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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Twelfth Session
Geneva, December 12 to 16, 2005**

**PCT INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION GUIDELINES**

Document prepared by the International Bureau

SUMMARY

1. The PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) will require updating over the course of the next 12 months to take account of a number of issues and developments. The Meeting is invited to agree an appropriate action plan.

BACKGROUND

2. The first version of the PCT International Search and Preliminary Examination Guidelines, replacing the previous separate International Search Guidelines and International Preliminary Examination Guidelines, was published in 2004. Drafting work had been led by the United States Patent and Trademark Office, guided by discussion between all the International Authorities at the seventh to ninth sessions of the Meeting, as well as using the Meeting’s electronic forum. Since that time, a number of amendments of the Regulations under the PCT and modifications of the Administrative Instructions have been agreed.

AMENDMENTS OF THE REGULATIONS; MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS

3. Since the publication of the Guidelines, the following amendments of the Regulations have been agreed:

(a) with effect from April 1, 2005:

- simplification of the protest procedure before both the International Searching Authority and the International Preliminary Examining Authority in case of non-unity of invention;
- furnishing of sequence listings for the purposes of search and examination;
- corrigenda and consequential amendments further to the amendments adopted by the Assembly on October 1, 2002, with effect from January 1, 2004;

(b) with effect from April 1, 2006:

- international publication and the PCT Gazette in electronic form;
- addition of Arabic as a language of publication;
- exceptions to the all-inclusive designation system;

(c) with effect from April 1, 2007:

- missing elements and parts of the international application;
- restoration of the right of priority;
- rectification of obvious mistakes;
- addition of patent documents of the Republic of Korea to the PCT minimum documentation.

4. There have also been a number of modifications of the Administrative Instructions. Apart from ones consequential to the above matters, these include:

- removal of Part 2 of Annex B, providing examples relating to unity of invention (following inclusion of updated examples in the Guidelines);
- signature of the declaration of inventorship;
- modifications of the standards for electronic filing and processing of international applications.

5. A number of further proposals are also under discussion relating to electronic filing and processing of international applications and, as a related matter, the handling of sequence listings relating to international applications.

UPDATING THE GUIDELINES

Subjects to Be Addressed

6. Many of the above changes will have no impact on the Guidelines. However, others are significant to the work of the International Authorities and should be reflected in new or amended relevant passages, most notably the provisions on protest procedures (already in force) and the amendments due to come into force in April 2007.

7. It is also recalled that there were some issues on which a common approach between Authorities could not be agreed at the time and consequently the Guidelines were drafted with flexible language, or else different possibilities were set out in appendices to certain chapters. At its ninth session, the Meeting “noted that it was desirable to work towards increased consistency in practice and agreed that areas of difference should be the subject of further review in the future, including in particular: (i) recording of search history [...]; and (ii) unity of invention practice in relation to biotechnological inventions [...]” (see paragraph 114 of document PCT/MIA/9/6). Other areas on which there are differences may also be suitable for review at an appropriate time.

Methodology and Timing

8. The International Bureau has prepared draft modifications to the Guidelines relating to amendments of the Regulations which have already come into force and correction of a number of minor errors which have been discovered. These changes do not appear urgent, since they relate mainly to the parameters within which Offices’ individual procedures must fall, rather than specific common features of the system. They could either be proposed to International Authorities by means of a circular in the near future, or else be considered as part of a wider package of changes. In addition, the French version has been thoroughly revised for consistency and to align it more accurately with the English text.

9. The amendments of the Regulations which will come into force in April 2006 appear to have little effect on the actions performed by Offices in their role as International Authorities.

10. The changes which will be required in relation to the amendments of the Regulations which will come into force in April 2007 will be more wide-ranging and include issues relating to the substantive content of the international application. In view of the fact that there will be no similar provisions in many national laws to assist the understanding of examiners, it would be desirable for the Guidelines to deal with these subjects as clearly and completely as possible, leading to a common approach from the outset. Consequently, International Authorities themselves may wish to make proposals for appropriate changes in respect of these matters.

11. In order that English and French versions of the Guidelines may be published well in advance of the entry into force of the major amendments to the Regulations in April 2007, it is recommended that a final draft should be completed by the end of December 2006. Furthermore, it is recommended that Authorities should aim to agree on the main principles which they consider relevant by the end of August 2006, in order that they may be taken into account in drafting related modifications of the Administrative Instructions and Receiving Office Guidelines, and that the results of consultations with receiving Offices and designated and elected Offices on those Instructions and Guidelines can be considered by Authorities before the final draft of the Guidelines is completed.

12. Authorities may wish to consider whether a minor interim update is also desirable to bring the Guidelines up to date in the meantime.

13. *The Meeting is invited to:*

(i) identify any matters in the Guidelines, in addition to matters arising from amendments of the Regulations and modifications of the Administrative Instructions, which should be reviewed; and

(ii) agree on a timetable and process for drafting the next version or versions of the Guidelines.

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