (contd)

10.5 A copy of the international search report is also sent to the applicant who may, as a result, file with the International Bureau amended claims, and may also file a brief statement explaining the amendments and indicating their likely effect on the description and drawings (see VI, 10.8).

Art 78(2) Art 157(2)(b) Art 157(2)(a) 10.6 When the application, in one of the official languages of the Office, and the international search report have been communicated to the Office, and the fees referred to in Article 78, paragraph 2, have been paid, the Search Division will prepare a supplementary search report, except where the Administrative Council has decided otherwise. Hence the application will reach the Examining Division containing either one or two search reports, which must be taken into consideration during the examination.

10.7 Either or both search reports may be incomplete, in which case further search after amendment may be required (see VI, 8). Alternatively if there was objection of lack of unity of invention only one, or some, of the inventions may have been searched, in which case the procedure in III, 7.9 et seq should be followed.

10.8 If amended claims were filed (see VI, 10.5) these should be considered together with any accompanying explanatory statement, in the same way as for other amendments filed prior to the examiner's first communication with the applicant (see VI, 3).

10.9 In all other respects the examination should be carried out as for any other European application.

SU: No comments

GB: Delete this section, not applicable to PCT

CHAPTER VI (contd.)

11 Time limits

Determination of time limits

41 → paragraphs 11.1 and 11.2

US:

~~Art 120~~ Treaty / Rule 16 / Rule 46.1 (filing of amendments) / 39 (transmittal of copy of international application)

11.1 The ~~Convention and the Implementing Regulations~~ impose time limits upon applicants, ~~some of these are fixed by the Convention~~, e.g. in ~~Article 78, paragraph 2~~ (payment of ~~filing and~~ search fees), ~~Article 91, paragraph 1 (designation of the inventor)~~ and Article ~~94, paragraph 2 (request for examination)~~. ~~Others are fixed in the Implementing Regulations, e.g. in Rule 36, paragraph 5~~ (document reproducing contents of telegram or telex), Rule 51, paragraph 4 (payment of fees for grant and printing and filing translations of claims) and Rule 69, paragraph 2 (applying for a decision after notification of loss of rights). Others take the form of a stipulated range, e.g. 2 to 6 weeks as in Rule 46, paragraph 1 (payment of further search fees), the precise period ~~within this range being, at the Office's discretion.~~

Receiving Office / 20.6 / ~~Rule 84~~ / ~~Rule 1(2)~~ / International Preliminary Examining Authority under the Treaty / International Preliminary Examining Authority

11.2 For certain cases, the time limit is to be determined by the Office, e.g. in Rule ~~41, paragraph 1~~ (rectification of formal deficiencies in application documents) ~~and Article 66, paragraph 1 (inviting applicant to state whether he desires a decision) where~~ this is so the period allowed should, in general, be not less than two months nor more than four months. Some Rules stipulate a minimum time limit, e.g. Rule 1, paragraph 2 (translation of a document to be used in evidence) *"not less than one month"*. Where ~~this is so, the stipulated period below the place of the two months referred to is given~~. When it is a matter for the ~~Office~~ to decide upon the period to be allowed, all the factors relevant to the particular application should be taken into account. These include the language normally used by the applicant or his agent; the nature of the objection raised; ~~and~~ the length and technical complexity of the application; the proximity of the ~~office~~ to the applicant or, if he has one, his agent; and the distance separating applicant and agent.

SU: No comments

GB: Revise paragraphs 11.1 and 11.2 to deal with PCT time limits so far as IPEAs are concerned

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paragraphs 11.3 and 11.4

US:

~~Rule 84~~ ~~11.3 In certain special circumstances the Office may allow up to~~ six months for the time limits referred to in ~~VI, 11.2~~. If, for instance, the applicant resides a long way from his agent and the language of the proceedings is not one to which the applicant is ~~accustomed, the six months period may be appropriate.~~

CHAPTER VI (contd.)

11 Time limits (contd.)

Determination of time limits (contd.)

paragraphs 11.3 and 11.4 (contd.)

US: (contd)

~~Rule 84~~ ~~11.4 In certain special cases (other than those provided for in Rule 85, see VI, 11.5), the period which has been allowed for the~~ time limits referred to in VI, 11.2 may be extended, but the applicant must request this extension before the expiry of the period that has been set. Such a request may be allowed if, e.g. an agent indicates that his client is so seriously ill that he is unable to give instructions. Any such request should be granted only when sufficient reason is given. It must be shown convincingly that reply in the period laid down will not be possible. A mere unsubstantiated statement that it will not be possible to meet the time limit, e.g. because of pressure of other work, is not sufficient. If the request is granted, the applicant should be informed of the new time limit. Otherwise, he should be told that ~~the relevant sanction has taken or will take effect (see VI, 11.4).~~

SU: No comments

GB: Revise paragraphs 11.3 and 11.4 to deal with PCT time limits so far as IPEAs are concerned

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41 → paragraph 11.5

US:

80.2
Rule ~~83.2~~
Authority ~~Rule 78~~
day following the date of mailing 80.1-80.4
while 80.5
Rule 82 covers the situation where service

11.5 ~~Although Rule 83 allows other possibilities,~~ any period fixed by the ~~Office~~ will usually be specified in full months which will be calculated from the ~~receipt~~ of the communication by the person to ~~whom it is addressed (see Rule 78, paragraphs 1 and 3).~~ Rule ~~83~~ gives precise details for the determination of the day of ~~the end~~ of the period. ~~Also~~ Rule ~~83~~ contains provisions covering certain contingencies, e.g. that the Office is not open on the day on which a time limit expires, or that there is a general disruption in the postal ~~[illegible]~~ expiration

SU: No comments

GB: Revise paragraph 11.5 to deal with PCT time limits so far as IPEAs are concerned

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41 → Failure to respond within a time limit

paragraph 11.6

US:

14(3)(a)
be withdrawn and under Rule 4.10 (b) the priority claim will be considered not to have been made.

11.6 If the applicant has not acted within a time limit, a sanction is applied and this differs according to the circumstances. For instance, under Article ~~[illegible]~~, the application will ~~[illegible]~~ has not been filed in time the application is deemed to be withdrawn (Article 94, paragraph 3) and this sanction also applies in those cases where the applicant fails to meet a time limit set by the Office (e.g. the time limit for replying to an invitation to amend ~~under Article 34, paragraph 2).~~

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

11 Time limits (contd.)

Failure to respond within a time limit (contd.)

41 → paragraph 11.6 (contd.)

SU: No comments

GB:

Not necessarily under PCT. It may be no more than that the IPE Report must then be established.

Revise to deal with PCT time limits so far as IPEAs are concerned and consequence of failure to comply.

11.6 If the applicant has not acted within a time limit, a sanction is applied and this differs according to the circumstances. For instance, under Article 90, paragraph 2, the application will not be proceeded with; under Article 91, paragraph 3, the application may be refused or a right of priority lost; under Rule 5 a document may be deemed not to have been received. If the examination request has not been filed in time the application is deemed to be withdrawn (Article 94, paragraph 3) and this sanction also applies in those cases where the applicant fails to meet a time limit set by the Office (e.g. the time limit for replying to an invitation to amend under Article 96, paragraph 2).

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41 → paragraph 11.7

US:

~~Rule 69(1)~~ Treaty

11.7 In any case where a time limit has not been met and a loss of right results from the ~~Convention without any decision concerning the refusal of the application~~, a notification will be sent to the applicant ~~by a formalities officer~~, informing him that the appropriate sanction has taken effect. No further action by the examiner is normally necessary. ~~If the applicant considers the finding of the Office to be inaccurate he may, within two months~~ ~~Rule 69(2)~~ from the notification, apply for a decision on the matter. Such a decision will then be given by the Examining Division (or other ~~appropriate department of the Office, unless the Office agrees with the applicant, in which case he will be informed accordingly.~~

SU: No comments

GB: Delete paragraph 11.7

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Request for further processing

42 → paragraph 11.8

US:

~~Art 121(1)~~ Authority Treaty ~~Art 121(2)~~

11.8 If the application is to be refused or is refused or deemed to be withdrawn following failure to meet a time limit set by the ~~Office~~ (as distinct from those fixed by the ~~Convention or in the Implementing Regulations~~), the application is allowed to proceed if the applicant makes a written request for further processing of the application. This request must, however, be filed within two months of the notification of refusal or notice that the application is deemed to be withdrawn, and the omitted act must be completed and a fee for further processing must be paid within this period. The request shall not be deemed to have been filed until this fee has been paid. The department competent to decide on the omitted act decides on the request for further processing. ~~Art 121(3)~~

(comments from SU and GB on the following page)

CHAPTER VI (contd.)

11 Time limits (contd.)

Request for further processing

(42) → paragraph 11.8 (contd.)

SU: No comments

GB: Delete paragraph 11.8, not applicable to PCT

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paragraphs 11.9 and 11.10

US:

~~Application to have rights restored~~

Art 122

11.9 The applicant for, or proprietor of, a European patent who has been unable to observe any time limit not specifically excluded by Article 122, paragraph 5, in spite of having exercised due care, may apply to have his rights restored. The conditions governing such application are fully set out in Article 122, paragraphs 1 to 6. The provisions of this Article might be invoked if e.g. the applicant's working documents had been destroyed by fire and he had been obliged to prepare fresh ones; or if a specialist agency had sent him the wrong set of drawings relating to a priority document, and the error was not immediately apparent. In all instances it is necessary for the applicant to supply evidence that he had exercised due care and that the delay was caused by factors outside his control.

Rule 90

11.10 When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in ~~Rule 90, time limits are subject to the provisions of Rule 90, paragraph 4.~~

SU: No comments

GB: Delete paragraphs 11.9 and 11.10, not applicable to PCT

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Effect of change in priority date

(43) → paragraph 11.11

US:

~~Art 88(2)~~

Rule 4.10(d)

11.11 Certain time limits run from the date of priority, or in the case of multiple priorities, from the earliest date of priority. Where this date no longer applies (e.g. the right of priority is lost in accordance with the provisions of ~~Article 91, paragraph 3~~), any such time limits become determinable from the amended date of priority. This does not restore any loss of right resulting from a time limit having already expired before the loss of priority date. The Formalities Guidelines deal with the procedure to be followed.

SU: No comments

GB: Delete paragraph 11.11, not applicable to PCT

CHAPTER VI (contd.)

12 Examination of observations by third parties

US:

~~12 Examination of observations by third parties~~

Art 115(1) 12.1 Following the publication of a patent application under Article 93, any person may present written observations concerning the patentability of the invention (i.e. any matter covered in Articles 52 to 57 - see Chapter IV). That person will not be a party to the proceedings before the Office, and although receipt of the observations is acknowledged, the examiner does not inform him of the further action taken by the Office in response to his observations.

Art 115(2) 12.2 The observations should be communicated to the applicant without delay and he may comment on them. If a request for examination has been filed, the examiner should take the observations, together with any comments by the applicant, into account during his examination and make at least a brief report upon them on the file. They are most likely to relate to documents which the third party considers to be relevant prior art, and the examiner should closely consider these, just as he would any ~~documents mentioned in the search report.~~

SU: No comments

GB: Delete this section, not applicable to PCT

13 Oral proceedings

US:

~~13 Oral proceedings~~

Art 116(1) 13.1 Oral proceedings take place before the Examining Division either at the instance of the European Patent Office or at the request of any party to the proceedings. Thus the applicant has the right to request oral proceedings. However, the Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same. The Examining Division would
Art 18(2) require oral proceedings to take place if this would be useful in
Art 116(3) expediting the proceedings. Oral proceedings must be before the whole Examining Division, and the proceedings are not public.

Rule 68(1) 13.2 By "*oral proceedings*" is meant formal proceedings which will normally result in a decision. The requirement that such proceedings should be before the Examining Division does not preclude the examiner entrusted with examination prior to a final decision from having informal contact with the applicant or his representative either at an interview or over the telephone (see VI, 6).

Rule 71 13.3 The applicant must be summoned to oral proceedings and should be given at least one month's notice of the date and time of the proceedings unless he agrees to a shorter period. The proceedings will be controlled
Art 133 by the Chairman of the Examining Division. The applicant may be
Art 134 represented by a professional representative or a legal practitioner.
Rule 2 The provisions on the use of languages are contained in Rule 2 (see I, 3).

CHAPTER VI (contd.)

13 Oral proceedings (contd.)

US : (contd)

13.4 As a general rule, the proceedings will be conducted in the following manner. The examiner who was charged with the examination will present a summary of the points disputed by the applicant. The applicant or his representative will then be invited to present his observations and may afterwards be questioned by the members of the Examining Division. At the request of the applicant or his representative, the Chairman may also allow accompanying experts or other persons to make observations and answer questions. At the end of the proceedings (possibly after a short adjournment), the Chairman may give the decision of the Examining Division orally or may state that the Division wishes to receive its decision. Any oral decision must be followed up by a

Rule 68 decision in writing.

Rule 76(1) 13.5 Minutes are required to be taken at oral proceedings. These minutes will normally be taken by a member of the Examining Division.

Rule 76(3) The minutes must be "*signed by the employee who drew them up and by the employee who conducted the oral proceedings*" (i.e. the Chairman), and the

Rule 76(4) Office must provide the applicant with a copy. These minutes need only

Rule 76(1) contain the essentials of the proceedings - that is to say, they need not be a complete record of all that is said but should contain a summary of any arguments relevant to any of the matters the Examining Division has to decide.

SU : No comments

GB : Delete this section, not applicable to PCT

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14 Taking of evidence

paragraph 14.1

US :

~~Art. 117(1) 14.1 Article 117, paragraph 1, gives a list of a number of means by~~ which evidence may be given or obtained. ~~The taking of evidence is likely to arise much more in opposition proceedings than in examination proceedings before grant, and is therefore dealt with in greater detail in the Guidelines relating to opposition.~~

SU: No comments

GB: Delete paragraph 14.1, not applicable to PCT

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(44) → paragraphs 14.2 to 14.7

US :

14.2 An Examining Division would not, as a general rule, require evidence to be produced. The primary function of the examiner in proceedings ~~before grant~~ is to point out to the applicant any ways in which the application does not meet the requirements of the ~~Convention~~ Treaty. If the applicant does not accept the view of the examiner, then it is for the applicant to decide whether he wishes to produce evidence in support of his case and, if so, what form that evidence should take. The Examining Division should afford the applicant a reasonable opportunity of producing any evidence which is likely to be relevant. However, this opportunity would not be given where the Examining Division is convinced that no useful purpose would be served by it, or that undue delay would result. It is convenient to consider such evidence according to whether it is written, oral, or by inspection.

CHAPTER VI (contd.)

14 Taking of evidence (contd.)

(44) → paragraphs 14.2 to 14.7 (contd.)

US: (contd)

For

14.3 Written evidence could include the supply of information, or the production of a document or of a sworn statement. ~~To take some~~ examples:
To rebut an allegation by the examiner of lack of inventive step, the applicant might, in support of his case, supply information as to the technical advantages of the invention; ~~Again~~ he might produce a sworn statement, either from himself or from an independent witness, purporting to show that workers in the art have been trying for a long time unsuccessfully to solve the problem with which the invention is concerned, or that the invention is a completely new departure in the relevant art.

International Preliminary Examining Authority

~~Rule 74(2)~~ Authority ~~Rule 74(1)~~

14.4 Oral evidence: The witness required to give evidence would normally be summoned by the ~~European Patent Office~~ in response to a request from the applicant, ~~the procedure for issuing a summons being set out in Rule 72.~~ Witnesses may, however, be heard even if they have not been summoned. The taking of evidence may be made conditional upon deposit by the applicant with the ~~Office~~ of a sum fixed by reference to an estimate of costs.

~~Rule 76(2)~~

~~Rule 74~~ Authority

Authority

14.5 Usually oral evidence would be given as part of the oral proceedings before the Examining Division. The minutes recording the testimony of a witness must be submitted to that witness for approval. Witnesses who are summoned by and appear before the ~~European Patent Office~~ are entitled to reimbursement of expenses and compensation for loss of earnings, and so are witnesses who appear before it without being summoned by the ~~Office~~ provided they are heard.

~~Art 117(3)(b)~~ to (6)

~~14.6 As an alternative to appearing before the European Patent Office, a witness may be permitted to give his evidence before a competent court in his country of residence.~~

~~Art 117(1)(c)~~

14.7 Evidence by inspection might, e.g., include the presentation of a working model, or of the actual device of the invention, or of the product of a process of the invention. Exceptionally, the evidence may be taken by visiting the factory where the invention is being used.

SU: No comments

GB: Delete paragraphs 14.2 to 14.7, not applicable to PCT

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15 Grant and publication of patent

~~15 Grant and publication of patent~~

US:

Rule 51(4)

Art 97(2)(a)

15.1 When the Examining Division has decided that a patent can be granted on the text submitted to it by the examiner entrusted with the examination, it must inform the applicant of the text. Such text may include minor amendments made by the examiner on his own initiative but the latter should never extend beyond minor corrections of a linguistic nature and other corrections of manifestly obvious defects.

CHAPTER VI (contd.)

15 Grant and publication of patent (contd.)

Art 97(2)(3) Art 97(5) Rule 51(4) Art 97(2)(c)

15.2 When the applicant's approval of the text is sought he is also requested to pay the fees for grant and printing and to file a translation of the claims, as they appear in the text sent to him, in the two official languages of the Office other than the language of the proceedings, the time allowed being three months. If such fees are not paid or such translations are not filed in due time, the application is deemed to be withdrawn. The applicant must also have paid any renewal fees and any additional fees that are due before a patent can be granted, the application being again deemed withdrawn if these fees are not paid.

Art 65(1) Rule 51(5)

15.3 At the same time the applicant is also informed which, if any, Contracting States out of those he has designated requires a translation of the text into an official language of that State, where the patent is not drawn up in one of the official languages of that State.

Rule 51(4)

15.4 If the applicant approves the text and if the requirements set out in VI, 15.2 have been satisfied, the Examining Division issues a final decision to grant. Payment of the fees for grant and printing and provision of the translation of the claims into the other two official languages may be deemed to indicate approval by the applicant.

15.5 If, however, the applicant has communicated his disapproval of the text within the three month period, then the examination is resumed. The disapproval will usually take the form of further amendments, which the examiner entrusted with the examination should examine as to their allowability (see VI, 4.7). Such further amendments should not be allowed at this stage unless they are of a minor character or are clearly necessary to correct deficiencies in the application. Amendment may, for example, be necessary because of fresh prior art which has only recently

US : (contd)

~~15.6 Certain applications will at the first examination stage satisfy~~ all the requirements of the Convention, enabling the Examining Division to make a decision that a patent can be granted without the examiner ever making a report for communication to the applicant. Thus the communication from the Examining Division seeking the applicant's approval of the text will be the "first" communication from the Examining Division for the purposes of Rule 86, paragraph 3. At this stage the applicant could amend the description, claims and drawings, once of his own volition; the extent of allowable amendments in this case is discussed in VI, 3.2. In such cases, the communication seeking approval of the text should inform the applicant that he has the opportunity to amend and should state that any amendment must be submitted within the period of three months allowed for approval of the text.

15.7 It is not part of an examiner's duty to check the accuracy of the translation of the claims when the text is returned from the applicant.

Art 97(4)(5) Rule 51(4)

15.8 The decision to grant a European patent does not take effect until the European Patent Bulletin mentions the grant. The mention must be at least five months after the Examining Division invites the applicant to approve the text. At the same time as the mention of the grant is

Art 98 Rule 49(2) Rule 52 Art 14(7)

published in the Bulletin, the Office publishes the specification of the patent containing the description, claims (in the three official languages) and any drawings. The published specification indicates the designated Contracting States (excluding any designations which have been withdrawn since the filing of the application).

CHAPTER VI (contd.)

15 Grant and publication of patent (contd.)

SU: No comments

GB: Delete this section, not applicable to PCT

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[Appendices follow]

PCT/TCO/VI/9
Annexe A/Annex A

APPENDICE I/APPENDIX I

WORLD INTELLECTUAL PROPERTY ORGANIZATION

ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

Circular No. 2409 January 26, 1976
PCT 081.3

Sir,

I have the honor to call to your attention that the PCT Interim Committee for Technical Cooperation, at its fifth session, held in Geneva from October 29 to November 3, 1975, included the following item in its present 1976 program : "Starting of the work on Guidelines for International Preliminary Examination" (see paragraph 71(vi) of the Report of the Interim Committee contained in document PCT/TCO/V/20).

In order to assist in carrying out this item of the 1976 program, the International Bureau of WIPO is using the present draft of the Guidelines for Substantive Examination of the European Patent Organisation (EPO) as the basis for elaborating PCT Guidelines for International Preliminary Examination.

./. It would, I am sure, facilitate preparation of the PCT Guidelines if you would mark up one of the two enclosed copies of the EPO Guidelines with any observations you may have to make. This does not, of course, exclude the possibility of making observations in any other way you may desire.

It would be appreciated if you would let us have a marked-up copy of the EPO Guidelines, or any other observations that you wish to provide, on or before April 30, 1976.

Sincerely yours,

F. Sviridov

Felix A. Sviridov
Deputy Director General

[L'appendice II suit/Appendix II follows]

32, chemin des Colombettes - 1211 GENÈVE 20 (SUISSE) - ✆ (022) 34 63 00 - Ⓣ 2 23 76 - Télégr.: OMPI

Response Submitted by the State Committee for Inventions and Discoveries of the USSR Council of Ministers with respect to the EPO Guidelines for Substantive Examination.

Mr. Sviridov
Deputy - Director General
World International Property Organization
32, Chemin des Colombettes,
1211, Geneva, 20
Switzerland

Dear Mr. Sviridov,

In reply to your circular letter N2409 of January 26, 1976 concerning the preparation of Guidelines for International Preliminary Examination under the PCT, I inform you that Draft Guidelines for Substantive Examination in the European Patent Office, prepared by Working Party III of the Interim Committee of the European Patent Organization (EPO) and distributed among the members of the PCT Interim Committee for Technical Cooperation in the form of document PCT/TCO/VI, are in our opinion, a useful material, containing a number of practical solutions applicable to Guidelines for International Preliminary Examination under the PCT.

However, the EPO Draft Guidelines do not cover many precedural problems connected with the proceedings in an International Preliminary Examining Authority and resulting from Chapter II of the PCT. This is also noted in paragraph 3 of Introduction to the EPO Draft Guidelines. Additionally, many provisions of the EPO Draft Guidelines are not adequate to the Articles and Rules of the PCT and in preparing the



PCT Guidelines, will require some amendments which are difficult to be made in a form of addings, expurgations, or corrections of EPO Draft Guidelines text.

Trying to contribute towards the work of the International Bureau in its efforts to prepare PCT Guidelines, I send you a material under the title of "Some Paragraphs of Guidelines for International Preliminary Examination under the PCT". This material deals with procedural and technical features of International Preliminary Examination under the PCT. The wording of many paragraphs of the material is adequate either to the Articles and Rules of the PCT, or to the paragraphs of the EPO Draft Guidelines, and certain paragraphs are so prepared that they reflect our experiences in the pilot work for issuing decisions that would be in conformity with the requirements of the PCT. The abovementioned material is not intended to cover all the aspects of the PCT Guidelines for International Preliminary Examination but it contains some features which in our opinion ought to be included in this or that form in the PCT Guidelines, now being under preparation.

It will be noted that for the purpose of convinience the text of the material is provided with subtitles and marginal references to indicate relevant PCT Articles and Rules or paragraphs of the EPO Draft Guidelines.

We hope that the following material will be of use in the efforts of the International Bureau to prepare the PCT Guidelines for International Preliminary Examination.

Very Respectfully Yours,
(signed) L.Komarov
Deputy Chairman
State Committee for Discoveries & Inventions.

# Some Paragraphs of Guidelines for International Preliminary Examination under the PCT.

## General

In.1 EPO

1. Entry into force of the Patent Cooperation Treaty (PCT) represents a major step forward in the history of patents. The eyes of the patent world will be on international applications and the procedure of their examination. The effectiveness and reputation of the PCT will depend on how full and thorough international search has been and how profoundly the decision of International Preliminary Examination is reasoned.

In.2 EPO

2. The Guidelines concern International Preliminary Examination and its procedures carried out by the examiners in an International Preliminary Examining Authority.

In.2 EPO

3. The Guidelines give instructions as to the practice to be followed in the various aspects of International Preliminary Examination of international applications. They will also be of assistance to applicants and patent practitioners.

In.2 EPO

4. The Guidelines contain general recommendations for International Preliminary Examination, resulting from Chapter II of the PCT and Regulations under the PCT. This first variant of the Guidelines prepared before the entry into force of the Patent Cooperation Treaty will hardly cover all the problems and cases that may be encountered by the examiner in his practical work. Nevertheless, applicants can expect every International Preliminary Examining Authority to act as a general rule in accordance with the Guidelines until such time as they are revised, and examiners will depart from the instructions only in exceptional cases.

In.,3 EPO

5. The Guidelines mostly deal with international applications. However, they may be used mutatis mutandis by National Offices in dealing with national applications if the national law provides so; also, they may be used in revising national laws with the purpose of unification of current practices in patent offices of various countries.

In., 5 EPO

Art.35(2) Art.27(5) Art.33(5) PCT

6. The attitude of the examiner to International Preliminary Examination is very important. He should be constructive, sticking to the principles, but at the same time he should have a sense of proportion and not pursue unimportant objections. He should bear in mind that International Preliminary Examination does not deal with the questions of patentability of inventions in relation to any national law, taken alone, and the drafting of the description and claims of an international application is the responsibility of the applicant or his

authorised representative.

In.,6 EPO

7. There is a further matter which should not be forgotten. The PCT imposes various time limits on applicant and examiner. These time limits provide for successful functioning of the examination of international applications. What is meant is that examiners and other employees of an International Preliminary Examining Authority work with a corresponding speed.

In.,7 EPO

8. It should hardly need stating that all international applications regardless of their countries of origin should receive equeal treatment on the part of the International Preliminary Examining Authority. An international patent system can be credible only if all trace of national bias is absent.

Objective of the International Preliminary Examination.

Art. 33 PCT

9. The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable.

Art.35(2) PCT

10. The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law.

Art.33(5) PCT

11. The criteria of novelty, inventive step, and industrial applicability merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not,

Rule 70 PCT

12. The international preliminary examination report should contain such information as to identify an international application. It should also mention any amendments and/or corrections made before the report was issued. It should indicate the priority date and the present priority documents. The report should contain remarks concerning unity of invention and the paiment of fees where there is lack of unity of invention. It should indicate the claims that were not the subject of international preliminary examination as to their novelty, inventive step, and industrial applicability. The report should indicate the classification according to the International Patent Classification and/or national classifications; it should contain considerations concerning each claim which is believed to be examined in the light of the three abovementioned criteria. The statement of the examiner in respect of the claims may be accompanied by the citations and explanations, if any. The report should also include information on any non-written disclosures and documents, published later but having an earlier priority date than the priority or filing date of the application. It should also mention the defects of the application and observe the clarity of the claims, description, and drawings, and decide whether the claims are in conformity with the description (see the form

of the International Preliminary Examination report).

The Claims.

13. For successful international preliminary examination the clarity of the claims is of the utmost importance in view of their function in defining the scope of the protection sought by the applicant. The requirements to the claims of an international application are provided for in Rule 6 of the Regulations to the PCT. They are closely connected with the requirements of unity of invention (see PCT Rule 13).

Rule 13.3 PCT

14. The Regulations to the PCT define various categories of claims (i.e., product, process, apparatus, or use). It should be noted that claims of one and the same category may contain different terms. For example the category "apparatus" may include claims defining a system, structure, mechanism, or their parts, etc. The category "process" covers processes, subsequence of technological operations, etc. The term "product" is not to be interpreted as limited to a substance or composition. It should be construed liberally as including any physical entity which can be manufactured, e.g. "woven garment". Often one and the same invention can be regarded simultaneously as "apparatus" and "product", or as "apparatus" and "use", etc.

III,7.4 EPO

Rule 13.3 PCT

15. Providing for the requirements of unity of invention, PCT Rule 13 permits that an international application may include two or more independent claims of the same category which cannot readily be covered by a single generic claim. It is permitted to include in the same international application claims of different categories provided that they are limited according to PCT Rule 13.2, and in addition to an independent claim of one category it is permitted to include in an international application a limited number of claims of different category. Further, it is permitted to include a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention (see PCT Rule 13.4).

Rule 6.4 PCT

16. Thus, according to the PCT claims may be divided into independentand dependentclaims, and independent claims in their turn are subdivided into main claims and claims in addition to an independent claim.

17. It is important for the purposes of the international preliminary examination that any dependent claim should be construed as including all the limitations contained in the claim to which it refers. Any dependent claim which refers to more than one other claim, refers to them only alternatively. Multiple dependent claims should not form a basis for other multiple dependent claims. A multiple dependent claim includes all the limitations contained in the particular claim in relation to which it is considered.

III, 4.2 EPO

18. The examiner should be quite sure of the clarity

and unambiguity of the claims. Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise.

III, 4.3 EPO

19. Where there is any serious inconsistency between claims and description, amendments to remove this should be required. For example, the description may state, or may imply, that a certain technical feature not mentioned in the claims is essential to the performance of the invention. In such a case, the examiner should require the claims to be amended to include this feature in the claims or exclude it from the description. Therefore, the examiner is eager to reach clarity in the interpretation of the claims and remove inconsistency between claims and description, in order to avoid wrong and incomplete results of the international preliminary examination.

III, 4.6 EPO

20. A claim should not include vague or equivocal forms of wording which leave the reader in doubt as to the exact scope of a feature. Examples of this are relative terms such as "wide", "strong", etc. It is necessary to have such terms either defined or excised.

III, 4.7 EPO

21. Claims which attempt to define the invention, or a feature thereof, by a result to be achieved should not be allowed. Claims should disclose a means to achieve this or that result or objective of the invention. The examiner should not pursue the claims that they include technical features relating to the results and objectives of the invention if it helps to define the subject matter.

Rule 6.2 PCT

22. Claims should not rely on general references to the description or drawing. Such phrases as: "as described in part... of the description", or "as illustrated in figure... of the drawings" are not allowed.

III, 4.11 EPO

However, it is preferable that the technical features of the claims were accompanied by the corresponding reference signs of the drawings. These reference signs should be placed in parentheses. But where they preclude the claims from understanding or make the claims very long, they should not be allowed.

III, 5.1 EPO

23. The requirement that the claims should be concise refers to the claims in their entirely as well as to the individual claims. The number of claims must be reasonable when considered in relation to the nature of the invention claimed. Undue repetition of wording, e.g. between one claim and another, should be avoided.

III, 6.3 EPO

24. When claims are speculative, in that their scope extends beyond the description to embrace possibilities not yet explored by the applicant, the effects of which cannot readily be predetermined or assessed, the examiner should object that such claims are not supported by the description, and this may lead to issuing the notification in accordance with Article 34(4)(a)(ii).

III, 7.5

25. Alternative forms of an invention may be claimed either in a plurality of dependent claims, or in a single claim. In the latter case the presence of the two alter-

natives may not be immediately apparent. In either case, however, the presence of the alternatives should not be objected where there is unity of invention according to the PCT Rules.

III, 7.8 EPO

26. Prior to drawing up the international preliminary examination report the examiner should ascertain whether the requirements to the claims of the invention have been met and invites the applicant to submit necessary amendments and/or corrections (if any).

Unity of Invention.

27. The International Preliminary Examining Authority ascertains whether the requirements of unity of invention (PCT Rule 13) have been met. In many and probably most instances lack of unity will have been noted by the International Searching Authority while establishing an international search report.

28. Where there is lack of unity the International Preliminary Examining Authority acts in accordance with PCT Rule 6.8.

IV, 7.1 EPO

Novelty.

Art.33(2) PCT

29. A claimed invention should be considered novel if it is not anticipated by the prior art.

Rule 64 PCT

30. For the purposes of the international preliminary examination, everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) should be considered prior art provided that such making available occurred prior to the relevant date. The relevant date is considered to be the international filing date or where the international application validly claims the priority of an earlier application, the filing date of such earlier application. The non-written disclosure should not be considered part of the prior art. Any application or any patent published after the relevant date but having an earlier priority date should not be considered part of the prior art. Nevertheless, the international preliminary examination report should call attention to such materials, if such materials are closely related to the international application under consideration.

IV, 7.2 EPO

31. In establishing an international preliminary examination report each claim which is supposed to be examined is considered as to novelty.

32. A claim should be regarded as part of the state of the art and therefore not new, if a single document or other item of prior art teaches the person skilled in the art that the combination of the technical features of this claim is derivable directly and unambiguously from prior art. Hence, in considering novelty it is not permissible to combine separate documents of prior art together. Similarly, it is not permissible to combine separate items of different documents together.

33. Lack of novelty may be apparent from what is explicitly stated in the document itself. The same consi-

deration applies in the case where, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claims of an international application.

IV, 7.3 EPO

34. In considering novelty, a prior document should be construed only in the light of knowledge available at the time the document was published and excluding any knowledge subsequently discovered.

Inventive Step

Art.33(3) PCT

35. A claimed invention should be considered to involve an inventive step if, having regard to the prior art it is obvious to a person skilled in the art.

Rule 65.1 PCT

36. In considering inventive step, the relation of any particular claim to the prior art as a whole is taken into consideration. Thus, not only separate documents or their parts are considered but also combinations of such documents or combinations of their parts, where such combinations are obvious to the person skilled in the art, i.e. where the possibility of combining such documents or their parts is obvious from technical point of view to the person skilled in the art.

37. Formally, the criterion of novelty differs from that of inventive step in that lack of novelty in the claims is confirmed by way of reference only to a single document, and lack of inventive step is confirmed by way of reference to a number of documents.

IV, 9.1 EPO

38. If a claim lacks novelty it, therefore, does not involve inventive step. In such a case, both novelty and inventive step are objected by way of one and the same reference. Thus, the question - Is there inventive step? - only arises if there is novelty, i.e. when there is a difference between each claim and any document belonging to prior art.

IV, 9.7 EPO

39. In considering whether the combination of documents is obvious, the examiner should have regard to the following:

(i) Whether the nature and content of the documents is such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the invention, would combine them;

(ii) Whether the documents come from similar, neighbouring, or remote technical fields;

(iii) The number of documents which need to be combined. The combination of documents or of two or more parts of the same document would be obvious if it would be natural for the skilled person to associate these documents or their parts with one another. For example, it would normally be obvious to combine with other prior documents a well-known textbook or standard dictionary. It would also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other, or to combine patent documents relating to classifications bound by references within classification indexes.

IV, 9.5 EPO

40. In the claims the applicant himself may indicate

what seems to be known. But the examiner should not proceed solely from the point of view suggested by the applicant in considering whether there is lack of inventive step or there is not. The examiner determines the difference between any claim and the whole of the known art. During the examination the examiner may put known technical features in an entirely different perspective from that apparent from reading the applicant's specification by itself.

IV, 9.8
EPO

41. The following list gives examples for guidance of circumstances where an invention should be regarded as obvious or where it involves an inventive step:

(A) Inventions involving the application of known measures in an obvious (non-obvious) way:

(i) The teaching of a prior document is incomplete and at least one of the possible ways of "filling the gap" would naturally or readily occur to the skilled person.

Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical).

Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor. However, if the use of a hydraulic motor involves a new, surprising effect, e.g. as a result of a specific technological cooperation with the pump, then the invention can be said to involve inventive step.

(iii) The invention consists merely in a new use of a well-known material employing the known properties of that material.

Example. Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water., this property being known to be an essential one for detergents, But if the use of such a washing composition was previously considered for some reasons impossible, and the inventor removed the undesirable effect, then the invention can be said to involve inventive step.

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use.

Example. An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding. But if such technique involves a surprising effect, e.g. rapid improvement of electrical durability of cables for high-frequency power, then the invention can be said to involve inventive step.

(v) The invention consists merely in the use of a known technique in a closely analogous situation.

Example. The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanism of an industrial truck, such as a fork-lift truck, the use of this technique being already known to con-

trol the movement of a carriage.

(B) Obvious and non-obvious combination of features: The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working interrelationship.

Example. Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

But if the features so associate with each other that a new technical result is achieved then inventive step can be said to be involved, even if each feature, taken alone, is fully known.

Example. Invention consisting of combined method of teeth treatment including simultenious use of mechanical and ultrasonic treatments can be said to involve inventive step if a quick and painless result is achieved provided that such a result cannot be achieved by these treatments taken separately.

(C) Obvious (non-obvious) selection among a number of known possibilities:

(i) The invention consists merely in choosing from a number of equally likely alternatives.

Example. The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat and a mere choice of one of them doesn't involve inventive step.

(ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures.

Example. The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. In such a case, there is no inventive step, especially if it is obvious that the prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner. But where the choice of rates results in a surprising effect in the working process or lead to new properties of the product, then it is possible to say that inventive step is involved.

(iii) The invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.

Example. The invention is characterized by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapalation on a straightline graph, obtained from the known art.

(iv) The invention consists merely in selecting a small number of chemical compounds from a broad field.

Example. The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or small group of radicals from

amongst those referred to, as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document since the question would then be one of lack of novelty rather than obviousness). If the resulting compounds are not described as having any advantageous properties not possessed by the prior art examples or are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art but those properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection, then the invention doesn't involve inventive step. But where there is no indication that it is the choice of this radical that leads to the effect, the invention seems to have inventive step.

(D) Overcoming a technical prejudice:

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention.

Example. Drinks containing carbon dioxide are after being sterilized, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps and a certain substance so that no precautions should be taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

IV, 9.9
EPO

42. It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at by a series of apparently easy steps. However, a series of such steps might have been far from being obvious before a new idea was formulated. That is why the examiner in considering prior art should give fair weight to relevant arguments or evidence submitted by the applicant. Very often an invention is shown to be of considerable technical value and provides a technical advantage which is new and surprising, but this is not obvious or clear from the claims. So the examiner should be hesitent in pursuing an objection that such a claim lacks inventive step. In complicated cases the examiner should not give much weight to merely qualitative considerations, but he should rather pay attention to the necessity to find a few relevant references to support his objection as to lack of inventive step.

IV, 9.9
EPO

43. Commercial or industrial success alone is not to be regarded as indicative of inventive step. But evidence of commercial success is of relevance provided it derives from a new combination of technical features of the invention and not from selling techniques or advertising or from removal of known deficiencies by known means.

Industrial Applicability

Art. 33(4)
PCT

44. A claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry.

"Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.

IV, 4.1 EPO

45. An invention should not be considered as susceptible of industrial application if a person skilled in the art readily comes to the conclusion that the invention is clearly contrary to well-established physical laws and will not lead to the expected results.

46. Low economic results or poor competitive abilities cannot serve the basis for objections because the invention is not industrially appliable, if the invention can be realised in principle.

Art.5 PCT

47. In considering the question whether the invention is industrially applicable, the examiner should bear in mind that the description should disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

## Statement According to the Criteria of Novelty, Inventive Step, and Industrial Applicability.

Art.35 PCT

48. The International preliminary examination report should state in relation to each claim which is considered to be examined, whether it satisfies the criteria of novelty, inventive step, and industrial applicability.

Rule 70.6 PCT

49. The statement should consist of the words "YES" or "NO", or their equivalents.

50. The statement is made on each of the criteria taken separately and on all the three criteria taken as a whole.

Rule 70.6 PCT

51. The statement should be negative if any of the three criteria is not satisfied.

52. If a claim doesn't satisfy the criterion of industrial applicability then the statemnnt on this criterion should be negative and the whole statement on this claim should be "NO". In such a case, novelty and inventive step may not be considered, especially if it is difficult as for example in the case of a perpetual motion machine.

53. It should be remembered that these criteria are inter-related. For example, lack of novelty leads to lack of inventive step.

Art.35(2) PCT

54. The international preliminary examination report should be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require.

Rule 70.8 .PCT

55. Citations are necessary when the statement is negative. They should be accompanied by explanations unless the reason for citing any document is easy to imagine on the basis of consultation of the cited document. It is preferable that the explanations give the relevant parts of the cited document.

56. Explanations (and probably citations) are necessary when the statement concerning industrial applicability is negative.

57. Explanations and citations may be given whenever the statement is posotive, for example, to support the examiner's decision or when attention should be drawn to a certain document, which could require to ascertain the applicant's claims.

58. In considering novelty, inventive step, or industrial applicability a dependent claim is regarded as limited by all the features of the claim on which it depends. Therefore, if the statement concerning novelty of the independent claim is positive, it should also be positive for the dependent claim. This principle applies to inventive step as well. However, if the independent claim involves inventive step the examiner should concentrate on the question whether the dependent claim also involves inventive step as compared to the independent claim. If the documents are known which would lead, when considered together with the corresponding independent claims, to a negative statement concerning the dependent claims these documents should be cited notwithstanding the positive statement.

59. When the statement concerning the independent claim is negative, it may be both positive or negative for the dependent claim.

60. In a case of multiple dependent claims, the explanations should, if necessary, indicate a claim together with which the given dependent claim was considered, and all necessary combinations of claims should be regarded with reasonable limitations.

## Procedure Before the International Preliminary Examining Authority.

Art.31 PCT

61. The international preliminary examination is carried out on the demand of the applicant which is made separately from the international application. The demand should contain the prescribed particulars and should be in the prescribed language and form.

62. The international preliminary examination is preceded by international search carried out by the International Searching Authority. International preliminary examination uses the results of international search and considers amendments and corrections in the international applications made by the applicant after international search.

Art.33(6) PCT

63. The international preliminary examination should take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

64. Before the international preliminary examination begins the international application should contain the following:

- request
- description
- claims
- drawings refered to in the description
- abstract
- international search report
- annexed to the international search report: the copies of the priority documents cited, replacement

sheets with amendments and corrections to the application, if any.

- demand for the international preliminary examination
- information on paiment of fees.

65. The copy of the international application for the International Preliminary Examining Authority is supplied by the International Searching Authority or by the International Bureau as PCT Rule 62 provides.

66. The requirements to the international application are set forth in PCT Articles 4 to 8 and Rules 3 to 12. The Receiving Office and International Searching Authority check up whether these requirements have been met. Thus, the international application is being carefully checked up before it is submitted to the International Preliminary Examining Authority.

Rule 66 PCT

Art.38 PCT

67. The International Preliminary Examining Authority should not, unless requested or authorized by the applicant, allow access to the file of the international preliminary examination by any person or authority at any time, except by the elected Office once the international preliminary examination report has been established.

Rules 55,12 PCT

68. The International Preliminary Examining Authority considers international application only in one of the languages specified by the agreement with the International Bureau. If an international application is in any other language the International Preliminary Examining Authority may require the applicant to submit the translation of the application in accordance with PCT Rule 55.2.

69. The International Preliminary Examining Authority carries out the international preliminary examination within the time limits provided for in PCT Rule 69.

70. No International Preliminary Examining Authority will carry out the international preliminary examination if the international application claims the objects listed in PCT Rule 67.

71. The international preliminary examination should initially be directed to the claims, the description and the drawings, as contained in the international application at the time the international preliminary examination starts. The International Preliminary Examining Authority may notify the applicant accordingly in writing as to the defects of his application as provided by PCT Rule 66.2. The notification should invite the applicant to submit a written reply with amendmendts and/or corrections within the prescribed time limits, where appropriate. The International Preliminary Examining Authority may issue one or more additional written opinions and may give the applicant one or more additional opportunities to submit amendments or corrections within the prescribed time limit.

Only The International Preliminary Examining Authority may unofficially communicate with the applicant (by means of telephone, letter, or interview). The said Authority decides whether to have an interview with the applicant on the request of the latter, or to reply to his unofficial letter.

The applicant should submit amendments and/or corrections in accordance with the prescribed Rules (see PCT Rule66).

Rule 71.1 PCT

72. The International Preliminary Examining Authority should, on the same day, transmit one copy of the international preliminary examination report and its annaxes, if any, to the International Bureau, and one copy to the applicant.

Art.36(3) PCT

73. The international preliminary examination report should be communicated by the International Bureau to each elected Office.

[L'appendice III suit/Appendix III follows]

**THE PATENT OFFICE**
25 Southampton Buildings London WC2A 1AY

Telegrams Patoff London WC2 Telephone 01-405 8721 ext 3278

F A Sviridov Esq
Deputy Director General
World Intellectual Property Organisation
32, chemin des Colombettes
1211 Geneve 20 (Suisse)

Your reference

Our reference IPCD 40120

Date 17 June 1976

Dear Mr Sviridov

I refer to your Circular No 2409 (PCT 081.3) and am enclosing herewith a copy of PCT/TCO/VI (CI/44/75) with marginal comments, notes and some amendments which I hope will be of assistance.

Our general view is that although the EPO Draft Guidelines are unsuitable for use by the PCT authorities from a number of points of view, they should not be scrapped entirely, as they often show the approach which should be followed in drafting guidelines for the IPEA. The European Draft Guidelines provide a comprehensive procedure and allude also to matters strictly outside the examiner's jurisdiction such as formalities matters and matters of language which should have been attended to before the application reaches the examiner. However, where one has a single organisation (even if it is in two or more Offices) dealing with the filing of a patent application through to grant, persons concerned with one part of the organisation's function must be concerned with, or at least aware of, persons concerned with other parts of it. This is not possible with the PCT; the IPEA has to attend to an application forwarded to it as it is, and while it is right for it to draw the IB's attention to any formal failings in the application, it is not for it to take further action. It might accordingly be appropriate for the guidelines to point out which formal failings should be reported back, though it should be made clear where responsibilities lie in this connection.

The PCT Examination is much more limited than the European one. Firstly, Article 33(1) makes it clear that it is only to provide a preliminary and non-binding opinion on a limited number of topics, though it would seem from Rule 66.2 sub-paragraphs (a)(iii) - (a)(v) that the authority should in effect make a full examination and express an opinion thereon, and secondly no decision whether or not to grant a patent has ever to be taken. There are no sanctions, eg refusal, and the IPEA cannot really require the applicant to do anything. It would seem that after the issue of the examiner's first "opinion" any further action must come from the applicant; moreover it would seem from Rule 69 that the time available for any bilateral correspondence is quite short.

With the above differences in mind, it is clear that Chapters I and VI need considerable revision. As regards Chapter VI quite a considerable part of the examiner's duties in respect of European applications have no counterpart under the PCT, eg reference to the Examining Division, oral proceedings, evidence etc. On the other hand the PCT requires the preparation of an International Preliminary Examination report and in fact it is to this that the whole of the preliminary examination is directed. A section is consequently required upon the preparation of this report.

Much of Chapter IV is useful and can be retained, but it should be rearranged to follow the different PCT approach contained in Articles 33 and 34(4)(a), and Rules 64, 65, 66.2(a)(i) and (ii) and 67.

Yours sincerely,

A F C Miller

PCT/TCO/VI/9
Annexe A/Annex A
APPENDICE III/APPENDIX III

[L'appendice IV suit/Appendix IV follows]

APPENDICE IV/APPENDIX IV

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAY 21 1976

Mr. Felix A. Sviridov
Deputy Director General
World Intellectual Property Organization
32, chemin des Colombettes
1211 Geneva 20, Switzerland

Dear Mr. Sviridov:

In response to WIPO Circular No. 2409 (PCT 081.3) of January 26, 1976, the United States Patent and Trademark Office herewith transmits to you one marked up copy of the draft of the Guidelines for Substantive Examination of the European Patent Office for the purpose of providing a basis for elaborating PCT Guidelines for International Preliminary Examination.

Although the United States Patent and Trademark Office does not plan to become an International Preliminary Examining Authority at this time, I believe it is a worthwhile effort to participate in the drafting of Guidelines for Preliminary Examination both in order to assist the Interim Committee for Technical Cooperation and to further our understanding and interest in the preliminary examination phase of the Patent Cooperation Treaty.

Sincerely,

Rene D. Tegtmeyer
Assistant Commissioner
for Patents

Attachment

[L'appendice V suit/Appendix V follows]

DER PRÄSIDENT
DES DEUTSCHEN PATENTAMTS

8000 MÜNCHEN 2, den Zweibrückenstraße 12
Fernruf (0 89) 2 19 51
Fernruftdurchwahl (0 89) 21 95
Fernschreiber 5 23 534
Hausruf 1971
Geschäfts-Nr. 8330/10(11)-3.1.3.28 XIV 3
Bitte in der Antwort die vorstehende Geschäftsnummer angeben.

March 11, 1976

Mr. F.Syrinidov
Deputy Director General
World Intellectual Property
Organization (WIPO)
32, chemin des Colombettes
CH 1211 Genf 20
- Schweiz -

Re: PCT Guidelines for International Preliminary Examination

Ref.: Circular No.2409 PCT 081.3 of January 26, 1976.

Dear Sir,

Although the German Patent Office is a prospective International Preliminary Examining Authority according to the Protocol of Centralization to the European Patent Convention, the Federal Republic of Germany however will, upon the entry into force of the Convention, renounce its position as an International Preliminary Examining Authority under the Patent Cooperation Treaty for the German Patent Office in favour of the European Patent Office. This means that the German Patent Office will never apply the Guidelines for International Preliminary Examination.

The Guidelines are expected to be discussed in the near future within the frame-work of Working Group III of the Interim Committee of the European Patent Organization in which our delegation will take an active part. I therefore ask you



to understand that it seems advisable at present to refrain from making any observations regarding the Guidelines on behalf of the German Patent Office and to coordinate our opinion with the other delegations.

Sincerely yours

Dr. Häusler



[L'appendice VI suit/Appendix VI follows]

APPENDICE VI/APPENDIX VI

PATENT OFFICE
JAPANESE GOVERNMENT

4-3, Kasumigaseki 3-chome
Chiyoda-ku, Tokyo, Japan

TOKU SO 582/51
May 31, 1976

Mr. F.A. Sviridov
Deputy Director General
World Intellectual Property Organization
32, chemin des Colombettes
1211 Geneva 20, Switzerland

Dear Sir:

In reply to your letter C. 2409/PCT 081.3 of Jan. 26, 1976, the Japanese Patent Office wishes to inform you that we believe that the draft of the Guidelines for Substantive Examination of EPO is valuable data, but as the draft was made for European Patent Convention, and as differences exist between EPO examination procedure and PCT preliminary examination procedure, a considerably large-scale revision may be necessary on the draft of EPO examination guidelines to make it a basis for a draft of PCT international preliminary examination guidelines.

Our Office wishes to reserve our stand and withhold from making comments in detail. We believe that an outline of the PCT international search guidelines should be made first, and then the work of drafting the guidelines for PCT international preliminary examination started.

Yours truly,

Y. Nakata

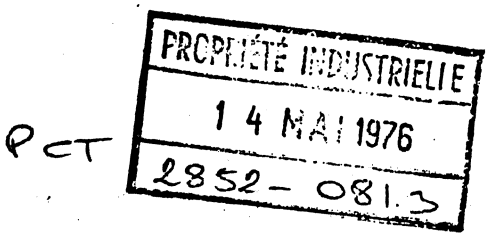
Yoshio Nakata
Director General
General Administration Department

[L'appendice VII suit/Appendix VII follows]

KUNGL PATENT- OCH REGISTRERINGSVERKET

Stockholm, May 11, 1976

Mr. Felix A. Sviridov
Deputy Director General
WIPO
32, chemin des Colombettes
CH-1211 Genève 20
Schweiz




PCT

Dear Mr. Sviridov,

In reply to your letter of January 26, 1976 (Circular No. 2409/PCT 081.3) I want to express our appreciation of the opportunity to make observations on the EPO guidelines for substantive examination. As you may know, Sweden is a member of Working Party III of the Interim Committee of the European Patent Organization, which is preparing those guidelines. Since the work there necessarily will result in compromises, which will have to be accepted as such, we feel that we are not in a position individually to make observations on this work that may lead to different conclusions in the PCT context. A general observation is, however, that in our opinion close agreement between the two systems would be of great value, and, secondly, that matter irrelevant to the PCT procedure (e.g. the EPC-solution with regard to prior applications) of course has to be omitted or suitably amended.

In conclusion, we therefore believe, that comments from delegations outside of the EPC should at this stage be of greater interest to the Secretariate.

Very sincerely yours

Saul Lewin

Deputy Director General

[L'annexe B suit/Annex B follows]

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ANNEX B

# COMPARATIVE ANALYSIS OF RESPONSES BY THE AUTHORITIES IN RESPECT OF THE DRAFT GUIDELINES FOR SUBSTANTIVE EXAMINATION IN THE EUROPEAN PATENT OFFICE

prepared by the International Bureau

Item 1, Explanatory Note

The responses under Item 1 above (dealing with the Explanatory Note of the EPO Guidelines) indicate that the two Authorities (GB and US) feel that the Explanatory Note set forth in the EPO Guideline must be replaced by an explanatory note relevant to the PCT. One Authority (US) has redrafted the Explanatory Note in the language of the PCT.

Item 2, Chapter I, paragraph 1.3 - change from the language of the international application and communication with the applicant in that language.

The responses set forth under Item 2 above (dealing with a change from the language of the international application as well as communication with the applicant in that language) show that a slight difference exists in respect of this question between two Authorities (GB and US). One Authority (GB) in its response to Item 2 above shows that the paragraph under this Item has no corresponding provision in the PCT other than as specified in PCT Rules 55.1 and 55.2. The response of the other Authority (US) points out that the applicant in some circumstances may request a change in the language of the international application if it is a language acceptable to the International Preliminary Examining Authority but states that, if such change is authorized by the Authority, only communication with the applicant will normally be in the new language.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice on this point. This flows from the fact that a distinction is made that any change in language of the international application should only involve communications from the applicant as provided for under PCT Rule 92.2(b).

Item 3, Chapter I, paragraphs 3.1, 3.2, 3.3, 3.5 and 3.6 - deviation from the language of the international application in oral interviews.

The responses set forth under the paragraphs of Item 3 above (dealing with deviation from the language of the international application in oral interviews) point out that the responses of two Authorities (GB and US) indicate somewhat different approaches for dealing with the subject matter under this Item. The response of one Authority (GB) makes the distinction that the only oral proceedings in the PCT are those referred to in PCT Rule 66.6 which is discretionary and not relevant to languages. The response of the other Authority (US) notes a difference in this regard and points out that, deviation from the language of the international application should be permitted with respect to personal interviews per se subject to certain international preliminary examination practices therefor.

Notwithstanding the fact that the PCT does not speak of deviation from the language of the international application in personal interviews, international preliminary examining practice under any future PCT Guidelines should provide International Preliminary Examining Authorities with necessary practice on the language or languages of such personal interviews, since it is clear that interviews will often take place under PCT Rule 66.6.

Item 4, Chapter I, paragraph 4.1 - language of the documents comprising an international application.

The responses set forth under Item 4 above (dealing with the language of the documents comprising the international application) show that the Authorities (GB, SU and US) do not interpret the paragraph under this Item in the same way. The response of one Authority (GB) points out that, if documents comprising the international application are filed in the wrong language, they should be noted by the receiving Office, the International Bureau or International Searching Authority.

This Authority (GB) felt that the paragraph under this Item was not relevant to the International Preliminary Examining Authority. The response of a second Authority (US) indicated that the language of the documents comprising the international application must be in a language acceptable to an International Preliminary Examining Authority. The response of another Authority (SU) refers to PCT Rules 12 and 55.

It would appear that the future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that under the PCT the requirements for the language of an international application lies between PCT Rule 12 and PCT Rule 55.2(a) and it would appear that the future PCT Guidelines should consider both these Rules as well as the possibility of combining the paragraph under this Item with paragraph 1.1 entitled, "The languages of the proceedings".

Item 5, Chapter I, paragraph 4.2 - document other than those comprising the international application not being filed in one of the prescribed languages being deemed not to have been received.

The responses set forth under Item 5 above (dealing with documents, other than those comprising the international application, when not filed in one of the prescribed languages under the PCT being deemed not to have been received) indicate that, the two Authorities (GB and US) are not necessarily in agreement One Authority (GB) indicates that the paragraph under this Item has no correspondence in the PCT. The other Authority (US) prefers the paragraph to be retained.

It would appear that any future PCT Guidelines should be able to harmonize the practice under the PCT on this point. This flows from the fact that even though the PCT does not appear to provide the sanction for not filing documents other than the international application in one of the prescribed languages, such a sanction could expedite issuance of international preliminary examination reports. No problem of harmonization is posed, since under PCT Rule 55.2(d), for example, a sanction exists for failing to provide a translation of the international application if the language of the international application is not one of the prescribed languages and if the competent International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the competent International Searching Authority. Likewise, under PCT Rule 66.7(e) a sanction exists for failing to provide a translation of the priority document when the applicant is invited to do so. It would seem a similar sanction should be applied mutatis mutandis for Item 5 above in connection with PCT Rule 92.2(a), (b) and (c) even though the PCT is silent on the matter. Similarly, consideration could be given to include such sanction in respect of PCT Rules 60.1 and 60.2.

Item 6, Chapter I, paragraph 6.1 - authentic text.

The responses set forth under Item 6 above (dealing with authentic text) indicate that the two Authorities (GB and US) are not in agreement. One Authority (GB) points out that the paragraph under this Item is not relevant to the PCT. The other Authority (US) considers the text of an application in the initial language of the international application as the authentic text.

Again no problem of harmonization is posed, since under Chapter I, paragraph 1.2 of the EPO Guidelines it is clear that the language in which the international application is filed is used as the language of the proceedings and such initial language should be considered the authentic text even though the PCT is silent on this matter. In view of the relevance of the paragraph under this Item, particular attention should be given in any future PCT Guidelines to the question of combining paragraphs 1.2 and 6.1 of Chapter I and also including a reference therein to Article 12(2) of the PCT.

Item 7, Chapter I, paragraph 6.2 - an erroneous translation of an application being brought into conformity with the original language at any time during the proceedings before the International Preliminary Examining Authority.

The responses set forth under Item 7 above (dealing with the possibility of the correction of an erroneous translation to conform to the original language at any time during the proceedings) point out that the two Authorities (GB and US) seem to appear in conflict on this point. The response of one Authority (GB) reflects doubt as to whether the subject matter under this Item is relevant to procedure in the International Preliminary Examining Authority. The response of the other Authority (US) specifically speaks of the solution with respect to erroneous translations.

Although the PCT does not seem to speak on Item 7 above, it would appear that any future PCT Guidelines should permit an International Preliminary Examining Authority to rectify an erroneous translation if only to protect applicants as well as properly evaluate any formal responses from applicants.

Item 8, Chapter I, paragraph 7.1 - the power to require a certificate that any translation supplied corresponds to the original text in case of serious doubt.

The responses set forth under Item 8 above (dealing with certificates of translations) show that two Authorities (GB and US) agree that certificates of translations should be provided for under the PCT. One Authority (GB) indicates that the paragraph should be redrafted in terms of PCT Rule 55.2(c) (translations limited to the international application), whereas the other Authority (US) substantially retains the original text of the paragraph requiring a certificate that any translation supplied corresponds to the original text in the case of serious doubts as to the accuracy of the translation.

It would appear that any future PCT Guidelines should readily be able to harmonize their practice under PCT on this point. This flows from the fact that the certificate of any translation would only be required in the case of serious doubt and the applicant would have the protection of verifying the correctness of a translation of the international application and any letter or document submitted to the International Preliminary Examining Authority in accordance with PCT Rule 55.2(c).

Item 9, Chapter II, paragraphs 3.2 and 3.3 - contents and practice concerning the title of an invention.

The responses set forth under Item 9 above (dealing with the contents and practice concerning the title of an invention) point out a considerable difference between the responses of the two Authorities (GB and US), particularly as to making a distinction as to the contents and practice concerning titles. One Authority (GB) feels that the paragraphs under this Item are not appropriate for the PCT and should be redrafted in the terms of PCT Rule 4.3. The other Authority (US) indicates the content and practice to be followed with respect to the title of an invention.

It would appear that the complete practice spelled out under this Item does not exist under the PCT. This flows from the fact that PCT Rule 4.3 differs in word formula from the paragraphs under this Item. Here a problem of harmonization is posed and it would appear that consideration in any future PCT Guidelines for drafting titles would better be left in the hands of national Offices.

Item 10, Chapter II, paragraph 4.18 - supplementing the disclosure of an international application by an indication or reference to the contents of a published or unpublished document.

The responses set forth under Item 10 above (dealing with adding to the content of the disclosure of an international application by reference to a published or unpublished document and whether that reference can properly be included in the international application) indicate that the two Authorities (GB and US) take a somewhat different approach. The response of one Authority (GB) in respect to a reference to an unpublished document, including an unpublished patent application later published, shows that so long as later publication of the unpublished document occurs on or before the international publication date of an international application there can be no objection to the reference. The response of the other Authority (US) indicates that a reference to a published document, published on or before the priority date of an international application, cannot be objected to, whereas a reference to an unpublished document later published including an unpublished patent application filed after the priority date of the international application should not be taken into account.

It would seem clear that the practice under this Item does not exist under the PCT, but that any future PCT Guidelines should readily be able to harmonize the practice on this point. In respect of supplementing or replacing a reference by an indication of the content of a document (beyond what is already explicitly

contained in the international application as originally filed), the said reference must be published on or before the filing date or priority date of the international application. This flows from the fact that, a person skilled in the art would be unable to carry out the invention without knowledge of the published or unpublished document which was later published unless the date of publication of these documents had occurred on or before the filing or priority date of the international application.

Item 11, Chapter II, paragraphs 6.1 to 6.3 - inventions relating to micro-organisms.

The response set forth under Item 11 above (dealing with inventions relating to micro-organisms) point out that the two Authorities (GB and US) do not interpret the paragraphs under this Item in the same way. The response of one Authority (GB) points out that the paragraphs under this Item are not applicable to the PCT. The response of the other Authority (US) indicates that the subject matter of micro-organisms should have certain directives for the examiners of an International Preliminary Examining Authority.

It would appear that any future PCT Guidelines should be able to harmonize the practice under the PCT on this point. This flows from the fact that PCT Rule 67.1(ii) includes microbiological processes and products of such processes on which international preliminary examination need be carried out. Although the PCT remains silent on particular practice with respect to micro-organisms, the practice suggested by one Authority (US) may meet that need.

Item 12, Chapter III, paragraph 1.3 - extent of protection conferred by the claims.

The responses set forth under Item 12 above (dealing with the scope of protection conferred by the claims) indicate that the Authorities (GB, SU and US) appear somewhat in conflict on whether the subject matter under this Item should be included in the PCT Guidelines. One Authority (GB) feels that such a paragraph is not applicable to the PCT. The responses of the other Authorities (SU and US) reiterate Article 6 of the PCT and PCT Rule 6.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that the paragraph under this Item stresses the importance and scope of protection of the claims in an international application as well as how claims may be interpreted. In respect of how claims may be interpreted, although unsaid in the PCT, such information seems essential for future PCT Guidelines.

Item 13, Chapter III, paragraph 2.3 - manner of claiming.

The responses set forth under Item 13 above (dealing with the manner of claiming) indicate that two Authorities (GB and US) make a distinction on the relevance of illustrating kinds of claims which may require different presentations. One Authority (GB) points out that the paragraph under this Item is not applicable in view of PCT Rule 6.3. The other Authority (US), however, makes a distinction as to different presentations of claims.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that the PCT (Rule 6.3(b)) spells out one format of claim presentation only "whenever appropriate". Thus, particular attention should be given in any future PCT Guidelines to the consideration of different claim formats.

Item 14, Chapter III, paragraph 4.3 - clarity and interpretation of claims where inconsistencies between the claims and description exist.

The responses under Item 14 above (dealing with the clarity and interpretation of claims with respect to the description of an international application) point out that the Authorities (GB, SU and US) interpret the

subject matter under this Item somewhat differently. One Authority (GB) feels that an International Preliminary Examining Authority cannot require anything at the time of the first written opinion by that Authority. The other two Authorities (SU and US) feel that an International Preliminary Examining Authority should require inconsistencies between the claims and descriptions to be removed.

The responses under this Item indicate that all Authorities responding are oriented in the same direction with respect to the practice under the PCT on this point. Thus, although PCT Rule 66.2 merely states that an International Preliminary Examining Authority "invites" the applicant to submit amendments or corrections, this invitation could be considered tantamount to a requirement, if only to protect applicants and permit the issuance of an international preliminary examination report which contains a statement on the three criteria of patentability.

Item 15, Chapter III, paragraph 6.4 - whether an examiner should require applicant to establish evidence on whether an invention can in fact be readily applied.

The responses under Item 15 above (dealing with whether an examiner should require applicant to establish evidence on whether an invention can in fact be readily applied) point out once again that the Authorities (GB and US) interpret PCT Rule 66.2 somewhat differently. One Authority (GB), as in previous Item 14, feels that an International Preliminary Examining Authority cannot require evidence from an applicant with respect to the subject matter under Item 15 above. The other Authority (US) indicates that such evidence should be required.

Again, no problem of harmonization is posed, since under Article 33(1) of the PCT one of the objectives of international preliminary examination is to formulate a non-binding opinion on the question of industrial applicability. Thus, the applicant should be required to provide the evidence in question under Item 15 above for the same reasons as previously set forth under Item 14.

Item 16, Chapter III, paragraph 7.5 - unity of invention providing alternative forms of an invention in a plurality of independent claims or in a single claim.

The responses under Item 16 above (dealing with whether alternative forms of an invention may be claimed in a plurality of independent claims or in a single claim) indicate that a major distinction exists between the Authorities (GB, SU and US) on this point. Two Authorities (GB and SU) feel that alternative forms of invention may be claimed either in a plurality of independent claims or in a single claim whereas one Authority (US) limits alternative forms of an invention in only a plurality of independent claims.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that PCT Rule 13.4 permits a dependent claim (single claim) as constituting itself as an invention in addition to its parent or independent claim and thus, particular attention should also be given in any future PCT Guidelines to the establishment of practice for handling two different inventions constituting lack of unity of invention whenever presented by an applicant in a single claim.

Item 17, Chapter III, paragraph 7.6 - general comment on the topic of unity of invention.

The responses under Item 17 above (dealing with general commentary on unity of invention) point out that two Authorities (GB and US) interpret the subject matter under this Item somewhat differently. One Authority (GB) feels the paragraph under this Item is not relevant to an International Preliminary Examining Authority whereas another Authority (US) retains the paragraph and adds permissive practice in respect of the practical consideration for how an examiner may consider the findings on the part of an International Searching Authority with respect to unity of invention when the claims have not been substantially amended.

It is recalled that Article 34(3)(a) permits an International Preliminary Examining Authority to reconsider a requirement for unity of invention on the part of an International Searching Authority, but if unity of invention findings on the part of an International Searching Authority could be followed, at least

where the claims have not been substantially amended, such practice would go a long way toward harmonization of any future PCT Guidelines. Although, the remainder of the text under this paragraph is also not spelled out in the PCT, such practice could help examiners of an International Preliminary Examining Authority better understand the concept of "one invention only", or "a group of inventions so linked as to form a single general inventive concept" under PCT Rule 13.1.

Item 18, Chapter III, paragraphs 7.8 to 7.11 - unity of invention in relation to the international search.

The responses set forth under Item 18 above (dealing with the requirements of unity of invention on the part of an International Searching Authority) point that the Authorities (GB, SU and US) are not necessarily oriented in the same direction. One Authority (GB) feels that the paragraphs under this Item should either be deleted or redrafted as PCT procedure for International Searching Authorities. Two Authorities (SU and US) indicate that the practice of International Searching Authorities with respect to unity of invention is important for examiners within an International Preliminary Examining Authority, especially in the context of fees under PCT Rule 68.

In view of the lack of any practice for unity of invention under the PCT, particular attention should be given in any future PCT Guidelines to the question of unity of invention particularly the aspects concerning the "main invention" under Article 17(3)(a) of the PCT and "what appears to be the main invention" under Article 34(3)(c) and PCT Rule 68.5. In respect of fees under unity of invention, the responses for the most part identify PCT Rule 68.3 (additional fees) and the said additional fees once established would be published in the Gazette under PCT Rule 86.1(ii).

Item 19, Chapter IV, paragraphs 1.1 and 2.1 - general comments concerning arrangement of Chapter IV and the criteria for patentability.

The responses set forth under Item 19 above (dealing with arrangement of Chapter IV, criteria for patentability and subject matter which may be excluded from international preliminary examination) indicate that the Authorities (GB, SU and US) remain well-harmonized on this point. One Authority (GB) points out that, generally the Chapter under this Item should be rearranged so as to follow the PCT approach of Articles 33, 34 and PCT Rules 64, 65, 66 and 67 and that the Chapter should also contain an early reference to Article 33(5) under the PCT. This same Authority (GB) states that the PCT does not specify the requirements of patentability but merely lists what may not be examined under PCT Rule 67. Two Authorities (SU and US) basically remain harmonized with the aforementioned position other than the particular order and manner of listing the criteria for patentability.

It would appear that any future PCT Guidelines should be able to harmonize the practice on the PCT on this point. In view of the various PCT Articles and PCT Rules concerned with international preliminary examination, it would appear logical that the Chapter under this Item could readily follow the order suggested by one Authority (GB), as well as most of the amendments suggested by the other Authorities (SU and US). In respect of the identification of "inventions" under paragraph 2.1 of this Item, the Authorities (GB, SU and US) for the most part do feel that the identification of those subject matters an Authority may not examine under PCT Rules 39 and 67 at least describe what is meant by an "invention" even though the PCT, of course, not being a patent granting system per se, does not speak of PCT Rules 39 and 67 subject matter as being an invention since the patentability of such subject matter is a matter of national law.

Item 20, Chapter IV, paragraph 2.1 - discoveries.

The responses set forth under Item 20 above (dealing with ascertaining a new property of a known material and the use made of an invention) show that, the Authorities (GB and US) take a somewhat different approach with respect to the practice under the PCT on this point. One Authority (GB) points out that, the paragraph under this Item is not mentioned in PCT Rule 67 whereas the other Authority (US) redrafts the paragraph to set forth certain examples indicating subject matter which may be an invention based upon discoveries.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that although the PCT is silent with respect to the term discoveries, the examiner of an International Preliminary Examining Authority should be informed as to when claimed subject matter derived from a discovery may or may not be an invention in order to formulate a preliminary or non-binding opinion with respect to the criterion of patentability set forth in Article 33(1) of the PCT.

Item 21, Chapter IV, paragraph 2.1 - aesthetic creation.

The responses set forth under Item 21 above (dealing with practice wherein an aesthetic creation might be an invention) show that, the Authorities (GB and US) make a distinction on the relevance of guidelines on this subject matter. One Authority (GB) points out that the PCT does not mention aesthetic creations whereas the other Authority (US) feels an examiner of an International Preliminary Examining Authority should know when an aesthetic creation might be an invention.

Although the PCT does not speak of subject matter concerning aesthetic creation, particular attention should be given in any future PCT Guidelines to the retention of this paragraph to aid examiners of International Preliminary Examining Authorities render preliminary and non-binding opinions on the criterion of patentability with respect to such subject matter.

Item 22, Chapter IV, paragraph 2.1 - programs for computers.

The responses set forth under Item 22 above (dealing with practice concerning computer programs) point out distinct differences between the responses of two Authorities (GB and US). One Authority (GB) indicates that an International Preliminary Examining Authority may be required to examine computer programs in accordance with PCT Rule 67.1(vi). The other Authority (US) points out that when contribution to the art resides solely in computer programs, the program per se is not an invention. It would appear that any future PCT Guidelines raise certain difficulties on this point. This flows from the fact that the practice for computer programs under PCT Rule 67.1(vi) only excludes computer programs from international examination for those Authorities not equipped to carry out international preliminary examination concerning such programs.

Item 23, Chapter IV, paragraph 2.2 - consideration of whether an invention is present.

The responses under Item 23 above (dealing with general guidelines considering whether an invention is present) show that the responses by the Authorities (GB and US) are oriented in the same direction. One Authority (GB) points out that the paragraph under consideration has a different approach in the PCT as spelled out in Article 34(4)(a)(i) and PCT Rules 66.2(a)(i) and 67. The other Authority (US) feels that certain subject matter for international preliminary examination should be illustrated by way of example to indicate whether an invention is present or not.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that, even though PCT Rule 67 clearly identifies subject matter which may be excluded from international examination and Article 34(4)(a)(i) provides the necessary practice for examiners to handle such excluded subject matter, any further examples which may aid an examiner to determine whether a claimed invention may or may not be excluded from international preliminary examination would help examiners render a preliminary and non-binding opinion on the criterion of patentability.

Item 24, Chapter IV, paragraphs 3.1 to 3.3 - exceptions from patentability.

The responses under Item 24 above (dealing with certain subject matter which is excluded from patentability) show that a distinction between two Authorities (GB and US) exists on this point. One Authority (GB) considers the paragraphs under this Item as not applicable to the PCT whereas the other Authority (US) has tailored the paragraphs to PCT Rule 9 and concluded that expressions contrary to morality and public order may be excluded from international applications.

A problem of harmonization is posed, since under the PCT subject matter or expressions not to be used such as expressions or drawings contrary to morality and public order may be noted by a receiving Office or International Searching Authority and suggested to an applicant for voluntary correction, but should the applicant fail to do so, such subject matter will only be excluded from international publication by the International Bureau, under Article 21(6) of the PCT. Thus, particular attention should be given in any future PCT Guidelines to the fact of whether subject matter contrary to morality or public order set forth in the claims of an international application would prevent an International Preliminary Examining Authority from issuing an international preliminary examination report.

Item 25, Chapter IV, paragraph 6.4 - conflicting applications.

The responses set forth under Item 25 above (dealing with conflicting applications) show that the Authorities (GB and US) are not necessarily oriented in the same direction with respect to the practice to be followed in the case of conflicting or interfering applications. One Authority (GB) points out that the paragraphs under this Item should be replaced by a short section dealing with the specific exclusions of PCT Rule 64.3. The other Authority (US) feels that these paragraphs are not useful for PCT Guidelines.

It would seem that any future PCT Guidelines may not be able to harmonize the practice on this point. This flows from the fact that even though certain published applications under PCT Rules 33.1(c) and 64.3 are to be cited in an international search report or called to the attention of the applicant in an international preliminary examination report, the practice in respect of handling of these certain published applications in the case of a conflicting international application is outside the scope of the PCT and depends upon national law.

Item 26, Chapter IV, paragraphs 8.1 to 8.4 - non-prejudicial disclosures.

The responses under Item 26 above (dealing with non-prejudicial disclosures) show that the Authorities (GB and US) interpret the paragraphs under this Item somewhat differently. Both Authorities (GB and US) consider that the aforementioned paragraphs should be cancelled, but one Authority (GB) feels the paragraphs could be replaced by a paragraph dealing with non-written disclosure under PCT Rule 64.2.

In view of the fact that non-prejudicial disclosure is not applicable to the PCT since it relates to legal concepts of national law, particular attention should be given in any future PCT Guidelines to the question of including a paragraph on non-written disclosure, particularly the aspects of when such disclosure can or cannot be considered relevant prior art under PCT Rules 33.1(b) and 64.2.

Item 27, Chapter IV, paragraph 9.7 - combining a document with an item of prior art made public in some other way (e.g., by use, etc.) for consideration of inventive step.

The responses set forth under Item 27 above (dealing with the manner of combining a prior art reference made public in some other way) show that the responses of the Authorities (GB, SU and US) remain well harmonized on this point. However, two Authorities (GB and SU) specifically point out that the last sentence of the paragraph under this Item is not applicable under PCT Rule 65.1.

In view of the lack of basis in the PCT with respect to combining "a document with an item of prior art made public in some other way e.g., by use," particular attention should be given to the elimination of such practice in any future PCT Guidelines.

Item 28, Chapter V, paragraph 1.4 and 1.5 - consideration of the right to priority particularly in the case of single or multiple priority claims.

The responses set forth under Item 28 above (dealing with the consideration of the right to priority particularly in the case of single or multiple priority claims) show that the Authorities (GB and US) are not necessarily oriented in the same direction on this point. One Authority (GB) questions whether the paragraphs under this Item are necessary for an International Preliminary Examining Authority. The other Authority (US) feels the practice defined by these paragraphs should be retained for the PCT Guidelines.

In respect of the general consideration of the right to priority, the Authorities for the most part do not feel that one of the tasks of an International Preliminary Examining Authority is to justify the right to single or multiple priority claims. Again, no problem of harmonization is posed since under the PCT the possibility of such justification may arise, and thus, the examiner would have to deal with the validity of priority claims at least to the extent that the question of priority is at issue and outstanding rights in respect of the subject matter of the international application being examined could be involved.

Thus, particular attention should be given in the PCT Guidelines to the consideration of the right to priority, particularly since the paragraphs under Item 28 above are consistent with the provisions of the Paris Convention for the Protection of Industrial Property and Article 8(1) of the PCT.

Item 29, Chapter VI, paragraphs 1.1 to 1.4 - the start of examination.

The responses set forth under Item 29 above (dealing with the start of international preliminary examination) show that the Authorities (GB, SU and US) interpret the paragraphs under this Item somewhat differently. Two Authorities (GB and SU) feel that paragraph 1.1 should be redrafted in terms of Article 31 of the PCT. One of these two Authorities (GB) further feels that entire Chapter VI is not generally applicable to the PCT. The responses of a third Authority (US) points out that certain of these paragraphs would be useful to explain processing tasks of international preliminary examination. Moreover, this Authority (US) feels that the paragraphs under this Item should further include practice under PCT Rule 62.

Again, no problem of harmonization is posed, but particular attention should be given in any future PCT Guidelines to the fact that Chapter VI does not necessarily deal, as does the earlier part of the PCT Guidelines, with further clarification or interpretation of practice under PCT per se, but rather with the processing aspects for handling national patent applications. Thus, the paragraphs are somewhat irrelevant to the PCT. Nevertheless, the PCT Guidelines could well follow the Chapter under this Item since the Chapter does suggest useful processing steps for the handling of international applications by an International Preliminary Examining Authority.

Item 30, Chapter VI, paragraph 2.5 - guidance with respect to additional written opinions.

The responses set forth under Item 30 above (dealing with procedure in the event the examiner wishes to issue an additional written opinion) indicates the Authorities (GB, SU and US) are not necessarily well-harmonized on this point. One Authority (GB) feels that the paragraph under this item should be deleted whereas two Authorities (SU and US) feel the paragraph should be retained.

Again, no problem of harmonization is posed even though the PCT does not spell out detailed practice concerned with additional written opinions and when and if they are necessary. However, the format under this Item could readily be followed for PCT Guidelines since both applicants and examiners need instructions for the handling of international application in the event an additional opportunity for amendment of the application is necessary under PCT Rule 66.4. This flows from the fact that applicants should normally be given the opportunity of contesting an invitation of an International Preliminary Examining Authority, with which he does not agree, before acquiescing in the invitation.

Item 31, Chapter VI, paragraph 3.2 - amendments by the applicant.

The responses set forth under Item 31 above (dealing with the conditions an applicant must satisfy to amend an international application) indicate, once again that the Authorities (GB and US) interpret the paragraph under this Item somewhat differently. One Authority (GB) feels that parts (a), (b) and (c) of the paragraph concerning what an amendment should contain should be redrafted in terms of Articles 19, 34(2)(b) and PCT Rule 46. This same Authority (GB) adds that the procedure of informing the applicant whenever his amendments do not meet certain conditions should be deleted. The other Authority (US) feels that the paragraph under this Item is suitable substantially as drafted and that an International Preliminary Examining Authority should inform an applicant that his international application cannot be allowed should his amendments not meet certain conditions.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that under the PCT an applicant will submit written amendments or corrections and particular attention should be given to the handling of such amendments and corrections. It is noted that under the PCT amendments under Article 19 are limited only to the claims and any future PCT Guidelines should include procedure for handling all types of amendments. However, information sent to an applicant informing him that amendments do not meet certain conditions and that the international application cannot be allowed appears better suited for procedure in national Offices rather than a PCT Guideline.

Item 32, Chapter VI, paragraph 3.5 - sanction if an applicant fails to reply to a written opinion of an International Preliminary Examining Authority.

The responses set forth under Item 32 above (dealing with the failure of an applicant to respond to a written opinion) show that the Authorities (GB and US) are not oriented in the same direction on this point. One Authority (GB) feels failure to respond to the invitation of an International Preliminary Examining Authority to correct formal matter or submit amendments to the description, claims and drawings cannot cause an international application to be withdrawn. Conversely, the other Authority (US) in such a situation feels that the international application could be deemed withdrawn.

Again, no problems of harmonization is posed, since under the PCT it would appear that an examiner of an International Preliminary Examining Authority would not hold an international application withdrawn in the case of any deficiencies formal or otherwise, but should follow the practice set forth in Article 34(4). It should be noted that there does not seem to be any reason why the invitation in the written opinion of the examiner referred to in this paragraph should necessarily come at the end of the opinion.

Item 33, Chapter VI, paragraph 3.6 - other specific procedure connected with the first written opinion on the part of an examiner.

The responses set forth under Item 33 above (dealing with other specific details for examiners connected with a first written opinion) once again indicate that the Authorities (GB and US) are not quite oriented in the same direction. One Authority (GB) points out that this paragraph should be redrafted referring to Articles 35(3) and 34(4)(a) under the PCT. The other Authority (US) feels that the paragraph should be retained to enhance the efficiency of international preliminary examining practice.

It should be noted that the complete practice governing an examiner's first written opinion is found in PCT Rule 66.2. Thus, particular attention should be given in any future PCT Guidelines to develop practice, not necessarily covered by PCT Rule 66.2, which may help examiners facilitate the early establishment of an international preliminary examination report.

Item 34, Chapter VI, paragraphs 4.6 and 4.7 - formal responses by applicant to the International Preliminary Examining Authority.

The responses set forth under Item 34 above (dealing with formal responses by the applicant under PCT Rule 66.3) show that the Authorities (GB and US) are not oriented in the same direction on this point. One Authority (GB) feels that

paragraph 4.6 should be redrafted in terms of Rule 66.2(c) while a portion of paragraph 4.7 concerning when an examiner should permit amendments to a written opinion of the International Preliminary Examining Authority should be retained. The other Authority (US) has redrafted paragraph 4.6 in terms of PCT Rule 66.3 and deleted paragraph 4.7 in its entirety.

It would appear any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that paragraph 4.6 under this Item indicates that both PCT Rules 66.2(c) and 66.3 are of particular relevance as an approach which lies between the two schools of thought of the Authorities (GB and US) responding.

In connection with paragraph 4.7, particular attention should also be given in any future PCT Guidelines as to whether this paragraph should be deleted or combined with the subject matter or amendments previously discussed under Item 31 above. Furthermore, if this paragraph should be retained it should be made clear that subsequent amendments under PCT Rule 66.4 are not a matter of right on the part of an applicant.

Item 35, Chapter VI, paragraph 5.10 - correction of errors of transcription and other mistakes being corrected at any time.

The responses set forth under Item 35 above (dealing with errors of transcription and other mistakes being corrected at any time) show that both Authorities (GB and US) are well harmonized on this point.

However, particular attention should be given in any future PCT Guidelines to inform examiners that PCT Rule 91 procedure is somewhat different from the paragraph under this Item in that the request for correction of an error is required to be made to different PCT Authorities depending upon in what part of the international application the error is contained.

Item 36, Chapter VI, paragraphs 6.3, 7.1, 7.4 and 7.5 - agreements as the result of an interview ultimately being subject to the views of other examiners and work within an examining division.

The responses set forth under Item 36 above (dealing with interviews and any agreement as the result thereof being ultimately subject to the views of other examiners and work within an examining division) show that the Authorities (GB and US) are not oriented in the same direction on this point. One Authority (GB) feels that the content of the subject matter under the paragraphs of this Item should be deleted, whereas the other Authority (US) desires substantial retention of the original texts subject to elimination of a part in paragraph 7.1 connected with the granting of a patent.

It would appear any future PCT Guidelines may not be able to harmonize the practice on this point. This flows from the fact that the requirements set forth in the last sentence of paragraph 6.3 and paragraphs 7.1, 7.4 and 7.5 under this Item deal with internal practice within particular offices and accordingly are not universally applicable to all International Preliminary Examining Authorities. It is noted that the type of practice under this Item may be more applicable to national Offices than international preliminary examination.

Item 37, Chapter VI, paragraph 7.6 - opinion of the examiner.

The responses set forth under Item 37 above (dealing with the opinion of the examiner) show that the Authorities (GB, SU and US) interpret the paragraph under this Item somewhat differently. One Authority (GB) feels that this paragraph should be deleted since the paragraph concerns the practice of an examiner wherever an application proceeds to grant. The other Authorities (SU and US) have redrafted the paragraph under this Item to include practice in respect of preparation of an international preliminary examination report.

Again, no problem of harmonization is posed, since it would appear that in any future PCT Guidelines particular attention should be given to the preparation of an international preliminary examination report by redrafting the paragraph under this Item in terms of Articles 33 and 35 of the PCT.

Item 38, Chapter VI, paragraphs 8.1 and 8.2 - searching and the international search report.

The responses under Item 38 above (dealing with searching and the international search report) show that the responses of the Authorities (GB and US) make a distinction as to the paragraphs under this Item. One Authority (GB) points out that these paragraphs should be deleted whereas the other Authority (US) feels that the PCT Guidelines should include sections on searching and the international search report.

It would appear any future PCT Guidelines should readily be able to harmonize the practice on this point. This flows from the fact that under the PCT the requirements of searching and the international search report are of particular relevance for the PCT Guidelines as well as the Guidelines for International Searches to be Carried Out under the PCT. Moreover, it would appear that whether or not the requirements of searching and the international search report are retained within the context of the PCT Guidelines, such Guidelines should nevertheless refer to the application of PCT Rules 34 and 63 as they concern International Preliminary Examining Authorities.

Item 39, Chapter VI, paragraph 8.3 - procedure in which an examiner would limit citation of a document in an unfamiliar language.

The responses under Item 39 above (dealing with an examiner limiting the citation of documents in an unfamiliar language only to the case where strong evidence exists that the document is relevant) show that the Authorities (GB, SU and US) are not oriented in the same direction on this point. One Authority (SU) feels the paragraph under this Item should be redrafted in the language of Article 33(6) of the PCT. A second Authority (GB) deletes the paragraph as not pertinent whereas the third Authority (US) retains the paragraph redrafted in the language of the PCT.

It would appear that any future PCT Guidelines may not be able to harmonize the practice under the PCT on this point. In respect of this paragraph, particular attention should be given to the fact that the paragraph does not seem compatible with the PCT and could therefore not be applied, as far as international search or international preliminary examination under the PCT is concerned. It cannot be excluded that such a practice could also promote a general tendency among searchers and even examiners which would be adverse to the requirement for a complete international search among all relevant documents of the PCT minimum documentation, irrespective of the language of the document. Such practice may tend to affect the quality of international searches by search examiners which, in turn, could possibly affect the quality of international preliminary examination.

Item 40, Chapter VI, paragraphs 8.5 to 8.9 - other additional searches during examination.

The responses set forth under Item 40 above (dealing with procedure with respect to when additional searches should be carried out during international preliminary examination) show that the Authorities (GB and US) make a distinction as to the relevance of such procedure under this Item. One Authority (GB) has deleted the paragraphs under this Item as not appropriate for international preliminary examination. The other Authority (US) feels these paragraphs should be retained subject, of course, to drafting changes in the language of the PCT.

Again, it should not entail any problems of harmonization for any future PCT Guidelines if particular practice is given to examiners of an International Preliminary Examining Authority in respect of additional searches during international preliminary examination. This flows from the fact that:

(i) international applications designating certain Contracting States will, in addition to the requirement of supplementary search (Article 157(2)(a) of the European Patent Convention), also undergo an "update" search by an examiner and,

(ii) the procedure under Item 40 above is considered to correspond with Article 33(6) of the PCT whereby an International Preliminary Examining Authority may if it considers it warranted, take any additional documents considered to be relevant into consideration in drawing up the international preliminary examination report.

Item 41, Chapter VI, paragraphs 11.1, 11.2, 11.5, 11.6 and 11.7 - determination of time limits and the failure to respond within a time limit.

The responses set forth under Item 41 above (dealing with the determination of time limits and the failure to respond within a time limit) show that the responses of the Authorities (GB and US) are not necessarily oriented in the same direction on the aforementioned paragraphs. One Authority (GB) points out that paragraphs 11.1, 11.2 and 11.5 on determination of time limits should be revised to deal with the PCT time limits as far as International Preliminary Examining Authorities are concerned and the consequence of the failure to comply with such time limits. This same Authority, also feels that paragraphs 11.6 and 11.7 on failure to respond within a time limit are not necessary within the PCT, since it may only be that the international preliminary examination report will not then be established. The other Authority (US) has redrafted the paragraphs under this Item to reflect certain PCT provisions connected with international search as well as international preliminary examination. In the case of international preliminary examination, this Authority (US) has redrafted paragraph 11.5 on determination of time limits in terms of PCT Rules 80 and 82.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that the paragraphs under this Item could serve examiners as a pattern for a corresponding position on time limits and the consequences of failure to respond to these time limits. It is noted that particular attention could possibly be given in any future PCT Guidelines to the following:

(i) submitting of translation of international application and a statement (Rule 55.2(b) and (d));

(ii) amending claims before International Bureau (Article 19(1); Rules 46.1; 62.2(b));

(iii) amendment before International Preliminary Examining Authority (Article 34(2)(b); Rules 66.1; 66.2(d));

(iv) authorization for rectification (Rule 91.1(g)(iii));

(v) correcting defects in demand (Rule 60.1);

(vi) correcting defects in later elections (Rule 60.2);

(vii) furnishing priority document (Rules 17; 66.7(a)(c));

(viii) furnishing translation of annexes (Article 36(3)(b); Rule 74));

(ix) furnishing translation of priority document (Rules 17.2(a); 66.7(c));

(x) international preliminary examination (Article 35(1); Rule 69);

(xi) keeping records and files (Rule 93.3);

(xii) paying handling fee (Article 31(5), Rules 57.3(a)(b), 57.5));

(xiii) paying preliminary examination fee (Article 31(5), Rule 58.1(b));

(xiv) proving delay or loss in mail (Rule 82.1);

(xv) proving interruption in mail (Rule 82.2);

(xvi) requesting copies of cited documents (Rule 71.2);

(xvii) responding to written opinion (Rule 66.2(d));

(xviii) restricting claims or paying additional fees (Article 34(3)(c), Rule 68.2);

(xix) withdrawal of demand or election (Article 37(4)(b), Rules 75.1 and 75.4);

(xx) computation of time limits (Rule 80).

Item 42, Chapter VI, paragraph 11.8 - request for further processing of the international application is deemed to be withdrawn.

The responses set forth under Item 42 above (dealing with request of an applicant for further processing of an international application deemed to be withdrawn for failure to meet time limits set by a PCT Authority) again show that the responses of the Authorities (GB and US) are not well harmonized. One Authority (GB) points out that the paragraph under this Item is not applicable under the PCT whereas the other Authority (US) retains the paragraph subject to a slight change of a drafting nature.

It is noted that the PCT remains silent in respect of the problem raised by paragraph 11.8 under this Item. Thus, particular attention should be given in any future PCT Guidelines to the consideration of how the problem raised by this paragraph could be solved.

Item 43, Chapter VI, paragraph 11.11 - effect of change in priority date.

The responses set forth under Item 43 above (dealing with the effect of change in priority date on time limits under the PCT) point out that the responses of the Authorities (GB and US) are once again oriented in different directions. One Authority (GB) feels that the effect of change in priority date is not applicable to international preliminary examination whereas the other Authority (US) feels that there are complications to the issue of time limits based on a possible changing priority date and thus, the paragraph under this Item should be retained.

It is recognised that under PCT Rule 4.10 procedure, when the original priority claim is cancelled and the international filing date becomes the "priority date" for time limit purposes, certain timing problems may be encountered.

In respect of these timing problems it would appear that particular attention should be given in all future PCT Guidelines for the establishment of practice on this matter. It should be noted that the practice, for example, provided in paragraph 11.11 including the provisions of Article 2(xi)(c) may help close the gap of harmonization in respect of change of priority date and the effect of such change on the time limits for processing under the PCT.

Item 44, Chapter VI, paragraphs 14.2, 14.3, 14.4, 14.5 and 14.7 - taking of evidence.

The responses set forth under Item 44 above (dealing with the taking of evidence, e.g., written evidence by production of document or sworn statement, oral evidence and evidence by inspection) again show a difference of opinion between the responses of the Authorities (GB and US) under this Item. One Authority (GB) feels the paragraphs under this Item are not applicable to international preliminary examination. The other Authority (US) has retained these paragraphs as useful instructions for examiners during the examination.

It would appear that any future PCT Guidelines should readily be able to harmonize the practice on this point. Notwithstanding the fact that the PCT is silent in respect of taking evidence as provided for under these paragraphs, particular attention should be given to whether such taking of evidence would be beneficial to applicants in responding to the opinion of the International Preliminary Examining Authority as well as examiners when they formulate a preliminary and non-binding opinion on the criterion of patentability under Article 33(1) of the PCT.

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